

# PATENTS IN GERMANY AND EUROPE

PROCUREMENT,  
ENFORCEMENT  
AND DEFENSE

An International Handbook

ALEXANDER HARGUTH

with STEVEN CARLSON



Wolters Kluwer

Law & Business

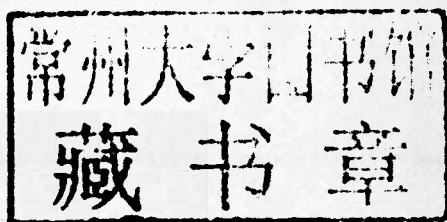
# **Patents in Germany and Europe**

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## **Patents in Germany and Europe**

## Preface

This handbook aims to provide lawyers in the United States and elsewhere in the world with a practical understanding of Germany's patent system. Why Germany? Because Germany itself is one of the most important markets in the world, and because the unique structure of Germany's patent system has made it a top jurisdiction for patent litigation. Enforcing patents in Germany provides important leverage for enforcing patent rights across Europe, and the swift, powerful remedies available in Germany can drive a resolution of disputes worldwide. Suits in Germany frequently resolve well ahead of U.S. counterpart suits, at a fraction of the cost.

This book 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 United States, could be strategically resolved by resort to the swifter, less expensive proceedings in Germany. Because of the substantive legal differences between the U.S. and Germany, many patent cases which could prove problematic in the U.S. can achieve a successful result in Germany. And the unique aspects of patent practice in Germany, such as the separation of infringement and validity cases, and the availability of utility models as a distinct form of intellectual property, offer surprising options without parallel in the United States. Understanding the opportunities available in Germany provides companies with a broader toolkit for enforcing their intellectual property, and defending against challenges brought by others.

This handbook is intended to put the German patent system 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 United States. The chapters track the structure of patent disputes, generally, starting with the overall structure of the German judicial system, followed by topics such as patentability, patent procurement, oppositions, infringement trials, and

## *Preface*

customs enforcement actions. The book concludes with extensive form and legislative material, including previously untranslated material. Thus, 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. Alexander Harguth is a Principal in the Munich office of Fish & Richardson. Mr. Harguth's understanding of the German system arises from 15 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 United States and is a principal in Fish & Richardson's Silicon Valley office. Together, they have endeavored to present the German patent system in an understandable, practical format for counsel in the United States and around the world.

The authors are grateful for the assistance of many others in bringing this work to fruition. In particular, they would like to thank David Maizenberg for dedicated and persistent review. And many thanks to the following attorneys at Fish & Richardson who have provided valuable feedback and comment: Frank Peterreins, Marcus Coehn, Hans Troesch, John Pegram, Adam Steinert and Leeron Kalay.

## List of Abbreviations

ArbEG	Arbeitnehmererfindergesetz (Act on Employees' Inventions)
BGBI	Bundesgesetzblatt (Federal Law Gazette)
BGHZ	Entscheidungen des Bundesgerichtshofs in Zivilsachen (Compilation of decisions of the Federal Supreme Court in civil matters)
BIPMZ	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

## *List of Abbreviations*

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
USPTO	U.S. Patent and Trademark Office
WIPO	World Intellectual Property Organization
WO-ISA	Written Opinion of the International Search Authority
ZPO	Zivilprozessordnung (Code of Civil Procedure)
ZGR	Zentralstelle Gewerblicher Rechtsschutz (centralised customs authority in Germany)



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