

BARDEHLE PAGENBERG hosts annual talk on European patent law

On November 24, 2009, a discussion on the amendment of claims took place in the framework of a series of seminars entitled “Münchner Patentgespräch” (“Munich Patent Talk”).

Judges from the German Federal Supreme Court, the Federal Patent Court, the Boards of Appeal of the European Patent Office and the remaining civil courts as well as representatives from industry and the Bar were informed by Dr. Jochen Pagenberg about the latest developments of the project of a European system of patent courts.

At present, proceedings for the examination of a draft agreement on setting up a European and Community Patents Court (ECPC) in accordance with the EU Treaty are still pending before the ECJ. A decision is not expected until the end of 2010. In parallel, an expert group consisting of judges and attorneys as well as the working group of the Member States are currently elaborating a draft of the rules of procedure that also comprise rules on claim limitation in a counterclaim for revocation. The rules discussed must be understood as an implementation of Article 138 (3) EPC 2000, containing a standard for claim amendments for the proceedings before civil courts in the EPC for the first time.

Having explained the multitude of various procedures of claim amendment in different countries in Europe, Jochen Pagenberg put a proposal up for discussion which he already presented on the V. Forum of European Patent Judges in Venice at the end of October 2009 according to which a simplification of the nullity proceedings could be achieved by way of two measures.

According to Option 1, a – significant – reduction of citations as evidence for obviousness should be contemplated. In UK practice, for instance, the rule “show me your best piece of prior art” normally applies, according to which, e.g., more than two

or three references submitted by the plaintiff for revocation are regarded as evidence of unsuccessful attempts in the prior art and would therefore be counterproductive if none of the skilled persons had found the solution of the patent.

Following Option 2, auxiliary requests of new sets of claims by the patent proprietor in order to overcome the citations should also be limited. In British practice, more than one auxiliary request is today considered inadmissible. Even though such radical reductions need not necessarily be adopted for the German and the future European practice, Dr. Pagenberg nonetheless considered it possible that a reduction to about 3 to 5 citations – when reasonably differentiating according to the underlying technology – causes both parties to focus on the essential technical and legal aspects. The primary goal, however, would be to reduce the case load of the Federal Patent Court and the Supreme Court in revocation proceedings which are sometimes confronted with several dozens of allegedly pertinent documents, in one case with altogether 95 prior patents and other publications. The result sometimes is, as a former judge admitted, that a patent is revoked on the basis of some borderline piece of prior art, if it is impossible to examine all for lack of time.

During the discussion, there were diverging views, and – surprisingly – even some of the judges were sceptical. German judges feel obliged to deal with each document under the concept of *ex officio* examination, and in order to avoid a challenge for violation of due process they often prefer to deal with all the references if the plaintiff has provided at least a faint reasoning. In spite of several publications in favour of the abolishment of the elimination of said *ex officio* examination and a large number of practitioners being in favour of the idea, German lawmakers still uphold the old rule. The same legal barrier would, however, not exist under European law.

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