

WIPO Circular C.9199

Contribution of Germany to a document updating SCP/32/6 (patent law provisions that contribute to effective transfer of technology, including sufficiency of disclosure)

A. Patent Law Provisions with respect to Voluntary Licensing

Pursuant to Section 23 para 1 sentence 1 of the German Patent Act, an applicant can declare the willingness to license. It is a voluntary restriction of one's own right by the patent seeker or patent proprietor, by which the latter declares in writing and unconditionally to the Patent Office that he is willing to allow anyone to use the invention in return for appropriate remuneration. Pursuant to Art. 2 para 2 European Patent Convention (EPC), Section 23 of the German Patent Act is also applicable to European patents designating the Federal Republic of Germany.

According to Section 23 para 1 sentence 1 German Patent Act, the consequence of the declaration of willingness to license is that the annual fees due for the patent are reduced to half of the amount specified in the tariff.

Further, Section 23 para 3 of the German Patent Act states that any person who, subsequent to the declaration being entered, wishes to use the invention is to inform the proprietor of the patent of this intention. The information is deemed to have been effected if it has been dispatched by registered letter to the person entered in the Register as the proprietor of the patent or to his or her registered representative or the person authorised to accept service. The information must indicate how the invention is to be used.

According to Section 23 para 4 German Patent Act, the remuneration is fixed by the Patent Division upon the written request of a party. The request may be directed against more than one party. When fixing the amount of the remuneration, the German Patent and Trade Mark Office may make an order requiring the party opposing the request to bear the costs of the procedure in full or in part. After the expiry of a period of one year following the last fixing of remuneration, any party affected thereby may apply for its adjustment if, in the meantime, circumstances have arisen or become known which make the remuneration fixed appear obviously inappropriate (Section 23, para 5 German Patent Act).

The declaration may be withdrawn in writing vis-à-vis the German Patent and Trade Mark Office at any time, as long as the proprietor of the patent has not yet been informed of any intention to use the invention. The withdrawal takes effect when it is filed. The sum by which the annual renewal fees have been reduced is to be paid within one month following withdrawal of the declaration (Section 23, para. 7 German Patent Act).

The declaration of willingness to license makes it possible to reduce future annual fees by half in the interests of the applicant, which is of particular interest for SMEs. At the same time, the likelihood of the invention being exploited is increased by enabling any third party to use the invention in return for appropriate remuneration, thus promoting technology transfer.

The declaration of willingness to license is to be distinguished from the non-binding declaration of license interest, which merely states that there is an interest in further exploitation by third parties. Although it is published by the DPMA in the register and in the Patent Gazette, it can be withdrawn at any time and has no effect on the amount of the annual fees. It becomes invalid with the submission of a declaration of willingness to license pursuant to Section 23 or the registration of an exclusive license pursuant to Section 30 para 4 of the German Patent Act.

B. Patent Law Provisions with respect to sufficiency of disclosure

Sufficiency of Disclosure is regulated in Section 34 para 3 and 4 of the German Patent Act. The invention shall be disclosed in the patent application. This shall include the request, the description, the claims and the drawings, all parts of the disclosure being equivalent (Section 34 para 3 German Patent Act).

In general, an invention is deemed to be disclosed in a clear and complete manner within the meaning of Section 34 para 4 German Patent Act if the information contained in the patent application provides the reader skilled in the art with so much technical information that he is able to successfully execute the invention in practice using his specialist knowledge and skills, without undue difficulties and without needing inventive skill. Hereby, the average person skilled in the art has to be taken into consideration.