

GERMANY



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Changes to nullity proceedings

On May 28 2009 the German Bundestag passed the Law on the simplification and modernisation of patent law, which introduces major changes to nullity proceedings in patent matters.

These changes aim to reduce the length of the proceedings by confining the submissions on the facts of the case to the first instance before the Federal Patent Court.

In future, the Federal Patent Court has to issue an office action before oral proceedings take place. This office action will inform the parties of the aspects of the case that are relevant to its decision and that need further discussion or clarification by the parties. The Federal Patent Court may also set deadlines for submitting evidence and arguments, in order to protect the parties from surprising submissions, in particular in oral proceedings, which often lead to delays in the overall procedure.

The function of the second instance Federal Supreme Court will in the future be restricted to reviewing the decision of the first instance. Hence, the possibility to submit further evidence and arguments will be limited in the second instance. For example, in contrast to the present situation where an expert is regularly appointed by the Federal Supreme Court, an expert will only be appointed in exceptional cases in second instance proceedings.

It remains to be seen how strictly these new rules – in particular with respect to the filing of evidence in the second instance – will be applied by the German courts. For the time being, it may be advisable to file all evidence and arguments – including new claim requests of the patentee – as early as possible in the proceedings. Finally, it is questionable whether these changes will lead to a reduction in the overall length of nullity proceedings or whether the length of the second instance proceedings will be shortened, only to have the first instance proceedings take longer.