

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2015-02-03
Docket Number / Aktenzeichen:	X ZR 69/13
Name of Decision / Name der Entscheidung:	Audio signal coding



Arbeitskreis
Patentgerichtswesen
in Deutschland e.V.



FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

DECISION

X ZR 69/13

Announced on:
February 3, 2015
Wermes
Judicial Inspector
as registrar
of the Court

in the legal dispute

Reference work: yes
BGHZ: yes (*decisions of the Federal Court of Justice in civil matters*)
BGHR: yes (*jurisprudence of the Federal Court of Justice*)

Audio signal coding

PatG (Patent Act) § 10 para 1

- a) A means does not relate to an essential element of the invention in the meaning of § 10 para 1 Patent Act, if it is used for realizing a method step preceding the steps provided in the patent claim of a method patent. This also applies, if the upstream step is necessary in order to be able to carry out the steps provided in the patent claim, and if the means due to its precise configuration can be used exclusively for this purpose.
- b) A means by which specific method steps are carried out during transmitting an audio signal, does not relate to an essential element of the invention, if the patent in fact protects a transmission method, however, in the patent claim, only other steps of this method are determined in more detail and the configuration of the method steps relating to the means are not of relevancy for the realization of the invention.
- c) Anyone who abroad provides a third party with a means relating to an essential element of the invention, the third party forwarding it with his knowledge and consent for using the invention in Germany, initiates a provision of the means within the scope of the Patent Act.

Federal Court of Justice, BGH, judgment dated
February 3, 2015 – X ZR 69/13 –

Higher Regional Court at Karlsruhe
District Court at Mannheim

The X. Civil Chamber of the Federal Court of Justice subsequent to the oral proceedings held on February 3, 2015 through the Presiding Judge Prof. Dr. Meier-Beck, the Judges Dr. Grabinski, Dr. Bacher, and Hoffmann as well as the female Judge Dr. Kober-Dehm

has ruled:

Subsequent to the revision appeal of the defendant, the judgment of the 6th Civil Chamber of the Higher Regional Court at Karlsruhe announced on May 8, 2013 shall be set aside regarding the matter of costs and to the extent as the confirmed sentencing relates to receivers (MP2 players), neither containing components suitable for carrying out the decoding steps according to the patent nor being offered or delivered together with the software by means of which such a decoding may be triggered.

In the scope of the annulment, the appeal against the judgement announced by the 7th Civil Chamber of the District Court at Mannheim on March 9, 2012, is dismissed.

The further revision appeal is rejected.

The costs of the legal dispute shall be two-thirds borne by the defendant and one-third by the plaintiff.

By law

Facts of the Case:

1 The plaintiff takes legal action against the defendant due to indirectly infringing a method patent.

2 The plaintiff is owner of an exclusive right of use in the European patent no. 568 532 (patent in suit) granted with effect in the Federal Republic of Germany relating to a method of transmitting digitized audio signals and expired due to lapse of time with expiry of June 27, 2011. Patent claim 1 has the following wording:

A method of transmitting digitized, block coded audio signals using scale factors formed during block coding of the digitized audio signals from the amount of the peak value of a sequence (block) of signal values and brought in quantized form to the sampled signal values of the respective sequence, wherein, in the coder:

a) from a plurality of k timely successive scale factors (scf_{11} , scf_{12} to scf_{1k} ; ... scf_{n1} , scf_{n2} , ... scf_{nk}) of each frequency sub-band or of a group of spectral values of an audio signal subdivided into n sub-bands or spectral values (where $n \geq 1$), the differences

$$\begin{aligned} d_{12-11} &= scf_{12} - scf_{11} \\ &\text{to} \\ d_{1k-1(k-1)} &= scf_{1k} - scf_{1(k-1)}; \\ &\cdot \\ &\cdot \\ &\cdot \\ d_{n2-n1} &= scf_{n2} - scf_{n1} \\ &\text{to} \\ d_{nk-n(k-1)} &= scf_{nk} - scf_{n(k-1)} \end{aligned}$$

are formed according to sign and amount;

(b) the $(k-1)*n$ differences formed according to step (a) are grouped in at least two value classes with each value class including a quantity of one or a plurality of possible differences;

(c) scale factors are selected on the basis of the sequence of $(k-1)*n$ value classes formed according to step (b) - separately for each one of the n sub-bands or spectral value groups, respectively - and are provided with identifying information, with the number of successive, different, selected scale factors within the sequence being less than or equal to the number of successive, different scale factors of the considered sub-band or spectral value group; and wherein the identifying information identifies the association of each one of the selected scale factors with one or a plurality of the k blocks

of the sampled signal values of the respective sub-band or spectral value group, respectively,

and wherein, in the decoder:

- (d) the associated, selected scale factors are assigned with the aid of the identifying information to the blocks of the sampled signal values; and
- (e) audio signals are regenerated from the sampled signal values and from the assigned selected scale factors, with these audio signals more or less corresponding to the original audio signals,

characterized in that during the block coding the following method steps are provided within irrelevance and redundancy reducing audio data reduction methods:

- (f) the $(k-1)n$ differences formed according to step (a) are grouped into more than two value classes;
- (g) in the selection of scale factors according to step (c), a transmission pattern of new scale factors is determined separately for each one of the n sub-bands or spectral value groups, respectively, according to psychoacoustic aspects with respect to the pre-masking and post-masking effects of the human auditory system, with a distinction being made between psycho-acoustically relevant changes in the scale factors; and
- (h) a control information indicating at which locations k the new scale factors are disposed is employed as the identifying information.

3 The defendant domiciled in China manufactures devices being able to receive and process television signals according to the DVB standard (Digital Video Broadcast). The audio signals belonging to such television signals are coded according to the standard MPEG-2. The coding method defined therein comprises the features provided in patent claim 1.

4 The defendant has exhibited her products in 2010 and 2011 at the CeBIT trade fair. In addition, she has delivered the devices to a company domiciled in Germany by using the trade term "free on board China". Her customers further include a different company in China delivering the devices to a further company domiciled in Germany, as well.

5 Some of these devices (in particular mobile TV devices) contain a unit by which the received signal is decoded. In other devices (in particular USB sticks, USB TV boxes, and plug-in cards), the signal is only demodulated, i.e. detached from the carrier frequency used for the transmission. The subsequent decoding occurs software-controlled via a computer by which these devices can be connected by means of a USB connection or a plug-in card. A part of these devices is provided with a software by which the decoding process can be triggered.

6 The plaintiff claims that offering and delivering of all attacked embodiments constituted an indirect infringement of the patent in suit. Her claim initially also directed to an injunctive relief and after expiration of the patent in suit only to accounting and determining the obligation of compensation liability, has remained unsuccessful in the first instance. The Court of Appeal, on the contrary, has sentenced the defendant according to the request. This is counteracted by the defendant by the revision appeal granted by the Senate to which the plaintiff opposes.

Grounds of Decision:

7 The admissible revision appeal is justified only with respect to one of the three
attacked embodiments. To this extent, it leads to re-establishment of the first instance
judgment.

8 I. The patent in suit relates to a method for transmitting digitized, block-coded
audio signals.

9 According to the explanations in the patent description in suit, it was known in the
prior art to form scale factors to reduce the data amount to be transmitted by means of which
the size range of the transmitted value is specified. This makes the transmission of
redundant data dispensable to a certain extent. There were also methods known according
to which the signals are split up into sub-bands and are adjusted about individual information
which are irrelevant for the human auditory system. Further, it was known that the amount of
the data to be transmitted can be further reduced with the transmission of scale factors by
determining the difference between consecutive scale factors and converting the same into
an identification information. In the patent description in suit, it is further described that the
known methods for compressing the scale factors only lead to a reduction of redundant
information, however, not to the removal of information which is irrelevant due to
psychoacoustic aspects.

10 Against this background, the patent in suit relates to the technical problem to provide
a transmission method according to which the required data amount can be even further
reduced.

11 In order to solve this problem, the patent in suit suggests a method for transmitting
digitized block-coded audio signals by using scale factors with the method steps a to h from
patent claim 1.

12 II. The Court of Appeal substantially has grounded its decision as follows:

13 Contrary to the objection raised by the defendant, the competent jurisdiction of the
German Courts is also given to that extent as the claim is supported on deliveries of the
defendant carried out directly to a German customer. The place of success for the alleged
infringing actions, thus, is located in Germany.

14 The attacked embodiments are means relating to an essential element of the protected invention. Regarding a method claim, all devices mentioned in the patent claim which were used for carrying out the method, regularly belong thereto. This requirement is fulfilled regarding all attacked embodiments.

15 Devices with integrated decoder are suitable to decode MPEG-2 coded signals according to the features d and e. The fact that the final customers only carried out the decoding process, however, not the coding process, is irrelevant. The protected method requires a functional interaction according to the invention of coder and decoder. In any event, in such a case, a direct patent infringement may also be committed in complicity and as an independent perpetrator.

16 The same applies for devices without decoder to the scope of delivery of which a software with decoding function belongs. Regarding these, the decoding which is essential according to the invention occurs by the provided software.

17 Devices without integrated decoder and without provided software, as well, essentially contribute to the decoding process. This cannot occur without a preceding demodulation. This differentiates the attacked devices from mere data carriers, as e.g. a DVD.

18 The defendant is responsible for placing such devices on the German market since she has known that the devices delivered by her were intended to be passed there. Due to the international DVB standard, it has also been obvious that the devices would be used for the method according to the patent. The defendant further has offered such devices at the CeBIT trade fair. It is irrelevant here that the customers addressed there are only retailers.

19 The objected acts of use have not occurred with the plaintiff's consent. For her contested submission that the software supplied with some devices uses the decoder of the licensee Microsoft belonging to the Windows Media Player, the defendant has not provided any evidence. In any case, one of the companies supplied by the defendant likewise does not have any rights of use in the subject matter of the patent in suit.

20 The fact that customers of devices without decoder and without provided software for decoding used the Windows Media Player, does not result in a deviating assessment. With

regard to a method patent, exhausting cannot occur, if only a device suitable for carrying out the method, as is presently the case, is realized. Granting a license to Microsoft cannot be considered being a tacit consent also, since the Windows Media Player is only one of several components required for carrying out the method and the demodulators of the defendant indisputably do not originate from the licensed source.

21 If the plaintiff granted a license to the broadcasting organizations, coding the signals in the manner as protected by the patent is irrelevant. Due to lack of other indications, it can be assumed that the consent of the plaintiff only relates to the method steps to be carried out by the coder.

22 III. This assessment only withstands the objections of the revision appeal to that extent as they relate to devices neither comprising components to carry out the decoding steps according to the patent nor are offered or provided together with the software by which the decoding can be triggered.

23 1. Justifiably and without objection in the revision appeal, the Court of Appeal affirmed the international competence also for supplies of the defendant to a customer domiciled in Germany.

24 According to the general principles applicable in the case of dispute, the German Courts are internationally competent pursuant to § 32 ZPO (Civil Code of Procedure) if an infringement of a property right arises from the plaintiff's submission in Germany (cf. Federal Court of Justice – BGH – judgment dated August 21, 2012 – X ZR 33/10, BGHZ 194, 272 = GRUR¹ 2012, 1230 recital 9 – MPEG-2-Videosignalcodierung (*video signal coding*); judgment dated June 29, 2010 – VI ZR 122/09, NJW²-RR 2010, 1554 recital 8). The Court of Appeal has justifiably considered these prerequisites being fulfilled since the place of success of the objected actions is located in Germany according to the plaintiff's submission relevant to that extent. The fact that the place of action is located abroad, is irrelevant (cf. Federal Court of Justice – BGH, NJW-RR 2010, 1554 recital 10).

25 2. The Court of Appeal has not erred in law coming to the result that the supplies carried out by the defendant from China constitute relevant acts of use in Germany.

¹ German Association for the Protection of Intellectual Property, its journal

² The Neue Juristische Wochenschrift (NJW) (German: New Legal Weekly Journal) is a German legal magazine. It is published weekly by C. H. Beck in a run of 42.836 copies. It was founded in 1946[1] and counts as one of the two most important German legal magazines. *Source: Wikipedia*

26 a) According to the jurisdiction of the Senate, a supplier domiciled abroad is responsible for a patent infringement committed in Germany, if he supplies a protected product to a customer domiciled in Germany. This applies irrelevant of the fact at which place property, possession, and risk of the supplied product are passed on to the customer (Federal Court of Justice – BGH, GRUR 2002, 599 – Funkuhr I (*radio clock*)).

27 b) Contrary to the opinion of the revision appeal, these principals also apply for actions qualified as indirect patent infringement in the sense of § 10 para 1 Patent Act.

28 The indirect infringement of a patent according to § 10 Patent Act constituting an act of offence takes up the fact that a specific subject had been supplied to Germany just as the direct patent infringement according to § 9 Patent Act constituting an act of offense. These elements of offense only differ due to the fact that the supplied subject in case of § 9 Patent Act considered by itself falls in the scope of protection of the patent, whereas in case of § 10 Patent Act, it only constitutes a means relating to an essential element of the invention. For the question relevant in this context, if a supply has occurred to Germany, does not justify any difference.

29 c) Against this background, the Court of Appeal in the case of dispute justifiably affirmed a supply to Germany.

30 aa) For the direct supply of devices to a customer domiciled in Germany from this it already arises that the defendant herself initiated the supply. The fact that the product had already been delivered in China corresponding to the stipulated provision “free on board China”, is irrelevant according to the demonstrated jurisdiction of the Senate.

31 bb) Regarding the supplies to a different company domiciled in China which has sold the product to a customer domiciled in Germany, in the case of dispute, the same issue remains unchanged.

32 According to the assessments of the Court of Appeal, the defendant has been aware of the fact that the company supplied by her possibly also exports products to Germany. Moreover, she has designated the customer domiciled in Germany on her Internet websites being distributor for the European market. In view of this, the conclusion drawn by the Court of Appeal that the defendant has contributed to the delivery to Germany initiated by her direct customer due to her own culpable behavior, is not objectionable.

33 3. The Court of Appeal has further justifiably decided that the attacked devices with integrated decoder or provided software constitute means which are suitable and intended to be utilized for the use of the invention.

34 a) Whether a means is suitable to be utilized for the use of the invention is to be assessed according to the objective configuration of the offered and supplied subject. The means has principally to be configured such that a direct use of the protected teaching with all its features is feasible by the customer (Federal Court of Justice – BGH, judgment dated September 24, 1991 – X ZR 37/90, BGHZ (115), 204, 208 = GRUR 1992, 40, 42 – Beheizbarer Atemluftschlauch (*heatable inhaled air hose*); judgment dated June 7, 2005 – X ZR 247/02, GRUR 2005, 848, 850 – Antriebsscheibenaufzug (*drive pulley lift*)).

35 Regarding patents relating to a multiple-stage method, a means may also be suitable to use the invention, if the customers of this means do not carry out all method steps on their own. In any case, in such an event, the direct patent infringement cannot be committed only by one actor by realizing all method steps but also in complicity (Federal Court of Justice – BGH, judgment dated February 27, 2007 – X ZR 113/04, GRUR 2007, 773 recital 19 – Rohrschweißverfahren (*tube welding method*)).

36 b) For the case of dispute, the Court of Appeal justifiably derived therefrom that the attacked embodiments are suitable to use the invention even if the customers only carry out the decoding steps therewith provided in the patent claim, however, the coding occurs by a different person.

37 c) Contrary to the opinion of the revision appeal, the above demonstrated jurisdiction not only relates to a non-generalizable individual case.

38 aa) The Senate, in fact, has outlined in the last cited decision that “in such an event, it would be sufficient in any case” if not all method steps were realized by the customer of the offered or supplied means (Federal Court of Justice – BGH, GRUR 2007, 773 recital 19 - Rohrschweißverfahren (*tube welding method*)). The principle formulated therein, however does not only relate to the individual case underlying this decision but in any case to all constellations in which a multiple-stage method is protected and single method steps constitute a necessary prerequisite to carry out further method steps essential for the invention.

bb) The constellation to be assessed in the case of dispute does not have any peculiarities leading to a deviating assessment. The features of the patent claim at issue are here as well taken up in the above mentioned manner.

40 Receiving and decoding of signals as provided in the patent claim requires that the same beforehand have been coded and sent in the manner as well provided in the patent claim. Conversely thereto, sending the coded signals typically occurs for the purpose that they are received and decoded at a remote position. Regarding the use at issue – receiving television signals – this context becomes particularly clear.

41 cc) Contrary to the opinion of the revision appeal, the demonstrated jurisdiction of the Senate does not only relate to the case of complicity.

42 However, the revision appeal justifiably assumes that the complicity in the case of dispute due to the conclusions drawn by the Court of Appeal cannot be affirmed. Just as incitement and abetment, complicity prerequisites a conscious and intentional interaction during precipitating the infringement (Federal Court of Justice – BGH, judgment dated February 23, 1988 – VI ZR 151/87, NJW 1988, 1719, 1720). According to the conclusions of the Federal Court of Justice, however, in the case of dispute only a negligent infringement of the patent in suit comes into question.

43 However, the Federal Court of Justice has decided that regarding a realization of individual method steps, not only complicity but also independent perpetration comes into question (Federal Court of Justice – BGH, judgment dated February 27, 2007 – X ZR 113/04, GRUR 2007, 773 recital 19 – Rohrschweißverfahren (*tube welding method*)). The Court of Appeal has not erred in law determining that the prerequisites therefor are available in the case of dispute.

44 d) Contrary to the opinion of the revision appeal, independent perpetration does not require that all prerequisites of the patent infringement are fulfilled regarding each perpetrator on his own.

45 aa) According to general principles under tort law, independent perpetration is available if several tort perpetrators under tort law have contributed to cause a damage without conscious concurrence (Federal Court of Justice – BGH, NJW 1988 1719, 1720). From this, it results as also assessed by the appeal to some extent that principally every

independent perpetrator is obligated to completely compensate the damage caused by him independent of the contributory offense of the other person (cf. Federal Court of Justice, only, - BGH, judgment dated October 5, 2010 – VI ZR 286/04, NJW 2011, 292 recital 9).

46 bb) Contrary to the opinion of the revision appeal, it does not arise therefrom that a patent infringement through independent perpetrators regarding method patents can only occur in the manner that every independent perpetrator carries out all method steps on his own.

47 As offender of a negligent patent infringement, the person who has caused the infringement of rights by his or her own culpable behavior rather has to be held responsible for the same. A culpable behavior in this sense may for example be based on the fact that actions of a third party which are directed to the use of a patent are not prohibited contrary to the duty (Federal Court of Justice – BGH, judgment dated September 17, 2009 – Xa ZR 2/08, BGHZ 182, 245 = GRUR 2009, 1142 recital 34 – MP3-Player-Import; judgment dated January 30, 2007 – X ZR 53/04, BGHZ 171, 13 = GRUR 2007, 313 recital 17 – Funkuhr II (*radio clock*); decision dated February 26, 2002 – X ZR 36/01, GRUR 2002, 599 – Funkuhr I (*radio clock*)).

48 A culpable behavior in this sense may also be available, if a person during applying the method takes the advantage from the circumstance that certain steps of the method are carried out by a third party and can be included into the own action. These prerequisites are fulfilled in the case of dispute.

49 cc) The question of the responsibility of offense stressed by the revision appeal, as justifiably held by the Court of Appeal, is irrelevant in this context.

50 It is not a question of whether the customers of the attacked devices can or have to prevent a broadcasting organization from broadcasting its television program. A user decoding a signal coded and broadcasted by the television station in the manner according to the patent, in any event takes advantage of the input of the television station in order to use the method according to the patent in its entirety. This is sufficient for affirming independent perpetration. It is irrelevant whether a broadcasting organization broadcasting signals which are coded according to the patent without a license has to answer for being independent perpetrator. As already outlined, every independent perpetrator is principally fully liable and remains independent of a possible liability of further parties involved.

51 e) Contrary to the opinion of the appeal, the patent in suit does not only protect
methods according to which all steps are carried out by the same user.

52 The wording of patent claim 1 cited for this purpose by the revision appeal cannot
support the interpretation postulated by the same. The patent claim only defines individual
steps of the method, however, does not determine the person who or the device which shall
carry out said method.

53 There cannot be drawn any deviating conclusions from the term “transmit” used in the
patent claim. Thereby, it is irrelevant which importance is attached to this term according to
the general technical language. From the context of patent claim 1, it arises at any event that
a method for transmitting audio signals in the meaning of the patent in suit is always
available if the signals are coded by the transmitter in the manner as defined in the patent
claim and are decoded by the receiver in the respective manner.

54 Other circumstances from which a narrower interpretation of the patent claim may
arise, is not demonstrated by the appeal.

55 f) Contrary to the opinion of the revision appeal, in this context it is not the
question whether a sub-combination or partial combination may fall under the scope of
protection of a patent. According to the jurisdiction demonstrated above and taken as a basis
by the Court of Appeal, all features of the protected method have always to be realized –
however, precisely not necessarily by the same person.

56 4. The Court of Appeal has justifiably concluded that devices with integrated
decoder or provided software are means in the meaning of § 10 para 1 Patent Act relating to
an essential element of the invention.

57 a) According to the jurisdiction of the Senate, the question of what belongs to the
essential elements of the invention is to be answered seen from the subject matter of the
invention.

58 Since the patent claim is decisive for the issue of the subject matter protected by the
patent, regularly all features mentioned in the patent claim are essential elements of the
invention pursuant to § 10 para 1 Patent Act. Therefore, regarding a method patent, a device
mentioned in the patent claim which is used for carrying out the method regularly relates to

an essential element of the invention (Federal Court of Justice – BGH, GRUR 2007, 773 recital 14 – Rohrschweißverfahren (*tube welding method*)). This shall not apply for means which in fact can be used for the utilization of the invention, however do not contribute to the realization of the protected teaching. If, in contrast, a means makes such a contribution, it is principally not a question with which feature or features of the patent claims it interacts (Federal Court of Justice, judgment dated August 21, 2012 – X ZR 33/10, BGHZ 194, 272 = GRUR 2012, 1230 recital 32 – MPEG-2-Videosignalcodierung (*video signal coding*); judgment dated February 27, 2007 – X ZR 38/06, BGHZ 171, 167 = GRUR 2007, 769 recital 18 – Pipettensystem (*pipette system*); judgment dated May 4, 2004 – X UR 48/03, BGHZ 159, 76, 86 = GRUR 2004, 758, 761 – Flügelradzähler (*impeller counter*)). Therefore, it is generally irrelevant, if the feature with which the means interacts is anticipated or rendered obvious by the prior art or if it relates to the “core” of the invention (BGHZ 171, 167 recital 20 - Pipettensystem (*pipette system*); BGH/ 159, 76, 86 (Flügelradzähler (*impeller counter*)).

59 b) Against this background, the Court of Appeal has not erred in law when
considering the attacked devices being means relating to an essential element of the
invention.

60 According to the non-contested conclusions of the Court of Appeal, these devices are
suitable to carry out the decoding steps as provided in patent claim 1. This is sufficient to
affirm the element of offense according to § 10 para 1 Patent Act.

61 c) The Court of Appeal as well has not erred in law when deciding that these
prerequisites are fulfilled also regarding those devices which are delivered without integrated
decoder but with the provided software.

62 aa) Contrary to the opinion of the revision appeal, offering or delivering such
devices including software belongs to the attacked embodiments.

63 According to the factual conclusions of the Court of Appeal, a software with decoder
functionality belongs to the scope of delivery. These conclusions are binding according to §
314 Civil Code of Procedure and are to be taken as a basis for an examination in the revision
appeal according to § 559 para 1 Code of Civil Procedure.

64 bb) On the basis of the above, the Court of Appeal justifiably has concluded that
these devices relate to an essential element of the invention since they are likewise suitable
to carry out the decoding steps provided in patent claim 1.

65 cc) The revision appeal objects that the Court of Appeal unjustifiably has assigned
the burden of proof to the defendant for the fact that the provided software uses a decoder
component to be procured from Microsoft by the user for decoding the signals.

66 This objection is unjustified.

67 (1) In this context, it is irrelevant whether the defendant's submission was
sufficiently substantiated to that extent.

68 The Court of Appeal has not disregarded the submission due to lacking substantiation
but due to the fact that the defendant considered it to that extent being subject to be proven.

The revision appeal does not demonstrate that the Court of Appeal has ignored the offers of evidence by the defendant.

69 (2) The Court of Appeal has justifiably considered the burden of proof being on the defendant.

70 By her submission the provided software uses a decoder component of Microsoft, the defendant has not contested that the software offered and supplied by her is suitable to carry out the decoding steps according to the invention. She rather has claimed carrying out these method steps is not illegal due to an issue of license to Microsoft. The prerequisites of licensing or another authorization to use the patent in suit has to be presented and evidenced by the person who refers to the corresponding rights. In the case of dispute, this is the defendant.

71 5. The Court of Appeal has not erred in law to negate an indirect patent infringement already due to offering or supplying devices with integrated decoder or provided software since the defendant according to her submission indicated the operating system Windows and Windows Media Player for all attacked embodiments being the system prerequisites.

72 Such reference in any event cannot exclude an indirect patent infringement since according to the patent pursuant to the conclusions of the Court of Appeal which are not to be objected to that extent, the method can be carried out with these devices independently of using additional software. The indication of the requirement of further software components which are likewise suitable to carry out the decoding steps according to the patent, cannot be understood as a request to carry out the decoding exclusively by means of those.

73 6. The Court of Appeal has not erred in law to conclude that due to lacking other indications, it is to be assumed that a consent of the plaintiff regarding the activity of the broadcasting organization at most refers to the method steps to be carried out by the coder.

74 a) The revision appeal claims in view of the circumstance that the broadcasting organizations use the standard of the patent in suit, it has to be assumed that they would have obtained corresponding rights.

75 Thereby, she does not demonstrate any legal error.

76

According to the factual conclusions in the appeal judgment, the defendant has indisputably submitted in the first instance that a license has been granted to the broadcasting organizations, at any event, by tacit consent. From this, it does not result that the plaintiff or other persons authorized to use the patent in suit have concluded an explicit license agreement with one or more broadcasting organizations. Without deviating submission of the plaintiff, as well, the Court of Appeal could, thus, at best assume a tacit grant of license by means of toleration.

77 Further submission of the defendant from which the Court of Appel would have had to deduce the conclusion of a license agreement, is not shown by the revision appeal. The submission of the plaintiff cited in the appeal hearing, according to which the broadcasting organizations precisely have not obtained a license to use the patent in suit, cannot support her argumentation.

78 b) Contrary to the opinion of the revision appeal, the deliberation made by the Court of Appeal that a tacit licensing at best refers to the coder, however, not to the decoding process does not err in law since a license which is limited to individual parts or part features would be unusual and legally absurd.

79 Thereby, it may remain undecided whether a license limited to individual partial steps of a patented method is usual. In the case of dispute, the appreciation of the Court of Appeal for legal reasons is not to be objected already for the reason that the plaintiff according to the submission which has to be taken as a basis precisely has not concluded a license agreement with broadcasting organizations but has only tacitly tolerated her activity. The appreciation that such a toleration does not deliberately constitute a consent for acts of use of other persons, is feasible and apart from that, also does not indicate a legal error. In particular, contrary to the opinion of the revision appeal, neither from the application of the broadcasting fee nor from other circumstances, a recognizable interest or even an obligation of the broadcasting organizations can be derived that potential viewers may obtain use authorizations for operating receivers under patent law.

80 c) Contrary to the opinion of the revision appeal, there does not result any deviating assessment from the jurisdiction of the Federal Court of Justice regarding the tacit issue for using a method patent.

81 According to the jurisdiction of the Federal Court of Justice, the person who has acquired a device required for carrying out the method from the owner of a method patent is allowed to use the same according to its provision, if explicit objecting agreements are lacking (Federal Court of Justice – BGH, judgment dated September 24, 1979 – KZR 14/78, GRUR 1980, 38, 39 – Fullplast). If the patent owner grants a license to a third party to market such devices, the third party is authorized to allow his customers to use the method due to lacking deviating agreements (Federal Court of Justice – BGH, GRUR 2007, 773 recital 29 – Rohrschweißverfahren (*tube welding method*)).

82 This jurisdiction – that has justifiably been consulted by the Court of Appeal only in connection with a license possibly granted to Microsoft – is not relevant in the present case already for the reason that by sending signals coded according to the patent, the broadcasting organizations do not sell any device which is suitable to use the method. The sent signals at best are a subject matter for which the decoding steps according to the invention may be used. However, – contrary to the attacked devices with decoding functionality – they are no means for carrying out these steps.

83 7. However, the Court of Appeal has erred in law when considering also those devices as means relating to an essential element of the invention which are offered or supplied without integrated decoder and without provided software.

84 a) Such devices are not suitable to carry out the decoding steps belonging to the method according to the patent, as also has not been misjudged by the Court of Appeal.

85 The decoding regarding these devices occurs on a computer and by means of a software which are not part of this attacked embodiment. The demodulation carried out on the provided devices is indeed necessary to carry out the decoding. However, it does not belong to the method steps provided in the patent claim.

86 b) The Court of Appeal further justifiably concluded that the demodulation is not to be considered as being a mere subject matter or starting point of the protected method.

87 According to the above demonstrated jurisdiction of the Senate, the required reference to an essential element of the invention can be available if a provided means is used quasi as element or component in order to completely carry out the protected invention like a “cog in the wheel”. However, by § 10 Patent Act means are not included which only

relate to the subject matter or starting point of a protected method. For the indirect infringement of a patent relating to a method for decoding data, it is therefore not sufficient to offer or supply a data carrier containing data which are suitable for the decoding. A decoding method without inserting a data carrier into a playback device provided therefor, is neither incomplete nor functionally defective; then, only need and reason for the process of the method is lacking (BGHZ 194, 272 recital 34 – MPEG-2-Videosignalcodierung (*video signal coding*)).

88 The demodulators to be assessed in the case of dispute do not only constitute the subject matter or starting point for the protected method, as the Court of Appeal has correctly recognized. The subject matter of the decoding steps provided in the patent claim are the coded signals which have been demodulated during the transmission of television signals according to the DVB standard to a carrier frequency. The demodulators belonging to the attacked embodiment serve the purpose to extract these signals from the transmitted signal. Thus, they are not subject matter or starting point of the transmission method, but a means to carry out the transmission.

89 c) Contrary to the opinion of the Court of Appeal, this, however, is not sufficient to be able to affirm the reference to an essential element of the invention which is necessary according to § 10 para 1 Patent Act.

90 aa) The decoding steps provided according to the patent claim indeed constitute an essential element of the invention. Contrary to the opinion of the Court of Appeal, however, the demodulators do not show a sufficient reference to this element already for the reason that the decoding of television signals according to the patent transmitted pursuant to the DVB standard is not possible without preceding demodulation.

91 According to the above demonstrated jurisdiction of the Senate, a means, however, can be considered as being a “cog in the wheel”, if its use for realizing a method step provided in the patent claim is causal. For this, however, as a rule, it is not necessary that the means is used during carrying out such a step. The use in an upstream step, principally does not suffice.

92 In the case of dispute, the demodulation indeed constitutes a method step which is necessary, however, which is only upstream to the decoding steps provided in the patent claim. Thus, the required context is lacking.

93 The submission of the defendant to be alleged as being correct for the legal examination in the revision appeal that the attacked devices are exclusively suitable to process DVB signal, does not lead to a deviating assessment. From this submission, it indeed can be derived that due to the circumstances, it is obvious that the devices are intended to demodulate the received signals for the purpose of the subsequent decoding. From the circumstance that a means is intended to be used for method steps upstream to the protected method, however, it cannot be derived that it refers to an essential element of the invention.

94 bb) Whether the demodulation of the received signal can be subsumed under the feature provided in the patent claim "transmitted", does not require a final decision. This feature, at any event, is not an essential element of the invention in the sense of § 10 para 1 Patent Act.

95 According to the jurisdiction of the Senate, a means does not relate to an essential element of the invention, if it indeed can be applied for the use, however, is of completely secondary importance (BGHZ 171, 167b recital 20 – Pipettensystem (*pipette system*)) and does not contribute to the realization of the protected teaching (BGHZ 194, 272 recital 32 – MPEG-2-Videosignalcodierung (*video signal coding*); BGHZ 171, 167 recital 18 – Pipettensystem (*pipette system*); BGHZ 159, 76, 86 – Flügelradzähler (*impeller counter*)).

96 In the case of dispute, this prerequisite is fulfilled with respect to a device which is suitable only for receiving and for demodulating an emitted signal, however, not for decoding that same signal provided in the patent claim.

97 The transmission of the coded signal indeed belongs to the features of the patent claim. However, the method steps between the coding according to the invention and the decoding of the data according to the invention are not of an essential importance according to the patent claim. In particular, according to the teaching of the patent in suit, it is principally irrelevant in which way, in what form and by whatsoever means the transmission occurs. Means which only serve the more precise configuration and realization of this stage of the transmission process, in view of this, are of a completely secondary importance. Therefore, they do not relate to an essential element of the invention.

98 IV. Insofar as the contested judgment is subject to annulment according to this, the Senate can decide in the matter since it is subject to decision (§ 563 para 3 Civil Code of Procedure).

99

From the conclusions of the Court of Appeal which have been made without legal errors, it results as already outlined above that devices supplied without an integrated decoder and without provided software do not relate to an essential element of the invention. Thus, an indirect patent infringement is lacking. Whether the head of claims to that extent are also unjustified for the reason as the users of such devices use the Windows Media Player for decoding and as Microsoft owns a license on the patent in suit, does not require a decision in the light of this.

100 IV. The cost decision is based on § 92 para 1 Code of Civil Procedure.

Meier-Beck

The Judge Dr. Grabinski is
taken ill and therefore
cannot sign here

Bacher

Meier-Beck

Hoffmann

Kober-Dehm

Courts of lower instance:

District Court at Mannheim, decision dated March 9, 2012 – 7 O 43/10

Higher Regional Court at Karlsruhe, decision dated May 8, 2013 – 6 U 34/12