

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2017-10-24
Docket Number / Aktenzeichen:	X ZR 55/16
Name of Decision / Name der Entscheidung:	Trommeleinheit



Arbeitskreis
Patentgerichtswesen
in Deutschland e.V.



FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

JUDGMENT

X ZR 55/16

Pronounced on:
24 October 2017
Anderer
Judicial Secretary as
Clerk of the court
registry

in the matter

Trommeleinheit/
Drum unit

Directive 2009/125/EC

In principle, no third-party rights arise from a voluntary agreement in which companies have committed themselves to the European Commission to comply with certain standards for the purpose of environmental protection in order to avoid mandatory regulation by the Commission pursuant to Art. 15 of Directive 2009/125/EC.

Patent Act Sec. 9 sentence 2 No. 1

- a) For the assessment of the question whether the replacement of parts of a device placed on the market with the consent of the patent proprietor belongs to the intended use or constitutes a new production, the protected product is to be used as the relevant point of reference. This also applies if the person entitled has placed a copy of the protected product (here: an image drum unit) on the market as a component of a more comprehensive object (here: a process cartridge).
- b) If a patent claim protects a product consisting of several parts, but the person entitled only puts into circulation objects which again comprise further components and therefore an actual conception of the market cannot be established with regard to the protected product, the delimitation between intended use and new production shall be based solely on whether the technical effects of the invention are reflected precisely in the replaced parts (supplement to judgment of July 17, 2012 - X ZR 97/11, GRUR 2012, 1118 - Palettenbehälter II).

ECLI:DE:BGH:2017:241017UXZR55.16.0

Federal Court of Justice, judgment of 24 October 2017 - X ZR 55/16 –
Higher Regional Court of Düsseldorf
Regional Court of Düsseldorf

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 24 October 2017, attended by the presiding judge Prof. Dr. Meier-Beck, the judges Gröning, Dr. Grabinski and Dr. Bacher as well as the judge Dr. Marx

ruled that:

On appeal by the defendant, the judgment of the 15th Civil Senate of the Higher Regional Court of Düsseldorf of 29 April 2016 is set aside and the judgment of the 4a Civil Chamber of the Regional Court of Düsseldorf of 11 June 2015 is amended.

The action is dismissed.

The plaintiff shall bear the costs of the legal dispute.

By operation of law

Facts of the case:

1 The plaintiff brings a claim against the defendants for direct patent infringement through the sale of remanufactured toner cartridges for laser printers and the like.

2 The plaintiff is the owner of European patent 2 087 407 (patent in suit), which was granted with effect for the Federal Republic of Germany and relates, inter alia, to a photosensitive drum unit for an electrophotographic image-forming device. Claim 1 reads in the language of the proceeding:

"An electrophotographic photosensitive drum unit (B) usable with a main assembly of an electrophotographic image forming apparatus, the main assembly including a driving shaft (180) to be driven by a motor, having a rotational force applying portion, wherein said electrophotographic drum unit is dismountable from the main assembly in a dismounting direction substantially perpendicular to an axial direction (L3) of the driving shaft, said electrophotographic drum unit comprising:

- i) an electrophotographic photosensitive drum (107) having a photosensitive layer (107b) at a peripheral surface thereof, said electrophotographic photosensitive drum being rotatable about an axis (L1) thereof;
- ii) a coupling member (150) rotatable about an axis (L2) thereof, engageable with the driving shaft (180) to receive a rotational force, from the rotational force applying portion, for rotating said electrophotographic photosensitive drum (107) said coupling member is provided at an axial end of said electrophotographic photosensitive drum (107) such that said coupling member (150) is capable of taking a rotational force transmitting angular position

substantially co-axial with said axis (L1) of said electrophotographic photosensitive drum (107) for transmitting the rotational force for rotating said electrophotographic photosensitive drum (107) to said electrophotographic photosensitive drum (107) and a disengaging angular position in which said coupling member (150) is inclined away from the axis (11) of said electro photographic photosensitive drum (107) from said rotational force transmitting angular position for disengagement of the coupling member (150) from the driving shaft (180),

wherein said electrophotographic drum unit (B) is adapted such that when said electrophotographic drum unit (B) is dismounted from the main assembly in the dismounting direction substantially perpendicular to the axis (L1) of said electrophotographic photosensitive drum (107) said coupling member (150) moves from said rotational force transmitting angular position to said disengaging angular position."

3 In claim 25, a cartridge comprising a drum unit having the features of claim 1 or one of the subclaims related thereto is placed under protection, in claim 29, an electrophotographic image forming apparatus comprising a drive shaft and a drum unit having the features of claim 1.

4 The plaintiff produces toner cartridges comprising a drum unit with an image drum, a flange and a coupling element (so-called process cartridges) and sells them as original equipment and consumables for the copiers and printers it offers. Some of its products are sold by another supplier under its brand.

5 The plaintiff has concluded a voluntary agreement with other suppliers (Industry voluntary agreement to improve the environmental performance of the imaging equipment placed on the European market, available at <http://www.eurovaprint.eu/pages/voluntary-agreement>), in which it has undertaken to comply with certain standards for the purpose of environmental

protection. In version 4 of December 3, 2012, which is relevant to the dispute, it states under No. 4.4:

"4.4 Cartridges

For all products placed on the market after 1 January 2012:

4.4.1 Any cartridge produced by or recommended by the OEM for use in the product shall not be designed to prevent its reuse and recycling.

4.4.2 The machine shall not be designed to prevent the use of a non-OEM cartridge.

The requirements of paragraph 4.4 shall not be interpreted in such a way that would prevent or limit innovation, development or improvements in design or functionality of the products, cartridges, etc."

6 The 1st Defendant sells remanufactured process cartridges in Germany via the 3rd Defendant, among others, which can be used instead of original cartridges from the Plaintiff. Defendant 2 is the Chairman of the Board of Defendant 1 and Managing Director of Defendant 3.

7 For the purpose of remanufacturing, the 1st defendant uses used cartridges that were originally marketed by the plaintiff. In doing so, it replaces the used image drum and, if necessary, also the flange with new, functionally identical parts that do not originate from the plaintiff. From these components and an original coupling element, it creates a functional drum unit, which it installs in the used cartridge.

8 In accordance with the claims based on patent claim 1, the Regional Court ordered the defendants to cease and desist, provide information and render an invoice, and additionally ordered the first and third defendants to destroy and recall the product, and found that the defendants were obligated to pay damages to the plaintiff. The defendants' appeal was unsuccessful.

9 In their appeal, which was allowed by the Court of Appeal, the defendants continue to pursue their motion to dismiss the action. The plaintiff opposes the appeal.

Grounds of the decision:

10 The admissible appeal is well-founded and leads to the dismissal of the
action.

11 I. The patent in suit relates to a process cartridge, an
electrophotographic image forming apparatus (hereinafter: apparatus) and an
electrophotographic photosensitive drum unit.

12 1. According to the description of the patent in suit, state of the art
devices were known in which the image drum is arranged in a removable
process cartridge and is connected to a drive shaft via a journal. The
disadvantage of this embodiment is that the drive shaft must be moved
horizontally away from the cartridge for assembly and disassembly.

13 Against this background, the patent in suit concerns the technical
problem of simplifying the assembly and disassembly of the cartridge.

14 2. To solve this problem, the patent in suit proposes in claim 1 a drum
unit whose features can be divided as follows:

1. An electrophotographic photosensitive drum unit comprising:
 - (a) an electrophotographic photosensitive drum (107)
 - (b) and a coupling component (150).
2. The electrophotographic drum unit (B) is
 - a) usable with a main assembly of an electrophotographic image forming apparatus, the main assembly including a drive shaft (180) to be driven by a motor and having a rotational force applying portion,
 - b) disassemblable from the main assembly in a disassembly direction substantially perpendicular to an axial direction (L3) of the drive shaft,
 - c) arranged such that the clutch member (150) moves from the rotational force transmitting angle position to the release angle position when disassembled from the main assembly in the disassembly direction substantially perpendicular to its axis (L1).
3. The electrophotographic photosensitive drum (107)
 - a) has a photosensitive layer (107b) on an outer surface; and
 - b) is rotatable about an axis (L1).

4. The coupling component (150) is
 - a) rotatable about an axis (L2),
 - b) engageable with the drive shaft (180) to receive a rotational force from the rotational force application section to rotate the electrophotographic photosensitive drum (107),
 - c) provided at an axial end of the electrophotographic photosensitive drum (107) such that it is capable of,
 - aa) assume a rotational force transmitting angular position substantially coaxial with the axis (L1) of the electrophotographic photosensitive drum (107) to transmit the rotational force to rotate the electrophotographic photosensitive drum (107), and
 - bb) assume a release angular position in which it is inclined away from the axis (L1) of the electrophotographic photosensitive drum (107) and the rotational force transmitting angular position to release the clutch member (150) from the drive shaft (180).

15 3. The coupling component (150) is of central importance. This enables the cartridge to be assembled and disassembled without horizontal movement of the drive shaft, because it can be pivoted between two different angular positions.

16 This function is illustrated in Figure 22 of the patent in suit:

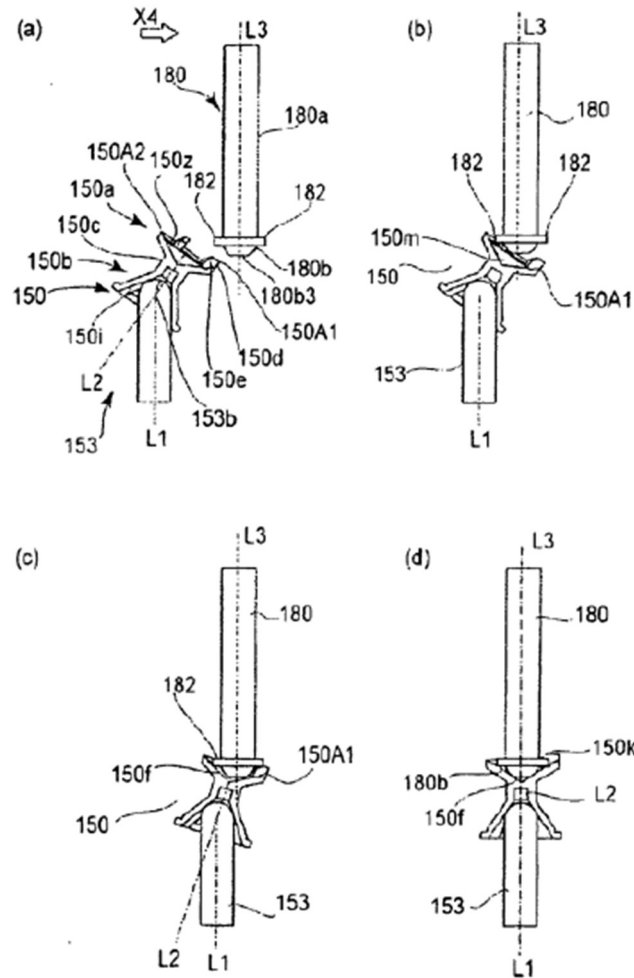


FIG. 22

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

18 In the case of the challenged process cartridges, all features of patent
claim 1 were literally realized.

19 The voluntary agreement concluded by the plaintiff with other
manufacturers does not prevent the assertion of the claims. This agreement is
only intended to enable reuse or recycling of process cartridges within the scope
of what is legally permissible. It was therefore subject to patent protection.

20 The compulsory license objection based on Art. 102 TFEU was also
unfounded. The assertion of claims for injunctive relief based on a patent does
not in itself constitute an abuse of a dominant position - which is disputed in the
dispute. An abusive refusal of a license had not been proven. In particular, there

was no substantiated argument as to whether the use of a patented drum unit was absolutely necessary for the sale of the process cartridges offered by the defendants.

21 Furthermore, the claims in suit are not precluded by the principle of exhaustion. For the assessment of this question, the subject matter defined in the asserted patent claim had to be taken into account. This also applies if the protected product is sold as a component of an overall device which is itself the subject of another patent claim of the same property right. With regard to the relevant drum unit, the replacement of the image drum alone constituted a new production. The relevant public perception had to be determined normatively, because the addressed public was at least predominantly composed of private and business customers of process cartridges suitable for use, and these end users did not perceive a drum unit according to the patent as an independent economic good, but only as part of the process cartridge. From a normative point of view, it was decisive that the image drum was the essential component of the drum unit, which accounted for about 70% of the value when new, that the cost of replacing a used image drum was the same as the cost of producing a new drum unit, and that the advantages of the invention had a positive effect on the image drum because the invention enabled simplified assembly and disassembly of the drum unit.

22 The accusation raised by the defendants that the plaintiff, by claiming patent protection for the drum unit, had created an obstacle to compatibility that prevented the image drum from being replaced, even though it was a previously known standard wear part, was not relevant to the decision, even at the outset. Irrespective of this, the subject matter of the patent protection in the case in dispute was not arbitrarily chosen. Only the functional interaction of the coupling component with the image drum leads to the simplification of assembly and disassembly of the drum unit as part of the process cartridge which is intended by the patent in suit.

23 III. This does not stand up to legal scrutiny in one decisive point.

24 1. The Court of Appeal was correct in concluding that the objection based on the voluntary agreement with other manufacturers of the inadmissible

exercise of rights under Sec. 242 Civil Code is not valid.

25 It can be left open whether the obligations entered into in No. 4.4 of this agreement can also apply to the extent that the design of the cartridges or devices concerned is the subject of a technical property right. Even if this were to be affirmed, contrary to the opinion of the Court of Appeal, a breach of these obligations would in any case not result in any rights in favor of competitors or other third parties.

26 a) The voluntary agreement does not create any legal positions in favor of private third parties.

27 According to No. 7.1 of the agreement, the signatories have assumed the obligations provided for therein vis-à-vis the European Commission. There are no indications in the agreement that rights or legal positions should also be granted to third parties.

28 According to No. 9 of the agreement, a multi-stage procedure is provided for in the event of non-compliance with the obligations, which includes a grace period for achieving the set goals, talks on the further course of action and, as a last resort, exclusion from the list of signatories.

29 As a further consequence, there is a threat of implementing measures in the form of a European Commission regulation based on Art. 15 of Directive 2009/125/EC of the European Parliament and of the Council of 21 October 2009 establishing a framework for the setting of ecodesign requirements for energy-related products (OJ EU L 285 p. 10). According to Art. 15(3) lit. a of the Directive, the decision on such measures shall take into account whether there are voluntary agreements that can be expected to enable the policy objectives to be achieved more quickly or at lower cost than mandatory requirements. Failure to comply with an existing agreement may indicate that it is insufficient to achieve those objectives.

30 Against this background, no direct legal effects in favor of private third parties can be derived from the voluntary agreement. According to recitals 4, 5, 10 and 12, the directive in the context of which the agreement was concluded also serves the interests of consumers and other product users. However, it is

precisely not mandatory regulations - in the form of a delegated regulation of the Commission - that are used to achieve this goal, but rather a voluntary commitment, compliance with which is only ensured by reporting obligations and monitoring mechanisms, but not by more extensive sanctions.

31 Contrary to the opinion of the revision, the conclusion cannot be drawn from Art. 15 of the Directive that the voluntary agreement has comparable legal effects as a mandatory regulation by the Commission. The existence of a voluntary agreement can indeed be a sufficient reason to refrain from a mandatory regulation. However, in doing so, the Directive merely takes into account the principle of proportionality, which also applies in European Union law and requires that the actions of the Union institutions are suitable for achieving the legitimate objectives pursued by the regulation in question and do not go beyond the limits of what is necessary to achieve those objectives (see only ECJ, Judgment of 16 June 2015 - C-62/14, NJW 2015, 2013 para. 67 - Gauweiler ./ Deutscher Bundestag). The assumption that a voluntary agreement has the same effects as a mandatory regulation is not compatible with this. Rather, Art. 15 of the Directive provides for mandatory regulations as a more sensitive remedy only in the event that a voluntary commitment is not sufficient as a less intrusive means of achieving the objectives.

32 b) In view of the above, the Court of Appeal was also correct in concluding that the voluntary agreement cannot establish a legitimate expectation in favor of the defendant or any other connecting factor for a defense against the assertion of claims arising from a technical property right for devices, cartridges or their components.

33 From the perspective of a reasonable third party, there is indeed a legitimate expectation that the parties to the agreement will comply with the obligations assumed therein in order to avoid the issuance of binding regulations by the Commission. At the same time, however, it is also recognizable to an outsider that, in the event of non-compliance with obligations, the sanctions provided for in the agreement and, if necessary, action by the Commission are to be the end of the matter and that there is no provision for legal enforcement by third parties, however this may be structured.

34 2. Contrary to the opinion of the Court of Appeal, the objection of exhaustion raised by the defendants is well-founded.

35 a) According to the established case law of the Federal Court of Justice, the exclusive right under a patent relating to a product is exhausted with respect to those copies of the protected product which have been put on the market by the patent proprietor or with his consent. The lawful acquirers as well as subsequent third party acquirers - including competitors of the patent proprietor - are entitled to use these copies as intended, to sell them to third parties or to offer them to third parties for one of these purposes (see only Federal Court of Justice, judgment of 17 July 2012 X ZR 97/11, GRUR 2012, 1118 marginal no. 17 - Palettenbehälter II; judgment of 27 February 2007 - X ZR 38/06, BGHZ 171, 167 = GRUR 2007, 769 marginal no. 27 Pipettensystem).

36 Intended use includes the maintenance and restoration of fitness for purpose if the functional or performance capability of the specific specimen is impaired or cancelled in whole or in part by wear and tear, damage or for other reasons. Not included in the intended use, on the other hand, are all measures which amount to re-manufacturing a product in accordance with the patent. The patent proprietor's exclusive right to manufacture is not exhausted when a copy of the patented product is placed on the market for the first time.

37 b) The Court of Appeal was correct in considering the product protected under claim 1 as the relevant connecting factor for assessing exhaustion.

38 aa) According to the case law of the Federal Court of Justice, the overall combination is decisive for the delimitation between intended use and new production (Federal Court of Justice, judgment of 4 May 2004 - X ZR 48/03, BGHZ 159, 76, 91 = GRUR 2004, 758, 762 - Flügelradzähler). This is the product protected under the relevant patent claim.

39 In accordance with this principle, the Senate has decided - in a departure from earlier case law - that the manufacture of individual parts of a protected product cannot be considered a direct patent infringement even if these parts are individualized in terms of the function of the invention. In the case of the

incorporation of individual parts, it is therefore decisive whether this is to be regarded as a new manufacture of a protected product with all the features provided for in the patent claim (BGHZ 159, 76, 91 = GRUR 2004, 758, 762 - Flügelradzähler).

40 bb) The product protected by the patent claim also constitutes the decisive connecting factor for the demarcation between intended use and new production if the person entitled has put a copy of it on the market as a component of a more comprehensive object.

41 (1) As the appeal rightly asserts in its approach and as the Court of Appeal also correctly saw, this question was not relevant for the previous decisions of the Federal Court of Justice on this subject. It is true that in these decisions the Federal Court of Justice has always considered the "overall device" as the relevant point of reference (Federal Court of Justice, judgment of 21 November 1958 - I ZR 129/57, GRUR 1959, 232, 234 - Förderrinne; judgment of 4 May 2004 - X ZR 48/03, BGHZ 159, 76, 90 et seq. = GRUR 2004, 758, 762 Flügelradzähler; judgment of 3 May 2006 - X ZR 45/05, GRUR 2006, 837 marginal no. 16 f. - Laufkranz; judgment of 27 February 2007 - X ZR 38/06, BGHZ 171, 167 = GRUR 2007, 769 marginal no. 31 - Pipettensystem; judgment of 17 July 2012 X ZR 97/11, GRUR 2012, 1118 marginal no. 28 f. - Palettenbehälter II). In all these cases, however, the patent protection related to such an overall device, so that the terms "overall device" and "protected product" had the same meaning.

42 (2) However, nothing else can apply to the situation to be assessed in the case at issue, i.e. that the person entitled puts into circulation objects comprising a copy of the protected product as an integral part - irrespective of whether the overall device is itself protected by a patent claim of the same or of another patent.

43 If the entire device is also protected by a patent, its placing on the market by the person entitled to it leads to exhaustion of the exclusive right relating to the entire object. A lawful acquirer is therefore entitled to carry out measures to maintain and restore the usability of the overall device within the limits of its intended use without this constituting an infringement of the patent protecting

this product. However, this has no influence on any patent protection for individual components of the product existing in addition. The rights to the two protected objects are to be assessed separately. If a measure is to be assessed as intended use with respect to one object, but as new production with respect to the other object, only the exclusive rights with respect to the overall device are exhausted, but not the exclusive rights with respect to the independently protected component.

44 The same must apply if the overall device is not under patent protection. In this constellation, a lawful acquirer is free to use the overall device in any way he wishes or even to manufacture it anew. However, this does not result in the authority to newly manufacture a component that is under patent protection. Placing the overall device on the market leads to an exhaustion of the existing exclusive rights with regard to its individual components. However, whether a measure is to be regarded as intended use or as new production must also be assessed in this constellation with regard to the respective protected product.

45 cc) The principle established by the Senate in another context, namely that the entitled party may only assert its exclusive rights once, namely upon the first sale of the patented object (Federal Court of Justice, order of 16 September 1997 - X ZB 21/94, GRUR 1998, 130, 132 - Handhabungsgerät), does not result in a different assessment for the constellation to be assessed in the dispute.

46 According to this principle, the person entitled is precluded from reserving the intended use of a product placed on the market by him on the basis of a patent claim, the subject matter of which, in the manner of an operating manual, is exhausted in precisely this intended use (Federal Court of Justice GRUR 1998, 130, 132 - Handhabungsgerät).

47 This constellation is not present in the case in dispute.

48 The patent claim on which the action is based is directed to the protection of a product which was put on the market with the consent of the plaintiff as a component of an overall device. However, the subject matter of this patent claim is not limited to the intended use of the protected product within the scope of the use of the overall device. Rather, it covers every act of use, irrespective of

whether this is connected with the use of an overall device placed on the market with the consent of the plaintiff. Against this background, the new production of such a product without the consent of the rightholder is not permissible even if it serves the intended use of an overall device placed on the market with the consent of the rightholder.

49 dd) No different conclusion can be drawn from the protection of the free movement of goods standardized in Art. 34 and Art. 35 TFEU.

50 Pursuant to Art. 36 sentence 1 TFEU, the aforementioned provisions do not preclude prohibitions and restrictions that are justified for the protection of industrial and commercial property. Accordingly, prohibitions and restrictions resulting from a technical property right are unobjectionable if they are suitable and necessary for the realization of these rights and the restrictions resulting from them are neither disproportionate nor discriminatory. The distinction between intended use and new production is based on these standards and is therefore not objectionable against the background of the free movement of goods.

51 c) Consequently, it is decisive for the decision of the dispute whether the replacement of the image drum is to be regarded as a new manufacture of a drum unit within the meaning of patent claim 1. Contrary to the opinion of the Court of Appeal, this is not based on a fictitious commercial conception. Rather, the only decisive factor is whether the technical effects of the invention are reflected in the replaced parts.

52 aa) According to the case law of the Federal Court of Justice, the decisive factor for the delimitation between intended use and new production is, in principle, first and foremost whether the measures taken preserve the identity of the concrete copy of a patented product already placed on the market or whether they are equivalent to the creation of a new copy of the patented product.

53 In order to assess this question, it is necessary to weigh the interests of the patent proprietor in the economic exploitation of the invention on the one hand and the interests of the customer in the unhindered use of the concrete

product according to the invention put on the market on the other hand, which are worthy of protection, taking into account the specific character of the patent-protected product. This is generally the task of the judge of facts (Federal Court of Justice, judgment of 17 July 2012 X ZR 97/11, GRUR 2012, 1118 marginal no. 26 - Palettenbehälter II; judgment of 27 February 2007 - X ZR 38/06, BGHZ 171, 167 = GRUR 2007, 769 marginal no. 27 Pipettensystem; judgment of 4 May 2004 - X ZR 48/03, BGHZ 159, 76, 91 = GRUR 2004, 758, 762 - Flügelradzähler).

54 bb) However, according to the case law of the Senate, if a measure is to be regarded as a new production according to the common understanding and comprises the replacement of a part which is mandatory in the patent claim, a patent infringement cannot normally be denied on the grounds that the replaced part does not reflect the technical effects of the invention. The question of whether the technical effects of the invention are reflected precisely in the replaced parts and therefore the technical or economic advantage of the invention is again realized by the replacement of these parts is generally only decisive if the replacement of the part in question can usually be expected during the life of the protected product (Federal Court of Justice, judgment of 17 July 2012 - X ZR 97/11, GRUR 2012, 1118 marginal no. 29 - Palettenbehälter II).

55 cc) However, an exception to the primacy of the orientation towards the conception of the market is generally required if a patent claim protects a product consisting of several parts, but the person entitled only puts into circulation objects which again comprise further components.

56 (1) According to the case law of the Senate, the entitled person may, however, in principle demand the grant of the patent in the form which corresponds to the given technical teaching. Therefore, the entitled party is in principle free to claim a process or a use in addition to a product or to formulate several patent claims of the same category (Federal Court of Justice, order of 14 March 2006 - X ZB 5/04, BGHZ 166, 347 = GRUR 2006, 748 marginal no. 16 f. - microprocessor). For the same reason, provided that the claimed subject matter satisfies the requirements for grant of a patent, it is generally up to the plaintiff to decide whether he seeks protection only for individual parts of a more

comprehensive product or for the more comprehensive product as a whole.

57 (2) For the question of exhaustion, however, it cannot be disregarded which subject matter is put on the market with the consent of the person entitled.

58 A conception of the market, which according to the principles outlined is in principle to be used as the first criterion for the delimitation between intended use and new production, can in principle only be formed with regard to a product which has actually been put on the market in this form. This prerequisite, as the Court of Appeal found without being challenged in this respect, is fulfilled in the case in dispute only with regard to printers and process cartridges, but not with regard to a drum unit.

59 (3) Contrary to the opinion of the Court of Appeal, the distinction between intended use and new production in such constellations may not be made on the basis of a fictitious conception of the market defined according to normative criteria.

60 The distinction on the basis of the market perception takes into account the legitimate expectations of the purchasers of an asset placed on the market. Such expectations are naturally shaped by the fact that a product is offered on the market in a certain form or configuration. In their place, fictitious expectations which might arise if a different product were offered may not be used. If the product protected by the patent claim is not congruent with the objects available on the market, this rather has the consequence that the perception of the market is not applicable as a criterion for the delimitation between new production and intended use.

61 (4) In the aforementioned constellation, a new production may only be affirmed if the technical effects of the invention are reflected precisely in the replaced parts.

62 According to the case law of the Federal Court of Justice, this criterion serves as an assessment on the basis of patent law considerations if a new production cannot be affirmed on the basis of the market perception. This prerequisite is also given in the constellation to be assessed in the dispute - precisely because it is not possible to ascertain a commercial conception. The

aforementioned criterion is also suitable for delimitation in this constellation, because it is based on patent law considerations and ensures an appropriate balance between the interests of the patent proprietor in the economic exploitation of the invention, which are worthy of protection, and the interests of the customer in the unhindered use of the product placed on the market, which are worthy of protection.

63 d) Against this background, the Court of Appeal wrongly regarded the replacement of the image drum and flange as a new production of a drum unit.

64 aa) The question answered in the affirmative by the Court of Appeal as to whether the replacement of the image drum is to be regarded as a new production of a drum unit according to the perception of the market is of no significance for the decision of the dispute for the reasons stated above. The only decisive factor is whether the technical effects of the invention are reflected in the replaced parts - image drum and flange.

65 bb) The contested decision does not prove to be correct in its result for other reasons. The technical effects of the invention are reflected neither in the image drum nor in the flange.

66 (1) According to the opinion of the Court of Appeal, the technical effects of the invention are not reflected in the image drum because the image drum of the protected drum unit was known from the state of the art and patent claim 1 does not provide for any changes with respect to the material properties, functioning or service life of the image drum.

67 This assessment does not reveal any legal error. Factual arguments of the plaintiff that could lead to a different result have not been shown.

68 (2) The Court of Appeal stated in connection with the determination of the perception of the market that the advantages of the invention nevertheless have a positive effect on the image drum because the coupling element according to the patent leads to the fact that the image drum can also be installed and removed more easily.

69 These considerations cannot support the assumption that the

replacement of the image drum is to be regarded as a new production of a drum unit.

70 According to the case law of the Federal Court of Justice, however, the replacement of a part can also be considered a new production if this part does not have to be designed in a special way according to the protected invention, but interacts with another part designed according to the invention in such a way that the advantages of the solution according to the invention are realized on that part. However, it is not sufficient for this that there is a functional connection between the parts in question. Rather, it is additionally required that the technical effects of the invention appear precisely in the replaced part, so that it can be said that the technical or economic advantage of the invention is again realized by the replacement of this part (Federal Court of Justice, judgment of 17 July 2012 - X ZR 97/11, GRUR 2012, 1118 marginal no. 43 - Palettenbehälter II). These requirements are not met if a replaced part interacts with other parts, but in this respect is only a mere object of an effect according to the invention, which finds its objective embodiment solely in the other parts (Federal Court of Justice, judgment of 27 February 2007 - X ZR 38/06, BGHZ 171, 167 = GRUR 2007, 769 marginal no. 31 - Pipettensystem).

71 In the case in dispute, as the Court of Appeal correctly pointed out, there is indeed a functional connection because a design of the coupling element in accordance with the invention facilitates the assembly and disassembly of the drum unit as a component of the process cartridge. However, this effect finds its objective embodiment only in the features of the coupling element provided in feature group 4. In this respect, the image drum is a mere object which, as a component of the process cartridge, participates in the effect according to the invention without being influenced in its function or service life for this purpose.

72 (3) In the event that the flange is also replaced in addition to the image drum, nothing to the contrary shall apply. Insofar as the flange interacts with the coupling element, it is likewise only an object of the effect according to the invention.

73 (4) The question discussed by the Court of Appeal in the context of an auxiliary consideration as to whether an exchange of the image drum is to

be regarded as a new manufacture of a process cartridge is of no significance for the decision.

74 As the Court of Appeal did not fail to recognize, this question would only be relevant if the process cartridge formed the decisive point of reference. The latter is incorrect for the reasons outlined above.

75 IV. The matter is ready for final decision (Sec. 563(3) Code of Civil Procedure).

76 It follows from the factual findings of the Court of Appeal, for the reasons set out above, that the replacement of the image drum and flange is not to be regarded as a new production of a drum unit. There are no further findings on this question that are relevant to the decision. The action is therefore ripe for dismissal.

77 V. The decision on costs is based on Sec. 91(1) Code of Civil Procedure.

Meier-Beck

Gröning

Grabinski

Bacher

Marx

Previous instances:

Regional Court of Düsseldorf, judgment of 11 June 2015 – 4a O 44/14 –

Higher Regional Court of Düsseldorf, judgment of 29 April 2016 – I-15 U 47/15 –