

GERMANY

Inescapable trap for German parts of European patents not inescapable

Maiwald Patentanwalts GmbH

Munich



Andreas Ledl

Contrary to the very strict approach at the EPO in the situation in opposition proceedings referred to as the inescapable trap (where the patentee is squeezed between Article 123(2) and Article 123(3) EPC), which almost exclusively leads to the revocation of a European patent, Germany's Federal Supreme Court (BGH) has established a more liberal practice of dealing with such a situation for national German patents (see in particular the BGH's decision Xa ZB 14/09 *Winkelmesseinrichtung*).

In *Managing IP*'s edition of October 2014, we reported on decision 4 Ni 34/12 (EP) *Fettsaugeabrichtung* by Germany's Federal Patent Court (BPatG). In this decision, the BPatG clarified that the above-mentioned case law established for national German patents does not apply to German parts of European patents. The decision could be interpreted such that this opens up a further opportunity for a third party who missed the nine-month opposition deadline in Europe to attack the German part of a European patent in nullity proceedings.

The above no longer applies in view a recent decision by the BGH, Germany's highest instance in patent matters. Although this decision by the BGH (X ZR 161/12 *Wundbehandlungsvorrichtung*) is not related to the above-mentioned BPatG-decision, the BGH explicitly referred to *Fettsaugeabrichtung* and took the opposite view of the BPatG. Thus, also the German parts of European patents may be maintained in German nullity proceedings according to the practice established for national German patents.

The BGH based its decision *inter alia* on Article II § 6 IntPatÜbkG. According to this Article, the nullity grounds for the

German part of a European patent are listed in Article 138 EPC. While the BGH acknowledged that Article 138 EPC lists the grounds in an exclusive manner, the BGH went on to say that it is nevertheless possible for a national court to desist from declaring a patent null even if such a ground is present. The BGH further referred to Article 14 GG and stated that the constitutional protection of property including the right on a patent must be protected against unnecessary sovereign intervention. It seems that the BGH balanced this against the very strict inescapable trap approach in EPO practice.