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# Guidelines for the Examination Procedure

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(Examination Guidelines)\*  
of 1 March 2004

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\* Prüfungsrichtlinien

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### 1. Preliminary remarks

These Guidelines replace the Guidelines of 2 June 1995 (*Blatt für PMZ*<sup>1</sup> 1995, p. 269).

The Guidelines serve to ensure the uniform and expeditious examination of patent applications (see also Sec. 12 Ordinance Concerning the German Patent and Trade Mark Office<sup>2</sup>): Equal treatment of all applicants is an obligation in accordance with the rule of law. Consequently, all examiners are obliged to perform the examination of patent applications in accordance with the guidelines below. Amendments of laws and developments of court decisions as well as special circumstances of the each particular case shall also be considered.

The aim of the publication of the Guidelines is to inform applicants on the examination practice of examiners. The quality of patent examination also depends on cooperation with the applicants. For example, if application documents are not clearly arranged and not unitary, this will lead to delays in processing and undesired results (see also paragraph 3.3.3.4).

<sup>1</sup> Official gazette

<sup>2</sup> *Verordnung über das Deutsche Patent- und Markenamt*

### 2. Requirements of the application, examination as to obvious defects

#### 2.1. Filing date, minimum requirements (Sec. 34, 35 Patent Act<sup>3</sup>)

The filing date of the patent application shall be the date on which the elements referred to in Sec. 34 (3) nos. 1 and 2 Patent Act and in Sec. 34 (3) no. 4, insofar as they contain any statement that would appear to constitute a description, have been received

1. at the German Patent and Trade Mark Office (DPMA), or
2. at a patent information centre where an announcement by the Federal Ministry of Justice in the Federal Law Gazette<sup>4</sup> has designated such centre for that purpose (Sec. 35 (2), first sentence, Patent Act).

<sup>3</sup> *Patentgesetz*

<sup>4</sup> *Bundesgesetzblatt (BGBl.)*

If the elements are not drafted in German, this shall apply only if a German translation is received by the German Patent and Trade Mark Office within a period referred to in Sec. 35 (1), first sentence, Patent Act; otherwise, the application shall be deemed not to have been filed.

The translation must be certified (cf. Sec. 14 Patent Ordinance<sup>5</sup> of 1 September 2003 (Federal Law Gazette I, p. 1702)).

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

Pursuant to Sec. 34 (3) nos. 1, 2 and 4 the application must contain:

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

If the minimum requirements mentioned in Sec. 35 (2) Patent Act are fulfilled, the patent application shall be valid. If the requirements are fulfilled in sequence, the application shall be valid only when the last of the requirement is met. Where the minimum requirements are not met, there is no room for a rejection of such an "application". Rather, after granting the right to be heard, it shall be stated by decision that the filing does not constitute a valid patent application (cf. BPatGE<sup>6</sup> 26, 198).

## 2.2. Examination as to obvious defects (Sec. 42 Patent Act)

If a valid application has been filed (cf. paragraph 2.1), which obviously does not comply with the requirements of Sec. 34, 36, 37 and 38 Patent Act, the examining section shall request the applicant to remedy the defects within a specified period (Sec. 42 (1), first sentence, Patent Act). However, if the application merely contravenes the provisions of the Patent Ordinance, the examining section may refrain from raising objections to the defects (Sec. 42 (1), second sentence, Patent Act) until the start of the examination procedure (Sec. 44 Patent Act).

If the subject matter of the application obviously:

- a) does not, by reason of its nature, constitute an invention;
- b) is not susceptible of industrial application;
- c) is excluded from patentability under Sec. 2 Patent Act; or
- d) its purpose is not, in the case of Sec. 16 (1), second sentence, Patent Act (patent of addition), an improvement or further development of the other invention,

the examining section notifies the applicant accordingly, stating its reasons, and invites him to submit his comments within a specified period (Sec. 42 (2) Patent Act). The same applies if, in the case of Sec. 16 (1), second sentence, Patent Act, the application of the patent of addition has not been filed within the specified period.

The examining section rejects the application (Sec. 42 (3), first sentence, Patent Act), if

- the defects to which it has objected are not remedied, or
- the application is maintained although obviously no patentable invention exists (Sec. 42 (2), first sentence, nos. 1 to 3 Patent Act), or
- the requirements for a patent of addition are obviously not met (Sec. 16 (1), second sentence, in conjunction with Sec. 42 (2) no. 4 Patent Act).

## 2.3. Competence

Unless otherwise specified, the officials of the higher intermediate and lower intermediate grades of the civil service are responsible for the examination of the application as to obvious formal defects, pursuant to the Administration Ordinance<sup>7</sup>. Examination as to obvious substantive defects under Sec. 42 (2) Patent Act, and insufficient disclosure (Sec. 34 (4) Patent Act), lack of unity (Sec. 34 (5) Patent Act) and inadmissible extension (Sec. 38 Patent Act) is carried out exclusively by the examiners competent in the field.

## 2.4. Obvious defects

Only defects which are obvious shall be objected to when examining the application under Sec. 42 (1) and (2) Patent Act. Anything which is evidently defective to the examiner, upon studying the documents, in the light of his special technical knowledge without further investigation and searches is an obvious defect. The defect shall be so evident that it requires only brief reasoning to prove the existence of a defect (cf. BGH<sup>8</sup>, *Blatt für PMZ* 1971, p. 371, p. 373 - *Isomerisierung* -).

If the examiner has doubts as to the obviousness of the defect or if he can ascertain the obviousness only after intensively studying the documents, this indicates that the defect is not obvious within the meaning of Sec. 42 Patent Act. Objections to legal defects may, as a rule, only be raised during the examination as to obvious defects if there are relevant established court rulings.

Examination as to obvious defects in abstracts extends only to the formal requirements laid down in Sec. 36 (2) Patent Act and in the Patent Ordinance.

<sup>5</sup> *Patentverordnung*

<sup>6</sup> *Entscheidungen des Bundespatentgerichts* (decisions of the Federal Patent Court)

<sup>7</sup> *Wahrnehmungsverordnung*

<sup>8</sup> *Bundesgerichtshof* (Federal Court of Justice)

## 2.5. Formal defects

Formal defects which can be objected to within the scope of an examination as to obvious defects 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) it is doubtful whether the patent is requested on behalf of 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 Sec. 34 to 36 Patent Act;
- e) the power of attorney for the representative(s) indicated in the request is incomplete or missing, insofar as the representatives are no lawyers within the meaning of Sec. 18 (3) Ordinance Concerning the German Patent and Trade Mark Office;
- f) the power of attorney furnished does not meet the requirements of Sec. 25 Patent Act in case of applicants having neither a domicile nor an establishment in Germany;
- g) the title of the invention (Sec. 34 (3) no. 2 Patent Act) is not clear and concise; or
- h) the designation of the inventor (Sec. 37 Patent Act) is missing or incomplete.

### 2.5.1. Designation of the inventor

The designation of the inventor shall 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. If the applicant can justifiably show that exceptional circumstances prevented him from making this declaration in due time, he shall be granted a reasonable extension of time (Sec. 37 (2) 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 (BPatG<sup>9</sup>, *Blatt für PMZ* 1979, p. 181).

### 2.5.2. Application fee

A fee pursuant to the Patent Costs Act<sup>10</sup> shall be paid when filing the application (Sec. 2 (1) Patent Costs Act). If the fee is not paid within three months from filing the application, the application shall be deemed withdrawn (Sec. 3, 6 Patent Costs Act).

### 2.5.3. Violations of the Patent Ordinance

Violations of the Patent Ordinance shall be notified only if they impede or totally prevent the printing of the first publication of the application documents (*Offenlegungsschrift*). This

applies in particular if, due to poor quality, the documents making up the application cannot be used as master copy for printing or if the provisions regarding the format or the other requirements prescribed in Sec. 5, 6, 11, 12, 13 and 15 Patent Ordinance have not been observed. In the interest of the public exacting standards shall be applied to the quality of the documents, particularly to their legibility.

### 2.5.4. Defects 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 defects shall be notified during the examination as to obvious defects (otherwise see paragraph 3.3.3.6.).

## 2.6. Requirements pursuant to Sec. 42 (2) Patent Act

### 2.6.1. Subject matter excluded from patent protection

The subject matter of an application only constitutes a true invention if it is in a field of technology. In this context, reference is made to the paragraphs 3.3.3.2.1. and 4.3.

Where the subject matter obviously does not meet the described requirements or where it obviously comes under a subject matter stated in Sec. 1 (2) and (3) Patent Act, the application must be objected to.

However, the examination as to obvious defects does not include examination as to novelty and inventive step.

### 2.6.2. Industrial application (Sec. 5 Patent Act)

With regard to industrial application reference is made to paragraph 3.3.3.2.4. Lack of industrial application must be recognisable without doubt and without further investigation when examining the documents as to obvious defects.

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

### 2.6.3. Exceptions to patentability (Sec. 2 Patent Act)

Patenting is prohibited for inventions the publication or exploitation of which would be contrary to public policy or morality, and for plant or animal varieties or essentially biological processes for the production of plants and animals.

It should be noted in this context that the wording of the Patent Act is based on Article 4<sup>quater</sup> of the Paris Convention for the Protection of Industrial Property, according to which the grant of a patent cannot be refused 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.

<sup>9</sup> *Bundespatentgericht* (Federal Patent Court)

<sup>10</sup> *Patentkostengesetz*

However, if the only possible publication or industrial application constitutes a violation of public policy or morality, legal provisions prohibiting the production and industrial application would lead to the refusal of the patent - e.g. the War Weapons Control Act<sup>11</sup> (Federal Law Gazette I 1990, p. 2507) or the Embryo Protection Act<sup>12</sup> (Federal Law Gazette I 1990, p. 2746) or legal provisions on foodstuffs.

#### **2.6.4. Applications of addition**

With regard to handling of applications of addition reference is made to paragraph 4.1.

Under Sec. 42 (2), second sentence, Patent Act it shall be examined whether the application of addition was filed within the prescribed period. First it shall be ascertained whether the main application or the main patent is still in force.

Defects shall only be objected to within the scope of the examination under Sec. 42 (2), first sentence, no. 4 Patent Act, if the subject matter of the application of addition is obviously neither an improvement nor a further development of the subject matter of the main patent. Consequently, a patent of addition can be granted only for subject matter that might have been filed together with the main patent as a unitary invention (see also paragraphs 2.7. and 3.3.3.4.).

#### **2.7. Unity**

With regard to the requirements of unity reference is made to paragraph 3.3.3.4.

In this context, the examination as to obvious defects 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 prior 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 (BPatGE 21, 243).

#### **2.8. Conclusion of the examination as to obvious defects**

If the examiner has not found any obvious defects, he makes a corresponding note in the files.

If the applicant objects to the notification of a defect while specifying the grounds for his opinion, another official communication shall be issued in exceptional cases only. If the reasons are sound the objection shall be dropped. The application shall be rejected, giving a concise statement of grounds for the rejection, if the reasons specified by the applicant are not convincing.

When corresponding with the applicant in the course of the examination as to obvious defects, the examiner shall take care that the conclusive decision (rejection of the application or dropping of the examiner's objection) is not

issued later than four months from the date of filing. 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 defects in time, the uncorrected documents shall be used for printing the first publication of the application documents (*Offenlegungsschrift*).

For further details concerning the documents for the first publication of the application documents (*Offenlegungsschrift*) reference is made to paragraph 4.4.

#### **2.9. Reference regarding a division**

With regard to the possibility of the division of an application by the applicant, reference is made to paragraph 3.3.3.5.

#### **2.10. Reference regarding the priority rights**

With regard to the possibility of claiming priority, reference is made to paragraph 3.3.3.7.

The substantive right to claim priority – either national or foreign priority – shall not be examined during the examination as to obvious defects (cf. BPatGE 28, 31).

#### **2.11. Granting time limits**

For details concerning the granting of time limits, reference is made to paragraph 3.5.

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

### **3. Examination procedure**

#### **3.1. Request for examination (Sec. 44 Patent Act)**

The examination procedure pursuant to Sec. 44 Patent Act is subject to a valid request for examination (Sec. 44 (1) 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 the filing of the application (Sec. 44 (2) Patent Act). This request presupposes a pending application and may be submitted together with the application. Where the request has been filed by a third party, the applicant is notified of this fact (Sec. 44 (3), second sentence; Sec. 43 (3), second sentence, Patent Act).

Any person having neither a residence nor a seat nor an establishment in Germany may file a valid request for examination only if he has appointed a patent attorney, lawyer or holder of a certificate of representation pursuant to Sec. 160 Patent Attorney Regulations<sup>13</sup> in conjunction

<sup>11</sup> Gesetz über die Kontrolle von Kriegswaffen

<sup>12</sup> Gesetz zum Schutz von Embryonen

<sup>13</sup> Patentanwaltsordnung

with Sec. 178 Patent Attorney Regulations (as in force until 31 August 2009) in Germany as his representative (Sec. 43 (2), third sentence, Sec. 25 Patent Act). Reference is made to the provisions under Sec. 25 (2) Patent Act concerning representatives who are nationals of a Member state of the European Union or another contracting state of the Agreement on the European Economic Area.

A fee pursuant to the Patent Costs Act must be paid when filing the request. Payment of the fee may subsequently be made until the expiration of the seven-year time limit for filing the request for examination (Sec. 44 (2) Patent Act, Sec. 2, 3, 6, Patent Costs Act). The request for examination will only be processed when the fee has been paid (Sec. 5 (1) Patent Costs Act).

If a search request pursuant to Sec. 43 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 dealt with. If there are grounds indicating that it was not the intention of the applicant to request a separate search under Sec. 43 Patent Act, the examining section will contact the applicant to clarify this.

If the request for examination is filed in relation to an application for a patent of addition, a request for examination must also be filed in relation to the application for the main patent. The applicant is invited to file the request within one month (Sec. 44 (3), second sentence, Sec. 43 (2), fourth sentence, Patent Act). If the applicant does not comply with this invitation, the application for the patent of addition shall be deemed, by operation of law, to be an application for an independent patent without any further declaration by the applicant. The applicant is obliged to file the request in relation to the main application even if the request in relation to the application of addition was filed by a third party.

If a request for examination has already been received, subsequent requests for examination shall be deemed not to have been filed.

Any third party who has filed an effective request for examination does not become a party to the examination procedure. He does not receive copies of official 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 (Sec. 44 (4) Patent Act).

### **3.2. Formal handling of the request for examination and of the replies**

In a first step, the request for examination is examined for formal defects. After receipt of the fee, the 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. Upon receipt of the file, the section checks whether it is competent. If

not, the examining section in charge is identified immediately and the file is forwarded to that section. The competent examining section adds the appropriate ancillary classes on the form provided for that purpose, to the required extent. If a reply is received, it is 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<sup>14</sup>.

If a third party request is found to be ineffective after notification of the patent applicant, this fact is notified to the third party and the applicant (Sec. 44 (3), second sentence; Sec. 43 (6) Patent Act).

### **3.3. Substantive examination**

#### **3.3.1. Order of processing**

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

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

- a) the prospect of patent grant had been held out and the decision of grant can now be taken immediately;
- b) the applicant has not, or not completely, eliminated objections, and therefore a rejection seems to be appropriate;
- c) in the preceding official communication defects not allowing to grant the patent have been notified and the files clearly show that the applicant's statements do not give rise to change this opinion.

#### **3.3.2. Requests for accelerated processing**

Where a substantiated request for accelerated processing is filed, priority shall 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 a corresponding interest results from the request.

#### **3.3.3. Subject matter of the examination**

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

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<sup>14</sup> Patentblatt

### 3.3.3.1. Disclosure of the invention (Sec. 34 (4) Patent Act)

Pursuant to Sec. 34 (4) 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 (Sec. 36 Patent Act).

An invention is disclosed in a clear and complete manner if a person skilled in the art, utilising his knowledge in the art, is able to execute the teaching, which constitutes the invention, in practice (cf. BGH, *Blatt für PMZ* 1984, p. 246 - *Isolierglasscheibenrandfugenfüllvorrichtung* -).

It is only necessary to indicate the decisive direction in which the person skilled in the art may work on his own accord. Consequently, it is not necessary to describe the invention in every detail. However, generalisation must not go so far as to only state the problem and the result to be achieved. This is to prevent that IP rights are granted that cover all other ways and means to achieve the same result, which would be an obstacle to technical progress (cf. BGH, *Blatt für PMZ* 1985, p. 28, p. 29 - *Acrylfasern* -). Moreover, scope and legal certainty of the IP right would not be clear.

It is not relevant for disclosure of the invention whether an item in the description has been mentioned as advantageous, useful or preferable compared to other simultaneously disclosed solutions. Special highlighting or emphasising, for instance as the subject matter of an embodiment or an example, or the marking as advantageous, useful or preferable simply make it easier to recognise that the corresponding feature or the teaching proper is disclosed as constituting a part of the invention claimed. However, the absence of such criteria does not exclude such disclosures (cf. BGH, *Blatt für PMZ* 1990, p. 366 - *Crackkatalysator* -).

The complete contents of the initial documents must be ascertained from the viewpoint of the person skilled in the art that has assessed patentability ( cf. BGH, GRUR<sup>15</sup> 1981, p. 812, p. 813 - *Etikettiermaschine* - ). It must be examined which knowledge is being conveyed to him in an objective and direct manner. Furthermore, it has to be noted that the person skilled in the art does not simply follow the wording of the documents, but is essentially guided by the purpose of the invention with respect to the disadvantages of the state of the art, and by the proposal for a solution with its individual elements.

### 3.3.3.2. Examination as to patentability pursuant to Sec. 1 to 5 Patent Act

The invention for which a patent is sought must be patentable (cf. Sec. 1 to 5 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 matter to be protected under Sec. 14, 34 (3) Patent Act.

### 3.3.3.2.1. Basic requirements pursuant to Sec. 1 to 5 Patent Act

Patent protection shall only be granted for inventions relating to a field of technology. Patent protection is available for systematic teaching using controllable natural forces to achieve a result with clear cause and effect (BGH, *Blatt für PMZ* 1970, p. 21 – *rote Taube* - and 2000, p. 276, p. 278 - *Sprachanalyseeinrichtung* -). The "direct" utilisation of controllable natural forces is not mandatory for the technical character of a teaching (cf. BGH, *Blatt für PMZ* 2000, p. 273, p. 275 - *Logikverifikation* -), but the result must be based on controllable natural forces and not on evaluative activity of the human mind.

The following subject matter or activities are not considered to be inventions within the meaning of the Patent Act and are not patentable (Sec. 1 (2) Patent Act):

- a) discoveries, scientific theories and mathematical methods (e.g. Archimedes' principle, methods for solving a system of equations);
- b) aesthetic creations (e.g. purely decorative designs of a surface or a body);
- c) schemes, rules and methods for performing mental acts, playing games or doing business (e.g. schemes for acquiring special skills; methods for solving brain teasers or schemes for organising commercial services) and computer programs (for details cf. paragraph 4.3.);
- d) presentations of information (e.g. literature, news or message contents).

The exclusion of the subject matter or activities mentioned under a) to d) is only applicable to the extent that protection is sought for them as such (Sec. 1 (2), (3) Patent Act), i.e. they are only excluded from patent protection insofar as they are claimed irrespective of any concrete implementation. Where they are utilised to solve a concrete technical problem, they are generally patentable in this context (BGH, Mitt.<sup>16</sup> 2001, p. 553, p. 555 - *Suche fehlerhafter Zeichenketten* -).

The exceptions to patentability under Sec. 2 Patent Act should be noted (cf. paragraphs 2.6.3. and 4.2.).

### 3.3.3.2.2. State of the art (Sec. 3 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 (Sec. 3 (1), second sentence, Patent Act).

<sup>15</sup> *Gewerblicher Rechtsschutz und Urheberrecht* (Industrial Property and Copyright Journal)

<sup>16</sup> *Mitteilungen der deutschen Patentanwälte* (publication of the German chamber of patent attorneys (*Patentanwaltskammer*))

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

- a) national applications as originally filed with the German Patent and Trade Mark Office;
- b) 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 Art. 79 (2) 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 Art. 158 EPC;
- c) international applications under the Patent Cooperation Treaty (PCT) as originally filed with the receiving office, where the German Patent and Trade Mark Office is the designated office for the application.

Thus the entire content of earlier applications is prior art; it is not relevant whether or not and to what extent a patent is being granted for the earlier application.

A disclosure of an invention comprised in the state of the art under Sec. 3 (1) and (2) Patent Act is not taken into consideration if it occurred no earlier than six months preceding the filing of the application and was due to

- an evident abuse in relation to the applicant or his legal predecessor (Sec. 3 (4) no. 1 Patent Act) or
- a display of the invention by the applicant at official or officially recognised exhibitions (Sec. 3 (4) no. 2 Patent Act). The relevant exhibitions are notified by the Federal Ministry of Justice in the Federal Law Gazette (Sec. 3 (4), third sentence, Patent Act). However, the applicant must state, when filing the application, that the invention has been displayed, and file a supporting certificate within four months after filing the application (Sec. 3 (4), second sentence, Patent Act).

### 3.3.3.2.3. Novelty (Sec. 3 Patent Act)

During the examination as to novelty the claimed subject matter of the application shall be compared to each individual prior art item (cf. BGH, *Blatt für PMZ* 1984, p. 332, p. 333 - *Zinkenkreisel* -). The subject matter of the application is new if each individual comparison shows at least one feature that is not comprised in the state of the art.

The entire contents of the respective prior publication is relevant, e.g. document, lecture or prior use. In this context it is not important whether an item was mentioned casually or presented as an essential finding. What matters is what the average person skilled in the relevant field of technology was able to understand.

The relevant content of an application with earlier priority that is to be considered as state of the art is:

- the content of that application, where earlier priority is established by virtue of its filing date;
- if the 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 priority establishing application (Sec. 3 (2), second sentence, Patent Act).

If the examining section has ascertained an application with earlier priority 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.

Substances known from prior 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, and if their use for this particular purpose has not been known (Sec. 3 (3) Patent Act).

### 3.3.3.2.4. Inventive step (Sec. 4 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 (Sec. 4 Patent Act). The inventive step is a key criterion in patent law and distinguishes a patent from a utility model, which requires only a lower level of inventiveness to be protectable.

First of all the examiner has to ascertain the knowledge 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 must be based on the art known at that time, seen in connection with the specialist knowledge of an average skilled person. If the ascertained art is part of another technical field, it is doubtful whether it can be attributed to the knowledge of the average skilled person. This is at best true for neighbouring fields.

It depends on the individual case whether the invention involves an inventive step. The decision must be taken with regard to the criteria of "technical teaching claimed", "summarised state of the art" and "person skilled in that field". Case law has not developed generally applicable specific criteria for this evaluative decision allowing to draw unambiguous conclusions as to inventiveness in other cases. Decisions in comparable cases can only serve as guidelines.

For instance, a quantum leap in the development, the overcoming of technical prejudices, futile efforts of experts, satisfaction of a long-standing need, a simple and low-cost way of manufacturing staple products or the reduction of production costs, etc. are indicative of an inventive step. These indications of evidence shall be taken into consideration when deciding on the inventive



step involved. They must be addressed when drafting the reasons for rejection. Not to deal with them may constitute a significant examination defect (cf. BGH, *Blatt für PMZ* 1981, p. 136 - *Halbleitereinrichtung* -).

Applications with earlier priority shall not be considered for assessing inventiveness (Sec. 4 Patent Act). The assessment of the claim shall always be based on the combined features. Isolated consideration of individual features is not admissible. In examining the inventive step of the subject matter of an invention that combines technical and non-technical features (e.g. calculation rules, schemes for performing mental acts), the entire subject matter must be assessed including the non-technical features. It is not admissible to subdivide the subject matter of an invention and to restrict the examination of inventiveness to the part consisting of the technical features (cf. BGH, *Blatt für PMZ* 1992, p. 255 - *Tauchcomputer* -). Non-technical contents shall not be considered where they do not have any technical connection and do not even indirectly contribute to outlining a technical feature of the claimed subject matter (cf. BPatG, Mitt. 2002, p. 275 - *Elektronischer Zahlungsverkehr* -).

The examiner should always bear in mind that the invention is already part of his/her knowledge when he assesses whether or not the invention was obvious at the date of filing or the date of priority. A retrospective approach would not be appropriate.

#### **3.3.3.2.5. Industrial application (Sec. 5 Patent Act)**

An invention is capable of industrial application if the 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.

If the technical teaching, on which the invention is based, is unsuited to solve the technical problem, the rejection of the application must be based on lack of technical usefulness, and not on lack of industrial applicability (cf. BGH, *Blatt für PMZ* 1985, p. 117, p. 118 - *Energiegewinnungsgerät* -).

Methods for the treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body shall not be regarded as being susceptible of industrial application. It should be noted that products, in particular substances or compositions, for use in any of these methods, may be susceptible of industrial application (Sec. 5 (2) Patent Act).

#### **3.3.3.2.6. Search within the examination procedure**

The search is carried out to discover 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 used to interpret the patent claims. The search covers the subject matter of all patent claims (cf.

paragraphs 1. and 3.3.3.4.). 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 search is terminated where it transpires that an unjustified high effort would be required to slightly improve the previously obtained search result. If the wording of the claims is sufficiently clear, the search should be carried out in one working step in order to avoid unnecessary communications that would delay the procedure.

If the applicant indicates the prior art on his own initiative or on request of the German Patent and Trade Mark Office pursuant to Sec. 34 (7) Patent Act, he shall identify the references known to him.

Where publications that might prejudice the grant of the patent are indicated by a third person that is not party to the procedure, these publications will be forwarded to the applicant *ex officio*.

Regarding the search in case of applications lacking unity, reference is made to paragraph 3.3.3.4.

#### **3.3.3.3. Amendment of documents (Sec. 38 Patent Act)**

The 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. Only corrections of obvious mistakes, the remedying of defects pointed out by the examining section or amendments to the claims are admissible before the filing of a request for examination.

According to Sec. 38, second sentence, Patent Act, no rights may be derived from inadmissible amendments which extend the scope of the subject matter of the application. If the applicant does not completely delete such amendments, the application shall be rejected as a whole.

#### **3.3.3.4. Examination of unity and division of the application**

An application may relate to one invention only, or to a group of inventions so linked as to form a single general inventive concept (Sec. 34 (5) Patent Act). This provision provides for well defined and well documented IP titles under legal certainty and searchability aspects. At the same time, it prevents abusive circumvention of fees.

Regarding lack of unity the examiner must assess whether, considering the technological context and the clarity of the inventive complex, it seems appropriate to process the matter in different procedures (cf. BGH, GRUR 1979, p. 619, p. 620 - *Tabelliermappe* -).

Where lack of unity is found, reasons for this objection will be given in the official communication and substantiated, as a rule, by pertinent material. Other material which can be cited against the different inventions contributes to avoiding divisional applications without prospect of being granted. If the part that is likely to be maintained in the application can be recognised, a full search is carried out for this part (cf. BPatGE 20, 10).

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

The divisional part is sufficiently determined in the declaration of division if it is clear what is to be maintained in the parent application and what item will constitute the subject matter of the divisional application. If the declaration is not sufficiently clear, the applicant is invited to clarify the matter within a fixed time limit. If no clarification is received, the original application shall be rejected.

If, after an objection due to lack of unity, the divided part covers the subject matter objected to (even) only in part, the separation shall be regarded as a division. In this case, the applicant is not entitled to invoke the provisions on a free division under Sec. 39 Patent Act.

Upon division of an application the divisional application will immediately become independent under procedural law. Processing continues in the stage of procedure which the original application had reached at the time of the division.

The filing fee and the fee for filing the request for examination must be subsequently paid for the divisional application. Where the fees are not paid within three months from the receipt of the declaration of division, the divisional application shall be deemed to be withdrawn (cf. Sec. 3, 6 Patent Costs Act and BGH, *Blatt für PMZ* 1986, p. 371, p. 373 - *Kraftfahrzeuggetriebe* -).

Where annual fees have already become due for the original application these fees also become due for the divisional application upon filing the declaration of division.

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 shall be rejected.

### 3.3.3.5. Free division of the application

The applicant may at any time divide his application by written declaration (Sec. 39 (1) Patent Act) until the expiry of the time limit for lodging an appeal against the decision to grant the patent (cf. BGH, *Blatt für PMZ* 2000, p. 245, p. 246 - *Graustufenbild* -). In case of unclear declarations of division, the applicant shall be given a short time limit for clarifying the matter. The three-month time limit under Sec. 39 (3) Patent Act is not affected.

The date of the original application and a priority claimed in the application continue to apply to each divisional application. If documents required according to Sec. 34 to

36 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 Sec. 39 (2) Patent Act, are not paid within this time limit, the declaration of division shall be deemed not to have been made (Sec. 39 (3) Patent Act).

### 3.3.3.6. Patent claims, patent category

An application must contain one or more claims defining the matter for which patent protection is sought (Sec. 34 (3) no. 3 Patent Act).

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

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

Under Sec. 14 Patent Act the content of the claims determines the extent 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 (BGH, GRUR 1987, p. 626 - *Rundfunkübertragungssystem* -). The inventive idea should be described in such an abstract manner that it comprises all conceivable embodiments. 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 up 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 order to establish legal certainty (cf. BGH, GRUR 1988, p. 757, p. 760 - *Düngerstreuer* -).

Features which are not necessary for the solution should not be included in the main claim, i.e. as few features as possible should be used. A concrete wording using the realised embodiment always involves the risk of narrowing the extent of protection too much. A limit for generalisations is being drawn by the requirement that the protected teaching must be clearly identifiable.

The main claim must reflect the entire concept of the inventive idea (cf. Sec. 9 (4) Patent Ordinance). The main claim may be followed by dependent claims relating to particular embodiments of the invention. Additional independent patent claims are admissible provided that the principle of unity of the invention is respected. Dependent claims involving a change of category (e.g. apparatus for carrying out a process) are of secondary importance. They shall therefore be examined separately as to patentability.

As a rule, only the subject matter of the patent and thus the protected object shall be conceptually determined in the patent grant procedure, but not the extent of protection (BPatG, Mitt. 1984, p. 50 - *Schutzumfang* -).

Product-by-process claims ("substance available by...") are admissible. This is applicable above all for chemical substances, when neither the structural formula of the substance is known nor the substance capable of being identified by means of specified characteristics. Indications concerning the 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 (BGH, GRUR 1972, p. 707, p. 708 - *Streckwalze* -).

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 the drafting of the patent claims. This restricts the free choice of the claimed category by the applicant. Characteristics of different patent categories should, if possible, not be included in a single claim with regard to the creation of unambiguous industrial property rights.

For manufacturing processes, the patent claim must contain the indication of the original material and the time sequence of action on 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 (e.g. 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.

### 3.3.3.7. Applications claiming a 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 (internal 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 (cf. Sec. 40 (1) Patent Act).

It is also possible to claim priority for a second subsequent application based on a later application for such characteristics not contained in the first application, but disclosed only in the further developed later application. Insofar the provision of Art. 4 F (2) of the Paris Convention applies *mutatis mutandis*, which means that a new priority right for the newly introduced characteristics is being created by the later application. In this case, however, the first subsequent filing shall be deemed withdrawn (Sec. 40 (5) Patent Act).

The declaration of priority shall be made together with the indication of the file number of the earlier application within two months from the filing date of the later application.

If the earlier application whose priority is claimed is still pending before the German Patent and Trade Mark Office, it shall be deemed withdrawn when the declaration of priority is submitted (Sec. 40 (5) Patent Act). The deemed withdrawal may also occur according to Art. III Sec. 4 of the Act on International Patent Conventions<sup>17</sup> where priority is being claimed for an international application under the PCT for which the Federal Republic of Germany has been designated for a patent. In this case, the earlier application shall be deemed withdrawn only after expiry of the 30-month time limit under PCT Art. 22, unless an explicit request for earlier examination and processing was filed under PCT Art. 23 (2). The examiner may, at his 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 later application, whether the formal requirements for effective claiming of the internal priority are being met (BPatGE 25, 74); a decision on the applicability of the deemed withdrawal can be taken in the procedure relating to the earlier application (BPatGE 25, 41).

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 member state of the Paris Convention or under another international treaty (Convention priority, Sec. 41 (1) Patent Act). Furthermore, the priority of a foreign application in a state not bound by a relevant international agreement may be claimed under certain conditions (notice of the Federal Ministry of Justice on reciprocity, cf. Sec. 41 (2) Patent Act).

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.

The right to claim a priority is only examined if material dating from the priority interval and relevant for the decision is ascertained. No interim decision is taken as to the right to claim a priority; if the priority claim is not effective, a decision on the application as a whole must be taken.

### 3.3.3.8. Other aspects of the examination

When carrying out substantive examination the examiner must check whether the abstract pursuant to Sec. 36 Patent Act is on file and - where the abstract has not yet been published within the scope of the publication of the application - that it does not have obvious defects (Sec. 45 (1), first sentence, Patent Act).

<sup>17</sup> Gesetz über internationale Patentübereinkommen

Reference is made to paragraph 2.5.1. regarding the naming of the inventor (Sec. 37 Patent Act), and to paragraph 4.1. regarding the patent of addition.

#### **3.4. Official communications (Sec. 45 Patent Act)**

Communications in the examination procedure serve to prepare the grant of a patent under Sec. 49 Patent Act or the rejection of the application under Sec. 48 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 should 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 3.7.1.

A communication shall 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 it shall inform the applicant accordingly. It shall specify, in particular, that no grantable main claim can be proposed and that the application is likely to be rejected even if new claims should be filed.

The applicant must be able to understand the content of the official communication. Publications on the state of the art shall not be discussed in connection with statements of a general nature. The examiner shall state, making reference to text passages and figures, why e.g. an object contained in the state of the art is an obstacle to the grant of a patent. General indications will only be sufficient if the cited publications are clearly arranged. The communication must contain unambiguous statements or requests allowing the applicant to get a clear picture of the examiner's opinion.

If an official communication deals with several individual problems, such as formal defects, inventive step, novelty and questions concerning categories, it should be subdivided into numbered sections for enhanced clearness.

Publications cited for the first time in an official communication should be listed at the beginning of the communication and provided with consecutive numbers which are 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 in the text of the communications and indicate their serial numbers.

#### **3.4.1. First official communication**

The first official 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 notified 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 would be advisable to file subsequent applications abroad or at the international level.

If, despite the previous examination as to obvious defects, formal defects are found at the beginning of the substantive examination, the objection to these defects shall be combined with a complete official communication as to substance. Exceptions are admissible only if remedying the formal defects appears to be impossible or if a substantive examination cannot be carried out because of these defects. The applicant should be allowed to decide whether it is advisable at all to remedy the formal defects and to pursue the application.

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

#### **3.4.2. Other official communications**

The second official communication as to substance, if required, should in general be the last one and lead to a final decision on the application.

An opinion once carefully reached by the examiner and communicated to the applicant with a statement of the reasons should be revised only if the applicant submits equally substantiated counter-arguments or if new facts and circumstances or a new legal situation have arisen. This applies as well if a change of examiners has taken place. A revision of the examiner's opinion shall always be substantiated, e.g. if the examiner did not recognise an inadmissible extension of the subject matter of the application.

Regarding the filing of documents ready for grant, reference is made to paragraph 3.7.1.

#### **3.5. Granting time limits**

It is the aim of the DPMA to complete the entire examination procedure up to the decision of grant or rejection within two years. This goal will only be achieved in the mid-term range, i.e. by the end of the decade. The 150 examiners that were newly recruited between 2002 and 2004 will help to continually reduce the stock of 130,000 examination procedures pending at the end of 2004. The applicant can contribute to shortening the procedure by replying to official communications within the fixed time limits. In order to avoid superfluous requests for the extension of time limits, the examiner should estimate the time required by the applicant for preparing a response and fix the time limit accordingly.

A time limit of one month should usually be sufficient for remedying formal defects. 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, depending on the circumstances - for replying to an official communication.

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 shall be granted even if the grounds are only briefly stated. Further extensions shall be granted if sufficiently substantiated. The statement of reasons shall not be subject to strict requirements unless the examination procedure would be excessively delayed.

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

Even if the request for time extension is not substantiated sufficiently, implicit extension of one month shall be granted for reasons of procedural economy provided that circumstances, e.g. the substantiation of the request for an extension of time, show that a reply to the communication can be expected shortly after the expiry of the specified period.

These provisions do not affect statutory time limits.

### **3.6. Hearings and telephone conversations**

#### **3.6.1. Hearings (Sec. 46 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. The examiner chairs the hearing. Third parties shall only be allowed to attend the hearing with the applicant's consent.

The applicant shall be heard on request where appropriate. It should be regarded as a request to this effect when the applicant suggests a hearing or demonstration of the subject matter of the application. If the examining section does not consider a hearing to be appropriate, it rejects the request.

The decision to reject the request is not subject to interlocutory appeal (Sec. 46 (1), fifth sentence, Patent Act).

A hearing can be convenient for conducting the procedure speedily. It should be held, in particular, in

cases where it is not possible to conduct the procedure swiftly in writing. The hearing aims at reaching a final evaluation of the subject matter of the application without requiring any further official communication.

A hearing 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 effect of the subject matter, or in case of questions about patentability or inconsistencies in connection with the wording of the claims that cannot be clarified sufficiently in writing.

A hearing is not appropriate if it would delay the procedure unnecessarily, according to the state of the files. If the applicant replies to a communication as to substance by merely requesting a hearing without giving comments on substantive matters, a hearing is not likely to be useful since it is not recognisable which substantive or legal questions, that might be relevant to the decision, might be clarified in a hearing (cf. BPatG, *Blatt für PMZ* 1976, p. 138).

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

The examiner can suggest a hearing or a demonstration on his own initiative if he considers it necessary.

If a hearing has taken place before a change of examiners, it should be repeated only if the new examiner has serious reasons for not sharing the view of his predecessor. The new examiner must inform the applicant on his deviating view in an official communication.

At the beginning of the hearing, the applicant or his representative must identify himself unless he is known to the examiner. A representative who is not an attorney or patent attorney must always be requested to produce a power of attorney (Sec. 18 (3) Ordinance Concerning the German Patent and Trade Mark Office).

In the hearing the examiner should at first outline the controversial and unclear items. The examiner can submit proposals. If an 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 shall be taken, reproducing the essentials of the hearing.

The following shall be included in the minutes:

- a) place, date, the persons attending, and the course of the hearing,
- b) the new state of the art or new legal aspects introduced,
- 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 division or abandonment, the combination of applications as well as declarations on the status of addition.

If, as a result of the hearing, the examiner deviates from his former view, the minutes shall show the reasons that have led to this change of view.

The examiner shall 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 legally relevant declaration but a question of providing evidence.

Under Sec. 46 (2), second sentence, Patent Act, minutes shall be drawn up in application of Sec. 160a, 162 and 163 of the Code of Civil Procedure<sup>18</sup>. 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 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 immediately after the hearing.

Subject to the consent of the persons attending the hearing it is admissible to ask technically competent colleagues to participate in a hearing if the subject matter of the application concerns the fields of examination of several examining sections or if additional special expert knowledge is required; participation and consent shall be recorded in the minutes.

As a rule, the decision of the examining section on the application should be pronounced at the end of the hearing. The delivery as well as the operative part of the pronounced decision shall be included in the minutes of the hearing. If the patent is being granted, the documents must as a rule be prepared for the grant as prescribed before the decision is delivered. The decision shall then be communicated *ex officio* (Sec. 47 (1), first and second sentences, 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 examiner considers it appropriate, he may also give an oral statement on the essential contents of the reasons. The written statement of reasons shall be prepared immediately. Any inconsistencies between the written statement of reasons and the orally communicated reasons are non-prejudicial, but should be avoided.

The German Patent and Trade Mark Office is bound by the pronounced decision. Communications by the parties received after the decision was pronounced may no

longer be taken into consideration, except in the case of a later review on appeal (cf. paragraph 3.9.).

### **3.6.2. Calling without invitation**

If an applicant or a representative calls at the examining section without being invited to do so, this shall be briefly noted in the files, especially when he makes an oral request for accelerating the procedure or for a time extension. If he requests an immediate hearing, the decision on this matter is left to the examiner's discretion; the examiner is not obliged to hear the caller.

### **3.6.3. Telephone conversations**

Questions not necessarily requiring a written communication shall be clarified by telephone with the applicant. Telephone conversations cannot replace official communications that provide substantive comments of considerable importance with regard to the subject matter of the invention. Nor can telephone conversations replace hearings that enable 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 shall make a note in the file on the telephone conversation.

## **3.7. Preparation of the grant of the requested patent**

### **3.7.1. Filing of documents ready for grant**

Under Sec. 10 Patent Ordinance, the invention for which patent protection is sought in the patent claims must be indicated in the description; the description shall not contain any information that is obviously not necessary for explaining the invention. Pursuant to Sec. 14 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 must 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 (Sec. 34 (7) Patent Act, Sec. 10 (2) no. 2 Patent Ordinance). The mentioning of the relevant state of the art does not mean that the applicant has to evaluate and assess it. Disparaging remarks on the state of the art are not admissible.

<sup>18</sup> Zivilprozessordnung

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

It should be noted that amendments must not contain inadmissible extensions (cf. Sec. 38 Patent Act). For this reason, requests for amendments should be limited to the necessary extent.

The applicant must file fair copies incorporating changes to the patent claims or the description (Sec. 15 (1) Patent Ordinance).

### **3.7.2. Editing documents**

Patent specifications are official publications. They may not contain any indications whose publication would be contrary to morality or infringe a statutory prohibition. The applicant is responsible for a correctly worded version of the patent specifications.

The examiner need not edit the documents if the documents filed are clearly drafted and if the wording is acceptable. The examiner shall, in particular, respect the particularities of the applicant's language.

Documents can no longer be modified after pronouncement of the decision to grant or after the decision to grant was handed over to the document dispatching service, except in case of interlocutory revision.

### **3.8. Decisions of the examining section (Sec. 47 Patent Act)**

Any final arrangement of the examining section affecting the rights of a party concerned constitutes a decision. Decisions shall contain reasoned statements, be in writing and be communicated *ex officio* to the parties concerned.

The structure and contents of the decisions depend on the requirements of the individual case. At the beginning, separated from the reasons, the decision shall contain a special dictum (the operative part), containing the actual decision.

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 if it gives reasons.

Reasons need not be given in detail if the application is rejected because the defects expressly notified in an official communication have not been removed and the applicant has not made any statements. In these cases reference can be made to the reasons stated in the communication.

Furthermore, reasons need not be given if the applicant is the only party to the procedure and his request has been allowed (Sec. 47 (1), third sentence, 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 shall be recorded in a short file note.

The written execution of a decision must be accompanied by a statement concerning the right to appeal pursuant to Sec. 47 (2), first sentence, Patent Act. In case of omitted or incorrect instructions, the appeal may be filed within one year of the service of the decision, except where the parties have been instructed in writing that an appeal is not permissible.

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

#### **3.8.1. Decision to grant (Sec. 49 Patent Act)**

If the subject matter of the application is patentable pursuant to Sec. 1 to 5 Patent Act and if the application complies with the requirements of Sec. 34, 37 and 38 Patent Act, and if possible defects in the abstract, objected to under Sec. 45 (1) 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 grant (Sec. 58 Patent Act).

#### **3.8.2. Decision to reject the application (Sec. 48 Patent Act)**

The examining section rejects the application if the invention is not patentable or if the defects objected to under Sec. 45 (1) Patent Act have not been remedied. If, during a hearing, a request for a decision on the record is filed, the arguments put forward in the hearing must be dealt with in the decision.

### **3.9. Appeal and review**

Pursuant to Sec. 73 (1) Patent Act, an appeal shall lie from the decisions of the examining sections.

It is irrelevant for the admissibility of an appeal whether the decision taken by the examining section was issued in the form of a decision, an order or an official communication. Rather, it is decisive whether the decision is conclusive and affects the applicant's rights.

The appeal shall be filed in writing with the German Patent and Trade Mark Office (Sec. 73 (2), first sentence, Patent Act). An appeal fee according to the Patent Costs Act shall be due upon the filing of the appeal. If the appeal fee is not paid within the period allowed for filing the appeal, the appeal shall be deemed not to have been filed (Sec. 2, 3, 6 Patent Costs Act).

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

A decision can be rectified only if the grounds for the rejection outlined by the examining section do no longer exist, e.g. because the substantiation of the appeal has convinced the examining section or requested amendments have been made. If the decision is rectified, the examining section may order the appeal fee to be refunded pursuant to Sec. 73 (3), second sentence, Patent Act.

A refund of the appeal fee shall 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 had been filed because of an unsuitable handling of the procedure.

The decision shall 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. If this is not the case, the appeal shall be submitted to the Federal Patent Court without comment as to its merits upon the expiration of the period for presentation (Sec. 73 (3), third sentence, Patent Act) even if other documents have been announced.

#### **4. Special procedures and subject matter of application**

##### **4.1. Handling of patents of addition**

A patent of addition may be applied for within 18 months from the date of filing or from the priority date of the main application (cf. Sec. 16 (1), second sentence, Patent Act).

For the application of a patent of addition it shall first be ascertained whether the main application or main patent is still in force, and whether the applicant of the main application and the applicant of the patent of addition are identical. The identity of the applicants can still be established until the date when the patent of addition is granted. Then the reduced fee shall be granted for the application of a patent of addition as from the date when the grant of a patent of addition is requested.

The subject matter of the application for a patent of addition must be an improvement or further development of the subject matter of the main patent (cf. Sec. 16 (1), second sentence, Patent Act). Consequently, a patent of

addition may be granted only for such inventions which, together with the subject matter of the main patent, could have been filed as a unitary invention.

##### **4.1.1. Lapse of the main patent or the main application**

If the main patent or main application lapses, the status of addition also ceases to exist. The following cases are conceivable:

- a) If the main patent lapses due to revocation or other reasons, the former patent of addition becomes an independent patent by act of law, Sec. 16 (2), first sentence, Patent Act, and shall become subject to the payment of fees. The due date and the annual fee amount shall be determined by the date of commencement of the preceding main patent, Sec. 17 (2), second sentence, Patent Act.
- b) If the main patent or main application in case of an application for the grant of a patent of addition lapses, the applicant shall be given the opportunity to convert his request into a request for an independent patent. In that case the applicant shall have the obligation to subsequently pay the fees that are due for an application that is independent from the beginning, Sec. 17 (2), third sentence, Patent Act. If such request is not filed, the application shall be rejected.
- c) The applicant shall also have an obligation to subsequently pay the fees, where the application of addition is deemed an application for an independent patent by act of law, pursuant to Sec. 43 (2), fourth sentence, Sec. 44 (3), second sentence, Patent Act.

##### **4.1.2. Dispute on status of addition**

If the examining section is of the opinion that the conditions for the requested grant of a patent of addition have not been met, annual fees will not become due for this application until after the disputed issue has been finally clarified.

If the request for the grant of a patent of addition is maintained, the application of addition shall be rejected, if the examining section cannot be convinced by the arguments of the applicant. If the applicant follows the view held by the examining section and if he converts the request for the grant of a patent of addition into a request for the grant of an independent patent, the fees having accrued in the meantime shall be due upon receipt of the declaration.

If the declaration is received after the rejection of the application and the filing of an appeal against the decision of rejection, and if the appeal is then granted by the examining section, the two-month time limit for the payment of the fees without surcharge for late payment (Sec. 7 (1), first sentence, Patent Costs Act) shall not commence upon receipt of the declaration, but upon service of the decision to grant the appeal. If the proceedings are pending before the Federal Patent Court and the Federal Patent Court allows a subsidiary request for the grant of an independent patent, the two-month



time limit shall commence on the date of pronouncement or on the date of service of the decision to the applicant.

#### 4.1.3. Due date of current annual fees

The special due dates for payment of the accrued annual fees do not affect the statutory due dates for payment of the subsequently arising annual fees. These annual fees shall become due pursuant to Sec. 17 (1) Patent Act and Sec. 2, 3 (2), Sec. 7 (1) Patent Costs Act.

## 4.2. Applications concerning biotechnological inventions

### 4.2.1. General aspects

Biotechnological inventions are inventions which concern a product consisting of or containing biological material or a process by means of which biological material is produced, processed or used. Biological material means any material containing genetic information, i.e. its structural design, and capable of reproducing itself or being reproduced in a biological system. Microbiological process means any process involving or performed upon or resulting in microbiological material.

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 no. L 213 p. 13 et seq.) is meant to stipulate community-wide harmonised provisions for the patenting of such innovations. The draft law of the Federal German Government to implement the Directive 98/44/EC (Bundestag printed paper<sup>19</sup> 15/1709 of 15 October 2003) is presently being discussed in the legislative bodies. The provisions of Directive 98/44/EC shall additionally be taken into account for the examination of biotechnological inventions.

Microbiological processes and products thereof (Sec. 2 no. 2, second sentence, 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 shall ensure that the invention is disclosed pursuant to Sec. 34 (4) Patent Act. The deposit of biological material, access to such material and the re-deposit of biological material are governed by Chapter IV of the Directive 98/44/EC. For implementation into national law, it is planned to issue a statutory order pursuant to Sec. 34 (8) Patent Act, which is being drafted presently.

If the application concerns a microbiological process itself, the deposit of the product of the process shall not replace proof of reproducibility of the process (BGH, *Blatt für PMZ* 1987, p. 201 et seqq. - *Tollwutvirus* -). 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 shall be submitted in electronic form (Sec. 11 Patent Ordinance in conjunction with Annex 1).

A due deposit for the national patent procedure may either be made according to the principles of the "Bäckerhefe" (baker's yeast) decision (BGH, *Blatt für PMZ* 1975, p. 171 et seqq.) or with 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"; *Blatt für PMZ* 1981, p. 53 et seqq.). The essential difference between the two depositary options is that, for deposits under the Budapest Treaty, no specific declaration of release is required for the release of a sample of the biological material to third parties. It must be ensured by the depositor's declaration of release, 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 guaranteed that the said microorganism is made available for a sufficiently long period of time.

### 4.2.2. Requirements of a deposit in detail

#### 4.2.2.1. Date of deposit

The biological material shall be deposited with a recognised, independent depositary institution not later than on the date of filing or the priority date. Among the depositary institutions recognised are at least the international depositary authorities which have acquired that status under Article 7 of the Budapest Treaty.

#### 4.2.2.2. Information concerning the depositary institution and the deposited biological material

The application documents as originally filed shall always indicate the depositary authority and the designation of the biological material assigned by it or indicated by the applicant. The said information must ensure clear attribution of the application to the deposited biological material. This applies also where the microorganism has already been deposited by a third party (BGH, *Blatt für PMZ* 1981, p. 418 et seqq. - *Erythronolid* -). The application documents as originally filed should also contain the information on the properties of the deposited biological material, known to the applicant, as well as its scientific designation.

#### 4.2.2.3. Duration of storage

A sufficient duration of storage of the deposited biological material by the depositary institution shall be irrevocably guaranteed on the date of filing, at the latest (BPatG, *Blatt*

<sup>19</sup> Bundestagsdrucksache

für PMZ 1987, p. 402; Mitt. PräsDPA<sup>20</sup>, no. 14/87, *Blatt für PMZ 1987*, p. 365). The duration of storage is sufficient if it complies with Rule 9.1 of the Regulations under the Budapest Treaty (BPatG, *Blatt für PMZ 1978*, p. 214 et seq.). The deposited material must be stored at least for the maximum possible patent term provided by law or until the possible expiry of supplementary protection certificate for medicinal products or plant protection products plus an appropriate additional period. An additional period of five years, as a rule, is deemed appropriate. The additional period shall start to run from the expiry of the maximum possible term of protection provided by law. Each request for the furnishing of a sample received from a third party during the additional period of five years will restart the additional period all over again. A sufficient duration of storage must also be guaranteed on the date of filing or priority date where the biological material has been deposited by a third party (BGH, *Blatt für PMZ 1981*, p. 418 et seqq. - *Erythronolid* -).

#### 4.2.2.4. Furnishing of samples

The deposited biological material is made available by furnishing samples. By a declaration vis-à-vis the depositary authority, made not later than on the date of filing, the depositor must have irrevocably authorised the depositary authority to furnish reproducible samples of the deposited biological material, specifically:

- a) any time upon request to the patent granting authority; and,
- b) to any third party as from the date of the first publication of the patent application. This is the date when the application is laid open to the public or, in case the patent is granted before it is laid open to the public, the date when the patent is granted (BPatG, *Blatt für PMZ 1987*, p. 402 et seqq.).

On the date of filing, at the latest, the deposited biological material must be withdrawn irrevocably from the depositor's sphere of influence. For the duration of storage, the depositor shall not have a claim to have the deposited biological material returned to him by the depositary authority. Accordingly, it must be ensured that the depositary authority will not comply with respective requests made by the depositor.

The depositary authority shall be ready to proceed according to the declaration of release made by the depositor; this readiness shall be proved.

The applicant may restrict the furnishing of samples. He may determine that third parties may not be furnished a sample of the biological material unless they undertake neither to pass on the sample including a culture derived from it to other parties, during the pendency of the application and the term of protection, nor to take it out of the scope of the Patent Act. Any culture still having the

features of the deposited biological material which are essential to carry out the invention shall be considered a derived culture.

No specific declaration of release is necessary for a deposit under the Budapest Treaty. The applicant may nevertheless restrict the furnishing of samples to the extent described above.

#### 4.2.2.5. Furnishing proof of the deposit

If the required proof of the deposit is not attached to the application, the defect shall, if it is obvious, be objected to within the examination as to obvious defects, otherwise within the examination procedure, and the applicant shall be invited to present appropriate proof (certificate of deposit or separate declaration of release, if any).

### 4.3. Applications comprising computer programs or rules

#### 4.3.1. Patent protection for inventions with computer programs, program-related processes, rules or the like

Inventions involving a computer program, an arithmetical or organisational rule, other software characteristics or a program-related process are in principle eligible for patent protection provided they contain a technical teaching. A technical teaching is a systematic teaching using controllable natural forces to achieve a result with clear cause and effect (BGH, last stated in *Blatt für PMZ 2000*, p. 276, p. 278 - *Sprachanalyseeinrichtung* -).

#### 4.3.2. Programs, rules as such

Excluded from patentability within the meaning of Sec. 1 (2) Patent Act, are among others.

- a) schemes, rules and methods for performing mental acts, playing games or doing business (e.g. a plan for learning certain skills, a method for solving mental exercise problems, or a plan for organising a commercial service) and programs for computers (see also paragraph 4.3.3.), and
- b) presentation of information (e.g. literature, contents of news).

The subject matter mentioned in items a) and b) are, by act of law, not regarded as inventions; however, patentability is excluded only to the extent to which protection is sought for the subject matter as such (Sec. 1 (3) Patent Act) i.e. it is excluded from patent protection only in so far as it is claimed in isolation from a specific function. But when used to solve a specific technical problem it is – in that context – in principle patentable (BGH, Mitt. 2001, p. 553, p. 555 - *Suche fehlerhafter Zeichenketten* -).

<sup>20</sup> *Mitteilungen des Präsidenten des DPA* (Communications of the President of the German Patent Office)

Consequently, this exclusion does not apply to the program-related inventions i.e. for technical instructions contained in programs or technical instructions drafted as a process or apparatus. Insofar as technical processes or apparatus are claimed in connection with subject matter mentioned in Sec. 1 (2) and (3) Patent Act, they are in principle patentable. This is true, above all, for programs performing procedural steps in conventional technical fields (cf. BGH, Mitt. 2001, p. 553, p. 555 - *Suche fehlerhafter Zeichenketten* -).

#### 4.3.3. Technical character of program-related inventions

A program-related invention has technical character, if, in order to solve the problem underlying the invention, it makes use of natural forces, technical measures or technical means (e.g. hydraulic flows, electric currents in circuit elements and control systems, or computer signals), or if the solution is the result of technical considerations (cf. BGH, *Blatt für PMZ* 2000, p. 273, p. 275 - *Logikverifikation* -).

Whether or not this is the case, must at first be ascertained by taking into account the features of the patent claim, considering the contents of the relevant application documents.

In doing so, the claimed subject matter shall be considered as a whole. The individual features must not be regarded separately. All features pertaining to the solution of the problem, i.e. all features of the patent claim, shall be taken into account, even though they are non-technical features (cf. also paragraph 3.3.3.2.4.). The link with technology must be established in the patent claim (cf. BGH, *Blatt für PMZ* 2000, p. 273, p. 274 - *Logikverifikation* -).

On the basis of an assessment of the subject matter defined in the patent claim it must be established whether the subject matter of the application relating to a process or a program for a computer or to a corresponding apparatus meets the requirements for technical character, pursuant to Sec. 1 (1) Patent Act. This includes the possibility of evaluating individual features of a claim differently, provided there are justified reasons for doing so, by taking account of the context on the basis of the understanding of a skilled person. However, the result of the assessment must not be made dependent on whether the subject matter is novel and inventive; nor should the assessment be biased towards what was already known and what, by comparison, is novel in the claimed teaching. The crucial issue is how the main substance of the claimed teaching is to be understood and evaluated from the skilled person's point of view at the time of filing the application (cf. BGH, *Blatt für PMZ* 2000, p. 273, p. 275 - *Logikverifikation* - with further references). Differences as compared to the state of the art are not investigated during the examination as to whether the invention has technical character, but later, during the examination as to novelty and inventive step.

#### 4.3.4. Process/program/circuit/data processing unit

In case of program-related inventions the technical character does not depend on the existence of a fixed circuit scheme (special purpose circuit). The same inventive idea underlying such technical scheme may also be patentable as a process, specifically in terms of combining software with programmable hardware. The decisive point is that the invention teaches and requires the use of technical means or technical considerations to solve the problem (cf. also paragraph 4.3.3.).

Program-related inventions may have a technical character even if the technical means used for the solution, i.e. data processing units or computer, circuit or control elements are already known. It is not detrimental if each of the individual elements separately operates in a known way.

The technical character of a process carried out by means of a program cannot be challenged on the ground that an ordinary data processing unit is used for the intended purpose. Rather, the characterising instructions in the claimed teaching must solve a specific technical problem. In these circumstances, the claimed teaching may also be protected as a computer program or in any other form which uses a data processing system (cf. BGH, Mitt. 2001, p. 553, p. 555 - *Suche fehlerhafter Zeichenketten* -). This applies particularly to manufacturing and control processes for technical installations, machines and devices. A program-related operating process for a control device, for instance, may be technical, if known control elements operating according to a programmed instruction have to be used to solve the problem.

A program does involve a technical teaching, in particular, where it is integrated into technical processes, for example, where it processes results of measurements, controls process flows or acts in another way as a control element. This is the case, for example, in an anti-lock braking system for wheel brakes: The sensors and valves are linked via control signals in accordance with a program-related process, whereby a signal triggered by the movement of a monitored wheel changes the brake pressure by activating a valve (cf. BGH, *Blatt für PMZ* 1981, p. 70 - *Antiblockiersystem* -).

An invention enabling the automatic indication of different parameters determined by measurements combined according to a given method of calculation provides a technical teaching (cf. BGH, *Blatt für PMZ* 1992, p. 255 - *Tauchcomputer* -).

A program-related teaching may generally be protected by a patent if it concerns the functional capability of the data processing system as such and consequently enables the direct interaction of its constituent elements (cf. BGH, *Blatt für PMZ* 1991, p. 345 - *Seitenpuffer* -).

#### 4.3.5. Formulating the teaching in the claim

An apparatus (computer) which is configured in a specific way has in principle technical character due to its concrete embodiment. This applies even if, for example, texts are edited on the computer. For the purpose of assessing the technical character of an apparatus it is not relevant whether the apparatus produces a (further) technical effect, whether technology is enriched by it or whether it makes a contribution to the state of the art (BGH, *Blatt für PMZ* 2000, p. 276 - *Sprachanalyseeinrichtung* -).

The teaching concretely formulated in the claim is not necessarily patentable just because the claim is directed to a physical object. The question as to whether the subject matter of a claim is patentable cannot be answered solely in the light of what category it belongs to. Rather the main thrust of the claimed teaching is decisive. A teaching falling within the prohibition on patenting (computer program as such) does not become patentable merely because it is set out in a patent application in a form which is stored on a conventional data carrier (BGH, *Mitt.* 2001, p. 553 - *Suche fehlerhafter Zeichenketten* -).

The case is different where the features of the claim in question characterised as a device serve to solve a concrete technical problem (cf. BGH, *Blatt für PMZ* 2000, p. 276 - *Sprachanalyseeinrichtung* - , BGH, *Mitt.* 2001, p. 553, p. 556 - *Suche fehlerhafter Zeichenketten* - ).

#### 4.3.6. Cases of doubt

For determining the technical character of the invention, it is sufficient if compliance with the requirements of technicality is established *prima facie* in consideration of the above stated principles. If sound reasons are given that the invention is technical, remaining doubts do, as a rule, not justify the denial of its technical character.

#### 4.3.7. Presentation of the application

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

In addition to or instead of structural features (circuit details) also customary operation-related and function-related data are allowed in the patent claims.

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 data processing units in a customary, exactly defined program language may be permitted in the description, if they are conducive to intelligibility.

#### 4.4. 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 defects cannot be concluded before the expiry of the relevant period for laying the application open for public inspection (18 months, Sec. 31 (2) no. 2 Patent Act), the uncorrected documents of the patent application shall be published.

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

The patent application is not published and no reference pursuant to Sec. 32 (5) Patent Act is made, if the patent specification has already been published.

The originally filed documents must be used for the first publication of the patent application, provided these are printable. If the drawings are missing on receipt of the application, 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 shall be incorporated in the documents for the first publication of the application (*Offenlegungsschrift*).

If the whole application or parts thereof is/are not drafted in German, the German translation shall 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 Sec. 14 Patent Ordinance. For the printing of the patent application (*Offenlegungsschrift*), after the examination as to obvious defects by the examiner, also such documents shall be used which were subsequently filed because the original documents were not printable or contained obvious errors, or were submitted upon the request of the examining section to remedy an obvious defect. Other unsolicited new documents filed by the applicant shall 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 shall 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 shall be made on the title page of the first publication of the patent application (*Offenlegungsschrift*), stating that the contents of the publication are not identical with the documents filed on the date of filing.

## 5. Supplementary provisions for the examination of patent applications and patents originating from the former GDR

These guidelines apply to the examination of patents and patent applications originating from the territory designated in Art. 3 of the Unification Treaty<sup>21</sup> (former GDR) and extended from that territory under Sec. 4 Extension Act<sup>22</sup> (*Blatt für PMZ* 1992, p. 202) provided that the formal and substantive requirements for protection are governed by statutory provisions of the former GDR, in accordance with Sec. 5 Extension Act.

### 5.1. Formal requirements for protection

As far as formal requirements for protection are concerned, the Ordinance of 5 November 1975 on the Requirements for the Drafting and Filing of Invention Applications<sup>23</sup> (*Blatt für PMZ* 1976, p. 174) shall apply to patent applications filed between 1 March 1976 and 31 July 1986. Patent applications filed between 1 August 1986 and 23 August 1990 are subject to the Ordinance of 20 May 1986 on the Requirements for the Drafting and Filing of Patent Applications (*Blatt für PMZ* 1987, p. 161). To patent applications filed between 24 August and 2 October 1990, the Ordinance on the Application for Patents<sup>24</sup> of 27 July 1990 (*Blatt für PMZ* 1990, p. 412) shall apply.

### 5.2. Substantive requirements for protection

The substantive requirements for protection of DD patents and applications filed up to 31 December 1983 are provided for in Sec. 1, 4 and 6 of the GDR Patent Act of 6 September 1950. Sec. 5 and 6 of the Act on the Legal Protection of Inventions<sup>25</sup> (Patent Act of the GDR) of 27 October 1983, in the version applicable until 30 June 1990, shall apply to DD patents and/or applications filed between 1 January 1984 and 30 June 1990. The provisions shall be construed according to the legal practice of the former GDR (cf. BPatG, GRUR 1993, p. 733). When applying these provisions it must be borne in mind that under Article 1 of the Unification Treaty the Basic Law<sup>26</sup> entered into force on 3 October 1990 in the territory designated in Art. 3 of the Unification Treaty. The said provisions shall therefore be construed in accordance with the constitution. Hence, ideological values and legal maxims shall not be considered. The application of Sec. 5 (5) GDR Patent Act was in accordance with the assessment criteria prevailing in the Federal Republic of Germany (BPatG, GRUR 1993, p. 733, p. 735).

The substantive requirements for protection of patents and/or applications filed between 1 July 1990 and 2 October 1990, are governed by Sec. 5 and 6 GDR Patent Act in the version of the Act amending the Patent Act and the Act of 29 June 1990 on Distinctive Signs for Goods<sup>27</sup> (*Blatt für PMZ* 1990, p. 347). Taking into account that the revised version was intended to bring GDR patent act in line with the law of the Federal Republic of Germany, these provisions should be construed, if possible, according to the principles of federal German law. This applies, in particular, to legal terms which are used in both, the law of the Federal Republic of Germany and the law of the former GDR (e.g. "novelty", "industrial application", "inventive step").

### 5.3. Special provisions concerning the deposit of microorganisms

For IP rights extended under Sec. 4 Extension Act, the requirement of the deposit of microorganisms or other reproducible cell material is provided for in Sec. 1 (1) no. 7, (2) of the Ordinance on the Requirements for the Drafting and Filing of Patent Applications of 20 May 1986 (*Blatt für PMZ* 1987, p. 161) or Sec. 1 (2) of the Ordinance on the Application for Patents of 27 July 1990 (*Blatt für PMZ* 1990, p. 412). The recognition of a deposit is laid down by the Ordinance of 27 September 1979 on the Deposit of Microorganisms when Filing an Invention Application<sup>28</sup> (*Blatt für PMZ* 1983, p. 8). Deposits effected before 3 October 1990 with a depositary institution recognised by the former GDR Patent Office shall be considered as duly disclosed inventions even if the depositary institution would not have complied with the requirements under federal German law.

<sup>21</sup> *Einigungsvertrag*

<sup>22</sup> *Erstreckungsgesetz*

<sup>23</sup> *Anordnung über die Erfordernisse für die Ausarbeitung und Einreichung von Erfindungspatenten (DDR)*

<sup>24</sup> *Anordnung über die Anmeldung von Patenten (DDR)*

<sup>25</sup> *Gesetz über den Rechtsschutz von Erfindungen (DDR)*

<sup>26</sup> *Grundgesetz*

<sup>27</sup> *Gesetz zur Änderung des Patentgesetzes und des Gesetzes über Warenkennzeichen (DDR)*

<sup>28</sup> *Anordnung über die Hinterlegung von Mikroorganismen bei der Vornahme von Erfindungsanmeldungen (DDR)*