

Übersetzung durch Ute Reusch in Zusammenarbeit mit dem Sprachendienst des Deutschen Patent- und Markenamts

Translation provided by Ute Reusch in cooperation with the Language Service of the German Patent and Trade Mark Office

Stand: Die Übersetzung berücksichtigt die Änderung(en) des Gesetzes durch Artikel 2 des Gesetzes vom 4.4.2016 (BGBl. I S. 558)

Version information: The translation includes the amendment(s) to the Act by Article 2 of the Act of 4.4.2016 (Federal Law Gazette I p. 558)

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## **Patent Act**

### **(Patentgesetz, PatG)**

Patent Act as published on 16 December 1980 (Federal Law Gazette 1981 I p. 1), as last amended by Article 2 of the Act of 4 April 2016 (Federal Law Gazette I p. 558)

#### **Part I**

#### **The patent**

##### **Section 1**

(1) Patents shall be granted for any inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application.

(2) Patents shall be granted for inventions within the meaning of subsection (1) even if they concern a product consisting of or containing biological material or a process by means of which biological material is produced, processed or used. Biological material which is isolated from its natural environment or produced by means of a technical process can also be the subject of an invention even if it previously occurred in nature.

(3) The following in particular shall not be regarded as inventions within the meaning of subsection (1):

1. discoveries, scientific theories and mathematical methods;
2. aesthetic creations;
3. schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;
4. presentations of information.

(4) Subsection (3) shall exclude patentability only to the extent to which protection is being sought for the subject-matter or activities referred to as such.

##### **Section 1a**

(1) The human body, at the various stages of its formation and development, including germ cells, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions.

(2) An element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention even if the structure of that element is identical to the structure of a natural element.

(3) The industrial application of a sequence or partial sequence of a gene shall be disclosed in the application specifying the function performed by the sequence or partial sequence.

(4) If the invention concerns a sequence or partial sequence of a gene whose structure corresponds to that of a natural sequence or partial sequence of a human gene, the patent claim shall include its use for which industrial application is disclosed pursuant to subsection (3).

## **Section 2**

(1) No patents shall be granted for inventions the commercial exploitation of which would be contrary to “ordre public” or morality; such exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation.

(2) Patents shall in particular not be granted for

1. processes for cloning human beings;
2. processes for modifying the germ line genetic identity of human beings;
3. uses of human embryos for industrial or commercial purposes;
4. processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes.

The relevant provisions of the Embryo Protection Act (Embryonenschutzgesetz) shall govern the application of nos 1 to 3.

## **Section 2a**

(1) Patents shall not be granted for

1. plant and animal varieties and essentially biological processes for the production of plants and animals and the plants and animals produced exclusively by such processes;
2. methods for the treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body. This shall not apply to products, in particular to substances or compositions, for use in one of these methods.

(2) Patents can be granted for inventions which concern

1. plants or animals if the technical feasibility of the invention is not confined to a particular plant or animal variety;
2. a microbiological or other technical process, or a product obtained by means of such a process other than a plant or animal variety.

Section 1a (3) shall apply mutatis mutandis.

(3) For the purposes of this Act,

1. “biological material” means any material containing genetic information and capable of reproducing itself or being reproduced in a biological system;
2. “microbiological process” means any process involving or performed upon or resulting in microbiological material;
3. “essentially biological process” means a process for the production of plants or animals consisting entirely of natural phenomena such as crossing or selection;
4. “plant variety” means a variety as defined in Council Regulation (EC) No 2100/94 of 27 July 1994 on Community plant variety rights (OJ L 227 p. 1), as amended.

## **Section 3**

(1) An invention shall be deemed to be new if it does not form part of the state of the art. The state of the art shall be held to comprise all knowledge made available to the public before the date governing the filing or priority date of the application by means of a written or oral description, by use or in any other way.

(2) The content of the following patent applications having an earlier filing or priority date which were made available to the public on or after the date governing the filing or priority date of the later application shall also be deemed to be comprised in the state of the art:

1. national applications as filed with the German Patent and Trade Mark Office;
2. European applications as filed with the competent authority if the application seeks protection in the Federal Republic of Germany and the designation fee has been paid in respect of the Federal Republic of Germany pursuant to Article 79 paragraph 2 of the European Patent Convention, and if, in the case of a Euro-PCT application (Article 153 paragraph 2 of the European Patent Convention), the requirements laid down in Article 153 paragraph 5 of the European Patent Convention are fulfilled;
3. international applications under the Patent Cooperation Treaty as filed with the receiving Office, provided the German Patent and Trade Mark Office is the designated Office in respect of the application.

If the earlier filing or priority date of an application is based on the claim to the priority of an earlier application, the first sentence shall apply only to the extent that the version of the application in question does not extend beyond the version of the earlier application. Patent applications pursuant to the first sentence, no. 1, in respect of which an order has been made in accordance with section 50 (1) or (4) shall be deemed to have been made available to the public after the expiry of a period of eighteen months following their filing.

(3) Subsections (1) and (2) shall not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in section 2a (1) no. 2, provided that its use for any such method is not comprised in the state of the art.

(4) Subsections (1) and (2) shall also not exclude the patentability of any substance or composition referred to in subsection (3) for any specific use in a method referred to in section 2a (1) no. 2, provided that such use is not comprised in the state of the art.

(5) For the application of subsections (1) and (2), a disclosure of the invention shall not be taken into consideration if it occurred no earlier than six months before the filing of the application and if it was due to, or in consequence of

1. an evident abuse in relation to the applicant or his legal predecessor, or
2. the fact that the applicant or his legal predecessor has displayed the invention at an official, or officially recognised, international exhibition falling within the terms of the Convention on international exhibitions signed at Paris on 22 November 1928.

The first sentence, no. 2, shall apply only if the applicant states, when filing the application, that the invention has been so displayed and files a certificate to that effect within four months of the filing. Exhibitions referred to in the first sentence, no. 2, shall be notified by the Federal Minister of Justice and Consumer Protection in the Federal Gazette (Bundesanzeiger).

#### **Section 4**

An invention shall be deemed to involve an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. If the state of the art also includes documents within the meaning of section 3 (2), these documents shall not be considered in deciding whether there has been an inventive step.

#### **Section 5**

An invention shall be deemed to be susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

### **Section 6**

The right to a patent shall belong to the inventor or his successor in title. If two or more persons have jointly made an invention, the right to the patent shall belong to them jointly. If two or more persons have made the invention independently of each other, the right shall belong to the person who is the first to file the application in respect of the invention with the German Patent and Trade Mark Office.

### **Section 7**

(1) In order to avoid the substantive examination of the patent application being delayed due to the need to establish the identity of the inventor, the applicant shall be deemed, in the proceedings before the German Patent and Trade Mark Office, to be entitled to request the grant of the patent.

(2) If a patent is revoked on account of opposition filed on the ground of usurpation (section 21 (1) no. 3) or if opposition results in the surrender of the patent, the opponent can himself file an application in respect of the invention within one month of the official communication thereof and claim the priority of the earlier patent.

### **Section 8**

The entitled person in respect of whose invention an application has been filed by a non-entitled person or a party aggrieved by usurpation can require the patent applicant to assign to him the right to the grant of the patent. Where the application has already resulted in a patent, he can require the proprietor of the patent to transfer the patent. Subject to the fourth and fifth sentences, the right can be asserted by bringing an action only within a time limit of two years after publication of the grant of the patent (section 58 (1)). If the aggrieved party has filed opposition on the ground of usurpation (section 21 (1) no. 3), he can still bring an action within one year of the final conclusion of the opposition proceedings. The third and fourth sentences shall not apply if the proprietor of the patent did not act in good faith when obtaining the patent.

### **Section 9**

The patent shall have the effect that the proprietor of the patent alone shall be entitled to use the patented invention within the scope of the law in force. In the absence of the consent of the proprietor of the patent, any third party shall be prohibited from

1. producing, offering, putting on the market or using a product which is the subject-matter of the patent, or from either importing or possessing such a product for the purposes referred to;
2. using a process which is the subject-matter of the patent or, if the third party knows or if it is obvious from the circumstances that use of the process is prohibited in the absence of the consent of the proprietor of the patent, from offering the process for use within the territorial scope of this Act;
3. offering, placing on the market or using a product which is produced directly by a process which is the subject-matter of the patent, or from either importing or possessing such a product for the purposes referred to.

### **Section 9a**

(1) Where the patent concerns biological material possessing specific characteristics as a result of an invention, the effects of section 9 shall extend to any biological material derived from that biological material through propagation or multiplication in an identical or divergent form and possessing those same characteristics.

(2) Where the patent concerns a process which enables biological material to be produced which possesses specific characteristics as a result of an invention, the effects of section 9 shall extend to biological material directly obtained through that process and to any other biological material derived from the directly obtained biological material through propagation or multiplication in an identical or divergent form and possessing those same characteristics.

(3) Where the patent concerns a product which contains or consists of genetic information as a result of an invention, the effects of section 9 shall extend to all material in which the product is incorporated and in which the genetic information is contained and performs its function. Section 1a (1) shall remain unaffected.

#### **Section 9b**

If the proprietor of the patent or a third party, with the consent of the proprietor of the patent, places on the market biological material which possesses specific characteristics as a result of the invention, in the territory of a Member State of the European Union or in a Contracting Party to the Agreement on the European Economic Area, and if further biological material is obtained from this biological material through propagation or multiplication, the effects of section 9 shall have no effect where the propagation or multiplication of the biological material was the purpose for which it was placed on the market. This shall not apply where the material obtained in this way is subsequently used for further propagation or multiplication.

#### **Section 9c**

(1) Where plant propagating material is marketed by the proprietor of the patent or by a third party with the consent of the proprietor of the patent to a farmer for agricultural use, the latter shall, contrary to sections 9, 9a and 9b, second sentence, be entitled to use the product of his harvest for propagation or multiplication by him on his own holding. Article 14 of Council Regulation (EC) No 2100/94, as amended, as well as the implementing rules adopted on that basis shall apply to the conditions and extent of this authorisation. Where claims arise therefrom for the proprietor of the patent, these claims are to be asserted pursuant to the implementing rules adopted on the basis of Article 14 paragraph 3 of Council Regulation (EC) No 2100/94.

(2) Where livestock or animal reproductive material are marketed to a farmer by the proprietor of the patent or by a third party with the consent of the proprietor of the patent, the farmer shall, contrary to sections 9, 9a and 9b, second sentence, be entitled to use the livestock or the animal reproductive material for agricultural purposes. This entitlement shall also include making the livestock or other animal reproductive material available for the purposes of pursuing the farmer's agricultural activity, but not the sale for the purpose or within the framework of a commercial reproduction activity.

(3) Section 9a (1) to (3) shall not apply to biological material obtained during agricultural activity by chance or in such manner as to be technically unavoidable. As a rule, a claim cannot therefore be brought on this ground against a farmer if he used the seeds or plants not subject to such patent protection.

#### **Section 10**

(1) The patent shall further have the effect that any third party shall be prohibited, in the absence of the consent of the proprietor of the patent, from supplying or offering to supply, within the territorial scope of this Act, persons other than those entitled to exploit the patented invention with means relating to an essential element of the invention for use within the territorial scope of this Act if the third party knows or if it is obvious from the circumstances that those means are suitable and intended for using that invention.

(2) Subsection (1) shall not apply if the means are generally available commercial products, except where the third party induces the person supplied to perform any of the acts prohibited under section 9, second sentence.

(3) Persons performing the acts referred to in section 11 nos 1 to 3 shall be deemed, within the meaning of subsection (1), not to be persons entitled to exploit the invention.

#### **Section 11**

The effect of a patent shall not extend to

1. acts done privately and for non-commercial purposes;

2. acts done for experimental purposes relating to the subject-matter of the patented invention;
  - 2a. the use of biological material for the purpose of breeding, discovering and developing a new plant variety;
  - 2b. studies, experiments and the practical requirements resulting therefrom which are necessary for obtaining authorisation to place medicinal products on the market in the European Union, or which are necessary for obtaining authorisation to place medicinal products on the market in the Member States of the European Union or in third countries;
3. the extemporaneous preparation in a pharmacy, for individual cases, of a medicine in accordance with a medical prescription or acts concerning the medicine so prepared;
4. the use of the patented invention on board vessels of another State party to the Paris Convention for the Protection of Industrial Property in the body of such vessel, in the machinery, tackle, gear and other accessories, when such vessels temporarily or accidentally enter the waters to which the territorial scope of this Act extends, provided that the patented invention is used there exclusively for the needs of the vessel;
5. the use of the patented invention in the construction or the operation of aircraft or land vehicles of another State party to the Paris Convention for the Protection of Industrial Property or the use of accessories to such aircraft or land vehicles when these temporarily or accidentally enter the territorial scope of this Act;
6. the acts specified in Article 27 of the Convention on International Civil Aviation of 7 December 1944 (Federal Law Gazette 1956 II p. 411) where these acts concern the aircraft of another State to which this article shall apply.

#### **Section 12**

- (1) The patent shall have no effect in respect of a person who, at the time the application was filed, had already begun to use the invention in Germany or had made the necessary arrangements for so doing. That person shall be entitled to use the invention for the needs of his own business in his own workshops or in the workshops of others. This entitlement may be inherited or sold only together with the business. Where the applicant or his legal predecessor has, before filing the application, disclosed the invention to others and, in so doing, has reserved his rights in the event of a patent being granted, a person learning of the invention as a result of this disclosure may not invoke measures referred to in the first sentence which he has taken within six months of the disclosure.
- (2) If the proprietor of the patent is entitled to a right of priority, the earlier application shall be decisive and not the application referred to in subsection (1). However, this shall not apply to nationals of a foreign state which does not guarantee reciprocity in this respect if they claim priority of a foreign application.

#### **Section 13**

- (1) The patent shall have no effect in a case where the Federal Government orders that the invention is to be used in the interest of public welfare. Further, it shall not extend to a use of the invention which is ordered in the interest of the security of the Federal Republic of Germany by the competent highest federal authority or by a subordinate authority acting on its instructions.
- (2) The Federal Administrative Court shall be competent to hear an appeal from an order made pursuant to subsection (1) if the order was made by the Federal Government or by the competent highest federal authority.
- (3) In the cases referred to in subsection (1), the proprietor of the patent shall be entitled to equitable remuneration from the Federal Republic of Germany. In the event of dispute as to its amount, recourse may be taken to the ordinary courts. A Federal Government order



pursuant to subsection (1), first sentence, shall be communicated to the person entered in the Register as the proprietor of the patent (section 30 (1)) before the invention is used. Where the highest federal authority which issued an order or instruction in accordance with subsection (1), second sentence, obtains knowledge of a remuneration claim in accordance with the first sentence, this authority shall communicate this to the person registered as the proprietor of the patent.

#### **Section 14**

The extent of the protection conferred by the patent and the patent application shall be determined by the patent claims. Nevertheless, the description and the drawings shall be used to interpret the patent claims.

#### **Section 15**

(1) The right to the patent, the entitlement to the grant of the patent and the right deriving from the patent shall devolve upon the heirs. Their rights may be transferred to others with or without limitation.

(2) The rights under subsection (1) can be the subject of exclusive or non-exclusive licences, in full or in part, for the entire territorial scope of this Act or a part thereof. Where a licensee contravenes a limitation of his licence under the first sentence, the right deriving from the patent may be asserted against him.

(3) A transfer of rights or the grant of a licence shall not affect licences previously granted to third parties.

#### **Section 16**

The term of the patent shall be twenty years, commencing on the date following the filing of the application in respect of the invention.

#### **Section 16a**

(1) An application for supplementary protection for the patent can be filed pursuant to the provisions set out in the Regulations of the European Communities concerning the creation of supplementary protection certificates, reference to which shall be made in the Federal Law Gazette, which supplementary protection shall follow immediately upon expiry of the patent in accordance with section 16. Annual renewal fees shall be paid for supplementary protection.

(2) Unless otherwise provided by the law of the European Communities, the provisions of this Act regarding the applicant's entitlement (sections 6 to 8), regarding the effect of the patent and the exceptions thereto (sections 9 to 12), regarding an order for use and the compulsory licence (sections 13 and 24), regarding the extent of protection (section 14), regarding licences and their registration (sections 15 and 30), regarding the lapse of the patent (section 20), regarding revocation (section 22), regarding the willingness to grant a licence (section 23), regarding representatives in Germany (section 25), regarding the Federal Patent Court and proceedings before the Federal Patent Court (sections 65 to 99), regarding proceedings before the Federal Court of Justice (sections 100 to 122a), regarding the re-establishment of rights (section 123), regarding the obligation to tell the truth (section 124), regarding electronic documents (section 125a), regarding the official language, notifications and judicial assistance (sections 126 to 128), regarding legal infringements (sections 139 to 141a, 142a and 142b), regarding the joinder of actions and arrogation of patent (sections 145 and 146) shall apply mutatis mutandis to supplementary protection.

(3) Licences and declarations made pursuant to section 23 which take effect for a patent shall also apply mutatis mutandis to supplementary protection.

#### **Section 17**

An annual renewal fee shall be paid for each application and each patent for the third year and each subsequent year calculated from the date of filing.

**Section 18  
(repealed)**

**Section 19  
(repealed)**

**Section 20**

(1) The patent shall lapse if

1. the proprietor of the patent surrenders it by written declaration to the German Patent and Trade Mark Office, or
2. the annual renewal fee or the difference is not paid in due time (section 7 (1), section 13 (3) or section 14 (2) and (5) of the Patent Costs Act (Patentkostengesetz), section 23 (7), fourth sentence, of this Act).

(2) The decision as to whether the payment has been made in due time shall lie solely with the German Patent and Trade Mark Office; sections 73 and 100 shall remain unaffected.

**Section 21**

(1) The patent shall be revoked (section 61) if it emerges that

1. the subject-matter of the patent is not patentable in accordance with sections 1 to 5;
2. the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
3. the essential content of the patent has been taken from the descriptions, drawings, models, implements or equipment of another person or from a process used by this person, without his consent (usurpation);
4. the subject-matter of the patent extends beyond the content of the application as filed with the competent authority; the same shall apply if the patent was granted on a divisional application or on a new application filed under section 7 (2), and the subject-matter of the patent extends beyond the content of the earlier application as filed with the competent authority.

(2) Where the grounds for revocation refer only to part of the patent, it shall be maintained with a corresponding limitation. The limitation may be effected in the form of an amendment of the patent claims, the description or the drawings.

(3) Upon revocation, the patent and the application shall be deemed not to have had, from the outset, the effects specified. In the event of maintenance with limitation, this provision shall apply mutatis mutandis.

**Section 22**

(1) A patent shall be revoked upon request (section 81) if it emerges that one of the grounds listed in section 21 (1) applies or that the scope of protection of the patent has been extended.

(2) Section 21 (2) and (3) shall apply mutatis mutandis.

**Section 23**

(1) Where a patent applicant or the person entered in the Register as the proprietor of the patent (section 30 (1)) declares to the German Patent and Trade Mark Office in writing that he is willing to allow anyone to use the invention in return for equitable remuneration, the annual renewal fees due in respect of the patent following receipt of the declaration shall be reduced to one half. The declaration shall be recorded in the Register and published in the Patent Gazette (Patentblatt).



- (2) The declaration shall be inadmissible as long as there is an entry in the Register regarding the grant of an exclusive licence (section 30 (4)) or an application is pending before the German Patent and Trade Mark Office for such entry to be made.
- (3) Any person who, subsequent to the declaration being entered, wishes to use the invention shall inform the proprietor of the patent of his intention. The information shall be deemed to have been effected if it has been dispatched by registered letter to the person entered in the Register as the proprietor of the patent or to his registered representative or the person authorised to accept service (section 25). The information shall indicate how the invention is to be used. Subsequent to the information, the informing party shall be entitled to effect use in the manner he has indicated. He shall be obliged, after the expiry of each calendar quarter, to inform the proprietor of the patent of the use effected and to pay the remuneration for that use. If he does not fulfil this obligation in due time, the person registered as proprietor of the patent may set him a reasonable extension of time for payment and, following expiry without the obligation being fulfilled, may prohibit further use of the invention.
- (4) The remuneration shall be fixed by the Patent Division upon the written request of a party. Sections 46, 47 and 62 shall apply mutatis mutandis to the procedure. The request may be directed against more than one party. When fixing the amount of the remuneration the German Patent and Trade Mark Office may make an order requiring the party opposing the request to bear the costs of the procedure in whole or in part.
- (5) After the expiry of a period of one year following the last fixing of remuneration, any party affected thereby may apply for its adjustment if in the meantime circumstances have arisen or become known which make the remuneration fixed appear obviously inappropriate. In other respects, subsection (4) shall apply mutatis mutandis.
- (6) Where the declaration is made in respect of an application, the provisions of subsections (1) to (5) shall apply mutatis mutandis.
- (7) The declaration may be withdrawn in writing vis-à-vis the German Patent and Trade Mark Office at any time, as long as the proprietor of the patent has not been informed of any intention to use the invention. The withdrawal shall take effect when it is filed. The sum by which the annual renewal fees have been reduced shall be paid within one month of the withdrawal of the declaration. If the difference is not paid within the time limit specified in the third sentence, it may still be paid together with the surcharge for late payment before the expiry of a period of a further four months.

#### **Section 24**

- (1) The non-exclusive authorisation to commercially use an invention shall be granted by the Federal Patent Court in an individual case in accordance with the following provisions (compulsory licence) where
1. a licence seeker has, within a reasonable period of time, unsuccessfully attempted to obtain permission from the proprietor of the patent to use the invention on reasonable commercial terms and conditions, and
  2. the public interest calls for the grant of a compulsory licence.
- (2) Where a licence seeker cannot exploit an invention for which he holds protection under a patent with a later filing or priority date without infringing a patent with an earlier filing or priority date, he shall be entitled, in respect of the proprietor of the patent with the earlier filing or priority date, to the grant of a compulsory licence from the proprietor of the patent if
1. the condition under subsection (1) no. 1 is fulfilled, and
  2. his own invention demonstrates an important technological advance of substantial economic significance compared to that of the patent with the earlier filing or priority date.

The proprietor of the patent can require the licence seeker to grant him a cross-licence on reasonable terms and conditions for the use of the patented invention with the later filing or priority date.

(3) Subsection (2) shall apply *mutatis mutandis* where a plant breeder cannot obtain or exploit a plant variety right without infringing an earlier patent.

(4) A compulsory licence under subsection (1) may be granted for a patented invention in the field of semiconductor technology only where this is necessary to eliminate those anti-competitive practices pursued by the proprietor of the patent which have been established in court or administrative proceedings.

(5) Where the proprietor of the patent does not apply the patented invention in Germany or does not do so predominantly, compulsory licences in accordance with subsection (1) may be granted to ensure an adequate supply of the patented product on the German market. Import shall thus be equivalent to the use of the patent in Germany.

(6) The grant of a compulsory licence in respect of a patent shall be admissible only after the patent has been granted. The compulsory licence may be granted subject to limitations and made dependent on conditions. The extent and the duration of use shall be limited to the purpose for which the compulsory licence was granted. The proprietor of the patent shall be entitled to remuneration from the proprietor of the compulsory licence, such remuneration being equitable in the circumstances of the case and taking into account the economic value of the compulsory licence. Where, in relation to recurrent remuneration payments due in the future, there is a substantial change in the circumstances which governed the fixing of the amount of remuneration, each party shall be entitled to require a corresponding adjustment. Where the circumstances upon which the grant of a compulsory licence was based no longer apply and if their recurrence is improbable, the proprietor of the patent can require withdrawal of the compulsory licence.

(7) A compulsory licence in respect of a patent may be transferred only together with the business which is involved in exploiting the invention. A compulsory licence in respect of an invention which is the subject-matter of a patent with an earlier filing or priority date may be transferred only together with the patent with a later filing or priority date.

## **Section 25**

(1) Any person who has neither their residence nor principal place of business nor an establishment in Germany may participate in the proceedings before the German Patent and Trade Mark Office or the Federal Patent Court which are regulated under this Act and assert the rights deriving from a patent only if he has appointed as his representative in Germany a lawyer or patent attorney who is authorised to represent him in proceedings before the German Patent and Trade Mark Office, before the Federal Patent Court and in civil litigation affecting the patent, as well as to file an application for criminal prosecution.

(2) Nationals of a Member State of the European Union or of another Contracting Party to the Agreement on the European Economic Area can be appointed as a representative within the meaning of subsection (1) for the purpose of providing a service within the meaning of the Treaty establishing the European Community if they are entitled to practise their professional activity under one of the professional titles referred to in the Annex to section 1 of the Act on the Activities of European Lawyers in Germany (Gesetz über die Tätigkeit europäischer Rechtsanwälte in Deutschland) of 9 March 2000 (Federal Law Gazette I p. 182) or to section 1 of the Act on the Qualifying Examination for Admission to Practise as a Patent Attorney (Gesetz über die Eignungsprüfung für die Zulassung zur Patentanwaltschaft) of 6 July 1990 (Federal Law Gazette I p. 1349, 1351), as amended.

(3) The place where a representative appointed pursuant to subsection (1) has his commercial premises shall be deemed, within the meaning of section 23 of the Code of Civil Procedure (Zivilprozessordnung), to be the place where the asset is located; if there are no such commercial premises, the place where the representative is residing in Germany shall be decisive or, if there is no such place, the place where the German Patent and Trade Mark Office has its seat.

(4) The legal termination of the appointment of a representative in accordance with subsection (1) shall not become effective until the German Patent and Trade Mark Office or the Federal Patent Court has been informed of both the termination of this appointment and the appointment of another representative.

## **Part II** **The German Patent and Trade Mark Office**

### **Section 26**

(1) The German Patent and Trade Mark Office (Deutsches Patent- und Markenamt) is an independent higher federal authority within the remit of the Federal Ministry of Justice and Consumer Protection. Its seat is in Munich.

(2) The German Patent and Trade Mark Office shall be composed of a President and further members. They must be qualified under the terms of the German Judiciary Act (Deutsches Richtergesetz) to hold judicial office (legally qualified members) or have expertise in a field of technology (technically qualified members). The members shall be appointed for life.

(3) As a rule, only a person who has passed a state or academic final examination in a technical or natural science subject at a university, technical or agricultural institution of higher education, or at a mining academy in Germany and who thereafter has worked in the field of natural sciences or technology for at least five years and who has the requisite legal knowledge may be employed as a technically qualified member. In accordance with the law of the European Communities, final examinations in another Member State of the European Union or in another Contracting Party to the Agreement on the European Economic Area shall be equivalent to a final examination in Germany.

(4) In case of a need which is expected to be limited as to time, the President of the German Patent and Trade Mark Office may commission persons who have the educational and additional background required for membership (subsection (2) and (3)) to perform the duties of a member of the German Patent and Trade Mark Office (assistant members). The commission can be effected for a specified time or for as long as necessary and may not be revoked during that period. In other respects, the provisions governing members shall also apply to the assistant members.

### **Section 27**

(1) The following shall be set up within the German Patent and Trade Mark Office:

1. examining sections responsible for processing patent applications and providing information on the state of the art (section 29 (3));

2. Patent Divisions responsible for all matters concerning the patents granted, the fixing of remuneration (section 23 (4) and (6)) and granting of legal aid in proceedings before the German Patent and Trade Mark Office. It shall also be incumbent upon each Patent Division to render expert opinions within its sphere of business (section 29 (1) and (2)).

(2) The obligations incumbent upon the examining section shall be performed by a technically qualified member of the Patent Division (patent examiner).

(3) The Patent Division shall constitute a quorum when at least three members are participating, at least two of whom must be technically qualified members in cases where the Division is operating in opposition proceedings. Where the case presents particular legal difficulties and if none of the participants is a legally qualified member, a legally qualified member of the Patent Division shall be involved in taking the decision. A decision on the basis of which a request to consult a legally qualified member is refused shall not be independently contestable.

(4) The chair of the Patent Division may act alone in handling all Patent Division matters, except for decisions regarding the maintenance, revocation or limitation of a patent, as well as regarding the fixing of remuneration (section 23 (4)), or he may delegate these tasks to a technically qualified member of the Division; this shall not apply to a hearing.

(5) The Federal Ministry of Justice and Consumer Protection shall be authorised, by issuing an ordinance, to entrust civil servants of the upper and intermediate grades and comparable employees with the handling of matters incumbent upon the examining sections or Patent Divisions and which by their nature present no particular technical or legal difficulties; however, this shall exclude the grant of a patent and the refusal of an application on grounds in respect of which the applicant has filed an opposition. The Federal Ministry of Justice and Consumer Protection may, by statutory instrument, delegate this authorisation to the German Patent and Trade Mark Office.

(6) Sections 41 to 44, section 45 (2), second sentence, and sections 47 to 49 of the Code of Civil Procedure concerning the exclusion of and objection to court personnel shall apply mutatis mutandis to the exclusion of and objection to the patent examiners and other technically qualified members of the Patent Divisions. The same shall apply to civil servants of the upper and intermediate grades and to employees in so far as they have been entrusted pursuant to subsection (5) with the handling of individual matters incumbent upon the examining sections or Patent Divisions. The Patent Division shall decide on the objection request in so far as a decision is necessary.

(7) Experts who are not members may be consulted in the course of deliberations in the Patent Divisions; they may not take part in the voting.

#### **Section 28**

The Federal Ministry of Justice and Consumer Protection shall regulate, by statutory instrument not requiring the consent of the Bundesrat, the establishment and the course of business of the German Patent and Trade Mark Office as well as the form of proceedings in patent matters, unless provision has been made by law in respect thereof.

#### **Section 29**

(1) The German Patent and Trade Mark Office shall be obliged to provide opinions at the request of the courts or of the public prosecution offices with regard to questions relating to patents if divergent opinions have been submitted in the proceedings by more than one expert.

(2) In other respects, the German Patent and Trade Mark Office shall not be entitled to take decisions or to provide opinions outside of its statutory scope of activities without the permission of the Federal Minister of Justice and Consumer Protection.

(3) For the purpose of making available documentation of the German Patent and Trade Mark Office, the Federal Ministry of Justice and Consumer Protection shall be authorised to determine, by statutory instrument not requiring the consent of the Bundesrat, that the German Patent and Trade Mark Office provide information on the state of the art without there being any guarantee that such information is complete. It may in particular determine the requirements for, the manner and extent of the provision of information, as well as the technical fields in which information may be provided. The Federal Ministry of Justice and Consumer Protection may, by statutory instrument not requiring the consent of the Bundesrat, delegate this authorisation to the German Patent and Trade Mark Office.

#### **Section 30**

(1) The German Patent and Trade Mark Office shall maintain a Register in which a record shall be kept of the titles of patent applications in respect of which file inspection is granted to any person, of patents granted and supplementary protection certificates (section 16a) as well as of the names and addresses of the applicants or proprietors of patents and of any representatives or persons authorised to accept service appointed pursuant to section 25, whereby the registration of one representative or person authorised to accept service shall suffice. The Register shall also record the commencement, expiry, lapse, order of limitation, revocation of the patents and invalidity of supplementary protection certificates (section 16a) as well as the filing of a notice of opposition and a revocation action.

(2) The President of the German Patent and Trade Mark Office may determine that further information be entered in the Register.

(3) The German Patent and Trade Mark Office shall record in the Register a change in the person, name or place of residence of the applicant or proprietor of the patent and his representative and the person authorised to accept service if proof thereof is furnished to the German Patent and Trade Mark Office. Until the change has been entered, the former applicant, proprietor of the patent, representative or person authorised to accept service shall remain subject to the rights and obligations as provided under this Act.

(4) The German Patent and Trade Mark Office shall, at the request of the proprietor of the patent or licensee, enter in the Register the grant of an exclusive licence if proof of the consent of the other party is furnished to the German Patent and Trade Mark Office. The request pursuant to the first sentence shall be inadmissible in a case where the willingness to grant a licence has been declared (section 23 (1)). The entry shall be cancelled at the request of the proprietor of the patent or licensee. A request for cancellation made by the proprietor of the patent shall require proof of the consent of the licensee designated upon entry or of his successor in title.

(5) (repealed)

### **Section 31**

(1) Upon request the German Patent and Trade Mark Office shall grant any person inspection of the files as well as of the models and samples pertaining to the files if and in so far as a legitimate interest is substantiated. However, any person may inspect the Register and the patent files, including the files concerning limitation or revocation proceedings (section 64).

(2) Any person may inspect the files of patent applications if

1. the applicant has declared his consent vis-à-vis the German Patent and Trade Mark Office to inspection of the files and has designated the inventor, or

2. a period of eighteen months has expired since the date of filing (section 35) or, if an earlier date is claimed to govern the application, since that date,

and information has been published in accordance with section 32 (5). If the application or part of the application is not in German, section 35a (4) shall apply.

(3) In so far as any person may inspect the files, he may also inspect the models and samples pertaining to the files.

(3a) In so far as any person may inspect the files, inspection may also be granted via the internet where the files are kept electronically.

(3b) The inspection of the files in accordance with subsections (1) to (3a) shall be ruled out where it is precluded by a legal provision or where an interest meriting protection of the person concerned within the meaning of section 3 (1) of the Federal Data Protection Act (Bundesdatenschutzgesetz) obviously prevails.

(4) Inspection of the designation of the inventor (section 37 (1)) shall be granted in accordance with subsection (1), first sentence, only where applied for by the inventor designated by the applicant; section 63 (1), fourth and fifth sentences, shall apply mutatis mutandis.

(5) The German Patent and Trade Mark Office may grant inspection of the files of patent applications and patents in respect of which, pursuant to section 50, there is no publication at all, only after consulting the competent highest federal authority if and in so far as the granting of inspection seems necessary due to the special interest meriting protection of the person making the request and it is not to be expected that granting of inspection will cause a risk of serious detriment to the external security of the Federal Republic of Germany. If a patent application or a patent pursuant to section 3 (2), third sentence, is cited in proceedings as the state of the art, the first sentence shall apply mutatis mutandis to such part of the files as relates to that citation.

### **Section 32**

(1) The German Patent and Trade Mark Office shall publish



1. the first publication of the application,
2. the patent specifications, and
3. the Patent Gazette.

Publication may be effected in electronic form. The German Patent and Trade Mark Office may transmit the documents referred to in the first sentence to third persons in electronic form for further processing or use for the purposes of providing information regarding a patent. No such transmission shall take place where inspection of the files is ruled out (section 31 (3b)).

(2) The first publication of the application comprises those documents which may be inspected by any person in accordance with section 31 (2) as well as the abstract (section 36) as filed or in the altered form as accepted by the German Patent and Trade Mark Office for publication. The first publication of the application shall not be published if the patent specification has already been published.

(3) The patent specification contains the patent claims, the description and the drawings on the basis of which the patent was granted. In addition, the patent specification shall indicate the state of the art which the German Patent and Trade Mark Office took into account when assessing the patentability of the invention in respect of which an application was filed (section 43 (1)). Where the abstract (section 36) has not yet been published, it shall be included in the patent specification.

(4) The first publication of the application or the patent specification shall be published under the conditions set out in section 31 (2) even in cases where the application is withdrawn or refused or deemed to be withdrawn or the patent has lapsed after the technical preparations for publication had been completed.

(5) The Patent Gazette contains regularly published summaries of entries in the Register, provided that they do not only concern the regular expiry of patents or the registration and cancellation of exclusive licences, and information about the possibility of inspecting patent application files.

### **Section 33**

(1) As from the publication of a reference pursuant to section 32 (5) the applicant can claim compensation which is reasonable in the circumstances from any person who used the subject-matter of the application although he knew or should have known that the invention he used formed the subject-matter of the application; further claims shall be ruled out.

(2) The entitlement shall not exist in cases where the subject-matter of the application is obviously not patentable.

(3) The provisions of Book 1, Division 5 of the German Civil Code (Bürgerliches Gesetzbuch) shall apply mutatis mutandis to limitation, with the proviso that the limitation shall become effective at the earliest one year after the grant of the patent. Where the person obliged obtains something as a consequence of the infringement at the expense of the person entitled, section 852 of the German Civil Code shall apply mutatis mutandis.

### **Part III**

#### **Procedures before the German Patent and Trade Mark Office**

### **Section 34**

(1) Applications for the grant of a patent for an invention shall be filed with the German Patent and Trade Mark Office.

(2) The patent application can also be filed through a patent information centre where this agency has been designated to receive patent applications on the basis of a notice published by the Federal Ministry of Justice and Consumer Protection in the Federal Law Gazette. An application which may contain a state secret (section 93 of the Criminal Code (Strafgesetzbuch)) may not be filed with a patent information centre.

(3) The application shall contain:



1. the name of the applicant;
2. a request for the grant of a patent, which shall clearly and concisely designate the invention;
3. one or more patent claims, which shall indicate what is to be protected as patentable;
4. a description of the invention;
5. the drawings referred to in the patent claims or the description.

(4) The application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

(5) The application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

(6) The Federal Ministry of Justice and Consumer Protection shall be authorised to issue, by statutory instrument, provisions concerning the form and other requirements of the application. It may, by statutory instrument, delegate this authorisation to the German Patent and Trade Mark Office.

(7) At the request of the German Patent and Trade Mark Office the applicant shall specify the state of the art to the best of his knowledge, fully and truthfully, and shall include it in the description (subsection (3)).

(8) The Federal Ministry of Justice and Consumer Protection shall be authorised to issue, by statutory instrument, provisions concerning the deposit of biological material, access to biological material, including those persons who are entitled to access biological material, and the re-deposit of biological material where an invention involves the use of or concerns biological material which is not available to the public and cannot be described in the application in such a manner as to enable the invention to be carried out by a person skilled in the art (subsection (4)). The Federal Ministry of Justice and Consumer Protection may, by statutory instrument, delegate this authorisation to the German Patent and Trade Mark Office.

#### **Section 34a**

(1) Where an invention is based on biological material of plant or animal origin or if it uses such material, the application should include information on the geographical origin of such material, if known. This shall be without prejudice to the examination of applications or the validity of rights arising from granted patents.

(2) If the application includes information on the geographical origin pursuant to the first sentence of subsection (1), the German Patent and Trade Mark Office shall notify this application to the Federal Agency for Nature Conservation (Bundesamt für Naturschutz) as the competent authority within the meaning of section 6 (1) of the Act Implementing the Obligations Under the Nagoya Protocol and Transposing Regulation (EU) No 511/2014 of 25 November 2015 (Federal Law Gazette I p. 2092) following publication of the information pursuant to section 32 (5).

#### **Section 35**

(1) The date of filing of the patent application shall be the date on which the documents referred to in section 34 (3) no. 1 and 2 and, if they at any rate contain particulars which by all appearances are to be regarded as a description, were received, in accordance with section 34 (3) no. 4, by

1. the German Patent and Trade Mark Office, or
2. the patent information centre, if this agency has been determined by notice published by the Federal Ministry of Justice and Consumer Protection in the Federal Law Gazette.

(2) If the application contains a reference to drawings and no drawings have been enclosed with the application or if at least part of a drawing is missing, the German Patent and Trade Mark Office shall invite the applicant to either subsequently file the drawings within one month after service of the invitation or to declare that the reference shall be deemed not to have been made. If the applicant subsequently files the missing drawings or the missing parts following this invitation, the date on which the German Patent and Trade Mark Office receives the drawings or the missing parts shall be the date of filing; otherwise the reference to the drawings shall be deemed not to have been made.

(3) Subsection (2) shall apply mutatis mutandis to any missing parts of the description.

#### **Section 35a**

(1) If the application or part of the application is not in German, the applicant shall subsequently submit a German translation within a time limit of three months after filing the application. If the German translation is not submitted within the time limit, the application shall be deemed to be withdrawn.

(2) If the application or part of the application is in English or French, the time limit under subsection (1), first sentence, shall be extended to twelve months. If an earlier date is claimed for the application rather than the date of filing, the period under the first sentence shall, however, end at the latest after the expiry of a period of fifteen months from this date.

(3) If a request in accordance with section 43 (1) or section 44 (1) has been filed in respect of the application, the examining section may request that the applicant submit a German translation of the application documents before the expiry of the period referred to in subsection (2).

(4) If the applicant notifies the German Patent and Trade Mark Office before the expiry of the time limit referred to in subsections (1) and (2) that he consents to the inspection of his application pursuant to section 31 (2), first sentence, no. 1, he must submit a German translation of the application documents. Such consent shall not be regarded as given until the German Patent and Trade Mark Office is in receipt of the translation.

#### **Section 36**

(1) The application shall include an abstract, which may be filed subsequently until the expiry of a period of fifteen months from the date of filing or, in so far as an earlier date is claimed to govern the application, until the expiry of a period of fifteen months from that date.

(2) The abstract shall serve the purpose of technical information only. It shall contain:

1. the title of the invention;
2. a concise summary of the disclosure as contained in the application, which shall indicate the technical field to which the invention pertains and shall be drafted in a manner allowing a clear understanding of the technical problem, its solution and the principal use of the invention;
3. any drawing mentioned in the concise summary; where several drawings are mentioned, the drawing which, in the applicant's opinion, most clearly characterises the invention shall be enclosed.

#### **Section 37**

(1) Within fifteen months of the date of filing or, if an earlier date is claimed to govern the application, within fifteen months of that date, the applicant shall designate the inventor or inventors and shall affirm that, to his knowledge, no other persons participated in the invention. Where the applicant is not the inventor or not the sole inventor, he shall also indicate how he acquired the right to the patent. The accuracy of the statements made shall not be verified by the German Patent and Trade Mark Office.

(2) Where the applicant substantiates that he was prevented by exceptional circumstances from making the declarations required in accordance with subsection (1) in due time, the German Patent and Trade Mark Office shall grant him a reasonable extension of the time

limit. The time limit may not be extended beyond the delivery of the decision on the grant of the patent.

#### **Section 38**

Before the decision is taken on the grant of the patent, it shall be permissible to make amendments to particulars contained in the application as do not extend the subject-matter of the application, although until receipt of the request for examination (section 44) only in so far as obvious mistakes are being corrected, deficiencies noted by the examining section are being corrected or amendments are being made to the patent claim. Rights may not be derived from amendments which extend the subject-matter of the application.

#### **Section 39**

(1) The applicant may divide the application at any time. The division shall be declared in writing. If the division is declared after the request for examination has been filed (section 44), the separated part shall be deemed to be the application for which the request for examination has been made. The date of the original application and any priority claimed for it shall remain applicable for each divisional application.

(2) The same fees shall be payable for the separated application for the period up until the division is made as were payable for the original application. This shall not apply in respect of the fee paid in accordance with the Patent Costs Act for the search in accordance with section 43 if the division was declared before the request for examination was filed (section 44), unless a request in accordance with section 43 is also filed for the separated application.

(3) If the application documents required in accordance with sections 34, 35, 35a and 36 for the separated application are not submitted within three months of receipt of the declaration of division or if the fees for the separated application are not paid within this period, the declaration of division shall be deemed not to have been made.

#### **Section 40**

(1) Within a period of twelve months from the date of filing of an earlier patent or utility model application with the German Patent and Trade Mark Office the applicant shall enjoy the right of priority in respect of the application for a patent for the same invention, unless a domestic or foreign priority has already been claimed for the earlier application.

(2) The priority of several applications for patents or utility models filed with the German Patent and Trade Mark Office may be claimed for the patent application.

(3) Priority may only be claimed for such elements of the application which are specifically disclosed in the application documents of the earlier application as a whole.

(4) The priority may only be claimed within two months of the date of filing of the later application; the declaration of priority shall be deemed not to have been made until the file number of the earlier application has been indicated.

(5) If the earlier application is still pending with the German Patent and Trade Mark Office, it shall be deemed to be withdrawn when the declaration of priority is made in accordance with subsection (4). This shall not apply where the earlier application refers to a utility model.

(6) If a request is filed to inspect the file of a later application (section 31) which claims the priority of an earlier patent and utility model application, the German Patent and Trade Mark Office shall add a copy of the earlier patent or utility model application to the files of the later application.

#### **Section 41**

(1) Any person who, in accordance with an international treaty, claims the priority of an earlier foreign application in respect of the same invention shall indicate the date, country and file number of the earlier application before the expiry of a period of sixteen months from the date of priority and shall submit a copy of the earlier application, unless this has already been effected. The particulars may be changed within the time limit. If the particulars are not submitted in due time, the right of priority shall be forfeited for the application.

(2) If the earlier foreign application has been filed in a state with which no international treaty on the recognition of priority has been concluded, the applicant may claim a right of priority corresponding to the right of priority under the Paris Convention, in so far as, in accordance with a notice published by the Federal Ministry of Justice and Consumer Protection in the Federal Law Gazette, the other state grants a right of priority on the basis of the first application filed with the German Patent and Trade Mark Office which is comparable as regards the terms and conditions and content to the right of priority in accordance with the Paris Convention; subsection (1) shall apply.

#### **Section 42**

(1) If the application obviously does not meet the requirements set out in sections 34, 36, 37 and 38, the examining section shall invite the applicant to correct the deficiencies within a specific time limit. If the application does not meet the provisions in respect of the form and other requirements of the application (section 34 (6)), the examining section may refrain from objecting to these deficiencies until the commencement of the examination procedure (section 44).

(2) If the subject-matter of the application is obviously

1. not, by its nature, an invention,
2. not susceptible of industrial application, or
3. excluded from the grant of a patent in accordance with section 2,

the examining section shall communicate this to the applicant, citing the grounds, and shall invite him to comment within a specific time limit.

(3) The examining section shall refuse the application if the deficiencies noted in accordance with subsection (1) are not corrected or if the application is maintained although the invention is obviously not patentable (subsection (2) nos 1 to 3). If the refusal is to be based on circumstances which have not yet been communicated to the patent applicant, he shall first be given the opportunity to comment within a specific time limit.

#### **Section 43**

(1) The German Patent and Trade Mark Office shall, upon request, carry out a search regarding the state of the art which shall be given due consideration in respect of the assessment of the patentability of the invention filed and shall preliminarily assess the patentability of the invention filed in accordance with sections 1 to 5 and whether the application meets the requirements set out in section 34 (3) to (5) (search). Where the search regarding the state of the art has been fully delegated to an international entity or entirely or partially for certain technical subject areas (subsection (8) no. 1), a request may be filed for the searches to be carried out in such a manner that the applicant may also use the search result for a European application.

(2) The request may be filed only by the patent applicant. It shall be submitted in writing. Section 25 shall apply *mutatis mutandis*.

(3) Receipt of the request shall be published in the Patent Gazette, although not before the information pursuant to section 32 (5) has been published. Any person shall be entitled to provide the German Patent and Trade Mark Office with such information regarding the state of the art which could prejudice the grant of a patent.

(4) The request shall be deemed not to have been filed if a request in accordance with section 44 has already been filed. In such cases the German Patent and Trade Mark Office shall inform the patent applicant when it received the request in accordance with section 44. The fee paid in accordance with the Patent Costs Act for the search in accordance with section 43 shall be refunded.

(5) If a request in accordance with subsection (1) has been received, later requests shall be deemed not to have been filed. Subsection (4), second and third sentences, shall apply *mutatis mutandis*.

(6) If, following the filing of a search request, the German Patent and Trade Mark Office establishes that the application does not meet the requirements set out in section 34 (5), it shall conduct the search for that part of the application referring to the invention or group of inventions described first in the patent claims so linked as to form a single general inventive concept.

(7) The German Patent and Trade Mark Office shall communicate to the applicant the result of the search in accordance with subsection (1), taking account of subsection (6), without any guarantee of completeness (search report). It shall publish in the Patent Gazette that this communication has been made. No legal remedy shall be available against the search report. If a search regarding the state of the art has been carried out by an international entity and if the applicant has filed a request within the meaning of subsection (1), second sentence, this shall be indicated in the communication.

(8) In order to expedite the proceedings for the grant of a patent the Federal Ministry of Justice and Consumer Protection shall be authorised to determine, by statutory instrument, that

1. the search regarding the state of the art referred to in subsection (1) is to be delegated to a department in the German Patent and Trade Mark Office other than the examining section (section 27 (1)), to another state or international entity, either fully or for specific technical subject areas or for specific languages, provided that this facility appears suited to searching the state of the art which is to be taken into consideration;

2. the German Patent and Trade Mark Office provides foreign or international authorities with information from files referring to patent applications for the purpose of mutual information regarding the outcome of examination procedures and of searches regarding the state of the art if the information refers to inventions for which an application for the grant of a patent has also been filed with these foreign or international authorities;

3. the examination of the patent applications in accordance with section 42 and the monitoring of fees and time limits is delegated in full or in part to units in the German Patent and Trade Mark Office other than the examining sections or Patent Divisions (section 27 (1)).

#### **Section 44**

(1) The German Patent and Trade Mark Office shall, upon request, examine whether the application meets the requirements set out in sections 34, 37 and 38 and whether the subject-matter of the application is patentable in accordance with sections 1 to 5.

(2) The request may be filed by the applicant and any third party, who does not, however, participate in the examination procedure on that account, until the expiry of a period of seven years from the filing of the application. The time limit for payment of the examination fee in accordance with the Patent Costs Act is three months after its due date (section 3 (1) of the Patent Costs Act). This time limit shall expire at the latest after the expiry of a period of seven years following filing of the application.

(3) If a request in accordance with section 43 has already been filed, the examination procedure does not commence until the request in accordance with section 43 has been executed. Where a third party has filed a request in accordance with subsection (1), receipt of the request shall be communicated to the applicant. In other respects, section 43 (2), second and third sentences, and subsections (3) and (5) shall apply *mutatis mutandis*.

(4) If, following communication to the applicant (subsection (3), second sentence), the request filed by the third party is deemed to be ineffective, the German Patent and Trade Mark Office shall communicate this to both the third party and the applicant. In the event of the request filed by the third party being ineffective, the applicant may himself file a request before the expiry of a period of three months from the service of the communication, provided that this time limit expires later than the time limit referred to in subsection (2). If he

does not file the request, a notice shall be published in the Patent Gazette that this request is ineffective, making reference to the publication of the request filed by the third party.

(5) The examination procedure shall be continued even if the request for examination is withdrawn. In the case referred to in subsection (4), second sentence, the procedure shall be continued from that stage which it was at when the applicant filed the request for examination.

#### **Section 45**

(1) If the request does not meet the requirements set out in sections 34, 37 and 38 or if the requirements set out in section 36 are obviously not fulfilled, the examining section shall invite the applicant to correct the deficiencies within a specific time limit. The first sentence does not apply to deficiencies relating to the abstract if the abstract has already been published.

(2) If the examining section comes to the conclusion that the invention is not patentable in accordance with sections 1 to 5, it shall communicate this to the patent applicant, citing the reasons, and shall invite him to comment within a specific time limit.

#### **Section 46**

(1) The examining section may summon and hear the parties at any time, may examine witnesses, experts and parties under oath or not under oath, and may undertake further examination as necessary to examine the matter. The applicant shall be heard upon request before the decision is taken on the grant of the patent. The request shall be submitted in writing. If the request is not submitted in the requisite form, the examining section shall refuse the request. The decision to refuse the request shall not be independently contestable.

(2) Minutes shall be drawn up of the hearings and taking of evidence containing the essentials of the proceedings and the relevant statements made by the parties. Sections 160a, 162 and 163 of the Code of Civil Procedure shall apply *mutatis mutandis*. The parties shall receive a copy of the minutes.

#### **Section 47**

(1) The decisions of the examining section shall be reasoned and a copy shall be served on the parties *ex officio*; the copy need not be certified. Execution copies shall be made only upon application of one of the persons concerned and only in paper form. The decisions may also be delivered at the end of a hearing; the first and second sentences shall remain unaffected. The decision need not be reasoned if only the applicant is party to the proceedings and his request is granted.

(2) Upon service of the decision the parties shall also be instructed about the appeal which is available from the decision, about the authority with which the appeal shall be filed, the time limit for filing of an appeal and the fee payable. The time limit for filing the appeal (section 73 (2)) only begins to run if the parties have been instructed in accordance with the first sentence. If the instruction has not been given or was given incorrectly, filing the appeal shall only be admissible within one year following service of the decision, except in cases where instruction was given in writing that an appeal was not available; section 123 shall apply *mutatis mutandis*.

#### **Section 48**

The examining section shall refuse the application if the deficiencies noted in accordance with section 45 (1) are not corrected or if the examination reveals that the invention is not patentable in accordance with sections 1 to 5. Section 42 (3), second sentence, shall apply.

#### **Section 49**

(1) If the application meets the requirements set out in sections 34, 37 and 38, the deficiencies in the abstract noted in accordance with section 45 (1) have been corrected and the subject-matter of the application is patentable in accordance with sections 1 to 5, the examining section shall decide to grant the patent.



(2) Upon the request of the applicant, the decision to grant the patent shall be suspended until the expiry of a period of fifteen months, which begins to run on the date of filing of the application with the German Patent and Trade Mark Office or, if an earlier date is claimed to be relevant for the application, on that date.

#### **Section 49a**

(1) If the person registered as the proprietor of the patent applies for supplementary protection, the Patent Division shall examine whether the application complies with the relevant Regulation of the European Communities as well as with subsection (5) and section 16a.

(2) If the application meets these requirements, the Patent Division shall issue the supplementary protection certificate for the duration of its term. Otherwise, it shall invite the applicant to correct any deficiencies within a time limit of at least two months to be set by the Patent Division. If the deficiencies are not corrected, the Patent Division shall take a decision to refuse the application.

(3) If a Regulation of the European Communities provides for the extension of the term of a supplementary protection certificate, subsections (1) and (2) shall apply mutatis mutandis.

(4) The Patent Division shall take a decision on the requests provided for in Regulations of the European Communities to

1. correct the term of a supplementary protection certificate if the date included in the application for the certificate in respect of the first authorisation for placing the invention on the market is incorrect;

2. revoke the extension of the term of a supplementary protection certificate.

(5) Section 34 (6) shall apply. Sections 46 and 47 shall apply to the procedure before the Patent Division.

#### **Section 50**

(1) Where a patent is sought for an invention which constitutes a state secret (section 93 of the Criminal Code), the examining section shall, ex officio, order that no publication at all be made. The competent highest federal authority shall be consulted before the order is issued. It may apply for the issue of an order.

(2) The examining section shall, ex officio or upon the request of the competent highest federal authority, the applicant or proprietor of the patent, cancel an order issued in accordance with subsection (1) if its preconditions have ceased to exist. The examining section shall examine at yearly intervals whether the preconditions for the issuing of the order in accordance with subsection (1) still exist. The competent highest federal authority shall be consulted before the order issued in accordance with subsection (1) is cancelled.

(3) The examining section shall communicate to the parties if no appeal is lodged within the time limit for the filing of an appeal (section 73 (2)) from a decision of the examining section refusing a request for the issue of an order in accordance with subsection (1) or cancelling an order in accordance with subsection (1).

(4) Subsections (1) to (3) shall apply mutatis mutandis to an invention which is kept secret by a foreign state for defence reasons and entrusted to the Federal Government, with its consent, on condition that it be kept secret.

#### **Section 51**

The German Patent and Trade Mark Office shall grant inspection of the files to the competent highest federal authority for the examination of the question of whether no publication at all shall be made in accordance with section 50 (1) or whether an order issued in accordance with section 50 (1) shall be cancelled.

#### **Section 52**

(1) A patent application containing a state secret (section 93 of the Criminal Code) may be filed outside of the territorial scope of this Act only with the written authorisation of the competent highest federal authority. The authorisation may be given subject to conditions.  
(2) Any person who

1. contrary to subsection (1), first sentence, files a patent application, or
2. contravenes a condition imposed in accordance with subsection (1), second sentence,

shall be punished with imprisonment for no more than five years or a fine.

#### **Section 53**

(1) If no order in accordance with section 50 (1) is served on the applicant within four months of the invention being filed with the German Patent and Trade Mark Office, the applicant and any other person who has learned of the invention, in so far as they doubt whether secrecy regarding the invention is necessary (section 93 of the Criminal Code), may assume that the invention need not be kept secret.

(2) If the examination of the question whether no publication at all shall be made pursuant to section 50 (1) cannot be concluded within the time limit referred to in subsection (1), the German Patent and Trade Mark Office may extend this time limit, by no more than two months, by communication which shall be served on the applicant within the time limit referred to in subsection (1).

#### **Section 54**

If a patent has been granted on an application for which an order was issued in accordance with section 50 (1), the patent shall be entered in a separate Register. Section 31 (5), first sentence, shall apply mutatis mutandis to the inspection of the separate Register.

#### **Section 55**

(1) An applicant, a proprietor of a patent or his successor in title who refrains from using an invention which is patentable in accordance with sections 1 to 5 for peaceful purposes with regard to an order issued in accordance with section 50 (1) shall be entitled to compensation from the Federal Republic of Germany for pecuniary loss arising therefrom if and in so far as he cannot be reasonably expected to carry the cost of the damage himself. When assessing the reasonableness, account shall in particular be taken of the economic situation of the party suffering damage, the amount of the expenses made for the invention or for acquiring the rights in the invention, the level of probability of the need to keep the invention secret which he could recognise when the expenses arose, as well as the benefit ensuing for the party suffering damage from other use of the invention. The claim cannot be asserted until the patent has been granted. The compensation can only be claimed in retrospect and for periods no shorter than one year.

(2) The claim shall be asserted before the competent highest federal authority. An appeal may be lodged with the ordinary courts.

(3) Compensation pursuant to subsection (1) shall be granted only if the first application in respect of the invention has been filed with the German Patent and Trade Mark Office and the invention has not already been kept secret by a foreign state for defence reasons before an order was issued in accordance with section 50 (1).

#### **Section 56**

The Federal Government shall be authorised to determine, by statutory instrument, the competent highest federal authority within the meaning of section 31 (5), sections 50 to 55 and section 74 (2).

#### **Section 57 (repealed)**

#### **Section 58**

(1) The grant of the patent shall be published in the Patent Gazette. The patent specification shall be published at the same time. The legal effects of the patent shall ensue upon publication in the Patent Gazette.

(2) If the application is withdrawn or refused after publication of the information about the possibility of inspecting the files (section 32 (5)) or if it is deemed to be withdrawn, the effect in accordance with section 33 (1) shall be deemed not to have ensued.

(3) If a request for examination is not filed before the expiry of the time limit specified in section 44 (2) or if an annual renewal fee payable in respect of the application is not paid in due time (section 7 (1) of the Patent Costs Act), the application shall be deemed to be withdrawn.

### **Section 59**

(1) Within nine months of publication of the grant of the patent any person may give notice of opposition to the patent, in the case of usurpation only the aggrieved party. Notice of opposition shall be given in a written reasoned statement. It may only be based on the claim that one of the grounds for revocation set out in section 21 exists. The facts justifying the opposition shall be detailed. The particulars shall, in so far as they have not already been included in the notice of opposition, be submitted in writing within the opposition period.

(2) Where a notice of opposition has been given to a patent, any third party who can prove that an action has been brought against him on account of an infringement of the patent may intervene in the opposition proceedings as an opponent after the expiry of the opposition period if he gives notice of intervention within three months of the date on which the action claiming the infringement was filed. The same shall apply to any third party who can prove that, following a demand by the proprietor of the patent that the third party refrain from the alleged infringement of the patent, he instituted proceedings for a ruling that he is not infringing the patent. The notice of intervention shall be declared in writing and reasoned within the time limit referred to in the first sentence. Subsection (1), third to fifth sentences, shall apply *mutatis mutandis*.

(3) A hearing shall be held in the opposition proceedings upon request of a party or if the Patent Division deems this to be expedient. When issuing the summons, the Patent Division shall draw attention to the points which in its opinion need to be discussed for the purposes of the decision to be taken. The hearing, including delivery of the decision, shall be public. Section 169, second sentence, as well as sections 171b to 175 of the Courts Constitution Act (Gerichtsverfassungsgesetz) shall apply *mutatis mutandis*, with the proviso that the public may also be excluded from the hearing at the request of one of the parties if there is concern that the interests of the applicant meriting protection are at risk.

(4) The chair of the Patent Division shall ensure that order is maintained during the hearing and shall thus exercise his domestic authority.

(5) In other respects, section 43 (3), second sentence, and sections 46 and 47 shall apply *mutatis mutandis* in the opposition proceedings.

### **Section 60 (repealed)**

### **Section 61**

(1) The Patent Division shall take a decision as to whether and to what extent the patent is to be maintained or revoked. The proceedings shall continue *ex officio* without the opponent if the opposition is withdrawn.

(2) In derogation of subsection (1), the Board of Appeal at the Federal Patent Court shall issue a decision

1. if a party so requests and no other party opposes this within two months of service of the request, or

2. at the request of only one party, if at least fifteen months have elapsed since the expiry of the opposition period, in the event of the request being made by a person who has intervened in the proceedings since his giving notice of intervention.

This shall not apply if the Patent Division served summons to a hearing or served the decision on the opposition within three months of receipt of the request for a decision by the Federal Patent Court. In other respects, sections 59 to 62, sections 69 to 71 and sections 86 to 99 shall apply mutatis mutandis.

(3) If the patent is revoked or maintained only with limitations, this fact shall be published in the Patent Gazette.

(4) If the patent is maintained with limitations, the patent specification shall be amended accordingly. The amendment to the specification of the patent shall be published.

### **Section 62**

(1) The Patent Division may, at its reasonable discretion, determine in the decision issued in accordance with section 61 (1) to what extent the costs arising from a hearing or the taking of evidence are to be imposed on a party. The determination may also be made if the opposition is withdrawn in full or in part or if the patent is surrendered. The Patent Division may order that the opposition fee to be paid in accordance with the Patent Costs Act shall be reimbursed in full or in part if this is equitable.

(2) The costs include the expenses incurred by the German Patent and Trade Mark Office and the costs arising for the parties, in so far as they were necessary to ensure appropriate safeguarding of the claims and rights. The amount of the costs to be reimbursed shall be determined upon request by the German Patent and Trade Mark Office. The provisions of the Code of Civil Procedure concerning the procedure for the assessment of costs (sections 103 to 107) and compulsory enforcement based on orders assessing the costs (sections 724 to 802) shall apply mutatis mutandis. The appeal from the order assessing the costs shall be available instead of the legal remedy provided for by the Code of Civil Procedure (Erinnerung); section 73 shall apply, with the proviso that the appeal shall be lodged within two weeks. The enforceable execution copy shall be issued by the registry clerk at the registry of the Federal Patent Court.

### **Section 63**

(1) The first publication of the application (section 32 (2)), the patent specification (section 32 (3)) and the publication of the grant of the patent (section 58 (1)) shall mention the inventor, provided that he has already been designated. The mention shall be noted in the Register (section 30 (1)). This shall not be done if the inventor designated by the applicant so requests. The request may be withdrawn at any time; in the event of withdrawal, the inventor shall be subsequently mentioned. The inventor's waiver of being mentioned shall be without legal effect.

(2) If the person of the inventor has been designated wrongfully or, in the case set out in subsection (1), third sentence, has not been designated at all, the patent applicant or the proprietor of the patent as well as the person who has been wrongfully designated shall be obliged vis-à-vis the inventor to declare to the German Patent and Trade Mark Office that they consent to the mention in accordance with subsection (1), first and second sentences, being corrected or subsequently made. This consent cannot be withdrawn. The proceedings for the grant of a patent shall not be delayed on account of the filing of an action for declaration of consent.

(3) The inventor shall not be subsequently mentioned (subsection (1), fourth sentence, subsection (2)) or the correction shall not be made (subsection (2)) in official documents which have already been published.

(4) The Federal Ministry of Justice and Consumer Protection shall be authorised, by statutory instrument, to issue provisions to implement the aforementioned provisions. It may delegate this authorisation by statutory instrument to the German Patent and Trade Mark Office.

#### **Section 64**

- (1) At the request of the proprietor of the patent, the patent may be revoked or limited with retroactive effect by amending the patent claims.
- (2) The request shall be filed in writing and reasoned.
- (3) The Patent Division shall take a decision on the request. Section 44 (1) and sections 45 to 48 shall apply mutatis mutandis. If the patent is revoked, this shall be published in the Patent Gazette. If the patent is limited, the specification of the patent shall be adapted in respect of the limitation in the decision to grant the request; the amendment to the specification of the patent shall be published.

### **Part IV The Federal Patent Court**

#### **Section 65**

- (1) The Federal Patent Court shall be established as a separate and independent federal court to take decisions on appeals from the decisions of the examining sections or Patent Divisions at the German Patent and Trade Mark Office, as well as on actions for the revocation of patents and in compulsory licence proceedings (sections 81, 85 and 85a). Its seat shall be at the seat of the German Patent and Trade Mark Office. It shall be designated in German "Bundespatentgericht" (Federal Patent Court).
- (2) The Federal Patent Court shall be composed of a President, the presiding judges and further judges. They must be qualified under the terms of the German Judiciary Act to hold judicial office (legally qualified members) or have expertise in a field of technology (technically qualified members). Section 26 (3) shall apply mutatis mutandis to the technically qualified members, with the proviso that they must have passed a state or academic final examination.
- (3) The judges shall be appointed for life by the Federal President unless otherwise provided in section 71.
- (4) The President of the Federal Patent Court exercises disciplinary supervision over the judges, civil servants, employees and workers.

#### **Section 66**

- (1) The following shall be set up at the Federal Patent Court:
  1. boards responsible for taking decisions on appeals (Boards of Appeal);
  2. boards responsible for taking decisions on actions on revocation of patents and in compulsory licence proceedings (Nullity Boards).
- (2) The Federal Minister of Justice and Consumer Protection shall determine the number of boards.

#### **Section 67**

- (1) When taking their decisions the Boards of Appeal shall sit in a composition of
  1. one legally qualified member acting as presiding judge and two technically qualified members in the cases referred to in section 23 (4) and in section 50 (1) and (2);
  2. one technically qualified member acting as presiding judge, two further technically qualified members and a legally qualified member in those cases
    - a) in which the application was refused,
    - b) in which the opposition was dismissed as inadmissible,
    - c) referred to in section 61 (1), first sentence, and in section 64 (1),
    - d) referred to in section 61 (2), and
    - e) referred to in sections 130, 131 and 133;

3. one legally qualified member acting as presiding judge, one further legally qualified member and one technically qualified member in the cases referred to in section 31 (5);

4. three legally qualified members in all other cases.

(2) The Nullity Board takes decisions in the cases referred to in sections 84 and 85 (3) sitting in a composition of one legally qualified member acting as presiding judge, one further legally qualified member and three technically qualified members, in all other cases sitting in a composition of three judges, one of whom shall be a legally qualified member.

#### **Section 68**

The provisions set out in the Second Title of the Courts Constitution Act shall apply mutatis mutandis to the Federal Patent Court on the following terms:

1. In those cases in which on account of the outcome of a vote a legally qualified judge would not be a member of the Presidium, the legally qualified judge obtaining the most votes of the legally qualified members shall be deemed to be elected.

2. A Board of Appeal at the Federal Patent Court sitting in a composition of three legally qualified judges shall decide on a challenge to a vote (section 21b (6) of the Courts Constitution Act).

3. The Federal Minister of Justice and Consumer Protection shall appoint the President's permanent deputy.

#### **Section 69**

(1) Proceedings before the Boards of Appeal shall be public provided that information about the possibility of inspecting the files in accordance with section 32 (5) or the specification of the patent in accordance with section 58 (1) has been published. Sections 171b to 175 of the Courts Constitution Act shall apply mutatis mutandis, with the proviso that

1. the public may also be excluded from the proceedings at the request of one of the parties if there are concerns of a threat to the interests of the applicant meriting protection,

2. the public is excluded when the decisions are delivered until the publication of the information about the possibility of inspecting the files in accordance with section 32 (5) or until the publication of the patent specification in accordance with section 58 (1).

(2) Proceedings before the Nullity Boards, including delivery of decisions, shall be public. Subsection (1), second sentence, no. 1 shall apply mutatis mutandis.

(3) The presiding judge shall be responsible for maintaining order when the Boards of Appeal are sitting. Sections 177 to 180, 182 and 183 of the Courts Constitution Act concerning the maintenance of order when the court is sitting shall apply mutatis mutandis.

#### **Section 70**

(1) The Boards of Appeal shall take their decisions on the basis of their deliberations and a vote. Only that number of members of the Board of Appeal determined by law may participate therein. In addition to the members of the Boards of Appeal appointed to take the decision only those persons occupied at the Federal Patent Court for the purposes of their training may attend the deliberations and the vote, provided that the presiding judge permits them to be present.

(2) The Boards of Appeal shall take their decisions by a majority vote; in the case of a tied vote the vote of the presiding judge shall prevail.

(3) The members of the Boards of Appeal shall cast their votes according to seniority of service, in the event of equal seniority according to their age; the younger member shall vote before the older member. If a reporting judge has been appointed, he shall cast his vote first. The presiding judge shall be the last to cast his vote.



#### **Section 71**

- (1) Judges by commission may be used at the Federal Patent Court. Section 65 (2), third sentence, shall apply.
- (2) Judges by commission and judges on secondment cannot preside over the court.

#### **Section 72**

A registry shall be established at the Federal Patent Court which will comprise the requisite number of registry clerks. The Federal Ministry of Justice and Consumer Protection shall order the establishment of the court registry.

### **Part V**

## **Proceedings before the Federal Patent Court**

### **1. Appeal proceedings**

#### **Section 73**

- (1) An appeal may be filed from the decisions of the examining sections and Patent Divisions.
- (2) The appeal shall be filed in writing with the German Patent and Trade Mark Office within one month of service of the decision. Copies for the other parties shall be enclosed with the appeal and all written pleadings. The appeal and all written pleadings containing substantive motions or the declaration of withdrawal of the appeal or of a motion shall be served on the other parties ex officio; other written pleadings shall be informally communicated to them unless service is ordered.
- (3) If the unit whose decision is contested regards the appeal as well-founded, it shall rectify its decision. It may order that the appeal fee in accordance with the Patent Costs Act be reimbursed. If the appeal is not allowed, it shall be remitted to the Federal Patent Court within one month and without comment as to its merit.
- (4) If the appellant is opposed by another party to the proceedings, the provision set out in subsection (3), first sentence, shall not apply.

#### **Section 74**

- (1) The parties to the proceedings before the German Patent and Trade Mark Office shall be entitled to appeal.
- (2) In the cases referred to in section 31 (5) and in section 50 (1) and (2), the competent highest federal authority shall also be entitled to appeal.

#### **Section 75**

- (1) The appeal shall have suspensive effect.
- (2) However, the appeal shall not have suspensive effect if it is filed against a decision by the examining section on the basis of which an order in accordance with section 50 (1) was issued.

#### **Section 76**

The President of the German Patent and Trade Mark Office may, if he considers it appropriate to safeguard the public interest, make written declarations to the Federal Patent Court in the appeal proceedings, participate in the hearings and make statements in the course of the proceedings. Written declarations on the part of the President of the German Patent and Trade Mark Office shall be communicated to the parties by the Federal Patent Court.

#### **Section 77**

The Federal Patent Court may provide the President of the German Patent and Trade Mark Office with the option to intervene in the appeal proceedings if it considers this to be suitable because of a legal issue which is of fundamental importance. Upon receipt of the declaration of intervention, the President of the German Patent and Trade Mark Office shall become a party.

### **Section 78**

Oral proceedings shall take place if

1. one of the parties makes a request for them,
2. the Federal Patent Court takes evidence (section 88 (1)), or
3. the Federal Patent Court considers them to be expedient.

### **Section 79**

(1) A decision on the appeal shall be taken by order.

(2) If the appeal is not an available remedy or has not been filed in the statutory form and within the statutory time limit, it shall be rejected as inadmissible. The order may be given without oral proceedings.

(3) The Federal Patent Court may set aside the contested decision without deciding on the merits if

1. the Patent Office has not yet decided on the merits,
2. the proceedings before the German Patent and Trade Mark Office suffer from a substantial defect,
3. new facts or evidence become known which are essential for the decision.

The German Patent and Trade Mark Office shall also base its decision on the legal assessment on which the setting aside was based.

### **Section 80**

(1) If several persons are involved in the proceedings, the Federal Patent Court may determine that the costs of the proceedings be imposed on one of the parties in full or in part if this is equitable. In particular, it may also determine that costs incurred by the parties, in so far as they were necessary to appropriately safeguard the claims and rights, be reimbursed by one of the parties in full or in part.

(2) Costs may be imposed on the President of the German Patent and Trade Mark Office only if he has made requests after intervening in the proceedings.

(3) The Federal Patent Court may order the reimbursement of the appeal fee in accordance with the Patent Costs Act.

(4) Subsections (1) to (3) shall also apply if the appeal, the application or the opposition is withdrawn in full or in part or the patent is surrendered.

(5) In other respects, the provisions of the Code of Civil Procedure concerning the procedure for the assessment of costs (sections 103 to 107) and compulsory enforcement based on orders assessing the costs (sections 724 to 802) shall apply mutatis mutandis.

## **2. Revocation and compulsory licence proceedings**

### **Section 81**

(1) Proceedings for revocation of the patent or invalidity of the supplementary protection certificate, or on account of the grant or withdrawal of the compulsory licence, or on account of the adjustment of the remuneration for a compulsory licence determined by court judgment shall be initiated by filing an action. The action shall be directed against the proprietor of the patent entered in the Register or against the holder of the compulsory licence. An action against the supplementary protection certificate may be consolidated with an action against the patent on which it is based and may also be based on the fact that there is a ground for revocation (section 22) of the patent on which it is based.

(2) An action for revocation of a patent cannot be filed as long as a notice of opposition can still be filed or opposition proceedings are still pending. An action for the declaration of invalidity of the supplementary protection certificate cannot be filed in so far as requests in

accordance with section 49a (4) can be filed or proceedings for a decision on these requests are pending.

(3) In the case of usurpation, only the aggrieved party shall be entitled to file an action.

(4) The action shall be filed in writing with the Federal Patent Court. Copies for the opposing party shall be enclosed with the action and all written pleadings. The notice of action and all written pleadings shall be served on the opposing party ex officio.

(5) When filing the action, the claimant, the defendant and the matter under dispute shall be designated and a specific motion should be included. The facts and evidence in support of the grounds shall be indicated. If the action does not fully meet these requirements, the presiding judge shall invite the claimant to make the necessary additions within a specific time limit.

(6) Claimants whose habitual residence is not in a Member State of the European Union or a Contracting Party to the Agreement on the European Economic Area shall, at the request of the defendant, provide security in respect of the costs of the proceedings; section 110 (2) nos 1 to 3 of the Code of Civil Procedure shall apply mutatis mutandis. The Federal Patent Court shall determine the amount of the security at its reasonable discretion and shall determine a time limit within which it is to be paid. If the time limit is not observed, the action shall be deemed to be withdrawn.

### **Section 82**

(1) The Federal Patent Court shall serve the action on the defendant and invite him to comment on it within one month.

(2) If the defendant does not submit comments in due time, a decision on the action may be taken immediately without oral proceedings and each fact claimed by the claimant assumed to be proven.

(3) If the defendant objects in due time, the Federal Patent Court shall communicate the objection to the claimant and shall schedule a date for oral proceedings. Oral proceedings may be dispensed with upon agreement of the parties. Subsection (2) shall remain unaffected.

### **Section 83**

(1) In the proceedings for revocation of the patent or of invalidity of the supplementary protection certificate the Federal Patent Court shall indicate to the parties as early as possible those aspects which will presumably be of particular significance in respect of the decisions or which are helpful for concentrating the oral proceedings upon the issues which are essential for the decision. No such indication need be made if the aspects to be discussed appear self-evident on the basis of the parties' pleadings. Section 139 of the Code of Civil Procedure shall in addition apply.

(2) The Federal Patent Court may set a time limit within which the parties may submit final comments on the indication in accordance with subsection (1) by making relevant requests or additions to their pleadings and also in other respects. The time limit may be extended if the party affected submits important grounds for this. These shall be substantiated.

(3) The competences under subsections (1) and (2) may also be exercised by the presiding judge or by a member of the Board of Appeal to be determined by him.

(4) The Federal Patent Court may reject means of challenge or defence introduced by a party or a change to the action or a defence brought forward by the defendant by means of an amended version of the patent which are brought forward only after the expiry of a time limit set for this under subsection (2) and may decide without further examination if

1. giving consideration to the new submission would require the postponement of the scheduled oral proceedings, and
2. the party affected does not sufficiently excuse the delay, and
3. the party affected has been instructed about the consequences of failing to observe a time limit.

The ground of excuse shall be substantiated.

#### **Section 84**

- (1) A decision on the action shall be taken by judgment. An interlocutory judgment may be issued on the admissibility of the action.
- (2) The judgment shall include a decision on the costs of the proceedings. The provisions set out in the Code of Civil Procedure in respect of legal costs shall apply *mutatis mutandis* unless equity requires that another decision be taken; the provisions set out in the Code of Civil Procedure concerning the procedure for the assessment of costs and the compulsory enforcement based on orders assessing the costs shall apply *mutatis mutandis*. Section 99 (2) shall remain unaffected.

#### **Section 85**

- (1) In proceedings for the grant of a compulsory licence the claimant may, at his request, be permitted to use the invention on the basis of an injunction if he substantiates that the requirements under section 24 (1) to (6) are fulfilled and that there is an urgent need, in the public interest, for the immediate grant of the permission.
- (2) The issue of the injunction may be made dependent on the fact that the person making the request provides a security due to the imminent threat of disadvantages arising for the party opposing the request.
- (3) The Federal Patent Court shall take its decision on the basis of oral proceedings. The provisions set out in section 82 (3), second sentence, and in section 84 shall apply *mutatis mutandis*.
- (4) Upon the withdrawal or rejection of the action for the issue of a compulsory licence (sections 81 and 85a), the effect of the injunction shall cease; a decision on costs may be amended if a party applies for the amendment within one month of the withdrawal or after the rejection has become effective.
- (5) If the ordering of the injunction proves unjustified from the outset, the person making the request shall be obliged to compensate the party opposing the request for any damage which he suffered from the implementation of the injunction.
- (6) The judgment awarding the compulsory licence may be declared provisionally enforceable upon request against or without provision of a security if this is in the public interest. If the judgment is set aside or amended, the person making the request shall be obliged to compensate the damage which the party opposing the request suffered from the enforcement.

#### **Section 85a**

- (1) The procedure in accordance with Article 5 point (c), Article 6, Article 10 (8) and Article 16 (1) and (4) of Regulation (EC) No 816/2006 of the European Parliament and of the Council of 17 May 2006 on compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with public health problems (OJ L 157 p. 1) shall be initiated by an action in accordance with section 81 (1), first sentence.
- (2) Sections 81 to 85 shall apply *mutatis mutandis* in so far as the proceedings are not determined by Regulation (EC) No 816/2006.

### **3. Common procedural provisions**

#### **Section 86**

- (1) Sections 41 to 44 and sections 47 to 49 of the Code of Civil Procedure shall apply *mutatis mutandis* to the exclusion of and objection to court personnel.
- (2) The following shall also be excluded from exercising the office of judge:
1. in appeal proceedings, any person who was involved in the preceding proceedings before the German Patent and Trade Mark Office;

2. in proceedings for revocation of the patent, any person who was involved in the proceedings before the German Patent and Trade Mark Office or Federal Patent Court on the grant of the patent or the opposition.

(3) That board of whom the judge objected to is a member shall decide on the objection to that judge. If the number of board members ceases to constitute a quorum on account of the withdrawal of the member objected to, a Board of Appeal at the Federal Patent Court sitting in a composition of three legally qualified members shall take the decision.

(4) That board in whose sphere of business the matter falls shall decide on the objection to a registry clerk.

#### **Section 87**

(1) The Federal Patent Court shall examine the facts ex officio. It shall not be bound by the pleadings and the motions to take evidence filed by the parties.

(2) Before the oral proceedings or, if no oral proceedings are held, before the Federal Patent Court takes its decision, the presiding judge or a member to be determined by him shall issue all orders which are necessary to dispose of the matter in oral proceedings or in one session if at all possible. In other respects, section 273 (2), (3), first sentence, and (4), first sentence, of the Code of Civil Procedure shall apply mutatis mutandis.

#### **Section 88**

(1) The Federal Patent Court shall take evidence in the oral proceedings. In particular, it may carry out an inspection, hear witnesses, experts and parties, and consult documents.

(2) In appropriate cases, the Federal Patent Court may even before the oral proceedings have one of its members as a judge by commission take evidence or may request another court to take evidence by designation of the individual question regarding which evidence is to be taken.

(3) The parties shall be informed of all dates scheduled for the taking of evidence and may attend the taking of evidence. They may address relevant questions to witnesses and experts. Where a question is challenged, the Federal Patent Court shall decide.

#### **Section 89**

(1) As soon as the date for oral proceedings has been scheduled, the parties shall be summoned with at least two weeks' notice. In urgent cases the presiding judge may shorten this period.

(2) The notice of summons shall indicate that if a party fails to appear, the proceedings may be held and a decision taken in his absence.

#### **Section 90**

(1) The presiding judge shall open and conduct the oral proceedings.

(2) After the case has been called up, the presiding judge or the reporting judge shall present the essential content of the files.

(3) Then the parties shall be allowed to speak in order to bring and reason their motions.

#### **Section 91**

(1) The presiding judge shall discuss the facts and legal aspects of the case with the parties.

(2) The presiding judge shall permit each member of the board to ask questions. Where a question is challenged, the board shall decide.

(3) After discussing the case, the presiding judge shall declare the oral proceedings closed. The board may decide to reopen the oral proceedings.

#### **Section 92**

(1) A registry clerk of the registry shall act as recording clerk at the oral proceedings and the taking of the evidence. If, on the order of the presiding judge, no recording clerk is required, a judge shall draw up the minutes.

(2) Minutes of the oral proceedings and any taking of evidence shall be drawn up. Sections 160 to 165 of the Code of Civil Procedure shall apply mutatis mutandis.

### **Section 93**

- (1) The Federal Patent Court shall decide according to its independent conviction gained as an overall result of the proceedings. The decision shall state the grounds by which the judges were guided in coming to their conviction.
- (2) The decision may be based only on facts and results of evidence on which the parties were able to comment.
- (3) If prior oral proceedings took place, a judge who was not present at the last session of the oral proceedings may participate in the taking of the decision only with the consent of the parties.

### **Section 94**

- (1) Where oral proceedings were conducted, the final decisions of the Federal Patent Court shall be delivered at the session at which the oral proceedings were closed or at a session to be scheduled immediately. This session shall be scheduled not more than three weeks later unless important grounds so require, in particular the extent or the complexity of the case. The final decisions shall be notified to the parties ex officio. Notification of the final decision shall be permissible instead of delivery. If the Federal Patent Court takes its decision without oral proceedings, delivery shall be replaced by notification to the parties.
- (2) The decisions of the Federal Patent Court by means of which a motion is refused or a decision is taken on a legal remedy shall be reasoned.

### **Section 95**

- (1) Errors of transcription, miscalculations and similar obvious mistakes in the decision shall be corrected by the Federal Patent Court at any time.
- (2) A decision on the correction may be taken without prior oral proceedings. The order for correction shall be noted in the decision and execution copies.

### **Section 96**

- (1) If the elements of the decision contain other mistakes or ambiguities, the correction may be requested within two weeks of service of the decision.
- (2) The Federal Patent Court shall issue a decision by order without taking evidence. Only that judge shall be involved who participated in the decision whose correction has been requested. The order for correction shall be noted in the decision and execution copies.

### **Section 97**

- (1) The parties may pursue proceedings before the Federal Patent Court themselves. Section 25 shall remain unaffected.
- (2) The parties may be represented by a lawyer or patent attorney as agent. In addition, only the following may be entitled to represent the parties as agents before the Federal Patent Court:
  1. employees of the party or of an associated company (section 15 of the Share Capital Companies and Partnerships Act (Aktiengesetz)); authorities and legal persons under public law, including associations formed by them for the fulfilment of their public duties, may also be represented by employees of other authorities or legal persons under public law, including associations formed for the fulfilment of their public duties;
  2. family members of full age (section 15 of the Fiscal Code (Abgabenordnung), section 11 of the Act on Registered Life Partnerships (Lebenspartnerschaftsgesetz)), persons qualified to hold judicial office and joined parties if the representation is not linked to a paid activity.

Agents who are not natural persons shall act through their organs and persons appointed to represent them in proceedings.

- (3) The court shall, by final order, refuse those agents who are not entitled to represent in accordance with subsection (2). Procedural acts by an agent who is not entitled to represent and notifications or communications to this agent shall be effective until the agent is refused.



The court may, by final order, refuse the agents designated in subsection (2), second sentence, from further representation if they are unable to properly present the facts and the dispute.

(4) Judges may not act as agents before the court of which they are a member.

(5) The authorisation shall be filed with the court in writing. It may be subsequently filed; the Federal Patent Court may determine a time limit for this purpose.

(6) Deficiencies of the authorisation may be asserted at any stage of the proceedings. The Federal Patent Court shall give due consideration to the deficiencies of the authorisation ex officio unless a lawyer or a patent attorney is acting as agent.

#### **Section 98 (repealed)**

#### **Section 99**

(1) Where this Act does not contain any provisions in respect of the proceedings before the Federal Patent Court, the Courts Constitution Act and the Code of Civil Procedure shall apply mutatis mutandis unless it is not precluded by the special characteristics of the proceedings before the Federal Patent Court.

(2) The decisions of the Federal Patent Court shall be contestable only in so far as this is permitted under this Act.

(3) Section 31 shall apply mutatis mutandis in respect of the grant of inspection of the files to third persons. The Federal Patent Court shall decide on the request. Inspection of the files in proceedings for the revocation of the patent shall not be granted if and in so far as the proprietor of the patent demonstrates an interest meriting protection which precludes this.

(4) Section 227 (3), first sentence, of the Code of Civil Procedure shall not apply.

### **Part VI**

#### **Proceedings before the Federal Court of Justice**

##### **1. Proceedings on appeals on points of law**

#### **Section 100**

(1) An appeal on points of law may be filed with the Federal Court of Justice from the orders of the Boards of Appeal at the Federal Patent Court ruling on an appeal under section 73 or on the maintenance or revocation of a patent under section 61 (2) if the Board of Appeal allowed the appeal on points of law in its order.

(2) An appeal on points of law shall be allowed if

1. a decision needs to be taken on a legal matter of fundamental importance, or
2. the development of the law or ensuring the consistency of court rulings requires a decision by the Federal Court of Justice.

(3) It shall not be required to allow an appeal on points of law from the orders of the Boards of Appeal at the Federal Patent Court in the event of one of the following defects in the proceedings which is being noted:

1. if the court issuing the order did not sit in the composition required by law;
2. if a judge was involved in taking the decision who was excluded from exercising judicial office by operation of law or was successfully objected to if suspected of partiality;
3. if one of the parties was denied the right to be heard;
4. if one of the parties was not represented in the proceedings in accordance with the provisions set out in this Act, unless he explicitly or tacitly consented to the conduct of the proceedings;

5. if the order was issued on the basis of oral proceedings in which the provisions on the admission of the public to the proceedings were violated; or
6. if the decision was not reasoned.

#### **Section 101**

- (1) The appeal on points of law shall be open to the parties to the appeal proceedings.
- (2) The appeals on points of law may only rely on the fact that the order is based on a violation of the law. Sections 546 and 547 of the Code of Civil Procedure shall apply mutatis mutandis.

#### **Section 102**

- (1) The appeal on points of law shall be filed in writing with the Federal Court of Justice within one month of service of the order.
- (2) The provisions set out in section 144 on the fixing of the value in dispute shall apply mutatis mutandis in the proceedings on the appeal on points of law before the Federal Court of Justice.
- (3) The appeal on points of law shall be reasoned. The time limit for submission of the grounds is one month; this period shall begin to run upon the filing of the appeal on points of law and may be extended by the presiding judge upon request.
- (4) The grounds for the appeal on points of law shall contain the following:
  1. the declaration as to the extent to which the decision is being contested and its amendment or setting aside is being requested;
  2. the indication of the violated legal provision;
  3. where the appeal on points of law is based on the fact that the law has been violated in respect of the proceedings, the description of the facts which result in the defect.
- (5) The parties shall be represented before the Federal Court of Justice by a lawyer as agent who has been admitted to practise before the Federal Court of Justice. At the request of one of the parties his patent attorney shall be permitted to speak. Section 143 (3) shall apply mutatis mutandis.

#### **Section 103**

An appeal on points of law shall have suspensive effect. Section 75 (2) shall apply mutatis mutandis.

#### **Section 104**

The Federal Court of Justice shall examine, ex officio, whether the appeal on points of law per se is an available remedy and whether it has been filed and reasoned in the statutory form and within the statutory time limit. If any of these requirements is not met, the appeal on points of law shall be rejected as inadmissible.

#### **Section 105**

- (1) If several persons are involved in the proceedings on the appeal on points of law, the notice of appeal and the statement of grounds of appeal shall be served on the other parties, inviting them to make any statements in writing to the Federal Court of Justice within a specific time limit after service. The date on which the appeal on points of law was filed shall be communicated when the notice of appeal is served. The appellant should submit the required number of certified copies together with the notice of appeal or the statement of grounds of appeal.
- (2) If the President of the Patent Office is not involved in the proceedings on an appeal on points of law, section 76 shall apply mutatis mutandis.

#### **Section 106**

(1) The provisions of the Code of Civil Procedure on the exclusion of and objection to court personnel, on agents and advisers, on notifications ex officio, on summonses, hearings and time limits, and on the re-establishment of rights shall apply mutatis mutandis in proceedings on the appeal on points of law. Section 123 (5) to (7) shall apply mutatis mutandis in the case of the re-establishment of rights.

(2) Section 69 (1) shall apply mutatis mutandis to the admission of the public to the proceedings.

#### **Section 107**

(1) The decision on the appeal on points of law shall be given by order; it may be taken without oral proceedings.

(2) The Federal Court of Justice shall be bound in its decision by facts established in the contested order unless admissible and reasoned grounds for an appeal on points of law are submitted in relation to these facts.

(3) The decision shall be reasoned and notified to the parties ex officio.

#### **Section 108**

(1) Where the contested order is set aside, the case shall be referred back to the Federal Patent Court for further proceedings and decision.

(2) The Federal Patent Court shall also base its decision on the legal assessment on which the setting aside was based.

#### **Section 109**

(1) If several persons are party to the proceedings on the appeal on points of law, the Federal Court of Justice may determine that the costs which were necessary to appropriately deal with the matter are to be reimbursed in full or in part by one of the parties if this is equitable. If the appeal on points of law is refused or rejected as inadmissible, the costs caused by the appeal on points of law shall be imposed on the appellant. If a party has caused costs through gross negligence, they shall be imposed on him.

(2) Costs may be imposed on the President of the Patent Office only if he has filed the appeal on points of law or brought motions in the proceedings.

(3) In other respects, the provisions of the Code of Civil Procedure concerning the procedure for the assessment of costs and compulsory enforcement based on orders assessing the costs shall apply mutatis mutandis.

### **2. Appellate proceedings on fact and law**

#### **Section 110**

(1) An appeal on fact and law from judgments of the Nullity Boards at the Federal Patent Court (section 84) may be filed with the Federal Court of Justice.

(2) An appeal on fact and law shall be filed by giving written notice of appeal on fact and law to the Federal Court of Justice.

(3) The time limit for the filing of an appeal on fact and law is one month. It shall commence upon service of the judgment in complete form, at the latest, however, after the expiry of a period of five months following delivery.

(4) The notice of appeal on fact and law shall contain the following:

1. the indication of the judgment against which the appeal on fact and law is being filed;

2. the declaration that an appeal on fact and law is being filed against this judgment.

(5) The general provisions set out in the Code of Civil Procedure on preparatory written pleadings shall apply to the notice of appeal on fact and law.

(6) An execution copy or a certified copy of the contested judgment shall be submitted together with the notice of appeal on fact and law.

- (7) Orders issued by the Nullity Boards shall be contestable only together with their judgments (section 84); section 71 (3) of the Code of Civil Procedure shall not apply.
- (8) Sections 515, 516 and 521 (1) and (2), first sentence, of the Code of Civil Procedure shall apply mutatis mutandis.

#### **Section 111**

- (1) The appeal on fact and law may only be based on the fact that the decision issued by the Federal Patent Court is based on a violation of federal law or that facts which are to be taken as the basis in accordance with section 117 justify a different decision.
- (2) The law has been violated if a legal provision was not applied or was not applied correctly.
- (3) A decision shall always be regarded as based on a violation of the law
1. if the Federal Patent Court did not sit in a composition required by law;
  2. if a judge was involved in taking the decision who was excluded from exercising judicial office by operation of law, unless this impediment has been unsuccessfully asserted by means of a motion of objection;
  3. if a judge was involved in taking the decision although he was objected to on account of being suspected of partiality and the motion of objection was declared well-founded;
  4. if one of the parties was not represented in the proceedings in accordance with the law, unless he explicitly or tacitly authorised the conduct of the proceedings;
  5. if the decision was issued on the basis of oral proceedings in which the provisions on the admission of the public to the proceedings were violated;
  6. if the decision was not reasoned, in contravention of the provisions of the law.

#### **Section 112**

- (1) The claimant in the appeal on fact and law shall state the grounds for the appeal on fact and law.
- (2) The statement of grounds of appeal on fact and law shall be filed in one written pleading with the Federal Court of Justice, unless it was already included in the notice of appeal on fact and law. The time limit for the submission of the statement of grounds of appeal on fact and law shall be three months. It shall commence upon service of the judgment, in complete form, at the latest, however, after the expiry of a period of five months following delivery. The presiding judge may extend the time limit upon request if the opposing party consents. Without such consent the time limit may be extended by up to one month if, according to the independent conviction of the presiding judge, the proceedings will not be delayed on account of the extension or if the claimant in the appeal on fact and law demonstrates significant grounds. If it is not possible within this time limit to grant file inspection for an appropriate time to the claimant in the appeal on fact and law, the presiding judge may, upon request, extend the period by up to two months after sending the case files.
- (3) The statement of grounds of appeal on fact and law shall contain the following:
1. the declaration as to the extent to which the judgment is being contested and its setting aside is being requested (petitions of appeal on fact and law);
  2. the grounds of appeal on fact and law, namely:
    - a) the indication of the circumstances from which the violation of the law results;

- b) where the appeal on fact and law is based on the fact that the law has been violated in respect of the proceedings, the indication of the facts which result in the defect;
- c) the indication of new means of challenge or defence and the facts on the basis of which the new means of challenge or defence shall be admitted in accordance with section 117.

(4) Section 110 (5) shall apply mutatis mutandis to the statement of grounds of appeal on fact and law.

#### **Section 113**

The parties must be represented before the Federal Court of Justice by a lawyer or a patent attorney as agent. The agent shall be permitted to appear with a technical adviser.

#### **Section 114**

(1) The Federal Court of Justice shall examine, ex officio, whether the appeal on fact and law is per se an available remedy and whether it has been filed and reasoned in the statutory form and within the statutory time limit. If any of these requirements is not met, the appeal on fact and law shall be rejected as inadmissible.

(2) The decision may be given by order.

(3) If the appeal on fact and law is not rejected as inadmissible by order, oral proceedings shall be scheduled and communicated to the parties.

(4) Section 525 of the Code of Civil Procedure shall apply mutatis mutandis. Sections 348 to 350 of the Code of Civil Procedure shall not apply.

#### **Section 115**

(1) The respondent in the appeal on fact and law may file a cross-appeal. The cross-appeal is also an available remedy if the respondent in the appeal on fact and law has waived an appeal on fact and law or if the period for filing an appeal on fact and law has expired.

(2) The cross-appeal shall be made by filing the notice of cross-appeal with the Federal Court of Justice and shall be declared until the expiry of a period of two months following service of the statement of grounds of appeal on fact and law. If the respondent in the appeal on fact and law has been given a time limit to respond to the appeal on fact and law, the cross-appeal shall be admissible until the expiry of this period.

(3) The grounds of cross-appeal shall be set out in the notice of cross-appeal. Section 110 (4), (5) and (8) as well as section 112 (3) shall apply mutatis mutandis.

(4) The cross-appeal shall cease to be effective if the appeal on fact and law is withdrawn or rejected.

#### **Section 116**

(1) Only the petitions filed by the parties shall be subject to examination by the Federal Court of Justice.

(2) An amendment of the action and, in proceedings for revocation of the patent or invalidity of the supplementary protection certificate, a defence based on an amended version of the patent shall be admissible only if

1. the opposing party has consented or the Federal Court of Justice deems the amendment to be expedient, and

2. the amended petitions may be based on facts on which the Federal Court of Justice shall base its proceedings and decision on the appeal on fact and law in accordance with section 117.

#### **Section 117**

Sections 529, 530 and 531 of the Code of Civil Procedure shall apply mutatis mutandis to the extent of the examination by the appellate court and to the means of challenge or

defence which were submitted too late, were rejected and which are new. In this case, section 112 of the Code of Civil Procedure shall apply instead of section 520.

#### **Section 118**

(1) The Federal Court of Justice shall give its judgment on the basis of oral proceedings. Section 69 (2) shall apply mutatis mutandis.

(2) At least two weeks' notice of the summons shall be given.

(3) Oral proceedings may be dispensed with if

1. the parties consent, or
2. a decision only in respect of the costs is to be taken.

(4) If one party does not appear at the hearing, the proceedings may be conducted in their absence and a judgment following adversarial proceedings given. If none of the parties appears at the hearing, the judgment shall be issued on the basis of the files.

#### **Section 119**

(1) If the grounds in the contested judgment reveal that the law has been violated but the decision itself proves to be correct for other reasons, the appeal on fact and law shall be rejected.

(2) Where the appeal on fact and law is deemed to be well-founded, the contested judgment shall be set aside. If the judgment is set aside on account of a defect in the proceedings, the proceedings shall also be set aside in so far as they are affected by the defect.

(3) In the event of the judgment being set aside, the case shall be referred back to the Federal Patent Court for new proceedings and a new decision. The case may be referred back to a different Nullity Board.

(4) The Federal Patent Court shall also base its decision on the legal assessment on which the setting aside was based.

(5) The Federal Court of Justice may itself take a decision in the case if this appears expedient. It shall itself take a decision if the case is ready for a final decision.

#### **Section 120**

The decision need not be reasoned if the Federal Court of Justice deems notices of procedural defects to be ineffective. This shall not apply to notices of defects in accordance with section 111 (3).

#### **Section 121**

(1) The provisions under section 144 on the fixing of the value in dispute shall apply mutatis mutandis in proceedings before the Federal Court of Justice.

(2) The judgment shall also contain a decision on the costs of the proceedings. The provisions set out in the Code of Civil Procedure on legal costs (sections 91 to 101) shall apply mutatis mutandis unless equity requires that a different decision be taken; the provisions set out in the Code of Civil Procedure on the procedure for the assessment of costs (sections 103 to 107) and compulsory enforcement based on orders assessing the costs (sections 724 to 802) shall apply mutatis mutandis.

### **3. Appeal proceedings**

#### **Section 122**

(1) An appeal from the judgments of the Nullity Boards at the Federal Patent Court on the issue of injunctions in proceedings relating to the grant of a compulsory licence (sections 85 and 85a) may be filed with the Federal Court of Justice. Section 110 (7) shall apply mutatis mutandis.

(2) The appeal shall be filed in writing with the Federal Court of Justice within one month.

(3) The time limit for filing of the appeal shall commence upon service of the judgment in complete form, at the latest, however, before the expiry of a period of five months following delivery.



(4) Section 74 (1), section 84 and sections 110 to 121 shall apply mutatis mutandis to the proceedings before the Federal Court of Justice.

#### **4. Common procedural provisions**

##### **Section 122a**

Upon the filing of a notice of defect by the party adversely affected by the decision, the proceedings shall be continued if the court has violated this party's right to be heard in a manner which has a decisive influence on the decision. A notice of defect shall not be an available remedy against a decision given prior to the final decision. Section 321a (2) to (5) of the Code of Civil Procedure shall apply mutatis mutandis.

#### **Part VII Common provisions**

##### **Section 123**

(1) Any person who through no fault of his own was prevented from observing a time limit vis-à-vis the German Patent and Trade Mark Office or Federal Patent Court, where non-observance of which causes a legal disadvantage in accordance with legal provisions, shall have his rights re-established upon request. This shall not apply to the time limit

1. for filing an opposition (section 59 (1)) and for paying the opposition fee (section 6 (1), first sentence, of the Patent Costs Act),
2. for the opponent for filing an appeal against maintenance of the patent (section 73 (2)) and for paying the appeal fee (section 6 (1), first sentence, of the Patent Costs Act) and
3. for filing applications for which a priority can be claimed in accordance with section 7 (2) and section 40.

(2) The re-establishment of rights shall be requested in writing within two months of removal of the cause of non-compliance. The request shall state the facts on which the re-establishment of rights is based; these shall be substantiated when the request is filed or in the proceedings concerning the request. The omitted act shall be completed within the period for making the request; where this is done, the re-establishment of rights may also be granted without request. The re-establishment of rights can no longer be requested and the omitted act no longer be completed one year after the expiry of the period which was not observed.

(3) The authority competent to decide on the completed act shall decide on the request.

(4) The re-establishment of rights shall be final.

(5) Any person who, in Germany and in good faith, has used or has made preparations necessary for using the subject-matter of a patent which has re-entered into force as a result of the re-establishment of rights during the period between the lapse of the patent and its re-entry into force shall be entitled to continue using the subject-matter of the patent for the needs of his own business in his own workshops or in the workshops of others. This entitlement may be bequeathed or transferred only together with the business.

(6) Subsection (5) shall apply mutatis mutandis if the effect referred to in section 33 (1) re-enters into force as a result of the re-establishment of rights.

(7) Any person who, in Germany and in good faith, has used the subject-matter of an application which, as a result of the re-establishment of rights, claims priority of an earlier foreign application (section 41) during the period between the expiry of the period of twelve months and the re-entry into force of the right of priority or who has made the necessary preparations for so doing within that period shall be entitled in accordance with subsection (5).

##### **Section 123a**

- (1) Where the patent application has been refused upon failure to comply with a time limit set by the German Patent and Trade Mark Office, the decision shall become ineffective without the need for its express setting aside if the applicant requests further processing of the application and completes the omitted act.
- (2) The request shall be filed within one month of service of the decision to refuse the patent application. The omitted act shall be completed within this period.
- (3) Re-establishment of rights shall be ruled out in respect of non-observance of the period under subsection (2) and the period for payment of the further processing fee under section 6 (1), first sentence, of the Patent Costs Act.
- (4) The authority competent to decide on the completed act shall decide on the request.

#### **Section 124**

In proceedings before the German Patent and Trade Mark Office, the Federal Patent Court and the Federal Court of Justice the parties shall make their statements on facts and circumstances in full and truthfully.

#### **Section 125**

- (1) Where the opposition or the action for revocation of the patent is based on the statement that the subject-matter of the patent is not patentable in accordance with section 3, the German Patent and Trade Mark Office or the Federal Patent Court may require the filing of originals, photocopies or certified copies of documents cited in the opposition or in the action and which are not available at the German Patent and Trade Mark Office and at the Federal Patent Court, with one copy each for the German Patent and Trade Mark Office or the Federal Patent Court and for the parties to the proceedings.
- (2) The German Patent and Trade Mark Office or the Federal Patent Court may demand the furnishing of uncertified or certified translations of cited documents in a foreign language.

#### **Section 125a**

- (1) In so far as the written form is required, proceedings before the Patent Office in respect of applications, requests or other acts, the provisions contained in section 130a (1), first and third sentences, as well as subsection (3) of the Code of Civil Procedure shall apply mutatis mutandis.
- (2) The case files of the Federal Patent Court and of the Federal Court of Justice may be kept in electronic form. The provisions of the Code of Civil Procedure on electronic documents, the electronic file and the electronic conduct of proceedings shall apply mutatis mutandis in other respects, unless otherwise provided by this Act.
- (3) The Federal Ministry of Justice and Consumer Protection shall, by statutory instrument not requiring the consent of the Bundesrat, determine
  1. the date from when electronic documents may be submitted to the German Patent and Trade Mark Office and the courts, the appropriate form for processing the documents, whether an electronic signature shall be used and the form of such signature;
  2. the date from when the case files may be kept in electronic form in accordance with subsection (2), as well as the applicable general organisational and technical conditions for the creation, keeping and storage of the electronic case files.

#### **Section 126**

The language before the German Patent and Trade Mark Office and the Federal Patent Court shall be German, unless otherwise provided. In other respects, the provisions of the Courts Constitution Act on the court language shall apply.

#### **Section 127**

- (1) The provisions of the Act on Service in Administrative Procedures (Verwaltungszustellungsgesetz) shall apply to service in proceedings before the German Patent and Trade Mark Office subject to the following conditions:

1. Where acceptance of service by registered letter is refused without statutory ground, service shall nevertheless be deemed to have been effected.

2. Service on addressees who are staying abroad and who, contrary to the requirement under section 25, have not appointed a representative in Germany may be effected by posting a registered letter. The same shall apply to addressees who themselves are representatives in Germany within the meaning of section 25 (2). Section 184 (2), first and fourth sentences, of the Code of Civil Procedure shall apply mutatis mutandis.

3. Section 5 (4) of the Act on Service in Administrative Procedures shall apply mutatis mutandis to service on holders of a certificate of representation (section 177 of the Patent Attorney Code (Patentanwaltsordnung)).

4. Service on addresses for whom a post box has been set up at the German Patent and Trade Mark Office may also be effected by depositing the document in the addressee's post box. A record of the deposit shall be added to the files. A note shall be made on the document of the date when it was deposited. Service shall be deemed to have been effected on the third day following deposit in the post box.

5. Service of electronic documents is to be made using a mode of transmission which guarantees the authenticity and integrity of the data and which, if generally accessible networks are used, safeguards the confidentiality of the data to be transmitted by means of an encryption procedure. The Federal Ministry of Justice and Consumer Protection shall regulate, by statutory instrument not requiring the consent of the Bundesrat, details concerning those modes of transmission which are suitable pursuant to the first sentence, as well as concerning the form and proof of electronic service.

(2) The provisions of the Code of Civil Procedure shall apply to service in proceedings before the Federal Patent Court.

#### **Section 128**

(1) The courts shall be obliged to provide judicial assistance to the German Patent and Trade Mark Office and the Federal Patent Court.

(2) In proceedings before the German Patent and Trade Mark Office, the Federal Patent Court shall, upon the request of the German Patent and Trade Mark Office, impose administrative penalties and measures of compulsion on witnesses or experts who fail to appear or who refuse to give evidence or to give evidence under oath. In like manner, a warrant shall be issued for a witness who has failed to appear to be brought before the court.

(3) A Board of Appeal at the Federal Patent Court sitting in a composition of three legally qualified members shall decide on the request in accordance with subsection (2). The decision shall be given by order.

#### **Section 128a**

Witnesses shall receive compensation and experts shall receive remuneration pursuant to the Judicial Remuneration and Compensation Act (Justizvergütungs- und -entschädigungsgesetz).

#### **Section 128b**

The provisions of the Seventeenth Title of the Courts Constitution Act shall apply mutatis mutandis to proceedings before the Federal Patent Court and the Federal Court of Justice.

### **Part XIII Legal aid**

#### **Section 129**

In proceedings before the German Patent and Trade Mark Office, the Federal Patent Court and the Federal Court of Justice, a party shall receive legal aid in accordance with the provisions set out in sections 130 to 138.

### **Section 130**

(1) Upon request and subject to the application mutatis mutandis of sections 114 to 116 of the Code of Civil Procedure, the applicant shall receive legal aid in the procedure for the grant of a patent where there is sufficient prospect of the patent being granted. Upon request by the applicant or the proprietor of the patent, legal aid may also be granted in respect of the annual renewal fees pursuant to section 17. Payments shall be made to the Federal Cash Office (Bundeskasse).

(2) The grant of legal aid shall have the effect that the legal consequences stipulated in the event of non-payment shall not occur in respect of the fees which form the subject of the legal aid. In other respects, section 122 (1) of the Code of Civil Procedure shall apply mutatis mutandis.

(3) Where several persons have jointly filed an application for the patent, they shall receive legal aid only if all the applicants fulfil the requirements set out in subsection (1).

(4) If the applicant or the proprietor of the patent is not the inventor or his universal successor in title, he shall receive legal aid only if the inventor also fulfils the requirements set out in subsection (1).

(5) Upon request, as many annual renewal fees may be incorporated into the legal aid as are necessary to preclude the limitation conflicting with the grant of legal aid in accordance with section 115 (3) of the Code of Civil Procedure. The instalments paid shall not be set off against the annual renewal fees until the costs of the procedure for the grant of the patent, including any costs incurred for an assigned representative, are covered by the instalment payments. In so far as the annual renewal fees can be regarded as having been settled by the instalments paid, section 5 (2) of the Patent Costs Act shall apply mutatis mutandis.

(6) Subsections (1) to (3) shall apply mutatis mutandis in the case referred to in section 44 to the requesting third party if he substantiates an interest of his own meriting protection.

### **Section 131**

The provisions under section 130 (1), (2) and (5) shall apply mutatis mutandis to proceedings to limit or revoke the patent (section 64).

### **Section 132**

(1) The proprietor of the patent shall, upon request and subject to the application mutatis mutandis of sections 114 to 116 of the Code of Civil Procedure and section 130 (1), second sentence, and subsections (2), (4) and (5), receive legal aid in opposition proceedings (sections 59 to 62). No examination shall be conducted as to whether the legal defence offers sufficient prospect of success.

(2) Subsection (1), first sentence, shall apply mutatis mutandis to the opponent and the third party who has intervened pursuant to section 59 (2) as well as to the parties in the proceedings for revocation of the patent or in compulsory licence proceedings (sections 81, 85 and 85a) if the person making the request substantiates an interest of his own meriting protection.

### **Section 133**

A party who has been granted legal aid in accordance with the provisions of sections 130 to 132 shall, upon request, be assigned a patent attorney or lawyer of his choice who is willing to act as his representative or, upon explicit request, a holder of a certificate of representation if the representation appears necessary to appropriately handle the proceedings or a party with opposing interests is represented by a patent attorney, a lawyer or a holder of a certificate of representation. Section 121 (4) and (5) of the Code of Civil Procedure shall apply mutatis mutandis.

### **Section 134**

Where a request for the grant of legal aid in accordance with sections 130 to 132 is submitted before the expiry of a time limit provided for the payment of a fee, this period shall be suspended until the expiry of a period of one month following service of the decision on the request.

#### **Section 135**

(1) The request for the grant of legal aid shall be submitted in writing to the German Patent and Trade Mark Office, the Federal Patent Court or the Federal Court of Justice. In proceedings in accordance with sections 110 and 122 the request may also be declared before and recorded with the registry of the Federal Court of Justice. Section 125a shall apply mutatis mutandis.

(2) The authority responsible for the proceedings for which the legal aid is being requested shall decide on the request.

(3) The decisions issued in accordance with sections 130 to 133 shall be final unless they are decisions of the Patent Division refusing legal aid or the assignment of a representative in accordance with section 133; an appeal on points of law shall be ruled out. Section 127 (3) of the Code of Civil Procedure shall apply mutatis mutandis to the proceedings before the Federal Patent Court.

#### **Section 136**

The provisions under section 117 (2) to (4), section 118 (2) and (3), sections 119 and 120 (1) and (3), section 120a (1), (2) and (4) as well as sections 124 and 127 (1) and (2) of the Code of Civil Procedure shall apply mutatis mutandis, section 127 (2) of the Code of Civil Procedure shall apply mutatis mutandis with the proviso that the appeal is an available remedy independently of the value in dispute. In opposition proceedings and in proceedings for revocation of the patent or in compulsory licence proceedings (sections 81, 85 and 85a), this also applies to section 117 (1), second sentence, section 118 (1), section 122 (2) as well as sections 123, 125 and 126 of the Code of Civil Procedure.

#### **Section 137**

The legal aid may be revoked if the invention in respect of which an application has been filed or which is protected by patent on the basis of which legal aid has been granted is exploited commercially by sale, use, issue of a licence or in another way and the income generated thereby changes the conditions relevant to the grant of legal aid that the party concerned can be reasonably expected to pay the costs of the proceedings; this also applies after the expiry of the period under section 124 (1) no. 3 of the Code of Civil Procedure. The party which has been granted legal aid shall inform that authority which took the decision on the grant of the legal aid of each commercial exploitation of this invention.

#### **Section 138**

(1) A party shall be granted legal aid upon request and subject to the application mutatis mutandis of sections 114 to 116 of the Code of Civil Procedure in proceedings on an appeal on points of law (section 100).

(2) The request for the grant of legal aid shall be submitted in writing to the Federal Court of Justice; it may also be declared before and recorded with the registry. The Federal Court of Justice shall decide on the request.

(3) In other respects, the provisions of section 130 (2), (3), (5) and (6) as well as sections 133, 134, 136 and 137 shall apply mutatis mutandis, with the proviso that a party which has been granted legal aid may only be assigned a lawyer who has been admitted to practise before the Federal Court of Justice.

### **Part IX Legal infringements**

#### **Section 139**

(1) Any person who uses a patented invention contrary to sections 9 to 13 may, in the event of the risk of recurrent infringement, be sued by the aggrieved party for cessation and desistance. This right may also be asserted in the event of the risk of a first-time infringement.

(2) Any person who performs the act intentionally or negligently shall be obliged to compensate the aggrieved party for the damage caused. When assessing the compensation, consideration may also be given to the profit which the infringer has obtained by infringing the right. The claim for compensation may also be calculated on the basis of the amount which the infringer would have been required to pay as equitable remuneration if he had obtained permission to use the invention.

(3) If the subject-matter of the patent is a process for manufacturing a new product, the same product produced by someone else shall, until there is proof to the contrary, be deemed to have been produced using the patented process. In taking evidence to the contrary, consideration shall be given to the defendant's legitimate interests in protecting his manufacturing and trade secrets.

#### **Section 140**

Where prior to the grant of a patent rights resulting from an application whose files may be inspected by any person (section 31 (1), second half of the second sentence, and subsection (2)) are asserted by judicial proceedings and where the decision on the proceedings depends on whether a claim in accordance with section 33 (1) exists, the court may order that the proceedings be suspended until a decision is delivered on the grant of the patent. Where a request for examination pursuant to section 44 has not been made, the court shall, upon motion by the opposing party, set the party asserting rights resulting from the application a time limit to make the request for examination. Where the request for examination is not made within the time limit, rights resulting from the application may not be asserted in the proceedings.

#### **Section 140a**

(1) Any person who uses a patented invention contrary to sections 9 to 13 may be sued by the aggrieved party for destruction of products held or owned by the infringer which are the subject-matter of the patent. The first sentence shall also apply in the case of products which have been produced directly by means of a process which is the subject-matter of the patent.

(2) Subsection (1) shall apply mutatis mutandis to materials and implements which are owned by the infringer and were predominantly used for manufacturing these products.

(3) Any person who uses a patented invention contrary to sections 9 to 13 may be sued by the aggrieved party for recall of the products which are the subject-matter of the patent or for definitive removal of the products from the channels of commerce. The first sentence shall also apply in the case of products which have been produced directly by means of a process which is the subject-matter of the patent.

(4) The claims under subsections (1) to (3) shall be ruled out if such a claim is disproportionate in an individual case. When examining proportionality consideration shall also be given to the legitimate interests of third parties.

#### **Section 140b**

(1) Any person who uses a patented invention contrary to sections 9 to 13 may be sued by the aggrieved party for provision of information, without delay, regarding the origin and the channel of commerce of the products used.

(2) In cases of an obvious legal infringement or in cases where the aggrieved party has brought an action against the infringer, the claim may also be asserted, without prejudice to subsection (1), against a person who, on a commercial scale,

1. had possession of infringing products,
2. made use of infringing services,



3. provided services used for infringing activities, or
4. according to the information provided by a person referred to in no. 1, 2 or 3, participated in manufacturing, creating or distributing such products or participated in the provision of such services,

unless that person would be entitled under sections 383 to 385 of the Code of Civil Procedure to refuse to give testimony in proceedings against the infringer. In the event of assertion of the claim in judicial proceedings under the first sentence, the court may, upon motion, suspend the proceedings pending against the infringer until the proceedings on the claim concerning the provision of information have been concluded. The person obliged to provide the information may demand from the aggrieved party reimbursement of the expenditure for the provision of the information.

(3) The person obliged to provide the information shall give particulars of

1. the names and addresses of the manufacturers, suppliers and other previous holders of the products or of the users of the services as well as of the intended wholesalers and retailers, and
2. the quantity of the products manufactured, delivered, received or ordered, as well as the prices paid for the products or services concerned.

(4) The claims under subsections (1) and (2) shall be ruled out if such a claim is disproportionate in an individual case.

(5) If the person obliged to provide the information, while acting intentionally or grossly negligently, provides false or incomplete information, he shall be obliged to compensate the aggrieved party for the damage caused.

(6) Any person who provides true information without having been obliged to do so in accordance with subsection (1) or subsection (2) shall be liable to third parties only if he knew that he was not obliged to provide the information.

(7) In cases of an obvious legal infringement the obligation to provide the information may be imposed by means of an injunction in accordance with sections 935 to 945 of the Code of Civil Procedure.

(8) In criminal proceedings or in proceedings under the Act on Regulatory Offences (Gesetz über Ordnungswidrigkeiten) the findings may be used against one of the persons obliged on account of an act committed prior to the provision of the information or against a relative referred to in section 52 (1) of the Code of Civil Procedure only with the consent of the person obliged.

(9) Where the information can be provided only by using traffic data (section 3 no. 30 of the Telecommunications Act (Telekommunikationsgesetz)), a court order regarding the admissibility of the use of the traffic data shall first have to be obtained upon motion by the aggrieved party. For issuance of this order, that regional court in whose district the person obliged to provide the information has his residence, principal place of business or an establishment shall have exclusive jurisdiction, irrespective of the value in dispute. The civil division shall decide. The provisions of the Act on Proceedings in Family Matters and in Matters of Non-Contentious Jurisdiction (Gesetz über das Verfahren in Familiensachen und in den Angelegenheiten der freiwilligen Gerichtsbarkeit) shall apply to the proceedings *mutatis mutandis*. The costs of the court order shall be borne by the aggrieved party. An appeal from the decision of the regional court shall be an available remedy. The notice of appeal shall be lodged within a time limit of two weeks. The provisions concerning the protection of personal data shall otherwise remain unaffected.

(10) The basic right to privacy of telecommunications shall be restricted (Article 10 of the Basic Law (Grundgesetz)) by subsection (2) in conjunction with subsection (9).

#### **Section 140c**

(1) Any person who with sufficient likelihood uses a patented invention contrary to sections 9 to 13 may be sued by the right holder or by another entitled person for production of a

document or inspection of an item which lies in his control or of a process which is the subject-matter of the patent if this is necessary for the purpose of establishing the claims of the right holder or another entitled person. Where there is sufficient likelihood of a legal infringement being committed on a commercial scale, the claim shall extend to the production of bank, financial or commercial documents. If the alleged infringer asserts that the information concerned is confidential, the court shall take the measures necessary to ensure the specific protection required in an individual case.

(2) The claim in accordance with subsection (1) shall be ruled out if such a claim is disproportionate in an individual case.

(3) The obligation to produce a document or to acquiesce to the inspection of an item may be imposed by means of an injunction in accordance with sections 935 to 945 of the Code of Civil Procedure. The court shall take the measures necessary to ensure the protection of confidential information. This shall in particular apply to those cases where the injunction is issued without giving a prior hearing to the opposing party.

(4) Section 811 of the German Civil Code as well as section 140b (8) shall apply mutatis mutandis.

(5) If there was no infringement or no risk of infringement, the alleged infringer may claim compensation for the damage caused to him by the production or inspection sought in accordance with subsection (1) from the person who sought the production or inspection.

#### **Section 140d**

(1) In the event of a legal infringement being committed on a commercial scale in the cases referred to in section 139 (2), the aggrieved party may also require the infringer to produce bank, financial or commercial documents or to provide appropriate access to the relevant documents as are in the infringer's control and are necessary for enforcing the claim for compensation if there is doubt as to whether the claim for compensation will be satisfied in the absence of such production. Where the infringer asserts that the information is confidential, the court shall take the measures necessary to ensure the specific protection required in an individual case.

(2) The claim in accordance with subsection (1) shall be ruled out if such a claim is disproportionate in an individual case.

(3) The obligation to produce the documents referred to in subsection (1) may be imposed by means of an injunction in accordance with sections 935 to 945 of the Code of Civil Procedure in cases where there evidently is a claim to compensation. The court shall take the measures necessary to ensure the protection of confidential information. This shall in particular apply to those cases where the injunction is issued without giving a prior hearing to the opposing party.

(4) Section 811 of the German Civil Code and section 140b (8) shall apply mutatis mutandis.

#### **Section 140e**

Where an action has been brought under this Act, the successful party may be entitled in the judgment to make the judgment public at the expense of the unsuccessful party if the successful party demonstrates a legitimate interest. The nature and extent of the publication shall be laid down in the judgment. The entitlement shall lapse if it is not used within three months of the judgment becoming final. The pronouncement in accordance with the first sentence shall not be provisionally enforceable.

#### **Section 141**

The provisions of Book 1, Division 5 of the German Civil Code shall apply mutatis mutandis to limitation in respect of claims deriving from an infringement of a patent right. Where the person obliged has obtained something as a consequence of the infringement at the expense of the entitled person, section 852 of the German Civil Code shall apply mutatis mutandis.

#### **Section 141a**

Claims under other statutory provisions shall remain unaffected.

#### **Section 142**

(1) Any person acting without the requisite consent of the proprietor of the patent or of a supplementary protection certificate (sections 16a and 49a) who

1. manufactures or offers, places on the market, uses a product which is the subject-matter of the patent or of the supplementary protection certificate (section 9, second sentence, no. 1) or either imports or holds the product for one of the purposes mentioned, or
2. uses or offers for use within the territorial scope of this Act a process which is the subject-matter of the patent or of the relevant protection certificate (section 9, second sentence, no. 2)

shall be liable to imprisonment for no more than three years or a fine.

The first sentence, no. 1, shall also apply to the case of a product which has been manufactured directly by a process which is the subject-matter of the patent or of the supplementary protection certificate (section 9, second sentence, no. 3).

(2) Where the offender acts on a commercial scale, the penalty shall be imprisonment for up to five years or a fine.

(3) An attempt shall be punishable.

(4) In the cases referred to in subsection (1), the offence shall be prosecuted upon motion only, unless the criminal prosecution authorities consider ex officio intervention imperative on account of the particular public interest in criminal prosecution.

(5) Objects to which the criminal offence relates may be confiscated. Section 74a of the Criminal Code shall apply. Where the claims referred to in section 140a are upheld in proceedings pursuant to the provisions of the Code of Criminal Procedure (Strafprozessordnung) governing compensation for the aggrieved person (sections 403 to 406c), the provisions on confiscation shall not apply.

(6) Where a penalty is imposed, an order shall be made upon motion by the aggrieved party and upon demonstration of a legitimate interest to the effect that the conviction be made public upon demand. The nature of the publication shall be laid down in the judgment.

#### **Section 142a**

(1) A product which infringes a patent protected under this Act shall be subject, upon request and security being given by the right holder, to seizure by the customs authority, on import or export, in so far as the legal infringement is obvious and there is no requirement to apply Regulation (EU) No 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights and repealing Council Regulation (EC) No 1383/2003 (OJ L 181 of 29.6.2013 p. 15), as amended. This shall apply to transactions with other Member States of the European Union and with the Contracting Parties to the Agreement on the European Economic Area only to the extent that controls are carried out by the customs authorities.

(2) Where the customs authority orders seizure, it shall without delay inform the person entitled to exercise the control and the person making the request. The origin, quantity and place of storage of the product as well as of name and address of the person entitled to exercise the control shall be communicated to the person making the request; the privacy of correspondence and posts (Article 10 of the Basic Law) shall thus be restricted. The person making the request shall be given the opportunity to inspect the product provided that this does not interfere with business or trade secrets.

(3) Where no objection is lodged in respect of the seizure before the expiry of a period of two weeks following service of the communication in accordance with subsection (2), first sentence, at the latest, the customs authority shall order confiscation of the seized product.

(4) Where the person entitled to exercise the control objects to the seizure, the customs authority shall inform the person making the request without delay. The latter shall declare to

the customs authority without delay whether he upholds the request in accordance with subsection (1) in respect of the seized product.

1. Where the person making the request withdraws his request, the customs authority shall revoke the seizure without delay.
2. Where the person making the request upholds his request and submits an enforceable court decision ordering the impounding of the seized product or imposing a restriction on the control, the customs authority shall take the necessary measures.

Where the cases referred to in no. 1 or 2 do not apply, the customs authority shall revoke the seizure after the expiry of a period of two weeks following service of the communication to the person making the request in accordance with the first sentence; where the person making the request proves that he has requested, but not yet received, a court decision in accordance with no. 2, the seizure shall remain in force for a maximum of a further two weeks.

(5) Where the seizure proves to have been unjustified from the outset and the person making the request has upheld the request in accordance with subsection (1) in regard to the seized product or did not without delay make a declaration (subsection (4), second sentence), he shall be obliged to compensate the person entitled to exercise the control for the damage caused by the seizure.

(6) The request in accordance with subsection (1) shall be made to the Central Customs Authority (Generalzolldirektion) and shall remain in force for one year unless the request has been made for a shorter duration; the request may be repeated. The person making the request shall be charged with the costs of official acts connected with the request subject to section 178 of the Fiscal Code.

(7) Seizure and confiscation may be contested using the appellate remedies admissible in respect of seizure and confiscation in regulatory fining proceedings in accordance with the Act on Regulatory Offences. The person making the request shall be heard in appeal proceedings. An immediate appeal may be filed from a local court decision; the higher regional court shall decide on it.

#### **Section 142b**

Section 142a (5) and (6) shall apply mutatis mutandis to the procedure under Regulation (EU) No 608/2013, unless that Regulation contains provisions which preclude this.

### **Part X Patent litigation**

#### **Section 143**

(1) The civil divisions of the regional courts shall have exclusive jurisdiction, irrespective of the value in dispute, over all actions in which a claim from one of the legal relationships regulated under this Act is asserted (patent litigation cases).

(2) The Land (federal state) governments shall be authorised to assign, by statutory instrument, patent litigation cases for the districts of more than one regional court to one such regional court. The Land governments may delegate this authorisation to the Land departments of justice. In addition, the Länder may, by agreement delegate duties incumbent upon the courts of one Land to the competent court of another Land, in whole or in part.

(3) In respect of the costs arising from the participation of a patent attorney in the litigation, fees pursuant to section 13 of the Act on the Remuneration of Lawyers (Rechtsanwaltsvergütungsgesetz) as well as the necessary expenses of the patent attorney shall be reimbursed.

#### **Section 144**

(1) Where a party to a patent litigation case substantiates that the burden of the costs of the proceedings based on the full value in dispute would pose a substantial risk to his economic situation, the court may, upon motion by that party, order that such party's obligation to pay

court costs shall be proportionate to a part of the value in dispute as adjusted to his economic situation. This order shall have the effect that the beneficiary shall also have to pay the fees of his lawyer only in relation to this part of the value in dispute. In so far as the costs of the proceedings are imposed on such party or the latter assumes these costs, the party shall reimburse the court costs paid by the opposing party and the fees of his lawyer only in relation to the part of the value in dispute. Where the extra-judicial costs are imposed on the opposing party or are assumed by that party, the beneficiary's lawyer may recover his fees from the opposing party in relation to such value in dispute as applies to the latter.

(2) The motion in accordance with subsection (1) may be declared before and recorded with the court registry. It shall be made before the court hearing on the merits. Thereafter it shall be admissible only where the court subsequently increases the presumed or assessed value in dispute. The opposing party shall be heard before a decision is taken on the motion.

#### **Section 145**

Any person who has brought an action pursuant to section 139 may bring a further action against the defendant for the same or the same kind of act by virtue of another patent only where he was, through no fault of his own, not in the position to also assert this patent in earlier proceedings.

### **Part XI Arrogation of patent**

#### **Section 146**

Any person who uses a designation on items or on their packaging which is likely to create the impression that the items concerned are protected by a patent or patent application pursuant to this Act or any person who in public advertisements, on signboards, on compliment slips or in similar acts of communication uses a designation of such nature shall, on demand, be obliged to provide information regarding the patent or the patent application upon which use of the designation is based to any person having a legitimate interest in knowing the legal situation.

### **Part XII Transitional provisions**

#### **Section 147**

(1) Article 229 paragraph 6 of the Introductory Act to the German Civil Code (Einführungsgesetz zum Bürgerlichen Gesetzbuche) shall apply mutatis mutandis, with the proviso that section 33 (3) and section 141 in the version in force until 1 January 2002 shall be treated as equivalent to the provisions of the German Civil Code on limitation in the version in force until 1 January 2002.

(2) The provisions of this Act in the version in force until 30 September 2009 shall continue to apply in respect of proceedings for revocation of the patent or invalidity of the supplementary protection certificate or for the grant or withdrawal of a compulsory licence or for adjustment of the remuneration for a compulsory licence assessed in a judgment, such proceedings having been initiated in an action brought before the Federal Patent Court before 1 October 2009.

(3) In proceedings in which a request for patent of addition has been filed or may still be filed in accordance with section 16 (1), second sentence, of this Act in the version applicable before 1 April 2014 or a patent of addition is in force, section 16 (1), second sentence, subsection (2), section 17 (2), section 23 (1), section 42 (2), first sentence, no. 4, second sentence, and subsection (3), first sentence, as well as section 43 (2), fourth sentence, of this Act in the version applicable until 1 April 2014 shall continue to apply.

(4) In respect of requests for the extension of the time limit for the designation of the inventor, section 37 (2), second to fourth sentence, and section 20 (1) no. 2 of this Act in the version applicable prior to 1 April 2014 shall continue to apply if the requests were received

by the German Patent and Trade Mark Office before 1 April 2014 and the patent has already been granted.

(5) In respect of requests for a hearing in accordance with section 46 (1) which the German Patent and Trade Mark Office received before 1 April 2014, section 46 of this Act in the version applicable until that time shall continue to apply.