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Some Reflections on Priority of a Partially Reflecting Sheeting

Thorsten Bausch (Hoffmann Eitle) · Tuesday, December 1st, 2015

A new decision by the German Federal Court of Justice ([X ZR 112/13 – Teilreflektierende Folie](#)) provides another illustrative example of the FCJ's fairly generous and applicant-friendly case law on the allowability of amendments and priority.

The patent at stake was a European Patent directed to the use of an image projector, a reflective surface and a smooth, transparent and partially reflecting sheeting for presenting images in the background of a stage, wherein the sheeting has a surface area of at least 3 m x 4 m and is under tension.

The Federal Patent Court revoked the patent for unallowable amendment of the feature “partially reflecting” and considered that the feature of the surface area of at least 3 m x 4 m is not entitled to priority. Indeed the application as filed only mentioned a sheeting that had a degree of reflection of 30% to 50%, and the priority document did not concretely specify any surface area at all.

The Federal Court of Justice, however, disagreed on both counts. It took from Figure 4 of the application as filed that the sheeting cannot be completely transparent and had to be partially reflecting in order to evoke the so-called “ghost trick” mentioned in the specification. The degree of reflexion of 30-50% would have been understood by a skilled person as a preferred embodiment only. Hmm. If so, one might wonder why the original application did not state this explicitly and apparently recited the degree of reflexion as an imperative, rather than preferred, feature.

Even more interesting was the FCJ's argument why it considered the surface area of at least 3 m times 4 m to be entitled to priority, even though such values had not been disclosed at all in the priority document. The court considered that this absence of concrete values suggests that the disclosure of the priority document comprised the use of sheetings of various sizes, including those having a smaller area than 3 m x 4 m. However, the Figures 2 and 4 of the priority document suggested such an area as a *possible* minimum area, as could be taken from the schematic representation of a human presenter (38) and the distance between the floor and the ceiling of the stage.

The court published the following headnote on Art. 87(1) EPC:

The priority of an earlier application that contains a definition of a range can at least be validly claimed if the partial range or single value claimed in the later application, which is within this range, has been disclosed in the earlier application as a possible

embodiment of the invention.

In my opinion, the patentee would therefore also have been entitled to priority, had he claimed a sheeting having an area of at least 3.12 m x 4.58 m or, arguably, 2.8 m x 3.6 m etc. As the FCJ put it, the fact (alone) that the priority document does not contain any concrete information on the dimensions of the sheeting does not result in that the patent in suit (claiming a range limited by concrete values) cannot claim priority from this document.

I am not sure that the EPO's Boards of Appeal would even have agreed to this statement in isolation. If and when a patent claims a concrete numerical range and such range is not "clearly and *unambiguously* derivable" from the priority document, i.e. if and when the priority document *explicitly* discloses the same numerical value or range, this will typically be the end of any debate on priority before the EPO. It may be tempting to speculate how such a case will be decided by the UPC in the future. Until then, this case again shows that a national German patent application can be an attractive alternative to European Patents, either with or without unitary effect.

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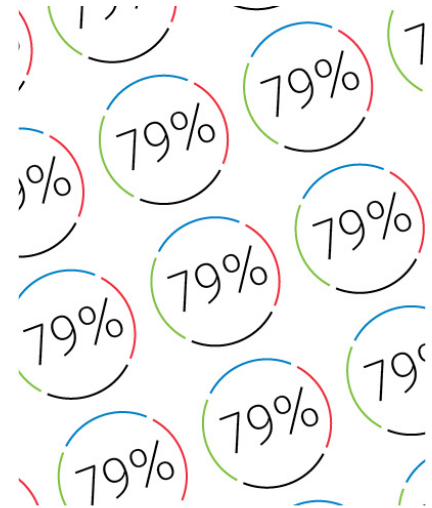
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This entry was posted on Tuesday, December 1st, 2015 at 8:01 am and is filed under [G 1/93](#), [OJ 1994, 541](#)) *The ‘gold standard’ of the European Patent Office’s Board of Appeal is that any amendment can only be made within the limits of what 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).*“>Amendments, [Germany](#), [Priority right](#)

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