



FEDERAL SUPREME COURT

IN THE NAME OF THE PEOPLE

JUDGMENT

KZR 39/06

Announced on:
May 6, 2009
Bott
Chief Judicial Secretary
as clerk of
the registry

in the case

Reference book: yes
BGHZ: yes
BGHR: yes

Orange Book Standard

EG Art. 82; GWB § 20 para. 1; BGB § 242 Cd

- a) The defendant claimed under a patent may object to the plaintiff Patent Owner's request for injunctive relief by claiming that the plaintiff Patent Owner is abusing a dominant position if he refuses to enter into a patent license agreement with the defendant on non-discriminatory and non-obstructive terms.
- b) However, the patent owner acts abusively only if the defendant has made him an unconditional offer to conclude a licence agreement to which he is bound and which the patent owner may not reject without infringing the prohibition of discrimination or the prohibition of obstruction, and if the defendant, as long as he is already using the subject-matter of the patent, complies with those obligations which the licence agreement to be concluded attaches to the use of the licensed subject-matter.
- c) If the defendant considers the patent owner's licence claim to be abusively excessive or if the patent owner refuses to quantify the licence fee, the requirement of an unconditional offer is satisfied by an offer to enter into a licence agreement under which the licensor determines the amount of the licence fee on an equitable basis.

BGH, judgment of 6 May 2009 - KZR 39/06 - OLG Karlsruhe
LG Mannheim

The Cartel Senate of the Federal Supreme Court (Bundesgerichtshof), at the hearing on February 10, 2009, by the President of the Federal Supreme Court, Prof. Dr. Tolksdorf, the Presiding Judge, Prof. Dr. Bornkamm, and the Judges Prof. Dr. Meier-Beck, Dr. Strohn, and Dr. Kirchhoff

decided in favor of the law:

The revision against the judgment of the 6th Civil Senate of the Court of Appeal Karlsruhe of 13 December 2008 is dismissed at the expense of the defendants no 3 - 8.

By law

Facts:

1 The plaintiff is the owner of European patent 325 330 (patent in suit), which was granted with effect in the Federal Republic of Germany, is based on an application filed on 17 January 1989 and lapsed in the course of the revision proceedings.

2 The claims 1 and 2 asserted by the complaint are:

1. An optically readable record (1) carrier of the inscribable type, comprising a recording layer (6) intended for recording an information pattern of optically detectable recording marks, which record carrier (1) is provided with a servo track (4) which in an area intended for information recording exhibits a periodic track modulation which can be distinguished from the information pattern, characterized in that the frequency of the track modulation is modulated in conformity with a position-information signal comprising

position-code signals (12) which alternate with position-synchronisation signals (11).

2. An optically readable record carrier as claimed in claim 1, characterized in that the position-code signals (12) are biphase-mark-modulated signals, the position-synchronisation signals (11) having signal waveforms which differ from the biphase-mark-modulated signal.

3 The Federal Supreme Court dismissed the nullity action brought by the defendant no. 4 in its judgment of 3 April 2007 (X ZR 36/04).

4 The defendant no. 4, whose general partner is the defendant no. 5, whose business is in turn managed by the defendant no. 6, distributes single and multiple recordable optical data carriers (CD-R and CD-RW) throughout Europe. It is supplied with CD-Rs, inter alia, by the defendant no. 7; the defendants no. 3 and 6 are managing directors of the general partner of the defendant no. 7; the defendant no. 8 was managing director of the legal predecessor of the defendant no. 7.

5 The District court prohibited the defendants 3 - 8 ('the defendants') from manufacturing, offering, putting on the market, using, importing or possessing for those purposes CD-Rs and CD-RWs which have not been put on the market with the consent of the plaintiff. It further ordered the defendants to provide information and accounts and to hand over CD-Rs and CD-RWs in their possession to a bailiff for destruction and found that the defendants were liable for damages. The defendant's appeal was essentially unsuccessful (OLG Karlsruhe InstGE 8, 14 = GRUR-RR 2007, 177). The Court of Appeal has worded the judgment formula "for clarification" in such a way that the sentencing of the defendants no. 3, 7 and 8 has been limited to actions relating to CD-R.

6 In their revision - admitted by the Senate - the defendants continue to pursue
their motion to dismiss the action.

7 The plaintiff counters the remedy on the ground that it seeks a declaration that
there is no longer any need to adjudicate on the substance of the application for
an injunction.

Reasons for Decision:

8 The admissible revision remains unsuccessful.

9 I. The Court of Appeal did not err in law in assuming that the defendants no. 4
and 7 were using the subject-matter of the patent in suit by the challenged acts in
contravention of § 9 PatG, since the recordable CDs distributed by the defendant
4 and partly obtained from the defendant no. 7 are (commercially available) data
carriers which literally implement all the features of claims 1 and 2 of the patent
in suit.

10 1. According to the Court of Appeal, the patent in suit relates to an optically
readable recordable data carrier, in particular a recordable compact disc (CD).
Such data carriers are manufactured without useful information and only written
with data by the end user in a suitable recorder by means of a laser beam. For this
purpose, the recording medium is provided with a light-sensitive layer, the
reflective properties of which can be changed selectively by irradiation with a
strongly focused laser beam. On a spiral track (servo track) extending outwardly
from the center of the recording medium, the information is written into the
recording medium as recording marks (pits), resulting in a sequence of pits and

lands, namely reflective and non-reflective areas. The coding of the information on the recording medium, in which data bit sequences are converted into channel bit sequences, is carried out in EFM modulation (Eight to Fourteen Modulation, see in more detail BGH, judgement of. 19.5.2005 - X ZR 188/01, GRUR 2005, 749, 750 - Aufzeichnungsträger). In known data carriers the servo track has a track modulation with constant frequency from which a clock signal is derived which is used to control the recording or read-out. The servo track is divided into information recording areas (used for recording the useful information) and synchronization areas located in between. These contain position information in the form of the address of the adjacent information recording area, from which it can be deduced during scanning which part of the recording medium is being read. In this way, a specific location on the disk can be visited quickly and precisely.

11 The disadvantage of the known recording media that the information recording areas are interrupted by the synchronization areas, which is unfavorable in particular for recording EFM-coded information, is to be remedied by the data carrier according to the invention, the features of which in the embodiment according to patent claim 2 are structured by the Court of Appeal as follows:

1. Optically readable recording carrier of the recordable type.
2. The recording carrier has a recording layer which is used to apply an information pattern of optically detectable recording marks.
3. The recording carrier has a servo track which has a periodic track modulation distinguishable from the information pattern in an area designated for information recording.

4. The frequency of the track modulation is modulated according to a position information signal.
5. The position information signal contains alternating position synchronization signals and position code signals.
6. The position code signals are biphase mark modulated signals.
7. The position synchronization signals have a different waveform with respect to the biphase mark modulated signal.

12 Such a data medium has the advantage that the address information is included in the track modulation, so that no synchronization regions are needed to interrupt the information recording region.

13 According to the further explanations of the Court of Appeal, the attacked commercially available CD-R and CD-RW discs have a track modulation (track oscillation) within the meaning of feature 3. This track oscillation is also frequency modulated in accordance with a position information signal (feature 4). This requires that the frequency of the track oscillation varies as a function of the instantaneous level of the position information signal. The information to be modulated is the position code signal consisting of 76 channel bits, which is - formed by biphase mark modulation of a position code consisting of 38 code bits. The average person skilled in the art addressed by the patent in suit understands the frequency shift keying used in the modulation of the position information signal, in which only two different frequencies occur, depending on whether the modulating signal has the logic state zero or one (23.05 KHz if the channel bit is one, 21.05 KHz if the channel bit is zero), as frequency modulation within the meaning of the patent in suit, because such a frequency shift keying is represented by the patent specification in the description (Sp. 22 Z. 44 ff. = p. 26 Z. 20 ff. of the translation) and illustrates it in Figure 9.

14 2. The revision challenges this assessment without success.

15 a) It complains that the Court of Appeal failed to recognise that the recordable CDs marketed by the defendant do not have an information pattern and thus do not have periodic track modulation which can be distinguished from an information pattern, and that the information pattern is only applied when the CD-R is written to. Moreover, the contested products do not use frequency modulation within the meaning of feature 4. It presupposes that the instantaneous frequency of the track oscillation can be used to infer the instantaneous logic value of the binary address signal (in the sense of the position code) at any point, as is apparent from the fact that the patent application in suit sees this as the substantive difference from the subject-matter of the earlier European patent application 265 695 (column 2, lines 37-41); the Court of Appeal disregarded this "disclaimer".

16 b) The Court of Appeal correctly interpreted the patent in suit. Its understanding of the protected technical teaching, which is consistent with the understanding given by the X. Civil Senate of the Federal Supreme Court in the patent nullity proceedings (judgment of 3.3.2007 - X ZR 36/04), is correct.

17 The revision wrongly holds that, in the case of the recordable CDs marketed by the defendants, feature 3 is only realised when the disks are written to by their users. The patent in suit does not (only) protect the written data carrier, but (already) the recordable data carrier, i.e. that data carrier which is provided with a servo track to which the information pattern can be applied by means of a suitable recording device. The periodic track modulation which can be distinguished from the information pattern is thus such a modulation which differs

in its structure from the information pattern - to be applied later. The patent claim expresses this clearly. According to feature 2, the record carrier does not have a recording layer with an information pattern, but a recording layer which is intended for recording an information pattern ("intended for recording an information pattern"). Accordingly, as feature 3 expresses, the servo track also has the track modulation in the area intended for recording the information pattern ("area intended for information recording"). The track modulation must therefore be different from the information pattern which, according to the convention used by CD recorders, is recorded on the recording layer when the CD is written. The Court of Appeal found that this was the case with the contested products without any error of law and without being challenged by the revision.

18 The revision also draws into doubt without success that frequency modulation within the meaning of feature 4 is used in the track modulation. That the information to be modulated can be the position code signal consisting of 76 channel bits and that the frequency shift keying used in the modulation of this position information signal is a frequency modulation within the meaning of feature 4 has already been deduced by the Federal Supreme Court in factual agreement with the Court of Appeal in the nullity proceedings from the description of the patent in suit (BGH loc. cit. para. 26). The revision does not put forward anything that could justify a different assessment. The question of the meaning of a "disclaimer", which is at the forefront of their argumentation, does not arise; neither the patent claim nor the description exclude such frequency shifting from the subject-matter of the patent claim; on the contrary, the description expressly states it.

19 II. The revision also challenges without success the Court of Appeal's refusal to allow the defendants to oppose the plaintiff's claim for injunctive relief, which follows from the infringement of the patent in suit under § 139 (1) Patent Act, with

the objection that the plaintiff was obliged to grant the defendants no. 4 and 7 a licence to the patent in suit.

20 1. The Court of Appeal held that the plaintiff did not violate the prohibition of discrimination under Section 20 (1) ARC. It was indeed the addressee of the standard since, according to its own argumentation, everyone who produces commercially available CD-R and CD-RW discs must comply with the standard applicable to such data carriers resulting from the specifications listed in the so-called Orange Book and thus necessarily also makes use of the patent in suit; the granting of licences to the patent in suit thus objectively formed a separate market which the plaintiff dominated as the sole supplier. The granting of licences also constitutes a commercial transaction which is usually accessible to similar undertakings, since the plaintiff has granted various licences. However, she did not treat the defendants unequally in relation to similar companies. Defendants have not shown that there are or were licensees with whom Plaintiff entered into a license agreement providing for the payment of a royalty equal to 3% of the net sales price, as Defendants believe is appropriate. It is true that the defendants make extensive submissions to the effect that the plaintiff does not sufficiently monitor compliance with the licence agreements it has concluded, does not enforce its claims, makes refunds and tolerates the under-reporting of production or delivery quantities subject to licensing, with the result that the agreed minimum licence fee per blank CD sold is ultimately not paid. However, it cannot be inferred from the defendant's submission that the actual and consensual handling of a licence agreement concluded on different terms amounts to the payment to the plaintiff of only 3% of the net sales price.

21 2. The attacks of the revision against this assessment do not need to be
discussed, since the defendants cannot rely on an obligation of the plaintiff to
grant a licence to the patent in suit for other reasons.

22 a) However, the defendant against whom a claim is made on the basis of a
patent may, in principle, oppose the injunctive relief sought by the patent owner
with the objection that the plaintiff, by refusing to conclude a patent licence
agreement, is unfairly hindering him in commercial transactions normally
available to similar undertakings or is discriminating against him in comparison
with other undertakings and is thus abusing his dominant position in the market.

23 aa) In its decision "Standard-Spundfass" (BGHZ 160, 67, 81 f.), the Senate
left open whether a claim under Section 33 (1) ARC in conjunction with Article
82 EC or Sections 19, 20 ARC can be held against the claim for injunctive relief
under Section 139 (1) Patent Act. The question is disputed in the case law of the
lower courts and in the literature.

24 Insofar as the "compulsory license objection under antitrust law" is admitted
(advocating LG Düsseldorf WuW/E DE-R 2120, 2121; Heinemann, ZWeR 2005,
198, 200 f.; Kühnen in Festschrift für Tilmann, p. 513, 523; Schulte/Kühnen, PatG,
8th ed, § 24 Rdn. 66 f.; Meinberg, Compulsory Licenses in Patent and Copyright
Law as an Instrument of Antitrust Abuse Supervision in German and European
Law (2006), p. 196; Benkard/Scharen, PatG, 10th ed, § 9, marginal no. 73;
Wirtz/Holzhäuser, WRP 2004, 683, 693 et seq.), it is based on the consideration
that the licence seeker acts unlawfully if he uses the patent without the patentee's
consent, but that the patentee cannot nevertheless claim an injunction against
him because he demands something with the injunction which he has to grant
back immediately (in the form of the grant of the licence) (*dolo petit, qui*

petit quod statim redditurus est), and thus infringes the principle of good faith (Paragraph 242 of the BGB).

25 According to the opposing view (OLG Düsseldorf InstGE 2, 168, para. 27; OLG Dresden GRUR 2003, 601, 603 f.; Jaecks/Dörmer in Festschrift für Säcker, p. 97, 106 ff; Maaßen, Normung, Standardisierung und Immaterialgüterrechte (2006), p. 257 f.; Graf von Merveldt, WuW 2004, 19 ff; Rombach in Festschrift für Günter Hirsch, p. 311, 321 f.), the compulsory license objection should not prevail in infringement proceedings because the prerequisites of a self-help right under Section 229 of the German Civil Code do not exist and the granting of the license - not unlike in the case of Section 24 of the Patent Act - only has an effect in the future; as long as the license seeker has not enforced his licensing claim by way of action or counterclaim, he is obligated to cease and desist. Moreover, Article 31 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) required a sovereign act for the grant of a compulsory licence.

26 bb) In principle, the first view is to be agreed with.

27 If a dominant company, by refusing to conclude a patent licence agreement offered to it, discriminates against the company seeking the licence in a business transaction normally accessible to similar companies or unreasonably hinders the licence seeker, the enforcement of the claim for injunctive relief under patent law also constitutes an abuse of the dominant position. This is because the dominant company thereby prevents the other company from gaining access to the market which it is obliged to open up by concluding the licence agreement. The enforcement of the injunctive relief is thus prohibited, as is the refusal to conclude the licence agreement, which would extinguish the injunctive relief. However, conduct prohibited by antitrust law may not be enjoined by the state courts.

28 Nor does Article 31 of the TRIPS Agreement provide otherwise. That provision permits, in principle, the grant of a right to use the subject-matter of a patent without the consent of the proprietor of the patent, provided that permission for such use is examined in the light of the circumstances of the particular case. The further requirement that a person who intends to use must have made unsuccessful efforts to obtain the consent of the right holder on reasonable commercial terms prior to the use (Art. 31(b)) is not obligatory for the Contracting States under Art. 31(k) if the use is permitted in order to remedy an anti-competitive practice established in judicial or administrative proceedings. Moreover, it is also fulfilled if the infringer of the patent in suit has unsuccessfully sought a licence on non-discriminatory terms prior to the commencement of use. Whether the Convention requires the contracting states to grant the right of use based on cartel law by a sovereign act, as the appellant, citing Rombach (*loc. cit.* p. 322), wants to deduce from Article 31 lit. a and i, can be left open, since in any case the judicial examination in the patent infringement proceedings, in which a binding decision is made as to whether and to what extent the user of the invention is entitled to the grant of a licence, is sufficient for this purpose.

29 b) However, the patent owner who asserts the injunctive relief from his patent although the defendant is entitled to the grant of a licence to the patent in suit only abuses his dominant position and acts in bad faith if two conditions are met: First, the license seeker must have made him an unconditional offer to enter into a license agreement, which the patentee may not reject without unreasonably hindering the license seeker or violating the prohibition of discrimination, and must hold himself bound by this offer. Secondly, if the licence seeker is already using the subject-matter of the patent before the patent owner has accepted his offer, he must comply with those obligations which the licence agreement to be

concluded attaches to the use of the licensed subject-matter. This means in particular that the licence seeker must pay or ensure payment of the royalties resulting from the contract.

30 aa) The fact that the license seeker must have made an acceptable offer on contractual terms that the patent owner cannot reject without treating the license seeker unequally vis-à-vis similar undertakings without objective reason or without unfairly hindering him is, as far as can be seen, generally accepted. For even the dominant patentee is not obliged to offer to permit the use of the invention himself; only if he refuses an offer to conclude a contract on non-obstructive or discriminatory terms does he abuse his dominant position. He is not obliged to tolerate the use of his patent by an undertaking which is not prepared to conclude a licence agreement on such terms.

31 The case in dispute does not give rise to any further elaboration as to which conditions such a licence offer must contain in detail. However, if the licence seeker makes an offer on usual contractual terms, the patent owner will only be able to plead that he does not have to accept individual contractual terms if he offers other terms in this respect that are compatible with his obligations under antitrust law.

32 At the same time, it follows from the above that an abuse of the dominant position cannot be considered if the license seeker only makes a conditional license offer, in particular offers the conclusion of the contract only on condition that the infringement court affirms the infringement of the patent in suit by the challenged embodiment, which he denies. The patent owner does not have to

accept such an offer otherwise; therefore, it cannot be held against his request for an injunction.

- 33 bb) However, the unconditional offer of a contract which can be accepted is not sufficient to allow the "compulsory licence objection" to prevail against the patent owner's request for an injunction. In principle, the grant of any licence has effect only in the future (Rombach loc.cit. p. 322). Only when the licence has been granted is the licensee entitled to use the subject matter of the licence agreement; at the same time the licensor's claim to the contractual consideration arises with each act of use (if and to the extent that no consideration independent of use has been agreed), typically - as in the case in dispute - in the form of a royalty per unit or turnover-related royalty. The license seeker who starts using the patent in suit in anticipation of the license to be granted to him may not only "anticipate" his contractual rights, but must also "anticipate" his contractual obligations. He can only oppose the request for injunctive relief with the *dolo petit* objection if he has not only made an offer to the patentee that the patentee may not reject, but also acts as if the patentee had already accepted his offer. In this case, he would not only be entitled to use the subject-matter of the patent, but would also be obliged, in particular, to regularly account for the use and to pay to the patentee the royalties resulting from the accounting. On the other hand, the patent owner does not act abusively or in bad faith if he asserts claims from the patent against the person who claims the right of use of a licensee for himself but does not provide the consideration which the licensee would be obliged to provide under a non-discriminatory or obstructive licence agreement.

34 This also takes account of the concerns that led the Federal Supreme Court to assume that a claim for injunctive relief under copyright law cannot be countered with the objection of the impermissible exercise of rights because of an existing claim to licensing. The Federal Supreme Court justified this primarily on the grounds that this would amount to a statutory licence which would place the author in a worse position than a compulsory licence under copyright law, since he would have to assert his claim to remuneration after the work had been used, instead of being able to make the granting of consent dependent on the payment of the remuneration owed (BGHZ 148, 221, 231 et seq. - SPIEGEL-CD-ROM, cf. also Jaecks/Dörmer loc. cit. p. 108 et seq.).

35 It cannot be objected to the requirement of "contractually faithful" action on the part of the licence seeker that it is the sole responsibility of the patent owner who refuses to conclude the contract that the consideration for the licence is not provided (so Kühnen loc. cit. p. 523, who, however, also demands that the user must not only be willing but also able to perform). Just as the licence seeker cannot be denied to defend himself primarily against the allegation of infringement with the consequence that the action must be dismissed in its entirety if the allegation of infringement is not confirmed, the patent owner cannot be denied to assert primarily the claim for injunctive relief under the patent with the consequence that this claim must be awarded if the allegation of infringement is confirmed and the court denies a dominant position or an abuse thereof. In this case, however, the mere fact that the patent owner refuses to conclude the licence agreement offered to him because he believes himself entitled to do so does not justify privileging the licence seeker over the licensee by dispensing the latter from observing the reciprocal relationship between contractual performance and consideration. Just as the patent owner must allow himself to be treated as if

he had granted the licence owed, the licence seeker must also behave as if the licence had been granted to him.

- 36 This means, on the one hand, that the licence seeker must settle accounts on the terms of a non-discriminatory contract concerning the scope of his acts of use and, on the other hand, that he must fulfil his payment obligations resulting from the settlement. In this context, however, the licence seeker does not have to pay the patent owner, but may, pursuant to § 372 sentence 1 of the German Civil Code, deposit the royalties, waiving the right of redemption. This is because the patent owner's refusal to conclude the licence agreement justifies the corresponding application of the provisions on creditor's default, either because the patent owner is also not prepared to accept the payment offered (§ 293 BGB) or because he is willing to accept the payment but is not prepared to provide the consideration in the form of the grant of the licence (§ 298 BGB). In substance, this takes account of the interest of the licence seeker in securing his claim to repayment of licence fees paid in the event that the action is dismissed for lack of infringement.
- 37 c) In terms of amount, the license fee and thus also the performance obligation of the license seeker is limited to the amount that results from the terms of a contract that is unobjectionable under antitrust law.
- 38 The fact that this amount is also not readily ascertainable for the license seeker does not place an unreasonable burden on him, since he basically bears the burden of presentation and proof for the prerequisites of the licensing claim anyway.

39 If the licence seeker considers the patent owner's royalty demand to be abusively excessive or if the patent owner refuses to quantify the royalty, for example because he considers himself entitled to refuse to license the patent-in-suit in any case, the licence seeker must, however, be granted the right to direct the offer to enter into a licence agreement with regard to the remuneration not to the agreement of a specific royalty rate but to a royalty rate to be determined by the patent owner in his reasonable discretion. Otherwise, the deposit of a higher amount than the one considered reasonable by the licence seeker himself could not prevent his conviction if it was not accompanied by a licence offer of the same amount. An offer increased "as a precaution" would, however, give the patentee the opportunity to secure an excessive royalty, if necessary, by accepting that offer. This would not only be inequitable, but would also burden the patent infringement process to an avoidable extent with the task of determining the exact amount of a non-obstructive or discriminatory royalty. This is because the license seeker will be more willing to deposit a higher amount that it believes is reasonable under antitrust law if it is not barred from objecting - which in principle remains its burden of proof - that a determination of the license fee by the patentee at that amount would be inequitable. On the other hand, the patent owner remains completely free to determine the licence fee; its determination is only inequitable if it does not comply with the limits imposed on it by antitrust law anyway and inequitably hinders the licensee or discriminates against it compared to other licensees.

40 In accordance with the provision in Section 11 (2) UrhWG, the deposit of the license fee shall not be precluded by the fact that the amount owed has not yet been determined, i.e. in this case it depends on the performance determination pursuant to Section 315 BGB. If a sufficient amount has been deposited in any case, the infringement court may, if the other requirements of the "compulsory

license objection" are also met, content itself with the finding that the patent proprietor is obligated to accept the license agreement offer and to determine the license fee according to equitable discretion.

41 d) Accordingly, the Court of Appeal was right to deny the defendants the plea that the plaintiff abused its dominant position by refusing to agree to a licence agreement with a licence fee of 3%. For the Court of Appeal - apart from the fact that it also did not make any more detailed findings on the remaining content of the defendants' contractual offer - did not establish that the defendants even settled the royalties owed in their opinion and deposited amounts in this amount.

42 III. Accordingly, the defendant's order to render an account and the determination of its obligation to pay damages are also upheld.

43 1. The Court of Appeal stated in this regard: The defendants could not successfully counter the plaintiff's claim for a declaration that the defendants were liable for damages with the objection of abuse of rights, if only because the defendants would have been liable for damages even if they had had a claim against the plaintiff for the grant of a licence. Such a claim would not have changed the fact that the defendants had made use of the plaintiff's property right without its consent and had thus acted unlawfully. Since the defendants did not claim a free license, but requested the granting of a license against payment of a license fee in the amount of 3% of the net sales price, the plaintiff would in any case have suffered damages in the amount that it could have claimed if it had concluded a corresponding license agreement with the defendants. Since it was undisputed that the defendants had manufactured and distributed CD-Rs, it was also established on the basis of the defendants' submissions that the plaintiff had

suffered minimum damages. This is sufficient to meet the plaintiff's request for a declaration.

- 44 2. It can be left open whether this reasoning would stand up to scrutiny in all points. For since the plaintiff was entitled to an enforceable injunctive relief according to what has been stated under II 2, the defendants, whose culpable conduct the Court of Appeal found to be without error of law, are also obliged under § 139 (2) Patent Act to compensate the plaintiff for the damage it suffered as a result of the defendants' use of the patented invention contrary to § 9 Patent Act.

- 45 IV. The same applies to the claim under Sec. 140a (1) Patent Act for destruction of the unlawfully produced data carriers, which was also granted by the Court of Appeal.

Tolksdorf

Bornkamm

Meier-Beck

Strohn

Kirchhoff

Lower courts:

LG Mannheim, decision dated 13.09.2002 - 7 O 35/02 -

OLG Karlsruhe, decision dated 13.12.2006 - 6 U 174/02 -