

# THE SYMBIOSIS OF LAWYERS AND NATURAL SCIENTISTS AS JUDGES OF THE FEDERAL PATENT COURT IN THE FEDERAL REPUBLIC OF GERMANY

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## INTRODUCTION

The origin, judicial staff, and jurisdiction of the Bundespatentgericht (Federal Patent Court) of the Federal Republic of Germany make it unique among European tribunals. Part I of this Article chronicles the origins of the tribunal. Part II describes the relationship between the lawyers and natural scientists who work together on the panels of the Bundespatentgericht, while Part III outlines the typical career progression of these individuals during their tenure with the Court. Part IV concludes with brief remarks on the Bundespatentgericht's unique organization.

## I. THE ORIGIN OF THE BUNDESPATENTGERICHT

In the late 1950s a petitioner obtained a decree in his favor in a proceeding at the Patentamt (Patent Office). As provided by the German Patent Act,<sup>1</sup> the petitioner's attorney sought attorney's fees from the losing party in the amount of DM 993, approximately \$200. The Board of Appeal at the Patentamt, however, awarded the petitioner only DM 547. The petitioner was thus left with a balance of DM 446, which he would have to pay himself.

Historically, the Board of Appeals' decision would have terminated the proceedings as the Patent Act did not provide for

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1. Patentgesetz, Bundesgesetzblatt [BGBl.] 1981, 1, *translated in* THE NEW GERMAN PATENT LAW (1981) (Hermann Kinkeldey & Wilfred Stockmair trans., 1981) [hereinafter THE NEW GERMAN PATENT LAW].

further judicial review. The petitioner's clever attorney, however, remembered article 19, paragraph 4, of the Grundgesetz (Federal Constitution).<sup>2</sup> This provision of the German Constitution guaranteed citizens, whose rights had been infringed by an act of the executive, access to an independent court. Even though the Patent Act provided no such remedy, the petitioner's attorney filed an action with the Bavarian Administrative Law Court<sup>3</sup> in Munich. In the petition, the attorney asked the court to set aside the decision of the Board of Appeal at the Patentamt. He argued that the decree of the Patentamt could be characterized as an act of the executive and was thus subject to judicial review pursuant to article 19, paragraph 4 of the Constitution. The Bavarian Administrative Law Court granted the requested relief.

With the consent of the parties, the decision of the administrative law court was appealed directly to the Supreme Court of the administrative branch of the German judiciary.<sup>4</sup> On June 13, 1959, the case was heard by the 1st Senat (Panel), with Chief Justice Werner presiding.<sup>5</sup> In affirming the lower court's decision, the Supreme Court ruled that the Boards of Appeals of the Patentamt are fully integrated into the organization of the administrative authority and, thus, did not constitute independent courts. The court further stated that, in order for a decisional body to be recognized as an independent court, it must have at least one lawyer among the quorum of judges. Since the Board of Appeal of the Patentamt did not have an attorney among its members and was, in any event, an administrative body, its decisions were subject to review by administrative law courts (Verwaltungsgerichte).

The defendant in this litigation, the Federal Department of Justice had expended substantial resources in urging a different conclusion, as the administrative law courts were ill-equipped to adjudicate the great number of cases related to technical patent applications. The court's decision thus required prompt action by

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2. [Constitution] [hereinafter GG].

3. Bayerisches Verwaltungsgericht München.

4. Bundesverwaltungsgericht [BVerwG]

5. Entscheidungen des Bundesverwaltungsgerichts [BVerwGE] 8, 350; Blatt für Patent-, Muster- und Zeichenwesen [Bl. f. PMZ] 1959, 258; Gewerblicher Rechtsschutz und Urheberrecht [GRUR] 1959, 435; Neue Juristische Wochenschrift [NJW] 1959, 1507; Betriebsberater [BB] 1959, 646.

both the Executive and Parliament. After several unsuccessful proposals, the need for an independent patent court became obvious. Because the Federation had exclusive legislative power in the field of industrial and intellectual property rights,<sup>6</sup> there existed the assumption that the new court should operate under federal jurisdiction. However, under article 95 of the Constitution, the states (Länder) had the exclusive right to organize courts, with the exception of the federal courts listed explicitly in that article. It therefore became necessary to amend the Constitution to provide for the creation of a new federal patent court. Due to the importance of the issue, the amendments were made in relatively short order. Article 96, paragraph 1, of the Constitution now provides the Federation with the exclusive right to establish a federal court for industrial property rights.<sup>7</sup>

Shortly after the amendment was made, Parliament created the Bundespatentgericht.<sup>8</sup> Parliament also amended the Patent Act by inserting Section 36 lit. b).<sup>9</sup> The first paragraph of Section 36 reads as follows:

For the decision on appeals against decrees of the Patentamt including actions for the nullification of patents and for granting of compulsory licences the patent court is established as an autonomous and independent court. It is located at the seat of the Patentamt (Munich) and has the denomination “Federal Patent Court.”

In addition, paragraph 2(i)(c) states that judges of the court shall be either qualified lawyers or “experts in a branch of technology.” These technical judges may decide matters in any field of technology, although as a matter of practice a chemist will not serve on a panel deciding matters in the field of physics. Section 36 lit. d) regulates the composition of the various panels of the court. This section requires assignment of at least one judge with formal

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6. GG, *supra* note 2, art. 73, no. 9.

7. BGBl. I 1961, 141.

8. Überleitungsgesetz [Sixth Transition Law], BGBl. I 1961, 274; *cf.* GEORG BENKARD & KARL BRUCHHAUSEN, PATENTGESETZ 56 (9th ed. 1993).

9. Patentgesetz § 65, BGBl. I 1981, 1, *translated in* THE NEW GERMAN PATENT LAW, *supra* note 1, at 111.

legal training to each panel. In so doing, it fulfills the requirement set out in the Supreme Court decision of June 13, 1959.<sup>10</sup>

## II. THE SYMBIOSIS OF LAWYERS AND NATURAL SCIENTISTS IN THE BUNDESPATENTGERICHT

With only a few exceptions, the majority of the Appeal Panels of the Bundespatentgericht have a mixed quorum of three natural scientists, including the Presiding Judge, plus one law-trained judge. The composition of the current panels reflects the Patentamt's historical development.

In May 1877, the first Reich Patent Act established the Imperial Patent Office.<sup>11</sup> Pursuant to a subsequent ordinance,<sup>12</sup> the examining divisions were under the chairmanship of lawyers, who supervised two technical members. This arrangement required a great deal of cooperation. The *Report on the Business Activities of the Imperial Patent Office and the Relationship of Patent Protection towards the Development of the Industry in Germany from 1891 to 1900*<sup>13</sup> illustrated this cooperation when it stated:

Technology and patent law are the cardinal points in the Patentamt activities. Both features must be fostered by the authority equally. Therefore, the Patent Act prescribes that Patentamt be composed of legally and technically trained members. The cooperation of the two types of officials must not be understood in the sense that the technical members handle the technical issues and the lawyers the legal problems. Such splitting of daily work would fail, since legal and technical problems rarely occur separately. To the contrary, joint performance of the work is mandatory. To this end it is necessary that the technical members of the Patentamt acquire a certain legal knowledge, and the lawyers must gain enough technical understanding to enable them to discuss and to evaluate decisive technical problems in their

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10. See *supra* note 5.

11. Reichsgesetzblatt [RGBl.] 1877, 501.

12. Ordinance of July 11, 1891, RGBl. 1891, 349.

13. Official Report 157 (Berlin 1902).

importance. It will be an essential task of the administration of the Patentamt to reconcile the technical and legal staff to a joint organism and to train them in cooperative fulfillment of their work.<sup>14</sup>

On October 25, 1899,<sup>15</sup> a new ordinance changed the organizational structure of the Patentamt by conferring the chairmanship of the patent divisions on either a legal or technical member. This option remained unused in practice because only technical members became patent division chiefs. Indeed, the predominance of technical patent division chiefs lasted many years. It was not altered in the last essential reform of the Patent Act<sup>16</sup> and continued after the Second World War. As a result, the practice both reduced the supremacy of lawyers in the Patentamt and enhanced the role of the technicians. For example, by 1900, the Patentamt's staff consisted of twenty-five lawyers and 198 technical members. Of these technical members, 187 were employed in the patent divisions together with only eight lawyers. Furthermore, each of the Boards of Appeal in the Patentamt had a quorum of three technical members, unless the appeal raised a difficult legal question. When such a question arose, a lawyer from the Patentamt was added to the team of three natural scientists. This practice is still followed today.

The technical members of the Boards of Appeal have traditionally been hesitant to work with lawyers because they often feel that they already have the requisite knowledge and experience necessary to decide legal issues. Their attitude seems justified by the fact that the law does not provide for any consequence where the technical majority has failed to call for assistance of a lawyer. Even when a lawyer is added, no technical member is required to withdraw. Attorneys must therefore contend with three technical "opponents."<sup>17</sup>

In the early years of the Imperial Patent Office, that is, from 1877 to 1900, cooperation among lawyers and technicians was controlled by the division chiefs, who were lawyers. Moreover, the administrators of the Patentamt participated in the effort to show both lawyers and technicians that law and technology develop together.

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14. *Ergänzungsband* (Supplement) Bl. f. PMZ 1902, 157.

15. Ordinance of October 25, 1899, RGB1. 1899, 661.

16. Patent Act of May 5, 1936, RGB1. II 1936, 117.

17. Patentgesetz § 27 ¶ 3, BGB1. I 1981, 1, *translated in* THE NEW GERMAN PATENT LAW, *supra* note 1, at 53.

However, lawyers were soon separated from the technical members of the Patentamt and only in matters with legal difficulties would a lawyer be called upon to participate in the decision. This meant that each division had the discretion to decide whether a difficult legal question existed and if so, whether it was difficult enough to warrant joint deliberation with a lawyer from the Patentamt.

In 1982, the Patentamt employed sixty-one lawyers and 784 technicians,<sup>18</sup> of whom approximately six hundred were examiners for patent applications and opposition proceedings. The Main Division I of the Patentamt consists of twenty-six examining departments, each with more than twenty-five examiners. Due to their great number, it should come as no surprise that technicians have little contact with their legal colleagues. The President of the Patentamt was only reluctantly convinced of the advantages in assigning at least one lawyer to each examining department. With this new rule, each examiner knows in case of need the name of “his” lawyer, with whom he can discuss difficult legal problems.

### III. CAREER PROGRESSION AT THE BUNDESPATENTGERICHT

Many changes await the examiner upon appointment as a technical judge at the Bundespatentgericht. As already noted, the decision of the Supreme Court for Administrative Law Cases (BVerwG) mandated participation in each court panel of at least one full-fledged lawyer as a judge.<sup>19</sup> There are also panels in which the technical members form a dominant majority, a fact explained by the history of the Patentamt leading to the creation of the Bundespatentgericht.

The Department of Justice, in drafting the Bill establishing the Bundespatentgericht, strove to maintain the quorum of the Boards of Appeal in the Patentamt by simply adding one lawyer to it as provided by the Supreme Court decision. Consequently, the unusual requirement of a quorum of four judges was combined with the proviso that in case of equal votes (2:2), the Presiding Judge’s vote would be weighted by giving him two votes. Nevertheless, the legislative act establishing the Bundespatentgericht had far-reaching

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18. Pakuscher in Festschrift Nirk 833-34 (1992).

19. Patentgesetz § 67, BGBl. I 1981, 1, *translated in* THE NEW GERMAN PATENT LAW, *supra* note 1, at 113.

consequences. Before their appointments, technical members of the examining departments in the Patentamt generally decide on patent applications without the assistance of a lawyer. After the appointment, a technical judge of the Bundespatentgericht must confront lawyers from the very first day of his service at the court. The cases must be submitted to the lawyers prior to any hearing or decision for their comments on both legal and technical aspects of a matter.

Another important change results from the different status and character of the Patentamt and the Bundespatentgericht. The former is an executive agency while the latter is an autonomous and independent court. The examiner in the Patentamt has wide discretion and authority and is subject only to the general direction of his President. Furthermore, the examiner decides individually whether to grant or to deny a patent. The individual examiner's power is reduced in the Bundespatentgericht because every decision requires consent of fellow judges. Moreover, a letter to the parties about the pending procedure must be drafted with care and caution to avoid a later revocation en banc. To acquire a more thorough understanding of the differences between the examiner and technical judge, an outline of the specialists' professional development from a graduate engineer to an examiner and finally to a technical judge at the Bundespatentgericht is necessary.

A successful applicant for the position of examiner at the Patentamt, after completing the requisite technical studies and examinations, must have at least five years of technical experience in industry or university research institutes.<sup>20</sup> Furthermore, the Patent Act presupposes an applicant's "possession of the necessary knowledge of law." In practice, however, the legal knowledge requirement was to be fulfilled largely after the applicant's entry into the service of the Patentamt. Otherwise, the applicant would have to earn a law degree in addition to his natural science degree. Applicants thus take intensive legal training courses given by Patentamt lawyers during the first eighteen months of their service. The courses cover selected topics in civil and patent law, as well as survey the most important rules of the Zivilprozeßordnung (ZPO), the German Code of Civil Procedure.

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20. *Id.* § 26 ¶ 2, at 15.

During the first eighteen months, applicants also work in an examining department and have no power to sign final decisions on patent applications. If they successfully pass the eighteen-month trial period, applicants become civil servants (Beamter) and may remain in their posts until the age of mandatory retirement. To complete the test period successfully, applicants must be in good standing in their examining departments and must receive above average evaluations in the legal training program.

Once applicants become full-fledged examiners, they must complete a sufficient number of applications each month. Their decisions are listed and statistics are submitted to department chiefs each month. When confronted with legal issues, junior examiners consult senior colleagues and their department chiefs in order to determine whether the detailed advice of a lawyer in the Patentamt is required. As a matter of tradition and practice, department chiefs have successfully served as technical judges in the Bundespatentgericht for periods of at least seven years. Department chiefs thus bring with them the experience and standards of the Bundespatentgericht.

The assigned lawyer is a member of the Main Division "Law" and is located either in another section of, or outside, the building, thus requiring the examiner to submit a written request for assistance of the lawyer via official channels. The organizational difficulties and working pressures on each examiner seem to suggest why an examiner, in many instances, often avoids requesting the assistance or participation of a lawyer. An examiner may try to resolve a matter quickly, knowing that applicants have recourse to the Bundespatentgericht, which might lead to a more thorough decision. In addition, any recourse taken by an unsatisfied applicant must be filed with the examining department of the Patentamt and not directly with the Bundespatentgericht. According to Section 73, paragraph 4, of the Patent Act, an examiner whose decision is appealed must set aside his decision, if the appeal is justified. Unnecessary appeals are thus prevented from reaching the court. There is, however, a time limit to expedite the procedure. The case must be forwarded to the court within three months, unless the examiner has decided in favor of the applicant.<sup>21</sup>

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21. *Id.* § 73 ¶ 4, at 121.



After some seven to ten years, an examiner with above average qualifications may apply for appointment as a technical judge of the Bundespatentgericht. Because personnel records alone are not a useful indicator of success as a judge, each candidate is invited to a personal interview with the chief judge. The applicant may then be transferred to the court as a “commissioned judge”<sup>22</sup> for a trial period of one year. During this period the applicant is usually assigned to a panel of the court entrusted with decisions in a field of technology in which the applicant is professionally qualified. Subsequently, an applicant may also be invited to serve as a member of two different panels in order to improve his abilities. The lawyer in the panel has the special task of acquainting a newcomer with techniques of writing summaries of the case. The summaries are written in anticipation of the oral hearing for information of the panel. Following the hearing, the written decision which must be circulated and, in case of approval, signed by all the panel members. As a rule, commissioned judges pass the one-year trial period successfully. During this period, the chief judge maintains contact with the candidate and the appropriate presiding judge. Occasionally, a candidate resigns or is sent back to the Patentamt for lack of qualification. Once appointed, however, a commissioned technical judge will then acquire the same status as judges of other appellate courts, and will stand on the same footing as his colleagues from the legal profession.<sup>23</sup>

This method of recruiting technical judges to the Bundespatentgericht is not exclusive: the Patent Act<sup>24</sup> provides that judges of the Bundespatentgericht must either be qualified for judgeship according to the pertinent law<sup>25</sup> or “experts” in a field of technology provided that they have passed the final university or state examination. Theoretically, it would be possible to employ engineers with sufficient professional experience gained in the industry, at a laboratory as a research assistant, or in the office of a patent attorney<sup>26</sup> outside the Patentamt. However, by custom and practice,

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22. *Id.* § 73 ¶¶ 1-2, at 119.

23. Deutsches Richtergesetz (Federal Law on the Status of Judges), BGBl. I 1961, 1665 (as amended by BGBl. I 1972, 713).

24. Patentgesetz § 65 ¶ 2, § 26 ¶ 2, BGBl. I 1981, 1, *translated in* THE NEW GERMAN PATENT LAW, *supra* note 1, at 51, 111.

25. *See supra* note 23.

26. Patentanwaltsordnung (Law on the status of patent attorneys), BGBl. I 1966, 557. In order to become a Patentanwalt, a lawyer must first acquire experience working with a

only examiners of the Patentamt have been assigned to judgeships in the Bundespatentgericht.

As suggested earlier, an examiner's passage to a judicial position results in a complete professional reorientation. The examiner must surrender his independent working methods. As an examiner deciding on a patent application, he had exclusive responsibility for his decision with the rare opportunity of discussing a complicated case with experienced colleagues and perhaps even a lawyer of the Patentamt. By contrast, his appointment as technical judge at the Bundespatentgericht gives him greater independence in his judicial task than he ever enjoyed in the Patentamt, since his chief judge could not interfere with his judicial activities. This independence is tempered by his membership in a quorum of four judges. A judge must present all his cases to his quorum colleagues before final disposition, and he must use all his knowledge and experience to convince them of his proposed solution. Finally, he must draft the opinion of the panel as discussed in camera. His draft is circulated among his colleagues, with the presiding judge being the last official to see it. In the course of this drafting procedure, the other members of the panel frequently demand amendments of the draft. Since the German Code of Civil Procedure allows no concurring or dissenting opinions in a judgment, the technical judge chosen as reporter of the individual case might be obliged to write the opinion to reflect the view of the majority. However, when the majority opinion is contrary to the reporter's own conviction, an experienced presiding judge will exempt him from this duty.

The accomplishments of presiding judges in their careers merit great respect. After termination of his technical university studies, an individual works for years in practice or scientific research, and then, several more as an examiner before his appointment as technical judge at the Bundespatentgericht. There the individual serves for several years in the appointed position of technical judge. Later the judge may return to the Patentamt as a department chief. Finally, the judge may be called back to the Bundespatentgericht, this time as presiding judge of a technical

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patent attorney. After this training is completed, an individual must complete both oral and written examinations before submitting an application to the President of the Patentamt for admission to the practice as Patentwalt.

appeal panel. As a result of this wide-ranging professional experience, a presiding judge is especially well qualified to reconcile the working methods of his technical colleagues with the more systematic approach of his law-trained judge. The cooperation of technicians and lawyers in patent cases depends heavily upon the energy with which the lawyer-judge is ready to take the lead in certain important issues. These issues are not restricted to legal matters; often a lawyer, by asking questions of his technical colleagues, can help to clarify technical features of the issue. The lawyer-judge gets another chance to take the lead when the written opinion of the court is drafted. Surprisingly, this duty rests not with the lawyer judge, but on the technical member of the panel who has become the reporter of the individual appeal. In many instances, however, the law-trained judge will offer his services to the technical reporter and will write the opinion. Since membership on a Technical Appeal Panel generally lasts for years, the technical judges eventually acquire the necessary experience and adopt the writing techniques of their lawyer colleagues. In the same vein, the lawyer judge must have an interest in technical problems, even if the field of technology involved is difficult to understand. This attitude is important because the three technical judges, including the presiding judge, come from the Patentamt, where they were accustomed to deciding technical problems alone. Thus, the law-trained judge in the court panel must show "educational adroitness" in presenting a legal problem and its proposed solution to his technical fellow judges.

#### IV. CONCLUSION

Having spent fourteen years in the service of the Bundespatentgericht as its Chief Judge while at the same time functioning as Presiding Judge in a panel composed of lawyers and technical judges, I can report that the symbiosis of lawyers and technicians on the bench of the Bundespatentgericht has proved to be of mutual advantage to both professions.

The Bundespatentgericht is the only court in the Federal Republic of Germany and perhaps in the world that employs as judges with lifetime tenure full-fledged lawyers and academic professionals from the engineering or natural sciences faculties of recognized universities with equal rights and duties of the members of both

professions. The technical judges are exposed to teamwork at the Bundespatentgericht and confront the need to reconcile their way of thinking with that of lawyers. This collaborative organization distinguishes this rather young court from other appellate courts in the Federal Republic of Germany. The value of this structure appears in the fact that an expert witness is rarely summoned to testify because the experts already occupy the bench. It should also be mentioned that some judges in the Bundespatentgericht are not only full-fledged lawyers, but also hold a degree in natural sciences so that they can function as both technical judges and lawyer judges. They have the advantage of knowing both sides of the coin. The symbiosis of lawyers and technicians as judges of the Bundespatentgericht will continue to evolve and improve in the future. It remains to be seen whether the Bundespatentgericht can serve as a model for other technical courts dependent on special expert knowledge and experience in areas such as medicine and architecture.<sup>27</sup>

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27. Pakuscher, *supra* note 18, at 829-30; WISSENSCHAFTSGERICHTSHÖFE 122 (Michael Wenz ed., 1983); Michael Wenz, ZEITSCHRIFT FÜR RECHTSPOLITIK [ZRP] 268 (1985); Horst Sendler, *Richter und Sachverständige* NJW 2907-15 (1986).