



# Newsletter 5/2018 Edition

Düsseldorf/Essen/Frankfurt/Munich, 16 November 2018

## Federal Court of Justice (I ZR 226/14): On the Duty of Care When Invoking the Repair Clause in Design Law

One of the most controversial regulations in European design law is the so-called “repair clause” or “spare parts clause,” Art. 110 CDR, pursuant to which no protection on the basis of a Community design shall exist for a spare part, or more specifically, for a design “*which constitutes a component part of a complex product used [...] for the purpose of the repair of that complex product so as to restore its original appearance*”<sup>1</sup>.

An infringement dispute between Porsche and Acacia Srl, a producer of replacement parts, centered on precisely this repair clause. The latter had sold wheel rims for which Porsche had Community design protection, and then invoked the repair clause when Porsche sued for Community design infringement. Among Porsche’s arguments was that the repair clause did not apply here because there is wide latitude for choice in design for wheel rims: The consumer could also choose rims of different design to be able to drive his car again when the rim is damaged. Porsche argued further that an automobile rim is not a true replacement part since it is not inseparably connected to the car.

The latter argument, in particular, persuaded the Stuttgart Higher Regional Court,<sup>2</sup> which ruled in favor of Porsche but allowed appeal to the German Federal Court of Justice; the appeal was indeed filed.

The Federal Court of Justice then referred the case to the CJEU<sup>3</sup>. The CJEU, however, did not affirm such a restriction of the repair clause, although it did see a duty of care on the part of the supplier when the repair clause is invoked; the supplier must then ensure that the items it sells are only used for repair or as replacement parts.

### And in our own affairs...

On 15 October 2018, patent attorney Dipl.-Ing. Wasilis Koukounis, M.Sc., LL.M. joined our practice. He is a mechanical engineer and will be based in our Düsseldorf location. We are pleased to have him on the team.

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Our practice is once again named in the latest JUVE Handbook as one of the leading firms in the field of patent law. Dr. Stefan Michalski, Dr. Aloys Hüttermann, Dr. Dirk Schulz, Guido Quiram, and Dr. Uwe Albersmeyer are mentioned by name as highly recommended lawyers.

### Proposals and Questions

If you have any proposals or questions, please don’t hesitate to contact us [here](#).

<sup>1</sup> Art. 110 of the Community Design Regulation (CDR) EC 6/2002

<sup>2</sup> Stuttgart Higher Regional Court [OLG], Ruling of 11 Sept. 2014 – 2 U 46/14, GRUR 2015, 380

<sup>3</sup> C-397/16 and C-435/16, see [here](#)

Accordingly, the Federal Court of Justice now ruled<sup>4</sup> that a defense based on the repair or spare parts clause is indeed possible for wheel rims. Nonetheless, the supplier is subject to extensive duties of care:

Thus, there is the duty of informing the subsequent user by means of a clear, easily visible notice (in all applicable languages) on the product, on its packaging, in the catalogs or in the sales documents, of the fact that *“a design of which he is not the holder is incorporated in the applicable wheel rim, and this wheel rim is intended solely for repair.”*<sup>5</sup>

Furthermore, the supplier must ensure, with all applicable means, in particular those of contractual nature, that purchased wheel rims are used only for repairs. If the supplier knows or must reasonably assume that purchased tires are not used exclusively for repairs, then it is even necessary to refrain from making a sale.<sup>6</sup>

Since not all of these duties of care were fulfilled in the present case, the appeal was denied.

This suit is of paramount importance for the field of spare parts. After the repair clause as such was interpreted relatively broadly by the CJEU, the Federal Court of Justice has now clarified that suppliers cannot “play the spare parts card” without further ado. Only if they fulfill the really quite substantial duties of care does Art. 110 CDR come into play.

It is probable, therefore, that future suits before the German courts will no longer hinge on Art. 110 CDR as such, since the CJEU has set the bar very low here, but instead the requirements for the duty of care will likely come to the fore. The particular requirement that original manufacturers are likely to make full use of is the one specifying that a sale should not be made if the supplier must assume that the parts in question are not being used exclusively for repairs.

It remains to be seen whether infringement courts in other countries will also establish requirements for the duty of care as stringent as the Federal Court of Justice. If this judgment prevails throughout Europe, it will naturally become ever less attractive for such suppliers to offer protected components despite the repair clause.

## Federal Court of Justice Confirms (X ZR 92/16): Infringement and Nullity Courts May Arrive at Different Interpretations

German law is distinguished by the separation of infringement and nullity proceedings.<sup>7</sup>

Proponents like to point out that nullity suits are filed in only about 50% of all infringement cases, which is to say primarily only when

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<sup>4</sup> BGH judgment of 26 July 2018 – I ZR 226/14, see [here](#)

<sup>5</sup> Summarized headnote 3 of the decision, quote from ruling

<sup>6</sup> Summarized headnotes 4 and 5 of the decision

<sup>7</sup> For details, see *Meier-Beck*, GRUR 2015, 929

the attack on validity is in fact promising.<sup>8</sup> In systems where nullity and infringement are dealt with together, a nullity defense is the general rule, and thus the courts are unduly occupied with questions that would never have arisen in the first place when nullity and infringement are separated.

Critics of the separation principle, on the other hand, like to point out that simultaneous assessment of infringement and validity of the patent avoids inconsistencies and, in particular, prevents the patent holder from interpreting his claim now broadly (in the infringement proceedings) and now narrowly (in the nullity proceedings).<sup>9</sup>

In practice, the defendant in an infringement case, in particular, will of course attempt to achieve a unified interpretation of a particular feature in the contested patent by all relevant courts. One way of achieving this is for the applicable opinions of the patent holder or the relevant courts to be submitted and discussed in the parallel suit.

Nonetheless the infringement defendant has no legal claim to a unified interpretation, as the Federal Court of Justice recently determined.<sup>10</sup> On the contrary, the Federal Court of Justice points out that the determination of the essential meaning of a patent claim is a legal finding that each court concerned must undertake on its own responsibility. Consequently, it is possible for the infringement court and the interpreting court to arrive at different results.<sup>11</sup>

By their nature, such situations can be unsatisfying, especially for defendants in patent infringement cases, since these cases may lead to the result that a feature is in fact interpreted now broadly (in the infringement proceedings) and now narrowly (in the nullity proceedings), and the defendants therefore fall between two chairs. It is thus all the more important to obtain a stay of the infringement proceeding in the case of a suit.

Alternatively, the goal in the infringement appeal case should be at least obtaining leave to appeal. In this case, it is then possible to achieve a procedural situation in which one court, in this case the Federal Court of Justice, decides on infringement and nullity (even if not in one proceeding).

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<sup>8</sup> See discussion of this with further references *Hüttermann*, Einheitspatent und Einheitliches Patentgericht, Rdn 1032ff.

<sup>9</sup> *Franzosi* called this the “angora cat” line of reasoning, an analogy that has become popular with English judges, in particular, see for example Lord Justice *Jacob* (in *European Central Bank v DSS* [2008] EWCA Civ 192)

<sup>10</sup> BGH judgment X ZR 92/16 of 18 August 2018

<sup>11</sup> Margin no. 22 of the decision