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## FCJ rules that the skilled person will look for approaches already provided by a standard when wanting to improve that standard

Thorsten Bausch (Hoffmann Eitle) · Saturday, January 21st, 2012

The German Federal Court of Justice recently issued a decision entitled ‘E-Mail via SMS’, November 22, 2011, X ZR 58/10, in which it was found that when seeking to improve a data structure prescribed in an international standard, a skilled person would consider mechanisms already described in the standard when solving the identified technical problem. It was furthermore found that if the standard provides a manageable number of possible solutions, each having specific advantages and disadvantages, this provides an incentive to take each of the solutions into account.

In the case in question it was ruled that it was obvious to apply a known concept for sending instructions to a SIM card of a mobile phone via special Short Message Service (SMS) messages that use the so-called SIM application toolkit to the problem of sending information elements of an email via SMS.

The fact that theoretically there is a large multitude of possible solutions different from the chosen one does not change the conclusion, because it is known to a skilled person to be undesirable to leave the context of a standard, as suggestions that require fundamental changes in a standard have little chance of being accepted. Thus, the wish to find a practical solution would lead the skilled person to concentrate on approaches already suggested in the standard.

The FCJ identified three solution paths from the standard for the identified objective problem, but did not accept the patent proprietor’s argument that the general prior art suggested one path in particular. Rather, it was found that the skilled person would have considered each of the paths, as it was recognizable that each had certain advantages and disadvantages.

This new decision is well in line with the FCJ’s case law on patentability, in which it is held that in order to conclude a lack of inventive step, it must be shown that a skilled person was not only able to identify a given problem, but in addition had certain incentives and hints towards the path chosen by the claimed invention (‘Betrieb einer Sicherheitseinrichtung’, April 30, 2009, Xa ZR 92/05). Namely, it has now been added that when dealing with inventions that relate to standards, an incentive to look into solution paths suggested by the standard itself can be assumed. On the other hand this also means that in future cases a plaintiff arguing a lack of inventive step of a standard related invention and drawing upon solutions outside of the standard context will have to take particular care to demonstrate why the skilled person had an incentive to look beyond the

standard.

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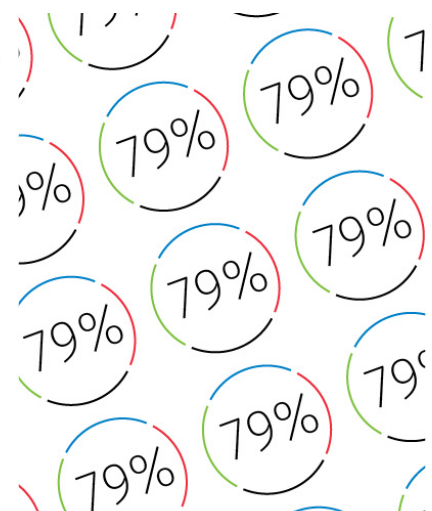
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