

FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

I ZR 118/16

JUDGMENT

Pronounced on:
22 March 2018
Führinger
Judicial Officer
Registrar
of the Court

in the legal dispute

Reference: yes
BGHZ: no
BGHR: yes

Hollow fiber membrane spinning system II

Act against Unfair Competition (UWG) Sec. 3 para. 1, Sections 3a, 17 para. 2 no. 2; Code of Civil Procedure (ZPO) Sec. 253 para. 2 no. 2

- a) A demand for relief seeking to obtain a cease-and-desist order for the production, offering and marketing of a technical system, wherein said demand is based on the prohibition of unauthorized exploitation of trade secrets pursuant to Sec. 17 para. 2 no. 2 UWG, is sufficiently specific if the prohibition that Plaintiff seeks to obtain is directed against a specific infringing embodiment, even if such demand for relief does not contain any verbal description of the circumstances from which Plaintiff infers a rights violation.
- b) The specific dimensions and arrangements of the nozzle body and nozzle blocks of a hollow fiber membrane spinning system, which are embodied by the design plans and the final product itself, can be considered a trade secret within the scope of Sec. 17 UWG.
- c) The relevant aspect for a fact to qualify for protection as a trade secret is whether, despite it being part of prior art, the relevant fact can only be found out, made accessible and therefore be made usable by the company subject to great efforts in terms of time and cost. Accordingly, design plans which show the dimensions and arrangements of the technical components of a machine and the preparation of which requires significant efforts may be protected as a trade secret.
- d) If, during his employment, a former employee had access to prepared written documents – for example in the form of personal records or in the form of a file stored on the personal computer – and if he infers a trade secret of his former employer from such documents, he has acquired said secret without authorization within the scope of Sec. 17 para. 2 no. 2 UWG, even if he is able, based on his education, training and experience, to perform the conduct

that is challenged as a violation of the trade secret without using said documents.

Federal Court of Justice (BGH), judgment of 22 March 2018 - I ZR 118/16 -

Higher Regional Court of Koblenz

Regional Court of Koblenz

Following the oral hearing on 22 March 2018, handed down by the Judges Prof. Dr. Koch, Dr. Löffler, Dr. Schwonke, Judge Feddersen and Judge Dr. Schmaltz, the I. Civil Senate of the Federal Court of Justice

has adjudged as follows:

In response to Plaintiff's appeal on points of law, the judgment of the 9th Civil Senate of the Higher Regional Court of Koblenz dated 04 May 2016 is revoked.

The matter is referred back to the Court of Appeal for new proceedings and a new decision, including a decision about the costs of the appeal on points of law.

Ex officio

Facts of the case:

- 1 Plaintiff belongs to the F. Medical Care Group. As part of the Group, Plaintiff sells in Germany dialysis filters that are used as disposables in the hemodialysis treatment of patients with kidney disease for the removal of contaminants from the blood. The hollow fibers that are used in these dialysis filters are produced in a continuous process on special spinning systems from a liquid polymer solution and are processed into filters. These spinning systems have been continuously further developed by Plaintiff and manufactured on Plaintiff's behalf since 1981. The production of the fibers in the spinning systems is carried out by means of nozzle blocks, on which nozzles (nozzle body) are installed. Around the year 1990, Plaintiff commissioned the spinning system "HEIDI II" that has nozzle blocks with 32 nozzles, respectively, and a capacity of 1024 "ends". The nozzle blocks consist of three plates, namely a top, center and bottom plate, on which 32 nozzles and/or nozzle bodies are installed. Plaintiff does not sell the fiber spinning system to third parties outside the Group. In 1999, after about two years of preparatory work, Plaintiff created the further developed fiber spinning system "HEIDI I", which has a nozzle block with 48 nozzles and a capacity of 1536 ends.
- 2 Defendant 1) manufactures and sells fiber spinning systems for the production of synthetic hollow fibers for dialysis filters. Defendant 2) is a chemist who has written his doctoral thesis on carbon, hollow and PAN fibers. From 1982 to 1989, he was employed by a competitor of Plaintiff and in charge of the manufacture of solution spinning systems for membrane hollow fibers. From November 1990 to June 1993, he was employed by

the legal predecessor of Plaintiff as a production manager for the area "membrane production" and responsible for the production of nozzles. In this context, he had access to technical drawings and data sets of Plaintiff's legal predecessor. His employment contract subjected him to the obligation to maintain secrecy.

3 After the expiry of a leave of absence, the employment of Defendant 2) was terminated in the summer of 1993 through a cancellation agreement. The cancellation agreement included a non-disclosure obligation with regard to any trade and industrial secrets of which Defendant 2) gained knowledge in the time of his employment. Since July 1993, Defendant 2) has been working for Defendant 1) and is now the managing director of Defendant 1). In 1996, Defendant 1) offered for the first time a fiber spinning system with 128 nozzles. With the offer of 29 September 2004 (Exhibit K 1), Defendant 1) offered for the first time a hollow fiber membrane spinning system with 1536 ends on the market.

4 Plaintiff asserts that using design drawings, plans and other information of Plaintiff, Defendants have inadmissibly reverse engineered hollow fiber spinning systems with 1024 and 1536 ends. It considers this an illegal exploitation of trade secrets and a violation against the contractual non-disclosure agreement.

5 To the extent relevant to the appeal proceedings, the Regional Court has prohibited Defendants on pain of penalties from

producing, offering and/or putting onto the market fiber spinning systems of the type "Hollow Fiber Membrane Spinning System 1536 Ends" consisting of the components that can be inferred from Annex A [= Exhibit K 1] and of the type "1024 Ends".

6 In addition, the Regional Court ordered Defendants to provide information and established an obligation to pay damages. Defendants have filed appeal against the sentence. Most recently, Plaintiff requested in the appeal proceedings that

the appeal be dismissed, in the alternative,

that the challenged judgment be upheld subject to the condition that Defendants be prohibited, on pain of penalties, from producing, offering or putting onto the market fiber spinning systems of the types "Hollow Fiber Membrane Spinning System 1536 Ends" and "1024 Ends" consisting of the components that can be inferred from Annex A, if said spinning systems have spinning nozzles in accordance with one of the following design drawings: [illustrations are following]

and

that, upon the dismissal of the challenged decision, Defendants be prohibited from producing, offering or putting onto the market fiber spinning systems of the type “Hollow Fiber Membrane Spinning System 1536 Ends” consisting of the components that can be inferred from Annex A of the demand for relief, or systems of the type “1024 Ends”, if said systems have nozzle blocks with 32 or 48 spinning nozzles that correspond to one or more of the following illustrations: [illustrations are following]

- 7 The Court of Appeal partially amended the Regional Court judgment and dismissed the complaint. In its appeal on points of law allowed by the Senate, Plaintiff continues to pursue its demands for relief submitted at the appellate instance. Defendants request that Plaintiff’s appeal be dismissed.

Grounds for the decision:

- 8 A. The Court of Appeal has considered the demands for relief, including the auxiliary requests, to be unjustified. Pursuant to the Court of Appeal, Plaintiff has not provided a sufficiently specific submission regarding a trade secret or an act of infringement within the scope of Sec. 17 UWG. The Court of Appeal explains in this regard:
- 9 A violation of a trade secret pursuant to Sec. 17 UWG does not exist. Plaintiff must specifically name the facts which it seeks to have protected as secrets. What is presently concerned is a 30 m long system consisting of a plurality of technical components and arrangements with different functions in the context of the production process. Plaintiff, which bears the burden of demonstration and proof, has not explained in a specific manner which part or which element of its systems of the type “1024 and 1536 Ends” is a trade secret. Likewise, Plaintiff has not explained which design plan of the spinning system, and, if applicable, which individual part or section, contains a trade secret.
- 10 Furthermore, Plaintiff has not demonstrated to a sufficient extent that Defendant 2) has exploited without authorization knowledge he gained from Plaintiff. The fact alone that some elements of the systems of the parties are identical does not allow such a conclusion. Protection from the acquisition of a secret does not exist if the acquisition is based on knowledge gained in an honest manner from experience and if the identical parts of the system could also be the result of admissible development work.
- 11 Plaintiff has not argued that the alleged trade secret is not known to the interested expert circles or that it is not used by such expert circles as a, from a technical point of view, reasonable solution for a problem. Furthermore, Plaintiff has not distinguished between

the trade secret, which it has not specified, anyway, and the knowledge gained in an honest manner from experience by Defendant 2). Therefore, Defendants are not able to counter the allegation of having exploited a trade secret without authorization in a legally valid manner.

- 12 Plaintiff is not entitled to any contractual claims, either. Since Plaintiff has not demonstrated that there is a trade secret that goes beyond the obvious knowledge of a skilled person, it is not proven that Defendant 2) has violated a contractual non-disclosure duty with regard to trade secrets.
- 13 While the auxiliary requests Plaintiff asserts in the appeal proceedings are admissible, they, as well, are unsubstantiated. The reference to the design drawings of the spinning nozzle and the nozzle body do not fulfill the requirements for the specification of a specific trade secret, since Plaintiff has not explained which element of the parts of the spinning nozzle and/or the nozzle body contained in the design drawing constitutes the trade secret.
- 14 B. Plaintiff's appeal on points of law against this assessment is successful. As a result, the appeal judgment is revoked and the matter is referred back to the Court of Appeal. The assumption of the Court of Appeal that Plaintiff has not made a sufficiently specific submission with regard to a trade secret or with regard to an unauthorized exploitation within the scope of Sec. 17 para. 2 UWG is not able to withstand the legal re-assessment.
- 15 I. Plaintiff's main cease-and-desist request is sufficiently specific.
- 16 1. Pursuant to Sec. 253 para. 2 no. 2 ZPO, a request for prohibition must not be worded so unspecific that no clear distinction is made between the subject matter and the scope of the decision-making authority of the court (Sec. 308 para. 1 ZPO), so that Defendant is therefore not able to defend himself sufficiently and, ultimately, the decision about what Defendant is prohibited from would have to be made by the court competent for the execution (established case law; BGH, judgment of 02 March 2017 – I ZR 194/15, GRUR 2017, 537, marg. no. 12 = WRP 2017, 542 – Konsumgetreide; judgment of 05 October 2017 – I ZR 184/16, GRUR 2018, 203 marg. no. 10 = WRP 2018, 190 – Betriebspsychologe). A request will usually be considered sufficiently specific if it contains a reference to the specific act of infringement or the specifically challenged infringing embodiment (cf. only BGH, judgment of 04 September 2003 – I ZR 23/01, BGHZ 156,

126, 131 [juris marg. no. 19] – Farbmarkenverletzung I; judgment of 16 July 2009 - I ZR 56/07, GRUR 2009, 1075 marg. no. 10 = WRP 2009, 1377 – Betriebsbeobachtung; judgment of 06 October 2011 - I ZR 54/10, GRUR 2012, 405 marg. no. 11 = WRP 2012, 461 – Kreditkontrolle; judgment of 17 July 2013 - I ZR 21/12, GRUR 2013, 1052 marg. no. 12 = WRP 2013, 1339 – Einkaufswagen III) and if, at least if one consults the statement of claim, the demand for relief unambiguously shows which features of the challenged product are to be the basis and the point of reference of the violation of competition and, therefore, of the cease-and-desist order (BGH, judgment of 12 July 2001 - I ZR 40/99, GRUR 2002, 86, 88 [juris marg. no. 54] = WRP 2001, 1294 – Laubhefter; BGH, GRUR 2013, 1052 marg. no. 12 – Einkaufswagen III).

- 17 2. According to these principles, the cease-and-desist request is sufficiently specific.
- 18 a) The prohibition Plaintiff seeks to obtain through its main request under I relates to fiber spinning systems of Defendant 1) with, pursuant to the offer description according to Annex A, 1536 ends, and, therefore, to a specific infringing embodiment. The statement of claim shows unambiguously which features of the challenged product are to be the basis and the point of reference of the violation of competition and, therefore, of the cease-and-desist order (cf. in this regard B II 1 c).
- 19 b) The demand for relief is not unspecific due to the fact that it does not include a verbal description of the circumstances from which Plaintiff infers the right infringement (cf. BGH, judgment of 13 December 2007 - I ZR 71/05, GRUR 2008, 727 marg. no. 9 = WRP 2008, 1085 – Schweißmodulgenerator; BGH, GRUR 2013, 1052 marg. no. 12 – Einkaufswagen III). Such a description is not necessary if - as in the present dispute - the prohibition that Plaintiff seeks to obtain relates to a specific infringing embodiment (BGH, judgment of 01 July 1960 - I ZR 72/59, GRUR 1961, 40, 42 = WRP 1960, 241 – Wurfertaubenpresse; BGH, GRUR 2008, 727 marg. no. 9 et seq. – Schweißmodulgenerator; BGH, judgment of 24 January 2013 - I ZR 136/11, GRUR 2013, 951 marg. no. 11 = WRP 2013, 1188 – Regalsystem). In this regard, it needs to be taken into consideration that the principle of a specific wording must not have the result that, disregarding its legitimate interests in secrecy, Plaintiff is forced to disclose business or trade secrets in the demand for relief (cf. regarding the tension between the principle of a specific wording and the protection of secrets Köhler in Köhler/Bornkamm/Feddersen, UWG, 36th ed., Sec. 17 marg. no. 64; Harte-Bavendamm in Harte/Henning, UWG, 4th ed., Sec. 17 marg. no. 60; Ohly in Ohly/Sosnitza, UWG, 7th ed., Sec. 17 UWG marg. no. 53).

- 20 c) In the present dispute it is not evident that Defendants are not clearly informed about which specific embodiment is the subject matter of the requested prohibition. The configuration of the spinning system of Defendant 1) described in the cease-and-desist request is undisputed between the parties. Defendants have, in particular, not asserted that Defendant 1) does not produce or has not produced spinning systems pursuant to the offer specified in Annex A to the demand for relief or that Defendant 1) has only done so or is only doing so based on different technical specifications relevant to the present dispute.
- 21 d) The request also covers the specific infringing embodiment where it relates to a fiber spinning system with 1024 ends. It is true that Annex A, referred to in the request, expressly and exclusively refers to a system with “1536 ends”. However, pursuant to the complaint, the spinning system with 1536 ends is merely a simple enlarged version of the system with 1024 ends; except for the number of ends, the specifications are identical for both spinning systems. Nothing different has been found by the Court of Appeal nor is anything to the contrary being asserted in the response to the appeal.
- 22 3. Plaintiff has also clearly specified the grounds for the complaint.
- 23 a) Plaintiff has based its demands for relief both on claims under tort law due to the infringement of trade and industrial secrets pursuant to Sec. 17 UWG and on contractual claims due to the violation of a non-disclosure agreement. These are different grounds for the complaint and, therefore, different subject matters in dispute (cf. BGH, GRUR 2013, 397 marg. no. 14 – Peek & Cloppenburg III; Büscher in Fezer/Büscher/Obergfell, UWG, 3rd ed., § 12 marg. no. 277; Köhler in Köhler/Bornkamm/Feddersen loc. cit. Sec. 12 marg. no. 2.23I). Pursuant to Sec. 253 para. 2 no. 2 ZPO, the statement of claim must contain certain information on the subject matter and the grounds for filing the claim. Therefore, Plaintiff must clarify in which order it seeks to assert the subject matters in dispute (cf. BGH, decision of 24 March 2011 - I ZR 108/09, BGHZ 189, 56 marg. no. 8 - TÜV I; judgment of 23 September 2015 - I ZR 78/14, GRUR 2015, 1201 marg. no. 38 = WRP 2015, 1487 – Sparkassen-Rot/Santander-Rot; judgment of 02 June 2016 - I ZR 75/15, GRUR 2017, 75 marg. no. 11 = WRP 2017, 74 – Wunderbaum II). This clarification may still be made at the appeal instance (BGH, judgment of 12 January 2017 - I ZR 253/14, GRUR 2017, 397 marg. no. 28 = WRP 2017, 434 - World of Warcraft II).
- 24 b) These conditions are met. In the appeal hearing, Plaintiff clarified that it based its demands for relief primarily on Sec. 17 para. 2 UWG and secondarily on general tort law,

and, in the alternative, on the contractual non-disclosure obligation.

- 25 II. The cease-and-desist claim on the grounds of unauthorized exploitation of trade secrets pursuant to Sec. 3 para. 1, Sec. 4 no. 11, Sec. 8 para. 1 UWG old version and/or Sec. 3 para. 1, Sections 3a, 8 para. 1 UWG, respectively in conjunction with Sec. 17 para. 2 no. 2 UWG asserted through the main request cannot be denied on the basis of the grounds cited by the Court of Appeal. First of all, the requirements of the Court of Appeal regarding the proof of a trade or industrial secret pursuant to Sec. 17 UWG are too strict (cf. in this regard B II 1). The assessment of the Court of Appeal regarding the act of infringement relevant with regard to Sec. 17 para. 2 no. 2 UWG is not able to withstand the legal re-assessment, either (cf. in this regard B II 2). Therefore, the Court of Appeal's denial of the contractual claims, as well, is lacking a sound basis (cf. in this regard B II 3).
- 26 1. The assumption of the Court of Appeal that Plaintiff has not proven the existence of a trade or industrial secret that might have been infringed by Defendants in the first place is not free from legal errors.
- 27 a) Pursuant to Sec. 17 para. 2 no. 2 UWG, it is prohibited to exploit without authorization a trade or industrial secret acquired through one of the communications pursuant to Sec. 17 para. 1 UWG or through an act of one's own or of a third party pursuant to Sec. 17 para. 2 no. 1 UWG, or which has been otherwise acquired or secured without authorization, or to communicate such secret to anyone without authorization, if the respective party is acting for purposes of competition, for personal gain, for the benefit of a third party, or with the intent of causing damage to the owner of the business. To the extent that they relate to actions in the context of business transactions, these specifications constitute a provision to regulate market conduct within the scope of Sec. 4 no. 11 UWG old version and Sec. 3a UWG new version (cf. BGH, judgment of 27 April 2006 – I ZR 126/03, GRUR 2006, 1044 marg. no. 17 = WRP 2006, 1511 – Kundendatenprogramm; judgment of 26 February 2009 - I ZR 28/06, GRUR 2009, 603 marg. no. 22 = WRP 2009, 613 – Versicherungsuntervertreter; judgment of 23 February 2012 – I ZR 136/10, GRUR 2012, 1048 marg. no. 22 = WRP 2012, 1230 – MOVICOL-Zulassungsantrag; Köhler in Köhler/Bornkamm/Feddersen loc. cit. Sec. 17 marg. no. 52; Harte-Bavendamm in Harte/Henning loc. cit. Sec. 17 marg. no. 43).
- 28 A business or industrial secret within the scope of Sec. 17 UWG is any fact in connection

with business operations that is not obvious but only known to a limited group of persons and that, pursuant to the business owner's expressed will, which is based on economic interests, is to be kept confidential (cf. BGH, GRUR 2006, 1044 marg. no. 19 – Kundendatenprogramm; GRUR 2009, 603 marg. no. 13 – Versicherungsuntervertreter, with further references, respectively). Trade secrets of a technical nature include, in particular, constructions, construction drawings, formulas, production methods, technical compositions and the way in which a system functions (cf. BGH, judgment of 10 July 1963 – Ib ZR 21/62, GRUR 1964, 31, 32 [juris marg. no. 16] = WRP 1963, 333 – Petromax II; judgment of 19 November 1982 - I ZR 99/80, GRUR 1983, 179, 180 [juris marg. no. 11] = NJW 1984, 239 - Stapel-Automat; judgment of 07 November 2002 – I ZR 64/00, GRUR 2003, 356, 358 [juris marg. no. 38] = WRP 2003, 500 – Präzisionsmessgeräte; Köhler in Köhler/Bornkamm/Feddersen loc. cit. Sec. 17 marg. no. 12a with further references).

- 29 b) The Court of Appeal proceeds on the basis of the assumption that Plaintiff has not provided sufficient evidence of the presence of such a trade or industrial secret. It assumes that Plaintiff, which bears the burden of demonstration and proof, has not explained in a specific manner which part or which element of its spinning systems of the types “1024 and 1536 Ends” is a trade secret. Likewise, Plaintiff has allegedly not explained which design plan of the spinning system, and, if applicable, which individual part or section, contains a trade secret. Defendants do not know which parts within the 30 m long system, consisting of 15 assemblies, will have to be changed, in order to circumvent the prohibition claimed by Plaintiff.
- 30 This assessment is not able to withstand a legal re-assessment. Contrary to what the Court of Appeal believes, Plaintiff has provided a specific submission regarding what parts of its spinning system it considers to be a trade secret.
- 31 aa) Based on the expert opinions obtained, the Regional Court has assumed that the spinning system of Plaintiff, especially the dimensions and arrangements of the nozzle bodies and nozzle blocks, are trade secrets. The Regional Court believes that the nozzle bodies and nozzle blocks are central elements of the technical operating sequence of the spinning system and that they are not obvious to third parties, but only known to a limited group of persons within Plaintiff's company. Plaintiff also has a significant economic interest in keeping those elements secret. The design of the nozzle blocks and spinning nozzles are very “know-how intensive”. The arrangement and design of the spinning nozzles on the individual nozzle blocks are the core technology of the entire system. The nozzle block as such is also part of the “key equipment”.

- 32 Through this assessment, the Regional Court has established the presence of trade secrets in the present case. The specific dimensions and arrangements of the nozzle bodies and nozzle blocks, embodied by the construction plans and the final product itself can be considered a trade secret (cf. BGH, GRUR 2003, 356, 358 [juris marg. no. 38] – Präzisionsmessgeräte).
- 33 bb) The Regional Court has made its assessment on the basis of Plaintiff's first instance submission and the expert opinions obtained in order to prove said submission. In addition, Plaintiff has adopted the result of the expert opinions and, at the appeal instance, also the findings of the Regional Court in Plaintiff's favor as its own submission. In doing so, Plaintiff has submitted specific facts that, in its opinion, are trade secrets. The cease-and-desist claim through which Plaintiff seeks to obtain the prohibition of specific spinning systems is justified if the challenged spinning systems contain nozzle bodies and nozzle blocks with the dimensions and arrangements submitted by Plaintiff. Any further specification in the statement of claim, regarding the details through which the trade secret is embodied, is, contrary to what the Court of Appeal believes, not relevant to the justification of the request through which a prohibition of the specific infringing embodiment is sought, but only to the scope of the request, namely to the question of whether or not essentially equivalent acts of infringement are also covered by the cease-and-desist order (cf. BGH, GRUR 2008, 727 marg. no. 17 et seq. – Schweißmodulgenerator).
- 34 c) Furthermore, the Court of Appeal has applied an incorrect legal standard to the assessment of the question of at what point a fact is not obvious and can therefore be considered to be a trade or industrial secret.
- 35 aa) The Court of Appeal has assumed that, with regard to the aspect of a lack of obviousness, Plaintiff has not argued that the alleged trade secret is not known to the interested expert circles or that it is not used by such expert circles as a, from a technical point of view, reasonable solution for a problem. The Court of Appeal believes that, in this context, it has to be taken into consideration that obviousness can also be caused through the submission of offers, advertisement, patent applications etc. Plaintiff also has not distinguished between the trade secret asserted by it and knowledge acquired by Defendant 2) in an honest manner from experience. This is why Defendants were not able to counter the allegation of having exploited a trade secret without authorization in a legally valid manner. Defendants are not able to prove their claim that their spinning systems are based on their own knowledge gained through experience or that they are in

accordance with prior art or obvious.

- 36 bb) This assessment is not free from legal errors.
- 37 (1) The Court of Appeal proceeded on the basis of an incorrect interpretation of the term obviousness.
- 38 Obviousness that excludes a fact from being a secret is present if the fact is generally known (BGH, GRUR 2008, 727 marg. no. 19 – Schweißmodulgenerator; GRUR 2012, 1048 marg. no. 31 – MOVICOL-Zulassungsantrag; Köhler in Köhler/Bornkamm/Feddersen loc. cit. Sec. 17 marg. no. 7). The fact that the fact in question was accessible to a limited - albeit, as the case may be, larger - group of people does not stand in opposition to the assumption that the fact in question is a trade secret (BGH, GRUR 2012, 1048 marg. no. 31 - MOVICOL-Zulassungsantrag). The secret nature is, in particular, generally not eliminated due to the fact that processes in a production company are revealed to the employees of the company (BGH, GRUR 2003, 356, 358 [juris marg. no. 40] - Präzisionsmessgeräte).
- 39 However, the fact that the fact in question can be classified as prior art, which the Court of Appeal believes to be decisive, is irrelevant to the question of whether the fact in question is generally known, which would exclude the fact in question from being a secret. Despite the fact that general prior art is regularly revealed in publications, it cannot be readily assumed that the underlying production methods are obvious (BGH, GRUR 2003, 356, 358 [juris marg. no. 39] – Präzisionsmessgeräte). Instead, the relevant aspect for a fact to qualify for protection as a trade secret is whether, despite it being part of prior art, the relevant fact can only be found out, made accessible and therefore be made usable by the company subject to great efforts in terms of time and cost (cf. BGH, GRUR 2008, 727 marg. no. 19 – Schweißmodulgenerator; GRUR 2012, 1048 marg. no. 21 – MOVICOL-Zulassungsantrag). Especially the use of construction plans embodying the dimensions and arrangements of the technical components of a machine - which is also discussed in the present dispute - will regularly save a company own construction efforts to a significant extent (cf. BGH, GRUR 1964, 31, 33 [juris marg. no. 26] – Petromax II; GRUR 2003, 356, 358 [juris marg. no. 38] – Präzisionsmessgeräte). This is why such construction plans can be protected as a trade secret.

- 40 Furthermore, the Court of Appeal assumed in a legally erroneous manner that, in order to prove the presence of a trade secret, Plaintiff was required to differentiate between the allegedly secret facts and the knowledge acquired by Defendant 2) in an honest manner from experience, and to make a submission in this regard. Whether or not an employee has knowledge of the facts in question is irrelevant to the assessment of whether or not a trade secret exists. The secret nature of a fact is usually not eliminated due to the fact that processes in a production company are revealed to the employees of the company (BGH, GRUR 2003, 356, 358 [juris marg. no. 40] – Präzisionsmessgeräte). If at all, the aspect of whether or not a (former) employee has expert knowledge gained from experience that enables him to perform the conduct challenged as a violation of a trade secrets even without him resorting to the documents he obtained or created during his employment is relevant to the question of which acts of exploitation are legally permissible (cf. B II 2).
- 41 (2) In addition, in violation of Sec. 286 para. 1 ZPO, the Court of Appeal has not sufficiently considered the circumstances of the dispute or the submission of the parties in the context of the assessment of the feature of obviousness.
- 42 The Court of Appeal has found that Plaintiff's spinning systems are Plaintiff's own creations that are not sold; what is sold is merely the dialysis filters produced by means of these systems. Furthermore, the Court of Appeal has found that Defendant 2) concluded a non-disclosure agreement - also applicable to the time after the termination of the contract - with Plaintiff in his employment contact; said non-disclosure agreement is also included in the cancellation agreement. In addition, pursuant to the findings the Regional Court made based on the explanations of the court expert adopted by Plaintiff as its own, the dimensions and arrangement of the nozzle bodies and blocks as well as numerous other identical circumstances were not generally known, but were only accessible to a very limited group of persons among Plaintiff's employees. Pursuant to the statements of the expert, with regard to the entire spinning system, approximately 1,000 hours would have had to be dedicated to development and construction, in order to achieve the advantages obtained by Defendant 2). The Court of Appeal has not found anything to the contrary. With regard to the fact that the Court of Appeal made a potential obviousness caused by "offers, advertisement or patent applications" its point of reference, the appeal on points of law successfully criticizes that the Court of Appeal has not provided any findings with regard to such circumstances.
- 43 2. The assessment of the Court of Appeal regarding the act of infringement relevant with

regard to Sec. 17 para. 2 no. 2 UWG is not able to withstand the legal re-assessment, either.

- 44 a) The Court of Appeal has assumed that the fact established by the Regional Court after the respective taking of evidence, pursuant to which the systems of the Parties are identical in some regards, alone, does not allow the conclusion that Defendant 2) has exploited without authorization knowledge obtained from Plaintiff. If at all, the identification of identical elements in the construction can be an indication suggesting an unfair appropriation, if and to the extent that such identical elements are not able to be explained by knowledge gained from experience and if and to the extent that they are not obvious. There is no protection from the acquisition of a secret if the acquisition is based on knowledge gained in an honest manner from experience and if the identical parts of the system could also be the result of admissible development measures. Defendant 2) has worked with fiber spinning systems and technology for many years. Pursuant to the statements of the experts heard at first instance, due to his knowledge gained from experience, Defendant 2) is not only able to build an entire fiber spinning system, but also to build a nozzle block all by himself, without using construction drawings. In light of the fact that Defendant 2) had left Plaintiff in November 1992 and that the first offer of Defendant 1) for a fiber spinning system with 128 nozzles was only submitted in 1996, Defendants' interest in preservation under competition law, i.e. the option to further use and develop their own knowledge gained from experience, is of particular relevance.
- 45 b) This assessment is not free from legal errors.
- 46 aa) It is true that a former employee may use the knowledge obtained during his employment later on without any restrictions, if he is not subject to a non-compete agreement - which has not been established by the Court of Appeal (cf. BGH, GRUR 2002, 91, 92 [juris marg. no. 47] – Spritzgießwerkzeuge; GRUR 2006, 1044 marg. no. 13 – Kundendatenprogramm). However, the Court of Appeal has not taken into consideration that this provision only relates to information that the former employee has memorized (BGH, judgment of 14 January 1999 – I ZR 2/97, GRUR 1999, 934, 935 [juris marg. no. 26] = WRP 1999, 912 – Weinberater; BGH, GRUR 2006, 1044 marg. no. 13 – Kundendatenprogramm; GRUR 2009, 603 marg. no. 15 – Versicherungsuntervertreter). Yet, the right to use the acquired knowledge after the termination of the employment even to the disadvantage of the former employer does not relate to information that is still known to the former employee only because he can resort to written documents that he prepared in the time of his employment (BGH, judgment of 19 December 2002 – I ZR 119/00, GRUR 2003, 453, 454 [juris marg. no. 26] = WRP 2003, 642 Verwertung von

Kundenlisten; BGH, GRUR 2006, 1044 marg. no. 13 – Kundendatenprogramm; GRUR 2009, 603 marg. no. 15 – Versicherungsuntervertreter). An employee who is leaving the company is not entitled to refresh and secure the knowledge he has acquired by taking along or stealing construction documents or to keep or continue to use the acquired knowledge as know-how embodied by these documents for his own purposes (cf. BGH, GRUR 2003, 356, 358 [juris marg. no. 30] – Präzisionsmessgeräte; GRUR 2006, 1044 marg. no. 14 – Kundendatenprogramm; GRUR 2009, 603 marg. no. 15 – Versicherungsuntervertreter). If such written documents are available to the employee leaving the company - for example in the form of personal records or of a file stored on the personal notebook - and if he infers a trade or industrial secret of his former employer from them, he thus acquires said secret without authorization within the scope of Sec. 17 para. 2 no. 2 UWG (BGH, GRUR 2006, 1044 marg. no. 14 – Kundendatenprogramm; GRUR 2009, 603 marg. no. 15 – Versicherungsuntervertreter). Such a flaw will not lose its relevance under competition law simply because Defendant is able to develop such a device or such device parts himself (cf. BGH, GRUR 2003, 356, 358 [juris marg. no. 28] – Präzisionsmessgeräte).

47 bb) Furthermore, the Court of Appeal has disregarded the findings provided by the Regional Court after a comprehensive taking of evidence with regard to the question whether or not Defendant 2) was able to construct the nozzle bodies and nozzle blocks in dispute from memory. According to the findings of the Regional Court, as a production manager, Defendant 2) was only working indirectly with the nozzle blocks of the spinning systems during his employment with Plaintiff. The Regional Court assumed that, in light of the large number of identical elements in the spinning systems in dispute and, in particular, in the layouts and individual dimensions of the respective nozzle blocks, a re-creation without the use of construction drawings, specifications, photographs or detailed drawings appeared to be impossible. It was not a realistic option that, after leaving Plaintiff's company, Defendant 2) was able to re-create the individual dimensions and arrangements from memory. All in all, the numerous technological and geometrical matches with regard to the hollow fiber membrane spinning systems with 1014 and 1536 ends, that had been described in detail in the detailed and easily understandable explanations of the court experts, and the note of Defendant 2) that Defendant 1) had deliberately removed the manufacturing tolerances from the construction drawings prior to submitting them to the experts, only allowed the conclusion that the system offered by Defendant 1) on the market for profit had been manufactured with the help of plans, construction drawings and other embodiments of information of Plaintiff.

48 The Court of Appeal has not provided any findings of its own that would deviate from the

above. Instead, the Court of Appeal itself proceeded, in accordance with the findings of the Regional Court, on the basis of the assumption that Defendant 2) had had access to technical drawings and data sets in the context of his employment with Plaintiff.

49 3. It can be inferred from the above that the assumption of the Court of Appeal, pursuant to which Plaintiff has not proven the presence of a trade secret so that it is irrelevant whether the requests in question might be justified on the grounds of a violation of effectively concluded contractual non-disclosure agreements, as well, is lacking a sound foundation.

50 III. The matter has to be referred back to the Court of Appeal for new proceedings. The Senate is prevented from making its own substantive decision, since the Court of Appeal has not yet provided the essential findings of the trial judge that are necessary for the assessment of the demand for relief. The requirements of Sec. 563 para. 3 ZPO, pursuant to which the court hearing the appeal on points of law is to decide on the matter as such if the judgment is reversed only due to a violation of the law, in application of the law to the situation of fact as established, and if in light of said situation the matter is ready for the final decision to be taken, are not fulfilled if, so far, the situation of fact has only been established by the first instance court and if the court of appeal has not yet assessed pursuant to Sec. 529 para. 1 no. 1 ZPO whether specific indications give rise to doubts as to the correctness of the findings of the first instance court (cf. BGH, judgment of 30 October 2007 - X ZR 101/06, NJW 2008, 576 marg. no. 27).

51 IV. With regard to the reopened appeal proceedings, the Senate points out the following:

52 1. Pursuant to Sec. 529 para. 1 no. 1 ZPO, the court of appeal is, as a general rule, bound to the facts established by the initial court. This provision serves the purpose of concentrating the establishing of facts in the first instance (BGHZ 162, 313, 315 [juris marg. no.13]). The binding character specified in this provision does not apply if specific indications give rise to doubts as to the court having correctly or completely established the facts relevant for its decision, and therefore mandate a new fact-finding process. Specific indications may arise from errors made by the initial court when it was establishing the facts (cf. BGHZ 159, 254, 258 [juris, marg. no. 15]; BGH, decision of 02 July 2013 - VI ZR 110/13, NJW 2014, 74 marg. no. 7 with further references). However, even facts established without any procedural errors will not be binding for the court of appeal pursuant to Sec. 529 para. 1 no. 1 ZPO if there are specific indications suggesting that what has been established is incomplete or incorrect (BGHZ 162, 313, 317 [juris

marg. no. 6]). If the facts have been established on the basis of an expert opinion, the incompleteness of the expert opinion as well may raise doubts as to the correctness and completeness of the established facts (Saenger/Wöstmann, ZPO, 7th ed., Sec. 529 marg. no. 4).

- 53 If, in the appeal proceedings, that are to be continued, the Court of Appeal is, due to specific indications, not able to convince itself of the correctness of the consideration of evidence in the first instance, it will not only be entitled to establish the facts again, but it will be obligated to do so (BGHZ 162, 313, 317 [juris marg. no. 7]; BGH, decision of 24 March 2010 - VIII ZR 270/09, BauR 2010, 1095 marg. no. 6). In principle, nothing different applies to the expert opinion. In case of the expert opinion, as well, the expert must be heard again by the Court of Appeal, if it wants to assess his statements differently than the previous instance and, in particular, if it wants to proceed on the basis of a different interpretation of the expert's statements and, thus, draw other conclusions from them than the initial judge (cf. BGH, BauR 2010, 1095 marg. no. 8 with further references).

- 54 2. So far, the Court of Appeal has not provided any findings with regard to the question whether the dimensions of the spinning nozzles and the nozzle body covered by the first auxiliary request or the dimensions and design of the nozzle blocks covered by the second auxiliary request qualify for protection as trade secrets of Plaintiff. To this end, it will have to assess the findings already provided by the Regional Court or establish facts itself, to the extent that a decision about the auxiliary requests is relevant.

Koch

Feddersen

Löffler

Schmaltz

Schwonke

Previous instances:

Regional Court of Koblenz, decision of 30 October 2013 – 10 O 354/05 –

Higher Regional Court of Koblenz, decision of 04 May 2016 – 9 U 1382/13 –