

Kluwer Patent Blog

Of Mice and Elephants

Thomas Musmann (Rospatt Osten Pross) · Thursday, September 30th, 2010

In this blog I report about how the Bundesgerichtshof (BGH) has recently eliminated some potential for conflicting decisions in Germany's bifurcated patent litigation system.

The separation of infringement and invalidity proceedings is the basis for what we call the "mouse and elephant strategy". In the infringement proceedings the patentee tries to establish a scope of protection of the size of an elephant and in the nullity proceedings the same patentee tries to establish a scope of protection of the size of a mouse. If he patentee succeeds, he can – in the extreme – achieve that the infringement court finds an embodiment which is within the prior art to be infringing the patent and that the nullity court confirms validity of the same patent because the prior art is outside the scope of protection of the patent.

Since it is established case law that claim construction must be the same in nullity proceedings and infringement proceedings (BGH X ZR 7/00 – blasenfreie Gummibahn I), this strategy is prone to fail if the infringement and the nullity action both proceed to the BGH level (the BGH is both the final instance for the nullity case as well as the final instance for the infringement case).

In nullity cases the BGH is the appeal court and an appeal to the BGH is always admissible. The problem for defendants is that infringement actions only reach the BGH level if either the Court of Appeals or the BGH admits the revision of the appeal court decision. According to the statute revision should, however, only be admitted, if either legal issues which are of general relevance are decisive for the case or if the appellate decision is based on an interpretation of law which diverges from the interpretation of the law in a previous decision by another Appeal Court (divergent decisions). Under this standard an appellate decision based on a false construction of a patent is not eligible to be admitted for revision.

Fortunately, this is not the end of the flagpole. The BGH has opened two alleys one of them in a very recent decision. The procedural basis for those BGH decisions is what is called a Nichtzulassungsbeschwerde (non admission complaint) to the BGH by which the losing party (requestor) asks the BGH to accept the revision:

In a first decision the requestor argued that there was an imminent risk of divergent decisions because a nullity action was pending. If the patent was restricted or revoked in the future decision the appellate infringement decision based on the patent before revocation or restriction would be diverging from this decision. The BGH accepted that argument and decided to stay the non admission complaint pending the final outcome of the nullity action (BGH X ZR 272/02 – Druckmaschinen-Temperierungssystem). It did so based on the finding that the nullity action had

sufficient prospects to succeed. If subsequently the patent will be maintained without (relevant) limitations the non admission complaint will be rejected otherwise the BGH will accept the infringement case for revision.

But what if the patent isn't revoked or limited in scope but upheld based on a narrow claim construction (mouse scope of protection) whereas the Appeal Court's infringement decision is based on an elephant scope of protection?

In the second decision the BGH has accepted the infringement case for revision based on the different claim construction in the nullity decision and the infringement decision (decision of 30 August 2010 in re X ZR 193/03 – Crimpwerkzeug IV). The BGH had upheld the patent in its final decision in the nullity proceedings based on a claim construction which was irreconcilable with the infringement decision of the Appeal Court. The BGH is now expected to reverse the Appeal Court decision or remand it to the Appeal Court ordering it to base its decision on the claim construction as laid out in its final decision in the nullity case.

As a result of the reported decisions, the defendant can now avoid a final decision in the infringement proceedings until a final decision in the nullity proceedings is taken and can achieve that the infringement proceedings will be continued on the basis of the construction adopted by the BGH in the nullity proceedings if under that construction the attacked embodiment is not covered by the patent. Thus, it is now in the hands of defendants to counter the “mouse and elephant strategy” but that will require a lot patience and a little bit of money.

Max v. Rospatt

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