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Validity of a German Utility Model Civil: Court vs. German Patent and Trademark Office

Thomas Musmann (Rospatt Osten Pross) · Friday, November 25th, 2011

by Miriam Büttner

In a recent decision of 15 September 2011 (ref. no. 4b O 99/11) the District Court of Düsseldorf (LG Düsseldorf) found that a non-final decision of the utility model cancellation division of the German Patent and Trademark Office (GPTO), with which the utility model was declared (partially) invalid, is not a sufficient reason to lift a preliminary injunction according to sec. 927 ZPO (Code of Civil Procedure). The decision is available on the website www.justiz.nrw.de.

What has happened?

The present defendant is registered owner of a German utility model regarding an ink cartridge, which can be used in inkjet printers. By way of a preliminary injunction, the present defendant requested with the District Court of Düsseldorf (LG Düsseldorf) to order that the present applicant shall cease and desist from infringing his utility model. In the end, his request was granted in September 2010 by the Higher Regional Court of Düsseldorf (OLG Düsseldorf) as the competent Court of Appeal .

Parallel to this infringement proceeding, the present applicant requested with the GPTO to partially cancel the defendant's utility model. In July 2011 the cancellation division complied with this request. The decision of the cancellation division is not final but under appeal.

After the decision of the cancellation division the present applicant requested with the District Court of Düsseldorf to lift the preliminary injunction granted by the Higher Regional Court of Düsseldorf due to the changed circumstances (sec. 927 ZPO). With its decision from 15 September 2011 the District Court of Düsseldorf refused this re-quest.

What is the legal background?

According to sec. 927 ZPO a preliminary injunction can be lifted when the uphold of the preliminary injunction is not justified anymore because meanwhile the requirements for such an urgent decision have fallen away. The court does not reassess if the original decision was justified.

Changed circumstances can for example be facts which arose only after the grant of the preliminary injunction or which already existed at this date but were unknown to the applicant. Furthermore it is common ground that specific legal changes can form such circumstances as a

change of the legal status by the legislation, a change of the case law of the Highest Courts, a revocation of the paragraph on which the preliminary injunction is based, a final decision in the main proceedings.

On the other hand, a new judicial estimation (of the liable party) or the improvement in parallel proceedings or pending (trademark) cancellation proceedings is not sufficient.

What is the reasoning of the court?

Considering this legal background the District Court of Düsseldorf found that in the present case no such changed circumstances have been presented by the present ap-plicant, which (for the moment) could lead to a lift of the preliminary injunction. He based its request only on a new non-final decision of the utility model cancellation division, with which the utility model has been declared (partially) invalid.

The court did not regard such a decision as changed circumstances in the meaning of sec. 927 ZPO, because during infringement proceedings regarding an utility model the court also has to evaluate the validity of the utility model. In this regard, the court has to estimate this question independently and come to a self-responsible conclusion. Thereby, the court also has to consider decisions of the cancellation divisions of the GPTO as competent comments on this issue, but such (non-final) decisions are not binding for the court due to the bifurcated system in Germany. According to this Ger-man legal principle the civil courts have to decide on the infringement of patents and utility models, while the GPTO/the Federal Patent Court has to decide on the universal validity of such intellectual property rights, but the validity question also arises inci-dentally during the infringement proceedings.

With its preliminary injunction the Higher Regional Court of Düsseldorf already evaluated the validity of the concerned utility model in detail. In this regard, the Higher Regional Court of Düsseldorf considered the same problems, arguments, substantiation, documents and prior art as the cancellation division of the GPTO. The Higher Regional Court of Düsseldorf and the GPTO came – with regard to the same facts – only to a different judicial evaluation. The decision of the Higher Regional Court of Düsseldorf only presents a different legal opinion than the decision of the cancellation division.

What is the conclusion of this decision?

Thus, during infringement proceedings the civil courts have to estimate the question of the validity of the utility model on their own. Decisions of the cancellation division of the GPTO can be a qualified support in this finding, but are not binding for the court as long as they are not final.

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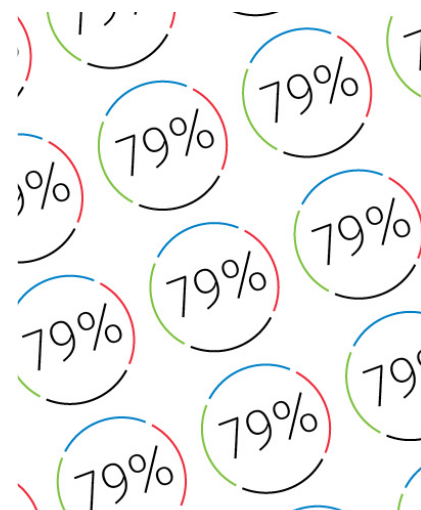
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