

## Deckblatt Übersetzung

### Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2019-10-22
Docket Number / Aktenzeichen:	X ZB 16/17
Name of Decision / Name der Entscheidung:	Karusselltüranlage

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**Arbeitskreis**  
**Patentgerichtswesen**  
in Deutschland e.V.



# FEDERAL COURT OF JUSTICE

## ORDER

X ZB 16/17

of

22 October 2019

in the appeal proceedings

Karusselltüranlage/  
Revolving door system

Patent Act Sec. 99; Code of Civil Procedure Sec. 62

Sec. 62 Code of Civil Procedure shall apply mutatis mutandis in opposition appeal proceedings.

BGH, Order of 22 October 2019 - X ZB 16/17 - Federal Patent Court

ECLI:DE:BGH:2019:221019BXZB16.17.0

The X. Civil Senate of the Federal Court of Justice ordered on 22 October 2019 by the judges Dr. Bacher, Dr. Grabinski and Hoffmann as well as the judges Dr. Kober-Dehm and Dr. Marx

that:

On the appeal on points of law filed by opponent no. 1, the order of the 19th Senate (Technical Board of Appeal) of the Federal Patent Court of September 27, 2017, is set aside.

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

Grounds of the order:

- 1           A.     The appellant (opponent number 1) and the opponent number 2 have independently filed an opposition against the German patent 10 2007 062 515 (patent in suit) of the respondent (patent proprietor).
- 2           The Patent Office upheld the patent in suit in limited form by order dated 29 October 2015.
- 3           Only opponent 2 filed an appeal against this within the time limit for filing an appeal. Opponent 1 claimed before the Patent Court to be a party to the appeal proceedings. It requested to be admitted as a party and, in the alternative, filed a cross-appeal.
- 4           By order dated 27 September 2017, the Patent Court dismissed the first opponent from the appeal proceedings and rejected the second opponent's appeal. Opponent 1 challenges this with the admitted appeal on points of law, with which it requests that the contested order of the Patent Court be set aside and that the case be referred back for a different hearing and decision. The patent proprietor and the second opponent did not make use of the opportunity to comment.

5           B.     The appeal on points of law filed by opponent no. 1, which is  
admissible in accordance with Sec. 101 et seq. Patent Act, leads to the  
annulment of the contested order and to the remittal of the case to the Patent  
Court.

6           I.     The appeal on points of law is admissible to the extent of the  
limited admission by the Patent Court and beyond, insofar as the opponent to  
1 asserts deficiencies of the proceedings according to Sec. 100(3) Patent Act.

7           1.     As is apparent from the grounds of the contested decision, the  
Patent Court did not allow an appeal on points of law without restriction, but  
only in order to clarify the question of the participation of a non-appealing  
opponent in opposition appeal proceedings against a decision of the Patent  
Division of the German Patent and Trade Mark Office upholding the patent in  
suit to a limited extent, against which at least one other opponent, but not the  
patent proprietor, had filed an appeal.

8           2.     The limitation to this question is effective. Like the appeal, the  
appeal on points of law can be admitted limited to a delimitable part of the  
appeal proceedings (settled case-law, cf. e.g. Federal Court of Justice, Order  
of 29 August 2017 - X ZB 3/15, GRUR 2018, 216 marginal no. 12 with further  
references - Ratschenschlüssel I). The participation of opponent no. 1 in the  
opposition appeal proceedings constitutes a separable, independent part of  
the subject matter of the dispute, the legal assessment of which does not  
depend on the decision on the appeal of opponent no.

9           3.     The appeal on points of law is also admissible insofar as  
opponent no. 1, with the complaint that the Patent Court wrongly failed to  
involve him in the opposition appeal proceedings, at the same time objects to  
the rejection of the appeal. In this respect, the opponent number 1 asserts a  
violation of the right to be heard, which is possible without admissibility (Sec.  
100(3) No. 3, (4) Patent Act; see Federal Court of Justice, GRUR 2018, 216  
Nos. 14 to 17 - Ratschenschlüssel I).

10          II.    The Patent Court essentially justified its decision that opponent  
number 1 was not a party to the opposition appeal proceedings and should be

removed from them as follows: If several opponents who are not in a legal community are involved in the opposition proceedings before the Patent Office and if the patent proprietor does not file an appeal, only those opponents are involved in the appeal proceedings who have filed an appeal themselves. Contrary to the view of the first opponent, the opposition proceedings and the opposition appeal proceedings did not constitute a unit in the sense that all parties to the opposition proceedings were always also involved in the opposition appeal proceedings. This was contradicted by the differences between opposition proceedings and appeal proceedings with regard to the procedural structure and the subject matter of the proceedings. The parties to the opposition proceedings were in each case free to decide whether to lodge an appeal against the decision of the Office and thus to acquire the status of parties to the opposition appeal proceedings. The Patent Act does not contain a provision corresponding to Article 107 sentence 2 EPC. Unlike several applicants or patent proprietors, several opponents were not to be regarded as necessary joint litigants. The case law on nullity proceedings could not be transferred to opposition proceedings in this respect either. Such a transfer would be contrary to the different character of the proceedings and the different position of the invalidity claimants and opponents. The reference to the effect of the Patent Division's decision on the form of the decision does not justify a different assessment. Finally, the reference to a possible deterioration in the position of the non-appealing opponent in the event of a cross-appeal by the patent proprietor does not justify the application of the provisions on the necessary joinder of parties. This legal disadvantage was to be accepted, especially since each opponent was free to file an appeal himself. Opponent No. 1 could also not be admitted as an intervening party. In this respect, the necessary declaration of accession was already lacking.

11           III.     This assessment does not stand up to legal review. The opponent to 1 is involved in the opposition appeal proceedings as a necessary intervener of the opponent to 2 and should therefore not have been dismissed from the proceedings.

12           1.     Following its earlier case law (BPatGE 12, 153; 12 163), the Patent Court took the position that an opponent who does not file an appeal

himself is not a party to appeal proceedings against a decision of the Patent Division of the German Patent and Trademark Office maintaining the patent in question to a limited extent, in which at least one other opponent, but not the patentee, has filed an appeal (also Schulte/Moufang, Patent Act, 10th ed, Sec. 59 marginal no. 143; Schulte/Püschel, Patent Act, 10th ed., Sec. 73 marginal no. 101). According to another opinion, in such cases the opponent who does not file an appeal himself is also a party to the proceedings initiated by the appeal of another opponent (Schnekenbühl in BeckOK Patentrecht, as of 25 July 2019, Sec. 59 marginal no. 70; Schäfers/Schwarz in Benkard, Patent Act, 11th ed., Sec. 74 marginal no. 33; Busse/Engels, Patent Act, 8th ed, Sec. 59 marginal no. 214, Sec. 74 marginal no. 37; van Hees/Braitmayer, procedural law in patent cases, 4th ed. marginal no. 557; see also Ballhaus, Mitt. 1961, 221, 227).

13           2.     The latter opinion is correct.

14           a)     The wording of the provisions on appeal proceedings does not make any clear statement. Sec. 74(1) Patent Act states that the appeal is open to the parties involved in the proceedings before the Patent Office, but does not regulate whether an opponent who does not file an appeal himself is also a party to the appeal proceedings if not the patent proprietor but another opponent appeals against the decision of the Patent Office. Sec. 73(2) sentences 2 and 3 Patent Act states that the notice of appeal and all pleadings must be communicated to the other parties, but makes no statement about their position in the appeal proceedings.

15           b)     However, the participation of the opponent number 1 results from a corresponding application of Sec. 62 Code of Civil Procedure.

16           aa)    Pursuant to Sec. 99 Patent Act, the provisions of the Judicature Act and the Code of Civil Procedure shall apply mutatis mutandis to the proceedings before the Patent Court if the special features of the proceedings before the Patent Court do not exclude this.

17           According to the case law of the Federal Court of Justice, Sec. 62 Code of Civil Procedure applies accordingly in patent nullity proceedings. If a nullity

action has been brought by several plaintiffs or if several actions relating to the same patent have been joined for the purpose of simultaneous hearing and decision, the plaintiffs are necessary co-joined parties (Federal Court of Justice, judgment of 27 October 2015 - X ZR 11/13, GRUR 2016, 361 marginal no. 48 - Fugenband; judgment of 2 February 2016 - X ZR 146/13 marginal no. 6, in Juris; on trade mark law Federal Court of Justice, judgment of 3 November 2016 - I ZR 101/15, GRUR 2017, 520 marginal no. 20 - MICRO-COTTON). In its reasoning, the Federal Court of Justice referred to the fact that the decision on the nullity of a patent is made by way of a judgment. It must be issued uniformly, since the invalidity judgment granting the action has effects vis-à-vis each of the plaintiffs. According to this, it is a question of a necessary litigation cooperative for reasons of procedural law. The corresponding application of Sec. 62 Code of Civil Procedure has the consequence that an invalidity plaintiff must continue to participate in the proceedings even if another plaintiff, but not the plaintiff itself, has filed an appeal against the decision of the Patent Court (see Code of Civil Procedure, GRUR 2016, 361 para. 49 - Fugenband; judgment of 24 January 2012 - X ZR 94/10, BGHZ 192, 245 para. 22 - Tintenpatrone II, Dressler in BeckOK Code of Civil Procedure, status 1 September 2019, Sec. 62 para. 41).

- 18            This comes into play in particular if, in the event of limited maintenance of the patent in suit by the judgment of the first instance, one of several invalidity plaintiffs does not file an appeal - for example, because he has come to the conclusion that the embodiment marketed by him does not fall within the scope of protection of the patent maintained in limited form -, another plaintiff files an appeal against this and the patent proprietor then files a cross-appeal. If a nullity plaintiff who does not file an appeal himself were not involved in the appeal proceedings under these circumstances, he would run the risk of losing the legal position favorable to him that he obtained by the decision of the first instance without being able to influence it. In contrast to a third party who sees his options for action impaired by the scope of protection of the patent but has not yet filed an action for revocation, he would also be prevented from (re)challenging the patent in suit in the event of an unfavorable outcome of the proceedings due to the res judicata nature of the decision.

19           bb)    Contrary to the opinion of the Patent Court, Sec. 62 Code of Civil Procedure is also to be applied mutatis mutandis in opposition appeal proceedings. Accordingly, an opponent who does not himself file an appeal against a decision by which the Patent Office maintains the patent in suit in full or to a limited extent is a party to the opposition appeal proceedings initiated by the appeal of a further opponent as a necessary party to the proceedings.

20           (1)    From the point of view of the aspects of interest here, the opposition appeal proceedings and the revocation proceedings are largely the same. In both proceedings the patent proprietor, who is a necessary party to the proceedings, has the possibility to avoid a complete revocation or a complete declaration of nullity by a limited defense of the patent. The decision of the Patent Office or the Patent Court in opposition or appeal proceedings revoking the patent in whole or in part can - not unlike a decision granting an action in nullity proceedings - only be issued uniformly due to its formative effect.

21           In opposition appeal proceedings, too, if Sec. 62 Code of Civil Procedure were not applicable, the opponent who has achieved a partial success in opposition proceedings could be deprived of a favorable position in the event of an appeal by another opponent and a cross-appeal by the patent proprietor, without being able to influence the proceedings. There is a difference to the legal situation in nullity proceedings insofar as the opponent who does not file an appeal himself would not be prevented in this case from filing an action for nullity of the patent in suit on the grounds on which he based his opposition. However, it would be contrary to the purpose of the law to provide a simple procedure for the rapid clarification of the legal status of a patent by means of the opposition procedure, if the opponent were to be able to file an appeal in such a case. The patent proprietor would always be obliged to file an appeal as a precautionary measure, because otherwise he would only be able to bring an action for revocation if the patent proprietor's cross-appeal were successful.

22           (2)    The corresponding application of Sec. 62 Code of Civil Procedure also takes account of the objective pursued by the amendment of the opposition and opposition appeal proceedings by the Community Patent



Law, namely to bring German law into line with European law in this respect (Draft Law on the Community Patent and on the Amendment of Patent Law Provisions, Bundestag printed paper 8/2087 p. 19, 23; Federal Court of Justice, order of 10 January 1995 - X ZB 11/92, BGHZ 128, 280, 288 - Aluminium trihydroxide). The case law of the Enlarged Board of Appeal of the European Patent Office is based on the fact that, under Art. 107 sentence 2 EPC, an appellant who does not file an appeal himself is a party to appeal proceedings initiated by an appeal filed by another appellant (decision of the Enlarged Board of Appeal of 29 November 1991 - G 2/91, point 6.2 of the grounds; decision of the Enlarged Board of Appeal of 14 July 1994 - G 4/93, points 8 and 16 of the grounds). The Patent Act does not contain a provision corresponding to Art. 107 sentence 2 EPC. However, the above-mentioned provision in Sec. 73(2) sentence 3 Patent Act, according to which the appeal and all pleadings must be communicated to the other parties to the appeal proceedings, can be easily reconciled with the view that several opponents in opposition appeal proceedings are necessary co-parties in the proceedings and thus count as parties to the proceedings, irrespective of whether they have filed an appeal themselves.

- 23           (3)     Finally, the corresponding application of Sec. 62 Code of Civil Procedure to several opponents in opposition appeal proceedings is not inconsistent with the special features of opposition proceedings. If several persons file an opposition, only one opposition procedure is conducted in which all opponents are involved. In these proceedings, each opponent can present the reasons relevant from his point of view for the revocation of the patent in suit and file requests without being bound by the opinion of other opponents. Even if the opposition proceedings have an administrative character (BGHZ 128, 280, 289 - Aluminium Trihydroxide), the position of the parties in opposition proceedings essentially corresponds to that of necessary co-parties in court proceedings. The corresponding application of Sec. 62 Code of Civil Procedure to the appeal proceedings ensures that several opponents are to be involved in the appeal proceedings irrespective of whether they themselves file an appeal. This also appears to be consistent because there is agreement that if the case is referred back to the Patent Office, all opponents are involved in the reopened opposition proceedings

(Ballhaus, Mitt. 1961, 221, 227).

24 IV. It cannot be excluded that the decision would have been different if the Patent Court had, as required, also involved opponent No. 1 in the appeal proceedings. The contested decision must therefore be set aside pursuant to Sec. 108(1) Patent Act and the case referred back for further proceedings and decision.

25 The Senate did not consider an oral hearing to be necessary (Sec. 107(1) Patent Act).

Bacher

Grabinski

Hoffmann

Kober-Dehm

Marx

Previous instance:

Federal Patent Court, judgment of 27 September 2017 - 19 W(pat) 16/17 -.