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Decision date:	November 22, 2023
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Law applied:	§ Section 140a (3) PatG

Guiding Principles:

1. The complete physical destruction of a directly infringing product cannot be demanded if it is disproportionate. This comes into consideration in particular if the patent-infringing condition can be eliminated in another way, e.g. by a modification.

2. As part of the required overall balancing of interests, not only the interests of the infringer, but also the interests of the (different) owner as well as general prevention and the sanction intended by the destruction must be taken into account. Weighing up all the circumstances, ordering destruction by means of destruction may be disproportionate due to the patent-free solution that can easily be implemented by means of a software update on the one hand and the considerable value of the attacked overall device on the other, given average culpability and sufficient general prevention and sanction.

3. The fact that the infringer is permitted to modify (here software update) the infringing objects into a patent-free design instead of destroying them in the sense of destruction does not mean that the same restriction would generally be justified and must be applied in the case of a recall pursuant to Section 140a (3) PatG (German Patent Act). Rather, even if a change to a part of the overall device already irreversibly results from the patent infringement, the claim may nevertheless exist without restriction if its patent-compliant design was the reason for the sale of the object and the infringer would then retain the customer base, which it owes largely to the patent infringement, by supplying the alternative technology.

4. The order for destruction by way of "conversion" can be made by handing the property over to the bailiff and carrying out the act with the bailiff and under his/her supervision.

Course of proceedings:

preceding District Court Mannheim, April 30, 2021, 7 O 2/20

Sentence

1. On appeal by the defendants nos. 2 and 3, the judgment of the Mannheim District Court of April 30, 2021 - 7 O 2/20 - is amended, upholding the decision on costs (item IV) and dismissing the remainder of the defendants' appeal in item I.4 is amended so that after the words "at its own expense" the following is added: "to be handed over to a bailiff, where and under whose supervision the infringing parts are disassembled/removed and

destroyed/deleted by the bailiff at the expense of the respective defendant by employees of the respective defendant or other third parties commissioned by the defendant, whereby the devices modified in this way are handed back to the respective defendant." and the rest of item I.4 is deleted, and the further action in this respect is dismissed.

2. The defendants are ordered to pay the costs of the appeal proceedings.

3. This judgment and - insofar as it is upheld - the judgment of the District Court referred to in item 1 are provisionally enforceable.

The defendants may avert enforcement by providing security or depositing security in the amount of € 250,000 per defendant with regard to injunctive relief, destruction and recall, in the amount of € 25,000 per defendant with regard to information and accounting and in the amount of 110 % of the amount enforceable on the basis of the judgments with regard to costs, unless the plaintiff provides security in the amount of 110 % of the amount to be enforced in each case prior to enforcement.

4. The appeal is not permitted.

Reasons

I.

1 The plaintiff claims against the defendants for alleged direct and indirect, literal patent infringement for injunctive relief, information and accounting as well as - the defendants nos. 2 and 3 - for destruction and recall of distributed items and seeks a declaration of an obligation to pay damages and compensation.

2 The complaint is based on the German part of the European patent EP 2 213 273 (patent in suit), which was filed on January 19, 2010, claiming priority from February 2, 2009. The application of the patent in suit was published on August 4, 2010; the publication of the mention of the grant of the patent took place on July 27, 2016. The patent in suit is in force. In response to the opposition, the Opposition Division at the European Patent Office issued an interlocutory decision on October 23, 2018 (see Exhibit [...]3). The appeals of both parties (opponent and patent owner) against the decision were rejected by decision of March 10, 2022 (T 2729/18, Annex [...] 39). The claims based on the parallel utility model DE 20 2009 001 238 were separated by the District Court by decision of August 19, 2020. The District Court ruled on these in its judgment of June 11, 2021 (7 O 94/20) and largely upheld the complaint. The defendant's appeal was unsuccessful (judgment of the Senate of November 9, 2022 - 6 U 182/21. The patent claims 8 and 1 asserted in the present infringement dispute with the main request in the version of the interim decision of the Opposition Division (hereinafter: patent claims in suit) have the following wording in the procedural language (without reference signs):

3 Claim 8:

4 "Apparatus for treating the human or animal body by a mechanical pressure wave:

5 a pressure gas supply device for producing gas pressure pulses repeated with a frequency,

6 a striking element to be accelerated by a pressure gas pulse of the pressure gas supply device,

7 an impact body to be struck by the accelerated striking element in order to receive an impulse therefrom for producing a pressure wave,

8 and a device for setting a pressure value of the pressure gas pulses;

9 characterized by a device for automatically selecting from a table memorized in the apparatus and setting the time duration of the pressure gas pulses and in that said apparatus is adapted for the method of one of the preceding claims."

10 Claim 1:

11 "Method for setting a pressure gas application duration of an apparatus for treating the human or animal body by a mechanical pressure wave,

12 said apparatus comprising:

13 a pressure gas supply device for producing gas pressure pulses repeated with a frequency,

14 a striking element to be accelerated by a pressure gas pulse of the pressure gas supply device,

15 an impact body to be struck by said accelerated striking element to thereby receive an impulse therefrom for producing the pressure wave,

16 and a device for setting a pressure value of the pressure gas pulses;

17 characterized in that the apparatus

18 comprises a device for automatically selecting and setting the time duration of the pressure gas pulses and

19 in that, in the setting method, preset time duration values for respective pressure values are automatically selected and set corresponding to the preset pressure values from a table memorized in the apparatus by the device for automatically selecting and setting the time duration of the pressure gas pulses."

20 The plaintiff is the original applicant and owner of the patent in suit; as such, it is registered in the register kept at the German Patent and Trademark Office.

21 The defendants are competitors of the plaintiff. They sell medical devices for pressure wave treatment in Germany, including via online stores. According to the plaintiff's statement at the oral hearing before the District Court on March 19, 2021, the complaint is finally directed solely against the control units and handpieces sold in the following combinations (as a combination uniformly: contested embodiment(s)) as well as individually

(emphasis of the abbreviations below by the Court):

22 - Control unit "[AA1]" with handpiece "[HS1]";

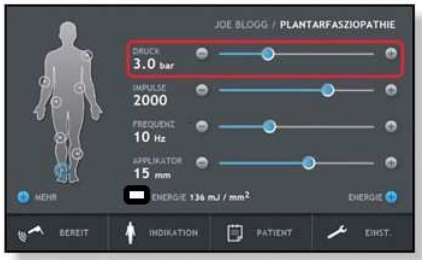
23 - Control unit "[AA2]" with handpiece "[HS1]";

24 - Control unit "[AA2]" with handpiece "[HS2]";

25 - Control unit "[AA2]" with handpiece "[HS3]".

26 The control units "[AA1]" and "[AA2]", with regard to the design of which reference is also made to Exhibits [...]14-16 and [...]18-19, comprise the compressed air supply required for the embodiments addressed and enable the user to set a pressure value, as shown below by way of example on the user interface of the control unit "[AA1]" (Fig. 1; red border added) and the control unit "[AA2]" (Fig. 1; red border added). (Fig. 1; red border added) and the control unit "[AA2]" (Fig. 2; red border added):

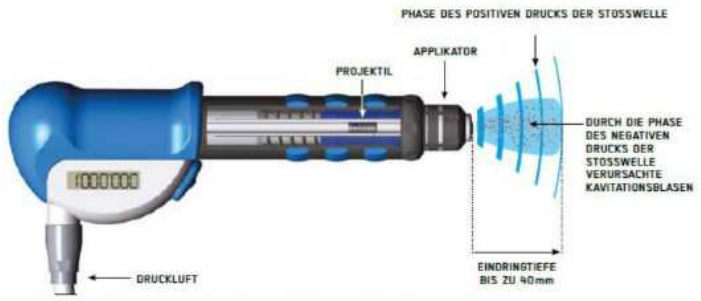
27 1. (Fig. 1)



28 2. (Fig. 2)

29 The handpieces "[HS1]", "[HS2]" and "[HS3]" contain a projectile (striking element) which can be accelerated by compressed air and an applicator (impact body) which is hit by the projectile (striking element) accelerated by compressed air and can thereby take over an impulse for producing the pressure wave. By way of illustration, reference is made to the following figure (Fig. 3) used by the defendants to illustrate the product range:

30 3. (Fig. 3)



31 According to the defendant's uncontradicted submission, the control units "[AA1]" and "[AA 2]" automatically set a time duration value depending on the set pressure value, which affects the duration of the compressed gas pulse, but is not identical to it. Rather, the time duration value relates to the duration between the time of detection of the complete opening of the compressed air valve and the time of the signal to close the compressed air valve, i.e. it corresponds to the duration during which the compressed air valve is completely open. The time duration value does not include the time that the valve requires to open fully in response to the opening signal, nor the time that elapses between the signal to close and full closure.

32 The plaintiff argued:

33 The contested embodiments realized the technical teaching of claim 8. The combined control units and handpieces were therefore means within the meaning of Sec. 10 (1) German Patent Act (PatG). It argued that setting the time duration value in the contested embodiments corresponds to selecting and setting the time duration of the compressed gas pulses within the meaning of features 8.6 and 8.7. in conjunction with 1.7. Based on its measurement results for the contested embodiments and the reference to the common use of look-up tables, the plaintiff claimed that the time duration values were memorized for the respective pressure values in a table stored in the respective control unit.

34 The claims to which the plaintiff is entitled due to direct and indirect patent infringement are not time-barred. It had only become aware in 2016 - after carrying out a series of tests and in view of the measurement results taken from this regarding the valve opening time - that the contested embodiments made use of the subject matter of the patent in suit. The complaint received by the Court on December 30, 2019 suspended the statute of limitations.

35 The plaintiff finally r e q u e s t e d:

36 I. The defendants are ordered:

37 1. to refrain from doing so under penalty of a fine of up to € 250,000 to be determined by the Court for each case of infringement - or, alternatively, imprisonment for up to six months or, in the event of repeated infringements, up to a total of two years, whereby the imprisonment is to be enforced on the respective legal representative,

38 to offer, place on the market or use in the Federal Republic of Germany or to import or possess for the aforementioned purposes

39 a) Apparatus for treating the human or animal body by a mechanical pressure wave, comprising a pressure gas supply device for producing gas pressure pulses repeated with a frequency, a striking element to be accelerated by a pressure gas pulse of the pressure gas supply device, an impact body to be struck by the accelerated striking element in order to receive an impulse therefrom for producing the pressure wave, and a device for setting a pressure value of the pressure gas pulses, characterized in that the apparatus comprises a device for automatically selecting from a table memorized in the apparatus, and setting the time duration of the pressure gas pulses, and in that said apparatus is adapted for a method for setting a pressure gas application duration of an apparatus for treating the human or animal body by a mechanical pressure wave, in which, in the setting method, preset time duration values for respective pressure values are automatically selected and set corresponding to the preset pressure values from a table memorized in the apparatus,

40 (Direct infringement of EP 2 213 273 B1, claim 8 in conjunction with claim 1, in each case as amended after the interlocutory decision of the Opposition Division);

41 (with regard to the sub-claims, reference is made to the reproduction of the requests in the judgment of the District Court)

42 b) to offer and/or supply handpieces suitable for devices in accordance with item I.1.a) to third parties in the Federal Republic of Germany,

43 *without pointing out in the event of an offer that the handpiece may not be used without the consent of the plaintiff as the owner of the German part of the European patent EP 2 213 273 for devices for treating the human or animal body with the features mentioned above under a), whereby in the case of a written offer the advice on the first page of the offer must be highlighted in print, set off from the rest of the text and in bold type, whereby the font size must be larger than the other maximum font size of the offer, in the case of delivery, to impose on the customers the written obligation not to use the handpiece for devices for treating the human or animal body with the features mentione d above under a), subject to a contractual penalty to be paid to the plaintiff for each case of non-compliance, to be determined by the* plaintiff *at its own discretion and to be reviewed by the District Court Mannheim;* in the alternative with a warning advice as granted; by "in particular requests" as in a) above;

44 c) Control devices with pressure pulse generation that are suitable for devices pursuant to item I.1.a) *to offer and/or deliver to third parties in the Federal Republic of Germany;*

45 *in the alternative:*

46 *without pointing out in the event of an offer that the handpiece may not be used without the consent of the plaintiff as the owner of the German part of the European patent EP 2 213 273 for devices for treating the human or animal body with the features mentioned above under a), whereby in the case of a written offer the advice on the first page of the offer must be highlighted in print, set off from the rest of the text and in bold type, whereby the font size must be larger than the other maximum font size of the offer, in the case of delivery, to impose on the customers the written obligation not to use the handpiece for devices for treating the human or animal body with the features mentioned above under a), subject to a contractual penalty to be paid to the plaintiff for each case of infringement, to be determined by the plaintiff at its own discretion and to be reviewed by the District Court Mannheim;*

47 further in the alternative:

48 without pointing out in the event of offering and in the event of delivery that the hand-piece may not be used without the consent of the plaintiff as the owner of the German part of the European patent EP 2 213 273 for devices for treating the human or animal body with the features mentioned above under a),

whereby in the case of a written offer the advice must be on the first page of the offer and in the case of delivery on the packaging and the housing, and the advice must be highlighted in each case, set off from the rest of the text and in bold type, whereby the font size must be larger than the other maximum font size; by *"in particular requests"* as in a) above;

49 2. in the alternative to 1:

50 to refrain from doing so under penalty of a fine of up to € 250,000 to be determined by the court for each case of infringement - or alternatively imprisonment for up to six months, in the event of repeated infringements up to a total of two years, whereby the imprisonment is to be enforced on the respective legal representative,

51 to offer, place on the market or use in the Federal Republic of Germany or to import or possess for the aforementioned purposes;

52 a) Apparatus for treating the human or animal body by a mechanical pressure wave, comprising a pressure gas supply device for producing gas pressure pulses repeated with a frequency, a striking element to be accelerated by a pressure gas pulse of the pressure gas supply device, an impact body to be stuck by the accelerated striking element while receiving an impulse therefrom for producing a pressure wave, and a device for setting a pressure value of the pressure gas pulses, characterized by a device for automatically selecting and setting the time duration of the pressure gas pulses, and in that said apparatus is adapted for a method of setting a pressure gas impact time of an apparatus for treating the human or animal body by a mechanical pressure wave, in which preset time duration values for respective pressure values corresponding to set pressure values are automatically selected and set by the device for automatically selecting and setting the time duration of the pressure gas pulses in the setting method,

53 (Direct infringement of EP 2 213 273, claim 9 in conjunction with claim 1, each as granted)

54 especially if the selection of the time duration values is performed from a table memorized in the apparatus;

55 (Direct infringement of EP 2 213 273, claim 9 in conjunction with claim 2, each as granted)

56 and/or

57 the time duration values are set such that only one collision of the striking element onto the impact body occurs per pressure gas pulse;

58 (Direct infringement of EP 2 213 273, claim 9 in conjunction with claim 3, each as granted)

59 and/or

60 the apparatus is constructed such that the striking element displaces air in front thereof along a path of its acceleration and thereby presses said air into a counter-pressure chamber in which a counterpressure is caused, for returning the striking element along said path;

61 (Direct infringement of EP 2 213 273, claim 9 in conjunction with claim 4, each as granted)

62 and/or

63 the impact body is elastically mounted, in particular via at least one elastomer ring, so that it can be displaced by an impulse transfer from the striking element;

64 (Direct infringement of EP 2 213 273, claim 9 in conjunction with claim 6, each as granted)

65 and/or

66 the apparatus comprises a catching device for catching the striking element in case of triggering the acceleration thereof while the impact body is dismounted, in particular in the implementation of a tapering at an end of the impact body's side of a tube portion for accelerating the striking element;

67 (Direct infringement of EP 2 213 273, claim 9 in conjunction with claim 8, each as granted)

68 b) to offer and/or supply handpieces capable for devices in accordance with item I.2.a) to third parties in the Federal Republic of Germany,

69 without pointing out in the event of an offer that the handpiece may not be used without the consent of the plaintiff as the owner of the German part of the European patent EP 2 213 273 for devices for treating the human or animal body with the features mentioned above under a), whereby in the case of a written offer the advice must be highlighted in type on the first page of the offer, set off from the rest of the text and in bold type, whereby the font size must be larger than the other maximum font size of the offer, in the case of delivery, to impose on the customers the written obligation not to use the handpiece for devices for treating the human or animal body with the features mentioned above under a), subject to a contractual penalty to be paid to the plaintiff for each case of infringement, to be determined by the plaintiff at its own discretion and to be reviewed by the District Court Mannheim;

70 in the alternative:

71 without pointing out, in the event of an offer and in the case of delivery, that the handpiece may not be used without the consent of the plaintiff as the owner of the German part of the European patent EP 2 213 273 for devices for treating the human or animal body with the features mentioned above under a), whereby in the case of a written offer the advice must be on the first page of the offer and in the case of delivery on the packaging and the housing and the advice must be highlighted in each case, set

off from the rest of the text and in bold type, whereby the font size must be larger than the other maximum font size; by "in particular requests" as in a)above;

72 c) to offer and/or supply to third parties in the Federal Republic of Germany control devices with pressure pulse generation that are capable for devices pursuant to item I.2.a)

73 in the alternative:

74 without pointing out in the event of an offer that the handpiece may not be used without the consent of the plaintiff as the owner of the German part of the European patent EP 2 213 273 for devices for treating the human or animal body with the features mentioned above under a), whereby in the case of a written offer the advice must be highlighted in type on the first page of the offer, set off from the rest of the text and in bold type, whereby the font size must be larger than the other maximum font size of the offer,

75 in the case of delivery, to impose on the customers the written obligation not to use the handpiece for devices for treating the human or animal body with the features mentioned above under a), subject to a contractual penalty to be paid to the plaintiff for each case of infringement, to be determined by the plaintiff at its own discretion and to be reviewed by the District Court Mannheim;

76 further in the alternative:

77 without pointing out in the event of the offer and in the case of delivery that the handpiece may not be used without the consent of the plaintiff as the owner of the German part of the European patent EP 2 213 273 for devices for treating the human or animal body with the features mentioned above under a), whereby, in the case of a written offer, the advice must be on the first page of the offer and, in the case of delivery, on the packaging and the housing, and the advice must be highlighted, set off from the rest of the text and in bold type, whereby the font size must be larger than the other maximum font size; by "in particular requests" as in a) above;

78 3. to provide the plaintiff with information, submitting a uniform, chronologically ordered list, and to provide an account of the extent to which they (the defendants) have committed the acts described under I.1. and I.2. since September 4, 2010, stating

79 a) the quantity of the products received or ordered, the names and addresses of the manufacturers and suppliers and other previous owners, in particular transportation and storage companies), as well as the prices paid,

80 b) the individual deliveries and orders, broken down by delivery and order quantities, times and prices and the respective type designations as well as the names and

addresses of the commercial customers and sales outlets for which the products were intended,

81 c) the individual offers, broken down by offer quantities, times, prices and the respective type designations, as well as the names and addresses of the offer recipients,

82 d) the advertising operated, broken down by advertising media, their circulation, distribution period and distribution area, in the case of advertising on the Internet, the Internet address, the number of hits/click rates and the duration of the respective advertising campaign/placement periods,

83 e) the costs broken down according to the individual cost factors and the profit generated,

84 whereby

85 - the disclosures under e) have only been required since August 27, 2016,

86 - those suppliers and customers who have used the devices described under I.1.b) and c) or I.2.b) and c) in accordance with the patent in suit must be specifically identified,

87 - the defendants must submit supporting documents (invoices, delivery bills, copies if necessary) with regard to the information under a) and b), whereby details requiring secrecy outside the data subject to disclosure may be blacked out,

88 - the defendants reserve the right to disclose the names and addresses of their offerees instead of the plaintiff to a sworn auditor domiciled in the Federal Republic of Germany to be designated by the plaintiff and bound to secrecy vis-à-vis the plaintiff, provided that the defendants bear the auditor's costs and authorize and oblige him to inform the plaintiff upon specific request whether a particular customer or offeree is included in the list;

89 4. only the defendants nos. 2 and 3: to destroy at their (the defendants nos. 2 and 3) own expense the devices referred to in I.1.a) and c) and I.2.a) and c) in their direct or indirect possession and/or ownership in the Federal Republic of Germany or, at their discretion, to hand them over to an executor to be appointed by the plaintiff for the purpose of destruction at their (the defendants nos. 2 and 3) expense;

90 5. to recall the devices referred to under I.1.a) and I.2.a), which have been placed on the market since July 27, 2016, with reference to the judicially ("judgment of the District Court of Mannheim of ...") determined infringing condition of the item 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 successfully recalled products;

91 II. it is determined that the defendants are obliged,

92 1. to pay the plaintiff appropriate compensation for the acts referred to in item I.1.a) committed in the period from September 4, 2010 up to and including July 26, 2016;

93 2. to surrender to the plaintiff, in accordance with the provisions on the restitution of unjust enrichment, that which the defendants obtained at the plaintiff's expense thro ugh the acts described under I.1.a) committed in the period from July 27, 2016 to Au gust 26, 2016;

94 3. to compensate the plaintiff for all damages that the plaintiff has suffered and will suffer as a result of the acts referred to in section I.1 committed since August 27, 2016.

95 The defendants have **r e q u e s t e d** ,

96 to dismiss the complaint.

97 The defendants have argued that the contested embodiment is not a product which is the subject-matter of claim 8 of the patent in suit. Features 8.6 and 8.7 in conjunction with 1.7 were not realized. Since the time duration value set by the respective control unit s of the contested embodiment does not take into account the opening and closing time of the valve and is therefore not identical to the time duration of the gas pressure pulse itself, the technical teaching of the patent in suit is not complied with. In addition, the plaintiff was making an empty claim when it asserted that the time duration values in the contested embodiment originate from a table memorized in the device. After all, the value s could also be calculated using a stored functional relationship.

98 The defendants have also raised the plea of the statute of limitations. They claim that claims arising up to 2016 are time-barred. The defendants claim that the plaintiff, as an immediate competitor, had been aware of the market launch of the accused embodiment and thus of the alleged patent infringement since 2013 at the latest. At the very least, the plaintiff was guilty of gross negligence with regard to any lack of knowledge. Even before 2016, it had been obvious to examine the contested embodiment to determine whether differently long pressurized gas pulses would result at differently set pressure values. Such measurements were also easy to carry out.

99 At the oral hearing, the plaintiff did not pursue the complaint further with regard to certain design forms, so that it was finally directed against the design form "[AA2]" with all hand-pieces as well as the control unit [AA1] with the handpiece [HS1] (minutes of March 19, 2021).

100 In the judgment under appeal, to whose findings of fact and grounds for decision reference is made, the District Court largely upheld the complaint - insofar as it was upheld - and set aside the costs. It held that the defendants infringed the patent in suit through the domestic distribution of the contested embodiments and the control units and handpieces suitable for combination in this respect. The contested embodiments are to be regarded as products which are the subject matter of the patent in suit. The control units [AA1] and [AA2] suitable for this purpose and the handpieces [HS1], [HS2]

and [HS3] are in turn means relating to an essential element of the invention of the patent in suit. Accordingly, the District Court found the defendants guilty of direct and contributory patent infringement largely as requested. With regard to the control unit [AA2], the requested prohibition per se was to be granted, since it could only be used in a technically and economically reasonable manner in a way that infringed the patent. With regard to the control unit [AA1] and the handpieces, the plaintiff could only demand a prohibition of offer and distribution without a respective warning relating to the patent in suit. Taking this into account, it ordered the defendants to cease and desist and their obligation to pay damages, compensation and restitution. The claims for information and accounting as well as for destruction were partially successful. Reference is also made to the District Court's ruling. The District Court's conviction was based on its opinion that the contested embodiments were also covered by features 8.6. and 8.7 in conjunction with feature 1.7. feature 1.7 in conjunction with feature 1.7. It was irrelevant under patent law that in the contested embodiments initially only a time value was used which corresponded to the time in which the valve was completely open. In view of the specific valve control, this time value represents the total opening time of the pressure valve and can be adjusted accordingly. The time duration of the pressure gas pulses according to claim 8 means the total opening time of the pressure valve, which, in addition to the time that the valve used is kept fully open, also includes the time that the valve used requires as a switching time for opening and closing. While the pressure value must be adjustable by the user as a parameter via the device according to feature 8.5, the time duration of the pressure gas pulses should be automatically selected and set as a parameter by means of the device according to feature 8.6, depending on the pressure value. For this automatism of setting the time duration depending on the set pressure value, optional or suitable duration values would be specified for the respective pressure values. Their determination is left to the discretion of a skilled person. Contrary to the defendant's view, the claim does not stipulate that the specified time duration value must be identical to the time duration of the pressure gas pulse to be ultimately set. Therefore, it does not lead out of the protected teaching if the total opening time of the pressure valve is not provided as a time duration value, but only the time duration in which the valve is fully open. The claims are not time-barred and the proceedings should not be suspended with regard to the opposition proceedings.

101 The defendants are appealing against the conviction. The defendants argue that the District Court recognized an infringement on the basis of an incorrect interpretation of the asserted property right. It is true that the District Court correctly referred to para. [0017] of the patent in suit, in which the "pulse durations" are the "valve opening times". However, it wrongly assumed that the time duration value merely had to represent the time duration of the pressure gas pulse, but not correspond to it. The wording of the claim distinguishes between the terms "time duration of the pressure gas pulses" and "duration value"; however, However, the skilled person would readily recognize from the matching word element "time duration" that the time duration of the pressure gas pulse refers to the actual opening time of the pressure valve and the time duration value refers to the value applicable to the time duration of the pressure gas pulse (compare the table in para. [0034] of the patent in suit, actual opening time of the pressure valve at a pressure of up to 1.0 bar 14 ms, time duration value 14ms). The predetermined time duration value should therefore be selected and set in such a way that the duration of the pressure gas pulses corresponds to this value. Contrary to the opinion of the District

Court, the skilled person would find this understanding confirmed in the description. For example, para. [0015] of the patent in suit referred to the complex relationships and the following paras. [0015] - [0017] explained the disadvantages that would arise if the time duration or pulse times/pulse duration were too long. This proves that, according to the teaching of the patent in suit, duration values must correspond to the time duration of the pressure gas pulses. This also follows from the wording in para. [0019] of the patent in suit, in which optimum pulse duration values or time values are first mentioned in order to then refer to longer or shorter times. From this, the skilled person would infer that the claimed time duration values of the time durations to be set are of the pressure gas pulses. The skilled person would infer the same from the wording in para. [0021] and para. [0034]. Contrary to the District Court's assumption, there is also a technical-functional argument in favor of this ratio: In para. [0020], the patent in suit referred to the fact that optimal time duration values for respective pressure values can be easily determined empirically. However, pressure valves not only had certain opening and closing times, but these also varied depending on the applied pressure and other operating conditions. If the optimum time duration values could also be determined empirically according to the teaching of the patent in suit, these would relate to the entire opening time of the pressure valve. According to the District Court, it is not apparent why the skilled person should recognize that it should not be necessary, depending on the control, to use a time duration value which includes the opening and closing time of the pressure valve, and in any case it is not claimed. The teaching of the patent in suit is subject to expert evidence. If the teaching of the patent in suit is correctly understood, there is no infringement.

102 In a writ of October 18, 2023, the defendants, not disputed by the plaintiff, argue that they now only offer modified embodiments and that they "therefore no longer have the contested embodiment in the contested configuration in their possession or ownership." Instead of a table, a function is now implemented in the control software of the devices which ensures that the required time duration value is calculated at the moment - and each time anew - when it is needed. From a legal point of view, the plaintiff believes that since it can implement this solution, which deviates from the doctrine of the patent in suit, in the 230 devices delivered by means of a software update by technical employees of the defendant no. 2 (the software control is not accessible to customers and consists of an encrypted machine code that cannot be used by third parties), a complete destruction or recall is disproportionate, also in view of the end customer price of the overall device of over € 10,000. In this context, the plaintiff does not dispute that the provision of a table for setting the duration of the compressed gas pulses in the control software of the contested embodiments was not known to their customers and could not be determined and therefore the existence of the table was not a decision criterion for the customers for the selection of the contested embodiments.

103 The defendants request,

104 on appeal by the defendants nos. 1-3 to amend the judgment under appeal and dismiss the complaint.

105 The plaintiff requests,

106 to dismiss defendant's appeal,

107 in the alternative, to dismiss the appeal with the proviso that the judgment of the District Court under I.4 is amended so that after the words "at its own expense" it is added "to be handed over to a bailiff, where and under whose supervision, at the expense of the respective defendant, the infringing parts are dismantled/ removed and destroyed/erased by the bailiff, whereby the devices modified in this way are handed back to the respective defendant." and the remainder of item I.4 is deleted.

108 The plaintiff defends the challenged judgment of the District Court by repeating and deepening its submissions at first instance. The wording of the claim already distinguishes between time duration values and time duration of the pressure gas pulses. The defendant's objection that both terms contain the word element "time duration" and therefore both terms refer to the same value, is incorrect. Furthermore, the descriptive passages of the patent in suit cited by the defendants (paras. [0015] - [0017]) offer no indication that the specified time duration value should be identical to the time duration of the pressure gas pulses. The above-mentioned descriptive passages are not concerned with how the device is controlled, but the technical relationship between pressure and time in the control of a valve is explained in an abstract manner without mentioning specific figures. Para. [0034] merely explains an example of implementation. Contrary to the defendant's view, the technical-functional understanding of the features also does not argue in favor of the restrictive interpretation advocated by the defendants. The patent in suit leaves the determination of the time duration values to the ability and discretion of skilled persons for the reasons stated therein. The patent description merely refers to the fact that the appropriate values can be determined approximately empirically, whereby a limited accuracy is acceptable. In these circumstances, the skilled person would recognize that the device for automatically selecting and setting the time duration of the pressure gas pulses does not necessarily have to be designed in such a way that a time duration value is set and selected which comprises the opening and closing time of the pressure valve used in each case. Rather, the patent in suit leaves this open; this applies in particular because the time required by the valve with certain pressure values to open or close can also be determined approximately empirically and therefore an actuation without taking this time into account also leads to expectable results. If correctly interpreted, the challenged embodiments infringe the patent in suit, since a time value is automatically selected and set which represents a duration during which the valve is fully open. Such a value represents the total opening time of the pressure valve, so that the contested embodiment is a device for automatically selecting and setting the time duration of the pressure gas pulses within the meaning of features 8.6 and 8.7 in conjunction with feature 1.7 of the patent in suit. feature 1.7 of the patent in suit.

109 Reference is also made to the exchanged writs and Exhibits as well as to the minutes of the oral hearing before the Senate on October 25, 2023.

II.

110 The defendant's admissible appeal is only successful to the extent stated in the operative part.

111 The District Court rightly upheld the complaint - insofar as a conviction to the detriment of the defendant was made - and assumed that the domestic distribution of the contested embodiments and the control units and handpieces suitable for combination in this respect infringed the patent in suit. The District Court correctly determined the scope of protection of the patent in suit to the effect that the asserted patent claims do not require that the specified time duration value must be identical to the "time duration of the pressure gas pulse" to be ultimately set. Therefore, it does not lead out of the scope of protection of the patent in suit if not the total opening time of the pressure valve (including the time required by the valve used as switching time for opening and closing) is provided as "time duration value", but - as the defendants assert with regard to their contested embodiments - only the time duration in which the valve is completely open.

112 The District Court therefore rightly assumed that the last embodiments contested are to be regarded as products which are the subject-matter of the patent in suit and that the control units "[AA1] and [AA2] suitable for these and the handpieces [HS1], [HS2] and [HS3] are in turn means which relate to an essential element of the invention of the patent in suit.

113 The interference with the patentee's right of use resulting from the domestic distribution of the contested embodiments as products without consent justifies the assumption of a direct patent infringement (Art. 64 EPC in conjunction with Section 9 sentence 2 no. 1 German Patent Act (PatG)). The domestic distribution of the suitable control units [AA1] and [AA2] as well as the handpieces [HS1], [HS2] and [HS3] as means relating to an essential element of the invention of the patent in suit justifies the allegation of contributory patent infringement (Art. 64 EPC in conjunction with Section 10 German Patent Act (PatG)). Since the claims are not time-barred for the reasons stated by the District Court, which are not contested on appeal, the patent infringement justifies the claims for injunctive relief, enrichment/compensation, the determination of liability for damages as well as claims for information and accounting and recall to the extent awarded by the District Court. However, on appeal by the defendants nos. 2 and 3, the order for destruction must be limited to the "conversion" described in more detail in the operative part of the judgment, to the extent that it is merely justified.

114 (1) The patent in suit relates to an apparatus for treating the human or animal body by mechanical pressure waves.

115 a) According to the patent in suit, such devices are already known per se. On the one hand, the intensity of the coupled pressure wave can be changed by adjusting a pressure value of a pneumatic supply device; the higher the pneumatic pressure applied, the more violently the striking element is accelerated and the greater the impulse and energy transfer to the impact body (see para. [0004]). On the other hand, many devices ensure that the repetition frequencies of pneumatic pulses can be adjusted (see para. [0005]).

116 The patent in suit sets itself the task of improving these devices with regard to parameter setting (see para. [0010]). On the one hand, the invention is based on the

knowledge that various advantages could be achieved with a parameter-dependent variable time duration of the pressure pulses (see para. [0014]). On the other hand, the invention takes into account that the optimum time duration of the pressure pulse in many devices shows a clearer dependence on the pressure than on the frequency (see para. [0026] in conjunction with para. [0020]). The basic relationship between the pressure values and optimum pulse duration values is essentially determined by the fact that at low pressure a longer time is required to supply sufficient air for acceleration, and at higher pressure values shorter times can and must be selected (see para. [0019]).

117 b) Against this background, the patent in suit - in the version already asserted in the infringement dispute at first instance after the interlocutory decision of the Opposition Division, which remained the same after the appeal decision - proposes, according to claim 1, a method for setting a pressurization time as a function of the pressure value and, according to claim 8 (in conjunction with claim 1), a device designed accordingly, the features of which can be structured synoptically in their correspondence with one another as follows:

118

8.1 Apparatus for treating the human or animal body with a mechanical pressure wave:	1.1 A method for setting a pressure gas application duration of an apparatus for treating the human or animal body by a mechanical pressure wave, comprising the apparatus:
8.2 / 1.2 a pressure gas supply device for producing gas pressure pulses repeated with a frequency,	
8.3 / 1.3 a striking element to be accelerated by a pressure gas pulse of the pressure gas supply device,	
8.4 / 1.4 an impact body to be struck by said accelerated striking element to thereby receive an impulse therefrom for producing the pressure wave, and	
8.5 / 1.5 a device for setting a pressure value of the pressure gas pulses,	
8.6 a device for automatically selecting from a table memorized in the apparatus and setting the time duration of the pressure gas pulses,	1.6 a device for automatically selecting and setting the time duration of the pressure gas pulses, and
8.7 wherein the apparatus is constructed for a method according to one of the preceding claims.	1.7 in the setting method, preset time duration values for respective pressure values are automatically selected and set corresponding to the preset pressure values from a table memorized in the apparatus by the device for automatically

	selecting and setting the time duration of the pressure gas pulses.

119 c) On the basis of the principles underlying patent interpretation, the following meaning is to be attributed to the protected combination of features - insofar as this is of interest for the legal dispute.

120 aa) The District Court correctly stated in the challenged decision that the scope of protection of the patent is determined by the claims in the relevant procedural language (Art. 69 (1), Art. 70 (1) EPC). In the interpretation of the claim required for the assessment of patent infringement, the meaning of the claim as a whole and the contribution of each individual feature to the overall performance result of the invention must be determined (see Federal Supreme Court, GRUR 2016, 1031, 1034 - Wärmetauscher). How the average person skilled in the art understands the combination of features of the claim is determined on the basis of the claim according to the technical context of its features, taking into account the description and drawings. By using the description for interpretation, it is ensured that the actual language usage of the patent is sufficiently taken into account. The skilled person is guided by the purpose of the features expressed in the patent specification, whereby the technical meaning of the words and terms used in the patent specification - not the philological or logical-scientific definition of the terms - is decisive, the patent specification represents its own lexicon, as it were (see Federal Supreme Court, GRUR 2002, 515, 517 - Schneidmesser I; Federal Supreme Court, GRUR 1999, 909, 912 - Spannschraube). The features and terms of the claim are to be interpreted as is appropriate in view of the technical function assigned to them according to the disclosed inventive concept (see Federal Supreme Court (BGH), GRUR 2009, 655, 656 - Trägerplatte).

121 The claim takes precedence over the description and the examples and the parts of the description relating to it. They may neither lead to an extension of the content nor to a restriction of the subject matter defined by the literal meaning of the claim. An interpretation beyond a more general meaning of the claims is generally not permissible (see Federal Supreme Court (BGH, GRUR 2004, 1023, 1024 - Bodenseitige Vereinzelungseinrichtung). At the same time, the patent specification must be read in a meaningful context and, in case of doubt, the claim must be understood in such a way that there are no contradictions with the statements in the description and the pictorial representations in the drawings (Federal Supreme Court, GRUR 2011, 701, 703 - Okklusionsvorrichtung). Only if and to the extent that the teaching of the patent claim cannot be reconciled with the description and the drawings and an irresolvable contradiction remains, those elements of the description that are not reflected in the patent claim may not be used to determine the subject matter of the patent (Federal Supreme Court, GRUR 2015, 972, 974 - Kreuzgestänge).

122 2. Based on these principles of interpretation, the District Court rightly assumed that the contested embodiments made direct and, to the extent mentioned above, indirect use of the teaching of claim 8 in conjunction with claim 1 by also realizing the feature of the "preset time duration value".

123 a) The realization of features 8.1, 8.2, 8.3, 8.4 and 8.5 (and the corresponding features 1.1, 1.2, 1.3, 1.4, 1.5) is not in dispute between the parties - without this being based

on misconceptions of patent law - and this assumption is not challenged in the appeal.

124 b) The appeal also does not challenge the District Court's assumption that in the contested embodiments the device is used for automatic selection from a table memorized in the device (part of feature 8.6. and 1.7). This must also be assumed in the appeal instance. The District Court based its decision on the fact that the plaintiff had effectively (and not in the blue) asserted that the pressure value-dependent time (duration) values were stored in a table memorized in the respective control unit and that the defendant had not effectively disputed the plaintiff's assertion. Rightly and without this being challenged by the defendant's appeal, the District Court then assumed that the plaintiff's submission was therefore to be regarded as admitted (Section 138 (3) Code of Civil Procedure (ZPO)).

125 c) The only question in dispute between the parties is therefore the understanding of the feature "[preset] time duration values" and whether this value must be identical with the "time duration of the pressure gas pulses" to be ultimately set, i.e. whether it is outside the scope of protection of the teaching if not the total opening time of the pressure valve, but only the time during which the valve is fully open, is held to be the "time duration value". The District Court assumed that it was sufficient if the "time duration value" represented the total opening time of the pressure valve as the "time duration of the pressure gas pulse". The defendants attack this understanding with their appeal without success.

126 aa) The parties and the District Court assume that the "time duration of the pressure gas pulse" must (precisely) include the time from the beginning of the opening to the complete closing of the valve (District Court Judgment (LGU) p. 19 below/20 above). It can be assumed in favor of the defendant in the present legal dispute that this specific understanding can be inferred from the feature (cf: Judgment of the Senate between the parties of November 9, 2022 - 6 U 182/21 p. 16 et seq.). This is advantageous for the defendants, because without this assumption, it would only be possible to infer from the claim (in the overall context) that the time duration value must in turn be selectable and adjustable in time intervals suitable for setting the time duration of the pressure gas pulses. Then there would be no reason at all to understand the claimed teaching according to the defendants, according to which the time duration value within the meaning of feature 1.7 would have to indicate exactly the time from the beginning of the opening to the complete closing of the valve.

127 bb) In determining the scope of protection without infringement of the law, the District Court came to the conclusion that the preset time duration values to be set need not be identical to the time duration of the pressure gas pulse.

128 (1) While the pressure value can be variably set by the user as a parameter via the device according to feature 8.5 (para. [0013]), according to the District Court, the time duration of the pressure gas pulses is to be selected and set "automatically" as a parameter by means of the device according to feature 8.6, depending on the pressure value (feature 8.7 in conjunction with feature 1.7: "according to the set pressure values"). The District Court correctly points out that when a pressure value is changed, the device automatically sets the time duration (see para. [0022]). For this automatism of setting the time duration depending on the set pressure value, according to the teaching of the patent in suit, optimum or suitable time duration values for respective pressure values are preset, i.e. determined and stored in the device of the apparatus for selection.

As the District Court points out, the patent in suit leaves it to the skilled person's ability and discretion to determine the time duration values.

129 (2) The District Court correctly stated that the wording of the claim does not support the defendant's assumption to the contrary. The term "time duration of the pressure gas pulses", which is to be equated with the total opening time in favor of the appeal, is not used in feature 1.7/8.6. Instead, the different term of time duration values is used. This initially rather speaks against the fact that the teaching is limited to a correspondence of the selectable and adjustable time duration values with the time duration understood as the total opening time. Insofar as the defendants in this context refer to the correspondence of the term "time duration", the skilled person recognizes that the wording of the claim distinguishes between the terms "time duration value" and "time duration of the pressure gas pulses", i.e. uses two different terms, and for this reason alone the conclusion suggests itself that these two terms refer to two different objects. The mere coincidence in one part of the word is not sufficient. The defendant's assumption that, because of the overlapping word component duration, it can be concluded that the preset time duration value must be selected and set in such a way that the time duration of the pressure gas pulses corresponds to this value, is therefore not correct.

130 (3) The description of the patent in suit does not support the defendant's understanding either. The description in para. [0015] explains the relationship between the time duration value and the pressure, i.e. the technical relationship between pressure and time when controlling a valve. The disadvantages of too short or too long time durations or pulse times/pulse durations are also explained. However, a connection between the time duration of the pressure gas pulses and the time duration values as understood by the defendant cannot be inferred from the descriptive passages. Contrary to the defendant's view, the skilled person will infer from the explanations in para. [0015] et seq. and also in para. [0019] that the time duration values according to the claim must correspond to the time duration of the pressure gas pulses to be set. The description of the embodiment example in para. [0034] cannot limit the claim, which is broader in its literal sense, to the embodiment example; a narrower understanding of the claim cannot be inferred solely from the explanations dealt with in the description (and/or drawings) (Federal Supreme Court (BGH) GRUR 2008, 779 para. 33 - Mehrgangnabe). Such statements regularly do not permit a restrictive interpretation of a patent claim generally characterizing the invention (BGHZ 160, 204 - Bodenseitige Vereinzelungsvorrichtung; BGHZ 172, 88 - Ziehmaschinenzugeinheit). There are no indications for a different understanding in the present case.

131 (4) The technical-functional understanding of the features does not support the defendant's view either. Evidence for the restrictive understanding, according to which the preset time duration value must be exactly identical to the duration of the pressure gas pulse, cannot be technically and functionally justified:

132 The patent in suit deals with a method or an apparatus realizing the method which, depending on the pressure value set by the user, automatically selects and sets time duration values with which the valve is actuated. This results in a certain opening time of the valve while the pressure gas pulse is maintained, which, according to the language of the patent in suit, represents the time duration of the pressure gas pulses.

The patent in suit leaves the setting of the time duration values to the ability and discretion of the skilled person. According to the patent in suit, the values can depend, among other things, on the geometric design of the respective device, but also on the switching valves used (paras.[0015], [0020]). According to the description, the appropriate values can be determined approximately empirically, whereby a limited accuracy should be acceptable (para. [0020]). The District Court (LGU 21, 3rd paragraph) correctly states that, in view of the circumstances that the question of how the pressure valves are to be controlled is left to the skill and discretion of the person skilled in the art and inaccuracies can be accepted, the device for automatically selecting and setting the time duration of the pressure gas pulses does not necessarily have to be technically and functionally designed in such a way that a time duration value is set and selected which includes the opening and closing time of the pressure valve used in each case. The skilled person will recognize that, depending on the control, it is not necessary to use such a time duration value in order to set the total opening time correctly. Rather - as the District Court has already explained - it may be sufficient, depending on the valve control system, to specify only the time of full valve opening as the value and apply it in the setting procedure. Insofar as the defendants state that the opening and closing times of the valve vary depending on the pressure applied, this does not contradict this technical-functional understanding. The skilled person can take this dependency into account when setting the time duration values, which can also be based on empirical determinations.

133 (5) Insofar as the defendants provide expert evidence of their skilled person's understanding of the teaching of the patent in suit, no expert opinion must be obtained. The interpretation of a patent is a question of law that must be made independently by the judge of fact and may not be left to the expert (BGHZ 164, 261 para. 19 - Seitenspiegel; BGHZ 171, 120 para. 18 - Kettenradanordnung; Federal Supreme Court (BGH) 172, 312 para. 38 - Zerfallszeitmessgerät; Federal Supreme Court (BGH) GRUR 2010, 317 para. 25 - Kettenradanordnung II; Federal Supreme Court (BGH) 186, 90 para. 15 - Crimpwerkzeug III). The Senate, which constantly deals with patent disputes, also does not need expert help to understand the terms used in the claim and forming the basis of the interpretation. Moreover, the technical basis of the patent in suit is not in dispute between the parties.

134 d) On the basis of this aforementioned interpretation of the complaint, the appeal does not attack in detail the District Court's assumption of direct and contributory patent infringement (LGU page 21 and LGU page 23). Reference is therefore made to the correct statements of the District Court.

135 3. Furthermore, the appeal does not challenge the District Court's assumption that the claims are not time-barred. Reference is made to the correct statements of the District Court (LGU pages 24-26).

136 4. The infringing acts established justify the claims awarded to the plaintiff by the District Court - except for the scope of the destruction order.

137 a) In this respect, too, the appeal does not (rightly) attack the merits and scope of the claims awarded to the plaintiff. Reference is made to the correct statements of the District Court (LGU pages 26 to 30) - insofar as they were found to be to the disadvantage of the

defendant and therefore reached the appellate instance - subject to the following statements on destruction. In the case of contributory patent infringement, the subjective elements of the offense are also fulfilled. It is obvious for the defendants - as the District Court states - that these control units and the handpieces are suitable for use in the combinations of the contested embodiments in accordance with the advertising and presentation in product brochures and on product websites, can be prepared by the customer as a patent-compliant product and are then intended by the customer for patent-compliant use (in Germany).

138 b) With regard to the destruction, the Senate amends the District Court's order of destruction on appeal by the defendants nos. 2 and 3, rejecting the defendants' further appeal, so that it is only upheld to the extent of the plaintiff's auxiliary claim. The amendment is based on the defendant's new submission on the question of the proportionality of the destruction in the court of appeal.

139 aa) The District Court's order to destroy the contested embodiment must be upheld in principle.

140 The submission that the defendants "now" only offer modified embodiments and that they "therefore" "no longer" have the contested embodiment in the contested configuration in their possession or ownership is unsubstantiated and irrelevant (see Kühnen, Handbuch der Patentverletzung, 15th ed., chapter D para. 977). A loss of ownership must - if not obvious for other reasons - at least be made comprehensible by the plaintiff (see Düsseldorf Higher Regional Court, judgment of July 30, 2020 - 2 U 31/19, juris para. 150 mwN). The linking of the submission of the current (amended) offer with the possession and ownership of previous (contested) embodiments with "therefore" is unclear. The Chairman of the Senate pointed this out at the oral hearing. Even if the plaintiff has not disputed this submission, it is already unsubstantiated at the level of conclusiveness. It is beyond the plaintiff's scope of knowledge whether, when and to what extent the defendants have disposed of the attacked embodiments once they have them (Grabinski/Zülch/Tochtermann in Benkard, PatG, 12th ed., § 140a para. 6b). It is therefore incumbent on the infringer, due to the secondary burden of proof, to demonstrate in a substantial manner that, despite previously existing possession and/or ownership, he now has neither possession nor ownership. Simply claiming that they no longer have possession and/or ownership (because a modified version is now being offered) is not sufficient. Rather, substantiated concrete facts must be presented which show that and through which event either possession and/or ownership has been completely relinquished (Kühnen loc. cit.) or at least that products still in possession have already been modified to such an extent that their further destruction can no longer be demanded for reasons of proportionality. There is no such submission by the defendant in the case in dispute. It is unclear whether and when previously stocked, contested embodiments were modified by a software update (which may only happen immediately before delivery of such a device offered in modified form) or whether only newly manufactured embodiments are still in stock in the possession and/or ownership of the defendant and the previous embodiment has been sold off.

141 Accordingly, it no longer matters whether the defendant's objection is irrelevant on the merits with regard to the claim for destruction, because this may continue to exist - irrespective of the current possession - already with regard to such (still unaltered) infringing objects which may come into the possession of the defendant in the future through a recall, so that the infringed party is not dependent on a new discovery procedure in this respect (see Grabinski/Zülch/Tochtermann in Benkard, PatG, 12th ed, § Section 140a para. 6c mwN; aA Düsseldorf Higher Regional Court, judgment of July 30, 2020 - 2 U 31/19, juris para. 150 mwN).

142 bb) However, destruction cannot be demanded if it is disproportionate in the individual case. This can be assumed in particular if the unlawful condition of the product can be remedied in another way - such as by a modification - than by complete destruction (see also Grabinski/Zülch/ Tochtermann in Benkard, PatG, 12th ed., Section 140a para. 8d, referred to there as a "milder measure"; Senate Judgment of January 27, 2016 - 6 U 83/10 (11), BeckRS 2016, 14987 para. 98 with reference to the challenged decision District Court Mannheim, judgment of May 4, 2010 - 2 O 142/08 JurisRn. 327 - zusätzliche Anwendungssoftware). As part of the overall assessment, however, not only the interests of the infringer, but also the interests of the (different) owner as well as the aspect of general prevention and the sanction intended by the destruction must be taken into account (see [on Section 18 (3) MarkenG] Federal Supreme Court BGH, judgment of October 11, 2018 - I ZR 259/15, JurisRn. 21 - Curapor). Another possibility of eliminating the consequences and/or minor fault does not automatically mean that the destruction would be disproportionate. Rather, all considerations must be included in the overall assessment (Kühnen loc. cit. para. 984).

143 In the case in dispute, the defendants argue that they now offer a different embodiment in which, instead of using a table within the meaning of feature 8.6./1.7) there is a function in the control software of the devices which has the effect that the currently required time duration value is calculated at the moment - and indeed each time anew - at which it is required. It argues that this solution, which deviates from the teaching of the patent in suit (as maintained), could be implemented by the defendants in the contested embodiments "without further ado by means of a software update of the control system and that the end customer price of the attacked overall device" is "over € 10,000."

144 This submission is procedurally relevant: It is irrelevant that it was not made within the time limit for filing an appeal within the meaning of Section 520 (2) Code of Civil Procedure (ZPO). With their appeal, the defendants have challenged the District Court's assumption of patent infringement and thus also - although not in detail - the subsequent claims arising from the infringement and awarded by the District Court. A delay in the submission within the meaning of Section 531 para. 2 Code of Civil Procedure (ZPO) cannot be assumed, even if it is new - although there is nothing to suggest why the submission was not already made at first instance or in any case from the amendment of the challenged embodiments (which was stated as "summer 2021" by the defendant's representative at the oral hearing) in view of the limited assertion of the patent in suit - since the defendant's factual submission is not disputed (Zöller/ Heßler, Code of Civil Procedure (ZPO), 34th ed. § 531 para. 20).

145 Weighing up all the circumstances, the Senate considers that, on the one hand, the patent-free solution that can easily be implemented by means of a software update (without

realizing the selection of values from a table required by the patent in features 8.6 and 1.7), on the other hand the considerable value of the contested overall device in excess of € 10,000, in the case of average fault and the sufficient general prevention and sanction (in the last maintained and asserted by the plaintiff from the outset) in the specific patent in suit for disproportionate, to destroy the attacked objects by destroying them. Rather, it is sufficient for the purpose, but also necessary and reasonable, to "convert" them by means of the software update - in accordance with the plaintiff's auxiliary requests - for the purpose of destroying the contested embodiment in this sense.

146 cc) Even if the defendants apparently see this differently according to their submission ("Complete destruction or recall are disproportionate in such a case (...)"), this does not mean that this restriction in the statement of the legal consequence of destruction also applies to the recall and thus to the recalled devices. However, it is true that the recall claim also serves to retrieve infringing objects that have already left the infringer's premises and are therefore - due to a lack of current ownership/possession - no longer subject to the destruction claim (at least according to the controversial view of the Düsseldorf Higher Regional Court, see above).) in order to fulfill the continuing claim for destruction (according to the opinion of Grabinski/Zülch/Tochtermann, see above) or (according to the opposing opinion) to re-establish the requirements for destruction and, if necessary, to enforce the claim in further discovery proceedings (see Kühnen loc. cit. para. 1021).

147 The fact that the infringer is permitted to modify (in this case, update the software) the infringing objects into a patent-free design instead of destroying them does not mean that the same restriction would also be generally justified and should be applied in the case of a recall. Rather, even if a modification of a part of the overall device already irreversibly results from the patent infringement, the claim may nevertheless exist without restriction if its patent-compliant design was the reason for the sale of the object and the infringer would then retain the customer base, which he owes largely to the patent infringement, by supplying the alternative technology (cf. Kühnen para. 1031 and 1034 above). However, this is not the case in the dispute. Rather, the restriction expressed in the context of destruction also applies to these items. For the defendants have argued - without being contradicted by the plaintiff - that the provision of a table for setting the time duration of the compressed gas pulses in of the control software of the contested embodiments was not known to their customers and could not be ascertained. The existence of the table could therefore - as the defendants rightly point out - not be a decision criterion for the customers for the selection of the contested embodiment. However, if the customers were not even aware of this fact and it was not a decision criterion for them to purchase from the defendants, the Senate cannot assume that the defendants acquired the customer base due to the patent infringement and obtained it by merely converting instead of destroying the objects to be destroyed.

148 This result is also not unfair with regard to the protected interests of the infringer. This is because the defendant's opportunity to maintain the income from the infringing transactions by merely modifying the infringing products supplied to the customers - and, accordingly, the impairment of, for example, the patentee - is not unfair.

The obligation of the defendant and, accordingly, the plaintiff's claim for damages calculable on the basis of the infringer's profit - are offset by the infringer's profit. When determining the latter, it is irrelevant that the infringer could have produced (later actually used) patent-free alternative products during the infringement period and thus also achieved the profit (BGHZ 194, 194 para. 34 f - Bottle carrier).

149 The Senate has tenored destruction by way of "conversion" only by handing over to the bailiff and carrying out the act with him and under his supervision - while rejecting the further appeal - in order to ensure in this way that the infringing objects do not return to the market (see Kühnen, Handbuch der Patentverletzung, 15th ed. ch. D para. 991).

150 c) Finally, in the case in dispute, the recall itself is not disproportionate - which the defendants do not claim. Whether it would be disproportionate if the recalled items had to be destroyed can be left open. The recall request alone does not specify the desired action in this respect. In the present case, the recall obligation is also not qualified under substantive law to the effect that it must include a reference to an intended complete destruction. This is because, as explained above, the defendants are not obliged to do so even in the case of items recalled.

151 5. A suspension of the proceedings is out of the question, the objection proceedings have been concluded.

152 6. The decision on costs is based on Section 97 (1), Section 92 (2) No. 1 Code of Civil Procedure (ZPO). The modification of the conviction pronounced by the District Court, as a result of which the destruction can be complied with by "modification" (software update) instead of by destroying the contested embodiment, represents an additional claim on the part of the plaintiff which is relatively insignificant and involves no or only slightly higher costs. The decision on provisional enforceability results from Section 708 no. 10, Section 711 Code of Civil Procedure (ZPO). There are no reasons to allow an appeal pursuant to Section 543 (2) Code of Civil Procedure (ZPO).