

## Germany

### Administrative procedure

#### Opposition

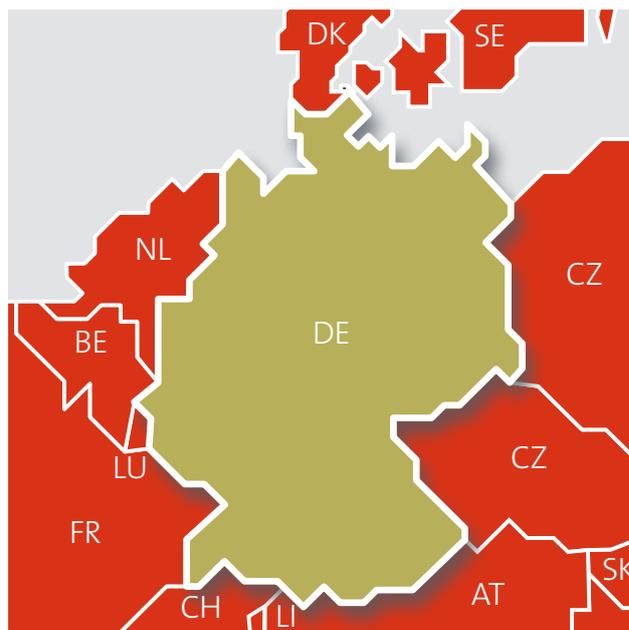
Any person may file notice of opposition within nine months of the date of publication of the grant (Section 59(1) 1 PatG) (no *restitutio in integrum* in case of failure to observe the nine-month time limit (Section 123(1) 2 No. 1 PatG)).

Opposition may be based only on the allegation that one of the grounds for revocation under Section 21 PatG exists (Section 59(1) PatG). Grounds of unlawful deprivation (Section 21(1) No. 3 PatG) may be invoked only by the injured party (Section 59(1) 1 PatG). The facts which justify the opposition must be stated in detail (Section 59(1) 2, 3 and 4 PatG).

If a patent infringement action for has been filed, the defendant may intervene in pending opposition proceedings relating to the patent in suit. Upon expiry of the period for opposition the defendant must declare its intention to intervene within three months of the filing of the infringement action. The same applies to a third party who has started proceedings for a ruling for a declaration of non-infringement upon the patent proprietor's request to cease alleged infringement of the patent (Section 59(2) PatG).

Patent Divisions (three members: at least two technical members, one additional legal member in case of particular legal difficulty; Section 27(3) PatG) at the German Patent and Trade Mark Office (hereinafter the "Patent Office") have competence for opposition proceedings (Sections 27(1) No. 2, 61 PatG). Under certain conditions the Federal Patent Court (Appeal Chamber (Beschwerdesenat) – three technical members and one legal member, Section 67(1) No. 2 PatG) may decide on the opposition (Section 61(2) PatG).

If the opposition is withdrawn, the proceedings are continued (Section 61(1) 2 PatG).



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#### Appeal

An appeal may be filed against the decisions of the Examining Sections and Patent Divisions (Sections 73(1), 27 PatG). One of the requirements is that the appealed decision does not, or does not fully comply with the appellant's request. The appeal must be filed with the Patent Office within one month after service of a decision (Section 73(2) PatG). A statement of grounds for the appeal is not compulsory. If there are no other parties to the appeal proceedings and if the authority whose decision is contested finds the appeal justified, the authority will rectify its decision (Section 73(3) 1 and 2, (4) PatG). Otherwise it will transfer the appeal to the Federal Patent Court (FPC)<sup>1</sup> for decision without comment as to its merits within one month (Section 73(3) 3 PatG).

Further appeal against decisions of the Federal Patent Court (restricted to legal questions) may be made to the German Federal Court of Justice (hereinafter the "FCJ") within one month of the appeal decision if the Federal Patent Court decision specifically grants leave to appeal (mandatory leave – Section 100(1), (2) PatG) or if no grant of leave is required on account of certain procedural deficiencies (such as denial of the right to be heard) (Section 100(3) PatG).

<sup>1</sup> The Federal Patent Court is an autonomous and independent federal court. It is *inter alia* competent for appeals from decisions of the Patent Office's Examining Sections or Patent Divisions (Section 65(1) 2 PatG). The decisions of the Federal Patent Court on appeals are handed down by the Appeal Chamber (Sections 66(1) No.1, 67(1) PatG).

## Revocation

Under German law, revocation proceedings are strictly separate from infringement proceedings (bifurcation system).

A German patent may be revoked or maintained during opposition proceedings by a Patent Division of the Patent Office (Section 61 PatG, see also “Opposition” above). The patent may be revoked or upheld with its originally granted claims or with amended claims (Section 61(1) PatG). Amendment of the claims, with the consent of the patent owner, in opposition proceedings is possible, but the amended claims may not be subject to grounds for revocation under Section 21 PatG.

A German patent or the German part of a European patent may also be revoked or limited by the Patent Division upon request of the patent owner without time limit (Section 64 PatG). Limitation of the claims is possible subject to certain requirements (Sections 44, 64(2) PatG).

Statistics on the outcome of opposition proceedings with the Patent Office are published annually in the *Blatt für Patent-, Muster- und Zeichenwesen*.

A German patent or the German part of a European patent may be declared invalid by the German Federal Patent Court in response to a nullity action (Section 81 PatG).

Anyone may bring a nullity action (grounds of unlawful deprivation may be invoked only by the injured party (Section 81(3) PatG)). An action against a German patent may be based on the allegation that one or more of the grounds for revocation listed in Section 21(1) PatG apply or that the scope of the patent has been broadened (Section 22 PatG). An action against the German part of a European patent may be based on one or more of the grounds for revocation listed in Article II Section 6 IntPatÜbkG, which are the same as those in Sections 21(1) and 22 PatG, apart from the ground of unlawful deprivation, which is almost the same.

There is no time limit for a nullity action; but a revocation action against a patent may not be filed as long as opposition proceedings may be initiated or are still pending (Section 81(2) PatG). However, after expiry of a patent a nullity action is admissible only if the claimant has a legal interest in a court declaration that the patent is nullified (with retroactive effect), which is generally recognised when the claimant is accused of having infringed the patent, e.g. by the patent proprietor in a pending infringement action.

The defendant has to object to the nullity action within one month after service of the action (Section 82(1) PatG). If no objection is filed in time, the Federal Patent Court may decide without a hearing, assuming that the facts put forward by the claimant are true (Section 82(2) PatG). The defendant may defend the patent as granted but also in his main request or one or more auxiliary requests in an amended set of claims.

At first instance, the proceedings are handled by a Revocation Chamber (*Nichtigkeitssenat*) – Sections 66(1) No. 2 PatG) of the Federal Patent Court, generally consisting of two legal and three technical members (Section 67(2) PatG).

After submission of the statement of defence the court refers in a written communication to issues that are likely to be of particular importance for deciding the case. It may set a time limit for the parties to comment, e.g. by revising their requests or supplementing their allegations. Failure to observe the time limit may make it inadmissible to defend the patent in an amended set of claims or to submit new documents or facts.

The hearing is held before the panel and under the control of the presiding judge. At the beginning the presiding judge or the reporting judge states the essential content of the file, followed by a hearing of the party’s pleadings and, possibly, a taking of evidence, e.g. the hearing of witnesses, rarely of experts since three out of the five judges on the panel are technically qualified in the patent’s field of technology. Most of the time, the final decision is given at the end of the hearing, while the reasons are given at a later point in time.

Decisions regarding the revocation of the patent have retroactive effect (*ex tunc*).

Appeal may be made to the FCJ within one month of delivery (i.e. service) of the full judgment (Section 110(3) PatG) for a review of legal and factual aspects (Section 111 PatG). Under the revised law enacted on 1 September 2009 and applicable to all nullity actions instituted from then on, the review is restricted to legal aspects. New facts can be introduced into the proceedings only if certain conditions are met [e.g. no negligently late presentation of the new facts] (Sections 111(1), 117 PatG). Cross-appeal is admissible. A panel of five legally qualified judges (Section 139 GVG) will decide on the appeal after a hearing (Section 118). The decision can be rejection of the appeal or full or partial reversal of the judgment or remittal of the case to the Federal Patent Court or a decision to take evidence and, after another hearing, rejection of the appeal or full or partial reversal of the judgment (Section 119 PatG).

## Civil procedure

### Infringement

Infringement claims of a German patent or the German part of a European Patent are subject to civil law (Sections 139-141 PatG). Criminal sanctions are available (criminal action on complaint of the aggrieved party, except in cases of public interest, where prosecution is *ex officio* (Section 142 PatG)).

The competent court for all claims based on infringement of a patent under German law is the District Court (LG, *Zivilkammern der Landgerichte* – Section 143(1) PatG) without regard to the value in dispute. Due to federal regulations, specific District Courts are wholly or partially competent for deciding all patent actions (*Patentstreitsachen*) in a particular federal state (*Bundesland* – Section 143(2) PatG)<sup>2</sup>. Parties are required to bring forward all facts and available evidence or offer of evidence in written statements within time limits set by the court. Panels of three legally qualified judges (Section 75 GVG) decide on the infringement action after a hearing.

The standard limitation period for actions for patent infringement is three years (Section 141 PatG, Section 195 BGB), which commences at the end of the year in which the claim arises and the claimant obtains knowledge of the infringement and of the identity of the infringer or would have obtained such knowledge if he had not shown gross negligence (Section 141 PatG, Sections 195, 199(1) BGB). Irrespective of such knowledge, claims become statute-barred ten years after they arise or thirty years from the date of the infringement (Section 141 PatG, Sections 195, 199(3), (4) BGB).

### Nullity/counterclaim for revocation

Under German patent law, only the Federal Patent Court may declare a German patent or the German part of a European patent invalid (the so-called bifurcation system; see “Revocation” above).

The invalidity of a patent may not be put forward as a defence or counterclaim defence in infringement proceedings, since civil courts are bound by the patent as an administrative act issued by the Patent Office which can only be revoked in opposition proceedings or declared invalid in nullity proceedings.

Infringement proceedings may, however, be stayed if opposition or nullity proceedings are pending and the District Court is of the view that there is a high likelihood that the patent claims relevant for the infringement will be revoked or held invalid (Section 148 ZPO).

### Remedies

Remedies available for patent infringement in a trial on the merits are permanent injunctive relief (Section 139(1) PatG), claim for information and rendering account on profits due to the infringement (Section 140b PatG, Sections 242, 259 BGB), claim for recall, removal and destruction of the infringing product (Section 140a PatG), claim for damages (Section 139(2) PatG), and publication of the decision (Section 140e PatG).

A claim on the extent of award of damages (Section 139(2) PatG) can be put forward in separate proceedings after the court has found that the defendant is liable for damages on the merits due to patent infringement and the case is not settled out of court.

Claim for reasonable compensation of the applicant from the date of publication of the application is available for intentional or negligent use of the subject-matter of the application (subject to further requirements) (Section 33 PatG, Article II Section 1 IntPatÜbkG).

### Other actions

Declaration of non-infringement is available in civil proceedings (Section 256 ZPO).

Preliminary injunctions or preliminary seizure may be ordered in preliminary proceedings (Section 140a PatG, Sections 935, 940 ZPO).

An order for inspection of the allegedly infringing product or process (Section 140c PatG) is also available before or during proceedings on the merits.

Border seizure measures may be available under the requirements of national law (Section 142a PatG) and/or European regulations.

<sup>2</sup> LG Mannheim (Baden-Wuerttemberg); LG Munich I and LG Nuremberg-Fürth (Bavaria); LG Berlin (Berlin, Brandenburg), LG Hamburg (Bremen, Hamburg, Mecklenburg-Western Pomerania, Schleswig-Holstein), LG Düsseldorf (North Rhine-Westphalia); LG Frankfurt (Main) (Hessen, Rhineland-Palatinate); LG Braunschweig (Lower Saxony); LG Leipzig (Saxony); LG Magdeburg (Saxony-Anhalt); LG Erfurt (Thuringia); LG Saarbrücken (Saarland).

## Appeal

The Higher District Court (“*Oberlandesgericht*” – OLG) has jurisdiction on appeals from decisions of the District Court.

Legal review of a decision on appeals of the Higher District Court is available by the Federal Court of Justice (FCJ) (Section 542 ZPO), only if leave to seek review is granted by the Higher District Court or if on appeal the decision of the Higher District Court not to grant leave is set aside by the FCJ (Sections 543-545 ZPO). Grounds for granting leave are that the case gives rise to a legal issue of general importance or that the development of law or the safeguarding of unitary case law requires a decision from the FCJ. Violations of the right to be heard are also a ground for granting leave.

## Parallel proceedings

See “Nullity/counterclaim for revocation” above.

## Arbitration/mediation

Alternative dispute resolution including means of mediation may be available in civil proceedings such as patent infringement proceedings (see e.g. Sections 278, 278a ZPO). Arbitration (*Schiedsverfahren*) may be possible in civil proceedings. German law contains certain provisions for arbitration in Sections 1025 et seqq. ZPO.

## Enforcement

Enforcement of the decisions of civil courts is subject to Sections 704 et seqq. ZPO, the provisions of German civil procedural law. A decision on the merits is enforceable when it is final.

A district court decision on the merits is provisionally enforceable when the decision has been serviced upon the defendant, a court certificate of enforceability (*Vollstreckungsklausel*) has been issued and security, as determined by the court, has been posted. The appeal court may upon request of the defendant, in exceptional cases suspend the enforceability of the decision if it has been appealed.

A court of appeal decision is also provisionally enforceable. For preliminary injunctions see also Sections 936, 929 ZPO.

The party that has enforced a provisionally enforceable decision is liable for damages if the decision is subsequently reversed (Section 717(2) ZPO). If the subsequently reversed

decision is a decision from a court of appeal, the liability of the party that enforced the decision is limited to the extent of unjustified enrichment (Section 717(3) ZPO).

Non-compliance with the orders in the court decision may, upon request of the other party, be subject to a penalty or imprisonment (non-compliance with an injunction, Section 890 ZPO) or a coercive measure (non-compliance with an order to give information and render account, Section 888 ZPO). Award of damages is enforced in the same way as a decision for payment in general.

## Compulsory licence

A non-exclusive compulsory licence may be granted by the Federal Patent Court at the request of a party (subject to further conditions – Sections 24, 81 et seqq. PatG).

The decision may be appealed to the FCJ within one month (Section 110 PatG).

## Relevant national law

Patent Act as promulgated by announcement of 16 December 1980 (Federal Gazette 1981 I p.1), last amended by Article 4 of the Law of 8 October 2017 (Federal Gazette I p. 3546) [cited as: PatG];

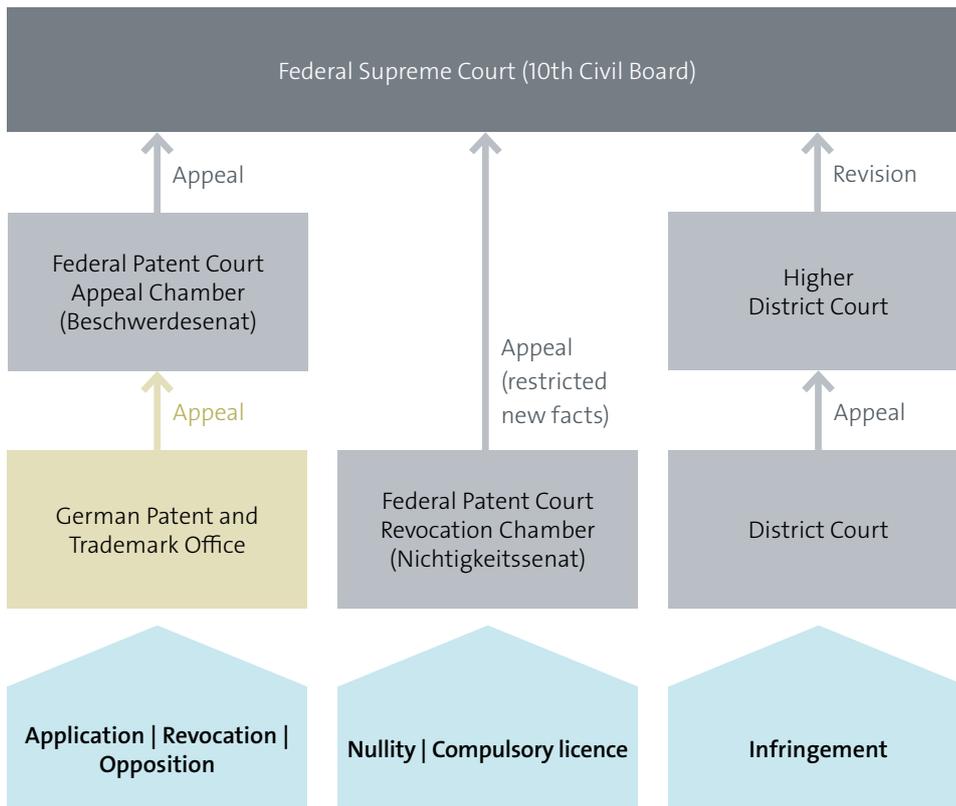
Act on International Patent Treaties of 21 June 1976 (Federal Gazette II p. 649), last amended by Article 3 of the Law of 17 July 2017 (Federal Gazette I p. 2541) [cited as: IntPatÜbkG];

German Civil Code as promulgated by announcement of 2 January 2002 (Federal Gazette I p. 42, 2909; 2003, p. 738), last amended by Article 7 of the Law of 31 January 2019 (Federal Gazette I p. 54) [cited as: BGB];

German Code of Civil Procedure as promulgated by announcement of 5 December 2005 (Federal Gazette I p. 3202; 2006 I p. 431; 2007 I p. 1781), last amended by Article 1 of the Law of 31 January 2019 (Federal Gazette I p. 54) [cited as: ZPO];

German Courts Constitution Act as promulgated by announcement of 9 May 1975 (Federal Gazette I p. 1077) last amended by Article 2 of the Law of 14 April 2019 (Federal Gazette I p. 466) [cited as: GVGG].

## Competent authorities or courts



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