



# J. Inventors' Rights in a Nutshell

Vorlesung Grundlagen des privaten Wirtschaftsrechts

-

Grundbegriffe des Wettbewerbsrechts

Sommersemester 2024



## Terminology

1. Right in an invention ... („Erfinderrecht“)
2. ... and inventors' rights („Erfinderrechte“)



## Terminology

1. Right in an invention ... („Erfinderrecht“)
2. ... and **inventors' rights** („Erfinderrechte“)



## Fundamental problem

### Distinction between

- Property in tangible objects, e.g. table
- Intellectual property, e.g. a specific technology of producing a table in a particular way providing for extra stability



## Principle

1. Freedom to operate/imitate derived from general freedom to act
2. In correspondence with general reservation to legislate freedom to imitate may be restricted by laws, but
  - Limited number („*numerus clausus*“) of IP rights, e.g. patent, utility model, design, copyright
  - P! complimentary protection of industrial performance by means of Unfair Competition law
  - „Workaround theory“ („Umwegtheorie“)?



# Patent

1. Protection based on Patent Act
  - a) Requirements
    - (1) Inventions, sec. 1 Patent Act
      - i. novel,
      - ii. based on inventive activity
      - iii. susceptible to commercial application
    - (2) 20 years protection from time of filing of an application, sec. 16 Patent Act,  
+ supplementary protection certificates for pharmaceuticals, sec. 16a Patent Act



# Patent

1. Protection based on Patent Act
  - a) Requirements
  - b) Types of patents
    - (1) Product patents, sec. 9 no. 1 Patent Act
    - (2) Process patents, sec. 9 no. 2 Patent Actbut: no protection of business methods in Germany and under EPA



# Patent

1. Protection based on Patent Act
  - a) Requirements
  - b) Types of patents
  - c) Granting of patents
    - (1) By German Patent Office
    - (2) Application for the grant of a patent, sec. 34 Patent Act
      - Securing priority, sec. 40 Patent Act
    - (3) Request for examination, sec. 44 Patent Act
    - (4) Substantive examination
      - i. Granting of patent or
      - ii. Rejection of application, sec. 48 Patent Act
    - (5) Appeal, secs. 73 ff. Patent Act
    - (6) Publication in the Patent Gazette, sec. 58 Patent Act





# Patent

## 1. Protection based on Patent Act

- a) Requirements
- b) Types of patents
- c) Granting of patents
- d) Private enforcement

(1) Actions for infringement, sec. 139 Patent Act



# Patent

1. Protection based on Patent Act
  - a) Requirements
  - b) Types of patents
  - c) Granting of patents
  - d) Private enforcement
    - (1) Actions for infringement, sec. 139 Patent Act
    - (2) Infringer's defences
      - i. Nullity of the patent?



# Patent

## 1. Protection based on Patent Act

- a) Requirements
- b) Types of patents
- c) Granting of patents
- d) Private enforcement

(1) Actions for infringement, sec. 139 Patent Act

(2) Infringer's defences

i. Nullity of the patent?

- No! Independent action for nullity necessary,  
secs. 81, 22 para. 1 Patent Act



# Patent

1. Protection based on Patent Act
  - a) Requirements
  - b) Types of patents
  - c) Granting of patents
  - d) Private enforcement
  - e) Transfer and license of patent, sec. 15 Patent Act



## Patent

1. Protection based on European Patent Convention
2. “European Patent” granted by European Patent Office in Munich
  - a) Not supranational, but international!
  - b) Single procedure to obtain protection, but “bundle” of national patents
  - c) Central challenge possible



## Patent

1. Protection based on European Patent Convention
2. “European Patent” granted by European Patent Office in Munich
3. “Unitary Patent”
  - a) Prior failure to create supranational “Community Patent”!
  - b) Final solution: European Patent with unitary effect (“Unitary Patent”), based on UPC agreement entered into force on June 1<sup>st</sup>, 2023
  - c) 17 Member States
  - d) Special courts



## Utility Models

1. Protection based on Utility Models Act (GebrMG)
2. Requirements: Inventions
  - a) novel
  - b) Inventive step
  - c) Susceptible to commercial application
3. 10 years protection, sec. 23 para. 1 Utility Models Act
4. Easier to get than patent:
  - a) No universal novelty
  - b) No substantive examination
  - Quicker and cheaper!



# Semiconductors

1. Protection based on Semiconductor Protection Act (1987)
2. Requirements:
  - a) Protection of topographies = three-dimensional structures of microelectronic semiconductor products, e.g. computer chips
  - b) Geometric layout critical
  - c) Application at the Patent Office, but for the roll of topographies
  - d) Identification or depiction of topography e.g. by drawings, photographs
  - e) No substantive examination
  - f) 10 years protection, sec. 5 para. 2 Semiconductor Protection Act





# Plant Varieties

1. Protection based on Plant Variety Protection Act (1985)
  - a) Requirements
    - (1) Plant varieties that are
      - i. novel,
      - ii. distinguishable,
      - iii. homogeneous,
      - iv. consistent and
      - v. identified by a registrable designation of variety
    - (2) Application at the Federal Office of Plant Varieties (Bundessortenamt; BSA) in Hannover
  - b) Only the holder of the plant variety right is entitled to market material for reproduction (plants, parts of plants, seeds) for commercial purposes
  - c) Protection for 25 resp. 30 years for hops, potatoes, vine and specific trees, sec. 13 Plant Variety Protection Act



## Plant Varieties

1. Protection based on Plant Variety Protection Act (1985)
2. Protection based on Community Plant Variety Regulation No. 2100/1994
  - a) Supranational IP right
  - b) Community Plant Variety Protection Office based in Angers/F



# Design

1. Protection based on Design Act (2004)
  - a) Object of protection
  - b) Requirements
    - (1) Two- or three-dimensional external appearance of an entire product or a part of it, in particular as a consequence of lines, contours, colours, shape, superficial structure or material of the product or its adornments
    - (2) novel
    - (3) original
    - (4) (not technically required)



# J. Inventors' Rights

## VIII.Design

### 1. Protection based on Design Act (2004)

#### a) Object of protection

Volvo 140:



Volvo 240:





## J. Inventors' Rights

### VIII. Design

#### 1. Protection based on Design Act (2004)

##### a) Object of protection

##### (1) Sec. 4 Design Act

A design which is applied to or incorporated in a product which constitutes a component part of a complex product shall be deemed to be new and shall have individual character only if the component part, once it has been incorporated in such a complex product, remains visible during its normal use and these visible features of the component part in themselves fulfil the requirements as to novelty and individual character.



## J. Inventors' Rights

### VIII. Design

#### 1. Protection based on Design Act (2004)

##### a) Object of protection

##### (1) Sec. 4 Design Act

- i. Monopolization of visible spare parts possible via Design law
- ii. Exception only for „must-fit“ parts, sec. 3 para. 1 no. 2 Design Act

##### (2) No exception for „must-match“ parts (left open in Art. 14 Design Directive), but „repair clause“ in sec. 40a Design Act since 2021



## Design

1. Protection based on Design Act (2004)
  - a) Object of protection
  - b) Requirements
  - c) Protection of design
    - (1) Registration at Patent Office
    - (2) Protection for 25 years
  - d) Private enforcement, secs. 38 ff. Design Act



## Community Design

1. Protection based on Design Act (2004)
2. Protection based on Community Design Regulation
  - a) registered (max. 25 years)
  - b) or based on use (3 years)
  - c) No protection of „must-match“ parts, consid. 13, Art. 8 Design Reg.





# Copyright

## 1. Protection of

a) creative work

b) Adaptations and related rights

**Ex.:** A piece of music is composed by A and made known to the public by singer B. Many years later it is newly arranged and presented by another musician C. It is then presented in a TV show organized by D and transmitted by the broadcaster E. X rips and records that transmission and markets the data as mp4 files through eBay.



# Copyright

1. Protection of creative work
2. Legal consequences of copyright
  - Moral rights of authors, secs. 12 ff. Copyright Act
    - Publication
    - Recognition of authorship
    - Action against distortion of the work



# Copyright

1. Protection of creative work
2. Legal consequences of copyright
  - Moral rights of authors, secs. 12 ff. Copyright Act
  - Exploitation rights, secs. 15 ff. Copyright Act
    - Reproduction
    - Distribution
    - Exhibition
    - Recitation, performance, presentation
    - Making available for the public
    - **broadcasting**



# Copyright

1. Protection of creative work
2. Legal consequences of copyright
  - Moral rights of authors, secs. 12 ff. Copyright Act
  - Exploitation rights, secs. 15 ff. Copyright Act
3. Limitations, secs. 44a ff. Copyright Act
  - Private use, sec. 53 Copyright Act
  - Quotations, sec. 51 Copyright Act
  - Reporting on current events, sec. 50 Copyright Act
  - Use for teaching, science etc., sec. 60a ff.



# Copyright

1. Protection of creative work
2. Legal consequences of copyright
3. Limitations
4. Private enforcement, secs. 97 ff. Copyright Act
5. Computer programmes, secs. 69a ff. Copyright Act
6. Related (neighbouring) rights, secs. 70 ff.  
Copyright Act, e.g.
  - Photographs
  - Performing artists
  - Producer of music records
  - Radio transmitters

