

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2020-06-09
Docket Number / Aktenzeichen:	X ZR 142/18
Name of Decision / Name der Entscheidung:	Penetrometer



Arbeitskreis
Patentgerichtswesen
in Deutschland e.V.



FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

JUDGMENT

X ZR 142/18

Pronounced on:
9 June 2020
Anderer
Judicial Secretary as
clerk of the court
registry

in the matter

Penetrometer

Civil Code Sec. 745(3) sentence 2

If it is to be decided in a community of inventors by fractional shares with a majority of votes that a third party is to be permitted to use the invention against payment, the agreement concluded with the third party must be structured in such a way that shareholders who have not agreed to the permission remain entitled to their due share of the benefits.

Federal Court of Justice, judgment of 9 June 2020 - X ZR 142/18 –
Higher Regional Court of Düsseldorf
Regional Court of Düsseldorf

ECLI:DE:BGH:2020:090620UXZR142.18.0

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 9 June 2020, attended by the presiding judge Dr. Bacher, the judges Hoffmann and Dr. Deichfuß and the judges Dr. Kober-Dehm and Dr. Rombach

ruled that:

On the appeals of both parties, the judgment of the 15th Civil Senate of the Düsseldorf Higher Regional Court of 26 July 2018 is set aside to the extent set out below, with the further appeals dismissed.

Contrary to the pronouncement of the Court of Appeal, all benefits are to be paid to the plaintiff alone.

It is further determined that the defendant is obligated to pay compensation in money to the plaintiff for the use of the patent family penetrometer in the territory of the Federal Republic of Germany as of 16 October 2017, for use benefits exceeding the defendant's share.

Of the costs of the appeal instances, the defendant shall bear nine tenths and the plaintiff one tenth.

By operation of law

Facts of the case:

1 From 1987 to 2014, the plaintiff was employed by the defendant or its legal predecessors as a design engineer. (hereinafter: defendant) as a design engineer. During time, together with the witness H. (H.), also employed by the defendant, he developed a witness H. (H.), who was also employed by the defendant, developed a device and a method for the automated flash point testing as well as a device (penetrometer) and a method for the a method for determining the degree of hardness of semi-solid materials. According to the plaintiff's allegations, its share of the inventions is 50%, whereas the defendant states it to be 20% and 30%, respectively.

2 The defendant is active in the field of development, production and distribution of measuring and testing devices, in particular for the mineral oil industry. On 28 February 1996 and 27 February 1997, respectively, it filed two patent applications relating to the inventions for flash point testing, from which one German and one European patent have resulted. On 17 October 2006, the defendant filed a German patent application and on 10 October 2007, an international patent application concerning the penetrometer and the hardness test, which resulted in a German patent, two European patents and a utility model. For the inventions mentioned, the defendant has obtained further applications and property rights in China, the United States of America and the Russian Federation. The owner of the property rights in each case is the defendant, and the plaintiff and the witness H. are named as inventors.

3 The defendant produces and sells devices according to the invention.

4 The plaintiff has filed a claim against the defendant by way of a step-by-step action on the first step for information and accounting of acts of use, for a declaration of the obligation to pay compensation and damages to him together with the witness H. as well as for reimbursement of his pre-judicial legal costs.

5 The Regional Court granted the action by way of partial judgment. The defendant has appealed. In the appeal proceedings, it submitted an agreement with witness H. dated 10 July 2017, which, among other things,

provides for a transfer of witness H.'s shares in the inventions and a retroactive permission of the defendant's acts of use. The plaintiff has contested the validity of this agreement. In the event of its effectiveness, he alternatively sought information and an accounting for himself alone (auxiliary claim to I) as well as a declaration that the defendant is obligated to pay him appropriate residual compensation for acts in the period from 24 April 2008, to 2 July 2008 (auxiliary claim to II 1), to pay him damages for acts up to 9 July 2017 (auxiliary claim to II 2), and to compensate him in money for the use of the penetrometer invention from 16 October 2017, for advantages of use exceeding his share (auxiliary claim to II 3).

- 6 The Court of Appeal - rejecting the defendant's further appeal and rejecting an auxiliary claim of the plaintiff - limited the order to provide information and an accounting of prime costs and profit as well as the determination of the obligation to pay damages to acts until 9 July 2017. Both parties appeal against this decision in the appeal allowed by the Court of Appeal.

Grounds of the decision:

7 The defendant's appeal is essentially unfounded, while the plaintiff's
appeal is for the most part well-founded.

8 A. The Court of Appeal gave the following main reasons for its
decision:

9 The service inventions made by the plaintiff jointly with the witness H
had become free because the defendant had not validly claimed them. It was
only with the agreement of 10 July 2017 that the defendant had acquired the
co-inventor shares of witness H. An effective earlier transfer by legal
transaction could not be established.

10 The plaintiff, together with witness H, was entitled to claims for
damages under Sec. 823(1) Civil Code for domestic acts of use committed by
the defendant up to 9 July 2017. The unlawful and culpable withholding of
corresponding property rights infringes the plaintiff's right to the invention and
gives rise to the obligation to pay damages and, in relation thereto, also to
provide information and render accounts.

11 In the period until 9 July 2017, the defendant was not entitled to use the
inventions. Until that time, the shares of witness H had not been transferred to
it. There was also no effective authorization of the use of the inventions by the
witness for the aforementioned period. The relationship of the two co-inventors
with regard to the inventions was governed by the rules of the community of
fractional shares. The permission of use was an administrative measure. Even
if majority shares of witness H were assumed, a conceivable, implied majority
resolution on the said measures was invalid because the plaintiff had not been
heard beforehand. The defendant had to pay damages for the use of the
subject matter of the applications and property rights withheld from the two co-
inventors. To the extent that the defendant had used the subject matter of the
withheld applications, the claim for damages for use was limited to reasonable
compensation. Insofar as a claim for damages existed, the plaintiff, together
with witness H, was also entitled to claims for information and accounting.

12 For the period from 10 July 2017, on the other hand, the action was to

be dismissed because the defendant was entitled to use the inventions as a shareholder as a result of the effective transfer of the shares pursuant to Sec. 743(2) Civil Code.

13 The auxiliary claims for a declaration of the defendant's obligation to pay compensation in money for the period from 16 October 2017, for advantages of use that exceeded its share were to be treated as cross-appeals. It was an amendment of the action. There was no case of Sec. 264 No. 2 or 3 Code of Civil Procedure. Even if the new claims were still directed at the determination of the obligation to pay money, the plaintiff based them on a different fact of life. The defendant's acts of use since 10 July 2017 do not constitute unlawful, but lawful conduct. Accordingly, the cross-appeal had to be dismissed as inadmissible because it had been filed outside the relevant time limit of Sec. 524(2) sentence 2 Code of Civil Procedure. The circumstance that the agreement of 10 July 2017, had only come into existence after the expiry of this deadline did not justify an exception, even taking into account the constitutional requirement of procedural equality of arms. An application for restitutio in integrum by analogous application of Secs. 233 et seqq. Code of Civil Procedure fails in any case due to the expiry of the relevant one-month period of Sec. 234(1) sentence 2 Code of Civil Procedure.

14 B. This assessment does not withstand the attacks of the revision in all respects. withstand.

15 I. The defendant's appeal is only successful to a small extent.

16 The Court of Appeal correctly decided that the plaintiff, together with the witness H., was entitled to claims against the defendant for damages as well as information and invoicing for the period up to 9 July 2017. However, due to the agreement reached on 10 July 2017, witness H.'s co-entitlement to these claims ceased to exist.

17 1. The plaintiff, as co-inventor, was entitled to the respective patent together with witness H. pursuant to Sec. 6 sentence 2 Patent Act, which is protected as other right under Sec. 823(1) Civil Code (Federal Court of

Justice, judgment of 27 September 2016 - X ZR 163/12, GRUR 2016, 1257 marginal no. 24 - Beschichtungsverfahren).

18 a) The Court of Appeal correctly and unobjected to by the appeal denied an effective claim of the service inventions by the defendant pursuant to Sec. 6 Code of Employee Inventions (old version) as well as a legal transfer of the co-inventor shares of witness H before 10 July 2017.

19 b) Without error of law and unchallenged by the appeal, the Court of Appeal further based its decision on the fact that claims for damages of the co-inventors under Sec. 823(1) Civil Code can be considered if a third party unjustifiably files an application for an industrial property right relating to the invention and deprives the inventors of the application and the industrial property right obtained. The damage to be compensated also includes the damage suffered by the entitled parties due to the fact that the third party uses the subject matter of the invention and they are unable to take action against this due to the withheld formal legal position (thus for the case of a contractual obligation to transfer the property right to the inventor Federal Court of Justice, judgment of 27 November 1969 - X ZR 89/65, juris, marginal no. 78 - Allzwecklandmaschinen [insofar not printed in GRUR 1970, 296]; Higher Regional Court of Düsseldorf Düsseldorf, Mitt. 2004, 418).

20 By applying for a patent or utility model for the inventions, withholding the property rights obtained from the inventors and using the inventions, the defendant has made itself liable to the plaintiff and witness H for damages under Sec. 823(1) Civil Code. This gave rise to claims for damages and information as well as accounting to the extent awarded by the Court of Appeal.

21 c) In terms of time, the claim for damages and the accessory claim for information and the accessory claim for information and rendering of accounts are each limited to actions expiry of the protective rights granted with effect for the Federal Republic of Germany for the Germany for the inventions in question. According to the findings According to the findings of the Court of Appeal, the protection for the device and the the flash point testing method ended on 27 February 2017, when the maximum period of maximum term of

protection. The protection for the method for determining the degree of hardness ended on 30 April 2013.

22 d) If several persons are involved in an invention, they are entitled to the right to the invention in fractional shares in the absence of separate agreements (Federal Court of Justice, GRUR 2016, 1257 marginal no. 17 - Beschichtungsverfahren). This also applies to claims for damages due to infringement of these rights as well as to the auxiliary claims for information and accounting.

23 This does not apply insofar as the damages are not intended to compensate for a disadvantage in respect of the joint right to the invention, but for a loss incurred by only one of the partners. In this respect there is no joint responsibility for receipt. This is the case here with regard to the claim of the plaintiff for reimbursement of his pre-court legal attorney's fees.

24 Insofar as the co-inventors are jointly entitled to the claims, this does not prevent a joint inventor from asserting the claim alone, insofar as he demands payment to both partners (Federal Court of Justice, judgment of 4 April 2006 - X ZR 2006 - X ZR 155/03, BGHZ 167, 118 marginal no. 10 - Liability label).

25 2. The appeal claims that the witness H. effectively allowed the defendant to use the joint inventions also for the past by the agreement concluded on 10 July 2017. Thus, a right of use under the law of obligations of the defendant had been established retroactively.

26 This objection is unsuccessful. A resolution adopted solely by the witness H. to permit the defendant to use the joint inventions would in any case be ineffective because it inadmissibly impairs the rights of the plaintiff.

27 It can be left open whether an individual shareholder is entitled to permit third parties to use the invention on the basis of the right of use to which he is entitled under Sec. 743(2) Civil Code or on the basis of a majority resolution adopted under Sec.745(1) Civil Code. Such a permission is in any case only effective if it is within the limits set by Sec. 743(2) and Sec. 745 Civil Code. by Sec. 743(2) and Sec. 745 Civil Code. This requirement is lacking in the case in

dispute.

28 Pursuant to Sec. 745(3) sentence 2 Civil Code, the right of the individual shareholder to a fraction of the benefits corresponding to his share may not be impaired by an administrative decision without his consent. Incompatible with this provision is a majority decision which distributes the benefits of use derived from the common property, such as the remuneration for its use, to the detriment of the minority (Staudinger/Eickelberg, Civil Code, 2015, Sec. 745 marginal no. 13 f.).

29 These principles also apply to the joint use of a patent. It is true that the possibilities of use of an individual partner are not restricted without further ado by the fact that other partners or with their consent third parties also use the invention. However, a consideration owed or paid for the permission to use belongs to the fruits pursuant to Sec. 99(3) Civil Code and thus to the uses of the joint right pursuant to Sec. 100 Civil Code. Pursuant to Sec. 743(1) Civil Code, each partner is entitled to a fraction thereof corresponding to his share. Pursuant to Sec. 745(3) sentence 2 Civil Code, the right of a part-owner thereto cannot be impaired without the part-owner's consent.

30 Contrary to the opinion of the appeal, this prohibition does not only have the consequence that a partner who agrees or collects a payment for allowing a third party to use the property is obliged to compensate the other partner in the internal relationship. Rather, the agreement made with the third party must be structured in such a way that shareholders who have not consented to the permission the third party, access to their due share of the benefits remains possible. share of the benefits to which they are entitled. This can be done in particular by that the remuneration is to be paid to the community, so that each partner has a joint is entitled to a co-entitlement to the proceeds.

31 The third party's reliance on the validity of an agreement concluded with individual shareholders agreement concluded with individual partners is not worthy of protection if it was obvious to him that his it was obvious to him that his contractual partner was not the sole beneficiary. is not the sole beneficiary.

32 3. However, the Court of Appeal erred in law in basing its decision

on the fact that the plaintiff and the witness H. continue to be jointly entitled to the claims for damages, provision of information and rendering of accounts for the period until 9 July 2017.

33 However, the transfer of the co-inventor shares and a retroactive authorization of use do not in themselves have any effect with regard to claims for infringement of the inventor's rights that have already arisen. Such claims could also not be extinguished by payments made by the defendant to the witness H., because only a payment to both partners together is suitable for fulfillment. Witness H., however, could also assign his shares in the accrued claims to the defendant.

34 It is true that such an assignment is not expressly provided for in the wording of the agreement of 10 July 2017. However, it is clear from the content of the agreement and its meaning and purpose that the agreement concerns all rights and claims to which the witness H. was entitled as co-inventor against the defendant.

35 According to the preamble of the agreement, it is intended to constitute a final contractual regulation on the nature and amount of the remuneration of witness H., on any possible legal ground. For this purpose, the witness H. in Art. II 1 of the agreement "assigned his rights to the inventions". According to Art. II 3, the compensation provided for in the agreement compensates all present and future payment claims of the witness H. against the Defendant, in particular also for the worldwide unrestricted use of the inventions.

36 It would not be compatible with this comprehensive provision if Witness H., together with the plaintiff, could continue to assert claims for information, accounting and damages against the defendant. The agreement of 10 July 2017, must therefore be interpreted beyond its wording to the effect that the witness H. not only assigned his rights "to" the inventions, but also his share in claims for unauthorized use of the inventions that have already arisen.

37 II The plaintiff's appeal is for the most part successful.

38 1. Contrary to the opinion of the appeal, however, the Court of Appeal correctly decided that the defendant effectively acquired a co-

entitlement to the inventions through the agreement of 10 July 2017.

39 a) The objection of the appeal that the Court of Appeal misjudged the burden of proof with regard to the effectiveness of this agreement is not well-founded.

40 The law assumes the transferability of the share in a fractional community. Pursuant to Sec. 747 sentence 1 Civil Code, each partner may dispose of his share. Whoever invokes a transfer of such a share by legal transaction therefore only needs to show that the participants have made declarations which show the conclusion of an agreement on the transfer of the share. On the other hand, the person who invokes the invalidity of the transfer must explain any reasons for this.

41 The Court of Appeal rightly assumed that the plaintiff had not shown such grounds for invalidity. In particular, an invalidity of the transfer of the shares in the joint inventions does not result from the fact that the agreement reflects the legal position of the defendant that it had validly claimed the service inventions of the plaintiff and the witness H. and that the latter had already transferred the shares in the inventions to it at an earlier point in time.

42 b) Contrary to the opinion of the appeal, the Court of Appeal did not fail to examine the authenticity of the document in which the agreement of 10 July 2017 is recorded.

43 Pursuant to Sec. 439(3) Code of Civil Procedure, the private document submitted by a party is to be considered genuine if the opponent does not doubt its authenticity, either expressly or by implication. The appeal does not show that the plaintiff did this in the appeal proceedings.

44 c) The Senate examined the procedural objections raised by the appeal but did not consider them to be relevant. No reasons are given in this respect (Sec. 564(1) Code of Civil Procedure).

45 2. The Court of Appeal was wrong to regard the auxiliary request under II 3 as inadmissible insofar as it relates to acts of use in Germany.

46 a) In the starting point, the Court of Appeal correctly took as a basis

that a plaintiff who has prevailed at first instance must join the appeal of the opposing party if he does not want to limit himself to defending the appeal but wants to expand the action or place it on a new cause of action (Federal Court of Justice, judgment of 22 January 2015 - I ZR 127/13, NJW 2015, 1608 marginal no. 12). This also applies to the subsequent filing of an auxiliary claim, which is to be regarded as an objective accumulation of actions to which the provisions of Sec. 533, 263, 264 Code of Civil Procedure are to be applied.

47 Pursuant to Sec. 524(2) sentence 2 Code of Civil Procedure, a cross-appeal is in principle only admissible until the expiry of the time limit for the response to the appeal. This also applies to an extension of the action within the meaning of Sec. 264 no. 2 German Code of Civil Procedure (Federal Court of Justice, judgment of 13 September 2011 - X ZR 69/10, GRUR 2012, 45 marginal no. 56 - Diglycidverbindung). After expiry of the time limit for the statement of grounds for appeal, a cross-appeal is thereafter only possible if the new application without change of the cause of action constitutes a limitation of the action within the meaning of Sec. 264 No. 2 Code of Civil Procedure or is directed at a surrogate within the meaning of Sec. 264 No. 3 Code of Civil Procedure.

48 b) Accordingly, the Court of Appeal was not allowed to reject the auxiliary request under II 3 as inadmissible insofar as it relates to acts of use in Germany.

49 The auxiliary claim to II 3 deviates in three respects from the original claims for acts of use by the defendant in relation to the penetrometer: It is no longer directed to performance to the plaintiff and the witness H. jointly, but to performance to the plaintiff. Furthermore, it no longer relates to an obligation to pay damages, but to an obligation to compensate in money for benefits of use that exceed the defendant's share. Finally, it no longer relates only to acts in the territory of the Federal Republic of Germany, but to the use of the entire patent family, which also includes foreign property rights.

50 aa) Insofar as the plaintiff seeks performance per se, this amendment is subject to Sec. 264 No. 3 Code of Civil Procedure.

51 (1) According to this provision, the original claim may be replaced by another claim in order to take into account a subsequent amendment. Such a constellation also exists if the plaintiff, as a partner in a fractional community consisting of two persons, demands performance from a third party for himself and the other partner, but the third party acquires the share of the other partner in the course of the legal dispute. In such a case, the payment to the plaintiff partner alone takes the place of the payment initially demanded to the two partners in community.

52 (2) Contrary to the opinion of the Court of Appeal, the auxiliary claims are not based on a new cause of action in this respect.

53 According to the established case law of the Federal Court of Justice, the subject matter of the dispute is determined by the claim in which the legal consequence claimed by the plaintiff is concretized and the facts of life (cause of action) from which the plaintiff derives the desired legal consequence. The facts of life in this sense include all facts which, when viewed naturally from the point of view of the parties, belong to the complex of facts put forward for decision by the party bringing the action. A different cause of action exists if the facts of life on which the application is based are substantially changed by the additional facts (Federal Court of Justice, order of 11 October 2006 - KZR 45/05, NJW 2007, 81 marginal no. 11 - Lesezirkel II).

54 The acquisition of the share of the witness H. in the invention community with regard to the penetrometer did not cause a change of the cause of action. The acquisition of the share has not changed the fact that the defendant is liable to pay damages to the plaintiff under Sec. 823(1) Civil Code for infringement of his right to the invention if it deprives him of a joint entitlement to the property rights in question.

55 According to the case law of the German Federal Court of Justice, not only a third party outside the inventive community, but also a co-owner of the invention is not authorized to file a patent application for the joint invention only in his own name (Federal Court of Justice, GRUR 2016, 1257 marginal no. 24 - Beschichtungsverfahren; judgment of 16 May 2017 - X ZR 85/14, GRUR 2017, 890 marginal no. 34 - Sektionaltor II). Such an application for property

rights by the co-owner solely for himself infringes the right to the invention protected by Sec. 823(1) Civil Code. The co-owner also acts unlawfully if he deprives the other co-owner of a co-entitlement to an acquired property right.

56 In any case, the plaintiff has also based his auxiliary requests on this plea. also on this plea. The auxiliary request under II 3 is directed to a compensation payment, as may also be owed in the case of authorized use by a co-inventor. can be owed. In support of this claim, however, the plaintiff did not merely refer to the use of the invention by the defendant. invention by the defendant, but also on the prior infringement of rights. infringement.

57 bb) The same applies insofar as the plaintiff now seeks monetary compensation instead of damages.

58 With this conversion, the plaintiff also takes into account the fact that the defendant is now a co-entitled party and that, in his opinion, he is therefore no longer entitled to damages. The conversion is thus also based in this respect on a change that occurred at a later date, which has resulted in the plaintiff being entitled to a different object instead of the object originally claimed.

59 cc) To the extent that the auxiliary request under II 3 also includes acts of use with regard to foreign property rights, the Court of Appeal was right to reject it as inadmissible.

60 (1) The extension of the claim to acts of use in other states for which a parallel property right exists constitutes an extension of the claim. In addition, the plaintiff has based his claim on a new fact of life. based. This amendment of the action was only possible in the context of a separate appeal or by way of annexation until the expiry of the time limit for the response to the appeal. the deadline for the response to the appeal.

61 (2) A different assessment is also not required from the point of view of procedural equality of arms.

62 The case law of the Federal Court of Justice has not yet decided the question of whether an exception to this time limit is to be permitted in special

cases in accordance with its purpose and taking into account the requirement of procedural equality of arms if the cross-appeal is a reaction to a change in circumstances that occurred after the conclusion of the oral proceedings at first instance or even after the expiry of the time limit for the response to the appeal (Federal Court of Justice, judgment of 7 May 2015 - VII ZR 145/12, NJW 2015, 2812, para. 33).

63 This question does not need to be decided here either, because the extension of the action to compensation for the use of the subject matter of foreign property rights was not prompted by the agreement of 10 July 2017.

64 (3) Since the claim is divisible in this respect, the auxiliary claim under II 3 is admissible in all other respects.

65 III. The legal dispute is ready for decision (Sec. 563(3) Code of Civil Procedure).

66 1. The transfer of joint entitlement to the defendant has the consequence that the plaintiff can no longer demand performance jointly for himself and for the witness H. The plaintiff's claim in the main claim is therefore inadmissible. Therefore, the action is unfounded in the main claim.

67 2. The claims for damages, information and rendering of accounts asserted with the alternative claim to I, II 1 and II 2 are well-founded.

68 a) All services owed are to be provided to the plaintiff alone.

69 aa) As has already been explained above, the witness H. has not paid his share of the claims asserted in the action to the defendant.

70 The Senate can interpret the agreement of 10 July 2017 itself in this respect. The court of appeal has already established the relevant facts for this. established. There are no indications that additional findings could be considered. could be considered are not apparent.

71 bb) The assignment means that the plaintiff can assert the claims alone. assert the claims alone.

72 It can be left open whether the assignment of a joint right to assert the

claims of claims against the defendant to the defendant led to a partial extinguishment or whether the extinguished or whether a legal community also arose between the plaintiff and the the plaintiff and the defendant. Even in the latter case the plaintiff is not limited to demanding performance for himself and the defendant jointly. to demand. Since the defendant has the information sought and is obliged to pay the information and is obligated to pay the requested damages, it must pay the plaintiff the it must grant the plaintiff the benefits to which he is entitled.

73 b) A claim for information and rendering of accounts for the period after 9 July 2017 is available to the plaintiff to the extent requested (i.e., without information on prime costs and profit) for the very reason that the Defendant is also entitled to for the above-mentioned reasons is also liable for damages for acts of use in this period. period is obliged to pay damages.

74 Contrary to the opinion of the Court of Appeal, the acquisition of the co-authorization does the defendant is no longer liable to pay damages to the plaintiff for the use of the no longer liable to pay damages to the plaintiff for the use of the inventions.

75 aa) The plaintiff bases his claims not only on the use of the invention, but on the unauthorized use of the invention by the defendant alone. defendant alone. The defendant would not have been authorized to do the latter even if it had been granted a joint right to the inventions from the beginning. from the beginning.

76 As explained above, even a co-inventor who, without authorization, for himself alone for the invention without authorization is also obliged to indemnify the other partners pursuant to Sec. 823(1) Civil Code. The damages resulting from the unjustified the unjustified sole registration of the property rights includes the obligation to compensate for all pecuniary disadvantages suffered by the other the other partner has suffered as a result of the application and the resulting formal sole the formal sole right resulting therefrom, and includes compensation for the advantages which the plaintiff benefits which the plaintiff has derived from the use of the subject matter of the applications (Federal Court of Justice, GRUR 2016, 1257 marginal no. 28 -

Beschichtungsverfahren).

77 bb) The principle that a person who has made use of the invention within the scope of Sec. 743(2) Civil Code, a pro rata compensation for advantages of use cannot be demanded from a co-owner using the invention (alone) as long as the co-owners have made neither an agreement nor a resolution in this respect and a claim existing in this respect pursuant to Sec. 745(2) Civil Code has not been asserted. is not opposed to this.

78 A co-owner can at most be referred to this limitation of his claims if he did not assert compensation claims with knowledge of the existence of a community or under circumstances equivalent to positive knowledge (Federal Court of Justice, GRUR 2016, 1257 marginal no. 29 - Beschichtungsverfahren). In the case in dispute, the plaintiff could not have had knowledge of a legal community between him and the defendant before 10 July 2017. At that time, it was apparent to the defendant that the plaintiff did not agree to use the invention without compensation.

79 3. The auxiliary request under II 3, in the version submitted for decision in the first instance, does not meet the requirements of Sec. 256(1) Code of Civil Procedure. In the alternative version, however, it is admissible and well-founded insofar as it relates to acts of use in Germany.

80 a) With the application filed in the first instance, the plaintiff seeks a declaration that the calculation of the compensation owed is to be based on the value of the entire object as the reference value, a license rate of 5% and a double personal share factor A in accordance with the Guidelines for the Remuneration of Employees' Inventions in the Private Sector of 20 July 1959.

81 This application is not directed to the determination of a legal relationship within the meaning of Sec. 256(1) Code of Civil Procedure, but to the decision of individual preliminary questions which arise in the calculation of the asserted claim for payment. Such an action is at most admissible if it is suitable for conclusively settling the parties' dispute about the existence and scope of the payment obligation. There is no evidence of this in the case in dispute.

82 b) With the alternative application, the plaintiff seeks a determination of the obligation to pay compensation without determining individual factors.

83 This application concerns a legal relationship within the meaning of Sec. 256(1) Code of Civil Procedure, in the determination of which the plaintiff has a legal interest.

84 The application is also well-founded. As already stated above, the plaintiff is entitled to damages for actions after 9 July 2017, which also includes a claim for compensation.

85 IV. The decision on costs is based on Sec. 97(1) and Sec. 92(1) Code of Civil Procedure.

Bacher

Hoffmann

Deichfuß

Kober-Dehm

Rombach

Previous instances:

Regional Court of Düsseldorf, judgment of 22 December 2016 – 4a I 105/14 –
Higher Regional Court of Düsseldorf, judgment of 26 July 2018 – I-15 U 2/17 –