Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2016-05-10
Docket Number / Aktenzeichen:	X ZR 114/13
Name of Decision / Name der Entscheidung:	Wärmetauscher

FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

Judgment

X ZR 114/13

Pronounced on:
10 May 2016
Anderer
Judicial Secretary
as Clerk
of the Court registry

in the matter

Wärmetauscher/Heat exchanger

EPC Art. 69; Patent Act Sec. 14; German Civil Code Sec. 242 Cd, D; TRIPS Art. 30; Directive 2004/48/EC Art. 3(2)

a) Determining the meaning of a dependent claim may basically contribute to the correct interpretation of the independent claim of a patent. However, thereby it should be noted that dependent claims regularly do not restrict the subject matter of the independent claim, but as well as the embodiments – if necessary connected with an additional advantage – only show possibilities of its design.

b) Granting a grace period in the patent infringement proceedings would only come into question if the immediate enforcement of the patent proprietor's injunctive relief, even in consideration of his interests due to special circumstances vis-à-vis the infringer, was a disproportionate unjustified severity due to the exclusive right and the regular consequences of its enforcement and, thus, contrary to good faith.

Federal Court of Justice, judgment of 10 May 2016 – X ZR 114/13 –
Higher Regional Court of Karlsruhe
Regional Court of Mannheim

ECLI:DE:BGH:2016:100516UXZR114.13.0

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 10 May 2016 attended by the presiding judge Prof. Dr Meier-Beck, the judges Gröning and Dr. Drabinski as well as the judges Schuster and Dr. Kober-Dehm

ruled that:

Further to the plaintiff's legal remedies, the decision of the 6th Civil Senate of the Higher Regional Court of Karlsruhe dated 7 August 2013 in respect of the costs and in the scope of the subsequent amendment of the decision of the 2nd Civil Chamber of the Regional Court of Mannheim dated January 17, 2012 are set aside and this decision amended:

The Defendant to 1 is ordered to cease and desist from manufacturing a heating system for vehicles with open-top passenger compartment, as e.g. convertibles, in which warm air is supplied via ducts for heating, which is configured separately from the vehicle heating and ventilation system as an additional heater which is provided as a separate heater comprising PTC elements and heat exchanging metal fins and fans, in which air nozzles are provided in the region of the backrest of seats for flowing warm air around the head, neck, and shoulder area of the seated person and in which the warm air flow achieved thereby is spatially limited in such a way that it extends to the two exterior sides of the shoulders and to the upper arms.

Defendants to 1 and 3 are ordered to cease and desist from offering, marketing, using or importing or possessing for the aforementioned purposes the aforementioned heating system.

For each case of violation, the defendants to 1 and 3 shall be subject to an administrative fine of up to € 250,000 – in lieu of which they may be held in custody – or an arrest for contempt of court of up to six months, in the event of a repeated violation of up to a total of two years.

Defendant to 1 and 3 are also ordered to provide the plaintiff with an account of the extent to which they have committed the acts which they are prohibited from doing since 28 February 1998, indicating

- Defendant to 1: manufacturing quantities and periods,

- Defendant to 3: quantity of the received or ordered products, names and addresses of producers, suppliers, and other previous owners as well as the prices paid,

- the individual deliveries, broken down by quantities, times and prices (and where appropriate type descriptions), as well as names and addresses of the customers including the points of sale for which the products were intended,

- the individual offerings, broken down by quantities, times and prices (and where appropriate type descriptions), as well as names and addresses of the offerees,

- the advertising activities, broken down by advertising media, their circulation, distribution period, and distribution area, and

- the production costs, broken down by the individual cost factors, and the realized profit;

Purchase prices and points of sale thereby have to be communicated only for the time since 1 September 2008.

It is established that the Defendants to 1 and 3 are obliged to compensate the plaintiff for the damage caused to the former patent holder L. S. by the acts they were prohibited from committing from 28 February 1998 to 15 August 2011 and to the Plaintiff itself by the acts they were prohibited from committing since 16 August 2011, and for damage that will still arise.

The remainder of the action is dismissed.

Further appeals are rejected.

Of the court costs and the extrajudicial costs incurred by the Plaintiff, the Plaintiff itself shall bear one third, the Defendants to 1 and 3 another third as joint and several debtor, and the defendants to 1 and 3 shall each bear a further sixth. The extrajudicial costs of the Defendants to 1 and 3 shall be borne by themselves, the extrajudicial costs of the Defendant to 2 shall be borne by the plaintiff.

By operation of law

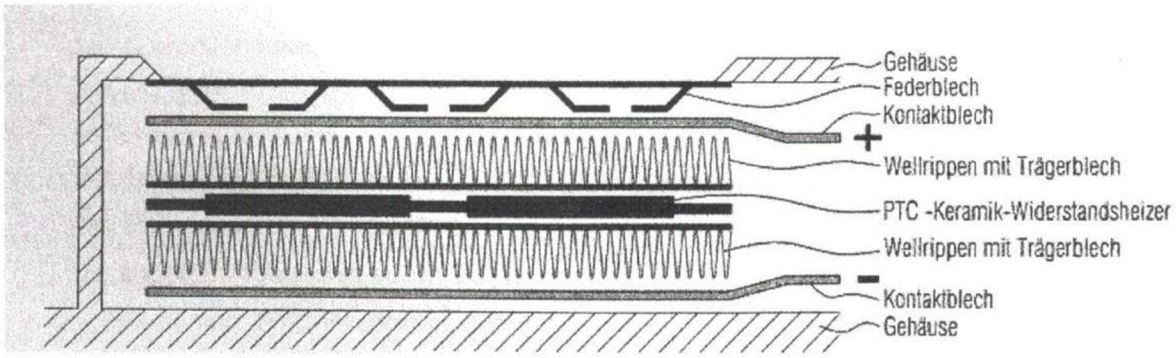
Facts of the Case:

1 The Plaintiff is the registered proprietor of the German patent no. 196 54 370 filed on 24 December 1996, of which claims 1 and 3 have received the following version in patent nullity proceedings (Federal Court of Justice - BGH, decision dated November 16, 2010 – X ZR 97/08, juris):

> “1. Heating system for vehicles with open-top passenger compartment, as e.g. convertibles, wherein warm air is supplied via ducts for heating, characterized in that
>
> a) it is configured separately from the vehicle heating and ventilation system in the form of an additional heating,
>
> b) it is provided as separate heating comprising a separate heat exchanger (22, 42) and fan (23, 43),
>
> c) that in the region of the backrest (3, 32) of seats air nozzles (6, 33) for feeding warm air around the head, neck and shoulder areas of the seated person are provided, and
>
> d) that the warm air circulation achieved thereby is spatially limited in such a way that it extends to the two exterior sides of the shoulders and to the upper arms.
>
> 3. Heating system according to claim 1, characterized in that electrical heating wires are provided at least in one part of the air channels (20, 41).”

2 The Defendant to 1 produces heating systems for car seats of convertibles. The Defendant to 2 is its parent company. The heating systems are integrated into the backrests of the seats and essentially consist of a paddle-wheel-shaped blower, a PTC element (PTC = positive temperature coefficient) and a special air duct. Thereby, an airflow generated by the blower is guided through the PTC element and heated for the output in the neck area of the vehicle occupants. The systems are integrated with the designation “X” as special equipment into specific vehicles manufactured by the Defendant to 3 and for this are supplied as spare parts.

3 According to a schematic sketch submitted to the files, such PTC elements are an arrangement of the following components:



4 According to the findings of the Court of Appeal, in PTC elements, electrical current is conducted via the outer circuit boards and the corrugated fins (lanellae) to the PTC ceramic resistors so that these are heated. The generated heat is transferred to the metal fins via the carrier plates and heats the passing air. The conduction of the electrical current to the ceramics themselves does not contribute to the heating of the lamellae, or only to a hardly measurable extent.

5 The Plaintiff has claimed that this system makes use of all the features of patent claim 1 of the patent in suit literally, at any case, however, by equivalent means; most recently, it has claimed against the Defendants before the court of appeal for injunctive relief, accounting, recall, destruction, and publication of the judgment, and has sought a declaration of its obligation to pay damages. The claim was unsuccessful in the lower courts. In its appeal,

which was allowed by the Senate, the Plaintiff is continuing to pursue its claims for injunctive relief and accounting – with the exception of proof of delivery and manufacturing quantities by means of copies of the receipts – and for a declaratory judgment; it has waived the further claims. The Defendants request that the appeal be dismissed and the Defendants to 1 and 3, moreover, auxiliarily request to grant them a grace period until the date on which the vehicles equipped with the X-technology that were ordered up to the date of the pronouncement of the appeal judgment have been delivered, plus a period of two months, however, for a maximum period of seven months, and to declare the Defendant to 3 entitled to supply vehicles already manufactured but not yet sold to end consumers within this period, but also to manufacture already ordered vehicles with X-technology up to the aforementioned date. The plaintiff opposes this request.

Grounds of the decision:

6 I. The patent in suit relates to a heating system for vehicles with an open-top passenger compartment. According to its description, heating systems for vehicles were known in the state of the art, in which the air heated by means of heat exchangers is supplied to the closed passenger compartment via ventilation ducts that are mounted in the area of the interior trim and provided with outlet openings and flaps. However, satisfying results could not be achieved for vehicles that are open-top as e.g. convertibles because, as a result of the strongly accelerated driving wind directed upward by the windshield, negative pressure was created in the area of the open passenger compartment and, as a result, a reverse air flow flowing past the seats from the rear to the front. Although this reverse airflow is not undesirable because it is part of the convertible driving experience, the cool draft can cause hypothermia and health problems in the head, neck and shoulder area in unfavorable weather conditions.

7 Against this background, the patent in suit relates to the problem of creating a heating system, in which the head, neck and shoulder area of the

vehicle passengers are better protected against hypothermia when driving in open-top vehicles. For this purpose, claim 1 of the patent in suit suggests a heating system

1. for vehicles with open-top passenger compartment, as e.g. convertibles,

2. wherein hot air is fed by air channels for heating

3. which is configured as a separate auxiliary heater, separate from the vehicle heating and ventilation system, comprising a separate heat exchanger and blowerm,

4. wherein in the region of the backrest of the seats air nozzles are provided,

5. being suitable to feed warm air around the head, neck and shoulder area of the seated person,

6. wherein the warm air circulation achieved thereby is spatially limited such that it extends to the two exterior sides of the shoulders and to the upper arms

8 II. The Court of Appeal assumed that the contested heating system complied with features 1, 5, and 6 and essentially stated, with regard to the implementation of features 2 to 4, which were disputed between the parties, by the contested embodiment, the following:

9 The features 2 and 4 are also fulfilled. Regarding the contested heating system, heat is supplied via air channels. Feature 2 is not to be understood as meaning that the heating system must be connected to the warm air system of the vehicle and that it must be supplied with warm air. Rather, it was sufficient for air to be heated in the heat exchanger and then guided via ducts to the air nozzles (feature 4) in order to flow around the head, neck, and shoulder area after it had emerged. In the specification of the patent in suit, it is repeatedly expressed that it is a matter of supplying the air nozzles with warm air, whereby the suction of cold air for heating in the heat exchanger is also described. The contested embodiment is configured in this way. The air is

heated during the transmission through the lamellae of the PTC heating element and supplied to the nozzles via a duct system.

10 Contrary thereto, the contested embodiment does not use a heat exchanger in the sense of feature 3. Such a heat exchanger does not necessarily have to utilize the heat generated during the operation of the vehicle, i.e. the heated cooling water or the exhaust gases, but can also exchange heat generated specifically for its use. However, the term “heat exchanger” does not cover a device that merely generates and dissipates heat like a heating wire or heating plate. This is derivable from patent claim 3 and from the distinctive comparison of heating wires and heat exchangers in the description. The patent in suit considers heat exchangers and electrical heating wires as being different devices. The fins of the PTC elements are heating wires shaped like plates, and the heat generated by the resistance heaters of the PTC elements is not exchanged by the fins, but they merely enlarge the surface of the device for better emission of the generated heat to the passing air. Thus, it relates to devices which generate heat by themselves and do not serve the sole purpose of exchanging heat according to the invention.

11 In the absence of a device with the same heat exchanging effect, the solution of the contested embodiment cannot be assessed as an equivalent realization of feature 3, particularly as the skilled person is led away by the subject matter of patent claim 3 from the fact to consider the active heat generation in the airstream as being covered by the scope of protection of the patent in suit.

12 III. The appeal successfully challenges this assessment of the content of the patent claim and its scope of protection

13 1. In its elaboration of the patent-comliant understanding of the term “heat exchanger”, the Court of Appeal referred to the empirical principle recognized in the case law of the Federal Court of Justice that terms in patent specifications may have a meaning that deviates from the general (technical) usage, which is then decisive for the correct understanding of the technical teaching in question (*Federal Court of Justice*, BGH – decision dated 2 March

1999 – X ZR 85/96, GRUR 1999, 909 – Spannschraube (*clamping screw*); decision dated 12 March 2002 – X ZR 168/00, BGHZ (*decisions in civil matters*) 150, 149, 155 et seq. – Schneidmesser I (*cutting knife*)). The question whether the patent in suit is based on a “dictionary of its own”, however, does not arise in the case of dispute insofar as the Court of Appeal states that the linguistic usage on the filing date with regard to the term “heat exchanger” was inconsistent and the submission of both parties proves inter alia that the PTC heaters or their fins were (also) referred to as heat exchangers on the filing date of the patent in suit. Therefore, an understanding of such a resistance heating element as being included in or excluded from the concept of a heat exchanger according to the patent does not constitute a characterization deviating from a fixed general (technical) linguistic understanding.

14 2. For its understanding of the term “heat exchanger” according to the patent in suit, the Court of Appeal, according to the context of the grounds of the appeal judgment, focused decisively on the relationship of patent claim 1 to patent claim 3 and the fact that in the latter mentioned dependent claim an element designated as a heating wire is provided as an additional means for heating the airstream. However, the conclusion drawn by the Court of Appeal that a unit cannot be classified as a heat exchanger within the meaning of feature 3 if the heat is generated the same way as with a heating wire, is significantly affecting the decision in a legally erring manner. The embodiment protected in patent claim 3 and the corresponding explanations in the patent specification (C1 patent specification, description column 2 lines 44 ff.) are not of the significance as given by the Court of Appeal for the determination of the inherent meaning of patent claim 1 in respect of the term “heat exchanger” in feature 3.

15 a) The determination of the inherent meaning of a dependent claim may fundamentally contribute to the correct interpretation of the independent claim (cf. Schulte/Rinken/Kühnen, Patent Act PatG, 9th edition, Sec.14 margin 26). This is because dependent claims further develop the solution claimed in the independent claim and can thereforen – indirectly – provide insights into its technical teaching. It should be noted, however, that they regularly do not

restrict the subject matter of the independent claim, but, unlike examples of embodiments (BGH, decision dated September 7, 2004 – X ZR 255/01, BGHZ 160, 204, 210 – Bodenseitige Vereinzelungseinrichtung (*bottom-side separating device*) – merely indicate – possibly with an additional advantage – possibilities of its embodiment. In addition, the extent to which viable conclusions can be drawn from the subject-matter of a dependent claim for the understanding of the main claim and the terms used therein depends on the circumstances of the individual case, in particular also on what the supplement to the technical teaching of the main claim proposed by the dependent claim consists of and in what way it develops the subject-matter of the main claim. If, for example, a feature is supplemented by an aspect further shaping this feature in the interest of functional optimization, this may under certain circumstances enable more viable conclusions to be drawn about the understanding of the feature in question within the scope of the teaching of the patent in suit than if a further element is added to the features of the main claim. Inferences from the nature of the additional feature to the “correct” understanding of the main claim will in any case not be easily drawn in this case.

16 b) In the case in disputethis is one of the last described additions to the main claim. The main claim and dependent claim are related to one another in that a further autonomous heating means (heating wires) is provided to support the effect of the heating system protected by the main claim. The Court of Appeal has drawn conclusions from the type of this additional means as to the mode of operation of the heating means actually provided, the heat exchanger of the additional heating system, which, however, are not sustainable.

17 aa) According to patent claim 3, electrical heating wires may at least be provided in one part of the air ducts (20, 41). In the description, this is suggested as an appropriate embodiment in order to ensure an additional heating of the air streaming to the nozzles and to reduce the heating time irrespective of the engine temperature (description column 2 lines 44 et seq.), in particular when the heating capacity of the heat exchanger is insufficient – for example, in cool conditions. To remedy the situation, the patent in suit

proposes in claim 3 the use of an additional heat source operating in such a way that further heat is added to the air flow, which has not been sufficiently heated by the heat exchanger or has already cooled down again on its way to the nozzles, by making space-saving use of the existing air ducts, so that the head, neck and shoulder areas of the occupants can be surrounded by sufficiently heated air.

18 bb) Thus, patent claim 3 indicates a means by which the objective of the additional heater according to the invention of providing a sufficient flow of warm air in the neck and shoulder region can be achieved even better, because the heating wire responds immediately and thus, for example after a cold start, the time span can be bridged until the cooling water has already warmed up sufficiently to provide the heat exchanger with sufficient heat capacity. The Court of Appeal has not been concerned with the question of what is to be inferred from this further development of the teaching according to the invention for the understanding of the invention in the general form of the main claim, but has interpreted the term of the heating wire in isolation as a counter term to the term of the heat exchanger used in patent claim 1, as illustrated in particular by its consideration that the lamellae of the PTC element represent a heating wire widened, as it were, to form a plate. The fact that the heat exchanger according to feature 3 and the heating wire provided in patent claim 3 both serve to heat the air flow, however, does not justify a restrictive understanding of the term “heat exchanger” in the sense of patent claim 1 – going beyond the implicitness that a heating wire is not a heat exchanger - in the meaning of a definition oriented on the counter term of the heating wire. The appeal judgment does not show that the description would give rise to the assumption that the patent in suit refers to a heat exchanger in the main claim in order to distinguish it from other heating elements, namely heating wires.

19 cc) With its considerations ins this regard, the court of appeal also contradicts its own starting point, namely that the protected heat exchanger, according to the understanding of the skilled person, is not reduced to the purpose of recovering the heat generated during the operation of the vehicle (cooling water, exhaust gases), but can fall back on heat generated only for it.

With this premise, the opinion of the Court of Appeal that the emission of the heat generated by the PTC elements via the lamellae may not be considered being a heat exchange in the meaning of patent claim 1 cannot be reconciled in a technically meaningful way. Because this would have the consequence that within the scope of the additional heating protected by the patent in suit, another fluid functionally corresponding to the cooling water or exhaust gas would have to be provided and heated in order to give off its heat to the air flow (without touching it) which is conducted past it.In view of the constructional effort associated therewith, the skilled person would not understand the term “heat exchanger” in the context of the teaching of the patent in suit in the sense attributed to it by the Court of Appeal. This applies all the more since, according to the findings of the court of appeal, the linguistic usage with regard to this term on the filing date of the patent in suit was inconsistent and, from the view of the skilled person, there was no compelling necessity to reduce it to the paraphrase in the guideline VDI 2076 (ROKH 14), where heat exchangers are indeed described as deviced in which warmer substances release part of their heat and this is absorbed by colder substance, whereby the mass flows involved in the heat exchange do not touch each other, but this definition is related to the proof of performance for “heat exchangers with two mass flows”.

20 IV. The contested judgment, therefore, cannot stand on the grounds given by the Court of Appeal. Insofar as the claim brought against Defendants to 1 and 3 is concerned, it is not deemed to be correct and is to be set aside to that extent (Sec. 562(1) ZPO – *Code of Civil Procedure*). The Court of Appeal has, contrary to the opinion of the responses in the appeal proceedings, obtained sustainable assessments on the realization of the features 2 and 4.

21 1. The Defendant to 3 complains that there are no findings that warm air is supplied via ducts in the challenged embodiment. This complaint is based on an editorially misleading wording of the patent in suit and a subsequent misunderstanding of the inherent meaning of feature 2.

22 a) According to the established case law of the Federal Court of Justice, the interpretation of the patent claim required for the assessment of a patent infringement must determine the meaning of the claim in its entirety and

the contribution of each individual feature to the overall performance result of the invention (BGH, judgment dated February 13, 2007 – X ZR 74/05, BGHZ 171, 1120 – Kettenanordnung I (*chain arrangement*); judgement dated July 17, 2012 – X ZR 117/11, BGHZ 194, 107 – Polymerschaum I (*polymer foam*)). The interpretation of patent claim 1 of the patent in suit which is based on these requirements does not disclose any indication for the fact that an embodiment would be technically desired in which (already) heat is fed to the heating system via channels, and that feature 2 is meant to express this. The feature states, as the Court of Appeal correctly pointed out, that heated air is conducted via ducts to the nozzles in the area of the backrests. The fact that no heating system is claimed to which heated air is already supplied on the other hand already follows from the fact that patent claim 1 in the granted version included heating systems in which the warm air supplied to the nozzles was generated by the general warm air system of the vehicle, i.e. no additional heating was used at all (description, column 2, line 23 ff.), and from the point of view of a skilled person it is far from being the case that the warm air system of the vehicle is already supplied with warm air via ducts for heating. Nothing else applies to the limited subject-matter of the patent in suit, and also in both embodiments of the invention fresh air is sucked in (column 3 lines 43 ff; lines 59 ff.). In patent claim 1 only the conjunction “in case of” is missing in the wording of feature 2. It refers to the introductory sentence of the description of the patent in suit, in which the invention is described as a heating system for vehicles, in particular those with an open passenger cell or a passenger cell to be driven open, “to which” warm air is supplied via ducts for heating. This description has found its way into the granted patent claim 1 (cf. facts of the Senate decision of 15 November 2010 – X ZR 97/08) and has therefore also remained in the limited version of the claim.

23 b) In the attacked embodiment, the warm air, is also ducted (channel guided) to the nozzles. This warm air does not necessarily have to be produced in front of the ducts within the additional heating system. The passage of the description (column 3 lines 5 ff.) claimed by the Defendant to 3 for its contrary point of view relates to a specific advantageous embodiment and the corresponding depiction in figures 2 and 4. According to general principles, this is not suitable to restrict the subject matter and the scope of

protection of the patent (BGHZ 160, 204, 210 – Bodenseitige Vereinzelungseinrichtung (*bottom-sided separation device*)).

24 2. According to the context of the grounds of the appeal judgment, feature 4 is fulfilled literally. The Court of Appeal understands the term “nozzles” in the context of patent claim 1 obviously as being a synonym for “air outlet openings”. This is appropriate in view of the function assigned to these elements according to the entirety of the features of the claim, namely to ensure that warm air flows around the head, shoulder and neck area up to the shoulder outer sides with hot air; a conically narrowing muzzle, which the air outlet opening are supposed to have according to the Defendant’s ideas, and the associated focusing of the air jets could possibly even be detrimental to the achievement of the aforementioned purpose, because a certain dispersion of the air flows is more favorable for this.

25 The air outlet openings according to feature 4 are provided in the region of the backrest. The fact that the patent in suit does not show any embodiment directly corresponding to the challenged embodiment does not restrict its subject-matter and scope of protection in this respect either (as above margin 23).

26 V. The Senate itself can decide on the merits of the case (Sec. 563(2) Code of Civil Procedure), because the legal dispute is ready for a final decision on the basis of the finding made and further findings are neither necessary nor to be expected.

27 1. It is quite possible that the PTC elements used by the contested embodiment represent heat exchangers in the sense of feature 3 from the view of the skilled person and that this feature is therefore realized in a literal sense.

28 The patent in suit as granted in patent claim 1 does not specify the way in which the air flow supplied to the passenger compartment is heated, even for the main heating of the vehicle. This could be a reason for an understanding of the separate heat exchanger in the meaning of feature 3, which places the emphasis on the separate provision of the heat required for

the additional heating rather than on a specific form of the provision by exchanging heat between two mass fluxes.

29 On the other hand, the description is pervaded by the assumption, which is taken for granted, that the vehicle (main) heating system consists of a “classical” heat exchanger in which the thermal energy required for the heating of the heating airstream is emitted by a different fluid stream, in particular the coolant stream. This could be a reason for understanding the “separate heat exchanger” of feature 3 also in this (narrower) sense.

30 2. However, this does not require a final decision. The contested embodiment also falls within the scope of protection of the patent in suit even if a narrower understanding of a heat exchanger is taken as a basis for feature 3. The contested embodiment in which the heat produced by the PTC resistance heating elements is absorbed by the lamellas and released to the air passing along, int any case fulfills the requirements established in the case law of the Federal Court of Justice for the infringement of property rights by equivalent means (cf. judgment dated January 13, 2015 - X ZR 81/13, GRUR 2015, 361 recital 18 – Kochgefäß (*cooking vessel*); judgement dated May 10, 2011 - X ZR 16/09, BGHZ 189, 330 recital 28 et seq. – Okklusionsvorrichtung (*occlusion device*); judgement dated December 14, 2010, GRUR 2011, 313, recital 35 - Crimpwerkzeug IV (*crimping tool*); judgement dated March 12, 2002 - X ZR 168/00, BGHZ 150, 149, 154 - Schneidmesser I (*cutting knife*)). This arises from the following contemplations.

31 a) The heat transfer via the fins of the PTC element achieves the effect of the heat exchanger according to the invention.

32 The skilled person derives from the description of the patent in suit that for heating the air for flowing around the head, neck, and shoulder area of the passengers, recourse can be made to the sources already available in the vehicle operation, i.e., to the cooling water heated by the engine cooling or a cooling air flow or, where appropriate to the exhaust gas flow. The fact that the patent in suit generally uses the term of the heat exchanger in connection with the generation of hot air for the vehicle heating, against this background can be explained from the skilled person’s point of view due to the fact that the hot

air for the general vehicle heating, as already mentioned, usually and for logical reasons is provided via heat exchangers without the need for the patent in suit to contain a determination to that extent in the granted patent claim 1 and thereby expressing that it not only depends on the heat transferred to the airstream serving the heating but also on the question where the thermal energy transferred to this airstream comes from.

33 This particularly applies to the heat transfer within the scope of the additional heating system of the applicable restricted version of patent claim 1. On the one hand, the energy demand here is limited since not the entire passenger compartment needs to be heated, on the other hand, the patent in suit as expressed by patent claim 3 considers it to be desirable to take into account the possible long way up to a fluid stream from which the heat may be taken and the longer response time by a heating wire as an additional, rapidly responding means that may be affixed near the point of effect for heating the airstream.

34 From the skilled person’s point of view, according to the aforesaid, for the same effect in connection with feature 3, it only depends on the fact that the additional heating during operation in a similar manner as the general vehicle heating continuously provides warm airstreams, wherein the same are not supposed to stream diffusely into the passenger compartment through the channels and air valves provided for this but are reserved to the targeted feeding around of the head, neck and shoulder area of the passengers. The PTC elements achieve this effect and simultaneously, the one of the heating wires according to patent claim 3, by rapidly and precisely responding to the hot air demand for the additional heating and by transferring via the lamellae the thermal energy required therefor to the airstream supplied to the air nozzles which are fitted in the region of the backrest.

35 Their effect mechanism is at least very similar to the one of a heat exchanger in the meaning of the definition in the Guideline VDI 2076. The lamellae (corrugated ribs) are heated according to the determined circumstances by the ceramic resistance heaters and the absorbed heat is transferred by the lamellae to the airstream passing along them for this purpose. Thus, the difference is that the airstream to be heated is not guided

along another (hotter) fluid. However, a transfer of thermal energy from one medium to the other occurs, which is comparable to the transfer in a contactless heat exchanger according to VDI 2076, also because the heat there, as well, is not exchanged due to the direct contact (mixing) of the streams of varying heat but via a partition wall. The corrugated ribs correspond to this partition wall through which the heat generated in the heating elements is transferred to the airstream and which comprise the corrugated surface profile for the purpose of the enlargement of the effective area.

36 b) The skilled person could find the modified embodiment with its deviating means due to his specialist knowledge as equivalently effective.

37 According to the decision of the Federal Court of Justice in the nullity proceedings referred to by the Court of Appeal, the relevant understanding of the skilled person includes the knowledge of a graduate engineer (FH) in the field of mechanical engineering with several years of professional experience with a vehicle manufacturer or supplier of approvals who is concerned with questions of air conditioning of passenger compartments. According to the findings of the Court of Appeal and the statements in the expert opinion provided by the Defendants, PTC heating elements were known to him on the filing date of the patent in suit, and due to his expert knowledge, he was able to recognize that according to their type, they were suitable for the operation of a vehicle additional heating if for this purpose, it could not be fallen upon a cooling fluid or an exhaust gas stream or if such an access deemed to be costly or otherwise inexpediently.

38 c) To provide such PTC elements is finally also a result of a consideration of the skilled person oriented to the meaning of the teaching of patent claim 1 justifying the assessment of this solution as being equivalent. Since the patent in suit, as explained, leaves the selection of the source of the thermal energy required for the additional heating to the skilled person and in this connection in particular points to the aspect of possibly short ways as well as to a desirable rapid responding of the additional heating, this evaluation of the skilled person that he may also ensure the heat transfer required for the heating of the heating airstream by means of the ribs of a PTC resistance heater and, thus, where appropriate, even waive an additional heating wire, is

directly oriented to the purpose of the separate heat exchanger according to the invention as well as to the operating mode of the heat exchange of the airstream supplied to the neck and shoulder area which is decisive for achieving this purpose.

39 d) The “Formstein” objection raised by the Defendants to 1 and 2 (Federal Court of Justice, judgement dated 29 April 1986 – X ZR 28/85, BGHZ 98, 12 – Formstein (*molded brick*)) is unjustified. The Defendants fail to demonstrate that and to which extent the equivalent embodiment of the teaching according to the invention attacked by the vehicle additional heating would be rendered obvious as a whole by the prior art.

40 3. The defendants to 1 and 3 according to this are obliged to cease and desist from using the teaching according to the invention (Sec. 139(1) in conjunction with Sec. 9(2) no. 1Patent Act). There is no room for granting the alternatively claimed grace period.

41 a) The granting of a grace period which is usually intended to bridge the time needed for the transition and removal measures (Teplitzky/Feddersen, Wettbewerbsrechtliche Ansprüche und Verfahren (*claims and procedures under competition law*), 11th edition, chapter 57, recital 17 with further references) may be necessary, if the immediate enforcement of the injunctive relief of the patent proprietor also in consideration of his interests vis-à-vis the infringing party constituted a disproportionate severity not being justified due to the exclusive right and, thus, was a breach of trust.

42 aa) According to the established case law of the Federal Court of Justice, a grace period generally comes into question, for example, in competition disputes from the point of view of good faith (Sec. 242 BGB (German Civil Code)), if disproportionate disadvantages occurred to the party subject to injunctive relief upon immediate effect of the prohibition command and the limited continuation of the attacked behavior does not lead to unreasonable damage for the infringed party (cf. BGH, judgment dated 11 March 1982 – I ZR 85/80 GRUR 1982, 425, 431 – Brillen-Selbstabgabestellen (*delivery points for glasses*).

43 bb) The question to which extent also in case of a patent infringement a grace period can be granted has not yet been decided by a Supreme Court (cf. BGH judgment dated December 2, 1980 – X ZR 16/79, GRUR 1981, 259 – Heuwerbungsmaschine (*hay-making machine*) – in which decision the Court of Appeal granted such a period, however, the patent in suit was expired before filing the appeal; cf. as well BGH judgment dated February 3, 1959 – I ZR 170/57, GRUR 1959, 528 – Autodachzelt (*tent for vehicle tops*)).

44 cc) In patent law literature, it is argued that the granting of a grace period should be decided on a case-by-case basis, taking into account all interests involved and subjective elements (good or bad faith of the infringing party). Thereby, it is in particular regarded a space for an exceptionally to be granted grace period, if the subject of infringement only relates to a small but a functionally necessary component of a technically complex device and cannot be replaced within a reasonable time by a patent-free or licensable product (Benkard/Grabinski/Zülch, PatG, 11th edition, Sec. 139 margin 136a with further reference; for application of strict criteria in consideration of type and extent of the fault of the infringing party, the behavior of the entitled person, and the economic impact also Busse/Keukenschrijver, PatG 7th edition Sec. 139 margin 82).

45 dd) In event of a patent infringement, the granting of a grace period only comes into question under strict conditions due to the nature of the impairment. In this case, it is not the question that for example goods which are per se duly manufactured are provided with trademark infringing signs (cf. Bornkamm in: Köhler/Bornkamm, UWG (*unfair completion law*) 34th edition Sec. 8 UWG margin 1.58) or that the rights and interests of the entitled person are endangered only in an indirect manner due to unjustified advertising measures or the like (cf. e.g. Ahrens/Baehr, Der Wettbewerbsprozess (*process of competition*), 7th edition, chapter 38 margin 1 with further references). In patent infringement matters, contrary to the effect of the patent (Sec. 9 Patent Act), rather a protected product is directly produced or marketed or a protected method is used. Therefore, it is the necessary consequence of the injunctive relief under patent law that the infringing party

has to stop the patent infringing production or the patent infringing distribution and can market the product in question again only if he has obtained the rights required from the patent proprietor or if he has modified the product such that it does not infringe the property right any more what, where appropriate, may require a considerable time and cost effort. The severities connected therewith are basically to be accepted. A limitation of the effect of the patent by granting a grace period therefore is only justified if the economic consequences of immediately observing the command of injunctive relief affect and disadvantage the infringing party in the individual case due to specific circumstances to a degree going beyond the damages associated with its pronouncement which makes the unconditional prohibition seem to be unreasonable.

46 ee) The international agreements and rules of European Union law referred to in this context do not give rise to a deviating assessment of the requirements in this respect.

47 (1) The Trade-Related Aspects of Intellectual Property Rights (TRIPS) does not contain any regulations directly relating to grace periods. Art. 30 TRIPS arguably allows the members to order limited exceptions from the exclusive rights from a patent insofar as such exceptions do not unreasonably contradict the normal exploitation of the patent and do not impact the legitimate interests of the patent proprietor, also in consideration of the interests of third parties.

48 Even if this regulation is understood to the extent that it does not only empowers a general limitation of the exclusive rights from a patent by legislative measures, - to which the defendant cannot draw upon – but legitimates the infringement court also in the individual case to appropriate exceptions, for this, the interests of the patent proprietor and the infringing party equally would have to be taken into account in order to be able to assess whether the respective claimed exception does not unreasonably contradict the normal exploitation of the patent. Indications for the fact that this could initiate a deviating evaluation of single aspects during the assessment (V 3 b below) in the light of Art. 30 TRIPS cannot be derived from this regulation.

49 (2) According to Art. 3 section 1 of the Directive 2004/48/EG of the European Parliament and the Council dated 29 April 2004 on the enforcement of the rights of intellectual property (OJ no. L 195 dated 2 June 2004 p. 16, Enforcement Directive), the member states provide fair and just measures, procedures and legal remedies for the enforcement of these rights not involving unreasonable terms or unjustified delays, and which are effective, proportionate, and deterrent according to Art. 3 para. 2 of the same regulation and which are applied such that the lawful trade is not limited and a guarantee against their abuse is given.

50 Granting a period of grace may basically come into question according to these Directive regulations, although not explicitly mentioned, in view of the proportionality, to the extent that this still requires the effectiveness required by Art. 3 para. 2 Enforcement Directive on the protection of intellectual property and the deterrent character of the intended measures. However, this also does not in principle result in any other or further consideration than in the context of national law. This is confirmed by the circumstance that the possibilities established by Art. 3 para. 2 of the Enforcement Directive of transgressing unconditional injunction orders are not extended by the English Courts as well, in the light of the foregoing (margin 45). According to a decision of the High Court of England and Wales (Pumfrey J) in a Copyright dispute ([2005 EWHC 282 (Ch) – Navitaire Inc v EasyJet Airline Co Ltd.), injunctive orders are to be unconditionally pronounced as long as they are not oppressive, which can only be assumed if the effect of the injunctive order is grossly disproportionate to the advantage of the protected right. The Court of Appeal (Jacobs LJ in Virgin Atlantic Airways Ltd v Premium Aircraft Interiours Group, [2009] EWCA Civ 1513) regards this assessment being consistent with Art. 3 of the Enforcement Directive (similar to the High Court of England and Wales [Arnold J] in a patent dispute ([2013] EWHC 3778 – HTC Corp. v Nokia Corp. marign 32).

51 b) The aspects claimed by the Defendants therefore in the event of a dispute, do not justify the granting of a period of grace.

52 aa) The subject matter of infringement, in fact only relates to a single element of a component (vehicle seat) mounted into a complex delivery item (vehicle). However, it already does not constitute a functionally essential

component but the X heating system is a special equipment feature which does not affect the general operational capability and usability of the vehicle and the vehicle seat. The fact that no or no adequate licensing possibility would have existed, is not shown. Even if the injunctive order - due to the forthcoming expiration of term of protection of the patent in suit - amounts to an obstacle precluding extradition for relevant vehicles which a priori is rather strictly limited in time, indications for severe and disproportionate economic effects for the entire business operation of the Defendants to 1 or 3 or even in respect of a certain segment of their product range are not obvious. The unconditional injunctive order against this background impacts the defendants disproportionally.

53 bb) Aspects of fault do not justify an assessment which is more favorable to the defendants. The defendants have not exercised the option to license the subject matter of the patent in dispute. The fact that the previous instances have not considered the attacked embodiment being patent-infringing does not give rise to a more favorable assessment for the defendants, not even in the light of an allegedly trust worthy of protection in the validity of the decision of the District Court and the Higher Regional Court. The circumstance that lower-instance courts have denied a patent infringement, at any case does not justify per se to perpetuate the effect of their decisions for the time after the announcement of the deviating appeal decision by granting a period of grace. The unconditional effect of the injunctive order in the factual circumstance, does not unreasonably impact the defendants, not even in this respect.

54 c) The Senate has formulated the pronunciation of injunction in compliance with the head of claim designated as auxiliary request. Irrespective of the issue of a literal or equivalent infringement and without defining in substance a different subject matter in dispute as main request, this corresponds to the demand to express in the head of claim and in a judgment sentence by which embodiments of the attacked products the teaching according to the invention is realized and, thus, not characterizing the subject matter of the patent in suit but the subject matter in dispute (BGH judgment dated 30 May 2005 – X ZR 126/01, BGHZ 162, 365 – Blasfolienherstellung

(*blown film production*); BGH judgment dated 21 February 2012 – X ZR 111/09, GRUR 2012, 485 – Rohrreinigungsdüse II (*pipe-cleaning nozzle*)).

55 4. According to Sec. 139(2) Patent Act, the Defendants to 1 and 3 further are obliged to compensate the plaintiff and the previous patent proprietor – who has assigned the claims for damages incurred to him to the plaintiff with agreement dated 16 August 2011 - for the damage incurred since by exercising ordinary care, they would have been able to recognize the infringement of the patent in suit by means of producing and distributing the attacked embodiment.

56 5. Finally, the obligations of the Defendants to 1 and 3 on accounting pursuant to Sec. 242 German Civil Code and the claim to give information via the sales channels of the attacked embodiment arise from Sec. 140b(1, 3) Patent Act.

57 6. The further originally asserted claims for destruction, recall as well as publication of judgement remain dismissed after the plaintiff in the oral proceedings before the Senate has resigned therefrom (Sec. 306 Civil Code of Procedure).

58 7. The claim brought against the defendant to 2 is unjustified. The Court of Appeal has merely established that this is the parent company of the defendant to 1 and that the parts supplied to the Defendant to 3 are characterized with the designation “Lear Corporation”. The last mentioned may also point to the Defendant to 1 alone and therefore does not justify to impute the patent infringement of the subsidiary to the parent company – not even in connection with the attachment of both companies under company law. The same applies in consideration to the circumstance additionally argued by the plaintiff that the Defendant to 2 subsequent to the claimed patent infringement has asked to conduct the further correspondence with her.

59 8. In the tenor of this judgement announced at the end of the session dated 10 May 2016, 16 December 2012 is allocated to the decision of the District Court and not 17 January 2012, the date on which the decision of

the District Court had been announced. The Senate has corrected this obvious mistake pursuant to Sec. 319(1) Code of Civil Procedure.

60 VI. The cost decision is based on Sec. 91(1), Sec. 92(2), Sec. 97(1) Code of Civil Procedure.

Meier-Beck Gröning Grabinski

Schuster Kober-Dehm

Previous instances:
Regional Court of Mannheim, judgment from 17 January 2012 – 2 O 112/07
Higher Regional Court of Karlsruhe, judgment from 7 August 2013 – 6 U 12/12