

GERMANY



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Binding effect of EPO decisions

In a recently issued decision, the German Federal Court of Justice (BGH) had to decide whether decisions of the European Patent Office (EPO) or courts of other European Patent Convention (EPC) member states are binding on German patent courts (Decision of April 15 2010, Xa ZB 10/09 – Walzenformgebungsmaschine).

The court ruled that in proceedings concerning the validity of an industrial property right, such as a patent or utility model, a German court has to take into account previous decisions issued by an Opposition Division or a Board of Appeal of the EPO or by courts of other contracting states of the EPC if these previous decisions relate to essentially the same question. If the German court issues a deviating decision, it has to provide the reasons that led to a different result to the previous decision.

This principle shall also be applied to questions of law, such as the question whether the cited prior art renders obvious the subject-matter of the industrial property right.

For all those who conclude from this ruling that from now on decisions by the EPO will have a binding effect on the German national patent courts, the Reasons for Decision contain a necessary clarification (Reasons, II.2.b): the general principle that decisions of the EPO are not binding for national courts and *vice versa* is still valid. However, in order to ensure uniform application of material patent law, the national courts are obliged to deal with those parts of the EPO decision which address similar material or legal questions – provided these parts are brought forward and discussed by one of the parties.

For all those who suffered from the German Patent Court's past attitude to EPO decisions, which mostly was to ignore them on their own merits, the German Federal Court's decision contains little solace: the court also ruled that not every violation of the above obligation violates the right to be heard of the party concerned.

For all those who wish to rely on an EPO decision in national proceedings in

the future, the practical advice given by the decision is to (1) file the EPO decision and (2) direct the court's attention to the relevant considerations in the EPO decision by discussing them in detail. A mere general reference to the EPO decision will not be sufficient to generate an obligation of the court to deal with the EPO decision's contents.