Machine translation

FEDERAL COURT OF JUSTICE

JUDGMENT IN THE NAME OF THE PEOPLE

X ZR 30/21

Announced on:
November 14, 2023
Zöller
Judicial Employee
as Clerk of the
Court Registry

in the legal dispute

Reference book: yes
BGHZ: yes
BGHR: yes

Upholstery converting machine

PatG §§ 9, 10, 139 para. 2, § 141 sentence 2; BGB §§ 242 Cb, 259, 852 sentence 1

a) For the calculation of the damage incurred by the right holder due to the infringement of a patent on the basis of the profit made by the infringer, all profits causally related to the infringement of the patent must in principle be taken into account (confirmation of BGH, judgment of May 29, 1962 - I ZR 132/60, GRUR 1962, 509 - Dia-Rähmchen II).

b) This includes profits from additional transactions which do not constitute an act of use within the meaning of Section 9 or Section 10 PatG, but whose conclusion is causally related to patent infringing acts and has a sufficient connection to the infringing object.

c) When calculating the damage caused by acts of use during the term of the patent, processes that only led to (additional) damage after the expiry of the patent must also be taken into account.

d) A claim for information and accounting is already given in relation to additional transactions if there is a possibility that the turnover and profits generated are relevant to the amount of the claim for damages.

e) These principles also apply to claims for damages by the right holder, which can only be asserted to the extent standardized in Section 141 sentence 2 PatG and Section 852 sentence 1 BGB due to the statute of limitations.

Federal Supreme Court (BGH), judgment of November 14, 2023 - X ZR 30/21 - OLG Karlsruhe
LG Mannheim

ECLI:DE:BGH:2023:141123UXZR30.21.0

The X. Civil Senate of the Federal Court of Justice at the hearing on November 14, 2023 by the presiding judge Dr. Bacher, the judge Hoffmann and the judges Dr. Kober-Dehm, Dr. Marx and Dr. Rombach

found to be right:

The appeal against the judgment of the 6th Civil Senate of the Higher Regional Court of Karlsruhe dated March 10, 2021 is dismissed.
Orders the defendant to pay the costs of the proceedings before the Federal Court of Justice (Bundesgerichtshof).

By law

Facts of the Case:

1 The plaintiff is suing the defendant for infringement of European patent 776 760 (the patent in suit), filed on July 21, 1995, relating to an upholstery converting machine.

2 The defendant manufactures upholstery converting machines and also sells them by way of leasing in cooperation with other companies. In addition, the defendant sells paper for use in these machines.

3 The plaintiff has argued that four types of machines marketed by the defendant make direct use of the teaching of the patent in suit.

4 The Regional Court considered the action to be well-founded with regard to two of the four attacked embodiments. With regard to these two embodiments, it ordered the defendant, insofar as still of interest for the appeal proceedings, to provide information and render accounts also with regard to the supply of consumables for use in the attacked devices and with regard to leasing contracts concluded for such devices and determined that the claim for information with regard to maintenance contracts for such devices is settled (nos. 3, 4 and 5 of the operative part).

5 The defendant's appeal against this part of the first instance decision was unsuccessful. With its appeal on points of law (only) permitted by the Senate to this extent, the defendant continues to pursue its motion to dismiss the action in this respect.

Reasons for Decision:

6 The Admissible appeal is unsuccessful on the merits.

7 I. The Court of Appeal justified its decision - insofar as relevant for the revision proceedings - essentially as follows:

8 The distribution of two of the challenged embodiments constitutes a culpable direct infringement of the patent in suit.

9 The resulting obligation of the defendant to pay damages extends to acts of use up to the expiry of the property right. However, due to the statute of limitations, a claim for damages for acts of use committed before December 30, 2004 is not enforceable. For acts of use from the period from December 30, 2004 to December 31, 2010, the obligation to pay damages is limited to the restitution of the unjust enrichment.

10 Due to the acts of use committed from December 30, 2004 until the expiry of the property right, the plaintiff could also demand information and invoicing with regard to the supply of consumables - in particular paper - for patent-infringing machines as well as leasing and maintenance contracts concluded for these. The plaintiff needs this information above all to determine and calculate the infringer's profit. This could also be demanded even if the obligation to pay damages was limited to the surrender of the profits gained through the patent infringement. With regard to the maintenance contracts, the claim was settled after the zero information had been provided, as the Regional Court had rightly found.

11 In terms of time, the claim for information and invoicing is not limited to sales transactions with consumables or leasing payments before the expiry of the patent in suit. Rather, it is sufficient that the sale of the patent-infringing

machine or the conclusion of a leasing transaction before this date was causal for the further business with the consumables or the receipt of the further leasing installments.

12 Whether and to what extent profits from leasing contracts and transactions with consumables for infringing devices are ultimately included in the calculation of the infringer's profit does not need to be clarified at this stage of the proceedings. The possibility that these transactions could be taken into account in the calculation of the infringer's profit is sufficient for the existence of a claim for information and accounting.

13 The latter is the case for sales of the infringer which are causally based on an act of use infringing the patent. Whether the economic income generated from the other transactions was based precisely on the advantages provided by the patent in suit could at most be of significance for the scope of the profit to be surrendered. The scope of the duty to provide information is not affected by this. This is the only way to enable the patent proprietor to determine the relevant transactions for calculating the infringer's profit and to verify the information provided by the infringer.

14 The causality required according to this was to be assumed in the case in dispute. It is not apparent that contracts for the supply of consumables, maintenance and leasing would have been concluded even without the distribution of the infringing devices.

15 A temporal restriction of the information and invoicing to transactions with consumables that were concluded before the expiry of the patent in suit was not necessary. Nor is such a restriction to leasing payments received before the expiry of the patent necessary. In this respect, too, it was sufficient that the respective patent-infringing act of use before the expiry of the patent in suit was causal for the further sales business. Therefore, leasing transactions concluded after the expiry of the property right could also be included, provided that they involved devices

which had been the subject of patent infringing acts of use before the expiry of the property right.

16 II. This decision stands up to legal review.

17 1. The Court of Appeal rightly assumed that the claim for surrender of the infringer's profits can also relate to profits that the infringer has made by supplying consumables and by concluding leasing and maintenance contracts for patent-compliant devices.

18 a) For the calculation of damages on the basis of the profit made by the infringer, all profits causally related to the infringement of the patent must be taken into account.

19 aa) The damage to be compensated by the infringement of an industrial property right is already to be seen in the impairment of the absolute right and the possibilities of use associated with it, which are assigned solely to the owner.

20 The damage consists in the fact that the infringer uses the specific market opportunities conveyed by the intangible property for himself and thus at the same time deprives the owner of the property right of their use. The aim of the methods for calculating damages is to determine the amount that is necessary and appropriate to compensate for this damage, and thus to determine the economic value of the property right and the market opportunity embodied in it. This is captured by the expected but lost profit of the property right holder, by the actual profit of the infringer or by the profit expectation that reasonable contracting parties would have associated with the conclusion of a license agreement on the use of the property right (BGH, judgment of 24 July 2012 - X ZR 51/11, BGHZ 194, 194 = GRUR 2012, 1226 marginal no. 15 f. - Bottle carrier).

21 bb) In contrast to the claim for compensation for lost profits, compensation for damages through the surrender of the infringer's profits and compensation through the payment of a reasonable license fee are not aimed at compensating for the specific damage incurred. Rather, the two latter calculation methods aim in a different way at an equitable compensation of the financial disadvantage suffered by the infringed right holder.

22 The claim for surrender of the profit is based on the consideration that it would be unfair to leave the infringer a profit based on culpable unauthorized use of the property right (BGH, judgment of 26 March 2019 - X ZR 109/16, BGHZ 221, 342 = GRUR 2019, 496 para. 20 - Chip supply device). It aims to compensate for the fact that the infringer has made use of the teaching of the invention in sales transactions and thus exploited the market opportunity assigned to the property right holder by the legal system (BGH, judgment of July 24, 2012 - X ZR 51/11, BGHZ 194, 194 = GRUR 2012, 1226 para. 35 - Bottle carrier).

23 The absorption of the infringer's profit also serves to sanction the harmful conduct and in this way to prevent an infringement of the particularly vulnerable intellectual property rights (BGH, judgment of March 26, 2019 - X ZR 109/16, BGHZ 221, 342 = GRUR 2019, 496 marginal no. 20 - Spannungsversorgungsvorrichtung).

24 cc) The extent to which the profit generated is attributable to the infringement of property rights cannot usually be determined precisely, but can only be estimated.

25 The necessary causal connection between the infringement of the property right and the profit made is therefore not only to be understood in terms of adequate causality. Rather, even in the case of profits from the marketing of patent-compliant devices, it must be determined on an evaluative basis whether and to what extent the profit achieved is based on the properties of the sold item

associated with the infringed property right or other factors (BGH, judgment of July 24, 2012 - X ZR 51/11, BGHZ 194, 194 = GRUR 2012, 1226 marginal no. 20 - Bottle carrier; decision of September 3, 2013 - X ZR 130/12, GRUR 2013, 1212 marginal no. 5 - Cable lock).

26 b) Based on this, the claim for the surrender of the seller's profit is also directed at profits that have been achieved through the conclusion of leasing contracts for patented devices.

27 The sale of patented devices by way of leasing means that they are offered and placed on the market within the meaning of Section 9 No. 1 PatG. The patent proprietor is therefore entitled to information about the conclusion of such contracts and to an accounting of the income and profits generated from them. Which part of these profits is based on the patent infringement must be determined on the basis of the other relevant factors.

28 c) Also included are profits from additional transactions which do not constitute an act of use within the meaning of § 9 or § 10 PatG, but whose conclusion is causally related to patent infringing acts and has a sufficient connection to the infringing subject matter.

29 aa) This is not precluded by the fact that the subject matter of such transactions is subject to the exclusive right established by the patent.

30 The claim for surrender of the infringer's profit is only directed to the profit that has been achieved through the unauthorized use of the invention. However, this profit is not necessarily limited to pecuniary benefits obtained in exchange for the provision of patented items.

31 The claim for restitution of profits can only fulfill its function of providing fair compensation for the financial disadvantage suffered by the infringed right holder if it relates to all profits made by the infringer because he took advantage of a market opportunity that was only accessible to him if the property right had been infringed. The right holder is entitled to compensation not only for the pecuniary disadvantages that he has suffered because he was deprived of the opportunity to collect remuneration for the acts of use liable to damages, but also for consequential damages from additional business that would have been possible if he had used the invention.

32 Consequently, the infringer's profit from such additional transactions must also be included in the basis for calculating the profit to be surrendered, provided that the necessary causal link to the patent infringement exists (BGH, judgment of May 29, 1962 - I U 82/02 jur. May 1962 - I ZR 132/60, GRUR 1962, 509, 512 et seq. - Dia-Rähmchen II; OLG Düsseldorf, judgment of November 20, 2008 - 2 U 82/02 - juris para. 143; judgment of November 3, 2022 - 2 U 39/21, GRUR 2023, 394 para. 120 et seq. - Tassenspender; Grabinski/Zülch in Benkard, Patentgesetz, 11th ed, § Section 139 para. 73a; Mes, Patentgesetz, 5th ed., Section 139 para. 175; Grabinski, GRUR 2009, 260, 262; Kühnen, Handbuch der Patentverletzung, 15th ed., Chapter D para. 749 ff.).

33 bb) However, the required causal link to the patent infringement may be lacking if an additional profit is causally linked to the sale of a protected device, but this link is based on circumstances that have nothing to do with the technical properties of the protected invention.

34 From this point of view, the Federal Court of Justice has, for example, regarded profits generated by reinvesting profits from a patent infringement in other areas as generally not to be surrendered

or which the infringer only achieved because he was able to increase his level of awareness and thus the sale of other products through patent-infringing sales activities (BGH, judgment of May 29, 1962 - I ZR 132/60, GRUR 1962, 509, 512 - Dia-Rähmchen II).

35 cc) However, a sufficient connection to a patent-infringing act exists in any case in the case of profits from additional transactions that are related to patent-infringing objects.

36 (1) Such a connection exists in principle if the transaction relates to a patent-infringing object, as is the case, for example, with a maintenance contract for a machine placed on the market in infringement of the patent, the conclusion of which is causally linked to the delivery of the machine by the infringer.

37 As with the profit from placing the infringing object on the market, in such constellations the profit from the additional business will generally not be based solely on the patent infringement, but on other factors that were decisive for the customer's purchase decision. However, this does not change the fact that the profit is in any case also based on the patent infringement because the additional service could not have been provided without the marketing of the infringing device.

38 The objection that the infringer could also have achieved the profit through lawful alternative conduct is generally denied to the infringer under these conditions - as well as in connection with the profit from the sale of the protected device (see BGH, judgment of July 24, 2012 - X ZR 51/11, BGHZ 194, 194 = GRUR 2012, 1226 marginal no. 35 - Bottle carrier).

39 (2) A sufficient connection to an infringing object also exists in the case of profits from transactions causally related to the patent infringement concerning other objects which are intended for use with an infringing device.

40 Even in this constellation, the additional profits could not have been achieved without placing the infringing device on the market. Therefore, the infringer is also denied the right to invoke lawful alternative conduct in this constellation.

41 dd) Contrary to the opinion of the appeal, this does not only apply to profits from additional services for which a continuing obligation with certain minimum purchase obligations or a certain minimum duration has already been established upon the sale of a patented device.

42 The required causal link can also exist without such a contractual obligation. It exists in particular if a customer concludes a subsequent additional transaction with the supplier only because he also purchased the patented device from the supplier. The affirmation of such a connection may be particularly obvious if the additionally acquired items are adapted to the protected device in terms of their nature or if the purchase from a single source offers advantages for other reasons.

43 2. The Court of Appeal was also right to assume that the plaintiff's claim may also cover profits that were only made after the expiry of the patent protection, even if the underlying contracts were only concluded after the expiry of the patent.

44 a) However, as the appeal rightly asserts, use of the protected invention only gives rise to a claim for damages if it was committed during the term of the patent (BGH, judgment of May 4, 2004 - X ZR 234/02 - BGHZ 159, 66 = GRUR 2004, para. 25 - Taxameter; judgment of February 19, 2013 - X ZR 70/12 - GRUR 2013, 1269 1269). May 2004 - X ZR 234/02, BGHZ 159, 66 = GRUR 2004, 755 para. 25 - Taxameter; judgment of February 19, 2013 - X ZR 70/12, GRUR 2013, 1269 para. 17 - Wundverband; judgment of June 9, 2020 - X ZR 142/18, GRUR 2020, 986 para. 21 - Penetrometer).

45 The Court of Appeal also saw this correctly. Consequently, it clarified that the finding of liability for damages and the order to render accounts for the manufacture, offering, placing on the market, use, importation and possession of patent-infringing machines pronounced by the Regional Court only relate to acts prior to the expiry of the patent in suit.

46 b) The Court of Appeal rightly assumed that this does not exclude the possibility that, when calculating the damage caused by acts of use during the term of the patent, processes which only led to (additional) damage after this point in time may also be taken into account.

47 aa) This legal consequence arises from the basic principle outlined above, according to which all profits causally related to the infringement of the patent must be surrendered.

48 A limitation to profits accrued during the term of the patent or based on acts carried out during this period would contradict the requirement to grant the infringed right holder compensation for all financial disadvantages suffered as a result of the infringing acts.

49 bb) Contrary to the opinion of the appeal, the inclusion of such profits does not lead to a temporal extension of patent protection.

50 Only acts of infringement committed during the term of validity of the patent can be considered as a connecting factor for an obligation to pay damages and thus for the obligation to surrender profits.

51 This takes sufficient account of the limited term of validity of a patent. In contrast, neither the provisions on the maximum term of protection nor Section 139 (2) PatG contain an additional limitation to the effect that damages from an infringing act committed are only eligible for compensation to the extent that they occurred during the term of the patent.

52 cc) In view of this, with regard to profits from continuing obligations, the point in time at which these could have been terminated by ordinary termination is not decisive.

53 A causal link of the type described above between an act of infringement committed within the term of the patent and the profit made is also necessary and sufficient in this respect.

54 (1) In this context, it is irrelevant that the proprietor no longer has a right to prohibit after the expiry of the patent in suit.

55 The profits in question are not to be taken into account in the assessment of damages because the underlying legal transactions are reserved to the patent proprietor, but because they constitute a measure of the pecuniary disadvantages suffered by the patent proprietor as a result of the act giving rise to the obligation to pay damages.

56 In addition, devices that have been used in an infringing manner are not subject to free use even after the term of protection has expired. Rather, they remain subject to claims for destruction, removal from the market and recall. Profits made by the infringer in connection with such devices are therefore not to be equated with profits from the marketing of devices after the expiry of the patent. Rather, they are still the result of an unlawful act.

57 (2) For the same reason, it is irrelevant whether the additional transactions relate to a direct patent infringement.

58 The causal link required and sufficient for the attribution of damages already exists if it concerns profits caused by the patent-infringing use of the respective device during the term of the patent.

59 (3) The case law cited by the appeal on the obligation to pay damages after termination without notice of a permanent relationship cannot be transferred to the constellation to be assessed in the case in dispute.

60 The cases cited by the revision for comparison concern the obligation to pay damages for breach of contractual obligations from which the debtor could have released himself at a certain point in time. In that situation, it is consistent to hold the debtor liable only for breaches in the period for which such a solution was not possible.

61 The constellation of the dispute does not concern the premature termination of a continuing obligation, but rather the consequences of individual acts of infringement during the term of a patent. In this constellation, too, the infringer is not liable for an unlimited period of time, but only for acts committed within a certain period of time. The relevant period in this respect is determined by the term of the patent. For the reasons set out above, the infringer must compensate in full for damages caused by acts of infringement committed within this period, irrespective of the further course of time.

62 dd) This assessment is in line with the case law of the Senate on the scope of claims for injunctive relief and removal resulting from a patent infringement.

63 The Senate has ruled that an infringer who has created a continuous state of disturbance by using the invention during the term of the patent remains obliged to eliminate this state even after the term of protection has expired. This may result in the obligation not to make use of a time advantage gained through the infringement of the patent in connection with an official approval procedure (BGH, judgment of February 21, 1989 - X ZR 53/87, BGHZ 107, 46 = GRUR 1990, 997, juris para. 58 et seq. - Ethofumesat).

64 Whether the generation of profits after the expiry of the term of protection due to an act of use carried out during the existence of patent protection constitutes a state of disturbance in this sense does not require a final decision. In any case, the case law referred to above confirms that an act of infringement committed during the term of protection can lead to legal consequences in relation to the period after the expiry of the patent. Similar legal consequences arise in the constellation of the dispute from the principle that the infringer must compensate for the entire damage caused by acts of infringement committed during the term of the patent.

65 3. The Court of Appeal also correctly decided that these principles also apply to claims for damages by the right holder, which can only be asserted to the extent standardized in § 141 sentence 2 PatG and § 852 sentence 1 BGB due to the statute of limitations.

66 a) As the Senate has already ruled, any profit made by the obligor is also to be regarded as having been obtained through the infringement at the expense of the entitled party within the meaning of Section 852 sentence 1 BGB.

67 The claim for information and accounting is therefore also directed at information on the profit made for periods in which compensation is subject to the restrictions under this provision (BGH, judgment of

March 26, 2019 - X ZR 109/16, BGHZ 221, 342 = GRUR 2019, 496 marginal no. 17 et seq. - Spannungsversorgungsvorrichtung).

68 b) In this context, it is irrelevant whether and to what extent the right holder can still assert claims for destruction, conversion, removal from the distribution channels and recall despite the statute of limitations.

69 The decisive factor for the obligation to surrender profits from additional transactions is the fact that devices that are the subject of such claims cannot be freely used even after the expiry of the term of protection and it would therefore be unfair even after this time if the infringer were allowed to keep profits that have been made possible by the infringing use of such devices. This applies irrespective of whether the right holder has asserted claims for destruction and the like to which he is entitled in good time. Failure to assert such claims does not render the devices concerned in the public domain.

704 Against this background, the Court of Appeal did not err in law in affirming the plaintiff's claim for information and rendering of accounts in the scope already awarded by the Regional Court.

71 a) As an auxiliary claim for the realization of his claim for damages, the patent proprietor is entitled to an accessory auxiliary claim for information and accounting against the infringer, which is subject to the principle of good faith in terms of content and scope.

72 The scope of this claim is limited to the information required to enforce the main claim, which the creditor cannot otherwise obtain and which the debtor can easily and reasonably be expected to provide (BGH, judgment of March 26, 2019 - X ZR 109/16, BGHZ 221, 342 = GRUR 2019, 496 marginal no. 12 - Spannungsversorgungsvorrichtung).

73 b) The Court of Appeal rightly decided that a claim for information and accounting in relation to additional transactions is already given if there is a possibility that the turnover and profits generated are of significance for the amount of the claim for damages.

74 As far as possible and reasonable, the information and accounting must contain all the information that the injured party needs to decide on one of the methods of compensation available to him, to determine the amount of the compensation payment according to this method and, in addition, to verify the accuracy of the accounting (BGH, judgment of 20 May 2008 - X ZR 180/05 May 2008 - X ZR 180/05, BGHZ 176, 311 = GRUR 2008, 896 para. 31 - Tintenpatrone I; judgment of March 26, 2019 - X ZR 109/16, BGHZ 221, 342 = GRUR 2019, 496 para. 25 - Spannungsversorgungsvorrichtung).

75 As far as profits from additional transactions are concerned, there is a right to information in relation to all transactions which, due to their content, due to the circumstances under which they were concluded or due to other indications, do not appear to be remotely related to an unlawful act of use. Whether such a connection actually exists must be decided after the information has been provided.

76 c) The Court of Appeal also correctly ruled that the requirements for a claim for information and accounting for additional transactions are met in the case in dispute.

77 aa) According to the findings of the Court of Appeal, which were not challenged in this respect, the maintenance contracts would not have been concluded without the sale of the machine in question.

78 This results in a sufficient causal connection in the sense described above.

79 bb) According to the also unchallenged findings of the Court of Appeal, the defendant would in any case not have made deliveries of consumables for patent-infringing machines to the same extent if it had not distributed the machines because the defendant distributes paper with different specifications suitable for the attacked embodiments.

80 It follows from this that the required causal link exists in any event with regard to part of the profits made from the supply of consumables. From this, the Court of Appeal rightly deduced that the defendant must account for the supply of all consumables intended for use in infringing machines supplied during the term of the patent in suit.

81 cc) As the Court of Appeal also correctly recognized, nothing else follows from the fact that the patent-infringing embodiments can also be used in patent-free modes of operation.

82 This circumstance is not capable of breaking the link to the infringing acts. At most, it is relevant when assessing the question of the extent to which the profit made is based on the properties of the item sold in connection with the infringed property right. This has no influence on the scope of the obligation to render accounts.

83 dd) It is not relevant for the decision of the dispute whether the connection to the infringing act can be removed by modifying the device concerned.

84 Even if this question were to be answered in the affirmative, at least for certain constellations, this would not change the fact that the right holder may demand the rendering of accounts with regard to all additional transactions relating to an originally infringing device. Whether this connection

has lapsed at a later date remains subject to clarification in a legal dispute as to the amount of the claim for compensation.

85 d) Contrary to the opinion of the appeal, an obligation to provide information and render accounts on business transactions after the expiry of the term of protection is not unreasonable.

86 The fact that such transactions may extend over a longer period of time does not mean that the obligation to provide information and render accounts in this regard is unreasonable. The information required to fulfill this obligation is regularly available to the patent infringer due to its continued sales activities.

87 The appeal does not point to any other circumstances that could result in unreasonableness.

88 III. The decision on costs - also with regard to the costs of the appeal against denial of leave to appeal - is based on Section 97 (1) ZPO.

Bacher Hoffmann Judge at the Federal Court of Justice Dr. Kober-Dehm cannot sign due to vacation

Bacher

Marx Rombach

Lower courts:
Mannheim Regional Court, decision of 04.12.2015 - 7 O 210/14 -
OLG Karlsruhe, decision of 10.03.2021 - 6 U 9/16 -