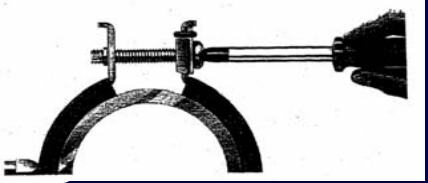


Topics

- Overview of the German patent litigation system
- General aspects of nullity proceedings
- Admissibility of a nullity action
- Grounds for nullity
- Proceedings of first instance
- Nullity decision
- Appeal proceedings

Infringement proceedings (Klaus Haft)

DE: 36 75 397.1 ./. 

Nullity Action
Federal Patent Court

Infringement Action
District Court

Court of Appeal

Federal Supreme Court

1st instance statutory fees of patent cases in Germany (value of matter: 1 Million €)

	nullity	infringement
2 attorneys	18.000 €	18.000 €
court	20.000 €	13.500 €

The Nullity Senate



Associate Judge
(technical)

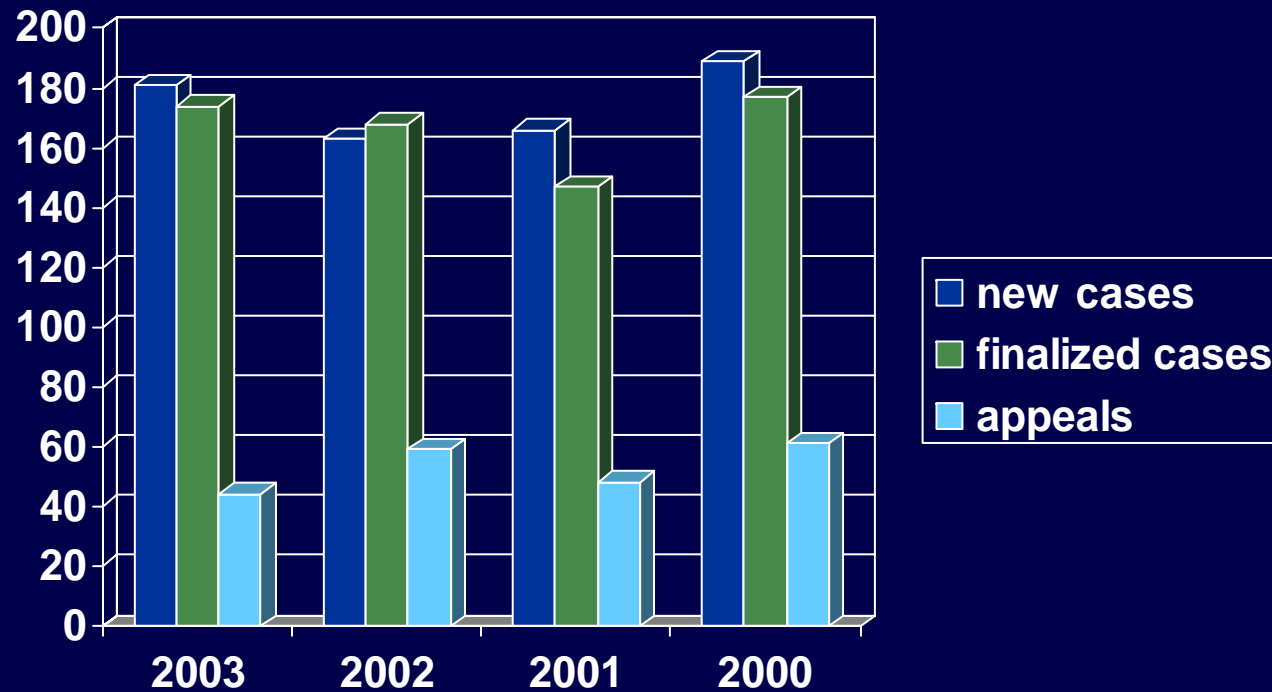
Associate Judge
(legal)

Presiding Judge
(legal)

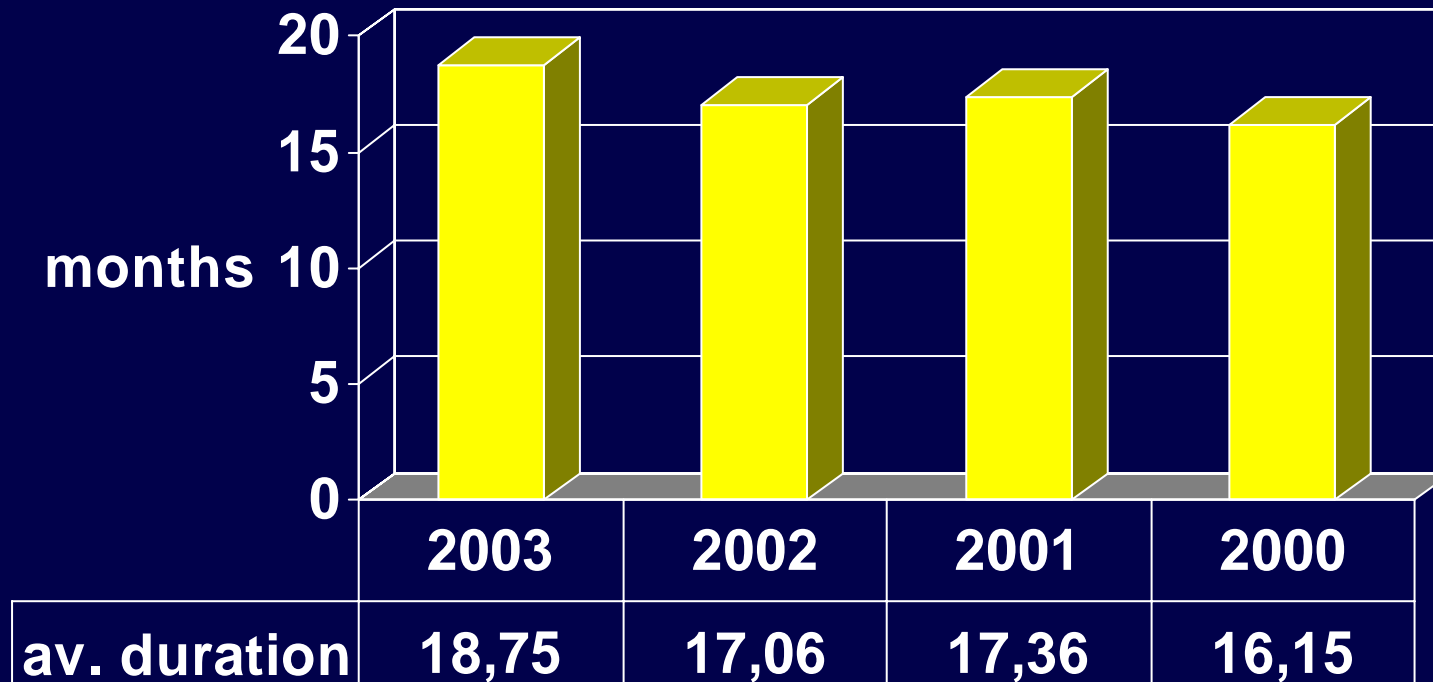
Associate Judge
(technical)

Associate Judge
(technical)

Nullity cases in the Federal Patent Court



average duration of 1st instance nullity proceedings



Formal Prerequisites I

- Anybody can file the nullity action
(if the patent expires, a legal interest of the plaintiff is necessary)
- No time limit
- Nullity action not possible during pending opposition proceedings (§ 81 (2) patent law)

Opposition ./ Nullity action

opposition		nullity
++	Divisional application	--
--	refund of statutory costs	++
+	overall duration and costs	-

Formal Prerequisites II

- Must be filed in writing
- Must be filed against registered patentee
- Arguments in support of the invalidity must be submitted but can be completed later
- Payment of court fee (approx. 20.000 € if the value of matter is 1 million €)
- Non-EU plaintiffs must make a security deposit upon request of the patentee

Nullity Reasons

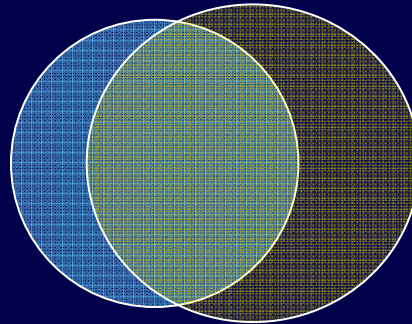
(§§ 21-22 pat. Law / Art. 138 EPC)

- Not patentable §§1-5 pat. law / art. 52 to 57 EPC
- Non-sufficient disclosure
- Unlawful acquisition (DE) / patentee is not entitled (EP)
- Extension beyond original disclosure
- **Extension beyond original scope of protection**

extension beyond original scope of protection

- Extension of scope of protection (e.g. deletion of a feature) after grant is not admissible and must be reversed (partial nullity)
- Complete cancellation if a scope of protection carried by all prior versions of the patent cannot be found

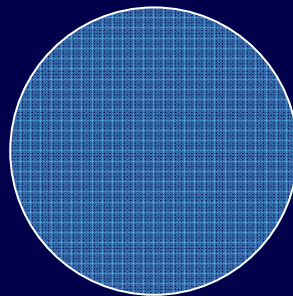
1st version



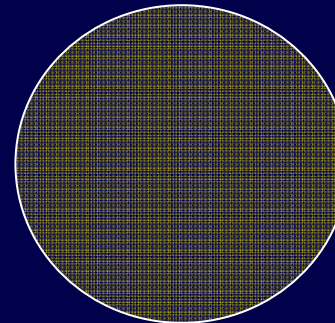
2nd version

→ Partial cancellation - overlap region is maintained

1st version

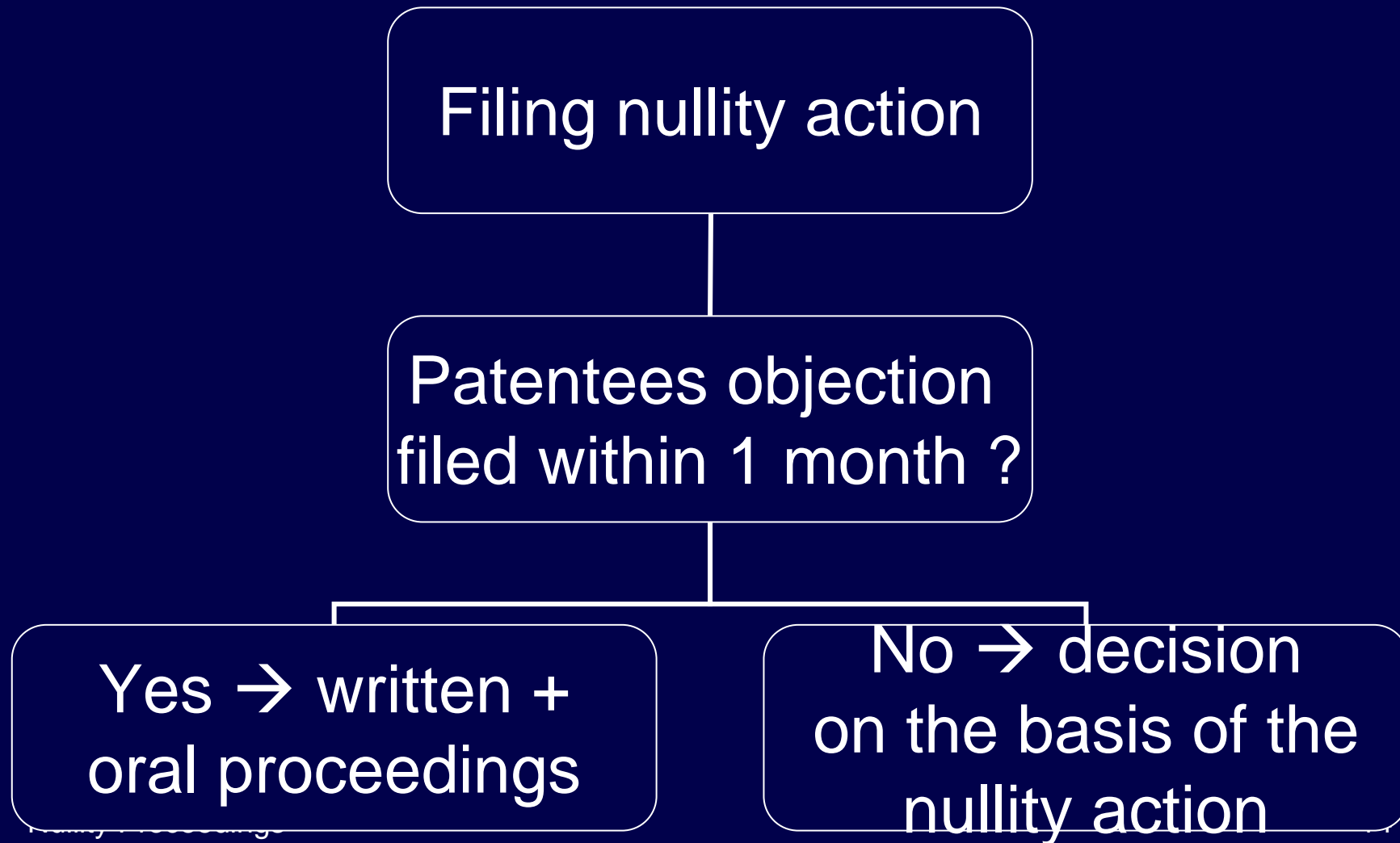


2nd version



extension beyond original disclosure ./.
original scope of protection

- Danger of deadlock situation
- Disclaimer generally accepted under German case law



Principles of the proceedings

- Extent of decision is limited by the requests of the parties
- Nullity action may be withdrawn at any time prior to a legally effective decision
- Federal Patent Court may examine the facts of its own motion

Decision:

- Cancellation of the patent or
- Partial cancellation of the patent or
- Rejection of the nullity action
- + Decision on the statutory costs
the failing party bears the costs
in case of partial success the costs are
split

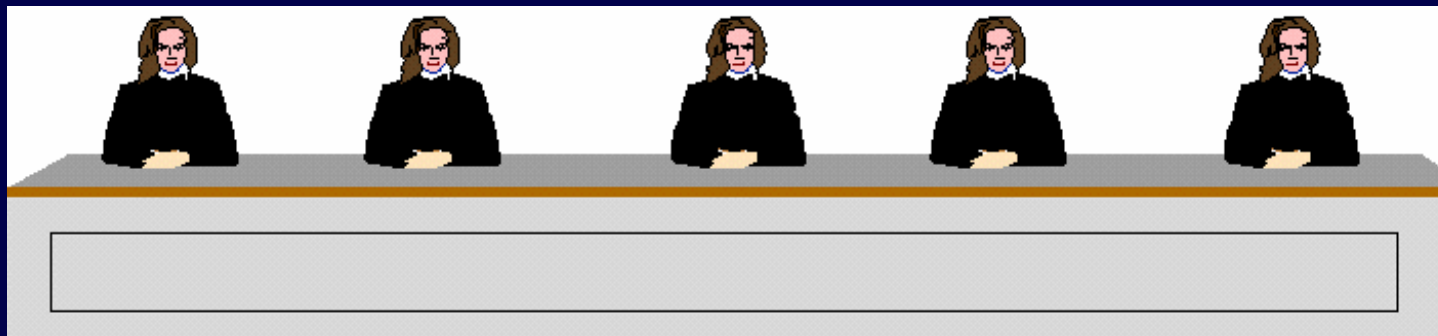
Legal effect of the decision

- (Partial) cancellation of the patent *ex tunc* and effective against anybody
- Rejection of the nullity action legally effective *inter partes*
 - same plaintiff may not file further nullity action on the same grounds

Nullity appeal to the Federal Supreme Court (§§ 110 – 121 patent law)

- Time limit:
 - 1 month after receipt of the written decision
not later than 5 months from oral delivery
- 1 further month for filing reasons of appeal
- Representation: patent attorney or attorney at law

X. Senate - Federal Supreme Court



Associate Judge Associate Judge Presiding Judge Associate Judge Associate Judge

+ Technical expert

