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# *Patents in Europe*

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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 is an infringement action on the merits to be filed with one of the German ‘Ivy League’ courts for patent infringement. The choice of venue must be made in view of 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 every year.

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

Due to the extraordinarily high frequency of patent infringement actions, the chambers and senates of the competent German courts handle practically only patent infringement cases. Hence, the level of expertise in all technological areas, as well as the field of IP-related law, is outstanding across 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 Federal Court of Justice. The German infringement court process is still considerably faster than the validity court process whenever the measures taken to accelerate the validity proceedings seem to gain traction. Only if the patent asserted is likely to be invalidated due to

lack of novelty in view of new facts will the infringement courts stay the 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 Regional Court, as the first level of jurisdiction, rarely appoints expert witnesses itself. At second instance before the Higher Regional Court, expert witnesses are appointed frequently. Encouraging the parties to present expert witness reports by themselves seems to be part of the measures taken to accelerate the proceedings by the Federal Court of Justice. This deviates from past practice of appointing court experts on a regular basis.

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

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

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

In principle, yes. In the course of EU-wide harmonisation of jurisdiction, the

prerequisites for finding equivalent patent infringement have been tightened considerably, and accordingly it is rare that infringement is found 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 German infringement courts will accept a patent granted by the European Patent Office (EPO) as it stands, the validity of the patent will become an issue only in case of obvious invalidity based on new facts. The technological field as such could hardly be a reason to reconsider the validity of the patent granted.

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

Due to the high number of cases, rich precedent in the field of patent law is available in Germany. Some of this precedent builds the background for each individual case. In addition, previous decisions issued in other jurisdictions now have 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, in view of the legal and technical tasks to be dealt with, parties are 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, German courts are willing to consider the reasoning of courts in other jurisdictions – but, of course, 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?**

The reasons for delaying infringement proceedings are very limited. Of practical relevance is only 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 add some time to the schedule of the infringement proceedings. The Dusseldorf Regional Court has just established a third patent litigation chamber and the Dusseldorf Higher Regional Court is to open a further patent litigation senate soon. This should further accelerate proceedings.

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

Yes, it is possible to obtain preliminary injunctions, which are immediately enforceable. In practice, the patent owner must file a request for an injunction within four weeks of becoming aware of the patent infringement. Furthermore, both infringement and validity must be apparent. Validity can be assumed to be apparent if, for example, 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?**

About 3% of the value of the litigation (ie, the value that the patent owner ascribes to its claims) is generally a good guideline, with the minimum amount being around €50,000. These numbers are based on the statutory minimum fees under the Attorneys' Remuneration Law. Depending on the circumstances, attorneys may ask for additional fees. The costs mentioned also include the relatively high 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 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 the injunction claim and the claim to render accounts. At the same time, the court will 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 ways to calculate damages:

- by analogy to a licence granted between reasonable parties;
- loss of profits by the patent owner; and
- profits of the patent infringer.

In practice, a calculation based on royalty fees is the most common way to calculate damage awards. It is not possible to obtain punitive damages, at least not comparable to triple damages. The courts have confirmed elements in the damage calculation with moderate 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 German court confirms infringement and the patent is not obviously invalid based on new facts – and, of course, the patent is in force – 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 German Ivy League courts will render a decision as quickly as within six to 12 months, depending mainly on the venue. A decision based on a request for a preliminary injunction will be issued within a few days to six weeks. Expedition of this process is mainly possible 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 if it issues a security bond to cover potential damages due to

enforcement of a decision that may be revised on appeal. The 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 alternative dispute resolution a realistic alternative to litigation?**

In practice, the parties are not obliged to undertake any type of mediation or arbitration prior to bringing a case before the courts. In view of the number of cases, alternative dispute resolution is not seen as a popular alternative to litigation.

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

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

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

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 German patent litigation courts have the clear understanding that a patentee is entitled to 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 German 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, it should be noted that German customs authorities are very cooperative in identifying patent-infringing goods and in seizing these goods. *iam*

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