

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:

Date of Decision / Datum der Entscheidung:

Docket Number / Aktenzeichen:

Name of Decision / Name der Entscheidung:

Bundesgerichtshof

2021-06-08

X ZR 47/19

Ultraschallwandler



Arbeitskreis
Patentgerichtswesen
in Deutschland e.V.



FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

JUDGMENT

X ZR 47/19

Pronounced on:
8 June 2021
Anderer
Judicial Secretary as
Clerk of the court
registry

in the matter

Ultraschallwandler/
Ultrasonic transducer

Patent Act Sec. 139(2), Sec. 140a(3) sentence 1

- a) If a manufacturer domiciled abroad has supplied a customer also domiciled abroad with products, although concrete indications made it appear obvious that the customer will offer or market the supplied goods in Germany despite the existence of patent protection there, claims for injunctive relief, provision of information and damages exist with respect to other customers only to the extent that the same characteristic circumstances exist with respect to these that justify the unlawfulness of the supply to the one customer.
- b) These circumstances must be specifically described in the application for relief or in the statement of grounds for the action as well as in a judgment upholding the action or its reasons (continuation of Federal Court of Justice, judgment of 16 May 2017 - X ZR 120/15, BGHZ 215, 89 marginal no. 62 et seq. - sealing system).

Federal Court of Justice, judgment of 8 June 2021 - X ZR 47/19 –
Higher Regional Court of Hamburg
Regional Court of Hamburg

ECLI:DE:BGH:2021:080621UXZR47.19.0

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 8 June 2021, attended by the presiding judge Dr. Bacher, the judges Dr. Grabinski and Hoffmann, the judge Dr. Kober-Dehm and the judge Dr. Rensen

ruled that:

On appeal by the defendant, the judgment of the 3rd Civil Senate of the Hanseatic Higher Regional Court of 25 April 2019 is set aside with regard to costs and insofar as it dismisses the appeal by the first defendant against the finding of liability for damages in the judgment of the Regional Court of Hamburg of 22 May 2015.

To the extent that it is set aside, the matter is referred back to the Court of Appeal for a new hearing and decision, including on the costs of the appeal.

By operation of law

Facts of the case:

1 The plaintiff is the proprietor of German patent 199 37 195 (patent in suit), which was filed on 6 August 1999, and whose grant was published on 9 March 2006. The patent-in-suit relates to an ultrasonic transducer that can be used as part of parking assistance systems for motor vehicles. Claim 1 reads:

An ultrasonic transducer (1) having a housing (2), having a diaphragm (3), having a piezoelectric element (13) arranged on the diaphragm (3), having a retaining element (4) which is formed in a rubber-like manner and retains the diaphragm (3) in the housing (2), and having a conductor track element (14) which is connected to the piezoelectric element (13), the retaining element (4) having a first portion for sealing with respect to the housing (2), characterized, in that the holding element (4) has a further second section which adjoins the first section and projects beyond the housing in the axial direction and has a cone (5), the cone receiving the diaphragm (3) in a sealing manner in the region of its tapering end and being provided for sealing contact against a holder (24) which receives the ultrasonic transducer (1), and the diaphragm (3) projecting beyond the housing (2) and the cone (5) in the axial direction. "

2 Defendant 1 ("Defendant"), a company located in the Republic of China (Taiwan), manufactures automotive parts and accessories, including ultrasonic transducers, at production facilities in China and Taiwan. It is a supplier to numerous automobile manufacturers, including R. /D. .

3 By letter dated 22 November 2012, the plaintiff contacted the defendant and asked it to explain on what grounds it was entitled to use the patent-in-suit by supplying R. with ultrasonic transducers used in D. L. type vehicles.

4 Ultrasonic transducers manufactured by the defendant were also placed on the market in Germany by R. /D. after 22 December 2012.

5 The Regional Court dismissed the action insofar as it was directed against another company and two managing directors, but ordered the

defendant to cease and desist, provide information and render an accounting, and determined its obligation to pay damages. The Court of Appeal essentially dismissed the defendant's appeal (Higher Regional Court of Hamburg, GRUR-RR 2020, 234).

6 At the hearing before the Senate, the plaintiff and the defendant unanimously declared the legal dispute resolved with regard to the claims for injunctive relief, provision of information and rendering of accounts.

7 With regard to the pending application for a declaratory judgment on the liability for damages, the defendant continues to pursue the goal of dismissing the action. The plaintiff opposes this.

Grounds of the decision:

8 The admissible appeal is well-founded. With regard to the part of the subject matter of the dispute still pending after the concurrent declaration of partial settlement, it leads to the reversal of the contested judgment and to the remittal of the case to the Court of Appeal.

9 I. The patent in suit concerns an ultrasonic transducer which is used in particular for parking aids.

10 According to the claims in the patent application, the diaphragm of such an ultrasonic transducer should be capable of oscillating and tightly mounted. In addition, the ultrasonic transducer should form a uniform plane with the vehicle surrounding it for optical, aerodynamic and aeroacoustic reasons (para. 2). In order to prevent the ingress of dust, dirt or moisture and the associated impairment of the ultrasonic transducer, it must be appropriately sealed (Par. 5). A simple design and a simple and inexpensive assembly were also desirable, as well as a positionally accurate arrangement of the ultrasonic transducer in a holder accommodating the ultrasonic transducer (Para. 6 f.).

11 As the Senate has already stated in nullity proceedings relating to the patent-in-suit, the task underlying the property right is to provide an ultrasonic transducer that is designed to be as simple and reliable as possible with regard to the mounting of the diaphragm, its external shape, its sealing against the environment, its structure and its assembly (Federal Court of Justice, judgment of 20 March 2018 - X ZR 4/16, juris, marginal no. 6).

12 According to the teaching of patent claim 1, this is to be achieved by a device with the following features:

1. Ultrasonic transducer with a housing,
2. with a diaphragm,
3. with a piezo element arranged on the diaphragm,
4. with a rubber-like holding element which holds the diaphragm in the housing, and
5. with a conductor track element connected to the piezo

element,

6. the retaining element having a first section for sealing with respect to the housing,
7. the retaining element having a further second section which adjoins the first section and projects beyond the housing in the axial direction and has a cone,
8. the cone receiving the diaphragm in a sealing manner in the region of its tapering end, and
9. being provided for sealing abutment against a mounting receiving the ultrasonic transducer
10. and wherein the diaphragm projects beyond the housing and the cone in the axial direction.

13 Figure 2 of the patent in suit reproduced below shows an example of an ultrasonic transducer according to the invention in longitudinal section:

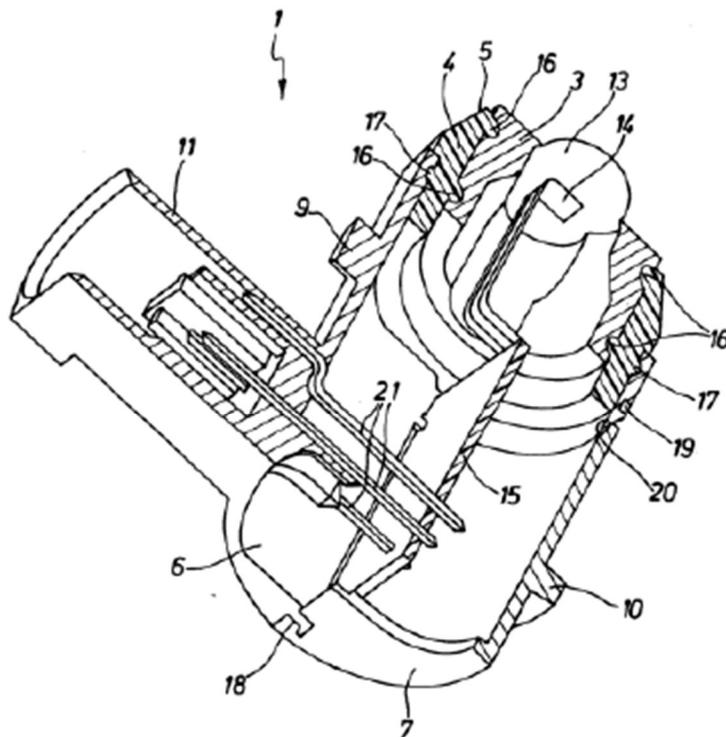


Fig. 2

14 II. The Court of Appeal gave the following main reasons for its

decision:

- 15 The challenged embodiment makes use of the teaching of the patent in suit. In this embodiment, the piezo element is electrically connected by the conductive membrane and a wire. Thus feature 5 is realized. The skilled person understands by a conductive track element only the presence of a current-conducting connection to the piezo element. It is not necessary to have a component on or in which several electrical connections (conductive tracks) run, as is the case, for example, with a conductor foil or a printed circuit board. The only task of the conductor element is to supply the piezo element with current. Further requirements for the design are also not to be taken from the description. If Figure 2 were to show a conductor foil, this would merely be an example of an embodiment with a flexible conductor track element described as advantageous in the description. The technical particularities of the transducer according to the invention would not lie in the power supply of the piezo element, but in the design of the holding element. Feature 5 is realized in the challenged embodiment because it has a current-carrying wire for supplying the piezo element.
- 16 The defendant was also responsible for the fact that the challenged embodiment had reached the German market. A supplier domiciled abroad of a customer also domiciled abroad is only obliged to check and monitor the further use of the delivered goods by the customer if there are concrete indications that the customer continues to deliver the delivered goods in Germany or offers them there. However, the defendant had such indications due to the plaintiff's authorization request of 22 November 2012, which included the allegation that the contested ultrasonic transducers had entered the German market in vehicles of the D. L. type. As the manufacturer of the ultrasonic transducers, the defendant had also been able to recognize that they were subject to the patent in suit.
- 17 The operative part of the Regional Court judgment also does not impose unreasonable or unmanageable obligations to act and pay on the defendant. The defendant is only liable for the conduct of third parties who receive the converters at the instigation of the defendant and then offer, use, import or possess them in Germany for the aforementioned purposes. Even insofar as

the conviction was not limited to the purchaser R./D., the defendant would not be subject to excessively far-reaching inspection obligations. The prohibition imposed covers the characteristic of the infringing act and thus also acts similar to the core, which are characterized by the culpable promotion of another party's patent infringement in breach of duty.

18 III. This assessment does not stand up to review by the court of appeal on one point.

19 1. The complaint of the appeal that the Court of Appeal erred in law by interpreting the term "conductive track element" in feature 5 too broadly does not hold.

20 a) The Court of Appeal correctly assumed that the description and the drawings are to be taken into account for the interpretation of a patent claim (Article 69(1) EPC; Sec. 14 Patent Act).

21 In this context, it is not the wording of the individual terms that is to be taken into account, but the overall technical context that the content of the patent specification conveys to the skilled person. Not the linguistic or logical-scientific determination of the terms used is decisive, but the understanding of the unbiased skilled person (Federal Court of Justice, judgment of 2 March 1999 - X ZR 85/96, GRUR 1999, 909, 911 - Spanschraube). Within the scope of the interpretation, the meaning of the patent claim in its entirety and the contribution that the individual features make to the performance result of the invention are to be determined (Federal Court of Justice, judgment of 17 July 2012 - X ZR 117/11, GRUR 2012, 1124 marginal no. 27 - Polymerschaum). The patent specification is to be read in a meaningful context and a patent claim is, in case of doubt, to be understood in such a way that no contradictions arise with the description and the drawings. Only if and to the extent that the teaching of the patent claim cannot be reconciled with the description and the drawings and an irresolvable contradiction remains, the elements of the description or the drawings which have not been reflected in the patent claim may not be used to determine the subject matter of the patent (Federal Court of Justice, judgment of 10 May 2011 - X ZR 16/09, GRUR 2011, 701 marginal no. 24 - Okklusionsvorrichtung; Federal Court of Justice, judgment of 2 June 2015 - X

ZR 103/13, GRUR 2015, 972 marginal no. 22 - Kreuzgestänge).

22 b) According to these principles, the interpretation of the Court of Appeal, which as a finding of law is subject to full review by the appellate court (settled case law, see only Federal Court of Justice, judgment of 31 March 2009 - X ZR 95/05, BGHZ 180, 215 marginal no. 16 = GRUR 2009, 653 - Straßenbaumaschine; Federal Court of Justice, judgment of 29 June 2010 - X ZR 193/03, BGHZ 186, 90 marginal no. 15 = GRUR 2010, 858 - Crimpwerkzeug III), is not objectionable.

23 aa) For the determination of what is to be understood by a conductive track element according to the invention, the Court of Appeal correctly started from the term of a conductive track, which technically characterizes this word combination, and defined it as a conductive track, i.e. an electrically conductive connection.

24 According to feature 5, the conductive track element is connected to the piezoelectric element so that the latter can be supplied with current via an electrically conductive connection. Therein lies the contribution of the conductive track element to the performance result of the claimed invention.

25 bb) It does not follow from the use of the term conductive track in the plural (conductive track element) that several electrical connections to the piezo element must exist. The power supply to the piezo element does not require a plurality of electrical connections, but can also be provided via a single electrical connection. Nor is there any indication in the patent specification that the invention is limited to embodiments with multiple electrical connections.

26 cc) The understanding of the conductor track element according to the invention as an electrically conductive connection with the piezoelectric element is consistent with the description and the drawings.

27 It is true that it follows from the description that in an advantageous embodiment the conductor track element can be designed to be flexible, whereby the number of individual strands which have to be contacted at the piezo element can be reduced (para. 18). In addition, with regard to the embodiment example in Figure 2, in which the conductor track element is shown

as a conductor foil, it is explained that the use of such a flexible conductor track element 14 and a rubber-like holding element 4 ensures that the diaphragm 3 can vibrate freely (Para. 33). However, all of the above are advantageous embodiments of the conductor track element which have not found expression in the teaching of patent claim 1.

28 dd) The aforementioned understanding of feature 5 is not changed even if it is assumed, according to the defendant's argument to be taken as a basis for the assessment under the law of review, that the skilled person understood a conductor track to be a flat conductive connection applied to a carrier, especially in data processing and in automotive engineering.

29 However, as the appeal rightly asserts in this respect, it is not decisive whether the solution according to the patent offers something "new" with regard to the piezo element and the way in which it is supplied with current and, from this point of view, represents a "significant" feature for the teaching according to the invention. Rather, what is decisive is what contribution the conductor track element makes to the result according to the invention. Even when applying this standard, however, there is no deviating result.

30 As already explained above, the contribution of the conductor track element to the performance result according to the invention consists solely in the production of a conductive connection, while its two-dimensional design is of no significant importance in this respect. It follows from this that the patent in suit uses the term in a manner deviating from the above understanding.

31 c) On this basis, the Court of Appeal correctly came to the conclusion that the wire connection used in the ultrasonic transducer objected to as infringing constitutes a conductive element within the meaning of patent claim 1.

32 d) The findings of the Court of Appeal, which are not challenged, that all further features of this claim are also fulfilled, do not reveal any legal error. 2.

33 2. The Court of Appeal rightly considered the defendant responsible for the fact that the ultrasonic transducers manufactured by it were distributed

in Germany.

- 34 a) According to the case law of the Senate, not only the person who intentionally participates in the use of the protected subject matter by a third party may be jointly liable for a patent infringement, but also the person who enables the use of the protected subject matter by a third party through his own conduct in breach of duty (Federal Court of Justice, judgment of 17 September 2009 - Xa ZR 2/08, BGHZ 182, 245 marginal no. 34 - MP3-Player-Import). However, if the contribution to causation is not based on intent, its attribution generally requires the violation of a legal duty by the actor, which also serves to protect the violated absolute right and if the contribution to causation had been observed, it would have been omitted or at least would have been recognizable as a prohibited contribution of the actor to the unlawful act of a third party, which therefore had to be omitted (BGHZ 182, 245 marginal no. 36 - MP3-Player-Import).
- 35 Accordingly, a supplier of a product protected by a patent in Germany who is domiciled abroad and who supplies a customer who is also domiciled abroad is not automatically obliged to check or monitor the further use of the delivered goods by the customer. However, such an obligation to review or monitor may arise if there are concrete indications for him that make such actions appear obvious (Federal Court of Justice, judgment of 16 May 2017 - X ZR 120/15, BGHZ 215, 89 = GRUR 2017, 785 marginal no. 62 - Abdichtsystem).
- 36 Concrete indications for a further delivery into the domestic market may result, for example, from the fact that the supplier has become aware of an actual or concretely imminent further delivery, that the purchased quantity is so large that it can hardly be distributed only on markets free of property rights, or that the purchasing behavior correlates conspicuously with a perceptible and potentially infringing activity of the customer on the domestic market (BGHZ 215, 89 marginal no. 64 - Abdichtsystem).
- 37 b) In the case in dispute, the Court of Appeal correctly decided that such sufficiently concrete indications of an infringement of the patent in suit by the customer R. /D. arose for the defendant from the plaintiff's letter of 22 November 2012.

38 According to the findings of the Court of Appeal, it was obvious in view of the geographical location and the economic circumstances that deliveries to the European Union would be made on a large scale from production facilities in Morocco. Against this background, the information contained in the letter of 22 November 2012 that the converters supplied by the defendant to R. would be used in vehicles of the type D. L. substantiated concrete evidence for the assumption of a patent-infringing distribution of the converters in Germany. On the other hand, according to the findings of the Court of Appeal, there was no concrete evidence that the R. /D. plants responsible for the German market also purchased such converters from other suppliers.

39 c) The assumption of concrete indications for a review of the deliveries of the challenged converters to Germany does not depend on whether the letter of 22 November 2012 was written as an authorization request or as a warning.

40 Concrete indications that would justify a review obligation on the part of the Defendant arise from the information contained in the letter regarding the delivery of certain vehicle types to Germany. The information content of such communications does not depend on whether the patent proprietor at the same time threatens legal action or merely requests a statement.

41 d) Thus, after receipt of the letter of 22 November 2012, the defendant was at least obliged to inform its customer R. /D. about the possible patent protection in Germany and to inquire about deliveries there. Since this was not done, the defendant participated in the acts of infringement committed by its customer in Germany even after 22 December 2012 according to the findings of the Court of Appeal.

42 3. The appeal rightly complains that the determination of the obligation to pay damages confirmed by the Court of Appeal also relates to offers and deliveries to other customers abroad.

43 a) As in other areas of law (see, for example, for trademark law: Federal Court of Justice, judgment of 23 February 2006 - I ZR 27/03, BGHZ166, 233 marginal no. 36 - Parfümtestkäufe; for copyright law: Federal Court of

Justice, judgment of 20 June 2013 - I ZR 55/12, GRUR 2013, 1235 marginal no. 18 - Restwertbörse II), however, claims for injunctive relief, provision of information and damages may also exist in patent law - insofar as there is a risk of repetition - beyond the specific infringing act to the extent of such acts in which the characteristic of the infringing act is expressed.

44 In a patent infringement action, the characteristic core is usually determined by the actual embodiment of a specific product, usually referred to as the challenged embodiment, with regard to the features of the asserted patent claim, which is at the same time decisive for the determination of the subject matter of the dispute (in this respect Federal Court of Justice, judgment of 21 February 2012 - X ZR 111/09, GRUR 2012, 485 marginal no. 19 - Rohrreinigungsdüse II).

45 b) In the case in dispute, it is not only a matter of generalizations with regard to the contested product, but also of generalizations with regard to the circumstances under which a delivery is made in a patent-free foreign country.

46 In cases involving the offering or marketing of protected products in Germany by the defendant himself, this aspect is of no significance, because the infringement in these circumstances does not depend on the person of the purchaser, but solely on the place where the offering or marketing takes place.

47 In contrast, the acts abroad challenged in the dispute are only patent-infringing if special indications are discernible from which an obligation to review or monitor on the part of the defendant arises. Generalizations are therefore only admissible insofar as they express the characteristic circumstances which justify the unlawfulness of offering or supplying to a particular customer.

48 These characteristic circumstances may not be described solely to the effect that particular indications of deliveries or offers in Germany were discernible. Otherwise, the dispute as to whether certain offers or deliveries are covered by a cease-and-desist order, an order to provide information and render accounts or the determination of an obligation to pay damages would be shifted to the enforcement proceedings or a subsequent legal dispute as to the amount of damages. Rather, it must at least be clear from the plaintiff's submissions and

from the reasons for a decision upholding the action which characteristic elements of the facts of life justify a duty to review or monitor and therefore constitute the core of the prohibited action or the action obligating the plaintiff to pay damages.

49 c) The finding pronounced by the Regional Court and confirmed by the Court of Appeal does not meet these requirements.

50 aa) The operative part of the contested decisions refers to supplying or allowing to be supplied to other persons who offer, place on the market or use the impugned ultrasonic transducers in Germany without the consent of the plaintiff or who import or possess them for the aforementioned purposes.

51 It cannot be inferred from this under which conditions the defendant is obliged to pay damages due to the actions of third parties. Rather, it would have to be clarified in a subsequent legal dispute on the amount of damages whether the defendant also had concrete indications of deliveries or offers in Germany with regard to other customers.

52 The wording "to deliver or cause to be delivered to third parties" does, as the Court of Appeal rightly assumed in principle, only cover targeted action, which is why the defendant would not have to be liable without further ado for the conduct of any company in a supply chain. However, it does not indicate which characteristic circumstances distinguish impermissible actions from permissible ones.

53 bb) It cannot be inferred from the statements of the Court of Appeal that the challenged design was marketed in Germany "in particular" by R./D. that the defendant had concrete indications, if applicable also with regard to other customers, which made deliveries or offers in Germany appear obvious. A fortiori, it cannot be inferred from which characteristic circumstances such indications arose.

54 cc The reference to certain illustrations in which transducers supplied to R. /D. are shown is also not sufficient for a description of the characteristic core.

55 Neither the operative part nor the grounds of the judgment under appeal
indicate which elements of the object depicted constitute the characteristic core.

56 IV. The legal dispute is not ripe for final decision (Sec. 563(3) Code of
Civil Procedure).

57 1. In the absence of factual findings by the Court of Appeal, the
Senate is unable to assess whether the defendant was aware of concrete
indications which made it appear obvious that the delivered goods were
forwarded to Germany or offered there, also with regard to further customers
domiciled abroad, and by which characteristic circumstances these indications
were substantiated.

58 In the reopened appeal proceedings, the Court of Appeal will therefore
have to give the plaintiff the opportunity to supplement its submissions in this
regard and, if necessary, to file relevant motions. Corresponding new
submissions by the plaintiff would also still be admissible in the appeal
proceedings because these relate to a point of view which the court of first
instance recognizably considered to be irrelevant (Sec. 531(2) No. 1 Code of
Civil Procedure).

59 2. The versions of the application submitted by the plaintiff to the
Senate in the oral proceedings as a substantive minus to the previous
application also do not allow a final decision.

60 a) The addition of the words "to third parties" sought in the first
instance by the words "with regard to which the first defendant had concrete
indications that they deliver to the Federal Republic of Germany" merely leads
to an abstract description of the conditions of a patent infringement. On the other
hand, it does not describe any characteristic circumstances on the basis of
which it could be assessed in subsequent proceedings, without recourse to the
abstract requirements, whether a specific act is covered by the requested
declaration.

61 b) The alternatively sought replacement of the expression "to third
parties" by "to R. SAS or affiliated companies" does not indicate, at least with
regard to affiliated companies, what the characteristic circumstances are that

give rise to an obligation to pay damages. Moreover, a conviction on this basis could not take place anyway without first giving the defendant the opportunity to make additional factual submissions.

Bacher

Grabinski

Hoffmann

Kober-Dehm

Rensen

Previous instance:

Regional Court of Hamburg, judgment of 22 May 2015 – 315 O 110/13 –

Higher Regional Court of Hamburg, judgment of 25 April 2019 – 3 U 87/15 –