

GULDE & PARTNER

NEWSLETTER | 1st Quarter 2023

[New handling of national rights](#) | [Appointment of UPC Judges](#) | [New office in Düsseldorf](#) | [Abolishment of 10-day-Rule](#)



New handling of national rights

“National rights do not form state of the art during EP prosecution, but can be dangerous”



During the EPO examination for patentability, earlier national rights do not form state of the art (Art. 54 EPC). However, after a European patent is granted and validated nationally, earlier national rights can be invoked as a ground for revocation in national proceedings (Art. 139(2) EPC). In order to account for this, applicants of an EP patent can file separate sets of claims for countries in which earlier national rights are found (R. 138 EPC).

However, the situation is different in the context of a Unitary Patent since only European patents granted with the same set of claims for all participating EU Member States are eligible for Unitary Patent protection (see Article 3(1) of Regulation (EU) No. 1257/2012).

Consequently, earlier national rights can be invoked as a ground for revocation of a Unitary Patent as a whole.

Thus, from Sep. 1st, 2022 the EPOs examining divisions carry out systematic top-up searches to find "earlier national rights" and assess their prima facie relevance. Identified "earlier national rights" are communicated in the intention-to-grant communication (Rule 71(3) EPC). If no such rights are found, this is communicated as well.

Of course, we will inform you about aforementioned national rights and, if they occur, assist you with the decision to restrict your patent claims either nationally or for your patent as whole. Kindly contact us if you wish to learn more about national rights.



Appointment of UPC Judges

“The UPC judges are appointed & *one third* of them are patent experts from Germany”

The Administrative Committee of the Unified Patent Court (UPC) has announced the complete list of future judges of the European Patent Court

The appointed **legally** qualified judges come from **eleven** of the **16 UPC member states**, while the **technically** qualified judges hail from **eight** of said **16**.

The list comprises **34 legally** and **51 technically** qualified persons, including a total of **27** patent experts from Germany (**12** of them legally, **15** of them technically qualified). The legally qualified judges from Germany include renowned jurists and judges such as **Klaus Grabinski, Patricia Rombach, Matthias Zigann** and **Ulrike Voß**, who will preside over the future proceedings.

German judge **Klaus Grabinski**, currently judge at the German Federal Court of Justice (“BGH”), will be the president of the **Court of Appeal (CoA)**.

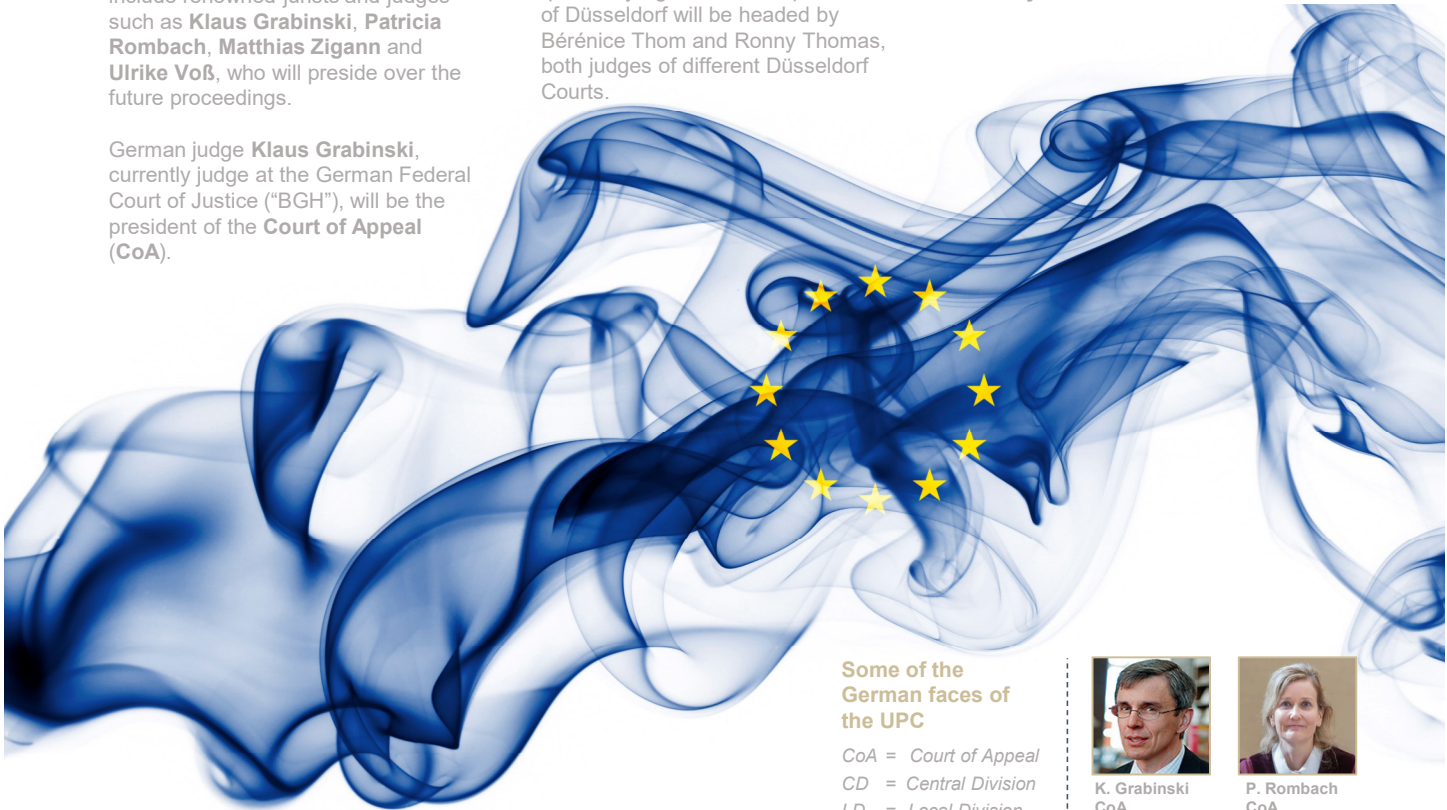
Besides Mr. Grabinski, the board of the **CoA** will comprise six further members, wherein five of them stem from national Appeal Courts from other “UPC countries” as e.g. **France, Italy** and the **Netherlands**.

“Below” the **UPC CoA** (= 2nd instance), there is a **Central Division (CD)** with its seat being based in Paris (**four** members) and a section being based in Munich (**two** members).

The **CD**, together with a **Regional Division** and **13 UPC Local Divisions (LD)** currently forms the 1st instance of the UPC, wherein each of the **LD** is staffed with **three** legally qualified judges. For example, the **LD** of Düsseldorf will be headed by Bérénice Thom and Ronny Thomas, both judges of different Düsseldorf Courts.

Of course, we consider the selection of judges to be quiet satisfactory, as Germany has a strong and well-established patent system, and German judges have **extensive experience** in handling patent cases. This expertise will be valuable in the UPC’s decision-making process and in ensuring that the court’s decisions are consistent and well-informed.

Further, the attorneys of **GULDE** have tried cases before **all** of the German judges appointed for the **UPC**. **We know them, and they know us**. Without doubt, this represents a good and stable “*starting position*” for our firm when the UPC begins operation in **July 2023**.



Some of the German faces of the UPC

CoA = Court of Appeal
 CD = Central Division
 LD = Local Division



K. Grabinski
CoA



P. Rombach
CoA



B. Thom
LD, Düsseldorf



B. Thomas
LD, Düsseldorf



S. Klepsch
LD, Hamburg



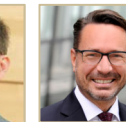
S. Schilling
LD, Hamburg



P. Tochtermann
LD, Mannheim



T. Pichlmaier
LD, Munich



M. Zigann
LD, Munich



M. Haedicke
CD, Paris

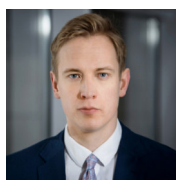


U. Voß
CD, Munich

New office in Düsseldorf

“A city of grace and light, where the Rhine River flows and shines so bright”

Düsseldorf is a German city located in the Rhine-Ruhr metropolitan region, one of the strongest economic regions in Germany and is headquarter to a multitude of international companies, SMEs and thriving startups. It offers a high quality of life with a rich cultural scene, excellent dining and shopping options, and plenty of green spaces.



Nicolas Haße
Partner
German and EP
Patent Attorney



Niklas Mellmann
Senior Associate
German and EP
Patent Attorney

The most important venue for patent litigation

Düsseldorf has been one of the world's leading locations for patent litigation for decades. In 2019 alone, a total of 361 new cases were received by the three competent chambers of the district court. 326 of these were patent disputes, 21 utility model disputes and 14 cases concerned employee inventions. In the same period, the chambers settled a total of 419 disputes.

This makes Düsseldorf the largest location for patent litigation in Germany so far.

With regard to the upcoming “UPC”, both the higher regional court (HRC) as well as the district court (DC) of Düsseldorf will play a significant role: While famous judges of the HRC will form part of UPCs Central Division, judges from the RC will form part of one of the UPCs Local Division being based in Düsseldorf (cf. slide 2).

For these reasons alone, opening a further “GULDE office” on March 1st, 2023 in Düsseldorf was just a logical next step for us.

The office will locally be managed by Senior Associate **Niklas Mellmann** and remotely assisted by Berlin Partner **Nicolas Haße**.

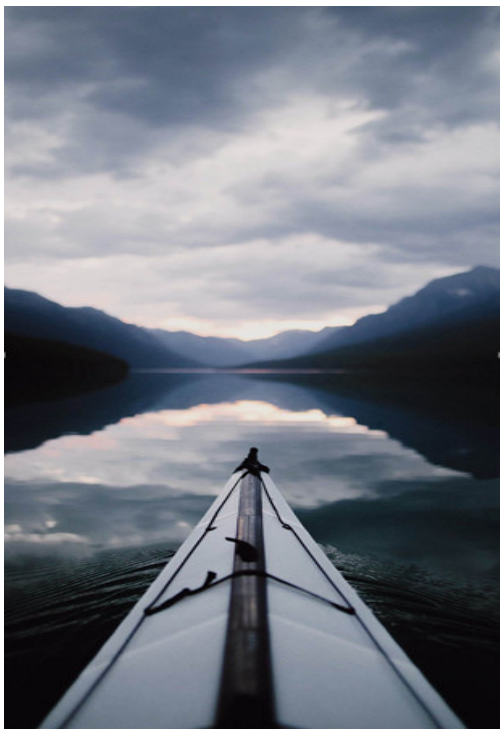
Abolishment of 10-day-Rule

“From paper to digital world: As of November 1st, 2023 the 10-day-Rule will be abolished”

Current Rule 126(2) EPC reads:

Where notification is effected in accordance with paragraph 1, the letter shall be deemed to be delivered to the addressee on the tenth day following its handover to the postal service provider, unless it has failed to reach the addressee or has reached him at a later date; in the event of any dispute, it shall be incumbent on the European Patent Office to establish that the letter has reached its destination or to establish the date on which the letter was delivered to the addressee, as the case may be.

MON	TUE	WED	THU	FRI	SAT	SUN
				1	2	3
	5	6	7	8	9	10
11	12	13	14	15	16	17
18	19	20	21	22	23	24
25	26	27	28	29	30	31

In alignment with the PCT a new fiction for notification and time limit calculation will apply as of 1 November 2023.

The "10-day rule" will be abolished and documents will be deemed to be notified on the date they bear.

Safeguards will be available in cases where a document is not received or received exceptionally late (more than 7 days after the date).

In the event of a dispute concerning the delivery of a document the Office will retain the obligation to prove that the document was delivered and the date of its delivery.

This change affects Rules 126(2), 127(2) and 131(2) EPC. Shifting the focus of the notification system from the paper to the digital world, where electronic documents are delivered on the same day, is key for the Office's digital transformation.



GULDE & PARTNER
PATENT AND LEGAL ATTORNEYS



Gulde & Partner Patent- und Rechtsanwaltskanzlei mbB

GERMANY

Berlin

Wallstr. 58/59
10179 Berlin
Tel. +49 30 20 62 30
Fax. +49 30 20 62 31 27

Munich

Sendliner Straße 2
80331 Munich
Tel. +49 89 23 23 61 82
Fax. +49 89 23 23 61 83

Hamburg

Neuer Wall 10
20354 Hamburg
Tel. +49 40 88 16 56 44
Fax. +49 40 88 16 56 88

Düsseldorf

Neuer Zollhof 3
40221 Düsseldorf
Tel. +49 211 955846-0

JAPAN

Yokohama

4-173-2-205
Noge-cho Naka-ku
Yokohama 231-0064
Tel: +81-(0)45-315-3654
Fax: +81-(0)45-315-3687

CHINA

Beijing

501, South Block, Tower C, Raycom
InfoTech Park No. 2 Kexueyuan South Road, Zhongguancun,
Beijing 100190
Tel: +86 13671205058
Fax: +86 10 6590 7018

E-Mail: office@gulde.com Internet: <http://www.gulde.com>