Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2019-03-26
Docket Number / Aktenzeichen:	X ZR 109/16
Name of Decision / Name der Entscheidung:	Spannungsversorgungsvorrichtung

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FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

JUDGMENT

X ZR 109/16

Pronounced on:
26 March 2019
Zöller
Judicial Secretary
as Clerk of the
Court Registry

in the matter

Spannungsversorgungsvorrichtung/Power supply device

Patent Act of 2002 Sec. 139(2), Sec. 141 sentence 2; Civil Code Sec. 852 sentence 1

a) Even after the limitation period for the claim for damages has expired, the patent infringer must surrender the profit he has made through the patent infringement as having been obtained at the expense of the infringed party in accordance with the provisions on the surrender of unjust enrichment.

b) Accordingly, the infringer shall provide an account of the profit made and the costs incurred and shall also provide information on the advertising for the infringing object.

Federal Court of Justice, judgment of 26 March 2019 – X ZR 109/16 –
Higher Regional Court of Karlsruhe
Regional Court of Mannheim

ECLI:DE:BGH:2019:260319UXZR109.16.0

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 8 January 2019, attended by the presiding judge Prof. Dr. Meier-Beck, the judges Dr. Grabinski, Hoffmann and Dr. Deichfuß as well as the judge Dr. Marx

ruled that:

The appeal of the defendant against the judgment of the 6th Civil Senate of the Higher Regional Court of Karlsruhe of 9 November 2016 is dismissed.

The defendant shall bear the costs of the proceedings before the Federal Court of Justice.

By operation of law

Facts of the case:

1 The plaintiff is the owner of European patent 881 145 (patent in suit) filed on 22 May 1998. It relates to a voltage supply device for providing a supply voltage for electrical devices. The patent lapsed during the appeal proceedings due to the passage of time.

2 The defendant supplies voltage supply devices in particular to domestic seat manufacturers who supply aircraft manufacturers.

3 The Regional Court granted the action for injunctive relief, information and accounting, recall and a declaration of the obligation to pay damages, and dismissed the application for publication of the judgment. On appeal by the defendant, the Court of Appeal, rejecting the further appeal and the cross-appeal, limited the established liability for damages for acts committed before 1 January 2007 to the surrender of the proceeds in accordance with the provisions on the surrender of unjust enrichment.

4 The defendant contests this with its appeal, which was admitted by the Senate on a limited basis, insofar as it was ordered to provide an account, also stating the advertising carried out, the prime costs and the profit generated for acts committed before 2 January 2007. The plaintiff opposes the appeal.

Grounds of the decision:

5 The admissible appeal is unsuccessful.

6 I. The Court of Appeal substantiated its decision - insofar as it is of interest for the appeal proceedings - essentially as follows:

7 The plaintiff is entitled to injunctive relief, information, invoicing and recall against the defendant for patent infringement. The defendant is also obliged to compensate the plaintiff for all damage that has arisen and will arise as a result of the acts committed. However, claims for damages that arose before 1 January 2007, as well as the claim for recall of patent-infringing products that were put on the market before that date, are time-barred.

8 The statute of limitations for the claim for damages for the period before 1 January 2007, had no effect on the scope of the claim for invoicing. The non-lapsed claim for residual damages under Sec. 141 Sentence 2 Patent Act in conjunction with Sec. 852 Civil Code was not necessarily limited to an appropriate license fee, but could also be directed to the surrender of the infringer's profits. According to the decision "Fahrradgepäckträger II" (Federal Court of Justice, judgment of 14 February 1978 - X ZR 19/76, BGHZ 71, 86), the claim for residual damages remains a claim for damages in terms of its legal nature and prerequisites; the reference to the law of enrichment is a reference to legal consequences. In addition to the use of the intangible object of protection, the infringer's profit could also be regarded as having been obtained at the expense of the owner of the property right as a result of the infringement. In contrast to the strict encroachment condemnation, the claim for residual damages did not require that the pecuniary advantage to be surrendered had been obtained directly at the expense of the enrichment creditor. It is sufficient that there is an adequate-causal connection between the enrichment of the infringer and the offense giving rise to the claim and that the enrichment would have accrued to the injured party in the case of lawful conduct. The term "obtained at the expense" in Sec. 852 Sentence 1 Civil Code, unlike in the case of encroachment condemnation, is based on the act by which the transfer of assets was effected. In view of this basic dogmatic decision, the infringer's profit

cannot be excluded from the claim for residual damages under Sec. 141 Sentence 2 Patent Act in conjunction with Sec. 852 Civil Code.

9 II. This holds up to review in the appeal proceedings.

10 1. As a result of the culpable infringement of its exclusive right, the plaintiff is entitled to damages for the acts of use referred to in the judgment of the Regional Court and committed since 26 December 2003, as is legally established by the partial rejection of the appeal against the non-admission of the appeal. For acts committed prior to 1 January 2007, this claim is limited pursuant to Sec. 141 Sentence 2 Patent Act in conjunction with Sec. 852 Sentence 1 Civil Code to the restitution of what the defendant obtained through these acts in accordance with the provisions on the restitution of unjust enrichment. Furthermore, it is established that the defendant is also obliged to provide the plaintiff with accounts for the period prior to 1 January 2007 on the merits and that the factual scope of the accounting for this period in any case includes the information specified in the judgment statement under I 3 a to c of the Regional Court judgment.

11 2. The Court of Appeal correctly assumed that the factual scope of the accounting for the period from 26 December 2003 to 31 December 2006 also includes the information specified in the first-instance judgment under I 3 d and e, meaning that the defendant must also provide information on the advertising it has conducted, its production costs and the profit it has generated, irrespective of the statute of limitations for the (unlimited) claim for damages. the profit achieved.

12 a) The scope of the claim for information and rendering of accounts recognized by customary law is determined by the subject matter of the claim whose lawful exercise is served by the duty to provide information (Federal Court of Justice, judgment of 17 November 2009 - X ZR 137/07, BGHZ 183, 182 marginal no. 21 - Türinnenverstärkung). The claim, which is subject to the principle of good faith in terms of content and scope, is an accessory claim. As such, its scope is limited to the information required to enforce the main claim, which the creditor cannot obtain in any other way and which the debtor can easily and reasonably be expected to provide (Federal Court of Justice,

judgment of 29 June 2000 - I ZR 29/98, GRUR 2000, 907, 910 - Filialleiterfehler). If the claim serves to prepare a claim for damages which is limited under Sec. 141 Sentence 2 Patent Act in conjunction with Sec. 852 Sentence 1 Civil Code, it therefore depends on what information is required for its exercise and is possible and reasonable for the debtor.

13 b) For the period from 1 January 2007, which is not subject to the statute of limitations, the plaintiff, as the owner of the property right, is entitled to damages under Sec. 139(2) Patent Act, old version, due to the culpable infringement of its exclusive right to the patent in suit. The plaintiff has three methods at its disposal for assessing the damages: the concrete calculation of damages, including in particular the lost profit, and compensation for damages by payment of an appropriate license fee or surrender of the infringer's profit (see Federal Court of Justice, judgment of 24 July 2012 X ZR 51/11, GRUR 2012, 1226 marginal no. 16 - Flaschenträger; judgment of 6 October 2006 I ZR 322/02, GRUR 2006, 419 marginal no. 14 Noblesse).

14 c) By contrast, the plaintiff's claim for damages is limited for acts of use committed prior to 1 January 2007, and thus in time barred by the statute of limitations. Pursuant to Sec. 141 Sentence 2 Patent Act in conjunction with Sec. 852 German Civil Code, the claim for damages remains enforceable only to the extent that the defendant has obtained something through the infringement at the plaintiff's expense. The defendant, as the party liable for compensation, remains obligated to surrender the latter in accordance with the provisions on the surrender of unjust enrichment even after the claim for compensation for the damage arising from the infringement has become time-barred.

15 aa) The provision of Sec. 852 Sentence 1 Civil Code constitutes a reference to the law on unjust enrichment. The factual prerequisites of the enrichment liability according to the regulations of Sec. 812 ff. Civil Code do not have to be given (Federal Court of Justice, judgement of 14 February 1978 - X ZR 19/76, BGHZ 71, 86, 98 ff. - bicycle luggage carrier II). Nevertheless, the facts of Sec. 141 sentence 2 Patent Act require enrichment on the part of the obligated party to the extent that he must have obtained something at the expense of the infringed party. The "claim for residual damages" is thus linked

to a transfer of assets caused by the patent infringement and requires an economic advantage on the part of the obligor which has increased his assets.

16 bb) The use of the intangible object of protection, in the case of dispute thus the technical teaching of the patent in suit, can initially be regarded as having been obtained by the infringing act at the expense of the entitled party within the meaning of Sec. 141 sentence 2 Patent Act. Since the surrender of this advantage is not possible by its nature, the value is to be compensated according to Sec. 818(2) Civil Code. The objective equivalent value for the use of an intangible property consists of the appropriate license fee for this (Federal Court of Justice, judgment of 15 January 2015 I ZR 148/13, GRUR 2015, 780 marginal no. 32 - Motorradteile; judgment of 12 May 2016 I ZR 48/15, GRUR 2016, 1280 marginal no. 96 Everytime we touch).

17 cc) However, contrary to a view expressed in the literature (Hacker in Ströbele/Hacker/Thiering, Markengesetz, 12th ed. Sec. 14 marginal no. 1177; Keukenschrijver in Busse/Keukenschrijver, Patent Act, 8th ed. Sec. 141 marginal no. 50; Kraßer/Ann, Patentrecht, 7th ed. Sec. 35 VII marginal no. 152; Kühnen, Hdb. Patentverletzung, 11th ed., ch. E marginal no. 670; Mes, Patent Act, 4th ed, Sec. 141 marginal no. 41), a profit which the obligor achieves precisely through the infringement of the intellectual property right or his participation in this infringement is also to be considered (Regional Court of Düsseldorf, judgment of 23 May 2000 4 O 162/99, Mitt. 2000, 458, 461 - Dämmstoffbahn; judgment of 13 June 2001 4 O 204/00, InstGE 1, 33 marginal no. 7 multiple contact arrangement; Regional Court of Mannheim, judgment of 16 January 2004 - 7 O 403/03, juris marginal no. 117; Benkard/Grabinski/Zülch, Patent Act, 11th ed, Sec. 141 marginal no. 9; Büscher in Büscher/Dittmer/Schiwy, Gewerblicher Rechtsschutz, 3rd ed., Sec. 14 MarkenG marginal no. 675; Fezer, MarkenR, 5th ed, Sec. 14, para. 1034; Hülsewig, GRUR 2011, 673, 678; Meier-Beck, GRUR 1993, 1, 5; Nieder, Mitt. 2009, 540; Pross, Festschrift für Tilman Schilling 2007, p. 333, 337 et seq.; Rinken in Fitzner/Lutz/Bodewig, PatRKomm, 4th ed., Patent Act Sec. 141, para. 40; left open in Federal Court of Justice, GRUR 2015, 780 para. 34 Motorcycle Parts).

18 (1) The legal nature of the claim for residual damages requires to distinguish between the term "obtained" within the meaning of Sec. 812 sentence 1 Alt. 2 of the German Civil Code and that of "obtained" within the meaning of Sec. 141 sentence 2 of the Patent Act.

19 (a) The provision of Sec. 141 Patent Act is systematically placed in the Ninth Section of the Patent Act under "Infringements". The words "obtained at cost" in Sec. 141 sentence 2 Patent Act refer to the act by which the transfer of property was effected, i.e. to the patent infringement. The claim, which is limited to the surrender of what has been obtained, remains by its nature a claim for damages. As the Senate decided with regard to the claim under Sec. 852(3) Civil Code in the version prior to the entry into force of the Law of Obligations Modernization Act of 26 November 2001 (BGBl. I, p. 3138), which corresponds to Sec. 852 sentence 1 Civil Code in force today, the provision has the character of a legal defense against the defense of limitation (BGHZ 71, 86, 98 et seq. - Fahrradgepäckträger II).

20 (b) Compensation for damages by surrender of the infringer's profits is, like compensation by payment of an appropriate license fee and in contrast to the claim for compensation for lost profits, not aimed at compensation for the concrete damage incurred. Rather, the surrender of the infringer's profit aims in a different way at a fair compensation of the pecuniary disadvantage suffered by the infringed right holder. It would be inequitable to leave the infringer with a profit based on the culpable unauthorized use of the property right. Skimming off the infringer's profit also serves to sanction the damaging conduct and in this way to prevent infringement of the intellectual property rights requiring special protection (Federal Court of Justice, judgment of 16 August 2012 I ZR 96/09, ZUM 2013, 406 marginal no. 27 Einzelbild; judgment of 14 May 2009 - I ZR 98/06, BGHZ 181, 98 marginal no. 76 Tripp-Trapp-Stuhl; judgment of 2 November 2000 I ZR 246/98, BGHZ 145, 366, 371 Gemeinkostenanteil).

21 (c) A comparable situation does not exist with regard to the claims governed by the provisions of Sec. 812 et seq. Civil Code does not exist. Unjust enrichment under these provisions is not tainted by culpable wrongdoing in relation to a protected legal interest of the party whose assets have been diminished. Therefore, in the case of encroachment condemnation, direct

encroachment on the content of the protected property used is required in order to trigger liability for enrichment. In contrast, the change in assets in favor of the tortfeasor brought about by means of a tortious act can also be based on a direct encroachment on the allocation content of the exclusive right of the owner of the property. However, the groups of cases of interference by a culpably unauthorized infringing act are not limited to the constellation of a direct shift of assets. The transfer of assets does not have to take place between the tortfeasor and the injured party (BGHZ 71, 86, 99 - Fahrradgepäckträger II). It can also take place in another way if it is only causally connected with the patent infringement (Federal Court of Justice, judgment of 29 May 1962 I ZR 132/60, GRUR 1962, 509, 512 Dia-Rähmchen II).

22 (d) Accordingly, it is in line with the purpose of the claim under Sec. 852 sentence 1 Civil Code not to leave the tortfeasor in possession of the advantages he has gained as a result of the tort and thus to the detriment of the injured party (BGHZ 71, 86, 99 - Fahrradgepäckträger II; Federal Court of Justice, judgment of 10 June 1965 - VII ZR 198/63, NJW 1965, 1914, 1915), and nothing else applies to the claim under Sec. 141 sentence 2 Patent Act. The assumption underlying the compensation of damages by surrender of the infringer's profit that the right holder would have achieved the same profit as the infringer through the exploitation of his property right without the infringement (cf. BGHZ 145, 366, 372 - share of overhead costs) justifies that also within the scope of the claim for residual damages - which is based on the same basis - the profit of the infringer is considered as profit which the infringed party could have achieved and which was thus obtained by the infringer through the infringement at the expense of the infringed party.

23 (2) Without success, the appeal objects to the fact that this renders the limitation of the claim for damages meaningless. It is true that the limitation of the (unlimited) claim for damages only has the consequence that the injured party can no longer calculate his damage in concrete terms, which in practice only rarely happens anyway. Nevertheless, this is a not insignificant restriction of the claim for damages, because the infringer now only has to hand over what he has gained through the infringement at the expense of the infringed party and no longer has to answer for damage that does not correspond to his own

economic advantage. The fact that the claim for damages remains enforceable beyond the time limits of the statute of limitations with regard to the surrender of what has been obtained, whether by payment of a license fee appropriate for the use of the protected property or by surrender of the profit made with the protected property, is precisely an expression of the legal idea of Sec. 852 sentence 1 Civil Code, which does not want to leave the infringer with the fruits of his unlawful action.

24 (3) A limitation of the subject matter of the obligation to surrender to compensation for the use of the protected subject matter would also lead to the exclusion of a claim under Sec. 141 Sentence 2 Patent Act in conjunction with Sec. 852 sentence 1 Civil Code in the case of contributory patent infringements (Hülsewig, GRUR 2011, 673, 677). This is because an indirect patent infringement does not constitute an interference condemnation because the indirect infringer does not interfere with the assignment content of the third party patent right and thus his acquisition is not at the expense of the patent proprietor within the meaning of Sec. 812(1) Sentence 1 Alt. 2 Civil Code (Federal Court of Justice, judgment of 24 November 1981 - X ZR 7/80, BGHZ 82, 299, 308 - Kunststoffhohlprofil II). The indirect infringer does not make use of the intangible object of protection himself and therefore does not obtain such use, but only promotes and enables such use. Nothing else applies to other cases of causing an infringement of an intellectual property right by an instigator or aider or abettor or a secondary infringer who, in the case of negligent commission of the act, only contributes to causing the infringement of the intellectual property right of a third party. As in the case of an unjustified warning of an infringement (BGHZ 71, 86 - Fahrradgepäckträger II - Bicycle Carrier II), in these cases it can only be prevented by surrendering the infringer's profit that the infringer is left with the fruits of his unlawful action, contrary to the meaning and purpose of Sec. 141 Patent Act.

25 3. The accessory claim for rendering of accounts includes, subject to the possibility and reasonableness, in addition to the information on the calculation basis of the (residual) claim for damages, also information which, although not necessary for the pure calculation per se, serves to verify and make plausible the input data communicated by the obligated party for the calculation

and for this reason is necessary for the enforcement of the main claim (Federal Court of Justice, judgment of 20 May 2008 X ZR 180/05, BGHZ 176, 311 margin no. 31 et seq. - ink cartridge; BGHZ 183, 182 margin no. 44 - door interior reinforcement).

26 a) Accordingly, the claim for rendering of accounts also includes, in addition to the information on the profit, information on the prime costs. These are necessary for the calculation of the infringer's profit to be surrendered (BGHZ 176, 311 marginal no. 33 - ink cartridge).

27 b) The same applies to information on the advertising carried out.

28 aa) If a technical property right is infringed, the entitled party regularly has justified grounds for fearing that the infringer might be tempted to conceal the scope of his infringing activities by providing incorrect or incomplete information, irrespective of whether his property right was infringed intentionally or negligently. Therefore, the rightful claimant cannot regularly be referred to content himself with information whose truthfulness he cannot verify. Without the possibility of verification, the entitled party would be deprived of the possibility of requiring the obligated party to provide truthful information by way of Sec. 259(2) of the German Civil Code. Subject to the possibility and reasonableness, he can therefore also demand such information which is only necessary for the verification of the information on the calculation basis of his claim (Federal Court of Justice, judgment of 2 April 1957 I ZR 58/56, GRUR 1957, 336 - Rechnungslegung). This includes not only further information on the business transactions forming the basis for the calculation, which allow a direct verification of individual statements, such as the disclosure of the purchasers of the sales transactions made, but also information on such transactions which indirectly allow conclusions to be drawn on the truthfulness of the statements.

29 bb) In accordance with these requirements, information on the advertising conducted is regularly already necessary for the plausibility check of the information on the turnover or the number of units sold and is also reasonable from this point of view. Thus, a conspicuous discrepancy between the scope of the advertising and the stated sales achieved or the number of units sold may give rise to doubts as to the correctness and completeness of

the information. It is true that this information can already be verified by comparing the notified customers with the customers determined independently by the entitled party, and this possibility of verification also encourages the obligated party to provide complete and correct information. However, the information provided on the advertising activities opens up the above-mentioned additional possibility of verification. Depending on how plausible the reported sales appear to be in comparison to the advertising, the entitled party can shape the scope of its search for possibly concealed customers or determine the direction of this search on the basis of the public addressed by the advertising. In this respect, the information on the advertising carried out is, for its part, comparatively easy to verify and, moreover, can give an indication of the care with which the accounting has been prepared. On the other hand, the obligated party is not unduly burdened by the notification of the operated advertising. Since the advertising is publicly perceptible, the obligor does not regularly have to disclose any internal information by communicating the operated advertising.

30 cc) If the obligor is also obligated to surrender the infringer's profit - as in the case in dispute - the information on the advertising served also serves to make the costs incurred more plausible and concrete.

31 III. The decision on costs - also with regard to the costs of the complaint against non-admission - is based on Sec. 97(1) Code of Civil Procedure.

Meier-Beck Grabinski Hoffmann

Judge at the Federal Court of Justice Dr. Deichfuß is ill and therefore unable to sign.

Meier-Beck Marx

Previous instances:
Regional Court of Mannheim, judgment of 6 February 2015 – 7 O 289/10 –
Higher Regional Court of Karlsruhe, judgment of 9 November 2016 – 6 U 37/15 –