Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2020-04-14
Docket Number / Aktenzeichen:	X ZB 2/18
Name of Decision / Name der Entscheidung:	EPA-Vertreter

FEDERAL COURT OF JUSTICE

ORDER

X ZB 2/18

of

14 April 2020

In the appeal proceedings

EPA-Vertreter/EPA representative

Patent Act Sec. 143(3)

The costs of the participation of a professional representative before the European Patent Office in a patent dispute shall be recoverable in accordance with Sec. 143(3) Patent Act.

Federal Court of Justice, order of 14 April 2020 – X ZB 2/18 –

Higher Regional Court of Karlsruhe

Regional Court of Mannheim

ECLI:DE:BGH:2020:140420BXZB2.18.0

The X. Civil Senate of the Federal Court of Justice ordered on 14 April 2020 by the judges Dr. Bacher, Dr. Grabinski, Hoffmann and Dr. Deichfuß

that:

The appeal against the order of the 6th Civil Senate of the Higher Regional Court of Karlsruhe of 9 February 2018 is dismissed at the expense of the plaintiff.

Grounds of the order:

1 A. In the proceedings for the determination of costs, the plaintiff challenges the assessment of patent attorney fees.

2 In its order of 2 May 2016, the Regional Court set the costs to be reimbursed by the plaintiff in a patent dispute at approximately €475,066 plus interest. Of this amount, €228,760 is attributable to patent attorney fees.

3 The defendants claim this amount for the assistance of a lawyer who is also admitted as a representative before the European Patent Office under Article 134(2) EPC (hereinafter also: EPO representative).

4 The Court of Appeal dismissed the appeal filed by the plaintiff with the aim of deducting the patent attorney's fees. With its appeal on points of law, which was allowed by the Court of Appeal, the plaintiff continues to pursue its objective.

5 B. The appeal on points of law, which is admissible (Sec. 574(1) sentence 1 No. 2 Code of Civil Procedure) and admissible in other respects, is not well-founded.

6 I. The appeal court gave the following reasons for its decision:

7 Any representative admitted under Art. 134 EPC was also to be regarded as a patent attorney within the meaning of Sec. 143(3) Patent Act. The aptitude test required for admission as an EPO representative ensured a qualification comparable to the requirements of the Patent Attorney Regulations. It was not justified to subject nationals to stricter reimbursement rules than EPO representatives from other EU countries, to whom Sec. 143(3) Patent Act was applicable due to the freedom to provide services. The fact that a German national is free to additionally obtain admission as a national patent attorney is irrelevant.

8 Contrary to the plaintiff’s view, it must also be assumed that the attorney whose costs are claimed had acted as EPO representative in the infringement proceedings. It had been made credible by means of a lawyer's statement that he had been instructed as an EPO representative and had cooperated in the

infringement proceedings, in particular by taking part in meetings with the defendant's counsel on the question of the suspension and on the oral proceedings. Since cooperation within the meaning of Sec. 143(3) Patent Act can still be made credible subsequently in the cost assessment proceedings the costs assessment proceedings, it was irrelevant that the person in question had been person in question was designated as a lawyer in the minutes of the proceedings.

9 II. This assessment stands up to legal review.

10 1. Sec. 143(3) Patent Act shall apply mutatis mutandis to a professional representative before the European Patent Office.

11 a) The direct scope of application of this provision is limited to a domestic patent attorney admitted under the Patent Attorney Regulation (see, e.g., Grabinski/Zülch in Benkard, Patent Act, 11th ed. (2015), Sec. 143 marginal no. 22; Kaess in Busse/Keukenschrijver, Patent Act, 8th ed. (2016), Sec. 143 marginal no. 133; Kircher in BeckOK Patentrecht, 13th edition [as of 15 October 2019], Sec. 143 marginal no. 38; likewise for the participation of a patent attorney in a trademark dispute pursuant to Sec. 140 (3) MarkenG oldF [now Sec. 140 (4) MarkenG]: Federal Court of Justice, decision of 19 April 2007 - I ZB 47/06, GRUR 2007, 999 marginal no. 15 - Consulente in marchi). Since the Act on the Activities of European Patent Attorneys in Germany (EuPAG, of M12 May 2017, Federal Law Gazette I 1121, 1137) entered into force on 18 May 2017, the German Patent Attorneys Act (EuPAG) has been in force. Pursuant to Sec. 16 EuPAG, patent attorneys who are domiciled in a Member State of the European Union or the European Economic Area or in Switzerland and who temporarily and occasionally exercise the activity of a patent attorney in Germany in accordance with the provisions of this Act (European patent attorneys providing services) have the same position (on this, for example, Gruber, GRUR Int. 2017, 859; Kircher, loc. cit. para. 38). The law does not contain a comparable provision for representatives admitted to the European Patent Office.

12 b) However, Sec. 143(3) Patent Act shall apply mutatis mutandis if a representative admitted to the European Patent Office assists in a patent dispute.

13 The Senate agrees with the essentially unanimous opinion in case law and literature on this point (Higher Regional Court of Düsseldorf, InstGE 12, 63 marginal no. 19 = decision of 5 March 2010 2 W 14/10, juris marginal no. 22; Higher Regional Court of Karlsruhe, GRUR 2004, 888; GRUR 1980, 331 [on Sec. 51(5) Patent Act old]; Grabinski/Zülch, loc. cit., Sec. 143 para. 22; Gruber, GRUR Int. 2016, 1025, 1026; Kaess, loc. cit., Sec. 143 para. 133; Kühnen, Handbuch der Patentverletzung, 12th ed, Chap. B Rn. 372; Rojahn/Rektorschek, Mitt. 2014, 1, 6; Rüting in Cepl/Voß, Prozesskommentar zum Gewerblichen Rechtsschutz, 2nd ed. (2018), § 91 marginal no. 106; Schulte/Rinken, Patent Act, 10th ed. (2017), Sec. 143 marginal no. 28; Vierkötter/Schneider/Thierbach, Mitt. 2012, 149, 155; Zapp, GRUR-Prax 2018, 194).

14 aa) In the case of the involvement of a representative admitted to the European Patent Office in a patent dispute, there is an unintended regulatory gap (on this analogy requirement e.g. Federal Court of Justice, decision of 25 August 2015 - X ZB 5/14, GRUR 2015, 1253 marginal no. 19 - Festsetzung der Patentanwaltsvergütung; judgment of 8 January 2019 - II ZR 364/18, BGHZ 220, 354 = NJW 2019, 1512 marginal no. 14).

15 (1) The historical legislator could not consider equating an EPO representative with a domestic patent attorney because the European Patent Organisation, of which the European Patent Office is the organ (Article 4(2)(a) EPC), did not yet exist when the underlying provision was introduced as Sec. 51(5) Patent Act in 1936 (BlPMZ 1936, 78, 85). The Patent Organisation was only established in 1977 on the basis of the European Patent Convention signed in 1973 (cf. inter alia OJ EPO 1/1978, p. 1 ff; Art. I No. 3 of the Law on International Patent Conventions of 21 June 1976, Federal Law Gazette II 1976, p. 649, 826).

16 (2) Since then, the provision has been amended several times. However, it is not evident that the legislator considered or intended to exclude

the equal status of a professional representative before the European Patent Office.

17 (3) The Act on the Activities of European Patent Attorneys in Germany cannot be interpreted as having any such intention with regard to the dispute, if only because it entered into force only on 18 May 2017, and thus after the end of the activity for which the plaintiff is requesting the determination of costs.

18 Irrespective of this, neither the regulations nor the explanatory memorandum of this law give any indication that the legislator also intended to regulate the position of EPO representatives in connection with Sec. 143(3) of the Patent Act.

19 (a) As part of the Act Implementing the Professional Qualifications Directive and Amending Other Provisions in the Field of the Legal Professions, the Act serves to implement several directives of the European Parliament and the Council in the field of professional qualifications, freedom to provide services and freedom of establishment (see in detail BTDrucks. 18/9521 p. 81 f.).

20 The activities of professional representatives under Art. 134 EPC do not fall within the scope of these directives. Therefore, it is far-fetched to assume that the legislator also intended to regulate them.

21 (b) The legislative materials do not provide any further indications.

22 The explanatory memorandum to the government bill mentions professional representatives admitted to the European Patent Office only in connection with the provision on the use of the professional title by a European patent attorney providing services (Sec. 13(1) sentence 1 EuPAG) and a European patent attorney in private practice (Sec. 20 EuPAG) (BT-Drucks. 18/9521 p. 191 (2)). The prohibition of using the designation "European patent attorney" in Sec. 13(2), third sentence, and Sec. 21(3) sentence 4 EuPAG is intended to avoid confusion with the representative admitted to practice before the European Patent Office in the field of representation by patent attorneys, since the latter is often referred to in English as "European patent attorney", so that a translation of this designation into German could lead to misunderstandings (BT-Drucks. 18/9521, p. 191 in conjunction with p. 197).

23 This clarification has no connection with the position of an EPO representative participating in a patent dispute within the scope of application of Sec. 143(3) Patent Act.

24 (c) The reference in the draft bill pointed out by the legal complaint, according to which legal and patent attorneys who are not admitted in Germany or in a Member State may not act in Germany before authorities and courts, refers only to an activity as a representative under Sec. 25 Patent Act (cf. BT-Drucks. 18/9521, p. 236). It does not relate to mere participation, as is the case in the scope of application of Sec. 143(3) Patent Act alone.

25 For this reason, it also does not speak for a deliberate legislative privileging of patent attorneys that they are entitled to represent in certain proceedings (Sec. 4(3) Patent Attorneys' Code, Sec. 97(2) sentence 1 Patent Act, Sec. 113 sentence 1 Patent Act; on the latter provision Federal Court of Justice, decision of 12 February 2014 - X ZR 42/13, GRUR 2014, 508 para. 3 et seq. - IP-Attorney [Malta]) and that the law distinguishes between patent attorneys, attorneys-at-law and other technical advisors (cf. e.g. Sec. 113 sentence 2 Patent Act).

26 In patent litigation, a patent attorney is in principle not authorized to represent. Pursuant to Sec. 143(1) Patent Act in conjunction with Sec. 78(1) sentence 1 Code of Civil Procedure, there is, in principle, compulsory representation by a lawyer (cf. Federal Court of Justice, decision of 18 December 2012 - X ZB 11/12, BGHZ 196, 52 = GRUR 2013, 427 marginal no. 22 - Doppelvertretung im Nichtigkeitsverfahren).

27 (d) The assumption of a regulatory gap is also not precluded by the fact that Sec. 91(1) Code of Civil Procedure contains a general provision on the scope of the obligation of the unsuccessful party to bear the costs.

28 The irrebuttable statutory presumption in Sec. 143(3) Patent Act (c.f. on Sec. 140(3) Trademark Act old version Federal Court of Justice, judgment of 17 September 2015 - I ZR 47/14, GRUR 2016, 526 marginal no. 46 - Irreführende Lieferantenangabe) precisely exempts from the examination required under Sec. 91(1) sentence1 Code of Civil Procedure whether the cooperation of a

patent attorney in a patent litigation was necessary for the purpose of prosecuting or defending the action (BlPMZ 1936, 103, 114 [on Sec. 51(5) Patent Act old version]; Grabinski/Zülch, loc.cit., Sec. 143 marginal no. 23 with further references).

29 bb) There is also a comparable interest situation (on this analogy requirement: BGHZ 220, 354 marginal no. 14).

30 The participation of a representative admitted to the European Patent Office in a patent dispute is legally so largely comparable to the situation regulated in Sec. 143(3) Patent Act that it can be assumed that the legislator would have arrived at the same result in a weighing of interests in which it would have been guided by the same principles as in the enactment of this provision (cf. generally: Federal Court of Justice, GRUR 2015, 1253 marginal no. 19 - Festsetzung der Patentanwaltsvergütung).

31 (1) With Sec. 51(5) Patent Act, old version, the historical legislator intended to clarify to what extent the losing opponent has to reimburse the costs incurred by the use of patent attorney assistance in patent proceedings. To this end, it dispensed with a case-by-case examination of necessity and introduced a reimbursement obligation based on the remuneration for attorneys (BlPMZ 1936, 103, 114).

32 The restriction of the reimbursement claim to a fee - which was originally intended to prevent excessive reimbursement obligations from unreasonably increasing the risk of litigation (BlPMZ 1936, 103, 114) - was abolished with effect from 1 January 2002 (cf. Art. 7 No. 36, Art. 30 Para. 1 of the Law on the Adjustment of Cost Regulations in the Field of Intellectual Property [juris: GeistEigKostBerG]), because from the legislative point of view it did not take into account the actual work performance of the patent attorney in the respective (infringement) proceedings and his position (Secs. 3, 4 Patent Attorneys' Code); moreover, the cap had reduced the claim for damages of the prevailing property right owner (BT-Drucks. 14/6203, p. 64).

33 (2) All these considerations apply in the same way if instead of a patent attorney a representative admitted to practice before the European

Patent Office participates in a patent dispute. In principle, there is a comparable interest worthy of protection in the involvement of such a representative.

34 The involvement of a representative admitted to practice before the European Patent Office can provide the court and the attorneys appointed to represent a party and assisting in the representation of the party in the proceedings with the special expertise required to comprehend the technical teaching of an invention and the circumstances relevant to its understanding and to assess it from a patent law point of view in the same way as that of a patent attorney (cf. Federal Court of Justice, decision of 22 February 2011 - X ZB 4/09, GRUR 2011, 662 marginal no. 10 - Patent litigation I; GRUR 2013, 756 marginal no. 10 - Patent litigation II). As the Court of Appeal correctly pointed out, an EPO representative - as far as relevant for the scope of application of Sec. 143(3) Patent Act - has a comparable professional qualification as a patent attorney.

35 (a) Pursuant to Sec. 5(1) sentence 1 Patent Attorneys' Code, a person may be admitted to the profession of patent attorney if he has obtained the qualification for the profession of patent attorney pursuant to Sec. 5(2) Patent Attorneys' Code or if he holds a certificate pursuant to Sec. 2(5) EuPAG.

36 The required technical qualification (Sec. 5(2) sentence 1 Patent Attorneys' Code) has been acquired by anyone who has devoted himself to the study of scientific or technical subjects in Germany as a regular student at a scientific university, has successfully completed his studies by passing a state or academic examination (Sec. 6(1) sentence 1 Patent Attorneys' Code) and has worked in a technical capacity for one year (Sec. 6(1) sentence 2 Patent Attorneys' Code). After nearly three years of training in the field of industrial property (Sec. 5(2), (3) in conjunction with Sec. 7 Patent Attorneys' Code), the required knowledge of the law must be proved by examination (Sec. 5(2) sentence 1, Sec. 8 Patent Attorneys' Code).

37 (b) Admission as an EPO representative requires successful completion of the European qualifying examination (Art. 134(2)(c) EPC), from which there is a possibility of exemption only within one year from the effective date of a state's accession to the European Patent Convention under the so-

called "grandfather provision" (Art. 134, para. 3, lit. c, first and second sentences, EPC; in individual cases, the required qualification may also be proved otherwise, see Article 134(7)(b) EPC).

38 Apart from this exception, which is not relevant in the present context, participation in the European qualifying examination requires a university degree in science or engineering or proof of equivalent knowledge (see, inter alia, Art. 134a(1)(b) EPC in conjunction with Art. 11(1)(b) EPC). Article 11(1)(a) of the Rules governing the European qualifying examination for professional representatives (VEP) as applicable to qualifying examinations from 2010 onwards, Annex to Decision of the Administrative Council CA/D 26/08 of 10 December 2008, OJ EPO 1/2009, p. 9 ff, last published in each case under Additional Publication 2, OJ EPO 2019, p. 1 ff). Subsequently, the plaintiff must gain the necessary professional experience for a period of basically at least three years (full-time) (Art. 11(2) et seq. VEP; for possible shortening by up to one year, cf. Art. 11(5) VEP, Rule 16 of the Implementing Regulations for the Regulations governing the European Qualifying Examination (ABVEP) in the version of 13 December 2018 applicable to qualifying examinations from 2019, Additional Publication 2, OJ EPO 2019, p. 18 ff.). Alternatively, a person who has been an examiner at the European Patent Office for at least four years may take the qualifying examination (Article 11(2)(b) VEP).

39 (c) These requirements ensure an ability to participate in patent litigation comparable to that of a patent attorney.

40 (aa) Contrary to the opinion of the appeal, it is irrelevant in this respect that an EPO representative does not have the same knowledge of German law as a patent attorney.

41 A patent attorney requires special knowledge of German law primarily because, as an independent body of the administration of justice, he is entitled to provide independent advice and representation in a large number of industrial property matters (Secs. 3, 4(3) Patent Attorneys' Code). In this respect, the orderly administration of justice and compelling reasons of general interest provide for a high level of qualification (BT-Drucks. 18/9521, p. 184, para. 3).

42 On the other hand, the focus of participation in patent litigation within the meaning of Sec. 143(3) Patent Act is regularly on technical or scientific fields, because in principle only attorneys at law are entitled to represent the parties. It is true that participation in patent litigation requires knowledge of substantive patent law. However, an EPO representative usually also has such knowledge, because substantive patent law has been largely harmonized at the European level (cf. only the Explanatory Memorandum to the Law Implementing the Act of 29 November 2000, Revising the Agreement on the Grant of European Patents of 24 August 2007, BT-Drucks. 16/4382, p. 7 and the overview on the harmonization of German and European patent law in Rogge/Melullis in Benkard, 11th ed. (2015) Introduction Patent Act, para. 42, 43, 61, 63, 66).

43 (bb) The fact that not only persons who have completed a scientific or technical course of study at a scientific university within the meaning of Sec. 6 (1), first sentence, PAO, but also graduates of a university of applied sciences may be admitted as representatives at the European Patent Office(Rule 11(1) ABVEP; on the deviating legal situation under the Patent Attorneys' Act Federal Court of Justice, judgment of 29 November 2013 - PatAnwZ 1/12, GRUR 2014, 510 nos. 13, 15 et seq. - Zulassung zum Patentanwalt) does not lead to a different assessment.

44 For an analogous application of Sec. 143(3) Patent Act, not exactly the same requirements as for a patent attorney activity in Germany have to be fulfilled. It is sufficient that an EPO representative, due to his professional qualification, is in a position to participate in a patent dispute comparable to a patent attorney. There are no relevant doubts about this due to the requirements for admission to the European Patent Office, in particular the high standard of the European qualifying examination (cf. inter alia Rules 11 to 14 ABVEP).

45 Irrespective of this, working as a patent attorney in Germany does not always require studies at a scientific university within the meaning of Sec. 6(1) Patent Attorneys’ Code (cf. Sec. 6(2) Patent Attorneys’ Act; Sec. 5(1) Sentence 1 Patent Attorneys’ Act, Sec. 2(5) in conjunction with Sec. 1(1), (2) EuPAG, Art. 11 (b), (c), (d) Professional Recognition Directive 2005/36/EC; Sections 13 f., 26 EuPAG).

46 (d) Comparability also does not depend on whether in the individual case there is an interest worthy of protection in the involvement of an EPO representative or whether a European patent is involved (cf. on trademark law: Federal Court of Justice, GRUR 2007, 999 marginal no. 15 - Consulente in marchi).

47 The technical questions that arise for an EPO representative and a patent attorney do not differ in principle (Higher Regional Court of Karlsruhe, GRUR 2004, 888; Higher Regional Court of Düsseldorf, InstGE 12, 63 marginal no. 19 = decision of 5 March 2010 2 W 14/10, juris marginal no. 22). Therefore, for the scope of application of Sec. 143(3) Patent Act, a typifying consideration is also indicated in this respect (cf. on Sec. 91 Code of Civil Procedure, for example: Federal Court of Justice, GRUR 2011, 662 marginal no. 19 - Patent litigation I).

48 (e) Contrary to the opinion of the appeal, it is not necessary to differentiate between an EPO representative domiciled in Germany and an EPO representative domiciled abroad (e.g. also Zapp, GRUR-Prax 2018, 194). Rather, only the ability - to be assumed on the basis of the entry in the list of professional representatives - to participate in a patent dispute like a domestic patent attorney is decisive.

49 The fact that a domestic EPO representative may be able to obtain admission as a patent attorney is irrelevant, as the Court of Appeal correctly pointed out. Due to the different requirements, in particular with regard to professional experience, this possibility does not exist without further ado. The differences in this respect are not of decisive importance for the knowledge and skills that are central in connection with Sec. 143(3) Patent Act.

50 Contrary to the opinion of the appeal, there is no reason to fear that a domestic EPO representative who does not meet the requirements for admission as a patent attorney can act as a patent attorney via the detour of Sec. 143(3) Patent Act. The participation according to Sec. 143(3) Patent Act is only one of many fields of activity open to a patent attorney.

51 2. The appeal is also unsuccessful against the assumption of the Court of Appeal that the attorney, whose costs the plaintiff wants to have fixed, acted as EPO representative in the infringement proceedings.

52 a) Contrary to the opinion of the appeal, it is not objectionable that the Court of Appeal allowed the attorney's affirmation of the attorney concerned to suffice as prima facie evidence, although the attorney is designated as an attorney in the minutes of the proceedings.

53 aa) The probative value of minutes of oral proceedings does not extend to the function in which a representative, authorized representative or counsel participated in the proceedings.

54 Pursuant to Sec. 165 sentence 1 Code of Civil Procedure, the minutes shall have probative value with respect to the formalities prescribed for the hearing. According to widespread opinion, this also includes the circumstances to be recorded in accordance with Sec. 160(1) Code of Civil Procedure. With regard to the aforementioned group of persons, however, Sec. 160(1) no. 4 Code of Civil Procedure provides in this respect only for the recording of the names.

55 bb) The Court of Appeal also rightly assumed, without being challenged by the appeal, that participation within the meaning of Sec. 143(3) Patent Act can still be presented and substantiated subsequently in the cost fixing procedure (see e.g. Higher Regional Court of Frankfurt a.M., GRUR-RR 2003, 125; Higher Regional Court of Hamburg, Mitt. 2019, 138, 139; Kaess, loc.cit., Sec. 143 para. 144; Kircher, loc.cit., Sec. 143 para. 51).

56 b) Whether the cooperation was necessary is not relevant to the decision.

57 As already explained above, a necessity test does not take place within the scope of application of Sec. 143(3) Patent Act. The principle developed by case law for other proceedings that the costs for the extrajudicial cooperation of a patent attorney are only to be reimbursed if the claimant demonstrates and, if necessary, proves that the participation was necessary (for trademark law: Federal Court of Justice, GRUR 2011, 754 para. 24 - Kosten des Patentanwalts

II; GRUR 2012, 756 marginal no. 24 f. - Kosten des Patentanwalts III; GRUR 2016, 526 marginal no. 46 - Misleading supplier information), cannot be transferred to the relationship between the parties involved in a patent dispute.

58 III. The decision on costs is based on Sec. 97(1) Code of Civil Procedure.

Bacher Grabinski Hoffmann

Deichfuß Marx

Previous instances:
Regional Court of Mannheim, judgment of 2 May 2016 – 7 O 30/12 –
Higher Regional Court of Karlsruhe, judgment 9 February 2018 – 6 W 79/16 –