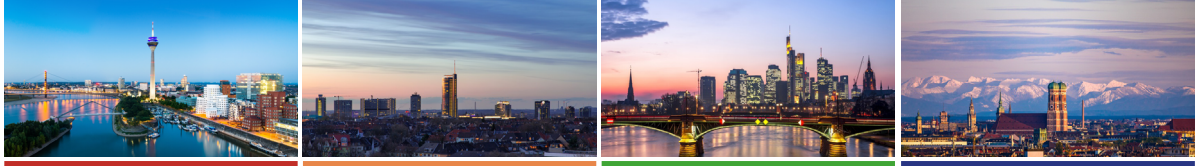

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G 1/19 - Existing case law practice for computer-implemented inventions also applies to computer-implemented simulations

Pyrrhic victory for Amazon (?) - The Federal Court of Justice decision „Davidoff Hot Water IV“

MICHALSKI · HÜTTERMANN

PATENTANWÄLTE

G 1/19 - Existing case law practice for computer-implemented inventions also applies to computer-implemented simulations

The Enlarged Board of Appeal (EBA) of the European Patent Office has published its decision G 1/19[1]. It has ruled that the computer-implemented simulation of a technical system or process can solve a technical task by generating a technical effect that goes beyond the implementation of the simulation on a computer.[2]

In this context, it is not a sufficient condition for assessing whether a computer-implemented simulation claimed as such solves a technical problem that the simulation is based at least in part on technical principles underlying the simulated system or process. Rather, even in the case of numerical simulations, it must be examined on a case-by-case basis whether the usual „technicity" criteria for computer-implemented inventions are met.[3]

No special standards apply just because a simulation is part of a design process.[4]

In an applicant's appeal, the referring board of appeal had to decide on a claim that simulated the movement of a plurality of pedestrians in a spatial environment. In this context, the claim included, inter alia, a dissatisfaction function for taking a step and an inconvenience function for a deviation from direction.

The examining division had disregarded all features of the simulation for lack of technical character and therefore only assessed the generic term of the claim. This defined a simulation method which was accordingly considered obvious.

Also according to the EBA, a simulation itself is initially non-technical.[5] It thereby agrees with decisions according to which algorithms only contribute to the technical character of a computer-implemented process if they serve a technical purpose.[6] In this respect, a further technical use of the results of a simulation could, for example, have an impact on physical reality. Similarly, a simulation could result in an adaptation of the computer or its operation. Such technical use or adaptation of the computer or its functioning must therefore be indicated in the claim, according to the EBA.[5]

Also for the evaluation of computer-implemented simulations the COMVIK ap-

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Together with Dr. Daniel Jendritza from the VDI Niederrheinischer Bezirksverein and Gordon Gemein from Gründungsberatung Niederrhein, Wasilis Koukounis is organizing the event „Innovativ Gründen" (Innovative Founding) on June 10 at our Düsseldorf premises as part of this year's Startup Week Düsseldorf. The event is planned as a hybrid, i.e. with both presence and online participation.

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1 Cf. our Newsletter 3/2019, available at: https://documents.epo.org/projects/babylon/eponet.nsf/0/99f4b971c9e3eb2fc125869400340179/$FILE/G_1_19_decision_of_the_Enlarged_Board_of_Appeal_of_10_March_2021_en.pdf

2 The first question referred was thus answered in the affirmative

3 The second question was reworded accordingly in part B, part A was not admitted.

4 The third question could thus be answered very briefly

5 No. 137 of the reasons for the decision

6 No. 112 of the reasons for the decision with reference to T 1358/09 and T 1784/06

proach is suitable in the eyes of the EBA.[7] The EBA points out that the COMVIK approach is not mandatory,[8] but that it is a „practicable system"[9].

The current approach to the examination of computer-implemented inventions actually involves three stages[10]: 1. Is it an invention? 2. Does a feature in question contribute to the technical character of the invention? 3. Is the invention based on an inventive step with respect to the closest prior art?

Of course, features to be considered must not only contribute to the technical character of the claimed subject-matter,[11] and over the entire claim scope,[12] but also to the solution of the technical task, and also with respect to the entire claim scope.[13] As an illustration, EBA cites the simulation of a billiard ball being played in a computer game, which does not solve any technical problem.[14]

The decision of the EBA is extremely detailed and even includes a chart on technicality.[15] The EBA does not spare with warnings regarding the patentability limits for computer-implemented inventions. For example, with respect to simulations, it explicitly sees quite narrow limits to the consideration of potential or merely calculated technical effects.[16] Also, the fundamental question of technicity seems to be only partially clarified, so that further fundamental decisions in this respect can be expected for the future.

In Our Own Affairs : EQE Preparatory Courses 2021

If the pandemic situation allows, our office will offer two free two-day preparatory courses for the C and D parts of the European Qualifying Examination (EQE exam) in 2021. The courses will be held on Monday/Tuesday, November 22/23, and Saturday/Sunday, December 4/5, 2021. Both courses are identical in content, so attending one course is sufficient.

The course content is primarily focused on appropriate exam techniques as well as strategies for avoiding mistakes in order to be able to successfully tackle the C and D parts of the EQE exam with these skills. It has been our experience that well-prepared exam materials significantly increase the chances of success. Therefore, we want to provide the participants with the necessary methodological knowledge in this course. In this respect, the course is to be understood as a supplement to the participants' own preparation of the legal fundamentals of the EPC. Instead, participants will learn how to convert their technical knowledge of the EPC into as many points as possible for passing the C and D parts of the EQE examination. The courses take place in Düsseldorf at our premises in Speditionstr. 21 and are free of charge. Speakers of the course are Dr. Torsten Exner, Dipl.-Ing. Andreas Gröschel and Dr. Aloys Hüttermann.

Registration is now possible (please state your full name and employer) at eqe@mhpatent.de.

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7 No. 136 of the reasons for the decision

8 No. 61 of the reasons for the decision

9 With reference to G 3/08, there No. 10.13.1 and No. 10.13.2 of the decision reasons

10 No. 39 of the reasons for the decision

11 No. 80 of the reasons for the decision

12 No. 84 of the reasons for the decision

13 No. 82 of the reasons for the decision

14 No. 119 of the reasons for the decision

15 No. 85 of the reasons for the decision prefixed

16 No. 133 of the reasons for the decision: Decision T 1227/05 is not generalizable to simulations in general.

Pyrrhic victory for Amazon (?) - The Federal Court of Justice decision „Davidoff Hot Water IV“

A few days ago, the German Federal Court of Justice published the decision „Davidoff Hot Water IV“[17], which, among other things, dealt with Amazon's obligations when operating the „Amazon Marketplace“, i.e. a platform on which third parties can sell goods via Amazon.

In the underlying case, an authorized licensee of the „Davidoff Hot Water“ brand had purchased perfume from a third-party seller operating on Amazon Marketplace. Perfumes from the seller were stored at an Amazon subsidiary in Bavaria under the „Shipping by Amazon“ program. Next, the licensee had asked the seller (who was not a party to the lawsuit) to cease and desist on the grounds that the perfume sold was not exhausted merchandise.[18] The seller then also issued this cease-and-desist declaration.

However, the licensee was not yet satisfied with this, he first requested Amazon to hand over all of the seller's perfumes to him. Amazon then sent a package containing 30 of these perfumes. However, after another Amazon subsidiary[19] informed the licensee that eleven of the 30 pieces sent came from the stock of another seller, the licensee requested Amazon to provide the name and address of this other seller because 29 of the 30 perfumes had not been exhausted. Amazon then informed the licensee that it was no longer possible to trace from which inventory the eleven pieces mentioned originated.

The licensee then sued Amazon[20] and the subsidiary operating the warehouse for trademark infringement and, in the alternative, for interference liability.

However, both the Munich Regional Court and the Munich Higher Regional Court dismissed the action, but an appeal was allowed and also filed. In the appeal proceedings, the Federal Court of Justice now found that it must first ask the ECJ whether Amazon and the subsidiary had even independently committed a trademark infringement, or more precisely:

„Does a person who stores trademark-infringing goods for a third party, without being aware of the infringement, possess those goods for the purpose of offering or putting them on the market when it is not the person himself, but the third party alone, who intends to offer or put the goods on the market?“

The ECJ[21] denied this, whereupon the proceedings were continued before the

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Dr. Aloys Hüttermann will be speaker at the PATENTE 2021 - Conference on June 28/29 in Munich on the topic: „The Unitary Patent System is Coming - This Time for Real?“

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17 Federal Court of Justice, judgment of January 21, 2021 I ZR 20/17- Davidoff Hot Water IV

18 Note: This is not further substantiated in the judgment, apparently this circumstance was undisputed between the parties.

19 Note: Who this subsidiary is is not further specified in the judgment, and it was probably not involved in the proceedings.

20 More precisely: the European subsidiary in Luxembourg, this shall be called „Amazon“ in the following

21 Judgment of April 2, 2020, C-567/18

Federal Court of Justice. As a result, the Federal Court of Justice denied claims against the subsidiary and claims for trademark infringement against Amazon. However, it found that there were indeed claims against Amazon based on „Störerhaftung" (Breach of Duty of Care) - and that there was a duty to examine and provide information:

„The fact that [Amazon] itself had no knowledge of the origin of [the seller's] products and the question of their exhaustion under trademark law does not preclude the assumption of a corresponding duty to examine. It was possible for [Amazon] to obtain information about the origin of the goods by inquiring at [the seller] on the basis of the plaintiff's notice. The use of this possibility of knowledge was also reasonable for it, because the effort required for this would have been only small and the examination of a subsequent information [of the seller] cannot be regarded as overtaxing from the outset.[22]*"*

The case was thus returned to the Munich Higher Regional Court accordingly.

As a result, from a neutral point of view, the ruling can probably be seen as a kind of Pyrrhic victory for Amazon. Although it was made clear that Amazon and its subsidiaries did not commit any trademark infringement of their own, claims for information - and corresponding testing efforts - will be enforceable against Amazon and, of course, all other companies that operate platforms in a similar manner due to the „Störerhaftung" (Breach of Duty of Care).

[22] Paragraph 61 of the decision

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We wish your relatives, employees, colleagues and of course yourself all the best for the current, still difficult time.

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