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Germany
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1. What are the most effective ways for a European patent holder whose rights cover your jurisdiction to enforce its rights in your jurisdiction?

The silver bullet of patent enforcement in Germany is an infringement action on the merits to be filed with one of the German “Ivy League” patent infringement courts. The choice of venue must be made in view of the complexity of the case and time constraints. The “big four” patent infringement courts – Dusseldorf, Mannheim, Hamburg and Munich (with Dusseldorf taking a clear lead) – handle about 1,000 patent litigation actions each year.

2. What level of expertise can a patent owner expect from the courts in your jurisdiction?

Due to the extraordinarily high number of patent infringement actions, the competent German courts handle patent infringement cases almost exclusively. Hence, the standard of expertise in all technological areas, as well as in the IP law field, is high at all levels of jurisdiction handling patent infringement actions.

3. How do your country’s courts deal with validity and infringement? Are they handled together or separately?

Validity and infringement are handled separately in two court processes, both finalised by the X Senate of the *Bundesgerichtshof*. The infringement process is considerably quicker than the validity process. Only if the patent asserted is likely to become invalid due to lack of novelty in view of new facts will the infringement court stay proceedings until validity has been confirmed.

4. To what extent is cross-examination of witnesses permitted during proceedings?

In practice, only court-appointed expert witnesses are cross-examined during proceedings.

5. What role can and do expert witnesses play in proceedings?

Expert witnesses appointed by the parties themselves will be heard via written expert opinions. The *Landgericht*, the first instance court, rarely appoints expert witnesses. At second instance before the *Oberlandesgericht*, expert witnesses are appointed more frequently. However, only in validity proceedings before the *Bundesgerichtshof* is it common for the court to appoint expert witnesses.

6. Is pre-trial discovery permitted? If so, to what extent?

Pre-trial discovery, as used in UK and US proceedings, does not exist in Germany. If there is a substantial likelihood of patent infringement but material evidence is not available, the patent owner may request inspection of the potential infringer’s premises and/or infringing devices (eg, exhibition at a trade fair).

7. Do the courts in your jurisdiction apply a doctrine of equivalents?

In principle, yes. In the course of the EU-wide harmonisation of jurisdiction, the requirements that must be met in order to find equivalent patent infringement have been considerably raised; thus, it is rare that infringement is based on the doctrine of equivalents.

8. Are certain patent rights (eg, those relating to business methods, software and biotechnology) more difficult to

enforce than others?

As the infringement courts will accept a patent granted by the European Patent Office (EPO) as it stands, the validity of the patent becomes an issue only in case of obvious invalidity based on new facts. The technological field as such could hardly be a reason to reconsider validity of the patent granted.

9. How far are the courts bound by previous decisions in cases that have covered similar issues?

Due to the high number of cases, patent-related case law is prolific in Germany. Some of this precedent can be used to provide the background for each individual case. But to answer the question, previous decisions have no binding effect in Germany.

10. Are there any restrictions on who parties can select to represent them in a dispute?

In patent infringement cases, parties must be represented by attorneys at law who are members of the German Chamber of Lawyers. For validity proceedings, parties can be represented by either a patent attorney admitted at the German Chamber of Patent Lawyers or an attorney at law. In practice, parties are typically represented by a team of attorneys at law and patent attorneys in both patent infringement and validity proceedings.

11. Are the courts willing to consider the reasoning of courts in other jurisdictions that have dealt with similar cases?

Yes, the German courts are willing to consider the reasoning of courts in other jurisdictions, but within the framework of German law.

12. How easy is it for defendants to delay proceedings and how can plaintiffs prevent them from doing so?

Infringement proceedings can be delayed for only very limited reasons. Of practical relevance is the delay of proceedings due to an obvious lack of validity in view of new facts. Depending on the venue, the complexity of the case may extend the schedule of infringement proceedings.

13. Is it possible to obtain preliminary injunctions? If so, under what circumstances?

Yes, it is possible to obtain preliminary injunctions and these are immediately enforceable. A preliminary injunction will be issued if the patent owner applies for one

within four weeks of becoming aware of the infringement. Furthermore, the infringement and the validity of the patent must be apparent. Validity can be assumed to be apparent if the patent has already been the subject of post-grant validity proceedings.

14. How much should a litigant plan to pay to take a case through to a decision at first instance?

As a guideline, a patent owner can expect litigation to cost about 3% of the value of litigation (ie, the estimated economic value of the lawsuit for the plaintiff, assuming that the claims asserted will be fully confirmed by the court). The minimum is around €50,000, based on the statutory minimum fees set out by the Attorneys Remuneration Law. Depending on the circumstances, attorneys may ask for additional fees. These costs include the considerable statutory court fees.

15. Is it possible for the successful party in a case to obtain costs from the losing party?

Yes, the statutory attorneys' fees – for both attorneys at law and patent attorneys – and the court fees are fully reimbursable.

16. What are the typical remedies granted to a successful plaintiff by the courts?

The remedies granted in Germany to a successful plaintiff are injunctions and claims to render accounts. The court will also decide whether the plaintiff is entitled to claim damages.

17. How are damages awards calculated? Is it possible to obtain punitive damages?

The courts have developed three methods of calculating damages:

- The cost of a licence granted between reasonable parties.
- The loss of profits suffered by the patent owner.
- The profits gained by the infringer.

In practice, the calculation based on royalty fees is the most common method used to calculate damages awards. Although it is not possible to obtain punitive damages, the courts have confirmed elements in the damages calculations with moderately punitive effects.

18. How common is it for courts to grant permanent injunctions to successful plaintiffs and under what circumstances will they do this?

If the court confirms infringement and the

patent is in force and not obviously invalid based on new facts, the court will always grant a permanent injunction.

19. How long does it take to obtain a decision at first instance and is it possible to expedite this process?

In case of infringement actions on the merits, the Ivy League courts will render a decision within six to 12 months, depending mainly on the venue. A decision on a request for a preliminary injunction will be issued within one to six weeks. Expedition of this process is possible, mainly based on the choice of venue.

20. Under what circumstances will the losing party in a first instance case be granted the right to appeal? How long does an appeal typically take?

The losing party in a first instance case will always be granted the right to appeal. Even on appeal, the successful party may enforce the first instance decision on condition of a security bond to cover potential damages due to enforcing a decision that may yet be revised. An infringement appeal typically takes 18 months to two years.

21. Are parties obliged to undertake any type of mediation/arbitration prior to bringing a case before the courts? Is ADR a realistic alternative to litigation?

In practice, the parties are not obliged to undertake any type of mediation or arbitration before bringing a case before the courts. In light of the number of cases, ADR

is not seen as a realistic alternative to litigation.

22. In broad terms, how pro-patentee are the courts in your jurisdiction?

Statistically, patentees win about 40% of the patent litigation actions filed in Germany. Another 40% of complaints filed are dismissed, while the remaining 20% are stayed due to validity issues.

23. Has your jurisdiction signed up to the London Agreement on Translations? If not, how likely is it to do so?

Yes, Germany has signed up to the London Agreement on Translations.

24. Are there any other issues relating to the enforcement system in your country that you would like to raise?

The competent German patent litigation courts have a clear understanding that a patentee is entitled to enjoy protection for patents granted by either the EPO or the German Patent and Trademark Office. Accordingly, the courts not only are reasonably pro-patentee, but also apply strict measures to enforce injunction claims once granted. The Patent Act qualifies patent infringement as a criminal act. Although criminal actions based on patent infringement are rare, patent infringers are not treated with kid gloves in Germany. Finally, the German customs authorities are very cooperative in identifying patent-infringing goods and in seizing such goods. *iam*



Gottfried Schüll is a prominent and highly renowned patent litigator. He has handled various high-profile cases for global clients, both as lead counsel and as part of an international legal counsel team. The Dusseldorf Appeals Court has appointed him as an independent court expert. Based on his degree in physics from RWTH Aachen University, Mr Schüll handles cases related to various sophisticated technologies.

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