Deutsches
Patent- und Markenamt

Guidelines for the Examination Procedure

(Examination Guidelines)*

of 2 March 2026

* *Prüfungsrichtlinien*

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Contents

Preliminary remarks 5

Legal bases 5

1. Requirements of the application, examination as to obvious deficiencies 6

1.1. Filing date, minimum requirements (sections 34, 35 of the Patent Act) 6

1.2. Examination as to obvious deficiencies (section 42 of the Patent Act) 6

1.3. Competence 6

1.4. Obviousness 6

1.5. Formal deficiencies 7

1.5.1. Designation of the inventor 7

1.5.2. Application fee 7

1.5.3. Violations of the Patent Ordinance 7

1.5.4. Deficiencies of the patent claims and of the description 7

1.6. Requirements pursuant to section 42 (2) of the Patent Act 8

1.6.1. Lack of an invention pursuant to section 42 (2) number 1 of the Patent Act 8

1.6.2. Industrial application pursuant to section 42 (2) number 2 of the Patent Act 8

1.6.3. Grounds for refusal (section 42 (2) number 3 of the Patent Act) 8

1.7. Unity 8

1.8. Conclusion of the examination as to obvious deficiencies 8

1.9. Reference regarding a division 8

1.10. Reference regarding priority rights 9

1.11. Granting time limits 9

1.12. Documents for the first publication of the patent application (*Offenlegungsschrift*) 9

2. Examination procedure 10

2.1 Request for examination (section 44 of the Patent Act) 10

2.2 Formal handling of the request for examination and of the replies 10

2.3 Substantive examination 10

2.3.1 Order of processing 10

2.3.2 Requests for accelerated processing 10

2.3.3 Subject matter of the examination 11

2.3.3.1. Disclosure of the invention (section 34 (4) of the Patent Act) 11

2.3.3.2. Examination as to patentability pursuant to section 1 to 5 of the Patent Act 11

2.3.3.2.1. Basic requirements pursuant to section 1 to 5 of the Patent Act 12

2.3.3.2.2. State of the art (section 3 of the Patent Act) 12

2.3.3.2.3. Novelty (section 3 of the Patent Act) 13

2.3.3.2.4. Inventive step (section 4 of the Patent Act) 13

2.3.3.2.5. Industrial application (section 5 of the Patent Act) 14

2.3.3.2.6. Search within the examination procedure 15

2.3.3.3. Amendment of documents/ impermissible extension (section 38 of the Patent Act) 15

2.3.3.4. Examination of unity of the application; division due to lack of unity 16

2.3.3.5. Free division of the application (section 39 (1) of the Patent Act) ... 17
2.3.3.6. Patent claims, patent category ... 17
2.3.3.7. Applications claiming a priority ... 18
2.3.3.7.1. Domestic priority ... 18
2.3.3.7.2. Foreign priority ... 19
2.3.3.8. Other aspects of the examination ... 19
2.4 Communications (section 45 of the Patent Act) ... 19
2.4.1. First communication ... 20
2.4.2. Other communications ... 20
2.5 Granting time limits ... 21
2.6 Hearings and telephone conversations ... 21
2.6.1. Hearings (section 46 of the Patent Act) ... 21
2.6.2. Calling without invitation ... 22
2.6.3. Telephone conversations ... 22
2.6.4. Participation in hearings and takings of evidence using image and sound transmission (section 46 (1) sentence 2 of the Patent Act) ... 22
2.7 Preparation of the grant of the patent applied for ... 23
2.7.1 Filing of documents ready for grant ... 23
2.7.2 Editing documents ... 23
2.8 Decisions of the examining section (section 47 of the Patent Act) ... 23
2.8.1 Decision to grant (section 49 of the Patent Act) ... 24
2.8.2 Decision to refuse the application (section 48 of the Patent Act) ... 24
2.9 Appeal and review ... 24
3. Special procedures and subject matter of application ... 26
3.1. Applications concerning biotechnological inventions ... 26
3.1.1 General aspects ... 26
3.1.2 Requirements of a deposit in detail ... 27
3.1.2.1 Date of deposit ... 27
3.1.2.2 Information concerning the depositary institution and the deposited biological material 27
3.1.2.3 Duration of storage ... 27
3.1.2.4 Furnishing of samples and undertaking ... 27
3.1.2.5 Furnishing proof of the deposit ... 28
3.2. Applications concerning program-related inventions (computer-implemented inventions) ... 28
3.2.1. "Technicity" pursuant to section 1(1) of the Patent Act ... 28
3.2.2. Exceptions to patentability under section 1 (3), (4) of the Patent Act ... 28
3.2.3. Three-stage examination approach of the *Bundesgerichtshof* ... 29
3.2.3.1. First stage: examination of the requirement of technicity pursuant to section 1 (1) of the Patent Act ... 29
3.2.3.2. Second stage: examination as to whether a concrete technical problem is solved by technical means (exceptions to patentability pursuant to section 1 (3), (4) of the Patent Act) ... 30
3.2.3.3. Third stage: examination of the solution a specific technical problem as to novelty and inventive step pursuant to sections 3, 4 of the Patent Act ... 31

3.2.4. Further aspects regarding program-related inventions 32
3.3. Inventions relating to artificial intelligence 32
4. Informing the public 33
Abbreviations 34
References 34

Preliminary remarks

As of 2 March 2026, these Guidelines replace the Guidelines for the Examination Procedure of 6 May 2025.

The Guidelines contain the basic principles applicable to the examination procedure before the German Patent and Trade Mark Office (DPMA). They are to ensure the uniform and expeditious handling of the procedural steps by the examining sections of the DPMA: examination as to obvious deficiencies, search, drafting of communications, grant and refusal of the application. Orders contrary to the Guidelines are hereby repealed.

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

As a rule, the parties to the procedure are to consider the Guidelines within the framework of their obligations to cooperate and thus assist in a consistent and streamlined examination procedure. The collaborative participation in the proceedings can make a significant contribution to speeding up the procedure. This includes, in particular, responding to communications in a timely manner, submitting documents and communications promptly and attending the hearings very well-prepared.

Special aspects of each particular case and the current case law must always be taken into account. In individual cases it may be necessary to deviate from general principles due to special circumstances.

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

Munich, February 2026

Legal bases

The statutory framework of the patent examination procedure 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 – Wahrnehmungsverordnung*),
- 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. Requirements of the application, examination as to obvious deficiencies

1.1. Filing date, minimum requirements (sections 34, 35 of the Patent Act)

The date of filing of the patent application is the date on which the documents referred to in section 34 (3) numbers 1 and 2 of the Patent Act and, if at any rate they contain particulars which by all appearances are to be regarded as a description, have been received (section 35 (1) of the Patent Act), in accordance with section 34 (3) number 4 of the Patent Act, by

1) the German Patent and Trade Mark Office (DPMA), or
2) a patent information centre, if this agency has been determined by notice published by the Federal Ministry of Justice and Consumer Protection in the Federal Law Gazette.

If the documents or parts thereof are not in German, this applies only if a German translation is received by the DPMA within a period referred to in section 35a (1) sentence 1 or section 35a (2) of the Patent Act; otherwise, the application is deemed to be withdrawn.

If the applicant subsequently files missing drawings or missing parts of the description after having been invited to do so in accordance with section 35 (2) sentence 1 of the Patent Act or on his own initiative, the date of receipt of the drawings or missing parts of the description at the German Patent and Trade Mark Office constitutes the filing date; otherwise any reference to the drawings or parts of the description is deemed not to have been made (section 35 (2), (3) of the Patent Act).

Pursuant to section 34 (3) numbers 1, 2 and 4 of the Patent Act the application must contain:

- the name of the applicant;
- a request for the grant of a patent, which designates the invention clearly and concisely; and
- a description of the invention.

If the minimum requirements mentioned in section 35 (1) of the Patent Act are fulfilled, the patent application is legally valid. If the requirements are fulfilled one after the other, the application is legally valid only after the last of the requirement has been met. Where the minimum requirements are not met, there is no scope of discretion left for rejecting such an "application". Rather, after having granted the right to be heard, it has to be stated by a decision that the filing does not constitute a legally valid patent application. [1]

1.2. Examination as to obvious deficiencies (section 42 of the Patent Act)

The scope of the examination as to obvious deficiencies must be limited to the requirements specified in section 42 of the Patent Act.

If a legally valid application has been filed (see paragraph 2.1), which obviously does not comply with the requirements of sections 34, 36, 37 and 38 of the Patent Act, the examining section will invite the applicant to remedy the deficiencies within a specified period (section 42 (1) sentence 1 of the Patent Act).

If the subject matter of the application obviously:

1) does not, by reason of its nature, constitute an invention,
2) is not susceptible of industrial application, or
3) is excluded from the grant of a patent in accordance with section 1a (1), section 2 or section 2a (1) of the Patent Act

the examining section notifies the applicant accordingly, stating its reasons, and invites him to comment within a specified period (section 42 (2) of the Patent Act).

The examining section refuses the application (section 42 (3) sentence 1 of the Patent Act), if the deficiencies which it has objected to pursuant to section 42 (1) of the Patent Act are not rectified or if the application is maintained although obviously the invention is not patentable (section 42 (2) sentence 1 numbers 1 to 3 of the Patent Act). If the refusal is to be based on circumstances which have not yet been communicated to the patent applicant, he must first be given the opportunity to give comment within a certain period (section 42 (3) sentence 2 of the Patent Act).

1.3. Competence

Examination as to obvious substantive deficiencies under section 42 of the Patent Act is carried out by the patent examiners competent in the field. Officials of the higher intermediate and lower intermediate grades of the civil service as well as comparable employees are responsible for the formal processing of patent applications, pursuant to section 27 (5) of the Patent Act in conjunction with section 1 of the *Wahrnehmungsverordnung*.

1.4. Obviousness

Only deficiencies which are obvious are to be objected to during the examination under section 42 (1) and (2) of the Patent Act. A deficiency is obvious if the examining section, on the basis of the facts submitted to it, can recognise the deficiency as such without doubt and without further substantive examination, meaning the deficiency becomes clearly evident.

[1] BPatG GRUR 184, 804

Therefore, the facts submitted to the DPMA with the application documents must be assessed by the examining section on the basis of its special technical knowledge, as a rule, without using material which is not immediately available and without further investigation and searches. This does not only apply to issues of a more technical nature, but also to issues of a more legal nature. Where the latter can be clearly and unequivocally answered on the basis of established case law, the examining section will normally be able to use them as the basis for its examination as to obvious deficiencies, provided that no particular problems arise. [2] Novelty and inventive step are not examined in the examination as to obvious deficiencies.

1.5. Formal deficiencies

Formal deficiencies which can be objected to within the scope of an examination as to obvious deficiencies exist, in particular, if

a) the request for the grant of a patent is incomplete or deviates from the contents of the power of attorney;

b) there are doubts as to whether the patent is requested for the applicant, in the name of the applicant's company or his civil name;

c) in the case of several applicants without a common representative, no person authorised to accept service is named or if not all of the co-applicants have signed;

d) parts of the documents making up the application (patent claims, description, drawings, if any, and the abstract - text and drawing, if any, -) are missing pursuant to sections 34 to 36 of the Patent Act;

e) the power of attorney document for the representative(s) indicated in the request is incomplete or missing, unless the representative is a lawyer within the meaning of section 15 of the Ordinance Concerning the German Patent and Trade Mark Office or a lawyer of an applicant having neither a residence nor principal place of business nor an establishment in Germany (section 25 of the Patent Act);

f) the title of the invention (section 34 (3) number 2 of the Patent Act) is not clear and concise; or

g) the designation of the inventor (section 37 of the Patent Act) is missing or incomplete.

1.5.1. Designation of the inventor

The designation of the inventor must be submitted within a period of 15 months from the filing date, or, if a priority date is claimed for the application, within 15 months from that date, section 37 (1) sentence 1 of the Patent Act. If the applicant can justifiably show that exceptional circumstances prevented him from making this declaration in due time, he is to be granted a reasonable extension of time (section 37 (2) of the Patent Act).

If the applicant has named himself as sole inventor, the declaration does not have to be submitted on a separate document, unless the inventor files a request not to be mentioned. [3]

1.5.2. Application fee

A fee pursuant to the Patent Costs Act (section 2 (1) of the Patent Costs Act) will be charged for the application. If a fee is not paid, not paid in full or not paid in due time (within three months from filing the application), the application is deemed withdrawn (sections 3, 6 of the Patent Costs Act).

1.5.3. Violations of the Patent Ordinance

If the application does not comply with the requirements concerning the form and other application requirements (section 34 (6) of the Patent Act; Patent Ordinance), the examining section may refrain from objecting to these deficiencies (section 42 (1) sentence 2 of the Patent Act) until the commencement of the examination procedure (section 44 of the Patent Act). Accordingly, the examining section may, in the course of the examination as to obvious deficiencies, restrict itself to those deficiencies that impede the printing of the first publication of the application documents (*Offenlegungsschrift*) or prevent an appropriate search. In the interest of the public exacting standards are to be applied to the quality of the documents, particularly to their legibility.

1.5.4. Deficiencies of the patent claims and of the description

With respect to the contents and the structure of the patent claims and the description only grave deficiencies are to be notified during the examination as to obvious deficiencies. Grave deficiencies mean that there is a risk of misleading the public when the first publication of the application documents (*Offenlegungsschrift*) is issued (otherwise see paragraph 2.3.3.6).

[2] BGH BlPMZ 71, 371 *Isomerisierung*

[3] BPatG BlPMZ 79, 181

1.6. Requirements pursuant to section 42 (2) of the Patent Act

1.6.1. Lack of an invention pursuant to section 42 (2) number 1 of the Patent Act

The subject matter of an application must be in one field of technology and must not obviously constitute a subject matter stated in section 1 (3) of the Patent Act.

1.6.2. Industrial application pursuant to section 42 (2) number 2 of the Patent Act

Lack of industrial application must be recognisable without doubt and without further investigation when examining the application documents as to obvious deficiencies.

Within the course of the examination as to obvious deficiencies, purely therapeutic and diagnostic medical methods may be objected to if there is no doubt that no other use is possible.

1.6.3. Grounds for refusal (section 42 (2) number 3 of the Patent Act)

The grounds for refusal under section 42 (2) number 3 of the Patent Act relate to the exceptions to patentability under section 1a (1), section 2 or section 2a (1) of the Patent Act. This covers in particular inventions the commercial exploitation of which would be contrary to public policy or morality (section 2 of the Patent Act), the human body, at the various stages of its formation and development, including germ cells (section 1a (1) of the Patent Act), plant or animal varieties and essentially biological processes for the production of plants and animals and also methods for the treatment of the human or animal body by surgery or therapy (section 2a (1) of the Patent Act). It should be noted in this context that the wording of the Patent Act is based on Article 4*quater* of the Paris Convention for the Protection of Industrial Property, according to which the grant of a patent cannot be refused and a patent cannot be declared invalid on the grounds that the sale of the patented product or the product resulting from a patented process is subject to restrictions imposed by national legislation. An exception to patentability exists pursuant to section 2 (1) of the Patent Act if the intended use of the invention would be contrary to public policy or morality. Not every legal violation constitutes a violation of public order. An exception to patentability exists if substantial norms or principles which constitute fundamental principles of the legal and moral order are affected (provisions on the protection of fundamental rights and human rights, for example, the War Weapons Control Act (*Gesetz über die Kontrolle von Kriegswaffen* – Federal Law Gazette I 1990, page 2507) or the Embryo Protection Act (*Gesetz zum Schutze von Embryonen* – Federal Law Gazette I 1990, page 2746).

1.7. Unity

In this context, the examination as to obvious deficiencies has the purpose of preventing that several obviously unrelated inventions are improperly combined in a single application. However, there is no obvious lack of unity where a technically useful and – before taking state of the art into account – unitary problem can be stated, and the solution of this problem requires all parts of the application or if all parts of the application are at least appropriate for solving the problem. [4]

1.8. Conclusion of the examination as to obvious deficiencies

If the examining section has not found any obvious deficiencies, it makes a corresponding note in the files. If obvious deficiencies are found, these will be notified and the applicant will be invited to remedy them within a certain period (section 42 (1) sentence 1 of the Patent Act). If the applicant objects to the notification of a deficiency while specifying the grounds for his opinion, another communication is to be issued in exceptional cases only. If the reasons are sound the objection must be dropped. The examining section rejects the application (section 42 (3) sentence 1 of the Patent Act) if the reasons specified by the applicant are not convincing and the deficiencies are not remedied.

When corresponding with the applicant in the course of the examination as to obvious deficiencies, the examiner must take care that the conclusive decision (refusal of the application or dropping of the examiner's objection) is issued four months from the date of filing at the latest. This is necessary, in particular, where priority is claimed, to ensure that the corrected documents can be used for printing the first publication of the application documents (*Offenlegungsschrift*). If it is not possible to conclude the examination as to obvious deficiencies in time, the uncorrected documents are to be used for printing the first publication of the application documents (*Offenlegungsschrift*).

1.9. Reference regarding a division

With regard to the possibility of the division of an application by the applicant, reference is made to paragraph 2.3.3.5.

[4] BPatG BlPMZ 80, 118

1.10. Reference regarding priority rights

The substantive entitlement to claim priority – whether domestic or foreign – is not examined during the examination as to obvious deficiencies. [5]

1.11. Granting time limits

In the examination as to obvious deficiencies pursuant to section 42 of the Patent Act, the time limit of four months for answering a communication may be reduced to two months, if otherwise the examination for obvious deficiencies cannot be completed before the application is laid open to the public.

1.12. Documents for the first publication of the patent application (*Offenlegungsschrift*)

The patent applications are published to inform the public of the possible creation of industrial property rights.

If the examination as to obvious deficiencies cannot be concluded before the expiry of the relevant period for laying the application open for public inspection (18 months, section 31 (2) number 2 of the Patent Act), the uncorrected documents are to be used for the first publication of the patent application (*Offenlegungsschrift)*.

The application must, as a rule, be laid open to the public even if it is subject of an appeal, except for appeals against the file inspection itself, against its date or against the intended contents of the first publication of the patent application (*Offenlegungsschrift*).

The patent application is not published and no reference pursuant to section 32 (5) of the Patent Act is made, if the patent specification has already been published (section 32 (2) sentence 2 of the Patent Act). The German Patent and Trade Mark Office may refrain from publishing the patent application if it contains information or drawings which are obviously contrary to 'ordre public' or morality (section 32 (2) sentence 3 of the Patent Act). Non-publication is to be limited to the problematic parts of the application. Contents which are obviously contrary to 'ordre public' or morality may result in particular from individual information or drawings, from the factual link between them or from the industrial application of the invention described by them. In exceptional cases, the entire application may not be published, in particular if the publication of the application would no longer have any informative content for the public after the extensive deletion of the problematic parts.

The originally filed documents must be used for the first publication of the patent application. If the drawings are missing when the application is received, although the application contains a reference to drawings or if the abstract is missing, and if these documents are filed subsequently in due time, they are to be incorporated in the documents for the first publication of the application (*Offenlegungsschrift*). Drawings that cannot be printed are to be treated as missing drawings. [6] Please refer to paragraph 1.1 for any postponement of the filing date resulting from the subsequent filing of missing drawings.

If the whole application or parts thereof is/are not drafted in German, the German translation is to be incorporated in the publication of the patent application (*Offenlegungsschrift*) instead of the foreign-language documents, provided it was filed in due time and complies with the requirements under section 14 of the Patent Ordinance.

After the examination as to obvious deficiencies by the examining section, such documents are also to be used for printing the patent application (*Offenlegungsschrift*) which were subsequently filed because the original documents were not printable or contained obvious errors or were submitted upon request of the examining section to remedy an obvious deficiency.

Other unsolicited new documents filed by the applicant are to be included in the files but not used for the first publication of the patent application (*Offenlegungsschrift*), not even if expressly so requested by the applicant. In the latter case the applicant is to be briefly notified accordingly.

In all cases in which the publication of the patent application (*Offenlegungsschrift*) is not based exclusively on the documents received on the filing date, a note is to be made on the title page of the first publication of the patent application (*Offenlegungsschrift*), stating that the content of the documents published is not identical with the documents filed on the date of filing.

[5] BPatG GRUR 1986, 607 *Schallsonde*

[6] BPatG of 16 December 2014 – 21 W (pat) 70/09

2. Examination procedure

2.1 Request for examination (section 44 of the Patent Act)

A valid request for examination is a prerequisite for the examination procedure pursuant to section 44 of the Patent Act (section 44 (1) of the Patent Act). The request for examination may be filed by the patent applicant or by any third party until the expiration of a period of seven years from filing the application (section 44 (2) of the Patent Act). This request presupposes a pending application and may also be submitted simultaneously with the application. Where the request has been filed by a third party, the applicant is notified of this fact (section 44 (3) sentence 2 of the Patent Act).

Any person having neither a residence nor an office nor an establishment in Germany may file a valid request for examination only if he has appointed a lawyer or patent attorney as his representative who is entitled and authorised to represent the applicant in proceedings before the Patent Office (section 44 (3) sentence 3 in conjunction with section 43 (2) sentence 3 in conjunction with section 25 of the Patent Act).

A fee pursuant to the Patent Costs Act is charged for the request. The payment period for the examination fee under the Patent Costs Act is three months from the due date, that is from the filing of the examination request with the DPMA (section 3 (1) of the Patent Costs Act). This period ends on the date of expiry of seven years after filing the application at the latest (section 44 (2) sentence 3 of the Patent Act). Processing of the request for examination will only begin when the fee has been paid (section 5 (1) of the Patent Costs Act).

If a search request pursuant to section 43 of the Patent Act has been filed before or together with the request for examination, the examination procedure will begin only after the search request has been processed (section 44 (3) sentence 1 of the Patent Act). If there are grounds indicating that it was not the intention of the applicant to request a separate search under section 43 of the Patent Act, the examining section will contact the applicant to clarify this.

If a request for examination has already been received, subsequent requests for examination are deemed not to have been filed (section 44 (3) sentence 3 in conjunction with section 43 (5) of the Patent Act).

Any third party who has filed a valid request for examination does not become a party to the examination proceedings (section 44 (2) of the Patent Act). He does not receive copies of communications or decisions. However, he may request file inspection. The third party will be informed of the conclusion of the procedure.

The examination procedure continues even if the request for examination is withdrawn (section 44 (5) of the Patent Act).

2.2 Formal handling of the request for examination and of the replies

In a first step, the request for examination is examined for formal deficiencies. After receipt of the fee, the case file will be passed on to the examining section in charge of the respective main class. This section is in charge of the substantive examination of the application. Immediately after the receipt of the case file, the examining section checks whether it is competent. If not, the examining section in charge must be identified without delay and the case file forwarded to that section. The competent examining section adds, if necessary, the appropriate ancillary classes on the form provided for that purpose. If a reply is received, it has to be examined in the same way, if competence still lies with the previously competent examining section.

The request for examination is published in the Patent Gazette.

If a third party request is found to be invalid after notification of the patent applicant, this fact is notified to the third party and the applicant (section 44 (4) sentence 1 of the Patent Act).

2.3 Substantive examination

2.3.1 Order of processing

As a rule, applications are being processed in the chronological order of receipt of the respective requests for examination. Replies are also being processed in the order of receipt. However, for reasons of efficiency, it may sometimes be more appropriate to jointly process technically related cases and to depart from the usual order of processing.

Applications and replies should be given preference, in particular, if:

a) the prospect of a patent grant had been promised and the decision of grant can now be taken without delay;

b) the applicant has not, or not completely, remedied deficiencies objected to, and therefore a refusal seems to be appropriate;

c) in the preceding communication deficiencies have been notified that do not allow the grant of a patent and the files clearly show immediately that the applicant's statements do not give rise to change this opinion.

2.3.2 Requests for accelerated processing

Where a well-founded request for accelerated processing is filed, preference is to be given to this procedure, if it seems possible that the usually expected duration of procedure might lead to considerable disadvantages for the requester. Requests for accelerated processing are in principle only

applicable to the next procedural step, however, the further procedure is speeded up if this follows from the request.

2.3.3 Subject matter of the examination

The application must comply with the requirements of sections 34, 37 and 38 of the Patent Act, and the subject matter of the application must be patentable under sections 1 to 5 of the Patent Act.

The examination of patentability, as a rule, requires an interpretation of the patent claim from the point of view of the competent skilled person, using the description and the drawings (see section 14 sentence 2 of the Patent Act), to determine the semantic content of the patent claim in its entirety and the contribution that the individual features make to the achievement of the invention. [7]

The subject-matter of the patent application must be searched on the basis of this interpretation and examined for the existence of the grounds for refusal explicitly and clearly stated in the Patent Act (that is essentially for patentability under sections 1 to 5 of the Patent Act and for disclosure of the invention under section 34 (4) of the Patent Act).

Lack of "clarity" should not be given as a single ground for refusal without interpretation of the claims and without carrying out a search.

2.3.3.1. Disclosure of the invention (section 34 (4) of the Patent Act)

Pursuant to section 34 (4) of the Patent Act, the application must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. The invention (technical teaching) may be disclosed in any part of the application documents except for the abstract, which serves exclusively to provide technical information to the public (section 36 of the Patent Act).

An invention is disclosed in a clear and complete manner if the information contained in the patent application provides the reader skilled in the art with so much technical information that he is able to successfully execute the invention using his specialist knowledge and skills. [8]

It is only necessary to indicate the decisive direction in which the person skilled in the art may work on his own accord. [9] The requirement of clear and complete disclosure does not require the description to contain indications of how to achieve all conceivable variants covered by the functional definition. It is sufficient if at least one practicable way is disclosed to the person skilled in the art. [10] However, it does not conflict with the clear and complete disclosure of an invention if the person skilled in the art still has to carry out tests in order to achieve the desired result on the basis of the information pointing the way in the patent specification, as long as such tests do not exceed the extent reasonable in the individual case. [11] The information in the patent specification must provide the person skilled in the art with sufficient information to enable him to successfully carry out the invention without any inventive effort on his part. It is not necessary to disclose directly and unambiguously at least one practical embodiment as such. [12] Consequently, it is not necessary to describe the invention in every detail. However, generalisation must not go so far as to only state the terms which merely circumscribe the problem of the underlying invention. This would be an obstacle to technical progress. [13] Likewise, general indications of ranges of physical properties going beyond the teaching disclosed to the skilled person in the documents must not be overly generalised so that protection would be extended to hypothetically claimed broad ranges exceeding the contribution made by the invention. [14]

2.3.3.2. Examination as to patentability pursuant to section 1 to 5 of the Patent Act

The invention for which a patent is sought must be patentable (see sections 1 to 5 of the Patent Act). For assessing patentability, the subject matter of the patent claim or claims must be examined with all features describing it, since this will determine the subject matter to be protected under sections 14 and 34 (3) number 3 of the Patent Act.

Before the assessment of patentability, the relevant skilled person must be defined, since the examination as to whether the subject matter of the application is new as compared to the state of the art and involves an inventive step must be performed from the point of view of the skilled person concerned. The meaning of the features of patent claims must be interpreted from the point of view of the skilled person in order to determine the claimed subject matter for the subsequent assessment of patentability. [15]

Where appropriate, the description and the drawings must be used to interpret the patent claims (see section 14 sentence 2 of the Patent Act). [16]

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7 BGH GRUR 2012, 1124 *Polymerschaum*

8 BGH GRUR 2010, 916 *Klammernahtgerät*

9 BGH GRUR 1968, 311 *Garmachverfahren*

10 BGH GRUR 2001, 813 *Taxol*; BGH Mitt 2015, 563 *Übertragungspapier für Tintenstrahldrucker*

11 BGH GRUR 1976, 213 *Brillengestelle*

12 BGH GRUR 2010, 916 *Klammernahtgerät*

13 BGH GRUR 1985, 31 *Acrylfasern*

14 BGH GRUR 2010, 414 *Thermoplastische Zusammensetzung*

15 BPatG GRUR 2014, 545 *Batterieüberwachungsgerät*

16 BGH GRUR 2001, 232 *Brieflocher*

2.3.3.2.1. Basic requirements pursuant to section 1 to 5 of the Patent Act

Pursuant to section 1 (1) of the Patent Act, patents are only granted to inventions which are new, involve an inventive step and are susceptible of industrial application.

In addition, the inventions must relate to a field of technology.

Generally, this is the case where an invention contains a systematic teaching applying controllable natural forces to achieve a causally predictable result. [17] However, it is not necessary that the causally predictable result is brought about directly by using controllable natural forces and without intervention of human intellectual power. Rather, an invention can also be of a technical nature if it is characterised through knowledge based on technical considerations and its implementation. [18] Likewise, it is no obstacle to the technical character of a teaching if, among other things, it also involves the intervention of the human intellect. [19] As a rule, reasons must be given for the assessment of a feature as non-technical.

If a patent claim with a combination of technical and non-technical features is to be examined, its subject matter is as a rule eligible for patent protection. However, non-technical features must not be taken into account in the examination of the inventive step. [20]

The following subject matter or activities are not considered to be inventions within the meaning of the Patent Act and are, in general, not patentable (section 1 (3) of the Patent Act):

1) discoveries and scientific theories and mathematical methods (for example, Archimedes' principle, methods for solving a system of equations);
2) aesthetic creations (for example, purely decorative designs of a surface or an object);
3) schemes, rules and methods for performing mental acts, playing games or doing business (for example, schemes for acquiring special skills; methods for solving brain teasers or schemes for organising commercial services) and computer programs (for details see paragraph 3.2);
4) presentation of information (for example, literature, news or message contents).

The exclusion of the subject matter or activities mentioned under 1) to 4) is only applicable to the extent that protection is sought for them as such (section 1 (3), (4) of the Patent Act), meaning they are only excluded from patent protection insofar as they are claimed irrespective of any particular implementation. If the teaching contains instructions to solve a specific technical problem with technical means, the exclusion from patentability does not apply. [21]

Moreover, the exclusions from patentability under section 1a (1), section 2 or Sec 2a (1) of the Patent Act should be noted (see paragraphs 1.6.3 and 3.2). Pursuant to section 2a (1) number 2 of the Patent Act, particularly methods for the treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body are excluded from patent protection. While a combination of technical and non-technical features may constitute a patentable invention (see above), multi-step methods are not patentable as a whole pursuant to section 2a (1) number 2 of the Patent Act if one of the steps includes a method of surgery, therapy or diagnosis.

2.3.3.2.2. State of the art (section 3 of the Patent Act)

The state of the art comprises any knowledge made available to the public by means of a written or oral description, by use, or in any other way, *before* the date relevant for the priority of the application (section 3 sentence 2 of the Patent Act).

According to section 3 (2) of the Patent Act the contents of the following patent applications, having an earlier filing date or priority date and having been made available to the public only on or after the date relevant for the priority of the later application, are considered as comprised in the state of the art:

1) national applications as originally filed with the German Patent and Trade Mark Office;
2) European applications as originally filed with the competent authority, in which protection is sought in the Federal Republic of Germany and for which the designation fee for the Federal Republic of Germany has been paid in accordance with Article 79 (2) of the European Patent Convention (EPC), unless the application for a European patent is based on an international application and does not fulfil the conditions set out in Article 153 (5) of the EPC;
3) international applications under the Patent Cooperation Treaty (PCT) as originally filed with the receiving office, if the German Patent and Trade Mark Office is a designated office for the application.

Thus the entire content of earlier applications is state of the art; it is not relevant whether or not and to what

[17] BGH GRUR 1969, 672 *Rote Taube*
[18] BGH GRUR 2000, 498 *Logikverifikation*
[19] BGH GRUR 2000, 1007 *Sprachanalyseeinrichtung*
[20] BGH GRUR 2011, 125 *Wiedergabe topografischer Informationen* and BGH GRUR 2013, 909 *Fahrzeugnavigationssystem*
[21] BGH GRUR 2002, 143 *Suche fehlerhafter Zeichenketten*; BGH GRUR 2010, 613 *Dynamische Dokumentengenerierung*; BGH GRUR 2011, 610 *Web-seitenanzeige*

extent a patent is being granted for the earlier application.

A disclosure of an invention comprised in the state of the art under section 3 (1) and (2) of the Patent Act is not taken into consideration if the disclosure occurred no earlier than six months *preceding* the filing of the application and was due to an evident abuse to the detriment of the applicant or his legal predecessor (section 3 (5) number 1 of the Patent Act) or a display of the invention by the applicant at official or officially recognised exhibitions (section 3 (5) number 2 of the Patent Act). The relevant exhibitions are notified by the Federal Ministry of Justice and Consumer Protection in the Federal Law Gazette (section 3 (5) sentence 3 of the Patent Act). However, the applicant must state, when filing the application, that the invention has been displayed, and file a certificate to that effect within four months after filing the application (section 3 (5) sentence 2 of the Patent Act).

2.3.3.2.3. Novelty (section 3 of the Patent Act)

During the examination as to novelty, it must be determined whether the subject matter of the patent application differs in any respect from each individual prior publication and prior use with regard to the features according to the invention.[22] The subject matter is deemed new if each individual comparison with the state of the art shows at least one feature of the subject matter that is not comprised in the state of the art taken into consideration. Conversely, novelty can only be denied if all the features of the patent claim can be inferred from a single citation.[23] The entire contents of the technical teaching of the respective prior publication is relevant, for example, document, lecture or prior use. In this context it is not important whether an item was mentioned casually or presented as an essential finding in the context of the disclosed technical teaching. What matters is what the average person skilled in the relevant field of technology was able to directly and unambiguously infer in connection with the technical teaching disclosed. Something can also be disclosed when it is not expressly mentioned in the state of the art but is self-evident to the skilled person for the teaching and for this reason does not require separate disclosure (but is instead "read into" the document). However, the inclusion of the self-evident does not permit specialist knowledge to be added to the disclosure, but merely serves to identify the complete meaning, that is the technical information that the expert reader will derive from the source against the background of his specialist knowledge.[24]

The relevant content of an application with earlier filing date or priority date that is to be considered as state of the art is the content of that application, where the date relevant for the earlier priority of the application is established by virtue of its earlier filing date. If the date relevant for earlier priority of an application is based on claiming the priority of an earlier application, the content of that application, but only to the extent that it does not go beyond the contents of the earlier application establishing priority is to be considered as state of the art (section 3 (2) sentence 2 of the Patent Act).

If the examining section has ascertained an application with an earlier filing date or priority date that has not yet been made available to the public, the contents and file number of this earlier application may only be communicated to the applicant of the later application after the earlier application has been made available to the public. The earlier application becomes part of the state of the art if it was still pending at the time of its publication. If it was no longer pending at the time of its publication and was nevertheless published, it becomes part of the state of the art on the date of its publication. However, it remains state of the art if it is withdrawn or refused after publication or is deemed to have been withdrawn.[25]

Substances known from the state of the art may be patentable if they are intended for the treatment of the human or animal body by surgery or therapy, or for diagnostic methods practised on the human or animal body (see section 2a (1) number 2 sentence 2 of the Patent Act) and if their use for this particular purpose has not been known (section 3 (3) of the Patent Act). This applies accordingly pursuant to section 3 (4) of the Patent Act to a new use of these substances (second medical indication).

2.3.3.2.4. Inventive step (section 4 of the Patent Act)

The invention must involve an inventive step. It is considered to involve an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art (section 4 of the Patent Act).

First of all, the examining section has to ascertain the state of the art available to the average person skilled in that field before the date relevant for the priority of the application. The assessment whether the subject matter of the invention was obvious for an average skilled person (on the filing date or priority date) must be made on this basis, seen in connection with the specialist knowledge of an average skilled person and avoiding a retrospective approach. The competent skilled person is the person who would normally be assigned the task or the technical problem to be solved. If the ascertained knowledge is part of another technical field, it is doubtful whether it can be attributed to the knowledge of the average skilled person. However, the skilled person may regularly

[22] BGH GRUR 1984, 797 *Zinkenkreisel*

[23] BGH GRUR 2015, 472 *Stabilisierung der Wasserqualität*

[24] BGH GRUR 2014, 758 *Proteintrennung* and BGH GRUR 2008, 382 *Olanzapin*

[25] BGH GRUR 2016, 166 *PALplus*

consult another expert. [26] A team of experts can also be taken into consideration for the assessment of obviousness. [27] The skilled person for assessing obviousness is not the user but the developer of a subject matter, and must usually be defined. [28]

It depends on the individual case whether the invention involves an inventive step. The courts have not developed generally applicable specific criteria in case law for this evaluative decision allowing to draw unambiguous conclusions as to inventiveness in other cases. Decisions in comparable cases can only serve as guidelines.

Obviousness requires that the skilled person with his knowledge and skills has been able to develop the subject matter of the invention from the known state of the art. In addition, he must have had reason to choose the solution according to the invention. [29] A new technical teaching cannot be regarded as not being based on an inventive step merely because there are no grounds that would constitute an obstacle in reaching the subject matter of that teaching based on the known state of the art. Rather, this evaluation assumes that the known art gave the skilled person a reason or suggestion to arrive at the proposed teaching. [30] If a mechanical engineering solution is part of the general expert knowledge of the engineer in question as a general means to be considered for a large number of applications, there may already be cause for its use if the use of its functionality is objectively purposeful in the context to be assessed. Unless special circumstances can be identified which make an application from an expert's point of view appear impossible, associated with difficulties or otherwise excluded. [31] It should be noted, however, that the general suitability of a solution that forms part of the general knowledge can only be sufficient reason to use that solution if it is immediately clear to the person skilled in the art that a technical starting point is given in which the use of the solution in question seems objectively suitable. [32] The fact that knowledge of a technical detail forms a part of the general expert knowledge is not sufficient proof that it was obvious for the skilled person to use this knowledge in solving a particular technical problem. [33]

Auxiliary criteria may only in individual cases give grounds for a particularly critical review of the solutions known in the state of the art to determine whether they provide sufficient indications for the obviousness of the invention against the background of general technical knowledge or whether they merely appear to contain a suggestion leading to the invention from a post-hoc point of view. [34] For instance, a quantum leap in the development, the overcoming of technical prejudices, futile efforts of experts in the past, satisfaction of a long-standing need, a simple and low-cost way of manufacturing staple products, the reduction of production costs or synergistic effects of the individual features, etcetera constitute such auxiliary criteria indicative of an inventive step. However, if features which are not inventive in themselves are combined, in an aggregative way, this is obvious and does not constitute an inventive step. This also applies if the existing doubts of the expert community are totally ignored and any associated disadvantages, actual or unforeseeable, are tolerated. [35] Even an almost completely random and arbitrary selection from a known field or the selection from several alternatives known to the skilled person is not suitable for establishing an inventive step. [36]

Applications having an earlier filing date or priority date and which were made available to the public on or after the date governing the filing or priority date of the later application are not to be considered for assessing inventiveness (section 4 sentence 2 of the Patent Act). The assessment of the claim must always be based on the combination of all features, regardless of whether the claim is formulated in one or two parts. Isolated consideration of individual features is not admissible. When examining the invention for inventive step, only those instructions are to be taken into account which determine or at least influence the solution of the technical problem by technical means. [37]

During the examination as to patentability, the examining section must always bear in mind that the subject matter to be examined is already part of its knowledge when it assesses whether or not the invention was obvious to the skilled person at the date of filing or the date of priority. Otherwise the approach would be retrospective and not permissible.

2.3.3.2.5. Industrial application (section 5 of the Patent Act)

An invention is capable of industrial application if its subject matter can be manufactured or used in any field of industry, including agriculture. This is the case, where it is possible to manufacture the subject matter in an industrial enterprise or make technical use of it in an industrial enterprise.

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[26] BGH GRUR 2010, 41 *Diodenbeleuchtung*
[27] BGH GRUR 2012, 482 *Pfeffersäckchen*
[28] BGH GRUR 2009, 1039 *Fischbissanzeiger*
[29] BGH GRUR 2012, 378 *Installiereinrichtung II*
[30] BGH GRUR 2010, 407 *Einteilige Öse*
[31] BGH GRUR 2014, 647 *Farbversorgungssystem*
[32] BGH GRUR 2018, 716 *Kinderbett*
[33] BGH GRUR 2009, 743 *Airbag-Auslösesteuerung*
[34] BGH GRUR 2010, 44 *Dreinahtschlauchfolienbeutel*
[35] BGH GRUR 1996, 857 *Rauchgasklappe*
[36] BGH GRUR 2004, 47, head note 3 *Blasenfreie Gummibahn I* and BGH GRUR 2008, 56 *Injizierbarer Mikroschaum*
[37] BGH GRUR 2011, 125 *Wiedergabe topografischer Informationen* and BGH GRUR 2013, 275 *Routenplanung*

2.3.3.2.6. Search within the examination procedure

The search is carried out in such a way as to identify the relevant state of the art in order to assess whether the filed invention is patentable. The subject matter of a search is the invention given in the patent claims. The description and the drawings are to be used to interpret the patent claims. The search covers the subject matter of all independent and dependent patent claims. The examining section in charge of the main class is responsible for the search.

The examining section must carry out the search utilising the technical tools provided and the information sources made available by means of these tools to the extent that it seems promising and justified considering the effort and time involved. The requirements referred to in item 5 of the Guidelines for the Search under Section 43 of the Patent Act (Search Guidelines) concerning the use of external electronic sources of search also apply to the search within the examination procedure.

The search is concluded where it becomes clear that a disproportionate effort would be required to only slightly improve the previously obtained search result. In order to avoid unnecessary communications that would delay the procedure, the search should be carried out and finalised in one working step for all patent claims submitted either within the scope of a search pursuant to section 43 of the Patent Act or when the examination request pursuant to section 44 of the Patent Act is filed, before establishing the first communication. It should be borne in mind that a search carried out before the expiry of six months after the filing date may lead to erroneous results due to the fact that, possibly, certain state of the art might not be available in the system.

If the applicant does not indicate the concrete state of the art in his application documents, he must, on request of the German Patent and Trade Mark Office, indicate the state of the art known to him and include it in the description, pursuant to section 34 (7) of the Patent Act.

Publications that might prejudice the grant of a patent may be indicated by a third person that is not party to the procedure (see sections 44 (3) sentence 3, 43 (3) sentence 2 of the Patent Act). In the interest of the most efficient handling of the procedure, these publications must as a rule be forwarded to the applicant *ex officio* together with the accompanying documents as soon as possible after they have been submitted. They will be taken into consideration *ex officio* in the course of the following examination procedure.

Regarding the search in case of applications lacking unity, reference is made to paragraph 2.3.3.4.

2.3.3.3. Amendment of documents/ impermissible extension (section 38 of the Patent Act)

The original application documents may be amended up to the decision on the grant of the patent provided that the scope of the subject matter of the application is not extended. However, only corrections of obvious mistakes, the remedying of deficiencies pointed out by the examining section or amendments to the patent claims are admissible before the filing of a request for examination pursuant to section 44 of the Patent Act.

According to section 38 sentence 2 of the Patent Act, no rights may be derived from unallowable amendments which extend the scope of the subject matter of the application. If the applicant does not completely delete such amendments, the application as a whole must be refused.

For the question of disclosure of the invention, it is not decisive whether something in the description is described as advantageous, purposeful or preferred over other solutions which have been disclosed simultaneously. Particularly emphasizing or stressing something, for example as the subject matter of an embodiment or an example, or describing it as advantageous, purposeful or preferred, only facilitates the realisation that the feature in question or the more limited teaching is disclosed as belonging to the claimed invention. However, the absence of such criteria does not exclude such disclosures. [38]

The content of the original application is what the average skilled person can infer from the original documents as belonging to the invention applied for. The decisive factor is whether the original disclosure has suggested to the average skilled person that the amended proposal for a solution should be covered, from the outset, by the subject matter for which protection has been sought. [39] Establishing the overall content of the original documents must be done with the eyes of the same skilled person who also assesses patentability. [40]

The disclosure of a patent application only includes what was capable of being derived directly and unambiguously from the documents originally filed, but does not comprise more extensive knowledge obtained by the skilled person on the basis of his general expertise or by modifying the teaching disclosed. There is an unallowable extension if the subject matter of the patent only becomes apparent to the skilled person on the basis of his own considerations based on his own expertise after he has acquired knowledge of the original documents. [41] Disclosure is not limited to the

[38] BGH GRUR 1990, 510 *Crackkatalysator*
[39] BGH Mitt 1996, 204 *Spielfahrbahn*
[40] BGH GRUR 1981, 812 *Etikettiermaschine*
[41] BGH GRUR 2015, 549 *Schleifprodukt* and BGH GRUR 2010, 509 *Hubgliedertor* I

subject matter of the patent claims formulated in the application. Rather, the decisive factor is what can be inferred from the whole of the original documents as belonging to the invention applied for. Within these limits, the patent claims can also be formulated more broadly than in the application, until the grant of the patent. [42]

If it can be inferred from the original documents of the patent application that a product is meant to "comprise" certain components, it is therefore not automatically disclosed as belonging to the invention that no further components may be added to it. For the disclosure that the invention includes that the product "consists" exclusively of the aforementioned components, it is rather necessary, as a rule, to have additional clues in the original documents, such as an indication that the fact that the product is consisting exclusively of the aforementioned components has particular advantages or is otherwise desired. [43]

2.3.3.4. Examination of unity of the application; division due to lack of unity

An application must not relate to more than a single invention or a group of inventions so linked as to form a single general inventive concept (section 34 (5) of the Patent Act). This provision provides for well-defined and well-documented IP titles to ensure legal certainty and searchability. At the same time, it prevents abusive circumvention of fees.

To determine lack of unity, the examiner must assess whether, in view of the technological context and the clarity of the inventive complex, processing in different procedures seems appropriate. [44]

Where lack of unity is found, the objection must be well-founded.

Even if lack of unity is apparent even without reference to the state of the art, meaning it is obvious, so to speak, patentability of the subject matter of the application must be substantively commented on and the state of the art to be taken into consideration here must be stated. However, an applicant is only entitled to a substantive examination for one subject matter for which lack of unity has been established, since a separate application is required for each invention, even if it is expedient for reasons of procedural economy to mention further material relating to the other subject matter. [45]

The examining section informs the applicant that the application might be refused and invites him to establish unity either by issuing a declaration of division due to lack of unity or by abandoning the part that lacks unity.

The declaration of division due to lack of unity must rectify the deficiency of lack of unity in such a way that it becomes clear what remains in the parent application. The subject matter of the divisional application must not go beyond the disclosed content of the parent application. If the declaration of division due to lack of unity is ambiguous, the applicant is to be invited to clarify the matter within a fixed time limit. If no clarification is received, the parent application must be refused.

Upon division of an application due to lack of unity, the divisional application will immediately become independent under procedural law. Processing continues at the procedural stage which the parent application had reached at the time of the division. [46] Section 39 of the Patent Act cannot be applied analogously to the division due to lack of unity.

Apart from the fact that the divisional application arises upon receipt of the declaration of division due to lack of unity, it must be treated like a regular application, so that the general legal provisions on fees apply. Consequently, the due date of the "filing of the application" mentioned in section 3 (1) sentence 1 of the Patent Costs Act is effected upon receipt of the declaration of division due to lack of unity and this date is the date when the application fee becomes due. [47]

The amount of the application fee depends on the form of filing (electronic or paper) of the declaration of division due to lack of unity and on the actual number of claims of the divisional application at the time the fee is due, with the application fee being payable within three months from the due date (section 6 (1) sentence 2 of the Patent Costs Act). If the application fee is not paid at all, not paid in due time or not paid in full, the divisional application is deemed to be withdrawn (see section 6 (2) of the Patent Costs Act). As a consequence, the divided part cannot be reintegrated into the parent application and therefore cannot be claimed in the parent application any more.

Since the divisional application continues to be processed in the procedural stage the parent application was in at the time of the division due to lack of unity, not only the application fee but also other fees such as the examination fee and annual renewal fees, if applicable, have to be paid for the divisional application.

If a request for examination has already been filed for the parent application, the examination fee is also due for the divisional application upon receipt of the declaration of division due to lack of unity and must be paid within a period of three months from the due date pursuant to section 44 (2) sentences 2 and 3 of the Patent Act, no later than seven years after the filing of the application. [48] If the examination fee is not paid or not paid in full within this period, the request for

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[42] BGH GRUR 2010, 910 *Fälschungssicheres Dokument* and BGH GRUR 2005, 1023 *Einkaufswagen* II

[43] BGH GRUR 2011, 1109 *Reifenabdichtmittel*

[44] BGH GRUR 1979, 619 *Tabelliermappe*

[45] BPatG Mitt 1978, 15

[46] BGH GRUR 1986, 877 *Kraftfahrzeuggetriebe*

[47] BPatG GRUR 2006, 791

[48] BPatG GRUR 2006, 791

examination is deemed to be withdrawn (section 6 (2) of the Patent Costs Act); however, the non-payment of the examination fee does not cause the divisional application to be deemed withdrawn.

The annual renewal fees for the period prior to the filing of the divisional application, which also become due upon receipt of the declaration of division due to lack of unity, may be paid without surcharge for late payment until the expiry of the second month after the due date and with surcharge for late payment until the expiry of the sixth month after the due date, according to section 7 (1) of the Patent Costs Act. Otherwise, the divisional application is deemed to be withdrawn (section 6 (2) of the Patent Costs Act).

In the procedure of the divisional application the applicant must file new documents as in the procedure for the parent application. If he does not file them within a time limit fixed by the examining section, the divisional application must be refused.

The previous procedural acts in the parent case file are also a component of the divisional case file.

2.3.3.5. Free division of the application (section 39 (1) of the Patent Act)

The applicant may at any time divide his application by written declaration until the expiry of the time limit for lodging an appeal against the decision to grant the patent. [49] In case of unclear declarations of division, the applicant is to be given a short time limit for clarifying the matter. The three-month time limit under section 39 (3) of the Patent Act is not affected.

The filing date or priority date of the original application and a priority claimed in the application continue to apply to each divisional application. If application documents required according to section 34 to 36 of the Patent Act for the divisional application are not filed within three months of receipt of the declaration of division or the fees for the divisional application, which are due under section 39 (2) of the Patent Act, are not paid within this time limit, the declaration of division is deemed not to have been made (section 39 (3) of the Patent Act). The previous procedural acts in the parent case file are also a component of the divisional case file.

2.3.3.6. Patent claims, patent category

An application must contain one or more patent claims defining the subject matter for which patent protection is sought (section 34 (3) number 3 of the Patent Act).

According to section 9 (1) of the Patent Ordinance the patent claims can be drafted in one-part form or be divided into a generic part and a characterising part (two-part form). In both cases the text may be arranged according to features.

If the two-part form is chosen, as a rule, the generic term is to be formed on the basis of the content of one document or one subject matter made available to the public. The characterising part of the claim must include the features of the invention for which protection is sought in connection with the features of the generic part. The characterising part must be preceded by such words as "characterised in that" or "characterised by" or any other expression to this effect.

In the two-part form of the claim, too, the entire claim must be examined, consisting of the generic part and the characterising part, so that there is no difference between the one-part and two-part versions with regard to the subject matter of the claim to be examined.

An application cannot be rejected as formally inadmissible on the grounds that the generic term of a patent claim divided into a generic part and a characterising part has not been formed on the basis of a previously published document or any other subject matter known in the state of the art which, in the opinion of the granting authority, is "closer" to the subject matter of the application or which, for other reasons, appears to be "better" suited to forming the generic part than the subject matter specified by the applicant in the application. [50]

Under section 14 of the Patent Act the content of the patent claims determines the scope of protection of a patent. An area of the invention that is merely presented in the description and not sufficiently clearly integrated in a patent claim is not protected. [51] Hence, the inventive idea should be described in such an abstract manner that it comprises all embodiments conceivable or desired by the applicant. Limits are set, however, by the original disclosure and the state of the art. When drafting patent claims the interests of the applicant should be weighed against the interests of the public. On the one hand, the applicant has a right to obtain a legal title that is as comprehensive as possible and, on the other hand, the subject matter must be clearly defined in the examination procedure in order to ensure legal certainty for the public. [52]

Features which are not necessary for the solution should not be included in the main claim as far as possible, meaning the definition of the subject matter should be made with as few characteristics as possible. A specific definition using the realised embodiment always involves the risk of narrowing the scope of protection too much. A limit for generalisations is being drawn by the requirement that the protected teaching must be clearly identifiable. However, for this purpose, the description may be used to interpret the subject matter of the claim. For the interpretation of the claim, the complete application documents must be

[49] BGH GRUR 2000, 688 *Graustufenbild*

[50] BGH GRUR 1986, 237 *Hüftgelenkprothese*

[51] BGH GRUR 1987, 626 *Rundfunkübertragungssystem*

[52] BGH GRUR 1988, 757 *Düngerstreuer*

examined as to whether they contain a more detailed explanation of the terms used and the measures described in the patent claims. [53]

The main claim must contain the essential features of the invention (see section 9 (4) of the Patent Ordinance). The main claim may be followed by sub-claims relating to particular embodiments of the invention. Additional independent patent claims (subsidiary claims) are admissible provided that the principle of unity of the invention is complied with. Sub-claims involving a change of category (for example, apparatus for carrying out a process) are of secondary importance. They must therefore be examined separately as to patentability.

As a rule, only the subject matter of the patent and thus the protected subject matter is to be conceptually determined in the patent grant procedure, but not the scope of protection. [54]

Product-by-process claims ("compound obtainable by...") are admissible. This is applicable above all for chemical compounds, if neither the structural formula of the compound is known nor an identification of the compound is possible by means of specified characteristics.

Indications concerning the purpose, effect or function used for designating a device are not inadmissible in general. Often they are even necessary in order to establish a clear connection of the indicated structural characteristics. [55] The reference in the patent claim to the suitability of a device or machine for a particular purpose can help the skilled person to determine how to spatially and geometrically design the individual features of the device in order to be able to use them for the aforementioned function. In this case, they must be regarded as establishing the features. [56]

An indication of purpose or function of the claimed device contained in a substantive claim regularly expresses the notion that the device must be objectively fit for the indicated purpose or function. The substantive claim thus is directed to a device with which the purposes or functions named can be realised. Indications of purpose and function in a substantive claim generally do not limit its subject matter to the stated purpose or function. Nevertheless, they are not meaningless. They normally define the subject matter of the patent claim as being designed in such a way that, in addition to fulfilling the other spatial and physical features, it can be used for the purpose indicated in the patent claim or can fulfil the function indicated in the patent claim. [57]

In general, optional features such as "in particular, preferably or for example" are permissible in all claims. They do not limit the claimed subject matter of the respective claim and are not relevant for the patent examination of the subject matter for which protection is sought.

Patents may concern products (devices, apparatus, substances) or processes. The subject matter disclosed in the application objectively evaluated is relevant for the classification of inventions in these different patent categories and consequently for drafting patent claims. This restricts the free choice of the claimed category by the applicant. Features of different patent categories should, if possible, not be included in a single claim with regard to the creation of unambiguous IP rights.

For manufacturing processes, the patent claim must contain the indication of the original material and the chronological sequence of action applied to the original material for achieving a defined final product. Additional features of an apparatus capable of explaining the steps of the process are allowable. The difference between working processes and manufacturing processes is that the former do not aim at modifying the final product (for example, measuring, conveying). Use claims are also classified under the category of process claims. They are directed at the protection of the use of a mostly known matter (substance, apparatus) for achieving a certain effect or a certain final product.

2.3.3.7. Applications claiming a priority

2.3.3.7.1. Domestic priority

The priority of one or several earlier German applications for a patent or a utility model for the same invention may be claimed for a patent application (domestic priority), provided the patent application was filed within a period of twelve months from the date of filing of the earlier application and provided a domestic or foreign priority has not already been claimed for the earlier application (see section 40 (1) of the Patent Act).

It is also possible to claim priority for a second subsequent application based on a subsequent application for such features not contained in the first application, but disclosed only in the first subsequent application, provided the inventions are identical. Insofar the provision of Article 4 F of the Paris Convention applies accordingly, which means that a new priority right for the newly introduced features is being created by the second subsequent application. In this case, however, the first subsequent application as well as the original application are deemed withdrawn (section 40 (5) of the Patent Act).

The declaration of priority must be made together with the indication of the file number of the earlier

[53] BGH GRUR 1980, 984 *Tomograph*
[54] BGH GRUR 1988, 757 *Düngerstreuer*
[55] BGH GRUR 1972, 707 *Streckwalze*
[56] BGH GRUR 1981, 259 *Heuwerbungsmaschine II* and BGH GRUR 1979, 149 *Schießbolzen*
[57] BGH GRUR 2018, 1128 *Gurtstraffer*

application within two months from the filing date of the later application (section 40 (4) of the Patent Act).

If the earlier application whose priority is claimed is still pending before the German Patent and Trade Mark Office, it is deemed withdrawn as soon as the declaration of priority is submitted (section 40 (5) of the Patent Act). The deemed withdrawal may also occur according to Article III section 4 (4) of the Act on International Patent Conventions (*Gesetz über internationale Patentübereinkommen*) where priority is being claimed for an international application under the international Patent Cooperation Treaty (PCT) for which the Federal Republic of Germany has been designated or elected for a patent. In this case, the earlier application is deemed withdrawn only after expiry of the 31-month time limit under Article III section 4 (4), in conjunction with (2) sentence 1 of the Act on International Patent Conventions, unless an explicit request for earlier examination and processing was filed under Article 23 (2) or Article 40 (2) of the PCT. The examining section may, at its discretion, process the earlier application or wait until the deemed withdrawal becomes effective.

It can be decided in advance, in the course of the procedure relating to the subsequent application, whether the formal requirements for effective claiming of the domestic priority are being met; [58] a decision on the applicability of the deemed withdrawal can be taken in the procedure relating to the earlier application. [59]

2.3.3.7.2. Foreign priority

The priority of an earlier foreign application may be claimed for a patent application deposited at the German Patent and Trade Mark Office if the application has been effectively filed in a contracting party of the Paris Convention or under another international treaty (Convention priority, section 41 (1) of the Patent Act). Furthermore, the priority of a foreign application in a state not bound by a relevant international treaty may be claimed (section 41 (2) of the Patent Act) under certain conditions (notice of the Federal Ministry of Justice and Consumer Protection on reciprocity).

Where a foreign priority is claimed, the required particulars (date, country, file number and a copy of the earlier application) must be furnished before expiry of the 16th month following the priority date (section 41 (1) of the Patent Act).

A valid claim to priority is to be examined only if documents dating from the priority interval and relevant for the decision were found. No interim decision is taken as to the valid claim to priority; if the priority claim is not effective, a decision on the application as a whole must be taken.

The subject matter of a patent application concerns the same invention as that of the earlier application if the claimed combination of features is disclosed to the skilled person in the earlier application in its totality as belonging to the invention applied for. Individual features with different priority cannot be combined in one and the same patent claim. [60]

2.3.3.8. Other aspects of the examination

If the abstract has not yet been published in the first publication of the application (*Offenlegungsschrift*) (section 45 (1) sentence 2 of the Patent Act), the examiner must check whether the abstract pursuant to section 36 of the Patent Act has been filed and does not have obvious deficiencies when carrying out the substantive examination. Where several drawings are mentioned in the concise summary and it is not clear which drawing, in the applicant's opinion, most clearly characterises the invention, the examining section determines that drawing which most clearly characterises the invention (section 36 (2) sentence 3 of the Patent Act). Reference is made to paragraph 1.5.1 regarding the naming of the inventor (section 37 of the Patent Act).

2.4 Communications (section 45 of the Patent Act)

Communications in the examination procedure serve to prepare the grant of a patent under section 49 of the Patent Act or the refusal of the application under section 48 of the Patent Act. The number of communications is determined by the obligation to inquire into the facts, to grant the right to be heard and by particular circumstances in the individual case. Communications must be drafted in a clear and neutral style.

The applicant should be invited to revise the description only after claims that seem to be patentable have been submitted or the examining section has proposed claims that seem to be patentable and the applicant's consent to the proposal can be expected. Reference is made in this context to paragraph 2.7.1.

A communication should not only state those aspects which are an obstacle to the grant of a patent, but also provide positive proposals for amending the claims. This should clearly show the applicant whether and to what extent the examining section considers the subject matter of the application to be patentable.

Where the examining section cannot identify any patentable subject matter in the application documents, it is to inform the applicant accordingly, specifying, in particular, that no grantable main claim

[58] BPatG BPatGE 25/74

[59] BPatG BPatGE 25/41

[60] BGH GRUR 2002, 146 *Luftverteiler*

can be proposed and that the application is likely to be refused even if new claims should be filed.

The applicant must be able to understand the content of the communication. Publications on the state of the art are not to be discussed by making sweeping references to their overall content and mere allegations. As part of a comparison of features, the examining section has to explain, with reference to text passages and figures, why for example, a subject matter contained in the state of the art conflicts with the subject matter of the applications thus constituting an obstacle to the grant of a patent.

If the subject matter is not based on an inventive step, an explanation must be given stating why the skilled person had a motivation to combine publications with each other or with the technical expert knowledge in order to avoid the possibility of being accused of having a retrospective view. It is essential for the viability of the decision to provide conclusive reasoning on the inventive step in the respective individual case, including the question of the motivation of the person skilled in the art, which is of high relevance for obviousness.

The communication must contain unambiguous statements or requests allowing the applicant to get a clear picture of the opinion of the examining section.

If a communication deals with several individual problems, such as formal deficiencies or patentability (novelty or inventive step), it should be subdivided into numbered sections for enhanced clearness. The facts relevant to the decision must be handled preferentially.

Publications cited for the first time in a communication on the examination should be listed at the beginning of the communication and provided with consecutive numbers which are to be maintained throughout the entire procedure. The serial numbers of citations newly introduced in a later communication should then be added at the end of the list established in the earlier communication. For better readability it may be useful to fully quote citations at the beginning of the communication and indicate their serial numbers.

2.4.1. First communication

The first communication – provided it concerns a first filing and the applicant has filed the request for examination in good time – should be issued early enough to be sent to the applicant four months before expiry of the priority year. This is an important service of the DPMA, which should provide assistance to the applicant in deciding whether it is advisable to file subsequent applications abroad or at the international level.

If, despite the previous examination as to obvious deficiencies, formal deficiencies are found at the beginning of the substantive examination, the objection to these deficiencies is to be combined with a complete communication about the substantive examination.

A search and an opinion on the patentability of all claimed subject-matter is absolutely necessary. A detailed opinion on the patentability of the subject matter of the subsidiary claims is indispensable. A brief statement with reference to the opinion on the main claim or on another independent claim is possible provided the features are identical; an opinion must be given in the individual case on features that go beyond this.

At the beginning of the first communication, the skilled person must be defined, since the view of the relevant skilled person is crucial for understanding the subject matter of the application and the relevant state of the art (see paragraph 2.3.3.2).

If necessary, the examining section must interpret the subject matter of the application (see paragraph 2.3.3.2) or make assumptions for the examination. The applicant must be informed of the interpretation or the assumptions for the examination.

Exceptions are admissible only if remedying the formal deficiencies appears to be impossible or if a substantive examination cannot be carried out because of these deficiencies. The applicant should be enabled to decide whether it is advisable at all to remedy the formal deficiencies and to pursue the application.

To gain a better overview, an outline of the features of the independent claims can be made at the beginning of the first communication, after mentioning the relevant publications.

If lack of unity of the application is found in the course of substantive examination, the relevant objection should be raised in the first communication.

2.4.2. Other communications

The second communication about the substantive examination, if required, should in general be the last one and lead to a final decision. In order to streamline the procedure, a hearing should, as far as possible, take precedence over further communications.

An opinion once carefully reached by the examining section and communicated to the applicant with a statement of the reasons should only be revised if the applicant submits equally substantiated and convincing counter-arguments or if new facts and circumstances or a new legal situation have arisen. This applies as well if a change of the examining section has taken place in the meantime. Reasons must always be given for a revision of the opinion of the examining section.

Regarding the filing of documents ready for grant, reference is made to paragraph 2.7.1.

2.5 Granting time limits

It is the declared aim of the DPMA, if requested by the applicant, to complete the entire examination procedure within a reasonable period after the request for examination under section 44 of the Patent Act by issuing a decision on the grant or refusal pursuant to sections 48, 49 of the Patent Act. The applicant, too, can contribute to expediting the procedure by replying to communications within the fixed time limits. In order to avoid superfluous requests for the extension of time limits, the examining section should estimate the time required by the applicant for preparing a response and fix an appropriate time limit on that basis. Where appropriate, the examining section should contact the applicant or his representative by telephone. A record of the telephone contacts should be taken, including their content.

A time limit of one month should usually be sufficient for remedying formal deficiencies. A time limit of four months should normally be granted for replying to communications concerning the subject matter of the application.

When fixing time limits, the examining section's workload should be taken into consideration and time limits should be set accordingly.

In the examination procedure of a patent application whose priority is claimed in a pending European application designating the Federal Republic of Germany, a time limit of up to twelve months may be granted – even repeatedly – for replying to a communication. This also applies as long as an opposition against the corresponding European patent can be filed or opposition proceedings against it have not been concluded. The decision is to take due account of the interests of the applicant and the public.

If a communication is not answered in time or a request for deciding on the record is filed, an immediate decision on the matter can be taken if this seems appropriate.

A first request for extension of the time limit is to be granted even if the grounds are only briefly stated. Further extensions are to be granted if they are sufficiently reasoned. The statement of reasons is not to be subject to strict requirements unless the examination procedure would be excessively delayed. Here, too, the examining section should contact the applicant or his representative by telephone in case of doubt.

The request for an extension of time must be rejected by a separate decision. It may be combined with a decision on the subject matter as such if a response to the communication can no longer be expected within the fixed time limit.

Even if the request for time extension is not sufficiently reasoned, implicit extension of one month is to be granted for reasons of procedural economy if it can be inferred from the circumstances, for example, the statement of reasons of the request for an extension of time, that a reply to the communication can be expected shortly after the expiry of the specified period.

The above regulations do not affect the running of statutory time limits.

2.6 Hearings and telephone conversations

2.6.1. Hearings (section 46 of the Patent Act)

The examining section may at any time summon and hear the parties, examine witnesses, experts and the parties, and institute other inquiries necessary to clarify the matter. Section 128a of the Code of Civil Procedure (*Zivilprozessordnung*) applies accordingly pursuant to section 46 (1) sentence 2 of the Patent Act (participation in hearings and taking of evidence using image and sound transmission – see paragraph 2.6.4). The examiner chairs the hearings. Third parties may only attend the hearings with the applicant's consent.

The applicant must be heard on request. If the applicant suggests a hearing or demonstration of the subject matter of the application, this should be regarded as a request to this effect.

In general, hearings can be convenient for conducting the procedure speedily. They should be held, in particular, in cases where it is not possible to conduct the procedure swiftly in writing. Since the Patent Act allows delivery of the decision at the end of the hearing (section 47 (1) sentence 3 of the Patent Act), the procedure may be concluded by means of a hearing without any further communication.

Hearings accompanied, if required, by a demonstration of the subject matter of the application can be useful in case of an ambiguity concerning the structure and the mode of operation of the subject matter, or in case of questions about patentability that cannot be clarified sufficiently in writing or inconsistencies in connection with the wording of the claims.

In preparation of the hearings, the examining section and the applicant must be familiar with the matter and the contents of the case file. If questions are to be discussed at the hearing which have not been considered so far, this is to be indicated in the summons.

The examining section can suggest a hearing or a demonstration on its own initiative if it considers it expedient or useful.

If a hearing has taken place before a change of examining sections, it should be repeated only if the new examining section has serious reasons for not sharing the view of its predecessor. The new examining section must inform the applicant on its deviating view in a communication.

At the beginning of the hearing, the applicant or his representative must identify himself unless he is

personally known to the examining section. A representative who is not a lawyer or patent attorney must always be requested to produce a power of attorney (section 15 (4) of the Ordinance Concerning the German Patent and Trade Mark Office).

In the hearing the examining section should first outline the controversial and unclear issues. The examining section may submit proposals to the applicant. If agreement has been reached on patentability, it is advisable to lay down the wording of the patent claims and, if possible, the structure of the description.

Minutes of the hearing and, if applicable, of any examination of witnesses are to be taken, reproducing the essentials of the hearing. The following must be included in the minutes:

a) place, date, the persons attending and the course of the hearing (no verbatim record with speech and counter-speech),

b) the new state of the art or new legal aspects introduced into the procedure,

c) all legally relevant declarations substantively altering the subject matter of the application or affecting the procedure, in particular, requests, amendments of requests and withdrawals of requests, including modifications of the application documents, declarations of abandonment or division of the application, the combination of applications as well as declarations concerning patent of addition.

If, as a result of the hearing, the examining section deviates from its previous opinion, the minutes must show the reasons which led to this deviation.

The examining section must sign the minutes. The parties receive a copy of the minutes.

It is advisable that the parties should countersign legally relevant declarations to be included in the minutes. This is not a prerequisite for the validity of the minutes or the declaration made but a question of providing evidence.

Under section 46 (2) sentence 2 of the Patent Act, minutes must be drawn up in application of section 160a, 162 and 163 of the Code of Civil Procedure. Therefore, it is also admissible to provisionally take the minutes down in shorthand or record them on tape. In this case, the minutes must be read out again or played back before the end of the hearing. The minutes must mention this fact and the approval of the parties or objections raised by the parties. If the minutes have only been provisionally recorded, a written version must be produced without delay after the hearing.

As a rule, a decision of the examining section on the application should be pronounced at the end of the hearing. The statement by the representative that consultation with the applicant is necessary is not a sufficient reason for postponing the decision-making process. The delivery as well as the operative part of the delivered decision must be included in the minutes of the hearing. If the patent is being granted, the documents must be prepared for the grant before the decision is delivered. The decision must then be served (section 47 (1) sentence 1 of the Patent Act).

When delivering the decision, it is sufficient to announce the operative part of the decision and to make reference to the written statement of reasons. If the examining section considers it appropriate, it may also make an oral statement on the reasons. The written statement of reasons must be prepared without delay.

The German Patent and Trade Mark Office is bound by the delivered decision. Submissions by the parties received after the decision was delivered may no longer be taken into consideration, except in the case of a later review on appeal (see paragraph 2.9).

2.6.2. Calling without invitation

If an applicant or a representative calls at the examining section without being invited to do so, this is to be briefly noted in the files, especially when he makes an oral request for accelerating the procedure or for extension of a time limit. If he requests an immediate hearing, the decision on this matter is left to the discretion of the examining section; the examining section has no obligation to hold a hearing.

2.6.3. Telephone conversations

Telephone conversations can be a means directed at furthering the completion of examination procedures. Questions not necessarily requiring a written communication are to be clarified in telephone conversations with the applicant. Telephone conversations cannot replace communications that notify the applicant of substantive comments of considerable importance with regard to the subject matter of the invention. Nor can telephone conversations replace hearings with extensive discussions on the subject matter. Telephone conversations are, above all, useful to briefly discuss the wording of the description, clarify doubts regarding new documents, request the transmittal of fair copies or similar matters. The examiner in charge or the official of the higher intermediate grade is to make a note in the case file on the telephone conversation.

2.6.4. Participation in hearings and takings of evidence using image and sound transmission (section 46 (1) sentence 2 of the Patent Act)

In proceedings before the civil courts, it is possible to participate in hearings and takings of evidence using image and sound transmission (section 128a of the Code of Civil Procedure). The corresponding application of section 128a of the Code of Civil Procedure enables the examining section to grant permission, at the

applicant's request or *ex officio*, to the applicant, his agents or representatives as well as to witnesses, experts and parties to the procedure to stay at another location in the course of a hearing or taking of evidence and to perform procedural acts from there. The image and sound of the hearing and the taking of evidence are to be broadcast in real time to this location, and, if necessary, to other locations if parties to the hearing are at different locations, as well as to the meeting room (section 46 (1) sentence 2 of the Patent Act, in conjunction with section 128a (1) and (2) of the Code of Civil Procedure). The decision on this is incontestable (section 46 (1) sentence 2 of the Patent Act in conjunction with section 128a (3) of the Code of Civil Procedure).

2.7 Preparation of the grant of the patent applied for

2.7.1 Filing of documents ready for grant

Under section 34 (3) number 4 of the Patent Act und section 10 of the Patent Ordinance, the invention for which patent protection is sought in the patent claims must be indicated in the description; the description must not contain any information that is obviously not necessary for explaining the invention. Pursuant to section 14 of the Patent Act, the description and the drawings are to be used to interpret the claims. This is important for determining the scope of protection. If, in the case of an invention considered patentable, agreement has been reached with the applicant on the wording of the claims, the applicant has the duty to bring the description in line with the valid claims. Furthermore, he must comply with the other requirements specified in the Patent Ordinance. To simplify matters, the literal quotation of the generic part and the characterising portion of the main claim may be replaced by including references to these parts of the claim in the description.

At the request of the German Patent and Trade Mark Office, the applicant must indicate the (relevant) state of the art, known to him, and include it in the description (section 34 (7) of the Patent Act, section 10 (2) number 2 of the Patent Ordinance). The mentioning of the relevant state of the art does not mean that the applicant himself has to evaluate and assess it. Disparaging remarks on the state of the art must be omitted.

The title of the invention which, pursuant to section 10 (1) in conjunction with section 4 (2) number 2 of the Patent Ordinance must be indicated at the beginning of the description, should take into account all subsidiary patent claims.

If necessary, the applicant is to be invited to take individual measures that are still required. The examining section may offer concrete proposals for amendments to accelerate the procedure. However, it may be assumed that persons who are well versed in patent office procedures understand general references to the legal provisions.

It should be noted that amendments must not contain inadmissible extensions (see section 38 of the Patent Act).

For this reason, requests for amendments must be limited to the necessary extent.

The applicant must file fair copies incorporating changes to the patent claims or the description (section 15 (1) sentence 2 of the Patent Ordinance). If the amendments have not been proposed by the German Patent and Trade Mark Office, the applicant must indicate in which part of the original documents each of the inventive features described in the new documents are disclosed (section 15 (3) of the Patent Ordinance).

2.7.2 Editing documents

Patent specifications are official publications. They must not contain any indications whose publication would be contrary to ‘ordre public’ or morality.

The applicant is responsible for an accurately worded version of the patent specifications. The examining section need not edit the documents if the documents filed are clearly drafted and if the wording is acceptable.

In particular, the examining section is to respect the particularities of the applicant's language since revisions in this respect carry the risk of an amendment which the applicant does not want or which is even inadmissible.

If, in a telephone conversation, the applicant agrees to a modification of the description by the examining section, the modification must be confirmed in writing. [61]

Documents can no longer be modified after delivery of the decision to grant or after the decision to grant was handed over to the document dispatching service, except in case of review after an appeal.

2.8 Decisions of the examining section (section 47 of the Patent Act)

Any statement of the DPMA (for example, the examining section) which results in a final regulation that may affect the rights of a party concerned constitutes a decision even if the statement/dictum has not been made in the form of a decision.

Decisions must be well-founded and a copy of them must be served *ex officio* to the parties concerned (section 47 (1) sentence 1 of the Patent Act). Execution

[61] BPatG, GRUR 1983, 505 *Fernmündliche Beschreibungsänderung*

copies are only made upon application of one of the persons concerned and only in paper form (section 47 (1) sentence 2 of the Patent Act).

The structure and contents of the decisions depend on the requirements of the individual case. At the beginning, the decision contains the caption in which the parties and, if applicable, their representatives are mentioned, as well as, separated from the reasons, an operative part (the tenor), containing the actual decision. The following statement of reasons consists of the facts of the case and the reasons for the decision. The facts of the case are to briefly describe the essential content of the claims asserted and the means of attack and defence put forward with emphasis on the motions submitted. The reasons for the decision contain a brief summary of the considerations on questions of fact and law on which the decision is based.

The reasons must cover all the points at issue of relevance to the decision. They must state in detail all the considerations on questions of fact and law which made the examining section reach its decision.

The quotation of unpublished decisions should be avoided, if possible. The examining section, however, may adopt the view held in the unpublished decision and the reasons given therein.

Reasons need not be given in detail if the application is refused because the deficiencies expressly notified in a communication have not been removed and the applicant has not made any comment. In these cases, reference can be made to the reasons stated in the communication, provided that they have been sufficiently explained therein.

Furthermore, reasons need not be given if the applicant is the only party to the procedure and his request has been allowed (section 47 (1) sentence 4 of the Patent Act). This applies, for instance, to the decision to grant the patent as requested and the decision allowing reinstatement, if these decisions are issued in procedures involving only one party. If reinstatement has been allowed, the grounds for reinstatement must be recorded in a short file note.

The written execution of a decision must be accompanied by instructions concerning the right to appeal pursuant to section 47 (2) sentence 1 of the Patent Act. In case of omitted or incorrect instructions, the appeal may still be filed within one year of service of the decision, except where the parties have been instructed in writing that an appeal is not permissible. In this case, the appeal, as a rule, remains admissible for an unlimited period of time. The instructions must therefore be rectified if it is found that they are incorrect.

The decisions take effect when they are delivered or when they are formally served. For in-office purposes self-obligation arises already by handing the decision over to the document dispatching service.

2.8.1 Decision to grant (section 49 of the Patent Act)

If the subject matter of the application is patentable pursuant to section 1 to 5 of the Patent Act and if the application complies with the requirements of sections 34, 37 and 38 of the Patent Act, and if possible deficiencies in the abstract, objected to under section 45 (1) of the Patent Act have been remedied, the examining section decides to grant the patent. The decision to grant cannot be revoked even if it is contrary to law.

The grant is published in the Patent Gazette. The statutory effects of the patent arise with the publication of the grant (section 58 of the Patent Act).

2.8.2 Decision to refuse the application (section 48 of the Patent Act)

The examining section refuses the application if the invention is not patentable pursuant to sections 1 to 5 of the Patent Act or if the deficiencies objected to under section 45 (1) of the Patent Act have not been remedied (section 48 sentence 1 of the Patent Act).

As a general rule, pursuant to section 48, sentence 2, in conjunction with section 42 (3) sentence 2 of the Patent Act, a refusal may only be based on circumstances which have been communicated to the patent applicant beforehand – even if the applicant has filed a request for a decision based on the status of the case file – in order to give him the opportunity to comment within a specified period.

2.9 Appeal and review

Pursuant to section 73 (1) of the Patent Act, the decisions of the examining sections are subject to appeal.

Decisions within the meaning of this provision are all decisions of the DPMA which contain a final regulation with external effect and may therefore affect the rights of the party concerned. The external form in which the decision was issued is therefore irrelevant for the admissibility of the appeal. The appeal may therefore challenge not only decisions which have been expressly designated as "decision", but also such final decisions which have an external effect and which are designated (whether correctly or incorrectly) as "order", "communication" or otherwise. [62]

The appeal must be filed in writing with the German Patent and Trade Mark Office within one month after service (section 73 (2) sentence 1 of the Patent Act). An

[62] see in other words BGH GRUR 1972, 535 *Aufhebung der Geheimhaltung*

appeal fee according to the Patent Costs Act is due upon filing the appeal (sections 2 and 3 (1), sentence 1, sentence 2 number 1 of the Patent Costs Act). If the appeal fee is not paid within the appeal period, the appeal is deemed not to have been filed (section 6 (1) sentence 1 and (2) of the Patent Costs Act in conjunction with section 73 (2) sentence 1 of the Patent Act).

The examining section must first examine whether an appeal that has been received is admissible and secondly, if it is well-founded. Whether or not the decision is rectified depends on the outcome of this examination. If the examining section considers the appeal well-founded, it must rectify its decision (section 73 (3) sentence 1 of the Patent Act). If the appellant is opposed by another party to the proceedings, such rectification is not admissible (section 73 (4) of the Patent Act). Another party may be for example, the opponent in a file inspection procedure. Furthermore, a decision may only be rectified if the appeal is admissible, that is if the appeal has been filed in due time and form.

If, when the appeal is filed by the applicant, the same case file also contains a request by the applicant objecting to the examining section that has issued the decision on refusal, a decision on the request for refusal must first be taken before deciding on interlocutory revision. [63]

A decision can be rectified only if the grounds for the refusal outlined by the examining section do no longer exist, for example, because the reasoning of the appeal has convinced the examining section of the other view or requested modifications have been made. If the decision is rectified, the examining section may order reimbursement of the appeal fee pursuant to section 73 (3) sentence 2 of the Patent Act.

Reimbursement of the appeal fee must be ordered if it would not be equitable to retain the fee. This is the case, for example, if an obvious error of the German Patent and Trade Mark Office made the appellant file an appeal. This applies to cases where an appeal would not have been necessary if the error had not occurred. The same applies if the appeal has been filed because of an unsuitable handling of the procedure.

The decision must be rectified if reasons and/or new documents are submitted within one month from the filing of the appeal and an examination reveals that the appeal is well-founded. Otherwise, the appeal must be submitted to the Federal Patent Court without comment as to its merits upon the expiration of the period for presentation (section 73 (3) sentence 3 of the Patent Act) even if other submissions have been announced.

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[63] BPatG GRUR-Prax. 2017, 176, therein in particular III.1.

3. Special procedures and subject matter of application

3.1. Applications concerning biotechnological inventions

3.1.1 General aspects

Biotechnological inventions are inventions whose subject matter is a product consisting of or containing biological material or a process by means of which biological material is produced, processed or used. Biological material is any material containing genetic information, that is its structural design, and capable of reproducing itself or being reproduced in a biological system (section 2a (3) number 1 of the Patent Act). A microbiological process is any process involving or performed upon or resulting in microbiological material (section 2a (3) number 2 of the Patent Act).

Biotechnological inventions are eligible for protection on the basis of the applicable Patent Act. The Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions (OJ EC number L 213 pages 13-21) stipulates community-wide harmonised provisions for the patenting of such innovations.

The Directive on Biotechnological Inventions was transposed into national law by the Act Implementing the Directive on the Legal Protection of Biotechnological Inventions (*Gesetz zur Umsetzung der Richtlinie über den rechtlichen Schutz biotechnologischer Erfindungen*) of 21 January 2005 of 21 January 2005 (BGBl I 2005, page 146 = BlPMZ 2005, pages 93-95). This Act entered into force on 28 February 2005.

The contents of the Directive on Biotechnological Inventions essential for patent examination can be found in section 1 (2), section 1a, section 2 (2), section 2a, section 9a, section 9b, section 9c, section 11 number 2a and section 34a of the Patent Act.

The Act Revising Certain Provisions of Patent Law and Other Acts in the Field of Industrial Property Protection (*Patentrechtsnovellierungsgesetz*) of 19 October 2013 (BGBl I 2013, pages 3830-3835) added that plants and animals produced exclusively by essentially biological processes for the production of plants and animals are excluded from patenting, to section 2a (1) number 1 of the Patent Act.

In addition, the Ordinance on the Deposit of Biological Material in Patent and Utility Model Procedures (*Verordnung über die Hinterlegung von biologischem Material in Patent- und Gebrauchsmusterverfahren*) of 24 January 2005 was issued, which also entered into force on 28 February 2005.

The purpose of depositing biological material is to supplement the disclosure of the application if the biological material in the patent application cannot be described in such a manner as to enable the invention to be reproduced by a person skilled in the art (section 1 (1) of the Ordinance on the Deposit of Biological Material). The deposit must ensure the disclosure of the invention as required by section 34 (4) of the Patent Act.

Microbiological processes and products thereof (section 2a (2) number 2 of the Patent Act) can be protected by patents, even if a sample of the biological material is deposited instead of a description indicating a reproducible manufacturing process of the biological material used and/or of the biological material claimed in the application. The deposit of biological material, access to such material and the new deposit of biological material are governed by the Ordinance on the Deposit of Biological Material in Patent and Utility Model Procedures (corresponding to Chapter IV of the Directive 98/44/EC).

If the application concerns a microbiological process itself, the deposit of the product of the process does not replace proof of reproducibility of the process.[64] However, if the application contains the description of a reproducible manufacturing process for the biological material, no evidence concerning its deposit is required. Vectors, as for instance plasmids, need not be deposited if either a reproducible manufacturing process or a complete nucleotide sequence is indicated. The complete nucleotide sequence must be submitted in electronic form (section 11 of the Patent Ordinance in conjunction with Annex 1).

A due deposit for the national patent procedure may either be made at a recognised international depositary authority under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure of 28 April 1977 (hereafter referred to as "Budapest Treaty"; BlPMZ 1981, pages 53 and following) or at recognised scientific institutions which guarantee that samples will be duly stored and furnished and must be legally, economically and organisationally independent of the applicant and the depositor (sections 2 and 8 of the Ordinance on the Deposit of Biological Material). The essential difference between the two depositary options is that, for deposits under the Budapest Treaty, no specific declaration authorising the furnishing of a sample is required for the furnishing of a sample of the biological material to third parties. The declaration authorising the furnishing of a sample is governed by section 4 of the Ordinance on the Deposit of Biological Material. It must be ensured by the depositor's declaration authorising the furnishing of a sample and complying with a minimum set of relevant information that the public is able to gain knowledge of the deposited biological material from the date of the first publication of the application or the patent. From that date, it must also be ensured that access to the said microorganism is possible for a sufficiently long period of time.

[64] BGH GRUR 1987, 231 *Tollwutvirus*

3.1.2 Requirements of a deposit in detail

3.1.2.1 Date of deposit

The biological material must be deposited with a recognised depositary institution not later than on the date of filing or the priority date (sections 1 (1) of the Ordinance on the Deposit of Biological Material).

Among the depository institutions recognised are the international depositary authorities which have acquired that status under Article 7 of the Budapest Treaty as well as recognised scientific institutions which guarantee that samples are duly stored and furnished in conformity with the Ordinance on the Deposit of Biological Material and which are legally, economically and organisationally independent of the applicant and the depositor (sections 2 of the Ordinance on the Deposit of Biological Material).

3.1.2.2 Information concerning the depositary institution and the deposited biological material

The application documents as originally filed must always contain the relevant information on the properties of the deposited biological material, known to the applicant, as well as the depositary institution and the file number of the deposit (section 1 (1) numbers 2 and 3 of the Ordinance on the Deposit of Biological Material). If the biological material has already been deposited by a third party, no further deposit is required, provided that a clear and sufficient disclosure for the further invention to be carried out is ensured by the first deposit for the period specified in section 7 of the Ordinance on the Deposit of Biological Material (section 1 (3) of the Ordinance on the Deposit of Biological Material).

If, on the basis of the application documents, a clear attribution of the application to the deposited biological material is possible, the file number of the deposit may be filed subsequently, in the case of patent applications, within a period of 16 months after the filing date or the priority date (section 3 (1) of the Ordinance on the Deposit of Biological Material).

3.1.2.3 Duration of storage

The deposited biological material must be stored for five years from receipt of the last request for the furnishing of a sample, but at least five years longer than the legally stipulated maximum term of protection of all industrial property rights referring to the deposited biological material (section 7 of the Ordinance on the Deposit of Biological Material).

For biological material deposited under the Budapest Treaty, the minimum storage period of 30 years from the date of deposit is applicable (Rule 9.1 Budapest Treaty).

3.1.2.4 Furnishing of samples and undertaking

The applicant must make the deposited biological material available to the depositary institution from the date of filing by making an irrevocable declaration authorising the furnishing of samples, without any reservation, in accordance with section 5 of the Ordinance on the Deposit of Biological Material (section 4 (1) of the Ordinance on the Deposit of Biological Material).

The furnishing of samples of biological material is governed by section 5 of the Ordinance on the Deposit of Biological Material.

Until the publication of the information on the first publication of the patent application pursuant to section 32 (5) of the Patent Act, a sample is only made available, on request, to the depositor or the German Patent and Trade Mark Office (section 5 (1) number 1 (a) and (b) of the Ordinance on the Deposit of Biological Material). In addition, a sample is made available on request to the applicant or another third party until publication of the information on the first publication of the patent application if the applicant or another third party is entitled to receive a sample on the basis of a decision by the German Patent and Trade Mark Office, pursuant to section 31 (1) sentence 1 of the Patent Act or on the basis of a decision by a court, or if the depositor has given his written consent to the furnishing of the sample (section 5 (1) (c) of the Ordinance on the Deposit of Biological Material).

From the first publication of the patent application to the grant of the patent, the biological material is made available, upon request, to any person by the furnishing a sample (section 5 (1) number 2 of the Ordinance on the Deposit of Biological Material).

However, the depositor may restrict access to the deposited biological material by furnishing a sample only to an independent expert appointed by the person filing the request (what is known as expert solution; section 5 (1) number 2, half sentence 2, of the Ordinance on the Deposit of Biological Material).

After a patent has been granted or a supplementary protection certificate has been granted, a sample of the biological material is made available to anyone on request, notwithstanding any subsequent revocation or declaration of invalidity of the patent or supplementary protection certificate (section 5 (1) number 3 of the Ordinance on the Deposit of Biological Material).

If the application is refused or withdrawn, access to the biological material, as provided for in section 5 (1) number 1 (c) and number 2 of the Ordinance on the Deposit of Biological Material, will, at the request of the applicant and for a period of 20 years from the date of filing of the application, be established only by the issue of a sample to an independent expert appointed by the applicant (section 5 (2) of the Ordinance on the Deposit of Biological Material).

The requests of the depositor that the sample be furnished only to an independent expert appointed by the person filing the request must be submitted to the German Patent and Trade Mark Office no later than the date on which the technical preparations for publication of the information on the first publication of the patent application are deemed to have been completed (section 5 (4) of the Ordinance on the Deposit of Biological Material).

The request for access to the biological material must be submitted to the German Patent and Trade Mark Office using the form issued for this purpose (section 5 (5) of the Ordinance on the Deposit of Biological Material).

For a deposit under the Budapest Treaty, no separate declaration authorising the furnishing of a sample is required. However, the applicant may restrict the furnishing of samples (Rule 11.2 Budapest Treaty).

A sample of the biological material is furnished only if the person filing the request undertakes vis-à-vis the applicant and, in the case of a third party deposit, vis-à-vis the depositor not to make available to third parties a sample of the material or of any material derived therefrom for the duration of the effect of all intellectual property rights referring to the deposited biological material and not to use any sample of the material or a material derived therefrom for purposes other than testing (what is known as an undertaking; section 6 (1) of the Ordinance on the Deposit of Biological Material).

The applicant or proprietor of the industrial property right, in the case of third-party deposits also the depositor, may waive this undertaking by the person filing the request to use the sample of the biological material for the purpose of testing only (section 6 (1) number 2 of the Ordinance on the Deposit of Biological Material).

If the sample is furnished to an independent expert, the latter must submit the undertaking (section 6 (2) of the Ordinance on the Deposit of Biological Material).

3.1.2.5 Furnishing proof of the deposit

If the required proof of the deposit is not attached to the application, the deficiency, if it is obvious, must be objected to within the examination as to obvious deficiencies, otherwise within the examination procedure, and the applicant must be invited to present appropriate proof (certificate of deposit or separate declaration authorising the furnishing of a sample, if required).

3.2. Applications concerning program-related inventions (computer-implemented inventions)

Applications involving programme-related inventions are inventions relating to devices and processes (programs) of electronic data processing.

These are inventions whose implementation involves the use of a computer, computer network or other programmable apparatus and which have at least one feature which is realised wholly or partly by means of a computer program. Such inventions are commonly referred to as computer-implemented inventions.

3.2.1. "Technicity" pursuant to section 1(1) of the Patent Act

Patents are only granted for inventions which are new, involve an inventive step and are susceptible of industrial application, pursuant to section 1 (1) of the Patent Act.

In addition, they must also have technical character. This is generally the case if the invention contains teachings for achieving a result following clear causal steps by controlling natural forces. [65] However, it is not necessary that the causal result is obtained by the direct application of controllable natural forces without the use of human intellectual power as an intermediate step. Rather, an invention can also have technical character if it is characterised by knowledge based on technical considerations and by the realisation of this knowledge. [66] Likewise, it is not contrary to the technicality of a teaching if, among other things, it also involves human intelligence. [67]

A program-related invention is considered to have technicity if the subject matter of the application serves to process, store and transmit data by a technical device. [68]

3.2.2. Exceptions to patentability under section 1 (3), (4) of the Patent Act

Pursuant to section 1 (1) of the Patent Act, inventions must have technical character in addition to complying with the other patent requirements. However, pursuant to section 1 (3) of the Patent Act, the following, in particular, are not regarded as inventions within the meaning of section 1 (1) of the Patent Act,

a) discoveries as well as scientific theories and mathematical methods (section 1 (3) number 1 of the Patent Act),

b) aesthetic creations (section 1 (3) number 2 of the Patent Act),

[65] BGH GRUR 1969, 672 *Rote Taube* (translation in IIC (1970), 136)

[66] BGH GRUR 2000, 498 *Logikverifikation* (translation in IIC (2002), 231)

[67] BGH GRUR 2000, 1007 *Sprachanalyseeinrichtung*

[68] BGH GRUR 2009, 479 *Steuerungseinrichtung für Untersuchungsmodalitäten*

c) schemes, rules and methods for performing mental acts, playing games or doing business as well as programs for computers (section 1 (3) number 3 of the Patent Act),

d) presentations of information (section 1 (3) number 4 of the Patent Act).

However, patent protection is only excluded for these activities or subject-matter as such – in particular also programs for computers – (section 1 (4) of the Patent Act). This means that program-related inventions, which generally also include combinations of subject matter (a) to (d), are as a rule eligible for patent protection.

However, it should be noted that the exception to patentability pursuant to section 1 (3) of the Patent Act generally only applies to processes but not to apparatus, since the *Bundesgerichtshof* (Federal Court of Justice) considered the exception to patentability pursuant to section 1 (3) number 3 of the Patent Act only for processes but not for apparatus. [69]

3.2.3. Three-stage examination approach of the *Bundesgerichtshof*

On the basis of sections 1, 3 and 4 of the Patent Act, the *Bundesgerichtshof* has derived a three-stage formal approach for the examination of program-related inventions.

In the first stage of the examination it must first be clarified whether the subject matter of the invention has technical character (section 1 (1) of the Patent Act). Then, in the second stage, it is examined whether the invention as such is excluded from patentability (section 1 (3) and (4) of the Patent Act) due to the existence of the aforementioned exceptions (a) to (d). This examination is carried out on the basis of a unitary examination criterion for these exceptions. In the absence of any exception, the third stage is to assess novelty and inventive step of the subject matter in such a way that only those instructions are taken into account which determine or at least influence the solution to a specific technical problem by technical means. [70]

The preliminary examination according to the first two stages as to whether an exception to patentability exists is made only on the basis of the patent application to be examined and as a rule without taking into account the state of the art; it thus serves as a kind of rough assessment to filter out those cases in which a patent claim does not contain any technical instruction at all, which can be used as a reasonable basis for the assessment of inventive step. [71] However, even in cases where an exception appears to exist, the examination of the patent application should not end at the second stage; rather, a search for the relevant state of the art should regularly be conducted and the features of the patent claims should be assessed in the light of the cited publications.

However, with regard to the legal requirements for patenting and exceptions to patentability, it is not absolutely mandatory to follow a certain examination sequence. [72]

3.2.3.1. First stage: examination of the requirement of technicity pursuant to section 1 (1) of the Patent Act

A process the subject matter of which is the execution of process steps using electronic data processing fulfils the technicity requirement pursuant to section 1 (1) of the Patent Act within the framework of the first stage of the examination if it at least implicitly teaches the use of computer components and thus provides a technical teaching. It is not necessary that these components are specified in the claim itself. This is because a process which serves the data processing of process steps in technical devices connected via a network has the technicity required for patent protection even if these devices are not expressly mentioned in the patent claim. If a process serves the processing, storage or transfer of data by means of a technical device or concerns the direct interaction of the elements of a computer system, it also fulfils the technicity requirement pursuant to section 1 (1) of the Patent Act; it is also irrelevant in this context whether the invention teaches (principal) variations of the working method of the computer components. [73]

Even an apparatus (computer), which is arranged in a certain way by means of program technology, already has technical character due to its concrete physical nature, even if the apparatus serves, for example, word processing according to the invention. For the assessment of the technical character of an apparatus, it is irrelevant whether it achieves a further technical effect, whether it enriches technology or whether it contributes to the state of the art. [74]

For the assessment of the technicity requirement, it is also irrelevant whether the subject matter of an application includes non-technical features in addition to technical features. [75]

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69 BGH of 27 March 2018 – X ZB 11/17

70 BGH GRUR 2011, 125 *Wiedergabe topografischer Informationen*; BGH GRUR 2011, 610 *Webseitenanzeige*

71 BGH GRUR 2011, 125 *Wiedergabe topografischer Informationen*

72 BGH GRUR 2004, 667 *Elektronischer Zahlungsverkehr*

73 BGH GRUR 2010, 613 *Dynamische Dokumentengenerierung*; BGH GRUR 2011, 610 *Webseitenanzeige*; BGH of 29 November 2016 – X ZR 90/14

74 BGH GRUR 2000, 1007 *Sprachanalyseeinrichtung*; BGH GRUR 2010, 613 *Dynamische Dokumentengenerierung*

75 BGH of 29 November 2016 – X ZR 90/14; BGH GRUR 2009, 479 *Steuerungseinrichtung für Untersuchungsmodalitäten*; BGH GRUR 2011, 125

3.2.3.2. Second stage: examination as to whether a concrete technical problem is solved by technical means (exceptions to patentability pursuant to section 1 (3), (4) of the Patent Act)

The Patent Act excludes the activities and subject matter as such mentioned above in paragraph 3.2.2 (a) to (d) from patentability. Therefore, patent protection is not available for a process used in the field of technology simply because it uses electronic data processing or a program to control a computer to achieve the desired success. A program-related invention is not patentable merely because it is in a form stored on a conventional data carrier when patent protection is sought for it. [76]

In the second stage of the examination it must be examined whether the claimed teaching contains instructions which serve to solve a specific technical problem by technical means. As a rule, non-technical instructions, in particular if they are limited to describing what the computer is to be used for are not, as a rule, sufficient, in this context. However, the exceptions to patentability pursuant to section 1 (3) number 3 and number 4 of the Patent Act do not apply if at least part of the teaching is based on a specific technical problem. It is not prejudicial if this is part of a more comprehensive problem solved by the claimed teaching, which for its part does not have technical character or only partially has technical character. [77]

Furthermore, the exception to patentability pursuant to section 1 (3) of the Patent Act only applies to processes but not to devices.

For example, the *Bundesgerichtshof* considered an exception to patentability pursuant to section 1 (3) number 3 of the Patent Act only for programs for computers, but not for a teaching about a device that uses electronic data processing. The same applies to the assessment of teachings containing mathematical methods, rules or methods for doing business or the presentation of information, so that even devices using these teachings are not excluded from patentability. [78]

In the process of answering the question as to whether the teaching in question contains instructions which serve to solve a specific technical problem by technical means, it is necessary to determine the technical problem proper, which is also relevant for the examination in the third stage. The determination of the technical problem underlying a patent or patent application is part of the interpretation of the patent claim. The technical problem must be developed from what is actually achieved by the invention. [79]

In general, as part of the interpretation of the patent claim, its semantic content in its entirety and the contribution that the individual features make to the achievement of the invention must be determined. The determination of the semantic content of an individual feature must always be made in this context; it is essential for understanding, at least in case of doubt, to consider what function the individual technical feature has alone and in interaction with the other features of the patent claim in achieving the result of the invention. [80] From the function of the individual features in the context of the patent claim, the technical problem can be inferred which is actually solved by these features alone and in their entirety. [81] In the process, the description and the drawings which explain and illustrate the technical teaching of the patent claim are to be consulted; [82] however, they must not result in a substantive limitation of the subject matter defined by the wording of the patent claim. [83]

The problem of the invention stated in the patent application may contain an indication of the correct understanding; [84] but it is not relevant as such and is merely a means of determining the objective technical problem. [85]

Whether a specific technical problem exists and is solved is based on an evaluation, which ultimately must not depend on whether the proposal to be evaluated is new and inventive. [86] For the determination of the technical problem (the "task") of the invention, specifications which the skilled person has received from his customers must also be factored in; they are not to be attributed to the solution of the problem but to the problem itself. [87]

A problem is solved by technical means if (i) device components are modified or addressed in a fundamentally different or new ("special") way, if (ii) the sequence of a computer program used to solve the problem is determined by technical aspects outside the computer, or if (iii) the technical solution consists precisely in adapting a computer program to the technical features of a computer. [88]

Wiedergabe topografischer Informationen; BGH GRUR 2010, 613 *Dynamische Dokumentengenerierung*

76 BGH GRUR 2002, 143 *Suche fehlerhafter Zeichenketten*

77 BGH GRUR 2005, 141 *Anbieten interaktiver Hilfe*; BGH GRUR 2004, 667 *Elektronischer Zahlungsverkehr*; BGH GRUR 2005, 143 *Rentabilitätsermittlung*; BGH GRUR 2011, 610 *Webseitenanzeige*

78 BGH of 27 March 2018 – X ZB 11/17; BGH GRUR 2005, 143 *Rentabilitätsermittlung*; BGH GRUR 2005, 141 *Anbieten interaktiver Hilfe*

79 BGH GRUR 2010, 602 *Gelenkanordnung*

80 BGH GRUR 2012, 1124 *Polymerschaum*

81 BGH GRUR 2010, 602 *Gelenkanordnung*

82 BGH GRUR 2012, 1124 *Polymerschaum*

83 BGH GRUR 2010, 602 *Gelenkanordnung*

84 BGH GRUR 2010, 602 *Gelenkanordnung*

85 BGH GRUR 2005, 141 *Anbieten interaktiver Hilfe*

86 BGH GRUR 2004, 667 *Elektronischer Zahlungsverkehr*

87 BGH GRUR 2011, 125 *Wiedergabe topografischer Informationen*; BGH GRUR 2010, 44 *Dreinahtschlauchfolienbeutel*

88 BGH GRUR 2010, 613 *Dynamische Dokumentengenerierung*; BGH GRUR 2011, 610 *Webseitenanzeige*

For example, a method for processing medically relevant data, which selects examination modalities on the basis of information specific to symptoms and/or diagnosis and transmits corresponding examination or measurement protocols to these modalities, solves a specific technical problem to the extent that it also controls the use of the respective examination modalities (for example, the setting of the CT image resolution). The program-controlled setting of such parameters of a device achieves a technical result comparable to an application program for monitoring and controlling the operation of a technical device or for processing measurement results. [89]

In contrast, it does not constitute a solution to a technical problem with technical means if a method automatically records and transmits operating data of a first medical device to a central database and determines remuneration data and imputed costs to calculate the profitability of the acquisition of a second medical device [90] or if the achievement of a method for finding and retrieving a certain information page on the Internet merely consists in collecting, storing and preparing of operator inputs on the user's computer with customary data processing steps. [91] A method for operating a communication system, which records the operating actions performed by a customer on his computer, reports them to a central computer, where they are logged and compared with reference protocols in order to offer the customer interactive computer support if, otherwise, he is not likely to place an order, is as such not eligible for patent protection either. [92]

The same as for computer programs applies to the second stage of the examination when the question at issue is whether a claimed teaching is to be as regarded a mathematical method (section 1 (3) number 1 of the Patent Act), as a rule or method for doing business (section 1 (3) number 3 of the Patent Act) or as a presentation of information (section 1 (3) number 4 of the Patent Act) and not as an invention. If instructions are claimed which solve a specific technical problem, it does not matter whether the patent claim also refers to the use of an algorithm, a commercial purpose of the method or the information character of the results of the method. [93]

However, a mathematical method can only be regarded as non-technical if, in connection with the claimed teaching, it contains no reference to the targeted use of natural forces. There is a sufficient reference to the targeted use of natural forces, for example, if a mathematical method is used for the purpose of obtaining more reliable information about the condition of an aircraft on the basis of available measurements and thus to influence the functioning of the system used to determine this condition. [94]

Instructions that, while concerning the (visual) reproduction of information, focus on the presentation of pictorial content in a manner that takes account of the physical features of human perception and acquisition of information, and whose aim is in a specific manner to enable, improve or appropriately arrange the human perception of the information shown, serve the solution of a technical problem with technical means. [95]

3.2.3.3. Third stage: examination of the solution a specific technical problem as to novelty and inventive step pursuant to sections 3, 4 of the Patent Act

Furthermore, a program-related invention can only be protected if the solution of the specific technical problem is new and involves an inventive step. For this reason, as with all other inventions, the subject-matter claimed must be examined as to whether it is new as compared to the state of the art and whether only the instructions determining or at least influencing the solution of the specific technical problem by technical means can support the inventive step of the teaching as compared to the state of the art within the meaning of section 4 of the Patent Act; [96] the other features are not taken into account in the examination as to inventive step. Non-technical instructions (for example, concerning the processes of merely collecting, storing, analysing and using data) are relevant only to the extent that they influence the solution of the technical problem by technical means. [97] However, the fact that a subject-matter may also contain features which do not contribute to solving a specific technical problem by technical means does not exclude it from being patented.

Instructions for the selection of data the technical aspect of which is limited to the instruction to use electronic data processing means for this purpose can in any event not be taken into account in the assessment of inventive step. This also applies if such instructions lead to a reduction of the calculation steps needed. [98]

For example, the selection of a central perspective display of topographical information depending on the position of a vehicle, suitable for its navigation, is not taken into account, as a non-technical instruction for

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89 BGH GRUR 2009, 479 *Steuerungseinrichtung für Untersuchungsmodalitäten*

90 BGH GRUR 2005, 143 *Rentabilitätsermittlung*

91 BGH GRUR 2011, 610 *Webseitenanzeige*

92 BGH GRUR 2005, 141 *Anbieten interaktiver Hilfe*

93 BGH GRUR 2005, 141 *Anbieten interaktiver Hilfe*; BGH GRUR 2005, 143 *Rentabilitätsermittlung*; BGH GRUR 2005, 749 *Aufzeichnungsträger*

94 BGH GRUR 2015, 983 *Flugzeugzustand*

95 BGH GRUR 2015, 660 *Bildstrom,* (translation IIC 2016, 220)

96 BGH GRUR 2011, 125 *Wiedergabe topografischer Informationen*

97 BGH GRUR 2010, 613 *Dynamische Dokumentengenerierung*; BGH GRUR 2009, 479 *Steuerungseinrichtung für Untersuchungsmodalitäten*

98 BGH GRUR 2013, 275 *Routenplanung*, (translation IIC 2013, 710)

the technically skilled person for assessing inventive step of a method for displaying topographical information. [99] This also applies to the instruction to a skilled person to consider, during the voice response of a navigation message under certain conditions, certain detailed information, such as, street names, it only concerns the content of the information rendered by the navigation system either optically or acoustically. [100] In addition, the assessment of inventive step does not take into account any instructions that concern precisely the communication of specific content and whose aim is thus to have an effect on the human imagination or intellect. [101]

3.2.4. Further aspects regarding program-related inventions

Applications must be drafted in the German technical language, but may contain the customary foreign-language technical terms from the field of data processing.

The description may be supplemented by diagrams which concern the operational steps of data processing. It may include a data flow chart, where the time sequence of related operations with the data and data carriers is indicated, as well as a program flow chart showing all the possible paths that data can take through the program.

Short excerpts from a program for computers in a customary, exactly defined programming language may be permitted in the description, if they are conducive to intelligibility.

3.3. Inventions relating to artificial intelligence

Applications whose subject matter are inventions relating to artificial intelligence (AI) may, on the one hand, concern inventions that create the basis for applying or using AI (for example, AI-specific hardware architectures, AI-specific algorithms and models, machine learning methods, etc). On the other hand, these applications may also concern inventions which use artificial intelligence for a specific field or use case.

So far, there is no established case law for the examination of applications whose subject matter are AI-related inventions. However, since AI-related inventions are generally closely related to program-related inventions (also called computer-implemented inventions), the approach to the examination of program-related inventions, including the three-stage examination approach, is as a rule transferred to the examination of AI-related inventions. Therefore, reference is made to the explanations in paragraph 3.2.

[99] BGH GRUR 2011, 125 *Wiedergabe topografischer Informationen*

[100] BGH GRUR 2013, 909 *Fahrzeugnavigationssystem*

[101] BGH GRUR 2015, 660 *Bildstrom* (translation IIC 2016, 220)

4. Informing the public

In accordance with section 31 of the Patent Act, the DPMA grants 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 is ruled out where it is precluded by a statutory provision or where the interest meriting protection of the data subject within the meaning of Article 4 number 1 of the Regulation (EU) 679/2016 of the European Parliament and of the Council of 27 April 2016 on the protection of natural persons with regard to the processing of personal data and on the free movement of such data, and repealing Directive 95/46/EC (General Data Protection Regulation, OJ L 119 of 4 May 2016, page 1, L134 of 22 November 2016, page 72, L 127 of 23 May 2018, page 2), as amended, obviously prevails or where the files contain information or drawings which are obviously contrary to 'ordre public' or morality (section 31 (3b) number 3 of the Patent Act). Reference is made to notice number 12/13 of the President of the German Patent and Trade Mark Office of 28 November 2013 (in German) concerning the introduction of electronic online file inspection in patent and utility model procedures.

Electronic file inspection is only available for applications already published (section 31 (1), sentence 2, and (2) of the Patent Act).

Non-patent literature is not shown due to reasons of copyright. It 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 case file documents sent and by having them made available for inspection in one of the search rooms of the DPMA.

Electronic file inspection is possible via the DPMAregister service, provided that the case file has been activated for electronic file inspection (https://register.dpma.de).

Abbreviations

BGH	*Bundesgerichtshof* (Federal Court of Justice)
BPatG	*Bundespatentgericht* (Federal Patent Court)
DPMA	*Deutsches Patent- und Markenamt* (German Patent and Trade Mark Office)
EC	European Communities
EU	European Union
OJ	Official Journal (of the European Union)

References

BlPMZ	*Blatt für Patent-, Muster- und Zeichenwesen* (Official Gazette of the German Patent and Trade Mark Office)
BPatGE	Decisions of the Federal Patent Court
GRUR	*Gewerblicher Rechtsschutz und Urheberrecht* (Journal of the German Association for the Protection of Intellectual Property)
GRUR RR	*Gewerblicher Rechtsschutz und Urheberrecht, Rechtsprechungs-Report* (Journal of the German Association for the Protection of Intellectual Property with current court decision)
IIC	International Review of Intellectual Property and Competition Law
Mitt	*Mitteilungen der deutschen Patentanwälte* (Bulletin of the German patent attorneys)

Judgements of the *Bundesgerichtshof* and the Federal Patent Court as of 2000 are accessible via the websites of these courts (www.bundesgerichtshof.de, www.bundespatentgericht.de).