

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 26 des Gesetzes vom 23. Oktober 2024 (BGBl. 2024 I Nr. 323)

Version information: The translation includes the amendment(s) to the Act by Article 26 of the Act of 23 October 2024 (Federal Law Gazette 2024 I No. 323)

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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 26 of the Act of 23 October 2024 (Federal Law Gazette 2024 I No. 323)

#### **Division 1**

##### **Patents**

##### **Section 1**

(1) Patents are 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 are 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, are not 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) excludes 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 must 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 is to include its use for which industrial application is disclosed pursuant to subsection (3).

## **Section 2**

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

(2) Patents are, in particular, not 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 animals resulting from such processes.

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

## **Section 2a**

(1) Patents are not 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 does 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) applies accordingly.

(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, 1.1.1994, p. 1), as amended.

## **Section 3**

(1) An invention is deemed to be new if it does not form part of the state of the art. The state of the art is 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 is also 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 for the Federal Republic of Germany pursuant to Article 79 (2) of the European Patent Convention and if, in the case of a Euro-PCT application (Article 153 (2) of the European Patent Convention), the requirements laid down in Article 153 (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, sentence 1 applies 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 sentence 1 no. 1, in respect of which an order has been made in accordance with section 50 (1) or (4) are deemed to have been made available to the public after the expiry of a period of 18 months following their filing.

(3) Subsections (1) and (2) do 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) also do 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 is not taken into consideration if it occurred no earlier than six months preceding 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 the applicant's legal predecessor, or
2. the fact that the applicant or the applicant's 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.

Sentence 1 no. 2 applies 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 after the filing. Exhibitions referred to in sentence 1 no. 2 are notified by the Federal Minister of Justice and Consumer Protection in the Federal Gazette.

#### **Section 4**

An invention is 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 are not considered in deciding whether there has been an inventive step.

#### **Section 5**

An invention is considered as 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 belongs to the inventor or the inventor's successor in title. If two or more persons have jointly made an invention, the right to the patent belongs to them jointly. If two or more persons have made the invention independently of each other, the right belongs 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 owing to the need to establish the identity of the inventor, the applicant is 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 or herself file an application in respect of the invention within one month after the official communication thereof and can 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 or her the right to the grant of the patent. Where the application has already resulted in a patent, that person can require the proprietor of the patent to transfer the patent. Subject to sentences 4 and 5, 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 or she can still bring an action within one year after the final conclusion of the opposition proceedings. Sentences 3 and 4 do not apply if the proprietor of the patent did not act in good faith when obtaining the patent.

#### **Section 9**

Patents have the effect that the proprietor of the patent alone is 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 is prohibited from

1. producing, offering, putting into circulation 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, putting into circulation 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 a patent concerns biological material possessing specific characteristics as a result of an invention, the effects of section 9 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 a 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

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 a patent concerns a product which contains or consists of genetic information as a result of an invention, the effects of section 9 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) remains unaffected.

#### **Section 9b**

If the proprietor of a patent or a third party having the consent of the proprietor of the patent puts into circulation, in the territory of a Member State of the European Union or in a Contracting Party of the Agreement on the European Economic Area, biological material which possesses specific characteristics as a result of the invention and if further biological material is obtained from this biological material through propagation or multiplication, the effects of section 9 have no effect where the propagation or multiplication of the biological material was the purpose for which it was put into circulation. This does 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 a patent or by a third party with the consent of the proprietor of the patent to a farmer for agricultural use, the latter is, contrary to sections 9, 9a and 9b sentence 2, entitled to use the product of his or her harvest for propagation or multiplication on his or her own holding. Article 14 of Council Regulation (EC) No 2100/94, as amended, and the implementing rules adopted on that basis apply to the conditions and extent of this entitlement. 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 (3) of Council Regulation (EC) No 2100/94.

(2) Where livestock or animal reproductive material is marketed to a farmer by the proprietor of the patent or by a third party having the consent of the proprietor of a patent, the farmer is, contrary to sections 9, 9a and 9b sentence 2, entitled to use the livestock or the animal reproductive material for agricultural purposes. This entitlement also includes 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) does 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 the farmer used seeds or plants which are not subject to such patent protection.

#### **Section 10**

(1) Patents further have the effect that any third party is 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) does 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 sentence 2.

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

#### **Section 11**

The effect of a patent does 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 put medicinal products into circulation in the European Union, or which are necessary for obtaining authorisation to put medicinal products into circulation in the Member States of the European Union or in third countries;
3. the extemporaneous preparation in a pharmacy, in 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 applies.

### **Section 12**

- (1) Patents 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 is entitled to use the invention for the needs of their own business in their own workshops or in the workshops of others. This entitlement may be bequeathed or sold only together with the business. Where the applicant or the applicant's legal predecessor has, before filing the application, disclosed the invention to others and, in so doing, has reserved his or her rights in the event of a patent being granted, a person learning of the invention as a result of this disclosure cannot invoke measures referred to in sentence 1 which they have taken within six months following disclosure.
- (2) If the proprietor of a patent is entitled to a right of priority, the earlier application is decisive and not the application referred to in subsection (1). However, this does 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) Patents 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 does 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 is 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 is 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 as

referred to in subsection (1) sentence 1 is to 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) sentence 2 obtains knowledge of a remuneration claim pursuant to sentence 1, this authority is to communicate this to the person registered as the proprietor of the patent.

#### **Section 14**

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

#### **Section 15**

(1) The right to a patent, the entitlement to the grant of a patent and the right deriving from a patent 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 or her licence under sentence 1, the right deriving from the patent may be asserted against the licensee.

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

#### **Section 16**

The term of a patent is 20 years, commencing on the day following the filing of the application in respect of the invention.

#### **Section 16a**

(1) An application for supplementary protection for a patent can be filed in accordance with the provisions of the Regulations of the European Communities concerning the creation of supplementary protection certificates, reference to which is to be made in the Federal Law Gazette, which supplementary protection is to follow immediately upon expiry of the patent in accordance with section 16. Annual renewal fees are to 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 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 revocation (section 64 (1) alternative 1, (2) and (3) sentences 1 to 3), 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 further processing (section 123a), 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) apply accordingly to supplementary protection.

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

#### **Section 17**

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

**Sections 18 and 19  
(repealed)**

**Section 20**

(1) A patent lapses 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 (4) or section 14 (2) and (5) of the Patent Costs Act (*Patentkostengesetz*), section 23 (7) sentence 4 of this Act).

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

**Section 21**

(1) A patent is revoked (section 61) if it emerges that

1. the subject matter of the patent is not patentable under 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 their consent (usurpation);
4. the subject matter of the patent extends beyond the content of the application as filed with the competent authority; the same applies 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 is 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 are deemed not to have had, from the outset, the effects specified. In the event of maintenance with limitation, this provision applies accordingly.

**Section 22**

(1) A patent is 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) applies accordingly.

**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 under the terms of section 125a that he or she 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 are reduced to one half. The declaration is to be recorded in the Register and published in the Patent Gazette.

(2) The declaration is 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 is to inform the proprietor of the patent of this intention. The information is 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 or her registered representative or the person authorised to accept service (section 25). The information must indicate how the invention is to be used. Subsequent to the information, the informing party is entitled to effect use in the manner indicated. The informing party is 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 the informing party does not fulfil this obligation in due time, the person registered as proprietor of the patent may set a reasonable extension of the time for payment and, following expiry without the obligation being fulfilled, may prohibit further use of the invention.

(4) The remuneration is fixed by the Patent Division upon the written request of a party. Sections 46, 47 and 62 apply accordingly 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 full 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 all other cases, subsection (4) applies accordingly.

(6) Where the declaration is made in respect of an application, the provisions of subsections (1) to (5) apply accordingly.

(7) The declaration may be withdrawn in writing under the terms of section 125a vis-à-vis the German Patent and Trade Mark Office at any time, as long as the proprietor of the patent has not yet been informed of any intention to use the invention. The withdrawal takes effect when it is filed. The sum by which the annual renewal fees have been reduced is to be paid within one month following withdrawal of the declaration. If the difference is not paid within the time limit specified in sentence 3, 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 is granted by the Federal Patent Court in an individual case in accordance with the following provisions (compulsory licence) if

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 or she holds protection under a patent with a later filing or priority date without infringing a patent with an earlier filing or priority date, the licence seeker is 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 or her 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 or her 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) applies accordingly 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 judicial 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 under subsection (1) may be granted to ensure an adequate supply of the patented product on the German market. Import is thus equivalent to the use of the patent in Germany.

(6) The grant of a compulsory licence in respect of a patent is 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 duration of use are to be limited to the purpose for which the compulsory licence was granted. The proprietor of the patent is 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 is 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 that person has appointed as their representative a lawyer (*Rechtsanwalt*) or patent attorney (*Patentanwalt*) who is entitled and authorised to represent them 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 apply for criminal prosecution.

(2) The place where a representative appointed pursuant to subsection (1) has his or her commercial premises is 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 is decisive or, if there is no such place, the place where the German Patent and Trade Mark Office has its seat.

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

## **Division 2**

### **German Patent and Trade Mark Office**

### **Section 26**

(1) The German Patent and Trade Mark Office 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 is 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 are 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 is to 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 of the Agreement on the European Economic Area are 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 (subsections (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 all other respects, the provisions governing members also apply to the assistant members.

#### **Section 26a**

(1) The German Patent and Trade Mark Office is tasked with providing the public, in particular small and medium-sized enterprises, with general information about intellectual property rights and limitations to such rights, and about the exercise and enforcement of such rights.

(2) The German Patent and Trade Mark Office cooperates, in the fulfilment of its tasks, with intellectual property offices in other countries and regions, with the European Patent Organisation, with the European Union Intellectual Property Office and with the World Intellectual Property Organization. This cooperation encompasses matters related to copyright. Section 65a of the Trade Mark Act (*Markengesetz*) remains unaffected.

#### **Section 27**

(1) The following are to 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 is also incumbent upon each Patent Division to render expert opinions within its sphere of business (section 29 (1) and (2)).

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

(3) The Patent Division constitutes 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 is, as a rule, to be involved in taking the decision. A decision on the basis of which a request to consult a legally qualified member is refused is not independently contestable.

(4) The chair of the Patent Division may act alone in handling all the Patent Division's 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 may delegate these tasks to a technically qualified member of the Division; this does not apply to a hearing.

(5) The Federal Ministry of Justice and Consumer Protection is authorised to entrust, by statutory instrument, civil servants of the upper and intermediate grades and comparable employees with handling matters incumbent upon the examining sections or Patent Divisions

and which by their nature present no particular technical or legal difficulties; however, this excludes 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) sentence 2 and sections 47 to 49 of the Code of Civil Procedure concerning the exclusion of and objection to court personnel apply analogously to the exclusion of and objection to the patent examiners and other technically qualified members of the Patent Divisions. The same applies to civil servants of the upper and intermediate grades and to employees insofar as they have been entrusted, pursuant to subsection (5), with handling individual matters incumbent upon the examining sections or Patent Divisions. The Patent Division decides on the objection request insofar 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**

(1) The Federal Ministry of Justice and Consumer Protection is authorised to regulate, by statutory instrument not requiring the approval of the Bundesrat,

1. 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;
2. as regards time limits in matters relating to patents, a rule applicable to all the offices of the German Patent and Trade Mark Office concerning public holidays of which account is to be taken.

(2) The Federal Ministry of Justice and Consumer Protection may, by statutory instrument not requiring the approval of the Bundesrat, delegate the authorisation referred to in subsection (1) in full or in part to the German Patent and Trade Mark Office.

### **Section 29**

(1) The German Patent and Trade Mark Office is 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 proceedings by more than one expert.

(2) In all other cases, the German Patent and Trade Mark Office is not 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 is authorised to determine, by statutory instrument not requiring the approval 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 approval of the Bundesrat, delegate this authorisation to the German Patent and Trade Mark Office.

### **Section 29a**

(1) The German Patent and Trade Mark Office is permitted to reproduce, for its employees, works or other subject matter protected under the Copyright Act (*Urheberrechtsgesetz*) and to make these available to the public if this serves the purpose of taking account of the state of the art documented therein in the context of proceedings before the German Patent and Trade Mark Office.

(2) Section 60g (1) and section 95b of the Copyright Act apply accordingly.

(3) Equitable remuneration is to be paid for the uses referred to in subsection (1) if the relevant rightholder offers the work or other protected subject matter to the public only against payment. Section 60h (3) to (5) of the Copyright Act applies accordingly.

### **Section 30**

(1) The German Patent and Trade Mark Office maintains a Register in which a record is 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 suffices. The Register also records the commencement, expiry, lapse, order of limitation, revocation of patents and invalidity of supplementary protection certificates (section 16a), as well as the filing of a notice of opposition and a revocation action. The Register is also to include the date of entry of the unitary effect of the European patent notified by the European Patent Office and the notified date of entry into effect of the European patent with unitary effect pursuant to Article 4 (1) of Regulation (EU) No 1257/2012 of the European Parliament and of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection (OJ L 361, 31.12.2012, p. 1; L 307, 28.10.2014, p. 83).

(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 records in the Register a change in the person, name or place of residence of the applicant or proprietor of the patent and his or her 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 remains subject to the rights and obligations as provided under this Act. If the person newly recorded in the Register as the applicant or proprietor of the patent takes over opposition proceedings before the German Patent and Trade Mark Office, opposition or appeal proceedings before the Federal Patent Court or proceedings on points of law before the Federal Court of Justice, the consent of the other parties to the proceedings is not required therefor.

(4) The German Patent and Trade Mark Office, at the request of the proprietor of the patent or licensee, enters 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 referred to in sentence 1 is inadmissible in a case where the willingness to grant a licence has been declared (section 23 (1)). The entry is cancelled at the request of the proprietor of the patent or licensee. A request for cancellation made by the proprietor of the patent requires proof of the consent of the licensee designated upon entry or of the licensee's successor in title.

(5) (repealed)

### **Section 31**

(1) Upon request, the German Patent and Trade Mark Office grants any person inspection of the files and of the models and samples pertaining to the files if and insofar 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 or her 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 18 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) applies.

(3) Insofar as any person may inspect the files, they may also inspect the models and samples pertaining to the files.

(3a) Insofar as any person may inspect the files, inspection via the internet may also be granted if the files are kept electronically.

(3b) Inspection of the files in accordance with subsections (1) to (3a) is ruled out if

1. it is precluded by a legal provision,
2. an interest meriting protection of the data subject within the meaning of Article 4 no. 1 of Regulation (EU) 2016/679 of the European Parliament and of the Council of 27 April 2016 on the protection of natural persons with regard to the processing of personal data and on the free movement of such data, and repealing Directive 95/46/EC (General Data Protection Regulation) (OJ L 119, 4.5.2016, p. 1; L 314, 22.11.2016, p. 72; L 127, 23.5.2018, p. 2), as amended, obviously prevails,
3. the files contain information or drawings which are obviously contrary to 'ordre public' or morality.

(4) Inspection of the designation of the inventor (section 37 (1)) is granted in accordance with subsection (1) sentence 1 only where applied for by the inventor as designated by the applicant; section 63 (1) sentences 4 and 5 applies accordingly.

(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 insofar as the granting of inspection seems necessary owing to the special interest meriting protection of the person making the request and it is not to be expected that the 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 under section 3 (2) sentence 3 is cited in proceedings as the state of the art, sentence 1 applies accordingly to such part of the files as relates to that citation.

### **Section 31a** **Data protection**

Insofar as the Register or publicly available electronic information services of the German Patent and Trade Mark Office contain personal data, the following do not apply:

1. the right of access pursuant to Article 15 (1) (c) of Regulation (EU) 2016/679,
2. the notification obligation pursuant to Article 19 sentence 2 of Regulation (EU) 2016/679, and
3. the right to object pursuant to Article 21 (1) of Regulation (EU) 2016/679.

The right to obtain a copy pursuant to Article 15 (3) of Regulation (EU) 2016/679 is deemed to be satisfied where the data subject can inspect the Register or publicly available information services of the German Patent and Trade Mark Office.

### **Section 32**

(1) The German Patent and Trade Mark Office publishes

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 sentence 1 to third persons in electronic form for

further processing or use for the purposes of providing information regarding a patent. No such transmission takes 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) and 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 is not published if the patent specification has already been published. The German Patent and Trade Mark Office may refrain from publishing the first publication of an application if the application contains information or drawings which are obviously contrary to 'ordre public' or morality.

(3) The patent specification contains the patent claims, description and drawings on the basis of which the patent was granted. In addition, the patent specification is to 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 is to be included in the patent specification.

(4) The first publication of the application or the patent specification is published under the conditions of 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 or she knew or should have known that the invention he or she used formed the subject matter of the application; further claims are ruled out.

(2) The entitlement does 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 Civil Code (*Bürgerliches Gesetzbuch*) apply accordingly to limitation, with the proviso that the limitation becomes 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 Civil Code applies accordingly.

### **Division 3**

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

### **Section 34**

(1) An application for the grant of a patent for an invention is to be filed with the German Patent and Trade Mark Office.

(2) The patent application can also be filed through a patent information centre if 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 must contain:

1. the name of the applicant;
2. a request for the grant of a patent which clearly and concisely describes the invention;

3. one or more patent claims which 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 must disclose the invention in a manner which is sufficiently clear and complete for it to be carried out by a person skilled in the art.
- (5) The application must 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 is 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 is to specify the state of the art to the best of his or her knowledge, fully and truthfully, and to include it in the description (subsection (3)).
- (8) The Federal Ministry of Justice and Consumer Protection is 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 redeposit 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 is, as a rule, to include information on the geographical origin of such material, if known. This is without prejudice to the examination of applications or the validity of rights arising from granted patents.
- (2) If the application includes information on geographical origin pursuant to subsection (1) sentence 1, the German Patent and Trade Mark Office notifies this application to the Federal Agency for Nature Conservation 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 (*Gesetz zur Umsetzung der Verpflichtungen nach dem Nagoya-Protokoll und der Durchführung der Verordnung (EU) Nr. 511/2014*) (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 is the date on which the documents referred to in section 34 (3) no. 1 and no. 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. a patent information centre if such 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 invites the applicant to either subsequently file the drawings within one month after service of the invitation or to declare that the reference is to be deemed not to have been made. If the applicant subsequently files the missing drawings or the missing parts

following such invitation, the date on which the German Patent and Trade Mark Office receives the drawings or the missing parts is the date of filing; otherwise the reference to the drawings is deemed not to have been made.

(3) Subsection (2) applies accordingly to any missing parts of the description.

#### **Section 35a**

(1) If the application or part of the application is not in German, the applicant is subsequently to 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 is deemed to be withdrawn.

(2) If the application or part of the application is in English or French, the time limit under subsection (1) sentence 1 is extended to 12 months. If an earlier date is claimed for the application rather than the date of filing, the period under sentence 1, however, ends at the latest after the expiry of a period of 15 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 or she consents to the inspection of the application pursuant to section 31 (2) sentence 1 no. 1, the applicant must submit a German translation of the application documents. Such consent is not regarded as given until the German Patent and Trade Mark Office is in receipt of the translation.

#### **Section 36**

(1) The application must include an abstract, which may be filed subsequently up until the expiry of a period of 15 months from the date of filing or, insofar as an earlier date is claimed to govern the application, up until the expiry of a period of 15 months from that date.

(2) The abstract serves the purpose of technical information only. It must contain:

1. the title of the invention;
2. a concise summary of the disclosure as contained in the application which is, as a rule, to indicate the technical field to which the invention pertains and to 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 is to be enclosed.

Where several drawings are mentioned in the concise summary and it is not clear which drawing, in the applicant's opinion, most clearly characterises the invention, the examining section determines that drawing which most clearly characterises the invention.

#### **Section 37**

(1) Within 15 months after the date of filing or, if an earlier date is claimed to govern the application, within 15 months after that date, the applicant is to designate the inventor or inventors and affirm that, to his or her knowledge, no other persons participated in the invention. Where the applicant is not the inventor or not the sole inventor, the applicant is also to indicate how he or she acquired the right to the patent. The accuracy of the statements made is not verified by the German Patent and Trade Mark Office.

(2) Where the applicant substantiates that he or she was prevented by exceptional circumstances from making the declarations as required by subsection (1) in due time, the German Patent and Trade Mark Office is to grant the applicant 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 is permissible to make amendments to particulars contained in the application as do not extend the subject matter of the application, although up until receipt of the request for examination (section 44) only insofar 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 is to be declared in writing. If the division is declared after the request for examination has been filed (section 44), the separated part is 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 remains applicable to each divisional application.

(2) The same fees are payable for the separated application for the period up until the division is made as were payable for the original application. This does 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 after receipt of the declaration of division or if the fees for the separated application are not paid within this period, the declaration of division is deemed not to have been made.

### **Section 40**

(1) Within a period of 12 months from the date of filing of an earlier patent or utility model application with the German Patent and Trade Mark Office the applicant enjoys 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 after the date of filing of the later application; the declaration of priority is 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 is deemed to be withdrawn when the declaration of priority is made in accordance with subsection (4). This does 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 adds 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 is to indicate the date, country and file number of the earlier application before the expiry of a period of 16 months from the date of priority and to 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 is 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, insofar 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) applies.

#### **Section 42**

(1) If the application obviously does not meet the requirements of sections 34, 36, 37 and 38, the examining section invites the applicant to correct the deficiencies within a specific time limit. If the application does not comply with 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 up 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 under section 1a (1), section 2 or section 2a (1),

the examining section communicates this to the applicant, citing the reasons, and invites him or her to comment within a specific time limit.

(3) The examining section refuses 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 or she is first to be given the opportunity to comment within a specific time limit.

#### **Section 43**

(1) Upon request, the German Patent and Trade Mark Office conducts a search regarding the state of the art which is to be given due consideration in respect of the assessment of the patentability of the invention filed and performs a preliminary assessment of the patentability of the invention filed in accordance with sections 1 to 5 and whether the application meets the requirements of 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 conducted 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 must be submitted in writing. Section 25 applies accordingly.

(3) Receipt of the request is published in the Patent Gazette, although not before the information has been published pursuant to section 32 (5). Any person is 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 is 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 informs 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 is refunded.

(5) If a request under subsection (1) has been received, later requests are deemed not to have been filed. Subsection (4) sentences 2 and 3 applies accordingly.

(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 of section 34 (5), it conducts 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 communicates 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 publishes, in the Patent Gazette, the fact that this communication has been made. No legal remedy is 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) sentence 2, this is 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 is 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 in full or for specific technical subject areas or for specific languages, provided that such entity 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 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) Upon request, the German Patent and Trade Mark Office examines whether the application meets the requirements of sections 34, 37 and 38 and whether the subject matter of the application is patentable under 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, up 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 expires at the latest after the expiry of a period of seven years after 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 is communicated to the applicant. In all other cases, section 43 (2) sentences 2 and 3, and (3) and (5) applies accordingly.

(4) If, following communication to the applicant (subsection (3) sentence 2), the request filed by the third party is deemed to be ineffective, the German Patent and Trade Mark Office communicates 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 or herself 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 the applicant does not file the request, a notice is 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 is continued even if the request for examination is withdrawn. In the case referred to in subsection (4) sentence 2, the procedure is 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 of sections 34, 37 and 38 or if the requirements of section 36 are obviously not fulfilled, the examining section invites the applicant to correct the deficiencies within a specific time limit. Sentence 1 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 under sections 1 to 5, it communicates this to the patent applicant, citing the reasons, and invites the patent applicant 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. Section 128a and section 284 (2) and (3) of the Code of Civil Procedure apply accordingly. The applicant is to be heard, upon request, before the decision is taken on the grant of the patent. The request must be submitted in writing. If the request is not submitted in the requisite form, the examining section refuses the request. The decision to refuse the request is not independently contestable.
- (2) Minutes are to be drawn up of the hearings and of the taking of evidence which are to contain the essentials of the proceedings and the relevant statements made by the parties. Sections 160a, 162 and 163 of the Code of Civil Procedure apply accordingly. The parties receive a copy of the minutes.

#### **Section 47**

- (1) The decisions of the examining section are to be reasoned and a copy served on the parties ex officio; the copy need not be certified. Execution copies are made only upon application by one of the persons concerned and only in paper form. The decisions may also be delivered at the end of a hearing; sentences 1 and 2 remain unaffected. The decision need not be reasoned if only the applicant is party to the proceedings and the request is granted.
- (2) Upon service of the decision, the parties are also to be instructed about the appeal which is available from the decision, about the authority with which the appeal is to be filed, the time limit for filing of the 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 sentence 1. If the instruction has not been given or was given incorrectly, filing of the appeal is only 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 applies accordingly.

#### **Section 48**

The examining section refuses 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 under sections 1 to 5. Section 42 (3) sentence 2 applies.

#### **Section 49**

- (1) If the application meets the requirements of 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 under sections 1 to 5, the examining section decides to grant the patent.
- (2) Upon the request of the applicant, the decision to grant the patent is suspended until the expiry of a period of 15 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 a patent applies for supplementary protection, the Patent Division examines whether the application complies with the relevant Regulation of the European Communities and with subsection (5) and section 16a.

(2) If the application meets these requirements, the Patent Division issues the supplementary protection certificate for the duration of its term. Otherwise, it invites 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 takes a decision to refuse the application.

(3) Where a Regulation of the European Communities provides for the extension of the term of a supplementary protection certificate, subsections (1) and (2) apply accordingly.

(4) The Patent Division takes 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 putting the invention into circulation is incorrect;

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

(5) Section 34 (6) applies. Sections 46 and 47 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 orders ex officio that no publication at all be made. The competent highest federal authority is to be consulted before the order is issued. It may apply for the issue of an order.

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

(3) The examining section informs 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 under subsection (1) or cancelling an order under subsection (1).

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

### **Section 51**

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

2. contravenes a condition imposed in accordance with subsection (1) sentence 2

incurs a penalty of a term of imprisonment of 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 after the invention is filed with the German Patent and Trade Mark Office, the applicant and any other person who has learned of the invention, insofar 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 whether no publication at all is to 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 is to be served on the applicant within the time limit referred to in subsection (1).

#### **Section 54**

If a patent has been granted based on an application for which an order was issued in accordance with section 50 (1), the patent is entered in a separate Register. Section 31 (5) sentence 1 applies accordingly to inspection of the separate Register.

#### **Section 55**

(1) Applicants, proprietors of a patent or their successor in title who refrain from using an invention which is patentable under sections 1 to 5 for peaceful purposes having regard to an order issued in accordance with section 50 (1) are entitled to compensation from the Federal Republic of Germany for pecuniary loss arising therefrom if and insofar as they cannot be reasonably expected to carry the cost of the damage themselves. When assessing reasonableness, account is in particular to be taken of the economic situation of the party suffering damage, the amount of the expenses for the invention or for acquiring rights in the invention, the level of probability of the need to keep the invention secret discernible 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 is to be asserted before the competent highest federal authority. An appeal may be lodged with the ordinary courts.

(3) Compensation pursuant to subsection (1) is 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 was not already 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 is 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 a patent is published in the Patent Gazette. The patent specification is published at the same time. The legal effects of the patent ensue upon publication in the Patent Gazette.

(2) If the application is withdrawn or refused after publication of information about the possibility of inspecting the files (section 32 (5)) or if it is deemed to be withdrawn, the effect referred to in section 33 (1) is 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 is deemed to be withdrawn.

#### **Section 59**

(1) Within nine months after publication of the grant of a patent any person may give notice of opposition to the patent, in the case of usurpation only the aggrieved party. Notice of opposition is to 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 must be detailed. The particulars, insofar as they have not already been included in the notice of opposition, are to be submitted in writing within the opposition period.

(2) Where a notice of opposition to a patent has been given, any third party who can prove that an action has been brought against them 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 they give notice of intervention within three months after the date on which the action claiming the infringement was filed. The same applies 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, they instituted proceedings for a ruling that they are not infringing the patent. The notice of intervention is to be declared in writing and reasoned within the time limit referred to in sentence 1. Subsection (1) sentences 3 to 5 applies accordingly.

(3) A hearing is held in the opposition proceedings upon the request of a party or if the Patent Division deems this to be expedient. When issuing the summons, the Patent Division is, as a rule, to 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, is public. Section 169 (1) sentence 2 and sections 171b to 175 of the Courts Constitution Act (*Gerichtsverfassungsgesetz*) apply accordingly, 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 ensures that order is maintained during the hearing and thus exercises domestic authority.

(5) In all other cases, section 43 (3) sentence 2 and sections 46 and 47 apply accordingly in the opposition proceedings.

## **Section 60 (repealed)**

## **Section 61**

(1) The Patent Division gives its decision by order. In the case of an admissible opposition, the Patent Division gives a decision as to whether and to what extent the patent is to be maintained or revoked. If the opponent withdraws the opposition, the proceedings continue ex officio without the opponent. In derogation from sentence 3, the proceedings are concluded if the opposition which has been withdrawn was exclusively based on the ground for revocation of usurpation pursuant to section 21 (1) no. 3. In such cases, or if the proceedings on the merits have been disposed of, the conclusion of the proceedings is determined by order.

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

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

2. at the request of only one party, if at least 15 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 giving notice of intervention.

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

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

(4) If the patent is maintained with limitations, the patent specification is to be amended accordingly. The amendment to the specification of the patent is to 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 is to 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, insofar as they were necessary to ensure appropriate safeguarding of the claims and rights. The amount of the costs to be reimbursed is 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) apply accordingly. The appeal from the order assessing the costs is available instead of the legal remedy provided for under the Code of Civil Procedure (*Erinnerung*); section 73 applies, with the proviso that the appeal must be lodged within two weeks. The enforceable execution copy is issued by the registry clerk of the Federal Patent Court.

### **Section 63**

(1) The first publication of the application (section 32 (2)), of the patent specification (section 32 (3)) and the publication of the grant of the patent (section 58 (1)) are to mention the inventor by name and place, provided that the inventor has already been designated. Such mention by name and place is to be noted in the Register (section 30 (1)). No mention by name and place or by place is made if the inventor designated by the applicant so requests. The request may be withdrawn at any time; in the event of withdrawal, the inventor is subsequently mentioned. The inventor's waiver of the right to be mentioned is without legal effect.

(2) If the inventor has been designated wrongfully or, in the case set out in subsection (1) sentence 3, has not been designated at all, the patent applicant or the proprietor of the patent and the person who has been wrongfully designated is 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) sentences 1 and 2 being corrected or subsequently made. This consent cannot be withdrawn. The proceedings for the grant of a patent are not delayed on account of the filing of an action for declaration of consent.

(3) The inventor is not subsequently mentioned (subsection (1) sentence 4 and (2)) or the correction is not made (subsection (2)) in official documents which have already been published.

(4) The Federal Ministry of Justice and Consumer Protection is authorised to issue, by statutory instrument, 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 a patent, the patent may be revoked or may be limited with retroactive effect by amending the patent claims.

(2) The request must be filed in writing and reasoned.

(3) The Patent Division takes a decision on the request. Section 44 (1) and sections 45 to 48 apply accordingly. If the patent is revoked, this is published in the Patent Gazette. If the patent is limited, the specification of the patent is to be adapted in respect of the limitation in the decision to grant the request; the amendment to the specification of the patent is to be published.

## **Division 4 Federal Patent Court**

### **Section 65**

(1) The Federal Patent Court is to 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 is at the seat of the German Patent and Trade Mark Office. Its German designation is '*Bundespatentgericht*'.

(2) The Federal Patent Court is 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) applies accordingly to the technically qualified members, with the proviso that they must have passed a state or academic final examination.

(3) The judges are 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 are to 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 for the revocation of patents and in compulsory licence proceedings (Nullity Boards).

(2) The Federal Minister of Justice and Consumer Protection determines the number of boards.

### **Section 67**

(1) When taking their decisions the Boards of Appeal 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) 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 must be a legally qualified member.

### **Section 68**

The provisions of Title 2 of the Courts Constitution Act apply accordingly 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 is deemed to be elected.
2. A Board of Appeal at the Federal Patent Court sitting in a composition of three legally qualified judges decides on a challenge to a vote (section 21b (6) of the Courts Constitution Act).
3. The Federal Minister of Justice and Consumer Protection appoints the President's permanent deputy.

### **Section 69**

(1) Proceedings before the Boards of Appeal are 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 apply accordingly, 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 while the decisions are delivered up until publication of information about the possibility of inspecting the files in accordance with section 32 (5) or up until publication of the patent specification in accordance with section 58 (1).

(2) Proceedings before the Nullity Boards, including the delivery of decisions, are public. Subsection (1) sentence 2 no. 1 applies accordingly.

(3) The presiding judge is 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 apply accordingly.

### **Section 70**

(1) The Boards of Appeal 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 employed at the Federal Patent Court as part 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 take their decisions by majority vote; in the case of a tied vote the vote of the presiding judge prevails.

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

### **Section 71**

(1) Judges by commission may be used at the Federal Patent Court. Section 65 (2) sentence 3 applies.

(2) Judges by commission and judges on secondment cannot preside over the court.

### **Section 72**

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

## **Division 5**

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

#### **1. Appeal proceedings**

##### **Section 73**

(1) An appeal (*Beschwerde*) may be filed from the decisions of the examining sections and Patent Divisions.

(2) The appeal is to be filed in writing with the German Patent and Trade Mark Office within one month after service of the decision. Copies for the other parties are, as a rule, to be enclosed with the appeal and all written pleadings. The appeal and all written pleadings containing substantive motions or a declaration of withdrawal of the appeal or of a motion are to be served on the other parties ex officio; other written pleadings are to be informally communicated to them, unless service is ordered.

(3) If the unit whose decision is contested considers the appeal to be well-founded, it is to 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 is to 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, subsection (3) sentence 1 does not apply.

##### **Section 74**

(1) The parties to proceedings before the German Patent and Trade Mark Office are 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 is also entitled to appeal.

##### **Section 75**

(1) The appeal has suspensive effect.

(2) The appeal does not, however, 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 or she 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 are to 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 becomes a party.

##### **Section 78**

Oral proceedings 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 is 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 is 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 German Patent and Trade Mark 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 also bases 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, insofar 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 or she 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) also apply if the appeal, the application or the opposition is withdrawn in full or in part or the patent is surrendered.

(5) In all other cases, 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) apply accordingly.

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

### **Section 81**

(1) Proceedings for the revocation of a patent or invalidity of a supplementary protection certificate, or on account of the grant or withdrawal of a compulsory licence, or on account of the adjustment of the remuneration for a compulsory licence determined by court judgment are initiated by way of action. The action is to 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 a supplementary protection certificate cannot be filed insofar 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 is entitled to file an action.

(4) The action must be filed in writing with the Federal Patent Court. Copies for the opposing party are, as a rule, to be enclosed with the action and all written pleadings. The notice of action and all written pleadings are to be served on the opposing party ex officio.

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

within a specific time limit. The court file number of patent litigation relating to the patent at issue and its value in dispute are, as a rule, to be indicated.

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

### **Section 82**

(1) The Federal Patent Court without delay serves the action on the defendant and invites him or her 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 proved.

(3) If the defendant objects in due time, the Federal Patent Court communicates the objection to the claimant. The defendant may substantiate the objection within two months following service of the action. The presiding judge may, upon request, extend the time limit by up to one month if the defendant submits substantial grounds therefor. These must be substantiated. Section 81 (5) sentence 3 applies accordingly, unless the information concerned can already be taken from the action.

(4) The presiding judge schedules oral proceedings at the earliest possible date. Oral proceedings may be dispensed with upon agreement of the parties. Subsection (2) remains unaffected.

### **Section 83**

(1) In proceedings for the revocation of a patent or of invalidity of a supplementary protection certificate the Federal Patent Court indicates 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. Such indication is, as a rule, to be made within six months following service of the action. Where patent litigation is pending, the indication is, as a rule, also to be made ex officio to the other court. The Federal Patent Court may, in preparation for the indication to be made in accordance with sentence 1, set the parties a time limit for final written submissions. If the Federal Patent Court does not set a time limit, the indication may not be made before the expiry of the time limit under section 82 (3) sentences 2 and 3. The Federal Patent Court is not bound to take into consideration any submissions made by the parties which are received following expiry of the time limit. No indication as required by sentence 1 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 applies in addition.

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

(3) The competence 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 or her.

(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 necessitate postponing 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 excuse must be substantiated.

#### **Section 84**

(1) A decision on the action is taken by judgment. An interlocutory judgment may be issued on the admissibility of the action.

(2) The judgment is also to include a decision on the costs of the proceedings. The provisions of the Code of Civil Procedure in respect of legal costs apply accordingly, unless equity requires that another decision be taken; 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 apply accordingly. Section 99 (2) remains unaffected.

#### **Section 85**

(1) In proceedings for the grant of a compulsory licence the claimant may, at his or her request, be permitted to use the invention on the basis of an injunction if he or she 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 on account of the imminent threat of disadvantages arising for the party opposing the request.

(3) The Federal Patent Court takes its decision on the basis of oral proceedings. The provisions of section 82 (4) sentence 2 and section 84 apply accordingly.

(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 ceases; a decision on costs may be amended if a party applies for the amendment within one month after the withdrawal or rejection has become effective.

(5) If the ordering of the injunction proves unjustified from the outset, the person making the request is obliged to compensate the party opposing the request for any damage which he or she suffered on account of 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 is obliged to compensate the damage which the party opposing the request suffered on account of enforcement.

#### **Section 85a**

(1) Procedures pursuant to Article 5 (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, 9.6.2006, p. 1) are initiated by way of action in accordance with section 81 (1) sentence 1.

(2) Sections 81 to 85 apply accordingly, unless the proceedings are 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 apply accordingly to the exclusion of and objection to court personnel.

(2) The following are also 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 the revocation of a 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 which the judge objected to is a member decides 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 takes the decision.

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

### **Section 87**

(1) The Federal Patent Court examines the facts ex officio. It is not 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 the presiding judge is to issue all orders which are necessary to dispose of the matter in oral proceedings or in one session if at all possible. In all other cases, section 273 (2), (3) sentence 1 and (4) sentence 1 of the Code of Civil Procedure applies accordingly.

### **Section 88**

(1) The Federal Patent Court takes 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 evidence taken by one of its members as judge by commission or request another court to take evidence by designating the individual questions regarding which evidence is to be taken.

(3) The parties are informed of all of the 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 decides.

### **Section 89**

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

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

### **Section 90**

(1) The presiding judge opens and conducts the oral proceedings.

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

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

### **Section 91**

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

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

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

### **Section 92**

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

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

### **Section 93**

- (1) The Federal Patent Court decides according to its independent conviction gained as an overall result of the proceedings. The decision must state the grounds by which the judges were guided in coming to their conviction.
- (2) The decision may be based only on facts and the 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 are delivered at the session at which the oral proceedings were closed or at a session which is to be scheduled immediately. This session is, as a rule, to be scheduled for no more than three weeks later, unless important grounds so require, in particular the extent or the complexity of the case. The final decisions are to be notified to the parties ex officio. Notification of the final decision is permitted in lieu of delivery. If the Federal Patent Court takes its decision without oral proceedings, delivery is 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 are to be reasoned.

### **Section 95**

- (1) Errors of transcription, miscalculations and similar obvious mistakes in the decision are to 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 is 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 after service of the decision.
- (2) The Federal Patent Court issues a decision by order without taking evidence. Only that judge is involved who participated in the decision whose correction has been requested. The order for correction is noted in the decision and execution copies.

### **Section 97**

- (1) The parties may pursue proceedings before the Federal Patent Court themselves. Section 25 remains unaffected.
- (2) The parties may be represented by a lawyer or patent attorney as agent. In addition, only the following may be authorised 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 Stock Corporation 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 act through their organs and persons appointed to represent them in proceedings.

- (3) The court refuses, by final order, those agents who are not authorised to represent in accordance with subsection (2). Procedural acts by an agent who is not authorised to represent and notifications or communications to such agent are effective until the agent is

refused. The court may, by final order, refuse the agents designated in subsection (2) sentence 2 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 power of agency is to 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 power of agency may be asserted at any stage of the proceedings. The Federal Patent Court is to give due consideration to the deficiencies of the power of agency ex officio, unless a lawyer or a patent attorney is acting as agent.

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

#### **Section 99**

(1) Unless this Act contains provisions in respect of proceedings before the Federal Patent Court, the Courts Constitution Act and the Code of Civil Procedure apply accordingly if this is not precluded by the special characteristics of the proceedings before the Federal Patent Court.

(2) The decisions of the Federal Patent Court are contestable only insofar as this is permitted under this Act.

(3) Section 31 applies accordingly in respect of the grant of inspection of the files to third persons. The Federal Patent Court decides on the request. Inspection of the files in proceedings for the revocation of a patent is not granted if and insofar as the proprietor of the patent demonstrates an interest meriting protection which precludes this.

(4) Section 227 (3) sentence 1 of the Code of Civil Procedure does not apply.

### **Division 6 Proceedings before Federal Court of Justice**

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

#### **Section 100**

(1) An appeal on points of law (*Rechtsbeschwerde*) 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 is to 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) An appeal on points of law from the orders of the Boards of Appeal at the Federal Patent Court need not be allowed 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 of this Act, unless he or she 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) An appeal on points of law is open to the parties to the appeal proceedings.
- (2) An appeal 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 apply accordingly.

#### **Section 102**

- (1) The appeal on points of law is to be filed in writing with the Federal Court of Justice within one month after service of the order.
- (2) The provisions of section 144 on the fixing of the value in dispute apply accordingly in proceedings on the appeal on points of law before the Federal Court of Justice.
- (3) The appeal on points of law is to be reasoned. The time limit for submission of the grounds is one month; this period begins 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 must contain the following:
  1. a declaration as to the extent to which the decision is being contested and its amendment or setting aside is being requested;
  2. an 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, a description of the facts which result in the defect.
- (5) The parties must 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, their patent attorney is to be permitted to speak. Section 143 (3) applies accordingly.

#### **Section 103**

An appeal on points of law has suspensive effect. Section 75 (2) applies accordingly.

#### **Section 104**

The Federal Court of Justice is to examine ex officio whether the appeal on points of 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 points of law is to 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 are to be served on the other parties and they are to be invited to make any statements in writing to the Federal Court of Justice within a specific time limit following service. The date on which the appeal on points of law was filed is to be communicated when the notice of appeal is served. The appellant is, as a rule, to 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 German Patent and Trade Mark Office is not involved in proceedings on an appeal on points of law, section 76 applies accordingly.

#### **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 apply accordingly in proceedings on an

appeal on points of law. Section 123 (5) to (7) applies accordingly in the case of the re-establishment of rights.

(2) Section 69 (1) applies accordingly to the admission of the public to the proceedings.

#### **Section 107**

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

(2) The Federal Court of Justice is 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 is to be reasoned and notified to the parties ex officio.

#### **Section 108**

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

(2) The Federal Patent Court is also to 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 are to be imposed on the appellant. If a party has caused costs through gross negligence, they are to be imposed on that party.

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

(3) In all other cases, 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 apply accordingly.

### **2. Proceedings on appeals on points of fact and law**

#### **Section 110**

(1) An appeal on points of fact and law (*Berufung*) 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 points of fact and law is 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 points of fact and law is one month. It commences 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 must contain the following:

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

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

(5) The general provisions of the Code of Civil Procedure on preparatory written pleadings apply to the notice of appeal.

(6) An execution copy or a certified copy of the contested judgment is, as a rule, to be submitted together with the notice of appeal.

(7) Orders issued by the Nullity Boards are contestable only together with their judgments (section 84); section 71 (3) of the Code of Civil Procedure does not apply.

(8) Sections 515, 516 and 521 (1) and (2) sentence 1 of the Code of Civil Procedure apply accordingly.

### **Section 111**

- (1) An appeal on points of 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 is always 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 or she 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 or she 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 appellant must state the grounds for the appeal.
- (2) The grounds of appeal are to be filed in one written pleading with the Federal Court of Justice, unless they were already included in the notice of appeal. The time limit for the submission of the grounds of appeal is three months. It commences 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 appellant demonstrates substantial grounds. If it is not possible within this time limit to grant file inspection for an appropriate time to the appellant, the presiding judge may, upon request, extend the period by up to two months after sending the case files.
- (3) The grounds of appeal must contain the following:
1. a declaration as to the extent to which the judgment is being contested and its setting aside is being requested (petitions of appeal on points of fact and law);
  2. the grounds of appeal, namely:
    - a) an indication of the circumstances from which the violation of the law results;
    - b) where the appeal on points of 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) an indication of new means of challenge or defence and the facts on the basis of which the new means of challenge or defence are to be admitted in accordance with section 117.
- (4) Section 110 (5) applies accordingly to the grounds of appeal.

### **Section 113**

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

#### **Section 114**

(1) The Federal Court of Justice examines ex officio whether the appeal on points of 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 points of fact and law is to be rejected as inadmissible.

(2) The decision may be given by order.

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

(4) Section 525 of the Code of Civil Procedure applies accordingly. Sections 348 to 350 of the Code of Civil Procedure do not apply.

#### **Section 115**

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

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

(3) The grounds of cross-appeal must be set out in the notice of cross-appeal. Section 110

(4), (5) and (8), and section 112 (3) applies accordingly.

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

#### **Section 116**

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

(2) An amendment of the action and, in proceedings for the revocation of a patent or invalidity of a supplementary protection certificate, a defence based on an amended version of the patent is 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 is to base its proceedings and decision on the appeal on points of fact and law in accordance with section 117.

#### **Section 117**

Sections 529, 530 and 531 of the Code of Civil Procedure apply accordingly to the extent of the examination by the appellate court and to the means of challenge or defence which were submitted too late, which were rejected and which are new. In this case, section 112 of the Code of Civil Procedure applies instead of section 520.

#### **Section 118**

(1) The Federal Court of Justice gives its judgment on the basis of oral proceedings. Section 69 (2) applies accordingly.

(2) The parties are to be summoned with at least two weeks' notice.

(3) Oral proceedings may be dispensed with if

1. the parties consent, or

2. a decision is only to be taken in respect of the costs.

(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 is 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 points of fact and law is to be rejected.

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

(3) In the event of the judgment being set aside, the case is to 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 is also to 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 on the case if this appears expedient. It is itself to 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 does not apply to notices of defects under section 111 (3).

#### **Section 121**

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

(2) The judgment is also to contain a decision on the costs of the proceedings. The provisions of the Code of Civil Procedure on legal costs (sections 91 to 101) apply accordingly, unless equity requires that a different decision be taken; the provisions of 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) apply accordingly.

### **3. Appeal proceedings**

#### **Section 122**

(1) An appeal (*Beschwerde*) 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) applies accordingly.

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

(3) The time limit for filing of the appeal commences 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 apply accordingly 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 a decision, the proceedings are to 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 is not an available remedy against a decision given prior to the final decision. Section 321a (2) to (5) of the Code of Civil Procedure applies accordingly.

## **Division 7 Common provisions**

### **Section 123**

(1) Any person who, through no fault of their 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 causes a legal disadvantage in accordance with legal provisions, is to have their rights re-established upon request. This does not apply to the time limit

1. for filing an opposition (section 59 (1)) and for paying the opposition fee (section 6 (1) sentence 1 of the Patent Costs Act),
2. for the opponent to file an appeal against maintenance of the patent (section 73 (2)) and to pay the appeal fee (section 6 (1) sentence 1 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 must be requested in writing within two months after removal of the cause of non-compliance. The request must state the facts on which the re-establishment of rights is based; these are to be substantiated when the request is filed or in the proceedings concerning the request. The omitted act is to 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 decides on the request.

(4) The re-establishment of rights is final.

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

(6) Subsection (5) applies accordingly 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 has in Germany in good faith 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) in the period between the expiry of the period of 12 months and the re-entry into force of the right of priority, or has made the necessary preparations for so doing within that period, is entitled in accordance with subsection (5).

### **Section 123a**

(1) Where a patent application has been refused upon failure to comply with a time limit set by the German Patent and Trade Mark Office, the decision becomes 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 is to be filed within one month after service of the decision to refuse the patent application. The omitted act is to be completed within this period.

(3) Re-establishment of rights is 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) sentence 1 of the Patent Costs Act.

(4) The authority competent to decide on the completed act decides 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 are to make their statements on facts and circumstances in full and truthfully.

### **Section 125**

(1) Where the opposition or the action for revocation of a patent is based on the statement that the subject matter of the patent is not patentable under 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) Insofar as the written form is required in proceedings before the German Patent and Trade Mark Office in respect of applications, requests or other acts, the provisions of section 130a (1), (2) sentence 1, (5) and (6) of the Code of Civil Procedure apply accordingly.

(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 apply accordingly in all other cases, unless otherwise provided by this Act.

(3) The Federal Ministry of Justice and Consumer Protection determines, by statutory instrument not requiring the approval of the Bundesrat,

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 is to 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) and 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 is German, unless otherwise provided. In all other cases, the provisions of the Courts Constitution Act on the court language apply.

### **Section 127**

(1) The provisions of the Act on Service in Administrative Procedures (*Verwaltungszustellungsgesetz*) 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 is nevertheless 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 applies to addressees who themselves are representatives in Germany within the meaning of section 25 (2). Section 184 (2) sentences 1 and 4 of the Code of Civil Procedure applies accordingly.

3. Section 5 (4) of the Act on Service in Administrative Procedures applies accordingly to service on holders of a certificate of representation (section 177 of the Federal Code for Patent Attorneys (*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 is to be added to the files. A note is to be made on the document of the date when it was deposited. Service is 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 regulates, by statutory instrument not requiring the approval of the Bundesrat, details concerning those modes of transmission which are suitable pursuant to sentence 1, as well as concerning the form and proof of electronic service.

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

#### **Section 128**

(1) The courts are 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, upon the request of the German Patent and Trade Mark Office, imposes administrative measures and means 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 is to 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 decides on the request in accordance with subsection (2). The decision is given by order.

#### **Section 128a**

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

#### **Section 128b**

The provisions of Title 17 of the Courts Constitution Act apply accordingly to proceedings before the Federal Patent Court and the Federal Court of Justice.

### **Division 8** **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 receives legal aid in accordance with the provisions of sections 130 to 138.

#### **Section 130**

(1) Upon request and applying sections 114 to 116 of the Code of Civil Procedure accordingly, the applicant receives legal aid in the procedure for the grant of a patent if 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 are to be made to the Federal Cash Office.

(2) The grant of legal aid has the effect that the legal consequences stipulated in the event of non-payment do not occur in respect of the fees which form the subject of the legal aid. In all other cases, section 122 (1) of the Code of Civil Procedure applies accordingly.

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

(4) If the applicant or the proprietor of the patent is not the inventor or the inventor's universal successor in title, he or she receives legal aid only if the inventor also fulfils the requirements of 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 (4) of the Code of Civil Procedure. The instalments paid are not to 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. Insofar as the annual renewal fees can be regarded as having been settled by the instalments paid, section 5 (2) of the Patent Costs Act applies accordingly.

(6) In the case referred to in section 44, subsections (1) to (3) apply accordingly to the requesting third party if he or she substantiates an interest of his or her own meriting protection.

### **Section 131**

The provisions of section 130 (1), (2) and (5) apply accordingly to proceedings to limit or revoke a patent (section 64).

### **Section 132**

(1) Upon request and applying sections 114 to 116 of the Code of Civil Procedure and section 130 (1) sentence 2, and (2), (4) and (5) accordingly, the proprietor of the patent receives legal aid in opposition proceedings (sections 59 to 62). No examination is to be conducted as to whether the legal defence offers sufficient prospect of success.

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

### **Section 133**

A party who has been granted legal aid in accordance with the provisions of sections 130 to 132 is, upon request, assigned a patent attorney or lawyer of their choice who is willing to act as their representative or, upon explicit request, a holder of a certificate of representation if the representation appears necessary to appropriately conduct 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 applies accordingly.

### **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 is suspended up until the expiry of a period of one month following service of the decision on the request.

### **Section 135**

(1) A request for the grant of legal aid is to 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 applies accordingly.

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

(3) Decisions issued in accordance with sections 130 to 133 are 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 is ruled out. Section 127 (3) of the Code of Civil Procedure applies accordingly to the proceedings before the Federal Patent Court.

### **Section 136**

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

### **Section 137**

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 such 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 is to inform that authority which took the decision on the grant of legal aid of each commercial exploitation of this invention.

### **Section 138**

- (1) A party is to be granted legal aid in proceedings on an appeal on points of law (section 100) upon request and applying sections 114 to 116 of the Code of Civil Procedure accordingly.
- (2) The request for the grant of legal aid is to 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 decides on the request.
- (3) In all other cases, the provisions of section 130 (2), (3), (5) and (6) and sections 133, 134, 136 and 137 apply accordingly, with the proviso that a party who has been granted legal aid may only be assigned a lawyer who has been admitted to practise before the Federal Court of Justice.

## **Division 9 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. This right is ruled out if asserting it would, based on the particular circumstances of the individual case and the principle of good faith, lead to disproportionate, unjustified hardship for the injurer or third parties which is not justified by the exclusive right. In such cases, the aggrieved party is to be granted reasonable monetary compensation. The claim for compensation under subsection (2) remains unaffected thereby.
- (2) Any person who performs such act intentionally or negligently is 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 the infringer 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 is, until there is proof to the contrary, deemed to have been produced using the patented process. In taking evidence to the contrary, consideration is to be given to the defendant's legitimate interests in protecting his or her 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) sentence 2 clause 2 and (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 is, upon motion by the opposing party, to 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. Sentence 1 also applies 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) applies accordingly 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. Sentence 1 also applies in the case of products which have been produced directly by means of a process which is the subject matter of the patent.
- (4) Claims under subsections (1) to (3) are ruled out if their assertion is disproportionate in an individual case. When examining proportionality, consideration is also to 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 under sentence 1 in judicial proceedings, 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 must provide 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) Claims under subsections (1) and (2) are ruled out if their assertion is disproportionate in an individual case.

(5) If the person obliged to provide the information, while acting intentionally or gross negligently, provides false or incomplete information, then that person is 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) is liable to third parties only if they knew that they were 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 (*Ordnungswidrigkeitengesetz*) 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. 70 of the Telecommunications Act (*Telekommunikationsgesetz*)), a court order regarding the admissibility of the use of the traffic data is first 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 or her residence, principal place of business or an establishment has exclusive jurisdiction, irrespective of the value in dispute. The civil division decides. 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*) apply to the proceedings accordingly. The costs of the court order are borne by the aggrieved party. An appeal from the regional court's decision is an available remedy. The notice of appeal is to be lodged within a time limit of two weeks. The provisions concerning the protection of personal data otherwise remain unaffected.

(10) The basic right to privacy of telecommunications is 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 rightholder or by another entitled person for production of a document or inspection of an item of which he or she has disposal 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 rightholder or another entitled person. Where there is sufficient likelihood of a legal infringement being committed on a commercial scale, the claim extends to the production of bank, financial or commercial documents. If the alleged infringer asserts that the information concerned is confidential, the court takes the measures necessary to ensure the specific protection required in an individual case.

(2) Claims under subsection (1) are ruled out if their assertion 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 takes the measures necessary to ensure the protection of confidential information. This in particular applies to those cases where the injunction is issued without giving a prior hearing to the opposing party.

(4) Section 811 of the Civil Code and section 140b (8) of this Act apply accordingly.

(5) If there was no infringement or no risk of infringement, the alleged infringer may claim compensation for the damage caused to him or her 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 of which the infringer has disposal 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 takes the measures necessary to ensure the specific protection required in an individual case.

(2) The claim under subsection (1) is ruled out if its assertion 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 takes the measures necessary to ensure the protection of confidential information. This in particular applies to those cases where the injunction is issued without giving a prior hearing to the opposing party.

(4) Section 811 of the Civil Code and section 140b (8) of this Act apply accordingly.

#### **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 are laid down in the judgment. The entitlement lapses if it is not used within three months after the judgment becomes final. The pronouncement in accordance with sentence 1 is not provisionally enforceable.

#### **Section 141**

The provisions of Book 1 Division 5 of the Civil Code apply accordingly 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 Civil Code applies accordingly.

#### **Section 141a**

Claims under other statutory provisions remain unaffected.

#### **Section 142**

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

1. manufactures or offers, puts into circulation, uses a product which is the subject matter of the patent or of the supplementary protection certificate (section 9 sentence 2 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 sentence 2 no. 2)

incurs a penalty of a term of imprisonment of no more than three years or a fine. Sentence 1 no. 1 also applies in 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 sentence 2 no. 3).

- (2) Where the offender acts on a commercial scale, the penalty is a term of imprisonment of no more than five years or a fine.
- (3) An attempt is punishable.
- (4) In the cases referred to in subsection (1), the offence is prosecuted upon motion only, unless the criminal prosecution authority considers 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 applies. 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 do not apply.
- (6) Where a penalty is imposed, an order is to 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 is to be laid down in the judgment.
- (7) Insofar as a right to cessation and desistance is ruled out under section 139 (1) sentence 3, the injurer is not punished in accordance with subsection (1), (2) or (3).
- (8) The criminal proceedings are to be suspended in accordance with section 262 (2) of the Code of Criminal Procedure where opposition proceedings or nullity proceedings are pending against the patent at issue.

#### **Section 142a**

- (1) A product which infringes a patent protected under this Act is subject, upon request and security being given by the rightholder, to seizure by the customs authority, on import or export, insofar 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, 29.6.2013, p. 15), as amended. This applies to transactions with other Member States of the European Union and with the Contracting Parties of 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 without delay informs the person entitled to dispose and the person making the request. The origin, quantity and place of storage of the product as well as the name and address of the person entitled to dispose are communicated to the person making the request; the privacy of correspondence and posts (Article 10 of the Basic Law) is thus restricted. The person making the request is 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 referred to in subsection (2) sentence 1, at the latest, the customs authority orders confiscation of the seized product.
  - (4) Where the person entitled to dispose objects to the seizure, the customs authority informs the person making the request thereof without delay. The latter is to declare to the customs authority without delay whether he or she upholds the request under subsection (1) in respect of the seized product.
    - 1. Where the person making the request withdraws the request, the customs authority revokes the seizure without delay.
    - 2. Where the person making the request upholds the request and submits an enforceable court decision ordering the impounding of the seized product or imposing a restraint on disposal, the customs authority takes the necessary measures.
- Where the cases referred to in no. 1 or no. 2 do not apply, the customs authority revokes the seizure after the expiry of a period of two weeks following service of the communication to the person making the request under sentence 1; where the person making the request

proves that they have requested, but not yet received, a court decision in accordance with no. 2, the seizure remains 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) sentence 2), he or she is obliged to compensate the person entitled to disposal for the damage caused by the seizure.

(6) The request under subsection (1) is to be made to the Central Customs Authority and remains in force for one year unless it has been made for a shorter duration; the request may be repeated. The person making the request is charged the costs of official acts connected with it, 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 fines proceedings under the Act on Regulatory Offences. The person making the request is to be heard in appeal proceedings. An immediate appeal (*sofortige Beschwerde*) may be filed from a local court decision; the higher regional court decides on it.

#### **Section 142b**

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

### **Division 10 Patent litigation**

#### **Section 143**

(1) The civil divisions of the regional courts 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* governments are 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*, as a 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*) and the patent attorney's necessary expenses are to 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 their economic situation, the court may, upon motion by that party, order that such party's obligation to pay court costs is to be proportionate to a part of the value in dispute as adjusted to their economic situation. This order has the effect that the beneficiary also has to pay the fees of his or her lawyer only in relation to this part of the value in dispute. Insofar as the costs of the proceedings are imposed on such party or the latter assumes these costs, the party is to reimburse the court costs paid by the opposing party and the fees of their lawyer only in relation to the part of the value in dispute. Where the extrajudicial costs are imposed on the opposing party or are assumed by that party, the beneficiary's lawyer may recover his or her fees from the opposing party in relation to such value in dispute as applies to the latter.

(2) The motion referred to in subsection (1) may be declared before and recorded with the court registry. It is to be made before the court hearing on the merits. Thereafter it is admissible only where the court subsequently increases the presumed or assessed value in dispute. The opposing party is to 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 they were, through no fault of their own, not in a position to also assert this patent in earlier proceedings.

### **Section 145a**

In patent litigation, with the exception of the independent taking of evidence and in compulsory licence proceedings pursuant to section 81 (1) sentence 1, sections 16 to 20 of the Act on the Protection of Trade Secrets of 18 April 2019 (*Gesetz zum Schutz von Geschäftsgeheimnissen vom 18. April 2019*) (Federal Law Gazette I, p. 466) apply accordingly. 'Information relating to the matter in dispute' within the meaning of section 16 (1) of the Act on the Protection of Trade Secrets means all the information introduced into the proceedings by the claimant and the defendant.

## **Division 11 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 is obliged, on demand, 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.

## **Division 12 Transitional provisions**

### **Section 147**

(1) Article 229 section 6 of the Introductory Act to the German Civil Code (*Einführungsgesetz zum Bürgerlichen Gesetzbuche*) applies accordingly, with the proviso that section 33 (3) and section 141 in the version in force until 1 January 2002 are to be treated as equivalent to the provisions of the 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 17 August 2021 continue to apply in respect of proceedings for the revocation of a patent or invalidity of a 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 18 August 2021.

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

(4) In respect of requests for the extension of the time limit for the designation of the inventor, section 37 (2) sentences 2 to 4 and section 20 (1) no. 2 of this Act in the version in force before 1 April 2014 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 in force until that time continues to apply.