

# IP Report

## Patent Law



**BARDEHLE  
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**Regarding claims for provision of information and rendering of accounts regarding deliveries abroad – the decision passed by the Higher Regional Court of Duesseldorf, docket no. I-2 U 25/19**

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**According to a judgment by the Higher Regional Court of Duesseldorf dated August 13, 2020, a Plaintiff that prevailed at first instance because of proven acts of infringement by the Defendant in Germany, who, however, also seeks information and rendering of accounts regarding relevant deliveries abroad by the Defendant has to attempt to have the facts and merits of the case corrected by an amendment to the first-instance judgment if no statements are made in the first-instance judgment regarding said deliveries abroad even though it had made submissions in this regard at first instance. If the Plaintiff fails to do so, these deliveries abroad only become a subject matter of the appeal proceedings if the Plaintiff makes a submission in this regard within the time limit for filing a cross appeal – which corresponds to the time limit for filing a statement of defense in the appeal proceedings. If the Plaintiff misses this deadline, it is only allowed to assert a corresponding provision of information and rendering of accounts regarding the deliveries abroad in new proceedings on the merits.**

### **1. Facts of the case**

The Plaintiff is the proprietor of the German part of the European Patent EP 1 801 005 (“*patent-in-suit*” below) which protects the specific embodiment of a quick release for securing a wheel to a bicycle. Defendant 2), a Taiwan-based company, exhibited the attacked embodiments at a trade fair in Germany.

In response, the Plaintiff filed an infringement suit with the Regional Court of Duesseldorf, asserting, *inter alia*, the common versions of claims for provision of information and rendering of accounts. In the statement of complaint, the Plaintiff also mentioned that Defendant 2) had also delivered the attacked embodiment to customers abroad which, in turn, had delivered them to Germany. The Plaintiff invoked that Defendant 2) knew about the onward sale.

The Regional Court Duesseldorf ruled against the Defendant in accordance with the requests, but only based on the acts of infringement committed by Defendant 2) itself in the context of the trade fair in Germany, without making any statement regarding the deliveries abroad in its judgment.

The Defendant lodged an appeal against this judgment with the Higher Regional Court of Duesseldorf. While the appeal proceedings were still pending, the Plaintiff initiated enforcement proceedings and

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requested that coercive measures be determined against the Defendant because of incomplete provision of information. After the Plaintiff's request for coercive measures had been absolutely and finally rejected and after the time limit for filing a statement of defense in appeal proceedings had expired, the Plaintiff requested that the operative part of the judgment of the Regional Court relating to the provision of information and rendering of accounts be amended as follows after:

„whereas the details owed by Defendant 2) include all and any deliveries to the customers in question, irrespective of whether a specific delivery was put into circulation in the territory of the Federal Republic of Germany by said customer, if the Defendants had specific indications suggesting that the customers sell on the delivered goods to the Federal Republic of Germany or offer them there.”

Here, the Plaintiff invoked the statement of the German Federal Court of Justice in its decision “Abdichtsystem” (GRUR 2017, 785), according to which an undue and culpable facilitation or promotion of a patent infringement by third parties by delivering items to a customer abroad violates a party's obligations and also exists if the supplier has specific indications suggesting that its customers sell the delivered goods onwards to Germany or offer the goods there.

The Defendant objected to the Plaintiff's submission and requested that the complaint be dismissed.

## **2. Decision of the Higher Regional Court of Duesseldorf**

The Higher Regional Court of Duesseldorf first also confirmed patent infringement and dismissed the Defendant's appeal. However, the Senate deemed the addition of deliveries abroad to the request for provision of information and rendering of account which the Plaintiff sought inadmissible for two reasons: Firstly, the Court stated, the amended request lacked the required precise specification (Sec. 253(2) no. 2 German Code of Civil Procedure). Secondly, the Court held, the amendment to the request was inadmissible because the time limit for filing a cross appeal had expired.

### **2.1 Lack of precise specification of the amended request**

First, the Senate rejected the amendment to the claim for provision of information and rendering of accounts requested by the Plaintiff because of a lack of precise specification of the request pursuant to Sec. 253(2) no. 2 German Code of Civil Procedure.

The Court held:

When assessing whether or not provision of information and rendering of accounts are complete, what is decisive is not the substantive legal situation, but only what the operative part of the judgment stipulates regarding the content and scope of the obligation to provide information and render accounts. This means that a merely formal examination of whether or not the party owing information provided all details according to the passed judgment is required.

The grounds for the decision may indeed be used to interpret the enforcement title regarding the scope of the details owed, but the provision of information on acts which were not at all reflected by the operative part of the judgment cannot be forced by way of enforcement proceedings.

With respect to the contentious proceedings, this means that the passed judgment already needs to be specific enough for the Defendant to be able to easily discern which information it has to provide under which conditions taking the grounds for the decision into consideration. This criterion is not met by the amended wording of the Plaintiff's request as it is not even clear which "*specific indications*" trigger the added obligation by the Defendant to provide information and render accounts regarding the deliveries abroad. Additionally, it is unclear which conditions "*suggest*" an onward delivery of the infringing items to Germany. Such questions of substantive law cannot be transferred to enforcement proceedings which are geared towards an enforcement of rights and formalized.

### 2.2 Amended request late

The Senate also held that the Plaintiff's amended request was also inadmissible because said request was filed only after the time limit for filing a cross appeal had expired and, thus, was late.

In this context, the Senate stated that the matter in dispute "*deliveries abroad*" had not reached the appellate instance.

According to the Court, the Plaintiff did indeed make a general submission regarding deliveries abroad, in its statement of complaint at first instance, but neither did the facts and merits of the case nor did the grounds for the decision of the first-instance judgment of the Regional Court include any statements regarding said deliveries abroad. Thus, in the opinion of the Senate, with respect to this part of the matter in dispute which the Regional Court did not recognize, the Plaintiff should have requested a correction of the statement of the facts and merits of the case (Sec. 320 German Code of Civil Procedure) and a subsequent amendment to the judgment (Sec. 321 German Code of Civil Procedure).

The Court also held that the matter in dispute "*deliveries abroad*" did not become the subject matter of the appeal proceedings retroactively either as the Plaintiff only filed the amended request after the time limit for filing a cross appeal had expired and, thus, late. According to the Court, a mere amendment to a request is generally possible at any stage of appeal proceedings if the matter in dispute remains unchanged. However, in this case, the Plaintiff submitted an extension of complaint with new facts and circumstances and, thus a new matter in dispute which had not been discussed by the first-instance judgment. The Court stated that, in line with the case law of the Federal Court of Justice, asserting such an extension of complaint is only possible until the time limit for filing a cross appeal has lapsed. The Court held that, as the time limit for filing a cross appeal had lapsed, the Plaintiff was only left with the option of initiating new proceedings on the merits in order obtain the desired information regarding the deliveries abroad.

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### Comments

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In terms of substantive law, according to the case law of the German Federal Court of Justice, a supplier that sells patent-infringing products to a customer abroad who, in turn, delivers these products to Germany is jointly responsible for a patent infringement in Germany if they (positively) know of the onward sale to Germany, or at least has specific indications suggesting that the customer abroad sells on the delivered goods to Germany or offers them there. If these requirements are met, the supplier generally has to provide information and render accounts regarding all deliveries to said customer abroad.

From a procedural point of view, however, such an obligation of providing information and rendering accounts on relevant deliveries abroad requires that the Plaintiff makes factual submissions and files a corresponding specific request addressing the deliveries abroad at first instance and at an early stage, if possible, at least if the Plaintiff also invokes acts of infringement committed by the Defendant itself (in Germany), according to the Higher Regional Court of Duesseldorf. The Court also states that, in such a setting, the first-instance judgment must carefully be examined within the statutory time limits as to whether said submission of fact is reflected by the statement of facts and merits of the case in the judgment and whether the requirements for a joint responsibility regarding deliveries abroad are addressed in the grounds for the judgment. If this is not the case, it has to be examined whether a request for correction of the facts and merits of the case and amendment to the judgment is to be filed.

If the Plaintiff does not do so, it runs the risk of having its request – filed at second instance – by which it seeks information regarding the deliveries abroad as well is rejected due to inadmissibility if the Plaintiff does not file said request in written form within the time limit for filing a cross appeal which is identical to the time limit for submitting a statement of defense in appeal proceedings. What is more is that the Plaintiff, making new factual submissions regarding the deliveries abroad only at second instance, risks that this submission is ruled out as being late under Sec. 531 German Code of Civil Procedure – if it does not remain unchallenged. This is another reason why it is recommended to clarify and, if necessary, research – before the complaint is filed, if possible – whether the potential infringer (also) uses distributing channels abroad which are the basis of subsequent onward sales to Germany.