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Newsletter 7/2017 Edition

Düsseldorf/Eszen/Munich, 21 December 2017

G1/16 published – G1/03 is upheld

Shortly before Christmas, the Enlarged Board of Appeal [published](#) the long-awaited decision G1/16, which came as a surprise to many, since the oral hearing did not take place until 16 October 2017.

The underlying case once again concerned the question of whether and to what extent unpublished disclaimers are admissible. There were two earlier decisions on this subject, starting with [G1/03](#) from 2004, which allowed undisclosed disclaimers under certain conditions. A later decision, [G2/10](#) from 2011, dealt with the question of whether it is possible for parts of the description originally described in positive terms to be negatively excluded (=disclaimed) in the claim. This was considered possible by G2/10, but at the same time it was also categorically explained in this decision that for every disclaimer, sufficient disclosure for the remaining portion of the claim must be found in the application.

This part of the decision in particular was later interpreted by many Boards of Appeal as meaning that G1/03 essentially no longer applied. In order to have this clarified once and for all, the Board of Appeal placed this question before the Enlarged Board of Appeal in the underlying decision [I 437/14](#).

The Enlarged Board of Appeal has now expressed itself with remarkable clarity. Firstly, it determined (appropriately) that a strict application of G2/10 would make a disclaimer in accordance with the

Stay of infringement proceeding due to manifest prior use

In a decision on 19 December 2017, the Civil Division 4b of the Düsseldorf Regional Court has stayed an infringement action (Case No. 4b O 113/16) between the Dutch company Sisgrass B.V. and heiler GmbH & Co. KG Sportplatzbau. This order of stay is particularly remarkable because the infringement defendant, the company heiler from Bielefeld, was able to provide only testimonial evidence of manifest prior use when contesting the patent rights asserted by Sisgrass.

Sisgrass had asserted a patent protecting a device and a method for producing a hybrid turf for playing fields, as well as a nearly identical utility model. Hybrid turf systems are growing in importance, especially in professional football, since they offer a possibility to further improve the quality of the playing surface. The heiler company provides not only the substructure and the sowing or laying of the natural turf but also the tufting-in of the synthetic turf fibers, and is successfully employed at this with many German Bundesliga clubs. This is what Sisgrass objected to in the present complaint, initially without success.

The criteria developed by the jurisprudence for staying an infringement action are different for patents and utility models: In the case of a patent a stay is generally only required when the infringement court not only sees the prospect of revocation of the patent in suit, but there is also a significant likelihood that

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holidays and all the best for
2018!

Proposals and Questions

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rules of G1/03 impossible.¹

Secondly, it ruled that the two decisions must be considered independently of one another, which is to say that G1/03 applies to undisclosed disclaimers and G2/10 to those that are disclosed.²

Now, what does this mean in practice?

On the one hand, this means a significant strengthening of the position of applicants, who can continue to use the relatively liberal options of G1/03. Together with G1/15, their options are even better than before.

On the other hand, this means that the axiomatic position³ of the Boards of Appeal of the European Patent Office, already weakened by [G1/15](#)⁴, has now been corrected once again.

It should also be noted that German courts have always taken a more liberal position, for example as manifested once again in the recently issued "*Phosphatidylcholin*" decision (X ZB 5/16, see [here](#)), in which a disclaimer of phosphatidylcholine (lecithine) was readily accepted in the application proceeding.

Consequently, the position of patent holders has also been improved in this regard. They can obtain patents before the European Patent Office more easily, and at the same time need not fear that a disclaimer accepted by the European Patent Office will result in loss of the patent after the fact in a revocation action.

¹ Point 42 of the decision

² Point 43 of the decision

³ see *Exner/Hüttermann/Michalski*, Mitt. 2017, 104

⁴ see also our [Newsletter 4/2016](#)

revocation is to be expected. In general, this requires prior art in the form of written prior disclosures that are prejudicial to the novelty of the asserted patent and have not yet been evaluated in the examination procedure. The situation differs for utility models: If a parallel cancellation proceeding is pending, the court must issue a stay if it holds the utility model registration to be invalid.

If a utility model and a patent are asserted in parallel, a stay would thus only come into consideration if the court approves a stay for both the patent and for the utility model. In the present case, however, heiler had filed a connected counterclaim, and as a result had inseparably coupled the two parts of the proceeding, making it possible for the court to issue an order of stay even in the event that a stay would have been required only for the patent or only for the utility model.

Since a statement of reasoning is not yet available in the present matter, one can still only speculate as to the court's motivations. At any event, however, it may be stated that a connected counterclaim can be an effective means of not only countering objections of lateness, but also of improving the prospects for a stay in the event of parallel assertion of both patent and utility model. In other regards, it appears – conclusively argued – that even a manifest prior use is not unsuitable from the outset for achieving a stay in patent and utility model infringement proceedings.

As infringement defendant in this proceeding, heiler GmbH & Co. Kg is represented by the law firm of Dr. Stracke, Bubenzer & Partner, attorney responsible for the matter: Mr. Volker Küpperbusch, and in patent matters by the law firm of Michalski Hüttermann & Partner, patent attorney responsible for the matter: Dr. Dirk Schulz.

[Impressum](#): Michalski · Hüttermann & Partner Patentanwälte mbB

Speditionstrasse 21 - D-40221 Düsseldorf, Germany - Tel +49 211 159 249 0 - Fax +49 211 159 249 20
Hufelandstr. 2 - D-45147 Essen - Tel +49 201 271 00 703 - Fax +49 201 271 00 726
Perchtinger Strasse 6 - D-81379 Munich, Germany - Tel +49 89 7007 4234 - Fax +49 89 7007 4262

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