

The case law of the German Courts of Instance (Instanzgerichte) for patent law and utility patent law since the year 2011

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This article was published in a slightly adapted version, tailored to the needs of the German market, in the leading German legal magazine for intellectual property law, *GRUR-RR*, in October 2013. The report deals with the case law of the German Courts of Instance, meaning the twelve German District Courts (Landgerichte) specializing in patent infringement cases at first instance as well as the regional German Courts of Appeal (Oberlandesgerichte), which specialize in the decisions of appeals. A selection of decisions up to July 2013 will be discussed, partially with reference to other decisions of the German Federal Court of Justice (Bundesgerichtshof) as appellate court (Revisionsgericht) and the German Federal Patent Court (Bundespatentgericht), which has the exclusive jurisdiction of first instance for decisions in patent validity proceedings.

The article is divided into one part that deals with the substantive law (I), another part with important procedural issues (II) and one with the question of costs and cost recovery (III). A basic understanding of German and European patent law is an advantage when reading this article. Where necessary and reasonable, explanations for a better understanding have been included, unlike in the German original.

The report is focused on the review of decisions of the Düsseldorf District Court (Landgericht Düsseldorf) and the Düsseldorf Court of Appeal (Oberlandesgericht Düsseldorf). The reason for this is not only that these Courts decided by far the most

patent suits within the reporting period, but also that they are active in the practice of court publications. The fact that some patent courts are not cited or have only a very small number of decisions is due to the small number of proceedings that were decided there, and those that were decided there have caused no significant case law developments, as was confirmed in personal conversations with several Chamber and Senate Chairmen at the appropriate courts.

I. Substantive law

1. The right to sue (Aktivlegitimation)

According to German law, a prerequisite for a patent infringement claim is that either the claimant is entitled to the asserted rights or that the claimant is explicitly entitled for another reason to claim such rights. Here, the "right to sue" means generally the basic substantive right to sue with regards to the asserted rights, without it being necessary to determine whether those rights exist in fact. Therefore, under German law, the right to sue essentially deals with the question of whether the correct claimant appears in court.

Under German law, the transfer of a patent does not need to be entered in the patent register, so that the transfer of rights can take place outside the register. It is therefore irrelevant to the lawsuit whether the defendant disputes the ownership of the asserted patent. Whoever was entered in the register may claim the patent rights even if it has been established that they are



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The case law of the German Courts of Instance (Instanzgerichte) for patent law and utility patent law since the year 2011

no longer entitled to the patent in the matter, for example due to them having sold the patent. The registration's effect of entitlement only exists from the date of registration.

The Düsseldorf Court of Appeal has in several cases expressed a view on the issue of the right to sue. It has said that the patent rights are based strictly on the entry status in the patent register, and it is irrelevant who the true owner of the patent is. Therefore, the registered claimant can also not plead that he had become the owner of the patent prior to the transfer.¹ If the patent register lists a trader's company, meaning the name under which the trader trades in the course of business, the legal unit, which is the company's legal entity, is legitimized.²

According to established case law, the exclusive licensee is entitled to claim patent infringement as well as the registered patent owner. However, according to the Düsseldorf District Court, the claimant has no right to sue if they only hold an exclusive distribution right to a particular patented entity because, due to the limitation to one embodiment, this is not an exclusive license for the proprietary right.³

The right to sue can also be achieved through the retroactive exclusive licensing of the patent if the licensee has in fact already exercised the proprietary rights during the relevant period in agreement with the owner of the proprietary right. However, according to the Düsseldorf Court of Appeal, if this cannot be ascertained, no claims that require an exclusive position can have arisen for the licensee due to the lack of exclusivity.⁴

2. Capacity to be sued (*Passivlegitimation*)

As a counterpart to the right to sue, the capacity to be sued requires the ascertainment of whether the asserted patent rights can be claimed against the defendant. The capacity to be sued is usually linked to the defendant's own act of infringement but may also be established by a separate attribution of facts by virtue of which the defendant is responsible for the actions of a third party. Of course specific requirements must be met for this.

In patent infringement actions, an attempt to involve a German subsidiary in the proceedings is often made in order to allow, for example, the service of the action in Germany to avoid time-consuming and costly translations. However, if the subsidiary itself has not infringed the patent, it would require the assertion of an attribution of facts, based on which the subsidiary could be held responsible for domestic patent infringements.

The Düsseldorf District Court has recently emphasized that this attribution does not arise automatically. For example, an advertisement by a foreign parent company is not necessarily attributable to its German subsidiary.⁵ The Mannheim District Court (Landgericht Mannheim) decided that a foreign subsidiary had the capacity to be sued with regards to a patent infringing offer from the operation of an Internet site, which automatically forwarded the user to a subsidiary's German language sub-page.⁶ According to this decision, the attribution of a patent infringing offer can arise from the specification of the company's contact details in the legal notice of a German-language website.⁷

3. Infringement

A prerequisite for the successful assertion of a patent claim is an infringement. The claimant must assert that the defendant has infringed the patent-in-suit or that—for particular claims such as the right of presentation and inspection—an infringement is at least probable. Depending on the type of infringement, there can be direct infringement on one hand and indirect infringement on the other hand. Direct infringement usually requires the existence of all features of asserted patent claim while indirect infringement refers to situations in which an indirect infringement can be facilitated through the provision of means that relate to the essential features of an invention.

The indirect infringement is to be distinguished from the equivalent infringement, which may occur if not all features of the asserted patent claim exist, but the aspects of the patent-in-suit are made use of by equivalent means.

1 *OLG Düsseldorf*, judgment of 13. 1. 2011 – I-2 U 56/09 = InstGE 12, 261 – Fernsehmenü-Steuerung; judgment of 24. 6. 2011 – I-2 U 26/10, BeckRS 2011, 20938.

2 *OLG Düsseldorf*, judgment of 27. 1. 2011 – I-2 U 18/09, BeckRS 2011, 08380 = InstGE 13, 15 – Faktor VIII-Konzentrat; confer *LG Düsseldorf*, judgment of 6. 11. 2012 – 4b O 93/11, BeckRS 2013, 14806.

3 *LG Düsseldorf*, Urt. 30. 8. 2012 – 4b O 99/12, BeckRS 2013, 14816; judgment of 30. 8. 2012 – 4b O 54/11, BeckRS 2013, 14817.

4 *OLG Düsseldorf*, judgment of 28. 4. 2011 – I-2 U 146/09, BeckRS 2011, 20931; judgment of 28. 4. 2011 – I-2 U 147/09, BeckRS 2011, 20932; judgment of 28. 4. 2011, I-2 U 147/09 – BeckRS 2011, 20933.

5 *LG Düsseldorf*, judgment of 10. 1. 2012 – 4b O 161/11, BeckRS 2013, 14880.

6 *LG Mannheim*, judgment of 19. 3. 2013 – 2 O 119/12, BeckRS 2013, 14990.

7 *LG Mannheim*, judgment of 19. 3. 2013 – 2 O 119/12, BeckRS 2013, 14990.

The case law of the German Courts of Instance (Instanzgerichte) for patent law and utility patent law since the year 2011

a. Direct infringement

In the opinion of the Düsseldorf District Court, a direct infringement requires proof of the attacked entity for the application of the aspects of the patent. It is not sufficient, if a general ingredient needs to be added and if the application of the protected aspect is dependent on the way that ingredient is added.⁸ However, in the opinion of the Court, and the Düsseldorf Court of Appeal, a direct infringement occurs if the ingredient that is missing for the application of the protected invention is provided to the purchaser in such a way that all features of the claim occur based on a division of labor.⁹ If the acting person relies on the purchaser being in possession of the missing ingredient or on the purchaser's ability to obtain it without difficulty in order to render the delivered item useable in accordance with its intended use, they deliberately make their purchaser's preliminary or subsequent work their own. This justifies the attribution of such preliminary or subsequent work to the acting person.¹⁰ This applies even more so if the purchaser performs a final act of creation while being used as a tool by the supplier who, for example, gives them directions.¹¹ A direct infringement is also to be assumed if a supplied device cannot be used in a reasonable way other than by simply connecting it to a computer and installing the software supplied for the proper operation of the system, whereby the invention is implemented.¹²

If a feature of the patent claim does not immediately occur in the finished product but is formed later, for example, in the case where an active pharmaceutical ingredient required for the claim only develops after several years of storage of a drug, a direct infringement exists.¹³ It has not been decided whether this also applies if items are included in the protection by the patent, which are part of the relevant technological standard. It is also unclear whether a change regarding the claim of the patent-in-suit has to be completed during the term of the patent.

b. Indirect infringement

Cases of indirect infringement were also repeatedly the subject of legal disputes. The Düsseldorf District Court has clarified again that it is sufficient if the material refers to an essential feature of the invention by functionally interacting with a feature of the

invention that is mentioned in the patent claim and thus realizing the inventive concept.¹⁴ It is assumed that the third party has no knowledge of the materials' suitability and intended use, and that this is not obvious due to the circumstances, if the manual advises against such use and when such use would result in increased wear and tear.¹⁵

A functional interaction does not occur if the supplied material contributes nothing to the solution under the patent, for example, if features have been included in the patent claim that deal with another function of the device that is not affected by the invention. However, this cannot be the case if, according to the claimed technical aspects, the material is to be matched with the features of the claim in a particular way.¹⁶ The Mannheim District Court assumed a functional interaction in the case of mobile telephones with pre-settings which were necessary for the use of the patent-protected service whereby the telephones automatically completed essential steps of the protected process.¹⁷

c. Equivalent infringement

aa. Principle

According to the German Federal Court of Justice's recent case law, the ascertainment of an equivalent infringement poses particular difficulties. The Düsseldorf District Court held that the specification of a particular material in the patent claim indicates that the use of exactly that material is needed for the realization of the technical aspects.¹⁸ In another lawsuit, the question arose whether the assessment of the equivalence can still be based on the patent description. The claimant argued that if an unclaimed substance was found, equivalence must be excluded in accordance with the "Occlusion Device" decision. However, if a substance is not mentioned in the description, equivalence fails if it is based solely on the description. In this situation, the reliance on an equivalent infringement is factually never successful. The Court rejected this because it would be quite possible to get to an infringement from equivalence, even with a focus on the specification, without ignoring the "Occlusion Device" decision.¹⁹ Despite the restrictions placed on the

⁸ *LG Düsseldorf*, judgment of 11. 12. 2012 – 4b O 100/11, BeckRS 2013, 14799.

⁹ *OLG Düsseldorf*, judgment of 5. 5. 2011 – I-2 U 9/10, BeckRS 2011, 20946; *LG Düsseldorf*, judgment of 15. 11. 2012 – 4b O 110/11, BeckRS 2013, 14805.

¹⁰ *OLG Düsseldorf*, judgment of 5. 5. 2011 – I-2 U 9/10, BeckRS 2011, 20946; *LG Düsseldorf*, judgment of 15. 11. 2012 – 4b O 110/11, BeckRS, 2013, 14799.

¹¹ *OLG Düsseldorf*, judgment of 24. 2. 2011 – I-2 U 102/09, BeckRS 2011, 08368.

¹² *OLG Düsseldorf*, judgment of 24. 2. 2011 – I-2 U 121/09, BeckRS 2011, 08374; judgment of 24. 2. 2011 – I-2 U 122/09, BeckRS 2011, 08375.

¹³ *OLG Düsseldorf*, judgment of 10. 11. 2011 – I-2 U 40/11, BeckRS 2011, 26946.

¹⁴ *LG Düsseldorf*, judgment of 6. 10. 2011 – 4a O 124/10, BeckRS 2013, 13269.

¹⁵ *LG Düsseldorf*, judgment of 20. 11. 2012 – 4b O 100/11, BeckRS 2013, 14799.

¹⁶ *LG Düsseldorf*, judgment of 30. 10. 2012 – 4a O 39/11, BeckRS 2013, 14808.

¹⁷ *LG Mannheim*, judgment of 13. 4. 2012 – 7 O 169/11.

¹⁸ *LG Düsseldorf*, judgment of 23. 4. 2013 – 4a O 191/12, BeckRS 2013, 08311; judgment of 23. 4. 2013 – 4a O 193/12, BeckRS 2013, 08313.

The case law of the German Courts of Instance (Instanzgerichte) for patent law and utility patent law since the year 2011

doctrine of equivalents by the German Federal Court of Justice's most recent decisions, an equivalence is possible, for example in cases of kinematic reversal, even if this approach was not successful in a case at the Düsseldorf Court of Appeal.²⁰

bb. Lack of substitute material and diversion

According to the Düsseldorf Court of Appeal, equivalence cannot be assumed if no substitute material is used and no suggestion to simply ignore the feature can be found in the patent specification.²¹ According to the Düsseldorf District Court, this also applies if an expert recognizes the feature as superfluous for the realization of the aspects of the patent.²² An equivalent infringement is also to be excluded if the patent-in-suit has made a conscious choice for a material that is not used in the attached embodiment.²³

cc. Lack of benefit and lack of effect

According to the Düsseldorf Court of Appeal, an equivalent infringement also does not occur if the attacked embodiment lacks the benefit of the patent-in-suit.²⁴ However, the Munich I District Court (Landgericht München I) is doubtful that a feature of the claim that serves no function and therefore has no effect, cannot per se be substituted equivalently, since due to the absence of an effect of the substituted part, an equivalent effect did not occur. The same applies to the assumption that a feature's function that does not contribute to the solution of the patent's underlying problem is an insufficient basis for an equivalent infringement.²⁵

d. Supplementary protection certificate

Supplementary protection certificates are issued on specific request to extend the patent protection by up to five years, as appropriate, for products that are subject to the drug approval process.

Regarding the scope of protection of a supplementary protection certificate, the Düsseldorf District Court referred the question to the European Court of Justice (ECJ) whether Articles 4 and 5 of the regulation (EC) No. 469/2009 must be interpreted to the effect that the protection of a supplementary protection certificate, which was issued for a single active pharmaceutical ingredient, extends to an embodiment that contains a composition of active pharmaceutical ingredients including this single active pharmaceutical ingredient.²⁶ The ECJ has answered the question in the affirmative²⁷ and thus follows the same line as the Düsseldorf District Court in a previous decision in interim injunction proceedings.²⁸ Furthermore, the Court clarified that the ECJ's decision on the question of the scope of the protection certificate cannot be used in reverse. In particular, due to the difference of active pharmaceutical ingredients and compositions thereof, the approval of a composition of active pharmaceutical ingredients does not relate to a product that does not contain all the active pharmaceutical ingredients combined.²⁹

According to the Düsseldorf District Court, it is sufficient for the issuance of a supplementary protection certificate if an active pharmaceutical ingredient is mentioned in the basic patent in such a way that active pharmaceutical ingredients or compositions thereof are only named in a generalized way as long as this enables an expert to recognize a particular active pharmaceutical ingredient upon reading the patent claim. There is no restriction to the effect that only one of multiple claimed products per basic patent can be made subject to a supplementary protection certificate.³⁰

4. The infringing acts

A patent infringement requires an infringing act. This could include the production, offering and sale of products covered by the patent-in-suit because they use its technical aspects. The claimant must substantiate these acts in the court proceedings and, if the defendant reasonably denies them, also prove them.

19 LG Düsseldorf, judgment of 23. 4. 2013 – 4a O 190/12, BeckRS 2013, 08236; judgment of 23. 4. 2013 – 4a O 192/12, BeckRS 2013, 08312.

20 OLG Düsseldorf, judgment of 8. 11. 2012 – I-2 U 36/11, BeckRS 2013, 11902.

21 OLG Düsseldorf, judgment of 5. 5. 2011 – I-2 U 9/10, BeckRS 2011, 20946.

22 LG Düsseldorf, judgment of 16. 10. 2012 – 4b O 119/07, BeckRS 2013, 14810; judgment of 10. 3. 2011 – 4a O 430/06, BeckRS 2013, 13314.

23 LG Düsseldorf, judgment of 23. 2. 2012 – 4b O 284/10, BeckRS 2012, 10294.

24 OLG Düsseldorf, judgment of 12. 5. 2011 – I-2 U 138/08, BeckRS 2012, 10492.

25 LG München I, judgment of 20. 3. 2013 – 21 O 13347/11 BeckRS

26 LG Düsseldorf, order of 8. 11. 2011 – 4b O 66/11, article 2012, 79 = BeckRS 2013, 13266 – Valsartan II.

27 EuGH, EuZW 2012, 431 – Novartis-AG/Actavis Deutschland-GmbH & Co. KG et al., with comments *Seitz; Kau*, GRUR-Prax 2012, 193; also confer the parallel decision of the European Court of Justice EuGH, GRUR Int 2012, 523 – Novartis-AG/Actavis UK Ltd. with affirmative comments by *Brückner* et al.

28 LG Düsseldorf, GRUR-RR 2012, 58 – Valsartan I.

29 LG Düsseldorf, judgment of 15. 11. 2012 – 4b O 123/12, BeckRS 2013, 02222; judgment of 15. 11. 2012 – 4b O 139/12, BeckRS 2013, 02395.

30 LG Düsseldorf, GRUR-RR 2012, 420 – Irbesartan; confer the parallel decision of the High Court of Justice (*Chancery Division*), GRUR Int 2013, 37, with which both questions were referred to the European Court of Justice for a preliminary ruling; the proceedings are held at the European Court of Justice under C-443/12.

The case law of the German Courts of Instance (Instanzgerichte) for patent law and utility patent law since the year 2011

a. Offering

According to the Düsseldorf District Court, the claimant does not sufficiently meet their obligation to substantiate an infringing act if they allege that the offering of products occurred when the defendant handed out a prospectus that identifies the attacked entity at a trade fair when it is not impossible that the distribution of the prospectus was merely for technical information purposes, etc.³¹ Preparatory measures for production, such as, for example, feasibility studies or training of Chinese engineers, are also not an offering of the product because such actions do not provide a product for such acquisition. This applies in any case if the product is to be produced by the contractual party in China and the aforementioned actions solely serve the purpose of providing the necessary theoretical knowledge.³²

According to the Düsseldorf District Court, with regards to a patented method, an offering occurs only if the offeror itself applies the procedure or does so via a third party. The offer to supply a device for the application of the method is not necessary.³³

b. Production

The Mannheim District Court has rejected domestic production in a case where the act was limited to the addition of secondary ingredients while the essential features of the invention had already been realized abroad. With regards to this, the manufacturing of the product according to the patent is crucial rather than the final product, which is to be placed on the market.³⁴ Furthermore, according to the Düsseldorf District Court, mere instructions do not amount to domestic production or participation in it, if the real process of creation in fact entirely takes place abroad.³⁵

5. Claims

In the case of patent infringement, the claimant may assert various claims side by side. The most important claim in practice is the claim for injunctive relief, which in principle exists regardless of equity. The court has no discretion in deciding on an injunction. If there is a danger of a first-time or repeated infringement of the asserted patent, the court has to grant the injunction. If an infringement already took place, the infringer can only dispel the suspected risk of recurrence if they issue a cease-and-desist order and submit to a sufficient contractual penalty in case of noncompliance.

31 *LG Düsseldorf*, judgment of 10. 11. 2011 – 4a O 149/10, BeckRS 2013, 13265; more rigorous in the case of sending a prospectus with a reference to a protected object within Germany *LG Düsseldorf*, judgment of 10. 1. 2012 – 4b O 161/11, BeckRS 2013, 14880.

32 *LG Düsseldorf*, judgment of 1. 3. 2012 – 4b O 141/10, BeckRS 2013, 14872.

33 *LG Düsseldorf*, judgment of 26. 7. 2012 – 4a O 11/11, BeckRS 2013, 14821.

34 *LG Mannheim*, judgment of 24. 1. 2012 – 2 O 252/11.

35 *LG Düsseldorf*, judgment of 1. 3. 2012 – 4b O 141/10, BeckRS 2013, 14872.

a. Cease and desist

aa. Risk of recurrent infringement

The risk of recurrent infringement does not necessarily refer to all acts of infringement. This is recognized in relation to production and other acts of patent utilization. According to the Düsseldorf District Court, this also applies to the use of a product as furniture and its possession in order to utilize it in this way, the purpose of which is not typically a subsequent sale. A risk of recurrent infringement in such cases can only be assumed for the use of a product and its possession for use.³⁶ Additionally, a risk of first infringement regarding other utilizations is usually unfounded.³⁷

bb. Risk of first infringement

The risk of first infringement can usually be dispelled by an *actus contrarius* to the act constituting the risk of first infringement, for example, by an undertaking to refrain from the utilization of a protected invention contrary to a previous announcement. With regards to a supplementary protection certificate, the Düsseldorf District Court rightly pointed out that the *actus contrarius* must relate to all possible proprietary rights even if, at the time of the undertaking, the patent that is the subject of an injunction (*Verfügungspatent*) is still in force, but the protection certificate is not yet in force. In the case that was subject of the Court's decision, the defendant had only declared to abstain from using the aspects of the patent up to the expiry of the patent and, thus, did not cover the subsequent protection certificate.³⁸

According to the Düsseldorf Court of Appeal, a risk of first infringement cannot be derived merely from the fact that the alleged infringer has received a permit under pharmaceutical law before the expiry of the protection by patent. This applies in any case if the permit does not expire due to lack of use during the remaining term of the patent.³⁹ However, according to the Düsseldorf District Court, a risk of first infringement can also be derived from an offering that has already taken place for further acts of infringement such as the placing on the market, utilization, import or possession for these purposes.⁴⁰

36 *LG Düsseldorf*, judgment of 9. 2. 2012 – 4b O 279/10, BeckRS 2013, 14874.

37 *LG Düsseldorf*, judgment of 9. 2. 2012 – 4b O 279/10, BeckRS 2013, 14874.

38 *LG Düsseldorf*, GRUR-RR 2012, 58 (59) – Valsartan I.

39 *OLG Düsseldorf*, GRUR-RR 2013, 241 (242) – HIV-Medikament.

40 *LG Düsseldorf*, judgment of 10. 1. 2012 – 4b O 161/11, BeckRS 2013, 14880.

The case law of the German Courts of Instance (Instanzgerichte) for patent law and utility patent law since the year 2011

cc. Warning

Unlike in the case of direct infringement, the grant of an injunction is usually not considered in case of an indirect infringement, even if a non-infringing utilization of the attacked object is possible. In such cases, the courts merely order the indirect infringer to issue a warning. The indirect infringer must then warn their buyers in an adequate way that the patent infringing use of the supplied material is not permitted.

In a case of indirect infringement, in which only the order to issue a warning came into consideration, the Düsseldorf District Court had ordered the infringer to agree to a cease-and-desist order with their buyers and submit to a sufficient contractual penalty in case of noncompliance in addition to the warning. In view of the low value of the supplied material, a contractual penalty of at least €50 per violation was determined.⁴¹ The Mannheim District Court came to a similar decision in a case where proof of a direct infringement would have been particularly difficult due to the installation of the attacked entities underground.⁴² In such exceptional cases, the supplier must effectively influence their buyers through appropriate contractual arrangements in order for them to refrain from a direct infringement of the patent.

b. Information

If, in the course of the proceedings, it comes to light that a patent infringement has already occurred, the claimant may demand detailed information about further acts of infringement. This information allows the claimant, on one hand, to identify third parties involved in the patent infringement and to proceed against them. On the other hand, on the basis of the information, the claimant can calculate their claims for damages that they would later claim against the infringer.

However, the information the infringer is obliged to provide can also be "zero" information if the data for the information is not available to the infringer and if they cannot readily obtain it. The Düsseldorf Court of Appeal has confirmed this and clarified that the infringer has no obligation to investigate third parties' circumstances.⁴³ According to the Düsseldorf District Court, the infringer is only obliged to provide information regarding its own deliveries to Germany. It is not an extended obligation to provide information, if it is merely known that the foreign buyer generally delivers to Germany.⁴⁴

According to a decision of the Munich I District Court, the right to information with regard to composite systems and devices covers the overall device. This applies especially when the overall device is claimed in the patent claim and the components of the overall device are not listed separately.⁴⁵ The Düsseldorf Court of Appeal decided that the claim is not substantiated through statements at the hearing, which merely serve the defense against the claims.⁴⁶

The obligations to provide information can be enforced with the means of coercion, which are coercive penalty and (substituted) coercive detention. According to the Düsseldorf Court of Appeal, if the claimant applies for an order for substituted coercive detention, they must state in their application which of several managing directors shall be the subject of the substituted coercive detention.⁴⁷

c. Compensation

Another important claim is the claim for damages. During infringement proceedings, this claim is usually initially made only on its merits. If the court finds that an infringement occurred and if the parties subsequently cannot agree on the amount of damages, the claim will be pursued in a new lawsuit for the amount of damages.

The claimant can base the calculation of the amount of compensation on one of three methods. They can claim compensation for specific damages incurred (for example, for loss of business), amount of profits made by the infringer from the patent infringement or a notional license fee.

aa. Infringer's profit

The determination of the infringer's profit requires the determination of the portion of the profit that is attributable to the patent infringement rather than to other factors. The Frankfurt am Main Court of Appeal (Oberlandesgericht Frankfurt a. M.) has found that the influence of the infringement on the infringer's profit must be based on the nature of the relevant proprietary right.⁴⁸ According to the Düsseldorf Court of Appeal, there is no indication that the infringer's profit is entirely based on the utilization of patents that are not the infringer's own. In this respect, the claimant is required to state the facts and bears the burden of proof.⁴⁹

41 *LG Düsseldorf*, judgment of 28. 1. 2011 – 4b O 318/03, BeckRS 2011, 02428.

42 *LG Mannheim*, judgment of 16. 3. 2012 – 7 O 78/10, BeckRS 2013, 14994.

43 *OLG Düsseldorf*, GRUR-RR 2012, 406 (408) – Nullauskunft.

44 *LG Düsseldorf*, judgment of 3. 11. 2011 – 4b O 67/10, BeckRS 2011, 26025.

45 *LG München I*, judgment of 22. 3. 2012 – 7 O 11396/11, BeckRS 2013, 11816.

46 *OLG Düsseldorf*, judgment of 22. 11. 2012 – I-2 U 103/11 BeckRS, 2013, 11859.

47 *OLG Düsseldorf*, order of 3. 5. 2011 – I-2 W 10/11, BeckRS 2012, 04013.

48 *OLG Frankfurt a. M.*, GRUR-RR 2011, 201 – Getränketräger; confirmed by BGH, GRUR 2012, 1226 – Flaschenträger.

49 *OLG Düsseldorf*, InstGE 13, 199 = BeckRS 2012, 09342 – Schräg-Raffstore.

The case law of the German Courts of Instance (Instanzgerichte) for patent law and utility patent law since the year 2011

A general principle that the portion of the profit based on the patent infringement must be more than 5% of the profit does not exist.⁵⁰ It does not have to be considered in the calculation of that portion whether the embodiment of a patent can be bypassed easily unless the product resulting from the bypass already reaches the market during the infringement period.⁵¹

The Düsseldorf District Court takes the same line. It can be concluded from the infringer's use of the technical aspects of the patent-in-suit that this in any case partially influences the object of infringement, since otherwise the infringer would not have had to use this type of entity. A hypothetical chain of causation cannot be considered; the defendant had argued that they could have chosen a non-infringing entity with the same profit.⁵² Cheap prices can only be considered as cause for a high profit for the infringer if it can be determined that these are the result of the infringer's own efforts rather than a reduction of research and development costs.⁵³

bb. Damages due to indirect infringement

The Düsseldorf District Court has held that the infringement court must be convinced that the indirect patent infringements resulted in direct infringements by the buyers. In a lawsuit regarding the amount of damages, the claimant cannot plead that they had no knowledge of their buyers' alleged direct infringements. Also, in the lawsuit on the merits of the claim, the Court does not find whether the buyers of the indirect infringer make direct use of the technical aspects of the patent-in-suit.⁵⁴ Thus, if the claimant claims only an indirect infringement, they must additionally substantiate and prove, for the success of claims for damages, that the indirect infringer's supply of materials actually resulted in direct patent infringements. Furthermore, the claimant must substantiate and prove exactly to what extent this happened.

cc. Fault

Unlike the claim for injunctive relief, the claim for damages requires that the infringement occurred through the infringer's fault. However, so far, the courts have only in very rare, exceptional cases assumed that there has been no such fault. Generally, a defense can hardly successfully be based on the declaration that there is no fault.

According to the Düsseldorf District Court, if a company, which appears only as a dealer in the course of business, infringes the patent-in-suit, the infringement may have occurred through no fault of the company if the goods come from well-known manufacturers who operate worldwide and whose name and reputation are familiar to anyone in the market. However, this shall not apply if the manufacturer is Chinese and has only recently entered the European market, and if the dealer has been previously advised of the possible infringement.⁵⁵

In the context of a utility model infringement, the accusation that the user is at fault is unfounded if the user had obtained expert advice and showed his doubts about the validity by initiating cancellation proceedings. However, according to the Düsseldorf Court of Appeal, the user's fault is to be assumed if the user had to expect the possibility of a protection by patent. The user should not only focus on the registered main claim but must also expect the recurring possibility that a utility patent will be partially maintained by combining its registered main claim with sub-claims.⁵⁶ In this context, it has to be pointed out that a limited version of a patent or utility model can be enforced retroactively to take effect prior to the limitation. This can constitute a significant business risk.

d. Destruction

A further important claim is the entitlement to destruction of the infringing objects in the infringer's possession or ownership. The courts generally grant an order for destruction only in the case of direct (and/or equivalent) patent infringement.

The Düsseldorf District Court has pointed out that the infringement court has to clarify whether the infringer has possession or ownership of the infringing products. Thus, the infringement court cannot limit its ruling to a contingent order to destroy the infringing objects if they are (still) in the infringer's possession or ownership. Thus, if the infringer can demonstrate in a substantial way that despite their prior possession and/or ownership they are now neither in possession nor have ownership of the infringing objects, the claimant's application for a destruction order must be dismissed. This requires the substantiation of concrete facts which prove that the possession or ownership of the infringing object was given up completely and through which events this happened.⁵⁷

50 *OLG Düsseldorf*, judgment of 4. 10. 2012 – I-2 U 76/11, BeckRS 2013, 11915, with detailed explanations of the calculation of the infringer's profits.

51 *OLG Düsseldorf*, InstGE 13, 199 = BeckRS 2012, 09342 – Schräg-Raffstore.

52 *LG Düsseldorf*, judgment of 20. 12. 2011 – 4b O 220/10 BeckRS 2013, 13256.

53 *LG Düsseldorf*, judgment of 20. 12. 2011 – 4b O 220/10 BeckRS 2013, 13256.

54 *LG Düsseldorf*, judgment of 1. 3. 2011 – 4b O 260/09, BeckRS 2011, 20669.

55 *LG Düsseldorf*, NJOZ 2012, 1320 = GRUR-RR 2012, 323 L – Transglutaminase.

56 *OLG Düsseldorf*, GRUR-RR 2012, 62 – Türlagerwinkel.

57 *LG Düsseldorf*, InstGE 13, 1 = BeckRS 2011, 20394 – Escitalopram.

The case law of the German Courts of Instance (Instanzgerichte) for patent law and utility patent law since the year 2011

However, the case law is not entirely uniform on this subject. The Düsseldorf District Court had very high requirements for the infringer's submission, even if the attacked entities are high-priced devices and no evidence exists that they are or were kept in stock in large quantities.⁵⁸ However, in another decision, it was found that the entitlement to destruction does not exist if the only known delivery of the attacked embodiment has indisputably passed into the possession of the recipient and, in addition, no circumstances have been substantiated that the defendant in Germany is still in possession of the attacked entity.⁵⁹

According to the Düsseldorf District Court, possession and/or ownership of the products must exist in Germany, whereby it has to be considered that based on *constitutum possessorium* and/or ownership, the domestically based infringer can dispose of the right to possession and thus the objects can return to Germany. Thus, the simple removal of a product abroad does not help the infringer.⁶⁰ According to the Düsseldorf Court of Appeal, if the defendant is based abroad, the entitlement to destruction is only coherently substantiated if the claimant submits that the foreign defendant is in possession of or owns an infringing product specifically in Germany.⁶¹

If the defendant refers to the partial destruction of the infringing entity being sufficient, they have to substantiate whether and how a recreation of the infringing product is possible.⁶² A partial destruction of the infringing product can only be considered sufficient for the protection of the claimant's rights if said recreation cannot be expected.

e. Recall and removal from the distribution channels

A further claim, which is important in practice, is the claim for recall and removal of infringing goods from the distribution channels. This claim generally exists as a result of the infringement. The court has no discretion in the matter.

For the defense of a recall claim, the defendant cannot rely on the fact that, due to the way the purchase contract was drafted, their buyers could not request the rescission of the purchase contract even if the supplied goods infringe a patent. According to the Düsseldorf District Court, the owner of the patent does not have to consider a contractual arrangement between the infringer and

their buyers, and may request a recall in the most effective way. This usually requires the infringer's offer to their buyers to take the goods back and refund the purchase price.⁶³ However, a court's decision on a recall does not provide a legal basis for action against the buyers. Buyers are not bound by the decision received by their supplier.

6. Right of prior use

The defendant may counter the allegation of an unlawful patent infringement by arguing that they have the right of prior use because they had already made and used the invention prior to the filing of the patent-in-suit. However, the defendant must substantiate this clearly and in detail and prove it if the claimant disputes it.

a. Right of prior use

Not just a manufacturer but also a dealer can be entitled to a right of prior use pursuant to section 12 of the German Patent Act (*§ 12 PatG*). However, according to the Düsseldorf District Court, this does not apply to a dealer who arranges for the production of the goods in accordance with the patent. They can only claim a right of prior use if they were in possession of the invention at the priority date.⁶⁴

b. Inadequate translation

In several cases, courts had to deal with seemingly inadequate translations of European patents. The background to this problem is that under the old law, an inadequate translation can give the defendant a right of use if they could rely on the inadequately translated version of the patent. However, it is not an inadequate translation if individual words in the patent claim had been mistranslated. Rather, it depends on the interpretation of the claims. If the interpretation results in the same meaning as in the language of the proceedings, the translation is not incorrect pursuant to the old version of Article II section 3 para 5 of the International Patent Convention Act (*Art. II § 3 V IntPatÜG a. F.*).⁶⁵ It is generally agreed that a right of use can only arise if the errors in the translation are relevant for the scope of protection.⁶⁶ According to the Düsseldorf Court of Appeal, this is usually not the case if the title "Patent claims" is missing in the translation. The absence of translations, such as "General description of the

58 *LG Düsseldorf*, judgment of 26. 7. 2012 – 4a O 11/11, BeckRS 2013, 14821.

59 *LG Düsseldorf*, judgment of 3. 7. 2012 – 4a O 282/10, BeckRS 2013, 01711.

60 *LG Düsseldorf*, InstGE 13, 1 = BeckRS 2011, 20394 – Escitalopram.

61 *OLG Düsseldorf*, InstGE 12, 261 = BeckRS 2011, 07499 – Fernsehmenü-Steuerung.

62 *OLG Düsseldorf*, judgment of 28. 4. 2011 – I-2 U 16/10, BeckRS 2011, 20394.

63 *LG Düsseldorf*, judgment of 13. 9. 2012 – 4b O 80/11, BeckRS 2013, 14811.

64 *LG Düsseldorf*, judgment of 29. 3. 2012 – 4a O 113/10, BeckRS 2013, 15860.

65 *LG Düsseldorf*, judgment of 12. 6. 2012 – 4b O 298/10, BeckRS 2012, 19490.

66 *OLG Düsseldorf*, judgment of 24. 6. 2011 – I-2 U 26/10, BeckRS 2011, 20938; *LG Düsseldorf*, judgment of 29. 3. 2012 – 4a O 236/10, BeckRS 2013, 14868; judgment of 29. 3. 2012 – 4a O 184/10, BeckRS 2012, 08545; *LG Mannheim*, judgment of 24. 1. 2012 – 2 O 63/11, BeckRS 2013, 14995.

The case law of the German Courts of Instance (Instanzgerichte) for patent law and utility patent law since the year 2011

invention" or "Description of preferred embodiments," is critical since whether or not certain comments shall be regarded as a basic description of the inventive idea could be important for the determination of the scope of protection.⁶⁷

c. The majority of proprietary rights holders

According to the Düsseldorf Court of Appeal, pursuant to section 743 para 2 of the German Civil Code (§ 734 II BGB), each joint owner is authorized to use the joint patent. This includes the exercise of the right of use via auxiliary persons such as suppliers, whom the authorized joint owner instructed due to lack of capacity. However, in their right to the use of the invention, such auxiliary persons are strictly bound to the owner who had instructed them, so that, for example, a supplier may only supply goods to the instructing joint owner of the patent, not to any third-party buyer.⁶⁸

d. Insolvency proof licenses

During the reporting period, the question of whether and under what circumstances simple licenses are insolvency-proof has been the subject of intense debate. The Munich I District Court has assumed this in an irrevocable grant of rights of use against payment of a one-off license fee as well as a mutual granting of licenses, in particular in the context of so-called cross-licensing agreements. The same should apply to licenses for proprietary rights, which have not yet existed upon conclusion of the relevant licensing agreement but occurred prior to the commencement of insolvency proceedings over the assets of the licensor.⁶⁹ The Munich Court of Appeal has confirmed this decision in the matter but has also admitted the case for appeal at the German Federal Court of Justice.⁷⁰

7. Compulsory license defense

a. Standard-essential proprietary rights

The debate about the compulsory license defense has also not fallen silent during the reporting period. With its referral decision "LTE Standard," the Düsseldorf District Court has partly deviated

from hitherto established practice and challenged the German Federal Court of Justice's case law regarding the compulsory license defense. Essentially, the Court has asked for an interpretation of Article 102 of the Treaty on the Functioning of the European Union (TFEU) regarding the question of whether it is an abuse of a dominant position in the market if the owner of a standard-essential patent, who declares their willingness to grant a license, seeks injunctive relief against an alleged patent infringer despite the alleged infringer having declared themselves willing to negotiate such a license. The Court enters new terrain in particular with its comments on the requirements for a serious licensing offer. The infringer cannot be faced with the counter argument that they make the offer subject to the attacked embodiments making use of the patent-in-suit. The Court comments similarly on the reservation of legal validity.⁷¹ The Karlsruhe Court of Appeal⁷² and the Mannheim District Court⁷³ had both recently emphasized the inadmissibility of these reservations.

b. Other proprietary rights

An obligation to grant a license pursuant to Article 102 TFEU requires extraordinary circumstances. In particular, the company requesting the license must intend to offer new products or services which the owner of the proprietary right does not offer and for which there is a potential consumer demand.⁷⁴ The Düsseldorf Court of Appeal has pointed out that to be new, the license seeker's product must, from the consumers' perspective, be designed in such a way that no substitutability exists between the license seeker's product and the products according to the patent. Hence, based on the view of the market, the consumers' demand for the license seeker's product cannot be satisfied by the products according to the patent.⁷⁵

c. Declaration of the willingness to grant a license

According to the Düsseldorf District Court, a declaration of the willingness to grant a license is not a pactum de non petendo but only the declaratory establishment of the obligation to conclude a licensing agreement, which already exists pursuant to antitrust

67 *OLG Düsseldorf*, judgment of 26. 4. 2012 – I-2 U 30/09, BeckRS 2013, 11917.

68 *OLG Düsseldorf*, GRUR-RR 2012, 319 (320) – Einstiegshilfe für Kanalöffnungen.

69 *LG München I*, GRUR-RR 2012, 142 with comments by *Haedicke*; confer *Hirte/Knof*, JZ 2011, 889, as well as *Berger*, GRUR 2013, 321; for urgency of the license *LG Mannheim*, judgment of 2. 5. 2012 – 2 O 240/11, BeckRS 2012, 11804.

70 *OLG München*, judgment of 25. 7. 2013 – 6 U 541/12, BeckRS 2013, 13793.

71 *GRUR-RR 2013*, 196 with comments by *Hoppe-Jänisch*; also confer *Verhauwen*, GRUR 2013, 558 (563); as well as *Hoppe-Jänisch*, article 2013, 384; different to numerous previous decisions from the reporting period such as, for example, *LG Düsseldorf*, judgment of 24. 4. 2012 – 4b O 273/10, BeckRS 2012, 09682; judgment of 24. 4. 2012 – 4b O 274/10, BeckRS 2012, 09376; judgment of 11. 12. 2012 – 4a O 54/12, BeckRS 2013, 14798.

72 *OLG Karlsruhe*, GRUR-RR 2012, 124 – GPRS-Zwangslizenz.

73 *LG Mannheim*, judgment of 20. 4. 2012 – 7 O 20/11; judgment of 9. 12. 2011 – 7 O 122/11, BeckRS 2011, 29013.

74 *EuGH*, GRUR 2004, 524 (526) – IMS/Health.

75 *OLG Düsseldorf*, judgment of 20. 1. 2011 – I-2 U 92/10, BeckRS 2011, 03266 L.

The case law of the German Courts of Instance (Instanzgerichte) for patent law and utility patent law since the year 2011

law.⁷⁶ According to the Mannheim District Court, a FRAND-declaration does not bind the purchaser of the German part of the patent because the declaration is made with the intention of concluding a preliminary contract for the benefit of third parties, which is not succession-proof.⁷⁷ With regards to the in personam effects of a declaration of the willingness to grant a license made before the French ETSI, the Düsseldorf District Court has followed the general opinion and assumed that the contractual statute also follows the principle that the law of the country for whose territory protection is sought is applicable, so that German law is applicable when a German proprietary right is affected.⁷⁸

8. Exhaustion

The question of exhaustion arises regularly in the proceedings at German courts. The exhaustion of patent rights is not regulated by law and raises a variety of issues, which to date have not been resolved satisfactorily in detail. The German courts still have a relatively strong tendency to find in favor of the patent owner. Despite occasional approaches in legal literature to the contrary, case law abides very strictly by the principle that exhaustion can only be considered if and insofar as the patent owner in Germany or the EU/EEA has agreed with the placing of a protected product on the market. A view which is more focused on tangible values, as adopted, for example, by the US Supreme Court in the decision *Quanta vs. LGE*, seemingly still has not been established in Germany. However, a certain shift in favor of competition and at the expense of proprietary rights owners may have emerged recently.

The Düsseldorf District Court had to assess in several cases whether the supply of coffee capsules can cause indirect infringement of a claim directed at a capsule extraction system. The Court assumed that the operation of the coffee machines with unlicensed capsules was a use for the intended purpose. Essentially, the Court referred to the fact that the capsules were not the “heart” of the invention and the invention does not affect the functionality or life span of the capsules.⁷⁹ It is up for debate whether this decision

is justified from a perspective of equity. It can be argued that the innovative effort is not sufficiently compensated by the remuneration for the machines as the invention itself makes the economic use of the capsules in large quantities possible. The Düsseldorf Court of Appeal confirmed the District Court's decision.⁸⁰

According to the Düsseldorf Court of Appeal, a user who only receives part of the protected combination (here: bone plate and bone screw) from licensed source (here: the screws) cannot rely on exhaustion. However, reliance on a license for the use of the bone plate and bone screw as a whole in addition to the bone screws as such may be possible. The focus is not on what the parties would have reasonably agreed to, but to what the license agreement parties have actually agreed.⁸¹

According to the Düsseldorf Court of Appeal, the burden of proof regarding the licensing agreement, on which the objection of exhaustion is based, also includes the extent and the terms of the licensing agreement insofar as this is beneficial for the defendant according to both parties' submissions.⁸²

9. Forfeiture and abuse of rights

In very exceptional cases, the claimant's rights may be forfeited or unenforceable due to abuse of rights.

For example, the Düsseldorf Court of Appeal has assumed forfeiture with regard to the rights resulting from a claim concerning a device in a case where the patent owner has brought a procedural claim regarding the patent-in-suit for more than twelve years before they brought the parallel claim regarding the device.⁸³

The Düsseldorf District Court has not considered it an abuse of rights if a claim is brought against a patent-infringing company and separately against its acting Chief Executive Officer even if this leads to an additional burden of costs.⁸⁴

⁷⁶ *LG Düsseldorf*, judgment of 24. 4. 2012 – 4b O 273/10, BeckRS 2012, 09682.

⁷⁷ *LG Mannheim*, judgment of 18. 2. 2011 – 7 O 100/10, BeckRS 2011, 04156; comment *Maaßen*, GRUR-Prax 2011, 149.

⁷⁸ *LG Düsseldorf*, judgment of 24. 4. 2012 – 4b O 273/10, BeckRS 2012, 09682; judgment of 24. 4. 2012 – 4b O 274/10, BeckRS 2012, 09376; judgment of 11. 12. 2012 – 4a O 54/12, BeckRS 2013, 14798; to the contrary with substantial arguments *Straus*, GRUR Int 2011, 469 (475).

⁷⁹ *LG Düsseldorf*, judgment of 16. 8. 2012 – 4b O 81/12, 4b O 82/12, BeckRS 2012, 18252; contrary to the comment by *Elmenhorst*, GRUR-Prax 2012, 459, this represents a renunciation of the decision of the *OLG Düsseldorf*, GRUR-RR 2006, 39 – „Coffee Pad“.

⁸⁰ *OLG Düsseldorf*, judgment of 21. 2. 2013 – I-2 U 73/12, BeckRS 2013, 05152.

⁸¹ *OLG Düsseldorf*, judgment of 22. 12. 2011 – I-2 U 78/11, BeckRS 2012, 07763.

⁸² *OLG Düsseldorf*, judgment of 22. 3. 2012 – I-2 U 112/10, BeckRS 2012, 17819; comment by *Künzel*, GRUR-Prax 2012, 440.

⁸³ *OLG Düsseldorf*, GRUR-RR 2013, 1 – Haubenstretchautomat.

⁸⁴ *LG Düsseldorf*, judgment of 11. 12. 2012 – 4a O 54/12, BeckRS 2013, 14798.

The case law of the German Courts of Instance (Instanzgerichte) for patent law and utility patent law since the year 2011

II. Procedural law

According to German practice, two essential points on procedural law have to be made. One is to emphasize that with the possibility of injunctive relief to be obtained in summary proceedings, the German civil procedure law hands the affected patent owner a sharp sword to speedily enforce their rights. Within a few weeks, the patent owner can obtain an enforceable preliminary injunction if the matter is urgent and the patent owner is entitled to the claim. The courts respond even faster to disputes in connection with trade fairs. On the other hand, the German patent litigation is still ruled by the principle of the separation of infringement and invalidity proceedings (bifurcated system). In infringement proceedings, the alleged infringer cannot successfully bring the argument that the claimed patent was granted wrongly. Although the infringement court can suspend the infringement dispute with regard to parallel pending proceedings regarding the validity of the patent, it very rarely does so. Given the significantly longer duration of validity proceedings compared to the duration of infringement proceedings, in many cases this is a strategic advantage for the patent owners, who often can enforce their rights without regard to their validity.

1. Main proceedings

The infringement proceedings follow very clear rules, which are written down in the German Civil Procedure Code (*Zivilprozessordnung*). Mostly, the procedural law leaves no room for judicial discretionary decisions.

a. Jurisdiction

The approached court will only deal with the matter if it has jurisdiction under the civil procedure rules. This concerns, in particular, the international jurisdiction. According to a decision of the Düsseldorf District Court, this is established at the destination of an Internet offer, and it has to be taken into consideration that an English-language Internet presence is usually also aimed at the German market.⁸⁵ According to the Düsseldorf Court of Appeal, the general rules of international jurisdiction also apply to claims for indirect infringement, if the offer or supply of a product pursuant to section 10 of the German Patent Act (§10 PatG) is claimed to have occurred in Germany.⁸⁶

⁸⁵ *LG Düsseldorf*, judgment of 29. 3. 2012 – 4a O 16/11, BeckRS 2013, 14871; similar *OLG Düsseldorf*, judgment of 13. 10. 2011 – I-2 U 75/10, BeckRS 2011, 26324.

⁸⁶ *OLG Düsseldorf*, judgment of 5. 5. 2011 – I-2 U 9/10, BeckRS 2011, 20946.

The territorial jurisdiction may be decided by the fact that the defendant is a company acting throughout the whole of Germany. This means that acts of infringement in one federal state constitute at least the initial risk of infringement by corresponding acts of infringement in the whole country.⁸⁷ This is usually the case because there are practically no relevant regional markets in Germany. Therefore, the claimant usually has free choice as to which of the 12 German patent infringement courts he wants to deal with the matter.

b. Specification of the heads of claim (Klageantrag)

The claim must be submitted with a specific application that clarifies what exactly the claimant wants. The application must state with sufficient clarity which entities should be the subject of the injunction. In practice, this is not always complied with because the courts usually deem it sufficient that the patent owner simply repeats the wording of the asserted patent claim and applies for the opponent to be banned from, for example, distributing entities that meet these features.

According to the Düsseldorf District Court, even if the patent claim contains alternative features, no commitment to a specific alternative is needed.⁸⁸ However, the Hamburg Court of Appeal (Oberlandesgericht Hamburg) has rightly, but against the prevailing practice, maintained that the mere repetition of the claim wording is not sufficient even if an infringement in the literal sense is claimed. In the decided case, the dispute between the parties was about which, if any, physical design of the attacked entity implements features of the patent claim.⁸⁹

c. Substantiation, denial and standard of evidence

To what extent and in what depth the parties have to plead questions of patent infringement is often disputed between the parties involved. In particular, in cases of standard-essential patents, claimants often rely on short references to standard-specifications together with the assertion that the attacked devices work according to these standards. Thus, in many cases, the argument regarding the infringement does not concern the devices, as such, but merely the industry standards. The Düsseldorf District Court has confirmed the common practice that an actual presumption indicates that an entity, which works according to a specific industry standard, implements all

⁸⁷ *LG Düsseldorf*, judgment of 24. 2. 2011 – 4a O 280/10, BeckRS 2013, 13315; repealed by *OLG Düsseldorf*, GRUR-RR 2011, 350 – Pramipexol.

⁸⁸ *LG Düsseldorf*, judgment of 20. 12. 2012 – 4a O 112/11, BeckRS 2013, 01709; judgment of 29. 3. 2012 – 4a O 236/10, BeckRS 2013, 14868.

⁸⁹ *OLG Hamburg*, judgment of 30. 4. 2013 – 3 U 184/10, BeckRS 2013, 11573.

The case law of the German Courts of Instance (Instanzgerichte) for patent law and utility patent law since the year 2011

mandatory requirements of the standards. It cannot be countered that the compliance with the standards is not checked due to the lack of suitable compatibility tests in practice.⁹⁰ The courts have made virtually impossible requirements for the submission that the attacked entity does not fully comply with the standard.⁹¹ Even the detailed submission of a deviation from mandatory standards is considered contradictory if, at the same time, it is undisputed that the attacked entity can be operated under the standard (here: UMTS).⁹²

According to the Düsseldorf Court of Appeal, the claimant can, in his submission, rely significantly on the defendant's statements in advertisements, which may serve as an indicator of the realization of the aspects of the patent. Moreover, the Court has approved the approach of the Düsseldorf District Court that the implementation of a feature results from the fact that via the exclusion principle and by carrying out various investigations, other possibilities can be eliminated. However, it is a prerequisite that the analytical methods used include all solutions, which may reasonably be considered as an explanation.⁹³

According to the Hamburg District Court, it is also permissible to prove an infringement via recognized test methods even if these methods only allow for a judgment on the possibility of an infringement.⁹⁴ In such a case, the defendant cannot simply dispute the infringement without making a substantiated and plausible counter-submission.⁹⁵

d. Criteria for suspension

As previously stated, the issue of the suspension of an ongoing infringement dispute, with regard to parallel pending proceedings regarding the validity of the patent, is of considerable importance due to the separation principle that is in force in Germany. However, the obstacles to a suspension are many.

The Düsseldorf District Court requires the existence of a predominant probability of a revocation or elimination of the patent-in-suit. This can usually not be assumed if the prior art closest to the patent-in-suit had already been considered in the procedure for granting the patent, or if later-discovered prior art merely demonstrates that the patent-in-suit is not based on an inventive step, but if at least reasonable arguments can be found for the affirmation of the inventive step, which depends on the assessment of the relevant instances.⁹⁶ The Munich I District Court uses the same standards whereby it sometimes mentions a clearly predominant probability.⁹⁷ According to the Munich I District Court, the focus is not on the parties' arguments but on the objective situation so that a suspension is not necessary merely because the patent owner had argued differently in validity proceedings.⁹⁸ The Mannheim District Court requires a high probability of the patent-in-suit being destroyed.⁹⁹

A suspension is excluded if the request for suspension is based on an obvious prior use, which must be evidenced by witnesses, since the questioning of witnesses can only take place in invalidity proceedings. According to the Düsseldorf District Court, this is also the case if the witness statements are submitted in writing.¹⁰⁰ According to the Düsseldorf Court of Appeal, the same applies in appeal proceedings.¹⁰¹ According to the Düsseldorf District Court, even if evidence was taken for the obvious prior use with regards to a utility model claim made in the same proceedings and therefore the utility model claim is not regarded as capable of being protected, suspension cannot be granted with regards to the patent since the obvious prior use is not fully documented by conclusive evidence.¹⁰²

A suspension is more likely to be considered if the patent-in-suit has already expired, so that the claimant can no longer enforce a claim for injunctive relief, and if the applicant is already in possession of a judgment of the first instance in his favor, which he can use for enforcement. However, according to the Düsseldorf

90 *LG Düsseldorf*, judgment of 11. 12. 2012 – 4a O 54/12, BeckRS 2013, 14798.

91 *LG Düsseldorf*, judgment of 11. 12. 2012 – 4a O 54/12, BeckRS 2013, 14798.

92 *LG Düsseldorf*, judgment of 24. 4. 2012 – 4b O 274/10, BeckRS 2012, 09376.

93 *OLG Düsseldorf*, judgment of 6. 6. 2013 – 2 U 112/11, BeckRS 2013, 12498;
LG Düsseldorf, judgment of 22. 11. 2001 – 4b O 159/10, BeckRS 2013, 06660.

94 *LG Hamburg*, judgment of 21. 6. 2012 – 327 O 378/11, BeckRS 2012, 13486.

95 *LG Hamburg*, judgment of 21. 6. 2012 – 327 O 378/11, BeckRS 2012, 13486.

96 *LG Düsseldorf*, judgment of 10. 11. 2011 – 4a O 143/10, BeckRS 2012, 21620;
LG Düsseldorf, judgment of 18. 12. 2012 – 4b O 176/11, BeckRS 2013, 14797;
also *LG Hamburg*, judgment of 2. 5. 2013 – 327 O 370/12, BeckRS 2013, 14999.

97 *LG München I*, judgment of 19. 5. 2011 – 7 O 6033/10, BeckRS 2012, 04008;
LG München I, judgment of 20. 2. 2013 – 21 O 9596/12, BeckRS; *LG München I*,
judgment of 16. 2. 2012 – 7 O 11395/11, BeckRS 2013, 11819; according to
LG München I, order of 16. 5. 2013 – 7 O 3815/12, in case of a lapsed proprietary
right a certain probability of invalidity is sufficient.

98 *LG München I*, judgment of 24. 11. 2011 – 7 O 22100/10, BeckRS 2011, 29471.

99 *LG Mannheim*, judgment of 7. 12. 2012 – 7 O 53/12, BeckRS 2013, 14992.

100 *LG Düsseldorf*, judgment of 6. 11. 2012 – 4b O 93/11, BeckRS 2013, 14806.

101 *OLG Düsseldorf*, judgment of 18. 8. 2011 – I-2 U 71/10, BeckRS 2011, 26947.

102 *LG Düsseldorf*, judgment of 29. 3. 2012 – 4a O 113/10, BeckRS 2013, 15860.

The case law of the German Courts of Instance (Instanzgerichte) for patent law and utility patent law since the year 2011

District Court, the defendant can only rely on an existing judgment on the patent-in-suit, which lowers the scale for suspension, if the decision was granted against him. For example, a board member of an infringing company, who is sued separately, cannot rely on a judgment that was granted against the company.¹⁰³

According to the Düsseldorf Court of Appeal, a request for suspension may also be rejected if the defendant has an interest in determining that one of the attacked entities does not use the patent-in-suit since, in this situation, the infringement court does not have the option to grant a partial judgment.¹⁰⁴

Furthermore, a request for suspension may be rejected if invalidity proceedings are initiated late. Usually, invalidity proceedings must be issued at the latest upon submission of the statement of defense in infringement proceedings. According to the Munich I District Court, the late issuance of invalidity proceedings cannot be excused with the argument that the other party had initially merely claimed indirect patent infringement and only later direct infringement. This is because invalidity proceedings are also an effective defense against an indirect patent infringement action.¹⁰⁵

e. Amendment of claim

According to a decision of the Düsseldorf Court of Appeal, the extension of the action to a further proprietary right is admissible at the appeal stage if the newly introduced proprietary right relates to the same invention, mainly the same entities are attacked in the original complaint and section 145 of the German Patent Act (§ 145 PatG) could be cited with strong arguments against a new action of the first instance¹⁰⁶. Whether these arguments would be justified as a result is not crucial¹⁰⁷. However, the introduction of a utility model is not prompted by section 145 of the German Patent Act and is generally not admissible at the appeal stage¹⁰⁸. However, the subjective extension of the action at the appeal stage to an additional Managing Director of the defendant company could be admissible¹⁰⁹. According to the Munich I District Court, it is admissible if, in addition to an indirect infringement, a direct infringement is claimed later with regard to the same patent-in-suit¹¹⁰.

103 LG Düsseldorf, judgment of 11. 12. 2012 – 4a O 54/12, BeckRS 2013, 14798.

104 OLG Düsseldorf, judgment of 26. 4. 2012 – I-2 U 39/09, BeckRS 2013, 02736.

105 LG München I, judgment of 19. 5. 2011 – 7 O 8923, BeckRS 2012, 03038.

106 OLG Düsseldorf, judgment of 13. 1. 2011 – I-2 U 2/10, BeckRS 2011, 08590.

107 OLG Düsseldorf, judgment of 4. 10. 2012 – I-2 U 39/11, BeckRS 2013, 11914.

108 OLG Düsseldorf, judgment of 27. 10. 2011 – I-2 U 84/10, BeckRS 2011, 26948; comment by Stjerna, GRUR-Prax 2012, 262.

109 OLG Düsseldorf, judgment of 22. 3. 2012 – I-2 U 112/10, BeckRS 2012, 17819.

110 LG München I, judgment of 19. 5. 2011 – 7 O 8923/10, BeckRS 2012, 03038.

2. Injunctive relief

In summary proceedings, the applicant has to substantiate two things: on one hand, the existing claim in its merits and, on the other hand, the reason why the matter should be decided in summary proceedings. The question of the grounds for a preliminary injunction and the question of urgency contained therein belong to this second aspect.

a. Grounds for the preliminary injunction

Summary proceedings are not only brought in legally and technically easy cases. The Düsseldorf District Court has rejected the respondent's defense that due to the difficulty of the legal situation, the matter is not suitable to be decided in summary proceedings¹¹¹. It is also relevant to the grounds for a preliminary injunction whether the patent-in-suit is expected to be valid. Unlike the principal proceedings, the infringement court must consider this in deciding the summary proceedings. The courts require that the patent's validity is sufficiently certain. According to the practice of the Düsseldorf courts, this requires, in principle but not always, that the patent has already successfully survived opposing validity proceedings.

In a variety of cases, the courts have dealt with the question of whether the patent's validity is sufficiently certain. The Düsseldorf District Court decided that the requirement of a positive but disputable decision on the validity follows the reverse conclusion that as soon as the decision has been granted, it can be assumed that the proprietary right's validity is sufficiently certain¹¹².

A disputable validity decision is not necessary in certain situations, specifically in exceptional circumstances that make it unreasonable for the applicant to await the outcome of opposition or nullity proceedings. An indicator for this could be that the respondent in the summary proceedings had had enough time to check the validity of the proprietary right prior to entering the market with the attacked entity but has initiated the validity proceedings only just before they started to use the entity.

111 LG Düsseldorf, GRUR-RR 2012, 58 (61) – Valsartan I, according to which this defense must be denied to the respondent because they had caused the risk of first infringement in order to make these legal questions the subject of a judicial review.

112 LG Düsseldorf, judgment of 14. 2. 2013 – 4b O 187/12 BeckRS 2013, 14668.

The case law of the German Courts of Instance (Instanzgerichte) for patent law and utility patent law since the year 2011

If there is a special situation, the grounds for the preliminary injunction can only be denied if the proprietary right's impending elimination is evident¹¹³. The practice is not consistent on this point. In a further decision, the Düsseldorf District Court has found there to be a special situation when at the time of market entry, the respondent was aware that they could soon expect a first instance decision in nullity proceedings initiated approximately two years prior to the market entry¹¹⁴.

According to the Düsseldorf Court of Appeal, it is a special situation if the respondent has already participated in the grant procedure so that the grant of the patent objectively equals the decision in an inter partes opposition proceeding¹¹⁵. The same applies if the respondent fails to identify those citations that would preclude the maintenance of the patent and to substantiate them with regard to their content¹¹⁶ or if the attacks on the validity already prove to be unfounded in summary examination¹¹⁷. According to the Düsseldorf District Court, this also applies if pure questions of law are the subject of the doubts on the validity¹¹⁸. According to the Düsseldorf Court of Appeal, it also suffices if the proprietary right was not attacked for years and concrete evidence for its elimination is neither apparent nor was it submitted.¹¹⁹

The other courts of instance have expressed less strict views. The Braunschweig Court of Appeal (Oberlandesgericht Braunschweig) has explicitly rejected the views of the Düsseldorf courts and found that it could not be required that the patent have already successfully survived opposition or nullity proceedings¹²⁰. However, a preliminary injunction could already be precluded if there are indications at the time of the decision which question whether the proprietary right should be protected¹²¹.

The Munich I District court repeatedly pointed out that, according to the Directive 2004/48/EC, injunctive relief must be available throughout Europe including in countries where patents are subject to limited examination. Hence, injunctive relief cannot, in principle, be excluded for a fully examined patent, because it has not yet been the subject of inter partes proceedings¹²².

The Nürnberg-Fürth District Court (Landgericht Nürnberg-Fürth) seems to require significant verification of the patent for the exclusion of a preliminary injunction¹²³.

According to the Düsseldorf District Court, less stringent requirements are required for the grounds of the preliminary injunction if the right of presentation and inspection is claimed. However, mere doubts on the validity are not sufficient¹²⁴.

b. Urgency

The aspect of urgency is treated with rigor. The courts generally require that the owner of an infringed patent act against the infringement without undue delay. If they hesitate, they can only pursue their rights successfully in the main proceedings. In these cases, this is called self-refutation. The patent owner usually cannot delay longer than approximately six weeks before they apply for injunctive relief. The time period is calculated from the date on which an application with a chance for success could be filed against the alleged infringer. It is also important in terms of urgency that the applicant pursue the proceedings without delay following the filing of the application. Hence, it may conflict with the urgency if the applicant applies for considerable deadline extensions for the submission of written statements.

113 *LG Düsseldorf*, judgment of 15. 11. 2012 – 4b O 123/12, BeckRS 2013, 02222; judgment of 15. 11. 2012 – 4b O 139/12, BeckRS 2013, 02395; judgment of 19. 10. 2012 – 4b O 135/12, BeckRS 2012, 22626.

114 *LG Düsseldorf*, judgment of 4. 9. 2012 – 4a O 50/12, BeckRS 2012, 19488; similar judgment of 4. 9. 2012 – 4a O 64/12, BeckRS 2012, 19489.

115 *OLG Düsseldorf*, judgment of 20. 1. 2011 – I-2 U 55/10, BeckRS 2011, 08596.

116 *OLG Düsseldorf*, judgment of 22. 12. 2011 – I-2 U 78/11, BeckRS 2012, 07763.

117 *OLG Düsseldorf*, judgment of 24. 11. 2011 – I-2 U 55/11, BeckRS 2012, 07762.

118 *LG Düsseldorf*, GRUR-RR 2012, 420 (421) – Irbesartan.

119 *OLG Düsseldorf*, judgment of 20. 1. 2011 – I-2 U 55/10, BeckRS 2011, 08596; *LG Düsseldorf*, judgment of 24. 2. 2011 – 4a O 277/10, BeckRS 2011, 25648.

120 *OLG Braunschweig*, GRUR-RR 2012, 97 – Scharniere auf Hannovermesse; similar the previous instance *LG Braunschweig*, judgment of 1. 6. 2011 – 9 O 842/11, BeckRS 2012, 03161.

121 *OLG Braunschweig*, GRUR-RR 2012, 97 – Scharniere auf Hannovermesse; stricter was the previous instance *LG Braunschweig*, judgment of 1. 6. 2011 – 9 O 842/11, BeckRS 2012, 03161, according to which serious indications must be present.

122 *LG München I*, judgment of 22. 3. 2012 – 21 O 4437/12, BeckRS 2013, 11817; judgment of 1. 2. 2012 – 21 O 26022/11, BeckRS 2012, 03697.

123 *LG Nürnberg-Fürth*, judgment of 7. 11. 2012 – 3 O 6652/12, BeckRS 2012, 22948.

124 *LG Düsseldorf*, judgment of 1. 2. 2011 – 4b O 270/10, BeckRS 2013, 13320.

The case law of the German Courts of Instance (Instanzgerichte) for patent law and utility patent law since the year 2011

However, it is not always easy to determine when the time period begins in individual cases. The Düsseldorf District Court has confirmed its previous decision in which a positive drug licensing decision does not simultaneously mean that an entry to the market is imminent¹²⁵. An application still meets the requirement of urgency if the applicant submits the application no earlier than one month after they received an expert's report which was prepared in an independent procedure for the taking of evidence¹²⁶ or if they do not make representations on the patent's validity in the application, although they already knew of existing nullity proceedings¹²⁷.

The resubmission of an application to another court does not per se conflict with the urgency requirement or abuse the law if the application was withdrawn in the first instance prior to the rejection of the first application, if the resubmission is made after the first application's withdrawal and if the previous application and its withdrawal are revealed to the new court¹²⁸.

According to a decision of the Düsseldorf District Court, a late application cannot be justified with the argument that the respondent has significantly increased its sales activities. The important point is that patent law claims could have been asserted previously¹²⁹. The same applies with regards to the placing of new entities on the market if an application for an injunction for other entities could have been made previously¹³⁰. The Hamburg District court has assumed that the exhibition of a model of a yet unavailable device at a domestic trade fair would represent a risk of recurrence only for comparable offers. The placing of a previously unavailable device on the market creates an infringement of a new quality, which starts a new urgency time period¹³¹.

According to the Düsseldorf Court of Appeal, it must generally be considered that the applicant of a preliminary injunction does not have to prepare the proceedings and obtain the preliminary evidence with undue haste as long as it cannot be concluded objectively that the applicant is not interested in a speedy enforcement of their rights. In this case, the applicant does not have to enter procedural risks and may get the status of the infringement expertly assessed in advance¹³².

c. Substantiation

The circumstances that are to justify the granting of a decision in summary proceedings must be substantiated. This means that the court must conclude that there is an overwhelming probability that the applicant is entitled to the asserted rights, that the patent is valid and that the matter is urgent after having looked at all procedurally admissible evidence and affidavits, which are generally not admissible in the main proceedings.

According to the Düsseldorf Court of Appeal, a submission with regard to the alleged infringement that does not specify which of the respondent's employees has made an offer to another person, the identity of that person and where the offer was made can be disputed effectively with unspecified counter-submissions¹³³. Anonymously conducted surveys are of no value as evidence of the alleged infringement¹³⁴. According to the Frankfurt am Main Court of Appeal, an order for inspection can be precluded if the court cannot assess the probability of a patent infringement due to lack of expert knowledge¹³⁵.

125 *LG Düsseldorf*, judgment of 14. 2. 2013 – 4b O 187/12, BeckRS 2013, 14668; judgment of 15. 11. 2012 – 4b O 123/12, BeckRS 2013, 02222; judgment of 15. 11. 2012 – 4b O 139/12, BeckRS 2013, 02395.

126 *LG Düsseldorf*, judgment of 20. 11. 2012 – 4b O 141/12, BeckRS 2013, 06156; comment by *Cepl*, GRUR-Prax 2013, 203.

127 *LG Düsseldorf*, judgment of 15. 11. 2012 – 4b O 123/12, BeckRS 2013, 02222; judgment of 15. 11. 2012 – 4b O 139/12, BeckRS 2013, 02395.

128 *LG Düsseldorf*, judgment of 4. 9. 2012 – 4a O 50/12, BeckRS 2012, 19488.

129 *LG Düsseldorf*, judgment of 4. 9. 2012 – 4a O 83/12, BeckRS 2013, 14812.

130 *LG Düsseldorf*, judgment of 30. 8. 2012 – 4b O 99/12, BeckRS 2013, 14816.

131 *LG Hamburg*, judgment of 6. 6. 2013 – 327 O 156/13, BeckRS 2013, 11165.

132 *OLG Düsseldorf*, GRUR-RR 2013, 236 – Flupirtin-Maleat; comment by *Stjerna*, PharmR 2013, 237 (244).

133 *OLG Düsseldorf*, GRUR-RR 2011, 350 (351) – Pramipexol; with a different view the previous instance *LG Düsseldorf*, judgment of 24. 2. 2011 – 4a O 280/10, BeckRS 2013, 13315.

134 *OLG Düsseldorf*, GRUR-RR 2011, 350 (352) – Pramipexol.

135 *OLG Frankfurt a. M.*, GRUR-RR 2012, 322 L = BeckRS 2012, 10149 – Besichtigungsverfahren.

The case law of the German Courts of Instance (Instanzgerichte) for patent law and utility patent law since the year 2011

3. Enforcement and stay of execution

The alleged infringer can proceed with an appeal against a first instance decision of the main proceedings. At the same time, they can try to ward off the detriments of an impending enforcement. However, this is already possible in the first instance via an application for a stay of execution which has to meet very high standards. A stay of execution pursuant to section 712 of the German Civil Procedure Code (§ 712 ZPO) requires a situation threatening the existence of the alleged infringer. According to the Düsseldorf District Court, the debtor must also substantiate to what extent they have exhausted the option to agree to reasonable terms with the patent owner at least for the duration of the proceedings¹³⁶. If the defendant can prove that detriments, which cannot be otherwise avoided, are imminent, the court can allow them to ward off the enforcement by posting a security.

In connection with the appeal, there is the option to make an application for an interim stay of execution. However, according to the Karlsruhe Court of Appeal, this can be precluded if the defendant has changed the attacked devices to the extent that they no longer make use of the patent-in-suit's technical aspects¹³⁷. Similarly, the fact that the claimant currently does not exercise their proprietary right does not work in the defendant's favor¹³⁸.

III. Costs

The costs of patent litigation means, in particular, the respective legal fees and court costs. In addition, this includes extrajudicial costs such as, for example, the costs for the determination of the facts of the infringement including the costs for experts, translations and travel expenses. With regard to the costs, the German procedural law is led by the principle that the losing party pays the succeeding party's incurred costs to the extent that they are necessary for their legal defense or the assertion of their legal

rights. An exception to this is when the losing party did not give rise to the initiation of legal proceedings and acknowledges the asserted claims immediately. An infringer gives rise to the initiation of legal proceedings if they do not respond adequately to an extrajudicial warning by providing a cease-and-desist order. Conversely, it is no cause for the initiation of legal proceedings if the patent owner refrains from issuing a warning unless the issuance of a warning would have been unacceptable to the patent owner.

With regard to the extent to which costs have to be reimbursed, it is to be noted that legal fees are determined on the basis of a statutory fee schedule depending on the value of the claim. In most cases, this fee is significantly below the actual costs incurred on the basis of hourly fee agreements. Thus, even the successful party can have a significant risk of costs.

1. Warning letter

According to the Düsseldorf District Court, an effective warning requires the indication of the concerned proprietary right. Furthermore, the warning should not be misleading. This can be assumed if the cease-and-desist order that was drafted in advance deviates from the attacked entity even if the undertaking is referred to as an example¹³⁹. The same applies if a judgment is cited that confirms the legal opinion of the person giving the warning without revealing that the judgment has been appealed and, as the Düsseldorf Court of Appeal pointed out, if adverse judgments are concealed¹⁴⁰ or, so the Düsseldorf District Court found, if the fact that a claimed utility model is an unexamined proprietary right is not mentioned¹⁴¹.

¹³⁶LG Düsseldorf, judgment of 6. 11. 2012 – 4b O 93/11, BeckRS 2013, 14806.

¹³⁷OLG Karlsruhe, order of 18. 4. 2011 – 6 U 29/11, BeckRS 2011, 12651.

¹³⁸LG Düsseldorf, judgment of 10. 11. 2011 – 4a O 143/10, BeckRS 2012, 21620.

¹³⁹LG Düsseldorf, judgment of 21. 8. 2012 – 4a O 9/12, BeckRS 2013, 15501.

¹⁴⁰OLG Düsseldorf, judgment of 15. 9. 2011 – I-2 W 58/10 BeckRS 2011, 27019.

¹⁴¹LG Düsseldorf, judgment of 12. 4. 2012 – 4a O 17/12, BeckRS 2013, 15673.

The case law of the German Courts of Instance (Instanzgerichte) for patent law and utility patent law since the year 2011

2. Immediate acknowledgement

The Düsseldorf District Court has seen the cause for the bringing of an action pursuant to section 93 of the German Civil Procedure Code (§ 93 ZPO) in the defendant's procedural conduct. Although the focus should be on the conduct prior to the proceedings, this could be indicated by later conduct¹⁴².

It is hard to see a clear direction. According to another decision by the Düsseldorf District Court, it is not permissible to retrospectively find a cause for the bringing of an action from a person's conduct during proceedings, since the cause for the bringing of an action cannot "evolve" in retrospect. According to the Düsseldorf Court of Appeal, a pre-trial warning is only unnecessary if it is certain that the defendant will not comply voluntarily¹⁴³. This is contradicted by a decision by the Düsseldorf District Court according to which it is sufficient if the applicant could have reasonably assumed that they would not get justice without legal action¹⁴⁴. Finally, a case should be mentioned in which the Düsseldorf District Court requested that the failure of a warning was almost certain, which could be concluded from the fact that the infringer had not issued a cease-and-desist order prior to two competition proceedings against the same applicant¹⁴⁵. The Düsseldorf Court of Appeal changed the decision and required the costs to be paid by the applicant¹⁴⁶.

According to the Düsseldorf District Court, even in trade fair matters a particular urgency, which allows the owner of the proprietary right to refrain from issuing a warning, is generally not given¹⁴⁷.

142 LG Düsseldorf, judgment of 15. 12. 2011 – 4a O 91/08, BeckRS 2013, 13262.

143 OLG Düsseldorf, order of 19. 5. 2011 – I-2W 13/11, BeckRS 2012, 05111; LG Düsseldorf, judgment of 26. 1. 2012 – 4b O 28/11, BeckRS 2013, 14877.

144 LG Düsseldorf, judgment of 27. 1. 2011 – 4b O 224/10, BeckRS 2013, 13321.

145 LG Düsseldorf, judgment of 11. 3. 2011 – 4b O 147/10, BeckRS 2013, 13312.

146 OLG Düsseldorf, order of 19. 5. 2011 – I-2W 13/11, BeckRS 2012, 05111.

147 LG Düsseldorf, Judgment of 27. 1. 2011 – 4b O 224/10, BeckRS 2013, 13321.