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Federal Constitutional Court rejects appeals concerning the European Patent Office

The Federal Court of Justice on the examination of nullity actions – Verbindungselement

MICHALSKI HÜTTERMANN

PATENT ATTORNEYS

Federal Constitutional Court rejects appeals concerning the European Patent Office

After the Federal Constitutional Court had already cleared the way for the unitary patent system in 2021,[1] the second outstanding decision[2] on the European patent system has now also been issued and the European Patent Office in particular will be relieved: The complaints have been rejected.

This is not necessarily surprising, as the Federal Constitutional Court had already rejected similar complaints before,[3] but some observers[4] had thought there was a chance that this time it could be different, especially due to the conduct[5] of former President *Battistelli*.

Battistelli, however, can feel vindicated in hindsight, however, because the Federal Constitutional Court made it clear, among other things, that any deficits would have been eliminated at the latest since the structural reforms he initiated:

"These deficits – which the appellants do not elaborate on – are likely to have been remedied by the structural reform that came into force on July 1, 2016, which unbundled the administrative and judicial functions and made the judicial function of the Boards of Appeal institutionally largely independent, in the result at least to such an extent that an overall view does not (any longer) support a shortfall of the minimum level of effective legal protection."[6]

The decision itself is unusually long (180 paragraphs) and will certainly provide material for discussion. As a result, however, the Federal Constitutional Court has confirmed the existing system; the fact that one day before publication of the decision the judge-rapporteur[7] of the first (and successful) constitutional complaint against the unitary patent system, Prof. Dr. Huber, left the court[8] is perhaps a coincidence, but fits the picture.

In Our Own Affairs

Wasilis Koukounis will lecture at the BECK course "Einheitspatentrecht" (Unitary Patent Law) of the BeckAkademie, which will take place from February 13 to 14, 2023.

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[1] Cf our Newsletter 9/2021, the final decision was issued in July 2022 https://www.bundesverfassungsgericht.de/SharedDocs/Entscheidungen/DE/2022/07/rs20220713_2bvr221620.html;jsessionid=BAE610D33D6D3DD4D9DC08B3BDF70AA1.2_cid344

[2] Constitutional Complaints 2 BvR 2480/10, 2 BvR 421/13, 2 BvR 786/15, 2 BvR 756/16, 2 BvR 561/18

[3] BVerfG: Beschluss vom 28.11.2005 - 2 BvR 1751/03, BVerfG,Beschluß vom 4. 4. 2001 - 2 BvR 2368/99, GRUR 2001, 728

[4] cf Vissel, GRUR Int. 2019, 25, or http://patentblog.kluweriplaw.com/2020/01/18/whats-the-worst-that-could-happen-constitutional-complaints-against-the-epo-in-germany/ more decisive http://patentblog.kluweriplaw.com/2017/05/25/rule-law-epo-ugly-writing-wall/

[5] Cf here http://patentblog.kluweriplaw.com/2018/06/21/tarnished-legacy-epo-president/

[6] Cf. the press release of the court, the full text (in German) can be found here: https://www.bundesverfassungsgericht.de/SharedDocs/Pressemitteilungen/DE/2023/bvg23-004.html

[7] Cf here: https://www.juve-patent.com/news-and-stories/people-and-business/straight-shooter-the-judge-behind-the-german-upc-decision/8

[8] Cf. the press release of the court, https://www.bundesverfassungsgericht.de/SharedDocs/Pressemitteilungen/DE/2023/bvg23-003.html

The Federal Court of Justice on the examination of nullity actions – Verbindungselement

In the recently published decision "Verbindungselement"[9] (connecting element), the Federal Court of Justice had the opportunity to comment on the minimum requirements in nullity proceedings, in particular the - in practice, however, very rare – case that the patent proprietor does not respond to the invitation under Sec. 82, para. 1 Patent Act.

The subject matter of the proceedings was a German patent on a connecting pipe between a single fireplace and a chimney. Initially, there had been an opposition, which, however, had been withdrawn shortly after filing; the DPMA had initially pursued the proceedings, but then rejected the opposition.

A few years later, there was then a nullity action in which essentially the same prior art was put forward, the main subject matter being product catalogs, i.e. documents for which the actual date and the question of whether and when they were available to the public are often the subject of discussion.

Pursuant to Sec. 82 (1) Patent Act, a request had been issued to the representative of the patent proprietor entered in the register to explain himself. However, there was no reaction here, so that a few months later a decision was made on the action in oral proceedings. However, a substantive examination of the patentability took place, but according to §82, para. 2, the facts submitted by the plaintiff, i.e. the product catalogs, were accepted as proven and classified as prior art.

The patent proprietor, who had changed representatives in the meantime, then appealed.

The Federal Court of Justice now stated:

- First, it is irrelevant whether the patentee herself became aware of the action if the representative entered in the register received the action. However, this is not really a surprise.

- Secondly, and this is the really interesting part of the decision, the Federal Court of Justice clarifies that a failure to respond to the request under §82 does not mean that – similar to a judgment by default - only a conclusiveness check is to be carried out. Likewise, nullity proceedings are precisely not trademark or utility model cancellation proceedings, where immediate cancellation takes place after the property right owner has failed to respond. Instead, a complete examination of patentability is necessary; the only examination that is no longer necessary is that of the facts presented:

"The decision under Sec. 82 (2) Patent Act requires a factual review of the pleading. Only the factual allegations of the plaintiff are to be assumed as correct. The legal examination on the basis of these allegations, on the other hand, must be carried out in the same manner as in contentious proceedings.

This examination also includes the assessment of the question whether a citation or a prior use to be assumed as true on the basis of the pleading discloses or suggests the subject matter of the patent in suit."[10]

In Our Own Affairs

We wish your relatives, employees, colleagues and of course yourself all the best for the present, still difficult time.

[9] BGH, Decision of 6 December 2022 - X ZR 120/20 - Bundespatentgericht
[10] Para 50 of the decision

- It then follows from this conclusion that an appeal is, of course, possible, in which the result of the first judgment may be challenged:

"This assessment is subject to review on appeal."[11]

In the end, however, the Federal Court of Justice came to the same conclusion as the Federal Patent Court after a detailed examination of the facts, i.e. the patent remained revoked.

This ruling shows once again how important it is to keep the registers up to date, even for patents that have granted years ago- the one-month period under Art. 82 PatG is not long, and if a nullity action is served to a representative who no longer works for the patent proprietor at all, this representative is obliged under professional law to forward the action, but time delays will inevitably occur. This is all the more true if the owner entered in the register is not the real owner at all.

For the coming unitary patent system, this necessity is even more important because of the wider scope of a judgment.

As a side issue, it is interesting to ask why the new representative did not try to save the patent in the alternative; the chance that such an alternative application would have been allowed is not great, but it would have been worth a try. According to the judgment, however, there seem to have been no such applications - but perhaps the attainable scope of protection would have been too small, so that such an application would not have been worthwhile either.

[11] Para 50 of the decision

Impressum:
Michalski · Hüttermann & Partner
Patentanwälte mbB

Kaistrasse 16A
D-40221 Düsseldorf
Tel +49 211 159 249 0
Fax +49 211 159 249 20

Hufelandstr. 2
D-45147 Essen
Tel +49 201 271 00 703
Fax +49 201 271 00 726

Perchtinger Straße 6
D-81379 München
Tel +49 89 7007 4234
Fax +49 89 7007 4262

De-Saint-Exupéry-Str. 10
D-60549 Frankfurt a.M.
Tel +49 211 159 249 0
Fax +49 211 159 249 20

Am Rathaus 2
D-42579 Heiligenhaus
Tel +49 2056 98 95 056

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