

GERMANY

## Submissions filed in second instance nullity proceedings

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In the court decision X ZR 111/13 – *Telekommunikationsverbindung*, the German Federal Court of Justice (BGH) discussed the flexibility that the parties have to amend the issues of dispute in second instance nullity proceedings. The case being considered relates to appeal proceedings before the German Federal Court of Justice reviewing the first instance decision in terms of the revocation of a patent by the German Federal Patent Court (BPatG).

In its decision, the Federal Court of Justice confirmed the revocation of the patent at first instance by the Federal Patent Court in respect of obviousness. The Federal Court of Justice considered new requests filed by the patentee at the stage of the second instance appeal proceedings to be inadmissible, since these new requests did not take account of a legal opinion expressed by the Federal Court of Justice which deviated from the first-instance assessment and the late-filing was due to the negligence of the party.

The decision at issue in the Federal Court of Justice takes into consideration previous rulings, such as the decision X ZR 2/13 – *Analog-Digital-Wandler* of the Federal Court of Justice of May 27 2014, in which it was considered that new requests may not be rejected if they represent an appropriate reaction to a notification given by the court during the appeal hearing.

In the decision at issue, the Federal Court of Justice went even further by stating that the patentee did not substantially react during first instance proceedings to the notification of the first instance court drawing the parties' attention to an attack made by the claimant. Therefore, the late-filing is considered to be due to the negligence of the party and, consequently, the new requests of the respective party

are inadmissible in second instance proceedings, a ruling comparable to the European practice, as established in G 9/91 and G 10/91 for inter partes appeal procedures.

As a result, amendments and auxiliary requests filed in second instance nullity proceedings are to be rejected unless a deficiency occurred in the first instance proceedings, or late-filing is not due to the negligence of the party.

