



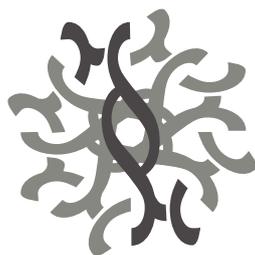
Newsletter Edition 9/2021

Düsseldorf/Essen/Frankfurt/Munich, 9 July 2021

Federal Constitutional Court clears the way for the unitary patent system

Double patenting ban sounded out
EPO's Enlarged Board of Appeal confirms existing practice

FCJ „Floor covering“ on substantive patent law



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

Federal Constitutional Court clears the way for the unitary patent system

On 9 July 2021, the Federal Constitutional Court published a [decision](#) dated 23 June 2021 in which the two constitutional complaints against the second ratification laws¹ were rejected as inadmissible, which means that the urgent applications were also rejected. The way is now clear for the unitary patent system.

The inadmissibility was mainly justified by the fact that the complainants could not prove a sufficiently high violation of their fundamental rights. In particular, the accusation (obviously made) that the selection procedure of the judges, especially the fact that the judges were only elected for a fixed term, would give reason for concerns, was not accepted:

„Particularities apply to international courts in this respect, which must be taken into account when transferring judicial tasks to intergovernmental institutions and may justify deviations from the requirements of the Basic Law to ensure the independence of judges. Limited terms of office for judges are the rule in international courts and are often also linked to the possibility of re-election.“²

Managing Intellectual Property

Our firm was again included in the list of the most important law firms for Germany in the field of „Patent Prosecution“ by „Managing Intellectual Property“. Dr Ulrich Storz and Dr Aloys Hüttermann are again „Patent Stars“ for the year 2021.

The discussion of Art 20 UPCA, which was still seen as possibly problematic in the first decision,³ is particularly interesting. This article emphasises the primacy of Union law. However, this is not problematic, because:

„Accordingly, Art. 20 UPCA must be understood in such a way that it is intended to dispel doubts as to the compatibility of the Convention with Union law, whereas it is not intended to regulate the relationship between Union law and national constitutional law beyond the status quo. For the interpretation of Art. 20 UPCA it is relevant that it goes back to Opinion 1/09 of the Court of Justice of the European Union of 8 March 2011, in which the latter described the primacy of Union law as interpreted by it and the preservation of the autonomy of the Union legal order as mandatory requirements for the admissibility of a unified European patent jurisdiction under Union law [...]“⁴

The decision of the Federal Constitutional Court removes the last remaining substantial hurdle to the entry into force of the unitary patent system. President Steinmeier can be expected to sign the ratification laws soon, which would



In our own affairs

Our partners, Dr Dirk Schulz and Dr Uwe Albersmeyer, have been named as recommended lawyers by the Handelsblatt in the list „Best Lawyers 2021“ as well as in Best Lawyers.

¹ See our newsletters [11/2020](#) and [1/2021](#)

² Paragraph 60 of the decision

³ See our newsletters [3/2020](#) and [4/2020](#)

⁴ Paragraph 77 of the decision

then be followed by the protocol phase in which, among other things, the judges would be appointed. This phase is reported to last about eight months, after which, perhaps in spring 2022, the unitary patent system can really enter into force.

Double patenting ban sounded out EPO's Enlarged Board of Appeal confirms existing practice

The Enlarged Board of Appeal (EBoA) of the European Patent Office (EPO) answered the following referral question with a "yes" in decision [G 4/19](#):

Can a European patent application be refused under Article 97(2) EPC if it claims the same subject-matter as a European patent granted to the same applicant which is not in the state of the art under Article 54(2) and (3) EPC?

Only this situation, and in the following constellations, was examined by the EBoA. The EBoA therefore refers to "double patenting in the narrower sense" throughout the decision.

In this "narrower sense", a double patenting prohibition was affirmed for all three following requested constellations in which the European patent application under examination:

- (a) was filed on the same day as the EP application already granted,
- (b) was filed as a European divisional application of the granted EP application; or
- (c) was filed claiming the priority of the granted EP application.

The prohibition of double patenting was in retreat at the European Patent Office at the beginning of the millennium. At the latest since decisions [T 877/06](#)⁵ and [T 1391/07](#)⁶, it has been established practice of the EPO to find that the question of



EQE Preparatory Courses 2021

There are still places available on our preparatory courses for the C and D parts of the European Qualifying Examination (EQE). Provided the pandemic situation allows, the courses will take place on Monday/Tuesday, November 22/23, and Saturday/Sunday, December 4/5, 2021. Both courses are identical in content, so attendance at one course is sufficient.

The course content is mainly focused on appropriate exam techniques as well as strategies for avoiding mistakes in order to be able to successfully tackle the C and D parts of the EQE exam with these skills. It has been our experience that well-prepared exam materials significantly increase the chances of success. Therefore, we want to provide the participants with the necessary methodological knowledge in this course. In this respect, the course is to be understood as a supplement to the participants' own preparation of the legal fundamentals of the EPC. Instead, participants will learn how to convert their technical knowledge of the EPC into as many points as possible for passing the C and D parts of the EQE examination. The courses take place in Düsseldorf at our premises in Speditionstr. 21 and are free of charge. Speakers of the course are Dr. Torsten Exner, Dipl.-Ing. Andreas Gröschel and Dr. Aloys Hüttermann.

Registration is now possible (please state your full name and employer) at eqe@mhpatent.de.

⁵ S. point 5 of the grounds for the decision and subpoints

⁶ S. point 2 of the grounds for the decision and subpoints

double patenting does not arise in the case of only a partial overlap of the scope of protection of two applications of the same applicant with the same priority date. Only recently, this practice was confirmed in decision [T 777/19](#)⁷: “A mere overlap of the scope of protection, even to a large extent, does not lead to double patenting.”

The double patenting prohibition does not have a codified provision in the EPC, rather an obiter dictum of the decision [G 1/05](#) and [G 1/06](#) of⁸ the EBoA is used as a basis. There, the EBoA recognises that “*the principle of the prohibition of double patenting⁹ is based on the fact that the applicant has no legitimate interest in a procedure leading to the grant of a second patent for the same subject-matter for which he already holds a granted patent.*”

An examination of double patenting therefore boils down to whether an applicant is seeking to obtain a grant for exactly the same subject-matter that he already possesses in granted form with the same priority date. Each delta in the scope of protection lifts one set of claims out of the double patenting prohibition. This goes as far as in decision [T 1780/12](#), where a board of appeal ruled that parent and divisional applications can be granted side by side already if a medical indication is formulated as a Swiss claim form in one case and as a purpose-bound product claim in the other. Whether this practice is in the sense of the EPC was explicitly not examined by the EBoA¹⁰.

Against this background, the question inevitably arises as to whether the double patenting prohibition is thus only a paper tiger or whether an examination as to whether exactly the same scope of protection exists is so in the sense of the EPC. The latter has now been confirmed by the UPC. The narrow prohibition of double patenting formulated as obiter dictum in [G 1/05](#) and [G 1/06](#) corresponds to the will of the legislator¹¹.

In the present decision [T 318/14](#), the applicant had argued that [G 1/05](#) and [G 1/06](#) only concerned the situation of divisional applications. For the situation of an internal priority, the scenario c) outlined above, the obiter dictum of the EBoA was not applicable¹². The two applications ended after different terms when granted, which justifies a legitimate interest. The EBoA now contradicts this: The prohibition of double patenting formulated as obiter dictum in [G 1/05](#) and [G 1/06](#) has general validity¹³.

It is therefore to be welcomed that the UPC has confirmed the previous practice of the Office as being in accordance with the EPC and has provided legal certainty in this respect. Furthermore, it would have been desirable to at least indicate



Leaders League

Our firm has been rated „highly recommended“ by Leaders League for the area of „Patent Prosecution“. Dr Stefan Michalski, Dr Aloys Hüttermann, Dirk Schulz, Ulrich Storz and Guido Quiram were singled out by name. In addition, our firm was also rated „highly recommended“ for the area of „Litigation“, with Wasilis Koukounis and Dirk Schulz mentioned by name.

⁷ S. point 2.6 of the grounds for the decision

⁸ S. point 13.4 of the grounds for the decision

⁹ According to the [English text of](#) the decision in the language of the proceedings; the official German translation of the EPO speaks of the “double protection prohibition”.

¹⁰ S. point 15 of the reasons for the decision in [G 4/19](#)

¹¹ P. 76 of the reasons for the decision in [G 4/19](#)

¹² S. points 4 and 5 of the reasons for the decision in [T 318/14](#).

¹³ S. point 86 of the reasons for the decision in [G 4/19](#)

what is covered by the wording “for the same subject-matter” in G 1/05 and G 1/06 or the “same invention”¹⁴. The same applies to the term “the applicant”. On the other hand, the omission of any statements in this respect is probably due to experience from previous decisions. Thus, at least at first glance, the present decision does not raise more questions than it answers.

Finally, it is to be expected that all proceedings which are [suspended due to the](#) problem of double patenting in examination and opposition proceedings will be resumed shortly.



FCJ “Floor covering” on substantive patent law

Even though the Paris Convention, in which priority was codified internationally, dates back to 1883 and is thus almost 140 years old, there are still decisions on priority law worth mentioning from time to time. In recent times, especially in the “CRISPR/CAS” case¹⁵, these have mainly concerned formal patent law, but there are also decisions on substantive patent law that are worth mentioning from time to time, such as the “[floor covering](#)” decision recently published by the Federal Court of Justice.¹⁶

The underlying patent was about floor coverings that are used to protect sensitive surfaces (especially grass surfaces in football stadiums) and that serve, for example, as stage substructures. These coverings often consist of plug-in systems so that a large surface can be built up in a simple way.

In the present patent, corresponding connecting elements were now protected, which could be connected to form panels, which in turn could be connected to each other, resulting in a flat large surface at the end.

What was now decisive was that there was prior art which, although chronologically after a priority date, was prior to the filing date of the patent in suit and anticipated claim 1 of the patent in suit.

The Federal Court of Justice now ruled that a certain feature of claim 1 was not disclosed in the priority document. This feature concerned a certain design of hollow chambers in the connecting elements. This design was possible in principle, but:

“an embodiment [according to the claim was] also not directly and unambiguously disclosed because it was ‘read along’ by the skilled person without further considerations. Rather, the embodiment [according to the patent in suit] required independent technical considerations which would have gone beyond the direct and unambiguous disclosure content of the previous application. Whether these considerations were prompted by the [drawings in the patent] and possibly ob-

¹⁴ According to point 15 of the reasons for the decision in G 4/19 not subject of the decision

¹⁵ S. our newsletters [1/2018](#) and [10/2020](#)

¹⁶ FCJ, judgment of 20 May 2021, X ZR 62/19 - Bodenbelag/floor covering.

*vious with regard to the knowledge and skill of the skilled person is irrelevant.*¹⁷

As a result, the patent was declared null and void.

The decision shows that - despite the occasionally more generous line of the Federal Court of Justice compared to the European Patent Office as far as disclosure is concerned¹⁸ - it should also be ensured in German law that the priority application is not deviated from too far, provided that priority is to be maintained.

In our own affairs

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

Imprint:

Michalski · Hüttermann &
Partner Patentanwälte mbB

Speditionstrasse 21
D-40221 Düsseldorf
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
Tel +49 89 7007 4234
Fax +49 89 7007 4262

De-Saint-Exupéry-Str. 10
D-60549 Frankfurt a.M.
Tel +49 211 159 249 0
Fax +49 211 159 249 20

The content of this newsletter only reflects general information and does not constitute legal advice as per the German Legal Advice Act.

Despite thoroughly checking the content, Michalski · Hüttermann & Partner Patent Attorneys mbB does not assume any responsibility for the validity, accuracy, integrity or quality of the information above.

Photo:
Zolnierrek/Shutterstock.com

¹⁷ Paragraph 49 of the decision

¹⁸ e.g. in the decision "Teilreflektierende Folie" BGH Mitt. 2015, 559 - Partially reflective foil