

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2015-01-13
Docket Number / Aktenzeichen:	X ZR 81/13
Name of Decision / Name der Entscheidung:	Kochgefäß



Arbeitskreis
Patentgerichtswesen
in Deutschland e.V.



FEDERAL COURT OF JUSTICE
IN THE NAME OF THE PEOPLE
JUDGMENT

I ZR 81/13

Pronounced on:
13 January 2015
Wermes
Judicial secretary
as clerk of the
Court registry

in the matter

Kochgefäß/Cooking pan

European Patent Convention Article 69; German Patent Act Sec. 14; German Act on International Patent Conventions Article II Sec. 3 in the version of 20 December 1991

- a) To check for same effect, the patent claim must be examined to see which of the effects that can be achieved by its features must converge in order to solve the task according to the invention. These combined effects together represent the solution according to the patent; a further subdivision into effects “fundamental to the invention” and “additional” effects is flawed.
- b) Good faith protection pursuant to Article II Sec. 3(5) German Act on International Patent Conventions can be relied on even by a party who was not familiar with the incorrect translation of the patent specification but who, with knowledge thereof, would have been entitled to conclude that the protected object varied from the object actually protected.

Federal Court of Justice, judgment of 13 January 2015 - X ZR 81/13 –
Higher Regional Court of Munich
Regional Court of Munich I

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 13 October 2015, attended by the presiding judge Prof. Dr. Meier-Beck and the judges Gröning, Dr. Bacher, Dr. Deichfuß and Dr. Kober-Dehm

ruled that:

In response to the Defendant's appeal on points of law, the judgment of the Higher Regional Court - 6th Civil Senate - of 23 May 2013 is set aside. The matter is remitted to the court of appeal for retrial and new judgment, including on the costs of the appeal on points of law.

By operation of law

Facts of the case:

1 The Plaintiff was the proprietor of European Patent 481 303 for cooking pans of capsular base type with a profiled lateral band, registered on 4 October 1991, granted with effect for Germany and now lapsed due to expiration of the term of protection (the "Patent in Suit"). The sole claim of the Patent in Suit reads, in the language of the proceedings:

"A cooking pan (10) with a capsular base (18), characterised in that the lateral wall (26) of the protection covering (22) of said capsular base (18) is shaped with raised portions (28, 30) and/or depressions (32, 34) obtained by providing corresponding recesses and/or projections in the relative region of the die of the mould used to produce said capsular base (18)."

2 By reason of the Defendants' sale and distribution of certain models of pans within Germany, the Plaintiff sued for cease and desist and for information and compensation, claiming that the contested embodiments infringe the Patent in Suit. The Regional Court upheld the action. Following expiration of the term of protection, the parties unanimously declared the lawsuit settled before the court of appeal with regard to the petition for cease and desist. The court of appeal obtained an expert report and then dismissed the Defendants' appeal. By the appeal on points of law, leave for which was granted by the Senate, the Defendants continue to pursue the motion to dismiss so far as the lawsuit has not unanimously been declared settled. The Plaintiff opposes the appeal.

Grounds of the decision:

3 The appeal on points of law results in annulment and remittal.

4 I. The Patent in Suit relates to cooking pans constructed of a metal of low thermal conductivity, such as rust-proof steel (stainless steel). For pans of this type, better heat distribution to the pan content is achieved by applying a layer of good thermal conductivity, such as of aluminium, to the underside of the pan. In order to protect this layer of greater thermal conductivity, it is covered in a further layer of metal, typically stainless steel, which provides a greater resistance to oxidation, corrosion and scratching. As state of the art, pursuant

to the description in the Patent in Suit, it was known to protect the layer of good thermal conductivity not only on its underside but also to extend the protective layer upwards laterally so that it also protect the lateral edge of said layer of good thermal conductivity. The result is a cooking pan in which the metal layer of good thermal conductivity is completely enclosed within the metal of lower thermal conductivity and of greater resistance to oxidation, corrosion and scratching. A pan of this type is designated a “capsular base pan” in the Patent in Suit (column 1, line 23 et seq.)

5 According to the description, a cooking pan of this kind, in which good bonding is achieved between the individual layers of the base, can be produced by the method set out in European Patent 209 745 and Italian patent 1 209 648. In doing so, a concave deformation is formed in the center of the underside of the pan base. When a pan produced in this way is heated, the layers that make up the pan base, and in particular the layer of good thermal conductivity, expand. This tends to lead, as depicted in the description of the Patent in Suit, to a convex deformation of the pan base which, under ideal conditions, i.e. when the pan base is evenly heated, is compensated for by the mentioned concavity. These ideal conditions are not always present however, particularly when the cooking pan is not centred on the heat source. In such a situation, heating the pan may cause peripheral deformations that are not compensated for by the concavity in the base. If the base is not completely flat, this has the disadvantage that it does not sit fully on the heat source and heat transfer to the pan and its content is compromised.

6 The technical problem therefore consists in further developing a capsular based pan so that peripheral deformations are prevented.

7 According to the invention, this is achieved by a pan with the features of the patent claim, which can be summarised as follows:

1. a cooking pan with a capsular base;
2. the lateral wall of the protection covering of said capsular base is shaped with raised portions and/or depressions;

3. obtained by providing corresponding recesses and/or projections in the relative region of the die of the mould used to produce said capsular base.

8 In the first-submitted German translation of the patent specification, the term “mould” was translated in both the claim and the description as “*Gusswerkzeug*” (casting tool). The Plaintiff only submitted a corrected translation of the patent specification during the proceedings before the Regional Court.

9 With the Patent in Suit the Plaintiff was granted protection for a product that is described also by its method of production. Pursuant to feature 3, the raised portions or depressions of the lateral wall are obtained by providing the mould used to produce said capsular base with corresponding recesses and/or projections in the relative region of the die. This formulation of the claim as a product-by-process claim serves solely to characterise the product according to the patent and does not denote a restriction to products actually produced using the method described in feature 3 (cf. FCJ, decision of 30 March 1993 - X ZB 13/90, BGHZ 122, 144, 155 - Tetraploide Kamille; FCJ, judgment of 8 June 2010 - X ZR 71/08, Juris margin no. 23). The required interpretation of the patent claim giving due consideration to the description of the Patent in Suit (FCJ, judgment of 19 June 2001 - X ZR 159/98, GRUR 2001, 1129, 1133 - Zipfelfreies Stahlband) does not indicate any restriction to the protected object from the method called on in order to identify it either. So far as the description, referring to European Patent application 209 745 and Italian patent 1 209 648, depicts the there-described methods, by which the various components of the base structure are heated in a particular way and by impact pressure, being first applied centrally, as ensuring particularly good bonding between the various layers, (column 1, line 40 et seq.), this has not fed into the patent claim, which simply requires that the raised portions or depressions can be produced by corresponding recesses or projections in the die of a mould.

10 II. The court of appeal essentially gave the following reasons for its decision:

- 11 The Defendants could not successfully argue pursuant to Article II Sec. 3(2) German Act on International Patent Convention in the version in force in the Federal Republic of Germany prior to 1 May 2008 that the Patent in Suit remained ineffective from the outset due to incorrect translation. A translation of incomplete or incorrect content is not the same as no translation.
- 12 The Regional Court had rightly found there to have been no literal infringement. The contested embodiments were lacking a capsular base. Pursuant to the Patent in Suit, this was to be understood as a base where the layer of higher thermal conductivity was completely encapsulated. This required not only that the stainless steel layer completely cover the layer of higher thermal conductivity on the underside of the pan but that it also extend laterally up to the base of the pan. The layer of good thermal conductivity on the pans sold and distributed by the Defendants was not completely encapsulated. Thus, the material of good thermal conductivity was not protected against every form of corrosion, oxidation and mechanical damage.
- 13 The contested embodiments had, however, made use of the Patent in Suit equivalently. The required same effect (*Gleichwirkung*) was present. The Defendants' claim that the problem addressed by the Patent in Suit - namely avoiding peripheral deformations that cause unevenness in the pan base - could not occur with the contested pans because there the layer of higher thermal conductivity was not completely encapsulated, is not correct according to the remarks by the expert. Moreover, the fact that the contested pans did not have a capsular base did not mean the effect was not the same. Complete encapsulation of the layer of good thermal conductivity served to prevent any oxidation, corrosion or mechanical damage to this layer whatsoever. The present matter did not hinge on this advantage of the capsular base however. Since the problem addressed by the Patent in Suit - namely preventing deformation of the pan base during heating - could also occur with pans with incomplete encapsulation, it was not possible to derive from the capsular base requirement any minimum requirements with regard to the protection afforded to the layer of good thermal conductivity since, in this respect, it was an effect additional to the increase in stiffness from deformations in the peripheral area, this being the effect intended by the feature and fundamental to the invention.

Nor did the contested embodiments' use of a copper layer in the middle of the pan base produce a different interpretation. The skilled person had been able to identify the modified embodiment without inventive effort. It had been evident to him that a base that dispensed with complete encapsulation was not only easier to manufacture but also offered the same advantages with regard to stiffness and the corresponding effects on deformation behaviour. The modified embodiment was also of equal value (*gleichwertig*). It built on the meaning of the Patent in Suit's teaching since, like said Patent in Suit, it took advantage of the effects had on the pan's deformation behaviour during heating from the stiffening at the edges.

14 The Defendants were also unsuccessful in invoking good faith protection pursuant to Article II Sec. 3(5) German Act on International Patent Conventions. This provision could only be relied on by a party who used the invention in reliance on the correctness of the incorrect translation. It was a precondition of this that the party concerned was familiar with the incorrect translation. Contrary to the Defendants' view, a party who, as the Defendants claimed of themselves, was not familiar with the Patent in Suit was unable to invoke good faith.

15 III. This assessment fails to withstand legal revision in one crucial regard.

16 1. The court of appeal correctly denied a literal infringement of the Patent in Suit. In accordance with the court of appeal's correct understanding of the Patent in Suit, a cooking pan with a capsular base in terms of feature 1 exists solely if the layer of good thermal conductivity applied to the base of the cooking pan is completely covered by a layer of metal of lower thermal conductivity but greater resistance to oxidation, corrosion and scratching, such as stainless steel. This ensues from the explicit definition of a cooking pan with capsular base as contained in the description, being the patent's own "encyclopaedia", by outlining the design previously known in this regard and further developed by feature 2. The court of appeal determined that in the case of the contested embodiments the stainless steel layer did not extend upwards to the top edge of the pan base and that the layer of the good thermal conductor aluminium was

therefore only partly protected on its lateral edge by a layer of stainless steel. Moreover, a copper plate was inserted in the centre of the base.

17 2. The grounds on which the court of appeal affirmed an equivalent infringement of the Patent in Suit are not sustainable, as rightly pointed out in the appeal on points of law.

18 a) Three conditions must generally be fulfilled in order for an embodiment that varies from the literal sense of the patent claim to fall within its extent of protection. Firstly, the embodiment must solve the problem underlying the invention by means which, albeit modified, objectively have the same effect. Secondly, the specialised knowledge of the skilled person must enable him to identify the modified embodiment of variant means as having the same effect. Thirdly, the effort that this requires of the skilled person must be based on the sense of the teaching protected by the claim. If these preconditions are fulfilled, the variant embodiment of modified means must be considered from a skilled perspective as a solution of equal value (equivalent) to the literal solution and hence must be accounted for pursuant to Article 2 Protocol on the Interpretation of Article 69 EPC when determining the extent of the protection conferred by the patent (cf. inter alia the Senate, judgment of 12 March 2002 - X ZR 168/00, BGHZ 150, 149, 154 - Schneidmesser I; judgment of 17 April 2007 - X ZR 1/05, GRUR 2007, 959, 961 - Pumpeinrichtung). In this way, the extent of protection conferred by the patent is determined according to that which, based on the patent's teaching according to the invention, a skilled person would consider equivalent, and thus interpreted in keeping with the requirement of Article 1 Protocol on the Interpretation of Article 69 EPC to combine fair protection for the patent proprietor with a reasonable degree of certainty for third parties when determining the extent of protection conferred by the patent (FCJ, judgment of 14 December 2010, GRUR 2011, 313 margin no. 35 - Crimpwerkzeug IV).

19 b) The question of same effect depends on the individual effects contributed by the patent features - individually and as a whole - to satisfying the task underlying the patent claim, and whether the contested embodiments achieve these effects by other means. It is therefore necessary to examine the patent claim to see which of the effects that can be achieved by its features must

converge in order to solve the task according to the patent. These combined effects together represent the patented solution and thus have decisive effect for the comparison to be made (FCJ, judgment of 28 June 2000 - X ZR 128/98, GRUR 2000, 1005, 1006 - Bratgeschirr; judgment of 17 July 2012 - X ZR 113/11, GRUR 2012, 1122 margin no. 19 - Palettenbehälter III). This is the only way to ensure that despite modifications in one or more features, only those embodiments that retain the meaning pursued by the protected invention are covered by the scope of protection conferred by the patent claim. An embodiment can, then, only be considered as having the same effect if it essentially achieves not only the overall effect of the invention but also and in particular any effect intended by the feature realised other than literally (FCJ, GRUR 2012, 1122 margin no. 26 - Palettenbehälter III).

20 c) The court of appeal's reasoning in this regard are not in accordance with the case law.

21 aa) The design of the lateral wall of the protection covering with raised portions and/or depressions, as described in feature 2, results in the formation of ribs that work to reinforce the circumferential strip of the protective layer, thus counteracting peripheral deformations of the base of the cooking pan that can arise for example from uneven heating and ensuring good contact between the base of the pan and the heat source. The purpose of furnishing a cooking pan with a capsular base according to feature 1 is to protect those parts of the base of good thermal conductivity from oxidation, corrosion or mechanical damage, such as scratches, by completely covering them with a metal layer - for example of stainless steel - of greater resistance to such influences. Same effect will therefore only come into consideration if the contested embodiments achieve both effects.

22 bb) Whilst, in accordance with the findings of the expert report obtained for this purpose, the court of appeal determined the contested cooking pans also to achieve the effects intended by the reinforcements in the lateral wall of the protection covering according to feature 2, with regard to the effect pursued by the capsular base the court held that it was not possible to infer from feature 1 any minimum requirements with respect to the protective effect against

oxidation, corrosion and mechanical damage. To this extent, the effect was an effect additional to the effect of increased stiffness of the pan base as pursued in features 2 and 3 and fundamental to the invention.

23 These remarks do not accord with the case law of the Senate as set out. They fail to take into account that same effect can only be assumed if all effects according to the invention are achieved. The court of appeal instead erred in law by distinguishing between effects that are fundamental to the invention and effects that are additional and by assuming that it did not matter whether the contested embodiment also achieved the latter. This is also demonstrated by the court of appeal's affirmative reference to the remarks by the regional court designating the encapsulation of the layer of good thermal conductivity as an objective that was without meaning for the teaching of the patent. Based on the reasons given, the appeal judgment cannot be upheld.

24 d) The Senate is unable to make a final decision in the matter due to a lack of determinations on whether the contested embodiments achieve the effects according to the invention to an extent that is still of significance in practice.

25 An embodiment with a variant design instead of a feature specified in the patent claim will not only fall within the extent of protection conferred by the patent in the event that it achieves the effects according to the invention without limitation. It can also suffice for same effect if the variant means only achieves an effect required according to the patent claim to a limited degree. In terms of reasonable compensation of the inventor, it may be appropriate for the protection conferred by the patent to already include cases in which the effects according to the invention are essentially achieved, i.e. achieved to an extent still of significance in practice. This will depend on the effect according to the patent and on an evaluation of the deficits in the contested embodiments measured against such effect (FCJ, judgment of 2 March 1999 - X ZR 85/96, GRUR 1999, 909, 914 - Spanschraube; FCJ, GRUR 2005, 1005, 1006 - Bratgeschirr; FCJ, GRUR 2012, 1122 margin no. 27 - Palettenbehälter III).

26 The contested embodiments in any event only achieve to a limited extent the effect pursued by feature 1. The lateral edge of the aluminium layer of good

thermal conductivity is only partly covered by a protective layer. Moreover, in the centre of the underside of the pan base there is a circular insert of copper and thus of a material that, in comparison to stainless steel, is soft and of good thermal conductivity. The question of whether the effect achieved by incomplete encapsulation of the components of the base structure of good thermal conductivity can still be considered to accord with the patent will depend in particular on what practical significance is ascribed to the protection of the individual areas of the pan base against corrosion, oxidation and mechanical damage and what impairments are to be expected from the point of view of a skilled person with regard to function and appearance where the pan is used as intended and if a circular copper plate is inserted into a stainless steel protective layer in the centre of the underside of the pan base and the upper part of the lateral wall of the aluminium layer is exposed and thus complete protection against the aforementioned effects is not ensured. The court of appeal - as was logical from its position - has not so far made any determinations in this regard.

27 IV. The judgment of the court of appeal is thus unable to be upheld; it must be set aside. As the matter is not ready for a final decision, it must be remitted to the court of appeal (Sec. 563(1) sentence 1 Code of Civil Procedure).

28 1. Should re-opened appeal proceedings find there to be same effect in the above-described sense, the court of appeal will have to examine on this basis whether the further requirements for an equivalent infringement are present.

29 2. If, on the other hand, the court of appeal concludes that the contested embodiments infringe the Patent in Suit by means of equal value, the court of appeal will be required to reconsider the issue of whether the Defendants can rely on good faith protection pursuant to Article II Sec. 3(5) German Act on International Patent Conventions in the version in force until 31 December 2001.

30 a) The court of appeal correctly found the translation requirement pursuant to Article II Sec. 3(1) German Act on International Patent Conventions (old version) to be decisive for the Patent in Suit. While the former Article II Sec. 3 German Act on International Patent Conventions has now been cancelled, the

provision nevertheless continues to apply to European patents published prior to 1 May 2008 in the version applicable at the time of publication of the mention of the grant of the patent (Article XI Sec. 4 German Act on International Patent Conventions). As the mention of the grant of the contested patent was published on 3 May 1995, the version of Article II Sec. 3 German Act on International Patent Conventions in force until 31 December 2001 is decisive for this case.

31 Pursuant to this provision, the applicant or proprietor of a European Patent that is granted in proceedings in a foreign language and to have effect within the Federal Republic of Germany, must submit a German translation of the patent specification within three months of publication of the mention of the grant of the European Patent; the effects of the European Patent are otherwise deemed as having not applied within Germany from the outset (Article II Sec. 3(1 and 2) German Act on International Patent Conventions (old version)). In the event of incorrect translation of a European Patent specification, Article II Sec. 3(5) German Act on International Patent Conventions (old version) provides that a party who has used or made actual or genuine arrangements to use the invention within the Federal Republic of Germany in good faith may continue to pursue his use of the invention free of charge for the needs of his own business in his own or another's workshops after publication of the corrected translation, provided that such use would not constitute an infringement of patent as incorrectly translated.

32 b) The original translation of the Patent in Suit submitted under file number 691 09 436 T2 was incorrect. In particular, it stated that the raised portions and/or depressions were achieved "*durch Vorsehen entsprechender Vertiefungen und/oder Vorsprünge im zugehörigen Bereich des (...) verwendeten Gußwerkzeugs*" ("by providing corresponding recesses and/or projections in the relative region of (...) the casting tool used (...)"). It was only in a corrected translation, submitted to the Patent Office by the Plaintiff at the suggestion of the Regional Court (691 09 436 T4), that the relevant phrase in the language of the proceedings ("obtained by providing corresponding recesses and/or projections in the relative region of the die of the mould used to produce said capsular base") was correctly translated into German. Whilst the corrected translation states that the raised portions and/or depressions in

the lateral wall of the protection covering by providing corresponding recesses and/or projections in the relative region of the die of the “*Prellwerkzeug*” used, it is directly apparent from a professional standpoint, and implicitly assumed by each of the parties, that this is a typographical error and what is actually meant is a “*Presswerkzeug*” (mould).

33 In the case of the contested embodiments, the ribs on the lateral walls of the stainless steel layer are produced by means of a mould and not a casting tool.

34 c) The court of appeal also correctly expounded that the errors in the first-submitted translation did not cause the effects of the Patent in Suit to be deemed not to have applied within the Federal Republic of Germany from the outset. Differences in content between patent specification and translation have no influence on the validity and scope of the protection conferred by a European Patent nationally (FCJ, judgment of 18 March 2010 - Xa ZR 74/09, GRUR 2010, 708 margin no. 12, 16 - Nabenschaltung II).

35 d) The court of appeal took the stance that the Defendants’ appeal on the basis of Article II Sec. 3(5) German Act on International Patent Conventions must be unsuccessful for the simple reason that the Defendants, by their own submissions, were not familiar with the incorrect translation of the patent specification. This is incorrect.

36 aa) In relation to the similar legal provision in Sec. 43(4) German Patent Act (old version), being the predecessor provision to Sec. 123(5) German Patent Act, the Federal Court of Justice held the good faith protection contained therein not to be limited to parties who knowingly commence using patents that have expired, for example due to non-payment of the statutory fees, but also to benefit the unwitting users of such (FCJ, judgment of 27 May 1952 - I ZR 138/51, BGHZ 6, 172, 176 - Wäschepresse; in the same way, Supreme Court of the German Reich, GRUR 1926, 475, 477 on the right to continued use pursuant to Sec. 6 of the Bekanntmachung betreffend die Begründung, Erhaltung oder Wiederherstellung von gewerblichen Schutzrechten der Angehörigen der Vereinigten Staaten von Amerika vom 6. Juli 1921 [RGBl. 1921, p. 844]). The Federal Court of Justice held in its judgment that Sec. 43(4) German Patent Act

(old version) contained a general legal concept that applied also outside its area of direct application. The conclusion correctly drawn from this was that even a party who is not familiar with the incorrect version of the translation favourable to him will generally enjoy good faith protection pursuant to Article II Sec. 3(5) German Act on International Patent Conventions (old version) (Rogge, GRUR 1993, 283, 284 et seq.; Kühnen, Handbuch der Patentverletzung, 7th edition, 2014, margin no. 1774; Higher Regional Court of Düsseldorf, judgment of 24 June 2011 - 2 U 62/04, Juris margin no. 185; dissenting Rauh, GRUR Int. 2011, 667, 671).

37 bb) Consequently, even a party who, had he been familiar with the incorrect translation, would have been entitled to conclude that the relevant patent claim was directed at an object variant from the actual object protected, may rely on good faith protection pursuant to Article II Sec. 3(5) German Act on International Patent Conventions (old version). Whether this is the case will depend on the specific circumstances of the individual case. It will therefore be necessary to reject good faith for example if, on reading the translation, the skilled person would immediately recognise its incorrectness and - possibly using the translation of the description - be able correctly to determine the content of the patent (cf. Higher Regional Court of Düsseldorf, *op. cit.*, Juris margin no. 181 ff.; Higher Regional Court of Düsseldorf, judgment of 10 April 2003 - 2 U 6/02 margin no. 77 et seq., in Juris; Rauh, GRUR Int. 2011, 667, 672). The Plaintiff bears the burden of proof in this regard (cf. BGHZ 6, 172, 177 - Wäschepresse). Based on this, the Defendants would be unable to rely on good faith if, on reading the first-submitted translation, it ought to have been immediately obvious to them based on their specialist knowledge that the lateral wall of the base could not be formed according to the invention by means of a casting tool, meaning that they would have to have concluded that the translation was incorrect.

38 e) Should good faith protection come into question in accordance with the above, the court of appeal will also be required to examine whether a claim by the Defendants to a right of continued use must fail on account of the contested embodiments constituting an infringement of even the incorrect translation of the Patent in Suit. Given, as already stated, that feature 3

engenders no further requirements as to the design of the raised portions or depressions in the lateral wall of the protection covering of the capsular base, it will only be possible to reject an infringement of the notional patent claim as incorrectly translated should the skilled person consider there to be requirements of this kind that the contested embodiments do not fulfil, should it be possible to achieve the raised portions or depressions in the lateral wall of the protection covering according to the invention by means of a casting tool.

39 The court of appeal - as was logical from its position - has made no determinations in this regard. This, too, must be done if necessary.

Meier-Beck

Gröning

Bacher

Deichfuß

Kober-Dehm

Previous instances:

Regional Court of Munich I, judgment of 4 February 2010 - 7 O 7110/08 –
Higher Regional Court of Munich, judgment of 23 May 2013 - 6 U 2752/10 (2) -