

## Deckblatt Übersetzung

### Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2017-01-10
Docket Number / Aktenzeichen:	X ZR 17/13
Name of Decision / Name der Entscheidung:	Vakuumtransportsystem

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



# FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

## JUDGMENT

X ZR 17/13

Pronounced on:  
10 January 2017  
Hartmann  
Judicial Secretary as  
Clerk of the court  
registry

in the restitution proceedings

Vakuumtransportsystem/  
Vacuum transport system

Code of Civil Procedure Sec. 543(2) sentence 1 No. 2, Sec. 544(2) sentence 2, Sec. 580 No. 6, Sec. 582

a) An appeal against a judgment of appeal ruling on patent infringement shall be allowed in order to ensure uniform jurisdiction if the patent is declared null in whole or in part by a final court decision and this deprives the judgment of appeal of its basis. The ground for admission must, if necessary, be asserted within the time limit for reinstatement of the time limit missed in this respect for substantiating the appeal against non-admission (continuation of Federal Court of Justice, order of 6 April 2004 X ZR 272/02, BGHZ 158, 372 Druckmaschinen-Temperierungssystem I).

b) The party cannot assert the lapse of the basis for the judgment by way of an action for restitution if it culpably failed to make the reason for restitution the subject of an appeal against the non-admission of the appeal in the infringement judgment.

Federal Court of Justice, judgment of 10 January 2017 - X ZR 17/13–  
Higher Regional Court of Düsseldorf

ECLI:DE:BGH:2017:100117UXZR17.13.0

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 10 January 2017, attended by the presiding judge Prof. Dr. Meier-Beck, the judges Gröning, Hoffmann and Dr. Deichfuß and the judge Dr. Kober-Dehm

ruled that:

On appeal by the restitution plaintiff, the judgment of the 2nd Civil Senate of the Higher Regional Court of Düsseldorf of 17 January 2013 is reversed.

The matter is referred back to the Higher Regional Court for a new hearing and decision, including on the costs of the appeal proceedings.

By operation of law

Facts of the case:

- 1 The restitution defendant was the proprietor of European patent 333 045 (patent in suit), which was granted with effect for the territory of the Federal Republic of Germany and relates to a vacuum transport system for wastewater. The patent in suit was filed on 9 March 1989, claiming a French priority of 11 March 1988, and expired on 9 March 2009, due to the passage of time. Claim 1 of the patent-in-suit, issued in the language of the proceedings, French, as issued, reads as follows:

"Procédé d'évacuation d'eaux usées par aspiration et refoulement à l'aide d'une pompe dans lequel un collecteur tubulaire (42) est relié par un passage d'aspiration (33) à ladite pompe et reçoit lesdites eaux usées sous la forme de bouchons successifs, ainsi que des masses d'air consécutives à ces bouchons et provenant de l'atmosphère, et ladite pompe aspire ces bouchons et ces masses d'air consécutives en abaissant la pression d'air dans ledit collecteur à une pression d'aspiration inférieure à la pression atmosphérique, et refoule par un passage de refoulement (34) lesdites eaux usées sous une pression d'évacuation supérieure à ladite pression d'aspiration et suffisante pour permettre leur

évacuation, caractérisé par le fait que ladite pompe mise en oeuvre est une pompe à anneau liquide (P) qui est en outre munie d'un passage d'alimentation en eau (19) pour recevoir un débit minoritaire d'une eau d'alimentation propre à former et/ou entretenir un anneau liquide dans cette pompe."

2 On 2 August 2007, the Regional Court ordered the restitution plaintiff, which during the term of the patent in suit manufactured vacuum pumps for installation in vacuum wastewater disposal systems in ships and marketed the models 15 MBD, 25 MBA, 25 MBD and 65 MBA under the designation "Vakuumarator Jets" in the Federal Republic of Germany, to cease and desist, to provide information, to render accounts and to pay damages for indirect infringement of the patent in suit on the basis of patent claim 1 as granted. In its judgment of 13 November 2008, the Higher Regional Court dismissed the appeal filed against this decision with the proviso that the ruling on accounting was slightly amended with regard to the information on the profit generated. It did not allow the appeal. The restitution claimant filed an appeal against this decision. The Federal Court of Justice suspended the appeal proceedings until a final decision had been reached on an action brought by the restitution plaintiff for a declaration of nullity of the patent in suit. By judgment of the Federal Patent Court of 5 May 2011 (10 Ni 21/10 (EU), juris), the patent in suit was declared partially null. Patent claim 1 was thereafter given the following wording:

"A method of removing waste water by suction and conveying with the aid of a pump, in which at least one WC bowl (43) with a water flush and a sealed vacuum drain valve is connected to a tubular collector (42), and in which the tubular collector (42) is connected to the pump via a suction passage (33) and receives the effluents in the form of successive plugs as well as air masses following these plugs and originating from the atmosphere, in which a non-return valve (55) is arranged between the tubular collector (42) and the pump and, upstream of the valve, a vacuum probe (56) measuring the vacuum in the collector which, through a relay (57), can start the pump at a high pressure threshold and stop it at a low pressure threshold, and in which the pump sucks in these plugs and these subsequent air masses by lowering the air pressure in the collector (42) to a suction pressure below atmospheric pressure and discharges the effluents through a delivery outlet (34) at an outlet pressure higher than the suction pressure and sufficient to allow the discharge, using as pump a liquid ring pump (P) which is also provided with a water supply passage (19) to obtain a low flow rate of supply water forming and/or maintaining a liquid ring in said pump. "

3           By order of 20 December 2011 (X ZR 116/11), the Federal Court of Justice rejected the restitution plaintiff's appeal against this as inadmissible because the restitution plaintiff had missed the deadline for substantiating the appeal. By order of 17 April 2012 (X ZR 139/08), the Federal Court of Justice refused a further stay of the appeal proceedings against the non-admission of the appeal, which the restitution plaintiff had requested in view of a renewed patent nullity action filed in the meantime by its patent attorney, and dismissed the non-admission appeal. The second patent nullity action filed by the patent attorney of the restitution plaintiff was dismissed by the Patent Court; the appeal of the plaintiff was unsuccessful (Federal Court of Justice, judgment of 24 May 2016 X ZR 28/14, juris).

4           In its restitution action received by the Court of Appeal on 18 May 2012, the restitution plaintiff claimed that the challenged embodiment no longer constituted indirect infringement of the patent in suit after the partial nullification of patent claim 1 because it did not feature a liquid ring pump containing a vacuum probe measuring the vacuum in the collector. The appellate judgment rendered in the infringement proceedings was therefore to be set aside and the infringement action dismissed. The Court of Appeal dismissed the restitution action. In its appeal, which was allowed by the Senate, the restitution plaintiff continues to seek reversal of the final infringement judgment and dismissal of the action in its entirety. The defendant in the restitution action opposes the appeal.

Grounds of the decision:

5           The admissible appeal is successful. It leads to the reversal of the contested judgment and remittal of the case to the Higher Regional Court.

6           I.       The Higher Regional Court essentially gave the following reasons for its decision:

7           The requirements of Sec. 582 Code of Civil Procedure were not met. The restitution plaintiff had not been unable, through no fault of its own, to assert the reason for restitution in earlier proceedings.

8           The reason for restitution was the partial declaration of nullity of the patent in suit by the judgment of the Federal Patent Court of 5 May 2011. The partial declaration of nullity at the same time constituted a ground for admission to appeal, which the restitution plaintiff could and should have already asserted in the proceedings on the appeal against the non-admission to appeal in the patent infringement proceedings by way of an application for reinstatement of the time limit for substantiating the appeal against non-admission. According to the case law of the Federal Court of Justice, a ground for appeal exists if either the patent in suit has been declared null in its entirety or the Federal Court of Justice has based its decision in the nullity appeal proceedings on an interpretation of the patent which, in a point relevant to the patent infringement proceedings, deviates from that on which the Higher Regional Court based its judgment appealed against in the non-admission appeal. Nothing else could apply to the situation underlying the dispute, in which the restitution plaintiff was convicted of patent infringement on the basis of the granted version and the patent in suit was subsequently declared partially null in nullity proceedings. In this case, too, conflicting decisions in the infringement and nullity proceedings could arise, which should be avoided in the general interest. Therefore, in the case in dispute, the restitution plaintiff should have asserted the partial declaration of nullity of the patent in suit as a ground for appeal in the context of the appeal proceedings on the non-admission of the appeal. It is true that the partial declaration of nullity of the patent in suit only became final on 20 December 2011, after the Federal Court of Justice dismissed the appeal against the judgment of the Federal Patent Court of 5 May 2011, as inadmissible, whereas the time limit for filing the grounds of the appeal against non-admission had already expired on 21 September 2009. However, the Federal Court of Justice had already ruled with regard to the ground for appeal on the grounds of divergent interpretation that this ground, if it only arose after the expiry of the time limit for substantiating the non-admission appeal filed in the infringement proceedings, had to be asserted by means of an application for restitutio in integrum (Federal Court of Justice, reference order of 29 June 2010 X ZR 193/03, Federal Court of Justice 186, 90 Crimp Tool III). In the period between the rejection of the nullity appeal on 20 December 2011, and the rejection of the non-admission appeal on 17 April 2012, the restitution plaintiff had had sufficient

opportunity to introduce into the proceedings the alleged non-use of the features additionally included in patent claim 1 in the course of the partial nullity declaration by means of an application for reinstatement of the missed time limit for substantiating the non-admission appeal. Sec. 234(3) Code of Civil Procedure would not have prevented reinstatement in the case in dispute, since the exceeding of the one-year time limit would not have been within the sphere of the restitution plaintiff. The restitution plaintiff had also culpably omitted to introduce the amendment of the patent claims in the appeal proceedings. As the plaintiff in the nullity proceedings, it had immediate knowledge of the restitution ground of partial nullity. Likewise, it was familiar with the technical features of the challenged embodiment, so that it could have recognized whether the patent in suit in the now relevant version - as alleged in the restitution action - was no longer being used. The decision "Crimping Tool III" had been published in several technical journals as of September 2010 and should therefore have been known to the legal representatives of the restitution claimant. The restitution plaintiff, to whom the negligence of its legal representatives was attributable, should have realized that, according to this decision, it should also have objected to the partial declaration of nullity of the patent in suit already in the non-admission appeal proceedings. At any rate, it should have applied for reinstatement of the time limit for substantiating the appeal of non-admission as a precautionary measure and should have additionally pleaded that the challenged embodiment did not make use of the additional (restrictive) features of the patent in suit. The restitution plaintiff was not entitled to rely on the fact that the Federal Court of Justice, due to the final partial declaration of nullity of the patent in suit, would ex officio allow the appeal and refer the case back to the Court of Appeal. On the basis of the decision of the Federal Court of Justice of 10 November 2009 (X ZR 11/06, GRUR 2010, 272 Produktionsrückstandsentsorgung), the restitution plaintiff should have been aware that an appeal against non-admission would not be successful merely because the patent in suit had been partially declared null after the judgment in the infringement proceedings had been issued. Rather, in view of this case law, the restitution plaintiff should have been aware that the decisive factor is whether the partial annulment removes the challenged embodiment from the scope of protection of the patent in suit.

9           II.       This assessment stands up to review by the Court of Appeal in its initial point, but not in its result. The Higher Regional Court correctly ruled that a party convicted of patent infringement cannot assert the lapse of the basis of the final appeal judgment resulting from the partial declaration of nullity of the patent in suit in infringement proceedings by way of an action for restitution if it culpably failed to make this the subject of an appeal against the non-admission of the appeal which was already pending at the time of the partial declaration of nullity of the patent in suit. In the case in dispute, however, the action for restitution is not precluded because the restitution plaintiff was unable, through no fault of its own, to assert the ground for restitution already in the non-admission appeal proceedings.

10           1.       The Court of Appeal correctly assumed that the action for restitution in actions based on a patent, the existence of which is binding on the court in the infringement dispute, can be based on the fact that the patent was infringed by analogous application of Sec. 580 No. 6 Code of Civil Procedure, that the basis for the judgment has lapsed due to the revocation of the patent in suit in the opposition proceedings or the declaration of nullity in the nullity proceedings, and this also applies if the subject matter of the patent has been restricted in the limitation, opposition or nullity proceedings with final effect in such a way, that the patent in suit has lapsed to the extent of a patent claim whose use by the embodiment considered to infringe the patent has been determined by the infringement court, either completely or by the inclusion of additional features whose use has not been determined (Federal Court of Justice, judgment of 29 July 2010 Xa ZR 118/09, BGHZ 187, 1 marginal no. 12 Bordako; judgment of 17 April 2012 X ZR 55/09, GRUR 2012, 753 marginal no. 13 Ink Cartridge III).

11           2.       However, the action for restitution is generally excluded if the restitution plaintiff has failed to assert the ground for restitution in proceedings of the appeal against non-admission of the revision pending at the time of the complete or partial revocation of the patent.

12           a)       Pursuant to Sec. 582 Code of Civil Procedure, an action for restitution is only admissible if the party was unable, through no fault of his own, to assert the ground for restitution in earlier proceedings, in particular by filing



appropriate appeals. Accordingly, the action for restitution is excluded if the claimant for restitution obtained positive knowledge of the ground for restitution or of the facts giving rise to a ground for restitution before the expiry of the time limit for filing the respective legal remedy or for an application for reinstatement of a time limit for appeal that may already have expired and the submission would have had a chance of success (Zöller/Greger, Code of Civil Procedure, 31st ed., Sec. 582 marginal no. 4). For then there was the possibility of asserting the ground for restitution in the earlier proceedings.

13           b)     The revocation or declaration of nullity of the patent in suit must be asserted as a ground for admission in the proceedings of the appeal against the non-admission of the revision in a judgment ruling on infringement of this patent, if the appellant does not want to lose the corresponding ground for restitution.

14           aa)    However, it is generally not to the disadvantage of the restitution plaintiff if he does not introduce new facts substantiating the ground for restitution in the appeal proceedings.

15           According to the case law of the Federal Court of Justice, new factual submissions on reasons for restitution are admissible in the appeal instance despite Sec. 559(1) sentence 1 Code of Civil Procedure is admissible under certain conditions because, on the one hand, for reasons of procedural economy, grounds for restitution should, as far as possible, be examined in pending litigation instead of referring the party to restitution proceedings to be instituted after the pending litigation has become final, and, on the other hand, there would be highly detrimental consequences for the uniformity and reputation of case law if, in the appellate instance, a judgment rendered without taking into account the new submissions were to contradict the content of a final judgment of another court or were to disregard this judgment (Federal Court of Justice, judgment of 23 November 2006 IX ZR 141/04, NJW-RR 2007, 767 marginal no. 14; judgment of 6 March 1952 IV ZR 80/51, BGHZ 5, 240, 247; judgment of 9 July 1951 IV ZR 3/50, BGHZ 3, 65, 67). In principle, however, it does not constitute an omission precluding a later action for restitution if a party fails to submit in the appeal proceedings new facts of which it only becomes aware in the appeal instance and which could not yet be the subject of the

appeal judgment (Federal Court of Justice, judgment of 27 October 1976 IV ZR 147/75, NJW 1977, 498, 499), since it cannot regularly know whether these facts will be established as undisputed and taken into account in the appeal proceedings. A fortiori, it is not obliged to file an appeal or a complaint against the non-admission of the appeal only with regard to such facts, which are only possibly to be taken into account.

16           bb)    If, however, an appeal against the non-admission of the revision is pending in the patent infringement proceedings or if the time limit for filing such appeal has not yet expired, the party adversely affected by the infringement judgment is obliged to assert the nullity of the patent by means of the appeal.

17           (1)    A change in the patent situation must be taken into account ex officio in the appeal proceedings like a change in the legal situation in the meantime, in contrast to facts justifying a ground for restitution which only arose and became known in the appeal instance (Federal Court of Justice, reference order of 29 June 2010 X ZR 193/03, Federal Court of Justice 186, 90 marginal no. 6 Crimpwerkzeug III). According to the case law of the Senate, it even fills the ground for appeal under Sec. 543(2) sentence 1 no. 2 Code of Civil Procedure. Thus, if patent nullity proceedings and patent infringement litigation are conducted in parallel, revision is to be permitted in the latter upon an admissibly filed complaint of non-admission if the patent in suit has been declared null in whole or in part and this decision has an effect on that in the infringement litigation (Federal Court of Justice, order of 6 April 2004 X ZR 272/02, BGHZ 158, 372, 376 Druckmaschinen-Temperierungssystem I).

18           In contrast to the introduction of new facts in the appeal proceedings, there is therefore no reason for the party benefiting from this not to introduce a change in the legal status of the patent in the appeal proceedings, which can even be used as a basis for allowing the appeal. Rather, in view of the subsidiarity of the restitution action, it is obliged to assert in pending revision proceedings a partial or complete declaration of nullity of the patent in suit which occurred after the judgment of appeal was issued and of which it became aware, in order to achieve a review of whether the assessment of the infringement issue in the judgment of the court of appeal is also valid with regard to the decision in the nullity proceedings. Precisely for this reason, revision proceedings or appeal

proceedings against non-admission of the revision are also generally suspended until the conclusion of pending patent nullity proceedings if the plaintiff requests this.

19           (2) For the proceedings of the appeal against the non-admission of the revision it follows from this that the party benefiting from a complete or partial declaration of nullity of the patent must also assert this declaration of nullity as a ground for admission.

20           This is because the appeal may not be admitted ex officio, but only if a ground for admission is asserted and actually exists or at least existed when the appeal against non-admission was filed (Federal Court of Justice, order of 23 July 2002 VI ZR 91/02, NJW 2002, 3334). The fact that the complete declaration of nullity must be taken into account ex officio in the appeal proceedings cannot therefore alter the fact that it must be asserted in the appeal against non-admission, at least insofar as no other ground for admission is applicable, in order to open the appeal proceedings at all.

21           If the patent in suit has been declared only partially null, it must be added that, unlike in the case of the complete lapse of the patent, this does not necessarily lead to a reversal of the decision granting the infringement action, but only if the change in the property right situation is relevant to the infringement dispute because the challenged embodiment no longer makes use of the amended property right (Federal Court of Justice, order of 10 November 2009 X ZR 11/06, GRUR 2010, 272 marginal no. 1 Production Residue Disposal). Accordingly, the party convicted of patent infringement must show that a ground for allowance has arisen because the findings of the Court of Appeal do not support the assumption that the challenged embodiment also infringes the patent in suit in the version of the claim limited by additional features. There is no need for new factual submissions in this regard; they can only exceptionally gain significance in the revision proceedings to the extent that the plaintiff makes assertions regarding the realization of the additional features, which are not disputed by the defendant.

22           cc) If a complaint of non-admission is pending at the time of the declaration of nullity of the patent and the time limit for substantiating it has

already expired, the complainant is obliged to subsequently assert the ground for admission and to request reinstatement of the (in this respect) missed time limit for substantiation (see Cegl/Voß/Bacher, Prozesskommentar zum Gewerblichen Rechtsschutz, 1st ed, Sec. 544 Code of Civil Procedure marginal no. 51, where it is left open whether the plaintiff has a corresponding obligation; cf. also Cegl/Voß/Tochtermann, Prozesskommentar zum Gewerblichen Rechtsschutz, 1st ed., Sec. 582 Code of Civil Procedure marginal no. 5, who considers the assertion by means of an application for reinstatement to be required in the case of a partial declaration of nullity of the patent in suit). The Federal Court of Justice has already decided this for the case, which is comparable with regard to the procedural situation, that it based its decision in the nullity appeal proceedings on an interpretation of the patent which, in a point relevant to the patent infringement proceedings, deviates from the interpretation on which the Higher Regional Court had based its judgment challenged with the non-admission appeal (BGHZ 186, 90 marginal no. 16 Crimpwerkzeug III).

- 23           (1)    The possibility, which is in principle not available outside of patent infringement proceedings, of being able to assert, by means of an application for reinstatement, a ground for appeal resulting from a change in the patent situation or an interpretation of the patent in suit by the Federal Court of Justice that deviates from the judgment on appeal in patent nullity proceedings after expiry of the time limit for filing the appeal against non-admission, is intended to take into account the interest of the defendant due to patent infringement to be able to defend himself comprehensively against the claim arising from the patent in suit, irrespective of the procedural separation of the attack against the patent in suit from the infringement proceedings. This is also served, as already discussed, by the possibility of a stay of the non-admission appeal proceedings, which gives the defendant the opportunity to file such an application for reinstatement before a decision is made on the non-admission appeal. Provided that the other requirements developed in the case law are met, the Senate even suspends the non-admission appeal proceedings if no further grounds for admission are asserted other than the request for suspension and the ground for admission which is supposed to arise from the outcome of the patent nullity proceedings.

24           If, on the other hand, the infringement defendant does not file a request for a stay, he indicates that he does not expect that the pending patent nullity proceedings will give rise to a ground for allowing an appeal. In this case, the non-admission appeal may be decided without regard to the possible outcome of the nullity proceedings.

25           (2)     It would not be compatible with the sense and purpose of this specific interlocking of patent infringement and nullity proceedings and the subsidiarity of the restitution action if it were at the discretion of the plaintiff to file a request for reinstatement despite a successfully filed request for a stay and notwithstanding a partial declaration of nullity, which has an effect on the existence of the infringement judgment, not to file an application for reinstatement of the time limit for substantiating the appeal against non-admission that had been missed in this respect and not to assert the ground for admission to appeal that has subsequently arisen.

26           3.     In the case in dispute, the action for restitution is admissible under Sec. 582 Code of Civil Procedure, in contrast to the Court of Appeal's assumption, because the restitution plaintiff was unable, through no fault of its own, to assert the ground for restitution in the proceedings for the complaint of non-admission.

27           It is true that the restitution plaintiff, as plaintiff in the nullity proceedings, was aware of the discontinuation of the basis for its conviction in the patent infringement litigation and would therefore also have been in a position to make the necessary presentation in the proceedings on the appeal against the non-admission of the appeal in the infringement litigation, which were still pending at the time of the partial nullification of the patent in suit, that the infringement of the patent in suit did not result from the findings of the Court of Appeal, taking into account the legally limited version of the patent claim. However, in the case in dispute, it cannot be blamed for having failed to assert the reason for restitution of which it was aware already in the non-admission appeal proceedings.

28           a)     A party is also unable, through no fault of its own, to assert the ground for restitution in earlier proceedings if it would actually have been

possible for it to do so but it could assume that it was not legally able to do so or at any rate that it was not obliged to do so.

29           b)     This is the case with the assertion of the lapse of the basis of a patent infringement judgment by the complete or partial declaration of nullity of the patent in suit.

30           aa)    At the time at the beginning of 2012 when the restitution plaintiff should have applied for admission of the revision with regard to the partial declaration of nullity of the patent in suit, it was not only entitled to assume that the change in the legal status of the patent in suit would be taken into account ex officio in the proceedings on the revision whose admission it had applied for. It also had no reason sufficient for fault to assume that the change in the legal status of the patent in suit was not to be taken into account ex officio in the non-admission appeal proceedings.

31           (1)    A ground for admission within the meaning of Sec. 543(2) sentence 1 Code of Civil Procedure cannot in principle arise subsequently. Rather, it must exist when the appeal against non-admission is lodged; only then can it be set out, as required, in the grounds of appeal (cf. Federal Court of Justice, order of 23 July 2002 VI ZR 91/02, NJW 2002, 3334).

32           (2)    In the decision of the Senate of 6 April 2004 (X ZR 272/02, BGHZ 158, 372 Druckmaschinen-Temperierungssystem I), due to the particularities of the legal splitting of the patent dispute in German procedural law into patent infringement and patent nullity proceedings and with regard to the legal requirements for maintaining an effective defense of the infringement defendant with the (counter) attack against the patent in suit (cf. on this also Federal Court of Justice, order of 16 September 2014 X ZR 61/13, BGHZ 202, 288 marginal note 7), the interlinking of both proceedings required, the admission of the revision in case of a subsequent declaration of nullity of the patent in suit was deemed admissible. However, the Senate did not expressly relate the admission of the appeal in these cases to a ground for admission and, in particular, did not discuss the question whether and in which way a ground for admission that may have grown after the expiry of the time limit for filing the appeal against non-admission can still be asserted. The reasons for the decision merely state that

in cases where patent nullity proceedings and patent infringement litigation are conducted in parallel, revision is to be granted in the latter upon admissible appeal against non-admission if the patent on which the proceedings are based has been declared null in whole or in part and this decision may have an effect on that in the infringement litigation (BGHZ 158, 372, 376 Druckmaschinen-Temperierungssystem I). These statements do not indicate that the complete or partial declaration of nullity of the patent in suit is to be asserted as a ground for appeal and that, if necessary, the appellant is to be reinstated in the missed time limit for filing the statement of grounds, but initially only state that in the event of a complete or partial declaration of nullity of the patent in suit, the appeal will be allowed in response to a complaint of non-admission admissibly filed on other grounds.

33           (3) For the first time in the decision "Crimpwerkzeug III" (BGHZ 186, 90 Crimpwerkzeug III), the Senate developed the possibility of reinstatement of the missed time limit for substantiating the appeal against non-admission in the event that the plaintiff wishes to assert an interpretation of the patent in suit by the court of appeal that deviates from a subsequently issued decision of the Federal Court of Justice. In view of the peculiarities of patent litigation, which were not taken into account in the reform of civil procedure law, the Court of Appeal saw this in turn as a special form of the ground for admissibility of securing uniform case law (Sec. 543(2) sentence 1 no. 2 Code of Civil Procedure) (BGHZ 186, 90 nos. 14 f. Crimpwerkzeug III).

34           (4) At the time in question, the decisions "Druckmaschinen-Temperierungssystem I" and "Crimpwerkzeug III" had not been related to each other either in the case law of the Senate or, as far as can be seen, in the literature. In particular, the decision "Crimping Tool III" issued in the middle of 2010 did not lead to the conclusion that the admission of the appeal opened up by "Printing Press Temperature Control System I" in the event of a declaration of nullity of the patent in suit was to be asserted after that decision within the time limit for reinstatement of the reasons for the decision that had been missed in this respect by subsequently asserting the ground for admission of securing a uniform case law. This is not changed by the decision "Produktionsrückstandsentsorgung" (BGH, GRUR 2010, 272), which does not

address the question of the ground for admission and possible reinstatement any more than the decision "Druckmaschinen-Temperierungssystem I".

35           bb)    Against this background, it cannot be assumed that the restitution plaintiff culpably failed to assert the reason for restitution in the appeal proceedings against the non-admission of the appeal in the appeal judgment issued in the infringement proceedings, which were still pending at the time the reason for restitution arose.

36           III.    Insofar as the restitution action is also based on the grounds for appeal on the fact that the interpretation of the patent in suit in the final appeal judgment deviates from the judgment of the Federal Court of Justice of 24 May 2016, and further requests that the order of the Federal Court of Justice of 17 April 2012, by which the appeal against the non-admission of the appeal in that judgment was rejected, be set aside, this request is not admissible. As the Higher Regional Court correctly pointed out, the appeal of non-admission is only admissible against the final appeal judgment in the infringement proceedings that contains the final decision on the merits. The assertion of a further ground for restitution constitutes an amendment to the action, which is not admissible in the appeal proceedings. Moreover, there is no reason for restitution in this respect, since any deviations in the interpretation of the patent in suit would not call into question the validity of the final appeal judgment in the infringement proceedings.



37 IV. Since there is no need for further findings in this respect, the legal dispute is ripe for final decision with regard to the restitution action, which proves to be admissible and well-founded. For a new hearing on the appeal against the judgment of the Regional Court of Düsseldorf of 2 August 2007, taking into account the applicable limited version of the patent in suit, the legal dispute is to be referred back to the Higher Regional Court.

Meier-Beck

Gröning

Hoffmann

Deichfuß

Kober-Dehm

Previous instances:

Higher Regional Court of Düsseldorf, judgment of 17 January 2013 – I-2 UH 1/12 and I-2 U 76/07