

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2017-05-16
Docket Number / Aktenzeichen:	X ZR 120/15
Name of Decision / Name der Entscheidung:	Abdichtsystem



Arbeitskreis
Patentgerichtswesen
in Deutschland e.V.



FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

JUDGMENT

X ZR 120/15

Pronounced on:
16 May 2017
Anderer
Judicial Secretary as
Clerk of the court
registry

in the matter

Abdichtsystem/
Sealing system

Code of Civil Procedure Sec. 521(2) sentence 2, Sec. 277(2), Sec. 524(3) sentence 2

The effectiveness of a time limit for filing a notice of appeal does not depend on whether the appellee was informed that a cross-appeal is also only admissible within this time limit.

Patent Act Sec. 140a(3) sentence 1

- a) The claims for recall and for final removal from the channels of commerce provided for in Sec. 140a(3) sentence 1 Patent Act may be asserted side by side.
- b) A claim for recall from the distribution channels is not excluded because the obligated party is domiciled abroad.

Patent Act Sec. 9 No. 1, Sec. 139; Civil Code Sec. 840

- a) A supplier of a domestically patented product who is domiciled abroad and who supplies a customer who is also domiciled abroad is not automatically obliged to check or monitor the further use of the supplied goods by the customer.

- b) In the aforementioned situation, the supplier is obliged to check the facts if there are concrete indications for him which make it appear obvious that his customers continue to supply the supplied goods in Germany or offer them there.
- c) The culpable facilitation or promotion of another party's patent infringement in breach of duty can only give rise to claims under Sec. 139 ff. Patent Act if a patent infringement by the third party has occurred or if there is at least a risk of first infringement (confirmation of Federal Court of Justice, judgment of 30 April 1964 - Ia ZR 224/63, GRUR 1964, 496, 497 - Formsand II).
- d) The culpable promotion or facilitation of another's patent infringement in breach of duty does not automatically give rise to an unrestricted claim for injunctive relief against acts, which in themselves do not constitute patent infringement.
- e) If a customer has committed at least one act of infringement, the supplier who has contributed to this in breach of duty and culpably is generally obliged to provide an invoice for all deliveries to this customer.

Federal Court of Justice, judgment of 16 May 2017 - X ZR 120/15–
Higher Regional Court of Karlsruhe
Regional Court of Mannheim

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 16 May 2017, attended by the presiding judge Prof. Dr. Meier-Beck, the judges Gröning, Dr. Grabinski and Dr. Bacher as well as the judge Dr. Kober-Dehm

ruled that:

The appeal of the defendant is dismissed.

On appeal by the plaintiff, the judgment of the 6th Civil Senate of the Karlsruhe Higher Regional Court of October 7, 2015 is set aside on the issue of costs and insofar as the plaintiff's cross-appeal was rejected.

To the extent of the reversal, the matter is referred back to the Court of Appeal for a new hearing and decision - including on the costs of the appeal proceedings.

By operation of law

Facts of the case:

- 1 The plaintiff is the owner of European patent 1 291 158 (patent in suit), which concerns a sealing system for inflatable objects. It is suing the Italian-based defendant for infringement of the patent in suit by offering and marketing repair kits for car tires.

- 2 The Regional Court ordered the defendant to cease and desist, issue an invoice, recall the product and remove it from the distribution channels, rejecting an additional claim for destruction, and found that the defendant was liable for damages.

- 3 On appeal, the defendant continued to seek dismissal of the action in its entirety. The plaintiff sought to extend the Regional Court's judgment to include deliveries to third parties located abroad that the defendant knows also deliver domestically. The Court of Appeal dismissed the defendant's appeal and the plaintiff's claim, which it qualified as a cross-appeal, and allowed the appeal with respect to the claim for recall and with respect to the claims for deliveries to customers domiciled abroad.

- 4 Both parties continue to pursue their second-instance claims to the extent of the Court of Appeal's allowance.

Grounds of the decision:

5 Both appeals are admissible. Only that of the plaintiff is well-founded.

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

7 The Regional Court had rightly ordered the defendant to recall infringing
products. Sec. 140a(3) sentence 1 Patent Act does not require that the infringer
has possession or ownership of infringing products in Germany. A claim for
recall also existed if the recall took place abroad and therefore could not entail
the obligation to destroy the recalled articles. The claims for recall and removal
do not serve exclusively to prepare for destruction, but in any case also to
remedy a state of disruption caused by the patent infringement. Article 10 and
recital 24 of Directive 2004/48/EC do not conflict with this view.

8 The claim pursued with the cross-appeal was, however, unfounded. A
delivery by a company based abroad to a recipient also based abroad does not
in principle constitute a patent infringement in Germany. Something else could
only apply if the delivered object was redelivered to the domestic market and
this redelivery could be objectively attributed to the original supplier. The latter
presupposes that the original supplier has participated in the further delivery as
an accomplice or accessory or has violated an obligation serving to protect the
infringed right. Such a breach of duty could only be affirmed in the constellation
of the dispute if the original supplier had knowledge that the customer was at
least also delivering the patented objects to Germany. Conditional intent is not
sufficient. In the case in dispute, the plaintiff had not provided any concrete
evidence that the defendant's customer based in Italy was supplying the
challenged embodiments to Germany. The fact that this company sells motor
vehicles in Germany and that the challenged repair kits contain instructions for
use in German, among other languages, is not sufficient.

9 II. This assessment does not stand up to legal scrutiny in one
decisive point.

10 1. However, the Court of Appeal did not err in law in affirming the
plaintiff's claim to recall products supplied to Germany from the distribution

channels pursuant to Sec. 140a(3) sentence 1 Patent Act.

11 a) Contrary to the view of the defendant, the entitled party may assert
the claims for recall and for final removal from the distribution channels provided
for in Sec. 140a(3) sentence 1 Patent Act side by side.

12 aa) The wording of the provision, according to which an infringer can
be claimed for recall or removal, is not unambiguous. However, it rather speaks
for a comprehensive right of choice of the entitled party.

13 The conjunction "or" permits both the understanding that the rightful
claimant must choose between one of the two remedies and the interpretation
that the rightful claimant may choose to demand one, the other, or both.
However, if the law attaches several claims to a given set of facts, the latter
interpretation is generally closer. In the case of so-called genuine competition
of claims, i.e. if several claims are directed at the same objective, they are in
principle independent of each other (cf. only Federal Court of Justice, judgment
of 22 July 2014 KZR 27/13, WuW/E DE-R 4328 = RdE 2014, 449 marginal no.
53 - Stromnetznutzungsentgelt VI). The same applies in principle if several
claims resulting from the same facts are directed at different goals.

14 The wording or structure of the law or the objective of the individual claims
may lead to a different conclusion in individual cases, in particular if the content
of the claims is mutually exclusive or cumulative assertion is contrary to the
purpose of the law for other reasons. However, there is nothing in the wording
of Sec. 140a(3) sentence 1 Patent Act to indicate that the creditor's right of
choice should be limited.

15 bb) The admissibility of a cumulative assertion in the present context
is supported by the complementary content of the two remedies.

16 Contrary to the view of the defendant, the claim for recall in relation to the
claim for final removal from the distribution channels is not merely a minus of
the same essence. Rather, the two claims are directed at different and
complementary goals.

17 The claim for recall obliges the debtor to request his customers to return

the infringing products supplied by him. Whether the purchasers comply with this request is left to their decision and has no effect on the debtor's liability, provided that the debtor has made all reasonable efforts to induce the purchasers to return the products on the basis of the request (Grabinski/Zülch in Benkard, Patent Act, 11th edition, Sec. 140a para. 17 ff.; Kaess in Busse, Patent Act, 9th edition, Sec. 140a para. 28 ff.; Rinken in BeckOK PatR, 3rd edition, Sec. 140a Patent Act marginal no. 48 ff; Kühnen, Handbuch der Patentverletzung, 9th edition, marginal no. D 603 ff; Mes, Patent Act, 4th edition, Sec. 140a marginal no. 19; D. Jestaedt GRUR 2009, 102, 103 f. ; cf. also Miosga in BeckOK MarkenR, 9th edition, Sec. 18 MarkenG marginal no. 39 ff; Ingerl/Rohnke, Markengesetz, 3rd edition, Sec. 18 marginal no. 46; Ströbele/Hacker, Markengesetz, 11th edition, Sec. 18 marginal no. 55 ff).

18 The claim for final removal from the distribution channels, on the other hand, obliges the debtor to exhaust all available and reasonable factual and legal possibilities in order to exclude the further or renewed circulation of patent-infringing subject matter in the distribution channels (see Grabinski/Zülch in Benkard, Patent Act, 11th edition, Sec. 140a para. 19; Kaess in Busse, Patent Act, 9th ed. Auflage, Sec. 140a Rn. 30; Rinken in BeckOK PatR, 3rd edition, Sec. 140a Patent Act Rn. 52 f.; Kühnen, Handbuch der Patentverletzung, 9th edition, Rn. D 614; Mes, Patent Act, 4th edition, Sec. 140a Rn. 27; D. Jestaedt GRUR 2009, 102, 105; Ingerl/ Rohnke, Markengesetz, 3rd edition, Sec. 18 marginal no. 48; Ströbele/Hacker, Markengesetz, 11th edition, Sec. 18 marginal no. 63 f.; further Miosga in BeckOK MarkenR, 9th edition, Sec. 18 MarkenG marginal no. 49). In individual cases, a mere invitation to the buyers may be suitable and sufficient to achieve this goal. Depending on the circumstances of the individual case, however, the debtor may be obliged to strive for this goal additionally or exclusively by other means, for example by taking legal action against a customer who refuses a return from the outset.

19 Despite this different objective, the two claims are not mutually exclusive. Rather, they complement each other (also Grabinski/Zülch in Benkard, Patent Act, 11th edition, Sec. 140a para. 19; Kaess in Busse, Patent Act, 9th edition, Sec. 140a para. 31; Rinken in BeckOK PatR, 3rd edition, Sec. 140a Patent Act para. 52; Mes, Patent Act, 4th edition, Sec. 140a marginal no. 25; D. Jestaedt

GRUR 2009, 102, 105; Ingerl/Rohnke, Markengesetz, 3rd edition, Sec. 18 marginal no. 48; Ströbele/Hacker, Markengesetz, 11th edition, Sec. 18 marginal no. 63).

20 Contrary to a view expressed in the literature (Miosga in BeckOK MarkenR, 9th edition, Sec. 18 MarkenG marginal no. 49), an alternative relationship cannot be based on the consideration that the two claims are directed to mutually exclusive acts, namely to a return transport to the supplier on the one hand and to a destruction at the customer on the other hand. It is true that the claim for final removal from the distribution channels can also be satisfied by destroying the infringing products directly at the customer's premises. However, final removal from the distribution channels can also be ensured in another way, for example by the supplier against whom the claim is asserted taking back the products and destroying them himself. In the latter constellation, the conduct owed on the basis of the claim for recall may partially coincide with the conduct to which the supplier is obligated on the basis of the claim for final removal. Consequently, there is no relationship of mutual exclusivity.

21 The possibility of a partial overlapping does not mean that the claim for recall could only be regarded as an essentially identical minus of the claim for final removal. On the contrary, it follows from the different objectives described above that in this constellation, too, the claims are complementary.

22 cc) A comprehensive right of choice corresponds to the legislator's ideas.

23 In the materials on Sec. 140a(3) Patent Act and the comparable provisions in other laws for the protection of intellectual property it is stated that the wording of Art. 10 of Directive 2004/48/EC is not completely clear, but rather speaks in favor of the Member States having to provide for all three claims mentioned therein (for destruction, recall and final removal from the distribution channels).

24 It can be inferred from this that the legislator intended to provide for all three claims cumulatively as a precautionary measure.

25 Whether this intention would also be relevant if it had not been reflected in the law can be left open. As already explained (para. 12 ff. above), the intention expressed in the materials has been sufficiently reflected in the wording of Sec. 140a(3) sentence 1 Patent Act by the use of the conjunction "or". Therefore, it must be taken into account in the interpretation of the provision.

26 dd) Contrary to the view of the defendant, there is no reason to obtain a preliminary ruling of the Court of Justice of the European Union on the question whether the understanding of Art. 10 of Directive 2004/48/EC favored by the legislator is correct.

27 According to Art. 2(1) of the Directive, Member States are free to provide for instruments that are more favorable to rightholders. Accordingly, the Court of Justice of the European Union has ruled on several occasions that the Directive does not prevent Member States from providing for more protective measures (ECJ, Judgment of 9 June 2016 - C-481/14, GRUR 2016, 1043 paras. 36 and 40 - Hansson; Judgment of 25 January 2017 - C-367/15, GRUR 2017, 264 para. 23 - Oławska Telewizja Kablowa).

28 Consequently, even if it were sufficient to make the claims for recall and for permanent removal from the distribution channels available as alternatives in order to transpose the Directive, the more extensive protection granted by the German legislator would undoubtedly be in line with the requirements of the Directive.

29 b) Contrary to the view of the defendant, the claim for recall under Sec. 140a(3) sentence 1 Patent Act does not require that the debtor has power of disposal over the subject matter affected by the recall.

30 The wording of the provision does not impose such a requirement. It would also be in contradiction with the sense and purpose of the provision, which imposes obligations on the debtor especially with regard to such objects which he has already delivered to third parties (also Grabinski/Zülch in Benkard, Patent Act, 11th edition, Sec. 140a para. 17; Kaess in Busse, Patent Act, 9th edition, Sec. 140a para. 28; Rinken in BeckOK PatR, 3rd ed. Edition, Sec. 140a

Patent Act marginal no. 41; Kühnen, Handbuch der Patentverletzung, 9th edition, marginal no. D 590; Mes, Patent Act, 4th edition, Sec. 140a marginal no. 19; D. Jestaedt GRUR 2009, 102, 104; cf. also Miosga in BeckOK MarkenR, 9th edition, Sec. 18 MarkenG marginal no. 57; Ingerl/ Rohnke, Markengesetz, 3rd edition, Sec. 18 marginal no. 42; Ströbele/Hacker, Markengesetz, 11th edition, Sec. 18 marginal no. 52). No different conclusions can be drawn from the earlier case law on recall claims based on the general claim for removal of an interference that has occurred, if only because Sec. 140a(3) sentence 1 Patent Act has led to a change in the legal situation in this respect.

31 Contrary to the defendant's view, an obligation to recall also cannot be considered disproportionate merely because the debtor has no power of disposal over the affected objects. Pursuant to Sec. 140a(3) sentence 1 Patent Act, the debtor is rather obliged, within the bounds of what is reasonable, to induce the purchasers to return the goods.

32 c) The Court of Appeal was also not correct in denying a claim for recall from the distribution channels because the defendant is domiciled abroad.

33 Contrary to a view expressed in case law (Higher Regional Court of Düsseldorf judgment of 18 July 2013 - 2 U 98/11, juris marginal no. 129), the claim for recall from the distribution channels is not a mere tool for enforcing the claim for destruction also provided for in Sec. 140a Patent Act. At least in the case of a supplier domiciled in Germany, both claims regularly go hand in hand because the entitled party can usually demand the destruction of products that the infringer has successfully recalled. Nevertheless, the claim for destruction in relation to the other two claims provided for in Sec. 140a Patent Act does not stand in a tiered or exclusive relationship either. Rather, all three claims are basically independent of each other due to their different, complementary objectives. Therefore, a claim for recall also exists against a supplier located abroad (in the result also Grabinski/Zülch in Benkard, Patent Act, 11th edition, Sec. 140a para. 13; Kaess in Busse, Patent Act, 9th edition, Sec. 140a para. 27; Rincken in BeckOK PatR, 3rd edition, Sec. 140a Patent Act para. 44; Kühnen, Handbuch der Patentverletzung, 9th edition, para. D 592 [differently still 6th edition, para. 1237]).

34 The question, which is to be distinguished from this, whether a transfer of infringing products to a foreign country free of property rights is sufficient to satisfy the claim for final removal from the distribution channels (Miosga in BeckOK MarkenR, 9th edition, Sec. 18 MarkenG marginal no. 53, in the negative), does not need to be decided in the case in dispute. The appeal does not challenge the defendant's order to permanently remove the products from the distribution channels - by which the defendant was ordered to take the products back or to have them destroyed by the respective owner.

35 2. The Court of Appeal was also correct in considering the plaintiff's cross-appeal admissible.

36 a) As the Court of Appeal correctly pointed out, the claim asserted at second instance goes beyond the subject matter of the action at first instance. The plaintiff, who had not challenged the first-instance judgment, was only allowed to assert the extension of the claim contained therein within the framework of a permissible cross-appeal. The admissibility of this appeal must also be examined ex officio in the appeal instance (Federal Court of Justice, judgment of 7 May 2015 - VII ZR 145/12, NJW 2015, 2812, para. 41).

37 b) As a result, the Court of Appeal correctly considered it harmless that the cross-appeal was not filed and substantiated within the deadline set by the presiding judge of the Court of Appeal for responding to the statement of grounds for appeal.

38 Pursuant to Sec. 524(2) sentence 2 Code of Civil Procedure, the notice of cross-appeal must be filed within the time limit set for the respondent to respond to the notice of appeal. However, according to the established case law of the Federal Court of Justice, the running of this period only begins if the court has issued the instruction prescribed in Sec. 521(2) sentence 2 and Sec. 277(2) Code of Civil Procedure (Federal Court of Justice, order of 23 September 2008 - VIII ZR 85/08, NJW 2009, 515 para. 4; judgment of 20 January 2011 - I ZR 10/09, GRUR 2011, 831 = WRP 2011, 1174 marginal no. 44 BCC; judgment of 9 June 2011 - I ZR 41/10, GRUR 2012, 180 marginal no. 28 - Werbegeschenke; judgment of 22 January 2015 - I ZR 127/13, NJW 2015, 1608 marginal no. 18; judgment of 7 May 2015 - VII ZR 145/12, NJW 2015, 2812 marginal no. 41).

39 As the Court of Appeal correctly decided in the result, this requirement is not met in the case in dispute.

40 c) However, contrary to the statements in the contested decision, instruction on the consequences of missing the deadline for filing the cross-appeal is not required (likewise Higher Regional Court of Düsseldorf, judgment of 22 December 2016 15 U 31/14, juris, marginal no. 66; Wulf in BeckOK Code of Civil Procedure, Edition 24, Sec. 524, marginal no. 18; for the similar, but not completely identical legal situation at the labor courts, see Federal Labor Court, judgment of 24 May 2012 2 AZR 124/11, NZA 2012, 1223, marginal no. 18).

41 aa Sec. 521(2) sentence 2 and Sec. 277(2) Code of Civil Procedure merely provide for the obligation to point out the compulsory representation by a lawyer applicable to the appeal and the consequences of missing the set deadline. Pursuant to Sec. 530 Code of Civil Procedure, these consequences consist in the fact that any means of attack and defense raised after the expiry of the time limit are subject to preclusion in accordance with Sec. 296(1) and (4) Code of Civil Procedure.

42 The loss of the possibility to join the appeal, on the other hand, is not a consequence of the failure to observe the time limit for filing a response to the appeal. Pursuant to Sec. 524(2) sentence 2 Code of Civil Procedure, a notice of cross-appeal must be filed within the same period as the notice of appeal. However, the admissibility of a timely declared cross-appeal does not depend on whether a response to the appeal was also filed within the deadline. Therefore, no obligation to provide information on the possibility of a statement of grounds and the relevant time limit or on the consequences of missing this time limit can be inferred from Sec. 521(2) sentence 2 and Sec. 277(2) Code of Civil Procedure.

43 bb) No further-reaching obligations arise from Sec. 524 Code of Civil Procedure.

44 Sec. 524(2) Code of Civil Procedure does not provide for instruction.

45 Pursuant to Sec. 524(3) sentence 2 Code of Civil Procedure, Sec. 521 Code of Civil Procedure, among other things, is applicable mutatis mutandis to

a cross-appeal. It follows that the presiding judge or the court may set a time limit for the appellant to respond to the cross-appeal and in doing so must also provide the instructions prescribed in Sec. 277(2) Code of Civil Procedure. This is not the issue in the constellation of the dispute.

46 cc) A further-reaching duty to instruct also does not result from Sec. 232 Code of Civil Procedure.

47 Pursuant to Sec. 232 Code of Civil Procedure, instructions must be given on legal remedies that are admissible and on objections, oppositions or reminders. The cross-appeal is not an appeal, but only an application within an appeal filed by the opponent (see only Federal Court of Justice, judgment of 14 May 1998 - III ZR 182/97, BGHZ 139, 12, 13). It is also not one of the other legal remedies about which instruction must be given under Sec. 232 Code of Civil Procedure. An analogous application of the provision is out of the question because there is no discernible gap in the provision.

48 d) The instruction given in the case in dispute was nevertheless inadequate because it only referred to the preclusive effect under Sec. 530 and Sec. 296(1) and (4) Code of Civil Procedure, but not to the obligation to be represented by a lawyer.

49 A reference to the obligation to be represented is also required in the second instance. If it is not provided, the time limit for the statement of defense and thus the time limit for a cross-appeal does not begin to run (Federal Court of Justice, judgment of 22 January 2015 - I ZR 127/13, NJW 2015, 1608 para. 19).

50 Whether the instruction was also insufficient because a mere reference to the legal consequences provided for in Sec. 296(1) and (4) Code of Civil Procedure or the repetition of the wording of the law is not sufficient without further ado (cf. Federal Court of Justice, judgment of 12 January 1983 - IVa ZR 135/81, BGHZ 86, 218, 226; judgment of 11 July 1985 - I ZR 145/83, NJW 1986, 133; judgment of 16 May 1991 - III ZR 82/90, NJW 1991, 2773, 2774), does not require a decision against this background.

51 3. Claims of the plaintiff with regard to the supply of customers

abroad cannot be denied on the basis of the state of facts and of the dispute to date.

52 a) According to the case law of the Federal Court of Justice, the party who enables a third party to use the protected subject matter by his own conduct in breach of duty shall also be liable for a patent infringement. This applies not only in the case of intentional participation in infringing acts by third parties, but also if such infringing acts are enabled or promoted by a negligent breach of duty (Federal Court of Justice, judgment of 17 September 2009 - Xa ZR 2/08, BGHZ 182, 245 = GRUR 2009, 1142 marginal no. 34 - MP3-Player-Import). However, the attribution of contributory negligence requires additional justification in the case of non-intentional actions. As a rule, it consists in the violation of a legal obligation, which in any case also serves to protect the violated absolute right and if the contribution to causation had been observed, it would not have occurred or would at least have been recognizable as a prohibited contribution of the actor to the unlawful act of a third party, which therefore had to be refrained from (BGHZ 182, 245 = GRUR 2009, 1142 marginal no. 36 - MP3-Player-Import).

53 Whether and to what extent there is a legal obligation to prevent an infringement of an intellectual property right is determined in each individual case by weighing up all the interests involved and relevant legal assessments. Of decisive importance is whether and to what extent the party against whom the claim is asserted can be expected to take action under the circumstances of the case. There is an interaction between the need for protection of the injured party and the reasonableness of the duties of examination and action to be observed by third parties: The more worthy of protection the injured party is, the more consideration for his interests can be expected of the third party. The lower the need for protection, the more critical it is to examine whether the third party can be expected to detect infringements of property rights and, if necessary, to stop or prevent them (BGHZ 182, 245 = GRUR 2009, 1142 marginal no. 43 - MP3-Player-Import).

54 For a freight forwarder or carrier, the Federal Court of Justice has denied a general duty to check the transported goods for infringement of third-party property rights (BGHZ 182, 245 = GRUR 2009, 1142 marginal no. 41 MP3-

Player-Import). However, if there are concrete indications of an infringement of third-party property rights in an individual case, the forwarder or carrier must take reasonable measures to clarify the suspicion. If the clarification reveals that an infringement of property rights has occurred, he may not continue to cooperate in the objectively unlawful act of the third party (BGHZ 182, 245 = GRUR 2009, 1142 marginal no. 45 - MP3-Player-Import).

55 b) These principles also apply to participation abroad in a patent infringement committed in Germany.

56 According to Art. 8(1) of Regulation (EC) No. 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations (OJ EU L 199, p. 40 - Rome II), the law applicable to non-contractual obligations arising from an infringement of intellectual property rights shall be the law of the country for which protection is claimed. In the case in dispute, this is the law of the Federal Republic of Germany.

57 According to the case law of the Federal Court of Justice, a company based abroad that supplies products to a customer also based abroad is involved in an act of use in Germany if it knows that the customer will supply the products on to Germany (Federal Court of Justice, judgment of 3 February 2015 - X ZR 69/13, BGHZ 204, 114 = GRUR 2015, 467 marginal no. 26 - Audiosignalcodierung). The same applies in the case of negligent participation (Federal Court of Justice, order of 26 February 2002 - X ZR 36/01, GRUR 2002, 599 - Funkuhr I).

58 In cases of this kind, as a rule, the jurisdiction of Art. 7 No. 3 of Regulation (EU) No. 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (OJ EU L 351 p. 1 - Brussels Ia) is also given. This exists - in contrast to the jurisdiction of Art. 93(5) Community Trademark Regulation - already if a person domiciled in another Member State is alleged to have committed an act there which has caused or threatens to cause damage in the area of jurisdiction of the court seized (ECJ, judgment of 5 June 2014 - C-360/12, GRUR 2014, 806 marginal no. 53 et seq. - Coty; Federal Court of Justice, judgment of 27 November 2014 - I ZR 1/11, GRUR

2015, 689 marginal no. 30 et seq. Parfumflakon III).

59 c) Against this background, the reasoning with which the Court of Appeal denied the breach of a duty to protect by the defendant in the case in dispute is not sustainable.

60 aa) In principle, the Court of Appeal correctly assumed that even a supplier of a product protected by a patent in Germany who is domiciled abroad and supplies a customer who is also domiciled abroad is not automatically obliged to check or monitor the further use of the supplied goods by the customer.

61 The customer of a product is basically responsible for using it only in a legally permissible manner. By making a delivery abroad which is unobjectionable under patent law, the supplier has not without further ado realized an act which creates a special risk situation for the rights of the patent holder. Therefore, the supply in itself does not create any special obligations to protect in favor of the person entitled under the patent.

62 bb) Contrary to the opinion of the Court of Appeal, the supplier's duty to protect cannot only exist if the supplier knows that the customer will supply the delivered goods to the domestic market or offer them there. On the contrary, the supplier is already obliged to check the facts if there are concrete indications for him which make such actions appear likely.

63 However, the merely abstract possibility that the customer could resell the delivered goods in Germany or offer them there is not sufficient for this purpose. Since the supplier is in principle not obliged to check or monitor the conduct of his customers, he cannot be expected to carry out a check simply because a patent-relevant use appears possible, for example because the customer has business relations in Germany or because he has already supplied similar products to Germany or offered them there.

64 Against this background, concrete indications for a further delivery to the home country may often only be given in the practical result if the supplier has become aware of a further delivery that has actually taken place or is concretely imminent. Depending on the circumstances of the individual case, however,

sufficiently concrete indications may already exist on the basis of other circumstances - for example, because the purchased quantity is so large that it can hardly be distributed only on markets free of property rights, or because the purchasing behavior correlates conspicuously with a perceptible and potentially infringing activity of the customer on the domestic market. If such concrete indications have become recognizably apparent, the supplier may no longer rely on the fact that his customer will refrain from patent infringing activities. Rather, he has reason to ask the customer about deliveries and offers to the domestic market and to point out the possibility of a patent infringement therein as a precaution. If there is no plausible answer to such an inquiry, the supplier must seriously reckon with the possibility that he is participating - even if without positive knowledge - in a third party patent infringement. In this situation, he violates a duty of conduct serving the protection of the third party's patent by continuing his deliveries unchanged, even if he subjectively assumes that the customer's conduct complies with the law.

65 cc) In the case in dispute, concrete indications for a further delivery of products supplied abroad to the German market result from the plaintiff's submission which is to form the basis for the assessment under the law of review.

66 (1) Despite its differing legal approach, however, the Court of Appeal was correct in considering the fact that the defendant's customer supplies automobiles and tire repair kits to Germany to be insufficient.

67 An activity of the customer on the relevant domestic market may justify the abstract possibility that the customer also supplies or offers the products in question there. However, for the reasons stated above, such a possibility cannot yet give rise to a duty of verification for the supplier.

68 (2) The same applies to the fact that the challenged repair kits also contained instructions in German.

69 Depending on the circumstances of the case, the fact that a product is prepared in a special way for a certain market by enclosed operating instructions or the like may, however, speak in favor of a distribution activity on this market.

In the case in dispute, however, the Court of Appeal was right to regard this circumstance as insufficient, in any case, because operating instructions in German were already obvious on the basis of the defendant's own sales activities in Germany as determined by the Court of Appeal. The delivery of the same products to a customer in Italy may also have enabled the latter to distribute them in Germany. However, this is not sufficient to substantiate concrete evidence of such activity.

70 (3) The fact that the defendant, as the Court of Appeal assumed in favor of the plaintiff, considered deliveries or offers of its customer on the German market to be possible is also not sufficient to establish a duty to verify.

71 In the absence of concrete indications, the defendant could at best arrive at such an assessment on the basis of the abstract possibility of a supply to the German market. Such a possibility cannot lead to a duty to verify even if the supplier is aware of it and, in the absence of more detailed knowledge, cannot safely rule out that its customer will make use of it.

72 (4) However, the plaintiff's arguments at second instance, as pointed out by the appeal, provide concrete indications of a considerable discrepancy between the number of repair kits supplied by the defendant to Germany and the total number of repair kits originating from the defendant and entering the German market.

73 In the second instance, the plaintiff submitted that the defendant had stated in proceedings for enforcement of the first-instance judgment that it had supplied challenged embodiments to Germany only to a minor extent and otherwise only to third parties abroad. At the same time, it referred to the defendant's submission in the first instance that enforcement of an injunction, even for a short time, would have serious economic consequences for it because it supplies numerous automobile manufacturers with the devices in dispute and would therefore face considerable consequences if it were unable to supply the German market, even temporarily. If both statements are correct, this leads to the conclusion that third parties, which the defendant has supplied abroad sell the challenged products to a considerable extent on the German market and that the defendant is not unaware of the economic consequences

of a cease-and-desist order which it is claiming. Consequently, the existence of concrete indications for a further delivery to Germany could hardly be denied.

74 III. The legal dispute is not ripe for a final decision.

75 1. In the absence of factual findings by the Court of Appeal in this regard, the Senate is unable to assess whether the defendant modified or supplemented the submission taken up by the plaintiff. Moreover, in view of the divergent legal approach of the Court of Appeal, the defendant has so far had no occasion to comment in more detail on the question of the extent to which concrete indications of onward delivery to Germany arise from its submissions.

76 In the reopened appeal proceedings, the Court of Appeal will therefore have to give the defendant the opportunity to make additional submissions and then decide whether it was able to identify concrete indications that its customers were continuing to supply the German market.

77 2. If the Court of Appeal answers this question in the affirmative, it will also have to examine whether there has already been an act of infringement by customers of the defendant domiciled abroad or whether there is at least a risk of first infringement within the meaning of Sec. 139(1) sentence 2 Patent Act.

78 A person whose own actions do not in themselves constitute a patent infringement is also liable for enabling or promoting another person's patent infringement in breach of duty and culpably. Such acts can only give rise to claims under Sec. 139 ff. Patent Act only if the third party has infringed the patent or if there is at least a risk of first infringement (Federal Court of Justice, judgment of 30 April 1964 Ia ZR 224/63, GRUR 1964, 496, 497 - Formsand II). This is only the case if the actions of the supplier meet the criteria of contributory patent infringement within the meaning of Sec. 10 Patent Act, which is designed as a separate element of risk and therefore does not require a direct patent infringement that has already been committed or is imminent (Federal Court of Justice, judgment of 3 June 2004 - X ZR 82/03, BGHZ 159, 221, 231 f. = GRUR 2004, 845, 848 - Drehzahlmittlung; judgment of 7 June 2005 - X ZR 247/02, GRUR 2005, 848, 852 - Antriebsscheibenaufzug; judgment of 13 June 2006 - X

ZR 153/03, BGHZ 168, 124 = GRUR 2006, 839 marginal no. 23 - Deckenheizung).

79 Indirect patent infringement within the meaning of Sec. 10 Patent Act cannot be inferred from the plaintiff's arguments in the dispute. It can therefore only be entitled to claims due to deliveries to customers abroad if such deliveries have led to a patent infringement or give rise to the risk of a first infringement. Such a risk may also arise in individual cases from the circumstances which justify the supplier's duty of examination. Whether it is to be affirmed requires the assessment by the court of facts.

80 3. The Court of Appeal will also have to take into account that a culpable promotion or facilitation of another's patent infringement in breach of duty does not automatically give rise to an unrestricted claim for an injunction to cease and desist from acts which in themselves do not constitute a patent infringement.

81 Similar to the case of an indirect patent infringement by supplying means that can also be used without a patent (see Federal Court of Justice, judgment of 13 June 2006 X ZR 153/03, BGHZ 168, 124 = GRUR 2006, 839 marginal no. 27 - Deckenheizung), it must be decided on the basis of a consideration of the facts in the individual case which measures are reasonable for the obligated party in order to avoid patent infringements by its customers (Federal Court of Justice, judgment of 8 November 1960 I ZR 67/59, GRUR 1961, 627, 628 - Metallspritzverfahren; judgment of 30 April 1964 - Ia ZR 224/63, GRUR 1964, 496, 497 - Formsand II). For the assessment of this question, it may also be relevant to what extent infringing acts have already been committed by the customers, what level of knowledge the customers have, how high the probability is that they consciously expose themselves to the risk of a claim for patent infringement by further delivery of the products purchased from the defendant, and what other legal possibilities the entitled party has to take action against the infringing acts of the customer.

82 If necessary, the Court of Appeal will have to give the parties the opportunity to make additional submissions on this point and, if necessary, to work towards the filing of relevant pleadings.

83 4. Insofar as acts of infringement have already occurred, the Court of Appeal will also have to determine the defendant's liability for damages and order it to render accounts for deliveries to those customers who have committed these acts of infringement.

84 a) Just as in the case of an indirect patent infringement (see Federal Court of Justice, judgment of 9 January 2007 - X ZR 173/02, BGHZ 170, 338 = GRUR 2007, 679 marginal no. 46 - Haubenstretchautomat), the claim for invoicing is not limited to those deliveries which have led to a patent infringement by the customer. If a customer has committed at least one act of infringement, the defendant is in principle obliged to provide information and an invoice for all deliveries to the customer so that the plaintiff can be certain whether the delivery has actually led to use of the invention in Germany and thus to damage for which compensation is due.

85 b) This is not contradicted by the fact that deliveries which have not led to a further delivery in Germany do not constitute a patent infringement.

86 The duty to provide information and to render accounts is not limited to patent infringing acts. Rather, its scope is determined by what information the entitled party needs to calculate the damage it has suffered and what information the infringer can provide without unreasonable burden.

87 In the constellation to be assessed in the dispute, this also includes information on non-infringing deliveries. Similar to the case of contributory patent infringement, the entitled party in this situation will only be able to calculate the damage caused to it by patent infringements made possible by this on the basis of a complete overview of all deliveries to the customers concerned. In this situation, the supplier who has made the patent infringements possible by supplying certain customers in breach of duty can regularly be expected to give an account of the entire scope of the deliveries to these customers.

Meier-Beck

Gröning

Grabinski

Bacher

Kober-Dehm

Previous instances:

Regional Court of Mannheim, judgment of 10 December 2013 – 2 O 180/12 –

Higher Regional Court of Karlsruhe, judgment of 07 October 2015 – 6 U 7/14 –