

Case C-44/21

Request for a preliminary ruling

Date lodged:

28 January 2021

Referring court:

Landgericht München I (Germany)

Date of the decision to refer:

19 January 2021

Applicant:

Phoenix Contact GmbH & Co. KG

Defendants:

HARTING Deutschland GmbH & Co. KG

Harting Electric GmbH & Co. KG

Landgericht München I (Regional Court, Munich I, Germany)

[...]

[...]

In the case of

Phoenix Contact GmbH & Co. KG, [...]Blomberg

- applicant -

[...]

v

1) **HARTING Deutschland GmbH & Co. KG, [...]** Minden

- defendant -

2) **Harting Electric GmbH & Co. KG, [...]** Espelkamp

- defendant -

[...] [Or. 2]

concerning an interlocutory injunction,

the Regional Court, Munich I – 21st Civil Chamber – [...] made, on 19 January 2021, the following

Order

The following question on the interpretation of Article 9(1) of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights ('Directive 2004/48/EC') is referred to the Court of Justice of the European Union for a preliminary ruling under Article 267 TFEU:

Is it compatible with Article 9(1) of Directive 2004/48/EC if German higher regional courts (*Oberlandesgerichte*), which have jurisdiction at last instance in proceedings for interim relief, refuse, in principle, to grant interim measures for patent infringement if the patent in dispute has not survived opposition or invalidity proceedings at first instance?

Grounds:

The applicant applied to the referring court for an interlocutory injunction prohibiting the defendants from offering or putting on the market plug connectors which make use of the teaching of European Patent EP 2 823 536 granted to the applicant.

1. Legal framework

a. EU law

The recitals of Directive 2004/48/EC read, in extract, as follows:

- (1) The achievement of the internal market entails ... creating an environment conducive to innovation and investment. In this context, the protection of intellectual property is an essential element for the success of the internal market. The protection of intellectual property is important not only for promoting innovation and creativity, but also for developing employment and improving competitiveness. [Or. 3]
- (2) The protection of intellectual property should allow the inventor or creator to derive a legitimate profit from his/her invention or creation. It should also allow the widest possible dissemination of works, ideas and new know-how. ...

- (3) However, without effective means of enforcing intellectual property rights, innovation and creativity are discouraged and investment diminished. It is therefore necessary to ensure that the substantive law on intellectual property, which is nowadays largely part of the *acquis communautaire*, is applied effectively in the Community. In this respect, the means of enforcing intellectual property rights are of paramount importance for the success of the internal market.

[...]

- (22) It is also essential to provide for provisional measures for the immediate termination of infringements, without awaiting a decision on the substance of the case, while observing the rights of the defence, ensuring the proportionality of the provisional measures as appropriate to the characteristics of the case in question and providing the guarantees needed to cover the costs and the injury caused to the defendant by an unjustified request. Such measures are particularly justified where any delay would cause irreparable harm to the holder of an intellectual property right.

[...]

- (24) Depending on the particular case, and if justified by the circumstances, the measures, procedures and remedies to be provided for should include prohibitory measures aimed at preventing further infringements of intellectual property rights. ...

Directive 2004/48/EC provides:

Article 9

Provisional and precautionary measures

1. Member States shall ensure that the judicial authorities may, at the request of the applicant:
 - (a) issue against the alleged infringer an interlocutory injunction intended to prevent any imminent infringement of an intellectual property right, or to forbid, on a provisional basis and subject, where appropriate, to a recurring penalty payment where **[Or. 4]** provided for by national law, the continuation of the alleged infringements of that right, or to make such continuation subject to the lodging of guarantees intended to ensure the compensation of the rightholder; ...

b. National law

Paragraph 58 of the applicable version of the Patentgesetz (Law on patents; ‘the PatG’) reads:

The mention of the grant of the patent shall be published in the Patentblatt (Patent Gazette). The patent specification shall be published at the same time. The legal effects of the patent shall take effect upon publication in the Patent Gazette.

Paragraph 139 of the applicable version of the Law on patents reads:

- (1) The injured party may, where there is a risk of recurrence, bring an action for an injunction against any person who uses a patented invention in breach of Paragraphs 9 to 13. The injured party shall also have that right if an infringement is liable to be committed for the first time.

Paragraph 935 of the applicable version of the Zivilprozessordnung (Code of Civil Procedure; ‘the ZPO’) reads:

Interlocutory injunctions relating to the subject matter of the dispute are permissible if there is a risk that a change in the existing situation could frustrate or substantially obstruct the realisation of a party’s rights.

Paragraph 940 of the applicable version of the Code of Civil Procedure reads:

Interlocutory injunctions are also permissible for the purpose of regulating a temporary state of affairs with regard to a disputed legal relationship, provided that such regulation appears to be necessary, in particular in the case of permanent legal relationships, to avert significant disadvantages or to prevent imminent violence, or for other reasons.

2. Facts of the main proceedings

- a. On 14 December 2020, the applicant applied for an interlocutory injunction to prohibit the defendants from infringing its European Patent EP 2 823 536 (‘the patent which is the subject of the injunction’). [**Or. 5**]

The date of the patent application on which the patent which is the subject of the injunction is based is 5 March 2013. By letter of 8 May 2020, the defendants’ legal representatives asserted objections concerning patentability in the grant procedure on behalf of the second defendant. The patent which is the subject of the injunction was finally granted on 26 November 2020 and the publication of the mention of the grant was scheduled for 23 December 2020. On 15 January 2021, the second defendant filed an opposition with the European Patent Office against that grant of the patent which is the subject of the injunction. In line with the applicant’s submissions, the referring court considers that the patent in force is infringed by the products offered by the defendants. Based on the European Patent Office’s examination, and also taking into account the defendants’ submissions regarding the opposition of 15 January 2021, the referring court does not consider that the validity of the patent is under threat.

- b. The referring chamber considers itself to be prevented from issuing the interlocutory injunction applied for solely by the case-law of the Oberlandesgericht München (Higher Regional Court, Munich), ruling at last instance.¹

According to the case-law of the Higher Regional Court, Munich, it is *not* sufficient for the issuing of an interim measure in the case of a patent infringement that the patent invoked was granted by the granting authority – in this case the European Patent Office – after a detailed examination and that the question of the legal validity of the patent is also subject to judicial examination in the context of the decision on an application for an injunction. Rather, the Higher Regional Court, Munich requires that, in addition to the Patent Office's technical examination of patentability in the grant procedure, a decision confirming the eligibility for protection of the patent invoked must have been given in opposition/appeal proceedings before the European Patent Office (EPO) or invalidity proceedings before the Bundespatentgericht (Federal Patent Court). Thus, according to the Higher Regional Court, Munich, the examination of patentability on the basis of which a patent is granted is not sufficient for the assumption of the secure legal validity of a patent; rather, the patent examined and granted must have been examined for patentability once again by the granting authority or the Federal Patent Court before an interlocutory injunction is issued owing to an infringement thereof. [Or. 6]

The relevant judgment of the Higher Regional Court, Munich of 12 December 2019 (Case No 6 U 4009/19; published in GRUR 2020, 385) reads, verbatim, as follows:

‘The general view is that the issuance of an interlocutory injunction in patent litigation can be considered only if both the question of patent infringement and the validity of the property right which is to be the subject of the injunction can ultimately be answered in favour of the applicant so clearly that an incorrect decision which needs to be revised in main proceedings is not seriously to be expected.

According to the case-law of the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) (see the references in the judgment of 14 December 2017 – 2 U 18/17, juris, paragraph 18, and in Kühnen, *Handbuch der Patentverletzung* (Manual on Patent Infringement), 12th ed., Chapter G, paragraph 42) and the Oberlandesgericht Karlsruhe (Higher Regional Court, Karlsruhe) (GRUR-RR 2009, 442 = InstGE 11, 143; GRUR-RR 2015, 509), **the sufficiently secure legal validity of the patent which is the subject of the injunction can generally be assumed only if it**

¹ Under German law, injunction proceedings end at second instance, at the Higher Regional Court; the Bundesgerichtshof (Federal Court of Justice) is not involved in the issuing of interlocutory injunctions.

has already withstood opposition or invalidity proceedings at first instance, that is to say, a decision confirming its eligibility for protection must have been given in opposition/appeal proceedings before the European Patent Office (EPO) or invalidity proceedings before the Federal Patent Court'

Nowhere in the relevant German legislation is there a requirement for a decision at first instance in proceedings concerning the legal validity of a patent as a prerequisite for an interim measure to prohibit the infringement of that patent. This would also not be compatible with the fact that the legal effects of the patent (and thus also the possibility of asserting rights in court) take effect upon publication of the mention of the grant of the patent (Paragraph 58(1) of the PatG; Article 97(3) of the European Patent Convention ('the EPC') – and not only at a later point in time (decision at first instance in opposition or invalidity proceedings). The referring court takes the view that the German law that has been adopted is therefore fully in conformity with Directive 2004/48/EC. However, the requirement of conformity of national law with EU law is not limited to the provisions of national law, but also includes the obligation for national courts to rule on cases or interpret the provisions of national law in a manner compatible with the objectives of a directive, failing which the case-law must be changed (see [...] [judgment of 17 April 2018, *Egenberger*, C-414/16, EU:C:2018:257]). **[Or. 7]**

The case-law derives the requirement for a decision at first instance in proceedings concerning the legal validity of a patent from Paragraph 940 of the ZPO by way of interpretation; accordingly, urgency ('essential' within the meaning of recital 22 of Directive 2004/48/EC) in respect of the issuance of an interim injunction exists only if the legal validity of the patent which is the subject of the injunction has been confirmed by opposition or invalidity proceedings at first instance. However, the referring court takes the view that such an interpretation is not compatible with Directive 2004/48/EC and is therefore **contrary to EU law**:

Pursuant to Article 9(1) of the Enforcement Directive, the intention is to ensure that an interlocutory injunction can be issued against an infringer to forbid the continuation of a patent infringement. However, this is not possible according to the case-law being questioned by this order for reference, because **a patent that has only just been granted** – such as that in the present case – **cannot possibly have gone through patent validity proceedings** (opposition or invalidity proceedings are possible only *after* a patent has been granted). Many patents granted a long time ago have often not yet gone through such patent validity proceedings at the time of the application for an interim measure either; the patent proprietor naturally has no influence whatsoever on whether his or her patent will be attacked by an opposition or action for invalidity after being granted. Even in the case of an infringement requiring urgent action, an interim measure can then only be issued, in principle, once patent validity proceedings (initiated by a third party) have been concluded at first instance, which can take many months or even

years. According to the case-law being questioned here, the continuation of the patent infringement must be accepted during that period, even though a patent – unlike other intellectual property rights – is subjected, by operation of law, to a thorough technical examination before it can be granted and invoked in legal proceedings.²

In so far as, according to the case-law being questioned here, exceptions are made to the principle requiring adversarial validity proceedings concluded at first instance, the referring court takes the view that this does nothing to change the fact that the case-law being questioned here and, in particular, the aforementioned principle of interpretation [Or. 8] are contrary to EU law; this is because a principle of interpretation contrary to EU law does not become compatible therewith by virtue of the fact that a number of exceptions are granted and thereby a legal practice compatible with EU law may be restored in some cases.

It is true that the case-law (Higher Regional Court, Munich, GRUR 2020, 385) does state that the issuance of an interlocutory injunction without a decision at first instance in patent validity proceedings may be considered if

- [‘]- the defendant has already participated with its own objections in the grant procedure, which was effectively already conducted as an inter-partes procedure, so to speak, that is to say the objections raised were also examined as to their substance,
- the property right which is the subject of the injunction is generally regarded as being eligible for protection,
- the objections to the legal validity of the property right which is the subject of the injunction are found to be unfounded even upon summary examination, or
- on an exceptional basis, it is unreasonable, due to exceptional circumstances, such as the market situation, for example, for the applicant to await the outcome of the opposition or invalidity proceedings.’

However, none of these exceptions see the light of day in the present case, as they are applied so restrictively by the Higher Regional Court, Munich that in practice – as in the present case – they remain merely theoretical. It is true that the second defendant did participate with its own objections in the grant procedure for the patent which is the subject of the injunction; however, according to the case-law of the Higher Regional Court, Munich (see the decision of 26 November 2020, Case No 6 W 1146/20; decision does not appear to have been published yet), it is necessary that the objections raised in the grant procedure are identical

² It should be noted at this point that the referring court also subjects legal validity to a summary examination when deciding on an application for an injunction; if the defendant presents substantial reasons explaining why there are legitimate doubts as to legal validity, an interlocutory injunction will not be granted.

to those asserted in the subsequent injunction proceedings. If in the injunction proceedings a defendant also relies on objections other than those raised in the grant procedure – as is the case here – the legal validity is assessed as not being secure. The other exceptions referred to above are not relevant here either.

Therefore, the referring court presently considers itself to be compelled, contrary to its understanding of the provision made in Article 9(1) of Directive 2004/48/EC, to refuse to issue interim measures in the present case, since the patent which is the subject of the injunction has not yet been through adversarial validity proceedings and the exceptions to that fundamental requirement that are prescribed in the case-law do not apply either. **[Or. 9]**

By the following question, the referring court asks the Court of Justice to interpret Article 9(1)(a) of Directive 2004/48/EC, in particular the passage which reads

‘may, [upon] request ... issue an interlocutory injunction intended to prevent any imminent infringement of an intellectual property right, or to forbid ... the continuation of the alleged infringements of that right’.

This is because the referring court assumes, on the basis of the literal meaning of that provision, that the possibility of an interlocutory injunction is not ensured under national law if it is refused on the ground that opposition or invalidity proceedings at first instance have not yet taken place.

Question:

Is it compatible with Article 9(1) of Directive 2004/48/EC if German higher regional courts (*Oberlandesgerichte*), which have jurisdiction at last instance in proceedings for interim relief, refuse, in principle, to grant interim measures for patent infringement if the patent in dispute has not survived opposition or invalidity proceedings at first instance?