

# Kluwer Patent Blog

## To suspend or not to suspend – Bundesgerichtshof on bifurcation

Thomas Musmann (Rospatt Osten Pross) · Wednesday, October 22nd, 2014

by Hetti Hilge

In two recent and surprising decisions the Bundesgerichtshof (German Federal Court of Justice) clarified the effects of a first instance decision nullifying the patent in suit on the enforcement of a parallel infringement finding (including an injunction) and, upon second review, remedied what it considers an unintended oversight by the legislator (“Planwidrige Regelungslücke”) in the specific circumstances of patent litigation and bifurcation. Effectively “overruling” its own previous decision in the very same case (Microsoft vs Motorola), the court now ordered the temporary suspension of the enforcement of an appeal court judgment finding for infringement, against the provision of a security by the defendant, following the nullification of the patent by the Federal Patent Court ([BGH, court order of 16 September 2014, X ZR 61/13](#)).

Microsoft succeeded with an infringement complaint against Motorola before the District Court Munich, resulting inter alia in an injunction and a claim to render account about infringing acts (the distribution of certain mobile phones with the Android operating system by Motorola in Germany), both preliminarily enforceable upon provision of a security by plaintiff Microsoft. The judgment was confirmed on appeal by the Appeal Court Munich with decision of 25 April 2013. Parallel to the infringement proceedings, Motorola had filed a nullity complaint against the patent in suit (EP 1 304 891, concerning a SMS function in mobile phones) with the Federal Patent Court (FPC) and requested the stay of the infringement proceedings pending the outcome of the nullity complaint. Both the first instance and the Appeal Court Munich denied the request to stay the infringement proceedings because the defendant did not succeed in establishing the required prevailing likelihood that the patent would be nullified by the FPC. The FPC decided on the nullity complaint only after the appeal court decision in the infringement proceedings had been handed down, and with judgment following an oral hearing of 7 May 2014 nullified the patent in suit.

After the oral announcement of the nullity judgment but before the written nullity judgment was available Motorola requested a suspension of the enforcement of the Appeal Court Munich judgment. The Bundesgerichtshof with a first decision of 8 July 2014 denied this request ([BGH, court order of 8 July 2014, X ZR 61/13](#)). Based on a formal application of the law the court was of the opinion that a first instance, non-final FPC decision nullifying the patent did not in itself result in the required irreparable harm for the defendant and was no sufficient reason to suspend the enforcement of the appeal court judgment on infringement.

Motorola filed a so-called “Anhörungsrüge” (a complaint with the allegation that the right to be heard has been violated) against this decision. Although the formal remedy chosen by the defendant was not justified, the Bundesgerichtshof interpreted it as an informal remonstrance (“Gegenvorstellung”) which it at this time surprisingly considered justified in the matter. Confirming the settled case law and suspension practice of the second instance courts, e.g. of the Appeal Court Duesseldorf, the Bundesgerichtshof noted that it is generally appropriate to suspend the enforcement of a judgment which is preliminarily enforceable and has been appealed if the patent in suit has been nullified in first instance by the Federal Patent Court. The same finding was considered appropriate if the enforceable decision was a second instance, appeal court decision against which the defendant has filed a further appeal on points of law or an appeal against the refusal of leave to appeal, although the requirements for a suspension of the enforcement under wording of the German Code on Civil Procedure were not fulfilled. The court, upon second review, closed this gap by applying the underlying provision in the statute by way of analogy.

The Bundesgerichtshof also provided general guidance by confirming that the suspension of the enforcement against the provision of a security by the defendant has to be the rule if there is a first instance decision of the Federal Patent Court nullifying the patent in suit. An exception to this rule could only be considered in very exceptional cases, e.g. if the decision of the Federal Patent Court was obviously wrong so that it would not stand an appeal. Since the written reasons for the nullity decision of the Federal Patent Court were available by the time the Bundesgerichtshof decided on the suspension request for the second time, it could exclude that the nullity decision was obviously wrong. Notably, the Bundesgerichtshof is not only the final instance court in the infringement proceedings, but at the same time the appeal court in the nullity proceedings and as such will also have to finally decide on the validity of the patent in suit.

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