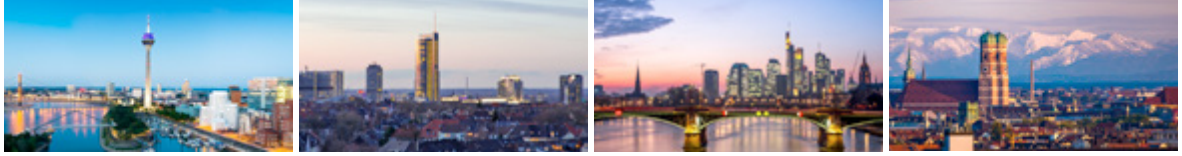

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Ministry of Justice submits draft ratification bill on unitary patent system

The Federal Court of Justice on the question of referring nullity suits back to the Federal Patent Court

Two decisions of the Federal Court of Justice (indirectly) concerning the legal status of professions

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PATENTANWÄLTE

Ministry of Justice submits draft ratification bill on unitary patent system

After the Federal Ministry of Justice and Consumer Protection announced[1] on 26 March 2020 that it would soon undertake a new attempt at ratification of the unitary patent system, the Ministry has submitted a ministerial draft bill for a new Act of Approval to the Agreement on a Unified Patent Court – with a promptness that may come as a surprise to many.

No changes to the original Act were made in the draft, which is to say it did not – as proposed – include a reservation.[2] This despite the fact that the problems with regard to Great Britain and the obiter dictum of the German Federal Constitutional Court concerning Art. 20 of the Agreement must still be addressed.[3]

The following comments on this topic were included in the reasoning, however:

Great Britain argues that the intention at the time was that at least "the big three" should take part in the unitary patent system at the start – but this does not mean, of course, that it should always be the case:

"The fact that Great Britain is withdrawing from the Agreement as a result of Brexit does not stand in the way of implementation:
The provisions in the Agreement and its protocols regarding entry into force were intended ensure that all three states participating in the agreement, the Federal Republic of Germany, France and Great Britain, would take part in the court system right from the beginning of the Unified Patent Court. This was intended to prevent the agreement from initially entering into force with only one or two of the three states, for instance because of differences in the length of the ratification process. The purpose of the reference to them is thus to coordinate the date of entry into force among the actual participants in the agreement.
Regardless of the fact that British approval is currently in hand, a withdrawal by Great Britain has no effect on the applicability of the provisions regarding entry into force, not least because these provisions must be construed such that a completely unforeseeable withdrawal of one of these three states does not impede overall entry into force for the remaining participants ."

The issue of locating the central division in London is – correctly – not considered to be a serious problem. The solution proposed in our previous Newsletter[4] of initially dividing the competences between Paris and Munich, and possibly seeking an alternative location in the future is envisioned:

"Apart from this, the Agreement expressly makes provision for a section to be located in London, in addition to the seat of the central division of first instance in Paris and the section in Munich. However, it cannot be understood as intending that a division location be established or remain in a non-member state. In the event of an elimination of the London central division unit, the Agreement must be construed such that its competences accrue at least transitionally to the (still) existing central divisions in Paris and Munich. An explicit provision can be enacted at an appropriate time within the framework of a review of the functioning of the Court as provided in Article 87(1) and (3) of the Agreement.

Among the remaining Contracting Member States a political clarification of these questions is sought."

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[1] See our Newsletter 4/2020
[2] See our Newsletter 4/2020
[3] See our Newsletter 3/2020 and Newsletter 4/2020
[4] See our Newsletter 4/2020

In Our Own Affairs

In view of the many requests, we have decided once again this year to offer free, two-day preparatory courses for parts C and D of the EQE exam. The courses will take place in Düsseldorf on Thursday/Friday, 12/13 November, and Saturday/Sunday, 12/13 December 2020, provided that events of this nature are possible at that time.

The course content is primarily aimed at suitable examination techniques and strategies for avoiding errors in order to be able successfully tackle parts C and D of the EQE exam using these skills. It has been our experience that well-prepared examination documents significantly increase the prospects of success. For this reason, we want to provide the participants in this course with the requisite methodological knowledge. In this regard, the course should be viewed as a supplement to your own preparation on the content of the legal fundamentals of the EPC. The participants will learn how to translate their specialized knowledge of

The reasoning also discusses Article 20 of the Agreement on a Unified Patent Court, although no constitutional problem whatsoever is seen here:

"The Federal Constitutional Court, in its decision of 13 February 2020 (Order of the Second Senate of the Federal Constitutional Court – 2 BvR 739/17 –), based the invalidity of the Act passed on 10 March 2017 solely on the violation of Article 23 (1) third sentence of the Basic Law. It also addressed whether a legal problem could arise from Article 20 of the Agreement (see paragraph 166 of the decision). Article 20 of the Agreement reads: "The Court shall apply Union law in its entirety and shall respect its primacy. "There is no conflict between this provision of the agreement and Article 79 (3) of the Basic Law. This provision serves to clarify that the international court occupies the same position with respect to European Union law that is accorded to national courts. The primacy of Union law is fundamentally undisputed and is also recognized by the Federal Constitutional Court. (Federal Constitutional Court, 2 BvE 2/08 of 30 June 2009 – Treaty of Lisbon, paragraph 331 ff, with further references)."

The expeditious advancement of the (re-)ratification of the unitary patent system must be considered surprising – especially in view of the fact that a comprehensive economic stimulus package is meant to be implemented in laws now – but does mean that both the Ministry and the government not only view the unitary patent system favorably, but even accord it priority.

Supporters can only consider this a good sign.

the EPC into the maximum number of points to pass parts C and D of the EQE exam. The courses are held in our offices in Düsseldorf and are free of charge. Course instructors are Dr. Torsten Exner, Dipl.-Ing. Andreas Gröschel and Dr. Aloys Hüttermann.

Registrations are being accepted now (please include your full name and your employer) at eqe@mhpatent.de.

You can find further information at www.mhpatent.de

The Federal Court of Justice on the question of referring nullity suits back to the Federal Patent Court

In a recently issued decision entitled "Bausatz"[5], the Federal Court of Justice dealt with the question of when it is suitable to refer a nullity suit back to the German Federal Patent Court.

In the underlying case, the Federal Patent Court had declared the patent partially invalid due to inadmissible extension, and thus logically said nothing about novelty or inventive step in its judgment. Nonetheless, corresponding statements about this were to be found in the qualified instructions under Section 83 of the Patent Act.

The Federal Court of Justice now stated that when an initial evaluation of patentability is absent in a nullity suit, the case should routinely be referred back. The reason for this is that the Federal Patent Court – in contrast to the Federal Court of Justice – is staffed with technical judges who have greater technical knowledge. The court thereby affirmed the "Bitratenreduktion I" decision issued in 2015[6].

In this case, however, the situation was that the Federal Patent Court had indeed addressed patentability, albeit only in the qualified indication according to Art 83 Patent Law rather than in the judgment, and the nullity plaintiff had also made pertinent submissions in this regard.

Under these circumstances, the Federal Court of Justice did not consider it suitable here to refer the case back, and thus made a final decision.

[5] Federal Court of Justice, Tenth Civil Panel 13.2.2020 28.5.2020, X ZR 6/18

[6] Federal Court of Justice, X ZR 64/13, GRUR 2015, 1095 Paragraph 39 -Bitratenreduktion I

This decision is logical if one starts from the premise that the Federal Court of Justice only wants to refer a case back when there is absolutely no basis for evaluating patentability in the proceedings before the court of first instance. For the Federal Court of Justice, as indeed the decision itself states, technical expertise is of primary importance, and what is stated in the judgment itself is less crucial.[7]

Ultimately, therefore, in future we can proceed from the assumption that a remand is less likely to occur when a technical assessment by the Patent Court exists. It suffices for this assessment to be made in the qualified indication according to Art 83 Patent Law.

Two decisions of the Federal Court of Justice (indirectly) concerning the legal status of professions

In two recently issued decisions, the Federal Court of Justice addressed the job descriptions of patent attorney (Patentanwalt) and representative before the EPO (European Patent Attorney), albeit only indirectly in part.

In the first decision, "EPA-Vertreter"[8], the issue was whether the costs of a representative before the EPO who is not a patent attorney are also reimbursable under Section 143(3) of the Patent Act even though this section explicitly refers only to patent attorneys.

The Federal Court of Justice now stated that it was not the intent of Section 143 to privilege patent attorneys in such a way, and that a representative before the EPO is also entitled to cost reimbursement under Section 143, since he has the appropriate expertise:

"The participation of a professional representative before the European Patent Office can provide the court, and the attorneys-at-law authorized to represent a party and participating in legal representation in court, with the special expertise needed to ascertain the technical teaching of an invention and the technical circumstances essential for understanding it, and to judge them in terms of patent law, in the same manner as that of a patent attorney."[9]

Specific admission as a German patent attorney is therefore not required in order to enjoy reimbursement under Section 143.

The second decision, which garnered attention even outside the field of industrial property law[10], is the decision "Berufungsbegründung durch Patentanwalt"[11], which translates roughly to "Patent attorney's statement of grounds of appeal."

In the underlying case, a patent attorney had filed an appeal in a nullity suit shortly before midnight on the last day of the deadline, but the fax malfunctioned. Reinstatement was then requested, and ultimately was also granted.

Aside from the fact that the Federal Court of Justice undertook a precise analysis of the time an attorney must allow for a fax transmission, of particular interest here are the deliberations by the Federal Court of Justice on the question of whether the patent attorney

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[7] See paragraphs 37 ff. of the judgment

[8] Federal Court of Justice, Tenth Civil Panel, 14.4.2020 28.5.2020 X ZB 2/18

[9] Paragraph 34 of the decision

[10] See: https://www.lto.de/recht/juristen/b/bgh-x-zr-60-19-frist-versaeumt-wiedereinsetzung-fax-defekt-anwalt-bea-anwaltspostfach-stoerungsanfaellig-nicht-notwendig-uebermittlungsweg/

[11] Federal Court of Justice, Tenth Civil Panel, 28.4.2020 26.5.2020 X ZR 60/19

was obligated to contact an attorney-at-law who would then file the appeal through the special electronic lawyer mailbox. The Federal Court of Justice rejected this, not least for the reason that, in view of the susceptibility to malfunction of the special electronic lawyer mailbox at the time, an attorney could not be expected to always fall back on this mailbox when the fax transmission malfunctions.[12]

In the present case, however, there is the added factor that patent attorneys do not even have access to this mailbox. Here, the Federal Court of Justice places importance on the fact that the independent authority of representation of patent attorneys in patent nullity matters is expressly established in Section 113 of the Patent Act. Consequently, they must also be in a position to practice their profession on their own authority, even when they work in a mixed professional partnership or when an attorney-at-law is retained as an additional representative:

"Under Section 113, first sentence, of the Patent Act, the parties in patent nullity proceedings before the Federal Court of Justice must be represented by an attorney-at-law or a patent attorney as authorized representative. This provision offers the parties the option of being represented solely by a patent attorney, even in the second instance […] This presupposes that the patent attorney can work on his own authority. This independent position would be rendered ineffective if a patent attorney were enjoined to avail himself of the help of an attorney-at-law in the event of problems arising immediately before expiration of the time limit in connection with the transmission of documents subject to a time limit. This also applies even when the patent attorney works in a professional partnership with attorneys-at-law or when the party has also retained attorneys-at-law as counsel, as in this dispute. Even in such circumstances, a patent attorney may fundamentally practice his profession on his own responsibility."

As a result, this constitutes a significant strengthening and explicit affirmation of the role of patent attorneys in industrial property law. Patent attorneys are not viewed merely as a kind of "assistant"[13] to the attorneys-at-law, but rather as a genuine alternative.

It should be noted that patent attorneys can also appear alone before the Unified Patent Court under Art 48 of the Agreement on a Unified Patent Court. Against this background, this decision, which one can cite under Art 24(1)(e) of the Agreement in case of doubt, is all the more welcome.

[12] Paragraph 16 of the decision

[13] For an informative article on the creation of the provision on representation before the Unified Patent Court, see Kiani/Springorum, Mitt 2016, 155

In Our Own Affairs

We wish all the best to your family, staff members, colleagues, and of course to you yourself, in these difficult times

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