
Sufficiency of Disclosure and Enablement

German Federal Court of Justice, judgment dated January 8, 2019 – docket no. X ZR 58/17

Reported by Dr. Axel B. Berger and Dr. Nils Lindenmaier

In its judgment dated January 8, 2019, docket no. X ZR 58/17, the German Federal Court of Justice consolidates its previous case law regarding the requirements of a clear and complete disclosure of an invention. For the purpose of such a disclosure, it is not necessary that all conceivable embodiments covered by the wording of the patent claim may be realized with the aid of the information disclosed in the patent. Rather, it usually suffices if at least one enabling way of achieving the invention is disclosed.

1. Background of the decision

The decision was based on the following facts and circumstances:

The subject matter of the patent-in-suit is an apparatus for the drying of particulate material of a type known as such in which the drying takes place in superheated steam in a closed container, in the upper part of which a dust-separation cyclone is arranged.

According to the patent-in-suit, a disadvantage of the known apparatus type is to be eliminated by means of the claimed apparatus, namely the fact that the steam flow and, thus, the drying capacity cannot be increased without an unacceptably great amount of particulate material simultane-

ously being swept into the dust separation cyclone together with the steam.

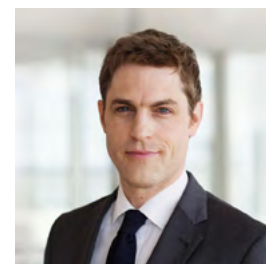
Specifically, the patent-in-suit defines that the problem to be solved by the invention is the provision of an apparatus which has a greater drying capacity than the known types of apparatus, without this giving rise to an increase in the cost of the apparatus, and without any reduction in the quality of the finished product.

To solve the problem, the patent-in-suit provides that at least a half part of the steam is fed into the upper part of the cyclone through corresponding openings instead of not feeding the steam into the bottom part of the dust separation cyclone, or only feeding the steam into said bottom part to a small extent, as was the case in the known types of apparatus.

For this purpose, patent claim 1 suggests an apparatus for drying particulate material in superheated steam, particularly comprising a dust separation cyclone (8) for receiving steam and dust and for separating the dust from the steam, characterized, *inter alia*, in that

5.1 the dust separation cyclone (8) has openings (14) in the **upper part thereof for receiving at least a half part of the steam and dust therefrom,**

and



Dr. rer. nat., Docteur,
Dipl.-Biol. Axel B. Berger
*German and European
Patent Attorney, Partner*



Dr. rer-nat., M. Sc.
(Chemistry)
Nils Lindenmaier
*Patent Engineer, Trainee
Patent Attorney*

BARDEHLE PAGENBERG
Partnerschaft mbB
Patentanwälte Rechtsanwälte

Prinzregentenplatz 7
81675 Munich
T +49.(0)89.928 05-0
F +49.(0)89.928 05-444
info@bardehle.de
www.bardehle.com

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5.2 that **the residual steam and dust, if any**, is fed to the cyclone (8) **from below**.

The Plaintiff filed a nullity complaint against the patent-in-suit with the German Federal Patent Court, *inter alia* on the grounds for nullity of a lack of enabling disclosure, in particular with respect to the aforementioned feature group 5. The Plaintiff argued that the instruction of feeding at least a half part of the steam and dust to the dust separation cyclone through the openings (14) in the **upper part** thereof and feeding the residual from below was not enabled because feeding x% of steam and dust to the openings (14) in its upper part and feeding (100 - x)% of steam and dust from below in a targeted manner is technically impossible.

2. The Decision of the German Federal Patent Court

The German Federal Patent Court dismissed the nullity complaint as unfounded and, in particular, affirmed the enabling disclosure of the invention. In its statements of grounds, the German Federal Patent Court also made reference to the worked example described in the patent-in-suit, according to which all of the steam and dust is fed through openings in the upper part.

3. The Decision of the German Federal Court of Justice

In reaction to the Plaintiff's appeal, the German Federal Court of Justice confirmed the decision by the German Federal Patent Court and dismissed the appeal, stating the following:

The embodiment of the patent-in-suit shows how a vaporization dryer in accordance with the claim features has to be designed. Said example also corresponds to features 5.1 and 5.2 in that the dust-containing steam is exclusively fed through the openings arranged in the upper part of the dust separation cyclone. The variation of feeding a part of the dust-containing steam to the dust separation cyclone from the bottom, according to feature 5.2, does not describe any different teaching in this regard. The German Federal Court of Justice explicitly followed the finding by the German Federal Patent Court, according to which this may be gathered from the parenthetical phrase "*if any*" in feature 5.2. Thus, to enable realization of the teaching of said claim, showing a subject matter in which the dust-containing steam is exclusively fed from the top by means of the embodiment in the patent-in-suit is sufficient, according to the German Federal Court of Justice.

Comments

The present decision confirms the principle regarding enabling disclosure that had previously been defined by the German Federal Court of Justice, according to which the person skilled in the art has to be able to realize the teaching of the patent claim without inventive skill and without undue burden based on the whole disclosure of the patent specification, including the description and the drawings, in combination with the common general knowledge of the skilled person on the date of filing or priority and to practically realize it in such a manner that the desired success is achieved. For this purpose, however, it is not necessary that all conceivable embodiments covered by the wording of the patent claim may be realized with the aid of the information disclosed in the patent.

The European Patent Office (EPO) applies the enablement regulations in a more stringent manner in this regard. While disclosing a way in which the person skilled in the art may carry out the invention is usually sufficient, even in the practice of the EPO, this only applies if the invention may also be realized in the whole area claimed on this basis. Therefore, in the present case, the EPO could conceivably have considered the provision of only one enabling way of the claimed invention in the form of the threshold value of 100:0% not sufficient regarding the distribution of 50:50% to 100:0% of the steam and the dust in the upper part claimed by means of feature 5.1. This would have been conceivable at least if the person skilled in the art had not been able to realize the full range up to a distribution of 50:50% on this basis without undue burden.