

Proving patent infringement in Germany fast and effectively

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Obtaining information and evidence on the facts establishing patent infringement – in particular the realization of all features of the asserted patent claim in suit by the attacked product – is the key to successful patent litigation. In most cases, German civil procedural law provides for satisfying means in this respect. However, in some cases, particularly with regard to method claims, difficulties can arise. In such cases, recent German case law has developed towards US standards and allows for a “limited discovery” by having established an extensive right of the right holder to inspection of an object, in particular of an infringing product. This right to inspection may be enforced by a preliminary court order within only a couple of weeks or months as a quick, early and inexpensive test prior to a full-blown infringement action.

No difficulties in regular cases

According to German civil procedural law, the burden of proof for the facts establishing infringement rests with the right holder. Courts cannot investigate these facts on their own motion. The defendant is – in principle – not obliged to contribute to plaintiff’s fact finding. Thus, the right holder

generally has to positively establish that every single feature of his patent claim is used by the attacked product or method.

In view of these principles, but also as a matter of fairness and equity, German civil procedural law provides for a system of stepwise “substantiated” allegation and contestation of the relevant facts. Accordingly, plaintiff has to present the facts underlying his claim in a “substantiated”, i.e. reasonably detailed manner, which also allows to make statements based on opinion and belief and does not require to file “hard” evidence for any relevant fact. If defendant aims to contest such substantiated allegations of plaintiff, he is obliged to present the disproving facts in an equally substantiated manner. The – finally required – degree of substantiation of plaintiff therefore depends on the degree of substantiation of the contestation of the presented facts by defendant. In other words: There is an interplay with regard to the statements of both parties – the more detailed plaintiff’s statements are, the more detailed defendant has to disprove these statements. Since it is illegal and liable to prosecution for either party to lie to the court, the right holder lacking sufficient publicly available information with regard to some features of the asserted patent claim can consequently force the alleged infringer to admit or produce substantial and detailed information with regard to these features, by just

stating the only presumed way of realization of these features in plausible detail. This approach is particularly recommendable, if said presumed way of realization is considered to be likely, and may finally – depending on the outcome of defendant’s statements – allow for proving infringement successfully without a need for further evidence. Furthermore, depending on the individual case, in particular on the likelihood of infringement and the involved interests in secrecy, the burden of substantiation may – with regard to some features – exceptionally shift to the alleged infringer, provided that the facts in dispute have occurred in his sphere, that these facts were not justly detectable for the right holder and that a disclosure of these facts is reasonable for the alleged infringer.

Independently thereof, the recent amendment of sections 142 and 144 of the German Civil Procedural Code in the course of a 2002 reform has further strengthened the position of the right holder: The court may – within its own discretion and independently from the burden of proof – order the submission of a document by defendant or by a third party, for example a technical manual of the attacked product, even if it is not publicly available, provided that one party (i.e. also plaintiff!) has cited said document in general terms. The court may correspondingly order a visual inspection or a court expert opinion of the attacked product. Although the



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court cannot force the obliged party to submitting a document or to giving access to the attacked product, the court may negatively evaluate a refusal – up to assuming infringement.

Thus, in regular cases, German civil procedural law allows for proving infringement fast and effectively even if plaintiff initially lacks some of the necessary information.

Recent German case law – “limited discovery” by enforcement of a right to inspection

For cases in which the aforementioned means would not be sufficient, the recent German case law has established an extensive right of the right holder to an inspection of an object according to section 809 German Civil Code which, interpreted in the light of the TRIPS Agreement, allows for collecting the necessary information and evidence with regard to infringement. This right to inspection extends to all objects and to those of their properties on which a claim for infringement may depend, for example to the presumed infringing object itself as well as to corresponding technical manuals, design drawings, pictures or devices with which a presumed infringing method is performed. Since May 2002, when the German Federal Supreme Court



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rendered the landmark decision “Fax Card” and thereby rejected the former restraining standards set by its decision “Print Bar” of 1985, the right to inspection no longer generally requires a “high degree of likelihood” of infringement, but – depending on the individual case, in particular on any potentially involved company secrets of defendant – may only require a “certain likelihood” of infringement.

Correspondingly, an intrusive inspection, which might even destroy or impair the object, may be allowed, since defendant can be protected by a damage claim and corresponding security bond.

Procedurally, such an inspection may be ordered and executed without prior oral hearing. The object may be seized upon request for a corresponding preliminary injunction (this being the difference to and advantage over the inspection order according to section 144 German Civil Procedural Code). Typically, the inspection is executed by an independent court-appointed expert in presence of plaintiff’s attorneys. The court expert delivers a written description as well as, if needed, pictures of the inspected object to the court. For protecting defendant’s company secrets, all persons involved in the inspection are sworn to secrecy

until defendant has had the opportunity to bring forward his respective arguments in a post-inspection oral hearing. According to the recent practice of the District Court of Düsseldorf, the right holder may obtain the written description within only a couple of weeks or months by requesting a so-called independent evidentiary procedure at reasonable cost exposure. Since it is not required that an infringement action is already pending, the enforcement of a claim for inspection may also be of substantial value for those right holders who want to attain maximum certainty about a potential infringement before deciding whether or not to file an infringement action.

Conclusion

In summary, German law still lacks extensive, general US style discovery, but recently has adopted instruments for discovering the properties of products suspected of patent infringement. This provides for satisfying, i.e. fast, effective, and inexpensive means for obtaining the necessary information and evidence on infringement during or prior to a patent infringement action. Unlike in the US, this German “limited” discovery does not bind any large part of the workforce and resources of the parties over an extended period of time, and is unlikely to involve comparable costs. ■



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