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The “CRISPR-Cas” decision T 844/18 now published

Germany introduces the repair clause in design 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

The “CRISPR-Cas” decision T 844/18 now published

Now, more than nine months after the pertinent Board of Appeal 3.3.08 rejected the appeal against the decision of the Opposition Division¹ in the first “CRISPR-Cas” case in January, the full decision has finally been published.²

In view of the commotion caused by the proceedings, the fact that this decision was internally placed in the lowest category “D,” which is to say it will not even be sent to the chairmen of the other Boards of Appeal, is surprising enough.

Even though the proceedings were unusually extensive, with nearly 300 documents discussed and ten parties, it ultimately came down to one simple question, as the Board of Appeal itself explains:

“A and B are applicants for the priority application. A alone is the applicant for the subsequent application. Is a priority claim valid even without any assignment of priority right from B to A?”³

The patent proprietor’s opinion was “yes,” but the opponents and, in the end, both the Opposition Division and the Board of Appeal held the opposite view.

Thus, the Board of Appeal ultimately continued the line of reasoning of previous decisions, most notably the decision T788/05, in which the so-called “all applicants” approach was established. This approach ultimately means that when a previous priority application has multiple applicants, a valid claim of priority requires that all of these applicants must either be named on the subsequent application or have assigned their right of priority for the priority to be valid.

That was not the case here, so the applicant’s own intervening publications were ultimately destructive to the novelty of the patent.

On this point, in addition to discussing the case law of the European Patent Office itself, the Board of Appeal also discussed the wording of the Paris Convention and the interpretation of both texts in light of the Vienna Convention on the Law of Treaties, and came to the following conclusion:

“Thus, although arguments can be made for the appellants’ “one or more applicant” approach, stronger arguments for the “all applicants” approach can be made and the “all applicants” approach has been applied, as far as the Board can determine, without exception since at least the early twentieth century by states that are currently member states of the EPC, and by the EPO since its inception.”⁴

Analogous possible alternative approaches in national law (an English and a Swiss decision were cited here), were rejected.

In addition, the Board of Appeal very clearly expressed its opinion on the question of whether the EPO is empowered to examine priority in the present circumstances.



In our own affairs

Our firm is mentioned once again in the new JUVE Handbook 2021. JUVE confirms that our regular clientele has confidence in our firm’s prosecution work in a broad technical range in an impressive number of oppositions and nullity actions as well as in a growing number of infringement proceedings. This prominent litigation activity underscores the firm’s good market position in western Germany, where it is among the three largest patent law firms. You can read more [here](#).

¹ See our [Newsletter 1/2018](#)

² See: [http://documents.epo.org/projects/babylon/eponet.nsf/0/22848DBA6784C-883C1258617004D48BB/\\$File/0844.18.3308\(decision\).pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/22848DBA6784C-883C1258617004D48BB/$File/0844.18.3308(decision).pdf)

³ IX of the decision, page 3.

⁴ Paragraph 86 of the decision

Referring to Art 60(3) EPC among other sources, the appellant had argued here that the EPO does not examine the entitlement of applicants to file. There is no provision for entitlement or vindication proceedings in the EPC, but instead, corresponding national proceedings are recognized under Art 61 EPC.⁵ This question was also at least mentioned in a Board of Appeal decision T239/16, although it was not material to the decision in the end.

Ultimately, however, the Board of Appeal confirmed the previous line of reasoning of the European Patent Office, according to which the EPO is empowered to fully examine priority.⁶

In summary, this decision signifies a clear continuation of T 788/05, in particular, which may be the reason this decision was rated by the Board of Appeal as not meriting further dissemination.

It should be noted that the patent proprietor is rumored to at least have considered filing a petition for review under Art 112(1) EPC; it remains to be seen whether and how such a petition will be filed.⁷

MH Partner Dr. Ulrich Storz was one of nine opponents in the present proceedings.

Germany introduces the repair clause in design law

In passing the “law to strengthen fair competition,”⁸ Germany has adopted the repair clause from EU law in design law.

This is very surprising in that Germany was an avowed opponent of such a regulation for decades. For example, Germany blocked an initiative of then-Commissioner Fritz Bolkestein that would have made implementation of a repair clause in national design laws mandatory by EU regulation until Bolkestein's successor Verheugen ultimately terminated this initiative.

The “law to strengthen fair competition” actually relates to competition law and serves the purpose of making life more difficult for lawyers who abuse warning letters and making it more difficult to send mass warning letters. To this end, the so-called “flying jurisdiction” was largely eliminated, for example, and rules on reimbursement of costs were introduced that are intended to make such warning letters less attractive.⁹

In the same legislative procedure, the passage from EU Directive 98/71/EC that provides no design protection for repair parts was introduced more or less as an “appendix.” The Directive had previously left it up to member states whether or not to introduce such regulation. The full text of the corresponding Section 40(a) reads:

“(1)No design protection shall be conferred for a design that is built into or applied to a product and that is a component of a complex product and that is used solely with the goal of permitting repair of this complex product in order to restore its original appearance. This

⁵ On this point, see also our [Newsletter 4/2018](#)

⁶ Paragraph 24 of the decision

⁷ On this point, see, for example, *Hüttermann/Malessa/Sommer*, GRUR 2014,448

⁸ F or the draft bill, see: <http://dipbt.bundestag.de/dip21/btd/19/120/1912084.pdf>

⁹ For one of many discussions of the law (in German), see: <https://www.lto.de/recht/kanzleien-unternehmen/k/aenderung-uwg-abmahnungen-missbrauch-anwalt-internet/>



does not apply when the primary purpose for which the said component is placed on the market is a purpose other than the repair of the complex product.

(2) Paragraph 1 shall only apply if consumers are properly informed of the origin of the product used for repair purposes by the use of labeling or by other suitable means so that they can choose among competing products for repair purposes with knowledge of the state of affairs."

However, this repair clause under Section 40(a) of the law does not apply to designs registered prior to 1 January 2020.

Of course, the introduction of this clause means a worsening of the position of applicants for German designs, for one thing. While German designs were previously excluded from the repair clause, this will no longer apply in future. One consequence could of course be that the previous trend of directly registering European designs instead of German designs will continue to grow due to this reduced attractiveness.

As already mentioned, German case law in corresponding EU design infringement proceedings has accorded great weight to the second paragraph, in particular, which states that consumers must be clearly notified of the repair purpose.¹⁰ This will now apply to corresponding proceedings, as well.

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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¹⁰ See our [Newsletter 5/2018](#)