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Infringement proceedings outside Germany do not provide justification for a negative declaratory action in Germany regarding the same European patent

Thorsten Bausch (Hoffmann Eitle) · Thursday, July 3rd, 2014

The Higher Regional Court Düsseldorf has ruled in its decision of 20 March 2014 ([docket number 12 W 8.14](#)) that an explicit allegation of entitlement to a national part of a European patent, e.g. by sending a warning letter or the filing of a court action, does not include an implicit allegation of entitlement (stillschweigende Berühmung) to the other parts of the same European patent in the respective other countries, nor does this provide grounds for declaratory interest (Feststellungsinteresse) in Germany, i.e. a legitimate interest in filing a negative declaratory action regarding the German part of the European patent.

The circumstances resulting in the German proceedings were infringement proceedings in Turkey where the defendant had filed an action against the plaintiff asserting infringement of the Turkish part of European patent EP 1 392 575 (“EP ‘575”). With regard to the German part of EP ‘575, defendant had neither sent a warning letter to plaintiff nor otherwise explicitly asserted that plaintiff was committing infringing acts. Defendant had in particular also not referred to an infringement of the German part of EP ‘575 in the Turkish proceedings. In the correspondence between defendant and plaintiff, defendant had merely informed plaintiff that it did not see any reason why it should have to provide any statements on the abstract question of whether potential, future activities of plaintiff might infringe defendant’s IP right. Based on these facts and circumstances, plaintiff filed a negative declaratory action requesting determination that it is not infringing the German part of EP ‘575.

Pursuant to Sec. 256 (2) German Code of Civil Procedure, a legal action may be filed to determine the existence or non-existence (i.e. negative declaratory action) of a legal relationship if the plaintiff has a legitimate interest in having the legal relationship determined by an immediate judicial ruling. Legitimate interest is to be affirmed if the danger of uncertainty that this question raises could impinge on plaintiff’s rights or its legal position and if this danger may be removed by the requested court decision.

The Higher Regional Court Düsseldorf stated that an explicit and in general also an implicit allegation of entitlement to an IP right can suffice to have a declaratory interest affirmed since an allegation of rights can cause the legal position of a plaintiff to become uncertain, and a decision by a court can remove this uncertainty. However, certain circumstances must be fulfilled before an implicit allegation of entitlement to an IP right will be considered by a court. The Court **denied** that an implicit allegation of entitlement to rights can be found in the following:

- an inquiry by the IP holder as to entitlement (Berechtigungsanfrage),
- any reference by the IP holder to an IP right,
- an announcement by the IP holder that it might in the future reassess the matter if circumstances change, or
- if the IP holder does not respond to an inquiry as to whether a certain embodiment might fall within the scope of its IP right because the IP right holder is not obliged to respond to such inquiries that fall entirely within the risk sphere of the competitors.

The Court in this decision abandoned its previous standpoint regarding the effect of a specific allegation of entitlement, i.e. when such an allegation of entitlement is asserted in Germany just on the basis that one part of the respective European patent is the subject of an infringement suit in a foreign country. In the past, the Court had ruled that

- an implicit allegation of entitlement was to be denied if the respective national parts of a European patent had different claim wordings or if only an infringement by equivalent means was alleged (because the doctrine of equivalence is subject to differing national court rulings), but that
- an implicit allegation of entitlement could be considered in a case of identical national parts, identical attacked embodiments and a claim of literal patent infringement since the same legal requirements would then apply (cf. Art. 69 EPC). Also, if one part of the European patent was infringed, it could be expected that the parallel national parts would also be infringed.

Regarding the second point, the Court has now ruled that when there is an allegation of rights, it is not the objective legal situation that is decisive. It is rather essential, subjectively, that the IP right holder wants to claim and actually does claim certain rights (whether justifiably or not). If a right granted by a European patent is claimed, it might well be that according to Art. 69 EPC the situation in the further designated countries is objectively the same. This does not, however, mean that the IP right holder really wants to assert its rights in all other countries. The European patent is not a unitary patent but a bundle of national patents.

In its decision, the Court deviated from its previous rulings and no longer finds that an allegation of entitlement to an IP right in an EPC Member State is a sufficient basis for asserting a declaratory interest in a legal action in Germany with respect to the same European patent. The Court, however, did confirm that basically an implicit allegation of entitlement to an IP right could justify a declaratory interest. It is not quite clear, however, which situation the Court has in mind, and therefore the courts will have to decide on the basis of each specific case. What is left in the end, we believe, is that it will be accepted to be an implicit allegation if there is, for example, an information letter by the IP holder in which the right is less obviously claimed than in a warning letter (which would be an explicit allegation) but is more strongly formulated than an inquiry as to entitlement (which is not considered sufficient to constitute implicit allegation of entitlement). It remains uncertain, however, where the line is supposed to be drawn. The Court ruled that declaratory interest would have to be affirmed if the holder of a European patent had expressed in the already pending court proceedings that it considers the offer or distribution of the attacked embodiment in the countries where the other national parts of the European patent are valid to constitute infringement. This would not, however, be an example of an implicit allegation of entitlement but rather of an explicit allegation of entitlement. Based on the statements by the Court, an IP holder in an infringement action should therefore be very careful what it alleges in

infringement proceedings with regard to possible infringements in other Member States.

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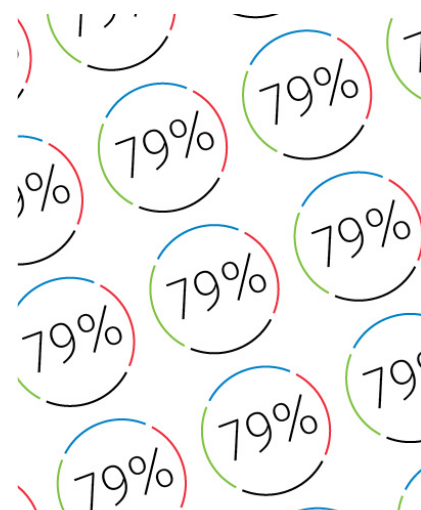
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