

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2021-05-11
Docket Number / Aktenzeichen:	X ZR 23/21
Name of Decision / Name der Entscheidung:	Nichtigkeitsstreitwert III





FEDERAL COURT OF JUSTICE

ORDER

X ZR 23/21

of

11 May 2021

in the patent nullity proceedings

Nichtigkeitsstreitwert III/
Nullity litigation value III

Court Costs Act Sec. 51(1)

The fact that the patent in suit is considered to be standard essential does not in itself justify setting the amount in dispute of the patent nullity proceedings at an amount exceeding the amount in dispute of the infringement proceedings based on this patent by more than one quarter (supplement to Federal Court of Justice, order of 12 April 2011 X ZR 28/09, GRUR 2011, 757 Nichtigkeitsstreitwert I).

Federal Court of Justice, order of 11 May 2021 - X ZR 23/21 –

Federal Patent Court

ECLI:DE:BGH:2021:110521BXZR23.21.0

The X. Civil Senate of the Federal Court of Justice ordered on 11 May 2021 with participation of the presiding judge Dr. Bacher, the judge Dr. Grabinski, the judges Dr. Kober-Dehm and Dr. Marx as well as the judge Dr. Rensen

that:

The litigation value of the appeal proceedings is provisionally set at 1,875,000 euros.

Grounds of the order:

1 I. The defendant is the proprietor of European patent 2 228 933
2 (patent in suit), filed on 26 December 2008, which concerns a device and a
3 method for radio transmission in communication systems with adaptive
4 modulation.

5 When the action for nullity was filed, three infringement proceedings
6 based on the patent in suit were pending. In each of these, the amount in dispute
7 was set at EUR 500,000.

8 The Patent Court declared the patent in suit partially null, dismissing the
9 further action, and ordered the defendant to pay nine-tenths of the costs. The
10 defendant contests this in its appeal.

1 The Patent Court set the amount in dispute for the first instance at 30
2 million euros in view of the fact that the patent in question is a standard essential
3 patent. A counter-appeal by the defendant was unsuccessful.

4 The defendant requests that the amount in dispute for the appeal
5 proceedings be provisionally set at EUR 1,875,000.

6 II. The Senate sets the amount in dispute as requested.

7 1. Sec. 63(1) sentence 1 Court Costs Act provides for the provisional
8 determination of the amount in dispute in cases in which neither a monetary
9 sum is demanded nor a fixed value is provided for by law. These requirements
10 are met.

1 2. The value of EUR 1,875,000 stated by the defendant appears
2 appropriate after preliminary assessment.

3 a) Pursuant to Sec. 51(1) Court Costs Act, the amount in dispute in
4 patent nullity proceedings is to be determined at equitable discretion.

5 According to the established case law of the Senate, the fair market value
6 of the patent at the time the action was filed or at the time the appeal was lodged
7 plus the amount of the claims for damages incurred up to that time shall be
8 decisive (Federal Court of Justice, order of 11 October 1956 - I ZR 28/55, GRUR

1957, 79; order of 7 November 2006 - X ZR 138/04, GRUR 2007, 175 - Sachverständigenentschädigung IV; order of 28 July 2009 - X ZR 153/04, GRUR 2009, 1100 - Druckmaschinen-Temperierungssystem III; order of 16 February 2016 - X ZR 110/13 marginal no. 7).

11 In the absence of other indications, the Senate has consistently applied the (preliminary) determination of the amount in dispute from pending infringement proceedings. This regularly reflects the interest of the invalidity plaintiff in the desired destruction of the patent in suit, by which the basis of the patent infringement action is to be withdrawn. As a rule, this amount is to be increased by 25% to take into account the value of the own use (Federal Court of Justice, order of 12 April 2011 - X ZR 28/09, GRUR 2011, 757, marginal no. 2 et seq. Nichtigkeitsstreitwert I; order of 16 February 2016 X ZR 110/13 marginal no. 7).

12 b) Contrary to the view taken by the Patent Court in setting the amount in dispute at first instance, the fact that the patent in suit is a standard essential patent does not in itself lead to a setting at the maximum value of 30 million euros or to any other increase in the surcharge for own use.

13 However, the Patent Court correctly assumed that a higher surcharge can be considered if special circumstances suggest that the value of the own use is significantly higher than 25% of the infringement value in dispute.

14 However, the fact that the patent in suit is regarded as essential by default is not in itself sufficient to justify such an increase.

15 aa) The fact that the patent in question is essential for access to a certain market is usually already taken into account when determining the amount in dispute in infringement proceedings.

16 The determination of the amount in dispute in infringement proceedings must take into account the importance of the patent in suit for the sale of marketable products and the sales expectations of the right holder based thereon (Federal Court of Justice, judgment of 13 November 2013 - X ZR 171/12, GRUR 2014, 206 marginal no. 16; order of 27 September 1984 - X ZR 53/82, GRUR 1985, 511, 512). This aspect - among others - also flows into a

license forecast used to determine the amount in dispute (Higher Regional Court of Düsseldorf, NJOZ 2010, 2425; GRUR-RR 2011, 341).

17 However, when assessing the expected sales and licensing income, it may also be necessary to take into account the fact that access to the market and the associated income opportunities often do not depend on a single patent, but on a portfolio comprising numerous property rights, and that the outcome of a single infringement suit does not without further ado lead to a noticeable impairment of the market position resulting from this portfolio.

18 bb) The latter aspect is also relevant for the determination of the amount in dispute in nullity proceedings.

19 If the patent challenged by the nullity action is part of a portfolio of numerous property rights which is typically licensed in its entirety, the market position of the owner is usually only marginally affected by the loss of this individual right. This does not result in the own use share or the value of the patent as a whole being assessed as marginal. However, it does have the consequence that a surcharge of 25% on the aggregate amount in dispute of pending infringement proceedings also for such patents generally adequately reflects the value of own use.

20 The circumstance emphasized by the Patent Court that the entitled party often already gains a strong negotiating position if an enforceable cease-and-desist order is issued against an alleged infringer, even from a single patent, does not lead to a different assessment in this respect. This aspect does not concern the own use, but the value which the patent conveys through the possibility of an infringement action. Moreover, a single patent asserted in an infringement suit is in this situation representative of a multitude of other property rights from which the owner can alternatively proceed in case of failure or possibly already proceeds in parallel. Accordingly, it is generally not appropriate to tie the leverage effect emanating from an injunction to this single patent in economic terms.

21 c) Other circumstances which in the case in dispute might make the determination of the amount in dispute in the infringement proceedings appear

inappropriate or might suggest that the amount in dispute in the invalidity proceedings be set at more than 125% of this amount are not apparent on the basis of the present state of facts and of the dispute.

- 22 d) Based on a total infringement value in dispute of 1.5 million euros, a value in dispute of 1,875,000 euros appears appropriate for the nullity proceedings.

Bacher

Grabinski

Kober-Dehm

Marx

Rensen

Previous instance:

Federal Patent Court, judgment of 1 October 2020 – 2 Ni 54/20 (EP)