

GERMANY
Patent Act

as amended by the Act on Improvement of Enforcement of Intellectual
Property Rights of 31 July 2009

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Part 1 The Patent

Section 1

(1) Patents shall be granted for inventions in any technical field if they are novel, involve an inventive step and are susceptible of industrial application.

(2) Patents shall be granted for inventions within the terms of subsection (1) even if the subject matter concerns a product consisting of or containing biological material or a process by means of which biological material is produced, processed or used. Biological material that has been isolated from its natural environment or produced by means of a technical process may be the subject matter of an invention even if it had previously occurred in nature.

(3) In particular, the following shall not be regarded as inventions within the terms 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 as well as programs for computers;
4. presentations of information.

(4) The provisions of subsection (3) shall constitute a bar to patentability only when protection is sought for said subject matters or activities as such.

Section 1a

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

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

(3) The industrial application of a sequence or a partial sequence of a gene shall have to be specifically disclosed in the application by indicating the function fulfilled by the sequence or partial sequence.

(4) Where the subject matter of an invention is a sequence or a partial sequence of a gene, the structure of which is identical to the structure of a natural sequence or partial sequence of a human gene, the use thereof, for which industrial application is specifically described in subsection (3), shall have to be included in the patent claim.

Section 2

(1) Patents shall not be granted for inventions if their commercial exploitation is contrary to public order or morality; however, such a contravention may not be deduced simply from the fact that the exploitation is prohibited by law or administrative regulation.

(2) Patents shall especially not be granted for

1. processes for cloning human beings;
2. processes for modifying the genetic identity of the germ line of human beings;
3. uses of human embryos for industrial or commercial purposes;
4. processes for modifying the genetic identity of animals, which are likely to cause said animals suffering without any substantial medical benefit to man or said animal, nor shall patents be granted for animals resulting from such processes.

When applying nos. 1 through 3, the corresponding provisions of the Embryo Protection Act [*Embryonenschutzgesetz*] shall be decisive.

Section 2a

(1) Patents shall not be granted for

1. plant or animal varieties or for essentially biological processes for breeding plants or animals;
2. methods for the surgical or therapeutic treatment of the human or animal body or for diagnostic methods used on the human or animal body. This shall not apply to products, in particular substances or substance mixtures, for use in one of the above-mentioned methods.

(2) Patents can be granted for inventions

1. having as subject matter plants or animals if the technical realization of the invention is not restricted to a particular plant or animal variety;
2. having as subject matter a microbiological or other technical process or a product obtained by means of such a process, unless a plant or animal variety is concerned.

Section 1a(3) shall apply *mutatis mutandis*.

(3) In accordance with this Act:

1. "biological material" shall denote any material containing genetic information and capable of reproducing itself or being reproducible in a biological system;
2. "microbiological process" shall denote any process involving the use of or intervention in microbiological material or by which microbiological material results;
3. "an essentially biological process" shall denote any process for breeding plants or animals based entirely on natural phenomena such as crossing or selection;
4. "plant variety" shall denote a variety in accordance with the definition of Regulation (EC) No. 2100/94 of the Council of July 27, 1994 on Community Plant Variety Types (OJ L 227, p. 1) in the valid version.

Section 3

(1) An invention shall be considered to be novel if it does not form part of the state of the art. The state of the art includes all knowledge made available to the public by written or oral description, by use or by any other manner before the date relevant for the priority of the application.

(2) Additionally, state of the art shall also be deemed to be the content of the following patent applications with earlier relevant filing dates which have been made available to the public only on or after the date relevant for the priority of the later application:

1. national applications as originally filed with the Patent Office;
2. European applications as originally filed with the competent authority where protection is sought for the Federal Republic of Germany and if the designation fee for the Federal Republic of Germany has been paid in accordance with Article 79(2) of the European Patent Convention, and if it is an application for a regular European patent based on an international application

(Article 153(2) EPC) that fulfills the conditions set out in Article 153(5) of the European Patent Convention;

3. international applications under the Patent Cooperation Treaty as originally filed with the receiving office when the Patent Office has been designated for the application.

When the earlier date relevant for priority of an application is based on a claim to priority of a prior application, the first sentence of subsection (2) shall be applicable only to the extent that the content of the application to be considered in accordance therewith does not go beyond the content of the prior application. Patent applications under no. 1 of the first sentence of subsection (2), which are the subject of an order under Section 50(1) or (4) of this Act, shall be considered to have been made available to the public upon expiry of the eighteenth month following their filing.

(3) The provisions of subsections (1) and (2) shall not exclude from patentability any substance or substance mixture included in the state of the art when such is intended for use in a process cited in Section 2a(1), no. 2, and its use for such a process is not included in the state of the art.

(4) Where this use is not part of the state of the art, such substances and substance mixtures as cited in subsection (3) for a specific use in one of the processes cited in Section 2a(1), no. 2, shall not be excluded from protection by subsections (1) and (2) either.

(5) With regard to the application of subsections (1) and (2), disclosure of the invention shall not be considered if this occurred no earlier than six months preceding the filing of the application and if this was directly or indirectly

1. due to an evident abuse to the detriment of applicant or his legal predecessor or

2. in consequence of the fact that the applicant or his legal predecessor had displayed the invention at official or officially recognized exhibitions falling within the terms of the Convention on International Exhibitions signed in Paris on November 22, 1928.

Sentence 1, no. 2, shall apply only if the applicant states, when filing the application, that the invention has actually been displayed and if applicant files certification of this within four months following the filing. Notification of the exhibitions

referred to in sentence 1, no. 2, shall be published by the Federal Minister of Justice in the Federal Law Gazette [Bundesgesetzblatt].

Section 4

An invention shall be deemed to involve an inventive step if it is not obvious to a person skilled in the art from the state of the art. Should the state of the art also include documents within the terms of Section 3(2), these documents shall not be considered when assessing the inventive step.

Section 5

An invention shall be deemed to be susceptible of industrial application if its subject matter can be produced or used in any industrial field, including agriculture.

Section 6

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

Section 7

(1) To avoid delay of substantive examination of a patent application owing to the need to determine the identity of the inventor, in the proceedings before the Patent Office the applicant shall be the party deemed entitled to request grant of a patent.

(2) When a patent is revoked by reason of an opposition based on usurpation (Section 21(1), no. 3) or when said opposition results in a waiver of the patent right, the opponent may file an application for the invention within one month after the official notification of said waiver, and claim the priority of the earlier patent.

Section 8

An entitled person whose invention has been applied for by a person not entitled to do so, or a person injured by usurpation, may demand that the patent applicant surrenders to him the right to the grant of a patent. If the application has already resulted in a patent, the entitled person may demand that the patentee assigns the patent

to him. This right may only be asserted, subject to sentences 4 and 5, by legal action within two years of publication of the grant of the patent (Section 58(1)). Should the injured person have filed an opposition on the grounds of usurpation (Section 21(1), no. 3), said injured person may bring the legal action within one year of the final conclusion of the opposition proceedings. The third and fourth sentences shall not apply if the patentee did not act in good faith when obtaining the patent.

Section 9

A patent shall have the effect that the patentee alone shall be authorized to use the patented invention within the applicable laws. A third party 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 from importing or possessing said product for such purposes;
2. from using a process which is the subject matter of the patent, or, when said third party knows or it is obvious from the circumstances that use of the process without the consent of the patentee is prohibited, from offering the process for use within the territory to which this Act applies;
3. from offering, putting on the market or using or importing or possessing for such purposes the product produced directly by a process which is the subject matter of the patent.

Section 9a

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

(2) Where a patent concerns a process that enables a biological material to be produced possessing specific characteristics as a result of an invention, the effects of Section 9 shall extend to the biological material possessing the same characteristics and directly obtained through said process and shall extend to any other biological material derived from the directly obtained biological

material through propagation or multiplication in an identical or divergent form.

(3) Where a patent concerns a product consisting of or containing genetic information as a result of an invention, the effects of Section 9 shall extend to any material in which the product is incorporated and in which the genetic information is contained and performs its function. Section 1a(1) shall not be effected thereby.

Section 9b

Should the patentee or a third party with the consent of patentee put biological material possessing certain characteristics owing to the invention on the market within the territory of a Member State of the European Union or in a contracting state of the European Economic Area Agreement and should further biological material be produced from this biological material by multiplication or propagation, the effects of Section 9 shall not come into force if the propagation of the biological material was the reason why this was put on the market. This shall not apply if the material produced by this means is used thereafter for a further multiplication or propagation.

Section 9c

(1) Where plant propagating material is sold to a farmer for agricultural use by the patentee or with his consent by a third party, said farmer may, contrary to Sections 9, 9a and 9b, sentence 2, use his harvest for his own multiplication or propagation on his own farm. Article 14 of Council Regulation (EC) No. 2100/94, in the valid version, shall apply *mutatis mutandis* to the conditions and extent of this right as shall also the implementing provisions issued on this basis. Should the patentee derive rights herefrom, these must be asserted in accordance with the implementing provisions issued on the basis of Article 14(3) of Council Regulation (EC) No. 2100/94.

(2) Where livestock or animal reproductive material is sold by the patentee, or with his consent by a third party, to a farmer, said farmer may, contrary to Sections 9, 9a and 9b, sentence 2, use said livestock or said animal reproductive material for agricultural purposes. This right shall extend also to the provision of the livestock or other animal reproduction material so as to conduct

said farmer's agricultural activities, however, this shall not extend to sales as part of a commercial reproduction activity or with the intent to commercially reproduce.

(3) Section 9a(1) to (3) shall not apply to biological material which was obtained coincidentally or technically unavoidable as part of an agricultural activity. A farmer may as a rule therefore not be sued if he has planted seeds or seed stock not subject to this patent protection.

Section 10

(1) A patent shall have the further effect that any third party not having the consent of the patentee shall be prohibited from offering or supplying within the territory to which this Act applies to any other persons, other than such persons authorized to use the patented invention, means relating to an essential element of said invention for use of the invention within the territory to which this Act applies, if said third party knows or it is obvious from the circumstances that such means are suitable and intended for use of the invention.

(2) Subsection (1) shall not apply when the means are products generally available in commerce, except if said third party intentionally 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, nos. 1 to 3, shall not be considered within the terms of subsection (1) as persons entitled to use the invention.

Section 11

The effects of a patent shall not extend to:

1. acts done privately for non-commercial purposes;
2. acts done for experimental purposes relating to the subject matter of the patented invention;
 - 2a. the use of biological material for breeding, discovery and development of a new plant variety type;
 - 2b. studies and trials and the resulting practical requirements necessary for obtaining a marketing authorization to place a medicinal product on the market in the European Union or a marketing

approval for a medicinal product in the Member States of the European Union or in third countries;

3. the extemporaneous preparation of medicinal products in individual cases in a pharmacy in accordance with a medical prescription, or acts concerning the medicinal products so prepared;

4. the use of the subject matter of the patented invention on board of vessels of another member state of the Paris Convention for the Protection of Industrial Property, in the body of the vessel, in the machinery, tackle, gear and other accessories, should such vessel temporarily or accidentally enter waters to which the territory of application of this Act extends, on the condition that this subject matter is used exclusively for the needs of said vessel;

5. the use of the subject matter of the patented invention in the construction or operation of aircraft or land vehicles of another member state of the Paris Convention for the Protection of Industrial Property or the use of accessories for such aircraft or land vehicles should these temporarily or accidentally enter the territory to which this Act applies;

6. the acts specified in Article 27 of the Convention on International Civil Aviation of December 7, 1944 (Federal Law Gazette [*Bundesgesetzblatt*], 1956, II, p. 411), where such acts concern the aircraft of another state to which the provisions of that Article are applicable.

Section 12

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

(2) When the patentee is entitled to a priority right, the date of the prior application shall be decisive and not the date of application referred to in subsection (1). However, this provision

shall not apply to nationals of a foreign country that does not guarantee reciprocity in this respect, when said national has claimed the priority of a foreign application.

Section 13

(1) A patent shall have no effect should the Federal Government order that the invention is to be used in the interest of public welfare. Nor shall the effect of a patent extend to any use of the invention ordered in the interests of the security of the Federal Republic by the competent highest federal authority or, on the latter's instructions, by a subordinate agency.

(2) Should an order under subsection (1) be challenged, the Federal Administrative Court [*Bundesverwaltungsgericht*] shall have jurisdiction if said order was issued by the Federal Government or the competent highest federal authority.

(3) In those cases referred to in subsection (1), the patentee shall have a claim against the Federal Republic for reasonable compensation. In the event of dispute as to the 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 used. If the highest federal authority that has issued an order or an instruction under the second sentence of subsection (1) becomes aware that a claim for compensation has arisen under the first sentence, said highest federal authority shall communicate this to the person recorded in the Register as patentee.

Section 14

The scope of protection conferred by a patent or a patent application shall be determined by the patent claims. Nevertheless, the description and drawings shall have to be consulted when interpreting the claims.

Section 15

(1) The right to a patent, the right to the grant of a patent and the rights to be derived from a patent shall pass to the heirs. These rights 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 Act applies. Should a licensee breach a restriction of his license covered by the first sentence, the right conferred by the patent may be asserted against him.

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

Section 16

(1) The duration of a patent shall be 20 years, beginning on the day following the filing of the application for 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, said applicant 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) When the main patent lapses due to revocation, declaration of nullity or due to relinquishment, 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.

Section 16a

(1) Subject to regulations of the European Communities concerning the creation of supplementary protection certificates, notification of which must be made in the Federal Law Gazette [*Bundesgesetzblatt*], supplementary protection may be requested for a patent that shall follow immediately upon the expiry of the term of the patent under Section 16(1). Annual fees shall have to be paid for supplementary protection.

(2) Unless otherwise provided by the laws of the European Communities, the provisions of this Act concerning the entitlement of the applicant (Sections 6 to 8), the effects of the patent and exceptions thereto (Sections 9 to 12), the order to use the patent, and compulsory licenses (Sections 13, 24), scope of protection

(Section 14), licenses and their registration (Sections 15, 30), lapse of the patent (Section 20), nullity (Section 22), willingness to grant licenses (Section 23), domestic representatives (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 122a), reinstatement (Section 123), obligation to abide by the truth (Section 124), electronic documents (Section 125a), the official language, service of documents and legal assistance (Sections 126 to 128), infringements (Sections 139 to 141a, 142a and 142b), concentration of actions and allegation of entitlement to a patent (Sections 145 and 146) shall apply *mutatis mutandis* to supplementary protection.

(3) licenses and declarations under Section 23 that are effective for a patent shall also apply to supplementary protection.

Section 17

(1) For each application and each patent an annual fee for the third year and each subsequent year following the date of filing shall have to be paid.

(2) No annual fees shall have to be paid 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 subject to the proviso that, where an application for a patent of addition is regarded as an application for an independent patent, such annual fees shall have to be paid as will be due for an application that is independent from the outset.

Subsections (3) through (6) deleted.

Sections 18 and 19 (void)

Section 20

(1) A patent shall lapse if

1. the patentee relinquishes it by 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 or the difference are not paid in due time (Section 7(1), Section 13(3) or Section 14(2) and (5) Patent Cost Act [*Patentkostengesetz*], Section 23(7), sentence 4, of this Act).

(2) The decision whether the declarations prescribed under Section 37(1) and the payments have been made in due time shall rest solely with the Patent Office; Sections 73 and 100 shall remain unaffected.

Section 21

(1) A patent shall be revoked (Section 61) if it arises that

1. the subject matter of the patent is not patentable according to Sections 1 through 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 contents of the patent have been taken from the descriptions, drawings, models, appliances or equipment of another, or from a process used by another, without the consent of said person (usurpation);
4. the subject matter of the patent extends beyond the content of the application as originally filed with the authority competent for the filing of the application; the same shall apply if the patent was based 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 authority competent for the filing of the earlier application.

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

Section 22

(1) Nullity of a patent shall be declared on request (Section 81) if it arises that one of the grounds given in Section 21(1) exists or if the scope of the patent has been extended.

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

Section 23

(1) When 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 the use of the invention in return for reasonable compensation, the annual fees falling due for said patent after receipt of the declaration shall be reduced by half. The effect of such 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 and published in the Patent Gazette [*Patentblatt*].

(2) Such a declaration shall be inadmissible if an entry concerning the grant of an exclusive license (Section 30(4)) is recorded in the Register or a request for recordation of such an entry has been filed with the Patent Office.

(3) A person who wishes to use the invention after the declaration has been recorded 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 the registered representative thereof or authorized party for service (Section 25). A statement of how the invention is to be used shall have to be given in the notification. After such notification, the notifying person shall be entitled to use the invention in the manner stated. Said person shall be obliged, at the end of every calendar quarter, to provide the patentee with the particulars of the use that has been made and to pay compensation therefor. If said person fails to meet this obligation in due time, the person recorded in the Register as patentee may grant said notifying person 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 fixed by the Patent Division upon written request by one of the parties. Sections 46, 47 and 62 shall apply *mutatis mutandis* to the proceedings. The request can be directed against several parties. The Patent Office can order, when fixing the compensation, that the costs of the fixing procedure be reimbursed in whole or in part by the adversaries to the request.

(5) After the expiration of one year from the last fixing of the compensation, any party affected thereby may apply for it to be changed if, in the meantime, circumstances have arisen or have become known which show that the amount of compensation fixed is obviously inappropriate. In other respects, the provisions of subsection (4) shall apply *mutatis mutandis*.

(6) Where the declaration has been made in regard to an application, the provisions of subsections (1) through (5) shall apply *mutatis mutandis*.

(7) The declaration may be withdrawn at any time by a written communication to the Patent Office as long as no intent to use the invention has been notified to the patentee. Withdrawal shall take effect upon filing. The amount by which the annual fees have been reduced shall have to be paid within one month after withdrawal of the declaration. Should the difference not be paid within the time limit laid down in sentence 3, it may still be paid with a surcharge for late payment up until expiry of a further time limit of four months.

Section 24

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

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

(2) When the person seeking a license is unable to exploit an invention for which he holds protection under a patent of later date without infringing the patent of earlier date, said person shall be

entitled to the grant of a compulsory license from the owner of the patent of earlier date if

1. the condition stipulated in subsection (1), no. 1, is fulfilled and

2. the invention of said person includes, in comparison with the invention under the patent of earlier date, an important technical progress of considerable commercial significance.

The patentee may request the grant of a counter-license under reasonable conditions by the person seeking a license for the use of the patented invention of later date.

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

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

(5) When a patentee does not work the patented invention or does not work it predominantly in Germany, compulsory licenses under the provisions of subsection (1) may be granted to ensure an adequate supply of the patented product to the domestic market. Importing shall insofar be deemed to constitute working of the patent in Germany.

(6) The grant of a compulsory license to a patent shall become permissible only after the patent has been granted. The license 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 said license has been granted. The patentee shall be entitled to remuneration from the holder of a compulsory license commensurate with the circumstances and taking into consideration the commercial value of the compulsory license. With regard to the recurring remuneration due in the future, should there be a significant change in the circumstances decisive for the determination of the amount of this remuneration, each party shall be entitled to demand 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 demand that the compulsory license be revoked.

(7) A compulsory license to a patent may only be transferred together with the business concerned with the exploitation of the invention. A compulsory license to an invention that is the subject matter of a patent of earlier date may only be transferred together with the patent of later date.

Section 25

(1) A person who has neither domicile nor registered office nor establishment in Germany may take part in proceedings regulated by this Act before the Patent Office or the Patent Court and may assert rights derived from a patent only if he has appointed in Germany an attorney-at-law or a patent attorney as his representative who is authorized to represent said person in proceedings before the Patent Office, the Federal Patent Court, and in civil suits affecting the patent.

(2) Within the terms of subsection (1), citizens of a Member State of the European Union or of any other contracting state of the European Economic Area Agreement may be appointed as representative for services as stipulated in the European Economic Community Foundation Agreement if said representative is entitled to practice his/her profession under one of the professional titles listed in the Annex to Section 1 of the Law Regulating the Activity of European Lawyers in Germany [*Gesetz über die Tätigkeit europäischer Rechtsanwälte in Deutschland*] of 9 March 2000 (Federal Law Gazette [*Bundesgesetzblatt*], I, p. 182) or in Section 1 of the Law on the Exams to be Passed to be Admitted as a Patent Attorney [*Gesetz über die Eignungsprüfung für die Zulassung zur Patentanwaltschaft*] of 6 July 1990 (Federal Law Gazette [*Bundessetzblatt*], I pp 1349, 1351), in the valid versions thereof.

(3) The place where a representative appointed under Subsection (1) has his business premises shall be deemed, within the terms of Section 23 of the Code of Civil Procedure [*Zivilprozessordnung*], to be the place where the asset is located; if there are no business premises, that place where the representative has his/her domicile in Germany shall be relevant and, in the absence thereof, the place where the Patent Office has its seat.

(4) Termination of the appointment of a representative in accordance with subsection (1) by a legal act shall only then become effective if the Patent Office or the Patent Court has been informed of both the termination as well as also the appointment of another representative.

Part 2 The Patent Office

Section 26

(1) The German Patent and Trademark Office is an independent higher federal authority within the portfolio of the Federal Ministry of Justice. It has its seat in Munich.

(2) The Patent Office has a President and other members. These members must possess the qualifications required for judicial office (legal members) under the German Law Relating to Judges [*Deutschen Richtergesetz*] or they must have expertise in a branch of technology (technical members). The members shall be appointed for life.

(3) As a rule, only a person who in Germany has passed a final state or academic examination in a technical or scientific subject at a university, a university of applied science or agricultural university or a mining academy, who has worked professionally for at least five years thereafter in a scientific or technical field 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.

(4) When there is a presumably temporary need, the President of the Patent Office may 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 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.

Section 27

(1) There shall be established in the Patent Office

1. Examining Sections for processing patent applications and for providing information on state of the art (Section 29(3));
2. Patent Divisions for all matters concerning granted patents, for the fixing of compensation (Section 23(4) and (6)) and for the approval of legal aid in proceedings before the Patent Office. Each

Patent Division shall also be responsible for providing opinions (Section 29(1) and (2)) on matters within its competence.

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

(3) The Patent Division shall be competent to make decisions when at least three members participate, who shall include two technical members when the Division handles an opposition procedure. If the case involves particular legal difficulties and if none of the members participating is a legal member, one of the legal members belonging to the Patent Division is to assist in rendering the decision. A decision, by which a request to call in a legal member is refused, cannot be independently appealed.

(4) The presiding member of the Patent Division may alone handle all matters of the Patent Division, with the exception of decisions on maintenance, revocation or limitation of a patent or fixation of compensation (Section 23(4)) 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 civil servants of the higher and intermediate grades as well as comparable employees shall be entrusted with the handling of matters that are the responsibility of the Examining Sections or the Patent Divisions and 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 German Patent and Trademark Office.

(6) As to 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 [*Zivilprozessordnung*] relating to exclusion and challenge of members of a court shall apply *mutatis mutandis*. The same shall apply to civil servants of the higher and intermediate grades 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. When a challenging petition requires a decision, such decision shall be rendered by the Patent Division.

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

Section 28

The Federal Ministry of Justice shall regulate by statutory order not requiring the approval of the *Bundesrat* (body of the German legislature representing the German states) the establishment and the business procedure of the Patent Office and shall determine the form of procedure in patent matters, insofar as provisions therefor have not been made by law.

Section 29

(1) The Patent Office shall be required to provide opinions at the request of the courts or the public prosecutor's office on questions affecting patents if divergent expert opinions have been submitted in proceedings.

(2) In other respects, the Patent Office shall not have the power to render decisions or provide opinions outside its statutory scope of activities without the approval of the Federal Ministry of Justice.

(3) The Federal Ministry of Justice shall have the power, for the purpose of making available to the public the utilization of the documentation of the Patent Office, to prescribe by statutory order, without the approval of the *Bundesrat* (body of the German legislature representing the German states) having to be obtained, that the Patent Office shall provide information on state of the art, without guaranteeing that the information is complete. In this regard, the Federal Ministry of Justice can stipulate in particular the conditions, the manner and the volume of the information to be provided as well as the technical fields involved. The Federal Ministry of Justice may by statutory order delegate such authority to the German Patent and Trademark Office, without the approval of the *Bundesrat* (body of the German legislature representing the German states) being required.

Section 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 protection certificates (Section 16a) and the names and addresses of applicants or patentees and their representatives, possibly appointed under Section 25, or authorized parties for service, whereby it shall suffice to enter either one representative or one authorized party for service. The commencement, expiration, lapse, order of limitation, revocation, declaration of nullity of patents and supplementary protection certificates (Section 16a) as well as the filing of oppositions and nullity actions 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, the name or the address of the applicant or the patentee and of its representative and authorized party for service, if the Patent Office has received proof thereof. As long as the change has not been recorded, the former applicant, patentee, representative or authorized party for service shall remain subject to the rights and obligations as provided in this Act.

(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. The request under the first sentence shall not be admissible as long as willingness to license is declared (Section 23(1)). The entry shall be cancelled upon a request by the patentee or the licensee. The request for cancellation by the patentee shall require proof of the consent of the licensee designated in the entry or of the successor in title of said licensee.

(5) (void)

Section 31

(1) The Patent Office shall permit any person so requesting to inspect the files and the models and samples belonging to said files if and to the extent that a legitimate interest has been credibly

shown. However, any person may freely inspect the Register and the patent files, including the files of limitation or revocation proceedings (Section 64).

(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 of the application (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) When so requested by the inventor designated by the applicant, inspection of the document designating the inventor (Section 37(1)) shall be allowed only in accordance with the first sentence of subsection (1); the fourth and fifth sentences of Section 63(1) shall apply *mutatis mutandis*.

(5) Inspection of the files of patent applications and patents which, pursuant to Section 50, shall not be published in any form, can be permitted by the Patent Office only after hearing the competent highest federal authority if and to the extent a special interest, warranting protection, of the person making the request appears to justify allowing inspection and no risk of serious detriment 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 state of the art, the first sentence shall apply *mutatis mutandis* to the part of the file pertaining to this citation.

Section 32

(1) The Patent Office shall publish

1. laid-open publications [*Offenlegungsschriften*];
2. patent specifications; and
3. the Patent Gazette [*Patentblatt*].

Publication may be in electronic form.

(2) The *Offenlegungsschrift* (laid-open publication) 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 amended form accepted for publication by the Patent Office. An *Offenlegungsschrift* 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 when assessing the patentability of the invention being the subject matter of the application (Section 43(1)). If the abstract (Section 36) has not yet been published, it shall be included in the patent specification.

(4) The *Offenlegungsschrift* or the patent specification shall also be published according to the provisions of Section 31(2) if the application has been withdrawn, rejected, deemed to have been withdrawn or if the patent has lapsed after the technical preparations for publication have been completed.

(5) The Patent Gazette [*Patentblatt*] shall regularly contain summaries of the entries in the Register, except where they concern only the normal expiry of patents or the entry and cancellation of exclusive licenses, and references to the possibility of inspection of patent application files.

Section 33

(1) As of the date of publication of the notification pursuant to Section 32(5), the applicant can demand from that 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 arise if the subject matter of the application is obviously not patentable.

(3) The provisions of Part 5 of Book 1 of the Civil Code [*Bürgerliches Gesetzbuch*] shall apply *mutatis mutandis* to the period of limitation, subject to the proviso that the period of limitation

shall commence at the earliest one year after the grant of the patent. Should the obligated person have gained something due to the infringement and at the cost of the entitled person, Section 852 of the Civil Code shall apply *mutatis mutandis*.

Part 3 Proceedings before the Patent Office

Section 34

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

(2) Applications may also be filed through a Patent Information Center if the Federal Ministry of Justice has designated said Center in an announcement in the Federal Law Gazette [*Bundesgesetzblatt*] as an office to receive patent applications. Applications that may contain a state secret (Section 93 of the Criminal Code [*Strafgesetzbuch*]) may not be filed at a Patent Information Center.

(3) An application shall contain:

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

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

(5) An application may include only one invention or a group of inventions so linked as to form a single general inventive concept.

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

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

(8) 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 should an invention include the use of biological material or concern 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 German Patent and Trademark Office.

Section 34a

Should an invention be based on biological material of plant or animal origin or if such material is used therefor, the patent application is to include information on the geographical origin of such material, if known. This shall not prejudice the examination of applications or the validity of rights arising from granted patents.

Section 35

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

(2) The filing date of a patent application shall be the date on which the documents referred to in Section 34(3), nos. 1 and 2, have been received and, if they contain any statements that would appear to constitute a description, the date on which documents referred to in Section 34(3), no. 4, have been received

1. at the Patent Office; or
2. at a Patent Information Center if said Center has been designated for said purpose in an announcement by the Federal Ministry of Justice in the Federal Law Gazette [*Bundesgesetzblatt*].

Should the documents not be drafted in German, this shall apply only if a German translation is received by the Patent Office within the time limit referred to in the first sentence of subsection (1); if no such translation is filed, 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.

Section 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 as relevant 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 indicating the technical field of the invention drafted in such a manner that it permits a clear understanding of the technical problem, its solution and the main use or uses of the invention;
3. a drawing mentioned in the concise summary; if several drawings are mentioned, that drawing is to be included that, in the opinion of the applicant, most clearly identifies the invention.

Section 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 designate 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, said applicant shall also state how he acquired the right to the patent. The correctness of such statements shall not be verified by the Patent Office.

(2) When the applicant can credibly show that he has been prevented by exceptional circumstances from submitting in due time the declarations prescribed in subsection (1), the Patent Office shall grant said applicant a reasonable extension of the time limit. The time limit should not be prolonged beyond the date of issuance of the decision to grant a patent. If by this date the aforesaid preventative circumstances still exist, the Patent Office shall grant another extension. Six months before expiration of the time limit, the Patent Office shall notify the patentee that the patent

will lapse if he does not submit the prescribed declarations within six months of service of the notification.

Section 38

Up to the time of the decision to grant a patent, the contents of an 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 removal of defects pointed out by the Examining Section or amendments to claims shall be admissible. No rights may be derived from amendments which extend the scope of the subject matter of the application.

Section 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 divided-out 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 retained for each divisional application.

(2) For the period up to division, the same fees which were payable for the original application shall have to be paid for the divisional application. This shall not apply to the fee prescribed by the Patent Cost Act [*Patentkostengesetz*] for a search in accordance with Section 43 if the division was declared prior to the filing of the request for examination (Section 44), unless a request in accordance with Section 43 is filed for the divisional application.

(3) Should the application documents required under Sections 34 through 36 not be filed for the divisional application within three months of receipt of the declaration of division, or if the fees for the divisional application have not been paid within this period, the declaration of division shall be deemed not to have been made.

Section 40

(1) Within a period of 12 months from the filing date of an earlier patent or utility model application filed with the Patent Office, the applicant is entitled to a priority right with respect to the

application for the same invention unless a domestic or foreign priority was already 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 entirety 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 file number of the earlier application is given.

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

(6) If inspection is requested (Section 31) of the file 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.

Section 41

(1) Any person who, in accordance with an international treaty, claims the priority of an earlier foreign application for the same invention shall, before the end of the sixteenth month following the priority date, state the date, country and file number of the earlier application and shall file a copy of the earlier application should such not have already been done. Particulars may be altered within this period. If 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 party to an international treaty 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 [Bundesgesetzblatt], the other state grants a right of priority on the basis of 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.

Section 42

(1) Should an application obviously 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 an application does not comply with the provisions on form or other requirements for applications (Section 34(6)), the Examining Section may refrain from objecting to the defects until the start of the examination procedure (Section 44).

(2) Should the subject matter of an application obviously

1. not, by reason of its nature, constitute an invention;
2. not be susceptible of industrial application;
3. be excluded from grant as a patent under Section 2 or
4. not be directed, in the case of the second sentence of Section 16(1), towards an improvement or further development of another invention,

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

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

Section 43

(1) The Patent Office shall, upon request, ascertain those publications available to the public to be taken into consideration

when assessing the patentability of the invention for which an application has been filed (search). When the search for such publications has been transferred, in part or entirely, to an international institution (subsection (8), no. 1) for all or for certain technical fields, a request may be submitted that the search be conducted in such a way that the applicant can use the result of the search also for a European application.

(2) The request may be filed by the patent applicant, or by a third party who shall not thereby become a participant in the procedure. The request must be filed in writing. Section 25 shall be applied *mutatis mutandis*. 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 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 [*Patentblatt*], but not before publication of the notification pursuant to Section 32(5). If the request is filed by a third party, 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 prejudice the grant of a patent.

(4) The request shall be deemed not to have been filed if a request pursuant to Section 44 had already been filed. In such a 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 as prescribed by the Patent Cost Act paid for the search pursuant to Section 43 shall be refunded.

(5) When 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 apply *mutatis mutandis*.

(6) Where a request filed by a third party is found to be without effect after notification of the applicant (subsection (3), second

sentence), the Patent Office shall also advise the applicant thereof in addition to said third party.

(7) The Patent Office shall notify the applicant regarding the publications ascertained in accordance with subsection (1) and, if the request has been filed by third party, said third party and the applicant, without a guarantee as to completeness, and shall publish in the Patent Gazette [*Patentblatt*] the fact that such notification has been made. If the publications have been ascertained by an international institution and if the applicant has so requested (subsection (1), second sentence), this shall be stated in the notification.

(8) To accelerate the patent granting procedure, the Federal Minister of Justice shall be empowered to direct by statutory order that

1. the search for the publications specified in subsection (1) be assigned to a division of the Patent Office other than the Examining Section (Section 27(1)) or to another national or international institution, either as a whole or for certain technical fields or certain languages, provided that the institution concerned appears competent to search for 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 reciprocal information on the results of examination procedures and searches of the state of the art when the applications concerned relate to inventions for which the grant of a patent has also been applied 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 divisions of the Patent Office other than the Examining Sections or Patent Divisions (Section 27(1)).

Section 44

(1) The Patent Office shall examine on request whether an application complies with the requirements of Sections 34, 37 and 38 and whether the subject matter of said application is patentable under Sections 1 to 5.

(2) The request may be filed by the applicant, or by any third party who will not by this become a participant in the examination

procedure, prior to the expiration of seven years after the filing of the application. The deadline for payment of the examination fee, as prescribed by the Patent Cost Act, shall be three months after the due date (Sec 3(1) Patent Cost Act). This deadline shall, however, end with expiry of the seven years following filing of the application.

(3) When a request pursuant to Section 43 has already been filed, the examination procedure shall begin only after disposal of the request pursuant to Section 43. In other respects, Section 43(2), second, third and fourth sentences, and subsections (3), (5) and (6) shall apply *mutatis mutandis*. If a request filed by a third party is without effect, the applicant 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 [*Patentblatt*] referring to the publication of the request filed by the third party and stating that this request is without effect.

(4) The examination procedure shall be continued even if the request for examination is withdrawn. In the case given in the third sentence of subsection (3), the procedure shall be continued from the point which it had reached at the time the applicant's request for examination was filed.

Section 45

(1) Should an application not satisfy the requirements of Sections 34, 37 and 38 or if the requirements of Section 36 are obviously not fulfilled, the Examining Section shall request the applicant to remedy the defects within a specified time limit. The first sentence shall not apply to defects concerning the abstract if the abstract has already been published.

(2) Should the Examining Section come to the conclusion that the invention is not patentable under Sections 1 to 5, it shall notify the applicant thereof, stating its grounds, and shall invite the applicant to submit observations within a specified time limit.

Section 46

(1) The Examining Section may at any time summon and hear the parties, question witnesses, experts and the parties, whether under oath or not, and may make other inquiries necessary for clarification of the matter. Up until that time when a decision on grant is rendered, the applicant shall be given a hearing on request, where expedient. 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 expedient, it shall reject the request. The decision rejecting a request cannot be independently appealed.

(2) Minutes shall be taken of the hearings and interrogations shall be made that reproduce the essentials of the proceedings and contain those declarations of the participants that are legally relevant. Sections 160a, 162 and 163 of the Code of Civil Procedure [Zivilprozessordnung] shall apply *mutatis mutandis*. The participants shall receive a copy of the minutes.

Section 47

(1) The decisions of the Examining Sections shall be reasoned, in writing and shall be served on the participants *ex officio*. The decisions may also be pronounced at the end of a hearing; the first sentence shall remain unaffected. Reasons need not be given if the applicant is the sole party to the proceedings and his request is allowed.

(2) The written copy shall be accompanied by a statement instructing the parties of the possibility to appeal the decision, of the authority where an appeal may be lodged, of the time limit for lodging an appeal and of the appeal fee. The time limit for lodging an appeal (Section 73(2)) shall commence only when the parties have been instructed in writing. If they have not been instructed or have been incorrectly instructed, an appeal may only be lodged within one year from service of the decision, except where instruction has been given in writing that an appeal is not permissible; Section 123 shall apply *mutatis mutandis*.

Section 48

The Examining Section shall reject an 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 apply.

Section 49

(1) If an application satisfies 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 as relevant for the application, beginning with such earlier date.

Section 49a

(1) Should the person registered as patentee request supplementary protection, the Patent Division shall examine whether the application complies with the relevant Council regulation of the European Communities and with subsection (5) and Section 16a.

(2) If the application satisfies those requirements, the Patent Division shall grant a supplementary protection certificate for the duration of its term. In the contrary case, the Patent Division will 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, the Patent Division shall reject the application by a decision.

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

(4) The Patent Division shall decide by order on the requests provided in the regulations of the European Communities

1. to correct the term of a supplementary protection certificate if the date of the first authorization for marketing a product in the application for the certificate is incorrect;
2. to revoke the extension of the term of a supplementary protection certificate.

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

Section 50

(1) When a patent is sought for an invention which is a state secret (Section 93 of the Criminal Code), the Examining Section shall order *ex officio* that no publication shall take place. The competent highest federal authority shall be heard before the order is issued. This federal authority may request that an order be issued.

(2) The Examining Section shall cancel *ex officio* or at the request of the competent highest 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 for the order under subsection (1) continue to exist. Before an order under subsection (1) is cancelled, the competent highest federal authority shall be heard.

(3) The Examining Section shall notify the parties if no appeal has been lodged within the time limit for appeal (Section 73(2)) against a decision of the Examining Section refusing a request for the issuance 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 country for reasons of national defense and have been entrusted to the Federal Government with its consent and on condition that it maintain secrecy.

Section 51

The Patent Office shall permit the competent highest 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.

Section 52

(1) A patent application containing a state secret (Section 93 of the Criminal Code) may only be filed, outside the territory to which this Act applies, with the written consent of the competent highest federal authority. Consent may be given subject to conditions.

(2) Any person who

1. files a patent 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.

Section 53

(1) Should no order under Section 50(1) be 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, if in doubt as to whether the invention is required to be kept secret (Section 93 of the Criminal Code), that the invention need not be kept secret.

(2) When examination as to whether, in accordance with Section 50(1), publication of an application is not to take place cannot be concluded within the time limit 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.

Section 54

If a patent is granted for 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.

Section 55

(1) An applicant, a patentee or the successor in title thereof who, as a result of an order under Section 50(1), refrains from using or ceases to use an invention patentable under Sections 1 to 5 for peaceful purposes shall have a claim to compensation, owing to the damages thereby incurred, against the Federal Republic if and to the extent that said party cannot reasonably be expected to bear the damages itself. When determining the extent to which said party 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 said party for the invention or for acquiring title thereto, the degree of probability that the

invention might have to be kept secret that could have been recognized by said party at the time the expenditure was incurred, and the profit derived by the injured party from another exploitation of the invention. The claim cannot be asserted until 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) The claim shall be asserted before the competent highest federal authority. Legal action may be instituted before the ordinary civil courts.

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

Section 56

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

Section 57 (void)

Section 58

(1) The grant of a patent shall be published in the Patent Gazette [*Patentblatt*]. The patent specification shall be published at the same time. The legal effects of the patent shall come into force with publication in the Patent Gazette [*Patentblatt*].

(2) If an 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 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 7(1) of the Patent Cost Act), the application shall be deemed to have been withdrawn.

Section 59

(1) Within three months of 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 for revocation 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 opposition brief, be subsequently provided in writing before expiration of the opposition period.

(2) In the event of opposition to a patent, a third party who proves that legal action has been filed against him on the grounds of infringement of said patent may, after the opposition period has expired, intervene in the opposition proceedings as opponent, provided said opponent gives notice of intervention within three months of the date on which the infringement action was instituted. The same shall apply to any third party who proves that, after patentee demands that he cease and desist the alleged infringement, he, has filed a legal action against said patentee requesting a ruling declaring that he is not infringing the patent. Notice of intervention shall be filed in writing and shall state the reasons for said intervention before expiration of the time limit mentioned in the first sentence. The third to fifth sentences of subsection (1) shall apply *mutatis mutandis*.

(3) A hearing shall be held in opposition proceedings if a party requests such a hearing or if the Patent Division considers this to be expedient. The Patent Division should point out in the summons those issues it considers need to be discussed for the decision to be reached.

(4) In other respects, the third sentence of Section 43(3) and Sections 46 and 47 shall apply *mutatis mutandis* in opposition proceedings.

Section 60 (void)

Section 61

(1) The Patent Division shall issue a decision 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 is withdrawn.

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

1. if a party requests the decision and no other party has filed an opposition within two months after service of the request, or

2. upon the request of only one party if at least 15 months have lapsed since expiry of the opposition time limit, or in the case of a request of an intervening party if at least 15 months have lapsed since declaration of intervention.

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

(3) When a patent is revoked or maintained only to a limited extent, this shall be published in the Patent Gazette [*Patentblatt*].

(4) When a patent is maintained to a limited extent, the patent specification shall be correspondingly amended. The amendment of the patent specification shall be published.

Section 62

(1) In its decision according to Sec. 61(1), the Patent Division may at its equitable discretion determine to what extent the costs arising due to a hearing or the taking of evidence shall be borne by a party. This shall also apply if the opposition is withdrawn in part or in full or if the patent is relinquished. The Patent Division can order that the opposition fee, as prescribed by the Patent Cost Act, be reimbursed in full or in part, should this comply with the principles of equity.

(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 claims and rights. The amount of the costs to be reimbursed shall be determined by the Patent Office upon request. The provisions of the Code of Civil Procedure [*Zivilprozessordnung*] relating to the procedure for the fixation of costs (Sections 103 to 107) and execution of

decisions regarding the fixation of costs (Sections 724 to 802) shall apply *mutatis mutandis*. An objection [*Erinnerung*] shall take the place of an appeal [*Beschwerde*] against the decision regarding the fixation of costs; Section 73 is to be applied subject to the proviso that the appeal is lodged within two weeks. The enforceable copy shall be issued by the registrar of the Patent Court.

Section 63

(1) The inventor shall be mentioned in the laid-open publication [*Offenlegungsschrift*] (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 designated. This designation 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. Waiver of his right to be mentioned by the inventor shall have no legal effect.

(2) When 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 designated 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 made. The 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 made in official publications that have already been published.

(4) The Federal Ministry of Justice shall have power to issue by statutory order regulations regarding the implementation of the foregoing provisions. It may delegate this power by statutory order to the German Patent and Trademark Office.

Section 64

(1) A patent may be revoked at the request of the patentee or limited with retroactive effect by amending the patent claims.

(2) The request shall be filed in writing and substantiated.

(3) The Patent Division shall decide on the request. Sections 44(1) and 45 to 48 shall apply *mutatis mutandis*. Should the patent be revoked, this shall be published in the Patent Gazette [*Patentblatt*]. If the patent is limited, the patent specification shall be adapted to the limitation in the decision whereby the request is granted; the amendment of the patent specification shall be published.

Part 4 The Patent Court

Section 65

(1) A Patent Court is established as an autonomous and independent federal court to hear appeals from decisions of the Examining Sections or Patent Divisions of the Patent Office and to decide actions for declaration of nullity of patents and in compulsory license proceedings (Sections 81, 85 and 85a). It has its seat at the seat of the Patent Office. It is designated the "Federal Patent Court".

(2) The Patent Court shall be composed of a president, presiding judges and further judges. They must possess the qualifications required for judicial office (legal members) under the German Law Relating to Judges [*Richtergesetz*] or must be experts in a branch of technology (technical members). Section 26(3) shall apply *mutatis mutandis* for the technical members, provided they have passed a state or academic final examination.

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

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

Section 66

(1) There shall be established in the Patent Court

1. boards for hearing appeals [*Beschwerden*] (Boards of Appeal);
2. boards for deciding actions for declaration of nullity of patents and compulsory license proceedings (Nullity Boards).

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

Section 67

(1) A Board of Appeal shall render decisions in the composition of

1. one legal member as presiding judge and two technical members, in cases under Sections 23(4) and 50(1) and (2);
2. one technical member as presiding judge, two further technical members and one legal member in those cases
 - a) in which an application was rejected,

- b) in which an opposition was dismissed as inadmissible,
 - c) pursuant to Section 61(1), sentence 1, and Section 64(1),
 - d) pursuant to Section 61(2) as well as
 - e) pursuant to Sections 130, 131 and 133;
3. one legal member as presiding judge, an additional legal member and a technical member in cases pursuant to Section 31(5);
 4. three legal members in all other cases.

(2) A Nullity Board shall render decisions in cases pursuant to 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 with a composition of three judges, of whom one must be a legal member.

Section 68

The provisions of Part 2 of the Judiciary Act [Gerichtsverfassungsgesetz] shall apply *mutatis mutandis* to the Patent Court subject to the following:

1. Where an election does not result in a judge, who is a legal member, being elected to the Presiding Board [Präsidium], that legal member shall be considered as elected who obtains the most votes of the legal members;
2. A challenge of an election (Section 21b(6) of the Judiciary Act) shall be decided by a board of the Patent Court consisting of three judges who are legal members;
3. The Federal Minister of Justice shall appoint the permanent substitute for the President.

Section 69

(1) Proceedings before the Boards 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 Act shall apply *mutatis mutandis* subject to the following:

1. At the request of one of the parties, the public may be excluded from the proceedings if the public nature of the proceedings threatens to endanger the interests warranting 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 Boards, including the pronouncement of decisions, shall be public. The second sentence of subsection (1), no. 1, shall apply *mutatis mutandis*.

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

Section 70

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

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

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

Section 71

(1) Commissioned judges may be employed at the Patent Court. The third sentence of Section 65(2) shall apply.

(2) Commissioned judges and delegated judges may not preside.

Section 72

A registrar's office shall be established at the Patent Court, which shall be staffed by the necessary number of registrars. The establishment of the registrar's office shall be determined by the Federal Minister of Justice.

Part 5 Proceedings before the Patent Court

1. Appeal [*Beschwerde*] Proceedings

Section 73

(1) The decisions of the Examining Sections and Patent Divisions may be appealed.

(2) An appeal must be filed in writing with the Patent Office within one month after service of the decision. Copies of the appeal and of all briefs shall be attached for the other parties. The appeal and all briefs containing requests pertaining to the matter or the declaration of withdrawal of the appeal or of a request shall be served *ex officio* upon the other parties; other briefs shall be conveyed informally where service has not been ordered.

(3) Where the authority whose decision is being appealed considers the appeal to be well-founded, it shall rectify its decision. Said authority may order that the appeal fee, as prescribed by the Patent Cost Act, be refunded. If the appeal is not remedied, it shall be remitted to the Patent Court without comment as to its merits before the expiration of one month.

(4) Should the appellant be opposed by another party to the proceedings, the provision of the first sentence of subsection (3) shall not be applicable.

Section 74

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

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

Section 75

(1) An appeal shall have a suspensive effect.

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

Section 76

The President of the Patent Office may, if he considers it appropriate so as to safeguard public interest, submit written statements in appeal proceedings to the Patent Court, be present at hearings and make observations therein. The Patent Court shall provide the parties with any written statements by the President of the Patent Office.

Section 77

The Patent Court may, if it considers it appropriate in connection with a question of law of principal importance, give the President of the Patent Office the opportunity to intervene in appeal proceedings. Upon receipt of the notice of intervention, the President of the Patent Office shall become a party.

Section 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 expedient.

Section 79

(1) An appeal shall be decided by court order.

(2) Where an appeal is not permissible or not lodged in the form provided by law and within the prescribed period, it shall be dismissed as not permissible. The court order may be issued without a hearing.

(3) The Patent Court may reverse the appealed 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 become known which are essential to the decision.

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

Section 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 imposed in full or in part on one of the parties, if 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 claims and rights involved, be reimbursed in full or in part by one of the parties.

(2) Costs may be imposed on the President of the Patent Office only if he has filed requests after his intervention in the proceedings.

(3) The Patent Court may order that the appeal fee, as prescribed by the Patent Cost Act, 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 [*Zivilprozessordnung*] relating to the procedure for the fixation of costs (Sections 103 to 107) and the execution of decisions regarding the fixation of costs (Sections 724 to 802) shall apply *mutatis mutandis*.

2. Nullity and Compulsory License Proceedings

Section 81

(1) Proceedings regarding a declaration of nullity of a patent or a supplementary protection certificate or regarding the grant or withdrawal of a compulsory license or regarding the adaptation of the remuneration determined by a judgment for 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 protection certificate may be joined with an action against the underlying patent and may also be based on the fact that there is a nullity ground with respect to the underlying patent (Section 22).

(2) An action for declaration of nullity of a patent may not be brought as long as opposition may still be filed or opposition proceedings are pending. A legal action requesting declaration of nullity of a supplementary protection certificate may not be filed if requests can be made pursuant to Section 49a(4) or if proceedings deciding these requests 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 to the Patent Court in writing. Copies of the action and of all briefs shall be attached for the adversary. The action and all briefs shall be served on the adversary *ex officio*.

(5) An action shall designate the plaintiff, the defendant and the matter at issue and shall contain a specific request. The facts and evidence used as grounds are to be stated. If the action does not fully comply with these requirements, the presiding judge shall invite the plaintiff to file the necessary supplements within a specified period.

(6) 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 proceedings; Section 110(2), nos. 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 determine a time limit within which said amount shall have to be furnished. If the time limit is not observed, the action shall be deemed to have been withdrawn.

Section 82

(1) The Patent Court shall serve the legal action on the defendant and invite him to respond thereto within one month.

(2) Should the defendant fail to respond in due time, a decision complying with the legal action may be rendered forthwith without a hearing and every fact asserted by the plaintiff may be assumed to be proved.

(3) Should the defendant file a counterstatement within the time limit, the Patent Court shall inform the plaintiff of said counterstatement and shall set a date for a hearing. If the parties agree, a hearing does not need to be held. Subsection (2) shall remain unaffected.

Section 83

(1) In proceedings regarding a declaration of nullity of a patent or a supplementary protection certificate, the Patent Court shall notify the parties as early as possible as to any aspects that might be of particular importance for the decision or that will contribute to concentrating the proceedings on the questions essential for the decision. Such a notification will not be required if the aspects to be discussed appear to be evident from that stated by the parties. Section 139 Code of Civil Procedure shall apply *mutatis mutandis*.

(2) The Patent Court can set a time limit for the parties, within which they may file statements regarding the notification stipulated in subsection (1) by submitting expedient requests or by supplementing their submissions, and within which they may also otherwise file conclusive statements. The time limit can be extended if said party should present considerable reasons for this. These reasons shall have to be credibly shown.

(3) The powers as stipulated in subsections (1) and (2) may also be exercised by the presiding judge or by a member of the Court that has been designated by the presiding judge.

(4) The Patent Court can reject means of attack or defense by one party or an amendment to a legal action or a defendant's defense using an amended version of the patent that have been filed only after expiry of a time limit as stipulated herefor in subsection (2), and the Patent Court can render a decision without any further investigation if

1. considering the new submission would require postponement of the date for the hearing already scheduled and
2. said party has not provided sufficient grounds for the delay and
3. said party was instructed as to the consequences of not observing a time limit.

The reasons given for the excuse will have to be credibly shown.

Section 84

(1) The decision on a legal action shall be rendered in the form of a judgment. A decision on the admissibility of the action may be rendered in the form of an interim judgment.

(2) A decision shall be included in the judgment also on the costs of the proceedings. The provisions of the Code of Civil Procedure [*Zivilprozessordnung*] 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 fixation of costs and execution of decisions regarding the fixation of costs shall apply *mutatis mutandis*. Section 99(2) shall remain unaffected.

Section 85

(1) In proceedings regarding the grant of a compulsory license, the plaintiff may, at his request, be allowed by provisional disposition to use the invention if he credibly shows that the conditions laid down in Section 24(1) to (6) have been met and that an immediate grant of permission is urgently required in the public interest.

(2) The issuance of a provisional disposition can be made dependent on the posting of security by the petitioner due to the detriment facing respondent.

(3) The Patent Court shall render its decision on the basis of a hearing. The provisions of the second sentence of Section 82(3) and of Section 84 shall apply *mutatis mutandis*.

(4) The effect of a provisional disposition shall end with the withdrawal or dismissal of the legal action regarding grant of a compulsory license (Sections 81 and 85a); the decision as to costs may be amended if a party applies for amendment within one month after the withdrawal or after the dismissal becomes final.

(5) Should the issuance of a provisional disposition prove to have been unjustified *ab initio*, petitioner shall be required to compensate the respondent for damages which he has suffered due to the execution of the provisional disposition.

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

Section 85a

(1) The procedures as stipulated in Article 5(c), Article 6, Article 10(8) and Article 16(1) and (4) of the Regulation (EC) No. 816/2006 of the European Parliament and of the Council of 17 May 2006 on compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with public health problems (OJ, L 157, p. 1) shall be instituted by legal action pursuant to Section 81(1), sentence 1.

(2) Where the procedures are not determined by Regulation (EC) No. 816/2006, Sections 81 to 85 are to be applied *mutatis mutandis*.

3. Common Procedural Provisions

Section 86

(1) Sections 41 to 44 and 47 to 49 of the Code of Civil Procedure [Zivilprozessordnung] shall apply *mutatis mutandis* to the exclusion and challenge of members of the Court.

(2) The following shall also be excluded from exercising the office of judge

1. in appeal proceedings, persons who have participated in the previous proceedings before the Patent Office;
2. in proceedings regarding 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 the opposition.

(3) A decision on the challenge of a judge shall be rendered by the board to which the judge who is being challenged belongs. If, as a result of the withdrawal of the member who has been challenged, the board is without a quorum, a board 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 board in whose scope of activities the matter falls.

Section 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 requests to take evidence of the parties.

(2) The presiding judge or a member to be designated by him shall, before the hearing or, in the absence of a hearing, before the decision is rendered by 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 apply *mutatis mutandis*.

Section 88

(1) The Patent Court shall take evidence during the hearing. In particular, it may undertake inspections, examine witnesses, experts and the parties involved and consult 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 regarding evidence, request another court to take such evidence.

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

Section 89

(1) As soon as a date for the hearing has been 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 involved fails to appear, the case may be heard and decided in his absence.

Section 90

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

(2) After the case is called, the presiding judge or the reporting judge shall state the essential content of the files.

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

Section 91

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

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

(3) After the discussion of the case, the presiding judge shall declare the hearing closed. The board may decide to reopen the hearing.

Section 92

(1) A registrar of the Court shall be called to act as recording clerk at the hearing and whenever evidence is taken. If, by order of the presiding judge, no recording clerk is to be called, one of the judges shall record the minutes.

(2) Minutes of the hearing shall be taken and whenever evidence is taken. Sections 160 to 165 of the Code of Civil Procedure shall apply *mutatis mutandis*.

Section 93

(1) The Patent Court shall make its decisions on the basis of its independent conviction reached in the light of the results of the proceedings as a whole. The decision shall state the grounds which determined the judges' conviction.

(2) The decision may be based only on facts and the results of evidence, on which the parties had an opportunity to make representations.

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

Section 94

(1) Final decisions of the Patent Court shall, if a hearing has taken place, be pronounced in the court session in which the hearing was concluded or in a session to be scheduled forthwith. This shall not be scheduled for later than three weeks except when important reasons, in particular the volume or 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) Decisions of the Patent Court by which a request is refused or a decision on a legal remedy is made shall state the grounds upon which the decision is based.

Section 95

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

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

Section 96

(1) Where the statement of facts as set out in the decision contains other mistakes or ambiguities, correction may be requested within two weeks after service of the decision.

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

Section 97

(1) A party may act itself in a lawsuit before the Patent Court. The provisions of Section 25 shall remain unaffected.

(2) A party can be represented by an attorney at law or a patent attorney as authorized representative. In addition, only the following shall have the right to act before the Patent Court as authorized representative:

1. employees of the party or a company affiliated with said party (Section 15 of Companies Act [*Aktiengesetz*]); authorities and legal entities of public law including the combined entities formed by these parties to meet their public duties can also be represented by employees of other authorities or legal entities of public law including the combined entities formed by said parties to meet their public duties,

2. family members of full age (Section 15 of the Fiscal Code [*Abgabenordnung*], Section 11 of the Life Partnership Act [*Lebenspartnerschaftsgesetz*]), persons having the qualifications for judicial office and joint litigants if representation is not in connection with paid actions.

Authorized representatives that are not natural persons shall act through their organs and representatives appointed to legal representation in court.

(3) The Court shall reject by a non-appealable order those authorized representatives who do not have a right to represent under the provisions of subsection (2). Any actions in proceedings by a representative not having a right to represent and any service of process or delivery of notifications to said representative shall be effective until said representative is rejected. The Court can prohibit the representative designated in subsection (2), sentence 2, from any further representation by non-appealable order if said representative is not in a position to present the factual and legal circumstances of the case in an appropriate manner.

(4) Judges may not act as authorized representatives before that Court to which they belong.

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

(6) The lack of a power of attorney may be raised at any stage of the proceedings. The Patent Court shall take into account the lack

of a power of attorney *ex officio*, however, not if an attorney at law or patent attorney acts as the authorized representative.

Section 98 (void)

Section 99

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

(2) The decisions of the Patent Court may only be appealed to the extent permitted under this Act.

(3) Section 31 shall apply *mutatis mutandis* to the grant of permission to a third party to inspect the file of a case. The request for permission shall be decided upon by the Patent Court. Permission to inspect the files of proceedings with regard to a declaration of nullity of a patent shall not be granted if and to the extent that the patentee proves a conflicting interest warranting protection.

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

Part 6 Proceedings before the Federal Court of Justice

1. Procedures regarding Appeals on a Point of Law [against court orders: *Rechtsbeschwerde*]

Section 100

(1) An appeal on a point of law may be filed with the Federal Court of Justice from an order issued by a Board of Appeal of the Patent Court on an appeal under Section 73 or on the maintenance or the revocation of a patent according to Section 61(2) if the Board of Appeal in its order has given leave to appeal on a point of law.

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

1. an issue of law of principal importance is to be decided or
2. the further development of the law or the assurance of consistent case law requires a decision by the Federal Court of Justice.

(3) Leave to appeal on a point of law from an order of a Board of Appeal of the Patent Court shall not be required if one of the following procedural deficiencies is involved and objected to:

1. if the court which rendered the order was not properly constituted;
2. if a judge participated in rendering the order who was excluded by law from exercising the office of judge or was successfully challenged on reasonable grounds of suspicion of partiality;
3. if a party to the proceedings was refused the right to be heard;
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 order was rendered on the basis of a hearing in which the provisions on the public nature of proceedings were violated, or
6. if the order does not state the grounds therefor.

Section 101

(1) Any party to proceedings regarding an appeal shall have the right to lodge an appeal on a point of law.

(2) An appeal on a point of law may only be based on the argument that the court order is based on a breach of the law. Sections 546 and 547 of the Code of Civil Procedure shall apply *mutatis mutandis*.

Section 102

(1) An appeal on a point of law must be lodged in writing with the Federal Court of Justice within one month after service of the court order.

(2) In proceedings regarding an appeal on a point of law before the Federal Court of Justice, the provisions of Section 144 on the fixation of the 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 court order is being appealed and the extent the modification or reversal thereof is requested;
2. an indication of the legal rule breached;
3. where the basis for the appeal on a point of law is the argument that the law in respect of procedure was breached, a statement of the facts constituting the defect.

(5) The parties must be represented before the Federal Court of Justice by an attorney at law admitted to practice before this Court as authorized representative. At the request of any party, said party's patent attorney shall be given leave to speak. Section 143(3) shall apply *mutatis mutandis*.

Section 103

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

Section 104

The Federal Court of Justice shall examine *ex officio* whether an appeal on a point of law is in itself permissible and whether it has been filed and the grounds for the appeal have been stated in the form provided by law and within the prescribed time limit. If any of these requirements is not met, the appeal on a point of law shall have to be dismissed as inadmissible.

Section 105

(1) Where more than one person is party to the proceedings regarding an appeal on a point of law, the notice of appeal and the statement of the grounds for the appeal shall be served on the other parties with the invitation 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 notice of appeal or the statement of the grounds for the appeal.

(2) When the President of the Patent Office is not a party to proceedings regarding an appeal on a point of law, Section 76 shall apply *mutatis mutandis*.

Section 106

(1) In proceedings regarding an appeal on a point of law, the provisions of the Code of Civil Procedure concerning 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) As to the public nature of proceedings, Section 69(1) shall apply *mutatis mutandis*.

Section 107

(1) The decision on an appeal on a point of law shall be rendered by court order; it can be made without a hearing.

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

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

Section 108

(1) In the event of reversal of the appealed court order, the case shall be remanded to the Patent Court for a further hearing and decision.

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

Section 109

(1) Where more than one person is party to the proceedings regarding an appeal on a point of law, the Federal Court of Justice may decide that the costs necessary for the appropriate final disposal of the matter 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 incurred owing to the appeal on a point of law shall be imposed on the appellant. Costs arising from gross negligence by one of the parties shall be imposed on said party.

(2) Costs may be imposed on the President of the Patent Office only if he lodged the appeal on a point of law or filed requests in the proceedings.

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

2. Procedures regarding Appeals [against judgments: *Berufung*]

Section 110

(1) An appeal from a judgment [*Berufung*] of a Nullity Board of the Patent Court (Section 84) can be filed to the Federal Court of Justice.

(2) The appeal [*Berufung*] may be filed by submission of a notice of appeal to the Federal Court of Justice.

(3) The time limit for said appeal shall be one month. It shall commence with service of the full text of the judgment, but at the latest upon expiry of five months after pronouncement.

(4) The notice of appeal shall contain

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

(5) The general provisions of the Code of Civil Procedure regarding the preparatory briefs are to be applied also to the notice of appeal.

(6) The notice of appeal is to be accompanied by an original or a certified copy of the contested judgment.

(7) Orders of the nullity boards shall be subject to appeal only together with their judgments (Section 84); Section 71(3) Code of Civil Procedure shall not apply.

(8) Sections 515, 516 and 521 (1) and (2), sentence 1, Code of Civil Procedure shall apply *mutatis mutandis*.

Section 111

(1) An appeal may be based only on the fact that the decision of the Patent Court was based on a breach of federal law or that such facts to be considered pursuant to Section 117 justify a different decision.

(2) The law is breached if a legal rule has not been applied or not correctly applied.

(3) A decision is always to be considered as based on a breach of the law

1. if the Patent Court was not properly constituted;
2. if a judge participated in the rendering of the decision who was excluded by law from exercising the office of judge unless this bar was unsuccessfully asserted by a challenging petition;
3. if a judge participated in the rendering of the decision although he had been challenged on grounds of suspicion of partiality and the challenging petition was declared to be substantiated;
4. if a party to the proceedings was not represented according to the provisions of law, unless said party expressly or tacitly agreed with the conduct of the proceedings;

5. if the decision was rendered on the basis of a hearing in which the provisions on the public nature of proceedings were violated;
6. if the decision does not state the grounds therefor, contrary to the provisions of the law.

Section 112

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

(2) When not already contained in the notice of appeal, the grounds of the appeal shall be filed in a brief to the Federal Court of Justice. The time limit for submitting the grounds of appeal shall be three months. It shall commence on the date of service of the full text of the judgment, at the latest, however, upon expiry of five months after pronouncement. The time limit may be extended by the presiding judge upon request if the adversary should consent. If adversary should not consent, the time limit may be extended by up to one month if the presiding judge is independently convinced that the lawsuit will not be delayed by the extension or if the appellant can show significant grounds. If the appellant cannot be permitted inspection of the court files for an appropriate time period within this time limit, the presiding judge may extend, upon a request, the time limit by up to two months after the files have been forwarded.

(3) The grounds of appeal shall contain:

1. a statement as to the extent to which the judgment is being appealed and the reversal thereof being requested (appeal requests);
2. stipulation of the grounds of appeal, i.e.
 - a) by presenting the circumstances that gave rise to the breach of a right;
 - b) where the appeal is based on the assertion that the law has been breached with regard to the procedure by presenting the facts resulting in the defect;
 - c) by presenting new means of attack and defense as well as facts, on the basis of which the new means of attack and defense are to be permitted pursuant to Section 117.

(4) Section 110(5) is to be applied *mutatis mutandis* to the grounds of appeal.

Section 113

Parties shall be represented before the Federal Court of Justice by an attorney at law or by a patent attorney as authorized representative. The authorized representative shall be permitted to appear accompanied by a technical advisor.

Section 114

(1) The Federal Court of Justice shall examine *ex officio* whether an appeal is permissible as such and whether it has been filed in the statutory form and within the statutory time limit and grounds were given. 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 by means of a court order.

(3) When an appeal is not dismissed as inadmissible by a court order, a date for the hearing shall be scheduled and the parties advised thereof.

(4) Section 525 Code of Civil Procedure shall apply *mutatis mutandis*. Sections 348 to 350 Code of Civil Procedure are not to be applied.

Section 115

(1) A respondent may file a cross-appeal. Such a cross-appeal shall even then be permissible if the respondent has relinquished his right to appeal or has allowed the deadline for appeal to lapse.

(2) A cross-appeal shall be made by filing the brief announcing the cross-appeal to the Federal Court of Justice, and this must be declared by the end of the two months following service of the grounds of appeal. Where a respondent has been awarded a time limit to respond to an appeal, a cross-appeal shall be permissible up until this time limit expires.

(3) The cross-appeal must be substantiated in the brief announcing said cross-appeal. Sections 110(4), (5) and (8) as well as 112(3) shall apply *mutatis mutandis*.

(4) The cross-appeal shall not be effective if the appeal is withdrawn or dismissed.

Section 116

(1) The Federal Court of Justice shall only examine the requests filed by the parties.

(2) An amendment of a legal action or, in proceedings to declare the nullity of a patent or a supplementary protection certificate, a defense with an amended version of the patent shall only then be admissible if

1. the adversary consents or the Federal Court of Justice considers the amendment of the requests to be expedient and

2. the amended requests can be based on facts which the Federal Court of Justice shall have to use as a basis for its hearing and decision on the appeal pursuant to Section 117.

Section 117

Sections 529, 530 and 531 Code of Civil Procedure shall apply *mutatis mutandis* to the scope of examination by the court of appeal, and to the late-filed, rejected and new means of attack and defense. Section 112 shall take the place of Section 520 Code of Civil Procedure.

Section 118

(1) A judgment by the Federal Court of Justice shall be rendered on the basis of a hearing. Section 69(2) shall apply *mutatis mutandis*.

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

(3) A hearing may be dispensed with if

1. the parties consent; or

2. only the costs are to be decided.

Should none of the parties appear at the hearing, the judgment may be rendered based on the files.

Section 119

(1) Should the grounds of a contested judgment include a breach of the law, but the decision itself is for other reasons correct, the appeal shall have to be rejected.

(2) Should the appeal be considered to be substantiated, the contested judgment shall have to be set aside. Should the judgment be set aside due to a procedural defect, said procedure shall also

have to be discontinued to the extent that it was affected by the defect.

(3) When a judgment is set aside, the matter shall have to be remanded for a new hearing and decision to the Patent Court. The case may be remanded to a different nullity board.

(4) The Patent Court shall also have to base its decision on the legal assessment that was the basis for the reversal.

(5) The Federal Court of Justice may decide the case on its merits where this is expedient. The Federal Court of Justice must decide if a case is ripe for final decision.

Section 120

The decision does not have to be reasoned should the Federal Court of Justice consider the objections to procedural defects to not be valid. This shall not apply to objections pursuant to Section 111(3).

Section 121

(1) The provisions of Section 144 concerning fixation of the value in dispute shall apply *mutatis mutandis* in proceedings before the Federal Court of Justice.

(2) A decision on the costs of the proceedings shall be included in the judgment. The provisions of the Code of Civil Procedure [*Zivilprozessordnung*] concerning the costs of the law suit (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 fixation of costs (Sections 103 to 107) and execution of decisions regarding the fixation of costs (Sections 724 to 802) shall apply *mutatis mutandis*.

3. Procedures regarding Specific Appeals [*Beschwerde*]

Section 122

(1) A specific appeal [*Beschwerde*] may be filed to the Federal Court of Justice appealing a judgment of a Nullity Board of the Patent Court regarding the issuance of a provisional disposition in proceedings relating to the grant of a compulsory license (Sections 85 and 85a). Section 110(7) shall apply *mutatis mutandis*.

(2) The 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 commence with service of the full text of the judgment, but at the latest upon expiry of five months after it has been pronounced.

(4) Sections 74(1), 84 and 110 to 121 shall apply *mutatis mutandis* with respect to the proceedings before the Federal Court of Justice.

4. Common Procedural Provisions

Section 122a

Upon an objection by a party adversely affected by a decision, the proceedings shall be continued if the Court has violated said party's right to be heard in a manner significant for the decision. The objection may not be brought against a decision preceding the final decision. Section 321a(2)-(5) of the Code of Civil Procedure shall apply *mutatis mutandis*.

Part 7 Common Provisions

Section 123

(1) Any person who, through no fault of his own, has been prevented from observing a time limit vis-à-vis the Patent Office or the Patent Court, the failure of observing it being detrimental to his rights according to the provisions of the law, shall, on request, have his rights reinstated. This provision shall not apply to the time limits

1. for filing an opposition (Section 59(1)) or for payment of the opposition fee (Section 6(1), sentence 1, of the Patent Cost Act),
2. allowed an opponent for filing an appeal [*Beschwerde*] against the maintenance of a patent (Section 73(2)) or for payment of the appeal fee (Section 6(1), sentence 1, of the Patent Cost Act) or
3. for filing patent applications for which a priority under Section 7(2) and Section 40 may be claimed.

(2) Reinstatement must be requested in writing within two months after the removal of the impediment. The request shall state the facts justifying the reinstatement; these facts must be credibly shown in the request or in the proceedings concerning the request. The omitted act must be completed 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 omitted act may no longer be completed.

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

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

(5) Any person who, in Germany, has in good faith commenced to use the subject matter of a patent which as a result of reinstatement has re-entered into force, in the period between the lapse and the re-entry into force of the patent or has, in this period, made the necessary arrangements for such purpose, shall be entitled to continue to use the subject matter of the patent for the needs of his own business in workshops of his own or others. This entitlement may only be bequeathed 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 used 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 this period, made the necessary arrangements for such purpose, shall also be entitled in accordance with subsection (5).

Section 123a

(1) When a patent application is rejected after a time limit set by the Patent Office has not been observed, the decision to reject will become ineffective without expressly having to be set aside if the applicant requests the further processing of the application and completes the omitted act.

(2) The request shall be filed within a time limit of one month after service of the decision on rejection of the patent application. The omitted act must be completed within this time limit.

(3) Reinstatement is not possible if the time limit pursuant to subsection (2) or the time limit to pay the further processing fee as prescribed by Section 6(1), sentence 1, of the Patent Cost Act is not observed.

(4) That Section shall decide on the request which must decide on the act to be completed.

Section 124

In proceedings before the Patent Office, the Patent Court and the Federal Court of Justice, the parties shall make their statements on the factual circumstances fully and truthfully.

Section 125

(1) Where an opposition or legal action regarding declaration of nullity of a patent is based on the assertion that the subject matter 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 legal action which are not available at the Patent Office or Patent Court be submitted, with 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 have to be provided when required by the Patent Office or Patent Court.

Section 125a

(1) To the extent that in proceedings before the Patent Office the written form is required for applications, requests and other actions, the provisions of Sections 130a(1), sentences 1 and 3 as well as (3) of Code of Civil Procedure shall apply *mutatis mutandis*.

(2) The case records of the Patent Court and of the Federal Court of Justice may be kept in electronic form. The provisions of the Code of Civil Procedure regarding electronic documents, electronic files and the electronic conduct of proceedings shall apply in other respects unless otherwise provided in this law.

(3) The Federal Ministry of Justice shall determine by a statutory order not requiring approval by the *Bundesrat* (body of the German legislature representing the German states)

1. the date after which electronic documents may be submitted to the Patent Office and the courts, and the form suited for processing the documents and the electronic signature to be used;

2. the date after which the case records pursuant to subsection (2) may be kept electronically as well as the general organizational and technical conditions to be applied here for the formation, processing and storage of the electronic case records.

Section 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 [*Gerichtsverfassungsgesetz*] concerning the language of the courts shall be applicable.

Section 127

(1) Regarding service of documents in proceedings before the Patent Office, the provisions of the Law on Service in Administrative

Procedures [Verwaltungszustellungsgesetz] shall apply, subject to the following:

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 to an addressee who resides abroad and who has not, contrary to the requirement of Section 25, appointed a German representative may be effected by registered letter mailed from a post office. The same shall apply to addressees who are themselves German representatives within the terms of Section 25(2). Section 184(2), sentences 1 and 4, of the Code of Civil Procedure shall apply *mutatis mutandis*;

3. For the purposes of service upon holders of certificates of representation (Section 177 of the Patent Attorney Regulations [Patentanwaltsordnung]), Section 5(4) of the Law on Service in Administrative Procedures shall apply *mutatis mutandis*;

4. Documents may be served on addressees for whom a mail box has been installed at the Patent Office also by depositing the documents in the mail box of the addressee. A written statement regarding the deposit shall be made in 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. (void)

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

Section 128

(1) The courts shall be 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 disciplinary means or coercive means [Ordnungs- oder Zwangsmittel] against witnesses or 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 Board of Appeal of the Patent Court composed of three legal members shall decide on the request under subsection (2). Pronouncement in such a case shall take the form of a court order.

Section 128a

Witnesses shall receive compensation and experts shall receive remuneration according to the Court Payment and Reimbursement Act [*Justizvergütungs- und entschädigungsgesetz*].

Part 8 Legal Aid

Section 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.

Section 130

(1) In proceedings regarding the grant of a patent, an applicant for a patent shall, on request, subject to the application *mutatis mutandis* of 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. Legal aid can also be granted upon the request of the applicant or patentee for the annual fees pursuant to Section 17(1). 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. In other respects, Section 122(1) of the Code of Civil Procedure shall apply *mutatis mutandis*.

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

(4) Where the applicant or patentee is not the inventor or his sole successor in title, legal aid shall be granted only if the inventor also meets the requirements of subsection (1).

(5) On request, as many annual fees shall be included in the legal aid 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 assigned representative, are covered by the payment of the installments. Where the annual fees can be considered as paid by the payment of the installments, Section 5(2) of the Patent Cost Act shall apply *mutatis mutandis*.

(6) In cases specified in Sections 43 and 44, subsections (1) to (3) shall apply *mutatis mutandis* to the third party filing the request if said third party can credibly show a personal interest warranting protection.

Section 131

In proceedings regarding limitation or revocation of a patent (Section 64), the provisions of Section 130(1), (2) and (5) shall apply *mutatis mutandis*.

Section 132

(1) In proceedings regarding opposition (Sections 59 to 62), a patentee shall, on request, be granted legal aid, subject to the application *mutatis mutandis* of Sections 114 to 116 of the Code of Civil Procedure and Section 130(1), second sentence, and (2), (4) and (5). In this respect, it shall not be examined whether the legal defense offers an adequate prospect 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 proceedings regarding nullity of a patent or regarding a compulsory license (Sections 81, 85 and 85a) if the petitioner can credibly show a personal interest warranting protection.

Section 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 conflicting interests is represented by a patent attorney, an attorney at law or a holder of a certificate of representation. Section 121(4) and (5) of the Code of Civil Procedure shall apply *mutatis mutandis*.

Section 134

Should a request for the grant of legal aid in accordance with Sections 130 to 132 be filed prior to the expiration of a time limit prescribed for the payment of a fee, said time limit shall be

interrupted until the expiration of one month after service of the decision on the request.

Section 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 declared and recorded at the registrar's office of the Federal Court of Justice. Section 125a shall apply *mutatis mutandis*.

(2) The decision on a request shall be made by the Section 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 a point of law is precluded. Section 127(3) of the Code of Civil Procedure shall apply *mutatis mutandis* to proceedings before the Patent Court.

Section 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*, and Section 127(2) of the Code of Civil Procedure shall apply subject to the proviso that the appeal is permissible irrespective of the value in dispute. In opposition proceedings and in proceedings to obtain a declaration of nullity of a patent or a compulsory license (Sections 81, 85 and 85a), 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.

Section 137

Legal aid may be withdrawn if the invention filed or protected by a patent, regarding which legal aid was granted, is commercially exploited through transfer, use, licensing or in any other manner, and the income earned thereby has changed the circumstances relevant for the grant of legal aid such that the payment of the costs of proceedings can reasonably be expected of the party concerned; this shall also apply after the expiry of the time limit laid down in Section 124, no. 3, of the Code of Civil Procedure. The party to

whom legal aid has been granted shall be obliged to report on any commercial exploitation of the relevant invention to the authority which made the decision on the grant.

Section 138

(1) In proceedings relating to appeals on a point of law against court orders (Section 100), legal aid shall be granted to a party, upon request, under application of 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 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*, subject to the proviso that only an attorney at law admitted to practice before the Federal Court of Justice may be assigned to a party that has been granted legal aid.

Part 9 Infringements

Section 139

(1) Any person who uses a patented invention in contravention of Sections 9 through 13 may, if there is danger of repetition, be sued by the injured party for injunctive relief. This claim shall also apply if there is a danger of first perpetration.

(2) Any person who intentionally or negligently undertakes such an act shall be liable to the injured party for compensation of the damages incurred thereby. When assessing the damages, the profit which the infringer has made by infringing the right may also be taken into account. The claim for compensation of damages may also be calculated on the basis of the amount the infringer would have had to pay as an adequate remuneration had he obtained the authorization to use the invention.

(3) Where the subject matter of a patent is a process for obtaining a new product, the same product made by another shall, in the absence of proof to the contrary, be deemed to have been made using the patented process. When taking contrary evidence, the legitimate interests of the defendant in protecting his manufacturing and business secrets are to be taken into account.

Section 140

If, prior to the grant of the patent, rights based on an application, the files of which may be inspected by any person (Section 31(1), second half of sentence 2, and (2)), are asserted in court proceedings, and if deciding the lawsuit depends on whether there is a claim under Section 33(1), the court may order that the proceedings be stayed until a decision on grant of the patent is rendered. If a request for examination has not been filed pursuant to Section 44, the court must, upon the request of the adversary, set a time-limit to the party claiming rights from the application for filing the request for examination. If the request for examination is not filed within said time-limit, the rights derived from the application may not be asserted in the lawsuit.

Section 140a

(1) Any person who uses a patented invention in contravention of Sections 9 through 13 may be sued by the injured party for

destruction of the products in the possession or ownership of the infringer that are the subject matter of the patent. The provision of sentence 1 is also to be applied if said products have been directly made by a process that is a subject matter of the patent.

(2) The provisions of subsection (1) are to apply *mutatis mutandis* to the materials and apparatuses in the ownership of the infringer that served predominantly to make these products.

(3) Any person who uses a patented invention in contravention of Sections 9 through 13 can be sued by the injured party for recall of the products that are a subject matter of the patent or for their definitive removal from the distribution channels. The provision of sentence 1 is also to be applied where products are concerned that have been directly made by a process that is a subject matter of the patent.

(4) The claims pursuant to subsections (1) through (3) shall be precluded if in the specific case such a claim is disproportionate. When assessing proportionality, the legitimate interests of third parties shall also be taken into account.

Section 140b

(1) Any person who uses a patented invention in contravention of Sections 9 through 13 may be sued by the injured party for prompt information as to the origin and the distribution channel of the products used.

(2) In cases where the infringement is obvious or in cases where the injured party has filed a legal action against the infringer, the claim also applies, irrespective of subsection (1), against any person that, on a commercial scale,

1. had infringing products in its possession,
2. made use of infringing services,
3. provided services used for infringing acts, or
4. participated, according to the statement of one of the persons referred to in nos. 1, 2 or 3, in the manufacture, production or distribution of said products or the provision of said services, except if said person is entitled to refuse to give evidence against the infringer in the lawsuit pursuant to Sections 383 to 385 Code of Civil Procedure. If the claim to information provided for in

sentence 1 is asserted in court, the court may, upon request, stay the lawsuit pending against the infringer until the lawsuit regarding the claim to information is disposed of. The person required to provide information can demand from the injured party reimbursement of the expenditures required for providing said information.

(3) The person required to provide information must specify

1. the names and addresses of the manufacturers, suppliers and other previous possessors of the products or users of the services as well as the commercial customers and sales outlets, for which said products were intended, and

2. the quantities of products manufactured, delivered, received or ordered as well as the prices paid for the respective products or services.

(4) The claims pursuant to subsections (1) and (2) shall be precluded if in the specific case such a claim is disproportionate.

(5) Where the person required to provide information intentionally or with gross negligence provides information that is incorrect or incomplete, said person shall be liable to compensate the injured party for any damages incurred due to this.

(6) The person that has provided correct information without being required to do so pursuant to subsections (1) or (2) shall be liable vis-à-vis a third party only if said providing person knew that he was not required to provide the information.

(7) In such cases where the infringement of a right is obvious, the requirement to provide information can be ordered by a provisional disposition pursuant to Sections 935 to 945 of the Code of Civil Procedure.

(8) Such knowledge may be used against the person required to give information or against a relative as indicated in Section 52(1) of the Code of Criminal Procedure in criminal proceedings or in proceedings under the Regulatory Offences Act (*Gesetz über Ordnungswidrigkeiten*) prosecuted with regard to an act committed before the information was provided only with the consent of the person required to give the information.

(9) Where the information can only be provided by use of communication data (Section 3, No. 30, of the Law on Telecommunications), a prior court order regarding the admissibility of the use of the communication data shall be required, to be requested by the injured party. The Regional Court in the district where the party required to provide information has its domicile, its seat or branch office shall have exclusive jurisdiction for the issuance of this order, irrespective of the value in dispute. The decision shall be rendered by the civil chamber. The rules and provisions of the Act Relating to Matters of Non-contentious Jurisdiction (*Gesetz über die Angelegenheiten der freiwilligen Gerichtsbarkeit*) shall apply *mutatis mutandis* to this procedure, with the exception of Section 28(2) and (3). The costs of the court order shall be borne by the injured party. The decision of the Regional Court may be appealed by an immediate appeal to the Higher Regional Court. The sole admissible basis for such an immediate appeal shall be a point of law. The decision of the Higher Regional Court shall be final. In other respects, the rules and provisions regarding protection of personal data shall not be affected.

(10) The basic right to secrecy of telecommunications (Article 10 of the Basic Constitutional Law) is restricted by subsection (2) in conjunction with subsection (9).

Section 140c

(1) A person who, with sufficient degree of certainty, uses a patented invention in contravention of Sections 9 to 13 can be sued by the right-holder or by another authorized party for production of a document or inspection of an object which is at said person's disposal, or inspection of a process that is the subject matter of the patent, if this is required to substantiate the right holder's or other authorized party's claims. If there is sufficient certainty of an infringement committed on a commercial scale, the claim shall also extend to the production of bank, financial or commercial documents. Should the presumed infringer assert that the information is confidential, the court shall take the necessary steps to ensure the proper protection in the specific case.

(2) The claim pursuant to subsection (1) shall be precluded if it is disproportionate in the specific case.

(3) The obligation to produce a document or to accept inspection of an object may be ordered by a provisional disposition pursuant to Sections 935 to 945 Code of Civil Procedure. The court shall take the necessary steps to ensure protection of confidential information. This shall apply in particular when the provisional disposition is issued without a prior hearing of the adversary.

(4) Section 811 Civil Code as well as Section 140b(8) shall apply *mutatis mutandis*.

(5) Where there was no infringement or threat of infringement, the presumed infringer may demand from the person that has requested production or inspection pursuant to subsection (1), compensation of the damages he has incurred due to the request.

Section 140d

(1) In the case of an infringement committed on a commercial scale, the injured party may sue the infringer in the cases stipulated in Section 139(2) also for production of bank, financial and commercial documents or for suitable access to the corresponding documents which are at the disposal of the infringer and are required to enforce the claim to compensation of damages if, without said production, satisfaction of the claim to compensation of damages might be questionable. Should the infringer assert that the information is confidential, the court shall take the necessary steps to ensure the proper protection in the specific case.

(2) The claim pursuant to subsection (1) shall be precluded if it is disproportionate in the specific case.

(3) The obligation to produce the documents stipulated in subsection (1) may be ordered by a provisional disposition pursuant to Sections 935 to 945 Code of Civil Procedure, if the claim to compensation of damages obviously exists. The court shall take the necessary steps to ensure protection of confidential information. This shall apply in particular in those cases when the provisional disposition is issued without prior hearing of the adversary.

(4) Section 811 Civil Code as well as Section 140b(8) shall apply *mutatis mutandis*.

Section 140e

When a legal action has been brought on the basis of this Act, it may be ordered in the judgment in favor of the prevailing party that said party may make the judgment public at the expense of the losing party, if the prevailing party can show a legitimate interest therein. The type and extent of publication shall be determined in the judgment. The permission shall expire if use is not made thereof within three months after the judgment becomes final. Said pronouncement pursuant to sentence 1 shall not be provisionally enforceable.

Section 141

As regards the period of limitation for claims due to infringement of a patent right, the provisions of Part 5 of Book 1 of the Civil Code shall apply *mutatis mutandis*. If the infringer has gained something through the infringement at the expense of the entitled party, Section 852 of the Civil Code shall be applicable *mutatis mutandis*.

Section 141a

Claims based on other statutory provisions shall not be affected hereby.

Section 142

(1) Any person shall be punished by imprisonment not exceeding three years or by a fine, who, without the required consent of the patentee or of the owner of a supplementary protection certificate (Sections 16a, 49a),

1. makes or offers, puts on the market, uses or imports or possesses for said purposes a product which is the subject matter of the patent or of the supplementary protection certificate (Section 9, sentence 2, no. 1); or

2. uses or offers for use within the territory to which this Act applies a process which is the subject matter of the patent or of the supplementary protection certificate (Section 9, sentence 2, no. 2);

The provision of sentence 1, no. 1, is also to be applied if the product has been directly made by a process which is the subject matter of the patent or of the supplementary protection certificate (Section 9, sentence 2, no. 3).

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

(3) The attempt is punishable.

(4) In the cases referred to in subsection (1), the act shall only be prosecuted on demand, unless the criminal prosecution authority deems that prosecution *ex officio* is justified due to a particular public interest.

(5) Objects to which the criminal act relates may be confiscated. Section 74a of the Criminal Code shall apply. Where the claims referred to in Section 140a are granted in proceedings under the provisions of the Code of Criminal Procedure (*Strafprozessordnung*) regarding compensation of the injured party (Sections 403 to 406c), the provisions on confiscation shall not be applied.

(6) When a penalty is imposed, the court shall, at the request of the injured party and if the latter can show a legitimate interest, order publication of the judgment. The form of publication shall be determined in the judgment.

Section 142a

(1) A product that infringes a patent protected by this Act shall be subject upon import or export, upon the application of the right holder and upon his posting of security, to seizure by the customs authorities when infringement is obvious and if Council Regulation (EC) No. 1383/2003 of 22 July 2003 Concerning Customs Action against Goods Suspected of Infringing Certain Intellectual Property Rights and the Measures to be Taken against Goods Found to Have Infringed Such Rights (OJ, L 196, p. 7), in the valid version, is not to be applied. This shall apply in trade with other Members States of the European Union as well as with the other contracting states of the European Economic Area Agreement only insofar as controls are carried out by the customs authorities.

(2) If the customs authorities order a seizure, they shall advise the person entitled to dispose of the product and also the applicant without delay. The origin, quantity and place of storage of the product, together with the name and address of the person entitled to dispose of the product, shall be communicated to the applicant;

the right to secrecy of correspondence and of mail (Article 10 of the Basic Constitutional Law) shall be restricted to that extent. The applicant shall be given the opportunity to inspect the product where such inspection does not constitute a breach of trade or business secrets.

(3) When no objection to the seizure is filed 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) Should the person entitled to dispose of the product object to the seizure, the customs authorities shall inform the applicant thereof without delay. The applicant shall declare to the customs authorities without delay whether he will maintain the application under subsection (1) in respect of the seized product.

1. If the applicant withdraws his application, the customs authorities shall lift the seizure without delay.

2. If the applicant maintains his application and submits an enforceable court decision ordering the impounding of the seized product or limitation of the right to dispose thereof, the customs authorities shall take the necessary measures.

Where neither of the cases referred to in nos. 1 and 2 are applicable, the customs authorities shall lift the seizure after expiry of two weeks after service of the notification to the applicant under the first sentence; should the applicant show that a court decision according to no. 2 has been requested, but has not yet been received, the seizure shall be maintained for a further two weeks at the most.

(5) Where the seizure proves to have been unjustified from the outset and if the applicant has maintained the application under subsection (1) with respect to the seized product or has not made a declaration without delay (second sentence of subsection (4)), said applicant shall be required to compensate the damages that the party entitled to dispose of the product has incurred owing to seizure.

(6) The application under subsection (1) must be submitted to the Federal Finance Directorate [*Bundesfinanzdirektion*] and shall be effective for one year unless a shorter period of validity has been applied for; it may be repeated. The costs of the official acts

related to the application shall be charged to the applicant in accordance with Section 178 Fiscal Code (*Abgabeordnung*).

(7) Seizure and confiscation may be challenged with the legal remedies allowed in administrative penalty procedures under the Regulatory Offences Act (*Gesetz über Ordnungswidrigkeiten*) with respect to seizure and confiscation. The applicant shall be heard in the legal remedy proceedings. An immediate appeal against the decision of the Local Court (*Amtsgericht*) is admissible; it shall be heard by the Higher Regional Court.

Section 142b

(1) If the competent customs authority detains or suspends the release of goods pursuant to Article 9 of Council Regulation (EC) No. 1383/2003, said authority shall immediately inform the right holder of this action as well as the applicant or the possessor or the owner of the goods.

(2) In the case as stipulated in subsection (1), the right holder can request that the goods be destroyed using the simplified procedure described below, as laid down in Article 11 of Council Regulation (EC) No. 1383/2003.

(3) The request must be submitted in writing to the customs authority within ten working days or, in the case of perishable goods, within three working days after receipt of the notification as stipulated in subsection (1). Said request must state that the goods being the subject of said procedure infringe a right protected by this Act. The written consent of the declarant, the possessor or the owner of the goods to destruction of the goods must be included. Notwithstanding sentence 3, the declarant, the possessor or the owner can directly declare to the customs authority in writing whether he consents to the destruction. The time limit given in sentence 1 can, before expiry, be extended upon request of the right-holder by ten working days.

(4) Agreement to destruction shall be presumed to be granted when the declarant, the possessor or the owner of the goods has not opposed destruction within ten working days or, in the case of perishable goods, within three working days after receipt of the

notification pursuant to subsection (1). This fact must be pointed out in the notification pursuant to subsection (1).

(5) Destruction of the goods shall be at the expense and under the responsibility of the right holder.

(6) The customs office can organize said destruction. Subsection (5) shall remain unaffected.

(7) The storage period pursuant to Article 11(1), second indent, of Council Regulation (EC) No. 1383/2003 shall be one year.

(8) In other respects, Section 142a shall apply *mutatis mutandis* should Council Regulation (EC) No. 1383/2003 not contain provisions to the contrary.

Part 10 Patent Litigation Proceedings

Section 143

(1) For all legal actions whereby a claim arising from one of the legal relationships regulated by this Act is asserted (patent dispute case), the civil chambers of the Regional Courts shall have exclusive jurisdiction without regard to the value in dispute.

(2) The governments of the federal states [*Länderregierungen*] shall have power to assign by statutory order the patent dispute cases in the districts of several Regional Courts to one such Regional Court. The governments of the federal states may transfer these powers to the state administrations of justice [*Landesjustizverwaltungen*]. The federal states can moreover transfer, by agreement, the functions of the courts of one federal state in their entirety or in part to the competent court of another federal state.

(3) Of the costs arising from the participation of a patent attorney in a legal action, fees according to Section 13 of the German Attorneys at Law Remuneration Act [*Rechtsanwaltsvergütungsgesetz*] shall be refunded, as shall the necessary expenses of the patent attorney.

Section 144

(1) When, in a patent dispute case, a party credibly shows the Court that imposition of the costs of the lawsuit against him according to the full value in dispute would considerably endanger its economic situation, the Court may, at the request of said party, order that this party's obligation to pay court costs be adjusted to accord with a portion of the value in dispute appropriate to its economic situation. As a result of the order, the favored party shall likewise be required to pay the fees of its attorney at law only in accordance with said portion of the value in dispute. To the extent that the costs of the lawsuit are imposed on said party or where said party accepts such costs, said party shall be required to reimburse the court fees paid by the adversary and the fees of the latter's attorney at law only in accordance with said portion of the value in dispute. To the extent that the extrajudicial costs are ordered to be paid by the adversary or are assumed by that party, the attorney at law of the favored party may recover his fees from

the adversary in accordance with the value in dispute applicable to said adversary.

(2) The request under the provisions of subsection (1) may be declared and recorded at the registrar's office of the Court. It shall be submitted before the main issues of the proceedings are 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 rendered, the adversary shall be heard.

Section 145

Any person who has brought a legal 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, said person was not able to assert also said patent in the earlier law suit.

Part 11 Allegation of Entitlement to a Patent [*Patentberühmung*]

Section 146

Any person who places on articles or their packaging a designation of such a nature as to create the impression that the articles are protected by a patent or a patent application pursuant to this Act, or any person who uses a designation of such a nature in public advertisements, on signboards, on with-compliment cards or in similar announcements shall be required to give, on demand, to any person having a legitimate interest in knowing the legal situation, information as to the patent or patent application upon which the use of said designation is based.

Part 12 Transitional Provisions

Section 147

(1) Article 229, Section 6, of Introductory Act to the Civil Code [*Einführungsgesetz zum Bürgerlichen Gesetzbuch*] shall be applied *mutatis mutandis*, subject to the proviso that Section 33(3) and Section 141 of this Act in the version valid until 1 January 2002 shall have equal status as the provisions of the Civil Code regarding periods of limitation in the version valid until 1 January 2002.

(2) The provisions of this Act in the version valid until 30 September 2009 shall continue to apply to proceedings in regard to declaration of nullity of a patent or a supplementary protection certificate or to grant or withdrawal of a compulsory license or in regard to adaption of reimbursement for a compulsory license as fixed by judgment that were instituted before 1 October 2009 by filing a legal action to the Federal Patent Court.

(3) (void)