

## WIPO Circular C.9141

### Contribution of Germany to a draft reference document on the exception regarding the use of articles on foreign vessels, aircrafts and land vehicles<sup>2</sup>

#### A. General Remarks

In German Patent law, exceptions and limitations regarding the use of articles on foreign vessels, aircrafts and land vehicles are **laid down in Section 11 No. 4, 5 and 6 of the German Patent Act**. The purpose of these provisions is to **protect and facilitate international trade**,<sup>1</sup> which would be hampered if the use of articles on foreign vessels, aircrafts and land vehicles that pass through the territories of several states were prohibited under the patent laws of these states. The respective provisions thus implement a balancing of interests between the interests of domestic patent holders and national patent protection systems on the one hand, and the interest in functioning international trade on the other hand.<sup>2</sup>

Section 11 No. 4 and 5 German Patent Act are largely based on the wording of Art.5ter of the Paris Convention on the Protection of Industrial Property. Section 11 No. 6 German Patent Act, which relates to the use of articles in the course of civil aviation, was introduced following the adoption of the Convention on International Civil Aviation of 7 December 1944. The regulatory approach of formulating No. 4 and 5 in correspondence to Art. 5ter Paris Convention was adopted in 1981.<sup>3</sup> **Before, German law had contained a teleologically corresponding provision with a different, more open-ended wording**,<sup>4</sup> which encompassed all kinds of vessels, aircrafts and land vehicles under the single German term "Fahrzeuge" ("means of transport" in a wide sense) and established that the effect of a patent shall not extend to features ("Einrichtungen") on such means of transport when they enter national territory only temporarily. This general clause was first enacted in 1877 as Section 5 para 3,<sup>5</sup> and in 1968 transposed into Section 7 para 4, with just a minor editorial edit.<sup>6</sup>

The **practical relevance of these provisions in Germany has been rather low**. There are only few court cases which dealt with them.<sup>7</sup> They addressed primarily the conditions for an article

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<sup>1</sup> Cf. Ensthaler, in: BeckOK Patentrecht, 26th edn. 2022, Section 11 para 19.

<sup>2</sup> Cf. Ensthaler, in: BeckOK Patentrecht, 26th edn. 2022, Section 11 para 19; Stauder, Die Freiheit des internationalen Verkehrs im Patentrecht, GRUR 1993, 305.

<sup>3</sup> Stauder, GRUR 1993, 305 (307).

<sup>4</sup> See on the historical developments Stauder, GRUR 1993, 305 (306 et seq).

<sup>5</sup> Section 5 para 3 German Patent Act of 1877: "*Auf Einrichtungen an Fahrzeugen, welche nur vorübergehend in das Inland gelangen, erstreckt sich die Wirkung des Patentbesitzes nicht.*"

<sup>6</sup> Section 7 para 4 German Patent Act of 1968: "*Auf Einrichtungen an Fahrzeugen, die nur vorübergehend in das Inland gelangen, erstreckt sich die Wirkung des Patentbesitzes nicht.*"

<sup>7</sup> These court cases are, in chronological order: Regional Court Hamburg, decision of 11<sup>th</sup> July 1973 - 15 O 473/72 "Rolltrailer", GRUR Int 1973, 703, concerning Section 7 para 4 German Patent Act of 1968; Higher Regional Court Hamburg, decision of 18<sup>th</sup> February 1988 - 3 U 159/87 "Pflanzen-Transportwagen", GRUR Int 1988, 781, concerning Section 7 para 4 German Patent Act of 1968; Higher Regional Court Düsseldorf, decision of 1<sup>st</sup> April 1993 - 2 U 96/92 "Stapelbarer Transportwagen", GRUR 1994, 105, concerning Section 7 para 4 German Patent

to be encompassed by the respective provision, and the conditions for the “temporary” character of it entering the territorial scope of German jurisdiction. Also academic work by German scholars on the matter is rare.<sup>8</sup> It mainly relates to the legal history of the provisions, and to the question whether they might teleologically extend to or be analogized towards encompassing spacecrafts, satellites and other items in outer-space constellations.<sup>9</sup>

#### **B. Section 11 No. 4 German Patent Act (vessels)**

According to Section 11 No. 4 German Patent Act, the effect of a patent shall not extend to the use of the patented invention on board vessels of another State party to the Paris Convention for the Protection of Industrial Property in the body of such vessel, in the machinery, tackle, gear and other accessories, when such vessels temporarily or accidentally enter the waters to which the territorial scope of this Act extends, provided that the patented invention is used there exclusively for the needs of the vessel.<sup>10</sup> The wording of the provision is based on Art. 5ter (i) Paris Convention.

German ships, also in the event they are returning from abroad to German waters, are not encompassed by the provision.<sup>11</sup> The condition for vessels to enter the waters „temporarily“ is only considered fulfilled up to a maximum duration of one year.<sup>12</sup> Only the uses of the patented invention explicitly mentioned in the provision are encompassed, i.e. uses “exclusively for the needs of the vessel”, not other or all kinds of uses.<sup>13</sup>

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Act of 1968; Regional Court Hamburg, decision of 26<sup>th</sup> April 2018 - 327 O 479/16 “Boom Lock”, concerning Section 11 No. 4 German Patent Act as formulated currently; Higher Regional Court Düsseldorf, decision of 14<sup>th</sup> February 2019 – 15 U 60/15, GRUR-RS 2019, 7925, concerning Section 11 No. 4 German Patent Act as formulated currently.  
<sup>8</sup> But see Stauder, GRUR 1993, 305; Stauder, comment on District Court, E.D. New York, 20.04.1974 “Cali”, GRUR Int 1975, 395, analysing international, US, and German law; Spielplan, Die Ausnahme vom Patentschutz gemäß § 5 Abs. 3 des PatG, GRUR 1908, 145, interpreting the old provision Section 5 para 3 German Patent Act of 1877.  
<sup>9</sup> Cf. Stauder, GRUR 1993, 305.

<sup>10</sup> This is the translation available at [https://www.gesetze-im-internet.de/englisch\\_patg/englisch\\_patg.html#p0092](https://www.gesetze-im-internet.de/englisch_patg/englisch_patg.html#p0092), an online service by the German Federal Ministry of Justice. Please note that the translations of German statutes into languages other than German available there are intended solely as a convenience to the non-German-reading public and that any discrepancies or differences that may arise in translations of the official German versions of these materials are not binding and have no legal effect for compliance or enforcement purposes ([https://www.gesetze-im-internet.de/Teilliste\\_translations.html](https://www.gesetze-im-internet.de/Teilliste_translations.html)). The original German wording is: “Die Wirkung des Patents erstreckt sich nicht auf den an Bord von Schiffen eines anderen Mitgliedstaates der Pariser Verbandsübereinkunft zum Schutz des gewerblichen Eigentums stattfindenden Gebrauch des Gegenstands der patentierten Erfindung im Schiffskörper, in den Maschinen, im Takelwerk, an den Geräten und sonstigem Zubehör, wenn die Schiffe vorübergehend oder zufällig in die Gewässer gelangen, auf die sich der Geltungsbereich dieses Gesetzes erstreckt, vorausgesetzt, daß dieser Gegenstand dort ausschließlich für die Bedürfnisse des Schiffes verwendet wird.“

<sup>11</sup> Ensthaler, in: BeckOK Patentrecht, 26<sup>th</sup> edn. 2022, Section 11 para 20; Schulte, Patentgesetz mit EPÜ, 11<sup>th</sup> edition 2022, Section 11 para 23; Higher Regional Court Düsseldorf 2019, para 72.

<sup>12</sup> Ensthaler, in: BeckOK Patentrecht, 26<sup>th</sup> edn. 2022, Section 11 para 20; Keukenschrijver in: Busse/Kreukenschrijver (eds), Patentgesetz, 9<sup>th</sup> edn. 2020, Section 11 para 25; Regional Court Hamburg GRUR-Int 1973, 703 (705) on the old provision Section 7 para 4 German Patent Act of 1968.

<sup>13</sup> Cf. Schulte, Patentgesetz mit EPÜ, 11<sup>th</sup> edition 2022, Section 11 para 23. The old, open-ended provision Section 7 para 4 German Patent Act of 1968 had been interpreted as not limited to acts „typical for transport“, but as extending to all acts of using the invention, cf. Higher Regional Court Düsseldorf GRUR 1994, 105 (106) in a case concerning presentation of items at a fair.

### C. Section 11 No. 5 German Patent Act (aircrafts and land vehicles)

According to Section 11 No. 5 German Patent Act, the effect of a patent shall not extend to the use of the patented invention in the construction or the operation of aircraft or land vehicles of another State party to the Paris Convention for the Protection of Industrial Property or the use of accessories to such aircraft or land vehicles when these temporarily or accidentally enter the territorial scope of this Act.<sup>14</sup> The wording of the provision is based on Art. 5ter (ii) Paris Convention.

Examples of aircrafts and land vehicles that have been assessed by German courts include a “Rolltrailer” (loading rack for container transport, under the old provision Section 7 para 4 German Patent Act of 1968)<sup>15</sup> and a “Pflanzentransportwagen” (transport carriage for plants, under the old provision Section 7 para 4 German Patent Act of 1968)<sup>16</sup>. With regard to the old, open-ended provision Section 7 para 4 German Patent Act of 1968, courts had decided that the means of transport must be capable of and determined for the transport of persons or things,<sup>17</sup> and that it is irrelevant whether it has an engine of its own,<sup>18</sup> whether it is destined for transport beyond borders,<sup>19</sup> and whether it has been brought into the country by different means of transport.<sup>20</sup> Like under No. 4, also under No. 5 the condition „temporarily“ is only considered fulfilled up to a maximum of one year.<sup>21</sup> The mere fact of repetition or regularity is considered not detrimental to fulfilling the condition “temporarily”.<sup>22</sup> Only the uses of the patented invention described in the provision are encompassed, not other or all uses.<sup>23</sup>

### D. Section 11 No. 6 German Patent Act (civil aviation)

According to Section 11 No. 6 German Patent Act, the effect of a patent shall not extend to the acts specified in Article 27 of the Convention on International Civil Aviation of 7 December 1944 where these acts concern the aircraft of another State to which this article shall apply.<sup>24</sup>

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<sup>14</sup> This is the translation available at [https://www.gesetze-im-internet.de/englisch\\_patg/englisch\\_patg.html#p0092](https://www.gesetze-im-internet.de/englisch_patg/englisch_patg.html#p0092). Please note the information on the legal relevance of translations provided already in footnote 10 above. The original German wording is: *“Die Wirkung des Patents erstreckt sich nicht auf den Gebrauch des Gegenstands der patentierten Erfindung in der Bauausführung oder für den Betrieb der Luft- oder Landfahrzeuge eines anderen Mitgliedstaates der Pariser Verbandsübereinkunft zum Schutz des gewerblichen Eigentums oder des Zubehörs solcher Fahrzeuge, wenn diese vorübergehend oder zufällig in den Geltungsbereich dieses Gesetzes gelangen.”*

<sup>15</sup> Regional Court Hamburg GRUR Int 1973, 703.

<sup>16</sup> Higher Regional Court Hamburg GRUR Int 1988, 781.

<sup>17</sup> Higher Regional Court Düsseldorf GRUR 1994, 105 (107).

<sup>18</sup> Higher Regional Court Hamburg GRUR-Int 1988, 781 (782).

<sup>19</sup> Higher Regional Court Düsseldorf GRUR 1994, 105 (107).

<sup>20</sup> Regional Court Hamburg GRUR-Int 1973, 703 (704).

<sup>21</sup> Ensthaler, in: BeckOK Patentrecht, 26th edn. 2022, Section 11 para 20.

<sup>22</sup> Ensthaler, in: BeckOK Patentrecht, 26th edn. 2022, Section 11 para 20 with the argument that international traffic is to be protected and the term traffic implies certain repetitions; on the old provision Section 7 para 4 German Patent Act of 1968 see Regional Court Hamburg GRUR-Int 1973, 703 (704).

<sup>23</sup> Cf. Schulte, Patentgesetz mit EPÜ, 11th edition 2022, Section 11 para 24.

<sup>24</sup> This is the translation available at [https://www.gesetze-im-internet.de/englisch\\_patg/englisch\\_patg.html#p0092](https://www.gesetze-im-internet.de/englisch_patg/englisch_patg.html#p0092). Please note the information on the legal relevance of translations provided already in footnote 10 above. The original German wording is: *“Die Wirkung des Patents*

Art. 27 of that Convention contains an “exemption from seizure on patent claims”. The key distinguishing feature between Section 11 No. 6 and the preceding No. 5 German Patent Act, which also relates to aircrafts, is that the Convention on International Civil Aviation, and correspondingly Section 11 No. 6, only relates to **private** aircrafts,<sup>25</sup> whereas Section 11 No. 5 relates to all kinds of aircrafts.

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*erstreckt sich nicht auf die in Artikel 27 des Abkommens vom 7. Dezember 1944 über die Internationale Zivilluftfahrt (BGBl. 1956 II S. 411) vorgesehenen Handlungen, wenn diese Handlungen ein Luftfahrzeug eines anderen Staates betreffen, auf den dieser Artikel anzuwenden ist.“*

<sup>25</sup> Ensthaler, in: BeckOK Patentrecht, 26th edn. 2022, Section 11 para 21; Keukenschrijver in: Busse/Keukenschrijver (eds), Patentgesetz, 9th edn. 2020, Section 11 para 27.