

ECJ referral on preliminary injunctions in patent disputes

By decision of 19.01.2021, the 21st Civil Chamber of the Regional Court Munich I, which is responsible for patent law, has referred a question on the treatment of preliminary injunctions in patent litigation to the European Court of Justice in Luxembourg in a so-called preliminary ruling procedure (21 O 16782/20).

The board referred the following question to the European Court of Justice:

Is it compatible with Article 9(1) of Directive 2004/48/EC for Higher Regional Courts having jurisdiction at last instance in proceedings for interim relief to refuse in principle to grant interim measures for infringement of patents where the patent in suit has not survived opposition or revocation proceedings at first instance?

Directive 2004/48/EC concerns the enforcement of intellectual property rights.

Background:

*Granting a preliminary injunction in a patent infringement case generally requires, in addition to the claim for an injunction (infringement of the patent in suit) and the reason for the injunction (urgency), the substantiation of a sufficiently secured validity of the patent in suit. According to the current case law of the higher courts, it is generally not sufficient for granting a preliminary injunction in the case of a patent infringement that the asserted patent was granted by the granting authority - in this case the European Patent Office - after detailed examination. **Several Higher Regional Courts rather require that - with few exceptions - a confirmation of patentability be provided in addition to the technical examination of patentability in the granting procedure by the patent office. This is because a secure validity can only be assumed if the patent has already proven to be legally valid in opposition/appeal proceedings before the European Patent Office (EPO) or the Federal Patent Court in nullity proceedings.** According to this view, for the assumption of a secured validity of a patent, the patent that has been examined and granted should, in principle, have been examined for its patentability a further time, in validity proceedings, before the grant of a preliminary injunction due to its infringement.*

However, in the view of the referring 21st Civil Chamber of the Regional Court Munich I, such an interpretation is contrary to European law.

"According to Art. 9(1) of the Enforcement Directive, it should be ensured that a provisional measure can be ordered against a patent infringer in order to prohibit the continuation of a patent infringement. However, according to the case law reviewed in this referral, this is not possible, because a patent that has only just been granted - as in the case at hand - may not yet have gone through validity proceedings (opposition or nullity proceedings are only possible after the patent has been granted). Many patents that were granted a long time ago have often not yet gone through such proceedings at the time of the application for a provisional measure; the patent proprietor naturally has no influence on whether his patent is attacked with an opposition or a nullity action after grant. Consequently, in spite of an urgent infringement case, a provisional measure can only be issued after the conclusion of proceedings on the validity of the patent in the first instance, which can take many months or even years. According to the case law under review, the continuation of the patent infringement must be accepted during this time, although in the case of a patent - unlike other intellectual property rights - a thorough technical examination already takes place before it can be granted".

The referring court is therefore currently forced, contrary to its understanding of the provision in Article 9(1) of Directive 2004/48/EC, to refuse in principle to order provisional measures in the case of patent infringement if the infringed patent has not yet been subject to adversarial proceedings and the exceptions to this principle set out in the case-law do not apply either.

This is what the 21st Civil Division of the Regional Court Munich I put up for review in its referral.