

Why courts and judges need to rely on completely searched and examined patents

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Judge

Problem

- Framework of the patent system
 - „voluntary“ participation of patent applicants
 - generous granting practice?

Where's the problem, if usually everybody gets what they want?

Alternatives to patent applications?

- Know-How
- Utility model

Interim conclusion:

Patent applications are made voluntarily, but inventors depend on the patent system

Reasons for patent applications

- Investment protection by
 - legal protection
 - effective law enforcement
- Legal certainty

§ 58 Patent Act (Germany)

The legal effects of the patent ensue upon publication in the Patent Gazette.

Legal certainty

- Judges basically are bound by the grant of a patent
- Conversely in utility model law:

§ 13 Utility Model Act (Germany)

(1) Registration shall not afford utility model protection where a claim for cancellation of the utility model, assertable by any person, exists against the person registered as the proprietor.

Grant of patents and validity

- ECJ:

“... it must be borne in mind that filed European patents enjoy a presumption of validity from the date of publication of their grant. ...”

- Presumption can be challenged

- various possibilities to attack validity
- infringement proceedings:
 - stay of the proceedings if there are doubts concerning validity
 - dismissal of applications for provisional measures

Necessity of valid patents

- Necessity of valid patents despite the possibility to attack the validity of a patent, which is inherent in the system
- Fundamental principle of law:

„You shall not apply unlawful rules“

Fundamental principle of law

Art. 100 Basic Law for the Federal Republic of Germany

If a court concludes that a law on whose validity its decision depends is unconstitutional, the proceedings shall be stayed, and a decision shall be obtained ... from the Federal Constitutional Court where this Basic Law is held to be violated.

Confidence crisis of jurisdiction?

"...[It is a] common fact that granted patents – despite their expert examination by the authorities ... – statistically only withstand an attack on their legal validity in one out of three cases, whereas in the vast majority of cases, namely in two out of three cases, they are revoked or declared invalid in whole or in part in roughly the same proportion. ...“

(Presiding Judge Kühnen, Higher Regional Court Düsseldorf, GRUR 2021, 466)

Confidence crisis of jurisdiction?

Higher Regional Court Munich:

“...[it] can generally only be assumed that the legal validity of a patent is sufficiently established if the patent has already survived first-instance opposition or nullity proceedings, i.e. a decision confirming its protectability must already be available in opposition/appeal proceedings before the EPO or the Federal Patent Court in nullity proceedings...”

Conclusion

- Inventors need to rely on a functioning patent system
- From an inventors – and competitors – perspective, legal certainty is a necessity of the patent system
- The same is true for courts and judges, because valid patents are the basis for decisions in infringement proceedings
- If there is an excess of faulty granted patents, the confidence of jurisdiction in the granting of patents can get lost
- Such a confidence crisis can adversely affect enforcement of patents

Courts and judges need to rely
on completely searched and examined patents

Invalid patents
are dangerous for the patent system