



STUDIO
LEGALE E TRIBUTARIO

Preliminary Injunction - a German perspective -

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Preliminary injunction in Germany – important fairs

Speed is often imperative if an infringing product is launched on the market.

International trade fairs in Germany lead to urgent cases under German Law

- **IAA**, Frankfurt
- **CeBit**, Hannover
- **ISPO**, München
- **Bauma**, München
- **ANUGA**, Köln



I. Pre-litigation strategy

1. Authorization Enquiry
2. Warning letter

II. What can be achieved with a preliminary injunction?

III. Protective (anticipatory) brief

IV. Requirements for a preliminary injunction

1. Claim to an injunction
2. Grounds of an injunction

Preliminary injunction in Germany – Pre-litigation strategy

I. Pre-litigation strategy

Before filing the action, the right holder may try to reach an out-of-court settlement.

1. Authorization Enquiry (*Berechtigungsanfrage*)

If the right holder has doubts as to whether the alleged infringer has been authorized to or is legitimately using a given design/trademark, it is prudent to request evidence thereof



Preliminary injunction in Germany – Pre-litigation strategy

2. Warning letter (*Abmahnung*) and cease and desist undertaking

- asking the infringer to cease and desist from the alleged infringement (e.g. using the sign, offering goods concerned for sale with the sign, import, export), to interfere with the right holder in future, to recognize claims for infringement (damages, rendering of accounts, destruction).
- penalty for each breach of cease and desist undertaking



Preliminary injunction in Germany – Pre-litigation strategy

2. Warning letter (*Abmahnung*) and cease and desist undertaking

- main purposes of a warning letter:
 - to try to avoid litigation
 - to avoid the cost risk. -> According to § 93 ZPO (German Code of Civil procedure), the plaintiff shall pay the defendant's costs if the defendant acknowledges the claim straight away in a subsequent litigation and the right holder did not send a warning letter prior to filing the action.



Preliminary injunction in Germany – what can be achieved with a preliminary injunction?

II. What can be achieved with a preliminary injunction?

- The enforcement of the cease-and-desist claim quickly
- The rights owner can request information about the origin of the infringing product and its distribution channels.
- The claim for damages and/or rendering of accounts in preparation for the damages claim cannot be asserted.
- In order to secure the right to destroy infringing goods a safe custody by the bailiff can be ordered by the court in order to prevent their sale or delivery.
- The destruction of the infringing goods requires a subsequent order by a court.



Preliminary injunction in Germany – Protective (anticipatory) brief

III. Protective (anticipatory) brief

The effectiveness and danger of p.i. lie in the surprise effect when there are issued ex parte.

- has no legal grounds.
- to ensure that an oral hearing is held and that the opponent's defence arguments are taken into consideration.
- sets out all the defence arguments that could prevent the issuance of a p.i.
- they are submitted, without reference to any existing, pending proceedings, to the courts which are likely to receive injunction claims.
- since 01.01.2016 all courts have access to a central register (= *Zentrales Schutzschriftenregister*).

Preliminary injunction in Germany – Requirements for a preliminary injunction

IV. Requirements for a preliminary injunction

1. Claim to an injunction

- the claimant must “substantiate by prima facie evidence” that the right has been infringed (claim to an injunction).
- this does not require full evidence. As means of substantiation any evidence is permissible that can be put before or presented to the court at the oral hearing.
- in particular reference may be made to affidavits (unlike in principal proceedings).



Preliminary injunction in Germany – Requirements for a preliminary injunction

2. Grounds for an injunction, §§ 935, 940 German Code of Civil procedure (=ZPO)

- urgency with respect of time (“*Dringlichkeit*”)
- the claimant must show that he has reacted as quickly as possible to the infringement.
- there is no absolute time limit.
- the claimant should not wait more than 30 days from the time he obtains certain knowledge of the infringement.
- on the question of urgency, rulings by the competent district courts can differ quite considerably.





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