

Preliminary Injunction in Patent and Utility Model Cases

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Introduction

In particularly urgent cases, intellectual property rights owners may apply for a preliminary injunction instead of, or at the same time as, proceedings in the main case. Speed is often imperative if an infringing product is launched on the market, especially if it is sold at an undercut price causing lasting damage to the intellectual property rights owner for which he is unlikely to be adequately compensated.

For a preliminary injunction to be issued there must be a clear infringement of intellectual property rights without serious doubt as to the validity of the patent or utility model. The intellectual property rights owner is also required to act quickly as soon as he becomes aware of all relevant circumstances of the infringement of his rights.

Patent and utility models are basically enforced in the same way. The following therefore applies to the assertion of both patents and utility models, except where express reference is made to differences.

1. What can be achieved with a preliminary injunction?

A preliminary injunction primarily makes it possible to enforce the cease-and-desist claim quickly, such as for example stopping the display of infringing products at a trade fair or the import of the infringing products into Germany.

In case of obvious infringement of intellectual property rights, the rights owner can also request information about the origin of the infringing product and its distribution channels. However, a claim for damages and the claim for rendering of accounts in preparation for the damages claim cannot be asserted by means of a preliminary injunction.

For securing the right to destroy infringing goods a safe custody by the bailiff can be

ordered by the court in order to prevent their sale or delivery. However, their destruction requires a subsequent order by a court.

2. Procedure for preliminary injunction proceedings

A request for the issuance of a preliminary injunction is submitted to the presiding judge immediately on receipt by the court. As for the proceedings in the main case, jurisdiction is held by the specialised patent litigation chamber of any of the 12 selected district courts in Germany. Preliminary injunction proceedings are brought most frequently before the regional courts of Duesseldorf, Mannheim, Munich and Hamburg.

If a preliminary examination of the request satisfies the court that the request for the issuance of a preliminary injunction will probably not have any chance of success, the court will often notify the claimant of its assessment in order to give him the opportunity to withdraw the request. This is because withdrawal at this point in time results in considerably lower costs. However, in contrast to previous practice, it is to be assumed on the basis of several new decisions issued by the Federal Constitutional Court in the fields of press law and law on fair trading practices that such an indication is placed on record and is sent to the opponent, so that it becomes aware of the pending request for a preliminary injunction.

1. What can be achieved with a preliminary injunction?
2. Procedure for preliminary injunction proceedings

If the court deems the request to be founded, it can issue a preliminary injunction without hearing the opponent (*ex parte*). However, the Federal Constitutional Court clarified that, in general, such *ex parte* injunctions for enforcing the right to procedural equality of arms only come into consideration, if prior to this, the opponent was heard, meaning that the opponent was given the opportunity to comment on the accusations. For example, this is the case if the opponent was given the opportunity to reply to a pre-trial warning letter, either by an extrajudicial letter of response or by filing an anticipatory brief (see in this regard under item 4), if it is ensured that the individual substantiation in the request for preliminary injunction and in the warning letter are identical and the pre-trial responses of the opponent are available to the court in full. According to the findings of the Federal Constitutional Court there is, however, an exception from the principle of prior hearing of the opponent, if the hearing did obstruct the purpose of the preliminary injunction proceedings. Thus, it remains to be seen whether this exception will be affirmed in the case law of courts of lower instances in highly time-critical situations, such as, for example, trade fair matters, or if at least a warning with a short deadline is necessary.

If the opponent did not receive a pre-trial warning letter (and there is no threat of an obstruction of the purpose of the preliminary injunction proceedings either) or if, after consideration of the warning letter and of a corresponding response, the court has doubts

about the merits of the claim, it will order an in-person oral hearing (*inter partes* proceedings). This usually takes place between three weeks and three months after the request is filed, depending on how busy the court's schedule is. At the oral hearing the case is extensively discussed. The court then gives its decision, usually on the same day as the oral hearing.

An oral hearing or at least hearing the opponent's arguments in writing may exceptionally be in the claimant's interest if the opponent has its place of business abroad. For in case a preliminary injunction is issued without the opponent having been heard, enforcing such preliminary injunction abroad may be problematic.

A preliminary injunction issued by a court only has legal effect from the date it is served on the opponent and/or his attorney for the action. This so-called execution (hereinafter referred to as enforcement in line with the terminology in main cases) of the preliminary injunction is incumbent upon the claimant. He must carry this out within one month of the date of issuance of the preliminary injunction. The claimant is not obliged to effect the enforcement since he also assumes liability for all and any damage which the opponent may suffer as a result of the enforcement should the preliminary injunction be lifted by a higher court.

Obtaining a preliminary injunction without enforcing it can nevertheless be useful in order to point out the legal situation to an essentially law-abiding opponent by informally sending

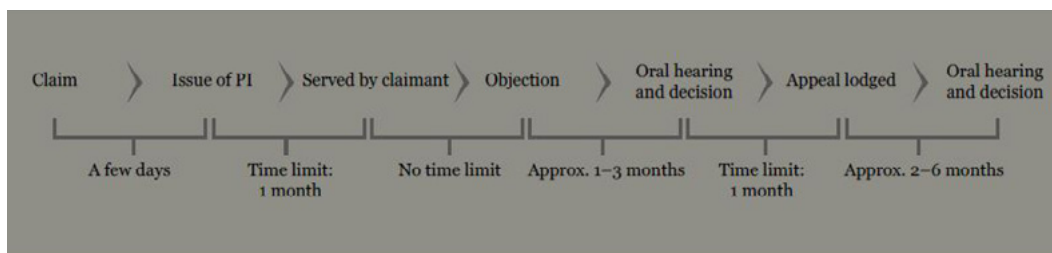
him the issued preliminary injunction to induce him to observe the intellectual property right.

amount of business the court is dealing with. An appeal on points of law is not admissible.

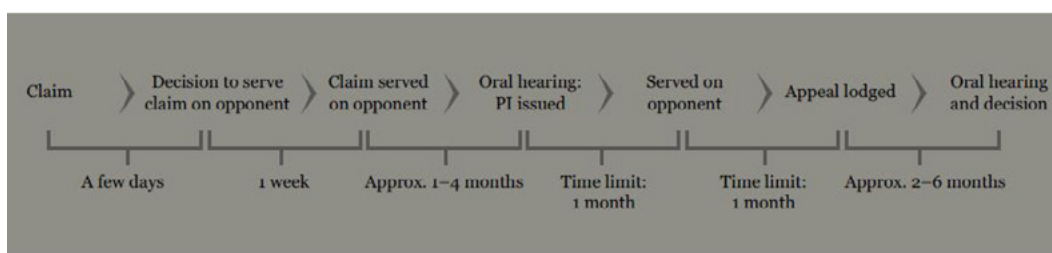
The opponent can lodge an objection against the issuance of a preliminary injunction (when it has been issued without an oral hearing) or an appeal (when it has been issued following an oral hearing). Lodging an objection or an appeal cannot prevent the enforcement of the preliminary injunction, *i.e.* the injunction order remains in force until the court has decided on the objection or appeal. Only in very few exceptional cases can the opponent request the enforcement of the preliminary injunction to be cancelled. Objection or appeal proceedings last between two to six months, depending on the

Should a request for the issuance of a preliminary injunction be rejected, the claimant is entitled to lodge an objection (in the case of rejection without an oral hearing) or an appeal (in the case of rejection following an oral hearing). These means are of little practical importance since the preliminary effect is lost, especially in trade fair matters, if it is not granted immediately. In the case of a preliminary injunction being granted, the timescale for preliminary injunction proceedings in patent and utility model matters is typically as follows:

Issuance of preliminary injunction (PI) without oral hearing:



Issuance of preliminary injunction (PI) following oral hearing:



3. Requirements for a preliminary injunction

3.1 Claim to an injunction

3.2 Grounds for an injunction

3. Requirements for a preliminary injunction

In order to obtain a preliminary injunction, the claimant must “substantiate by prima facie evidence” that the patent-in-suit has been infringed (claim to an injunction) and that the enforcement of the patent-in-suit by means of the preliminary injunction rather than by the usual, slower main proceedings, is necessary and justified (grounds for an injunction).

3.1 Claim to an injunction

The same as in principal proceedings, the claimant must first set out his entitlement to assert the injunction claim against the opponent. He must substantiate the facts on which this claim is based. While substantiation does not require full evidence, it must nevertheless prove an overwhelming degree of probability.

As means of substantiation any evidence is permissible, provided that it can be put before or presented to the court at the oral hearing, such as, for example, certificates or present witnesses. In particular, unlike in principal proceedings, reference may also be made to affidavits.

3.2. Grounds for an injunction

In examining the grounds for an injunction the court weighs the different parties’ interests. The interest of the claimant in having his intellectual

property right enforced immediately to prevent imminent disadvantages must be weighed against the disadvantages which the opponent might suffer as a consequence of the issuance and/or enforcement of the preliminary injunction.

Of particular importance is the so-called urgency with respect to time. The claimant must show that he has reacted as quickly as possible to the identified infringement of the intellectual property right by the opponent. Although there is no absolute or legal time limit, the claimant should wait no longer than one month from the time he obtains certain knowledge of the infringement of an intellectual property right and the infringer’s identity before filing a claim for the issuance of a preliminary injunction. On the question of urgency, rulings by the competent patent litigation chambers can differ quite considerably.

The claimant’s interests are regarded as less worthy of protection especially if the validity of the patent-in-suit is not deemed to be sufficiently secure, *i.e.* if pending nullity or opposition proceedings against the patent-in-suit have a good chance of success. Previously successful nullity or opposition proceedings, or the granting of a licence for the patent-in-suit to well-known competitors has an indicative effect that the patent-in-suit is valid. In individual cases, and particularly according to the case law of the Düsseldorf and Mannheim courts, which the Higher District Court of Munich has also adopted now, it may be advisable for the claimant to

generally await the outcome of a pending nullity or opposition proceedings before submitting the request.

In the case of a claimant wishing to enforce a utility model which has been registered by the German Patent and Trade Mark Office without examination of the protectability of the subject matter of the claim (so-called registration property right), a detailed submission and substantiation of the protectability of the subject matter of the claim must be made.

3.3 The court's decision

The court's decision on the request for preliminary injunction is a summary decision which requires consideration of a number of factors and the assessment of the substantiation of a variety of facts.

The court can make the enforcement of the preliminary injunction subject to the provision of security by the claimant in order to secure potential disadvantages the opponent may suffer from the enforcement.

4. Protective letters

The effectiveness and danger of preliminary injunctions lie in the speed with which they are issued and the summary examination of the entitlement of the claims being asserted. Even if the relevance of surprising effects of the issuance of ex parte injunctions (without prior warning letter) decreased due to the new case

law of the Federal Constitutional Court, such ex parte injunctions are still possible.

To avoid the surprise effect resulting from this, in other words to ensure that an oral hearing is held, but also as a means of ensuring that the opponent's defence arguments are heard in any case, the filing of protective letters by the defendant is provided for by law.

A protective letter is a precautionary brief by a potential opponent, which sets out all the defence arguments that could prevent the issuance of a preliminary injunction, or at least delay it. Protective letters are deposited in the central, transnational, electronic register of protective letters without reference to an already pending procedure. They shall be deleted six months after its submission. The potential claimant remains unaware of this if he does not file a claim for the issuance of a preliminary injunction.

Lodging a protective letter, however, entails the risk that a request for the issuance of a preliminary injunction is made conclusive only by the statements of the opponent in the protective letter. Further, in case of a protective letter, in particular if it is lodged in reaction to a prior warning letter, there is the risk that the court may assume a sufficient hearing of the opponent in the protective letter so that it might issue ex parte injunction without hearing the opponent further.

The costs of a protective letter are reimbursable in proceedings for determination of costs if a request for the issuance of a preliminary injunction is in fact submitted.

3.3 The court's decision

4. Protective letters

5. When is it better to apply for the issuance of a preliminary injunction rather than proceedings in the main case?

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A claim for the issuance of a preliminary injunction should be considered if, as a result of an infringement of intellectual property rights, there is the danger of particular damages for which there is no compensation and hence there is an urgent need to stop the infringement as quickly as possible. This is typically the case in the run-up to or during important trade fairs, or in the case of a competitor launching an infringing product in Germany.

On the other hand, by enforcing a preliminary injunction the claimant assumes liability should the injunction be subsequently lifted, be it because the patent-in-suit proves invalid, be it that there is insufficient evidence to justify the urgency of the claim, or be it because the infringement of the patent-in-suit is not determined.



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