

# Patents 2021

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# Patents

## 2021

**Contributing editors****Louis E Fogel and Shaun M Van Horn****Jenner & Block LLP**

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Lexology Getting The Deal Through is delighted to publish the eighteenth edition of *Patents*, which is available in print and online at [www.lexology.com/gtdt](http://www.lexology.com/gtdt).

Lexology Getting The Deal Through provides international expert analysis in key areas of law, practice and regulation for corporate counsel, cross-border legal practitioners, and company directors and officers.

Throughout this edition, and following the unique Lexology Getting The Deal Through format, the same key questions are answered by leading practitioners in each of the jurisdictions featured. Our coverage this year includes new chapters on Israel, Singapore, Turkey and the United Kingdom.

Lexology Getting The Deal Through titles are published annually in print. Please ensure you are referring to the latest edition or to the online version at [www.lexology.com/gtdt](http://www.lexology.com/gtdt).

Every effort has been made to cover all matters of concern to readers. However, specific legal advice should always be sought from experienced local advisers.

Lexology Getting The Deal Through gratefully acknowledges the efforts of all the contributors to this volume, who were chosen for their recognised expertise. We also extend special thanks to the contributing editors, Louis E Fogel and Shaun M Van Horn of Jenner & Block LLP, for their continued assistance with this volume.



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## PATENT ENFORCEMENT PROCEEDINGS

### Lawsuits and courts

- 1 | What legal or administrative proceedings are available for enforcing patent rights against an infringer? Are there specialised courts in which a patent infringement lawsuit can or must be brought?

In Germany, patent rights can be enforced in legal proceedings before the district courts, either by way of preliminary injunction proceedings or a main proceeding on the merits. In order to ensure that there is a group of judges with a frequent workload of patent cases and thus adequate competence, patent infringement matters are concentrated by law to specific patent chambers of 12 district courts: Munich I, Nuremberg, Mannheim, Frankfurt, Saarbrücken, Erfurt, Leipzig, Magdeburg, Düsseldorf, Braunschweig, Berlin and Hamburg.

In general, each federal state has at least one patent infringement court; however, some federal states share courts.

The most prominent – and busy – courts are Düsseldorf, Mannheim, Munich I and Hamburg.

### Trial format and timing

- 2 | What is the format of a patent infringement trial?

German patent infringement trials are front-loaded. The proceedings on the merits commence therefore with the filing of a statement of complaint with the court. The statement of complaint contains the requests and a detailed account of the infringement. The statement of complaint is then formally served on the defendant, usually with a summons to an early oral hearing, which may also be a case management conference in which only the deadline regime is set and the motions are made. Some courts use this hearing to try to negotiate a settlement between the parties.

Before the main oral hearing, each party usually files two briefs:

- the plaintiff – a statement of complaint and a rejoinder; and
- the defendant – a statement of reply and a counter rejoinder.

Owing to this detailed preparation, cases are often tried in one main oral hearing before the first-instance decision is rendered.

The disputed issues are decided by (non-technical) judges (one presiding judge and two assessors).

Documents, affidavits and live testimony are used as evidence to prove or rebut the infringement. Further, expert witnesses are an important means of evidence. However, if the court deems that an expert witness opinion is necessary to hand down a judgment, it will appoint its own expert witness. Such expert witnesses are the most common means of providing evidence in patent infringement cases. Expert witnesses appointed or submitted by the parties have less importance. The court will carefully consider the expert opinion rendered by its appointed expert witness. However, it is not bound by this opinion and may deviate from it.

Depending on the court, it takes approximately seven to 15 months from the service of the statement of complaint on the defendant until a first-instance decision is handed down by the court.

### Proof requirements

- 3 | What are the burdens of proof for establishing infringement, invalidity and unenforceability of a patent?

In general, each party must set out and prove the actual features of the legal rule favourable to the respective party. The plaintiff must prove the conditions on which its claims are based. The alleged infringer must prove the facts that deny the claims. The specific distribution and extent of the burden of proof in the course of the proceedings depends on the submissions in the specific case. The more detailed the submission; the more detailed must be the response.

This means that it is first the plaintiff's duty to substantiate all facts relevant to the decision (such as the right to sue, infringement acts and the features of the patent claim) and all facts should be presented precisely and, if possible, with indication of the source of knowledge.

It is then the responsibility of the defendant to respond to this submission conclusively and, in the case of dispute, to provide proof for his or her allegations. This includes also any defence he or she may rely on (eg, invalidity of the patent).

Only if specific facts submitted by one party are substantially disputed by the other party, does the burden of proof rest on the party submitting these facts to provide sufficient proof for their assertions, either by way of documents, witnesses or experts.

### Standing to sue

- 4 | Who may sue for patent infringement? Under what conditions can an accused infringer bring a lawsuit to obtain a judicial ruling or declaration on the accusation?

The patent owner and a licensee (exclusive and non-exclusive) may sue for patent infringement. With respect to the latter, the extent of the right to sue and the respective remedies obviously depend on the scope of the licence.

An accused infringer may bring an action for declaratory of non-infringement.

### Inducement, and contributory and multiple party infringement

- 5 | To what extent can someone be liable for inducing or contributing to patent infringement? Can multiple parties be jointly liable for infringement if each practises only some of the elements of a patent claim, but together they practise all the elements?

Someone can be liable to contributing to an infringement under the conditions of section 10 of the German Patent Act:

*The patent shall further have the effect that any third party shall be prohibited, in the absence of the consent of the proprietor of the patent, from supplying or offering to supply, within the territorial scope of this Act, persons other than those entitled to exploit the patented invention with means relating to an essential element of the invention for use within the territorial scope of this Act if the third party knows or if it is obvious from the circumstances that those means are suitable and intended for using that invention.*

It is, therefore, in particular necessary that the alleged infringer provides means relating to an essential element of the invention. A means refers to an element of the invention if it is capable of interacting functionally with it in the realisation of the protected inventive idea. This is, for example, the case by offering and delivering a device element that can be combined with other elements to form the patented overall combination.

In general, multiple parties will be jointly liable.

### Joinder of multiple defendants

**6** | Can multiple parties be joined as defendants in the same lawsuit? If so, what are the requirements? Must all of the defendants be accused of infringing all of the same patents?

Yes, multiple parties can be joined as defendants in the same lawsuit. The parties must be accused of infringing the same patent and the same infringing embodiment or methods.

### Infringement by foreign activities

**7** | To what extent can activities that take place outside the jurisdiction support a charge of patent infringement?

According to the case law of the Federal Court of Justice (BGH), a person who enables a third party to use the protected object through his or her own conduct in breach of duty is also liable for a patent infringement (see BGH case ref. X ZR 120/15). These principles also apply to foreign activities contributing to a patent infringement committed in Germany. For example, where a person, in applying a procedure, takes advantage of the fact that certain steps of the protected procedure are carried out by a third party (abroad), that third party may also be liable for patent infringement; and a foreign person (company), who supplies products to a foreign customer is involved in an act of domestic use if it knows that the customer will supply the products to Germany (BGH, case ref. X ZR 69/13 – *Audiosignalcodierung*).

### Infringement by equivalents

**8** | To what extent can 'equivalents' of the claimed subject matter be shown to infringe?

German patent law applies the doctrine of equivalents. The requirements are as follows:

- the accused product must solve the problem of the invention with objectively equal means;
- the skilled person must be able – based on his or her specialist knowledge – to find the technical solution of the altered version of the accused product as objectively equal; and
- the skilled person must determine that the altered accused product is equivalent to the objective (literal) solution of the patent.

### Discovery of evidence

**9** | What mechanisms are available for obtaining evidence from an opponent, from third parties or from outside the country for proving infringement, damages or invalidity?

The concept of discovery is unknown in German procedural rules.

However, in order to obtain evidence, the initiation of inspection proceedings pursuant to section 140(c) of the Patent Act is available. The inspection can also be enforced with a preliminary injunction. The requirements for obtaining a preliminary injunction for an inspection are low. It is sufficient merely to demonstrate a probability of patent infringement.

### Litigation timetable

**10** | What is the typical timetable for a patent infringement lawsuit in the trial and appellate courts?

The litigation timetable depends very much on the concrete venue.

Depending on the court, it takes approximately seven to 15 months from the service of the statement of complaint on the defendant until a first-instance decision is handed down by the court. Where evidence is taken, the procedure may take an additional six to 12 months.

As the court sets a strict deadline regime, there is little scope for expediting the process.

The appeal stage (Higher District Court) will typically take another eight to 12 months.

### Litigation costs

**11** | What is the typical range of costs of a patent infringement lawsuit before trial, during trial and for an appeal? Are contingency fees permitted?

This depends on the disputed value of the court costs. In general, the total cost of an average case should be calculated at a minimum of €70,000 to €100,000; the costs for an appeal can be assumed to be a little lower. However, the total costs depend very much on the complexity of the case, the number of parties and the number of IP rights to be asserted.

Contingency fees are (currently) not permitted.

### Court appeals

**12** | What avenues of appeal are available following an adverse decision in a patent infringement lawsuit? Is new evidence allowed at the appellate stage?

An adverse (or partly adverse) decision on the merits before the District Court can be appealed to the Higher District Court, which will be a full legal review of the case. Therefore, generally, the appeals court has to base their review upon the facts and evidence determined by the first instance court. However, under very narrow circumstance new facts or evidence is allowed:

- if there are doubts in relation to correctness and completeness of the facts determined by the first instance court based upon concrete indications; and
- if explicitly allowed by law, in particular by section 531 sec. II of German code of civil procedure, if:
  - the court has apparently overlooked one aspect or inaccurately determined it as not relevant;
  - the new facts were not considered due to a procedural error; and
  - the delayed submission of the new fact is not due to negligence.

## Competition considerations

13 | To what extent can enforcement of a patent expose the patent owner to liability for a competition violation, unfair competition, or a business-related tort?

According to established case law of the Federal Court of Justice, an unjustified warning based upon an industrial property right may infringe the right of the alleged infringer to the established and practised business (business-related tort).

Enforcing a standard essential patent only towards specific infringers may under circumstances be relevant under competition law.

## Alternative dispute resolution

14 | To what extent are alternative dispute resolution techniques available to resolve patent disputes?

Some of the patent infringement courts particularly foresee mediation processes for suitable cases; the Munich court, for example, proposes an internal court mediation to use the time between the dates of the oral hearings to achieve an amicable, appropriate and interest-based solution. The preliminary view of the case given by the chamber in the early first appointment often gives the parties reason to try mediation.

Besides that, it is possible to resolve patent matters by out-of-court mediation or arbitration proceedings.

## SCOPE AND OWNERSHIP OF PATENTS

### Types of protectable inventions

15 | Can a patent be obtained to cover any type of invention, including software, business methods and medical procedures?

### General limits on patentability

According to section 1 of the Patent Act, the following are not regarded as inventions:

- discoveries, scientific theories and mathematical methods;
- aesthetic creations;
- schemes, rules, methods for performing mental acts, playing games or doing business and computer programs; and
- presentations of information.

However, this applies only where protection is sought for the subject matter or activities referred to as such.

### Software

Under section 1(3) of the Patent Act, 'programs for computers' will not be regarded as inventions. However, this applies only to the extent that protection is sought for the subject matter as such.

Another restriction on software is the requirement under section 1(1) of the Patent Act that patents are granted to inventions or fields of technology, excluding any subject matter considered to be non-technological.

In practice, it is seldom difficult to establish novelty. However, when considering the inventive step, non-technical or software features are not usually considered.

### Business methods

Under section 1(3) of the Patent Act, 'methods for doing business' will not be regarded as inventions. However, this applies only to the extent that protection is sought for the subject matter as such.

Another restriction on business methods is the requirement under section 1(1) of the Patent Act that patents are granted to inventions or fields of technology, excluding any subject matter considered to be non-technological.

Again, in practice, it is seldom difficult to establish novelty. However, when considering the inventive step, non-technical or business method features are not usually considered.

### Stem cells

The patenting of stem cells is not prohibited; however, it is only possible if the stem cells can be obtained without the destruction of human embryos.

### Other restrictions

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

In addition, patents will not be granted for inventions that concern:

- processes for cloning humans;
- processes for modifying the germ line genetic identity of humans;
- the use of human embryos for industrial or commercial purposes; or
- processes for modifying the genetic identities of animals which are likely to cause them suffering without any substantial medical benefit to humans, animal or animals resulting from such processes.

Finally, patents will not be granted in respect of:

- any plant or animal varieties;
- essentially biological processes for the production of plants or animals;
- methods for the treatment of human or animal bodies by surgery or therapy; or
- diagnostic methods practised on human or animal bodies.

The latter provision does not apply to products, in particular substances or compositions, used in any of these methods.

However, patents can be granted for inventions that concern:

- plants or animals if the technical feasibility of the invention is not confined to a particular plant or animal variety; and
- microbiological or other technical processes, or a product obtained by means of such a process, other than a plant or animal variety.

The Patent Act defines the following terms:

- 'Biological material' – any material containing genetic information and capable of reproducing itself or being reproduced in a biological system.
- 'Microbiological process' – any process involving, performed on or resulting in microbiological material.
- 'Essentially biological process' – a process for the production of plants or animals consisting entirely of natural phenomena (eg, crossing or selection).
- 'Plant variety' – a variety as defined under the EU Community Plant Variety Rights Regulation (2100/94), as amended.

### Patent ownership

16 | Who owns the patent on an invention made by a company employee, an independent contractor, multiple inventors or a joint venture? How is patent ownership officially recorded and transferred?

### General

The owner of the patent is the original applicant or his or her successor in title. However, the right to a patent belongs to the inventor or his or her successor in title (section 6, Patent Act). If the inventor differs from the owner, the inventor may lodge a claim for assignment of the patent to him (section 8, Patent Act). If this is (eg, after a court's decision) successful, the inventor becomes the new owner.

### Company employees

The German Employee Inventions Act (GEIA) distinguishes between 'service inventions' and 'free inventions' (section 4, GEIA). Service inventions result from the obligatory duties of the employee, or are decisively based on know-how or resources of the employer. All other inventions are free inventions that are at the free disposal of the employee, with the only exception that the employee must offer to the employer a non-exclusive licence under reasonable conditions if the invention falls within the range of the employer's actual or planned activities.

The right to service inventions transfers 'automatically' to the employer if:

- the employer communicates an explicit claim in writing to the employee before the end of a four-month period from the employee's invention report; or
- the employer remains silent within the four-month period (this is understood as an implicit claim to the invention).

The employer may also actively release the claim to the invention within the four-month period. If not, the employer becomes automatically the owner of the invention with a bundle of (potentially costly) duties such as the duty to file a patent application.

### Independent contractors

The right to the patent is freely negotiable, either before the invention is made or afterwards. Care must be taken not only as to whether any explicit agreement in the contract may have the consequence of a transferal of the right to the patent but that also whether the circumstances and the 'nature' of the contract (and the invention made) may have the consequence that a German court would assume an implicit assignment.

### Multiple inventors or joint ventures

If two or more persons have jointly made an invention, the right to the patent shall belong to them jointly. If two or more persons have made the invention independently of each other, the right shall belong to the person who is the first to file the application in respect of the invention with the German Patent and Trade Mark Office (section 6, German Patent Act). For joint ventures, the same applies in principle, subject to any potentially differing contractual agreement.

### Recording and transferring patent ownership

The ownership is recorded in the Register of the German Patent and Trade Mark Office. The German Patent and Trade Mark Office records in the Register a change in the person, name or place of residence of the applicant or proprietor of the patent if proof thereof is furnished to the German Patent and Trade Mark Office. Until the change has been entered, the (former) applicant or proprietor of the patent remains subject to the rights and obligations of the German Patent Act (section 30, German Patent Act).

The Register has only a declaratory effect. If the Register is not in agreement with the 'real' situation (eg, because a contractual transferal of the patent has not been recorded yet), the incorrectly recorded owner is not entitled to raise a claim based on the patent at issue.

## DEFENCES

### Patent invalidity

17 | How and on what grounds can the validity of a patent be challenged? Is there a special court or administrative tribunal in which to do this?

Patents cannot be challenged before the civil courts but rather through an opposition or a nullity case. Nullity actions are dealt with at the Federal Patent Court and can be lodged by any third party over the lifecycle of a patent.

The first phase of the proceedings is in writing, after which the Federal Patent Court will generally send a summons for an oral hearing with an unbinding first opinion on the case. The decision is made by five judges after the oral hearing. Appeals can be brought before the German Supreme Court.

If an opposition proceeding is already pending, a party that has received a cease-and-desist letter or against which a claim for patent infringement has been brought may intervene in the pending proceedings if the term for filing an opposition has expired. Such a party will be a full independent party of the opposition proceedings.

Further, the German patent procedure allows for third-party observations to be filed during examination of a patent. Third parties may bring forward any facts or arguments; however, they will not be an official party to the proceedings.

Cancellation actions against utility models can be brought before the German Patent and Trademark Office (GPTO). After a cancellation request has been submitted, the utility model owner will be notified and must oppose the cancellation request within one month. If it fails to do so, the utility model will be cancelled automatically. If the utility model owner opposes the cancellation request, a full cancellation procedure will commence.

### Absolute novelty requirement

18 | Is there an 'absolute novelty' requirement for patentability, and if so, are there any exceptions?

Under sections 1 to 3 of the Patent Act, patents must have absolute novelty.

### Obviousness or inventiveness test

19 | What is the legal standard for determining whether a patent is 'obvious' or 'inventive' in view of the prior art?

Owing to the bifurcated system of infringement and nullity proceedings in Germany, the infringement courts, if a nullity action is pending against the respective patent in suit, only determine the likelihood of whether or not the nullity action will be successfully based upon a summary examination of the main attacks against the patent. Therefore, obviousness and inventiveness only play a subordinate role in the infringement proceedings.

### Patent unenforceability

20 | Are there any grounds on which an otherwise valid patent can be deemed unenforceable owing to misconduct by the inventors or the patent owner, or for some other reason?

No.



### Prior user defence

21 | Is it a defence if an accused infringer has been privately using the accused method or device prior to the filing date or publication date of the patent? If so, does the defence cover all types of inventions? Is the defence limited to commercial uses?

Yes, and the defence is limited to commercial use (the accused infringer must, at least, have taken concrete dispositions to commence commercial activities very soon).

## REMEDIES

### Monetary remedies for infringement

22 | What monetary remedies are available against a patent infringer? When do damages start to accrue? Do damage awards tend to be nominal, provide fair compensation or be punitive in nature? How are royalties calculated?

Royalties can be calculated in three ways:

- lost profits of the patent owner;
- licence analogy – damages calculated on the basis of the amount that the infringer would have paid as an appropriate licence fee if it had obtained permission to use the infringing right; or
- infringer's profit – the profits that the infringer made as a result of the infringement (product-related costs incurred specifically through the manufacture or distribution of the infringing products are deductible; overhead costs are not).

The patent owner may choose between the above calculation methods. It may alternate between these methods until a final decision on the damages is handed down; the plaintiff may even choose one method for past use of the patent and the other for future use. Lost profits of the patent owner is seldom chosen because of the difficulty of proving what profits the patent owner would have made absent the infringement. Damages do not tend to be punitive in nature.

### Injunctions against infringement

23 | To what extent is it possible to obtain a temporary injunction or a final injunction against future infringement? Is an injunction effective against the infringer's suppliers or customers?

The threshold for granting preliminary injunctions varies from court to court. However, the standard of proof is generally lower than that in proceedings on the merits. Additional means of proof (eg, sworn affidavits) are admissible.

The patent owner must show that the patent has been infringed and that the matter is urgent (that waiting for a decision on the merits is not justified).

The patent owner must initiate the preliminary injunction proceedings without undue delay on positive knowledge of the patent infringement (that is, it must show that it has taken appropriate measures to obtain a speedy decision). The case law varies from court to court regarding what constitutes an undue delay. In general, if the preliminary injunction proceedings commence within four to six weeks following knowledge of the infringement; there is no undue delay.

The validity of the disputed patent must be beyond a reasonable doubt. Some courts require that the patent must have survived opposition proceedings or nullity proceedings.

### Banning importation of infringing products

24 | To what extent is it possible to block the importation of infringing products into the country? Is there a specific tribunal or proceeding available to accomplish this?

Yes, it is possible to block the importation of infringing products into the country. The Central Office for Intellectual Property of the Federal Finance Directorate (Southeast), based in Munich, is responsible for all applications for customs action due to the infringement of IP rights.

### Attorneys' fees

25 | Under what conditions can a successful litigant recover costs and attorneys' fees?

In general, a fully successful litigant can recover the following costs and fees:

- statutory fees for one attorney at law and one patent attorney (not recoverable is any amount beyond that, eg due to a higher hourly rate of the attorney);
- court fees; and
- reasonable costs to pursue the lawsuit (such as travel costs, translations, costs for experts and post fees).

The court fees and the statutory fee for the attorneys are calculated based upon the value of the case, which is usually suggested by the parties and determined by the court (the higher the value, the higher the fees, whereby the fees rise on a diminishing scale). If a litigant is only partly successful, the court will determine a quota (proportion of win and lose in view of the whole case); the costs and fees are refundable to that quota.

### Wilful infringement

26 | Are additional remedies available against a deliberate or wilful infringer? If so, what is the test or standard to determine whether the infringement is deliberate? Are opinions of counsel used as a defence to a charge of wilful infringement?

No.

### Time limits for lawsuits

27 | What is the time limit for seeking a remedy for patent infringement?

Generally, the limitation period for damage claims is three years, starting from the end of the year in which the claim arose and the right holder obtains knowledge of the circumstances giving rise to the claim and of the identity of the infringer, or would have obtained such knowledge if he had not shown gross negligence. However, based upon legal considerations (see, for example, Federal Court of Justice, case ref. X ZR 109/16 *Spannungsversorgungsvorrichtung*) the time limit for specific remedies is 10 years.

### Patent marking

28 | Must a patent holder mark its patented products? If so, how must the marking be made? What are the consequences of failure to mark? What are the consequences of false patent marking?

No.

## LICENSING

### Voluntary licensing

29 | Are there any restrictions on the contractual terms by which a patent owner may license a patent?

Yes, there are, in particular, concrete restrictions due to (European) antitrust law.

### Compulsory licences

30 | Are any mechanisms available to obtain a compulsory licence to a patent? How are the terms of such a licence determined?

Yes, either based upon section 24 of the German Patent Act or based upon antitrust law.

Section 24 (paragraph 1) of the German Patent Act has the following terms:

*The non-exclusive authorisation to commercially use an invention shall be granted by the Federal Patent Court in an individual case in accordance with the following provisions (compulsory licence) where*

- (1) *a licence seeker has, within a reasonable period of time, unsuccessfully attempted to obtain permission from the proprietor of the patent to use the invention on reasonable commercial terms and conditions, and*
- (2) *the public interest calls for the grant of a compulsory licence.*

### Antitrust compulsory licence

Under specific circumstance, the patent owner may be obligated to grant a licence in respect of the subject matter of the patent pursuant to antitrust law. This argument may be lodged as a defence by the alleged infringer in a patent infringement proceeding. This may be the case, where the plaintiff holds a dominant position on the product market because of the respective patent with the result that the obligations under article 102 of the Treaty on the Functioning of the European Union apply to him or her in enforcing his or her patent.

## PATENT OFFICE PROCEEDINGS

### Patenting timetable and costs

31 | How long does it typically take, and how much does it typically cost, to obtain a patent?

According to the German Patent and Trademark Office (GPTO), the grant or rejection of a patent application takes on average two-and-a-half years, provided that a request for examination was filed at the time of the application. A first-office action containing comments on patentability is usually issued within nine months of the filing date if the application was first filed in Germany.

The total costs – from the filing of the patent application to the grant of the patent by the GPTO – depends on:

- the complexity of the application;
- the number of prior art documents cited by the GPTO; and
- the length of the examination proceedings.

On average, the total costs (including official and attorney fees) vary between €4,000 and €6,000, excluding the drafting of the application.

### Expedited patent prosecution

32 | Are there any procedures to expedite patent prosecution?

#### Request for acceleration

According to the Examination Guidelines of the German Patent and Trademark Office (GPTO), No. 2.3.2, accelerated proceedings may be expected 'upon a justified request for acceleration'. In such a case, the GPTO pursues the application as a matter of priority 'if the otherwise expected duration of the procedure would lead to considerable disadvantages for the applicant'. Applications for acceleration are in principle only valid for the next procedural step; however, the further procedure will be accelerated if the request for acceleration indicates so.

#### Global Patent Prosecution Highway

An acceleration request under the Global Patent Prosecution Highway (GPPH) is possible. This is a fast-track way to apply for and have your invention examined internationally. Participation in the GPPH at the GPTO is free of charge.

The prerequisite for participating is that you have already filed, at a GPPH partner office, a patent application with the same content and the same filing date or priority date. Furthermore, the office of first filing must have considered the invention to be patentable – at least for one patent claim. This means, for example, that you must have received a patent or a positive Patent Cooperation Treaty search report.

#### Other measures

Requesting examination and paying the examination fee upfront accelerates the proceedings. The examination request may be postponed for a maximum of seven years. Filing informal letters to the examiner or contacting the examiner by telephone is helpful, at least inasmuch one usually obtains information as to when a further office action may be expected.

### Patent application contents

33 | What must be disclosed or described about the invention in a patent application? Are there any particular guidelines that should be followed or pitfalls to avoid in deciding what to include in the application?

The application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (section 34, German Patent Act). An invention is, in principle, sufficiently disclosed if at least one way is clearly indicated enabling the person skilled in the art to carry out the invention. Second, it is necessary that the skilled person can put the invention into practice over the whole scope of the claim. Hence, one example only may not be sufficient, in particular for chemical or pharmaceutical inventions. The general approach of the GPTO, however, is not overly strict, in this regard.

Clear and plausible information on the effects of the features of the claimed invention is often very helpful for inventive step discussions with the examiner. This is also important (and very often missing) for features of the dependent claims or features from the description, when incorporated in the independent claim in a fallback situation.

Also – even if the GPTO is far less strict than the European Patent Office in this regard – care should be taken regarding the disclosure of any feature of the invention that may serve as a fallback position during prosecution. Even if certain generalisations are often accepted as being implicitly disclosed, it may be detrimental if they are not explicitly disclosed.

### Prior art disclosure obligations

34 | Must an inventor disclose prior art to the patent office examiner?

No.

### Pursuit of additional claims

35 | May a patent applicant file one or more later applications to pursue additional claims to an invention disclosed in its earlier filed application? If so, what are the applicable requirements or limitations?

As long as the patent application is pending, a divisional application may be filed (with different and/or additional claims). The patent application is considered to be pending up to:

- withdrawal of the application; or
- a final decision (either grant or refusal) plus one month (which is the deadline for filing an appeal; it is not necessary to actually file an appeal).

Moreover, within the first 10 years, a utility model application may be branched off (with different and/or additional claims).

### Patent office appeals

36 | Is it possible to appeal an adverse decision by the patent office in a court of law?

Yes, appeals against decisions of the GPTO (typically in examination, opposition or restoration proceedings) are handled by the Federal Patent Court in Munich. Under certain circumstances, a further appeal (revision) can be brought to the German Supreme Court.

### Oppositions or protests to patents

37 | Does the patent office provide any mechanism for opposing the grant of a patent?

In Germany, the opposition process occurs after grant of the patent. A third party may file an opposition within nine months of the publication of a grant. The opposition may be based on one or more of the following grounds:

- lack of novelty or inventive step;
- the subject matter is not patentable in another respect;
- the patent does not disclose the invention in a sufficiently concise and complete way to enable a person skilled in the art to carry it out in practice;
- essential elements of the patent were taken without consent from a third party; or
- the subject matter extends beyond the content of the patent application as originally filed.

The grounds for opposition must be substantiated within the nine-month opposition period. Oppositions are handled before the competent 'patent division' consisting of a panel of three examiners deciding on the case. A hearing will take place on the request of a party or if the patent division deems this to be expedient.

### Priority of invention

38 | Does the patent office provide any mechanism for resolving priority disputes between different applicants for the same invention? What factors determine who has priority?

If two or more persons have made the invention independently of each other, the right shall belong to the person who is the first to file the application in respect of the invention with the GPTO, (section 6, German Patent Act).

### Modification and re-examination of patents

39 | Does the patent office provide procedures for modifying, re-examining or revoking a patent? May a court amend the patent claims during a lawsuit?

At the request of the proprietor of the patent, the patent may be revoked or limited with retroactive effect by amending the patent claims. The patent office may not refuse a limitation request because the limited claims do not define a patentable invention (eg, vis-à-vis prior art cited by the patentee). By law (section 22 of the German Patent Act), the scope of protection may not be extended. According to case law, the scope of protection must be reduced so that a mere change of the wording is not allowable.

The patent may not be amended in an infringement procedure before the infringement court. However, before the infringement court, it is generally possible to enforce the patent in a limited version. *Inter omnes*, the patent may be amended by the Federal Patent Court in a nullity action (being separate from the infringement proceedings).

### Patent duration

40 | How is the duration of patent protection determined?

The maximum term of protection is 20 years from the filing date.

## UPDATE AND TRENDS

### Key developments of the past year

41 | What are the most significant developing or emerging trends in the country's patent law?

On 28 October 2020, the German Federal Ministry of Justice published a draft act (*Regierungsentwurf*) to modernise German patent law.

### Clarification of potential limitations of the cease-and-desist claim

The Modernisation Draft comprises an explicit proportionality clause in section 139 (1) of the German Patent Act, according to which the cease and desist claim is 'excluded as far as the enforcement of the claim would lead to disproportionate hardship for the infringer or third parties not justified by the exclusive right due to the special circumstances of the individual case'.

According to the reasoning provided by the Ministry of Justice, this clause is to be understood as a mere clarification of the Enforcement Directive (RL 2004/48/EC) of the European Union and established case law of the German Supreme Court (BGH GRUR 2016, 1031 – *Wärmetauscher*). The idea behind the amendment seems to be to encourage the infringement courts to consider potential limitations of the cease-and-desist claim. Since there does not seem to be a substantial change of law, the impact of the intended 'clarification' remains open.

### Improved coordination between infringement and invalidity proceedings

The draft Modernisation Act seeks to close the 'injunction gap' between infringement and invalidity proceedings. According to the draft, the Federal Patent Court 'should' provide a preliminary assessment of patent validity within six months. In view of that preliminary assessment, an infringement court may stay infringement proceedings until a decision in the parallel invalidity proceedings is lodged.

### Coronavirus

42 | What emergency legislation, relief programmes and other initiatives specific to your practice area has your state implemented to address the pandemic? Have any existing government programmes, laws or regulations been amended to address these concerns? What best practices are advisable for clients?

In the field of patent law, no specific emergency legislation is currently in force. According to a communication of the GPTO (German Patent and Trademark Office) of 19 October 2020, the GPTO has stopped summoning for oral hearings in patent cases. As of 9 March 2021, this practice was still in force.

The courts continue to summon for and hold (actual) Oral Proceedings. Based on section 128a Code of Civil Procedure, the infringement courts occasionally permit the parties upon their filing a corresponding request or ex officio, to stay at another location in the course of *Orla Proceedings*, and to take actions in the proceedings from there (by video connection).

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