

Bird & Bird

# Germany

Patent Litigation Q&A

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# Germany – Patent Litigation

## Where can patent infringement actions be started? Is there a choice of venue?

### Regional Courts

Patent infringement actions in Germany are initiated in Regional Courts (German: “*Landgericht*”). In order to maintain a specialized judiciary, the legislator selected 12 Regional Courts, in which patent litigation chambers were established. These have exclusive jurisdiction for patent disputes. Patent litigation chambers currently exist at the Regional Courts of Munich I, Nuremberg-Fürth, Mannheim, Frankfurt, Saarbrücken, Erfurt, Leipzig, Magdeburg, Düsseldorf, Braunschweig, Berlin and Hamburg. Out of these, Munich, Düsseldorf, Mannheim and Hamburg are most regularly seised.

### Choice of Venue

In addition to the Defendant's place of business, the place of jurisdiction for the tort is of practical importance in patent infringement cases. It is given at any place where a patent infringement has been committed (e.g. where the attacked embodiment has been offered or put on the market). Since this is often the case throughout the territory of Germany, an infringement action can be brought in the forum of choice.

## Are the judges’ specialists? Do they have technical backgrounds?

Germany has a bifurcated system. This means that infringement issues are dealt with by the Regional Court, while validity will be handled by a different panel (either before the EPO or the national instances). German nullity actions are brought before a special court, the Federal Patent Court (first instance). In nullity actions, the panels (Senates) consist of two legal judges and three technical judges with formal technical training.

The Regional Court judges handling infringement proceedings are specialized in cases relating to patent infringement and have gained significant experience in infringement issues concerning different technical issues. However, they usually do not have a technical background.

## How long does it take from starting proceedings to trial?

The duration of infringement proceedings varies depending on the forum and the workload of the judges. Generally, infringement courts aim to set the hearing 12-15 months after initiating an action.

## Can a party be compelled to disclose documents before or during the proceedings?

The German Code of Civil Procedure contains possibilities for the Court to order the disclosure of documents that are relevant for the proceedings. However, this is rather seldom and not as extensive or common as for example in the USA or in the UK. In particular, the Court will have to determine whether the disclosure is proportionate and weigh up the relevant interests (i.a. trade secrets). Note that there are also provisions in German law to keep information confidential.

## How are arguments and evidence presented at the trial?

Most factual evidence has already been introduced by the time of the hearing through prior written submissions. The oral hearing basically serves to clarify open questions for the court. Thus, the presiding judge often introduces their view of the case, indicating the critical issues that shall be discussed in the oral hearing.

Parties can submit their own party expert opinions. It is possible, though not common, to hear party experts at the hearing.

The Court can also decide to appoint a neutral Court expert who shall issue an expert opinion. They can then be ordered to explain their expert opinion in an oral hearing and be questioned by the Court and the parties.

## How long does the trial generally last and how long is it before a judgment is made available? Are judgments publicly available?

An infringement hearing typically lasts a few hours, though it can take an entire day in complex cases.

The court's aim is to deliver their decision within 2-4 weeks after the hearing. In some cases, the decision grounds are already available then.

Judgments are not generally publicly available; however some decisions are made available in anonymized form. The judgments are made publicly available, but the court does not publish them. Judgments are typically available on private dedicated web platforms.

### Can a defence of patent invalidity be raised? Are infringement and validity issues heard together?

Since Germany has a bifurcated system, infringement courts cannot decide on validity issues of the patent-in-suit. Instead these issues are heard by other panels (i.e. EPO or Federal Patent Court).

However, in main proceedings, validity issues can be raised as a reason for staying the proceedings until a decision of the technical panel regarding the validity action of the concerned patent is made.

Also, in preliminary injunction proceedings, the Court will consider validity issues in the context of the ground for an injunction.

### Are infringement proceedings stayed pending resolution of validity in the national patent office (or, if relevant, the EPO) or another court?

A stay of infringement proceedings pending a decision in parallel validity proceedings is possible. This is a discretionary decision for the infringement courts. The Court will consider the chances of success of the validity attack. In principle, a stay will only be ordered if the court concludes that it is highly probable that the patent will be revoked in the parallel validity proceedings.

### Are preliminary injunctions available? If they are, can they be obtained *ex parte*? Is a bond necessary? Can a potential defendant file protective letters?

Preliminary injunctions are available and can be granted if the necessary conditions are met. For this, the applicant must substantiate a claim for injunction and a ground for injunction.

- A claim for injunction basically requires that the applicant substantiates infringement of the concerned patent by the respondent.
- A ground for injunction basically requires urgency in terms of time and that a general weighing of interests of the applicant and the respondent is in favor of the applicant. In this regard, a core issue is whether the patent's validity is sufficiently secured. According to settled case law, this will usually only be assumed if the patent has already survived opposition or nullity proceedings in the first instance. However, there are various exceptions to this rule, e.g. in cases involving generic market entry.

Preliminary injunctions can also be ordered *ex parte*, though this is rather the exception. In particular, the German Federal Constitutional Court has set high requirements regarding the right to be heard.

If ordered, a preliminary injunction contains an injunction (e.g. no manufacturing, offering, distributing) in the territory of Germany. Said decision will have to be enforced by the Applicant. It is rather common (but not necessary) that a Court will order a bond for enforcing a preliminary injunction decision.

It is possible to file protective letters at a central court register valid for all German courts. These are in force for intervals of 6 months and can be renewed. The Applicant will only learn of the protective letter's existence upon filing a PI request.

### Are final injunctions available as of right? Is a bond necessary?

An injunction can be lifted, e.g. via an objection (Widerspruch), appeal or in case of changed circumstances. However, it is possible to request a final declaration (German: "Abschlusserklärung") from the Defendant, i.e. a declaration that the preliminary injunction is accepted as a legally binding principal title.

## What other remedies are usually ordered if a patentee is successful?

In an action on the merits, the Plaintiff can basically request the following remedies:

- Injunction
- Accounting and information
- Determination of obligation to pay damages
- Destruction
- Recall
- Publication of Judgment
- (Compensation claim in case of using a published patent application)

In PI proceedings, the following remedies can be ordered:

- Injunction
- In the case of an *obvious* infringement: information on origin and distribution chain of the attacked product
- Custody for securing the destruction claim

## Would the tribunal consider granting cross-border relief?

If the international jurisdiction of the German court is given, infringement of a foreign patent could be asserted before a German Court. The principle of territoriality of patent law then requires that a German court applies the law of the state in which the patent is in force.

However, there is a considerable risk regarding jurisdiction, if the applicable foreign law allows a defense of invalidity in the infringement proceedings. In this case, Article 24(4) of the Brussels Ia-Regulation provides for an exclusive jurisdiction of the Court of the granting member state. The exclusive jurisdiction has been interpreted broadly by the CJEU and covers all cases in which the validity of the IP right is challenged, irrespective of whether this is done by way of an action or by way of a plea (CJEU decision C-4/03 – *Gat/LuK*). Since it is common practice for the infringement defendant to contest the validity of the patent in a lawsuit, insofar as this is admissible, this means that cross-border proceedings in patent disputes are de facto excluded or depend solely on the defense of the defendant.

However, the exclusive jurisdiction of Article 24(4) of the Brussels Ia Regulation has no effect on the jurisdiction for preliminary measures (Article 35 of the Brussels Ia Regulation; cf. CJEU decision C-616/10 – *Solvay/Honeywell*).

## Is there a right of appeal from a first instance judgment? How long between judgment at first instance and hearing the appeal?

The first instance judgment can be appealed. The deadline for filing the formal appeal is 1 month following the service of the written decision.

The duration of an appeal depends on the Court and the workload of the judges. Typically, we estimate around 12-15 months.

## Is an appeal by way of a review or a rehearing? Can new evidence be adduced on appeal?

In infringement proceedings, the appellate instance is a second, albeit limited, factual instance whose task is to obtain an error-free and convincing and thus correct decision of the individual case.

The appeal court will basically review the matter on the basis of the facts determined in first instance. New evidence may be introduced in second instance under certain prerequisites (exclusion in case of preclusion/delay).

What is the cost of a typical infringement action to first instance judgment? If the issues of invalidity and infringement are bifurcated, what is the cost of the invalidity action? Can the winner's costs be recovered from the losing party? How much is the cost of an appeal?

### **Infringement Proceedings**

The statutory costs of infringement proceedings depend on the value in dispute, which is suggested by the Plaintiff and later determined by the court. In patent infringement matters, the value in dispute is often between €1 million to €5 million. The maximum value in dispute is €30 million.

#### **First instance infringement proceedings**

The Plaintiff has to advance the Court fees (calculated on the basis of the value in dispute).

As an example: For a value in dispute of 5 million EUR, the Court fees would be around €65,000.

The winner can recover costs from the losing party. This mainly concerns statutory attorney's and patent attorney's costs and possibly advanced Court fees. Further costs, such as those for private expert opinions, can be recoverable if these are considered "necessary" – but this is often the subject of a subsequent dispute.

As an example: For a value in dispute of 5 million EUR, the statutory attorney's and patent attorney's fees would be around €92,000.

#### **Second instance infringement proceedings**

The Appellant has to advance the Court fees (again, calculated on the basis of the value in dispute).

As an example: For a value in dispute of 5 million EUR, the Court fees on appeal would be around €87,000.

Also on appeal, the winner can recover costs from the losing party. This mainly concerns statutory attorney's and patent attorney's costs and possibly advanced Court fees and/or appeal fees.

As an example: For a value in dispute of 5 million EUR, the statutory attorney's and patent attorney's fees on appeal would be around €103,000.

### **National Invalidity Action**

In nullity proceedings, there is often a "surcharge" on the value in dispute in comparison with parallel infringement litigation (depending on the specific case).

As an example: For a value in dispute of 7 million EUR, the Court fees for a nullity action would be around €133,000.

The "loser pays" system is on the basis of a statutory fee remuneration and also applies to nullity cases.

*Note: The information in this document relates to litigation through the national jurisdiction and not the UPC.*

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