



# Newsletter Edition 2/2021

---

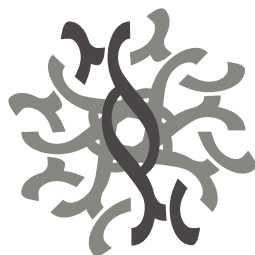
Düsseldorf/Essen/Frankfurt/Munich, 22<sup>nd</sup> January 2021

Federal Court of Justice on §145 Patent Act and functional features – “Flügelfenster”

---

Munich Regional Court refers  
„Harnkatheterset“ practice to ECJ

---



M I C H A L S K I • H Ü T T E R M A N N  
P A T E N T A N W Ä L T E

# Federal Court of Justice on §145 Patent Act and functional features – “Flügelfenster”

In the recently published „Flügelfenster“<sup>1</sup> [decision](#), the Federal Court of Justice (BGH) dealt with a large number of issues relevant to both procedural and material law.

The underlying case constellation is very complex and cannot be presented in all details. The basis of the dispute was a patent on a casement for a window or a door in which profile frames are used.

The defendant was not sued for direct patent infringement, but only for indirect patent infringement, since it does not sell window sashes, but profile frames from which the window sashes are then manufactured. In a first judgment, the defendant was ordered to offer and sell these profile frames for the manufacture of window sashes only if a corresponding clear indication was made that a certain assembly was only possible with the consent of the patent holder.

After the defendant had changed its processing guideline, a renewed action for indirect patent infringement was directed precisely against this new processing guideline.

The Munich Higher Regional Court, as the court of appeal, had then dismissed the action, but allowed the appeal, in particular so that the Federal Court of Justice would have the opportunity to determine whether Section 145 of the Patent Act was applicable in the present case.

This §145 Patent Act has the following wording:

*„A person who has brought an action under section 139<sup>2</sup> may bring another action against the defendant for the same or a like action based on another patent only if, through no fault of his own, he was unable to assert that patent in the earlier action as well.“*

Here, the Federal Court of Justice clarified:

- Section 145 Patent Act refers to the so-called concentration of actions, namely that if an act possibly infringes several patents of an owner, the latter must assert all these patents in one proceeding and thus cannot resort to a kind of „salami tactics“:

*„The ‚concentration maxim‘ provided in this provision is intended to cause a patentee to proceed against the same or similar alleged infringing acts with all patents it believes have been infringed [...] thus not withholding them at will.“<sup>3</sup>*

- This is not the case in the present case, since it was always only about one patent, but about different alleged acts of infringement. Thus, §145 is not



---

<sup>1</sup> BGH, decision of November 3, 2020 -X ZR 85/19 - Flügelfenster

<sup>2</sup> Note: Action for infringement of a patent

<sup>3</sup> Para 36

applicable at all.

*„The infringement action is based on the same patent that was the basis of the parties' previous infringement dispute, and thus not - as the wording of the provision would have it - on a different patent“*

- However, this does not mean that the previous proceedings cannot have any effect at all on the present legal dispute. However, other legal provisions come into play here, above all §261 and §322 of the ZPO:

*„On the other hand, the application of Sec. 261 (3) No. 1 ZPO may be considered if a patent proprietor, after having already filed an action for infringement of a patent by the manufacture or distribution of a certain damaged embodiment and this action is still pending, files a further action against the same defendant for infringement of the same patent by the manufacture or distribution of a - - modified damaged embodiment, compared to the first. If a decision has already been made in the first infringement proceedings in this respect by a final judgment, the res judicata effect of the judgment pursuant to Section 322 (1) of the German Code of Civil Procedure may also prevent the admissibility of the second infringement action based on the same patent as a negative procedural requirement.“<sup>4</sup>*

- Thus, a second infringement action is only admissible if the subject matter of the infringement is new, and this must then be examined accordingly.

The Federal Court of Justice considered a new subject matter of infringement in the present case and thus had no admissibility concerns.

In the present case, however, there is a further complication. The defendant had attempted to „drag“ the new processing guidelines into the first infringement dispute by filing a counterclaim claiming a declaration that it could operate unhindered with regard to the new processing guidelines. In response, the plaintiff had testified that it was only attacking a specific embodiment with this action, and the counterclaim was then rejected as inadmissible.

In the new proceedings, the defendant had now argued in the appeal that this statement - analogous to the „Weichvorrichtung II“ decision<sup>5</sup> - would have the consequence that the second action was inadmissible under §242. However, the Federal Court of Justice did not see any problem here:

*„In the case at issue, the defendant was not entitled to draw the conclusion from the plaintiff's statement in the pretrial proceedings that it [would assert only certain claims] that the plaintiff would permanently refrain from asserting such claims or would permanently waive such claims.“<sup>6</sup>*

After the admissibility of the infringement action had been affirmed in the result, the Federal Court of Justice - in agreement with the Munich Higher Regional Court - now ruled on non-infringement. In the feature of the patent claim there was a feature that an insulating glazing as well as an adhesive layer applied in a



---

<sup>4</sup> Para 37

<sup>5</sup> BGH, decision of June 5, 1997 - X ZR 73/95, NJW 1997, 3377, 3379 f. - Weichvorrichtung II

<sup>6</sup> Para 45

certain way and a limiting web for this adhesive layer also provided in a certain way.

The Federal Court of Justice now clarified that in particular the feature „limiting bar“ is to be understood functionally. In principle, this only presupposes suitability:

*„It is true that, according to the case law of the Senate, indications of function and purpose regularly define the subject-matter protected by the patent merely to the effect that it must be suitable for use for the function and purpose mentioned in the patent claim [...].“<sup>7</sup>*

However, it is precisely these suitability requirements that can have an impact on the scope of protection:

*„Where the function relates to the manufacturing process of a protected product, however, it may be necessary that the function also be realized in the finished product.“<sup>8</sup>*

For the present case, the Federal Court of Justice states:

*„According to feature 6 [of the feature analysis of the patent in suit], the adhesive layer may only be applied to the peripheral surface facing the end surfaces of the insulating glazing. This precludes the adhesive layer from extending to surfaces facing the side surfaces of the insulating glazing. The means by which this is to be precluded in the manufacture of the adhesive layer is not left to the discretion of the person skilled in the art, but is prescribed for him by features 10 and 8. According to these, a limiting web running in the circumferential direction and arranged in the region of a cover plate facing the folding surface must be provided as a barrier for the adhesive which has not yet cured. Accordingly, the function of the limiting web to limit the flow of the adhesive when an adhesive bond is made between the end face of the insulating glazing and the circumferential face opposite thereto must also be realized in the finished sash composed of frame and insulating glazing by the fact that the adhesive layer formed with the solidification of the adhesive thus limited in its flow reaches up to the limiting web.“<sup>9</sup>*

However, the latter was not the case in window sashes manufactured in accordance with the defendant's new processing guidelines:

*„The Court of Appeal correctly assumed that the action is directed against profile frames for which it was obvious to the defendant in view of its new processing guidelines of September 2010 that they are suitable and intended for fixing the window panes in such a way that the bonding does not touch the centering lip. Such use does not realize feature 10 of patent claim 1 for the reasons explained above.“<sup>10</sup>*



---

<sup>7</sup> Para 49

<sup>8</sup> Para 49

<sup>9</sup> Para 50

<sup>10</sup> Para 57

This decision has both procedural and substantive legal significance. It gains procedural significance from the statements as to the extent to which a renewed action arising from the same patent against the same defendant is admissible and to what extent the first action can be prejudicial here.

The substantive legal significance, which is perhaps to be classified even higher, results from the stronger weighting of functional features, for which, under certain conditions, not only a fundamental suitability but also an actualization must be given in order for a patent infringement to exist.

## Munich Regional Court refers „Harnkatheterset“ practice to ECJ

In a sensational decision, the Munich Regional Court ruled on January 19<sup>11</sup> to refer the „Harnkatheterset“ practice of the German courts of instance to the ECJ for consideration of whether this is compatible with the Enforcement Directive 2004/48/EC.

Background:

For some time now, it has been the common practice of the important German courts of instance that an application for a preliminary injunction arising from a patent can (essentially) only be successful if that patent has previously gone through opposition or nullity proceedings. Otherwise, the patent is almost always classified as insufficiently legally valid and no preliminary injunction is granted.

This practice was first established by the Düsseldorf Higher Regional Court, among others in the „Harnkatheterset“ decision<sup>12</sup>, followed later by the two other important higher regional courts in Karlsruhe<sup>13</sup> and most recently Munich<sup>14</sup>.

Even in the rules of the Unified Patent Court a corresponding reference was included that the Unified Patent Court<sup>15</sup> should take into account whether the patent in suit had previously been subject to litigation.

Exceptions were usually granted only rarely, such as when there were many licensees or when there had been a number of third party submissions in the granting process, so that the granting process could be considered „opposition-like.“<sup>16</sup>

Due to the Enforcement Directive 2004/48/EC, the practice of granting prelimi-



<sup>11</sup> s. here: <https://www.justiz.bayern.de/gerichte-und-behoerden/landgericht/muenchen-1/presse/2021/1.php>

<sup>12</sup> OLG Düsseldorf, InstGE 12, 114 - Harnkatheterset, see also Böhrer, GRUR 2011, 965 as well as OLG Düsseldorf, decision of 30.9.2010 - I-2 U 47/10 - Gleitsattelscheibenbremse II

<sup>13</sup> OLG Karlsruhe, GRUR-RR 2015, 509 - Ausrüstungssatz

<sup>14</sup> OLG Munich, judgment of December 12, 2019 - Case No. 2 U 4009/19 - Leiterklemme

<sup>15</sup> Rule 209.2

<sup>16</sup> Examples where the Düsseldorf courts have been more generous include LG Düsseldorf, decision of May 8, 2014, 4a O 65/13 (not published), in which an Italian private expert opinion was recognized, and the proceedings from utility model 20 2007 019 528 U1, see <https://www.juve-verlag.at/nachrichten/verfahren/2015/06/gebrauchsmuster-ampersand-setzt-fuer-hettich-einstweiliges-verfuegung-durch>



nary injunction proceedings in industrial property rights is subject to European law, for example, as recently as 2019, the decision C-688/17 was issued on the issue of awarding damages in the case of unjustifiably granted preliminary injunctions.<sup>17</sup>

In the present case<sup>18</sup>, a patent proprietor had filed an application with the Munich District Court for an interim injunction based on a European patent which had been challenged with an opposition, but at the time the application was filed, no decision had yet been issued by the European Patent Office.

The court considered the patent to be infringed, but did not feel able to grant a preliminary injunction. This was for the reason that the Munich Higher Regional Court had previously switched to the „Harnkatheterset“ practice and it could therefore have been expected that the preliminary injunction would be lifted again in the second instance at the latest.

At the same time, however, the district court had concerns about whether this practice was consistent with the Enforcement Directive:

*„According to Art. 9(1) of the Enforcement Directive, it should be ensured that a provisional measure can be ordered against a patent infringer in order to prohibit the continuation of a patent infringement. However, this is not possible according to the case law put up for review by this order for reference, because a patent - as in the present case - which has only just been granted may not even have gone through validity proceedings (opposition or nullity proceedings are only possible after the patent has been granted).*

*Also, many patents granted a long time ago have often not yet gone through such a legal status procedure at the time of the application for a provisional measure; the patent proprietor naturally has no influence at all on whether his patent is attacked with an opposition or an action for revocation after it has been granted. A provisional measure can then, despite an acute infringement case, in principle only be issued once a legal status proceeding has been concluded in the first instance, which can take many months or even years. The continuation of the patent infringement must be accepted during this time according to the case law put up for review, although in the case of a patent - unlike other intellectual property rights - a thorough technical examination already takes place before it can be granted.*

*The referring court therefore finds itself compelled at present, contrary to its understanding of the provision in Art. 9(1) of Directive 2004/48/EC, to refuse in principle to order provisional measures in the case of patent infringement if the infringed patent has not yet been subject to adversarial continuance proceedings and the exceptions to this principle set out in the case law do not apply either.”<sup>19</sup>*

Thus, the Regional Court decided to refer the following question to the ECJ in a preliminary ruling:



---

<sup>17</sup> s. our [newsletter 8/2019](#)

<sup>18</sup> Munich Regional Court, Case No. 21 O 16782/20

<sup>19</sup> Quote from the press release: <https://www.justiz.bayern.de/gerichte-und-behoerden/land-gericht/muenchen-1/presse/2021/1.php>

*„Is it compatible with Article 9(1) of Directive 2004/48/EC for higher regional courts having jurisdiction at last instance in proceedings for interim relief to refuse in principle to grant interim measures for infringement of patents if the patent in dispute has not survived opposition or revocation proceedings at first instance?“*

The outcome of these proceedings is eagerly awaited and could either confirm or end the established practice of the most important instance courts as well as the Unified Patent Court in advance. In the event of confirmation, it can be assumed that preliminary injunctions based on IP rights that have not been challenged beforehand will be granted even less frequently than they already are.

## In Our Own Affairs

We wish your relatives, employees, colleagues and of course yourself all the best for the current, still difficult time.

### Impressum:

Michalski · Hüttermann &  
Partner Patentanwälte mbB

Speditionstrasse 21  
**D-40221 Düsseldorf**  
Tel +49 211 159 249 0  
Fax +49 211 159 249 20

Hufelandstr. 2  
**D-45147 Essen**  
Tel +49 201 271 00 703  
Fax +49 201 271 00 726

Perchtinger Straße 6  
**D-81379 Munich**  
Tel +49 89 7007 4234  
Fax +49 89 7007 4262

De-Saint-Exupéry-Str. 10  
**D-60549 Frankfurt a.M.**  
Tel +49 211 159 249 0  
Fax +49 211 159 249 20

The content of this newsletter only reflects general information and does not constitute legal advice as per the German Legal Advice Act.

Despite thoroughly checking the content, Michalski · Hüttermann & Partner Patent Attorneys mbB does not assume any responsibility for the validity, accuracy, integrity or quality of the information above.

Photo:  
Zolnierrek/Shutterstock.com