

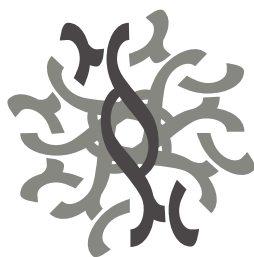


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G 1/21 - „the curtain has been closed,
(almost) all questions remain open“?

FCJ „Ultraschallwandler“ (ultrasonic transducer)
- concretization of the „Abdichtsystem“ (sealing system) decision



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

G 1/21 - "the curtain has been closed, (almost) all questions remain open"?

On July 16, only two weeks after the oral proceedings, the Enlarged Board of Appeal [published](#) its decision in the case G 1/21 on the question of the compatibility of videoconferences with Art 116 EPC; the complete decision, however, will be provided later.

The decision reads:

"During a general emergency affecting the parties'ability to participate in oral proceedings in person at the EPO premises, the conduct of oral proceedings before the Boards of Appeal in the form of a videoconference is compatible with the EPC, even if not all parties to the proceedings have given their consent to oral proceedings in the form of a videoconference."

Considering the course of the proceedings, in which - for the first time - members of the Enlarged Board of Appeal were considered to be biased¹ and the oral proceedings were adjourned², the decision is somewhat disappointing. The question had been whether videoconferences are generally compatible with the EPC if not all parties have agreed - the Enlarged Board of Appeal thus only partially answered this question.³

Consequently, the only thing that is clear is that during the current pandemic situation, oral hearings before the Boards of Appeal can be conducted by videoconference, regardless of the parties' position on the matter.

The President's orders regarding oral proceedings before the Examining Divisions⁴ and Opposition Divisions⁵ will probably also remain in place for the time being, even though the decision does not comment on this. However, if the oral proceedings before the Boards of Appeal (which are to be classified as higher-ranking) may already be conducted as a video conference during the pandemic, this will probably apply in exactly the same way to oral proceedings in the first-instance proceedings.

However, whether videoconferences do not require the consent of all even in the absence of a general emergency⁶ was not answered. However, this is most



In our own affairs

Patent attorneys Dr. Rolf Claessen and Dipl.-Ing. Robert Lange will strengthen our firm as of 01.08.2021.

Dr. Rolf Claessen will join us in Düsseldorf. In addition to his work as a patent attorney, he is also an author, lecturer and known to the general public through his participation in the Sat.1 show „Wie genial ist das denn ?!“, his Youtube channel and his podcast „IP Fridays“. He is the author of numerous articles in trade journals, online magazines and books.

Dipl.-Ing. Robert Lange will join us in Frankfurt a.M.. He worked as a project engineer in the automotive industry for many years until, after his patent attorney training, he worked for more than ten years as an in-house patent attorney. In particular, he has in-depth knowledge of employee invention law and contract law.

¹ s. our newsletter [6/2021](#)

² s. our newsletter [8/2021](#)

³ s. the G 3/19, see our newsletter [4/2020](#)

⁴ s. here: <https://www.epo.org/law-practice/legal-texts/official-journal/2020/12/a134.html>

⁵ s. here: <https://www.epo.org/law-practice/legal-texts/official-journal/2021/05/a41.html>

⁶ note: It is interesting that this was formulated in general terms

important for future practice before the European Patent Office, some observers see the strong position of Munich law firms in danger in the long run, should videoconferences become the rule.⁷ It is obvious that the Office is satisfied with the practice of conducting oral proceedings by videoconference and would like to maintain it if possible.⁸

The full decision can thus be eagerly awaited, and it is to be hoped that it will be more revealing than the decision itself - otherwise, another referral is probably only a matter of time.

FCJ “Ultraschallwandler” (ultrasonic transducer) - concretization of the “Abdichtsystem” (sealing system) decision

As already presented,⁹ in the “Abdichtsystem” decision the Federal Court of Justice had considered it possible in principle for a competitor to be entitled to injunctive relief under German law even if the competitor had not supplied to Germany or offered to supply in Germany at all, provided that the competitor was aware or must have been aware that this would be done by a customer.

In the recently published decision “[Ultraschallwandler](#)” (ultrasonic transducer)¹⁰, which was based on similar facts, the “Abdichtsystem” decision has now been further clarified. The subject of the dispute was an ultrasonic transducer as used in parking aids in automobiles. The ultrasonic transducers in question had been manufactured by the defendant in Asia, but customers of the defendant used them in automobiles that were also sold in Germany. The plaintiff now argued that this should have come to the attention of the defendant because it had supplied corresponding parts to Morocco, i.e. to a country close to the EU - and at the latest when it brought this to the attention of the defendant.

After the patent infringement was affirmed, the Federal Court of Justice now stated -in affirmation of the “Abdichtsystem” decision:

“Accordingly, a supplier of a product protected by a patent in Germany who is domiciled abroad and supplies a customer who is also domiciled abroad is not automatically obliged to check or monitor the further use of the supplied goods by the customer. However, such an obligation to verify or monitor may arise if there are concrete indications for him which make such actions appear obvious.”¹¹

One such clue had been the delivery to Morocco; in addition, the plaintiff had



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Our firm is [recommended](#) by iam magazine for the area of examination proceedings and nullity. Four partners, Dr. Aloys Hüttermann, Dr. Stefan Michalski, Guido Quiram and Dr. Dirk Schulz were included in the iam 1000, the list of the 1000 best lawyers in patent law worldwide.

⁷ s. our newsletter [3/2021](#)

⁸ s. e.g., <https://www.epo.org/news-events/news/2021/20210712.html>, see also the President's submission in G 1/21: <https://www.epo.org/news-events/news/2021/20210428.html>

⁹ s. our newsletter [4/2017](#)

¹⁰ FCJ judgment of June 8, 2021, X ZR 47/19 - Ultrasonic transducer

¹¹ para. 35 of the decision

written to the defendant. Accordingly:

"[the defendant] was thus at least obliged, after receipt of the letter [from the plaintiff], to point out to its customer [...] the possible patent protection in Germany and to inquire about deliveries there. Since this was not done, the defendant participated in the [...] infringing acts committed in Germany by its customer."

¹²

However, the plaintiff had requested that the defendant pay damages not with regard to this delivery, but also with regard to further possible deliveries, which might then have had reference to Germany. Accordingly, the court ruled that there was also a delivery to third parties *"who receive the converters at the instigation of the defendant and then offer them in Germany, use them, import them for the above-mentioned purposes or possess them."* ¹³



However, the Federal Court of Justice put a stop to this, see the headings of the decision:

"(a) If a manufacturer domiciled abroad has supplied products to a customer also domiciled abroad, although concrete indications made it appear obvious that the customer will offer the supplied product or place it on the market in Germany despite the existence of patent protection there, claims for injunctive relief, provision of information and damages exist with respect to other customers only to the extent that the same characteristic circumstances exist with respect to them that establish the illegality of the supply to the one customer.

(b) These circumstances shall be specifically set out in the application or in the statement of grounds for the application, as well as in a judgment upholding the application or in the grounds thereof."

In summary, this means: The fact that in individual cases also deliveries abroad - as far as it is obvious that the customers are active in Germany at this point - can be patent infringing, does not immediately mean that a quasi "general suspicion" exists as far as deliveries also to other customers are concerned.

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.

¹² para. 41 of the decision

¹³ para. 17 of the decision

Only if analogous circumstances are present, which must then also be specifically stated, a patent infringement can also be considered. Incidentally, this also applies to a tenor of the court. The general formulations used by the District Court and the Higher District Court in their judgments were thus also rejected and the matter was referred back to the Upper District Court.

In our own affairs

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

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