

GERMANY



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the German part of a European patent in nullity proceedings.

Inescapable trap for German parts of European patents

If it can be established in opposition proceedings that a granted European patent contains subject-matter that extends beyond the content of the application as filed within the meaning of Article 123(2) EPC, the patent cannot be retrospectively amended by deleting that subject-matter from the claims, if such amendment(s) would extend the scope of protection conferred by the patent. This creates an inescapable trap in EPO practice that would, apart from a few exceptional cases, render a European patent containing such a limiting amendment open to revocation.

According to the established practice of Germany's Federal Patent Court (BPatG) and Federal Supreme Court (BGH), the EPO's inescapable trap does not apply to German patents as long as the overall scope of the claimed subject-matter finds a true basis in the original disclosure, that is the added feature is a scope-limiting one. If this condition is fulfilled, the limiting feature that is not originally disclosed in the application as filed can remain in the granted claims. In several cases, the BPatG required an amendment to the patent to the effect that no rights may be derived from the inadmissible inclusion of the limiting feature. According to the BGH (Xa ZB 14/09 *Winkelmesseinrichtung*) the addition of such a disclaimer is not necessary, but is also not objectionable.

In a recent decision (4 Ni 34/12 (EP) *Fettabsaugevorrichtung*), the BPatG clarified that the case law established for national German patents does not apply to German parts of European patents. In contrast to national patents, it is not possible to defend the German part of a European patent that contains an inadmissible extension resulting from the introduction of a limiting feature through the inclusion of a corresponding disclaimer, as permitted for national German patents. The inescapable trap thus opens up a further opportunity for a third party who missed the nine-month deadline for filing an opposition against the grant of a European patent to successfully attack