EIP

Preserving the strict deadline of urgency in patent preliminary injunction proceedings

A discussion of:

- Regional Court Düsseldorf, Judgement of December 15, 2022 – 4a O 91/22, „Solarzelle II" (German language source: link)
- Regional Court Munich I, Order of July 20, 2022 – 7 O 6982/22, „Bortezomib II"

(German language source: link)

The urgency deadline (which is a deadline set by case law and not by statutory law) remains a crucial aspect that patent holders must keep in mind when seeking a preliminary injunction before German courts. The forementioned German courts had to deal particularly with the question whether it is possible that the deadline for determining the urgency recommences in certain situations.

- The Regional Court of Düsseldorf granted a preliminary injunction in a case where the applicant waited with the application until receiving a positive decision on the validity of the patent. The court found that the patent proprietor could wait for the patent to be confirmed in the validity proceeding without risking the urgency for a preliminary injunction. This also applies after the CJEU's decision in Phoenix Contact/Harting. This is because the finding of the CJEU that a preliminary injunction may also be granted before a decision in a validity proceeding is issued does not oblige the patent holder to apply for a preliminary injunction before the issuance of a validity decision. The decision confirming the validity still represents a factor that significantly increases the likelihood of a successful application for an

injunction.

- The Munich I Regional Court denied a preliminary injunction due to the applicant failing to comply with the strict one-month urgency deadline. A validity proceeding was not pending. The court expressed doubts as to the conformity of such a rigid time limit with European law, but it was to be adhered to for reasons of legal certainty. Since the CJEU's decision in Phoenix Contact/Harting changed the prevailing jurisdiction of the Higher Regional Court of Munich, the Munich I Regional Court considered a "restart" of the urgency deadline two weeks after possible knowledge of the CJEU´s decision. Also, in respect of said decision and in contrast to the decision of the Regional Court Düsseldorf, the Munich I Regional Court reaffirmed its prevailing jurisdiction of validity presumption of the granted patent.

The decisions share the common principle that once an applicant has sufficient knowledge of the possible infringement and gathered all necessary prima facie evidence to file an application with a reasonable chance of success, it has a month to file a preliminary injunction application.

The regional courts have in common that the urgency period begins without considering the existence of a (positive) decision in validity proceedings. The assessment of legal validity does not affect the begin of the urgency deadline. A positive validity decision is not mandatory for obtaining a preliminary injunction. Hence, there are cases where an application for an injunction is successful even without a (positive) decision on validity. In these cases, the patent holder cannot wait indefinitely, and the application would no longer be considered urgent. However, the urgency deadline may restart if a decision confirming the validity of the patent is handed down or if new judgements affect the prevailing jurisdiction and therefore the prospects of success of a preliminary injunction. This is appropriate, as patent holders would otherwise be forced to file preliminary injunctions prematurely and would not be able to file a new application after an unsuccessful attempt.

As the Regional Court of Düsseldorf does not presume the validity of a granted patent by default, it generally sets a new urgency deadline in motion when the patent proprietor waited for the decision in the validity proceedings. According to this case law, an application for a preliminary injunction can be (re)filed if a decision confirming the validity is issued. If the applicant decides to file an application for a preliminary injunction prior to the issuance of a validity decision, he must overcome the strict requirements for a positive prognosis decision. In other words, the applicant must convince the court that the patent is likely to be upheld in (hypothetical) validity proceedings.

It does not follow from the decision of the Munich I Regional Court that a renewed application for a preliminary injunction after a positive validity decision would have to be rejected for lack of urgency. This decision would significantly increase the threshold for the potential infringer to plead against the validity presumption. Hence one can assume that such a decision also sets off a new urgency deadline according to the case law of the Munich I Regional Court.

In terms of the expressed doubts by the Munich I Regional Court regarding the compliance of this "rigid" deadline regime with European law, it remains to be seen whether there will be a change of case law in the future. For the time being, it can be expected that judges of German local chambers of the UPC will apply the recent approach of the national courts when deciding on preliminary injunction