



FEDERAL SUPREME COURT
ON BEHALF OF THE PEOPLE
JUDGMENT

X ZR 10/20

Announced on:
November 8, 2022
Anderer
Judicial clerk as
clerk of the court
registry

in the litigation

Reference book: yes
BGHZ: yes
BGHR: yes

Disc brake II

Patent Law Sec. 10 (1), Sec. 9 sentence 2 No. 1

- a) In order for the technical effects of an invention to be reflected in certain parts and their incorporation to lead to a new production displacing the exhaustion effect, these must be designed in a special manner adapted to the invention in order to be able to fulfill the function assigned to them, for example through a special design (Federal Supreme Court (BGH), judgment of May 4, 2004 - X ZR 48/03, BGHZ 159, 76, 92 f. - Flügelradzähler; judgment of May 3, 2006 - X ZR 45/05, GRUR 2006, 837 para. 22 - Laufkranz).
- b) These requirements are not met if the relevant effect of the parts to be assessed is solely that they wear out.

Federal Supreme Court (BGH), judgment of November 8, 2022 - X ZR 10/20 -
Düsseldorf Higher Regional Court
Düsseldorf District Court

ECLI:EN:BGH:2022:081122UXZR10.20.0

The X. Civil Senate of the Federal Supreme Court, at the oral hearing on November 8, 2022, by the Presiding Judge Dr. Bacher, Judges Hoffmann and Dr. Deichfuß, Judge Dr. Kober-Dehm and Judge Dr. Rensen,

found in favor of the defendant:

On the appeals of the defendants, the judgment of the 2nd Civil Senate of the Düsseldorf Higher Regional Court of January 23, 2020 is set aside and the judgment of the 4c. Civil Chamber of the Düsseldorf District Court of February 7, 2019, is amended.

The complaint is dismissed.

The plaintiff shall bear the costs of the proceedings.

By law

Facts:

1 The plaintiff is suing the defendant for contributory infringement of European patent European patent 1 974 150 (patent in suit).

2 The patent in suit relates to a disc brake, in particular for motor vehicles. Patent claims 1, 12 and 16, on which the complaint is based, have been given the following wording by a judgment of the Federal Patent Court (BPatG, judgment of October 25, 2018 - 7 Ni 12/17 (EP), juris; Federal Supreme Court (BGH), judgment of December 15, 2020 - X ZR 180/18, GRUR 2021, 701 - Scheibenbremse I), which was upheld on appeal:

1. A disc brake with a brake carrier (3) arranged fixed with respect to an axle beam (1) and having receiving elements (21) fixed on it for the fastening and floating mounting of a brake calliper, wherein the brake carrier (3) has a lining cavity (10) for receiving a brake pad resting against a disc of the disc brake and each further brake pad is arranged in a receiving means of the brake calliper, wherein guide faces (11, 12) are arranged on the lining cavity (10) for the radial and tangential guidance of the brake pad, and wherein the brake carrier (3) is arranged directly on the axle beam (1) and extends substantial transversely thereto, characterized in that the brake carrier (3) is designed in the form of a planar plate, preferably in the form of a flat steel plate, and at least one wear plate (40, 40a), which is arranged on the inside of the lining cavity (10) and on which are formed a radial guide face (11) and a tangential guide face (12) for the brake pad, is provided for the interchangeability of the guide faces (11, 12) arranged on the lining cavity (10).
12. A disc brake according to any one of the preceding Claims, characterized in that the brake carrier (3; 3 a, 3b) is welded to the axle beam (1).
16. A disc brake according to Claim 1, characterized by means (43) formed integrally on the wear plate (40, 40a) for fixing the wear plate to the lining cavity (10), preferably in the form of folds extending over the flat sides (25, 26) of the brake carrier (3).

3 The defendant sells brake pad kits suitable as replacement parts for disc brake models manufactured by the plaintiff. The installation accessories supplied include two wear plates.

4 The plaintiff considers this to be an indirect infringement of the patent in
suit.

5 The District Court ordered the defendant to cease and desist, to provide
information, to render accounts, and to pay pre-court warning costs, and found the
defendant liable for damages. The defendant's appeal against this was
unsuccessful. In the appeal allowed by the Senate, the defendant is pursuing its
request for the complaint to be dismissed. The plaintiff opposes the appeal.

Reasons for Decision:

6 The admissible appeal is successful and leads to the dismissal of the
complaint.

7 I. The patent in suit relates to a disc brake with a brake carrier
which is fixedly attached to an axle beam.

8 1. Disc brakes with similar features were known in the prior art.

9 Among these, according to the patent in suit, were brakes composed of two
separate parts arranged on either side of the brake disc. Other arrangements had
a brake carrier which held only the inner brake lining, while the outer brake lining
was held and guided by a brake caliper, the brake caliper being designed as a
sliding caliper with sliding guide elements and the brake carrier having support
arms for this purpose.

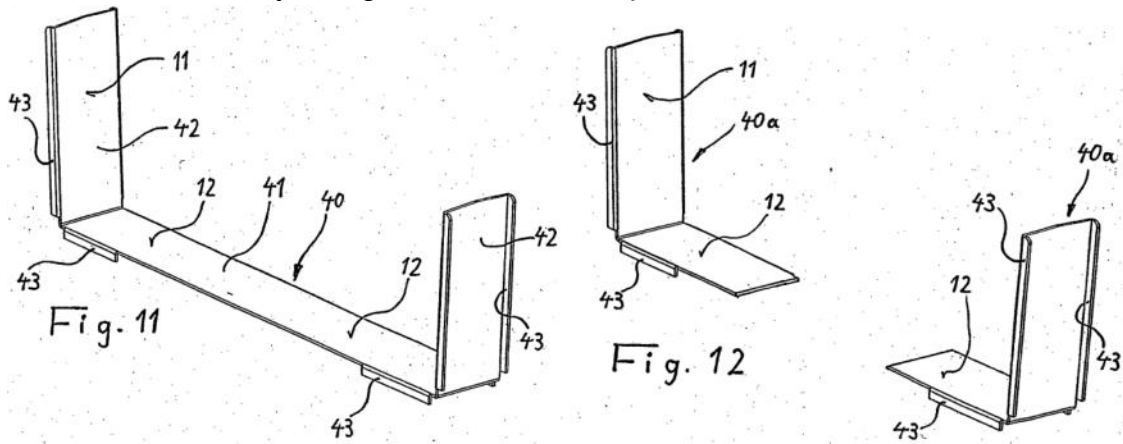
10 2. Against this background, as the Senate has already explained in
the invalidity proceedings, the patent in suit relates to the technical problem of
providing a disc brake that is as simple as possible in design, as light as possible
and as easy as possible to assemble (Federal Supreme Court (BGH), judgment
of December 15, 2020 - X ZR 180/18, GRUR 2021, 701 para. 9 -
Scheibenbremse).

- 11 3. To solve this, claim 1 as in force proposes a disc brake whose features can be divided as follows:

Disc brake

1. with a brake carrier (3) arranged fixed with respect to an axle beam (1)
 - 1.1 having receiving elements (21) fixed on it for the fastening and floating mounting of a brake calliper,
 - 1.2 The brake carrier (3) has a lining cavity (10) for receiving a brake pad resting against a disc of the disc brake and each further brake pad is arranged in a receiving means of the brake calliper,
 - 1.2.1 Guide faces (11, 12) are arranged on the lining cavity (10) for the radial and tangential guidance of the brake pad.
 - 1.3 The brake carrier (3) is arranged directly on the axle beam (1) and extends substantial transversely thereto.
2. The brake carrier (3) is designed in the form of a planar plate, preferably in the form of a flat steel plate.
3. At least one wear plate (40, 40a) which is arranged on the inside of the lining cavity (10) and which is provided for the interchangeability of the guide faces (11, 12) arranged on the lining cavity (10),
 - 3.1 on which a radial (11) and
 - 3.2 a tangential (12) guide surface for the brake pad is formed.

12 4. Examples of embodiments of a wear plate in the sense of feature 3 are shown schematically in Figures 11 and 12 reproduced below.



13 II. The Court of Appeals gave the following main reasons for its decision:

14 The distribution of the disputed wear plates is reasons for an indirect infringement of the patent in suit. They were an essential element of the patented invention because they were expressly mentioned in the characterizing part of the main claim and made a decisive contribution to the solution. The patented disc brake is low-maintenance because in the event of wear it is no longer necessary to replace the entire brake carrier, but only the wear plates.

15 The installation of the wear plates distributed by the defendant in Germany as spare parts for disc brakes manufactured by the plaintiff results in a disc brake which is directly patentable and has all the features of claims 1, 12 and 16. In particular, this brake has a flat, plane steel plate within the meaning of feature 2.

16 Customers of the defendant who are in possession of the plaintiff's brakes and have a need for replacement are not entitled to replacement because the replacement of used wear plates results in a patent remanufacture.

17 This replacement was to be regarded as a normal maintenance measure for the use of an asset which continued to be marketable and which originated from the patent owner. Under these circumstances, however, a new production is to be assumed by way of exception if the technical effects of the invention appear precisely in the replaced wear plates. Whether the contribution to the invention made available by the replacement part was of central importance and whether the advantages of the invention were realized in the replacement part was to be assessed on the basis of the content of the patent specification.

18 The patent in suit pursues several objectives. In addition to assembly advantages and the reduction of the brake pad weight, a high degree of ease of maintenance in the event of wear is to be ensured. The ease of maintenance is achieved by the fact that the guide surfaces of the lining shaft for the brake pad are protected by separately replaceable wear plates. They therefore represent a central solvent for this part of the task. Therefore, their replacement was to be regarded as new production.

19 III. This does not withstand review under the law of revision in one decisive point.

20 1. The interpretation of the claims by the Court of Appeal is, however, correct.

21 A steel plate is flat and level within the meaning of feature 2 even if it has minor protrusions in individual, small areas which serve neither the purpose of supporting the brake caliper nor similar purposes essential to the function of the invention.

22 a) As the Senate has already stated in the invalidity proceedings, a panel is in principle to be regarded as flat within the meaning of feature 2 if it has no significant elevations or depressions.

23 Accordingly, in particular weight-reducing recesses or openings as well as bores and countersunk holes for fastening or receiving other elements are irrelevant, because a plate with such features is represented in the description of the patent in suit as being according to the invention. This understanding is consistent with the description of a prior art patent application in which the brake carrier is provided with support arms extending outwardly beyond the brake disc and serving to support the brake caliper. Both the attribute "flat" and the attribute "planar" serve to distinguish this embodiment (Federal Supreme Court (BGH), judgment of December 15, 2020 - X ZR 180/18, GRUR 2021, 701 para. 21 f. - Scheibenbremse).

24 b) Against this background, the Court of Appeal correctly concluded that a plate is flat and level within the meaning of feature 2 even if it has minor elevations in individual areas which do not serve to support the brake caliper or similar purposes.

25 Such elevations are not to be judged differently from the recesses, openings, bores and countersinks expressly mentioned in the description, provided that they have only a minor effect on the overall dimensions of the panel and do not have the function of the support arms criticized by the patent in suit and known from the prior art.

26 2 On this basis, the Court of Appeal did not err in law in its assessment that the brakes for which the contested spare parts are intended satisfy feature 2.

27 a) According to the findings of the Court of Appeal, the elevations have a relatively large surface area but only a marginal height, which is why they are not comparable to the support arms known from the prior art.

28 These findings support the conclusion that the elevations are minor and not for caliper storage or similar purposes.

29 b) Against this background, the plaintiff's submission referred to by the Court of Appeal, according to which the surveys only account for around 1.8% of the total weight of the brake carrier, is of no decisive significance.

30 It can be assumed with the Court of Appeal that the design according to feature 2 makes it possible to keep the weight of the brake carrier low. However, it cannot be concluded from this that only a certain proportion of the weight may be accounted for by elevations.

31 The description of the patent in suit explicitly cites recesses and indentations as a means of achieving further weight reduction. Such a design necessarily leads to the fact that there are areas which have a greater thickness than the areas surrounding them. A restriction to the effect that the higher areas may only account for a certain proportion of the total weight cannot be inferred from the patent in suit.

32 3. Likewise, the Court of Appeal rightly decided that the challenged wear plates relate to an essential element of the invention.

33 a) According to the case law of the Senate, a means relates to an essential element of the invention if it is suitable to functionally cooperate with one or more features of the claim in the realization of the protected inventive concept (Federal

Supreme Court (BGH), judgment of May 4, 2004 - X ZR 48/03, BGHZ 159, 76, 85 = GRUR 2004, 758, 761 - Flügelradzähler).

34 Means which can be used in the use of the invention but which do not contribute to the realization of the teaching of the invention are not covered by this criterion. If, on the other hand, a means makes such a contribution, it is generally irrelevant with which feature or features of the claim the means interacts. What is part of the claim is therefore already regularly an essential element of the invention (Federal Supreme Court (BGH), judgment of February 27, 2007 X ZR 38/06, BGHZ 171, 167 para. 18 - Pipettensystem).

35 b) The court of appeal applied these principles to the case in dispute without any error of law.

36 The Court of Appeal correctly considered the advantage, also emphasized in the description of the patent in suit (para. 32), that in the event of wear it is not necessary to replace the entire brake carrier, but only the wear plate, as a contribution to the realization of the protected inventive idea.

37 Contrary to the opinion of the revision, the wear plates contribute to the realization of the protected teaching against this background.

38 As the appeal rightly asserts, the above-mentioned design may have the disadvantage that the brake comprises more components overall and that replacement of wear parts is necessary more often overall than in the case of a design without wear plates. However, this disadvantage is countered by the advantage, also described in the description, that the replacement of the wear plates can be carried out together with maintenance work that is already required on a regular basis, for example every third change of the brake pads (Para. 32). In any case, this is an essential contribution to the realization of the protected invention.

39 Against this background, whether the attachment of wear plates for these purposes was known in the prior art in itself is not relevant for the assessment. Even known elements can contribute to the realization of the protected inventive idea (Federal Supreme Court (BGH), judgment of May 4, 2004 - X ZR 48/03, BGHZ 159, 76 = GRUR 2004, 758, 761 - Flügelradzähler).

40 4. Contrary to the opinion of the Court of Appeal, however, the principle of exhaustion precludes the plaintiff from opposing the use of the challenged wear plates in brakes that were placed on the market with the plaintiff's consent.

41 a) According to the established case law of the Federal Supreme Court, the exclusive right under a patent relating to a product is exhausted with respect to those copies of the protected product which have been put on the market by the patent owner or with his consent. The lawful acquirers as well as subsequent third party acquirers - including competitors of the patent owner - are authorized to use these copies as intended, to sell them to third parties or to offer them to third parties for one of these purposes (see only Federal Supreme Court (BGH), judgment of July 17, 2012 X ZR 97/11, GRUR 2012, 1118 para. 17 - Palettenbehälter II; judgment of February 27, 2007 - X ZR 38/06, BGHZ 171, 167 para. 27 - Pipettensystem).

42 Intended use includes the maintenance and restoration of serviceability if the functional or performance capability of the specific specimen is impaired or cancelled in whole or in part by wear and tear, damage or for other reasons.

43 By contrast, the intended use does not include all measures that amount to remanufacturing a product that complies with the patent, because the patent owner's exclusive right to manufacture is not exhausted when a copy of the product that complies with the patent is placed on the market for the first time (Federal

Supreme Court (BGH), judgment of October 24, 2017 X ZR 55/16, BGHZ 216, 300 para. 35 et seq. - Drum unit).

44 b) According to the case law of the Federal Supreme Court, the demarcation between intended use and new production is in principle primarily determined by whether the measures taken preserve the identity of the specific copy of a patentable product already placed on the market or whether they are tantamount to the creation of a new copy of the patentable product.

45 In order to assess this question, it is necessary to weigh the interests of the patent owner in the economic exploitation of the invention on the one hand and the interests of the customer in the unhindered use of the specific product according to the invention that has been put on the market, taking into account the specific nature of the patented product. This is generally the task of the judge of fact (Federal Supreme Court (BGH), judgment of October 24, 2017 X ZR 55/16, BGHZ 216, 300 para. 53 f. - Trommeleinheit; judgment of July 17, 2012 - X ZR 97/11, GRUR 2012, 1118 para. 26 - Palettenbehälter II; judgment of February 27, 2007 - X ZR 38/06, BGHZ 171, 167 para. 27 - Pipettensystem; judgment of May 4, 2004 - X ZR 48/03, BGHZ 159, 76, 91 - Flügelradzähler).

46 Insofar as a market perception can be established and the measure in question is to be regarded as a new production according to this, this is usually of decisive importance (Federal Supreme Court (BGH), judgment of October 24, 2017 X ZR 55/16, BGHZ 216, 300 para. 54 et seq. - Trommeleinheit).

47 c) A measure which is not already to be regarded as a new production according to the public perception can nevertheless be assessed as such under patent law if the technical effects of the invention are reflected precisely in the replaced parts (see only Federal Supreme Court (BGH), judgment of October 24, 2017 X ZR 55/16, BGHZ 216, 300 para. 54 - drum unit).

48 In this context, it is not sufficient if a replaced part interacts with other parts, but in this respect is only a mere object of an effect according to the invention, which finds its objective embodiment solely in the other parts (Federal Supreme Court, judgment of February 27, 2007 - X ZR 38/06, Federal Supreme Court) 171, 167 para. 31 - Pipettensystem; judgment of October 24, 2017 X ZR 55/16, Federal Supreme Court) 216, 300 para. 70 - Trommeleinheit).

49 d) In the case in dispute, the Court of Appeal came to the conclusion that the replacement of the challenged wear plates is not to be regarded as a new production of a disc brake protected by the patent in suit according to the perception of the trade. These considerations, which are not challenged, do not reveal any error of law.

50 e) Contrary to the opinion of the court of appeal, a new production is also not to be affirmed because of the technical effects of the challenged parts.

51 aa) However, the Court of Appeal correctly assumed that the technical effects of the invention that are relevant in this context also include the low maintenance requirements and the long service life of the protected device as a whole.

52 As already stated above, the advantages mentioned constitute a contribution to the realization of the protected inventive concept. It follows from this that the realization of these advantages belong to the technical effects of the invention which are of importance for the delimitation between permissible use and prohibited new production.

53 bb) However, even if the attacked wear parts belong to the parts in which these effects according to the invention are reflected, their replacement does not lead to a new production.

54 The technical effect of the attacked wear parts consists solely in the fact that they wear and thus counteract wear of the firmly welded-on brake carrier. This effect is not sufficient to affirm a new production.

55 (1) The replacement of a component which is designed as a wearing part and limited to this function does not add any technical function to the product concerned. Rather, only the conditions are again created for the product to achieve the intended long service life. However, the maintenance of the intended service life is one of the actions which a lawful purchaser and his successors are generally entitled to perform.

56 This authority may be limited to the extent that the replacement of a wearing part leads to the fact that technical effects of the invention, which have been lost or limited due to the wear, are brought about again or made possible. However, this exception cannot apply if the technical effect of the replaced part consists solely in maintaining the usability of the product as a whole by forming it as a wearing part.

57 This also applies if the extension of the service life of the product as a whole is one of the objective advantages of the protected invention. Even in such cases, the user of a specimen placed on the market with the consent of the person entitled cannot be denied the right to ensure the possibility of use over the entire intended service life by carrying out the maintenance measures provided for this purpose. A different assessment can only be considered if the invention has further effects and at least one of these effects is also reflected in the replaced part. If, on the other hand, the patent owner were also entitled to replace a mere wearing part, the rule/exception relationship shown would be reversed.

This resulted in excessive harm to the legitimate interests of the rightful purchasers.

58 According to the case law of the Federal Supreme Court, the delimitation based on the question whether the technical effects of the invention are reflected in the replaced part requires an evaluative consideration based on patent law considerations. The objective of the delimitation is an appropriate balance between the interests of the patent owner worthy of protection in the economic exploitation of the invention and the interests of the customer worthy of protection in the unhindered use of the product put on the market (Federal Supreme Court (BGH), judgment of October 24, 2017 X ZR 55/16, BGHZ 216, 300 para. 62 - Trommeleinheit). Such compensation would not be achieved if a user were prevented from replacing a wearing part simply because the wear of this part is part of the effects of the invention.

59 (2) In the case in dispute, new production must be denied. The technical effect of the attacked wear plates consists solely in the fact that they wear out.

60 This is not contradicted by the fact that the shape of the wear plates must be adapted to the brake carrier so that they can be incorporated into the overall device, and that patent claim 16, on which the complaint is based, among other things, provides for a specific shape.

61 This design only serves the purpose of ensuring the intended effect as a wear plate. However, additional effects such as a particularly simple installation (see OLG Karlsruhe, judgment of July 23, 2014 - 6 U 89/13, legal para. 72 et seq.; judgment of November 11, 2015 - 6 U 151/14, legal para. 73 et seq.) do not apply to the challenged wear plates even if the specifications for their design are taken into account.

62 IV. The case is ripe for final decision (Section 563 (3) Code of Civil
Procedure (ZPO)).

63 1. It follows from the above considerations that the replacement of the
challenged wear plates is not to be regarded as new production. Consequently,
the rights of the plaintiff with regard to the challenged acts are exhausted.

64 2. A suspension until the decision on a currently pending second nullity
action, which led to the partial destruction of the patent in suit in the first instance
(BPatG, judgment of July 4, 2022 - 4 Ni 23/21 (EP)), is not occasioned.

65 a) Whether or not the patent in suit as in force proves to be legally valid
is not relevant for the decision of the dispute, because for the reasons stated
above the challenged acts do not constitute an infringement of the property right
in this case.

66 b) Nothing else applies to the version now considered legally valid by the
Federal Patent Court and to the versions sought by the plaintiff with its priority
auxiliary requests. This also applies to auxiliary request 7 cited by the plaintiff at
the oral appeal hearing (defended in fifth place in the invalidity proceedings at first
instance).

67 The version according to the judgment of the Patent Court and the version
according to auxiliary request 7 additionally provide that the wear plates for each
lining shaft are provided as two separate angle plates, that means are attached
to these plates to fix them to the lining shaft, and that these means have a certain
shape.

68 Even according to these versions, there is no additional technical effect of the
wear plates beyond the protection of the brake carrier against wear. The special
design may contribute to the fact that the effect as a wear plate can be achieved
in a particularly purposeful manner.

However, this is not an additional effect that could lead to the affirmation of a new production.

69 V. The decision on costs is based on Section 91 (1) of the Code of Civil Procedure (ZPO).

Bacher

Hoffmann

Deichfuß

Kober-Dehm

Rensen

Lower courts:

Düsseldorf District Court, decision dated February 07, 2019 - 4c O 98/17 -

Düsseldorf Higher Regional Court, Decision dated January 23, 2020 - I-2 U 13/19 -