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G 1/21 – Full decision published

The Law Accompanying the Ratification of the
Unitary Patent System

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 – Full decision published

As already reported,¹ the Enlarged Board of Appeal had [published](#) its order in G 1/21 on the question of the compatibility of videoconferences with Art 116 EPC on July 16. In the meantime, the entire [decision](#) is also available. The order read:

„During a general emergency impairing the parties’ possibilities to attend in-person oral proceedings 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 of the parties to the proceedings have given their consent to the conduct of oral proceedings in the form of a videoconference”

The justification for the deviation from the reference questions was essentially this, that the situation during a pandemic is fundamentally different from the normal situation. If, even during a pandemic, oral hearings are only possible in personam, this means that, as a result, they will not take place at all as long as the situation does not improve. Under normal circumstances, on the other hand, a hearing would take place without any problems. In the opinion of the Enlarged Board of Appeal, this justifies a reformulation of the question referred.

To answer the question, it was first examined whether a video conference can be an oral hearing at all. In this regard, the Enlarged Board of Appeal noted that the question of what constitutes oral is not defined in the EPC, nor in the travaux préparatoires, nor has it been discussed. The referring board had stated in this respect that the legislators at the time had undoubtedly envisaged exclusively oral proceedings in presence, if only because the corresponding technical possibilities were not available in 1973.

The Enlarged Board of Appeal agreed, but not without adding that this was basically irrelevant:

„In the wider context of the EPC, the Enlarged Board notes that the object and purpose of the Convention is to provide a system for the grant of European patents with the aim of supporting innovation and technological progress. In the view of the Enlarged Board, it would be at odds with this object and purpose if the intention of the legislator was to exclude future formats for oral proceedings that might be made possible by technological progress.”

For this reason, oral negotiations during the pandemic would also be possible via video conference without the consent of the parties. However, it was clarified that in particular due to the potential technical complications that may arise during the negotiation, which may distract all parties from the actual issues to be discussed,³ as well as due to the poorer transparency, especially towards the public,⁴ videoconferences do not (yet) come close to oral negotiations in personam.

The bottom line:

„All in all, the Enlarged Board considers that the limitations currently inherent in the use of video technology can make it suboptimal as a format for oral proceedings, either objectively or in the perception of the participants, but normally not to such a degree that a party’s right to be heard or right to fair proceedings is seriously impaired.”⁵

¹ Cf. our [Newsletter 10/2021](#)

² Para 28

³ Para 38

⁴ Para 39

⁵ Para 43



In Our Own Affairs

Our firm is [ranked](#) in the current JUVE ranking for both patent filing and Litigation. Particularly recommended attorneys are: Dr. Uwe Albersmeyer, Dr. Aloys Hüttermann, Dr. Stefan Michalski, Guido Quiram, Dr. Dirk Schulz and Dr. Ulrich Storz.

For the current exceptional situation, video conferences are thus permissible even against the request of the parties.

The Enlarged Board of Appeal did not explicitly rule on the actually more decisive question of how to proceed after the pandemic. However, there are strong indications that it will again be possible to force oral hearings in personam after the end of the pandemic.

In this regard, the Enlarged Board of Appeal first states that, although oral proceedings are scheduled by the Board of Appeal, „...under the EPC it is a party's right to request oral proceedings. This demonstrates that the holding of oral proceedings is seen as serving the interests of the parties. The vast majority of oral proceedings are held upon request by a party. It therefore makes sense that the choice of format for these oral proceedings can be made by the party who requested them and not by the board of appeal, especially as this concerns more than just an organisational matter.“⁶

As mentioned, videoconferences are considered a worse alternative to in personam hearings. In order to be able to schedule a hearing by videoconference even against the request of a party, the following two conditions would have to be met:

First, negotiations by videoconference would have to be a suitable alternative to in personam negotiations and this is the case.⁷

On the other hand, it is stated that there must be specific circumstances that justify not holding the hearing on the premises of the EPO and these should be “limitations and impairments” of the possibility of participation of the parties. Mere organizational reasons are ruled out; it is the task of the European Patent Office to provide sufficient rooms such as translation facilities.⁸

However, the decision as to whether such restrictions existed was one to be made by the Board of Appeal.⁹

The second condition in particular will be decisive, but it seems clear from the wording (“limitations and impairments”) that e.g. longer journeys, for example from abroad, do not constitute such limitations. It is thus likely that after the pandemic situation has ended, in-person oral hearings will again be the rule, as they can be compelled by a party, although this will of course depend on the jurisprudence of the Boards of Appeal.

Although the decision does not comment on this, it can be assumed that the corresponding principles also apply to hearings before examination and opposition divisions.

As a result, the Enlarged Board of Appeal has thus established, if only implicitly, the future practice, which is unlikely to differ much from the pre-Corona era.

The Law Accompanying the Ratification of the Unitary Patent System

As reported and discussed several times both here¹⁰ and by other sources, Germany has meanwhile completed the ratification law for the unitary patent system and the protocol is also well on its way.¹¹

⁶ Para 46

⁷ Para 48

⁸ Para 49

⁹ Para 50

¹⁰ Cf. our [Newsletter 11/2021](#)

¹¹ Cf. our [Newsletter 12/2021](#)



So far, it has gone unnoticed that Germany has in parallel also implemented the necessary changes in national patent law, more precisely the Law on International Patent Conventions ("Gesetz über Internationale Patentübereinkommen", abbreviated IntPatÜG). The corresponding¹² accompanying law will thus be discussed in the following. It will become effective upon entry into force of the Convention¹³.

The most drastic and important amendment, which had already been part of the accompanying law to the (failed) first ratification¹⁴, is the abolition of the prohibition of double protection for unitary patents and nationally validated European patents, the latter, however, only if no "opt-out" request is filed. For this purpose, Article II, §8 IntPatÜG is amended accordingly, a prohibition of double protection thus applies in case of a European patent which *"is not subject to the exclusive jurisdiction of the Unified Patent Court due to a request¹⁵ according to Article 83 (3) of the Agreement on the Unified Patent Court."*

In this regard the following is important:

- If the "opt-out" request is withdrawn, which is possible under Rule 5.9 UPCA, the prohibition of double protection nevertheless remains, as explicitly stated in the new paragraph 2 of Article II, §8 IntPatÜG. Applicants must thus decide.
- The provision refers to an effective opt-out ("subject to"). If the opt-out request is not valid because it is defective - which is not fully checked at registration, there is only a cursory check - the double protection prohibition does not apply.
- The law clarifies through a newly inserted section (Article XI, §5) that the lifting of the double protection prohibition is not retroactive. Only national patents for which the publication date of grant is after the effective date of the law (= effective start date of the unitary patent system) will benefit.
- In order to prevent a patent proprietor from "shooting twice", a defense of double claiming was included (Article II, §18 IntPatÜG), according to which a national patent infringement action, if a substantively identical action exists before the Unified Patent Court, is inadmissible if the defendant complains about this *"at the first date from the accrual of the defense until the beginning of the oral proceedings on the merits"*. The reverse case, i.e. an action before the Unified Patent Court is filed although there is already a pending German action, is not regulated (due to lack of competence); here the Unified Patent Court would then have to dismiss the action, e.g. on the basis of a preliminary objection under Rule 19 UPCA.

In particular, the fact that the prohibition of double protection is not retroactively lifted means that in ongoing German proceedings - if parallel European IP rights or IP applications exist - consideration should be given to delaying the proceedings until the unitary patent system enters into force and, if necessary, filing an appeal against the grant.

Since this could lead to numerous appeals being filed at the GPTO purely to gain time, the GPTO should consider giving applicants the option of filing a request by which the GPTO would not publish the grant until after entry into force in the case of corresponding applications. However, corresponding initiatives are not known, but would make life easier for both the Office and the applicants. Our partner Andreas Gröschel, who is a member of the User Advisory Council of the GPTO, has already contacted the Office in this regard. We will keep you informed.

¹² Full Title: „Gesetz zur Anpassung patentrechtlicher Vorschriften aufgrund der europäischen Patentreform“ of 20. August 2021, Bundesgesetzblatt Teil I Nr. 59, S. 3914

¹³ Note: Except for an editorial change to the IntPatÜG, which is, however, insignificant for the practice.

¹⁴ Cf. Hüttermann, Einheitspatent und Einheitliches Patentgericht, Heymanns 2016, para 167 ff

¹⁵ Note: This is the „opt-out“ request

In Our Own Affairs

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

Impressum:

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 München
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

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