

# Patents in Germany and Europe

Procurement, Enforcement  
— and Defense —  
An International Handbook

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SECOND EDITION

ALEXANDER HARGUTH  
STEVEN CARLSON



Wolters Kluwer

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## Procurement, Enforcement and Defense – An International Handbook

Second Edition

Alexander Harguth  
Steven Carlson



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## About the Authors

**Dr. Alexander Harguth** is a German patent litigator. His understanding of the German system arises from 20 years litigating patent infringement actions in Germany's district and appellate courts, along with related parallel nullity and opposition proceedings, as well as German border enforcement proceedings. Mr. Harguth's experiences provide a historical depth, as well as extensive lessons for coordinating parallel U.S. litigation.

His co-author is **Steven C. Carlson**, a former clerk to the Honorable Paul R. Michel of the U.S. Court of Appeals for the Federal Circuit, and to the Honorable Roderick R. McKelvie of the U.S. District Court for the District of Delaware. Mr. Carlson litigates patents in courts throughout the U.S. through the Silicon Valley office of Kasowitz, Benson, Torres & Friedman LLP. Together, they have endeavored to present the German patent system in an understandable, practical format for counsel in the U.S. and around the world.

## Preface

This handbook aims to provide lawyers in the U.S. and elsewhere in the world with a practical understanding of Germany's patent system. This second edition addresses the many legal changes that have occurred since the original publication of the handbook in 2011.

This handbook is motivated by a simple reason—patent litigation is global. Many cases will inherently spread into cross-border litigation. Other disputes, which are initially confined to the U.S., could be strategically resolved by resort to the swifter, less expensive proceedings through German courts and soon through the German divisions of the Unified Patent Court. Understanding the opportunities available in Germany provides companies with a broader toolkit for enforcing their intellectual property, and defending against challenges brought by others.

Germany itself is one of the most important markets in the world. Winning a patent suit in Germany effectively provides dominance over the entire European market, and consequently gives the patent owner important leverage worldwide. Suits in Germany frequently resolve well ahead of U.S. counterpart suits, at a fraction of the cost. And because injunctive relief is generally available following a successful lawsuit, Germany offers relief that often cannot be obtained in the U.S. These factors, combined with the unique procedural structure of Germany's patent system, have made it the top jurisdiction for patent litigation in Europe, and one of the most important forums worldwide.

The present edition addresses the upcoming changes in connection with the Unitary Patent and the Unified Patent Court which will be operational in December 2017, notwithstanding Brexit. The start of the “sunrise” period for the possibility to “opt out” ordinary European patents from the Unified Patent Court is planned for early September 2017. It provides a minimum period of three months for patentees who wish to opt out their ordinary European Patents to do so before the Unified Patent Court becomes operational. The new system represents a new enforcement tool which will co-exist with the German system.

This handbook is intended to put the systems available in Germany into context for a non-German audience, and particularly for American lawyers. Proceedings in Germany are presented in relation to the U.S. system—patentability, discovery,

pleadings, claim construction, trial, etc. are described in counterpart to patent litigation in the U.S. The structure provides the practitioner an informed framework for the various phases of patent procurement, enforcement and defense in Germany.

To provide this bridge between the German and U.S. systems, the authors offer their perspectives as native practitioners in their respective jurisdictions. Dr. Alexander Harguth is a German patent litigator. His understanding of the German system arises from 20 years litigating patent infringement actions in Germany's district and appellate courts, along with related parallel nullity and opposition proceedings, as well as German border enforcement proceedings. Mr. Harguth's experiences provide a historical depth, as well as extensive lessons for coordinating parallel U.S. litigation.

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## List of Abbreviations

ArbEG	Arbeitnehmererfindergesetz (Act on Employees' Inventions)
BeckRS	Law Journal "Beck Rechtsprechung"
BGBI	Bundesgesetzblatt (Federal Law Gazette)
BGHZ	Entscheidungen des Bundesgerichtshofs in Zivilsachen (Compilation of decisions of the Federal Supreme Court in civil matters)
BlPMZ	Blatt für Patent-, Muster- und Zeichenwesen (Gazette for intellectual property matters published by the GPTO)
BT-Drucksache	Bundestags-Drucksache (Gazette of the Federal Parliament)
CD	Community Design
EC	European Commission
ECJ	European Court of Justice
EESR	Extended European Search Report
EPC	European Patent Convention
EPO	European Patent Office
EPO-G	Decision of the EPO's Enlarged Board of Appeal
EPO-J	Decision of the EPO's Legal Board of Appeal.
EPO-T	Decision of the EPO's Technical Board of Appeal
EU	European Union
FPC	(German) Federal Patent Court
GRUR	Gewerblicher Rechtsschutz und Urheberrecht (German professional journal for intellectual property matters)
GebrMG	Gebrauchsmustergesetz (Utility Model Act)
GPTO	German Patent and Trademark Office
IIC	International Review of Intellectual Property and Competition Law published by the Max Planck Institute for Intellectual Property and Competition Law

IntPatÜG	Gesetz über internationale Patentübereinkommen (Act on International Patent Conventions)
InstGE	Entscheidungen der Instanzgerichte zum Recht des geistigen Eigentums (Compilation of decisions of Instance Courts in intellectual property matters)
ISA	International Searching Authority
ITC	International Trade Commission
Mitt	Mitteilungen der deutschen Patentanwälte (German professional journal for intellectual property matters)
NJW	Neue Juristische Wochenschrift (German professional journal for legal matters)
OJ	Official Journal of the European Patent Office
PatG	Patentgesetz (Patent Act)
PCT	Patent Cooperation Treaty
RCD	Registered Community Design
SPC	Supplementary Protection Certificate.
TRIPS	Agreement on Trade-Related Aspects of Intellectual Property Rights
UPC	Unified Patent Court
UPCA	Unified Patent Court Agreement
UP	Unitary Patent
USPTO	U.S. Patent and Trademark Office
TRIPS	Agreement on Trade-Related Aspects of Intellectual Property Rights
WIPO	World Intellectual Property Organization
WO-ISA	Written Opinion of the International Search Authority
ZPO	Zivilprozessordnung (Code of Civil Procedure)
ZGR	Zentralstelle Gewerblicher Rechtsschutz (centralized customs authority in Germany)



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