



FEDERAL SUPREME COURT
IN THE NAME OF THE PEOPLE
JUDGMENT

X ZR 47/22

Delivered on:
December 6, 2022
Schönthal
Judicial Employee
as Clerk of the Court
Registry

in the patent nullity case

Reference book: yes
BGHZ: yes
BGHR: yes

Aminopyridine

Sec. 81 (2), 1st Sentence, Patent Act

- a) For the assessment of whether the bar to filing an action under Sec. 81 (2), 1st Sentence, Patent Act exists, the time of the decision on the action is to be taken into account, not the time at which the action was filed. In this context, changes that only occurred in the course of the appeal proceedings must also be taken into account (confirmation of BGH, judgment of April 19, 2011 - X ZR 124/10, GRUR 2011, 848 para. 17 - Mautberechnung).
- b) The cause of action ceases to exist if the European Patent Office has decided that the patent is maintained with an amended version of its claims and this decision can no longer be appealed.
- c) In this constellation, an action for revocation is only admissible to the extent that it is aimed at eliminating the legal status of the patent to a greater extent than can be expected according to the binding decision of the European Patent Office.

BGH, Judgment of December 6, 2022 - X ZR 47/22 - Federal Patent Court

ECLI:DE:BGH:2022:061222UXZR47.22.0

The X. Civil Senate of the Federal Supreme Court, at the oral hearing on December 6, 2022, by the Presiding Judge Dr. Bacher, the Judge Dr. Deichfuß, the Judge Dr. Kober-Dehm, and the Judges Dr. Rensen and Dr. Crummenerl

ruled:

On appeal, the judgment of the 3rd Senate (Nullity Senate) of the Federal Patent Court of February 25, 2022, is set aside.

The case is referred back to the Patent Court for a new hearing and decision, including the costs of the appeal proceedings.

By law

Facts of the Case:

1 The defendant is the owner of European patent 2 377 536 (patent in suit),
granted with effect for the Federal Republic of Germany, which arose from a
parent application of April 11, 2005, claims two U.S. priorities of April 9, 2004, and
April 8, 2005, and relates to the use of aminopyridine compositions.

2 The Opposition Division of the European Patent Office revoked the patent by
decision of April 6, 2016. By decision of September 4, 2019 (T 0799/16 - 3.3.01,
NiB1), the Board of Appeal revoked this decision and remitted the case to the
Opposition Division with the proviso that the patent in suit be maintained with the
amended claims in accordance with the main request filed in the appeal instance
and that the description be adapted.

3 Claim 1, to which three claims are referred back, reads as amended
[amendments from the granted version are highlighted]:

A sustained release 4-aminopyridine composition for use in a method of ~~treating~~
increasing walking speed in a patient with multiple sclerosis, wherein said
composition is administered twice daily in a dose of 10 milligrams ~~or less~~ of 4-
amino-pyridine.

4 Claim 5, as similarly amended, relates to the use of 4-aminopyridine for
manufacturing a composition having corresponding features.

5 In its action filed on August 20, 2020, the plaintiff sought a complete declaration
of invalidity of the patent in suit, claiming that the challenged subject matter was not
patentable. The defendant defended the property right as granted and, in the
alternative, in two amended versions.

6 On March 16, 2021, the defendant filed an amended description with the Opposition Division. On May 26, 2021, the Opposition Division invited the parties to comment thereon. By decision of October 22, 2021 (NK11), it decided that, taking into account the amendments made, the European patent and the invention to which it relates satisfy the requirements of the European Patent Convention.

7 By judgment of February 25, 2022, the Patent Court dismissed the action as inadmissible. The plaintiff's appeal is directed against this and it continues to pursue its request of first instance and, as a matter of priority, requests that the case be referred back to the Patent Court. The defendant opposes the appeal.

8 On March 25, 2022, the Opposition Division formally determined that the interim decision of October 22, 2021, had become final. On July 8, 2022, the defendant filed translations of the new version of the claim and paid the scheduled fee of 80 euros. By decision dated July 21, 2022, the Opposition Division ruled that the patent as amended was maintained. On August 17, 2022, the reference to this decision has been published. The new version of the patent specification (NiB28) has also been published in the meantime.

Reasons for Decision:

9 The admissible appeal is successful and leads to the remittal of the case to
the Patent Court.

10 I. The Patent Court gave the following main reasons for its decision.

11 The action was inadmissible under Sec. 81 (2), 1st Sentence, Patent Act
because the opposition proceedings were still pending.

12 The opposition procedure is not only governed by Articles 99 to 101 EPC, but
also by Rules 75 et seq. of the Implementing Regulations to the European Patent
Convention (AOEPC). In the case of maintenance of a patent in limited form, Rule
82 AOEPC prescribes a formalized procedure. The final decision on maintenance
under Rule 82 (4) AOEPC may only be taken after the interim decision under Rule
82 (1) AOEPC has become final and the patentee has paid the fee for publication
of the amended patent specification and filed a translation of the amended patent
claims into the official languages within the time limit. If these requirements were
not met, the patent would be revoked under Rule 82(3), 2nd sentence, AOEPC.

13 This procedure must also be followed if the Board of Appeal remits the
proceedings to the opposition division for a further decision on the opposition. In
this constellation, the Opposition Division is bound only by the legal assessment
of the Board of Appeal (Article 111(3) EPC). The subsequent interim decision
stated that the available documents satisfied the legal requirements. For the
substantive amendment of the patent in suit, a final decision under Rule 82(4)
AOEPC was also required in this course of proceedings.

14 This was not a mere formality. Due to the possibility of revocation for lack of
payment of the publication fee or submission of translations, there is a risk of
conflicting decisions as long as the opposition proceedings have not been finally
concluded.

15 II. This assessment does not stand up to review in the appeal instance, if
only because the opposition proceedings have since been concluded.

16 1. As the defendant also does not dispute, the opposition proceedings in
the dispute are concluded by the decision of July 21, 2022, issued in the course of
the appeal proceedings, on the maintenance of the patent as amended under
Article 101 (3)(a) EPC and Rule 82 (4) AOEPG of July 21, 2022.

17 With this decision, the patent in suit has lost its effect insofar as its subject
matter extends beyond the amended version (BGH, judgment of April 17, 2012 - X
ZR 55/09, GRUR 2012, 753, para. 19 - Tintenpatrone III). At any rate, this means
that the bar to action set out in Sec. 81 (2), 1st sentence, Patent Act no longer
applies.

18 2. This change shall be taken into account in the decision on the appeal.

19 a) The preclusion provisions in Sec. 117, Patent Act do not prevent
consideration.

20 The plaintiff was not in a position to plead the events in question at first
instance, if only because they only occurred during the appeal proceedings. In
view of this, it can be left open whether submissions on the ground for refusal
standardized in Sec. 81 (2), 1st Sentence, Patent Act are at all subject to
preclusion under Sec. 117, Patent Act.

21 b) Pursuant to Sec. 81 (2), 1st Sentence, Patent Act, amendments which have subsequently occurred shall also be taken into account in the appeal proceedings.

22 For the assessment of whether the cause of action under Sec. 81 (2), 1st Sentence 1, Patent Act exists, the point in time to be taken into account is not the time at which the action was filed, but the time at which the decision on the action was made (BGH, judgment of April 19, 2011 - X ZR 124/10, GRUR 2011, 848, para. 17 - Mautberechnung).

23 aa) This is in line with the established case law of the Federal Supreme Court, according to which the prerequisites for the proceedings must, in principle, be present at the time of the last oral proceedings and changes that only occurred in the appeal instance must also be taken into account (cf. only BGH, judgment of November 25, 2004 - I ZR 145/02, GRUR 2005, 502, 503 - Götterdämmerung; judgment of January 9, 1996 - VI ZR 94/95, NJW 1996, 1059, 1060; judgment of February 24, 1994 - VII ZR 34/93, BGHZ 125, 196, 201).

24 bb) No further restrictions result from the meaning and purpose of Sec. 81 (2), 1st Sentence, Patent Act.

25 The aim of the provision is to relieve the Patent Court of the time-consuming nullity proceedings as long as opposition proceedings are pending (BT-Dr. 8/2087 p. 37 on Sec. 37 PatG old version). It also has the purpose of avoiding conflicting decisions on the legal validity of a patent (BGH, judgment of April 19, 2011 - X ZR 124/10, GRUR 2011, 848, para. 9 - Mautberechnung; judgment of July 12, 2005 - X ZR 29/05, BGHZ 163, 369, 371 = GRUR 2005, 967 - Strahlungssteuerung).

26 These purposes do not require that a nullity action be dismissed even if an opposition was admissible or pending when it was filed. Nor is the Patent Court required to dismiss an action that was inadmissible when it was filed as soon as

possible. Rather, it is authorized to wait at least until the proceedings are due for a decision anyway and, if necessary, to decide on the merits if the obstacle to the action has ceased to exist by then.

27 III. Irrespective of this, the Patent Court should not have dismissed the
action as inadmissible already at the time of the oral proceedings at first instance.

28 1. Pursuant to Sec. 81 (2), 2st sentence, Patent Act, an action for a
declaration of nullity of the patent may not be brought as long as an opposition may
still be filed or opposition proceedings are pending. The provision also applies in
principle to opposition proceedings before the European Patent Office (BGH,
judgment of April 19, 2011 - X ZR 124/10, GRUR 2011, 848, para. 10 -
Mautberechnung; judgment of July 12, 2005 - X ZR 29/05, BGHZ 163, 369, 370 =
GRUR 2005, 967 - Strahlungssteuerung).

29 2. Contrary to the opinion of the Patent Court, it is not the only decisive
factor for the lapse of the bar to action created by opposition proceedings at the
European Patent Office whether the proceedings have been formally terminated
and the patent has been formally restricted in its legal existence. Rather, the
decisive factor is whether the opposition proceedings have reached a stage where
there is no longer a risk of conflicting decisions or unnecessary duplication of
proceedings.

30 a) As already explained above, Sec. 81 (2), 1st Sentence, Patent Act
serves the purpose of relieving the Patent Court and avoiding conflicting decisions
on the legal status of the patent.

31 The latter is based on the consideration that a patent in opposition
proceedings can be given a content which is not opposed by the prior art asserted
in parallel nullity proceedings, although this could lead to the nullity of the patent

as originally granted. Conducting nullity proceedings on such an uncertain basis may lead to an unjustified loss of the patent in its rightfully granted scope (BGHZ 163, 369, 371 = GRUR 2005, 967 - Strahlungssteuerung).

32 b) This purpose must also be taken into account when assessing the point in time at which the bar to an action established by opposition proceedings ceases to exist. Therefore, a nullity action may only be considered inadmissible as long as there is still a sufficient probability that the dangers, the prevention of which is the purpose of Sec. 81 (2), 1st Sentence, Patent Act may materialize in the specific case.

33 c) Contrary to the opinion of the Patent Court, there is no longer a sufficient likelihood that these dangers will materialize if the European Patent Office has decided that the patent will be maintained with an amended version of its claims and this decision can no longer be appealed (similarly, BPatG, judgment of May 28, 2013 - 3 Ni 2/11 (EP), juris para. 93 et seq.; aA Keukenschrijver in Busse, PatG, 9th ed. 2020, Sec. 81, para. 20).

34 aa) In such a procedural situation, it is certain that the patent will not endure in the granted version and that further attacks by the opponents against the version considered legally valid by the European Patent Office will not be successful. This creates a sufficient basis for the subsequent assessment of the patent on the basis of the amended version of the patent claims in nullity proceedings.

35 (1) The fact that changes to the description may occur in the further course of the opposition proceedings is irrelevant in this context.

36 Amendments to the description may, in individual cases, lead to a different interpretation of the patent claims than on the basis of the previous description. However, the risk of such changes occurring is negligible in the constellation at issue here.

37 If the European Patent Office has bindingly decided that the patent is to be maintained in a certain amended version, the findings relevant for this are also binding for subsequent decisions on an adaptation of the description (EPO, decision of August 5, 1993 - T 843/91, OJ EPO 1994, 832 under 3.4.2).

38 The patent owner is therefore precluded from amending the description in a way that leads to deviations from the subject-matter already bindingly regarded as legally valid. Amendments made and approved by the European Patent Office are to be interpreted in the light of this binding effect and, for this reason alone, cannot as a rule lead to an amended interpretation of the patent claims.

39 (2) The possibility that the Patent Court may consider the patent in suit as not legally valid even in the version maintained by the European Patent Office shall not prevent a nullity action.

40 This danger also exists if the opposition proceedings are formally concluded after the patent has been maintained in limited form. It is inherent in nullity proceedings and is not one of the dangers which Sec. 81 (2), 1st Sentence, Patent Act is intended to counteract.

41 (3) The fact that a translation of the amended patent claims into the official languages of the European Patent Office is pending is already irrelevant in view of their informative character (Art. 70(1) EPC).

42 bb) The danger of contradictory decisions would, however, still exist in the procedural situation in question if the Patent Court were required to assess the legal status of the - formally still in force - granted version of the patent in suit, which the European Patent Office has already bindingly denied.

43 However, in the aforementioned procedural situation, there is no need for legal protection for a nullity action aimed at this objective. Even if the patent in suit is still formally in full force (see BGH, judgment of April 17, 2012 - X ZR 55/09, GRUR 2012, 753, para. 18 et seq. - Tintenpatrone III), a nullity action is only admissible to the extent that it is aimed at eliminating the legal validity of the patent to a greater extent than can be expected after the binding decision in the opposition proceedings.

44 As long as the challenged patent is formally in force, the admissibility of a nullity action does not depend on the plaintiff's need for legal protection. Rather, the interest of the general public in the elimination of a wrongfully granted patent that is not eligible for protection is sufficient (see most recently BGH, judgment of July 21, 2022 - X ZR 110/21, GRUR 2022, 1628, para. 12 et seq. - Stammzellengewinnung). However, it does not follow from this that a nullity action is also admissible without any need for legal protection.

45 The procedural requirement of a need for legal protection is intended to prevent litigation from reaching the stage of examination of the merits for which such examination is not required (BGH, judgment of September 29, 2022 - I ZR 180/21, para. 10). Accordingly, there is in principle no interest worthy of protection in re-submitting the granted version of a patent for substantive examination if it is established on the basis of a binding decision in opposition proceedings that the patent will only be maintained in a specific, amended version.

46 While it cannot be ruled out that nullity proceedings will lead to a formal restriction of the legal status earlier than the formally still pending opposition

proceedings. Even before this formal legal effect occurs, however, an infringement defendant in the constellation in question has sufficient means at its disposal to defend itself against the further assertion of rights under the granted version of the patent. A conviction for infringement of the patent in the granted version is generally excluded if it is certain that this version will not be upheld. If there is already an enforceable title, the enforcement thereof shall generally be discontinued if it is established or at least there is a substantial probability that the embodiment affected by the title does not have the additional features of the amended version.

47 cc) Against this background, the risk of an unnecessary referral to the Patent Court is also excluded with sufficient certainty in the procedural situation at issue.

48 (1) The danger that the Patent Court has to judge the patent in suit in a version which does not withstand the examination in the opposition proceedings no longer exists in the constellation in question for the reasons already pointed out above.

49 (2) The fact that the further course of the opposition proceedings may lead to the complete lapse of the patent, for example because the patentee does not make an amendment to the description considered necessary by the European Patent Office, fails to translate the amended claims into the official languages of the European Patent Office or fails to pay the fees provided for, does not preclude a nullity action in this constellation.

50 Such a course is not one of the specific dangers against which Sec. 81 (2), 1st Sentence, Patent Act is intended to protect. It is not based on a substantive assessment of the body of law by the European Patent Office, which could give rise

to the danger of divergent decisions, but essentially on the decision of the patent owner.

51 Comparable developments may also occur outside the constellations regulated in Sec. 81 (2), 1st sentence, Patent Act, for example, if the patent in suit loses its validity due to non-payment of the renewal fee and the nullity action becomes inadmissible due to the lack of a need for legal protection on the part of the plaintiff.

52 d) In the case in dispute, it is clear from the decisions taken in the opposition proceedings that the patent in suit is maintained only in a limited version.

53 aa) The decision of the Board of Appeal to maintain the patent in suit in the version of the main request from the appeal proceedings is binding on the Opposition Division after remittal under Article 111(2) EPC (see EPO, decision of August 5, 1993 - T 843/91, OJ EPO 1994, 832 at 3.4; decision of November 8, 2021 - T 2558/18, GRUR-RS 2021, 35499, para. 86 et seq).

54 The Senate has previously summarized this to the effect that it is a genuine decision on the merits which is substantively and formally final (BGH, judgment of April 17, 2012 - X ZR 55/09, GRUR 2012, 753, para. 15 - Tintenpatrone III).

55 According to Art. 111(2), 1st Sentence, EPC, the binding effect exists only insofar as the facts are the same. However, this does not entitle the patent owner to defend the patent after remittal in a version which differs from the version which the Board of Appeal considered to be legally valid (EPO, decision of November 8, 2021 - T 2558/18, GRUR-RS 2021, 35499, para. 132 et seq.).

56 Furthermore, the binding effect also exists in subsequent appeal proceedings against a decision of the Opposition Division rendered after remittal. If the Board of Appeal has decided that the patent is to be maintained in a particular version and merely remitted the case to the Opposition Division for adaptation of the description and further subsequent decisions, neither the wording of the claims nor the patentability of their subject-matter may be challenged again in subsequent appeal proceedings concerning the remitted points (EPO, decision of August 5, 1993 - T 843/91, OJ EPO 1994, 832 under 3.4.2).

57 bb) The fact that the Board of Appeal in the case in dispute decided only on the patent claims, but not on adaptations of the description, does not lead to a different assessment for the reasons already explained above.

58 IV. Since the Patent Court - logically from its point of view - did not examine the merits of the action, the matter must be referred back for a new hearing and decision in accordance with Section 119 (3), 1st Sentence of the German Code of Civil Procedure.

59 Pursuant to Sec. 119 (5), 1st Sentence, Patent Act a remittal may be omitted if a decision on the merits by the Federal Supreme Court is appropriate. However, this requirement is generally not met if there is no initial assessment of the prior art by the Patent Court from the point of view of patentability (BGH, judgment of July 7, 2015 - X ZR 64/13, GRUR 2015, 1095, para. 39 - Bitratenreduktion I).

60 Contrary to the view of the defendant, a separate decision on the merits by the Senate is not relevant in the dispute because the Patent Court dealt with the prior art in its reference issued under Sec. 83 (1), Patent Act. This circumstance may lead to the affirmation of relevance in individual cases (BGH, judgment of February 13, 2020 - X ZR 6/18, GRUR 2020, 728, para. 38 - Bausatz). In the case in dispute,

however, the brief statements of the Patent Court do not form a suitable basis for deciding the complex facts of the case.

61 Contrary to the view of the defendant, the decision on the action does not depend only on the assessment of legal questions. In order to be able to identify and answer the relevant legal questions, it is necessary to assess the prior art presented and the teaching of the patent in suit. In the case in dispute, too, it is expedient that such an assessment is first carried out by the Patent Court, which is called upon to decide with the participation of technical judges.

Bacher

Deichfuß

Kober-Dehm

Rensen

Crummenerl

Lower court:

Federal Patent Court, Decision of February 25, 2022 - 3 Ni 23/20 (EP) -