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VI.C Intellectual Property Law in Germany

by Stephan Bahner

1. Introduction

Intellectual property (IP) rights can be valuable assets both for business entities and for private individuals. The owner of an IP right has the exclusive right to use the protected item. This means that he can exclude other persons from use of his protected asset. He may then market the relevant product himself and license the right to third parties so that they may produce and distribute related products. Under German IP law, know-how normally needs to take physical form in order to be protected as an IP right. It is possible to protect know-how by way of contractual obligations (in particular by way of **non-disclosure agreements**), but such agreements are only effective between the contracting parties and not in respect of third parties. The recent act of harmonisation with regard to the protection of trade secrets within the European Union (Directive (EU) 2016/943) does not provide for an exclusive right to know-how or trade secrets either.

There is a distinction between **industrial property rights** (*gewerbliche Schutzrechte*), such as trade marks and patents, and non-industrial property rights, such as copyright. There is a further distinction between technical property rights, such as patents and utility models, and creative property rights, such as designs or copyright protected works.

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The following overview of the extensive legislation will describe the most significant IP rights. The more specific legislation (e.g. the Semiconductor Protection Act – *Halbleiterschutzgesetz*) will not be discussed here. This overview is intended to give information on the main statutory provisions and the main risks to be considered by persons doing business in Germany.

Part 6 below describes possible **remedies** for the **infringement** of IP rights. In this regard it should be borne in mind that once the protected (e.g. patented or branded) products have been put on the market in the European Community (or the European Economic Area) by the right's owner or with his consent, the rights become **exhausted**. In this event the owner of the IP right may not take action against the resale of such products.

Although **competition law** (within the meaning of unfair competition but not antitrust law) does not grant exclusive IP rights to companies or individuals; the German Act on Unfair Competition (*Gesetz gegen den unlauteren Wettbewerb/UWG*) is relevant and will be discussed here. Practices that may seem to relate to IP rights often turn out to relate to unfair competition, and vice versa. It is therefore useful to include an overview of what is deemed to be **unfair commercial practice** in Germany.

2. Patents and Utility Models

2.1 General

Both **patents** and **utility models** are IP rights relating to technical knowledge. The relevant statutes are the German Patent Act (*Patentgesetz/PatG*) and the Utility Model Act (*Gebrauchsmustergesetz/GebrMG*). An important difference between these two rights is that a patent requires an

invention that is being considered a **teaching for technical action** (*Lehre zum technischen Handeln*), meaning directions according to a plan using controllable natural forces in order to achieve a result with a clear cause and effect. A utility model, on the other hand, requires an **inventive step** (implying a less active process of invention), and can be considered as a "small patent". An invention can therefore be protected either as a utility model or as a patent.

The German Patent and Trademark Office (*Deutsches Patent- und Markenamt*/DPMA), which maintains both the register of patents and the register of utility models, examines whether the requirements of the application have been duly met. The DPMA will register a utility model even if only the procedural requirements have been met. The DPMA does not check whether the substantive requirements for protection as a utility model are fulfilled. The **substantive review** takes place before the court which has jurisdiction in the case of an infringement. Therefore, a utility model is deemed to be an **unverified IP right** (*ungeprüftes Schutzrecht*). Contrary to that the DPMA extensively checks whether both procedural and substantive requirements of a are fulfilled.

2.2 Requirements for protection

2.2.1 Substantive requirements

According to Sec. 1 (1) *PatG* patents shall be granted for inventions in any technical field if they are **novel**, involve an **inventive action** and are **suitable for commercial application**. The term 'invention' is not defined by statute, however, an invention is generally considered to be a teaching for technical action that solves a technical problem.

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An invention is considered novel if it does not form part of the **state of the art**. The state of the art includes all knowledge made available to the public by written or oral description, by use or by any other manner before the date of filing of the application (Sec. 3 (1) *PatG*). If the **inventor** were to publish the invention before the **filing date**, the consequence would be that the invention would no longer be novel on the filing date. Inventors must therefore keep their invention secret before filing the application, which is an issue, because the invention must also be usable for commercial purposes at the time the application is filed.

An invention is deemed to involve an inventive action if it is not obvious to a **person skilled in the art** from the state of the art (Sec. 4 (1) *PatG*). An invention is deemed to be suitable for commercial application if the subject of the same can be produced or used in an industrial context, including agriculture (Sec. 5 (1) *PatG*).

According to Sec. 1 (3) *PatG* the following subjects are excluded from **patent protection**: scientific theories, mathematical theories, aesthetic creations, schemes, rules, methods for mental acts, languages or business activities as well as computer programs and presentations of information. This is because, as stated above, an invention must comprise a teaching for technical action. Inventions must make use of **controllable forces of nature**, which is why theories, schemes, rules and methods are not eligible for patent protection. Indeed, such intangible subjects are hardly **capable of protection** under German laws at all. In addition, aesthetic creations do not contain a teaching for technical action (they can be protected as design models, trade marks or by copyright).

Patents are normally divided into '**product patents**' (*Erzeugnispatente*) and '**process patents**' (*Verfahrenspatente*). This distinction is important to **the scope of protection** as laid

down in Sec. 9 *PatG*. Product patents cover any concrete product that was manufactured on the basis of the relevant instruction (Sec. 9 No. 1 *PatG*). Process patents cover the application of a concrete process (Sec. 9 No. 2 *PatG*) as well as the direct products manufactured on the basis of such a process (Sec. 9 No. 3 *PatG*).

In contrast to patents, utility models do not necessarily need to involve an inventive action, but they do require an inventive step (Sec. 1 (1) *GebrMG*). They must also be new and suitable for industrial application. Furthermore, it is not possible to obtain protection for a process as a utility model.

2.2.2 Procedural requirements

Registration is required in order to obtain a patent or a utility model.

One may either file for registration of a patent with the DPMA in order to obtain protection in Germany, or file for registration with the European Patent Office as a European Patent and request protection for Germany (according to the regulations of the European Patent Convention), or file for international registration with the World Intellectual Property Organization (WIPO) and request protection in Germany (according to the regulations of the Patent Cooperation Treaty).

Utility models are also registered with the DPMA.

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2.3 Ownership

The invention and the right to the patent belong to the inventor (or his successor). If two or more people made the invention they are considered **joint inventors**.

If the invention was developed by an employee the right to the invention belongs to the employer if the employee acted in the execution of his tasks or followed instructions given by his employer according to the Act on Employee Inventions (*Arbeitnehmererfindungsgesetz/ArbnEG*): The employee must have immediately reported the invention to the employer (Sec. 5 *ArbnEG*) who must then **claim the invention** with reference to the employee (Sec. 6 (1) *ArbnEG*). Until 30 September 2009 the employer was obliged to formally claim the invention within four months of the employee's report. In the event that the employer failed to take the correct steps to claim the invention, it became available to the employee. Since 1 October 2009 any rights related to an invention will automatically be **transferred** to the employer if he does not formally **release** it (Sec. 6 (2) *ArbnEG*). In the event that the employer claims the invention (according to Sec. 6 (1) or (2) *ArbnEG*) he is obliged to pay the employee an adequate **reward** (Sec. 9 *ArbnEG*). The invention is only made available to the employee if the employer expressly releases it (Sec. 8 *ArbnEG*).

2.4 Application proceedings, duration

2.4.1 Patent

According to Sec. 44 *PatG* the DPMA will duly check whether the invention meets the procedural and substantive requirements (**novelty**, inventive step, industrial applicability and technical character). The examination for novelty is very extensive in particular. An invention is

not new if it was **made available to the public** by any means, anywhere in the world, before the date of filing (including written or oral descriptions, use or exhibitions). As a result of that situation several years might elapse before a patent is granted.

The invention is **disclosed** (*Offenlegung*) by the DPMA during the course of the application process and this should be considered before applying for a patent. There may be situations where it is more beneficial to refrain from applying for patent registration in order to keep the idea secret.

One of the most important elements of a patent application (Sec. 34 *PatG*) is the patent claim(s). The patent claims define the scope of the patent (Sec. 14 *PatG*) and, therefore, need to be worded very precisely.

Due to the importance of a patent application being correctly drafted, particularly with regard to the patent claims, it is recommended that an applicant seeks the advice of a patent attorney during the application process. In the event that a patent claim is not correctly drafted, the scope of the patent may be reduced. A later amendment or **supplemental application** is not possible since the invention is not considered new anymore (due to the fact that it was made public during the course of the first application).

The **term of protection** for a patent is twenty years from the date of filing the application (Sec. 16 (1) *PatG*).

2.4.2 Utility model

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Given that the DPMA only checks procedural requirements before registering a utility model application, it is cheaper and faster to gain protection through a utility model than by patent. In contrast to that, the term of protection of a utility model is ten years from the date of filing the application (Sec. 23 (1) *GebrMG*).

2.5 Infringement of patents or utility models

2.5.1 Patents

According to Sec. 9 *PatG* a patent has the effect that only the **patentee** is authorised to use the patented invention in accordance with applicable law. A third party who does not have the consent of the patentee is prohibited from making, offering, placing on the market, using, or importing a product which is the subject matter of the patent or importing or storing the product for such purposes as well as from using a process which is the subject matter of the patent. Furthermore, when the third party is aware of the fact or if it is obvious from the circumstances that use of the process is prohibited without the consent of the patentee, he is barred from offering the process for use within the territory to which the Act applies and from offering, placing on the market, using, importing or storing for such purposes.

2.5.2 Utility models

Section 11 (1) *GebrMG* provides that the particular effect of registration of a utility model is that the **holder** alone is authorised to use the subject matter of the utility model. A person not having the consent of the holder is prohibited from making, offering, putting onto the

Intellectual Property Law Glossary

abandonment of mark	Aufgabe einer Marke
access (to the original)	Zugang (zum Original)
acknowledgement	Eigentumshinweis, Nennung des Urhebers; Anerkenntnis
acquiescence	Duldung, stillschweigende Billigung
actionable	einklagbar
actual damages	Ersatz des tatsächlich entstandenen Schadens, echter/adäquater Schaden(s)ersatz
adaptation	Bearbeitung (eines literarischen oder musikalischen Werks)
administrative procedure	Verwaltungsverfahren
administrative proceedings	Verwaltungsverfahren
affix (to)	anbringen
agency	Behörde, Amt
alteration	Änderung
amend an application (to)	einen Antrag ergänzen
appeal	Rechtsmittel, Berufung
appeal (to)	Rechtsmittel erheben, berufen
appeal a decision rendered by an agency (to)	eine verwaltungsbehördliche Entscheidung bekämpfen
applicant	Antragsteller, Anmelder
application	Antrag, Anmeldung
application form	Antragsformular, Anmeldeformular
appropriation	Zuerkennung, Zuordnung
arbitrary mark	Fantasiemarke, keine beschreibende Qualität
artistic merit	Werkhöhe
artistic quality	künstlerisches Potential
artistry	künstlerisches Geschick, Kunstfertigkeit
assent	Zustimmung, Genehmigung
assign (to)	abtreten
assignee	Übernehmer
assignment	Abtretung
assignment deed	Abtretungsurkunde, Abtretungsvertrag
assignment of all rights (pertaining) to patent	Abtretung aller Patent(nutzungs)rechte
assignment of mark	Markenabtretung
assignor	Abtretender
author	Urheber
badge of origin	Zeichen/Angabe über die Herkunft
bar (to)	ausschließen

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bar appropriation (to)	Zuteilung/Eintragung ausschließen
bar later use (to)	späteren Gebrauch ausschließen
barred from registration	von der Registrierung ausgeschlossen
become publicly available (to)	öffentlich zugänglich werden
blurring (distinctiveness of a mark)	Schwächen (der Unterscheidungskraft einer Marke)
breach of duty	Obliegenheitsverletzung, Pflichtverletzung
bring proceedings (to)	ein Verfahren einleiten, Klage einbringen
broadcast (to)	senden, übertragen, ausstrahlen
burden of proof	Beweislast
cancellation proceedings	Löschungsverfahren
candor	Aufrichtigkeit (Pflicht zur vollständigen Offenlegung aller relevanten Umstände)
case law	Präzedenzrecht, Richterrecht; Judikatur, Rechtsprechung
causal connection	kausaler/ursächlicher Zusammenhang
cause of action	Klagsgrund, Klagegrund
certification mark	Gütezeichen, Prüfzeichen
charge of infringement	Vorwurf des Eingriffs
circumvent (to)	umgehen
cite (a) reference(s) (to)	bereits eingetragene Patente anführen, Ähnlichkeitsprotokoll
claim	Anspruch
clear and convincing evidence	klarer und überzeugender Beweis
coin a mark (to)	eine Marke prägen
coincidence	Zufall
collaboration	Gemeinschaftswerk/-arbeit
collective mark	Kollektivmarke
commercial use	gewerbliche Nutzung
commissioned work	Auftragsarbeit
common name	allgemein gebräuchliche Bezeichnung
common terms	allgemein gebräuchliche Begriffe (Freihaltebedürfnis*)
communication	Schriftverkehr, Verständigung
competitor	Mitbewerber
composite mark	zusammengesetzte Marke
compulsory licensing	Zwangslizenz
conduct	Verhalten
conduct a search of past patents (to)	eingetragene Patente recherchieren
confer a right (to)	ein Recht übertragen
confidentiality	Vertraulichkeit
confiscation	Einziehung

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conflicting interests	gegensätzliche Interessen, Interessensgegensatz/ -konflikt
conflicting mark	vorhandene/ältere/frühere Marke
confusingly similar	verwechslungsfähig ähnlich
consideration	Gegenleistung
constructive notice	Publikationswirkung* (schließt späteren gutgläubigen Erwerb/Gebrauch sowie jede territoriale Einschränkung aus)
construe (to)	auslegen
contest a patent (to)	ein Patent anfechten
contest a patent by a request to the Patent Office to re-examine (to)	ein Patent mittels Antrag auf neuerliche Prüfung an das Patentamt anfechten
contest a patent by an infringement suit (to)	ein Patent im Zuge einer Patenteingriffsklage anfechten
contributory infringement	Patenteingriff durch Verkauf von ausschließlich im Zusammenhang mit patentgeschützten Waren verwendbaren Produkten
conviction on indictment	Verurteilung nach Anklageerhebung
copying	Nachahmen
copyist	Nachahmer; Abschreiber
copyright	Copyright, Urheberrecht*
copyright claimant	Anspruchswerber
copyright infringement	Urheberrechtsverletzung
copyright infringement action	Urheberrechtsklage
copyright notice	Urheberrechtsvermerk; Anzeige- bzw. Hinterlegungspflicht betreffend geschützte Objekte (an Copyright Office Library of Congress) als Voraussetzung für die gerichtliche Durchsetzung von Ansprüchen
Copyright Office	für Copyright-Sachen zuständige US-Behörde
copyright owner	Copyright-Inhaber
copyright work	urheberrechtlich geschütztes Werk
copyrightability	Copyright-Schutzfähigkeit
copyrightable	schutzfähig
copyrightable matter(s)	schutzfähige Objekte
copyrighted material	durch Urheberrecht geschütztes Material
costs	Kosten
court	Gericht
craftsmanship	handwerkliche Kunst, Verarbeitung
creation of the mind	geistige Schöpfung
creative effort	künstlerische Leistung, Werkhöhe*
creative work	geistige Schöpfung
creator	Verfasser, Urheber

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