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Higher Regional Court of Munich on the requirements for the reasons for a preliminary injunction in patent litigation – change of previous case law (judgment of December 12, 2019 – Case 2 U 4009/19[1]) – *"Leiterklemme"*
Reported by *Nadine Westermeyer*

Nadine Westermeyer
Attorney-at-Law (Rechtsanwältin), Partner

Abstract

1. In patent litigation, the reasons for an injunction necessary for the issuance of a preliminary injunction generally require that the validity of the patent-in-suit may clearly be assessed in favor of the applicant.

   The question whether the validity of a patent-in-suit is sufficiently certain needs to be assessed based on the standard of a high probability. This may generally only be assumed if the patent-in-suit has already survived first instance opposition or nullity proceedings or if an exception applies (change of previous case law of Higher Regional Court of Munich, judgement of July 26, 2012, case 6 U 1260/12, BeckRS 2012, 16104; following case law of Higher Regional Court of Duesseldorf, judgment of December 14, 2017, 2 U 17/18, BeckRS 2017, 142305, and Higher Regional Court of Karlsruhe, judgment of September 23, 2015, 6 U 52/15, GUR-RR 2015, 509 – *Ausruestungssatz*).

2. A violation of the defendant's right to be heard in the first-instance proceedings due to a tightly scheduled procedure can be cured by further proceedings and remains unpunished insofar as the defendant had sufficient opportunity to deal with the infringement issue and the validity of the patent-in-suit and to present its case prior to the second-instance hearing.

3. A utility model, which is an unexamined intellectual property right, generally does not form a suitable basis of a preliminary injunction.

Facts of the case

Only 5 days after the grant of the patent-in-suit, the plaintiff claimed injunctive relief from the defendant for patent infringement by way of preliminary injunction proceedings.

The oral hearing on the request for a preliminary injunction before the Regional Court of Munich I took place only 10 days after the request had been filed.

The Regional Court issued the requested preliminary injunction, finding:

BARDEHLE PAGENBERG
Partnerschaft mbB
Patentanwälte Rechtsanwälte

Prinzregentenplatz 7
81675 München
T +49.(0)89.928 05-0
F +49.(0)89.928 05-444
info@bardehle.de
www.bardehle.com

ISO 9001 certified

1 LINK to source: Judgment of the Higher Regional Court of Munich, December 12, 2019 – Case 2 U 4009/19

> The attacked embodiments make use of the teaching according to the literal sense of claim 1 of the patent-in-suit. There also is a reason for an injunction. The required urgency exists, and the legal validity of the patent-in-suit is sufficiently certain. The objections asserted by the defendant do not give rise to any doubt as to the validity of the patent-in-suit. Lastly, the reason for the injunction also is to be affirmed after having weighed all the circumstances of this individual case.

The defendant appealed against the first instance conviction, arguing:

> There is not even a claim for the injunction. In addition, the Regional Court wrongly affirmed a reason for the injunction. Even the required urgency is lacking, since the plaintiff should have based the request for a preliminary injunction on a parallel utility model registered earlier. Furthermore, the Regional Court erred in law in assuming that the legal status of the patent-in-suit is sufficiently certain, and weighing the interests of the parties to this individual case should have resulted in a judgment in favor of the defendant, particularly because the patent-in-suit had only just been granted and had not yet survived any first instance opposition or nullity proceedings. In addition, the defendant was considerably restricted in its possibilities of presenting the prospects of success of validity proceedings due to the tightly scheduled conduct of the proceedings by the Regional Court.

The Munich Higher Regional Court reversed the injunction issued at first instance and rejected the plaintiff's request for a preliminary injunction.

Findings of the Court

1. The Higher Regional Court of Munich upheld the first-instance judgment in so far as it found a claim for injunction. However, in the opinion of the Higher Regional Court, the preliminary injunction had to be revoked because there was no reason for a preliminary injunction.

   In express deviation from its previous case law – and in accordance with the case law of the Higher Regional Courts of Duesseldorf and Karlsruhe –, the Higher Regional Court of Munich now takes the legal view that a sufficiently certain legal validity of the patent-in-suit justifying the issuance of a preliminary injunction can generally only be assumed if the patent-in-suit has already survived first-instance opposition or nullity proceedings.

   In the absence of a first-instance decision in validity proceedings, issuing a preliminary injunction may only be considered if a special exception applies. The Senate lists the following exceptional cases (again in accordance with the case law of the Higher Regional Court of Duesseldorf in particular):

   - The defendant contributing its own observations to the grant procedure of the patent-in-suit, so that these proceedings were already conducted as a "quasi" bilateral procedure;

   - the general recognition of the validity of the patent-in-suit (for

example, in the form of the existence of well-known licensees or the absence of attacks on the validity of the patent despite infringement attacks);

- the objections against the validity of the patent-in-suit turn out to be unfounded even in summary examination;

- the existence of extraordinary circumstances which render waiting for the first-instance opposition or nullity proceedings or enforcing the claims in main proceedings inappropriate.

The Senate justifies its decision by stating that it is not the task of the infringement court to anticipate the legal validity of the patent-in-suit de facto by means of an urgent decision in proceedings for preliminary legal protection. It states that, with the means available to it in such proceedings, the infringement court is only able to assess the outcome of the validity proceedings to a limited extent and to an extent that does not satisfy the parties. The Senate continues that this is also shown by the fact that recent forecast decisions on the protectability of patents-in-suit in favor of the plaintiff for a preliminary injunction have proven to be incorrect.

2. Insofar as the defendant complained about the violation of its right to be heard due to the tightly scheduled conduct of the first-instance proceedings, the Senate states that this violation of the right to be heard at the first instance was cured by the subsequent proceedings, since the defendant had sufficient opportunity to deal with the infringement issue and the validity of the patent-in-suit and to present its case prior to the second-instance oral hearing.

3. Finally, the Higher Regional Court of Munich points out that the registration of a parallel utility model is irrelevant. As an unexamined intellectual property right, a utility model usually does not constitute a suitable basis of a preliminary injunction, since the plaintiff usually cannot demonstrate and substantiate its protectability. In particular, the Court states, the notification pursuant to Rule 71 (3) EPC of the intended grant of a European patent with identical contents is not sufficient on its own to substantiate the validity of the utility model.

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Remarks

The present decision is in the context of the case law of the Higher Regional Courts of Duesseldorf and Karlsruhe, which has become established case law there in the past few years. According to this case law, a sufficiently certain validity of the patent-in-suit, a requirement for the issuance of a preliminary injunction, can generally only be assumed if a decision confirming the protectability of the patent has already been rendered in opposition proceedings before the European Patent Office or in nullity proceedings before the Federal Patent Court (see Higher Regional Court of Duesseldorf, judgment of December 14, 2017, 2 U 17/18, BeckRS 2017, 142305, and Higher Regional Court of Karlsruhe, judgment of September 23, 2015, 6 U 52/15, GUR-RR 2015, 509 – *Ausruestungssatz*).

After having taken a legal view deviating from such case law so far, taking the stance that a patent-in-suit does not have to have survived opposition or nullity proceedings for a request for a preliminary injunction for patent infringement to be successful (cf. judgment of July 26, 2012, 6 U 1260/12, BeckRS 2012, 16104), the Higher Regional Court of Munich now expressly follows the established case law of the Duesseldorf and Karlsruhe Higher Regional Courts in its current decision.

This harmonizes the case law regarding an elementary requirement for the affirmation of the reasons for an injunction in proceedings for a preliminary legal protection for the three most important German locations for patent litigation.

With its decision, the Higher Regional Court of Munich is making obtaining preliminary injunctions based on "hot off the press" patents more difficult at this place of jurisdiction as well. As a result, patents will regularly be excluded from preliminary legal protection for a considerable period of time – apart from special exceptions which have been explicitly listed and must be demonstrated in each individual case.

With this change in case law, the Higher Regional Court of Munich specifically also reacts to the fact that a considerable number of opposition and nullity proceedings lead to the revocation, nullification or restriction of patents.