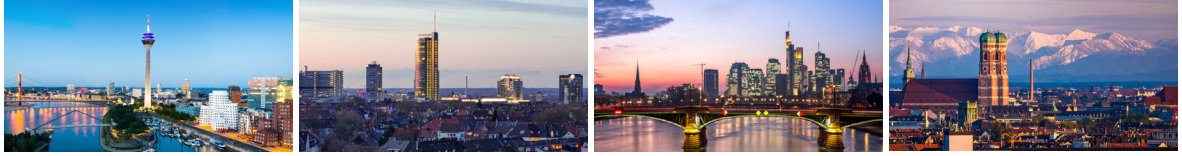

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A New Referral (G 3/19) is Submitted to the Enlarged Board of Appeal of the EPO by the President in Connection with Case T 1063/18

Federal Supreme Court Raises Admissibility Requirements in Nullity Appeal Proceedings

MICHALSKI HÜTTERMANN

PATENTANWÄLTE

A New Referral (G 3/19) is Submitted to the Enlarged Board of Appeal of the EPO by the President in Connection with Case T 1063/18

Ever since the issuance of Decision T 1063/18, in which Rule 28(2) of the EPC was declared inapplicable[1], new developments have been coming thick and fast. Following initial considerations on the possibility of amending Article 53 of the EPC[2], the President of the EPO has now put a referral to the Enlarged Board of Appeal as a sort of compromise. This means that an amendment of the EPC no longer appears likely for now. Having been assigned Docket No. 3/19, the proceeding represents the fourth question[3] on points of law to be referred to the Enlarged Board of Appeal within a brief time span. Concomitantly, all relevant application and application-appeal proceedings have been suspended.

The questions referred by the President are as follows:

1. Having regard to Article 164(2) EPC, can the meaning and scope of Article 53 EPC be clarified in the Implementing Regulations to the EPC without this clarification being a priori limited by the interpretation of said Article given in an earlier decision of the Boards of Appeal or the Enlarged Board of Appeal?

2. If the answer to question 1 is yes, is the exclusion from patentability of plants and animals exclusively obtained by means of an essentially biological process pursuant to Rule 28(2) EPC in conformity with Article 53(b) EPC which neither explicitly excludes nor explicitly allows said subject-matter?

Here the President is addressing one of the key questions raised in the proceeding leading up to Decision T 1063/18: i.e. whether or not it is possible to change the Enlarged Board of Appeal's interpretation of an article by making an amendment to the rules of the EPC. That this was impossible was simply assumed in Decision T 1063/18, even though the Enlarged Board of Appeal had never issued a corresponding decision on this point, and despite the fact that Decision T 39/93, which was specifically cited in this context, had failed to conclusively settle the issue.[4]

Recall that a referral by the President is only possible if there are two diverging decisions. Accordingly, the President now cites Decision T 315/03, inter alia. Yet the upshot of this decision was interpreted in a wholly contrary manner in a previous internal document[5], namely to confirm that the Enlarged Board of Appeal would not be able to reject an article's interpretation even by introducing a rule. Another decision cited by the President, T 991/04, seems less relevant here, since it (correctly) states that while the Boards of Appeal have the competence to interpret the Articles of the EPC, they must also adhere to any corresponding provisions which said rules may contain. But it has nothing further to say about any previous – and thus potentially higher-ranking – decisions handed down by the Enlarged Board of Appeal. It therefore remains to be seen whether the Enlarged Board of Appeal may actually reject the referral as inadmissible, as it did in Opinion G 3/08, for example.

[1] See our June 2018 Newsletter.
[2] See our February 2019 Newsletter.
[3] See our February 2019 and March 2019 Newsletters.
[4] Note: A separate article on this issue is in preparation.
[5] Document CA/PL 4/17.

In Our Own Affairs

The next Rhineland Biopatent Forum will be held on 6 June 2019 at the Dusseldorf offices of our law firm.
If you wish to participate in this free-of-charge seminar, please contact us by email at seminar@mhpatent.de.

On 2 May 2019, Dr Aloys Hüttermann will present a lecture at the 8th European Conference of the IPO in Basel, Switzerland on the topic 'An Institutional Patent Theory and Why a Different View on Patents May Help.'

Our firm is looking for patent attorneys (male/female/diverse), particularly in the field of information technology as well as candidates (male/female/diverse) for all other fields. If interested, please contact Ms Judith Felsner at bewerbung@mhpatent.de.

Although the circumstances of the case are anything but fortunate, especially in terms of the political distortions involved – the Anglo-Saxon legal adage 'hard cases made bad law' comes to mind – the President's referral is to be welcomed on the whole, inasmuch as it serves to clarify a fundamental question concerning the legal architecture of the European Patent Office. It remains to be seen what the Enlarged Board of Appeal will make of it.

Federal Supreme Court Raises Admissibility Requirements in Nullity Appeal Proceedings

The Federal Court of Justice's recent Decision X ZR 37/17 in the Eierkarton ("Egg Carton") case examined the extent to which a patent-nullity appeal may be inadmissible. In the underlying case, a patent holder in a nullity proceeding had defended his patent according to the main request in the same form in which the patent had been granted, as well as in a limited form on the basis of several auxiliary requests. The Federal Patent Court had nonetheless declared the patent null and void and, in particular, had held that the set of claims asserted in the main application were not new as far as to two specific documents were concerned. Yet the patent holder had discussed only one of the two documents in his grounds for appeal; when it came to the other document, he had merely cited his pleadings in the first instance. It was not until the later course of the proceeding that he had presented a more detailed statement of position in this regard.

Thus, the Federal Supreme Court has now ruled that the appeal is inadmissible with regard to the main application: *The appeal is inadmissible if the patent holder, having lost the patent-nullity proceeding before the patent court, submits grounds of appeal which fail to challenge each one of the independent and separately supporting legal considerations that were adduced in the judgment under appeal in order to justify the complete or partial nullity of the patent.* Thus, the preconditions for the admissibility of an appeal have been significantly increased and one would be well-advised to draft one's grounds of appeal for a nullity appeal proceeding a good deal more thoroughly than was perhaps the case till now, while also taking care to avoid referrals to previous replies in the first instance.

Two further points bear noting:

- As the decision makes clear, the Federal Court of Justice draws a sharp distinction between the admissibility of the various requests, given that the appeal was not dismissed in its entirety. Rather, the nullity appeal with respect to the first auxiliary application – which the Federal Patent Court had also deemed to be non-patentable – was not only admitted but also proved successful on the merits, so that the patent was ultimately upheld in the version of the first auxiliary request. It remains to be seen whether this means that the converse is also true, i.e. that an appeal in respect of individual auxiliary requests may be contestable in the future even after the appeal in respect of the main request has been held to be admissible.

- These heighted preconditions for admissibility are in line with the planned revision of the Rules of Procedure of the Boards of Appeal of the European Patent Office. Here too, a statement of grounds that is merely incorporated by reference – whether in the grounds of appeal pursuant to Article 108 EPC or in the reply of the appeal respondent – will probably not be considered to be a part in the proceeding except in special cases. Thus, a detailed statement of grounds without references is advisable in this context as well.

In Our Own Affairs

In 2019, as in previous years, Michalski Hüttermann & Partners will once again offer two gratis preparatory courses, lasting two days each, for Parts C and D of the European qualifying examination (EQE). The first course will take place on 30 November and 1 December 2019 and the second on 12 and 13 December 2019.

The course content will focus on useful test-taking techniques and error-avoidance strategies – skills that can be applied to successfully tackle Parts C and D of the EQE exam. Our experience has shown that well-prepared study materials can significantly increase the chances of success and our aim is to impart the necessary test-taking skills to the course participants. Inasmuch, the course should be seen as supplementary to a substantive study of the EPC's underlying legal principles. The participants learn how to apply their technical knowledge of the EPC in as many practical points as possible so as to maximize their chances of passing Parts C and D of the EQE examination.

The courses will be conducted at the Dusseldorf offices of our law firm and are free of charge. The course lecturers will be Dr Torsten Exner, Dipl.-Ing., Andreas Gröschel and Dr Aloys Hüttermann. The teaching language will be German.

You may send our regist ration request to at eqe@mhpatent.de (Please be sure to state your full name and your employer as well as the desired date.)

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