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Supreme Court rules on prerequisites for prior use

The German Patent Law and Utility Model Law stipulate that a patent or utility model is ineffective against someone already using the invention within Germany at the time of filing of the patent application or utility model application.

Recently, the German Federal Supreme Court had to decide on a case in which the defendant was in possession of a specific formulation comprising the active agent desmopressin at the time of filing of a utility model by the plaintiff disclosing and claiming such a formulation together with a feature defining an upper range for a class of ingredients.

The utility model as registered is directed to a solid pharmaceutical dosage form comprising desmopressin together with pharmaceutically acceptable excipients, wherein the amount of oxidants is equal to or less than 15 ppm of the dosage form. The teaching of the utility model, particularly the feature relating to the amount of oxidants, is based on the finding that desmopressin is degraded during storage by the activity of oxidants (comprised for example in some excipients) and that the amount of oxidants should thus be within the low range as defined.

According to case law, a right based on prior use demands that the party has independently gained possession of the invention. Further, possession of an invention is generally acknowledged if the technical teaching derived from a problem-and-solution analysis has been objectively completed and if it has been subjectively recognised that the actual implementation of the invention is possible – the question raised in the present case was whether the defendant had indeed realised in a subjective manner that the specific formulation as developed comprises oxidants within a certain amount range, which, according to the utility model of the plaintiff, is critical for increased storage stability.

The Court was of the opinion that all features of the utility model were clearly fulfilled by the specific formulation used by the defendant. For a right

based on prior use, it is sufficient that someone's actions are directed to the realisation of a technical teaching fulfilling all features of the claimed subject matter (in the present case the defendant's specific formulation comprising an amount of oxidants within the range as claimed in the utility model) – irrespective of whether the party was aware of the effect achieved.