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Injunctions in European Patent Law

The proportionality of patent law injunctions has been under discussion for some time now in Germany, originally with a focus on patent enforcement by non-practicing entities.¹ The discussion has been revived recently, concentrating on standard-essential patents (SEPs) and complex products.² The latter is exemplified by cases where the patent concerned protects a technology, which is only a minor component of a complex system. Scenarios frequently invoked relate to patented chip technology, installed in the control unit of larger machinery, such as connected cars, or in general if the distribution of a complex system has to be stopped because of the patent infringement by a minor part.³ The potential effect of the injunction to stop the use of the system as a whole is seen as excessive by some.⁴ The main argument is that a cease and desist order is only founded with regard to the minor component, but will in practical terms prevent the distribution of the end product. The intensity of the discussion is such that the legislator is currently reviewing the legal situation.⁵

The aim of the present article is to explore the environment for an injunction from a statutory perspective *de lege lata*. To this end it first takes a look at the international instruments, which serve as common foundations – or at least points of reference – for the application of national patent laws in the EU, namely the Agreement on Trade-Related Aspects of Intellectual Property Rights of 1995 (TRIPS)⁶ and – at the European level – the Enforcement Directive⁷ (Part I). On this basis, second, a closer look then is taken on the practice of granting injunctions in selected European jurisdictions with a focus on Germany. The picture, however, would be incomplete without a look at the Agreement on a Unified Patent Court (UPCA), which may serve as an example of unification in the field of patent law. Despite not being

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1 Ohly, GRUR Int. 2008, 787; Osterrieth, GRUR 2009, 540; Country report for Germany, AIPPI Q 219: Haft/Nack/Lunze/Heusch/Schohe/Joachim, GRUR Int. 2011, 927.

2 See only conference “Enforcing Patents Smoothly: From Automatic Injunctions to Proportionate Remedies”, University of Erlangen, 22. March 2019 with a conference report to be found at <http://ipkitten.blogspot.com/2019/04/conference-report-should-we-say-no-to.html> (last accessed 18. Juli 2019).

3 BGH GRUR 2016, 1031 – *Wärmetauscher*, para. 41; Osterrieth, GRUR 2018, 985.

4 See only views expressed in this volume by 352; Hofmann as well as references in Lüthi, GRUR Int. 2019, 352; Hofmann, NJW 2018, 1290.

5 Interested circles were invited to the German Federal Ministry of Justice on 20 May 2019 to discuss the matter of “Injunctions in the context of SEPs and complex products”.

6 BGBl. 1994 II 1730.

7 Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights.

up and working yet it still is the result of a decades-long undertaking to identify a common denominator of national European patent laws (**Part II**).

On this basis it eventually is argued why the patent system as it stands already provides for fair and functional system of remedies taking heed of all interests concerned (**Part III**). Including a general proportionality requirement in the assessment of granting an injunction would put this system out of balance. In any event, should the legislator decide to join the current criticism that a general proportionality assessment is necessary, it must create a genuine statutory basis.

From a technical perspective there are two ways to construe such a proportionality assessment: either as a cap on the procedural remedy of the injunction – presupposing that the preconditions for a substantive cease and desist claim are given; or as a precondition for the substantive right as such. As will be displayed in the following, both approaches are advocated for in the discussion on proportionality⁸ but they must be clearly delineated.

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I. Legal foundations in international law

A frequent argument in the German debate on the proportionality requirement is that it is mandated by international law. To test the validity of this argument it is necessary to study the relevant instruments in some detail, namely TRIPS and the Enforcement Directive. First and foremost, they exemplify that the aim to

⁸ See account of Hofmann in Lüthi, GRUR Int. 2019, 352.

establish a certain convergence in the enforcement of intellectual property rights is internationally recognized.⁹

Thus, if those instruments should explicitly provide for a proportionality assessment as a requirement for granting an injunction, this must be respected by the national legal orders in their implementation of these instruments.

1. The TRIPS-Agreement of 1995

a) Applicability

The primary objective of TRIPS is to strengthen and harmonize the protection of intellectual property on a worldwide scale.¹⁰ Originally, both the Community and its Member States acceded to TRIPS by virtue of shared competence.¹¹ Hence, in the application of TRIPS, it was necessary to determine the dividing line between the obligations under TRIPS assumed by the European Union and those remaining in the responsibility of the Member States.

However, the relevant point in time to assess the distribution of competences is the entry into force of the current TFEU.¹² In its Art. 207, it sets new standards particularly by attributing “commercial aspects of intellectual property” to the exclusive competence of the European Union in matters of the common commercial policy according to Art. 3(1)(e) TFEU.¹³ In *Daiichi Sankyo et al. / DEMO*, the CJEU concluded that TRIPS falls within the field of common commercial policy in its entirety and is hence excluded from the field of the internal market.¹⁴ However, the Court also reiterates that this attribution in particular reflects the fact that the context of those rules is the liberalization of international trade and not the harmonization of the law of the Member States. Therefore, the European Union remains free to legislate on the subject of intellectual property rights by

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- ⁹ TRIPS, Preamble; CJEU, Opinion 1/94 of the Court of 15 November 1994, European Court reports 1994 Page I-05267 = NJW 1995, 2543, para. 58; CJEU, *Schieving-Nijstad vof and Others v Robert Groeneveld*, C-89/99, ECLI:EU:C:2001:438 = GRUR Int. 2002, 41, para. 36; Enforcement Directive Recitals 3–5; Benkard / *Ullmann / Tochtermann*, PatG, 11th ed. 2015, Internationaler Teil, paras. 77 et seq.
- ¹⁰ CJEU, Opinion 1/94 of 15 November 1994, European Court reports 1994 Page I-05267 = NJW 1995, 2543, para. 58; CJEU, *Schieving-Nijstad vof and Others v Robert Groeneveld*, C-89/99, ECLI:EU:C:2001:438 = GRUR Int. 2002, 41, para. 36.
- ¹¹ CJEU, *Merck Genéricos – Produtos Farmacêuticos Lda v Merck & Co. Inc. and Merck Sharp & Dohme Lda*, C-431/05, ECLI:EU:C:2007:496 = GRUR 2008, 55, paras. 31 et seq.
- ¹² In *Daiichi Sankyo et al. / DEMO*, the CJEU is clear in saying that neither its Opinion 1/94 nor the judgment in *Merck Genéricos – Produtos Farmacêuticos* are applicable any more because they relate to the old Art. 133 EC, which does not mention commercial aspects of intellectual property, see CJEU, *Daiichi Sankyo Co. Ltd Sanofi-Aventis Deutschland GmbH v DEMO*, C-414/11, ECLI:EU:C:2013:520 = GRUR Int. 2013, 895.
- ¹³ CJEU, *Daiichi Sankyo et al. v DEMO*, C-414/11, ECLI:EU:C:2013:520 = GRUR Int. 2013, 895, para. 45 et seq.
- ¹⁴ *Idem* paras. 53, 60.

virtue of competence relating to the field of the internal market. On the other hand, any act adopted in this respect will have to comply with the rules concerning the availability, scope and use of intellectual property rights under TRIPS.¹⁵ This finding also is in line with Art. 207(6) TFEU stipulating that the allocation of competences effected by this provision shall not lead to harmonization of legislative provisions of the Member States in so far as the Treaties of the European Union exclude such harmonization.

The decision *Daichi Sankyo et al./DEMO* also marks a turning point in the CJEU's jurisprudence with respect to the question whether Member States are principally competent to give direct effect to provisions of TRIPS, which in turn would enable national courts to directly apply those provisions. While in the judgment in *Merck Génériques – Produtos Farmacêuticos* the CJEU answered this question in the affirmative,¹⁶ the judgment in *Daichi Sankyo et al./DEMO* must be read to exclude any direct effect of TRIPS.¹⁷ The courts of the Member States are barred from any discrete interpretation of TRIPS, aside from *actes claires/actes éclairés*. Member States are bound by the CJEU's interpretation of TRIPS, which favors the right holder according to its primary objective to strengthen and harmonize the protection of intellectual property rights on a worldwide scale.¹⁸ It further emphasizes the objective of TRIPS to reduce distortions of international trade by ensuring the effective and adequate protection of intellectual property rights.¹⁹ These aims again naturally emphasize the position of the right holder.

In summary, TRIPS does not have any direct harmonizing effect on the law of the Member States, a result, which is in accordance with Art. 207(6) TFEU.

b) Standards established by TRIPS

While there is no direct effect of the TRIPS in the Member States and, thus, individual persons are barred from relying on TRIPS provisions in court, the principles laid down in it are to be observed by way of an interpretation of the applicable legal rules.²⁰

In order to reduce distortions in international trade, the TRIPS identifies effective and appropriate means for the enforcement of trade-related intellectual

¹⁵ *Idem* paras. 59, 60.

¹⁶ CJEU, *Merck Génériques – Produtos Farmacêuticos*, C-431/05, ECLI:EU:C:2007:496 = GRUR 2008, 55, paras. 47 et seq.

¹⁷ *Liebenau/Uhrich/Zech*, 2014, 107, 111/112; Benkard/*Ullmann/Tochtermann*, PatG, Internationaler Teil, para. 79.

¹⁸ *Liebenau/Uhrich/Zech*, 2014, 107, 112.

¹⁹ CJEU, *Daichi Sankyo et al. v DEMO*, C-414/11, ECLI:EU:C:2013:520 = GRUR Int. 2013, 895, para. 58; CJEU, *Schieving-Nijstad vof and Others v Robert Groeneveld*, C-89/99, ECLI:EU:C:2001:438 = GRUR Int. 2002, 41, para. 36.

²⁰ *Liebenau/Uhrich/Zech*, 2014, 107, 112; Benkard/*Ullmann/Tochtermann*, PatG, Internationaler Teil, para. 79.

property rights as one of the primary concerns. In doing so, however, it explicitly acknowledges the differences of national legal systems.²¹

This underlines that – albeit strengthening intellectual property rights by promoting a minimum harmonization on the international level – TRIPS does not interfere with national legislative competences. States are free to implement the principles established therein in their national legal orders. TRIPS notably provides for guidance.

Thus, with respect to the question of proportionality presently discussed, regard is to be had to the guidelines established in TRIPS. The most obvious starting point is a reading of Art. 44 TRIPS on injunctions. It states: “The judicial authorities shall have the authority to order a party to desist from an infringement [...]”

In the current context, it is particularly noteworthy that Art. 44 TRIPS on injunctions does not stipulate any sort of requirement of proportionality as a precondition for granting an injunction.²² At the same time it can be safely assumed that if the drafters of TRIPS had intended to institute such a precondition, they would have explicitly done so. This can be deduced from a simple comparison: Art. 46 on *Other Remedies* explicitly mentions a “need for proportionality” in considering such requests.²³

Looking further in the TRIPS provisions, Art. 41 para. 2 on *General Obligations*, may seem as an adequate basis for a requirement of proportionality because it calls for “fair and equitable procedures concerning the enforcement of intellectual property rights”. However, albeit being a general statement, it merely pertains to the (court) procedure, i. e. of granting an injunction, but may not be read as a parameter to take a proportionate decision on the merits. This finding is underlined by Art. 42 on *Fair and Equitable Procedures*, which again focuses solely on procedural aspects.

However, provisions concentrating on procedural aspects cannot genuinely prescribe a proportionality requirement with respect to the grant of injunctions, if and because such a requirement would substantially limit the exclusivity right conferred by a patent.²⁴ Accordingly, any such requirement must be rooted in material provisions, i. e. the rule on the scope of the exclusivity right.

In general, the rights conferred by a patent are described in Art. 28 TRIPS and neighboring provisions. TRIPS does not actually prescribe an absolute exclusivity right, but rather allows for exceptions in order to accommodate the different

21 TRIPS, Preamble para. 2 lit. (c); CJEU, *Daiichi Sankyo et al. v DEMO*, C-414/11, ECLI:EU:C:2013:520 = GRUR Int. 2013, 895, para. 58.

22 *Ohly*, GRUR Int. 2008, 787, 797.

23 “In considering such requests, the need for proportionality between the seriousness of the infringement and the remedies ordered as well as the interests of third parties shall be taken into account.”

24 In this sense *Ohly*, GRUR Int. 2008, 787, 797: “[...] a limitation of the injunction would touch the core of the intellectual property right [...]”; *Osterrieth*, GRUR 2018, 985, 987.

interests concerned when it comes to the functioning of the patent system as a whole.²⁵ However, Art. 30 TRIPS may not be construed in a broad manner allowing for individual exceptions to the exclusivity right of the patentee, which are to be granted by judges deciding on the enforcement of the patent. It reads:

“Exceptions to Rights Conferred

Members may provide limited exceptions to the exclusive rights conferred by a patent, provided that such exceptions do not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties.”

Despite the open wording several reasons speak against a broad reading of this provision.

First, its wording clearly addresses the extent of the patent as a substantive (exclusivity) right. It describes “exceptions to the rights conferred”, thus potentially limiting their scope. Addressing “members” also leads to the assumption that the exceptions should only be granted by TRIPS Member States’ legislators as opposed to the judiciary.

Second, Art. 30 TRIPS prescribes clear preconditions: exceptions must be (1) “limited”, (2) “do not unreasonably conflict with a normal exploitation of the patent” and (3) “do not unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties.”²⁶ A general proportionality requirement for an injunction would already be problematic with respect to the precondition that the exception has to be “limited”. In order to determine the meaning of this precondition, guidance can be sought from the Panel report of the WTO Dispute Settlement Body (DSB) in the case of *Canada-Patent Protection of Pharmaceutical Products*, where the panel was concerned with the interpretation of Art. 30 TRIPS. While DSB rulings strictly are binding only on the parties to the dispute,²⁷ they can still serve as guidance.

According to *Canada-Patent Protection of Pharmaceutical Products*, the term “limited” is to be given a rather narrow interpretation in the context of the phrase “limited exceptions” since the word “exception” by itself connotes a limited derogation. Hence it must be read in a manner to cause only a small (further) diminution of the rights in question.²⁸ The Panel further concluded that the term had to be read literally, focusing on the extent to which legal rights have been curtailed.²⁹ It held that to determine whether a particular exception constitutes a limited exception, the extent to which the patent owner’s rights have

²⁵ Busche/Stoll/Wiebe-*v. Saint-André/Taşdelen*, TRIPS, 2nd ed., Heymanns 2013, Art. 30 para. 2.

²⁶ *Canada-Patent Protection of Pharmaceutical Products*, WT/DS114/R, para. 7.20.

²⁷ There is no rule of stare decisis in WTO dispute settlement, reports of panels are not binding precedents for other disputes: https://www.wto.org/english/tratop_e/dispu_e/dispu_settlement_cbt_e/c7s2p1_e.htm (last accessed: 16 July 2019).

²⁸ *Canada-Patent Protection of Pharmaceutical Products*, WT/DS114/R, para. 7.30.

²⁹ *Canada-Patent Protection of Pharmaceutical Products*, WT/DS114/R, paras. 7.30 et seq.

been curtailed must be measured.³⁰ With respect to the provisions of the Canadian Patent Act on the protection of pharmaceutical products, such measure of the patent owner's rights could reasonably be undertaken because it concerned a very specific and narrow case. And even in this scenario, that Panel upon conducting this measurement concluded that the provision in question did not satisfy the first precondition of a "limited exception".³¹

Considering that the DSB-Panel could not convince itself of the limited character of the provision in question despite such a specific and narrow scenario, it is assumed that it would neither do so with respect to a rule subjecting the exercise of the rights conferred upon the patent holder to a general proportionality assessment. Such exception could by no means be described as "limited" as it would be applied without differentiation to any type of the patent holder's rights. This would run contrary to the clear-cut preconditions set out by Art. 30 TRIPS.

It may be argued that TRIPS neither prescribes a proportionality requirement of its own nor would it welcome such a requirement in the national patent law of a signatory. An unlimited exception to the rights of the patent holder is simply not covered by Art. 30 TRIPS.

Of course, this does not imply that a proportionality assessment concerning injunctions is generally barred under TRIPS. A statutory provision to this effect remains possible, but in order to comply with the standards established in Art. 30 TRIPS, it must be strictly limited in scope.

2. The Enforcement Directive of 2004

A further legal source to be contemplated is the European Enforcement Directive. It was adopted in 2004 with the intention to foster the success of the internal market by enhancing the protection of intellectual property rights. This is regarded as central not only for promoting innovation and creativity, but also for developing employment and improving competitiveness.³² With the intention to ensure that the substantive law on intellectual property, which is nowadays largely part of the *acquis communautaire*, is applied effectively throughout the Union,³³ it also sets the stage for an effective enforcement of patent rights.

Just as TRIPs the Enforcement Directive does not expressly stipulate any proportionality requirement for granting an injunction. The conditions for granting an injunction explicitly are left for the national legal orders to determine.³⁴ It is

³⁰ *Canada-Patent Protection of Pharmaceutical Products*, WT/DS114/R, para. 7.32.

³¹ *Canada-Patent Protection of Pharmaceutical Products*, WT/DS114/R, para. 7.38.

³² Recital 1 Enforcement Directive.

³³ Recital 3 Enforcement Directive.

³⁴ Art. 3(1) Enforcement Directive: "Member states shall provide for the measures [...]"; CJEU, *L'Oréal SA and Others v. eBay International AG and Others*, C-324/09, EU:C:2011:474 = MMR 2011, 596, para 135.

to be said in advance that the discussion on proportionality regarding copyright infringement, which is led on the level of EU law and has already been covered by several decisions of the CJEU, is not to be transposed to patent law. Copyright – albeit being an intellectual property right – is fundamentally different from a patent, already because it emerges *ipso iure* with the creation of the copyrighted work while a patent right needs to be registered in order to be protected. Hence, the incentives to seek patent protection are fundamentally different from those of copyright protection. This must naturally be taken into account in any (potential) proportionality assessment concerning injunctions with regard to one or the other.

Against this background, it comes as no surprise that the discussion on proportionality with respect to copyright remedies is far more developed, in particular because of several landmark decisions by the CJEU in the cases of *Promusicae*,³⁵ *L'Oréal*,³⁶ *SABAM*³⁷ and *Telekabel*.³⁸ In the case of *Coty Germany/Sparkasse Magdeburg*, the CJEU extended its reasoning to Union trade mark law³⁹ and in *Bastei Lübbe/Strotzer* reiterated it recently.⁴⁰ Here, the proportionality debate is centered around the balancing of fundamental rights protected by the Charter of Fundamental Rights. This development is problematic, however, in light of the fact that most interests concerned can easily be broken down to their roots in fundamental rights.

It cannot be ruled out that the CJEU may extend this reasoning to patent law because here the fundamental right to an effective remedy and, ultimately, the fundamental right to intellectual property are at stake as well. However, EU secondary law such as the Enforcement Directive already is the result of a careful balancing of fundamental rights. It is therefore problematic to conduct a separate balancing in each particular case, when the application of those instruments is concerned.

As of now, the differences in the fields of intellectual property require to separately assess the field of patent law from the field of copyright law.

35 CJEU, *Productores de Música de España (Promusicae) v. Telefónica de España SAU*, C-275/06, ECLI:EU:C:2008:54 = MMR 2008, 227.

36 CJEU, *L'Oréal SA and Others v. eBay International AG and Others*, C-324/09, EU:C:2011:474 = MMR 2011, 596.

37 CJEU, *Scarlet Extended SA v. Société Belge des Auteurs, Compositeurs et éditeurs SCRL (SABAM)*, C 70/10, ECLI:EU:C:2011:771 = GRUR 2012, 265 and *Belgische Vereniging van Auteurs, Componisten en Uitgevers (SABAM) v. Netlog NV*, C-360/10, ECLI:EU:C:2012:85 = MMR 2012, 334.

38 CJEU, *UPC Telekabel Wien GmbH v. Constantin Film Verleih GmbH, Wega Filmproduktionsgesellschaft mbH*, C 314/12, ECLI:EU:C:2014:192 = GRUR 2014, 468. For a detailed discussion of these decisions see *Fischman Afiori*, IIC 2014, 889, 901 et seq.

39 CJEU, *Coty Germany GmbH/Sparkasse Magdeburg*, C-580/13 ECLI:EU:C:2015:485 = GRUR 2015, 894, paras. 33 et seq.

40 CJEU, *Bastei Lübbe GmbH & Co. KG/Michael Strotzer*, C-149/17, ECLI:EU:C:2018:841 = GRUR 2018, 1234, para. 43 et seq.

a) Structure

Considering the material provisions of the Directive it is noteworthy that proportionality in fact is mentioned in several instances, albeit not explicitly in Art. 11 on injunctions.

A frequent argument is, however, that a proportionality assessment is mandated by Art. 3(2) Enforcement Directive,⁴¹ which contains a general statement that the remedies prescribed by the Directive shall “also” be proportionate. *Prima facie*, this wording seems to be unambiguous as to the effect that this requirement shall apply to all remedies mentioned in the following, including injunctions. Yet, despite the general statement, a number of the following provisions explicitly set out proportionality requirements, while the particular provision on injunctions does not: this is the case for Art. 10(3) Enforcement Directive. It prescribes a need for proportionality in considering a request for corrective (provisional) measures. The same holds true for Art. 8(1) Enforcement Directive requiring a Claimant’s request for information to be justified and proportionate. This exemplifies that if the drafters of the Enforcement Directive had intended to subject the granting of injunctions to a proportionality requirement they would have explicitly done so.

Furthermore, Art. 12 Enforcement Directive addresses the proportionality of measures against the infringer in a particularly explicit manner. It provides for a very specific instrument. It opens to judicial authorities the possibility (“may” instead of “shall”) of ordering pecuniary compensation instead of an injunction in cases where the infringement was committed unintentionally and without negligence. The further requirement is that the execution of the measures in question would cause disproportionate harm to the person held liable. The provision also applies to injunctions.⁴² Apparently, it does not constitute a general proportionality requirement but rather an exemption clause targeting faultless infringement.⁴³ This shows that the drafters very carefully considered the aspect of proportionality of injunctive relief. Yet they chose not to insert a general exception. In fact, it applies only to very narrow cases of faultless behavior. For these cases, they specifically prescribe pecuniary compensation instead of an injunction. Hence, even in these narrow scenarios, the Directive does not call for proportionality as a requirement for the order of an injunction in itself, but instead merely proposes a remedy in replacement.

41 *Ohly* GRUR Int. 2008, 796, 797; *Hofmann*, WRP 2018, 1, 5 et seq.; *Osterrieth*, GRUR 2018, 985, 988.

42 Recital 25 explicitly links the alternative measure of pecuniary compensation to injunctions. This together with the placement of Art. 12 behind Art. 10 on *Corrective measures* and behind Art. 11 on *Injunctions* lets it be assumed that the provision applies to both.

43 *Ahrens/McGuire*, ModellG, § 56 Buch 1, para. 3.

b) Wording of Art. 3(2) Enforcement Directive

By no means may Art. 3(2) Enforcement Directive be read as broadly as to provide for a general precondition to any cease and desist claim of the rightholder.⁴⁴

Further it is to be assumed that Art. 3(2) Enforcement Directive is directed at Member States implementing the Enforcement Directive (Art. 3(1): “Member States shall provide for measures [...]”) and not at individuals invoking proportionality in a particular case. Similarly, Art. 3(2) Enforcement Directive by its wording makes a clear distinction: while the first half sentence “Those measures [...] shall [...]” is directed at the preceding paragraph 1, the second half sentence explicitly addresses the application of the remedies. In the application, courts have to be careful not to create barriers to legitimate trade and to provide for safeguards against the abuse of remedies. Proportionality, however, addressed in the first half sentence, clearly is to be observed at the level of the national legislator, not at the level of application by national courts.⁴⁵

c) Objectives

A national rule on a “remedy” necessary to ensure the enforcement of intellectual property rights must meet the standards prescribed by Art. 3(2) Enforcement Directive. Hence, a national rule allowing for an application of the proportionality requirement, such as to exclude injunctions, must always be balanced against the effectiveness and dissuasiveness of the remedy.⁴⁶ Rules of national law implementing the Enforcement Directive must be designed in such a way that the objective pursued by the directive may be achieved.⁴⁷ Already, the standards of effectiveness and dissuasiveness exemplify the objective⁴⁸ of the Directive to strengthen the protection of the rightholder of an intellectual property right.

According to the Union law principle of effectiveness, in order to safeguard all rights individuals derive from Union law, rules established by Member States to this effect must be designed in a manner that their exercise is not rendered virtually impossible or excessively difficult.⁴⁹

In addition, by particularly stressing the dissuasiveness of the remedies implemented by national legislators, it becomes clear that the directive intends them

⁴⁴ *Ohly* GRUR Int. 2008, 796, 797; *Hofmann*, WRP 2018, 1, 5 et seq.; *Osterrieth*, GRUR 2018, 985, 988.

⁴⁵ *Reetz/Pecnard/Fruscalzo/van der Velden/Marfé*, GRUR Int. 2015, 210, 211; in CJEU, *L'Oréal*, C-324/09, EU:C:2011:474 = MMR 2011, 596, paras. 138–140 the CJEU practices this delineation as well.

⁴⁶ BGH GRUR 2016, 1031, para. 50 – *Wärmetauscher*; *Ohly*, GRUR Int. 2008, 787, 797.

⁴⁷ CJEU, *L'Oréal*, C-324/09, EU:C:2011:474 = MMR 2011, 596, para. 136.

⁴⁸ Recitals 2 and 3 Enforcement Directive.

⁴⁹ CJEU, *J. van der Weerd et. al.*, joint Cases C-222/05 to C-225/05, ECLI:EU:C:2007:318 para. 28; CJEU, *L'Oréal*, C-324/09, EU:C:2011:474 = MMR 2011, 596, para. 136.

to be powerful enough to not only provide for a compensatory effect after an infringement but also for a deterrent effect to prevent infringements. A general proportionality assessment weighing all interests concerned in the particular case can likely not meet these standards.

Finally, it may be argued that it would not meet the standards of TRIPS. The Enforcement Directive mandates that the standards are observed by the Member States in the implementation of the Directive.⁵⁰ Also, the provisions of the Enforcement Directive should be given an interpretation respecting the obligations under TRIPS. As laid out above, a general proportionality assessment before granting an injunction would amount to a restriction of the patent holder's exclusivity right. Such restriction must meet the standards provided for in Art. 30 TRIPS, calling for exceptions to be "limited". A general proportionality requirement in the granting of an injunction would have to be considered unlimited because it requires a weighing of all interests concerned on a case by case basis. It would make it unpredictable for the patent holder whether it will be possible to effectively enforce the exclusivity right against the infringer. This violates the principle of legal certainty.

3. The European Patent Convention

Naturally, the EPC does not set out any requirements for claiming an injunction. According to Art. 63 para. 3 EPC "Any infringement of a European patent shall be dealt with by national law."

II. An overview: European substantive patent laws

According to the findings presented above, national legal provisions on injunctions must on the one hand comply with the preconditions set out in Art. 11 Enforcement Directive but must also meet the standards of Art. 3(2) Enforcement Directive. Hence, legislation must be proportionate, effective and dissuasive while courts in its application must avoid to create barriers to legitimate trade and must provide safeguards against abuse of rights. This will be tested for legislation and jurisprudence in Germany and briefly compared with selected European jurisdictions, in particular the United Kingdom. The overview will be complemented with the relevant provisions from the UPCA.

⁵⁰ Art. 2(3)(b) and Recitals 4 and 5 Enforcement Directive.

1. Patent injunctions in German law

Sec. 139 German Patent Act grants a right to claim an injunction against anyone using a patented invention contrary to Sec. 9 or 10 German Patent Act. Sec. 9 describes the scope of application of patent protection in terms of granting the patent holder a right to use the patented invention as well as a right to exclude all others from such use without his/her consent.

It should be mentioned that a claim for an injunction is rooted in substantive and not procedural law in Germany. Hence, if the preconditions of Sec. 139 German Patent Act are met, an injunction must be granted. There is no procedural leeway for judges to abstain from granting an injunction on the basis of proportionality considerations.

However, it is an ongoing discussion in Germany whether an injunction should be subjected to a general proportionality assessment despite a positive finding of patent infringement.⁵¹ Certain interest groups lobby for an amendment of the provisions presently in force.⁵² It is considered disproportionate to allow the holder of a patent concerning a minor component (i.e. concerning a computer chip) of a much more complex system (i.e. a car) to enforce its right by e.g. stopping the distribution of the whole complex product.⁵³ To back up this argument, the standards allegedly imposed by the Enforcement Directive are frequently invoked.⁵⁴

However, a close analysis of the German patent law reveals that it meets the standards of the Enforcement Directive as identified in the foregoing:

First, it may not be argued on the basis of Art. 3(2) of the Enforcement Directive that Sec. 139 German Patent Act should be complemented with a general proportionality requirement because Art. 3(2) Enforcement Directive must be read against Art. 30 TRIPS. This provision calls for exceptions to the exclusivity right to be “limited” (see *supra*). Second, Germany has not implemented Art. 12 of the Enforcement Directive calling for an alternative measure of pecuniary compensation in cases of disproportionality (see *supra*). However, as its non-binding wording indicates (“Member States may provide that”), it was not imperative to implement this provision.⁵⁵ Under German patent law, only the claims for destruction and recall of products are subjected to an explicit proportionality requirement in Sec. 140a para. 3 German Patent Act.

51 See other articles included in this volume; *Lüthi*, GRUR Int. 2019, 352; *Hofmann*, NJW 2018, 1290; *Osterrieth*, GRUR 2018, 985.

52 Interested circles were invited to the German Federal Ministry of Justice on 20 May 2019 to discuss the matter of “Injunctions in the context of SEPs and complex products”.

53 See references in *Lüthi*, GRUR Int. 2019, 352; *Hofmann*, NJW 2018, 1290; *Osterrieth*, GRUR 2018, 985.

54 See *supra*, note 42.

55 Begr. RegE-Durchsetzungsg, BT-Drucks. 16/5048, p. 32.

On the other hand, in German patent law, proportionality in awarding substantive claims is ensured in a way to meet the requirements of Art. 3(2) Enforcement Directive. First and foremost, every interference with the constitutional guarantee of ownership (Art. 14 German Basic Law) (including patent ownership) has to be justified against the backdrop of the proportionality principle.⁵⁶ In general civil law it is implemented by virtue of the good faith principle. A potential infringer may raise the defense of disproportionality against an injunction by invoking good faith under Sec. 242 German Civil Code (BGB).⁵⁷ For example, the Federal Supreme Court (BGH) held in its *Wärmetauscher* decision of 2016 that an immediate enforcement of an injunction – even considering the legitimate interests of the patent holder *vis-à-vis* the infringer – may constitute a disproportionate severity that could not be justified by the exclusivity of the patent right and therefore was considered to be contrary to good faith. The court defined this standard in order to consider the granting of a grace period for the infringer to accomplish transition and elimination measures.⁵⁸

However, the criteria for assessing proportionality of a grace period had not yet been established by case law for patent cases. The BGH therefore drew from criteria used in the area of competition law as well as from legal literature. In this respect it is to be stressed that the BGH has defined high thresholds, accounting for the very nature of patent infringement. Since the infringement was a direct consequence by i. e. the manufacture of a protected product it is a necessary consequence of an injunction that the infringer would have to cease production. The consequential hardship is to be accepted. A limitation of the effects of a patent was only justified if and because an absolute prohibition was an intolerable hardship (“unzumutbar”).⁵⁹ On the backdrop of this very strict standard, interestingly, the BGH ruled in *Wärmetauscher* that in the particular circumstances of the case it was not justified to grant a grace period.⁶⁰

From the point of view of the statutory law, proportionality in extreme cases is ensured by the principle of good faith radiating into patent law. From the point of view of the application of the law, judges undertake a proportionality assessment where for example abusive behavior is invoked or where there is intolerable hardship.

Furthermore, to determine whether the German patent law meets the standards of Art. 3(2) Enforcement Directive, it is insufficient to look at isolated provisions. A guarantee for proportionality may also be derived from the functioning

56 Maunz/Dürig-Papier/Shrivani, GG, Art. 14 para. 694.

57 Benkard-Grabinski/Zülch, PatG, § 139 para. 26: Infringer may raise defenses of fraudulent behavior or unlawful exercise of a right; Ohly, GRUR Int. 2008, 787, 795 et seq.

58 BGH GRUR 2016, 1031 – *Wärmetauscher*, para. 41.

59 BGH GRUR 2016, 1031 – *Wärmetauscher*, para. 45; see the application of a similar standard in BGH GRUR 2018, 292 – *Produkte der Wundversorgung*, para. 26; Hofmann, NJW 2018, 1290, 1292 with further references.

60 BGH GRUR 2016, 1031 – *Wärmetauscher*, paras. 51 et seq.

of the patent system as a whole. In Germany, judgements ordering injunctions are only declared provisionally enforceable against security (Sec. 709 German Code of Civil Procedure). The security is meant to cover possible damage claims of the debtor for example in cases where the judgment of the lower instance court is reversed by the appellate court (Sec. 717 para. 2 German Code of Civil Procedure). The amount the claimant has to provide may be considerable, especially for judgments of injunctions in cases of intellectual property infringement.⁶¹ It must not only cover legal costs but also possible damages the debtor might incur because of the provisional enforcement of the judgment. These might be considerably higher than the overall interest of the claimant in the injunction.⁶² Hence, the amount of security might deter the claimant from seeking provisional enforcement or at least to evaluate its chances carefully.

Also, an application by the defendant for a temporary stay of compulsory enforcement according to Sec. 719, 707 German Code of Civil Procedure may be filed on the ground – *inter alia* – that the enforcement would entail a disadvantage that it is impossible to compensate or remedy. In the assessment whether a stay can be granted, courts weigh all interests concerned in the particular case.⁶³

These procedural mechanisms may serve as further examples of how proportionality of injunctions is ensured by the functioning of the legal system as such.

2. Patent injunctions in other European jurisdictions

When comparing these results with other European jurisdictions, the dividing line at first glance seems to be drawn between the continental European legal orders and the Anglo-Saxon legal tradition.

In a recent study, *Reetz, Pecnard, Fruscalzo, van der Velden* and *Marfé* have concluded that in none of the continental European countries under consideration (Germany, France, Italy, Netherlands) either the power of the courts to grant patent injunctions or the substantive cease and desist claims were limited by a proportionality assessment.⁶⁴ The only limitations were imposed by the principle of market freedom – guaranteed by the rules on the internal market and the Unions competition policy (Art. 101, 102 TFEU) – and the prohibition of abuse of rights. None of the states implemented Art. 12 Enforcement Directive.⁶⁵

On the other hand, the UK legal order seems more prone to conduct a proportionality assessment in the single case. In the Anglo-Saxon legal tradition, a remedy such as an injunction is not a legal consequence of substantive law

61 Cepl/Voß-Lunze, *Prozesskommentar zum Gewerblichen Rechtsschutz*, 2nd ed. 2018, § 709 para. 8.

62 *Idem*.

63 Cepl/Voß-Lunze, *Prozesskommentar zum Gewerblichen Rechtsschutz*, § 707 paras. 11 et seq.

64 *Reetz/Pecnard/Fruscalzo/van der Velden/Marfé*, *GRUR Int.* 2015, 210, 211.

65 *Idem*.

(strict law) but an application of the law of equity. English courts see themselves as being authorized on the basis of their equity law tradition not to grant a cease and desist order in the event of disproportionality.⁶⁶ However, a closer look at the requirements applied to the proportionality assessment reveals that it is considered only for rare and exceptional cases.⁶⁷ As Judge *Pumfrey* put it in the case of *Navitaire Inc v. EasyJet Airline Co Ltd (No. 2)*:

“[...] the grant or refusal of a final injunction is not merely a matter of the balance of convenience. Justice requires that the court [...] remembers that if the effect of the grant of an injunction is not oppressive the defendant cannot buy his way out of it, even if the price, objectively ascertained, would be modest. My understanding of the word ‘oppressive’ in this context is that the effect of the grant of the injunction would be grossly disproportionate to the right protected. The word ‘grossly’ avoids any suggestion that all that has to be done is to strike a balance of convenience.”⁶⁸

However, in recent years, English courts have given Art. 3(2) Enforcement Directive and its reading by the CJEU more room: proportionality may require to balance intellectual property rights against other rights concerned.⁶⁹ However, in this approach, the courts rely on the CJEU jurisprudence presented above, which focuses on copyright. What is more, in the recent case of *HTC Corporation v. Nokia Corporation* on patent infringement, the EWHC drew a clear line by stating that in the concrete circumstances

“[...] refusal of an injunction would be tantamount to imposing a compulsory licence on Nokia in the circumstances where HTC could not obtain a compulsory licence by the proper route.”⁷⁰

This may serve as an indication that English courts as well apply high standards to the refusal of an injunction for proportionality considerations.⁷¹ Presumably, the results of a proportionality assessment under the continental European and the Anglo-Saxon legal orders are not too far apart.

3. Patent injunctions according to UPCA

Even though the prospects of the Unified Patent Court (UPC) are still somewhat unpredictable, it is worthwhile to take a look at the UPCA and the Rules of

⁶⁶ *Reetz/Pecnard/Fruscalzo/van der Velden/Marfé*, GRUR Int. 2015, 210, 214.

⁶⁷ *Idem*.

⁶⁸ *Navitaire Inc v easyJet Airline Co Ltd (No. 2)* [2005] EWHC 282 (Ch), [2006] RPC 4; for a detailed presentation of the UK jurisprudence see the article of *Alexander*, QC, in this volume at p. 279; cf. also BGH GRUR 2016, 1031 – *Wärmetauscher*, para. 50; *Reetz/Pecnard/Fruscalzo/van der Velden/Marfé*, GRUR Int. 2015, 210, 214; *Tilmann*, Unified Patent Protection, Art. 63 UPCA, para. 27.

⁶⁹ *HTC Corporation v. Nokia Corporation* [2013] EWHC 3378 (Pat) (03 December 2013) with further references.

⁷⁰ *Arnold J in HTC Corporation v. Nokia Corporation* [2013] EWHC 3378 (Pat) (03 December 2013).

⁷¹ See also the article of *Alexander*, QC, in this volume at p. 279.

Procedure (RoP) – after all they are a body of harmonized European Law. Experts in patent litigation from all over Europe have discussed for decades in order to establish a common ground for patent litigation before the UPC and tried to create a kind of “best of all worlds”.

But yet again, Art. 63 UPCA on injunctions does not feature a proportionality requirement:

“Permanent injunctions

(1) Where a decision is taken finding an infringement of a patent, the Court may grant an injunction against the infringer aimed at prohibiting the continuation of the infringement. The Court may also grant such injunction against an intermediary whose services are being used by a third party to infringe a patent.”

In fact, Art. 63 UPCA is a literal implementation of Art. 11 Enforcement Directive.

a) No procedural discretion

A preliminary remark has to be made about the legal nature of the provision. It clearly reflects the continental European understanding that a procedural order of an injunction is the result of a substantive cease and desist claim against the infringer. In particular, there is no procedural discretion of the judges not to grant an injunction if it considers it to be disproportionate. Therefore, any counter-arguments against a cease and desist order must be asserted under substantive law.⁷²

But would Art. 63 UPCA give room to such counter-arguments? There has been some discussion whether the wording “may grant” still confers discretion upon the judges not to grant the injunction despite a clear infringement. The predominant opinion rejects this point of view though.⁷³ Hence, if the court, after having considered all counter-arguments, finds that there is an infringement, an injunction – if claimed – is imperative. Arguing on the award of the substantive claim, the defendant has ample opportunity to raise its counter-arguments against infringement.⁷⁴

Instead, the wording “may” is read in a way as to give legal authority (power) to the UPC to grant a cease and desist order and also to abstain from doing so, if the substantive claim appears to be unfounded from a substantive patent law perspective.⁷⁵

⁷² *Tilman*, Unified Patent Protection, Art. 63 UPCA, paras. 27 et seq.

⁷³ *Reetz/Pecnard/Ruscalzo/van der Velden/Marfé*, GRUR Int. 2015, 210, 216; *Tilman*, Unified Patent Protection, Art. 63 UPCA, para. 29; dissenting i.a. *Osterrieth*, GRUR 2018, 985, 988/989; *Schröer*, GRUR Int. 2013, 1102, 1107 f.

⁷⁴ *Tilman*, Unified Patent Protection, Art. 63 UPCA, paras. 29 et seq.

⁷⁵ *Tilman*, Unified Patent Protection, Art. 63 UPCA, paras. 20 and 29 et seq.

It might count as another argument against procedural discretion that the special provision on pecuniary relief instead of an injunction of Art. 12 Enforcement Directive has not been implemented in the UPCA. Up until the 16th Draft the RoP still contained a rule along the lines of Art. 12 Enforcement Directive, but this option for judges in the application of the law was deleted from later drafts.

b) No general substantive law defense of disproportionality

This leads to the question whether the defendant can claim disproportionality as an argument based on substantive law?

The legal basis for a cease and desist claim with respect to European Patents with Unitary Effect (EPUEs) is Art. 5(1) EPUE-Reg.⁷⁶ combined with Art. 25 UPCA. Again, neither of these provisions features a proportionality requirement. As argued in the foregoing, this would run counter the provisions of Art. 3(2) Enforcement Directive read in light of Art. 30 TRIPS.

The remaining question is whether a defense on proportionality may be raised under the applicable national law according to Art. 24(1)(e) and (2) UPCA. The UPCA and the EPUE referring to the Enforcement Directive are comprehensive and binding on the issue of proportionality under patent law. None of the directly relevant provisions contains a proportionality requirement concerning injunctions. On the other hand, several other provisions of the UPCA explicitly hold elements of a proportionality assessment. Some examples are Art. 60 UPCA on preserving evidence, Art. 62 UPCA on provisional measures, which expressly calls for a balancing of interests the Court is required to undertake in a discretion decision (Art. 62(2) UPCA). Hence, the drafters of the UPCA took a deliberate choice not to include a proportionality requirement in the rule on injunctions in Art. 63 UPCA. There is no room for the application of national patent law.

As for non-patent law defenses, on the other hand, such as the civil law objection based on “good faith”, these should be allowed on the basis of national law. As it will mostly concern general principles of civil law, their scope presumably is going to be limited and might be quite similar in many Member States.

III. Proportionality de lege ferenda?

1. Argument concerning the functioning of the patent system as a whole

Finally, in light of these findings, the question whether the existing law should be amended in order to include a general proportionality assessment must be addressed.

⁷⁶ *Tilmann*, Unified Patent Protection, Art. 63 UPCA, para. 17.

First and foremost, if it was drafted in rather general and broad terms, it would run counter the requirements of Art. 30 TRIPS (see supra).

Another argument may be construed taking into consideration the impact of a general proportionality assessment on the patent system as a whole. As an additional requirement for granting an injunction it may be hazardous. Without specific standards defined by law it could severely disturb the balance enshrined in the patent system.

In a nutshell,⁷⁷ patent law is driven by the underlying idea that the technology behind the patents shall be made available to the general public in order to further technical knowledge of the society as a whole (theory of disclosure). This is supposed to reduce the necessary investment in the research of new technologies and to target these investments better. Disclosing existing knowledge allows others to build upon this knowledge and to develop it further. The risk of parallel inventions – generating double costs – is reduced and the society as a whole can steadily continue to innovate. Thus, disclosure is an efficient means of innovation.

While this evidently is desirable from the point of view of the society as a whole, the prospect of being used and copied is not similarly appealing to innovators. Accordingly, there must be an incentive to disclose their innovations (incentive effect). This is where the patent system comes in. Innovators/Patent holders are granted a temporary monopoly on the use of the invention. By virtue of their exclusive right, they alone may decide who is allowed to use the patented invention. Patent laws clearly define the scope and the restrictions of the patent right as a temporary monopoly to assure it does not go overboard. But within these limits, the injunction is central to the effective enforcement of this right, bearing much more deterrent potential than i. e. the damage remedy because it has the power to exclude competitors from the market.

Introducing a general proportionality requirement for any injunction would equal an unwritten restriction of the patent right as such. In essence it would mirror a compulsory license.⁷⁸ However, the preconditions of a compulsory license are set out in detail in Sec. 24 German Patent Act. To put the grant of an injunction in case of an infringement into question by applying a vague proportionality requirement would in addition massively undermine legal certainty. It would put the deliberate choice of the legislator to balance the interests concerned into question.

The existing system, namely the automatic grant of an injunction in case of infringement, is not overly detrimental to the potential infringer.⁷⁹ Competitors

⁷⁷ See also *Ohly*, GRUR Int. 2008, 787, 791 et seq.

⁷⁸ For the comparison see *Osterrieth*, GRUR 2018, 985, 988.

⁷⁹ Different view expressed by *Hofmann* in this volume at p. 249, *Osterrieth*, GRUR 2018, 985 and in Country report for Germany, AIPPI Q 219: *Haft/Nack/Lunze/Heusch/Schohe/Joachim*, GRUR Int. 2011, 927.

have ample opportunity to attack unjustified patents in opposition and nullity proceedings.

However, should the legislator consider an amendment of the existing patent law with respect to proportionality, this must meet the high standards of Art. 30 TRIPS, i. e. only provide for limited exceptions of the exclusivity right.

2. Argument from Sec. 6, 9 German Trade Secret Act

The fact that the (European) legislator is fully aware of specific rules to strike an acceptable compromise is underlined by the Trade Secrets Directive.⁸⁰ In this case the German legislator followed suit and did not omit the European rule, but implemented it into the national Trade Secret Act. Both the European and the German legislation give an idea of what a proportionality requirement could look like.

According to Sec. 6 German Trade Secret Act, an injunction may be granted against an infringer for obtaining, using or disclosing a trade secret without authorization according to Sec. 4 German Trade Secret Act.

All remedies under the German Trade Secret Act are subject to a proportionality assessment according to Sec. 9 German Trade Secret Act.

Sec 9 (translation by the author)

“Suspension of rights in case of disproportionality

The claims under Sec. 6 to 8(1) are suspended in case their performance would be disproportionate in the particular case, especially taking into account

1. the value or other specific features of the trade secret,
2. the measures taken to protect the trade secret,
3. the conduct of the infringer in acquiring, using or disclosing the trade secret,
4. the impact of the unlawful use or disclosure of the trade secret,
5. the legitimate interests of the parties and the impact which the granting or rejection of the measures could have on the parties,
6. the legitimate interests of third parties or
7. the public interest.”

Sec. 9 is an implementation of Art. 13 of the Trade Secrets Directive, which equally spells out specific criteria for the proportionality assessment.

Several points have to be noted: Firstly, Sec. 9 German Trade Secret Act works on the assumption that an infringement is positively found. Only as an exception in particular cases, remedies following from the infringement may be excluded if their enforcement would be disproportionate. This underlines the exceptional character of the provision.⁸¹

⁸⁰ Directive (EU) 2016/943 of the European Parliament and of the Council of 8 June 2016 on the protection of undisclosed know-how and business information (trade secrets) against their unlawful acquisition, use and disclosure.

⁸¹ For a more detailed analysis see *L. Tochtermann*, WRP 2019, 688.

Secondly, in order to guide the proportionality assessment, the provision sets out a list of criteria, making it clear which points have to be taken into consideration.

But is it possible that the same legislator within the same area of IP law considers a proportionality assessment to be justified with respect to trade secret infringement but could still reject it with respect to patent law infringement?

The answer relates to the difference between the rights granted. While the patent right is an absolute right, excluding all others from the unauthorized use of the patented invention (exclusivity right), trade secrets are not fully-fledged IP rights. They share many, but not all features of traditional IP. The object of protection is only the fact that the information is secret, not the information itself.⁸² The owner of the trade secret has to take active steps to keep secrecy. The aim of trade secret protection is to prevent information from being leaked to the general public while the aim of patent protection on the other hand is to make the invention known. Therefore, the public interest in the protection differs and accordingly the proportionality assessment in both cases must similarly be different.

There is also a major difference from the perspective of the infringer. With regard to patents there is a public register and any person acting in the market has to ensure it has freedom to operate. With regard to trade secrets there is no means to ascertain whether knowledge gain from a third party has been legally obtained. This considerably increases the risk of faultless or contributory infringement – in this case the proportionality may be a fair means to obtain a balance of interests.

With regard to patent law injunctions, on the other hand, there is no need to amend the law to include a proportionality assessment. In essence, an effective and dissuasive injunction is the necessary compensation for the desirable disclosure of the invention.

IV. Conclusion

1. TRIPS does not mandate a proportionality requirement.
2. Art. 3(2) Enforcement Directive may not be read as broadly as to provide for a general precondition of proportionality to any cease and desist claim of the rightholder. Art. 3(2) Enforcement Directive is directed at Member States implementing the Enforcement Directive and is not aimed at individual applications.
3. The German statutory law complies with the requirements of the Enforcement Directive read in light of TRIPS, because it limits injunctions only in extreme

⁸² Büscher-McGuire, UWG, Heymanns 2019, § 2 GeschGehG, paras. 13 et seq.

cases such as abuse of rights. Proportionality is further guaranteed by the functioning of the legal system as a whole.

4. A general proportionality assessment before granting an injunction would amount to a restriction of the patent holder's exclusivity right. Such restriction must meet the standards provided for in Art. 30 TRIPS, calling for exceptions to be "limited". A general proportionality requirement in the granting of an injunction would have to be considered unlimited because it requires a weighing of all interests concerned on a case by case basis. It would make it unpredictable for the patent holder whether it will be possible to effectively enforce the exclusivity right against the infringer. This violates the principle of legal certainty.

5. A general proportionality requirement would disturb the balance of the patent system as a whole.

6. If the German legislator *de lege ferenda* was to amend the law in order to include a proportionality requirement for injunctions such amendment must especially comply with the requirements of Art. 30 TRIPS to provide only for "limited" exceptions.

Zusammenfassung

Gegenstand lebhafter Diskussion in Deutschland ist derzeit die Frage, ob der Unterlassungsanspruch einem Verhältnismäßigkeitsvorbehalt unterworfen werden sollte. Wird aus Patenten auf einzelne Komponenten gegen den Vertrieb ganzer komplexer Systeme vorgegangen, so wird die Rechtsdurchsetzung teilweise als unbillige Härte empfunden. Hier soll eine einzelfallbezogene Interessenabwägung und Verhältnismäßigkeitsprüfung Abhilfe schaffen.

Der vorliegende Beitrag argumentiert auf der Grundlage des geltenden Rechts gegen eine solche Verhältnismäßigkeitsprüfung. Aus internationalen Rechtsgrundlagen kann eine entsprechende Anspruchsvoraussetzung nicht abgelesen werden. Insbesondere schreibt Art. 3 Abs. 2 Durchsetzungsrichtlinie keine solche vor: der einschlägige Teilsatz ist an die Mitgliedsstaaten gerichtet und stellt keine Voraussetzungen für die konkrete Anwendung durch die Gerichte auf. Zudem wird die Forderung nach einer Verhältnismäßigkeit von Rechtsbehelfen (u. a.) dadurch einer Abwägung unterworfen, dass sie zugleich wirksam und abschreckend sein müssen. Dies betont die Position des Rechtsinhabers.

Das geltende deutsche Recht entspricht diesen Vorgaben, da es Verhältnismäßigkeitsabwägungen in Grenzfällen wie etwa bei Rechtsmissbrauch zulässt und zudem durch die Funktionsweise der Gesamtrechtsordnung, insbesondere bei der vorläufigen Vollstreckbarkeit von Urteilen, den Ausgleich der betroffenen Interessen sicherstellt.

Eine weitergehende Auslegung von Art. 3 Abs. 2 Durchsetzungsrichtlinie im Sinne eines allgemeinen Verhältnismäßigkeitsvorbehalts würde gegen Art. 30 TRIPS verstoßen, wonach nur ‚begrenzte‘ Ausnahmen zu den durch das Patent gewährten Ausschließlichkeitsrechten zu gewähren sind. Ein genereller Verhältnismäßigkeitsvorbehalt in Bezug auf die Gewährung eines Unterlassungsanspruchs würde dieses Kriterium schlechterdings nicht

erfüllen. Ein solcher würde die Durchsetzung der Rechte aus dem Patent unkalkulierbar machen und damit die Rechtssicherheit beeinträchtigen.

Wollte der deutsche Gesetzgeber *de lege ferenda* dennoch einen Verhältnismäßigkeitsvorbehalt einziehen, so wäre die gesetzliche Regelung eng auszugestalten, und von vornherein auf bestimmte vordefinierte Fallkonstellationen zu begrenzen. Nur so kann den Vorgaben von Art. 30 TRIPS entsprochen werden.

