



Guidelines for Opposition, Revocation and Limitation Proceedings before the DPMA

of 3 July 2018

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Preliminary remarks

These Guidelines replace the Guidelines for opposition proceedings before the DPMA of 18 January 2007¹ as of 1 August 2018 and are also applicable to proceedings initiated before 1 August 2018.

The Guidelines contain the basic principles applicable to opposition, revocation and limitation proceedings before the German Patent and Trade Mark Office (DPMA). They are to facilitate the uniform and expeditious handling of the proceedings concerning the maintenance or revocation or limitation of the patent by the patent divisions of the DPMA and provide corresponding guidance. Orders contrary to the Guidelines are hereby repealed.

The publication of the Guidelines is intended to provide information to the parties to the proceedings and the public.

The parties to the proceedings are to consider the Guidelines within the framework of their obligations to cooperate and thus assist in the uniform and streamlined execution of the opposition, revocation and limitation proceedings. The collaborative participation in the proceedings can make a significant contribution to speeding up the process. This includes, in particular, responding to office actions in a timely manner, furnishing written submissions rapidly and attending the hearings very well-prepared.

Special aspects of each particular case and the current case law must always be taken into account. If further aspects arise in opposition proceedings which cannot be answered by legal provisions and case law, the Guidelines for the Examination Procedure must be consulted, insofar as they can be applied accordingly in opposition proceedings. In individual cases it may be necessary to deviate from general principles due to special circumstances.

For reasons of better readability, gender-neutral language (e.g. he/she) is not used in these Guidelines. The masculine form of the personal terms used refers to individuals of all genders.

Munich, July 2018

Legal basis

The statutory framework of patent opposition proceedings and patent revocation or limitation proceedings essentially consists of:

- the Patent Act (*Patentgesetz*),
- the Ordinance on Patent Procedures before the German Patent and Trade Mark Office (Patent Ordinance – *Verordnung zum Verfahren in Patentsachen vor dem Deutschen Patent- und Markenamt*),
- the Ordinance Concerning the German Patent and Trade Mark Office (DPMA Ordinance – *Verordnung über das Deutsche Patent- und Markenamt [DPMA-Verordnung]*),
- the Ordinance on the Performance of Particular Tasks for which the Examination Sections, the Utility Model Section, the Trade Mark Sections and the Divisions of the Patent Office are in charge (*Verordnung über die Wahrnehmung einzelner den Prüfungsstellen, der Gebrauchsmusterstelle, den Markenstellen und den Abteilungen des Patentamts obliegender Geschäfte*),
- the Act Concerning the Costs of the German Patent and Trade Mark Office and of the Federal Patent Court (Patent Costs Act – *Gesetz über die Kosten des Deutschen Patent- und Markenamts und des Bundespatentgerichts*),
- the Ordinance on Payment of Costs of the German Patent and Trade Mark Office and of the Federal Patent Court (Patent Costs Payment Ordinance – *Verordnung über die Zahlung der Kosten des Deutschen Patent- und Markenamts und des Bundespatentgerichts*),
- the Ordinance Concerning the Administrative Costs at the German Patent and Trade Mark Office (Ordinance Concerning the Administrative Costs at the DPMA – *Verordnung über Verwaltungskosten beim Deutschen Patent- und Markenamt*),
- the Ordinance on Electronic Legal Transactions with the German Patent and Trade Mark Office (*Verordnung über den elektronischen Rechtsverkehr beim Deutschen Patent- und Markenamt*),
- the Ordinance on the Keeping of Electronic Files at the Patent Office, the Patent Court and the Federal Court of Justice (*Verordnung über die elektronische Aktenführung bei dem Patentamt, dem Patentgericht und dem Bundesgerichtshof*),
- the Act on Service in Administrative Procedures (*Verwaltungszustellungsgesetz*).

¹ BIPMZ 2007, 49

A Opposition proceedings

1. General information

In opposition proceedings, it is possible to have the legal validity of a patent reviewed within the framework of the grounds for revocation conclusively mentioned in section 21 (1) of the Patent Act and, if appropriate, to achieve revocation of the patent or its maintenance in limited scope.

Pursuant to section 59 (1) of the Patent Act, any person, in the case of usurpation only the aggrieved party, may give notice of opposition to the patent within nine months of the publication of the grant. As a rule, the lodging of an opposition does not require any particular economic or legal interest. The patent proprietor who is not entitled to lodge an opposition may have the patent revoked or limited with retroactive effect by a procedure under section 64 of the Patent Act ([see Part B](#)).

The opposition must be declared in writing, state the reasons and exactly indicate the patent. Electronic filing requiring digital signatures is equivalent to the written form. The facts justifying the opposition must be specified. The information, unless already included in the written notice of opposition, must subsequently be filed in writing by the end of the opposition period. The full amount of the statutory opposition fee must also be paid within the opposition period. Opposition may also be lodged if the patent has lapsed due to surrender or non-payment of the annual fee. This takes into account possible IP interests, since the effects of the patent remain in force until it lapses from which claims may be derived.

Only the patent proprietor, the opponent or the opponents and the person or the persons having intervened in the opposition proceedings under section 59 (2) of the Patent Act shall be parties to the opposition proceedings. As a rule, each party to the proceedings shall bear its own costs. Other persons who are neither patent proprietors nor opponents nor interveners are free to observe the proceedings as members of the public, e.g. by inspecting the files via the Internet or by attending a public hearing. Those other persons do not constitute parties to opposition proceedings even if they provide information regarding the state of the art (section 59 (5), 43 (3) sentence 2 of the Patent Act).

The parties to the proceedings submit only one copy of each of their written submissions and documents; as a rule, it is not necessary to attach copies for the other parties. However, the DPMA may invite the parties to submit copies (section 17 (2) sentence 3 of the DPMA Ordinance). The patent proprietor is immediately notified of the receipt of an opposition. The complete

documents of this and any other oppositions will be sent to the patent proprietor only after expiry of the full opposition period notifying him of a time limit to comment; the patent literature and non-patent literature filed will also be sent to him.

The Patent Divisions of the DPMA are responsible for opposition proceedings (sections 27 (1) sentence 1 no. 2, 61 (1) of the Patent Act) unless a party to the proceedings requests a decision by the Board of Appeal at the Federal Patent Court and the requirements for this are met (section 61 (2) of the Patent Act). A hearing will be held in opposition proceedings if a party so requests or if the Patent Division deems this to be expedient.

Where an opposition is lodged, a respective information is published in the Patent Gazette (*Patentblatt*) and in DPMAregister. As a rule, any person may inspect the files kept by the DPMA on opposition proceedings via the Internet, [cf. part C](#).

2. Procedural principles

2.1 Principle of *ex-officio* examination

In order to initiate opposition proceedings, a notice of opposition must be given and the intention to lodge an opposition must be clearly recognisable. Once opposition proceedings have been initiated, the Patent Division will control *ex officio* the course of the proceedings. Accordingly, the proceedings will be continued *ex officio* without the opponent even if the opposition is withdrawn (section 61 (1) sentence 2 of the Patent Act). Therefore, withdrawal of an opposition will as a rule only end that opponent's participation in the proceedings. When examining the legal validity of the patent, the Patent Division is not bound by the grounds for revocation submitted. Although the Patent Division primarily examines the grounds for revocation raised by the parties, it is, however, at the discretion of the Patent Division to include *ex officio* further grounds for revocation in the proceedings instead of or in addition to these grounds and, if appropriate, base the revocation thereon.²

An essential maxim of opposition proceedings is the principle of *ex-officio* examination (investigation principle). The Patent Division must determine and examine the circumstances *ex officio* on which the decision is to be based, i.e. also without a request from a party or independently of it. In this context, the purpose of the principle of the investigation is not to complete an opponent's insufficient presentation of the facts by *ex-officio* examination.³ Citations introduced by an opponent after expiry of the opposition period will only be taken into account by the Patent Division if it considers them to be substantial after due assessment of the circumstances.⁴ The same

² BGH GRUR 1995, 333 *Aluminium-Trihydroxid*

³ BPatG 8 W (pat) 21/10, BeckRS 2014, 11093

⁴ BGH GRUR 1978, 99 *Gleichstromfernspeisung*

applies with respect to documents cited by a third party as conflicting with the maintenance of the patent (sections 59 (5), 43 (3) sentence 2 of the Patent Act). The principle of *ex-officio* examination has its limit where the necessary examination require cooperation of the parties involved who evade the obligation to cooperate, in particular in the case of an alleged obvious prior use.⁵ Accordingly, the Patent Division examines whether the subject-matter of the patent goes beyond the content of the application in the version as originally filed, provided that the reasons stated for the ground for revocation are comprehensible. If the ground for revocation has not been presented by the opponent, it may nevertheless be taken into account *ex officio*. The *ex-officio* examination shall also take place with regard to the extension of the scope of protection (section 22 (1) alternative 2 of the Patent Act).

2.2 Obligation to cooperate

Within the framework of their obligation to cooperate, the parties to the proceedings have the duty to furnish written submissions and requests in good time so that both, the other parties to the proceedings and the Patent Division, will be able to deal with the submissions appropriately. This applies in particular to written submissions and requests furnished in preparation for a hearing already scheduled. If, in a particular case, it emerges that a party's submission in or relating to a hearing is such as to require that the hearing has to be postponed to ensure the right to be heard, the costs of the hearing may be imposed on that party to the proceedings.

When submitting amended documents, the patent proprietor shall – in particular in the case of extensive amendments to the patent claims – state in detail in analogy with section 15 (3) of the Patent Ordinance) where in the documents originally filed and also in the patent specification the features newly included in the claims are disclosed as belonging to the invention. If necessary, the Patent Division will demand the relevant information.

If the patent is defended in opposition proceedings in amended version, the admissibility of this version must be examined without limitation to the grounds for revocation.⁶ This also includes the admissibility of the amended version under formal law, so that it may also be necessary to adapt the description, and possibly also the drawings, in addition to admissible limited claims, in order to obtain a version of the patent that can be granted.⁷ When submitting new claims, the patent proprietor is obliged to simultaneously adapt the description to these claims in accordance with section 10 of the Patent Ordinance, to submit new

drawings, if necessary, and to indicate the relevant state of the art cited in the opposition proceedings.

Amendments are necessary if, for example, the patent is to be maintained with reformulated claims, but such reformulation would cause a contradiction with the description or drawings. In the event of an amendment to the patent claims, the description shall only be amended to the extent absolutely necessary. Care must be taken to ensure that deletions, if any, do not result in inadmissible extensions.

2.3 Ensuring the right to be heard

Opposition proceedings shall be conducted in a manner ensuring the right to be heard. The right to be heard confers on each party to the proceedings the right to comment on the facts on which the decision is based and to present their own views on the legal issues relevant to the decision. Full revocation or limited maintenance of the patent may be based only on grounds known to the patent proprietor before the decision was taken and which he was given an opportunity to comment on.

The Patent Division shall take into consideration the submissions and requests of the parties and examine their relevance to the decision. However, it cannot be inferred from this that the Patent Division has to explicitly deal with any submission of a party to the proceedings in the reasons for the decision.⁸ Fixing a reasonable time limit, dealing with the submissions of the parties in a manner appropriate to the current state of the proceedings and notifying the points relevant to the decision and possibly requiring discussion in a supplement to the summons or in an interlocutory communication by the Patent Division also serve to ensure the right to be heard.

A notification to the parties to the proceedings is necessary if the Patent Division intends to introduce new circumstances into the proceedings or considers amendments to the patent specification to be necessary which are not only of an editorial nature. If new documents with amended content have been filed by the patent proprietor and the Patent Division considers the claims submitted to be sufficient for limited maintenance, it is sufficient for the documents to be served on the other parties to the proceedings before the final decision is taken, specifying a time limit for comment.

In particular, it is not necessary to make a notification before the decision is taken if the opponents had commented on claims with amended content and the patent proprietor had been given the opportunity to comment thereon.⁹

If no hearing is held, a decision without a notification may be considered if the parties have been granted the

⁵ BPatG 17 W (pat) 34/03, BeckRS 2009, 23117

⁶ BGH GRUR 1998, 901 *Polymermasse*

⁷ BPatG Mitt 2011, 368, with further evidence

⁸ BGH GRUR 1999, 919 *Zugriffsinformation*

⁹ BGH GRUR 1966, 583 *Abtastverfahren*

right to be heard regarding all the circumstances on which the decision is based in the written proceedings. If the Patent Division considers that the new claims cannot be granted on the basis of the arguments already introduced in the proceedings and known to the patent proprietor, a notification is not required before taking a decision on the revocation of the patent.

3. Effectiveness of the opposition

When an opposition is lodged, a fee becomes due pursuant to section 3 (1) of the Patent Costs Act, which is based on section 2 (1) of the Patent Costs Act in accordance with the Schedule of Fees in the annex to the Patent Costs Act (opposition proceedings: fee number 313 600). Pursuant to section 6 (1) sentence 1 of the Patent Costs Act in conjunction with section 59 (1) sentence 1 of the Patent Act, this fee must be paid within the opposition period. In the case of several opponents it should be noted that the fee pursuant to (2) of the preliminary remarks to section A. of the Schedule of Fees of the Patent Costs Act is charged separately for each person filing a request e.g. each opponent.

The methods of payment and the date of payment are governed by the Patent Costs Payment Ordinance. If the opposition fee is not paid at all, not paid in full or not paid on time, the opposition shall be deemed not to have been lodged pursuant to section 6 (2) of the Patent Costs Act. This is established by the Patent Division by a decision. Pursuant to section 123 (1) sentence 2 no. 1 of the Patent Act, *restitutio in integrum* shall not apply to the payment period for the opposition fee.

4. Competence

4.1 Patent Division (section 27 (1) sentence 1 no. 2 of the Patent Act)

The Patent Divisions of the German Patent and Trade Mark Office are responsible for opposition proceedings (section 27 (1) sentence 1 no. 2, section 61 (1) of the Patent Act), unless a party to the proceedings requests a decision by the Board of Appeal of the Federal Patent Court and the further requirements pursuant to section 61 (2) of the Patent Act are fulfilled. The Patent Division shall constitute a quorum when at least three members are participating, at least two of whom must be technically qualified members (examiners) (section 27 (3) sentence 1 of the Patent Act). At hearings at least three members must also be present. The standard in opposition proceedings is a Division of three members; four members in the case of participation of a legally qualified member. Pursuant to section 27 (7) of the Patent Act, experts who are not members of the competent Patent Division or of the

German Patent and Trade Mark Office may be consulted in the deliberations in the Patent Divisions. However, experts may not take part in the voting. The experts to be considered within the framework of the *ex-officio* examination shall primarily be technically qualified members with specific expertise relevant to a particular aspect.

If the case presents particular legal difficulties, a legally qualified member of the Patent Division shall participate ([cf. part A, section 4.1.4](#)). The composition of the Patent Division shall remain unchanged until the conclusion of the proceedings. If requisite to speed up the proceedings or otherwise expedient, the chairperson can replace the reporting and/or the associate member of the Patent Division with other members of the organisational Patent Division.

Decisions on the maintenance or revocation of the patent in proceedings before the Patent Division shall be subject to deliberations and voting after a hearing or at a session. The Patent Division shall decide by a majority vote; when the votes cast for and against are equal in number, the chairperson shall have the casting vote (section 2 (4) of the DPMA Ordinance).

4.1.1 Chairpersons

The chairpersons of the Patent Divisions, usually the Heads of the organisational Divisions, direct the proceedings before their Patent Divisions in accordance with section 2 (2) sentence 1 of the DPMA Ordinance. This includes managing and controlling the course of the opposition proceedings. The chairpersons examine the draft decisions and establish them (section 2 (2) sentence 4 of the DPMA Ordinance). They may amend the drafts without the consent of the other members of the respective Patent Division in so far as the changes do not concern the substantive content. The Patent Division shall decide on disagreements concerning substantive aspects (section 2 (2) sentence 5 of the DPMA Ordinance).

Except for decisions on the maintenance or revocation of the patent as well as on the fixing of the remuneration, the chairpersons shall determine which procedural matters they will handle alone on a regular basis or in individual cases and which they will delegate to a technically qualified member of the Division (section 27 (4) of the Patent Act). An exception to this is the hearing (section 27 (4) last half sentence of the Patent Act). Pursuant to section 2 (3) no. 4 of the DPMA Ordinance, decisions on the granting of legal aid for procedural fees in limitation and opposition proceedings and on the assignment of a representative pursuant to section 133 of the Patent Act also require deliberations and a vote by the Patent Division in a session.

If chairpersons of Patent Divisions are unavailable due to illness, leave or other factual or legal circumstances, excluded or successfully objected to or have left the service, the member of the Patent Division appointed as representative shall act as chair.

4.1.2 Rapporteur

In the proceedings before the Patent Division, the technically qualified member who is responsible for the processing according to the distribution of duties, normally, is in charge of reporting. If the legally qualified member has joined proceedings, reporting can be assigned to this legal member in cases with particular legal difficulties.

The reporting comprises the presentation at the non-public meeting or at the deliberations, the drafting of a vote, if necessary, and the preparation of the decisions (section 2 (2) sentence 3 of the DPMA Ordinance). It also includes the preparation of proposals concerning the points requiring discussion for the decision to be taken, which are to be communicated to the parties to the proceedings with a supplement to the summons or, as the case may be, in an interlocutory communication, and the drafting of decisions in coordination with the other members of the Patent Division.

4.1.3 Associate member, secretary

The associate member completes the Patent Division to achieve the necessary composition and participates in the deliberations and decision of the Patent Division. As a rule, this member also assumes the function of secretary, i.e. takes the minutes of the hearing.

4.1.4 Legally qualified member

Where the case presents particular legal difficulties, e.g. the taking of evidence by questioning witnesses, a legally qualified member assigned to the Patent Division shall be involved in the decision-making process pursuant to section 27 (3) sentence 2 of the Patent Act. A decision on the basis of which a request to consult a legally qualified member is refused shall not be independently appealable (section 27 (3) sentence 3 of the Patent Act).

4.2 Board of Appeal of the Federal Patent Court (section 61 (2) of the Patent Act)

In derogation of section 61 (1) of the Patent Act, the Board of Appeal at the Federal Patent Court shall decide if a party so requests and no other party objects to it within two months of service of the request, or at the request of only one party if at least fifteen months have elapsed since the expiry of the opposition period, or in the event of the request being made by a person who has intervened in the proceedings, fifteen months have elapsed since notice of intervention has been given (section 61 (2) sentence 1 of the Patent Act). This shall not apply if the Patent Division served a summons to a hearing or served the decision on the opposition within three months of receipt of the request for a decision by the Federal Patent Court (section 61 (2) sentence 2 of the Patent Act). In the case of requests

for a decision by the Federal Patent Court (section 61 (2) of the Patent Act), the chairpersons therefore shall examine whether a summons to a hearing or the decision on the opposition can be served on the parties to the proceedings within three months of the request.

With the filing of a request for a court decision pursuant to section 61 (2) of the Patent Act, a fee shall become due and payable within three months from the filing of the request (section 3 (1) sentence 2 no. 2, section 6 (1) sentence 2 of the Patent Costs Act). If the fee for the request is not paid at all, not paid in full or not paid on time, the senior judicial officer (*Rechtspfleger*) of the Federal Patent Court shall decide on the question whether the request shall be deemed not to have been filed pursuant to section 6 (2) sentence 2 of the Patent Costs Act (cf. section 23 (1) no. 4 of the Act on Senior Judicial Officers [*Rechtspflegergesetz*]). The fee shall be refunded if the opposition is not presented to the Federal Patent Court for decision pursuant to section 61 (2) of the Patent Act because another party opposes the request (section 61 (2) sentence 1 no. 1 of the Patent Act) or the Patent Division has served a summons to a hearing or the decision on the opposition within three months after receipt of the request for a decision by the Federal Patent Court (section 61 (2) sentence 2 of the Patent Act).

5. Admissibility of the opposition

At the expiry of the opposition period, an admissible opposition must exist in order to initiate opposition proceedings. If the sole opposition is inadmissible, opposition proceedings shall end when the decision rejecting the opposition has become final without a substantive review of the patent. There is then no leeway to take a decision on whether to maintain the patent.¹⁰ The documents submitted in support of the inadmissible sole opposition cannot be taken into consideration *ex officio*. However, if there is at least one further admissible opposition, the Patent Division shall also consider the submissions of the inadmissible opposition after due assessment of the circumstances.

5.1 Parties to the proceedings

Parties to the opposition proceedings shall be the patent proprietor, all opponents and the intervener(s) ([see part A, section 5.1.1.2](#)). Other third persons shall not be parties to the proceedings ([see part A, section 5.1.4](#)). However, the status of party to the proceedings does not give rise to a dominant position in the proceedings, since, as a rule, opposition proceedings shall continue *ex officio*, even if the opposition is withdrawn (section 61 (1) sentence 2 of the Patent Act). The withdrawal of the opposition only terminates the opponent's status of party to the proceedings. The same applies in the case of a

¹⁰ BPatG GRUR 1984, 799 "inadmissible opposition"

surrender of a patent unless the opponent asserts a legitimate interest to take legal action. However, the patent proprietor remains a party to the opposition proceedings even in the event of surrender of the patent.

5.1.1 Opponents

Upon lodging an opposition, the mere entitlement to oppose enjoyed by everyone is converted into participation as a party in the opposition proceedings which is acquired only by those who exercise that right on time and in proper form.¹¹

Within the opposition period, information on the opponent's name must be provided which allows the identity of the opponent to be established unambiguously and beyond doubt. If this is not done in a satisfactory manner, the opposition shall be inadmissible.¹²

If a patent attorney or lawyer lodges an opposition in his own name, he himself/becomes a party to the proceedings, but not any (unknown) client.

Several opponents become independent parties to the uniform opposition case. Jointly lodging an opposition requires representation by a common attorney, common written submissions and support on common grounds for revocation. Still, all opponents retain their (independent) status as party to the proceedings.

An opponent's status as a party in the proceedings ceases upon receipt of a declaration of withdrawal of the opposition, final rejection of the opposition or of the intervention as inadmissible¹³, the final and legally binding conclusion of the opposition proceedings, or upon the termination of the opponent (from the proceedings) without legal succession. As a rule, however, the termination of the opponent does not terminate opposition proceedings; rather, the opposition proceedings must be continued *ex officio* without the opponent (section 61 (1) sentence 2 of the Patent Act by analogy).¹⁴

5.1.1.1 Entitlement to oppose

As a rule, any person may give notice of opposition against the patent pursuant to section 59 (1) of the Patent Act. Since the opposition proceedings have been legally designed as remedial proceedings for everybody, there is no need to show a particular legitimate interest. An exception is the opposition due to usurpation (sections 59 (1), 21 (1) no. 3 of the Patent Act); in this case only the party aggrieved by the usurpation is entitled to give notice of opposition.

As a rule, the sole patent proprietor is not entitled to give notice of opposition. A co-proprietor of the patent may exceptionally be entitled to give notice of

opposition in the event of an opposition due to usurpation, in order to be able to alone apply for a patent for the invention after revocation.¹⁵

The entitlement to oppose does not cease to exist even if the opponent becomes the proprietor of the patent in the course of the opposition proceedings, since the revocation of the patent confers to him the right to subsequently apply for a patent pursuant to section 7 (2) of the Patent Act and he himself is able to exert a formative influence on the wording of the patent specification and, above all, of the patent claims.¹⁶

In the case of a strawman (i.e. a person who acts in his own name but has no interest of his own but acts in the interest and on behalf of a person who stays in the background) the entitlement to oppose may be lacking if background person itself is not entitled to give notice of opposition. The burden of proof for this constellation lies with the patent proprietor. If such allegation cannot be proven, a substantive examination of the grounds brought forward will need to be conducted.¹⁷

Only the infringed party (owner of the invention) whose invention has been usurped by another person without consent can assert what is known as usurpation as a further ground for opposition. The right to the invention is governed by section 6 of the Patent Act. For further details, please refer to [part A, section 7.3](#).

If there is no entitlement to oppose, the opposition shall be inadmissible.

5.1.1.2 Intervention of the alleged infringer

Where an opposition has been lodged to a patent, any third party who can prove that proceedings for infringement of the patent have been instituted against him, after expiry of the opposition period, may intervene in the opposition proceedings as an opponent if he gives notice of intervention within three months of the date on which proceedings for infringement of the patent have been instituted (section 59 (2) sentence 1 of the Patent Act). The same shall apply to any third party who can prove that, after the patent proprietor has requested him to cease alleged infringement of the patent, has instituted proceedings for a court ruling that he is not infringing the patent (section 59 (2) sentence 2 of the Patent Act). The proceedings shall be instituted upon service of the statement of claim pursuant to section 253 (1) of the Code of Civil Procedure (*Zivilprozessordnung [ZPO]*); the corresponding proof of service is used to determine the three-month period under section 59 (2) sentence 1 of the Patent Act. Any third party against whom the patent proprietor has applied for an injunction because of infringement of the patent may

¹¹ BGH GRUR 1968, 613 *Gelenkkupplung*

¹² BGH GRUR 1990, 108 *Meßkopf*; BPatG [Mitt](#) 2016, 506 *Gabelschlüssel*

¹³ BGH GRUR 1972, 592 *Sortiergerät*

¹⁴ BPatG 12 W (pat) 366/03, BeckRS 2009, 12580

¹⁵ BGH GRUR 2011, 509 *Schweißheizung*

¹⁶ BGH GRUR 1996, 42 *Lichtfleck*

¹⁷ BGH GRUR 2011, 409 *Deformationsfelder*

also intervene in the opposition proceedings as an opponent.¹⁸

This grants legal protection to third parties in the event of an infringement dispute, since pursuant to section 81 (2) sentence 1 of the Patent Act, an action for revocation cannot be filed as long as a notice of opposition can still be filed or opposition proceedings are still pending. An intervener is a “third party” if he is not or has not already been involved in the proceedings as an opponent, i.e. a person other than the intervener must have lodged an opposition. Admissibility and effectiveness of the intervention do not depend on the admissibility of the opposition originally lodged.¹⁹

The intervention must be declared in writing and reasoned within the time limit referred to in section 59 (2) sentence 1 of the Patent Act (section 59 (2) sentence 3 of the Patent Act). Intervention is only admissible as long as the opposition proceedings are still pending. Thus intervention is still possible within the appeal period. The intervener thus becomes an opponent and may himself lodge an appeal. An intervention which is not declared in time shall be inadmissible.

The opposition fee becomes due upon declaration of the intervention and must be paid within three months (section 3 (1) sentence 2 no. 3, section 6 (1) sentence 2 of the Patent Costs Act). Reference is made to [part A, section 3](#).

By an admissible intervention, the intervener acquires the procedural status of an opponent who has lodged an admissible opposition. The intervener is not bound by the grounds for revocation submitted so far by the other opponents. Any of the grounds for revocation under section 21 (1) of the Patent Act may be invoked as a reason within the time limit specified in section 59 (2) sentence 3 of the Patent Act. Accordingly, the statement of reasons must meet the relevant requirements of an opposition, including substantiation.

5.1.1.3 Transfer of opponent status, involvement of the patent proprietor

Mere changes to the name or the company name under commercial law without change of the legal person or legal form do not affect the opponent status. The same applies to a mere change of address, place of residence or principal place of business.

However, opponent status is not freely transferable. Therefore, as a rule, it only passes to the legal successor in the event of overall succession in law (e.g. inheritance or merger of legal persons, e.g. integration pursuant to section 319 of the Share Capital Companies and Partnerships Act [*Aktiengesetz*]). Exceptionally, the transfer of opponent status is possible in the event of legal succession to a special fund.

Proof of legal transfers must be provided to the DPMA. If necessary, the patent proprietor must be given the opportunity to comment.

5.1.2 Patent proprietor, change of proprietor

Pursuant to section 30 (1) of the Patent Act, the patent proprietor party to the proceedings shall be the proprietor of the patent registered in the Patent Register (<https://register.dpma.de>) at the time of filing the opposition.

If several persons are proprietors of a patent, they are, as a rule, mandatory joined parties within the meaning of section 62 of the Code of Civil Procedure, since the legal relationship in dispute (i.e. the validity of the patent) can only be established uniformly vis-à-vis all parties. This means, for example, that a surrender is only effective if it is declared by all proprietors. Similarly, restrictive new claims can only be taken into account in the case of a joint request. However, mutual representation, with an appropriate authorisation, is possible.

In the case of singular succession in law, the provision of section 265 (2) sentence 2 of the Code of Civil Procedure applies accordingly in the pending opposition proceedings, i.e. the successor in title cannot assume the former patent proprietor’s status as a party to the proceedings without the consent of the opponent, even though the change has been carried out in the Patent Register. Thus, the singular successor in title does not automatically become a party to the opposition proceedings. However, if the opponent does not agree to the change of party to the proceedings, the successor in title may intervene in the proceedings in support of the legal predecessor (section 66 of the Code of Civil Procedure).²⁰

In the case of overall succession in law with disappearance of the previous legal entity, e.g. due to the merger of legal persons or in the case of inheritance, section 265 of the Code of Civil Procedure shall not be applicable, as this only comprises singular succession. In the case of overall succession, the successor in title automatically becomes a party to the proceedings without requiring the consent of the opponent.

Proof of legal transfers must be provided to the DPMA. If necessary, the opponent must be given the opportunity to comment.

5.1.3 Insolvency of a party to the proceedings

The decision to open insolvency proceedings is published centrally and nationwide on the Internet (www.insolvenzbekanntmachungen.de/) pursuant to section 9 (1) of the Insolvency Statute (*Insolvenzordnung*). By opening insolvency proceedings, the debtor’s right to manage and dispose of the assets

¹⁸ BGH GRUR 2018, 216 *Ratschenschlüssel*

¹⁹ BGH GRUR 1993, 892 *Heizkörperkonsole*

²⁰ BGH GRUR 2008, 87 “change of patent proprietor in the opposition proceedings”

belonging to the insolvency estate (section 35 Insolvency Statute) shall be transferred to the insolvency administrator, pursuant to section 80 (1) of the Insolvency Statute.

With regard to opposition proceedings, this means that the insolvency administrator, as a party by virtue of office, enters into the legal position of the patent proprietor or opponent, who shall lose his powers of administration and disposition accordingly. Powers of authorisation granted by the debtor with respect to the assets forming part of the insolvency estate, as a rule, shall expire pursuant to section 117 (1) of the Insolvency Statute.

The period for payment of renewal fees pursuant to section 7 (1) of the Patent Costs Act shall not be interrupted in the event of the insolvency of the patent proprietor.²¹ The DPMA does not apply section 240 of the Code of Civil Procedure in IP proceedings, so that in the event of insolvency there is no interruption of the proceedings and time limits at the DPMA ([Mitteilung des Präsidenten 20/08](#) of 14 November 2008).

5.1.4 Status of third parties

Only the patent proprietor, the opponent(s) and, if applicable, the intervener pursuant to section 59 (2) of the Patent Act shall be parties to the opposition proceedings. Other (third) persons shall not be parties to the opposition proceedings. Third parties shall not become a formal party to the proceedings, even if they have provided the German Patent and Trade Mark Office with documents which may conflict with the patent (sections 59 (5), 43 (3) sentence 2 of the Patent Act).

In the case of oral descriptions, uses and other public disclosures submitted by third parties, the submission must be considered and taken into account in the decision if the discretionary review carried out shows that they would be relevant to the decision. In this context, a balance must be taken between the relevance of the submissions and procedural expediency, in particular considering the purpose of the opposition proceedings, namely to ensure, as soon as possible, legal certainty as to the validity of the patent. The further facts of the case shall not be investigated *ex officio* if, without the involvement of the third party who is not a party to the proceedings, this would require unreasonable time and effort. Submissions by third parties shall be sent to all parties to the opposition proceedings; a formal notification is not required.

5.2 Time limit

The grant of a patent is published in the Patent Gazette (*Patentblatt*) (section 58 (1) sentence 1 of the Patent

Act). At the same time the patent specification is published (section 58 (1) sentence 2 of the Patent Act).

Pursuant to section 59 (1) of the Patent Act, notice of opposition must be lodged with the DPMA within nine months of the publication of the patent grant in the Patent Gazette, i.e. irrespective of the publication of the patent specification. The opposition shall be inadmissible prior to the publication of the grant of the patent.²² If the opposition is received by the German Patent and Trade Mark Office after expiry of the opposition period, it shall be inadmissible. Filing an opposition with a patent information centre is not sufficient to meet the time limit. Re-establishment shall not apply to non-observance of the opposition period (section 123 (1) sentence 2 no. 1 of the Patent Act).

5.3 Form

5.3.1 Language

The language in the opposition proceedings before the Patent Office shall be German (section 126 of the Patent Act), since no other provision is laid down in the Patent Act for the opposition proceedings.

The examination of the content of foreign-language documents may be restricted in particular cases by the limits of the *ex officio* examination, e.g. if a party to the proceedings refers to a foreign-language document which would only be accessible to the other parties and to the Patent Division by means of a translation which, however, is neither provided nor furnished later, upon request.

5.3.2 Written form

Notice of opposition shall be given in a written reasoned statement (section 59 (1) sentence 2 of the Patent Act) otherwise it is inadmissible. The Patent Act does not contain any independent definition of the written form, but section 10 of the DPMA Ordinance stipulates that originals of requests and submissions shall be signed. The signature, as a rule, shall be handwritten because of the importance of the notice of opposition as a determining submission for the course of proceedings. In accordance with section 11 (1) of the DPMA Ordinance, the hand-signed original may also be sent by fax. Pursuant to section 11 (2) of the DPMA Ordinance, the DPMA may request the repetition of the transmission by fax or the furnishing of the original if it has reasonable doubts as to the completeness of the transmission or the concordance of the original with the transmitted fax or if the quality of the representation does not meet the requirements of the German Patent and Trade Mark Office. If the handwritten signature is missing by the end of the opposition period, the opposition, as a rule, shall be inadmissible.

²¹ BGH GRUR 2008, 551 *Sägeblatt*

²² BPatG 23 W (pat) 78/75, Mitt 1979, 120 (headnote)

In addition, notices of opposition may be filed electronically in accordance with section 12 of the DPMA Ordinance in conjunction with section 1 of the Ordinance on Electronic Legal Transactions with the German Patent and Trade Mark Office (DPMA), thus complying with the formal requirement. The DPMA provides DPMAdirektPro as access and transmission software for this purpose. The provisions of section 3 of the Ordinance on Electronic Legal Transactions with the DPMA must be observed.

The filing of notices of opposition by e-mail shall be inadmissible.

5.3.3 Representatives, power of authorisation

As a rule, parties to the proceedings may take part in the proceedings without a representative, as representation by a patent attorney or a lawyer is not mandatory before the DPMA. Parties to proceedings who have neither their residence nor principal place of business nor an establishment in Germany may participate in the proceedings before the German Patent and Trade Mark Office only if they have appointed as their representative a lawyer or patent attorney in Germany who is entitled and authorised to represent them in proceedings before the German Patent and Trade Mark Office, before the Federal Patent Court and in civil litigation affecting the patent, as well as to file an application for criminal prosecution (section 25 (1) of the Patent Act).

Patent attorneys or lawyers admitted in Germany are entitled to represent clients before the DPMA, in the cases of section 155 of the Patent Attorney Code (*Patentanwaltsordnung*) also patent agents (*Patent-assessoren*).

Domestic representatives may also be:

- established or service-providing European lawyers in accordance with the provisions of sections 1, 2, 25 et seqq. of the Act on the Activities of European Lawyers in Germany (*Gesetz über die Tätigkeit europäischer Rechtsanwälte in Deutschland*) or
- European patent attorneys providing services pursuant to sections 13 et seqq. of the Act on the Activities of European Patent Attorneys in Germany.

Pursuant to section 15 (4) of the Act on the Activities of European Patent Attorneys, the Chamber of Patent Attorneys keeps a list of European patent attorneys providing services.²³ If a European patent attorney providing services is registered there, his power of representation can be assumed because the Chamber

of Patent Attorneys had to examine compliance with the necessary requirements before registration.

A representative and, if applicable, a person authorised to accept service can also be appointed subsequently after expiry of the opposition period. If a lawyer or patent attorney or, in the cases referred to in section 155 of the Patent Attorney Code, a patent agent (*Patentassessor*) acts as a representative, the German Patent and Trade Mark Office, as a rule, will not check whether he has a written power of attorney (section 15 (4) of the DPMA Ordinance). If the power of attorney covers several applications, IP rights or proceedings, it is sufficient to submit only one copy of the power of attorney (section 15 (2) of the DPMA Ordinance).

6. Substantiation

As a further condition for the admissibility of the opposition it is necessary to state the facts justifying in detail the opposition, in accordance with section 59 (1) sentence 4 of the Patent Act. The opposition can only be based on the allegation that one of the grounds for revocation mentioned in section 21 (1) of the Patent Act applies. This requirement to "substantiate" the ground for opposition enables the patent proprietor and the Patent Division to verify, on the basis of the specific circumstances and facts communicated and without having to conduct their own investigations, the opponent's allegation that a particular ground for revocation indicated by him actually exists.²⁴

Allegations without statement of reasons or mere value judgments are not sufficient. The mere listing of patent specifications, first publications of examined and unexamined patent applications (*Auslegeschriften, Offenlegungsschriften*), older patent applications or sources of other publications is generally not sufficient either.²⁵

Thus, for example, if the ground for revocation invoked is lack of patentability, it is incumbent on the opponent to explain the technical facts and the conclusions drawn. A statement of grounds for opposition which only deals with a partial aspect of the protected invention, but not with the entire patented teaching, is formally incomplete.²⁶ A statement of reasons which, with regard to a challenged independent claim, merely addresses features of the characterising part whereas it only refers as regards the features of the generic part to a blanket statement of their alleged prior knowledge is, as a rule, insufficient.²⁷

If the opposition is based on the allegation that the patent does not disclose the invention in such a clear

²³ The group of "European patent attorneys providing services" does not correspond to the group of people covered by Art. 134 of the European Patent Convention (EPC).

²⁴ BGH GRUR 1972, 592 *Sortiergerät*, BGH GRUR 1993, 651 *Tetraploide Kamille*, with further references

²⁵ BGH GRUR 1972, 592 *Sortiergerät*

²⁶ BGH GRUR 1988, 364 *Epoxidations-Verfahren*, BPatG GRUR 1989, 906 *Schwerkraft-Rollenbahn*

²⁷ BPatG BPatGE 35, 263 admissibility of the opposition

and complete manner for a skilled person to be able to carry it out, general statements are not sufficient. Rather, the opposition must contain more detailed explanations as to why a person skilled in the art is not able to carry out the teaching.²⁸ Doubts concerning the enabling disclosure can be proved in theoretical explanations, if necessary, without requiring experiments.

If this information is not already contained in the opposition notice, it must be submitted in writing in accordance with section 59 (1) sentence 5 of the Patent Act before the expiry of the opposition period. The evidence relating to the facts to be mentioned may also be filed after expiry of the time limit.

If it is asserted in the opposition that the subject-matter of the patent has been made available to the public by oral description, by use or in any other way before the date relevant for the priority of the patent, the opponent must, within the opposition period, indicate a particular object of use, provide information on the specific circumstances of use (type of prior use, location of prior use, person of prior user) and provide verifiable information as to when the object was used in this way. The date of prior use should be specified as concretely as possible. However, the opposition is not inadmissible just because the commencement and duration of prior use are not indicated, provided that it is asserted that prior use took place before the relevant filing or priority date.²⁹

If the requirement of sufficient substantiation is not fulfilled, the opposition will be rejected as inadmissible. In this case, there is no leeway for an additional statement on the maintenance of the patent (even without substantive examination).³⁰ However, in order to ensure the admissibility of the opposition, it is not necessary that the facts set out actually justify the requested revocation of the patent, i.e. that the statement of reasons is conclusive, which means that the opposition may be admissible even though the submission is factually unfounded.

7. Reasonable justification of the opposition

The opposition may only be based on the claim that one of the grounds for revocation conclusively set out in section 21 of the Patent Act exists. A sufficiently substantiated statement of grounds for opposition shall contain the individual facts justifying that a ground for revocation exists. It must set out the factual circumstances relevant for the assessment of an alleged ground for revocation in such detail as to enable the patent proprietor and the Patent Division to recognise, on the basis of the notice of opposition, the

factual grounds on which the opponent considers that the patent should be revoked.

The facts and circumstances presented only justify revocation if they provide conclusive reasons for the existence of one of the statutory grounds for revocation.

7.1 Lack of patentability under sections 1 to 5 of the Patent Act

The patent shall be revoked pursuant to section 21 (1) no. 1 of the Patent Act if it emerges that the subject matter of the patent is not patentable pursuant to sections 1 to 5 of the Patent Act. The subject matter of the patent is defined by the patent claims. Description and drawings shall be used for their interpretation (section 14 of the Patent Act), taking into account the understanding of the skilled person. In the course of the interpretation, the meaning of the patent claim in its entirety and the contribution of the individual features to what is achieved by the invention must be determined.³¹

Lack of patentability includes

- the absence of a technical invention (section 1 (1) of the Patent Act),
- subject matter that is not regarded as an invention (section 1 (3) of the Patent Act),
- inventions excluded from patentability (sections 1a, 2 and 2a of the Patent Act),
- lack of novelty (sections 1 (1), 3 of the Patent Act),
- absence of an inventive step (sections 1 (1), 4 of the Patent Act),
- lack of industrial applicability (sections 1 (1), 5 of the Patent Act).

Insofar, reference is made to the relevant sections in the guidelines for the examination of patent applications (Examination Guidelines).

If the grounds for revocation only relate to a part of the patent, it will be maintained with a corresponding limitation. The limitation may take the form of an amendment to the patent claims, the description or the drawings (section 21 (2) of the Patent Act).

7.2 Lack of sufficient disclosure of the invention

The patent shall be revoked pursuant to section 21 (1) no. 2 of the Patent Act if it emerges that it does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

Insofar as lack of sufficient disclosure of the invention is claimed as a ground for revocation, the skilled person

²⁸ BGH GRUR 1993, 651 *Tetraploide Kamille*

²⁹ BGH GRUR 1997, 740 *Tabakdose*

³⁰ BPatG GRUR 1984, 799 "inadmissible opposition"

³¹ BGH GRUR 2012, 1124 *Polymerschaum*

as well as his expert knowledge and skills shall not be considered in a different way than in the assessment of novelty and inventive step. Therefore, information on the concrete facts, taking into account the person skilled in the art, is necessary in order to provide a conclusive reasoning (also) for this ground for revocation. By granting the patent, it was at least implicitly examined whether the invention had been clearly and completely disclosed and acknowledged that it was the case here. Therefore, as a rule, the party invoking this ground for revocation bears the burden of proving that it is not possible for the person skilled in the art to carry out the claimed teaching by using his expert knowledge without unreasonable difficulties, even though he has become acquainted with the information in the description and drawings of the patent specification.³²

The disclosure is sufficient if the skilled person, without inventive effort and without unreasonable difficulties, is able to practically carry out the teaching of the patent claim on the basis of the overall disclosure of the patent specification in connection with the general expert knowledge on the date of filing or priority date in such a way as to achieve the desired result.³³ In this context, it is not necessary that the patent claim already contains all information required to carry out the invention. Rather, it is sufficient if the skilled person is able to obtain the necessary details from the general description or the detailed embodiments of the invention.³⁴

With regard to the principles of sufficient disclosure of the invention, reference is made to the corresponding section of the Examination Guidelines concerning section 34 (4) of the Patent Act.

7.3 Usurpation

In the event of usurpation, the patent shall be revoked pursuant to section 21 (1) no. 3 of the Patent Act if its essential content has been taken from the descriptions, drawings, models, apparatus or equipment of another person or from a process applied by that person without his consent. This provision is a temporary alternative, limited in time by the opposition period, to the claim of the inventor pursuant to section 8 of the Patent Act.

For the assertion of usurpation in the opposition proceedings, substantiated information on the ownership of the invention, on the equality of nature between the usurped and the patented invention and on the unlawfulness of the act of appropriation must be provided. As regards ownership of an invention, a specific description must be given of the circumstances

on the basis of which ownership of the patented teaching can be assessed. In order to assess the equality of nature, the identity of the patent features with those of the alleged use must be shown, in which case the disclosure of a general solution principle is sufficient, of which the application in dispute constitutes an easily identifiable concrete embodiment.³⁵ In addition, the unlawfulness of the act of appropriation must be shown, in which case it is important whether the patent proprietor was entitled to file the application. Whether there was fault on the part of the usurping party or whether he acted in good faith is not relevant. The burden of proof for the usurpation lies with the opponent.

Usurpation does not necessarily require that the invention which has been appropriated is patentable. The inventor of a teaching has a right to the invention irrespective of whether or not the teaching is capable of being protected.³⁶ A decision on the usurpation must be taken in any case, as the failure to decide on this ground for revocation already leads to grievance.³⁷ Upon revocation due to usurpation or if the opposition based on usurpation leads to the surrender of the patent, the owner of the invention will be granted, under the conditions of section 7 (2) of the Patent Act, a temporary right to file a subsequent application for which he may claim the priority of the earlier patent. An official notification is required to trigger the one-month period for filing a subsequent application.

7.4 The subject-matter of the patent goes beyond the original application

If it emerges that the subject-matter of the patent goes beyond the content of the application as originally filed with the competent authority, the patent shall be revoked (section 21 (1) no. 4 of the Patent Act). The same shall apply if the patent is based on a divisional application or a new application filed under section 7 (2) of the Patent Act and the subject-matter of the patent goes beyond the content of the earlier application as originally filed with the competent authority. For the concept of the subject-matter of the patent, see [part A, section 7.1](#).

Whether the subject-matter of the patent goes beyond the content of the application must be assessed, taking into account the content of the disclosure in the light of the understanding of the skilled person. In order to determine whether an extension is inadmissible, the subject-matter of the granted patent must be compared with the content of the original application. The content of the patent application must be inferred from the documents in their entirety, without the

³² BGH GRUR 2010, 901 *Polymerisierbare Zementmischung*

³³ BGH GRUR 2010, 901 *Polymerisierbare Zementmischung* with reference to BGH GRUR 1980, 166 *Doppelachsaggregat*

³⁴ BGH GRUR 2010, 901 *Polymerisierbare Zementmischung*, with further references

³⁵ BGH GRUR 1981, 186 *Spinnmaschine II*

³⁶ BGH GRUR 2011, 509 *Schweißheizung*

³⁷ BGH GRUR 2007, 996 *Angussvorrichtung für Spritzgießwerkzeuge*

patent claims having an outstanding importance in that respect. The crucial factor is whether it was clear for the skilled person from the original disclosure that the application for protection was meant to cover the amended subject-matter from the outset.

A patent shall not be revoked simply because the granted patent claim contains a feature which is not disclosed as belonging to the invention in the documents originally filed, provided that such feature leads to a limitation of the subject-matter and not to an aliud. However, when patentability is examined, the feature which has not been originally disclosed shall be disregarded insofar as it is not allowed to use the feature to support patentability.³⁸ A feature which is not disclosed as belonging to the invention in the documents originally filed may remain in the patent claim if its deletion or replacement by a feature covered by the original disclosure would lead to the extension of the scope of protection and its inclusion leads to a limitation with respect to the content of the application. Limitation within this meaning exists if the added feature further restricts a technical teaching which is disclosed as belonging to the invention in the originally filed documents.³⁹

The patent may be limited by including some or all of the features of a detailed embodiment, if such a limitation can be inferred from the application documents as a possible embodiment of the invention.⁴⁰

8. Inadmissible defence of the patent

The patent shall not be defended in opposition proceedings in such a way as to extend the scope of protection.⁴¹ In particular, a change in the category of claims may involve the risk of an extension of the scope of protection. Therefore, the Patent Division will examine *ex officio* the documents of requests filed for a limited defence of the patent with regard to an inadmissible extension of the scope of protection (section 22 (1) alternative 2 of the Patent Act).

There is no legitimate interest for maintaining the patent with amendments which do not serve the purpose of dispelling grounds for revocation. Amendments aimed solely at clarifying patent claims that otherwise are maintained unchanged are therefore also inadmissible.⁴²

³⁸ Analogous to BGH GRUR 2015, 573 *Wundbehandlungs-vorrichtung*, continuation of BGH GRUR 2011, 40 *Winkelmesseinrichtung*; BGH GRUR 2011, 1003 *Integrationselement*

³⁹ BGH GRUR 2011, 40 *Winkelmesseinrichtung*

9. Conducting opposition proceedings

9.1 Management of the proceedings

The management and control of the proceedings shall be based on the principle of procedural expediency, while ensuring that the right to be heard is respected. The chairpersons manage the proceedings and control the procedures accordingly, with the other members of the Patent Division participating accordingly. The parties to the proceedings must also work towards streamlining proceedings due to their duty to cooperate.

The order in which the proceedings are conducted in the field of business of the Patent Division as a rule is determined by the date of receipt of the opposition. The processing of opposition files shall be given priority in which a party has submitted a request for acceleration and has provided reasons which justify a departure from the chronological order. The processing of opposition proceedings shall also be given priority if there are doubts as to the admissibility of the sole opposition or, in the case of several oppositions, if there are doubts as to the admissibility of several or all oppositions. One decision shall be taken on the admissibility of the opposition and the validity of the patent, if possible. An appeal may be filed in respect of a preliminary decision on admissibility; if such an appeal is filed, the substantive decision of the Patent Division must await the outcome of the decision on the appeal.

Opposition proceedings in which the sole or all oppositions have been withdrawn should also be given priority.

9.2 Proceedings in case of withdrawal of opposition, surrender of the patent, lapse of the patent

Pursuant to section 61 (1) sentence 2 of the Patent Act, the proceedings shall be continued *ex officio* without the opponent, even if the only admissible opposition is withdrawn.

If the patent lapses because the proprietor surrenders the patent during the opposition proceedings or does not pay the annual fee in due time or the full amount of the fee (section 20 of the Patent Act), the proceedings shall only be continued if the opponent has a legitimate interest.⁴³ The same shall apply if the term of protection (section 16 of the Patent Act) expires during the opposition proceedings. Accordingly, the opponent shall be invited to communicate any

⁴⁰ BGH GRUR 2002, 49 *Drehmomentenübertragungseinrichtung*; cf. also BGH GRUR 2008, 60 *Sammelhefter II*

⁴¹ BGH GRUR 1990, 432 *Spleißkammer*

⁴² BGH GRUR 1988, 757 *Düngerstreuer*, BPatG 2008 – 6 W (pat) 311/07, with further references

⁴³ BGH GRUR 1997, 615 *Vornapf*

legitimate interest within a specified period. A legitimate interest must be affirmed if infringement proceedings against the opponent are pending or if there are tangible indications to suggest that opposition proceedings are imminent. On the other hand, a legitimate interest must be denied if the patent proprietor exempts the opponent from all claims, including those from the past.

If no legitimate interest is claimed or if it has to be denied, the opposition should be rejected as inadmissible. If the opposition is withdrawn before the decision has been taken in the case of a lapsed patent, it is no longer possible to reject the opposition as inadmissible. In this case, the opposition proceedings must be terminated with a decision to discontinue the proceedings.

The patent proprietor remains a party to the proceedings even if the patent lapses due to surrender or non-payment of the annual fee. This also applies if the surrender expressly includes all rights for the past.

If only the patent proprietor is still a party to the opposition proceedings and if his request can be granted, the decision shall be taken without substantive reasoning (section 59 (5), section 47 (1) sentence 4 of the Patent Act).

9.3 Fixing time limits and service of documents

Time limits shall be fixed in the opposition proceedings for actions which appear to be necessary for preparing a hearing or a decision.

The opposition will be served after the expiry of the opposition period; the patent proprietor will normally be given a period of three months to comment on the opposition or oppositions. As a rule, a time limit of three months must be given to respond to an interlocutory communication.

Where a reasoned request for an extension of the time limit is made, the period shall in any case be extended to three months in total. Initial extensions may be granted upon request if the person making the request provides sufficient reasons. Further extensions of time limits shall only be granted if a legitimate interest as well as the consent of the other parties to the proceedings are credibly shown (section 18 (3) of the DPMA Ordinance). For granting extensions of time limits, reference is made to the Examination Guidelines, which shall be observed accordingly.

In opposition proceedings, certain documents, e.g. decisions pursuant to section 59 (5) in conjunction with section 47 (1) sentence 1 of the Patent Act, must be served, i.e. formally delivered. In contrast to merely sending a document, service of a document proves that the document has been received by the recipient and documents the date of receipt, on which a period starts to run, if applicable.

Therefore, even in the case of documents for which service is not prescribed by law, service may be useful, for example, to prove that the parties to the proceedings have received certain information from the Patent Division in order to ensure that the right to be heard is respected. Written submissions other than the opposition which contain substantive motions or a declaration of withdrawal of a motion should, as a rule, be formally served on the other parties *ex officio*; they may be notified of further written submissions or documents without formal service (section 21 of the DPMA Ordinance).

Service or communication not requiring a specific form, respectively, will as a rule be made without delay within the course of business. It is unproblematic to serve or communicate written submissions together with the decision by the Patent Division, provided that this does not prejudice the right to be heard, e.g. if the case is ready for a decision and either has to be decided anyway in favour of the person or persons authorised to receive documents or the content of the written submission is irrelevant for the decision to be taken.

The service of paper documents is governed by section 127 (1) nos. 1 to 4 of the Patent Act in conjunction with the Act on Service in Administrative Procedures. Electronic service is possible if the recipient has opened access to it (section 127 (1) no. 5 of the Patent Act in conjunction with section 5 of the Ordinance on Electronic Legal Transactions with the DPMA).

Decisions shall be served as paper copies or – if the requirements are met – electronically, in which case the copy need not be certified (section 47 (1) sentence 1 of the Patent Act). Execution copies shall only be made at the request of a party to the proceedings and only in paper format (section 47 (1) sentence 2 of the Patent Act).

9.4 Hearing

The Patent division may at any time summon and hear the parties to the proceedings, i.e. the patent proprietors and opponents as well as any intervening parties, examine witnesses, experts and the parties, whether sworn or unsworn, as well as institute other inquiries necessary to clarify the matter (sections 59 (3), (5), 46 (1) of the Patent Act).

A hearing shall be held in the opposition proceedings upon request of a party or if the Patent Division deems this to be expedient pursuant to section 59 (3) sentence 1 of the Patent Act. The date of the hearing and a period appropriate for preparing the hearing should be fixed in the summons. If the summons is issued exclusively on the basis of a request of one party to the proceedings, although the factual and legal situation as such is already ripe for a decision on the basis of the written submission, this should be communicated in the summons, as this may have consequences in terms of costs ([cf. part A, section 9.5.2](#)).

When issuing the summons, the Patent Division shall draw attention to the points which in its opinion need to be discussed for the purposes of the decision to be taken (section 59 (3) sentence 2 of the Patent Act). This means that, in preparation for the hearing, the Patent Division will, as a rule, respond in due time to the parties' submissions in the form of a supplement to the summons, alternatively in the form of an interlocutory communication, and will indicate the points which are relevant for the decision and which need to be discussed. This aims at a concentration on the aspects that are essential for decision-making, contributing to achieve procedural expediency.

The chairpersons shall preside over the hearings. When conducting the hearing, care must be taken to ensure that all circumstances relevant to the decision are being discussed with the parties to the proceedings and that they are also given the opportunity to comment on legal issues. The purpose of the hearing is, in principle, to comment on factual or legal circumstances that still need to be discussed in addition to the written submissions. If duly summoned parties to the proceedings fail to appear, the hearing may nevertheless be held including delivery of the decision.

9.4.1 Public nature of the hearing

As a rule, hearings in opposition proceedings are public (section 59 (3) sentence 3 of the Patent Act). They are made known in such a way that the interested public can gain knowledge of the place and date of the hearing (e.g. by putting up a notice in the entrance area of the DPMA's office buildings, the hearing room).

In certain cases, the public may be excluded from the hearing (section 59 (3) sentence 4 of the Patent Act in conjunction with sections 171b to 175 of the Courts Constitution Act [*Gerichtsverfassungsgesetz*]). Section 59 (3) sentence 4 of the Patent Act provides that the public may also be excluded from a hearing at the request of one of the parties to the proceedings, for example, because an important business, trade, invention or tax secret is mentioned, the public discussion of which would violate overriding interests meriting protection (pursuant to section 172 no. 2 of the Courts Constitution Act). The exclusion shall be limited to the extent necessary. As a rule, the Patent Division shall discuss the exclusion of the public in a non-public sitting (pursuant to section 174 (1) sentence 1 of the Courts Constitution Act). As a rule, the order excluding the public must be delivered in public. The delivery of the decision on the maintenance or revocation of the patent shall be public in any case. It must be evident from the minutes whether the proceedings were public or non-public.

The chairpersons of the Patent Division shall ensure that order is maintained during the hearing and shall thus exercise their domestic authority (section 59 (4) of the Patent Act). For this purpose, they may impose disciplinary measures concerning the parties to the proceedings (including their legal representatives or counsels), witnesses, experts, lawyers and patent

attorneys, the audience or third parties staying in adjacent rooms. Chairpersons may decide that individuals are denied access to a hearing as listeners because of their inappropriate appearance (pursuant to section 175 of the Courts Constitution Act). Limiting access in the event of overcrowding of the hearing room does not constitute a breach of the principle of publicity of proceedings.

During the hearing, audio and television or radio recordings as well as audio and film recordings intended for public presentation or for publication of their content shall be inadmissible (section 59 (3) sentence 4 of the Patent Act in conjunction with section 169 (1) sentence 2 of the Courts Constitution Act).

9.4.2 Taking of evidence, witnesses

Pursuant to section 46 (1) sentence 1 of the Patent Act, applicable in opposition proceedings pursuant to section 59 (5) of the Patent Act, the Patent Division may at any time summon and hear the parties to the proceedings, may examine witnesses, experts and parties under oath or not under oath, and may undertake further examination as necessary to examine the matter. Visual inspection (by presentation or survey), experts (oral or written statement) and official documents, in addition to the examination of witnesses, may be taken into account as evidence with the highest probative value. The examination of the parties to the proceedings only has a subsidiary function and should take second place to the other means of evidence. The affirmation in lieu of an oath is a means of prima facie evidence (making a plausible case) within the framework of taking informal evidence and correspondingly has a lower probative value.

According to the principle of *ex-officio* examination, the taking of evidence is necessary if, from the point of view of the Patent Division, facts relevant to the decision have to be clarified and are accessible to the taking of evidence.

An announcement of the taking of evidence is necessary in order to ensure the right to be heard. In order to be able to conduct the taking of evidence efficiently and in a manner that ensures procedural expediency, it is advisable to issue a formal order on evidence to be taken in which the facts relevant to the decision and the means of evidence are specified. However, a formal order on evidence to be taken is not mandatory for the taking of evidence.

The order on evidence to be taken may be issued in the written proceedings or during the hearing. In the latter case, the order on evidence to be taken shall be delivered and recorded. The order on evidence to be taken may be amended at any time. If necessary, the competent local court may also be requested to execute the order on evidence to be taken. Pursuant to section 128 (1) of the Patent Act, the courts are obliged to provide legal assistance to the German Patent and Trade Mark Office. However, requests for legal

assistance shall only be made in exceptional cases, e.g. where the topic of evidence does not contain difficult technical details and it is unlikely that the Patent Division will ask supplementary questions of the witness.

An instruction may be issued to the effect that a question regarding which evidence is to be taken may be answered in writing (written testimony) if it is deemed sufficient in the light of the content of the question regarding which evidence is to be taken and taking into consideration the person of the witness (cf. section 377 (3) sentence 1 of the Code of Civil Procedure). The consent of the parties to the proceedings is not required. In general, it can be assumed that a written testimony of a witness has a lower probative value than an oral testimony, since there is no personal impression and no opportunity of raising further questions. The written testimony must contain answers to questions concerning credibility.

For the taking of evidence and the preparation thereof, the legally qualified member should be consulted in accordance with section 27 (3) of the Patent Act.

9.4.3 Minutes

Minutes shall be taken (section 59 (5) and section 46 (2) of the Patent Act) of the hearing (and, if applicable, of the examination), which shall normally be drawn up by a member of the Patent Division. They should concisely reflect the essential course of the proceedings and contain the legally relevant statements of the parties to the proceedings; sections 160a, 162 and 163 of the Code of Civil Procedure applies accordingly (section 59 (5) of the Patent Act in conjunction with section 46 (2) of the Patent Act). The fact of the delivery of the decision as well as the operative provisions of the decision delivered shall be included in the minutes of the hearing.

The minutes shall include the fact that the hearing before the Patent Division was open to the public, the date of the hearing and the persons present. They shall also include the course of the hearing, new state of the art to be taken into account and new circumstances or aspects, insofar as they are necessary for understanding the course of the hearing or serve the purpose of granting a right to be heard, as well as the legally relevant statements of the parties to the proceedings (in particular requests, amendments and withdrawals of requests, including amendments to the patent documents) and statements by witnesses, if any. In the case of content going beyond this, a sufficiently concise form must be chosen.

It is permissible to write down the contents of the minutes by hand, in a common shorthand, by using comprehensible abbreviations or to record them provisionally on a sound or data carrier. In this case, the electronic minutes shall be produced immediately after

the hearing. The minutes shall be read out loud to the parties or submitted to them for review, in which case section 162 of the Code of Civil Procedure applies accordingly. If the content of the minutes should have been recorded only on a provisional basis, reading the notes or replaying the recordings shall be sufficient. A note must be made in the minutes of the hearing that this has taken place and that the minutes have been approved by the parties to the proceedings. If objections are raised, these shall also be noted down. The final electronic minutes shall be signed by the chairperson and the person in charge of the records (pursuant to section 163 of the Code of Civil Procedure).

The parties to the proceedings shall receive a copy of the minutes, which shall be sent to them as soon as possible after the hearing.

9.4.4 Taking a decision at the end of the hearing

At the end of a hearing, a decision may be delivered, section 59 (5) in conjunction with section 47 (1) sentence 2 of the Patent Act. The German Patent and Trade Mark Office shall be bound by the decision delivered. Written submissions by the parties filed thereafter shall no longer be taken into consideration. When the decision is delivered, it is sufficient merely to make the operative provisions of the decision known and to refer to a later written statement of reasons. If the chairperson deems it appropriate, he shall communicate the essential content of the reasons. The delivery (section 47 (1) sentence 3, second half sentence of the Patent Act) shall not replace the prescribed service of a copy of the complete decision (operative provisions and statement of reasons) required under section 59 (5) of the Patent Act in conjunction with section 47 (1) sentence 1 of the Patent Act.

9.4.5 Deferring/postponing a hearing

The parties to the proceedings are required to participate in the hearing on the date notified. If a party to the proceedings demonstrates substantial and satisfying grounds for deferment, the hearing shall be deferred. Section 227 of the Code of Civil Procedure may be applied analogously.

In the interest of procedural expediency, one scheduled hearing should be sufficient to discuss all points relevant to the decision. If this cannot be achieved or if there are other substantial grounds, the hearing shall be postponed (i.e. it shall be interrupted for a limited period and continued on a subsequent date exactly where it was left off on the last day of the hearing). Substantial grounds justifying the postponement of the hearing are those which affect the right to be heard of one or several of the parties to the proceedings and which, especially to ensure the right to be heard, require that the need to expedite proceedings should be given lower priority.⁴⁴ This is particularly the case

⁴⁴ BGH GRUR 2004, 354 *Crimpwerkzeug*/postponement, with further references

where the party to the proceedings requesting postponement or the Patent Division is faced with a submission on which a factually well-founded comment can only be made after a reasonable period of reflection and preparation and to which no other remedy is possible, such as an interruption of the hearing. As a rule, however, it can be assumed that the parties to the proceedings can be expected to provide a sufficient comment on new submissions after a reasonable interruption, if the Patent Division also considers itself in a position to do so. A postponement is not necessary if the new submission is not taken into account to the detriment of the party requesting the postponement.

9.5 Decision

9.5.1 Substantive decision

Before a decision can be taken on the maintenance or revocation of the patent or on the rejection of an opposition as inadmissible, the Patent Division must hold deliberations and vote (section 2 (3) sentence 1 no. 1 of the DPMA Ordinance). If the decision is taken at a session, the date of the session shall not be communicated in advance to the parties to the proceedings. The session shall not be public. Minutes shall be taken of the session and shall contain information on the participants of the session, on the date of any previous hearing and on the decision taken. Exceptionally, a session may be dispensed with if the chairperson does not consider it necessary (section 2 (3) sentence 2 of the DPMA Ordinance).

Unlike the hearing, deliberations and the vote are not public. The Patent Division decides by a majority vote; in the event of a tie, the chairperson has the casting vote (section 2 (4) of the DPMA Ordinance). The decision as a result of the deliberations and the vote is, as a rule, already accessible to the parties to the proceedings and to the public on the basis of its delivery. The DPMA shall be bound by the decision delivered.

The decisions of the Patent Division shall be reasoned pursuant to section 59 (5), section 47 (1) sentence 1 of the Patent Act. The written statement of reasons must be drawn up in such a timely manner that the decision-makers can sufficiently remember the facts on which the decision is based. Therefore, the reasoned decision is to be signed and taken on file before the expiry of five months after the delivery. The structure and contents of the decisions depend on the requirements of the individual case. The decision shall contain, separated from the statement of reasons, the operative provisions (special dictum). It contains the actual decision as delivered in the event of the taking of a decision in a hearing. The operative provisions shall take precedence if there is a conflict between its

wording and that of the reasons. The reasons regularly consist of the facts of the case and the reasons for the decision. The facts shall summarise the subject-matter of the patent and the means of challenge and defence raised in connection with it in a concise manner and only based on the essential content, highlighting the motions submitted. The details of circumstances and facts as well as the status of the dispute thus far shall be included by reference being made to the written submissions, the minutes of the hearings and, where appropriate, minutes of the testimony of witnesses and other documents (cf. section 313 (2) of the Code of Civil Procedure). The reasons for the decision shall contain a brief introductory summary of the considerations of the facts and circumstances of the case and the legal aspects on which the decision is based (cf. section 313 (3) of the Code of Civil Procedure).

An inadmissible opposition shall be rejected by a decision. If the patent is maintained in a limited form, this amended version shall be clearly indicated in the operative provisions of the decision. As a rule, a reference to the relevant request documents, which are always included in the case file, is sufficient for this purpose. A word-by-word reproduction of extensive amendments are to be avoided in the operative provisions of the decision.

The decisions shall be accompanied by an instruction on the available legal remedies and a copy shall be served on the parties *ex officio*; the copy need not be certified (section 59 (5), section 47 (1) sentence 1 and (2) sentence 1 of the Patent Act). An execution copy of a decision shall be made only upon request of one of the parties concerned and only in paper form (section 59 (5), section 47 (1) sentence 2 of the Patent Act). Pursuant to section 20 (1) sentence 4 of the DPMA Ordinance, the Ordinance on the Keeping of Electronic Files at the Patent Office, the Patent Court and the Federal Court of Justice shall apply to the execution of electronic documents.

9.5.2 Decision on costs, reimbursement of opposition fee

As a basic principle, each party to the proceedings shall bear their own costs incurred from the opposition proceedings.

Section 62 (1) of the Patent Act provides for a deviation from the basic principle of each party bearing their own costs, but only for costs arising from a hearing or the taking of evidence and only if this is equitable. An imposition of costs is only equitable if the hearing or the taking of evidence was caused by conduct of the parties to the proceedings which constitutes a wrongful breach of the general duty of due procedural diligence. It is equitable that the party that has caused unnecessary costs by default or delay, negligence or other avoidable disruptions of the proceedings must bear these costs.⁴⁵ Therefore, the costs of the hearing

⁴⁵ BPatG 19 W (pat) 2/14, BeckRS 2015, 14006, with further references

may be imposed on a party who fails to appear without excuse at a hearing scheduled solely on his request or if that party fails to give notice of non-participation in time for the summons to be cancelled ([cf. part A, section 9.4](#)).

The imposition of costs may even be considered in the event that the opposition is withdrawn in full or in part or the patent is surrendered, section 62 (1) sentence 2 of the Patent Act).

Pursuant to section 62 (1) sentence 1 of the Patent Act, the Patent Division shall determine the imposition of costs at its reasonable discretion. The Patent Division shall duly exercise this discretion. Depending on the individual case, this discretion can be reduced in a manner that makes a decision on the costs mandatory. If a request for a decision on costs has been filed, the Patent Division must also decide on this request in the operative provisions of the decision. It is also possible to impose only specific individual costs on a party to the proceedings, such as the costs or travel expenses for a particular hearing or the examination of a particular witness.

After the basic decision on costs, which determines who must bear the costs, the costs to be refunded are determined in separate procedure. The civil servants in the upper intermediate grade of the civil service and comparable salaried employees referred to in section 7 (2) no. 1 of the Ordinance on the Performance of Particular Tasks for which the Examination Sections, the Utility Model Section, the Trade Mark Sections and the Divisions of the Patent Office are in charge (*Wahrnehmungsverordnung*) shall be entrusted with the determination of costs. The enforceable execution copy shall be issued by the registry clerk at the registry of the Federal Patent Court.

The possible decision on costs pursuant to section 62 (1) sentence 1 of the Patent Act does not comprise the opposition fee; the Patent Division may order that this fee shall be reimbursed in full or in part to the opponent if it is equitable (section 62 (1) sentence 3 of the Patent Act).

10. Legal remedies

10.1 Appeal

An appeal may be filed from the decisions of Patent Divisions (section 73 (1) of the Patent Act). The appeal shall be filed in writing with the German Patent and Trade Mark Office within one month of service of the decision (section 73 (2) sentence 1 of the Patent Act). Since decisions in opposition proceedings usually concern several parties and the appellant is usually opposed by another party to the proceedings who, on his part, would be adversely affected by rectifying the decision, that possibility is generally not available pursuant to section 73 (4) of the Patent Act.

The appeal fee is charged separately for each appellant; this shall also apply to appeals brought by several patent proprietors (see paragraph (1) of the Preliminary Remarks to Part B of the Schedule of Fees of the Patent Costs Act; information of the DPMA on the charging of fees for lodging appeals and/or legal remedies by several parties, dated 7 March 2016, <https://www.dpma.de>).

10.2 Correction of obvious mistakes

By applying section 95 of the Patent Act *accordingly*, errors of transcription, miscalculations and similar obvious mistakes in decisions of the Patent Divisions may be corrected at any time.

B Revocation or limitation proceedings

A partial or complete surrender of the patent (section 20 (1) no. 1 of the Patent Act) is a declaration which takes effect for the future only from the date of its receipt at the DPMA. In contrast, pursuant to section 64 of the Patent Act, the patent proprietor may at any time achieve a retroactive reduction of the scope of protection granted by means of limitation proceedings or remove it with retroactive effect, i.e. from the outset, by means of revocation proceedings.

For the revocation and limitation in proceedings pursuant to section 64 of the Patent Act, a request of the patent proprietor, i.e. the person recorded in the Patent Register pursuant to section 30 of the Patent Act, is required. Reference is also made to [part A](#) with regard to the term and status of the patent proprietor.

The request shall be filed in writing and reasoned (section 64 (2) of the Patent Act). Upon filing of the request, a fee according to the schedule of fees shall become due (section 3 (1) of the Patent Costs Act). Pursuant to section 6 (1) sentence 2 of the Patent Costs Act, the fee shall be paid within a period of three months from the filing of the request. If the fee is not paid in due time, the request is deemed to be withdrawn (section 6 (2) of the Patent Costs Act). Furthermore, the person filing the request may withdraw it at any time while the proceedings are pending. Third parties shall not be entitled to file a request. Please refer to [part A](#) for further information on the written form of the request and on the payment of fees.

The Patent Division shall take a decision on the request for revocation or limitation (section 64 (3) sentence 1 of the Patent Act). For further information on the Patent Division, please refer to [part A](#).

If a limitation is requested, this shall be effected by amending the patent claims (section 64 (1) of the Patent Act). Only if the scope of protection of the claims is reduced in a permissible manner, this constitutes a limitation.

The Patent Division applies sections 44 (1), 45 to 48 of the Patent Act *accordingly* (section 64 (3) sentence 2 of the Patent Act), i.e. with regard to the procedural principles. However, the *ex-officio* examination is limited to the extent that the request of the patent proprietor aimed at a mere limitation of the patent should not prompt a – repeated – examination of the substantive requirements for patentability.⁴⁶

The procedures for ensuring the right to be heard pursuant to [part A](#) apply accordingly. Objections by third persons are not provided for in the proceedings

under section 64 of the Patent Act. However, it remains at the discretion of the Patent Division to notify such objections to the patent proprietor for consideration in connection with the request.

If the patent is limited, the patent specification shall be adapted in respect of the limitation in the decision to allow the request; the amendment to the patent specification shall be published (section 64 (3) sentence 4 of the Patent Act). If the patent is revoked, this shall be published in the Patent Gazette (section 64 (3) sentence 3 of the Patent Act).

No statement of reasons is required if the request is allowed by the decision in application of section 47 (1) sentence 4 of the Patent Act. If a decision to grant the request cannot be taken, a request for a hearing shall be taken into consideration; however, the Patent Division may also schedule a hearing without a request by applying *accordingly* section 46 (1) sentence 1 of the Patent Act. The hearing is not public, unlike the hearing in opposition proceedings.

Revocation and limitation proceedings are applicable to national patents. They are also applicable to national parts of European patents which have effect for the territory of the Federal Republic of Germany.⁴⁷If, in proceedings before the DPMA, the national part of a European patent is being limited, the amendments are published by the DPMA. If a European patent with effect for the Federal Republic of Germany is limited in both, the national limitation proceedings as well as the European opposition proceedings, only that part of the patent remains protected which still enjoys protection after both decisions.⁴⁸

Revocation and limitation proceedings shall have the same priority as opposition proceedings. If, in addition to revocation or limitation proceedings, opposition proceedings are also pending, the proceedings shall be conducted in a manner that complies with procedural expediency.

⁴⁶ BGH GRUR 1964, 308 *Dosier- und Mischanlage*

⁴⁷ BGH BIPMZ 1995, 322 *Isothiazolon*; BGH GRUR 1996, 862 *Bogensegment*

⁴⁸ BGH GRUR 2001, 730 *Trigonellin*

C Informing the public

In accordance with section 31 of the Patent Act, the DPMA shall grant any person inspection of the files. This also includes online file inspection in so far as any person may inspect the files (section 31 (3a) of the Patent Act). File inspection shall be ruled out where it is precluded by a legal provision or where the interest meriting protection of the data subject within the meaning of Article 4 no. 1 of the General Data Protection Regulation, as amended, obviously prevails (section 31 (3b) of the Patent Act). Reference is made to [Mitteilung der Präsidentin Nr. 12/13](#) of 28 November 2013 concerning the introduction of electronic online file inspection in patent and utility model procedures.

Opposition as well as any additional oppositions are available by means of the electronic online file inspection after their receipt, as are any requests for limitation or revocation pursuant to section 64 of the Patent Act. Unless otherwise determined, any further correspondence shall also be accessible via file inspection.

However, online file inspection does not provide access to the non-patent literature contained in the file. This may be inspected if expressly requested at the DPMA by means of a written request for inspection of the files pursuant to section 31 (1) sentence 2 of the Patent Act. In addition to online inspection of the files, inspection is still possible, upon request, by having copies of file documents sent and by having them made available in one of the search rooms of the DPMA.

If the patent is revoked or maintained only with limitations, this fact shall be published in the Patent Gazette (section 61 (3) of the Patent Act) and a corresponding entry shall be made in the Patent Register. If the patent is maintained with limitations, the patent specification shall be amended accordingly; the amendment to the patent specification shall be published (section 61 (4) of the Patent Act). Pursuant to section 64 (3) of the Patent Act, this also applies in the case of revocation or limitation, at the request of the patent proprietor.

DPMAregister, by means of which the amended patent specification is also made available electronically, is accessible via the DPMA website (<https://register.dpma.de>).

Abbreviations

Art.	Article
BGH	<i>Bundesgerichtshof</i> (Federal Court of Justice)
BPatG	<i>Bundespatentgericht</i> (Federal Patent Court)
DPMA	German Patent and Trade Mark Office
DPMA Ordinance	Ordinance Concerning the German Patent and Trade Mark Office
et seq.	and the following
ZPO	German Code of Civil Procedure

Source references

BIPMZ	<i>Blatt für Patent-, Muster- und Zeichenwesen</i> (Official Gazette)
BPatGE	Decisions of the Federal Patent Court
GRUR	<i>Gewerblicher Rechtsschutz und Urheberrecht</i> (Journal of Intellectual Property Law & Practice of the German Association for the Protection of Intellectual Property)
Mitt	<i>Mitteilungen der deutschen Patentanwälte</i> (Communications of the German patent attorneys)

Decisions of the BGH and the BPatG since 2000 are available online on the websites of these courts at (www.bundesgerichtshof.de, www.bundespatentgericht.de).