

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2014-09-16
Docket Number / Aktenzeichen:	X ZR 61/13
Name of Decision / Name der Entscheidung:	Short message services



Arbeitskreis
Patentgerichtswesen
in Deutschland e.V.

[Stamp:] Received
October 2, 2014
Jordan & Hall
Attorneys-at-law at the Federal Supreme Court

FEDERAL SUPREME COURT

DECISION

X ZR 61/13

dated

September 16, 2014

in the litigation

Motorola Mobility Germany GmbH, represented by the managing directors,
Telco-Kreisel 1, Idstein

Defendant and appellant,

- Attorneys of record: Attorneys Jordan and Dr. Hall -

versus

Microsoft Corporation, represented by the Chief Executive Officer, One Microsoft Way,
Redmond, Washington, United States of America,

Plaintiff and appellee,

- Attorneys of record: Attorneys Dr. Osterloh and Osterloh -

On September 16, 2014, the 10th Civil Senate of the Federal Supreme Court, under Presiding Judge Prof. Dr. Meier-Beck, Judges Dr. Grabinski, Dr. Bacher Hoffmann and Schuster,

has ruled:

The compulsory execution from the decision by the Munich I Regional Court of May 25, 2012 and from the decision by the Munich Higher Regional Court of April 25, 2013, is temporarily suspended subject to provision of a security in the amount of €4 million.

Grounds:

I. The Regional Court ordered that Defendant be enjoined and further ordered rendering of accounts, destruction and recall and held that Defendant is obligated to pay damages for infringement of European Patent 1 304 891 (patent in suit), granted for the Federal Republic of Germany. The appeals court rejected the appeal [German: Berufung] and disallowed a further appeal [German: Revision]. The Defendant filed a complaint with the objective of securing leave for a further appeal, on which the senate has not yet ruled on. Meanwhile, the Federal Patent Court, in a decision dated May 7, 2014 (6 Ni 12/14), declared the patent in suit invalid with effect for the Federal Republic of Germany following a nullity action filed during the regional court proceedings. Prior to delivery of this ruling, the Defendant petitioned to have the compulsory enforcement from the contested appellate court ruling temporarily suspended subject to a security.

In a decision dated July 8, 2014 (X ZR 61/13, juris – irreplaceable disadvantage), the senate rejected this petition. Against this decision, the Defendant filed a motion for reconsideration.

II. The admissible motion for reconsideration is unfounded. At the same time, however, it is to be viewed as a remonstrance and leads, in light of the changed circumstances resulting from the grounds for the patent court decision, which are now available, to the temporary suspension of the compulsory enforcement, subject to a security.

1. Under §719 para. 1 ZPO [German Code of Civil Procedure], in connection with §707 para. 1 ZPO, the compulsory enforcement for a first instance judgment finding patent infringement must in general be temporarily suspended subject to a security, if the patent in suit is declared invalid by the (not final) decision of the patent court.

If the patent in suit is challenged with a nullity action, the infringement court only issues an infringement judgment, when it decides that there was an infringement of the patent, only if it believes a nullification to be (overwhelmingly) unlikely; otherwise, it suspends the proceedings pursuant to §148 ZPO, at least until a decision is reached at first instance over the nullity action. A – temporarily enforceable – obligation of the Defendant in the infringement action to an injunction, rendering of accounts and destruction of accused products is generally not justifiable, if it is to be expected with sufficient likelihood that the basis of this conviction will fall apart as a result of the nullification of the patent in suit. The constitutionally backed right to legal relief following from the right of due process (Art. 20 para. 3 GG [German Basic Law]), in connection with the basic rights

(see only BVerfGE [Federal Constitutional Court Review] 88, 118, 123), mandates that effective legal protection be provided to the defendant in the infringement action if it wishes to fight the attack from the patent in suit with a counterattack against the validity of this patent. This not only requires an effective ability to conduct this attack by filing a nullity action, but also the suitable consideration of the fact that this attack constitutes a – and possibly the only – means of defense against being sued based on the patent. Because of the statutory rule, which merely requires a valid patent for the claims pursuant to §§ 139 ff. PatG [German Patent Act] and, for the elimination of this legal position, only provides for the nullity action, which falls within the exclusive jurisdiction of the Patent Court, the attack on the patent in suit cannot, in contrast to other legal systems, be used as an objection in the infringement proceeding or be waged by filing a countersuit for revocation. However, this must not lead to this attack being denied any impact on the infringement proceeding. Instead, the stay of the infringement suit is generally necessary if it can be expected with sufficient likelihood that the patent in suit will not withstand the nullity action.

However, if the defendant in the infringement action has already been sentenced for patent infringement in a temporarily enforceable decision, the stay of the infringement suit alone is not sufficient to accommodate a likely nullification of the patent in suit. Instead, the expectation of the infringement court that the patent in suit will be declared invalid at the same time rattles the basis of a previously issued judgment establishing patent infringement, as well as a judgment by default, to such a degree that it is generally necessary to make use of the possibility of temporarily suspending the compulsory enforcement of this ruling pursuant to §§719 para. 1, 708 para. 1 ZPO subject to a security.

This is regularly indicated when the patent in suit has already been declared invalid by the Federal Patent Court, which has to assess its validity in first instance. This also corresponds to the practice of the higher regional courts (cf. Düsseldorf Higher Regional Court, decision of July 7, 2008 – 2 U 90/06, InstGE 9, 173 – Cardiac valve ring prosthesis).

A different assessment can be appropriate in an individual situation if significant indications arise, from the grounds of the patent court's decision, that it is unlikely to withstand a review in the appeal proceedings. However, this comes into question only in exceptional cases.

2. If the Patent Court has – as in the case at issue – declared the patent in suit to be invalid, the compulsory enforcement must also be temporarily suspended based on an analogous application of §§719 para. 1, 707 para. 1 ZPO subject to a security, if the infringement proceeding had already been decided by the appellate court and is pending with the Federal Supreme Court due to a motion to allow for a further appeal or an allowed further appeal. In this regard, the possibility of suspension pursuant to §§719 para. 1, 707 para. 1 ZPO applies in addition to the suspension pursuant to §719 para. 2 ZPO, which was primarily sought by the Defendant and explained in the court decision of July 8, 2014, the conditions of which were not met, as was explained in detail in this ruling.

According to the wording of §719 para. 1 ZPO, in a case where the defendant cannot show probable cause that it would suffer an irreplaceable disadvantage as a result of the enforcement, the possibility of ordering the temporary suspension of the compulsory enforcement is only available if an objection or an appeal is filed against a ruling declared temporarily enforceable.

However, the provisions must be applied analogously during the appeal proceedings and in the proceedings for allowance of a further appeal if the patent in suit was declared invalid in first instance.

The goal and purpose of differentiating between the conditions of §719 para. 1 and §719 para. 2 ZPO is to allow for the increased guarantee of accuracy, which the law associates with appellate judgments, as is similarly the case in §708 No. 10 and §717 para. 3 ZPO, on the one hand, and in §§709, 717 para. 2 ZPO, on the other. It does not sufficiently account for the peculiarities of the interconnection between a patent infringement trial and a patent nullification proceeding, which arise from the "principle of bifurcation." The resulting gap in regulation, which is unintended, is to be filled by analogously applying §719 para. 1 ZPO.

In the infringement litigation, the question of a stay pursuant to §148 ZPO and, therefore, the question of whether an action filed for revocation has sufficient prospects of success, must be reexamined in each instance, while taking into account the respective state of the patent nullity suit. However, the evaluation of this question does not offer a guarantee of accuracy comparable to the assessment of the legal situation on the whole, because the decision on the revocation action is not incumbent on the judge in the infringement case, but rather the Patent Court in first instance. If the Patent Court accedes to the revocation action, the guarantee of accuracy of an appellate judgment is rattled for reasons beyond this judgment, namely to the same degree as the guarantee of accuracy of a corresponding ruling in the first instance would be rattled. In light of this, there is no room for the differentiation on which the provision in §719 para. 1 and 2 ZPO is based. Instead, the provision of §719 para. 1 ZPO must be applied analogously if an appeal proceeding or a motion for allowance of a further appeal has been filed against an appellate judgment.

3. According to these principles, the temporary suspension of compulsory enforcement from the appellate judgment and the judgment of the Munich I Regional Court must also be applied in the case at issue.

The assessment on which the contested appellate judgment was based, namely that the nullity action would remain unsuccessful, was refuted by the decision of the Patent Court. The grounds for that decision, which are now available, contain no indication that this is obviously incorrect. Against this background, the enforcement of the contested judgment is to be temporarily suspended subject to a security by analogously applying §719 para. 1 ZPO. Special circumstances that could, as an exception, suggest a different assessment have neither been demonstrated nor are otherwise apparent. The Plaintiff's statement that it will not undertake any further enforcement measures based on the infringement decisions until final resolution of the nullity action does not

provide the Defendant with a legal position that would be comparable with the temporary suspension of the compulsory enforcement, because it was given under the vague reservation of "unchanged circumstances."

Meier-Beck

Grabinski

Bacher

Hoffmann

Schuster

Lower courts:

Munich I Regional Court, decision of 5/25/2012 – 7 O 19334/11 –

Munich Higher Regional Court, decision of 4/25/2013 – 6 U 2420/12 –

Executed

[signature]

(Bürk)

Official Inspector

As Clerk of the Court