

GERMANY



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patent can be attacked during the period when both patents are alive. Note that such an attack may have an unwanted cost for the owner of the German priority patent. To avoid this cost risk, it may be advisable to file an express abandonment of the German priority patent.

The risk of owning co-existing patents

Let us assume a European patent is granted and validated in Germany. The European patent claims priority of an earlier filed German priority application. This priority application becomes a patent and is still alive when the German part of the European patent is validated.

According to German law, the part of the German priority application that overlaps with the scope of the German part of the European patent loses effect. This part cannot be enforced. Thus, if there is 100% overlap, the German priority patent is without effect.

Therefore, when the European patent has been validated in Germany, most applicants stop paying fees for the German priority patent, which eventually is deemed to be withdrawn. However, between the validation of the German patent in Germany and the end of life of the German priority patent, there is usually a period of time when both patents are alive.

Due to the fact that the German priority patent is without effect, it could be assumed that the German priority patent cannot be attacked legally in this period. It could even be expected that such an attack (opposition, appeal, nullity proceeding) is an abuse of legal right.

Recently, the German Federal Supreme Court (BGH) decided that it is possible to attack such a German patent (X ZB 18/06). The Federal Supreme Court confirmed that the German patent is without effect. However, it can still be used by the patent owner, for example for advertising, which may create a competitive advantage. Due to this potential competitive advantage for the patent owner, the Federal Court of Justice decided that it is possible to attack the German priority patent even if it is technically without effect.

Accordingly, the German priority