OLG Karlsruhe, decision of July 18, 2023 - 6 W 30/23

Reference openJur 2023, 7501 Rkr: □ AmtlSlg: □

1. The recall within the meaning of Sec. 140a (3), 1st sentence Alt. 1 PatG is generally to be enforced as an unenforceable act under Section 888 Code of Civil Procedure (ZPO).

2. In the distribution channels, the infringing object that is not with a private end user is also with a trader who is not a trader but uses the object himself as an end user.

3. A sufficient possibility of further distribution for the recall claim may result from the fact that it is conceivable under the circumstances that an object provided by the industrial customer with the infringing product will be sold by the industrial customer (such as here a property in which infringing aluminum planks were installed as flooring).

Tenor

1. 1. The immediate appeal of the judgment debtors against the decision of the District Court Mannheim of May 19, 2023, file no. 2 O 86/21 ZV II, is dismissed.

2. 2. The judgment debtors shall bear the costs of the immediate appeal.

3. 3. The appeal on points of law is admitted.

Reasons

4. I.

5. The District Court has, inter alia, the enforcement debtors here (hereinafter debtors) on the complaint - based on alleged patent infringement in the distribution of the product "A[...] plank" as "outdoor aluminum flooring" - the enforcement creditor (hereinafter: creditor) with final partial judgment of 5. July 2021, file no. 2 O 86/21 (main volume there, AS I 66 et seq.; hereinafter LGU), in particular ordered to "recall or permanently remove from the distribution channels" certain aluminum floorboards for the manufacture of a covering device in accordance with specifications specified therein. At the request of the creditor, the District Court imposed coercive fines of EUR 1,000 each, or alternatively one day for each EUR 500 - to be executed on [...] as legal representative with respect to the first debtor and on [...] as legal representative of the second debtor - to enforce these acts imposed on the debtors. For the details, reference is made to the reasons of the decision of the District Court. In their immediate appeal against this decision, which seeks to have it set aside, the debtors state that a recall is not possible; there is nothing left in the distribution channels; the products placed on the market have all been installed in the end consumer's home and have thus become the property of the end consumer. The District Court decided not to grant the appeal. For the details and the precise requests, reference is made to the contested decision.

6. II.

7. The debtors' admissible immediate appeal remains unsuccessful on the merits.

8. 1. The application for enforcement is admissible and well-founded and justifies the means of enforcement imposed.

9. a) According to the correct and unobjectionable findings of the District Court, the general prerequisites for compulsory enforcement, in particular a title issued in favor of the (merely renamed) creditor, are present.

10. b) The District Court also correctly recognized that the present order to recall "or" remove is to be enforced by the requested fixing of a penalty payment pursuant to Section 888 of the Code of Civil Procedure (ZPO). This follows from the fact that at least one of these two actions is not justifiable and the judgment leaves the debtors the choice as to which of the two actions they take with respect to each item.

11 aa) The conduct required under the title consists in "recalling the products specified therein or permanently removing them from the distribution channels" (in conjunction with the declarations to the addressees further required in the title). While the substantive basis for the claim in Sec. 140a (3) sentence 1 Patent Act, on which the judgment is based according to its grounds, uses the conjunction "or" to give the creditor the choice of demanding recall or removal or both in parallel (see BGHZ 215, 89 para. 11 et seq. - sealing system), the present judgment uses the same conjunction to give the debtors to whom it is addressed the choice between recall or removal. This is confirmed by the reasons for the judgment, which must be consulted for the interpretation of the title (see Federal Supreme Court (BGH), GRUR 2015, 1248 para. 20 mwN - Toner cartridges; GRUR 2017, 208 para. 22 - Recall of RESCUE products). The District Court expressly assumed in its order as requested that the creditor had placed the recall and removal from the distribution channels in an alternative relationship to the defendant's choice with the claim (LGU 15).

12 bb) If at least one of these optional acts proves to be unjustifiable, the debtors' right to choose cannot be overridden by the creditor being authorized to perform the alternative under section 887 of the Code of Civil Procedure (ZPO) if it is a justifiable act, but the only option is to require the debtors to perform the alternative - left to their choice - under section 888 of the Code of Civil Procedure (ZPO).

13 cc) At least the recall offered to the debtors at their choice is generally - and also here - not a representable act to be enforced under section 887 of the Code of Civil Procedure (ZPO), but is to be enforced as a non-representable act under section 888 of the Code of Civil Procedure (ZPO).

14 This position already taken by the Senate (decision of July 21, 2020 - 6 W 40/19, unpublished) corresponds to an apparently unanimous view in case law and also to a widespread view in the literature (Düsseldorf Higher Regional Court, GRUR 2022, 79 f - Rückrufvollstreckung I; MittdtschPatAnw 2022, 142 - Rückrufvollstreckung II; Düsseldorf District Court I, judgment of December 2, 2021 - 7 O 10571/20, juris para. 199; Kühnen, Handbuch der Patentverletzung, 15th ed, Chap. D para. 1056; Chakraborty/Haedicke in Haedicke/Timmann, Handbuch des Patentrechts, § 15 para. 761 f; Wirtz in Ingerl/Rohnke/Nordemann, MarkenG, 4th ed., § 18 para. 50; BeckOK-MarkenR/Miosga, as of Apr. 2023, MarkenG § 18 para. 111, both mwN; Haft in Cepl/Voß, Code of Civil Procedure (ZPO), 3rd ed, § 888 para. 2; Kaess in Busse/Keukenschrijver, PatG, 9th ed., § 140a para. 33; Loth/Pantze, GebrMG, § 24a para. 32; Kefferpütz in Wandtke/Bullinger, Urheberrecht, 6th ed., UrhG § 112 para. 68). The deviating literature opinion (Jestaedt, GRUR 2009, 102, 104; Grabinski/Zülch/Tochtermann in Benkard, PatG, 12th ed. § 140a para. 22; Mes, PatG, 5th ed. § 140a para. 29; Fezer, Markenrecht, 4th ed. MarkenG § 18 para. 79; Jansen in: Ekey/Bender/Fuchs-Wissemann, Markenrecht, 4th ed., MarkenG § 18 para. 53; Wimmer in Schricker/Loewenheim, Urheberrecht, 6th ed., UrhG § 98 para. 26; restrictively BeckOK-PatR/Fricke, status Apr. 2023, PatG § 140a para. 57 mwN zum Streitstand) the Senate disagrees.

15 An invitation to the owners of the infringing goods, which is dedicated to the recall but is issued by third parties (including the creditor), is not suitable to induce the parties involved in the distribution channels to return the infringing goods to the same extent as an invitation issued by the debtor personally. The declaration of the debtor himself to the addressee of the recall that he is prepared to take back the infringing goods against reimbursement of costs is, in addition to raising awareness of the infringement, a further significant incentive for the customers to return the goods. This cannot be equally achieved by the mere declaration of a third party that the debtor is obliged to do so, which does not bind the debtor in relation to the addressee of the recall (cf. Kühnen, loc.cit.). Moreover, a recall by a third party is excluded in particular if the creditor - as is regularly the case - has no or at least less comprehensive or secure knowledge of the debtor's customers (cf. Düsseldorf Higher Regional Court, GRUR 2022, 79 f - Rückrufvollstreckung I; Kühnen, ibid.; see also BeckOK-PatR/Fricke, ibid. for this case).

16 dd) In view of the above, it is irrelevant whether an order for (unconditional) removal from the distribution channels would be enforceable under Sec. 887 Code of Civil Procedure (ZPO), as long as no personal removal measures are required (see Grabinski/Zülch/Tochtermann in Benkard, Patent Law, 12th ed. Sec. 140a para. 22; Kaess in Busse/Keukenschrijver, Patent Law, 9th ed, § Sec. 140a para. 33; Chakraborty/Haedicke in Haedicke/Timmann, Handbuch des Patentrechts, Sec. 15 para. 761, 763; Kühnen, Handbuch der Patentverletzung, 15th ed., chap. D para. 1056; Haft in Cepl/Voß, Code of Civil Procedure (ZPO), 3rd ed., Sec. 888 para. 2; BeckOK-PatR/Fricke, Apr. 2023, PatG Sec. 140a para. 58).

17 c) The further factual requirements of the means of coercion under Section 888 of the Code of Civil Procedure (ZPO) are met.

18 aa) The Complaint does not challenge the District Court's correct finding that, according to the record, the Debtors did not take any action at the time of the contested decision to comply with their obligation to recall or permanently remove from the distribution channels. The complaint does not assert any new facts in this respect.

19 bb) The appeal merely contains - permissibly (§ 571 (2) sentence 1 Code of Civil Procedure (ZPO)) - new factual submissions with which the debtors wish to justify the objection of impossibility from a legal point of view. They are unsuccessful in doing so. It is true that impossibility is in principle relevant in enforcement proceedings (see Federal Supreme Court (BGH), GRUR 2009, 794 para. 20 mwN - Auskunft über Tintenpatronen; NJW 2022, 393 para. 58 mwN). Whether this only applies if the reasons cited for the impossibility occurred after the point in time of the proceedings referred to in Section 767 (2) of the Code of Civil Procedure (ZPO) or at least were not "the subject of the proceedings" (BAG, NZA 2023, 590 para. 15 f; BAGE 130, 195 para. 25; aA Lackmann in Musielak/Voit, ZPO, 20th ed., Section 888 para. 9) can be left open. The facts presented are not suitable to support the objection of impossibility. They are also not relevant from another legal point of view.

20 (1) The objection must in any case remain unsuccessful as long as, with regard to the objects designated in the title, both the recall provided for in the judgment and the removal provided for therein are not (cumulatively) impossible or excluded for other legal reasons to be examined in the enforcement proceedings. It is true that the title allows the debtors to choose between these two actions. However, in the event that one of these actions is excluded, the obligation to perform the other remains, unless the latter is also excluded (see Section 265 German Civil Code (BGB)).

21 (2) Here, even on the basis of the debtors' submissions, it cannot be seen that a recall, in particular, as designated in the title, is excluded with regard to products named therein.

22 (a) The terms recall and removal from the distribution channels are obviously intended to have the same meaning in their use in the conviction as in Sec. 140a (3) sentence 1 Patent Act. It is admittedly irrelevant for the interpretation of the conviction which claims under substantive law the creditor is entitled to (see Federal Supreme Court (BGH), GRUR 2015, 1248 paras. 21, 23 cit. - Toner cartridges; GRUR 2017, 208 para. 22 - Recall of RESCUE products). However, according to the reasons for the judgment to be considered for interpretation (see above), among others, it is clear that the title intends to use these mentioned terms in the same way as the law (LGU 15). Therefore, the limits of the sentence in this respect coincide with the principles recognized with regard to the statutory duties to recall and remove from the distribution channels.

23 (b) Accordingly, the recall is in particular not rendered irrelevant and thus excluded by the fact that the aluminum planks affected by the acts of use of the debtors may have all already reached - unspecified - end users.

24 (aa) The subject matter of the recall under Sec. 140a (3), 1st sentence, alt. 1 Patent Act, as in the case of removal pursuant to Sec. 140a (3), 1st sentence, alt. 2 Patent Act is merely to remove products "from the distribution channels". This wording of the insofar linguistically ambiguous law refers to both alternatives (see BGHZ 215, 89 para. 32 - sealing system: "recall from the distribution channels"), as is also clear from the objective pursued thereby of implementing Art. 10 (1) sentence 1 letter a ("recall from the distribution channels") and letter. b ("final removal from the distribution channels") of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (Enforcement Directive) (cf. Grabinski/Zülch/Tochtermann in Benkard, PatG, 12th ed, § Sec. 140a para. 17b mwN). The duty to recall thus neither presupposes that the debtor has power of disposal over the objects affected by the recall (BGHZ 215, 89 para. 29 et seq. - sealing system), nor that the product has not reached an end user. In the distribution channels, the infringing item, which is not located with a private end user, is rather also located with a trader who is not a trader but uses the item himself as an end user, for example for production purposes. For here, too, it is conceivable that the item is later sold second-hand, encroaching on the exclusive right of the patent owner in the course of commercial activities (see Sec. 11 No. 1 Patent Act) (see Senate, judgment of 8. April 2015 - 6 U 92/13; judgment of July 21, 2020 - 6 W 40/19, both unpublished; Düsseldorf Higher Regional Court, GRUR-RR 2021, 421, 428 mwN - Montagegrube; judgment of August 13, 2020 - 2 U 10/19, juris para. 163 mwN; Grabinski/Zülch/Tochtermann in Benkard, PatG, 12th ed, § Sec. 140a para. 17b; Kühnen, Handbuch der Patentverletzung, 15th ed., ch. D para. 1008; aA LG Mannheim, InstGE 12, 200 - Nitrogen monoxide evidence; Jestaedt, GRUR 2009, 102, 104; Jestaedt in Jestaedt/Fink/Meiser, DesignG, 7th ed., Sec. 43 para. 22). The purpose of the recall is also to clear the market of infringing products and thus to create a new demand for lawful invention products for the benefit of the IP right holder (Senate, decision of July 21, 2020 - 6 W 40/19, unpublished).

25 (bb) Accordingly, the aspect of the debtors' submission according to which the products in question are to be found "with the end consumer" is irrelevant. Because this does not exclude that there are commercial customers among the end consumers. It cannot be inferred from the debtors' submissions that they (exclusively) mean consumers within the meaning of Section 13 of the German Civil Code (BGB). Rather, the term "end consumer" used by the complaint merely expresses that the goods have reached their final purchasers, where they have been "consumed" by installation.

26 (c) Of course, the fact that the products to be recalled may have become the property of their customers (in the opinion of the complaint by installation, but possibly already beforehand at the time of delivery) is not an obstacle for at least the recall.

27 (d) The fact that the aluminum planks in question here are to be installed at the end users does not exclude the recall obligation either.

28 This circumstance cannot give reasons for impossibility anyway, at least as long as dismantling and return of the infringing goods by their end user are not impossible. Recall in this sense is (merely) the debtor's request to his customers to return the infringing products delivered by him. Whether the customers comply with this request is left to their decision and has no effect on the debtor's liability. Rather, the debtor must make all reasonable efforts to persuade the customers to return the products on the basis of the request (BGHZ 215, 89 para. 17 mwN - Abdichtsystem). It has not been claimed that it would not be possible to dismantle the aluminum planks placed on the market by the debtors (and that a recall would therefore have to come to nothing). In this respect, it could therefore at most be considered that a recall could be disproportionate or unreasonable for the debtors due to the fact that the items may have been installed at the customers. Whether the objection of unreasonableness or disproportionality under Sec. 140a (4) Patent Act is excluded in any case in compulsory enforcement proceedings (thus Düsseldorf Higher Regional Court, decision of November 25, 2019 - I-2 W 15/19, juris para. 3 et seq.; Kühnen, Handbuch der Patentverletzung, 15th ed., chap. D para. 1038), therefore does not need to be discussed here. Impossibility, disproportionality, unreasonableness or other grounds for exclusion cannot be discerned in the circumstance that the infringing products have already been installed, in each case at least for the result, because neither the lack of a likelihood of success nor other reasons arise from this, according to which the interest which the creditor has in a request by the debtors to the purchasers which meets the requirements for a recall would be out of proportion to the associated disadvantages of the debtors.

29 (aa) In particular, the recall is not precluded by the fact that isolated resale of aluminum planks already installed is not to be expected.

30 In principle, a recall claim is only excluded if it is ruled out that the infringing products will be distributed further at a later date (cf. Higher Regional Court Düsseldorf, judgment of August 13, 2020 - 2 U 10/19, juris para. 163; cf. Higher Regional Court Düsseldorf, GRUR-RR 2021, 421, 428 - Montagegrube). This corresponds to the purpose of the recall claims standardized by special law to provide abstract and thus further protection. Its creditor can demand the recall of all infringing products per se, even if this recall does not directly serve to prevent concretely threatening further acts of infringement (see Federal Supreme Court (BGH), GRUR 2018, 292 para. 30 - Produkte zur Wundversorgung). However, according to the case law of the Senate (judgment of January 24, 2018 - 6 U 149/16, unpublished), mere theoretical resale possibilities due to conceivable residual stocks at individual customers do not preclude an exclusion of the recall claim under Sec. 140a (4) Patent Act due to disproportionality if it is established that the by far predominant part of the infringing articles manufactured and distributed during the patent term has been consumed or must be disposed of. However, a sufficient possibility of further distribution for the existence of the recall claim may arise if it is conceivable under the circumstances that an item provided with the infringing product by the industrial customer will be sold by the latter, which would infringe the exclusive right of the patent owner with regard to the patented products then also sold (see Düsseldorf Higher Regional Court, judgment of August 13, 2020 - 2 U 10/19, juris para. 163). This is the situation here.

31 A resale of the aluminum floorboards placed on the market is not sufficiently excluded, even on the basis of the debtors' submissions. It is true that, after their installation, it may not be possible for the purchasers to resell them later in isolation, because there may at most theoretically be a demand for such used floor covering elements made of aluminum. However, it is not far-fetched that a property of a businessman provided with these products is sold by him. The products sold by the debtors ("A[...]-plank") may have been used as "outdoor aluminum flooring" by the end users, in particular as roof covering or as covering of front or attached balconies, dormers or terrace extensions/terraces. They may be located with the end user as parts of the building they have become, in particular as business assets (for example, in the case of commercial landlords or property developers). In this respect, commercial resale of the defendant's installed products (aluminum planks) together with the property is possible. This would constitute a (renewed) patent infringement (see Jestaedt, GRUR 2009, 102, 104), the prevention of which is served by the claim for recall and removal from the distribution channels (aA in the case of - here neither shown nor otherwise apparent - inseparable connection: Jestaedt, GRUR 2009, 102, 104).

32 (bb) Furthermore, it has neither been shown nor is it otherwise apparent that a recall would lack the likelihood of success from the outset if all of the products in question are permanently installed in the end users' homes. It does not necessarily follow from a fixed installation that customers per se will not or cannot comply with a recall, especially if they agree to bear the costs. The debtors do not claim that a removal of installed aluminum planks would not be possible without (moreover, not without irreparable) damage or destruction of the buildings concerned (see Düsseldorf Higher Regional Court, GRUR-RR 2021, 421, 427 - Montagegrube).

33 (cc) The fact that the debtors would find it unreasonable to accept a recall associated with the offer to bear the costs, because these costs could be considerable in the event of the dismantling of installed floorboards, is also not shown and cannot be assumed without further ado (cf. Düsseldorf Higher Regional Court, judgment of August 13, 2020 - 2 U 10/19, juris para. 167 mwN, GRUR-RR 2021, 15, 20 - Bodenbelag; GRUR-RR 2021, 421, 427 - Montagegrube; Kühnen, Handbuch der Patentverletzung, 15th ed, Chap. D para. 1032).

34 c) Finally, the complaint raises no objections to the District Court's assessment of the means of coercion and the determination of the persons who may be called upon for substitute coercive detention, which are also not objectionable.

35 The decision on costs shall be made in accordance with Section 97 (1), Section 891 sentence 3 Code of Civil Procedure (ZPO). The appeal on points of law was to be allowed pursuant to Sec. 574 (1) sentence 1 No. 2, (2) No. 1, (3) sentence 1 German Code of Civil Procedure (ZPO) because the case is of fundamental importance since its decision depends on the disputed question, which has not been clarified by the highest courts as far as can be seen and which repeatedly arises in the practice of patent infringement proceedings, whether the imposition of coercive means (Sec. 888 Code of Civil Procedure (ZPO)) to enforce a recall order is permissible.