

Germany - late filing of new prior art can be too late

Kluwer Patent Blog
August 6, 2015

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Please refer to this post as: Hetti Hilge, 'Germany - late filing of new prior art can be too late', *Kluwer Patent Blog*, August 6, 2015, <http://patentblog.kluweriplaw.com/2015/08/06/germany-late-filing-of-new-prior-art-can-be-too-late/>

The Oberlandesgericht Düsseldorf (Higher Regional Court, appeal instance) just issued a court order on the admissibility of new prior art that the defendant discovered only in the second instance infringement proceedings. The defendant and appellant in the proceedings had requested a stay of the infringement appeal based on this new and relevant prior art until a decision in the parallel invalidity action will be rendered. Irrespective of the admissibility of the new citation in the parallel invalidity action, the infringement appeal court requested the defendant to provide sufficiently justified reasons for the late filing in order to admit the new citation.

Pursuant to the formal rules on civil procedure, a new defense in appeal proceedings is only admissible under specific and exceptional circumstances, one of them being that the defendant did not act negligently by not raising the defense in the first instance (sec. 531 (2) first sentence No. 3 German Code of Civil Procedure). The court applied this rule and further applied the corresponding requirements for the admissibility of new prior art in nullity appeal proceedings as set out in the Bundesgerichtshof decision *Tretkurbeinheit* (German Federal Court of Justice, judgment of 27 August 2013, [X ZR 19/12](#); English translation published in IIC 2014, 457 - Bicycle Crank Arm Apparatus) even though the new prior art, in this case, would clearly still be admissible in the parallel invalidity action which is only pending in the first instance. The appellant in particular has to demonstrate that and why an appropriate selection of the search profile for the search carried out to justify the nullity action would not have revealed the citation.

Applying this standard to infringement appeal proceedings, the Higher Regional Court Düsseldorf sets out in its order that the filing of new prior art in the second instance may be inadmissible if an appropriate search has not been conducted in the first instance. The defendant has the burden to demonstrate if, how (e.g. selected search profile) and when it conducted a search, or the reasons why such a search would not have been required by a diligent party in the first instance.

As a consequence, defendants risk an injunction by the appeal court which is directly enforceable if they cannot demonstrate that they carried out an appropriate search in time even though they may later succeed in the nullity action against the patent based on newly discovered prior art.

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