

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2015-12-15
Docket Number / Aktenzeichen:	X ZR 30/14
Name of Decision / Name der Entscheidung:	Glasfasern II





FEDERAL COURT OF JUSTICE
IN THE NAME OF THE PEOPLE
JUDGMENT

X ZR 30/14

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

in the matter

Glasfasern II/
Fiberglass II

Patent Act Sec. 14; EPC Art. 69

- a) An enterprise which offers or places on the market a product for a certain intended use, the distribution of which is legally permissible only under certain conditions serving the protection of health, thereby indicates under normal circumstances that it considers these conditions to be fulfilled.
- b) If the marketing of a product for a specific intended use is legally permissible only with a health warning, a company that offers or places such a product on the market for this intended use without a corresponding warning indicates under ordinary circumstances that it considers the product to be marketable without a warning.
- c) The legal representative of a company which manufactures a patent-infringing product or places it on the domestic market for the first time shall be liable to pay damages to the infringed party if he fails to take all possible and reasonable measures to set up and control the business activities of the company in such a way that no technical property rights of third parties are infringed thereby.
- d) For the assumption that the culpable infringement of a patent by a company which manufactures a product or introduces it into the domestic market is based on culpable misconduct on the part of its legal representative, as a rule no further statements by the plaintiff and no further findings by the court of facts regarding the relevant actions of the legal representative are required.

Federal Court of Justice, judgment of 15 December 2015 - X ZR 30/14 –
Higher Regional Court of Karlsruhe
Regional Court of Mannheim

ECLI:DE:BGH:2015:151215UXZR30.14.0

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 22 September 2015, attended by the presiding judge Prof. Dr. Meier-Beck, the judges Dr. Grabinski, Dr. Bacher and Hoffmann as well as the judge Dr. Kober-Dehm

ruled that:

The appeal against the judgment of the 6th Civil Senate of the Higher Regional Court of Karlsruhe of 26 February 2014 is dismissed at the expense of the defendant.

By operation of law

Facts of the case:

- 1 The defendant is the proprietor of European patent 399 320 (patent in suit), granted with effect for the Federal Republic of Germany, which concerns the use of glass fibers that do not exhibit carcinogenic potential. Patent claim 1 reads in the language of the proceeding:

"Use of the glass fibers having the following glass composition indicated in mole %:

SiO ₂	55-70	vorzugsweise	58-65
B ₂ O ₃	0-5	vorzugsweise	0-4
Al ₂ O ₃	0-3	vorzugsweise	0-1
TiO ₂	0-6	vorzugsweise	0-3
Eisenoxide	0-2	vorzugsweise	0-1
MgO	1-4		
CaO	8-24	vorzugsweise	12-20
Na ₂ O	10-20	vorzugsweise	12-18
K ₂ O	0-5	vorzugsweise	0,2-3
Fluorid	0-2	vorzugsweise	0-1

and having a diameter of < 8 µm, with more than 10% of the glass fibers having a diameter of < 3 µm, than glass fibers showing no carcinogenic potential, with the proportions of TiO₂, BaO, ZnO, SrO, ZrO₂ being < 1 mol%."

- 2 An action for nullity brought by the second defendant against the patent in suit was unsuccessful in two instances (see Federal Court of Justice, judgment of 20 December 2011 - X ZR 53/11, GRUR 2012, 373 - Glasfasern).
- 3 The second defendant manufactures glass fiber products in sheet form, which are offered in Germany as insulation material. Until 2006, these products were distributed to the building materials trade by a GmbH (limited liability company), in 2007 and 2008 by a limited partnership merged with the latter, whose personally liable partner was the fourth defendant, and since 2009 by the first defendant. The third defendant is the managing director of the first defendant. He was also joint managing director of the former distribution companies.

4 The Regional Court granted the claim seeking a declaration of liability for damages and an accounting for the period from 1 November 1998 to 11 May 2010. The defendant's appeal was essentially unsuccessful. In their appeal, which was allowed by the Court of Appeal, the defendants continue to seek dismissal of the action. The plaintiff opposes the appeal.

Grounds of the decision:

5 The admissible appeal is unfounded.

6 I. The patent in suit relates to the use of glass fibers, which show no carcinogenic potential.

7 1. According to the statements in the patent specifications, it was known in the state of the art that glass fibers can lead to cancer. Decisive for this effect is, among other things, the residence time of the fibers in the lungs. This in turn depends on the size and durability of the fibers. According to a scientific definition drawn up on the basis of findings on the carcinogenic effects of asbestos, such effects can occur with fibers that have a geometric diameter of less than three micrometers, a length of more than five micrometers, and a ratio between length and diameter of more than three to one. A 1986 publication stated that the tumorigenic effect of certain fibers could be reduced by intensive pretreatment with an acid.

8 Against this background, the patent in suit concerns the technical problem of providing glass fibers that do not exhibit carcinogenic potential.

9 2. To solve this problem, the patent in suit proposes in claim 1 the use of glass fibers having the following features:

1. The glass composition comprises the following substances:
 - a) 55 to 70 (preferably 58 to 65) mole percent silicon dioxide (SiO₂),
 - b) 8 to 24 (preferably 12 to 20) mole percent calcium oxide (CaO),

- c) 10 to 20 (preferably 12 to 18) mole percent sodium oxide (Na₂O),
 - d) 0 to 5 (preferably 0 to 4) mole percent boron trioxide (B₂O₃),
 - e) 0 to 3 (preferably 0 to 1) mole percent aluminum oxide (Al₂O₃),
 - f) 0 to 2 (preferably 0 to 1) mole percent iron oxides,
 - g) 1 to 4 mole percent magnesium oxide (MgO),
 - h) 0 to 5 (preferably 0.2 to 3) mole percent potassium oxide (K₂O),
 - i) 0 to 2 (preferably 0 to 1) mole percent fluoride.
2. The following substances are included in the glass composition in a proportion of less than 1 mole percent at most:
- a) titanium dioxide (TiO₂),
 - b) barium oxide (BaO),
 - c) zinc oxide (ZnO),
 - d) strontium oxide (SrO),
 - e) zirconium dioxide (ZrO₂).
3. The diameter is
- a) Less than eight micrometers for all glass fibers,
 - b) less than three micrometers for more than 10% of the glass fibers.
4. The glass fibers are used as glass fibers that do not show carcinogenic potential.

10 II. The Court of Appeal gave the following main reasons for its decision:

11 All features of patent claim 1 were literally realized in the attacked products.

12 This was not contradicted by the fact that it was undisputed that at least 10% of the glass fibers contained in the products had a diameter of eight micrometers or more. Such glass fibers are irrelevant for use for the purpose defined in patent claim 1 from the outset because they are not respirable due to

their large diameter and therefore have no carcinogenic effect. The subject matter of the patent in suit therefore also included the use of products in which glass fibers according to the invention were combined with glass fibers of larger diameter, provided that all glass fibers whose diameter was less than eight micrometers had the properties defined in feature groups 1 to 3. This requirement is fulfilled in the challenged embodiment.

13 The glass fibers contained in the contested products are conspicuously prepared for the use defined in feature 4, in that these products are designed and marketed as building materials for building construction. In the case of such building materials, the risk of cancer must be excluded with sufficient certainty. According to Sec. 23 of the Annex to Sec 1 of the Chemicals Prohibition Ordinance (ChemVerbotsV) in the version applicable since 1 June 2000, mineral fibers of the type in question may only be placed on the market for purposes of thermal and acoustic insulation in building construction if they meet one of three alternatively mentioned criteria. The second of those criteria required that the half-life after intratracheal instillation of two milligrams of a suspension of fibers with a length greater than five micrometers, a diameter less than three micrometers, and a length-to-diameter ratio greater than three to one be no longer than forty days. This was in accordance with the requirements set out in the description of the patent in suit. In view of this, there is at least prima facie evidence that the challenged embodiment is used for a purpose in which the risk of cancer must be excluded at least to the same extent as according to the patent in suit. The defendants had not shaken this prima facie case. The actual carcinogenic potential of the challenged embodiment was irrelevant. Irrespective of this, for the reasons already mentioned, the proof of the prima facie case also speaks in favor of the plaintiff in this respect.

14 For the period before the entry into force of the above-mentioned regulation, nothing else applies in the result. Directive 67/548/EEC, as amended by Directive 97/69/EC of December 5, 1997, provided for an obligation to label mineral fiber products with a warning. This labeling was dispensable if the harmlessness of the product had been established according to certain test methods.

15 III. This holds up in the result of the revision-legal examination.

16 1. The Court of Appeal correctly came to the conclusion that feature 3(a) is also fulfilled if the product used contains glass fibers with a diameter of eight micrometers or more in addition to glass fibers whose diameter meets the requirements defined in feature group 3.

17 a) According to the description of the patent in suit, toxicological efficacy can only be considered for fibers with a diameter of less than three micrometers. In accordance with this, the patent in suit relates to the use of glass fibers of which at least a certain proportion has a diameter below this limit. For such fibers, the requirements defined in feature groups 2 and 3 serve to achieve the intended use despite the potentially hazardous dimensions. In the case of fibers whose diameter is significantly above the limit, there is no need for such measures from the starting point described in the patent specifications, because the achievement of the intended purpose is already ensured by the sufficient size.

18 From this, the Court of Appeal correctly concluded that feature 3 a does not contain a specification for the maximum diameter of all glass fibers contained in the product used, but only specifies that all fibers used whose diameter is smaller than eight micrometers must have the properties defined in feature groups 1 and 2.

19 b) Contrary to the opinion of the revision, no deviating assessment results from the intended use defined in characteristic 4.

20 However, the appeal rightly asserts that the interpretation of patent claim 1 must be based on this intended use. However, the Court of Appeal neither overlooked this requirement nor implemented it in a legally erroneous manner. On the contrary, its conclusion that the presence of fibers with a diameter of eight micrometers and more does not prevent the realization of feature 3(a) is consistent precisely from this point of view. If the intended use defined in feature 4 can already be taken into account by a sufficiently large diameter, there is no need for the additional characteristics defined in feature groups 1 and 2.

21 This is not contradicted by the fact that the upper limit specified in feature 3 a is clearly above the value of three micrometers described as critical in the

description of the patent in suit. Admittedly, with strict orientation to the latter value, it may seem consistent to provide the requirements for the quality defined in feature groups 1 and 2 only for those fibers whose diameter is smaller than three micrometers. However, it cannot be deduced from this that the upper limit provided for in characteristic 3 a serves other purposes and therefore applies to all glass fibers affected by the use. The extension of the size range, to which the special requirements of feature groups 1 and 2 apply, brought about by feature 3 a is rather a kind of safety margin in order to achieve the intended purpose as far as possible even if the assessment of the beginning of the critical size range should prove to be incorrect.

22 c) Contrary to the opinion of the appeal, this understanding does not lead to contradictory results.

23 However, in the example cases formed by the revision that a subset of the glass fibers used fulfills all features of patent claim 1, while the others have a diameter of less than eight micrometers but do not have the properties defined in feature groups 1 and 2, the achievement of the purpose defined in feature 4 would not be ensured. Such uses, however, do not fall within the scope of protection of the patent in suit.

24 As already explained above, according to the patent in suit, all glass fibers with a diameter of less than eight micrometers covered by the use must meet the requirements defined in feature groups 1 and 2. This requirement is precisely not fulfilled in the example case formed by the revision.

25 d) The objection raised by the appeal that in this interpretation the fulfillment of the dimensional requirements of the patent in suit depends on chance finds no basis in the factual findings of the Court of Appeal, as the appeal rejection rightly asserts.

26 There is no indication from the factual findings in the appeal judgment that the size and composition of the glass fibers contained in a product depend on chance. The appeal does not point to any submissions by the defendant which the Court of Appeal might have disregarded in this context.

27 In view of this, it can be left open whether the objection - with which the appeal denies the executable disclosure of the invention, i.e. asserts a ground for nullity - could be asserted at all in the infringement dispute.

28 e) Contrary to the opinion of the appeal, the understanding of the Court of Appeal is not in contradiction to the decision of the discerning Senate in the nullity proceedings.

29 In this judgment, the Senate left open, as the appeal correctly points out in a different context, whether the subject matter of the patent in suit also includes the use of glass fibers with features 1 to 3 in combination with glass fibers of larger diameter (Federal Court of Justice, judgment of 20 December 2011 - X ZR 53/11, GRUR 2012, 373 marginal no. 26 - Glasfasern).

30 No deviating assessment results from the considerations made by the Senate in this context regarding the content of the documents originally submitted. These considerations only relate to the question - which the Senate answered in the negative - whether the transition from the definition of the average diameter to the definition of the largest diameter, which took place in the course of the granting procedure, led to an extension. Nothing can be derived from this for the question of whether, as a result of this change, uses are excluded in which glass fibers with a diameter above the specified upper limit are also used.

31 f) The Senate cannot agree with the foreign decisions submitted by the defendant in which actions based on an infringement of the patent in suit were dismissed.

32 aa) The decision of the Cour d'appel de Paris of 16 May 2014 (RG no 12/06678) is not of decisive importance in the present context.

33 In this decision, the patent in suit was declared null with effect for the French Republic. In the present legal dispute, however, the Senate is bound by the grant of the patent.

34 bb) In its decision of 19 September 2013 (2011/RG/1503), the Cour d'appel de Liège came to the conclusion that an interpretation according to

which the upper limit of eight micrometers provided for in the patent claim does not preclude the use of additional fibers with a larger diameter amounts to the fact that patent claim 1 only contains requirements for the average diameter of the fibers, as had been provided for in claim 1 of the originally filed documents. However, the defendant was not entitled to rely on this reading because the word "medium" had been deleted in the course of the grant procedure. The appeal filed against this decision was dismissed by the Belgian Court of Cassation in its judgment of 12 March 2015 (C.14.0098.F/1).

35 The Senate is unable to share the assessment underlying these decisions in one decisive point.

36 According to the case law of the Senate, events in the grant procedure that preceded the grant of the patent and are not reflected in the patent claim may not be taken into account in the interpretation of the patent (Federal Court of Justice, judgment of 12 March 2002 - X ZR 43/01, BGHZ 150, 161, 162 et seq. = GRUR 2002, 511, 513 et seq. - Kunststoffrohrteil). The Senate has left open whether this principle also prohibits relying on patent publications such as the officially published patent specifications or earlier versions of the patent specification amended later, for example, in opposition proceedings or in limitation proceedings, if the content of the relevant version of the patent specification can only be derived from a comparison with the latter and has thus also led to its being reflected in the latter (Federal Court of Justice, judgment of 10 May 2011 - X ZR 16/09, BGHZ 189, 330, 340 et seq. = GRUR 2011, 701, 704 - Okklusionsvorrichtung; judgment of 4 February 2010 - Xa ZR 36/08, GRUR 2010, 602 marginal no. 33 - Gelenkanordnung). This question does not need to be answered in the dispute either. It would only be relevant to the decision if it were to be inferred from the application that the requirements formulated therein always apply to all glass fibers contained in a specific product. However, this condition is not fulfilled. As the Senate has already stated in its judgment in the nullity proceedings, the fact that the fibers must have an average diameter of less than eight micrometers according to the claim formulated in the application cannot lead to the conclusion that products or uses in which fibers according to the invention are combined with glass fibers of larger

diameter do not form part of the subject matter of the claimed invention (Federal Court of Justice, GRUR 2012, 373 marginal no. 26 - Glasfasern).

37 The claim formulated in the application was directed to a product. The subject matter of the claimed invention thus includes all products that have the features disclosed in the application as belonging to the invention, regardless of how they are used. This includes uses in which products according to the invention are combined with other glass fibers.

38 However, from the requirement formulated in the application that only the average diameter of the fibers must be below the maximum value of eight micrometers, it can be inferred that the subject matter of the application also includes products in which some glass fibers have a diameter of more than eight micrometers, as long as only the average diameter is below this limit. However, it cannot be deduced from this that all glass fibers contained in the respective product must always be included in the calculation of the relevant average value. It can be left open whether it is sufficiently clear from the application how this average value is to be calculated. From the information already contained in the application, according to which toxicological efficacy can only be considered for fibers with a diameter of less than three micrometers, it is in any case clear that glass fibers whose diameter is above the limit of eight micrometers mentioned in the claim do not necessarily have to be included in this calculation. Thus, the notification also contains only an upper limit for the diameter of the glass fibers relevant for the legal assessment, but not the stipulation that a combination with glass fibers of larger diameter is excluded.

39 2. The Court of Appeal did not err in law in concluding that feature 3(b) of the challenged embodiment is also fulfilled as intended.

40 a) The Court of Appeal correctly assumed that the total number of all fibers used is not to be used as the comparative value for determining the percentage specified in feature 3 b, but only the number of fibers used that have a diameter of less than eight micrometers.

41 As has already been pointed out in connection with feature 3 a, the stipulations of patent claim 1 concern only fibers whose diameter is below the

limit specified in feature 3 a. This also applies to the portion of fibers defined in feature 3 b with a diameter below the critical limit of three micrometers according to the description of the patent in suit.

42 b) In view of this, the Court of Appeal rightly considered it irrelevant that in the challenged embodiment the proportion of fibers with a diameter of less than three micrometers in relation to the total number of all fibers used is less than 10%.

43 c) Insofar as the appeal implies that the said percentage is also not reached in relation to the number of fibers used with a diameter of less than eight micrometers, it contradicts the factual findings of the Court of Appeal, as the appellant rightly complains.

44 According to the findings of the Regional Court, more than 10% of the fibers with a diameter of less than eight micrometers also have a diameter of less than three micrometers in the challenged embodiment, as shown by an examination report (B12) submitted by the defendants. According to the factual findings of the Court of Appeal, the defendants did not object to this finding in the appeal. The Court of Appeal considered the test reports submitted in the appeal proceedings (BK6), which show a proportion of less than 10% for other samples, to be irrelevant.

45 The appeal does not challenge these findings. They are therefore to be taken as a basis for the review under appeal law. It follows from them that characteristic 3 a is fulfilled in the challenged embodiment.

46 3. The Court of Appeal rightly concluded that the distribution of the challenged products constitutes a use protected under patent claim 1.

47 a) As the Senate has already stated in the nullity proceedings, the patent in suit covers the use of the glass fibers for all purposes in which the risk of cancer is to be excluded with sufficient certainty (Federal Court of Justice, GRUR 2012, 373 marginal no. 11 - Glasfasern). Requirements in this regard can arise not only from technical contexts, but also from legal requirements (Federal Court of Justice, GRUR 2012, 373 marginal no. 55 - Glasfasern).

48 b) Such legal requirements existed for the use of glass fibers as insulating materials in building construction in the relevant period from November 1998 to May 2010.

49 aa) Since the entry into force of Sec. 23 of the Annex to Sec. 1 Chemicals Prohibition Ordinance on 1 June 2000, glass fibers, which in the opinion of the legislator are to be regarded as (potentially) carcinogenic, may no longer be marketed for the purpose of thermal and acoustic insulation in building construction.

50 The group of fibers affected by this ban is defined in column 1 of the said regulation. According to the provisions in columns 2 and 3, the distribution of such fibers for the above-mentioned purposes is allowed only if they meet one of several criteria established in column 3. These criteria serve the purpose of excluding the risk of cancer or at least reducing it to a level that is acceptable according to the assessment of the legislator.

51 This results in a special, objectively definable intended use for glass fibers, namely the legally compliant use as non-cancer-causing glass fibers for purposes of thermal or acoustic insulation in building construction.

52 bb) It is true that there were no comparable sales bans prior to 1 June 2000. However, according to the findings of the Court of Appeal, which are not challenged in this respect, artificial mineral fibers had to be provided with a warning if their harmlessness had not been established on the basis of specific test methods.

53 This also resulted in a special purpose, namely the use as glass fibers, which may be marketed without a warning label.

54 c) The Court of Appeal was right to regard the marketing of insulating materials for building construction for the period from 1 June 2000 and the marketing of such materials without a warning label in the period prior to that as a reasonable preparation for use as a non-carcinogenic product within the meaning of the relevant legal provisions.

55 aa) According to the established case law of the Senate, a use protected by a patent already includes such acts in which the object is conspicuously prepared for the respective use (Federal Court of Justice, decision of 20 September 1983 - X ZB 4/83, BGHZ 88, 209, 216 f. = GRUR 1983, 729 - Hydroxyridin). The conspicuous presentation can not only be achieved by a special design of the product, but also by instructions for use in the form of a package insert or in any other way (Federal Court of Justice, judgment of 21 November 1989 - X ZR 29/88, GRUR 1990, 505, 506 f. - Geschlitzte Abdeckfolie).

56 bb) For the period from 1 June 2000 onwards, the Court of Appeal correctly considered the fact that products containing artificial mineral fibers within the meaning of Section 23 of Annex I to Sec. 1 Chemicals Prohibition Ordinance are offered or placed on the market for the purpose of thermal and acoustic insulation in building construction to be an obvious preparation for the aforementioned use.

57 In this context, it can be left open which explanatory value can be attributed to such actions in connection with claims of the purchasers under purchase law or tort law. If an entrepreneur offers or places on the market a product for a certain purpose, which may only be offered or placed on the market under certain conditions due to legal requirements, he thereby indicates that he considers these conditions to be fulfilled, at least under normal circumstances. This applies at least when it comes to basic requirements, compliance with which serves to protect health. A supplier who markets such products without pointing out possible restrictions or doubts creates the impression that no prohibited health hazards emanate from his products.

58 In the case in dispute, according to the findings of the Court of Appeal, which are not challenged in this respect, the defendants marketed the challenged products as insulation material for construction purposes. Thus, with regard to the aforementioned rules of the Chemicals Prohibition Ordinance, the products have been prepared for the legally compliant use as non-carcinogenic glass fibers. Special circumstances, from which a deviating evaluation could result, are not determined and are not asserted by the revision.

59 cc) The same applies to the period before 1 June 2000.

60 If the marketing of a product for a specific intended use is only permitted with a health warning, an entrepreneur who offers or markets such a product without a corresponding warning for this intended use indicates under normal circumstances that he considers the product to be marketable without a warning. In this context, too, it can be left open whether this applies to any indication of any danger. From the point of view of potential customers, which is decisive in this respect, a marketing activity is to be understood in the sense described at any rate if it involves compliance with elementary rules for the protection of health. These rules already included, in the period between 1998 and 2000, the rules for labeling fiberglass products as potentially carcinogenic.

61 By marketing the challenged products as insulating material for construction purposes, the defendants have conspicuously prepared the products for use in conformity with the law as glass fiber, which may be marketed without a warning.

62 d) As a result, the Court of Appeal correctly assumed that a conspicuous preparation for use as a product that is not hazardous to health within the meaning of the relevant legal provisions also constitutes a conspicuous preparation for the use defined in characteristic 4.

63 aa) As the Senate has already stated in its appeal judgment in the nullity proceedings, glass fibers which do not show any carcinogenic potential are to be regarded as glass fibers according to the content of the patent specification in suit, for which there is no significant connection between the uptake of the material via the human lungs and the development of a cancer (Federal Court of Justice, GRUR 2012, 373 marginal no. 12 - Glasfasern).

64 According to the relevant explanations in the description of the patent in suit, a significant connection in this sense exists if the glass fibers cause a disease rate of more than about 10% within a period of two years in the animal tests described in the patent specification (Federal Court of Justice, GRUR 2012, 373 marginal no. 13 - Glass fibers). Feature 4 of the patent in suit is

therefore fulfilled if the glass fibers are clearly prepared for an application for which a corresponding maximum value is prescribed.

65 bb) The Court of Appeal was correct in deciding that the use as insulating material in building construction in the period from 1 June 2000 met this requirement.

66 (1) The version of the Chemicals Prohibition Ordinance that came into force on 1 June 2000 makes the placing on the market of artificial mineral fibers as insulating material for building construction dependent on the cancer risk posed by the fibers being sufficiently low.

67 It is true that Sec. 23 of the Annex to Sec. 1 of the Chemicals Prohibition Ordinance does not define an exact maximum value for the expected morbidity rate. However, it can be inferred from the regulatory context that the requirements defined there coincide with the requirements resulting from characteristic 4.

68 According to column 3 of Sec. 23, the marketing of fibers is permitted if one of four alternatively listed criteria is met. The first of these criteria establishes the abstract requirement that an appropriate intraperitoneal test has not expressed evidence of excessive carcinogenicity. The other criteria provide maximum values for the half-life of certain types of fibers or the difference between the mass contents of certain ingredients. No further explanation is given as to why these maximum values are important. However, from the systematic connection with the first criterion it can be inferred that the legislator regards these maximum values under the respective defined boundary conditions as a suitable indication that there is no excessive carcinogenicity.

69 (2) The patent in suit is based on comparable considerations.

70 The second of the criteria listed in Sec. 23 of the Annex to Sec. 1 Chemicals Prohibition Ordinance, which according to the findings of the Court of Appeal, which are not challenged, is realized in the challenged products, provides that the half-life in the case of intratracheal instillation of two milligrams of a suspension of fibers with a length of more than five micrometers, a diameter of less than three micrometers and a length-to-diameter ratio of more than three

to one must not exceed forty days (according to the version in force from June 1. June to 30 September 2000: a maximum of 65 days).

71 A similar criterion is also used in the patent-in-suit.

72 In the description of the patent-in-suit it is stated that the results of the tests carried out clearly showed that fibers with a high half-life had a high carcinogenic potential (paragraph 29). For fibers of sample B used in embodiment example 1 with a length of more than five micrometers, half-lives between 36 and 42 days with a mean value of 39 days are given (para. 26). Particular attention is therefore paid to the fiber length mentioned because fibers with a length of more than five micrometers, a diameter of less than three micrometers and a ratio between length and diameter of more than three to one are to be regarded as biologically effective (para. 21).

73 (3) It is sufficiently clear from this that the degree of hazard is sufficiently low within the meaning of characteristic 4 if the fibers have a half-life as also provided for in the second criterion of Sec. 23 of the Annex to Sec. 1 Chemicals Prohibition Ordinance.

74 Contrary to the opinion of the Court of Appeal, however, this cannot be based on the principles of prima facie evidence. The question of whether the requirements of the Chemicals Prohibition Ordinance coincide with those of feature 4 of the patent in suit is a question of law in the present context. The intended use defined in feature 4 is exhausted by the requirement of a sufficiently low cancer risk. From the explanations in the description of the patent in suit, which are to be used for the interpretation of this feature, there are only indications as to what risk can still be considered acceptable, but not additional requirements for the material or spatial-physical properties of the fibers, which go beyond the requirements defined in feature groups 1 to 3. The question of whether the requirements resulting from characteristic 4 are consistent with those of the Chemicals Prohibition Ordinance is therefore not to be answered on the basis of a comparison of the actual properties of certain fibers with the requirements of the Ordinance, but on the basis of a comparison of the normative requirements from characteristic 4 with those from the Ordinance.

75 The necessary comparison of the two specifications shows that they are congruent in all points relevant to the decision. Both the regulation and feature 4 are based on the abstract requirement of a sufficiently low cancer risk. A half-life of forty days, among other things, is used as sufficient evidence for this in both the regulation and the patent in suit. From this it can be inferred that the same level of protection is involved.

76 The fact that a half-life of a maximum of forty days is prescribed in the regulation, whereas a half-life of 42 days is regarded as sufficient in the description of the patent in suit (paragraph 13), does not lead to a different assessment. The mentioned value represents an upper limit. Feature 4 is therefore also fulfilled in the case of a use to which slightly stricter requirements apply.

77 (4) The question raised by the defendants as to whether the statements in the patent specifications are correct from a scientific point of view is irrelevant.

78 As has already been explained, feature 4 does not give rise to any requirements as to the nature of the fibers, but only to requirements as to the use for which the patent grants protection. For the realization of the patent features, it is therefore sufficient if the fibers have the properties defined in feature groups 1 to 3 and are used for purposes for which special requirements apply with regard to the resulting cancer risk. This requirement is fulfilled in the case of the challenged products because the fibers contained therein exhibit the characteristics of groups 1 to 3 and because they are conspicuously prepared for a use in which the cancer risk must not exceed the limit specified in characteristic 4. Whether the cancer risk actually remains within the specified limits when the fibers are used as intended is irrelevant to the realization of the patent features.

79 (5) Also irrelevant is whether a test using the method of intratracheal instillation described in the patent specifications would result in a tumor rate of no more than 10% for the challenged products.

80 This criterion is mentioned in the description of the patent in suit in order to specify the intended use defined in feature 4. However, it cannot be inferred from this that the cancer risk must always be determined on the basis of tests with intratracheal instillation. In the description of the patent in suit, both the half-life after intratracheal instillation (paragraph 24 ff.) and the tumor rate after intraperitoneal injection (paragraph 36 ff.) are used to assess the cancer risk. In addition, it is stated that the carcinogenic potential depends on the half-life (para. 29). From this it can be inferred that a sufficiently low carcinogenic risk in the sense of characteristic 4 - in accordance with the regulation in Sec. 23 of the Annex to Sec. 1 Chemicals Prohibition Ordinance - is already to be affirmed if one of the criteria presented as suitable for this in the description is realized. The challenged products meet this requirement because they comply with the second criterion of the Ordinance. Therefore, it can be left open whether a use in accordance with the patent would also have to be affirmed if the attacked products were not suitable for the use for which they are conspicuously designed.

81 cc) Nothing else applies to the period from November 1998 to May 2000.

82 It is true that the regulations referred to by the Court of Appeal for this period do not provide any binding specifications for the cancer risk that can still be considered acceptable. However, the requirement of harmlessness applicable at that time for a distribution without a warning label is likewise only met if the risk of cancer can be ruled out with sufficient certainty. The Directive 97/69/EC cited by the Court of Appeal, which entered into force on 16 December 1997 and was to be implemented within one year, already provided criteria in this regard that correspond to those of the later Chemicals Prohibition Ordinance and which, among other things, also rely on a half-life of less than forty days. In view of this, the distribution of glass fibers without a warning label was already at that time subject to conditions that corresponded to the requirements resulting from characteristic 4.

83 e) Contrary to the opinion of the appeal, infringement of the patent in suit is not excluded because products with the properties defined in feature

groups 1 to 3 were already marketed as insulation material for construction purposes before the priority date.

84 aa) In the infringement dispute, such sales activities would at most be relevant from the point of view of a right of prior use under Sec. 12 Patent Act. However, it has neither been established nor asserted that the defendants had already distributed the challenged products for the intended use set forth in feature 4 prior to the priority date.

85 bb) Irrespective of this, the distribution of such products without a warning notice did not yet constitute a use for the purpose set out in feature 4 as long as it was not subject to any legal restrictions.

86 As the appeal correctly asserts in its approach and as the Senate has already stated in the nullity proceedings (Federal Court of Justice, GRUR 2012, 373 marginal no. 55 - Glasfasern), the use of a substance for a specific purpose is admittedly possible even if it is not known which scientific relationships are decisive for achieving the intended effect. In the case in dispute, however, the obvious preparation for the use defined in feature 4 only results from the legal restrictions to which the distribution was subject according to the findings of the Court of Appeal in the relevant period from 1998. The fact that comparable restrictions already existed before the priority date has neither been established nor asserted.

87 Contrary to the opinion of the appeal, it does not follow from this that the scope of protection of the patent in suit was subsequently extended due to newly gained knowledge about the hazard potential of optical fibers. The scope of protection of the patent in suit was and is, as the Senate has already stated in the nullity proceedings (Federal Court of Justice, GRUR 2012, 373 marginal no. 55 - Glasfasern), limited to uses for which the risk of cancer caused by the fibers must be excluded on the basis of legal or other requirements. If such requirements are only introduced or tightened after the patent in suit has been granted, this may lead to an increase in the need to use the protected use. However, this does not constitute an extension of the scope of protection. 4.

88 4. The finding pronounced by the Regional Court and confirmed by
the Court of Appeal does not go beyond what is permissible under formal and
substantive law.

89 a) An infringement of Sec. 308(1) sentence 1 Code of Civil Procedure
is neither alleged nor evident.

90 The operative part of the first-instance judgment corresponds to the claim
insofar as it concerns the description of the acts obligating the claimant to pay
damages. For the interpretation of this request, which in this respect essentially
corresponds to the wording of patent claim 1, the statement of grounds for the
action must be consulted in addition (see Federal Court of Justice, judgment of
21 February 2012 - X ZR 111/09, GRUR 2012, 485 marginal no. 23 -
Rohrreinigungsdüse II). However, even taking these into account and making
additional reference to the reasons for the decision, there are no indications that
the Regional Court or the Court of Appeal awarded the plaintiff more than it had
requested.

91 The Regional Court referred to fiber optic products as the challenged
embodiment, which are offered, among others, under three product
designations also listed in the statement of claim. In addition, it stated that the
challenged embodiments are sold nationwide to building material dealers,
where they can be purchased by consumers for use as insulation material in
board form. These considerations, which are essentially identical in wording in
the appeal judgment, are largely based on the description of the challenged
embodiment in the statement of claim and offer no indication that the Regional
Court or the Court of Appeal assumed that the subject matter of the dispute
went beyond this.

92 b) On the other hand, there are also no indications that the Regional
Court or the Court of Appeal intended to award the plaintiff less than requested
in this respect. Both instances did indeed dismiss the action in part. However,
they considered the claim to be partially unfounded only in terms of time.

93 The declaratory interest required under Sec. 256(1) Code of Civil
Procedure is not lacking for the requested and awarded declaratory judgment.

94 aa) According to the established case law of the Federal Court of Justice, claims for injunctive relief, provision of information and damages may exist beyond the specific infringing act for acts in which the characteristic of the infringing act is expressed.

95 For claims for injunctive relief, this is based on the fact that an infringing act gives rise to the presumption of a risk of repetition not only for the identical form of infringement, but for all infringing acts that are essentially similar (see only Federal Court of Justice, judgment of 20 June 2013 - I ZR 55/12, GRUR 2013, 1235 marginal no. 18 - Restwertbörse II). As a rule, nothing else applies to applications for a declaration of liability for damages. It is true that an obligation to pay damages may theoretically also arise from future acts with regard to which there is no risk of repetition or first offence. In the absence of such a risk, however, there is usually no sufficient interest in the judicial determination of such claims.

96 bb) The finding pronounced by the Regional Court and confirmed by the Court of Appeal does not go beyond the limits of what is permissible thereunder.

97 As already explained above, the finding pronounced by the Regional Court and confirmed by the Court of Appeal corresponds to the claim insofar as the description of the challenged embodiment is concerned. Contrary to the opinion of the plaintiff, this in turn does not refer to all embodiments falling within the scope of protection of the patent, but only to glass fiber products sold for use as insulating material for construction purposes.

98 This is not contradicted by the fact that the wording of the claim essentially corresponds to the wording of claim 1. From the fact that a plaintiff omits to formulate a claim tailored to the challenged embodiment submitted by him, it cannot in principle be inferred that he intends to direct his action against further embodiments. In such cases, too, the interpretation of the claim - which the Senate as the Court of Appeal must make itself - must be based on the arguments put forward in support of the claim (Federal Court of Justice, judgment of 21 February 2012 - X ZR 111/09, GRUR 2012, 485 marginal no. 23 - Rohrreinigungsdüse II).

99 In the case in dispute, the plaintiff stated both in the statement of grounds for the action and in its reply that the action was not only directed against products with the three designations given by way of example, but against all fiberglass products of the first defendant that originated from the second defendant's plant and exhibited the listed properties. It is not the product designations that are decisive, but the technical characteristics.

100 Accordingly, the relevant characteristic properties include not only the properties defined in feature groups 1 to 3, but also the use relevant for the realization of feature 4. In this regard, the plaintiff stated that the challenged products are building materials and may therefore only be placed on the market under the condition that they are not carcinogenically hazardous. The obvious preparation for this purpose results from the fact that the end products are offered and marketed as building material products, for example as partition wall insulation boards.

101 It follows from this that the action is not directed per se against every glass fiber product with the features of the patent in suit, but only against products that are marketed as building materials. Moreover, the characteristic features of the challenged embodiment include its obvious preparation as an insulating material, because the provisions of the Chemicals Prohibition Ordinance, on which the majority of the claim is based, apply only to this.

102 In contrast, the fact that the products have the shape of a board and are sold via the building materials trade is not part of the characteristic properties of the challenged embodiment. A connection between the spatial form of the end products and the realization of the patent features is neither shown nor otherwise evident. It is true that distribution via the building materials trade represents a typical form of the use defined in feature 4. However, it is not the distribution channel that is decisive for the assessment under patent law, but the intended use by the end user.

103 5. There is also no legal error in the fact that the introductory sentence of the pronounced statement refers to the damage that the plaintiff has suffered and is still suffering, while the specification for the individual

defendants only refers to the damage that the plaintiff suffered in the respective periods indicated.

104 Even if this formulation were to be regarded as contradictory, this contradiction could be resolved by interpreting the operative part of the judgment with reference to the reasons for the decision. The Regional Court and the Court of Appeal only dealt with the temporal scope of the liability for damages from the aspect of which acts of infringement the individual defendants were liable for. From this and from the fact that the version of the claims on which the first instance judgment is based was filed at a time when the patent in suit had already lapsed due to the passage of time, it is sufficiently clear that the finding also relates to damages which were caused by acts within the respective time period mentioned, but which only occurred or will occur later.

105 6. Without any error of law, the Court of Appeal also considered the claim to be well-founded to the extent awarded against the third defendant.

106 The Court of Appeal did not make any more detailed findings as to the specific actions by which the third defendant was involved in the acts of infringement on which the action is based. However, explicit findings in this regard were not necessary in the given constellation.

107 a) The Senate has so far not objected to the fact that, in the wake of a patent infringement, not only a company but also its legal representatives have been ordered to cease and desist and to pay damages (see, for example, Federal Court of Justice, judgment of 16 September 2003 - X ZR 179/02, GRUR 2003, 1031, 1033 - Kupplung für optische Geräte). The I. Civil Senate has generally affirmed liability of the legal representative for an infringement of intellectual property rights committed by the company at least if the legal representative was aware of the infringing acts and did not prevent them (most recently Federal Court of Justice, judgment of 19 April 2012 - I ZR 86/10, GRUR 2012, 1145 marginal no. 36 Pelikan).

108 In more recent times, the I. Civil Senate has taken the view both for acts of infringement in the area of unfair competition (Federal Court of Justice, judgment of 18 June 2014 I ZR 242/12, BGHZ 201, 344 = GRUR 2014, 883 -

Geschäftsführerhaftung) and for infringements of Sec. 95(3) Copyright Act (Federal Court of Justice, judgment of 27 November 2014 - I ZR 124/11, GRUR 2015, 672 marginal no. 80 - Videospiegel-Konsolen II) the view that a legal representative is liable for infringing acts of the company only if he participated in them by positive action or if he had to prevent them on the basis of a guarantor position established under general principles of tort law. The VI. Civil Senate has developed similar principles for the infringement of rights protected under Sec. 823(1) Civil Code (Federal Court of Justice, judgment of 5 December 1989 - VI ZR 335/88, BGHZ 109, 297, 302 et seq.; judgment of 10 July 2012 - VI ZR 341/10, BGHZ 194, 26 marginal no. 24).

109 b) Whether the approach taken by the cognizing Senate to date is fully in line with these principles does not need to be decided in the present context. The findings made by the Court of Appeal also lead, on the basis of the last approach outlined, to a guarantor obligation on the part of the third defendant and to his liability to the extent pronounced by the Court of Appeal.

110 aa) According to the case law described above, a guarantor position for the protection of the legal interests of third parties does not already arise from the duties incumbent on the legal representative, for example under Sec. 43(1) Limited Liability Company Act or Sec. 93(1) sentence 1 Stock Corporation Act, vis-à-vis the company.

111 Duties arising from the position as a corporate body to manage the business properly exist in principle only vis-à-vis the Company. In the event of a breach of these duties, therefore, only the company is entitled to claim damages (BGHZ 109, 297, 303; BGHZ 194, 26 para. 23; BGHZ 201, 344 para. 23 - Managing Director's Liability; Federal Court of Justice, judgment of 13 April 1994 II ZR 16/93, BGHZ 125, 366, 375). Personal liability requires a guarantor position going beyond this, on the basis of which the legal representative is personally required to protect outsiders from endangerment or infringement of their rights protected by Sec. 823(1) Civil Code.

112 bb) A guarantor position may exist in particular if the protection of the rights of third parties is an organizational task to which the legal representative is first and foremost called (BGHZ 109, 297, 304).

113 However, it is not sufficient for this either that the company has legal obligations towards third parties. For example, the position as a corporate body and the general responsibility for business operations do not in themselves give rise to an obligation vis-à-vis outside third parties to prevent breaches of competition by the company (BGHZ 201, 344, para. 23 - Geschäftsführerhaftung). If, on the other hand, the protection of the absolute rights of third parties is involved, a personal responsibility of the executive body towards the affected third parties, which goes beyond the executive body's position, may come into play in connection with the responsibility for the organization and management and the resulting personal influence on the prevention and control of danger. In this respect, nothing else applies in principle to the personal liability of the managing director than to 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). In this case, too, the mere existence of an absolutely protected right is not sufficient to establish a guarantor's duty. However, it can be considered in any case if the person concerned has entrusted an object of protection to the company's sphere of influence or if, for other reasons, a concrete situation of danger exists for the object of protection and the managing director or employee of the company is responsible for controlling that company activity from which the situation of danger arises (cf. BGHZ 109, 297, 304). In these cases, the liability of the managing director does not follow from his position as managing director as such, but from the actual and legal possibility and reasonableness - independent of the legal form of the company - of controlling a hazardous situation for absolutely protected rights of third parties.

114 cc) With regard to the protection of patents, these requirements are typically fulfilled at any rate if an enterprise manufactures technical products or introduces them into the domestic market.

115 For practically every field of technology, a large number of patents are in force covering a wide variety of subject matter. Therefore, before starting one of the mentioned activities, a company must check whether its products or processes fall within the scope of protection of third party rights (cf. Federal Court of Justice, judgment of 14 January 1958 - I ZR 171/56, GRUR 1958, 288,

290 - Dia-Rähmchen I; judgment of 3 March 1977 - X ZR 22/73, GRUR 1977, 598, 601 - Autoskooterhalle; judgment of 29 April 1986 - X ZR 28/85, BGHZ 98, 12, 24 = GRUR 1986, 803, 806 - Formstein).

116 This obligation is not based solely on the general duty to protect the legal interests of others. Rather, it is an expression of the increased risk to which technical property rights are typically exposed. The protection resulting from such rights, which in any case exists only for a limited period of time, would not be adequately ensured if other market participants attached only secondary importance to the question of whether their activities infringe third-party property rights.

117 By virtue of his responsibility for the organization and management of business operations and the associated risk that these may be set up in such a way that the company's production or sales activities result in the continuous infringement of third parties' technical property rights, the legal representative of a company is therefore in principle required to arrange for the necessary checks to be carried out or to organize business operations in such a way that the fulfillment of this duty is ensured by employees responsible for this. In particular, he must ensure that fundamental decisions on the company's business activities are not made without his consent and that the company's employees entrusted with development, production and distribution take the necessary precautions to avoid infringement of third party patents.

118 dd) In this initial situation, it is generally not necessary to make any further findings that the culpable infringement of a patent by a company is based on culpable misconduct on the part of its legal representatives.

119 In view of the special risk situation described above and the great importance attached to an examination of the property right situation, the fact that a culpable patent infringement has occurred generally indicates that the legal representatives have culpably violated the duties incumbent upon them in this respect (cf. also Benkard/Grabinski/Zülch, 11th edition, Sec. 139 Patent Act marginal no. 22). For this reason, the infringed party - who in principle has the burden of presentation and proof for all claim requirements - regularly has no reason to elaborate on the personal responsibility of the managing director. As

a rule, he also does not have the opportunity to provide more detailed information in this regard because it concerns internal processes of the infringer into which he has no insight.

120 Instead, the legal representative of the infringing company may have a secondary burden of proof with regard to the question of how he has fulfilled his obligations. In this context, the legal representative of the infringing company may have to explain in particular why it had no reason to reserve a decision on the challenged actions and which organizational measures it took to prevent an infringement of property rights by employees of the company.

121 The factual findings of the Court of Appeal, which are not challenged in this respect, do not reveal any submission by the defendant in this regard. The Court of Appeal was therefore right to conclude that the third defendant is also obliged to pay the plaintiff damages and render accounts to the extent awarded.

122 c) Whether the third defendant is also liable for the infringements committed because it contributed to them through its own actions - which, according to the more recent case law of the First Civil Senate, must be assumed if the plaintiff is to be held liable for the infringements committed. Civil Senate, this can already be assumed if the infringement is based on conduct which, according to its external appearance and in the absence of deviating findings, is to be attributed to the legal representative, in particular if it concerns measures which are typically decided on at management level (Federal Court of Justice, GRUR 2015, 672 marginal no. 83 - Videospiele-Konsolen II) - does not need to be decided in view of this.

123 IV. The decision on costs is based on Sec. 97(1) and Sec. 100(1)
Code of Civil Procedure.

Meier-Beck

Grabinski

Bacher

Hoffmann

Kober-Dehm

Previous instances:

Regional Court of Mannheim, judgment of 17.04.2012 – 2 O 129/09 –

Higher Regional Court of Karlsruhe, judgment of 26.02.2014 – 6 U 50/12 –