

Pitz / Kawada / Schwab

**Patent Litigation
in Germany, Japan and
the United States**

C. H. Beck • Hart • Nomos

Pitz/Kawada/Schwab

Patent Litigation in Germany, Japan and the United States

Patent Litigation in Germany, Japan and the United States

by

Johann Pitz
Atsushi Kawada
Jeffrey A. Schwab

2015

C.H. BECK · Hart · Nomos

Published by

Verlag C. H. Beck oHG, Wilhelmstraße 9, 80801 München, Germany,
eMail: bestellung@beck.de

Co-published by

Hart Publishing, 16C Worcester Place, Oxford, OX1 2JW, United Kingdom,
online at: www.hartpub.co.uk

and

Nomos Verlagsgesellschaft mbH & Co. KG Waldseestraße 3–5
76530 Baden-Baden, Germany
eMail: vertrieb@nomos.de

Published in North America (US and Canada) by Hart Publishing,
c/o International Specialized Book Services, 930 NE 58th Avenue, Suite 300,
Portland, OR 97213-3786, USA, eMail: orders@isbs.com

ISBN 978 3 406 65075 8 (Beck)
ISBN 978 1 84946 195 5 (Hart Publishing)
ISBN 978 3 8487 0302 9 (Nomos)

© 2015 Verlag C. H. Beck oHG
Wilhelmstr. 9, 80801 München
Printed in Germany by
fgb · freiburger graphische betriebe GmbH & Co. KG
Bebelstraße 11, 79108 Freiburg

Typeset by
Reemers Publishing Services GmbH, Krefeld

All rights reserved. No part of this publication may be reproduced, stored in a retrieval system, or transmitted, in any form or by any means, without the prior permission of Verlag C. H. Beck, or as expressly permitted by law under the terms agreed with the appropriate reprographic rights organisation. Enquiries concerning reproduction which may not be covered by the above should be addressed to C. H. Beck at the address above.

Preface

Patent systems in leading industrial nations like Germany, Japan and the United States have an important impact on research development and product commercialization.

The elaboration and further refinement of efficient patent litigation proceedings in these jurisdictions is of utmost importance in order to guarantee powerful enforcement of patent rights.

Practitioners with a multinational focus on patent disputes will have to be aware about the specific legal conditions in the various countries.

The book provides a comparative overview on patent law and patent litigation proceedings in Germany/Europe, Japan and the United States. The systematic presentation of the legal systems including comprehensive references reveals differences and similarities.

Munich, October 2014

Johann Pitz

Authors

Dr Johann Pitz, attorney at law and patent litigator, Vossius and Partner, Munich

Atsushi Kawada, attorney at law and patent attorney, Tokyo

Jeffrey A. Schwab, patent attorney who specializes in IP litigation, licensing, ADR, and advertising law, New York

Contents

Preface	V
Authors	VII
Abbreviations	XI
Selected Bibliography	XV
Part 1. Survey	1
I. The European Patent litigation system	1
1. National patent enforcement	1
(1) Forum shopping	1
(2) Overview of German judicial system for patent infringement procedure	1
(2-1) Court system	1
(2-2) Procedure	2
(2-3) The dual system	2
(2-4) Time to trial	3
(2-5) Likelihood of success	3
(2-6) Final remedies	3
(3) Cross-border enforcement and “torpedo actions”	4
2. The Unitary Patent system	5
II. The Japanese patent litigation system	7
1. Overview of Japanese judicial system for patent infringement procedure	7
(1) “Double track” system and concentration of jurisdiction for patent disputes	7
(2) Number of patent litigations in Japan – Statistics	9
2. Overview of Japanese court procedure for patent infringement cases	9
(1) Litigation fee and attorney’s reward	9
(2) Complaint	10
(3) Course of proceedings	10
(4) Judgements	11
(5) Appeals	12
III. The U.S. patent litigation system	12
Part 2. Matter of infringement	17
I. Germany	17
1. Scope of protection	17
(1) Literal and non-literal infringement	17
(2) Doctrine of equivalents	18
(2-1) Requirements of equivalents	18
(2-2) “Formstein Defense”	19
(3) Basic principles for the determination of the scope of protection	20
(3-1) The wording of claims	20
(3-2) The person skilled in the art is relevant for claim interpretation	20
(3-3) File history	20
(3-4) The effect of emphasizing particular features of a patent claim in the description	21
(3-5) The extent of protection of a patent claim containing numerical data and ranges	22
(3-6) Time of equivalence determination	22
2. Direct patent infringement	23
(1) Product patent	23
(2) Process patent	23
(3) Product by process patent	23
3. Indirect patent infringement	24
(1) General principles	24
(2) Material requirements	24
II. Japan	26
1. Scope of protection of the patent in action	26
(1) Literal scope of claim	26
(1-1) Description and drawings	26
(1-2) Prior art	27
(1-3) Prosecution history	27

Contents

(1-3-1) Prosecution History as a means for interpretation	28
(1-3-2) Prosecution history as a reason for estoppel	28
(2) Doctrine of equivalents	28
(2-1) “Ball Sprine” judgement	28
(2-2) Requirement No. 1 – replacement of unessential element	29
(2-3) Requirement No. 2 – identical function and effect despite replacement	30
(2-4) Requirement No. 3 – obviousness of replacement at the time of infringing	31
(2-5) Requirement No. 4 – objection of free technology	31
(2-6) Requirement No. 5 – objection of intentional exclusion	31
(2-7) Patented inventions containing numerical ranges	32
2. Direct infringement	32
3. Indirect infringement	33
(1) Old types of provisions against indirect infringements	34
(2) New types of provisions against indirect infringements	34
(3) Indirect infringement in the practice	35
III. USA	35
1. Scope of protection	35
(1) The wording of the claims	35
(2) Claim interpretation	35
2. Direct patent infringement	36
(1) Requirements of equivalents	36
(2) Time of equivalents determination	37
(3) Equivalency and the prior art	37
(4) Equivalency and file history estoppel	37
3. Indirect patent infringement – active inducement	38
(1) Active inducement	38
(2) Contributory infringement	38
(3) Infringement through the supply of components from United States for combinations made abroad	38
(4) Infringement by sale, offer for sale, use or importation of a product made outside the United States by a patented process	39
4. Types of patents	39
(1) Product patents	39
(2) Process patents	39
(3) Product by process patent	39
Part 3. Fact Finding	41
I. Germany	41
1. Test-purchase	41
2. Product analyses and private expertises	41
3. Inspection claim	41
4. Seizure by customs authorities	42
5. Information claim	43
6. Investigation by public prosecutors	43
7. Professional confidentiality obligations	43
II. Japan	44
1. Test purchase	44
2. Product analyses and private expertises	44
3. Procedural measures for collecting information about infringement	44
(1) Preservation of evidence	45
(1-1) Prerequisites and proceeding for preservation of evidences	45
(1-2) Preservation of documents	45
(1-3) Preservation of subject matters for observation	45
(2) Disposition of collection of evidence before filing an action	46
4. Seizure by customs authorities	46
5. Preliminary proceedings with public prosecutors	46
III. USA	47
1. Pre-filing investigation (FRCP Rule 11)	47
2. Product analysis	47
3. Pre-filing discovery	48
4. Seizure by custom authorities	48
5. Government participation in the proceedings	49

Part 4. Claims of the patent holder and objections of the infringer	51
I. Legal basis for claims	51
1. Germany	51
(1) Injunctive relief	51
(2) Rendering account	51
(3) Obligation to pay damages	52
(3-1) Basic principles	52
(3-2) Calculation of damages	52
(3-2-1) Patentee's lost profits	52
(3-2-2) Infringer's profits	53
(3-2-3) Hypothetical license fee	53
(3-2-4) Relations between the calculation methods	54
(4) Disclosure of the source of origin and of purchasers	54
(5) Destruction	54
(6) Removal of infringing goods	54
(7) Costs	54
2. Japan	54
(1) Claim for injunction	54
(1-1) Patent holder	54
(1-2) Licensee	55
(2) Claim for compensation for damages	55
(2-1) Overview	55
(2-1-1) Legal basis of claim for compensation of damages caused by infringement	55
(2-1-2) Claimant for compensation for damages	55
(2-1-3) Judicial practice for claiming the compensation for damages	56
(2-1-4) Prerequisites for claiming the compensation of damages	56
(2-2) Calculation of damages	57
(2-2-1) Patent holder's lost profits	57
(2-2-2) Patent holder's profits estimated from the quantity of infringer's products	57
(2-2-3) Patent infringer's profits	59
(2-2-4) Licence analogy	60
(2-2-5) Relations between these alternatives for calculation of damages	60
(3) Claim for compensation for the use of an opened invention before grant of patent	61
(4) Other claims	61
(4-1) Procedural claims for submission of documents	61
(4-2) Claim for measures preventing further infringement	62
(4-3) Claim for costs	62
3. USA	62
(1) Injunctive relief	62
(2) Accounting and monetary relief	63
(3) Obligation to pay damages	65
(4) Disclosure of the source of origin and of purchasers	65
(5) Destruction of infringing goods	66
(6) Removal of infringing goods	66
(7) Costs	66
(8) Award of attorney's fees	67
II. Objections in patent litigation	67
1. Germany	67
(1) License agreement, compulsory license, anti-trust defence	67
(1-1) License agreement	67
(1-2) Compulsory license	68
(1-3) Anti-trust defence	68
(2) Revocation action and the dual system	69
(3) Prior use right	69
(4) Test privilege	70
(4-1) Research privilege	70
(4-1-1) Legal provision	70
(4-1-2)	70
(4-1-3) Economic purposes of research	71
(4-2) Bolar exemption	72
(5) Statute of limitation	73

Contents

(6) Laches	73
(7) Exhaustion	73
2. Japan	74
(1) License	74
(1-1) License agreement	74
(1-2) Non-exclusive licenses granted by the Commissioner	74
(1-3) Legal licenses	75
(1-3-1) Types of legal licenses	75
(1-3-2) Legal license based upon a prior use	75
(2) Validity of invention	76
(2-1) Change of dual system- <i>Kilby</i> patent case	76
(2-2) Countermeasure of patent holders – correction	77
(2-3) Delay of procedure and the amendment of the Japanese Patent Act 2011	78
(3) Restrictions of patent rights	79
(3-1) Expiration of patent rights	79
(3-2) Private uses	80
(3-3) Experimental purposes	80
(3-4) Restriction of exercise patent right against passing vessels or aircrafts	81
(3-5) Medical treatments	82
(3-6) Exhaustion of patent right	82
(3-7) Parallel import	83
(3-8) Abuse of patent rights	84
(3-9) FRAND	84
(4) Statute of limitation	85
3. USA	85
(1) Defenses – in general	85
(1-1) Written description requirement	85
(1-2) Enablement	86
(1-3) Inventorship	86
(1-4) Inequitable conduct	86
(2) Anti-trust defense	87
(3) Licenses	88
(4) Invalidation, (prior art) and parallel patent office proceedings	89
(4-1) Anticipation and Section 102 statutory bars	89
(4-2) Anticipation and Other Section 102 statutory bars	90
(4-3) Obviousness (35 U.S.C. § 103) and person of ordinary skill	92
(4-4) Level of ordinary skill	94
(4-5) Scope and content of the prior art	94
(4-6) Challenges outside the United States court system	94
(5) The key AIA procedures are:	96
(5-1) Supplemental examination	96
(5-2) IPR	96
(5-3) Post Grant Review (PGR)	97
(5-4) Contested Business Methods (CBM) proceeding	97
(5-5) Prior use rights	98
(5-6) Experimental use	98
(5-7) Statute of limitation	99
(5-8) Laches	99
(5-9) Equitable estoppel	99
(5-10) Prosecution laches	100
(5-11) Unclean hands	100
Part 5. Pre-procedural measures	101
I. Pre-procedural measures of the patent holder	101
1. Germany	101
(1) Warning letter due to patent infringement	101
(1-1) Practical and judicial meaning	101
(1-2) Unauthorized warning	101
(1-3) Exhaustion periods	102
(2) Preliminary injunctions	102
(2-1) A survey of summary proceedings in patent law	102
(2-2) Procedural principles in injunction proceedings	102

(2-3) Validity of the patent of disposal	103
(2-4) Infringement	103
(2-5) Urgency	104
(2-6) Proportionality	104
(2-7) Enforcement and remedies	104
(2-8) Damages	105
2. Japan	105
(1) Warning	105
(2) Preliminary injunction	106
(2-1) Preliminary injunction as a provisional remedy	106
(2-2) Characters of a preliminary injunction	107
(2-3) Material prerequisites for an order of a preliminary injunction	107
(2-4) Procedure	108
(2-4-1) Jurisdiction	108
(2-4-2) Petition	108
(2-4-3) Relation of a preliminary injunction with an ordinary injunction	109
(2-4-4) Hearing	109
(2-4-5) Proof with prima facie evidences	110
(2-5) Decision and objection	111
(2-5-1) Dismissal of a petition and immediate appeal	111
(2-5-2) Issue of an order for a preliminary injunction, objection and appeal	112
(2-6) Revocation of a preliminary injunction	112
3. USA	113
(1) Warning letter	113
(2) Injunctive relief	114
II. Pre-procedural measures of the infringer	115
1. Germany	115
(1) Negative declaratory action and counter-warning	115
(2) Protective letter	115
(3) Application for issuing a injunctive relief due to unauthorized claim of patent rights	115
2. Japan	115
(1) Counter warning	115
(1-1) Counter warning based on a patent	115
(1-2) Counter warning based on an unfair competition	116
(2) Protective letter	117
(3) Declaratory judgement	118
3. USA	118
(1) Counter-warning/protective letter	118
(2) Opinions of counsel	119
(3) Declaratory judgment proceedings	120
(4) Request for injunctive relief due to unauthorized claim of patent rights	120
Part 6. Infringement proceedings	123
1. Germany	123
1. Jurisdiction and courts	123
2. Parties and participants to the proceedings	123
(1) The parties	123
(2) Right to sue	123
(2-1) The registered patent holder	123
(2-2) Several patent owners	123
(2-3) Right to sue of the licensee	124
(3) The defendant's standing to be sued	124
(3-1) Alleged infringers	124
(3-2) Two or more infringers	125
(3-3) Managing directors	125
(4) Attorneys of record	126
(5) Experts	126
(5-1) Court experts	126
(5-2) Party-appointed expert	127
(6) Third party intervention	127
3. Procedure	128
(1) Filing the complaint	128

Contents

(2) Reply to a complaint	128
(3) Oral hearing	129
(4) Judgement and appeal	129
(5) Procedural guidelines of the court	129
II. Japan	130
1. Jurisdiction	130
(1) International jurisdiction and governing law	130
(1-1) Injunction claims	131
(1-2) Claims for compensation of damages	132
(2) National jurisdiction	132
(2-1) Jurisdiction for the first instance	132
(2-2) Jurisdiction for the second instance	133
(2-3) Jurisdiction for the final instance	133
2. Parties to the proceeding	133
(1) Courts	133
(2) Parties	133
(2-1) Plaintiffs	133
(2-1-1) Existence of an effective patent right	134
(2-1-2) Transfer of patent rights	134
(2-1-3) Registered exclusive licensee	135
(2-3) Defendants	135
(2-4) Representatives of civil procedure	136
(2-5) Experts	137
(2-6) Third parties	137
3. Procedural steps	138
(1) Filing a complaint by a plaintiff	138
(2) Service of a complaint to the defendant	138
(3) Answer of the defendant to a complaint	139
(4) Begin of oral proceeding	140
(5) Preparatory proceeding	140
(5-1) Preparatory proceeding for recognising infringement	140
(5-2) Preparatory proceeding for calculation of damages	141
(6) Conclusion of oral proceeding	141
(7) Judgement	141
(7-1) Judgement recognising infringement	141
(7-2) Judgement denying infringement	141
(8) Appeal to the Japanese Intellectual Property High Court	142
(9) Final appeal to the Japanese Supreme Court	142
III. USA	143
1. Jurisdiction	143
2. Parties to the proceedings	144
(1) Court	144
(2) Necessary and permissible parties	144
(3) Rights of action	145
(4) Adding of additional parties	145
(5) Representatives	145
(6) Experts	146
(7) Third party participation	146
3. Procedure	147
(1) Filing of the complaint	147
(2) Answer to the complaint	147
(3) Proceedings leading to the decision of the court	147
(4) Motion practice and oral hearings	148
(5) Trial, judgment and appeal	149
Part 7. Procedural principles	151
1. Germany	151
1. The dual system	151
2. The principle of party control	152
(1) Substantive motions	152
(1-1) Subject-matter of the motions	152
(1-2) The principle of the binding nature of the application	153

Contents

(2) Commencement and termination of the proceedings	153
(2-1) Bringing a suit	153
(2-2) Withdrawal of action	153
(2-3) Acceptance	154
(2-4) Settlement	154
(3) Changes in the factual and legal situations	154
(3-1) Change of party	154
(3-2) Invalidation or restriction of the patent-in-suit	155
3. Adversarial system	156
4. Investigative principle and judicial information obligation	157
5. The legal judge	158
6. Right to be heard	158
7. Oral presentation and publicity	159
8. Burden of demonstration and burden of proof	159
(1) Extent of the burden of demonstration and proof	159
(2) Exemption of certain facts from the burden of proof	160
(3) Shifting of the burden of proof	162
(4) Taking of evidence and means of evidence	162
9. The principle of concentration	163
10. Liability of the losing party to pay the costs	163
(1) Cost risk	163
(2) Value of the matter in dispute	164
II. Japan	165
1. “Double Track” system	165
(1) Separation system before the judgement in 2000	166
(2) Introduction of “Double Track” system by the judgement in 2000	166
(3) Contradiction between courts’ judgements and the JPO’s decisions	166
(4) Invalidation of patent after the final and binding judgement	167
(5) Discussion to reform the “Double Track” system	167
2. Principle of party disposition	168
(1) Substantive motions	168
(1-1) Specification of claims	168
(1-1-1) Discretion of a patent holder to specify the claims	168
(1-1-2) Initiative of an alleged infringer	168
(1-1-3) Specification of the objects of claim	169
(1-2) Specification of parties	169
(2) Party’s discretion for ending the procedure	170
(2-1) Withdrawal of action	170
(2-1-1) Prerequisites of withdrawal of action	170
(2-1-2) Effect of withdrawal of action	170
(2-1-3) Practical meaning of withdrawal of action	170
(2-2) Waiver of claim	171
(2-3) Acknowledgment of claim	171
(2-4) Amicable settlement within a judicial procedure	172
3. Principle of party presentation	172
(1) Responsibilities of parties to state facts and to submit proofs	172
(2) Exceptions to the principle of party presentation	173
(2-1) Interpretation and application of laws	173
(2-2) Procedural requirements for filing an action	173
(2-3) Progress of proceedings	174
(2-4) Subsidiary authority of courts to collect evidences	174
4. Judicial information obligation	174
5. Legal judges	175
6. Principles of orality and publicity	176
(1) Principles of orality and publicity for civil procedures	176
(2) Exceptions in the practice of patent infringement cases	177
(2-1) Suitableness for preparatory proceedings	177
(2-2) Limitation of opening records containing trade secrets to the public	177
(2-3) Protective order	177
(2-3-1) Prerequisites for protective order	178
(2-3-2) Legal results from protective order	178
(2-4) Suspension of opening the examination of parties to the public	179

Contents

7. Burden of demonstration and burden of proof	179
(1) Burden of demonstration	179
(2) Burden of proof	180
(2-1) Burden of proof for literal infringement	180
(2-2) Burden of proof for equivalent infringement	180
(2-3) Burden of proof for compensation of damages	180
(3) Procedural measures easing the burden of proof related to infringement	180
(3-1) Obligation of an alleged infringer to present the exploiting forms	181
(3-2) Presumption of exploiting patented process from identification of products	181
(3-3) Order to submit documents related to infringement	181
(3-4) Order to submit a subject matter of observation	182
(4) Procedural measures easing the burden of proof related to calculation damage	182
(4-1) Order to submit documents related to damages	182
(4-2) Presumption of the amount of damages	183
(4-3) Obligation of infringer to explain the facts for the calculation of damages	183
(4-4) Recognition of reasonable amount of damages	184
8. Maxim of concentration of examination of witnesses and parties	184
9. Liability of the losing party to pay the costs	184
III. USA	185
1. All matters before the court	185
(1) Substantive motions	185
(2) Procedural motions	185
2. Adversarial system	186
3. Discovery	186
4. The Court and the judge and their roles	187
5. The jury and their role	187
6. Public trials and right to be heard	188
7. Publicity	188
8. Burden of proof	188
(1) Preponderance of the evidence	188
(2) Clear and convincing	189
(3) Taking of evidence and means of evidence	189
(3-1) Pre-trial discovery	189
(3-2) Evidence outside the United States	190
(3-3) Evidence at trial	190
9. Costs	191
Part 8. Comparative aspects of Law and practice	193
I. Territoriality	193
II. Collection of evidence and experts	194
III. Courts, jury and judges	196
IV. Validity objection	196
V. Infringement	196
VI. Injunctions	197
VII. Damages	198
VIII. Costs	199
Index	201

Abbreviations

AIA	American Invention Act
AIPLA	American Intellectual Law Association
ALJ	(U.S.) administrative law judge
Art.	Article
BGB	<i>Bürgerliches Gesetzbuch</i> (German Civil Code)
BGH	<i>Bundesgerichtshof</i> (German Federal Supreme Court)
CAFC	(U.S.) Court of Appeal of the Federal Circuit
CBM	(U.S.) Contested Business Methods
cf.	confer (see)
CJEU	Court of Justice of the European Union
DOJ	(U.S.) Department of Justice
ECJ	European Court of Justice
EP	European Patent
EPC	European Patent Convention
EPO	European Patent Office
et seq./seqq.	et sequentia
EU	European Union
F.	(U.S.) Federal Reporter
F.R.D.	(U.S.) Federal Rules Decisions
FDA	(U.S.) Food and Drug Administration
Fed. Cir.	(U.S.) Federal Circuit
ff.	and the following
FITF	“First Inventor To File”
FPC	(German) Federal Patent Court
FRAND	fair, reasonable and non-discriminating
FRCP	(U.S.) Federal Rules of Civil Procedure
FRE	(U.S.) Federal Rules of Evidence
FTC	(U.S.) Federal Trade Commission
FTI	“First To Invent”
GATT	General Agreement on Tariffs and Trade
GG	<i>Grundgesetz</i> (German Constitution)
GKG	<i>Gerichtskostengesetz</i> (German Court Fees Act)
GPTO	German Patent and Trademark Office
GRUR	<i>Gewerblicher Rechtsschutz und Urheberrecht</i> (German journal on IP and copyright law)
GRUR Int	<i>Gewerblicher Rechtsschutz und Urheberrecht- Internationaler Teil</i> (German journal on IP and copyright law – international)
GRUR -RR	<i>Gewerblicher Rechtsschutz und Urheberrecht- Rechtsprechungsreport</i> (German journal on IP and copyright law- case reporter)
GVG	<i>Gerichtsverfassungsgesetz</i> (German Judicature Act)
id.	idem (the same)
IIC	International Review of Intellectual Property and Competition Law
INPIT	Japanese National Centre for Industrial Property Information and Training
InstGE	<i>Entscheidungen der Instanzengerichte zum Recht des geistigen Eigentums</i> (German reporter on IP cases)
IPR	(U.S.) Inter Partes Review
ITC	International Trade Commission
L. Ed.	(U.S.) Supreme Court Reports, Lawyers’ Edition
LG	<i>Landgericht</i> (German court of first instance)
MPEP	(US) Manual of Patent Examining Procedures
N.D. Cal.	Northern District of California
No.	number
NPE	non-practicing entities
OJ	Official Journal
PAO	<i>Patentanwaltsordnung</i> (German Patent Attorney Code)

Abbreviations

PatG	<i>Patentgesetz</i> (German Patent Act)
PGR	(US) Post Grant Review
PGR	(US)
pp.	pages
PTAB	(US) Patent Trial and Appeal Board
PTO	(US) Patent and Trademark Office
RAND	Reasonable And Non-Discriminatory
RG	<i>Reformgesetz</i> (German Reform Act)
RVG	<i>Rechtsanwaltsvergütungsgesetz</i> (German Lawyers' Fees Act)
S. Ct.	(U.S.) Supreme Court Reporters
S.D.N.Y.	(U.S.) District Court, Southern District of New York
SEP	standard essential patent
SSO	(U.S.) Standard Setting Organizations
Sup. Ct.	Supreme Court of the United States
TRIPS	Agreement on Trade-Related Aspects of Intellectual Property Rights
U.S.C.	United States Supreme Court
U.S.C.A.	United States Code Annotated
U.S.S.C.	Supreme Court of the United States
UP	Unitary Patent
UPC	Unified Patent Court
UPCA	Unified Patent Court Agreement
v.	versus
Vol.	Volume
ZPO	<i>Zivilprozessordnung</i> (German Code of Civil Procedure)
U.S.	United States Reports

Selected Bibliography

Germany

Books

- Benkard* Patengesetz, 10th Ed. 2006; cited: Benkard/author, PatG
Busse Patengesetz, 7th Ed. 2013; cited: Busse/author
Fitzner/Lutz/Bodewig Patentrechtskommentar, 4th Ed. 2012; cited: Fitzner/Lutz/Bodewig/author
Kraßer Patentrecht (Patent Law), 6th Ed. 2009
Kühnen Handbuch der Patentverletzung, 6th Ed. 2013
Kühnen Patent Litigation Proceedings in Germany, 6th Ed. 2013
Mellulis Handbuch des Wettbewerbsprozesses, 3rd Ed. 2000
Pitz Patentverletzungsverfahren, 2nd Ed. 2010
Schramm Der Patentverletzungsprozess, 6th Ed. 2010
Schulte Patengesetz mit EPÜ (German Patent Act), 9th Ed. 2014; cited: Schulte/author

Articles

- Brinks/Fritze* Einstweilige Verfügungen in Patentverletzungssachen in den United StatesA und Deutschland, GRUR Int 1987, 133
Heath Patent Litigation in Japan and Germany: An introduction, J. Japan. L special issue No. 3 (2011), 13
Klopschinski Der Patentverletzungsprozess in Japan und Deutschland, GRUR Int. 2010, 309
Meier-Beck The interaction between infringement and invalidation decisions in German patent disputes, I. Japan. L. Special Issue No. 3 (2011), 63
Maxeiner Der Sachverständige in Patentrechtsstreitigkeiten in den United StatesA und Deutschland, GRUR Int 1991, 85
Ohly "Patentrolle" oder: Der patentrechtliche Unterlassungsanspruch unter Verhältnismäßigkeitsvorbehalt? – Aktuelle Entwicklung im United States-Patentrecht und ihre Bedeutung für das deutsche und europäische Patentsystem, GRUR Int 2008, 787
Rauh Mittelbare Patentverletzung in Deutschland, Japan und den United States, GRUR Int 2010, 459
Rahn Patent Infringement Proceedings in Japan and Germany: Similarities and Differences, J. Japan. L special issue No. 3 (2011), 29
Schönknecht Beweisbeschaffung in den United States zur Verwendung in deutschen Verfahren, GRUR Int 2011, 1000

Japan

Books

- Abe/Ikubo/Katayama* Japanese Patent Litigation, 2nd Ed. 2012
Hansen/Schüssler-Langeheine (eds) Patent Practice in Japan and Europe, Liber Amicorum for Guntram Rahn, 2011
Hinkelmann Gewerblicher Rechtsschutz in Japan, 2nd Ed., 2008
Kawaguchi The Essentials of Japanese Patent Law: Cases and Practice, 1st Ed. 2006

Articles

- Heath* Patent Litigation in Japan and Germany: An introduction, J. Japan. L special issue No. 3 (2011), 13
Heath Erlangung und Durchsetzung von Patentrechten in Japan, GRUR Int 1998, 555
Kimijima Das Patentnichtigkeitsverfahren in Japan, GRUR Int 1996, 986
Klopschinski Der Patentverletzungsprozess in Japan und Deutschland, GRUR Int. 2010, 309
Rahn, Patentstrategien japanischer Unternehmen, GRUR Int 1994, 377
Rahn, Neuere Entwicklungen bei Patentverletzungsklagen in Japan, Mitt. 2001, 199
Rahn, Patent Infringement Proceedings in Japan and Germany: Similarities and Differences,

Selected Bibliography

- J. Japan. I special issue No. 3 (2011), 29
- Rauh*, Mittelbare Patentverletzung in Deutschland, Japan und den USA, GRUR Int 2010, 459
- Someno*, Grundlagen und Probleme des japanischen Patentrechts, GRUR Int 1994, 371

USA

Books

- John R. Thomas*,
Martin J. Adelman &
Randall J. Rader, Cases and Materials on Patent Law (St. Paul, Minn.: West 3rd Ed. 2009)
- John R. Thomas &*
Roger E. Schechter Principles of Patent Law (St. Paul, Minn.: Thomson/West 2004)

Articles

- Bergen-Babinecz/Hinrichs/*
Jung/Kolb Zum Schutzbereich von US-Patenten: Festo und eine deutsche Sicht, GRUR Int 2003, 487
- Bodewig* Erschöpfung der gewerblichen Schutzrechte und des Urheberrechts in den USA, GRUR Int 2000, 597
- Bodewig* Nichtangriffspflichten des Veräußerers im US-amerikanischen Patentrecht, GRUR Int 2004, 918
- Brinks/Fritze* Einstweilige Verfügungen in Patentverletzungssachen in den USA und Deutschland, GRUR Int 1987, 133
- Calvetti/Hughes* Mittelbare Verletzung und Anstiftung zur Verletzung im United States-Patentrecht, GRUR Int 1993, 833
- Calvetti/Venturino* Zur Gültigkeit von Patenten in den USA: Mitteilungspflichten im Patenterteilungsverfahren und im Verletzungsprozess, GRUR Int 1988, 815
- The Federal Circuit*
Bar Association Model Patent Jury Instructions, <http://www.fedcirbar.org>
- Henry* Pretrial Discovery in USA: Extritorialer Einfluss auf Durchsetzung und Benutzung von gewerblichen Schutzrechten, GRUR Int 1983, 82
- Hufnagel* Ausweitung des Versuchsprivilegs in Europa und den USA – Verschiebung der Grenzen zwischen Patentschutz und Versuchsfreiheit bei Arzneimitteln, PharmR 2006, 209
- Koch* Reform des Patentrechts in den USA – Ein Überblick über die Vorschläge zur Revision und Modernisierung des Patentgesetzes, GRUR Int 1975, 103
- Maxeiner* Der Sachverständige in Patentrechtsstreitigkeiten in den USA und Deutschland, GRUR Int 1991, 85
- Mehler* Das Prosecution History Estoppel im US-Patentrecht, GRUR Int 2006, 278
- Münsterer* Fallstricke und andere Besonderheiten der US-Patentpraxis aus deutscher Sicht, MitttdtPatA 2010, 332
- Müller-Stoy* Grundzüge des U.S.-amerikanischen Patentverletzungsverfahrens, GRUR Int 2005, 558
- Pakuscher* Das neue zentrale Berufungsgericht in den USA – ein Schritt in die europäische Richtung – Dem alten und neuen Chef-Richter Howard T. Markey, GRUR Int 1983, 71
- Ohly* "Patentrolle" oder: Der patentrechtliche Unterlassungsanspruch unter Verhältnismäßigkeitsvorbehalt? – Aktuelle Entwicklung im US-Patentrecht und ihre Bedeutung für das deutsche und europäische Patentsystem, GRUR Int 2008, 787
- Pfeiffer* Hätte Columbus gewusst, was aus seiner "discovery" wird – das "discovery"-Verfahren im amerikanischen Patentverletzungsprozess, GRUR Int 1999, 598
- Rauh* Mittelbare Patentverletzung in Deutschland, Japan und den USA, GRUR Int 2010, 459
- Reitboeck* Das rechtliche Umfeld für (und gegen) nicht operative Patentinhaber in den USA – Ein Überblick über wichtige Entwicklungen der letzten Jahre, GRUR Int 2013, 419

Selected Bibliography

- Ruess* Der U.S. Court of Appeals for the Federal Circuit und seine Bedeutung im U.S.-Gerichtssystem unter besonderer Berücksichtigung des U.S. Supreme Court, GRUR Int 2011, 1
- Schönknecht* Beweisbeschaffung in den USA zur Verwendung in deutschen Verfahren, GRUR Int 2011, 1000
- Wehr* Die Rechtskraftwirkung von Entscheidungen über die Nichtigkeit von Patenten in den USA – die Entscheidung in *Blonder-Tongue* und ihre Auswirkungen, GRUR Int 1973, 131

