



HOFFMANN EITLE

# **Infringement of Process Patents based upon Cross-Border Acts under German Law**

- Report for Japan External Trade Organization -

September 24, 2021

# CONTENTS

Issues .....	3
Report.....	4
1. Court Cases .....	4
1.1 <i>Pipe Welding Process</i> (2007) – Indirect Infringement Affirmed .....	4
1.2 <i>Prepaid Telephone Card</i> (2009) – Infringement Affirmed .....	6
1.3 <i>Prenatal Diagnostics</i> (2017) – Infringement Denied.....	8
1.4 <i>Music Streaming</i> (2018) - Infringement Denied .....	10
1.5 <i>Online Eye Test</i> (2020) – Infringement Affirmed .....	11
2. Legal Basis.....	12
3. Purpose .....	14
3.1 Legislation of GPA Provisions .....	14
3.2 Case Law affirming Attribution .....	17
4. Requirements .....	18
4.1 Standards applied by the HRC Düsseldorf .....	18
4.2 (Non-)Relevance of the Last Process Step .....	18
Contacts.....	22

## Issues

(背景)

複数の事業者や製品等を連結させ、ネットワーク化する特許発明の重要性が増している中、時に国境を越えた複数の事業者が関与するネットワークシステム全体をカバーする特許発明について、「誰が実施者か？」を特定したり、「侵害行為を適切に認定できるか？」という点が課題と考えている。

With the increasing importance of patented inventions that link and network multiple businesses, products etc., and the occurrence of patented inventions that cover an entire network system and eventually involve multiple operators across national borders, it is important to identify as to "who is the implementer?" or as to whether "it is possible to properly establish an infringing act?".

(質問内容)

1. ドイツの判決によれば、方法の発明のうち、一部のステップがドイツ国外であったとしても、ドイツ国内にいて全体のステップを知っている者に導かれたものである場合には侵害として捉えられる旨、認められ得ると考える（デュッセルドルフ高裁、プリペイドテレフォンプカード判決）。その認識で正しいか。これと関連する他の判決はあるか。

According to our understanding of German court cases, even if some steps of a method invention are realized outside of Germany, an infringement can be found to the extent those steps are triggered by a person who is in Germany and aware of all steps (Düsseldorf High Court, Prepaid Telephone Cards Judgment). Is that understanding correct? Are there any other judgments related to this issue?

2. (以下、1. が正しい場合) 根拠となるドイツ特許法9条2号と10条1項のうち、どのような解釈によりその結論が導かれているか(学説(通説)、判例)。

To the extent our understanding of item no. 1 is correct, what kind of interpretations of the relevant legal provision, i.e. Art. 9 No. 2 and Article 10 Par. 1 of the German Patent Act lead to that conclusion (academic (prevalent) theories, precedents).

3. これらの条文の立法趣旨はどのようなものであるか。(立法趣旨について、根拠となる文書も記載)

What is the legislative intent of these provision? (If there is a document that supports the legislative intent, please provide it as well.)

4. 侵害として捉えられる場合の要件が判決等により明確になっていれば、その要件を記載。

If the requirements for what is considered infringement have been clarified by a court decision, etc., please let us know what those requirements are.

# Report

## 1. Court Cases

According to our understanding of German court cases, even if some steps of a method invention are realized outside of Germany, an infringement can be found to the extent those steps are triggered by a person who is in Germany and aware of all steps (Düsseldorf High Court, Prepaid Telephone Cards Judgment). Is that understanding correct? Are there any other judgments related to this issue?

As for cases where the patented process is partly realized domestically in Germany, the German courts have occasionally found a process patent to be infringed where persons have realized (only) a part of the process steps to the extent the other steps of the process could be attributed to him. In addition to *Prepaid Telephone Card* (Higher Regional Court (“HRC”) Düsseldorf, 2009), the attribution of acts taken abroad (or taken domestically by third parties) has become an issue in *Pipe Welding Process* (German Federal Court of Justice (“FCJ”), 2007), *Prenatal Diagnostics* (HRC Düsseldorf, 2017), *Music Streaming* (Regional Court (“RC”) Mannheim, 2018), and *Online Eye Test* (RC Düsseldorf, 2020):

### 1.1 *Pipe Welding Process* (2007)<sup>1</sup> – Indirect Infringement Affirmed

While being no cross-border case, the judgement by the FCJ of 2007 in *Pipe welding process* attributed acts of third parties and paved the way for later cross-border cases in which acts taken abroad were attributed. The patent in suit concerned a welding process and comprised several process steps providing, in a 1<sup>st</sup> part of steps, for the production of a data carrier with the proper welding data and, in a 2<sup>nd</sup> part of steps, for the use of that data to control the actual welding process. While these parts of process steps were realized by different business operators, the relevant issue was whether the manufacturer of the welding machines is liable for indirect infringement and thus whether his offering and supply of welding machines were objectively suited for the use of the invention under Sec. 10 Par. 1 of the German Patent Act (“GPA”)<sup>2</sup>.

In essence, the courts in all instances considered that the user of the data carrier would make use of the patented process with all its features when carrying out the welding process by means of the stored welding data.

<sup>1</sup> FCJ, judgement of 27 February 2007, case no. X ZR 113/04 – *Pipe welding process (Rohrschweißverfahren)*

<sup>2</sup> **Sec. 10 Par. 1 GPA:** *The patent shall further have the effect that any third party shall be prohibited, in the absence of the consent of the proprietor of the patent, from supplying or offering to supply, within the territorial scope of this Act, persons other than those entitled to exploit the patented invention with means relating to an essential element of the invention for use within the territorial scope of this Act if the third party knows or if it is obvious from the circumstances that those means are suitable and intended for using that invention.*

In the 2<sup>nd</sup> instance, the HRC Düsseldorf had affirmed the suitability for the use of the invention by focusing on the close connection between the steps of the patented process rather than on the different parties involved<sup>3</sup>:

*The attacked welding devices can only carry out the process steps [2<sup>nd</sup> part] if the steps [1<sup>st</sup> part] for generating the identification cards allocated to the parts to be welded, the data of which the welding device shall read and implement during welding, have been carried out beforehand. Thus, the attacked welding machines are objectively suitable "for use of the invention" within the meaning of Sec. 10 (1) GPA, i.e. the invention as such with all its features, including features [1<sup>st</sup> part], because it is precisely the welding machines that read the cards produced according to steps [1<sup>st</sup> part], the production of which would be pointless, if it were not followed by steps [2<sup>nd</sup> part].*

*With the aid of the welding machines from the second defendant, which carry out the process steps [2<sup>nd</sup> part], and using the welding fittings according to feature 2, as well as the identification cards attached to them and produced according to process steps [1<sup>st</sup> part], they produce welded joints of pipes which, because all the process steps according to the patent are carried out in their production (even though by different parties), are direct products of the protected process within the meaning of Sec. 9 No. 3 GPA.*

*[underlined by author]*

The FCJ confirmed the above findings and additionally based its considerations on the legal construct of joint and secondary responsibility (see 2. below regarding further legal details) stating that<sup>4</sup>:

*The means must be constructed in such a way that the direct use of the protected teaching with all its features by the customers is possible (...)*

*This is not absent if, in a multi-stage process such as is the subject matter of claim 1 of the patent in suit, a part of the process steps according to the patent, on the result of which - in this case embodied on the card - the further process steps are based, is not carried out by the customers of the offering party or supplier. The production of the card with the data necessary for controlling the temperature of the fittings during welding is a necessary condition for controlling the temperature while using the card during the actual welding process. At least in such a case, a direct patent infringement can be committed not only in sole responsibility under realization of all procedural steps, but also in joint and secondary responsibility (see Scharen, in: Benkard, Sec. 10 GPA mn.*

---

<sup>3</sup> HRC Düsseldorf, judgement of 24 June 2004, case no. 2 U 18/03 (par. 107, 110)

<sup>4</sup> See above fn. 1 (par. 18, 19)

*28 with further references on case law on joint and secondary responsibility in case of direct patent infringement; regarding joint responsibility also Keukenschrijver, in: Busse, GPA, 6<sup>th</sup> ed. [2003], Sec. 10 mn. 30 with references).*

*[underlined by author]*

For affirming that the welding machines were suited for the use of the invention under Sec. 10 Par. 1 GPA<sup>5</sup> and thus defendant's liability for indirect infringement, the FCJ considered the steps of the patented process realizable by multiple operators (producer of fittings with cards, piper layers using welding machines with cards) with the acts of other operators being attributed based upon joint and secondary responsibility.

## **1.2 Prepaid Telephone Card (2009)<sup>6</sup> – Infringement Affirmed**

The judgement by the HRC Düsseldorf of 2009 in *Prepaid telephone card*, which you are referring to, attributed acts undertaken outside Germany and is considered a landmark case in the cross-border context. While the patent in suit concerned a process regarding prepaid telephone calls<sup>7</sup>, the use of the patented invention under Sec. 9 S.2 No. 2 GPA<sup>8</sup> was disputed as the server of defendant administering the credits and enabling the telephone connections was located outside of Germany.

The HRC Düsseldorf yet attributed the processes for enabling the prepaid calls on the server abroad to the defendant and justified this attribution by referring to major patent literature and the FCJ judgement in the previous *Pipe welding process* as follows<sup>9</sup>:

*According to the correct opinion shared by the Senate, a person who carries out a process patented in A in its entirety can infringe the patent even if he carries out the measures required for this only partly in the domestic country (Kraßer, *ibid.*, p. 767; Benkard/Scharen, *ibid.*, Sec. 9 GPA mn. 49; Busse/Keukenschrijver, *ibid.*, Sec. 9 GPA mn. 139). For example, it should be sufficient to start the domestic use provided that the completion of the use abroad is also attributable to the person acting in the domestic country (Kraßer, *ibid.*, p. 767;*

---

<sup>5</sup> See above fn. 2

<sup>6</sup> HRC Düsseldorf, judgment of 10 December 2009, case no. 2 U 51/08, InstGE 11, 203 – *Prepaid telephone card (Prepaid Telefonkarte)*

<sup>7</sup> In essence, the patented process comprised the steps of (1) programming a telephone switchboard, (2) enabling and (3) cutting off a telephone connection, (4) erasing used ID numbers, (5) marking a series of ID numbers on data carriers, and (6) offering of the said data carriers.

<sup>8</sup> **Sec. 9 S. 2 No. 2 GPA:** *The patent shall have the effect that the proprietor of the patent alone shall be entitled to use the patented invention within the scope of the law in force. In the absence of the consent of the proprietor of the patent, any third party shall be prohibited from (...) 2. using a process which is the subject-matter of the patent or, if the third party knows or if it is obvious from the circumstances that use of the process is prohibited in the absence of the consent of the proprietor of the patent, from offering the process for use within the territorial scope of this Act*

<sup>9</sup> See above fn. 6 (par. 134)

*Busse/Keukenschrijver, ibid., Sec. 9 GPA mn. 139). However, attributability is not only possible if the uses begin in the domestic country and are then completed in the domestic country. Rather, attributability is possible in the opposite case, for example, if a manufacturing process involves the production of a preliminary product by means of the first process steps abroad, this intermediate product is then brought to the domestic market and the remaining process steps for the production of the final product are carried out here. In such a case in particular, the user must regularly accept attribution of the process previously started by him (or a third party) abroad, because he relies on these measures and makes use of them in the domestic country and adopts them as his own. Consequently, the FCJ also assumes – in case of domestic acts of use – that (...) the user of the data carrier makes use of the method with all its features, when he carries out the welding process by means of the stored welding data (FCJ, GRUR 2007, 773 – Pipe welding process). Whether the device required to carry out the further process in such a case is manufactured domestically or abroad cannot make any difference. Otherwise, it would be possible for the user to circumvent patent protection without further ado. His conduct would not constitute an infringement of the respective process patent in either the one state or the other.*

*[underlined by author]*

In consideration of the above, the HRC Düsseldorf established the following basis for deciding on the attribution in cross-border constellations<sup>10</sup>:

*Against this background, taking one of several necessary actions domestically may be sufficient for constituting the act of using (a process) if also the other actions taken abroad are attributable to the person acting domestically (Benkard/Scharen, ibid., § 9 GPA mn. 49). Partial acts taken abroad are to be treated as domestic acts to the extent the infringer adopts them as his own for an infringing effect occurring domestically. In order to exclude too far-reaching liability, however, an economic-normative approach is – even if it may otherwise not be necessary whether a product or a process which is the subject matter of the patent has a territorial connection with the territory of the Federal Republic of Germany or whether an act has its effect here (see Benkard/Scharen, ibid., Sec. 9 GPA, mn. 10 with further references) – required in such cases as a suitable corrective, the necessary connection for the attribution being that the conduct in question is targeted and tailored to an effect in the domestic market. As a result, national patent protection intervenes only in cases that directly affect the national protected area.*

---

<sup>10</sup> See above fn. 6 (par. 135)

*[underlined by author]*

Given in the present case that the prepaid telephone cards with the ID numbers were sold in Germany, enabling customers in Germany to make the prepaid telephone calls, and also considering that the commands generated by the server (ID verification, credit check, enabling telephone connection, its termination after use of credit) which are relevant for achieving the advantageous effect of the invention (enabling prepaid telephone calls) were transmitted and used in Germany, the HRC Düsseldorf attributed these acts undertaken on the server abroad to the defendant. The court in such a way extended liability for direct infringement of a process patent (“use” under Sec. 9 S. 2 No. 2 GPA<sup>11</sup>) to a cross-border constellation.

### **1.3 Prenatal Diagnostics (2017)<sup>12</sup> – Infringement Denied**

In 2017, the HRC Düsseldorf denied infringement of a process patent concerning the examination of a maternal blood sample provided (1<sup>st</sup> step) to diagnose the risk of a genetic abnormality (last step).<sup>13</sup> The blood sample was taken in Germany, whereas the subsequent DNA analysis and risk assessment (diagnosis based on the fetal nucleic acid) were assigned to a partner laboratory in the US.

First, the HRC confirmed the attributability of acts taken abroad, making a slight distinction between the considerations to be made in case of manufacturing processes and those in case of work processes as follows:<sup>14</sup>

*If the process is applied partly in Germany and partly abroad, there is only a domestic infringement of property rights if the process carried out abroad can be attributed to the person who carries out the other process steps in the domestic country (Senate, InstGE 11, 203 - Prepaid telephone card). In this context, manufacturing and working processes are to be considered equally, whereby it makes no difference for the legal assessment whether the person acting abroad is the same as the person acting domestically or a third party, and it is equally irrelevant whether the third party acted on its own responsibility or at the instigation of the domestic person.*

*If the patent protection relates to a manufacturing process, attribution is required if the process steps abroad produce a preliminary or intermediate product which is delivered to Germany and refined there using the remaining process steps to produce the final process product (Senate, InstGE 11, 203 -*

---

<sup>11</sup> See above fn. 8

<sup>12</sup> HRC Düsseldorf, judgment of 23 March 2017, case no. I-2 U 5/17 – Prenatal diagnosis (Pränatale Diagnostik)

<sup>13</sup> In essence, the patented process comprised the steps of (1) providing a maternal blood samples, (2) separating the sample into a cellular and non-cellular fraction, (3) detecting the presence of a nucleic acid in the non-cellular fraction, and (4) providing a diagnosis based upon the nucleic acid.

<sup>14</sup> See above fn. 12 (para. 78-80)



*Prepaid telephone card). In this case, the person acting in the domestic country must accept attribution of the preliminary work of the third party (which is embodied in the preliminary product brought within the jurisdiction of the GPA and on which the final outcome of the invention is based), which is why the situation is no different than if the preliminary product had been produced by the person's own hand in the domestic country. The situation is different in the opposite constellation, where only the first process steps leading to a preliminary product are carried out in the domestic country and the preliminary product is then taken abroad, where a third party - possibly even foreseeably - undertakes the partial acts concluding the process. In contrast to the case discussed at the beginning, the use of the patent in this case takes place to a substantial extent outside of the country, resulting in the success of the invention. Accordingly, at most the domestic process steps can be attributed to the non-domestic person continuing the process (with the consequence that the national patent there is infringed), but not vice versa.*

*Further, the Senate (InstGE 11, 203 - Prepaid telephone card) has recognized an attribution according to the rules described above in the case of a (work) process for the processing of telephone calls paid for in advance (...) The reason for the attribution was the consideration that partial acts of the protected process carried out abroad are relevant, if the infringer adopts them as his own for the purpose of achieving an infringement in Germany. Only if this is affirmed, is it important for the limitation of liability from an economic-normative viewpoint whether the appropriated action abroad is purposefully tailored to an effect in the domestic market. The last-mentioned criterion does not therefore suspend from attribution for the success of the domestic invention, but rather constitutes a further condition for attribution and liability in case partial acts are taken abroad.*

*[underlined by author]*

As a result, however, the HRC considered the diagnosis steps undertaken in the US not attributable to the defendant in Germany although the results of the DNA analysis were subsequently forwarded to Germany with this service being billed and remunerated there. The HRC elaborated on the standards as set out in *Prepaid telephone card* as follows<sup>15</sup>:

*Whether process steps carried out abroad are applied and used to achieve a domestic effect of the invention is assessed on the basis of the allegedly infringed patent claim with its technical features and not on the basis of how the results of the process are commercially exploited. (...) For the evaluation*

---

<sup>15</sup> See above fn. 12 (para. 81)

*under patent law, it is crucial that in view of the given claim the patented process is fully completed (making a diagnosis regarding a gene abnormality) abroad and thus the effects of the invention are fully achieved abroad. Therefore, the district court rightfully drew a parallel to the case of a non-domestically-infringement, in which merely a preliminary product is manufactured in Germany, on which all remaining measures necessary for the completion of the process are executed abroad.*

*[underlined by author]*

While confirming *Prepaid Telephone Card* and requesting for a “use of process steps taken abroad for a domestic success of the infringement” for attributing those acts to the person acting domestically, *Prenatal diagnosis* made a slight distinction between the considerations in case of a manufacturing processes (assessed as to where the preliminary products are delivered) and in case of work processes (assessed based upon the patent claim with its technical features). Here, the patented process in *Prenatal diagnosis* assumed to be a work process, an attribution was denied since the process according to the patent claim was seen completed in the US with the technical effects of the invention having been achieved there. It was regarded irrelevant that the analysis results were thereafter forwarded to Germany with the diagnostic service being billed and remunerated there.

#### **1.4 *Music Streaming (2018)*<sup>16</sup> - Infringement Denied**

In *Music streaming*, the RC Mannheim denied the attribution of acts taken abroad and rejected the infringement claims. The patent in suit concerned a process patent regarding the assembling of information from various information sources for a media user according to a user profile.<sup>17</sup> The defendant provided music streaming services to media users in Germany, while conducting the relevant data processing on a server outside of Germany.

The RC, first, yet confirmed that acts taken abroad can be attributed to the extent the steps realized in Germany have certain relevance, stating without particularly referring to patent literature and case law as follows<sup>18</sup>:

*An attribution of individual acts carried out abroad to the domestic country is at most possible if a preliminary or intermediate product is produced abroad, but the final process steps decisive for the success according to the invention*

---

<sup>16</sup> RC Mannheim, judgment of 9 October 2018, case no. 2 O 163/17 – *Music Streaming (Musikstreaming)*]

<sup>17</sup> In essence, the patented process comprised the steps of 1) establishing a user profile, 2) establishing a virtual unified space, 3) populating the virtual unified space with a plurality of different virtual media collections, 4) browsing the unified space, and 5) recommending media information items of the virtual unified space

<sup>18</sup> See above fn. 16 (par. 36, 49)

*are carried out in the domestic country. The attribution is justified here by the fact that the success according to the invention is ultimately realized in the domestic country.*

*An attribution of acts carried out abroad to the domestic country requires, in particular taking the principle into account that the law of the place of protection applies, according to what has been said above, that the acts carried out in the domestic country are of such importance for the concretely protected (process) claim that the act of protected (process) claim that the infringing act is ultimately to be regarded as having been carried out in the domestic country, because the success according to the invention is realized there.*

The patent in suit comprised the last step of recommending media information<sup>19</sup> and therefore implied the recommendation to be communicated to the user in Germany. Such communication was yet considered of minor relevance and not sufficient to have the other process steps attributed to Germany.

#### **1.5 Online Eye Test (2020)<sup>20</sup> – Infringement Affirmed**

In *Online eye test*, the RC Düsseldorf affirmed infringement of a process patent concerning an online eye test which aimed at saving the bulky and expensive equipment that is typically required for a conventional eye test at an ophthalmologist or optician. The first three steps of the patented process thus concerned an eye test to be conducted on the patient's own computer at home, while two further steps intended to conclude the eye test by calculating a visual defect and a therapeutic corrective lens prescription. The relevant data was processed by the defendant outside of Germany with the aid of servers, but the technical effects of the patented process occurred when the first part of process steps was realized by the patient on the home computer in Germany.

After confirming the findings in *Prepaid telephone card* and *Prenatal diagnosis*, the RC Düsseldorf elaborated on the relevance of the domestic effect (success) of the invention for the attribution as follows<sup>21</sup>:

*The HRC Düsseldorf correctly assumes that in the case of a process that is partly used in the domestic country and partly abroad, the partial acts of the protected process carried out abroad can be attributed if the infringer adopts them as his own for an infringing result occurring in the domestic country (HRC Düsseldorf, InstGE 11, 203 - Prepaid telephone card; Busse/Keukenschrijver, GPA, 8<sup>th</sup> ed. 2016, Sec. 9 mn. 138 with further references also to other views).*

---

<sup>19</sup> See above fn. 17

<sup>20</sup> RC Düsseldorf, judgement of 28 July 2020, case no. 4a O 53/19 – *Online Eye Test (Online Sehtest)*

<sup>21</sup> See above fn. 20 (para. 144, 147)

*According to the case law of the HRC Düsseldorf, whether process steps carried out abroad are used to achieve a domestic inventive success is assessed on the basis of the patent claim with its technical features. For the assessment under patent law, it is decisive that, with the given claim wording, the patented process is fully completed abroad and, as a result, the success of the invention is fully achieved (HRC Düsseldorf, GRUR-RS 2017, 109826 mn. 41 – Prenatal diagnosis). (...)*

*However, attribution may also be possible if the last step of the process is not carried out in the domestic country. The domestic inventive success referred to by the HRC Düsseldorf can be seen not only in the completion of the claimed process in the domestic country, but also in the domestic achievement of the intended advantages of an invention. If the advantages of a patented process occur due to process steps undertaken domestically and if they also have a domestic effect, the domestic success of the invention - and thus an attribution - can be affirmed even if the process is completed only abroad. This particularly applies when the last process step carried out abroad does not make a relevant contribution to the advantages of the invention as compared to the prior art.*

Given that the expenses for bulky and expensive eye test equipment were reduced in Germany by conducting an online test on the patient's own computer at home and realizing the first part of process steps in Germany, the RC considered the attribution of acts undertaken subsequently abroad (diagnosis, therapy calculations) justified. While *Prenatal diagnosis* demanded for an assessment based upon the patent claim with its technical features, *Online eye test* went further and evaluated the features of the patent claim as to how these contribute to the results of the patented invention. As the last steps taken abroad were regarded not differing from the state of the art, the RC Düsseldorf found that these would not hinder attribution and affirmed infringement ("use") of the process patent under Sec. 9 S.2 no. 2 GPA<sup>22</sup>.

In the absence of an appeal, the RC judgement in *Online eye test* has become final. But its reasoning has been criticized by influential judge Kühnen, who is currently presiding judge of the HRC Düsseldorf and may have decided if *Online Eye Test* were appealed (see 4.2.4 below regarding details).

## 2. Legal Basis

What kind of interpretations of the relevant legal provision, i.e. Art. 9 No. 2 and Article 10 Par. 1 of the German Patent Act lead to that conclusion (academic (prevalent) theories, precedents).

---

<sup>22</sup> See above fn 8.

While for an infringement of process patents the principle of territoriality basically requires that all steps are realized within the relevant country, the German courts have occasionally found infringement where the patented process is only partly realized in Germany: The “use” (Sec. 9 S.2 no. 2 GPA<sup>23</sup>) or suitability of a means for the “use of the invention” (Sec. 10 Par. 1 GPA<sup>24</sup>) has been affirmed by German case law to the extent the other steps of the process taken abroad could be attributed to him given that he had made use of these “other” steps and adopted these as his own.

The legal fundamentals for the attribution of acts taken abroad can be found in the attribution of acts taken by third parties:

In *Pipe welding process*, the FCJ found that the steps of the patented process could be realized by multiple operators (producer of fitting with cards, pipe layers using welding machines with cards) with the acts of other operators being attributed. The FCJ based such attribution of third-party acts upon the legal construct of joint and secondary responsibility by citing major patent literature with references to case law.<sup>25</sup> Joint liability requires a joint infringement, i.e. a conscious and intended cooperation in the realization of the claim. Secondary responsibility is regarded as wrongful (at least negligent) contribution to an infringement and has, for instance, been accepted in cases of insufficient precautions against infringements or the delivery of goods (protected by a German patent) abroad in view of the distribution routes and the legal situation in Germany.<sup>26</sup>

By referring to major patent literature as well as to *Pipe Welding Process*, the HRC Düsseldorf in *Prepaid telephone card* extended the scope of attributability and accepted to attribute acts taken abroad to the infringer who has realized (only) a part of the process steps in Germany.<sup>27</sup> The HRC saw no reasons to differentiate whether the remaining steps were taken by a third party domestically or abroad, seeing gaps of protection without such attribution, since it would be possible for the user to circumvent patent protection without further ado, and his conduct would not amount an infringement in either state.

The subsequent case law primarily bases upon *Prepaid telephone card: Prenatal diagnostics* referred to *Prepaid telephone card* and elaborated on its findings, while *Online eye test* built upon both aforementioned judgements as well as on major patent literature.<sup>28</sup>

---

<sup>23</sup> See above fn. 8

<sup>24</sup> See above fn. 2

<sup>25</sup> See above fn. 1 (par. 19)

<sup>26</sup> E.g. FCJ, decision of 26 February 2002; case no. X ZR 36/01 – *Radio clock I (Funkuhr I)*

<sup>27</sup> See above fn. 6 (par. 134)

<sup>28</sup> See above fn. 12 (par. 78-80), fn. 20 (par. 144-145)

### 3. Purpose

What is the legislative intent of these provisions? (If there is a document that supports the legislative intent, please provide it as well.)

#### 3.1 Legislation of GPA Provisions

The GPA provisions regarding the patent proprietor's right to prohibit the direct and indirect use of the patented invention and, in particular, the abovementioned Sec. 9 S. 2 no. 2<sup>29</sup> and Sec. 10 Par. 1 GPA<sup>30</sup> were regulated in its current form by the German Act on the Community Patent and for the Amendment of Patent Law Provisions ("**Community Patent Act**") which came into effect on 1 January 1981.<sup>31</sup>

While already at that time, a new patent system was driven forward on an European level with a patent having unitary effect within the European Community ("**EC**") market ("**Community Patent**"), the EC member states had agreed on a Community patent convention on 15 December 1975 ("**Luxembourg Convention**"). This Convention particularly stipulated the right deriving from a Community Patent in Art. 29 and 30 with its proprietor's right to prohibit the direct and indirect use of a patented invention.<sup>32</sup>

The German Community Patent Act adapted Sec. 6, 6a GPA (current Sec. 9, 10) and regulated these in line with the said provisions of the Luxembourg Convention. The intention of the German lawmakers was to harmonize the GPA provisions regarding national patents in view of the planned Community Patent system, while there are no indications for particular considerations on the issue of infringement (of process patents) by means of cross-border acts:

1. The adaption of the GPA provisions was considered necessary to secure that the rights deriving from a national patent would provide the same level of protection as the rights based upon a Community Patent. This is stated particularly in the draft act of the German Federal Government of 7 September 1978 for the Community Patent Act:<sup>33</sup>

---

<sup>29</sup> See above fn. 8

<sup>30</sup> See above fn. 2

<sup>31</sup> Act on the Community Patent and for the Amendment of Patent Law Provisions (*Gesetz über das Gemeinschaftspatent und zur Änderung patentrechtlicher Vorschriften*) of 26 July 1979, Federal Law Gazette 1979, part I pp. 1269, 1271

<sup>32</sup> While the Luxembourg Convention did not come into force as it was not ratified by all EC members states, the infringement provisions are now embedded with the same contents in Art. 25, 26 of the Agreement on a Unified Patent Court which might come into effect in 2022.

<sup>33</sup> Draft Act of the Federal Government, Draft of an Act on the Community Patent and for the Amendment of Patent Law Provisions (*Gesetzesentwurf der Bundesregierung, Entwurf eines Gesetz über das Gemeinschaftspatent und zur Änderung patentrechtlicher Vorschriften*) of 7 September 1978, Federal Parliament Official Record 8/2087, p.23, right column, 2<sup>nd</sup> half

*The adaptation of the Patent Act to the substantive provisions of Articles 29, 30 and 31 of the Community Patent Convention is absolutely necessary. According to Article 64 of the European Patent Convention, the European patent shall provide to its proprietor the same rights as would be provided to him by a national patent granted in the Contracting State concerned. The purpose of this provision is to ensure, in the interest of equal value of European and national patents, that the rights deriving from the European patent in the respective Contracting State for which it has been granted are identical to the rights provided by a national patent. The rights derived from the Community patent, which is also a European patent, must therefore be congruent with the rights which a patent granted by the German Patent Office would provide, so that at least in terms of content, but if possible also in terms of wording, the provisions of the aforementioned articles of the Community Patent Convention are to be incorporated into the Patent Act.*

2. Even to the extent each amendment of the GPA is reasoned in the Draft Act, the Federal Government referred to the Luxembourg Convention and its related memorandum:<sup>34</sup>

*As already stated at the beginning (...) the need for the amendment proposed under this point arises from the ratification of the Community Patent Convention. Section 6 corresponds to Article 29 of the Community Patent Convention. For its content, reference is made to the explanations in the memorandum concerning this Article. Furthermore, it seems appropriate to emphasize that the patent is not only a prohibitive right, but also grants its proprietor an exclusive right of use which enables him, for example, to grant licenses to his patent. (...)*

*Section 6a incorporates Article 30 of the Community Patent Convention. Thus, the legal construct of indirect patent infringement is regulated by law for the first time and newly defined as compared to the previous legal situation. For the details of the provision, please refer to the explanations in the memorandum on Article 30 of the Community Patent Convention.*

3. Also, in the said memorandum of the German Federal Government concerning the Luxembourg Convention (“**Memorandum**”), it was clarified that the (future) Community Patent shall contribute to a harmonization of the infringement rules in

---

<sup>34</sup> Draft Act of the Federal Government (see fn. 33), p.24, rights column, 2<sup>nd</sup> half – p.25, left column, 1<sup>st</sup> half

the EC member states, with the Community Patent being given all effects provided under the national laws and its protection aligned to that of the national patents.<sup>35</sup>

*The provisions of this and the following Articles are intended to extend to the Community patent all effects that are connected with a national patent in the Contracting States, in order to achieve with the Community patent effects of protection in principle in each Contracting State which are not inferior to those of a national patent as far as possible.*

4. As far as the Memorandum refers to process patents and Art. 29 (b), the remarks concern the offering for the use of a patented process.<sup>36</sup> As for Art. 30 prohibiting the indirect use of the protected invention, it was clarified that this provision shall determine indirect infringement uniformly for the EC member states given the non-uniform case law and the differences in the systems of law; while indirect infringement was provided as an independent form of infringement not requiring direct infringement by another person.<sup>37</sup>

The efforts of the EC member states were thus directed to establish a patent system where the Community Patent would confer full patent protection in the same way as a national patent, but would cover the entire territory of the EC. Under such system, borders within the EC would become irrelevant for patent protection and thus make considerations on cross-border acts of infringement obsolete within the EC territory as far as Community Patents are concerned (the Community Patent did not enter into effect, so that this result was never achieved<sup>38</sup>).

Conversely, the intention of the German lawmakers was to adjust the legal provisions for German national patents, in particular Sec. 9 and 10 GPA, to the legal provisions that were planned to govern the Community Patent system. The above legislative documents confirm that there was no particular consideration of the German lawmakers on the issue of infringement of German patents (or German parts of European patents) by means of cross-border acts, let alone consideration of cross-border infringement of process patents.

---

<sup>35</sup> Memorandum on the Luxembourg Convention is printed in the Draft Act of the Federal Government (see fn. 33), pp.112-146. Remarks to Art. 29 and 30 are printed on pp.122 (right column)-124 (left column).

<sup>36</sup> See above fn. 35. While such offering under German law formerly required an offering to sell the process rules or the granting of a permission to use the process, the scope was extended to e.g. the mere notification of a certain process in light of the French law to the extent the offeror is aware that the use is prohibited (or this is obvious) and the offering is done for the use within the EC territory.

<sup>37</sup> See above fn. 35.

<sup>38</sup> See also above fn. 32.



### 3.2 Case Law affirming Attribution

While the efforts of the German lawmakers were not particularly directed to cross-border infringement cases, the German courts were affirming infringement in cases where the patented process is only partly realized in Germany by attributing acts taken abroad (see 1. above). The intention of attributing acts abroad is expressed e.g. in *Prepaid telephone card* and *Online eye test*.

In *Prepaid telephone card*, the HRC saw no reasons to differentiate as to whether the remaining steps are taken by a third party domestically or abroad. The court thus equated the acts taken abroad in view of the potential gaps in patent protection, finding that in the absence of an attribution of acts taken abroad, it would be possible for the user to circumvent patent protection without further ado, and his conduct would not amount an infringement in either state.<sup>39</sup>

In *Online eye test*, the RC Düsseldorf<sup>40</sup> referred to the case law of the HRC and reasoned the strong need to attribute acts taken abroad (even as far this is related to the last process step) in view of the possibility to circumvent protection of process patents as follows:

*A patent is intended to grant the inventor a fair reward for the technical teaching he has conceived; the possibility of obtaining patent protection for an invention is also intended to encourage potential inventors and give them an incentive to disclose their invention. These objectives would be practically undermined in some areas of technology if a patent could be granted for a process, but it could not ultimately be enforced in any country because the carrying out of the process can be divided into several countries.*

*It is also recognized that neither the applicant nor the patent offices are in a position to fully cover the numerous possibilities of concrete technical embodiments of a claimed teaching for technical acts in the wording of the patent claim (Benkard/Scharen, GPA, 11th ed. 2015, Sec. 14 mn. 99). Based on this problem, the doctrine of equivalent patent infringement was developed. However, comparable difficulties may also arise in formulating the claim of a process patent in such a way that the last process step must be carried out domestically. This problem exists particularly in the case of processes that run on computer systems and computing steps can be outsourced via the internet to practically any location in the world.*

---

<sup>39</sup> See above fn. 6 (par. 134)

<sup>40</sup> See above fn. 20 (par. 153, 154)

## 4. Requirements

If the requirements for what is considered infringement have been clarified by a court decision, etc., please let us know what those requirements are.

### 4.1 Standards applied by the HRC Düsseldorf

According to the landmark decisions rendered by the HRC Düsseldorf in *Prepaid Telephone Card* and *Prenatal Diagnosis*, a process patent can be infringement (“use” under Sec. 9 S.2 no. 2 GPA<sup>41</sup>; suitability of a means for the “use of the invention” under Sec. 10 Par. 1 GPA<sup>42</sup>) where the patented process is only partly realized in Germany if the actions taken abroad are attributable to the person acting domestically, i.e. the infringer adopts these actions as his own for an infringing effect occurring domestically.

This can particularly be affirmed:

- (As for manufacturing processes) if the process steps taken abroad produce a preliminary or intermediate product which is delivered to Germany and refined there using the remaining process steps to produce the final process product.
- (As regard to work processes) if the process steps taken abroad are used for an infringing effect occurring domestically in view of the patent claim with its technical features and, additionally, the conduct in question is targeted and tailored to an effect in the domestic market.

In the absence of a decision by the FCJ in the cross-border context, the above considerations by the HRC Düsseldorf are enjoying a high practical value. While these do not have a legally binding effect towards the courts in other HRC jurisdictions (such as the RC Munich and Mannheim), the factual impact is significant and extend beyond the HRC boundaries due to the vast experience of the courts in Düsseldorf and their highly respected views within the German patent community.

### 4.2 (Non-)Relevance of the Last Process Step

With respect to the attribution of acts taken abroad and the above decisions requiring that the infringer adopts these as his own, the recent decisions of the instance courts have revealed differing views on the relevance of the last step of a patented process:

---

<sup>41</sup> See above fn. 8

<sup>42</sup> See above fn. 2

#### 4.2.1 HRC Düsseldorf

Particularly the HRC Düsseldorf presupposed the final step to be taken in Germany for the attribution of acts taken abroad. In a side note of *Prenatal Diagnosis*, the HRC Düsseldorf elaborated as follows:<sup>43</sup>

*The situation would be different (meaning attribution leading to patent infringement) if the patent claim, in addition to making the diagnosis, also covered its subsequent disclosure to the patient. Under such circumstances, the first and the last steps of the process would be carried out in Germany, whereby the intermediate acts abroad would both build on the domestic preparatory work (taking of samples) and the proceeds thereof would be used by the last domestic act (communication of the diagnosis made) to achieve the success of the invention, which justifies attributing them to the domestic person as if he had carried out the intermediate steps himself in Germany. It is irrelevant in this context that the domestic process steps (taking of samples, announcement of the diagnosis result) represent subordinate acts from a technical point of view, with which the actual core of the invention is not realized.*

*[underlined by author]*

According to the HRC, the steps taken in the US regarding to the DNA diagnosis would have been attributed if the patent claim in addition to the diagnosis had included its simple notification to the patient as a further step. The final step would thus be considered for the attribution but be determined formally based upon the asserted patent claim.

#### 4.2.2 RC Mannheim

The RC Mannheim explicitly distanced itself from the HRC Düsseldorf in *Music streaming* setting out a higher standard for affirming the attribution of acts taken abroad, stating as follows:<sup>44</sup>

*(...) the board cannot agree with the HRC Düsseldorf's view according to which the mere disclosure of the analysis result found by the process of the patent constitutes the success according to the invention, as far as such a feature is included in the patent claim. ... The acts committed within the country must in any case be equivalent to the acts committed abroad with regard to the task and solution of the specific process claim.*

---

<sup>43</sup> See above fn. 12 (par. 83)

<sup>44</sup> See above fn. 16 (par. 48, 53)

The RC Mannheim thus required that the acts undertaken in Germany are equivalent to the acts taken abroad with regard to the task and solution of the specific process claim. The mere notification of a result of a patented process would thus not be sufficient.

#### 4.2.3 RC Düsseldorf

In contrast to the RC Mannheim, RC Düsseldorf did not even request for a last step to be conducted in Germany in *Online eye test*.<sup>45</sup> An attribution can be affirmed if the advantages of a patented process occur due to process steps undertaken domestically and if these also have a domestic effect. While not denying the general relevance of the last step, the RC considered it sufficient if, for instance, based upon an evaluation of the patented process the last step carried out abroad does not relevantly contribute to the advantages of the invention with respect to the state of the art.

#### 4.2.4 Kühnen, presiding judge at the HRC Düsseldorf

While the judgement of the RC Düsseldorf in *Online eye test* has become final in the absence of an appeal, its reasoning has been criticized by influential judge *Kühnen*, who is currently presiding judge at the HRC Düsseldorf and may have decided in *Online eye test* if the case were appealed.<sup>46</sup>

The criticism is directed against the legal construct to affirm infringement by way of attribution irrespective of whether any technical steps concluding the process follow and are realized abroad. As relevance has to be attached to all features of the patent claim, according to *Kühnen*, patent protection cannot to be affirmed before the last step is completed, thus requesting that the last process step is realized in Germany. But as a result, *Kühnen* suggests coming to the same conclusion by way of claim interpretation and understanding the claim feature “calculation” of the last process step not as a mere procedural act of calculation, but functionally as an act by which the calculation results are made available and allow a diagnosis of the visual defect and its correction, which may have arguably occurred in Germany.

While *Kühnen* stresses the relevance of the last process step to be realized in Germany (even if formal) in accordance with the previous decisions of the HRC Düsseldorf, a substantial assessment as to whether the acts taken abroad are attributed would yet take place. The attribution would be assessed in the context of the specific claim feature providing for the concerned process step and seems to shift into the claim interpretation.

---

<sup>45</sup> See above fn. 20 (par. 147-155)

<sup>46</sup> Kühnen, Handbuch der Patentverletzung, 13. Aufl. 2021, A V 359ff.

#### 4.2.5 Comments

While the reasoning of the RC and the HRC in Düsseldorf (including *Kühnen*) for the attribution of acts taken abroad shows differences, the proactive tendency of the Düsseldorf courts to affirm attribution and infringement of process patents in cross-border cases is apparent.

The standards set out by the RC Mannheim for the attribution of actions abroad are considerably higher, requiring the acts taken domestically to be equivalent to the acts taken abroad regarding the task and solution of the specific process claim.

As for the courts other than the HRC Düsseldorf and the RCs Düsseldorf and Mannheim, the further developments will have to be observed, but the views of the Düsseldorf courts as described above are expected to have a strong factual impact on their assessment.

## Contacts

---



### **Dirk Schüßler-Langeheine**

Partner, Dr. jur., attorney-at-law, Mediator

[dschuessler@hoffmanneitle.com](mailto:dschuessler@hoffmanneitle.com)

---



### **Nobuchika Mamine**

Attorney-at-Law, LL.M.

[nmamine@hoffmanneitle.com](mailto:nmamine@hoffmanneitle.com)

---

HOFFMANN EITLE | Patent- und Rechtsanwälte PartmbB

Arabellastraße 30, 81925 Munich

Phone: +49 (0) 89 92 40 90

---

This report has been prepared for general guidance and does not constitute professional advice. You should not act upon the information contained in this report without having obtained specific professional advice. No representation or warranty is given as to the accuracy or completeness of the information contained in this report, and, to the extent permitted by law, Hoffmann Eitle Patent- und Rechtsanwälte PartmbB, its members, employees and agents do not accept or assume any liability, responsibility or duty of care for any consequences of you or anyone else acting, or refraining to act, in reliance on this report or for any decision based on it.

This report is based on information that has been available on 24 September 2021 and is subject to any changes occurring after that date either on a prospective or retrospective basis.

© 2021 Hoffmann Eitle Patent- und Rechtsanwälte PartmbB. All rights reserved.