
**Council for Trade-Related Aspects
of Intellectual Property Rights**

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**MAIN DEDICATED INTELLECTUAL PROPERTY LAWS AND REGULATIONS
NOTIFIED UNDER ARTICLE 63.2 OF THE AGREEMENT**

GERMANY

Addendum

The present document reproduces the text¹ of the Second Law to Amend the Patent Law and other Laws of 16 July 1998, as notified by Germany under Article 63.2 of the Agreement (see document IP/N/1/DEU/1/Rev.1/Add.1).

**Conseil des aspects des droits de propriété
intellectuelle qui touchent au commerce**

**PRINCIPALES LOIS ET RÉGLEMENTATIONS CONSACRÉES
À LA PROPRIÉTÉ INTELLECTUELLE NOTIFIÉES
AU TITRE DE L'ARTICLE 63:2 DE L'ACCORD**

ALLEMAGNE

Addendum

Le présent document contient le texte¹ de la Deuxième loi portant modification de la Loi sur les brevets et d'autres lois, du 16 juillet 1998, notifiée par l'Allemagne au titre de l'article 63:2 de l'Accord (voir le document IP/N/1/DEU/1/Rev.1/Add.1).

**Consejo de los Aspectos de los Derechos de Propiedad
Intellectual relacionados con el Comercio**

**PRINCIPALES LEYES Y REGLAMENTOS DEDICADOS A LA
PROPIEDAD INTELECTUAL NOTIFICADOS EN VIRTUD
DEL PÁRRAFO 2 DEL ARTÍCULO 63 DEL ACUERDO**

ALEMANIA

Addendum

En el presente documento se reproduce el texto¹ de la segunda Ley para modificar la Ley de Patentes y otras leyes, de 16 de julio de 1998, que Alemania ha notificado en virtud del párrafo 2 del artículo 63 del Acuerdo (véase el documento IP/N/1/DEU/1/Rev.1/Add.1).

¹ In English only./En anglais seulement./En inglés solamente.

Second Law
to Amend the Patent Law
of 16 July 1998

The Federal Parliament has passed the following Law:

Article 2
Amendment of the Patent Law
(420-1)

The Patent Law in the version published on 16 December 1980 (Federal Law Gazette 1981 I page 1), last amended by Article 3 paragraph 13 of the Law of 28 October 1996 (Federal Law Gazette I page 1546), shall be amended as follows:

1a. In the Table of contents the titles of Parts II, III and V shall be worded as follows:

| | Sections |
|---|-----------|
| "Part II: The Patent Office | 26 to 33 |
| Part III: Procedure Before the Patent Office | 34 to 64 |
| Part V: Proceedings Before the Patent Court | |
| 1. Proceedings on Appeal | 73 to 80 |
| 2. Nullity, Forfeiture and Compulsory Licence Proceedings | 81 to 85 |
| 3. Common Rules of Procedure | 86 to 99" |

1b. Section 3 (2), first sentence item 2, shall be worded as follows:

"2. European applications as originally filed with the competent authority, in which protection is sought for Germany and the designation fee for Germany under Article 79 (2) of the European Patent Convention unless the application for a European patent is based on an international application and does not fulfil the conditions set out in Article 158(2) of the European Patent Convention;"

1c. In Section 16 (2), first sentence, the word "forfeiture" shall be deleted.

2. In Section 16a (2) the word "their" shall be inserted after the words "the compulsory licence and" and the words "(Sections 15, 34)" shall be replaced by the words "(Sections 15, 30)".
3. Section 17 (3), second sentence, shall be worded as follows:
"If an annual fee has not been paid by the end of the last day of the second month following the due date, the surcharge prescribed in the schedule of fees shall become due."
4. In Section 23 (2) the words "concerning the grant of a right to the exclusive use of the invention (Section 34 (1))" shall be replaced by the words "concerning the grant of an exclusive licence (Section 30 (4))".
5. Section 24 shall be worded as follows:

"Section 24

(1) The non-exclusive right to the industrial exploitation of an invention shall be granted by the Patent Court in an individual case in accordance with the following provisions (compulsory licence) if

1. the person seeking a licence has tried unsuccessfully with a reasonable time to obtain permission from the patentee to exploit the invention on reasonable business terms, and
2. the public interest requires the grant of a compulsory licence.

(2) If the person seeking a licence cannot use an invention protected by a subsequent patent without infringing the prior patent, he shall, in the framework of subsection (1), be entitled to the grant of a compulsory licence by the holder of the prior patent, so far as his own invention when compared with that of the prior patent exhibits important technical progress of substantial economic significance. The patentee can require the person seeking a licence to grant him a cross-licence on reasonable conditions for the use of the subsequent patented invention.

(3) In respect of a patented invention in the field of semiconductor technology a compulsory licence may only be granted in terms of subsection 1 if this is

necessary to eliminate an anti-competitive practice by the patentee which has been established in court proceedings or in an administrative procedure.

(4) If the patentee does not work, or does not predominantly work, the patented invention in Germany, compulsory licences may be granted in terms of subsection (1) to ensure adequate supply of the patented product on the domestic market. Importation shall therefore be equivalent to the working of the patent in Germany.

(5) The grant of a compulsory licence for a patent shall be permissible only after the grant of the patent. It may be granted subject to restrictions and made dependent upon conditions. The extent and duration of exploitation shall be confined to the purpose for which it was granted. The patentee shall be entitled to remuneration from the compulsory licensee, being remuneration that is reasonable in the circumstances of the case and that takes account of the economic value of the compulsory licence. If, in cases where recurrent remuneration payments become due in future, there is a substantial change in the circumstances that were decisive for determining the level of remuneration, every participant shall be entitled to demand a corresponding adjustment. If the circumstances on which the grant of the compulsory licence was based no longer apply and if their recurrence is improbable, the patentee may demand forfeiture of the compulsory licence.

(6) The compulsory licence for a patent may only be transferred together with the enterprise concerned with evaluation of the invention. The compulsory licence for an invention which is the subject of a prior patent may only be transferred with the subsequent patent.

6. Section 26 (2) shall be worded as follows:

"(2) As a rule, only a person who has passed a State or academic final examination in a technical or natural scientific subject in Germany as a regular student at a university or a technical or agricultural university or mining academy and who has also worked thereafter in the field of natural science or in the practical field for at least five years and is in possession of the requisite legal knowledge shall be appointed a technical member. Final examinations in another

Member State of the European Union or in a Contracting State of the Convention Concerning the European Economic Area shall be equivalent to the final examination in Germany in accordance with the law of the European Communities.”

6a. Section 27 (5) shall be worded as follows:

“(5) The Federal Ministry of Justice shall have power to establish by statutory order that officials of the higher intermediate and intermediate grades of the civil service as well as comparable employees shall be entrusted with the handling of matters within the competence of the Examining Sections or the Patent Divisions which present no particular technical or legal difficulties, with the exception, however, of the grant of a patent and the rejection of a patent application on grounds which the applicant has contested. The Federal Ministry of Justice may delegate such power by statutory order to the President of the Patent Office.

7. Section 30 shall be amended as follows:

a) Subsection (1) shall be worded as follows:

“(1) The Patent Office shall maintain a Register in which shall be recorded the titles of patent applications, the files of which may be inspected by any person, and of granted patents, supplementary certificates of protection (section 16a) and the names and addresses of applicants or of patentees and appointed representatives, if any (Section 25), whereby an entry made by a representative shall suffice. The commencement, division, expiration, lapsing, order for limitation, revocation, declaration of nullity of patents and supplementary certificates (Section 16a) as well as the filing of opposition and of a nullity action shall also be recorded therein.”

b) Subsection (2) shall be worded as follows:

“(2) The President of the Patent Office may require further information to be recorded in the Register.”

c) In subsection (3), first sentence, the words “of the applicants or the patentees and of their representatives” shall be replaced by the words “of the applicant or the patentee or his representative.”

d) The following Sections (4) and (5) shall be added:

“(4) Upon application by the patentee or the licensee the Patent Office shall record in the Register the grant of an exclusive licence if proof of consent by the other party is furnished to the Patent Office. The application pursuant to the first sentence shall be inadmissible so long as there is a declaration of willingness to grant a licence (Section 23 (1)). The record shall be cancelled upon application by the patentee or the licensee. The patentee’s application for cancellation shall be supported by proof of consent by the licensee designated when the record was made or by his successor in title.

(5) A fee as prescribed by the schedule of fees shall be paid when an application is made pursuant to the first or the third sentence of subsection (4); if the fee is not paid the application shall be deemed not to have been filed.”

8. In Section 31 (2), item 2, the words “the filing date of the application” shall be replaced by the words “day of application” (Section 35 (2)).
9. Section 32 shall be amended as follows:
 - a) In subsection (2), first sentence, the words “(Section 35 (1), items 2 to 4) shall be replaced by the words “and the abstract” (Section 36)”.

b) In subsection 2 the second sentence shall be repealed.

c) In subsection 5 the words "or the recording and cancellation of exclusive licences" shall be inserted after the words "expiration of the patent".

10. Sections 34 and 35 shall be worded as follows:

"Part III

Procedure before the Patent Office

Section 34

(1) Applications for the grant of a patent for an invention shall be filed with the Patent Office for an invention.

(2) Applications may also be made through a Patent Information Centre where such office has been designated to accept patent applications by promulgation in the Federal Law Gazette by the Federal Ministry of Justice. An application that may contain a state secret (section 93 of the Criminal Code) shall not be filed through a Patent Information Centre.

(3) The application shall contain:

1. the name of the applicant;
2. a request for the grant of a patent, which shall designate the invention clearly and concisely;
3. one or more claims defining the matter for which protection is sought;
4. a description of the invention;
5. any drawings referred to in the claims or the description.

(4) Applications shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

(5) Applications may contain only one invention or a group of inventions connected with each other in such a way that they manifest a single general inventive idea.

(6) A fee for the costs of the procedure as prescribed by the schedule of fees shall be paid with the application. If the fee is not paid, the Patent Office shall notify the inventor that the application will be deemed to have been withdrawn unless the fee is paid before the end of one month after service of the notification.

(7) The Federal Ministry of Justice shall have the power to issue by statutory order regulations concerning the form and other requirements for the application. It may delegate such power by statutory order to the President of the Patent Office.

(8) At the request of the Patent Office, the applicant shall state the prior art fully and truthfully to the best of his knowledge and incorporate it in the description (subsection (3)).

(9) The Federal Ministry of Justice shall have the power to issue by statutory order regulations on the deposit of biological material, on access thereto, including the persons entitled to access, and on renewed deposit of biological material so far as the invention embraces the use of biological material or concerns such material as is not available to the public and cannot be disclosed in the application in a manner fit for it to be carried out by a person skilled in the art. The Federal Ministry of Justice may delegate such power by statutory order to the President of the Patent Office.

Section 35

(1) If the application is not drawn up wholly or partly in German, the applicant shall submit a German translation within a period of three months after filing the application. If the application contains a reference to drawings and if no drawings are enclosed with the application, the Patent Office shall request the applicant, within a period of one month after service of the request, either to submit the drawings or to declare that any reference to the drawings shall be deemed not to have been made.

(2) The filing date of the patent application shall be the day on which the documents pursuant to Section 34 (3), items 1 and 2, and so far as they at least contain information which to all appearances is to be deemed to be a description pursuant to Section 34 (3), item 4, were received

1. at the Patent Office
2. or at a Patent Information Centre if such office has been designated for this purpose by promulgation in the Federal Law Gazette by the Federal Ministry of Justice.

Where the documents have not been drawn up in German, this shall only apply if the German translation has been received by the Patent Office within the period pursuant to subsection (1), first sentence; otherwise the application shall be

deemed not to have been filed. If the applicant submits the missing drawings following a request pursuant to subsection (1), second sentence, the filing date shall be the date on which the drawings were received by the Patent Office, otherwise any reference to the drawings shall be deemed not to have been made."

11. In Section 36 (1) and in Section 37 (1), first sentence, the words "date of the filing of the application" shall be replaced by the word "filing date" in each case.

12. In section 39 (3) the words "Sections 35 and 36" shall be replaced by the words "Sections 34 to 36".

12a. Section 40 shall be amended as follows:

a) In Section 40 (4), second half of the sentence, the words "and a copy of the earlier application filed" shall be deleted.

b) The following subsection (6) shall be inserted after subsection (5):

"(6) If there is a request for inspection of the file of a subsequent application (Section 31) claiming priority for an earlier patent and utility model application, the Patent Office shall place a copy of the earlier patent or utility model application in file relating to the subsequent application."

13. Section 41 (1) shall be worded as follows:

"(1) Any person who, in accordance with an international agreement, claims priority for an earlier foreign application for the same invention shall, within a period of sixteen months after the priority date, state the date, country and serial number of the earlier application and file a copy of that application, if such action has not already been taken. Particulars may be altered within that period. Where the particulars are not provided in due time, the priority claim for the application shall be forfeited."

14. Section 42 (1) shall be worded as follows:

(1) If the application obviously does not comply with the requirements of Sections 34, 36, 37 and 38, the Examining Section shall request the applicant to remedy the defects within a specified period. If the application does not comply with the provisions on the form and on other requirements for applications

(Section 34 (7)), the Examining Section may refrain from objecting to the defects until the start of the examination procedure (Section 44)."

15. In Section 44 (1) the number "35" shall be replaced by the number "34".
16. Section 45 (1) shall be amended as follows:
 - a) In subsection (1), first sentence, the number "35" shall be replaced by the number "34".
 - b) Subsection 1, second sentence, shall be repealed.
17. In Section 48, first sentence, the words "application is maintained although" shall be replaced by the words "examination shows that".
18. In Section 49 (1) the number "35" shall be replaced by the number "34".
19. In Section 49a (3), first sentence, the words "Section 35 (4)" shall be replaced by the words "Section 34 (7)".
20. In Section 62 (2), first sentence, the words "at the equitable discretion" shall be deleted.
- 20a. Section 65 (1), first sentence, shall be worded as follows:

"There shall be established a Patent Court as an autonomous and independent federal court for hearing appeals from decisions of the Examining Sections or Patent Divisions of the Patent Office and actions for declaration of nullity of patents and for the grant of compulsory licences (Sections 81, 85)."
- 20b. Section 66 (1), item 2, shall be worded as follows:

"2. chambers for deciding actions for declaration of nullity of patents and for the grant of compulsory licences (Nullity Chambers)."
21. In Section 73 (4), third sentence, the words "three months" shall be replaced by the words "one month".

22. In Section 80 (1), second sentence, the words “can be reasonably considered to have been” shall be replaced by the word “were”.

22a. The title preceding Section 81 shall be worded as follows:

“2. Nullity and Compulsory Licence Proceedings”.

23. Section 81 (1), first and second sentences, shall be worded as follows:

“Proceedings for a declaration of nullity of a patent or supplementary certificate of protection or for the grant or revocation of a compulsory licence or for adjustment of the remuneration for a compulsory licence, as assessed in a judgment, shall be instituted by bringing legal action. The action shall be directed against the person recorded in the Register as patentee.”

24. In Section 85 (1) the words “Section 24 (1)” shall be replaced by the words “Section 24 (1) to (5)”.

25. Section 100 (3) shall be amended as follows:

a) The following item 3 shall be inserted after item 2:

“3. if a participant was denied a hearing in accordance with the law,”.

b) The previous numbers 3, 4 and 5 shall become numbers 4, 5 and 6.

26. Section 102 (2) shall be amended as follows:

“(2) In proceedings before the Federal Court of Justice in an appeal on a point of law the provisions contained in Section 144 on assessment of the value in dispute shall apply mutatis mutandis.”

27. In Section 106 (1), first sentence, the words “Section 123 (5) shall apply” shall be replaced by the words “Section 123 (5) to (7) shall apply”.

28. Sections 110 to 114 shall be worded as follows:

“Section 110.

(1) An appeal shall lie to the Federal Court of Justice from the judgments of the Nullity Chambers of the Patent Court (Section 84).

(2) An appeal shall be filed with the Federal Court of Justice by submission of the notice of appeal.

(3) The time limit for an appeal shall amount to one month. It shall commence with service of the judgment drawn up in complete form, and at the latest on expiration of five months after its pronouncement.

(4) The notice of appeal must contain:

1. a reference to the judgment from which the appeal lies;
2. a declaration that an appeal has been filed against the judgment concerned.

(5) An official copy or a certified copy of the contested judgment should be submitted with the notice of appeal.

(6) Decisions of the Nullity Chambers shall only be subject to appeal together with the judgments (Section 84); Section 71 (3) of the Code of Civil Procedure shall not apply.

Section 111

(1) The appellant must give the grounds of appeal.

(2) The grounds of appeal, so far as they are not already contained in the notice of appeal, shall be filed with the Federal Court of Justice in a memorial. The time limit shall amount to one month; it shall commence when the appeal is filed. Upon a motion, the time limit may be extended by the presiding judge if he is freely convinced that the proceedings will not be delayed by the extension or if the appellant sets forth substantial grounds.

(3) The grounds of appeal must contain:

1. a declaration on the extent to which the judgment is being contested and as to the amendments to the judgment being moved (motions of appeal);
2. a definite description of the individual grounds to be adduced for contesting the judgment (grounds of appeal) as well as the new facts, the evidence and objections to evidence that a party is required to adduce in justification of his appeal.

(4) Parties shall be represented before the Federal Court of Justice by an attorney at law or a patent attorney holding their power of attorney. The representative shall be permitted to appear accompanied by technical advisor.

Section 112

(1) The notice of appeal and the grounds of appeal shall be served on the respondent on appeal. On service of the notice of appeal the date shall be indicated on which the appeal was filed. The appellant shall file the required number of certified copies with the notice of appeal or the grounds of appeal.

(2) The Chamber or the presiding judge may set the respondent a time limit for filing a written reply to the appeal and the appellant a time limit for filing a written statement on the reply to the appeal.

Section 113

(1) The Federal Court of Justice shall examine *ex officio* whether the appeal is admissible and whether it was filed in the statutory form and within the statutory time limit. If one of these requirements is not met, the appeal shall be dismissed as inadmissible.

(2) The decision may be given in a ruling without a hearing.

Section 114

If the appeal is not ruled as inadmissible, the date shall be set down for a hearing and shall be communicated to the parties."

29. Section 121 shall be worded as follows:

"Section 121

(1) In the proceedings before the Federal Court of Justice the provisions of Section 144 on assessment of the value in dispute shall apply *mutatis mutandis*.

(2) A decision shall also be given on the costs of the proceedings in the judgment. The provisions of the Code of Civil Procedure on the costs of proceedings (sections 91 to 101) shall apply *mutatis mutandis* unless equity requires a different decision; the provisions of the Code of Civil Procedure on assessment of costs (sections 103 to 107) and on compulsory execution of cost assessment orders (sections 724 to 802) shall apply *mutatis mutandis*."

30. Section 122 shall be amended as follows:

- a) In subsection (1), second sentence, the words "The first sentence of Section 110 (4)" shall be replaced by the words "Section 110 (6)".
 - b) Subsections (2), (3) and (4) shall be worded as follows:
 - "(2) An appeal shall be filed in writing with the Federal Court of Justice within one month.
 - (3) The time limit for an appeal shall commence with service of the judgment drawn up in complete form, and at the latest on expiration of five months after its pronouncement.
 - (4) Sections 74 (1), 84, 110 to 121 shall apply mutatis mutandis to proceedings before the Federal Court of Justice."
31. Section 123 shall be worded as follows
- a) Subsection 1, second sentence, shall be worded as follows:

"This shall not apply to the time limit for filing an opposition (Section 59 (1)), to the time limit allowed an opponent for filing an appeal against the maintenance of a patent (Section 73 (2)) and to the time limit for filing patent applications for which a priority may be claimed pursuant to Section 7 (2) and Section 40."
 - b) The following subsection (7) shall be added:

"(7) Any person who, in Germany, has in good faith started exploiting the subject matter of an application, which, as a result of reinstatement, claims priority for an earlier foreign application (Section 41), in the period between expiration of the term of twelve months and the re-entry into force of the priority right, or has, within that period, made the necessary arrangements for doing so, shall also be entitled to a right pursuant to subsection (5)."
32. Section 126 shall be amended as follows:
- a) The first sentence shall be worded as follows:

"The language used before the Patent Office and the Patent Court shall be German unless otherwise provided."
 - b) The second sentence shall be repealed.
33. Section 127 shall be amended as follows:
- a) In subsection (1) item 5 shall be deleted.

b) In subsection (2) the words "Section 122 (2)" shall be replaced by the words "Section 122 (3)", the words "Section 110 (1)" by the words "Section 110 (3), and the words "or for the application for a decision by the Federal Court of Justice (Section 112 (2))" shall be deleted.

34. Section 129, second sentence, shall be repealed.

34a. Section 132 (2) shall be worded as follows:

"(2) The first sentence of subsection 1 shall be applied *mutatis mutandis* to the opponent and to any person intervening pursuant to Section 59 (2) as well as to participants in proceedings for a declaration of nullity of a patent or in proceedings for the grant of a compulsory licence (Sections 81, 85) if the applicant furnishes *prima facie* evidence of his own interest warranting protection."

35. Section 135 shall be amended as follows:

a) Subsection (1) shall be worded as follows:

"(1) A request for the grant of legal aid shall be filed in writing with the Patent Office, the Patent Court or the Federal Court of Justice. In proceedings under Sections 110 and 122, the request may also be filed on record before the Registry of the Federal Court of Justice."

b) Subsection (2), second sentence, shall be repealed.

35a. Section 136, second sentence, shall be worded as follows:

"In opposition proceedings and in proceedings for a declaration of nullity of a patent or in proceedings for the grant of a compulsory licence (Sections 81, 85) this shall also apply to Section 117 (1), second sentence, Section 118 (1), Section 122 (2) and to sections 123, 125 and 126 of the Code of Civil Procedure."

36. Section 142a (1), second sentence, shall be worded as follows:

"This provision shall apply in trade with other Member States of the European Union as well as with other Contracting States of the Convention Concerning

the European Economic Area only insofar as controls are carried out by the customs authorities.”

Article 3
Amendment of the Utility Model Law
(421-1)

The Utility Model Act in the version published on 28 August 1986 (Federal Law Gazette, I page 1455), last amended by Article 13 of the Law of 2 September 1994 (Federal Law Gazette I page 2278), shall be amended as follows:

1. The abbreviation “UML” shall be added to the title.
2. Section 4 shall be amended as follows:
 - a) In subsection (1), first sentence, the words “in writing” shall be deleted.
 - b) The following subsection (2) shall be inserted after subsection (1):

“(2) Applications may also be filed through a Patent Information Centre where such office has been designated to accept patent applications by promulgation in the Federal Law Gazette by the Federal Ministry of Justice. An application possibly containing a state secret (section 93 of the Criminal Code) shall not be filed through a Patent Information Centre.”
 - c) The present subsection (2) shall become subsection (3) and shall be worded as follows:

“(3) Applications shall contain:

 1. the name of the applicant;
 2. a request for registration of the utility model, which must designate clearly and concisely the subject matter of the utility model;
 3. one or more claims in which shall be specified what is to be protected;
 4. a description of the subject matter of the utility model;
 5. the drawings referred to in the claims or the description.”
 - d) The present subsection (3) shall become subsection (4) and shall be worded as follows:

“(4) The Federal Ministry of Justice shall have the power to issue by statutory order regulations concerning the form and other requirements for

the application. It may delegate such power by statutory order to the President of the Patent Office.”

e) The present subsections (4) to (6) shall become subsections (5) to (7).

f) The following subsection (8) shall be inserted after subsection (7):

“(8) The Federal Ministry of Justice shall have the power to issue by statutory order regulations on the deposit of biological material, on access thereto, including the persons entitled to access, and on renewed deposit of biological material so far as the invention embraces the use of biological material or concerns such material as is not available to the public and cannot be disclosed in the application in a manner fit for it to be carried out by a person skilled in the art. The Federal Ministry of Justice may delegate such power by statutory order to the President of the Patent Office.”

3. The following Section 4a shall be inserted after Section 4:

“Section 4a

(1) If the application is not drawn up wholly or partly in German, the applicant shall submit a German translation within a period of three months after filing the application. If the application contains a reference to drawings and if no drawings are enclosed with the application, the Patent Office shall request the applicant, within a period of one month after service of the request, either to submit the drawings or to declare that any reference to the drawings shall be deemed not to have been made.

(2) The filing date of the utility model application shall be the day on which the documents pursuant to Section 34 (3), items 1 and 2, and so far as they at least contain information which to all appearances is to be deemed to be a description pursuant to Section 34 (3), item 4, were received

1. at the Patent Office
2. or at a Patent Information Centre if such office has been designated for this purpose by promulgation in the Federal Law Gazette by the Federal Ministry of Justice.

Where the documents have not been drawn up in German, this shall only apply if the German translation has been received by the Patent Office within the period pursuant to subsection (1), first sentence; otherwise the application shall be deemed not to have been filed. If the applicant submits the missing drawings

following a request pursuant to subsection (1), second sentence, the filing date shall be the date on which the drawings were received by the Patent Office, otherwise any reference to the drawings shall be deemed not to have been made.”

3a. In Section 6 (1), second sentence, the words “Section 40 (2) to (4)” shall be replaced by the words “Section 40 (2) to (4), (5), first sentence, (6)”.

4. In Section (1), first sentence, the words “Section 4” shall be replaced by the words “Sections 4, 4a”.

4a. Section 10 (2) shall be worded as follows:

“(2) The Federal Ministry of Justice shall have the power to establish by statutory order that officials of the higher and lower intermediate grades of the civil service or employees in similar positions may be entrusted with the handling of matters within the competence of the Utility Model Sections or the Utility Model Divisions which present no particular technical or legal difficulties, with the exception, however, of the rejection of applications on grounds which the applicant has contested. The Federal Ministry of Justice may delegate such power by statutory order to the President of the Patent Office.”

5. Section 20 shall be worded as follows:

“Section 20

The provisions of the Patent Law concerning the grant or the withdrawal of compulsory licences or adjustment of the remuneration for a compulsory licence, as assessed in a judgment, and concerning the procedure (Sections 81 to 99 and 110 to 122) shall apply mutatis mutandis in the case of registered utility models.”

6. Section 25a (1), second sentence, shall be worded as follows:

“This provision shall apply in trade with other Member States of the European Union as well as with other Contracting States of the Convention Concerning the European Economic Area only insofar as controls are carried out by the customs authorities.”

**Amendment of the Law on Employee Inventions
(422-1)**

Section 47 of the Law on Employee Inventions in the revised version published in the Federal Law Gazette Part III, No. 422-1, last amended by Article 2 section 17 of the Law of 22 December 1997 (Federal Law Gazette I p. 3224) shall be repealed.

**Article 5
Amendment of the Trade Mark Law
(423-5-2)**

The Trade Mark Law of 25 October 1994 (Federal Law Gazette I p. 3082, 1995 I p. 156), as last amended by Article 13 of the Law of 22 June 1998 (Federal Law Gazette I p. 1474) shall be amended as follows:

1. In Section 65 (1) items 11 and 12 shall be worded as follows:
 - “11. to entrust officials of the higher intermediate grade of the civil service or comparable employees with the handling of matters within the competence of the Trade Mark Divisions which present no particular legal difficulties, with the exception of decisions on the cancellation of trade marks (Section 48 (1), Sections 53 and 54), the giving of opinions (Section 58 (1)) and the decisions whereby the giving of an expert opinion is refused;
 12. to entrust officials of the lower intermediate grade of the civil service or comparable employees with the handling of matters within the competence of the Trade Mark Sections or Trade Mark Divisions which present no particular legal difficulties, with the exception of decisions on applications oppositions or other requests;”
2. Section 85 (2) shall be worded as follows:

“(2) In proceedings before the Federal Court of Justice in an appeal on a point of law the provisions contained in Section 142 on positive assessment of the value in dispute shall apply mutatis mutandis.”

Article 6
Amendment of the Law on International Patent Treaties
(118-17)

The Law on International Patent Treaties of 21 June 1976 (Federal Law Gazette II p. 649), last amended by Article 2 of the Law of 23 March 1993 (Federal Law Gazette I p. 366) shall be amended as follows:

1. Article II Section 4 shall be amended as follows:

- a) The title shall be worded as follows:

“Section 4

European Patent Applications

to the German Patent and Trade Mark Office”.

- b) Subsection 1, first sentence, shall be worded as follows:

“European patent applications may also be filed with the German Patent and Trade Mark Office or, pursuant to section 34 (2) of the Patent Law, through a Patent Information Centre.”

- c) In subsections 2 and 3 the words “German Patent Office” shall be replaced by the words “German Patent and Trade Mark Office”.

2. In Article II Section 4 (2), item 4 third sentence, the words “Section 35 (3), second sentence” shall be replaced by the words “Section 34 (6), second sentence”.

3. In Article II Section 9 (1), second sentence, the words “Section 35 (3), second sentence” shall be replaced by the words “Section 34 (6), second sentence”.

4. Article III Section 1 shall be amended as follows:

- a) The title shall be worded as follows:

“Section 1

The German Patent and Trade Mark Office as Receiving Office”.

- b) In subsection (1) the words “German Patent Office” shall be replaced by the words “German Patent and Trade Mark Office”.

- c) Subsection 2 shall be worded as follows:

“(2) International applications may be filed in German with the German Patent and Trade Mark Office or, pursuant to section 34 (2) of the Patent Law, through a Patent Information Centre.”

- d) In subsections 3 and 4 the words “German Patent Office” shall be replaced by the words “German Patent and Trade Mark Office”.
5. In Article III Section 2 (2), third sentence, the words “Section 35 (3), first sentence” shall be replaced by the words “Section 34 (6), first sentence”.
6. Article III Section 4 shall be amended as follows:
- a) The title shall be worded as follows:

“Section 4

The German Patent and Trade Mark Office as Designated Office”.
 - b) In subsections (1) and (2) the words “German Patent Office” shall be replaced by the words “German Patent and Trade Mark Office”.
 - c) In subsection 2, first sentence, the words “Section 35 (3)” shall be replaced by the words “Section 34 (6)” and the words “Section 4 (4)” by the words “Section 4 (5)”.
 - d) Subsection (3) shall be worded as follows:

“(3) Where in respect of an international application priority is claimed for an earlier patent or utility model application filed with the German Patent and Trade Mark Office, the latter shall, notwithstanding section 40 (5) of the Patent Law or section 6 (1) of the Utility Model Law, be deemed to have been withdrawn on the date on which the conditions set down in subsection (2) were fulfilled and the time limits set down in Article 22 or 39 (1) of the Patent Cooperation Treaty expired.”
7. Article III Section 5 shall be amended as follows:
- a) In subsection (1), first sentence, the words “Section 35 (3)” shall be replaced by the words “Section 34 (6)”.
 - b) In subsection (1) the words “German Patent Office” shall be replaced by the words “German Patent and Trade Mark Office”.

Amendment of the Extension Law

(424-3-8)

Part 3 of the Law on the Extension of Industrial Property Rights of 23 April 1992 (Federal Law Gazette I p. 938), last amended by Article 2 section 18 of the Law of 22 December 1997 (Federal Law Gazette I p. 3224), shall be repealed.

Article 11

Amendment of the Semiconductor Protection Law

(426-1)

Section 3 of the Semiconductor Protection Law of 22 October 1987 (Federal Law Gazette I p. 2294), last amended by Article 6 of the Law of 7 March 1990 (Federal Law Gazette I p. 422), shall be amended as follows:

- a) In subsection (1), first sentence, the words "in writing" shall be deleted.
- b) Subsection (3) shall be worded as follows:

“(3) The Federal Ministry of Justice shall have the power to issue by statutory order regulations concerning the form and other requirements for the application. It may delegate such power by statutory order to the President of the Patent Office.”

Article 12

Amendment of the Law on Copyright and Related Rights

(440-1)

The Law on Copyright and Related Rights of 9 September 1965 (Federal Law Gazette I p. 1273), last amended by Article 1 of the Law of 8 May 1998 (Federal Law Gazette I p. 902), shall be amended as follows:

- 1. In Section 69c, item 3, the words "European Communities" shall be replaced by the words "European Union".

2. In Section 111a subsection (1), second sentence, the words "European Economic Community" shall be replaced by the Words "European Union".

Article 13

Amendment of the Law Concerning Copyright in Industrial Designs (442-1)

The Law Concerning Copyright in Industrial Designs in the revised version published in the Federal Law Gazette Part III No. 422-1, last amended by Article 13 subsection 2 of the Law of 25 October 1994 (Federal Law Gazette I p. 3082) shall be amended as follows:

1. In Section 7 subsection (3), item 1, the word "written" shall be deleted.
2. Section 7b subsection (1) shall be worded as follows:

"(1) An applicant who claims, under an international treaty, the priority of an earlier foreign application for the same design shall, within a period of sixteen months after the priority date, state the date, country and serial number of the earlier application and file a copy of that application, if such action has not already been taken. Particulars may be altered within that period."
3. In Section 10 subsection (5) the words "Sections 123 (1) to (5)" shall be replaced by the words "Sections 123 (1) to (5) and (7)".
4. In Section 10a subsection (1), fourth sentence, and subsection (2), second sentence, the words "123 (1) to (5)" shall be replaced by the words "123 (1) to (5) and (7)".
5. In Section 10b, third sentence, the words "129, second sentence" shall be deleted.
6. In Section 12 subsection (1), first sentence, the words "The Federal Minister of Justice" and "the requirements for applications for designs" shall be replaced

respectively by the words "The Federal Ministry of Justice" and "the form and other requirements for applications for designs".

7. In Section 12 subsection (1), second sentence, the word "He" shall be replaced by the word "It".
8. In Section 12 subsection (2) and in Section 12a subsections (1) and (2) the words "The Federal Minister of Justice" shall be replaced by the words "The Federal Ministry of Justice".
9. Section 12a shall be amended as follows:
 - a) Subsection (1), first sentence, shall be worded as follows:

"The Federal Ministry of Justice shall have the power to entrust, by statutory order, officials of the higher intermediate and lower intermediate grades as well as employees in comparable positions with the handling of matters in proceedings concerning the Designs Register where these matters involve no particular legal difficulties."
 - b) In subsection (2) the words "The Federal Minister of Justice" shall be replaced by the words "The Federal Ministry of Justice".

Article 20

Amendment of the Order Concerning Patent Applications

(420-1-6)

The Order Concerning Patent Applications of 29 May 1981 (Federal Law Gazette I p. 521), last amended by the Order of 27 June 1997 (Federal Law Gazette I p. 1595, 2017) shall be amended as follows:

1. In Section 2 the words "Sec. 35 (1)" shall be replaced by the words "Sec. 34 (1) and (3)" and the words "and in the German language" shall be deleted.
2. In Section 3 subsection (1) the words "Sec. 35 (1) sentence 3, No 1" shall be replaced by the words "Sec. 34 (3) No 2".

3. Section 4 shall be amended as follows:
 - a) In subsection (1), first sentence, the words "Sec. 35 (1) sentence 3, No 2" shall be replaced by the words "Sec. 34 (3) No 3".
 - b) In subsection (5) the words "Sec. 35 (1) sentence 2" shall be replaced by the words "Sec. 34 (5)".
4. In Section 5 subsection (1) the words "Sec. 35 (1) sentence 3 No 3" shall be replaced by the words "Sec. 34 (3) No 4".
5. Section 10 shall be worded as follows:

"Section 10

Translations

(1) A translation of a document forming part of the documentation relating to the application must be certified by a practising lawyer or patent attorney or be done by an officially authorised translator. The translator's signature shall be officially certified (Article 129 of the Civil Code) and so must the fact that he is officially authorised for such purposes.

(2) If a document not forming part of the documentation relating to the application is not filed in English, French, Italian or Spanish, a translation certified by a practising lawyer or patent attorney or done by an officially authorised translator shall be filed within one month of receipt of the document. If the translation is not filed within this time limit, the document shall be deemed to have been received on the date of receipt of the translation.

(3) If a document not forming part of the documentation relating to the application is filed in English, French, Italian or Spanish, the Patent Office may require a translation certified by a practising lawyer or patent attorney or done by an officially authorised translator to be filed within a time limit set by that Office. If the translation is not filed within this time limit, the document shall be deemed to have been received on the date of receipt of the translation.

(4) Where, in the case of priority documents submitted under the revised Paris Convention for the Protection of Industrial Property or of copies of earlier applications (Sec. 41 (1) sentence 1 of the Patent Law) a German translation is required, such translation shall be furnished if so demanded by the Patent Office.

6. In Section 11 subsection (1), second sentence, the words "Sec. 10 (1)" shall be replaced by the words "Sec. 10 (1) to (3)".

Article 22

Amendment of the Order Concerning Utility Model Applications (421-1-3)

The Order Concerning Utility Model Applications of 12 November 1986 (Federal Law Gazette I p. 1739), last amended by the Order of 27 June 1997 (Federal Law Gazette I p. 1597) shall be amended as follows:

1. In Section 2 subsection (1) the words "(Sec. 1 (1) UML)" shall be replaced by the words "(Sec. 1 (1) Utility Model Law)" and the words "(Sec. 4 (1) sentence 1) shall be deleted.
2. In Section 2 subsection (2) the word "UML" shall be replaced by the words "Utility Model Law".
3. Section 2 subsection (3) shall be worded as follows:

"(3) The application shall contain the following application documentation (Sec. 4 (3) nos 1-5 Utility Model Law):

 1. the name of the applicant,
 2. the request,
 3. one or more claims,
 4. the description,
 5. the drawings to which the claims or the description refer."
4. In Section 4 subsection (1) the words "(Sec. 4 (2) no 1 UML)" shall be replaced by the words "(Sec. 4 (3) no 2 Utility Model Law)".
5. In Section 4 subsection (2), item 7, the words "(Sec. 4 (6) ULM)" shall be replaced by the words "(Sec. 4 (7) Utility Model Law)".

6. In Section 4 subsection (2), item 8, the words "ULM" shall be replaced by the words "Utility Model Law".
7. In Section 5 subsection (1), first sentence, the words "(Sec. 4 (2) no 2 ULM)" shall be replaced by the words "(Sec. 4 (3) no 3 Utility Model Law)".
8. In Section 5 subsection (5), first sentence, the word "ULM" shall be replaced by the words "Utility Model Law".
9. In Section 6 subsection (1) the words "(Sec. 4 (2) no 3 ULM)" shall be replaced by the words "(Sec. 4 (3) no 4 Utility Model Law)".
10. In Section 8 the word "ULM" shall be replaced by the words "Utility Model Law" and in subsection (3), second sentence, the words "Sec. 9 (1)" shall be replaced by the words "Sec. 9 subsections (1) to (3)".
11. Section 9 shall be amended as follows:

"Section 9

Translations

(1) A translation of a document forming part of the documentation relating to the application must be certified by a practising lawyer or patent attorney or be done by an officially authorised translator. The translator's signature shall be officially certified (Article 129 of the Civil Code) and so must the fact that he is officially authorised for such purposes.

(2) If a document not forming part of the documentation relating to the application is not filed in English, French, Italian or Spanish, a translation certified by a practising lawyer or patent attorney or done by an officially authorised translator shall be filed within one month of receipt of the document. If the translation is not filed within this time limit, the document shall be deemed to have been received on the date of receipt of the translation.

(3) If a document not forming part of the documentation relating to the application is filed in English, French, Italian or Spanish, the Patent Office may require a translation certified by a practising lawyer or patent attorney or done by an officially authorised translator to be filed within a time limit set by that

Office. If the translation is not filed within this time limit, the document shall be deemed to have been received on the date of receipt of the translation.

(4) Where, in the case of priority documents submitted under the revised Paris Convention for the Protection of Industrial Property or of copies of earlier applications (Sec. 6 (2) Utility Model Law, Sec. 41 (1) sentence 1 Patent Law) a German translation is required, such translation shall be furnished if so demanded by the Patent Office.

Article 24

Amendment of the Regulation on Semiconductor Protection Applications (426-1-1)

In Section 2 of the Regulations on Semiconductor Protection Applications of 4 November 1987 (Federal Law Gazette I p. 2361), the word "written" shall be inserted before the word "application".

Article 25

Amendment of the Order Concerning Industrial Designs and Type Faces Applications (442-1-3)

In Section 2 of the Order Concerning Industrial Designs and Type Faces Applications of 8 January 1988 (Federal Law Gazette I p. 76), last amended by the Order of 13 August 1993 (Federal Law Gazette I p. 1506), the word "written" shall be inserted before the word "application".

Article 28

Return to uniformity of level of legal source

The parts of the amended statutory orders based on Articles 19 to 25 may be amended by statutory order by virtue of the applicable authorisation in each case.

Article 29
Transitional Provisions

Sections 110 to 122 of the Patent Law shall apply in their previous version if appellate remedies were sought in proceedings pursuant to the Patent Law and the Utility Model Law before this Law enters into force.

Article 30
Entry into Force

- (1) Article 7 shall enter into force on 1 January 2000.
 - (2) This Law shall otherwise enter into force on 1 November 1998.
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The constitutional rights of the Federal Council have been heeded.
The above Law is hereby executed and promulgated in the Federal Law Gazette.

Berlin, 16 July 1998

The Federal President
Roman Herzog

The Federal Chancellor
Dr. Helmut Kohl

The Federal Minister of Justice
Schmidt-Jortzig
