

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2017-08-29
Docket Number / Aktenzeichen:	X ZB 3/15
Name of Decision / Name der Entscheidung:	Ratschenschlüssel



Arbeitskreis
Patentgerichtswesen
in Deutschland e.V.



FEDERAL COURT OF JUSTICE

ORDER

X ZB 3/15

of

29 Augsburg 2017

In the appeal proceedings

Ratschenschlüssel/
Ratchet wrench

Patent Act Sec. 59(2) sentence 1

The third party against whom the patent proprietor has applied for an interim injunction for infringement of the patent may also join the opposition proceedings as opponent.

Federal Court of Justice, order of 29 August 2017 – X ZB 3/15 –

Federal Patent Court

ECLI:DE:BGH:2017:290817BXZB3.15.0

The X. Civil Senate of the Federal Court of Justice ordered on 29 August 2017 by the presiding judge Prof. Dr. Meier-Beck, the judges Gröning, Dr. Grabinski and Hoffmann as well as the judge Dr. Marx

that:

On appeal by the second opponent 2, the decision of Patent Division 15 of the German Patent and Trademark Office of 3 December 2009, and the decision of the 11th Senate of the Federal Patent Court of 10 November 2014, are set aside insofar as the interventions of the second opponent were rejected as inadmissible. In all other respects, the appeal on points of law against the order of the Federal Patent Court is dismissed.

The second opponent shall bear the costs of the appeal proceedings.

Grounds of the order:

I.

- 1 The respondent to the appeal is the proprietor of German patent 100 62 853 (patent in suit), which was filed on 16 December 2000 and relates to a reversible ratchet wrench and was published on 5 July 2007.
- 2 Four companies initially filed oppositions to the patent in suit, but withdrew their oppositions in January 2008.
- 3 In a written statement received by the German Patent and Trademark Office on 7 May 2008, the second opponent intervened in the opposition proceedings. In support of this, it argued that the patent proprietor had obtained a preliminary injunction from the Regional Court of Düsseldorf dated 11 March 2008, based on the patent in suit, prohibiting it from offering or putting into circulation in Germany a reversible ratchet wrench with the features of the granted patent claim 1 and from handing over infringing objects in its possession to the bailiff. On the merits, opponent 2 asserted the grounds of revocation based on lack of patentability and inadmissible extension.

4 The German Patent and Trademark Office considered the interventions of the second opponent - like those of the first opponent, who had been warned by the patent proprietor for patent infringement - to be inadmissible and revoked the patent in suit.

5 With the appeal filed against this decision, the patent proprietor requested that the patent in suit be maintained in a limited version. Both opponents initially joined this appeal, but withdrew their cross-appeals during the appeal proceedings. The second opponent filed an appeal against the rejection of its appeal, which was opposed by the patent proprietor.

6 The Patent Court, whose decision is published in Mitt. 2015, 283, dismissed the appeal of the opponent 2 (statement 1 a), allowed the appeal on points of law (statement 1 b) and maintained the patent in suit in a limited version as requested (statement 2).

7 With its appeal on points of law, which the patent proprietor requests to be dismissed, the second opponent seeks the annulment of the decision of the Patent Court.

II.

8 The appeal on points of law is admissible to the extent of the limited admissibility by the Patent Court and beyond, insofar as the opponent 2 asserts deficiencies of the proceedings according to Sec. 100(3) Patent Act.

9 1. The Patent Court did not admit the appeal on points of law of opponent 2 without restriction, but only to clarify the question of the admissibility of its intervention in the opposition proceedings.

10 a) The Patent Court expressed its intention to grant only limited admissibility by the sequence of the statements in the order appealed against (above para. 6). It first dismissed the appeal of opponent 2, then pronounced the allowance of the appeal on points of law, and only subsequently decided on the appeal of the patent proprietor. The Patent Court obviously did not choose this order sequence to make it clear that only the appeal of the opponent 2 was

to be admitted without restriction and not also that of the patent proprietor, but to make it clear that it only wanted to enable the Court of Appeal to clarify the question of the admissibility of the appeal of the opponent 2. This is confirmed by the fact that the Patent Court explained the statements in the reasons to the effect that it was allowing the appeal of the second opponent in order to ensure uniform jurisdiction. However, there was a corresponding need only for the question of the admissibility of their appeal, which, according to established case law, indicates a limitation of admissibility (Federal Court of Justice, order of 6 August 2013 X ZB 2/12, GRUR 2013, 1135 marginal no. 36 inkjet printer; order of 17 July 2012 X ZB 1/11, GRUR 2012, 1243 marginal no. 5 moisture absorption container).

11 b) The appeal on points of law could effectively be limited to the question of the admissibility of the intervention.

12 According to established case law, the appeal on points of law, like the revision, can be admitted limited to a definable part of the appeal proceedings (Federal Court of Justice, GRUR 2013, 1135, marginal no. 39 Inkjet printer; order of 17 April 2007 X ZB 9/06, BGHZ 172, 108 marginal no. 7 Informationsübermittlungsverfahren I, in each case with the relevant references). This requirement is met in the case in dispute.

13 The question of the admissibility of the accession of the opponent 2 constitutes a separable independent part of the subject matter of the dispute. It cannot be successfully objected that an isolated review of the admissibility of the application without an associated review of the decision of the Court of Appeal in other respects in the manner of an appeal by the Court of Appeal, which is only opened up by an unrestricted admission of the appeal, would be contradictory. On the contrary, the procedural consequences of the restriction of admissibility correspond to the systematics of the appeal proceedings under patent law and the regulatory content of its provisions.

14 aa) An appeal on points of law to the Federal Court of Justice against decisions of the Patent Court's Boards of Appeal on the maintenance or revocation of a patent under Sec. 61(2) Patent Act is only possible if the Board of Appeal has admitted the appeal on points of law in the decision (Sec. 100(1)

Patent Act). Admission to file an appeal on points of law is only not required if one of the grounds listed in Sec. 100(3) Patent Act exists and is objected to.

15 bb) In summary, it follows from these provisions that the decisions of the appeal senates of the Patent Court, if it has not admitted the appeal on points of law, are in principle only reviewable by the Court of Appeal for the existence of the procedural defects listed in Sec. 100(3) Patent Act and are otherwise exempt from review. Without (limited) admissibility in the case in dispute, this restriction would also apply to the question of the admissibility of the second opponent's intervention in the opposition proceedings. If the Patent Court had not allowed the appeal and if this had not been subject to any objections that would have been valid under Sec. 100(3) Patent Act, the opponent 2 would not have acquired the status of a party to the proceedings. As a result, it would be precluded from also asserting such defects of the proceedings before the Patent Court that affect the decision on the merits by means of the appeal based on Sec. 100(3) Patent Act.

16 The limited admissibility of the appeal therefore puts the second opponent in a better position than it would be in without admissibility, because the decision of the Patent Court denying the admissibility of its appeal is itself subject to unrestricted legal review by the Court of Appeal, and not only to the extent of Sec. 100(3) Patent Act. With regard to the possibility of a substantive review of the decision of the Court of Appeal, the second opponent is then not in a worse position than all other parties to the proceedings who, in the case of a non-admitted appeal on points of law, may also only raise the objections referred to in Sec. 100(3) Patent Act.

17 2. Furthermore, the appeal on points of law is admissible insofar as the composition of the Court of Appeal and the denial of the right to be heard are challenged (Sec. 100(3) Nos. 1 and 3 Patent Act).

III.

18 The appeal on points of law, which is also admissible in other respects,
is successful only to the extent that the Patent Court confirmed the rejection of
the application as inadmissible, and is otherwise unfounded.

19 1. The Patent Court dismissed the appeal of the second opponent on
the grounds that the requirements for intervening had not been met according
to the wording of Sec. 59(2) Patent Act, which is not open to an expansive
interpretation.

20 2. The appeal on points of law successfully challenges this. The
Patent Court wrongly denied the admissibility of the second opponent's
participation in the opposition proceedings.

21 a) Pursuant to Sec. 59(2) Patent Act, if an opposition has been filed
against a patent, any third party may intervene in the opposition proceedings as
opponent after expiry of the opposition period, if he proves that an action for
infringement of the patent has been filed against him, provided that he declares
his intervention within three months after the date on which the action for
infringement has been filed. The same shall apply to any third party who proves
that, following a request by the patent proprietor to cease and desist from an
alleged infringement of the patent, he has brought an action against the patent
proprietor for a declaration that he is not infringing the patent.

22 b) The question of the extent to which a person against whom the
patent proprietor has taken legal action for alleged patent infringement, but only
by way of provisional legal protection, may also join the opposition proceedings,
is judged differently in case law and technical literature (in the negative: Federal
Patent Court, order of 31 March 1994 4 W (pat) 3/91; with the same tendency
Benkard/Schäfers/Schwarz, Patent Act, Sec. 59 marginal no. 104; affirmative:
Federal Patent Court, order of 12 July 2011 8 W (pat) 23/08, juris marginal no.
44; Engels in Busse/Keukenschrijver, 8th ed, Sec. 59 Patent Act marginal no.
170).

23 c) The latter view is correct.

- 24 aa) The fact that Sec. 59(2) Patent Act does not expressly mention the preliminary injunction in addition to the filing of an action is obviously not the result of a deliberate decision by the legislator to the effect that the party against whom the patent proprietor has merely taken measures of preliminary legal protection due to alleged patent infringement should not be entitled to join the opposition proceedings. The provision in Sec. 59(2) Patent Act was inserted into the law by Art. 8 No. 35 of the Community Patent Law of 26 July 1979 (BGBl. I p. 1269 as Sec. 35a(2) Patent Act). The intention of the historical legislator was to align it with the corresponding provision in Art. 105(1) lit. a EPC (cf. BT-Drucks. 8/2087 p. 34 et seq.), the German version of which was used as a basis for the provision to be created in national law, but the legislator did not go beyond its wording.
- 25 bb) The regulation of the conditions under which a third party exposed to the accusation of infringement of the patent in suit can subsequently join the opposition proceedings is based on the evaluative distinction as to whether this dispute is still conducted purely out of court or whether one side has already crossed the line to resort to judicial assistance. According to the provision in Sec. 59(2) sentence 2 Patent Act, the former is not sufficient. The latter shall apparently only be sufficient if the owner of the property right has filed an action for patent infringement or if the person warned has filed a negative declaratory action. For the reason mentioned above, however, this is not to be regarded as conclusive, especially since it should be added that at least the English version of Art. 105(1) lit. a EPC implies a further understanding of the term "Klage wegen Verletzung dieses Patents" ("... proceedings for infringement of the same patent ...").
- 26 cc) It must therefore be recognized as recourse to judicial assistance if the patent proprietor, as in the case in dispute, has requested the issuance of an preliminary injunction against the third party. The receipt of the application by the court establishes the *lis pendens*, because in proceedings for a preliminary injunction against the defendant a decision on the merits can be issued immediately by way of a resolution, even without his prior hearing (cf. Musielak/Voit/Huber, Code of Civil Procedure, 14th ed., Sec. 921 marginal no. 6; Ahrens/Scharen, Der Wettbewerbsprozess, 8th ed., ch 51 marginal no. 19).

With the receipt of the application for a preliminary injunction, the area of mere extrajudicial action against the third party is accordingly left and a degree of dispute is reached which is to be equated with the filing of an action and can no longer be assigned to the stage of an extrajudicial dispute.

27 In addition, from the point of view of the defendant in the injunction proceedings, the infringement issue may, depending on the circumstances of the individual case, be clearly judged in favor of the patent proprietor and it may therefore appear advisable to him in the interest of costs to recognize the preliminary injunction as the final settlement. Nevertheless, to make his accession to the opposition proceedings generally dependent on his having caused the patent proprietor to file the main action or having himself filed a negative declaratory action in a legal dispute in which he must accept the existence of the property right against him would not be objectively justifiable against this background either.

28 3. The objections of the appeal based on Sec. 100(3) Nos. 1 and 3 Patent Act and directed against the partial maintenance of the patent in suit do not succeed.

29 a) The complaint that the Court of Appeal was not properly constituted (Sec. 101(2) Patent Act in conjunction with Sec. 547 No. 1 Code of Civil Procedure, Sec. 100(3) No. 2 Patent Act) is not properly stated and is therefore unsuccessful.

30 If the appeal is based on the infringement of procedural rules, the facts showing the deficiency must be stated (Sec. 102(3) No. 3 Patent Act). In order to substantiate the complaint of the defective composition of the court, it is necessary to state the individual facts from which this defect is supposed to result (Federal Court of Justice, order of 30 March 2005 - X ZB 8/04, GRUR 2005, 572 Vertikallibelle). This is lacking.

31 The appeal on points of law relies on the fact that the appeal was initially lodged with the 10th Senate of the Patent Court, was passed on to the 11th Senate on the grounds of a vote not accessible to it and, in the absence of any

possibility of clarification, it must be assumed that the appeal was passed on to a Senate without jurisdiction.

32 This is not sufficient to demonstrate the alleged infringement, because the question of whether a panel has arbitrarily assumed its jurisdiction according to the allocation of duties does not depend on the reasons given by the panel to justify its jurisdiction, but on whether the assumption of its jurisdiction proves to be incomprehensible and obviously untenable when viewed objectively (Federal Court of Justice, order of 5 October 1982 - X ZB 4/82, GRUR 1983, 114 - Auflaufbremse). In order to demonstrate this, the appeal was not reliant on the knowledge of the filing notice, but would have had to show, on the basis of the allocation of business in force at the time the appeal was filed with the Court of Appeal, that the 11th Senate of the Patent Court could only have assumed its jurisdiction arbitrarily according to the subject matter of the invention.

33 Moreover, if the erroneous allocation of the court is based on internal court processes, it must be shown that an attempt to clarify the matter was made in vain (Federal Court of Justice, GRUR 2005, 572 Vertikallibelle). To this end, the opponent 2 could and should have tried to find out the reasons for the submission to the 11th Senate of the Court of Appeal through official statements.

34 b) The alleged violation of the right to be heard (Sec. 100(3) No. 3 Patent Act) is also not properly presented.

35 It is true that the patent in suit was maintained in a limited version which was only submitted during the oral proceedings. However, this does not in itself constitute an infringement of the right to be heard, but could at most constitute an infringement of the opponent's fundamental procedural rights if the Court of Appeal had prevented her from adapting her attacks to the modified defense. However, this is not the case. The indication in the summons to the hearing that its entitlement to intervene could be denied on the basis of a preliminary assessment does not change the fact that the second opponent was duly summoned to the oral proceedings, that the factual and legal situation was discussed there with the parties as shown by the minutes of the hearing and that a decision on its procedural position and on the merits was not taken until

after the end of the oral proceedings. Accordingly, the opponent 2 not only had the opportunity to present its position in the oral proceedings before the appeal court, but also otherwise to take all procedural steps there which could be conducive to achieving a decision on appeal favorable to it.

36 4. Insofar as the Patent Court considered the limited defense of the patent in suit with the set of claims submitted at the oral proceedings to be admissible and its subject matter to be protectable, its decision is not subject to review in the appeal instance for the reasons stated.

IV.

37 The decision on costs is based on Sec. 109(1) sentence 2 Patent Act.

38 The Senate did not consider an oral hearing necessary (Sec. 107(1) half-sentence 2 Patent Act).

Meier-Beck

Gröning

Grabinski

Hoffmann

Marx

Previous instance:

Federal Patent Court, judgment of 10 November 2014 – 11 W(pat) 12/10 –