

## Deckblatt Übersetzung

### Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2015-10-20
Docket Number / Aktenzeichen:	X ZR 149/12
Name of Decision / Name der Entscheidung:	Kfz-Stahlbauteil

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# FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

## JUDGMENT

X ZR 149/12

Pronounced on:  
20 October 2015  
Hartmann  
Judicial Secretary as  
Clerk of the court  
registry

in the matter

Kfz-Stahlbauteil/  
Automotive steel component

Patent Act Sec. 8, 63(2) sentence 1

Whether an entitled person can demand the assignment of a patent application or the granting of a joint right thereto, or whether there is a claim to be named as (co-)inventor, requires an examining comparison of the teaching applied for by the patent with that whose unlawful taking is claimed. For this purpose, it must first of all be examined to what extent both teachings correspond. Whether an unlawful taking exists can be reliably assessed in the overall view to be taken for this purpose only on the basis of established correspondences between the teaching asserted as taken and the teaching applied for (continuation of Federal Court of Justice judgment of 11 November 1980 X ZR 58/79, BGHZ 78, 358 et seq. Spinnmaschine II and judgment of 17 January 1995 X ZR 130/93, Mitt. 1996, 16, 18 - Gummielastische Masse I).

Federal Court of Justice, judgment of 20 October 2015 - X ZR 149/12 –  
Higher Regional Court of Munich  
Regional Court of Munich I

ECLI:DE:BGH:2015:201015UXZR149.12.0

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 20 October 2015, attended by the presiding judge Prof. Dr. Meier-Beck, the judges Gröning, Dr. Grabinski and Dr. Deichfuß as well as the judge Dr. Kober-Dehm

ruled that:

On appeal by the plaintiffs, the judgment of the 6th Civil Senate of the Higher Regional Court of Munich pronounced on 8 November 2012 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 1, which does business in Belgium, is engaged in the development of new processes for the anti-corrosion coating of metals, and the plaintiff 2 is its managing director (hereinafter collectively referred to as: the plaintiffs). Defendant 1 is active in the automotive supply industry, Defendant 5 is a German automobile manufacturer. Defendants 2, 3 and 4 and 6, respectively, are respective company employees.
- 2           Defendants 1 and 5 are registered as co-proprietors of German patent 10 2005 054 847 (patent in suit), and defendants 2, 3, 4 and 6 are named as its inventors. The parties mainly dispute the transfer of the patent in suit to the plaintiff 1 due to unlawful taking and whether the plaintiff 2 is the sole inventor. The facts of the case are as follows.
- 3           The plaintiff 1 had a zinc thermodiffusion process developed by the plaintiff 2 for (surface) corrosion protection of components made of high-strength steel (Victocor/Levicor technology). From 2002, the plaintiff 1 and the

defendant 1 cooperated on the initiative of D. in a project for the improved surface treatment of high-strength steels for car body construction. Under the terms of a confidentiality agreement (rop5), the 1st Defendant obtained detailed knowledge of the Levicor technology.

4           On 13 October 2003, the 1st defendant filed an application for a German patent (DE 103 48 086 A1, rop1) for a high-strength steel component with a zinc anti-corrosion coating in violation of the agreement. In the course of a dispute between the first plaintiff and the first defendant concerning the entitlement to the subject matter of this application and during the period of a standstill period agreed in this respect, the first defendant withdrew the application on 12 October 2005 and subsequently informed the first plaintiff accordingly. For its part, the 1st plaintiff filed an application for a German patent identical to rop1 on 17 November 2005 (DE 10 2005 055 374 A1, BP7).

5           Two days earlier, on 15 November 2005, the 1st defendant had filed the patent in suit, which concerns a high-strength steel component with targeted deformation in the event of a crash and claim 1 of which reads:

"1. Use of a component made of high-strength steel, which has been heat-treated at 320 to 400°C after hot forming and press hardening, as a structural and/or safety component for a motor vehicle."

6           The use according to subclaims 2 and 3 relates to a component which is specifically subjected to an axial load in the event of a crash and a longitudinal member, respectively; subclaim 4 provides for the use of a high-strength steel in the composition of the press-hardened steel grade BTR 165 produced by the 1st defendant and subclaim 5 provides for the use of a component coated with a corrosion protection layer.

7           Before the Regional Court, the plaintiffs essentially requested that the 1st and 5th defendants be ordered to transfer the patent in suit to the 1st plaintiff and to consent to its rewriting, to provide information and to give an account of the extent to which and the manner in which the 1st defendant and/or the 5th defendant and/or third parties authorized by them have used the patent in suit

since 5 October 2007. The plaintiffs have also requested the court to provide information on the extent to which the defendant 1 and/or the defendant 5 and/or third parties authorized by them have manufactured, offered for sale, placed on the market or either imported and/or possessed for these purposes components in accordance with the patent in question since 5 October 2007 and/or how they have otherwise commercially exploited the invention underlying the patent. In addition, the plaintiffs have requested that the defendants be ordered to agree with the German Patent and Trademark Office that only the plaintiff 2 is named as inventor, and to declare that the defendants 1 and 5 are liable to compensate the plaintiff 1 for the benefits derived from their own and third party use or in any other way from their legal position as applicants, and to compensate the plaintiff 1 for all damages incurred as a result of the unauthorized application for the patent in suit; further, to declare that the defendants are jointly and severally liable to compensate the plaintiff 2 for the entire damage resulting from the incorrect naming of the inventor.

8           The Regional Court allowed the action; the Court of Appeal dismissed it.

9           In their appeal, which was allowed by the Senate and which the defendants seek to have dismissed, the plaintiffs pursue their motion to dismiss the defendants' appeal.

Grounds of the decision:

10           1.       According to the description of the patent in suit, components made of strong and high-strength steel are increasingly being used in vehicle construction in order to meet lightweight construction criteria with increasing demands on material characteristics. Structural or safety components are also increasingly being made of hot-formed and press-hardened solid or ultra-high-strength steel in body construction to meet weight targets and safety requirements. If a vehicle side member made of high-strength steel is hit from the front or rear, crash energy is introduced into it in the longitudinal direction. In some cases, this can lead to brittle component cracks, which is detrimental to the dissipation of this energy. Against this background, the patent in suit concerns the problem of further developing a hot-formed and press-hardened structural and/or safety component for a motor vehicle made of high-strength steel for more favorable energy dissipation in the event of a crash. For this purpose, patent claim 1 proposes:

1.       A component made of high-strength steel,
2.       which has been heat-treated at 320 to 400°C after hot forming and press hardening,
3.       is used as a structural and/or safety component for a motor vehicle.

11           According to the explanations in the patent specification in dispute, structural or safety components include door impact beams, A- and B-pillars, bumpers, and longitudinal and transverse beams (paras. 2, 9).

12           According to the invention, energy acting on the affected structural or safety component in the event of an accident is to be converted into (deformation) work. The component is to form dent-like folds (paras. 10, 22) so that the impact energy does not fully affect the vehicle occupants. According to the patent in suit, the intended heat treatment at a relatively low temperature specifically influences the high-strength properties of the component. With virtually unchanged yield strength  $R_{p0.2}$  and elongation  $A_5$ , the tensile strength  $R_m$  is reduced by 100 to 200 N/mm<sup>2</sup>. Surprisingly, the slight reduction in tensile

strength is sufficient to restore the deformability in the sense of wrinkling in a structural or safety component while retaining the high-strength properties of the steel. After heat treatment at 320°C to 400°C, the steel grade BTR 165 would have a tensile strength  $R_m$  of 1,200 to 1,400 N/mm<sup>2</sup>, a yield strength  $R_{p0.2}$  of 950 to 1,250 N/mm<sup>2</sup> and an elongation  $A_5$  of 6 to 12%. The material still has the necessary high-strength mechanical properties. As a result of the somewhat lower tensile strength, however, it is so ductile that it wrinkles instead of breaking or cracking under appropriate load (paras. 11 and 12). This material property would make the steel suitable for structural or safety components where such deformation in the event of a crash is desirable.

13           According to the description, the component according to the invention can be coated. In addition to the corrosion protection required in many cases anyway, it is possible according to the invention to heat treat the component simultaneously in conjunction with a coating process at 320°C to 400°C, for example with an immersion coating or a diffusion process (para. 14).

14           II.       The Court of Appeal is of the opinion that the second plaintiff is neither the inventor of the technical teaching of the patent in suit nor has he made a creative contribution to it. From the relevant skilled person's point of view, the invention according to claim 1 exclusively covers the use of heat-treated, high-strength steel components as structural or safety components of a motor vehicle, which are intended to form a specific fold in the event of a crash. It does not cover use as a structural or safety component where this folding is not desired (door impact beams, B-pillars). The plaintiffs had not shown that the second plaintiff, thanks to his own knowledge, had been in possession of a technical teaching of the same essence as the subject matter of the invention thus understood before the priority date of the patent in suit. In particular, the plaintiff's patent application BP7 was unhelpful in this respect. BP7 did not deal with the problem of a targeted folding of structural/safety components by increasing the ductility of the hardened steel, but exclusively with the corrosion protection coating of components made of hot-formed and press-hardened high-strength steel while retaining its material properties as unchanged as possible despite the heat input associated with the coating. Accordingly, BP7 envisages avoiding the temperature range of over 320°C known for diffusion galvanizing

("sherardizing") and instead carrying out the surface treatment specifically at temperatures of below 320°C. In view of the fact that the patent in suit expressly refers to a temperature range of more than 320°C in order to increase the ductility of the material for targeted wrinkling in the event of a crash, it could also not be assumed that the second plaintiff had grasped a general solution idea with the coating technology he had developed, which would also have been reflected in the patent in suit. Nothing else applied to the other documents in which the plaintiffs saw the core idea of the invention embodied. A creative contribution to the teaching of the patent in suit could not be inferred from the report on a presentation of the plaintiffs' coating process on 24 February 2003 (Exhibit rop32) written by the second defendant.

15           The further presentation documents of the plaintiffs also did not document any inventive ownership of or creative contributions to the subject matter of the protected invention. An indication that specifically the thermal coating in the temperature window claimed by the patent in suit and the accompanying slight reduction of the tensile strength could be utilized for the advantage of a folding under energy input according to the invention is not to be found there. References in the documents on various occasions to the ductility of the heat-coated hardened steel according to the Levicor technology could therefore not establish a contribution by the plaintiffs to the invention. The plaintiffs' reference to crash tests carried out on B-pillars at the German Aerospace Center (DLR) in November 2003 is also unhelpful. (DLR) in November 2003.

16           Also with regard to the particular embodiments of the protected teaching formulated in the subclaims, no (not only insignificant) contributions by the plaintiffs could be identified.

17           III.     The attacks of the appeal directed against this assessment are successful and lead to the reversal of the contested judgment and to the remittal of the case to the Court of Appeal.

18           In its comments on the determination of the subject matter protected in the patent in suit, the Court of Appeal, also insofar as decisions of the Senate are cited for this purpose, which were issued on the question of the creative

contribution (Federal Court of Justice, judgment of 17 May 2011 - X ZR 53/08, GRUR 2011, 903 marginal no. 16 - Atemgasdrucksteuerung), admittedly starts from correct higher principles. However, in the following, the Court of Appeal, even though it refers to contributions to the invention on various occasions, essentially only examined whether it can be inferred from various documents of the plaintiffs that they were in possession of a technical teaching that was consistent with patent claim 1 - as it understood the latter. This falls short in several respects.

19           1.       The Court of Appeal's interpretation of the patent in suit, which is subject to unrestricted legal review by the Court of Appeal in vindication proceedings as well as in infringement proceedings (cf. Federal Court of Justice, judgment of 31 March 2009 - X ZR 95/05, BGHZ 180, 215 marginal no. 16 - Straßenbaumaschine), cannot be accepted. With its assumption that patent claim 1 only covers the use of such high-strength structural or safety components of a motor vehicle which are intended to form a targeted fold in the event of a crash, the Court of Appeal interpreted patent claim 1 below its literal meaning (cf. in this respect Federal Court of Justice, judgment of 1 August 2006 X ZR 114/03, GRUR 2006, 962, 965 - Restschadstoffentfernung, to that extent not printed in BGHZ 169, 30).

20           Claim 1 is directed to the use of an article, namely a component of high-strength steel heat-treated at 320°C to 400°C after hot forming and press hardening, as a structural or safety component for a motor vehicle. Any structural or safety component made of a high-strength steel which has been heat-treated after hot forming and press hardening at 320°C to 400°C is thus protected. As can be seen from paragraphs 2 and 9 of the description, the claim is based on a comprehensive concept of structural and safety component. Insofar as, according to the description, the invention cannot be usefully applied to B-pillars because these are not intended to project into the passenger compartment as a result of deformation (paragraph 13), this does not result in any limitation of its subject matter. Nor does such a restriction follow from the use of the invention - not mentioned in the patent in suit anyway - for bulkhead crossmembers, which was additionally discussed by the Court of Appeal.

21           2.       As a result of its incorrect interpretation of the patent in suit, the

Court of Appeal sets requirements for the provision of creative contributions which are not related to its subject matter and does not take into account achievements in its examination in this respect on which the plaintiffs rightly rely for this purpose.

22           a)       Whether a person entitled under Sec. 8 sentence 1 and 2 Patent Act can demand the assignment of a patent or the granting of a co-entitlement thereto and whether there is a claim to be named as (co-)inventor under Sec. 63(2) sentence 1 Patent Act, requires an examination comparison of the teaching for which a patent application has been filed with the teaching the unlawful taking of which is claimed (cf. Federal Court of Justice, judgment of 11 November 1980 - X ZR 58/79, BGHZ 78, 358 et seq. Spinn turbine II). For this purpose, it must be examined first and foremost to what extent both doctrines coincide. Whether and, if so, to what extent there is an unlawful taking can only be reliably assessed in the overall view to be taken for this purpose on the basis of established correspondences between the doctrine asserted as taken and the doctrine applied for. This applies because the vindication claim also applies to a person who has not taken a complete invention which may be protectable on its own, but who has taken a substantial contribution to the subject matter applied for by him or protected on his behalf, provided that what has been taken constitutes an inventive contribution, a creative share or a qualified contribution to the subject matter of the application or the property right granted (Federal Court of Justice, judgment of 17 January 1995 - X ZR 130/93, Mitt. 1996, 16, 18 Gummielastische Masse I).

23           b)       In contrast, the Court of Appeal based its examination for unlawful taking on existing or alleged differences between the teaching of the patent in suit and the contributions of the first plaintiff which it examined. In doing so, it primarily examined the question of whether these documents contain a technical teaching similar in essence to the invention, essentially reducing this to the folding in the event of a crash and consequently disregarding the fact that the plaintiffs recognized the teaching according to the invention when they heat-treated (and at the same time coated) hot-formed and press-hardened components made of high-strength steel in the low-temperature range in accordance with the patent, which were suitable and intended for use as

structural components for motor vehicles. The fact that the components continue to be high-strength, but due to the somewhat lower tensile strength are so ductile that they wrinkle instead of breaking or cracking when subjected to appropriate loads, did not have to be recognized for this purpose.

24           3. a) The assessment of the BP7 application, which is obviously in complete agreement with rop1 because the first plaintiff wanted to make the - for legal reasons unsuitable - attempt of an application under Sec. 7(2) Patent Act, is wrong in several respects.

25           aa) The assumption of the Court of Appeal that BP7, in contrast to the patent in suit, does not "deal with the problem of a targeted folding of structural/safety components in the event of a crash with otherwise (essentially) constant mechanical properties" misses the point of the subject matter of the patent in suit because, as explained (above III 1), this also covers those structural or safety components which are the subject matter of BP7. Most importantly, contrary to what the Court of Appeal seems to think, the patent in suit does not teach such a directed wrinkle, but this is merely the result of a certain (heat) treatment to which the component made of high-strength steel is subjected according to the teaching of the patent in suit. Notwithstanding the fact that the claims of the patent in suit are formulated as use claims, its subject matter is not directed to a method for producing a steel component which wrinkles in the event of a crash. Rather, it is directed to a specific use of the heat-treated steel components described in more detail and, as explained, could accordingly just as well be directed to subject matter claims for corresponding structural and safety components. Heat-treated structural steel components are, however, also the subject of BP7.

26           bb) In the view of the Court of Appeal, BP7 differs fundamentally in purpose from the teaching of the patent in suit in that according to BP7 work is to be carried out at temperatures below 320°C so as not to significantly influence the strength values of the hardened steel. In doing so, the Court of Appeal neglects the fact, which it recognizes per se, that the steel heat-treated according to the teaching of the patent in suit should still have the necessary high-strength mechanical properties and only the tensile strength - with virtually unchanged yield strength and elongation - should be somewhat reduced in the

interest of increased ductility and thus allow folding (description, par. 12 f.). The contrast between BP7 and the teaching of the patent in suit, which the Court of Appeal sees in the fact that the latter, unlike BP7, provides a hot-formed and hardened structural component made of (high-)strength steel with an anti-corrosion layer which has no or only an insignificant effect on the strength values of the component, therefore does not exist in this way.

27           cc)    The same applies to the temperature data. The Court of Appeal identifies as the essential difference between the two teachings the different temperature ranges of < 320°C (rop1/BP7) and 320 to 400°C (patent in suit) assigned to the heat treatment in each case and denies the second plaintiff a creative contribution by pointing out that he had elsewhere (report rop32) described a coating of the hardened steel at temperatures higher than 320°C as not recommendable because of the undesirable fluctuations in the thickness of the coating that would then occur, which virtually leads away from the teaching of the patent in suit. This is not valid, if only because according to the teaching of the patent in suit, components provided with an anti-corrosion coating can also be subjected to the envisaged heat treatment between 320°C and 400°C (subclaim 4). The description explains that, according to the invention, in addition to the frequently required corrosion protection, it is possible to heat treat the component simultaneously in conjunction with a coating process at 320°C to 400°C (description, para. 14). If the patent in suit itself provides for the heat treatment of coated parts in a temperature range which, according to the Court of Appeal, is supposed to be counterproductive for the coating purpose, this speaks against the strict delimitation of the suitable temperature ranges assumed by the Court of Appeal and indicates a certain range of temperatures favorable for coating on the one hand and for increasing ductility on the other hand, as well as overlaps of these ranges, and corresponds with the plaintiffs' submission, documented in the facts, that a temperature range of 280°C to 370°C, preferably 300°C to 320°C, was recognized as suitable.

28           In this context, the Court of Appeal should not have considered the different temperature ranges in BP7 and the patent in suit, as the appeal rightly complains, as indications speaking against ownership of the invention, without addressing the plaintiffs' argument - also based on the hearing before the

German Patent and Trademark Office (rop10, BP23) - that the temperature range claimed in the patent in suit was only chosen to differentiate rop1/BP7.

29           b)     The Court of Appeal considers the note on the plaintiffs' presentation of 24 February 2003 (rop32) - which is expressly regarded as meaningful with regard to the plaintiffs' level of knowledge - essentially only from the point of view of whether the aspect of increased ductility or wrinkle formation was addressed. According to the findings made by it, however, rop32 describes a heat treatment process explained by the plaintiff to 2 in which bolts are coated and the drum-shaped furnace provided for this purpose is heated up to a final temperature of 300°C to 500°C. It is pointed out that for the heat treatment of large components, racks must be inserted in the drums, and the possible number of pieces per drum is stated for various structural and safety components (A and B pillars, side members).

30           It further follows from the findings of the Court of Appeal that the Victocor/Levicor technology presented was assigned a temperature range of 280°C to 370°C, preferably 300°C to 320°C, in a presentation given on February 24, 2003, and that tensile strength values - determined by D. - of BTR steel heat-treated at 320°C were communicated which, at 1,400 MPA, correspond to the value determined according to the description of the patent in suit for steel of this grade treated at 320°C to 400°C (I above).

31           c)     As far as the crash tests carried out at DLR are concerned, the Court of Appeal even assumes that the plaintiffs' documents in this respect contain indications of increased ductility of the steel heat-treated in this temperature range. It considers this to be irrelevant only because it wrongly sees B-pillars, with which these tests were carried out, as excluded from the subject matter of the patent in suit (III 1 above). Moreover, a creative contribution to the invention could even be considered if the assumption of the Court of Appeal were correct. A creative contribution to an invention cannot be said to have been made only and only when it has found its way into the final version of the claims, but it can be sufficient for this if it has contributed to the final form of the invention. A contribution can only no longer be considered as a creative contribution if, after modification of the patent claims, it lies outside the patent-protected subject matter and can therefore no longer establish co-inventorship

therein (Federal Court of Justice GRUR 2011, 903 marginal no. 16 - Atemgasdrucksteuerung).

32           d)       Finally, a contribution to the invention cannot be denied either by the statements made by the Court of Appeal with regard to patent claim 4 or by the statements made with regard to patent claim 5.

33           Patent claim 4 claims the use of the steel grade BTR 165, to which the properties desired according to the invention are attributed (description, para. 11). The fact that this steel grade originates from the 1st defendant does not change the fact that, according to the findings of the Court of Appeal, the 2nd plaintiff used and examined precisely this steel and thus also contributed to the subject matter of the invention.

34           According to claim 5, the component is coated with an anti-corrosion coating. Such a surface treatment was, as the Court of Appeal states, known in many ways (BU 37 to A.1.c aE). However, the mere fact that a certain technical aspect is known in the state of the art does not justify the assumption that it can at most be an inventively insignificant contribution. For the assessment of whether a creative contribution can be seen in the utilization of an element known in the state of the art in the context of an invention, it depends on its significance within the invention and the nature and technical meaning of its use in the context of the problem solution by the technical teaching as a whole (cf. Federal Court of Justice GRUR 2011, 903 marginal no. 21 - Atemgasdrucksteuerung). As explained, the invention teaches to heat treat the component "simultaneously" in connection with a coating process, in particular with a diffusion process (para. 14), i.e. to use the heat treatment simultaneously for coating. This is precisely what the plaintiff at 2, whose investigations into the coating of high-strength steel sheets using the zinc thermal diffusion process formed the starting point for the knowledge gained, was concerned with.

35           IV.       Accordingly, the judgment on appeal cannot stand. The Senate cannot make a final decision on the merits of the case. It is true from the findings of the Court of Appeal that the plaintiffs recognized at least essential parts of the invention and also communicated these to the first defendant. However, it did not make any findings on the communication of the knowledge gained from

the crash tests to the defendants. Insofar as the Court of Appeal noted that this could not have occurred on the occasion of the presentation in accordance with Annex rop33 in May 2003, because the tests at DLR were carried out for the first time in November 2003, this does not preclude consideration as a creative contribution to the invention, however, because its development is often a process-like event stretched out over time, and supporting contributions can in principle be made up to the time of its application for an industrial property right. According to the findings of the Court of Appeal, there is no reason to assume that the situation in the case in dispute would have been different.

36           Furthermore, the Court of Appeal, logically from its point of view, did not make any findings as to whether the 6th defendant is to be counted among the group of inventors.

37           The case must be referred back to the Court of Appeal to make the necessary findings, and the Court of Appeal will also have to decide on the costs of the appeal proceedings.

38           Insofar as the Court of Appeal assumed in the parallel proceedings that claims for damages of the plaintiff 1 against the defendant 1 in connection with the application for the patent in suit there could not exist if the defendant 1 was a co-entitled party within the meaning of Sec. 8 Patent Act, the Senate notes that it has allowed the appeal against the judgment of the Court of Appeal rendered there in this respect.

Meier-Beck

Gröning

Grabinski

Deichfuß

Kober-Dehm

Previous instances:

Regional Court of Munich I, judgment of 30 June 2011 – 7 O 18657/09 –

Higher Regional Court of Munich, judgment of 8 November 2012 – 6 U 3743/11 –