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Restriction of Patent Claims in German Infringement Proceedings

Eike Schaper · Thursday, December 30th, 2010 · Landmark European Patent Cases

What happens in Germany's bifurcated patent litigation system, if – during pending infringements proceedings – the nullity court declares the patent partly invalid?

The patentee can amend its infringement action accordingly. The infringement action is then based on the patent claim as amended by the nullity court, and not on the patent claim as initially granted. The German Federal Court (BGH) decided that such an amendment of an infringement action is possible, even if the decision of the nullity court is appealed and not yet legally binding (judgement of 6 Mai 2010, [Xa ZR 70/08 – Maschinensatz](#)). This confirms common practice of the Duesseldorf Court of Appeal (cf. judgement of 21 Dec. 2006, [2 U 58/05 – Thermocycler II](#)).

The patentee may even file a patent infringement action based on a restricted patent claim – without having filed such a restricted claim with the patent office. This was already established case law for utility models (cf. BGH, judgement of 13 May 2006, [X ZR 226/00 – Momentanpol I](#)), and has now been confirmed for patents. A patent infringement action can therefore be based on a restricted patent claim although the patent has been granted with a broader claim.

The restricted patent claim is then also relevant for the question whether the infringement proceedings are stayed until the nullity court has decided about the validity of the patent. Usually, German courts apply very strict standards to the stay of infringement proceedings. They are stayed if there is no reasonable argument to uphold the patent, in particular due to novelty-destroying prior art which has not been reviewed during prosecution. If the infringement action is based on a restricted patent claim, the infringement court must further verify whether such a restriction is admissible in nullity proceedings when deciding about the stay of the infringement proceedings.

Even if the wording of the patent claim is identical, a different claim construction in infringement and nullity proceedings would lead to conflicting decisions: The patentee often tries to establish a scope of protection of the size of an elephant in the infringement proceedings, and a scope of protection of the size of a mouse in the nullity proceedings. This risk of conflicting decisions in Germany's bifurcated patent litigation system due to different claim construction in infringement and nullity proceedings was recently limited by another judgement of the German Federal Court – as explained by Max v. Rospatt in his blog "[Of Mice and Elephants](#)".

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This entry was posted on Thursday, December 30th, 2010 at 1:00 am and is filed under [Germany](#), [Procedure](#), [Scope of protection](#), [Validity](#)

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