

GRUR

Newsletter



GRUSSWORT

Die GRUR – Ein geschätzter Diskussionspartner
in bewegten Zeiten

WISSENSCHAFTSFÖRDERUNG

Interview mit Prof. Benjamin Raue

JUNGE WISSENSCHAFT

GRUR-Dissertationspreise

INTERNATIONALES

WIPO-Konferenz zum Riyadh Design Law Treaty

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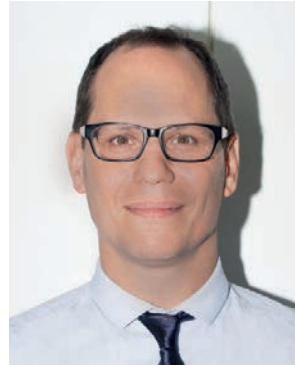
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In its Study Question Q292, the *Association Internationale pour la Protection de la Propriété Intellectuelle* (AIPPI) asked its National and Regional Groups to report on how their laws deal with unjustified infringement allegations of intellectual property (“IP”) rights.¹

The question touches upon the need to strike a balance between the legitimate exercise of IP rights and unjustified conduct that adversely affects competition: IP owners should be able to freely assert their IP rights against suspected infringers. This is true even where the question of infringement or validity has not been answered with full clarity prior to the assertion. On the other hand, the mere threat of exercising the IP rights may effectively deter competitors even from legitimate conduct. Even unjustified warning letters, take-down notices or unfounded infringement allegations in a press release may therefore cause competitors to withdraw their products from the market or at least to change their behavior.

This article is based on the answers for AIPPI Study Question Q 292 provided by the German National Group of the AIPPI on the law and practice in Germany.² It will discuss six common types of allegations of infringement of IP rights and compare the applicable legal criteria to the Resolution adopted by the AIPPI on this issue at their congress in Hangzhou on 22 October 2024.

I. Warning letters

In practice, the most relevant category of infringement allegations are warning letters (*Abmahnungen*), i.e. formal infringement notices by which the addressee is, under threat of legal action, requested to refrain from the allegedly infringing conduct and to sign a cease-and-desist-understanding subject to a contractual penalty.

Although warning letters are recognized as a desirable means to settle an infringement dispute without expensive and time-consuming court proceedings, they may put a severe threat on the addressee and cause him to cease the incriminated conduct regardless of whether the infringement allegation was founded. Warning letters vis-à-vis customers or distributors (so-called customer warnings) can be particularly harmful not only to their addressees but to the manufacturer, because customers who receive a warning letter may switch to other products and have therefore a lesser interest than the manufacturer himself in a legal dispute with the claimant. Accordingly, there is an increased risk that they simply cease the distribution of the concerned products as a precautionary measure and regardless of whether the allegation was justified.

Given these potentially adverse effects, unjustified allegations of an IP infringement are seen as tortious acts under sec. 823(1) German Civil Code.³ If it turns out that the infringement allegation was unfounded, e.g. due to non-infringement or the invalidity of the asserted IP right, the law provides for an injunction against the claimant.⁴ The assessment whether a warning letter is unfounded is made objectively and with hindsight. It is not relevant whether the claimant acted in good faith or whether the warning letter was sent with abusive intent.

Moreover, the law provides for damages, on the condition that the unjustified warning letter was culpably issued, i.e. with negligence or intent. As a rule, an IP right holder is not considered to have acted culpably if he was convinced of his legal position based on diligent and thorough examination, and his actions were based on reasonable and fair deliberations.⁵

An injunction or, as the case may be, damages can also be granted if the warning letter is considered as unfair competition practice. This is particularly relevant in case of customer

¹ See Summary Report for Q292: <https://aiippi.soutron.net/Portal/Default/en-GB/DownloadImageFile.aspx?objectId=9921&ownerType=0&ownerId=6129>. The adopted Resolution can be found at <https://aiippi.soutron.net/Portal/Default/en-GB/RecordView/Index/6-125>.

² The answers of the German Group to AIPPI Study Question Q292 can be found under <https://aiippi.soutron.net/Portal/Default/en-GB/RecordView/Index/5090>. The authors of the answers were, in addition to the authors of this article: Carsten Plaga, Stefan Schohe, Detlef von Ahsen, Lars Baum, Ole Dirks, Matthias Rößler, Matthias Hülsewig.

³ BGH, decision of 15-07-2005, GSZ 1/04, GRUR 2005, 882 – *Unberechtigte Schutzrechtsverwarnung*.

⁴ Injunctions can be granted under sec. 1004 para. 1, 823 para. 1 German Civil Code.

⁵ BGH, judgment of 11-01-2018, I ZR 187/16, GRUR 2018, 832 para. 88 – *Ballerinaschuh*.

warnings which may, depending on the circumstances, qualify, for instance, as a discreditation of competitor's goods under sec. 4 no. 1/2 UWG, a boycott or another unlawful obstruction of competitors (sec. 4 no. 4 UWG) and/or a misleading commercial practice under sec. 5 para. 2 no. 3 UWG.

II. Authorization Enquiries

As an alternative (or preparatory) instrument to a warning letter, an authorization enquiry (*Berechtigungsanfrage*) is established in the German legal practice. Such an enquiry substantiates only a potential infringement of an IP right by the addressee and requests a statement as to why the addressee considers himself either not to make use of the IP right or to be entitled to do so.

As an authorization enquiry contains no threat with court proceedings and typically no definitive allegation of infringement but rather concludes with an invitation to discuss the legal situation, it is usually considered as a reasonable and proportionate measure to clarify the situation even if it ultimately turns out that it was unjustified. It therefore does not trigger any legal consequences.

III. Court Proceedings

If an IP right holder fears his IP right to be infringed, he has basically two ways to enforce it in court: For a quick relief



barring the infringer from continuing his infringing actions he may file a motion for an interim injunction. It is usually issued after the accused infringer has been heard by the court or at least by the IP right holder via a warning letter. Especially if a patent or a utility model is in suit, the court will schedule an oral hearing before issuing the interim order. Oftentimes, the order is enforceable without a security deposit provided by the applicant.⁶

The other way to pursue an alleged infringement is via a proceeding on the merits. In such an action, the claimant may seek injunctive relief as well as other remedies.

If a patent or utility model holder does not yet have enough information to prove the infringement in court, he may – as a third court option – initiate proceedings for a so-called order of inspection.⁷

For all these proceedings, the so-called “procedural privilege” applies. The procedural privilege is a well-established principle of German civil procedural law. It is not explicitly

mentioned in the statutory law but was developed by the German courts. Its reasoning is that the initiation of any proceedings established and regulated by law does not unlawfully interfere with a protected legal interest of the adversary.⁸ The possibility of unjustified claims is an imminent feature of any legal proceeding.⁹ Within a legally provided framework it does not matter whether the sought judicial remedy is objectively justified and/or the other party suffers disadvantages from the proceedings. The defendant does not need any additional protection since the established legal framework already provides protection if he was pursued without justification. This means that the defendant is entitled to claim the statutory costs of legal representation if the asserted infringement is held unfounded.

Unlike for the warning letter, there is no differentiation between the nature of the defendants, whether a court proceeding is initiated against the customers or distributors or the product manufacturer himself.

However, the procedural privilege is not without boundaries. An exception is made if the claimant initiates the court proceedings in bad faith. In the (very) exceptional case of abusive court proceedings, the procedural privilege does not strike for the claimant. On the contrary, an abusive court proceeding may create a liability for intentional immoral damage. To the knowledge of the authors, there exists no decision in Germany finding that an IP right holder has abusively asserted his right in a court proceeding.

IV. Border Seizures

Under German law, liability for unjustified seizures is strict. Sec. 142a(5) of the German Patent Act and sec. 149 of the German Trademark Act require IP holders to compensate the target of the seizure for damages caused by wrongful detentions, even when enforcement was initiated in good faith. The justification of a border seizure is assessed using an objective hindsight test, examining whether the enforcement action was legally sound at the time it was taken.



Parties harmed by wrongful seizures can seek several remedies, including damages and injunctions.

V. Take-Down Notices

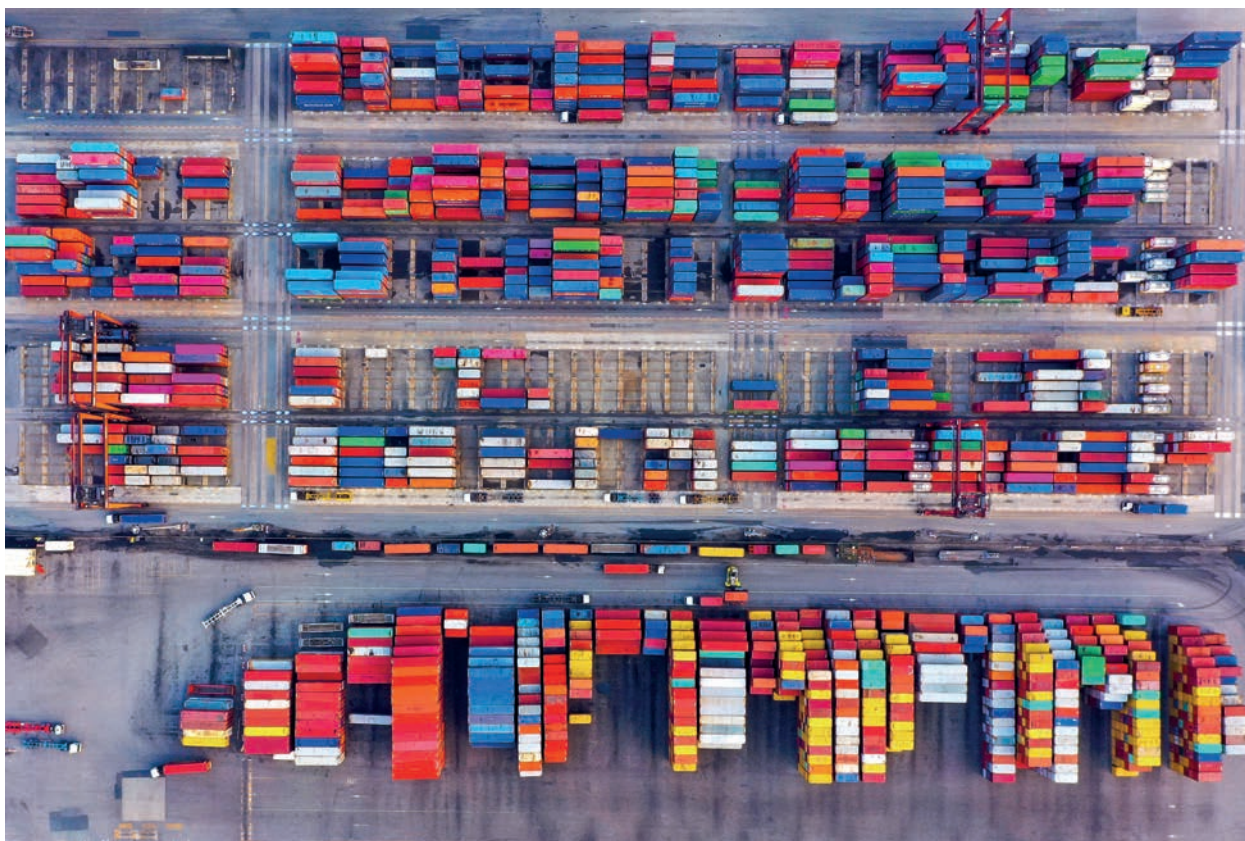
Although a take-down notice based on an unjustified allegation of infringement is a serious matter, the German law does not address this issue directly. However, German courts

⁶ LG München I, judgment of 24-07-2020, 21 O 8569, GRUR-RS 2020, 27094.

⁷ BGH, order of 16-11-2009, X ZB 37/08 – Lichtbogenschneidung.

⁸ BVerfG, order of 25-02-1987, 1 BvR 1086/85, NJW 1987, 1929 – Schadenersatz durch Straf-anzeigeerstatte.

⁹ BVerfG, order of 29 -05-2015, 1 BvR 163/15, NJW 2015, 3083 para 15.



have treated an unjustified take-down notice as an unjustified warning letter from the right holder, prompting the same legal consequences for the sender.¹⁰

It has been ruled that an allegation prompting a take-down notice may be unjustified for formal and/or for substantive reasons. Formally, an allegation notification might be unjustified because it does not indicate exactly on which specific IP right in which specific version of the claim it is based. On the substantive side, it might be unjustified because there is no infringement of IP rights.

VI. Press Releases and Other Public Allegations

The use of press releases to communicate allegations of IP infringement is a potent tool for IP holders.

Public allegations of IP infringement in press releases are primarily evaluated under the principles of competition law. Courts consider whether the statements are value judgments (*Werturteile*) or factual allegations.

The German Federal Court of Justice found that even value judgments must be substantiated by reliable evidence if they imply facts capable of verification.¹¹ In another decision, the court highlighted the delicate balance between freedom of expression and the obligation to maintain fairness in competitive practices.¹²

These rulings underscore the importance of substantiation, clarity, and balance in press releases alleging IP infringement. Statements that fail to meet these standards risk being classified as misleading or defamatory, exposing the issuer to legal remedies under competition law.

VII. Conclusion and Outlook

In sum, the described German approach for judging whether an infringement allegation was unjustified corresponds largely to what Study Question Q292 called an “objective hindsight-based view on whether the IP right in question was valid and infringed.”¹³ Study Question Q292 contrasted this with an approach based on “the reasonable subjective belief of the IP right holder”.

In practice, the German approach works well due to relatively clear rules, and despite the objective hindsight-based test, IP assertions in Germany are not less frequent than in other jurisdictions. However, compared internationally, this view is rarely shared. The study conducted by the AIPPI in preparation of its annual Congress in Hangzhou from October 18 through 22, 2024 revealed that the objective hindsight-based view was not preferred by 80% (28 out of 35) of the National Groups of the AIPPI. According to the prevailing view, an allegation of infringement which later is proved incorrect, should not be categorically considered as unjustified allegations regardless of the knowledge of the parties.¹⁴

Nonetheless, too much emphasis on subjective criteria seems at least impractical. For instance, the alleged infringer will hardly be able to prove criteria like actual knowledge of circumstances leading to non-infringement or invalidity of the IP right. Furthermore, the legal costs should be borne by the party that was objectively wrong in the assertion of claims. Ultimately, according to the view of most members of the German delegation and the authors of this contribution, it remains a challenge to find an approach that is both internationally acceptable and practicable.

¹⁰ LG München I, judgment of 14-10-2021, 7 O 12732/20, GRUR-RS 2021, 31805 – *Starthilfegerät*.

¹¹ BGH, judgment of 15-05-2009, I ZR 82/07 – *Mecklenburger Obstbrände*.

¹² BGH, judgment of 01-03-2018, I ZR 264/16 – *Verkürzter Versorgungsweg II*.

¹³ Summary Report for Q292, *supra* note 1, question 9.

¹⁴ Summary Report for Q292, *supra* note 1, question 13a.