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Two in one: FCJ eases the claiming of damages in cases of indirect patent infringement and patent assignment

Thorsten Bausch (Hoffmann Eitle) · Friday, July 12th, 2013

In its recent decision “Fräsverfahren” [[Milling Method](#)] of 7 May 2013 (Docket X ZR 69/11), the FCJ eased the conditions regarding a claiming of damages with regard to indirect patent infringement and the rights of the assignee of the patent right.

(1) The FCJ decided that if a plaintiff can prove there was an “offering” of means for the patented purposes, it can be assumed that the means were also delivered for those purposes, and that therefore the plaintiff has a right to claim damages and the provision of information due to indirect infringement. The means of proof will be sufficient even if, in cases of indirect infringement, it was only with the delivery for the patented purposes that the damages were incurred.

(2) Furthermore, when a patent is assigned during pending patent infringement proceedings, the right of the assignee to claim damages shall arise starting on the date of the assignment agreement, and not on the date of registration (contrary to the case law of the Higher Regional Court Dusseldorf). With regard to claims to damages for the time period after assignment, the plaintiff (assignor) will need to assert that payment must be made to the assignee.

The plaintiff in this case was the original owner of EP 1034865 that protects a milling method to be applied in the manufacture of turbine blades. The defendant is a software company specialized in Computer Aided Manufacturing (CAM), also using milling methods. The plaintiff had asked the defendant to develop software for its milling method. The defendant presented its results to plaintiff between February 1999 and November 2002. The plaintiff filed an application for the method in March 1999 and the subsequent EP was granted in 2001.

In December 2002, the defendant offered software at a trade fair and on the Internet which can be used for the patented method, i.e. it explicitly marketed the software for the patented use. The defendant did, however, send a warning letter to plaintiff in 2003 and also later filed a patent infringement suit at the Regional Court Munich (first instance to this FCJ decision) (more details on this case will be published in Kluwer Patent Cases).

The first-instance court fully sustained the cease and desist claims and the claim to damages on the grounds of indirect infringement. The second-instance court, however, rejected the claim to damages and provision of information on the grounds that the plaintiff had failed to provide evidence of deliveries to customers.

After the appeal proceedings had been terminated, the patentee assigned the patent to a third party. According to the German Code of Civil Procedure, the assignment of the patent had no impact on the parties to the proceedings (Sec. 265 (2) 1 CCP).

The FCJ upheld the cease-and-desist claim and also sustained the claim to damages. It referred the case back to the appeal court for modifications with regard to the claim to injunction. The FCJ decided that when there is a case of indirect infringement, the offering of a means is sufficient for the assumption that there is a certain likelihood that the defendant had also delivered the indirect-patent-infringing means. Consequently, the plaintiff also has a right to the information it needs to enforce its claim to damages. The FCJ thus enables plaintiff to carry out further investigations with regard to possible deliveries which were denied by the defendant.

With regard to the assignment of the patent, the FCJ decided that an assignment has no impact on pending patent proceedings. However, it did decide that the plaintiff will have to amend its claim to damages as regards the time period after which the assignment agreement came into force, i.e. to be paid to the new owner. The date of registration is of no relevance.

The FCJ explicitly rejected an earlier decision of the Higher Regional Court Dusseldorf which held that under consideration of the provisions regarding the entry into the patent register (Sec 30 (3) 2 Patent Act) a legal successor has a right to obtain damages only as of the date of registration. If this is not taken as the decisive date, it will be difficult to clarify the evidence.

Contrary to this, the FCJ stressed that the register only has a declaratory effect, and not an effect on substantive rights. The legal successor must have the right to claim damages as of the date of the assignment contract so as to avoid any loss of its rights to damages. It is of no relevance whether it will be difficult to investigate the evidence concerning the assignment of the patent right.

The FCJ decision on the establishment of the right to damages in cases of patent assignment will be of practical relevance also in direct-patent-infringement cases. The legal successor may claim damages not only as of the date of registration, but even earlier, i.e. as of the date when the assignment contract became effective. The assignee will therefore have no loss as to the amount of damages due to delayed registration proceedings.

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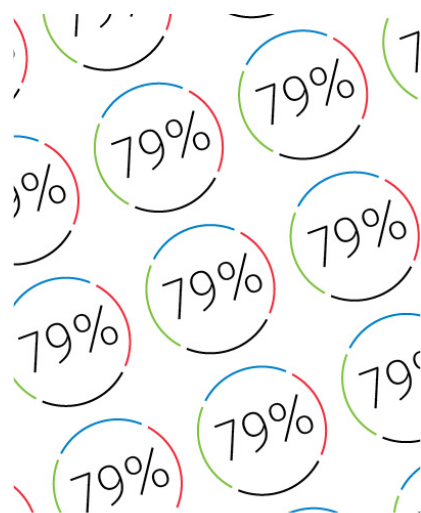
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