

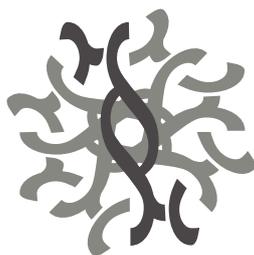


Newsletter Edition 14/2021

Düsseldorf/Essen/Frankfurt/Munich, 6 December 2021

Austria ratifies the Protocol to the UPC,
Protocol phase will start soon

The Federal Court of Justice on procedural law and on
publicity



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

Austria ratifies the Protocol to the UPC, Protocol phase will start soon

On December 2, Austria was the last necessary state to ratify the Protocol¹ to the Unified Patent Court. In the session of the Bundesrat a unanimous approval was given, after the National Council had already unanimously approved the Protocol before.

A formal ratification and deposit is expected in the near future, on the following day, according to Article 3, the Protocol will enter into force and the so-called "Protocol Phase" will begin. As a result, it will then be possible for the Unified Patent Court to officially appoint judges, so that when the Agreement enters into force and the Unified Patent Court starts its work, it will be ready to do so.

Prof. Dr. Aloys Hüttermann will be a speaker at the [PATENTE 2022](#) on February 2, 2022, on the topic „The Unitary Patent System is Coming - For Real This Time?“

Since it has been several years since the last round of applications, it has been suggested by some observers that a second round of applications with a short deadline should be held, but it is unclear at this time if and how this is planned.

As mentioned,² during the protocol phase it will be possible to enter "opt-outs", i.e. declarations under Article 83(3) of the Agreement that the Unified Patent Court should not have jurisdiction over a specific patent, but not immediately.

Here it is heard that the original planning from 2017, which provided that the period for this, also often called the "sunrise period", should begin about three months before the final entry into force, is still valid. "Opt-outs" could thus not be registered until the spring or summer of next year, shortly after the deposit of Germany's ratification of the Agreement on the Unified Patent Court.³

Furthermore, it is not planned on the part of the Unified Patent Court to make "opt-outs" of several or a large number of patents feasible by means of reading in lists, etc. Instead, the Unified Patent Court has published the API file for the "opt-out" system and it is up to users to create appropriate programs that will then automatically enter "opt-outs" for patents, one at a time.⁴

Likewise, it is currently unclear when European Patent Attorneys will be able to have their European Litigation Certificate courses registered. Hopefully, the Preparatory Committee will comment on all of these issues in the near future.

With the imminent introduction of the Protocol, another essential step towards the introduction of the Unitary Patent System has been taken and an introduction in 2022 or 2023 at the latest can now almost certainly be expected.

¹ Exact title: „Protocol to the Agreement on a Unified Patent Court on provisional application“, cf. our Newsletters [9/2021](#), [11/2021](#) and [12/2021](#)

² Cf our Newsletters [9/2021](#), [11/2021](#) and [12/2021](#)

³ Cf our Newsletters [9/2021](#) and [11/2021](#)

⁴ Note: Our law firm (lead: Prof. Dr. Aloys Hüttermann and Dr. Rolf Claessen) is planning a corresponding software project together with the Hochschule Niederrhein; we will report on the progress in this newsletter.

The Federal Court of Justice on procedural law and on publicity

In three recently published decisions, the Federal Court of Justice has commented on procedural law in nullity proceedings and once on the question of publicity, i.e. when a particular document has become prior art.

The first decision⁵ is entitled "[Oszillationsantrieb](#)" (Oscillation Drive) In this case, four plaintiffs had filed nullity suits against a patent in nullity proceedings, but the Federal Patent Court had dismissed the action. All four plaintiffs then appealed, but one of them went bankrupt shortly thereafter.

The Federal Court of Justice now ruled as follows:

- It is true that in parallel actions for nullity, the plaintiffs are necessary co-joined parties under § 62 of the ZPO (the German code of civil procedures), since the decision must be issued uniformly.
- At present, it is not clear what will happen to the insolvent plaintiff and the proceedings are interrupted due to the initiation of insolvency proceedings pursuant to § 240 ZPO.
- In spite of the necessary joint litigation, however, it was possible and also expedient to continue proceedings with regard to the action of the three remaining plaintiffs by means of a partial judgment, since this was at the discretion of the court.

In the end, this is what the Federal Court of Justice did, and in its partial judgment it dismissed the action in exactly the same way as the Federal Patent Court had previously done, i.e. the patent remains in force unchanged.

This ruling is straightforward and will in future lead to proceedings being continued in appropriate constellations, even if one invalidity plaintiff out of several goes into insolvency.

The second decision⁶ is called "[„Bediengerät für Spiele“](#)" (Operating device for games). Here it had been the case that the Federal Patent Court had upheld an attacked patent in suit in an amended version. Since the nullity plaintiff had declared that it did not wish to attack the patent as amended, no further decision had been made on this.

Wasilis Koukounis LL.M. will be moderator and Prof. Dr. Aloys Hüttermann speaker at the first VDI/VPP conference on the unitary patent system, which will take place at the Industrieclub Düsseldorf on February 9/10, 2022. More information and the possibility to register can be found [here](#).

⁵ Bundesgerichtshof, Teilurteil vom 24. August 2021 - X ZR 59/19 - Oszillationsantrieb

⁶ Bundesgerichtshof, Urteil vom 3. August 2021 - X ZR 71/19 – Bediengerät für Spiele.

Both the nullity plaintiff and the patent proprietor appealed.

The Federal Court of Justice now ruled:

- In principle, the invalidity plaintiff's appeal was actually inadmissible as it was not adversely affected, because:

"In the oral proceedings before the Patent Court, the plaintiff stated, as shown by the minutes, that it was not attacking the patent in suit in the version defended by auxiliary request 1.

Thus, the plaintiff expressed that it no longer pursued its written request for a complete declaration of invalidity, but only sought a declaration of invalidity to the extent that the subject matter of the patent in suit went beyond the version defended by auxiliary request 1 at first instance.

*The patent court has fully complied with this limited claim."*⁷

Since the relief sought was granted in its entirety, the invalidity plaintiff's appeal was thus (actually) inadmissible.

- The patent proprietor's appeal, on the other hand, was admissible and a corresponding request by the nullity plaintiff fell flat. If a patent proprietor defends a patent in a limited way in the alternative, it is of course permissible for it to attempt on appeal to obtain maintenance with broader scope, ideally as granted.
- As mentioned, the plaintiff's appeal was deemed inadmissible. However, since the patentee had also appealed, this was reinterpreted a cross-appeal:

*"The inadmissible appeal of the plaintiff may [...] not be dismissed because it can be reinterpreted as an admissible cross-appeal."*⁸

The nullity plaintiff was thus lucky - but rather lucky in bad luck, because in the result the Federal Court of Justice followed the patentee's appeal and upheld the patent in its entirety.

Plaintiffs in nullity suits are therefore well advised to be careful with corresponding statements that they do not want to proceed against certain versions of a patent.⁹

Dr. Stefan Luginbühl and Prof. Dr. Aloys Hüttermann will be speakers at a webinar of the Japan External Trade Organization JETRO on „Preparing for the start of Unitary Patent (UP) and Unified Patent Court (UPC) system“ on December 17, 2021.

⁷ Note 10- 12

⁸ Note 152. It should be noted that a corresponding request had also been made by the plaintiff.

⁹ Note: It was not considered to what extent such statements can otherwise no longer be challenged in good faith, cf. the decision "Weichvorrichtung" (BGH X ZR 6/91 "Weichvorrichtung"- GRUR 1993, 886).

The last¹⁰ of the three decisions is called „[Diskontinuierliche Funkverbindung](#)“ (Discontinuous Radio Link) and concerns both procedural and substantive law.

Here it was the case that in nullity proceedings there were several nullity plaintiffs as well as an intervener.

All of them had filed appeals after the Federal Patent Court had declared the patent in suit only partially invalid. The intervener, however, had missed the deadline for filing the grounds of appeal, but the invalidity plaintiffs had been granted an extension of the deadline for filing the grounds of appeal.

The Federal Court of Justice now stated that although the intervener was a party to the appeal, the admissibility of the appeals filed had to be assessed separately. The intervener could therefore not benefit from the extension of time granted to the invalidity plaintiffs, and its statement of grounds was thus late filed. However, the intervener was fortunate in that its application for *restitutio in integrum*, which had also been filed, was granted.

This will probably only be relied upon in the rarest of cases in analogous constellations, so in the future it will be the case that every nullity plaintiff and intervener will have to monitor their deadlines very closely.

In the ruling, the Federal Court of Justice also commented on whether a particular document had become prior art. This document had been discoverable on an ftp server of a standardization body before the priority date. The patentee had now argued that this was not public domain, in particular because standard search engines would not have been able to find this document. But this would be irrelevant, the Federal Court of Justice ruled:

“The [relevant] document was publicly accessible before the priority date of the patent in suit because, according to the patent court’s findings, which are not challenged in this respect and are correct, it was stored on the ftp server of the 3GPP standardization body on July 5, 1999, where it was available for retrieval.

It can be left open whether every document available on the Internet is readily accessible to the public or whether additional resources are required to make accessibility possible. Contrary to the view of the defendant, it is in any case not absolutely necessary that the document can be found by entering suitable search terms in a search engine. Rather, it is sufficient if the document can be accessed via a directory that is known to the public as a storage location for subject-related publications and is available as a source of information.

The latter requirement is fulfilled in the case in dispute. Therefore, there is no need to clarify the question of whether common search engines were already able to index Word documents stored in a zip file before the priority date.”¹¹

On December 1, 2021, the Hochschule Niederrhein appointed Dr. Aloys Hüttermann as honorary professor. Prof. Dr. Aloys Hüttermann, as he may now call himself, had been a lecturer there since 2014.

¹⁰ Bundesgerichtshof, Urteil vom 13. Juli 2021 - X ZR 81/19 -Diskontinuierliche Funkverbindung

¹¹ Note 83 bis 85

The decision of the Federal Court of Justice is not surprising in this respect and is in line with the previous opinion, according to which unhindered access is essential for establishing public access and not whether an expert would actually have found the document in question. It is interesting to note that the Federal Court of Justice also cited an analogous decision of a Board of Appeal of the European Patent Office¹² in this regard.

However, this was of little help to the plaintiffs and the intervener in the end; even though this document had now become prior art, the Federal Court of Justice did not change the decision of the Federal Patent Court and instead dismissed the appeal.

In our own affairs

We wish your relatives, employees, colleagues and, of course, yourself all the best for the current, still difficult time and only the best for 2022.

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¹² T 1460/10, s. Note 86