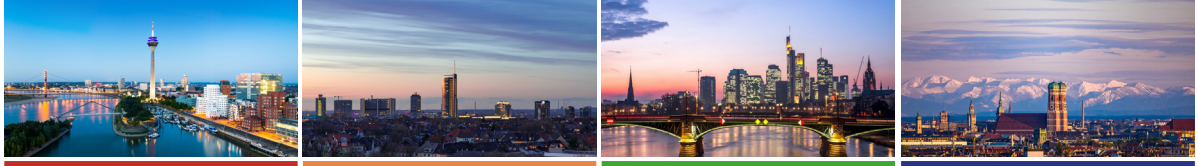

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Germany ratifies the Unitary Patent System

Referral to the Enlarged Board of Appeal concerning plausibility

Two decisions of the Federal Court of Justice concerning inventive step

MICHALSKI · HÜTTERMANN

PATENTANWÄLTE

Germany ratifies the Unitary Patent System

After the Federal Constitutional Court cleared the way for the unitary patent system on July 9[1] this year, Germany has now officially approved both the Agreement on the Unified Patent Court and the Protocol with the „Gesetz zu dem Übereinkommen vom 13. Februar 2013 über das Einheitliche Patentgericht" (Law on the Agreement on the Unified Patent Court of February 13, 2013)[2] on August 7.

As soon as two more states[3] now ratify the protocol, the so-called „protocol phase" can begin, during which the court will carry out the necessary preparations, especially the recruitment of judges. In consultation with the court, Germany will then deposit the ratification, whereupon „on the first day of the fourth month after the deposit" (Art. 89) the court will begin its work.

Albeit with a long delay, Germany has now done everything that is currently necessary; it is now up to other member states to let the protocol phase begin, and it is to be hoped that the two further necessary approvals will be given soon.

In our own affairs

Dr. Aloys Hüttermann will speak on September 6 at the GRUR district group Berlin in Berlin and on September 28 at a joint webinar of the VPP district groups Mitte-West and Mitte-Nord on the topic „Per aspera ad astra - Das Einheitspatentsystem kommt" (Per aspera ad astra – the Unitary Patent System is coming)

Referral to the Enlarged Board of Appeal concerning plausibility

In appeal T116/18, the competent Board of Appeal T 3.3.02 referred questions to the Enlarged Board of Appeal concerning the so-called plausibility. The reason for this was opposition proceedings in which the patent proprietor had referred to experimental data to support a synergistic effect - and thus to substantiate an inventive step - which had only been submitted in the opposition proceedings. The appellant had thereupon requested that this data not be admitted to the proceedings, but be rejected as late filed.

The Board of Appeal now decided[4] that a) the decisive factor for patentability was whether or not this data was to be admitted into the proceedings, and b) that the Enlarged Board of Appeal would have to be asked whether this was permitted.

Thus, a referral was decided with the preliminary questions:

" If for acknowledgement of inventive step the patent proprietor relies on a technical effect and has submitted data or other evidence to proof such effect, such data or other evidence having been generated only after the priority or filing date

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1 s. our newsletter 9/2021

2 Bundesgesetzblatt Jahrgang (German Law Gazette) 2021, Teil II Nr. 18, S. 850

3 For the current ratification status cf https://www.consilium.europa.eu/en/documents-publications/treaties-agreements/agreement/?id=2015056

4 Remark: As can be taken from the minutes, the full decision is not yet published

of the patent (post-published data):

1. Should an exception to the principle of free evaluation of evidence (see e.g. G 1/21 reasons 31) be accepted in that the post-published data must be disregarded on the ground that the proof of the effect rests exclusively on such post-published data?

2. If the answer is yes (post published data must be disregarded if the proof of the effect rests exclusively on these data): can post-published data be taken into consideration if based on the information in the patent application the skilled person at the relevant date would have considered the effect plausible (ab initio plausibility)?

3. If the answer to the first question is yes (post published data must be disregarded if the proof of the effect rests exclusively on these data): can post-published data be taken into consideration if based on the information in the patent application the skilled person at the relevant date would have seen no reasons to consider the effect implausible (ab initio implausibility)?"

However, the parties suggested some changes, so that the final questions may be slightly different. The reference will probably be given the file number G2/21.

After excitement grew high[5] in 2017 about plausibility and its possible introduction in the context of the jurisprudence of the Boards of Appeal, it had been somewhat quieter since then - also in the absence of a referral already expected6 at that time, but which had not been made. Now the topic is back on the agenda with a bang and the decision of the Enlarged Board of Appeal can be eagerly awaited. It has the potential to make the commonly used filing strategies before the European Patent Office in the chemical/biotech field completely obsolete. In view of the importance of the issues presented, the Enlarged Board of Appeal cannot be envied for its task of reaching a balanced result here.

Two decisions of the Federal Court of Justice concerning inventive step

In two recently published decisions, the Federal Court of Justice commented on inventive step, more precisely on the question to what extent the person skilled in the art would or would not use certain means.

The first decision is called „Laufradschnellspanner"[7] (wheel quick release) and concerned a patent on a quick release for bicycles. Here it had been the case that the cited prior art was already very old, partly from the 1940s and 1950s. This applied both to the "closest prior art" (even if, according to the case law of the Federal Court of Justice, this does not actually exist) and to the documents that were to be combined with it.

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5 cf. our Newsletter 5/2017

6 cf. Exner/Hüttermann, GRUR Int 2018, 97

7 FCJ, Decision of 15. June 2021 - X ZR 61/19 - Laufradschnellspanner

The Federal Court of Justice now ruled that if a principle, which has been known for a long time, is to be replaced by another principle, which has also been known for a long time, this is possible, but only if a correspondingly clear suggestion is recognizable to the skilled person:

"If a functional principle has been known for many decades in its own right, an additional suggestion is usually required to apply this principle for the first time to devices whose purpose, structure and mode of operation have also been known for many decades."[8]

As a result, inventive step was affirmed. In a similar, albeit not identical case, the decision "Gestricktes Schuhoberteil" [9] (Knitted shoe upper), which also dealt with the extent to which very old prior art had to be taken into account, the Federal Court of Justice had reached a different conclusion. Unfortunately, this decision is neither cited nor discussed in the "Laufradschnellspanner" decision, so it remains to be seen how the Federal Court of Justice will classify the relationship of the two decisions.

The second decision is called „Führungsschienenanordnung"[10] (Guide rail arrangement) and concerned guide rails for roller blinds in motor vehicles; specifically, the issue here was whether it was obvious to provide a certain part of the guide rail in two parts instead of in one part as in the prior art. The Federal Court of Justice has now ruled that such a two-part design may be suggested, even if this may entail disadvantages:

"If a certain means, as a general means to be considered for a multitude of cases of application, belongs by its nature to the general technical knowledge and also presents itself as objectively expedient in the concrete context to be judged, an application is not unfeasible from a technical point of view merely because this means generally has certain disadvantages or because other embodiments can also be considered in the concrete context."[11]

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). If the pandemic situation allows, these 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 primarily 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.

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8 Headnote of the decision

9 FCJ, Decision of 31 January 2017 – X ZR 119/14 – Gestricktes Schuhoberteil

10 FCJ, Decision of 15. June 2021 - X ZR 58/19 - Führungsschienenanordnung

11 Headnote of the decision

As a result, this naturally means that attacks based on lack of inventive step are facilitated and this decision could thus prove to be the more relevant of the two in practice. Whether this will result in a general weakening of the position of patent owners, however, remains to be seen.

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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