



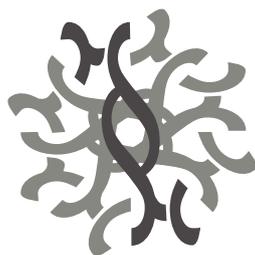
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DPMA allows delayed grant to benefit
from double protection

FCJ decision „Windturbinenschaufelmontage“ concerning the possibilities of further submissions in nullity appeal proceedings

FCJ decision „Aminosäureproduktion“ concerning the right to sue



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

On the initiative of our law firm: DPMA allows delayed grant to benefit from double protection

With the entry into force of the unitary patent system, the previously applicable prohibition of double protection will be lifted¹ in Germany, provided that

- a) the publication of the grant of the German patent concerned took place after the Unified Patent Court entered into force, and
- b) no "opt-out" is requested for the European patent in question.

Since the former is in the hands of the DPMA, MH partner Andreas Gröschel had suggested in internal office consultations² with users of the German patent system that the DPMA should create a request option to delay the grant of German patent applications so that they could then benefit from the double protection.

We are pleased to report that with [Notice 6/22](#) the President of the DPMA has complied with this suggestion. Accordingly, for applications that are in the examination procedure and for which a parallel European patent has already been granted, it is possible to request:

- (a) to extend the time limit for an examination communication that is still open; and
- b) to defer the decision on grant of an application for which there is no open office action. By its very nature, this request is no longer possible if a corresponding decision to grant has already been taken.

The maximum extension of the time limit that can be requested or the deferment to be granted is eight months, four months after the deposit of Germany's instrument of ratification³ with the EU. In the request, applicants are asked to provide

Preparation courses for the C- and D-part of the European Qualifying Examination

If the pandemic situation allows, our office will offer two free two-day preparatory courses for the C and D parts of the European Qualifying Examination (EQE) in 2022. The courses will be held on Thursday/Friday, November 24/25, and Saturday/Sunday, December 10/11, 2022. Both courses are identical in content, so attendance at one course is sufficient.

The course content is mainly focused on appropriate exam techniques as well as strategies to avoid mistakes in order to successfully approach the C and D part of the EQE exam with these skills. We have made the 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 Kaistraße 16A and are free of charge, language is German. Speakers of the course are Dr. Torsten Exner, Dipl.-Ing. Andreas Gröschel and Prof. Dr. Aloys Hüttermann.

Registration is now possible (please state your full name and employer) at eqe@mhpatent.de.

¹ cf our Newsletter [13/2021](#)

² cf our Newsletter [13/2021](#)

³ cf our newsletters [Newsletter 9/2021](#), [11/2021](#), [12/2021](#), [14/2021](#) and [1/2022](#)

the publication number of their granted European patent⁴ when filing the request. This is unreservedly good news for all applicants of German patent applications and corresponding requests, especially under option b), i.e. for applications where no office action is open, should be filed promptly.

FCJ decision “Windturbinenschaufelmontage” concerning the possibilities of further submissions in nullity appeal proceedings

The question of whether and how additional submissions are possible in German nullity and nullity appeal proceedings and at what point they are to be considered late has already been the subject of numerous decisions of the Federal Court of Justice,⁵ but the recent decision “Wind Turbine Blade Assembly” („[Windturbinenschaufelmontage](#)“)⁶ was also devoted to this problem, among others.

Here, the patent in suit had been declared invalid by the Federal Patent Court as granted and according to some auxiliary requests, but upheld according to a further auxiliary request.

Thereupon, the plaintiff had submitted two further documents in the invalidity appeal proceedings, on the basis of which this last auxiliary request could then also be brought to fall, i.e. the patent was declared invalid in its entirety.

Such a submission of new documents is usually not possible in invalidity appeal proceedings. However, in the present case it had been the case that in the qualified reference the Federal Patent Court had announced that it would consider the patent to be invalid as granted as well as according to all auxiliary requests at that time and that nothing further would result for the subclaims either.

In response to this comment, the patentee then submitted a further request in which one of the subclaims was introduced in claim 1 and which led to the patent being maintained according to that request.

The Federal Court of Justice now held that because the subclaims were also mentioned in the qualified reference, there would have been no reason for the plaintiff to submit further documents, and this even in the knowledge of the patent proprietor's new request:

“The separate defence of patent claim 7 in auxiliary request 1, which took place after the reference under Section 83(1) Patent Act, likewise provided no occasion for the applicant to seek further documents in relation to this claim.

Due to the necessarily provisional nature of a court reference, the applicant could not safely assume that the patent court would adhere to its assessment. However, it was entitled to trust that it would be given the opportunity to supplement its submissions if the patent court reached a different assessment.

Dr. Christoph Volpers is speaker on 28 June 2022 in Montpellier, Frankreich, at the [10th Antibody Industrial Symposium](#) about „European Patent Law Reloaded – The Unitary Patent System”

⁴ In principle, however, such applications should also be possible if only one European patent application is available, but this is not provided for in the communication. In this case, however, a request for a long-term delay (“Langzeitfristgesuch”) can always be filed.

⁵ cf. *Hüttermann*, Mitt. 2017, 193.

⁶ BGH, Decision of 15 March 2022 - X ZR 45/20 - Windturbinenschaufelmontage

Contrary to the defendant's view, the fact that the defendant countered the Patent Court's observations with granted claim 9 [= subclaim 7 in auxiliary request 1] could not replace such an indication. The defendant was obliged to respond to the reference given insofar as it wished to maintain its position that differed from that of the Patent Court. However, in the case in dispute, its submissions did not give rise to any new elements that would make it appear obvious that the Patent Court would depart from its preliminary assessment."⁷

Thus, the documents submitted in the invalidity appeal were accepted. This decision is a consistent continuation of the Federal Court of Justice's line, according to which both sides may initially rely on the qualified reference if it is favourable to them, and (only) if the Federal Patent Court deviates from this reference may they still submit documents or requests in the invalidity appeal proceedings, if necessary.⁸

A different assessment could possibly have resulted if the qualified reference had not contained an assessment of the subclaims. Here, the applicant would have had to submit new documents immediately when it learned that a corresponding subclaim would be included in the main claim with a new request.

FCJ decision "Aminosäureproduktion" concerning the right to sue

In the "Amino Acid Production" ("[Aminosäureproduktion](#)"⁹) decision, which was also published recently, the Federal Court of Justice had to decide on the question of active legitimacy, i.e. the right to sue.

Here, there were two plaintiffs, one being the patent proprietor, the other having a sub-licence agreement to the patent in suit. On this agreement, there existed two versions, one from 2011 and the other a supplementary agreement from 2017, where *"for the purpose of clarifying the agreements from 2011, the contracting parties agreed that an exclusive licence or sub-licence for the German part of the patent-in-suit would be granted retroactively to 1 November 2011 and that the respective licence agreement would be governed by German law."*¹⁰

However, the action at issue in the decision had already been filed in 2015 and the defendant consequently contested the licensee's right to sue. However, both the Düsseldorf Regional Court and the Düsseldorf Higher Regional Court had ruled that an exclusive licence had been granted retroactively at the latest with the supplementary agreement from 2017 and that an exclusive licence had also been implied from the actions of both the patent proprietor and the licensee.

In this regard, the Federal Court of Justice stated as follows:
In principle, the question of whether the licensee was granted the position of an exclusive licensee, which is important for the right to sue, is determined by the law of the state in which the action was brought, i.e. in this case German law. Important for the case at hand is whether a retroactively granted licence also

⁷ Para 86 to 88 of the decision

⁸ cf *Hüttermann*, Mitt. 2017, 193.

⁹ Decision of 22. February 2022 - X ZR 102/19 - Aminosäureproduktion

¹⁰ Para 5

has effect vis-à-vis third parties. The BGH initially denied this:
*"The retroactive agreement of an exclusive patent licence with effect vis-à-vis third parties is generally excluded outside of statutorily provided retroactive effects."*¹¹

Although it is possible to grant an exclusive licence retroactively via §177 and §184 of the General German Civil code (action without power of representation and subsequent authorisation), this cannot have any effect on third parties. In the present case, however, it was the case that the contract from 2011 had already contained a passage according to which the licensee *"has the right to settle disputes with third parties about the IP right on its own responsibility and the [patent proprietor] must support it in this with advice and action"*.

According to German law, this already presupposes an exclusive licence and thus the 2011 agreement was already to be interpreted in such a way that a corresponding licence had already been granted here. Thus, the Federal Court of Justice in the result agreed with the judgement of the lower courts.

In our own affairs

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

Imprint:

Michalski · Hüttermann & Partner
Patentanwälte mbB

Kaistrasse 16A
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 Munich
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

Am Rathaus 2
D-42579 Heiligenhaus
Tel +49 2056 98 95 056

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¹¹ 2nd headnote of the decision