

GERMANY

Infringer cannot intervene in reinstatement procedure

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Recently, the German Federal Supreme Court (BGH) had to decide on the request of a complainant, himself sued for patent infringement, to become a party in an *ex parte* reinstatement procedure concerning the allegedly infringed patent. After the European patent was maintained in opposition in amended form, the patentee failed to perform the required validation steps in time before the German Patent and Trademark Office (GPTO). Having been informed by the GPTO about the loss of his German patent, the patentee requested reinstatement and simultaneously performed the required validation actions.

A third party, sued for infringement of this patent, intervened before the Patent Office and requested to become a party to the reinstatement procedure, because it was directly affected by the outcome of the reinstatement.

The GPTO rejected the request to become a party and granted *restitutio in integrum* to the patentee for his patent. The Federal Patent Court and the BGH confirmed this decision.

In its decision (XZB4/14, Verdickerpolymer II), the BGH argued that the patent law provides the possibility for a party being sued for patent infringement to intervene in a procedure at the Patent Office only under particular circumstances, for example an intervention of the accused infringer in a continuing opposition procedure. This being *lex specialis*, the BGH denied a general possibility of intervention in any other Patent Office proceedings by a third party being affected by the outcome.

Reinstatement proceedings are generally an “intermediate procedure” in a main procedure, such as examination, grant, or

in the decided case, a validation procedure. There, intervention is not provided in the law.

While in opposition proceedings, where intervention is implemented in the law, the intervener may become a party to a reinstatement procedure, the BGH concluded that there is no legal basis for becoming a party as intervener in *ex-parte* proceedings at the German Patent Office.

