

WIPO Circular C.8893 – Input for the preparation of a document compiling information on patent law provisions and practices that contributed to effective transfer of technology, including sufficiency of disclosure

Numerous German patent law provisions contribute to effective technology transfer:

1. Patent law provisions on providing information to the public about patent applications and patents are of fundamental importance for the effective dissemination of technological knowledge.

a) Pursuant to Section 32(1), first sentence, No. 1, and (2) of the Patent Act (*Patentgesetz*) in conjunction with Section 31(2) of the Patent Act, a patent application shall be published within 18 months after the filing date or the priority date, at the latest, within the framework of the first publication of the patent application (*Offenlegungsschrift*) unless, in an exceptional case, the invention is an invention that must be kept secret within the meaning of Sections 31(5), 50 of the Patent Act. The *Offenlegungsschrift* contains, inter alia, the patent claims contained in the patent application, the description of the invention and the drawings referred to in the patent claims or the description. The purpose of the publication of the *Offenlegungsschrift* is to enable the general public to obtain early information on potential future IP rights. The DPMA publishes a reference concerning the option of file inspection in the Patent Gazette (Sec. 35(5) Patent Act). From this date at the latest, as a rule, the case file relating to the patent application will be available for inspection by any person, provided that it is not precluded by a legal provision or that no interest meriting protection of the data subject within the meaning of Article 4 No. 1 of the General Data Protection Regulation obviously prevails (Sec. 31(2) and (3b) Patent Act).

Upon grant of the patent, a patent specification (*Patentschrift*) shall also be published (Secs. 32(1), first sentence, No. 2 and (3), 58(1) Patent Act) which contains the patent claims, the description and the drawings, among other things, based on which the patent was granted. In addition, the patent specification specifies the state of the art which the DPMA has taken into consideration for assessing the patentability of the invention applied for.

All essential information on published patent applications and granted patents is entered in a Register maintained by the DPMA, pursuant to Sec. 30 of the Patent Act. In particular, the Register contains bibliographical information and legal and procedural status data on published patent applications and patents. Pursuant to Section 31(1), second sentence, of the Patent Act, any person may inspect the Register.

Overviews regularly appearing in the Patent Gazette (*Patentblatt*) (Secs. 32(1), first sentence, No. 3 and (5), 58(1) Patent Act) provide information on the Register entries.

Pursuant to Section 32(1), second sentence, of the Patent Act, the *Offenlegungsschriften* and the patent specifications (*Patentschriften*) as well as the Patent Gazette may also be published in electronic form.

Pursuant to Section 32(1), third and fourth sentences, of the Patent Act, the information published in the publications of the DPMA may also be transmitted to third parties in electronic form for further processing and use for the purposes of patent information.

b) The DPMA fulfils its legal duties to inform the public about patent applications and patents through publication and search services available on the Internet.

DPMAregister, the DPMA's free publication and register database, provides online access to the register data with current legal and procedural status information on patent applications

and patents and makes the official publications (*Offenlegungsschrift*, patent specification (*Patentschrift*) and Patent Gazette) available. The database offers comprehensive and complex search options and thus contributes substantially to making technical knowledge searchable. In addition to the detailed description of the inventions by linking the *Offenlegungsschriften* and patent specifications (*Patentschriften*), the database also contains information on the scope and validity of patent rights as well as bibliographical data of the inventor, patent applicants and patent proprietors. Thus, the database not only makes detailed technological knowledge available to others, but also provides the opportunity to identify to what extent technological knowledge may be freely used or from whom it may possibly be acquired through licensing agreements or the transfer of rights.

In addition, *Offenlegungsschriften* and patent specifications (*Patentschriften*) – together with other patent publications from all over the world – are made available in the free DEPATISnet database. The database offers an extensive source of technological knowledge. The database makes an essential contribution to the dissemination of technological knowledge, in particular through the detailed search options within the extensive data records.

Via the data supply services of the DPMA (DPMA Datenabgabe, DPMAconnect, DEPATISconnect), the DPMA, as far as possible, also transmits the information published in the publications of the DPMA to third parties who may use it to establish, develop and update their own IP databases and other information systems and services. By supplying data for integration into third-party systems and services, the DPMA simplifies and supports the dissemination and use of German IP information and technological knowledge.

2. The requirements for disclosure of the invention also contribute to effective technology transfer. Pursuant to Section 34(4) of the Patent Act, the invention must be disclosed in the application in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

An invention is disclosed in a workable manner when the information comprised in the patent application conveys to the skilled reader so much technical information that with his technical knowledge and skills he is able to successfully carry out the invention (*Bundesgerichtshof*, judgment of 13 July 2010, ref: Xa ZR 126/07, GRUR 2010, 916, *Klammernahtgerät/stapler*). The requirement of clear and complete disclosure does not require the description to contain information on how to achieve all conceivable variants covered by the functional definition. It is sufficient if it provides at least one way of carrying it out to the skilled person. (*Bundesgerichtshof*, judgment of 16 June 2015, ref: X ZR 67/13, *Patentfähigkeit eines Übertragungspapiers für Tintenstahldrucker/Patentability of a transfer paper for inkjet printer*). On the basis of the application, without any inventive effort of his own, the skilled person must be able to complete missing elements and, if need be, obtain clarity by means of orientation tests. (*Bundesgerichtshof*, judgment of 13 July 2010, ref: Xa ZR 126/07, GRUR 2010, 916, *Klammernahtgerät/stapler*).

3. The patent law provisions on the transferability and licensing of patent rights also contribute to promoting technology transfer.

Section 15(1), second sentence, of the Patent Act clarifies that the right to the patent, the entitlement to the grant of the patent and the right deriving from the patent may be transferred to others, with or without limitation. Section 15(2), first sentence, of the Patent Act adds that these rights can, in full or in part, be the subject of exclusive or non-exclusive licences.

Patent proprietors who are interested in the exploitation of their inventions and the transfer of the knowledge contained therein can express their willingness to technology transfer by submitting a declaration of their willingness to grant a licence or a declaration of being interested in licensing.

Section 23 of the Patent Act provides for the option of making a declaration of willingness to grant a licence vis-à-vis the DPMA. This declaration constitutes a binding offer to allow anyone to use the invention in return for equitable remuneration. In order to inform the public on the patent proprietor's willingness to grant a licence, the binding declaration on the willingness to grant a licence is recorded in the Register and published in the Patent Gazette (Sec. 23(1), second sentence, Patent Act). This encourages the potential exploitation of patent rights and thus a possible technology transfer. As an incentive for making a declaration of willingness to grant a licence, Section 23(1), first sentence, of the Patent Act provides for a reduction by half of the annual fees which become due after receipt of the declaration.

In addition, the proprietor can make a non-binding declaration of being interested in licensing. By making a declaration of being interested in licensing, the patent proprietor shows that he is interested in licensing the invention. However, it does not constitute an obligation on the patent proprietor to license the invention, but is merely intended to inform potential licensees. In the case that the patent is granted, the declaration is recorded in the Patent Register and published in the Patent Gazette. It can be revoked any time and does not affect the amount of the annual fees.

4. In addition to the patent law provisions mentioned above, which contribute to effective technology transfer, the DPMA provides a wide range of information on its website for users of the patent system and the interested public.

The website of the DPMA contains information on, for example:

- cooperation with patent information centres (https://www.dpma.de/english/our_office/about_us/cooperation/patent_information_centres/index.html)
- cooperation with the Chamber of Patent Attorneys (https://www.dpma.de/english/services/customer_care_services/consultation_inventors/index.html) and
- special information for SMEs, also containing information on advice, support and funding opportunities (https://www.dpma.de/english/services/sme/where_can_i_find_information/index.html).