

The Provision and Case Law of Contributory Patent Infringement in Germany

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Direct and Accessory Patent Infringement

- Direct patent infringement (regulated by Art. 9 German Patent Act (PatG))
 - ◆ requires infringing act taking place in Germany (DE) (like offering, even if for supply outside DE)
- Accessory patent infringement (Art. 9 PatG)
 - ◆ aiding and abetting in direct patent infringement, requires infringing act taking place in DE

Contributory/Indirect Patent Infringement

- Contributory/indirect patent infringement regulated by Art. 10 PatG
 - ◆ does not require any infringing act taking place in Germany
 - ◆ offering/supply in Germany of means relating to an essential element of patented invention prohibited if offerer/deliverer knows, or it is obvious, that means are intended by customer to be used for patent infringement in DE

Two-fold Domestic Element Condition for Indirect/Contributory Patent Infringement

- Means relating to an essential element condition for indirect/contributory patent infringement
- Offered/delivered means must be offered or supplied in DE
 - ◆ sufficient: offer from DE into patent-free other country
- Offered/delivered means must be intended (or obvious) to be used in DE for patent infringement there
 - ◆ sufficient: intended (or obvious) to be offered inside/from Germany

Two-fold Knowledge of Third Party (or Obviousness) as Condition for Contributory/Indirect Patent Infringement

- Third Party must know (or it must be obvious) that the means are suitable and intended to be used for realizing the invention
- Third Party must know (or it must be obvious) that customer/recipient of the means intends to use the invention in DE
- Important decision: BGH GRUR 2007, 313 (= IIC 2007, 607) – Radio Clock II –

Essential Element Theory of German Federal Court of Justice (BGH)

- Means essential element if feature of a patent claim
- Means essential element if functionally cooperating with a feature of a patent claim
- Means mentioned in a claim or functionally cooperating with a claim feature only non-essential if of absolutely minor significance for the implementation of the invention

Repair vs. Reconstruction - I

- Acquirer of patented Product is entitled in repair, including replacement of worn-out parts etc.
- Acquirer is not entitled in reproduction of Product
- Repair must leave identity of concrete Product acquired unchanged, otherwise reproduction is assumed
 - ◆ e.g. out of several „broken“ products a new intact product is made

Repair vs. Reconstruction - II

- Additional considerations for decision whether possibly prohibited replacement really constitutes patent infringement:
 - ◆ Is replacement part particularly responsible for the technical-functional effect of the invention?
 - ◆ Is replacement part expected by acquirer/purchaser to be replaced regularly/frequently?
- Balancing between the above conditions must always be done by court, depending on a factual analysis of the individual case
 - ◆ BGH GRUR 2004, 758 – Impeller Flow Meter
 - ◆ BGH GRUR 2007, 679 – Hood-Stretching Automat
 - ◆ BGH GRUR 2007, 769 – Pipette System