

---

# Kluwer Patent Blog

## Waiting for urgency – a new strategic option?

Thomas Musmann (Rospatt Osten Pross) · Tuesday, May 25th, 2010

German courts (and German attorneys) have been quite creative to improve the position of the patentee in litigation in the past. Last year the Olanzapine- decision of the Appeals Court in Düsseldorf, which rendered a preliminary injunction although the patent had been previously nullified by the Federal Patent Court, has caused a sensation in the legal community.

Probably less sensational, but of far more practical impact could be a decision of the District court of Düsseldorf which has been rendered just recently also in preliminary injunction proceedings.

The District court rendered an ex parte injunction in the following scenario:

The patent was granted in 2007 and had been opposed by two competitors of the patentee, which both have been on the market with their products prior to the grant of the patent. After oral proceedings have been held the opposition division of the EPO maintained the patent and rejected the opposition. Even before the written decision was available the plaintiff filed a motion to grant a preliminary injunction against the opponents with the District Court of Düsseldorf.

The peculiarity of the case was the striking lack of urgency. The plaintiff apparently knew of the allegedly infringing products for several years already before he launched proceedings. The court has nevertheless granted the injunction, even ex parte. The service of the immediately enforceable injunction struck the defendants as a total surprise.

According to German procedural law preliminary injunctions, even more so ex parte injunctions are exceptional. One of the legal requirements for injunctive relief is urgency. The plaintiff has to pursue his claim without undue delay. In general, any time above one month is detrimental. In patent cases the courts tend to be more generous given the usually more complex nature of patent cases, nevertheless, any significant delay which cannot be justified by the complexity of the case is detrimental.

Here the patentee positively knew about the allegedly infringing activities of the defendants for several years. He could have filed a complaint already years ago.

The decision of the court was based on the assumption that the decision of the EPO rejecting the opposition has created a new situation which “resets the urgency clock”.

The rationale of this is the following: Unlike in proceedings on the merits, in preliminary injunction proceedings the infringement courts, although not competent to rule on the validity of

patents, are much more skeptical with respect to the strength of patents. Whereas in proceedings on the merits they disregard an attack on the validity of a patent unless they see a high likelihood of success, in preliminary injunction proceedings they require that the plaintiff convinces the court that the patent is strong. The most convincing way to show the strength of a patent is to refer to the decision of a competent court (or judicial body as the EPO) confirming the validity. If the patent is “fresh” or has not been subject to attacks in the past, it is much more difficult to meet this requirement. In view of this the court was of the opinion that before the decision of the EPO has been issued, plaintiff could not have filed a motion for a preliminary injunction with a reasonable expectation of success. It referred to a previous decision of the court confirmed by the Appeal Court of Düsseldorf in this respect, which however dealt with a different situation.

Although it is true that without the EPO decision the chances to obtain a preliminary injunction (ex parte) were remote, plaintiff could have filed proceedings on the merits already years ago without any problem and would have obtained an injunction much earlier, even a second instance verdict by then.

If the reasoning of the court will govern the future praxis, it probably will drastically change the strategy of patentees at least if they have a strong focus on the German market. Instead of filing proceedings on the merits once the patent is granted it might be worthwhile to consider waiting for a decision of the EPO, which even could be indirectly initiated and then use the preliminary injunction afterwards as a forceful weapon. The loss in time at the beginning would be outweighed by the speed and impact of an (ex parte) injunction.

Likewise defendants should carefully consider whether the advantage of the opposition procedure, which allows the revocation of the patent for all member states outweighs the disadvantage of being the potential subject of a Preliminary injunction in Germany should the opposition fail in first instance.

The decision of the court is under appeal. Stay tuned for further developments.

Thomas Musmann

---

*To make sure you do not miss out on regular updates from the Kluwer Patent Blog, please [subscribe here](#).*

## **Kluwer IP Law**

The **2022 Future Ready Lawyer survey** showed that 79% of lawyers think that the importance of legal technology will increase for next year. With Kluwer IP Law you can navigate the increasingly global practice of IP law with specialized, local and cross-border information and tools from every preferred location. Are you, as an IP professional, ready for the future?

Learn how **Kluwer IP Law** can support you.

---

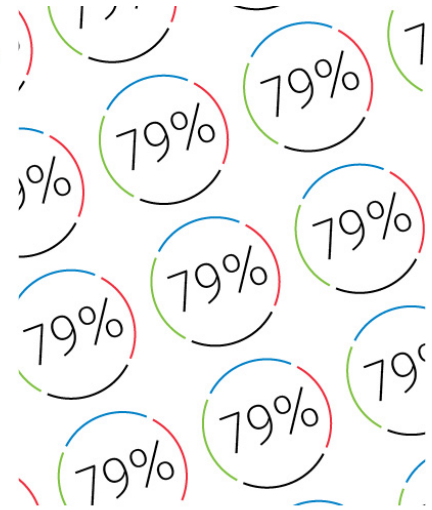
79% of the lawyers think that the importance of legal technology will increase for next year.

**Drive change with Kluwer IP Law.**

The master resource for Intellectual Property rights and registration.



2022 SURVEY REPORT  
The Wolters Kluwer Future Ready Lawyer  
Leading change



This entry was posted on Tuesday, May 25th, 2010 at 1:07 pm and is filed under [\(Indirect\) infringement](#), [Enforcement](#), [Germany](#), [Injunction](#)

You can follow any responses to this entry through the [Comments \(RSS\)](#) feed. Both comments and pings are currently closed.