

I: European Community Patent & Community Patent Court II: New Law on Design Patents in Germany

I. European Community Patent & Community Patent Court

Abstract

European Community Patents will be filed in one of the official languages of the European Patent Office, namely German, English or French. A European Community Patent Court in Luxembourg will be established under the aegis of the European Court of Justice for the resolution of disputes within the future community patent system, in particular those on infringements and on the validity of community patents. The community patent title will, at the latest by 2010 and following a transitional period during which national courts will retain jurisdiction for the subject matter, also be enforceable at a community court whose decisions will enjoy community-wide validity.

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1. Motivation

Nowadays, a national patent resulting from a European patent can be the subject of decisions made by different courts within the different member states of the EP system, such as for example in the case of

- infringement procedures
- invalidity procedures

The disadvantages of today's system are:

- higher procedural costs
- higher watch and survey costs
- higher attorney costs
- legal uncertainty: the courts of different member states may interpret a European patent differently and reach incompatible verdicts. This causes multiple litigation.

To avoid the disadvantages arising with today's European patents, European Community Patents will be established. In order to maximize the benefits of these community patents, a single European Community Patent Court is needed.

2. European Community Patent (ECP)

2.1 Languages and Costs

The language regime must meet the objectives of:

- affordability
- cost-efficiency
- legal certainty
- non-discrimination of any member state.

The European Community Patent has to be filed in one of the official EPO languages (German, English, French).

If an applicant files an application in a non-EPO language and provides a translation into one of the EPO languages, the cost of the translation will be borne by the EPO ("mutualisation of costs").

Upon the grant of a patent all claims have to be translated into all official community languages, unless a member state renounces its right to translations into its official language. The translation costs are borne by the applicant.

The European Council states that the words "upon the grant of the patent" mean within a reasonable time from the date on which the patent is granted. During this time, the granted patent shall be valid. The German delegation, for example, considers a reasonable time to be two years.

2.2 Jurisdiction

The jurisdictional system of the European Community Patent will be based on the principle of a unitary court for the community patent under the aegis of the European Court of Justice. The European Community Patent Court shall have exclusive jurisdiction in actions and claims of invalidity and infringement proceedings, in actions of a declaration of non-infringement, in proceedings relating to the use of the patent or to the rights based on prior use of the patent, or in requests for limitation, counterclaims for invalidity or applications for a declaration of lapse, including requests for provisional measures. The community patent may also be the subject of proceedings to claim damages.

2.3 Formalities

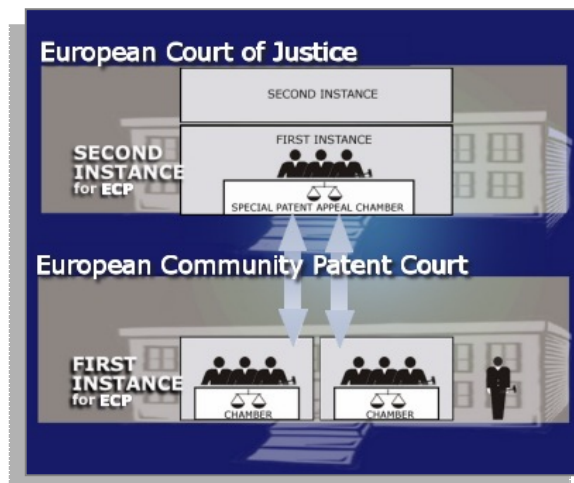
The European Community Patent Court is to be located in Luxembourg.

The European Community Patent Court may hold hearings in member states other than the one in which its seat is located.

The chambers of the European Community Patent Court will each sit with three judges. The judges will be appointed by unanimous decision of the council for a fixed term. The judges of the European Community Patent Court, a specialized Community jurisdiction, should be sufficiently experienced in the field of patents.

This has been expressly recognized by the European Council which agreed in its common political approach that candidates for appointment must have an established high level of legal expertise in patent law and that judges shall be appointed on the basis of their expertise. It is proposed that the European Community Patent Court will consist of seven judges including the president. With the normal composition of the bench being three judges, six judges would permit the formation of two chambers

within the European Community Patent Court. The seventh member would be for the reinforcement of a chamber wherever needed, e.g. due to illness of a judge, or for the chamber presided over by the president of the European Community Patent Court who also has to assume tasks related to the administration and the representation of the European Community Patent Court.



Technical experts will assist the judges throughout the handling of the case. These technical experts will be required to participate in the preparation, the hearing and the deliberation of the case.

An appeal against the final decision of the European Community Patent Court may be brought before the court of first instance of the European Court of Justice. For that purpose it is suggested that a special patent appeal chamber be set up within the European Court of First Instance comprising three judges, all with a high level of legal expertise in patent law.

The European Community Patent Court in the first instance and the patent appeal chamber of the European Court of First Instance in patent appeal proceedings must, as the two stages of a uniform procedure, work to the same set of procedural rules. In principle, European Community patent disputes will be heard by the European Court of First Instance which will have appellate jurisdiction and will be the court of last resort. A further appeal of a case to the European Court of Justice is not foreseen.

2.3 Future Prospect

The European Community Patent will, at the latest by 2010 and following a transitional period during which national courts will retain jurisdiction for the subject matter, also be enforceable by means of a community court system whose decisions will be valid for the whole community.

3. European Community Patent Court

3.1 Status Quo

The European Commission has presented two proposals for two European Council Decisions to establish a community patent jurisdiction

- European Community Patent Court
- 1st proposal (23.12.2003):
 - conferring on the European Court of Justice formal jurisdiction concerning certain disputes over community patents
- 2nd proposal (23.12.2003):
 - establishing a European Community Patent Court consisting of seven judges appointed by the Council of Ministers to exercise the court's jurisdiction on its behalf.
 - establishing a specialized chamber within the European Court of First Instance to hear appeals against the European Community Patent Court's judgements. (In exceptional cases, a decision of the Court of First Instance could be subject to review by the Court of Justice.)
- European Community Patent Court:
 - under the aegis of the European Court of Justice
 - located in Luxembourg
 - exclusive jurisdiction in actions and claims of invalidity and infringement proceedings, in actions of declaration of non-infringement, in proceedings relating to the use of a patent or to rights based on prior use of a patent, or in requests for limitation,
 - counterclaims for invalidity or applications for declaration of lapse, including requests for provisional measures
 - principles of a unitary court for the community patent

- preparation of the Competitiveness Council of Ministers, 11th March 2004:
The agreement reached in March 2003 was on broad outlines and further progress was made towards overall agreement at the November 2003 Council meeting. A small number of points remain outstanding, in particular on requirements for the translation of patents and how infringements of patents which might arise as a result of mistranslations should be treated. The Irish Presidency was presented with alternative texts aimed at resolving these issues at the Competitiveness Council of Ministers.
- **results of the Competitiveness Council of Ministers, Brussels, 11th March 2004:**
The Council **failed to reach agreement** on the proposed regulation for a community patent despite agreement on the broad outlines reached by the same Council in March 2003. The main sticking point was how infringements of patents which might arise as a result of mistranslations should be treated. In the absence of agreement, the Irish Presidency concluded that it would reflect on how to proceed further.

3.2 History

- Dec. 1975:
Community Patent Convention intending to establish a unitary community patent title signed in Luxembourg
- Dec. 1989:
Agreement on the community patent including a protocol on litigation concerning infringement and validity of community patents
- July 2000:
Proposal for a regulation setting up the community patent proposed by the Commission
- Dec. 2000:
EC Treaty of Nice: legal basis for the establishment of community patent jurisdiction:
 - Art. 229a forms the basis for conferral of jurisdiction on the Court
 - Art. 225a, 245 form the basis for the establishment of the Community Patent Court
- March 2003:
Council reached broad political agreement on the main points of the proposal
- March – Nov. 2003:
detailed work by a council working group
- Nov. 2003:
Competitiveness Council
 - very close to an agreement on the outstanding issues
 - failed to agree on period of time during which translation of claims can be filed
- 11th March 2004:
Competitiveness Council of Ministers, Brussels,
Council failed to reach agreement on the proposed regulation creating a community patent.

4. References

Press release, "Industrial property: Commission proposes establishing Community Patent Court", 02.02.2004, Brussels

Commission of the European Community,
"Proposal for a COUNCIL DECISION conferring jurisdiction on the Court of Justice in disputes relating to the community patent", 23.12.2003, Brussels

Forum Gemeinschaftspatent, 08.03.2004

2490th Council Meeting, " – COMPETITIVENESS – ", 03.03.2003, Brussels

Commission of the European Community, "Proposal for a COUNCIL DECISION establishing the Community Patent Court and concerning appeals before the Court of First Instance", 23.12.2003, Brussels

Results of the Competitiveness Council of Ministers, Brussels, 11th March 2004 – internal market, enterprise, consumer protection and research issues

Should you have specific questions on this subject, please feel free to contact me by email or at the address below.



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II. New law on design patents in Germany

The new law on design patents came into force on June 1, 2004.

In our newsletter dated Summer 2003 we reported on a bill to reform the law on design models, which replaces the old law on design models dating from 1876. This new law finally came into force on June 1, 2004.

An important improvement is the development of the law on design patents as an exclusive right, which enables its holder to prevent any third party from using the subject under protection without his permission. Knowledge of the protected design patent is no longer a prerequisite of infringement.

With the new law, protection of the design patent begins no longer on the date of application but on its being entered in the register at the German Patent and Trademark Office. The maximum term of protection is extended from 20 to 25 years. The period of grace is now 12 months.

A two-dimensional or three-dimensional image of a whole product or of a part of it can be protected as a design patent if the image results in particular from characteristics such as outline, contour, color, shape, texture and/or materials of the product itself and/or its ornamentation.

The protection of spare parts for insertion into a complex product is maintained, inasmuch as they are protectable themselves. This regulation is particularly relevant to the market for motor vehicle spare parts.

Should you have specific questions on this subject, please feel free to contact me by email or at the address below.



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