Prinz & Partner.
PATENTANWÄLTE RECHTSANWÄLTE

Nullity Proceedings for Invalidating German Patents

November 2016

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- First Instance Proceedings
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- Options for amended claims

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Nullity Proceedings against a German Patent

Who:

Anybody (but not the patentee)

When:

Any time after

- the end of the term for filing an opposition or
- the end of opposition proceedings

(can also be after the end of the maximum lifetime of the patent)

Nullity Proceedings against a German Patent

Why:

- Subject matter not patentable (non-patentable subject matter, lack of novelty, lack of inventive step)
- Insufficient disclosure
- Misappropriation
- Undue broadening
- Extension of the scope of protection over scope of granted patent (as a result of claim amendments made in opposition proceedings)

Nullity Proceedings against a German Patent

How:

- Draft and file an action against the patentee, requesting revocation of the patent (either national DE patent or DE part of granted EP patent)

- Pay court fees

  Court fees depend from the "amount in dispute"

  - Typical values for the "amount in dispute":

    € 500,000 to € 2,000,000 (¥ 60 million to ¥ 200 million)

  - Corresponding court fees (to be reimbursed if successful):

    € 15,912 to € 40,212 (¥ 1,8 million to ¥ 4,6 million)

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Some Figures

Nullity actions filed per year: approx. 220 (very stable over past years)

(Low number compared with approx. 1,250 infringement actions filed per year)

Decisions of Federal Patent Court: approx. 80 % revocation or restriction

approx. 20 % dismissal of action

Appeal decisions: 60 % confirmation of ruling of Federal Patent Court

40 % amendment of decision of Federal Patent Court

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General comments

Amended procedural rules in effect since 2009. New:

- "Front loaded" proceedings
- Preliminary opinion of the Federal Patent Court

Court might reject amended claims which are filed too late

Federal Patent Court and Federal Court of Justice still in the process of building up enough decisions to understand what is "too late"

General rule: Amended claims have to be filed no later than in response to preliminary opinion

General aim: Proceedings should be terminated in 18 months (currently still approx. 24 months)

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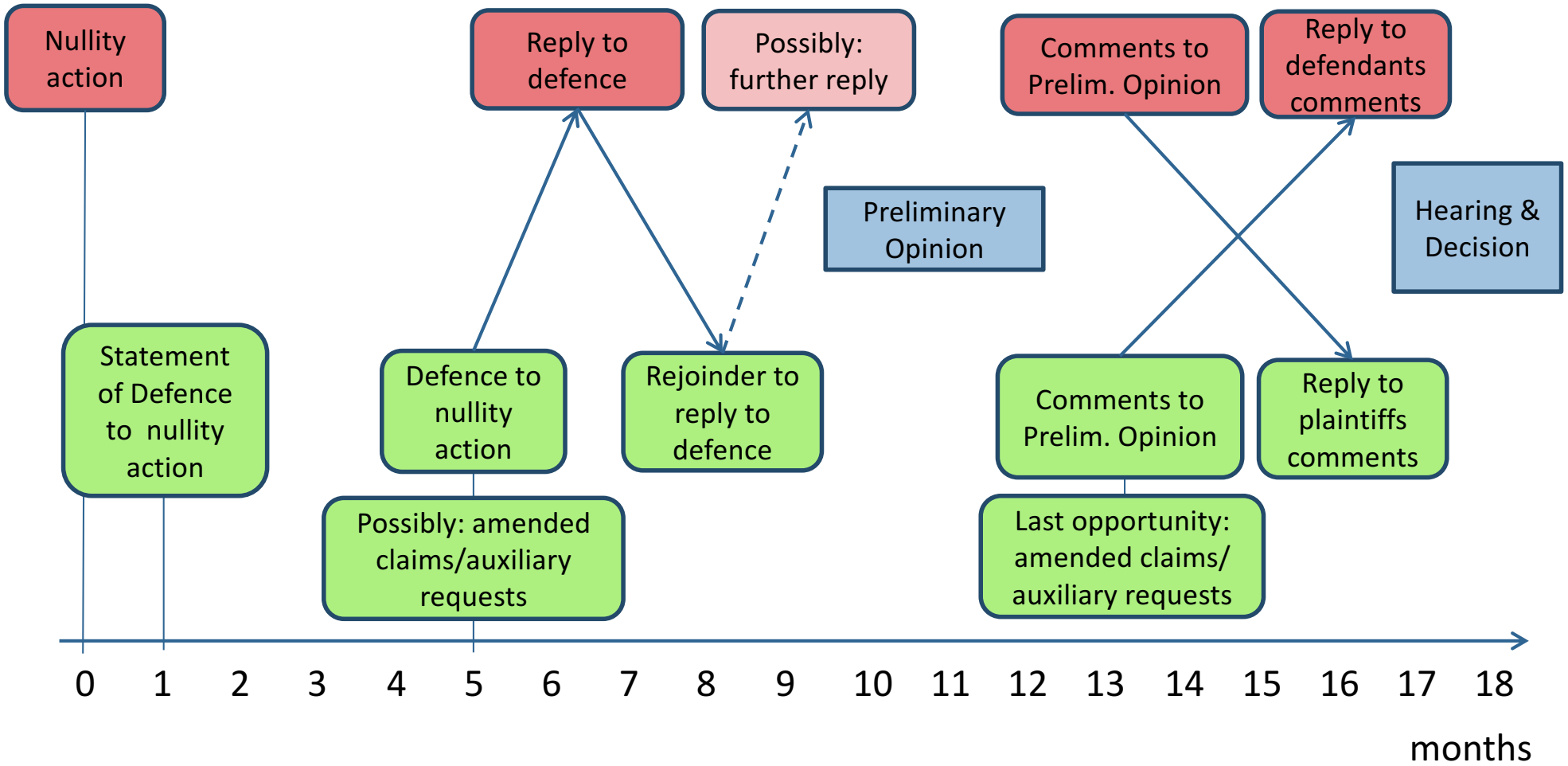
First Instance