

Industrial Property

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INTERNATIONAL UNIONS

Paris Convention for the Protection of Industrial Property

of March 20, 1883,

as revised

at BRUSSELS on December 14, 1900, at WASHINGTON on June 2, 1911,
at THE HAGUE on November 6, 1925, at LONDON on June 2, 1934,
at LISBON on October 31, 1958,
and at STOCKHOLM on July 14, 1967

Official English Text

Article 1

[Establishment of the Union; Scope of Industrial Property]¹⁾

(1) The countries to which this Convention applies constitute a Union for the protection of industrial property.

(2) The protection of industrial property has as its object patents, utility models, industrial designs, trademarks, service marks, trade names, indications of source or appellations of origin, and the repression of unfair competition.

(3) Industrial property shall be understood in the broadest sense and shall apply not only to industry and commerce proper, but likewise to agricultural and extractive industries and to all manufactured or natural products, for example, wines, grain, tobacco leaf, fruit, cattle, minerals, mineral waters, beer, flowers, and flour.

(4) Patents shall include the various kinds of industrial patents recognized by the laws of the countries of the Union, such as patents of importation, patents of improvement, patents and certificates of addition, etc.

Article 2

[National Treatment for Nationals of Countries of the Union]

(1) Nationals of any country of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals; all without prejudice to the rights specially provided for by this Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with.

(2) However, no requirement as to domicile or establishment in the country where protection is claimed may be imposed upon nationals of countries of the Union for the enjoyment of any industrial property rights.

(3) The provisions of the laws of each of the countries of the Union relating to judicial and administrative procedure and to jurisdiction, and to the designation of an address for service or the appointment of an agent, which may be re-

quired by the laws on industrial property are expressly reserved.

Article 3

[Same Treatment for Certain Categories of Persons as for Nationals of Countries of the Union]

Nationals of countries outside the Union who are domiciled or who have real and effective industrial or commercial establishments in the territory of one of the countries of the Union shall be treated in the same manner as nationals of the countries of the Union.

Article 4

[A to I. Patents, Utility Models, Industrial Designs, Marks, Inventors' Certificates: Right of Priority. — G. Patents: Division of the Application]

A. — (1) Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

(2) Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognized as giving rise to the right of priority.

(3) By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application.

B. — Consequently, any subsequent filing in any of the other countries of the Union before the expiration of the periods referred to above shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, the putting on sale of copies of the design, or the use of the mark, and such acts cannot give rise to any third-party right or any right of personal possession. Rights acquired by third parties before the date of the first application that serves as the basis for the right of priority are reserved in accordance with the domestic legislation of each country of the Union.

C. — (1) The periods of priority referred to above shall be twelve months for patents and utility models, and six months for industrial designs and trademarks.

(2) These periods shall start from the date of filing of the first application; the day of filing shall not be included in the period.

(3) If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.

(4) A subsequent application concerning the same subject as a previous first application within the meaning of paragraph (2), above, filed in the same country of the Union, shall be considered as the first application, of which the filing date shall be the starting point of the period of priority, if,

¹⁾ Articles have been given titles to facilitate their identification. There are no titles in the signed (French) text.

at the time of filing the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

D. — (1) Any person desiring to take advantage of the priority of a previous filing shall be required to make a declaration indicating the date of such filing and the country in which it was made. Each country shall determine the latest date on which such declaration must be made.

(2) These particulars shall be mentioned in the publications issued by the competent authority, and in particular in the patents and the specifications relating thereto.

(3) The countries of the Union may require any person making a declaration of priority to produce a copy of the application (description, drawings, etc.) previously filed. The copy, certified as correct by the authority which received such application, shall not require any authentication, and may in any case be filed, without fee, at any time within three months of the filing of the subsequent application. They may require it to be accompanied by a certificate from the same authority showing the date of filing, and by a translation.

(4) No other formalities may be required for the declaration of priority at the time of filing the application. Each country of the Union shall determine the consequences of failure to comply with the formalities prescribed by this Article, but such consequences shall in no case go beyond the loss of the right of priority.

(5) Subsequently, further proof may be required.

Any person who avails himself of the priority of a previous application shall be required to specify the number of that application; this number shall be published as provided for by paragraph (2), above.

E. — (1) Where an industrial design is filed in a country by virtue of a right of priority based on the filing of a utility model, the period of priority shall be the same as that fixed for industrial designs.

(2) Furthermore, it is permissible to file a utility model in a country by virtue of a right of priority based on the filing of a patent application, and vice versa.

F. — No country of the Union may refuse a priority or a patent application on the ground that the applicant claims multiple priorities, even if they originate in different countries, or on the ground that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed, provided that, in both cases, there is unity of invention within the meaning of the law of the country.

With respect to the elements not included in the application or applications whose priority is claimed, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions.

G. — (1) If the examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.

(2) The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized.

H. — Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that the application documents as a whole specifically disclose such elements.

I. — (1) Applications for inventors' certificates filed in a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate shall give rise to the right of priority provided for by this Article, under the same conditions and with the same effects as applications for patents.

(2) In a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate, an applicant for an inventor's certificate shall, in accordance with the provisions of this Article relating to patent applications, enjoy a right of priority based on an application for a patent, a utility model, or an inventor's certificate.

Article 4^{bis}

[*Patents: Independence of Patents Obtained for the Same Invention in Different Countries*]

(1) Patents applied for in the various countries of the Union by nationals of countries of the Union shall be independent of patents obtained for the same invention in other countries, whether members of the Union or not.

(2) The foregoing provision is to be understood in an unrestricted sense, in particular, in the sense that patents applied for during the period of priority are independent, both as regards the grounds for nullity and forfeiture, and as regards their normal duration.

(3) The provision shall apply to all patents existing at the time when it comes into effect.

(4) Similarly, it shall apply, in the case of the accession of new countries, to patents in existence on either side at the time of accession.

(5) Patents obtained with the benefit of priority shall, in the various countries of the Union, have a duration equal to that which they would have, had they been applied for or granted without the benefit of priority.

Article 4^{ter}

[*Patents: Mention of the Inventor in the Patent*]

The inventor shall have the right to be mentioned as such in the patent.

Article 4^{quarter}

[*Patents: Patentability in Case of Restrictions of Sale by Law*]

The grant of a patent shall not be refused and a patent shall not be invalidated on the ground that the sale of the patented product or of a product obtained by means of a patented process is subject to restrictions or limitations resulting from the domestic law.

Article 5

[*A. Patents: Importation of Articles; Failure to Work or Insufficient Working; Compulsory Licenses. — B. Industrial Designs: Failure to Work; Importation of Articles. — C. Marks: Failure to Use; Different Forms; Use by Co-proprietors. — D. Patents, Utility Models, Marks, Industrial Designs: Marking*]

A. — (1) Importation by the patentee into the country where the patent has been granted of articles manufactured in any of the countries of the Union shall not entail forfeiture of the patent.

(2) Each country of the Union shall have the right to take legislative measures providing for the grant of compulsory licenses to prevent the abuses which might result from the exercise of the exclusive rights conferred by the patent, for example, failure to work.

(3) Forfeiture of the patent shall not be provided for except in cases where the grant of compulsory licenses would not have been sufficient to prevent the said abuses. No proceedings for the forfeiture or revocation of a patent may be instituted before the expiration of two years from the grant of the first compulsory license.

(4) A compulsory license may not be applied for on the ground of failure to work or insufficient working before the expiration of a period of four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever period expires last; it shall be refused if the patentee justifies his inaction by legitimate reasons. Such a compulsory license shall be non-exclusive and shall not be transferable, even in the form of the grant of a sub-license, except with that part of the enterprise or goodwill which exploits such license.

(5) The foregoing provisions shall be applicable, *mutatis mutandis*, to utility models.

B. — The protection of industrial designs shall not, under any circumstance, be subject to any forfeiture, either by reason of failure to work or by reason of the importation of articles corresponding to those which are protected.

C. — (1) If, in any country, use of the registered mark is compulsory, the registration may be cancelled only after a reasonable period, and then only if the person concerned does not justify his inaction.

(2) Use of a trademark by the proprietor in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered in one of the countries of the Union shall not entail invalidation of the registration and shall not diminish the protection granted to the mark.

(3) Concurrent use of the same mark on identical or similar goods by industrial or commercial establishments considered as co-proprietors of the mark according to the provisions of the domestic law of the country where protection is claimed shall not prevent registration or diminish in any way the protection granted to the said mark in any country of the Union, provided that such use does not result in misleading the public and is not contrary to the public interest.

D. — No indication or mention of the patent, of the utility model, of the registration of the trademark, or of the deposit of the industrial design, shall be required upon the goods as a condition of recognition of the right to protection.

Article 5^{bis}

[*All Industrial Property Rights: Period of Grace for the Payment of Fees for the Maintenance of Rights; Patents: Restoration*]

(1) A period of grace of not less than six months shall be allowed for the payment of the fees prescribed for the maintenance of industrial property rights, subject, if the domestic legislation so provides, to the payment of a surcharge.

(2) The countries of the Union shall have the right to provide for the restoration of patents which have lapsed by reason of non-payment of fees.

Article 5^{ter}

[*Patents: Patented Devices Forming Part of Vessels, Aircraft, or Land Vehicles*]

In any country of the Union the following shall not be considered as infringements of the rights of a patentee:

1. the use on board vessels of other countries of the Union of devices forming the subject of his patent in the body of the vessel, in the machinery, tackle, gear and other accessories, when such vessels temporarily or accidentally enter the waters of the said country, provided that such devices are used there exclusively for the needs of the vessel;
2. the use of devices forming the subject of the patent in the construction or operation of aircraft or land vehicles of other countries of the Union, or of accessories of such aircraft or land vehicles, when those aircraft or land vehicles temporarily or accidentally enter the said country.

Article 5^{quarter}

[*Patents: Importation of Products Manufactured by a Process Patented in the Importing Country*]

When a product is imported into a country of the Union where there exists a patent protecting a process of manufacture of the said product, the patentee shall have all the rights, with regard to the imported product, that are accorded to him by the legislation of the country of importation, on the basis of the process patent, with respect to products manufactured in that country.

Article 5^{quinquies}

[*Industrial Designs*]

Industrial designs shall be protected in all the countries of the Union.

Article 6

[Marks: Conditions of Registration; Independence of Protection of Same Mark in Different Countries]

(1) The conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation.

(2) However, an application for the registration of a mark filed by a national of a country of the Union in any country of the Union may not be refused, nor may a registration be invalidated, on the ground that filing, registration, or renewal, has not been effected in the country of origin.

(3) A mark duly registered in a country of the Union shall be regarded as independent of marks registered in the other countries of the Union, including the country of origin.

Article 6^{bis}

[Marks: Well-Known Marks]

(1) The countries of the Union undertake, *ex officio* if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

(2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.

(3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith.

Article 6^{ter}

[Marks: Prohibitions concerning State Emblems, Official Hallmarks, and Emblems of Intergovernmental Organizations]

(1) (a) The countries of the Union agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.

(b) The provisions of subparagraph (a), above, shall apply equally to armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations of which one or more countries of the Union are members, with the exception of armorial bearings, flags, other emblems, abbreviations, and names, that are already the subject of international agreements in force, intended to ensure their protection.

(c) No country of the Union shall be required to apply the provisions of subparagraph (b), above, to the prejudice

of the owners of rights acquired in good faith before the entry into force, in that country, of this Convention. The countries of the Union shall not be required to apply the said provisions when the use or registration referred to in subparagraph (a), above, is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations, and names, or if such use or registration is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization.

(2) Prohibition of the use of official signs and hallmarks indicating control and warranty shall apply solely in cases where the marks in which they are incorporated are intended to be used on goods of the same or a similar kind.

(3) (a) For the application of these provisions, the countries of the Union agree to communicate reciprocally, through the intermediary of the International Bureau, the list of State emblems, and official signs and hallmarks indicating control and warranty, which they desire, or may hereafter desire, to place wholly or within certain limits under the protection of this Article, and all subsequent modifications of such list. Each country of the Union shall in due course make available to the public the lists so communicated.

Nevertheless such communication is not obligatory in respect of flags of States.

(b) The provisions of subparagraph (b) of paragraph (1) of this Article shall apply only to such armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations as the latter have communicated to the countries of the Union through the intermediary of the International Bureau.

(4) Any country of the Union may, within a period of twelve months from the receipt of the notification, transmit its objections, if any, through the intermediary of the International Bureau, to the country or international intergovernmental organization concerned.

(5) In the case of State flags, the measures prescribed by paragraph (1), above, shall apply solely to marks registered after November 6, 1925.

(6) In the case of State emblems other than flags, and of official signs and hallmarks of the countries of the Union, and in the case of armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations, these provisions shall apply only to marks registered more than two months after receipt of the communication provided for in paragraph (3), above.

(7) In cases of bad faith, the countries shall have the right to cancel even those marks incorporating State emblems, signs, and hallmarks, which were registered before November 6, 1925.

(8) Nationals of any country who are authorized to make use of the State emblems, signs, and hallmarks, of their country may use them even if they are similar to those of another country.

(9) The countries of the Union undertake to prohibit the unauthorized use in trade of the State armorial bearings of

the other countries of the Union, when the use is of such a nature as to be misleading as to the origin of the goods.

(10) The above provisions shall not prevent the countries from exercising the right given in paragraph (3) of Article 6^{quinquies}, Section B, to refuse or to invalidate the registration of marks incorporating, without authorization, armorial bearings, flags, other State emblems, or official signs and hallmarks adopted by a country of the Union, as well as the distinctive signs of international intergovernmental organizations referred to in paragraph (1), above.

Article 6^{quater}

[Marks: Assignment of Marks]

(1) When, in accordance with the law of a country of the Union, the assignment of a mark is valid only if it takes place at the same time as the transfer of the business or goodwill to which the mark belongs, it shall suffice for the recognition of such validity that the portion of the business or goodwill located in that country be transferred to the assignee, together with the exclusive right to manufacture in the said country, or to sell therein, the goods bearing the mark assigned.

(2) The foregoing provision does not impose upon the countries of the Union any obligation to regard as valid the assignment of any mark the use of which by the assignee would, in fact, be of such a nature as to mislead the public, particularly as regards the origin, nature, or essential qualities, of the goods to which the mark is applied.

Article 6^{quinquies}

[Marks: Protection of Marks Registered in One Country of the Union in the Other Countries of the Union]

A. — (1) Every trademark duly registered in the country of origin shall be accepted for filing and protected as is in the other countries of the Union, subject to the reservations indicated in this Article. Such countries may, before proceeding to final registration, require the production of a certificate of registration in the country of origin, issued by the competent authority. No authentication shall be required for this certificate.

(2) Shall be considered the country of origin the country of the Union where the applicant has a real and effective industrial or commercial establishment, or, if he has no such establishment within the Union, the country of the Union where he has his domicile, or, if he has no domicile within the Union but is a national of a country of the Union, the country of which he is a national.

B. — Trademarks covered by this Article may be neither denied registration nor invalidated except in the following cases:

1. when they are of such a nature as to infringe rights acquired by third parties in the country where protection is claimed;
2. when they are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods,

or the time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed;

3. when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public. It is understood that a mark may not be considered contrary to public order for the sole reason that it does not conform to a provision of the legislation on marks, except if such provision itself relates to public order.

This provision is subject, however, to the application of Article 10^{bis}.

C. — (1) In determining whether a mark is eligible for protection, all the factual circumstances must be taken into consideration, particularly the length of time the mark has been in use.

(2) No trademark shall be refused in the other countries of the Union for the sole reason that it differs from the mark protected in the country of origin only in respect of elements that do not alter its distinctive character and do not affect its identity in the form in which it has been registered in the said country of origin.

D. — No person may benefit from the provisions of this Article if the mark for which he claims protection is not registered in the country of origin.

E. — However, in no case shall the renewal of the registration of the mark in the country of origin involve an obligation to renew the registration in the other countries of the Union in which the mark has been registered.

F. — The benefit of priority shall remain unaffected for applications for the registration of marks filed within the period fixed by Article 4, even if registration in the country of origin is effected after the expiration of such period.

Article 6^{sexies}

[Marks: Service Marks]

The countries of the Union undertake to protect service marks. They shall not be required to provide for the registration of such marks.

Article 6^{septies}

[Marks: Registration in the Name of the Agent or Representative of the Proprietor Without the Latter's Authorization]

(1) If the agent or representative of the person who is the proprietor of a mark in one of the countries of the Union applies, without such proprietor's authorization, for the registration of the mark in his own name, in one or more countries of the Union, the proprietor shall be entitled to oppose the registration applied for or demand its cancellation or, if the law of the country so allows, the assignment in his favor of the said registration, unless such agent or representative justifies his action.

(2) The proprietor of the mark shall, subject to the provisions of paragraph (1), above, be entitled to oppose the use of his mark by his agent or representative if he has not authorized such use.

(3) Domestic legislation may provide an equitable time limit within which the proprietor of a mark must exercise the rights provided for in this Article.

Article 7

[Marks: Nature of the Goods to which the Mark is Applied] _____

The nature of the goods to which a trademark is to be applied shall in no case form an obstacle to the registration of the mark.

Article 7^{bis}

[Marks: Collective Marks]

(1) The countries of the Union undertake to accept for filing and to protect collective marks belonging to associations the existence of which is not contrary to the law of the country of origin, even if such associations do not possess an industrial or commercial establishment.

(2) Each country shall be the judge of the particular conditions under which a collective mark shall be protected and may refuse protection if the mark is contrary to the public interest.

(3) Nevertheless, the protection of these marks shall not be refused to any association the existence of which is not contrary to the law of the country of origin, on the ground that such association is not established in the country where protection is sought or is not constituted according to the law of the latter country.

Article 8

[Trade Names]

A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark.

Article 9

[Marks, Trade Names: Seizure, on Importation, etc., of Goods Unlawfully Bearing a Mark or Trade Name]

(1) All goods unlawfully bearing a trademark or trade name shall be seized on importation into those countries of the Union where such mark or trade name is entitled to legal protection.

(2) Seizure shall likewise be effected in the country where the unlawful affixation occurred or in the country into which the goods were imported.

(3) Seizure shall take place at the request of the public prosecutor, or any other competent authority, or any interested party, whether a natural person or a legal entity, in conformity with the domestic legislation of each country.

(4) The authorities shall not be bound to effect seizure of goods in transit.

(5) If the legislation of a country does not permit seizure on importation, seizure shall be replaced by prohibition of importation or by seizure inside the country.

(6) If the legislation of a country permits neither seizure on importation nor prohibition of importation nor seizure inside the country, then, until such time as the legislation is

modified accordingly, these measures shall be replaced by the actions and remedies available in such cases to nationals under the law of such country.

Article 10

[False Indications: Seizure, on Importation, etc., of Goods Bearing False Indications as to their Source or the Identity of the Producer]

(1) The provisions of the preceding Article shall apply in cases of direct or indirect use of a false indication of the source of the goods or the identity of the producer, manufacturer, or merchant.

(2) Any producer, manufacturer, or merchant, whether a natural person or a legal entity, engaged in the production or manufacture of or trade in such goods and established either in the locality falsely indicated as the source, or in the region where such locality is situated, or in the country falsely indicated, or in the country where the false indication of source is used, shall in any case be deemed an interested party.

Article 10^{bis}

[Unfair Competition]

(1) The countries of the Union are bound to assure to nationals of such countries effective protection against unfair competition.

(2) Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition.

(3) The following in particular shall be prohibited:

1. all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor;
2. false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor;
3. indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.

Article 10^{ter}

[Marks, Trade Names, False Indications, Unfair Competition: Remedies, Right to Sue]

(1) The countries of the Union undertake to assure to nationals of the other countries of the Union appropriate legal remedies effectively to repress all the acts referred to in Articles 9, 10, and 10^{bis}.

(2) They undertake, further, to provide measures to permit federations and associations representing interested industrialists, producers, or merchants, provided that the existence of such federations and associations is not contrary to the laws of their countries, to take action in the courts or before the administrative authorities, with a view to the repression of the acts referred to in Articles 9, 10, and 10^{bis}, in so far as the law of the country in which protection is claimed allows such action by federations and associations of that country.

Article 11

[*Inventions, Utility Models, Industrial Designs, Marks: Temporary Protection at Certain International Exhibitions*]

(1) The countries of the Union shall, in conformity with their domestic legislation, grant temporary protection to patentable inventions, utility models, industrial designs, and trademarks, in respect of goods exhibited at official or officially recognized international exhibitions held in the territory of any of them.

(2) Such temporary protection shall not extend the periods provided by Article 4. If, later, the right of priority is invoked, the authorities of any country may provide that the period shall start from the date of introduction of the goods into the exhibition.

(3) Each country may require, as proof of the identity of the article exhibited and of the date of its introduction, such documentary evidence as it considers necessary.

Article 12

[*Special National Industrial Property Services*]

(1) Each country of the Union undertakes to establish a special industrial property service and a central office for the communication to the public of patents, utility models, industrial designs, and trademarks.

(2) This service shall publish an official periodical journal. It shall publish regularly:

- (a) the names of the proprietors of patents granted, with a brief designation of the inventions patented;
- (b) the reproductions of registered trademarks.

Article 13

[*Assembly of the Union*]

(1) (a) The Union shall have an Assembly consisting of those countries of the Union which are bound by Articles 13 to 17.

(b) The Government of each country shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.

(c) The expenses of each delegation shall be borne by the Government which has appointed it.

(2) (a) The Assembly shall:

- (i) deal with all matters concerning the maintenance and development of the Union and the implementation of this Convention;
- (ii) give directions concerning the preparation for conferences of revision to the International Bureau of Intellectual Property (hereinafter designated as "the International Bureau") referred to in the Convention establishing the World Intellectual Property Organization (hereinafter designated as "the Organization"), due account being taken of any comments made by those countries of the Union which are not bound by Articles 13 to 17;
- (iii) review and approve the reports and activities of the Director General of the Organization concerning the Union, and give him all necessary instructions concerning matters within the competence of the Union;

- (iv) elect the members of the Executive Committee of the Assembly;
- (v) review and approve the reports and activities of its Executive Committee, and give instructions to such Committee;
- (vi) determine the program and adopt the triennial budget of the Union, and approve its final accounts;
- (vii) adopt the financial regulations of the Union;
- (viii) establish such committees of experts and working groups as it deems appropriate to achieve the objectives of the Union;
- (ix) determine which countries not members of the Union and which intergovernmental and international non-governmental organizations shall be admitted to its meetings as observers;
- (x) adopt amendments to Articles 13 to 17;
- (xi) take any other appropriate action designed to further the objectives of the Union;
- (xii) perform such other functions as are appropriate under this Convention;
- (xiii) subject to its acceptance, exercise such rights as are given to it in the Convention establishing the Organization.

(b) With respect to matters which are of interest also to other Unions administered by the Organization, the Assembly shall make its decisions after having heard the advice of the Coordination Committee of the Organization.

(3) (a) Subject to the provisions of subparagraph (b), a delegate may represent one country only.

(b) Countries of the Union grouped under the terms of a special agreement in a common office possessing for each of them the character of a special national service of industrial property as referred to in Article 12 may be jointly represented during discussions by one of their number.

(4) (a) Each country member of the Assembly shall have one vote.

(b) One-half of the countries members of the Assembly shall constitute a quorum.

(c) Notwithstanding the provisions of subparagraph (b), if, in any session, the number of countries represented is less than one-half but equal to or more than one-third of the countries members of the Assembly, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the conditions set forth hereinafter are fulfilled. The International Bureau shall communicate the said decisions to the countries members of the Assembly which were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiration of this period, the number of countries having thus expressed their vote or abstention attains the number of countries which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains.

(d) Subject to the provisions of Article 17(2), the decisions of the Assembly shall require two-thirds of the votes cast.

(e) Abstentions shall not be considered as votes.

(5) (a) Subject to the provisions of subparagraph (b), a delegate may vote in the name of one country only.

(b) The countries of the Union referred to in paragraph (3)(b) shall, as a general rule, endeavor to send their own delegations to the sessions of the Assembly. If, however, for exceptional reasons, any such country cannot send its own delegation, it may give to the delegation of another such country the power to vote in its name, provided that each delegation may vote by proxy for one country only. Such power to vote shall be granted in a document signed by the Head of State or the competent Minister.

(6) Countries of the Union not members of the Assembly shall be admitted to the meetings of the latter as observers.

(7) (a) The Assembly shall meet once in every third calendar year in ordinary session upon convocation by the Director General and, in the absence of exceptional circumstances, during the same period and at the same place as the General Assembly of the Organization.

(b) The Assembly shall meet in extraordinary session upon convocation by the Director General, at the request of the Executive Committee or at the request of one-fourth of the countries members of the Assembly.

(8) The Assembly shall adopt its own rules of procedure.

Article 14

[Executive Committee]

(1) The Assembly shall have an Executive Committee.

(2) (a) The Executive Committee shall consist of countries elected by the Assembly from among countries members of the Assembly. Furthermore, the country on whose territory the Organization has its headquarters shall, subject to the provisions of Article 16(7)(b), have an ex officio seat on the Committee.

(b) The Government of each country member of the Executive Committee shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.

(c) The expenses of each delegation shall be borne by the Government which has appointed it.

(3) The number of countries members of the Executive Committee shall correspond to one-fourth of the number of countries members of the Assembly. In establishing the number of seats to be filled, remainders after division by four shall be disregarded.

(4) In electing the members of the Executive Committee, the Assembly shall have due regard to an equitable geographical distribution and to the need for countries party to the Special Agreements established in relation with the Union to be among the countries constituting the Executive Committee.

(5) (a) Each member of the Executive Committee shall serve from the close of the session of the Assembly which elected it to the close of the next ordinary session of the Assembly.

(b) Members of the Executive Committee may be re-elected, but only up to a maximum of two-thirds of such members.

(c) The Assembly shall establish the details of the rules governing the election and possible re-election of the members of the Executive Committee.

(6) (a) The Executive Committee shall:

- (i) prepare the draft agenda of the Assembly;
- (ii) submit proposals to the Assembly in respect of the draft program and triennial budget of the Union prepared by the Director General;
- (iii) approve, within the limits of the program and the triennial budget, the specific yearly budgets and programs prepared by the Director General;
- (iv) submit, with appropriate comments, to the Assembly the periodical reports of the Director General and the yearly audit reports on the accounts;
- (v) take all necessary measures to ensure the execution of the program of the Union by the Director General, in accordance with the decisions of the Assembly and having regard to circumstances arising between two ordinary sessions of the Assembly;
- (vi) perform such other functions as are allocated to it under this Convention.

(b) With respect to matters which are of interest also to other Unions administered by the Organization, the Executive Committee shall make its decisions after having heard the advice of the Coordination Committee of the Organization.

(7) (a) The Executive Committee shall meet once a year in ordinary session upon convocation by the Director General, preferably during the same period and at the same place as the Coordination Committee of the Organization.

(b) The Executive Committee shall meet in extraordinary session upon convocation by the Director General, either on his own initiative, or at the request of its Chairman or one-fourth of its members.

(8) (a) Each country member of the Executive Committee shall have one vote.

(b) One-half of the members of the Executive Committee shall constitute a quorum.

(c) Decisions shall be made by a simple majority of the votes cast.

(d) Abstentions shall not be considered as votes.

(e) A delegate may represent, and vote in the name of, one country only.

(9) Countries of the Union not members of the Executive Committee shall be admitted to its meetings as observers.

(10) The Executive Committee shall adopt its own rules of procedure.

Article 15

[International Bureau]

(1) (a) Administrative tasks concerning the Union shall be performed by the International Bureau, which is a continuation of the Bureau of the Union united with the Bureau of the Union established by the International Convention for the Protection of Literary and Artistic Works.

(b) In particular, the International Bureau shall provide the secretariat of the various organs of the Union.

(c) The Director General of the Organization shall be the chief executive of the Union and shall represent the Union.

(2) The International Bureau shall assemble and publish information concerning the protection of industrial property. Each country of the Union shall promptly communicate to the

International Bureau all new laws and official texts concerning the protection of industrial property. Furthermore, it shall furnish the International Bureau with all the publications of its industrial property service of direct concern to the protection of industrial property which the International Bureau may find useful in its work.

(3) The International Bureau shall publish a monthly periodical.

(4) The International Bureau shall, on request, furnish any country of the Union with information on matters concerning the protection of industrial property.

(5) The International Bureau shall conduct studies, and shall provide services, designed to facilitate the protection of industrial property.

(6) The Director General and any staff member designated by him shall participate, without the right to vote, in all meetings of the Assembly, the Executive Committee, and any other committee of experts or working group. The Director General, or a staff member designated by him, shall be *ex officio* secretary of these bodies.

(7) (a) The International Bureau shall, in accordance with the directions of the Assembly and in cooperation with the Executive Committee, make the preparations for the conferences of revision of the provisions of the Convention other than Articles 13 to 17.

(b) The International Bureau may consult with intergovernmental and international non-governmental organizations concerning preparations for conferences of revision.

(c) The Director General and persons designated by him shall take part, without the right to vote, in the discussions at these conferences.

(8) The International Bureau shall carry out any other tasks assigned to it.

Article 16

[Finances]

(1) (a) The Union shall have a budget.

(b) The budget of the Union shall include the income and expenses proper to the Union, its contribution to the budget of expenses common to the Unions, and, where applicable, the sum made available to the budget of the Conference of the Organization.

(c) Expenses not attributable exclusively to the Union but also to one or more other Unions administered by the Organization shall be considered as expenses common to the Unions. The share of the Union in such common expenses shall be in proportion to the interest the Union has in them.

(2) The budget of the Union shall be established with due regard to the requirements of coordination with the budgets of the other Unions administered by the Organization.

(3) The budget of the Union shall be financed from the following sources:

- (i) contributions of the countries of the Union;
- (ii) fees and charges due for services rendered by the International Bureau in relation to the Union;

(iii) sale of, or royalties on, the publications of the International Bureau concerning the Union;

(iv) gifts, bequests, and subventions;

(v) rents, interests, and other miscellaneous income.

(4) (a) For the purpose of establishing its contribution towards the budget, each country of the Union shall belong to a class, and shall pay its annual contributions on the basis of a number of units fixed as follows:

Class I	25
Class II	20
Class III	15
Class IV	10
Class V	5
Class VI	3
Class VII	1

(b) Unless it has already done so, each country shall indicate, concurrently with depositing its instrument of ratification or accession, the class to which it wishes to belong. Any country may change class. If it chooses a lower class, the country must announce such change to the Assembly at one of its ordinary sessions. Any such change shall take effect at the beginning of the calendar year following the said session.

(c) The annual contribution of each country shall be an amount in the same proportion to the total sum to be contributed to the budget of the Union by all countries as the number of its units is to the total of the units of all contributing countries.

(d) Contributions shall become due on the first of January of each year.

(e) A country which is in arrears in the payment of its contributions may not exercise its right to vote in any of the organs of the Union of which it is a member if the amount of its arrears equals or exceeds the amount of the contributions due from it for the preceding two full years. However, any organ of the Union may allow such a country to continue to exercise its right to vote in that organ if, and as long as, it is satisfied that the delay in payment is due to exceptional and unavoidable circumstances.

(f) If the budget is not adopted before the beginning of a new financial period, it shall be at the same level as the budget of the previous year, as provided in the financial regulations.

(5) The amount of the fees and charges due for services rendered by the International Bureau in relation to the Union shall be established, and shall be reported to the Assembly and the Executive Committee, by the Director General.

(6) (a) The Union shall have a working capital fund which shall be constituted by a single payment made by each country of the Union. If the fund becomes insufficient, the Assembly shall decide to increase it.

(b) The amount of the initial payment of each country to the said fund or of its participation in the increase thereof shall be a proportion of the contribution of that country for the year in which the fund is established or the decision to increase it is made.

(c) The proportion and the terms of payment shall be fixed by the Assembly on the proposal of the Director General and after it has heard the advice of the Coordination Committee of the Organization.

(7) (a) In the headquarters agreement concluded with the country on the territory of which the Organization has its headquarters, it shall be provided that, whenever the working capital fund is insufficient, such country shall grant advances. The amount of these advances and the conditions on which they are granted shall be the subject of separate agreements, in each case, between such country and the Organization. As long as it remains under the obligation to grant advances, such country shall have an ex officio seat on the Executive Committee.

(b) The country referred to in subparagraph (a) and the Organization shall each have the right to denounce the obligation to grant advances, by written notification. Denunciation shall take effect three years after the end of the year in which it has been notified.

(8) The auditing of the accounts shall be effected by one or more of the countries of the Union or by external auditors, as provided in the financial regulations. They shall be designated, with their agreement, by the Assembly.

Article 17

[Amendment of Articles 13 to 17]

(1) Proposals for the amendment of Articles 13, 14, 15, 16, and the present Article, may be initiated by any country member of the Assembly, by the Executive Committee, or by the Director General. Such proposals shall be communicated by the Director General to the member countries of the Assembly at least six months in advance of their consideration by the Assembly.

(2) Amendments to the Articles referred to in paragraph (1) shall be adopted by the Assembly. Adoption shall require three-fourths of the votes cast, provided that any amendment to Article 13, and to the present paragraph, shall require four-fifths of the votes cast.

(3) Any amendment to the Articles referred to in paragraph (1) shall enter into force one month after written notifications of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director General from three-fourths of the countries members of the Assembly at the time it adopted the amendment. Any amendment to the said Articles thus accepted shall bind all the countries which are members of the Assembly at the time the amendment enters into force, or which become members thereof at a subsequent date, provided that any amendment increasing the financial obligations of countries of the Union shall bind only those countries which have notified their acceptance of such amendment.

Article 18

[Revision of Articles 1 to 12 and 18 to 30]

(1) This Convention shall be submitted to revision with a view to the introduction of amendments designed to improve the system of the Union.

(2) For that purpose, conferences shall be held successively in one of the countries of the Union among the delegates of the said countries.

(3) Amendments to Articles 13 to 17 are governed by the provisions of Article 17.

Article 19

[Special Agreements]

It is understood that the countries of the Union reserve the right to make separately between themselves special agreements for the protection of industrial property, in so far as these agreements do not contravene the provisions of this Convention.

Article 20

[Ratification or Accession by Countries of the Union; Entry Into Force]

(1) (a) Any country of the Union which has signed this Act may ratify it, and, if it has not signed it, may accede to it. Instruments of ratification and accession shall be deposited with the Director General.

(b) Any country of the Union may declare in its instrument of ratification or accession that its ratification or accession shall not apply:

- (i) to Articles 1 to 12, or
- (ii) to Articles 13 to 17.

(c) Any country of the Union which, in accordance with subparagraph (b), has excluded from the effects of its ratification or accession one of the two groups of Articles referred to in that subparagraph may at any later time declare that it extends the effects of its ratification or accession to that group of Articles. Such declaration shall be deposited with the Director General.

(2) (a) Articles 1 to 12 shall enter into force, with respect to the first ten countries of the Union which have deposited instruments of ratification or accession without making the declaration permitted under paragraph (1)(b)(i), three months after the deposit of the tenth such instrument of ratification or accession.

(b) Articles 13 to 17 shall enter into force, with respect to the first ten countries of the Union which have deposited instruments of ratification or accession without making the declaration permitted under paragraph (1)(b)(ii), three months after the deposit of the tenth such instrument of ratification or accession.

(c) Subject to the initial entry into force, pursuant to the provisions of subparagraphs (a) and (b), of each of the two groups of Articles referred to in paragraph (1)(b)(i) and (ii), and subject to the provisions of paragraph (1)(b), Articles 1 to 17 shall, with respect to any country of the Union, other than those referred to in subparagraphs (a) and (b), which deposits an instrument of ratification or accession or any country of the Union which deposits a declaration pursuant to paragraph (1)(c), enter into force three months after the date of notification by the Director General of such deposit, unless a subsequent date has been indicated in the instrument or declaration deposited. In the latter case, this Act shall enter into force with respect to that country on the date thus indicated.

(3) With respect to any country of the Union which deposits an instrument of ratification or accession, Articles 18 to 30 shall enter into force on the earlier of the dates on which any of the groups of Articles referred to in paragraph (1)(b) enters into force with respect to that country pursuant to paragraph (2)(a), (b), or (c).

Article 21

[Accession by Countries Outside the Union; Entry Into Force]

(1) Any country outside the Union may accede to this Act and thereby become a member of the Union. Instruments of accession shall be deposited with the Director General.

(2) (a) With respect to any country outside the Union which deposits its instrument of accession one month or more before the date of entry into force of any provisions of the present Act, this Act shall enter into force, unless a subsequent date has been indicated in the instrument of accession, on the date upon which provisions first enter into force pursuant to Article 20(2) (a) or (b); provided that:

- (i) if Articles 1 to 12 do not enter into force on that date, such country shall, during the interim period before the entry into force of such provisions, and in substitution therefor, be bound by Articles 1 to 12 of the Lisbon Act,
- (ii) if Articles 13 to 17 do not enter into force on that date, such country shall, during the interim period before the entry into force of such provisions, and in substitution therefor, be bound by Articles 13 and 14(3), (4), and (5), of the Lisbon Act.

If a country indicates a subsequent date in its instrument of accession, this Act shall enter into force with respect to that country on the date thus indicated.

(b) With respect to any country outside the Union which deposits its instrument of accession on a date which is subsequent to, or precedes by less than one month, the entry into force of one group of Articles of the present Act, this Act shall, subject to the proviso of subparagraph (a), enter into force three months after the date on which its accession has been notified by the Director General, unless a subsequent date has been indicated in the instrument of accession. In the latter case, this Act shall enter into force with respect to that country on the date thus indicated.

(3) With respect to any country outside the Union which deposits its instrument of accession after the date of entry into force of the present Act in its entirety, or less than one month before such date, this Act shall enter into force three months after the date on which its accession has been notified by the Director General, unless a subsequent date has been indicated in the instrument of accession. In the latter case, this Act shall enter into force with respect to that country on the date thus indicated.

Article 22

[Consequences of Ratification or Accession]

Subject to the possibilities of exceptions provided for in Articles 20(1)(b) and 28(2), ratification or accession shall automatically entail acceptance of all the clauses and admission to all the advantages of this Act.

Article 23

[Accession to Earlier Acts]

After the entry into force of this Act in its entirety, a country may not accede to earlier Acts of this Convention.

Article 24

[Territories]

(1) Any country may declare in its instrument of ratification or accession, or may inform the Director General by written notification any time thereafter, that this Convention shall be applicable to all or part of those territories, designated in the declaration or notification, for the external relations of which it is responsible.

(2) Any country which has made such a declaration or given such a notification may, at any time, notify the Director General that this Convention shall cease to be applicable to all or part of such territories.

(3) (a) Any declaration made under paragraph (1) shall take effect on the same date as the ratification or accession in the instrument of which it was included, and any notification given under such paragraph shall take effect three months after its notification by the Director General.

(b) Any notification given under paragraph (2) shall take effect twelve months after its receipt by the Director General.

Article 25

[Implementation of the Convention on the Domestic Level]

(1) Any country party to this Convention undertakes to adopt, in accordance with its constitution, the measures necessary to ensure the application of this Convention.

(2) It is understood that, at the time a country deposits its instrument of ratification or accession, it will be in a position under its domestic law to give effect to the provisions of this Convention.

Article 26

[Denunciation]

(1) This Convention shall remain in force without limitation as to time.

(2) Any country may denounce this Act by notification addressed to the Director General. Such denunciation shall constitute also denunciation of all earlier Acts and shall affect only the country making it, the Convention remaining in full force and effect as regards the other countries of the Union.

(3) Denunciation shall take effect one year after the day on which the Director General has received the notification.

(4) The right of denunciation provided by this Article shall not be exercised by any country before the expiration of five years from the date upon which it becomes a member of the Union.

Article 27

[Application of Earlier Acts]

(1) The present Act shall, as regards the relations between the countries to which it applies, and to the extent that it applies, replace the Convention of Paris of March 20, 1883, and the subsequent Acts of revision.

(2) (a) As regards the countries to which the present Act does not apply, or does not apply in its entirety, but to which the Lisbon Act of October 31, 1958, applies, the latter shall remain in force in its entirety or to the extent that the present Act does not replace it by virtue of paragraph (1).

(b) Similarly, as regards the countries to which neither the present Act, nor portions thereof, nor the Lisbon Act applies, the London Act of June 2, 1934, shall remain in force in its entirety or to the extent that the present Act does not replace it by virtue of paragraph (1).

(c) Similarly, as regards the countries to which neither the present Act, nor portions thereof, nor the Lisbon Act, nor the London Act applies, the Hague Act of November 6, 1925, shall remain in force in its entirety or to the extent that the present Act does not replace it by virtue of paragraph (1).

(3) Countries outside the Union which become party to this Act shall apply it with respect to any country of the Union not party to this Act or which, although party to this Act, has made a declaration pursuant to Article 20(1)(b)(i). Such countries recognize that the said country of the Union may apply, in its relations with them, the provisions of the most recent Act to which it is party.

Article 28

[Disputes]

(1) Any dispute between two or more countries of the Union concerning the interpretation or application of this Convention, not settled by negotiation, may, by any one of the countries concerned, be brought before the International Court of Justice by application in conformity with the Statute of the Court, unless the countries concerned agree on some other method of settlement. The country bringing the dispute before the Court shall inform the International Bureau; the International Bureau shall bring the matter to the attention of the other countries of the Union.

(2) Each country may, at the time it signs this Act or deposits its instrument of ratification or accession, declare that it does not consider itself bound by the provisions of paragraph (1). With regard to any dispute between such country and any other country of the Union, the provisions of paragraph (1) shall not apply.

(3) Any country having made a declaration in accordance with the provisions of paragraph (2) may, at any time, withdraw its declaration by notification addressed to the Director General.

Article 29

[Signature, Languages, Depositary Functions]

(1) (a) This Act shall be signed in a single copy in the French language and shall be deposited with the Government of Sweden.

(b) Official texts shall be established by the Director General, after consultation with the interested Governments, in the English, German, Italian, Portuguese, Russian and Spanish languages, and such other languages as the Assembly may designate.

(c) In case of differences of opinion on the interpretation of the various texts, the French text shall prevail.

(2) This Act shall remain open for signature at Stockholm until January 13, 1968.

(3) The Director General shall transmit two copies, certified by the Government of Sweden, of the signed text of this Act to the Governments of all countries of the Union and, on request, to the Government of any other country.

(4) The Director General shall register this Act with the Secretariat of the United Nations.

(5) The Director General shall notify the Governments of all countries of the Union of signatures, deposits of instruments of ratification or accession and any declarations included in such instruments or made pursuant to Article 20(1)(c), entry into force of any provisions of this Act, notifications of denunciation, and notifications pursuant to Article 24.

Article 30

[Transitional Provisions]

(1) Until the first Director General assumes office, references in this Act to the International Bureau of the Organization or to the Director General shall be deemed to be references to the Bureau of the Union or its Director, respectively.

(2) Countries of the Union not bound by Articles 13 to 17 may, until five years after the entry into force of the Convention establishing the Organization, exercise, if they so desire, the rights provided under Articles 13 to 17 of this Act as if they were bound by those Articles. Any country desiring to exercise such rights shall give written notification to that effect to the Director General; such notification shall be effective from the date of its receipt. Such countries shall be deemed to be members of the Assembly until the expiration of the said period.

(3) As long as all the countries of the Union have not become Members of the Organization, the International Bureau of the Organization shall also function as the Bureau of the Union, and the Director General as the Director of the said Bureau.

(4) Once all the countries of the Union have become Members of the Organization, the rights, obligations, and property, of the Bureau of the Union shall devolve on the International Bureau of the Organization.

LEGISLATION

GERMANY (Federal Republic)

The Patent Law

(Text of January 2, 1968) *)

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PART ONE

The Patent

Article 1

(1) Patents are granted for new inventions which permit of industrial application [*gewerbliche Verwertung*].

(2) Inventions shall be excluded the use of which would be contrary to law or morality, except where the laws merely restrict the offering for sale or putting on the market of the subject of the invention or, if the invention relates to a process, of the product obtained directly by means of that process.

Article 2

An invention is not considered new if at the time of the application for a patent (Article 26) it has already been described in printed publications made available to the public [*öffentliche Druckschriften*] during the preceding hundred years, or has already been publicly used in this country in such a manner that use thereafter by other persons skilled in the art [*Sachverständige*] seems possible. Any description or use within six months prior to the application shall not be taken into account if it is based upon the invention of the applicant or his predecessor in title.

Article 3

The right to the patent shall belong to the inventor or his successor in title. If several persons have jointly made an

*) BIRPI translation of the text as published in the German *Bundesgesetzblatt* I, page 2.

invention, the right to the patent shall belong to them jointly. If several persons have made the invention independently of each other, the right shall belong to the person who is the first to file an application with the Patent Office.

Article 4

(1) In order that the examination of the patent application as to substance [*sachliche Prüfung*] may not be delayed by the determining of the identity of the inventor, the applicant, in the proceedings before the Patent Office, shall be deemed to be entitled to the grant of the patent.

(2) However, if the invention is the subject of a patent granted on an earlier application, a later application cannot establish the right to the grant of the patent. If this condition applies only in part, the applicant shall have a right to the grant of the patent with a corresponding limitation.

(3) The applicant for a patent shall also not have the right to the grant of the patent if the essential elements of his application have been taken from the descriptions, drawings, models, appliances or equipment of another person or from a process used by that person, without his consent, and such other person has, on that ground, lodged opposition [*Einspruch erhoben*]. If the opposition results in the withdrawal or rejection of the application and if, within one month after the official notification thereof, the opponent himself files an application in respect of the invention, he may request that the date of the earlier application be established as the date of his own application.

Article 5

The person entitled to apply whose invention has formed the subject of an application filed by a person not entitled to apply, or the person injured by such unlawful usurpation [*Entnahme*], may demand of the applicant for the patent that the right to the grant of the patent be assigned to him. If the application has already resulted in a patent, he may demand of the patentee that the patent be assigned to him. The right may be asserted by an action at law within one year after publication of the grant of the patent (Article 35, paragraph (1)), but thereafter only if the patentee, in obtaining the patent, has not acted in good faith.

Article 6

The effect of the patent shall be such that the patentee alone is authorized to produce, put on the market, offer for sale, or use, the subject matter of the invention industrially, commercially or professionally [*gewerbmässig*]. If the patent has been granted for a process, the effect shall also extend to the products obtained directly by means of such process.

Article 7

(1) A patent shall have no effect against any person who, at the time of the filing of the application, had already used the invention in this country, or had made the necessary arrangements for doing so. Such person shall be entitled to use the invention for the needs of his own business in his own plant or workshops [*Werkstätten*] or the plant or workshops of others.

This right can only be inherited or transferred together with the business. If the applicant or his predecessor in title has, before applying for a patent, disclosed the invention to other persons and reserved his rights in the event that a patent be granted, the person learning of the invention as a result of such disclosure cannot, under the provisions of sentence 1, invoke measures which he has taken within six months after the disclosure.

(2) (Repealed)

(3) If the patentee is entitled to a right of priority under an international agreement (Article 27) or to temporary protection under the Law Concerning the Protection of Inventions, Models and Trademarks at Exhibitions, of March 18, 1904 (*Reichsgesetzblatt*, page 141), the date of the prior foreign application or the commencement of the display of the invention shall be substituted for the date of the application referred to in paragraph (1). However, this provision shall not apply to nationals of a foreign country which does not grant reciprocity in this respect.

(4) The effect of the patent shall not extend to devices on vehicles which only temporarily enter this country.

Article 8

(1) A patent shall have no effect to the extent that the Federal Government orders that the invention shall be used in the interest of public welfare. Nor shall the effect of the patent extend to any use of the invention which is ordered in the interest of the security of the Federal Republic by the competent highest Federal Authority or, on the latter's instructions, by a subordinate agency.

(2) Only the Federal Administrative Court [*Bundesverwaltungsgericht*] shall have jurisdiction to consider appeals from any order under paragraph (1) issued by the Federal Government or by the competent highest Federal Authority.

(3) In cases mentioned in paragraph (1), the patentee shall have a claim against the Federal Government for reasonable compensation. In the event of dispute as to its amount, legal action may be brought before the ordinary civil courts. Any order by the Federal Government under paragraph (1), sentence 1, shall be communicated to the person recorded as patentee in the Register (Article 24, paragraph (1)) before the invention is used. If the highest Federal Authority from which an order or an instruction under paragraph (1), sentence 2, is issued learns that a claim for compensation has arisen under paragraph (1), it must give notice thereof to the person recorded in the Register as patentee.

Article 9

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

Article 10

(1) The duration of the patent shall be eighteen years, beginning on the day following the filing of the application in respect of the invention. If the purpose of an invention is the improvement or further development of another inven-

tion 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 main patent.

(2) If the main patent expires through a declaration of nullity [*Nichtigkeit*], as a result of revocation [*Zurücknahme*], or through abandonment [*Verzicht*], 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 shall become independent, and the others shall be deemed to be patents of addition thereto.

Article 11

(1) There shall be paid in respect of every application a publication fee (Article 31) prior to publication, and in respect of every application and every patent an annual fee, as prescribed in the schedule of fees, at the beginning of the third year and each successive year after the day following the date of the application.

(2) In the case of a patent of addition (Article 10, paragraph (1), sentence 2), no annual fees shall be payable. If the patent of addition is converted into an independent patent, it shall be subject to the payment of fees; the due date and the annual amount shall be determined by the date of commencement of the hitherto existing main patent. These provisions shall be applicable *mutatis mutandis* to the application for a patent of addition, provided that, in cases 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 in the case of an originally independent application.

(3) Fees for the third and each successive year shall be paid before the expiration of a period of two months from the due date. If such period has elapsed, the surcharge for delayed payment prescribed in the schedule of fees shall be paid. After the expiration of the grace period the Patent Office shall notify the applicant or patentee that the application will be deemed to have been withdrawn (Article 35, paragraph (3)) or that the patent will lapse (Article 12) if the fee and the surcharge prescribed in the schedule of fees are not paid before the expiration of a period of six months from the due date or of one month from service of the notification if the latter period expires later than six months after the due date.

(4) The Patent Office may postpone dispatch of the notification at the request of the applicant or patentee on proof being furnished by the latter that lack of resources prevents him from paying at that time. Postponement may be made conditional upon payment of installments within specified periods. If an installment is not paid in due time, the Patent Office shall advise the applicant or patentee that the application will be deemed to have been withdrawn or that the patent will lapse if the balance is not paid within one month after service of the notification.

(5) If no request has been made to postpone dispatch of the notification, then, on proof being furnished that payment is not to be expected because of lack of resources, the due date of the fee and the surcharge may be deferred even after

service of the notification, provided that a request is made within fourteen days after service and the previous delay is satisfactorily explained. Deferment may also be authorized subject to the payment of installments. If a deferred sum is not paid in due time, the Patent Office shall repeat the notification, whereby the whole of the balance outstanding shall be demanded. After service of the second notification, further deferment shall be inadmissible.

(6) A notification which has been postponed on request (paragraph (4)), or which, after deferment has been granted, must be repeated (paragraph (5)), shall be dispatched not later than two years after the fee falls due. Installments paid shall not be refunded if, owing to non-payment of the balance outstanding, the patent lapses [*erlischt*] (Article 12) or the application is deemed to have been withdrawn (Article 35, paragraph (3)).

(7) If the applicant or the patentee furnishes proof of his needy circumstances, the payment of the fees for publication and for the third to the ninth year may be deferred until the commencement of the tenth year, and may be waived if the patent application is withdrawn or the patent lapses within the first ten years.

(8) If the patent has been granted, an order may be made in favor of an applicant in needy circumstances who makes a declaration under Article 14, paragraph (1), to the effect that reasonable expenses for drawings, models and expert opinions, the production of which was necessary in the grant proceedings, shall be refunded to him out of Federal funds. The request for a refund must be submitted to the Patent Office within six months after the grant of the patent. The refund shall be recorded in the Register of Patents (Article 24, paragraph (1)). If, later, circumstances seem so to justify, the Patent Office shall order the sum refunded to be repaid in whole or in part. Repayments shall be added as a supplement to the annual patent fees and treated as part thereof.

(9) The fees may be paid before they fall due. If the patent is abandoned, or if it is declared null and void, or revoked, or if the application is withdrawn or rejected, any fees which have not become due shall be refunded.

Article 12

(1) The patent shall lapse, if:

1. the patentee abandons it by a written declaration to the Patent Office;
2. the declarations prescribed in Article 26, paragraph (6), are not made in due time after service of the official notification (Article 26, paragraph (7)); or
3. the fees are not paid in due time after service of the official notification (Article 11, paragraph (3)).

(2) The Patent Office shall be the sole judge of the question whether the declarations prescribed under Article 26, paragraph (6), as well as the payment, have been effected in due time; Articles 36*l* and 41*p* shall not be affected.

Article 13

(1) Nullity of the patent shall be declared on request (Article 37) if it appears that:

1. the subject matter is not patentable under Articles 1 and 2;
2. the invention is the subject of the patent of a prior applicant; or
3. the essential elements of the patent application have been taken from the descriptions, drawings, models, appliances, or equipment, of another person or from a process used by that person, without his consent.

(2) If one of these conditions applies only in part, nullity shall be declared in the form of a corresponding limitation of the patent.

Article 13a

Nullity of the patent shall be declared on request (Article 37), to the extent that an amendment of the patent claims, ordered for the purpose of limiting the patent (Article 36*a*), contains a broadening of the scope thereof.

Article 14

(1) If the applicant for a patent or the person recorded as patentee in the Register (Article 24, paragraph (1)) declares to the Patent Office in writing that he is prepared to allow anyone to use the invention in return for reasonable compensation, the annual fees falling due after receipt of the declaration shall be reduced to one-half of the amount prescribed in the schedule of fees. The effect of a declaration made in respect of a main patent shall extend to all its patents of addition. Such declaration shall be irrevocable. It shall be recorded in the Register of Patents and published once in the Patent Gazette [*Patentblatt*].

(2) The declaration shall be inadmissible as long as a note concerning the grant of a right to the exclusive use of the invention (Article 25, paragraph (1)) is recorded in the Register of Patents or a request for the recording of such note is pending in the Patent Office.

(3) Any person who wishes to use 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 has been dispatched by registered mail to the person recorded in the Register as patentee or his registered representative. A statement of how the invention is to be used shall be given in the notification. After such notification, the notifying party shall be entitled to use the invention in the manner stated by him. He shall be obliged, at the end of every calendar quarter, to give the patentee particulars of the use which has been made and to pay the compensation therefor. 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 said extension of time expires without result, may prohibit further use of the invention.

(4) Reasonable compensation shall be assessed by the Patent Office on the written request of any interested party. The decision shall be made by the Patent Division [*Patentabteilung*]. The provisions of Article 33 shall apply to the proceedings *mutatis mutandis*. A fee as prescribed by the schedule of fees shall be paid with the request, which may be directed against more than one interested party; if the fee is

not paid, the request shall be deemed not to have been made. In assessing the compensation, the Patent Office may order that the fee be repaid in whole or in part by the opponents of the request. Payment of the fee may be deferred up to six months after the termination of the proceedings, in the case of a patentee who furnishes proof of his needy circumstances. If the fee is not paid by that time, the opponents of the request may be ordered to pay the compensation for the use of the invention to the Patent Office for account of the patentee until such time as the amount of the fees still owing has been paid.

(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 unreasonable. A fee as prescribed by the schedule of fees shall be paid with the request. In other respects, the provisions of paragraph (4), sentences 1 to 5, shall apply *mutatis mutandis*.

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

Article 15

(1) If the applicant or patentee refuses to permit the use of the invention by another person offering to pay reasonable compensation and to furnish security therefor, that person shall be given authority to use the invention (compulsory license) if permission is indispensable in the public interest. The grant of the compulsory license shall be permissible only after publication of the application (Article 30) or after the grant of the patent. The compulsory license may be granted subject to restrictions and made dependent upon conditions.

(2) In so far as international agreements do not provide to the contrary, the patent shall be revoked if the invention is exclusively or mainly exploited outside Germany. Revocation may not be demanded until after the expiration of two years from the grant of a compulsory license by a final decision, and then only if the public interest can no longer be satisfied by the grant of compulsory licenses. These restrictions, however, shall not apply in the case of nationals of a foreign country which does not grant reciprocity in this respect. The assignment of the patent to another person shall be invalid in so far as it is intended only to avoid revocation.

Article 16

Any person who has neither a domicile nor an establishment in this country may take part in proceedings before the Patent Office or the Patent Court [*Patentgericht*] regulated by this Law and assert the rights deriving from a patent only if he has appointed a patent attorney [*Patentanwalt*] or an attorney at law [*Rechtsanwalt*] in this country as his representative. The latter shall be authorized to represent him in Patent Office and Patent Court proceedings and in civil litigation affecting the patent; he may also file requests for the institution of criminal proceedings [*Straf-*

anträge]. The place where the representative has his business premises shall be deemed, within the meaning of Article 23 of the Code of Civil Procedure [*Zivilprozessordnung*], to be the place where the assets [*Vermögensgegenstand*] are located; if there are no business premises, then the place where the representative has his domicile shall be relevant, and, in the absence thereof, the place where the Patent Office has its seat.

PART TWO

The Patent Office

Article 17

(1) The Patent Office shall consist of a President and other members. They must possess the qualifications required for judicial office under the German Law Relating to Judges [*Deutsches Richtergesetz*] (legal members) or must be experts in a branch of technology (technical members). The members shall be appointed for life.

(2) As a rule, only a person who has devoted himself to the study of natural science and technical subjects in this country as a regular student of a university or a technical or agricultural college or mining academy, who has then passed a State or academic final examination, who has also worked thereafter in the practical field for at least five years, and is in possession of the requisite legal knowledge, shall be appointed a technical member. Attendance at foreign universities, colleges, or academies, for a maximum duration of two years, may be taken into account in computing the time of study; in such cases also, the final examination must have been passed in this country.

(3) When a presumably temporary need exists, the President of the Patent Office may temporarily appoint persons having the qualifications required for members (paragraphs (1) and (2)) to perform the duties of a member of the Patent Office (assistant members) [*Hilfsmitglieder*]. The temporary appointment [*Auftrag*] may be for a specified period or for as long as is needed, and cannot be terminated during such period. In other respects, the provisions regarding members shall also apply to assistant members.

Article 18

(1) There shall be established in the Patent Office:

1. Examining Sections [*Prüfungsstellen*] for the examination of patent applications and for the grant of patents, in so far as the Patent Divisions do not have jurisdiction;
2. Patent Divisions [*Patentabteilungen*] for the handling of patent applications in opposition procedure (Article 32, paragraph (2)), requests for the grant of the right to poor persons' legal aid [*Bewilligung des Armenrechts*] (Article 46g, paragraph (2), No. 1), and for all matters concerning granted patents, including requests for limitation of the patent (Article 36a, paragraph (3)). It shall also be the duty of each Patent Division to give opinions (Article 23) on matters within its competence.

(2) The tasks of the Examining Section shall be performed by a technical member of the Patent Division (examiner).

(3) The Patent Division shall be competent to make decisions when at least three members participate, among whom must be two technical members when the Division operates under the opposition procedure. If the case involves special legal difficulties and if none of the members participating is a legal member, one of the legal members belonging to the Patent Division shall [soll] assist in rendering the decision. A decision whereby a request for the calling in of a legal member is refused shall not be subject to interlocutory appeal.

(4) The Chairman of the Patent Division may handle alone those matters of the Patent Division that relate to granted patents, with the exception of decisions on the limitation of the patent (Article 36a, paragraph (3)).

(5) The Federal Minister of Justice shall have power to establish by statutory order [Rechtsverordnung] that officials of the higher intermediate [gehobener Dienst] and lower intermediate [mittlerer Dienst] grades of the civil service shall be entrusted with the handling of particular matters within the competence of the Examining Sections or the Patent Divisions which present no technical or legal difficulties; with the exception, however, of the grant of the patent and the rejection of the patent application on grounds which the applicant has contested. The Federal Minister of Justice may delegate such power by statutory order to the President of the Patent Office.

(6) For the exclusion and challenge [Ablehnung] of examiners and other members of the Patent Divisions, Articles 41 to 44, 45, paragraph (2), sentence 2, and Articles 47 to 49, of the Code of Civil Procedure relating to exclusion and challenge of members of a court shall apply *mutatis mutandis*. The same holds good for officials of the higher and lower intermediate grades of the civil service in so far as they have been entrusted under paragraph (5) with the handling of particular matters within the competence of the Examining Sections or Patent Divisions. The decision on a challenge plea [Ablehnungsgesuch], in so far as the plea requires a decision, shall be made by the Patent Division.

(7) Experts who are not members may be called in during the deliberations of the Patent Divisions; they shall not take part in the voting.

Article 19

(Repealed)

Article 20

(Repealed)

Article 21

(Repealed)

Article 22

The Federal Minister of Justice shall regulate the establishment and the business procedure of the Patent Office and determine by statutory order the form of the procedure and the collection of administrative fees in so far as provision therefor has not been made by law.

Article 23

(1) The Patent Office shall be required to give opinions at the request of the courts or of the State attorney's offices [Staatsanwaltschaften] on questions affecting patents, if there are divergent opinions by a number of experts in the proceedings.

(2) In other respects, the Patent Office shall not have power to make decisions or give opinions outside its sphere of activity as provided by the Law, without the permission of the Federal Minister of Justice.

Article 24

(1) The Patent Office shall maintain a Register which shall record the subject matter and duration of the patents granted, as well as the names and addresses of the patentees and of their appointed representatives, if any (Article 16). The commencement, expiration, lapsing, order for limitation, declaration of nullity, and revocation of patents shall also be recorded therein.

(2) The Patent Office shall record in the Register a change in the identity of the patentee or of his representative, if proof thereof is furnished to it. A fee as prescribed by the schedule of fees shall be paid with the request; if the fee is not paid, the request shall be deemed not to have been filed. As long as the change has not been recorded, the former patentee and his former representative shall remain subject to the rights and obligations as provided in this Law.

(3) The Patent Office shall permit anyone so requesting to inspect the files and models and samples relating thereto if and to the extent that satisfactory proof of a legitimate interest has been furnished. Anyone may inspect:

1. the Register,
2. the files of unpublished patent applications, if, since the date of filing of the application, or since an earlier date if such date has been claimed as relevant, eighteen months have elapsed and a notice as specified in paragraph (4) has been published,
3. the files of published patent applications, and
4. the files of issued patents, including the files relating to limitation procedures (Article 36a),

as well as models and samples belonging to the said files. In connection with the naming of the inventor (Article 26, paragraph (6)), inspection shall be authorized only according to sentence 1, if so requested by the inventor designated by the applicant; Article 36, paragraph (1), sentences 4 and 5, shall be applicable *mutatis mutandis*. Inspection of patent applications and patents which, pursuant to Article 30a, have not been published shall be permitted by the Patent Office only after hearing the competent highest Federal Authority, if and to the extent that a special interest of the person making the request, which is worthy of protection, appears to warrant the requested permission to inspect and no danger can be expected to arise therefrom for the welfare of the Federal Republic of Germany or for any one of its *Länder* [States of the Federal Republic].

(4) The Patent Office shall publish the descriptions and drawings which are the basis for the grant of patents (Patent

specifications) [*Patentschriften*], reviews of recordings in the Register at regular intervals, provided they do not relate solely to the normal expiration of patents, and notifications regarding the possibility of inspecting the files of still unpublished patent applications (Patent Gazette) [*Patentblatt*]. The Patent Office may also publish the contents of files laid open to public inspection in accordance with paragraph (3), No. 2. The provisions of Article 30a, paragraph (1), shall not be affected.

(5) From the date of publication of the notification pursuant to paragraph (4), sentence 1, the applicant may claim from any person who has used the subject of the application, although he knew or should have known that the invention used by him was the subject of the application, compensation appropriate to the circumstances; during the period prior to publication of the application, the claiming of rights pursuant to Article 47, paragraphs (1) and (2), shall not be permitted. There shall be no claim for compensation if the subject of the application is obviously unpatentable. Article 48, sentence 1, shall be applicable *mutatis mutandis*.

(6) In the patent specification there shall be indicated the publications which the Patent Office has taken into account for the purposes of delimiting the subject matter of the application from prior art.

Article 25

(1) The grant of a right to the exclusive use of an invention protected by a patent may be recorded in the Register (Article 24, paragraph (1)). The Patent Office shall record as aforesaid on request, if proof is furnished of the consent of the person registered as patentee or his successor in title. The request shall be accompanied by an indication of the person to whom the right has been granted (licensee) [*Berechtigter*]; such indication shall not be given in the Register.

(2) Requests for recording the grant shall not be allowed after a declaration has been made of the patentee's willingness to grant licenses [*Lizenzbereitschaft*] to any person (Article 14, paragraph (1)).

(3) The recording of the grant shall be cancelled on request, if proof is furnished of the consent of the licensee named at the time of recording or of his successor in title.

(4) Requests filed under paragraphs (1) and (3) shall be subject to payment of a fee as prescribed by the schedule of fees; if the fee is not paid, the request shall be deemed not to have been filed.

(5) Recordings of grants and cancellations under paragraphs (1) and (3) shall not be published.

PART THREE

Proceedings Before the Patent Office

Article 26

(1) An application for the grant of a patent in respect of an invention shall be filed in writing with the Patent Office. For every invention, a separate application shall be

required. It must contain the request for the grant of the patent, and such request must designate precisely the subject matter to be protected by the patent. In an attachment, the invention must be so described that its use by others skilled in the art appears possible. At the end of the description, there shall be specified what is to be protected by patent (patent claim) [*Patentanspruch*]. The necessary drawings, pictorial illustrations, models and samples shall be attached.

(2) A fee for the costs of the proceedings as prescribed by the schedule of fees shall be paid with the application. If the fee is not paid, the Patent Office shall notify the inventor that the application shall be deemed to have been withdrawn unless the fee is paid before the end of one month after service of the notification.

(3) The Federal Minister of Justice shall have power to issue by statutory order regulations concerning other requirements for the application. He may delegate such power by statutory order to the President of the Patent Office.

(4) On the request of the Patent Office, the applicant shall indicate the prior art fully and truthfully to the best of his knowledge, and incorporate it in the description (paragraph (1)). If the applicant has also filed his invention in another country, he shall, independently of the requirement referred to in sentence 1, submit the serial number of the application and the printed publications used as reference in the procedure before the patent office of the other country.

(5) Up to the time of the decision to publish the application, additions to and corrections in the contents of the application shall be permissible, provided that the scope of the subject matter of the application is not broadened; however, until a request for examination is filed (Article 28b), only the correction of obvious mistakes, the remedying of defects pointed out by the Examining Section, or additions to and corrections of claims, shall be permissible. No rights may be derived from additions or corrections which broaden the scope of the subject matter of the application.

(6) Within a period of three months from the date of filing of the application, the applicant shall name the inventor or inventors and affirm that to his knowledge no other person has contributed to the invention. If the applicant is not the inventor, or not the sole inventor, he shall also state how he acquired the right to the patent. The correctness of such statements shall not be verified by the Patent Office.

(7) If the applicant satisfies the Patent Office that he is prevented by exceptional circumstances from making in due time the declarations prescribed in paragraph (6), it shall grant him a reasonable extension of time. This time limit shall [*soll*] not be prolonged beyond the time of issue of the decision to grant the patent. If by that time the aforesaid circumstances still exist, the Patent Office shall grant another extension. Six months before the expiration of the time limit, the Patent Office shall notify the patentee that the patent will lapse if he does not make the prescribed declarations within six months after service of the notification.

Article 27

Any person who, in accordance with an international agreement, claims the date of an earlier foreign patent application for the same subject matter as relevant shall, within a period of two months beginning with the day after the filing of the application with the Patent Office, state the date and country of the earlier application (priority declaration). After receipt of the priority declaration, the Patent Office shall request the applicant to indicate the serial number of the earlier application and to file a copy of the said application within a period of two months after communication of the request, if such action has not already been taken. Statements may be altered within those periods. If they are not made in due time, the priority claim for the application shall be forfeited.

Article 28

(1) If the application obviously does not comply with the prescribed requirements (Article 26), the Examining Section shall request the applicant to remedy the defects within a specified period. Where, in the case of Article 27, the production of documentary evidence (copies of the earlier application, descriptions, drawings, etc.) is required, this period shall be so fixed that it shall expire not less than three months after the filing of the application. If the application does not comply with the regulations in respect of other requirements for applications (Article 26, paragraph (3)), the Examining Section may refrain from objecting to the defects until the examining procedure is conducted (Article 28b).

(2) If, in the opinion of the Examining Section, the subject of the application obviously

1. does not by reason of its nature constitute an invention,
2. does not lend itself to industrial application,
3. is excluded from patentability under Article 1, paragraph (2),
4. is not directed, in the case of Article 10, paragraph (1), sentence 2, towards an improvement or further development of the other invention,

the Examining Section shall notify the applicant accordingly with an indication of the reasons therefor, and request him to state his views within a specified period.

(3) The Examining Section shall reject the application if the defects referred to in paragraph (1) are not remedied or the application is maintained although obviously no patentable invention exists (paragraph (2), Nos. 1 to 3), or the requirements of Article 10, paragraph (1), sentence 2, are obviously not met (paragraph (2), No. 4). If the rejection is to be based on facts that have not yet been communicated to the applicant he shall first be given an opportunity to state his views within a specified period.

Article 28a

(1) The Patent Office shall upon request search for the publications which are to be considered in connection with the determination of patentability of the invention in respect of which application has been filed.

(2) The request may be filed by the patent applicant or by any third party, who however shall not thereby become

a participant in the procedure. The request must be filed in writing. The provisions of Article 16 shall be applicable *mutatis mutandis*. A fee as prescribed by the schedule of fees shall be paid with the request; if the fee is not paid, the request shall be deemed not to have been filed. If the request is filed in connection with an application for a patent of addition (Article 10, paragraph (1), sentence 2), the Patent Office shall invite the applicant to file a request as specified in paragraph (1), before the expiration of a period of one month after the invitation, in connection with the application for the main patent; if the request is not filed, the application for the patent of addition shall be regarded as an application for an independent patent.

(3) The filing of the request shall be published in the Patent Gazette, but not before publication of the notification pursuant to Article 24, paragraph (4), sentence 1. If the request is filed by a third party, the applicant shall also be notified of the filing of the said request. Any person shall be authorized to inform the Patent Office of publications which might adversely affect the grant of a patent.

(4) The request shall not be deemed to have been filed if a request pursuant to Article 28b has been previously filed. In such case, the Patent Office shall notify the person making the request of the date of filing of the request pursuant to Article 28b. The fee paid for the request shall be refunded.

(5) If a request pursuant to paragraph (1) has been filed, subsequent requests shall be deemed not to have been filed. Paragraph (4), sentences 2 and 3, shall be applicable *mutatis mutandis*.

(6) If, after notification of the applicant (paragraph (3), sentence 2), a request filed by a third party is found to be ineffective, the Patent Office shall so advise both the third party and the applicant.

(7) The Patent Office shall communicate the publications ascertained in accordance with paragraph (1) to the applicant, and, if the request has been filed by a third party, to that party and the applicant, without guarantee as to their completeness, and shall publish in the Patent Gazette the fact that such communication has been effected.

(8) To accelerate the patent granting procedure, the Federal Minister of Justice shall have power to direct by statutory order that:

1. the search for the publications specified in paragraph (1) shall be assigned to a section of the Patent Office other than the Examining Section (Article 18, paragraph (1)) or to another national or international organization, in whole or for specific arts or languages, provided that the organization concerned appears competent to search for the publications to be taken into consideration;
2. the Patent Office shall supply the foreign or international authorities with data from the files of patent applications for their mutual information on the results of examination procedures and searches into prior art, provided that the applications concerned relate to inventions in respect of which the grant of a patent has also been applied for to the said foreign or international authorities;

3. the examination of patent applications according to Article 28, as well as the control of fees and time limits, shall be transferred in whole or in part to Patent Office sections other than the Examining Sections or Patent Divisions (Article 18, paragraph (1)).

Article 28b

(1) The Patent Office shall on request examine whether the application complies with the prescribed requirements (Article 26) and whether the subject matter of the application is patentable within the meaning of Articles 1, 2, and 4, paragraph (2).

(2) The request may be filed by the applicant or by any third party, who however shall not thereby become a participant in the examining procedure, until the expiration of a period of seven years after the filing of the application.

(3) A fee as prescribed by the schedule of fees shall be paid with the request; if the fee is not paid, the request shall be deemed not to have been filed.

(4) If a request pursuant to Article 28a has previously been filed, the examination procedure shall begin only after disposal of the request pursuant to Article 28a. In other respects, the provisions of Article 28a, paragraph (2), sentences 2, 3 and 5, and paragraphs (3), (5) and (6), shall be applicable *mutatis mutandis*. If a request filed by a third party is ineffective, the applicant himself may file a request within a period of three months from service of the notification, provided that the said period terminates later than the period specified in paragraph (2). If the applicant does not file a request, a notice shall be published in the Patent Gazette, referring to the publication of the request filed by the third party and stating that the said request is ineffective.

(5) The examination procedure shall continue even if the request for examination is withdrawn. In the case of paragraph (4), sentence 3, the procedure shall continue from the point which it had reached at the time of filing of the applicant's request for examination.

Article 28c

(1) If the application does not comply with the prescribed requirements (Article 26), the Examining Section shall request the applicant to remedy the defects within a specified period. If, in the case of Article 27, production of documents (copies of the earlier application, description, drawings, etc.) is required, the said period shall be fixed to end at the earliest three months after the date of filing of the application.

(2) If, in accordance with Articles 1, 2, and 4, paragraph (2), the Examining Section reaches the conclusion that the invention is not patentable, the said Section shall notify the applicant accordingly, with an indication of the grounds therefor, and request him to state his views within a specified period.

Article 29

(1) The Examining Section shall reject the application if the defects denounced under the terms of Article 28c, paragraph (1), have not been remedied, or if the application is

maintained although no patentable invention in accordance with Articles 1, 2, and 4, paragraph (2), exists. Article 28, paragraph (3), sentence 2, shall be applicable.

Article 30

(1) If the application complies with the prescribed requirements (Article 26) and if the Patent Office considers that the grant of a patent is not precluded, it shall order the publication of the application. Upon publication, the effects of the patent provided by the Law (Articles 6, 7, and 8) shall, for the benefit of the applicant for the patent, provisionally enter into force in respect of the subject matter of the application.

(2) The application shall be published by printing the name of the applicant and the essential elements of his request once in the Patent Gazette. In connection therewith, notice shall be given that the subject matter of the application is also provisionally protected against unauthorized use.

(3) Simultaneously, the description and drawings on which the publication is based shall be published (*Auslegeschrift*) and laid open, with the supporting documents explaining them, for public inspection at the Patent Office. The Federal Minister of Justice may order that the patent application shall also be laid open to public inspection outside the seat of the Patent Office.

(4) Publication shall, at the request of the applicant, be postponed until the expiration of a period of fifteen months beginning either with the day of the filing of the application with the Patent Office or, if an earlier date has been claimed as relevant, with that earlier date.

Article 30a

(1) If a patent is applied for in respect of an invention which is a state secret (Article 99, paragraph (1), of the Penal Code [*Strafgesetzbuch*]), the Examining Section shall order ex officio that no publication shall take place. The competent highest Federal Authority shall be heard before the order is issued. The said Authority may request that an order be issued.

(2) The Examining Section may cancel ex officio, or upon the request of the competent highest Federal Authority or of the applicant or patentee, an order under paragraph (1) when the reasons therefor no longer exist. The Examining Section shall examine at yearly intervals whether the reasons for the order under paragraph (1) continue to exist. Before cancellation of an order under paragraph (1), the competent highest Federal Authority shall be heard.

(3) The Examining Section shall notify the parties concerned if no appeal has been filed, within the period prescribed for such appeals (Article 36I, paragraph (2)), from a decision of the Examining Section whereby a request for the issuance of an order under paragraph (1) has been refused or an order under paragraph (1) has been cancelled.

(4) The provisions of paragraphs (1) to (3) shall be applied *mutatis mutandis* to an invention which has been kept secret by a foreign country for reasons of national defense and entrusted to the Federal Government with its consent

and on condition that it maintain the secrecy of the said invention.

Article 30b

The Patent Office shall permit the competent highest Federal Authority to inspect the files in order to examine the question whether, according to Article 30a, paragraph (1), no publication of an application shall take place, or whether an order issued under Article 30a, paragraph (1), shall be cancelled.

Article 30c

An invention which is a state secret (Article 99, paragraph (1), of the Penal Code) may be the subject of an application for a patent outside the jurisdiction of this Law only if the competent highest Federal Authority consents thereto in writing. Consent may be given subject to conditions.

Article 30d

(1) If, within a period of four months after the filing of the application with the Patent Office, no order under Article 30a, paragraph (1), is served upon the applicant, the said applicant and any other person having knowledge of the invention may, when in doubt as to whether or not the invention requires to be kept secret (Article 99, paragraph (1), of the Penal Code), assume that the invention need not be kept secret.

(2) When the examination of the question whether, according to Article 30a, paragraph (1), publication of an application is not to take place cannot be concluded within the period mentioned in paragraph (1), the Patent Office may, by means of a notice to be served upon the applicant within the period mentioned in paragraph (1), extend this period by two months at most.

Article 30e

(1) If the application in respect of an invention for which an order under Article 30a, paragraph (1), was issued satisfies the prescribed requirements (Article 26) and an invention patentable under Articles 1, 2, and 4, paragraph (2), exists, the Patent Office shall decide to grant the patent.

(2) The patent shall be recorded in a special Register. Before the decision is rendered, the declarations prescribed in Article 26, paragraph (6), shall be made and a fee of the same amount as the publication fee shall be paid; Article 31 shall apply *mutatis mutandis*.

Article 30f

(1) An applicant, a patentee, or the successor in title thereof, who refrains from using or ceases to use for peaceful purposes an invention which is patentable under Articles 1, 2, and 4, paragraph (2), as a result of an order under Article 30a, paragraph (1), shall have a claim for compensation, in respect of the damage thereby caused to him, against the Federal Republic, if and to the extent that he cannot be expected to bear the damages himself. In determining the extent to which he can be expected to do so, account shall be taken, in particular, of the financial position of the injured party, the amount of expenditure incurred by him for the invention or for acquiring the title thereto, the degree to which the

probability that the invention would have to be kept secret could have been recognized by him at the time when the expenditure arose, and the profit derived by the injured party from a different use of the invention. The claim can be validly asserted only after the patent is granted. Compensation can be claimed only after it has become due and for periods which shall not be shorter than one year.

(2) The claim shall be validly asserted before the competent highest Federal Authority. Legal action may be brought before the ordinary civil courts.

(3) Compensation under paragraph (1) shall be awarded only if the first application in respect of the invention has been filed with the Patent Office and the invention has not already been kept secret by a foreign State for reasons of national defense before the issuance of an order under Article 30a, paragraph (1).

Article 30g

The Federal Government shall have power to determine by statutory order the competent highest Federal Authority within the meaning of Article 24, paragraph (3), Articles 30a to 30f, and 36m, paragraph (2).

Article 31

The publication fee (Article 11, paragraph (1)) shall be paid within two months after service of the decision regarding publication. If the time limit is not observed, the surcharge prescribed by the schedule of fees must be paid. After the expiration of the period of two months, the Patent Office shall notify the applicant that the application will be deemed to have been withdrawn if the fee and the surcharge are not paid within one month after service of the notification.

Article 32

(1) Within a period of three months after publication, any person, but in the cases referred to in Article 4, paragraph (3), only the injured party, may oppose the grant of the patent. Opposition must be filed in writing and accompanied by a statement of the grounds. The opposition may be based only on the assertion that the subject matter is not patentable under Articles 1, 2, and 4, paragraph (2), or that the applicant for the patent has no right under Article 4, paragraph (3), to the grant of the patent. The facts justifying this assertion shall be stated in detail. Statements, in so far as they are not already contained in the opposition document, must be filed in writing before the expiration of the opposition period.

(2) As soon as opposition has been filed, further proceedings, including the rendering of a decision as to the grant of the patent, shall pass from the Examining Section to the Patent Division.

(3) If no opposition is filed, the Examining Section shall, after the expiration of the period, render its decision as to the grant of the patent.

Article 33

(1) The Examining Section and the Patent Division may at any time summon and hear the interested parties, examine

witnesses, experts and the parties concerned, whether under oath or not, and institute other inquiries necessary for investigation of the matter. Until such time as the decision is made as to publication, the applicant shall be given a hearing on request where appropriate. The request shall be filed in writing. If the request is not filed in the prescribed form or if the Examining Section does not consider a hearing to be appropriate, it shall reject the request. The decision whereby a request is rejected shall not be subject to interlocutory appeal. Minutes [*Niederschrift*] of the audiences [*Anhörungen*] and the examination of witnesses [*Vernehmungen*] shall be taken, which shall reproduce the essentials of the proceedings and contain the legally material declarations of the parties concerned. The minutes relating to the testimony of a witness, expert or party concerned shall be read to such person or handed over to him to be read. A note shall be entered in the minutes indicating that this has been done and the minutes have been approved, or what objections have been raised. The parties concerned shall receive a copy of the minutes.

(2) In its decision on the grant of the patent, the Patent Office may in its equitable discretion determine to what extent the costs arising from an audience or the taking of evidence shall be borne by an interested party. Such determination may also be made if the application or the opposition is wholly or partly withdrawn. The costs shall include, in addition to the expenses of the Patent Office, the costs incurred by the parties concerned to the extent that, in the equitable discretion of the Patent Office, they were necessary for the appropriate protection of the rights. The amount of the costs to be refunded shall be determined by the Patent Office upon request. The provisions of the Code of Civil Procedure relating to the procedure for the assessment of costs [*Kostenfestsetzungsverfahren*] and execution of decisions regarding the assessment of costs [*Kostenfestsetzungsbeschlüsse*] shall apply *mutatis mutandis*. Instead of an objection [*Erinnerung*], an appeal shall lie from the decision regarding the assessment of costs; Article 36*l* shall apply, provided that the appeal shall be filed within two weeks. The executable [*vollstreckbar*] copy shall be furnished by the registrar [*Urkundsbeamter*] of the Patent Court.

Article 34

(1) The decisions of the Examining Sections and the Patent Divisions shall contain the grounds therefor, and shall be in writing and be communicated *ex officio* to all interested parties.

(2) The decisions shall be accompanied by a statement informing the parties concerned of the appeal which shall be permissible from the decision, of the authority where the appeal shall be filed, of the period for filing the said appeal, and the appeal fee (if any) to be paid. The period for filing the appeal (Article 36*l*, paragraph (2)) shall begin to run only when the parties concerned have been so informed in writing. If they have not been informed, or incorrectly informed, the appeal may be filed only within one year from the time of the communication of the decision, except where information has been given in writing that an

appeal was not permissible; Article 43 shall apply *mutatis mutandis*.

Article 35

(1) When the patent has been granted, the Patent Office shall publish a notice to that effect in the Patent Gazette and shall issue a patent certificate [*Urkunde*] to the patentee.

(2) If the application is withdrawn after publication (Article 30) or if the patent is refused, this fact shall likewise be published by the Patent Office. With the withdrawal or refusal, the effects of the provisional protection (Article 24, paragraph (5), sentence 1, and Article 30, paragraph (1), sentence 2) shall be deemed not to have come into force.

(3) If, before the expiration of the period prescribed in Article 28*b*, paragraph (2), a request for examination is not filed, or if the annual fee payable for the application is not paid in due time (Article 11), the application shall be deemed to have been withdrawn.

Article 36

(1) The inventor shall be mentioned as such in the publication of the patent application (Article 30), in the publication of the grant of the patent (Article 35, paragraph (1)), and likewise in the printed patent specification itself (Article 24, paragraph (4)). Such mention shall be entered in the Register (Article 24, paragraph (1)). It shall be omitted if the inventor indicated by the applicant so requests. The request may be withdrawn at any time; in the event of withdrawal, mention shall be effected thereafter. Renunciation by the inventor of the right to be mentioned as such shall have no legal effect.

(2) If the identity of the inventor is incorrectly given or, in the case of paragraph (1), sentence 3, is not given at all, the applicant or the patentee and likewise the person wrongly mentioned shall be under an obligation to the inventor to declare to the Patent Office that they consent to having the mention provided for in paragraph (1), sentences 1 and 2, corrected or effected subsequently. Such consent shall be irrevocable. The procedure for the grant of the patent shall not be delayed by the bringing of an action for a declaration of consent.

(3) The subsequent mention of the inventor (paragraph (1), sentence 4, and paragraph (2)) or the correction (paragraph (2)) shall not be effected in official publications which have already been published.

(4) The Federal Minister of Justice shall have power to issue by statutory order regulations for the implementation of the foregoing provisions. He may delegate this power by statutory order to the President of the Patent Office.

Article 36*a*

(1) The patent may, on the request of the patentee, be limited, with retroactive effect, by amending the patent claims.

(2) The request shall be filed in writing with an indication of the grounds on which it is based. A fee as prescribed by the schedule of fees shall be paid with the request; if the fee is not paid, the request shall be deemed not to have been filed.

(3) The Patent Division shall decide on the request. The provisions of Article 28*b*, paragraph (1), and Articles 28*c*, 29, and 33, paragraph (1), shall be applicable *mutatis mutandis*. In the decision whereby the request is granted, the patent specification shall be adapted to the limitation. The amendment of the patent specification shall be published in accordance with Article 24, paragraph (4).

(4) Before deciding on the request, a contribution towards printing costs shall be paid within a period to be fixed by the Patent Office, to cover the costs arising from the publication of the amendment of the patent specification. The amount of the contribution shall depend on the number of lines of print. The Federal Minister of Justice shall have power to establish by statutory order the contribution, generally per line of print. He may delegate this power by statutory order to the President of the Patent Office. If the contribution to printing costs is not paid within the prescribed period, the request shall be rejected.

PART FOUR

The Patent Court

Article 36*b*

(1) The Patent Court is established as an autonomous and independent Federal Court for deciding appeals from decisions of the Examining Sections or Patent Divisions of the Patent Office, as well as actions for declaration of nullity or for revocation of patents and for the grant of compulsory licenses. It shall have its seat at the seat of the Patent Office. It shall be called "Federal Patent Court" [*Bundespatentgericht*].

(2) The Patent Court shall consist of a President, the presidents of the various Chambers [*Senatspräsidenten*], and other judges. They must possess the qualifications required for judicial office under the German Law Relating to Judges (legal members) or must be experts in a branch of technology (technical members). For the technical members, Article 17, paragraph (2), shall be applicable, *mutatis mutandis*, provided that the said technical members shall have passed a State or academic final examination.

(3) Judges shall be appointed for life by the President of the Federal Republic, except where otherwise provided in Article 36*i*.

(4) The President of the Patent Court shall exercise official supervision over judges, officials [*Beamte*], employees [*Angestellte*], and workers [*Arbeiter*].

Article 36*c*

(1) There shall be established in the Patent Court:

1. Chambers for deciding appeals (Chambers of Appeal) [*Beschwerdesenate*],
2. Chambers for deciding actions for a declaration of nullity and for revocation of patents as well as the grant of compulsory licenses (Nullity Chambers) [*Nichtigkeits-senate*].

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

Article 36*d*

(1) The Chamber of Appeal shall decide cases under Article 14, paragraph (4), and Article 30*a*, paragraphs (1) and (2), when it is composed of one legal member as presiding judge [*Vorsitzender*], and two technical members; in cases under Article 36*l*, paragraph (3), and Articles 46*b*, 46*c*, and 46*e*, when it is composed of one technical member as presiding judge, two additional technical members, and one legal member; in cases under Article 24, paragraph (3), sentence 4, when it is composed of one legal member as presiding judge, one additional legal member, and one technical member; in other cases, when it is composed of three legal members.

(2) The Nullity Chamber shall decide in cases under Articles 40 and 41, paragraph (3), when it is composed of one legal member as presiding judge, one additional legal member, and three technical members; in other cases, when it is composed of three judges of whom one must be a legal member.

Article 36*e*

(1) The President of the Court and the presidents of the Chambers shall preside over the Chambers. Before the commencement of the fiscal year [*Geschäftsjahr*], the President of the Court shall determine the Chamber to which he will be attached. The decisions on the allocation of the presidencies of the other Chambers shall be made by the President of the Court and the presidents of the Chambers by a majority vote; if the votes are equally divided, the President of the Court shall have a casting vote.

(2) Before the commencement of the fiscal year, the business shall be allocated for the duration of the said year among the Chambers of the appropriate competence, and the permanent members of the individual Chambers shall be appointed, as well as their regular substitutes in the event of prevention. Each judge may be appointed member of several Chambers. These arrangements may be changed in the course of the fiscal year only if it becomes necessary on account of the excessive workload of a Chamber or as a result of the change or permanent prevention of individual members of the Chambers.

(3) The arrangements referred to in paragraph (2) shall be made by the Presidium [*Präsidium*]. The Presidium shall consist of the President of the Court as chairman, his permanent substitute (Article 36*f*, paragraph (2)), the eight most senior presidents of the Chambers according to seniority of service, or, seniority of service being equal, according to date of birth, and three members elected by all the members of the Patent Court for the duration of the fiscal year. The Presidium shall make its decisions by a majority vote; if the votes are equally divided, the President shall have a casting vote.

(4) In the case of differences of opinion between several Chambers regarding their jurisdiction, the Presidium shall decide.

(5) Within each Chamber, the presiding judge shall allocate the business among the members. In the case of the Nullity Chamber, the presiding judge shall determine, before

the commencement of the fiscal year and for the entire duration thereof, the principles according to which the members shall take part in the proceedings; this arrangement may be changed only if it becomes necessary on account of excessive workload, insufficient workload, change or permanent prevention of individual members of the Chamber.

Article 36f

(1) In the case of prevention of the regular presiding judge, the member of the Chamber appointed as regular substitute by the Presidium before the commencement of the fiscal year shall preside; if such substitute has not been appointed or if he has also been prevented from presiding, the most senior member of the Chamber according to seniority of service, or, seniority of service being equal, according to date of birth, shall preside. Article 36d shall not be affected.

(2) The President of the Court shall, in his other activities defined by this Law, be represented by the president of the Chamber appointed as his permanent substitute, and, in the event of the latter's being prevented, by the most senior president of the Chamber according to seniority of service, or, seniority of service being equal, according to date of birth. The permanent substitute of the President of the Court shall be appointed by the Federal Minister of Justice.

(3) When the regular substitute of a member of a Chamber has been prevented from attending, a temporary substitute shall be appointed by the President of the Court.

Article 36g

(1) Proceedings before the Chambers of Appeal shall be public if the application has been published, or if a notice of the possibility of inspecting the files (Article 24, paragraph (4), sentence 1) has been published. The provisions of Articles 172 to 175 of the Judiciary Act [*Gerichtsverfassungsgesetz*] shall be applicable *mutatis mutandis*, provided that:

1. on the request of one of the parties, the public may also be excluded from the proceedings if publicity threatens to endanger the interests, worthy of protection, of the party making the request;
2. the public shall be excluded from the pronouncement of the decisions until the publication of a notice of the possibility of inspecting the files (Article 24, paragraph (4), sentence 1), or until publication of the application (Article 30).

(2) The proceedings before the Nullity Chambers, including the pronouncement of decisions, shall be public. Paragraph (1), sentence 2, No. 1, shall be applicable *mutatis mutandis*.

(3) The maintenance of order in the sessions of the Chambers shall be the responsibility of the presiding judge. Articles 177 to 180, 182 and 183, of the Judiciary Act relating to the maintenance of order in court [*Sitzungspolizei*] shall be applicable *mutatis mutandis*.

Article 36h

(1) Decisions in the Chambers shall require to be made on the basis of deliberation and the taking of votes. In such

cases, only the number of members of the Chambers prescribed by law may participate. During the deliberation and voting there may be present, in addition to the members of the Chambers qualified to make the decision, only persons employed at the Patent Court for training purposes, provided that the presiding judge permits them to be present.

(2) The decisions of the Chambers shall require a majority vote; if the votes are equally divided, the presiding judge shall have a casting vote.

(3) The members of the Chambers shall vote according to seniority of service, and, seniority of service being equal, according to age, the younger voting before the older. If a recording judge [*Berichterstatter*] has been appointed, he shall vote first. The presiding judge shall vote last.

Article 36i

(1) Judges may be employed at the Patent Court on temporary appointment [*kraft Auftrags*]. Article 36b, paragraph (2), sentence 3, shall be applicable.

(2) Judges appointed on a temporary basis and temporarily delegated [*abgeordnete*] judges cannot preside.

Article 36k

There shall be established at the Patent Court a registrar's office, which shall be staffed with the necessary number of registrars [*Urkundsbeamte*]. The establishment of the office shall be ordered by the Federal Minister of Justice.

PART FIVE

Proceedings Before the Patent Court

1. Proceedings on Appeal

Article 36l

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

(2) The 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 [*Schriftsätze*] shall [*sollen*] be attached for the other parties. The appeal and all written statements containing motions pertaining to the matter [*Sachanträge*] 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 the said parties, provided that ex officio service has not been ordered.

(3) If the appeal lies from a decision to reject the application or from a decision on the grant or limitation of the patent, a fee as prescribed by the schedule of fees shall be paid within the period allowed for filing the appeal; if the fee is not paid, the appeal shall be deemed not to have been filed.

(4) If the instance whose decision is appealed against considers the appeal to be justified, it shall redress the grievance. It may order that the appeal fee be refunded. If the grievance is not redressed, the appeal shall be referred before the expiration of three months to the Patent Court without expressing an opinion on its merits.

(5) If the appellant is opposed by another party to the proceedings, the provisions of paragraph (4), sentence 1, shall not be applicable.

Article 36m

(1) The appeal may be filed by the parties to the proceedings before the Patent Office.

(2) In the case of Article 24, paragraph (3), sentence 4, and of Article 30a, paragraphs (1) and (2), the appeal may also be filed by the competent highest Federal Authority.

Article 36n

(1) The appeal shall have a staying effect.

(2) The appeal shall, however, have no staying effect when it lies from a decision of the Examining Section by which an order under Article 30a, paragraph (1), has been issued.

Article 36o

A hearing [*mündliche Verhandlung*] shall take place if:

1. one of the parties so requests;
2. evidence is to be taken before the Patent Court (Article 41c, paragraph (1)), or
3. the Patent Court considers it appropriate.

Article 36p

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

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

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

Article 36q

(1) When several persons are parties 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 that this is equitable. It may, in particular, also order that the costs incurred by the parties shall, to the extent that they can be reasonably considered to have been necessary for the appropriate protection of the rights involved, be refunded in whole or in part by one of the parties.

(2) The Patent Court may order that the appeal fee (Article 36l, paragraph (3)) be refunded.

(3) The provisions of paragraphs (1) and (2) shall also be applicable if the appeal, the application, or the opposition, is withdrawn either in whole or in part.

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

2. Nullity, Revocation and Compulsory License Proceedings

Article 37

(1) Proceedings for a declaration of nullity or for revocation of the patent or for the grant of a compulsory license shall be instituted by bringing legal action. The action shall be directed against the person recorded in the Register as patentee.

(2) In the case of Article 13, paragraph (1), No. 3, only the injured party shall be entitled to file the action.

(3) The action must be filed with the Patent Court in writing. Copies of the action filed and of all written statements shall [*sollen*] be attached for the defendant [*Gegenpartei*]. These copies shall be served *ex officio* on the defendant.

(4) The action must designate the plaintiff, the defendant, and the matter at issue, and shall [*soll*] contain a specific motion. The facts and documentary evidence relied on shall be indicated. If the action does not fully comply with these requirements, the presiding judge shall invite the plaintiff to file the necessary additional materials within a specified period.

(5) A fee as prescribed by the schedule of fees shall be paid when the action is filed; if the fee is not paid, the action shall be deemed not to have been filed.

(6) If the plaintiff is domiciled abroad, he shall furnish to the defendant, at the latter's request, security for the costs of the proceedings. The Patent Court shall determine, in its equitable discretion, the amount of the security and shall fix a time limit within which the said amount shall be furnished. If the time limit is not observed, the action shall be deemed to have been withdrawn.

Article 38

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

(2) If the defendant fails to reply in due time, a decision complying with the plaintiff's request may be rendered forthwith without a hearing, and to that end every factual allegation of the plaintiff may be regarded as proved.

Article 39

(1) If the defendant files a contesting reply in due time, the Patent Court shall notify the plaintiff of such reply.

(2) The Patent Court shall render its decision on the basis of a hearing. With the consent of the parties, the decision may be rendered without a hearing.

Article 40

(1) The decision on the action shall be delivered in the form of a judgment [*Urteil*]. A separate interim decision on the admissibility of the action may be delivered in the form of an interlocutory judgment.

(2) In the judgment, the Patent Court shall determine, in its equitable discretion, in what proportion the costs of the proceedings shall be borne by the parties. Article 36*q*, paragraph (1), sentence 2, and paragraph (4), shall be applicable *mutatis mutandis*.

Article 41

(1) In proceedings for the grant of a compulsory license, the plaintiff may, on his request, be allowed the use of the invention by a provisional order if he satisfies the Court that the conditions referred to in Article 15, paragraph (1), are complied with and that the immediate grant of permission is urgently required in the public interest.

(2) A fee as prescribed by the schedule of fees shall be paid with the request; if the fee is not paid, the request shall be deemed not to have been filed. The issuance of the provisional order may be made conditional on the furnishing of security, by the person making the request, for the damage which the patentee (defendant) may suffer.

(3) The Patent Court shall render its decision on the basis of a hearing. The provisions of Article 39, paragraph (2), sentence 2, and of Article 40 shall be applicable *mutatis mutandis*.

(4) The effect of the provisional order shall cease with the withdrawal or refusal of the action for the grant of the compulsory license (Article 37); 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 issuance of the provisional order proves to have been unjustified from the beginning, the person making the request shall be obliged to compensate the patentee for the damage which he has suffered from the execution of the provisional order.

(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 patentee for the damage which he has suffered through the enforcement.

3. General Rules of Procedure

Article 41a

(1) For the exclusion and challenge of members of the court, Articles 41 to 44 and 47 to 49 of the Code of Civil Procedure shall be applicable *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 the declaration of nullity of the patent,
 - (a) persons who have participated in the proceedings before the Patent Office relating to the grant of the patent;
 - (b) persons who have participated in the proceedings before the Patent Court relating to the decision on the grant of the patent.

(3) The decision on the challenge of a judge shall be rendered by the Chamber to which the person who is challenged belongs. If, as a result of the elimination of the member who has been challenged, the Chamber lacks a quorum, a Chamber 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 Chamber in whose jurisdiction the matter belongs.

Article 41b

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

(2) The presiding judge or a member appointed by him shall, before the hearing or, in the absence of a hearing, before the decision of the Patent Court, make all necessary arrangements for finally disposing of the matter, if possible in one hearing or in one session. In other respects, Article 272*b*, paragraphs (2), (3), and (4), sentences 1 and 2, of the Code of Civil Procedure shall be applicable *mutatis mutandis*.

Article 41c

(1) The Patent Court shall take evidence at the hearing. In particular, it may make inspections on the spot [*Augenschein einnehmen*], examine witnesses, experts and the parties, and order the consultation of documents.

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

(3) The parties shall be notified of all hearings in which evidence is taken [*Beweistermine*] 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.

Article 41d

(1) As soon as the date for the 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 his absence.

Article 41e

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

Article 41f

(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 Chamber to ask questions. If a question is objected to, the Chamber shall decide.

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

Article 41g

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

(2) The essential processes of the hearing, in particular the final formulation of the motions made by the parties, shall be included in the minutes. The parties may request that specific elements or statements be included in the minutes. The Patent Court may refuse such inclusion if the element or statement is immaterial. Any such decision shall be noted in the minutes. The minutes shall be signed by the presiding or examining judge and the minute-writer.

(3) The minutes relating to the statements of a witness, expert, or party, shall be read to such person or handed over to him to be read. A note shall be entered in the minutes indicating that this has been done and the minutes have been approved, or what objections have been raised. In the event of examination outside the hearing, the person examined shall also be required to sign his statement.

Article 41h

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

(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 hearing, a judge not present at the last session of the hearing may participate in rendering the decision only if the parties consent.

Article 41i

(1) Decisions of the Patent Court shall, if a hearing has taken place, be rendered at the court session at which the hearing was concluded or at a session to be fixed forthwith, and which shall not be more than two weeks later. They shall be served ex officio upon the parties. Decisions may be served upon the parties instead of being pronounced in court. If the Patent Court makes its decision without a hearing, pronouncement of the decision shall be replaced by service thereof upon the parties.

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

Article 41k

(1) Clerical errors [*Schreibfehler*], errors in calculation, and similar obvious errors in the decision may at any time be corrected by the Patent Court.

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

Article 41l

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

(2) The Patent Court shall decide on this matter without taking evidence. In such decisions, only judges who have taken part in rendering the decision whose correction is requested shall participate. The decision concerning the correction shall be recorded on the decision itself and the copies thereof.

Article 41m

(1) Any party may, at any stage of the proceedings, be represented before the Patent Court by an authorized representative. A decision may be made, ordering the appointment of a representative. The provisions of Article 16 shall not be affected.

(2) The power of attorney shall be filed in writing at the Court with the documents of the case. It may be filed later; for this purpose, the Patent Court may fix a time limit.

Article 41n

In proceedings before the Patent Court, the Law on Court Costs [*Gerichtskostengesetz*] shall apply *mutatis mutandis* with respect to the expenses.

Article 41o

(1) In the absence of provisions in this Law concerning proceedings before the Patent Court, the Judiciary Act and the Code of Civil Procedure shall apply *mutatis mutandis* unless the special nature of the proceedings before the Patent Court does not so permit.

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

(3) For the grant to third persons of permission to inspect the files of the case, Article 24, paragraph (3), shall apply *mutatis mutandis*. The request for permission shall be decided upon by the Patent Court. Permission to inspect the files of proceedings for the obtaining of a declaration of nullity of a patent shall not be granted if and to the extent that the patentee proves an interest to the contrary, worthy of protection.

(4) The provisions of the Judiciary Act on court vacations shall not apply.

PART SIX

Proceedings Before the Federal Court of Justice [*Bundesgerichtshof*]*)

1. Procedure in respect of Appeals on Points of Law [*Rechtsbeschwerde*]

Article 41p

(1) An appeal on a point of law from decisions of the Chambers of Appeal of the Patent Court in respect of an

*) This is the highest Federal Court in civil and criminal cases.

appeal under Article 36l shall lie to the Federal Court of Justice if the Chamber of Appeal in its decision has given leave to appeal on the said point of law.

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

1. a question of law of basic significance is to be decided, or
2. the further development of the law or the assurance 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 of the Patent Court 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, on account of the possibility of partiality, had been successfully challenged;
3. 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;
4. if the decision was made on the basis of a hearing in which the provisions on the publicity of proceedings were violated; or
5. if the decision does not state the grounds therefor.

Article 41q

(1) The right to appeal on a point of law shall belong to the parties to the proceedings on appeal.

(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. Articles 550 and 551, Nos. 1 to 3 and 5 to 7, of the Code of Civil Procedure shall apply *mutatis mutandis*.

Article 41r

(1) The appeal on a point of law shall be filed in writing with the Federal Court of Justice within one month after service of the decision.

(2) In proceedings concerning appeals on points of law before the Federal Court of Justice, fees and expenses shall be determined by the provisions of the Law on Court Costs. There shall be levied, for the proceedings, a full fee which shall be calculated according to the rates applicable to proceedings in appeal instance cases [*Revisionsinstanz*]. The provisions of Article 53 on the assessment of value in dispute [*Streitwertfestsetzung*] shall apply *mutatis mutandis*.

(3) The 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. the declaration as to the extent to which the decision is contested and the modification or reversal thereof is requested;
2. the indication of the violated rule of law;
3. where 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) The parties must be represented before the Federal Court of Justice by an attorney at law, admitted to practise before that Court, as authorized representative. Upon the request of any party, the latter's patent attorney shall be given leave to speak. Article 157, paragraphs 1 and 2, of the Code of Civil Procedure shall not apply in this event. Article 51, paragraph (5), shall apply *mutatis mutandis*.

Article 41s

The appeal on a point of law shall have a staying effect. Article 36n, paragraph (2), shall apply *mutatis mutandis*.

Article 41t

The Federal Court of Justice shall examine *ex officio* whether the appeal on a point of law is in itself admissible 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 lacking, the appeal on a point of law shall be dismissed as inadmissible.

Article 41u

When several persons are parties to the proceedings in respect of the appeal on a point of law, the appeal and the statement of the grounds therefor shall be served upon 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 [*soll*] file the required number of certified copies together with the appeal or the statement of the grounds for the appeal.

Article 41v

(1) In proceedings in respect of the appeal on a point of law, the provisions of the Code of Civil Procedure regarding exclusion and challenge of members of the court, authorized representatives [*Prozessbevollmächtigte*] and legal assistants [*Beistände*], *ex officio* service of documents, summons, sessions and time limits, and reinstatement [*Wiedereinsetzung in den vorigen Stand*], shall apply *mutatis mutandis*. In the case of reinstatement, Article 43, paragraph (4), shall apply *mutatis mutandis*.

(2) As to the publicity of the proceedings, Article 36g, paragraph (1), shall apply *mutatis mutandis*.

Article 41w

(1) The appeal on a point of law shall be the subject of a decision; such decision may be rendered without a 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 *ex officio* upon the interested parties.

Article 41x

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

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

Article 41y

(1) When several persons are parties to the proceedings relating to the appeal on a point of law, the Federal Court of Justice may, in its equitable discretion, 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 the gross negligence of one of the parties shall be awarded against that party.

(2) In other respects, 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*.

2. Procedure on Appeal [*Berufungsverfahren*]

Article 42

(1) An appeal shall lie to the Federal Court of Justice from the judgments of the Nullity Chambers of the Patent Court (Article 40). It shall be filed in writing with the Patent Court within one month after service of the decision. Within this period, a fee as prescribed by the schedule of fees shall be paid; if the fee is not paid, the appeal shall be deemed not to have been filed.

(2) In proceedings before the Federal Court of Justice, fees and expenses shall be levied in accordance with the provisions of the Law on Court Costs. The fees shall be calculated according to the rates which apply to proceedings in appeal instance cases [*Revisionsinstanz*]. The provisions of Article 53 on the assessment of value in dispute shall apply *mutatis mutandis*. The fee paid for the filing of the appeal shall be deducted from the Federal Court of Justice fees; it shall not be refunded.

(3) In the judgment, provision shall also be made for the costs of the proceedings. Article 40, paragraph (2), shall apply *mutatis mutandis*.

(4) Interlocutory decisions of the Nullity Chambers shall be subject to appeal only together with the final judgments (Article 40). Article 42b, paragraph (2), shall not be affected.

Article 42a

The appeal must contain the motions of appeal and the indication of the new facts and means of establishing evidence which the appellant wishes to introduce.

Article 42b

(1) If the appeal is not received in due time, or is not drawn up in the German language, or does not contain the motions of appeal, the Patent Court shall dismiss the appeal as inadmissible.

(2) The appellant may, within one week after service of such decision (to dismiss the appeal), request a decision by the Federal Court of Justice.

Article 42c

(1) The Patent Court shall serve the appeal upon the appellee with the request to file his written response with the Patent Court within one month after service. The date on which the appeal was filed shall be communicated with the service of the appeal. The appellant shall [*soll*] file the required number of certified copies together with the appeal.

(2) The response of the appellee must contain the counter-motions and the indication of the new facts and means of establishing evidence which the appellee wishes to introduce.

Article 42d

The Patent Court shall submit the files of the case to the Federal Court of Justice and notify the parties thereof while communicating the response to the appellant.

Article 42e

(1) The Federal Court of Justice shall have discretion to take all measures necessary for the investigation of the case. It shall not be bound by the factual statements and offers of proof of the parties.

(2) Evidence may also be taken through the intermediary of the Patent Court.

Article 42f

(1) The judgment of the Federal Court of Justice shall be rendered on the basis of a hearing. Article 36g, paragraph (2), shall apply *mutatis mutandis*.

(2) The summons shall be served with at least two week's notice.

(3) The hearing may be dispensed with if:

1. the parties consent;
2. a party is to be declared to have forfeited the legal remedy; or
3. only the costs are to be decided.

Article 42g

(1) The introduction of new facts and means of establishing evidence at the hearing shall be admissible only to the extent that it results from the factual statements of the appellee in the written response.

(2) The Federal Court of Justice may also consider facts and evidence which the parties are forbidden to invoke.

(3) Article 42e shall be applicable if any additional evidence requires to be taken.

(4) When the judgment is to be based upon factors which have not been discussed by the parties, the said parties shall be given an opportunity to express their views thereon.

Article 42h

(1) Facts alleged by one party on which the other party has made no statement may be deemed to be proven.

(2) If none of the parties appears at the hearing, the judgment shall be based on the files of the case.

Article 42i

(1) At the hearing, minutes shall be taken which shall record in general the course of the proceedings.

(2) The minutes shall be signed by the presiding judge and the registrar of the Court.

Article 42k

(1) The judgment shall be pronounced at the hearing that concludes the proceedings, or at a hearing whose date shall be fixed forthwith.

(2) If pronouncement of the grounds for the decision is deemed appropriate, it shall take the form of a reading of such grounds or an oral communication of the essential elements thereof.

(3) The judgment shall be served *ex officio* upon the parties.

Article 42l

(1) Attorneys at law admitted to practise before a German court and patent attorneys shall be authorized to undertake representation in the proceedings on appeal before the Federal Court of Justice.

(2) The parties and their representatives shall be permitted to appear accompanied by a technical advisor.

3. Special Procedure on Appeal [*Beschwerdeverfahren*]

Article 42m

(1) An appeal from decisions of the Nullity Chambers of the Patent Court on the issuance of provisional orders in proceedings relating to the grant of a compulsory license (Article 41) shall lie to the Federal Court of Justice. Article 42, paragraph (4), sentence 1, shall apply *mutatis mutandis*.

(2) The appeal shall be filed in writing with the Patent Court within one month after service of the decision. Within this period, a fee as prescribed by the schedule of fees shall be paid; if the fee is not paid, the appeal shall be deemed not to have been filed. As to the expenses, Article 42, paragraph (2), sentence 1, shall apply *mutatis mutandis*.

(3) The Patent Court shall submit the appeal to the Federal Court of Justice without expressing an opinion as to its merits.

(4) Article 36m, paragraph (1), Articles 40 and 42e to 42l shall apply *mutatis mutandis*, with respect to the proceedings before the Federal Court of Justice.

PART SEVEN

Common Provisions

Article 43

(1) Any person who, through unavoidable circumstances, has been prevented from observing a time limit in the pro-

cedure before the Patent Office or the Patent Court, default of which is detrimental to his rights according to the provisions of the law, shall, on request be reinstated. This provision shall not apply to the time limit for filing an opposition (Article 32, paragraph (1)), to the time allowed to the opponent for filing an appeal against the decision granting the patent (Article 36l, paragraph (2)), to the time limit for filing patent applications for which a priority right may be claimed, to the time allowed for making the priority declaration (Article 27), and to the time allowed for indicating the serial number of the earlier application (Article 27).

(2) Reinstatement must be requested in writing within two months after the removal of the impediment. Within the said period, the action in default shall be made good. The request must state the facts upon which it is based and the means of substantiating the said facts. After one year from the expiration of the time limit which has not been observed, reinstatement can no longer be requested and the action in default can no longer be made good.

(3) A decision on the request shall be made by the instance which must decide on the action made good.

(4) Any person who, in this country, has in good faith used the subject matter of a patent which, as a result of reinstatement, has re-entered into force, in the period between the lapsing and the re-entry into force of the patent, or has within that period made the necessary arrangements for such purpose, shall be entitled to continue to use the subject matter of the patent for the needs of his own business in his own or other people's plant or workshops. This right can only be inherited or transferred together with the business.

(5) Paragraph (4) shall apply *mutatis mutandis* if, as a result of reinstatement, provisional protection (Article 24, paragraph (5), sentence 1, and Article 30, paragraph (1), sentence 2) again becomes effective.

Article 44

In proceedings before the Patent Office, the Patent Court, and the Federal Court, the parties must make their statements on questions of fact fully and truthfully.

Article 44a

(1) If an opposition or action for a declaration of nullity of the patent is based upon the assertion that the subject of the application or of the patent is not patentable under Article 2, the Patent Office or the Patent Court may require that originals, photocopies or certified copies of the publications mentioned in the opposition or in the action which are not available at the Patent Office or Patent Court be furnished, in one copy each, for the Patent Office or Patent Court and for the parties to the proceedings.

(2) Uncertified or certified translations of publications in a foreign language shall be produced when required by the Patent Office or Patent Court.

Article 45

The language of the Patent Office and Patent Court shall be German. Communications in other languages shall not be considered. In other respects, the provisions of the Judiciary Act concerning the language of the courts shall be applicable.

Article 45a

(1) For the purpose of the service of documents in proceedings before the Patent Office and the Patent Court, the provisions of the Law on Service in Administrative Procedure [*Verwaltungszustellungsgesetz*] of July 3, 1952 (*Bundesgesetzblatt I*, page 379), last amended by the Law of October 6, 1965 (*Bundesgesetzblatt I*, p. 1477), shall apply subject to the following conditions:

1. If acceptance of service by registered letter is refused without such grounds as are provided by the law, service shall notwithstanding be deemed to have been effected.
2. Service upon addressees residing abroad may also be effected by mailing in accordance with Articles 175 and 213 of the Code of Civil Procedure.
3. For the purposes of service upon holders of certificates of representation [*Erlaubnisscheininhaber*] (Article 177 of the Patent Attorney Law of September 7, 1966, *Bundesgesetzblatt I*, p. 557), Article 5, paragraph (2), of the Law on Service in Administrative Procedure shall apply *mutatis mutandis*.
4. Documents may also be served upon addressees for whom a mail box has been installed at the Patent Office or at the Patent Court, by depositing the said documents in the mail box of the addressee. A written statement relating to the deposit shall be added to the files of the case. The time of the deposit shall be recorded on the document. Service shall be deemed to have been effected on the third day after deposit in the mail box.
5. If a representative is appointed and the written power of attorney has been included in the files, the documents shall be served upon the representative.

(2) Article 9, paragraph (1), of the Law on Service in Administrative Procedure shall not apply if the service marks the commencement of the period allowed for the filing of the appeal (Article 36*l*, paragraph (2), and Article 42*m*, paragraph (2)) or of the appeal on a point of law (Article 41*r*, paragraph (1)), or for the filing of the appeal (pursuant to Article 42, paragraph (1)), or for the request for a decision by the Federal Court (Article 42*b*, paragraph (2)).

Article 46

(1) The courts shall be required to furnish legal assistance to the Patent Office and the Patent Court.

(2) In proceedings before the Patent Office, the Patent Court shall, at the request of the said Patent Office, fix the penalties for witnesses and experts who fail to appear or who refuse to give evidence or to give it under oath. Enforcement of the summons served on a witness who has failed to appear shall likewise be ordered.

(3) A Chamber of Appeal of the Patent Court composed of three legal members shall pronounce on the request made

under paragraph (2). Pronouncement [*Entscheidung*] in such case shall take the form of a decision [*Beschluss*].

PART EIGHT

Poor Persons' Legal Aid Procedure [*Armenrechtsverfahren*]

Article 46a

In proceedings before the Patent Office, the Patent Court, and the Federal Court, the parties shall be granted the right to free legal aid for poor persons in accordance with the provisions of Articles 46*b* to 46*k*.

Article 46b

(1) In proceedings for the grant of a patent, an applicant for a patent who furnishes proof of his needy circumstances shall, on request, be granted legal aid if there are adequate prospects that the patent will be granted.

(2) Through the grant of legal aid, the applicant for a patent shall obtain provisional exemption from payment of:

1. the application fee in the case mentioned in Article 4, paragraph (3), sentence 2;
2. the fees for requests under Articles 28*a* and 28*b*;
3. the appeal fee (Article 36*l*, paragraph (3));
4. arrears of expenses and expenses accruing in the future, including the indemnity to be paid to witnesses and experts, as well as the service costs.

(3) If several persons apply for the patent jointly, legal aid shall be granted only if all the applicants for the patent are in needy circumstances.

(4) If the applicant for the patent is not the inventor or his sole successor in title, legal aid shall be granted only if the inventor is also in needy circumstances.

(5) The provisions of paragraphs (1) to (4) shall apply *mutatis mutandis*:

1. in cases specified in Articles 28*a* and 28*b*, to the third party filing the request if the said third party can substantiate a personal interest worthy of protection;
2. in the case of Article 32, to the opponent if the opposition is based on Article 4, paragraph (3).

Article 46c

In proceedings for limitation of the patent (Article 36*a*), the provisions of Article 46*b* shall apply *mutatis mutandis*, subject to the condition that the patentee, through the grant of legal aid, shall also obtain provisional exemption from payment of the fee for the request for limitation of the patent and from payment of the contribution towards printing costs.

Article 46d

(1) In proceedings for a declaration of nullity or for revocation of the patent or for the grant of a compulsory license, a party who furnishes proof of his needy circumstances shall be granted legal aid if the contemplated prosecution of a right or defense of a right offers adequate prospects of success and the party substantiates a personal interest worthy of protection.

(2) Through the grant of legal aid, the party shall obtain provisional exemption from payment of arrears of fees

and expenses and fees and expenses accruing in the future, including the indemnity to be paid to witnesses and experts, as well as the service costs.

Article 46e

(1) Any party who has been granted legal aid in accordance with the provisions of Articles 46b to 46d may, upon request, be assigned a patent attorney or an attorney at law or, on express demand, a holder of a certificate of representation [*Erlaubnisscheininhaber*] for the provisionally cost-free pursuit of his rights, if such assignment appears necessary for the proper handling of the proceedings.

(2) The representative to be assigned shall be chosen by the Chairman of the Patent Division in proceedings before the Patent Office, and in other cases by the presiding judge of the Chamber of the Patent Court or Federal Court of Justice competent to decide on the request for assignment. In proceedings before the Patent Office, the representative selected and the interested parties shall be entitled to appeal from the decision in accordance with Article 36l, paragraph (1).

(3) The representative assigned shall be obliged to accept the representation.

(4) Article 42l shall not be affected.

Article 46f

If the request for the grant of legal aid in accordance with Articles 46b to 46d is filed prior to the expiration of the period prescribed for the payment of a fee, the course of that period shall be interrupted until the expiration of one month after service of the decision on the request.

Article 46g

(1) The request for the grant of legal aid shall be filed in writing with the Patent Office or the Patent Court. In proceedings under Articles 42 and 42m, the request may also be filed with the Federal Court of Justice if the Patent Court has transmitted the files of the case to that Court.

(2) The decision shall be made on the aforesaid request by the instance competent for the proceedings in respect of which legal aid is sought. However, the decision on the request shall be made:

1. by the Patent Division in proceedings before the Examining Section;
2. by the Patent Court, in proceedings under Article 42, if the appeal under Article 42b is to be dismissed as inadmissible.

(3) The decisions rendered under Articles 46b to 46e, paragraph (1), shall not be appealable when they do not involve a decision of the Patent Division whereby that body refuses the grant of legal aid or the assignment of a representative under Article 46e, or orders the subsequent payment of costs.

Article 46h

(1) The provisions of Article 114, paragraphs (2) to (4), Article 115, paragraph (2), Article 116a, paragraph (1), Article 116b, paragraphs (1) and (2), Articles 117, 118, paragraphs (2) and (3), Article 118a, paragraph (1), Articles 119,

121, 122, 123, paragraph (1), and Article 126, of the Code of Civil Procedure shall apply *mutatis mutandis*.

(2) In proceedings for obtaining a declaration of nullity or for revocation of the patent or for the grant of a compulsory license, Article 118a, paragraph (2), Articles 120, 123, paragraph (2), and Article 124, of the Code of Civil Procedure shall also apply *mutatis mutandis*.

Article 46i

(1) Any party granted legal aid shall be liable for the subsequent payment of the sums from the payment of which he was provisionally exempted, as soon as he is no longer in needy circumstances. The same shall apply to the sums from the payment of which the opposing party was provisionally exempted, to the extent that the costs of the proceedings have been awarded against the needy party.

(2) After the conclusion of the proceedings, other parties shall be liable for subsequent payment of the costs of the proceedings awarded against them and from the payment of which they or the needy party have been provisionally exempted.

Article 46k

(1) In proceedings relating to the appeal on a point of law (Article 41p), the right to legal aid shall be granted upon request to a party who furnishes proof of his needy circumstances if the intended legal proceedings offer adequate prospects of success.

(2) The request for the grant of legal aid shall be filed in writing with the Federal Court of Justice; it may also be declared before and recorded at the registrar's office of the Court. The Federal Court of Justice shall decide on the request.

(3) In other respects, the provisions of Article 46d, paragraph (2), and Articles 46e, 46f, 46h and 46i, shall apply *mutatis mutandis*, provided that only an attorney at law admitted to practise before the Federal Court may be assigned to a party who has been granted legal aid.

PART NINE

Infringement

Article 47

(1) Any person who uses an invention contrary to the provisions of Articles 6, 7 and 8 may be sued by the injured party to enjoin such use.

(2) Any person who undertakes such action intentionally or negligently shall be liable for compensation to the injured party for the damage suffered therefrom. If the infringer is charged with only slight negligence, the court may fix, in lieu of compensation, an indemnity situated between the damage to the injured party and the profit which has accrued to the infringer.

(3) In the case of an invention whose subject matter is a process for the production of a new substance, any substance of the same nature shall, in the absence of proof to the contrary, be deemed to have been produced by the patented process.

Article 47a

If, prior to the grant of the patent, rights based on an application the files of which may be inspected by any person (Article 24, paragraph (3), sentence 2, Nos. 2 and 3) are claimed in court proceedings, and if the decision on the litigation depends on whether the subject matter of the application enjoys provisional protection (Article 24, paragraph (5), sentence 1, and Article 30, paragraph (1), sentence 2), the court may order that the proceedings be deferred until the decision on the grant of the patent. If a request for examination pursuant to Article 28b has not been filed, the court may, at the request of the opposing party, give to the party claiming rights on the basis of the application a time limit for filing the request for examination. If the request for examination is not filed within that time limit, the rights on the basis of the application involved in the litigation may not be claimed.

Article 48

Claims on account of infringement of the rights in a patent shall come under the statute of limitation after three years from the time when the claimant obtains knowledge of the infringement and of the identity of the infringer, and, irrespective of such knowledge, after thirty years from the infringement. If the infringer has obtained anything through the infringement at the expense of the claimant, the said infringer shall be liable, even after expiration of the term of limitation, for restitution in accordance with the provisions on restitution of unjust enrichment.

Article 49

(1) Any person who intentionally uses an invention contrary to the provisions of Articles 6, 7 and 8 shall be punished by a fine or by imprisonment not exceeding one year.

(2) Criminal prosecution shall be instituted only upon request. The request may be withdrawn.

(3) In the case of conviction, authority shall at the same time be given to the injured party, if he shows a legitimate interest in doing so, to publish the sentence at the expense of the party sentenced. The scope and nature of the publication shall be determined in the judgment. The authority shall lapse if the decision is not published within three months after it becomes final.

Article 50

(1) In lieu of any compensation arising out of this Law, punitive damages [*Busse*] payable to the injured party may, on his demand, be awarded in addition to the penalty. The parties sentenced thereto shall be liable for the punitive damages as joint debtors.

(2) The award of punitive damages shall preclude the assertion of a further claim for compensation.

PART TEN

Procedure in Patent Litigation

Article 51

(1) For all actions whereby a claim arising out of one of the legal relationships regulated in this Law is asserted

(patent litigation) [*Patentstreitsachen*], the *Landgerichte*¹⁾ shall have exclusive jurisdiction without regard to the value in dispute.

(2) The State Governments [*Landesregierungen*] shall have power to allot by statutory order [*Rechtsverordnung*] patent litigation for the areas of several *Landgerichte* to one such court. The State Governments may transfer those powers to the State Ministries of Justice [*Landesjustizverwaltungen*].

(3) The parties may also, in cases of patent litigation, be represented before the court by attorneys at law admitted to practise in the *Landgericht* before which the action, in the absence of the arrangement under paragraph (2), would be heard. The same shall apply in the case of representation before the Court of Appeal [*Berufungsgericht*].

(4) Any additional costs incurred by a party arranging to be represented, as provided in paragraph (3), by an attorney at law not admitted to practise in the court hearing the case shall not be refunded.

(5) Of the costs arising from the collaboration of a patent attorney in the case, fees up to the amount of a full fee according to Article 11 of the Federal Fee Ordinance for Attorneys at Law [*Bundesgebührenordnung für Rechtsanwälte*] shall be refunded, as well as the necessary expenses of the patent attorney.

Article 52

(Repealed)

Article 53

(1) If, in a patent case, a party satisfies the court 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 the said party's liability to pay court costs be adjusted in accordance with a portion of the value in dispute that shall be appropriate to his financial position. As a result of the order, the favored party shall likewise be required to pay the fees of his attorney at law only in accordance with that portion of the value in dispute. To the extent that the costs of the case are awarded against him or to the extent to which he assumes such costs, he shall be required to refund the court fees paid by the opposing party and the fees of the latter's attorney at law only in accordance with that portion of the value in dispute. To the extent that the extra-judicial costs are ordered to be paid by the opposing party or are assumed by that party, the attorney at law of the favored party may recover his fees from the opposing party in accordance with the value in dispute applying to the latter.

(2) The request under paragraph (1) may be declared before and recorded at the registrar's office of the court. It shall be presented before the substance of the case is heard. Thereafter, it shall only be admissible if the presumed or fixed value in dispute is subsequently increased by the court. Before the decision is given on the request, the opposing party shall be heard.

¹⁾ A higher first instance court dealing with certain major civil and criminal cases.

Article 54

Any person who has brought an action pursuant to Article 47 may bring a further action against the defendant on account of the same or a similar act on the basis of another patent only if, through no fault of his own, he was not in a position to assert that patent also in the earlier suit.

PART ELEVEN

Arrogation of Patent [Patentberühmung]

Article 55

Any person who places on articles or their packing a marking or designation of such a nature as to create the impression that the articles are protected by a patent or a patent application pursuant to this Law, or any person who uses a marking of such a nature in public notices, on signboards, on business cards or in similar announcements, shall be obliged to give on demand, to every person having a legitimate interest in knowing the legal position, information as to the patent or patent application upon which the use of the marking or designation is based.

ITALY

Decrees

Concerning the Temporary Protection of Industrial Property Rights at Twenty-one Exhibitions

(of February 5, 10, 13, 16 and 26, and March 1, 11, 14, 21, 28 and 30, 1968)¹⁾

Single Article

Industrial inventions, utility models, designs and trademarks relating to objects appearing at the following exhibitions:

XXXII^a *Mostra mercato internazionale dell'artigianato* (Florence, April 24 to May 8, 1968);

Rassegna suinicola internazionale (Reggio Emilia, April 28 to May 1, 1968);

XVI^a *Fiera campionaria di Roma* (Rome, May 25 to June 9, 1968);

XLVI^a *Fiera di Padova campionaria internazionale* (Padua, May 31 to June 13, 1968);

III^o *Salone internazionale dell'aeronautica e dello spazio* (Turin, June 4 to 13, 1968);

I^a *Mostra internazionale dei paesi africani — AFRICA 68* (Genoa, June 6 to 16, 1968);

XX^a *Fiera di Trieste campionaria internazionale* (Trieste, June 21 to July 5, 1968);

XXVIII^a *Fiera di Ancona — Mostra mercato internazionale della pesca, degli sports nautici e attività affini* (Ancona, June 27 to July 7, 1968);

V^o *Salone internazionale componenti, strumenti di misura elettronici e accessori* (Milan, September 1 to 8, 1968);

XXXIII^a *Mostra nazionale radio televisione* (Milan, September 1 to 8, 1968);

V^a *Esposizione europea elettrodomestici* (Milan, September 5 to 11, 1968);

V^a *MACEF — Mostra mercato internazionale degli articoli casalinghi, cristalleria, ceramiche, ferramenta e utensileria* (Milan, September 7 to 10, 1968);

XXXII^a *Fiera del Levante — Campionaria internazionale* (Bari, September 10 to 23, 1968);

XVIII^o *Salone internazionale della tecnica — V^o Salone della Montagna* (Turin, September 20 to October 2, 1968);

V^o *SMAU — Salone internazionale macchine attrezzature ufficio* (Milan, September 21 to 29, 1968);

II^a *Mostra internazionale dei servizi pubblici — SEP* (Padua, September 26 to 30, 1968);

VI^a *Biennale italiana della macchina utensile — BI-MU* (Milan, October 6 to 13, 1968);

VI^a *Mostra internazionale dei trasporti interni e del magazzinoaggio — Manutenzione degli impianti e servizi tecnici — Strumenti di misura e pesatura per magazzini — Imballaggi per magazzini — TRAMAG* (Padua, October 10 to 15, 1968);

VIII^a *Mostra internazionale delle apparecchiature chimiche — MAC 68* (Milan, October 12 to 20, 1968);

V^a *Mostra internazionale delle attrezzature alberghiere e turistiche — TECNHOTEL* (Genoa, November 16 to 26, 1968);

X^a *Mostra convegno internazionale dell'automazione e della strumentazione* (Milan, November 20 to 26, 1968)

shall enjoy the temporary protection provided by Laws No. 1127 of June 29, 1939²⁾, No. 1411 of August 25, 1940³⁾, No. 929 of June 21, 1942⁴⁾, and No. 514 of July 1, 1959⁵⁾.

²⁾ See *La Propriété industrielle*, 1939, p. 124; 1940, p. 84.

³⁾ *Ibid.*, 1940, p. 196.

⁴⁾ *Ibid.*, 1942, p. 168.

⁵⁾ *Ibid.*, 1960, p. 23.

GENERAL STUDIES

The New German Patent and Trademark Law

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The Law for the Amendment of the Patent Law, Trademark Law and Other Laws, dated September 4, 1967¹⁾, introduced the most far-reaching changes undergone by German patent and trademark law since its institution in the second half of the nineteenth century. The intention originally pursued in drafting the Bill was merely to remedy the drastic situation that had arisen through the constant deterioration of the state of the German Patent Office's workload. More specifically, it had not been intended in any way to anticipate the general reform of industrial property legislation that has been in preparation for a number of years. Nevertheless, as

¹⁾ Official communications from the Italian Administration.

¹⁾ *Bundesgesetzblatt*, I, p. 953; *Industrial Property*, 1967, p. 305.

the legislative process went ahead, numerous amendments and additions were introduced into the Bill and it was gradually transformed into a long-term arrangement, as a result of which it acquired such substance as to make it one of the most important reforms in the history of German industrial property law. This is immediately evident from a simple enumeration of the essential changes it incorporates:

- (1) The principle of prior examination that had applied in German patent law since the earliest days (from 1877) is replaced by the principle of deferred examination.
- (2) Unrestricted early publication 18 months after the beginning of the period of priority is obligatory for all patent applications, irrespective of the procedural situation in each case.
- (3) Contrary to the tradition in German patent law, inventions relating to foodstuffs, alcoholic beverages and tobacco (*Genussmittel*), medicaments, and substances produced by chemical processes are now patentable (repeal of the prohibition to patent certain products).
- (4) The principle of registration, which — in contrast to trademark law in many other countries — has traditionally governed German trademark law ever since its earliest stages, has now been substantially supplemented and developed through the introduction of a special compulsory use requirement.
- (5) The national classification system for the registration of trademarks had remained unchanged for several decades. This is now replaced by the International Classification of Goods based on the Nice Agreement of June 15, 1957.

From the very beginning, and right up to the last moment, there was quite considerable controversy over some of these fundamental legal changes, and in particular the introduction of a system of deferred examination in the German patent grant procedure as well as the provision for early publication of all applications after a period of 18 months. In some cases, divergences of opinion caused a complete split within the interested circles, and the proposed changes found equally vehement supporters and opponents among the experts concerned. The competent legal committee of the German *Bundestag*, the Federal Parliament, showed an admirable degree of determination and objectivity in facing up to the great difficulties which arose not only from the hotly disputed nature of the proposals but also from the highly specialized character of the whole subject matter. By means of intensive hearings of experts and detailed discussion, it endeavored not only to make its own informed judgment of the situation but also, wherever possible, to bridge the great divergences of opinion with suitable compromise proposals. This also explains why the Law enacted by Parliament deviates from the Government's Bill to no small degree on quite a number of points. Thus, it is possible to explain and understand many of the new regulations and provisions only in the light of their historical development. The following survey therefore sets out to state the underlying causes and the guiding features of the new German patent and trademark law in a manner that will also be comprehensible to the foreign reader.

I

Deferred Examination

(1) The state of the German Patent Office's workload had been gradually deteriorating every year since 1957. The number of new applications increased constantly each year, while the number of cases disposed of each year steadily declined. The result was a constant increase in the backlog of pending applications. By the end of 1967, the number of such pending applications approached 280,000. Industry found it increasingly difficult to bear the gradual lengthening of the patent procedure, which finally averaged a period of over five years. Much the same situation existed in almost all examining patent offices throughout the world, even though the situation was not so serious everywhere.

(2) This meant that the reasons for the existing situation were not to be found in any temporary decline in the capacity and ability of the Patent Office to deal with the workload or even primarily in staffing shortages in the Patent Office: the causes were structural.

(a) The constant rise in the number of applications filed with the German Patent Office is basically a consequence of advancing industrialization and of technological expansion covering ever more widespread fields of activity. A further factor lies in the increasing complexity of international economic relations. The growing attraction of the European Common Market placed an increasing workload on the German Patent Office, as one of the two examining patent offices existing within the area of the Community, because firms from outside the Common Market were tending more and more to file their inventions in that area as well. The fact that applications from abroad already account for some 45% of applications filed with the German Patent Office provides evidence that this is at least one of the essential reasons for the Office's expanding workload. The largest proportion of these foreign applications comes from the United States.

(b) A second cause closely connected with the increasing volume of new applications is the extraordinarily rapid development of the "state of the art," the literature which has to be taken into account in the examination of patent applications. It has been calculated that the volume of technical literature throughout the world doubles roughly every ten years, and the term "literature explosion" has been coined to describe the situation in the field of technology. This inevitably means that the examination of every single patent application is going to take longer and longer if it is to continue to refer to the full state of the art known at the time of application.

(c) A final element is that, with the growing differentiation of technology, individual patent applications have also become much more complex, so that it is more difficult for the Patent Office's examiners to understand and evaluate them. The processing period required for each application is consequently considerably longer than in earlier times.

(3) These three principal causes of the steady deterioration of the state of the German Patent Office's workload clearly demonstrate that this was no passing phase and that

the problem was structural in character. During the discussions on what measures to take, there was quite soon a basic consensus that, as the problem was a structural one, it could not be solved by administrative action or staff increases alone. Any attempt to overcome the difficulties by means of extra staff alone would have necessitated the recruitment of more examiners every year, at least for the foreseeable future, if not for good. It is of course obvious that Parliament, in particular, was not prepared to agree to this.

In the course of the legislative process, the Federal Government did, however, repeatedly stress the absolute need for improving the Patent Office's equipment and for substantial staff increases as administrative measures to provide additional support quite apart from the amendment of the legal procedure governing patent grant. Despite the exceedingly tight budgetary situation, the Government met with truly generous support from all of the authorities involved, including Parliament. It is therefore no exaggeration to say that the entry into force of the new Law will see the German Patent Office both staffed and equipped in a manner that has never been equalled in the whole of its 90 years and more of existence. In this respect, there is every guarantee that the new patent procedure will be successful.

(4) But the provision of sufficient staff and equipment was not enough in itself. When it introduced the Bill on which the Law of September 4, 1967, is based, the Government declared that the structural causes of the existing situation had led it to consider a legislative change in the patent procedure unavoidable, at least for the foreseeable future. It therefore proposed the introduction of the system of deferred examination, which had already been in force in the Netherlands since January 1, 1964. While regarding it as vital that patents should continue to be granted in Germany only following full formal and substantive examination as to patentability, it pointed out that not only in Germany, but in other industrialized States as well, past experience showed that only a very small percentage of inventions filed for patenting were economically exploited during the period of validity of the patent. The figure of 2 to 5% has been advanced, and others have put it at 10%. In any event, it is certain that only an astonishingly small percentage of inventions is actually exploited in any manner whatsoever. Patent applications are filed for the great majority of inventions at a stage when their economic value cannot yet be gauged. In most cases, it turns out that the invention cannot be exploited in the way in which the applicant originally thought it could be. Patents granted on such applications are accordingly dropped as soon as the patent has to bear a gradually rising annual fee under the present regulations. But the Patent Office has had to carry out the exceedingly expensive work of examination for these inventions which are not economically exploited.

(5) This is the experience on which the draft of the Law of September 4, 1967, tried to base an adequate solution. The idea behind it was that patent applications should in future remain virtually unprocessed after filing and should be regarded as having been withdrawn after a specified period unless a special request for examination, supported by the payment of a fee, has been made before the expiry of that

period. It was only in response to such a request for examination that the expensive process of examination should in future be instituted, the procedure then applying being largely the same as previously. In this way, the applicant himself was to be induced to separate the wheat from the chaff. The basic reasoning was that the applicant would not make such a request, involving the payment of a fee, unless it were economically worthwhile in respect of the invention for which he had filed an application.

This is the essence of the system of deferred examination which ignited the arguments in Germany in exactly the same manner as had occurred in the Netherlands earlier on. In the course of the subsequent discussions, lasting nearly three years, the system of deferred examination was molded into a pattern that differs to no small extent both from the Federal Government's original Bill and from the Dutch model. Nevertheless, it remains a system of deferred examination and has been combined only to a certain degree with elements of the traditional procedure for prior examination.

(6) What will the procedure be from October 1, 1968, when the new provisions for the grant of patents come into force? This is explained below by illustrating each of the successive stages, although it should be noted that these stages are liable to overlap.

(a) The first thing to do, as previously, is to file a patent application with the German Patent Office, a fee of DM 50 being payable at the same time (Article 26 (1) and (2), of the Patent Law). The only new requirement is that applicants who have already filed an application for the same invention in another country are obliged, without being specially invited to do so by the Patent Office, to submit the serial number of the foreign application as well as any printed references cited in the procedure before the patent office of the other country (Article 26 (4), second sentence), regardless of whether these citations were made before or after the German application was filed.

(b) Following the filing of the application, it is first subjected to an examination aimed at discovering any obvious defects (*Offensichtlichkeitsprüfung* — Article 28). This examination as to obvious defects is carried out by a separate preliminary examination department of the Patent Office so that applications are not yet submitted to the competent technical examiner. This means that he is not burdened with the applications at this stage, which should not be underestimated as a psychological factor. The examination is restricted to establishing whether the application obviously fails to comply with the formal requirements or whether the subject of the invention obviously

- (i) does not essentially constitute an invention,
- (ii) does not lend itself to industrial application,
- (iii) would be contrary to laws or public morals if utilized, or
- (iv) is not intended as an improvement or further development of a main application already filed, despite the applicant's affirmation to the contrary.

If the preliminary examination department of the Patent Office finds an obvious defect of this kind, it rejects the application. The applicant may then appeal to the Patent Court.

(c) If, as will normally be the case, the Patent Office's preliminary examination department fails to find any obvious defect in the application, the Patent Office does nothing to continue the examination procedure for the time being. The application is stayed unless the applicant himself or a third party takes special action. All the Patent Office itself does is to allow public inspection of the application (Article 24 (3) (2)) 18 months after the priority date claimed for the application and to publish a notice to that effect in the Patent Gazette (*Patentblatt*) (Article 24 (4)). This opening for public inspection of the application also entails a certain provisional protection. The details of the procedure for laying an application open for public inspection are described in Section II below.

(d) Any further action from there on now lies with the applicant. Under the new Law, he has the following alternatives:

(i) He may simply wait and ask for nothing more. This means that his application has at least provisionally secured priority for his invention and has also obtained a certain degree of provisional protection from the time it is laid open for public inspection onwards, since he may claim compensation appropriate to the circumstances from any third party using the invention he has filed (see Section II below). He must simply remember that, under Article 35 (3), the application is considered withdrawn if he fails to file a request for examination within seven years of filing the application. In the case of an employee's invention coming within the terms of the Employees' Inventions Law, the period is reduced by three months, because the employer is then required under Article 16 of the Law to offer the invention to the employee for transfer three months before the expiry of the seven-year period. It should also be noted that under the new provisions it is no longer only in respect of patents already granted, but also in respect of applications still pending, that from the beginning of the third patent year the progressively rising annual fees are payable (Article 11 (1)), and that under Article 35 (3) the application is also considered withdrawn if the annual fee has not been paid within the prescribed period of time.

(ii) The applicant may, however, also take the initiative and accelerate the procedure. Here again there are two possibilities open to him:

On the one hand, he may file a request for an isolated search (Article 28a). A fee of DM 100 is payable with this request, poor persons' legal aid being granted where appropriate. If such a request is filed, the Patent Office ascertains the publications which are to be cited in connection with determining the patentability of the invention, notifies the applicant of these publications, with no guarantee of completeness, and publishes a notice in the Patent Gazette stating that such notification has been issued. A request may also be filed by a third party, who does not, however, thereby become a party to the procedure. An applicant will normally file such a request for an isolated search only if he is not yet concerned with having the examination procedure carried out and his only immediate need is to know the state of the art with reference to his invention. This means that, for ap-

plicants (or third parties) having their own reliable documentation on the special technical field to which the application relates, a request for an isolated search is hardly likely to be of practical utility.

On the other hand, the applicant (and again any third party) may file a request for examination (Article 28b) and thereby cause the actual examination procedure to be initiated. A fee of DM 300 is payable when the request is filed; this sum also being subject to poor persons' legal aid; the fee is reduced to DM 200 if a request for an isolated search has already been filed, in which case the examination procedure is not started until the earlier request has been dealt with by carrying out the search. This is explained by the very purpose of the request for an isolated search, which is to inform the applicant of the state of the art and thus allow him to decide whether he should withdraw the application in order to avoid unnecessary costs or whether it is worthwhile to have the examination procedure carried through.

The applicant (and any third party) may, however, also file a request for examination quite independently of any request for an isolated search, at any time within seven years of the filing of the application. This constitutes the essential point of divergence from the new patent legislation of the Netherlands according to which no request for examination may be filed unless a request for an isolated search has already been filed and the results of the search are already available. Under the new German Law, a request for examination may be filed at any time regardless of whether or not it is preceded by a request for search; the only difference is that the examination fee is reduced from DM 300 to DM 200 if a request for search has already been filed.

Thus, the request for examination may be filed immediately, together with the application. If it is, the procedure follows practically the same lines as hitherto. In this way, as mentioned above, the system of deferred examination is combined with the traditional system of prior examination. If the request for examination is filed at the same time as the application or immediately afterwards, the procedure is continued by the competent examiner once the examination as to obvious defects has been completed (see 6(b) above), and from then on it differs in no way from the traditional prior examination procedure. But the applicant is also free to hold back with his request for examination and thereby "defer" the examination. It is therefore up to him, and him alone, to decide whether his application should be dealt with under the traditional procedure of prior examination or under that of deferred examination. It is no longer the Patent Office that dictates the procedure, but the applicant, unless a third party files a request for examination.

(e) If a request for examination has been filed, the same procedure for examination is followed as hitherto. The application is examined as to novelty, technical progress and inventive step, but the results of any previous search carried out on the basis of a request for an isolated search are taken into account. If there has been no such isolated search, the search is made by the competent examiner as part of the examination procedure, exactly as before. If the results of this examination are positive, the application is formally

published in pamphlet form under the name "*Auslegeschrift*" (Article 30). Upon such publication of the application, full provisional patent protection is granted, giving the applicant the right to claim a preventive injunction and compensation. Within three months following the publication of the application, any person may oppose the granting of the patent (Article 32). If no opposition is filed, or if any opposition already filed is withdrawn, the patent is granted.

(7) A new principle is introduced by the provision of Article 26 (5), second sentence, stating that no rights may be derived from amendments or corrections which, by adding new matter, broaden the scope of the application. This puts an end to the possibility existing under the previous procedure before the Patent Office whereby derived applications could be filed which received the priority attaching to the extension of the original application. In the case of an inadmissible extension of the application, the only action open to the applicant is to file a new application for the extension with new priority.

(8) A further point to be noted is that, as already touched on briefly, Article 11 as amended requires the progressively rising annual fees to be paid, from the beginning of the third year after filing, on all pending applications and not just on patents already granted. This applies irrespective of whether or not a request for search or examination has been filed. In this way, the applicant is to be induced to consider constantly whether it is worth his expense to maintain his application despite the rising fee payable.

(9) It should be mentioned finally that, in court proceedings where rights are claimed in respect of a patent application for which no request for examination has been filed, the court must require the applicant to file such a request if the decision on the litigation depends on whether the application enjoys provisional protection (Article 47a). If the applicant fails to comply with the said requirement within the time limit no rights may be derived from the application in the legal proceedings.

II

Laying Open of All Applications for Public Inspection

(1) It is not only the applicant who suffers considerable disadvantage from the increasing length of time required for the process of patenting. The interests of the general public are adversely affected, too. Even if they have carried out an apparently exhaustive search, the applicant's competitors introducing a new line have to reckon with the possibility of third parties' prior rights for an increasingly long period of time. It is certainly unavoidable and perfectly justifiable to maintain the secrecy of applications filed with the Patent Office for a certain period of time. But the longer this period lasts the more difficult it becomes to justify the absence of the general public's access to the application. With the lapse of a number of years that had become normal because of the constantly deteriorating state of the German Patent Office's workload, this situation could no longer be tolerated in commerce and industry.

(2) The Government's earliest Bill for what became the Law of September 4, 1967, already contained a proposal to lay

all patent applications open for public inspection, and thus make them accessible to the public, 18 months after the date of priority. This proposal corresponded to the new legislation in the Netherlands, the latest Draft Convention relating to a European Patent Law and the draft of the new Nordic Patent Law. It was thus in line with international trends.

(3) The proposal nevertheless gave rise in Germany to disputes that were no less heated than those concerning the question of deferred examination. The opponents of early publication of all patent applications were particularly worried that they would no longer be able to cope with the "flood" of unexamined applications that would be launched on them. Their opposition was unsuccessful, however. In deciding to go along with the Government's proposal, Parliament was moved primarily by the consideration that industry and commerce were vitally concerned, for the sake of their investment and production planning, in being informed in good time of any obstacles in the form of third parties' rights that their plans might encounter. Parliament was also impressed by the report published at that time by the Commission appointed by the President of the United States of America to report on the patent system, in which the problem was stated in the following concise terms:

"Early publication could prevent needless duplication of the disclosed work, promote additional technological advances based on the information disclosed, and apprise entrepreneurs of their potential liability."

Industry's need for information was further underscored by the fact that many German firms were already able to obtain knowledge of the unpublished patent applications filed with the German Patent Office by the simple expedient of studying the French and Belgian patents published soon after the filing of an application, their assumption that corresponding applications would have been filed in Germany normally proving quite correct. In answer to the objection that the extra workload resulting from the need to study applications published without examination would prove insurmountable, it was replied that the compilation and evaluation of information always entailed work. Those who were daunted by the need for this effort could reject the invaluable advantages offered by early information and accept the risk of discovering subsequently that their technological and economic arrangements had been thwarted by the existence of third parties' exclusive rights.

(4) The new Law therefore provides in Article 24 (3) that anyone so requesting shall be allowed to inspect the files of all patent applications 18 months after the priority date if notice to that effect has been published in the Patent Gazette. On the basis of a special authorization contained in Article 24 (4), second sentence, the Patent Office may also publish, as far as the original documents relating to the application are concerned, the contents of such files in pamphlet form under the name "*Offenlegungsschrift*." The purpose of publishing these documents is not merely to facilitate access to the files but also to ensure that patent applications opened for public inspection by the German Patent Office

will be acknowledged in all other countries as printed early publications.

(5) From the time patent applications are opened for public inspection, they will also enjoy a certain degree of protection, however, under Article 24 (5) of the new Law. This will not be so extensive as what had been proposed in the Government's original Bill. In particular, it seemed unreasonable to Parliament that these normally unexamined applications should give full rights to sue for a preventive injunction and compensation. Article 24 (5) therefore limits protection to the right to claim "such compensation as is appropriate to the circumstances." In other words, use of the subject of an application that has been laid open for public inspection, as opposed to an application that has been formally published after examination, is not prohibited but simply gives rise to entitlement to claim compensation. Under Article 35 (2) and (3), even the effects of such protection become inapplicable, with retroactive effect, if the application is refused or withdrawn, or is considered withdrawn owing to failure to file a request for examination within seven years of the filing of the application or to pay the annual fee in connection with the application in due time.

III

Repeal of Prohibition to Patent Certain Products

(1) It was not until the final stages of the legislative process that it was decided to repeal the provisions, dating back to the earliest days of German patent law, which prohibited the patenting of certain products, and the decision came as a great surprise. The clinching argument lay in the fact that many industrialized countries, including the United States and the United Kingdom, have long since allowed the possibility of obtaining patent rights for such products and that the European Convention on the Unification of Certain Points of Substantive Law on Patents for Invention of November 27, 1963, which has been signed by the Federal Republic of Germany although it has not yet come into force, provides for the introduction of protection for such products. It was also hoped that the decision to introduce protection for such products would help to relieve the pressure on the German Patent Office because it had been found that the existing prohibition induced those filing applications for inventions relating to non-patentable products to try to obtain protection for just about every conceivable process for producing such products in order to achieve in practice what was intended to be excluded through the prohibition in force.

(2) As of now, it is possible for the German Patent Office to grant patents for inventions relating to foodstuffs, alcoholic beverages and tobacco (*Genussmittel*), medicaments, and substances produced by chemical processes. This is the result of the decision to repeal the previously existing prohibition relating to the protection of certain products; the new provisions are contained in Article 1 (2) of the Patent Law and have already been in force since January 1, 1968. They will undoubtedly give rise to numerous practical questions, but it is too early to attempt to answer these. On January 2, 1968, the President of the German Patent Office issued comprehen-

sive preliminary guidelines for the examination of such patent applications. These would seem to indicate that the German Patent Office will, at least in the beginning, follow a restrictive interpretation of the new legal provisions. In this way, it is intended to allow the courts, and in particular the Federal Patent Court and the Supreme Court, to express their views on the new legal problems that are arising and to come to the basic decisions as early as possible, in order to overcome the inevitable initial uncertainty as rapidly as possible.

(3) The parliamentary debates on the question of repealing the prohibition of protection for certain products led to consideration of the possible need to extend the opportunities for the issue of compulsory licenses in view of the reinforcement of patent protection inherent in the general patentability of products. The view prevailed, however, that the essential conditions listed in Article 15 for the issue of a compulsory license, namely that the permission be "required in the public interest," make sufficient allowance for any additional requirements that may arise as a result of the introduction of patentability for certain products. It is intended, incidentally, that the German legal requirements relating to the issue of a compulsory license should be subjected to thorough examination in connection with the forthcoming reform of German substantive patent law and that the existing legal possibilities for the issue of a compulsory license might well be extended if it were revealed, contrary to expectations, that the present wording of Article 15 of the Patent Law is unequal to the situation resulting from the introduction of patentability for certain products.

IV

Compulsory Use Requirement for Trademarks

(1) It had long been felt necessary to introduce a compulsory use requirement for trademarks under German law, because there had been an increasing volume of applications filed which either remained entirely unused after registration or were used only after a very long time or for a small proportion of the goods for which they had been registered. The increasing volume of these reserve or defense marks had led not only to progressive overcrowding of the Trademark Register but also to a great rise in the number of opposition proceedings, with a consequently expanding pressure on the Patent Office. Applicants were finding it more and more difficult to have the trademarks they really needed duly registered. The proposal to introduce a compulsory use requirement that was already contained in the Government's original Bill therefore met with well-nigh unanimous approval, in striking contrast to the patent proposals.

(2) Under the new Law, which came into force on January 1, 1968, the maintenance of and the right to rely upon a registered trademark in opposition proceedings are now essentially dependent on its use. This has the following implications:

(a) The first thing to note is that, in opposition proceedings before the German Patent Office, earlier marks on the basis of which opposition is raised against a newly filed mark are not considered if they have not been used during the five

years preceding the publication of the pending mark (Article 5 (7) of the Trademark Law). Use of the mark by a licensee of the owner of the mark is considered equivalent to use by the owner. Moreover, marks that have been used are considered in opposition proceedings only in accordance with the actual scope of their use. If therefore, as does frequently occur, trademarks are filed and registered in respect of a number of goods and it is then found that they have been used for only some of those goods during the five-year period concerned, the opposition may not be based on the goods for which the mark has not been used.

(b) In addition, a mark may now be canceled upon request, and protection in the Federal Republic of Germany withdrawn from an internationally registered mark belonging to an owner of a foreign mark, if the mark has not been used within five years of its registration with the German Patent Office or its international registration in Geneva or if use of the mark has been interrupted for a period of five years (Article 11 (1) (4) of the Trademark Law). Failure to use the mark does not, however, entail adverse consequences in such cases if there are circumstances owing to which the owner of the mark could not reasonably have been expected to use the mark during the five years preceding the request for cancellation. This provision corresponds to the reservation laid down in Article 5 C (1) of the Lisbon Act of the Paris Convention.

(c) There is no precise ruling as to the area where the mark must be used. According to the principle of territoriality that dominates trademark law, it is to be regarded as implicit that, in principle, only use within the area where the new German Trademark Law is in force is to be considered use corresponding to the new provisions. Owing to the vast range of conceivable forms of use, it was not found possible to settle by law the question of whether and subject to what conditions the use of a trademark abroad, for example in connection with goods exported from Germany, can be held to constitute use of the mark within the meaning of the new Law. It will therefore have to be left to the courts to rule on this question.

(d) Another point deliberately left open was that of deciding what specific acts of use legally constitute use of the mark. It is to be assumed, however, that ostensible acts performed solely to satisfy the legal requirements for allowing a trademark to be relied upon for the purpose of opposition should not be deemed to constitute acts of use. Only those acts of use which correspond in nature, scope and duration to the goal sought by the introduction of compulsory use, namely to counter exercise of purely formal trademark rights, can be recognized as sufficient. In applying and interpreting the new provisions, the Patent Office and the courts will have to ensure that the legislative purpose of introducing compulsory use is attained and is not circumvented by means of purely ostensible acts of use.

(3) The new regulations have introduced the principle of compulsory use in a fairly cautious manner. In particular, it has been made possible to eliminate at any time any consequences of failure to use a trademark by starting to use a mark or resuming its use, provided that no request for can-

cellation was in existence at the time of such first use or resumption of use. Moreover, there is no stipulation that a declaration of use should be made to the Patent Office at the statutory ten-yearly intervals for prolongation of protection of the mark. Parliament did not consider it justifiable to cancel a used mark and perhaps thereby to interfere with valuable property simply because the mark had not been used for a considerable period of time in the past. The principal consideration underlying this decision was that investigation of the factual grounds for a request to cancel a trademark would be made difficult under the existing procedural conditions if the mark were to be liable to cancellation even after many years of use if it had not been in use during some period of five years out of the entire time of its existence since registration. Only the future will show whether the new provisions will be sufficient to give a satisfactory solution to the problems connected with failure to use trademarks. Parliament deliberately chose the path of caution for the time being, with the possibility of considering more stringent measures for dealing with the non-utilization of trademarks should the new provisions prove inadequate.

V

Introduction of the International Classification of Goods

(1) In conjunction with the amendments to the Trademark Law, the German system of classification of goods was also radically changed (appendix to Article 2 (3) of the Law). With effect from October 1, 1968, it is to be entirely replaced by the International Classification of Goods by Ordinance of the Federal Minister of Justice dated December 5, 1967, and issued by virtue of the powers granted under Article 2 (5) of the Law. The International Classification has already played an important part in the business of the German Patent Office because, as a result of the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks, of June 15, 1957, the Office has had to use it as a secondary system of classification in addition to the German one and has therefore had to classify applications twice over. This duplication of effort will now be eliminated through the adoption of the International Classification as the internal German system, which will bring relief to the Patent Office in particular.

(2) However, the replacement of the previous national system by the International Classification called for a rise in the class fees payable at the time of the filing and prolongation of trademarks according to the list of goods covered by the particular mark. The previous German system comprised a total of 58 classes and sub-classes for which a class fee was payable in respect of each filing and prolongation if the list of goods covered by the trademark referred to those classes. The International Classification contains only 34 classes. In order to avoid an unjustifiable reduction of the total fees payable by the mark holder concerned and in order to keep the overall burden at roughly the same level, the class fees are to be raised with effect from October 1, 1968, for both filing and prolongation. Leaving aside certain adjustments to produce a round figure, the degree of increase

corresponds to the proportion between the number of classes subject to payment of fees under the previous German system and under the International Classification, respectively.

VI

Transitional Provisions

The far-reaching procedural and substantive changes incorporated in German patent and trademark law under the Law of September 4, 1967, naturally necessitated comprehensive transitional provisions, which are of particular importance with regard to patent and trademark applications already pending at the time of the entry into force of the new Law. These transitional provisions are contained in Article 7 of the Law, and lay down the following:

(1) In the case of those patent applications whose formal publication will already have been decided upon by the Patent Office before the Law enters into force on October 1, 1968, for which the examination procedure will already have been concluded and which will therefore remain subject only to the opposition procedure, the situation will stay essentially unchanged. The system of deferred examination cannot be applied in respect of such applications because they will already have been subjected to examination. The same is true of patent applications rejected after full examination as to patentability since for them, too, the examination procedure, which is to be "deferred" under the new provisions, will have already taken place.

(2) All other applications filed before October 1, 1968, and not yet dealt with by that time will be subject in principle to the new provisions, specially to those relating to deferred examination, but with some peculiarities:

(a) These applications, too, will be laid open for public inspection 18 months after the priority date, but not less than six months after the applicant has been informed. Until the expiry of this six-month period, the applicant may file new full application documents. If he makes use of this possibility, public inspection will be provided only as concerns the new documents.

Announcement of these applications began as of January 1, 1968. It is intended that some 2,000 will be announced per week out of the total of some 250,000 coming into consideration, with a view to liquidating the whole backlog of unprocessed applications within two and a half to three years. Since all of these applications will be published after the expiry of six months from the announcement, industry is going to be confronted with a great volume of printed patent documents in the next few years.

(b) Isolated search cannot be requested for these applications. This exception had to be made because otherwise the Patent Office would have been totally incapable of handling the anticipated volume of work. Thus it is only possible to file a request for examination of these applications. The necessary search concerning the state of the art will then take place, of course, as part of the examination procedure.

(c) For applications that have been pending for over five years at the time of the entry into force of the Law on October 1, 1968, the period of time for filing a request for examination will end only two years after announcement of those applications, instead of the normal seven years from the time of filing the application.

(d) If the applicant files a request for examination, the application fee will be counted towards the examination fee, which will thus be reduced in such instances from DM 300 to DM 250.

(3) Patent protection for foodstuffs, alcoholic beverages and tobacco (*Genussmittel*), medicaments, and substances produced by chemical processes, as introduced with effect from January 1, 1968, may also be claimed for applications filed with the German Patent Office before January 1, 1968, for which a priority before that date is requested. In such cases, however, third parties which had begun to make use of the invention described in such an application in the Federal Republic of Germany before January 1, 1968, or which had made the necessary arrangements for this purpose, will be permitted to continue such use free of charge. The intention is to protect those persons who had relied on the traditional prohibition of protection of certain products before that prohibition was repealed.

(4) For trademarks already entered in the Trademark Register of the German Patent Office as of January 1, 1968, the five-year period for the commencement of use begins from January 1, 1968, only. This transitional provision is necessary for constitutional reasons because otherwise the new Law would lead to interference in properly acquired rights. This means that legal claims resulting from the introduction of compulsory use cannot be effective before January 1, 1973.

VII

Consolidated, New Edition of the Industrial Property Laws

The Law of September 4, 1967, amended the German industrial property laws in so many respects that it was felt necessary to publish them in a consolidated new edition. On January 2, 1968, the Federal Minister of Justice made use of the empowering clause in the Law allowing such publication. On that day, new versions of the Patent Law, the Utility Model Law, the Trademark Law, and the Law on Patent Office and Patent Court fees, were published by means of a special announcement, a translation of the consolidated version of the Patent Law being reproduced in this issue of *Industrial Property*. These new versions of January 2, 1968, represent the latest consolidation of German law in the field of industrial property and also show the numerous new provisions in their relationship to the parts remaining unchanged. They will remain the dominant legal foundation until the general reform of German law in this field, mentioned at the outset, is introduced, and that probably means until well into the 1970s, even though they may be altered in the meantime in less important points of detail. For the time being, there is no likelihood of any other substantial changes in German industrial property law.

NEWS CONCERNING INTERNATIONAL ORGANIZATIONS OTHER THAN BIRPI

The Second Session of the United Nations Conference on Trade and Development

The Second Session of the United Nations Conference on Trade and Development ("UNCTAD II") took place in New Delhi from February 1 to March 29, 1968. It brought together 1,500 delegates from 121 countries and numerous international organizations. BIRPI was represented during the earlier part by Mr. I. Morozov, Counsellor, Industrial Property Division, and during the latter part by Mr. R. Woodley, Senior Counsellor for Relations with International Organizations.

The agenda and discussions ranged over every facet of trade and development, but this note deals only with the few references which were made in the Conference to patents.

The agenda included an item entitled "transfer of technology including know-how and patents." This was allotted to a Working Group to report directly to the Plenary of the Conference.

Meanwhile, the question of the transfer of technology particularly in its patent aspects had been highlighted by Mr. Philippe de Seynes, UN Under Secretary-General for Economic and Social Affairs, in his statement to the Plenary, in the course of which he said:

"The problems involving international mechanisms for the transfer of technology are complex. For a long time, the patent and license system was the chief vehicle for the dissemination of modern technology throughout the world. That it is still required to play an important role is amply demonstrated by the number of patent applications filed, even if they now cover only part of the technology concerned. However, a host of obstacles are preventing the less-developed countries from gaining access to foreign technology despite the attempts made to adapt the patent system to the development of international trade. Indeed the difficulty lies largely in the *embarras de richesses* resulting from the constant rise in the rate of innovation. In twenty-three countries, including four less-developed nations, the patent offices are receiving 5,000 applications for patents a year. In six of these countries, the number is ten times as high and, in the case of the USSR and the United States, about one hundred thousand inventions are filed every year. There is therefore a tremendous problem of organization to which the international agencies cannot remain indifferent. The number and variety of processes among which choices must be made far exceeds the capacity for assessment and analysis at the disposal of most countries of the third world and, it must be said, of many industrialized countries. Any attempt to absorb such a vast supply of information will require some form of international arrangement. One of the most significant efforts is that known by its initials 'ICIREPAT' (Committee for

International Cooperation in Information Retrieval among Examining Patent Offices) which has a membership of some twenty industrialized countries in the East and West, and seeks to devise a system of computerizing the technical data through their uniform classification. This is a long-term project, but, in view of its importance to the industrialized countries themselves, it can be expected to be carried out with great energy and to result in the creation of centralized storage facilities and of exchange networks in which the developing countries can readily participate at little cost.

"As pointed out in a recent United Nations survey entitled 'The role of patents in the transfer of technology to developing countries'¹⁾, the patent system can be of great benefit in the industrialization of the less-developed countries, provided that they are able to protect themselves against the abuses often inherent in the monopoly position created by the patent. This position is tolerable so long as it is temporary and involves genuinely new and useful inventions. Many countries simply do not have the know-how and personnel to examine applications with these criteria in view. Consequently many patents are issued without justification and impose unfair restrictions on imports and production. Investors are thus robbed of the incentives they normally have under satisfactory patent systems. The creation of Regional Patent Cooperation Centers, in which technical facilities would be pooled by several countries, as well as the Patent Cooperation Treaty being prepared under the auspices of the Bureau of the International Union for the Protection of Industrial Property with the participation of the International Patent Institute at The Hague, which contemplates the establishment of an international system of examination for use by patent offices in different countries, would do much to improve the situation, and such projects should be encouraged by the United Nations.

"Still, even with all these possible arrangements, the fact remains that the patent and license system can no longer play as important a role in the transfer of technology as it did in the past. Modern technological processes and innovations are often far too complex to lend themselves to the simple act of identification entailed in the registration and issue of a patent. What is 'patentable' is only a part of the total technological knowledge and know-how necessary for the application of technical innovations."

*

The Working Group to which transfer of technology was allotted also had on its agenda the item dealing with the World Food Program, and most of the meetings allocated to the Group were taken up with that item. In the end, only two and a half meetings were left for transfer of technology.

These were mainly devoted to general debate and settling the Group's report. The representative of BIRPI made a statement in which he outlined the program of BIRPI for the benefit of developing countries and emphasized the importance of a patent system in developing countries under suitable legislation properly administered as a prerequisite for the

¹⁾ United Nations publication, Sales No. 65.II.B.1.

attraction of foreign technology and an encouragement to the investment of foreign private capital. Many of the comments referred to the difficulties of the patent system for developing countries although it had been explained that most of the shortcomings could be overcome by appropriate legislation.

Too late to be debated in the Group, a draft resolution sponsored by four developing countries was introduced requesting that the Trade and Development Board should contemplate setting up a Committee of the Board to consider the whole subject of the transfer of technology including the effects of the patent system. Without debate, this was referred to the Plenary for consideration.

In Plenary, this draft came under considerable criticism, mainly on the ground of unnecessary expense and the likelihood of duplication with the work of existing bodies. The sponsors amended the draft to the effect that the Board should consider setting up the Committee "after obtaining the views of the Economic and Social Council," but the opponents of the draft did not think this helped very much. The Advisory Committee on the Application of Science and Technology to Developing Countries and BIRPI were especially singled out as bodies whose work was certain to be duplicated. After a lively debate, a motion merely "to take note" of the draft was rejected, but another proposal to refer it to the Seventh Session of the Trade and Development Board in Geneva in September was adopted.

In both the Working Group and in Plenary, there were many appreciative references to the work of BIRPI in the patent field.

Two other resolutions also mentioned patents but only as elements of larger questions.

The Second Committee had before it a draft on restrictive business practices which cited the use of patents as a restrictive device. The draft requested the Secretary-General of UNCTAD to make a study of all restrictive practices with the help of a group of non-governmental experts and to present it to the Third Session of the Committee on Manufactures. For lack of time, this draft was not debated in Plenary and was transmitted to the Trade and Development Board for its consideration.

General Assembly resolution 2091 (XX) and Economic and Social Council resolution 1201 (XLII) called on the Secretary-General of the United Nations to study the manner, forms, conditions, costs and effects of transfer of patented and non-patented technology, from foreign enterprises to enterprises in developing countries (both public and private). The Third Committee had before it a draft resolution which asked the Secretary-General in making these studies to consider a number of factors set out in the resolution, including "restrictive business practices affecting the granting of patents, licenses and know-how by foreign enterprises" and "restrictions imposed by foreign enterprises on exports of products resulting from foreign investment and/or grant of patents and licenses." The Secretary-General was also asked to consider the outflow of funds from developing countries in various forms, including royalties. This draft resolution was adopted by the Plenary without comment.

African and Malagasy Industrial Property Office Inauguration of the New Headquarters

The new headquarters of the African and Malagasy Industrial Property Office (OAMPI) were inaugurated on April 10, 1968, at Yaoundé, Cameroon.

At the present time, OAMPI has 13 members (Cameroon, Central African Republic, Chad, Congo (Brazzaville), Dahomey, Gabon, Ivory Coast, Madagascar, Mauritania, Niger, Senegal, Togo, Upper Volta), all of which are also members of the Paris Union.

Mr. John Ngu Foncha, Vice-President of the Federal Republic of Cameroon, and Mr. Simon Pierre Tchoungui, Prime Minister of East Cameroon, were present at the inauguration, as well as representatives of a number of countries both members and non-members of OAMPI. BIRPI was represented by Dr. Arpad Bogsch, Deputy Director.

Mr. Denis Ekani, Director General of OAMPI and the person mainly responsible for the establishment of the new headquarters, received the visitors. He gave two splendid receptions, one at the headquarters and the other at his official residence. Among those present were numerous high officials of the Federal Cameroon Government, the members of the OAMPI Board of Directors, the officers of OAMPI, visitors from abroad, and almost the entire diplomatic corps of Yaoundé.

The chairman of the OAMPI Board of Directors, Mr. Barkire Alidou (Republic of the Niger) made a speech in which he said, in particular:

"Having made a painfully slow start, mostly owing to our lack of experience in the management of industrial property rights, OAMPI has made remarkable progress both from the standpoint of facilities and from the standpoint of administrative and technical capability. The sacrifices that have been made in order to achieve this result demonstrate the importance attached by our countries to the protection of industrial property in general and to the African and Malagasy Industrial Property Office in particular.

"The dream of establishing industrial property offices that would be competent over a territory comprising a number of States is an old one which had only been realised to a very limited extent by the Paris Convention of March 20, 1883. Thanks to the creation of the African and Malagasy Industrial Property Office, this dream became true on September 30, 1962, and exemplifies a commendable desire to respect the sovereignty of States, a regard for efficiency through centralization of effort, and a remarkable concern for economy of means. This is the reason for the considerable number of applications received by our Office. It is also the reason why our Office is one of the rare inter-African organizations to be self-supporting and the only industrial property office to make some profit.

"At the same time, the Office offers enormous advantages to applicants since a single registration made by one of its services ensures protection in all of the member States. Hence, our organization stimulates research and promotes the transfer of technical knowledge. This means that the African and

Malagasy Industrial Property Office is an important factor in the promotion of our economies for, although in the past economic development has been linked at times to natural factors and at other times to demographic factors, it is now primarily dependent on technical progress.

“OAMPI thus meets three of the current needs of developing countries:

- the need for regional regroupings;
- the need for international cooperation;
- the need for economic and technical development.”

CALENDAR OF MEETINGS

BIRPI Meetings

Date and Place	Title	Object	Invitations to Participate	Observers Invited
1968				
June 24 Geneva	Committee of Directors of National Industrial Property Offices of the Madrid Union (Marks)	Administrative questions	All member States of the Madrid Agreement (Marks)	—
June 28 *) Geneva	Committee for International Cooperation in Information Retrieval among Examining Patent Offices (ICIREPAT) - Enlarged Transitional Steering Committee	Questions of technical cooperation	Germany (Fed. Rep.), Japan, Netherlands, Soviet Union, Sweden, United Kingdom, United States of America	International Patent Institute
July 1 to 5 Paris (Unesco Headquarters)	Committee of Experts on the Photographic Reproduction of Works Protected by Copyright, convened jointly with Unesco	To examine the copyright problems raised by the reproduction of protected works by photographic or analogous processes and to formulate appropriate recommendations with a view to possible solutions	Argentina, Bulgaria, Congo (Kinshasa), Czechoslovakia, France, India, Iran, Japan, Lebanon, Mexico, Nigeria, Netherlands, Spain, Sweden, United States of America. Consultants from Germany (Fed. Rep.) and the United Kingdom	<i>Intergovernmental Organizations:</i> United Nations and Specialized Agencies <i>Non-Governmental Organizations:</i> International Confederation of Societies of Authors and Composers (CISAC); International Congress on Reprography; International Council on Archives; International Federation for Documentation; International Federation of Library Associations; Internationale Gesellschaft für Urheberrecht; International Law Association; International Literary and Artistic Association; International Publishers Association
September 24 to 27 Geneva	Interunion Coordination Committee (6th Session)	Program and Budget of BIRPI for 1969	Argentina, Australia, Austria, Belgium, Brazil, Cameroon, Denmark, France, Germany (Fed. Rep.), Hungary, India, Iran, Italy, Japan, Kenya, Morocco, Mexico, Netherlands, Poland, Portugal, Rumania, Soviet Union, Spain, Sweden, Switzerland, United Kingdom, United States of America	—
September 24 to 27 Geneva	Executive Committee of the Conference of Representatives of the Paris Union (4th Session)	Program and Budget (Paris Union) for 1969	Argentina, Australia, Austria, Cameroon, France, Germany (Fed. Rep.), Hungary, Iran, Japan, Kenya, Morocco, Mexico, Netherlands, Poland, Soviet Union, Spain, Sweden, Switzerland, United Kingdom, United States of America	All the other member States of the Paris Union; United Nations; International Patent Institute; Council of Europe

*) Changed from May 3 and 4.

Date and Place	Title	Object	Invitations to Participate	Observers Invited
October 2 to 8 Locarno	Diplomatic Conference	Adoption of a Special Agreement Concerning the International Classification of Industrial Designs	All member States of the Paris Union	States not members of the Paris Union <i>Intergovernmental Organizations:</i> United Nations; Unesco; Council of Europe <i>Non-Governmental Organizations:</i> Committee of National Institutes of Patent Agents; Inter-American Association of Industrial Property; International Association for the Protection of Industrial Property; International Chamber of Commerce; International Federation of Patent Agents; International League Against Unfair Competition; International Literary and Artistic Association; Union of European Patent Agents
October 21 to November 1 Tokyo	Committee for International Cooperation in Information Retrieval among Examining Patent Offices (ICIREPAT) - Technical Meetings	Questions of technical cooperation in information retrieval	All members of ICIREPAT	International Patent Institute; Council of Europe; European Atomic Energy Community; Fédération internationale de documentation
November 25 to 29 Geneva	BIRPI Symposium on Practical Aspects of Copyright (held with the cooperation of CISAC)	To offer to participants information on practical aspects of copyright protection (collection and distribution of royalties, organization and working of authors' societies or other bodies, etc.)	Personalities from developing countries. Individual participants against payment of a registration fee	—
December 2 to 10*) Geneva	Committee of Experts — Patent Cooperation Treaty (PCT)	New Draft Treaty	All member States of the Paris Union	<i>Intergovernmental Organizations:</i> United Nations; United Nations Industrial Development Organization; United Nations Conference on Trade and Development; International Patent Institute; Organization of American States; Permanent Secretariat of the General Treaty for Central American Economic Integration; Latin-American Free Trade Association; Council of Europe; European Atomic Energy Community; European Economic Community; European Free Trade Association; African and Malagasy Industrial Property Office <i>Non-Governmental Organizations:</i> Committee of National Institutes of Patent Agents; Council of European Industrial Federations; European Industrial Research Management Association; Inter-American Association of Industrial Property; International Association for the Protection of Industrial Property; International Chamber of Commerce; International Federation of Patent Agents; Japan Patent Association; National Association of Manufacturers (U. S. A.); Union of European Patent Agents; Union des industries de la Communauté européenne

*) This meeting replaces the meetings previously announced for July 1 to 9, and November 4 to 12, 1968.

Meetings of Other International Organizations Concerned with Intellectual Property

Place	Date	Organization	Title
1968			
Prague	May 1 to 5	International League Against Unfair Competition (LICCD)	Symposium
Amsterdam	June 9 to 15	International Publishers Association (IPA)	Congress
Strasbourg	June 17 to 21	Council of Europe	Working Party of the Committee of Experts on Patents
Vienna	June 24 to 29	International Confederation of Societies of Authors and Composers (CISAC)	Congress
The Hague	July 8 and 9	International Patent Institute (IIB)	97 th Session of the Administrative Council
Lima	December 2 to 6	Inter-American Association of Industrial Property (ASIPI)	Congress

VACANCIES FOR POSTS IN BIRPI

Applications are invited for the following posts:

*Competition No. 60**Second Deputy Director or Assistant Director**Category:*

According to the qualifications and experience of the candidate selected, an appointment will be offered either as Second Deputy Director or as Assistant Director.

Duties:

The duties of the post consist, in general, in assisting the Director of BIRPI in organizing and implementing the tasks of BIRPI.

Qualifications:

- (a) wide experience in the field of industrial property law and in the field of copyright law — particularly in their international aspects — or at least in one of these two fields, preferably with some experience in the other;
- (b) wide experience in administrative matters, preferably in connection with international organizations;
- (c) university degree in law or equivalent professional qualification;
- (d) excellent knowledge of one of the official languages (English and French) and at least a good knowledge of the other. Knowledge of additional languages would be an advantage.

Nationality:

Candidates must be nationals of one of the member States of the Paris Union or of the Berne Union.

Age limit:

Less than 55 at the date of appointment.

Date of entry on duty:

January 1, 1969, or a later date as mutually agreed.

Applications forms and full information regarding the *conditions of employment* may be obtained from the Head of Personnel, BIRPI, 32, chemin des Colombettes, 1211 Geneva, Switzerland.

Applications forms duly completed should reach BIRPI *not later than July 31, 1968.*

*Competition No. 59**Assistant
(Developing Countries)*

(Fixed term appointment for two years with the possibility of renewal)

*Category and Grade: P 3.**Principal duties:*

In general, to assist in the formation and implementation of BIRPI programs concerning assistance to developing countries.

The particular duties will include:

- (a) correspondence and contacts with representatives of developing countries;
- (b) participation in international meetings dealing with questions of particular interest to developing countries;
- (c) studying and preparing documents on questions of technical assistance to developing countries in the field of industrial property and copyright.

Qualifications:

- (a) university degree or equivalent qualification;
- (b) experience in the field of industrial property or copyright (preferably including their international aspects) with particular knowledge of conditions in developing countries;
- (c) experience in the work of intergovernmental agencies would be an advantage;
- (d) excellent knowledge of one of the official languages (English and French) and at least a good knowledge of the other.

Date of entry on duty: August 1968.

Nationality:

Candidates must be nationals of one of the member States of the Paris or Berne Unions. Qualifications being equal, preference will be given to candidates who are nationals of States of which no nationals are on the staff of BIRPI.

Age limit:

The candidate designated must be less than 50 years of age at the date of appointment.

Application forms and full information regarding the *conditions of employment* may be obtained from the Head of Personnel, BIRPI, 32, chemin des Colombettes, 1211 Geneva, Switzerland.

Application forms duly completed should reach BIRPI *not later than June 30, 1968.*