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World Intellectual Property Organization
(WIPO)
attention of Ms. Tomoko Miyamoto
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AKTENZEICHEN WIPO Circular C. 7992

DATUM Berlin, 26. Juli 2011

BETREFF: WIPO Circular C. 7992 dated June 10, 2011, following SCP 16

Dear Ms. Miyamoto,

Thank you very much for sending us Circular 7992.

Further to your request, we are pleased to provide information on the legal requirements of oppositions and to include statistical information, for example, on the number of oppositions.

Under German law, a notice of opposition against a granted patent can be filed at the German Patent and Trade Mark Office (DPMA). The opposition must be filed at the DPMA within three months from the publication of the patent grant (Sec. 59(1), 1st and 2nd sentences, Patents Act [Patentgesetz]). The time limit is only observed if all admissibility requirements are met within the specified period. In particular, the notice of opposition must be sufficiently substantiated. Reestablishment of rights is not available if the time limit of opposition has not been observed. Under the Patent Costs Act [Patentkostengesetz] the filing of an opposition is subject to a fee of 200 EUR, to be paid to the DPMA within the opposition period.

In principle, anybody can oppose a patent (legal remedy in the public interest). This does not apply to the patent owner himself. The patent owner, however, can abandon his patent or

request a limitation of his patent at the DPMA. In case of usurpation, only the injured party can file an opposition against the patent.

The notice of opposition must be filed at the DPMA in writing, bear a hand-written signature, and comply with all other requirements for admissibility. These include, for example, the requirement that the notice of opposition must not leave any doubt as to the opponent's identity.

In the reasoning, the opponent must specify the facts supposed to lead to the conclusion that the patent has to be revoked in full or in part. The relevant actual facts must be explained in detail in such a way that the DPMA and the patent owner need not further investigate the matter in order to examine whether or not there is a ground for revocation.

Sec. 21(1) Patents Act conclusively sets out the grounds for revocation on which an opposition can be based. According to this provision, a patent is revoked if

- (i) "the subject matter of the patent is not patentable under Sections 1 to 5 Patents Act",
- (ii) "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",
- (iii) "the essential elements of the patent have been taken from the descriptions, drawings, models, appliances or equipment of another person, or from a process used by another person, without his consent", and
- (iv) "the subject matter of the patent extends beyond the content of the application as originally filed with the competent authorities".

In opposition proceedings conducted at the DPMA, the Patent Division decides whether the patent shall be revoked or maintained (Sec. 61(1) Patents Act). As a rule, the decision is taken by a panel of three technical members of the Patent Division. If the case involves special legal difficulties, a legal member of the Patent Division joins the panel (Sec. 27(3) Patents Act).

665 oppositions were filed at the DPMA in 2010. Opposition proceedings conducted in 2010 were concluded as follows: 75 cases by the abandonment of the patent by the patent owner, 87 cases by non-payment of the annual fee, 278 cases by revocation of the patent by the DPMA and 538 cases by a decision of the DPMA to maintain the patent in full or in part. In 61 cases, the patent owner lodged an appeal against the revocation of the patent. In 123

cases, an appeal was lodged against the decision of the DPMA to maintain the patent in full or in part.

Yours sincerely,

Dr. Stefan Walz

Head of Unit of Patent Law