Kluwer Patent Blog

Preliminary Injunctions remain exceptional in patent cases

Markus Lenssen (Rospatt Osten Pross) · Friday, December 9th, 2011

Preliminary injunctions in patent disputes can be a very effective weapon to fight against free riders on the one hand but are equally hurtful for defendants being at-tacked unjustifiably on the other hand. Such preliminary injunctions, especially when granted on an ex parte basis, can simply hinder the defendant to conduct business on the market.

This is true in particular if a patentee strikes in with an ex parte preliminary injunction on a trade show. Under such circumstances, when there is only very limited time to fight against the injunction until the end of the show (typically only a few days) a rem-edy cannot be dealt with. Only after the trade show is over, an unjustifiably granted preliminary injunction would be lifted. Such remedy is than just useless for the de-fendant if the trade show is the main (and most often only existent) venue to estab-lish trade relationships, especially when the most important trade show in the industry does only happen every three years.

The Regional Court of Duesseldorf (Landgericht Düsseldorf) has now – again – ex-pressed its view on preliminary injunctions based on patents (court order of 13 May 2011, 4b O 88/11). Following the nowadays well-known decision “Harnkatheterset” of the Higher Regional Court of Duesseldorf (Oberlandesgericht Düsseldorf, decision of 29 April 2010, I-2 U 126/09), the Regional Court has rejected to grant a preliminary injunction right away and has asked the applicant to substantiate his request first. With his initial request, the applicant had asked the court to grant a preliminary in-junction to stop a Spanish competitor to exhibit an allegedly patent infringing device on an international trade show in Germany. The patent underlying this request was granted nine years ago and has never been attacked by anyone before. In addition, a corresponding patent had been granted in the US as well. Only shortly before the trade show the patentee had become alerted that his competitor did also build the patent protected machine now .

According to the decision “Harnkatheterset” of the Higher Regional Court of Duessel-dorf, a preliminary injunction based on a patent can only be granted if the validity of the patent is beyond doubt. Usually, this is only the case if the patent has already sur-vived a validity attack. A very limited exception to this rule might be acceptable if there has never been an attack on the validity of the patent because the patent is commonly respected as being valid. However, the hurdles to reach such common respect are very high. This has been highlighted by the Regional Court of Duesseldorf in the trade show case mentioned before. With its court order asking the applicant to substantiate his request for a preliminary injunction the Regional Court stated that the mere fact a patent stands unattacked for nine years is not sufficient to regard the patent as being commonly respected. Also the fact that there has been also a parallel US patent being in force did not impress

the court.

As a further side aspect of the case, the court also requested the applicant to give more substance to his statement that it was not known before that the defendant would market the attacked device outside of Spain. The court asked for more evidence in this regard as a preliminary injunction can only be granted if the matter is urgent and if the applicant has been tardy when asserting his rights. It seems that the court was sceptical whether there really was urgency with respect to the trade show or whether the applicant used the occasion of the trade show to facilitate service of an injunction.

In summary, getting a preliminary injunction based on a patent has never been easy and the Regional Court of Duesseldorf has upheld the high thresholds again. The court is right when it points out that the age of the patent alone is of no relevance with re-spect to its validity. There is no rule that old patents must be valid. Indeed, there are far too many patents around that might not be valid but do not receive any attention because the inventions are of no commercial value and it is obvious that such patents will never be attacked for this reason. However, this is kind of an unsatisfying situation for the patentee, too. Is there a need to initiate nullity proceedings by a stooge just to facilitate preliminary injunctions in the future? The answer must be no. Rather, the applicant has to be very carful when proposing his request for a preliminary injunction and he has to present a comprehensive analysis of the validity of the patent so that the court feels comfortable when judging about the question whether the validity of the patent is beyond doubt. In this context the age of the patent or the existence of parallel (foreign) indisputed patents can play a role if the patentee can show that the patent has been of relevance for the industry in the past and that there are competitors respecting the patent instead of attacking it.

Dr. Markus Lenßen, LL.M. (Cantab.)
rospatt osten pross – Intellectual Property Rechtsanwälte

This entry was posted on Friday, December 9th, 2011 at 7:12 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.