

GERMANY

Late-filed submissions in nullity proceedings

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The Patent Law Modernisation Act (Patentrechtsmodernisierungsgesetz) introduced a legal basis for rejecting late-filed submissions during German nullity proceedings by the revised Section 83 paragraph 4 (§ 83 Abs 4) of the German Patent Act (Patentgesetz). A late-filed submission may be rejected if its consideration results in the adjournment of an already scheduled oral hearing. However, the party filing the late submission may overcome an impending rejection if an adequate reasoning can be provided for the lateness of the submission.

A harmonisation of procedural law regarding late-filed submissions in patent disputes was expected, in particular between European opposition and German nullity proceedings. Indeed, developing jurisdiction as addressed by two remarkable judgments of the German Federal Patent Court (Bundespatentgericht) holds that, in essence, the legal concept of disregarding requests, facts or evidence that are not submitted in due time may enter German practice.

The Third Nullity Board (Nichtigkeitssenat) 3 Ni 6/12 (EP) of the German Federal Patent Court decided that in accordance with Section 83 paragraph 4 of the German Patent Act the late submission was held to be admissible, since in this case the subject matter of the late submission was a restricted defence in the form of only a few features that have already been discussed in terms of the patent as granted and no adjournment of the scheduled oral hearing was necessary.

In contrast, the Fifth Nullity Board 5 Ni 59/10 (EP) of the German Federal Patent Court rejected a late submission by the defendant, since they could not present adequate reasoning for the late submission. The late submission was

held to be inadmissible although it was in the form of an auxiliary request adding features of dependent claims as previously granted.

As a consequence, even though the criteria for rejecting late-filed submissions differ in German (exculpation, adjournment of the oral hearing) and European practice (no rejection if late-filed evidence is presented without any further investigation, that is *prima facie*), harmonisation is accomplished and nullity proceedings in Germany are streamlined.