

Germany

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For patent litigation, Germany is among the most frequented venues in Europe.¹ Both large, international law firms and highly specialized boutique firms are active before German courts. Not only the Federal Supreme Court (Bundesgerichtshof – BGH) but also a handful of major first- and second-instance venues, such as Düsseldorf, Hamburg, Mannheim and München, play an important role in shaping German patent law. Stakeholders, such as patentees, licensees, inhouse and outside counsel, scholars and non-German courts or lawmakers, therefore have a strong interest not only in the established legal framework for patent litigation in Germany, but also in shifts this framework is, of late, undergoing. At the same time, the language barrier complicates insights on these matters, not least for Anglo-American stakeholders, although a slowly increasing part of scholarship, and even of case law, is available in English. Against that background, this chapter sets out to explain basic structures and recent developments in German patent injunction law. It covers the main types of and requirements for such injunctions under German law (Section A), the injunction’s scope as claimed and granted (Section B), bifurcation and stays (Section C), defences and limitations (Section D), as well as alternatives to injunctive relief (Section E), before a conclusion and an outlook (Section G) round off the chapter.

A. PATENT INJUNCTIONS: MAIN TYPES AND REQUIREMENTS

1. *Main Types*

As a rule of thumb, all acts infringing a patent can trigger injunctive relief under German law. This goes, hence, not only for direct infringements (Sec. 9 German

¹ Commission of the European Communities. 2007. “Communication from the Commission to the European Parliament and the Council, Enhancing the patent system in Europe,” COM (2007) 165 final, 8; Ann 2009; Klos 2010; Kühnen & Cleassen 2013.

Patent Act – GPA) but also for contributory infringements (Sec. 10 GPA), for acts that enable or promote the infringement, and for uses not falling within the literal scope of a patent claim but which are captured by the doctrine of equivalents.² Requirements for an injunction can, however, slightly vary depending on the type of infringing act (see Section A.2). Furthermore, decisions granting injunctive relief can differ in the parallel claims they award to the patentee, such as damages (Sec. 139(2) GPA), recall or destruction (Sec. 140a GPA).

Besides injunctions granted as part of a final court decision (“final injunctions”), interim relief is available in the form of “preliminary injunctions” (see Section A.3). Injunctions can also form part of a court settlement, based either on a court-recorded party agreement (Sec. 794(1) No. 1 Code of Civil Procedure – CCP, Sec. 779 German Civil Code – GCC) or on a court proposal (Sec. 278(6) CCP).

2. General Requirements and Specific Requirements for Preliminary Injunctions

Some requirements must be fulfilled for all types of patent injunctions. For instance, the patent, Supplementary Protection Certificate (SPC) or patent application at issue must not be exhausted and the defendant must have used it in the sense of Sec. 9, 10 or 14 GPA. Absent a contractual (Sec. 15(2) GPA) or compulsory (Sec. 24 GPA) licence and absent a (general) declaration of willingness to license (Sec. 23 GPA), there must be a risk of first-time (Sec. 139(1)(2) GPA) or recurrent (Sec. 139(1)(1) GPA) infringement.³ To give a last example, an injunction is only warranted where the defendant cannot raise a defence, such as the free state-of-the-art defence (also called “Formstein” defence; cf. BGH, 29.04.1986, X ZR 28/85 – Formstein).

Some other requirements depend, however, on whether the injunction sought is of an interim nature. The injunction stipulated in Sec. 139(1) GPA is a final, as

² On the doctrine of equivalents in German patent law, see Hasselblatt 2012, § 38 para. 199; Osterieth 2015b, para. 109.

³ Only infringing acts which have actually taken place, or which are likely to happen, can be enjoined, i.e. injunctions are not granted with regard to theoretical settings; on the requirements for a sufficient first-time infringement risk, see Grabinski & Zülch 2015, paras. 28, 32; Keukenschrijver 2016b, para. 263 (in particular on negative statements regarding the patent); regarding logistics providers: BGH, 19.09.2009, Xa ZR 2/08 – MP3-Player-Import; OLG Hamburg, 16.10.2008, 5 W 53/08 – iPod II. Injunction claims are too broad and will remain unsuccessful if they exclusively try to capture future infringing acts; Kraßer & Ann 2016, § 35 para. 8 et seq.; Grabinski & Zülch, 2015, para. 32. Furthermore, infringing acts do not justify an injunction if there is no risk of a recurrent infringement. This risk is, however, presumed in the event of an infringement, the presumption is rebuttable but the threshold for a rebuttal is high; see Grabinski & Zülch 2015, para. 30. One option is a cease-and-desist declaration, secured by a contractual penalty; Kraßer & Ann 2016, § 35 para. 6 et seq. Note further that the risk of a recurrent infringement can be removed by a court decision granting (preliminary) injunctive relief; OLG Karlsruhe, 10.04.1991, 6 U 164/90 – Erbenermittlung; OLG Karlsruhe, 22.02.1995, 6 U 250–94; OLG Hamburg, 20.06.1984, 3 W 103/84; KG Berlin, 20.08.1992, 25 U 2754/92; KG Berlin, 25.10.1996, 5 U 4912/96; dissent OLG Hamm, 19.02.1991, 4 U 231/90, para. 26.

opposed to a preliminary injunction. “Final” is, however, not the same as “infinite” since it is, by definition, not possible to enjoin a defendant from the use of a patent beyond the patent’s protection period.⁴ The duration of patent protection constitutes, hence, a built-in time limitation for injunctions.

Much more limited in time are injunctions granted as preliminary injunctive relief under Sec. 935, 940 CCP.⁵ This limitation can be caused not only by the fact that the preliminary injunction is replaced by a final decision⁶ but also by a time-limited scope of the preliminary injunction itself,⁷ or by a legal remedy⁸ curtailing the injunction.

For a preliminary injunction, the patentee has to show an obvious claim to an injunction and a reason why the injunction ought to be granted as preliminary relief.⁹ To fulfil the first requirement, both patent validity and infringement need to be evident to the court.¹⁰ Unclear validity of the asserted patent may prevent the court from issuing a preliminary injunction.¹¹ As a general rule, courts do not issue a preliminary injunction where they would stay (Sec. 148 CCP) the main proceedings (on stays see Section C) because of pending validity proceedings and a high

⁴ Grabinski & Zülch 2015, para. 34, with reference to BGH, 22.11.1957, I ZR 152/56 – Resin, para. 19, BGH, 20.5.2008, X ZR 180/05 – Tintenpatrone, para. 7.

⁵ Voß 2019, para. 276. As to TRIPS and EU law background, see in particular: Sec. 50, 41(1) TRIPS; Sec. 9 Enforcement Directive 2004/48/EC; Gesetz zur Verbesserung der Durchsetzung von Rechten des geistigen Eigentums vom 7. Juli 2008, PMZ 2008, 274. The core, general requirements for preliminary relief under Sec. 935, 940 CCP are the existence of a claim (*Verfügungsanspruch*); here mainly: requirements for an injunction, as described in Section A.2 and of sufficient grounds/urgency for issuing a preliminary decision (*Verfügungsgrund*); here e.g. occurrence of an infringement alone not sufficient, further aspects necessary that intensify need for immediate relief; OLG Düsseldorf, 18.05.2009, 2 U 140/08 – Captopril; much depends on expeditious conduct of patentee, OLG München, Mitt. 2001, 85, 89 – Wegfall der Dringlichkeit). The patentee does not have to fully prove that these requirements are fulfilled (*Vollbeweis*), it suffices for it to show prima facie evidence, i.e. preponderance of the evidence (*überwiegende Wahrscheinlichkeit*), Sec. 940, 936, 920(2) CCP. Furthermore, the court has to balance the involved interests (here of infringer and patentee). For legal remedies against a preliminary injunction, See, e.g., Sec. 924, 926, 927 CCP. On the – for the patent context quite important – instrument of a “protective brief” submitted by the (alleged) infringer, see Deutsch 1990.

⁶ On the specific constellation that, after the granting of a preliminary injunction, an injunction is denied in the final decision, see BGH, 01.04.1993, I ZR 70/91 – Verfügungskosten.

⁷ Grabinski & Zülch 2015, para. 153b, 153h, with case law. One example are preliminary injunctions regarding trade fairs, LG Düsseldorf, 11.05.2004, 4a O 195/04.

⁸ E.g., Sec. 927, 929 CCP.

⁹ Haft et al. 2011, 927.

¹⁰ Voß 2019, para. 281 et seq.; Osterrieth 2015b, para. 79; cf. OLG Düsseldorf, 29.04.2010, I 2 U 126/09 – Harnkatheterset. In a way, these requirements, together with the ensuing balancing of interests, soften bifurcation and the infringement–injunction nexus as far as preliminary relief is concerned.

¹¹ Validity concerns are usually considered as removing the grounds/urgency for preliminary relief (*Verfügungsgrund*); OLG Düsseldorf, 29.04.2010, I 2 U 126/09 – Harnkatheterset; OLG Karlsruhe, 08.07.2009, 6 U 61/09 – Vorläufiger Rechtsschutz.

likelihood of invalidation of the patent.¹² The same is usually¹³ true where a first-instance ruling has held the patent to be invalid, even though the decision is not yet final.¹⁴ Conversely, a first-instance (although not final) confirmation of validity supports the justification for preliminary relief.¹⁵

The second requirement is fulfilled where preliminary relief appears suitable and necessary to protect the applicant from substantial disadvantage (*Verfügungsgrund* – grounds for preliminary relief).¹⁶ This usually requires that an element of urgency is present and that the interests of the patentee outweigh – in a balancing exercise – the interests of the infringer.¹⁷ For the determination of urgency, both the pre-litigation conduct of the patentee and its conduct during the litigation are relevant.¹⁸ For instance, the patentee must not, without good reason, allow an extended time-span to pass between learning of the infringement and its circumstances and the filing of the injunction.¹⁹ Nor must it fail to litigate in an active and timely manner, e.g., by defaulting²⁰ or by delaying an injunction request until publication of the full-fledged reasoning of a decision in parallel nullity proceedings.²¹ Factors relevant in the balancing of interests include the impact of an injunction on the infringer's business, the likelihood for the patentee to successfully collect damages later on, and the question whether the patentee engages in patent-based production itself or merely collects royalties.²²

All in all, the requirements for a preliminary injunction are rather strict since this relief severely impairs the rights of the alleged infringer.²³ Consequently, preliminary injunctions are a well-established, but – at least traditionally²⁴ – not a very frequent feature of German patent law.²⁵

¹² OLG Düsseldorf 21.10.1982, 2 U 67/82; OLG Düsseldorf, 05.10.1995, 2 U 43/95; OLG Frankfurt, 27.03.2003, 6 U 215/02 – Mini Flexiprobe.

¹³ But not where the decision is evidently flawed; OLG Düsseldorf, 29.05.2008, 2 W 47/07 – Olanzapin.

¹⁴ Grabinski & Zülch 2015, para. 153b.

¹⁵ OLG Düsseldorf, 29.04.2010, I 2 U 126/09 – Harnkatheterset.

¹⁶ Voß 2019, para. 284.

¹⁷ *Id.*

¹⁸ *Id.*

¹⁹ OLG Düsseldorf, 17.01.2013, I-2 U 87/12 – Flupirtin-Maleat.

²⁰ Voß 2019, para. 290.

²¹ OLG Düsseldorf, 29.06.2017, I-15 U 4/17 – Olanzapin II.

²² Voß 2019, para. 303 with further references.

²³ Osterieth 2015b, para. 79.

²⁴ On recent tendencies to grant preliminary injunctions more frequently, see Böhler 2011, 965.

²⁵ On numbers, see von Falck 2002, 429. On preliminary injunctions in general, see also Böhler 2011, 965; Wuttke 2011, 393. Prominent court decisions have held that it can be difficult to assess the requirements for an injunction in preliminary proceedings and that, therefore, this relief is to be granted with caution, *See, e.g.*, OLG Karlsruhe, 27.04.1988, 6 U 13/88 – Dutralene; OLG Karlsruhe, 08.07.2009, 6 U 61/09 – Vorläufiger Rechtsschutz, para. 13; OLG Düsseldorf, 29.05.2008, 2 W 47/07 – Olanzapin (especially on the relevance of first-instance decisions on patent validity); OLG Hamburg, 03.09.1987, 3 U 83/87; OLG Frankfurt, 03.05.1988, 6 U 207/87.

B. SCOPE AS CLAIMED AND GRANTED: ENFORCEMENT

The usual patent infringement litigation in Germany includes an oral hearing and is decided by a judgment on the merits,²⁶ including a decision on costs and provisional enforcement.²⁷ The operative part (*Tenor/Urteilstenor*)²⁸ of such a judgment is based on the plaintiff's motion, reflects its pleas,²⁹ and provides the legal basis for the enforcement of the ruling.³⁰ An infringement decision must state clearly the actions from which a defendant has to refrain.³¹ Wording and interpretation of the decision's operative part (*Tenor*) are crucial since they determine the (range of) acts which a defendant is not allowed to repeat/undertake.³² The operative part must not be so abstract as to cover acts which were not in dispute.³³ By way of interpretation, the scope of an injunction is oftentimes delineated according to the so-called core theory: The infringer cannot evade an injunction by making minor changes to the infringing act/product if the core of the (form of the) infringement remains unchanged.³⁴

Whether and in which cases the patent claims can be used to identify the infringing acts is a complex and highly debated issue.³⁵ Although a plaintiff is not procedurally barred from asserting broad claims for patent infringement, even claims as comprehensive as the patent claims themselves,³⁶ the action will be dismissed unless the plaintiff specifies the infringement,³⁷ in particular the infringing product, in the initial complaint or during³⁸ the proceedings. While the court may not award more than the plaintiff has requested (Sec. 308(1) CCP), it is possible for the court to reframe the claim, to grant less than requested, or to base the decision on different legal grounds than submitted.³⁹ Inadmissible actions will be thrown out by means of a procedural ruling.⁴⁰

As key means for the enforcement of patent injunction decisions, such decisions regularly impose both a penalty payment (maximum EUR 250,000) for each case of

²⁶ On wording regarding claims and subclaims of the infringed patent, see Voß, 2019, para. 198.

²⁷ *Id.*, para. 197.

²⁸ Summarizes the core content of the decision, e.g. the (partial) approval or rejection of the plaintiff's motion as well as the costs. For examples, see the cited decisions, the operative part precedes the reasoning.

²⁹ Voß 2019, para. 36.

³⁰ BGH, 30.03.2005, X ZR 126/01 – Blasfolienherstellung.

³¹ Grabinski & Zülch 2015, para. 32.

³² Pitz 2010, para. 134.

³³ Grabinski & Zülch 2015, para. 32.

³⁴ Pitz 2010, para. 134.

³⁵ See in detail BGH, 29.04.1986, X ZR 28/85 – Formstein; BGH, 30.03.2005, X ZR 126/01 – Blasfolienherstellung; OLG München, 06.10.1958, 6 W 607/58; Meier-Beck 1998, 277; Grabinski & Zülch 2015, para. 32.

³⁶ Grabinski & Zülch 2015, para. 32.

³⁷ BGH, 23.02.1962, I ZR 114/60 – Furniergitter, para. 20; BGH, 29.04.1986, X ZR 28/85 – Formstein.

³⁸ BGH, 24.11.1999, I ZR 189/97, para. 38.

³⁹ Voß 2019, para. 36.

⁴⁰ Pitz 2010, para. 134.

culpable non-compliance and custody (maximum two years) in case of repeated non-compliance or failure to make a penalty payment.⁴¹

C. BIFURCATION AND STAYS

In Germany, patent litigation is a civil law dispute subject, in principle, to the same procedural rules as other civil law cases.⁴² As a very important exception to this rule, however, German patent litigation is “bifurcated”: Court proceedings are split into validity matters⁴³ on the one hand and all other patent-related disputes, infringement disputes in particular, on the other hand.⁴⁴ As one of the reasons for this approach, the relatively thorough patent granting procedure is perceived to justify a presumption of validity of the patent, permitting the infringement court to grant relief without having itself assessed patent validity. Furthermore, the effectiveness of infringement proceedings would be reduced if the infringement court had to deal with validity matters because assessing validity would delay the grant of injunctions, damages or other remedies.⁴⁵

1. *Stay of Infringement Proceedings Pending Validity Proceedings*

Due to bifurcation, it is possible (and frequent) that injunction proceedings and validity proceedings run in parallel and that the infringement court awards an injunction before the validity court ascertains whether the patent in question is valid or not.⁴⁶ A key instrument for avoiding contradictory results in the two prongs of the bifurcated system – grant of injunction on the one hand, invalidation of the patent on the other – is a stay of the infringement proceedings according to Sec. 148 CCP.

Courts may grant a stay of infringement proceedings in the first, second⁴⁷ or third⁴⁸ instance. They have some discretion based on a balancing of the parties’

⁴¹ See further Grabinski & Zülch 2015, para. 160 et seq.

⁴² Osterrieth 2015b, para. 2.

⁴³ The main relevant types of validity proceedings are opposition proceedings (Sec. 59, 81 GPA) or an action for revocation (Sec. 22, 81 GPA). The German Patent Office, the Federal Patent Court, and the Federal Court of Justice have exclusive jurisdiction over validity, infringement courts are bound by their decision. See Osterrieth 2015b, para. 2 et seq.; Mes 2015, § 139 para. 353.

⁴⁴ Osterrieth 2015b, para. 1.

⁴⁵ On both reasons, see *id.*, para. 3.

⁴⁶ *Id.*, para. 4.

⁴⁷ *Id.*, para. 5; Kraßer & Ann 2016, § 36 para. 71. On the particularities of a second-instance assessment, e.g. on the lower threshold for a stay if the patentee won the first instance, can as a result enforce the injunction based on the provisionally enforceable first-instance decision, and is, therefore, less severely affected by a stay, see OLG Düsseldorf, 20.06.2002, 2 U 81/99 – Haubentrechtautomat, para. 128; OLG Düsseldorf, 21.12.2006, 2 U 58/05 – Thermocycler, para. 130.

⁴⁸ BGH, 28.09.2011, X ZR 68/10 – Klimaschrank; BGH, 06.04.2004, X ZR 272/02 – Druckmaschinen-Temperierungssystem, e.g. holding that the interests of the patentee ought to prevail the more clearly the later the infringer has attacked the patent’s validity.

interests.⁴⁹ As a general tendency, German courts use this discretion to take a rather patentee-friendly position; they are restrictive in the grant of stays.⁵⁰ According to one of the standard tests, an infringer requesting a stay must show a high likelihood that the patent will be invalidated.⁵¹ A stay is considered appropriate if the patent scope has already been limited as a result of opposition (Sec. 21, 59 GPA) or nullity (Sec. 22, 81 et seq. GPA) proceedings in the first instance, at least where this restriction has the challenged form of execution no longer covered.⁵² Some scholars argue that opposition proceedings suggest a stay more strongly than actions for revocation since, in opposition proceedings, it is the patentee who bears the burden of proof.⁵³ Generally speaking, a stay seems more likely where novelty of the infringed patent is questionable,⁵⁴ and less likely where opposition/revocation proceedings focus on inventiveness.⁵⁵ If one action for revocation has failed but a second action been filed (on similar grounds), infringement proceedings will usually not be stayed any longer, unless imminent success of the second action for revocation is evident.⁵⁶ The suspension will not be granted if the defendant has delayed in initiating the invalidity proceedings (Sec. 296 CCP).⁵⁷ Neither the mere possibility of destruction or revocation nor a threat of an action for annulment justify a stay.⁵⁸ The same goes for a compulsory licence action,⁵⁹ since such action can legitimate use of the patent for the future only.⁶⁰

As to the standards by which the infringement courts determine the likelihood of patent invalidation, there is no formal taking of evidence. However, the defendant should not be significantly worse off than if the infringing court also had the jurisdiction to decide on validity, and the courts do engage in a serious examination of the likelihood of success.⁶¹ For instance, if a stay is requested on the grounds that the patented invention has been in use prior to the granting of the patent and that, therefore, the patent must be nullified, the infringer must produce conclusive and

⁴⁹ BGH, 28.09.2011, X ZR 68/10 – Klimaschrank; OLG München, 29.12.2008, 6 W 2387/08 – Abstrakte Vorgeiflichkeit.

⁵⁰ Mes 2015, § 139 para. 354.

⁵¹ *Id.*, § 139 para. 352, 354; Grabinski & Zülch 2015, para. 107; Osterrieth 2009, 543. On the lower threshold before appeal courts, see BGH, 11.11.1986, X ZR 56/85 – Transportfahrzeug; Grabinski & Zülch 2015, para. 107.

⁵² Grabinski & Zülch 2015, para. 107 with reference to OLG Düsseldorf, 22.02.12, I 2 U 26/05.

⁵³ Mes 2015, § 139 para. 359.

⁵⁴ For instance, because the opposing party raises elements of the state of the art which have not been reviewed in the verification procedure; LG München I, 24.08.2007, 21 O 22456/06 – Antibakterielle Versiegelung.

⁵⁵ Mes 2015, § 139 para. 355 w.f.r.

⁵⁶ BGH, 17.07.2012, X ZR 77/11 – Verdichtungsvorrichtung.

⁵⁷ LG München I, 19.05.2011, 7 O 8923/10; BGH, 28.09.2011, X ZR 68/10 – Klimaschrank; Grabinski & Zülch 2015, para. 107.

⁵⁸ Grabinski & Zülch 2015, para. 107.

⁵⁹ On compulsory licences, see Section D.1.b.

⁶⁰ Grabinski & Zülch 2015, para. 109.

⁶¹ *Id.*, para. 107.

detailed evidence of the alleged prior use.⁶² Stays may be decided without oral hearing, but this is not the rule.⁶³ The decision on a stay can be appealed (Sec. 252, 567 et seq. CCP) but review is limited by the principle that the appeal court is not supposed – at this stage – to question the first instance court’s preliminary view on whether an infringement has taken place.⁶⁴

Especially in recent times, bifurcation has drawn criticism,⁶⁵ not least because a considerable patent invalidation rate and substantial time gaps between the decisions in infringement and validity proceedings can harm alleged infringers who are enjoined from using a technology the patent on which is subsequently declared invalid.⁶⁶ The need to wait for the decision of the – usually slower – validity court delays the overall resolution of the case⁶⁷ and alleged infringers may be forced into settlement by the costs and other disadvantages they would incur during this period.⁶⁸ On the other hand, the swifter decision on and termination of an infringement which bifurcation permits does generate strong patent protection and it certainly makes Germany an attractive venue for patentees.⁶⁹

2. Other Types of Stays and Procedural Reactions to Patent Invalidation

Usually, even a permanent injunction issued by a court of first instance is provisionally – i.e. until (and if) overturned by the second instance – enforceable on the condition that the plaintiff lodges sufficient security.⁷⁰ Enforcement of the injunction can, as an exception, be stayed until a final decision in the case at the request of the defendant⁷¹ where (i) the defendant provides security (Sec. 719, 707 CCP), (ii) an enforcement threatens to inflict serious, irreparable damage upon the defendant, and (iii) a balancing of interests shows that the defendant’s interests outweigh the plaintiff’s interests given the facts of the case, including validity concerns.⁷²

Other reasons for delaying or staying injunctions in time are, in particular, so-called torpedo actions in other EU member states under Sec. 27, 30 of the Brussels

⁶² Critical of the high requirements for suspension and with further references, see *id.*, para. 107.

⁶³ *Id.*, para. 108.

⁶⁴ OLG Düsseldorf, 27.05.2003, 2 W 11/03 – Vorgreiflichkeit; OLG Düsseldorf, 08.12.1993, 2 W 79/93 – Prüfungskompetenz des Beschwerdegerichts, para. 8; OLG München, 29.12.2008, 6 W 2387/08 – Abstrakte Vorgreiflichkeit.

⁶⁵ See Meier-Beck 2015, 929; Thambisetty 2010, 144; Lemely 2013, 1732; Practical Law Arbitration, 2019.

⁶⁶ E.g., BGH, 08.07.2014, X ZR 61/13.

⁶⁷ Practical Law Arbitration 2019, 6.

⁶⁸ Meier-Beck 2015, 932.

⁶⁹ *Id.*, 932.

⁷⁰ One way of providing security is to submit a bank guarantee. Roughly speaking, the amount of the security is calculated to cover costs and damages incurred by the defendant in case the first-instance decision is overturned on appeal. For details, see Lackmann 2021, paras. 1 et seq.

⁷¹ See for granting of a use-by period according to considerations of proportionality Section D.6.

⁷² Haft et al. 2011.

I Regulation (recast),⁷³ a pending constitutional complaint against a ruling that grants annulment of the patent,⁷⁴ or a referral for a preliminary ruling to the Court of Justice of the European Union pursuant to Sec. 267 TFEU.⁷⁵

If the patent lapses during infringement proceedings, but without retroactive⁷⁶ effect, the patentee must limit its claims to the period of patent validity.⁷⁷ If the infringement court issues an injunction and the patent is subsequently invalidated, the infringer may file an “action raising an objection to the claim being enforced” (Sec. 767 CCP) based on the grounds that the patent, the use of which has been enjoined, lacks validity. Furthermore, the infringer may file for an interim order staying enforcement (Sec. 769 CCP).⁷⁸ If the infringement decision is final and has already been enforced before the invalidation/lapse of the patent,⁷⁹ an action for retrial according to Sec. 580 No. 6 CCP (by way of analogy)⁸⁰ or claims based on undue enrichment (Sec. 812 et seq. GCC) may be raised. An action for retrial based on a decision (partly) invalidating the patent can, however, only be brought after the invalidating decision has become final.⁸¹

D. DEFENCES AND LIMITATIONS

1. *Considerations of Public Interest*

a. Relevance and Types of Public Interest Considerations

Sec. 139(1) GPA itself, German patent law’s core provision on injunctions, does not foresee the consideration of public interest as far as the latter is not embodied in the requirements the provision establishes for the grant of an injunction. Nor does a strong tradition of wide judicial discretion exist⁸² which would enable courts to broadly introduce public interest considerations.

⁷³ “Torpedos” are actions in another EU member state, seeking a declaratory judgment that the patent is not infringed and aiming to block infringement proceedings, using the principle that the infringement court must stay its proceedings until the declaratory judgment court has decided whether it has jurisdiction. See, for details, Osterrieth 2015b, para. 34; Kühnen 2017, § C para. 177.

⁷⁴ See LG Düsseldorf, 27.08.2004 – Suspension on constitutional complaint.

⁷⁵ Mes 2015, § 139 para. 352. This can apply not only where the referral resulted from proceedings concerning the patent whose (alleged) infringement caused the infringement proceedings to be stayed, but also where the referral concerns another patent but raises the same issue which is relevant to the infringement proceedings to be stayed; BGH, 24.01.2012, VIII ZR 236/10.

⁷⁶ There is no retroactive effect, if, for instance, the patent lapses because the protection period is over.

⁷⁷ Kühnen 2009, 289 et seq.

⁷⁸ Osterrieth 2015b, para. 6.

⁷⁹ BGH, 29.07.2010, Xa ZR 118/09 – Bordako.

⁸⁰ BGH, 17.04.2012, X ZR 55/09 – Tintenpatrone III; BGH, 29.07.2010, Xa ZR 118/09 – Bordako.

⁸¹ OLG Düsseldorf, 11.11.2010, I 2 U 152/09 – Tintenpatronen.

⁸² Ohly 2008, 795.

The balancing of interests required for an interim injunction, however, and in particular the provisions in Sec. 24(1) No. 2 GPA,⁸³ Sec. 11 GPA, and Sec. 13(1) GPA, are important settings in which public interest considerations can be brought to bear. The general concept of public interest, which is embodied in these provisions, changes over time and cannot be lumped into a single, general formula.⁸⁴ It is a broad and multifaceted concept, encompassing, for instance, technical, economic, socio-political and medical aspects,⁸⁵ which factor into an assessment of whether an injunction would be proportional⁸⁶ under the circumstances of the case.⁸⁷ To give an idea, aspects hitherto considered (not only in interim injunction settings) were:

- the patent holder did not satisfy or could not satisfy domestic needs;⁸⁸
- improvement of the trade balance⁸⁹ and promotion of exports;⁹⁰
- improvement of the currency situation;⁹¹
- likely insolvency of the licensee and resulting increase in unemployment;⁹²
- increase in workplace safety;⁹³
- promotion of public health;⁹⁴
- continuous availability of a particular medicinal product,⁹⁵ in particular one that has major advantages (therapeutic properties, efficacy, reduced side effects) over similar products;⁹⁶
- the simultaneous pursuit of financial interests does not prevent presence of a public interest and the granting of a compulsory licence;⁹⁷
- the mere promotion of competition is not sufficient as a public interest.⁹⁸

⁸³ On the compatibility of this provision with Sec. 30 TRIPS, see *Wilhelmi* 2019, para. 24.

⁸⁴ BGH, 05.12.1995, X ZR 26/92 – Polyferon, para. 45.

⁸⁵ Rogge & Kober-Dehm 2015, para. 17; BGH, 05.12.1995, X ZR 26/92 – Polyferon, para. 50; BGH, 13.07.2004, KZR 40/02 – Standard-Spundfass, para. 21.

⁸⁶ See also, on proportionality-related modifications to the German legal framework, Section F.

⁸⁷ BGH, 05.12.1995, X ZR 26/92 – Polyferon, para. 50.

⁸⁸ RG, 27.05.1918, I. 89/17, para. 5; RG, 18.01.1936, I 90/35.

⁸⁹ RG, 27.06.1928, I 271/27, para. II.3.

⁹⁰ RG, 21.12.1935, I 18/35.

⁹¹ RG, 01.02.1938, I 173 174/36.

⁹² RG, 11.03.1926, I 243 244/25 – Stapelfaser, para. 2.a; RG, 24.01.1934, I 37/33 – Tonaufnahmeverfahren.

⁹³ RG, 11.02.1903, I 291/02.

⁹⁴ RG, 16.08.1935, I 44/35.

⁹⁵ BGH, 05.12.1995, X ZR 26/92 – Polyferon, para. 56; BPatG, 07.06.1991, 3 Li 1/90 – Zwangslizenz.

⁹⁶ Rogge & Kober-Dehm 2015, para. 21.

⁹⁷ *Id.*, para. 16.

⁹⁸ *Id.*, para. 16.

b. Compulsory Licences on Public Interest Grounds

Based on Art. 5A of the Paris Union Convention for the Protection of Industrial Property and Sec. 31 TRIPs almost all European countries have incorporated legal standards which provide for the right to a compulsory licence.⁹⁹ Under German law, if the patentee is unwilling to grant a licence for reasonable remuneration and if there is a public interest in such a licence, a compulsory licence shall be granted to the licence seeker (Sec. 24(1) No. 2 GPA). The presence of a public interest is determined according to the general criteria mentioned in Section D.1.a. So far, Sec. 24(1) GPA has gained traction mainly in the pharmaceutical field¹⁰⁰ and recent case law seems to indicate its relevance is growing there, although the provision is not applied regularly.¹⁰¹ An abusive exploitation of the patent by the patentee is not a necessary requirement for the grant of a compulsory licence under Sec. 24 GPA.¹⁰² Nor does the licence seeker's unsuccessful offer of licensing conditions (Sec. 24(1) No. 1 GPA) have to meet the requirements for a compulsory licence (defence) under competition law (e.g., dominance, FRAND or Orange Book requirements regarding content and timeframe; see Section D.3).¹⁰³ A compulsory licence is not warranted, however, where equivalent ways exist to satisfy the public interest.¹⁰⁴

The compulsory licence is an exception to the principle that the patent holder remains free to decide whether and how to grant licences enabling use of the patented invention for the benefit of the public interest.¹⁰⁵ Hence, the burden of proving the prerequisites for a compulsory licence lies with the licence seeker.¹⁰⁶ If it can show they are fulfilled, there is no judicial discretion, the licence seeker has a claim to the compulsory licence (Sec. 24 (1), 81 (1), 84 GPA)¹⁰⁷ and the court has to grant it.¹⁰⁸

The licence seeker can enforce its compulsory licence claim by way of an action before the Federal Patent Court (Sec. 81 GPA). The Patent Act also allows, in case

⁹⁹ Pitz 2019, 78.

¹⁰⁰ See Mes 2015, para. 2; BPatG, 31.8.2016, 3 LiQ 1/16; BPatG, 07.06.1991, 3 Li 1/90 – Zwangslizenz: permission to start selling infringing arthritis medication for a limited time period to patients not reactive to other medication, 8% royalty, revoked on the basis of different assessment of facts in BGH, 05.12.1995, X ZR 26/92 – Polyferon.

¹⁰¹ BPatG, 31.8.2016, 3 LiQ 1/16; BGH, 11.7.2017, X ZB 2/17 – Raltegravir: permission to continue selling patent infringing HIV medication in the territory and to the extent previously covered; *Wilhelmi* 2019, para. 7 with further references.

¹⁰² Mes 2015, para. 14.

¹⁰³ BPatG, 31.8.2016, 3 LiQ 1/16 (EP).

¹⁰⁴ Rogge & Kober-Dehm 2015, para. 16.

¹⁰⁵ E.g., if the possible uses are sufficiently researched or evaluated by the patentee himself, if an equivalent medicinal product or therapy is available for treatment, see BGH, 05.12.1995, X ZR 26/92 – Polyferon, para. 17, 19. *Wilhelmi* 2019, para. 5 et seq.

¹⁰⁶ See BGH, 05.12.1995, X ZR 26/92 – Polyferon, para. 68.

¹⁰⁷ Mes 2015, para. 30, 33; *Wilhelmi* 2019, para. 5, 48.

¹⁰⁸ *Wilhelmi* 2019, para. 25 with reference to RG, 29.06.1943, I 79/42.

of urgency, for the grant of a compulsory licence as an interim measure (Sec. 84 GPA).¹⁰⁹ The result of the court decision granting a compulsory licence is not an outright licence contract between the parties but the legalization of the patent use¹¹⁰ and a statutory, non-exclusive licence on the conditions¹¹¹ – especially the royalties – determined by the court.¹¹² Hitherto, patent infringers could not use pending proceedings regarding a compulsory licence under Sec. 24 GPA as a defence against the patentee's claim for an injunction.¹¹³ This may change in the future given the case law on competition law-based compulsory licences (see Section D.3). A decision – including preliminary rulings – granting a compulsory licence can, however, be raised in the infringement proceedings and prevent an injunction.¹¹⁴ Furthermore, the infringer can try to have the infringement court stay the injunction proceedings with regard to the pending compulsory licence proceedings if the compulsory licence is requested with retroactive effect and the court sees a sufficient likelihood – with regard to the requirements mentioned in Section C.1 – that it will be awarded.¹¹⁵

c. Expropriation Orders on Public Interest Grounds

Another key provision on public interest considerations is Sec. 13(1) GPA which states, in pertinent part:

(1) The patent shall have no effect in a case where the Federal Government orders that the invention is to be used in the interest of public welfare. Further, it shall not extend to a use of the invention which is ordered in the interest of the security of the Federal Republic of Germany by the competent highest federal authority or by a subordinate authority acting on its instructions. . . .

(3) In the cases referred to in subsection (1), the proprietor of the patent shall be entitled to equitable remuneration from the Federal Republic of Germany.

As to its legal nature, Sec. 13 GPA is – today mainly¹¹⁶ – considered not as a provision foreseeing a contract-based compulsory licence for the benefit of other market participants but as a provision permitting an expropriation of the patentee in the sense of Sec. 14(3) GC, by way of a state order and in exchange for an equitable remuneration. The expropriation order does not, however, invalidate the patent

¹⁰⁹ On details, see Mes 2015, para. 33; *Wilhelmi* 2019, para. 77.

¹¹⁰ BGH, 11.07.1995, X ZR 99/92 – *Klinische Versuche*, para. 22 et seq.

¹¹¹ See Mes 2015, para. 35 et seq.; *Wilhelmi* 2019, para. 52 et seq. for typical contents of a compulsory licence. *Inter alia*, the licence can be limited in scope and subject to case-specific obligations on the licensee.

¹¹² Mes 2015, paras. 33, 43.

¹¹³ *Pitz* 2012, para. 198.

¹¹⁴ Cf. *Rogge & Kober-Dehm* 2015, para. 36; *Wilhelmi* 2019, para. 85.

¹¹⁵ *Nieder* 2001, 401; *Pitz* 2012, para. 198.

¹¹⁶ Compulsory licence: RG, 28.09.1921, I 46/21, RGZ 102, 391; reflecting the public-good limitations to property following from Sec. 14(2) FL.

altogether; it is –and must strictly be¹¹⁷ – limited to the timespan and forms of use necessary to achieve the public interest goals.¹¹⁸ Sec. 13 GPA is considered to be coherent with Sec. 31 TRIPS.¹¹⁹ Its practical relevance is quite low¹²⁰ and the most interesting aspects regarding Sec. 13 GPA do (today) probably relate not so much to how the provision plays out in practice but to what it tells us about the possibility of and requirements for a limitation of patent exclusivity and property rights in the public interest, in particular from a constitutional and economic viewpoint.

As to some details of the provision, “public welfare” (Sec. 13(1)(1) GPA) is interpreted in a narrower sense than “public interest” in Sec. 24 GPA, addressing natural disasters, epidemics, attacks using biological weapons, and similar gruesome events.¹²¹ “Interest[s] of the security” (Sec. 13(1)(2) GPA) mainly addresses police or military concerns, as well as the protection of the population during catastrophic events.¹²² The expropriating “order” must be cloaked in the form of an administrative act specifying the (extent of the) public use to be made of the invention.¹²³ Importantly, an order under Sec. 13 GPA may only be issued if use of the patented invention cannot be ensured by other means, such as a (compulsory) licence or less extensive administrative orders.¹²⁴

2. *Compulsory Licence According to Sec. 24(2) GPA*

Sec. 24(2) GPA provides for the grant of a compulsory licence in situations where “a licence seeker cannot exploit an invention for which he holds protection under a patent with a later filing or priority date without infringing a patent with an earlier filing or priority date”. Instead of a specific public interest, the provision requires that the dependent patent embodies an important technical progress of considerable economic potential compared with the invention underlying the earlier patent.¹²⁵ In addition, the conditions of Sec. 24 (1) No. 1 GPA must be fulfilled (except public interest), namely the licence seeker must have made unsuccessful efforts within a reasonable period of time to obtain the consent of the patentee to use the protected invention on reasonable commercial terms (see Section D.1.b). By way of compensation for the grant of a compulsory licence, the owner of the earlier patent may request a counter-licence from the licence seeker on reasonable terms (Sec. 24 (2)).

¹¹⁷ Scharen 2015, para. 8.

¹¹⁸ BGH, 21.02.1989, X ZR 53/87 – Ethofumesat, para. 31.

¹¹⁹ Scharen 2015, para. 2.

¹²⁰ One of the very few cases: OLG Frankfurt PMZ 1949, 330.

¹²¹ Lenz & Kieser 2002, 401, 402 li.Sp. For a pre-World War II case-law example, see RG, 03.03.1928, I 242/27, RGZ 120, 267: protection of miners.

¹²² Scharen 2015, para. 6.

¹²³ *Id.*, para. 3.

¹²⁴ *Id.*, para. 4; Keuekenshijver 2016a, para. 8.

¹²⁵ Mes 2015, para. 20; Wilhelmi 2019, para. 37.

3. Competition Law

It is, meanwhile, a well-established principle in German and EU law that competition law rules can impact patent law, especially by limiting the claims and exclusivity rights of patent holders.¹²⁶ The focus of this chapter is, however, not on competition law as another part of this book deals with the topic.¹²⁷

4. General Abuse of Rights Doctrine, Sec. 242 GCC

In general German civil law, the abuse of a right is usually interpreted as one form of violating the duty to “perform according to the requirements of good faith, taking customary practice into consideration” (Sec. 242 GCC).¹²⁸ Courts have considered the exercise of patent rights to constitute such an abuse in a number of settings, including the enforcement of claims based on a patent which had been acquired by way of misrepresentations to the patent office;¹²⁹ contradictory positions the patentee defends in the infringement proceedings and in the validity proceedings respectively;¹³⁰ or the forfeiture of rights due to lapse of time.¹³¹ On the relevance of Sec. 242 GCC in the context of recent discussions about injunction law reform, see Section D.6.

5. Personal Characteristics of the Patentee or Infringer

a. Infringers

In some cases, injunctions are not successful because of who claims them or against whom they are claimed. Indirect/contributory infringers and co-liable persons (*Störer*) cannot be targeted as long as the specific requirements for an injunction against them are not met. The same goes for other groups in the holding to which the infringing company belongs.¹³² Furthermore, injunctions are not possible against civil servants who have committed an infringement, as long as the state takes liability (*Amtshaftung* – public liability).¹³³ The situation is similar for those

¹²⁶ See BGH, 6.5.2009, KZR 39-06 – Orange Book-Standard; CJEU, 16.07.2015, C-170/13 – Huawei Technologies; CJEU, 05.10.1988, C-238/87 – AB Volvo/Veng; Unwired Planet v. Huawei, [2017] EWHC 711 (Pat); Commission Decision, 29.04.2014, AT.39939 – Samsung; Drexl, 2008, XV; Heinemann 2002, 1, 178 et seq., 321 et seq.; Pregartbauer 2017, 2.

¹²⁷ See, with a view specifically to the impact on German injunction case law Picht 2019b, S. 324; Picht 2019a, 1097.

¹²⁸ Sutschet 2019, para. 47 et seq.

¹²⁹ RG, 25.03.1933, I 226/32, RGZ 140, 187 et seq; Kohler 1888, 162 et seq. This position has been criticized in the academic literature, see e.g., Schulte 2017, § 9 para. 79; Mes 2015, § 9 para. 79.

¹³⁰ BGH, 05.06.1997, X ZR 73/95 – Weichvorrichtung II.

¹³¹ BGH, 19.12.2000, X ZR 150/98 – Temperaturwächter, para. 15.

¹³² OLG Düsseldorf, 16.02.2006, I-2 U 32/04 – Permanentmagnet; Buxbaum 2009.

¹³³ BGH, 21.09.1978, X ZR 56/77 – Straßendecke I, para. 24.

protected by a licence contract (Sec. 15(2) GPA), (the right to) a compulsory licence (Sec. 24 GPA), or some other legal position as a result of which they are not considered to have committed an infringement. To the extent the economic effects of an injunction on the defendant are considered in gauging the proportionality of the injunction, characteristics such as the SME status of the defendant can become relevant. We will say more on this aspect in Section D.6.

b. Plaintiffs

On the side of the plaintiff/patent owner, a focus in case law and literature is on the treatment of so-called non-producing entities (NPEs).¹³⁴ It follows from the almost “automatic nexus” between infringement and injunction (on limitations see Section D.7) in German statutory patent law, as well as from a relatively patentee-friendly tradition in German case law,¹³⁵ that – so far – courts do not systematically deny injunctive relief to a certain type of plaintiff.¹³⁶ Some decisions have been restrictive in granting injunctions to NPEs in the context of temporary relief¹³⁷ or the provisional enforcement of first-instance decisions.¹³⁸ However, with regard to NPEs enforcing patents in the particularly sensitive field of SEPs regarding Information and Communication Technologies (ICT-SEPs), the Düsseldorf Higher Regional Court has underscored, in a high-profile FRAND case, that they should not a priori be treated differently from other patentees.¹³⁹

In a more recent decision,¹⁴⁰ though, the same court has established some boundaries regarding the enforcement of SEPs acquired by an NPE from the original patent holder. It is of vital importance, in such cases, whether a FRAND declaration made by the previous patent owner obliges the acquirer to offer licences on FRAND conditions to standard implementers as well, or whether the acquirer remains free to seek an injunction even though an implementer proves willing to take such a licence. Sometimes, an acquiring NPE will have made its own FRAND declaration, for instance because the relevant standard was set only after the patent acquisition or because the acquirer contractually undertook to do so, but there is no guarantee and implementers may, hence, have to seek refuge from an injunction in the previous patentee’s FRAND declaration. Coming to their rescue, the Düsseldorf court held that the acquirer of a SEP is directly and necessarily bound to the FRAND declaration of its predecessor, even absent an express or implied declaration

¹³⁴ There is no obligation to use a patent in German patent law; Pitz 2012, para. 75.

¹³⁵ Contreras & Picht 2017, 6.

¹³⁶ See Osterrieth 2009, 542, in particular on NPEs.

¹³⁷ LG Düsseldorf, 08.07.1999, 4 O 187/99 – NMR-Kontrastmittel.

¹³⁸ OLG Karlsruhe, 11.05.2009, 6 U 38/09 – Patentverwertungsgesellschaft.

¹³⁹ OLG Düsseldorf, 13.01.2016, I-15 U 66/15 – Sisvel/Haier, para. 11.

¹⁴⁰ OLG Düsseldorf, 22.03.2019, 4b O 49/14.

to this effect.¹⁴¹ In the court's view, the FRAND licensing commitment has the effect that the patentee no longer holds an exclusivity right which would allow its holder discretion to permit or prohibit use of the patent. Instead, as a result of the FRAND declaration, the rights from the patent are now limited by the obligation to allow access on FRAND terms. Very importantly, the court seems – the language of the decision is somewhat ambiguous regarding the doctrinal level but it may draw on a similar proposal in the literature¹⁴² – to derive this limitation not from a contractual promise, the lack of which could remove the limitation, but from a modification of the patent *in rem* due to a waiver contained in the patentee's FRAND declaration. Hence, the owner can transfer its patent only together with the FRAND “encumbrance” and the presence or absence of an additional FRAND declaration by the acquirer has no impact on the FRAND licensing obligation. Nor, according to this Düsseldorf decision,¹⁴³ can the acquirer usually claim an injunction if an implementer refuses to license the SEP on terms incompatible with those offered by the previous patentee. This is because the court finds, based *inter alia* on Sec. 15(3) GPA,¹⁴⁴ that the previous FRAND commitment binds the acquirer not only in a general way, but also regarding the licensing practice of the previous patent holder. Existing licence agreements, in particular, do not end or alter their terms and conditions only because of the transfer. As another – and, for once, patentee-friendly – implication of these findings, the Düsseldorf court perceives no competition law violation where the contractual arrangements between patent seller and buyer do not explicitly oblige the buyer to make or honour a FRAND commitment since the FRAND obligation travels with the patent anyway,¹⁴⁵ arguably even if the purchaser is unaware of the FRAND declaration. In consequence, an implementer, especially one who is not willing to take a FRAND licence, cannot raise the absence of such a contractual obligation as a competition law defence against the acquirer's injunction claim.

6. Proportionality

a. Traditional Legal Framework

German courts do take proportionality into consideration where they have judicial discretion, such as in the granting of interim injunctions or in the decision on provisional enforceability of injunctions.¹⁴⁶ However, according to German statutory

¹⁴¹ On this and the following, see OLG Düsseldorf, 22.03.2019, 4b O 49/14, para. 203 et seq.

¹⁴² See, in particular, Ullrich 2010a, 14, 90 et seq.

¹⁴³ On this and the following, see OLG Düsseldorf, 22.03.2019, 4b O 49/14, para. 240.

¹⁴⁴ Sec. 15(3) GPA: “A transfer of rights or the grant of a licence shall not affect licences previously granted to third parties.”

¹⁴⁵ OLG Düsseldorf, 22.03.2019, 4b O 49/14, para. 242.

¹⁴⁶ Haft et al. 2011, 928; Pitz 2012, para. 76.

patent law, the claim to an injunction was, hitherto, not subject to a general proportionality requirement or a balancing of the parties' interests.¹⁴⁷ While proportionality is explicitly mentioned in Sec. 140a GPA (claim for destruction of products) and Sec. 140b GPA (claim for information), Sec. 139 GPA, as the core provision on injunctions, did not explicitly establish a proportionality threshold.¹⁴⁸ Nor is there anything like a broadly available, US-style "eBay" balancing test.¹⁴⁹ Apart from the settings just mentioned, German courts tended – and may well continue to tend – to create an almost automatic link between the establishment of a patent infringement and the granting of an injunction.¹⁵⁰ Many scholars agree that there was no such thing as a general, effective proportionality threshold in traditional German patent injunction law.¹⁵¹ This has, as noted, made Germany an attractive venue to patentees. Recent developments and a revision of the GPA may, however, increase the relevance of proportionality notions, as we will discuss in the following Section.

b. Revision of Sec. 139 GPA

In August 2021, a revised version of the Patent Act took effect¹⁵² and modified German patent injunction law in mainly three respects. First, the bill adds flexibility to Sec. 139(1) GPA by stating in Sec. 139(1)(3) GPA that the claim to injunctive relief is precluded to the extent it would, due to the special circumstances of the individual case and in view of the principle of good faith (*Gebote von Treu und Glauben*), lead to disproportionate hardship on the infringer or third parties which would not be justified by the patent exclusivity right.

Second, in case and to the extent an injunction is thus precluded, the injured party is entitled to appropriate monetary compensation (*angemessener Ausgleich in Geld*, Sec. 139(1)(4) GPA). Such compensation leaves "unaffected" (*unberührt*) a claim for damages, Sec. 139(1)(5) GPA.¹⁵³

Third, in bifurcated proceedings, the Federal Patent Court is supposed to send a qualified opinion on the validity of a patent to the parties and the infringement court

¹⁴⁷ Hessel & Schnellhom 2017; Haft et al. 2011, 928.

¹⁴⁸ Osterrieth 2009, 543; cf. Pitz 2019a, para. 74.

¹⁴⁹ Contreras & Picht 2017, 4. See also Chapter 14 (United States).

¹⁵⁰ Osterrieth 2018, 987.

¹⁵¹ Hessel & Schnellhom 2017, 672; Osterrieth 2015a, para. 119.

¹⁵² Zweites Gesetz zur Vereinfachung und Modernisierung des Patentrechts.

¹⁵³ In German, the wording of Sec. 139(1)(3)–(5) GPA is as follows: "Der Anspruch ist ausgeschlossen, soweit die Inanspruchnahme aufgrund der besonderen Umstände des Einzelfalls und der Gebote von Treu und Glauben für den Verletzer oder Dritte zu einer unverhältnismäßigen, durch das Ausschließlichkeitsrecht nicht gerechtfertigten Härte führen würde. In diesem Fall ist dem Verletzten ein angemessener Ausgleich in Geld zu gewähren. Der Schadensersatzanspruch nach Absatz 2 bleibt hiervon unberührt".

within six months from the filing of an action for annulment (Sec. 83(1)(2), (3) GPA), a timeframe that did not hitherto exist.¹⁵⁴

To a certain extent, the wording of and rationale behind Sec. 139(1)(3) GPA¹⁵⁵ implements a proportionality limitation introduced by the Federal Supreme Court in its *Heat Exchanger (Wärmetauscher)* decision.¹⁵⁶ In this decision, the BGH firmly settled¹⁵⁷ that, in principle, injunctions can be subject to a use-by period during which the infringer has, in particular, the opportunity to sell off infringing products before the injunction takes effect.¹⁵⁸ The court drew this limitation from the general principle of good faith (Sec. 242 GCC) and from similar unfair competition case law¹⁵⁹ and perceives it to be in line with Art. 30 TRIPS, Art. 3 of the Enforcement Directive, and the case law of the UK courts.¹⁶⁰ At the same time, the BGH defined a rather restrictive threshold for the granting of such a use-by period, stating that it can only be considered if the immediate enforcement of the injunction would, due to special circumstances of the individual case, constitute a hardship that is disproportionate and therefore contrary to good faith even in view of the patentee's interests, of the exclusivity of the patent right, and of the regular consequences of its enforcement.¹⁶¹ Aspects relevant for this test are, inter alia, whether the infringing item constitutes an essential component of a complex product, whether there was an acceptable option for licensing the infringed patent, whether the remaining protection period for the patent is long or short, whether an immediate injunction would have a grave and disproportionate impact on the (entire) business of the infringer, and whether the infringement was a culpable one.¹⁶² Importantly, the fact that the lower instances did not consider the challenged embodiment to infringe the patent does not – according to the BGH – give rise to an assessment more favourable to the infringer as it cannot legitimize the expectation that these decisions will not be overturned.¹⁶³

While the revised Sec. 139(1) GPA is clearly rooted in this case law, it goes a step beyond it. In particular, it arguably introduces a somewhat more general proportionality requirement, allows for the consideration of third-party interests (see also below

¹⁵⁴ In German, the wording of Sec. 83(1)(2), (3) is as follows: “Dieser Hinweis soll innerhalb von sechs Monaten nach Zustellung der Klage erfolgen. Ist eine Patentstreitsache anhängig, soll der Hinweis auch dem anderen Gericht von Amts wegen übermittelt werden”.

¹⁵⁵ Entwurf eines Zweiten Gesetzes zur Vereinfachung und Modernisierung des Patentrechts, 2020, p. 50 et seq. For key excerpts from this passage in English, see Cotter 2020.

¹⁵⁶ BGH, 10.05.2016, X ZR 114/13 – Wärmetauscher (the decision is sometimes also called “Air Scarf”, after the name of the product at issue).

¹⁵⁷ Previous decisions by the Federal Supreme Court had left this open, see BGH, 02.12.1980, X ZR 16/79 – Heuwerbungsmaschine II.

¹⁵⁸ BGH, 10.05.2016, X ZR 114/13 – Wärmetauscher, para. 40 et seq.

¹⁵⁹ *Id.*, para. 42, 45.

¹⁶⁰ *Id.*, para. 46 et seq.

¹⁶¹ *Id.*, para. 41.

¹⁶² *Id.*, para. 52 et seq.

¹⁶³ *Id.*, para. 53.

in this section), and grants a claim to financial compensation without the need for the patentee to show damages or, in fact, any of the requirements for a claim to damages.

The envisaged modification to Sec. 139(1) GPA triggered a broad range of reactions. Some criticized the new provision as a measure cementing the status quo instead of raising the bar for injunctions.¹⁶⁴ Those who suggested, in view of the initial draft, taking third-party interests into consideration and relaxing the link between an injunction stay and the fulfilment of the *Heat Exchanger* criteria¹⁶⁵ were sympathetic towards the reform bill's subsequent modifications.¹⁶⁶ The Max Planck Institute welcomed the introduction of a proportionality test but criticized the precedence it grants the patentee's interests.¹⁶⁷ Other commentators deemed the new provision to strike a good compromise between firmness and flexibility in the granting of injunctive relief, not least by dispelling German judges' hesitations to take into account considerations of proportionality in Sec. 139 GPA.¹⁶⁸ There were, however, also those who denied any need for a modification of Sec. 139 GPA, for instance because they deemed it to inappropriately weaken patent protection and Germany's attractiveness as a patent (litigation) venue, to violate the TRIPS and the EU Enforcement Directive, or to be unnecessary in view of the EU Enforcement Directive's proportionality precept.¹⁶⁹

Given the intense, controversial debate over whether and how a proportionality defense should be introduced into German patent injunction law, it is worthwhile to look at what the legislature has to say in the legislative materials:¹⁷⁰ It considers the modifications to be, first and foremost, a legislative clarification of a principle rooted in the German constitution, in civil law provisions on good faith and relief from unreasonable obligations, as well as in the EU Enforcement Directive. According to Art. 3(2) of said Directive, measures, procedures and remedies for the enforcement of intellectual property rights must be not only effective and dissuasive, but also proportionate. The legislative materials concur with the view that the principle of proportionality – at least by way of an interpretation in conformity with EU law – already applies to the claim for injunctive relief and that the reluctance of German (lower instance) courts to apply it renders a clarification to this effect worthwhile. At the same time, a proportionality defence must be restricted to exceptional settings as

¹⁶⁴ Müller 2020.

¹⁶⁵ Ohly 2020.

¹⁶⁶ *Id.*

¹⁶⁷ Desaunettes-Barbero et al. 2020, 3 et seq., 6 et seq.

¹⁶⁸ Dijkman 2020.

¹⁶⁹ See, for instance, Stellungnahme Deutsche Vereinigung für gewerblichen Rechtsschutz, 29 September 2020; Stellungnahme Bundesverband Deutscher Patentanwälte, 23 September 2020; Stellungnahme Prof. Dr. Winfried Tilmann, 2 September 2020, all available at www.bmjv.de/DE/Startseite/Startseite_node.html.

¹⁷⁰ On the following, see Justification of the government in Entwurf eines Zweiten Gesetzes zur Vereinfachung und Modernisierung des Patentrechts, p. 58 et seq.

it interferes with the core of patent exclusivity rights. In line with such a restrictive application, the patent infringer bears the burden of proof for the disproportionality of the claim and the court must engage in a thorough weighing of all relevant circumstances, taking into account also the paramount, legitimate interest of the patentee in enforcing its right to an injunction. While the recast Sec. 139(1) GPA refrains from listing exemplary settings or criteria for a proportionality defence, the legislative materials identify as relevant (i) the legitimacy of the patentee's interest in an injunction, depending inter alia on whether the patentee manufactures patent-based products itself or merely monetizes the patent, and on whether the patentee's royalty claims seem exaggerated; (ii) the severity of the injunction's economic effects on the infringer, resulting for instance from substantial R&D that went into the infringing product; (iii) the complexity of the infringing product, especially where an injunction based on the infringing nature of one of its many patented components would – possibly in combination with market approval requirements for the product – necessitate the infringer to invest much time and resources in a design-around and to suspend production for a longer period of time; (iv) “subjective” aspects, for instance the nature and extent of the infringer's culpability, including whether it undertook a freedom-to-operate analysis and made sufficient efforts to obtain a licence, as well as the patentee's compliance with good-faith principles, which may for instance be questionable where the patentee deliberately delays the assertion of its injunction until the infringer has made considerable investments in the infringing product; (v) severe harm to fundamental third-party interests,¹⁷¹ for instance where an injunction would endanger the supply of vital drugs or the maintenance of important infrastructure.

As to the consequences of a successful proportionality defence, the legislature underlines that, instead of denying the injunction entirely, use-by or work-around periods may be the appropriate remedy. To the extent an injunction is denied, the patentee must usually receive monetary compensation, to be determined in the court decision. In addition to this compensation, the patentee remains free to claim damages under Sec. 139(2) GPA.

It remains to be seen whether these changes will profoundly alter the course of German patent injunction law. As to the proportionality requirement, this will very much depend on whether the courts interpret the provision as a prompt to stay, or even refuse, injunctions more frequently and whether they limit its application to a narrow set of cases¹⁷² displaying facts similar to the *Heat Exchanger* case. Initial

¹⁷¹ With this consideration, the legislature rejects, at the same time, German case law which considered compulsory licences under Sec. 24 PatG as the only appropriate option for protecting such third-party interests, see Justification of the government in Entwurf eines Zweiten Gesetzes zur Vereinfachung und Modernisierung des Patentrechts, p. 62.

¹⁷² For a discussion on what the *Heat Exchanger* criteria mean for FRAND cases, see Picht 2019b, 1097.

reactions by the judiciary do, indeed, indicate such a restrictive approach.¹⁷³ As to the claim for financial compensation, some judges and scholars have already argued¹⁷⁴ that, for the sake of deterrence, the level of compensation should be substantially higher than a reasonable royalty rate, while others consider the reasonable royalty as the appropriate starting point, to be complemented by damages claims and augmented in appropriate settings, for instance where third-party interests are the main basis for the proportionality defence and, hence, the infringer seems not entitled to any profits from the continuing use of the patented invention.

7. Further Limitations

There are some further limitations to injunctions worth mentioning. According to Sec. 712(1) CCP, a patent infringer can, in its capacity as addressee (debtor) of the claim to an injunction, file a petition for protection “insofar as the enforcement would entail a disadvantage for the debtor that it is impossible to compensate or remedy . . . The court is to allow him, upon a corresponding petition being filed, to avert enforcement by providing security or by lodgement, without taking account of any security that the creditor may have provided”. Sec. 712(2) CCP states that “the petition filed by the debtor shall not be complied with if an overriding interest of the creditor contravenes this”. In practice, hurdles for success of such a petition are quite high in the patent injunction field.¹⁷⁵

The infringer can raise a complaint based on a violation of their right to be properly heard in the infringement proceedings (*Anhörungsrüge*, Sec. 321a CCP, Sec. 103(1) FL). If successful, the complaint results in a continuation of the (infringement) proceedings and the infringer can request that the enforcement of the injunction be stayed (Sec. 707 CCP).

Failure to send a warning/cease and desist letter prior to filing for an injunction will, in principle, not limit the patentee’s right to an injunction. The main legal consequence (strategic disadvantages aside) of not sending such warning/cease and desist letter can be that the patentee has to bear the litigation costs if the infringer acknowledges the infringement (Sec. 93 CCP).¹⁷⁶

¹⁷³ Views expressed and referred to during the CIPLITEC Conference on “Patentrecht: Der Anspruch auf Unterlassen nach dem 2. PatMoG”, 21/22 October 2021, notes on file with the authors and materials partially available at www.ciplitec.de/veranstaltung/der-patentrechtliche-unterlassungsanspruch-nach-dem-2-patmog/.

¹⁷⁴ Views expressed and referred to during the CIPLITEC Conference on “Patentrecht: Der Anspruch auf Unterlassen nach dem 2. PatMoG”, 21/22 October 2021, notes on file with the authors and materials partially available at www.ciplitec.de/veranstaltung/der-patentrechtliche-unterlassungsanspruch-nach-dem-2-patmog/.

¹⁷⁵ Osterrieth 2009, 543, reference to BGH, 20.06.2000, X ZR 88/00 – Spannvorrichtung; OLG Düsseldorf, 16.11.1978, 2 U 15/78 – Flachdachabläufe.

¹⁷⁶ Osterrieth 2015a, para. 1060. On the reduced (e.g., oral warning sufficient) requirements for a sufficient warning before the filing for a preliminary injunction, see LG München I,

Enforcement of an injunction under Sec. 89o CCP can become problematic if the infringer subsequently modifies the contested embodiment (*angegriffene Ausführungsform*) against which the injunction has been issued: While it is admissible to work around the patent, to develop and sell a non-infringing product, the infringer must not continue to market products which have been modified only to such a slight extent that the core of the enjoined infringing¹⁷⁷ conduct remains the same (*kerngleiche Handlung*).¹⁷⁸

General patent protection requirements obviously have an impact on patent injunctions as well. Examples are acts of use permitted under Sec. 11 GPA,¹⁷⁹ priority rights (Sec. 12 GPA), lapse (Sec. 20 GPA) or exhaustion of the patent, usurpation of the invention by the patentee vis-à-vis the “infringer”, (Sec. 8 GPA), or the free state-of-the-art defence.¹⁸⁰ At least some German scholars contend that an injunction, being a future-oriented remedy, should not be granted where the patent is about to expire.¹⁸¹

Use-by periods, permitting an infringer to sell or use infringing products within a certain time period after the injunction has been granted, were arguably always possible under German patent law, but the option remained a rather theoretical one as courts were reluctant to grant such deferrals.¹⁸² However, use-by periods may become somewhat more frequent due to the modification of Sec. 139 GPA (see Section D.6).

E. ALTERNATIVES TO INJUNCTIVE RELIEF

The injunction is a core remedy in case of patent infringement, but it is by no means the only one. The patentee can combine its injunction claim with other civil and criminal patent infringement claims.¹⁸³ These include, in the case of intentional or negligent infringement, claims for compensation according to Sec. 139(2) GPA.

09.06.2011, 7 O 2403/11 – Lawinenschutzrucksack; LG München I, 10.11.2010, 21 O 7656/10 – Messeauftritt, para. 18; OLG Düsseldorf, 12.01.2004 – INTERPACK.

¹⁷⁷ Whether a modified product continues to realize the core of the enjoined, infringing conduct must, to a large extent, be determined by interpreting the injunction decision, Voß 2019, para. 400.

¹⁷⁸ OLG Frankfurt, 14.04.1978, 6 W 12/78 – Küchenreibe; OLG Karlsruhe, 30.11.1983, 6 W 88/83 – Andere Ausführungsform; OLG Düsseldorf, 10.06.2010, 2 U 17/09 – Münzschloss II; LG Düsseldorf, 22.07.2005, 4b O 327/04 – Rotordüse; BGH, 08.11.2007, I ZR 172/05 – Euro und Schwarzgeld; BGH 23.02.1973, I ZR 117/71 – Idee-Kaffee I.

¹⁷⁹ Sec. 11 GPA permits in principle acts privately done, acts for experimental purposes, the extemporaneous preparation for individual cases, the use on-board vessels and the use in the construction or the operation of aircraft or land vehicles of another state party to the Paris Convention for the Protection of Industrial Property, and finally the acts specified in Art. 27 of the Convention on International Civil Aviation of 7 December 1944.

¹⁸⁰ The so-called Formstein defence; see BGH, 29.04.1986, X ZR 28/85 – Formstein.

¹⁸¹ Kraßer & Ann 2016, § 35 para. 12.

¹⁸² Grabinski & Zülch 2015, para. 136a.

¹⁸³ Kraßer & Ann 2016, § 33 para. 25; Grabinski & Zülch 2015, para. 27; Hofmann 2018, 1291.

Additionally, patentees may – subject to a proportionality test (Sec. 140a(4) GPA) – request reparative measures in the form of claims for destruction (Sec. 140a(1), (2) GPA), “for recall of the products which are the subject-matter of the patent[,] or for definitive removal of the products from the channels of commerce” (Sec. 140a(3) GPA).¹⁸⁴ In specific situations, these reparative measures may be granted although the patentee is not entitled to an injunction. In particular, the German Federal Court of Justice has held that destruction of infringing products can be requested even after expiration of the infringing patent.¹⁸⁵ Furthermore, a patentee can – if the respective requirements are fulfilled – claim the provision of information (Sec. 140b GPA), the “production of a document or inspection of an item which lies in [the infringer’s] control or of a process which is the subject-matter of the patent” (Sec. 140c(1) GPA), the production of or access to bank, financial or commercial documents (Sec. 140d(1) GPA), as well as the publication of a judgment in its favour (Sec. 140e GPA). In addition to the GPA claims, the patentee may have claims under general civil law.¹⁸⁶ Such GCC claims are declared applicable by Sec. 141a GPA. Last but not least, an infringement can trigger criminal and customs sanctions according to Sec. 142 GPA and Sec. 142a GPA. These additional claims are distinct from and parallel to the injunction, i.e. they are not merely a facet and consequence of the claim for an injunction and the patentee can petition for them independently. For a long time, it had been firmly established in German case law that other infringement remedies do not constitute an alternative to injunctions in the sense that courts would award them in lieu of injunctive relief. Instead, injunctions were, and largely still are, regarded as an almost indispensable consequence of patent infringement.¹⁸⁷ Of late, however, a discourse has evolved on whether German injunction rules ought to be more flexible, including the award of other remedies in lieu of an injunction. As described in Section D.6., this has even induced changes to the German Patent Act, the practice impact of which remain, however, to be seen.

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¹⁸⁴ Osterrieth 2015b, para. 26.

¹⁸⁵ BGH, 21.02.1989, X ZR 53/87 – Ethofumesat; Kühnen 2017, para. 1405 et seq.

¹⁸⁶ In particular removal of the consequences of an infringement, Sec. 823(1), 1004 GCC; unjust enrichment, Sec. 812 et seq. GCC; and/or accounting, Sec. 242, 677, 681, 666 GCC (by way of analogy).

¹⁸⁷ Osterrieth 2018, 987.

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