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for review of draft patent law modernization act

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M I C H A L S K I



H Ü T T E R M A N N

P A T E N T A N W Ä L T E

Bundesrat approves unitary patent system and asks for review of draft patent law modernization act

In the last session of 2020, the Bundesrat, as previously expected, unanimously approved the ratification law on the unitary patent system, so that it is now (once again) only up to President Steinmeier to put the ratification law into effect with his signature.¹

However, two constitutional complaints against ratification have now been lodged with the Federal Constitutional Court.² It remains to be seen whether these will lead to the Federal Constitutional Court again asking for a postponement of the signing, as it did in the first ratification attempt. This would be a surprise, however, since the actual reason why the first ratification law was classified as unconstitutional no longer exists.

In view of the political situation, in which all parties except the AfD are in favor of the unitary patent system, the Federal Constitutional Court should have expected that a second ratification would take place - and could then actually have (or perhaps even should have) made clear in the first judgment that the legislative bodies could be spared such a renewed attempt.

In the same session, however, the Bundesrat also dealt with the draft of the new German Patent Act,³ albeit still in preliminary proceedings pursuant to Art. 76(2) of the Basic Law, since the discussion in the Bundestag has not yet taken place here.

It is all the more remarkable that the Bundesrat has proposed amendments to the law.⁴

In addition to a rather formal proposal to amend §33 Patent Act (the less relevant claim basis for compensation from published patent applications in practice), the proposals concern, on the one hand, the planned reorganization of nullity proceedings and - more politically explosive - the new version of §139 Patent Act, i.e. the planned easing of the injunctive relief.

With regard to the reorganization of the nullity proceedings, it is recommended to examine whether the planned changes in the nullity proceedings, in particular the six-month period for the qualified reference, are really sufficient.⁵

Potentially more explosive, on the other hand, is the proposal that §139 be worded differently than in the draft bill. The draft states that injunctive relief should be denied *"insofar as, due to the particular circumstances of the individual case, recourse would result in disproportionate hardship for the infringer or third parties that is not justified by the exclusive right."* Instead, monetary compensation is to be granted where appropriate.

One of the reasons given for this was that it would codify the case law of the Federal Court of Justice, in particular the "Wärmetauscher" decision.⁶



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We congratulate Dr. Kevin Lamberts on passing the patent attorney examination. After his admission, he will strengthen our Düsseldorf office.

¹ S. our [newsletter 12/2020](#)

² Compare here: <https://www.juve-patent.com/news-and-stories/legal-commentary/breaking-german-upc-legislation-challenged-again-by-constitutional-complaints/>

³ S. our [newsletter 2/2020](#)

⁴ S. here: https://www.bundesrat.de/SharedDocs/drucksachen/2020/0601-0700/683-1-20.pdf?__blob=publicationFile&v=1

⁵ S. our [newsletter 2/2020](#)

⁶ BGH, Decision from May 10, 2016 – X ZR 114/13 „Wärmetauscher“

However, the Federal Council - rightly - points out that the planned amendment to the law, which provides for the possibility of refusing to refrain in cases of hardship, is not included in the "Wärmetauscher" decision, which only speaks of the possibility of granting a grace period.

Thus, it is suggested to *"adapt the wording of the planned proportionality objection in Sec. 139 PatG and Sec. 24 GebrMG to the "Wärmetauscher" decision of the BGH, so that - as intended by the draft law - only the already existing case law of the highest courts is codified."*

In addition, *"there might be a need for supplementing Section 139 PatG and Section 24 GebrMG with (further) criteria or standard examples, on the one hand with respect to the application of the principle of proportionality and, on the other hand, with respect to the granting and determination of the amount of the monetary compensation provided for."*

However, this new version would result in the automatic injunctive relief continuing to exist and, if necessary, only the length of an expiry period would be discussed.

This is certainly not what the numerous proponents of the new law had in mind, and it can be eagerly awaited whether the law will still change in the further legislative process.

However, the fact that the Bundesrat is already intervening in the discussion at this very early stage was certainly unexpected and shows that the legislative process may still have a few surprises in store.

BGH readjusts the nullity ground due to of lack of disclosure – "Zigarettenpackung"

In the "Zigarettenpackung" [decision](#)⁷ published a few days ago, the Federal Court of Justice dealt with the grounds for invalidity of the lack of disclosure in the original documents. The patent in suit concerned a cigarette packet, which comprised a frame on the one hand and a barrier sheet surrounding the frame on the other, the barrier sheet having specially shaped sealed seams with which it tightly enclosed both the frame and the cigarettes.

The characteristic part of the patent in suit was now that *"all sealed seams at least partly overlap a part [...] of the frame."*

This feature was now considered by the Federal Patent Court as not originally disclosed, but (only) with the consequence that the patent was not declared invalid, but that no rights could be derived from this feature.

The Federal Court of Justice now contradicted this and declared the patent null and void. The court explained that, in principle, a lack of disclosure of a feature does not necessarily have to lead to the declaration of invalidity of a patent:

*"Insofar as the undisclosed feature leads to a mere restriction of the subject matter applied for, but not to an aliud *, the legitimate interests of the public are already satisfied if the feature remains in the patent claim and, at the same time, care is taken to ensure that in all other respects, i.e., as far as the creation of patent rights is concerned, no rights can be derived from the amendment."⁸*



⁷ BGH, Urteil vom 20. Oktober 2020 -X ZR 158/18 - Zigarettenpackung

⁸ Para 40 of the decision

However, this only applies if the feature in question only restricts the subject matter of the application - and this is not the case here:

*"An aliud, which necessarily leads to a declaration of invalidity, is present not only if the subject matter of the patent in suit bears an exclusive relationship to the originally disclosed subject matter, but also if the added feature concerns a technical aspect which cannot be inferred from the originally filed documents either in its concrete form or at least in abstract form as belonging to the invention."*⁹

This was precisely what the BGH saw as given in the case at hand, because the undisclosed feature was an *"addition of a new technical aspect that is also not disclosed in abstract form in the originally submitted documents."*¹⁰

Thus, the Federal Court of Justice clarifies: The nullity ground of lack of disclosure in the original documents still exists and patentees are still well advised to pay attention to a support of their claims in the original description, not only before the European Patent Office, but also in Germany, be it before the DPMA and in German opposition proceedings, be it in nullity proceedings.

The Federal Court of Justice on the relationship between patent and design – the "Papierspender" decision

In the "Papierspender" [decision](#)¹¹ published a few days ago, the Federal Court of Justice once again took the opportunity to clarify the relationship between patent and design law. In particular, when both patent and design protection are sought for an object, the design is often attacked on the grounds that it only has technical features.

This was also the case in the present case, where both a patent and a design had been applied for a paper dispenser and even the same drawings had been used for both the patent and the design application.

The owner of the design had now sued a competitor. After the Düsseldorf Regional Court had upheld the action, the Higher Regional Court (OLG) again upheld the re-claim for invalidity of the design¹², but allowed the appeal.

The BGH now reversed the decision and referred the matter back to the OLG. At the same time, however, it clarified the following:

Decisive for the classification of whether a given feature of a design is technical or not is the "DOCERAM" decision of the ECJ¹³. Accordingly, when *"assessing whether appearance features of a product are exclusively due to its technical function, it must be determined whether this function is the only factor determining these features."*¹⁴



⁹ Para 41 of the decision

¹⁰ Para 41 of the decision

¹¹ BGH, Decision from October 7, 2020 -I ZR 137/19 - Papierspender

¹² Note: This was an EU design, here the old name still applies

¹³ ECJ, Decision of March 8, 2018 - C-395/16, GRUR 2018, 612 Rn. 32 = WRP 2018, 546 - DOCERAM

¹⁴ Para 10 of the decision, at the same time quoting from ECJ „Doceram“.

However, the OLG had now demanded, in particular with regard to the fact that the same drawings had been used for patent and design, that it had to be examined *“whether the appearance features of the product in question had, on objective assessment, only been chosen with the aim that this product should fulfill a certain technical function, or whether they had an ‘aesthetic surplus’”*. Since there was no such aesthetic surplus, the design had to be declared null and void.

The Federal Court of Justice now rejected this approach, stating that such an “aesthetic surplus” could not be discerned from the DOCERAM decision. Instead, *“what matters is merely whether considerations other than the requirement that the product fulfill its technical function, in particular those related to visual appearance, did not play a role in the decision as to the appearance characteristics of a product.”*¹⁵

Here it is also irrelevant whether the same drawings were used for patent as design, because:

*“There is neither a principle of experience of the content nor a factual presumption that considerations related to the visual appearance of a product played no role in the decision for an appearance feature which, according to a patent disclosure, is necessary for its technical function. To judge this is rather a question of the individual case. In view of the task of the patent application to explain the technical function of the product, considerations related to the visual appearance of individual appearance features are neither necessary nor per se excluded in a patent disclosure [...] Therefore, the absence of considerations on the visual appearance of the product in a patent disclosure per se does not allow the conclusion of the exclusively technical conditionality of an appearance feature any more than the presence of considerations on its technical function. Rather, in both cases it must be examined whether objective circumstances lying outside the patent disclosure indicate a visual conditionality of the appearance feature in question.”*¹⁶

In other words, just because an object is shown in the drawings of a patent application, does not (automatically) mean that this object is then also exclusively technical. This requires an examination in the individual case, which in the present case still has to be carried out by the Düsseldorf Higher Regional Court, since the Federal Court of Justice has referred the case back for this purpose.

The Federal Court of Justice has thus (once again) clarified that patent and design protection are different spheres and that one does not exclude the other, even if the images of the design can be found identically in a patent application.

Whether, on the other hand, it would not be more advisable to use more abstract drawings in a patent application if a design is to be submitted in parallel is, of course, another matter entirely.

¹⁵ Para 12 of the decision

¹⁶ Para 28 of the decision

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We wish your relatives, employees, colleagues and of course yourself all the best for the current, still difficult time.

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