
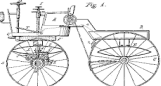


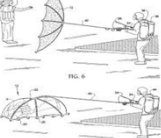


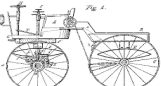


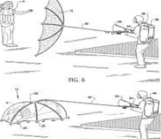


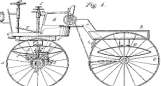


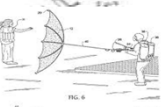


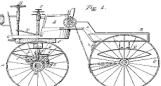


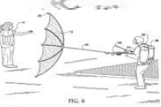
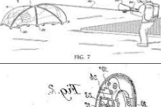

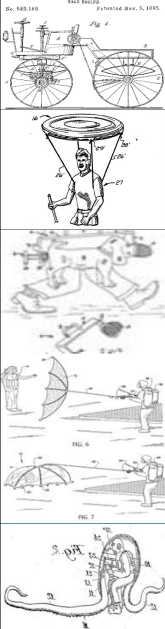



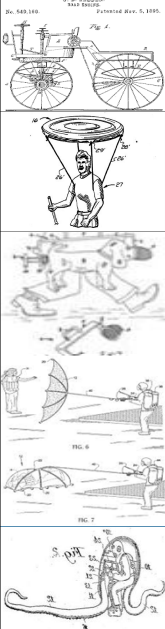
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|  <p>U. B. FRIEDEN DEUTSCHES PATENT PATENTIERUNG AM 12. 11. 1905.</p>      | <h2 style="text-align: center;">Burden of Proof and Taking of Evidence in IP Proceedings</h2> <p style="text-align: center;">Beate Schmidt President of the German Patent Court</p> <p style="text-align: center;">EU-China Judicial Forum Shanghai, 17 and 18 March 2016</p> |
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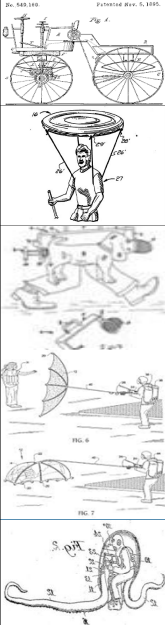
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|  <p>U. B. FRIEDEN DEUTSCHES PATENT PATENTIERUNG AM 12. 11. 1905.</p>      | <h2 style="text-align: center;">Principle of Party Disposition</h2> <h3 style="text-align: center;">Section 138 Law of Civil Procedure</h3> <p>obligation of the parties to make declarations as to the facts and to tell the truth</p> <p>each party is to react in substance to the facts alleged by the opponent</p> <p>facts that are not expressly disputed are to be deemed as having been acknowledged</p> |
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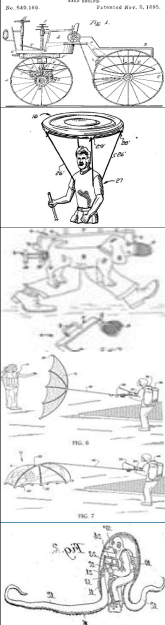
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|  <p>U. B. FRIEDEN Mitar. Pat. Anw. No. 543 510 Patented Nov. 5, 1920.</p>      | <h2 style="text-align: center;">Section 139 Law of Civil Procedure Section 83 Patent Law</h2> <h3 style="text-align: center;">Direction in substance of the course of proceedings</h3> <ul style="list-style-type: none"> • circumstances and facts • legal ramifications • necessary amendments by further information • indication of significant and essential aspects • designation of evidence, • filing of the relevant petitions or auxiliary requests |
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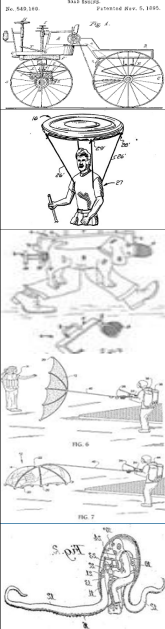
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|  <p>U. B. FRIEDEN Mitar. Pat. Anw. No. 543 510 Patented Nov. 5, 1920.</p>      | <h2 style="text-align: center;">Ex Officio Examination in Patent Nullity Proceedings</h2> <h3 style="text-align: center;">Section 87 Patent Law</h3> <p>(1) The Federal Patent Court shall examine the facts ex officio. It shall not be bound by the pleadings and the motions to take evidence filed by the parties.</p> <p>(2) Before the oral proceedings the presiding judge shall issue all orders which are necessary to dispose of the matter in oral proceedings or in one session if at all possible</p> |
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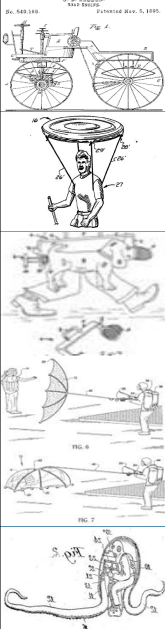
|  BUNDES PATENT GERICHT | Burden of Proof – General Principle |
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|  | <p>„iura novit curia“ – the judge knows the law</p> <p>however, necessary facts to know the law are to be provided by the parties</p> <p>a party bears the burden of proof for those facts, which are beneficiary for it and which it wants to rely on for ist petitions</p> |


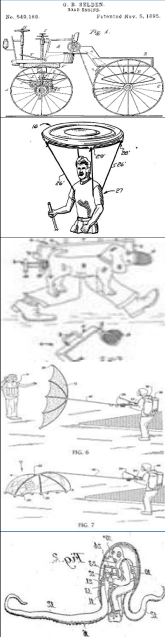
|  BUNDES PATENT GERICHT | Burden of Proof – General Principle |
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|  | <p>the claimant has to provide evidence for the facts that justify its petition</p> <p>the defendant has to provide evidence for the facts that justify a refusal of the claimants petition</p> |


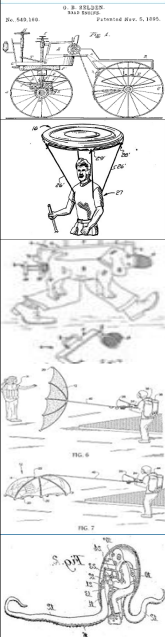
|  BUNDES PATENT GERICHT | Burden of Proof – Example Patent Infringement |
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|  | <p>by the claimant for</p> <ul style="list-style-type: none"> • his ownership of the patent • facts concerning the scope of protection • liability of the defendant for the infringement • amount of damages • etc |


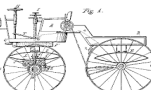


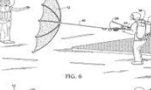
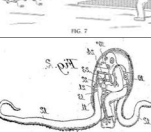
|  BUNDES PATENT GERICHT | Burden of Proof – Example Patent Infringement |
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|  | <p>by the defendant</p> <ul style="list-style-type: none"> • right based on prior use • valid licence to use • no infringement • nullity of the patent (not in case of bifurcation!) • etc |


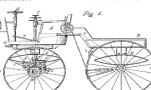


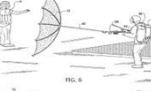

|  BUNDES PATENT GERICHT | Burden of Proof – Example Trade Mark |
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|  | <p>by the claimant:</p> <ul style="list-style-type: none"> • use of the trade mark by the defendant in trade • enhanced distinctiveness • facts on similarity of goods and services • well-known mark • etc |


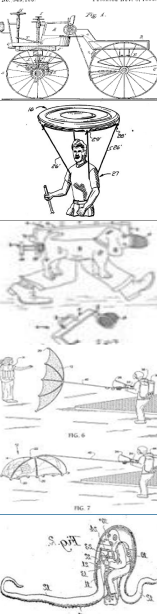
|  BUNDES PATENT GERICHT | Burden of Proof – Example Trade Mark |
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|  | <p>by the defendant:</p> <ul style="list-style-type: none"> • refute the assumption that the claimant is the owner • exception of private use • right to use by license • exhaustion of rights • etc |


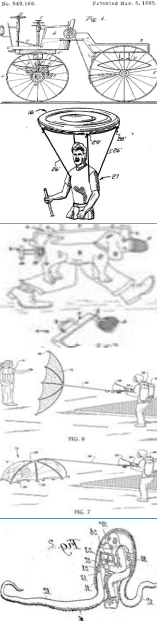
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|  | <h2 style="text-align: right;">Legal Presumptions</h2> |
|  | <p>should the law make a presumption as to a certain fact being given, its opposite may admissibly be proven unless otherwise provided for by the law. This proof may also be established by petitioning the examination of a party</p> |


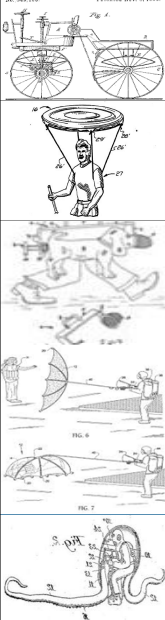
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|  | <h2 style="text-align: right;">Section 293 Foreign law; customary law; statutes</h2> |
|  | <p>The laws applicable in another state, customary laws, and statutes must be proven only insofar as the court is not aware of them. In making inquiries as regards these rules of law, the court is not restricted to the proof produced by the parties in the form of supporting documents; it has the authority to use other sources of reference as well, and to issue the required orders for such use.</p> |


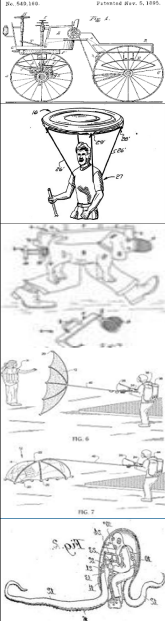
|  BUNDES PATENT GERICHT | Means of Evidence |
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|  | witnesses, expert witnesses (sec. 373; 414) and experts (sec. 402) as well as parties (sec. 445) |
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|  | documents (sec. 415), provided on file by the parties or ordered to be provided by third parties |
|  | inspection on site/ visual inspection (sec. 371) |
|  | |


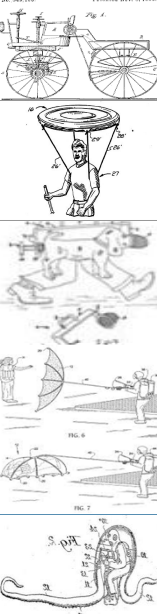
|  BUNDES PATENT GERICHT | Section 88 Patent Law Means of Evidence |
|--|---|
|  | the Federal Patent Court shall take evidence in the oral proceedings. In particular, it may carry out an inspection, hear witnesses, experts and parties, and consult documents |
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|  | however, the court may use any other means it thinks adequate |
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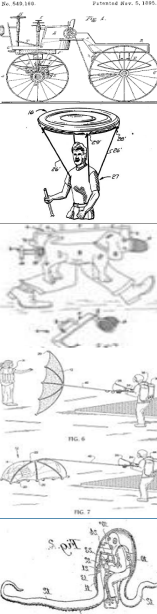
|  BUNDES PATENT GERICHT | Responsability of the Parties |
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|  | <p>claimant has to provide necessary information on relevant facts and offer means of providing evidence</p> <p>defendant may dispute alleged facts and/or offer evidence to proof the contrary</p> <p>defendant has to provide its own information and offer evidence</p> <p>claimant may dispute defendant's arguments and offer counterevidence</p> |


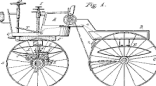


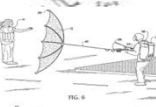


|  BUNDES PATENT GERICHT | Responsability of the Parties |
|--|---|
|  | <ul style="list-style-type: none"> • clear indication of the facts to be proven • clear indication, which facts are to be proven by which means • production of documents or clear indication which documents can be found where, when the claimant is not in possession of the documents documents • name and address of witnesses |


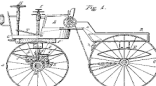


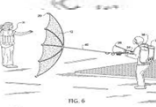

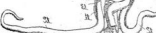
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|  <p>BUNDES PATENT GERICHT</p> | <h2>Section 373,403: Offer to Provide Evidence</h2> |
| <p>U. B. FRIEDEN Mitar. Pat. Nr. 543 510 Patentamt Wien, 9. 1895.</p>  | <p>evidence by hearing witnesses or experts shall be offered by naming the witnesses and designating the facts regarding which the witnesses are to be examined or by designating the items regarding which a report is to be prepared by an expert.</p> |


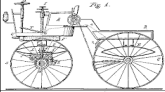

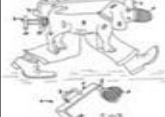
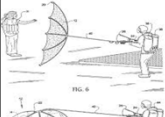


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|  <p>BUNDES PATENT GERICHT</p> | <h2>Sec.420, 421,422 Offer to Provide Evidence</h2> |
| <p>U. B. FRIEDEN Mitar. Pat. Nr. 543 510 Patentamt Wien, 9. 1895.</p>  | <ul style="list-style-type: none"> • producing the document constitutes an offer of evidence • in case a document is in the hands of the opponent, evidence shall be offered by filing a petition that the court direct the opponent to produce said record or document • the opponent is under obligation to produce the record or document |

|  BUNDES PATENT GERICHT | <h2 style="text-align: center; margin: 0;">Reasons to Refuse Taking Evidence</h2> |
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| <p style="font-size: small;">U. B. FRIEDEN Mitar. Pat. Nr. 543 510 Patentabz. Nr. 5, 1925.</p>  | <ul style="list-style-type: none"> • the evidence offered is not relevant for the decision of the case • the evidence offered, if taken, will not prove the alleged facts • the facts are already clear and there is no need for further evidence • the taking of the evidence would be unlawful • the offered means for taking evidence are not available or not sufficiently and precisely described |

|  BUNDES PATENT GERICHT | <h2 style="text-align: center; margin: 0;">Section 359: Order for Evidence</h2> |
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| <p style="font-size: small;">U. B. FRIEDEN Mitar. Pat. Nr. 543 510 Patentabz. Nr. 5, 1925.</p>  | <p>The order for evidence to be taken shall:</p> <ul style="list-style-type: none"> • designate the facts at issue, regarding which evidence is to be taken; • designate the evidence, naming the witnesses and experts to be examined or the party to be examined; • designate the party that has taken recourse to the evidence |

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|  <p>U. B. FRIEDEN Mitarbeiter Patentamt Bonn, 1905.</p>       | <h2 style="text-align: center;">Section 355 Law of Civil Procedure</h2> <p>(1) Evidence shall be taken before the court hearing the case. Only in the cases determined in the present Code shall the taking of evidence be transferred to a member of the court hearing the case or to another court.</p> <p>(2) The court order instructing one or the other manner of taking evidence is not contestable.</p> |
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|  <p>U. B. FRIEDEN Mitarbeiter Patentamt Bonn, 1905.</p>       | <h2 style="text-align: center;">Section 396 Examination regarding the dispute</h2> <ul style="list-style-type: none"> • the taking of evidence is the task of the court • the court is to ask further questions where necessary • the presiding judge is to grant to each member of the court making the corresponding request the opportunity to ask questions |
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|  <p>U. K. FRIEDERICH Patentanwalt No. 548 110</p>       | <p style="text-align: right;">Section 397</p> <p style="text-align: center;">Right of the parties to ask questions</p> <ul style="list-style-type: none"> • the parties are entitled to have questions put to the witness that they believe expedient for clearing up the matter, or for establishing the circumstances of the witness. • the presiding judge may permit the parties to directly address questions to the witness, and is to grant this permission to their counsel upon the latter's request. • in case of doubt, the court shall rule on whether or not a question is admissible. |
|--|--|