

Older right as a defence?

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With a judgement of 12 February 2009 the German "Bundesgerichtshof" has dealt with the question whether defendant of a patent infringement action shall be allowed to defend against the claims raised by a patent owner by pointing to another patent which is older than the litigious patent and by further saying that this older patent grants the right to perform the allegedly patent infringing activities.

The "Bundesgerichtshof" held that an older patent may grant a "defence-right" against the claims which are derived from a younger patent. The court further held that defendant of a patent infringement action can point to such an older patent right even if defendant is merely entitled to the older patent via a licence-agreement. The court did not decide the question whether the "defence-right" depends on the question whether the subject matter of the older patent is used or whether it is sufficient that the used (and allegedly patent infringing) product is covered by the scope of the older patent. The court could let this question undecided because the court's ratio decidendi is as follows: an older patent does only give a "defence" to the defendant of a patent infringement action if the technical teaching of the older patent is being used and if additional features which are taught by the younger (litigious) patent are not being used. Otherwise an older patent would entitle its owner or licensee to use all depending inventions what is clearly beyond the exclusive right granted by the older patent.

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