Machine translation

FEDERAL SUPREME COURT

DECISION

X ZB 9/21

from

August 1, 2023

in the independent proceedings for taking evidence

Reference book:	yes
BGHZ:	yes
BGHR:	yes

Aesthetic treatment

Code of Civil Procedure (ZPO) Sec. 567 (1) No. 2; Patent Law Sec. 140c (1) 3rd sentence, (3) 2nd sentence; GebrMG Sec. 24c (1) 3rd sentence, (3) 2nd sentence

a) Pursuant to Sec. 567 (1) No. 2 Code of Civil Procedure (ZPO), an immediate appeal is admissible against a decision on the disclosure to the claimant of an expert opinion prepared in independent evidence proceedings on the basis of an inspection ordered under Sec. 140c (3) Patent Law or Sec. 24c (3) GebrMG. This applies not only if the request for surrender is rejected, but also if the court of first instance orders surrender although the respondent has opposed this by asserting confidentiality interests.

b) For the decision on the release of the expert opinion, the question of how probable the existence of claims for infringement of the property right is is only relevant if the respondent has demonstrated justified interests in secrecy (supplement to Federal Supreme Court (BGH), decision of November 16, 2009 - X ZB 37/08, BGHZ 183, 153 = GRUR 2010, 318 - Lichtbogenschnürung).

Federal Supreme Court (BGH), decision of August 1, 2023 - X ZB 9/21 - OLG Munich
LG Munich I

ECLI:EN:BGH:2023:010823BXZB9.21.0

The X. Civil Senate of the Federal Supreme Court decided on August 1, 2023 by the presiding judge Dr. Bacher, the judge Dr. Deichfuß, the judges Dr. Kober-Dehm and Dr. Rombach and the judge Dr. Rensen:

The decision of the 6th Civil Senate of the Higher Regional Court of Munich dated October 7, 2021 is reversed with regard to the costs and with regard to No. 1 of the decision formula relating to the "Z." and "S." devices.

To the extent of the annulment, the matter is referred back to the court of appeal for a new decision.

The value of the appeal proceedings is set at EUR 100,000.

Reasons:

1 I. The applicant seeks the release of two expert reports prepared on the basis of an inspection.

2 The applicant is the owner of the German utility model 20 2016 008 804 (disputed utility model), registered on October 24, 2019, which was branched off from the European patent application 3 316 962 and concerns a device for aesthetic treatment.

3 Claim 1, to which thirteen further claims are related back are named:

> An aesthetic treatment device for training muscles, reducing adipose cells, or shaping a human body by means of a plurality of time-varying magnetic fields, the treatment device comprising:
>
> - a control unit;
> - a first magnetic field generator,
> - a second magnetic field generator;
>
> characterized in that the control unit is configured to control the power supply to the first magnetic field generator and the second magnetic field generator; wherein the first magnetic field generator is configured to generate a first time-varying magnetic field, and the second magnetic field generator is configured to generate a second time-varying magnetic field;
> wherein the first and second time-varying magnetic fields are applied to muscles, neuromuscular plates, or nerves that excite the neuromuscular plates of the human body.

4 The defendant offers, among others, devices for aesthetic treatment under the type designations "Z." and "S.", which, according to the applicant, infringe the contested utility model.

5 The District Court issued a preliminary injunction requiring the defendant to tolerate an inspection of its premises. At the same time, in the present proceedings, it ordered that two written expert opinions be obtained on the question of whether the devices found at the defendant's premises and at

a trade fair stand are in compliance with the the defendant and the devices found on a trade fair booth infringe the encroach upon the scope of protection of the contested utility model.

6 After the defendant had filed an opposition to the preliminary injunction and a cross-appeal against the order to take evidence, the parties agreed at the oral proceedings to continue the taking of evidence and to suspend the injunction proceedings until the Utility Model Board had reached a decision on the legal validity of the disputed utility model.

7 The District Court forwarded the expert opinions submitted by the two experts to the petitioner's counsel, with the proviso that they not be released to the petitioner herself.

8 Among other things, the applicant requested that both expert opinions, including Exhibits, be released to her and that her legal representatives be released from their duty of confidentiality. The respondent has opposed this and has filed several countermotions.

9 The District Court ordered the surrender of the two expert opinions in accordance with the application. On the respondent's immediate appeal, the appellate court dismissed the request for the surrender of the two aforementioned types of equipment as currently unfounded. The applicant challenges this with its appeal on points of law, which is admitted in this respect. The defendant opposes the appeal.

10 II. The appeal on points of law is admissible due to its admission by the appellate court and is also admissible in other respects.

11 1. However, the Federal Supreme Court is not bound by the admission of the appeal if this appeal against the contested decision is not even admissible. In particular, there is no binding effect if the appeal to the court of appeal was already inadmissible (cf. only Federal Supreme Court (BGH), decision of December 18, 2008 - I ZB 118/07, GRUR 2009, 519 para. 6 - Hohlfasermembranspinnanlage I).

12 2. However, the Court of Appeal was correct in its finding that the immediate appeal against the decision of the District Court was admissible to the extent to be assessed here.

13 a) Pursuant to Sec. 567 (1) No. 2 Code of Civil Procedure (ZPO), an immediate appeal is admissible against a decision on the surrender to the claimant of an expert opinion prepared in independent evidence proceedings on the basis of an inspection ordered under Sec. 140c (3) Patent Act or Sec. 24c (3) GebrMG. This applies not only if the request for surrender is rejected (on this constellation Federal Supreme Court (BGH), decision of November 16, 2009 - X ZB 37/08, BGHZ 183, 153 = GRUR 2010, 318 - Lichtbogenschnürung), but also if the court of first instance orders surrender even though the respondent has opposed this by asserting confidentiality interests.

14 aa) Section 567(1)(2) of the Code of Civil Procedure (ZPO) opens the possibility of an immediate appeal only in the event that the court has rejected a request relating to the proceedings.

15 In principle, this requirement is only met if the issuance of the contested decision requires a request by the party, but not if the contested decision can be issued ex officio without a request (see Federal Supreme Court (BGH), decision of November 6, 2013 - I ZB 48/13, GRUR 2014, 705 para. 8 - Domestic Admin-C).

16 bb) In the constellation underlying the dispute, both the order to release the expert opinion and a negative decision may only be issued upon request.

17 As a rule, an expert opinion prepared in independent evidence proceedings shall be communicated to the parties or their procedural representatives without reservation. However, an expert opinion prepared in independent evidence proceedings following an inspection ordered on the basis of Sec. 140c (3) Patent Law may only be disclosed to the claimant for his own perusal to the extent that this does not conflict with legitimate interests of the respondent in maintaining secrecy.

18 The reason for this is the duty of the court standardized in Sec. 140c (1) sentence 3 and (3) sentence 2 PatG to take the necessary measures to ensure the protection of confidential information when deciding on the obligation to produce a document or to tolerate the inspection of a thing (Federal Supreme Court (BGH), decision of November 16, 2009 - X ZB 37/08, BGHZ 183, 153 = GRUR 2010, 318 para. 15 - Lichtbogenschnürung).

19 This obligation does not only apply to the decision on the claim for production or inspection. Rather, justified confidentiality interests of the respondent must also be taken into account in independent evidence proceedings in which an expert opinion has been prepared on the basis of an ordered production or inspection. Deviating from the conventional rules of independent evidence proceedings, such an expert opinion may not be communicated to the parties without reservation. If the claimant requests that the expert opinion be handed over to him/herself, it must rather be decided to what extent interests of the respondent that are worthy of protection are affected and the interest in secrecy prevails (loc. cit. para. 35).

20 If the respondent wishes to prevent the complete disclosure of the expert opinion to the opposing party for reasons of protection of business or private secrets or other confidential interests worthy of protection, the respondent shall bear the general If the court does not wish the expert opinion to be brought to the attention of the opposing party in its entirety, the party must demonstrate the factual prerequisites for this in accordance with the general principles of presentation and

burden of proof. to demonstrate the factual prerequisites for this. The orders required to protect the confidential interests are then to be made on the basis of a case-by-case assessment that comprehensively takes into account all interests that may be impaired on both sides (e.g., the parties to the proceedings, the parties to the proceedings, the parties to the proceedings). interests of both parties (para. 37 f.).

21 According to these principles, which also apply in inspection proceedings on the basis of Sec. 24c GebrMG, the court may only decide on the disclosure of the expert opinion if the claimant so requests. It may only refuse such a request if the respondent claims confidentiality interests. In both constellations, a decision ex officio is therefore excluded.

22 cc) This interpretation of Section 567(1)(2) of the Code of Civil Procedure (ZPO) is consistent with the purpose of the provision.

23 The restriction of the admissibility of the immediate appeal to the rejection of a petition relating to the proceedings serves the purpose of not hindering the course of the proceedings in a disproportionate manner by means of rampant appeal possibilities (see only BeckOK ZPO/Wulf, 48th edition, Section 567 para. 30; Stein/Jonas/Jacobs, 23rd ed. 2018, Section 567 para. 8; Jänich in Wieczorek/Schütze, Code of Civil Procedure (ZPO), 5th ed. 2021, Section 567 para. 2). This restriction of the possibilities of legal protection is generally unobjectionable under constitutional law, if only because Article 19 (4) of the Basic Law does not mandatorily prescribe a course of appeal and because any error of law can be corrected in the context of the decision on an appeal against the final decision.

24 On the other hand, a different assessment is required if the interim decision would already result in a permanent disadvantage for one party which could no longer be remedied or at least not completely remedied in the further proceedings (Federal Supreme Court (BGH), decision of December 18, 2008 - I ZB 118/07, GRUR 2009, 519 para. 12 - Hohlfasermembranspinnanlage I).

25 Such a constellation usually exists if the respondent opposes the claimant's request with the reasons that the disclosure of the expert opinion would unjustifiably disclose secrets worthy of protection.

26 If the order to provide the claimant with the expert opinion subsequently proves to be incorrect, the disclosure of secret information associated with the provision of the expert opinion can no longer be reversed. Against this background, it is also necessary for reasons of equality of arms to give not only the claimant but also the respondent the opportunity to appeal against a decision that is unfavorable to him (cf. on this aspect also OLG Munich, NJW-RR 2015, 33, 34; BeckOK ZPO/Wulf, 48th edition, Section 567 para. 30.1; Stein/Jonas/Jacobs, 23rd ed. 2018, Section 567 para. 11; Jänich in Wieczorek/Schütze, Code of Civil Procedure (ZPO), 5th ed. 2021, Section 567 para. 11).

27 dd) This result is also in line with the legislature's intention expressed in Section 20 (5) sentences 4 and 5 GeschGehG.

28 According to the provision in Sec. 20 (5) sentence 5 GeschGehG, which is applicable pursuant to Sec. 145a sentence 1 PatG and Sec. 26a GebrMG shall apply mutatis mutandis in patent and utility model litigation. a decision by which a request for judicial measures for the protection of business for the protection of trade secrets is subject to an immediate appeal. This provision is based on the consideration that the unrestricted accessibility of the trade secret leads to a remaining The court's decision was based on the assumption that the disclosure of the information would result in a disadvantage for the party requesting secrecy that could no longer

be remedied in the further proceedings (BT-Drucks. 19/4724 S. 38; FEDERAL SUPREME COURT (BGH), Decision of November 18, 2021 - I ZB 86/20, GRUR 2022, 591 para. 16. - Trade secret for hollow fiber membrane spinning systems).

29 The same danger threatens in the constellation underlying the dispute. The disclosure of secret information associated with the provision of the expert opinion cannot be reversed in the further course of the proceedings.

30 The fact that independent evidence proceedings are expressly excluded from the facts of Sec. 145a, first sentence, Patent Act and Sec. 26a, first sentence, Utility Model Law does not justify any conclusion to the contrary. This exception serves the purpose of enabling the combination of independent evidence proceedings and a preliminary injunction to tolerate inspection, which has been established in the field of patent law, to continue in the manner practiced to date (BT-Drucks. 19/25821 p. 57). It cannot be assumed that the legislator thus intended to exclude the possibility of appeal for independent evidence proceedings expressly opened in Section 20 (5) sentence 4 GeschGehG, if only because the case law of the higher courts at that time already considered an appeal to be admissible (Düsseldorf Higher Regional Court, InstGE 8, 186, para. 28 et seq.; Düsseldorf Higher Regional Court, InstGE 9, 41, para. 7; Munich Higher Regional Court, InstGE 12, 192, para. 24; cf. also Deichfuß, GRUR 2015, 436, 441).

31 ee) The fact that decisions rejecting a secrecy order pursuant to Section 174 (3) GVG are not subject to immediate appeal (in this regard, Federal Supreme Court (BGH), decision of October 14, 2020 - IV ZB 8/20, NJW-RR 2020, 1386 para. 11 et seq.) does not speak against, but rather in favor of the result found here.

32 The refusal of such an order does not necessarily result in the loss of secrets worthy of protection. The party concerned may protect itself from disclosure by not obtaining a copy of the documents for forwarding to the plaintiff's side. This may result in a negative decision on the merits. However, legal errors in this respect can, if necessary, be corrected by an appeal against the decision on the

merits (see Federal Supreme Court (BGH), decision of October 14, 2020 - IV ZB 8/20, NJW-RR 2020, 1386 para. 17 et seq.).

33 In the constellation underlying the dispute, however, there is no such possibility of correction. With the transfer of the expert opinion to the claimant, the information worthy of protection in the view of the respondent is irretrievably disclosed. Consequently, the person concerned must have the opportunity to have an erroneous decision corrected before the expert opinion is handed over to the opponent.

34 b) An appeal against the order to surrender the property to the applicant is also not excluded under Section 490 (2) sentence 2 of the Code of Civil Procedure (ZPO) (likewise Düsseldorf Higher Regional Court, InstGE 8, 186, para. 28 et seq.; Düsseldorf Higher Regional Court, InstGE 9, 41, para. 7; OLG Munich, InstGE 12, 192, para. 24; Deichfuß, GRUR 2015, 436, 441).

35 Pursuant to Section 490 (2) sentence 2 of the Code of Civil Procedure (ZPO), a decision ordering independent evidence proceedings is not subject to appeal.

36 In the present proceedings, it is not the decision by which the District Court ordered the evidentiary proceedings that is at issue, but the downstream question of whether the expert opinion prepared on the basis of an inspection enforced by a preliminary injunction may be released to the applicant herself. This decision is to be made on the basis of different criteria than the decision on the order of the evidentiary proceedings. The order of independent proceedings for taking evidence also does not lead to irreparable impairment for the defendant (see Federal Supreme Court (BGH), decision of September 13, 2011 - VI ZB 67/10, NJW 2011, 3371 para. 6; decision of September 15, 2022 - V ZB 71/21, NJW-RR 2022, 1553 para. 6).

37 III. The appeal on points of law is well-founded and leads to the case being referred back to the appellate court.

38 1. The court of appeal gave the following main reasons for its decision:

39 The handing over of an expert opinion to the applicant in inspection proceedings was not only to be omitted if the defendant asserted conflicting interests in secrecy. Rather, handing over the report was also excluded if there was no sufficient probability of an infringement of a utility model within the meaning of Sec. 24c (1) GebrMG due to the lack of protectability of the underlying property right. Objections in this respect would have to be possible for the defendant in such proceedings according to Art. 7 (1) sentence 5 of Directive 2004/48/EC (hereinafter: Enforcement Directive). No other legal remedy is available. This was in any case not appropriate for an unexamined property right.

40 In the case in dispute, a utility model infringement was not sufficiently probable after the Cancellation Division of the German Patent and Trademark Office had come to the preliminary conclusion that the utility model in dispute was not legally valid. The applicant did not counter this with any substantiated argument.

41 2. This assessment does not withstand the attacks of the appeal on points of law.

42 a) As already explained above, an expert opinion prepared in independent evidence proceedings following an inspection ordered on the basis of Sec. 140c (3) Patent Act may be made available to the claimant for his own perusal only to the extent that this does not conflict with legitimate confidentiality interests of the respondent.

43 b) These principles apply in principle in the same way in independent evidence proceedings relating to a utility model, as the Court of Appeal also correctly assumed in the appendix.

44 § Sec. 24c GebrMG contains a provision corresponding to Sec. 140c Patent Law. It differs only insofar as there is no right to inspection of proceedings - which is already logical because proceedings under Sec. 2 No. 3 GebrMG are not accessible to utility model protection.

45 c) Contrary to the opinion of the Court of Appeal, it follows from these principles that the question of how probable the existence of claims for infringement of the property right is is only relevant for the decision on the release of the expert opinion if the respondent has shown justified interests in secrecy and, therefore, a weighing in the above sense is to be carried out.

46 Unless it is shown that the disclosure of the expert opinion affects legitimate secrecy interests, measures within the meaning of Sec. 140c (1), 3rd sentence, and (3), 2nd sentence, Patent Law or the corresponding provisions of Sec. 24c GebrMG are not required.

47 d) The requirement in Article 7 (1) sentence 5 of the Enforcement Directive does not result in any further requirements.

48 aa) According to the aforementioned regulation, it must be possible for an affected person who has not been heard prior to the ordering of measures for the preservation of evidence to obtain a judicial decision on whether the measures should be amended, revoked or confirmed after notification of the measures.

49 bb) German law takes account of this requirement through the possibility provided for in Sections 936 and 924 of the Code of Civil Procedure (ZPO) of lodging an appeal against a preliminary injunction ordering the production of documents or the toleration of an inspection (BR-Drucks. 64/07, p. 65).

50 Pursuant to Section 490 (2) sentence 2 Code of Civil Procedure (ZPO), there is in principle no right of appeal against the order of independent evidence proceedings (Federal Supreme Court (BGH), decision of 13 September 2011 - VI ZB 67/10, NJW 2011, 3371 para. 6; decision of 15 September 2022 - V ZB 71/21, NJW-RR 2022, 1533 para. 6). However, if the respondent has not been heard prior to the order, as is usual in cases of the present kind, the court must review, in response to a counter-argument, whether the requirements for ordering independent evidence proceedings are also met in light of the counter-argument (cf. generally OLG Koblenz, decision of August 16, 2012 - 5 W 445/12, MDR 2013, 171; on inspection proceedings Kühnen, Handbuch der Patentverletzung, 15th ed. 2023, chap. B para. 182; Cepl/Voß/Hahn, 3rd ed. 2022, Code of Civil Procedure (ZPO) § 490 para. 28).

51 cc) This arrangement provides the respondent with sufficient legal protection.

52 The respondent may obtain that both typically issued court decisions - the preliminary injunction ordering acquiescence and the decision to initiate independent evidence proceedings - be reviewed and, if necessary, amended or set aside if it is found that there is no legal basis.

53 In this context, there is no need for a final decision on the question under which conditions the preliminary injunction ordering acquiescence is to be regarded as settled after the inspection has been carried out. To the extent that the claimant can no longer bring about a renewed decision on the request originally filed from this point of view (Kühnen, Handbuch der Patentverletzung, 15th ed. 2023,

Chap. B para. 186), this is based solely on the fact that legal protection in this regard is no longer possible in a meaningful way due to the developments that have actually occurred. The Enforcement Directive also does not provide for senseless legal remedies. Insofar as an ordered measure continues to have effects, a subsequent judicial decision may not be refused in response to an admissible legal remedy. Irrespective of this, the respondent can at least bring about a declaratory decision on the original legality by opposing a statement of compliance by the claimant.

54 dd) Against this background, a renewed examination of the question whether the requirements for a preliminary injunction to tolerate an inspection or for ordering independent evidence proceedings are met is not necessary in the context of the decision on the surrender of the expert opinion. Rather, it is sufficient to take the measures for the protection of confidential information prescribed in Sec. 140c (1), third sentence, and (3), second sentence, Patent Law or the corresponding provisions in Sec. 24c GebrMG, if applicable.

55 Article 7 of the Enforcement Directive does not require that a data subject be able to seek judicial review of the same issues more than once.

56 ee) A request for a preliminary ruling by the Court of Justice of the European Union is not required.

57 Against the background outlined above, there is no doubt that German law offers the person concerned the possibilities prescribed in Art. 7 of the Enforcement Directive to obtain effective legal protection.

58 e) In the present proceedings, due to the limited admissibility of the appeal on points of law, the only question to be decided is whether the two expert opinions are to be handed over to the applicant. Consequently, the legal status of the disputed utility model and other requirements for the existence of claims for infringement of the property right are only relevant if the defendant has shown justified interests in secrecy.

59 3. The decision of the appellate court is not correct on other grounds (Section 577 (3) of the Code of Civil Procedure (ZPO)).

60 a) The request for the release of an expert opinion cannot be denied on the grounds that it would not be usable if the expert were not qualified.

61 This circumstance exclusively concerns the utilization of the expert opinion. If necessary, this is to be decided in the proceedings on the merits.

62 b) The same applies to the objection that the evidence order is not solely directed to findings on the nature of the challenged embodiment, but also to an evaluative assessment of the infringement issue.

63 4. The case is not ripe for final decision (Section 577 (5) sentence 1 Code of Civil Procedure (ZPO)).

64 The Court of Appeal - from its legal point of departure - did not address the question of whether the respondent has presented justified interests in secrecy and therefore whether a comprehensive weighing of the interests of both parties must be carried out. The assessment of these questions and any balancing that may be required thereafter will have to be made up for in the reopened appeal proceedings.

65 IV. The Senate does not consider an oral hearing to be necessary.

Bacher Deichfuß Kober-Dehm

Rombach Rensen

Lower courts:
LG Munich I, decision of 05.02.2021 - 7 OH 15561/19 –
OLG Munich, decision of 07.10.2021 - 6 W 829/21 -