

Higher Regional Court Dusseldorf: No sufficiently secure legal existence of the patent for injunction after revocation of the parent patent in a generic drug case

Higher Regional Court Dusseldorf, decision of. 23 February 2023 - Ref. 15 W 14/21

In its decision of 23 February 2023 (Case No. 15 W 14/21), the 2nd Civil Senate of the Higher Regional Court Dusseldorf ruled that the grant of the patent for an injunction, which came about with the participation of a third party, does not justify an injunction even in a generic drug case if it is opposed by a revocation decision of the Opposition Division on the parent patent with the same content.

I. The facts

The Plaintiff in the injunction proceedings is the proprietor of the German part of a European patent on a pharmaceutical composition for the treatment of multiple sclerosis. A pending opposition has not yet been decided. The parent patent was revoked by the Opposition Division of the EPO in opposition proceedings brought by ten opponents, including the Defendant. The appeal against this decision was rejected by the Technical Board of Appeal. The revoked parent patent is largely identical in content to the patent in suit.

The Regional Court Dusseldorf dismissed the application for a preliminary injunction because the legal validity was not secured. The grant of the patent in suit and the decision of the Board of Appeal were in an irresolvable contradiction.

The Higher Regional Court Dusseldorf confirmed the decision of the Regional Court and dismissed the appeal as unfounded.

II. About the decision

The Higher Regional Court Dusseldorf ruled that a preliminary injunction based on a claim for injunctive relief under patent law can only be issued if the existence of the patent in suit can be answered so unambiguously that an erroneous decision is not seriously to be expected. In

principle, this can only be the case if the patent in suit has survived opposition or nullity proceedings in the first instance.

An exception to this is made if there are circumstances in which the patent proprietor is particularly worthy of protection. This is usually the case. For while the damage caused by an injunction that has not been issued is often enormous and frequently irreparable in the event that the patent is subsequently upheld, an injunction that subsequently proves to be unjustified only has the effect that the opposing generic company has been temporarily and unjustifiably kept out of the market. In this case, the weighing of interests is clearly in favor of the patent proprietor, since the opposing generic company does not regularly have to take any economic risks of its own for its market presence.

The Higher Regional Court Dusseldorf admitted that this was such a generic product case and that, in principle, an order should therefore also be issued if there was no final certainty as to the legal status. However, in this case, the negative disputed decision on the existence of rights precludes the assumption of a secured existence of rights. This also applies to a parent or parallel patent if - as here - the arguments regarding the destruction of the property right can be transferred to the patent in suit. The issuance of the interlocutory injunction precludes the decision of the Opposition Division of the EPO, which, compared to the Examining Division, is the higher-ranking body and is technically competent.

Due to the given circumstances, a discussion of the ECJ decision of 28 April 2022, Case C-44/21 - Phoenix / Harting, according to which a restrictive case law that an preliminary injunction could only be issued after opposition or revocation proceedings in the first instance would violate Art. 9 (1) lit. a of Directive 2004/48, was not necessary.

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