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Germany: FCJ's Digitales Buch - Generalisation and (in)admissible extension?

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In its [judgment of 7 November 2017](#), X ZR 63/15 - *Digitales Buch*, the German FCJ (*Bundesgerichtshof*) took the opportunity to complete its *Kommunikationskanal* case law on the admissibility of a generalisation of a teaching in patent claims by the omission of specific features that have been taught in the examples of the patent application.

The patent application can either be the priority application or the original patent application. While in the former case the question of the admissibility of the generalisation is relevant with regard to the right to claim priority, in the latter case it is decisive for the question whether the generalisation is an (in)admissible extension. In both cases under the established case law of the FCJ it is necessary that the claimed invention has been disclosed identically in the (prior) patent application. This is to be assessed in accordance with the principles of novelty review (FCJ, Judgment of 14 October 2003, X ZR 4/00 - *Elektronische Funktionseinheit*). An identical disclosure requires that the skilled person can take the claimed technical teaching „directly and unambiguously“ from the original application documents (FCJ, Judgment of 11 September 2001, X ZR 168/98 - *Luftverteiler*; FCJ, Judgment of 8 July 2010, Xa ZR 125/07 - *Fälschungssicheres Dokument*; FCJ, Judgment of 14 August 2012, X ZR 3/10 - *UV-unempfindliche Druckplatte*) as a possible embodiment of the invention (FCJ, Decision of 11 September 2001, X ZB 18/00 - *Drehmomentübertragungseinrichtung*; FCJ, Judgment of 18 February 2010, Xa ZR 52/08 - *Formteil*). The exploitation of the content of such disclosure by a generalisation of the teaching shown in the originally disclosed examples is admissible if the described examples appear to the skilled person to be an embodiment of the more general teaching claimed in the subsequent patent application (or the patent), and if this teaching, in the generality claimed in the subsequent patent application (or the patent), could already be taken from the (prior) patent application as being part of the filed invention (FCJ, Judgment of 17 July 2012, X ZR 117/11 - *Polymerschaum*).

The [earlier FCJ judgment](#) of 11 February 2014, X ZR 107/12 - *Kommunikationskanal*, concerned the possibility to claim priority despite a generalisation of the technical teaching by omitting a specific feature in the subsequent patent application that was taught in the description and the examples of the priority applications. The FCJ had found that in such case priority could be claimed if the content of the (prior) patent

application did not show a concrete connection between the concerned to be omitted feature and the claimed means for the solution of the technical problem underlying the patent. In the case underlying the *Kommunikationskanal* decision such connection could not be established, thus priority could be claimed. As this had not been relevant for the case at that time though, the FCJ did not comment on the omission of features that in accordance with the description of the patent application were in a (merely) cumulative manner relevant for the proposed solution of the problem underlying the patent.

In the judgment of 7 November 2017, X ZR 63/15 – *Digitales Buch*, the FCJ had the chance to make up for this. The case concerned a patent for a display device with an interface in the swivel joint. The description in the patent application distinguished between bigger less handy devices like laptops and notebooks and more handy and easier to operate devices like digital books. All the examples in the patent application concerned such book-like easily handable devices. The patent claim as defended in the main request of the nullity proceedings however used the expression “display device for the reproduction of text and/or image information” and not a “digital book”. Thus the claim did not reflect the distinction between the more and the less handy devices and accordingly included bigger devices like bigger laptops and notebooks.

The Federal Patent Court had found in first instance this contained a subject-matter extending beyond the content of the application as filed, thus inadmissibly extended the patent application. In the appeal proceedings, the FCJ confirmed this finding and reasoned that the omission of a feature that has been described in the examples of the patent application, namely in this case the book-like quality, was inadmissible if and because the means provided for in the patent claim served the solution of a problem that required the book-like properties of the device.

The problem underlying the invention was to provide a device for the reproduction of book information allowing for an easier handling and operation of the device. Feature group 3 of claim 1 required that the interface for the electrical connector was arranged within the swivel joint about which the casing with a main part and at least one secondary part could be folded open and shut. According to the description this construction avoided that the plug-in connections placed at the backside of the main part hindered (when plugged) that the device could be held at the spine and could be laid down on its back. Accordingly, the advantages of the plug-in connection in the swivel joint as provided for by the invention were described to be the better possibility to lay down the device, a more favourable symmetry and balance of the device and a lower irritation of the user by disturbing cables and a reduction of the “technical impression” of the device. These advantages of the claimed invention described in the original application necessitated that the device due to its dimensions, its weight and the choice and the arrangement of its control elements could be handled like a book. The described arrangement of the interface within the swivel joint was therefore functionally associated with the suitability of the device to be handled like a book. Therefore, devices that have a corresponding arrangement of the interface but could not be handled book-like were not disclosed as being part of the invention and the omission of this feature in the patent was inadmissible.

The FCJ further explained that the fact that such non book-like devices may realise

other advantages described for the invention did not alter this assessment, because according to the description in the patent application the easy handling of the device was in the foreground of the advantages of the invention. Correspondingly, it was not directly and unambiguously disclosed that embodiments that could not be handled book-like fulfilling other advantages of the invention though, should be part of the invention.

The seemingly decisive criterion for the inadmissibility of the omission of the “book-like” feature in the patent claim for the FCJ was (just as it has been in the *Kommunikationskanal* decision) that the problem underlying the invention required (or did not as in the *Kommunikationskanal* decision) the presence of the concerned feature or in other words that there was a specific connection between the feature to be omitted and the problem and the corresponding invention of the patent application. This is similar to the feature (ii) of the essentially or the three-point test in the Guidelines for Examination, Part H, No. 3.1 “*the feature is not, as such, indispensable for the function of the invention in the light of the technical problem the invention serves to solve*”. It has been criticised as being vague though (see reference above) compared to the EPO test. It is surely true that it is difficult to predict what will be identified as concept of “the invention” used to measure whether or not there is a relationship with the to be omitted feature. It has to be kept in mind however, that the question of what the skilled person would learn or take from a patent application always contains valuating elements and correspondingly has discretionary elements. The orientation at the relationship between the to be omitted feature and the problem and solution identified by the skilled person in and from the patent application avoids however that the patentee is restricted in a manner not justified with respect to the technical contribution of the patent.

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Art. 123(2) of the European Patent Convention (EPC), a European patent (application) may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. Adding subject-matter which is not disclosed would give an applicant an unwarranted advantage and could be damaging to the legal security of third parties. (G 1/93, OJ 1994, 541) The 'gold standard' of the European Patent Office's Board of Appeal is that "*any amendment can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed*" (G 3/89, OJ 1993,117; G 11/91, OJ 1993, 125).">Added matter, [Extension of subject matter, Germany, Validity](#)

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