Reference book: Yes

BGHZ: no

BGHR: Yes

Messaging service

IntPatÜbkG Art. 2 Sec. 6 (1) No. 4

The scope of protection of a patent, the granted version of which protects a process carried out on a mobile device in cooperation with a server, is not necessarily extended merely because the patent claim is supplemented in the revocation proceedings by a process step carried out on the server (supplement to BGH, judgment of December 20, 2018 - X ZR 56/17, GRUR 2019, 389 - Schaltungsanordnung III).

BGH, Judgment of December 15, 2020 - X ZR 120/18 - Federal Patent Court

FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE
JUDGEMENT

X ZR 120/18

Announced on:
December 15, 2020
Other judicial clerk
as clerk of the court
office

in the patent invalidity case

Rembrandt Messaging Technologies, LP, represented by General Partner Rembrandt Virginia Management, LLC, represented by Rembrandt IP Management, LLC, 401 City Avenue, Suite 900, Bala Cynwyd, Pennsylvania (United States of America), represented by the President, 1655 North Fort Myer Drive, Suite 700, Arlington, Virginia (United States of America),

Defendant and Appellant,

- attorney of record: Lawyer Dr. Hall, Karlsruhe;
  participating: Bosch Jehle Patentanwaltsgesellschaft mbH, Flüggenstraße 13, Munich -

against

Apple Retail Germany GmbH, represented by the Managing Directors, Eschenheimer Anlage 1, Frankfurt,

Plaintiff and appellee

- Legal representatives: Lawyers Prof. Dr. Rohnke and Dr. Winter, Karlsruhe;
  participating: Samson & Partner Patentanwälte mbß, Widenmayerstraße 6, Munich; Attorneys at Law Freshfields Bruckhaus Deringer LLP, Feldmühleplatz 1, Düsseldorf -

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

The X. Civil Senate of the Federal Court of Justice, at the oral hearing on October 27, 2020, by the Presiding Judge Dr. Bacher, the Judge Dr. Deichfuß, the Judges Dr. Kober-Dehm and Dr. Marx, and the Judge Dr. Rensen

found to be right:

On appeal by the defendant, the judgment of the 5th Senate (Cancellation Senate) of the Federal Patent Court of January 24, 2018, is amended and the further appeal is dismissed.

European patent 2 177 072 is declared partially invalid with the remainder of the action being dismissed in that patent claim 1 is replaced by the following version, to which claims 1 to 16 refer back directly or indirectly, and claims 17 and 18 are omitted:

A method for providing a messaging service on a sender's mobile wireless device in a wireless communications net work;

the method comprising:

the sender's mobile wireless device (112) retrieving, a destination address associated with a recipient's mobile wire less 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.

The defendant shall bear nine-tenths and the plaintiff one-tenth of the costs of the proceedings.

By law

Facts:

1 The defendant is the owner of the European patent 2 177 072 (patent in suit) granted with effect for the Federal Republic of Germany and registered on July 18, 2008, claiming Australian priorities of July 24, 2007, and November 13, 2007, and relating to a messaging service in a wireless communications network. Patent claim 1, to which fifteen claims refer back, reads as follows after a limitation procedure:

> 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 asso ciated 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 sta tion (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 out going message to the recipient's mobile wireless device at the destination ad dress via an SMS bearer.

2 Claims 17 and 18 protect, mutatis mutandis, a mobile radio device and a computer program product by which such a method can be carried out.

3 The plaintiff claimed that the subject matter of the patent in suit was not based on inventive step. The defendant defended the patent in suit as amended and, in the alternative, in five amended versions.

4 The patent court declared the patent in suit invalid. The defendant has appealed against this decision, pursuing its first-instance claims and filing five further auxiliary claims. The plaintiff opposes the appeal.

Reasons for Decision:

5 The admissible appeal is partially well-founded.

6 I. The patent in suit concerns a messaging service in a wireless communications network.

7 1) The patent in suit states that the Short Messaging Service (SMS) is very popular, but has the shortcoming that a message may not contain more than 160 characters. Furthermore, a message must pass through several Short Messaging Service Centers (SMSC) or SMSC gateways if the recipient's network is operated by a different provider or uses different radio standards than the sender's network.

8 The Enhanced Messaging Service (EMS), which uses the SMS infrastructure, makes it possible to bundle up to 255 SMS messages into one EMS message, the content of which can be enriched with animations, images, sounds and formatted text.

9 Multimedia Messaging Service (MMS) could be used to send multimedia messages that could include pictures, audio clips, and videos. Unlike SMS and EMS, the MMS transmits messages via a packet-switched carrier. This would allow messages to be transmitted in unlimited sizes and at higher speeds.

10 With mobile instant messaging (MIM) technology, cellular facilities could engage in real-time Instant Messaging over an IP data network

switch on. To do this, users must register with a constant messaging service provider either with a user name (tag) or with an alias name (handle) in order to be able to send and receive messages. In some cases, it is also required that the connection to the Internet is maintained at all times during a chat session.

11 2 The patent in suit does not specify which technical problem the invention relates to.

12 Against the background shown, the technical problem can be seen in providing a procedure that enables messages to be sent and received as straightforwardly and inexpensively as possible using different services.

13 To solve this problem, the patent in suit, as amended by claim 1, proposes a method for providing a messaging service, the features of which can be divided 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 objects protected by claims 17 and 18 have comparable features and are therefore subject to the same assessment as the subject-matter of claim 1.

15 5. Some features require further consideration.

16 a) A major advantage of the method is that a message can be sent via a packet-switched or an SMS carrier, depending on the circumstances.

17 According to feature 2, the basis is a destination address of an outgoing message that is associated with a mobile radio device of the recipient. 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 carrier. If this is the case, the transmission is packet-switched according to feature 4, otherwise via an SMS carrier according to feature 5.

18 b) The way in which the destination address is associated with the mobile radio device of the receiver is left to the person skilled in the art.

19 According to the description of the patent in suit, it can be a mobile phone number or a short numeric code that can stand for a phone number, an email address, the user name (user handle) in an IM system, an IP address, or a combination of these. This should make it possible to identify all users by their mobile phone number, so that - unlike with conventional MIM clients - the user does not have to register with a user name (user name, tag, handle) (para. 12).

20 c) The specification in feature 2.1 that the destination address is retrieved from an outgoing message on the sender's mobile radio equipment presupposes that a message intended for transmission containing this address information has already been created.

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

22 Contrary to the opinion of the appeal, the explanations in the description, which describe the use of XML structures, do not result in any restrictions in this respect. These statements merely describe an example of an embodiment and are not reflected in the patent claim.

23 The fact that the structure of the message has not yet been finally determined at the time the destination address is called up is also clear from the description of the embodiment example, the sequence of which is shown schematically in Figure 3 reproduced below.

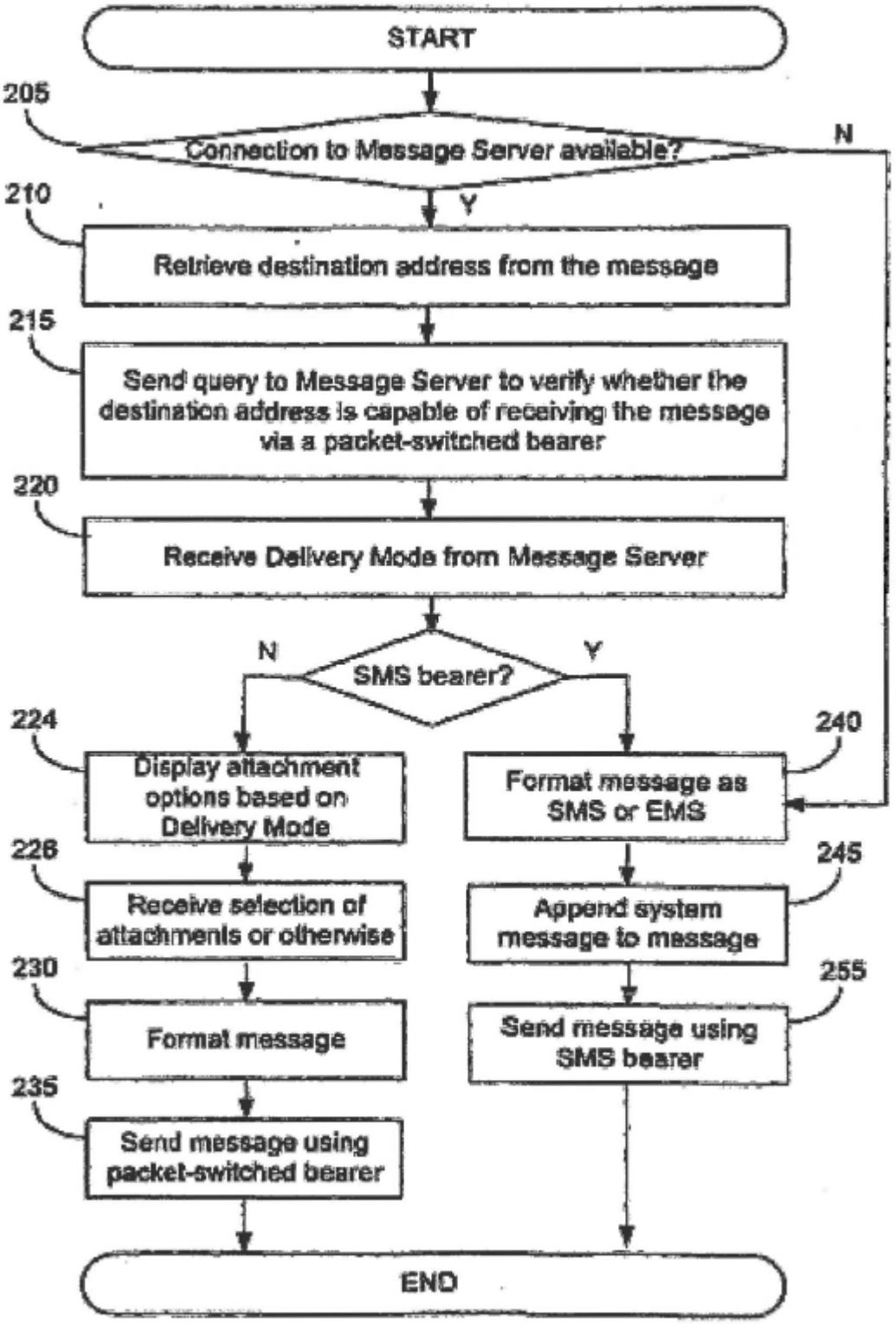
START
205
Connection to Message Server available?
N
Y
210
Retrieve destination address from the message
215
Send query to Message Server to verify whether the destination address is capable of receiving the message via a packet-switched bearer
220
Receive Delivery Mode from Message Server
N
SMS bearer?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

FIG. 3

24 After the system has received information about the possible dispatch route from the message server in step 220, the message is formatted for the respective carrier in steps 230 or 240. When sending via an SMS carrier, a system message is still added in step 245 (par. 57). Both actions have an effect on the structure of the message. This means that the message does not necessarily have the same structure at the time it is sent as it does when the destination address is retrieved.

25 bb) The example shown in Figure 3 also shows that the content of the message does not have to be known at the time the destination address is called up.

26 When sending via a packet-switched carrier, the user is given the option to add attachments prior to formatting in step 224 (par. 57). Providing this option is explicitly protected in patent claims 9 and 10. From this it can be seen that changes to the content of the message remain possible before it is sent.

27 Against this background, it can also not be inferred from patent claim 1 that the message at the time of the retrieval of the destination address already has a

must have a certain minimum content. It is true that in the example shown in Figure 3 the user must enter the text of the message before this point in time, while after this point in time he only has the option of adding attachments. Patent claim 1, however, does not take up this distinction, but contains just no specifications with regard to the content of the message at this early point in time.

28 cc) It can be concluded from this that it is sufficient if a basic structure exists which can be supplemented at a later stage of the procedure to form a message ready for dispatch. With regard to the content of this basic structure, feature 2.1 merely imposes the minimum requirement that at least one item of information must be present which enables the destination address to be queried.

29 d) Against the background shown, features 4 and 5 cannot be understood to mean that the transmission process is triggered immediately after completion of the verification process.

30 However, the wording of the two features, which stipulate that the outgoing message is automatically sent via a packet-switched or SMS carrier depending on the result of the verification process, could speak in favor of immediate sending without the possibility of modification. However, this interpretation would contradict the description, which provides for modification of the message between the verification process and dispatch.

31 In light of the description, features 4 and 5 are to be interpreted as meaning that the term "automatic" refers only to the determination of the carrier and the use of that carrier after the user initiates the transmission process.

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

33 aa) Patent claim 1 does not contain any specifications regarding the requirements that must be fulfilled in order to affirm the suitability of the destination address for receiving the message via a packet-switched carrier. Therefore, it is basically left to the person skilled in the art which criteria he defines in this respect.

34 bb) From the general statements in the description of the patent in suit, according to which the method may include the step of queuing the outgoing message for later delivery (para. 31), no narrower understanding of the patent claim results.

35 Patent claim 1 does not take up this feature, which is only optionally provided in the description. Accordingly, the subject matter of the patent is not limited to methods that can serve such a queue and do not make sending via the packet-switched carrier dependent on the recipient being currently connected to the message server.

36 cc) The example of an embodiment described in the description also does not give rise to a narrower understanding.

37 In this embodiment, the message server first 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 is negative, the message server informs that an SMS carrier must be used (par. 55 f.).

38 This embodiment does indicate that a transmission can take place even if the recipient is not connected to the message server. However, this requirement is also not reflected in patent claim 1. The claim does not provide for a queue and also does not contain any requirements regarding the question under which conditions a transmission via a packet-switched carrier should be considered possible.

39 The understanding postulated by the appeal that the ability to receive the destination address must also be affirmed if the recipient is temporarily not ready to receive due to a lack of connection to the message server would also contradict the example described. In this case, the abstract possibility of transmission is not regarded as a sufficient criterion, but rather the length of the queue is used to additionally check whether a message can be expected to be received in the foreseeable future. This confirms the understanding already suggested by the wording that the person skilled in the art is basically free to determine the criteria.

40 II. The patent court gave the following main reasons for its decision:

41 The subject matter of patent claim 1 as amended was suggested to the skilled person, a graduate engineer in electrical engineering specializing in communications engineering, who had practical experience in the design of messaging systems in the field of mobile and Internet communications and was familiar with the relevant standards, by Korean patent application 10 2006 0077401 (K4a) in conjunction with his skilled knowledge. K4a discloses an instant messaging (IM) method that combines an IM message transmission operating over the Internet, and thus packet-switched, with an SMS message transmission. This would provide a uniform interface for sending messages via both the IM service and the SMS, thus improving usability. The only difference between the method according to the invention and this method is that the verification request is made via WPAN or WLAN and not via a packet-switched service. This did not constitute an inventive step, since at the time of priority mobile radio devices with short-range radio interface (WLAN/WPAN) were ready for series production and thus known to the skilled person. For cost reasons, there was a reason for the skilled person to transmit the verification request via WLAN or WPAN, since the use of the packet-switched service via the mobile network was very expensive at the time of priority. Contrary to the defendant's view, the user did not have to be registered with a service only in the K4a method in order to use the method. Also with the method according to the patent in suit, the user has to connect to a message server, for which he needs corresponding connection data. Only then could a verification request be sent to the message server and it be checked whether a user was entered in a subscriber directory and thus registered. The fact that a cell phone number is sufficient as an identifier in the method according to the invention does not mean that registration is not required. Rather, the user is registered with this telephone number. The fact that in the method according to K4a the receiving device must necessarily be online, whereas in the method according to the invention the basic suitability of the receiving device to receive a message via a packet-switched carrier is sufficient, does not lead to a different assessment. This test is not part of the claimed method. Claim 1 also covers the case that the receiving device is online at the time of the verification query.

42 The additional feature provided according to auxiliary claim 1' in patent claim 1 as amended, that the message sender checks whether the destination address is on a subscriber list after receipt of the verification request, would result in an obvious way for the skilled person from K4a in connection with his expert knowledge. The IM server providing the Instant Messaging service in the method according to K4a manages the status and the reception mode of the respective user as well as the message reception list and the environment information of the subscribed users. This corresponds to a subscriber address list within the meaning of the feature added by auxiliary request 1' and suggests the verification provided for by this feature.

43 The additional features provided according to auxiliary request 2' compared to the valid version of patent claim 1 are also suggested to the skilled person by K4a. Sending a packet-switched message using a WiFi protocol is an everyday implementation option for the person skilled in the art. If he had already considered sending the verification request via WLAN for cost reasons, it would be obvious to him to also send the packet-switched message via WLAN and thus in accordance with the WiFi protocol on the data link layer.

44 The subject matter defended by auxiliary request 3' was suggested to the skilled person by the international application 01/414777 (K16). This citation disclosed a constant messaging system which used telephone numbers as addresses. Therefore, it had been obvious for the skilled person to also use telephone numbers as destination addresses in the method according to K4a, to which it had been part of the prior art at the time of priority to provide a single telephone number as an address for a plurality of services.

45 The subject matter defended by auxiliary request 4' was not based on inventive step for the same reasons as the versions defended by the main request and auxiliary request 3'.

46 The defense of the patent in suit in the version of auxiliary request 5' was inadmissible, since the subject-matter of patent claim 1 in this version went beyond the content of the originally filed documents. According to the feature added by this version of the application, the message server checks after receipt

of the verification request whether the queue of messages at the destination address has not exceeded a predetermined maximum length. However, in contrast to the embodiments described in the original documents, patent claim 1 does not contain any provision on the consequences of the check to be carried out according to the added feature with regard to the selection of the carrier to be used for the transmission of the message and the corresponding feedback to the transmitting mobile radio device.

47 III. This assessment withstands review on appeal with regard to the current version of the patent in suit and with regard to the versions defended by auxiliary requests 1', 2', 3' and 4', which the defendant again submitted for decision on appeal as auxiliary requests 1, 2, 3 and 9.

48 (1) Whether the subject-matter of patent claim 1 in the current version was suggested to the skilled person by K4a can be left open. In any case, it is suggested to the skilled person by the publication of the international patent application WO 2004/061583 (K5).

49 (a) K5 relates to a method and apparatus for supporting wireless communication (messaging).

50 The citation addresses the problem of incompatibility of different transmission standards such as SMS and MMS (par. 2). K5 sees the fact that the sender can only determine the incompatibility after the message has been sent as particularly disadvantageous (para. 4).

51 To remedy this, K5 suggests querying what type of message format the recipient device is capable of receiving before sending a message (par. 23).

52 aa) !n the figure 2 of K5 reproduced below, several embodiments are shown:

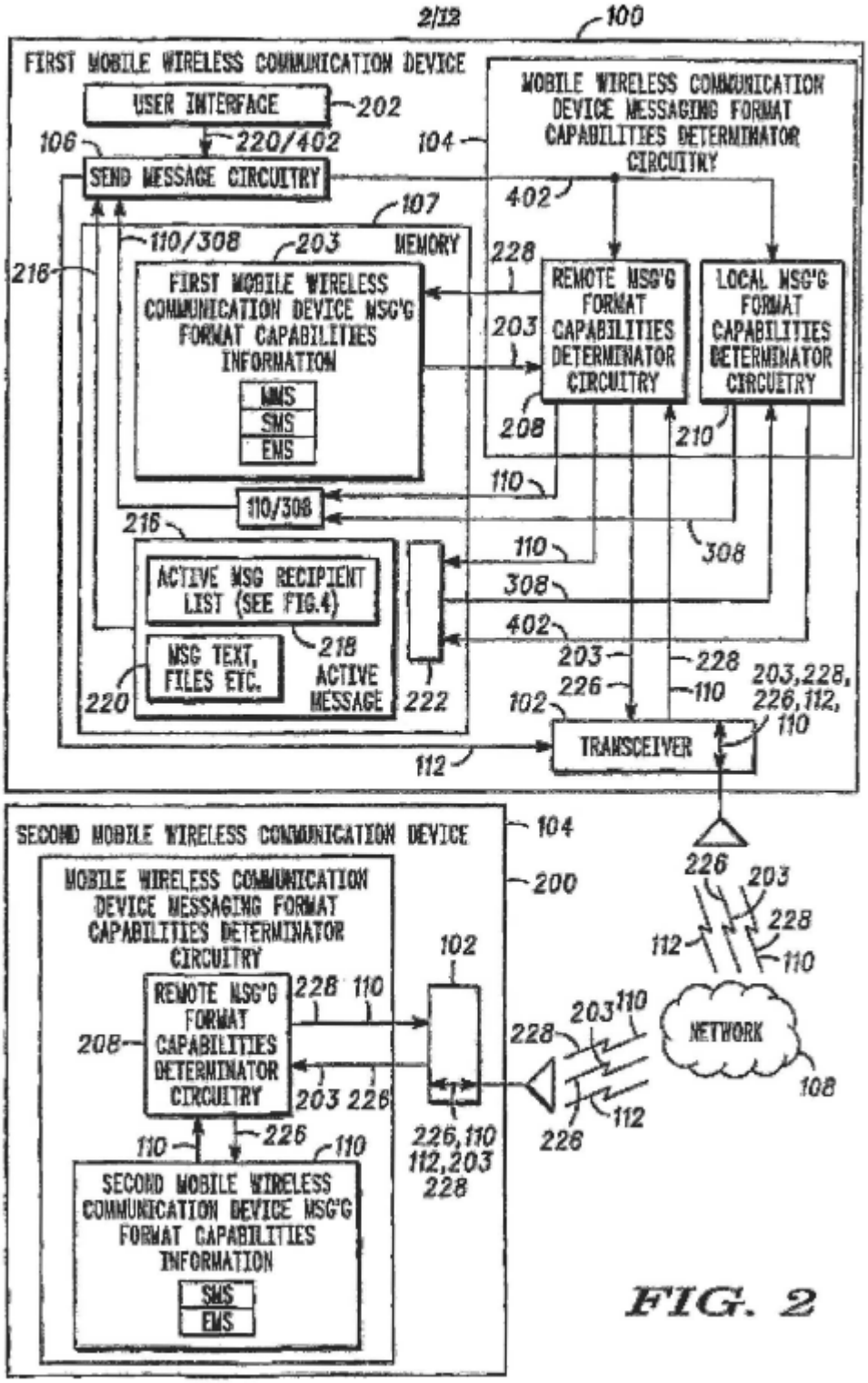
100
FIRST MOBILE WIRELESS COMMUNICATION DEVICE
USER INTERFACE
202
220/402
106
SEND MESSAGE CIRCUITRY
104
MOBILE WIRELESS COMMUNICATION DEVICE MESSAGING FORMAT CAPABILITIES DETERMINATOR CIRCUITRY
402
107
110/308
203
MEMORY
216
FIRST MOBILE WIRELESS COMMUNICATION DEVICE MSG'G FORMAT CAPABILITIES INFORMATION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

FIG. 2

53 bb) The mobile device (100) proposed in K5 communicates with the network (108) by means of special circuitry (104) to retrieve information about which message delivery formats the recipient's mobile device can process. This information is stored in the mobile device (100) and associated with the receiver's device (para. 25).

54 However, the information about which messaging formats are supported by the recipient's mobile device does not necessarily have to be stored (only) in the recipient's mobile device. In an alternative embodiment of K5, the information about the message delivery formats supported by the recipient device can also be stored in an address book connected to the sender's mobile device (para. 64). In another embodiment of K5, such information about capacities of the recipient device may also be stored in another location, such as a network device, such as a web server or other server, in which information about the supported message delivery formats for various devices may be stored (para. 39).

55 cc) A circuit (106) is used to send the message in a supported format (par. 25).

56 In one of the embodiments disclosed in K5, the user can decide whether to send the message at all depending on the message formats supported by the recipient's mobile device. For example, he can cancel the transmission if it is determined that the recipient device does not support the message format selected by the sender (par. 26 and 33).

57 In an alternative embodiment, as the sender enters the current message, the sender's mobile device contacts the network to connect to the recipient's address (e.g., MSISDN) and its Horne Location Register (HLR) to determine whether the address is capable of receiving a message in MMS format. If this is the case, the appropriately formatted message is transmitted to the recipient's mobile device. If, on the other hand, the MMS format is not supported by the recipient's mobile device, the mobile device informs the sender of this and suggests that the sender format the message as an SMS message and send it, noting that attached multimedia files will be lost. The user can then decide whether to send the message via SMS or MMS or to cancel the sending process (par. 61-62).

58 b) Thus, as also the appeal does not doubt, the characteristics 1, 2, 2.1, 3 and 3.1 are disclosed.

59 c) Contrary to the opinion of the appeal, feature 4 is also open.

60 If the recipient's mobile device supports a message transmission format supported by the sender's mobile device, the message is sent in this format. If the format supported by both devices is a packet-switched carrier, the message is accordingly sent via such a carrier (par. 25 and 61).

61 d) By contrast, feature 3.2. is not disclosed, as the applicant does not question.

62 e) Contrary to the applicant's view, feature 5 is also not disclosed.

63 The procedure according to K5, in the case that the mobile device of the recipient is not able to receive messages via a packet-switched carrier (MMS messages in the described embodiment), does not automatically determine that the message is sent via an SMS carrier, but offers the sender the choice between transmission as an SMS or MMS message or aborting the transmission process (par. 26 and 62).

64 f) The subject-matter of claim 1 was suggested to the skilled person on the basis of K5.

65 aa) Based on K5, the expert had reason to check whether the destination address can receive messages via a packet-switched carrier, either via WPAN or WLAN.

66 K5 deals with devices that can handle different standards. This suggested to the expert that the K5 solution should also be considered for those devices that inherently have not only cellular but also WPAN or WLAN functions. For such devices, it made sense to use WPAN or WLAN, which are generally more cost-effective, for packet-switched communication, provided the respective device is capable of this and a corresponding network is available.

67 The appeal's objection that technical difficulties and aspects of system security would have prevented the skilled person from sending the address verification request using a WPAN or WLAN because mobile network operators have secured their networks against external interference by third parties and special authorization is required to access the mobile network from the WPAN or WLAN is not valid. Contrary to the opinion of the appeal, an address verification request in the sense of feature 3.1 is not only possible for the system disclosed in K5 in the form of a query to the Horne Location Register (HLR) of the mobile network. As already explained above, according to the description of K5, the required information can also be stored on a web server (par. 39). At least with this variant, the technical difficulties and security concerns pointed out by the appeal did not stand in the way of an address verification request via WPAN or WLAN.

68 bb) Whether the user is given the opportunity to cancel the transmission process if it turns out that the transmission can only be carried out on the SMS carrier is a question of the appropriate design in the individual case. Thus, K5 provides that the proposed procedure in the individual embodiments described can be designed either with or without user prompts (paragraph 55). Against this background, a design of the method with which the selection between an SMS carrier and a packet-switched carrier is made automatically depending on the presence of the respective applicable requirements cannot lead to the affirmation of inventive step.

69 (2) The patent in suit does not prove to be legally valid in the versions of auxiliary requests 1 to 9 either.

70 a) The subject-matter of patent claim 1 according to auxiliary request 1 (at first instance: auxiliary request 1') is not based on inventive step.

71 aa) According to auxiliary request 1, claims 17 and 18 are to be deleted. In patent claim 1 the following additional feature is provided:

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) Whether the subject matter thus defended is disclosed in the originally filed documents as belonging to the invention can be left open.
In any case, it was suggested to the skilled person by K5. The procedure proposed in K5 also provides in the already mentioned embodiment example for checking the reachability of a subscriber on the basis of a subscriber list (paras. 33, 39).

73 b) The subject-matter of patent claim 1 defended by auxiliary request 2 (at first instance: auxiliary request 2') is also not based on inventive step.

74 aa) According to auxiliary request 2, the following additional features are provided compared to the version according to the main request, with patent claim 17 referring back to the amended version of patent claim 1 and patent claim 18 being adapted accordingly:

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 zurdrahtlosen Kommunikation auf der Sieherungsschicht verwendet, um die abgehende Nachricht von der Mobilfunkeinrichtung des Senders (112) an dasdrahtlose 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 in substance to feature 3.3 according to auxiliary request 1 and is not subject to a different assessment.

76 cc) Feature 4.1 cannot establish patentability even in combination with this feature.

77 As the patent court rightly pointed out, sending a message using a WiFi protocol is an obvious measure for a person skilled in the art. If WiFi, i.e. a WLAN network is available, it is obvious to send not only the verification request but also the message itself via it.

78 Contrary to the opinion of the appeal, there were no obstacles to the transmission of MMS via a WLAN at the time of priority that would have prevented the skilled person from finding such a solution. The difficulties pointed out by the appeal in determining the IP address of a recipient device in the WLAN are irrelevant if only because feature 4.1, *as* the plaintiff rightly points out, only concerns the sending of the message from the sender to the wireless communications network, but not the receiving of the message.

79 c) The subject-matter of claim 1 defended by auxiliary request 3 (at first instance: auxiliary request 3') is also not patentable.

80 aa) According to auxiliary request 3, the following additional features are provided compared to the version according to the main request, with patent claim 17 referring back to the amended version of patent claim 1 and patent claim 18 being adapted accordingly:

2.2	Die Zieladresse ist eine Mobiltelefonnummer.	The destination address is a mobile phone number.
4.1	Ein WiFi-Protokoll wird zur drahtlosen Kommunikation aufder Sieherungsschicht 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) The use of a mobile telephone number as the destination address, as provided for in the newly added feature 2.2, was suggested to the skilled person by K16, as the Patent Court correctly assumed.

82 This citation discloses an Instant Messenger system and method for transmitting instant messages that enable a sender to send an instant message to a recipient when the sender knows only the recipient's cell phone number, but not the recipient's Instant Messenger address.

83 cc) With regard to feature 4.1, the same applies as to auxiliary request 2, which also provides for this feature.

84 dd) According to the unchallenged findings of the patent court, an SMS message according to the GSM standard is always sent to the core network due to the system. These findings support the conclusion drawn by the patent court that feature 5.1 is a matter of course for the person skilled in the art.

85 d) Auxiliary claims 4 to 8, filed for the first time in the appeal proceedings, are not to be considered under Sec. 116 (2) and Sec. 117, first sentence, Patent Law and Sec. 531 (2), Code of Civil Procedure, because they are not relevant and the applicant has not agreed to them.

86 The Patent Court has already indicated in the reference issued under Sec. 83 (1) Patent Act that the subject-matter of claims 1, 17 and 18 is not likely to be inventive with regard to K4a, but also on the basis of K5. The defendant therefore had reason to file these auxiliary requests, which serve to further distinguish the cited citations, already at first instance (see BGH, judgment of December 15, 2015 - XZR 111/13, GRUR2016, 365 marginal no. 26 - Telekommunikationsverbindung).

87 e) The subject-matter of patent claim 1 defended by auxiliary request 9 (at first instance: auxiliary request 4') is also not based on inventive step.

88 aa) According to auxiliary request 9, claims 17 and 18 are to be deleted. In patent claim 1, the following additional features are provided compared to the version according to the main request:

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 The following changes are also envisaged:

90 Feature 3.1 is to be amended to state that the address verification request is sent to the message server over the second network.

91 In Feature 3.2, the words "the wireless Internet" should be inserted before the words "base station".

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

93 Finally, feature 5 is to be supplemented to the effect that the outgoing message is sent via the core network (140; over the core network) to the mobile radio equipment of the recipient.

94 bb) With regard to feature 2.2 and the addition of feature 5, the comments on auxiliary request 3 apply accordingly.

95 cc) The other newly added or supplemented features relate to the transmission of the verification request and the outgoing message via WLAN or WPAN. In this respect, the comments on the current version and on auxiliary request 2 apply accordingly.

96 IV. On the other hand, the patent in suit - contrary to the Patent Court's assumption - is valid in the version of auxiliary request 10 (at first instance: auxiliary request 5').

97 1. after auxiliary request 10, claims 17 and 18 are to be deleted. In patent claim 1, the following additional feature is provided compared to the version according to auxiliary request 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 opinion of the patent court, the subject matter thus defended is sufficiently disclosed in the documents originally filed.

99 It can be left open whether the application shows a compelling connection between the result of the two checks provided for in features 3.3 and 3.4 and the automatic selection of a carrier.

100 Contrary to the opinion of the patent court, such a connection also results from the version of the patent claim defended by auxiliary request 10, and in any case from the interaction of the two features mentioned with features 4 and 5, which expressly provide for an automatic selection of a carrier. A confirmed verification within the meaning of feature 4 is only present if both checks provided for in features 3.3 and 3.4 have produced a positive result.

101 3 Contrary to the applicant's view, auxiliary claim 10 is also not directed at an extension of the scope of protection.

102 a) According to the case law of the Senate, the subsequent inclusion of a subject matter not protected by the patent in suit in the granted version leads to an extension of the scope of protection.

103 The patent nullity proceedings do give the patent proprietor the opportunity to defend the property right in a limited form. However, it does not serve the purpose of shaping the patent beyond that. Therefore, a patent claim may not be amended in nullity proceedings to include subject matter not covered by the granted version (BGH, judgment of December 20, 2018 - X ZR 56/17, GRUR 2019, 389 marginal no. 33 - Schaltungsanordnung III; judgment of September 14, 2004 - X ZR 149/01, GRUR 2005, 145, 146 - Elektronisches Modul).

104 b) In the case in dispute, the insertion of feature 3.4 does not result in the patent claim being directed to subject matter not covered by the applicable version.

105 Contrary to the applicant's view, the subject matter of patent claim 1 is already in the current version not limited to a method that is executed solely on the mobile radio device. Patent claim 1 presupposes much more already in the valid version that a message server is present and that this answers a verification request.

106 It is true that the current version does not contain any specifications as to which criteria must be fulfilled in order for the message server to answer the request with "affirmative". However, in the case of dispute, the specification of such criteria is tantamount to a concretization of the request directed to the server. In substance, the insertion of feature 3.4 results in the server no longer

being asked for information on whether the specified recipient can be reached at all by a particular communication route, but for information on whether the recipient can probably be reached without complications. Compared to the subject matter of the current version, this is merely a concretization of the procedure that the mobile radio device carries out in interaction with the server.

107 4 The new feature 3.4 added by auxiliary claim 10 is not suggested to the skilled person by any of the citations in the proceedings.

108 a) In particular, contrary to the applicant's view, the technical specification 3G TS 22.140 version 0.1.0 (K21) did not suggest to the expert that carrier selection should be made dependent on exceeding a certain message queue length on the receiver side.

109 K21 merely states that messages are queued if the recipient's mobile device cannot be reached by the network, and that a controlled delivery mechanism is required as soon as reachability is restored (Section 5.2, p. 8 under "Message queuing"). This does not suggest that the selection of the carrier used for sending a message should depend on the length of the queue.

110 b) The plaintiff's argument, which is not specified in more detail and is disputed by the defendant, that the measurement of the length of the queue was already a common and obvious means in the state of the art to check the availability of the recipient, is not capable of leading to a different assessment.

111 The applicant has neither submitted citations nor shown any other concrete circumstances from which the customary or obvious nature of this approach can be inferred. On this basis, patentability cannot be denied.

112 V. The decision on costs is based on Sec. 121 (2) Patent Law in conjunction with Sec. 92 (1) ZPO.

Bacher Deichfuß Kober-Dehm

Marx Rensen

Lower court:
Federal Patent Court, decision of 24.01.2018 - 5 Ni 22/16 (EP) -