

Recent Case Law in German Patent Law



2021

© **Eisenführ Speiser**
Patentanwälte Rechtsanwälte PartGmbB

Eisenführ Speiser Patentanwälte Rechtsanwälte PartGmbB is a partnership with limited professional liability registered in the Partnerships Register of Bremen Local Court, Registration no. PR 30.

All rights reserved. No part of this publication may be reproduced, stored in a retrieval system or transmitted in any form or by any means, mechanical, photocopying, recording or otherwise, without prior written permission of Eisenführ Speiser Patentanwälte Rechtsanwälte PartGmbB.

Nothing in this publication constitutes legal advice. Eisenführ Speiser Patentanwälte Rechtsanwälte PartGmbB assumes no responsibility for information contained in this publication or on the website www.eisenfuhr.com and disclaims all liability with respect to such information.

CONTENTS

Foreword	2
I. Patent interpretation	
1. Specific functions of features and their relevance for interpretation	3
<i>Federal Court of Justice judgment of 2 February 2021 in case no. X ZR 170/18 – Anhängerkupplung II</i>	
2. Relevance of the state of the art as acknowledged in the patent for interpretation.....	7
<i>Federal Court of Justice judgment of 2 March 2021 in case no. X ZR 17/19 – Schnellwechseldorn</i>	
II. Patent infringement / Equivalence	
3. On the question of the same effect	9
<i>Federal Court of Justice judgment of 17 November 2020 in case no. X ZR 132/18 – Kranarm</i>	
4. On the question of the equivalent solution / considerations based on the essential meaning of the claim	12
<i>Düsseldorf Higher Regional Court judgment of 8 April 2021 in case no. 2 U 42/20 – Abstreifeinheit</i>	
5. Liability in case of activities performed in foreign countries.....	15
<i>Federal Court of Justice judgment of 8 June 2021 in case no. ZR 47/19 – Ultraschallwandler</i>	
6. Liability in case of activities performed only in foreign countries	18
<i>Düsseldorf Higher Regional Court judgment of 30 September 2021 in case no. I-2 U 52/20 – CE-Kennzeichnung</i>	
III. Validity	
7. On inadmissible amendments.....	20
<i>Federal Court of Justice judgment of 20 October 2020 in case no. X ZR 158/18 – Zigarettenpackung</i>	
8. On the validity of the priority claim – „the same invention“	25
<i>Federal Court of Justice judgment of 20 May 2021 in case no. X ZR 62/19 – Bodenbelag</i>	
IV. Other issues in substantive law	
9. Standard-essential patents / FRAND principles	27
<i>Karlsruhe Higher Regional Court court order of 12 February 2021 in case no. 6 U 130/20 – Wurzelsequenzen</i>	
<i>Mannheim Regional Court judgment of 2 March 2021 in case no. 2 O 131/19 – (Uplink)-Synchronisation</i>	
<i>Munich Regional Court judgment of 9 September 2021 in case no. 7 O 15350/19 – Sprachsignalcodierer</i>	
<i>Düsseldorf Higher Regional Court judgment of 7 February 2022 in case no. I-2 U 27/21 – AASI</i>	
<i>Düsseldorf Regional Court judgment of 11 May 2021 in case no. 4b O 83/19 – Matrixvorgang</i>	
<i>Düsseldorf Regional Court judgment of 21 December 2021 in case no. 4c O 42/20 – Entropiedecodierer</i>	
10. May artificial intelligence be an inventor?.....	31
<i>Federal Patent Court judgment of 11 November 2021 in case no. 11 W (pat) 5/21 – DABUS</i>	
11. Requirements regarding the employer’s notification of intention to abandon	33
<i>Federal Court of Justice judgment of 27 July 2021 in case no. X ZR 61/20 – Zündlanze</i>	
V. Procedural law issues	
12. On the applicability and scope of Section 145 PatG.....	36
<i>Federal Court of Justice judgment of 3 November 2020 in case no. X ZR 85/19 – Fensterflügel</i>	
13. Protection of secrets	38
<i>Munich Regional Court court order of 21 January 2022 – Inhouse-Mitarbeiter</i>	

FOREWORD

This year's Case Law Review begins once again with two supreme court judgments on a classic issue in patent law, namely claim interpretation. As expected, there are no surprises in the major premises behind the judgments. However, the interested reader who focuses on the details of the arguments put forward by the Federal Court of Justice will find once again that patent interpretation according to German law is founded on very systematic basic concepts that need 'only' be applied anew in each particular case.

This year, a primary focus in (infringement) case law is on acts committed at least partly abroad. The German infringement courts are starting, cautiously but with a clear tendency, to widen the circle of those who are liable for patent infringement in Germany. The attitude of German courts can be summarised as follows: anyone who knows that his actions also have repercussions for the German market must also concern himself with German patent law.

The section on 'Other issues in substantive law' includes a novelty of our annual case law reviews: a (Federal Patent

Court) judgment on artificial intelligence and the question of who is or can be inventor in the case of inventions, in the making of which neural networks were involved. This question will certainly occupy our courts and us in the years ahead.

Following the landmark decisions of the Federal Court of Justice in 2020 with regard to FRAND, one might have hoped for consolidation of the established legal practice of the courts of instance. Unfortunately, however, there are still major differences in the interpretation of those decisions between the Munich and the Mannheim/Karlsruhe courts, on the one hand, and the Düsseldorf courts, on the other – especially as regards the parties' respective obligations in negotiations. A different situation prevails in respect of anti-anti-suit injunctions, where Düsseldorf has adopted the practices of the Munich courts (their substantive core at least).

May 2022

EISENFÜHR SPEISER



Bremen

Am Kaffee-Quartier 3
28217 Bremen
Tel. +49 421 3635-0
Fax +49 421 3378788
mail@eisenfuhr.com



Munich

Arnulfstraße 27
80335 Munich
Tel. +49 89 549075-0
Fax +49 89 55027555
mailmuc@eisenfuhr.com



Berlin

Stralauer Platz 34
10243 Berlin
Tel. +49 30 841887-0
Fax +49 30 841887-77
mailbln@eisenfuhr.com



Hamburg

Johannes-Brahms-Platz 1
20355 Hamburg
Tel. +49 40 309744-0
Fax +49 40 309744-44
mailham@eisenfuhr.com