

described using words.⁵⁷⁰ Numbers are a clear expression of the objects they describe while general terms using language are a level of abstraction from the object.⁵⁷¹

Terms such as “comprising”, “including”, “containing” introduce a list of element that is not exhaustive and to which other elements could be added. Conversely a term such as “consisting of” indicates an **exhaustive list**, to which no further elements can be added. 366

Optional features or groups of features in the patent claim are identified by such terms as “in particular”, “for example”, “preferably”. They do not have any restrictive effect on the claimed subject matter. 367

The word “and” between two features in a patent claim indicates a combination of two features that must be cumulative. The word “or” in a patent claim indicates two **alternative embodiments**, that is to say two objects that exist alongside each other. More than two embodiments may be expressed by using a series of “or” or by using a **Markush formula** (such as “...comprising one of the following features from the group of features comprising the features...” or “...comprising at least one of the following features from the group of features comprising the features...”). The term “and/or” between two features indicates that both features are present individually or together. In all cases each of these (sometimes multiplicity of) features is to be tested for patentability.⁵⁷² 368

A **statement of intended use** or of **functional features** in an apparatus claim is to be understood as meaning that the apparatus must be **suitable** for the stated purpose.⁵⁷³ However it does not limit the claimed object to this purpose, but defines a functional aptitude and specific embodiment of the feature in question.⁵⁷⁴ Such data serves to describe a feature indirectly. It is particularly useful to describe a feature that cannot be defined in another objective and precise manner without undue limitation of the invention.⁵⁷⁵ Information about purpose, effect and function in product claims can contribute to distinguishing them against state of the art, in particular if the product element is more closely defined and thereby configured in such a way that it can fulfil the appropriate function, whilst the state of the art element cannot.⁵⁷⁶ Functional feature defines the claimed subject matter, in a spatial and physical manner, and also functionally in that it is configured to be used for the purpose given in the patent claim.⁵⁷⁷ If in a **product claim** based on a recording medium the claimed subject is at least in part not directly defined by (spatial-physical or functionally circumscribed) product features but through a process which gives rise to a certain information structure, then the patent claim must be **interpreted** to establish whether and to what extent the process is reflected in the medium and its features, so it may be considered as inventive.⁵⁷⁸ The indications of purpose, effect or function contained in a patent claim do not necessarily have to refer to the subject matter of the claim or its individual features. They may use language to relate the invented object to such subject matter or processes that only have a specific relationship to the claimed teaching and which are mentioned to provide 369

⁵⁷⁰ v. *Rospatt* GRUR 2001, 991, 993; BGH GRUR 2002, 523, 525 – Custodiol I.

⁵⁷¹ BGH GRUR 2002, 523, 525 – Custodiol I.

⁵⁷² Usage of accumulated “or-” or “and/or-” combinations or Markush groups in a patent claim may cause problems in case that thereby the patent claim becomes unclear or inconsistent.

⁵⁷³ EPO T 468/05, mn. 2.2; EPO T 287/86, mn. 2.1; EPO T 637/92, mn. 4.5.

⁵⁷⁴ BGH GRUR 1979, 149, 151 – Schießbolzen; BGH GRUR 2006, 570, 573, [mn. 21] – Extracoronales Geschiebe; BGH GRUR 2006, 923, 925, [mn. 15] – Luftabscheider für Milchsammelanlage.

⁵⁷⁵ EPO OJ 87, 228, 232 et seq.

⁵⁷⁶ BGH GRUR 2006, 923, 925, [mn. 15] – Luftabscheider für Milchsammelanlage.

⁵⁷⁷ BGH GRUR 2009, 837, 838, [mn. 15] – Bauschalungsstütze.

⁵⁷⁸ BGH GRUR 2005, 749, 750 – Aufzeichnungsträger; BGH GRUR 2001, 1129, 1133 – Zipfelfreies Stahlband.

possible guidance to the skilled person in understanding and classifying technically the subject matter of the teaching.⁵⁷⁹

- 370 The subject matter of a patent is defined in nullity proceedings using the **same principles** that apply to the meaning and interpretation of a patent in an **infringement case**.⁵⁸⁰ When examining patentability and establishing scope of protection (Patent Act Section 14; EPC Art. 69)⁵⁸¹ the terms in the patent claims are to be interpreted as they would be understood by the appropriate skilled person according to the patent’s full content and taking into account the objectively disclosed solution.⁵⁸² Information about the purpose of a product claim has the same significance in a nullity case as they do in an infringement suit.⁵⁸³ In a nullity case in particular it is not allowable to adopt a restrictive interpretation of the attacked patent claims because of the reason that such interpretation could make it easier to acknowledge patentability.⁵⁸⁴

3. The problem on which the invention is based

- 371 A patent claim must characterise the solution of the problem; a **description of the problem** upon which the invention is based does not suffice.⁵⁸⁵ Conversely the problem must be **separate** from all elements of the solution, such as approaches to a solution, principles of a solution or other ideas pertaining to the solution, and does not provide instructions on the solution or contribute to it.⁵⁸⁶ There can be no invention in the **problem** itself, only in the solution to the problem.⁵⁸⁷ Therefore overwhelming opinion is that there is no such thing as a “problem invention”.⁵⁸⁸ However the way in which the problem is framed can mean that some means are rejected as **unsuitable** for solving the problem. In such a case the problem can influence that assessment of inventive step.⁵⁸⁹ Information about the “**problem**” underlying the invention in the **introduction to the patent description** (“subjective problem”) is not conclusive,⁵⁹⁰ because it is not necessarily correct.⁵⁹¹ When determining the technical problem any instructions the skilled person receives from his client are deemed to be part of the problem, not its solution.⁵⁹² As patent law does not stipulate that a subject matter in the claim must solve the problem set out in the description, the problem is to be adapted to the claimed invention during the grant procedure, and not the converse, if the claimed invention does not solve the stated problem.⁵⁹³

⁵⁷⁹ BGH GRUR 2010, 1081, 1083 – Bildunterstützung bei Katheternavigation.

⁵⁸⁰ BGH GRUR 2004, 47, 48 – Blasenfreie Gummibahn I.

⁵⁸¹ Regarding scope of protection of a patent see ch. 6.

⁵⁸² BGH GRUR 2001, 232, 233 – Briefflocher.

⁵⁸³ BGH GRUR 2007, 859, 861 – Informationsübermittlungsverfahren I; BGH GRUR 2001, 232, 233 – Briefflocher; BGH GRUR 2009, 837, 838, [mn. 15] – Bauschalungsstütze.

⁵⁸⁴ BGH GRUR 2004, 47, 49 – Blasenfreie Gummibahn I.

⁵⁸⁵ BGH GRUR 1985, 31, 32 – Acrylfasern; BPatG BeckRS 2011, 8547.

⁵⁸⁶ BGH GRUR 1991, 811, 814 – Falzmaschine; BGH Mitt. 2003, 116, 117 – Rührwerk.

⁵⁸⁷ BGH GRUR 1984, 194, 195 – Kreiselegge.

⁵⁸⁸ BGH GRUR 1984, 194, 195 – Kreiselegge; BGH GRUR 1985, 31, 31 – Acrylfasern; see European case law: EPO T 630/92; EPO T 798/92; EPO T 578/92; EPO T 610/95; EPO T 805/97; EPO T 1417/05. A task was considered as being relevant in EPO T 135/94; EPO T 540/93; EPO T 1236/03.

⁵⁸⁹ BGH GRUR 1978, 98, 99 – Schaltungsanordnung.

⁵⁹⁰ BGH GRUR 2005, 141, 142 – Anbieten interaktiver Hilfe; BGH GRUR 1981, 186, 187 et seq. – Spinnturbine II; BGH GRUR 1986, 803, 804 – Formstein; BGH GRUR 2003, 693, 695 – Hochdruckreiniger.

⁵⁹¹ BGH GRUR 2011, 607, [mn. 19] – Kosmetisches Sonnenschutzmittel III.

⁵⁹² BGH GRUR 2010, 44, 45 – Dreinahtschlauchfolienbeutel; BGH GRUR 1991, 881, 814 – Falzmaschine.

⁵⁹³ BPatG GRUR 1997, 523 – Faksimile-Vorrichtung; EPO T 400/98.

In European case law the “objective problem” which is established by comparing the claimed invention with the closest state of the art, plays a central role in determining inventive step via the “problem-solution-approach”.⁵⁹⁴ 372

4. Priority of the claimed invention

The **priority** of the claimed invention establishes which knowledge belongs to the state of the art. It also establishes the day that is the **basis** of examination of the novelty and inventive step of the claimed invention. It is the chosen date of filing (“**filing date**”) effective in Germany or, if a priority can be effectively claimed, the day of the filing establishing priority (“**priority date**”; Patent Act Sections 40, 41; EPC Art. 87–89). Knowledge dated on that day (publication⁵⁹⁵ or application⁵⁹⁶) or later is not part of the examination of patentability. Filing date is established according to the date of reception of the application documents at the patent office, but not according to when they were posted.⁵⁹⁷ 373

Priority pre-dates filing date if the (German, European or international) application enjoys **priority** of an earlier application. A priority right may be based on the following earlier applications: national patent applications or similar industrial property rights (e. g. utility models) in signatory countries of the Paris Convention for the Protection of Industrial Property or patent applications with effect in those countries (Patent Act Sections 40, 41; Paris Convention Art 4; EPC 87 f; PCT 8). If such priority is successfully claimed, the priority for the invention is the date of **filing of the earlier application on which priority is based** (“Priority date”; Patent Act Section 3 Para 1 sentence 2 and Section 2; Paris Convention Art 4B; EPC 89). If the claimed invention enjoys such a priority right, the state of the art includes neither knowledge made available to the public on or after the date of filing of the priority document, nor the content of applications filed later, whose own priority comes after the day of filing of the priority documents (for example during the “priority interval” i. e. the period between the filing of the application establishing priority and the filing date of the application containing the claimed invention). 374

The priority for establishing disclosure of a prior publication is significant in distinguishing it from the **priority** relevant for the novelty of the claimed invention.⁵⁹⁸ While novelty and inventive step of a claimed invention must be present at the priority date of the claimed invention, the disclosure of a citation is determined through its priority, meaning for publications the **date of publication** and for a subsequently published patent application its priority (filing date or priority date) – “senior rights” according to Patent Act Section 3, Para 2 or EPC Art. 54 Para 3). 375

5. Substances for medical procedures

The law excludes from patent protection procedures for surgical or therapeutic treatment of human or animal bodies and diagnostic procedures that are undertaken on human or animal bodies (“**medical methods**”) – Patent Act Section 2 a Para 1 sentence 2; EPC Art. 53c. However it is possible to **provide protection for a specific use** to substances or compounds of substances that are used in one of these medical procedures. The law thereby broadens the product protection for medically usable substance or compounds such as medicines or diagnostic agents if they are intended 376

⁵⁹⁴ Information on the term “Problem-Solution Approach” is given in ch. 2 mn. 568 et seqq.

⁵⁹⁵ BGH BIPMZ 1963, 144.

⁵⁹⁶ BGH GRUR 1964, 473, 478 – Dauerwellen I; BPatG GRUR 1971, 115, 115 – Eisenoxyde.

⁵⁹⁷ BGH NJW-RR 1989, 123 – Schlauchfolie.

⁵⁹⁸ Explanations with respect to the subject of right of priority are given in ch. 5 A I 2 g, [mn. 298 et seq].

for such medical procedures, provided their use in one of these procedures is not part of the state of the art (known as “**first medical use**”, Patent Act Section 3 Para 3; EPC Art. 54, Para 4). Alongside the absolute protection also available on substances for medicines and diagnostic agents, it is thus possible to obtain protection for a specific purpose even if the substance or mixture is not novel to the extent that the use of this (known) substance or mixture is new and based on an inventive step. The novelty of known substances or mixtures of substances is therefore based on the first medical use. Such product protection on medically usable substances is an **exemption** according to the wording of the law, and is therefore not transferable to different technical fields.⁵⁹⁹ A patent claim for a known substance or mixture of substances for use in surgical, therapeutic or diagnostic procedures should have the following general format: “Substance or mixture of substances X” followed by a statement of the use, for example “for use as a medicine”, “as an anti-bacterial agent” or “for the treatment of disease Y”.⁶⁰⁰

- 377 If the first use of a substance or mixture of substances in a medical procedure is already part of the state of the art, this exemption extends to apply to all further specific medical uses that are new and inventive (known as “**second medical use**”, Patent Act Section 3 Para 4; EPC Art. 54, Para 5). Under past law (EPC 1973) protection for every additional medical use could be obtained using the “Swiss style claim”, meaning a claim for the “use of a substance or mixture of substances to produce a medicament for a specific new and inventive therapeutic use”.⁶⁰¹ One no longer needs to use this claim format and it is in fact no longer permitted for European patent applications.⁶⁰²

IV. State of the art

1. Basic concept

- 378 According to legal definition, state of the art **comprises everything** made available to the public by means of a written or oral description, by use, or in any other way, before the priority date of the claimed invention⁶⁰³ (Patent Act Section 3 Para 1, EPC Art. 54 Para 2). No additional limitations of any kind are provided for that go beyond the priority and public accessibility, be they material, language, spatial or also of a chronological nature. Any medium can be considered for the dissemination of information that is able to communicate the technical teaching to the skilled person in such a way that he is able to understand it using his own senses. State of the art may exist in the appropriate general knowledge that does not necessarily have to be established in writing.⁶⁰⁴ Earlier descriptions and uses by the applicant or his predecessor in title (“own publications”) are also part of state of the art, unless (Patent Act section 3 Para 5; EPC Art. 55) they are based on a clear abuse vis-a-vis the applicant or his predecessor in title or on a display at certain international exhibitions with official recognition (known as “**exhibition protection**”).⁶⁰⁵
- 379 Furthermore, the contents of **later published patent applications** with an earlier priority (known as “fictitious state of the art” or “senior rights”) that are filed before priority of the claimed invention – before its filing or priority date – but are published

⁵⁹⁹ EPO G 1/83.

⁶⁰⁰ EPO-Guidelines G II 4.2.

⁶⁰¹ EPO G 1/83, OJ 1985, 60; EPO case law, I. C.5.2.

⁶⁰² EPO G 2/08 and EPO, OJ Special Edition 1, 2010, 131.

⁶⁰³ Information on the term “priority of the claimed invention” is given in ch. 2 mn. 373 et seqq.

⁶⁰⁴ Information on the term “general knowledge” is given in ch. 2 mn. 341 et seqq.

⁶⁰⁵ Information on the term “non-prejudicial disclosure” is given in ch. 2 mn. 465 et seqq.

on the same day or later, are also considered part of state of the art provided certain conditions are met (Patent Act Section 3 Para 2, EPC Art. 54 Para 3).⁶⁰⁶

2. Different sources of disclosure

Knowledge may be made accessible via oral, written, electronic, via domestic or foreign uses, through display at trade exhibitions or by means of publicly accessible testing or “in other ways”. There is no limitation regarding the types of media. There are similarly no restrictions regarding the place, provided there was the **possibility of public access**. There are no particular requirement of the source’s permanence, provided its **existence** and the opportunity to **gain knowledge of its content** can be proven, because once an object has entered the public domain, it is part of state of the art for all time.⁶⁰⁷

a) **Written sources.** The term **written description** includes all products that use systems of writing based on letters, syllables, words or pictorial depictions, that is objectively able to transmit a technical teaching. Examples are patent applications or descriptions, utility models, utility model applications (if published), scientific or lay publications, Internet websites, books, drawings, circuit diagrams, manuscripts, catalogues, (promotional) brochures, letters, e-mails, advertisements, photocopies, (micro) films, film negatives, manuals etc. The summary of a document also constitutes state of the art,⁶⁰⁸ but is to be interpreted and assessed in the light of the original document – if available.⁶⁰⁹ Information can also be disclosed by dint of being stored in data processing systems.

Unlike oral descriptions, written descriptions can be passed on; whether the person passing on the information has understood the description is immaterial. If retained in representational form written descriptions keep the information content when transmitted (dispatch, copying etc.) while in the case of an oral description it is generally the case that only what the provider of the information has understood can be passed on.

In modern multimedia communications, such as the Internet, online databases, e-books, e-mail, SMS, MMS, video phones and video conferences a different approach must be taken to establishing the nature of the source of disclosure, and it involves asking in which format the information was provided. If the disseminated information existed in a physical form that went beyond the here and now and if it is within the gift of the recipient to pass it on to third parties as a file, this should be deemed to be a written description. If the carrier is such that the information exists for the recipient only in the moment it is received and subsequently disappears (for example this regularly occurs with broadcast transmissions, online chats, live-streaming, live chat) it would not possess the documentary character that is typical of a written description. In such cases there is therefore more likely to be an oral description or a description “of another sort”.⁶¹⁰

b) **Oral sources of disclosure.** A technical teaching may be described orally, for example within a presentation, lecture, speech or discussion or explanations on a visit, plant visits or trade exhibition, sound, radio or (TV) image recording. Only what is actually disclosed orally is state of the art, but only to the extent that the information is accessible to the recipient. The knowledge of the recipient must be considered because

⁶⁰⁶ Information on the term “senior right” is given in ch. 2 mn. 414 et seqq.

⁶⁰⁷ BGH GRUR 1985, 1035, 1036 – Methylomonas.

⁶⁰⁸ EPO T 260/92, OJ 1995, 35; EPO T 243/96.

⁶⁰⁹ EPO T 160/92, mn. 4.6.

⁶¹⁰ From a patent law perspective, it does not matter in what form the description is presented. The form, however, is important for the German utility model, which is based on a different understanding of the state of the art, according to which foreign uses and oral descriptions do not belong to the state of the art (§ 3 mn. 1 GebrMG). For more details see ch. 13 mn. 22.

only material within the knowledge of the recipient can be passed on and added to state of the art. Transmitted information that the recipient cannot understand is lost when described orally.

- 385 In this context knowledge transmitted via modern multi-media sources such as the Internet can be considered as oral description, if the transmitted information has not been stored long term in a file and cannot be passed to third parties as the recipient sees fit. Because then the reception of the information always involves a change of content, that can lead – although not inevitably – to a loss of information, as is typical with oral descriptions.
- 386 Proof of what was communicated can be supported by documents that testify to the contents of the oral disclosure, even if they first became available to the public after the priority of the claimed invention. Doubts about what was actually disclosed affect the party that relies upon the information.⁶¹¹
- 387 c) **Public prior use.** The public may receive knowledge through use. Use means “every action that by its nature is susceptible to make the nature of the invention accessible”.⁶¹² They may be non-commercial or carried out for testing or research purposes.⁶¹³ As with other sources of disclosure the essence of the invention must be clear without further explanation to the skilled person.⁶¹⁴ It does not matter whether the user is authorized to use it or not. The user does not need to have grasped the inventive design, as long as use shows the skilled person the essence of the invention. Use is public when it is within the realms of possibility that other experts can gain **sufficient knowledge** of the used object and its features, even if they are not stated.⁶¹⁵ The **possibility for skilled persons to gain said knowledge** is to be judged objectively according to common practical experience. It should be more than simply theoretical.⁶¹⁶ Examples are the sale (marketing) of products, the use of processes or **display**. Even if the actual use is unimportant,⁶¹⁷ proof that third parties had no actual knowledge of the used invention may indicate a lack⁶¹⁸ of accessibility.⁶¹⁹
- 388 The use of a **product** discloses the product with its **features** that can be established by the skilled person without undue burden, and thus brings not only the product but also its **composition and structure** into the public domain.⁶²⁰ The skilled person accepts some burden and spares no effort in carrying out further **investigations**, if his interest has been whetted or he has a reason to do so.⁶²¹ A product’s features are known through accessibility and the ability to analyse, regardless of whether there is a reason to look for them.⁶²² A sold product is part of state of the art to the extent a skilled person can

⁶¹¹ EPO T 877/90; EPO T 86/95.

⁶¹² BGH GRUR 1956, 208, 209 – Handschuh; BGH GRUR 1962, 86, 90 – Fischereifahrzeug.

⁶¹³ BGH GRUR 1975, 254, 256 – Ladegerät II.

⁶¹⁴ EPO G 1/92, OJ 93, 277.

⁶¹⁵ See BGH GRUR 1966, 484, 486 – Pfennigabsatz; BGH GRUR 1973, 263, 264 – Rotterdam-Geräte.

⁶¹⁶ BGH BeckRS 2011, 23 248; BGH GRUR 1966, 484, 486 – Pfennigabsatz; BGH GRUR 1973, 263, 264 – Rotterdam-Geräte; BGH GRUR 1978, 297, 299 – Hydraulischer Kettenbandantrieb; BGH GRUR 1986, 372, 374 – Thrombozyten-Zählung; BGH GRUR 1996, 747, 752 – Lichtbogen-Plasma-Beschichtungssystem; BPatG GRUR 1993, 808, 811 – Abschlußblende II; BGH BeckRS 2001, 30 187 219.

⁶¹⁷ BGH GRUR 1962, 518, 521 – Blitzlichtgerät.

⁶¹⁸ Information on the term “public availability” is given in ch. 2 mn. 390 et seqq.

⁶¹⁹ BGH GRUR 1966, 484, 486 et seq. – Pfennigabsatz.

⁶²⁰ BGH NJW-RR 1986, 734 – Thrombozyten-Zählung; EPO G 01/92, OJ 93, 277; T 390/88.

⁶²¹ BGH GRUR 1986, 372, 374 et seq. – Thrombozyten-Zählung; BGH GRUR 1966, 484, 486 – Pfennigabsatz; EPO T 93/89, OJ 92, 718; EPO T 270/90.

⁶²² EPO G 01/92, mn. 2.

reproduce it through copying.⁶²³ A finished product discloses a manufacturing process as long as experts can understand the manufacturing process on the basis of the finished product, even if examination is only possible by **destroying** the product in question.⁶²⁴

d) **Other forms of disclosure.** In addition to knowledge acquired through written or oral description or through use, the state of the art also includes by law knowledge made available to the public in any other way (Patent Act Section 3 Para 1; EOC Art 54 Para 2). State of the art is therefore not limited either by the nature of the information medium or carrier or through the chosen path of communication. 389

3. Public access

The existence of knowledge does not *per se* constitute state of the art. Knowledge is only part of the state of the art if it is **made available to the public**. In this context public means a group of people that due to its size or the nature of its members is not under the control of the originator of the information.⁶²⁵ It does not depend on the actual acquisition of knowledge but on the existence of an objective **possibility**⁶²⁶ to do so as well as the possibility of **unrestricted further transmission**.⁶²⁷ This possibility should, based on experience, not be too remote, so that any third parties and therefore also experts can obtain **reliable and sufficient knowledge** of the technical teaching.⁶²⁸ With disclosure that happen only in the “**here and now**” and which are addressed to just a **restricted group** of recipients, information is only permanently in the public domain if the recipients are able to **understand** the information.⁶²⁹ This possibility should, based on experience, not be too remote, meaning that **any third parties** and therefore also experts can obtain **reliable and sufficient knowledge** of the technical teaching.⁶³⁰ An **offer** can also be assigned to state of the art if experience indicates that the recipient of the offer is likely to distribute the information further to other third parties before the relevant date for examination of patentability.⁶³¹ Information enters the public domain in particular if only a **single member** of the public, who is not bound by any duty of confidentiality, is able to gain access to and to understand the information.⁶³² 390

Only the objective circumstances surrounding the possibility of gaining knowledge are material.⁶³³ The **purpose** for which publication took place is unimportant, whether intentional, for example to create state of the art (“defensive publishing”), through coincidence or by error. If there was an objective possibility to obtain the knowledge, it is not important whether it was **actually used**⁶³⁴ or whether it was done lawfully or came about as the result of an earlier unauthorized action⁶³⁵ or whether it was in writing, oral 391

⁶²³ EPO T 977/93, OJ 01, 84.

⁶²⁴ BGH GRUR 1956, 73, 75 – Kalifornia-Schuhe.

⁶²⁵ BGH BIPMZ 71, 230, 231 – Customer prints.

⁶²⁶ BGH BIPMZ 1962, 311, 313 – Blitzlichtgerät; BGH GRUR 1961, 24, 25 – Holzimprägnierung; EPO T 355/07. From the original case law which is based solely on the theoretical possibility of taking note, see EPO T 84/83, EPO T 381/87, EPO T 444/88, the EPO seems to distance itself, see EPO T 314/99, EPO T 186/01.

⁶²⁷ EPO T 611/95, mn. 4.1.1.

⁶²⁸ BGH GRUR 1997, 892, 894 – Leiterplattennutzen.

⁶²⁹ See EPO T 877/90, mn. 2.1.6. A bit artificial appearing exception is a knowledge transfer through a messenger, who memorizes the technical teaching and passes it on.

⁶³⁰ Schulte/*Moufang*, ch. 3 mn. 26, 27, 61; Benkard/*Melullis* ch. 3 mn. 63, 63 a, 65; BPatG BeckRS 2009, 23 237, mn. II.3.

⁶³¹ BGH GRUR 2008, 885, 886 – Schalungsteil.

⁶³² EPO T 87/90; EPO T 300/86.

⁶³³ BGH GRUR 1966, 255, 256 – Schaufenstereinfassung.

⁶³⁴ EPO G 1/92.

⁶³⁵ BGH GRUR 1966, 255 – Schaufenstereinfassung.

or of any other nature. It is not significant if the possibility is subsequently lost, because everything that becomes state of the art remains so for ever.⁶³⁶

- 392 Information exchanged within a **confidentiality agreement** is not public. However it becomes public if the duty of confidentiality is broken, or it is divulged outside the group of people who have a duty to keep it secret.⁶³⁷ A duty of confidentiality may be **expressly agreed** or be **tacit**⁶³⁸ or **emerge from the circumstances**.⁶³⁹
- 393 If the recipient of the information is in a **special relationship** with its provider, he may not be considered to be a member of the public.⁶⁴⁰ For example the following groups are not deemed to be members of the public: the staff of the company⁶⁴¹, a licensee,⁶⁴² close scientific colleagues⁶⁴³ or fellow staff in a publishing company.⁶⁴⁴ There may be a legitimate expectation of confidentiality arising from (1) the shared purpose and target audience of the imparted knowledge, for example, joint research,⁶⁴⁵ further development⁶⁴⁶ or joint venture,⁶⁴⁷ (2) from commercial or business relationships, such as licensing⁶⁴⁸ or a joint-venture agreement,⁶⁴⁹ (3) from an order to manufacture⁶⁵⁰ or (4) in areas where security is an issue (weapons technology).⁶⁵¹ Common practical experience shows that in such cases of shared interest it is unlikely that a participant, who profits directly or indirectly from the project, would pass on information⁶⁵² about it to third parties, so generally such knowledge would not be considered to be in the public domain.⁶⁵³ Good relationships are of themselves not enough to create a tacit duty of confidentiality.⁶⁵⁴ If the **special relationship ends**, the information that has been kept secret does not enter the public domain because of its ending. There has to be separate action.⁶⁵⁵ A scientific thesis for an academic title is in general not confidential.⁶⁵⁶

⁶³⁶ BGH GRUR 1985, 1035, 1036 – Methylomonas.

⁶³⁷ EPO T 1081/01; BGH GRUR 1962, 518, 520 et seq. – Blitzlichtgerät; BGH GRUR 1966, 464, 484 – Pfennigabsatz; BGH GRUR 1993, 466 – Fotovoltaisches Halbleiterbauelement; BGH GRUR 1996, 747, 751 – Lichtbogen-Plasma-Beschichtungssystem.

⁶³⁸ BGH GRUR 1962, 518, 521 – Blitzlichtgerät; BGH GRUR 1966, 464, 487 – Pfennigabsatz; confidentiality obligation affirmed: EPO T 830/90; EPO T 838/97; EPO T 634/91; EPO T 820/90; EPO T 823/93; EPO T 828/93; confidentiality obligation denied: EPO T 292/93; EPO T 809/95.

⁶³⁹ Confidentiality obligation affirmed: EPO T 1085/92; EPO T 799/91; EPO T 478/99; EPO T 887/90; EPO T 541/92; EPO T 1076/93; EPO T 480/95; Confidentiality obligation denied: EPO T 1309/07; EPO T 173/83; EPO T 958/91; EPO T 87/90; EPO T 809/95.

⁶⁴⁰ EPO T 1081/01.

⁶⁴¹ EPO T 1085/92.

⁶⁴² EPO T 300/86.

⁶⁴³ BGH GRUR 1993, 466, 467 – Fotovoltaisches Halbleiterbauelement.

⁶⁴⁴ BPatGE 35, 122, 126.

⁶⁴⁵ BGH GRUR 1993, 466, 467 – Fotovoltaisches Halbleiterbauelement.

⁶⁴⁶ BGH Mitt. 1999, 362, [mn. III.2 a] – Herzklappenprothese; BIPMZ 1999, 311 – Flächenschleifmaschine; EPO T 1085/92.

⁶⁴⁷ BGH GRUR 1962, 518, 520 – Blitzlichtgerät; BGH GRUR 1987, 297 – Hydraulischer Kettenbandantrieb; BGH GRUR 1996, 747, 749 – Lichtbogen-Plasma-Beschichtungssystem; BPatGE 31, 174, 175; BPatGE 42, 221, 223; BPatG Mitt. 1988, 207; EPO T 830/90.

⁶⁴⁸ EPO T 300/86.

⁶⁴⁹ EPO T 472/92.

⁶⁵⁰ BGH BeckRS 2000, 07 419 – Hydraulische Spannmutter; BGH GRUR 2001, 819 – Schalungselement; EPO T 1081/01.

⁶⁵¹ EPO T 1076/93.

⁶⁵² BPatGE 24, 144, 145.

⁶⁵³ BGH Mitt. 1999, 362, Ziff. III.2 a – Herzklappenprothese; BGH BIPMZ 1999, 311, 313 – Flächenschleifmaschine; EPO T 1085/92.

⁶⁵⁴ EPO T 602/91.

⁶⁵⁵ EPO T 1081/90.

⁶⁵⁶ EPO T 151/99.