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## Claiming for damages after transfer of a patent – New Approach of the Duesseldorf Appeal Court

Thomas Musmann (Rospatt Osten Pross) · Tuesday, August 3rd, 2010

The holder of a patent is entitled to damages caused by unlawful usage of the patent's teaching. But what to do if the patent is transferred while the patent is being infringed? Who can claim damages for whose damage then?

In principle, the transfer of the patent is not subject to the registration of the new patent owner. However, according to sec. 30 para 3 sentence 2 of the German Patent Act (GPA) the former patent holder is deemed to be duly authorised for administrative purposes until the new owner is registered. Hence, there is a period where the (contentwise) patent owner is not the (formwise) registered patent holder. Dogmatically only the legal patent owner may be damaged by infringement. However, the question whether the plaintiff was still or has already been the legal owner of the patent for the time of the infringing actions can be a tricky one. During infringement proceedings this can require extensive examinations and lead to a delay of the court's decision.

Putting aside dogmatic concerns for the benefit of practicability, the Duesseldorf Court of Appeal has identified a path to circumvent these problems (court order of 25 February 2010 – ref. I 2 U 87/04). The court perceives sec. 30 para 3 sentence 2 GPA as an “irrebuttable presumption”: damages caused by patent infringement shall always occur at the registered patent holder at the time. This presumption shall even stay valid once the new patent owner has been registered.

The consequences of this approach are:

- the former patent holder can claim damages which have occurred not at himself but at the person of the new patent owner
- the new patent owner can only claim damages for infringing actions undertaken after his registration
- the infringer may be sued by two affected persons, the former and the new patent holder, if he infringed the patent both before and after the change of registration

The results of this new legal practice are as follows:

Firstly, the Düsseldorf court secures a fast realisation of compensation for damages. The court relies on the old and new patent holder to balance the discrepancy between formwise and contentwise damages among themselves. Patent infringement proceedings in Düsseldorf have thereby gained even more efficiency. However, the decision discussed could not be appealed. One

has to see if other courts, especially the Federal Supreme Court, will follow this route.

Secondly, whoever acquires a patent should urge for a swift change of registration. The agreement to transfer a patent should rule who is entitled to damages and who has to enforce any claims for damages if infringing actions occur between the transfer of the patent and the change of registration.

Stephan von Petersdorff-Campen

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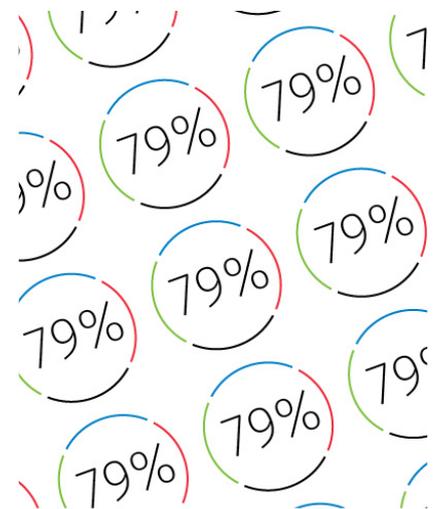
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