

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2019-12-17
Docket Number / Aktenzeichen:	X ZR 148/17
Name of Decision / Name der Entscheidung:	Fesoterodinhydrogenfumarat





FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

JUDGMENT

X ZR 148/17

Pronounced on:
17 December 2019
Zöller
Judicial Secretary as
Clerk of the court
registry

in the matter

Fesoterodinhydrogenfumarat/
Fesoterodine hydrogen fumarate

Act of Employee Inventions in the version applicable until 30 September 2009 Sec. 5(1) and (2)

a) The written form requirement under Sec. 5(1) sentence 1 Act of Employee Inventions (old version) is satisfied if the employer receives an original notification signed by the employee. Further requirements with regard to the addressing or the transmission of the notification to the employer do not result from this provision.

b) The assumption of a separate notification pursuant to Sec. 5(1) sentence 1 Act of Employee Inventions (old version) shall not be precluded if the employee combines various formulation concepts, procedures and forms of presentation in one letter, as long as these concern the same technical problem and are based on a common solution approach and the invention disclosure is recognizable as such in the abundance of in-house correspondence (following Federal Court of Justice, judgment of 12 April 2011 - X ZR 72/10, GRUR 2011, 733 - Initialidee).

c) In the case of participation of several employees in an invention, the notification of an employee satisfies the requirements under Sec. 5(2) sentence 3 Act of Employee Inventions (old version) if the employer can see from it that co-inventors were involved and how he can determine them and their shares. The degree of detail required in the notification depends in particular on the knowledge the employee has or can easily obtain. Accordingly, the employee is generally required to specifically name the co-inventors from his own area of responsibility. With regard to the involvement of employees from other areas of the company, it is generally sufficient to state the relevant organizational unit (continuation of Federal Court of Justice, judgment of 18 March 2003 - X ZR 19/01, GRUR 2003, 702, 703 - Gehäusekonstruktion).

Civil Code Sec. 117(1)

a) An agreement in which an employee transfers rights to an invention to the employer with the purpose of enabling the employer to register property rights does not constitute a sham transaction.

b) If the employee transfers rights to an invention on the basis of such an agreement because he assumes that the invention will be validly claimed as a service invention, he may, in accordance with Sec. 812(1) sentence 1 case 1 Civil Code, demand the reassignment of the rights assigned and the transfer of the legal positions which the employer has acquired as a result of the applications made on the basis of the transfer if it later transpires that the invention was not validly claimed.

Federal Court of Justice, judgment of 17 December 2019 - X ZR 148/17 –

Higher Regional Court of Düsseldorf
Regional Court of Düsseldorf

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 17 December 2019, attended by the judge Dr. Bacher, the judges Dr. Kober-Dehm, Dr. Marx and Dr. Rombach and the judge Dr. Rensen

ruled that:

On appeal, the judgment of the 2nd Civil Senate of the Düsseldorf Higher Regional Court of November 30, 2017 is set aside on the issue of costs and insofar as the Court of Appeal ruled to the disadvantage of the defendant.

To the extent that it is set aside, 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 a pharmacist and was employed by the legal predecessor of the defendant (hereinafter: defendant) from 1998 to April 2005 and was involved there as a co-inventor in a service invention with the internal designation "SPM 907 Fesoterodine hydrogen fumarate sustained release tablet". This invention gave rise to U.S. Patent 8 501 723, filed on 22 January 2010 and issued on 6 August 2013, and U.S. Patent Application 13/933 788, derived therefrom by division on 2 July 2013, relating to drug compositions containing fesoterodine. The plaintiff claims the defendant for the grant of a co-entitlement to these property rights and for the determination of an inventor's share.
- 2 The plaintiff sent the then head of the defendant's patent department by internal mail a letter dated 26 January 2005, signed by him and entitled "SPM 907 (fesoterodine hydrogen fumarate) sustained release tablet Galenic development/property rights," to which three attachments were attached. The

letter was received by the defendant's patent department on 28 January 2005.

3 The letter contains more detailed information about the background, the origin and the subject matter of the development. Under the heading "Patent aspects", it is stated that the question of the extent to which patentable facts can be derived from the development work requires careful examination. The "Formulation" and "Analytics" working groups are involved in the development. For the "Formulation" group, to which he himself belonged, the plaintiff proposed a share of 30%. In addition, he suggested that the distribution within the "Analytics" group be left to a member of this group named by him.

4 On 7 February 2005, the plaintiff forwarded a counter-proposal of his colleague from the "Analytics" group dated 28 January 2005, by e-mail to the head of the defendant's patent department. This proposed a distribution to both groups in equal shares. The plaintiff indicated that he was in agreement.

5 On 8 April 2005, the defendant requested the plaintiff to file an invention disclosure using the form commonly used by the defendant. The plaintiff complied with this request on 15 April 2005. The completed form was accompanied by a letter and Annexes 1 to 3, which, like the form, was dated 15 April 2005, and the contents of which corresponded to the plaintiff's letter of 26 January 2005. Only the comments on patent aspects were amended as follows:

"The extent to which patentable facts can be derived from the development work performed naturally requires careful examination. ~~Naturally, the other persons significantly involved in the development should also be involved in this.~~ In the opinion of the undersigned, the stabilization of a phenol ester achieved by interaction with xylitol is novel, especially since it significantly suppresses hydrolysis even in the presence of water."

6 Furthermore, instead of the original proposal, a split in half between the two groups was proposed and the shares attributable to the individual employees were quantified with percentages.

7 In a letter dated 3 June 2005, the defendant declared, with reference to

the invention disclosure of 15 April 2005, that it was making unrestricted use of the service invention.

8 Since 2007, the parties have been negotiating (without result) a compensation agreement. The plaintiff claims that it had already reported the service invention in its letter of 26 January 2005.

9 The Regional Court dismissed the action. The Court of Appeal ordered the defendant to grant the plaintiff co-ownership of the granted patent and the pending application concurrently with the pro rata reimbursement of the property rights costs incurred by the defendant, and to consent to the transfer of the patent and the patent application to the plaintiff as co-owner vis-à-vis the U.S. Patent Office. It also found that the plaintiff continued to be the substantive beneficiary with regard to his share of the service invention reported on 26 January 2005. Insofar as the plaintiff asserted assigned claims of one of the participating female employees, the Court of Appeal dismissed the action.

10 In its appeal, which was allowed by the Senate, the defendant seeks to have the judgment of the Regional Court restored. The plaintiff opposes the appeal.

Grounds of the decision:

11 The admissible appeal leads to the reversal of the contested judgment to the extent requested and to the remand of the case to the Court of Appeal.

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

13 The plaintiff was entitled to the granting of a joint right to the property rights applied for and granted on the invention. The defendant had not validly claimed the invention. The time limit for this in Sec. 6(2) sentence 2 Act of Employee Inventions in the version applicable to the dispute and valid until 30 September 2009 had already expired on 3 June 2005.

14 The plaintiff's letter of 26 January 2005, obviously met the requirements

for a separate written invention disclosure pursuant to Sec. 5(1) Act of Employee Inventions (old version). There was no reasonable doubt that it was a separate declaration. The contrary assumption of the Regional Court fails to recognize that the letter and the enclosures attached to it constitute a document which is coherent in terms of content and which is dedicated to a uniform subject. Equally unconvincing is the assumption of the Regional Court that it is merely an activity report. The wording and content of the letter left absolutely no room for an interpretation to this effect. This follows already from the time of the letter, which was provided after conclusion of the investigations. Accordingly, the letter did not report on interim results, but on final findings. The content of the letter was also worded exactly in this sense. Any remaining doubts had in any case been dispelled by the explanations on the distribution of shares. This conclusion was supported by the fact that the defendant had not raised any objections to the plaintiff's notification of 15 April 2005. A postponement of the beginning of the time limit for claiming the invention does not result from the fact that the plaintiff, at the request of the defendant, again reported the invention using a form, nor from the fact that the plaintiff initially estimated the share of the "Formulation" group, which he headed, in the invention at 30% and later increased it to 50%. For an effective invention disclosure, only a designation of the employees involved and their factual contributions to the invention was required, but not a quantification of the resulting shares in the invention. Information on this was to be regarded merely as suggestions to the employer.

- 15 The fact that on 20 November 2007, the plaintiff signed an agreement pre-formulated by the legal predecessor of the defendant for the transfer of the rights to the inventions at issue (assignment) did not lead to a transfer of the plaintiff's share of the invention to the defendant. In view of the fact that the plaintiff had certified the receipt of a remuneration therein, but had undisputedly not received such a remuneration so far, the overall circumstances would indicate that this agreement was a sham transaction, in which neither the plaintiff nor the legal predecessor of the defendant had had a legally binding intention aimed at the transfer of the plaintiff's share of the invention, and that the sole purpose of this contractual document had been to create the outward appearance for the US Patent Office of a transfer of the invention to the legal predecessor of the defendant.

16 The claim to which the plaintiff was entitled was also not forfeited. It had to be assumed that the plaintiff had become aware of the vindication claim existing in his favor in 2013 at the earliest, since he had been advised by a lawyer. The elapsed period of two and a half years until the filing of the action is not sufficient to consider the enforcement of the claim as abusive and in breach of trust.

17 II. This assessment does not withstand legal review in all points.

18 The considerations made by the Court of Appeal are not sufficient to support its conclusion that the time limit for claiming the service invention set out in Sec. 6(2) sentence 2 Act of Employee Inventions (old version) already began on 28 January 2005.

19 1. However, the appeal unsuccessfully complains that the plaintiff's letter of 26 January 2005, cannot be regarded as an invention disclosure because it does not indicate an addressee, in particular because it is not addressed to the patent department of the defendant, but merely contains a distribution list for copies.

20 Pursuant to Sec. 5(1) sentence 1 Act of Employee Inventions in the version applicable to the dispute and valid until 30 September 2009, an employee who has made a service invention must report this separately and in writing to the employer without delay. For this purpose, the employer must receive an original notification signed by the employee.

21 Beyond this requirement, Sec. 5(1) sentence 1 Act of Employee Inventions (old version) does not contain any requirements regarding the addressing or the transmission of the notification to the employer. According to Sec. 22 sentence 1 Act of Employee Inventions, further requirements cannot be contractually stipulated.

22 In the case in dispute, the then head of the patent department of the defendant received the original of the notification of 26 January 2005 signed by the plaintiff two days later. The written form requirement of Sec. 5(1) sentence 1 Act of Employee Inventions (old version) is thus satisfied. 2.

23 2. The appeal also unsuccessfully asserts that there was no separate
notification.

24 a) Without error of law, the Court of Appeal assumed in this respect
that the letter of 26 January 2005 and the enclosures attached thereto are to be
regarded as a unit. Therefore, it is harmless if individual pieces of information
relevant for the assessment are not contained in the letter itself but in an
attachment.

25 b) Contrary to the opinion of the revision, a separate notification is
not lacking because the plaintiff has shown different formulation concepts,
procedures and forms of presentation.

26 The requirement of a separate notification serves the purpose of
preventing the danger that the employer does not recognize an invention
disclosure as such in time in the abundance of internal correspondence.
Therefore, the report may not be inserted into other reports (Federal Court of
Justice, judgment of 12 April 2011 - X ZR 72/10, GRUR 2011, 733 marginal no.
12 - Initialidee).

27 It is not necessary to decide whether in certain constellations the
employee is also required to submit a separate report for each of several
inventions. In the case in dispute, the plaintiff was in any case not prevented
from summarizing all results in one letter because they concerned the same
technical problem and the individual proposals for solutions were based on a
common solution approach which, as the defendant also does not deny, was
even the focus in the further course.

28 3. The Court of Appeal also rightly decided that the notification of 26
January 2005 is not insufficient because it does not indicate all co-inventors and
their shares or because the plaintiff later corrected the information on the shares
attributable to the participating working groups.

29 a) Pursuant to Sec. 5(2) sentence 3 Act of Employee Inventions (old
version), however, the notification shall indicate, inter alia, the employees and
the nature and extent of their participation and shall emphasize what the
notifying employee regards as his own share. This information is not at the

discretion of the employee. The notification must also be designed in such a way that the employer can make an appropriate decision. For this purpose, the employer requires information on the participation of third parties, because in the case of a plurality of participating co-inventors, the employer owes remuneration for each of them separately (Federal Court of Justice, judgment of 18 March 2003 X ZR 19/01, GRUR 2003, 702, 703 - Gehäusekonstruktion).

30 In principle, however, a notification already meets these requirements if the employer can see from it that co-inventors were involved and how he can determine them and their shares. The degree of detail required in the report depends in particular on the knowledge the employee has or can easily obtain. As a rule, he is required to specifically name the co-inventors who were active in his own area of responsibility. However, he is generally not obliged to make any further investigations. If he is aware that employees from other areas of the company are involved, it is therefore sufficient in principle to indicate the relevant organizational unit.

31 Based on this standard, the notification of 26 January 2005 is not insufficient in the case in dispute because the plaintiff did not name the employees from the "Analytics" working group. The plaintiff did not belong to this group and was therefore not required to make inquiries as to the nature and extent of the involvement of members of this group. Rather, it was sufficient to inform the plaintiff that members of this group were involved in the invention.

32 b) According to the case law of the Senate, information on the shares of co-inventors is only of an informative character because each co-inventor is obliged to file his own invention disclosure. Even if an individual employee values his own share too highly, both in the event of a claim and in the event of the invention becoming free, he can only acquire rights to it to the extent to which he is entitled in relation to the other co-inventors (Federal Court of Justice, judgment of 14 February 2017 - X ZR 64/17, GRUR 2017, 504 marginal no. 47 - Lichtschutzfolie).

33 From this, the Court of Appeal correctly concluded that the notification of 26 January 2005 is not insufficient because the plaintiff later corrected the proposal contained therein for the distribution of the shares between the two

work groups.

34 If an employee makes proposals regarding the distribution of the co-inventor shares in an overly obligatory manner, this may not in principle result in him being in a worse position than if he had refrained from making such proposals. It is not necessary to decide whether, by way of exception, something else may apply if the proposals are misleading in such a way that the employer is prevented from making an appropriate decision. In the case in dispute, no indications in this regard have been established or are otherwise evident.

35 4. The Court of Appeal likewise did not err in law in concluding that the plaintiff's claims are not forfeited.

36 The decision as to whether the conditions for forfeiture exist is in principle reserved to the judge of the facts (Federal Court of Justice, judgment of 19 December 2000 - X ZR 150/98, BGHZ 146, 217, 223 - Temperaturwächter).

37 In the case in dispute, the appraisal carried out by the Court of Appeal does not reveal any legal error that is significant under review law.

38 However, the Court of Appeal's consideration that it must be assumed that the plaintiff had been aware of the existing vindication claim at the earliest since 2013 cannot exclude the objection of forfeiture. A claim can also be forfeited if it was unknown to the entitled party (Federal Court of Justice, judgment of 27 June 1957 - II ZR 15/56, BGHZ 25, 47; order of 23 January 2018 - XI ZR 298/17, NJW 2018, 1390 marginal no. 17).

39 However, the assessment of the Court of Appeal is supported by its finding that there were no indications of a possible vindication claim from the perspective of the defendant either. In the absence of such indications, no basis for trust could have arisen on the part of the defendant with regard to possible claims of the plaintiff, especially since the negotiations conducted since 2007 regarding a remuneration of the plaintiff never reached a conclusion.

40 5. The Court of Appeal was also correct in deciding that a time limit effectively set in motion by the letter of 26 January 2005, did not retroactively start anew as a result of the invention disclosure of 15 April 2005.

41 As the Senate has already decided, the assumption that an employee wishes to give up the legal position resulting from a valid invention disclosure requires special indications. This also applies if the validly set deadline for claiming the invention has not yet expired (Federal Court of Justice, GRUR 2017, 504 marginal no. 28 - Lichtschutzfolie).

42 The Court of Appeal's assessment that such indications do not exist in the case in dispute withstands review under the law of review.

43 6. The Court of Appeal was also correct in its decision that the transfer agreement of 20 November 2007 does not preclude the claims.

44 a) Contrary to the opinion of the Court of Appeal, however, this agreement cannot be regarded as a sham transaction if its purpose was to enable the defendant to file applications for property rights in the United States.

45 The parties could only achieve this purpose by means of an effective declaration. Therefore, at least on the basis of German law, it cannot be assumed that the parties did not intend the agreed legal consequence to occur.

46 b) Even if a transfer of rights was effective thereafter, this does not preclude claims of the employee to (re)transfer if both parties assumed that the rights to the invention under German law had already been transferred to the employer by virtue of claim in accordance with the provisions of the Law on Employees' Inventions.

47 aa) Contrary to a widespread opinion (Higher Regional Court of Düsseldorf, judgment of 18 September 2003 - 2 U 70/99, GRUR-RR 2004, 163; Regional Court of Düsseldorf, judgment of 1 March 2011 - 4b O 124/08, juris para. 61; Higher Regional Court of Frankfurt, judgment of 8 March 2007 - 6 U 92/06, OLGR Frankfurt 2008, 854, 855), even in such cases there is no lack of the declaratory awareness required for a transfer of rights, at least under German law.

48 In such cases, both parties know and want that the legal position required for filing a U.S. patent application is transferred to the employer.

49 bb) However, the act of transfer in rem required for the purpose of filing

an application must be distinguished from the basic relationship under the law of obligations on which it is based.

50 If an employee transfers his rights to an invention to the employer because he assumes that it will be validly claimed as a service invention, the act of transfer serves to fulfill a duty which the employee believes is incumbent on him on the basis of the relationship under the law of obligations between him as service inventor and the employer. If it later transpires that the invention was not validly claimed, the employee may therefore, pursuant to Sec. 812(1) sentence 1 case 1 Civil Code, demand the reassignment of the assigned rights and the transfer of the legal positions which the employer has acquired as a result of the applications made on the basis of the assignment.

51 c) This applies irrespective of the legal system according to which the validity of the act of transfer is to be assessed.

52 In this respect, too, a distinction must be made between the act of transfer and the legal relationship on which it is based. According to German conflict of laws, the latter is governed by the law applicable to the employment relationship because this is also decisive for the rights and obligations arising from a service agreement (Federal Court of Justice, judgment of 4 September 2018 X ZR 14/17, GRUR 2019, 271 marginal no. 65 - Drahtloses Kommunikationsnetz). In accordance with the conflict-of-law rule in Art. 38(1) Introductory Act to the German Civil Code, which is relevant to the dispute, this legal system is also decisive for rescission under the law of enrichment.

53 d) As a result, it can therefore be left open whether the validity of the transfer is governed by German or American law and whether it is also valid under the latter. Even if this is to be affirmed, the claims under the German law applicable to the employment relationship are in any case justified in accordance with Sec. 812(1) sentence 1 case 1 Civil Code.

54 However, the appraisal of the Court of Appeal that the letter of 26 January 2005 fulfills the function of an invention disclosure is not free of legal errors.

55 a) Pursuant to Sec. 5(1) sentence 1 Act of Employee Inventions (old version), the employee must indicate that it is a notification of an invention.

56 The notification does not only serve the purpose of communicating the technical teaching of the invention as such to the employer. Rather, it should also make it clear to him that it is a new and (at least possibly) technical teaching based on inventive activity, which he can (only) claim within the statutory period and apply for a patent (Federal Court of Justice, GRUR 2011, 733 marginal no. 19 Initialidee).

51 An activity report or the mere announcement of test results and the like are not sufficient for this. In addition, there must at least be an indication that the employee regards the experiments as significant and as an expression of a possibly patentable general solution principle or an invention (Federal Court of Justice, judgment of 17 January 1995 - X ZR 130/93, Mitt. 1996, 16 - Gummielastische Masse I).

52 b) In the case in dispute, the existence of these requirements cannot be affirmed on the grounds given by the Court of Appeal.

53 The appeal rightly complains that the Court of Appeal did not include all circumstances relevant to the dispute in its assessment. The assessment made on this basis that there is absolutely no room for a different interpretation therefore does not stand up to review under the law of review.

54 The Court of Appeal correctly assumed that the letter including the enclosures attached to it must be assessed in its entirety. However, in its assessment that there is no doubt that an invention disclosure has been made, it only dealt with passages which in themselves speak in favor of this result. On the other hand, the Court of Appeal did not deal with other passages which led the Regional Court to a different assessment.

55 aa) The appeal rightly asserts that the Court of Appeal should have dealt with the introductory passages of the letter, according to which the information provided served "to prepare an in-depth assessment".

56 These statements are consistent with the assessment expressed at the end of the letter that a careful examination is required to determine the extent to which patentable subject matter results from the development work performed. They do not necessarily contradict the result reached by the Court

of Appeal. However, within the framework of the assessment of the facts incumbent upon it (Sec. 286 Code of Civil Procedure), the Court of Appeal would have had to deal with them and justify why it considered the passages of the letter referred to by it to be decisive. The repeatedly expressed assessment that the result is quite obvious or that there is no reasonable doubt cannot replace the required comprehensive assessment.

57 bb) The appeal also rightly complains that the Court of Appeal does not indicate on what basis it arrived at the assessment that the notification was made after the investigations had been completed.

58 In this respect, too, it is not sufficient that the employee has already reached a final conclusion. Rather, this circumstance must be recognizable to the employer from his notification.

59 Against this background, the court of appeal should have at least briefly explained on which passages of the notification it based its assessment. The contested judgment does not meet these requirements.

60 III. The matter is not ripe for final decision (Sec. 563(1) Code of Civil Procedure).

61 The question of whether the letter of 26 January 2005 fulfills the requirements of an invention disclosure requires a new assessment by the court of facts. This will have to be carried out by the Court of Appeal in the reopened appeal proceedings.

62 There is no reason to refer the case back to another senate, as suggested by the defendant. The fact that the Court of Appeal did not assess all the circumstances essential for the assessment does not give any reason to believe that it will again assess the facts incompletely after the referral back.

Bacher

Kober-Dehm

Marx

Rombach

Rensen

Previous instances:

Regional Court of Düsseldorf, judgment of 3 November 2016 – 4c O 37/15 –

Higher Regional Court of Düsseldorf, judgment of 30 November 2017 – I-2 U 77/16 –