

GERMANY

WIPO Note C 8585:

*"In addition, Member States and Regional Patent Offices are invited to **send updated information** concerning their applicable laws on the following subjects in order for the Secretariat to carry out the future work agreed by the Committee (document SCP/24/5, paragraph 5 and paragraph 17, second bullet point under "Quality of Patents, including Opposition Systems"):*

- (i) certain aspects of national/regional patent laws, available at:
http://www.wipo.int/scp/en/annex_ii.html; and*
- (ii) opposition systems and other administrative revocation and invalidation mechanisms, in document SCP/18/4 available at:
http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=202420"*

Ad (i) (see Revised Annex II of document SCP/12/3 Rev.2: Report on the International Patent System):

[...]

Exclusions from Patentable Subject Matter

1. Discoveries, scientific theories and mathematical methods as such.
2. Aesthetic creations as such.
3. Schemes, rules and methods for performing mental acts, playing games or doing business as such.
4. Programs for computers as such.
5. Presentations of information as such.

[...]

12. Methods for the treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body.

Exceptions and Limitations of the Rights:

[...]

4. Propagation or multiplication of biological material placed on the market in the European Economic Area by the patent owner or by a third party with the consent of the patent owner for that purpose, other than for further multiplication or propagation.

[...]

8. Extemporaneous preparation of prescribed medicines in pharmacies and acts concerning those medicines.

[...]

11. Exploitation in the interest of public welfare ordered by the Federal Government or in the interest of the security of the Federal Republic of Germany ordered by, or on the instruction of, the competent highest federal authority, subject to remuneration.

12. Compulsory licenses for reasons of public interest.

Ad (ii) (SCP/18/4):

[...]

V. EXAMPLES OF OPPOSITION PROCEDURES

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70. Under the German Patent Act (*Patentgesetz*), 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 nine months from the publication of the patent grant.¹ The time limit is observed only if all admissibility requirements are met within the specified period. Re-establishment of rights is not available if the time limit for filing an opposition has not been observed². 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.

71. Anyone can oppose a patent, except the patent owner himself.³ In case of usurpation⁴, only the injured party can file an opposition against the patent. In case of (non-) infringement proceedings regarding a patent, an alleged infringer who is party to such proceedings may under certain circumstances intervene in already pending opposition proceedings even after the expiry of the opposition period against the patent in suit.⁵

72. The notice of opposition must be filed with the DPMA in writing bearing a handwritten signature or in electronic form pursuant to Section 125a(1) of the Patent Act and comply with further 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 particular, the notice of opposition must be sufficiently reasoned. 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.

73. Section 21(1) of the Patents Act sets out the grounds for revocation on which an opposition can be based. According to this provision, a patent will be revoked if:

- (i) the subject matter of the patent is not patentable in accordance with Sections 1 to 5 of the Patent 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 content of the patent has been taken from the descriptions, drawings, models, implements or equipment of another person or from a process used by this person, without his consent, and (iv) the subject matter of the patent extends beyond the content of the application as filed with the competent authority.

74. The opposition proceedings are conducted by the Patent Division of the DPMA, which decides whether a patent shall be revoked or maintained.⁶ The decision is taken by a panel of at least three members of the Patent Division, including at least two technically qualified members. If the case involves particular legal difficulties and if none of the participants is a legally qualified member, a legally qualified member of the Patent Division joins the panel.⁷ If the opposition is withdrawn, the proceedings are continued *ex officio* without the opponent.⁸ An appeal against the decision of the Patent Division can be filed with the DPMA within one month of service of the decision.⁹ 75. According

¹ Section 59(1) of the Patent Act

² Section 123(1) no. 1 of the Patent Act

³ The patent owner, however, can abandon his patent or request a limitation of his patent before the DPMA (Section 64 of the Patent Act).

⁴ Section 21(3) of the Patent Act states that: "3. the essential content of the patent has been taken from the descriptions, drawings, models, implements or equipment of another person or from a process used by this person, without his consent (usurpation)".

⁵ Section 59(2) of the Patent Act.

⁶ Section 61(1) of the Patent Act

⁷ Section 27(3) of the Patent Act

⁸ Section 61(1), second sentence, of the Patent Act

⁹ Section 73(1) of the Patent Act

to the DPMA, 480 oppositions concerning 402 patents were filed in 2015. 461 opposition proceedings were conducted in 2015 and concluded as follows: 38 cases by the abandonment of the patent by the patent owner, 51 cases by non-payment of the annual fee, 157 cases by revocation of the patent by the DPMA and 215 cases by a decision of the DPMA to maintain the patent in full or in part. In 67 cases, the patent owner lodged an appeal against the revocation of the patent. In 94 cases, an appeal was lodged against the decision of the DPMA to maintain the patent in full or in part.

[...]

VI. RELATED MECHANISMS

[...]

B. Submission of Information by Third Parties

[...]

(ii) National/Regional laws

[...]

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Third parties may submit information regarding prior art which could prejudice the grant of the patent.¹⁰ That person will not become a party to the proceedings before the DPMA. The submitted information will be communicated to the applicant. The submission will be reviewed by the DPMA *ex officio* and – if relevant – it will be considered during the search or examination procedure. Third party observations may also be submitted during opposition proceedings.¹¹ ANNEX I

STATISTICS

GERMANY

- 480 oppositions concerning 402 patents were filed in 2015.
- Opposition proceedings conducted in 2015 were concluded as follows:
 - 38 cases by the abandonment of the patent by the patent owner;
 - 51 cases by the abandonment of the patent by non-payment of the annual fee;
 - 157 cases by the revocation of the patent by the DPMA;
 - 215 cases by the decision of the DPMA to maintain the patents in full or in part.
- Patent owners lodged an appeal against the revocation of their patents by the DPMA in 67 cases.
- In 94 cases, an appeal was lodged against the decisions of the DPMA to maintain the patents in full or in part.

ANNEX II

Germany: Third Party Observation + Post-grant Opposition

¹⁰ Section 43(3), second sentence, of the Patent Act

¹¹ Section 59(5) of the Patent Act