FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

JUDGEMENT

X ZR 120/18

Issued:
December 15, 2020
Court Clerk other than the
Court Registrar

In the Patent Nullity Proceedings

Reference work: Yes

BGHZ [Federal Court of Justice in civil cases]: No

BGHR [Federal Court of Justice case law]: Yes

Messaging service

IntPatÜbkG [Act on International Patent Conventions], Art. 2, §6, Paragraph 1, No. 4

The scope of protection of a patent, whose granted version provides protection to a mobile wireless device in conjunction with a method that is carried out using a server, is not necessarily broadened because the patent claim in nullity proceedings is supplemented with a method step that is carried out on the server (Supplement to BGH [Federal Court of Justice], judgement dated December 20, 2018 - X ZR 56/17 GRUR [German Association for the Protection of Industrial Property and Copyright] 2019, 389 – Circuit arrangement III).

BGH, judgement dated December 15, 2020 - X ZR 120/18 - Federal Patent Court

ECLI:DE:BGH:2020:151220UXZR120.18.0

The X. Civil Division of the Federal Court of Justice, based on the oral proceedings held on October 27, 2020 under Presiding Judge Dr. Bacher, Judge Dr. Deichfuß, Judge Dr. Kober-Dehm, Judge Dr. Marx, and Judge Dr. Rensen,

has ruled as follows:

With regard to Defendant's appeal, the judgement of the 5th Division (Nullity Board) of the Federal Patent Court dated January 24, 2018 is modified, with dismissal of further right to appeal.

European Patent 2 177 072 is declared null and void in part, with dismissal of the case in other respects, in that claim 1 is worded in the following version to which claims 1 through 16 make direct or indirect back-reference, and claims 17 and 18 are deleted:

> A method for providing a messaging service on a sender’s mobile wireless device in a wireless communications network;
>
> the method comprising:
>
> the sender’s mobile wireless device (112) retrieving, a destination address associated with a recipient’s mobile wireless device (122), from an outgoing message on the sender’s mobile wireless device (112);
>
> the sender’s mobile wireless device verifying whether the destination address is capable of receiving the outgoing message via a packet-switched bearer,
>
> wherein the step of verifying the destination address involves sending an address verification request to a message server;

wherein the verification request is sent to the message server (170) via base station (180) and the Internet (160) using a WPAN or WLAN;

upon receiving the address verification request, the message server (170) checks whether the destination address is on a list of subscribing addresses, and checks whether the destination message queue length has not exceeded a predetermined maximum length;

in the event verification is affirmative, the sender's mobile wireless device then automatically sending the outgoing message to the recipient's mobile wireless device at the destination address via the packet-switched bearer;

but otherwise, the sender's mobile wireless device automatically sending the outgoing message to the recipient's mobile wireless device at the destination address via an SMS bearer.

Defendant shall bear nine-tenths, and Plaintiff shall bear one-tenth, of the costs of the legal proceedings.

By action of law

Statement of Facts:

1 Defendant is the proprietor of granted European Patent 2 177 072 (disputed patent), with effect in the Federal Republic of Germany, for which application was filed on July 18, 2008 with claim to Australian priorities dated July 24, 2007 and November 13, 2007, and relating to a messaging service in a wireless communications network. After restriction proceedings, claim 1, to which fifteen claims make back-reference, reads as follows:

> A method for providing a messaging service on a sender's mobile wireless device in a wireless communications network; the method comprising:
> the sender's mobile wireless device (112) retrieving, a destination address associated with a recipient's mobile wireless device (122), from an outgoing message on the sender's mobile wireless device (112);
> the sender's mobile wireless device verifying whether the destination address is capable of receiving the outgoing message via a packet-switched bearer,
> wherein the step of verifying the destination address involves sending an address verification request to a message server;
> wherein the verification request is sent to the message server (170) via base station (180) and the Internet (160) using a WPAN or WLAN;
> in the event verification is affirmative, the sender's mobile wireless device then automatically sending the outgoing message to the recipient's mobile wireless device at the destination address via the packet-switched bearer;
> but otherwise, the sender's mobile wireless device automatically sending the outgoing message to the recipient's mobile wireless device at the destination address via an SMS bearer.

2 Analogously, claims 17 and 18 provide protection for a mobile wireless device, and a computer program product with which such a method may be carried out.

3 Plaintiff has asserted that the subject matter of the disputed patent is not based on an inventive step. Defendant has defended the disputed patent in the current version, and alternatively in five revised versions.

4 The Patent Court declared the disputed patent null and void. Defendant has filed an appeal which pursues its first-instance petitions, with submittal of five further supplementary petitions. Plaintiff does not concur with the appeal.

Grounds for the decision:

5 The permissible appeal is justified in part.

6 The disputed patent relates to a messaging service in a wireless communications network.

7 In the disputed patent specification it is stated that although Short Messaging Service (SMS) is extremely popular, it has the drawback that a message cannot contain more than 160 characters. Furthermore, a message must pass through several messaging centers (Short Messaging Service Centres (SMSCs)) or SMSC gateways if the recipient's network is operated by a different provider or uses different wireless standards than the sender's network.

8 Enhanced Messaging Service (EMS), which uses SMS infrastructure, allows up to 255 SMS messages to be packaged as one EMS message having richer content such as animation, pictures, sounds, and formatted text.

9 Multimedia messages which may contain images, audio clips, and videos can be sent via Multimedia Messaging Service (MMS). MMS, unlike SMS and EMS, transmits messages via a packet-switched bearer. This allows transmission of messages of unlimited size, at higher speeds.

10 Mobile Instant Messaging (MIM) technology enables mobile wireless devices to engage in real-time, instant messaging via an IP data network. For this purpose, users must register either a user name (tag) or alias name (handle) with an instant messaging service

provider to be able to send and receive messages. Sometimes there is also a requirement to maintain a persistent connection with the Internet during a chat session.

11 2. The disputed patent specification does not state the technical object to which the invention relates.

12 In light of this background, the technical object may be regarded as providing a method that enables sending and receiving of messages, using different services which are as uncomplicated and economical as possible.

13 3. To achieve this object, the disputed patent in the current version of claim 1 proposes a method for providing a messaging service, the features of which may be subdivided as follows:

1.	Das Verfahren dient der Bereitstellung eines Nachrichtenübermittlungsdienstes auf einer Mobilfunkeinrichtung eines Senders in einem Funkkommunikationsnetzwerk und umfasst folgende Schritte:	A method for providing a messaging service on a sender's mobile wireless device in a wireless communications network; the method comprising:
2.	Die Mobilfunkeinrichtung (112) des Senders ruft eine mit der Mobilfunkeinrichtung (122) eines Empfängers assoziierte Zieladresse ab,	the sender's mobile wireless device (112) retrieving, a destination address associated with a recipient's mobile wireless device (122),
2.1	und zwar aus einer abgehenden Nachricht auf der Mobilfunkeinrichtung (112) des Senders.	from an outgoing message on the sender's mobile wireless device (112);

3.	Die Mobilfunkeinrichtung des Senders verifiziert, ob die Zieladresse die abgehende Nachricht über einen paketvermittelten Träger empfangen kann.	the sender's mobile wireless device verifying whether the destination address is capable of receiving the outgoing message via a packet-switched bearer,
3.1	Dieser Schritt beinhaltet, dass eine Adressverifikationsanforderung an den Nachrichtenserver (170) gesendet wird,	wherein the step of verifying the destination address involves sending an address verification request to the message server;
3.2	und zwar über eine Basisstation (180) und das Internet (160) unter Verwendung eines WPAN oder WLAN.	wherein the verification request is sent to the message server (170) via base station (180) and the Internet (160) using a WPAN or WLAN;
4.	Wird die Verifikation bestätigt, sendet die Mobilfunkeinrichtung des Senders die abgehende Nachricht automatisch über den paketvermittelten Träger an die Mobilfunkeinrichtung des Empfängers unter der Zieladresse.	in the event verification is affirmative, the sender's mobile wireless device then automatically sending the outgoing message to the recipient's mobile wireless device at the destination address via the packet-switched bearer;
5.	Wird die Verifikation nicht bestätigt, sendet die Mobilfunkeinrichtung des Senders die abgehende Nachricht automatisch über einen SMS-Träger an die Mobilfunkeinrichtung des Empfängers unter der Zieladresse.	but otherwise, the sender's mobile wireless device automatically sending the outgoing message to the recipient's mobile wireless device at the destination address via an SMS bearer.

14 4. The subject matter protected by claims 17 and 18 has comparable features, and is therefore subject to the same assessment as the subject matter of claim 1.

15 5. Some features require closer examination.

16 a. A significant advantage of the method is that a message may be sent via a packet-switched bearer or an SMS bearer, depending on the circumstances.

17 According to feature 2, the basis is formed by a destination address of an outgoing message that is associated with a recipient's mobile wireless device. According to feature 3, a query is made on a message server to check whether this destination address can also receive the message via a packet-switched bearer. If this is the case, the transmission takes place via a packet-switched bearer according to feature 4, and otherwise, via an SMS bearer according to feature 5.

18 b) The manner in which the destination address is associated with the recipient's mobile wireless device is left to the person skilled in the art.

19 According to the description in the disputed patent, this may involve a mobile phone number or a short numeric code which may represent a phone number, an email address, the user name (user handle) in an IM system, an IP address, or a combination of this information. The aim is to allow identification of all users with the aid of their mobile phone number, so that the user – unlike the situation with conventional MIM clients – does not have to register a user name (tag, handle) (paragraph 12).

20 c) The stipulation in feature 2.1, according to which the destination address is retrieved from an outgoing message on the sender's mobile wireless device, presupposes that a message intended for sending, which contains this address information, is already created.

21 aa) The type of structure of this message is not further specified in claim 1.

22 Contrary to the argumentation according to the appeal, the statements in the description, which describe the use of XML structures, do not result in any restrictions in this regard.

These statements merely describe one exemplary embodiment, and are not reflected in the claim.

23 The fact that the structure of the message is not yet completely established at the time that the destination address is retrieved also results from the description of the exemplary embodiment, the sequence of which is schematically illustrated in Figure 3 below.

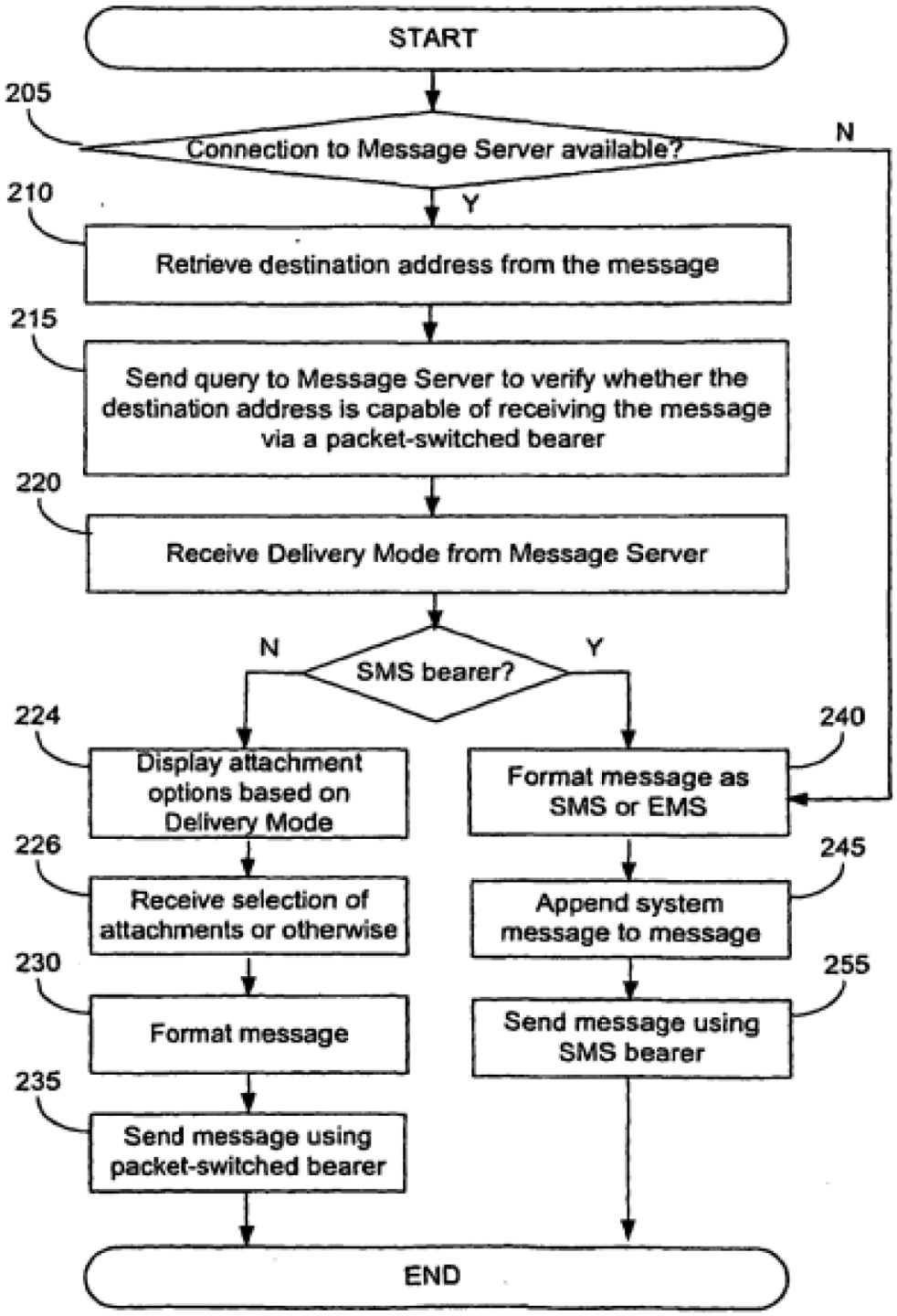
START
205
Connection to Message Server available?
N
Y
210
Retrieve destination address from the message
215
Send query to Message Server to verify whether the destination address is capable of receiving the message via a packet-switched bearer
220
Receive Delivery Mode from Message Server
N
SMS bearer?
Y
224
Display attachment options based on Delivery Mode
226
Receive selection of attachments or otherwise
230
Format message
235
Send message using packet-switched bearer
240
Format message as SMS or EMS
245
Append system message to message
255
Send message using SMS bearer
END

FIG. 3

24 After the system, in step 220, has obtained information from the message server concerning the possible transport path, the message is formatted for the particular bearer in step 230 or 240. When sending is performed via an SMS bearer, a system message is also appended in step 245 (paragraph 57). Both measures have effects on the structure of the message. As a result, at the time of sending, the message does not necessarily have to have the same structure as at the time when the destination address is retrieved.

25 bb) It also follows from the exemplary embodiment illustrated in Figure 3 that the content of the message also does not have to be established at the time the destination address is retrieved.

26 When sending is performed via a packet-switched bearer, prior to the formatting the user is provided with the option of adding attachments in step 224 (paragraph 57). Provision of this option is expressly afforded protection in claims 9 and 10. It may thus be inferred that changes in the content of the message prior to sending are still possible.

27 In light of this background, it cannot also be inferred from claim 1 that the message has to have a certain minimum content at the time the destination address is retrieved. In particular, in the exemplary embodiment illustrated in Figure 3, the user must input the text of the message before that time, while afterwards the user has only the option for adding attachments. However, claim 1 does not make this distinction, and in particular contains no specifications regarding the content of the message at this early time.

28 cc) Thus, it is sufficient for a basic structure to be present, which in a subsequent stage of the method can be supplemented to form a sendable message. With regard to the content of this basic structure, feature 2.1 results only in the minimum requirement that at least one piece of information must be present that allows the destination address to be queried.

29 d) In light of this background, features 4 and 5 also cannot be understood such that the sending operation is initiated immediately after the verification procedure is

completed.

30 However, the wording of the two features, which provide that the outgoing message is automatically sent via a packet-switched bearer or via an SMS bearer, depending on the result of the verification procedure, could indicate immediate sending without the possibility for change. However, this design would conflict with the statements in the description, which provides for modification of the message between the verification procedure and the sending operation.

31 In light of the description, features 4 and 5 are to be interpreted such that the term "automatically" refers only to establishing the bearer and using this bearer after the sending operation is initiated by the user.

32 e) The verification provided in feature 3, concerning whether the destination address can receive an outgoing message via a packet-switched bearer, may be limited to the question of whether the recipient of the message is even reachable at all via such a bearer. However, such a limitation is not mandatory.

33 aa) Claim 1 contains no specifications concerning the requirements that must be met so that the suitability of the destination address for receiving the message via a packet-switched bearer may be affirmed. Therefore, it is basically left to those skilled in the art as to which criteria they define.

34 bb) The general statements in the description section of the disputed patent, according to which the method may include the step of queuing the outgoing message for later delivery (paragraph 31), do not result in a narrower understanding of the claim.

35 Claim 1 does not address this feature, which is only optionally provided in the description. Accordingly, the subject matter of the patent is not limited to methods that can manage such a queue and that do not make sending via the packet-switched bearer dependent on the recipient being connected to the message server at the time.

36 cc) The exemplary embodiment explained in the description likewise does not result in a narrower understanding.

37 In this exemplary embodiment, the message server initially checks whether the destination address is listed in a subscriber directory. If this is the case, the server additionally checks whether the recipient's message queue has exceeded a certain length. If one of the two checks has a negative result, the message server provides the information that an SMS bearer must be used (paragraph 55ff.).

38 Although this configuration indicates that sending can also take place when the recipient is not connected to the message server, this requirement is not reflected in claim 1. The claim does not mandatorily provide a queue, and also contains no specifications regarding the question of which prerequisites must be met in order to regard sending via a packet-switched bearer as possible.

39 The understanding postulated by the appeal, that the capability for receiving the destination address must necessarily be affirmed, even if the recipient is temporarily not ready to receive because the lack of a connection to the message server, would also be in conflict with the described exemplary embodiment. In this exemplary embodiment, the abstract possibility of transmitting is specifically not regarded as a sufficient criterion; rather, based on the length of the queue it is additionally checked whether receipt of a message is likely in the foreseeable future. This confirms the understanding, already rendered obvious by the wording, that those skilled in the art basically remain free to set the criteria.

40 II. The Patent Court justified its decision essentially as follows:

41 For one skilled in the art, a degreed engineer in electrical engineering with a specialty in communications technology, who has practical experience in the design of messaging systems in the field of mobile wireless and Internet communication, and who is familiar

with the relevant standards, it was stated that the subject matter of claim 1 was rendered obvious by Korean Patent application 10 2006 0077401 (K4a) in conjunction with his/her technical knowledge. K4a discloses a method for instant messaging (IM), in which IM messaging that operates via the Internet and thus via packet-switching is combined with SMS messaging. A uniform interface is thus provided for sending messages via the IM service as well as via SMS, thus improving user-friendliness. The method according to the invention differs from this method solely in that the verification request takes place via WPAN or WLAN, and not via a packet-switched service. This does not form the basis for an inventive step, since at the time of priority, mobile wireless devices with a short-range wireless interface (WLAN/WPAN) were ready for series production and thus were also known to those skilled in the art. Cost considerations prompted those skilled in the art to transmit the verification request via WLAN or WPAN, since using the packet-switched service via the mobile wireless network was very costly at the time of priority. Contrary to Defendant's view, the user does not have to be registered only with the method of K4a to enable use of the method. Also in the method according to the disputed patent, the user has to be connected to a message server, which requires appropriate connection data. Only then can a verification request be sent to the message server and checked for whether a user is entered in a subscriber directory and thus registered. The fact that a mobile phone number is sufficient as an identifier in the method according to the invention does not mean that registration is not necessary. Rather, the user is registered with this phone number. The fact that for the method according to K4a, the receiving device must necessarily be online, while for the method according to the invention the basic suitability of the receiving device to receive a message via a packet-switched bearer is sufficient, results in no other assessment. This check is not part of the claimed method. Claim 1 also encompasses the case that the receiving device is online at the time of the verification query.

42 The feature additionally provided according to supplementary petition 1' in claim 1 in the current version, that after receipt of the verification request the message sender checks whether the destination address is on a subscriber list, results in an obvious manner from K4a for those skilled in the art in conjunction with their technical knowledge. The IM

server, which in the method according to K4a provides the instant messaging service, manages the status and the receive mode of the particular user, as well as the received message list and information concerning the surroundings of the subscribed users. In the sense of the feature that is added with supplementary petition 1', this corresponds to a subscriber address list, and renders obvious the check provided according to this feature.

43 The features additionally provided according to supplementary petition 2', with respect to the current version of claim 1, were likewise rendered obvious to those skilled in the art by K4a. Sending a packet-switched message using a Wi-Fi protocol represents a commonplace implementation variant for those skilled in the art. If those skilled in the art had already considered sending the verification query via WLAN for cost reasons, the obvious solution would be to also send the packet-switched message on the security layer via WLAN, and thus according to the Wi-Fi protocol.

44 The subject matter defended with supplementary petition 3' was rendered obvious to those skilled in the art by international application 01/414777 (K16). This citation discloses an instant messaging system that uses phone numbers as addresses. For those skilled in the art, in the method according to K4a it was therefore obvious to likewise use phone numbers as a destination address, especially since at the time of priority, providing a single phone number as an address for a plurality of services was part of the technical knowledge.

45 For the same reasons as for the versions defended with the main petition and supplementary petition 3', the subject matter defended with supplementary petition 4' was not based on an inventive step.

46 The defense of the disputed patent in the version of supplementary petition 5' was impermissible, since the subject matter of claim 1 in this version goes beyond the content of the documents originally filed. According to the feature added with this version of the petition, it was provided that after receipt of the verification request, the message server checks whether the queue of messages to the destination address has not exceeded a

predefined maximum length. However, unlike in the exemplary embodiments described in the original documents, claim 1 makes no mention of the consequences resulting from the added feature of checking the selection of the bearer to be used for transmitting the message, and the corresponding feedback to the sender's mobile wireless device.

47 III. This assessment is thus drawn from the examination in the appeal proceedings with regard to the current version of the disputed patent, and with regard to the versions defended with supplementary petitions 1', 2', 3', and 4', which Defendant resubmitted in the court of appeal as supplementary petitions 1, 2, 3, and 9 for the decision.

48 1. Whether the subject matter of claim 1 in the current version was rendered obvious to those skilled in the art by K4a remains an open question. In any case, it was rendered obvious to those skilled in the art by publication of the international patent application WO 2004/061583 (K5).

49 a) K5 relates to a method and a device for assisting with wireless communication (messaging).

50 The cited document deals with the problem of incompatibility of different messaging standards such as SMS and MMS (paragraph 2). K5 views it as particularly disadvantageous that the sender cannot determine incompatibility until after the message is sent (paragraph 4).

51 As a remedy, K5 proposes to query, prior to sending a message, which type of message format the recipient's device is capable of receiving (paragraph 23).

52 aa) Several exemplary embodiments are illustrated in Figure 2 of K5, shown below:

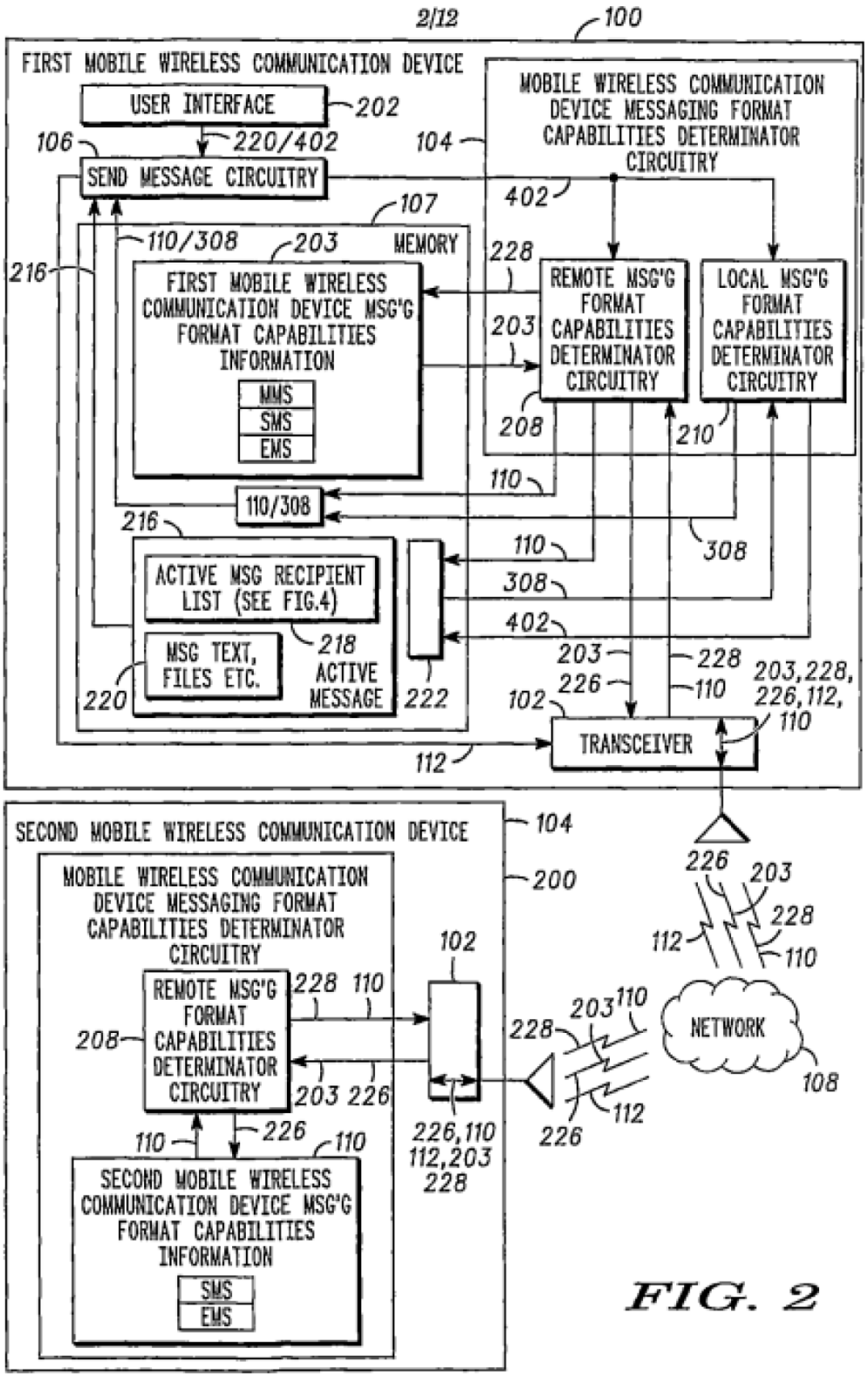
2/12
100
FIRST MOBILE WIRELESS COMMUNICATION DEVICE
USER INTERFACE
202
106
220/402
SEND MESSAGE CIRCUITRY
104
MOBILE WIRELESS COMMUNICATION DEVICE MESSAGING FORMAT CAPABILITIES DETERMINATOR CIRCUITRY
402
107
MEMORY
110/308
203
216
FIRST MOBILE WIRELESS COMMUNICATION DEVICE MSG'G FORMAT CAPABILITIES INFORMATION
MMS
SMS
EMS
228
REMOTE MSG'G FORMAT CAPABILITIES DETERMINATOR CIRCUITRY
LOCAL MSG'G FORMAT CAPABILITIES DETERMINATOR CIRCUITRY
203
208
210
110
110/308
216
308
ACTIVE MSG RECIPIENT LIST (SEE FIG.4)
218
MSG TEXT, FILES ETC.
ACTIVE MESSAGE
220
222
110
308
402
203
228
226
110
203,228, 226,112, 110
102
TRANSCEIVER
112
SECOND MOBILE WIRELESS COMMUNICATION DEVICE
104
200
MOBILE WIRELESS COMMUNICATION DEVICE MESSAGING FORMAT CAPABILITIES DETERMINATOR CIRCUITRY
102
REMOTE MSG'G FORMAT CAPABILITIES DETERMINATOR CIRCUITRY
228 110
208
203 226
110
226
110
SECOND MOBILE WIRELESS COMMUNICATION DEVICE MSG'G FORMAT CAPABILITIES INFORMATION
SMS
EMS
226,110 112,203 228
226
203
228
110
112
NETWORK
108

FIG. 2

53 bb) The mobile wireless device (100) proposed in K5 communicates with the network (108) by means of a specialized circuit (104) in order to query information concerning which messaging formats the recipient's mobile wireless device is able to process. This information is stored in the mobile wireless device (100) and associated with the recipient's device (paragraph 25).

54 However, the information concerning which messaging formats are supported by the recipient's mobile wireless device does not have to be stored (only) in the recipient's mobile wireless device. In one alternative embodiment of K5, the information concerning messaging formats that are supported by the recipient's device may also be stored in an address book associated with the sender's mobile wireless device (paragraph 64). In a further embodiment in K5, such information may also be stored at some other location via capacity in the recipient's device, for example in a network apparatus such as a web server, or some other server in which information concerning the supported messaging formats for various devices may be stored (paragraph 39).

55 cc) The message is sent in a supported format via a circuit (106) (paragraph 25).

56 In one of the embodiments disclosed in K5, the user may decide, based on the message formats supported by the recipient's mobile wireless device, whether the user still wants to send the message at all. Thus, the user can terminate the transmission if it is determined that the recipient's device does not support the message format selected by the sender (paragraphs 26 and 33).

57 In an alternative embodiment, while the sender is inputting the current message, the sender's mobile wireless device contacts the network to establish a connection to the recipient's address (MSISDN, for example) and the recipient's Home Location Register (HLR) and determine whether the address is capable of receiving a message in the MMS format. If this is the case, the appropriately formatted message is transmitted to the recipient's mobile wireless device. On the other hand, if the MMS format is not supported by the recipient's mobile wireless device, the mobile wireless device informs

the sender and recommends formatting and sending the message as an SMS message, pointing out that attached multimedia files will be lost. The user can then decide whether to send the message via SMS or MMS or to terminate the sending operation (paragraphs 61-62).

58 b) Thus, as also not called into question in the appeal, features 1, 2, 2.1, 3, and 3.1 are disclosed.

59 c) Contrary to the argumentation according to the appeal, feature 4 is also disclosed.

60 If the recipient's mobile wireless device supports a messaging format that is supported by the sender's mobile wireless device, the message is sent in this format. If the format supported by the two devices is a packet-switched bearer, the message is accordingly also sent via such (paragraphs 25 and 61).

61 d) However, feature 3.2 is not disclosed, which is also not called into question by Plaintiff.

62 e) Contrary to Plaintiff's view, feature 5 is likewise not disclosed.

63 In the event that the recipient's mobile wireless device is not capable of receiving messages via a packet-switched bearer (MMS messages in the described exemplary embodiment), the method according to K5 does not automatically specify that the message is sent via an SMS bearer; rather, the sender is offered a choice between transmitting as an SMS message or an MMS message, or terminating the transmission operation (paragraphs 26 and 62).

64 f) The subject matter of claim 1 was rendered obvious to those skilled in the art, proceeding from K5.

65 aa) Those skilled in the art, proceeding from K5, would have had reason to make the

check, concerning whether the destination address could receive messages via a packet-switched bearer, selectively via WPAN or WLAN.

66 K5 relates to devices that are governed by different standards. This rendered it obvious to those skilled in the art to consider the approach of K5 also for devices which inherently have not only mobile wireless functions, but also WPAN or WLAN functions. For such devices, it was logical to use WPAN or WLAN, which is generally less costly, for the packet-switched communication, provided that the device in question can handle this, and an appropriate network is likewise available.

67 The objection according to the appeal, that technical difficulties and aspects of system security would have discouraged those skilled in the art from sending the address verification request using a WPAN or WLAN, since mobile wireless network operators safeguarded their networks from outside third-party attacks, and special authorization was necessary for the mobile wireless network to be accessed from the WPAN or WLAN, is flawed. Contrary to the argumentation according to the appeal, for the system disclosed in K5 an address verification request in the sense of feature 3.1 is not considered just in the form of a query to the Home Location Register (HLR) of the mobile wireless network. As discussed above, according to the description in K5 the necessary information may also be stored on a web server (paragraph 39). At least in this variant, the technical difficulties and security concerns pointed out by the appeal did not stand in the way of a verification request via WPAN or WLAN.

68 bb) Whether the user was given the opportunity to terminate the sending operation when it turned out that sending could take place only on the SMS bearer is a question of the suitable configuration in the individual case. Thus, K5 provides that the proposed method in the individual described exemplary embodiments may be selectively designed either with or without user prompts (paragraph 55). In light of this background, a design of the method for which the selection between an SMS bearer and a packet-switched bearer automatically takes place, depending on the presence of the respective necessary prerequisites, cannot result in the affirmation of inventive step.

69 2. The disputed patent also proves to be legally invalid in the versions of supplementary petitions 1 through 9

70 a) The subject matter of claim 1 according to supplementary petition 1 (in the first instance: supplementary petition 1') is not based on an inventive step.

71 aa) According to supplementary petition 1, claims 17 and 18 are to be deleted. The following additional feature is provided In claim 1:

3.3	Der Nachrichtenserver (170) prüft nach Erhalt der Verifikationsanforderung, ob die Zieladresse auf einer Teilnehmerliste steht.	Upon receiving the address verification request, the message server (170) checks whether the destination address is on a list of subscribing addresses.

72 bb) It is immaterial whether the subject matter thus defended and disclosed in the originally filed documents is part of the invention. In any case, it was rendered obvious to those skilled in the art by K5. In the above-mentioned exemplary embodiment, the method proposed in K5 likewise provides for checking the accessibility of a subscriber based on a subscriber list (paragraphs 33, 39).

73 b) The subject matter of claim 1 defended with supplementary petition 2 (in the first instance: supplementary petition 2') is likewise not based on an inventive step.

74 aa) According to supplementary petition 2, the following additional features are provided with respect to the version according to the main petition, with claim 17 making back-reference to the amended version of claim 1, and claim 18 being correspondingly adapted:

3.3	Die Verifikationsanforderung schließt die Verifikation ein, dass die Zieladresse auf einer Teilnehmerliste steht.	The verification request involves verifying whether the destination address is on a subscriber list.
4.1	Ein WiFi-Protokoll wird zur drahtlosen Kommunikation auf der Sicherungsschicht verwendet, um die abgehende Nachricht von der Mobilfunkeinrichtung des Senders (112) an das drahtlose Kommunikationsnetzwerk zu übermitteln.	A WiFi wireless protocol is used in a data link layer to deliver the outgoing message from the sender's mobile wireless device (112) to the wireless communications network.

75 bb) Feature 3.3 corresponds to the matter according to feature 3.3 in accordance with supplementary petition 1, and is not assessed differently.

76 cc) Feature 4.1, also in combination with this feature, cannot form the basis for patentability.

77 As the Patent Court correctly stated, sending a message using a Wi-Fi protocol was an obvious measure for those skilled in the art. If Wi-Fi, i.e., a WLAN network, is available, it is obvious to send not only the verification query, but also the message itself via same.

78 Contrary to the argumentation according to the appeal, at the time of priority there were no obstacles to transmitting MMS via a WLAN that would have discouraged those skilled in the art from such an approach. The difficulties, stated by the appeal, of determining the IP address of a recipient's device in the WLAN are therefore irrelevant because feature 4.1, as correctly stated by Plaintiff, relates only to sending the message from the sender to the wireless communications network, but not to receiving the message.

79 c) The subject matter of claim 1 defended with supplementary petition 3 (in the first instance: supplementary petition 3') is likewise not patentable.

80 aa) According to supplementary petition 3, the following additional features are

provided with respect to the version according to the main petition, with claim 17 making back-reference to the amended version of claim 1, and claim 18 being correspondingly adapted:

2.2	Die Zieladresse ist eine Mobiltelefonnummer.	The destination address is a mobile phone number.
4.1	Ein WiFi-Protokoll wird zur drahtlosen Kommunikation auf der Sicherungsschicht verwendet, um die abgehende Nachricht von der Mobilfunkeinrichtung des Senders (112) an das drahtlose Kommunikationsnetzwerk zu übermitteln.	A WiFi wireless protocol is used in a data link layer to deliver the outgoing message from the sender's mobile wireless device (112) to the wireless communications network.
5.1	Die abgehende Nachricht wird zu einem Kernnetzwerk (140) gesendet.	The outgoing message is sent to a core network (140).

81 bb) Use of a mobile phone number as a destination address, provided according to newly added feature 2.2, was rendered obvious to those skilled in the art by K16, as correctly found by the Patent Court.

82 This citation discloses an instant messaging system and a method for transmitting instant messages, which allow a sender to send an instant message to a recipient when the sender knows only the recipient's mobile phone number, but not the recipient's instant messaging address.

83 cc) With regard to feature 4.1, the same applies as for supplementary petition 2, which likewise provides this feature.

84 dd) According to the determinations by the Patent Court which were not challenged, due to the system an SMS message is always sent to the core network according to the GSM standard. These determinations support the conclusions, drawn by the Patent Court, that feature 5.1 is self-evident to those skilled in the art.

85 d) Supplementary petitions 4 through 8, submitted for the first time in the appeal proceedings, in accordance with §116, Paragraph 2 and §117, Clause 1, PatG [German Patent Act] and §531 and Paragraph 2, ZPO [German Code of Civil Procedure], are not to be considered because they are irrelevant and have not been consented to by Plaintiff.

86 However, the Patent Court has already communicated, in the note provided according to §83, Paragraph 1, PatG, that the subject matter of claims 1, 17, and 18 cannot be based on inventive step in light of K4a, but also proceeding from K5. Defendant therefore had cause to submit these supplementary petitions, which serve to make further delimitation from the referenced citations, even in the first instance proceedings (see BGH, judgement dated December 15, 2015 - X ZR 111/13, GRUR 2016, 365 margin note 26 - Telecommunications connection).

87 e) The subject matter of claim 1 defended with supplementary petition 9 (in the first instance: supplementary petition 4') is likewise not based on an inventive step.

88 aa) According to supplementary petition 9, claims 17 and 18 are to be deleted. The following additional features are provided in claim 1 with respect to the version according to the main petition:

1.1	Die Mobilfunkeinrichtung des Senders ist verbunden mit	the sender's mobile wireless device being connected to
1.1.1	dem Kernnetzwerk (140) und	a core network (140) and

1.1.2	einem zweiten Netzwerk, das von einem unabhängigen Internet-Service-Provider bereitgestellt wird, das dem Mobilfunkgerät des Senders erlaubt, über WLAN oder WPAN auf das Internet (160) zuzugreifen.	a second network provided by an independent mobile Internet service provider allowing the sender's mobile wireless device to access the Internet (160) using a WPAN or WLAN.
2.2	Die Zieladresse ist eine Mobiltelefonnummer.	The destination address is a mobile phone number.

89 In addition, the following revisions are provided:

90 Feature 3.1 is to be supplemented in such a way that the address verification request is sent to the message server over the second network.

91 In feature 3.2, the words "base station" are to be inserted before the words "the wireless Internet."

92 Feature 4 is to be supplemented in such a way that the outgoing message is sent by the message server over the second network via WLAN or WPAN.

93 Lastly, feature 5 is to be supplemented in such a way that the outgoing message is sent over the core network 140 to the recipient's mobile wireless device.

94 bb) With regard to feature 2.2 and the supplementation of feature 5, the statements concerning supplementary petition 3 correspondingly apply.

95 cc) The remaining newly added or supplemented features relate to transmitting the verification query and the outgoing message via WLAN or WPAN. In this regard, the statements concerning the current version and supplementary petition 2 correspondingly apply.

96 IV. However, contrary to the view of the Patent Court, the disputed patent is upheld in the version of supplementary petition 10 (in the first instance: supplementary petition 5').

97 1. According to supplementary petition 10, claims 17 and 18 are to be deleted. The following additional feature is provided in claim 1 with respect to the version according to supplementary petition 1:

3.4	Der Nachrichtenserver (170) prüft nach Erhalt der Verifikationsanforderung, ob die Warteschlange der Nachrichten an der Zieladresse eine vorher festgelegte maximale Länge nicht überschritten hat.	upon receiving the address verification request, the message server (170) checks whether the destination message queue length has not exceeded a predetermined maximum length.

98 2. Contrary to the view of the Patent Court, the subject matter thus defended is sufficiently disclosed in the originally filed documents.

99 It is irrelevant whether a necessary correlation between the result of the two checks provided in features 3.3 and 3.4 and the automatic selection of a bearer is to be inferred from the patent application.

100 Contrary to the view of the Patent Court, such a correlation also results from the version of the claim defended with supplementary petition 10, and in any case from the interplay between the two stated features with features 4 and 5, which expressly provide for automatic selection of a bearer. A confirmed verification within the meaning of feature 4 is present only when both checks provided in features 3.3 and 3.4 have shown a positive result.

101 3. Supplementary petition 10, contrary to the view of Plaintiff, also is not directed to a broadening of the scope of protection.

102 a) According to Division case law, the subsequent incorporation of subject matter, not

protected by the disputed patent in the granted version, into a claim results in broadening of the scope of protection.

103 Although the patent nullity proceedings opened up the possibility for the patent proprietor to defend the protective right in a restricted version, this does not additionally apply to the structure of the patent. Therefore, a claim in the nullity proceedings cannot be modified in such a way that it incorporates subject matter not included by the granted version (BGH, judgement dated December 20, 2018 – X ZR 56/17, GRUR 2019, 389 margin note 33 – Circuit arrangement III; judgement dated September 14, 2004 – X ZR 149/01, GRUR 2005, 145, 146 – Electronic module).

104 b) In this matter, the insertion of feature 3.4 does not result in the claim being directed to subject matter not included by the current version.

105 Contrary to the view of Plaintiff, the subject matter of claim 1, even in the current version, is not limited to a method that is carried out solely on the mobile wireless device. Rather, claim 1, even in the current version, presupposes that a message server is present which responds to a verification query.

106 Although the current version contains no information concerning which criteria must be met in order for the message server to respond to the request in the affirmative, in this matter the determination of such criteria is tantamount to specification of the request that is directed to the server. In the matter at hand, as a result of insertion of feature 3.4 the server is no longer asked for information concerning whether the indicated recipient is even available on a certain communication path, but, rather, is asked for information concerning whether the recipient is likely to be available without complications. In comparison to the subject matter of the current version, this is merely a specification of the method which the mobile wireless device carries out in cooperation with the server.

107 4. Feature 3.4, newly added to supplementary petition 10, is not rendered obvious to those skilled in the art by any of the citations referenced in the proceedings.

108 a) In particular, contrary to the view of Plaintiff, for those skilled in the art there was no incentive from Technical Specification 3G TS 22.140, Version 0.1.0 (K21) to make the bearer selection dependent on exceedance of a certain length of the message queue on the recipient side.

109 In K21 it is merely stated that messages are queued when the recipient's mobile wireless device cannot be accessed from the network, and that a controlled delivery mechanism is necessary as soon as accessibility is once again available (Section 5.2, page 8 under "Message queuing"). This provides no incentive to make the selection of the bearer used for sending a message dependent on the length of the queue.

110 b) Plaintiff's argument (not described here in greater detail), contested by Defendant, that measuring the length of the queue was already a commonplace, obvious procedure in the prior art for checking the availability of the recipient, does not result in a different assessment.

111 Plaintiff has not submitted citations or shown any other specific circumstances demonstrating that this procedure was commonplace or obvious. Patentability cannot be denied on this basis.

112 V. The cost determination is based on §121, Paragraph 2, PatG in conjunction with §92, Paragraph 1, ZPO.

Bacher Deichfuß Kober-Dehm

Marx Rensen

Previous instance:
Federal Patent Court, decision dated January 24, 2018 - 5 Ni 22/16 (EP) –

Certification of Accuracy

I, Michael L. Magee, hereby attest that I am a translator fluent in English and German, that I have translated the attached documents from German to English, and that to the best of my knowledge, ability and belief these translations are true, accurate and complete translations of the original German documents that were provided to me.

The documents are designated as:

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Michael L. Magee
Signature of Translator

November 20, 2025
Date