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How far does the duty to provide information in patent nullity proceedings go?

Thomas Musmann (Rospatt Osten Pross) · Friday, November 22nd, 2013

by Stefan Lieck

Based on the act for simplification and modernization of Patent Law (“Patentrechtsmodernisierungsgesetz”) patent nullity proceedings in Germany have been reformed fundamentally in order to accelerate the appeal proceedings significantly. Therefore, the Federal Patent Court (“Bundespatentgericht”) that is responsible in the first instance shall determine the facts of the case exclusively whereas the Federal Court of Justice (“Bundesgerichtshof”) which is responsible in the appeal proceedings is generally limited to deal only with the legal issues of the case.

To determine the facts of the case the Federal Patent Court shall provide the parties with information on the relevant validity issues prior to the oral hearing. After that the parties may file their final comments including further pleas within a deadline set by the Federal Patent Court, Sec. 83 para. 2, 4 of the Patent Act. These rules are accompanied by Sec. 117 of the Patent Act under which the Federal Court of Justice is prevented from considering new facts in the appeal proceedings unless the party is able to prove that the delay is not based on negligence.

In its decision “Mischer-Befestigung” of August 8, 2013 (docket number X ZR 36/12) the Federal Court of Justice had to deal with the interplay between Se. 83 and Sec. 117 of the Patent Act: Originally, the plaintiff had attacked merely subclaims 3 and 4 of the patent in suit, but failed to attack also main claim 1. After the Federal Patent Court had indicated vis-à-vis the plaintiff according to Sec. 83 para. 1 of the Patent Act prior to the oral hearing that the nullity action would therefore be rejected, the plaintiff amended its action by attacking also main claim 1 and by introducing its citations only at that point. During the oral hearing the Federal Patent Court pointed out that the court does not agree with the opinion of the plaintiff so that the patent in suit was maintained.

In the appeal proceedings the plaintiff then referred to a new citation which was not filed in the first instance. The Federal Court of Justice rejected to consider this citation according to Sec. 117 of the Patent Act as the plaintiff did not prove that the lack of a prior submission was not based on negligence. Furthermore, the Federal Court of Justice hold that the Federal Patent Court was not obliged to provide the plaintiff with its negative opinion with regard to the submitted citations after its prior indication.

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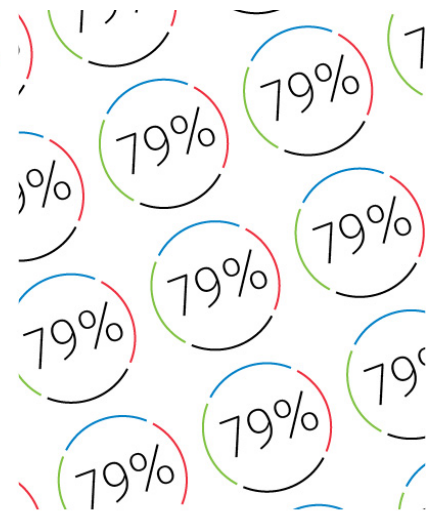
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