



# FEDERAL COURT OF JUSTICE

## ON BEHALF OF THE PEOPLE

### JUDGMENT

X ZR 75/21

Announced on:  
November 14, 2023  
Zöller  
Clerk of the Court  
as clerk of the court  
registry

in the legal dispute

Reference book:       yes  
BGHZ:                   no  
BGHR:                   yes

Plastic bag

ZPO § 543 para. 2

A limited admission of the appeal requires that the affected part of the matter in dispute can be assessed independently of the rest of the matter in dispute from a factual and legal perspective and that no contradiction to the decision on the other parts of the matter in dispute can arise even in the event of a referral back (confirmation of BGH, judgment of March 16, 2017 - I ZR 39/15, GRUR 2017, 702 marginal no. 17 - PC mit Festplatte; decision of December 16, 2021 - I ZR 186/20, marginal no. 16 [not in MMR 2022, 773]).

IntPatÜbkG Art. II § 5 para. 1; EPC Art. 60 para. 1 sentence 2; EGBGB Art. 30 old version.

The question of whether an employee can demand the transfer of rights from a patent application or from a granted patent from his employer on the basis of a service invention is to be assessed uniformly for all parts of a European patent according to the law of the state which is decisive for the employment contract.

BGB § 823 para. 2 Ag, § 249 para. 1 Hd

The obligation to pay damages due to the unauthorized filing of a patent application includes the surrender of the profit generated by the unauthorized use of the invention for the period from the publication of the notice of grant of the patent.

BGB § 242 Be; PatG § 140b

The assessment underlying § 140b PatG is not transferable to a claim for accounting for the use of an invention for which a patent application was wrongly filed.

BGH, judgment of November 14, 2023 - X ZR 75/21 - OLG Frankfurt am Main  
Frankfurt am Main Regional Court

ECLI:DE:BGH:2023:141123UXZR75.21.0

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:

On the defendant's appeal and the plaintiff's cross-appeal, the judgment of the 6th Civil Senate of the Higher Regional Court of Frankfurt am Main of July 22, 2021 is set aside and the further appeals dismissed insofar as

- a) the defendant was ordered to render accounts for the period prior to February 25, 2004 and to render accounts for the prime costs and the profit made for the period prior to March 26, 2008;
- b) the auditor's reservation relates to information on the prime costs broken down by individual cost factors and the profit generated;
- c) that the defendant is liable to pay damages for actions prior to March 26, 2008, also on the basis of the calculation of the profit made.

In the scope described under a) and c), the action is dismissed on the defendant's appeal, amending the judgment of the 6th Civil Chamber of the Regional Court of Frankfurt am Main of April 28, 2010.

The plaintiff shall bear 30% and the defendant 70% of the costs of the proceedings at first instance. Of the costs of the second instance, the plaintiff shall bear 20% and the defendant 80%. Of the costs of the appeal proceedings, the plaintiff shall bear 10% and the defendant 90%.

By right

Facts of the Case:

- 1           The parties are in dispute about the rights to an employee invention.
- 2           Among other things, the defendant manufactures films and nonwovens for the construction industry. The plaintiff was employed in a branch office as head of the finishing department (development).
- 3           On February 25, 2004, the plaintiff handed the plant manager of the branch office (Mr. S.) a letter with the heading "Application for the grant of a patent or copyright or utility model protection" (CBH2). The letter lists the defendant, the plaintiff and two other employees of the defendant (Mr. H. and Mr. L.) as applicants. It is signed by the plaintiff and the now deceased Mr. H. The letter contains a description of the invention referred to as a "venting system on FFS hoses" and comments on its novelty.
- 4           On May 27, 2004, the defendant filed a European patent application for the invention, which led to the grant of European patent 1 607 339 (patent in suit). Messrs. H. and L. and the plaintiff are named as inventors.
- 5           The property right comprises six patent claims. Claim 1 reads in the language of the method:

Flexible packaging container made of plastic, in which a region with inner and outer walls is formed by means of welded or glued seams through an overlap between the two outer edges of a film used to produce the packaging container, openings being provided in the inner wall which allow gas to escape from the interior of the container into the region between the inner and outer walls, characterized in that the transverse welded or glued seams enclosing the region are designed, at least in a partial region, in such a way that a controlled gas escape is ensured in order to reduce an excess pressure occurring during or after filling. the transverse welded or glued seams enclosing the region are designed, at least in a partial region, in such a way that a controlled gas outlet is ensured in order to reduce an excess pressure occurring during or after filling.

6           On July 26, 2004, the defendant submitted a declaration (K10) entitled "Confirmation of receipt/claim release declaration". In the upper part of the document, signed by its representative, the defendant confirms receipt of an invention disclosure "Cement bag with overpressure venting" dated July 13, 2004. The text section below contains the declaration that the service invention is claimed without restriction pursuant to § 6 ArbNErfG. This is followed by references to the legal consequences of the claim and the request to confirm receipt of the letter by signing it and returning it without delay. It then states: "I (we) confirm receipt". This document was signed by the plaintiff and Mr. H. and Mr. L. on August 25, 2004.

7           On May 27, 2005, the defendant filed the international patent application (WO 2005/115856) for a plurality of destination states, claiming priority to the application for the patent in suit.

8           Insofar as it is still of interest for the appeal proceedings, the plaintiff has filed a claim in his own right and as a representative ad litem for Mr. L. and Mr. H.'s two heiresses:

- > the sentence to
  - transfer of all rights from the two patent applications and the resulting patents,
  - accounting for sales and profits generated,
- > the finding that the defendant
  - was never the rights holder,
  - each of the three co-inventors a third of the profit made.has to spend,
- is also obliged to prepare accounts in subsequent years.

9           The Regional Court ruled against the defendant in accordance with these motions.

10           The Court of Appeal initially dismissed the claim in its entirety. The Senate overturned this judgment and referred the case back to the Court of Appeal (BGH, judgment of June 18, 2013 - X ZR 103/11). In the newly opened appeal instance, the plaintiff limited the application for transfer to the parts of the patent in dispute that are in force and the application for an accounting to acts in Germany and unilaterally declared the legal dispute regarding some of the countries of destination of the patent in dispute to be settled in the main proceedings.

11           In the judgment now under appeal, the Court of Appeal dismissed the application for a declaration that the defendant was never the owner of the rights as inadmissible. It granted the other claims, albeit with the restriction that the property rights are only to be transferred concurrently against reimbursement of costs incurred in the amount of EUR 140,146.61 and that the defendant reserves the right to provide information on customers, licensees, costs and profits to an auditor.

12           With the appeal allowed by the Court of Appeal, the defendant continues to pursue its motion to dismiss the action. The plaintiff opposes the appeal and challenges the auditor's reservation by way of a cross appeal.

Reasons for the decision:

13 Revision and cross-appeal are admissible. Both appeals are only partially  
justified.

14 I. The appeal is admissible without restriction.

15 1. The Court of Appeal dismissed the appeal in the operative part of the  
decision. The audit judgment is fully admissible.

16 2. The grounds for the decision show a restriction of the access

The same cannot be said of the release.

17 a) A restriction of the right to appeal may result from the fact that  
that the Court of Appeal justifies the admission on the basis of the need to clarify  
a specific legal question and that this legal question only concerns a definable  
part of the matter in dispute (BGH, judgment of March 3, 2005 - IX ZR 45/04,  
NJW-RR 2005, 715, 716).

18 The prerequisite for this is that the affected part of the matter in dispute  
can be assessed in factual and legal terms independently of the rest of the matter  
in dispute and that, even in the event of a referral back, there can be no  
contradiction with the decision on the other parts of the matter in dispute (BGH,  
judgment of March 16, 2017 - I ZR 39/15, GRUR 2017, 702 para. 17 - PC mit  
Festplatte; decision of December 16, 2021 - I ZR 186/20, para. 16 [not in MMR  
2022, 773]).

19 b) These requirements are not met in the case in dispute.

20 The legal question considered by the Court of Appeal as relevant for  
admissibility as to whether the right to assignment of a European patent granted  
for several countries in the case of employee inventions is to be assessed  
uniformly according to the law of the place of employment or separately according  
to the law of the respective country of protection only arises in the case in dispute  
with regard to other countries,

but not in relation to Germany. In any case, if the question is to be answered with the Court of Appeal to the effect that the claim is to be assessed uniformly in accordance with German law, there is a risk of contradictory decisions.

21           II. The Court of Appeal has issued its decision (GRUR 2021, 1504),  
insofar as it is of interest for the appeal proceedings, essentially as follows:

22           The plaintiff is entitled to bring proceedings pursuant to Section 1011  
BGB.

23           The vindication claim still asserted is justified pursuant to Art. 60 para. 1  
sentence 2 EPC in conjunction with Art. II § 5 para. 1 sentence 2 IntPatÜbkG. The  
vindication under inventor's rights was of a quasi-in rem nature, which argued in  
favor of basing it on the place of location, i.e. applying the statute of the country of  
protection. However, since under Article 60 (1) sentence 2 EPC the right to the  
European patent, if the inventor is an employee, is governed by the law of the state  
in which the employee is predominantly employed, it is obvious that the right to  
vindication of the patent should also be assessed uniformly according to the law of  
that place. This interpretation corresponds to the meaning and purpose of the  
regulation, which is to protect the employee and to spare him a vindication  
according to a possibly large number of legal systems.

24           The plaintiff was co-inventor of the invention "plastic bag with overpressure  
venting". The service invention had become available for lack of timely claiming.

25           The letter of February 25, 2004 (CBH 2) triggered the claim period  
pursuant to Sec. 6 (2) ArbNErfG old version. It was an invention disclosure within  
the meaning of Sec. 5 (1) ArbNErfG old version. It was irrelevant that the letter did  
not meet all the requirements of Sec. 5 (2) ArbNErfG old version. Pursuant to  
Section 5 (3) ArbNErfG (old version), the notification is deemed to be correct if the  
employer does not declare within a period of two months that

and in what respect the notification needed to be supplemented. The latter had not been done. The letters from the patent attorney Dr. W. to Mr. S. dated March 19 and April 2, 2004 did not contain any indication as to which aspects of the invention disclosure needed to be supplemented, but only dealt with the patentability of the invention in general.

26           The defendant could also not be heard with the objection that in any case the co-inventor L. had not submitted a proper invention disclosure because he had not signed the application of February 25, 2004. The notification was not unclear in this respect. It expressly named the plaintiff and Mr. H. and Mr. L. as applicants. Insofar as the defendant disputed the authority of the other two parties to represent Mr. L. for the first time at the hearing on 17 December 2015, this was irrelevant. The defendant itself had named Mr. L. as a co-inventor in the application for the European patent and therefore had no doubts that the invention disclosure had also been submitted in his name.

27           The defendant's declaration of claim of August 25, 2004 did not satisfy the written form requirement of Sec. 6 (3) ArbNErfG (old version). In its appeal judgment, the Federal Court of Justice pointed out that the content of the declaration in this reading of the document was limited to acknowledging receipt of the invention disclosure, which was not the purpose of using the form. However, this does not change the fact that the declaration of intent requiring a form was not signed.

28           The service invention was also not transferred to the defendant by way of a contractual transfer. In particular, such a transfer could not be inferred from the signing of assignment declarations in relation to the US patent. The reason for these declarations was obviously that the co-inventors had assumed that the defendant would make a legally effective claim.



29           The plaintiff could only demand the assignment of the property rights still  
in dispute concurrently with payment of the necessary costs for the patent  
applications and the maintenance of the property rights. Contrary to the defendant's  
view, the right of retention does not extend to the use of patent applications and  
patents whose surrender is no longer demanded.

30           The plaintiff's unilateral declaration of settlement was also successful for  
the reasons set out above.

31           The request for an accounting was justified pursuant to Section 242  
BGB. The plaintiff, Mr. L. and the heirs of Mr. H. had a claim for damages against  
the defendant under Section 823 (1) BGB. The defendant had acted negligently  
by using the invention of the plaintiff and his co-inventors, although it had neither  
claimed the service invention in good time nor in due form.

32           However, an auditor's reservation should be titled, as the defendant could  
invoke a legitimate interest in confidentiality. The plaintiff is now the managing  
director of a company that manufactures functional packaging.

33           III This assessment largely withstands the attacks of the appeal.  
stand.

34           1. The Court of Appeal rightly decided that the plaintiff, Mr. L. and the  
heirs of Mr. H. pursuant to Art. II § 5 para. 1 IntPatÜbkG are entitled to the transfer  
of the property rights specified in the operative part.

35           a) The claims asserted are uniformly governed by German law.  
right to judge.

36        aa) The question as to whether an employee can demand the transfer of the rights from a patent application or from a granted patent from his employer on the basis of a service invention is to be assessed uniformly for all parts of a European patent according to the law of the state that is decisive for the employment contract (in conclusion also OLG Düsseldorf, Mitt. 2004, 418; OLG Munich GRUR-RR 2009, 219, 220; OLG Karlsruhe, GRUR 2018, 1030 para. 23; Werner, GRUR-Prax 2019, 149, 151. Dissenting Nieder, GRUR 2015, 936, 938; Ulrici, GRUR-Prax 2018, 439; McGuire Mitt. 2019, 197, 199; Krahforst, Mitt. 2019, 207, 210; Haedicke/Timmann, Handbuch des Patentrechts, 2nd ed. § 10 para. 149).

37                (1) As the Senate has already ruled, the rights are determined by the and obligations arising from a service invention are governed by the same law that is otherwise applicable to the employment relationship between the employee inventor and the employer (BGH, judgment of September 4, 2018 - X ZR 14/17, GRUR 2019, 271 para. 65 - Drahtloses Kommunikationsnetz; also OLG Karlsruhe, GRUR 2018, 1030 para. 23).

38                According to the provision in Art. 30 para. 2 no. 1 EGBGB relevant to the dispute, the law of the state in which the employee usually performs his work in fulfillment of the contract is decisive.

39                (2) This right is also decisive for the question of which rights the parties with regard to property rights abroad.

40                As the Senate has also already ruled, the formal entitlement of an applicant or patent proprietor, which arises from the application, particularly in the case of German and European patents, irrespective of the substantive entitlement to the invention, must be distinguished from claims for the transfer of this legal status based on the substantive entitlement to the invention (BGH, judgment of April 12, 2011 - X ZR 72/10, GRUR 2011, 733 para. 31 - Initialidee).

41 In the relationship between employee and employer, claims of the latter  
type are primarily governed by the provisions of the employment contract and the  
related statutory provisions such as the German law on employee inventions. This  
connection takes precedence over the connection to the law of the country of  
protection.

42 (3) Whether Art. 60 (1) sentence 2 EPC contains a special provision  
under collision law for European patents does not require a final decision.

43 According to Art. 60 para. 1 sentence 2 EPC, the law applicable to the  
European patent for employee inventors is determined by the law of the state in  
which the employee is predominantly employed. Insofar as no choice of law has  
been made, as in the case in dispute, this corresponds to the provision in Art. 30  
para. 2 no. 1 EGBGB.

44 bb) Accordingly, German law is applicable in the case in dispute because  
all co-inventors were employed in Germany.

45 b) The appeal is unsuccessful in challenging the opinion of the Court  
of Appeal that the defendant had not validly claimed the patent in suit.

46 aa) The Senate has already stated in the first appeal judgment that the  
plaintiff and Mr. H. and Mr. L. are to be regarded as co-inventors on the basis of  
the findings of the Regional Court, which are not contested in this respect (BGH,  
judgment of June 18, 2013 - X ZR 103/11, para. 8, 13).

47 The findings of the Court of Appeal in the contested judgment and the  
submissions of the appeal do not provide any indications that could lead to a  
different assessment.

48 bb) The service invention has become free due to lack of timely claiming  
of the service invention by the employer.

49           It remains to be seen whether the defendant's letter of July 26, 2004  
satisfies the formal requirements for a declaration of claim. In any case, this  
declaration was made after expiry of the deadline to be observed.

50           Pursuant to Section 8 (1) No. 3 ArbNErfG in the version applicable to  
the dispute until September 30, 2009 (hereinafter: old version), a service invention  
is released if the employer does not claim it within four months of receipt of the  
proper notification.

51           The Court of Appeal did not err in law in assuming that this period began  
to run upon receipt of the letter of February 25, 2004 (CBH2) with respect to all  
three co-inventors.

52           (1) The letter makes it sufficiently clear that it is an invention disclosure.

53           (a) According to Section 5 (1) sentence 1 ArbNErfG old version, an  
employee who has made a service invention must immediately report this  
separately to the employer in writing and indicate that it is a report of an invention.

54           The purpose of the reporting obligation is not only to inform the employer  
in general terms about work carried out. Rather, it is intended to draw the  
employer's attention to inventions made by the employee in order to make him  
aware of the question of a claim or release (BGH, judgment of April 4, 2006 - X  
ZR 155/03, BGHZ 167, 118 para. 26 - Haftetikett; judgment of April 12, 2011 - X  
ZR 72/10, GRUR 2011, 733 para. 14 - Initialidee). The notification must therefore  
be made separately, i.e. not inserted into other reports (BGH, GRUR 2011, 733  
para. 14 - Initialidee; BT-Drucks. II/1648 p. 21).

55 (b) The assessment of the Court of Appeal that the letter of February  
25, 2004 (CBH2) meets these requirements is not objectionable on legal grounds.

56 (aa) Contrary to the opinion of the appeal, the contested judgment reveals  
the basis on which the Court of Appeal bases its assessment that the authors of  
CBH2 claim to have made an invention.

57 In this context, the Court of Appeal only cited the fact that the heading  
contains the phrase "Application for the grant of a patent". However, as the appeal  
does not fail to recognize, it is sufficiently clear from the context that the Court of  
Appeal also considered the designation of the plaintiff and Mr. H. and Mr. L. as  
applicants to be decisive.

58 The assessment of the facts by the court is true to life and cannot be  
objected to on legal grounds.

59 (bb) Contrary to the opinion of the appeal, the letter does not give the  
impression that the claiming of the invention has already been decided and that  
it is only a matter of the patent application process.

60 It remains to be seen whether labeling a patent application as a draft  
can give such an impression in individual cases (see Bartenbach/Volz, ArbNErfG,  
6th ed. 2019; Section 5 para. 42). CBH2 does not present itself as such a draft  
and does not otherwise indicate that it is merely information on an invention that  
has already been claimed.

61 Against this background, the Court of Appeal was entitled to conclude  
from the designation as an application, from the fact that the invention is described  
in outline, and from the fact that the letter makes no express or implied reference  
to a notification or claim that has already been made

that the defendant's letter made it sufficiently clear that it was to decide whether to claim or release a service invention.

62           The fact that the defendant is also listed in the letter as the applicant does not lead to a different assessment. The comparison with the area provided for signatures, in which only the names of the three inventors are listed, supports the conclusion drawn by the Court of Appeal that the defendant was offered a patentable invention for claiming from the point of view of the notifying parties.

63           (2) The subject matter of the invention is sufficiently described in the letter.

64           According to Section 5 (2) ArbNErfG, the employee must describe the technical task, its solution and how the service invention came about in the notification.

65           The Court of Appeal did not err in law in deciding that these requirements are to be regarded as fulfilled in the case in dispute pursuant to Sec. 5 (3) ArbNErfG because the defendant did not raise any relevant objections.

66           (a) The question raised by the defendant's patent attorney as to why a permeable weld seam represents an advantage over the perforation of the inner wall known in the prior art does not concern the subject-matter of the invention but, as the Court of Appeal rightly assumed, its assessment under patent law.

67           The question indicates that the patent attorney could already infer from CBH2 what distinguishes the invention from the prior art. The question of whether this difference constitutes an advantage is at most relevant for the assessment of inventive step, but not for the understanding of the reported invention.

68 (b) The question of suitable separation media has already been  
answered in CBH2 to the effect that a release varnish can be used in any case.

69 The invention is thus described in its essential features. As can be seen  
from the draft patent description prepared by the patent attorney in accordance  
with Annex CBH 6, the supplement requested by the patent attorney was merely  
intended to list further examples of separation media which were suitable for  
realizing the invention.

70 (c) According to the findings of the Court of Appeal, the defendant did not  
object to the fact that the invention disclosure was not accompanied by the sketch  
cited therein as an annex.

71 The grounds of appeal do not challenge this finding. In particular, it does  
not show that the Court of Appeal disregarded arguments of the defendant that  
were relevant to the decision.

72 In view of this, the defendant's deviating submission at the oral hearing  
before the Senate is irrelevant for the purposes of appeal.

73 (3) As a result, the Court of Appeal rightly consider it harmless that the  
letter was not signed by Mr. L.

74 (a) The Court of Appeal correctly assumed that an invention disclosure  
can be made by a representative (affirmative in this respect also Bar-  
tenbach/Volz, ArbNErfG, 6th ed. 2019, Section 5 para. 5 with further references).

75 However, the rules on legal representation are not directly applicable to  
an invention disclosure. According to the case law of the Senate, such a  
notification is not a declaration of intent because it merely serves to impart  
knowledge (BGH, judgment of April 4, 2006 - X ZR 155/03, BGHZ 167, 118 =  
GRUR 2006, 754 para. 26 - Haftetikett).

76           § Section 164 BGB is, however, applicable to an invention disclosure to the extent that it is possible for a third party to provide the required information on behalf of an employee, provided that the employee has given their consent. The written form required under Section 5 (1) ArbNErfG (old version) is complied with if the document signed by the notifying party makes it sufficiently clear that the notification is being made (possibly also) on behalf of another person. Any lack of consent can be replaced by subsequent consent in accordance with Section 180 sentence 2 and Section 177 para. 1 BGB.

77           (b) Against this background, the Court of Appeal affirmed the effective representation of Mr. L. by the plaintiff and Mr. H. in the case in dispute without any legal error.

78           The content of CBH2 does not contain any explicit references to the fact that the two signatories were also acting on behalf of Mr. L.. Contrary to the opinion of the appeal, however, an express addition of representation is not absolutely necessary to comply with the written form requirement in the case of a pure transfer of knowledge. Rather, it is sufficient if the text of the notification makes it clear from its entire content that it is (also) made on behalf of a third party.

79           The Court of Appeal did not err in law in seeing such an indication in the fact that Mr. L. is also named as an applicant in CBH2. The Court of Appeal took into account in particular that the mere naming of other persons as co-inventors is not sufficient in this respect (see BGH, judgment of October 5, 2005 - X ZR 26/03, GRUR 2006, 141 para. 26 - Ladungsträgergenerator). Its assessment that Mr. L. is not only listed in CBH2 as a further party, but as one of three co-inventors who submit a joint notification, is not objectionable on legal grounds.

80           (4) The date of receipt of the notification by the superior of the plaintiff (Mr. S.) is decisive for the start of the deadline.



81           The Court of Appeal derived the authority to receive the invention disclosure from the fact that Mr. S. was an authorized signatory of the defendant, that he received the invention disclosure and that he had patent grant proceedings initiated. This assessment of the facts by the court is possible and does not reveal any legal error.

82           (a) The grounds of appeal do not show that the appellate court did not court ignored arguments relevant to the decision in this assessment.

83           (b) Contrary to the opinion of the appeal, the Court of Appeal did not did not misjudge the burden of presentation and proof.

84           The Court of Appeal expressly stated that the employee bears the burden of proof that the invention disclosure was sent to "the right person".

85           Its assessment based on this makes it sufficiently clear that it did not affirm Mr. S.'s authority because the defendant had not stated otherwise, but because it considered the plaintiff's submission to be sufficient and the defendant did not counter it in any significant way.

86           c) The creditors of the transfer claim are, as the Court of Appeal the plaintiff, Mr. L. and the two heiresses of Mr. H. (Ms. H. and Ms. P.) as joint heirs.

87           Contrary to the concerns expressed by the defendant at the hearing, it is also sufficiently clear from the operative part of the contested decision that Ms. H. and Ms. P. are entitled to inherit from Mr. H. The operative part does not expressly mention their status as heirs. However, it is clear from the grounds of the decision, which are to be used for interpretation, which state that Mr. H. is inherited by Ms. H. and Ms. P.

has been awarded. An additional confirmation results from points 4 and 5 of the operative part, in which one third of the profit made is awarded to the plaintiff and Mr. L. and the remaining third to Ms. H. and Ms. P. respectively.

88                   2. The Court of Appeal was right in its approach in deciding that the defendant is obliged to pay damages and this obligation extends to the surrender of the profit made. However, contrary to the contested decision, the latter does not apply to the entire period since the invention was reported, but only to the period from the grant of the patent.

89                   a) The Court of Appeal did not err in law in deciding that the defendant is obliged to pay damages.

90                   aa) According to the case law of the Senate, a claim for damages claim of the entitled person pursuant to Section 823 (1) BGB against the person who files an unauthorized application for an IP right relating to the invention and uses the invention (see BGH, judgment of 17 January 1995 - X. January 1995 - X ZR 130/93, NJW-RR 1995, 696 - Gummielastische Masse; BGH, judgment of September 27, 2016 - X ZR 163/12, GRUR 2016, 1257 marginal no. 24 - Beschichtungsverfahren; BGH, judgment of June 9, 2020 - X ZR 142/18, GRUR 2020, 986 marginal no. 19 - Penetrometer).

91                   bb) The property right application and the use of the invention by the defendant were unlawful because the defendant did not effectively claim the invention.

92                   The fact that the inventors did not object to the use does not make the use an authorized use.

93                   As the Senate has already ruled, the assumption that an employee wishes to give up the legal position arising from an effective invention disclosure requires specific evidence (BGH, judgment of December 17, 2019 - X ZR 148/17, GRUR 2020, 388 para. 41 - GRUR 2020, 388 para. 41

- fesoterodine hydrogen fumarate). This also applies to the question of whether the employee permits the employer to use the invention even though it has not been effectively claimed.

94                   cc) The Court of Appeal was right to assume that the defendant acted culpably.

95                   According to the established case law of the Federal Court of Justice, a person also acts negligently if he recognizably moves in a borderline area of what is legally permissible, in which he must consider an assessment of the legal permissibility of the conduct in question that differs from his own assessment (see only BGH, judgment of 19 May 2005 - X ZR 152/01, GRUR 2005, 761, 762 - Rasenbefestigungsplatte, judgment of 15 June 2023 - I ZR 179/22, para. 48, GRUR 2023, 1619 - Microstock-Portal).

96                   In the case in dispute, the defendant should have recognized for the reasons set out above that it is in any case not far-fetched to qualify the letter of 25 February 2004 (CBH2) as a proper invention disclosure. By filing the application for the property right and using the invention on the basis of a claim made more than four months after this notification, the defendant has therefore clearly moved within a borderline area of what is legally permissible. There are no indications that the defendant was nevertheless entitled to assume that the invention disclosure was effective, nor are any such indications apparent.

97                   b) As a starting point, the Court of Appeal was right to assume that the that the obligation to pay damages includes the surrender of the profit made by using the invention.

98                   aa) According to the case-law of the Senate, the right to be replaced damage includes compensation lost by the entitled party for the benefits that the defendant has derived from the use of the applications (BGH, judgment of

September 27, 2016 - X ZR 163/12, GRUR 2016, 1257 marginal no. 28 - Beschichtungsverfahren).

99           These advantages also include the profit that the party liable for damages has derived from the use of the invention.

100           The realization of such profits is in principle reserved to the person who has the rights to the invention and is therefore materially entitled to apply for a patent. Accordingly, the owner of a patent can, in principle, calculate the damage caused to him by unauthorized use on the basis of the profit made by the infringer.

101           Nothing else applies to the relationship between the person entitled to the invention and another person who has wrongly applied for a patent and used the invention. In this constellation, too, the user realizes advantages that are reserved for the entitled party.

102           bb) As the appeal on points of law rightly asserts, in this context, however, the values resulting from Section 33 PatG and Art. II § 1 para. 1 IntPatÜbkG must be taken into account.

103           This means that the person entitled to damages can only claim reasonable compensation for the period prior to the grant of the unauthorized patent application. The decisive factor here is the consideration that the entitled party must not be in a better position vis-à-vis the person who used the invention in connection with an unauthorized patent application than vis-à-vis an outside third party (BGH, judgment of 27 September 2016 - X ZR 163/12, GRUR 2016, 1257 marginal no. 30 - Beschichtungsverfahren).

104           Contrary to the opinion of the appeal, however, this idea only applies to the period before the patent was granted.

105           After the patent has been granted, its proprietor may also claim damages from a third party and recover his loss on the basis of the

profit generated by the unauthorized use. He is also entitled to this right against an unauthorized patent applicant who has used the invention without authorization.

106           cc) In the event of a dispute, the co-inventors are entitled to the surrender of the profit made only for the period from the publication of the reference to the grant of the patent in dispute until its expiry, i.e. for the period from March 26, 2008.

107           dd) For the time prior to this, the claim for compensation is based on § 823 para. 1 BGB is only entitled to compensation as owed under Section 33 PatG and Art. II § 1 para. 1 IntPatÜbkG is owed.

108           This claim exists for the period from receipt of the invention disclosure by the defendant, i.e. from February 25, 2004.

109           According to the case law of the Senate, an employer who has not acquired any rights to the service invention, in any case from the time of a patent application, from which it is clear that he is fully informed about the invention, is in conflict with its legal assignment by using it (BGH, judgment of April 4, 2006 - X ZR 155/03, BGHZ 167, 118 = GRUR 2006, 754 marginal no. 35 - Haftetikett). Equivalent information results from a proper invention disclosure.

110           3. Since the plaintiff and the co-inventors can only demand surrender the profit made for the period from March 26, 2008, they are also only entitled to information and accounting with regard to the production and distribution costs of the profit with this time limit.

111           IV. the plaintiff's cross-appeal is only successful to the extent that the Court of Appeal ordered an auditor's reservation with regard to the information on prime costs and profit.

112           1. Contrary to the opinion of the appeal, an auditor is not entitled to the  
reservation of rights in the case in dispute is not precluded by the assessment  
made by the legislator in Section 140b PatG.

113           a) According to the case law of the Senate, the concession of of an  
auditor's reservation within the scope of § 140b PatG can only be considered in  
exceptional cases, because the law generally gives priority to the infringed party's  
interest in discovering the supply channels (BGH, judgment of December 20,  
1994 - X ZR 56/93, BGHZ 128, 220, 228 = GRUR 1995, 338, 341 f. -  
Kleiderbügel).

114           However, the case in dispute does not fall within the scope of Section  
140b PatG.

115           The plaintiff and the two co-inventors are not entitled to a claim for patent  
infringement under Section 139 PatG. Rather, their claim for compensation under  
Section 823 (1) BGB is based on the unjustified use of their invention by the  
defendant.

116           b) The assessment of Sec. 140b PatG is not applicable to such  
constellations transferable.

117           The purpose of uncovering the distribution channels is to enable the  
patent proprietor to enforce his rights as comprehensively as possible. Knowledge  
of the origin and distribution channels of an infringer is of particular interest here  
because suppliers and customers are also potential infringers (BT-Drucks. 11/4792  
p. 31 f.).

118           In contrast, the claim under Section 823 (1) BGB existing in the case in  
dispute is only directed against the defendant, but not against its suppliers and  
customers.

119           2. According to the relevant basis for the claim (§ 242 BGB) is the  
approval of an auditor's reservation with regard to the names and

addresses of purchasers and licensees cannot be objected to in the case in dispute.

120           a) According to the established case law of the Federal Court of Justice  
The content, type and scope of a claim for information based on Section 242 BGB  
must be determined by weighing up the interests of both parties (BGH, decision  
of February 13, 1981 - I ZR 111/78, GRUR 1981, 535 -  
Wirtschaftsprüfervorbehalt).

121           When balancing interests, it must be taken into account that this impairs  
the litigation of the party requesting information to prepare further claims. If it is only  
granted information subject to an auditor's reservation, it can no longer base its  
decision on further procedural steps on its own comprehensive knowledge of the  
facts, but is partially dependent on knowledge only made available to it by third  
parties. The claimant only has to accept this if his claim is clearly outweighed by  
the interests of the party obliged to provide information (BGH, decision of January  
8, 1999 - I ZR 299/98, NJWE-WettbR 1999, 238, 239). The assessment of this  
question generally falls within the scope of factual assessment and weighing (BGH,  
judgment of November 13, 1997 - X ZR 6/96, GRUR 1998, 684, 688 - Spulkopf).  
An interest in confidentiality can arise in particular from a competitive relationship  
(see BGH, judgment of November 13, 1997 - X ZR 132/95, GRUR 1998, 689, 693  
- Copolyester II).

122           b) Against this background, the assessment of the Court of Appeal is  
the data of suppliers and customers is not objectionable.

123           According to the findings of the Court of Appeal, the plaintiff is now the  
managing director of a company that manufactures functional packaging and  
describes the functional principle of an FFS hose with a weld seam in accordance  
with the invention on its website.

124           The deviating submissions of the cross-appeal in the oral hearing are irrelevant. The grounds for the cross-appeal do not show that the Court of Appeal ignored the plaintiff's submissions that were relevant to the decision or that its finding is based on other legal errors.

125           Given this initial situation, it is not objectionable on legal grounds that the Court of Appeal gave priority to the defendant's interest in confidentiality with regard to customers and licensees.

126           3. No overriding interest is apparent, however, insofar as the Court of Appeal extended the reservation to the prime costs broken down by individual cost factors and the profit made.

127           As the cross-appeal rightly asserts and as the defendant does not fail to recognize in its approach, the plaintiff and the other entitled parties are dependent on this information to calculate their claim for compensation on the basis of the profit made. The authorization provided for in the contested judgment to inform the plaintiff on request whether a specific customer or licensee is included in the accounts is not capable of providing this information.

128           V. The Senate can decide on the merits of the case because, according to the is ready for a final decision (Section 563 (3) ZPO).

129           1. Insofar as the defendant is obliged to render accounts for the period before the company was ordered to pay the costs of production and the profit made for the period prior to March 26, 2008, the action must be dismissed.

130           2. The ordered auditor's reservation is to be deleted without substitution. the report must be prepared in accordance with the German Commercial Code (HGB) insofar as it relates to information on the prime costs broken down by individual cost factors and the profit generated.



131                    3. The finding that the defendant must surrender the profit made the  
defendant's admission that it is liable for damages for the period prior to March  
26, 2008 must be restricted to the effect that the defendant is only obliged to pay  
damages on one of the other permissible bases of calculation.

132                    According to its wording, the plaintiff's application for a declaratory  
judgment is only aimed at compensation for the profit made. However, it is  
sufficiently clear from the context that the plaintiff is also seeking damages, but  
not only on this basis of calculation.

133                    VI The decision on costs follows from Section 97 (1) and Section 92 (1)  
ZPO.

Bacher

Hoffmann

Kober-Dehm

Marx

Rombach

Lower courts:

Regional Court Frankfurt am Main, decision of April 28, 2010 - 2-06 O 696/08 –  
Higher Regional Court Frankfurt am Main, decision of 22.07.2021 - 6 U