1. **How common is it for preliminary injunctions to be awarded in patent infringement actions?**

   In the past it was rather unlikely that a preliminary injunction was awarded in German patent litigation matters. But nowadays, even though not easy it is possible to obtain such injunctions in suitable cases, for example in trade fair matters or rather straightforward cases. Since a few years, the number of successful injunction applications in patent infringement matters is generally increasing. In this regard, it is important to know that the likelihood of obtaining such an injunction varies according to which court hears the application. There are 12 courts in Germany who may have competence in first instance. Since different weight is given to different issues, injunctions are rarely obtained in Munich and Mannheim, but more often in Düsseldorf, Hamburg and Frankfurt.

2. **What are the considerations that a court would weigh up in determining whether or not to award a preliminary injunction.**

   What is the balance between the substantive issues of infringement and validity, on the one hand, and other considerations, such as urgency/delay, the ‘risk of injustice’ or ‘balance of convenience’ – the impact that granting (or not granting) the injunction would have, on the other hand?

   The infringement courts are well aware that granting a preliminary injunction may have severe consequences on the defendant. Hence, the courts require both evidence of the infringement and (different from the proceedings on the merits) an examination of the validity of the patent. A court will consequently only grant a preliminary injunction if it is confident that the patent is unlikely to be revoked and that the infringement has apparently been shown.

   Further, a preliminary injunction can only be successful if the claimant demonstrates that urgent relief is needed. This means that patent owners should not wait too long from the moment they gain knowledge of the infringement until the application for the preliminary injunction. As a general rule, less than one month is fine. A one to two-month period is often acceptable. But if the claimant waits more than two months before applying for a preliminary injunction, the situation becomes critical, since delay in seeking preliminary injunction indicates that the matter is in fact not that urgent.

   The balance between these requirements varies between the courts. Some do emphasise the validity aspect while other courts focus more on the infringement and urgency issue.
3. The procedure for obtaining a preliminary injunction:

(A) What evidence would the patentee be required to submit?

In preliminary injunction proceedings the rules of burden of proof are the same as in the proceedings on the merits. The main difference is that in preliminary injunction proceedings the patentee can submit evidence by affidavits which is not possible in main proceedings. In general, the patentee has to demonstrate and to substantiate that his patent is infringed and that there is a strong likelihood of the validity of the patent. The patentee can convince the court of an existing infringement inter alia by providing samples of the infringing product, pictures, product brochures etc. Additionally an own experts opinion can be provided to demonstrate the infringement by a detailed analysis of the infringing conduct in comparison with the features of the patent in dispute. Regarding the validity, the patentee has to convince the court that there are no severe doubts about the validity of the patent. If any prior art is discovered which has not been considered in the patent granting procedure, the patentee has to discuss in his application why this does not affect the validity of the patent in dispute. To substantiate his position, it may be necessary that the patentee provides an own experts opinion which discusses the validity in detail. Further the patentee has to accredit that the patent in question is in force, the applicant is entitled to enforce the relevant patent rights and that urgent relief is needed.

(B) How long does it typically take to obtain a preliminary injunction in a patent matter?

The answer to this question mainly depends on whether the preliminary injunction is awarded *ex parte* or not. It is possible that a preliminary injunction can be awarded within one day without an oral hearing. In case the court wants to hear the defendant before making a decision, it usually takes several weeks to obtain a preliminary injunction, depending on the complexity of the relevant case and the obviousness of the infringing conduct.

(C) Would a ‘temporary injunction’ be granted in the meantime i.e. pending the outcome of the decision re grant of a preliminary injunction?

Under German law such a "temporary injunction" is not available.

(D) What is the typical cost of preliminary injunction proceedings?

It is difficult to make a general cost estimate. The court fees strictly depend on the value of the case. Regarding the attorney’s fees (fees for the patent attorney and attorney at law) the costs depend on the complexity of the dispute and are slightly less than the costs for initiating patent infringement proceedings on the merits. In an average patent case the attorney’s fees will be approximately between EUR 100.000 and 150.000.
(E) Is the procedure separate from proceedings on the merits? If so, is it necessary to commence proceedings on the merits?

The procedure for preliminary injunctions is separate from the proceedings on the merits. There is no statutory obligation to commence proceedings on the merits after a preliminary injunction has been granted. The defendant can request the claimant to commence such proceedings. Important to know is that rights to damages and the information for the calculation of the damages can become time-barred if the claimant does not start proceedings on the merits after the preliminary injunction has been granted.

4. What bond or undertakings are required in order to secure a preliminary injunction? What is the consequence in damages and costs if a preliminary injunction is awarded but the patentee is ultimately unsuccessful?

A preliminary injunction itself is generally awarded by the courts without the premises of a security payment. But the courts sometimes require a security payment for the enforcement of the awarded preliminary injunction. The amount of such security payment depends on the possible impact of the injunction on the defendant and is usually not under EURO 1 million. The security can be provided by a bank guaranty.

In case that a preliminary injunction is awarded but the patentee is ultimately unsuccessful, the defendant has a full damage claim against the patentee and can further claim refund of his attorney’s fees (including fees for his patent attorney) according to certain statutory fee tables.

6. Any additional thoughts on the likelihood of obtaining a preliminary injunction or the tactical considerations that could be relevant.

From a tactical point of view, it is worth to mention that in German proceedings it is possible to apply for a preliminary injunction and discuss the likelihood of success with the relevant judge confidentially without any notification to the defendant. If the court indicates in such an informal discussion that the requirements to award a preliminary injunction are not fulfilled, the applicant has the possibility to withdraw his application “silently”. The effect is that the defendant will never get to know that the patentee once applied for a preliminary injunction against him.

Further, to obtain a preliminary injunction without an oral hearing it is usually necessary to send a prior warning letter to the defendant. Contrariwise a warning letter bears the risk that the defendant might send a protective letter to the court, which usually leads to an oral hearing. The alternative would be to apply directly for a preliminary injunction with an oral hearing. The question which option should be preferred is subject to the individual case. Important aspects for the balance of pros and cons are the arguments for the validity of the patent and the obviousness of the infringement.
7. If a preliminary injunction is not granted, how long would it take to achieve a decision on the merits of the case? Is there a procedure by which these proceedings could be expedited?

The time for a decision on the merits of the case varies from court to court. The Mannheim court is particularly fast (less than a year) but they are reluctant to proceed with infringement cases if the patent has been amended in a pending EPO procedure. Procedures in Düsseldorf (the most popular patent trial forum for patentees in Europe) takes a little bit more time (12 to 15 months) but the Düsseldorf patent chambers are prepared to rule on validity challenges based on their own expertise. The Munich patent chamber tends to ask for an external expert opinion which further delays the procedure. The time which procedures take in other first instance courts is rather unpredictable and can vary from very fast (6 to 8 months) to several years.

Under German law there are no possibilities to expedite the proceedings.

Source: Simmons & Simmons Düsseldorf (www.simmons-simmons.com)

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