

German Patent Law

(last amended by the Laws of July 16 and August 6, 1998)

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Part I**The Patent**

§1.-(1) Patents shall be granted for inventions that are new, involve an inventive step and are susceptible of industrial application.

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

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

(3) The provisions of subsection (2) shall exclude patentability only to the extent to which protection is sought for the above-mentioned subject matter or activities as such.

2. Patents shall not be granted in respect of:

1. inventions the publication or exploitation of which would be contrary to public policy or morality, provided that the exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation. The first sentence above shall not exclude the granting of a patent for an invention falling under Section 50(1);
2. plant or animal varieties or essentially biological processes for the production of plants or animals. This provision shall not apply to microbiological processes or the products thereof.

[Amended by Law of March 27, 1992]

§3.-(1) An invention shall be considered to be new if it does not form part of the state of the art. The state of the art comprises all knowledge made available to the public by means of a written or oral description, by use or in any other way, before the date relevant for the priority of the application.

(2) Additionally, the content of the following patent applications, which have an earlier priority and which were published only on or after the date relevant for the priority of the later application, shall be considered to be comprised in the state of the art:

1. national applications, as originally filed with the German Patent Office;
2. European applications, as originally filed with the competent authority, in which protection is sought in the Federal Republic of Germany and for which the designation fee for the Federal Republic of Germany has been paid in accordance with Article 79(2) of the European Patent Convention, unless the application for a European patent is based on an international application and does not fulfill the conditions set out in Article 158(2) of the European Patent Convention;
3. international applications under the Patent Cooperation Treaty, as originally filed with the receiving Office, where the German Patent Office is the designated Office with respect to the application.

If the earlier priority of an application is based on a claim to the priority of an earlier application, the first sentence of the present subsection shall be applicable only to the extent that the contents of the application in question do not go beyond the contents of the earlier application. Patent applications under item 1 of the first sentence of the present subsection which have been subject to a decision under Section 50(1) or (4) of the Patent Law shall be considered to have been made available to the public on expiry of the 18th month following their filing.

(3) The provisions of subsections (1) and (2) shall not exclude from patentability any substance or composition comprised in the state of the art where it is intended for use in a method referred to in Section 5(2) and its use for such method is not comprised in the state of the art.

(4) For the application of subsections (1) and (2), disclosure of the invention shall not be 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 his legal predecessor or
2. the fact that the applicant or his legal predecessor has displayed the invention at an official or officially recognized international exhibition falling within the terms of the Convention on International Exhibitions signed at Paris on November 22, 1928.

Item 2 of the first sentence of the present subsection shall apply only if the applicant states, when filing the application, that the invention has been so displayed and files a supporting certificate within four months following the filing. The exhibitions referred to in item 2 of the first sentence of the present subsection shall be notified by the Federal Minister for Justice in the Federal Law Gazette [Bundesgesetzblatt].

[Amended by Law of July 16, 1998]

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

§5.-(1) An invention shall be considered susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

(2) Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practiced on the human or animal body shall not be regarded as inventions which are susceptible of industrial application within the meaning of subsection (1). This provision shall not apply to products, in particular substances or compositions, for use in any of these methods.

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

§7.-(1) To avoid the substantive examination of the patent application being delayed due to the need to determine the identity of the inventor, the applicant shall be deemed in the proceedings before the Patent Office to be entitled to request grant of a patent.

(2) If a patent is revoked by reason of opposition based on usurpation (Section 21(1)3) or if opposition results in the withdrawal of the patent, the opponent may himself file an application in respect of the invention, within one month after the official notification thereof, and claim the priority of the earlier patent.

§8.-An entitled person whose invention has been applied for by a person not so entitled may require the patent applicant to surrender to him the right to the grant of a patent. If the application has already resulted in a patent, he may require the patentee to assign the patent to him. Such right may only be asserted by an action at law within two years after publication of the grant of the patent (Section 58(1)), subject to the fourth and fifth sentences. If the injured person has filed opposition on the grounds of usurpation (Section 21(1)3), he may bring an action within one year of the final conclusion of the opposition proceedings. The third and fourth sentences shall not apply if the patentee had not acted in good faith in obtaining the patent.

§9.-A patent shall have the effect that the patentee alone shall be authorized to use the patented invention. A person not having the consent of the patentee shall be prohibited

1. from making, offering, putting on the market or using a product which is the subject matter of the patent or importing or stocking the product for such purposes;
2. from using a process which is the subject matter of the patent or, when he knows or it is obvious from the circumstances that the use of the process is prohibited without the consent of the patentee, from offering the process for use within the territory to which this Law applies;
3. from offering, putting on the market, using or importing or stocking for such purposes the product obtained directly by a process which is the subject matter of the patent.

§10.-(1) A patent shall have the further effect that a person not having the consent of the patentee shall be prohibited from supplying or offering to supply within the territory to which this Law applies a person, other than a person entitled to exploit the patented invention, with means relating to an essential element of such invention for exploiting the invention, where such person knows or it is obvious from the circumstances that such means are suitable and intended for exploiting the invention.

(2) Subsection (1) shall not apply when the means are staple commercial products, except where such person induces the person supplied to commit acts prohibited by the second sentence of Section 9.

(3) Persons performing the acts referred to in Section 11.1 to 3 shall not be considered persons entitled to exploit the invention within the meaning of subsection (1).

§11.-The effects of a patent shall not extend to

1. acts done privately and for non-commercial purposes;
2. acts done for experimental purposes relating to the subject matter of the patented invention;
3. the extemporaneous preparation for individual cases in a pharmacy of a medicine in accordance with a medical prescription or acts concerning the medicine so prepared;
4. the use on board vessels of another State party to the Paris Convention for the Protection of Industrial Property of the patented invention, in the body of the vessel, in the machinery, tackle, gear and other accessories, where such vessels temporarily or accidentally enter the waters to which the territory of this Law extends on condition that such use serves exclusively the needs of the vessel;
5. the use of the patented invention in the construction or operation of aircraft or land vehicles of another State party to the Paris Convention for the Protection of Industrial Property or of accessories for such aircraft or land vehicles, where these temporarily or accidentally enter the territory to which this Law applies;
6. the acts specified in Article 27 of the Convention on International Civil Aviation of December 7, 1944, where such acts concern the aircraft of another State to which the provisions of that Article are applicable.

§12.-(1) A patent shall have no effect against a person who, at the time of the filing of the application, had already begun to use the invention in Germany, or had made the necessary arrangements for so doing. Such person shall be entitled to use the invention for the needs of his own business in his own plant or workshops or the plant or workshops of others. This right can only be inherited or transferred together with the business. If the applicant or his predecessor in title has, before applying for a patent, disclosed the invention to other persons and reserved his rights in the event of a patent being granted, a person learning of the invention as a result of such disclosure cannot, under the provisions under the first sentence, invoke measures which he has taken within six months after the disclosure.

(2) If the patentee is entitled to a right of priority, the date of the prior application shall be substituted for the date of the application referred to in subsection (1). However, this provision shall not apply to nationals of a foreign country which does not guarantee reciprocity in this respect, where they claim the priority of a foreign application.

§13.-(1) A patent shall have no effect where the Federal Government orders that the invention be exploited in the interest of public welfare. Nor shall the effect of a patent extend to any exploitation of the invention which is ordered in the interests of the security of the Federal Republic by the appropriate supreme federal authority or, on the latter's instructions, by a subordinate agency.

(2) Appeals from orders under subsection (1) shall be heard by the Federal Administrative Court where such orders have been made by the Federal Government or the appropriate supreme federal authority.

(3) In the cases mentioned in subsection (1), the patentee shall have a claim against the Federal Republic for reasonable compensation. In the event of dispute as to its amount, legal action may be brought before the ordinary civil courts. Any order by the Federal Government under the first sentence of subsection (1) shall be communicated to the person recorded as patentee in the Register (Section 30(1)) before the invention is exploited. If the supreme federal authority by which an order or an instruction under the second sentence of subsection (1) is issued learns that a claim for compensation has arisen under the first sentence, it shall give notice thereof to the person recorded in the Register as patentee.

§14.-The extent of the protection conferred by a patent or a patent application shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims.

§15.-(1) The right to a patent, the right to the grant of a patent and the rights deriving from a patent shall pass to the heirs. They may be assigned to others with or without restrictions.

(2) The rights under subsection (1) may be licensed in whole or in part, exclusively or non-exclusively, for the whole or part of the territory to which this Law applies. Where a licensee contravenes a restriction of his license covered by the first sentence, the right conferred by the patent may be invoked against him.

(3) The assignment of rights or the granting of a license shall not affect licenses previously granted to other persons.

[Amended by Law of August 15, 1986]

§16.-(1) The duration of a patent shall be 20 years, beginning on the day following the filing of the application in respect of the invention. If the purpose of an invention is the improvement or further development of another invention for which the applicant has already secured patent protection, he may apply, within 18 months from the date of filing of the application or, insofar as an earlier date is claimed as relevant for the application, from that date, for a patent of addition, which shall expire at the same time as the patent for the earlier invention.

(2) If the main patent lapses due to revocation, declaration of nullity or abandonment, the patent of addition shall become an independent patent; its duration shall be determined by the date of commencement of the main patent. Where there are several patents of addition, only the first shall become independent; the others shall be deemed patents of addition to that patent.

[Amended by Law of July 16, 1998]

§16a.-(1) Pursuant to Regulations of the European Economic Community concerning the creation of supplementary certificates of protection, which shall be notified in the Federal Law Gazette, supplementary protection may be requested in respect of a patent, that shall follow on immediately from the expiry of the term of the patent under Section 16(1). Annual fees shall be paid for supplementary protection in accordance with the schedule of fees.

(2) Unless otherwise provided by the law of the European Communities, the provisions of the Patent Law concerning entitlement of the applicant (Sections 6 to 8), effects of the patent and exceptions thereto (Sections 9 to 12), order to exploit the patent, compulsory license and forfeiture (Sections 13, 24), extent of protection (Section 14), licenses and their registration (Sections 15, 30), fees (Sections 17(2) to (6), 18 and 19), lapse of the patent (Section 20), nullity (Section 22), preparedness to grant licenses (Section 23), domestic representative (Section 25), the Patent Court and proceedings before the Patent Court (Sections 65 to 99), proceedings before the Federal Court of Justice (Sections 100 to 122), reinstatement (Section 123), obligation of truth (Section 124), official language, service of documents and legal aid (Sections 126 to 128), infringement (Sections 139 to 141 and 142a), joining of actions and advertising of patent (Sections 145 and 146) shall apply *mutatis mutandis* to supplementary protection.

(3) Licenses and declarations under Section 23 of the Patent Law which are effective for a patent shall also apply to supplementary protection.

[Added by Law of March 23, 1993 and amended by Law of July 16, 1998]

§17.-(1) There shall be paid in respect of every application and every patent an annual fee, as prescribed in the schedule of fees for the third year and each subsequent year following the date of filing.

(2) No annual fees shall be payable for a patent of addition (second sentence of Section 16(1)). If a patent of addition is converted to an independent patent, it shall become subject to the payment of fees; the due date and the annual amount shall be determined by the date of commencement of the preceding main patent. The first sentence and the first half of the second sentence shall apply *mutatis mutandis* to an application for a patent of addition with the proviso that, where an application for a patent of addition is regarded as an application for an independent patent, such annual fees shall be payable as are due for an application that is independent from the beginning.

(3) Annual fees in respect of the coming year shall be due on the last day of the month bearing the same name as the month containing the anniversary of the date of the application. If an annual fee has not been paid by the end of the last day of the second month after the due date, the surcharge prescribed in the schedule of fees shall become due. After the expiration of the time limit, the Patent Office shall notify the applicant or patentee that the application will be deemed to have been withdrawn (Section 58(3)) or that the patent will lapse (Section 20(1)) if the fee and the surcharge prescribed in the schedule of fees are not paid before the expiration of a period of four months from the end of the month in which the notification has been served.

(4) The Patent Office may postpone dispatch of the notification at the request of the applicant or patentee on proof being furnished by the latter that payment may not reasonably be expected of him at present due to his financial situation. Postponement may be made conditional upon payment of installments within specified periods. If an installment is not paid in due time, the Patent Office shall advise the applicant or patentee that the application will be deemed to have been withdrawn or that the patent will lapse if the balance is not paid within one month after service of the notification.

(5) Where no request has been made to postpone dispatch of the notification, the due date of the fee and the surcharge may be deferred on proof being furnished that payment may not reasonably be expected of the applicant or the patentee at present due to his financial situation, even after service of the notification, provided that a request is made within 14 days after service and the previous failure to comply is satisfactorily explained. Deferment may also be authorized subject to the payment of installments. If a deferred sum is not paid in due time, the Patent Office shall repeat the notification, whereby the whole of the balance outstanding shall be demanded. After service of the second notification, no further deferment shall be allowed.

(6) A notification which has been postponed on request (subsection (4)) or which, after deferment has been granted, must be repeated (subsection (5)) shall be dispatched not later than two years after the fee falls due. Installments paid shall not be refunded if, owing to nonpayment of the balance outstanding, the application is deemed to have been withdrawn (Section 58(3)) or the patent lapses (Section 20(1)).

[Amended by Law of July 16, 1998]

§18.-(1) If an applicant or patentee furnishes proof that the payment may not reasonably be expected of him at present due to his financial situation, payment of the fees for the grant and for the third to 12th years may be deferred, at his request, until the commencement of the 13th year and may be waived if the patent application is withdrawn or the patent lapses within the first 13 years. The patent applicant or patentee shall immediately inform the Patent Office of any alteration in his personal and economic circumstances relevant to the deferral.

(2) If a patent has been granted or maintained after opposition, an order may be made in favor of an applicant that the reasonable expenses for drawings, models and expert opinions, the production of which was necessary in the grant proceedings or opposition proceedings, be refunded to him as outlay if he furnishes proof that payment of such expenses may not reasonably be expected of him at present due to his financial situation. The request for refund must be submitted to the Patent Office within six months after the grant of the patent; if opposition is brought, it must be filed within six months after the maintenance of the patent. The refund shall be recorded in the Register (Section 30(1)). If later circumstances seem so to justify, the Patent Office shall order the sum refunded to be repaid in whole or in part. Repayments shall be added as a supplement to the annual fees and treated as part thereof.

§19.-Annual fees may be paid before they fall due. Fees which have not become due shall be refunded if it is established that they will no longer become due.

§20.-(1) A patent shall lapse if

1. the patentee abandons it by a written declaration to the Patent Office;
2. the declarations prescribed in Section 37(1) are not made in due time after service of the official notification (Section 37(2)); or
3. the annual fee and the surcharge are not paid in due time after service of the official notification (Section 17(3)).

(2) The Patent Office shall be the sole judge of whether the declarations prescribed under Section 37(1) and the payments have been made in due time; Sections 73 and 100 shall remain unaffected.

§21.-(1) A patent shall be revoked (Section 61) if it transpires 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 elements of the patent have been taken from the descriptions, drawings, models, appliances or equipment of another person, or from a process used by another person, without his consent (usurpation);
4. the subject matter of the patent extends beyond the content of the application as originally filed with the competent authorities; the same shall apply if the patent was granted on a divisional application or on a new application filed in accordance with Section 7(2) and the subject matter of the patent extends beyond the content of the earlier application as originally filed with the competent authorities.

(2) If the grounds for revocation affect the patent in part only, the patent shall be maintained in the form of a corresponding limitation. The limitation may be affected in the form of an amendment to the claims, the descriptions or the drawings.

(3) In the event of revocation, the effects of the patent and of the application shall be deemed not to have existed ab initio. This provision shall apply mutatis mutandis to limited maintenance; where in such case a patent is not maintained by reason only of a division (Section 60), the effect of the application shall remain unaffected.

§22.-(1) Nullity of a patent shall be declared on request (Section 81) if it transpires that one of the grounds mentioned in Section 21(1) is present or the scope of the patent has been broadened.

(2) Section 21(2) and (3), first sentence and first half of second sentence, shall apply mutatis mutandis.

§23.-(1) If the applicant for a patent or the person recorded as patentee in the Register (Section 30(1)) declares to the Patent Office in writing that he is prepared to allow anyone to use the invention in return for reasonable compensation, the annual fees falling due after receipt of the declaration shall be reduced to one half of the amount prescribed in the schedule of fees. The effect of a declaration made in respect of a main patent shall extend to all its patents of addition. The declaration shall be recorded in the Register of Patents and published in the Patent Gazette [Patentblatt].

(2) Such declaration shall not be accepted if a note concerning the grant of an exclusive license (Section 30(4)) is recorded in the Register of Patents or a request for the recording of such note is pending before the Patent Office.

(3) Any person who wishes to exploit the invention after the recording of the declaration shall notify the patentee of his intention. Notification shall be deemed to have been effected if it has been dispatched by registered mail to the person recorded in the Register as patentee or to his registered representative. A statement of how the invention is to be exploited shall be given in the notification. After such notification, the notifying party shall be entitled to exploit the invention in the manner stated by him. He shall be obliged, at the end of every calendar quarter, to give the patentee particulars of the use which has been made and to pay the compensation therefor. If he fails to meet this obligation in due time, the person recorded in the Register as patentee may grant him a reasonable extension of time and, if the extension of time expires without result, may prohibit further use of the invention.

(4) The compensation shall be assessed by the Patent Division at the written request of a party. Sections 46, 47 and 62 shall apply *mutatis mutandis* to the proceedings. A fee as prescribed in the schedule of fees shall be paid with the request, which may be directed against more than one party; if the fee is not paid, the request shall be deemed not to have been made. In assessing the compensation, the Patent Office may order that the fee be repaid in whole or in part by the opponents of the request. Payment of the fee may be deferred for up to six months after the termination of the proceedings if the patentee furnishes proof that payment may not reasonably be expected of him at present due to his financial situation. If the fee is not paid by that time, the opponents of the request may be ordered to pay compensation for the exploitation of the invention to the Patent Office for the account of the patentee until such time as the amount of the fees still owing has been paid.

(5) After the expiration of one year from the last assessment, any person affected thereby may apply for it to be altered if, in the meantime, circumstances have arisen or have become known which show that the amount of compensation assessed is obviously inappropriate. A fee as prescribed in the schedule of fees shall be paid with the request. In other respects, the provisions of the first to fourth sentences of subsection (4) shall apply *mutatis mutandis*.

(6) If the declaration is made in respect of an application, the provisions of subsections (1) to (5) shall apply *mutatis mutandis*.

(7) The declaration may be withdrawn at any time by a written communication to the Patent Office insofar as no intention of using the invention has been notified to the patentee. Withdrawal shall take effect on filing. The amount by which the annual fees have been reduced shall be paid within one month after withdrawal of the declaration. The second and third sentences of Section 17(3) shall apply *mutatis mutandis* with the proviso that the due date shall be replaced by the end of the one-month period in accordance with the third sentence.

[Amended by Laws of December 20, 1991 and July 16, 1998]

§24.-(1) A non-exclusive authorization to commercially exploit an invention shall be granted by the Patent Court in individual cases in accordance with the following provisions (compulsory license) if

1. the applicant for a license has unsuccessfully endeavored during a reasonable period of time to obtain from the patentee consent to exploit the invention under reasonable conditions usual in trade; and
2. public interest commands the grant of a compulsory license.

(2) If the applicant for a license is unable to exploit an invention for which he holds protection under a patent of later date without infringing a patent of earlier date, he shall be entitled within the framework of subsection (1) to request the grant of a compulsory license with respect to the owner of the patent of earlier date if his own invention comprises, in comparison with that under the patent of earlier date, an important technical advance of considerable commercial significance. The patentee may require the applicant for a license to grant him a counter license under reasonable conditions for the exploitation of the patented invention of later date.

(3) A compulsory license under subsection (1) may be granted for a patented invention in the field of semiconductor technology only if such grant is necessary to remove an anti-competitive practice on the part of the patentee that has been established in judicial or administrative proceedings.

(4) If the patentee does not use the patented invention or does not use it predominantly in Germany, compulsory licenses under subsection (1) may be granted to ensure an adequate supply of the patented product to the domestic market. Importing shall be deemed to constitute use of the patent in Germany in such case.

(5) The grant of a compulsory license in a patent shall be permissible only after the grant of the patent. It may be granted subject to restrictions and made dependent upon conditions. The scope and duration of use shall be restricted to the purpose for which they have been permitted. The patentee shall be entitled to remuneration from the holder of a compulsory license that shall be commensurate with the circumstances and shall take into consideration the commercial value of the compulsory license. In the event of a significant change, with respect to the repeated remuneration that will become due in future, in the circumstances on which the determination of the amount of the remuneration was based, each party shall be entitled to require a corresponding adjustment. If the circumstances on which the grant of a compulsory license was based no longer apply and if it is unlikely that they will reoccur, the patentee may require the withdrawal of the compulsory license.

(6) A compulsory license in a patent may only be transferred together with the enterprise concerned by the exploitation of the invention. A compulsory license in an invention that is the subject matter of a patent of earlier date may only be transferred together with the patent of later date.

[Amended by Law of July 16, 1998]

§25.-A person who has neither domicile nor establishment in Germany may take part in proceedings before the Patent Office or the Patent Court regulated by this Law and assert rights deriving from a patent only if he has appointed a patent attorney or an attorney-at-law in Germany as his representative. The latter shall be authorized to represent him in Patent Office and Patent Court proceedings and in civil litigation affecting the patent; he may also file requests for the institution of criminal proceedings. The place where the representative has his business premises shall be deemed, within the meaning of Section 23 of the Code of Civil Procedure [Zivilprozessordnung], to be the place where the assets are located; if there are no business premises, then the place where the representative has his domicile shall be relevant and, in the absence thereof, the place where the Patent Office has its seat.

Part II

The Patent Office

§26.-(1) The Patent Office shall consist of a President and other members. They must possess the qualifications required for judicial office under the German Law Relating to Judges [Richtergesetz] (legal members) or must be experts in a branch of technology (technical members). The members shall be appointed for life.

(2) As a rule, only a person who has passed a final State or academic examination in a technical or scientific subject at a university, a technical or agricultural university or a mining academy, who has worked professionally for at least five years thereafter in the field of science, agronomy or technology and who is in possession of the requisite legal knowledge shall be appointed a technical member. Final examinations in another Member State of the European Union or in another Contracting State to the Agreement on the European Economic Area shall be deemed equivalent to German final examinations in accordance with European Community law.

(3) When a probable temporary need exists, the President of the Patent Office may temporarily appoint persons having the qualifications required for members (subsections (1) and (2)) to perform the duties of a member of the Patent Office (assistant members). The temporary appointment may be for a specified period or for as long as is needed and cannot be terminated during such period. In other respects, the provisions regarding members shall also apply to assistant members.

[Amended by Law of July 16, 1998]

§27.-(1) There shall be established in the Patent Office

1. Examining Sections for the processing of patent applications and for the provision of information on the state of the art (Section 29(3));

2. Patent Divisions for all matters concerning granted patents, for the assessment of compensation (Section 23(4) and (6)) and for the grant of the right to legal aid in proceedings before the Patent Office. It shall also be the duty of each Patent Division to give opinions (Section 29(1) and (2)) on matters within its competence.

(2) The tasks of the Examining Sections shall be performed by a technical member of the Patent Division (examiner).

(3) The Patent Division shall be competent to take decisions when at least three members participate, who shall include two technical members when the Division operates under the opposition procedure. If the case involves special legal difficulties and if none of the members participating is a legal member, one of the legal members belonging to the Patent Division shall assist in rendering the decision. A decision whereby a request for the calling in of a legal member is refused shall not be subject to interlocutory appeal.

(4) The Chairman of the Patent Division may handle alone all matters of the Patent Division, with the exception of decisions on maintenance, revocation or limitation of a patent or assessment of compensation (Section 23(4)) and grant of legal aid, or he may delegate these functions to a technical member of the Division; this shall not apply to a hearing.

(5) The Federal Ministry of Justice shall have power to establish by statutory order that officials of the higher and intermediate grades of the civil service as well as comparable employees shall be entrusted with the handling of matters within the competence of the Examining Sections or the Patent Divisions which present no particular technical or legal difficulties, with the exception, however, of the grant of a patent and the rejection of a patent application on grounds which the applicant has contested. The Federal Ministry of Justice may delegate such power by statutory order to the President of the Patent Office.

(6) For the exclusion and challenge of examiners and other members of the Patent Divisions, Sections 41 to 44, the second sentence of Section 45(2) and Sections 47 to 49 of the Code of Civil Procedure relating to exclusion and challenge of members of a court shall apply *mutatis mutandis*. The same shall apply to officials of the higher and intermediate grades of the civil service and to employees, insofar as they have been entrusted under subsection (5) with the handling of matters within the competence of the Examining Sections or Patent Divisions. Where a challenge plea requires a decision, it shall be taken by the Patent Division.

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

[Amended by Laws of March 23, 1993 and July 16, 1998]

§28.-(1) The Federal Minister for Justice shall regulate the establishment and the business procedure of the Patent Office and determine by statutory order the form of procedure, insofar as provision therefor has not been made by law.

(2) To the extent that provision therefor has not been made by law, the Federal Minister for Justice may prescribe by statutory order the collection of administrative fees to cover the expense of requests addressed to the Patent Office and may, in particular

1. order that fees be collected for certificates, authentications, consultation of files and furnishing of information and to cover all costs incurred;
2. establish rules concerning the persons liable to pay fees, the due date of payments, the obligation to pay in advance, exemption from fees, prescription and the procedure for determining fees.

§29.-(1) The Patent Office shall be required to give opinions at the request of the courts or of the State Prosecutor's Office on questions affecting patents if divergent expert opinions are submitted in the proceedings.

(2) In other respects, the Patent Office shall not have the power to take decisions or give opinions outside its statutory sphere of activity without the approval of the Federal Minister for Justice.

(3) The Federal Minister for Justice may, in order to make the documentation of the Patent Office available to the public, prescribe by statutory order that the Office will provide information on the state of the art, without guarantee that the information is complete, without requiring the approval of the Federal Council. In this regard, he shall be authorized to determine the manner in which the information shall be given, the volume of information and the technical fields involved. The Federal Minister for Justice may delegate such authority to the President of the Patent Office without requiring the approval of the Federal Council.

§30.-(1) The Patent Office shall maintain a Register in which shall be recorded the titles of patent applications, the files of which may be inspected by any person, and of granted patents, supplementary certificates of protection (Section 16a) and the names and addresses of applicants or of patentees and appointed representatives, if any (Section 25), whereby it shall suffice to enter one such representative. The commencement, division, expiration, lapsing, order for limitation, revocation, declaration of nullity of patents or supplementary certificates of protection (Section 16a), as well as the filing of opposition and of a nullity action shall also be recorded therein.

(2) The President of the Patent Office may determine that further particulars be entered in the Register.

(3) The Patent Office shall record in the Register a change in the identity of the person, of the name or of the address of the applicant or the patentee and of their representatives, if proof thereof is furnished to it. A fee as prescribed by the schedule of fees shall be paid with the request to register a change in the identity of the applicant or of the patentee; if the fee is not paid, the request shall be deemed not to have been filed. As long as the change has not been recorded, the former applicant, patentee or representative shall remain subject to the rights and obligations as provided in this Law.

(4) The Patent Office shall enter in the Register, at the request of the patentee or the licensee, the grant of an exclusive license on condition that the consent of the other party is proven. A request under the first sentence shall not be admissible for the duration of a declaration of willingness to license (Section 23(1)). The entry shall be cancelled on a request by the patentee or the licensee. A request for cancellation by the patentee shall require proof of the consent of the licensee designated in the entry or of his successor in title.

(5) A fee as prescribed by the schedule of fees shall be paid together with a request under the first or third sentences of subsection (4); if the fee is not paid, the request shall be deemed not to have been filed.

[Amended by Law of July 16, 1998]

§31.-(1) The Patent Office shall permit any person so requesting to inspect the files and the models and samples relating thereto if and to the extent that satisfactory proof of a legitimate interest has been furnished. However, any person may freely inspect the Register and the patent files, including the files of limitation proceedings (Section 64); the same shall apply to the inspection of files concerning separated parts of a patent (Section 60).

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

1. if the applicant has expressed to the Patent Office his consent to the inspection of files and has designated the inventor; or

2. if 18 months have elapsed since the filing date (Section 35 (2)) or, if an earlier date is claimed with respect to the application, since that date,

and a notification has been published under Section 32(5).

(3) Where inspection of the files is open to any person, the inspection of models and samples belonging to the files shall also be open to any person.

(4) With respect to the naming of the inventor (Section 37(1)), inspection shall be authorized only in accordance with the first sentence of subsection (1) if requested by the inventor designated by the applicant; the fourth and fifth sentences of Section 63(1) shall be applicable *mutatis mutandis*.

(5) Inspection of patent applications and patents which, pursuant to Section 50, have not been published, shall be permitted by the Patent Office only after hearing the competent supreme federal authority if and to the extent a special interest, warranting protection, of the person making the request appears to justify affording access and no serious prejudice to the external security of the Federal Republic of Germany is to be expected. If a patent application or a patent under the third sentence of Section 3(2) is cited in proceedings as prior art, the first sentence shall apply *mutatis mutandis* to that part of the file that is relevant to the opposition.

[Amended by Law of July 16, 1998]

§32.-(1) The Patent Office shall publish

1. unexamined patent applications;

2. patent specifications; and

3. a Patent Gazette.

(2) The published applications shall contain those elements of the application open to public inspection under Section 31(2) and the abstract (Section 36) as originally filed or in the altered form accepted for publication by the Patent Office. The applications shall not be published if the patent specification has already been published.

(3) The patent specification shall include the patent claims, description and drawings, on the basis of which the patent was granted. The patent specification shall also state the publications which the Patent Office has taken into account for the assessment of the patentability of the invention which is the subject matter of the application (Section 43(1)). If the abstract (Section 36) has not already been published, it shall be included in the patent specification.

(4) The published applications and patent specifications shall also be published according to the provisions of Section 31(2) if the application has been withdrawn, refused or deemed to have been withdrawn, or if a patent has lapsed after the technical preparation of the publication has been completed.

(5) The Patent Gazette shall regularly contain summaries of entries in the Register, except where they concern only the normal term of patents or the entry and cancellation of exclusive licenses, and references to the possibility of inspection of patent application files, including the files concerning separated parts of a patent (Section 60).

[Amended by Law of July 16, 1998]

§33.-(1) As from publication of the notification pursuant to Section 32(5), the applicant may require from any person who has used the subject matter of the application, although he knew or should have known that the invention used by him was the subject matter of the application, compensation appropriate to the circumstances; further claims shall not be permitted.

(2) No claim to compensation shall be admissible if the subject matter of the application is obviously unpatentable.

(3) Section 141 shall be applicable mutatis mutandis with the proviso that the claim shall not be barred prior to expiration of one year after the grant of the patent.

Part III

Procedure Before the Patent Office

[Amended by Law of July 16, 1998]

§34.-(1) Applications for the grant of patents for invention shall be filed with the Patent Office.

(2) Applications may also be filed through a Patent Information Center where an announcement by the Federal Ministry of Justice in the Federal Law Gazette has designated such center for receiving patent applications. Applications that may contain a State secret (Section 93 of the Penal Code [Strafgesetzbuch]) may not be filed with a Patent Information Center.

(3) Applications shall contain

1. the name of the applicant;
2. a request for the grant of a patent, which shall designate the invention clearly and concisely;
3. one or more claims defining the matter for which protection is sought;
4. a description of the invention;
5. any drawings referred to in the claims or the description.

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

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

(6) A fee as prescribed by the schedule of fees shall be paid with the application. If the fee is not paid, the Patent Office shall notify the applicant that the application will be deemed to have been withdrawn unless the fee is paid before the end of one month after service of the notification.

(7) The Federal Ministry of Justice shall have power to issue by statutory order regulations concerning the form and other requirements of the application. It may delegate such power by statutory order to the President of the Patent Office.

(8) At the request of the Patent Office, the applicant shall state the prior art fully and truthfully to the best of his knowledge and incorporate it in the description (subsection (3)).

(9) The Federal Ministry of Justice shall have power to issue by statutory order regulations concerning the deposit of biological material, access to such material, including those persons entitled to have access and the repeated deposit of biological material where an invention comprises the use of biological material or concerns such material that is not accessible to the public and cannot be described in the application in such a way that a person skilled in the art could carry out the invention (subsection (4)). It may delegate such power by statutory order to the President of the Patent Office.

[Amended by Law of July 16, 1998]

§35.-(1) If the application is not drafted or is not drafted wholly in German, the applicant shall be required to file a German translation within three months of the filing of the application. If the application contains a reference to drawings and no drawings accompany the application, the Patent Office shall invite the applicant to file the drawings or to declare that any reference to drawings shall be deemed not to have been made, within one month of service of the invitation.

(2) The filing date of the patent application shall be the date on which the elements referred to in Section 34(3)1 and 2 and, if they contain any statements that would appear to constitute a description, those referred to in Section 34(3)4, have been received

1. at the Patent Office;
2. or at a Patent Information Center where such center has been designated for that purpose in an announcement by the Federal Ministry of Justice in the Federal Law Gazette.

If the elements are not drafted in German, this shall apply only if a German translation is received by the Patent Office within the period of time referred to in the first sentence of subsection (1); if such is not done, the application shall be deemed not to have been filed. If the applicant files the omitted drawings after having been invited to do so in accordance with the second sentence of subsection (1), the date of receipt of the drawings at the Patent Office shall constitute the filing date; if such is not done, any reference to the drawings shall be deemed not to have been made.

[Amended by Law of July 16, 1998]

§36.-(1) Applications must be accompanied by an abstract which can be filed up to 15 months from the filing date or, where an earlier date is claimed for the application, up to 15 months from that date.

(2) Abstracts shall merely serve for use as technical information. They shall contain

1. the title of the invention;
2. a concise summary of the disclosure as contained in the application, which shall indicate the technical field of the invention and shall be drafted in such a way that it permits a clear understanding of the technical problem, its solution and the main use or uses of the invention;
3. a drawing, if mentioned in the concise summary; if several drawings are mentioned, the drawing that, in the opinion of the applicant, most clearly identifies the invention.

[Amended by Law of July 16, 1998]

§37.-(1) Within a period of 15 months from the filing date or, if an earlier date is claimed as relevant to the application, within 15 months from such date, the applicant shall name the inventor or inventors and affirm that to his knowledge no other person has contributed to the invention. If the applicant is not the inventor or not the sole inventor, he shall also state how he acquired the right to the patent. The correctness of such statement shall not be verified by the Patent Office.

(2) If the applicant can justifiably show that he has been prevented by exceptional circumstances from making in due time the declarations prescribed in subsection (1), the Patent Office shall grant him a reasonable extension of time. The time limit shall not be prolonged beyond the time of issue of the decision to grant a patent. If by that time the aforesaid circumstances still exist, the Patent Office shall grant another extension. Six months before the expiration of the time limit, the Patent Office shall notify the patentee that the patent will lapse if he does not make the prescribed declarations within six months after service of the notification.

[Amended by Law of July 16, 1998]

§38.-Up to the time of the decision to grant a patent, the contents of the application may be amended on condition that the scope of the subject matter of the application is not extended; however, until a request for examination is filed (Section 44), only the correction of obvious mistakes, the remedying of defects pointed out by the Examining Section or amendments to claims shall be permissible. No rights may be derived from amendments which broaden the scope of the subject matter of the application.

§39.-(1) An applicant may at any time divide his application. The division shall be declared in writing. If the division is declared after the filing of the request for examination (Section 44), the separated part shall be deemed an

application for which a request for examination has been filed. The date of the original application and any claimed priority shall be maintained for each divisional application.

(2) For the period up to division, the same fees which were payable for the original application shall be paid for the separated application. This shall not apply to the fee under Section 43 if the division is declared prior to the filing of the request for examination (Section 44), unless a request under Section 43 is filed for the separated application.

(3) If the elements of the application required by Sections 34 to 36 are not filed for the separated application within three months of receipt of the declaration of division, or the fees for the separated application have not been paid within such period, the declaration of division shall be deemed not to have been made.

[Amended by Law of July 16, 1998]

§40.-(1) An applicant shall enjoy, within a period of 12 months from the filing date of an earlier patent or utility model application filed with the Patent Office, a priority right with respect to a patent application for the same invention, unless a domestic or foreign priority had already been claimed for the earlier application.

(2) The priority of more than one application for a patent or utility model filed with the Patent Office may be claimed for the application.

(3) Priority may only be claimed for those features of the application which are clearly disclosed in the totality of the application documents for the earlier application.

(4) Priority may only be claimed within two months of the filing date of the later application; the declaration of priority shall only be deemed to have been made if the reference number of the earlier application is given.

(5) If the earlier application is still pending before the Patent Office, it shall be deemed withdrawn at the time of making the declaration of priority under subsection (4). This shall not apply if the early application concerns a utility model.

(6) If inspection of the file is requested (Section 31) for a later application that claims the priority of an earlier patent or utility model application, the Patent Office shall include a copy of the earlier patent or utility model application in the file of the later application.

[Amended by Laws of December 20, 1991 and July 16, 1998]

§41.-(1) Any person who, in accordance with an international treaty, claims the date of an earlier foreign application for the same invention shall, before the end of the 16th month following the priority date, state the date, country and reference number of the earlier application and file a copy of the earlier application where such has not already been done. Particulars may be altered within those periods. Where the particulars are not provided in due time, the priority claim for the application shall be forfeited.

(2) Where the earlier foreign application has been filed in a State not bound by an international agreement on the recognition of priority, the applicant may claim a right of priority corresponding to that under the Paris Convention, provided that, after publication by the Federal Ministry of Justice in the Federal Law Gazette, the other State grants a right of priority for a first filing with the Patent Office, which is, according to its requirements and contents comparable to that under the Paris Convention; subsection (1) shall be applicable.

[Amended by Laws of October 25, 1994 and July 16, 1998]

§42.-(1) If the application obviously does not comply with the requirements of Sections 34, 36, 37 and 38, the Examining Section shall request the applicant to remedy the defects within a specified period. If the application does not comply with the provisions in respect of the form and other requirements for applications (Section 34(7)), the Examining Section may refrain from objecting to the defects until the start of the examination procedure (Section 44).

(2) If the subject matter of the application obviously

1. does not, by reason of its nature, constitute an invention;
2. is not susceptible of industrial application;
3. is excluded from patentability under Section 2; or
4. its purpose is not, in the case of the second sentence of Section 16(1), an improvement or further development of the other invention,

the Examining Section shall notify the applicant thereof, stating its reasons, and invite him to submit his comments within a specified period. The same shall apply if, in the case of the second sentence of Section 16(1), the additional application has not been filed within the specified period.

(3) The Examining Section shall reject the application if the defects referred to in subsection (1) are not remedied or the application is maintained although obviously no patentable invention exists (subsection (2), items 1 to 3) or the requirements of the second sentence of Section 16(1) are obviously not met (subsection (2), first sentence, item 4, second sentence). If rejection is to be based on facts that have not yet been communicated to the applicant, he shall first be given an opportunity to submit his comments within a specified period.

[Amended by Law of July 16, 1998]

§43.-(1) The Patent Office shall, upon request, identify those publications to be taken into consideration in assessing the patentability of the invention in respect of which an application has been filed. Where the search for such publications is assumed for all or for certain technical fields, wholly or in part, by an international institution (subsection (8), item 1), a request may be submitted that the search be made in such a way that the applicant can also use the result for a European application.

(2) The request may be filed by the patent applicant or by any other person, whereby the latter shall not thereby become a participant in the procedure. The request shall be filed in writing. Section 25 shall be applicable *mutatis mutandis*. A fee as prescribed by the schedule of fees shall be paid with the request; if the fee is not paid, the request shall be deemed not to have been filed. If the request is filed in connection with an application for a patent of addition (Section 16(1), second sentence), the Patent Office shall invite the applicant to file a request as specified in subsection (1), before the expiration of one month after the invitation in connection with the application for the main patent; if no request is filed, the application for the patent of addition shall be regarded as an application for an independent patent.

(3) The filing of the request shall be published in the Patent Gazette, but not before publication of the notification pursuant to Section 32(5). If the request is filed by a person other than the applicant, the applicant shall also be notified of the filing of the request. Any person shall be entitled to inform the Patent Office of publications which might oppose the grant of a patent.

(4) The request shall be deemed not to have been filed if a request pursuant to Section 44 has already been filed. In such case, the Patent Office shall notify the person making the request of the date of filing of the request pursuant to Section 44. The fee paid for the request shall be refunded.

(5) If a request pursuant to subsection (1) has been filed, subsequent requests shall be deemed not to have been filed. The second and third sentences of subsection (4) shall be applicable *mutatis mutandis*.

(6) If a request filed by a person who is not the applicant is found to be ineffective after notification of the applicant (subsection (3), second sentence), the Patent Office shall also advise the applicant thereof in addition to such other person.

(7) The Patent Office shall communicate the publications ascertained in accordance with subsection (1) to the applicant and, if the request has been filed by another person, to such person and the applicant, without guarantee as to their completeness, and shall publish in the Patent Gazette the fact that such communication has been made. If the publications have been searched by an international institution and if the applicant has so requested (subsection (1), second sentence), this shall be stated in the communication.

(8) To accelerate the patent granting procedure, the Federal Minister for Justice shall have power to direct by statutory order that

1. the search for the publications specified in subsection (1) shall be assigned to a section of the Patent Office other than the Examining Section (Section 27(1)) or to another national or international institution, in whole or for certain technical fields or certain languages, provided that the institution concerned appears competent to search for the publications to be taken into consideration;

2. the Patent Office shall provide foreign or international authorities with data from the files of patent applications for their mutual information on the results of examination procedures and state-of-the-art searches, where the applications concerned relate to inventions in respect of which the grant of a patent has also been applied for to such foreign or international authorities;

3. the examination of patent applications according to Section 42 and the supervision of fees and time limits shall be transferred in whole or in part to sections of the Patent Office other than the Examining Sections or Patent Divisions (Section 27(1)).

§44.-(1) The Patent Office shall examine on request whether the application complies with 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 or by any other person, whereby the latter shall not become a participant in the examination procedure, prior to the expiration of seven years after the filing of the application.

(3) A fee as prescribed in the schedule of fees shall be paid with the request; if the fee is not paid, the request shall be deemed not to have been filed.

(4) If a request pursuant to Section 43 has already been filed, the examination procedure shall begin only after the request pursuant to Section 43 has been dealt with. In other respects, Section 43(2), second, third and fifth sentences, and subsections (3), (5) and (6) shall be applicable *mutatis mutandis*. If a request filed by a person other than the applicant is ineffective, the applicant himself may file a request within a period of three months from service of the notification, provided that such period expires later than the period specified in subsection (2). If the applicant does not file a request, a notice shall be published in the Patent Gazette, referring to the publication of the request filed by such other person and stating that the request is ineffective.

(5) The examination procedure shall be continued even if the request for examination is withdrawn. In the case under the third sentence of subsection (4), the procedure shall be continued from the point which it had reached at the time the applicant's request for examination was filed.

[Amended by Law of July 16, 1998]

§45.-(1) If the application does not comply with the requirements of Sections 34, 37 and 38 or if the requirements of Section 36 are manifestly not fulfilled, the Examining Section shall request the applicant to remedy the defects within a specified period. The first sentence shall not apply to defects concerning the abstract, where the abstract has already been published.

(2) If the Examining Section reaches the conclusion that the invention is not patentable under Sections 1 to 5, it shall notify the applicant thereof, shall state its grounds, and shall invite the applicant to submit his comments within a specified period.

[Amended by Law of July 16, 1998]

§46.-(1) The Examining Section may at any time summon and hear the parties, may examine witnesses, experts and the parties, whether under oath or not, and may institute other inquiries necessary for clarification of the matter. Before a decision is taken as to publication, the patent applicant shall be given a hearing on request where appropriate. The request shall be filed in writing. If the request is not filed in the prescribed form or if the Examining Section does not consider a hearing to be appropriate, it shall reject the request. A decision to reject a request shall not be subject to interlocutory appeal.

(2) Minutes of the hearing and examination of witnesses shall be taken, which shall reproduce the essentials of the proceedings and shall contain those declarations of the parties that are relevant in law. Sections 160a, 162 and 163 of the Code of Civil Procedure shall apply *mutatis mutandis*. The parties shall receive a copy of the minutes.

§47.-(1) The decisions of the Examining Sections shall contain the grounds, shall be in writing and shall be communicated *ex officio* to the parties. They may also be pronounced at the end of a hearing; the first sentence shall remain unaffected. Grounds need not be given if the applicant is the sole party and his request is allowed.

(2) The written copy shall be accompanied by a statement informing the parties of possible appeal from the decision, of the authority with which an appeal may be lodged, of the time limit for lodging an appeal and of the appeal fee, if any, to be paid. The time limit for lodging an appeal (Section 73(2)) shall begin to run only when the parties have been informed in writing. If they have not been informed or have been incorrectly informed, an appeal may only be lodged within one year from service of the decision, except where information has been given in writing that an appeal was not permissible; Section 123 shall apply *mutatis mutandis*.

§48.-The Examining Section shall reject the application if the defects objected to under Section 45(1) have not been remedied or if examination shows that the invention is not patentable under Sections 1 to 5. The second sentence of Section 42(3) shall be applicable.

[Amended by Law of July 16, 1998]

§49.-(1) If the application complies with the requirements of Sections 34, 37 and 38, if defects in the abstract objected to under Section 45(1) have been remedied and if the subject matter of the application is patentable in accordance with Sections 1 to 5, the Examining Section shall order the grant of a patent.

(2) The decision to grant shall be deferred at the request of the applicant for a period of 15 months beginning either with the date on which the application is filed with the Patent Office or, if an earlier date has been claimed, with such earlier date.

[Amended by Law of July 16, 1998]

§49a.-(1) If the person registered as patentee requests supplementary protection, the Patent Division shall examine whether the application complies with the relevant Council Regulation of the European Economic Community and with subsections (3) and (4) and Section 16a.

(2) If the application complies with those requirements, the Patent Division shall grant a supplementary certificate of protection for the duration of its term. In the contrary case, it shall invite the applicant to rectify any defect within a time limit to be set by the Patent Division, which shall be of at least two months. If the defects are not remedied, it shall reject the application by a decision.

(3) Section 34(7) shall apply. Sections 46 and 47 shall apply to the proceedings before the Patent Division.

(4) The application shall be accompanied by a fee as prescribed in the schedule of fees. If the fee is not paid, the Patent Office shall notify the applicant that the application will be deemed to have been withdrawn if the fee is not paid within one month after service of the notification.

[Added by Law of March 23, 1993 and amended by Law of July 16, 1998]

§50.-(1) If a patent is sought in respect of an invention which is a State secret (Section 93 of the Penal Code), the Examining Section shall order ex officio that no publication shall take place. The competent supreme federal authority shall be heard before the order is issued. The latter authority may request that an order be issued.

(2) The Examining Section shall cancel ex officio or at the request of the competent supreme federal authority or of the applicant or patentee an order under subsection (1) when the relevant grounds cease to exist. The Examining Section shall examine at yearly intervals whether the grounds of the order under subsection (1) continue to exist. Before an order under subsection (1) is cancelled, the competent supreme federal authority shall be heard.

(3) The Examining Section shall notify the parties if no appeal has been lodged within the time limit (Section 73(2)) against a decision of the Examining Section refusing a request for the issue of an order under subsection (1) or canceling an order under subsection (1).

(4) Subsections (1) to (3) shall apply mutatis mutandis to inventions which have been kept secret by a foreign State for reasons of defense and have been entrusted to the Federal Government with its consent and on condition that it maintain secrecy.

§51.-The Patent Office shall permit the competent supreme federal authority to inspect the files in order to examine whether, in accordance with Section 50(1), no publication shall take place or whether an order issued under Section 50(1) shall be cancelled.

§52.-(1) A patent application containing a State secret (Section 93 of the Penal Code) may only be filed, outside the territory to which this Law applies, with the written consent of the competent supreme federal authority. Consent may be given subject to the fulfillment of conditions.

(2) Any person who

1. files an application in violation of the first sentence of subsection (1); or
2. acts in violation of a condition under the second sentence of subsection (1)

shall be liable to imprisonment not exceeding five years or to a fine.

§53.-(1) If no order under Section 50(1) is served on the applicant within a period of four months after the filing of the application with the Patent Office, the applicant or any other person having knowledge of the invention may assume, when in doubt as to whether the invention is required to be kept secret (Section 93 of the Penal Code), that the invention need not be kept secret.

(2) If examination of whether, in accordance with Section 50(1), publication of an application is not to take place cannot be concluded within the period mentioned in subsection (1), the Patent Office may, by means of a notice to be served on the applicant within the period mentioned in subsection (1), extend this period by a maximum of two months.

§54.-If a patent has been granted in respect of an application for which an order under Section 50(1) was issued, the patent shall be recorded in a Special Register. The first sentence of Section 31(5) shall apply mutatis mutandis to the inspection of the Special Register.

§55.-(1) An applicant, a patentee or his successor in title who refrains from using or ceases to use for peaceful purposes an invention which is patentable under Sections 1 to 5 as a result of an order under Section 50(1), shall have a claim for compensation, in respect of the damage thereby caused to him, against the Federal Republic if and to the extent that he cannot reasonably be expected to bear the damages himself. In determining the extent to which he can reasonably be expected to do so, account shall be taken, in particular, of the financial position of the injured party, the amount of expenditure incurred by him for the invention or for acquiring title thereto, the degree to which the probability that the invention would have to be kept secret could have been recognized by him at the time the expenditure was incurred, and the profit derived by the injured party from other exploitation of the invention. A claim may only be asserted after a patent has been granted. Compensation may be claimed only after it has become due and for periods which shall not be shorter than one year.

(2) A claim shall be asserted before the competent supreme federal authority. Legal action may be instituted before the ordinary courts.

(3) Compensation under subsection (1) shall be awarded only if the first application in respect of the invention has been filed with the Patent Office and the invention has not already been kept secret by a foreign State for reasons of defense before the issue of an order under Section 50(1).

§56.-The Federal Government shall have power to determine by statutory order the competent supreme federal authority within the meaning of Sections 31(5), 50 to 55 and 74(2).

§57.-(1) A fee for grant shall be paid for the grant of the patent in accordance with the schedule of fees. The fee shall fall due on service of the decision to grant. If it is not paid within two months of becoming due, the surcharge prescribed by the schedule of fees shall be paid. After the expiration of such period, the Patent Office shall notify the patentee that the patent will be deemed not to have been granted and the application will be deemed to have been withdrawn if the fee and the surcharge are not paid within one month after service of the notification.

(2) If the fee and the surcharge are not paid in due time following service of the official notification, the patent shall be deemed not to have been granted and the application to have been withdrawn.

§58.-(1) The grant of a patent shall be published in the Patent Gazette. The patent specification shall be published at the same time. The legal effects of the patent shall come into force on publication in the Patent Gazette.

(2) If the application is withdrawn after publication of the reference to the possibility of inspection of the files (Section 32(5)) or is refused or is deemed withdrawn, the effects under Section 33(1) shall be deemed not to have come into force.

(3) If no request for examination is filed before the expiration of the period prescribed in Section 44(2) or if the annual fee payable for the application is not paid in due time (Section 17), the application shall be deemed to have been withdrawn.

§59.-(1) Within three months of the publication of grant, any person, but only the injured party in the case of usurpation, may give notice of opposition to the patent. Opposition shall be lodged in writing and grounds shall be stated. The opposition may be based only on the assertion that one of the grounds of opposition mentioned in Section 21 exists. The facts which justify the opposition shall be stated in detail. The particulars must, if not already contained in the document of opposition, be subsequently provided in writing before the expiration of the opposition period.

(2) In the event of opposition to a patent, any person who proves that proceedings for infringement of the same patent have been instituted against him may, after the opposition period has expired, intervene in the opposition proceedings, provided he gives notice of intervention within three months of the date on which the infringement proceedings were instituted. The same shall apply in respect of any person who proves both that the proprietor of the patent has demanded that he cease alleged infringement of the patent and that he has instituted proceedings for a

ruling that he is not infringing the patent. Notice of intervention shall be filed in writing stating the reasons therefor before the expiration of the period mentioned in the first sentence. The third to fifth sentences of subsection (1) shall apply mutatis mutandis.

(3) The third sentence of Section 43(3) and Sections 46 and 47 shall apply mutatis mutandis in opposition proceedings.

§60.-(1) Up to the completion of opposition proceedings, a patentee may divide his patent. If division is declared, the separated part shall be deemed to be an application for which a request for examination (Section 44) has been filed. Section 39(1), second and fourth sentences and subsections (2) and (3) shall apply mutatis mutandis. For the separated part, the effects of the patent shall be deemed not to have come into force ab initio.

(2) The division of the patent shall be published in the Patent Gazette.

§61.-(1) The Patent Division shall decide whether and to what extent the patent shall be maintained or revoked. The proceedings shall be continued ex officio without the opponent if the opposition has been withdrawn.

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

(3) If the patent has been maintained with limitations, the patent specification shall be correspondingly amended. The amendment of the patent specification shall be published.

§62.-(1) In its decision on the opposition, the Patent Office may at its equitable discretion determine to what extent the costs arising from a hearing or the taking of evidence shall be borne by a party. This shall also apply if the opposition is wholly or partly withdrawn or if the patent is relinquished.

(2) The costs shall include, in addition to the expenses of the Patent Office, the costs incurred by the parties to the extent that they were necessary for the appropriate defense of their interests and rights. The amount of the costs to be awarded shall be determined by the Patent Office upon request. The provisions of the Code of Civil Procedure relating to the procedure for the assessment of costs and execution of decisions regarding the assessment of costs shall apply mutatis mutandis. An appeal shall lie in place of a complaint from the decision regarding the assessment of costs; Section 73 shall apply with the proviso that the appeal be lodged within two weeks. The enforceable copy shall be issued by the registrar of the Patent Court.

[Amended by Law of July 16, 1998]

§63.-(1) The inventor shall be mentioned as such in the published application (Section 32(2)), in the patent specification (Section 32(3)) and in the publication of the grant of the patent (Section 58(1)), if he has already been mentioned. Such mention shall be entered in the Register (Section 30(1)). It shall be omitted if the inventor designated by the applicant so requests. The request may be withdrawn at any time; in the event of withdrawal, mention shall be effected thereafter. Renunciation by the inventor of the right to be mentioned as such shall have no legal effect.

(2) If the identity of the inventor is incorrectly given or, in the case of the third sentence of subsection (1), is not given at all, the applicant or the patentee or the person wrongly mentioned shall be under an obligation to the inventor to declare to the Patent Office that they consent to having the mention provided for in the first and second sentences of subsection (1) corrected or subsequently effected. Consent shall be irrevocable. The procedure for the grant of the patent shall not be delayed by the bringing of an action for a declaration of consent.

(3) Subsequent mention of the inventor (subsection (1), fourth sentence, and subsection (2)) or the correction (subsection (2)) shall not be effected in official publications which have already been published.

(4) The Federal Minister for Justice shall have power to issue by statutory order regulations for the implementation of the foregoing provisions. He may delegate this power by statutory order to the President of the Patent Office.

§64.-(1) A patent may be limited with retroactive effect, at the request of the patentee, by amending the patent claims.

(2) The request shall be filed in writing and the grounds on which it is based shall be stated. A fee as prescribed by the schedule of fees shall be paid with the request; if the fee is not paid, the request shall be deemed not to have been filed.

(3) The Patent Division shall decide on the request. Sections 44(1) and 45 to 48 shall be applicable mutatis mutandis. In the decision whereby the request is granted, the patent specification shall be adapted to the limitation. The amendment of the patent specification shall be published.

Part IV**The Patent Court**

§65.-(1) There shall be established a Patent Court as an autonomous and independent federal court for hearing appeals from decisions of the Examining Sections or Patent Divisions of the Patent Office and actions for declaration of nullity of patents and for compulsory licenses (Sections 81, 85). It shall have its seat at the seat of the Patent Office. It shall be designated the "Federal Patent Court".

(2) The Patent Court shall consist of a President, presiding judges and other judges. They must possess the qualifications required for judicial office under the German Law Relating to Judges (legal members) or must be experts in a branch of technology (technical members). For the technical members, Section 26(2) shall be applicable *mutatis mutandis* provided they have passed a State or academic final examination.

(3) Judges shall be appointed for life by the Federal President, except where otherwise provided in Section 71.

(4) The President of the Patent Court shall exercise official supervision over judges, officials, employees and workers.

[Amended by Law of July 16, 1998]

§66.-(1) There shall be established in the Patent Court

1. chambers for hearing appeals (Chambers of Appeal);
2. chambers for deciding actions for declaration of nullity of patents and for compulsory licenses (Nullity Chambers).

(2) The number of chambers shall be determined by the Federal Minister for Justice.

[Amended by Law of July 16, 1998]

§67.-(1) Chambers of Appeal shall decide cases under Sections 23(4) and 50(1) and (2) in the composition of one legal member as presiding judge and two technical members, in cases under Section 73(3) and Sections 130, 131 and 133, in the composition of one technical member as presiding judge, two additional technical members and one legal member, in cases under Section 31(5) in the composition of one legal member as presiding judge, one additional legal member and one technical member and in other cases in the composition of three legal members.

(2) Nullity Chambers shall decide in cases under Sections 84 and 85(3) in the composition of one legal member as presiding judge, one additional legal member and three technical members and in other cases in the composition of three judges of whom one must be a legal member.

§68.-The provisions of Part II of the Judiciary Law [Gerichtsverfassungsgesetz] shall apply to the Patent Court with the following provisos:

1. where election does not result in a presiding judge and a further judge who are legal members, the presiding judge and further judge being legal members who obtain the most votes from the legal members shall be considered elected;
2. disputes concerning election (Section 21b(6) of the Judiciary Law) shall be heard by a Chamber of the Patent Court consisting of three judges being legal members;
3. the Federal Minister for Justice shall appoint the permanent substitute of the President.

§69.-(1) Proceedings before the Chambers of Appeal shall be public if notice of the possibility of inspecting the files under Section 32(5) has been given or if the patent specification has been published under Section 58(1). Sections 172 to 175 of the Judiciary Law shall be applicable, *mutatis mutandis*, with the proviso that

1. at the request of one of the parties, the public may also be excluded from the proceedings if publicity threatens to endanger the interests worthy of protection of the party making the request;
2. the public shall be excluded from the pronouncement of the decisions until publication of a notice of the possibility of inspecting the files under Section 32(5) or until publication of the patent specification under Section 58(1).

(2) The proceedings before the Nullity Chambers, including the pronouncement of decisions, shall be public. The second sentence of subsection (1), item 1, shall be applicable mutatis mutandis.

(3) The maintenance of order in the sessions of the Chambers shall be the responsibility of the presiding judge. Sections 177 to 180, 182 and 183 of the Judiciary Law relating to the maintenance of order in court shall be applicable mutatis mutandis.

§70.-(1) Decisions in the Chambers shall be made on the basis of deliberation and the taking of votes. In such cases, only the number of members of the Chambers prescribed by law may participate. During the deliberation and voting there may be present, in addition to the members of the Chambers, only persons employed at the Patent Court for training purposes, provided that the presiding judge permits them to be present.

(2) The decisions of the Chambers shall require a majority vote; if the votes are equally divided, the presiding judge shall have the casting vote.

(3) The members of the Chambers shall vote according to seniority of service and, seniority of service being equal, according to age, the younger voting before the older. If a recording judge has been appointed, he shall vote first. The presiding judge shall vote last.

§71.-(1) Judges may be employed at the Patent Court on temporary appointment. The third sentence of Section 65(2) shall be applicable.

(2) Judges appointed on a temporary basis and temporarily delegated judges may not preside.

§72.-There shall be established at the Patent Court a registrar's office, which shall be staffed by the necessary number of registrars. The establishment of the office shall be determined by the Federal Minister for Justice.

Part V

Proceedings Before the Patent Court

1. Proceedings on Appeal

§73.-(1) An appeal shall lie from the decisions of the Examining Sections and Patent Divisions.

(2) An appeal shall be filed in writing with the Patent Office within one month after service of the decision. Copies of the appeal and of all written statements shall be attached for the other parties. The appeal and all written statements containing motions pertaining to the matter or the declaration of withdrawal of the appeal or of a motion shall be served ex officio upon the other parties; other documents shall be communicated informally to those parties, where service has not been ordered.

(3) If an appeal lies from a decision to reject an application or from a decision on the maintenance, revocation or limitation of a patent, a fee as prescribed by the schedule of fees shall be paid within the period allowed for filing an appeal; if the fee is not paid, the appeal shall be deemed not to have been filed.

(4) If the authority whose decision is contested considers the appeal to be well founded, it shall rectify its decision. It may order that the appeal fee be refunded. If the appeal is not allowed, it shall be remitted to the Patent Court without comment as to its merits before the expiration of one month.

(5) If the appellant is opposed by another party to the proceedings, the provisions of the first sentence of subsection (4) shall not be applicable.

[Amended by Law of July 16, 1998]

§74.-(1) An appeal may be lodged by the parties to the proceedings before the Patent Office.

(2) In the case of Sections 31(5) and 50(1) and (2), an appeal may also be lodged by the competent supreme federal authority.

§75.-(1) An appeal shall have a staying effect.

(2) An appeal shall have no staying effect, however, when it lies from a decision of the Examining Section by which an order under Section 50(1) has been issued.

§76.-The President of the Patent Office may, if he considers it appropriate to safeguard the public interest, make written statements in appeal proceedings before the Patent Court, be present at hearings and make representations therein. Written statements by the President of the Patent Office shall be communicated to the parties by the Patent Court.

§77.-The Patent Court may, if it considers it appropriate on an issue of law of basic importance, give the President of the Patent Office the opportunity to intervene in appeal proceedings. The President of the Patent Office shall become a party on receipt of the notice of intervention.

§78.-A hearing shall be held if

1. one of the parties so requests;
2. evidence is to be taken before the Patent Court (Section 88(1)); or
3. the Patent Court considers it appropriate.

§79.-(1) A decision shall be given on an appeal.

(2) If an appeal is not admissible or not lodged in the form provided by law and within the prescribed period, it shall be dismissed as inadmissible. The decision may be given without a hearing.

(3) The Patent Court may reverse the contested decision without itself deciding the case on its merits if

1. the Patent Office has not yet decided the case on its merits;
2. the proceedings before the Patent Office suffer from a substantial defect;
3. new facts or evidence have become known which are essential to the decision.

The Patent Office shall base its decision on the legal judgment on which the reversal is based.

§80.-(1) Where more than one person is party to the proceedings, the Patent Court may decide that the costs of the proceedings shall be borne in whole or in part by one of the parties if and to the extent that this is equitable. It may, in particular, also order that the costs incurred by the parties shall, to the extent that they were necessary for the appropriate protection of the rights involved, be refunded in whole or in part by one of the parties.

(2) Costs may be awarded against the President of the Patent Office only if he has made petitions after his intervention in the proceedings.

(3) The Patent Court may order that the appeal fee (Section 73(3)) be refunded.

(4) Subsections (1) to (3) shall also be applicable if, either in whole or in part, the appeal, the application or the opposition is withdrawn or if the patent is relinquished.

(5) In other respects, the provisions of the Code of Civil Procedure relating to the procedure for the assessment of costs and the execution of decisions regarding the assessment of costs shall apply *mutatis mutandis*.

[Amended by Law of July 16, 1998]

2. Nullity and Compulsory License Proceedings

[Amended by Law of July 16, 1998]

§81.-(1) Proceedings for a declaration of nullity of a patent or supplementary certificate of protection or for the grant or withdrawal of a compulsory license or for the adaptation of the remuneration determined by a judgment under a compulsory license shall be instituted by bringing legal action. The action shall be directed against the person recorded in the Register as patentee or against the holder of the compulsory license. An action against a supplementary certificate of protection may be consolidated with an action against the basic patent and may also be based on the fact that one of the grounds for nullity exists in respect of the basic patent (Section 22).

(2) An action for a declaration of nullity of a patent shall not be brought as long as opposition may still be filed or opposition proceedings are pending.

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

- (4) An action shall be filed with the Patent Court in writing. Copies of the action and of all written statements shall be attached for the defendant. The action and all written statements shall be served ex officio on the defendant.
- (5) An action shall designate the plaintiff, the defendant and the matter at issue and shall contain a specific motion. The facts and documentary evidence relied on shall be stated. If the action does not fully comply with these requirements, the presiding judge shall invite the plaintiff to file the necessary additional materials within a specified period.
- (6) A fee as prescribed by the schedule of fees shall be paid when the action is filed; if the fee is not paid, the action shall be deemed not to have been filed.
- (7) Plaintiffs who do not have their usual place of residence in a Member State of the European Union or in a Contracting State to the Agreement on the European Economic Area shall provide security, at the demand of the defendant, with respect to the costs of the procedure; Section 110(2)1 to 3 of the Code of Civil Procedure shall apply mutatis mutandis. The Patent Court shall determine, at its equitable discretion, the amount of the security and shall fix a time limit within which that amount shall be furnished. If the time limit is not observed, the action shall be deemed to have been withdrawn.

[Amended by Laws of March 23, 1993, July 16, 1998 and August 6, 1998]

§82.-(1) The Patent Court shall serve notice of the action on the defendant and invite him to reply thereto within one month.

(2) If the defendant fails to reply in due time, a decision complying with the plaintiff's request may be rendered forthwith without a hearing and every factual allegation of the plaintiff assumed to be proved.

§83.-(1) If the defendant files a contesting reply in due time, the Patent Court shall notify the plaintiff of such reply.

(2) The Patent Court shall render its decision on the basis of a hearing. With the consent of the parties, a decision may be rendered without a hearing.

§84.-(1) The decision on an action shall be delivered in the form of a judgment. An interim decision on the admissibility of the action may be delivered in the form of an interlocutory judgment.

(2) In the judgment, the costs of the proceedings shall also be decided. The provisions of the Code of Civil Procedure concerning procedural costs shall apply mutatis mutandis insofar as equity does not require otherwise; the provisions of the Code of Civil Procedure relating to the procedure for the assessment of costs and execution of decisions regarding the assessment of costs shall apply mutatis mutandis. Section 99(2) shall remain unaffected.

§85.-(1) In proceedings for the grant of a compulsory license, the plaintiff may, at his request, be allowed to exploit the invention by a provisional order if he satisfies the Court that the conditions referred to in Section 24(1) to (5) are complied with and that an immediate grant of permission is urgently required in the public interest.

(2) A fee as prescribed by the schedule of fees shall be paid with the request; if the fee is not paid, the request shall be deemed not to have been filed. The issue of a provisional order may be made conditional on the furnishing of security, by the person making the request, for the damage which the defendant may suffer.

(3) The Patent Court shall render its decision on the basis of a hearing. The provisions of the second sentence of Section 83(2) and of Section 84 shall be applicable mutatis mutandis.

(4) The effect of the provisional order shall cease with the withdrawal or refusal of the action for the grant of a compulsory license (Section 81); the decision as to costs may be amended if a party applies for amendment within one month after the withdrawal or after the refusal becomes final.

(5) If the issue of the provisional order proves to have been unjustified ab initio, the person making the request shall be required to compensate the defendant for the damage which he has suffered from the execution of the provisional order.

(6) The judgment granting the compulsory license may, on request, with or without security, be declared provisionally enforceable if such is in the public interest. If the judgment is reversed or altered, the person making the request shall be obliged to compensate the defendant for the damage which he has suffered through the enforcement.

[Amended by Law of July 16, 1998]

3. Common Rules of Procedure

§86.-(1) For the exclusion and challenge of members of the Court, Sections 41 to 44 and 47 to 49 of the Code of Civil Procedure shall be applicable mutatis mutandis.

(2) The following shall also be excluded from judicial office:

1. in proceedings on appeal, persons who have participated in the previous proceedings before the Patent Office;
2. in proceedings for declaration of nullity of a patent, persons who have participated in the proceedings before the Patent Office or Patent Court relating to the grant of the patent or relating to opposition.

(3) The decision on the challenge of a judge shall be rendered by the Chamber to which the person who is challenged belongs. If, as a result of the elimination of the member who has been challenged, the Chamber is unable to render a decision, a Chamber of Appeal of the Patent Court consisting of three legal members shall render the decision.

(4) The decision on the challenge of a registrar shall be rendered by the Chamber in whose jurisdiction the matter falls.

§87.-(1) The Patent Court shall investigate ex officio the facts of the case. It shall not be bound by the factual statements and the offers of proof of the parties.

(2) The presiding judge or a member designated by him shall, before the hearing or, in the absence of a hearing, before the decision of the Patent Court, make all arrangements necessary for the matter to be dealt with, if possible, in one hearing or in one session. In other respects, Section 273(2), (3), first sentence, and (4), first sentence, of the Code of Civil Procedure shall be applicable mutatis mutandis.

§88.-(1) The Patent Court shall take evidence at the hearing. In particular, it may make inspections on the spot, examine witnesses, experts and the parties and order the consultation of documents.

(2) In suitable cases, the Patent Court may, prior to the hearing, have evidence taken by one of its members as commissioned judge or, specifying particular questions of evidence, request another court to take such evidence.

(3) The parties shall be notified of all hearings in which evidence is to be taken and may attend such hearings. They may put relevant questions to witnesses and experts. If a question is objected to, the Patent Court shall decide.

§89.-(1) As soon as the date for a hearing is fixed, the parties shall be summoned with at least two weeks' notice. In urgent cases, the presiding judge may shorten this period.

(2) It shall be pointed out in the summons that if a party fails to appear, the case may be heard and decided in his absence.

§90.-(1) The presiding judge shall open and conduct the hearing.

(2) After the case is called, the presiding judge or recording judge shall report on the essential contents of the files.

(3) Thereupon, the parties shall be given leave to speak in order to make and substantiate their motions.

§91.-(1) The presiding judge shall discuss with the parties the questions of fact and questions of law involved in the case.

(2) The presiding judge shall, upon request, permit each member of the Chamber to ask questions. If a question is objected to, the Chamber shall decide.

(3) After discussing the case, the presiding judge shall declare the hearing closed. The Chamber may decide to reopen the hearing.

§92.-(1) At the hearing, and whenever evidence is taken, a registrar of the Court shall be called to act as minute-writer. If, by order of the presiding judge, no minute-writer is called, one of the judges shall record the minutes.

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

§93.-(1) The Patent Court shall take its decisions on the basis of its own conclusions freely reached in the light of the results of the proceedings as a whole. The decision shall state the grounds which led the judges to form their conclusions.

(2) The decision may be based only on facts and the results of evidence on which the parties have had an opportunity to state their views.

(3) Where there has been a previous hearing, a judge not present at the last session of the hearing may participate in rendering the decision only if the parties consent.

§94.-(1) Final decisions of the Patent Court shall, if a hearing has taken place, be rendered at the court session at which the hearing was concluded or at a session to be fixed forthwith. This deadline shall not exceed three weeks except when important reasons, in particular the volume and the difficulty of the case, so require. Final decisions shall be served *ex officio* on the parties. They may be served on the parties instead of being pronounced in court. If the Patent Court makes its decision without a hearing, pronouncement of the decision shall be replaced by service thereof on the parties.

(2) Final decisions of the Patent Court by which a motion is refused or a legal remedy is decided upon shall state the grounds upon which the decision is based.

§95.-(1) Clerical errors, errors in calculation and similar obvious errors in the decision may at any time be corrected by the Patent Court.

(2) The correction may be decided without a previous hearing. The decision concerning the correction shall be recorded on the decision itself and on the copies thereof.

§96.-(1) If the statement of facts as set out in the decision contains other mistakes or obscurities, correction may be requested within two weeks after service of the decision.

(2) The Patent Court shall decide on this matter without taking evidence. In such decisions, only judges who have taken part in rendering the decision whose correction is requested shall participate. The decision concerning the correction shall be recorded on the decision itself and the copies thereof.

§97.-(1) A party may, at any stage of the proceedings, be represented before the Patent Court by an authorized representative. A decision may be made ordering the appointment of a representative. The provisions of Section 25 shall remain unaffected.

(2) The power of attorney shall be filed in writing at the Court with the documents of the case. It may be filed later; the Patent Court may set a time limit for this purpose.

(3) The lack of a power of attorney may be raised at any stage of the proceedings. The Patent Court shall *ex officio* consider the lack of a power of attorney if an attorney-at-law or patent attorney does not appear as the representative.

§98.-In proceedings before the Patent Court, the Law on Court Costs [Gerichtskostengesetz] shall apply *mutatis mutandis* with respect to expenses.

§99.-(1) In the absence of provisions in this Law concerning proceedings before the Patent Court, the Judiciary Law and the Code of Civil Procedure shall apply *mutatis mutandis* unless the special nature of the proceedings before the Patent Court does not so permit.

(2) Appeals from decisions of the Patent Court shall lie only to the extent permitted under this Law.

(3) For the grant to other persons of permission to inspect the files of the case, Section 31 shall apply *mutatis mutandis*. The request for permission shall be decided by the Patent Court. Permission to inspect the files of proceedings for obtaining a declaration of nullity of a patent shall not be granted if and to the extent that the patentee proves an interest to the contrary worthy of protection.

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

[Amended by Law of October 28, 1996]

Part VI

Proceedings Before the Federal Court of Justice

1. Procedure in Respect of Appeals on Points of Law

§100.-(1) An appeal on a point of law from decisions of the Chambers of Appeal of the Patent Court in respect of an appeal under Section 73 shall lie to the Federal Court of Justice if the Chamber of Appeal in its decision has given leave to appeal on the point of law.

(2) Appeal on a point of law shall be permitted if

1. an issue of law of basic importance is to be decided; or
2. the further development of the law or the assurance of uniform judicial practice requires a decision by the Federal Court of Justice.

(3) Leave to appeal on a point of law from the decisions of the Chambers of Appeal of the Patent Court shall not be required if one of the following procedural defects is present and denounced:

1. if the court which rendered the decision was not properly constituted;
2. if a judge having participated in rendering the decision was excluded by law from the exercise of judicial office or, because of the possibility of partiality, had been successfully challenged;
3. if a party to the proceedings was refused the opportunity to present comments;
4. if a party to the proceedings was not represented according to the provisions of the law, unless he expressly or tacitly agreed with the conduct of the proceedings;
5. if the decision was made on the basis of a hearing in which the provisions on the publicity of proceedings were violated; or
6. if the decision does not state the grounds therefor.

[Amended by Law of July 16, 1998]

§101.-(1) The right to appeal on a point of law shall belong to the parties to the proceedings on appeal.

(2) The only basis for an appeal on a point of law shall be the argument that the decision is founded on a breach of the law. Sections 550 and 551, items 1 to 3 and 5 to 7, of the Code of Civil Procedure shall apply *mutatis mutandis*.

§102.-(1) An appeal on a point of law shall be lodged in writing with the Federal Court of Justice within one month after service of the decision.

(2) In proceedings concerning appeals on points of law before the Federal Court of Justice, the provisions of Section 144 on the assessment of value in dispute shall apply *mutatis mutandis*.

(3) An appeal on a point of law shall state the grounds on which it is based. The period allowed for stating the grounds shall be one month; it shall commence with the filing of the appeal on a point of law and may, upon request, be extended by the presiding judge.

(4) The statement of the grounds for the appeal on a point of law must contain

1. a declaration as to the extent to which the decision is contested and if the modification or reversal thereof is requested;
2. designation of the violated rule of law;
3. where the basis for the appeal on a point of law is the argument that the law was violated in respect of procedure, a statement of the facts constituting the defect.

(5) The parties shall be represented before the Federal Court of Justice by an attorney-at-law admitted to practice before the Court as authorized representative. At the request of any party, the latter's patent attorney shall be given leave to speak. Section 157(1) and (2) of the Code of Civil Procedure shall not apply in this event. Section 143(5) shall apply *mutatis mutandis*.

[Amended by Law of July 16, 1998]

§103.-An appeal on a point of law shall have a staying effect. Section 75(2) shall apply mutatis mutandis.

§104.-The Federal Court of Justice shall examine ex officio whether an appeal on a point of law is in itself admissible and whether it has been filed and the grounds therefor have been stated in the form provided by law and within the prescribed time limit. If any of these requirements is lacking, the appeal on a point of law shall be dismissed as inadmissible.

§105.-(1) Where more than one person is party to the proceedings in respect of an appeal on a point of law, the appeal and the statement of the grounds therefor shall be served on the other parties, with the request to file declarations, if any, in writing with the Federal Court of Justice within a given period after service. The date on which the appeal was filed shall be communicated with the service of the appeal on a point of law. The appellant shall file the required number of certified copies together with the appeal or the statement of the grounds for the appeal.

(2) If the President of the Patent Office is not a party in an appeal on a point of law, Section 76 shall apply mutatis mutandis.

§106.-(1) In proceedings in respect of an appeal on a point of law, the provisions of the Code of Civil Procedure regarding exclusion and challenge of members of the Court, authorized representatives and legal assistants, ex-officio service of documents, summonses, sessions and time limits, and reinstatement, shall apply mutatis mutandis. In the case of reinstatement, Section 123(5) to (7) shall apply mutatis mutandis.

(2) For the publicity of proceedings, Section 69(1) shall apply mutatis mutandis.

[Amended by Law of July 16, 1998]

§107.-(1) An appeal on a point of law shall be the subject of a decision; such decision may be rendered without a hearing.

(2) The Federal Court of Justice shall be bound, when rendering its decision, by the facts established in the decision appealed from, except when admissible and substantiated grounds for an appeal on a point of law are put forward in relation to such facts.

(3) The decision must state the grounds on which it is based and shall be served ex officio on the parties.

§108.-(1) In the event of reversal of the decision appealed against, the case shall be referred back to the Patent Court for a further hearing and decision.

(2) The Patent Court shall be bound to base its decision on the legal opinion on which the reversal is based.

§109.-(1) Where more than one person is party to the proceedings relating to an appeal on a point of law, the Federal Court of Justice may, at its equitable discretion, decide that the costs necessary for the appropriate final disposal of the case shall be borne in whole or in part by one of the parties if and to the extent that this is equitable. If the appeal is rejected or dismissed as inadmissible, the costs arising from the appeal shall be awarded against the appellant. Costs arising from gross negligence by one of the parties shall be awarded against that party.

(2) Costs may only be awarded against the President of the Patent Office if he lodged the appeal on a point of law or made petitions in the proceedings.

(3) In other respects, the provisions of the Code of Civil Procedure relating to the procedure for the assessment of costs and execution of decisions regarding the assessment of costs shall apply mutatis mutandis.

2. Procedure on Appeal

§110.-(1) An appeal shall lie to the Federal Court of Justice from the judgments of the Nullity Chambers of the Patent Court (Section 84).

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

(3) The time limit for appeal shall be one month. It shall begin with service of the full text of the judgment, but at the latest on expiry of five months of delivery of the judgment.

(4) The appeal in writing shall contain

1. the identification of the judgment against which the appeal is directed;
2. a statement that the appeal is filed against that judgment.

(5) The appeal in writing shall be accompanied by an original or a certified copy of the contested judgment.

(6) Decisions of the Nullity Chambers shall be subject to appeal only together with their judgments (Section 84); Section 71(3) of the Code of Civil Procedure shall not apply.

[Amended by Law of July 16, 1998]

§111.-(1) The appellant shall state the grounds of appeal.

(2) Where not already contained in the written appeal, the grounds of appeal shall be filed in a written submission to the Federal Court of Justice. The time limit for submitting the grounds of appeal shall be one month; it shall begin with the filing of the appeal. The time limit may be extended by the presiding judge, on request, if it is his conviction that the extension will not delay the procedure or if the appellant can show significant grounds.

(3) The grounds of appeal shall contain

1. a statement of the extent to which the judgment is contested and the amendments to the judgment that are requested (motions of appeal);
2. the exact designation of the grounds of contestation to be individually presented (grounds of appeal) together with the new facts, evidence and objections to evidence which the party shall submit to justify the appeal.

(4) Parties shall be represented before the Federal Court of Justice by an attorney-at-law or a patent attorney holding their power of attorney. The representative shall be permitted to appear accompanied by a technical advisor.

[Amended by Law of July 16, 1998]

§112.-(1) The written appeal and the grounds of appeal shall be served upon the appellee. The date on which the appeal was filed shall be communicated with the service of the appeal. The appellant shall file the required number of certified copies together with the written appeal or the grounds of appeal.

(2) The Chamber or the presiding judge may impose upon the appellee a time limit for submitting his written counter motions and on the appellant for submitting his written observations on the counter motions.

[Amended by Law of July 16, 1998]

§113.-(1) The Federal Court of Justice shall be required to examine ex officio whether the appeal as such is admissible and whether it has been filed and grounds given in the statutory form and within the statutory time limit. In the event of failure to comply with any one of these requirements, the appeal shall be dismissed as inadmissible.

(2) A decision may be taken without oral hearing by means of an order.

[Amended by Law of July 16, 1998]

114. If the appeal is not dismissed as inadmissible by means of an order, the date for the oral hearing shall be determined and the parties advised thereof.

[Amended by Law of July 16, 1998]

§115.-(1) The Federal Court of Justice shall have discretion to take all measures necessary for the investigation of the case. It shall not be bound by the factual statements and offers of proof of the parties.

(2) Evidence may also be taken through the intermediary of the Patent Court.

§116.-(1) The judgment of the Federal Court of Justice shall be rendered on the basis of a hearing. Section 69(2) shall apply mutatis mutandis.

(2) The summons shall be served with at least two weeks' notice.

(3) The hearing may be dispensed with if

1. the parties consent;

2. a party is to be declared to have forfeited the legal remedy; or
3. only the costs are to be decided.

§117.-(1) The introduction of new facts and evidence at a hearing shall be admissible only to the extent that it results from the factual statements of the appellee in the written declaration.

- (2) The Federal Court of Justice may also consider facts and evidence which the parties are forbidden to invoke.
- (3) Section 115 shall be applicable if any additional evidence is required to be taken.
- (4) When the judgment is to be based upon factors which have not been discussed by the parties, they shall be given an opportunity to express their views thereon.

§118.-(1) Facts alleged by one party on which the other party has made no statement may be deemed to be proven.

- (2) If none of the parties appears at the hearing, the judgment shall be based on the files.

§119.-(1) At the hearing, minutes shall be taken which shall record the general course of the proceedings.

- (2) The minutes shall be signed by the presiding judge and the registrar of the Court.

§120.-(1) The judgment shall be pronounced at the hearing that concludes the proceedings or at a hearing whose date shall be fixed forthwith.

- (2) If pronouncement of the grounds for the decision is deemed appropriate, it shall take the form of a reading of such grounds or an oral communication of the essential elements thereof.
- (3) The judgment shall be served ex officio.

§121.-(1) The provisions of Section 144 concerning assessment of the value in dispute shall apply mutatis mutandis in proceedings before the Federal Court of Justice.

- (2) A decision on the costs of proceedings shall be included in the judgment. The provisions of the Code of Civil Procedure concerning costs of procedure (Sections 91 to 101) shall apply mutatis mutandis unless equity should require a different decision; the provisions of the Code of Civil Procedure on the procedure for the assessment of costs (Sections 103 to 107) and execution of decisions regarding the assessment of costs (Sections 724 to 802) shall apply mutatis mutandis.

[Amended by Law of July 16, 1998]

3. Special Procedure on Appeal

§122.-(1) An appeal from decisions of the Nullity Chambers of the Patent Court on the issue of provisional orders in proceedings relating to the grant of a compulsory license (Section 85) shall lie with the Federal Court of Justice. Section 110(6) shall apply mutatis mutandis.

- (2) An appeal shall be lodged in writing with the Federal Court of Justice within one month after service of the decision.
- (3) The time limit for appeal shall begin with service of the full text of the judgment, but at the latest on expiry of five months after it has been delivered.
- (4) Sections 74(1), 84 and 110 to 121 shall apply mutatis mutandis with respect to the proceedings before the Federal Court of Justice.

[Amended by Law of July 16, 1998]

Part VII

Common Provisions

§123.-(1) Any person who, through no fault of his own, has been prevented from observing a time limit, default of which is detrimental to his rights according to the provisions of the law, shall, on request, be reinstated. This provision shall not apply to the time limit for filing an opposition (Section 59(1)), to the time limit allowed an opponent for filing an appeal against the maintenance of a patent (Section 73(2)) or to the time limit for filing patent applications for which a priority under Section 7(2) and Section 40 may be claimed.

(2) Reinstatement shall be requested in writing within two months after the removal of the impediment. The request shall state the facts upon which the reinstatement may be based; these facts must be established to the satisfaction of the Court in the request or in the procedure on the request. The action in default shall be made good within the time limit for the request; if this is done, reinstatement may be granted without a request. After one year from the expiration of the time limit which has not been observed, reinstatement may no longer be requested and the action in default may no longer be made good.

(3) A decision on the request shall be taken by the authority that is required to decide on the action to be made good.

(4) The decision on reinstatement shall not be appealable.

(5) Any person who, in Germany, has in good faith exploited the subject matter of a patent which, as a result of reinstatement, has re-entered into force in the period between the lapsing and the re-entry into force of the patent or has, within that period, made the necessary arrangements for such purpose, shall be entitled to continue to exploit the subject matter of the patent for the needs of his own business in his own or the plants or workshops of others. This entitlement may only be inherited or transferred together with the business.

(6) Subsection (5) shall apply *mutatis mutandis* if, as a result of reinstatement, the provisions of Section 33(1) again become effective.

(7) Any person who, in Germany, has in good faith exploited the subject matter of an application which, as a result of reinstatement, claims the priority of an earlier foreign application (Section 41), in the period between the expiry of the 12-month time limit and the re-entry into force of the priority right, or has, within that period, made the necessary arrangements for such purpose, shall also be entitled in accordance with subsection (5).

[Amended by Law of July 16, 1998]

§124.-In proceedings before the Patent Office, the Patent Court and the Federal Court of Justice, the parties shall make their statements on questions of fact fully and truthfully.

§125.-(1) If an opposition or action for a declaration of nullity of a patent is based upon the assertion that the subject matter of the application or of the patent is not patentable under Section 3, the Patent Office or the Patent Court may require that originals, photocopies or certified copies of the publications mentioned in the opposition or in the action which are not available at the Patent Office or Patent Court be furnished, in one copy each, for the Patent Office or Patent Court and for the parties to the proceedings.

(2) Uncertified or certified translations of publications in a foreign language shall be produced when required by the Patent Office or Patent Court.

§126.-The language of the Patent Office and Patent Court shall be German, where not otherwise provided. In other respects, the provisions of the Judiciary Act concerning the language of the courts shall be applicable.

[Amended by Law of July 16, 1998]

§127.-(1) For the purpose of the service of documents in proceedings before the Patent Office and the Patent Court, the provisions of the Law on Service in Administrative Procedures [Verwaltungszustellungsgesetz] shall apply, subject to the following conditions:

1. if acceptance of service by registered letter is refused without such grounds as are provided by law, service shall nevertheless be deemed to have been effected;
2. service on addressees residing abroad may also be effected by mail in accordance with Sections 175 and 213 of the Code of Civil Procedure;
3. for the purposes of service upon holders of certificates of representation (Section 77 of the Patent Attorney Regulations [Patentanwaltsordnung]), Section 5(2) of the Law on Service in Administrative Procedures shall apply *mutatis mutandis*;
4. documents may also be served on addressees for whom a mail box has been installed at the Patent Office or at the Patent Court, by depositing the documents in the mail box of the addressee. A written statement relating to the

deposit shall be added to the files of the case. The time of the deposit shall be recorded on the document. Service shall be deemed to have been effected on the third day after deposit in the mail box.

5. (repealed)

(2) Section 9(1) of the Law on Service in Administrative Procedures shall not apply if service initiates the period allowed for the filing of an appeal (Section 73(2), 122(3)), an appeal on a point of law (Section 102(1)) or an appeal (Section 110(3)).

[Amended by Law of July 16, 1998]

§128.-(1) The courts shall be required to furnish legal assistance to the Patent Office and the Patent Court.

(2) In proceedings before the Patent Office, the Patent Court shall, at the request of the Patent Office, prescribe orders or coercive means against witnesses and experts who fail to appear or who refuse to give evidence or to give it under oath. Enforcement of the summons served on a witness who has failed to appear shall likewise be ordered.

(3) A Chamber of Appeal of the Patent Court composed of three legal members shall pronounce on the request made under subsection (2). Pronouncement in such case shall take the form of a decision.

Part VIII

Legal Aid

§129.-In proceedings before the Patent Office, the Patent Court and the Federal Court of Justice, parties shall be granted legal aid in accordance with the provisions of Sections 130 to 138.

[Amended by Law of July 16, 1998]

§130.-(1) In proceedings for the grant of a patent, an applicant for a patent shall, on request, subject mutatis mutandis to Sections 114 to 116 of the Code of Civil Procedure, be granted legal aid if there are adequate prospects that the patent will be granted. Payments shall be made to the Federal Treasury.

(2) The grant of legal aid shall have the effect that the legal consequences resulting from the non-payment of the fees which are the subject of legal aid shall not come into effect. Section 122(1) of the Code of Civil Procedure shall also apply mutatis mutandis.

(3) Where more than one person applies for a patent jointly, legal aid shall be granted only if all the applicants for the patent comply with the requirements of subsection (1).

(4) If the applicant for the patent is not the inventor or his sole successor in title, legal aid shall be granted only if the inventor also complies with the requirements of subsection (1).

(5) On request, as many annual fees shall be included in the legal aid, in lieu of a delay granted or to be granted under Section 18(1), as are necessary to avoid a limitation opposing a grant of legal aid under Section 115(3) of the Code of Civil Procedure. The installments paid shall be set off against the annual fees only when the costs of the patent-granting procedure, including costs possibly arising for an appointed representative, are covered by the payment of the installments. To the extent that the annual fees shall be considered paid by the payment of the installments, Section 19 shall apply mutatis mutandis. The first sentence shall apply mutatis mutandis to the inclusion of the fees in the legal aid under Section 23(4), third sentence, and (5), second sentence.

(6) Subsections (1) to (3) shall apply mutatis mutandis in cases specified in Sections 43 and 44 to the third party filing the request if that third party can substantiate a personal interest worthy of protection.

§131.-In proceedings for limitation of a patent (Section 64), the provisions of Section 130(1), (2) and (5) shall apply mutatis mutandis.

§132.-(1) In proceedings for opposition (Sections 59 to 62), a patentee shall, on request, be granted legal aid, subject mutatis mutandis to Sections 114 to 116 of the Code of Civil Procedure and Section 130(1), second sentence, and (2), (4) and (5). No account shall be taken of whether the legal defense offers adequate prospects of success.

(2) The first sentence of subsection (1) shall apply mutatis mutandis to the opponent and to the third party intervening under Section 59(2) as well as to the parties in procedures for nullity of a patent or for a compulsory license (Sections 81, 85) if the person making the request can substantiate a personal interest worthy of protection.

[Amended by Law of July 16, 1998]

§133.-A party who has been granted legal aid in accordance with the provisions of Sections 130 to 132 may, on request, be assigned a patent attorney or attorney-at-law of his choice who is prepared to represent him, or, on express demand, a holder of a certificate of representation, if such assignment appears necessary for the proper handling of the proceedings or a party with contrary interests is represented by a patent attorney, an attorney-at-law or a holder of a certificate of representation. Section 121(3) and (4) of the Code of Civil Procedure shall apply *mutatis mutandis*.

§134.-If a request for the grant of legal aid in accordance with Sections 130 to 132 is filed prior to the expiration of a period prescribed for the payment of a fee, that period shall be interrupted until the expiration of one month after service of the decision on the request.

§135.-(1) A request for the grant of legal aid shall be filed in writing with the Patent Office, the Patent Court or the Federal Court of Justice. In proceedings under Sections 110 and 122, the request may also be deposited with the registry of the Federal Court of Justice.

(2) The decision on a request shall be made by the authority competent for the proceedings in respect of which legal aid is sought.

(3) Decisions rendered under Sections 130 to 133 shall not be appealable except for decisions of the Patent Division refusing the grant of legal aid or the assignment of a representative under Section 133; an appeal on points of law shall be excluded. Section 127(3) of the Code of Civil Procedure shall apply *mutatis mutandis* to proceedings before the Patent Court.

[Amended by Laws of December 9, 1986 and July 16, 1998]

§136.-The provisions of Sections 117(2) to (4), 118(2) and (3), 119 and 120(1), (3) and (4), as well as Sections 124 and 127(1) and (2) of the Code of Civil Procedure, shall apply *mutatis mutandis*. In opposition proceedings and in proceedings for obtaining a declaration of nullity of a patent or for a compulsory license (Sections 81, 85), the same shall also apply to Sections 117(1), second sentence, 118(1), 122(2), and Sections 123, 125 and 126 of the Code of Civil Procedure.

[Amended by Laws of December 9, 1986 and July 16, 1998]

§137.-Legal aid may be withdrawn if the invention filed or protected by a patent, with reference to which legal aid has been granted, is commercially exploited through assignment, use, licensing or in any other way, and the income earned thereby has so altered the circumstances relevant for the granting of legal aid that the payment of the costs of proceedings can reasonably be expected to be paid by the party concerned; this shall also apply after the end of the period laid down in Section 124, item 3, of the Code of Civil Procedure. The party to whom legal aid has been granted shall be obliged to reveal every commercial exploitation of the relevant invention to the authority which made the decision on the grant.

§138.-(1) In proceedings relating to appeals on points of law (Section 100), the right to legal aid shall be granted to a party, upon request, under Sections 114 to 116 of the Code of Civil Procedure *mutatis mutandis*.

(2) The request for the grant of legal aid shall be filed in writing with the Federal Court of Justice; it may also be declared before and recorded at the registrar's office of the Court. The Federal Court of Justice shall decide on the request.

(3) In other respects, the provisions of Sections 130(2), (3), (5) and (6), 133, 134, 136 and 137 shall apply *mutatis mutandis*, provided that only an attorney-at-law admitted to practice before the Federal Court of Justice may be assigned to a party who has been granted legal aid.

Part IX

Infringement

§139.-(1) Any person who exploits an invention contrary to Sections 9 to 13 may be sued by the injured party to enjoin such use.

(2) Any person who undertakes such action intentionally or negligently shall be liable for compensation to the injured party for the damage suffered therefrom. If the infringer is charged with only slight negligence, the Court may fix, in lieu of compensation, an indemnity within the limits of the damage to the injured party and the profit which has accrued to the infringer.

(3) If the subject matter of a patent is a process for obtaining a new product, the same product when produced by any other party shall, in the absence of proof to the contrary, be deemed to have been obtained by the patented process. In the adduction of proof to the contrary, the legitimate interests of the defendant in protecting his manufacturing and business secrets shall be taken into account.

§140. If, prior to the grant of a patent, rights based on an application the files of which may be inspected by any person (Section 31(1), the second half of the second sentence and (2)) are claimed in court proceedings, and if the decision on the litigation depends on whether an action exists under Section 33(1), the Court may order that the proceedings be deferred until the decision is made on the grant of the patent. If a request for examination pursuant to Section 44 has not been filed, the Court may, at the request of the opposing party, give a time limit for filing the request for examination to the party claiming rights on the basis of the application. If the request for examination is not filed within that time limit, the rights deriving from the application involved in the litigation may not be claimed.

§140a.-(1) In the cases covered by Section 139, the injured party may require destruction of the product that is the subject matter of the patent and that is in the possession of the infringer or is his property unless the infringing nature of the product can be removed in some other way and its destruction would be disproportionate in the individual case for the infringer or the owner. The first sentence shall also apply in the case of a product that has been directly manufactured by means of a process that is the subject matter of the patent.

(2) The provisions of subsection (1) shall apply mutatis mutandis to devices that are the property of the infringer and that are used or intended exclusively or almost exclusively for the unlawful manufacture of a product.

[Added by Law of March 7, 1990]

§140b.-(1) Any person who uses a patented invention in contravention of Sections 9 to 13 may be required by the injured party to give information as to the origin and distribution channels of the product used, without delay, except where disproportionate in the individual case.

(2) The person required to give information under subsection (1) shall give particulars of the name and address of the manufacturer, the supplier and other prior owners of the product, of the trade customer or of the principal, as also in respect of the quantity of products that have been manufactured, dispatched, received or ordered.

(3) In those cases where infringement is obvious, the obligation to provide information may be imposed by an injunction in compliance with the Code of Civil Procedure.

(4) Such information may only be used in criminal proceedings or in proceedings under the Law on Minor Offenses [Gesetz über Ordnungswidrigkeiten] against the person required to give information, or against a dependent person under Section 52(1) of the Code of Criminal Procedure [Strafprozessordnung], in respect of an act committed before the information was given, with the consent of the person required to give the information.

(5) Further claims to information shall remain unaffected.

[Added by Law of March 7, 1990]

§141.-Actions for infringement of the rights in a patent shall become statute-barred after three years from the time when the claimant obtains knowledge of the infringement and of the identity of the infringer and, irrespective of such knowledge, after 30 years from the infringement. Section 852(2) of the Civil Code [Bürgerliches Gesetzbuch] shall apply mutatis mutandis. If the infringer has obtained anything through the infringement at the expense of the claimant, the infringer shall be liable, even after expiration of the term of limitation, for restitution in accordance with the provisions on the surrender of unjust enrichment.

§142.-(1) Any person who, without the necessary consent of the patentee or the holder of the supplementary certificate of protection (Sections 16a and 49a)

1. makes or offers, puts on the market, uses or imports or stocks for these purposes a product which is the subject matter of a patent or a supplementary certificate of protection (Section 9, second sentence, item 1); or

2. uses or offers for use within the territory to which this Law applies a process which is the subject matter of a patent or a supplementary certificate of protection (Section 9, second sentence, item 2),

shall be liable to imprisonment not exceeding three years or a fine.

The first sentence, item 1, shall also apply if there is a product which has been directly produced by a process which is the subject matter of a patent or a supplementary certificate of protection (Section 9, second sentence, item 3).

(2) Where the offender acts by way of trade, he shall be liable to imprisonment of up to five years or a fine.

(3) The attempt to commit such an offense shall be punishable.

(4) Offenses under subsection (1) shall only be prosecuted on complaint unless the prosecuting authorities deem that ex-officio prosecution is justified in view of the particular public interest.

(5) Objects implicated in an offense may be confiscated. Section 74a of the Penal Code shall apply. Where the claims referred to in Section 140a are upheld in proceedings under the provisions of the Code of Criminal Procedure with regard to compensation of the injured party (Sections 403 to 406c), the provisions on confiscation shall not be of application.

(6) If a penalty is pronounced, the Court shall, at the request of the injured party and if the latter can show a justified interest, order publication of the judgment. The nature of the publication shall be laid down in the judgment.

[Amended by Laws of March 7, 1990 and March 23, 1993]

§142a.-(1) A product that infringes a patent protected under this Law shall be subject, at the request of the holder of the rights and against his security, to seizure by the customs authorities, on import or export, in those cases where the infringement is obvious. This provision shall apply in trade with other Member States of the European Union and with the other Contracting States to the Agreement on the European Economic Area only insofar as controls are carried out by the customs authorities.

(2) Where the customs authorities order a seizure, they shall advise the person entitled to dispose, and also the petitioner thereof without delay. The origin, quantity and place of storage of the product, together with the name and address of the person entitled to dispose, shall be communicated to the petitioner; the secrecy of correspondence and of mail (Section 10 of the Basic Law [Grundgesetz]) shall be restricted to that extent. The petitioner shall be given the opportunity to inspect the product where such inspection does not constitute a breach of commercial or trade secrecy.

(3) Where no opposition to the seizure is made, at the latest within two weeks of service of the notification under the first sentence of subsection (2), the customs authorities shall order confiscation of the seized product.

(4) If the person entitled to dispose opposes seizure, the customs authorities shall inform the petitioner thereof without delay. The petitioner shall be required to declare to the customs authorities, without delay, whether he maintains the request under subsection (1) in respect of the seized copies.

1. If the petitioner withdraws his request, the customs authorities shall lift the seizure without delay.

2. If the petitioner maintains his request and submits an executable court decision ordering the impounding of the seized copies or the limitation of the right to dispose, the customs authorities shall take the necessary measures.

Where neither of the cases referred to in items 1 and 2 is applicable, the customs authorities shall lift the seizure on the expiry of two weeks after service of the notification to the petitioner under the first sentence; where the petitioner can show that a court decision according to item 2 has been requested, but has not yet been received, the seizure shall be maintained for a further two weeks at most.

(5) Where the seizure proves to have been unjustified from the beginning and if the petitioner has maintained the request under subsection (1) in respect of the seized product or has not made a declaration without delay (second sentence of subsection (4)), he shall be required to compensate the damages that seizure has occasioned to the person entitled to dispose.

(6) The petition under subsection (1) is to be submitted to the Regional Finance Office and shall be effective for two years unless a shorter period of validity has been requested; the request may be repeated. The cost of official acts related to the request shall be charged to the petitioner in accordance with Section 178 of the Fiscal Code [Abgabenordnung].

(7) Seizure and confiscation may be opposed by the legal remedies allowed by the fixed penalty procedure under the Law on Minor Offenses in respect of seizure and confiscation. The petitioner shall be heard in the review proceedings. An immediate appeal shall lie from the decision of the Local Court; it shall be heard by the Provincial High Court.

[Added by Law of March 7, 1990 and amended by Law of July 16, 1998]

Part X

Procedure in Patent Litigation

§143.-(1) For all actions whereby a claim arising out of one of the legal relationships regulated in this Law is asserted (patent litigation), the civil chambers of the regional courts shall have exclusive jurisdiction without regard to the value in dispute.

(2) The Governments of the L_{änder} shall have power to allot by statutory order patent litigation for the areas of several regional courts to one such court. The Governments of the L_{änder} may transfer those powers to the provincial administrations of justice.

(3) The parties may also, in cases of patent litigation, be represented before the court by attorneys-at-law admitted to practice in the Landgericht before which the action, in the absence of the arrangement under subsection (2), would be heard. The same shall apply in the case of representation before the Court of Appeal.

(4) Any additional costs incurred by a party arranging to be represented, as provided in subsection (3), by an attorney-at-law not admitted to practice in the court hearing the case shall not be refunded.

(5) Of the costs arising from the collaboration of a patent attorney in the case, fees up to the amount of a full fee according to Section 11 of the Federal Regulations on Fees for Attorneys-at-Law [Bundesgebührenordnung für Rechtsanwälte] shall be refunded, as shall the necessary expenses of the patent attorney.

§144.-(1) If, in a patent case, a party satisfies the court that the awarding of the costs of the case against him according to the full value in dispute would considerably endanger his financial position, the court may, at his request, order that party's liability to pay court costs to be adjusted in accordance with a portion of the value in dispute that shall be appropriate to his financial position. As a result of the order, the favored party shall likewise be required to pay the fees of his attorney-at-law only in accordance with that portion of the value in dispute. To the extent that the costs of the case are awarded against him or to the extent to which he assumes such costs, he shall be required to refund the court fees paid by the opposing party and the fees of the latter's attorney-at-law only in accordance with that portion of the value in dispute. To the extent that the extrajudicial costs are ordered to be paid by the opposing party or are assumed by that party, the attorney-at-law of the favored party may recover his fees from the opposing party in accordance with the value in dispute applying to the latter.

(2) The request under subsection (1) may be declared before and recorded at the registrar's office of the Court. It shall be presented before the substance of the case is heard. Thereafter, it shall only be admissible if the presumed or fixed value in dispute is subsequently increased by the Court. Before the decision on the request is given, the opposing party shall be heard.

§145.-Any person who has brought an action pursuant to Section 139 may bring a further action against the defendant on account of the same or a similar act on the basis of another patent only if, through no fault of his own, he was not in a position to assert that patent also in the earlier suit.

Part XI

Advertising of Patent

§146.-Any person who places on articles or their packaging a marking of such a nature as to create the impression that the articles are protected by a patent or a patent application pursuant to this Law, or any person who uses a marking of such a nature in public notices, on signboards, on business cards or in similar announcements, shall be required to give on demand, to any person having a legitimate interest in knowing the legal position, information as to the patent or patent application upon which the use of the marking is based.

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