

Alert 10-167



Preliminary injunctions in patent matters – current developments

Preliminary injunctions are a powerful tool, in particular in patent matters, as they usually force the stakeholder to immediately take his elaborately introduced product from the market. Therefore, there were good reasons for the courts to be reluctant in issuing such injunctions.

Now, the courts are developing the interim relief in patent cases with surprising speed, but some points remained unclear. It is therefore a welcome development that the Appellate Court of Düsseldorf recently (judgment of 29 April 2010, 1-2 U 126/09, InstGE 12, 114 = Beck RS 2010, 15862) took the opportunity to sharpen the requirements, in particular with regard to the necessary validity of the patent-in-suit.

Preliminary injunctive relief for patent infringement only comes into consideration if the validity of the injunction patent and the patent infringement at issue are crystal clear in favour of the applicant, that an erroneous decision in the subsequent merits-proceeding that would have to be revised cannot reasonably be expected.

However, a dismissal of the petition for an injunction for dubious validity of the injunction patent generally requires that the validity of the patent-in-suit is indeed challenged in related opposition or nullity proceedings, or that a related attack is reliably foreseeable.

If the petition for an injunction is submitted shortly after grant of the patent, i.e., at the beginning of the opposition period, the defendant will in many cases not be in a position to conduct a substantive search regarding opposing prior art. In this case, according to the Appellate Court of Düsseldorf, a dismissal must also be anticipated even if the defendant does not submit concrete prior art, because the status of the patent is unclear and there is the possibility that with respective research, relevant prior art can be found.

As soon as the validity of the patent is challenged in opposition or nullity proceedings, or a related attack is at least foreseeable, the applicant bears the burden of proof that these attacks lack any substance, so that the injunction patent will be upheld with certainty. German translations of foreign citations must be provided by the plaintiff if required.

The Appellate Court of Düsseldorf stresses that validity can generally only be assumed if the patent-in-suit has already survived a first-instance opposition or nullity proceeding. There are only limited exceptions to this rule, i.e.:

- If the defendant has already participated in the examination procedure with its own objections so that factually, the grant of the patent is equivalent to a decision in a contentious proceeding
- If the opposition or nullity proceeding has not been carried out because the patent was accepted as generally valid. The existence of respective license agreements may be an indication for this.
- If the submitted objections against the validity of the patent are obviously without merits, or
- If, with respect to the market situation or the imminent disadvantages resulting from the infringement, extraordinary circumstances are present that make it unreasonable for the plaintiff to await the outcome of an opposition or nullity action

At this occasion, the court in Düsseldorf refers to its earlier Olanzapin decision (InstGE 9, 140), according to which even after revocation of the patent-in-suit in the first instance, a preliminary injunction will be considered if the decision revoking the injunction patent is obviously erroneous. However, this requires specific disadvantages for the applicant that

would result from a referral to the outcome of the opposition appeal or nullity appeal proceeding.

The current decision shows that the courts have found a practicable way to meet the legitimate interests of the patent owner in case of infringement. At the same time, the bar is raised with regard to the validity that ultimately takes account of the interests of the defendant in an injunction proceeding. It remains to be seen what results this system will bring across the board.

→ [Dr. Richard Schlötter](#)
Partner, Munich
+49 (0)89 20304 158

About Reed Smith

Reed Smith is a global relationship law firm with nearly 1,600 lawyers in 22 offices throughout the United States, Europe, Asia and the Middle East. Founded in 1877, the firm represents leading international businesses, from Fortune 100 corporations to mid-market and emerging enterprises. Its lawyers provide litigation and other dispute resolution services in multi-jurisdictional and other high-stakes matters; deliver regulatory counsel; and execute the full range of strategic domestic and cross-border transactions. Reed Smith is a preeminent advisor to industries including financial services, life sciences, health care, advertising, technology and media, shipping, energy trade and commodities, real estate, manufacturing, and education. For more information, visit reedsmith.com.

Europe: [London](#), [Paris](#), [Munich](#), [Greece](#)

Middle East: [Abu Dhabi](#), [Dubai](#)

Asia: [Hong Kong](#), [Beijing](#)

United States: [New York](#), [Chicago](#), [Washington](#), [Los Angeles](#), [San Francisco](#), [Philadelphia](#), [Pittsburgh](#), [Oakland](#), [Princeton](#), [Northern Virginia](#), [Wilmington](#), [Silicon Valley](#), [Century City](#), [Richmond](#)

© Copyright 2010 Reed Smith LLP. All Rights Reserved.

The information contained in this Alert was compiled by Reed Smith LLP as a summary of the subject matter covered and is intended to be a general guide only and not to be comprehensive, nor to provide legal advice. All information provided in newsletters and publications is thoroughly reviewed by Reed Smith LLP. However, Reed Smith LLP takes no responsibility for the correctness, completeness and up-to-dateness of the information. The complete Impressum (Legal Notices) can be viewed at www.reedsmith.com/telemediengesetz/telemediengesetz_english.cfm.

Questions or comments? Please e-mail RSGermanyClientServices@ReedSmith.com or contact us at Reed Smith LLP, Theatinerstrasse 8, 80333 München, +49(0)89 2030 410. Thank you.