



## Newsletter Issue 2/2016

Düsseldorf/Munich, 14 June 2016

### Opposition proceedings before the EPO to be faster

Opposition proceedings before the European Patent Office currently take an average of nearly three years, which is why the EPO now has introduced [introduced](#) rules for a streamlined procedure that shall apply to oppositions as of 1 July 2016.

Streamlined proceedings should take just 15 months, and apply to "standard" oppositions, i.e. proceedings involving only one proprietor and only one opponent.

Under the new rules, each party shall make only one written submission before the opposition division issues its opinion: the opponent submits only their reasoned notice of opposition, and the patentee only their response whilst observing a four-month deadline. Extensions to the four-month deadline shall only be granted in exceptional cases.

The opposition division shall then summon the parties to oral proceedings. Oral proceedings shall as a rule be held six months from the date of the summons, and the deadline for written submissions shall be two months.

This procedure is already standard practice for many opposition proceedings; opponents now often do not wait for the statement of the patentee but instead simply await the assessment of the opposition division.

The European Patent's Office aim to speed up proceedings can therefore only be welcomed.

However, the rules regarding submission in due time are unclear. While they clearly state that documents submitted during oral proceedings are to be deemed late and only considered if they are of prima facie relevance, it is unclear what applies to documents that are submitted before the dead-

### What would "Brexit" mean for intellectual property rights?

On 23 June 2016, the British will vote on their membership of the EU. What would a "Yes" to "Brexit" mean for intellectual property rights?

Firstly, it should be noted that the United Kingdom would in fact remain a member of the European Union for the foreseeable future even in the event of a "Yes" vote. Article 50 of the Lisbon Treaty allows for a Member State to withdraw within two years of an application for withdrawal, and this deadline can be extended.

The implications for EU-wide intellectual property rights are clear: European Union trade marks and Community designs would have no force in the United Kingdom after a UK exit. For trademarks in particular, a transfer of EU property rights into domestic British intellectual property law would probably be possible in a process similar to that applied in the former Soviet Union and ex-Yugoslavia. Whether or not and just how this would be done would, however, be a decision for the United Kingdom alone.

Little would change for existing patents. As the European Patent Office is not an EU body, it would still be possible to have European patent applications validated in the United Kingdom after patents are granted. This would, as before, have to be implemented in domestic law.

What would change would be the possibility of using infringement proceedings in the United Kingdom to stop infringement proceedings in Europe. A scenario such as that in "Actavis v. Eli Lilly"<sup>1</sup> – an attempt to have infringement proceedings before the *Landgericht* [regional court of] Düsseldorf thrown out on the grounds of an action for a negative declaration in the United Kingdom – would no longer be possible.

The implications for the Unified Patent Court

### Our latest news

Michalski • Hüttermann & Partner is on course to become a pan-European IP firm. We have set up [EU-RIPTA](#) with our partner legal firms in Belgium, Italy and Poland.

Our EURIPTA group with offices in Düsseldorf, Munich, Leuven, Bologna, Milan, Reggio Emilia and Warsaw has over 45 patent attorneys. Planning is currently underway for offices in France and Switzerland. In the light of the upcoming unified patent and the Unified Patent Court, EURIPTA will allow us to represent your interests in Europe even more effectively.

\*\*\*

On 9 June 2016, [Jan Sommer](#) was admitted as a German patent attorney and has joined the team at our Munich office. Congratulations!

\*\*\*

Harald Bienert will be a guest speaker at this year's ["Summer School on Intellectual Property"](#) at the University of Bonn, which runs from 25 July to 5 August 2016. On **26 July 2016**, he will deliver a

line for written submissions.

It would impose considerable restrictions on both parties if documents and requests submitted before the written submissions deadline were also fundamentally deemed to be submitted too late. Such a rule would not, moreover, reduce the workload of the opposition divisions. Both parties would make extensive initial submissions if they did not have a subsequent opportunity to make requests or submit documents (this is not least a concern for the Unified Patent Court).<sup>1</sup>

The approach to date has proved effective and should not be abandoned.

Regrettably, there are no initiatives to also streamline proceedings before the boards of appeal. Many boards of appeal now simply stop allowing new applications and evidence, a move that has attracted some criticism.<sup>2</sup> Yet despite this development, proceedings before the boards of appeal are still unacceptably long.

Nevertheless, speeding up proceedings before the opposition divisions is certainly a welcome start, provided the existing options for submitting applications and documents remain in place.

<sup>1</sup>s. Hüttermann, Mitt 2016, 212

<sup>2</sup>see for example Anetsberger et al, epi information 2015, 63, Wallinger, VPP Rundbrief 2015, 18

and Unitary patents would probably be more serious. Although the Agreement on the Unified Patent Court is an international treaty, only EU Member States can be signatories.

According to Article 89, ratification by the United Kingdom is required as the UK is one of the three countries "*in which the highest number of European patents had effect in the year preceding the year in which the signature of the Agreement takes place*". Ratification will not occur before 23 June, even if the United Kingdom has already changed its domestic patent law. The United Kingdom could ratify the Agreement after the referendum as a "farewell gift", or in recognition of the numerous amendments successfully demanded by the UK, and some of which were implemented only just before conclusion of the Agreement.<sup>2</sup> However, this does not appear likely.

Italy would only take the United Kingdom's place once the UK had actually left the EU, and this would delay the Agreement's entry into force by several years.

The remaining Member States could, however, simply change the Agreement, for example by amending the ratification clauses in Art. 89. The office of the London section of the central division would then doubtless be revised. Such a change would, moreover, demonstrate the powers and capacity of the EU and its Member States to act following a British "Yes" to "Brexit". Whether or not the entire ratification process would then have to be relaunched, and if so, how, remains unclear.<sup>3</sup>

No British judges would then sit at the Unified Patent Court, and parties could not be represented by British lawyers. It seems likely that this would also apply to qualified British patent attorneys, even if Article 48(2) of the Agreement leaves the question of nationality open.

As British cases account for less than 10% of all proceedings for infringement in Europe,<sup>4</sup> the Unified Patent Court would still be of great significance to international patent law even after a UK withdrawal from EU.

<sup>1</sup>See *Actavis Group HF v Eli Lilly & Co* [2012] EWHC 3316 (Pat) and following rulings. It is worth noting that the British and German courts ultimately came to the same conclusion.

<sup>2</sup>See for example Tillmann, GRUR 2013, 157 and GRUR 2015 527, in which he compares the United Kingdom's approach to the acts of piracy under Queen Elisabeth I.

<sup>3</sup>Some are suggesting the Vienna Convention on the Law of Treaties be applied to avoid repeating the entire ratification process.

<sup>4</sup>See also Kühnen/Claessen, GRUR 2013, 592

lecture on "IP and Telecommunications".

### Questions and feedback

We welcome your questions and feedback. Please contact us [here](#).

**Legal notice:** Michalski Hüttermann & Partner Patentanwälte mbB

Speditionstraße 21 - 40221 Düsseldorf - Tel.: +49 211 159 249 0 - Fax: +49 211 159 249 20  
Nymphenburger Straße 4 - 80335 München - Tel.: +49 (0)89 208 027 274 - Fax: +49 (0)89 208 027 275

This newsletter merely provides general information and does not constitute legal advice as defined in the *Rechtsberatungsgesetz* [German Act on Legal Advice]. Whilst this newsletter has been compiled with the utmost care, Michalski Hüttermann & Partner Patentanwälte mbB cannot guarantee the quality of the information provided or that it is correct, up-to-date or complete.