

Patent Enforcement – Preliminary and Permanent Injunctive Relief in Germany, Japan and the U.S.

Research Project

Investigator:

Christoph Rademacher

Abstract:

A patent confers on its holder the right to exclude others from the use of the invention protected by the patent. During the modern history of patent law, a patentee's claim for permanent injunctive action has therefore been widely perceived as the logical consequence of a patent infringement. Such understanding changed fundamentally in the U.S., when the Supreme Court handed down its judgment in the matter *eBay, Inc. v. MercExchange, LLC* (547 U.S. 388 (2006)) in 2006 and created a four-factor test as a requirement for granting a permanent injunction, requiring the plaintiff to show

- (1) that it has suffered an irreparable injury;
- (2) that remedies available at law are inadequate to compensate for that injury;
- (3) that considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and
- (4) that the public interest would not be disserved by a permanent injunction.

Following the Supreme Court's decision, especially those patentees who were not actively exploiting their patents in a manufacturing process, but rather aimed to generate license fees by licensing patented technology to manufacturing companies faced difficulties obtaining injunctive relief. Having said so, a parallel path for obtaining injunctive relief remains in those circumstances when the patent infringer imports the infringing goods. In this scenario, a patentee can obtain an exclusion order at the International Trade Commission (ITC) without being subject to the four-factor test established by the Supreme Court.

This paper will review the application of the four-factor test in U.S. district court proceedings conducted in the aftermath of *eBay*. Also, it will question the different treatment of patent infringers in district courts and at the ITC. It will compare the prerequisites of the claim for injunctive relief in the U.S. with those in Germany and Japan, where leading patent courts continue to affirm the almost absolute right of the patentee to obtain a permanent injunction against an infringer. After comparing the scope and requirements for the permanent injunction, this paper will illustrate the additional requirements a plaintiff has to overcome when seeking preliminary injunctive relief in a patent proceeding in Germany, the U.S. or in Japan.