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Prior public use- life experience counts-
a commentary on the decision BGH X ZR 75/18

In the decision BGH X ZR 75/18 of April, 21, 2020, "*Konditionierverfahren*", which is reproduced in excerpts below, the BGH (Federal Court of Justice) has consistently continued and further consolidated its previous case law practice on prior public use by stating:

> *Delivery, installation and commissioning of a system at a buyer's premises do not automatically constitute a sufficient likelihood that any third party will examine the system and thereby obtain knowledge of an invention.*

The underlying facts of the case were that at the end of the year 2000, the defendant in a nullity case delivered a system to a customer (a major semiconductor manufacturer) for carrying out a process for conditioning semiconductor wafers and/or hybrids, which had all the features of the granted independent patent claims 1 and 5 of the patent in dispute.

The system in question was operated in a clean room-like factory building of the customer. The features constituting novelty and inventive step were implemented in the delivered device in such a way that in practice only a quasi-irreversible destruction of the high-quality substantial component of the system, a cooling device (chiller), could have revealed the invention in detail.

According to established case law, prior use is known to the public if the - not only theoretical and not only remote – opportunity is provided that any third party, and thus also skilled persons, may obtain reliable and sufficient knowledge of the invention (see e.g. BGH, decision of December 9, 2014 –X ZR 6/13, GRUR 2015, 463 margin no. 39 - *Presszange*, decision of November 8, 2016 - X ZR 116/14 margin no. 25).

According to the BGH, the existence of these requirements may be assumed on the basis of life experience if a device according to an invention has been offered or supplied to a third party (BGH, GRUR 2015, 463 margin no. 39 - *Presszange*).

However, the offer or delivery of a device according to an invention does not lead to notoriousness without further ado even if the customer is not liable to a secrecy agreement. If a secrecy agreement has not been agreed to and confidentiality is not to be expected in any other way, one may generally assume that upon delivery the knowledge of the invention has been disclosed to the public and that the opportunity – which in any case does not appear impossible - has been created for any third party to obtain knowledge of it (BGH, decision of November 8, 2016 - X ZR 116/14, margin no. 26), but even in such situations, however, a mere theoretical or remote opportunity of obtaining knowledge is not sufficient.

In the present case it was not possible to substantiate an explicit or implied confidentiality agreement with the customer.

Also, the BGH did not assume in the present case that the system was delivered in the framework of a development project.

Although these "examples of rules" with respect to obligation of secrecy and development cooperation, which are already known in case law, were not accepted

by the BGH in the present case, the reverse conclusion could not be drawn from this, namely that prior public use was on hand.

On the contrary, in the present decision the BGH has again clearly shown that it is a matter of the particular individual case and the particular answer to the question whether the - not only theoretical and not only remote -opportunity has been created that any third party, and thus also skilled persons, may obtain reliable and sufficient knowledge of the invention (see for example BGH, decision of December 9, 2014 –X ZR 6/13, GRUR 2015, 463 margin no. 39 - *Presszange*, decision of November 8, 2016 - X ZR 116/14 margin no. 25).

In particular, the BGH concluded in the present case that in the present case the delivery, installation and commissioning of the system at the customer's premises did not provide a sufficient opportunity that any third party could inspect the system and, in particular, figure out the main feature, namely that the air used for conditioning the receiving unit is tempered in a subsequent step by means of a concealed heat exchanger in the cooling device (chiller) and that the air is supplied into a wafer prober room.

Before the priority day, the employees of the customer were not able to obtain knowledge of the internal structure of the cooling device and its function during normal operation of the system. The customer's employees did not maintain and repair the cooling device themselves during the relevant period of the alleged prior public use. According to a statement of a witness, the supplier was responsible for this. Thus, the employees of the customer definitely did not know how the system was designed and how the system functions. They were not allowed to make any changes to the cooling device except for changes to the measuring software.

A closer inspection of the system by third parties was not possible without consent of the customer.

The system was located in a cleanroom-like factory building to which only a limited number of people had access. This means that there is no sufficient opportunity that any third party could enter the factory building and examine the system.

Witness testimonies, according to which technicians from outside the company were allowed to enter the factory building for the purpose of maintenance and troubleshooting of other systems and which technicians were not under constant observation at the same time, provided at best a theoretical opportunity of obtaining knowledge.

In order to gain knowledge of the invention, the respective persons would have had to tamper with the system without authorization. According to the BGH, this might not be theoretically impossible, but a sufficient opportunity for this could only be affirmed if there were concrete indications for this, e.g. that the customer had tolerated or even encouraged such behavior. The latter was not the case.

It therefore seemed rather unlikely in the particular individual case that such investigations would have gone unnoticed. In doing so, the plaintiff assumed that knowledge of the basic mode of operation could already have been obtained by a hand probe. However, even for this purpose, the entire prober system would have had to be taken out of operation and three air lines between the cooling device and the probing table would have had to be disconnected. The fact that the customer would have tolerated such interventions by a third party not authorized to do so seemed remote, not only because the customer himself had no apparent interest in such actions.

There was also no sufficient opportunity that employees of the customer could have attempted to obtain knowledge of the functioning of the cooling system until the

priority date of the patent in dispute, or that they could have given third companies, in particular competitors of the defendant, access to the system for this purpose.

As mentioned above, installation, maintenance and repair of the system were the sole responsibility of the supplier. The customer's interest in a functioning device was thus complied with. The customer therefore had no reason to give this any consideration.

The fact that the customer himself wanted to manufacture or sell systems according to the invention and that the customer could therefore have been interested in obtaining knowledge of how the cooling system worked was not raised, nor was it otherwise obvious.

There were also no indications that the customer had an interest for other reasons in obtaining more detailed knowledge about the function of the cooling system or the cooling device, respectively.

Such an interest could be justified by considering at best a circumstance that a competitor of the defendant could copy the system and offer it to the customer at a lower price, as was argued by the plaintiff.

The fact that the customer would have agreed to this appeared, not alone for that reason, unlikely because the customer would have had to accept tampering with the system causing certain financial disadvantages, but in return the customer would at best have obtained a vague prospect of a more favorable source of supply.

In order to understand the construction of the cooling device in a concrete and reliable manner, a hand probe would not have been sufficient in the opinion of the BGH. Rather, at least the insulating foam of the cooling device would have had to be removed, which would have necessitated a repair.

Rather more obvious seemed to be the possibility that the customer would sell the system to a third company after the end of its useful life. In the period between the delivery of the system and the priority date of the patent in dispute, however, such a process was not to be expected.

The fact that, according to the findings of the patent court, the defendant offered systems of the same type for sale to an unlimited circle of companies did not lead to a different assessment either.

However, the subject matter of the patent in dispute would have become public if the layout according to the invention would have been obvious from the offer itself. However, no evidence of this was submitted or apparent in any other way.

In view of these facts, the BGH dismissed the attack of the plaintiff with regard to an alleged prior public use.

The approach adopted by the BGH shows that the BGH ascribes a central role to general life experience in the assessment of a possible prior public use and consistently rejects the dogmatically theoretical approach.

It has also been made clear once again in the present case that in order for the plaintiff to prove prior public use, concrete evidence must be provided that the opportunity is not only theoretical and not only remote that any third party, and thus also skilled persons, may obtain reliable and sufficient knowledge of the invention.

This also corresponds to the previous case law of the BGH. For example, the BGH has already decided that no prior public use is to be assumed if patented formwork elements have been used in the priority interval on a construction site, because unlike upon delivery of patented objects to third parties for resale, where this is regularly the case, an equally typical situation is not involved upon usage on a construction site

(BGH GRUR 01, 819 (IV) *Schalungselement*). Here, too, the BGH had taken into account the essential fact that third parties will regularly not be able to readily enter a construction site. Typically, it is also not to be expected that competent third parties will enter a construction site without a particular reason. The inspection possibilities for third parties on construction sites are not the same a priori as in the case of a delivery based on alienation. Building materials may not simply be taken away by third parties and be subjected to an inspection. On a construction site, therefore, one may not readily expect a not-unlikely opportunity to obtain knowledge of an embodiment of a component which embodiment is not discernable on the basis of mere visual inspection (see BGHZ 136, 40, 47, 51 - *Leiterplattennutzen*; senate decision of March, 5, 1996 -X ZB 13/92, GRUR 1996, 747 – *Lichtbogen-Plasma-Beschichtungssystem*).

For the practice of lawyers, this decision means that the proof of prior public use by the plaintiff in a nullity case is a major hurdle and regularly includes aspects which are usually difficult or impossible for the plaintiff in a nullity case to access.

In conclusion, it is worth mentioning regarding the present case that the entire facts of the case refer back more than 15 years and that in the end it was not the vague statements of the witnesses but the particular interests of the user and the general life experience that were considered primarily relevant for the decision.

Taking all this into account, the BGH decided directly in the present case, even taking into account that the documents have not been further discussed in the Patent Court's decision, and did not remand the case.

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