

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2015-12-01
Docket Number / Aktenzeichen:	X ZR 170/12
Name of Decision / Name der Entscheidung:	Unberechtigte Schutzrechtsverwarnung II



**Arbeitskreis
Patentgerichtswesen**
in Deutschland e.V.



FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

DEFAULT JUDGMENT

X ZR 170/12

Pronounced on:
1 December 2015
Hartmann
Judicial Secretary as
Clerk of the court
registry

in the matter

Unberechtigte Schutzrechtsverwarnung II/
Unauthorized property right warning II

Civil Code Sec. 823 Ai

- a) The lawyer engaged by the owner of the property right with regard to a property right warning shall have a guarantor's duty towards the person subsequently warned not to advise the owner of the property right in a manner that incorrectly assesses the legal situation with regard to the justification of the property right warning.
- b) If the unjustified warning of the property right is based on negligently incorrect legal advice given to the property right holder by a lawyer, the lawyer may be liable for damages in addition to the property right holder from the point of view of an unlawful and culpable interference with the established and practiced business.
- c) If the lawyer has pointed out to the owner of the property right all essential aspects that speak for or against an infringement of the property right in the case of an unclear legal situation, and if the owner of the property right decides to issue the warning despite the concerns pointed out, liability of the lawyer for unjustified warning of the property right pursuant to Sec. 823(1) Civil Code cannot be considered as a rule.

Federal Court of Justice, default judgment of 1 December 2015 - X ZR 170/12 –
Higher Regional Court of Frankfurt at the Main
Regional Court of Frankfurt at the Main

ECLI:DE:BGH:2015:011215UXZR170.12.0

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 1 December 2015, attended by the presiding judge Prof. Dr. Meier-Beck, the judges Dr. Grabinski, Dr. Bacher, Hoffmann and the judge Schuster

ruled that:

On appeal by the plaintiff, the partial judgment of the 6th Civil Senate of the Higher Regional Court of Frankfurt at the Main of 8 November 2012 is set aside. The case 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 and the 1st defendant are engaged in business in the field of satellite reception technology. The 1st defendant was the proprietor of German patent 44 04 978 (hereinafter only: patent), which was granted on 18 February 1999 and relates to an antenna arrangement for satellite receivers.

2 Claims 3 and 4 of the patent, which are solely of interest in the present litigation, read:

"3. Method for transmitting control signals from a reproduction apparatus (7) having a generator (9) serving to generate a continuous signal determining the transmission range for a reception converter (6) to a reception control unit (4) via a coaxial cable for transmitting the reception signals and the transmission range control signals, characterized in that, during program switching from the reproduction apparatus, the continuous signal for determining the transmission range is briefly interrupted one or more times in accordance with a control sequence when it is in the switched-on state

or is switched on when it is in a switched-off state, and in that the reception control unit (4) receives these signals for controlling the antenna and sets the reception converter (6) to the desired position.

4. Method according to claim 1, characterized in that the adjustment of the position is carried out by interrogating the actual position of the receiving converter (6), reading out a desired position from the memory and controlling the motor (1) according to the deviation between the desired position and the actual position."

3 The patent was declared null by the Federal Patent Court in a judgment of 29 April 2009, to the extent of claims 3 and 4; the appeal filed against this was dismissed by the Federal Court of Justice in a judgment of 27 October 2011 (X ZR 94/09).

4 In February 2007, the first defendant had a third-party company invite numerous customers of the plaintiff from the specialist trade to submit a written offer for a rotatable satellite system. Customers of the plaintiff who subsequently made an offer were warned in March 2007 by the second defendant, who runs a law firm with the third defendant, as the legal representative of the first defendant, for direct infringement of the patent. In a letter dated 2 April 2007, the plaintiff's attorney at first instance legitimized himself vis-à-vis the 1st defendant and rejected the warning for 400 of the plaintiff's customers after the plaintiff had issued a corresponding declaration of assumption of costs and informed its customers accordingly.

5 On 22 March 2007, the plaintiff obtained an interim injunction from the Regional Court of Düsseldorf prohibiting the 1st defendant from issuing warnings with the content stated, because at most an indirect patent infringement on the part of the warned customers was possible, but they had been warned for direct patent infringement. The first defendant then issued a corresponding cease-and-desist declaration. In the opposition proceedings, the Regional Court found that the injunction proceedings had been disposed of on the merits. The appeal filed by the first defendant against this decision was

unsuccessful.

6 In a letter dated 22 June 2007, the second defendant, as legal representative of the first defendant, issued a warning to the plaintiff's customers for indirect patent infringement. After a renewed declaration of assumption of costs and information of the customers, the plaintiff's attorney at first instance again legitimized himself vis-à-vis the 1st defendant and rejected the warnings for 313 customers.

7 On 4 July 2007, the plaintiff obtained a further preliminary injunction prohibiting the first defendant from issuing warning notices to dealers as it had done, on the grounds that it had not been pointed out that the Regional Court of Mannheim had held in infringement proceedings in a judgment of 6 October 2006, that the process doctrine in claim 3 of the patent was not applied by reception systems for multiple satellites (multifeed systems). The opposition filed by the first defendant against this decision was unsuccessful, as was the appeal filed against the Regional Court's judgment. Later, in the main proceedings, the Higher Regional Court of Karlsruhe ruled in a judgment dated 25 February 2009 that patent claim 3 was also infringed by the offering and supply of multifeed systems.

8 The plaintiff is suing the defendants for damages of €1,500,000 for unauthorized warnings of intellectual property rights. The Regional Court ordered the 1st defendant to pay €272,800 and dismissed the rest of the claim. After the plaintiff filed its appeal, insolvency proceedings were opened against the 1st defendant's assets and the legal dispute was suspended in this respect. The Court of Appeal dismissed the appeal in respect of the action brought against the 2nd and 3rd defendants. The plaintiff's appeal, which was allowed by the Senate, is directed against this and she is pursuing her appeal in this respect.

Grounds of the decision:

9 The plaintiff's appeal must be decided by default judgment as requested, since the 2nd and 3rd defendants were in default at the hearing. Despite the default of the defendants on appeal, the judgment is based on a complete legal review to the extent of the challenge (see only Federal Court of Justice, judgment of 13 September 2005 X ZR 62/03, GRUR 2006, 223 mwN). This leads to the reversal of the judgment on appeal and to the remittal of the case to the Court of Appeal.

10 I. The Court of Appeal found the claims to be unfounded, since the case law of the Federal Court of Justice, according to which the unjustified warning of a customer can constitute an interference with the established and practiced business operations that is liable for damages, cannot be applied to the liability of the lawyer involved in the warning. The specific interests of the lawyer must be taken into account in the overall assessment required in this respect. For the lawyer, a personal liability leads to incalculable risks, which cannot be justified according to the overall circumstances and with regard to the fees to be earned by him as a correlate of his liability. The lawyer's task is to inform his client properly about the risks associated with the warning. If he fails to do so and the client then has to pay damages because of the unjustified warning, he can take recourse against the lawyer. Nor could the lawyer limit his liability risk vis-à-vis the third party, but at most agree a release from liability with his client. The involvement of a lawyer at the time of issuing the warning does not create a special basis of trust for the opponent which could justify the lawyer's own liability. Rather, the warned party must expect that the agent of his opponent will use the available leeway in favor of his client.

11 Another argument against the assumption of a tortious liability of the lawyer from the point of view of an encroachment on the established and practiced business is that a lawyer who, within the scope of his professional activity, merely represents the competitive interests of his client is not liable under the provisions of unfair competition law due to the lack of a sales promotion connection pursuant to Sec. 2(1) No. 1 Unfair Competition Act. In view of Art. 12 German Constitution, a lawyer as a professional advisor and representative of his client must have the indispensable freedom of expression

in all legal matters outside of legally ordered proceedings, which his position as an independent organ of the administration of justice requires.

12 There were also no special circumstances that could exceptionally justify a different assessment of the interests at stake and thus a corresponding need for compensation. In particular, the second defendant had not issued the warning without a mandate or consciously in the knowledge that it was not justified. There was no evidence that the 2nd defendant had been aware at the time of the warnings that the patent had been wrongly granted. Nor could it be assumed that the defendant had deliberately issued the warnings incorrectly in order to influence the plaintiff's customers in a particularly serious manner. The fact that the warning of 12 March 2007 wrongly demanded a cease-and-desist declaration for acts of use other than offering and selling could not have significantly influenced the warned retailers in their reaction to the warning. The fact that, according to two decisions of the Regional Court of Mannheim, multifeed systems were excluded from the scope of protection of the patent was not expressly mentioned in the warning of 22 June 2007, but the wording of the required cease-and-desist declaration took this circumstance into account, so that here, too, the "excess" of the warning was of no material significance for its effect.

13 II. This assessment does not withstand review under the law of review in one decisive point.

14 The appeal rightly criticizes the statements of the Court of Appeal as erroneous in law, according to which the second defendant, as the lawyer engaged by the first defendant, is only obliged to pay damages for interference with the established and practiced business of the plaintiff by unjustified warning from the first defendant's patent in accordance with Sec. 823(1) Civil Code in the event of intentional conduct. Liability of the 2nd defendant and the 3rd defendant as its partner in analogous application of Sec. 128 Commercial Code in conjunction with Sec. 31 Civil Code (see Federal Court of Justice, judgment of 3 May 2007 IX ZR 218/05, BGHZ 172, 169 marginal no. 23) is also possible if the unjustified warning is based on negligent misjudgment of the legal situation by the 2nd defendant in advising the 1st defendant.

- 15 a) It is recognized in case law that the unjustified warning under an industrial property right may give rise to an obligation to pay damages from the point of view of an unlawful and culpable encroachment on the right to the established and practiced business. This is based on the consideration that the necessary balance between the rights protected by Art 14 German Constitution. This is based on the consideration that the necessary balance between the constitutionally protected interest of the property right holder in being able to assert his right and the interest of competition, which is also protected by the German Constitution, in being able to develop freely outside the scope of protection of existing rights in compliance with the law, would no longer be effectively guaranteed, if the owner of the property right were allowed to claim protection to an extent to which he is not entitled and if he were allowed to derive the economic benefit from a culpable misjudgement of the extent of the protection to which he is entitled without having to answer for any damage caused to his competitors as a result (Federal Court of Justice, order of 15 July 2005 GSZ 1/04, BGHZ 164, 1 marginal no. 15 Unjustified warning of property rights).
- 16 b) The encroachment on the right to established and practiced business operations by unauthorized property right warning is an objective fact equivalent to the absolute property rights under Sec. 823(1) Civil Code. The consideration that the owner of the property right may not only enjoy the advantages of the exclusive right granted to him, but as a correlate to this privileged position must also bear the dangers associated with the assertion of his exclusive right (cf. Federal Court of Justice, loc. cit., marginal no. 14 Unauthorized property right warning), does not exclude the possibility that other persons involved in the property right warning may also be liable to pay damages. It may be that it is generally the owner of the property right who benefits the most from an unjustified property right warning. For tort liability, however, it is not a matter of who benefits most from the tortious conduct. Rather, the decisive factor is whether someone is involved in the tortious conduct of a third party as a perpetrator or participant (Sec. 830 Civil Code) in accordance with general principles of tort law (Federal Court of Justice, judgment of 18 June 2014 I ZR 242/12, BGHZ 201, 344 marginal no. 13 Geschäftsführerhaftung; judgment of 27 November 2014 I ZR 124/11, marginal

no. 83, GRUR 2015, 672 Videospiegel-Konsolen II). Accordingly, liability may arise not only from a positive act but also from an omission if the perpetrator is obliged on the basis of a guarantor position to avert a threat to or infringement of the rights of outsiders protected by Sec. 823(1) Civil Code (Federal Court of Justice, judgment of 5 December 1989 VI ZR 335/88, BGHZ 109, 297, 303; judgment of 10 July 2012 VI ZR 341/10, BGHZ 194, 26 marginal no. 18; BGHZ 201, 344 marginal no. 16 Geschäftsführerhaftung).

17 c) The lawyer engaged by the property right owner with regard to a property right warning has such a guarantor position vis-à-vis the person subsequently warned. This results in the lawyer's obligation to refrain from advising the owner of the property right in a manner that incorrectly or incompletely represents the legal situation with regard to the justification of the property right warning.

18 (a) However, the lawyer instructed by the owner of the property right in the case of a property right warning is contractually obliged only towards his client to advise him correctly and comprehensively about the property right situation. This obligation is comparable to that of the managing director of a GmbH (limited liability company) who, due to his position as a member of the executive body, is likewise in principle only obliged to conduct business properly vis-à-vis the company (BGHZ 109, 297, 303; judgment of 13 April 1994 II ZR 16/93, BGHZ 125, 366, 375; BGHZ 194, 26 marginal no. 23; BGHZ 201, 344 marginal no. 23 Geschäftsführerhaftung; Federal Court of Justice, judgment of 15 December 2014 X ZR 30/14, juris marginal no. 111 Glasfasern II [intended for BGHZ]).

19 (b) However, according to established case law, the managing director is also personally liable to third parties if he has a guarantor position that goes beyond his position as a member of the executive body and obligates him to protect third parties from the risk or infringement of their rights protected by Sec. 823(1) Civil Code (BGHZ 109, 297, 303; 125, 366, 375; Federal Court of Justice, judgment of 15 December 2014 X ZR 30/14, marginal no. 111 Glasfasern II). Such a position of guarantor can arise in the case of the managing director from a personal responsibility for third-party rights that is absolutely protected in connection with his responsibility for the organization

and management and the resulting personal influence on hazard prevention and control. In this respect, nothing else applies in principle than for any other person working for a company, insofar as his area of responsibility extends to the protection of the tortious integrity interests of third parties (BGHZ 109, 297, 303).

20 (c) The lawyer who provides legal advice to the owner of the property right with regard to a property right warning likewise has, on the basis of his mandate, considerable possibilities of defense and control with regard to the avoidance of an encroachment on the established and practiced business of a third party by an unjustified warning. He can and must therefore also be expected to exercise the mandate in such a way that the owner of the property right does not decide, under the impression of incorrectly assessing the legal situation, to give a third party an unjustified warning for the infringement of his property right and thereby interfere with his right to the established and practiced business. In this respect, the lawyer has a guarantor obligation towards the third party affected by an unjustified property right warning to advise the property right holder in a legally correct and comprehensive manner about the justification of the property right warning.

21 If the attorney declares a property right warning to be legally unobjectionable and the property right holder consequently decides to warn an alleged infringer, the encroachment on the rights of third parties is based on an at least negligent misjudgment of the legal situation by the attorney if the factual and legal situation at the time of the advice gave reason to deny an infringement of the property right or at least to consider it doubtful.

22 If, on the other hand, the attorney has pointed out to the owner of the property right all essential aspects that speak for or against an infringement of the property right in the case of an unclear legal situation, and if the owner of the property right decides to carry out the warning despite the doubts pointed out, liability of the attorney for unjustified warning pursuant to Sec. 823(1) Civil Code does not normally come into consideration, because the warning is not based on negligent misjudgment of the legal situation in the lawyer's area of responsibility, but on a decision of the property right owner, which he made after advice by the lawyer in the knowledge of the unclear legal situation, which was presented to him correctly and completely.

23 (d) The latter also applies if it is not the property right owner himself who issues the warning to the third party, but this is issued by the lawyer on the instructions of the property right owner in his name. This is because, as an independent organ of the administration of justice, it is the lawyer's task to represent and safeguard the interests of his client in order to protect and pursue his client's rights. Insofar as he expresses himself on behalf of and in the name of a client, he is not acting on his own behalf, but in his function as a lawyer and representative of his client. It is therefore recognized in case law that a lawyer regularly does not adopt as his own a factual situation described to him by his client as a personal assertion when he reproduces it (Federal Court of Justice, judgment of 16 November 2004 VI ZR 293/03, NJW 2005, 279, 281; cf. also Federal Constitutional Court, order of 16 July 2003 1 BvR 801/03, NJW 2003, 3263). In the case of a warning issued by a lawyer on behalf of his client, a legal assessment of a factual assertion with regard to the infringement of the property right and a request to cease and desist are added to the mere statement of facts. However, this does not change the fact that the attorney who acts on behalf of the owner of the property right when issuing the property right warning is clearly not speaking on his own behalf but in the interest of his client and therefore acts exclusively in his function as attorney and representative of his client, which is why the warning cannot be attributed to him as his own as long as he does not act in the knowledge that the property right warning is not justified. The lawyer does not thereby violate a guarantor's duty towards the warned person even if the warning proves to be objectively unjustified.

24 2. The complaint raised by the appeal that the Court of Appeal's finding that the second defendant did not issue the warnings in the knowledge that they were not justified is based on insufficient exhaustion of the plaintiff's evidence.

25 a) In the case of the first warning of 12 March 2007, the Court of Appeal took into account that, in addition to offering and distributing, acts of use were also objected to vis-à-vis the plaintiff's customers, the cessation of which could not be demanded in the case of the only indirect patent infringement in question. However, it did not see in this "excess" any circumstance which would have been capable of decisively influencing the decision of the retailers as to

how they should react to the warning, and therefore assumed that the warning could not have been drafted by the second defendant in the awareness of its non-authorization. This does not reveal any error of law. If, on the other hand, the appeal emphasizes the unjustified objection to individual acts of use in the warning and wants to derive from this an awareness of the lack of authorization of the warning, it is merely substituting its own assessment for that of the court of fact.

26 b) With regard to the second warning of 22 June 2007, the Court of Appeal assumed that it did not mention two decisions of the Regional Court of Mannheim according to which multifeed systems do not make use of the teaching of the patent. However, since the requested cease-and-desist declaration was formulated in such a way that multifeed systems were not covered by it, the Court of Appeal was of the opinion that the "excess" of the warning was of no material significance for its effect, or that it was not issued by the second defendant in awareness of its lack of justification. The appeal also criticizes this assessment without success. It is true that the second warning also contains the statement by the second defendant that "in our opinion" the teaching of the patent is also used by a multifeed system. However, this does not call into question the appraisal of the Court of Appeal that a deliberate misrepresentation of the legal situation cannot be established, especially since the Karlsruhe Higher Regional Court came to the same conclusion in its judgment of 25 February 2009. This is not altered by the fact, also cited by the appeal, that the 2nd defendant acted as counsel in the two proceedings before the Regional Court.

27 c) The appeal also complains without success that the Court of Appeal denied the liability of the 2nd and 3rd defendants on the grounds of unjustified warning of the customer under Sec. 826 Civil Code. In this respect, the Court of Appeal stated that the plaintiff's argument that the insolvent defendant 1 had reached a settlement with the defendant 2 concerning a payment by the defendant 2 on account of incorrect legal advice and that the latter had paid the settlement sum to the two managing partners and their wives as silent partners also spoke against collusive cooperation between the defendants when issuing the warning. Even if, on the other hand, it is assumed

in the appeal that the settlement was economically disadvantageous for the first defendant because the second defendant was subsequently released from liability, while the settlement sum accrued not to the second defendant but to its partners, the Court of Appeal was not obliged to conclude from this that the defendants had already colluded to the detriment of the plaintiff when the warning was issued.

28 d) Finally, the appeal cannot be upheld on the grounds that the Court of Appeal did not sufficiently consider the economic self-interest of the second defendant. Even if it is assumed on the basis of the plaintiff's submissions that the 2nd defendant issued at least 440 warnings for the 1st defendant in March 2007, for each of which reimbursement of costs was demanded in the amount of a 1.3 business fee from a value in dispute of €25,000, and that in June 2007 every warning was issued for the 1st defendant. 000, and in June 2007 at least 313 further warnings were issued, each of which was billed at a 2.0 business fee with a value of € 100,000, it is not objectionable under review law if the Court of Appeal did not conclude from this that the second defendant must have been aware that the warnings were unjustified property right warnings.

29 III. The Senate cannot make a final decision on the merits of the case because the Court of Appeal, logically from its legal standpoint, did not make sufficient findings as to whether the two warnings were unjustified and whether they were based on a negligent misjudgement of the legal situation by the second defendant. 1.

30 The justification of the (second) customer warning of 22 June 2007, which asserted an indirect infringement of the process protected in claim 3 of the patent, depends first of all on whether, from the objectified point of view of a customer as the recipient of the warning, it was to be understood as also being directed against multifeed systems. The Court of Appeal's assumption that the cease-and-desist declaration attached to the warning was worded in such a way that multifeed systems were not covered by it does not necessarily rule this out. Rather, the Court of Appeal will have to take into account that the warning letter expressly states that, in the view of the defendant, reception systems in which switching takes place between several reception converters (i.e., multifeed systems) also made use of the teaching of the patent. In this context, it is not

pointed out that, nevertheless, no claims would be asserted in this respect. It therefore seems possible that the warning had to be understood by the typically not legally trained addressees as meaning that the not completely unambiguously pre-formulated cease-and-desist declaration was also intended to cover multi-feed systems.

31 If the Court of Appeal comes to the conclusion that multifeed systems are also covered by the warning, it will have to examine whether they are objectively suitable for the protected procedure. While the Regional Court of Mannheim answered this question in the negative in its judgments of 6 and 24 October 2006, the Higher Regional Court of Karlsruhe came to the opposite conclusion in its judgment of 25 February 2009. The Court of Appeal did not make any findings in this respect.

32 If it were found that offering or supplying multifeed systems indirectly infringed the process protected in claim 3 of the patent, the warning would not constitute an infringement of the plaintiff's right to its established and practiced trade or business due to a lack of reference to the judgments of the Regional Court of Mannheim, because the Regional Court would then have incorrectly assessed the property rights situation. Whether the warning was nonetheless anti-competitive due to the failure to refer to the differing judicial assessment and whether the second defendant would have been liable for this does not need to be discussed, as the plaintiff cannot have suffered any compensable damage as a result.

33 If, on the other hand, the Court of Appeal comes to the conclusion that the offering and delivery of multifeed systems do not constitute an indirect infringement, a warning that nevertheless extended to this was unjustified in this respect. The court of appeal will then have to examine whether the unjustified warning was based on a negligent misjudgement of the legal situation by the second defendant, because the second defendant did not advise the first defendant correctly and completely about the legal situation.

34 2. The (first) warning of March 2007 was unjustified insofar as it did not merely demand that the plaintiff's customers refrain from acts of indirect infringement of the teaching protected in process claim 3, but rather that they

refrain from acts of direct infringement.

35 Whether the first warning was also partially unjustified with regard to indirect patent infringements depends in turn on whether the operation of multifeed systems was also covered by this warning, and if so, whether the teaching protected in process claim 3 is applied in the operation of multifeed systems. In this respect, the Court of Appeal will also have to examine whether the first warning already claimed too broad protection due to the merely keyword-like designation of the satellite reception systems complained of.

36 If it is found that the first warning was only unjustified to the extent that it demanded the omission of a direct instead of an indirect infringement, the Court of Appeal will also have to examine, irrespective of the question of whether the unjustified warning was based on negligent misadvice by the second defendant, whether and to what extent the plaintiff's right to its established and practiced business was infringed solely by the fact that its customers, who according to the findings of the Court of Appeal were specialist dealers, were also required to refrain from actions that are only prohibited in the event of a direct infringement, namely the manufacture or introduction of satellite reception systems. This will depend on whether such acts could reasonably have been expected at all.

37 3. Whether the two warnings were unjustified already because the patent was later declared null to the extent of claims 3 and 4 asserted therein, so that the effects of the patent are deemed not to have occurred from the outset in this respect (Sec. 21(3) sentence 1 Patent Act in conjunction with Sec. 22(2) Patent Act), however, will not require discussion. In this respect, a negligent misjudgement of the legal situation by the second defendant is ruled out. The appeal does not show any factual argument by the plaintiff from which it follows that the 2nd defendant was not entitled to consider the patent to be legally valid as a whole at the time of the warnings in 2007.

Notice of appeal:

The defaulting party has the right of appeal against this default judgment. This must be filed with the Federal Court of Justice in Karlsruhe by a lawyer admitted to practice before this court within an emergency period of two weeks from service of the default judgment by filing a notice of appeal.

Meier-Beck

Grabinski

Bacher

Hoffmann

Schuster

Previous instances:

Regional Court of Frankfurt at the Main, judgment of 20 July 2011 – 2-6 O 609/10 –

Higher Regional Court of Frankfurt at the Main, judgment of 9 November 2012 – 6 U
161/11 –