

German Law Accessible

Intellectual Property Law in Germany

Protection, Enforcement and Dispute Resolution

von

Alexander R. Klett, Matthias Sonntag, Stephan Wilske

1. Auflage

Intellectual Property Law in Germany – Klett / Sonntag / Wilske

schnell und portofrei erhältlich bei beck-shop.de DIE FACHBUCHHANDLUNG

Thematische Gliederung:

[Gesamtdarstellungen](#)



Verlag C.H. Beck München 2008

Verlag C.H. Beck im Internet:

www.beck.de

ISBN 978 3 406 54530 6

Table of Contents

Abbreviations	XXIII
Introduction	XXVII

Part 1: Protection of Intellectual Property Rights

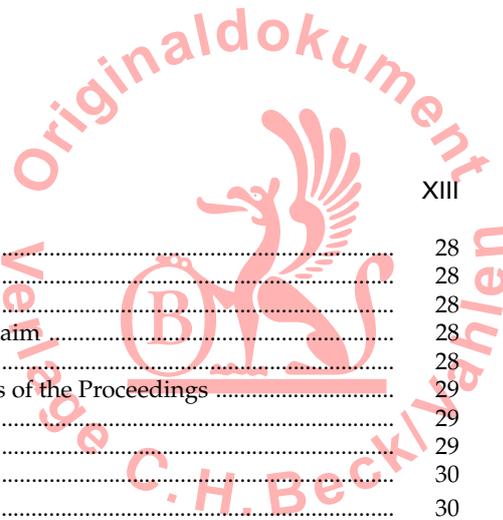
Chapter 1: Patents and Utility Models	1
A. Sources of Patent Law	1
I. National Statutes and Regulations	1
II. European Legislation and International Treaties	2
B. Requirements of Patentability	2
I. General	2
II. Patentability	3
1. Exclusions from Patentability	3
2. Technical invention	4
3. Novelty	4
a) General	4
b) Priority	5
c) Prior Art	5
d) Legal Standard of Novelty	5
4. Inventiveness	6
5. Susceptible of Industrial Application	6
III. Term of Protection	6
IV. Supplementary Protection Certificate	6
C. Ownership and Assignment of Patents	7
1. General	7
2. Right to the Invention	7
3. Right to the Patent	8
4. Effect of the Registration of the Grant of the Patent	8
5. Patent Vindication	9
D. Patent Office Proceedings	9
I. Patent Prosecution	9
1. General	9
2. First-to-File Principle	9
3. Proceedings before the PTO	9
a) Requirements	9
b) Timetable	10
c) Costs	10
4. European Patent Application	11
5. PCT-Application	11
II. Observations, Oppositions and Patent Office Appeals	12
1. Observation on Patentability	12

2. Opposition to Patents	12
3. Appeals	13
III. Modification of Patents	13
E. Licensing	13
I. Voluntary Licensing	13
II. Compulsory Licensing	14
F. Patent Enforcement	14
I. Rights of the Patentee	15
II. Limitations of the Rights of the Patentee	15
1. Privileged Use of a Patent	15
2. Right of prior use	16
3. Exhaustion of Rights	16
III. Types of Infringement	16
1. Claim Construction and Doctrine of Equivalents	16
2. Inducement/Contributory Infringement	17
3. Infringement by Activities Abroad	18
IV. Remedies for Patent Infringement	18
1. Injunction against Infringement	18
2. Monetary Remedies for Infringement	18
3. Claims for Information and Rendering of Accounts	20
4. Claims for Destruction, Recall and Final Removal	20
5. Publication of Court Decision	20
6. Statute of Limitations	21
G. Litigation in Patent Cases	21
I. Civil Law System	21
II. Pre-Litigation Strategy	22
1. Authorization Enquiry	22
2. Warning Letter	22
3. Filing without Warning	22
III. Standing to Sue	23
1. Infringement Proceedings	23
2. Actions for Declaratory Judgment of Non-Infringement	23
3. Nullity Actions	24
IV. Specialized Courts for Patent Matters	24
1. District Courts	24
2. First Appellate Level (<i>Berufung</i>)	24
3. Second Appellate Level (<i>Revision</i>)	24
4. European Court of Justice	24
V. Invalidity Defense / Separate Nullity Proceedings	24
VI. Subsequent Action for Damages	25
VII. Preliminary Relief and Anticipatory statement of defense	25
1. Requirements for Preliminary Injunctions	26
2. Proceedings	26
3. Anticipatory Statement of Defense	26
4. Standard of proof	27
5. Enforcement of Preliminary Injunctions	27
VIII. Litigation Timetable and Trial Format	28

Table of Contents

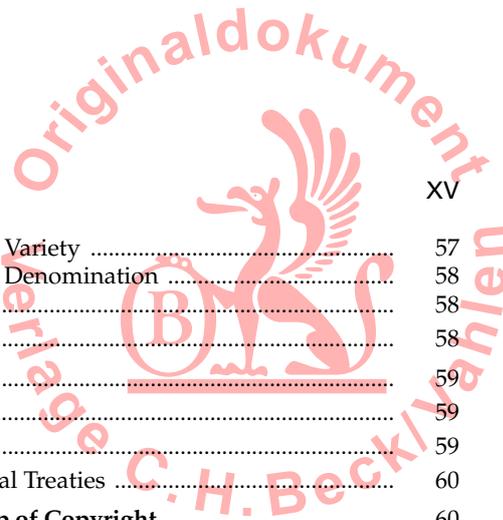
XIII

1. Duration of Proceedings	28
a) Infringement Proceedings	28
b) Nullity Proceedings	28
2. Initial Service of Statement of Claim	28
3. Early First Session	28
4. Motion for Security for the Costs of the Proceedings	29
5. Third-Party Notice	29
6. Pleadings	29
7. The Oral Hearing	30
IX. Discovery and Taking of Evidence	30
1. No Pre-trial Discovery	30
2. Taking of Evidence Prior to Commencing the Infringement Action	31
a) Independent Procedure for the Taking of Evidence	31
b) Disclosure Proceedings Abroad	32
3. Taking Evidence in the Course of the Proceedings	33
a) General Principles	33
b) Means of Evidence	33
c) Court Orders to Produce Evidence	33
d) Expert Testimony	34
e) Witness Testimony	35
4. The Acting Persons in Patent Litigation	35
a) Litigators	35
b) Patent Attorneys	35
c) Judges	35
5. Litigation Costs	36
a) Court Fees	36
b) Attorney Fees	37
c) Reimbursement of Costs	37
6. Appellate Remedies	37
a) General	37
b) First Appeal (<i>Berufung</i>)	38
c) Second Appeal (<i>Revision</i>)	38
7. Enforcement and Execution of Judgments	38
a) General	38
b) Provisional Enforcement	39
c) Avoiding Execution	39
d) Enforcement Abroad	39
H. Utility Models	40
I. Sources of Law	40
II. Subject Matter and Scope	40
III. Requirements	40
IV. Validity Challenges	41
1. Novelty	41
2. Inventive Step	41
3. Grace Period	42
V. Enforcement	42
I. Emerging Trends	42
I. London Agreement	43
II. Community Patent and European Patent Litigation Agreement	43



Chapter 2: Know-How and Other Technical Intellectual Property Rights	45
A. Protection of Know-How and Trade Secrets	45
I. General	45
II. Know-How and Trade Secrets	45
III. The Concept of Know-How Protection	46
1. Disclosure of Know-How and Trade Secrets	47
a) Misappropriation of Know-How by Employees	47
b) Industrial Espionage	47
c) Illegal Exploitation of Know-How	47
2. Illegal Use of Documents	47
3. Practical Consequences	47
IV. Remedies	48
1. Injunctions	48
2. Damages	48
3. Disclosure of Information	49
4. Destruction or Return	49
5. Publication of Judgments	49
6. Statute of Limitations	49
V. Enforcement and Procedure	49
1. Pre-Litigation Strategy	49
2. Preliminary Relief	50
B. Topographies of Semiconductor Products	50
I. Sources of Law	50
II. Subject Matter, Requirements and Ownership of Topographies	51
1. Topographies	51
2. Protectable Subject Matter	51
3. Duration of Protection	51
4. Requirements for Protection	51
5. Ownership and Assignment	52
6. Rights of the Owner of a Topography	52
III. Office Proceedings	52
IV. Validity Challenges	53
V. Enforcement	53
C. Plant Variety Rights	54
I. Sources of Law	54
II. Subject Matter, Requirements and Ownership	54
1. Protectable Subject Matter	54
2. Requirements for Protection	55
a) Distinctiveness	55
b) Uniformity	55
c) Stability	55
d) Novelty	55
e) Suitable Designation	55
3. Ownership and Assignment	56
4. Term of Protection	56
III. Office Proceedings	56
IV. Rights of the Holder of the Plant Variety Right	57
1. Scope	57

Table of Contents	XV
2. Exclusionary Right as Regards the Variety	57
3. Exclusionary Right as Regards the Denomination	58
4. Limitations	58
V. Enforcement	58
Chapter 3: Copyright	59
A. Sources of Copyright Law	59
I. Domestic Statutes	59
II. European Legislation and International Treaties	60
B. Requirements, Scope and Ownership of Copyright	60
I. Categories of Works Protected	60
II. Requirements for Protection	60
III. Copyright Ownership	61
IV. Term of Protection	62
C. Rights of the Copyright Owner	62
D. Limits to Copyright	63
I. Legal Licenses	63
II. Permitted Use Without Remuneration	63
III. Exhaustion of the Right of Distribution	64
E. Licensing	64
I. Form Requirements	64
II. Scope of Licensing	64
1. Contractual Options	64
2. Contractual Interpretation if the Scope is Unclear	65
3. Rules for Licenses in Employment Relationships	65
4. Grants of Rights for Unknown Forms of Use	65
5. Reasonable Remuneration to the Licensor	66
F. Neighboring Rights	67
I. Protection of Scientific Editions and Unpublished Posthumous Works	67
II. Protection of Non-Creative Photographs and Non-Creative Films	67
III. Protection of Performing Artists	67
IV. Neighboring Rights for Entrepreneurs	68
1. Neighboring Rights for Organizers of Performances	68
2. Neighboring Rights for Producers of Sound Recordings	68
3. Neighboring Rights for Broadcasters	69
V. Neighboring Rights for Film Producers	69
VI. Neighboring Rights Protection for Databases	69
G. Copyright Infringements and Remedies	69
I. Types of Infringement	70
1. Direct Infringement	70
2. Contributory and Vicarious Liability	70
II. Remedies for Copyright Infringement	70
1. Injunctions Against Infringement	70
2. Monetary Claims for Infringement	71
a) Compensation for Actual Damages	71
b) Compensation for Immaterial Damage	71



3. Claims Based on Unjust Enrichment	71
4. Claims for Information and Rendering of Accounts	72
5. Claims for Destruction, Recall or Restitution of Infringing Copies and Equipment	72
6. Exceptions to Remedies for Infringement	73
7. Publication of Court Decision	73
8. Statute of Limitations	73
9. Criminal Law	74
H. Copyright Enforcement Proceedings	74
I. Pre-Litigation Strategy	74
1. Warning Letter	74
2. Starting Court Action Without a Warning Letter	75
II. Standing to Sue	75
III. Specialized Courts in Copyright Matters	75
1. Court of First Instance	75
2. First Appellate Level (<i>Berufung</i>)	76
3. Second Appellate Level (<i>Revision</i>)	76
4. European Court of Justice	76
Chapter 4: Design Rights	77
A. Sources of Design Law	77
I. Domestic Statutes	77
II. European Legislation and International Treaties	77
B. Requirements, Scope and Ownership of Design Rights	78
I. Protectable Subject Matter	78
1. The Standard for Novelty	78
a) Legal Standard	78
b) Grace Period for Novelty	79
c) Priority of Previous Foreign Application	79
d) Exhibition Priority	79
2. Individual Character of the Design	79
3. Parts of Complex Products	80
4. Designs Excluded from Protection	80
II. Requirements for Protection	81
1. Registered Designs	81
2. Unregistered Community Designs	81
III. Ownership and Assignment of Design Rights	81
1. Ownership	81
2. Presumed Entitlement	82
3. Assignment of Design Rights	82
4. Claim to be Recognized as Holder of a Design	82
IV. Term of Protection	82
1. Registered Designs	82
2. Unregistered Community Designs	82
C. Office Proceedings Before the German PTO and OHIM	82
I. Application Timetable and Costs	82
II. Application Proceedings Before the German PTO and OHIM	83

Table of Contents	XVII
III. Opposition Proceedings	83
IV. Invalidity Proceedings	84
1. Application for Declaration of Invalidity Before OHIM and the German PTO	84
2. Cancellation Action Against a German Registered Design	84
3. Counterclaim for Declaration of Invalidity of a Community Design	84
4. Invalidity Action Against an Unregistered Community Design	84
D. Rights of the Owner of a Design	84
I. Scope of Protection	84
II. Specific Rights of the Owner of a Design	85
1. Exclusive Rights of the Owner of a Registered Design	85
2. Exclusive Rights of the Owner of an Unregistered Community Design	85
3. Rights of Prior Use of a Third Party	85
III. Limits to the Exclusive Rights of the Owner	86
1. Legal Limitations to Rights	86
2. Exhaustion of Rights	86
E. Licensing	86
F. Design Infringements and Remedies	86
I. Types of Infringement	87
1. Direct Infringement	87
2. Contributory and Vicarious Liability	87
II. Remedies for Design Infringement	87
1. Injunctions against Infringement	87
2. Monetary Claims for Infringement	87
3. Claims Based on Unjust Enrichment	88
4. Claims for Information and Rendering of Accounts	88
5. Claims for Seizure of the Infringing Products and Materials and Implements Used to Manufacture Them	89
6. Claims to Destruction of Infringing Goods and Equipment	89
7. Exceptions to Remedies for Infringement	90
8. Publication of Court Decision	90
9. Statute of Limitations	90
10. Criminal Law	90
G. Design Enforcement Proceedings	90
I. Pre-Litigation Strategy	91
II. Standing to Sue	91
III. Specialized Courts in Design Matters	91
1. Courts of First Instance	91
2. First Appellate Level (<i>Berufung</i>)	92
3. Second Appellate Level (<i>Revision</i>)	92
4. European Court of Justice	92
Chapter 5: Trademarks	93
A. Sources of Trademark Law	93
I. Domestic Statutes	93
II. European Legislation and International Treaties	93

B. Requirements, Scope and Ownership of Trademarks and Commercial Designations	94
I. Protectable Subject Matter	94
1. Trademarks	94
2. Commercial Designations	95
3. Geographical Indications of Origin	96
II. Requirements for Protection	96
1. Registered Trademarks	96
2. Unregistered Trademarks Having Acquired Secondary Meaning	96
3. Secondary Meaning as a Tool to Obtain Registration	97
4. Commercial Designations	97
5. Geographical Indications of Origin	98
III. Ownership and Assignment of Trademarks and Commercial Designations	98
1. Ownership of Trademarks	98
2. Ownership of Commercial Designations	99
3. Assignment of Trademarks	99
4. Assignment of Commercial Designations	99
IV. Term of Protection	99
1. Registered Trademarks	99
2. Other Designations Protected under the German Trademark Act	99
C. Trademark Office Proceedings	100
I. Application Timetable and Costs	100
1. German Trademarks	100
2. Community Trademarks	101
II. Application Proceedings before the German Patent and Trademark Office and OHIM	102
1. General	102
2. Priority and Seniority Claims	102
3. Relative Grounds for Refusal	102
4. Appeals Against Office Decisions	103
III. Opposition to Trademarks	103
1. German Trademarks	103
2. Community Trademarks	104
IV. Challenges to Trademarks Beyond Opposition Proceedings	105
D. Rights of the Trademark Owner	105
I. Scope of Protection	105
1. Trademarks	105
2. Other Designations Protected under the Trademark Act	106
3. Geographical Indications of Origin	106
II. Specific Rights of the Owner of a Trademark or Commercial Designation	106
III. Limits to the Exclusive Rights of the Owner	107
1. Legal Limitations to Rights	107
2. Exhaustion of Rights	107
3. Limitation/Estoppel	107
E. Licensing	107
F. Trademark Infringement and Remedies	108

Table of Contents	XIX
I. Types of Infringement	108
1. Direct Infringement	108
2. Contributory and Vicarious Liability	108
II. Remedies for Trademark Infringement	108
1. Injunctions Against Infringement	108
2. Monetary Claims for Infringement	108
3. Claims Based on Unjust Enrichment	109
4. Claims for Information and Rendering of Accounts	109
5. Claims for Destruction and Recall of Infringing Goods	109
6. Exceptions to Remedies for Infringement	109
7. Statute of Limitations	109
8. Criminal Law	110
G. Customs Actions	110
H. Trademark Enforcement Proceedings	111
I. Pre-Litigation Strategy	111
II. Standing to Sue	111
III. Specialized Courts in Trademark Matters	111
1. Courts of First Instance	111
2. First Appellate Level (<i>Berufung</i>)	112
3. Second Appellate Level (<i>Revision</i>)	112
4. European Court of Justice	112
Chapter 6: Arbitration and Mediation of IP Disputes	113
A. Introduction	113
I. Traditional German Litigation of IP Disputes	113
II. Advantages of Arbitration and Mediation	114
B. Arbitration of IP Disputes	115
I. German Legislation on Arbitration	115
1. Arbitration Act	115
2. International Treaties	115
II. Arbitration Agreement	116
1. Arbitrability	116
2. Content and Form Requirements	117
a) Content Requirements of an Arbitration Agreement	117
b) Form Requirements	117
III. Constitution and Composition of the Arbitral Tribunal	118
1. Appointment of Arbitrators	119
2. Challenge of Arbitrators	119
IV. Jurisdiction of the Arbitral Tribunal	119
1. Competence of the Arbitral Tribunal to Rule on Its Jurisdiction	119
2. Interim Measures of Protection	120
a) Dual System	120
b) Enforcement of Interim Measures	120
V. The Arbitral Proceedings	121
1. General Rules of Procedure	121
2. Language of the Arbitral Proceedings	121
3. Place of Arbitration	121

4. Default of a Party	121
5. Taking of Evidence	122
a) General Approach to Fact-Finding and Gathering of Evidence	122
b) Documents	122
c) Witnesses	122
d) Experts	123
6. Confidentiality of Proceedings	123
a) Confidentiality of the Arbitration	123
b) Confidentiality of Evidence inter partes	124
7. Settlement Attempt by the Arbitral Tribunal	124
VI. Role of Courts in Arbitral Proceedings	124
VII. Making of an Award and Termination of Proceedings	125
1. Applicable Rules to Substance of Dispute	125
2. Form and Content Requirements of an Award	125
3. Decision on Costs	126
4. Application for Setting Aside an Award	126
VIII. Recognition and Enforcement of an Award	127
1. Domestic Award	127
2. Foreign Award	127
IX. The German Arbitration Landscape	127
1. Tradition and Development	127
2. Specialized Types of Arbitration	128
a) Business and Trade Specific Arbitration Institutions	128
b) Domain Name Disputes	128
C. Mediation of IP Disputes	129
I. German Approach to Mediation	129
II. Advantages of Mediation	129
III. Mediation Required by German Law	130
IV. Mediation Clauses and Agreements	130
1. German Law on Mediation Agreements	130
2. Ignoring an Obligation to Mediate	131
a) Duty to Mediate	131
b) Commencing Litigation in Contravention of a Mediation Agreement	131
V. Mediation Proceedings	131
1. Reference to Rules of a Mediation Institution	132
2. Mediation and Court Proceedings	132
a) Defense of Mediation Agreement	132
b) Confidentiality Obligations	132
c) Suspension of the Limitation Period	132
VI. Mediator Service Agreement	133
1. Mediator's Duties: Rules of Professional Conduct	133
2. Remuneration of Mediators	133
3. Liability of Mediators	134
VII. Conclusion of Mediation Proceedings	134
1. Settlement Agreement	134
2. Enforcement of the Settlement Agreement	134
D. Emerging Trends	135

Table of Contents

XXI

Part 2: Relevant Legislative Instruments

Chapter 1: German Legislative Instruments (Excerpts)	137
A. Patent Act	137
B. Act on Utility Models	238
C. Act on Copyright and Neighboring Rights	266
D. Act on the Administration of Copyright and Neighboring Rights	361
E. Act on the Protection of Designs and Models	375
F. Trademark Act	420
G. Act Against Unfair Competition	529
H. Semiconductor Protection Act	533
I. Act on Plant Variety Rights	543
Chapter 2: European Legislative Instruments	584
A. European Patents	584
B. Community Trademarks	584
C. Community Designs	584
D. Community Plant Variety Rights	584
E. Other Intellectual Property Legislation	584
Chapter 3: Foreign National Legislative Instruments	584
A. Collection of Laws for Electronic Access	584
B. List of WIPO Administered Treaties	584

Part 3: Samples and Other Tools

Chapter 1: Samples of Pre-Litigation Correspondence	585
A. Authorization Enquiry (<i>Berechtigungsanfrage</i>)	585
B. Warning Letter (<i>Abmahnung</i>) and Cease and Desist Undertaking (<i>Verpflichtungserklärung</i>).....	586
C. Application for a Preliminary Injunction (<i>Antrag auf Erlass einer einstweiligen Verfügung</i>)	589
D. Anticipatory Statement of Defense (<i>Schutzschrift</i>)	593
E. Request for taking of evidence (<i>Beweisantrag</i>)	597
Chapter 2: Sample Calculations of Costs of IP Disputes in Germany	601
Chapter 3: Internet Links	609
A. PTOs and Other Authorities	609
1. Directory of Intellectual Law Offices Worldwide	609
2. Directory of Regional Offices	609
3. European Patent Office	609
4. Office for Harmonization in the Internal Market (Trade Marks and Designs)	609
5. European Judicial Atlas	609
6. German PTO	609

B. Online Search Services	609
1. esp@cenet	609
2. DEPATISnet	609
3. Scientific Technical Information Network (STN)	609
C. Case Law	609
1. European Court of Justice/European Court of First Instance:	609
2. Decisions of the EPO – Boards of Appeal	609
3. Decisions of the OAMI – Boards of Appeal (Trademarks)	609
4. Decisions of the OAMI – Invalidity Division (Designs)	610
5. Judgments of Community Design Courts Concerning Community De- signs)	610
6. German Federal Court of Justice	610
7. German Federal Patent Court	610
8. Patent Chambers of Düsseldorf	610
Chapter 4: Bibliography	611
A. Commentaries and Books in the German Language	611
B. Books, Articles and Journals in the English Language	612
Chapter 5: German-English Glossary	615
Index	625