



Newsletter Edition 10/2022

Düsseldorf/Essen/Frankfurt/München, 7. December 2022

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The Federal Court of Justice on Spare Parts –
Scheibenbremse II

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

Unitary patent system to arrive on June 1, 2023

On December 5, 2022, the Unified Patent Court published a notice stating that the introduction of the unitary patent system, originally [planned](#) planned for April 1, 2023,¹ will be delayed by two additional months.

The deposit on the part of Germany will then be made accordingly so that the so-called "sunrise period"² will begin on March 1, 2023. This "sunrise period" will allow, among other things, the precautionary registration of opt-outs and registration as a representative.

However, irrespective of this, as early as January 1, 2023, it will be possible to request a delay in the publication of the registration (which would then make a unitary patent possible) as well as an early application as a unitary patent for patent applications for which the so-called 71(3) communication has been issued but not yet answered. This is because all this is within the competence of the European Patent Office, which is independent of the Unified Patent Court, and which had already decided in November³ to open up corresponding possibilities to applicants.

The reason for the delay on the part of the Unified Patent Court is given as technical reasons, in particular due to the changeover to electronic authentication by signature card. The court did not want to issue its own cards for this purpose, but referred to already existing signature systems. However, according to an [overview](#) also published by the court, not all of these providers are capable of fulfilling all the requirements of the Unified Patent Court - in particular no German or French provider.

The repeated postponement of the deadline is regrettable, but on the other hand it offers even more time to prepare for the upcoming system. That the unitary patent system will see the light of day next year is probably beyond question.

The Federal Court of Justice on Spare Parts – Scheibenbremse II

In the recently [published](#) decision "Scheibenbremse II"⁴ (Disk Brake II), the German Federal Court of Justice (Bundesgerichtshof) once again commented on the question to what extent sold spare parts constitute a patent infringement.

The subject matter of the patent in suit was a disc brake with a brake carrier and wear plates formed in a certain way. The defendant had sold these wear plates and was sued by the patent owner for patent infringement. The OLG (Higher Regional Court) Düsseldorf had now affirmed an indirect patent infringement, but allowed an appeal. The OLG had based its

In Our Own Affairs

Prof. Dr. Aloys Hüttermann will speak on the [PATENTE 2023](#) about the topic „Das Einheitspatentsystem kommt – diesmal wirklich (!)“ / „The Unitary Patent System is coming – this time for real (!)“

¹ Cf our newsletter [9/2022](#)

² Cf our newsletter [4/2022](#)

³ cf. <https://www.epo.org/news-events/news/2022/20221114.html>

⁴ Decision of 8. November 2022 - X ZR 10/20 – Scheibenbremse II

decision on the fact that the wear plates *“are an essential element of the patent-protected invention because they are expressly mentioned in the characterizing part of the main claim and make a decisive contribution to the solution.”*⁵

The Federal Court of Justice was able to follow this, but in the end did not see any patent infringement. First of all, it clarified that it also considered the wear plates to be subject matter of the invention:

“The Court of Appeal correctly considered the [...] advantage that in case of wear not the entire brake carrier has to be replaced, but only the wear plate, as a contribution to the realization of the protected inventive idea.

[...] [It] contributes against this background the wear plates to the realization of the protected teaching.

*The mentioned design may have [...] the disadvantage that the brake comprises altogether more components and a replacement of wear parts is necessary altogether more often than with a design without wear plates. However, this disadvantage is offset by the advantage, also described in the description, that the replacement of the wear plates can be carried out together with maintenance work that occurs regularly anyway, for example at every third change of the brake pads [...] In any case, therein lies a substantial contribution to the realization of the protected invention.”*⁶

However, the Federal Court of Justice referred to the principle of exhaustion in order - in analogy to the “Trommeleinheit”⁷ (Drum unit) decision - to deny a patent infringement in the end.

*“Contrary to the opinion of the Court of Appeal, however, the principle of exhaustion precludes the plaintiff from opposing the use of the challenged wear plates in brakes that were put on the market with the plaintiff’s consent.”*⁸

What matters here (as in the “drum unit” decision) is the technical effect of the relevant parts. In the “drum unit” case, it was still the case that the technical effect was not to be found in the replaced parts. This is different in the present decision, but:

*“The technical effect of the attacked wear parts consists solely in the fact that they wear and thus counteract wear of the firmly welded brake carrier. This effect is not sufficient to affirm a new manufacture.”*⁹

Although the wear parts are designed in such a way that they can be replaced particularly easily, this is irrelevant:

“This is not contradicted by the fact that the shape of the wear plates must be adapted to the brake carrier so that they can be inserted into the overall device [...].

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

⁵ para 14 of the decision

⁶ paras 36-38 of the decision

⁷ Decision 24. Oktober 2017 X ZR 55/16 – Trommeleinheit, cf our Newsletter [2/2018](#)

⁸ para 40 of the decision

⁹ para 54 of the decision

This shaping serves only the purpose of ensuring the intended effect as a wear plate. Effects going beyond this, such as a particularly simple installation [...] do not, on the other hand, come to the challenged wear plates even when the specifications for their shaping are taken into account.”¹⁰

As a result, the Federal Court of Justice has further increased the conditions under which indirect patent protection for spare parts is possible. It remains to be seen whether and how this ruling will make patent protection for spare parts virtually impossible.

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⁵ paras 60/61 of the decision