
Direct patent infringement of combination patents and recall from obligors abroad if patent-free replacement deliveries are possible – Higher Regional Court of Düsseldorf in “Beheizbarer Boden für Viehställe”, judgement of July 19, 2018, docket no.: 15 U 43/15

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In the above-mentioned decision, the Higher Regional Court deals with three legal aspects:

First, the Senate confirms its previous case law according to which in the case of combination patents, not only contributory but direct patent infringement is present if the offered or supplied part of a claimed entire device already shows all material features of the idea of the invention, and only an insignificant “everyday ingredient” is necessary at most for it to be completed.

Second, the Senate also confirms its previous case law according to which an obligor abroad is subject to the claim for recall as well.

Finally, the Higher Regional Court considers recall of the patent-infringing products against reimbursement of the purchase price disproportionate if the customer can be provided a patent-free product as a less severe means in exchange for the infringing embodiment.

Facts and circumstances

The plaintiff is the proprietor of two patents that both relate to a heatable floor for livestock stalls. The claimed floor systems consist of a plurality of hollow, rectangular plate bodies, whose cavities are filled with a heat carrier fluid (e.g. water) and heatable by means of heating lines. Between the upper and the lower shells of the plate bodies, there are pipe sockets open on the side, whose lateral openings are oriented in the direction of a filling opening at the edge of the upper shell. This way, during filling, bubble-free distribution of the heat carrier fluid at the underside of the upper shell is achieved, which results in particularly efficient heating of the upper shell.

The defendant, which is located in Spain, has been offering so-called “NON-AIR” filling systems since 2012, which also ensure bubble-free filling of the cavity with water. The systems are supplied without a heat carrier fluid as the customers themselves usually have water available with which they fill the systems.



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Since 2015, the defendant has been offering modified embodiments – which are undisputedly patent-free – where the lateral openings of the pipe sockets are no longer oriented in the direction of the filling opening.

The plaintiff *inter alia* asserted claims for recall against the defendant for direct patent infringement.

The Regional Court of Düsseldorf basically found for the plaintiff and ordered the defendant, particularly due to direct patent infringement, to recall the supplied products against reimbursement of the purchase price. The defendant lodged an appeal against the judgment.

The decision of the Higher Regional Court of Düsseldorf

The Higher Regional Court confirms the decision of the Regional Court in two respects; however, it holds a different opinion in one respect.

1. In the opinion of the Higher Regional Court, the Regional Court correctly assumed direct use although the defendant offers and supplies the infringing “NON-AIR” systems without a heat carrier fluid. If only individual components of an entire device are supplied, only contributory and no direct patent infringement can be taken into consideration in general. However, as an exception, this is different under two premises:

On the one hand, the offered or supplied part of an entire device already has to show all material features of the

protected idea of the invention. On the other hand, for completion, only obvious ingredients have to be added at most (so-called “*everyday ingredients*”), which are insignificant for the teaching protected in the patent as they do not embody the actual invention.

This emerges from the following evaluative consideration: If a third party supplied the missing ingredient, jointly committed direct patent infringement would be present. In the opinion of the Higher Regional Court, it therefore cannot make a difference if the customer is already in the possession of the missing ingredient or will obtain it for certain in order to combine the everyday ingredient with the other components into the entire device protected by the patent. In this constellation, the supplier in the end deliberately appropriates the preparatory and subsequent work of its customer. Therefore, it is justified to treat it as though it had itself supplied the claimed entire device, including the everyday ingredient, to the customer.

In the present case, water is an everyday ingredient, which does not embody the invention as such, since water is available to any customer. Therefore, it can be safely assumed that the customers will fill the supplied “NON-AIR” filling systems with water to achieve heating of the floors in accordance with the systems’ intended purpose. In this regard, it is irrelevant that the wording of the patent claims is not limited to water but covers any heat carrier fluid and only mentions water as an example. The reason for this is that if according to the general teaching of the patent, different ingre-

dients could be taken into consideration for manufacturing the entire device in accordance with the patent, direct patent infringement is already present if only one of them meets the two premises explained above. This is not precluded by the fact that the “NON-AIR” filling systems can theoretically also be heated with air. On the one hand, this is technically improbable as the person skilled in the art is aware that air has significantly lower thermal conductivity than water. On the other hand, the defendant itself admitted that it was not aware of any cases from practice where the infringing floor systems are actually heated with air.

2. The Higher Regional Court further arrives at the conclusion that the Regional Court correctly found that the claim for recall could also be asserted against persons located abroad. This is not precluded if the obligor is neither in the possession of, or has ownership in infringing products in Germany.

3. Contrary to the Regional Court, however, the Higher Regional Court assumed that the asserted “complete” recall was to be limited due to proportionality considerations.

First of all, the Higher Regional Court found that the recall was basically only disproportionate in extreme exceptional cases. For this, legitimate interests of the infringer would clearly have to prevail, for which there were no indications in the present case. However, in the present case, “complete” recall (i.e. returning the patent-infringing objects against reimbursement of the purchase price) could not be taken into consideration as it was disproportionate because taking back the patent-infringing “NON-AIR” filling systems in return for patent-free replacement deliveries would constitute less severe means that would eliminate the fault just as certainly and finally. In any case, this applied if, as in the present case, it was excluded that the patent-infringing state could be restored by subsequent manipulation and the object could then be put into circulation again.

Comments

The Higher Regional Court first of all consistently and with convincing reasoning confirms its previous case law regarding the “*everyday ingredient*” for delimiting direct patent infringement from contributory patent infringement. In the individual case, however, it may be difficult to reliably assess whether an “*everyday ingredient*” is present; therefore, at least asserting contributory patent infringement in the alternative is advisable in these cases.

Moreover, the Higher Regional Court also consistently continues its previous case law regarding recall from an obligor abroad with reference to the “*Abdichtsystem*” decision of the German Federal Court of Justice (GRUR 2017, 785). In said decision, the German Federal Court of Justice particularly explained with convincing reasoning that in the case of a claim for recall in Germany – as opposed to a claim for destruction –, the power of disposition was not provided by law, and a claim for recall was not a right that is preliminary to a claim for destruction and identical in nature. Rather, according to the German Federal Court of Justice, both claims pursued different goals, which may but did not have to supplement each other.

The most interesting aspect of the decision relates to the question of proportionality of the claim for recall. In this regard, the Senate – for the first time, as far as we can see – confirms the disproportionality of “*complete*” recall in cases where the infringer already has a patent-free alternative technology available, and subsequent manipulation with regard to an alteration into the patent-infringing state can be excluded.

It should be noted that this case law presents the risk that the unlawful state caused by the distribution of the patent-infringing products is perpetuated. This is because due to the possibility of a “*replacement delivery*”, the risk for the infringer to lose customers again which it particularly acquired by originally patent-infringing products is to be considered significantly lower than if it was obliged to reimburse them with the purchase price, with the consequence that the customers then have the possibility to look for competing products. In legal respects, it will often be problematic whether subsequent manipulation of the patent-free state into the patent-infringing state is excluded.