

12. German Patent Law (as of 01.10.2009)

Part I The Patent

Section 1

(1) Patents shall be granted for inventions which are new, involve an inventive step and are susceptible of industrial application.

(2) Patents shall also be granted for inventions within the meaning of subsection (1) whose subject matter is a product that consists of or contains biological material or whose subject matter is a process by means of which biological material is produced or processed or which makes use of it. Biological material which is isolated from its natural environment or produced by means of a technical process can also constitute the invention's subject matter if it naturally existed beforehand.

(3) The following in particular shall not be regarded as inventions within the meaning of subsection (1):

1. discoveries, scientific theories and mathematical methods;
2. aesthetic creations;
3. schemes, rules and methods for mental acts, games or business activities and programs for computers;
4. presentations of information.

(4) Subsection (3) contradicts the patentability only to the extent to which protection is sought for the mentioned objects or activities as such.

Section 1a

(1) The human body in its individual stages of origin and development, including the gamete, as well as the mere discovery of one of its components including the sequence or partial sequence of a gene cannot constitute a patentable invention.

(2) An isolated component of the human body or a component that was produced in another way by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if this component's structure is identical to the structure of a natural component.

(3) In the application, the industrial applicability of a sequence or partial sequence of a gene is to be described precisely by stating the sequence's or partial sequence's function.

(4) If the subject matter of an invention is a sequence or partial sequence of a gene whose structure is identical to the structure of a natural sequence or partial sequence of a human gene, its use, whose industrial applicability according to subsection 3 is described precisely, is to be included in the patent claim.

Section 2

(1) No patents are granted for inventions whose industrial application would be contrary to public policy or contra bonos mores; such infringement cannot be derived simply from the fact that the utilization is prohibited by law or an administrative provision.

(2) Patents are especially not granted for

1. processes for cloning human beings;
2. processes for modifying the genetic identity of the human being's germ line;
3. the use of human embryos for industrial or commercial purposes;
4. processes for modifying the genetic identity of animals which might cause these animals to suffer without essential medical benefit for the human being or the animal, as well as animals created by means of such processes.

When applying numbers 1 to 3, the respective provisions of the Law for Embryo Protection [*Embryonenschutzgesetzes*] shall prevail.

Section 2a

(1) Patents are not granted for

1. plant varieties or animal breeds as well as essentially biological processes for the growing of plants and breeding of animals.
2. methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practiced on the human or animal body. This provision shall not apply for products, in particular substances or compositions, for use in any of these methods.

(2) Patents can be granted for inventions

1. whose subject matters are plants or animals if the invention's description is not limited to a specific plant variety or animal breed;

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2. whose subject matter is a microbiological or other technical process or a product obtained by means of such process, as far as this is not a plant variety or animal breed.

Section 1a, sentence 3 shall apply *mutatis mutandis*.

(3) Within the meaning of the law the following terms are defined as follows:

1. “biological material” means a material containing genetic information and capable of reproducing itself or suitable for being reproduced in a biological system;

2. “microbiological process” means a process which makes use of microbiological material, by means of which an interference with microbiological material is performed or by means of which microbiological material is produced;

3. “essentially biological process” means a process for growing plants or breeding animals which is exclusively based on natural phenomena such as cross-breeding or selection;

4. “plant variety” means a variety in the sense of the definition of the Council Regulation (EC) No 2100/94 of 27 July 1994 concerning the Community Plant Variety Right (OJEC No. L 227 p. 1) as amended from time to time.

Section 3

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

(2) Additionally, the content of the following patent applications, which have an earlier priority and which were published only on or after the date relevant to the priority of the later application, shall be considered to be comprised in the state of the art:

1. national applications, as originally filed with the German Patent Office;

2. European applications, as originally filed with the competent authority, in which protection is sought in the Federal Republic of Germany and for which the designation fee for the Federal Republic of Germany has been paid in accordance with Article 79 (2) of the European Patent Convention and if it constitutes a Euro-PCT application (Article 135 (2) of the European Patent Convention), and if the preconditions set forth in Article 153 (5) of the European Patent Convention are being complied with.

3. international applications under the Patent Cooperation Treaty, as originally filed with the Receiving Office, where the German Patent Office is the designated office with respect to the application.

If the earlier priority of an application is based on a claim to the priority of an earlier application, the first sentence shall be applicable only to the extent to which the contents of the application in question do not go beyond the contents of the earlier application. Patent applications under the first sentence number 1 which have been subject to a decision pursuant to Section 50 (1) or (4), shall be considered to have been made available to the public upon expiry of the eighteenth month following their filing.

(3) If substances or compositions of substances are comprised by the state of the art, their patentability shall not be excluded by the provisions of subsections (1) and (2) as far as they are intended for the use in a method referred to in Section 2a (1) no. 2 and their use for such method is not comprised by the state of the art.

(4) The patentability of substances or compositions of substances as mentioned in Section 3 for the specific use in a method as referred to in Section 2a (1) no. 2 shall also not be excluded by the provisions of subsections (1) and (2) if this use is not comprised by the state of the art.

(5) For the application of subsections (1) and (2), a disclosure of the invention shall not be taken into consideration if it occurred no earlier than six months preceding the filing of the application and if it was due to or in consequence thereof

1. an obvious abuse causing a disadvantage for the applicant or his legal predecessor or

2. the fact that the applicant or his legal predecessor displayed the invention at an official or officially recognized international exhibition subject to the provisions set forth in the Convention on International Exhibitions ratified in Paris on November 22, 1928.

The first sentence no. 2 shall only apply if the applicant states, when filing the application, that the invention was actually displayed and submits a certificate proving this fact within four months after the application's filing. The Federal Ministry for Justice will officially inform the public of the exhibitions referred to in the first sentence no. 2 in the Federal Law Gazette [*Bundesgesetzblatt*].

Section 4

An invention shall be considered to involve an inventive step if it is not obvious to the person skilled in the art from the state of the art. If the state of the art also includes documents within the meaning of Section 3 (2), these documents shall not be considered for the decision as to whether or not an inventive step is involved.

Section 5

An invention shall be considered susceptible of industrial application if its subject matter can be produced or used in any kind of industry, including agriculture.

Section 6

The right to a patent shall belong to the inventor or his legal successor. If two or more persons jointly made an invention, the right to a patent shall belong to them jointly. If two or more persons made an invention independently of each other, the right shall belong to the person who is the first to file an application with the Patent Office.

Section 7

(1) In order to avoid the substantive examination of the patent application being delayed due to the need to determine the identity of the inventor, in the proceedings before the Patent Office the applicant shall be deemed to be entitled to request the grant of a patent.

(2) If a patent is revoked due to an opposition based on usurpation (Section 21 (1) no. 3) or if the opposition results in the patent's withdrawal, the opponent may himself file an application for the invention, within one month after the official notification thereof and claim the priority of the earlier patent.

Section 8

The rightful claimant whose invention was applied for by an unauthorized person, or the person having suffered damage due to the usurpation shall be entitled to request to be assigned the right of the patent's application by the applicant. If the application has already resulted in the patent being granted, he may require the patentee to assign the patent to him. Subject to the sentences 4 and 5, such right may only be asserted by means of a legal action within two years after publication of the grant of the patent (Section 58 (1)). If the person having suffered damage has filed an opposition due to usurpation (Section 21 (1) no. 3), he may file an action within one year after the legally binding conclusion of the opposition proceedings. Sentences 3 and 4 shall not apply if the patentee did not act in good faith when acquiring the patent.

Section 9

The patent shall have the effect of the patentee being exclusively authorized to use the patented invention subject to the prevailing law. Without the patentee's prior consent, any third party shall be prohibited

1. from producing, offering, putting into circulation or using a product constituting the subject matter of the patent or importing or owning such product for said purposes;
2. from using a process which is the subject matter of the patent or, if the third party is aware of or if, due to the circumstances, it is obvious that the use of the process is prohibited without the patentee's consent, from offering the process for use within the territory to which this law applies;
3. from offering, putting into circulation, using or importing or owning the product which was directly produced by a process which is the subject matter of the patent for said purposes.

Section 9a

(1) If the patent deals with biological material comprising specific features due to an invention, the effect of Section 9 shall extend to any biological material which was obtained from this biological material by means of generative or vegetative reproduction in the same or similar form and comprising the same features.

(2) If the patent refers to a method enabling biological material to be produced comprising specific features due to an invention, the effects of Section 9 shall extend to any biological material which was directly obtained by said method and any other biological material comprising the same features which was produced by generative or vegetative reproduction in the same or similar form from the material which was obtained from the directly produced material.

(3) If the patent refers to a product made of or containing genetic information due to an invention, the effects of Section 9 extend to any material into which in this product is incorporated and which contains genetic information and complies with its function. Section 1a (1) shall remain unaffected.

Section 9b

If the patentee puts into circulation biological material comprising specific features due to the invention within the territory of a member state of the European Union or in a contracting state to the Agreement on the European Economic Area and if that further biological material is produced by means of generative or vegetative reproduction, the effects of Section 9 shall not come into force if the reproduction of the biological material served the purpose which it was put into circulation for. This shall not apply if the material

produced in such way is used for further generative or vegetative reproduction afterwards.

Section 9c

(1) If vegetable reproduction material is put into circulation to a farmer by the patentee or by a third party upon his consent for the purpose of agricultural cultivation, the farmer shall be entitled to use his crop for generative or vegetative reproduction himself in his own business, contrary to sections 9, 9a and 9b second sentence. Regarding the provisions and scope of this authorization, Article 14 of the Council Regulation (EC) No. 2100/94 as amended from time to time as well as the implementing regulations enacted based on it shall apply *mutatis mutandis*. As far as claims of the patentee arise therefrom, they are to be asserted according to the implementing regulations that were enacted due to Article 14 (3) of the Council Regulation (EC) No. 2100/94.

(2) If agricultural livestock or animal reproduction material is put into circulation to a farmer by the patentee or by a third party upon his consent for agricultural purposes, the farmer shall be entitled to use said agricultural livestock or the animal reproduction material for agricultural purposes contrary to the sections 9, 9a and 9b second sentence. This authorization shall also apply in case of the agricultural livestock or other animal reproduction material being surrendered for the purpose of continuing its agricultural activity, it shall not apply, however, for the sale with the objective or in the context of a reproduction serving profit-making purposes.

(3) Section 9a (1) through (3) shall not apply to biological material which was produced coincidentally or due to the fact that it was technically inevitable in the course of agricultural activity. Therefore, a farmer can usually not be held liable if he has cultivated seeds or plants which are subject to this patent protection.

Section 10

(1) A patent shall have the further effect that any third party not having obtained the patentee's consent shall be prohibited from offering or supplying means which refer to an essential element of the invention to any person other than those authorized for using the patented invention for the purpose of using the invention within the area of this law's application, if the third party is aware of or if, due to the circumstances, it is obvious that these means are suitable of and intended for exploiting the invention.

(2) Subsection (1) shall not apply if the means are general products commercially available on the market, unless the third party intentionally

had the recipient acting in a way prohibited by the provisions set forth under Section 9 second sentence.

(3) Persons performing the acts referred to in Section 11 no. 1 to 3 shall not be considered persons entitled to exploit the invention within the meaning of subsection (1).

Section 11

The effects of the patent shall not extend to

1. acts carried out privately for non-commercial purposes;
2. acts carried out for experimental purposes relating to the subject matter of the patented invention;
 - 2a. the use of biological material for the purpose of cultivation, discovery and development of new plant varieties;
 - 2b. Studies and experiments and the practical requirements resulting thereof which are required for being granted an authorisations for the purposes of the law on medicinal products for the putting into circulation within the European Union or a license for the purpose of the law on medical products within the Member States for the European Union or in third-party countries.
3. the direct individual preparation of pharmaceuticals in pharmacies in accordance with medical prescription as well as acts concerning pharmaceuticals so prepared;
4. the use of the patented invention's subject matter aboard vessels of another state party to the Paris Convention for the Protection of Industrial Property in the body of the vessel, in the machinery, rigging, on the instruments and other equipment, if such vessels temporarily or accidentally enter the waters falling within the purview of this Law provided that this subject matter exclusively serves the needs of the vessel;
5. the use of the patented invention's subject matter for the construction or operation of aircraft or land vehicles of another state party to the Paris Convention for the Protection of Industrial Property or of equipment for such vehicles, provided that they temporarily or accidentally enter the territory to which this law applies;
6. acts specified in Article 27 of the Convention on International Civil Aviation of December 7, 1944, provided that such acts concern the aircraft of another state to which the provisions of said Article are applicable.

Section 12

(1) A patent shall not apply to a person who had already been using the invention in Germany, or had made the arrangements necessary for doing so

at the time of the filing of the application. Such person shall be entitled to use the invention for the needs of his own business in his own or other people's workshops. This authorization can only be willed or transferred together with the business. If the the applicant or his predecessor in title disclosed the invention prior to applying for a patent to other persons and thereby reserved his rights in the event of a patent being granted, a person learning of the invention as a result of such disclosure cannot refer to measures according to the provision's first sentence which he has taken within six months after the disclosure.

(2) If the patentee is entitled to a right of priority, the application prior to application mentioned in subsection (1) shall prevail. However, this shall not apply to nationals of a foreign country which does not guarantee reciprocity in this respect, as far as they claim the priority of a foreign application.

Section 13

(1) The patent shall have no effect if the German Federal Government orders that the invention be exploited in the interest of public welfare. Furthermore, the patent shall not apply to any exploitation of the invention which is ordered in the interests of the security of the Federal Republic by the highest competent Federal authority or, on the latter's instructions, by a subordinate agency.

(2) Appeals against orders according to subsection (1) shall be heard by the German Federal Administrative Court if such orders were issued by the Federal Government or the highest competent Federal authority.

(3) In cases as described in subsection (1) above, the patentee shall be entitled to receive reasonable compensation from the Federal Government. Due to their considerable amount, legal actions may be brought before the ordinary civil courts. Any order by the Federal Government according to the first sentence of subsection (1) shall be communicated to the person recorded as patentee in the Register (Section 30 (1)) prior to the invention's exploitation. If the highest competent Federal authority by which an order or an instruction according to the second sentence of subsection (1) was issued, learns that a claim for compensation arose according to the first sentence, it shall inform the person recorded in the Register as patentee.

Section 14

The scope of protection of the patent as well as the patent application shall be determined by the patent claims. However, for interpreting the patent claims the description and drawings shall be referred to.

Section 15

(1) The right to a patent, the right to the grant of a patent and the rights deriving from a patent shall pass to the heirs. They may be assigned to others with or without restrictions.

(2) The rights according to subsection (1) may be the subject matter of exclusive or non-exclusive licenses for the whole or a part of the territory to which this Law applies. If a licensee contravenes a restriction of his license covered by the first sentence, the right conferred by the patent may be asserted against him.

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

Section 16

(1) The duration of a patent shall be twenty years, beginning on the day following the filing of the invention's application. If the purpose of an invention is the improvement or further development of another invention for which the applicant has already secured patent protection, he may apply for a patent of addition, which shall expire at the same time as the patent for the earlier invention, within eighteen months from the date of filing of the application or, if an earlier date is claimed as relevant for the application, from that date.

(2) If the main patent lapses due to revocation, declaration of nullity or abandonment, the patent of addition shall become an independent patent; its duration shall be determined by the date of commencement of the main patent. Where there are several patents of addition, only the first one shall become independent; the others shall be deemed patents of addition to that patent.

Section 16a

(1) Pursuant to Regulations of the European Communities concerning the creation of supplementary certificates of protection, which shall be notified in the Federal Law Gazette, supplementary protection may be requested in respect of a patent, which shall immediately follow the expiry of the term of the patent according to Section 16 (1). Annual fees shall be paid for supplementary protection.

(2) Unless otherwise provided by the law of the European Communities, the provisions of this Law concerning the applicant's authorization (sections 6 through 8), the effects of the patent and exceptions thereto (sections 9 through 12), the order to exploit the patent and the compulsory license (sections 13 and 24), the scope of protection (Section 14), the licenses and

their registration (sections 15 and 30), on the patent's expiry (Section 20), the nullity (Section 22), the willingness to grant a license (Section 23), on the domestic representative (Section 25), the Patent Court and proceedings before the Patent Court (sections 65 through 99), proceedings before the Federal Court of Justice (sections 100 through 122a), the reinstatement (Section 123), the duty to tell the truth (Section 124), the electronic document (Section 125a), the official language, the deliveries and legal aid (Section 126 through 128), the infringements of a right (sections 139 through 141a, 142a and 142b), the joining of actions and the arrogation of the patent (sections 145 and 146) shall apply mutatis mutandis to supplementary protection.

(3) Licenses and declarations pursuant to Section 23 which are effective for a patent shall also apply to the supplementary protection.

Section 17

(1) An annual fee is to be paid for every application and every patent for the third year and each subsequent year following the date of filing.

(2) No annual fees shall be payable for a patent of addition (Section 16 (1) second sentence). If a patent of addition is converted into an independent patent, it shall become subject to the payment of fees. The due date and the annual amount shall be determined by the date of commencement of the preceding main patent. The first sentence and the first half of the second sentence shall apply mutatis mutandis to an application for a patent of addition provided that, where an application for a patent of addition is regarded as an application for an independent patent, such annual fees shall be payable as are due for an application that is independent from the beginning.

(3) through (6) (repealed)

Sections 18 and 19

(repealed)

Section 20

(1) The patent shall expire if

1. the patentee waives it by a written declaration to the Patent Office;
2. the declarations set forth in Section 37 (1) are not made in due time after service of the official notification (Section 37 (2)); or

3. the annual fee or the difference is not paid in due time (Section 7 (1), Section 13 (3) or Section 14 (2) and (5) of the Law on Patent Fees [*Patentkostengesetz*], Section 23 (7) fourth sentence of this Law).

(2) The Patent Office shall have the sole power of decision as to whether or not the declarations set forth in Section 37 (1) as well as the payments have been made in due time; sections 73 and 100 shall remain unaffected.

Section 21

(1) The patent shall be revoked (Section 61) if it becomes obvious that

1. the subject matter of the patent is not patentable according to sections 1 through 5,

2. the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;

3. the essential elements of the patent were taken from the descriptions, drawings, models, appliances or equipment of another person, or from a process used by another person, without his consent (usurpation);

4. the subject matter of the patent extends beyond the content of the application as originally filed with the competent authorities; the same shall apply if the patent was granted on a divisional application or on a new application filed in accordance with Section 7 (2) and the subject matter of the patent extends beyond the content of the earlier application as originally filed with the competent authorities.

(2) If the grounds for revocation affect the patent in part only, the patent shall be maintained in the form of a corresponding limitation. The limitation may be affected in the form of an amendment to the patent claims, the descriptions or the drawings.

(3) In the event of revocation, the effects of the patent and of the application shall be deemed not to have existed ab initio. In case of restricted maintenance, this provision shall apply mutatis mutandis.

Section 22

(1) Nullity of a patent shall be declared upon request (Section 81) if it becomes obvious that one of the grounds mentioned in the aforementioned Section is present or the patent's scope of protection has been extended.

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

Section 23

(1) If the applicant for a patent or the person recorded as patentee in the Register (Section 30 (1)) declares to the Patent Office in writing his willingness to allow for anyone to exploit the invention subject to reasonable compensation, the annual fees falling due after receipt of the declaration shall be reduced to one half of the amount. The effect of a declaration made in respect of a main patent shall extend to all its patents of addition. The declaration shall be recorded in the Register of Patents and published in the Patent Gazette [*Patentblatt*].

(2) Such declaration is inadmissible if a note concerning the grant of an exclusive license (Section 30 (4)) is recorded in the Register of Patents or a request for the recording of such note has been submitted to the Patent Office.

(3) Any person who wishes to exploit the invention after the recording of the declaration shall notify the patentee of his intention. Notification shall be deemed to have been effected if it is sent by registered mail to the person recorded in the Register as patentee or to his registered representative or domestic representative (Section 25). A statement of how the invention is to be exploited shall be given in the notification. After such notification, the notifying party shall be entitled to exploit the invention in the manner stated by him. He shall be obliged to inform patentee on the patent's exploitation at the end of every calendar quarter, and shall pay compensation for it. If he fails to meet this obligation in due time, the person recorded in the Register as patentee may grant him a reasonable extension of time and, if the extension of time expires without result, may prohibit further exploitation of the invention.

(4) The compensation shall be assessed by the Patent Division upon a party's request in writing. Sections 46, 47 and 62 shall apply *mutatis mutandis* to the proceedings. The application can be filed against several parties involved. In assessing the compensation, the Patent Office may order that the costs of the taxation of costs be borne in whole or in part by the opponent.

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

(6) If the declaration is made in respect of an application, the provisions of subsections (1) through (5) shall apply *mutatis mutandis*.

(7) The declaration may be withdrawn at any time by a written declaration to the Patent Office insofar as no intention of exploiting the invention has been communicated to the patentee. Withdrawal shall take effect upon filing. The amount by which the annual fees have been reduced shall be paid within one

month after withdrawal of the declaration. If the differential amount is not paid within the time limit stipulated in the third sentence, it can be paid together with the default fine until the expiration of a time limit of four further months

Section 24

(1) The non-exclusive authorization for the commercial exploitation of an invention is granted by the Patent Court in individual cases subject to the following provisions (compulsory license) as far as

1. the person applying for a license has unsuccessfully tried to obtain the licensee's consent for exploiting the invention subject to reasonable provisions as customary in business within a reasonable period of time, and
2. the public interest demands for the granting of a compulsory license.

(2) If the patent applicant is not able to exploit an invention that has been protected by a patent having later priority without infringing the patent having earlier priority, he shall be entitled towards the patent holder to be granted a compulsory license, if

1. the precondition set forth in subsection 1 no. 1 is complied with and
2. his own invention comprises an important technical improvement of substantial economic importance over such patents which have earlier priority.

Patentee may require the license applicant to be granted a cross license subject to reasonable conditions for the patented invention's exploitation having the earlier priority.

(3) Subsection (2) shall apply *mutatis mutandis* if a plant breeder was not granted or cannot use a plant variety right without infringing an earlier patent.

(4) Regarding a patented invention in the field of semiconductor technology, a compulsory license may only be granted in accordance with subsection (1) if this is necessary in order to rectify anticompetitive practices on the part of the licensee that have been detected in the course of court or administrative proceedings.

(5) If the patentee does not or not mainly exploit the patent in Germany, compulsory licenses can be granted in accordance with subsection (1) in order to ensure that the domestic market be supplied sufficiently with the patented product. In so far, the import equals the patent's exploitation within Germany.

(6) The granting of a compulsory license of a patent is only admissible upon said patent's granting. It can be granted in a restricted way and subject to

conditions. Scope and duration of the exploitation are to be limited to the purpose for which it was granted. The patentee shall be entitled to be paid a remuneration by the owner of the compulsory license which is reasonable depending on the individual circumstances and which takes the economic value of the compulsory license into account. In the event that essential changes of the circumstances which were decisive regarding the assessment of the remunerations amount occur, every party involved shall be entitled to claim for respective adjustments. If the circumstances which were the basis for the compulsory license being granted are not present anymore and if they are unlikely to reoccur, patentee may request that the compulsory license be revoked.

(7) The compulsory license of a patent can only be assigned together with the business which was in charge of the invention's evaluation. The compulsory license of an invention which is the subject matter of a patent having earlier priority can only be assigned together with the patent which has later priority.

Section 25

(1) A person who has neither domicile, residence nor place of business in Germany may take part in proceedings before the Patent Office or the Patent Court regulated by this Law and may assert rights derived from a patent only if he has appointed a patent attorney or an attorney-at-law authorized to represent in proceedings before the Patent Office, the Patent Court and in civil litigations concerning the patent and authorized to demand prosecution as his representative in Germany.

(2) Citizens of member states of the European Union or another contracting member of the Agreement on the European Economic Area can be appointed for rendering a service within the meaning of the Treaties of Rome as representatives within the meaning of subsection 1 if they are authorized to practice in their profession as one of the professions listed in Annex 1 of Section 1 of the Law Implementing the Directives of the European Community pertaining to the professional law regulating the legal profession [*Gesetz über die Tätigkeit europäischer Rechtsanwälte in Deutschland*] dated March 09, 2000 (BGBl. [Federal Law Gazette] I S. 182) or of Section 1 of the German Act relating to the aptitude test for admission as a patent attorney [*Gesetzes über die Eignungsprüfung für die Zulassung zur Patentanwaltschaft*] dated July 06, 1990 (BGBl. [Federal Law Gazette] I S. 1349, 1351) mutatis mutandis.

(3) The place where the representative appointed pursuant to subsection (1) has his business premises shall be deemed, within the meaning of Section 3 of the Code of Civil Procedure [*Zivilprozessordnung*], to be the place where

the assets are located; if there are no such business premises, then the place within Germany where the representative has his domicile or, in absence thereof, the place where the Patent Office has its seat, shall be relevant.

(4) The legal termination of an appointment as representative pursuant to subsection (1) shall only become valid upon the Patent Office or the Patent Court being notified of both this termination and the appointment of another representative.

Part IV Patent Court

Section 65

The Patent Court shall be established as an autonomous and independent federal court for deciding on appeals against decisions of the Examining Divisions or Patent Divisions of the Patent Office and actions for declaration of nullity of patents and for compulsory license proceedings (sections 81, 85 and 85a). It shall have its official residence at the official residence of the Patent Office. It shall be designated the "Federal Patent Court".

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

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

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

Section 66

In the Patent Court, there shall be established

1. Senates for hearing appeals (Senates of Appeal);
2. Senates for deciding actions for the declaration of nullity of patents and for compulsory license proceedings (Nullity Senates).

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

Section 67

(1) The Senate of Appeal shall decide in the composition of

1. one legally qualified member as presiding judge and two technically qualified members in cases pursuant to sections 23 (4) and 50 (1) and (2),
2. one technically qualified member as presiding judge, two additional technically qualified members and one legally qualified member in cases
 - a) in which the application was rejected,
 - b) in which the notice of opposition was rejected as inadmissible,
 - c) pursuant to Section 61 (1) first sentence and Section 61 (1), d) of Section 61 (2) as well as
 - e) sections 130, 131 and 133;
3. one legally qualified member as presiding judge, one additional legally qualified members and one technically qualified member in cases of Section 31 (5);
4. three legally qualified members in all other cases.

(2) The Nullity Senate shall decide in the composition of one legally qualified member as presiding judge, an additional legally qualified member and three technically qualified members in cases pursuant to sections 84 and 85 (3), and, in other cases, in the composition of three judges, one of which has to be a legally qualified member.

Section 68

The provisions of Part II of the Judiciary Law [*Gerichtsverfassungsgesetz*] shall apply to the Patent Court provided that:

1. In cases in which no legally qualified judge would be on the Board according to the election result, the legally qualified judge having received the highest number of votes out of all the legally qualified members shall be deemed to have been elected.
2. A senate of the Patent Court consisting of three legally qualified judges shall decide in cases where the election has been contested (Section 21b (6) of the Judiciary Law).
3. The Federal Minister for Justice shall appoint the permanent Substitute of the President.

Section 69

(1) Any hearing before the Senate of Appeal shall be public, provided that a notification of the possibility of file inspection pursuant to Section (5) or the patent specification pursuant to Section 58 (1) has been published. Sections 172 through 175 of the Judiciary Law shall be applicable mutatis mutandis provided that

1. at the request of one of the parties, the public may also be excluded from the hearing if it threatens to endanger the requesting party's interests worthy of protection,

2. the public shall be excluded from the pronouncement of the decisions until publication of a notice of the possibility of file inspection pursuant to Section 32 (5) or of the patent specification pursuant Section 58 (1).

(2) The proceedings before the Nullity Senates, including the pronouncement of the decisions, shall be public. Subsection (1), second sentence, no. 1, shall apply mutatis mutandis.

(3) The maintenance of order in the senates' sessions shall be the responsibility of the presiding judge. Sections 177 through 180, 182 and 183 of the Judiciary Law relating to the police power in court shall apply mutatis mutandis.

Section 70

(1) Decisions in the Senates shall require deliberation and the taking of votes. Only the number of members of the Senates prescribed by law may participate in this. During the deliberation and voting, only persons employed at the Patent Court for training purposes may be present in addition to the members of the Senates, provided that the presiding judge permits them to be present.

(2) The Senates shall decide according to the majority of votes; if the votes are equally divided, the presiding judge shall have the casting vote.

(3) The members of the Senates shall vote according to seniority of service and, in cases of equal seniority of service, according to age, the younger person shall vote before the older one. If one has been appointed, the recording judge shall vote first. The presiding judge shall vote last.

Section 71

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

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

Section 72

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

Part V

Proceedings Before the Patent Court

1.

Proceedings on Appeal

Section 73

(1) An appeal shall lie from the decisions of the Examining Sections and Patent Divisions.

(2) An appeal shall be filed in writing with the Patent Office within one month after service of the decision. Copies of the appeal and of all written statements shall be attached for the other parties. The appeal and all written statements containing motions pertaining to the matter or the declaration of withdrawal of the appeal or of a motion shall be served ex officio upon the other parties; other documents shall be communicated informally to those parties, provided that service has not been ordered.

(3) If the authority whose decision is contested considers the appeal to be well founded, it shall rectify its decision. It may order that the appeal fee be refunded pursuant to the Law on Patent Fees. If the appeal is not allowed, it shall be remitted to the Patent Court without comment as to its merits before the expiration of three month.

(4) If the appellant is opposed by another party to the proceedings, the provisions of the first sentence of sub-section 3 shall not apply.

Section 74

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

(2) In the case of Section 31 (5) and Section 50 (1) and (2), an appeal may also be lodged by the competent supreme federal authority.

Section 75

(1) An appeal shall have a staying effect.

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

Section 76

The President of the Patent Office may, if he considers it appropriate to safeguard the public interest, make written statements in appeal proceedings before the Patent Court, be present at hearings and make statements therein. Written statements by the President of the Patent Office shall be communicated to the parties by the Patent Court.

Section 77

The Patent Court may, if it considers it appropriate on an issue of law of basic importance, give the President of the Patent Office the opportunity to intervene in appeal proceedings. The President of the Patent Office shall become a party on receipt of the notice of intervention.

Section 78

An oral hearing shall be held if

1. one of the parties applies for it,
2. evidence is to be taken before the Patent Court (Section 88 (1)) or
3. the Patent Court considers it pertinent.

Section 79

(1) A decision shall be given on an appeal.

(2) If an appeal is not admissible or not lodged in the form provided by law and within the prescribed period, it shall be dismissed as inadmissible. The decision may be given without an oral hearing.

(3) The Patent Court may reverse the contested decision without itself deciding the case on its merits if

1. the Patent Office has not yet decided the case on its merits;
2. the proceedings before the Patent Office suffer from a substantial defect,
3. new facts or evidence have become known which are essential to the decision.

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

Section 80

(1) Where more than one person is party to the proceedings, the Patent Court may decide that the costs of the proceedings shall be borne in whole or in part by one of the parties if and to the extent to which this is equitable. It may, in particular, also order that the costs incurred by the parties shall, to the extent to which they were necessary for the appropriate protection of the rights involved, be refunded in whole or in part by one of the parties.

(2) Costs may be awarded against the President of the Patent Office only if he has made petitions after his intervention in the proceedings.

(3) The Patent Court may order that the appeal fee be refunded pursuant to the Law on Patent Fees.

(4) Sub-sections 1 through 3 shall also be applicable if, either in whole or in part, the appeal, the application or the opposition is withdrawn or if the patent is relinquished.

(5) In other respects, the provisions of the Code of Civil Procedure relating to the procedure for the assessment of costs (Sections 103 through 107) and execution of decisions regarding the assessment of costs (Sections 724 through 802) shall apply mutatis mutandis.

2.

Nullity and Compulsory License Proceedings

Section 81

(1) Proceedings for a declaration of nullity of a patent or supplementary certificate of protection or for the grant or withdrawal of a compulsory license or for the adaptation of the remuneration determined by a judgment under a compulsory license shall be instituted by bringing legal action. The legal action is to be brought against the person registered as the patentee or against the owner of the compulsory license. An action against a supplementary certificate of protection may be consolidated with an action against the basic patent and may also be based on the fact that one of the grounds for nullity (Section 22) exists in respect of the patent forming the basis.

(2) An action for a declaration of nullity of a patent shall not be brought as long as opposition may still be filed or opposition proceedings are pending.

Action for declaration of nullity of the supplementary certificate of protection cannot be filed if applications pursuant to Section 49a (4) can be filed or proceedings on a decision for these applications are pending.

(3) In the case of usurpation, only the injured party shall be entitled to bring an action.

(4) An action shall be filed with the Patent Court in writing. Copies of the action and of all briefs shall be attached for the opposing party. The action and all briefs shall be served on the opposing party ex officio.

(5) The action shall designate the plaintiff, the defendant and the matter at issue and shall contain a specific motion. The facts and documentary evidence relied on shall be stated. If the action does not fully comply with these requirements, the presiding judge shall request the plaintiff to file the necessary additional materials within a specified period.

(6) Plaintiffs who do not have their usual place of residence in a Member State of the European Union or in a Contracting State to the Agreement on the European Economic Area shall provide security, at the demand of the defendant, with respect to the costs of the procedure; Section 110 (2) No. 1 through 3 of the German Code of Civil Procedure shall apply mutatis mutandis. The Patent Court shall determine, at its equitable discretion, the amount of the security and shall fix a time limit within which that amount shall be furnished. If the time limit is not observed, the action shall be deemed to have been withdrawn.

Section 82

(1) The Patent Court shall serve notice of the action on the defendant and requests him to reply thereto within one month.

(2) If the defendant fails to reply in due time, a decision complying with the plaintiffs request may be rendered forthwith without an oral hearing and every factual allegation made by the plaintiff is assumed to be proved.

(3) If Defendant files an objection in due time, the Patent Court informs the plaintiff about the objection and fixes a date for the oral hearing. With the consent of the parties, the oral hearing may be waived. Sub-section 2 shall remain unaffected.

Section 83

(1) In the proceedings for a declaration of nullity of a patent or supplementary certificate of protection the Patent Court shall bring issues which will expectedly be of major importance for the decision or which are useful to focussing the trial on questions essential to the decision to the parties' attention as early as possible. Such an indication shall not be deemed

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necessary if the issues to be discussed seem to be obvious according to the parties' submissions. Section 139 of the German Code of Civil Procedure shall apply supplementarily.

(2) The Patent Court may set a deadline to the parties within which they may give their final opinion as regards the indication according to sub-section 1 by means of pertinent applications of supplements to their submissions and also regarding other aspects. The time limit may be prolonged if the party concerned presents significant causes for this. Such causes are to be established.

(3) The authorization pursuant to sub-sections 1 and 2 may also be exercised by the presiding judge or a member of the senate designated by him.

(4) The Patent Court may reject pleas in law of a party or an amendment of statement of claim or a defence of the defendant by means of an amended version of the patent which are submitted only after expiration of the time limit set according to sub-section 2 and may render a decision without further investigations if

1. the consideration of the new submission would necessitate an adjournment of the already set date for the oral hearing and
2. the party concerned fails to provide an adequate excuse and
3. the party concerned has been informed of the consequences of a failure to observe the time limit.

The ground of excuse is to be established.

Section 84

(1) The decision on an action shall be delivered in the form of a judgment. An interim decision on the admissibility of the action may be delivered in the form of an interlocutory judgment.

(2) In the judgment, the costs of the proceedings shall also be decided on. The provisions of the Code of Civil Procedure concerning procedural costs shall apply *mutatis mutandis* insofar as equity does not require otherwise; the provisions of the Code of Civil Procedure relating to the procedure for the assessment of costs and execution of decisions regarding the assessment of costs shall apply *mutatis mutandis*. Section 99 (2) shall remain unaffected.

Section 85

(1) In proceedings for the grant of a compulsory license, the plaintiff may, at his request, be allowed to exploit the invention by preliminary injunction if he satisfies the Court that the conditions referred to in Section 24 (1) through

(6) are complied with and that an immediate grant of permission is urgently required in the public interest.

(2) The issue of a preliminary injunction may be made conditional on the furnishing of security by the person making the request for the damage which the defendant may suffer.

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

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

(5) If the issue of the preliminary injunction proves to have been unjustified *ab initio*, the person making the request shall be required to compensate the defendant for the damage which he has suffered from the execution of the preliminary injunction.

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

Section 85a

(1) The proceedings pursuant to Article 5 letter c, Article 6, 10 (8) and Article 16 (1) and (4) of the Regulation (EC) No 816/2006 of the European Parliament and of the Council of 17 May 2006 on compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with public health problems (Official Journal of the European Union No. L 157 p. 1) are instituted by an action pursuant to Section 81 (1) first sentence.

(2) Sections 81 through 85 shall apply *mutatis mutandis* if the proceedings are not subject to the Council Regulation (EC) No. 816/2006.

3.

Common Rules of Procedure

Section 86

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(1) For the exclusion and challenge of members of the Court, Sections 41 through 44 and 47 through 49 Code of Civil Procedure shall apply mutatis mutandis.

(2) The following shall also be excluded from judicial office:

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

2. in proceedings for declaration of nullity of a patent, persons who have participated in the proceedings before the Patent Office or Patent Court relating to the grant of the patent or relating to opposition.

(3) The decision on the challenge of a judge shall be rendered by the senate to which the person who is challenged belongs. If, as a result of the elimination of the member who has been challenged, the senate is unable to render a decision, a senate of Appeal of the Patent Court consisting of three legal members shall render the decision.

(4) The decision on the challenge of a registrar shall be rendered by the Senate having jurisdiction in the matter.

Section 87

(1) The Patent Court shall investigate the facts of the case ex officio. It shall not be bound by the factual statements and the offers of proof of the parties.

(2) The presiding judge or a member designated by him shall, before the oral hearing or, in the absence of an oral hearing, before the decision of the Patent Court, make all arrangements necessary for the matter to be dealt with, if possible, in one oral hearing or in one session. In other respects, Section 273 (2), (3), first sentence, and (4), first sentence, of the German Code of Civil Procedure shall apply mutatis mutandis.

Section 88

(1) The Patent Court shall take evidence at the oral hearing. In particular, it may carry out judicial inspection, examine witnesses, experts and the parties and order the consultation of documents.

(2) In suitable cases, the Patent Court may, prior to the oral hearing, have evidence taken by one of its members as commissioned judge or, specifying particular questions of evidence, request another court to take such evidence.

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

Section 89

(1) As soon as the date for the oral hearing is fixed, the parties shall be summoned with at least two weeks' notice. In urgent cases, the presiding judge may shorten this period.

(2) It shall be pointed out in the summons that if a party fails to appear, the case may be heard and decided in its absence.

Section 90

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

(2) After the case is called, the presiding judge or recording judge shall report on the essential contents of the files.

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

Section 91

(1) The presiding judge shall discuss with the parties the questions of fact and questions of law involved in the case.

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

(3) After discussing the case, the presiding judge shall declare the hearing closed. The senate may decide to reopen the hearing.

Section 92

(1) At the oral hearing, and whenever evidence is taken, a registrar of the court shall be called to act as minute-writer. If, by order of the presiding judge, no minute-writer is called, one of the judges shall record the minutes.

(2) Minutes shall be taken of oral proceedings and of all taking of evidence. Sections 160 through 165 of the German Code of Civil Procedure shall apply *mutatis mutandis*.

Section 93

(1) The Patent Court shall take its decisions on the basis of its own conclusions freely reached in the light of the results of the proceedings as a whole. The decision shall state the grounds which led the judges to form their conclusions.

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(2) The decision may be based only on facts and the results of evidence on which the parties have had an opportunity to state their views.

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

Section 94

(1) Final decisions of the Patent Court shall, if an oral hearing has taken place, be rendered during the court session during which the oral hearing was concluded or during a session to be fixed forthwith. This deadline shall not exceed three weeks except when important reasons, in particular the volume and the difficulty of the case, so require. Final decisions shall be served ex officio on the parties. A final decision may be served on the parties instead of being pronounced in court. If the Patent Court makes its decision without an oral hearing, pronouncement of the decision shall be replaced by service thereof on the parties.

(2) Final decisions of the Patent Court by which a motion is refused or a legal remedy is decided upon shall state the grounds upon which the decision is based.

Section 95

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

(2) The correction may be decided on without a previous hearing. The decision concerning the correction shall be recorded on the decision itself and the counterparts thereof.

Section 96

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

(2) The Patent Court shall decide on this matter without taking evidence. Only the judges who took part in rendering the decision whose correction is requested shall participate in this. The decision concerning the correction shall be recorded on the decision itself and the counterparts thereof.

Section 97

(1) The parties may conduct the litigation themselves before the Patent Court. Section 25 shall remain unaffected.

(2) The parties may have an attorney-at-law or patent attorney represent them as authorized representative. Otherwise, only the following persons are authorized to represent as authorized persons before the Patent Court:

1. Employees of the party or an affiliated company (Section 15 of the German Stock Corporation Act); Authorities and legal entities of public law including any affiliations formed by them for the performance of their public tasks may also have employees of other authorities and legal entities of public law including any affiliations formed by them for the performance of their public tasks represent them,

2. family members of legal age (Section 15 of the German Fiscal Code, Section 11 of the German Civil Partnership Act), persons qualified to exercise the functions of a judge and joint litigants, provided that the representation is not connected to actions in return for payment.

Authorized persons who are not natural persons shall act through their bodies and representatives charged with legal representation in court.

(3) The Court shall reject any authorized persons who are not authorized to represent in accordance with sub-section 2 by means of an incontestable decision. Steps in the proceedings carried out by an authorized person not authorized to represent and service or communications to this authorized person shall be effective until he is rejected. The Court may prohibit the authorized persons specified in sub-section 2, second sentence from further representing by means of an incontestable decision if they are not able to set the facts and situation of the dispute forth appropriately.

(4) Judges may not appear as authorized persons before the court which they belong to.

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

(6) The lack of a power of attorney may be asserted at any stage of the proceedings. The Patent Court shall ex officio consider the lack of a power of attorney if an attorney-at-law or patent attorney does not appear as the authorized person.

Section 98

(repealed)

Section 99

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(1) In the absence of provisions in this Law concerning proceedings before the Patent Court, the German Judiciary Law and the Code of Civil Procedure shall apply mutatis mutandis unless the special nature of the proceedings before the Patent Court precludes this.

(2) Appeals from decisions of the Patent Court shall lie only to the extent permitted under this Law.

(3) For the grant to other persons of permission to inspect the files of the case, Section 31 shall apply mutatis mutandis. The request for permission shall be decided by the Patent Court. Permission to inspect the files of proceedings for obtaining a declaration of nullity of a patent shall not be granted if and provided that the patentee proves an adverse interest worthy of protection.

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

Part VI

Proceedings Before the Federal Court of Justice

1.

Procedure in Respect of Appeals on Points of Law

Section 100

(1) An appeal on a point of law from decisions of the Chambers of Appeal of the Patent Court in respect of an appeal under Section 73 or in respect of the maintenance or revocation of a patent pursuant to Section 61 (2) shall lie to the Federal Court of Justice if the Chamber of Appeal in its decision has given leave to appeal on the point of law.

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

3. an issue of law of basic importance is to be decided; or

2. the further development of the law or the safeguarding of uniform judicial practice requires a decision by the Federal Court of Justice.

(3) Leave to appeal on a point of law from the decisions of the Chambers of Appeal shall not be required if one of the following procedural defects is present and denounced:

1. if the court which rendered the decision was not properly constituted;

2. if a judge having participated in rendering the decision was excluded by law from the exercise of judicial office or, because of the possibility of partiality, had been successfully challenged;
3. if a party to the proceedings was refused a fair hearing,
4. if a party to the proceedings was not represented according to the provisions of the law, unless he expressly or tacitly agreed with the conduct of the proceedings;
5. if the decision was made on the basis of an oral hearing in which the provisions on the publicity of proceedings were violated; or
6. if the decision does not state the grounds therefor.

Section 101

- (1) The parties to the proceedings on appeal shall have the right to appeal on a point of law.
- (2) The only basis for an appeal on a point of law shall be the argument that the decision is founded on a breach of the law. Sections 546 and 547 of the German Code of Civil Procedure shall apply *mutatis mutandis*.

Section 102

- (1) An appeal on a point of law shall be lodged in writing with the Federal Court of Justice within one month after service of the decision.
- (2) In proceedings about the appeal on a point of law before the Federal Court of Justice, the regulations of Section 144 regarding the determination of the value in dispute shall apply *mutatis mutandis*.
- (3) An appeal on a point of law shall state the grounds on which it is based. The period allowed for stating the grounds shall be one month; it shall commence with the filing of the appeal on a point of law and may, upon request, be extended by the presiding judge.
- (4) The statement of the grounds for the appeal on a point of law must contain
 1. a declaration regarding the extent to which the decision is contested and whether the modification or reversal thereof is requested;
 2. designation of the violated rule of law;
 3. provided that the basis for the appeal on a point of law is the argument that the law was violated in respect of procedure, a statement of the facts constituting the defect.
- (5) Before the Federal Court of Justice, the parties shall be represented by an attorney-at-law admitted to practice before the Federal Court of Justice as

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authorized representative. At the request of any party, its patent attorney shall be granted leave to speak. Section 143 (3) shall apply mutatis mutandis.

Section 103

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

Section 104

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

Section 105

(1) If more than one person is party to the proceedings in respect of an appeal on a point of law, the appeal and the statement of the grounds therefor shall be served on the other parties, with the request to file declarations, if any, in writing with the Federal Court of Justice within a given period after service. The date on which the appeal was filed shall be communicated with the service of the appeal on a point of law. The appellant shall file the required number of certified copies together with the appeal or the statement of the grounds for the appeal.

(2) If the President of the Patent Office is not a party in an appeal on a point of law, Section 2 shall apply mutatis mutandis.

Section 106

(1) In proceedings in respect of an appeal on a point of law, the provisions of the German Code of Civil Procedure regarding exclusion and challenge of members of the court, authorized persons and legal assistants, ex-officio service of documents, summonses, sessions and time limits, and reinstatement, shall apply mutatis mutandis. In the case of reinstatement, Section 123 (5) through (7) shall apply mutatis mutandis.

(2) Regarding the publicity of proceedings, Section 69 (1) shall apply mutatis mutandis. .

Section 107

(1) An appeal on a point of law shall be the subject of a decision; such decision may be rendered without an oral hearing.

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

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

Section 108

(1) In the event of reversal of the decision appealed against, the case shall be referred back to the Patent Court for a further trial and decision.

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

Section 109

Where more than one person is party to the proceedings relating to an appeal on a point of law, the Federal Court of Justice may decide that the costs necessary for the appropriate final disposal of the case shall be borne in whole or in part by one of the parties if and to the extent that this is equitable. If the appeal is rejected or dismissed as inadmissible, the costs arising from the appeal shall be awarded against the appellant. Costs arising from gross negligence by one of the parties shall be awarded against that party.

(2) Costs may only be awarded against the President of the Patent Office if he lodged the appeal on a point of law or made petitions in the proceedings.

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

2.

Procedure on Appeal

Section 110

(1) An appeal shall lie to the Federal Court of Justice from the judgments of the nullity chambers of the Patent Court (Section 84).

(2) The appeal is lodged by filing written notice of appeal with the Federal Court of Justice.

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(3) The period allowed for appeal shall be one month. It shall commence upon service of the judgment reduced to writing in the complete version, but no later than within five months of pronouncement.

(4) The notice of appeal shall contain:

1. the denomination of the Judgment against which the appeal is directed;
2. the declaration that an appeal is being lodged against that Judgment.

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

(6) A counterpart of certified copy of the challenged Judgment shall be submitted alongside the notice of appeal.

(7) Decisions of the nullity senates shall be appealable only together with their judgments (Section 84); Section 71 (3) of the German Code of Civil Procedure shall not apply.

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

Section 111

(1) The appeal may only be based on the fact that a decision by the Patent Court is based on an infringement of Federal Law or if facts to be used as a basis pursuant to Section 117 justify a different decision.

(2) The Law shall be infringed if a rule of law has not or not correctly been applied.

(3) A decision shall always be regarded as being based on an infringement of the Law,

1. if the Patent Court was not properly constituted;
2. if a judge participated in rendering the decision who was excluded by law from the exercise of judicial office, provided that this impediment was not unsuccessfully asserted by means of a motion to disqualify the judge;
3. if a judge participated in rendering the decision despite the fact that he had been challenged on grounds of bias and the motion to disqualify him had been declared to be well-founded;
4. if a party to the proceedings was not represented according to the provisions of the law, unless he expressly or tacitly permitted the litigation;
5. if the decision was made on the basis of an oral hearing in which the provisions on the publicity of proceedings are violated;
6. if, contrary to the provisions of the law, the decisions does not state the reasons on which it is based.

Section 112

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

(2) Unless it is already contained in the notice of appeal, the statement of grounds of appeal shall be submitted to the Federal Court of Justice in a brief. The time limit for stating the grounds of appeal shall be three months. It shall commence upon service of the judgment reduced to writing in the complete version, but no later than within five months of pronouncement. On application, the time limit may be extended by the presiding judge, provided that the opponent consents. Without consent, the time limit may be extended by up to one month, if, in the presiding judge's free conviction, the legal dispute will not be delayed by the extension or if the appellant shows good cause. If the appellant cannot be granted inspection of the court records for an appropriate period of time during this time limit, the presiding judge may upon application extend the time limit by up to two months after delivery of the court records.

(3) The statement of grounds of appeal shall contain:

1. declaration regarding the extent to which the judgment is contested and reversal thereof is requested (motions of appeal);

2. declaration of the grounds of appeal, that is:

a) specification of the circumstances from which the infringement of law results;

b) provided that the basis for the appeal is the argument that the law was violated in respect of procedure, a statement of the facts constituting the defect.

c) specification of new pleas in law, as well as the facts due to which the new pleas of law are to be permitted pursuant to Section 117.

(4) Section 110 (5) shall apply mutatis mutandis to the statement of grounds of appeal.

Section 113

Before the Federal Court of Justice, the parties shall be represented by an attorney-at-law or patent attorney as authorized representative. The authorized representative shall be entitled to appear with a technical advisor.

Section 114

(1) The Federal Court of Justice shall examine ex officio whether the appeal is admissible in itself and whether it has been filed and the grounds therefor

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have been stated in the form provided by law and within the prescribed time limit. If any of these requirements is lacking, the appeal shall be dismissed as inadmissible.

(2) The decision may be rendered as a decision.

(3) If the appeal is not dismissed as inadmissible by a decision, a date shall be set for the oral hearing and communicated to the parties.

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

Section 115

(1) The respondent may cross-appeal. The cross-appeal is admissible even if the respondent waived the appeal or if the period allowed for appeal has lapsed.

(2) The cross-appeal shall take place by means of submitting a statement of cross-appeal to the Federal Court of Justice and it shall be made within two months of service of the statement of grounds of appeal. If a time limit for the response to the appeal has been set for the respondent, the cross-appeal shall be admissible until the lapse of this time limit.

(3) The reasons for the cross-appeal shall be stated in the statement of cross-appeal. Section 110 (4), (5), and (8), as well as Section 112 (3) shall apply *mutatis mutandis*.

(4) The cross-appeal loses effect if the appeal is withdrawn or dismissed.

Section 116

(1) Only the applications made by the parties shall be subject to examination by the Federal Court of Justice.

(2) An amendment of claim and, in the proceedings for declaration of nullity of the patent or the supplementary certificate of protection, defense by means of an modified version of the patent is only admissible if

1. the opponent agrees or the Federal Court of Justice regards the amendment of application to be pertinent and
2. the amended applications can be based on facts which the Federal Court of Justice shall use as a basis for its trial and decision regarding the appeal pursuant to Section 117.

Section 117

Sections 529, 530 and 531 of the German Code of Civil Procedure shall apply mutatis mutandis to the scope of examination of the Federal Court of Justice and to the pleas of law which are submitted late, which are rejected or new. At the same time, Section 112 shall take the place of Section 520 of the German Code of Civil Procedure.

Section 118

(1) The judgment of the Federal Court of Justice shall be rendered on the basis of an oral hearing. Section 69 (2) shall apply mutatis mutandis.

(2) The period indicated in the summons shall amount to at least two weeks.

(3) The oral hearing may be refrained from if

1. the parties agree or
2. only a decision regarding the costs is to be rendered.

(4) If a party fails to appear at the date for the oral hearing, trial may take place without it and the decision may be made by means of a disputed judgment. If neither party appears, the judgment shall be based on the files.

Section 119

(1) If an infringement of the law does become apparent due to the appeal against the contested judgment but the decision proves to be correct for other reasons, the appeal shall be rejected.

(2) Provided that the appeal is regarded as well-founded, the contested judgment shall be reversed. If the judgment is reversed due to a defect in the proceedings, the proceedings shall simultaneously be reversed to the extent to which they are affected by the defect.

(3) In the event of reversal of the judgment, the case shall be referred back to the Patent Court for a new trial and decision. The remittal may be directed to a different nullity senate.

(4) The Patent Court shall be bound to base its decision on the legal opinion on which the reversal is based.

(5) The Federal Court of Justice may decide on the matter itself if this is pertinent. It shall decide itself if the matter is mature for final decision.

Section 120

Grounds for the decision do not have to be stated provided that the Federal Court of Justice does not regard notices of defects in the proceedings as drastic. This shall not apply to notices pursuant to Section 111 (3).

Section 121

(1) In proceedings before the Federal Court of Justice, the regulations of Section 144 regarding the determination of the value in dispute shall apply mutatis mutandis.

(2) In the judgment, the costs of the proceedings shall also be decided on. The provisions of the German Code of Civil Procedure concerning procedural costs (Sections 91 through 101) shall apply mutatis mutandis provided that equity does not require otherwise; the provisions of the German Code of Civil Procedure relating to the procedure for the assessment of costs (Sections 103 and 107) and execution of decisions regarding the assessment of costs (Sections 724 through 802) shall apply mutatis mutandis.

3.

Proceedings on Appeal

Section 122

(1) An appeal shall lie to the Federal Court of Justice from the judgments of the nullity senate of the Patent Court about the grant of preliminary injunction in proceedings for the granting of a compulsory license (Sections 85 and 85a). Section 110 (7) shall apply mutatis mutandis.

(2) An appeal shall be lodged in writing with the Federal Court of Justice within one month.

(3) The period for filing an appeal shall commence upon service of the judgment reduced to writing in the complete version, but no later than within five months of pronouncement.

(4) Section 74 (1), Sections 84, 110 through 121 shall apply mutatis mutandis to proceedings before the Federal Court of Justice

4.

Common Rules of Procedure

Section 122a

Upon notice of the party encumbered by the decision, the proceedings shall be continued if the Court violated that party's claim to a fair hearing in a manner relevant to the decision. No notice shall lie against a decision

preceding the final decision. Section 321a (2) through (5) of the German Code of Civil Procedure shall apply mutatis mutandis.

Part IX Infringements

Section 139

(1) A claim for injunction may be made by the infringed party against any person who exploits a patented invention contrary to sections 1 through 9, provided there is a danger of repetition. This claim also exists if there is an impending first infringement.

(2) Any person who undertakes such action intentionally or negligently shall be required to compensate the infringed party for the resulting damage. The profit made by the infringing party as a result of the infringement may also be taken into consideration when assessing damages. The claim for damages may also be calculated based on the amount which the infringing party would have had to pay as an appropriate fee if the permission to use the invention had been obtained.

(3) If the subject matter of a patent is a process for manufacturing a new product, the same product produced by any other party shall, until proof to the contrary has been established, be deemed to have been manufactured by the patented process. When establishing proof to the contrary, the defendant's legitimate interests in protecting his manufacturing and business secrets shall be taken into account.

Section 140

If, prior to the granting of a patent, rights from an application whose files may be inspected by any person (Section 31 (1), second half of second sentence and (2)) are claimed in court, and if the decision in the litigation depends the existence of a claim under Section 33 (1), the Court may order that the proceedings be deferred until the decision regarding the granting of the patent is made. If a request for examination pursuant to Section 44 has not been filed, the Court shall, at the request of the opposing party, determine a time limit for filing the request for examination to the party claiming rights from the application. If the request for examination is not filed within that time limit, the rights deriving from the application may not be claimed in the litigation.

Section 140a

(1) A claim for destruction of the products which are subject matter of the patent and possessed or owned by the infringing party may be made by the infringing party against any person who exploits a patented invention contrary to sections 9 through 13. The first sentence shall also apply to products which have been directly manufactured by means of a process which is the subject matter of the patent.

(2) Subsection (1) shall apply mutatis mutandis to the material and devices owned by the infringing party, which have been utilized mainly for the manufacturing of these products.

(3) A claim for recalling the products which are subject matter of the patent or for finally removing them from the channels of distribution may be made by the infringing party against any person who exploits a patented invention contrary to sections 9 through 13. The first sentence shall also apply to products which have been directly manufactured by means of a process which is the subject matter of the patent.

(4) The claims pursuant to sections 1 through 3 shall be precluded if their individual assertion is disproportionate. The legitimate interests of third parties shall also be taken into consideration when assessing the proportionality.

Section 140b

(1) A claim for immediate information about the origin and the channel of distribution of the used products may be made by the infringing party against any person who exploits a patented invention contrary to sections 9 through 13.

(2) In cases of obvious infringement of rights or in cases in which the infringing party has brought an action against the infringing party, the claim, notwithstanding subsection (1), shall also exist against any person who, on a commercial scale,

1. owned products infringing rights,
2. made use of services infringing rights,
3. rendered services used for activities infringing rights or
4. took part in the manufacturing, producing or distributing of such products or in the rendering of such services according to the statements of a person mentioned under numbers 1, 2 or 3,

unless this person would be privileged from testifying against the infringing party in the proceedings pursuant to sections 383 through 385 German Code of Civil Procedure [*Zivilprozessordnung*]. In case the claim pursuant to the first sentence is being asserted in court, the court may, if this applied for, stay the proceedings pending against the infringing party until the proceedings conducted due to the claim to information have been settled. The party required to provide information can claim compensation for the expenditures necessary to provide information from the infringed party.

(3) The party required to provide information shall furnish particulars concerning

1. the names and addresses of the manufacturers, suppliers and other previous owners of the products or the users of the services as well as the commercial purchasers and sales outlets they were intended for, and

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

(4) The claims pursuant to sections 1 through 2 shall be precluded if their individual assertion is disproportionate.

(5) If the person required to provide information intentionally or grossly negligently provides the information incorrectly or incompletely, he shall be required to compensate the infringed party for the resulting damage.

(6) Whoever furnished a true piece of information without having been required to do so pursuant to Section (1) or Section (2), shall only be liable towards third parties if he knew that he was not required to provide information.

In cases where infringement of rights is obvious, the obligation to provide information may be imposed by a preliminary injunction pursuant to sections 935 through 945 German Code of Civil Procedure [*Zivilprozessordnung*].

(8) In criminal proceedings or in proceedings under the Law on Minor Offenses [*Gesetz über Ordnungswidrigkeiten*] due to an act committed before the information was given, such findings may only be used against the person required to give information, or against a dependent person pursuant to Section 52 (1) of the German Code of Criminal Procedure [*Strafprozessordnung*] with the consent of the person required to give the information.

(9) If the information can only be provided using telecommunications traffic data (Section 3 number 30 German Law of Telecommunications [*Telekommunikationsgesetz*]), it being provided requires a prior judicial order concerning the admissibility of the use of telecommunications traffic data, which shall be applied for by the infringed party. The Regional Court in whose region the person required to provide information has its domicile, residence or a place of business, has exclusive jurisdiction regarding the

issuing of this order, irrespective of the value in dispute. The Civil Chamber shall make the decision. The provisions of the law regarding proceedings in family matters and in the matters of voluntary jurisdiction shall apply to the proceedings *mutatis mutandis*. The infringed party shall bear the costs of the judicial order. An immediate appeal against the decision is admissible. The appeal shall be filed within a time period of two weeks. The remainder of the provisions concerning the protection of personal data shall remain unaffected.

(10) Subsection (2) in combination with subsection (9) limits the fundamental right of the secrecy of telecommunications (Article 10 of the German Basic Law [*Grundgesetz*]).

Section 140c

(1) A claim for presentation of a deed or of inspection of a thing at his disposition or a process which constitutes the subject matter of the patent can be made against any person who is sufficiently probable to be using a patented invention contrary to sections 9 through 13 by the holder of right or another authorized person, if this is necessary for substantiating his claims. Provided that it is sufficiently probable that an infringement of rights is being carried out on a commercial scale, the claim also extends to the presentation of bank, financial or trade documents. As far as the alleged infringing party claims that it is confidential information, the court will take the necessary measures to ensure the protection required in the individual case.

(2) The claim pursuant to Section 1 shall be precluded if its individual assertion is disproportionate.

(3) The obligation to present a deed or to tolerate the inspection of a thing may be imposed by a preliminary injunction pursuant to sections 935 through 945 German Code of Civil Procedure [*Zivilprozessordnung*]. The court will take the necessary measures to ensure the protection of confidential information. This especially applies in cases in which the preliminary injunction is issued without the opposing party being heard beforehand.

(4) Section 811 of the German Civil Code [*Bürgerliches Gesetzbuch*] as well as Section 140b (8) shall apply accordingly.

(5) If no infringement was at hand or impending, the alleged infringing party can claim compensation for the damage incurred by him by the request from the party who had claimed the presentation or inspection pursuant to subsection (1).

Section 140d

(1) In case of an infringement of rights on a commercial scale in the cases pursuant to Section 139 (2), the infringed party can also claim the presentation of bank, finance or trade documents or appropriate access to the relevant documents, which are at the infringing party's disposition and which are necessary for the assertion of the claim for damages, from the infringing party if it is questionable whether the claim for damages will be satisfied without the presentation. As far as the infringing party claims that it is confidential information, the court will take the necessary measures to ensure the protection required in the individual case.

(2) The claim pursuant to Section 1 shall be precluded if its individual assertion is disproportionate.

(3) The obligation to present the deeds specified in subsection (1) may be imposed by a preliminary injunction pursuant to sections 935 through 945 German Code of Civil Procedure [*Zivilprozessordnung*] if the claim for damages obviously exists. The court will take the necessary measures to ensure the protection of confidential information. This especially applies in cases in which the preliminary injunction is issued without the opposing party being heard beforehand.

(4) Section 811 of the German Civil Code [*Bürgerliches Gesetzbuch*] as well as Section 140b (8) shall apply accordingly.

Section 140e

If an action has been brought based on this law, in the judgment the winning party may be granted permission to publicize the judgment at the losing party's expense, if it sets forth a legitimate interest. The nature and extent of the publication shall be laid down in the judgment. This permission lapses if it is not utilized within three months of the judgment becoming final and absolute. The dictum pursuant to the first sentence is not provisionally enforceable.

Section 141

The provisions of Part 5 of Book 1 of the German Civil Code [*Bürgerliches Gesetzbuch*] shall apply mutatis mutandis to the limitation of time of the claims due to the infringement of the patent right. If the obliged party has obtained something by the infringement at the entitled party's costs, Section 852 of the German Civil Code [*Bürgerliches Gesetzbuch*] shall apply mutatis mutandis.

Section 141a

Claims from other legal regulations shall remain unaffected.

Section 142

1) Imprisonment of up to three years or a fine shall be imposed on anyone who, without the necessary consent of the patentee or the owner of a supplementary certificate of protection (sections 16a, 49a),

1. produces or offers, distributes, uses or imports or owns for one of these purposes a product which is the subject matter of a patent or a supplementary certificate of protection (Section 9, second sentence, no. 1) or

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

The first sentence, no. 1, shall also apply in the case of a product which has been directly produced by a process which is the subject matter of the patent or the supplementary certificate of protection (Section 9, second sentence, no. 3). (2) If acting commercially, the offender shall be liable to imprisonment of up to five years or a fine.

(3) The attempt shall be subject to punishment.

(4) Offenses under subsection (1) shall only be prosecuted on complaint unless the prosecuting authorities deem that ex-officio intervention is justified in view of the particular public interest in prosecution.

(5) Objects to which the offence is related may be confiscated. Section 74a of the German Criminal Code [*Strafgesetzbuch*] shall apply. If the claims set forth in Section 140a are upheld in proceedings pursuant to the provisions of the Code of Criminal Procedure [*Strafprozessordnung*] regarding compensation of the injured party (sections 403 through 406c), the provisions on confiscation shall not apply.

(6) If a penalty is pronounced, the court shall, if requested of the injured party and if the latter can show a legitimate interest, order publication of the judgment if requested. The nature of the publication shall be laid down in the judgment.

Section 142a

(1) A product which infringes a patent protected under this Law shall, at the request and against provision of security of the holder of the right, be subject to seizure by the customs authorities upon its import or export, if the infringement is obvious and unless the Council's Regulation (EC) No. 1383/2003 dated July 22, 2003 concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights (Official

Journal EU No. L 196 p. 7) applies in the version applicable from time to time. This provision shall apply to trade with other Member States of the European Union and with the other Contracting States to the Agreement on the European Economic Area only if controls are carried out by the customs authorities.

(2) If the customs authorities order seizure, it shall notify both the person entitled to dispose and the petitioner without delay. The origin, quantity and place of storage of the product, together with the name and address of the person entitled to dispose, shall be communicated to the petitioner; the secrecy of correspondence and of the mail (Article 10 of the German Basic Law [*Grundgesetz*]) shall be restricted in this respect. The petitioner shall be given the opportunity to inspect the product if such inspection does not constitute a breach of business or trade secrets

(3) If no opposition to the seizure is made within two weeks of service of the notification pursuant to the first sentence of subsection (3), the customs authorities shall order confiscation of the seized product.

(4) If the person entitled to dispose opposes seizure, the customs authorities shall inform the petitioner of this fact without delay. The petitioner shall declare to the customs authorities without delay whether or not he will maintain the request under subsection (1) in respect of the seized product.

1. If the petitioner revokes his request, the customs authorities shall lift the seizure without delay.

2. If the petitioner maintains his request and submits an executable court decision ordering the impounding of the seized product or the limitation of the right to dispose, the customs authority shall take the necessary measures.

If neither of the cases referred to in nos. 1 and 2 is applicable, the customs authorities shall lift the seizure upon the expiry of two weeks within service of the notification to the petitioner pursuant to the first sentence; if the petitioner can prove that a court decision according to no. 2 has been requested, but has not yet been received, the seizure shall be maintained for a further two weeks at most.

(5) If the seizure proves to have been unjustified from the beginning and if the petitioner has maintained the request pursuant to subsection (5) in respect of the seized product or has not made a declaration without delay (second sentence of subsection (1)), he shall be required to compensate the damages incurred by the person entitled to dispose due to the seizure.

(6) The petition pursuant to subsection (6) shall be submitted to the Federal Finance Office [*Bundesfinanzdirektion*] and shall be effective for one year unless a shorter period of validity is requested; the request may be repeated. The cost of official acts related to the request shall be charged to the

petitioner in accordance with Section 178 of the German Fiscal Code [*Abgabenordnung*].

(7) Seizure and confiscation may be opposed by the legal remedies provided for against seizure and confiscation by the fixed penalty procedure under the Law on Minor Offenses [*Gesetz über Ordnungswidrigkeiten*]. The petitioner shall be heard in the appellate proceedings. An immediate appeal against the decision of the Local Court is admissible; it shall be decided upon by the Higher Regional Court.

Section 142b

(1) If the competent customs authorities stay or withhold the relinquishment of the goods pursuant to Article 9 of Regulation (EC) No. 1383/2003, it shall notify both the holder of the right and the declarant or possessor or owner of the goods without delay.

(2) In case of subsection (1) applying, the holder of the right may request to have the goods destroyed by the simplified procedure described below within the meaning of Article 11 of Regulation (EC) No. 1383/2003.

(3) The request shall be made in writing with the customs authorities within ten working days or, in the case of perishable goods, within three working days of receipt of the notification pursuant to subsection (1). It shall contain the information that the goods which are the subject matter of the process infringe a right protected under this Law. The goods' declarant's, possessor's or owner's written consent to their destruction shall be attached. Notwithstanding the third sentence, the declarant, possessor or owner may make his written statement as to whether or not he consents the destruction directly with the customs authority. The time limits set forth in the first sentence can be prolonged by ten working days at the request of the holder of the right before its lapse.

(4) The request shall be made in writing with the customs authorities within ten working days or, in the case of perishable goods, within three working days of receipt of the notification pursuant to subsection (1). This fact shall be pointed out in the notification pursuant to subsection (1).

(5) The destruction of the goods shall be carried out at the expense and responsibility of the owner of the right.

(6) The customs office may take the organisational implementation in charge. Subsection (5) shall remain unaffected.

(7) The time limit for retention pursuant to Article 11 (1) second bullet point of the Regulation (EC) No. 1383/2003 shall be one year.

(8) In other respects, Section 142a shall apply mutatis mutandis, provided that regulation (EC) No. 1383/2003 contains provisions to the contrary.

Part X

Procedure in Patent Litigation

Section 143

(1) The civil chambers of the regional courts shall have exclusive jurisdiction regarding any and all actions whereby a claim arising from one of the legal relationships regulated in this Law is being asserted (patent litigation), without regard to the value in dispute.

(2) The Governments of the Länder shall have the power to assign any patent litigation in the regions of several regional courts to one such court by statutory order. The Governments of the Länder may transfer those powers to the regional administrations of justice. Moreover, the Länder may assign duties of the court of one Land to the competent court of another land in part or in whole by agreement.

(3) Of the costs arising due to the participation of a patent attorney in the litigation, the fees pursuant to Section 13 of the Federal Attorney Remuneration Law [*Rechtsanwaltsvergütungsgesetz*] as well as the patent attorney's necessary expenses shall be refunded.

Section 144

(1) If, in a patent litigation, a party furnishes prima facie evidence that the awarding of the costs of the case against him according to the full value in dispute would considerably endanger his financial position, the court may, at his request, order that party's liability to pay court fees be adjusted in accordance with a portion of the value in dispute appropriate to his financial position. As a result of the order, the beneficiary shall also be required to pay the fees of his attorney only in accordance with that portion of the value in dispute. Should the costs of the case be imposed on him or should he bear such costs, he shall be required to refund the court fees paid by the opposing party and the fees of the latter's attorney only according to that portion of the value in dispute. Should the extrajudicial costs be imposed on the opposing party or be borne by that party, the beneficiary's attorney may recover his fees from the opposing party in accordance with the value in dispute applicable to the latter.

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(2) The request pursuant to subsection (2) may be declared before and recorded at the court office. It shall be made before the case is tried on its merits. Thereafter, it shall only be admissible if the presumed or fixed value in dispute is subsequently increased by the court. The opposing party shall be heard before the decision on the request is rendered.

Section 145

Any person who has brought an action pursuant to Section 139 may only bring a further action against the defendant on account of the same or a similar act on the basis of another patent if, through no fault of his own, he was unable to also assert that patent in the earlier litigation.