

Johannes Heselberger

IAM says: “Johannes Heselberger approaches each case with exceptional judgement, guiding us to the best decisions possible in a difficult legal environment. Over decades of practising law, he has built a deep well of credibility and respect from the German judges handling patent cases.”

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Biography

Johannes Heselberger has a degree in physics and comprehensive technical experience in the fields of telecommunications, medical devices and automotives. He has also practised in pharmaceutical and biotech cases, including extremely rare proceedings for a compulsory licence. Mr Heselberger's expertise in SEP and FRAND litigations, as well as in enforcement of and defence against licence programmes, makes him a highly sought-after adviser.



What led you to a career in intellectual property and what would be your advice for anyone considering a similar career path?

It was my interest in both technical matters and law. To carve out the core of technical issues for legal evaluation is still a thrill that I enjoy every day.

In April 2022, the Court of Justice of the European Union (CJEU) found that the preliminary injunction practice of the Munich Higher Regional Court was incompatible with Directive 2004/48. What impact could this – or should this – have on German and European patent litigation strategies?

I am not sure whether the practice of the Munich Higher Regional Court is, indeed, the way the CJEU thought it is. In any event, the CJEU made it clear that a request for preliminary injunction must not be judged based on formalistic rules but needs to be considered on a case-by-case basis. In particular, the validity of the patent-in-suit must be considered individually and all available information must be taken into account. Although this decision is unlikely to change the landscape of patent litigation in Germany, plaintiffs and courts should be heartened to request and issue, respectively, preliminary injunctions if they are convinced of the patent's validity – even if the formal validity test has not yet been passed.

You have said: “Arguments win cases. Developing these arguments and their presentation in the courtroom is what has always fascinated me.” What are your three top tips for developing winning arguments?

First, the argument must be technically truthful and legally sound. No one can successfully fight for arguments that, at the end of the day, are non-existent.

Second, your argument should be simple. If it needs more than three sentences to explain on the highest level of abstraction, it will be difficult to sell. Complexity is a deterrent. Finally, and that being said, the simple truth needs thorough underpinnings of explanations and proof. Therefore, a short high-level argument requires regular and detailed briefs to support the line of thinking.

What are some of the biggest challenges facing your clients at present – and what steps can they take to mitigate them?

SEPs that fail to define the core of the client's products, but only side aspects thereof (eg, a refrigerator with a WiFi connection), is a big issue. To combat this, familiarise yourself with the landscape of SEP licensing and litigation early on and take measures to mitigate risk (eg, by buying from licensed suppliers, by planning design-arounds). When it comes to SEP licensing and litigation, the determination of FRAND licence rates is another concern. One solution is to try to utilise economic intelligence in order to form arguments. Finally, there is a lot of uncertainty around the UPC, a new court system with completely new rules, which are untested and which cannot be interpreted from the solid grounds of any individual legal system. To deal with this you should listen, think and have discussions with practitioners as to what they think and expect.

The UPC is finally set to launch later this year. What have you been doing to prepare?

Read, think, discuss and teach – the latter in order to learn from the questions. It is an ongoing effort. But using all of our lawyers' skills, the UPC will develop into a big success story for our clients, ourselves and the judges who are taking on the burden of shaping the new system – hundreds of years after their home systems were erected.