

German versus European patent system

A plea in favor of the German patent system

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Since 1 June 2023, proprietors of European patents granted by the European Patent Office (EPO) have had the choice between a traditional European bundle patent and a Unitary Patent for the 17 participating member states of the European Union.

Introduction

On 1 June 2023, the new European Unified Patent Court (UPC) opened its doors. It is responsible for patent disputes for both existing and future European bundle patents granted under the existing system as well as for the new European Patents with Unitary Effect (Unitary Patent – UP) for the 17 participating member states of the European Union. An interactive map showing the 17 participating member states of the European Union can be found

on the UPC's [website](#). It is expected that Ireland and Croatia will follow very soon.

The Regulation on the creation of the UP mentioned above also entered into force on the same date as the UPC. Since then, proprietors of European patents granted by the European Patent Office (EPO), insofar as they were granted after this date, have had the choice between a traditional European bundle patent and a UP for the 17 participating member states of the European Union.

Only the bundle patent is available for the remainder of the member states of the European Patent Convention.

The launch of the new European patent system had been eagerly awaited. Initial experience shows that this new system promises to be a great success. The new system has already been used extensively in the first few weeks and the first rulings published by the UPC show that the judges involved are applying the rules with the utmost competence and care.

Despite all the euphoria shared by the author in favor of the new system and the associated advantages for patent proprietors and patent applicants, the tried and tested national German patent system should not be overlooked. In particular, it offers individual inventors and small and medium-sized enterprises a number of advantages, which will be highlighted below.

German versus European patent application

In particular, an IP right for Germany alone is often sufficient for individual inventors and small and medium-sized enterprises. Furthermore, Germany is a very important market within the European Union, so that competitors can be sufficiently disrupted, if not blocked, by an IP right that is only valid for Germany when entering the market outside Germany. However, this must be carefully examined for each individual case.

Both the EPO and the German Patent and Trademark Office (Deutsches Patent- und Markenamt – DPMA) have

highly qualified examiners with a Master's degree or even a doctorate in an engineering or natural science subject from a university. Both offices provide intensive internal training for their work as examiners. However, in order to become an examiner at the DPMA, several years of practical technical experience are also required. As a result, DPMA examiners always have practical experience in their field of specialization. Consequently, they recognize the everyday work of typical inventors from their own experience.

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In the author's opinion, a further advantage is the so-called deferred examination. Whereas in the case of a European patent application, a search request must be filed with the application and then a request for examination must be filed with the EPO within six months of the publication of the official search report (i.e., usually within two years of the filing date), applicants in the German procedure have up to seven years to file a request for examination. This means that applicants can wait for market opportunities and market development for the invention, if they wish, and can observe whether a time-consuming and costly examination procedure is worthwhile at all. Furthermore,

competitors and their products can be observed during this time.

To avoid misunderstandings: Of course, applicants can also file the request for examination with the DPMA immediately with the application if they are interested in a very fast patent grant. In the German procedure the search and examination are carried out in one step and not in two consecutive steps, as is the case at the European Patent Office. This means a faster patent grant can generally be expected (if the requirements for protection are met).

Formal aspects of a patent application

Patent applications, in particular patent claims, must be clearly worded so that everyone can clearly recognize what is protected as an invention and thus prohibited to third parties. Furthermore, the application text, in particular the patent claims, is amended in the course of an examination procedure if it emerges during the examination procedure that the initially filed patent claims do not fulfil the requirements for protection, such as novelty or an inventive step. The author considers it a great advantage that the DPMA examiners are less formalistic in their examination of clarity and the admissibility of amendments than their colleagues at the EPO. Experience has shown that the DPMA examiners have a much closer eye on what a person skilled in the relevant technical field actually recognizes directly and unambiguously as technical teaching from the application documents in the light of the overall disclosure of the patent application. However, they are not too generous, as the author feels is the case in the

U.S. procedure, for example. Rather, in the author's opinion, there is a very good balance.

Despite careful examination, from time to time in the course of the examination procedure it happens that an inadmissible amendment, for example to the patent claims, creeps in. Here, too, the German procedure offers an advantage. If such an inadmissible extension of the disclosure occurs, the patent claims would actually have to be amended back again after the patent has been granted. At the same time, however, the scope of protection of a patent may no longer be broadened after the patent has been granted. In such a case, the prohibition of the unauthorized extension of the disclosure often conflicts with an inadmissible broadening of the scope of protection. In most cases, the inadmissible extension of the disclosure cannot be removed without simultaneously broadening the scope of protection.

In the European proceedings, the patent proprietor is then caught in what the EPO's Enlarged Board of Appeal called an inescapable trap in its rulings. The patent is completely revoked in its entirety purely for this formal reason, without any consideration of the quality of the invention.

In German proceedings, this error can be remedied by a disclaimer: If the novelty and inventive step of the invention are examined in opposition or nullity proceedings after the patent has been granted, the impermissibly extended feature is ignored. The patent proprietor cannot rely on this feature to support novelty or inventive step. If, on the other hand, the patent proprietor takes action against an alleged infringer on the basis of the patent, they

must also rely on the impermissibly extended feature. The accused infringement must also show this feature in order to constitute an infringement.

The German utility model bifurcation

Another very nice German instrument is branching off a utility model, which is available to both European and German patent applications and patents. If an applicant still needs full protection during the pending examination procedure, they can branch off a German utility model from the pending patent application (whether German or European). This is registered without an examination of the requirements for protection, in particular novelty and inventive step, and thus very quickly offers full protection equivalent to a patent.

It should be noted that the term of a utility model is limited to a maximum of ten years from the filing date. In the case of branching off, the filing date of the patent application applies. Furthermore, utility models cannot be granted for pure process claims. This can often be avoided by skillfully wording the claims.

However, the applicant bears the full risk that the requirements for protection are met. As already mentioned, these are not officially examined. The state of the art to be taken into account for the protectability of utility models is less than for patents. Whereas in the case of patents, any prior publication, whether by written description, prior use, orally or in any other way, must be taken into account, only public prior use in Germany and written descriptions

constitute relevant prior art in the case of utility models. If, for example, it turns out that an invention was pre-published by public prior use, for example in Japan or France, or by purely oral description during a lecture in Heidelberg, effective patent protection can no longer be obtained, but valid a utility model is still possible.

Furthermore, it is still possible to branch off a utility model during pending opposition proceedings, but not after the conclusion of such proceedings, e.g., during nullity proceedings. As a result, it is worthwhile to branch off a utility model at the end of a patent application procedure and have it up your sleeve.

Tactical considerations

With the introduction of the new system on 1 June 2023, the prohibition of double protection for European patents and national German patents, insofar as the patent proprietor also subjects their traditional European bundle patent to the jurisdiction of the UPC, has been removed and replaced by a prohibition of double enforcement. This means that both patents can continue to be valid side by side without restriction. Only when the patent proprietor actually wants to take action against an alleged infringer will they have to decide which of the patents to enforce, the German or the European patent. This means that it may be worthwhile to maintain both patents despite the costs for two patents with effect in Germany.

Another tactical consideration is the possibility of deferred examination in Germany. As mentioned above, the request

for examination at the DPMA can be deferred for up to seven years from the filing date. This makes it possible to apply for a European patent and have it granted as quickly as possible, while at the same time filing a German patent application and making use of the deferred examination. If an alleged patent infringement now occurs, a utility model can be branched off, the protection claims of which will be tailored to the alleged form of infringement within the disclosure of the patent application (an impermissible extension is also prohibited in the case of branching off a utility model). This provides a very sharp sword for infringement proceedings, which the author has often used successfully for his clients in his about 30 years of practice.

German court system versus EPG

Patent infringement proceedings for the 17 participating Member States arising from European bundle patents, unless their owners have opted out (in which case the national courts retain exclusive jurisdiction) and European Patents with Unitary Effect (the UPs) can be brought before the UPC. An infringement action before a competent regional court is possible for national German patents.

As already reported at the beginning, the UPC has experienced and highly qualified judges in patent law. Yet, this also applies to the competent German regional courts. Some German patent judges are at the same time judges at the UPC. However, one advantage of the UPC could be that a technically qualified judge can be added to the three legally qualified judges as a fourth full judge.

In German proceedings, the regional court can only appoint a technical expert. However, the preparation of expert opinions by an expert usually takes a long time and consequently often leads to considerable delays in the proceedings.

In response to an infringement action, an action for revocation is regularly brought against the patent in suit. In the case of the UPC, a nullity action is brought as a counterclaim and consequently also initially ends up before the infringement division. This division can separate the nullity counterclaim and refer it to a central division. This is not expected in practice. Rather, it can be assumed that the infringement chamber will decide on both the nullity counterclaim and the infringement claim in the same judgement in uniform proceedings.

In German proceedings, a nullity action must be brought before the Federal Patent Court in Munich. The regional courts are not authorized to rule on the validity of the patent in suit. Therefore, in a typical course of proceedings, the defendant will file a nullity action shortly before the expiry of the time limit for filing a defense in the infringement proceedings in order to obtain a stay of the infringement proceedings until the nullity proceedings have been concluded. However, practice shows that the regional courts are very reluctant to make use of the stay and only stay the proceedings if there is a potential probability that the patent in suit will be invalidated.

Nullity proceedings usually begin several months after the infringement action becomes pending. As the duration of proceedings at the Federal Patent Court is currently longer

than at the regional courts, a judgement of nullity is often only issued several months later than a judgement of infringement if the proceedings have not been stayed. This time difference is referred to as the injunction gap.

In general, this injunction gap is perceived to be disadvantageous and jeopardizes the acceptance of the German court system. However, a patent proprietor can also take advantage of this injunction gap. Therefore, it can also be perceived as an advantage of the German system. However, the patent proprietor also exposes themselves to a liability risk if the patent in suit later proves to be invalid. Consequently, it must be considered very carefully whether a patent proprietor actually wants to enforce the infringement judgement obtained before the nullity proceedings have been concluded.

Conclusion

The list of differences between the European and German systems could be continued. The author has only picked out what he considers to be the most relevant.

At the same time, this article is intended to promote the filing of German patent applications in addition to or even instead of European patent applications. The German utility model should not be overlooked either. ←