

**Haedicke / Timmann**

**Patent Law  
A Handbook**

**C. H. Beck • Hart • Nomos**

Haedicke/Timmann (eds.)  
Patent Law Handbook  
European and German Patent Law



# Patent Law Handbook

European and German Patent Law

edited by

**Maximilian Haedicke and  
Hendrik Timmann**

C. H. Beck · Hart · Nomos  
2013

*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, OXI 2JW, United Kingdom,  
online at: www.hartpub.co.uk

and

Nomos Verlagsgesellschaft mbH & Co. KG Waldseestraße 3–5  
76530 Baden-Baden, Germany  
eMail: nomos@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 978-3-406-65074-1 (Beck)  
ISBN 978-1-84946-492-5 (Hart Publishing)  
ISBN 978-3-8487-0301-2 (Nomos)

© 2013 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.

## Foreword

The practical relevance of German patent law and of European patent law as applied in Germany is reflected in its enormous economic impact, Germany being Europe's most important location for patent infringement suits and the country in which most European patent applications are filed. Hence, German patent law is of particular interest not only for German practitioners, but for practitioners throughout the world. Literally everybody who is concerned with patents in Europe has to take the legal situation in Germany into account.

Furthermore, German patent-related legal research and case law have evolved for more than a century, strongly influencing European patent law. It is a further goal of this book to make such long-standing principles accessible to those unfamiliar with the German language in order to enrich the international debate in all legal matters related to patents.

Thus, the Patent Law Handbook is meant for lawyers, legal and patent departments of business entities, as well as judges and administrative bodies worldwide, in order to support them in their day-to-day business when they are concerned with questions relating specifically to German patent law, and in order to allow a comparison of their own legal assessment with German principles.

For these purposes, this book offers a comprehensive presentation and analysis of the substantive issues of German, European and international patent law. It also covers procedural aspects insofar as they do not relate solely to the German court system and therefore seem to be of international interest.

The content of this book is essentially an English translation of its parallel German publication "Handbuch des Patentrechts", which was published in 2012 by C. H. Beck. Some sections of the German equivalent have been adapted to better meet international needs, one section covering purely procedural aspects of infringement suits has been omitted. The section on Supplementary Protection Certificates (SPCs) will be subject to a separate English publication.

The authors of the Patent Law Handbook are judges, attorneys, patent attorneys and researchers. All of them have years of experience in the field of patent law and practice. The editors wish to thank all the authors for their unrelenting efforts and work.

Literature and case law up to February 2012 have been taken into account.

Freiburg and Düsseldorf, August 2013

*Maximilian Haedicke*

*Henrik Timmann*



## List of Contributors

Dr Dirk Bühler	§§ 7, 13, 14, together with Marco Stief
Dr Johannes W. Bukow	§ 9
Professor Dr Maximilian Haedicke	§§ 1, 3, 4; § 8, together with Dr Henrik Timmann
Dr Lorenz Hartmann	§ 2, together with Dr Raph Nack and Dr Joel S.H. Nägerl
Dr Dietrich Kamlah	§ 10
Dr Felix Landry	§ 5
Dr Ralph Nack	§ 2, together with Dr Lorenz Hartmann and Dr Joel S.H. Nägerl
Dr Joel S.H.Nägerl	§ 2, together with Dr Raph Nack and Dr Lorenz Hartmann
Marco Stief	§§ 7, 13, 14, together with Dr Dirk Bühler
Dr Henrik Timmann	§ 6; § 8, together with Professor Dr Maximilian Haedicke
Axel Verhauwen	§§ 11, 12



## Content Overview

Foreword .....	V
List of Contributors .....	VII
Abbreviations and Acronyms .....	XIII
Bibliography .....	XIX
Table of Contents .....	XXIII

### § 1. Introduction

A. Ambit, meaning, goals and means of patent law ( <i>Haedicke</i> ) .....	3
B. Historic development ( <i>Haedicke</i> ) .....	7
C. Relevant sources of law ( <i>Haedicke</i> ) .....	12
D. Patent law and neighbouring legal fields ( <i>Haedicke</i> ) .....	19
E. Patent law and competition law ( <i>Haedicke</i> ) .....	28
F. Patent law and the European Single Market ( <i>Haedicke</i> ) .....	54

### § 2. Inventions and their amenability to patent protection

A. The “Technical Invention” criterion ( <i>Nack/Nägerl/Walder-Hartmann</i> ) .....	65
B. Catalogue of exclusions (Section. 1 para. 3–4 PatG resp. Art. 52 para. 2–3 EPC) ( <i>Nack/Nägerl/Walder-Hartmann</i> ) .....	90
C. The “industrial applicability” criterion ( <i>Nack/Nägerl/Walder-Hartmann</i> ) .....	124
D. Obstacles to protection ( <i>Nack/Nägerl/Walder-Hartmann</i> ) .....	127
E. Differentiation from the state of the art ( <i>Nack/Nägerl/Walder-Hartmann</i> ) .....	129
F. Realisability and sufficiency of disclosure for realisability ( <i>Nack/Nägerl/ Walder-Hartmann</i> ) .....	207

### § 3. Ownership

A. Inventor and inventor right ( <i>Haedicke</i> ) .....	243
B. Multiple owners ( <i>Haedicke</i> ) .....	247
C. Recovery of inventors’ rights ( <i>rei vindicatio</i> ) ( <i>Haedicke</i> ) .....	272

### § 4. Patent transfer and licensing

A. Common foundations of patent transfer and licensing ( <i>Haedicke</i> ) .....	299
B. Full transfer of patents ( <i>Haedicke</i> ) .....	307
C. Licenses ( <i>Haedicke</i> ) .....	311

### § 5. Grant and rejection of patents

A. The proceedings for grant ( <i>Landry</i> ) .....	338
B. Opposition proceedings ( <i>Landry</i> ) .....	501
C. Appeal proceedings ( <i>Landry</i> ) .....	542
D. Nullity proceedings ( <i>Landry</i> ) .....	569

E. Limitation and revocation proceedings ( <i>Landry</i> ) .....	594
F. Lapse without retroactive effect ( <i>Landry</i> ) .....	602

### § 6. Interpretation and scope of protection of patents

A. Basic outline ( <i>Timmann</i> ) .....	607
B. The importance of the patent specification as a source for interpretation ( <i>Timmann</i> ) .....	618
C. The importance of sources outside the patent specification ( <i>Timmann</i> ) .....	640
D. Extension of the scope of protection to equivalents ( <i>Timmann</i> ) .....	647

### § 7. Chemical and biological inventions

A. Introduction and development ( <i>Stief/Bühler</i> ) .....	664
B. Definitions, exceptions and special cases regarding biological inventions ( <i>Stief/Bühler</i> ) .....	672
C. Prerequisites for patent registration ( <i>Stief/Bühler</i> ) .....	680
D. Scope of protection and types of claims ( <i>Stief/Bühler</i> ) .....	695
E. Effects of the patent ( <i>Stief/Bühler</i> ) .....	715

### § 8. Use of a patent

A. General ( <i>Haedicke/Timmann</i> ) .....	733
B. Direct use of a patent ( <i>Haedicke/Timmann</i> ) .....	733
C. Indirect use of a patent ( <i>Haedicke/Timmann</i> ) .....	753
D. Liability and imputation ( <i>Haedicke/Timmann</i> ) .....	770

### § 9. Defences

A. Permitted acts under Section 11 PatG ( <i>Bukow</i> ) .....	790
B. Exhaustion ( <i>Bukow</i> ) .....	804
C. Prior use law according to Section 12 PatG ( <i>Bukow</i> ) .....	818
D. Defence of invalidity ( <i>Bukow</i> ) .....	834
E. Fraudulent abstraction ( <i>Bukow</i> ) .....	847
F. Objection of a compulsory licence under antitrust law ( <i>Bukow</i> ) .....	851
G. Forfeiture of rights ( <i>Bukow</i> ) .....	880

### § 10. Legal consequences of patent infringement

A. Creditors and debtors of claims for infringement ( <i>Kamla</i> ) .....	890
B. Injunctive relief ( <i>Kamla</i> ) .....	896
C. Claim for damages ( <i>Kamla</i> ) .....	904
D. Claims for unjust enrichment and claims for compensation ( <i>Kamla</i> ) .....	921
E. Claims for information and accounts ( <i>Kamla</i> ) .....	925
F. Claim for recall and destruction ( <i>Kamla</i> ) .....	940
G. Statute of limitation for the claims ( <i>Kamla</i> ) .....	945
H. Publication of a judgment ( <i>Kamla</i> ) .....	948

### § 11. European Patent and European Patent Court

I. Current position ( <i>Verhauwen</i> ) .....	951
II. The European Patent with unitary effect ( <i>Verhauwen</i> ) .....	952

## § 12. Other proceedings and claims in patent cases

A. Criminal patent law ( <i>Verhauwen</i> ) .....	959
B. Border seizure proceedings ( <i>Verhauwen</i> ) .....	967
C. Allegation of entitlement and misleading advertising ( <i>Verhauwen</i> ) .....	983
D. Claims arising from unjustified warnings of property right infringement ( <i>Verhauwen</i> ) .....	991

## § 13. The law of utility models

A. General ( <i>Stief/Bühler</i> ) .....	1001
B. Protection: Subject-matter and prerequisites ( <i>Stief/Bühler</i> ) .....	1004
C. Inventor's rights and invention ownership ( <i>Stief/Bühler</i> ) .....	1011
D. Formation and expiration of the utility model ( <i>Stief/Bühler</i> ) .....	1012
E. Content and scope of protection of the utility model ( <i>Stief/Bühler</i> ) .....	1023
F. Utility models in business transactions ( <i>Stief/Bühler</i> ) .....	1026
G. Consequences of the utility model infringement under civil law ( <i>Stief/Bühler</i> ) .....	1027
H. Consequences of the utility model infringement under criminal law ( <i>Stief/ Bühler</i> ) .....	1028
I. Utility model infringement action ( <i>Stief/Bühler</i> ) .....	1029
J. Unjustly claiming a utility model ( <i>Stief/Bühler</i> ) .....	1033

## § 14. The supplementary protection certificate

A. General, purpose, history and legal character of the certificate ( <i>Stief/Bühler</i> ) ..	1037
B. Substantive granting prerequisites ( <i>Stief/Bühler</i> ) .....	1046
C. Calculation of term ( <i>Stief/Bühler</i> ) .....	1055
D. Subject matter and scope of protection ( <i>Stief/Bühler</i> ) .....	1060
E. Rights, limitations and obligations ( <i>Stief/Bühler</i> ) .....	1070
F. Grant procedure ( <i>Stief/Bühler</i> ) .....	1075
G. Expiry, invalidity and revocation ( <i>Stief/Bühler</i> ) .....	1084
H. Remedies ( <i>Stief/Bühler</i> ) .....	1088
Index .....	1089



## Abbreviations and Acronyms

ABL.....	<i>Amtsblatt</i> (Official journal)
ACTA .....	Anti-Counterfeiting Agreements
ADA.....	Arrangements for Deposit Accounts
AIPPI .....	<i>Association Internationale pour la protection de la Propriété Industrielle</i> (International Association for the Protection of Intellectual Property)
AMNOG .....	<i>Arzneimittelmarktneuordnungsgesetz</i> (German pharmaceutical restructuring act)
AMPPreisV .....	<i>Arzneimittelpreisverordnung</i> (German drug price regulation)
AO .....	<i>Ausführungsordnung</i> (implementing regulation); <i>Abgabenordnung</i> (German regulation of taxation)
ArbnErfG .....	<i>Arbeitnehmererfindungsgesetz</i> (German employee invention act)
Art./arts. ....	article/s
AT.....	<i>Allgemeiner Teil</i> (general part)
ATC.....	anatomical, therapeutic, chemical
BB .....	<i>Der Betriebs-Berater</i> (German law journal)
BeckEuRS.....	<i>Beck'sche Rechtsprechungssammlung im Europarecht</i> (Beck online law report in EU matters)
Beck-RS .....	<i>Beck'sche Rechtsprechungssammlung</i> (Beck online law report)
BER .....	Block Exemption Regulation
BGB.....	<i>Bürgerliches Gesetzbuch</i> (German civil code)
BGBL.....	<i>Bundesgesetzblatt</i> (German federal law gazette)
BGH .....	<i>Bundesgerichtshof</i> (German federal supreme court)
BGHZ .....	<i>Entscheidungen des Bundesgerichtshofes in Zivilsachen, amtliche Sammlung</i> (official law report of the BGH in civil matters)
BioMatHintV .....	<i>Verordnung über die Hinterlegung von biologischem Material in Patent- und Gebrauchsmusterverfahren</i> (biological material deposit regulation)
BIRPI.....	<i>Bureaux Internationaux Réunis pour la Protection des la Propriété Intellectuelle</i> (United International Bureaux for the Protection of Intellectual Property)
BKartA.....	<i>Bundeskartellamt</i> (German federal cartel office)
Bl. f. PMZ .....	<i>Blatt für Patent-, Muster- und Zeichenwesen</i> (German law journal)
BIPMZ .....	<i>Blatt für Patent-, Muster- und Zeichenwesen</i> (German law journal)
BMBF.....	<i>Bundesministerium für Bildung und Forschung</i> (German federal ministry for education and research)
BMJ .....	<i>Bundesjustizministerium der Justiz</i> (German federal ministry for justice)
BPatG.....	<i>Bundespatentgericht</i> (German federal patent court)
BPatGE .....	<i>Entscheidungen des Bundespatentgerichts, amtliche Sammlung</i> (Official law report of the BPatG)
BR.....	<i>Bundesrat</i> (Second chamber of the German Parliament)
BR-Drucks. ....	<i>Bundesratsdrucksache</i> (Bundesrat printed matter)
BT .....	<i>Bundestag</i> (First chamber of the German Parliament)
BT-Drucks. ....	<i>Bundestagsdrucksache</i> (Bundestag printed matter)
BVerfG.....	<i>Bundesverfassungsgericht</i> (German federal constitutional court)

BVerwG.....	Bundesverwaltungsgericht (German federal administrative court)
BVerwGE.....	<i>Entscheidungen des Bundesverwaltungsgerichts, amtliche Sammlung</i> (Official law report of the BVerwG)
Cal. L. Rev. ....	California Law review
CBD.....	Convention on Biological Diversity
CCPA.....	United States Court of Customs
cf. ....	confer; see
CFREU .....	Charter of Fundamental Rights of the European Union
ch. ....	chapter
CIPA .....	Chartered Institute of Patent Agents (UK)
CIPP .....	Continuous Improvement Performance Plan
CNPA .....	Committee of National Patent Agents
COM.....	Commission documents for the other institutions
CPC.....	Community Patent Convention
CPI .....	<i>Code de la Propriété Intellectuelle</i>
CR/CuR.....	<i>Computer und Recht</i> (German law journal)
DB.....	<i>Der Betrieb</i> (German law journal)
DIN .....	<i>Deutsche Industrienorm</i>
DirMPH .....	Directive on the Community code relating to medicinal products for human use
DirMPV.....	Directive on the Community code relating to veterinary medicinal products
DNS.....	Desoxyribonucleic Acid
DPMA .....	<i>Deutsches Patent- und Markenamt</i> (German patent and trademark office)
DPMVA .....	<i>Verordnung über das Deutsche Patent- und Markenamt</i> (DPMA ordinance concerning the German patent and trademark office)
DPMVAwKostV..	<i>Verordnung über die Verwaltungskosten beim Deutschen Patentamt</i> (Ordinance concerning administrative costs at the DPMA)
e. g. ....	for instance
EC.....	European Community
ECHR.....	European Convention on Human Rights
ECJ .....	European Court of Justice; Court of Justice of the EU
ECMR.....	European Community Merger Regulation
ECR.....	European Court Report
Ed./s .....	edition/s; editor/s
EEA .....	European Economic Area
EEUPC .....	European and EU Patent Court Convention
EFTA.....	European Free Trade Association
EGBGB.....	<i>Einführungsgesetz zum BGB</i> (introductory act to the BGB)
EIPR.....	European Intellectual Property Review
EPC.....	European Patent Convention
EPO.....	European Patent Office; European Patent Organisation
EPUE .....	European Patent with Unitary Effect
ErstrG .....	<i>Erstreckungsgesetz</i> (German extension law)
ERVDPMVA.....	<i>Verordnung über die Neuregelung des elektronischen Rechtsverkehrs beim Deutschen Patent- und Markenamt</i> (ordinance on the revision of the rules for electronic legal transactions within the German patent and trademark office)
ESPACE.....	ESPACE-net at the EPO
EST.....	Expressed Sequence Tag(s)

et seq./et seqq.....	et sequentia
ETSI .....	European Telecommunications Standards Institute
ETSI IPR .....	Intellectual Property Rights in ETSI
EU .....	European Union
EUCO .....	European Council
EuZW .....	<i>Europäische Zeitschrift für Wirtschaftsrecht</i> (German law journal)
FICPI.....	<i>Fédération Internationale des Conseils en Propriété Industrielle</i> (International Federation of Intellectual Property Attorneys)
Fn.....	footnote
FRAND .....	Fair, reasonable and non-discriminatory conditions
FS.....	<i>Festschrift</i> (liber amicorum)
GATT.....	General Agreement on Tariffs and Trade
GC .....	General Court
GDR .....	German Democratic Republic
GebraMG .....	<i>Gebrauchsmustergesetz</i> (German utility models act)
GeschmG .....	<i>Geschmacksmustergesetz</i> (German design act)
GG.....	<i>Grundgesetz</i> (German constitution)
GRUR .....	<i>Gewerblicher Rechtsschutz und Urheberrecht</i> (German law journal)
GRUR Int.....	<i>Gewerblicher Rechtsschutz und Urheberrecht – Internationaler Teil</i> (German law journal – international part)
GRUR-Beil.....	<i>Gewerblicher Rechtsschutz und Urheberrecht – Beilage</i> (German law journal – supplement)
GRUR-Prax .....	<i>Gewerblicher Rechtsschutz und Urheberrecht – Praxis</i> (German law journal – practice)
GRUR-RR.....	<i>Gewerblicher Rechtsschutz und Urheberrecht – Rechtsprechungsteil</i> (German law journal – law report)
GVG.....	<i>Gerichtsverfassungsgesetz</i> (German judiciary act)
GWB .....	<i>Gesetz gegen Wettbewerbsbeschränkungen</i> (German law against restraints of competition)
GWR.....	<i>Zeitschrift für Gesellschafts- und Wirtschaftsrecht</i> (German law journal)
G-ZollVG.....	<i>Zollverwaltungsgesetz</i> (German customs administration law)
HGB .....	<i>Handelsgesetzbuch</i> (German commercial code)
ICT .....	Information and Communications Technologies
i. e.....	id est
ibid .....	in the same place
id.....	<i>see idem.</i>
idem. ....	the same as something/someone previously mentioned
IIC .....	International Review of Intellectual Property and Competition Law
Impl. Reg. [EPC]..	Implementing Regulations to the EPC
InstGE.....	<i>Entscheidungen der Instanzgerichte zum Recht des geistigen Eigentums</i> (German law report of higher regional court concerning IP cases)
IntPatÜG.....	<i>Gesetz über internationale Patentübereinkommen</i> (German law on international patent conventions)
Intro. ....	Introduction
IP .....	Intellectual Property
IPR.....	<i>International Privatrecht</i> (private international law)
IPRED.....	Intellectual Property Enforcement Directive

ISO/IEC.....	Information technology – Security techniques – Information security management systems – Requirements
ITRB.....	<i>IT Rechtsberater</i> (German law journal)
JIPITEC.....	Journal of Information Technology and E-Commerce Law
JIPLP.....	Journal of Intellectual Property Law & Practice
JW.....	<i>Juristische Wochenschrift</i> (German law journal)
JZ.....	<i>Juristen Zeitung</i> (German law journal)
KostRegBerG.....	<i>Gesetzes zur Änderung des patentrechtlichen Einspruchsverfahrens und des Patenkostengesetzes</i> (German law amending patent opposition proceedings and the patent costs law)
LG.....	<i>Landgericht</i> (court of first instance in Germany and Austria)
lit.....	litera
LK-author.....	<i>Leipziger Kommentar zum Strafrecht</i> (article-by-article commentary on criminal law)
LMuR.....	<i>Lebensmittel &amp; Recht</i> (German law journal)
MA.....	Marketing authorisation
MarkenG.....	<i>Markengesetz</i> (German trademark act)
Mitt.....	<i>Mitteilungen der deutschen Patentanwälte</i> (German law journal)
MMR.....	<i>Multimedia und Recht</i> (German law journal)
mn.....	margin number
MPI.....	Max Planck Institute for Intellectual Property and Competition Law
MPR.....	<i>Medizin Produkte Recht</i> (German law journal)
MuW.....	<i>Markenschutz und Wettbewerb</i> (German law journal)
MüKo-BGB.....	<i>Münchener Kommentar zum BGB</i> (article-by-article commentary on the BGB)
NJOZ.....	<i>Neue Juristische Online-Zeitschrift</i> (German law online journal)
NJW.....	<i>Neue Juristische Wochenschrift</i> (German law journal)
NJWE-WettbR.....	<i>NJW Entscheidungsdienst Wettbewerbsrecht</i> (German law report)
NJW-RR.....	<i>NJW Rechtsprechungs-Report Zivilrecht</i> (German law report in civil matters)
No./nos.....	number/s
NVwZ.....	<i>Neue Zeitschrift für Verwaltungsrecht</i> (German law journal)
NZI.....	<i>Neue Zeitschrift für Insolvenzrecht</i> (German law journal)
OGH.....	<i>Oberster Gerichtshof</i> (supreme court of Austria)
OHIM.....	Office of Harmonization for the Internal Market
OJ.....	Official Journal
OJ EPO.....	Official Journal of the EPO
OLG.....	<i>Oberlandesgericht</i> (higher regional court in Germany)
OMPI.....	<i>Organisation Mondiale de la Propriété Intellectuelle</i>
OWiG.....	<i>Ordnungswidrigkeitengesetz</i> (German code of administrative offences)
p./pp.....	page/s
PACE.....	Notice from the European Patent Office concerning the programme for accelerated prosecution of European patent applications
para./s.....	paragraph/s

PatG .....	<i>Patentgesetz</i> (German patent act)
PatGÄndG .....	<i>Patentrechtsänderungsgesetz</i> (
PatKostG.....	<i>Gesetz über die Kosten des DPMA</i> (patent costs law)
PatKostZV .....	<i>Verordnung über die Zahlung der Kosten des DPMA</i> (patent costs payment ordinance)
PatRModG.....	<i>Patentrechtsmodernisierungsgesetz</i> (law for streamlining and modernising patent law)
PatV .....	<i>Patentverordnung</i> (German patent ordinance)
PC.....	Paris Convention
PCT .....	Patent Cooperation Treaty
Pharm. Ind. ....	German journal
PharmR .....	<i>Pharma Recht</i> (German law journal)
PIP .....	Practical investigation plan
PMZ .....	<i>Patent-, Muster- und Zeichenwesen</i> (law related to patents, trademarks and signs)
Prop. Ind.....	<i>La Propriété Industrielle</i> (French law journal)
PrPG .....	<i>Produktpirateriegesetz</i> (German product piracy act)
PTO.....	Patent and trademark office
R.....	Rule
R&D BER.....	Block Exemption Regulation Research and Development
RegCAP .....	Regulation on Community procedures for the authorisation and supervision of medicinal products for human and veterinary use and establishing a European Medicines Agency
RegMPP.....	Regulation on medicinal products for paediatric use
RegSPC.....	Regulation concerning the supplementary protection certificate for medicinal products
RFees.....	Rules relating to fees
RG .....	Imperial Court
RGSt.....	<i>Entscheidungen des Reichsgerichts in Strafsachen, amtliche Sammlung</i> (official law report of the RG in criminal matters)
RGZ.....	<i>Entscheidungen des Reichsgerichts in Zivilsachen, amtliche Sammlung</i> (official law report of the RG in civil matters)
RiStBV .....	<i>Richtlinien für das Strafverfahren und das Bußgeldverfahren</i> (German guideline for criminal proceedings and proceedings concerning administrative fines)
RiW .....	<i>Recht der internationalen Wirtschaft</i> (German law journal)
RNA .....	Ribonucleic acid
ROHGE.....	<i>Entscheidungen des Reichsoberhandelsgerichts</i> (Official law report of the German Imperial supreme commercial court)
RPA .....	<i>Reichspatentamt</i> (German Imperial patent office)
RPBA .....	Rules of Procedure of the Board of Appeals
RPEBA.....	Rules of Procedure of the Enlarged Board of Appeals
RulesGCP.....	German Rules on the Application of Good Clinical Practice during Conduct of Clinical Trials with Medicinal Products for Human Use
SCRIPTed .....	Centre for Research in Intellectual Property and Technology Law
Sec.....	Section; paragraph
sid .....	Scientific information data base
SortG.....	<i>Sortengesetz</i> (German plant variety protection act)
SPC.....	Supplementary Protection Certificate
StGB.....	<i>Strafgesetzbuch</i> (German penal code)
StPO .....	<i>Strafprozeßordnung</i> (German criminal procedure code)
SUG.....	<i>Signaturgesetz</i> (German digital signature act)

TEC.....	Treaty establishing the European Community
TEU.....	Treaty on European Union
TFEU.....	Treaty on the Functioning of the European Union
TRIPS.....	Trade-Related Aspects of Intellectual Property Rights
TT.....	Technology Transfer
TT-BER.....	Technology Transfer Block Exemption Regulation
UPC.....	Unified Patent Court
UrhG.....	<i>Gesetz über Urheberrecht und verwandte Schutzrechte</i> (German copyright act)
U.S.C.....	United States Code
USPTO.....	US Patent and Trademark Office
UWG.....	<i>Gesetz gegen den unlauteren Wettbewerb</i> (German law against unfair competition)
v./vs.....	versus
Vertical-BER.....	Vertical Block Exemption Regulation
vol.....	volume
VPP.....	Association of Intellectual Property Experts
VPP-Rundbrief....	Circular of the VPP
VwZG.....	<i>Verwaltungszustellungsgesetz</i> (German law on service in administrative procedures)
WIPO.....	World Intellectual Property Organization
WRP.....	<i>Wettbewerb in Recht und Praxis</i> (German law journal)
WTO.....	World Trade Organisation
WuW.....	<i>Wirtschaft und Wettbewerb</i> (German law journal)
ZEuP.....	<i>Zeitschrift für Europäisches Privatrecht</i> (German law journal)
ZGE.....	<i>Zeitschrift für Geistiges Eigentum</i> (German law journal)
ZGR.....	<i>Zentrale Gewerblicher Rechtsschutz</i>
ZPO.....	<i>Zivilprozessordnung</i> (German civil procedure code)
ZUM.....	<i>Zeitschrift für Urheber- und Medienrecht</i> (German law journal)
ZWeR.....	<i>Zeitschrift für Wettbewerbsrecht</i> (German law journal)

## General Bibliography

- Ahrens (Ed.), Der Wettbewerbsprozess, 6<sup>th</sup> ed. 2009  
Ann/Loschelder/Grosch, Praxishandbuch Know-how-Schutz, 2010  
Bartenbach, Patentreizenz- und Know-How Vertrag, 6<sup>th</sup> ed. 2007  
Baumbach/Lauterbach/Albers/Hartmann, Zivilprozessordnung (ZPO) Kommentar, 70<sup>th</sup> ed. 2012  
Beck'sche Formulsammlung zum gewerblichen Rechtsschutz mit Urheberrecht, 4<sup>th</sup> ed. 2009  
Benkard, Europäisches Patentübereinkommen, 2<sup>nd</sup> ed. 2012  
Benkard, Patentgesetz – Gebrauchsmustergesetz, 10<sup>th</sup> ed. 2006  
Berger/Wündisch, Urhebervertragsrecht, Handbuch, 2008  
Bodenhausen, Pariser Vervol.sübereinkunft zum Schutz des gewerblichen Eigentums, 1971  
Borgmann, Beck'sches Rechtsanwalts-Handbuch, 10<sup>th</sup> ed. 2011  
Brändel, Technische Schutzrechte, 1995  
Bremi, The European Patent Convention, 2008  
Bühning, Gebrauchsmustergesetz, 7<sup>th</sup> ed. 2007  
Büscher/Dittmer/Schiwy, Gewerblicher Rechtsschutz, Urheberrecht und Medienrecht, 2<sup>nd</sup> ed. 2011  
Busse/Keukenschrijver/Schwendy, Patentgesetz (mit Gebrauchsmustergesetz u. a.), 6<sup>th</sup> ed. 2004  
Däbritz/Jesse/Bröcher, Patente, 3<sup>rd</sup> ed. 2009  
Diener/Reese, Handbuch des Pharmarechts, 1st ed. 2010  
Dreier/Schulze, Urheberrechtsgesetz: UrhG, 3<sup>rd</sup> ed. 2008  
Dybdahl-Müller, Europäisches Patentrecht, 3<sup>rd</sup> ed. 2008  
Eisenmann/Jautz, Grundriss gewerblicher Rechtsschutz und Urheberrecht, 8<sup>th</sup> ed. 2009  
EPA (Ed.), Rechtsprechung der Beschwerdekammern des Europäischen Patentamts, 6<sup>th</sup> ed. 2010  
Europäisches Patentübereinkommen – Münchener Gemeinschaftskommentar, 1984 et seqq. (in supplements)  
Erdmann/Rojahn/Sosnitza (Eds), Handbuch des Fachanwalts für Gewerblichen Rechtsschutz, 2<sup>nd</sup> ed. 2011  
Fezer, Markenrecht, 4<sup>th</sup> ed. 2009  
ders. (Ed.), Handbuch der Markenpraxis, 2<sup>nd</sup> ed. 2012  
Fromm/Nordemann, Urheberrecht, 10<sup>th</sup> ed. 2008  
Gall/Rippe/Weiss, Die europäische Patentanmeldung und der PCT in Frage und Antwort, 6<sup>th</sup> ed. 2002  
Gaul/Bartenbach, Handbuch des gewerblichen Rechtsschutzes, loose-leaf  
Geimer/Schütze (Eds), Europäisches Zivilverfahrensrecht, 3<sup>rd</sup> ed. 2010  
Gloy/Loschelder/Erdmann (Eds), Handbuch des Wettbewerbsrechts, 4<sup>th</sup> ed. 2010  
Götting, Gewerblicher Rechtsschutz, 9<sup>th</sup> ed. 2010  
Groß, Der Lizenzvertrag, 10<sup>th</sup> ed. 2011  
Gruber/Adam/Haberl, Europäisches und internationales Patentrecht, 6<sup>th</sup> ed. 2008  
Haedicke, Patentrecht, 2009  
Harte/Henning, Gesetz gegen den unlauteren Wettbewerb, 2<sup>nd</sup> ed. 2009  
Hasselblatt, Münchener Anwaltshandbuch Gewerblicher Rechtsschutz, 3<sup>rd</sup> ed. 2009  
Hefermehl/Köhler/Bornkamm, Gesetz gegen den unlauteren Wettbewerb, 26<sup>th</sup> ed. 2008  
Hosoda/Jaenichen/McDonell/Haley, From Clones to Claims, 2006

- Immenga/Mestmäcker*, Wettbewerbsrecht – Kommentar zum Europäischen Kartellrecht, Vol. 2: GWB, 4<sup>th</sup> ed. 2007
- Ingerl/Rohnke*, Markengesetz, 3<sup>rd</sup> ed. 2010
- Jestaedt*, Patentrecht, 2008
- Keukenschrijver*, Patentinichtigkeitsverfahren, 4<sup>th</sup> ed. 2011
- Klauer/Möhring*, Patentrechtskommentar, 3<sup>rd</sup> ed. 1971
- Köhler/Bornkamm*, UWG, 29<sup>th</sup> ed. 2011
- Kraßer*, Patentrecht, 6<sup>th</sup> ed. 2009
- Kühnen*, Handbuch der Patentverletzung, 5<sup>th</sup> ed. 2011
- Larenz/Wolf*, Allgemeiner Teil des Bürgerlichen Rechts, 9<sup>th</sup> ed. 2004
- Loth*, Gebrauchsmustergesetz, 2001
- Loewenheim*, Handbuch des Urheberrechts, 2<sup>nd</sup> Ed. 2010
- Mes*, Münchener Prozessformularbuch, Vol. 5, Gewerblicher Rechtsschutz, Urheber- und Presserecht, 2<sup>nd</sup> ed. 2005
- Mes*, Patentgesetz – Gebrauchsmustergesetz, 3<sup>rd</sup> ed. 2011
- Münchener Kommentar InsO*, 2<sup>nd</sup> ed. 2008
- Musielak (Ed.)*, Kommentar zur Zivilprozessordnung, 8<sup>th</sup> ed. 2011
- Nieder*, Die Patentverletzung, 2004
- Nirk/Ullmann*, Patent-, Gebrauchsmuster- und Sortenschutzrecht, 3<sup>rd</sup> ed. 2006
- Osterrieth*, Patentrecht, 4<sup>th</sup> ed. 2010
- Palandt*, Bürgerliches Gesetzbuch: BGB, 70<sup>th</sup> ed. 2011
- Pahlow*, Lizenz und Lizenzvertrag im Recht des Geistigen Eigentums, 2006
- Pfaff/Osterrieth (Eds)*, Lizenzverträge – Formulkommentar, 3<sup>rd</sup> ed. 2010
- Piper/Ohly/Sosnitza*, Gesetz gegen den unlauteren Wettbewerb, 5<sup>th</sup> ed. 2010
- Pitz*, Patentverletzungsverfahren, 2<sup>nd</sup> ed. 2010
- Rauscher (Ed.)*, Europäisches Zivilprozessrecht und Kollisionsrecht, Bearbeitung 2010
- Rauscher/Wax/Wenzel (Eds)*, Münchener Kommentar zur Zivilprozessordnung, 3<sup>rd</sup> ed. 2008
- Rebel*, Gewerbliche Schutzrechte, 6<sup>th</sup> ed. 2009
- Reich*, Gestaltung und Änderung europäischer Patentansprüche, 2009
- Reich*, Materielles europäisches Patentrecht, 2009
- Rippe*, Europäische und internationale Patentanmeldungen, 3<sup>rd</sup> ed. 2003
- Säcker, Rixecker (Eds)*, Münchener Kommentar zum BGB, 5<sup>th</sup> ed. 2010
- Saenger (Ed.)*, Zivilprozessordnung, 4<sup>th</sup> ed. 2011
- Schack*, Urheber- und Urhebervertragsrecht, 5<sup>th</sup> ed. 2010
- Schickedanz*, Die Formulierung von Patentansprüchen, 2<sup>nd</sup> ed. 2009
- Schramm*, Der Patentverletzungsprozeß, 6<sup>th</sup> ed. 2010
- Schricker/Loewenheim*, Urheberrecht, 4<sup>th</sup> ed. 2010
- Schulte*, Patentgesetz mit Europäischem Patentübereinkommen, 8<sup>th</sup> ed. 2008
- Singer/Stauder*, Europäisches Patentübereinkommen (EPÜ), 5<sup>th</sup> ed. 2009
- Stein/Jonas*, Kommentar zur Zivilprozessordnung, 22<sup>nd</sup> ed. 2004
- Ströbele*, Markengesetz, 10<sup>th</sup> ed. 2012
- Teplitzky*, Wettbewerbsrechtliche Ansprüche und Verfahren, 10<sup>th</sup> ed. 2011
- Tetzner*, Leitfaden des Patent-, Gebrauchsmuster- und Arbeitnehmererfindungsrechts der Bundesrepublik Deutschland, 3<sup>rd</sup> ed. 1983
- Thomas/Putzo*, ZPO, 29<sup>th</sup> ed. 2008
- Troller*, Immaterialgüterrecht, 3<sup>rd</sup> Ed., Vol. I 1983, Vol. II 1985
- Uhrich*, Stoffschutz, 2010
- Ullmann*, jurisPK-UWG, 2<sup>nd</sup> ed. 2009
- Ulmer*, Urheber- und Verlagsrecht, 3<sup>rd</sup> ed. 1980
- van Hees/Braitmayer*, Verfahrensrecht in Patentsachen, 4<sup>th</sup> ed. 2010
- van Venrooy*, Patentrecht einschließlich Arbeitnehmererfinder- und Vertragsrecht, 1996

*Wandtke/Bullinger*, Urheberrecht, 3<sup>rd</sup> ed. 2009  
*Watchorn/Veronese*, PCT Procedures and Passage into the European Phase, 2008  
*Witte/Vollrath*, Praxis der Patent- und Gebrauchsmusteranmeldung, 6<sup>th</sup> ed. 2008  
*Zöller*, Zivilprozessordnung: ZPO, 29<sup>th</sup> ed. 2012

#### Selected articles on patent law in *Festschriften*

Festschrift 25 Jahre Bundespatentgericht, 1986  
Festschrift 50 Jahre Bundespatentgericht, 2011  
Festschrift für Günther Eisenführ zum 70<sup>th</sup> Geburtstag, 2003  
Festschrift Gewerblicher Rechtsschutz und Urheberrecht in Deutschland, 1991  
Festschrift für Rudolf Kraßer zum 70<sup>th</sup> Geburtstag, GRUR Int. Heft 9/2004  
Festschrift für Klaus-Jürgen Melullis zum 65<sup>th</sup> Geburtstag, GRUR Heft 3–4/2009  
Festschrift für Peter Mes zum 65<sup>th</sup> Geburtstag, 2009  
Lohn der Leistung und Rechtssicherheit, Festschrift für Albert Preu zum 70<sup>th</sup> Geburtstag, 1988  
Patentrecht, Festschrift für Thomas Reimann zum 65<sup>th</sup> Geburtstag, 2009  
Festschrift für Rüdiger Rogge zum 65<sup>th</sup> Geburtstag, GRUR Heft 10–11/2001



# Table of Contents

Foreword .....	V
List of Contributors .....	VII
Content overview .....	IX
Abbreviations and Acronyms .....	XI
Bibliography .....	XVII

## § 1. Introduction

A. Ambit, meaning, goals and means of patent law .....	3
I. Subject matter and legal principles .....	4
II. Aims and justifications of patent law .....	5
III. Critique .....	6
B. Historic development .....	7
I. The German patent law until 1945 .....	7
II. German patent law until 1981 .....	8
III. Reunification .....	9
IV. Development of European patent law .....	10
V. Recent developments .....	11
1. European patent law .....	11
2. Changes of the Patent Act .....	11
C. Relevant sources of law .....	12
I. European patent law .....	12
1. European Patent Convention (EPC) .....	12
2. Implementing Regulations to the Convention on the Grant of European Patents .....	12
3. Guidelines for Examination .....	13
4. Protocol on the Interpretation of Article 69 EPC .....	13
5. The London Agreement on the Application of Article 65 EPC .....	13
6. Decision, communications and other legal acts .....	14
II. Legal sources of the German patent law .....	14
1. German Patent Act ( <i>PatG</i> ) .....	14
2. Utility Models Act ( <i>Gebrauchsmustergesetz/GebrMG</i> ) .....	14
3. Laws governing costs and fees .....	14
4. Employee Invention Act ( <i>Arbeitnehmererfindergesetz/ArbnErfG</i> ) .....	15
5. Law on international patent conventions ( <i>Gesetz über Internationale             Patentübereinkommen/IntPatÜG</i> ) .....	15
III. International patent law .....	15
1. The Paris Convention (PC) .....	15
2. Strasbourg Convention .....	16
3. Patent Cooperation Treaty (PCT) .....	16
4. TRIPS-Agreement .....	16
5. Failed Anti-Counterfeiting Trade Agreement (ACTA) .....	17
6. “TRIPS-plus” – Free trade agreement .....	17
IV. Legal sources of EU patent law .....	17
1. Primary community law (Art. 34, 36, 101, 102 TFEU) .....	17
2. Secondary community law .....	18
a) Directives .....	18
b) Regulations .....	18
D. Patent law and neighbouring legal fields .....	19
I. Constitutional law .....	19

II. Civil law .....	20
1. Tort law .....	20
2. Contract law .....	21
3. Law of unjust enrichment .....	21
4. Property law .....	22
III. Patent and other intellectual property rights .....	23
1. Patent and copyright law .....	23
2. Patent and trademark law .....	24
3. Patent law and the Plant Variety Protection Act .....	24
IV. Patent law and the law against unfair competition .....	25
1. Technical achievements with commercial particularity .....	25
2. Statutory actions .....	26
V. Patent law and protection of technical know-how .....	27
1. Overview .....	27
2. Patent and know-how protection .....	27
3. Reasons for know-how protection next to patent protection .....	28
E. Patent law and competition law .....	28
I. General .....	29
1. Patents as restrains on competition? .....	29
2. The pharmaceutical sector enquiry of the European Commission and its tendencies of development .....	30
3. German and European competition law .....	31
II. Prohibition of agreements and practices restraining competition according to Art. 101 TFEU .....	31
1. Overview .....	31
2. Cases of patent related competition restraints .....	31
a) Transfers of IP rights .....	31
b) Agreements to license .....	32
c) Pay-for-delay agreement .....	33
d) Patent pools and standardizing agencies .....	35
3. Exemption according to Art. 101 para. 3 TFEU .....	36
a) General .....	36
b) Technology transfer block exemption regulation (772/2004/EC) .....	36
c) EU rule on research and development agreements (1217/2010/EU) .....	38
d) BER on specialisation agreements (1218/2010/EU) .....	40
e) BER on vertical agreements and concerted practices (330/2010/EU) .....	40
f) Guidelines on the applicability of Article 101 TFEU to horizontal co-operation agreements (2011/C 11/01) .....	41
III. Prohibition of abuse according to Art. 102 TFEU .....	41
1. Meaning .....	41
2. Dominant position in the market .....	42
a) Tenet .....	42
b) Market dominance on the product and license market .....	43
c) Particularities of market delineation in the pharmaceutical sector .....	44
3. Abuse of a market dominating position .....	44
a) General .....	44
b) Attainment of a market dominant position as abuse? .....	44
c) Extension of an existing market dominant position with the help of patents ...	44
d) Patent acquisition by means of misleading application information .....	45
e) Assessment of defensive patent strategies – “blocking patents” .....	46
f) Patent thickets .....	47
g) Price abuse .....	48
h) Deregistration and life cycle strategies in the pharmaceutical sector .....	48
i) Violation of competition law with respect to parallel importers .....	49
j) License denial .....	49
IV. Patent law and merger control .....	50
1. Meaning .....	50
2. Acquisition of assets (sec. 37 para. 1 no. 1 GWB) .....	51

3. Acquisition of control (sec. 37 para. 1 no. 2 lit. a GWB) .....	51
4. Essentiality .....	52
a) Scope of application .....	52
b) Essentiality when acquiring assets (sec. 37 para. 1 no. 1 GWB) .....	52
c) Essentiality when acquiring control (sec. 37 para. 1 no. 2 GWB) .....	53
5. European merger control .....	53
6. Turnover threshold .....	54
F. Patent law and the European Single Market .....	54
I. Patents as non-tariff trade barriers according to Art. 34, 36 TFEU .....	54
II. European exhaustion .....	55
1. Content .....	55
2. Legal basis .....	56
3. Exhaustion of IP rights after placing goods in circulation in EU member states which lack patent-protection for such goods .....	56
4. No exhaustion from placing products in circulation due to compulsory licenses .....	56
5. European and international exhaustion .....	57
III. Compulsory licenses .....	57
IV. No disguised restrictions on trade .....	57
 <b>§ 2. Inventions and their amenability to patent protection</b> 	
A. The “Technical Invention” criterion .....	65
I. Summary .....	65
II. Introduction .....	65
1. The concept of invention as a functional legal term .....	65
2. The limiting function of the invention concept .....	66
3. Dynamic openness of the concept of invention .....	67
III. Approach by consideration of inventiveness .....	68
1. Principle .....	68
2. Achievement-related approach in case law .....	69
a) German case law .....	69
b) EPO Board of Appeal case law .....	72
3. The principle of achievement-related consideration in the literature .....	74
4. Special examples of the principle of achievement-related consideration in case law and literature .....	74
a) The extreme core theory .....	74
b) Technical contribution to the art .....	75
c) Technical thinking .....	76
d) “Technical problem” criterion .....	77
e) “Technical effect” criterion .....	77
5. Alternatives to the principle of achievement-related consideration? .....	78
a) The teaching of “assessment in entirety” or “phenotypical consideration” ....	78
b) The balanced consideration approach .....	79
IV. The “technical” art in patent law: Tradition Theory .....	80
1. Principle .....	80
2. Other definitions of the term “technical invention” in case law and literature ...	83
a) The “Red Dove Formula” .....	83
b) Technical invention as a problem solution .....	84
c) The development of “Features” of a patentable invention .....	86
d) “Reproducibility” (workability), “being finished” and “technical usefulness” as features of a technical invention .....	86
e) Progressiveness as a feature of the technical invention .....	87
f) Social usefulness as a feature of technical inventions .....	87
g) Repeatability as a feature of the technical invention .....	88
h) Orientation by economic and commercial criteria .....	90
B. Catalogue of exclusions (Section. 1 para. 3–4 PatG resp. Art. 52 para. 2–3 EPC) .....	90
I. Abstract .....	90
II. History of the Catalogue of Exclusions .....	91

III. Principle .....	96
IV. Discoveries .....	97
1. Linguistic meaning .....	97
2. Legal significance .....	97
a) Patentability of natural materials .....	98
b) Patentability of functional discoveries .....	98
c) The problem of inventive step in a discovery .....	99
d) The problem of “practical applicability” .....	100
e) The problem of “abstract” claims .....	101
V. Scientific theories .....	101
VI. Mathematical methods .....	102
1. Linguistic meaning .....	102
2. Legal significance .....	102
3. Other interpretations in case law and literature .....	103
a) “Absolute” bar to the patentability of mathematical algorithms .....	103
b) Requirement of linkage to a purpose in the patent claim .....	104
VII. Aesthetic creations .....	105
1. Linguistic meaning .....	105
2. Legal significance .....	105
VIII. Plans, rules and methods for intellectual activities .....	106
1. Linguistic meaning .....	107
2. Legal significance .....	107
a) Mnemonic techniques, sorting diagrams, book-keeping and stenography techniques, teaching methods, etc. ....	107
b) Forms, symbols and scales, etc. ....	108
c) Advertising techniques .....	109
d) Ground plans for houses, etc. ....	109
e) Computer programs .....	109
f) No “monopoly on thinking”? .....	109
IX. Plans, rules and methods for playing games .....	110
X. Plans, rules and methods for business activities .....	110
1. Linguistic meaning .....	110
2. Legal significance .....	110
a) EPO Appeal Board case law .....	111
b) German case law .....	113
XI. Programs for data processing equipment .....	115
1. Linguistic meaning .....	115
2. Legal significance .....	115
a) Principle .....	115
b) Approaches to interpretation in German case law .....	116
c) Interpretation approaches in EPO practice .....	117
d) Interpretation in the literature .....	118
e) Evaluation of case law .....	119
XII. Presentation of information .....	121
1. Linguistic meaning .....	121
2. Legal significance .....	122
a) Principle .....	122
b) Cases .....	123
C. The “industrial applicability” criterion .....	124
I. Principle .....	124
II. Industrial applicability of genetic sequences (Section 1 a para. 3 PatG) .....	126
D. Obstacles to protection .....	127
I. General remarks .....	127
II. Offence against <i>ordre public</i> and morality .....	127
1. <i>Ordre public</i> .....	128
2. Morality .....	128
III. Special provisions concerning biotechnology inventions .....	129

E. Differentiation from the state of the art .....	129
I. Legal sources .....	130
1. Legal sources for the European patent .....	130
2. Legal sources for German patents .....	131
II. The skilled person .....	131
1. The person skilled in the art .....	131
2. General knowledge of the skilled person .....	132
3. The skilled person's technical field .....	133
4. The skills of the person skilled in the art .....	134
5. Expert groups .....	135
III. The patent claim – the claimed invention .....	136
1. Claim categories .....	136
2. Interpretation of patent claims .....	137
3. The problem on which the invention is based .....	140
4. Priority of the claimed invention .....	141
5. Substances for medical procedures .....	141
IV. State of the art .....	142
1. Basic concept .....	142
2. Different sources of disclosure .....	143
a) Written sources .....	143
b) Oral sources of disclosure .....	143
c) Public prior use .....	144
d) Other forms of disclosure .....	145
3. Public access .....	145
a) Examples of access to written descriptions .....	148
b) Examples of accessibility of oral descriptions .....	149
c) Examples of prior public use .....	149
4. The priority of prior knowledge .....	150
5. Later published patent applications with a earlier priority as state of the art:	
Senior rights .....	151
a) Senior rights in relation to national patent applications .....	152
b) Senior rights in relation to European patent applications and European	
patents .....	153
6. Contents of the sources of disclosure .....	154
a) General rules for establishing disclosed content .....	154
b) Inevitable features and (interim) results .....	157
c) Implicit disclosure, inherent features .....	158
d) The technical drawing .....	158
e) Chemical formulae .....	159
f) Intervals of parameters .....	159
g) Functional connection .....	159
h) Reference to other documents .....	160
i) Realizability .....	161
j) Mistakes in publication .....	161
k) Medical uses .....	162
l) Sources of information of a later date (auxiliary information sources) .....	162
7. Non-prejudicial disclosures .....	162
a) In the event of abuse .....	162
b) International exhibitions .....	163
V. Novelty .....	163
1. Meaning and purpose .....	163
2. Assessing novelty .....	164
a) The patent claims as the key subject-matter of the invention under	
examination .....	164
b) The skilled person .....	164
c) The timing of examination .....	164
d) The individual comparison .....	165
e) Criteria for novelty-destroying disclosure of features .....	166

f) Senior rights .....	173
g) The disclaimer .....	173
h) Substances for medical procedures .....	174
3. Non-prejudicial disclosures .....	175
4. The relationship with other legal requirements .....	175
VI. Inventive step .....	176
1. Significance and purpose .....	176
2. Assessing inventive step .....	176
a) Patent claims as the decisive object of examination .....	177
b) Consistent subject-matter .....	178
c) The actual contribution .....	178
d) The date of the examination .....	179
e) The relevant prior art .....	179
f) Combining citations .....	180
g) The person skilled in the art and consultation of other skilled persons from other technical fields .....	181
h) Criteria for a solution to be obvious from the state of the art .....	181
ff) Combinations of known individual features known .....	193
i) Evidence for the presence of inventive step: supporting considerations .....	194
j) Mistakes in the patent application .....	201
3. Substances for medical processes .....	201
4. Relations to other legal requirements .....	202
a) Relation to technicality .....	202
b) Relation to realizability (reproducibility) .....	204
c) Relation to an inadmissible extension .....	205
d) Relation to clarity .....	206
e) Relation to unity .....	206
F. Realisability and sufficiency of disclosure for realisability .....	207
I. Legal sources .....	207
II. Realisability .....	207
1. Connection with the concept of invention .....	208
2. Aspects of realisability .....	209
a) Usefulness .....	210
b) Completeness .....	211
c) Repeatability .....	211
d) Further aspects? .....	211
3. Relation to other patentability criteria .....	212
4. Relation to the requirement of sufficient disclosure .....	213
5. Practical consequences .....	215
III. Sufficient disclosure .....	217
1. The invention .....	217
2. Disclosure .....	218
a) Clearness .....	220
b) Completeness .....	222
3. Ability to carry out an invention .....	223
a) The decisive point in time when the invention can be carried out .....	223
b) Examination of disclosure for the purposes of realisability .....	227
4. Particularities in the case of biotechnology .....	235
5. Proof of sufficiency of disclosure and the burden of proof .....	238

### § 3. Ownership

A. Inventor and inventor right .....	243
I. Overview .....	243
II. The inventor .....	243
1. Inventor as natural person .....	243
2. Inventor as material beneficiary and the applicant fiction .....	244

III. The inventive process .....	244
1. Physical act .....	244
2. Completion and announcement of the invention .....	244
IV. Personal inventor right .....	245
V. Right of invention and right to a patent .....	246
1. Emergence .....	246
2. Scope of protection .....	246
3. Classification .....	247
B. Multiple owners .....	247
I. Criteria for joint inventorship .....	248
1. Nature of the contribution .....	248
a) Intellectual collaboration .....	248
b) Creative contribution .....	249
c) Independence of the contribution .....	250
d) For resolving a particular problem .....	250
2. Commonality of the invention .....	251
II. The inventor's rights in the case of a joint invention .....	251
1. The inventor's personal rights in the case of a joint invention .....	252
2. The property-right components of the co-inventor's rights .....	252
III. Derivative acquisition of joint inventorship of the invention .....	252
IV. Legal relationship of the co-inventors to the invention .....	253
1. The Partnership of part owners .....	255
a) Agreement relating to the partnership .....	255
b) Free disposal of the inventor's rights as part of the partnership assets .....	255
c) Administration of the inventor's rights .....	256
d) Use of the invention .....	257
e) Claims for compensation and indemnification .....	259
f) Termination and dissolution of the partnership .....	259
2. Co-ownership by defined shares .....	260
a) Size of the share .....	261
b) Disposal of the invention as a whole and the ownership share .....	262
c) Administration .....	264
d) Right of use of the part owners .....	266
e) Claim for compensation .....	267
f) Termination and dissolution of the partnership .....	268
V. Double inventors .....	269
VI. Plurality of Patent owners in proceedings .....	270
1. Partnership of part owners .....	270
2. Partnership of part owners .....	271
C. Recovery of inventors' rights ( <i>rei vindicatio</i> ) .....	272
I. The claims to the recovery of an inventor's rights .....	272
1. Persons entitled .....	273
a) The inventor or his successor in title .....	273
b) The possessor of the invention injured by usurpation .....	274
2. Obligor .....	275
3. Subject matter of the recovery of rights .....	275
a) Total or partial recovery of rights .....	275
b) Identical nature .....	276
c) Identical invention .....	277
d) Finished invention .....	278
e) No examination of patentability .....	278
4. Cut-off period with exceptions .....	279
5. Forfeiture of rights .....	280
II. Ancillary claims of the obligee and obligor .....	280
III. Asserting the recovery of rights by taking legal action .....	282
1. Jurisdiction .....	282
a) International jurisdiction .....	282

b) Local jurisdiction .....	282
c) Substantive jurisdiction .....	283
2. Need for legal protection and relationship with other legal remedies .....	283
3. Motions .....	284
4. Obligation to present arguments, and burden of proof .....	284
5. Further aspects .....	285
IV. Securing the claim to the recovery of rights by means of a temporary injunction ..	285
1. Content of the protective measure .....	286
a) Protecting German patent applications and patents, including German parts of granted European patents .....	286
b) Protecting European patent applications .....	286
c) Protecting foreign intellectual property rights including foreign parts of granted European patents .....	286
2. Requirements regarding the obligation to present evidence and arguments in support of the entitlement to an injunction .....	287
3. Grounds for an injunction .....	287
a) Claim to the recovery of rights specifically jeopardised .....	287
b) Refutation of urgency .....	288
4. Cautions dispensable .....	289
V. The defence of fraudulent intent in patent infringement proceedings .....	289
VI. Usurpation as a ground for revocation in German opposition proceedings .....	290
1. Conditions .....	290
2. Principle of arguments presented <i>intra partes</i> and principle that the parties delimit the subject matter of the proceedings .....	291
3. Relationship with the proceedings for the recovery of rights and the need for legal protection .....	292
4. Right to make a second filing .....	293
VII. Usurpation or lack of entitlement as a ground for nullity in nullity proceedings ...	294
VIII. Intervention in the European patent grant procedure .....	294
1. Staying the proceedings for grant .....	295
2. Prohibition on withdrawal .....	295
3. Triple choice .....	295
<b>§ 4. Patent transfer and licensing</b>	
A. Common foundations of patent transfer and licensing .....	299
I. Relevance and sources of law .....	300
II. Transferrable patent rights .....	300
1. The patent and its antecedent forms as legal transfer objects .....	300
2. Transfer of patents as part of technology transfer agreements .....	301
III. Forms of patent transfer .....	301
1. Full transfer .....	301
2. Limited transfer of rights .....	301
3. Transfer due to death .....	302
IV. Dispositions, separation principle and the principle of the abstract nature of rights in rem .....	302
V. No bona fide acquisition .....	302
VI. Anticipatory disposal .....	303
VII. Rules of interpretation and the theory of transfer tied to purpose .....	303
VIII. Relevance of the patent registry for the assignment of rights .....	304
IX. Application of rules of general civil law .....	305
1. Rescission .....	305
2. Ineffectiveness and invalidity, sec. 134, 138 BGB .....	306
3. Applicability of further civil law rules .....	306
B. Full transfer of patents .....	307
I. General .....	307
II. Form .....	307
III. Default in performance and warranty for defects .....	307

1. Warranty in law of sales .....	307
a) Preliminary notes .....	307
b) Liability for defects .....	308
c) Liability for sound title .....	309
2. Liability for failure to perform .....	310
C. Licenses .....	311
I. Economic relevance and statutory provisions .....	311
II. Terminology .....	312
III. Form .....	312
IV. Structure of exclusive and non-exclusive licenses .....	312
1. Preliminary notes .....	312
a) Necessity of approximation between types of licenses .....	312
b) Structural independence irrespective of the breadth of rights assigned .....	313
2. Exclusive licenses .....	313
3. Non-exclusive licenses .....	314
a) The legal position of the non-exclusive licensee .....	314
b) Non-exclusive license as positive right of use .....	314
4. Sole licenses .....	314
5. Negative licenses .....	315
6. Consent .....	315
V. Dogmatic fundamentals of the granting of a license .....	315
1. Relevance of this inquiry .....	315
2. Licenses as rights in rem .....	315
a) Exclusive licenses .....	315
b) Non-exclusive licenses as right in rem .....	316
3. Separation principle and the principle of the abstract nature of rights in rem ...	317
VI. Issuance of sub-licenses and transfer of licenses .....	318
1. Issuance of sub-licenses .....	318
a) Disposition by authorised party .....	318
b) Approval requirements .....	318
2. Transfer of licenses .....	319
a) Exclusive licenses .....	319
b) Non-exclusive licenses .....	320
c) Consequences of the invalidity of the obligation to transfer the license .....	320
3. Consequences of the unauthorized issuing of sub-licenses or transfer of licenses .	320
VII. Elements of contract design .....	321
1. Overview .....	321
2. Personal scope of application .....	321
3. Territory subject to a license .....	322
4. Duration .....	322
5. Modalities of remuneration .....	323
6. Rights of use .....	323
a) Overview .....	323
b) Production and distribution license .....	323
c) License for use .....	324
d) Simultaneous transfer of patent related know-how .....	324
7. Non-challenge clause .....	324
8. Restraint of competition .....	325
9. Warranty .....	325
10. Other typical contractual obligations .....	325
11. Differentiation between the infringement of the executory agreement and the patent .....	326
a) Necessity of the differentiation .....	326
b) Limits to splitting up agreements to license .....	326
c) Consequences of infringement .....	327
VIII. Protection against interim dispositions .....	327
1. Overview and dogmatic classification .....	327
2. Effect of protection against interim dispositions .....	328

IX. Termination of licenses .....	329
1. Expiry of term of protection and other reasons for the cessation of a patent .....	329
2. Termination or cessation of a license .....	329
a) Prevailing opinion .....	329
b) Conclusions from the application of the principle of the abstract nature of rights in rem .....	329
c) Exceptional automatic return despite the applicability of the principle of the abstract nature of rights in rem .....	330
3. Consequences of the cessation of the primary license for the sub-license .....	330
<b>§ 5. Grant and rejection of patents</b>	
A. The proceedings for grant .....	338
I. The European Proceedings for Grant .....	339
1. Overview of the proceedings and its stages .....	340
2. The application .....	341
a) Two ways to file a European patent application: Direct application and Euro PCT application .....	341
b) The applicant and his representative .....	344
c) Text of the application and drawings .....	347
d) Request for grant .....	372
e) Fees .....	374
f) Designation of the inventor .....	386
g) <i>Priority Background</i> .....	388
h) Obligation to mention the prior art .....	394
i) Filing requirements for the accordance of a date of filing .....	395
j) Filing an application .....	399
3. Effect of a filing .....	404
4. Examination on filing and examination as to formal requirements .....	404
a) Examination on filing .....	405
b) Examination as to formal requirements .....	405
5. Search .....	407
a) Subject-matter of the search .....	408
b) Scope of the considered state of the art .....	412
c) The search report .....	412
d) The applicant's response to the search report .....	413
6. Publication of the application .....	416
7. Examination procedure .....	418
a) Summary .....	418
b) Request for examination .....	419
c) Communications during examination .....	420
d) Observations by third parties .....	422
e) Response options of the applicant .....	422
f) Oral proceedings .....	424
g) Grant .....	427
h) Refusal .....	433
i) Appeal and correction of decisions .....	433
8. Amendments and corrections .....	433
a) Time limitations for amendments .....	434
b) Procedural limitations for amendments .....	435
c) Subject-matter limitations for amendments .....	436
d) Correction of errors and mistakes .....	441
9. Divisional applications .....	442
a) Applicant of a divisional application .....	443
b) Period for filing a divisional application .....	444
c) Subject-matter and content of a divisional application .....	446
10. Special requirements for PCT applications .....	448

11. Time limits and failure to observe time limits .....	451
a) Calculation of periods .....	452
b) Extension of a time limit .....	453
c) Observation of a time limit .....	454
d) Failure to observe a time limit .....	455
12. Accelerated prosecution of applications .....	458
II. National patent grant procedure .....	459
1. Overview of the procedure and its stages .....	459
2. The application .....	459
a) Two paths to a German patent application: direct application and PCT application .....	460
b) The applicant and its representative .....	460
c) Application text and drawings .....	462
d) Request .....	468
e) Fees .....	469
f) Designation of the inventor .....	472
g) Priority .....	474
h) Minimum requirements for the accordance of a date of filing .....	476
i) Filing of the application .....	477
3. Examination for obvious defects .....	478
4. Search .....	480
a) Search request .....	480
b) Subject-matter of the search .....	481
c) Scope of consideration of prior art .....	482
d) The search report .....	482
5. Publication of the application .....	482
6. Examination procedure .....	483
a) Overview .....	483
b) Request for examination .....	484
c) Examiner's communications .....	485
d) Options of the applicant .....	487
e) Hearing .....	487
f) Grant .....	488
g) Rejection .....	489
h) Appeal from and correction of decisions .....	489
7. Amendments and corrections .....	489
a) Time limits for amendments .....	490
b) Restrictions regarding the nature of amendments .....	490
c) Implementation of amendments .....	491
d) Correction of errors .....	491
8. Divisional applications .....	492
a) Divisional applications .....	492
b) Divisional applications by elimination .....	496
9. Special requirements for PCT applications .....	498
10. Time limits and failure to observe time limits .....	499
a) Further processing .....	500
b) Reinstatement .....	501
B. Opposition proceedings .....	501
1. The procedure before the European Patent Office .....	502
1. Purpose, nature and object of the proceedings .....	502
2. Grounds for opposition .....	503
a) Lack of patentability .....	503
b) Insufficiency of disclosure .....	505
c) Inadmissible extension .....	505
d) No grounds for opposition .....	506
3. Overview of the course of the proceedings .....	506
4. Admissibility .....	507
a) Right to file an opposition .....	507

b) Formal requirements .....	508
c) Sufficiency of substantiation .....	511
d) Examining admissibility .....	512
5. Substantive examination of the opposition .....	516
a) Extent of the substantive examination .....	516
b) Grounds for opposition .....	516
c) Prior use as prior art .....	517
6. The patent proprietor's options for taking action and the written procedure .....	518
7. Oral proceedings .....	521
a) Preparing for oral proceedings .....	521
b) The course of the oral proceedings .....	521
8. Decision .....	523
9. Costs .....	524
10. Appeal .....	525
11. Intervention .....	525
12. Procedural matters .....	527
a) Right to be heard .....	527
b) Time limits and failure to observe them .....	528
c) Lateness .....	528
d) Withdrawal of the opposition .....	529
13. Change of the patent proprietor during opposition proceedings .....	529
14. Change in the person of the opponent .....	529
15. Accelerating the proceedings .....	529
II. The proceedings before the German Patent and Trade Mark Office .....	530
1. Purpose, nature and object of the proceedings .....	530
2. Grounds for opposition .....	531
a) Lack of patentability .....	531
b) Insufficiency of disclosure .....	531
c) Inadmissible extension .....	532
d) Usurpation .....	532
3. Course of the proceedings .....	533
4. Admissibility .....	533
a) Right to file an opposition .....	533
b) Formal requirements .....	534
c) Substantiation .....	535
d) Examining admissibility .....	536
5. Substantive examination of the opposition .....	536
a) Extent of the substantive examination .....	536
b) Grounds for opposition .....	536
6. The patent proprietor's options for taking action .....	537
7. Oral proceedings .....	538
8. Decision .....	538
9. Costs .....	539
10. Appeal .....	540
11. Intervention .....	540
12. Procedural matters .....	541
a) Right to be heard .....	541
b) Time limits .....	541
c) Lateness .....	541
d) Withdrawal of the opposition .....	541
13. Change of patent proprietor during the opposition proceedings .....	541
14. Change in the person of the opponent .....	542
C. Appeal proceedings .....	542
I. Proceedings according to the EPC .....	542
1. Purpose, nature and object of the proceedings .....	542
2. Overview of the course of the proceedings .....	543
3. Effects of filing an appeal .....	544

4. Admissibility .....	544
a) Appealable decisions .....	544
b) Entitlement to appeal .....	545
c) Notice of appeal .....	545
d) Grounds for appeal .....	546
5. Amendments to the patent application or the patent .....	549
a) Principles .....	549
b) Issues specific to multilateral proceedings .....	550
6. Oral proceedings .....	551
a) Principles .....	551
b) Preparing for oral proceedings .....	551
c) Conduct of the oral proceedings .....	551
7. Decision .....	552
a) Own decision on the merits .....	552
b) Remittal for a further decision by the department of first instance .....	552
8. Costs .....	553
9. Petition for review by the Enlarged Board of Appeal .....	553
a) Principles .....	553
b) Admissibility .....	553
c) Overview of the course of the proceedings .....	554
d) Decision .....	555
10. Intervening in opposition appeal proceedings .....	556
11. Miscellaneous procedural issues .....	556
a) Procedural principles .....	556
b) Right to be heard .....	556
c) Time limits and the consequences of the failure to observe them .....	556
d) Lateness .....	557
e) Withdrawal of the appeal .....	557
f) Withdrawal of the opposition in opposition appeal proceedings .....	558
12. Change in the person of the opponent .....	558
II. National Procedure .....	558
1. Purpose, Character and subject matter of the proceedings .....	559
2. Overview of the procedure .....	560
3. Effects of the lodging of an appeal .....	560
4. Admissibility .....	560
a) Appealable decisions – Permissibility .....	560
b) <i>Locus standi</i> .....	561
c) Notice of appeal .....	562
d) Time limit for submitting the statement of grounds for appeal .....	562
e) Examination of admissibility .....	563
5. Factual examination of the appeal .....	563
a) Scope .....	563
b) Examination of grounds of appeal in multilateral proceedings .....	564
6. Amendment of the patent application or specification .....	564
a) Principles .....	564
b) Special features of multilateral proceedings .....	564
7. Oral proceedings .....	564
a) Principles .....	564
b) Preparation of the oral hearing .....	565
c) Holding oral hearings .....	565
8. Ruling .....	565
a) Independent ruling .....	565
b) Remittal .....	566
9. Costs .....	566
10. Appeal on points of law .....	566
a) Principles .....	566
b) Differences compared to the appeal procedure .....	567
11. Intervention in appeal proceedings .....	567

12. Various procedural questions .....	568
a) Procedural principles .....	568
b) Right to be heard .....	568
c) Time limits and consequences of non-observance .....	568
d) Lateness .....	568
e) Withdrawal of the appeal .....	569
f) Withdrawal of the opposition in appeal proceedings .....	569
13. Change in identity of the opponent .....	569
D. Nullity proceedings .....	569
I. Purpose, character and subject-matter of the proceedings .....	570
II. Delimitation to opposition proceedings .....	571
III. Grounds for nullity .....	571
IV. Overview of the proceedings .....	572
1. First instance .....	572
2. Second instance .....	573
V. Procedure in the first instance .....	574
1. Filing of a complaint .....	574
a) Claimant .....	574
b) Defendant .....	575
c) Representative .....	576
d) Value of the subject matter .....	576
e) Prerequisites of admissibility .....	576
f) Fee .....	578
g) Security .....	579
2. Service of the writ and invitation to contest .....	580
a) Service .....	580
b) No contesting .....	580
c) Cost in case that no contesting reply is submitted .....	580
3. Statement of defence .....	581
4. Examination of admissibility .....	581
5. Examination as to substance .....	582
a) Subject-matter of the examination (review) as to substance .....	582
b) Amendment of the patent .....	583
6. Qualified interim report .....	584
7. Oral hearing .....	585
a) Principles .....	585
b) Preparation .....	585
c) Procedure in the oral hearing .....	585
8. Decision .....	586
VI. Appeal against the judgements .....	587
1. In general .....	587
2. Admissibility .....	588
3. Representation .....	588
4. Notice of appeal .....	588
a) Time limit .....	588
b) Requirements as to content and form .....	589
5. Statement of grounds for appeal .....	589
a) Time limit .....	589
b) Content .....	590
6. Fee .....	590
7. Procedure .....	591
8. Oral hearing .....	592
9. Basis of decision and decision .....	592
VII. Withdrawal of the action and settlement .....	594
E. Limitation and revocation proceedings .....	594
I. Purpose and nature .....	594
II. Delimitation to other procedures .....	595
III. Effect .....	595

IV. Procedure pursuant to the EPC .....	596
1. Formal requirements .....	597
a) Request .....	597
b) Fee .....	598
2. Examination as to substance .....	598
3. Decision and conclusion of the proceedings .....	600
a) Decision in revocation proceedings .....	600
b) Decision in limitation proceedings .....	600
V. National procedure .....	601
1. Formal requirements .....	601
a) Request .....	601
b) Fee .....	601
2. Requirements as to substance .....	601
3. Decision .....	601
F. Lapse without retroactive effect .....	602
I. Failure to designate the inventor .....	602
II. Surrender .....	602
III. Failure to pay annual fees or surcharge .....	603
IV. Expiry .....	603

## § 6. Interpretation and scope of protection of patents

A. Basic outline .....	607
I. The definition of interpretation .....	607
II. General remarks on determining the scope of protection .....	608
1. The meaning of the scope of protection in patent law .....	608
2. The patent specification and its interpretation as the basis for determining the scope of protection .....	608
3. Balancing interests between the reward function and legal certainty .....	608
III. Legal sources .....	609
1. Legal sources for European patents .....	609
a) Art. 69 EPC .....	609
b) Protocol on the Interpretation of Article 69 EPC .....	610
2. Legal sources for German patents .....	610
IV. Objective criterion for interpretation .....	611
1. The understanding of the person of average skill in the art .....	611
a) Level of education and practical professional experience .....	612
b) Average knowledge and skill .....	612
2. Relevant time .....	613
3. Criterion substantively unchanged over time .....	614
4. Distinction between interpretation and subsumption of the attacked embodiment under the scope of protection .....	615
V. Interpretation as a question of law/findings as to facts .....	615
VI. Functionally orientated interpretation .....	618
B. The importance of the patent specification as a source for interpretation .....	618
I. The authentic version of the patent specification .....	619
1. Authentic nature of the version in the language of the proceedings in the case of European patents .....	619
2. Consideration of later amendments .....	619
II. The patent specification as its own dictionary .....	620
III. Authoritative role of the claims .....	621
1. Categories of claims .....	622
2. The claim as the sum of its features .....	623
a) Unity of the claim .....	623
b) The feature analysis as an aid .....	624
c) Importance of all technical features .....	625
d) Peculiarities of statements of purpose, effect and function .....	626
e) Peculiarities of numerical and dimensional statements .....	627

f) Peculiarities of product-by-process wording .....	629
g) Explanatory reference numerals in the claim .....	631
3. The systematic structure of the respective claims .....	631
a) Relationship with independent claims .....	631
b) Relationship with dependent claims .....	632
IV. Comprehending the literal wording taking the description and drawings into account .....	633
1. Relationship between the description and the claims .....	633
2. Classic structure of the description .....	634
3. The technical background and state of the art mentioned in the patent .....	634
a) The range of relevant documents for interpretation purposes .....	634
b) Influence of the relevant documents on the interpretation .....	635
4. The object, or the technical problem .....	636
5. The general description of the idea behind the solution and its advantages .....	637
6. The description of worked embodiments .....	638
7. Illustration by means of drawings .....	639
8. The abstract .....	639
C. The importance of sources outside the patent specification .....	640
I. Common general knowledge .....	640
1. Definition of common general knowledge .....	640
2. The influence of common general knowledge on the substance of the interpretation .....	641
II. State of the art not mentioned in the patent specification and not forming part of the common general knowledge .....	641
III. Grant history .....	642
IV. Reasons for decisions in proceedings attacking validity .....	643
1. Prevailing teaching .....	644
2. Comment .....	644
D. Extension of the scope of protection to equivalents .....	647
I. Principles .....	647
II. Prerequisites for protection .....	648
1. The alternative means .....	648
2. The identical effect .....	649
3. Perceptibility .....	650
a) Relevant knowledge and skill .....	650
b) Point in time for perceptibility .....	651
c) Special constellations .....	652
4. Equivalent in value .....	653
a) Outline .....	653
b) Technical value judgments in the patent .....	654
c) Special constellations .....	655
III. "Formstein" defence .....	657
1. Outline .....	657
2. Examination criteria .....	658
3. Scope .....	659
IV. Procedural issues .....	660
1. Obligation to present arguments and burden of proof .....	660
2. Subject matter of the dispute .....	660
3. Motion .....	661

## § 7. Chemical and biological inventions

A. Introduction and development .....	664
I. Chemical inventions .....	665
1. General .....	665
2. Historical development and current status .....	665
a) <i>Patentgesetz of 1877 – PatG</i> (German Patent Act 1877) .....	665

b) Restatement 1891 .....	666
c) Abolition of the Substance Protection Prohibition 1967 .....	667
II. Biological inventions .....	670
B. Definitions, exceptions and special cases regarding biological inventions .....	672
I. Definitions regarding chemical and biological inventions .....	672
II. Exceptions and special cases regarding biological inventions .....	674
1. Inventions regarding the Human Body .....	674
2. Inventions regarding micro-organisms .....	677
3. Inventions regarding animals .....	678
4. Inventions regarding plants .....	678
C. Prerequisites for patent registration .....	680
I. General .....	682
II. Novelty and inventive step .....	682
1. Novelty of substances .....	683
a) Novelty of the first medical indication .....	683
b) Novelty of the second medical indication .....	685
b) Interim products .....	686
d) Polymorphic forms .....	687
e) Enantiomers .....	687
f) Markush formula .....	688
g) Selection inventions .....	689
h) Natural Substances .....	690
i) DNA sequences .....	691
2. Novelty of processes .....	691
3. Novelty of non-medical applications .....	691
III. Capability of industrial application .....	691
IV. Specific problems of feasibility .....	692
V. Particular problems in case of stem cells .....	694
D. Scope of protection and types of claims .....	695
I. Introduction .....	698
II. Absolute substance protection – range and wording of the unrestricted substance claim .....	699
1. General and scope of the substance claim .....	699
2. Most recent criticism of absolute substance protection .....	700
3. Drafting the claim .....	701
4. The product-by-process claim .....	703
III. Limited substance claim – range and wording of the claim .....	704
1. General .....	704
2. Purpose-bound substance protection .....	704
3. First medical indication .....	704
4. Second medical indication .....	706
5. Case studies on substance inventions and first and second medical indication .....	708
6. Function-bound substance protection .....	709
7. Indirect substance protection .....	711
IV. Process and utility claim – scope and wording of the claim .....	712
1. Process claims .....	712
2. Utility claims .....	713
E. Effects of the patent .....	715
I. Overview of §§ 9 a to 9 c PatG .....	715
II. Biological material, § 9 a PatG .....	716
1. General .....	716
2. Product patents, § 9 a para. 1 PatG .....	716
a) Propagation and multiplication .....	716
b) “with identical properties” .....	717
c) Scope of Protection .....	717
3. The process patent, § 9 a para. 2 PatG .....	717
4. Genetic information, § 9 a para. 3 PatG .....	718

III. The reproduction of biological material, § 9 b PatG .....	719
1. General .....	719
2. Exhaustion .....	719
a) General .....	719
b) Prerequisites .....	720
c) Restriction of § 9 b sentence 2 PatG .....	721
d) Legal consequence .....	721
IV. Use for agricultural purposes, § 9 c PatG .....	721
1. General .....	721
2. Farmers' privilege for crops, § 9 c para. 1 PatG .....	721
a) Variety constituents .....	721
b) Farmer .....	722
c) "For the purpose of agricultural cultivation" .....	722
d) His/her crops and farming operation .....	722
e) Use by the farmer .....	723
f) Legal consequence: Limitation of §§ 9, 9 a and 9 b sentence 2 PatG .....	723
g) Information and compensation claim .....	723
3. Farm animals or animal reproductive material, § 9 c Abs. 2 PatG .....	727
a) Farm animals .....	727
b. Animal reproductive material .....	727
c. Placing on the market .....	727
d. Use for agricultural purposes .....	728
e) Legal consequence .....	728
4. Accidental reproduction, § 9 c para. 3 PatG .....	728
a) Agriculture .....	728
b) Accidental reproduction .....	728
c) Burden of proof .....	729
d) Legal consequence .....	729

§ 8. Use of a patent

A. General .....	733
B. Direct use of a patent .....	733
I. General principles .....	733
1. Patents as monopoly rights and positive rights of use .....	733
2. Rights of use when patents collide .....	734
a) Positive right of use .....	734
b) Collision of patents with different priorities .....	734
c) Collision of patents with the same priority .....	735
3. Analysis of features and comparison of features .....	735
4. Objective criterion for determining the use of a patent .....	736
5. Improved embodiments and embodiments of poorer quality .....	736
a) Sub-combination .....	736
b) Dependent inventions .....	737
6. Implementation of plural use actions side-by-side or in succession .....	737
II. Individual elements of use .....	737
1. Product patents .....	738
a) Comprehensive exploitation rights in principle .....	738
b) Combining, mixing, further processing .....	738
c) Manufacturing .....	739
d) Offering .....	741
e) Placing in circulation .....	744
f) Using .....	746
g) Importing and possessing .....	746
2. Process patents .....	746
a) Preliminary remarks .....	746
b) Carrying out a patented process as a use of the patent .....	747
c) Offering a patented process to be carried out as a form of using a patent .....	748

d) Using in Germany .....	748
e) Protection of the direct product of a process .....	749
3. Employing use patents in the form of a “manifest arrangement” .....	753
C. Indirect use of a patent .....	753
I. Historical development .....	754
II. European law .....	754
III. Systematic position and purpose of section 10 PatG .....	755
1. Elements of risk as a preliminary to direct patent infringement .....	755
2. Delimitation from other forms of accompliceship in the law of tort .....	755
3. Typology of features of the constituent elements .....	756
a) Constituent elements relating to the nature of the means and others .....	756
b) Objective and subjective constituent elements .....	756
4. The special provisions of section 10 paras. 2 and 3 PatG .....	756
IV. The object of indirect patent infringement .....	757
1. The definition of the means .....	757
2. Means relating to an essential element of the invention .....	757
3. Means which are objectively suitable for being employed in order to use the invention .....	758
V. The prohibited act and its circumstances .....	760
1. Offering .....	760
2. Supplying .....	760
3. Limitations on the effects of the patent .....	760
4. Means must be intended to be used in accordance with the invention .....	761
5. Knowledge or obviousness .....	763
a) Knowledge relating to the nature of the use, not the patent granted .....	763
b) Knowledge of the suitability .....	763
c) Knowledge of the intention .....	763
d) Obviousness as an alternative to knowledge .....	764
e) Special considerations in the case of products which are generally commercially available .....	765
6. Double domestic nexus .....	766
VI. Relevant time for assessment .....	767
VII. The persons involved and their lack of legitimation .....	767
1. The perpetrator .....	767
2. The customer .....	768
VIII. Special cases .....	769
1. Supplying replacement parts .....	769
2. Indirect infringement of use claims .....	769
IX. Legal consequences .....	770
D. Liability and imputation .....	770
I. General principles .....	771
II. Patent infringement by the perpetrator .....	771
III. Complicity .....	771
IV. Liability of participants .....	772
1. General .....	772
2. Premeditated participation .....	772
3. Contributory infringement by omission .....	773
V. Indirect perpetration .....	774
VI. Vicarious liability .....	774
1. Analogue liability of executive bodies sec. 31 BGB .....	774
2. Liability for employees, representatives and vicarious agents .....	775
VII. Liability for violations of commercial obligations and interference liability .....	775
1. Accountability of third parties beyond contributory patent infringement .....	775
a) Nature of the interests involved .....	775
b) Scope of third party liability other than participant liability and contributory patent infringement .....	775

2. Taking interference liability and liability for violations of commercial obligations as a starting point .....	777
a) Evolution of interference liability in competition and trademark law .....	777
b) Terminology .....	777
3. Liability for violations of commercial obligations under patent law .....	778
4. Practical consequences .....	779
5. Content of commercial obligations under patent law .....	780
a) Transferability of case law in the areas of trademark, copyright and competition law .....	780
b) No proactive obligation to search .....	780
c) No liability for privileged patent usage .....	780
d) Isolated cases .....	781
6. Liability of executive bodies for patent infringements as liability for a violation of commercial obligations .....	783
<b>§ 9. Defences</b>	
A. Permitted acts under Section 11 PatG .....	790
I. Introduction .....	790
II. Acts in the private domain (Section 11 No. 1 PatG) .....	791
1. Acts in the private domain .....	791
2. Acts for non-commercial purposes .....	792
III. Privilege for experimentation (Section 11 No. 2 PatG) .....	792
1. Justification .....	793
2. What is an experiment or an act relating to the subject matter of a patented invention? .....	794
a) Opinion of the previous instance .....	794
b) Opinion of the BGH .....	794
3. Exempted acts and preparatory acts .....	796
4. Limitations of the privilege for experimentation .....	797
5. Contract research .....	797
6. Acts of facilitation by third parties (external deliveries) .....	798
a) Indirect infringement by the third party .....	798
b) Direct infringement by the third party .....	800
7. Research tools .....	800
IV. Use of biological material (Section 11 No. 2 a PatG) .....	800
V. Roche Bolar Rule (Section 11 No. 2 b PatG) .....	801
VI. Individual preparation of medical drugs (Section 11 No. 3 PatG) .....	802
VII. Other privileges (Section 11 No. 4–6 PatG) .....	802
1. Section 11 No. 4 PatG – Shipping .....	802
2. Section 11 No. 5 PatG – Air and land transportation .....	802
3. Section 11 No. 6 PatG – International civil aviation .....	803
B. Exhaustion .....	804
I. Introduction .....	804
II. Principle and justification .....	805
III. Conditions and scope of exhaustion .....	805
1. Putting on the market .....	806
a) Principle .....	806
b) Borderline cases .....	806
2. Consent .....	807
3. Scope of exhaustion .....	808
IV. Scope of exhaustion and ban on new manufacture .....	809
1. Flügelradzähler .....	809
2. Laufkranz decision .....	811
3. Pipettensystem decision .....	812
4. Summing up .....	813

V. Exhaustion in cases of method claims .....	813
1. No exhaustion for the method claim .....	814
2. Implied licence in the disposal of apparatus .....	814
VI. EU-wide and international exhaustion .....	815
1. EU-wide exhaustion .....	815
a) Principle and justification .....	815
b) Individual and special cases .....	816
2. No further international exhaustion beyond this .....	817
VII. Procedural aspects and burden of proof .....	818
C. Prior use law according to Section 12 PatG .....	818
I. Introduction .....	819
II. Arguments in justification of Section 12 PatG .....	819
III. Conditions of prior use .....	820
1. Possession of the invention .....	820
a) Possession of the invention .....	820
b) Honest and lawful possession of the invention .....	821
2. Use or arrangements for use .....	822
a) Use in Germany .....	822
b) Arrangements to use .....	823
3. Timing of use or arrangements for use and cessation of use and its consequences .....	824
a) Timing of use or arrangements for use .....	824
b) Cessation of use and its consequences .....	824
4. Entitlement to right of prior use .....	825
IV. Legal consequences of a right of prior use .....	826
1. Legal nature of right of prior use .....	826
2. Scope of the right of prior use for the immediate entitled person .....	826
a) Principle .....	826
b) Qualitative scope of the right of prior use – acts of use .....	826
c) Qualitative scope of the right of prior use – development of the invention ...	827
d) Quantitative scope of the right of prior use .....	828
3. Consequences of the right of prior use in favour of third parties .....	829
a) Principle .....	829
b) The problem of “indirect prior use” .....	829
V. Transfer of a right of prior use .....	831
VI. Other rights of continued use .....	831
1. Interim use between application and disclosure of the patent .....	831
2. Use after expiry of a patent and effective restitutio in integrum (Section 123 Para. 5 PatG) .....	831
3. Section 28 ErstrG .....	832
4. Positive right of use .....	832
a) Principle .....	832
b) Extent of the right of use .....	833
c) Procedural aspects .....	833
D. Defence of invalidity .....	834
I. Introduction .....	834
II. The connection between infringement proceedings and the invalidity action via Section 148 ZPO .....	835
III. Application of Section 148 ZPO .....	835
1. General conditions of Section 148 ZPO and procedures .....	836
2. Infringement proceedings of first instance .....	837
a) Decision or opinion from the nullity action .....	838
b) Prior art .....	838
c) Public prior use as a special case .....	839
d) Grounds for nullity .....	839
e) Behaviour of the defendant .....	839

3. Second-instance infringement proceedings .....	840
a) Defeat for patent proprietor and claimant in first-instance infringement proceedings .....	840
b) Victory for the patent proprietor and claimant in first-instance infringement proceedings .....	840
4. Infringement proceedings in the third instance .....	841
5. Special case: enforcement of a limited version of the claim .....	841
a) Present practice .....	841
b) <i>The Maschinensatz</i> decision .....	842
c) Criterion for examination .....	843
IV. Special case: Preliminary injunction proceedings .....	844
1. Principle .....	844
2. More recent tendencies and decisions .....	845
3. Further aspects and exceptions .....	847
E. Fraudulent abstraction .....	847
I. Introduction .....	847
II. The offence of usurpation .....	848
III. Use as a defence in infringement proceedings .....	849
F. Objection of a compulsory licence under antitrust law .....	851
I. Introduction .....	851
II. European law .....	852
III. National Law .....	853
1. The Standard-Spundfass ruling .....	853
2. The Orange Book Standard ruling .....	856
3. Implementation in case law and open questions according to the Orange Book Standard .....	858
a) Summary of the Orange Book mechanism .....	858
b) Point in time the offer has to be made .....	859
c) Content of the offer – no most-favoured-treatment, change in the practice of granting licences .....	860
d) Content of the offer – inadmissibility of conditions and degree of regulation .....	861
e) Content of the offer – Amount of royalty .....	862
f) Content of the offer – Regulation of the past .....	863
g) Content of the offer – territorial scope .....	864
h) Acts of performance – Deposit and rendering of accounts .....	865
i) Discrimination – selective legal enforcement/non-enforcement of the licence agreement .....	866
4. Rulings on patent pools and the transferability of the statements contained therein .....	867
a) Exploitative abuse – the unnecessary inclusion of patented technologies in the standard .....	869
b) Exploitative abuse – benchmarks in relation to the licence fee .....	869
c) National licence/global licence .....	870
d) Single licence for infringers/general licence for a group .....	871
e) Cap/royalty stacking .....	872
5. Procedural Aspects of the FRAND objection .....	872
a) Burden of proof .....	872
b) Delayed FRAND objection .....	873
c) Jurisdiction .....	873
6. Consequences for the Individual Claims .....	874
IV. Specifics of a Licensing Declaration (FRAND Declaration) .....	875
1. Introduction and Background .....	875
2. Content of a licensing declaration: the example of the ETSI declaration .....	875
3. Legal Consequences .....	876
a) Applicable law .....	876
b) Legal effects of such a declaration .....	877
c) Licensing willingness declaration and equal treatment of de-facto- and de-iure standard .....	879

G. Forfeiture of rights .....	880
I. Introduction .....	880
II. Requirements and consequences of a defence that the claim has been forfeited .....	880
1. The Temperaturwächter ruling .....	880
2. The requirements for a forfeiture of rights .....	881
a) Legal principle .....	881
b) Injunctive relief .....	881
c) Compensation for damages and unjust enrichment .....	883
3. Possible elements allowing for acceptance of a forfeiture of claims and individual aspects .....	884
a) Element of time and element of circumstance .....	884
b) Lack of knowledge of the patent .....	884
c) Flexible system in terms of the element of time and the element of circumstance .....	884
<b>§ 10. Legal consequences of patent infringement</b>	
A. Creditors and debtors of claims for infringement .....	890
I. Creditors .....	890
1. Registered owner .....	890
2. Extent of the registered owner's capacity to sue .....	891
3. Several owners .....	891
4. Others with property rights .....	891
5. Exclusive licensees .....	892
6. Other licensees .....	892
7. Transferred claims .....	892
II. Debtors .....	893
1. Potential debtors of an infringement claim .....	893
2. Infringer in the narrow sense .....	893
3. Patent infringement by "interferers" .....	893
a) Joint cause and promotion of a patent infringement by a third party .....	893
b) Liability as "interferer" when infringing statutory inspection duty .....	893
c) Extent of liability as interferer .....	894
4. Several debtors .....	894
B. Injunctive relief .....	896
I. Basis and conditions for the claim .....	896
1. Legal basis for the claim .....	896
2. Condition for injunctive relief in a nutshell .....	896
II. Risk of repetition and first perpetration .....	897
1. Risk of repetition .....	897
a) How a risk of repetition occurs .....	897
b) Removal of the risk of repetition .....	897
2. Risk of first perpetration .....	898
a) Cause of the risk of first perpetration .....	898
b) Removal of the risk of first perpetration .....	899
3. Personal extent of the risk of perpetration .....	899
III. Extent of the cease and desist obligation .....	900
1. Extent of the cease and desist obligation .....	900
2. Conditions for compliance with the cease and desist order .....	901
3. Beginning of the cease and desist obligation .....	901
4. Additional aspects of indirect patent infringement .....	902
IV. Claim for removal .....	903
C. Claim for damages .....	904
I. Basis and conditions for a claim for damages .....	904
1. Legal basis and purpose of a claim for damages .....	904
2. Fault of the infringer .....	905

II. Calculating the level of damages .....	907
1. There are three ways to calculate damages .....	907
a) The creditor's right to choose .....	907
b) Comparing the creditor's right to choose with the provisions of the Enforcement Directive .....	908
2. Damages actually suffered .....	908
a) Lost profit .....	909
b) Concomitant/accessory damages .....	909
c) Interest .....	910
3. Licence analogy .....	910
a) Basis of the calculation .....	910
b) Reference volumes .....	911
c) Royalty rate .....	912
d) Interest .....	915
4. Surrender of the infringer's profit .....	915
a) The relevance of infringer's profit .....	915
b) Infringer's relevant sales .....	916
c) Debtor's cost deductions .....	916
d) Causality of the infringer's profit .....	919
e) Interest .....	920
5. Calculation of damages for indirect patent infringement .....	920
D. Claims for unjust enrichment and claims for compensation .....	921
I. Legal basis of other compensation claims .....	921
II. General claim for unfair enrichment .....	922
III. Claim for residual damages .....	922
IV. Claims for compensation under Section 33 PatG and Law on International Patent Conventions Art II Section 1 .....	923
V. Claims for unjust enrichment and compensation in the case of indirect patent infringement .....	925
E. Claims for information and accounts .....	925
I. Legal basis .....	925
II. Information and accounts as a supporting claim .....	926
1. Basis and conditions for the claim .....	926
2. The contents of the claim .....	927
3. The sworn statement .....	927
4. The limits on the duty to provide information .....	928
III. Claim for information under Section 140 b PatG .....	929
1. Purpose and conditions of Section 140 b PatG .....	929
2. Claim for information from the infringer and interferer .....	929
3. Claim for information from other debtors .....	930
a) General conditions to be met .....	930
b) Debtors .....	930
4. The scope of the claim .....	931
5. Exclusion of the claim and inadmissibility as evidence .....	932
a) Debtor's right of refusal under Section 140 b Paragraph 2 PatG .....	932
b) Exclusion of claim if disproportionate .....	933
c) Inadmissible evidence in criminal proceedings .....	933
6. Liability of the person providing information .....	934
a) Liability for false or late information .....	934
b) Exemption from liability when correct information is provided .....	934
7. Reimbursement claim by the person providing information .....	935
8. Information on traffic data .....	935
9. Enforcement of claim for information in interim proceedings .....	936
IV. Claim for the disclosure of banking, financial and commercial documents .....	937
1. Legal base and purpose of the claim .....	937
2. The conditions for the claim .....	937
3. The scope of the claim .....	937
4. Refusal of claim if disproportionate .....	938

5. Order by interim injunction .....	938
6. Inadmissible evidence in criminal proceedings .....	939
7. Cost of production of documents .....	939
V. Claims for information and accounts in cases of indirect patent infringement .....	939
F. Claim for recall and destruction .....	940
I. Legal basis .....	940
II. Claim for destruction .....	940
1. General conditions for the claim .....	940
2. Debtors to the claim for destruction .....	941
3. Exclusion of claim if disproportionate .....	941
4. Implementation of destruction .....	942
5. The destruction of materials and apparatus .....	943
III. Claim for recall .....	943
1. Basis of the claim .....	943
2. The contents of the Claim .....	944
3. Exclusion of claim if disproportionate .....	944
IV. Recall and destruction claims in the case of indirect patent infringement .....	945
G. Statute of limitation for the claims .....	945
I. Statute of limitation pursuant to Section 141 PatG .....	945
II. The beginning of limitation .....	946
III. Limitation of the residual damages claim .....	947
IV. Statute of limitation of the claim for compensation .....	947
H. Publication of a judgment .....	948
I. Legal basis for publication of a judgment .....	948
II. Formal requirements for publication of a judgment .....	948
III. Legitimate interest .....	949
IV. The court's discretion .....	950
V. Type and extent of publication .....	950
VI. Using authorisation to publish .....	950

## § 11. European Patent and European Patent Court

I. Current position .....	951
II. The European Patent with unitary effect .....	952
1. European Court of Justice Opinion 1/09 of 8 <sup>th</sup> March 2012 .....	952
2. Enhanced cooperation: the “European Patent Package” .....	952
a) The Unitary Patent Regulation .....	953
b) Translation Regulation .....	954
c) Patent Court Agreement: Unified Patent Court (UPC) .....	954

## § 12. Other proceedings and claims in patent cases

A. Criminal patent law .....	959
I. General .....	959
II. Objective elements ( <i>actus reus</i> ) .....	960
1. Punishable alternative actions .....	960
2. “Acts carried out for commercial purposes/on a commercial basis” .....	961
3. Granted patents or supplementary protection certificates .....	961
4. Scope of patent protection .....	962
5. Offenders and accomplices .....	962
III. Subjective criteria ( <i>plus mens rea</i> ) .....	962
1. Intent .....	962
2. Mistakes .....	962
a) Mistake of fact .....	962
b) Mistake in law .....	963
IV. Attempts .....	963
V. Prosecution .....	963
1. Request: (particular) public interest .....	963

2. Time limit for filing requests .....	964
3. Limitation period .....	964
4. Private prosecution .....	965
5. Public prosecution .....	965
VI. Consequences .....	965
1. Deprivation .....	965
2. Forfeiture of the proceeds of an act .....	966
3. The legal rights of the aggrieved party .....	966
4. Summary proceedings .....	966
5. Recovery procedures .....	966
6. Publication of the judgment .....	967
B. Border seizure proceedings .....	967
I. Border seizure procedures: section 142 a PatG .....	967
1. Primacy of community law .....	967
2. Purpose of the provision .....	968
3. Substantive requirements giving rise to national seizure procedures .....	969
a) Patent-infringing products .....	969
b) Import/export .....	969
4. Formal conditions for seizure .....	970
a) Request .....	970
b) Applicant .....	970
c) Duration of the request .....	971
d) Posting of a security .....	971
5. Procedure following a seizure of goods by the customs authorities .....	971
a) Notification and time limit .....	971
b) Absence of timely objection .....	972
c) Timely objection .....	972
6. Risk of damage claims .....	972
7. Right of appeal .....	974
II. Seizure under EU law EC Regulation No. 1383/2003 .....	974
1. Primacy of community law .....	974
2. Scope of application .....	974
3. General/Purpose of the provisions .....	976
4. Substantive requirements giving rise to seizure procedures .....	977
a) Patent-infringing products .....	977
b) Simple suspicion .....	977
c) The external borders of the EU: Import/export .....	978
5. Formal conditions for seizure .....	979
a) Without a request .....	979
b) Lodging and processing of applications “for action by the customs authorities” .....	979
c) Applicant .....	980
d) Content/form .....	980
c) Duration of the application .....	980
f) Declaration of assumption of liability .....	980
g) Competence .....	980
6. Procedure .....	980
a) Notification of the customs department by the Federal Finance Directorate, Art. 8 para. 2 Regulation 1383/2003 .....	980
b) Discovery of infringing goods, Art. 9 para. 1 Regulation 1383/2003 .....	980
c) Notification, Art. 9 para. 2 Regulation 1383/2003 .....	981
d) Declaratory procedure, Art. 10 Regulation 1383/2003 .....	981
e) Simplified destruction procedure Art. 11 Regulation 1383/2003/§ 142 b PatG .....	981
7. Risk of damage claims .....	982
8. Legal remedy and defence measures .....	983
C. Allegation of entitlement and misleading advertising .....	983
I. General .....	983

1. Allegation of entitlement to a patent .....	983
2. Further assessment criteria based on general competition rules .....	984
II. The right to information resulting from an allegation of entitlement to a patent, section 146 PatG .....	984
1. Essential conditions governing the exercise of the right to information .....	984
a) Allegation of entitlement to a patent .....	984
b) Public statements .....	985
c) The right to sue .....	986
d) The right to be sued .....	986
e) Requests for information .....	986
2. The legal consequences of exercising a right to information .....	986
a) Scope of the duty to inform .....	986
b) Legal obligations .....	987
c) Information procedure .....	987
III. Intellectual property rights in advertising .....	987
1. Application of general competition rules .....	987
2. No specific labelling requirements under patent law .....	988
3. Existence of patent protection .....	988
4. Material scope of protection .....	990
5. Utility models .....	990
6. Validity of intellectual property rights .....	990
7. Sphere of personal responsibility .....	991
8. Civil proceedings .....	991
D. Claims arising from unjustified warnings of property right infringement .....	991
I. Differentiation .....	991
1. Letter of notice .....	991
2. Warning (reprimand) .....	992
3. Warnings issued to manufacturers and their customers .....	992
II. Intrusion into an established and operating business .....	993
1. Unlawful warning letters .....	993
2. Unlawfulness .....	994
3. Fault – minor negligence .....	995
4. Legal consequences .....	996
a) Injunction .....	996
b) Removal, information .....	996
III. Warnings used as an unlawful business practice .....	997
<b>§ 13. The law of utility models</b>	
A. General .....	1001
I. The importance of the law of utility models .....	1001
II. Historical development of the law of utility models .....	1002
III. Development of European law .....	1003
IV. Legal bases .....	1004
B. Protection: Subject-matter and prerequisites .....	1004
I. The technical invention .....	1004
II. Novelty .....	1005
III. Inventive step .....	1008
IV. Commercial applicability .....	1009
V. Exceptions from utility model protectability .....	1009
C. Inventor's rights and invention ownership .....	1011
D. Formation and expiration of the utility model .....	1012
I. Application and registration .....	1012
1. General prerequisites .....	1012
2. Form and contents of the application .....	1012
3. Claiming a senior right .....	1013
4. Withdrawal of the application .....	1015
5. Limited scope of review .....	1015

6. Registration .....	1016
7. Branch-off registration .....	1016
8. International utility model applications .....	1017
II. Term of protection and expiration of the utility model .....	1017
III. The cancellation of the utility model .....	1018
1. Cancellation claim .....	1018
2. Cancellation application .....	1020
3. Cancellation proceedings .....	1020
4. Relationship between cancellation proceeding and infringement litigation .....	1021
IV. Appeal proceedings .....	1022
V. Costs of representation in cancellation and appeals proceedings .....	1023
E. Content and scope of protection of the utility model .....	1023
I. Effects of a utility model registration .....	1023
II. Limitations of the utility model .....	1023
III. Scope of protection .....	1024
IV. Objections in infringement actions .....	1025
1. Objection of liability to cancellation .....	1025
2. Free state of the art (“Formstein Objection”) .....	1026
3. Objection of illicit extraction .....	1026
4. Further objections .....	1026
F. Utility models in business transactions .....	1026
G. Consequences of the utility model infringement under civil law .....	1027
I. Damage compensation claim .....	1027
II. Deletion claim .....	1027
III. Presentation and inspection claim .....	1028
IV. Judgment publication claim .....	1028
H. Consequences of the utility model infringement under criminal law .....	1028
I. Utility model infringement action .....	1029
I. Pre-trial measures: Gathering evidence and warning .....	1029
II. Preliminary injunction .....	1029
1. Substantial likelihood of success on the merits of the case .....	1029
2. Substantial threat of irreparable damage or injury .....	1030
III. General preconditions for decisions on the merits .....	1031
IV. The Judgment and its validity .....	1031
V. Determination of the disputed amount and costs of the utility model action .....	1031
VI. Restitution action (sec. 578 et seq. ZPO) and action to oppose enforcement (§ 767 ZPO) .....	1032
VII. Seizure by the customs agency .....	1032
VIII. Utility models in execution .....	1032
J. Unjustly claiming a utility model .....	1033

#### § 14. The supplementary protection certificate

A. General, purpose, history and legal character of the certificate .....	1037
I. Overview .....	1037
1. Temporal relevance of the supplementary protection certificate .....	1037
2. Economic relevance of the supplementary protection certificate .....	1038
3. Scope of application .....	1039
II. Relationship between grant of the patent and authorisation under pharmaceutical law .....	1039
1. Overview of the drug authorisation procedures .....	1040
2. Differentiation between preparatory actions and actual authorisation procedure .....	1041
3. The early patent application .....	1042
4. The factual reduction of the patent duration and its ‘countermeasures’ .....	1042
5. Conceivable alternatives to the supplementary protection certificate .....	1044
III. History .....	1044
IV. Legal character .....	1045

B. Substantive granting prerequisites .....	1046
I. General .....	1046
II. Product .....	1046
III. Basic patent .....	1048
1. Discrepancy between basic patent and authorisation .....	1049
2. Multiple basic patents and patent holders .....	1050
IV. First marketing authorisation .....	1051
1. Senior and extraterritorial authorisations .....	1052
2. Interim extension in case of ex-post authorisation .....	1053
V. No earlier certificate .....	1054
C. Calculation of term .....	1055
I. General .....	1055
II. Relevant date for the calculation of term .....	1056
1. Grant of the basic patent .....	1056
2. Lodging the basic patent application .....	1057
1. Grant of the first marketing authorisation .....	1058
III. Discrepancy between delay and term .....	1058
IV. Negative terms .....	1059
D. Subject matter and scope of protection .....	1060
I. General .....	1060
II. Specific problems of the scope of protection .....	1061
1. Salt problem .....	1061
2. Indication patents .....	1063
3. Substance combinations .....	1065
a) Formulation patents – active ingredient and adjuvant .....	1065
b) Substance combinations .....	1066
E. Rights, limitations and obligations .....	1070
I. Rights of the certificate holder .....	1071
1. Rights of use and exclusivity .....	1071
2. Licenses .....	1071
3. Right to the SPC (Art. 6 RegSPC) .....	1073
II. Limitations and obligations .....	1074
F. Grant procedure .....	1075
I. General .....	1075
II. Application .....	1075
1. General application requirements .....	1076
2. Form and content of the application .....	1076
3. Application deadline .....	1078
4. Application regarding the term extension of an SPC .....	1080
5. Application fees .....	1081
6. Publication of an application notice .....	1081
III. Grant and announcement .....	1082
IV. Fees to maintain the SPC .....	1084
G. Expiry, invalidity and revocation .....	1084
I. Reasons for expiry pursuant to Art. 14 RegSPC .....	1084
II. Reasons for invalidity pursuant to Art. 15 RegSPC .....	1086
III. Revocation of a term extension .....	1087
IV. Announcement .....	1087
H. Remedies .....	1088
Index .....	1089

