



FEDERAL SUPREME COURT
IN THE NAME OF THE PEOPLE
JUDGMENT

X ZR 47/19

Pronounced on:
June 8, 2021
Anderer
Judicial Employee
as Clerk of the Court
Registry

in the legal dispute

Reference book: yes
BGHZ: no
BGHR: yes

Ultrasonic converter

Section 139 (2), section 140a (3) sentence 1 of German Patent Act (PatG)

- a) If a manufacturer domiciled abroad has delivered products to a customer also domiciled abroad, although there are concrete indications that the customer will offer or market the delivered goods in Germany despite patent protection existing there, claims for injunctive relief, disclosure and damages in relation to other customers exist only to the extent that the same characteristic circumstances exist in relation to them that justify the unlawfulness of the delivery to one customer.
- b) These circumstances must be specifically described in the statement of claim or in the statement of grounds as well as in a judgment granting the claim or its reasons (continuation of Federal Supreme Court (BGH), judgment of May 16, 2017 - X ZR 120/15, BGHZ 215, 89 para. 62 et seq. – Abdichtsystem).

BGH, Judgment of June 8, 2021 - X ZR 47/19 – Court of Appeal (OLG) Hamburg
District Court (LG) Hamburg

ECLI:DE:BGH:2021:080621UXZR47.19.0

The X. Civil Senate of the Federal Supreme Court, at the oral hearing on June 8, 2021, by the Presiding Judge Dr. Bacher, Judges Dr. Grabinski and Hoffmann, Judge Dr. Kober-Dehm and Judge Dr. Rensen

ruled as follows:

On revision by the defendant, the judgment of the 3rd Civil Senate of the Hanseatic Court of Appeal of April 25, 2019 is set aside with respect to costs and insofar as it dismissed the appeal of the 1st defendant against the finding of liability for damages by the judgment of the Hamburg District Court of May 22, 2015.

The case is referred back to the Court of Appeal for a new hearing and decision, including on the costs of the appeal.

By law

Facts of the Case:

1 The plaintiff is the proprietor of German patent 199 37 195 (patent in suit), which was applied for on August 6, 1999 and the grant of which was published on March 9, 2006. The patent in suit relates to an ultrasonic converter which can be used as part of parking assistance systems for motor vehicles. Patent claim 1 reads:

Ultrasonic converter (1) comprising a housing (2), with a membrane (3), with a piezo element (13) arranged at the membrane (3), with a rubber-like holding element (4) which holds the membrane (3) in the housing (2), and with a conductor track element (14) connected to the piezo element (13), the holding element (4) comprising a first section for sealing with respect to the housing (2), characterized in that the holding element (4) comprises a further second section with a cone (5) adjoining the first section and projecting beyond the housing in axial direction, wherein the cone sealingly receives the membrane (3) in the region of its tapering end and is provided for sealing abutment against a holder (24) accommodating the ultrasonic converter (1), and wherein the membrane (3) projects beyond the housing (2) and the cone (5) in axial direction."

2 The 1st defendant (hereinafter: defendant), a company based in the Republic of China (Taiwan), manufactures in its production facilities in China and Taiwan parts and accessories for automobiles, including ultrasonic converters. The company is a supplier to numerous automobile manufacturers, including R. /D. .

3 By letter dated November 22, 2012, the plaintiff contacted the defendant and asked for an explanation as to why it was entitled to use the patent in suit by supplying ultrasonic converters to R. , which were used in vehicles of the D. L. type.

4 Ultrasonic converters manufactured by the defendant were also placed on the market in Germany by R. /D. after December 22, 2012.

5 The District Court dismissed the action insofar as it was directed against another company and two managing directors, but ordered the defendant to

injunctive relief, disclose information and render accounts and determined its obligation to pay damages. The Court of Appeal essentially dismissed defendant's appeal (Court of Appeal (OLG) Hamburg, GRUR-RR 2020, 234).

6 At the oral hearing before the Senate, the plaintiff and the defendant agreed to declare the legal dispute settled with regard to the claims for injunctive relief, disclosure of information and rendering of accounts.

7 With regard to the pending request for determination of liability for damages, the defendant continues to pursue the aim of dismissing the action. The plaintiff opposes this.

Reasons for the decision:

8 The admissible appeal is well-founded. It leads to the annulment of the
contested judgment and the referral of the case back to the court of appeal with
regard to the part of the matter in dispute that is still pending after the concordant
declaration of partial settlement.

9 I. The patent in suit relates to an ultrasonic converter which is used in
particular for park assist systems.

10 According to the specifications of the patent in suit, the membrane of such
an ultrasonic converter should be able to vibrate and be mounted in a sealed
manner. In addition, the ultrasonic converter should form a uniform plane with the
surrounding vehicle for optical, aerodynamic and aeroacoustic reasons (para. 2).
In order to prevent the entry of dust, dirt or moisture and the associated
impairment of the ultrasonic converter, it must be appropriately sealed (para. 5).
A simple structure and an easy and cost-effective installation are also desirable,
as is the precise positioning of the ultrasonic converter in a holder that holds the
ultrasonic converter (para. 6 et seq.).

11 As the Senate has already stated in nullity proceedings relating to the patent
in suit, the property right is based on the task of providing an ultrasonic converter
which is configured as simply and reliably as possible with regard to the mounting
of the membrane, its external shape, its sealing against the environment, its
structure and its assembly (Federal Supreme Court (BGH), judgment of March
20, 2018 - X ZR 4/16, juris para. 6).

12 According to the teaching of patent claim 1, this is to be achieved by a device
with the following features:

1. Ultrasonic converter comprising a housing,
2. with a membrane,
3. with a piezo element arranged at the membrane,
4. with a rubber-like holding element which holds the membrane in the housing and
5. with a conductor track element connected to the piezo element,
6. wherein the holding element comprising a first section for sealing with respect to the housing,
7. the holding element comprises a further second section with a cone adjoining the first section and projecting beyond the housing in axial direction,
8. wherein the cone receives the membrane in a sealing manner in the region of its tapering end and
9. is provided for sealing abutment against a holder accommodating the ultrasonic converter
10. and where the membrane projects beyond the housing and the cone in axial direction.

13 Figure 2 of the patent in suit, reproduced below, shows an example of an ultrasonic converter according to the invention in longitudinal section:

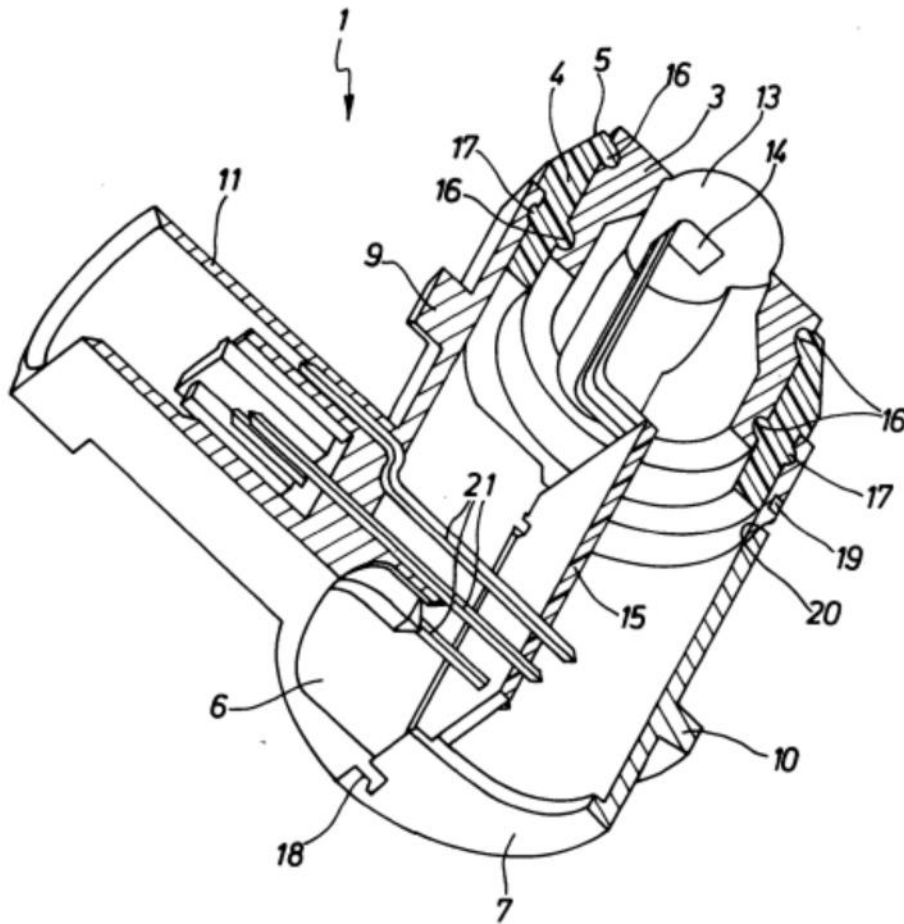


Fig. 2

14 II. The Court of Appeal essentially justified its decision as follows:

15 The contested embodiment would use the teaching of the patent in suit. In this embodiment, the piezo element would be electrically connected by the conductive membrane and a wire. Feature 5 was thus realized. The skilled person would understand a conductive track element solely as the existence of a current-conducting connection to the piezo element. It would not be necessary to have a component on or in which several electrical connections (conductive paths) run, such as in the case of a conductive foil or a printed circuit board. The only task of the conductor track element would be to supply the piezo element

with power. Further requirements for configuration could not be found in the description either. If Figure 2 were to show a conductor foil, this would merely be an embodiment example with a flexible conductor track element described as advantageous in the description. The special technical features of the converter according to the invention would not lie in the power supply of the piezo element, but in the configuration of the holding element. Feature 5 was realized in the contested embodiment, since it had a current-carrying wire for supplying the piezo element.

16 The defendant was also responsible for the fact that the contested embodiment had reached the German market. A supplier domiciled abroad of a customer also domiciled abroad is only obliged to check and monitor the further use of the delivered goods by the customer if there are concrete indications that the customer is reselling the delivered goods in Germany or offering them there. However, the defendant had such indications on the basis of the plaintiff's request for authorization dated November 22, 2012, which alleged that the contested ultrasonic converters had been placed on the German market in vehicles of the D. L. type. As the manufacturer of the ultrasonic converters, the defendant was also able to recognize that they were subject to the patent in suit.

17 The operative part of the judgment of the District Court also does not impose any unreasonable or unmanageable obligations to act and pay on the defendant. The defendant is only liable for the conduct of third parties who receive the converters at the instigation of the defendant and then offer, use, import or possess them in Germany for the aforementioned purposes. Even if the conviction is not limited to the customer R. /D. , the defendant is not subject to any excessively far-reaching inspection obligations. The prohibition imposed covers the characteristic of the infringing act and thus also acts of a similar nature which are characterized by the culpable promotion of a third-party patent infringement in breach of duty.

18 III. This assessment does not withstand appellate review in one respect.

19 1. The appeal's objection asserting that the Court of Appeal erred in law by
interpreting the term "conductor track element" in feature 5 too broadly in
accordance with the invention does not prevail.

20 a) The Court of Appeal correctly assumed that the description and the
drawings are to be used to interpret a patent claim (Art. 69 (1) EPC; Sec. 14 of
German Patent Act (PatG)).

21 It is not the wording of the individual terms that must be taken into account,
but the overall technical context that the content of the patent specification conveys
to the skilled person. It is not the linguistic or logical-scientific definition of the terms
used that is decisive, but the understanding of the unbiased skilled person (Federal
Supreme Court (BGH), judgment of March 2, 1999 - X ZR 85/96, GRUR 1999,
909, 911 - Spanschraube). As part of the interpretation, the meaning of the patent
claim as a whole and the contribution that the individual features make to the
performance result of the invention must be determined (Federal Supreme Court
(BGH), judgment of July 17, 2012 - X ZR 117/11, GRUR 2012, 1124 para. 27 -
Polymerschaum). The patent specification must be read in a meaningful context
and, in case of doubt, a patent claim must be understood in such a way that there
are no contradictions with the description and the drawings. Only if and to the
extent that the teaching of the patent claim cannot be reconciled with the
description and the drawings and an irresolvable contradiction remains, the
elements of the description or the drawings that are not reflected in the patent
claim may not be used to determine the subject matter of the patent (Federal
Supreme Court (BGH), judgment of May 10, 2011 - X ZR 16/09, GRUR 2011, 701
para. 24 - Okklusionsvorrichtung; Federal Supreme Court (BGH), judgment of
June 2, 2015 - X ZR 103/13, GRUR 2015, 972 para. 22 - Kreuzgestänge).

22 b) According to these principles, the interpretation of the court of
appeal, which is subject to full review by the supreme court as a finding of law

(established case law, see only Federal Supreme Court (BGH), judgment of March 31, 2009 - X ZR 95/05, BGHZ 180, 215 para. 16 = GRUR 2009, 653 - Straßenbaumaschine; Federal Supreme Court (BGH), judgment of June 29, 2010 - X ZR 193/03, BGHZ 186, 90 para. 15 = GRUR 2010, 858 - Crimpwerkzeug III), is not objectionable.

23 aa) In order to determine what is to be understood by a conductor track element according to the invention, the Court of Appeal correctly proceeded from the term of a conductor track, which technically characterizes this word combination, and which it defined as a conductive track, i.e. an electrically conductive connection.

24 According to feature 5, the conductive track element is connected to the piezoelectric element so that it can be supplied with current via an electrically conductive connection. This is the contribution of the conductive track element to the performance result of the claimed invention.

25 bb) The use of the term "conductor track" in the plural (conductor track element) does not imply that there must be several electrical connections to the piezo element. The power supply of the piezo element does not require a plurality of electrical connections, but can also take place via a single electrical connection. There is also no indication in the patent specification that the invention is limited to embodiments with several electrical connections.

26 cc) The understanding of the conductor track element according to the invention as an electrically conductive connection with the piezo element is consistent with the description and the drawings.

27 The description shows that the conductor track element can be configured to be flexible in an advantageous embodiment, whereby the number of individual strands that have to be contacted on the piezo element can be reduced (para. 18). In addition, with regard to the embodiment example in Figure 2, in which the conductor track element is shown as a conductor foil, it is explained that the use

of such a flexible conductor track element 14 and a rubber-like holding element 4 ensures that the membrane 3 can vibrate freely (para. 33). However, all of the above are advantageous embodiments of the conductor track element which are not reflected in the teaching of patent claim 1.

28 dd) The aforementioned understanding of feature 5 does not change even if, according to the defendant's submissions on which the assessment on appeal is to be based, it is assumed that the skilled person understood a conductor track to be a flat conductive connection applied to a carrier, particularly in data processing and automotive engineering.

29 However, as the appeal rightly asserts in this respect, it is not decisive here whether the patented solution offers something "new" with regard to the piezo element and the way in which it is supplied with power and, from this point of view, constitutes a "significant" feature for the teaching according to the invention. Rather, the decisive factor is the contribution of the conductor track element to the result according to the invention. Even when applying this standard, however, there is no deviating result.

30 As has already been explained above, the contribution of the conductor track element to the performance result according to the invention consists solely in the production of a conductive connection, while its planar configuration is of no significant importance in this respect. It follows from this that the patent in suit uses the term differently from the above-mentioned understanding.

31 c) On this basis, the Court of Appeal correctly came to the conclusion that the wire connection used in the ultrasonic converter claimed to be infringing constitutes a conductor track element within the meaning of patent claim 1.

32 d) The uncontested findings of the Court of Appeal that all other features
of this claim are also fulfilled do not reveal any error of law.

33 2. The Court of Appeal was right to regard the defendant as responsible
for the fact that the ultrasound converters it manufactured were distributed in
Germany.

34 a) According to the case law of the Senate, not only the person who
intentionally participates in the use of the protected subject matter by a third party
may be jointly liable for a patent infringement, but also the person who enables the
use of the protected subject matter by a third party through his own conduct in
breach of duty (Federal Supreme Court (BGH), judgment of September 17, 2009 -
Xa ZR 2/08, BGHZ 182, 245 para. 34 - MP3-Player-Import). However, if the
contributory causation is not based on intent, its attribution generally requires the
breach of a legal obligation by the actor which also serves to protect the infringed
absolute right and, if observed, the contributory causation would have ceased or,
in any case, would have been recognizable as a prohibited contribution of the actor
to the unlawful act of a third party and therefore to be omitted (BGHZ 182, 245
para. 36 - MP3-Player-Import).

35 A supplier of a domestically patented product domiciled abroad who supplies
a customer also domiciled abroad is not automatically obliged to check or monitor
the further use of the delivered goods by the customer. However, such an
obligation to inspect or monitor may arise if there are concrete indications that
make such actions appear obvious (Federal Supreme Court (BGH), judgment of
May 16, 2017 - X ZR 120/15, BGHZ 215, 89 = GRUR 2017, 785 para. 62 -
Abdichtsystem).

36 Concrete indications of an onward delivery to the domestic market may arise,
for example, from the fact that the supplier has become aware of an actual or

imminent onward delivery, that the quantity purchased is so large that it can hardly be distributed only on markets without intellectual property rights, or that the purchasing behavior correlates conspicuously with a perceptible and potentially infringing activity of the customer on the domestic market (BGHZ 215, 89 para. 64 - Abdichtsystem).

37 b) In the case in dispute, the Court of Appeal correctly decided that such sufficiently concrete indications of an infringement of the patent in suit by the customer R. /D. arose for the defendant from the plaintiff's letter of November 22, 2012.

38 According to the findings of the Court of Appeal, in view of the geographical location and the economic circumstances, it was obvious that large-scale deliveries to the European Union would be made from production sites in Morocco. Against this background, the notification contained in the letter of November 22, 2012 that the converters supplied by the defendant to R. would be used in vehicles of the type D. L. provided concrete evidence for the assumption of a patent-infringing distribution of the converters in Germany. According to the findings of the Court of Appeal, however, there was no concrete evidence that the R. /D. plants responsible for the German market also purchased such converters from other suppliers.

39 c) The assumption of concrete evidence for a review of the deliveries of the contested converters to Germany does not depend on whether the letter of November 22, 2012 was written as a request for authorization or as a warning.

40 The information contained in the letter about the delivery of certain vehicle types to Germany provides concrete evidence that would justify the defendant's

obligation to check. The information content of such notifications does not depend on whether the patent proprietor simultaneously threatens legal action or merely requests a statement.

41 d) After receiving the letter of November 22, 2012, the defendant was thus at least obliged to inform its customer R. /D. of the possible patent protection in Germany and to inquire about deliveries there. Since this was not done, the defendant participated in the acts of infringement committed by its customer in Germany even after December 22, 2012, according to the findings of the Court of Appeal.

42 3. The appeal rightly criticizes the fact that the finding of the obligation to pay damages confirmed by the Court of Appeal also refers to offers and deliveries to other customers abroad.

43 a) As in other areas of law (see, for example, for trademark law: Federal Supreme Court (BGH), judgment of February 23, 2006 - I ZR 27/03, BGHZ166, 233 para. 36 – Parfümtestkäufe; for copyright law: Federal Supreme Court (BGH), judgment of June 20, 2013 - I ZR 55/12, GRUR 2013, 1235 para. 18 - Restwertbörse II), however, claims for injunctive relief, disclosure and damages may also exist in patent law - insofar as there is a risk of repetition - beyond the specific infringing act to the extent of such acts in which the characteristic of the infringing act is expressed.

44 In a patent infringement action, the characteristic core is usually determined by the actual embodiment of a certain product, usually referred to as the contested embodiment, with regard to the features of the asserted patent claim, which is also decisive for determining the subject matter of the dispute (see Federal Supreme Court (BGH), judgment of February 21, 2012 - X ZR 111/09, GRUR 2012, 485 para. 19 – Rohrreinigungsdüse II).

45 b) The dispute is not only about generalizations in relation to the attacked product, but also about generalizations in relation to the circumstances under which a delivery is made in a patent-free foreign country.

46 In cases involving the offering or placing on the market of protected products in Germany by the defendant himself, this aspect is of no significance because the infringement under these conditions does not depend on the person of the purchaser, but solely on the place where the offering or placing on the market takes place.

47 In contrast, the acts abroad contested in the case in dispute are only patent infringing if specific indications are recognizable from which a duty of inspection or monitoring on the part of the defendant arises. Generalizations are therefore only permissible to the extent that they express the characteristic circumstances that justify the unlawfulness of offering or supplying to a particular customer.

48 These characteristic circumstances may not be described solely in terms of the fact that particular indications for deliveries or offers in Germany were recognizable. Otherwise, the dispute over whether certain offers or deliveries are covered by an injunction, an order to disclose information and render accounts or the determination of an obligation to pay damages would be shifted to the enforcement proceedings or a subsequent legal dispute over the amount of damages. Rather, it must at least be clear from the plaintiff's submissions and from the grounds of a decision upholding the action which characteristic elements of the facts of life justify an obligation to review or monitor and therefore represent the core of the prohibited action or the action obliging the plaintiff to pay damages.

49 c) The finding made by the District Court and confirmed by the Court of Appeal does not meet these requirements.

50 aa) The operative part of the contested decisions relates to the delivery or allowing to be delivered to other persons who offer, place on the market or use the contested ultrasound converters in Germany or import or possess them for those purposes without plaintiff's consent.

51 It cannot be inferred from this under which conditions the defendant is obliged to pay damages due to the actions of third parties. Rather, it would have to be clarified in a subsequent legal dispute about the amount of damages whether the defendant also had concrete evidence of deliveries or offers in Germany with regard to other customers.

52 The wording "to deliver or to be delivered to third parties" covers, as the Court of Appeal correctly assumed in principle, only targeted action, which is why the defendant would not automatically be liable for the conduct of any company in a supply chain. However, it does not indicate which characteristic circumstances distinguish impermissible actions from permissible ones.

53 bb) It cannot be inferred from the statements of the Court of Appeal that the contested embodiment was marketed in Germany "in particular" by R. /D. that the defendant had concrete indications, possibly also with regard to other customers, which made deliveries or offers in Germany appear obvious. A fortiori, it cannot be inferred from which characteristic circumstances such indications arose.

54 cc) The reference to certain illustrations in which converters delivered to R. /D. are shown is also not sufficient for a description of the characteristic core.

55 Neither the operative part nor the grounds of the judgment under appeal
indicate which elements of the depicted object represent the characteristic core.

56 IV. The legal dispute is not ready for a final decision (Section 563 (3) ZPO).

57 1. In the absence of factual findings by the Court of Appeal, the Senate
cannot assess whether the defendant was aware of specific indications that made
it appear obvious that delivered goods were being supplied or offered in Germany,
also with regard to other customers domiciled abroad, and by which characteristic
circumstances these indications were justified.

58 In the reopened appeal proceedings, the court of appeal will therefore have
to give the plaintiff the opportunity to supplement its submissions in this regard
and, if necessary, to submit relevant motions. Corresponding new submissions by
the plaintiff would also be admissible in the appeal proceedings because they
concern an aspect that was clearly considered irrelevant by the court of first
instance (Section 531 (2) no. 1 of German Code of Civil Procedure (ZPO)).

59 2. The versions of the request submitted to the Senate by the plaintiff in the oral hearing as a substantive minus compared to the previous request also do not allow a final decision.

60 a) The primarily sought addition of the words "to third parties" by the words "in respect of which the first defendant had concrete indications that they were delivering to the Federal Republic of Germany" merely leads to an abstract description of the requirements for patent infringement. However, it does not describe any characteristic circumstances on the basis of which it could be assessed in subsequent proceedings, without recourse to the abstract requirements, whether a particular act is covered by the requested declaration.

61 b) The replacement of the expression "to third parties" by "to R. SAS or affiliated companies", which is sought in the alternative, does not indicate, at least with regard to affiliated companies, what the characteristic circumstances are that give rise to an obligation to pay damages. In addition, a conviction on this basis could not be made anyway without first giving the defendant the opportunity to make additional factual submissions.

Bacher

Grabinski

Hoffmann

Kober-Dehm

Rensen

Lower courts:

District Court (LG) Hamburg, decision of May 22, 2015 - 315 O 110/13 -

Court of Appeal (OLG) Hamburg, decision of April 25, 2019 - 3 U 87/15 -