

## Machine Translation

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**Date:** 23.11.2023  
**Court:** Düsseldorf Higher Regional Court  
**Panel:** 2nd Civil Senate  
**Type of decision:** judgment  
**Reference number:** 2 U 138/22  
**ECLI:** ECLI:EN:OLGD:2023:1123.2U138.22.00

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**Lower court:** Düsseldorf District Court, 4a O 18/20  
**Guidelines:**

### Guiding principles

1.

If the plaintiff asserts claims for the time before the (alleged) transfer of the patent to it with its complaint, it must demonstrate and prove its active legitimacy, insofar as this is disputed by the defendant, in accordance with general principles.

2.

If the defendant expressly refers in its submission to a corresponding burden of presentation and proof on the part of the plaintiff, there is only a (supplementary) judicial duty to provide information pursuant to Section 139 (1) Code of Civil Procedure (ZPO) if the defendant's submission was - obviously for the court - misunderstood. In the case of a party represented by a lawyer, the question of whether such a misunderstanding has occurred depends solely on the person of the attorney of record.

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**Tenor:**

I. The plaintiff's appeal against the judgment of the 4a Civil Chamber of the Düsseldorf District Court announced on November 8, 2022, as amended by the corrective order of December 16, 2022, is dismissed.

II. The plaintiff is also ordered to pay the costs of the appeal proceedings.

III. The judgment and the judgment of the District Court are provisionally enforceable.

The plaintiff may avert the defendants' enforcement against security in the amount of 120 % of the amount enforceable on the basis of the judgments of first and second instance, unless the defendants provide security in the amount to be enforced in each case prior to enforcement.

The defendants may avert the plaintiff's enforcement against security in the amount of EUR 625,000 unless the plaintiff provides security in the same amount prior to enforcement.

IV. The appeal is not permitted.

V. The amount in dispute for the appeal proceedings is set at EUR 500,000.

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**Reasons:**

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**I.**

The plaintiff is suing the defendants for infringement of German patent 10 2004 027 XXA B4 (hereinafter: patent in suit) for information and invoicing, payment of warning costs and damages on the merits. In addition, the plaintiff demands recall, destruction and compensation on the merits from the defendant (1).

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The patent in suit was granted on June 2, 2004, claiming the priority date of a British document dated 03.06.2003. After publication of the patent application on 30.12.2004, the reference to the grant of the patent was published on 20.10.2016. The patent in suit is in force.

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Since April 23, 2019, the plaintiff has been registered in the register of the German Patent and Trademark Office as A (hereinafter also: A) was registered as the (first) patent holder, whose subsidiary the plaintiff, then trading as B GmbH, had formerly been. The plaintiff received its current name after the transfer to C S.p.A. (hereinafter also: C).

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The patent in suit is entitled "Cup dispenser". Its claim 1 is as follows:

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"Carousel-style cup dispenser with a large number of cups arranged radially around a carousel axis"

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*mechanism comprises four or more cup separating screws forming a circular cup dispensing opening, and adjacent dispensing mechanisms are arranged close to each other in the dispenser so that the smallest distance between adjacent cup dispensing openings is about 25 millimeters or less, each cup dispensing mechanism comprising two outer cup separating augers disposed on a first half of a circumference of the cup dispensing openings, the two outer augers being spaced apart a first distance, and two inner cup separating augers disposed on a second half of the opening and spaced apart a second distance, the second distance being less than the first distance."*

Figure 1 of the patent in suit, reproduced in reduced form below, explains the Invention according to a preferred embodiment. It is a perspective view of a cup dispensing mechanism for a cup dispenser according to a first embodiment of the invention: 7

Defendant 1) manufactures vending machines. Its product range includes 8  
These include so-called "InCup" vending machines with the brand name "D". With InCup systems, water is poured into disposable cups (InCups) pre-filled with beverage granulate in machines designed for this purpose. Defendant 2) has been the managing director of the general partner of defendant 1) since December 1, 2018.

With regard to the "D" type hot drinks vending machines marketed by the defendants 9  
also include the machines shown in Exhibits K 11 to K 13 (hereinafter: original attacked embodiment). In these, four dispensing mechanisms of a cup dispenser segment were provided - as required by the patent in suit.

The defendants later modified the originally challenged embodiment by adding an 10  
each of the four dispensing mechanisms of a cup dispenser segment, the right-hand one of the inner cup separating screws was removed and at the same time the bearing pin provided for this purpose was replaced by a hole (hereinafter: modified attacked embodiment; see Exhibit K 16).

After the action was filed, but before the statement of defence was submitted, the defendants 11  
submitted a declaration to cease and desist under penalty of perjury with regard to the original attacked embodiment. After the plaintiff later warned the defendants about the form of use of manufacturing, the defendants added the form of use of manufacturing to their cease-and-desist declaration they had submitted.

That the original contested embodiment of claim 1 of the patent in suit 12  
was undisputed between the parties at first instance. The plaintiff also argued that it had standing to assert all claims, that the infringement of the patent in suit was culpable, that neither the claim for destruction nor the claim for recall were excluded due to disproportionality and that its claim for reimbursement of warning costs was justified. As far as the formerly asserted claim for injunctive relief is concerned, the parties have already unanimously declared the legal dispute settled in the first instance with regard to the declaration of discontinuance submitted by the defendants. With regard to an indirect patent infringement asserted by the plaintiff by way of an extension of complaint due to the modified attacked embodiment, the plaintiff already withdrew the complaint at first instance.

The defendants, who asked for the action to be dismissed, argued before the District Court that the plaintiff did not have standing. Furthermore, there was no fault and the claims for destruction and recall were disproportionate, and the claim for destruction was also disproportionate due to the lack of possession or ownership of defendant 1). There was also no entitlement to reimbursement of warning costs. The defendants also raised the plea of the statute of limitations.

In its judgment dated November 8, 2022, the Düsseldorf District Court ruled in each case for the period since 27.12.2018 granted the requests for information, rendering of accounts and damages (in this respect vis-à-vis defendant 2) only from 01.01.2019), the defendant to 1) (limited) to recall the product and ordered both defendants to pay warning costs. In all other respects, it dismissed the complaint. In detail, the District Court ruled as follows: 14

I. The defendants are sentenced, 15

1. to provide the plaintiff with information on the extent to which the defendants, 16

since 27.12.2018

cup dispensers in carousel design with a plurality of dispensing mechanisms arranged radially around a carousel axis 17

spaced-apart dispensing mechanisms for dispensing cups from a corresponding plurality of corresponding plurality of stacks of nested cups,

manufactured, offered, placed on the market or sold in the Federal Republic of Germany used or imported or possessed for the aforementioned purposes, 18

wherein each mechanism has four or more barrel separating screws that form a circular cup dispensing opening, and adjacent dispensing mechanisms are arranged close to each other in the dispenser so that the smallest distance between adjacent cup dispensing openings is about 25 millimeters or less, each cup dispensing mechanism comprising two outer cup separating augers disposed on a first half of a circumference of the cup dispensing opening, the two outer augers being spaced apart a first distance, and two inner cup separating augers disposed on a second half of the opening and spaced apart a second distance, the second distance being less than the first distance; 19

in each case stating 20

a) the names and addresses of manufacturers, suppliers and other previous owners, 21

b) the names and addresses of the commercial customers and the Sales outlets for which the products were intended, 22

c) the quantity of products delivered, received or ordered and the Prices paid for the products concerned; 23

whereby the corresponding proofs of purchase (namely invoices, alternatively delivery bills) must be submitted in copy, whereby details requiring confidentiality outside the data subject to disclosure may be blacked out; 24

2. to account to the plaintiff for the extent to which the defendants have 25

I.1. have committed the aforementioned acts since 27.12.2018, stating:

a)	production quantities and times,	26
b)	of the individual deliveries, broken down by delivery quantities, times and prices and type designations as well as the names and addresses of the customers,	27
c)	of the individual offers, broken down by offer quantities, times and prices and type designations as well as the names and addresses of the offerees,	28
d)	of the advertising operated, broken down by advertising media, their Circulation, distribution period and distribution area and, in the case of Internet advertising, the Internet addresses, placement periods and access figures,	29
e)	the prime costs broken down according to the individual cost factors and of the profit generated,	30
	whereby the defendant to 2) only has to provide the information for actions from 01.01.2019 has; and	31
	whereby the defendants reserve the right to disclose the names and addresses of the non-commercial and the offerees instead of the plaintiff to a person to be designated by the plaintiff and to a sworn accountant domiciled in the Federal Republic of Germany to be designated by the plaintiff and bound to secrecy, provided that the defendant 1) and/or the defendant 2) bear his costs and authorize and oblige him to inform the plaintiff upon specific request whether a particular customer or offeree is included in the list;	32
3.	only the defendant to 1): the claims described under I.1. and after 20.10.2016 to recall products placed on the market to commercial customers with reference to the patent-infringing condition of the item established by the court (judgment of the Düsseldorf District Court of November 8, 2022) and with the binding promise to reimburse any fees and to bear any necessary packaging and transport costs as well as customs and storage costs associated with the return and to take back the products;	33
	whereby the defendant to 1) is permitted to grant those third parties to whom the defendant to 1) has granted or with whose consent possession of the products referred to in I.1. was granted, instead of returning the product to the defendant 1) against reimbursement of the purchase price, to have the products redesigned by the defendant 1) in such a way that one of the four cup separating screws is irreversibly removed in each case, with the defendant 1) bearing all the costs of the redesign;	34
4.	to pay the plaintiff EUR 3,456.59.	35
II.	It is noted that	36
1.	the defendant (1) is obliged to compensate the plaintiff for all damage suffered by the plaintiff by the persons referred to in Section I.1. in the period from 27.12.2018 to 31.12.2018 has arisen and will arise in the future;	37
2.	the defendants are jointly and severally liable to pay the plaintiff all damages which the plaintiff has suffered as a result of the events described in Section I. 1. has arisen and will arise in the future.	38
		39

III. The remainder of the complaint is dismissed.

In its reasons, the District Court essentially stated:

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The plaintiff was entitled to assert the claims for destruction and recall on the basis of her entry as owner in the patent register on the basis of Section 30 (3) sentence 2 PatG, because these claims are not owed to the patent owner, but are owed per se. With regard to the claims for damages, information and rendering of accounts, its legitimacy to take action for acts from 27.12.2018 arises from the submission that the patent in suit was transferred to it on this date, in combination with its entry as patent proprietor in the patent register on 29.04.2019. The submission that a transfer of rights entered in the patent register took place a few weeks or months before its entry generally does not require any further substantiation or evidence (Federal Supreme Court BGH, GRUR 2013, 713, 716 f. - Fräsverfahren). This was the case here after the plaintiff had sufficiently presented the corporate transaction agreed between A and C on September 29, 2018, in the course of which the patent in suit was transferred directly from A to the plaintiff and the closing date of which was December 27, 2018. The transfer in the patent register had also taken place sufficiently close in time to the alleged transfer, taking into account that the transfer had taken place as part of a larger international transaction and that the plaintiff had been renamed in the meantime. Finally, the plaintiff was already entitled to claim the costs of the warning letter because it had commissioned the corresponding letter.

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On the other hand, with regard to claims for compensation, information, rendering of accounts and damages for acts prior to 27.12.2018, the plaintiff's right to bring an action cannot be established. The patent register says nothing about the assignment of the claims alleged by the plaintiff in this respect, which presupposes an agreement that goes beyond the mere transfer of property rights. After the defendants had denied an assignment, the plaintiff should have presented more details and, if necessary, offered evidence, which it did not do, but continued to insist on the non-existent indicative effect of the register despite the express indications of the defendants.

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The (now) solely disputed original contested embodiment infringes claim 1 of the patent in suit, which is not specifically denied by the defendants, in accordance with its wording. The plaintiff therefore has the tenor of the claims against the defendants. The fault of the defendants required for the claim for damages was 1) was given, in particular the patent attorney search by the client of the attacked embodiment did not exonerate her. The defendant under 2) is also liable from the time of his order plus a waiting period of one month. A recall claim also exists, however, for reasons of proportionality, this should be limited to the transformation into a non-infringing embodiment. On the other hand, the plaintiff is not entitled to destruction after the defendants have shown that they have modified the original contested design by removing the fourth cup separating screw.

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Against this judgment, which was served on its legal representatives on 08.11.2022, the plaintiff lodged an appeal with the court in a lawyer's writ dated December 7, 2022, received by the court on the same day, in which she also demands a conviction of the defendant to the extent that it concerns the period from October 20, 2016 to December 26, 2018 (information), March 4, 2010 to December 26, 2018 (invoicing) and November 21, 2016 to December 26, 2018 (defendant's liability for damages under 1)) and the period from March 4, 2010 to November 20, 2016

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the claim for compensation asserted by the defendant 1) was dismissed in its entirety. In the alternative, it requests that the judgment be set aside to the extent stated and that the case be referred back to the District Court.

In particular, the plaintiff claims that:

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Insofar as the District Court dismissed the complaint for lack of proof of active legitimacy The Chamber's decision was an inadmissible surprise decision pursuant to Section 139 (2) Code of Civil Procedure (ZPO), which infringed the plaintiff's right to be heard pursuant to Article 103 (2) GG and the requirement of a fair trial. Since she, the plaintiff, was clearly mistaken as to the necessity of further factual submissions due to previous decisions in the proceedings and in parallel proceedings, the Chamber should have given appropriate instructions.

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Thus, the submission on active legitimation in the parallel proceedings against E GmbH corresponds to amongst others (file no.: 4a O 9/20, final judgment of 25.11.2021 submitted as Exhibit WKS 3) was essentially the same as that in the present proceedings and the active legitimacy for claims arising from assigned rights was also in dispute there. However, the Chamber had sentenced the defendants in the parallel proceedings in accordance with the application without further addressing the disputed active legitimacy or even considering it to be problematic. Moreover, with the order of reference dated August 24, 2022, the District Court gave the impression that there was no deficiency in presentation because it merely requested the plaintiff to reformulate the version of the application and did not at least point out the insufficient presentation.

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Since the defendant regularly uses the plaintiff's factual submissions on legitimacy as a reason for extensive disputes, every disputable factual submission proves to be a factual submission is a serious error in legal advice if the party, even without a factual facts is to be regarded as having legal standing for legal reasons. She, the plaintiff, had assumed that the presumption of registration according to the "milling procedure" extended to the facts of the case. On this basis, it was consistent and necessary to refrain from further factual submissions.

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If the Chamber had issued the required notice pursuant to Section 139 (2) Code of Civil Procedure (ZPO), the plaintiff would have supplemented its submission on its entitlement to take action by submitting evidence and would also have withdrawn its consent to a decision in written proceedings due to a significant change in the procedural situation. She would have submitted the following:

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The transfer of the patent in suit from A to B GmbH, then still trading as already stated at first instance, the plaintiff was involved in the sale of the beverage business from A to C. The corporate law basis of this sale had been agreed in a Sales and Purchase Agreement (hereinafter: SPA) dated 29/09/2018, as also explained at first instance.

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The transfer of the intellectual property rights, on the other hand, is included in the SPA, which The SPA does not contain a general agreement in this respect, but has been spun off into a separate assignment agreement between the respective IP right holders as assignors and the intended IP right holders as assignees, the Global IP Assignment Deed dated December 27, 2018 (Exhibit WKS 4, in German translation as Exhibit WKS 4a; hereinafter: Deed). "Deed" refers to a specific form of contractual document in the English law applicable pursuant to section 4.1. The actual declaration of assignment can be found in

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Section 1 of the Deed is broadly worded and aims to give the respective assignee the legal position previously held by the respective assignor.

In particular, claims for compensation and damages of the respective previous owner would be transferred to the respective acquirer of the property right. The acquirer should be explicitly entitled to claim damages for acts of infringement that occurred before the dates of the deed.

Because the declarations of assignment in the Deed are individual, merely bundled assignment declarations, the only thing that matters for the legal validity of the transfer of the patent in suit is that the declarations made on behalf of these two companies are effective. This was the case. A (= A, Incorporated) as the original owner of the patent in suit, legally represented by two

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"Authorized Signatories" assigned the patent in suit together with all resulting claims - including all claims for past acts of infringement - to the plaintiff (= then B GmbH), whose two managing directors at the time accepted the assignment with their signatures.

The transfer of the patent in suit together with the assignment of all claims arising therefrom was part of an extensive corporate transaction between two well-known international groups and was legally supported by several renowned law firms. This alone suggests that the legal requirements for the assignment of claims for compensation and damages were met. To date, none of the parties involved have questioned the effectiveness of the assignment.

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Insofar as the defendants dispute the effectiveness of the SPA, this is irrelevant. On its legal effectiveness is not relevant for the effectiveness of the Deed because the latter is independent of the SPA in its effectiveness. The lack of identity of the parties between the SPA and the Deed speaks in favor of this and against the condition assumed by the defendant and can also be inferred from the wording of the Deed itself, for example from the arbitration clause (clause 4.2) and the severability clause (clause 3.9). Moreover, the defendants were not allowed to dispute facts simply because they were to their disadvantage due to the procedural duty of truth. In fact, the SPA had been effectively concluded and the transaction of the beverage business from A to C - a transaction worth many hundreds of millions of euros - had been an economic reality for almost five years. It was abstruse for the defendants to seriously claim, despite all the evidence presented, that such massive errors had been made here that the contracts were void without being noticed. Should the Senate, contrary to expectations, consider the defendants' denial to be significant, it is requested that it be notified so that appropriate confidentiality measures can be taken before the contract documents are produced. This is because the details of the SPA are strictly confidential and subject to confidentiality clauses.

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The defendants also wrongly denied the invalidity of the deed. The term "English law" is by no means unclear, but is the usual formulation for the law applied by the courts in England and Wales. The fact that this law is meant is also clear from the rule of interpretation in Schedule 7, point 2 (e) of the Deed. The combination of bilateral declarations for the transfer of individual property rights from individual assignors to individual assignees is of course legally possible, even under the agreed English law. Insofar as the defendants take the view that there is a lack of an overall deed signed by all assignors and assignees, which must be inseparably linked and secured with a seal, there is no such requirement under English law. Even according to the explicit

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provision in clause 3.7 of the Deed, a deed with all signatures under a single document is not required.

With regard to the authority to sign disputed by the defendants, the only relevant factor is the transfer of the patent in suit from A to B GmbH and thus also according to The assignor argued that under English law, only the representatives signing on behalf of these two companies were authorized to sign. Mr. F and Mr. G, who signed on behalf of the assignor, A, were authorized to sign according to the relevant law of the US state of Delaware as the state in which the company was founded. By the decision of the Board of Directors of A dated 12.09.2008, they were authorized to conclude agreements for the execution of the transaction of the beverage business from A to C, as can be seen from a certificate of Ms. H, Vice President, Secretary and General Counsel of A dated 26.09.2018, submitted as Exhibit WKS 6 (in German translation as Exhibit WKS 6a). According to the relevant German law, the authority of Mr. I and Mr. J to sign on behalf of the assignee, B GmbH, arises from the fact that they are managing directors of the company and as such are jointly authorized to sign in accordance with the general representation rule in Section 5 (2) of the articles of association dated 30 July 2007 (Exhibit WKS 7).

The plaintiff **claims that the Court should,** 57

on appeal, set aside the judgment under appeal in so far as the complaint was partially dismissed in respect of information and rendering of accounts as well as determination of compensation and damages and 58

1. order the defendants to pay the costs, 59

a) as recognized under I.1, but with the proviso that instead of "since the 27.12.2018" means: "since 20.10.2016"; 60

b) as recognized under I.2, but with the proviso that instead of "since 27.12.2018" means: "since 04.03.2010"; 61

2. to be determined, 62

a) that the defendant (1) is obliged to pay it (the plaintiff) for the damage referred to in pointl.1. 63

to pay appropriate compensation for the aforementioned acts committed in the period from March 4, 2010 to November 20, 2016;

b) as recognized under II.1, but with the proviso that the defendant under 1) furthermore is obliged to compensate it (the plaintiff) for all damages incurred by Mars Incorporated as a result of the acts described in Section I.1. committed in the period from November 21, 2016 to December 26, 2018; 64

alternatively: 65

to the extent of the claims for information that have not been recognized or established, The Court of First Instance has set aside the judgment of the Düsseldorf District Court and referred the case back to the Düsseldorf District Court for a new hearing and decision. 66

The defendants **request** 67

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that the appeal be dismissed.

They argue that the plaintiff bases its appeal solely on the provisions relating to the new means of attack introduced in the grounds of appeal. However, these were not admissible pursuant to Section 531 (2) Code of Civil Procedure (ZPO) and were therefore late. The plaintiff was already aware of the entire new argument at first instance, but nevertheless deliberately did not submit it at first instance. The District Court had also not infringed any duty to provide information; on the contrary, it was foreseeable for the plaintiff with careful conduct of the proceedings that the court would base its decision on considerations of active legitimacy and that the plaintiff's allegations in this regard would require proof. The aspects of legitimacy and the need for evidence had been sufficiently explained in the writ.

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The statement on the alleged evidence submitted by the plaintiff regarding the right to bring an action is only made in the alternative and as a precautionary measure in the event that the first submission of the plaintiff is admitted by the Senate in the appeal instance:

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It is disputed that the deed leads to an effective transfer of rights from the assignors to the assignees, that the signatories listed therein were authorized to sign and that the SPA between A and C, which was a condition for the validity of the Deed and which was alleged but not presented, had been validly concluded. The wording of the Deed suggested that the alleged SPA preceded it in time and that the Deed was therefore an ineffective self-dealing transaction. The structure of the deed was also undefined and it remained unclear which assignees were to receive which rights from which assignors.

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If the deed involved a large number of individual transfers of rights, the necessary individual transfer deeds or contracts were lacking.

If, on the other hand, it is a collective deed or a collective contract, then, as there are only individual, unnumbered sheets at the end of the deed, each signed by only one company, the necessary collective deed signed by all assignors and assignees in one document is lacking. Furthermore, the authority of the subscribers to sign and thus the effective transfer of all rights in one document, which had not been signed jointly by all of them, was disputed. Assuming the (disputed) validity of the SPA, the buyer would have become the legal successor for the beverage business of the seller and its affiliated companies from the date of conclusion of the contract and this business would now continue to exist with the buyer. As a result, the assignors subscribing to the Deed would no longer have been authorized to sign for the respective assignor and thus would not have been entitled to the rights to be transferred. Which right is meant by the "English Law" referred to in clause 4.1 of the Global IP Assignment Deed remains unclear, even after the plaintiff's supplementary statements.

With regard to the further facts of the case and the dispute, reference is made to the content of the reciprocal reference is made to the writs of the parties and the Exhibits submitted by them as well as to the facts of the case and the grounds of the contested decision.

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**II.**

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The plaintiff's appeal is admissible, but is not successful on the merits.

## **A.**

The plaintiff did not challenge the District Court's judgment in its entirety, but rather filed an admissible appeal for the dismissal of the claims for compensation as well as, insofar as it concerns actions from the time before 27.12.2018, limited to information, accounting and damages (§§ 520 para. 3 no. 1, 528 Code of Civil Procedure (ZPO)). 74

The plaintiff's appeal, which is limited in this respect, is also admissible in other respects; in particular, the grounds of appeal satisfy the requirements of Section 520 (3) Code of Civil Procedure (ZPO). Since the plaintiff bases its appeal attack on a breach of the judicial duty to provide information pursuant to Section 139 Code of Civil Procedure Procedure, it was not only necessary to submit the corresponding procedural objection, but also to state what it would have submitted in the first instance in response to the missing information and that it cannot be ruled out that this submission would have led to a different decision by the court of first instance (Federal Supreme Court BGH, NJW 2016, 2890 para. 11; NJW-RR 2020, 573 para. 14; Musielak/Voit-Ball, 20th ed, § Section 520 para. 32). The plaintiff has done justice to this with its further submissions on the assignment of the claims of the former patentee to it and the corresponding offers of evidence. 75

## **B.**

The appeal remains unsuccessful on the merits. 76

### **1.**

The District Court rightly dismissed the complaint on the basis of the first instance submissions with regard to the claims for compensation as well as for information, accounting and damages for acts prior to December 27, 2018. This is because the plaintiff, which has the burden of presentation and proof in this respect in accordance with general principles of civil procedure, asserted its right to bring an action on the basis of an assignment of these claims by the former patent holder at first instance, but, following the defendant's denial, neither elaborated on this assertion nor offered evidence in this regard. 77

The plaintiff does not challenge this legal assessment, on which the District Court based its reasoning, in the appeal instance. In particular, it rightly does not assert that it benefits from a facilitation of presentation and/or proof with regard to the assignment of claims of the former patentee to it due to an indicative effect of the patent register, as can be considered for a period from the transfer of the patent according to the decision "Fräsverfahren" of the Federal Supreme Court (GRUR 2013, 713).

For the sake of clarity, the Senate assumes that the plaintiff has met its burden of proof for the assignment of the claims with the submission in the reply at first instance (p. 71 et seq. GA LG), but the defendants disputed this considerably in their writ of 20.09.2022 (p. 351 et seq. GA LG). Following the defendants' denial, it was incumbent on the plaintiff to substantiate this claim in more detail - for example by submitting contractual documents - 78

and to offer evidence or, if it was able to do so, to name evidence immediately. However, it failed to do both, as the District Court correctly stated.

## 2.

A different assessment also does not result from the plaintiff's submission in the In the second instance of appeal, the applicant submits further details on the alleged assignment of the former patent proprietor's claims to it and offers evidence, submitting contractual documents. Both the factual submission and the offers of evidence are new means of attack within the meaning of Section 531 (2) Code of Civil Procedure (ZPO), for which there is no reason for admission. The only possible ground for admission of a procedural defect (Section 531 (2) sentence 1 no. 2 Code of Civil Procedure (ZPO)) due to an infringement of the duty to provide information pursuant to Section 139 Code of Civil Procedure (ZPO) does not exist. Contrary to the plaintiff's opinion, the District Court was not obliged to refer to the missing offers of evidence pursuant to Section 139 (1) or (2) Code of Civil Procedure (ZPO). The District Court also did not infringe the plaintiff's right to a fair hearing (Article 103 (1) of the German Constitution).

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Article 103 (1) of the Basic Law guarantees the parties to the proceedings that they have the opportunity to comment on the facts of the case before a court decision is made. However, this does not mean that a court must always inform the parties to the proceedings of how it is likely to assess the facts forming the basis of its decision. As a rule, it is sufficient if the factual and legal situation is discussed and the parties are thereby shown which aspects are likely to be of significance for the decision (Federal Supreme Court (BGH), decision of 19.01.2021, File no.: X ZB 14/19, GRUR-RS 2021, 3382 para. 11 - Laderaumabdeckung; Beschl. v. 16.02.2021, file no.: X ZR 144/18, GRUR-RS 2021, 3470 para. 4 - Personenrufsystem II; OLG Düsseldorf, judgment of June 1, 2021, file no.: I-15 U 27/20, GRUR-RS 2021, 63459 para. 83 - Luftfilter). However, a notice may be required if it is not foreseeable for the parties involved, even with careful conduct of the proceedings, on which considerations the court will base its decision (Federal Constitutional Court, NJW 2003, 2524; Federal Supreme Court BGH, GRUR 2013, 318 para. 10 - Sorbitol; GRUR 2014, 1235 para. 11 - Kommunikationsrouter; decision of 15.09.2020, file no.: X ZB 16/19, GRUR-RS 2020, 27434 para. 12 - Sortiervorrichtung). In principle, the duty to inform exists vis-à-vis a party represented by a lawyer in any case if the legal representative has clearly misjudged the legal situation (Federal Supreme Court (BGH), NJW 2002, 3317 (3320); decision of 18.05.2017, file no.: I ZR 178/16, GRUR-RS 2017, 126762 para. 12 - Glückskäse; Düsseldorf Higher Regional Court, judgment of June 1, 2021, file no.: I-15 U 27/20, GRUR-RS 2021, 63459 para. 84 - Luftfilter).

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In the case in dispute, the District Court was obliged to issue a notice in accordance with these principles not obliged to do so. The plaintiff had already been sufficiently informed of the factual and legal situation by the defendant's submissions, which is why in principle no indication was required (see a) below). The court also did not create a situation of trust on the basis of which, by way of exception, a reference would nevertheless have been necessary (see b) below). Finally, a different assessment is not required because the District Court's decision was issued in written proceedings pursuant to Section 128 (2) Code of Civil Procedure (ZPO) (see c) below).

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### a)

A reference by the District Court was in principle not required because the plaintiff was sufficiently informed of the need to submit evidence for its submission on an assignment of the claims of the former patentee on the basis of the defendant's submissions.

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aa)

A judicial reference pursuant to Section 139 (1) Code of Civil Procedure (ZPO) is not required if the affected party was correctly informed of the factual and legal situation as a result of a detailed submission by the opposing party that it had correctly understood (Federal Supreme Court (BGH), NJW 2007, 759 (761); NJW-RR 2008, 581; NJW-RR 2010, 70 (70 f.); decision of 18.05.2017, file no.: I ZR 178/16, GRUR-RS 2017, 126762 para. 12 - Glückskäse; Düsseldorf Higher Regional Court, judgment of June 1, 2021, file no.: I-15 U 27/20, GRUR-RS 2021, 63459 para. 85 - Luftfilter). However, just as in the case of a misunderstood judicial reference (see Federal Supreme Court, NJW 2002, 3317 (3320)), the misunderstanding of a reference contained in the opposing party's submission leads to the need for clarification by the court in order to enable the party concerned to supplement its factual submission in a relevant manner (Federal Supreme Court, decision of 18.05.2017, file no.: I ZR 178/16, GRUR-RS 2017, 126762 para. 12 - Glückskäse). As a rule, it must be assumed that the party represented by a lawyer has understood an unambiguous submission, unless there are clear indications of insufficient comprehension (MüKo ZPO-Fritsche, 6th ed., Section 139 para. 45). The decisive factor is that it is obvious to the court that the party's legal representative has not correctly recorded the concerns of the opposing party (Federal Supreme Court, NJW 2001, 2548 (2549); NJW-RR 2004, 1247 (1248); NJW 2012, 3035 para. 8; MüKo Code of Civil Procedure (ZPO-Fritsche, 6th ed., Section 139 para. 43).

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bb)

Measured against this, based on the defendant's presentation in its writ of 20.09.2022 (p. 351 et seq. GA LG) no obligation of the court to provide information.

84

(1)

85

In the aforementioned writ, the defendants have not only claimed the assignment of - also A's earlier claims against the plaintiff; they also expressly referred to the lack of offers of evidence. The writ states under the heading

86

"Lack of active legitimacy of the plaintiff for asserted claims from assigned rights" in excerpt:

*"The plaintiff alleges sweeping, vague and without appropriate evidence (statement of claim and Reply) to be entitled to assert all rights and claims from assigned rights as its own rights in its own name. However, the plaintiff has not provided any evidence whatsoever of the assignment of third-party rights to the plaintiff, which it merely asserts in its writ. Neither is an assignment agreement submitted, nor are there any statements in the statement of claim regarding the content of an assignment agreement, apart from general and vague statements.*

87

*In particular, there is therefore a lack of evidence for the transfer of the own rights of the former patent holder A to the plaintiff for the period prior to the plaintiff's entry in the patent register. The plaintiff's statements in the reply and complaint in this regard are*

88

unsubstantiated, lack evidence and the plaintiff's entire submission in this regard is disputed.

...

Therefore, if the patent in suit is transferred, as in the present case, the plaintiff must prove that the transfer agreement makes special provisions for compensation and also clearly regulates who may assert rights for the period prior to registration of the new owner.

In the present case, the plaintiff's mere allegations without any evidence and the claims asserted by the former patentee, A, on the basis of assigned rights **do not give rise to any presumption of legitimacy of the entry in the patent register** on which the plaintiff could rely. During the period for which the plaintiff is asserting rights from assigned rights, the plaintiff was not registered as a patent holder in the patent register. Thus, an assignment of rights by A in relation to the period prior to the plaintiff's registration must be fully proven in the present case, which the plaintiff has deliberately omitted to do.

*(emphasis added in part)*

ITo the extent that the plaintiff states in the grounds of appeal that the defendant's writ lacked any further argumentation and that it was not argued that the "milling procedure" case law was not applicable, this does not apply. The fact that the defendants do not differentiate between the period between the alleged transfer of the patent and the transfer in the patent register (27.12.2018 to 23.04.2019) on the one hand and the period before the alleged transfer (up to and including 26.12.2018) on the other hand and do not mention the "milling procedure" decision, which is not relevant for the latter period anyway, does not change the clearly recognizable denial of the assignment of those claims that arose before the alleged transfer of the patent. The defendants clearly refer to the entire period for which the plaintiff asserts claims, which easily includes the period prior to December 27, 2018. A "further argumentation" by the defendants was also not necessary for a substantial dispute. Since the assignment of claims of the former patentee concerns facts that are neither the defendant's own actions nor the subject of its own perception, the defendant's denial was, on a reasonable assessment, a declaration of ignorance. (Section 138 (4) Code of Civil Procedure (ZPO)). The admissibility of such a declaration excludes the obligation to provide a substantiated denial (Federal Supreme Court (BGH), NJW 2015, 468 para. 12).

The plaintiff's duty to observe the contents of the defendant's writ of 20.09.2022, it also does not change the fact that the defendants did not initially address the plaintiff's submission on the assignment of earlier claims in the writs following the reply, but only disputed this in the same writ of 20.09.2022 - possibly prompted by the Chamber's reference (see b) below). The denial of the assignment (or the corresponding declaration with ignorance) was procedurally admissible at this time; the plaintiff does not assert anything else.

(2)

That it was or should have been obvious to the District Court that the plaintiff's counsel misunderstood the defendant's instructions,

cannot be established. In fact, in its writ of October 6, 2022 (p. 366 f. GA LG), the plaintiff simply does not address the defendant's statements on the assignment of (also earlier) claims, but merely criticizes the defendant's denial of the transfer of rights as irrelevant when it states:

*"... The defendants fail to recognize that the submission in the reply of August 6, 2020, in which the transfer of the patent in suit and the rights arising from the patent to the plaintiff were presented, cannot simply be disputed (or even denied with ignorance) according to Federal Supreme Court BGH GRUR 2013, 713 - Fräsverfahren. "Blanket, vague and without suitable evidence" (writ of 20.09.2022, p. 3) is not the submission here, but the unsubstantiated and thus irrelevant denial of the defendant in the present case. The submission of transfer documents is therefore not appropriate in the present case. ..."*

97

From the District Court's perspective, this submission does not allow the conclusion that the defendant's statements were taken note of by the plaintiff's legal representatives, but were misunderstood in legal terms.

98

Insofar as a legal misunderstanding in the written appeal submission is initially seen in the fact that the plaintiff assumed that the presumption of registration according to the "milling procedure" extends to the present facts (para. 4, p. 360 E-file OLG), this does not justify a duty to provide information. According to the principles described above, it is not the legal understanding of the party itself that is decisive, but that of its legal representative. In any case, the District Court could not have recognized from the aforementioned writ that the lawyer experienced in patent law and working in a specialized law firm, who signed the writs in question, was allegedly in a legal error about the fact that the assignment of claims up to the transfer of the patent in suit must be presented and proven according to the usual standards of civil procedure.

99

In the oral hearing before the Senate on November 2, 2023, this same lawyer from the law firm of the plaintiff's legal representatives no longer claimed such a misunderstanding on his part. Rather, he recognized his decisive error in the fact that he had assumed that the defendant's denial in its writ of 20.09.2022 was too general and therefore procedurally irrelevant. In the oral hearing, he gave the reasons for this in particular by stating that, in his view, it was not a denial with ignorance, but rather a blanket denial - which, in his legal opinion, was irrelevant - which had become clear in particular through the reference to the statement of defence. A misunderstanding in this respect on the part of the plaintiff's legal representatives, for example to the effect that a denial cannot be understood as a declaration with no knowledge even if the requirements of Section 138 (4) Code of Civil Procedure (ZPO) are met without an explicit designation, was in any case not recognizable or even obvious to the District Court. Since the plaintiff's writ of 6 October 2022 states that her determined submission from the reply "cannot simply be denied (or even denied with ignorance)", the District Court rather had to assume that the undersigned lawyer had recognized the possibility of interpreting the denial as a declaration with ignorance.

100

b)

A different assessment of the duty to inform does not arise because the court would have created a situation of trust from which it could not deviate without further information.

aa)

According to Section 139 Code of Civil Procedure (ZPO), a court may be obliged to give notice to one or both parties if it has changed its specific legal opinion on a question of fact or law that is relevant to the parties and their procedural situation (Federal Supreme Court, GRUR 2011, 851 para. 12 et seq. - Werkstück; decision of October 25, 2011, file no.: X ZR 3/11, BeckRS 2011, 25938 para. 10; MüKo ZPO- Fritsche, 6th ed, § Section 139 para. 43). For example, the court can create a situation of trust that triggers a duty to provide information by indicating its legal opinion by means of clearly formulated information and by wanting to deviate from it (Federal Constitutional Court BVerfG, NJW 2021, 2581 para. 13; NJW 2003, 3687; Federal Supreme Court BGH, NZG 2020, 317 para. 7; BeckOK Code of Civil Procedure-von Selle, Stand: 01.09.2023, Section 139 para. 39) or if it wishes to dismiss the complaint as inconclusive after it has indicated by ordering the taking of evidence that it considers the complaint to be conclusive (OLG Saarbrücken, MDR 2003, 1372, BeckOK ZPO-von Selle, version: 01.09.2023, Section 139 para. 39). A judicial indication that the court no longer intends to adhere to a legal opinion relevant to the decision may also be required if the court has taken this legal opinion in a previous legal dispute between the parties and a party in another legal dispute between the parties, recognizable to the court, assumes that the court will not take a different view in these proceedings either (Federal Supreme Court, NZG 2020, 317 para. 7).

bb)

Neither the District Court's reference of August 24, 2022 nor the earlier judgment of the same Chamber of the District Court in parallel proceedings give rise to any legitimate expectations in this sense. 103

The District Court's notice of 24.08.2022 could not justify any trust on the part of the plaintiff, if only because this notice was issued on the basis of a different procedural situation. It was only *after* the notice, namely in the aforementioned writ of 20/09/2022, that the defendants disputed the plaintiff's submissions in the reply. There is no need to discuss in more detail whether, due to the defendants' denial in the statement of defence, the assignment of claims that had already arisen before the transfer of the patent in suit - as part of the corporate transaction between A and C - mentioned only in the reply could also be regarded as disputed. In any case, the District Court clearly did not assume this at the time of the reference decision, which is also fully consistent with the Chamber's earlier judgment cited by the plaintiff. 104

That earlier judgment of the 4a Civil Chamber of the District Court in a legal dispute between the plaintiff and other defendants, in which, however, the defendant 1) here was involved as an intervener (final judgment of 25.11.2021, file no.: 4a O 9/20, Exhibit WKS 3), indicated that the award of the claims from assigned rights was based on the assumption that the plaintiff's submissions were not sufficiently disputed and thus acknowledged by the defendants there. 105



It states on p. 17:

*"... The agreement regarding the transfer of the relevant property rights with the simultaneous transfer of all previous claims of A to the individual A companies to be taken over by C was then made as part of a separate contractual arrangement dated 27.12.2018. The defendants no longer contested this. ..."* 106

Even if the corresponding statements of the District Court are embedded in a discussion of the presentation requirements for a substantive legal situation deviating from the status of the register after "milling proceedings", it can be inferred from the judgment that the award of these claims is based on a lack of denial by the defendant and not on a - legally erroneous - extension of the indicative effect of the patent register to the assignment of earlier claims. Therefore, there are no reasons to rely on such a legal opinion of the District Court, irrespective of whether reliance on the recurrence of a legal error could be justified at all. Contrary to the plaintiff's view, the defendant's submission in the earlier proceedings, as presented by the plaintiff in Exhibit WKS 2, was not comparable to that in the present proceedings. For while in the earlier proceedings no further submission was made in response to the plaintiff's reply, in which the assignment of earlier claims was also set out for the first time, the defendants in the present proceedings still submitted the writ of September 20, 2022, which has already been discussed, and disputed the assignment of claims of the former patentee. 107

c)

Finally, a different assessment of the duty to provide information does not follow from the fact that the District Court's decision was made in the written procedure ordered with the consent of the parties pursuant to Section 128 (2) Code of Civil Procedure (ZPO) and that the plaintiff had already given its consent at the time of the defendant's writ. The plaintiff would have had the opportunity to supplement its own submission and offer evidence until the time corresponding to the conclusion of the oral hearing, October 6, 2022. 108

In fact, it also submitted a writ within this period but, as explained above, did not address the defendant's submissions in detail. If it had deemed it necessary, it would also have been free to revoke its consent in view of the defendant's denial pursuant to section 128 sentence 1 ZPO. 2 sentence 1 Code of Civil Procedure (ZPO) due to a significant change in the procedural situation. This may include, in particular, amended substantive motions and significant new allegations and evidence (Musielak/Voit- Stadler, 20th ed, § Section 128 para. 14; see also Federal Supreme Court (BGH), decision of 23.09.2020, file no.: XII ZR 86/18, BeckRS 2020, 3124 para. 14 on a revocation of the consent to the decision by the single judge in the appeal instance, to which Section 128 (2) sentence 1 Code of Civil Procedure (ZPO) is applicable accordingly) and thus also the defendant's specific denial without further ado.

Contrary to the plaintiff's opinion, there is also no increased need for instructions in written proceedings due to the lack of an oral discussion. The Code of Civil Procedure does not contain any indications for such a differentiation. Moreover, even if an oral hearing had been held, there would have been no procedural need to discuss certain points if there was no obligation to provide information. 109

### III.

The decision on costs follows from Section 97 (1) Code of Civil Procedure (ZPO). 110

The orders for provisional enforceability are based on Sections 708 No. 10, 711 Code of Civil Procedure (ZPO). 111

There was no reason to grant leave to appeal because the requirements set out in Section 543 of the Code of Civil Procedure (ZPO) are clearly not met. This is purely an individual case decision of no fundamental importance, which does not have to be referred to the Federal Supreme Court in the interests of further developing the law or ensuring uniform case law (Section 543 (2) Code of Civil Procedure (ZPO)). 112

Dr. X	Dr. Y	Dr. Z	113
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