

GERMANY



**Maiwald Patentanwalts
GmbH
Munich**

Dirk Bühler

Court emphasises differences in evaluating obviousness

The different handling of the same nullity grounds by national courts of EPC member states and by the EPO is generally considered one of the obstacles to a unified patent practice in Europe. The Olanzapin decision as handed down by the German Federal Supreme Court last year was therefore welcomed as a major move bringing German validity practice towards EPO practice, at least as far as novelty is concerned. In fact, it seems that German courts handling nullity cases now follow the EPO's photographic novelty test.

However, in its recent decision *Fischbissanzeiger* (BGH Xa, ZR 138/05) the Federal Supreme Court made it clear that it is still keen on preserving differences in the handling of inventive step.

For assessing inventive step the EPO generally relies on the problem-solution approach, which requires identifying the closest prior art. According to the examination guidelines and established EPO case law, the closest prior art is the one which corresponds to a similar use and requires the minimum of structural and functional modifications to arrive at the claimed subject matter. In fact, the guidelines state that in selecting the closest prior art, the first consideration is that it should be directed to a similar purpose or effect as the invention.

In its *Fischbissanzeiger* decision, the German Federal Supreme Court now explicitly rejects the concept of selecting one closest prior art document from which it would be necessary to start an inventive step analysis. Rather, an obviousness analysis would need to look at whether more than routine exercise is required to arrive at the claimed subject matter by considering references that would be in the same technical field even if they were not conceived for the same purpose.

While in a lot of situations the different approaches for evaluating inventiveness lead to identical results, there are cases in which the outcome will differ. Given that the skilled person in

German practice is comparatively imaginative and skilful, patentees will need to develop elaborate strategies to avoid the experience that patents that have been upheld by the EPO's Technical Boards of Appeal may nevertheless be revoked in German nullity proceedings over prior art which is even further remote than that considered by the EPO.