



# Nullity Proceedings in Germany

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***Four things belong to a judge:  
to hear courteously,  
to answer wisely,  
to consider soberly,  
and to decide impartially.***

SOCRATES (470/469 -399 BC)  
classical greek philosopher

# Tasks and Status of the Patent Court



## FEDERAL PATENT COURT

### ACTIONS

nullity of:

- ✓ national patents
- ✓ European patents
- ✓ supplementary protection certificates

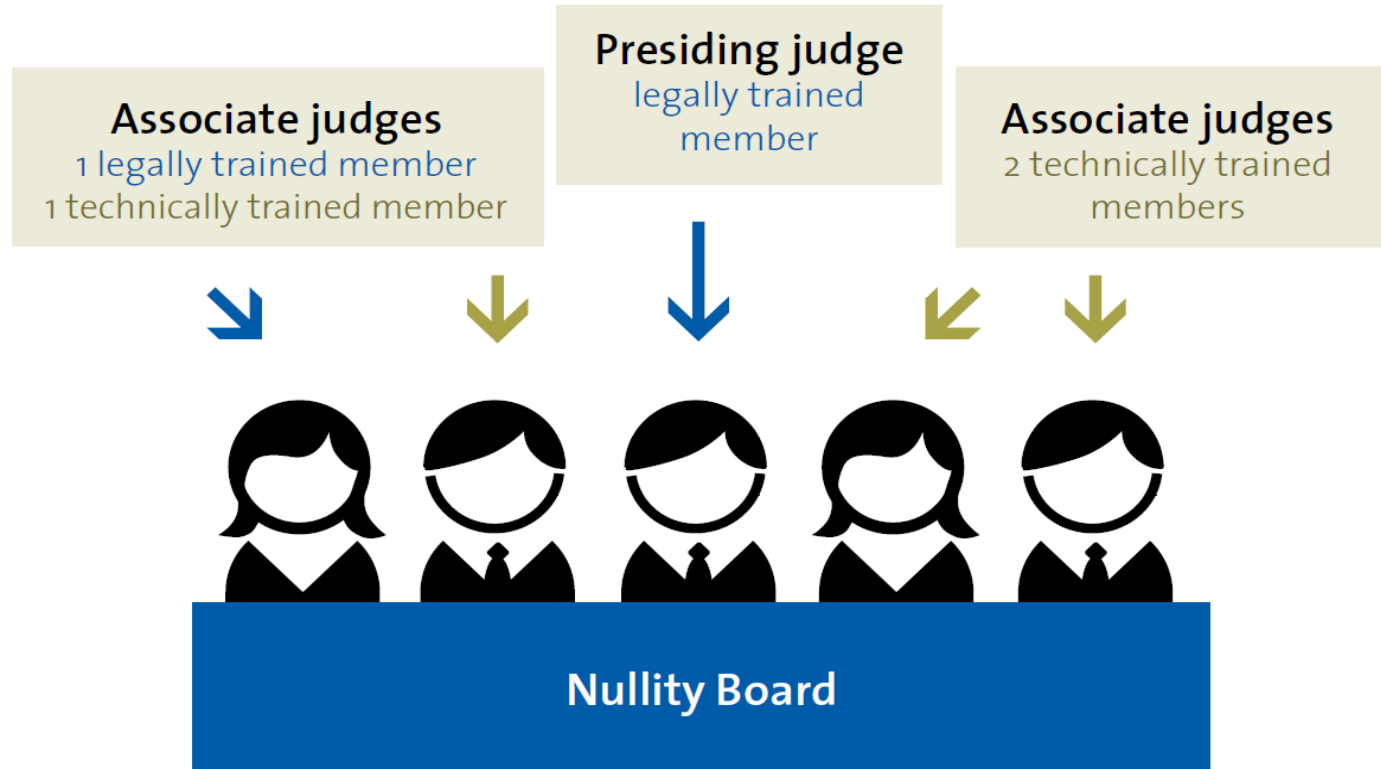
compulsory licences

### APPEALS

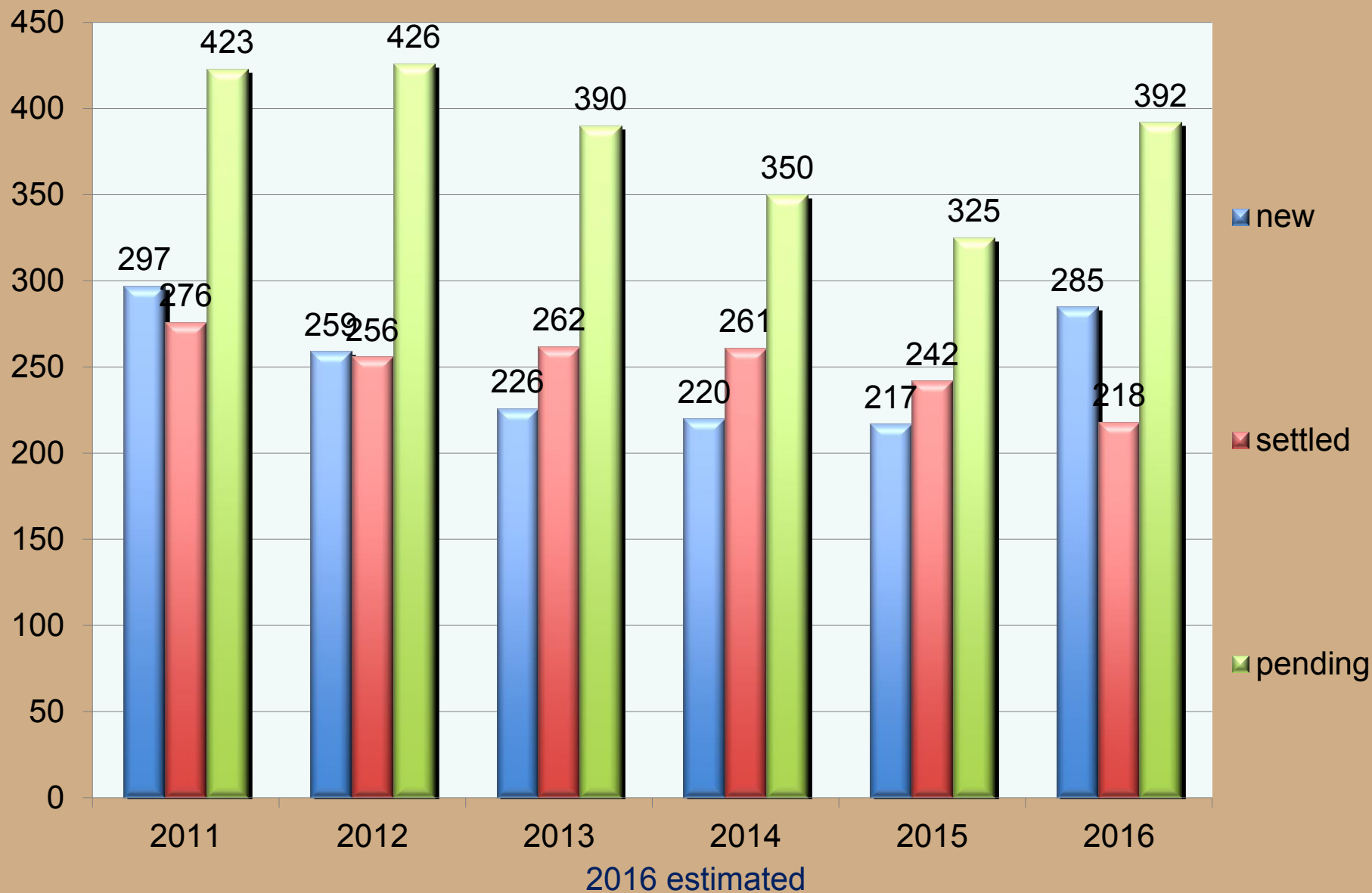
- ✓ patents
- ✓ trade marks
- ✓ utility models
- ✓ topographies
- ✓ designs
- ✓ plant varieties 3

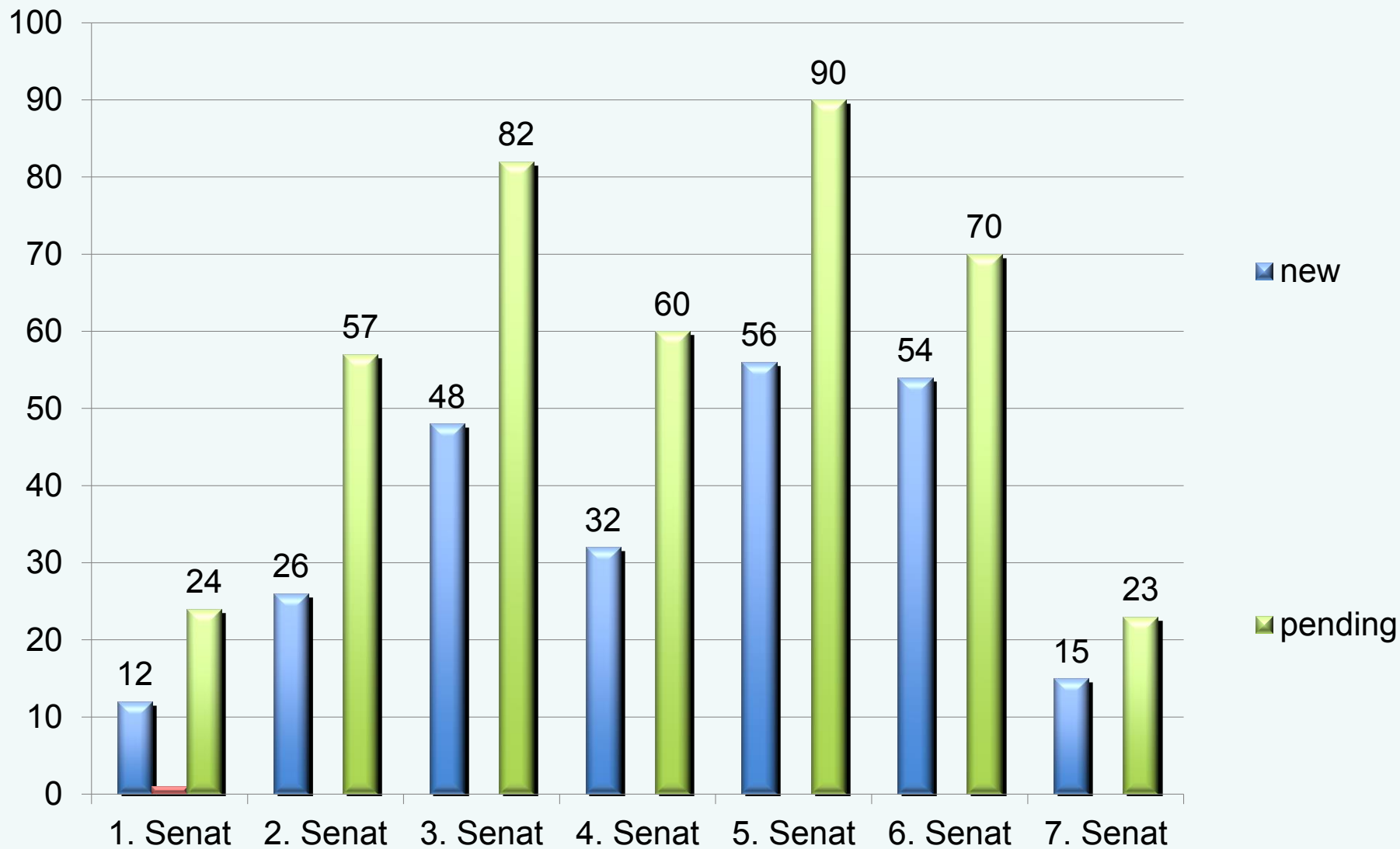


# Composition of the Nullity Board



# Nullity Proceedings





# Section 81 Patent Law – Nullity Action

an action filed for nullity shall indicate

- the claimant
- the defendant – the proprietor of the patent as entered in the Register
- the matter under dispute
- a specific motion
- the facts and evidence in support of the grounds

No action for revocation as long as an opposition is admissible or opposition proceedings pending

fee depends on the value of the dispute which has to be decided by the court

- estimation by the parties
- known facts, e.g:
  - use of patent in business
  - licences
  - damages paid or asked for
  - duration of protection left
  - number of proceedings pending





BGH April 12, 2011-X ZR 28/09:

value fixed in pending infringement proceedings is to be increased by 25 %



Failure to pay within timelimits:

if the fee is not paid within three months from filing the application, the application shall be deemed not to have been filed (Sec. 3, 6 Patent Costs Law)

[https://www.dpma.de/service/formulare\\_merkblaetter/formulare/index.html](https://www.dpma.de/service/formulare_merkblaetter/formulare/index.html)

# Sec 97 Authorisation for the Attorney

- parties may pursue proceedings themselves or be represented by a lawyer or patent attorney as agent
- authorisation shall be filed – even subsequently - in writing
- deficiencies of authorisation may be asserted at any stage of the proceedings ex officio unless a lawyer or a patent attorney is acting as agent.



any person who has neither

- residence nor
- principal place of business nor
- an establishment in Germany
- must appoint a representative with a special authorisation
- termination of representation effective only after information and appointment of another representative





authorisation must comprise to act in proceedings before

- the German Patent and Trade Mark Office
- before the Federal Patent Court
- in civil litigation affecting the patent as well
- as to file an application for criminal prosecution.



## 20<sup>th</sup> board (20 W (pat) 6/12):

filing of power of attorney in written form is required, any deficiencies are taken into consideration ex officio – Sec. 97 para 6 does **not** apply in the special case of Sec 25.

## 23<sup>rd</sup> board (23 W (pat) 9/10)

Sec. 97 para 6 is applicable, the power of attorney is examined only if objections are raised by the other party or there are doubts concerning the authorisation

# Section 87 Ex Officio Examination

the Court is not limited exclusively by the facts as submitted by the parties

the court must investigate facts and arguments *ex officio*

parties are required to assist in clarifying the subject matter by making full and truthful statements regarding the facts and circumstances





## BGH Tretkurbeleinheit X ZR 19/12

within the framework of the applications submitted the court has no obligation to examine documents provided by the parties without further comments on the merit of those documents





BPatG judgement April 16, 2013, 4 Ni1/12

The board is not obliged to examine whether documents, which were filed without further explanation, have any relevance in relation to the grounds invoked. Parties are obliged to provide arguments and explanations



# Sec 83: Information Of Parties



the Federal Patent Court shall indicate as early as possible those aspects which will presumably be of particular significance or which are helpful for concentrating the oral proceedings upon the issues which are essential for the decision.

- facts of the case, including claim construction
- preliminary assessment of the invoked grounds for nullity and evaluation of the filed documents on state of the art
- definition of the person skilled in the art
- time limits for both parties for filing comments, new documents to support the claim, amendments or restriction of patent claims, auxiliary claims
- instruction about the consequences of failing to observe a time limit



# Sec 83: Information Of Parties

Possibility to reject means of challenge or defense brought forward after the expiry of a time limit if

1. the postponement of oral proceedings would be required
2. the party affected does not sufficiently excuse the delay, and
3. there has been instruction about the consequences of failing to observe a time limit





## BPatG 4 Ni 26/13 (EP) apparatus

when an amendment of claims is late, however excused, and happens in reaction to arguments, which the plaintiff itself had brought forward during proceedings, postponement of oral hearing is denied, as the plaintiff could easily have prepared beforehand its reaction to an amendment it initiated itself in the first place



## BGH X ZR 111/13, GRUR 2016,365 Telekommunikationsverbindung

- In general in appeal proceedings new auxiliary amendments will not be allowed if the defendant within its duty to bring matters to court in good time should have provided those requests already before the Patent Court
- If the Patent Court indicated in its opinion doubts in relation to the patentability, that should be reason enough for the defendant to react

## BGH X ZR 41/14, Fahrzeugscheibe II

patent owner may defend its patent with amended claims for the first time in appeal proceedings, when in first instance a initially positive preliminary opinion according to Section 83 was changed only in the oral hearing





# New Arguments in Appeal Proceedings

BGH X ZR , GRUR 2012, 1236,  
Fahrzeugwechselstromgenerator

BGH X ZR 21/12, GRUR 2013, 912;  
Walzstraße

If the Federal Patent Court in its preliminary opinion indicates to follow the arguments of the plaintiff, there is no need to file more arguments supporting the claim in first instance





## BGH X ZR 2/13, Analog-Digital-Wandler

- preliminary opinion (sect 83) refers only to part of the plaintiff's arguments
- defendant reacts in time with auxiliary claims to counter (only) these arguments
- defendant cannot be obliged to react – just in case - to any further argument, which was not dealt with in the opinion or even defined as probably not successful

