

## PATENT ASSIGNMENT COVER SHEET

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EPAS ID: PAT5600919

<b>SUBMISSION TYPE:</b>	NEW ASSIGNMENT	
<b>NATURE OF CONVEYANCE:</b>	USPTO DECISION ACKNOWLEDGING PROPRIETARY INTEREST OBTAINED OTHER THAN BY ASSIGNMENT, INCLUDING PETITION, LEGAL MEMORANDUM AND EXHIBITS	
<b>CONVEYING PARTY DATA</b>		
	<b>Name</b>	<b>Execution Date</b>
	WOLFGANG MANN	05/01/2019
	WOLFGANG HEIMBERG	05/01/2019
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<b>City:</b>	YANTAI, SHANDONG	
<b>State/Country:</b>	CHINA	
<b>Postal Code:</b>	264006	
<b>PROPERTY NUMBERS Total: 1</b>		
	<b>Property Type</b>	<b>Number</b>
	Application Number:	14910681
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<b>ATTORNEY DOCKET NUMBER:</b>	0996.0002C	
<b>NAME OF SUBMITTER:</b>	MARK J. DEBOY	
<b>SIGNATURE:</b>	/Mark J. DeBoy/	
<b>DATE SIGNED:</b>	07/02/2019	
<b>Total Attachments: 303</b>		
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# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
**United States Patent and Trademark Office**  
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P.O. Box 1450  
Alexandria, Virginia 22313-1450  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/910,681	02/05/2016	Zhaoqiang Wang	0996.0002C	4497
27896	7590	05/01/2019		
EDELL, SHAPIRO & FINNAN, LLC			EXAMINER	
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Suite 750				
Gaithersburg, MD 20878				
			ART UNIT	PAPER NUMBER
			1774	
			NOTIFICATION DATE	DELIVERY MODE
			05/01/2019	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

epatent@usiplaw.com



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

In re Application of :  
Wang et al. :  
Application No. 14/910,681 :  
Filed: 5 Feb 2016 : DECISION ON PETITION  
For: CENTRIFUGE AND METHOD FOR :  
CENTRIFUGING A REACTION VESSEL :  
UNIT :

This is in response to the petition under 37 CFR 1.46(b)(2) filed March 12, 2019.

For patent applications filed on or after September 16, 2012, 35 U.S.C. 118 recognizes three types of entities other than an inventor who may apply for a patent: an assignee, an obligated assignee-entity to which the inventor is under an obligation to assign, or the entity who otherwise shows sufficient proprietary interest in the matter.

Applicant states the present petition is being filed to demonstrate that Yantai AusBio Laboratories Co., Ltd. has sufficient proprietary interest in the present application.

37 CFR 1.46(b)(2) states:

If the applicant is a person who otherwise shows sufficient proprietary interest in the matter, such applicant must submit a petition including:

- (i) The fee set forth in § 1.17(g);
- (ii) A showing that such person has sufficient proprietary interest in the matter; and
- (iii) A statement that making the application for patent by a person who otherwise shows sufficient proprietary interest in the matter on behalf of and as agent for the inventor is appropriate to preserve the rights of the parties.

Office guidance on establishing a proprietary interest is as follows:

A discussion of the evidence necessary for a showing that a person has sufficient proprietary interest in the matter is set forth in MPEP § 409.03(f).

See Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act, 77 Fed. Reg. 48776 (August 14, 2012).

MPEP § 409.05 states, in pertinent part:

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the **37 CFR 1.46** applicant. The facts in support of any conclusion that a court would award title to the **37 CFR 1.46** applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

The present petition is accompanied by a legal memorandum prepared by Daniel Hoppe attesting that a court of competent jurisdiction in Germany would award title of the invention to Yantai AusBio Laboratories Co., Ltd.. Additionally, applicant submitted the fee set forth in § 1.17(g) and a statement that making the application for patent by Yantai AusBio Laboratories Co., Ltd. on behalf of and as agent for the inventors is appropriate to preserve the rights of the parties.

In view of the above, the petition is **GRANTED**.

The application is being forwarded to the Office of Data Management.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3211.

/Christina Tartera Donnell/

Christina Tartera Donnell  
Attorney Advisor  
Office of Petitions

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 14/910,681  
First Named Inventor : Zhaoqiang Wang  
Confirmation No. : 4497  
Filed : February 5, 2016  
TC/A.U. : 1774  
Examiner : Shuyi S. Liu  
Docket No. : 0996.0002C  
Customer No. : 27896  
Title : CENTRIFUGE AND METHOD FOR CENTRIFUGING  
A REACTION VESSEL UNIT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION PURSUANT TO 37 C.F.R. § 1.46(B)(2)**

Pursuant to 37 C.F.R. § 1.46(b)(2), Yantai AusBio Laboratories Co., Ltd. ("Petitioner") hereby petitions to proceed as the applicant in the United States National Stage of PCT Application No. PCT/EP2014/066947 (designated Serial No. 14/910,681).

**I. Introduction**

As indicated in 37 C.F.R. § 1.46(b)(2), a petition seeking to proceed as the applicant in an application by an entity showing sufficient proprietary interest in the matter must include:

- (i) The fee set forth in [37 C.F.R.] § 1.17(g);
- (ii) A showing that such person has sufficient proprietary interest in the matter; and
- (iii) A statement that making the application for patent by a person who otherwise shows sufficient proprietary interest in the matter on behalf of and as agent for the inventor is appropriate to preserve the rights of the parties.

37 C.F.R. § 1.46(b)(2).

Accordingly, submitted concurrently herewith is the petition fee pursuant to 37 C.F.R. § 1.17(g), and Petitioner states that making the application for patent by Petitioner on behalf of and as agent for the inventors is appropriate to preserve the rights of the parties. Furthermore, as shown through the discussion below and in the accompanying Legal Opinion Concerning the



Assignment of Inventor's Rights prepared by Daniel Hoppe ("Legal Memorandum") and accompanying Exhibits 1-40, Petitioner has sufficient proprietary interest in the matter. Specifically, Petitioner will show that a court of competent jurisdiction would, by the weight of authority in that jurisdiction, award title to the invention underlying the application to Petitioner. *See, e.g.*, MPEP § 409.05 ("A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.46 applicant.").

## **II. Factual Background**

On August 6, 2013, AusBio R&D Europe GmbH's ("AusBio Europe") patent attorney Mr. Bernhard Ganahl filed European Patent Application No. 13179437 ("European Application"), in the name of AusBio Europe and Petitioner. Legal Memorandum at 5. The inventors named for the European Application are Mr. Zhaoqiang Wang, Dr. Wolfgang Mann and Dr. Wolfgang Heimberg.

On August 6, 2014, International Application No. PCT/EP2014/066947 ("PCT Application") was also filed in the name of AusBio Europe and Petitioner, and which claims priority to the European Application. Legal Memorandum at 5.

On January 16, 2015, AusBio Europe assigned its full rights and title in the PCT Application to AusBio Yantai. Exhibit 15; Exhibit 41; *see also* Legal Memorandum at 6.

On February 5, 2016, the PCT Application entered the national stage in the United States and was issued serial number 14/910,681 ("U.S. National Stage of the PCT Application"). Exhibit 42 at 1, 4.

On March 5, 2016, inventor Zhaoqiang Wang executed a Declaration for the U.S. National Stage of the PCT Application. Exhibit 43.

On September 12, 2016, Mr. Wang assigned his entire rights and title in the PCT Application, the U.S. National Stage of the PCT Application, and any divisionals, renewals and continuations therefrom to Petitioner. Exhibit 16; Exhibit 44.

To date, inventors Dr. Mann and Dr. Heimberg have refused to execute Declarations. Exhibits 45 and 46.

As explained in the Legal Memorandum, a court of competent jurisdiction in Germany, the relevant authority (Legal Memorandum at 7-10), would award to AusBio Europe the rights of inventors Dr. Mann and Dr. Heimberg in the PCT Application, and consequently the rights to the U.S. National Stage of the PCT Application (Legal Memorandum, *passim*).

### **III. Discussion**

As indicated above, Petitioner submits the current petition in order to proceed as the applicant in the U.S. National Stage of the PCT Application as the entity having sufficient proprietary interest in the matter to serve as agent for the inventors to preserve the rights of the parties. Through the following discussion, Petitioner will show that a court of competent jurisdiction in Germany would award title in the PCT Application to AusBio Europe based upon the facts and law as discussed in the Legal Memorandum submitted currently herewith. Petitioner will further show that AusBio Europe has assigned its full rights and title in the PCT Application to Petitioner. Finally, Applicant will show that Petitioner has full rights and title in the U.S. National Stage of the PCT Application. Because the full rights and title in the U.S. National Stage of the PCT Application resides with Petitioner, Petitioner has sufficient proprietary interest in the matter to proceed as the applicant in the U.S. National Stage of the PCT Application.

First, as an initial matter, Mr. Wang assigned his entire right, title and interest in the PCT Application, the U.S. National Stage of the PCT Application, and any divisionals, renewals and continuations therefrom to Petitioner. Exhibit 16; Exhibit 44. Accordingly, Petitioner is the assignee of Mr. Wang's full rights and title in the PCT Application and the U.S. National Stage of the PCT Application.

Second, as discussed in the Legal Memorandum, a German court would award to AusBio Europe the full rights and title of Drs. Heimberg and Mann to the invention underlying the PCT Application. Legal Memorandum, *passim*; *see also* MPEP § 409.05 ("A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title **of the invention** to the 37 CFR

1.46 applicant.")(emphasis added). As discussed in the Legal Memorandum, the assignment of the full rights and title of Drs. Heimberg and Mann in the underlying invention also includes the assignment of the rights and title in the PCT Application to AusBio Europe, including the U.S. National Stage of the PCT Application. *See, e.g.*, Legal Memorandum at 16 ("[A] German court would hold that Dr Mann had an obligation to assign his rights to AusBio Europe."); *id.* at 22 ("[A]gainst the background of HTI's obligation to assign the rights to the invention to AusBio Europe, a German court will hold that Dr Heimberg's behaviour subsequent to making the invention resulted in an assignment of the rights to the invention to HTI, empowering HTI to pass the rights on to AusBio Europe."). Accordingly, AusBio Europe was assigned the full rights and title of Drs. Heimberg and Mann in the PCT Application.

Third, AusBio Europe has assigned its full rights and title to the PCT Application to Petitioner. Exhibit 15; Exhibits 41; *see also* Legal Memorandum at 23 ("A competent German court will hold that AusBio Europe has assigned its rights to the invention underlying the PCT Application to AusBio Yantai by virtue of the Declaration of Assignment.").

Accordingly, Petitioner has the full rights and title to the PCT Application as follows, as the rights of all three inventors have been assigned to Petitioner. Specifically:

1. Mr. Wang assigned his full rights and title in the PCT Application directly to Petitioner via written assignment. Exhibit 16; Exhibit 44.
2. A court of competent jurisdiction in Germany would grant AusBio Europe Dr. Mann's full rights and title in the PCT Application. Legal Memorandum, *passim*. AusBio Europe, in turn, assigned its full rights and title in the PCT Application to Petitioner. Exhibit 15; Exhibit 41.
3. A court of competent jurisdiction in Germany would grant AusBio Europe Dr. Heimberg's full rights and title in the PCT Application. Legal Memorandum, *passim*. AusBio Europe, in turn, assigned its full rights and title in the PCT Application to Petitioner. Exhibit 15; Exhibit 41.

Accordingly, Petitioner holds the full and undivided rights and title in the PCT Application.

For completeness, Petitioner notes that the full rights and title to the PCT Application held by Petitioner include the full rights and title to the U.S. National Stage of the PCT Application. Specifically, the international stage and the national stage of an international application are just that, two stages of examination of the same international application. *See, e.g.*, 35 U.S.C. § 372 ("All questions of substance and, within the scope of the requirements of the treaty and Regulations, procedure **in an international application designating the United States** shall be determined as in the case of national applications regularly filed in the Patent and Trademark Office.") (emphasis added); 35 U.S.C. § 375 ("A patent may be issued by the Director based **on an international application designating the United States**, in accordance with the provisions of this title. Such patent shall have the force and effect of a patent issued on a national application filed under the provisions of chapter 11.")(emphasis added); *see also, e.g., Zachariah v. Commissioner of Patents and Trademarks*, 243 F.3d 555 (Fed. Cir. 2000) ("The PCT process consists of an international and a national stage. During the international stage, the World Intellectual Property Organization (WIPO) preliminarily processes **the application** under the terms of the PCT. During the national stage, the applicant designates member countries in which the applicant desires patent protection. Thereafter, the patent office of each designated country processes **the application** under its own patent laws.")(emphasis added); *see also, e.g., MPEP* § 1801 ("In the same manner, the PCT enables foreign applicants to file **a PCT international application**, designating the United States of America, in their home language in their home patent office and have **the application** acknowledged as a regular U.S. national filing. The PCT also provides for the establishment of an international search report and written opinion at 16 months from the priority date and publication of the international application after 18 months from the priority date. Upon payment of national fees and the furnishing of any required translation, usually 30 months after the filing of any priority application for the invention, or the international filing date if no priority is claimed, **the application** will be subjected to national procedures for granting of patents in each of the designated countries.")(emphasis added). Accordingly, the U.S. National Stage of the PCT Application is simply an examination of the PCT Application, an application in which Petitioner has the full rights and title.

In light of the above, Petitioner respectfully submits that Petitioner has the full rights and title to the U.S. National Stage of PCT Application No. PCT/EP2014/066947 (designated Serial No. 14/910,681), and therefore, Petitioner has sufficient proprietary rights in the matter to proceed

as the applicant in the U.S. National Stage of PCT Application No. PCT/EP2014/066947 (designated Serial No. 14/910,681).

#### **IV. Conclusion and Action Requested**

Applicant respectfully submits that the present petition, including the Legal Memorandum, has made "A showing that [Petitioner] has sufficient proprietary interest in the matter" of the U.S. National Stage of the PCT Application. As noted above, submitted concurrently herewith is the petition fee pursuant to 37 C.F.R. § 1.17(g). Finally, Petitioner states that making the U.S. National Stage of the PCT Application for patent by Petitioner, an entity who shows sufficient proprietary interest in the matter, on behalf of and as agent for the inventors is appropriate to preserve the rights of the parties. Therefore, Petitioner respectfully submits that the present petition meets the requirements under 37 C.F.R. § 1.46(b)(2), and Petitioner requests that the Office grant Petitioner the right to proceed in the U.S. National Stage of the PCT Application as the applicant.

Applicant hereby petitions for any extension of time that may be necessary to maintain the pendency of this application. The Commissioner is hereby authorized to charge payment of any additional fees required for the above-identified application or credit any overpayment to Deposit Account No. 05-0460.

Dated: March 12, 2019

Respectfully submitted by:

**EDELL, SHAPIRO & FINNAN, LLC**  
**CUSTOMER NO. 27896**  
9801 Washingtonian Blvd., Suite 750  
Gaithersburg, MD 20878  
(301) 424-3640

/Jason M. Shapiro/  
Jason M. Shapiro  
Reg. No. 35354

## Legal Opinion

concerning the assignment of inventor's rights

Prepared by:

Rechtsanwalt Daniel Hoppe  
Certified expert lawyer for intellectual property

Prepared for:

Yantai AusBio Laboratories Co. Ltd

Date: 6 March 2019

## I. The Author

The author used to work as a judge in the Administrative Court in Leipzig/Germany and as a public prosecutor in the public prosecutor's office in Leipzig/Germany. He is a partner of Preu Bohlig & Partner, one of the leading intellectual property law firms in Germany. He advises and represents clients from Germany and abroad in the field of intellectual property law, in particular in questions of patent and utility model law, employee invention law and the protection of trade secrets.

The author has particular experience in the field of patent law and employee inventions. Among many others, he has been lecturing International Law and Intellectual Property Law at the Northern Institute of Technology Management (NIT) in Hamburg/Germany. Moreover, he has been lecturing Patent Law at the University of Applied Science in Merseburg/Germany and has been engaged for lecturing patent law at the Bucerius Law School in Hamburg/Germany. He has been publishing in this field on a regular basis. His publications include:

- Co-author:
  - Boemke/Kursawe, *"Arbeitnehmererfindungsgesetz"* (Act on employee inventions; sect. 13 to 16 and international application of the act); one of the leading legal commentaries on the German Employee Invention Act;
  - Petillion, *"The Enforcement of Intellectual Property Rights in the EU Member States"*, German national part.
- Author:
  - 2015: *"IP Assignments in International Employment Agreements"*;
  - since 2013: *"The Patent and Utility Model Case Law of the German Lower Courts"*, annual report published in the leading German IP magazine GRUR-RR including cases of patent and utility law, employee inventions law and procedural law;
  - 2015: *"Patent infringement in Germany"* - A Guide to Litigating Patents in Germany.

- 2015 to 2017 FCBA Monthly Newsletter concerning the Unified Patent Court;
- several dozens other articles in leading legal magazines.

## II. Factual Background

### 1. Entities and persons involved

#### (i) Yantai AusBio Laboratories Co. Ltd.

Yantai AusBio Laboratories Co. Ltd. (hereafter: „AusBio Yantai“) is a China based innovative company with its headquarter in No. 2 Huashan Road, Yeda, Yantai 264006, China. For more than 25 years, AusBio Yantai has been active on the market for diagnosis and analyses devices. AusBio Yantai offers its products mostly in China. The customers of AusBio Yantai include blood centres, hospitals and forensic laboratories. One of AusBio Yantai’s products is the “AusWasher”, which is the commercial version of the invention disclosed in the international patent application PCT/EP2014/066947 (hereafter: “invention at issue” and “PCT Application,” respectively). Managing director of AusBio Yantai is Mr Zhaoqiang Wang (also called “Johnson Wang”).

#### (ii) AusBio R&D Europe GmbH

AusBio R&D Europe GmbH (hereafter: “AusBio Europe”) was a subsidiary of AusBio Yantai in Germany, in particular for the purpose of developing and marketing medicinal diagnostic products in Germany/Europe. *AusBio Europe’s Articles of Association, attached as Exhibit 1.*

AusBio Europe was founded in 2012 and dissolved on February 5, 2015. *Excerpt of AusBio Europe from the company register, attached as Exhibit 2.*



Effective 1 April 2013, Dr Wolfgang Mann became managing director of AusBio Europe *Excerpt of AusBio Europe from the company register, Exhibit 2.*

Notwithstanding the dissolution of AusBio Europe in February 2015, Dr Mann held his position until his employment agreement was terminated formally as of 30 June 2015.

(iii) HTI bio-x GmbH

HTI bio-x GmbH (hereafter: „HTI“) is a German company, which is located in Ebersberg. It has been providing engineering services and solutions for laboratory and production automation for more than 20 years. HTI entered into an Agreement about the Cooperation of various Development Projects with AusBio Europe dated March 15, 2013 (hereafter: Development Agreement). According to the Development Agreement, HTI was obliged to conduct certain development work resulting in the invention at issue. *Agreement about the Cooperation of various Development Projects dated March 15, 2013, attached as Exhibit 3.* The Development Agreement was signed by Dr Heimberg for HTI and by Dr Mann for AusBio Europe.

HTI issued invoices for the development work to AusBio Europe in the amount of approximately EUR 671,605.00 and for technical services and support in the amount of approximately EUR 155,374.00. *Declaration of Zhaoqiang Wang dated 27 February 2019, attached as Exhibit 4.* HTI's invoices were fully paid. *Declaration of Zhaoqiang Wang dated 27 February 2019, Exhibit 4.*

(iv) BlueCatBio GmbH

BlueCatBio GmbH (hereafter: „BlueCatBio“) is a German based limited liability company. AusBio Europe has entered into a license agreement with BlueCatBio concerning the invention at issue and the PCT Application. *License Agreement dated 3 October 2014, attached as Exhibit 5.*

(v) Dr Wolfgang Mann

Dr Wolfgang Mann (hereafter: "Dr Mann") was the director/CEO of AusBio Europe. He is named as one of the three co-inventors of the invention at issue.

(vi) Dr Wolfgang Heimberg

Dr Wolfgang Heimberg (hereafter: "Dr Heimberg") is the director/CEO of HTI. He is named as one of the three co-inventors of the invention at issue. He has owned 64% of HTI's shares. *List of owners of HTI dated 12 July 2002, attached as Exhibit 6; list of owners of HTI dated 14 June 2013, attached as Exhibit 7.*

(vii) Mr Zhaoqiang Wang

Mr Zhaoqiang Wang is the director/CEO of AusBio Yantai. He is also one of the three co-inventors of the invention at issue.

## 2. The invention at issue and the further process

The invention at issue was made as a result of the development work conducted in the course of the Development Agreement concluded by AusBio Europe and HTI.

On 6 August 2013, AusBio Europe's patent attorney Mr Bernhard Ganahl working for Patronus IP, Neumarkter Street 18, 81673 Munich, filed the European Patent Application no. 13179437 (hereafter: European Application). On 6 August 2014, Mr Ganahl filed the PCT Application, which claims the priority of the European Application. The European Patent Application and the PCT Application were filed in the name of AusBio Europe and AusBio Yantai.

Mr Ganahl was hired by Dr Mann in his capacity as the CEO of AusBio Europe. This is evidenced by an email dated 19 June 2013 of Dr Mann, signed by Dr Mann expressly as "CEO" and carrying the AusBio Europe signature. *Email dated 19 June 2013, attached as Exhibit 8.*

Dr Heimberg assisted in the drafting process. In particular, the drawings required for both patent applications were provided to Mr Ganahl by Dr Heimberg or, on his behalf, by employees of HTI. *Emails from Dr. Heimberg and employees of HTI to Patronus dated 31 July 2013, attached as Exhibit 9, 11 September 2014, attached as Exhibit 10, 16 September 2014, attached as Exhibit 11, 18 September 2014, attached as Exhibit 12, 7 October 2014, attached as Exhibit 13 and 16 October 2014, attached as Exhibit 14.*

The drawings used with the PCT Application were provided subsequent to filing the PCT Application. Dr Mann also assisted the drafting and filing of both patent applications.

On 3 October 2014, Dr Mann in his capacity as the CEO of AusBio Europe entered into the License Agreement concerning the PCT Application with BlueCatBio. According to the License Agreement, AusBio Europe was supposed to grant BlueCatBio a non-exclusive license under the PCT Application. Under the License Agreement, AusBio Europe retained ownership of the invention and the right to obtain patents throughout the world. *License Agreement dated 3 October 2014, Exhibit 5.*

AusBio Europe assigned to AusBio Yantai its rights pertaining to the PCT Application at issue by way of an Assignment Declaration on 16/17 January 2015 (hereafter: "Declaration of Assignment"). *Declaration of Assignment dated 16/17 January 2015, attached as Exhibit 15.*

Mr Wang assigned to AusBio Yantai his rights pertaining to the United States national stage patent application filed on 5 February 2016 and assigned Serial No. 14/910,681 which claims the priority of the European Application (hereafter: "US Application"). *Assignment dated 12 September 2016, attached as Exhibit 16.*

### III. Law and Argument

#### 1. Scope of the legal argument

This memorandum addresses the questions as to whether and how AusBio Yantai has become the sole owner of the entire right and interest in and to the invention at issue underlying the PCT Application, and consequently the owner of the PCT Application itself and the corresponding US Application.

The following is based on the assumption that the invention was made by three individuals, namely Dr Mann, Dr Heimberg and Mr Wang. The memorandum will therefore focus on the assignment of those individuals' inventor's rights to their respective companies and ultimately, in the instances of Dr Mann and Dr Heimberg, to AusBio Yantai.

#### 2. Applicable Law

As far as Dr Mann's and Dr Heimberg's contribution is concerned, the ownership of the invention at issue must be assessed under German law. As explained in detail below, the application of German law follows from the Regulation (EC) No 593/2008 of the European Parliament and of the Council of 17 June 2008 on the law applicable to contractual obligations (hereafter: "*Rome I Regulation*"). According to Article 1 Rome I Regulation, the Rome I Regulation shall apply, in situations involving a conflict of laws, to contractual obligations in civil and commercial matters. *Rome I Regulation, attached as Exhibit 17.*

In detail:

The ownership of the invention at issue is determined by the contractual obligations of (i) Dr Mann vis-à-vis AusBio Europe, (ii) Dr Heimberg vis-à-vis HTI, (iii) AusBio Europe vis-à-vis HTI and (iv) AusBio Europe vis-à-vis AusBio Yantai. (v) Additionally, the assignment of ownership rights in the PCT Application between AusBio Europe vis-à-vis AusBio Yantai must be assessed under the law of the country where protection is sought.

(i) Dr Mann vis-à-vis AusBio Europe

The employment agreement between Dr Mann and AusBio Europe does not contain a provision concerning the applicable law. In the absence of a choice of law clause, according to Art. 4 and Art. 8(2) of the Rome I Regulation, an employment contract shall be governed by the law of the country in which or, failing that, from which the employee habitually carries out his work in performance of the contract. The country where the work is habitually carried out shall not be deemed to have changed if the employee is temporarily employed in another country. This rule is applicable to ordinary employees as well as CEOs of limited liability companies who perform their duties under the direction and subject to the supervision of another body of that company, receives remuneration in return for the performance of his duties and does not himself own any shares in the company. *ECJ judgment dated 9 July 2015, C-229/14, Ender Balkaya v Kiesel Abbruch- und Recycling Technik GmbH, attached as Exhibit 18*. If the CEO does him- or herself own shares in the company, the applicable law follows from Art. 4(1)(b) Rome I Regulation, according to which a contract for the provision of services shall be governed by the law of the country where the service provider has his habitual residence.

In the case of Dr Mann both approaches result in the applicability of German law on his employment relationship to AusBio Europe. Either, Dr Mann must be considered an employee within the meaning of Art. 8(2) Rome I Regulation. In that event, German law is applicable as Dr Mann habitually carried out his work in performance of the contract in Germany. Or, if he must be treated as a non-employee, the applicability of German law results from the fact that Dr Mann, who provided the services, had his habitual residence in Germany.

The applicability of German law extends to the ownership in work results.

(ii) Dr Heimberg vis-à-vis HTI

The employment agreement between Dr Heimberg and HTI has not been made available. However, both Dr Heimberg and HTI resided in Germany at the time of the invention and there is no indication that the employment agreement contained a connecting factor to a country other than Germany. According to Art. 1(1) of the Rome I Regulation, the Rome I Regulation is applicable only in situations involving a conflict of laws. In the case at hand, as concerns the relationship of Dr Heimberg and HTI, no such conflict of laws exists. Therefore, a competent German court would apply German law to all questions of Dr Heimberg's and HTI's employment relationship.

(iii) AusBio Europe vis-à-vis HTI

The relationship of AusBio Europe and HTI according to the Development Agreement is governed by German law, too. The Development Agreement does not contain any connecting factor to a country other than Germany. As pointed out before, according to Art. 1(1) of the Rome I Regulation, the Rome I Regulation is applicable only in situations involving a conflict of laws. In the case at hand, as concerns the relationship of AusBio Europe and HTI, no such conflict of laws exists.

(iv) AusBio Europe vis-à-vis AusBio Yantai

As far as the Declaration of Assignment brings into existence certain rights and obligations of the contractual parties AusBio Europe and AusBio Yantai, German law is applicable. According to Art. 4(2) Rome I Regulation, where a contract is not covered by Art. 4(1) Rome I Regulation or where the elements of the contract would be covered by more than one of points (a) to (h) of Art. 4(1) Rome I Regulation, the contract shall be governed by the law of the country where the party required to effect the characteristic performance of the contract has its habitual residence. In case of agreements to assign intellectual property rights, the characteristic performance of the contract is the

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assignment. Therefore, the assignor's habitual residence is decisive. In the case at hand, the habitual residence of AusBio Europe is its registered office, which is in Germany.

(v) Performance of the Assignment between AusBio Europe and AusBio Yantai

However, as far as the performance and the validity of the assignment of the US national part of the PCT applications listed in the Declaration of Assignment is concerned, US law is applicable. The validity of the assignment under US law is essentially outside the scope of this memorandum. It is the author's understanding that the validity of the assignment under US law is being addressed in more detail in the Petition being submitted concurrently herewith.

3. Starting Point

According to German law, the right to an invention comes into existence as a result of the process of creating the invention. This act of creating the invention is attributed to one or several individuals, i.e. a single inventor or a plurality of inventors. *Kraßer/Ann Patentrecht [Patent Law], 7<sup>th</sup> ed. (2016), § 19 mn. 7, attached as Exhibit 19*. Under German law, the rights to an invention cannot come into existence for a legal entity, as for instance a limited liability company, directly. *Kraßer/Ann Patentrecht [Patent Law], 7<sup>th</sup> ed. (2016), § 19 mn. 10, Exhibit 19*. Thus, the basic rule under German law is very similar to US law: An inventor initially owns the invention and the associated rights to it by virtue of the act of creation i.e. as a matter of an inventor's natural right. *Hoppe-Jänisch, IP Assignment Clauses in International Employment Contracts, (2015), page 3, attached as Exhibit 20*.

Legal entities can become the owner of inventor's rights in a derivative manner.

In an employment context, special rules apply. German law does not share US patent law's concept of shop rights or hired-to-invent. Pursuant to Sect. 4(2) of the German Act on Employees' Inventions, all inventions which either result from the employee performing his or her duties or are significantly dependent on the company's experience or works are

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considered employment-related inventions. Employers are entitled to claim the assignment of these rights to them, and thus acquire the right to the invention. *Hoppe-Jänisch, IP Assignment Clauses in International Employment Contracts, (2015), page 4, Exhibit 20.*

Outside an employment context, legal entities can become the owner of an invention by way of contractual agreements, i.e. assignment, or legal succession.

#### 4. Passing on of Dr Mann's inventor's rights to AusBio Europe

In the case at hand, Dr Mann was – by the standards of German employment law – not employed as an employee, but as a director/CEO of AusBio Europe. The employment agreement concluded with Dr Mann does not contain any reference to employment-related provisions of German law, e.g. the law on employee inventions. Therefore, Dr Mann's position cannot be derived from German employee invention law. However, Dr Mann has validly assigned his right in the invention to AusBio Europe.

A competent German court will come to the conclusion that Dr Mann assigned his share in the invention to AusBio Europe by conduct implying an intent, in particular by way of

- his behaviour subsequent to making the invention, in particular his collaboration in the drafting of the patent application;
- his emails to the patent attorney Mr Ganahl dated 6 August 2013 and 7 August 2014, according to which AusBio Europe pays the cost incurred for drafting and filing the European Application and AusBio Yantai shall receive the invoice for drafting and filing the PCT Application.

A competent German court will further take into account that

- Dr Mann was under a contractual obligation to assign the rights to the invention to AusBio Europe, and



- that Dr Mann has subsequently confirmed the assignment of his rights to AusBio Europe.

In detail:

- (i) Dr Mann's behaviour subsequent to making the invention

Dr Mann has repeatedly shown his intent to assign his rights to the invention to AusBio Europe. A German court will consider this behaviour as an implied assignment of Dr Mann's right to the invention to AusBio Europe.

Recently, German courts have defined a very low threshold for assuming an implied assignment of rights in intellectual property. For example, the Federal Court of Justice has held that the priority right concerning a first patent application can be assigned by conduct implying an intent if the owner (merely) informs another employee in the patent department of his employer of the application number of the first patent application. *FCJ, judgment dated 4 September 2018, X ZR 14/17 mn. 71, attached as Exhibit 21*. According to the Federal Court of Justice, the employer may interpret such information as a contractual offer to assign the priority right to the patent application at issue. *Loc. cit.* The Federal Court of Justice held that the inventor may be generally considered to intend providing any support necessary and owed to his or her employer in order to assist in obtaining the patent. *Loc. cit.*

In view of this approach of the German courts to an implied assignment of rights, and against the background of Dr Mann's obligation to assign his rights to the invention to AusBio Europe, a German court will hold that Dr Mann's behaviour subsequent to making the invention resulted in an assignment of the rights to the invention, namely:

- his course of conduct in connection with the drafting of the patent application, in particular as exemplified by the following emails:

- email dated 19 June 2013 to Mr Ganahl announcing the intention to file a patent application for “Sample Carrier Centrifuge”;
  - email dated 29 July 2013 to Dr Heimberg and Mr Ganahl concerning details of the invention;
  - email dated 30 June 2014 to Mr Ganahl according to which AusBio Europe wants to follow Mr Ganahl’s recommendation of a PCT application;
  - email dated 1 August 2014 to Mr Ganahl setting out that Mr Wang is reviewing the patents and consequently a decision can be expected about the content of the PCT application;
  - email dated 7 August 2014 confirming the receipt of Mr Ganahl’s secretary’s email according to which the PCT Application was filed in the name of AusBio Europe and AusBio Yantai on August 6, 2014.
- his emails to the patent attorney Mr Ganahl dated 6 August 2013 and 7 August 2014, according to which AusBio Europe pays the cost incurred for drafting and filing the European Application and AusBio Yantai pays the cost incurred for drafting and filing the PCT Application.

*Emails dated 19 June 2013, attached as Exhibit 22, 29 July 2013, attached as Exhibit 23, 30 June 2014, attached as Exhibit 24, 1 August 2014, attached as Exhibit 25, 7 August 2014, attached as Exhibit 26, 6 August 2014, attached as Exhibit 27, and 7 August 2014, attached as Exhibit 28.*

A competent German court will also take into account that the European and the PCT Application were filed in the name of AusBio Europe and AusBio Yantai, in particular as the filing in the names of AusBio Europe and AusBio Yantai was initiated by Dr Mann. *Declaration of Bernhard Ganahl dated 25 February 2019, attached as Exhibit 29; PCT Request, attached as Exhibit 30; EP application request, attached as Exhibit 31.*

(ii) Dr Mann's obligation to assign his inventor's rights

In his capacity as the CEO of AusBio Europe, Dr Mann was not covered by the rules on employee inventions of the German Employee Invention Act, which would have given AusBio Europe the right to claim the invention as an employer.

However, a director's contract of employment may impose an obligation on him to assign his invention to the company, either in the sense of a complete assignment of rights or in the sense of granting a non-exclusive or exclusive licence. *Düsseldorf Higher Regional Court, judgement dated 28 February 2015, I-2 U 39/12 mn. 67, attached as Exhibit 32*. If the director's employment agreement – as is the case here – does not contain any express provisions to the director's obligation to offer the invention to the company, the hypothetical intent of the parties to the employment agreement must be established. *Loc. cit.* This must be done in accordance with the principles of the complete interpretation of the contract. *Loc. cit.*

In this respect, the entire circumstances of the case must be taken into account. The following aspects speak in favour of the director's obligation to assign his invention:

*First*, a German court will tend to assume an obligation on the part of the director to assign the rights to the invention if, according to his employment agreement, he is appointed, at least inter alia, for the purpose of making and/or managing technical development in the company. *Düsseldorf Higher Regional Court, judgement dated 28 February 2015, I-2U 39/12 mn. 67, Exhibit 32*

In the case at hand, Dr Mann's duties according to § 1(1) of his employment agreement extended to running all operations of AusBio Europe. *Employment Agreement dated March 2013, attached as Exhibit 33*.

According to § 2(1) of AusBio's Articles of Association, this included the development and the trade of medicinal diagnostic products. Therefore, a German court will conclude that it was within Dr Mann's duties of work to make and care for inventions in the field of medicinal diagnostic products. The invention at issue falls into this category because it is directed to a centrifuge that can be used to clean a reaction vessel unit, such as a microtiter plate, as well as for numerous kinds of assays such as blood typing by means of microtiter plates, cellular assays, assays comprising magnetic beads, or PCRs, etc.

*Second*, the court will take into account that the invention is predominantly based on the resources, experience and preparatory work of the company. *Düsseldorf Higher Regional Court, judgement dated 28 February 2015, I-2U 39/12 mn. 67, Exhibit 32.*

In the case at hand, the operations of AusBio Europe were funded by AusBio Yantai, who had invested approximately EUR 3 million in the period of 2012 to 2014 for the purpose of equipping AusBio Europe with the necessary means to fulfil its purpose of developing and trading of medicinal diagnostic products. In particular, AusBio Yantai provided significant technical information and preparatory work, including concerning the proof concept of the prototype, the optimization of the centrifugation speed and timing, cross contamination experiment and analysis, the loading mechanism with a flexible beam, the general user interface and the dump-and-shake method. *Declaration of Zhaoqiang Wang dated 27 February 2019, Exhibit 4.*

Moreover, the costs of the development work conducted by HTI in the amount of approximately EUR 671,605.00 and of technical service and support provided by HTI in the amount of approximately EUR 155,374.00 were borne by AusBio Europe and AusBio Yantai. *Declaration of Zhaoqiang Wang dated 27 February 2019, Exhibit 4.* Equally, the costs of drafting and filing the European Application (as well as the PCT Application) were borne by AusBio Europe and AusBio

*Yantai. Invoice Patronus IP dated 7 August 2013, attached as Exhibit 34; Invoice Patronus IP dated 8 August 2014, attached as Exhibit 35.*

*Third, according to the case-law of the Federal Court of Justice, a German court would view the contractual parties' behaviour as indicative of the parties' legal relationship. FCJ, decision dated 16 October 1997, IX ZR 164/96, NJW-RR 1998, 259, attached as Exhibit 36. Accordingly, a German court would consider who decided about filing a patent application for a certain technical development as indicative of who controlled, and therefore, had rights in the filed application. In the case at hand, as in all other cases in AusBio Europe, the decision to file patent applications was taken by Mr Wang pursuant to his position as director/CEO of AusBio Yantai, who was the only shareholder of AusBio Europe. Declaration of Zhaoqiang Wang dated 27 February 2019, Exhibit 4. A German court would interpret this as a very strong indicator that Dr Mann himself accepted his obligation to assign his rights to inventions made by him to AusBio Europe. Otherwise, he would not have assumed a subordinate position in these decisions.*

For these reasons, a German court would hold that Dr Mann had an obligation to assign his rights to AusBio Europe.

(iii) Dr Mann's confirmation of the assignment of rights

A German court will hold that Dr Mann confirmed the assignment of his inventor's rights to AusBio Europe by entering into the License Agreement with BlueCatBio on October 3, 2014. The court will consider this confirmation to be persuasive evidence as to the actual assignment of the rights to the invention to AusBio Europe. As explained below, by entering into the license agreement on behalf of AusBio Europe, and not himself, Dr Mann illustrated his intent and understanding that his rights in the invention were assigned to AusBio Europe.

The preamble of the License Agreement, inter alia, states:

*“AusBio and AusBio Laboratories have jointly developed instruments for centrifugation that are based on a horizontal centrifugation axis.*

*AusBio has filed a patent application PCT/EP2014/066497 titled ‘Centrifuge and Method for Centrifuging a Reaction Vessel Unit’ and an EO 13 179 437.2 with the same title that describe centrifugation of microtiterplates in SBS format based on the horizontal rotation axis.”*

Based on this preamble, § 2 of the License Agreement contains the granting of a license concerning Licensed Products to the benefit of BlueCatBio. According to § 1 of the License Agreement, the Licensed Products include any and all products which make use of at least one claim of one of the aforementioned patent rights, which includes the PCT Application. Further, according to § 6 of the License Agreement, AusBio Europe shall assure its ownership of these rights and its entitlement to freely dispose thereof. The License Agreement was signed by Dr Mann in his capacity as the CEO of AusBio Europe.

The License Agreement provides persuasive evidence that the rights in the underlying inventions, as regards Dr Mann’s share, were assigned to AusBio Europe prior to the signing of the License Agreement. The License Agreement is a private document within the meaning of Sect. 416 German Code of Civil Procedure. *Sect. 416 German Code of Civil Procedure, attached as Exhibit 37.* Pursuant to Sect. 416 German Code of Civil Procedure, private documents shall establish full proof that the declarations they contain have been made by the parties who prepared such records and documents to the extent that such private documents are signed by the parties issuing them, or have been signed using a mark that has been certified by a notary. Moreover, according to the case-law of the German Federal Court of Justice, such documents – depending on their contents – are also suitable, alone or in connection with other circumstances, for

obtaining the conviction that the facts or processes attested in the document are true. *FCJ decision of 13 April 1988, VIII ZR 274/87, NJW 1988, 2741, attached as Exhibit 38.*

In the case at hand, a German court will consider the confirmation of AusBio's ownership given by Dr Mann in the License Agreement in light of Dr Mann's previous behaviour in the process of drafting and filing the European Application and the PCT Application and of his existing contractual obligation to assign his right as persuasive evidence that Dr Mann has actually assigned his right to the invention to AusBio Europe.

5. Assignment of rights of Dr Heimberg to HTI

The employment agreement of Dr Heimberg is not available to the applicant. Therefore, the applicant cannot assess an assignment of inventor's rights from Dr Heimberg to HTI by virtue of the employment agreement. However, this does not affect the present analysis because, as explained in Sections 6 and 7 below, the Development Agreement and Dr Heimberg's subsequent behaviour show that the rights in the invention were transferred to AusBio Europe by Dr Heimberg and HTI.

6. Assignment of rights of HTI to AusBio Europe

With regards to the invention at issue, a competent German court will hold that HTI has assigned any rights to the invention to AusBio Europe by virtue of the Development Agreement for the following reasons:

The Development Agreement contains an express provision stating that the rights in any development made under the Agreement shall vest in AusBio Europe. According to Annex A of the Development Agreement, *Exhibit 3*, this includes the centrifuge project on which the invention at issue is based. Annex A specifies the project "*Development of a centrifuge/washer for microtiter plates based on a horizontal rotational axis*" ("*Entwicklung einer Zentrifuge / eines Washers für Mikrotiterplatten basierend auf einer horizontalen Rotationsachse*"). According to Sect. 2(2) of the Development

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Agreement, HTI and AusBio Europe agreed that any protective right resulting from the development work, as a matter of principle, shall be owned by AusBio Europe. See Sect. 2(2) of the Development Agreement (*“any protective right resulting from the development work, as a matter of principle, shall be owned by AusBio Europe”*).

A competent German court will interpret Sect. 2(2) to cause an immediate assignment of the inventor’s rights to AusBio Europe once the invention has been made. Specifically, according to German law, a distinction is made between a transaction imposing a legal obligation (e.g. an obligation to assign the rights to a future invention) and a transaction performing a legal obligation (e.g. the assignment itself). *Benkard, Patentgesetz [German Patent Act], 11<sup>th</sup> ed. (2015), § 15 mn. 15, 16, attached as Exhibit 39*. In the case at hand, the language of the Development Agreement performed the assignment of the invention to AusBio Europe, and a separate act was not required to assign the inventor’s rights in the invention to AusBio Europe. Therefore, a German court would consider the Development Agreement to order an immediate transfer of the inventor’s rights to AusBio Europe.

The language of Sect. 2(2) of the Development Agreement (*“any protective right resulting from the development work, as a matter of principle, shall be owned by AusBio Europe”*) does not suggest a different interpretation. One may argue that the Development Agreement does not make entirely clear which impact the caveat “as a matter of principle” may have. However, as explained below, it is clear from the language of the Development Agreement and the circumstances that the invention at issue was not subject to such caveat.

The Development Agreement was supposed to be the basis for an ongoing working relationship between HTI and AusBio Europe. This becomes clear from the title of the document (*“Agreement on the cooperation of various development projects”*) and the preamble, which refers to the Development Agreement as a framework agreement for the parties’ collaboration, and Sect. 1 of the Development Agreement, according to which the parties intend a long-term working relationship for developments in various fields. Against



this background, a German court may give the caveat “as a matter of principle” certain weight with regards to future development projects. However, it will not relate the caveat to the development project at issue, which had already been agreed in detail according to Annex A to the Development Agreement.

Moreover, the Development Agreement prevents HTI from disclosing the development results and using them for an own application for a protective right, e.g. a patent. According to Sect. 3(1) of the Development Agreement, HTI and AusBio Europe must keep confidential all information of a technical or commercial nature, intentions, experience, findings, constructions and documents, including pre-existing results, of which they become aware as a result of the collaboration under the Development Agreement; Such information must not be used for an own application for a protective right (*Original German text of Sect. 3(1) of the Development Agreement: Die Vertragspartner verpflichten sich, die Arbeitsergebnisse des anderen Partners sowie alle sonstigen Informationen, insbesondere technischer und wirtschaftlicher Art, Absichten, Erfahrungen, Erkenntnisse, Konstruktionen und Unterlagen, einschließlich der Vorbestehenden Ergebnisse, die ihnen aufgrund der Zusammenarbeit gemäß dieses Vertrages bekannt werden (zusammen “Information” genannt), Dritten gegenüber – auch über die Dauer des Vertrages hinaus – vertraulich zu behandeln, Dritten nicht zugänglich zu machen, vor dem Zugriff Dritter zu schützen sowie nicht zum Gegenstand einer eigenen Schutzrechtsanmeldung zu machen*). In view of the allocation of the inventor’s rights to AusBio Europe in Sect. 2(2), it is clear that the prohibition of filing an own patent application contained in Sect. 3(1) of the Development Agreement applies to HTI. Accordingly, for the reasons set forth above, a German court would consider the fact that HTI does not have the right to file a patent application according to Sect. 3(1) of the Development Agreement as a supporting argument to hold that any of HTI’s rights to the invention at issue will have immediately passed on to AusBio Europe once the invention has been created.

7. Power of HTI to assign Dr Heimberg's rights to the invention

A German court would also hold that HTI had the power to assign Dr Heimberg's rights to the invention to AusBio Europe irrespective of the contents of the employment agreement between Dr Heimberg and HTI. The court would base this conclusion on three points.

*First*, Dr Heimberg signed the Development Agreement knowing that proper performance of the agreement requires that the rights of inventors at HTI, including employees and the CEO, are made available to HTI. If Dr Heimberg had signed the Development Agreement with the intention not to enable HTI to perform it properly, this would have constituted fraud according to Sect. 263 German Criminal Code.

*Second*, Dr Heimberg has collaborated in the drafting and application process in that he provided the drawings to the European and the PCT Application, in particular with an email dated 10 September 2014 instructing Mr Stefan Andrasic to provide drawings for the PCT Application. *Email dated 10 September 2014, Exhibit 40.*

By providing the drawings, Dr Heimberg has shown and confirmed his intent to empower HTI to assign his right to the invention to AusBio Europe. For the reasons explained below, a German court will consider this behaviour as an implied assignment of Dr Heimberg's right to the invention to AusBio Europe. As pointed out before, German courts have defined a very low threshold for assuming an implied assignment of rights in intellectual property. The Federal Court of Justice has held that an inventor has an interest to give any required support to his employer in order to enable him to file a valid patent application. Therefore, any support provided by an employed inventor in connection with the filing of a patent application may be considered a confirmation of the employee's intent to assign the necessary rights to the employer. *FCJ, judgment dated 4 September 2018, X ZR 14/17 mn. 71, Exhibit 21.* Against this background, a competent German court would interpret Dr Heimberg's behaviour as an implied assignment of his rights to HTI, as otherwise he would make himself liable for non-performance of his contractual duties.

In view of this generous approach of the German courts to an implied assignment of rights, and against the background of HTI's obligation to assign the rights to the invention to AusBio Europe, a German court will hold that Dr Heimberg's behaviour subsequent to making the invention resulted in an assignment of the rights to the invention to HTI, empowering HTI to pass the rights on to AusBio Europe. A German court would also take into account that Dr Heimberg knew that the European Application will be filed in the name of AusBio Europe and AusBio Yantai, and still decided to support the application process. *Declaration of Bernhard Ganahl, Exhibit 29.*

*Third*, as explained below, a German court would take into account that HTI's business is the provision of development services to its customers. As the customers pay HTI for the unhindered use of the development results, this requires in any event that the rights to inventions made in the course and as a result of the development are first assigned to HTI and then, either automatically or by virtue of a separate transaction, assigned to the customers. Therefore, a German court would be considerably observant to any behaviour of Dr Heimberg that may be interpreted as an implied assignment to HTI. Against this background, a German court would consider Dr Heimberg's behaviour from the perspective of a reasonable customer who, in view of HTI's business model and Dr Heimberg's position at HTI, would consider any behaviour in support of a patent application as an implied assignment. In particular, a German court would take into account that Dr Heimberg, as the CEO of HTI, has issued invoices for the development work and technical service and support in the amount of approximately EUR 827.000 and has accepted the payment of these invoices. A German court would further take into account that Dr Heimberg is the majority owner of HTI and therefore has a direct commercial benefit from these payments. The invoices covered the development work as well as AusBio Europe's right to exploit the development work, in particular to obtain patent protection for it. If Dr Heimberg had had a mental reservation against the passing on of all intellectual property rights in the invention, he would have needed to communicate this. If he had been of the opinion that he does not want to transfer the rights in the invention to AusBio Europe and that he will not effect

such transfer, the issuing of the invoices and the acceptance of the payment would have amounted to fraud according to Sect 263 Criminal Code

8. Assignment of rights of AusBio Europe to AusBio Yantai

A competent German court will hold that AusBio Europe has assigned its rights to the invention underlying the PCT Application to AusBio Yantai by virtue of the Declaration of Assignment.

Under German law, a distinction is made between a transaction imposing a legal obligation (e.g. an obligation to assign the rights to an invention) and a transaction performing a legal obligation (e.g. the assignment itself). With regard to the obligation to assign the rights to the invention underlying the PCT Application, the Declaration of Assignment complies with the requirements of the applicable German law and, therefore, may also have led to the assignment of those rights itself.

However, as far as the performance and the validity of the assignment of the US national part of the PCT Application, namely the US Application, is concerned, it is the author's understanding that US law is applicable. The validity of the assignment under US law is outside the scope of this memorandum. It is the author's understanding that the validity of the assignment under US law is being addressed in the Petition submitted concurrently herewith.

9. Conclusion

It follows from the above that all rights in the invention underlying the PCT Application, and consequently the ownership of the PCT Application itself, are owned by AusBio Yantai.

AusBio Yantai has acquired Mr Wang's share of the invention by assignment of Mr Wang. Moreover, AusBio Yantai has acquired Dr Mann's and Dr Heimberg's share by assignment from AusBio Europe.

AusBio Europe had obtained Dr Mann's share by way of implied assignment from Dr Mann. Moreover, AusBio Europe had obtained Dr Heimberg's share

Legal Memorandum  
Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/910,681

Page 23 of 24

**PATENT**  
**REEL: 049669 FRAME: 0040**

by way of assignment contained in the Development Agreement between HTI and AusBio Europe.

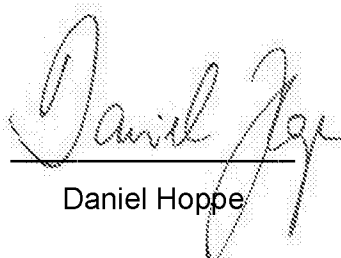
HTI Europe had obtained Dr Heimberg's share by way of assignment from Dr Heimberg himself. This assignment has taken place either expressly between Dr Heimberg and HTI or, at the latest, by way of an implied assignment in the process of drafting and filing the PCT Application.

Therefore, any competent German court would come to the conclusion that AusBio Yantai is the sole owner of the inventors' rights in the invention at issue and the owner of the PCT Application.

#### IV. Declaration of Truthfulness

I, the above-named author of this memorandum, hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that wilful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States

Executed on this 6th day of March, 2019.



Daniel Hoppe

A n n e x

to the deed of notary Hendrik Zuber in Bayreuth, Germany  
dated                   , deed no.       Z/2012  
.....

B y l a w s

Article 1

Company Name and Place of Business

The company name is:

AusBio R&D Europe GmbH

The company has its place of business in Kulmbach, Germany.

Article 2

Object of the Company

The object of the company is the development and  
distribution of products for medical diagnostics and any  
associated activities.

The company is entitled to acquire companies of the same or  
similar type, to obtain an interest in them or to take over  
their representation or business management.

[Articles 3 through 17 not translated]

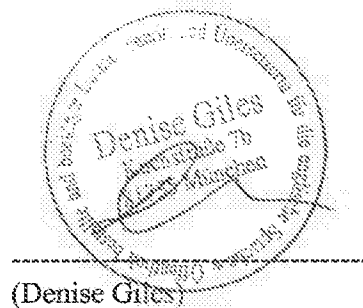
## ATTESTATION CLAUSE:

In my capacity as a translator for the English language, duly appointed, commissioned and sworn in by the Munich Regional Court I in the German federal state of Bavaria, I hereby certify to the best of my belief that the foregoing is a true and complete English translation of the original document in the German language submitted to me as a copy.

IN WITNESS WHEREOF I have hereunder set my hand and seal at

Munich, February 27, 2019

Denise Giles  
Kuenstraße  
81735 Munich  
Germany



Annex

to the deed of the notary Hendrik Zuber in Bayreuth  
from , deed no.. Z/2012

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Bylaws

§ 1

Company Name and Place of Business

The name of the company is:

AusBio R&D Europe GmbH

The registered office of the company is in Kulmbach.

§ 2

Object of the company

The object of the company is the development of and  
distribution of products for medical diagnostic and any  
associated activities.

The Company is entitled to acquire companies of the  
same or similar type, to obtain an interest in them or  
to take over their representation or business  
management.



§ 3

Capital stock and capital contributions

The share capital of the company amounts to  
25.000,00 EUR  
-twenty-five thousand euros.

The entire share capital of the company, i.e. share 1  
with a nominal value of EUR 25,000.00, is assumed by  
YANTAI AUSBIO Labors Ltd. with the seat in Yantai  
city.

The payment for the share must be made in cash.

It shall be payable in full immediately.

§ 4

Duration of the Company, Termination, Fiscal Year

The company has been established for an indefinite  
period of time.

Each shareholder is entitled to terminate the company  
at the end of a financial year by giving six months'  
notice. The company is not dissolved by the termination  
of a shareholder. Rather, the terminating shareholder  
withdraws from the company.

Notice of termination must be given by registered  
letter to the other shareholders. The date of the  
postmark decides whether the deadline has been met.

The fiscal year is the calendar year.

§ 5

Disposal of business shares and  
assignment of claims

The sale and encumbrance of shares or parts of shares requires the consent of the Company, which may only be granted on the basis of a corresponding shareholder resolution.

The same applies to the assignment and pledging of claims arising from the participation in the company, such as claims to profits, liquidation proceeds and compensation credit balances.

§ 6

Management and representation

The company has one or more managing directors. If there is only one managing director, he represents the company alone.

If there are several managing directors, the company is represented by two managing directors jointly or by one managing director together with an authorized signatory.

The shareholders' meeting has the right to grant the managing directors or individual managing directors sole power of representation.

The shareholders' meeting is also authorized to exempt managing directors from the restrictions of § 181 BGB (German Civil Code).

The above shall apply mutatis mutandis to liquidators.

§ 7

general meeting

The shareholders' meeting is convened by the managing directors in an authorized number.

It shall be convened within six months of the end of a financial year for the purpose of approving the annual financial statements of the Company, passing resolutions on the appropriation of profits and granting discharge to the management.

It shall also be convened if a resolution of the shareholders becomes necessary or if the convening is in the urgent interest of the Company for any other reason.

In addition, each shareholder has the right to demand the convening of the meeting, stating the purpose and reasons.

All shareholders must be summoned by registered letter. The invitation period is two weeks, whereby the day of the invitation and the day of the meeting are not to be counted.

The place, time and agenda of the meeting must be stated in the invitation.

If all shareholders agree, resolutions may be passed in any manner, in particular in writing, by fax, e-mail or telephone. Shareholders' resolutions must always be recorded in writing.

Resolutions of the shareholders' meeting shall be passed by a simple majority of the votes cast, unless a larger majority is required by law or these Articles of Association.

Each EUR 1.00 of a share entitles the holder to one vote.

Unless mandatory law provides otherwise, erroneous resolutions may only be challenged within a period of two months from receipt of the minutes and only by shareholders who have appeared or been represented at the shareholders' meeting and have objected to the resolution for the minutes or who have not appeared or been represented at the shareholders' meeting if they have not been wrongly admitted or if the meeting has not been properly convened or the subject of the resolution has not been properly announced.

§ 8

contest

Outside the object of the enterprise (§ 2) each partner may be arbitrarily commercially active. If a shareholder who is also a managing director makes use of this right, this must be taken into account in his managing director remuneration.

Within the purpose of the company (§ 2), a shareholder may only be active if this is expressly permitted by a unanimous shareholder resolution. In the course of this authorization, a possible fee for the authorization of competitive transactions shall also be determined.

§ 9

annual financial statement

The balance sheet, the income statement including any necessary notes and, if applicable, a management report shall be prepared within the period specified in Section 264 (1) HGB and submitted to the shareholders without delay.

Accounting and reporting must be carried out in accordance with commercial and tax regulations.

§ 10

appropriation of profits

The shareholders' meeting decides at its own discretion on the appropriation of the annual balance sheet profit. If profit is distributed, it shall be distributed among the shareholders in proportion to their shares.

Advance distributions on the expected profit for the current financial year can be resolved before the end of the financial year.

§ 11

Death of a shareholder

The inheritance of shares is not restricted.

However, the other shareholders may decide that the heirs of a deceased shareholder, unless they are co-partners, spouses or descendants of the deceased shareholder, shall leave the company at the end of the financial year in which the shareholder died or at the end of the following financial year. The heirs have no voting rights in this resolution.

If the successors of the deceased shareholder remain in the company, they are obliged to immediately appoint a joint proxy to exercise their shareholder rights. The vote shall be suspended until the proxy has been appointed.

This does not apply if the shares of the retired shareholder are administered by an executor.

§ 12

Withdrawal from the Company  
for any other reason

In addition to the cases specified in § 4 and § 11, a shareholder also withdraws from the company if

- a) the shareholder has filed an application to open insolvency proceedings against his assets;
- b) insolvency proceedings are opened against the assets of the shareholder at the request of a third party or are not opened due to lack of assets;
- c) the shareholder's share is seized, unless the seizure is revoked within thirty days;
- d) the shareholder's share has been transferred to a third party by way of levy of execution or in insolvency proceedings against its assets;
- e) the shareholder must affirm the correctness of his list of assets in lieu of an oath;
- f) there is another important reason in his person which makes it unreasonable for the other shareholders to continue the company relationship with him.

§ 13

Carrying out the withdrawal

The share of a withdrawing shareholder shall, at the discretion of the shareholders' meeting, be withdrawn, assigned to the company, the shareholders or to third parties determined by the shareholders' meeting. The withdrawing shareholder shall have no voting rights in respect of any resolutions in connection with his withdrawal.

If the shareholders' meeting does not decide otherwise within two months of the occurrence of the circumstance leading to the withdrawal of the shareholder, all other shareholders are entitled to an acquisition right to the share of the withdrawing shareholder in proportion to their shareholding in the company.

If a shareholder does not exercise his purchase right, the other shareholders are entitled to it in proportion to their shareholding in the company.

If a resignation in accordance with the aforementioned provisions does not take place, the Company shall be dissolved.

§ 14

severance pay

If a shareholder leaves the company, he receives a severance payment.



- (1) The severance payment shall be 40% of the value determined for the participation of the withdrawing shareholder for inheritance tax purposes by applying the simplified capitalized earnings value method to determine the fair market value of unlisted shares in corporations and business assets in accordance with Sections 199 - 203 of the FL, as amended, as of the valuation date. The valuation date is 31.12., which precedes or coincides with the date of retirement.

The shareholders agree that §§ 199 - 203 BewG only serve to simplify the valuation and lead to a significant overvaluation for small and medium-sized enterprises in the fiscal interest; this fact and the continued interest of the enterprise are taken into account by the flat-rate discount according to p. 1.

- (2) The severance payment shall be paid to the withdrawing shareholder in three equal annual instalments, the first half a year after the date of the withdrawal. The outstanding amount shall bear interest at three percentage points above the base interest rate in accordance with § 247 BGB (German Civil Code). No collateral can be required for this.

(3) The severance payment shall be determined by the Company's tax advisor. In the event of a dispute, an independent auditor (auditing company) acts as a binding arbitrator for all parties involved. If no agreement can be reached on the person of the arbitrator, the latter shall be determined by the President of the Chamber of Industry and Commerce for Upper Franconia in Bayreuth upon written application of the Company and/or the withdrawing shareholder. The costs of the arbitrator shall be borne equally by the Company and the withdrawing shareholder.

§ 15

Announcements of the Company

Announcements of the Company shall, to the extent required by law, only be made through the electronic Federal Gazette (elektronischer Bundesanzeiger).

§ 16

Severability clauses

As far as in this contract there are no special provisions the statutory provisions shall apply in addition.

Should individual provisions of these Articles of Association be or become invalid, this shall not affect the validity of the remaining provisions.

In this case, however, the shareholders are obliged to cooperate immediately in the creation of a legally effective provision that corresponds to the purpose and economic significance of the invalid provision or comes as close as possible to it.

§ 17

bearing of costs

The company assumes the formation expenses (costs of drawing up the articles of association, entry in the register and publication) up to an amount of 2,500.00 euros.

The Company shall also bear all costs associated with future capital increases.

A n l a g e  
zur Urkunde des Notars Hendrik Zuber in Bayreuth  
vom                   , URNr.           Z/2012  
-----

## S a t z u n g

### § 1

#### Firma und Sitz

Die Firma der Gesellschaft lautet:

AusBio R&D Europe GmbH

Sitz der Gesellschaft ist Kulmbach.

### § 2

#### Gegenstand des Unternehmens

Gegenstand des Unternehmens ist die Entwicklung von und der Handel mit medizinisch diagnostischen Produkten und alle damit zusammenhängende Tätigkeiten.

Die Gesellschaft ist berechtigt, gleichartige oder ähnliche Unternehmen zu erwerben, sich daran zu beteiligen oder ihre Vertretung oder Geschäftsführung zu übernehmen.

§ 3

**Stammkapital und Stammeinlagen**

Das Stammkapital der Gesellschaft beträgt

25.000,00 EUR

-fünfundzwanzigtausend Euro-.

Den das gesamte Stammkapital der Gesellschaft ausmachenden Geschäftsanteil 1 mit einem Nennbetrag in Höhe von 25.000,00 Euro übernimmt

YANTAI AUSBIO Labors GmbH. mit dem Sitz in Yantai Stadt.

Die Einzahlung auf den Geschäftsanteil hat in Geld zu erfolgen.

Sie ist sofort in voller Höhe zu leisten.

§ 4

**Dauer der Gesellschaft, Kündigung, Geschäftsjahr**

Die Gesellschaft ist auf unbestimmte Zeit errichtet.

Jeder Gesellschafter ist befugt, die Gesellschaft unter Einhaltung einer Kündigungsfrist von sechs Monaten zum Schluss eines Geschäftsjahres zu kündigen. Durch die Kündigung eines Gesellschafters wird die Gesellschaft nicht aufgelöst. Der kündigende Gesellschafter scheidet vielmehr aus der Gesellschaft aus.

Die Kündigung hat durch eingeschriebenen Brief gegenüber den anderen Gesellschaftern zu erfolgen. Über die Fristwahrung entscheidet das Datum des Poststempels.

Das Geschäftsjahr ist das Kalenderjahr.

§ 5

**Veräußerung von Geschäftsanteilen und  
Abtretung von Ansprüchen**

Die Veräußerung und Belastung von Geschäftsanteilen oder Teilen von Geschäftsanteilen bedarf der Zustimmung der Gesellschaft, die nur aufgrund eines entsprechenden Gesellschafterbeschlusses erteilt werden darf.

Das gleiche gilt für die Abtretung und Verpfändung von aus der Gesellschaftsbeteiligung fließenden Ansprüchen, wie Ansprüche auf Gewinn, Liquidationserlös und Abfindungsguthaben.

§ 6

**Geschäftsführung und Vertretung**

Die Gesellschaft hat einen oder mehrere Geschäftsführer. Ist nur ein Geschäftsführer vorhanden, vertritt er die Gesellschaft allein.

Sind mehrere Geschäftsführer vorhanden, wird die Gesellschaft durch zwei Geschäftsführer gemeinsam oder durch einen Geschäftsführer in Gemeinschaft mit einem Prokuristen vertreten.

Die Gesellschafterversammlung hat das Recht, den Geschäftsführern oder einzelnen von ihnen Einzelvertretungsbefugnis zu erteilen.

Die Gesellschafterversammlung ist weiterhin befugt, Geschäftsführer von den Beschränkungen des § 181 BGB zu befreien.

Vorstehendes gilt entsprechend für Liquidatoren.

#### § 7

#### Gesellschafterversammlung

Die Gesellschafterversammlung wird durch die Geschäftsführer in vertretungsberechtigter Zahl einberufen.

Sie ist einzuberufen innerhalb von sechs Monaten seit Beendigung eines Geschäftsjahres zum Zwecke der Genehmigung des Jahresabschlusses der Gesellschaft, zur Beschlussfassung über die Gewinnverwendung und über die Entlastung der Geschäftsführung.

Sie ist weiter einzuberufen, wenn eine Beschlussfassung der Gesellschafter erforderlich wird oder die Einberufung aus einem sonstigen Grund im dringenden Interesse der Gesellschaft liegt.

Darüber hinaus hat jeder Gesellschafter das Recht, unter Angabe des Zwecks und der Gründe die Einberufung der Versammlung zu verlangen.

Alle Gesellschafter sind mittels eingeschriebenen Briefes zu laden. Die Ladungsfrist beträgt zwei Wochen, wobei der Tag der Ladung und der Tag der Versammlung nicht mit zu rechnen sind.

Tagungsort, Tagungszeit und Tagesordnung sind in der Ladung mitzuteilen.

Sind alle Gesellschafter einverstanden, so können Beschlüsse in jeder beliebigen Weise, insbesondere schriftlich, durch Telefax, E-Mail oder telefonisch gefasst werden. Gesellschafterbeschlüsse sind in jedem Fall schriftlich niederzulegen.

Die Beschlüsse der Gesellschafterversammlung werden mit einfacher Mehrheit der abgegebenen Stimmen gefasst, soweit nicht das Gesetz oder diese Satzung eine größere Mehrheit zwingend vorschreiben.

Je 1,-- EUR eines Geschäftsanteils gewähren eine Stimme.

Soweit dem zwingendes Recht nicht entgegensteht, können fehlerhafte Beschlüsse nur innerhalb einer Frist von zwei Monaten seit Zugang der Niederschrift und nur von Gesellschaftern angefochten werden, die in der Gesellschafterversammlung erschienen oder vertreten waren und dem Beschluss zur Niederschrift widersprochen haben oder die in der Gesellschafterversammlung nicht erschienen oder vertreten waren, wenn sie zu Unrecht nicht zugelassen wurden oder die Versammlung nicht ordnungsgemäß einberufen oder der Gegenstand der Beschlussfassung nicht ordnungsgemäß bekannt gemacht worden ist.



§ 8

Wettbewerb

Außerhalb des Gegenstandes des Unternehmens (§ 2) darf jeder Gesellschafter beliebig gewerblich tätig sein. Macht ein Gesellschafter, der zugleich Geschäftsführer ist, von diesem Recht Gebrauch, ist dies bei seiner Geschäftsführervergütung zu berücksichtigen.

Innerhalb des Gesellschaftszweckes (§ 2) darf ein Gesellschafter nur tätig sein, wenn ihm dies durch einstimmigen Gesellschafterbeschluss ausdrücklich gestattet ist. Im Zuge dieser Gestattung ist auch ein etwaiges Entgelt für die Zulassung von Konkurrenzgeschäften festzulegen.

§ 9

Jahresabschluss

Die Bilanz, die Gewinn- und Verlustrechnung samt etwa erforderlichem Anhang und gegebenenfalls ein Lagebericht sind innerhalb der in § 264 Abs. 1 HGB genannten Frist aufzustellen und den Gesellschaftern unverzüglich vorzulegen.

Buchführung und Bilanzierung haben nach handels- und steuerrechtlichen Vorschriften zu erfolgen.

§ 10

Gewinnverwendung

Die Gesellschafterversammlung beschließt nach freiem Ermessen über die Verwendung des jährlichen Bilanzgewinns. Wird Gewinn ausgeschüttet, so ist dieser auf die Gesellschafter im Verhältnis ihrer Geschäftsanteile zu verteilen.

Vorabausschüttungen auf den zu erwartenden Gewinn des laufenden Geschäftsjahres können bereits vor dessen Ablauf beschlossen werden.

§ 11

Tod eines Gesellschafters

Die Vererbung der Geschäftsanteile ist nicht eingeschränkt.

Die anderen Gesellschafter können aber beschließen, dass die Erben eines verstorbenen Gesellschafters, sofern sie nicht Mitgesellschafter, Ehegatte oder Abkömmlinge des verstorbenen Gesellschafters sind, zum Ende des Geschäftsjahres, im dem der Gesellschafter verstorben ist, oder zum Ende des darauf folgenden Geschäftsjahres, aus der Gesellschaft ausscheiden. Die Erben haben bei dieser Beschlussfassung kein Stimmrecht.

Verbleiben die Nachfolger des verstorbenen Gesellschafters in der Gesellschaft, so sind sie verpflichtet, unverzüglich einen gemeinsamen Bevollmächtigten zu bestimmen, der ihre Gesellschafterrechte wahrnimmt. Bis zur Bestimmung des Bevollmächtigten ruht das Stimm-

recht. Dies gilt nicht, wenn die Geschäftsanteile des ausgeschiedenen Gesellschafters durch einen Testamentsvollstrecker verwaltet werden.

§ 12

Ausscheiden aus der Gesellschaft  
aus einem sonstigen Grunde

Ein Gesellschafter scheidet neben den in § 4 und § 11 genannten Fällen außerdem aus der Gesellschaft aus, wenn

- a) der Gesellschafter Antrag auf Eröffnung des Insolvenzverfahrens über sein Vermögen gestellt hat;
- b) auf Antrag eines Dritten das Insolvenzverfahren über das Vermögen des Gesellschafters eröffnet oder mangels Masse nicht eröffnet wird;
- c) der Geschäftsanteil des Gesellschafters gepfändet wird, es sei denn, die Pfändung wird innerhalb von dreißig Tagen wieder aufgehoben;
- d) der Geschäftsanteil des Gesellschafters im Wege der Zwangsvollstreckung oder im Insolvenzverfahren über sein Vermögen an einen Dritten gelangt ist;
- e) der Gesellschafter die Richtigkeit seines Vermögensverzeichnisses an Eides Statt zu versichern hat;
- f) in seiner Person ein sonstiger wichtiger Grund eintritt, der den anderen Gesellschaftern die Fortsetzung des Gesellschaftsverhältnisses mit ihm unzumutbar macht.

§ 13

Durchführung des Ausscheidens

Der Geschäftsanteil eines ausscheidenden Gesellschafters ist nach Wahl der Gesellschafterversammlung einzuziehen, an die Gesellschaft, die Gesellschafter oder auf von der Gesellschafterversammlung bestimmte Dritte abzutreten. Der ausscheidende Gesellschafter hat bei allen mit seinem Ausscheiden zusammenhängenden Beschlüssen kein Stimmrecht.

Trifft die Gesellschafterversammlung innerhalb von zwei Monaten nach Eintritt des Umstandes, der zum Ausscheiden des Gesellschafters führt, keine andere Wahlentscheidung, so steht allen anderen Gesellschaftern im Verhältnis ihrer Beteiligung an der Gesellschaft ein Erwerbsrecht am Geschäftsanteil des ausscheidenden Gesellschafters zu.

Macht ein Gesellschafter von seinem Erwerbsrecht keinen Gebrauch, so wächst es den anderen Gesellschaftern im Verhältnis ihrer Beteiligung an der Gesellschaft zu.

Kommt ein Ausscheiden nach den vorgenannten Bestimmungen nicht zustande, wird die Gesellschaft aufgelöst.

§ 14

Abfindung

Scheidet ein Gesellschafter aus der Gesellschaft aus, erhält er eine Abfindung.

- (1) Als Abfindung sind 40 v.H. desjenigen Werts zu vergüten, der für die Beteiligung des ausscheidenden Gesellschafters für erbschaftsteuerliche Zwecke durch Anwendung des vereinfachten Ertragswertverfahrens zur Ermittlung des gemeinen Wertes von nichtnotierten Anteilen an Kapitalgesellschaften und Betriebsvermögen gemäß §§ 199 - 203 BewG in ihrer aktuellen Fassung zum Bewertungsstichtag ermittelt wird. Bewertungsstichtag ist der 31.12., der dem Tag des Ausscheidens vorangeht oder mit diesem zusammenfällt.

Die Gesellschafter sind sich darüber einig, dass §§ 199 - 203 BewG nur der Bewertungsvereinfachung dienen und für kleine mittelständische Unternehmen im fiskalischen Interesse zu einer deutlichen Überbewertung führen; dieser Tatsache und dem Fortbestandsinteresse des Unternehmens wird durch den pauschalen Abschlag gem. S. 1 Rechnung getragen.

- (2) Die Abfindung ist dem ausscheidenden Gesellschafter in drei gleichen Jahresraten auszahlbar, die erste ein halbes Jahr nach dem Zeitpunkt des Ausscheidens. Der jeweils ausstehende Betrag ist mit drei Prozentpunkten über dem Basiszinssatz gemäß § 247 BGB zu verzinsen. Sicherheiten dafür können nicht verlangt werden.

(3) Die Ermittlung der Abfindung erfolgt durch den Steuerberater der Gesellschaft. Im Streitfall erfolgt sie durch einen unabhängigen Wirtschaftsprüfer (Wirtschaftsprüfungsgesellschaft) als Schiedsgutachter für alle Beteiligten verbindlich. Kann über die Person des Schiedsgutachters kein Einvernehmen erzielt werden, so wird dieser auf schriftlichen Antrag der Gesellschaft und/oder des ausscheidenden Gesellschafters durch den Präsidenten der IHK für Oberfranken in Bayreuth bestimmt. Die Kosten des Schiedsgutachters tragen die Gesellschaft und der ausscheidende Gesellschafter zu gleichen Teilen.

#### § 15

##### Bekanntmachungen der Gesellschaft

Bekanntmachungen der Gesellschaft erfolgen, soweit sie gesetzlich vorgeschrieben sind, nur durch den elektronischen Bundesanzeiger.

#### § 16

##### Salvatorische Klauseln

Soweit in diesem Vertrag nicht spezielle Bestimmungen getroffen wurden, gelten ergänzend die gesetzlichen Bestimmungen.

Sollten einzelne Bestimmungen dieser Satzung unwirksam sein oder werden, so soll dadurch die Wirksamkeit der übrigen Bestimmungen nicht berührt werden.

In diesem Fall sind jedoch die Gesellschafter verpflichtet, unverzüglich bei der Schaffung einer rechtswirksamen Regelung mitzuwirken, die dem Zweck und der wirtschaftlichen Bedeutung der unwirksamen Bestimmung entspricht oder möglichst nahekommt.

**§ 17**

**Kostentragung**

Die Gesellschaft übernimmt den Gründungsaufwand (Kosten der Errichtung des Gesellschaftsvertrages, der Registereintragung und der Veröffentlichung) bis zu einem Betrag von 2.500,00 Euro.

Die Gesellschaft trägt auch sämtliche mit künftigen Kapitalerhöhungen in Verbindung stehende Kosten.

**Certified translation from German**

Commercial Register B of the Local Court of Bayreuth

Called up on March 1, 2019, 10:29 a.m.

Number of company:  
Page 1 of 1

HRB 1 5623

Number of entry	a) Business name b) Place of business, branch, business address in Germany, authorized recipient, branch offices c) Line of business	Basic or stock capital	a) General provisions of representation b) Executive board, management body, executive directors, personally liable members, managing directors, authorized representatives and special power of representation	Power of procuration	a) Legal form, start, statutes or articles of incorporation b) Other legal relations	a) Date of entry b) Confirmation
1	2	3	4	5	6	7
1	a) AusBio R&D Europe GmbH b) Kumbach Business address: Fritz-Hornschuch-Str. 9, 95526 Kumbach, Germany c) Development and distribution of products for medical diagnostics and all associated activities The company is entitled to acquire companies of the same or similar type, to obtain an interest in them or to take over their representation or business management.	EUR 50,000.00	a) If only one managing director has been appointed, he represents the company alone. If several managing directors have been appointed, the company is represented by the two managing directors or by one managing director together with an authorized representative. b) Appointed: Managing director: Dr. Marc Wolfgang Neudrosserfeld, born November 29, 1963 authorized to sign, represent, with the right to conclude legal transactions in the name of the company with himself in his own name or as a representative of a third party.		a) Gesellschaft mit beschränkter Haftung (German limited liability company) Articles of incorporation	a) October 11, 2012 b) Breunig
2			a) Amended, now: If only one liquidator has been appointed, he represents the company alone. If several liquidators have been appointed, the company is represented by the two liquidators or by one liquidator together with an authorized representative. b) Appointed: Liquidator: Wieland, Andreas, Balzer/Laethenstein, born February 26, 1954 No longer entitled to represent the company: Managing Director: Dr. Marc Wolfgang Neudrosserfeld, born November 29, 1963		b) The company is dissolved.	a) February 5, 2015 b) Weber

<sup>1</sup> Translator's note: HRB stands for „Handelsregister B“, meaning section B of the commercial register.



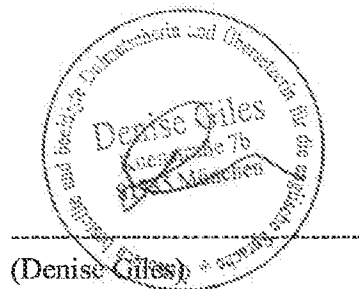
## ATTESTATION CLAUSE:

In my capacity as a translator for the English language, duly appointed, commissioned and sworn in by the Munich Regional Court I in the German federal state of Bavaria, I hereby certify to the best of my belief that the foregoing is a true and complete English translation of the original document in the German language submitted to me as a copy.

IN WITNESS WHEREOF I have hereunder set my hand and seal at

Munich, February 27, 2019

Denise Giles  
Kuenstraße  
81735 Munich  
Germany



Nummer der Eintragung	a) Firma b) Sitz, Niederlassung, inländische Geschäftsbezeichnung, eingetragensberechtigtes Person, Zweigniederlassungen c) Gegenstand des Unternehmens	Grund- oder Stammkapital	a) Allgemeine Verordnungsregelung b) Vorstand, Leitungsorgan, geschäftsführende Direktoren, persönlich haftende Gesellschafter, geschäftsführender, Vertretungsberechtigter und besondere Vertretungsbefugnisse	Prokura	a) Rechtsform, Beginn, Satzung oder Gesellschaftsvertrag b) Statutäre Rechtsverhältnisse	a) Tag der Eintragung b) Bemerkungen
1	2	3	4	5	6	7
1	a) Ausbio R&D Europe GmbH b) Kumbach Geschäftsbezeichnung: Fritz-Hornschuh-Str. 9, 95326 Kumbach c)	50.000,00 EUR	a) Ist nur ein Geschäftsführer bestellt, so vertritt er die Gesellschaft allein. Sind mehrere Geschäftsführer bestellt, so wird die Gesellschaft durch zwei Geschäftsführer oder durch einen Geschäftsführer gemeinsam mit einem Prokuristen vertreten. b) Bestell: Geschäftsführer: Dr. Mann, Wolfgang, Neudrossenfeld, 29.11.1963 einzelfreistellungsbescheid mit der Erklärung, im Namen der Gesellschaft mit sich im eigenen Namen oder als Vertreter eines Dritten Rechtsgeschäfte abzuschließen.		a) Gesellschaft mit beschränkter Haftung Gesellschaftsvertrag vom 24.9.2012.	a) 11.10.2012 Breunig
2			a) Geändert, nur: Ist nur ein Liquidator bestellt, so vertritt er die Gesellschaft allein. Sind mehrere Liquidatoren bestellt, so wird die Gesellschaft durch zwei Liquidatoren oder durch einen Liquidator gemeinsam mit einem Prokuristen vertreten. b) Bestell: Liquidator: Wesand, Andreas, Eitzers/Lochstein, 26.02.1964 Nicht mehr vertretungsberechtigt: Geschäftsführer: Dr. Mann, Wolfgang, Neudrossenfeld, 29.11.1963		b) Die Gesellschaft ist aufgelöst.	a) 06.02.2015 Weber

Exhibit 2

Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/940 681

PATENT Page 3 of 3

REEL: 049669 FRAME: 0070

**Vertrag  
über die Kooperation verschiedener  
Entwicklungsprojekte**

zwischen der

**AusBio R&D Europe GmbH  
„AusBio“  
Fritz Hornschuch Str. 9  
85328 Kulmbach**

und der

**HTI bio-X GmbH  
„HTI“  
Am Forst 8  
85580 Ebersberg**

### Vorbemerkung

Die HTI ist ein Entwickler und Anbieter von Instrumenten und Produkten auf den Gebieten der Laborautomation, Analysenmesstechnik, Life Science und Optoelektronik. Ihr Portfolio umfasst Komponenten und Stand - Alone Systeme.

HTI arbeitet insbesondere schnell und effizient im Rapid Prototyping, in Projektphasen, in denen in die Entwicklung hinein bereits Produkte (für beta test eties) zur Verfügung stehen sollen. Dabei werden die Geräte nach bestehenden Gesetzen, Normen und Richtlinien produziert bzw. hergestellt.

Die AusBio R&D Europe GmbH beschäftigt sich mit der Entwicklung von und dem Handel mit medizinisch diagnostischen Produkten, Gesamtsystemen und allen damit zusammenhängenden Tätigkeiten.

Die fachliche Verbindung zwischen den Vertragspartnern sowie die Ausrichtung ihrer beabsichtigten Arbeiten bilden eine gute Voraussetzung für die sinnvolle Zusammenarbeit zur gegenseitigen Ergänzung und Vertiefung bestehender Kenntnisse.

In dem Kooperationsvertrag werden grundsätzliche Rahmenvereinbarungen für diese Zusammenarbeit, ihre Durchführung sowie begleitend notwendige Maßnahmen getroffen. Diese beziehen sich neben der Durchführung von Forschungs- und Entwicklungsarbeiten auch auf die gemeinsame Nutzung von Produkten der Kooperationspartner, den Austausch von Erfahrungen und Ergebnissen sowie die personelle Zusammenarbeit.

Ansprechpartner bei der HTI ist Herr Dr. Wolfgang Helmberg.  
Ansprechpartner bei der AusBio ist Herr Dr. Wolfgang Mann.

Hierausgehend treffen die Vertragspartner folgende Vereinbarung:

### § 1

#### Vertragsgegenstand

(1) Die Vertragspartner beabsichtigen eine langfristige Zusammenarbeit für Entwicklungen auf verschiedenen Gebieten in folgenden Formen:

- Entwicklung von Komponenten für automatisierter Systeme der Nukleinsäureaufreinigung, molekulardiagnostischer Nachweissysteme und der Endpunktdetektion
- Zusammenarbeit im Bereich Produktion, Vertrieb und Marketing

mit folgenden Zielen:

- gegenseitiger wissenschaftlicher und technischer Beistand
- Vorbereitung und Realisierung gemeinsamer Projekte, die neue Verfahren und wissenschaftlich-technische Leistungen zum Ziel haben
- Entwicklung von Prototypen und Kleinserien von Geräten durch HTI für AusBio.

(2) Die Vertragsparteien sind sich bewusst, dass die Vereinbarung vorgenannter Zusammenarbeit einen dynamischen Prozess erfordert. Zunächst wird ein Teilprojekt formuliert (siehe Anhang A). Dieser Anhang wird im Sinne eines Moving Targets ständig aktualisiert.

§ 2  
Durchführung der Zusammenarbeit

- (1) AusBio gibt Entwicklungs- und Fertigungsprojekte bei HTI in Auftrag. Die für die Durchführung und Umsetzung der Projekte entstehenden Kosten wird HTI der AusBio monatlich nach Aufwand in Rechnung stellen. Sonderaufwendungen z.B. für die Erstellung von Kleinserien können gemäß Absprache hiervon abweichend gesondert in Rechnung gestellt werden.
- (2) Die Projekte werden vollständig dokumentiert und diese Dokumentation an AusBio geliefert. Alle aus den Entwicklungsarbeiten entstehenden Schutzrechte liegen grundsätzlich bei der AusBio. Über mögliche Lizenznahme wird gesondert und fallweise entschieden.
- (3) Keiner der Vertragspartner ist berechtigt, rechtsverbindliche Erklärungen jedweder Art für den anderen Vertragspartner abzugeben, insbesondere den anderen Vertragspartner nach außen zu vertreten.
- (4) Die Vertragspartner bemühen sich entsprechend den jeweils vorhandenen Möglichkeiten um gemeinsam zu bearbeitende Aufträge und um die Publizierung der erreichten Ergebnisse. Über den Stand der jeweiligen Arbeiten ist der Vertragspartner in regelmäßigen Abständen zu informieren. Die Inanspruchnahme von Leistungen des Partners setzt insbesondere die rechtzeitige zeitliche Abstimmung voraus.

§ 3 Geheimhaltung

- (1) Die Vertragspartner verpflichten sich, die Arbeitsergebnisse des anderen Partners sowie alle sonstigen Informationen, insbesondere technischer und wirtschaftlicher Art, Absichten, Erfahrungen, Erkenntnisse, Konstruktionen und Unterlagen, einschließlich der Vorbestehenden Ergebnisse, die ihnen aufgrund der Zusammenarbeit gemäß dieses Vertrages bekannt werden (zusammen „Information“ genannt), Dritten gegenüber – auch über die Dauer des Vertrages hinaus – vertraulich zu behandeln, Dritten nicht zugänglich zu machen, vor dem Zugriff Dritter zu schützen sowie nicht zum Gegenstand einer eigenen Schutzrechtsanmeldung zu machen. Unter die Geheimhaltungspflicht fallende und dem anderen Partner übergebene Dokumente sind mit einem Vertraulichkeitsvermerk zu kennzeichnen. Mündlich übermittelte Informationen sind von der Partei, die sie übermittelt hat, innerhalb von 30 Tagen schriftlich zusammenzufassen. Die Zusammenfassung wird ebenfalls mit einem Vertraulichkeitsvermerk versehen und der anderen Partei übergeben.
- (2) Die Vertragspartner sind nur mit vorheriger Zustimmung des anderen Partners berechtigt, diese Information an etwaige Nachunternehmerfirmen unter Auflegung der Verpflichtungen über die Vertraulichkeit weiterzugeben.
- (3) Die vorstehenden Verpflichtungen gelten nicht für solche Informationen, die einem Partner bereits vor ihrer Mitteilung im Rahmen dieses Vertrages bekannt waren, von diesem unabhängig erarbeitet oder anderweitig rechtmäßig erlangt wurden oder die allgemein sind oder ohne Verstoß gegen diesen Vertrag allgemein bekannt werden.
- (4) Die Vertragspartner werden in geeigneter Form dafür sorgen, dass auch die von ihnen bei der Durchführung dieses Vertrages hinzugezogenen Mitarbeiter, freien Mitarbeiter und Unterauftragnehmer die vorstehende Vertraulichkeit wahren.

- (5) Nach Beendigung dieses Vertrages sind die in Unterlagen etc, einschließlich sämtlicher Kopien, verkörpertem Arbeitsergebnisse und sonstige projektbezogene Informationen, die sich im Besitz oder unter Kontrolle von HTI befinden, an AusBio vollständig und unverzüglich zu uebergeben.

#### § 4

#### Vertragsdauer/Kündigung

- (1) Dieser Vertrag wird auf unbestimmte Zeit geschlossen. Er beginnt am 15.03. 2013.
- (2) Der Vertrag kann von beiden Vertragspartnern mit einer Frist von 4 Wochen zum Quartalsende gekündigt werden.
- (3) Das Recht zur außerordentlichen Kündigung aus wichtigem Grund bleibt unberührt.

#### § 5 Sonstige Bestimmungen

- (1) Änderungen oder Ergänzung dieses Vertrags bedürfen der Schriftform. Das gilt auch für einen Verzicht auf dieses Schriftformerfordernis.
- (2) Mündliche Abreden bestehen daneben nicht.
- (3) Die Übertragung von Rechten und Pflichten aus diesem Vertrag ist nur mit vorheriger Zustimmung des anderen Vertragspartners zulässig.
- (4) Sollte eine Bestimmung dieses Vertrages unwirksam sein, so berührt dies die Wirksamkeit der übrigen Bestimmungen nicht. Die Vertragspartner werden zusammenwirken, um – sofern keine gesetzlichen Vorschriften bestehen – an Stelle der unwirksamen Klauseln rechtlich zulässige und wirksame Klauseln zu setzen, welche geeignet sind, den mit den unwirksamen Klauseln beabsichtigten Erfolg zu erreichen.

Kulmbach, den 15.3.2013  
AusBio R&D Europe GmbH

Ebersberg, den 15.03.2013  
HTI bio-X GmbH

  
.....  
Dr. Wolfgang Mann  
Geschäftsführer

  
.....  
Dr. Wolfgang Heimberg  
Geschäftsführer

Anlage A

Spezifikation der Teilprojekte

1. Entwicklung einer Zentrifuge / eines Washers fuer Mikrotiterplatten basierend auf einer horizontalen Rotationsachse

Exhibit 3

Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/910,681

Page 6 of 12

**PATENT**

**REEL: 049669 FRAME: 0076**



**Agreement  
on the cooperation in  
various development projects**

between

**AusBio R&D Europe GmbH**  
**"AusBio"**  
Fritz Hornschuch Str 9  
95326 Kulmbach, Germany

and

**HTI bio-X GmbH**  
**"HTI"**  
Am Forst 6  
85560 Ebersberg, Germany

**Preliminary remarks**

HTI develops and offers instruments and products in the fields of laboratory automation, analytical measurement technology, life sciences, and opto-electronics. The company's portfolio includes components and stand-alone systems.

In particular, HTI offers fast and efficient rapid prototyping in stages of projects in which products already are to be provided during development (for beta test sites). In this context, the devices are produced and/or manufactured according to existing laws, standards and directives.

AusBio R&D Europe GmbH is concerned with the development and distribution of products for medical diagnostics, integral systems, and all associated activities.

The technical connection between the contractual parties and the focus of their intended activities form a good basis of sensible cooperation with the aim of mutually complementing and intensifying existing knowledge.

The cooperation agreement stipulates fundamental general consent regarding such cooperation, its performance and necessary accompanying provisions. In addition to research and development, the latter also relate to the shared use of products by the cooperating parties, the exchange of insights and results as well as cooperation in terms of human resources.

HTI's point of contact is Dr. Wolfgang Heimberg.

AusBio's point of contact is Dr. Wolfgang Mann.

Now therefore, the contractual parties have agreed as follows:

**§1**

**Subject matter of the agreement**

- (1) The contractual parties plan a long-term cooperation for developments in various fields in the following forms:
  - Development of components of automated systems for the purification of nucleic acid, detection systems for molecular diagnostics and endpoint detection;

— cooperation in production, sales and marketing;

with the following goals:

— Mutual scientific and technical support;

— preparation and implementation of joint projects aiming at new methods and scientific/technological achievements;

— development of prototypes and small-batch series of devices by HTI for AusBio.

- (2) The contractual parties are aware of the fact that the agreement on the cooperation described above requires a dynamic process. Initially, a sub-project shall be drafted (see Annex A). This Annex shall be continuously revised within the meaning of a moving target.

## **§2**

### **Implementation of cooperation**

- (1) AusBio shall assign development and manufacturing projects to HTI. HTI shall invoice AusBio for the costs incurred by the performance and implementation of the projects on a monthly at-cost basis. Deviating from this stipulation, special expenses, for example on the creation of small-batch series, may be separately invoiced as agreed.
- (2) The projects shall be documented in full, and such documentation shall be delivered to AusBio. AusBio shall generally own all intellectual property rights arising from the development activities. Any potential licensing shall be decided on separately on a case-by-case basis.
- (3) Neither of the contractual parties shall be entitled to make a declaration of any kind which legally binds the other contractual party; specifically, neither of the contractual parties shall be entitled to represent the other contractual party with respect to third parties.
- (4) Considering the possibilities which exist in the respective situation, the contractual parties shall strive for joint assignments and for the publication of the

achievements. Each contractual party shall regularly inform the other one about the state of the activities. Drawing on goods and services of the other party specifically requires the coordination of timing in due time.

### **§ 3 Confidentiality**

- (1) Each contractual party undertakes to keep confidential from, not make accessible to any third party, protect from access by any third party, and not apply for any intellectual property right of their own regarding the deliverables of the other party as well as all other information, particularly of technical and commercial nature, intent, experience, insight, structure, and documents, including preexisting achievements of which they become aware due to the cooperation under this agreement (jointly referred to as "information"), even beyond the term of this agreement. Documents subject to confidentiality handed over to the other party shall be marked confidential. Information orally conveyed shall be summarized in writing within 30 days by the party having conveyed such information. Such summary shall also be marked confidential and handed over to the other party.
- (2) Only with the prior consent of the other party shall a contractual party be entitled to transfer such information to any potential sub-contractors, committing the latter to the confidentiality obligations.
- (3) The aforementioned obligations shall not apply to any information of which one party had already been aware before becoming aware of it under this agreement, which one party developed independently of the other one, or which were lawfully obtained in any other manner, or which are or become generally known without any breach of this agreement.
- (4) The contractual parties shall ensure in a suitable manner that any employees, freelancers and sub-contractors relied upon for the performance of this agreement also adhere to the above confidentiality.
- (5) After the termination of this agreement, all deliverables found in any documents, etc., including all copies, and all other project-related information of which HTI has possession or control shall entirely be handed over to AusBio immediately.

**§4**

**Term of agreement/termination**

- (1) This agreement shall be in effect for an indefinite term. It becomes effective on March 15, 2013.
- (2) Either party may terminate this agreement by the end of each quarter with 4 weeks' notice.
- (3) The right of termination for cause of a compelling reason shall remain unaffected.

**§ 5 Miscellaneous**

- (1) Any alterations of or amendments to this agreement shall require written form. This shall also apply to a waiver of such requirement of written form.
- (2) Any other oral agreements do not exist.
- (3) The transfer of rights and obligations under this agreement shall only be admissible with the prior consent of the other contractual party.
- (4) Should any provision of this agreement be invalid, this shall not affect the validity of the remaining provisions. Unless statutory regulations exist, the contractual parties shall make joint efforts to replace the invalid provisions by legally admissible and valid provisions suitable for achieving what the invalid provisions had intended to achieve.

Kulmbach, March 15, 2013  
AusBio R&D Europe GmbH  
[Signature]

Dr. Wolfgang Mann  
Managing director

Ebersberg, March 15, 2013  
HTI bio-X GmbH  
[Signature]

Dr. Wolfgang Heimberg  
Managing director

**Annex A**

Specification of sub-projects

1. Development of a centrifuge/washer for microplates based on a horizontal rotation axis

As an English translator duly appointed and sworn by the Regional Court of Munich I, I certify that, to the best of my knowledge and belief, the above translation is a true and correct translation of the German document presented to me.

Munich, February 25, 2019



  
Saskia Ettling

## DECLARATION OF ZHAOQIANG WANG

I, Zhaoqiang Wang (hereinafter "Declarant"), having personal knowledge of the facts stated herein, and being of legal age and sound mind and memory, do hereby declare as follows:

1. I was at the time of filing of the EP Application No 13179437.2 (hereinafter: "EP Application") and the PCT Application No. PCT/EP2014/066947 (hereinafter: "PCT Application") and still am Chief Executive Officer of Yantai AusBio Laboratories Co., Ltd, No. 2 Huashan Road, Yeda 264006, Yantai, China (hereinafter: "AusBio Yantai").

2. Until its dissolution on February 5, 2015 AusBio R&D Europe GmbH (hereinafter: "AusBio Europe") was a subsidiary of AusBio Yantai in Germany. AusBio Yantai was the only shareholder of AusBio Europe. In the period of 2012 to 2014 AusBio Yantai had invested approximately EUR 3,0 million for the purpose of equipping AusBio Europe with the necessary means to fulfil its purpose of developing and trading of medicinal diagnostic products.

3. Before filing the EP application and the PCT Application I instructed Dr. Wolfgang Mann, who was the managing director of AusBio Europe at that time, to instruct Mr. Ganahl, who served as patent counsel for AusBio Europe and AusBio Yantai at the time of filing of the EP Application and the PCT Application, to file the EP Application and the PCT Application on behalf of AusBio Yantai and AusBio Europe. The decisions to file the EP Application and the PCT Application were taken by me.

4. The cost of the development work conducted by HTI bio-x GmbH (hereinafter: "HTI") and the costs for drafting and for filing the EP Application as well as the PCT Application were borne by AusBio Europe and AusBio Yantai. In particular, HTI issued invoices for the development work to AusBio Europe in the amount of approximately EUR 671,605.00 and invoices regarding technical service and support in the amount of approximately EUR 155,374.00 from 2013 to 2015. These invoices have been fully paid either by AusBio Europe or by AusBio Yantai.

5. AusBio Yantai provided the following technical Information and preparatory work to Dr. Mann and/or AusBio Europe concerning the invention at issues:

- Proof of concept with prototype model built out of laundry machine.
- Optimization of centrifugation speed and timing



- Cross contamination experiment and analysis
- Loading mechanism with flexible beam
- General User Interface (GUI)
- Dump and Shake method

I, the above-named Declarant, hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States.

Executed on this 27th day of February, 2019.

  
\_\_\_\_\_  
Zhaoqiang Wang

## License Agreement between

AusBio R&D Europe GmbH  
Fritz Hornschuch Str. 9  
95326 Kulmbach

("AusBio")

and

BlueCatBio GmbH  
Registered at Amtsgericht Bayreuth  
HRB 6201

("BCB")

### PREAMBLE

AusBio is a German based company that has been established as an R&D center of the Yantai AusBio Laboratories company (AusBio Laboratories) located in China. AusBio Laboratories history and milestones are summarized as follows:

1992: founded with RMB 230 k served as distributor of Elitech (France) in China  
1994: became distributor of DiaSorin's infectious disease ELISA kits combined with automated ELISA analyzer  
1995: strategic partnership with Ortho Clinical Diagnostics and Hamilton AG (Bonaduz, CH). Exclusive dealer for Chinese blood bank market  
2000: annual turnover reached RMB 100 Million (≈ USD 16.5 Million)  
2003 donated instrument valued USD 230 k to Ministry of Health in the epidemic outbreak of SARS  
2007: entered forensic DNA business with total solution for forensic laboratory automation  
2009: established R&D Group and AusChannel as AusBio's distribution network covering all of China  
2011: established European R&D center in Kulmbach, Germany

As a leading IVD company in the Chinese blood bank business of today AusBio Laboratories' target for the next five years period is the transition to a full line provider of AusBio branded systems, consumables, and diagnostic solutions. Primarily, AusBio Laboratory is focused on the diagnostics blood bank business but the systems development will be expanded to diagnostics in hospitals as well. Added value is generated by implementing components to large functional units based on Hamilton liquid handling platforms. These units are called TLA

(total lab automation) or ALA (absolute automation systems). For this reason an OEM contract between Hamilton and AusBio Laboratories has been established recently.

AusBio and AusBio Laboratories have jointly developed instruments for centrifugation that are based on a horizontal centrifugation axis.

AusBio has filed a patent application PCT/EP2014/066947 titled "Centrifuge and Method for Centrifuging a Reaction Vessel Unit" and an EP 13 179 437.2 with the same title that describe centrifugation of microtiterplates in SBS format based on the horizontal rotation axis. The prototype of the instruments based on above patent applications have been developed by HTI bio-X GmbH, Am Forst 6, 85560 Ebersberg, ("HTI") and paid for by AusBio and AusBio Laboratories. To date, approximately 32 AusWasherMTP prototype instruments, and 3 AusFuge prototype instruments have been built by HTI and delivered to AusBio and AusBio Laboratories Ltd, for evaluation (internal and by third parties), and for integration in AusBio Laboratories systems. Above referenced patent applications and the design blueprints of the prototype AusWasherMTP and AusFuge are jointly referred to as "AusWasher" and "AusFuge", respectively, hereafter.

BCB has been founded in September 2014 after a discussion between AusBio Laboratories' CEO (Johnson Wang), the CEO of Aus Bio (Dr. Wolfgang Mann) and the representative of AusBio of the Americas (Frank Feist) during AACC 2014 in Chicago. Dr. Wang stated that AusBio Laboratories has no interest in sales and marketing of components only but will focus on highly integrated ALA and TLA systems for IVD applications, initially with a focus on the Chinese market, with future expansion into international markets. ALA and TLA systems are based on high throughput 384 well micro titer plates, and achieve unique competitive advantage through focus on cost effective singleplex level of protein analysis in IVD. The intention is to extend the 384 well format to nucleic acids testing in IVD as well. The AusWasher MTP is regarded as an enabling technology for ALA and TLA higher integrated systems.

Frank Feist suggested, and Dr. Wang approved for Frank Feist to set up a separate company in order to commercialize the AusWasher technology with a focus on non IVD niche applications in pharmaceutical R&D. The intention of BCB is to develop small solutions for such niche applications where AusWasher offers unique advantages, including cell-based assays, multiplex microarrays, ELISA, and plate coating. BCB will further develop and modify the design of the original AusWasherMTP prototype for the needs of its specific target customers.

At his time point the hardware is manufactured by a Bavarian based engineering company (HTI bio-X GmbH, Am Forst 6, 85560 Ebersberg).

Against this background the parties agree as follows:

4

## § 1 Definitions

1. Contractual Protective Rights are the patents described in PCT/EP2014/ and EP 13 179 437.2. and any and all protective rights both applied for and granted, based on the same invention and on the applications for protective rights indicated above and the design blueprint for the AusWasherMTP and AusFuge prototypes.

2. Licensed Products are any and all products which make use of at least one claim of one of the Contractual Protective Rights. Furthermore, Licensed Products are all parts of the inventive system, independently of whether BCB manufactures or uses the complete system or individual parts thereof only. AusWasherMTP derived Licensed Products have a rotor oriented such that the wells of a MTP face outwards for the purpose removing liquids during centrifugation, whereas AusFuge derived Licensed Products feature MTPs with wells facing inward to centrifuge well components towards the well bottom.

3. The Contractual Territory are all of the countries in which any of the Contractual Protective Rights have been applied for or are in force.

## § 2 Granting of the License

1. BCB is granted a License for the manufacture, use and distribution of Licensed Products in the Contractual Territory. The License is non-exclusive and non-transferable. The License is exclusive for cell based applications restricted to US territory.

## § 3 License Fee und Purchase Obligation

1. For the first 8 years of this agreement, BCB shall pay to AusBio \$1,000 for each instrument that uses Contractual Protective Rights for AusWasher derived instruments, and \$500 for AusFuge derived instruments. After 8 years, until termination of this agreement, BCB will pay AusBio 50% of above statement royalties.

2. AusBio assures BCB that these royalties of \$1,000 and \$500, respectively per unit will not be increased during the entire duration of the agreement by more than a possible adjustment to the inflation of the Euro.

## § 4 Bookkeeping and Payment Terms

1. BCB shall keep proper business accounts and invoice accounts in which all the particulars required for calculating license fees shall be recorded.

2. BCB shall settle the license fees quarterly, i.e. as per the accounting dates March 31, June 30, September 30, and December 31 of each year and shall provide AusBio with a statement of account within 30 days, itemizing the manufactured and installed Licensed Products. The



license fees shall be due within 60 days from each accounting date and shall be paid exempt from any bank charges into the following bank account Sparkasse Kulmbach, Acc No. 101283851.

3. AusBio shall be entitled at any time, upon prior written notice, to have the account and invoice books of BCB which are relevant to the present agreement, inspected by an independent auditor who is bound to secrecy. In the case that the inspection uncovers errors to the disadvantage of AusBio, BCB shall pay to AusBio triple the differential amount, which payment shall be due immediately. BCB shall reimburse AusBio for the costs of the inspection, unless the differential sum is less than 5 percent in which case AusBio shall bear the inspection costs.

4. Interest on payments in arrears shall accrue from the due date in the amount of eight percentage points above the basic interest rate of the Central Bank of Germany without requiring a reminder; higher interest may only be charged if proven.

### § 5 Assignment and Sublicensing

1. BCB shall not be authorized to assign the present agreement, parts of the present agreement, or any rights conceded in the present agreement. An exception shall apply to assignment to an affiliated company in the sense of Sec. 15 Stock Corporation Act.

2. BCB shall not be authorized to grant sublicenses.

3. BCB shall indemnify AusBio against claims from any third party based on manufacture or use, sales or distribution of the Licensed Products, in particular in view of any and all claims for product liability.

### § 6 Assurances

1. AusBio shall assure that they are the proprietor of the Contractual Protective Rights and entitled to freely dispose thereof, and that they have no knowledge of any attack by any third party nor of any encumbrance by rights of any third party, in.

2. AusBio shall not assure that the Contractual Protective Rights are legally valid and/or that they will be maintained if they are contested, that they are economically exploitable, technically feasible or useful, or that they do not infringe rights of any third party.



#### § 7 Revocation of the Contractual Protective Rights

1. In the case that any and all of the Contractual Protective Rights shall be finally and absolutely cancelled or nullified, the present License Agreement shall be automatically terminated on the date at which an according decision shall become final and absolute.

In the case that only particular Contractual Protective Rights are finally and absolutely cancelled or nullified, BCB shall be entitled to a reasonable adjustment of the License Fee, if the scope of protection of a granted patent defined by the claim is amended over the claim as filed with the application in such a way that the core of the invention is no longer protected.

2. Any license fees paid cannot be reclaimed. Any license fees due and payable but not yet paid up to a final and absolute cancellation or annulment shall be paid by BCB.

#### § 8 Indemnification

BCB shall indemnify AusBio against claims from any third party based on manufacture or use, sales or distribution of the Licensed Products, in particular in view of any and all claims for product liability.

#### § 9 Maintenance of the Contractual Protective Rights

1. AusBio and AusBio Laboratories shall maintain the Contractual Protective Rights for the duration of the present agreement at their own expense.

2. In the case that AusBio should abandon particular Contractual Protective Rights, or insolvency proceedings are initiated with regard to AusBio, or in case of its liquidation, dissolution or winding up, AusBio will transfer Contractual Protective Rights to BCB for a consideration of no more than the total of licensing fees paid in the 12 months prior. In such case, BCB will continue to honor any agreements concerning Contractual Protective Rights that AusBio has granted to other parties.



### § 10 Infringement of the Contractual Protective Rights

1. In case that BCB obtains knowledge of an actual or imminent infringement of any of the Contractual Protective Rights, AusBio shall be notified thereof in writing without delay
2. AusBio shall on their own settle any dispute and take any action in respect of the Contractual Protective Rights, deciding at their own discretion whether to take any measures, and if so which (including court action, arbitration proceedings, and conciliation).

### § 11 Marking of the Product

1. BCB is not obligated to mark the Licensed Product with the Contractual Protective Rights or with an indication of the fact that a license has been granted or with the designation used by AusBio
2. This applies also for any kind of product manual, advertising material, brochures and the like.

### § 12 Duration and Termination of the Agreement

1. The present agreement shall enter into force upon signing of both parties and shall run until expiry of the term of protection of the last Contractual ProtectiveRight.
2. Moreover, the License Agreement may be terminated for cause by any Contractual Party without notice. Cause shall be given in particular if:
  - (a) the other party violates an essential contractual duty,
  - (b) BCB attacks the Contractual Protective Rights during the License Agreement period or supports or causes an attack by any third party (non-aggression clause)
  - (c) insolvency proceedings are initiated with regard to the other BCB, or in case of its liquidation, dissolution or winding up



(d) BCB does not pay the license fees within the agreed dates

The notice of termination shall, except in the cases (b) and (c), be preceded by a written warning in which the other Contractual Party is demanded to comply with the terms and conditions of the agreement within 14 days.

### § 13 Final clause

1. The interpretation of the License Agreement is subject to German law to the exclusion of the rules of private international law. The German version of this License Agreement shall be binding.
2. The jurisdiction of the District Court Bayreuth --- Patent Litigation Division - shall be agreed for any and all dispute arising out of or in conjunction with this License Agreement.
3. Any modifications of the License Agreement shall be made in writing. This shall include amendments of the requirement of the written form.
4. The License Agreement shall comprise any and all agreements in respect of the subject of the present agreement. No supplements to this License Agreement have been made.
5. Should any provision of the License Agreement be invalid or become so in the future, or should the License Agreement contain an omission, the validity of the remaining provisions shall remain unaffected. In place of any invalid clause or provision, a clause or provision shall be deemed to be agreed which comes closest to the economic intent of the parties. This shall apply mutatis mutandis in the case of an omission.

Signed on behalf of BCB

Signed on behalf of AusBio

Frank Feist, CEO

Dr. Wolfgang Mann, CEO

Exhibit 5

Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/940,681

PATENT Page 7 of 7

REEL: 049669 FRAME: 0092



[handwritten: 143635]

[handwritten: 4]

HRB number<sup>1</sup>

[barcode]

143635

[stamp: Local Court of Munich,  
Registry Court,  
received on: JULY 18, 2002]

## LIST OF SHAREHOLDERS

of the company

### HTI bio-X GmbH

having its place of business in Ebersberg, Germany

Address: 85560 Ebersberg, Germany, Gewerbepark Nord-Ost 7

1. Dr. Wolfgang Heimberg,  
born on January 19, 1953,  
residing at 85560 Ebersberg, Germany, Böhmerwaldstraße 72,  
**with an initial capital contribution of EUR 16.000**
2. Mr. Samuel Gebert,  
born on October 30, 1958,  
residing at 85462 Eitting, Germany, Eschenweg 6,  
**with an initial capital contribution of EUR 9.000**

**A total of**

**EUR 25.000**

Munich, July 12, 2002

[Signature: illegible]

[Signature: illegible]

<sup>1</sup> Translator's note: HRB stands for „Handelsregister B“, meaning section B of the commercial register.

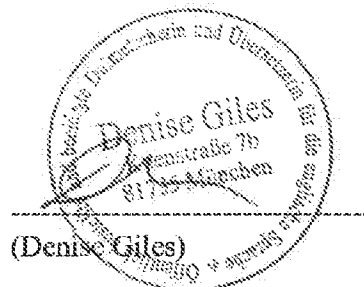
## ATTESTATION CLAUSE:

In my capacity as a translator for the English language, duly appointed, commissioned and sworn in by the Munich Regional Court I in the German federal state of Bavaria, I hereby certify to the best of my belief that the foregoing is a true and complete English translation of the original document in the German language submitted to me as a copy.

IN WITNESS WHEREOF I have hereunder set my hand and seal at

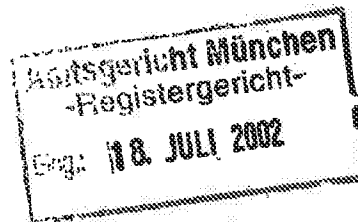
Munich, February 27, 2019

Denise Giles  
Kuenstraße  
81735 Munich  
Germany



143 635

4



## GESELLSCHAFTERLISTE

der Firma

**HTI bio-X GmbH**

mit dem Sitz in Ebersberg

Anschrift: 85560 Ebersberg, Gewerbepark Nord-Ost 7

1. Herr Dr. Wolfgang Heimberg,  
geboren am 19.01.1953,  
wohnhaft 85560 Ebersberg, Böhmerwaldstraße 72,  
mit einer Stammeinlage in Höhe von 16.000 EUR
2. Herr Samuel Gebert,  
geboren am 30.10.1958,  
wohnhaft 85462 Eitting, Eschenweg 6,  
mit einer Stammeinlage in Höhe von 9.000 EUR

Insgesamt

25.000 EUR

München, den 12. Juli 2002

*W. fgg*  
*Samuel Gebert*

Deed No. 1362 /2013B

**List with Certification of the Notary**

of the shareholders of the company  
HTI bio-X GmbH  
having its place of business in Ebersberg,  
Germany  
Local Court of Munich, HRB 143635  
with the amounts of the shares as of

June 14, 2013

No. of share	Name, date of birth place of residence or company name	Nominal value of the shares EUR	Sum of the nominal values EUR
1	Dr. Wolfgang Heimberg, born on January 19, 1953, Böhmerwaldstr. 72, 85560 Ebersberg, Germany	€ 16,000.00	€ 16,000.00
2	as above	€ 9,000.00	€ 9,000.00
Total nominal values			€ 25,000.00

The undersigned notary hereby certifies that the amended entries in the list of shareholders correspond to the amendments he participated in and that the remaining entries are identical with the content of the list previously included in the commercial register.

Ebersberg, August 5, 2013

[Stamp: Notary Dr. Christopher Baumhof]

[Signature: illegible]  
Dr. Baumhof, Notary

I hereby certify that the image data (copy) contained in this file is identical with the paper document (original document) before me.

Ebersberg, August 5, 2013

Dr. Baumhof, Notary

\*

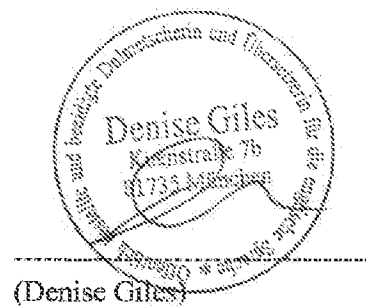
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IN WITNESS WHEREOF I have hereunder set my hand and seal at

Munich, February 27, 2019

Denise Giles  
Kuenstraße  
81735 Munich  
Germany



Liste mit Bescheinigung des Notars

der Gesellschafter der Firma

HTI bio-X GmbH

mit dem Sitz in Ebersberg

Amtsgericht München, HRB 143635

mit den Beträgen der Geschäftsanteile, Stand: 14.6.2013

Nr. des Geschäfts- Anteils	Name, Geburtsdatum Wohnort bzw. Firma	Nennbetrag der Geschäftsanteile EUR	Summe der Nennbeträge EUR
1	Dr. Wolfgang Heimberg, geb. am 19.01.1953, Böhmerwaldstr. 72, 85560 Ebersberg	16.000,-- €	16.000,-- €
2	wie vor	9.000,-- €	9.000,-- €
insgesamt Nennbeträge			25.000,-- €

Der Unterzeichnete Notar bestätigt hiermit, daß die geänderten Eintragungen in der Gesellschafterliste den Veränderungen entsprechen, an denen er mitgewirkt hat, und die übrigen Eintragungen mit dem Inhalt der zuletzt im Handelsregister aufgenommenen Liste übereinstimmen.

Ebersberg, den 5.8.2013



*Dr. Baumhof*  
Dr. Baumhof, Notar

Hiermit beglaubige ich die Übereinstimmung der in dieser Datei enthaltenen Bilddaten  
(Abschrift) mit dem mir vorliegenden Papierdokument (Urschrift).

Ebersberg, den 05.08.2013

Dr. Baumhof, Notar



**patronus**

---

**From:** Wolfgang Mann <wmann@ausbio.de>  
**Sent:** Wednesday, June 19, 2013, 7:45 am  
**To:** patronus  
**Subject:** Further aspects regarding the first application  
**Enclosures:** Weitere Aspekte zur Anmeldung.docx<sup>1</sup>

Hello Bernhard,

We wanted to subsequently add a multiple application for "Sample Carrier Centrifuge" before August. I have listed some essential points. I will speak to Wolfgang Heimberg today and will then possibly add further points.

Maybe we could speak on the phone later this week; I will be in China for 10 days from next Tuesday.

Wolfgang

Dr. Wolfgang Mann  
CEO

---

AusBio R&D Europe GmbH.  
Fritz Hornschuch Str. 9  
95326 Kulmbach  
Germany  
phone: +49(0) 9221 827628830  
mobile: +49(0) 1752206131  
e-mail: [wmann@ausbio.de](mailto:wmann@ausbio.de)

[Enclosure: Further Aspects regarding the application "Sample Carrier Centrifuge" *not translated*]

---

<sup>1</sup> Translator's note: The title of the document translates as "Further aspects regarding the application.docx"

## ATTESTATION CLAUSE:

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IN WITNESS WHEREOF I have hereunder set my hand and seal at

Munich, February 27, 2019

Denise Giles  
Kuenstraße  
81735 Munich  
Germany



patronus

---

Von: Wolfgang Mann <wmann@ausbio.de>  
Gesendet: Mittwoch, 19. Juni 2013 07:45  
An: patronus  
Betreff: weitere Aspekte zur ersten Anmeldung  
Anlagen: Weitere Aspekte zur Anmeldung.docx

Hallo Bernhard,

Wir wollten eine Sammelanmeldung nachschieben fuer " Sample Carrier Centrifuge" vor August. Ich habe mal wesentliche Punkte aufgelistet. Mit Wolfgang Heimberg spreche ich heute, dann schicke ich evtl. Weitere Punkte nach.

Vielleicht koennen wir dann Ende der Woche telefonieren, ab naechsten Dienstag bin ich fuer 10 Tage in China.

Wolfgang

Dr. Wolfgang Mann  
CEO

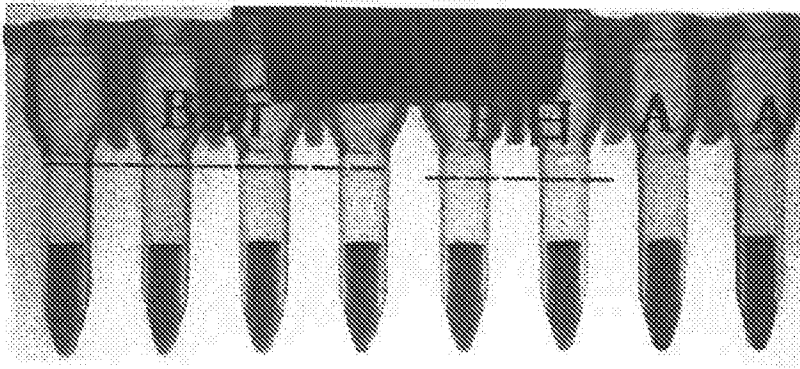
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AusBio R&D Europe GmbH.  
Fritz Hornschuch Str. 9  
95326 Kulmbach  
Germany  
phone: +49(0) 9221 827628830  
mobile: +49(0) 1752206131  
e-mail: [wmann@ausbio.de](mailto:wmann@ausbio.de)

Weitere Aspekte zur Anmeldung "Sample Carrier Centrifuge"

1. Beim Zentrifugieren / Waschen von offenen Gefaessen, insbesondere Mikrotiterplatten, (96 oder 384 oder 1536 Kavitaeten) wird die Platte in horizontaler Ausrichtung in die Zentrifuge eingefuehrt. Dabei sind die Reaktionsraeume nach oben hin offen. Dann wird die Platte auf den Kopf gedreht. Dabei entleeren sich die Reaktionsraeume. Vorteilhaft ist eine schnelle Hin-und Herbewegung in dieser Position (moeglicherweise ruckartig, um dem haendischen Prozess nahezukommen) , sodass sich alle Reaktionsraeume leeren. Die Auslenkung betraegt wenige mm in beide Rotationsrichtungen. Dieser Vorgang wird zunehmend wichtig, je kleiner die Reaktionsraeume werden. Die Kapillarkraft wirkt der Schwerkraft entgegen.
2. Wenn nach dem Entleeren die letzten Reste der Fluessigkeiten per Zentrifugation entfernt werden, so besteht die Gefahr der Kontamination des Reaktionsraumes und damit die Gefahr, dass sich Material in anderen Reaktionsraeumen niederschlaegt und zu falschen Ergebnissen fuehrt. Daher muss der Reaktionsraum sehr schnell von Aerosolen befreit werden. Das kann durch einen Unterdruck passieren , Luft stroemt beim Beginn der Rotaionsbewegung zentral in den Reaktionsraum und wird peripher abgesaugt. Damit werden alle Aerosole von der Platte weg transportiert. Geschickte technische Anordnungen daefuer wird es einige geben. Sollten wir beschreiben.
3. Wenn Sedimente in Platten analysiert werden sollen, so enthaelt die Zentrifuge eine optische Einrichtung, so dass der Boden einer Mikrotiterplatte von unten analysiert werden kann.
4. Fuer bestimmte Anwendungen muss der Zentrifugenraum temperiert werden. Der Bereich kann 0-80 Grad C umfassen.
5. Gelkartensysteme (urspruengliche Idee der GelKartenzentrifuge) muessen unter bestimmten Temperaturen abgearbeitet werden. Heute stellt man sie dazu in Heizblocks (zwischen den Handlingsschritten). Wenn der Zentrifugenraum temperiert ist und der sample carrier (die Halterung fuer die GelKarte in der Zentrifuge) bewegt (geschuettelt) werden kann, dann fehlt nur noch eine Aufnahme (Bilddokumentation) nach der letzten Zentrifugation. Also sollten wir eine Zentrifuge schuetzen, die alle Funktionen enthaelt. Dann wuerde die Karte in der Zentrifuge abgearbeitet werden bis zum Foto. Robotarme waeren nur am Anfang und am Ende zum Bewegen und Positionieren notwendig. Die Zentrifuge wird zum Platz fuer die Analyse.
6. Die Karten werden heute durch spezielle Gripper angefasst und transportiert. Eine Karte, die als Aufsatz eine Vorrichtung enthaelt, die dem oberen Schaft einer Pipettenspitze enthaelt, wuerde den Gripper ueberfluessig machen. Eine solche GelKarte koennte von jedem Pipttiroboter, der Spitzen bearbeiten kann, benutzt werden. Ich hatte diesbezieuglich schon einmal eine Skizze per e-mail geschickt.
7. Die Auslesung von GelKarten findet heute in transparentem Material statt. Gegenlicht bietet die besten Kontraste. Eine Karte bestehend aus 2 Komponenten (eine Haelfte weiss, damit die roten Banden der Blutkoerperchen gut gesehen werden koennen ) die Vorderseite nach wie vor transparent, damit ein Foto gemacht werden kann, ist sehr von Vorteil.

8. Wir bauen gerade eine Anbindung fuer eine Handy Camera (Android) , die statt einer 10,000CHF Version eingebaut werden soll. Dafuer waere diese Art der Karte deutlich einfacher zum lesen.  
Als Beispiel hier mal ein Bild der konventionellen Karte:



Patronus [handwritten: EP-7418] [handwritten: illegible]  
 From: Wolfgang Heimberg <W.Heimberg@hti-bio-x.com>  
 Sent: Wednesday, July 31, 2013, 4:30 pm [handwritten: illegible]  
 To: patronus  
 Subject: AW: further information EP-7418  
 Enclosures: 13-07-31\_Patent.zip

Hi Bernhard,

Please find attached a few images. Have a look at them, they may be helpful. Let me know if you need further illustrations.

As regards the final drawings: You should rework them with an illustrator of yours once again, you probably have more experience and know what parts are relevant.

Please get in touch if you have any questions or requests.

With regard to our meeting, I wanted to send you the acceleration values for the centrifuge. Currently, we use/recommend the following acceleration and delay value:

$a = 100 \dots 1200 \text{ rpm/s}$

**Please contact me if you have any questions.**

All the best,

Wolfgang

Kind regards

Dr. Wolfgang Heimberg

**Managing Director**

HTI bio-X GmbH

Phone: 0049-8092-209222

[handwritten: Mobile: 0179/7903250]

Fax: 0049-8092-209228

[www.hti-bio-x.com](http://www.hti-bio-x.com)

### Local Court of Munich

HRB 143635

**From:** patronus [mailto:patronus@patronus-ipc.com]

Sent: Tuesday, July 30, 2013, 11:39 am

To: Wolfgang Mann

CC: Wolfgang Helmberg

**Subject:** AW: further information EP-7418

Hello Wolfgang,

I will call you today at 2 pm our time. That should be 7 am Texas time.

Please find attached the supplemented version including the drawings. They are inserted at the beginning of the text.

Greetings,

Bernhard

## ATTESTATION CLAUSE:

In my capacity as a translator for the English language, duly appointed, commissioned and sworn in by the Munich Regional Court I in the German federal state of Bavaria, I hereby certify to the best of my belief that the foregoing is a true and complete English translation of the original document in the German language submitted to me as a copy.

IN WITNESS WHEREOF I have hereunder set my hand and seal at

Munich, February 27, 2019

Denise Giles  
Kuenstraße  
81735 Munich  
Germany



patronus

EP-2418

W

Von: Wolfgang Heimberg <W.Heimberg@hti-bio-x.com>  
Gesendet: Mittwoch, 31. Juli 2013 16:30  
An: patronus  
Betreff: AW: weiterer Nachtrag EP-7418  
Anlagen: 13-07-31\_Patent.zip

W

Hallo Bernhard,

anbei sende ich Dir ein paar Bilder. Schau sie Dir an ob sie helfen  
und melde Dich bitte, wenn Du weitere Darstellungen brauchst.  
Bzgl. der finalen Zeichnungen solltest Du das mit einem Zeichner von Euch  
nochmals bearbeiten, da habt ihr wohl mehr Erfahrung, worauf es ankommt.  
Bei Fragen oder Wünschen bitte melden.

Bzgl. unserer Besprechung wollte ich Dir noch Beschleunigungswerte für die Zentrifuge  
liefern. Im Moment verwenden/empfehlen wir folgende Beschleunigung- und Verzögerungswerte:

a = 100 ... 1200 rpm/s

Wenn Du Fragen hast melde Dich bitte  
Schöne Grüße  
Wolfgang

Mit freundlichen Grüßen

>>>>>>>>>>

Dr. Wolfgang Heimberg  
Geschäftsführer  
HTI bio-X GmbH  
Tel. 0049-8092-209222  
Fax. 0049-8092-209228  
[www.hti-bio-x.com](http://www.hti-bio-x.com)  
Amtsgericht München  
HRB 143635

Handy: 0179/7903250

Von: patronus [<mailto:patronus@patronus-ip.com>]  
Gesendet: Dienstag, 30. Juli 2013 11:39  
An: Wolfgang Mann  
Cc: Wolfgang Heimberg  
Betreff: AW: weiterer Nachtrag EP-7418

Hallo Wolfgang,

Ich rufe Dich heute um 14:00 unserer Zeit an. Das müsste 7:00 Texas-Zeit sein.

Anbei die ergänzte Fassung mit den Zeichnungen. Sie sind zu Beginn des Textes eingebettet.

Gruss,

Bernhard



**patronus**

---

**From:** Stefan Andrasic <S.Andrasic@hti-bio-x.com>  
**Sent:** Thursday, September 11, 2014, 10:03 am  
**To:** patronus  
**Subject:** AW: Our reference: AUS1003PWO\_CAD files  
**Enclosures:** 5.jpg

Good morning Ms. Nguyen,

Please find attached the first revised page as was instructed to me by Mr. Heimberg.  
Does it look ok to you or are there certain "norms" with respect to font, size etc.  
Likewise, I took over the arrangement from your pdf file -- is it mandatory?

CAD files? Do you want the complete construction?

Thank you very much.

Kind regards,  
Stefan Andrasic

Phone: 08092/2092-40  
Fax: 08092/2092-28  
[s.andrasic@hti-bio-x.com](mailto:s.andrasic@hti-bio-x.com)  
[www.hti-bio-x.com](http://www.hti-bio-x.com)

HTI bio-X GmbH  
Am Forst 6  
85560 Ebersberg  
Germany  
Managing Director: Dr. Wolfgang Heimberg  
Local Court of Munich  
HRB 143635

---

**From:** Wolfgang Heimberg  
**Sent:** Wednesday, September 10, 2014, 10:32 am  
**To:** Stefan Andrasic  
**Subject:** WG: Our reference: AUS1003PWO\_CAD files

---

**From:** patronus [<mailto:patronus@patronus-ip.com>]  
**Sent:** Thursday, August 7, 2014, 2:27 pm  
**To:** Wolfgang Heimberg  
**Subject:** Our reference: AUS1003PWO\_CAD files

Dear Mr. Heimberg,

In the abovementioned matter we forward the figures we filed with the European Patent Office.

However, the final drawings still have to be prepared and filed later. Therefore, we want to ask whether it is possible for you to provide us with the CAD files of the figures attached.

Exhibit 10

Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/940,681

**PATENT**  
Page 1 of 3

**REEL: 049669 FRAME: 0109**

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IN WITNESS WHEREOF I have hereunder set my hand and seal at

Munich, February 27, 2019

Denise Giles  
Kuenstraße  
81735 Munich  
Germany



.....  
(Denise Giles)

**patronus**

---

**Von:** Stefan Andrasic <S.Andrasic@hti-bio-x.com>  
**Gesendet:** Donnerstag, 11. September 2014 10:03  
**An:** patronus  
**Betreff:** AW: Unser Zeichen: AUS1003PWO\_CAD-Dateien  
**Anlagen:** 5.jpg

Guten Tag Frau Nguyen,

im Anhang finden Sie mal die erste überarbeitete Seite, wie es mir Herr Heimberg gesagt hatte.  
Ist dies für Sie ok, oder gibt es bezüglich der Schriftart, Größe usw. gewisse "Normen"  
Ebenso die Anordnung wurde von mir aus Ihrem pdf übernommen - ist diese verpflichtend?

CAD - Daten? Sie wollen die komplette Konstruktion?

Vielen Dank.

Mit freundlichen Grüßen  
Stefan Andrasic

Tel.: 08092/2092-40  
Fax: 08092/2092-28  
[s.andrasic@hti-bio-x.com](mailto:s.andrasic@hti-bio-x.com)  
<http://www.hti-bio-x.com>

HTI bio-X GmbH  
Am Forst 8  
85660 Ebersberg  
Geschäftsführer: Dr. Wolfgang Heimberg  
Amtsgericht München  
HRB 143635

---

**Von:** Wolfgang Heimberg  
**Gesendet:** Mittwoch, 10. September 2014 10:32  
**An:** Stefan Andrasic  
**Betreff:** WG: Unser Zeichen: AUS1003PWO\_CAD-Dateien

---

**Von:** patronus [<mailto:patronus@patronus-ip.com>]  
**Gesendet:** Donnerstag, 7. August 2014 14:27  
**An:** Wolfgang Heimberg  
**Betreff:** Unser Zeichen: AUS1003PWO\_CAD-Dateien

Sehr geehrter Herr Heimberg,

in oben genannter Angelegenheit übersenden wir Ihnen Figuren, welche wir beim Europäischen Patentamt eingereicht haben.

Hierzu müssen jedoch noch Reinzeichnungen erstellt und nachgereicht werden. Daher möchten wir nachfragen, ob es Ihnen möglich wäre, uns zu den in der Anlage beigefügten Figuren die CAD-Dateien zu übersenden.

**patronus**

---

**From:** Stefan Andrasic <S.Andrasic@hti-bio-x.com>  
**Sent:** Tuesday, September 16, 2014, 2:01 pm  
**To:** patronus  
**Subject:** AW: Our reference: AUS1003PWO\_CAD files  
**Enclosures:** 1.jpg; 2.JPG; 3.JPG; 4.JPG; 5.JPG; 6.JPG; 7.jpg; 8.jpg; 9.jpg; 10.jpg; 11.jpg; 12.jpg; 13.jpg; 14.jpg

Hello Ms. Nguyen,

Please find attached the requested images.

Kind regards  
Stefan Andrasic

Phone: 08092/2092-40  
Fax: 08092/2092-28  
[s.andrasic@hti-bio-x.com](mailto:s.andrasic@hti-bio-x.com)  
[www.hti-bio-x.com](http://www.hti-bio-x.com)

*[Logo: HTI bio-x engineering]*

HTI bio-X GmbH  
Am Forst 6  
85560 Ebersberg  
Germany  
Managing Director: Dr. Wolfgang Heimberg  
Local Court of Munich  
HRB 143635

---

**From:** Wolfgang Heimberg  
**Sent:** Wednesday, September 10, 2014, 10:32 am  
**To:** Stefan Andrasic  
**Subject:** WG: Our reference: AUS1003PWO\_CAD files

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**Sent:** Thursday, August 7, 2014, 2:27 pm  
**To:** Wolfgang Heimberg  
**Subject:** Our reference: AUS1003PWO\_CAD files

Dear Mr. Heimberg,

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However, the final drawings still have to be prepared and filed later. Therefore, we want to ask whether it would be possible for you to provide us with the CAD files of the figures attached.

Kind regards,

p.p. Yvonne Nguyen

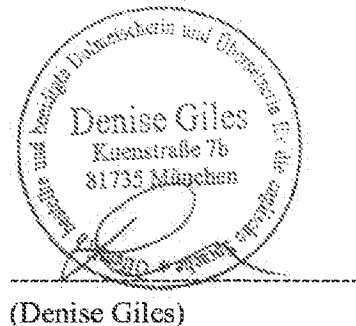
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IN WITNESS WHEREOF I have hereunder set my hand and seal at

Munich, February 27, 2019

Denise Giles  
Kuenstraße  
81735 Munich  
Germany



patronus

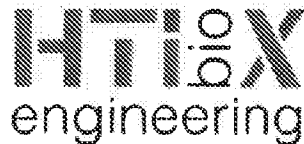
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**Von:** Stefan Andrasic <S.Andrasic@hti-bio-x.com>  
**Gesendet:** Dienstag, 16. September 2014 14:01  
**An:** patronus  
**Betreff:** AW: Unser Zeichen: AUS1003PWO\_CAD-Dateien  
**Anlagen:** 1.jpg; 2.JPG; 3.JPG; 4.JPG; 5.JPG; 6.JPG; 7.jpg; 8.jpg; 9.jpg; 10.jpg; 11.jpg; 12.jpg; 13.jpg; 14.jpg

Hallo Frau Nguyen,  
  
im Anhang die gewünschten Bilder.

Mit freundlichen Grüßen  
Stefan Andrasic

Tel.: 08092/2092-40  
Fax: 08092/2092-28  
[s.andrasic@hti-bio-x.com](mailto:s.andrasic@hti-bio-x.com)  
<http://www.hti-bio-x.com>



HTI bio-X GmbH  
Am Forst 6  
85560 Ebersberg  
Geschäftsführer: Dr. Wolfgang Heimberg  
Amtsgericht München  
HRB 143635

---

**Von:** Wolfgang Heimberg  
**Gesendet:** Mittwoch, 10. September 2014 10:32  
**An:** Stefan Andrasic  
**Betreff:** WG: Unser Zeichen: AUS1003PWO\_CAD-Dateien

---

**Von:** patronus [<mailto:patronus@patronus-ip.com>]  
**Gesendet:** Donnerstag, 7. August 2014 14:27  
**An:** Wolfgang Heimberg  
**Betreff:** Unser Zeichen: AUS1003PWO\_CAD-Dateien

Sehr geehrter Herr Heimberg,

in oben genannter Angelegenheit übersenden wir Ihnen Figuren, welche wir beim Europäischen Patentamt eingereicht haben.

Hierzu müssen jedoch noch Reinzeichnungen erstellt und nachgereicht werden. Daher möchten wir nachfragen, ob es Ihnen möglich wäre, uns zu den in der Anlage beigefügten Figuren die CAD-Dateien zu übersenden.

Mit freundlichen Grüßen

I. A. Yvonne Nguyen

patronus

---

**From:** Stefan Andrasic <S.Andrasic@hti-bio-x.com>  
**Sent:** Thursday, September 18, 2014, 2:47 pm  
**To:** patronus  
**Subject:** AW: Our reference: AUS1003PWO\_CAD files  
**Enclosures:** AAApdf1.jpg; AAApdf2.jpg; AAApdf3.jpg; AAApdf4.jpg; AAApdf5.jpg

Hello,

Please find attached the requested drawings.

Kind regards,  
Stefan Andrasic

Phone: 08092/2092-40  
Fax: 08092/2092-28  
[s.andrasic@hti-bio-x.com](mailto:s.andrasic@hti-bio-x.com)  
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[Logo: HTI bio-x engineering]

HTI bio-X GmbH  
Am Forst 6  
85560 Ebersberg,  
Germany  
Managing Director: Dr. Wolfgang Helmberg  
Local Court of Munich  
HRB 143635

---

**From:** patronus [<mailto:patronus@patronus-ip.com>]  
**Sent:** Thursday, September 18, 2014, 8:02 am  
**To:** Stefan Andrasic  
**Subject:** Our reference: AUS1003PWO\_CAD files

Dear Mr. Andrasic

Thank you very much for forwarding the figures.

Please note that some of the figures drawn by you are not in accordance with the Implementing Regulations under the PCT. We attach, for your information, the notification of the European Patent Office concerning the deficiencies which are marked with a cross. Figures may not contain shading, for example. In addition, the drawings are not to be drawn freehand, but with the aid of drafting instruments, see for example Figure 17.

We ask that you observe these complaints when creating the drawings.

In our last email, we only forwarded a part of the drawings. Therefore, we now provide you with the entire figures filed and, for the purpose of a better understanding, the corresponding drafts for the final drawings of Figures 4, 8, 9, 10 and 18a-d taken from a parallel file.

Please do not hesitate to contact us if you have any questions.

Kind regards,

p.p. Yvonne Nguyen  
Patent Paralegal

## ATTESTATION CLAUSE:

In my capacity as a translator for the English language, duly appointed, commissioned and sworn in by the Munich Regional Court I in the German federal state of Bavaria, I hereby certify to the best of my belief that the foregoing is a true and complete English translation of the original document in the German language submitted to me as a copy.

IN WITNESS WHEREOF I have hereunder set my hand and seal at

Munich, February 27, 2019

Denise Giles  
Kuenstraße  
81735 Munich  
Germany



(Denise Giles)



**patronus**

---

**Von:** Stefan Andrasic <S.Andrasic@hti-bio-x.com>  
**Gesendet:** Donnerstag, 18. September 2014 14:47  
**An:** patronus  
**Betreff:** AW: Unser Zeichen: AUS1003PWO\_CAD-Dateien  
**Anlagen:** AAApdf1.jpg; AAApdf2.jpg; AAApdf3.jpg; AAApdf4.jpg; AAApdf5.jpg

Hallo,

im Anhang die gewünschten Zeichnungen.

Mit freundlichen Grüßen  
Stefan Andrasic

Tel.: 08092/2092-40  
Fax: 08092/2092-28  
[s.andrasic@hti-bio-x.com](mailto:s.andrasic@hti-bio-x.com)  
<http://www.hti-bio-x.com>

**HTI·X**  
engineering

HTI bio-X GmbH  
Am Forst 6  
85560 Ebersberg  
Geschäftsführer: Dr. Wolfgang Heimberg  
Amtsgericht München  
HRB 143635

---

**Von:** patronus [<mailto:patronus@patronus-ip.com>]  
**Gesendet:** Donnerstag, 18. September 2014 08:02  
**An:** Stefan Andrasic  
**Betreff:** AW: Unser Zeichen: AUS1003PWO\_CAD-Dateien

Sehr geehrter Herr Andrasic,

vielen Dank für die Übersendung der Figuren.

Bitte beachten Sie, dass einige von Ihnen erstellte Figuren nicht der PCT-Ausführungsordnung entsprechen. Zu Ihrer Information fügen wir Ihnen den Mängelbescheid des Europäischen Patentamtes bei, in dem die Mängel angekreuzt sind. U. a. dürfen die Figuren keine Schattierungen enthalten. Zudem sollen die Linien der Zeichnungen nicht freihändig, sondern mit Zeichengeräten gezogen werden, wie es z. B. bei Figur 17 der Fall ist.

Wir bitten Sie, diese Beanstandungen bei der Erstellung der Zeichnungen zu beachten.

In der letzten E-Mail hatten wir Ihnen nur einen Teil der Zeichnungen übersandt. Daher übersenden wir Ihnen nun unsere komplett eingereichten Figuren sowie zum besseren Verständnis entsprechende Vorlagen für Reinzeichnungen zu den Figuren 4, 8, 9, 10 und 18a-d., welche wir aus einer parallelen Akte entnommen haben.

Für Rückfragen stehen wir Ihnen gerne zur Verfügung.

Mit freundlichen Grüßen

I. A. Yvonne Nguyen  
Patentanwaltfachangestellte

Anika Mergner

---

**From:** christoph schmidt <christoph.schmidt@hti-bio-x.com>  
**Sent:** Tuesday, October 7, 2014, 9:11 am  
**To:** patronus@patronus-ip.com  
**CC:** Wolfgang Heimberg  
**Subject:** Your references: EU-7692; EU trademark application no. 012836375 "X-TubeProcessor" (word mark); expiration of the deadline for claiming the priority // Your references: US-7825; later application in the US  
**Enclosures:** 7c.JPG; 11b.jpg; 12d.JPG; 13d.JPG; 14c.JPG; 15d.jpg; 16b.jpg; 17c.jpg; 1c.JPG; 2d.JPG; 3b.JPG; 5c.JPG; 6c.JPG

Dear Sir or Madam,

Please find attached the missing and revised images for the patent application.  
Please provide us with a short feedback as to whether the images meet the requirements for the application. Thank you very much in advance.

Kind regards,  
Christoph Schmidt

Phone: 08092/2092-40  
Fax: 08092/2092-28  
[christoph.schmidt@hti-bio-x.com](mailto:christoph.schmidt@hti-bio-x.com)  
<http://www.hti-bio-x.com>

[Logo: HTI bio-x engineering]

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85560 Ebersberg  
Germany  
Managing Director: Dr. Wolfgang Heimberg  
Local Court of Munich  
HRB 143635

## ATTESTATION CLAUSE:

In my capacity as a translator for the English language, duly appointed, commissioned and sworn in by the Munich Regional Court I in the German federal state of Bavaria, I hereby certify to the best of my belief that the foregoing is a true and complete English translation of the original document in the German language submitted to me as a copy.

IN WITNESS WHEREOF I have hereunder set my hand and seal at

Munich, February 27, 2019

Denise Giles  
Kuenstraße  
81735 Munich  
Germany



**Anika Mergner**

---

**Von:** christoph schmidt <christoph.schmidt@hti-bio-x.com>  
**Gesendet:** Dienstag, 7. Oktober 2014 09:11  
**An:** patronus@patronus-ip.com  
**Cc:** Wolfgang Heimberg  
**Betreff:** Ihre Zeichen: EU-7692; EU-Markenanmeldung Nr. 012836375 "X-  
TubeProcessor" (Wortmarke); Ablauf der Frist zur Inanspruchnahme der  
Priorität // Ihre Zeichen: US-7825; Nachanmeldung in den USA  
**Anlagen:** 7c.JPG; 11b.jpg; 12d.JPG; 13d.JPG; 14c.JPG; 15d.jpg; 16b.jpg; 17c.jpg; 1c.JPG;  
2d.JPG; 3b.JPG; 5c.JPG; 6c.JPG

Sehr geehrte Damen und Herren,

anbei erhalten Sie von mir die fehlenden und nachbearbeiteten Bilder für die Patentanmeldung.  
Bitte geben Sie uns ein kurzes Feedback, ob die Bilder den Anforderungen für die Anmeldung entsprechen. Vielen  
Dank im Voraus

Mit freundlichen Grüßen  
Christoph Schmidt

Tel.: 08092/2092-40  
Fax: 08092/2092-28  
[christoph.schmidt@hti-bio-x.com](mailto:christoph.schmidt@hti-bio-x.com)  
<http://www.hti-bio-x.com>

**HTI:O:X**  
engineering

HTI bio-X GmbH  
Am Forst 6  
85560 Ebersberg  
Geschäftsführer: Dr. Wolfgang Heimberg  
Amtsgericht München  
HRB 143835

Anika Mergner

---

**From:** christoph schmidt <christoph.schmidt@hti-bio-x.com>  
**Sent:** Thursday, October 16, 2014, 11:07 am  
**To:** patronus@patronus-ip.com  
**CC:** Wolfgang Heimberg  
**Subject:** WG: Your references: EU-7692; EU trademark application no. 012836375 "X-  
TubeProcessor" (word mark); expiration of the deadline for claiming the  
priority // Your references: US-7825; later application in the US  
**Enclosures:** 17c.jpg; 1c.JPG; 2d.JPG; 3c.JPG; 5c.JPG; 6c.JPG; 7c.JPG; 11b.jpg; 12d.JPG;  
13d.JPG; 14c.JPG; 15d.jpg; 16b.jpg

Dear Sir or Madam,

Please find attached the lacking and revised images for the patent application.  
Please provide us with a short feedback as to whether the images meet the requirements for the  
application this time. Thank you very much in advance.

Kind regards  
Christoph Schmidt

Phone: 08092/2092-40  
Fax: 08092/2092-28  
[christoph.schmidt@hti-bio-x.com](mailto:christoph.schmidt@hti-bio-x.com)  
<http://www.hti-bio-x.com>

[Logo: HTI bio-x engineering]

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Germany  
Managing Director: Dr. Wolfgang Heimberg  
Local Court of Munich  
HRB 143635

## ATTESTATION CLAUSE:

In my capacity as a translator for the English language, duly appointed, commissioned and sworn in by the Munich Regional Court I in the German federal state of Bavaria, I hereby certify to the best of my belief that the foregoing is a true and complete English translation of the original document in the German language submitted to me as a copy.

IN WITNESS WHEREOF I have hereunder set my hand and seal at

Munich, February 27, 2019

Denise Giles  
Kuenstraße  
81735 Munich  
Germany



**Anika Mergner**

---

**Von:** christoph schmidt <christoph.schmidt@hti-bio-x.com>  
**Gesendet:** Donnerstag, 16. Oktober 2014 11:07  
**An:** patronus@patronus-ip.com  
**Cc:** Wolfgang Heimberg  
**Betreff:** WG: Ihre Zeichen: EU-7692; EU-Markenanmeldung Nr. 012836375 "X-  
TubeProcessor" (Wortmarke); Ablauf der Frist zur Inanspruchnahme der  
Priorität // Ihre Zeichen: US-7825; Nachanmeldung in den USA  
**Anlagen:** 17c.jpg; 1c.JPG; 2d.JPG; 3c.JPG; 5c.JPG; 6c.JPG; 7c.JPG; 11b.jpg; 12d.JPG;  
13d.JPG; 14c.JPG; 15d.jpg; 16b.jpg

Sehr geehrte Damen und Herren,

anbei erhalten Sie von mir die fehlenden und nachbearbeiteten Bilder für die Patentanmeldung.  
Bitte geben Sie uns ein kurzes Feedback, ob die Bilder den Anforderungen für die Anmeldung diesmal entsprechen.  
Vielen Dank im Voraus

Mit freundlichen Grüßen  
Christoph Schmidt

Tel.: 08092/2092-40  
Fax: 08092/2092-28  
[christoph.schmidt@hti-bio-x.com](mailto:christoph.schmidt@hti-bio-x.com)  
<http://www.hti-bio-x.com>

**HTI bio-X**  
engineering

HTI bio-X GmbH  
Am Forst 6  
85560 Ebersberg  
Geschäftsführer: Dr. Wolfgang Heimberg  
Amtsgericht München  
HRB 143635

### Declaration of Assignment

for patents, utility models, trademarks, their applications and international trademarks.

I/We

**AusBio R&D Europe GmbH**

**Fritz-Hornschuch-Str. 9**

**95328 Kulmbach**

the undersigned owner of the

international patent applications

Serial no.: PCT/EP2014/066947

Title: "Centrifuge and Method for Centrifuging a Reaction Vessel Unit"

Serial no.: PCT/EP2014/071399

Title: "Method for Determining the Result of an Agglutination Reaction and Microplate for Determining Products of Agglutination Reactions"

herewith assign its shares with all rights and duties to

**Yantai AusBio Laboratories Co., Ltd.**

**No. 2 Huashan Road, Yeda**

**264006 Yantai**

**CHINA**

and agree that the assignment is recorded in the Patent and Trademark Office.

Place, Date:

Bonnadur, 16.1.2015



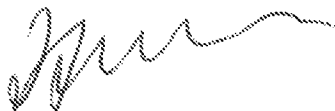
Andreas Wieland as liquidator for AusBio R&D Europe GmbH

### Declaration of Acceptance

I/We hereby agree to the aforementioned assignment and apply for recording of the assignment in the registers of the Patent and Trademark Office.

Place, Date:

Yantai, 18.1.2015



Johnson Z Wang (CEO of Yantai AusBio Laboratories Co., Ltd.)

Exhibit 15

Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/910,681

PATENT Page 1 of 1

REEL: 049669 FRAME: 0124



## PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1  
 Stylesheet Version v1.2

EPAS ID: PAT4094755

<b>SUBMISSION TYPE:</b>	NEW ASSIGNMENT
<b>NATURE OF CONVEYANCE:</b>	ASSIGNMENT
<b>CONVEYING PARTY DATA</b>	
<b>Name</b>	<b>Execution Date</b>
ZHAOQIANG WANG	09/12/2016
<b>RECEIVING PARTY DATA</b>	
<b>Name:</b>	YANTAI AUSBIO LABORATORIES CO., LTD.
<b>Street Address:</b>	NO. 2 HUASHAN ROAD
<b>City:</b>	YEDA, YANTAI
<b>State/Country:</b>	CHINA
<b>Postal Code:</b>	264006
<b>PROPERTY NUMBERS Total: 1</b>	
<b>Property Type</b>	<b>Number</b>
Application Number:	14910681
<b>CORRESPONDENCE DATA</b>	
<b>Fax Number:</b>	(202)478-2725
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.</i>	
<b>Phone:</b>	202-470-0126
<b>Email:</b>	info@harrisfirm.net
<b>Correspondent Name:</b>	RONALD C. HARRIS, JR.
<b>Address Line 1:</b>	922 N STREET, NW, SUITE 101
<b>Address Line 4:</b>	WASHINGTON, D.C. 20001
<b>ATTORNEY DOCKET NUMBER:</b>	PAT001
<b>NAME OF SUBMITTER:</b>	RONALD C. HARRIS, JR.
<b>SIGNATURE:</b>	/Ronald C. Harris, Jr./
<b>DATE SIGNED:</b>	10/13/2016
<b>Total Attachments: 1</b>	
source=16-10-13_Assignment_Wang_PAT001#page1.tif	

Exhibit 16

Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/910,681

PATENT

Page 1 of 2

## ASSIGNMENT

WHEREAS, WE, Zhaoqiang Wang, citizen of P.R. CHINA, residing at No. 2 Huashan Rd., Yeda, 264006 Yantai, P.R. CHINA, Dr. Wolfgang Mann, citizen of GERMANY, residing at Hornungstruth 22A, 95512 Neudrossenfeld, GERMANY, ASSIGNORS, are the inventors of the invention in CENTRIFUGE AND METHOD FOR CENTRIFUGING A REACTION VESSEL UNIT, for which we have executed a PCT application for a Patent of the United States

- ☒ which is executed on ☐ even date herewith or ☒ February 5, 2016 \_\_\_\_\_  
☒ which is identified by Attorney docket no. PAT001  
☐ which was filed on N/A, Application Ser. No. N/A

and WHEREAS, Yantai AusBio Laboratories Co., Ltd., No. 2 Huashan Road, Yeda, 264006 Yantai, P.R. CHINA, ASSIGNEE is desirous of obtaining our entire right, title and interest in, to and under the said invention and the said application.

NOW, THEREFORE, in consideration of the sum of One Dollar (\$1.00) to us in hand paid, and other good and valuable consideration, the receipt of which is hereby acknowledged, we, the said ASSIGNORS, have sold, assigned, transferred and set over, and by these presents do hereby sell, assign, transfer and set over, unto the said ASSIGNEE, its successors, legal representatives and assigns, our entire right, title and interest in, to and under the said invention, and the said United States application and all divisions, renewals and continuations thereof, and all Patents of the United States which may be granted thereon and all reissues and extensions thereof; and all applications for industrial property protection, including, without limitation, all applications for patents, utility models, and designs which may hereafter be filed for said invention in any country or countries foreign to the United States, together with the right to file such applications and the right to claim for the same the priority rights derived from said United States application under the Patent Laws of the United States, the International Convention for the Protection of Industrial Property, or any other international agreement or the domestic laws of the country in which any such application is filed, as may be applicable; and all forms of industrial property protection, including, without limitation, patents, utility models, inventors' certificates and designs which may be granted for said invention in any country or countries foreign to the United States and all extensions, renewals and reissues thereof.

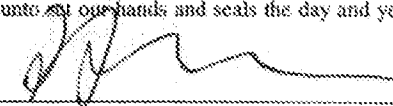
AND WE HEREBY authorize and request the Commissioner of Patents and Trademarks of the United States, and any Official of any country or countries foreign to the United States, whose duty it is to issue patents or other evidence or forms of industrial property protection on applications as aforesaid, to issue the same to the said ASSIGNEE, its successors, legal representatives and assigns, in accordance with the terms of this instrument.

AND WE HEREBY covenant and agree that we have full right to convey the entire interest herein assigned, and that we have not executed, and will not execute, any agreement in conflict herewith.

AND WE HEREBY further covenant and agree that we will communicate to the said ASSIGNEE, its successors, legal representatives and assigns, any facts known to us respecting said invention, and testify in any legal proceeding, sign all lawful papers, execute all divisional, continuing, reissue and foreign applications, make all rightful oaths, and generally do everything possible to aid the said ASSIGNEE, its successors, legal representatives and assigns, to obtain and enforce proper protection for said invention in all countries.

AND WE HEREBY grant the power to Ronald C. Harris, Jr. (Reg. No. 48,901) and any other registered practitioners listed under customer no. 50571 to insert on this Assignment any further identification that may be necessary or desirable in order to comply with the rules of the United States Patent and Trademark Office for recordation of this document.

IN TESTIMONY WHEREOF, We hereunto set our hands and seals the day and year set opposite our respective signatures.

Date Sept 12, 2013 2013  \_\_\_\_\_ L.S.  
Zhaoqiang Wang

Date \_\_\_\_\_, 2013 \_\_\_\_\_ L.S.  
Dr. Wolfgang Mann

**REGULATION (EC) No 593/2008 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL**  
**of 17 June 2008**  
**on the law applicable to contractual obligations (Rome I)**

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 61(c) and the second indent of Article 67(5) thereof,

Having regard to the proposal from the Commission,

Having regard to the opinion of the European Economic and Social Committee <sup>(1)</sup>,

Acting in accordance with the procedure laid down in Article 251 of the Treaty <sup>(2)</sup>,

Whereas:

- (1) The Community has set itself the objective of maintaining and developing an area of freedom, security and justice. For the progressive establishment of such an area, the Community is to adopt measures relating to judicial cooperation in civil matters with a cross-border impact to the extent necessary for the proper functioning of the internal market.
- (2) According to Article 65, point (b) of the Treaty, these measures are to include those promoting the compatibility of the rules applicable in the Member States concerning the conflict of laws and of jurisdiction.
- (3) The European Council meeting in Tampere on 15 and 16 October 1999 endorsed the principle of mutual recognition of judgments and other decisions of judicial authorities as the cornerstone of judicial cooperation in civil matters and invited the Council and the Commission to adopt a programme of measures to implement that principle.
- (4) On 30 November 2000 the Council adopted a joint Commission and Council programme of measures for implementation of the principle of mutual recognition of decisions in civil and commercial matters <sup>(3)</sup>. The programme identifies measures relating to the harmonisation of conflict-of-law rules as those facilitating the mutual recognition of judgments.
- (5) The Hague Programme <sup>(4)</sup>, adopted by the European Council on 5 November 2004, called for work to be pursued actively on the conflict-of-law rules regarding contractual obligations (Rome I).
- (6) The proper functioning of the internal market creates a need, in order to improve the predictability of the outcome of litigation, certainty as to the law applicable and the free movement of judgments, for the conflict-of-law rules in the Member States to designate the same national law irrespective of the country of the court in which an action is brought.
- (7) The substantive scope and the provisions of this Regulation should be consistent with Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters <sup>(5)</sup> (Brussels I) and Regulation (EC) No 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations (Rome II) <sup>(6)</sup>.
- (8) Family relationships should cover parentage, marriage, affinity and collateral relatives. The reference in Article 1(2) to relationships having comparable effects to marriage and other family relationships should be interpreted in accordance with the law of the Member State in which the court is seised.
- (9) Obligations under bills of exchange, cheques and promissory notes and other negotiable instruments should also cover bills of lading to the extent that the obligations under the bill of lading arise out of its negotiable character.
- (10) Obligations arising out of dealings prior to the conclusion of the contract are covered by Article 12 of Regulation (EC) No 864/2007. Such obligations should therefore be excluded from the scope of this Regulation.
- (11) The parties' freedom to choose the applicable law should be one of the cornerstones of the system of conflict-of-law rules in matters of contractual obligations.
- (12) An agreement between the parties to confer on one or more courts or tribunals of a Member State exclusive jurisdiction to determine disputes under the contract should be one of the factors to be taken into account in determining whether a choice of law has been clearly demonstrated.
- (13) This Regulation does not preclude parties from incorporating by reference into their contract a non-State body of law or an international convention.

<sup>(1)</sup> OJ C 318, 23.12.2006, p. 56.

<sup>(2)</sup> Opinion of the European Parliament of 29 November 2007 (not yet published in the Official Journal) and Council Decision of 5 June 2008.

<sup>(3)</sup> OJ C 12, 15.1.2001, p. 1.

<sup>(4)</sup> OJ C 53, 3.3.2005, p. 1.

<sup>(5)</sup> OJ L 12, 16.1.2001, p. 1. Regulation as last amended by Regulation (EC) No 1791/2006 (OJ L 363, 20.12.2006, p. 1).

<sup>(6)</sup> ~~Regulation~~ **Petition Pursuant to 37 CFR 1.46(B)(2)**

- (14) Should the Community adopt, in an appropriate legal instrument, rules of substantive contract law, including standard terms and conditions, such instrument may provide that the parties may choose to apply those rules.
- (15) Where a choice of law is made and all other elements relevant to the situation are located in a country other than the country whose law has been chosen, the choice of law should not prejudice the application of provisions of the law of that country which cannot be derogated from by agreement. This rule should apply whether or not the choice of law was accompanied by a choice of court or tribunal. Whereas no substantial change is intended as compared with Article 3(3) of the 1980 Convention on the Law Applicable to Contractual Obligations<sup>(1)</sup> (the Rome Convention), the wording of this Regulation is aligned as far as possible with Article 14 of Regulation (EC) No 864/2007.
- (16) To contribute to the general objective of this Regulation, legal certainty in the European judicial area, the conflict-of-law rules should be highly foreseeable. The courts should, however, retain a degree of discretion to determine the law that is most closely connected to the situation.
- (17) As far as the applicable law in the absence of choice is concerned, the concept of 'provision of services' and 'sale of goods' should be interpreted in the same way as when applying Article 5 of Regulation (EC) No 44/2001 in so far as sale of goods and provision of services are covered by that Regulation. Although franchise and distribution contracts are contracts for services, they are the subject of specific rules.
- (18) As far as the applicable law in the absence of choice is concerned, multilateral systems should be those in which trading is conducted, such as regulated markets and multilateral trading facilities as referred to in Article 4 of Directive 2004/39/EC of the European Parliament and of the Council of 21 April 2004 on markets in financial instruments<sup>(2)</sup>, regardless of whether or not they rely on a central counterparty.
- (19) Where there has been no choice of law, the applicable law should be determined in accordance with the rule specified for the particular type of contract. Where the contract cannot be categorised as being one of the specified types or where its elements fall within more than one of the specified types, it should be governed by the law of the country where the party required to effect the characteristic performance of the contract has his habitual residence. In the case of a contract consisting of a bundle of rights and obligations capable of being categorised as falling within more than one of the specified types of contract, the characteristic performance of the contract should be determined having regard to its centre of gravity.
- (20) Where the contract is manifestly more closely connected with a country other than that indicated in Article 4(1) or (2), an escape clause should provide that the law of that other country is to apply. In order to determine that country, account should be taken, *inter alia*, of whether the contract in question has a very close relationship with another contract or contracts.
- (21) In the absence of choice, where the applicable law cannot be determined either on the basis of the fact that the contract can be categorised as one of the specified types or as being the law of the country of habitual residence of the party required to effect the characteristic performance of the contract, the contract should be governed by the law of the country with which it is most closely connected. In order to determine that country, account should be taken, *inter alia*, of whether the contract in question has a very close relationship with another contract or contracts.
- (22) As regards the interpretation of contracts for the carriage of goods, no change in substance is intended with respect to Article 4(4), third sentence, of the Rome Convention. Consequently, single-voyage charter parties and other contracts the main purpose of which is the carriage of goods should be treated as contracts for the carriage of goods. For the purposes of this Regulation, the term 'consignor' should refer to any person who enters into a contract of carriage with the carrier and the term 'the carrier' should refer to the party to the contract who undertakes to carry the goods, whether or not he performs the carriage himself.
- (23) As regards contracts concluded with parties regarded as being weaker, those parties should be protected by conflict-of-law rules that are more favourable to their interests than the general rules.
- (24) With more specific reference to consumer contracts, the conflict-of-law rule should make it possible to cut the cost of settling disputes concerning what are commonly relatively small claims and to take account of the development of distance-selling techniques. Consistency with Regulation (EC) No 44/2001 requires both that there be a reference to the concept of directed activity as a condition for applying the consumer protection rule and that the concept be interpreted harmoniously in Regulation (EC) No 44/2001 and this Regulation, bearing in mind that a joint declaration by the Council and the Commission on Article 15 of Regulation (EC) No 44/2001 states that 'for Article 15(1)(c) to be applicable it is not sufficient for an undertaking to target its activities at the Member State of the consumer's residence, or at a number of Member States including that Member State; a contract must also be concluded within the framework of its activities'. The declaration also states that 'the mere fact that an Internet site is accessible is not sufficient for Article 15 to be applicable, although a factor will be that this Internet site solicits the conclusion of distance contracts and that a contract is actually concluded by such means'. Distance, by

<sup>(1)</sup> OJ C 334, 30.12.2005, p. 1.

<sup>(2)</sup> OJ L 145, 30.4.2004, p. 1. Directive as last amended by Directive 2008/10/EC (OJ L 76, 19.3.2008, p. 33).

whatever means. In this respect, the language or currency which a website uses does not constitute a relevant factor.<sup>1</sup>

- (25) Consumers should be protected by such rules of the country of their habitual residence that cannot be derogated from by agreement, provided that the consumer contract has been concluded as a result of the professional pursuing his commercial or professional activities in that particular country. The same protection should be guaranteed if the professional, while not pursuing his commercial or professional activities in the country where the consumer has his habitual residence, directs his activities by any means to that country or to several countries, including that country, and the contract is concluded as a result of such activities.
- (26) For the purposes of this Regulation, financial services such as investment services and activities and ancillary services provided by a professional to a consumer, as referred to in sections A and B of Annex I to Directive 2004/39/EC, and contracts for the sale of units in collective investment undertakings, whether or not covered by Council Directive 85/611/EEC of 20 December 1985 on the coordination of laws, regulations and administrative provisions relating to undertakings for collective investment in transferable securities (UCITS) <sup>(1)</sup>, should be subject to Article 6 of this Regulation. Consequently, when a reference is made to terms and conditions governing the issuance or offer to the public of transferable securities or to the subscription and redemption of units in collective investment undertakings, that reference should include all aspects binding the issuer or the offeror to the consumer, but should not include those aspects involving the provision of financial services.
- (27) Various exceptions should be made to the general conflict-of-law rule for consumer contracts. Under one such exception the general rule should not apply to contracts relating to rights *in rem* in immovable property or tenancies of such property unless the contract relates to the right to use immovable property on a timeshare basis within the meaning of Directive 94/47/EC of the European Parliament and of the Council of 26 October 1994 on the protection of purchasers in respect of certain aspects of contracts relating to the purchase of the right to use immovable properties on a timeshare basis <sup>(2)</sup>.
- (28) It is important to ensure that rights and obligations which constitute a financial instrument are not covered by the general rule applicable to consumer contracts, as that could lead to different laws being applicable to each of the instruments issued, therefore changing their nature and preventing their fungible trading and offering. Likewise, whenever such instruments are issued or offered, the contractual relationship established between the issuer or the offeror and the consumer should not necessarily be

subject to the mandatory application of the law of the country of habitual residence of the consumer, as there is a need to ensure uniformity in the terms and conditions of an issuance or an offer. The same rationale should apply with regard to the multilateral systems covered by Article 4(1)(h), in respect of which it should be ensured that the law of the country of habitual residence of the consumer will not interfere with the rules applicable to contracts concluded within those systems or with the operator of such systems.

- (29) For the purposes of this Regulation, references to rights and obligations constituting the terms and conditions governing the issuance, offers to the public or public take-over bids of transferable securities and references to the subscription and redemption of units in collective investment undertakings should include the terms governing, *inter alia*, the allocation of securities or units, rights in the event of over-subscription, withdrawal rights and similar matters in the context of the offer as well as those matters referred to in Articles 10, 11, 12 and 13, thus ensuring that all relevant contractual aspects of an offer binding the issuer or the offeror to the consumer are governed by a single law.
- (30) For the purposes of this Regulation, financial instruments and transferable securities are those instruments referred to in Article 4 of Directive 2004/39/EC.
- (31) Nothing in this Regulation should prejudice the operation of a formal arrangement designated as a system under Article 2(a) of Directive 98/26/EC of the European Parliament and of the Council of 19 May 1998 on settlement finality in payment and securities settlement systems <sup>(3)</sup>.
- (32) Owing to the particular nature of contracts of carriage and insurance contracts, specific provisions should ensure an adequate level of protection of passengers and policy holders. Therefore, Article 6 should not apply in the context of those particular contracts.
- (33) Where an insurance contract not covering a large risk covers more than one risk, at least one of which is situated in a Member State and at least one of which is situated in a third country, the special rules on insurance contracts in this Regulation should apply only to the risk or risks situated in the relevant Member State or Member States.
- (34) The rule on individual employment contracts should not prejudice the application of the overriding mandatory provisions of the country to which a worker is posted in accordance with Directive 96/71/EC of the European Parliament and of the Council of 16 December 1996 concerning the posting of workers in the framework of the provision of services <sup>(4)</sup>.

<sup>(1)</sup> OJ L 375, 31.12.1985, p. 3. Directive as last amended by Directive 2008/18/EC of the European Parliament and of the Council (OJ L 76, 19.3.2008, p. 42).

<sup>(2)</sup> OJ L 280, 29.10.1994, p. 83.

<sup>(3)</sup> OJ L 166, 11.6.1998, p. 45.

<sup>(4)</sup> OJ L 182, 16.7.1996, p. 1.

- (35) Employees should not be deprived of the protection afforded to them by provisions which cannot be derogated from by agreement or which can only be derogated from to their benefit.
- (36) As regards individual employment contracts, work carried out in another country should be regarded as temporary if the employee is expected to resume working in the country of origin after carrying out his tasks abroad. The conclusion of a new contract of employment with the original employer or an employer belonging to the same group of companies as the original employer should not preclude the employee from being regarded as carrying out his work in another country temporarily.
- (37) Considerations of public interest justify giving the courts of the Member States the possibility, in exceptional circumstances, of applying exceptions based on public policy and overriding mandatory provisions. The concept of 'overriding mandatory provisions' should be distinguished from the expression 'provisions which cannot be derogated from by agreement' and should be construed more restrictively.
- (38) In the context of voluntary assignment, the term 'relationship' should make it clear that Article 14(1) also applies to the property aspects of an assignment, as between assignor and assignee, in legal orders where such aspects are treated separately from the aspects under the law of obligations. However, the term 'relationship' should not be understood as relating to any relationship that may exist between assignor and assignee. In particular, it should not cover preliminary questions as regards a voluntary assignment or a contractual subrogation. The term should be strictly limited to the aspects which are directly relevant to the voluntary assignment or contractual subrogation in question.
- (39) For the sake of legal certainty there should be a clear definition of habitual residence, in particular for companies and other bodies, corporate or unincorporated. Unlike Article 60(1) of Regulation (EC) No 44/2001, which establishes three criteria, the conflict-of-law rule should proceed on the basis of a single criterion; otherwise, the parties would be unable to foresee the law applicable to their situation.
- (40) A situation where conflict-of-law rules are dispersed among several instruments and where there are differences between those rules should be avoided. This Regulation, however, should not exclude the possibility of inclusion of conflict-of-law rules relating to contractual obligations in provisions of Community law with regard to particular matters.
- This Regulation should not prejudice the application of other instruments laying down provisions designed to contribute to the proper functioning of the internal market in so far as they cannot be applied in conjunction with the law designated by the rules of this Regulation. The application of provisions of the applicable law designated by the rules of this Regulation should not restrict the free movement of goods and services as regulated by Community instruments, such as Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market (Directive on electronic commerce) <sup>(1)</sup>.
- (41) Respect for international commitments entered into by the Member States means that this Regulation should not affect international conventions to which one or more Member States are parties at the time when this Regulation is adopted. To make the rules more accessible, the Commission should publish the list of the relevant conventions in the *Official Journal of the European Union* on the basis of information supplied by the Member States.
- (42) The Commission will make a proposal to the European Parliament and to the Council concerning the procedures and conditions according to which Member States would be entitled to negotiate and conclude, on their own behalf, agreements with third countries in individual and exceptional cases, concerning sectoral matters and containing provisions on the law applicable to contractual obligations.
- (43) Since the objective of this Regulation cannot be sufficiently achieved by the Member States and can therefore, by reason of the scale and effects of this Regulation, be better achieved at Community level, the Community may adopt measures, in accordance with the principle of subsidiarity as set out in Article 5 of the Treaty. In accordance with the principle of proportionality, as set out in that Article, this Regulation does not go beyond what is necessary to attain its objective.
- (44) In accordance with Article 3 of the Protocol on the position of the United Kingdom and Ireland, annexed to the Treaty on European Union and to the Treaty establishing the European Community, Ireland has notified its wish to take part in the adoption and application of the present Regulation.
- (45) In accordance with Articles 1 and 2 of the Protocol on the position of the United Kingdom and Ireland, annexed to the Treaty on European Union and to the Treaty establishing the European Community, and without prejudice to Article 4 of the said Protocol, the United Kingdom is not taking part in the adoption of this Regulation and is not bound by it or subject to its application.
- (46) In accordance with Articles 1 and 2 of the Protocol on the position of Denmark, annexed to the Treaty on European Union and to the Treaty establishing the European Community, Denmark is not taking part in the adoption of this Regulation and is not bound by it or subject to its application.

Exhibit 17

Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/910,681

PATENT

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REEL: 049669 FRAME: 0130

HAVE ADOPTED THIS REGULATION:

## CHAPTER I

### SCOPE

#### Article 1

##### Material scope

1. This Regulation shall apply, in situations involving a conflict of laws, to contractual obligations in civil and commercial matters.

It shall not apply, in particular, to revenue, customs or administrative matters.

2. The following shall be excluded from the scope of this Regulation:

- (a) questions involving the status or legal capacity of natural persons, without prejudice to Article 13;
- (b) obligations arising out of family relationships and relationships deemed by the law applicable to such relationships to have comparable effects, including maintenance obligations;
- (c) obligations arising out of matrimonial property regimes, property regimes of relationships deemed by the law applicable to such relationships to have comparable effects to marriage, and wills and succession;
- (d) obligations arising under bills of exchange, cheques and promissory notes and other negotiable instruments to the extent that the obligations under such other negotiable instruments arise out of their negotiable character;
- (e) arbitration agreements and agreements on the choice of court;
- (f) questions governed by the law of companies and other bodies, corporate or unincorporated, such as the creation, by registration or otherwise, legal capacity, internal organisation or winding-up of companies and other bodies, corporate or unincorporated, and the personal liability of officers and members as such for the obligations of the company or body;
- (g) the question whether an agent is able to bind a principal, or an organ to bind a company or other body corporate or unincorporated, in relation to a third party;
- (h) the constitution of trusts and the relationship between settlors, trustees and beneficiaries;
- (i) obligations arising out of dealings prior to the conclusion of a contract;
- (j) insurance contracts arising out of operations carried out by organisations other than undertakings referred to in Article 2 of Directive 2002/83/EC of the European Parliament and of the Council of 5 November 2002 concerning life assurance<sup>(1)</sup> the object of which is to provide benefits for employed or self-employed persons belonging to an undertaking or group of undertakings, or to a trade or group of trades, in the event of death or survival or of discontinuance or curtailment of activity, or of sickness related to work or accidents at work.

3. This Regulation shall not apply to evidence and procedure, without prejudice to Article 18.

4. In this Regulation, the term 'Member State' shall mean Member States to which this Regulation applies. However, in Article 3(4) and Article 7 the term shall mean all the Member States.

#### Article 2

##### Universal application

Any law specified by this Regulation shall be applied whether or not it is the law of a Member State.

## CHAPTER II

### UNIFORM RULES

#### Article 3

##### Freedom of choice

1. A contract shall be governed by the law chosen by the parties. The choice shall be made expressly or clearly demonstrated by the terms of the contract or the circumstances of the case. By their choice the parties can select the law applicable to the whole or to part only of the contract.

2. The parties may at any time agree to subject the contract to a law other than that which previously governed it, whether as a result of an earlier choice made under this Article or of other provisions of this Regulation. Any change in the law to be applied that is made after the conclusion of the contract shall not prejudice its formal validity under Article 11 or adversely affect the rights of third parties.

3. Where all other elements relevant to the situation at the time of the choice are located in a country other than the country whose law has been chosen, the choice of the parties shall not prejudice the application of provisions of the law of that other country which cannot be derogated from by agreement.

4. Where all other elements relevant to the situation at the time of the choice are located in one or more Member States, the

<sup>(1)</sup> OJ L 345, 19.12.2002, p. 1. Directive as last amended by Directive 2002/83/EC of the European Parliament and of the Council of 5 November 2002 concerning life assurance.

parties' choice of applicable law other than that of a Member State shall not prejudice the application of provisions of Community law, where appropriate as implemented in the Member State of the forum, which cannot be derogated from by agreement.

5. The existence and validity of the consent of the parties as to the choice of the applicable law shall be determined in accordance with the provisions of Articles 10, 11 and 13.

#### Article 4

##### Applicable law in the absence of choice

1. To the extent that the law applicable to the contract has not been chosen in accordance with Article 3 and without prejudice to Articles 5 to 8, the law governing the contract shall be determined as follows:

- (a) a contract for the sale of goods shall be governed by the law of the country where the seller has his habitual residence;
- (b) a contract for the provision of services shall be governed by the law of the country where the service provider has his habitual residence;
- (c) a contract relating to a right in rem in immovable property or to a tenancy of immovable property shall be governed by the law of the country where the property is situated;
- (d) notwithstanding point (c), a tenancy of immovable property concluded for temporary private use for a period of no more than six consecutive months shall be governed by the law of the country where the landlord has his habitual residence, provided that the tenant is a natural person and has his habitual residence in the same country;
- (e) a franchise contract shall be governed by the law of the country where the franchisee has his habitual residence;
- (f) a distribution contract shall be governed by the law of the country where the distributor has his habitual residence;
- (g) a contract for the sale of goods by auction shall be governed by the law of the country where the auction takes place, if such a place can be determined;
- (h) a contract concluded within a multilateral system which brings together or facilitates the bringing together of multiple third-party buying and selling interests in financial instruments, as defined by Article 4(1), point (17) of Directive 2004/39/EC, in accordance with non-discretionary rules and governed by a single law, shall be governed by that law.

2. Where the contract is not covered by paragraph 1 or where the elements of the contract would be covered by more than one of points (a) to (h) of paragraph 1, the contract shall be governed by the law of the country where the party required to effect the

characteristic performance of the contract has his habitual residence.

3. Where it is clear from all the circumstances of the case that the contract is manifestly more closely connected with a country other than that indicated in paragraphs 1 or 2, the law of that other country shall apply.

4. Where the law applicable cannot be determined pursuant to paragraphs 1 or 2, the contract shall be governed by the law of the country with which it is most closely connected.

#### Article 5

##### Contracts of carriage

1. To the extent that the law applicable to a contract for the carriage of goods has not been chosen in accordance with Article 3, the law applicable shall be the law of the country of habitual residence of the carrier, provided that the place of receipt or the place of delivery or the habitual residence of the consignor is also situated in that country. If those requirements are not met, the law of the country where the place of delivery as agreed by the parties is situated shall apply.

2. To the extent that the law applicable to a contract for the carriage of passengers has not been chosen by the parties in accordance with the second subparagraph, the law applicable shall be the law of the country where the passenger has his habitual residence, provided that either the place of departure or the place of destination is situated in that country. If these requirements are not met, the law of the country where the carrier has his habitual residence shall apply.

The parties may choose as the law applicable to a contract for the carriage of passengers in accordance with Article 3 only the law of the country where:

- (a) the passenger has his habitual residence; or
- (b) the carrier has his habitual residence; or
- (c) the carrier has his place of central administration; or
- (d) the place of departure is situated; or
- (e) the place of destination is situated.

3. Where it is clear from all the circumstances of the case that the contract, in the absence of a choice of law, is manifestly more closely connected with a country other than that indicated in paragraphs 1 or 2, the law of that other country shall apply.

#### Article 6

##### Consumer contracts

1. Without prejudice to Articles 5 and 7, a contract concluded by a natural person for a purpose which can be regarded as being of a private nature and a professional or commercial activity with another



person acting in the exercise of his trade or profession (the professional) shall be governed by the law of the country where the consumer has his habitual residence, provided that the professional:

- (a) pursues his commercial or professional activities in the country where the consumer has his habitual residence, or
- (b) by any means, directs such activities to that country or to several countries including that country,

and the contract falls within the scope of such activities.

2. Notwithstanding paragraph 1, the parties may choose the law applicable to a contract which fulfils the requirements of paragraph 1, in accordance with Article 3. Such a choice may not, however, have the result of depriving the consumer of the protection afforded to him by provisions that cannot be derogated from by agreement by virtue of the law which, in the absence of choice, would have been applicable on the basis of paragraph 1.

3. If the requirements in points (a) or (b) of paragraph 1 are not fulfilled, the law applicable to a contract between a consumer and a professional shall be determined pursuant to Articles 3 and 4.

4. Paragraphs 1 and 2 shall not apply to:

- (a) a contract for the supply of services where the services are to be supplied to the consumer exclusively in a country other than that in which he has his habitual residence;
- (b) a contract of carriage other than a contract relating to package travel within the meaning of Council Directive 90/314/EEC of 13 June 1990 on package travel, package holidays and package tours <sup>(1)</sup>;
- (c) a contract relating to a right *in rem* in immovable property or a tenancy of immovable property other than a contract relating to the right to use immovable properties on a timeshare basis within the meaning of Directive 94/47/EC;
- (d) rights and obligations which constitute a financial instrument and rights and obligations constituting the terms and conditions governing the issuance or offer to the public and public take-over bids of transferable securities, and the subscription and redemption of units in collective investment undertakings in so far as these activities do not constitute provision of a financial service;
- (e) a contract concluded within the type of system falling within the scope of Article 4(1)(h).

<sup>(1)</sup> OJ L 158, 23.6.1990, p. 59.

## Article 7

### Insurance contracts

1. This Article shall apply to contracts referred to in paragraph 2, whether or not the risk covered is situated in a Member State, and to all other insurance contracts covering risks situated inside the territory of the Member States. It shall not apply to reinsurance contracts.

2. An insurance contract covering a large risk as defined in Article 5(d) of the First Council Directive 73/239/EEC of 24 July 1973 on the coordination of laws, regulations and administrative provisions relating to the taking-up and pursuit of the business of direct insurance other than life assurance <sup>(2)</sup> shall be governed by the law chosen by the parties in accordance with Article 3 of this Regulation.

To the extent that the applicable law has not been chosen by the parties, the insurance contract shall be governed by the law of the country where the insurer has his habitual residence. Where it is clear from all the circumstances of the case that the contract is manifestly more closely connected with another country, the law of that other country shall apply.

3. In the case of an insurance contract other than a contract falling within paragraph 2, only the following laws may be chosen by the parties in accordance with Article 3:

- (a) the law of any Member State where the risk is situated at the time of conclusion of the contract;
- (b) the law of the country where the policy holder has his habitual residence;
- (c) in the case of life assurance, the law of the Member State of which the policy holder is a national;
- (d) for insurance contracts covering risks limited to events occurring in one Member State other than the Member State where the risk is situated, the law of that Member State;
- (e) where the policy holder of a contract falling under this paragraph pursues a commercial or industrial activity or a liberal profession and the insurance contract covers two or more risks which relate to those activities and are situated in different Member States, the law of any of the Member States concerned or the law of the country of habitual residence of the policy holder.

Where, in the cases set out in points (a), (b) or (e), the Member States referred to grant greater freedom of choice of the law applicable to the insurance contract, the parties may take advantage of that freedom.

<sup>(2)</sup> OJ L 228, 16.8.1973, p. 3. Directive as last amended by Directive 2005/68/EC of the European Parliament and of the Council (OJ L 160, 22.6.2005, p. 1). Pursuant to 37 CFR 1.46(B)(2)

To the extent that the law applicable has not been chosen by the parties in accordance with this paragraph, such a contract shall be governed by the law of the Member State in which the risk is situated at the time of conclusion of the contract.

4. The following additional rules shall apply to insurance contracts covering risks for which a Member State imposes an obligation to take out insurance:

- (a) the insurance contract shall not satisfy the obligation to take out insurance unless it complies with the specific provisions relating to that insurance laid down by the Member State that imposes the obligation. Where the law of the Member State in which the risk is situated and the law of the Member State imposing the obligation to take out insurance contradict each other, the latter shall prevail;
- (b) by way of derogation from paragraphs 2 and 3, a Member State may lay down that the insurance contract shall be governed by the law of the Member State that imposes the obligation to take out insurance.

5. For the purposes of paragraph 3, third subparagraph, and paragraph 4, where the contract covers risks situated in more than one Member State, the contract shall be considered as constituting several contracts each relating to only one Member State.

6. For the purposes of this Article, the country in which the risk is situated shall be determined in accordance with Article 2(d) of the Second Council Directive 88/357/EEC of 22 June 1988 on the coordination of laws, regulations and administrative provisions relating to direct insurance other than life assurance and laying down provisions to facilitate the effective exercise of freedom to provide services <sup>(1)</sup> and, in the case of life assurance, the country in which the risk is situated shall be the country of the commitment within the meaning of Article 1(1)(g) of Directive 2002/83/EC.

#### Article 8

##### Individual employment contracts

1. An individual employment contract shall be governed by the law chosen by the parties in accordance with Article 3. Such a choice of law may not, however, have the result of depriving the employee of the protection afforded to him by provisions that cannot be derogated from by agreement under the law that, in the absence of choice, would have been applicable pursuant to paragraphs 2, 3 and 4 of this Article.

2. To the extent that the law applicable to the individual employment contract has not been chosen by the parties, the contract shall be governed by the law of the country in which or, failing that, from which the employee habitually carries out his work in performance of the contract. The country where the

work is habitually carried out shall not be deemed to have changed if he is temporarily employed in another country.

3. Where the law applicable cannot be determined pursuant to paragraph 2, the contract shall be governed by the law of the country where the place of business through which the employee was engaged is situated.

4. Where it appears from the circumstances as a whole that the contract is more closely connected with a country other than that indicated in paragraphs 2 or 3, the law of that other country shall apply.

#### Article 9

##### Overriding mandatory provisions

1. Overriding mandatory provisions are provisions the respect for which is regarded as crucial by a country for safeguarding its public interests, such as its political, social or economic organisation, to such an extent that they are applicable to any situation falling within their scope, irrespective of the law otherwise applicable to the contract under this Regulation.

2. Nothing in this Regulation shall restrict the application of the overriding mandatory provisions of the law of the forum.

3. Effect may be given to the overriding mandatory provisions of the law of the country where the obligations arising out of the contract have to be or have been performed, in so far as those overriding mandatory provisions render the performance of the contract unlawful. In considering whether to give effect to those provisions, regard shall be had to their nature and purpose and to the consequences of their application or non-application.

#### Article 10

##### Consent and material validity

1. The existence and validity of a contract, or of any term of a contract, shall be determined by the law which would govern it under this Regulation if the contract or term were valid.

2. Nevertheless, a party, in order to establish that he did not consent, may rely upon the law of the country in which he has his habitual residence if it appears from the circumstances that it would not be reasonable to determine the effect of his conduct in accordance with the law specified in paragraph 1.

#### Article 11

##### Formal validity

1. A contract concluded between persons who, or whose legal representatives, are domiciled in the same country at the time of its conclusion is

<sup>(1)</sup> OJ L 172, 4.7.1988, p. 1. Directive as last amended by Directive 2005/14/EC of the European Parliament and of the Council (OJ L 149, 11.6.2005, p. 14).

formally valid if it satisfies the formal requirements of the law which governs it in substance under this Regulation or of the law of the country where it is concluded.

2. A contract concluded between persons who, or whose agents, are in different countries at the time of its conclusion is formally valid if it satisfies the formal requirements of the law which governs it in substance under this Regulation, or of the law of either of the countries where either of the parties or their agent is present at the time of conclusion, or of the law of the country where either of the parties had his habitual residence at that time.

3. A unilateral act intended to have legal effect relating to an existing or contemplated contract is formally valid if it satisfies the formal requirements of the law which governs or would govern the contract in substance under this Regulation, or of the law of the country where the act was done, or of the law of the country where the person by whom it was done had his habitual residence at that time.

4. Paragraphs 1, 2 and 3 of this Article shall not apply to contracts that fall within the scope of Article 6. The form of such contracts shall be governed by the law of the country where the consumer has his habitual residence.

5. Notwithstanding paragraphs 1 to 4, a contract the subject matter of which is a right in rem in immovable property or a tenancy of immovable property shall be subject to the requirements of form of the law of the country where the property is situated if by that law:

- (a) those requirements are imposed irrespective of the country where the contract is concluded and irrespective of the law governing the contract; and
- (b) those requirements cannot be derogated from by agreement.

#### Article 12

##### Scope of the law applicable

1. The law applicable to a contract by virtue of this Regulation shall govern in particular:

- (a) interpretation;
- (b) performance;
- (c) within the limits of the powers conferred on the court by its procedural law, the consequences of a total or partial breach of obligations, including the assessment of damages in so far as it is governed by rules of law;
- (d) the various ways of extinguishing obligations, and prescription and limitation of actions;
- (e) the consequences of nullity of the contract.

2. In relation to the manner of performance and the steps to be taken in the event of defective performance, regard shall be had to the law of the country in which performance takes place.

#### Article 13

##### Incapacity

In a contract concluded between persons who are in the same country, a natural person who would have capacity under the law of that country may invoke his incapacity resulting from the law of another country, only if the other party to the contract was aware of that incapacity at the time of the conclusion of the contract or was not aware thereof as a result of negligence.

#### Article 14

##### Voluntary assignment and contractual subrogation

1. The relationship between assignor and assignee under a voluntary assignment or contractual subrogation of a claim against another person (the debtor) shall be governed by the law that applies to the contract between the assignor and assignee under this Regulation.

2. The law governing the assigned or subrogated claim shall determine its assignability, the relationship between the assignee and the debtor, the conditions under which the assignment or subrogation can be invoked against the debtor and whether the debtor's obligations have been discharged.

3. The concept of assignment in this Article includes outright transfers of claims, transfers of claims by way of security and pledges or other security rights over claims.

#### Article 15

##### Legal subrogation

Where a person (the creditor) has a contractual claim against another (the debtor) and a third person has a duty to satisfy the creditor, or has in fact satisfied the creditor in discharge of that duty, the law which governs the third person's duty to satisfy the creditor shall determine whether and to what extent the third person is entitled to exercise against the debtor the rights which the creditor had against the debtor under the law governing their relationship.

#### Article 16

##### Multiple liability

If a creditor has a claim against several debtors who are liable for the same claim, and one of the debtors has already satisfied the claim in whole or in part, the law governing the creditor's obligation towards the debtors who have not yet paid shall apply to the creditor's claim against the debtors who have not yet paid.

claim recourse from the other debtors. The other debtors may rely on the defences they had against the creditor to the extent allowed by the law governing their obligations towards the creditor.

#### Article 17

##### Set-off

Where the right to set-off is not agreed by the parties, set-off shall be governed by the law applicable to the claim against which the right to set-off is asserted.

#### Article 18

##### Burden of proof

1. The law governing a contractual obligation under this Regulation shall apply to the extent that, in matters of contractual obligations, it contains rules which raise presumptions of law or determine the burden of proof.

2. A contract or an act intended to have legal effect may be proved by any mode of proof recognised by the law of the forum or by any of the laws referred to in Article 11 under which that contract or act is formally valid, provided that such mode of proof can be administered by the forum.

### CHAPTER III

#### OTHER PROVISIONS

#### Article 19

##### Habitual residence

1. For the purposes of this Regulation, the habitual residence of companies and other bodies, corporate or unincorporated, shall be the place of central administration.

The habitual residence of a natural person acting in the course of his business activity shall be his principal place of business.

2. Where the contract is concluded in the course of the operations of a branch, agency or any other establishment, or if, under the contract, performance is the responsibility of such a branch, agency or establishment, the place where the branch, agency or any other establishment is located shall be treated as the place of habitual residence.

3. For the purposes of determining the habitual residence, the relevant point in time shall be the time of the conclusion of the contract.

#### Article 20

##### Exclusion of renvoi

The application of the law of any country specified by this Regulation means the application of the rules of law in force in

that country other than its rules of private international law, unless provided otherwise in this Regulation.

#### Article 21

##### Public policy of the forum

The application of a provision of the law of any country specified by this Regulation may be refused only if such application is manifestly incompatible with the public policy (*ordre public*) of the forum.

#### Article 22

##### States with more than one legal system

1. Where a State comprises several territorial units, each of which has its own rules of law in respect of contractual obligations, each territorial unit shall be considered as a country for the purposes of identifying the law applicable under this Regulation.

2. A Member State where different territorial units have their own rules of law in respect of contractual obligations shall not be required to apply this Regulation to conflicts solely between the laws of such units.

#### Article 23

##### Relationship with other provisions of Community law

With the exception of Article 7, this Regulation shall not prejudice the application of provisions of Community law which, in relation to particular matters, lay down conflict-of-law rules relating to contractual obligations.

#### Article 24

##### Relationship with the Rome Convention

1. This Regulation shall replace the Rome Convention in the Member States, except as regards the territories of the Member States which fall within the territorial scope of that Convention and to which this Regulation does not apply pursuant to Article 299 of the Treaty.

2. In so far as this Regulation replaces the provisions of the Rome Convention, any reference to that Convention shall be understood as a reference to this Regulation.

#### Article 25

##### Relationship with existing international conventions

1. This Regulation shall not prejudice the application of international conventions to which one or more Member States are parties at the time when this Regulation is adopted and which lay down rules of law in respect of contractual obligations.

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2. However, this Regulation shall, as between Member States, take precedence over conventions concluded exclusively between two or more of them in so far as such conventions concern matters governed by this Regulation.

#### Article 26

##### List of Conventions

1. By 17 June 2009, Member States shall notify the Commission of the conventions referred to in Article 25(1). After that date, Member States shall notify the Commission of all denunciations of such conventions.

2. Within six months of receipt of the notifications referred to in paragraph 1, the Commission shall publish in the *Official Journal of the European Union*:

- (a) a list of the conventions referred to in paragraph 1;
- (b) the denunciations referred to in paragraph 1.

#### Article 27

##### Review clause

1. By 17 June 2013, the Commission shall submit to the European Parliament, the Council and the European Economic and Social Committee a report on the application of this Regulation. If appropriate, the report shall be accompanied by proposals to amend this Regulation. The report shall include:

- (a) a study on the law applicable to insurance contracts and an assessment of the impact of the provisions to be introduced, if any; and

- (b) an evaluation on the application of Article 6, in particular as regards the coherence of Community law in the field of consumer protection.

2. By 17 June 2010, the Commission shall submit to the European Parliament, the Council and the European Economic and Social Committee a report on the question of the effectiveness of an assignment or subrogation of a claim against third parties and the priority of the assigned or subrogated claim over a right of another person. The report shall be accompanied, if appropriate, by a proposal to amend this Regulation and an assessment of the impact of the provisions to be introduced.

#### Article 28

##### Application in time

This Regulation shall apply to contracts concluded after 17 December 2009.

#### CHAPTER IV

##### FINAL PROVISIONS

#### Article 29

##### Entry into force and application

This Regulation shall enter into force on the 20th day following its publication in the *Official Journal of the European Union*.

It shall apply from 17 December 2009 except for Article 26 which shall apply from 17 June 2009.

This Regulation shall be binding in its entirety and directly applicable in the Member States in accordance with the Treaty establishing the European Community.

Done at Strasbourg, 17 June 2008.

For the European Parliament

The President

H.-G. PÖTTERING

For the Council

The President

J. LENARČIČ

## JUDGMENT OF THE COURT (First Chamber)

9 July 2015 (\*)

(Reference for a preliminary ruling — Directive 98/59/EC — Article 1(1)(a) — Collective redundancies — Concept of ‘worker’ — Member of the board of directors of a limited liability company — Person working under a scheme for training and reintegration into the labour market and benefitting from a public training grant but not receiving remuneration from the employer)

In Case C-229/14,

REQUEST for a preliminary ruling under Article 267 TFEU from the Arbeitsgericht Verden (Germany), made by decision of 6 May 2014, received at the Court on 12 May 2014, in the proceedings

**Ender Balkaya**

v

**Kiesel Abbruch- und Recycling Technik GmbH,**

THE COURT (First Chamber),

composed of A. Tizzano, President of the Chamber, S. Rodin (Rapporteur), A. Borg Barthet, E. Levits and M. Berger, Judges,

Advocate General: Y. Bot,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after considering the observations submitted on behalf of:

- E. Balkaya, by M. Barton, Rechtsanwalt,
- Kiesel Abbruch- und Recycling Technik GmbH, by P. Wallenstein, Rechtsanwalt,
- the Estonian Government, by N. Grünberg, acting as Agent,
- the Polish Government, by B. Majczyna, acting as Agent,
- the European Commission, by M. Kellerbauer and J. Enegren, acting as Agents,

having decided, after hearing the Advocate General, to proceed to judgment without an Opinion,

gives the following

### Judgment

- 1 This request for a preliminary ruling concerns the interpretation of Article 1(1)(a) of Council Directive 98/59/EC of 20 July 1998 on the approximation of the laws of the Member States relating to collective redundancies (OJ 1998 L 225, p. 16).

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- 2 The request has been made in proceedings between Mr Balkaya and Kiesel Abbruch- und Recycling Technik GmbH ('Kiesel Abbruch') concerning the lawfulness of a dismissal on economic grounds announced by the latter, upon the closure of an establishment, no notification of the projected collective redundancies having been given to the Bundesagentur für Arbeit (German Federal Employment Agency) before that dismissal.

### Legal context

#### *EU legislation*

- 3 Article 1(1) of Directive 98/59 provides:

‘1. For the purposes of this Directive:

(a) “collective redundancies” means dismissals effected by an employer for one or more reasons not related to the individual workers concerned where, according to the choice of the Member States, the number of redundancies is:

(i) either, over a period of 30 days:

- at least 10 in establishments normally employing more than 20 and less than 100 workers,
- at least 10% of the number of workers in establishments normally employing at least 100 but less than 300 workers,
- at least 30 in establishments normally employing 300 workers or more,

(ii) or, over a period of 90 days, at least 20, whatever the number of workers normally employed in the establishments in question;

(b) “workers’ representatives” means the workers’ representatives provided for by the laws or practices of the Member States.

For the purpose of calculating the number of redundancies provided for in the first subparagraph of point (a), terminations of an employment contract which occur on the employer’s initiative for one or more reasons not related to the individual workers concerned shall be assimilated to redundancies, provided that there are at least five redundancies.’

- 4 Article 3 of Directive 98/59 provides:

‘1. Employers shall notify the competent public authority in writing of any projected collective redundancies.

...

2. Employers shall forward to the workers’ representatives a copy of the notification provided for in paragraph 1.

The workers’ representatives may send any comments they may have to the competent public authority.’

- 5 Article 4(1) and (2) of the directive provides:

‘1. Projected collective redundancies notified to the competent public authority shall take effect not earlier than 30 days after the notification referred to in Article 3(1) without prejudice to any provisions governing individual rights with regard to notice of dismissal.

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Member States may grant the competent public authority the power to reduce the period provided for in the preceding subparagraph.

2. The period provided for in paragraph 1 shall be used by the competent public authority to seek solutions to the problems raised by the projected collective redundancies.'

6 According to Article 5 of the directive:

'This Directive shall not affect the right of Member States to apply or to introduce laws, regulations or administrative provisions which are more favourable to workers or to promote or to allow the application of collective agreements more favourable to workers.'

*German law*

7 Paragraph 17 of the Law on protection against unfair dismissal (Kündigungsschutzgesetz, 'KSchG'), which lays down the requirement to give a collective redundancies notice, is worded as follows:

'(1) The employer is under an obligation to notify the Employment Agency before it makes redundant:

1. more than 5 workers in establishments normally employing more than 20 and less than 60 workers;

...

over a period of 30 calendar days. Any other termination of an employment relationship brought about by the employer shall be assimilated to redundancy.

(2) If the employer contemplates making redundancies that are subject to the obligation to issue a notification under subparagraph 1 it shall promptly provide the works council with the appropriate information and notify it in writing, in particular, of:

1. the reasons for the projected redundancies;
2. the number and professional categories of workers to be made redundant;
3. the number and professional categories of workers normally employed;
4. the period over which the redundancies are expected to take place;
5. the proposed criteria for selecting the workers to be made redundant;
6. the proposed criteria for calculating any redundancy payments.

...

(3) The employer must simultaneously forward to the Employment Agency a copy of the notice given to the works council; this must contain at least the details stated in points 1 to 5 of the first sentence of subparagraph 2.

...

(5) The following shall not be regarded as workers for the purposes of this paragraph:

1. in establishments of one legal person, the members of the body that is responsible for the legal representation of that person;
2. in unincorporated associations without a legal personality, the persons entitled under the law, the statutes or by the articles of association to represent that association;

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3. company directors, managers of the establishment and other persons holding analogous managerial posts, in so far as they are themselves authorised to take decisions relating to the recruitment and dismissal of workers.’

8 Paragraph 6 of the Law on limited liability companies (Gesetz betreffend die Gesellschaft mit beschränkter Haftung, ‘GmbHG’), concerning the status of director, provides:

‘(1) The company shall have one or more directors.

(2) Only a natural person with full legal capacity may be a director.

...

(3) Shareholders or any other persons may be appointed as directors. The appointment shall be made either in the company’s articles of association or in accordance with the provisions of the third chapter of this law.

...’

9 Paragraph 35 of the GmbHG provides:

‘(1) The company shall be represented in legal proceedings and in other matters by its directors.

(2) Where several directors have been appointed, they are only authorised to represent the company jointly, unless the articles of association provide otherwise ...

...’

10 Paragraph 37 of the GmbHG, headed ‘Limitation on the power of representation’, provides:

‘(1) The directors are required to respect, as regards the company, the limitations imposed on their power of representation by the articles of association or, unless otherwise stated in the articles of association, by the decisions of the shareholders.

(2) The limitations on the directors’ power of representation may not be relied on against third parties. That shall be the case, in particular, when the representation is limited to certain legal acts or categories of legal act, or to certain circumstances, or to a certain period, or to certain named places or, furthermore, when the consent of the shareholders or of a body of the company is required for certain acts.’

11 Paragraph 38 of the GmbHG, concerning the removal of directors, provides:

‘(1) The directors may be removed at any time, without prejudice to any claim for damages that may arise under existing contracts.

(2) The articles of association may limit the power to remove a director to cases in which there are serious reasons justifying that decision. Such reasons include, inter alia, serious breach of duty or lack of fitness to conduct the business of the company properly.’

12 Paragraph 43 of the GmbHG on directors’ liability provides:

‘(1) The directors must conduct the company’s business using the care due of a prudent businessman.

(2) Directors who breach their obligations shall be jointly and severally liable to the company for the damage that they have caused.

...

13 Paragraph 46 of the GmbHG, headed ‘Powers of the shareholders’, is worded as follows:

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‘The following shall be subject to the decision of the shareholders:

1. the adoption of the annual accounts and the distribution of the profits;
- 1a. decisions concerning the publication of the financial statements in accordance with international accounting standards ... and concerning the approval of the annual accounts drawn up by the directors;
- 1b. approval of the consolidated accounts prepared by the directors;
2. the calling in of contributions;
3. the repayment of additional contributions;
4. the division, consolidation or redemption of shares;
5. the appointment, removal or discharge of directors;
6. the measures for the review and supervision of management;
7. the appointment of persons having power of attorney and representatives authorised to carry out generally business operations on behalf of the company;
8. the conduct of the company’s claims for damages against the directors or the shareholders, as a result of the formation of the company or its management, and the representation of the company in proceedings brought against its directors.’

**The dispute in the main proceedings and the questions referred for a preliminary ruling**

- 14 Kiesel Abbruch, a limited liability company incorporated under German law, employed Mr Balkaya, with effect from 1 April 2011, as a technician. Mr Balkaya was appointed to work within the company and with its clients.
- 15 Kiesel Abbruch terminated, with effect from 15 February 2013, all of the contracts of employment of its employees, including Mr Balkaya, and ceased all its business, which had become loss-making, on the site at Achim (Germany). Mr Balkaya was given notice of dismissal by letter of 7 January 2013.
- 16 It is not disputed that Kiesel Abbruch did not give notification of the projected collective redundancies to the Bundesagentur für Arbeit before giving notice of Mr Balkaya’s dismissal.
- 17 Mr Balkaya relies on that omission to challenge, before the referring court, the validity of his dismissal. He submits that, as the number of workers normally employed by Kiesel Abbruch in its establishment in Achim was above the threshold of 20 persons provided for in Paragraph 17(1)(1) of the KSchG, the employer was required, under that provision, to give such notification before giving notice of dismissal.
- 18 As is apparent from the order for reference, it is not disputed that 18 people, including Mr Balkaya, were amongst the workers normally employed by Kiesel Abbruch in that establishment at the date on which notice of the dismissal was given.
- 19 However, the parties in the main proceedings disagree as to the question whether, in addition, three other persons who were also employed by Kiesel Abbruch must be counted in that category, in order to determine whether the threshold of 20 persons, laid down in Paragraph 17(1)(1) of the KSchG, was attained.
- 20 First, that question relates to Mr S, who was employed as a draftsman and had terminated his own contract of employment with effect from 7 December 2012.

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- 21 Second, Kiesel Abbruch employed, at the date of the dismissals of which notice was given, Mr L. as a director. Mr L. did not hold any shares in Kiesel Abbruch and it was only jointly with another director that he was entitled to act on behalf of the company.
- 22 Third, at that same date, Kiesel Abbruch employed Ms S., who was undergoing training within the company to re-qualify as an office assistant, funded by the Jobcenter im Landkreis Diepholz (the public employment office for the district of Diepholz). A grant, which was equivalent to the whole of the remuneration due to Ms S for her work done in the context of her training, was paid to her directly by the Bundesagentur für Arbeit.
- 23 It is clear from the order for reference that the referring court considers it to be proven that Mr S. falls within the category of workers normally employed that must be taken into account in accordance with Paragraph 17(1)(1) of KSchG, which transposed Article 1(1)(a) of Directive 98/59 into German law. Thus, the number of 19 workers within that category is reached.
- 24 Therefore, the question arises as to whether it is appropriate also to include in that category of employed workers, within the meaning of those provisions, a director, such as Mr L., and a person undergoing requalification training, such as Ms S., with the result that, in the main proceedings, more than 20 workers were normally employed by Kiesel Abbruch within its establishment at the date of the dismissal in question.
- 25 In that regard, the referring court specifies, in the first place, as regards Mr L., that, under Paragraph 17(5)(1) of the KSchG, members of the body of a legal person which is responsible for the legal representation of that person are deemed not to be workers or employees for the purposes of that provision. The numerically most significant group of those members is that of directors of limited liability companies ('Gesellschaften mit beschränkter Haftung').
- 26 Furthermore, the referring court notes, as regards the relationship between the director and such a company, that German law clearly distinguishes the status of director as an officer, on the one hand, from the rights and obligations of the director vis-à-vis the company, on the other hand. While that status is acquired upon the appointment of the director by a general meeting of the shareholders, the most powerful body in the company, the rights and obligations of the director as regards that company are governed by the director's service contract. That contract is a contract for services in the form of a business management contract and does not constitute, according to German case-law, an employment contract.
- 27 In that context, the referring court raises a question, in particular, as to the interpretation of the criterion — established by the judgment in *Danosa* (C-232/09, EU:C:2010:674) for determining whether a member of a board of a company has the status of worker within the meaning of EU law — of carrying out an activity under the direction or supervision of another body of such a company.
- 28 In the second place, as regards a person such as Ms S., who has the status of 'trainee', performing real work within a company in order to acquire or improve skills or following vocational training, the referring court observes that, whereas, normally, recognised vocational training leads to the conclusion of a contract for that purpose between the company providing the training and the trainee and to the payment of remuneration by that company, the training provided to Ms S. was not the subject of such a contract and Kiesel Abbruch did not pay her a salary.
- 29 Therefore, the referring court is unsure as to the relevant criteria to be used to assess whether persons who are undergoing such vocational training or internships are workers, for the purposes of Article 1(1)(a) of Directive 98/59, and, in particular, as to the relevance in that regard of remuneration paid directly by the employer.
- 30 In those circumstances the Arbeitsgericht Verden decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

'(1) Is applicable EU law, in particular Article 1(1)(a) of Directive 98/59, to be interpreted as precluding national legislative provisions or practices which, in order to determine whether a member

of the board of directors of a limited liability company in the calculation provided for by that provision of the number of workers employed, even where he performs his duties under the direction and subject to the supervision of another body of that company, receives remuneration in return for the performance of his duties and does not himself own any shares in the company?

- (2) Is applicable EU law, in particular Article 1(1)(a) of Directive 98/59, to be interpreted as making it mandatory also to regard as workers, in the calculation provided for by that provision of the number of workers employed, persons who, while not receiving remuneration from the employer, perform real work within the undertaking, with financial support from, and the recognition of, the public authority responsible for the promotion of employment, in order to acquire or improve skills or to complete vocational training ('trainees'), or are Member States permitted to lay down national legislative provisions or practices in that regard?

## The questions referred

### *The first question*

- 31 By its first question, the referring court asks, in essence, whether Article 1(1)(a) of Directive 98/59 must be interpreted as meaning that it precludes a national law or practice that does not take into account, in the calculation provided for by that provision of the number of workers employed, a member of the board of directors of a capital company, such as the director in question in the main proceedings, who performs his duties under the direction and subject to the supervision of another body of that company, receives remuneration in return for the performance of his duties and does not himself own any shares in the company.
- 32 In order to reply to this question, it must be recalled, first of all, that by harmonising the rules applicable to collective redundancies, the EU legislature intended both to ensure comparable protection for workers' rights in the different Member States and to harmonise the costs which such protective rules entail for European Union undertakings (see, inter alia, judgments in *Commission v Portugal*, C-55/02, EU:C:2004:605, paragraph 48, and *Commission v Italy*, C-596/12, EU:C:2014:77, paragraph 16).
- 33 Therefore, contrary to the submission of Kiesel Abbruch, the concept of 'worker', referred to in Article 1(1)(a) of Directive 98/59, cannot be defined by reference to the legislation of the Member States but must be given an autonomous and independent meaning in the EU legal order (see, by analogy, judgment in *Commission v Portugal*, C-55/02, EU:C:2004:605, paragraph 49). Otherwise, the methods for calculation of the thresholds laid down in that provision, and therefore the thresholds themselves, would be within the discretion of the Member States, which would allow the latter to alter the scope of that directive and thus to deprive it of its full effect (see, to that effect, judgment in *Confédération générale du travail and Others*, C-385/05, EU:C:2007:37, paragraph 47).
- 34 It is apparent, next, from the settled case-law of the Court that that concept of 'worker' must be defined in accordance with objective criteria which distinguish the employment relationship by reference to the rights and duties of the persons concerned. In that regard, the essential feature of an employment relationship is that, for a certain period of time, a person performs services for and under the direction of another person, in return for which he receives remuneration (see judgment in *Commission v Italy*, C-596/12, EU:C:2014:77, paragraph 17, citing, by analogy, the judgment in *Danosa*, C-232/09, EU:C:2010:674, paragraph 39).
- 35 It that regard, in so far as the referring court emphasises the fact that the employment relationship of a director such as the one in question in the main proceedings is governed, inter alia, by a service contract to act as director, which is not, according to German case-law, a contract of employment, it must be observed, first, that it is clear from the settled case-law of the Court that the nature of the employment relationship under national law is of no consequence as regards whether or not a person is

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a worker for the purposes of EU law (see, to that effect, judgment in *Kiiski*, C-116/06, EU:C:2007:536, paragraph 26 and case-law cited).

- 36 It follows that, provided that a person meets the conditions specified in paragraph 34 above, the nature of that person's legal relationship with the other party to the employment relationship has no bearing on the application of Directive 98/59 (see, by analogy, judgment in *Danosa*, C-232/09, EU:C:2010:674, paragraph 40).
- 37 In the second place, in so far as the referring court is unsure, in particular, as to the existence, in the main proceedings, of a relationship of subordination, in accordance with the case-law of the Court regarding the concept of 'worker', because the degree of dependency or subordination of a director, such as the one in question in the main proceedings, in the exercise of his functions is of a lesser intensity than that of a worker within the usual meaning under German law, it must be observed that whether such a relationship of subordination exists must, in each particular case, be assessed on the basis of all the factors and circumstances characterising the relationship between the parties (see, to that effect, judgment in *Danosa* C-232/09, EU:C:2010:674, paragraph 46).
- 38 In that regard, it is apparent from the case-law of the Court, which is applicable in connection with Directive 98/59, the fact that a person is a member of the board of directors of a capital company is not enough in itself to rule out the possibility that that person is in a relationship of subordination to that company (see, to that effect, judgments in *Danosa* C-232/09, EU:C:2010:674, paragraph 47, and *Commission v Italy*, C-596/12, EU:C:2014:77, paragraphs 14, 17 and 18). It is necessary to consider the circumstances in which the board member was recruited; the nature of the duties entrusted to that person; the context in which those duties were performed; the scope of the person's powers and the extent to which he or she was supervised within the company; and the circumstances under which the person could be removed (see judgment in *Danosa* C-232/09, EU:C:2010:674, paragraph 47).
- 39 Thus, the Court has already held that a member of a board of directors of a capital company who, in return for remuneration, provides services to the company which has appointed him and of which he is an integral part, who carries out his activities under the direction or supervision of another body of that company and who can, at any time, be removed from his duties without such removal being subject to any restriction, satisfies, *prima facie*, the criteria for being treated as a 'worker' within the meaning of EU law (see, to that effect, judgment in *Danosa*, C-232/09, EU:C:2010:674, paragraphs 51 and 56).
- 40 In the present case, it must be held that it is apparent from the order for reference that a director of a capital company, such as the director in question in the main proceedings, is appointed by the general meeting of shareholders of that company, which may revoke his mandate at any time against the will of the director. Furthermore, that director is, in the exercise of his functions, subject to the direction and supervision of that body, and, in particular, to the requirements and restrictions that are imposed on him in that regard. Moreover, although it is not by itself a decisive factor in that context, it must be observed that a director, such as the one in the main proceedings, does not hold any shares in the company for which he carries out his functions.
- 41 In those circumstances, it must be found that, even if such a board member of a capital company enjoys a degree of latitude in the performance of his duties that exceeds, in particular, that of a worker within the meaning of German law, who may be directed by the employer, as the national court has observed, as to the specific tasks that he must complete and the manner in which they must be carried out, the fact remains that the board member is in a relationship of subordination vis-à-vis that company within the meaning of the case-law cited at paragraphs 38 and 39 above (see, to that effect, the judgment in *Danosa*, C-232/09, EU:C:2010:674, paragraph 49 to 51).
- 42 Furthermore, it is common ground that a director, such as the one in the main proceedings, receives remuneration in return for the services he provides.

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- 43 Having regard to the foregoing considerations, it must, therefore, be held that a member of the board of directors of a capital company, such as the director in question in the main proceedings, must be regarded as a ‘worker’ within the meaning of Article 1(1)(a) of Directive 98/59 and, consequently, be taken into account in the calculation of the thresholds laid down in that article.
- 44 That interpretation is also borne out by the objective of that directive which is, as is apparent from recital 2 in the preamble thereto, *inter alia*, to afford greater protection to workers in the event of collective redundancies. In accordance with that objective, a narrow definition cannot be given to the concepts that define the scope of that directive, including the concept of ‘worker’ in Article 1(1)(a) of the directive (see, to that effect, judgments in *Athinaiki Chartopoiia*, C-270/05, EU:C:2007:101, paragraphs 25 and 26, and, by analogy, *Union syndicale Solidaires Isère*, C-428/09, EU:C:2010:612, paragraph 22).
- 45 Finally, the Court rejects the submission made by Keisel Abbruch and the Estonian government that a director such as the one in question in the main proceedings does not need the protection afforded by Directive 98/59 in the event of collective redundancies.
- 46 In that regard, it must be held, first, that there is nothing to suggest that an employee who is a board member of a capital company, in particular, a small or medium sized company such as that at issue in the main proceedings, is necessarily in a different situation from that of other persons employed by that company as regards the need to mitigate the consequences of his dismissal, and, *inter alia*, to alert, for that purpose, the competent public authority so that it is able to seek solutions to the problems raised by all the projected collective redundancies (see, to that effect, judgment in *Junk*, C-188/03, EU:C:2005:59, paragraph 48, and in *Claes and Others*, C-235/10 to C-239/10, EU:C:2011:119, paragraph 56).
- 47 Second, it must be observed that a national law or practice, such as that at issue in the main proceedings, which does not take into account the board members of a capital company in the calculation provided for in Article 1(1)(a) of Directive 98/59 of the number of workers employed, is liable not only to affect the protection afforded by that directive to those members, but, above all, to deprive all the workers employed by certain establishments, normally employing more than 20 workers, of the rights which they derive from that directive and thus undermines its effectiveness (see, to that effect, judgment in *Confédération générale du travail and Others*, C-385/05, EU:C:2007:37, paragraph 48).
- 48 Having regard to all the foregoing considerations, the answer to the first question is that Article 1(1)(a) of Directive 98/59 must be interpreted as meaning that it precludes a national law or practice that does not take into account, in the calculation provided for by that provision of the number of workers employed, a member of the board of directors of a capital company, such as the director in question in the main proceedings, who performs his duties under the direction and subject to the supervision of another body of that company, receives remuneration in return for the performance of his duties and does not himself own any shares in the company.

#### *The second question*

- 49 By its second question, the referring court asks, in essence, whether Article 1(1)(a) of Directive 98/59 must be interpreted as meaning that it is necessary to regard as a worker for the purposes of that provision a person, such as the one in question in the main proceedings, who, while not receiving remuneration from his employer, performs real work within the undertaking in the context of a traineeship — with financial support from, and the recognition of, the public authority responsible for the promotion of employment — in order to acquire or improve skills or complete vocational training.
- 50 In that regard, it must be recalled, in the first place, that it is clear from the Court’s well-established case-law that the concept of ‘worker’ in EU law extends to a person who serves a traineeship or periods of apprenticeship in an occupation that may be regarded as practical preparation related to the actual pursuit of the occupation in question, provided that the person is under the conditions of genuine and effective activity as an employed person, for and under the direction of an employer.

The Court has stated that that conclusion cannot be invalidated by the fact that the productivity of the person concerned is low, that he does not carry out full duties and that, accordingly, he works only a small number of hours per week and thus receives limited remuneration (see, to that effect, *inter alia*, judgments in *Lawrie-Blum*, 66/85, EU:C:1986:284, paragraphs 19 to 21; *Bernini*, C-3/90, EU:C:1992:89, paragraphs 15 and 16; *Kurz*, C-188/00, EU:C:2002:694, paragraphs 33 and 34, and *Kranemann*, C-109/04, EU:C:2005:187, paragraph 13).

- 51 In the second place, it is also clear from the Court's case-law that neither the legal context of the employment relationship under national law, in the framework of which the vocational training or internship is carried out, nor the origin of the funds from which the person concerned is remunerated and, in particular, in the present case, the funding of that remuneration through public grants, can have any consequence in regard to whether or not the person is to be regarded as a worker (see, to that effect, *inter alia*, judgments in *Bettray*, 344/87, EU:C:1989:226, paragraphs 15 and 16; *Birden*, C-1/97, EU:C:1998:568, paragraph 28, and *Kurz*, C-188/00, EU:C:2002:694, point 34).
- 52 Accordingly, and in the light of the considerations set out, in particular, in paragraphs 33, 34 and 44 of this judgment, the answer to the second question is that Article 1(1)(a) of Directive 98/59 must be interpreted as meaning that it is necessary to regard as a worker for the purposes of that provision a person, such as the one in question in the main proceedings, who, while not receiving remuneration from his employer, performs real work within the undertaking in the context of a traineeship — with financial support from, and the recognition of, the public authority responsible for the promotion of employment — in order to acquire or improve skills or complete vocational training.

### Costs

- 53 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (First Chamber) hereby rules:

1. **Article 1(1)(a) of Directive 98/59/EC of 20 July 1998, on the approximation of the laws of the Member States relating to collective redundancies, must be interpreted as meaning that it precludes a national law or practice that does not take into account, in the calculation provided for by that provision of the number of workers employed, a member of the board of directors of a capital company, such as the director in question in the main proceedings, who performs his duties under the direction and subject to the supervision of another body of that company, receives remuneration in return for the performance of his duties and does not himself own any shares in the company.**
2. **Article 1(1)(a) of Directive 98/59 must be interpreted as meaning that it is necessary to regard as a worker for the purposes of that provision a person, such as the one in question in the main proceedings, who, while not receiving remuneration from his employer, performs real work within the undertaking in the context of a traineeship — with financial support from, and the recognition of, the public authority responsible for the promotion of employment — in order to acquire or improve skills or complete vocational training.**

[Signatures]

§ 19. Erfinderprinzip Ann  
und Erfinderrecht

Kraßer/Ann,  
Patentrecht  
7. Auflage 2016

Rn. 7-16

## II. Entstehung des Erfinderrechts. Rechtsnachfolge

1. Das Erfinderrecht entsteht durch den tatsächlichen Vorgang des Schaffens der Erfindung. Dieser ist stets das **Werk eines oder mehrerer Menschen**. Auch durch den Einsatz elektronischer Datenverarbeitungsanlagen kommen neue technische Problemlösungen nur zustande, wenn Menschen die Anlage im Hinblick auf eine solche Lösung gezielt einsetzen oder zumindest die Brauchbarkeit eines von ihr ausgegebenen Resultats als Lösung eines technischen Problems erkennen.<sup>7</sup> Es mag sein, dass solches Handeln über das dem Fachmann Geläufige oft nicht hinausgeht; dann kommt mangels erfinderischer Tätigkeit Patentschutz für die mittels des Computers erarbeitete Lösung ohnehin nicht in Betracht. Die Möglichkeit des Einsatzes von Datenverarbeitungsanlagen macht heute wohl manche Problemlösung zu einer naheliegenden, die unter früheren Verhältnissen als erfinderisch hätte gelten können. Eben deshalb bedarf es, wenn mittels Computers nicht naheliegende Lösungen gefunden werden sollen, in erheblichem Umfang menschlicher Geistestätigkeit. Wo auf solchem Weg eine schutzwürdige Erfindung zustande kommt, ist der Computer stets nur Hilfsmittel des Erfinders, nicht aber selbst „Erfinder“.

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2. Das Erfinderrecht entsteht, sobald eine patentierbare oder gebrauchsmusterfähige Erfindung im früher erläuterten Sinne (vgl. oben § 13 Rn. 21) **fertig** ist.<sup>8</sup> Es enthält, wenn die Erfindung die Voraussetzungen sowohl für Patent- als auch für Gebrauchsmusterschutz erfüllt, als vermögensrechtlichen Bestandteil das Recht auf das Patent *und* das Recht auf das Gebrauchsmuster, andernfalls je nach Sachlage nur eines von beiden. Im Übrigen richten sich aber Entstehung und Zuordnung dieser Rechte nach den gleichen Regeln. Deshalb genügt es insoweit, das Recht auf das Patent zu nennen, ohne auch das Recht auf das Gebrauchsmuster ausdrücklich zu erwähnen.

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3. Praktische Bedeutung erlangt das Erfinderrecht allerdings erst, wenn die Erfindung durch irgendeine Mitteilung oder körperliche Wiedergabe **verlautbart** ist, die die technische Handlungsanweisung, ohne sie der Öffentlichkeit zugänglich zu machen (vgl. unten § 19 Rn. 36 ff.), für einen Fachmann erkennbar werden lässt<sup>9</sup> und damit die Erfindung zu einem unabhängig von ihrem Urheber existenzfähigen Immaterialgut macht. Erst die Verlautbarung ermöglicht es, dass andere als der Erfinder auf die Erfindung einwirken, insbesondere sie benutzen, weitergeben, zum Schutz anmelden usw. Solange sie – was bei einer fertigen Erfindung selten sein wird – allein im Kopf des Erfinders vorhanden ist, droht ihr schon faktisch kein fremder Zugriff. Dennoch empfiehlt es sich nicht, als Entstehungszeitpunkt des Erfinderrechts die Verlautbarung anzusehen;<sup>10</sup> sie aktualisiert lediglich das Bedürfnis für eine individuelle Zuordnung der Erfindung; dagegen liegt im Schaffen der Erfindung der innere Grund, der eine solche Zuordnung erst rechtfertigt. Nimmt man demgemäß die Fertigstellung der Erfindung als Zeitpunkt der

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Exhibit 19

Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/940,681

<https://beck-online.beck.de/Print/CurrentDoc?vpath=bibdata%5CKomm%5CKrasser/Patent/Patent%2019>

REEL: 049669 FRAME: 0148



Entstehung des Rechts an, erübrigt sich die Frage, unter welchen Voraussetzungen eine Verlautbarung vorliegt: hinreichend verlautbart ist jede Erfindung, für die überhaupt ein Bedürfnis zur Geltendmachung des Erfinderrechts auftritt.

4. Das Schaffen einer Erfindung ist ein **Realakt**, kein Rechtsgeschäft. Es setzt keine Geschäftsfähigkeit voraus. Auch geschäftsunfähige oder in der Geschäftsfähigkeit beschränkte Personen erwerben ein Erfinderrecht, wenn sie eine Erfindung machen. Es bedarf dabei keinerlei Mitwirkung eines gesetzlichen Vertreters. Da das erfinderische Handeln kein rechtsgeschäftliches ist, findet keine Stellvertretung statt. Auch gibt es hier keine Zurechnung fremden tatsächlichen Verhaltens, wie sie etwa in den Fällen der §§ 31 und 855 BGB und bei Verarbeitungsklauseln im Rahmen des § 950 BGB erfolgt. Erfinderrechte können daher nur als Rechte **natürlicher Personen** neu entstehen, und zwar derjenigen, die die Erfindung wirklich gemacht haben, nicht anderer, für welche diese – in welcher Funktion auch immer – tätig geworden sind.<sup>11</sup> Insbesondere ist mit dem Erfinderprinzip die Vorstellung unvereinbar, es gebe „Betriebserfindungen“, die keinem Menschen als individuelle Leistung zugerechnet werden könnten, so dass das Recht an ihnen von vornherein in der Person des Betriebsinhabers (gegebenenfalls also auch einer juristischen Person) entstehe.

5. Das Recht auf das Patent kann nach Entstehung des Erfinderrechts von Todes wegen, kraft rechtsgeschäftlicher Verfügung seines Inhabers (zunächst also des Erfinders) oder kraft Inanspruchnahme durch den ArbGeb des Erfinders auf einen **Rechtsnachfolger** übergehen. Es handelt sich dann jedoch nicht um ursprünglichen, sondern um abgeleiteten Erwerb, selbst wenn die Rechtsnachfolge durch eine schon vor der Entstehung des Rechts vorgenommene Verfügung (Vorausverfügung) bewirkt wird.

Keine Rechtsnachfolge unter Lebenden gibt es auf der persönlichkeitsrechtlichen Seite des Erfinderrechts; insbesondere verbleibt, wenn das Recht auf das Patent auf einen anderen übergeht, dem Erfinder das Recht, gemäß dem PatG oder dem EPÜ als solcher genannt zu werden. Nach dem Tode des Erfinders wird man Erben oder Vertrauenspersonen in gewissem Umfang die Befugnis zubilligen müssen, die Anerkennung der Urheberschaft des Verstorbenen durchzusetzen.

6. Der Erfinder, in dessen Person das Recht auf das Patent entsteht, kann verpflichtet sein, es einem anderen zu übertragen. Eine solche **Verpflichtung** kann beispielsweise aus Anlass eines Forschungsauftrags oder der Gewährung von Forschungsmitteln,<sup>12</sup> aber auch in einem Gesellschaftsvertrag begründet werden, der in der Erwartung geschlossen wird, dass in Verfolgung des Gesellschaftszwecks Erfindungen entstehen.<sup>13</sup> Ob in einer Rechtsbeziehung ohne besondere Abrede eine Übertragungspflicht besteht, ist eine Frage des Einzelfalls. Ein Werk- oder Werklieferungsvertrag verpflichtet den Unternehmer grundsätzlich nicht zur Übertragung des Rechts an einer im Zusammenhang mit der vertraglichen Leistung entstandenen Erfindung.<sup>14</sup> Dass die Verfasser von Qualifikationsarbeiten an Hochschulen (Seminar-, Bachelor-, Master-, Diplomarbeiten, Dissertationen,

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PATENT

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REEL: 049669 FRAME: 0149

Habilitationsschriften) Erfindungen, die sie bei ihrer Arbeit machen, nicht an die Hochschule oder (gar!) ihre Betreuer übertragen müssen, ist evident, weil ein Betreuungsverhältnis für eine solche Übertragung keinen zureichenden Rechtsgrund bildet.<sup>15</sup>

Eine Übertragungsverpflichtung ändert als solche noch nichts daran, dass das Recht auf das Patent beim Erfinder liegt. Es wechselt seinen Inhaber erst, wenn die Verpflichtung durch das Verfügungsgeschäft der **Übertragung** erfüllt wird. Soll der Gläubiger des Übertragungsanspruchs stärker gesichert werden, kann eine Vorausübertragung erfolgen.<sup>16</sup> Sie ist wirksam, wenn die Erfindung(en), auf die sie sich bezieht, eindeutig bestimmbar ist (sind): Im Zeitpunkt der Fertigstellung einer Erfindung muss zweifelsfrei gesagt werden können, ob sie von der Vorausübertragung erfasst wird. Trifft dies zu, geht das Recht auf das Patent sogleich nach seiner Entstehung auf den Erwerber über; doch ändert die Vorausübertragung nichts daran, dass es zunächst in der Person des Erfinders entsteht.

7. Da das Recht an der Erfindung unabhängig davon entsteht, ob diese die materiellen Patenterteilungsvoraussetzungen erfüllt, **bestehen Erfinderrechte an einer Erfindung grundsätzlich auch, wenn diese nicht schutzfähig ist,**<sup>17</sup> – unabhängig davon, ob dies im amtlichen Prüfungsverfahren festgestellt wird, ob das Patent durch Verzicht wegfällt oder ob es erfolgreich nichtig geklagt wird. Das muss so sein, denn Grundlage des Erfinderrechts ist allein die schöpferische Tat des Erfinders, nicht die Anmeldung oder Erteilung eines Schutzrechts.<sup>18</sup>

Weil die reinen Erfinderrechte – Befugnis zur Schutzrechtsanmeldung der Erfindung, Befugnis zur Inhaberschaft am erteilten Schutzrecht und Recht auf Erfindernennung – sich von den Rechten unterscheiden, die die Schutzrechtserteilung vermittelt, und weil die Schutzrechtserteilung sogar dann eine nutzbare (faktische) Vorzugsstellung vermittelt, wenn das Schutzrecht später mit Wirkung *ex tunc* wegfällt, können die Vorteile von Benutzungshandlungen, die ohne Rechtsgrund am Erfinderrecht oder an dieser faktischen Vorzugsstellung vorgenommen werden, nicht dem Nutzer verbleiben, sondern **kann der Erfinder sie nach den Regeln über die Eingriffskondition herausverlangen.**<sup>19</sup>

<sup>7</sup> Zur Problematik der „Computererfindung“ vgl. *Volmer*, Mitt. 1971, 256–264; *Zipse*, Mitt. 1972, 41–44; *Benkard/Melullis*, § 6 PatG Rn. 3a f.

<sup>8</sup> Vgl. *Hellebrand*, 155 f.

<sup>9</sup> Vgl. BGH 10.11.1970 Wildbißverhinderung GRUR 1971, 210, 213f.

<sup>10</sup> So aber *Benkard/Melullis*, § 6 PatG Rn. 7; *Schulte/Moufang*, § 6 Rn. 11; *Busse/Keukenschrijver*, § 6 PatG Rn. 17.

<sup>11</sup> Das gilt auch für das EPÜ, vgl. *Heath*, Art. 60 Rn. 6 ff.

<sup>12</sup> Vgl. *Ullrich*, 99 ff., 302 ff.; *ders.*, ZHR 146 (1982) 410, 433 ff.

<sup>13</sup> Vgl. BGH 16.11.1954, GRUR 1955, 286, 289; ferner BGH 22.10.1964 Schellenreibungskupplung GRUR 1965, 302, 304f.; OLG Düsseldorf 10.6.1999 GRUR 2000, 49; zu Erfindungen von Organpersonen s. unten § 21 Rn. 34.

- <sup>14</sup> BGH 24.6.1952 GRUR 1953, 29, 30r.
- <sup>15</sup> Vgl. *Fahse*, in: Arbeitsgruppe Fortbildung im Sprecherkreis der Hochschulkanzler (Hrsg.), 163, 179 ff.
- <sup>16</sup> BGH 16.11.1954 GRUR 1955, 286.
- <sup>17</sup> BGH 17.5.2011 Atemgasdrucksteuerung GRUR 2011, 903, 904 (Rn. 13); 18.5.2010 Steuervorrichtung GRUR 2010, 817, 820 (Rn. 30) mit Bezug auf 15.5.2001 Schleppfahrzeug GRUR 2001, 823, 825.
- <sup>18</sup> *Pinzger*, ZZP 60 (1936/37), 415, 416.
- <sup>19</sup> BGH 18.5.2010 Steuervorrichtung GRUR 2010, 817, 820 f. (Rn. 30 f.).

Exhibit 19

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**PATENT**  
**REEL: 049669 FRAME: 0151**

Section 19. First-to-invent principle    Ann    Kraßer/Ann,    Translation of  
and inventor's right    Patent law    marginal nos. 7, 10

## II. Establishment of inventor's right. Legal succession

1. The inventor's right is established by the actual process of creating the invention. 7

This always is the **achievement of one or several human being(s)**. Even when electronic data processing equipment is used, new technical solutions are only achieved if humans use the equipment in a targeted manner with respect to such a solution or at least recognize that one of the outputs may be used to solve a technical problem.<sup>7</sup> It is possible that such activities often do not exceed what the person skilled in the art is familiar with; in such cases, patent protection for the solution developed by means of the computer is out of the question anyway due to a lack of inventive step. The possibility of using data processing equipment seems to turn some solutions that could have been considered inventive under former circumstances into obvious ones. Therefore, human mental activity is required to a considerable extent when non-obvious solutions are to be found by means of a computer. Whenever an invention worthy of protection is achieved in this way, the computer always only is a tool of the inventor, not the "inventor" as such.

4. Creating an invention is an **act causing legal consequences independent of the intent of the person acting**, not a legal transaction. It does not require legal capacity. Even persons without legal capacity or with a limited legal capacity acquire an inventor's right when creating an invention. The involvement of a legal representative is not required in any way. Since the inventive activity is not a legal transaction, no representation takes place. An attribution of actual conduct by third parties, which takes place in Sections 31 and 855 German Civil Code (BGB) and in the processing provisions in the context of Section 950 German Civil Code, does not exist either in this case. This means that new inventors' rights can only arise in the form of rights of **natural persons**, more specifically of those who actually created the invention, not of others on behalf of whom they took action in whichever capacity.<sup>11</sup> In particular, the notion of "service inventions" which cannot

<sup>7</sup> Regarding the problematic nature of "computer inventions", see Voimer, notice 1971, 256-264; Zipse, notice 1972, 41-44; Benkhard/Melullis, Sec. 6 PatG marginal no. 3a f.

be attributed to any human being as an individual performance which means that it is the owner of the company (so possibly even a legal person) that has the right to them from the outset, is irreconcilable with the first-to-invent principle.

<sup>11</sup>This also applies to EPC, cf. Heath, Art. 60 marginal nos. 6 et seqq.

As an English translator duly appointed and sworn by the Regional Court of Munich I, I certify that, to the best of my knowledge and belief, the above translation is a true and correct translation of the German document presented to me.

Munich, February 25, 2019



# IP Assignment Clauses in International Employment Contracts

Daniel Hoppe-Jänisch<sup>1</sup>

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The world is growing together and keeps getting more complicated every day. Multinational corporations have worldwide operations in a variety of business segments. They employ a large number of employees in a growing number of countries. There are companies that have offices in almost every country of the world nowadays.

Managing large numbers of employees in an international context can be a real challenge, particularly when a consistent and uniform handling of employees and their employment contracts is required across the corporation globally. Subtleties of local law also have to be taken into consideration, from statutory requirements regarding working time and vacation to regulatory requirements regarding remuneration, just to name but a few.

One important aspect of employment contracts is the assignment of IP rights to the employer. It goes without saying that the employer must be entitled to use the employees' work product. However, how this can be effected in various jurisdictions is not obvious in many cases. In this article, we touch on only some of the important points in a . Specific IP assignment agreements will need to be assessed on a case-by-case basis.

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<sup>1</sup> The author would like to thank Ms. Alice Pasch, White & Case Hamburg, Ms. Clara Hainsdorf, White & Case Paris, and Ms. Sarah Taylor and Mr. John Benjamin, White & Case London, for their generous contributions and their review of the article. Also, the author would like to thank Mr. Don Dowling, KL Gates New York, who came up with the idea for this article.

## 1. Introduction

The complexity of IP assignment clauses becomes clearer if one takes into account that IP rights are mainly territorial rights; legal relationships to these IP rights are therefore mainly shaped by national laws.

For these reasons, it will not be possible to use a US standard IP assignment clause for employees in Europe. A number of topics have to be addressed regarding such IP assignment clauses. The following remarks are designed to point out the considerations which employers will need to bear in mind when implementing IP assignment clauses in Germany, UK and France.

- The first question which comes to mind is the question of who initially owns the rights in intellectual creations made by employees during the course of their employment and how these rights, if necessary, are assigned to the employer. This includes the question which limitations to such assignments exist and how such limitations could possibly be circumvented.
- The second question which is always related to IP assignment clauses is the question of remuneration. This covers in particular whether an additional payment has to be made to employees by way of consideration for the attribution or assignment of IP rights.
- The third main question is whether and to what extent the parties to the employment contract are subject to other obligations such as obligations to apply for a registration of IP rights or obligations to support the other party in PTO proceedings.

Even though all these questions are pressing, it is difficult to find comprehensive guidelines which address such matters. This stems, inter alia, from the fact that some IP-related statutory provisions have been drafted rather vaguely and are often therefore difficult to interpret. There is partly also a lack of clarifying and/or consistent case law. Further employment law also needs to be considered when

dealing with IP assignments in employment contracts, in particular since very broad IP clauses can be problematic from an employment law perspective. One also needs to keep in mind that a contractual agreement will be declared invalid if it contravenes the general principle of good faith.

## **2. Who owns IP rights and how can such rights be assigned to the employer?**

In the context of an international employment contract, a distinction should be made between patents or rights to inventions and copyrights on the one hand and other intellectual property rights on the other hand. This is due to the specific treatment which inventions and copyright protected works are given in various jurisdictions. The special treatment of copyrights, for instance, is based on the strong manifestation of moral rights in European copyright law. With other IP rights, there are mostly no legal provisions that prohibit an assignment or make a payment of additional compensation mandatory.

### **2.1 Inventions**

The term “invention” includes technical inventions within the meaning of Art. 1(2) of the Paris Convention for the Protection of Industrial Property. It also includes developments which are eligible for protection by patent or utility models.

The legal relationship between employer and employee with regards to inventions is strongly influenced by national laws.

#### *(a) Germany*

The basic rule under German law is very similar to US law: An inventor initially owns the invention and the associated rights to it by virtue of the act of creation i.e. as a matter of an inventor's natural right. This basic rule also applies in connection with employee-made inventions; the employee is the first owner of all rights connected to the invention.



It is important to note that German law does not share US patent law's concept of *shop rights* or *hired-to-invent*. However, there are provisions under German law that are not so different from these doctrines.

The transfer of the rights in employee-made inventions to the employer is most peculiar in Germany. An advance assignment is not possible. Freedom of contract is generally very limited when it comes to inventions made by employees during their employment. The reason for this is that the German Act on Employee Inventions (*Arbeitnehmererfindungsgesetz – ArbEG*) lays down detailed and mostly mandatory provisions that leave little room for individual agreements.

- 1) German employee invention law distinguishes between employment-related inventions and free inventions.

All inventions which either result from the employee performing his or her duties or are significantly dependent on the company's experience or works are considered employment-related inventions. Rights to employment-related inventions originally belong to the employee. However, employers are entitled to claim the transfer of these rights to them.

- 2) German law requires the employee to notify the employer of the created invention in writing. The employer then has the right to claim the invention within a period of four months. Due to some recent changes in the law, the transfer of the invention to the employer takes place automatically unless the employer expressly rejects the invention within this time limit in writing.

For employers, this may seem convenient because the employer then does not have to ensure a timely transfer of the invention. However, it should be pointed out that a number of obligations are created as soon as the employee notifies the employer about an

invention, for example, the employer's obligation to apply for a patent or utility model.

- 3) Inventions which are not employment-related inventions are free. This means that the employee may freely decide whether he or she assigns the rights to the employer or not. Nonetheless, the employee has to communicate such inventions to the employer unless the invention obviously cannot be used in the employer's business. The rationale behind this obligation is to enable the employer to assess whether the invention is an employment-related invention or a free invention.

The employee's freedom to dispose of free inventions is subject to an important restriction: Before the employee exploits the invention elsewhere, he or she is obliged to offer the employer a non-exclusive right of use on reasonable terms, provided the invention can be used in the employer's business.

- 4) In the context of international IP assignment agreements it is important to note that it is not possible to contractually deviate from the statutory rules to the disadvantage of the employee before a particular invention has been disclosed to the employer. This means that an employment contract cannot contain stipulations which – compared to the statutory provisions of German employee invention law – disadvantage the employee. Therefore, an IP clause will be void if it is designed to have the employee assign all rights in future inventions to their employer, regardless of whether the clause is supposed to apply to free inventions or to employment-related inventions.
- 5) The German Act on Employee Inventions prohibits all contractual agreements which deviate from the Act in favor of the employer if these agreements are related to future employee inventions. Rights in employee inventions can especially not be pre-assigned in the employment contract. This restriction on contractual freedom cannot be avoided by use of a non-German governing law clause

because German courts consider the German employee invention law as mandatory. According to Art. 8 (1) Rome-I Regulation a law clause must not result in that mandatory provisions of the national law are derogated.

*(b) United Kingdom*

The situation differs significantly from the above in the UK.

The UK Patents Act comprises specific regulations for employee inventions.

- 1) In contrast to German and US law, under UK law the rights in employment-related inventions belong to the employer from the outset. This means that the employer does not need to claim an employment-related invention in order to acquire the associated rights. Thus, an advance assignment clause is not necessary.
- 2) With respect to non-employment-related inventions, UK law resembles German law in that such inventions belong to the employee and the associated rights cannot be assigned to the employer prior to the invention's creation. This means that an assignment clause in the employment contract would be unenforceable as far as it concerns non-employment-related inventions in terms of the UK Patents Act.
- 3) The UK Patents Act does not require the employee to offer the employer a non-employment-related invention. This means that the employer may typically, not force the employee to assign or license the associated rights. However, such an obligation might arise from general employment law considerations, in particular from the employee's duties of loyalty and confidentiality to the employer.

*(c) France*

In France, the statutory provisions contained in Article L.611-7 of the French Intellectual Property Code concerning employee inventions distinguish three types of employee inventions, namely inventions

under mission, employment-related inventions beyond mission and free inventions.

- 1) Inventions under mission can be characterized by the act that an employee creates them (i) pursuant to an employment contract which stipulates an inventive mission as the employee's usual work task; or (ii) while performing research tasks according to the employer's directions. The rights in inventions under mission automatically vest in the employer so that there is no need for an assignment clause, either in advance of the invention's creation or subsequent to it.
- 2) Employment-related inventions beyond mission are inventions which the employee does not create within the scope of his or her inventive mission but still relate to the employer's business or the employee's function within the employer's business, e.g. because they were made by using specific in-house technologies or processes.

The rights in employee inventions beyond mission belong to the employee; however, the employer enjoys the right to have them assigned in whole or in part. There is a deadline of four months from the day of notification to claim the invention.

- 3) All other inventions are free which means that the rights in these inventions remain with the employee. The employer cannot demand their transfer.
- 4) According to French law, the statutory provisions in relation to employee inventions apply unless the parties agree upon something more favorable to the employee. Therefore, a clause by which the employee assigns to the employer all rights in future employment-related inventions beyond mission or free inventions will not be enforceable. The same applies to clauses by which employees commit themselves to assign the rights as soon as they have created an invention.

(d) *Preliminary result*

It shows that the assignment of rights to employee-made inventions is particularly difficult in Germany and in France. Even though these jurisdictions provide for sufficient employer's rights to claim all the inventions needed for their business, an advance assignment is not possible. Where an advance assignment is possible, namely with regards to inventions under mission in France and employment-related inventions in the UK, it is not necessary, because employers automatically obtain the rights in these inventions by law.

## 2.2 Works protected by copyright

The situation differs significantly when it comes to copyright protected works. With respect to inventions, employer and employee are mainly bound by mandatory statutory provisions that leave little to no room for divergent contractual agreements. By contrast in many European jurisdictions it may be possible to establish individual provisions relating to copyrights in the employment contract. Nonetheless, the parties to the employment contract need to be aware of certain statutory rules when drafting copyright-related agreements.

Broadly speaking, copyright is an intellectual property right which subsists in artistic, musical, literary and suchlike creations, provided these creations meet certain criteria.

First of all, it should be pointed out that the Anglo-American copyright system and the European copyright system differ substantially from each other.

The Anglo-American copyright is an economic exploitation right; it grants its holder – as the term suggests – the *right to copy*, to exploit the creation. Copyright holder and work's author do not necessarily have to be identical; even though it is usually the author who first owns the copyright in the work, it can be (pre-)assigned to other individuals or legal entities.

European copyright systems provide for a stronger connection between the copyright and the author of the protected work. This makes sense if one considers that even though the German *Urheberrecht* or the French *droit d'auteur* are often translated as *copyright*, the literal translation is *author's right*. It comprises not only proprietary rights but also moral rights. In many European jurisdictions, only the proprietary rights are assignable; in others, copyrights, including the proprietary rights, cannot be assigned at all but authors may only grant others a license to exploit the protected work. Moral rights are usually not assignable and can be waived only to a limited extent.

Companies need to bear this in mind when they draft IP clauses. A clause whereby the employee *assigns* the copyright in future works might not be enforceable in jurisdictions where the assignment of copyright is not possible. Moreover, especially in continental Europe, employment contracts should include waivers of moral rights or, where moral rights cannot be waived, determine restrictions on their exercise as far as the respective law permits this.

(a) *Germany*

When employees create a copyright protected work, by nature of their creation, they become the owner of the copyright. The employee cannot transfer the copyright to the employer, because copyright is non-assignable under German law.

Moreover, German copyright law does not know the concept of *work made for hire*, under which the employer is deemed the author of a work that an employee created within the scope of the employment and therefore owns the copyright from the outset.

However, the employee can grant the employer various exploitation rights, e.g. the right to reproduce the work or the right to distribute it. Exploitation rights can be granted exclusively or non-exclusively. An

exclusive exploitation right also excludes the author from using the work.

Other than in case of employee inventions, copyright exploitation rights can be granted with regard to future creations. In fact, German courts even assume an implicit grant of certain essential exploitation rights by virtue of the employment contract; naturally, this applies only to such works which employees create within the scope of their employment contract.

Nonetheless, employers should seek to obtain an express grant of exploitation rights in their employment contracts. Such an IP clause should not be worded vaguely. Rather the clause should exactly specify to what extent exploitation rights are granted. Ideally, it should name each type of exploitation that is supposed to be covered. Otherwise, only those exploitation rights will be covered which employers need in order to operate their usual business. Especially the right to license or transfer the granted exploitation rights to third parties is not always considered essential in order to conduct the ordinary business activities. Thus, it should be expressly granted in the employment contract. Furthermore, it is important to know that the grant of rights in respect of as yet unknown types of exploitation must be in writing and signed.

A special provision exists for employee-made computer programs: If an employee creates software in the execution of his or her duties or according to the employer's instructions only the employer is entitled to exercise the related proprietary rights. Thus, the employer is granted comprehensive rights with respect to all forms of exploitation by law. There is no need for a contractual agreement.

It should be noted that no insightful case law has been established with regards to the question of whether and under which circumstances an employee can validly commit themselves to offer future non-work related creations to his or her employer. An IP clause

which includes such works is exposed to the risk that a court will hold it invalid or unenforceable.

Besides exploitation rights the German copyright includes moral rights. These are the right to determine if, when and how the work shall be published, the right to be recognized as the work's author and to be or not to be mentioned in publications and the right to prohibit a distortion of the work.

Moral rights cannot be waived as such; however, to a certain degree, employees may contractually commit themselves to not exercise them, at least as far as the exercise would hinder the authorized commercial exploitation of the work. Employers could, for instance, not exercise their right to distribute the protected work if employees objected to this by invoking their moral right to determine whether, when and how the work is to be published.

(b) *United Kingdom*

The basic rule concerning initial ownership of copyright is the same as in the US: Authors initially own the copyright in their work. In certain scenarios UK copyright law attributes *authorship* – which entails copyright ownership – to certain individuals or legal entities, e.g. the producer is deemed the author of a sound recording.

For employee-made copyright works UK law stipulates an exception to this general rule: Where an employee creates a literary, dramatic, musical or artistic work, or a film in the course of the employment, the employer is the first owner of the copyright in the work. Therefore, an advance assignment in the employment contract is not necessary. Computer programs count as literary works.

This exception provision may not be confused with the *work made for hire* concept; while under the work made for hire doctrine the employer is considered the *author* of a work, UK copyright law only refers the *copyright* in the work to the employer; the employee is nonetheless deemed the author.



Besides economic exploitation rights, UK copyright law grants the author of a copyright protected work certain moral rights, e.g. the right to be identified as the author in publications of the work. Moral rights are non-assignable. However, employees can waive them in advance by an express statement in the employment contract. Such a waiver must be in writing and signed.

Unlike with inventions, there is no statutory rule that prohibits the advance assignment of copyrights in works that employees create outside the scope of their employment. However, courts might consider such an assignment unfair on the employee and therefore declare a corresponding assignment clause void or unenforceable.

(c) *France*

With respect to the possible transfer of copyrights, French copyright law provides for very strict provisions compared to other European jurisdictions. Besides, it contains a lot of special regulations concerning certain types of copyright protected works.

It parallels German copyright law in that the author of a work is usually the original owner of the connected copyright. There are some exceptions to this general rule, e.g. with respect to collective works and employee-made computer programs. However, there is no exception for other employee-made works such as a *work made for hire* rule. Further, moral rights are not assignable but can only be waived to a limited extent.

However, unlike in German law, the proprietary rights to copyright protected works can actually be assigned to others.

In the context of employment contracts it must be noted that the French Intellectual Property Code declares a *global* assignment of future works void. What is meant by *global* assignment is not so obvious. It definitely encompasses clauses that are designed to assign to the employer *all* propriety rights to *all* future copyright protected works that the employee will create in the course of the employment.

Consequently, such broadly worded clauses in employment contracts will be void. However, there have been cases where courts, for instance, have upheld assignment clauses when it was possible to individualize the assigned future works. It can be seen from this that the determination of whether a particular assignment clause falls within the scope of the provision highly depends on the deciding court's interpretation of the provision. Given this uncertainty, assignment clauses that relate to future works are always at risk of being void. It is more secure to have the employee assign the proprietary rights on a case-by-case basis or at least upon creation of the work.

French law requires assignment contracts to separately list each of the proprietary rights that is supposed to be covered. Further, it must precisely define the scope and purpose of the authorized exploitation as for its duration and place. Only what is expressly agreed upon will be transferred. General clauses that globally include *all* rights run the risk of being invalid.

*(d) Preliminary result*

With respect to copyright protected works the three jurisdictions provide for quite different regulations. In the UK there is actually no need for an assignment of copyrights to employment-related works, whereas in France, employers cannot permissibly exploit a work unless the employee contractually assigns the proprietary rights to them, which is usually only possible once a work has been created. As regards Germany, one needs to keep in mind that employees cannot *assign* the copyright to works they create, but only grant their employers exploitation rights. However, unlike in French law, exploitation rights can be granted globally with respect to future employment-related works.

In all three jurisdictions authors enjoy certain moral rights, which can be contractually limited to a greater or lesser extent.

### 3. Remuneration

Another crucial question is whether the employer has to make extra payments for the transfer of rights to employee-made intellectual creations.

#### 3.1 Inventions

##### *(a) Germany*

According to German employee invention law, the employer has to remunerate the employee – beyond the monthly salary – in return for the rights to employee-made inventions.

When the employer has obtained the rights to an invention the parties shall individually agree upon a reasonable compensation on the basis of the invention's economic value. Each party may demand an adjustment if, at a later time, circumstances change which were decisive for determining the amount of compensation.

Employees cannot validly waive their right to additional remuneration in the employment contract, because the statutory provisions cannot be modified to the employee's disadvantage before a particular invention has been communicated to the employer. Moreover, an IP clause that stipulates a certain lump sum as remuneration for the transfer of rights over future inventions is void.

Only after the employee has informed the employer of a particular invention the parties may deviate from the statutory rules. However, such individual agreements are void if they are grossly unfair. In what circumstances a contractual provision is considered grossly unfair cannot be answered universally. Neither does the Act on Employee Inventions specify the term, nor is there illuminating case law concerning this matter. A remuneration agreement is or becomes grossly unfair and thus void if the remuneration according to the agreement is considerably lower than the remuneration the employee could claim according to the statutory provisions. As a general rule it can be said that this should be considered if the agreed remuneration is

below 50% of the remuneration owed under the Act on Employee Inventions. The real problems lie in this determination, where a lot of difficult to evaluate factors have to be taken into account. Despite that, a complete waiver of the right to additional compensation is not grossly unfair per se, provided the employee is entirely aware of the waiver's consequences. However, since courts do not assume a will to waive rights easily, complete waivers are rather exposed to the risk of being considered as grossly unfair.

Many German companies have introduced so-called *incentive systems* with which they offer the employee inventor a payment of a certain lump sum instead of ongoing (e.g. annual) payments for a particular invention. The offer is usually made when the employee reports the invention. The amount usually depends on the invention's estimated economic value. While some incentive systems leave it at that, others combine the payment of a lump sum with a waiver of several employee rights, e.g. the above-mentioned right to an adjusted amount of compensation. Even though employees are free to decide to be compensated pursuant to the statutory provisions of the Act on Employee Inventions instead, according to a recent survey, the majority chooses to be remunerated according to their employer's incentive system.

(b) *United Kingdom*

Under UK patent law the employee inventor is entitled to additional compensation in exceptional circumstances only.

With regards to inventions which belong to the employer from the outset, a court may – at its discretion – award the employee compensation if a patent has been granted for the invention at issue and the invention is of “outstanding benefit” to the employer. The law does not define the meaning of “outstanding benefit”; the courts demand a greater benefit than one would normally expect to arise from an employee's work, a benefit which is “more than significant”, “out of the ordinary” or “something special”.

With respect to free inventions, courts may award compensation if the employee has assigned the rights in the invention or granted an exclusive license to the employer, a patent has been obtained and the consideration the employee received for the assignment or grant is inadequate in relation to the employer's benefit from the invention.

UK courts are rather reluctant to award compensation. This is due to the difficulty of meeting the requirements for a successful remuneration claim, especially the "outstanding benefit", on the one hand, and proving them on the other hand. To date, only one successful compensation application has been made. Nonetheless, the employee's right to legally seek compensation cannot be excluded by means of the employment contract. Accordingly, a clause with such content would not be enforceable.

*(c) France*

The current legal situation in France is quite similar to the one in Germany. As a rule, the employer has to remunerate employees in return for the rights to their inventions. The employer cannot be released from this obligation by way of the employment contract, because only agreements that favor the employee more than the statutory provisions are permissible.

The law expressly and unequivocally states the employee's entitlement to a "additional compensation" with respect to employee inventions under mission and to a "fair price" with respect to employment-related inventions beyond mission. With respect to "additional compensation", the French Intellectual Property Code provides that the conditions under which an employee is entitled to additional remuneration shall be determined by provisions in collective bargaining agreements, company agreements and individual employment contracts. In fact, some collective bargaining agreements in France grant employees additional remuneration only if certain requirements are met, e.g. if a patent has been filed or granted, the employer actually exploits the invention and/or the invention is of

exceptional interest to the company. However, some courts have declared such provisions inapplicable. According to these courts, the French Intellectual Property Code provides that additional remuneration is mandatory in all circumstances; the law merely permitted collective bargaining agreements, company agreements and individual employment contracts to lay down rules for calculating the amount of the compensation. Therefore, companies need to be aware of the fact that a court might declare a clause invalid if it hinges the employee's entitlement to additional compensation on certain requirements. Contractual provisions that specify methods of calculating the compensation are, however, permissible unless they contradict mandatory terms of collective bargaining agreements.

### **3.2 Works protected by copyright**

#### *(a) Germany*

With respect to works that were created within the scope of the employment contract, employees are in general not legally entitled to additional remuneration. Consequently, an IP clause of such contents will usually not evoke legal problems. Only if exploiting the work brings the employer a profit in relation to which the monthly salary is an inadequate reward, the employee may claim to be paid additional compensation. An IP clause whereby the employee waives this right will be void.

#### *(b) United Kingdom*

As German law, UK law does not provide employees with a right to additional compensation in return for the attribution of the copyright in work-related creations to the employer.

(c) *France*

French copyright law stipulates that the author who assigns proprietary rights has to be remunerated proportional to the assignee's proceeds of exploiting the work. The law enumerates several cases in which the remuneration can have the form of a lump sum instead of profit-based royalties. However, there is no general exception for employee-made copyright protected works. Consequently, employees are entitled to a proportional share of the proceeds or, in case of one of the enumerated exceptions, a lump sum for the assignment of proprietary rights. Usually, an agreement according to which the employer does not have to remunerate the employee for the assignment of proprietary rights will be void. In addition, courts tend to consider that additional remuneration for copyright, like additional remuneration for inventions, should not be included in the employee salary.

(d) *Preliminary result*

Except for the UK, the employer must usually pay the employee an additional compensation for the attribution or assignment of rights to inventions. Normally, employees cannot waive their right to additional remuneration at all; they can definitely not waive it in advance.

For the attribution of copyrights (UK), the transfer of proprietary rights (France) or granting exploitation rights (Germany), however, only French law requires an additional payment.

## **4. Other rights and obligations**

Besides the questions of right's ownership and additional compensation, there are a couple of other issues that should be addressed in the context of IP rights in employment relationships.

### **4.1 Reporting of intellectual creations**

Without the information that an intellectual creation has been made the employer cannot know about his or her rights to it. Such a situation can only be avoided if employees have the duty to inform their employer of intellectual creations they have made in the course of their employment.

German and French employee invention laws stipulate the employee's obligation to immediately report a created invention to the employer. This applies to employment-related as well as free inventions, because the employer needs to be able to classify the invention in question. The relevant laws also contain provisions as to the content of the report (circumstances under which the invention was made, description of the invention etc.) and the formalities that have to be complied with. It should come as no surprise that in Germany, the employment contract cannot validly stipulate stricter requirements than the Act on Employee Inventions sets out because agreements that disadvantage the employee are only permissible after a particular invention has been reported to the employer.

In the UK, there is no statute that particularly mentions the employee's obligation to report inventions to the employer. However, such an obligation is naturally implied by the statutory provisions that vest the rights to employment-related inventions in the employer, or by the employment relationship itself. Apart from this, the employment contract may expressly stipulate the employee's duty to report inventions to the employer.

With other intellectual creations there are usually no statutory provisions that stipulate an obligation to report. Such an obligation



may be laid down by a clause in the employment contract. Otherwise, it will in most cases be implied by virtue of the employment relationship.

#### 4.2 Registration of IP rights

As opposed to copyrights, intellectual property rights that serve to protect an invention, most importantly patents need to be registered with the competent authorities in order to come into existence. The right to apply for and be granted a patent is in fact the most valuable right connected to an invention.

As a general rule in European jurisdictions, the person or legal entity that holds the rights to an invention is also the one that is entitled to apply for and be granted a registered IP right for the invention at question. In an employment context this means that only the employer has the right to do so when he or she has acquired the rights to an employee-made invention.

In this context, German employee invention law contains some peculiarities.

As soon as the employee has reported an employment-related invention to the employer, only the employer is entitled to apply for a registration of IP rights in Germany, especially patents and utility models. Thus an employer has the sole right to apply for a registered IP right even before he or she claims the invention and thereby acquire the connected rights. It needs to be noted that this only applies to German IP rights; the right to apply for registered IP protection in other states is only transferred to the employer when he or she claims an invention.

The sole *right* to apply for a registered IP right in Germany is accompanied by the *obligation* to apply for a domestic patent or utility model. The employer must file the application without undue hesitation. Again, it needs to be pointed out that this obligation arises as soon as the invention is reported to the employer. Depending on the

particular circumstances, an employer might be obliged to apply for a German patent or utility model even before he or she has decided whether or not to claim the invention.

The obligation to apply for a German patent or utility model lapses in three scenarios. Firstly, if the employment-related invention has become free due to the employers rejection of it. In this case all rights connected with the invention belong ultimately to the employee.

Secondly, if legitimate interests of the company necessitate the invention to be treated as a trade secret and the employer acknowledges to the employee that the invention is capable of IP protection.

Thirdly and most importantly in our context, the obligation to apply for a German patent or utility model ceases if the employee has agreed that no application is to be filed. However, employers cannot be released from the obligation prior to the invention's disclosure to them. Therefore, a corresponding clause in the employment contract will be void. In practice it is common that employees release their employer from the obligation when they decide to be treated according to their employer's incentive system instead of according to the statutory provisions of German employee invention law.

Only when the employer claims the invention, he or she also become entitled – but not obliged – to apply for a registration of IP rights abroad. However, the employee can permit the employer to do so before claiming the invention. As with most individual agreements concerning employee inventions, this is not possible in the employment contract, but only after the invention has been reported to the employer.

In the context of the registration of IP rights abroad the employer is subject to a peculiar obligation: With respect to the countries for which the employer does not desire to obtain registered IP rights, he or she has to release the claimed invention to the employee so that the

employee can apply for IP protection in these countries. At the employee's request, the employer has to support the employee in the process of acquiring IP rights abroad. However, the employer can also be released from this obligation, but only after the invention has been reported. Many German companies also include the waiver of this obligation in their incentive system.

There are no suchlike obligations laid down in UK and in French employee invention law. This implies that employers may normally freely decide whether or not to apply for a patent. In particular cases, however, French and UK courts might find the employer nevertheless to be obliged to apply for a patent or at least exploit the invention in another way. This is conceivable in cases where the employee's entitlement to additional remuneration or the amount of the additional remuneration depends on a patent or an actual exploitation of the invention.

In Germany, the UK and France there are no legal provisions that speak against clauses in the employment contract obliging the employee to assist the employer in acquiring intellectual property rights for creations that are attributed to the employer. The German Act on Employee Inventions even stipulates that the employee, if requested to do so, has to assist the employer in the application proceedings and has to make the statements that are necessary in order to acquire registered IP rights.

### **4.3 Confidentiality**

Where the employer enjoys the rights to an employee-made intellectual creation, it actually goes without saying that the employee must not disclose the creation to third parties or the public. This applies to both parties as long as the final attribution of the rights is still in abeyance.

The German Act on Employee Inventions as well as the Act on Unfair Competition and the French Decree on Employees' Inventions

expressly state such an obligation to confidentiality as regards inventions.

Where there is no explicit statutory provision, the obligation to confidentiality results from the employment relationship itself. There is no need to expressly include it in the employment contract. However, a suchlike clause will not cause validity issues.

German competition law, for example, even penalizes the violation of the employee's obligation to confidentiality.

## **5. Conclusion and practical advice**

European IP law, especially employee invention law, permits individual agreements in employment contracts only to a limited extent. Usually, it is not possible, in individual agreements, to deviate from statutory provisions that are designed to protect employees. This applies in particular to remuneration regulations with the consequence that a waiver of statutory remuneration claims is rarely possible. Many issues, particularly in respect of invention's and copyright's ownership, are, however, sufficiently regulated by statute.

As was shown, the various IP rights are treated quite differently from each another. For IP clauses in employment contracts it follows from this that, first of all, employers should draw a clear distinction between different types of IP rights in their employment contracts.

Further, it is advisable to use "staggered" IP clauses in order to absorb the peculiarities of various jurisdictions. Such clauses will in particular be useful to deal with jurisdictions where certain types of assignments or restrictions of remuneration clauses are invalid or unenforceable.

BeckRS 2018, 37254

**BGH (X. Zivilsenat), Urteil vom 04.09.2018 - X ZR 14/17****Titel:**

Verfahren wegen Patentnichtigkeitssache

**Normenketten:**

EGBGB a.F. Art. 30, Art. 33

EPÜ Art. 54 Abs. 2, Art. 89

**Entscheidungsname:**

Drahtloses Kommunikationsnetz

**Amtliche Leitsätze:**

1. Die Wirksamkeit der Überleitung der Rechte an einer Erfindung durch Inanspruchnahme als Dienstleistung durch den Arbeitgeber richtet sich nach dem Arbeitsstatut.
2. Welche Rechte und Pflichten der Vertragsparteien sich aus einer rechtsgeschäftlichen Vereinbarung über die Übertragung eines Prioritätsrechts ergeben, ist nicht nach dem für die Erstanmeldung maßgeblichen Recht zu beurteilen, sondern nach dem Vertragsstatut. Wird die Vereinbarung zwischen dem Dienstleistungserfinder und seinem Arbeitgeber getroffen, entspricht das Vertragsstatut regelmäßig dem Arbeitsstatut.
3. Eine technische Lehre, die der Öffentlichkeit dadurch zugänglich gemacht wird, dass sie auf einen Webserver hochgeladen und über das Internet allgemein oder einem Teil der Fachöffentlichkeit weltweit verfügbar gemacht wird, bildet nicht bereits dann Stand der Technik, wenn zum Zeitpunkt des Hochladens in einer andern Zeitzone als derjenigen des Ortes des Hochladens der Prioritäts- oder Anmeldetag noch nicht angebrochen war.

**Rechtsgebiete:**

Patentrecht, Gebrauchsmusterrecht, Arbeitsrecht, EDV-, Multimedia-, Medien- und Postrecht, Europarecht, ausl. Recht, Völkerrecht

**Schlagworte:**

Erfindung, Patentanmeldung, Inanspruchnahme

**vorgehend:**

BPatG, Urteil vom 20.09.2016 - 5 Ni 28/14 (EP)

**Weiterführende Hinweise:**

Nachschlagewerk: ja; BGHZ: nein; BGHR: ja

**ECLI:**

ECLI:DE:BGH:2018:040918UXZR14.17.0

Exhibit 21

Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/910,681

<https://beck-online.beck.de/Print/CurrentMagazine?vpath=bibdata%5Cents%5CcheckPage1022059>

REEL: 049669 FRAME: 0177

- 67** (d) Denn das Recht auf die Inanspruchnahme der Priorität ist jedenfalls durch rechtsgeschäftliche Vereinbarung zwischen der Ericsson GmbH und dem Miterfinder Meyer übertragen worden.
- 68** (aa) Nach der Rechtsprechung des Bundesgerichtshofs richtet sich die Wirksamkeit einer Übertragung des Rechts auf Inanspruchnahme der Priorität einer Patentanmeldung gemäß Art. 33 Abs. 2 EGBGB nach dem Recht des Staates der Erstanmeldung (BGH, Urteil vom 16. April 2013 - X ZR 49/12, GRUR 2013, 712 Rn. 12 - Fahrzeugscheibe mwN). Von der nach Art. 33 Abs. 2 EGBGB zu beurteilenden Frage der Übertragbarkeit und insoweit gegebenenfalls geltender Form- und anderer Wirksamkeitserfordernisse ist jedoch die Frage zu unterscheiden, nach welchem Recht sich die Verpflichtungen zwischen altem und neuem Rechtsinhaber richten. Dies ist jedenfalls für die Vereinbarung über die Verpflichtung zur Übertragung des Rechts auf Inanspruchnahme der Priorität (Verpflichtungsgeschäft) nach Art. 33 Abs. 1 EGBGB das jeweilige Vertragsstatut. Das Vertragsstatut richtet sich aber wiederum regelmäßig nach dem Arbeitsstatut, wenn die Übertragung in Zusammenhang mit der Inanspruchnahme einer Dienstfindung durch den Arbeitgeber steht.
- 69** (bb) Aus den von der Beklagten vorgelegten Unterlagen ergibt sich unter Berücksichtigung der Interessenlage der Beteiligten, dass der Miterfinder Meyer mit seiner damaligen Arbeitgeberin, der Ericsson GmbH, vereinbart hat, dieser sein Recht als Mitanmelder der USamerikanischen Voranmeldung zur Inanspruchnahme der Priorität aus dieser Voranmeldung zu übertragen.
- 70** a) Herr Meyer hat der Ericsson GmbH mit an eine Sachbearbeiterin aus der Patentabteilung seiner Arbeitgeberin gerichteter E-Mail vom 8. Januar 2008 die Nummer der USamerikanischen Voranmeldung mitgeteilt. Diese Mitteilung war unter Berücksichtigung der Gesamtumstände für die Ericsson GmbH nicht nur als Wissensmitteilung zu verstehen, sondern auch als Erklärung ihres Arbeitnehmers, die Übertragung des Prioritätsrechts der Voranmeldung auf die Ericsson GmbH für den Fall anzubieten, dass diese - wie zu erwarten stand - die Erfindung als Dienstfindung nach §§ 5, 6 ArbErfG aF in Anspruch nehmen sollte.
- 71** Diese Auslegung der abgegebenen Erklärung rechtfertigt sich vor dem Hintergrund, dass es der Ericsson GmbH oder der TLME nach dem seinerzeit geltenden USamerikanischen Recht nicht möglich gewesen wäre, die Voranmeldung selbst einzureichen, da Patentanmeldungen nur von dem oder den Erfindern selbst eingereicht werden konnten, so dass sich auch das Recht auf die Inanspruchnahme der Priorität der Voranmeldung nicht originär zugunsten der Ericsson GmbH oder der TLME begründen ließ, sondern es einer Übertragung dieses Rechts von den Erfindern und Anmeldern der Voranmeldung bedurfte. Teilte der Dienstfinder danach seiner Arbeitgeberin am 8. Januar 2008 die Nummer der USamerikanischen Voranmeldung mit, war dies als Bekundung seiner Bereitschaft zu verstehen, bei Inanspruchnahme der Erfindung alles Nötige und rechtlich Geschuldete zu tun, um der Arbeitgeberin wirksame Nachanmeldungen der Erfindung zu ermöglichen. Da dies insbesondere die Übertragung des Prioritätsrechts umfasste, lag hierin das Angebot, insbesondere auch das aus der Voranmeldung hervorgegangene Prioritätsrecht zu übertragen. Dies entsprach auch dem Interesse des Miterfinders, da das Prioritätsrecht nach einer wirksamen Inanspruchnahme der Erfindung durch seine Arbeitgeberin aufgrund des damit bewirkten Übergangs des Rechts an der Erfindung nicht mehr von dem Dienstfinder selbst, sondern nur noch von seiner Arbeitgeberin (oder deren Konzernmutter) als nunmehriger Inhaberin der Rechte an der Erfindung für Nachanmeldungen in

Exhibit 21

Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/940,681

PATENT

REEL: 049669 FRAME: 0178

Anspruch genommen werden konnte. Im Gegenzug eröffnete sich der Dienstfinder mit der Übertragung des Prioritätsrechts auf seine Arbeitgeberin die Aussicht, dass von dieser eingereichte Nachanmeldungen einen für die Patentfähigkeit gegebenenfalls ausschlaggebenden besseren Zeitrang erhielten und ihm dies im Rahmen des Vergütungsanspruchs nach § 9 ArbErfG zu Gute kommen würde. Zugleich kam er damit seiner Verpflichtung nach § 15 Abs. 2 ArbErfG nach, die Ericsson GmbH als seine Arbeitgeberin auf Verlangen beim Erwerb von Schutzrechten zu unterstützen und die erforderlichen Erklärungen abzugeben, wozu nach zutreffender Ansicht bei Voranmeldungen durch den Arbeitnehmer auch die Zustimmung zur Übertragung von Prioritätsrechten gehört (Bartenbach/Volz, ArbErfG, 5. Aufl., § 15 Rn. 32; Rother in Reimer/Schade/Schippel, ArbErfG, 8. Aufl., § 15 Rn. 12).

- 72 β) Das Angebot zur Übertragung des Rechts auf die Inanspruchnahme der USamerikanischen Voranmeldung hat die Ericsson GmbH mit Inanspruchnahme der Erfindung als Dienstfindung mit Erklärung vom 28. Januar 2008 angenommen, deren Zugang der Miterfinder Meyer am 6. Februar 2008 bestätigt hat (Anl. DN3d). Zwar ist in der Erklärung der Ericsson GmbH ausdrücklich nur von einer unbeschränkten Inanspruchnahme der Erfindung „RLC polling for continuous transmission, P-number P25436 US1“ die Rede. Mit Erwähnung der USamerikanischen Voranmeldung 61/19746 kommt in der Erklärung jedoch darüber hinaus zum Ausdruck, dass die Ericsson GmbH mit der unbeschränkten Inanspruchnahme der Erfindung auch - ihrem wirtschaftlichen Interesse entsprechend - das Recht auf Inanspruchnahme der Priorität aus der Voranmeldung auf sich übergehen lassen und entsprechend das hierauf gerichtete Angebot ihres Arbeitnehmers annehmen wollte.
- 73 (cc) Ob auch, wozu der Senat neigt, für die mit dem kausalen Rechtsgeschäft zugleich bewirkte Verfügung über das Recht auf Inanspruchnahme der Priorität (Verfügungsgeschäft) nach Art. 33 Abs. 1 EGBGB an das Vertragsstatut, hier also deutsches Recht, anzuknüpfen ist oder an das Statut, dem das zu übertragende Recht unterliegt, im Streitfall also USamerikanisches Recht, da die Übertragung des Rechts auf Inanspruchnahme der Priorität einer USamerikanischen Voranmeldung in Rede steht, kann offen bleiben.
- 74 α) Die Frage stellt sich, weil Art. 33 EGBGB nach überwiegender Ansicht so verstanden wird, dass das für die Übertragung der Forderung erforderliche abstrakte Verfügungsgeschäft einheitlich dem Statut der abgetretenen Forderung nach Art. 33 Abs. 2 EGBGB zu unterstellen ist, während nach anderer Auffassung auch für das Verfügungsgeschäft mit Ausnahme der in Art. 33 Abs. 2 EGBGB genannten Aspekte einheitlich an das Statut nach Art. 33 Abs. 1 EGBGB anzuknüpfen ist, dem die Vereinbarung über die Verpflichtung zur Übertragung der Forderung unterliegt, was im Wesentlichen der seit dem 17. Dezember 2009 an die Stelle des Art. 33 EGBGB getretenen Regelung in Art. 14 Rom-I-VO unter Berücksichtigung auch der Erläuterungen in Erwägungsgrund 38 Rom-I-VO entspricht (vgl. dazu etwa Bamberger/Roth/Spickhoff, 3. Aufl. (2012), Art. 14 Rom-I-VO Rn. 2 ff.; MüKo-BGB/Martiny, 7. Aufl. (2018), Art. 14 Rom-I-VO Rn. 25; Palandt/Thorn, 77. Aufl. (2018), Art. 14 Rom-I-VO Rn. 3; Staudinger/Hausmann, Neubearb. 2016, Art. 11-29 Rom-I-VO Rn. 9 ff.; jeweils mit weiteren Nachweisen).
- 75 β) Sie kann im Streitfall aber offen bleiben, weil sowohl bei Anwendung des Statuts des Prioritätsrechts (USamerikanischen Rechts) als auch bei Anwendung des Vertragsstatuts (deutschen Rechts) eine Vereinbarung zwischen dem Miterfinder Meyer und der Ericsson GmbH zustande gekommen ist.

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Exhibit 21

Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/940,681

<https://beck-online.beck.de/Print/CurrentMagazine?vpath=bibdata%5Cents%5CbeckrPage%2f0179>

REEL: 049669 FRAME: 0179

**German Federal Court of Justice (Xth Civil Senate), judgment dated  
September 4, 2018 - X ZR 14/17**

**Title:**

Proceedings in patent nullity matter

**Provisions:**

Introductory Act to the German Civil Code, previous version, Sec. 30, Sec. 33  
EPC Art. 54 (2), Art. 89

**Name of the decision:**

Wireless communication network

**Official head notes:**

**1. The effectiveness of the transfer of rights to an invention by use as a service invention by the employer is subject to labor law.**

**2. The question which rights and obligations of the contractual parties arise from a contractual agreement on the assignment of a right of priority must not be assessed based on the law relevant for the first application but based on law governing the agreement. If the agreement is concluded between the service inventor and their employer, the law governing the agreement regularly corresponds to labor law.**

**3. A technical teaching that is made available to the public by being uploaded to a web-server and made available worldwide on the internet to the general public or a part of the expert public does not yet constitute prior art if, at the time of the upload, the date of priority or filing date had not begun in a time zone different from the location of the upload.**

**Areas of law:**

Patent law, utility-model law, labor law, regulations governing data processing, multi-media and media, legal provisions concerning postal services, European law, foreign law, international law

**Keywords:**

Invention, patent application, claim

**Previous decision:**

German Federal Patent Court, judgment dated September 20, 2016 - 5 NI 28/14 (EP)

**Further information:**

Reference work: yes; German Federal Court of Justice in Civil Matters: no; case law of the German Federal Court of Justice: yes

**ECLI:**

ECLI:DE:BGH:2018:040918UXZR14.17.0

Exhibit 21



**71** Such an interpretation of the declaration made is justified against the background that, according to US legislation applicable at the time, Ericsson GmbH or TLME would not have been able to file the prior application itself as patent applications could only be filed by the inventor(s) themselves, which means that the right to claim the priority of the prior application originally could not be established to the benefit of Ericsson GmbH or TLME but an assignment by the inventors/applicants of the prior application of such right was necessary. Later, on January 8, 2008, the service inventor communicated the number of the prior US application to their employer; this was to be understood to be an expression of their willingness to do everything necessary and owed under the law to make valid later applications of the invention possible for their employer if the invention is claimed. Since this specifically included the assignment of the right of priority, this constituted the offer to specifically also assign the right of priority which had arisen from the prior application. It also corresponded to the co-inventor's interest as, after an effective utilization of the invention by their employer, the right of priority could no longer be claimed by the service inventor himself/herself, but only by their employer (or its parent company) as the new proprietor of the rights to the invention for later applications because of the transfer of the right to the invention effected by it. In return, the prospect that later applications filed by the employer included a more favorable priority which might be decisive in terms of patentability and that this would benefit the service inventor in the context of the claim for remuneration pursuant to Sec. 9 German Employee Inventor Act (ArbErfG) presented itself to the service inventor upon assignment of the right of priority to their employer. At the same time, the service inventor fulfilled their obligation pursuant to Sec. 15 (2) German Employee Inventor Act of supporting Ericsson GmbH, their employer, in acquiring IP rights and making the required declarations upon request, which also includes the consent to the assignment of rights of priority in case of prior applications by the employer, according to the correct opinion (Bartenbach/Volz, ArbErfG, 5th edition, Sec. 15 marginal no. 32; Rother in Reimer/Schade/Schippel, ArbErfG, 8th edition, Sec. 15 marginal no. 12).

As an English translator duly appointed and sworn by the Regional Court of Munich I, I certify that, to the best of my knowledge and belief, the above translation is a true and correct translation of the German document presented to me.

Munich, February 25, 2019

  
Saskia Ettling



Exhibit 21

<https://beck-online.beck.de/Print/CurrentMagazine?vpath=bibdata%5CContent%5C> REEL 049869 FRAME: 0182

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FEDERAL SUPREME COURT  
ON BEHALF OF THE PEOPLE  
JUDGEMENT  
X ZR 14/17

Announced on: September 4th, 2018.

in the patent nullity case

FCJ, judgment of 4 September 2018 - X ZR 14/17 - Federal Patent Court

The X. The Civil Senate of the Federal Court of Justice has ruled based on the oral hearing of 4. September 2018 by the Presiding Judge Prof. Dr. Meier-Beck, the Judges Dr. Grabinski, Dr. Bacher and Hoffmann, and the Judge Dr. Marx  
for justice:

**Tenor:**

The judgment of the 5th Senate (Invalidity Senate) of the Federal Patent Court of 20 September 2016 is amended in response to the defendant's appeal.

The European patent 2 229 744 is declared invalid with effect in the Federal Republic of Germany to the extent that its subject-matter goes beyond the following patent claims 1 and 12, to which claims 2 to 11 and 13 to 15 refer:

„1. Method in a first node (110) for requesting a status report from a second node (120), the first node (110) and the second node (120) both being comprised within a wireless communication network (100), the status report comprising positive and/or negative acknowledgement of data sent from the first node (110) to be received by the second node (120), wherein the method comprises the steps of:

transmitting (306) a sequence of data units or data unit segments to be received by the second node (120), the method further comprises the steps of:

counting (307) the number of transmitted data units and the number of transmitted data bytes of the transmitted data units, requesting (310) a status report from the second node (120) if the counted number of transmitted data units exceeds or equals a first predefined value, or the counted number of transmitted data bytes of the transmitted data units exceeds or equals a second predefined value and resetting both the counted number of transmitted data units and the counted number of transmitted data bytes, if the counted number of transmitted data units exceeds or equals the first predefined value, or the counted number of transmitted data bytes units exceeds or equals the second predefined value.

12. A first node (110) comprising an arrangement (400) for requesting a status report from a second node (120), the first node (110) and the second node (120) both used for a wireless communication network (100), the status report comprising positive and/or negative acknowledgement of data sent from the first node (110) to be received by the second node (120), wherein the arrangement (400) comprises:

a transmitter (406), adapted to transmit a sequence of data units or data unit segments to be received by the second node (120), the arrangement (400) further comprises:

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Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/940,681

<https://beck-online.beck.de/Print/CurrentMagazine?ypath=bibdata%5Cents%5CbeckPage4703r2019>

**PATENT**  
**REEL: 049669 FRAME: 0183**

a counting mechanism (407), adapted to count the number of transmitted data units and the number of transmitted data bytes of the transmitted data units, a requesting unit (410), adapted to request a status report from the second node (120) if the counted number of transmitted data units exceeds or equals a first predefined value, or the counted number of transmitted data bytes of the transmitted data units exceeds or equals a second predefined value, and a resetting unit (411, 412), adapted to reset the counting mechanism thereby to reset both the counted number of transmitted data units and the counted number of transmitted data bytes, if the counted number of transmitted data units exceeds or equals the first predefined value, or if the counted number of transmitted data bytes exceeds or equals the second predefined value."

Dismisses the remainder of the action.

Orders the defendant to pay one quarter of the costs of the proceedings and the plaintiff and its intervener to pay three quarters.

By law

### **Facts:**

- 1** The defendant is the proprietor of the European patent 2 229 744 (patent in suit), granted with effect in the Federal Republic of Germany, relating to a method and an order in a radio communication network.

The patent in suit was filed on October 7, 2008, claiming the priority of a US patent application filed on January 8, 2008.

- 2** The patent in suit comprises 15 patent claims. Claims 1 and 12, to which the following patent claims are directly or indirectly related back, are as follows in the language of the proceedings:

„1. Method in a first node (110) for requesting a status report from a second node (120), the first node (110) and the second node (120) both being comprised within a wireless communication network (100), the status report comprising positive and/or negative acknowledgement of data sent from the first node (110) to be received by the second node (120), wherein the method comprises the steps of:

transmitting (306) a sequence of data units or data unit segments to be received by the second node (120), the method further comprises the steps of:

counting (307) the number of transmitted data units and the number of transmitted data bytes of the transmitted data units, and requesting (310) a status report from the second node (120) if the counted number of transmitted data units exceeds or equals a first predefined value, or the counted number of transmitted data bytes of the transmitted data units exceeds or equals a second predefined value."

12. A first node (110) comprising an arrangement (400) for requesting a status report from a second node (120), the first node (110) and the second node (120) both used for a wireless communication network (100), the status report comprising positive and/or negative acknowledgement of data sent from the first node (110) to be received by the second node (120), wherein the arrangement (400) comprises:

a transmitter (406), adapted to transmit a sequence of data units or data unit segments to be received by the second node (120), the arrangement (400) further comprises:

a counting mechanism (407), adapted to count the number of transmitted data units and the number of transmitted data bytes of the transmitted data units, and a re-requesting unit (410), adapted to request a status report from the second node (120) if

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Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/940,681

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the counted number of transmitted data units exceeds or equals a first predefined value, or the counted number of transmitted data bytes of the transmitted data units exceeds or equals a second predefined value."

- 3** The plaintiff and its intervener have argued that the subject-matter of the contested patent is not patentable. The defendant defended the property right as granted and with an auxiliary motion.
- 4** The Patent Court has declared the patent in suit invalid. The defendant's appeal, in which it defends the patent in suit only with the auxiliary application filed in the first instance as the main application, is opposed to this.

The plaintiff contests the appeal.

### Reasons for decision:

- 5** The admissible appeal shall be successful to the extent last asserted.
  - I.**
- 6** The patent in suit concerns a method and an order to request status reports in a wireless communications network.
- 7** (1) According to the description of the patent in suit, the quality of communication in such a network is subject to fluctuations for a variety of reasons. In particular, during communication between two subscriber devices, such as a base station and a user facility, referred to as nodes in the contested patent, sent data units such as protocol data units (PDUs) may be distorted or not arrive at the recipient at all. It may therefore be necessary to send such data units again. For this purpose, they must be buffered at the transmitter in a retransmission buffer. Since the storage space available for this purpose is limited, the sending node must at some point learn which stored data units it must resend and which are no longer required. A status report is used for this, which the receiving node sends back to the sending node. It can either acknowledge (acknowledgment = ACK) or deny (NACK) the receipt of a data unit.
- 8** Such a status report can be triggered ("triggered") by either the sending or the receiving node. The patent in suit describes that the Radio Link Control Protocol (RLC Protocol), which belongs to the LTE standard (= 3GPP TS 36.322 Evolved Universal Terrestrial Radio Access [E-UTRA], Radio Link Control [RLC] protocol specification [Release 8], NK4a), provides for a method in which the broadcaster sends a request (poll) for a status report if certain criteria are met. Criteria for this are the sending of the last PDU in a buffer or the expiration of a timer for resending a request if the receipt of the data unit has not been confirmed by then. The criteria were suitable for bursty traffic. In the case of continuous transmission, however, additional triggers would have to be considered.
- 9** As the patent specification further explains, a jam or a stalling can result both from the fact that too many bytes are buffered and from too many data units. In the LTE standard, the size of the data units is variable; it therefore does not correspond to a specific number of bytes. Since the sender needs the sequence number to recognize whether it has all the data units

but the number of sequence numbers to be assigned is limited, a blockade can occur not only because the buffered data exhausts the storage capacity, but also because it prevents the re-allocation of the sequence of numbers. The limitation of the number of data units or bytes stored up to a report request can be either counter or window based. With a counter-based method, the number of transmitted data units or bytes is counted and a poll bit is set after reaching a set number of the same. With a window-based method, however, a status report is only requested if the number of sent but not yet confirmed data units or bytes exceeds a certain number.

- 10** The patent specification criticises the fact that no known method takes account of the fact that a blockade may sometimes occur both because of the limitation of storage space and because of the sequence number limitation. However, the quality and capacity of a network would be compromised by data loss and blockages as well as unnecessary status reporting and data resending.
- 11** 2. Against this background, the contested patent refers to the task of providing an improved wireless communication system.
- 12** 3. The invention solution protected by patent claim 1 - in the version last defended by the defendant - can be structured as follows - in substantive agreement with the judgment of the Patent Court:
1. proceedings
    - 1.1 in a first node (110) for requesting a status report from a second node (120);
    - 1.2 wherein the first node (110) and the second node (120) are both located in a wireless communication network (100);
    - 1.3 wherein the status report comprises positive or negative acknowledgement of data to be sent from the first node (110) and received by the second node (120).
  2. The method comprises the following steps:
    - 2.1 transmitting (306) a sequence of data units or data unit segments to be received by the second node (120);
    - 2.2 Counting (307)
      - 2.2.1 the number of data units transmitted and
      - 2.2.2 the number of transmitted data bytes of the transmitted data units;
    - 2.3 Requesting (310) a status report from the second node (120) when
      - 2.3.1 the counted number of transmitted data units exceeds or corresponds to a first predefined value; or
      - 2.3.2 the counted number of transmitted data bytes of the transmitted data units exceeds or corresponds to a second predefined value;
    - 2.4 Resetting of both counters when
      - 2.4.1 the counted number of transmitted data units exceeds or corresponds to the first predefined value; or

2.4.2 the counted number of transmitted data bytes exceeds or corresponds to the second predefined value.

**13** 4. Claim 1 requires the following explanations:

**14** (a) The term 'data bytes' used in characteristics 2.2.2, 2.3.2 and 2.4.2 (steps of counting, requesting a status report and resetting both counters) is identical to the term 'bytes' also used in the description. This results from the explanations given in the description of the state of the art, the advantages of the doctrine in accordance with the invention and the examples of execution in accordance with the invention, in which the terms "bytes" or "data bytes" are used in connection with the features mentioned, without thereby expressing a different meaning (cf. paragraphs 8 ff.; 16 ff.; 35 ff.; 63 ff.).

**15** (b) Feature 2.3.2 provides that a status report is requested by the second node when the counted number of transmitted data bytes of the transmitted data units exceeds or corresponds to a second predefined value. This excludes a change in the counted number of transmitted data bytes by subtracting the data bytes positive or negative (ACK or NACK) of confirmed data units from the counted number of transmitted data bytes of the transmitted data units, since this number would then no longer be decisive for the request of the status report alone if a predefined threshold value is reached or exceeded. Such an understanding is consistent with Feature 2.4.2, which links resetting both counters to reaching or exceeding a predefined numerical value of transmitted data units and alternatively to reaching or exceeding a predefined numerical value of transmitted data bytes. It also corresponds to the counter-based technique described in the patent specification, according to which the number of sent PDUs or bytes is counted and the query is triggered when a preset number of PDUs or bytes has been sent, and is thus distinct from the window-based technique, in which the query is triggered only when the amount of sent but not yet confirmed data exceeds a certain number of PDUs or bytes (cf. par. 9 f.).

**16** c) By resetting both counters simultaneously with the request for the status report (feature group 2.4), superfluous report requests are avoided by a single mechanism both because of the sequence number limitation and because of the limited storage space, as stated in the patent specification. By combining the two requirement criteria number of data units sent and number of bytes sent, it is achieved that no request is unnecessarily made on the basis of the first criterion, although such a request has only recently been triggered by the other second criterion (paragraph 17). In addition, blockages due to sequence number restrictions as well as lack of memory space are prevented (par. 18).

**17** 5. The Explanatory Notes to patent claim 1 shall apply mutatis mutandis to patent claim 12.

II.

**18** The Patent Court denied the patentability of the subject-matter of the patent in suit and essentially stated the following reasons:

**19** The conference contribution Tdoc R2-073937 of the company ZTE, which was written in October 2007 within the framework of a 3GPP standardisation working group dealing with LTE (NK1), contains a compilation of proposals of participating companies.

to request status reports between two specific LTE participants. The status report may contain positive or negative acknowledgements of data packets sent by the sender.

- 20** In the NK1, the "Rel-6 Status reporting triggers" with reference to the conference fee R2-074176 of NTT DoCoMo, Inc. (NK2), the general counting of data units as the basis for a subsequent request for a status report is revealed by determining (counting) the individually assigned number of each transmitted data unit (PDU) in the sequence number space available therefor and, in the absence of sequence numbers, detecting the corresponding data packets as not having been received.
- 21** The Polling Trigger "Every Poll\_PDU PDU" listed among others in Table 1 "Rel-6 Polling triggers" also indicates a count of the data units provided as "Poll\_PDU", which serve as triggers for sending a status report after reaching a predefined value, documenting missing data packets and initiating their retransmission. The fact that the polling trigger "Every Poll\_PDU PDU" was rejected by ZTE, as also noted in Table 1, and that the decision proposal "No?." was also found there, did not imply any mandatory or already made determination on the part of the 3GPP working group, since the document was understood only as a basis for discussion and was not meant exhaustively.
- 22** In addition, from Motorola's predecessor document R2-073538 of the same 3GPP working group of August 2007 (NK3), the expert was aware of the advantage of counting the number of bytes of data packets sent, to which Table 3 'New polling triggers proposed' of the NK1 also refers the polling trigger 'Transmission of every N bytes data' listed therein. If a predetermined byte value is exceeded, the status report is requested by the sending network node from the receiver, thus preventing the data buffer from overflowing.
- 23** In the run-up to NK1, the expert was thus already shown that a mere monitoring of the sequence number space for data units, as in the UMTS standard in the LTE context, was no longer sufficient to prevent a blockade of the communication system due to the now variable data packet size. On the one hand, the expert will continue to use the PDU counter already known to him from the UMTS standard, which occupies little storage space in itself, since this can signal the absence of data units by means of sequence number monitoring in a simple and proven manner, and on the other hand, due to the variable PDU size in the LTE future, he will additionally ensure that data units requiring very large storage space are protected by a byte counter. The fact that this approach was not adopted in the standard does not prevent this, since not only technical-scientific, but also economic and company policy factors could be of significance for the inclusion of a functionality in a standard.
- 24** III. This assessment of the patentability of the invention does not stand up to review in appeal proceedings to the extent of the patent in suit (former auxiliary application) defended by the defendant alone.
- 25** 1. the subject-matter of patent claim 1 is new in relation to the NK1.
- 26** a) The ZTE contribution first lists "Polling and status reporting triggers" discussed in the working group. The following is displayed next to the respective trigger-



which of the parties are in favour of or against the inclusion of the trigger in the LTE standard and which decision is likely to emerge thereafter. In a further part of NK1, ZTE considers the selection of triggers with regard to reduced complexity and latency as well as increased efficiency and reliability (reduced complexity, reduced latency, improved efficiency and improved reliability) and, finally, six ZTE proposals for further development.

- 27** b) As the Patent Court has correctly stated and as the defendant does not deny, features 1 to 2.1 are disclosed in the NK1.
- 28** c) Table 1 of the NK1 lists - among other triggers - the PDU counter-based trigger "Every Poll\_PDU PDU", which corresponds to characteristics 2.2.1 and 2.3.1. However, this trigger is expressly rejected by ZTE and no other company supporting such a trigger is mentioned. Instead, ZTE advocates a window-based PDU trigger. Whether a disclosure of the aforementioned features can nevertheless be assumed appears doubtful, since here it would be disregarded that the patent in suit precisely teaches a certain combination of known triggers, but no final decision is required, because in any case there is no disclosure of features 2.3, 2.3.2 and 2.4 in the NK1.
- 29** d) Table 3 of the NK1 lists the trigger "Transmission of every N bytes data" as a newly proposed "Polling Trigger". NK1 refers in this respect to NK3, which comes from Motorola, another company in the 3GPP working group. In the NK3 this trigger is defined as follows (NK3, 2.2):
- „The sender triggers the polling function for every N bytes of data transmitted which haven't been ACK/NACK yet. The trigger aims at avoiding RLC buffer overflows. Note that RLC PDU size is flexible in LTE system, so the byte based polling is more accurate in reflecting the potential buffer level than PDU or SDU counts.“
- 30** Accordingly, a status report should only be requested if the number of transmitted data bytes of the transmitted data units (PDUs) that have not yet been confirmed positive or negative (ACK/NACK) reaches or exceeds a predefined threshold value. This does not meet the requirements of feature 2.3.2, which makes requesting a status report dependent solely on the counted number of transmitted data bytes of the transmitted data units exceeding or corresponding to a predefined value.
- 31** e) The NK1 further does not disclose that requesting a status report from the second node is conditional upon the counted number of sent data units or the counted number of sent data bytes of the sent data units reaching or exceeding a respective predefined value. That would apply even if, contrary to the abovementioned assessment, it were assumed in favour of the plaintiff that the trigger 'Every Poll\_PDU PDU' listed in Table 1 of the NK1, together with several other triggers, reveals characteristics 2.2.1 and 2.3.1 and the trigger 'Transmission of every N bytes data' listed in Table 3 of the NK1, together with other triggers, reveals characteristics 2.2.2 and 2.3.2. Because even then, the NK1 does not result in combining these two triggers as invented.
- 32** (f) Finally, the NK1 does not disclose to reset both counters if either of the two values provided for in characteristics 2.4.1 or 2.4.2 has been reached or exceeded.

**33**

2. Contrary to the assumption of the Patent Court, the doctrine resulted from patent claim 1 for the person skilled in the art also not in an obvious way from the state of the art.
- 34** a) It may be that it (in hindsight) only appears logical to avoid blockages of the data buffer particularly efficiently by focusing on the combination of the two criteria "number of sent data units" and "number of sent bytes" and resetting both counters simultaneously. However, a corresponding suggestion is not to be found in any of the three citations taken into account in the judgment of the Patent Court.
- 35** aa) This applies initially to NK1, from which there is already no suggestion to modify the trigger "Transmission of every N bytes data" or another of the triggers listed in the tables of NK1 in the sense of feature 2.3.2.
- 36** bb) In addition, although the NK1 names "Rel-6 Polling Trigger" in Table 1, the PDU counter-based trigger "Every Poll\_PDU PDU", and the trigger "Transmission of every N bytes data" in Table 3, "New polling triggers proposed", it does indicate a clear preference for a window-based trigger (NK1, p. 1, Table 1; p. 4 under "improved efficiency"), while the PDU counter-based trigger "Every Poll\_PDU PDU" is rejected by the authors of NK1 (ZTE) (NK1, p. 1, Table 1; p. 4 Proposal 1).
- 37** Accordingly, at no point in the NK1 is it even considered to combine the PDU counter-based trigger "Every Poll\_PDU PDU" with a byte counter-based trigger. On the contrary, the "reduced complexity" aspect discussed under the heading "2.2 further considerations", according to which unnecessary options are to be eliminated, tends to speak against combinations of several triggers. From the point of view of improved reliability, only the combination of transmitter-side triggers with receiver-initiated status reports is advocated. From the point of view of "improved efficiency", it is also stated that studies have shown that recipient-initiated status reports are more efficient than sender-initiated reports. In addition, window-based queries could be an efficient way to trigger status reports. Accordingly, the expert was not prompted by NK1 to consider a combination of the PDU- and byte counter-based triggers listed in Tables 1 and 3.
- 38** cc) Thus, the NK1 could not give rise to any suggestion to reset both counters if one of the two prerequisites according to characteristics 2.4.1 or 2.4.2 has been fulfilled.
- 39** dd) A suggestion to supplement the method known from the NK1 in the sense of the method according to the invention did not arise for the skilled person even if he included the NK2 in his considerations.
- 40** The NK2, which originates from another company in the 3GPP working party (NTT DoCoMo Inc.) other than the NK1, is based on the trigger 'Transmission of last data in the buffer' (also considered by the patent in suit to be useful for intermittent data transmission) and notes that a further transmitter-side trigger is required for continuous data transmission. Of the four possible options (SDU-based polling, timer-based periodic polling, PDU counter polling and window-based polling), the latter two are preferred as efficient solutions.
- 41** The NK2 may thus, in contrast to the NK1, place the "PDU counter polling" on the same level as the "window-based polling" with regard to its efficiency. A motif that combines the PDU-based trigger with a byte-based trigger and, on reaching

or if one of the two threshold values has already been exceeded, both counters are reset, but this does not result in a reset.

**42** ee) It finally did not result from NK3.

**43** (1) As explained above, the transmitter-side trigger "Transmission of every N bytes data" disclosed in the NK3 does not comply with the requirements of feature 2.3.2. The NK3, which proposes to the 3GPP working group that the above trigger be advantageous together with other triggers, gives no reason to modify it in accordance with feature 2.3.2.

**44** (2) In addition, NK3 merely proposes to combine the trigger "Transmission of every N bytes data" with the periodically triggered transmitter-side trigger "Transmission of every K TTIs", but not, as required by the invention, with a PDU counter-based trigger. A suggestion to replace the periodic trigger "Transmission of every K TTIs" by another trigger and in particular a PDU counter-based trigger from these two triggers does not result from the NK3.

**45** (3) Accordingly, there is no suggestion to reset both counters according to characteristics 2.4.1 and 2.4.2.

IV.

**46** The judgment of the Patent Court, to the extent still defended by the defendant, is not, for any other reason, correct in its conclusion.

**47** Irrespective of the question whether the subject-matter of patent claims 1 and 12 is different from the technical specification belonging to the LTE standard '3GPP TS 36.322 V.8.1.0 (2008-03) - 3rd Generation Partnership Project; Technical Specification Group Radio Access Network; Evolved Universal Terrestrial Radio Access (E-UTRA) Radio Link Control (RLC) protocol specification (Release 8)' (NK4b) and the other LTE specifications NK4c and NK4d would be new, the NK4b, NK4c and NK4d do not belong to the state of the art with respect to the patent in suit because they were not granted until 17 January 2008. The patent in question claims - contrary to the plaintiff's view - the priority of US patent application 61/19746 of 8 January 2008 (N4).

**48** a) This initially applies in terms of content.

**49** aa) According to the case law of the Federal Court of Justice, the subject-matter of the claimed invention must be disclosed in the prior application as belonging to the invention applied for (BGH, judgement of 11. September 2009 - X ZR 168/98, BGHZ 148, 383, 389 = GRUR 2002, 146 - Air distributor; judgment of 11 February 2014 - X ZR 107/12, BGHZ 200, 63 marginal 23 = GRUR 2014, 542 marginal 21 - Communication channel; see also EPO (GBK) GRUR Int. 2002, 80).

**50** bb) The plaintiff argues that the "counting of sent data bytes" required in features 2.2.2, 2.3.2 and 2.4.2 of patent claim 1 and correspondingly in patent claim 12 is not disclosed in the pre-announcement because there is only talk of "counting of sent bytes" throughout. The plaintiff assumes that the term 'data bytes' refers only to 'useful data', whereas the term 'bytes' includes not only useful data but also header bytes. Accordingly, the counting of "the transmitted data bytes of the transmitted data units" is not disclosed in the advance notification.

**51** cc) This may not be joined.

**52**

Exhibit 21

Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/910,681

<https://beck-online.beck.de/Print/CurrentMagazine?vpath=bibdata%5Cents%5Ccase%5CPage%5C15%5C19>

**REEL: 049669 FRAME: 0191**

(1) As explained above, the notion of "data bytes" used in patent claims 1 and 12 and in the description of the patent in suit does not differ from the notion of "bytes" also used in the description of the patent in suit in relation to features 2.2.2, 2.3.2 and 2.4.2. Accordingly, there is no difference between the term "data bytes" used in patent claims 1 and 12 and the term "bytes" used in the preliminary application in connection with the steps of counting, requesting and resetting the counters (see N4, p. 2, line 24 et seq.; p. 4, line 23 et seq.). Since the term "data bytes" used in the patent claim does not differ from the term "bytes" used in the prior application, it is also disclosed as belonging to the invention.

- 53** The question as to whether the terms "data bytes" and "bytes" (used identically in the preliminary application and the patent in suit) refer to useful data or useful data and header bytes, or whether another understanding is to be taken as a basis, does not need to be assessed in the absence of relevance to the decision.
- 54** (2) The plaintiff's other objections that the pre-announcement does not generally disclose first and second nodes, a wireless communications network, transmission and counting of data units and data unit segments, and the request for a status report as provided for in patent claims 1 and 12 are also unfounded.
- 55** According to the case-law of the Bundesgerichtshof (Federal Court of Justice), the priority of a pre-announcement may be claimed if the technical instructions for the skilled person described there on the basis of an example of implementation or in any other way present themselves as a form of the more general technical doctrine described in the pre-announcement and, in the general public revealed in the pre-announcement, that doctrine can already be inferred from the pre-announcement as belonging to the invention applied for (BGH, judgment of 11 September 2006 in the case law of the Federal Court of Justice). February 2014 - X ZR 107/12, BGHZ 200, 63 marginal 23 = GRUR 2014, 542 marginal 24 - Communication channel; see also BGH, judgment of 17 February 2015 - X ZR 161/12, GRUR 2015, 573 marginal 29 - Wound treatment equipment; judgment of 7 November 2017 - X ZR 63/15, GRUR 2018, 175 marginal 30 - Digital book).
- 56** The pre-announcement mentions the document "3GPP TS 36.322 Evolved Universal Terrestrial Radio Access (E-UTRA), Radio Link Control (RLC) Protocol Specification (Release 8)" as the background to the invention and explains the method and application according to the invention with regard to the LTE communication system described therein. The person skilled in the art, however, is already aware of this from the introductory note to the pre-announcement, in which it is pointed out that the invention refers to a method and an application in a telecommunications system and in which the RLC polling for continuous transmission is mentioned only as a "special case" of such a method or application (N4, p. 1, para. 1). 1 under the heading "Method and Arrangement in a Telecommunication System"), that the inventive method for requesting a status report generally concerns communication between a first and a second node in a wireless communication network and the application between "user equipments" (p. 4, line 10 ff.: "UE") of the LTE communication system is to be understood only as a special application case. In addition, the last sentence of the pre-announcement states that although the invention was described for the LTE ("evolved UTRAN") communication system, similar principles also apply to the UMTS ("UTRAN") communication system.

Exhibit 21

Petition Pursuant to 37 CFR 1.46(B)(2)

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if flexible RLC PDU sizes were introduced (N4, p. 6). From a technical point of view, this reference should also be understood without further consideration to the effect that the method and application in accordance with the invention refer to all suitable wireless communication systems and in this respect also to the communication between two nodes of such systems and not only to the LTE communication system and the "user equipment" used by it.

- 57** Accordingly, it appears to the person skilled in the art that the counting of transmitted "PDUs" explained in the pre-announcement in relation to the LTE communication system also refers generally to the transmission and counting of data units or data unit segments as provided for in patent claims 1 and 12. Nothing else applies to the request for a status report, which is explained in the advance notification in relation to the LTE communication system that a poll bit is set in the RLC header (N4, p. 1, line 16 et seq.). This characteristic also reveals itself to the expert with regard to communication systems that, according to the invention, a status report should be queried depending on the two mechanisms mentioned in the summary (N4, p. 2, para. 2: "Summary") (counting the number of PDUs or data units and counting the number of transmitted bytes).
- 58** (b) The plaintiff for the contested patent, Telefonaktiebolaget L M Ericsson (TLME), was also entitled to claim the priority of US patent application 61/19746 of 8 January 2008 (N4). It is not the plaintiff for the pre-notification. However, as the legal successor to the three plaintiffs for the preliminary application, Per Johan Torsner, Janne Pelsa and Michael Meyer, it is entitled to claim priority (Article 87(1) EPC).
- 59** aa) The two plaintiffs Torsner and Pelsa have transferred their right of priority as a mere form of general doctrine to TLME through legal agreements dated 5 and 9 August 2008 (Annexes DN3a and 3b). In so far as the plaintiff first of all denied with ignorance the authenticity of the copies of the agreements submitted and the authenticity of the signatures thereon, it did not come back to that in the appellate court and, on its own, denied a transfer of the priority right of the third plaintiff Meyer to his employer, Ericsson GmbH, and from that company to TLME.
- 60** bb) However, the right of priority has also been transferred to TLME in this respect.
- 61** (1) The priority right was transferred from the plaintiff Meyer to Ericsson GmbH by way of a legal agreement between the two parties.
- 62** (a) While the case law and the literature in Germany and the Boards of Appeal of the European Patent Office assume that the right of priority is to be qualified as an independent right of property to claim priority, which can be transferred by the plaintiff for the first application to a third party as successor in title (BPatG, judgment of 13 June 2001 in the case of the German Patent and Trademark Office), the right of priority is to be qualified as an independent right of property to claim priority (BPatG, judgment of 13 December 2001 in the case of the German Patent and Trademark Office). January 1981 - 13 W (pat) 36/78, GRUR Int. 1982, 452, 453; OLG Düsseldorf, judgment of 6 December 2012 - 2 U 46/12, juris Rn. 44; Benkard/Grabinski, EPC, 2nd ed. (2012), Article 87(3); Buses/Keuken-schrijver, PatG, 8th ed. (2016), § 40 marginal 10; Keukenschrijver, Mitt. 2001, 233; Schul-te/Moufang, PatG with EPC, 8th ed, § 41 para. 27; see also BGH, Urteil vom 16. April 2013 - X ZR 49/12, GRUR 2013, 712 para. 11 - Fahrzeugscheibe; EPA (TBK), Entscheidung vom 18. Juni 2015 - T 205/14, 3.3; Entscheidung vom [2009]19. Juni 2015 - T 517/14, 2.4), sees the English case-law as a "successor in title" without further ado

Exhibit 21

Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/940,681

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REEL: 049669 FRAME: 0193

to those to whom the rights to the invention have been transferred (High Court, Kitchen J, EWHC 1304 (Pat) marginal 93 [2010]- Edwards Lifesciences AG/Cook Biotech Inc; High Court, Arnold J, EWHC 1487 (Pat) marginal 58, 70 - KCI Licensing Inc/Smith & Nephew Plc). The same applies according to the case law of the Swiss Federal Supreme Court (BGE 42 II 400).

- 63** (b) Both views shall be held in cases where the right to the invention has been transferred by legal agreement from the inventor and plaintiff of the first application to the plaintiff of the second application after the first filing and before the filing of the European subsequent application, as in the KCI Licensing Inc/Smith & Nephew Plc, because even in the absence of an express agreement, the transfer agreement will usually have to be interpreted according to general principles in such a way that the rights to the invention are tacitly transferred together with the right to claim priority (cf. e.g. BGH, GRUR 2013, 712 marginal 14 et seq. - vehicle window).
- 64** (c) However, in the event of a dispute, the rights of co-inventor Meyer to the invention did not pass to Ericsson GmbH on the basis of a legal transaction agreement, but by being claimed as an employee invention by means of a declaration received from Mr Meyer on 6 February 2008. Whether the right of co-inventor Meyer to claim priority from the US pre-announcement has also been transferred with this transfer does not require a final decision in the event of a dispute.
- 65** (aa) German law shall apply to the transfer of the rights of the co-inventor Meyer to the invention by claiming it as an employee invention. The rights and obligations arising from a service invention shall be governed by the same law which is also otherwise applicable to the employment relationship between the employee inventor and the employer (OLG Karlsruhe, judgment of 13 April 2018 - 6 U 161/16, GRUR 2018, 1030 marginal 23 = juris marginal 145; Busse/Keukenschrijver, 8th ed. (2016) PatG, Einl ArbEG marginal 11; MüKo-BGB/Drexl, 7th ed., 2018, IntImmGR marginal 204 f.; Staudinger/Fezer/Koos, Neubearb. 2015, IntWirtschR marginal 1053; each on Art. 8 Rome I Regulation). Accordingly, the effectiveness of claiming an invention as an employee invention is also assessed according to the employment statute. As a claim declared in 2008 is at issue, Art. 30 EGBGB applies. Since the employment relationship between Ericsson GmbH and Mr Meyer, who was employed at the Herzogenrath location, was subject to German law, the validity of Ericsson GmbH's claim to the invention also depends on this.
- 66** (bb) Under German law in force at the time, all rights to the invention are transferred by operation of law to the employer upon receipt by the employee of the unrestricted declaration of claim (§ 7 (1) ArbErfG aF). However, according to the case law of the Federal Court of Justice, this does not apply to industrial property rights based on the invention or to applications for industrial property rights of which the employee is the owner at the time of the claim, since he does not hold such rights on the basis of the right to the invention but on the basis of his position as plaintiff or patent holder irrespective of his substantive justification (BGH, Judgment of 12 April 2011 - X ZR 72/10, GRUR 2011, 733 para. 31 - Initial Idea). Whether the right to claim priority under Art. 87 EPC is nevertheless transferred to the employer when the employer claims an employee invention can remain open in the event of a dispute.

- 67** (d) In any event, the right to claim priority has been transferred by legal agreement between Ericsson GmbH and the co-inventor Meyer.
- 68** (aa) According to the case-law of the Federal Court of Justice, the validity of a transfer of the right to claim the priority of a patent application pursuant to Article 33(2) of the Introductory Law to the Civil Code (Introductory Law to the German Civil Code) is governed by the law of the State of the first filing (BGH, judgment of 16 April 2013 - X ZR 49/12, GRUR 2013, 712 marginal 12 - Fahrzeugscheibe mwN). However, the question of transferability to be assessed according to Art. 33 para. 2 EGBGB and any applicable formal requirements and other requirements for effectiveness must be distinguished from the question of which law governs the obligations between the old and the new right holder. This is in any case the respective contract statute for the agreement on the obligation to transfer the right to claim priority (obligation transaction) according to Art. 33 para. 1 EGBGB. However, the contractual statute is again regularly governed by the employment statute if the transfer is related to the employer's claim to a service invention.
- 69** (bb) It follows from the documents submitted by the defendant, taking into account the interests of the parties involved, that the co-inventor Meyer has agreed with his then employer, Ericsson GmbH, to transfer his right as co-announcer of the US American pre-announcement to claim priority from this pre-announcement.
- 70** a) Mr Meyer informed Ericsson GmbH of the number of the US-American pre-announcement by e-mail dated 8 January 2008 addressed to a clerk in the patent department of his employer. Taking into account the overall circumstances for Ericsson GmbH, this communication was to be understood not only as a communication of knowledge but also as a declaration by its employee to offer to transfer the priority right of the prior application to Ericsson GmbH in the event that Ericsson GmbH - as was to be expected - claimed the invention as a service invention pursuant to Sections 5 and 6 ArbErfG aF.
- 71** That interpretation of the statement made is justified in the light of the fact that, under US law in force at the time, Ericsson GmbH or TLME would not have been able to file the prior application itself, since patent applications could be filed only by the inventor or inventors themselves, so that the right to claim the priority of the prior application could not be established originally in favour of Ericsson GmbH or TLME either, but required a transfer of that right from the inventors and plaintiffs of the prior application. If the service inventor then informed his employer on 8 January 2008 of the number of the US advance application, this was to be understood as an expression of his willingness to do everything necessary and legally owed when claiming the invention in order to enable the employer to file effective subsequent applications for the invention. Since this included in particular the transfer of the right of priority, this included the offer to transfer in particular also the right of priority resulting from the pre-announcement. This was also in the interest of the co-inventor, since the priority right, after an effective claim to the invention by his employer, would no longer be held by the service inventor himself, but only by his employer (or its parent company) as the current owner of the rights to the invention for subsequent applications in

could be claimed. In return, with the transfer of the right of priority to his employer, the service inventor opened up the prospect that subsequent applications filed by his employer would be given a better priority, which might be decisive for patentability, and that this would benefit him within the scope of the remuneration claim under Section 9 ArbErfG. At the same time, it complied with its obligation under Section 15(2) ArbErfG to assist Ericsson GmbH, as its employer, on request in acquiring industrial property rights and to make the necessary declarations, including, in the case of prior notifications by the employee, consent to the transfer of priority rights (Bartenbach/Volz, ArbErfG, 5th ed., Section 15 para. 32; Rother in Reimer/Schade/Schippel, ArbErfG, 8th ed., Section 15 para. 12).

- 72** b) Ericsson GmbH accepted the offer to transfer the right to claim the US American pre-announcement by claiming the invention as a service invention with a declaration dated 28 January 2008, the receipt of which was confirmed by co-inventor Meyer on 6 February 2008 (Anl. DN3d). The statement of Ericsson GmbH expressly refers only to an unrestricted use of the invention "RLC polling for continuous transmission, P-number P25436 US1". However, by mentioning the US advance application 61/19746, the declaration also expresses that Ericsson GmbH - in accordance with its economic interest - also wanted to transfer the right to claim priority from the advance application to itself by unrestricted claiming of the invention and accordingly wanted to accept the offer of its employee directed towards this.
- 73** (cc) Whether, as the Senate tends to do, for the disposal of the right to claim priority (disposal transaction) under Art. 33 (1) Introductory Act to the German Civil Code (Introductory Act to the German Civil Code), which is simultaneously effected with the causal legal transaction, the contractual statute, i.e. here German law, is to be linked to the statute to which the right to be transferred is subject, in the event of a dispute US-American law, since the transfer of the right to claim the priority of a US advance application is at issue, can be left open.
- 74** a) This essentially corresponds to the provision in Art. 14 Rome I Regulation which has replaced Art. 33 EGBGB since 17 December 2009, taking into account also the explanations in recital 38 Rome I Regulation (cf. e.g. Bamberger/Roth/Spickhoff, 3rd ed. (2012), Art. 14 Rome I Regulation Rn. 2 et seq.; MüKo-BGB/Martiny, 7th ed. (2018), Art. 14 Rome I Regulation marginal 25; Palandt/Thorn, 77th ed. (2018), Art. 14 Rome I Regulation marginal 3; Staudinger/Hausmann, Neubearb. 2016, Art. 11-29 Rome I Regulation marginal 9 et seq.; each with further evidence).
- 75** b) However, it can remain open in the event of a dispute because an agreement has been reached between the co-inventor Meyer and Ericsson GmbH both in the application of the statute of priority law (US-American law) and in the application of the contract statute (German law).

**76**

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**77** The application of US law does not lead to any other result. It follows from the expert opinion submitted by the defendant by Prof. T. (Anl. DN3h) that, with regard to the communication of the co-inventor Meyer to his employer regarding the number of the US advance application on 8 January 2008 as well as the claim of the invention as a service invention by Ericsson GmbH with a declaration dated 28 January 2008, the following is true: the invention was filed as a service invention by Ericsson GmbH on 8 January 2008. In view of the fact that the agreement of January 1, 2008, and taking into account the interests of both parties, an implied-in-fact agreement on the transfer of the priority right from the co-inventor Meyer to Ericsson GmbH is to be assumed for essentially the same reasons as in the application of German law and in the application of American law.

**78** (2) The priority right has been transferred from Ericsson GmbH to TLME by means of an Assignment Declaration dated 14 February 2008 (Anl. DN3e).

**79** (a) According to the German law applicable as the contractual statute pursuant to Art. 33 (1) EGBGB (Introductory Act to the German Civil Code), an agreement has been reached on the transfer of the priority right from Ericsson GmbH to TLME.

**80** (aa) Since the parties involved did not choose the law in the "Assignment Declaration" of 14 February 2008, the presumption rule of Art. 28 para. 2 sentence 1 Introductory Act to the Introductory Act to the Introductory Act to the German Civil Code (Introductory Act to the Introductory Act to the Introductory Act to the Introductory Act to the Introductory Act to the Introductory Act to the Introductory Act to the Introductory Act to the Introductory Act to the Introductory Act to the Introductory Act to the Introductory Act to the Introductory Act to the German Civil Code (Introductory Act to the Introductory Act to the German Civil Code) (Pahlow, GRUR 2017, 393, 396 et seq. with regard to Art. 4 para. 2 Rome I Regulation) applies. As Ericsson GmbH has its registered office in Herzogenrath, German law therefore applies.

**81** (bb) The transfer declaration contains an offer by Ericsson GmbH to transfer the priority right, which was submitted with deposit in the electronic archive of the Ericsson group of companies on 14 February 2008 and received by TLME pursuant to Section 130 (1) sentence 1 of the German Civil Code (BGB), as the latter could and should have access to it and this was to be expected within the framework of the Ericsson group of companies. TLME's declaration of acceptance was not necessary for the agreement to be concluded, since such a declaration was not to be expected under the chosen form of transmission (Section 151, first sentence, Alt. 1 BGB). In this respect, too, the interpretation corresponds to the identifiable interests of the parties, since the transfer was a legal transaction advantageous to TLME and TLME alone could and should claim the right of priority for the application for the patent in suit after the two other plaintiffs for the pre-notification Peisa and Torsner had already transferred their right of priority to it.

**82** (b) In addition, the priority right has been assigned in the agreement concluded between Ericsson GmbH and TLME, irrespective of whether German or US American law is applicable in this respect pursuant to Art. 33 (1) and (2) EGBGB.

**83** (aa) This results from the application of German law in accordance with the above explanations on the conclusion of an agreement on the transfer to 37 CFR 1.46(B)(2)

Exhibit 24

**84** (bb) Even if US American law is applied, the "Assignment Declaration" of Ericsson GmbH is to be regarded as an offer to transfer the priority right and its acceptance results from the later conduct of

TLME, in particular the claiming of priority from the pre-announcement when applying for the patent in suit (cf. also expert opinion T., para. 25, Anl. DN3h).

- 85** 2) The patentability of the subject matter of patent claim 1 to the extent defended by the defendant is not precluded by Ericsson's contribution to the TSGRAN WG2 Meeting #60bis (NK6). This is not part of the state of the art, since it was only published on 8 January 2008 and thus on the priority date of the patent in suit. Contrary to the plaintiff's submission, it is irrelevant that, at the time when the NK6 was uploaded by TLME to the European web server of the 3GPP standardisation group and thus made available worldwide (around 8.36 a.m. Central European Time (CET)) in some other time zones (for example, in Alaska, where it was 22.36 a.m. (Yu-kon time), and in Hawaii (21.36 p.m. after Hawaii standard time)), 8 January 2008 had not yet started. The same applies to the e-mail uploaded to the same 3GPP server with which the co-inventor Peisa pointed this out to the WG2 working group shortly after uploading the NK6.
- 86** (a) Under Article 54(2) in conjunction with Article 89 EPC, the prior art is what has been made available to the public by written or oral description, by use or by any other means prior to the filing date or, as relevant in the event of dispute, the priority date of the European patent application. The starting point for the examination as to whether a citation, as published before that date, belongs to the prior art, is thus the calendar day on which the patent application or priority application was filed with the respective patent office. It is irrelevant, however, at what hour or minute the submission was made on that day. The date of the application or priority application shall then be related to the date on which the citation was made available to the public.
- 87** (b) With regard to the different time zones, different reference periods have been used in case law and administrative practice for the latter date:
- 88** (aa) The High Court of England and Wales and its Court of Appeal and an Opposition Division of the European Patent Office shall, as a reference for determining the time of making available to the public within the meaning of Article 54(1)(a) of Regulation (EC) No 40/94, make available to the public 2 EPC based on the time zone applicable at the place where the patent or priority application is filed (High Court, Birss J [2015] EWHC 3366 (pat) marginal 156, Court of Appeal, Gross, Floyd LJ, Sales J, [2017] EWCA Civ 266 marginal 161 - Unwired Planet International Ltd v Huawei Technologies Co Ltd; Opposition Division of the EPO, decision of 31 July 2013 - Application No 03 012 734.4, para. 2.2.1, DN9).
- 89** bb) However, as a yardstick for determining the time of the prior publication, the time zone applicable at the place where the action took place, with which the technical teaching was made accessible to the public, may also be considered alternatively.
- 90** (cc) By contrast, an Examining Division of the European Patent Office has - in accordance with the plaintiff's view - determined whether the citation was available on the Internet in any time zone on the day before the filing date or the priority date and thus made available to the public (see EPO, Order of 12 August 2013 - Application No 09 733 661.4, DN8, paragraph 5).
- 91** (c) Whereas, in the event of a dispute, the effect of the latter approach would be that the NK6 would be part of the state of the art, since, for example, in Alaska or Hawaii it would be retrieved via the Internet after the time applicable there on the day before filing the priority application

Exhibit 21

Petition Pursuant to 37 CFR 1.46(B)(2)

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PATENT

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the first two views lead to the opposite result, since the NK6 was only available on the date of filing of the priority application, if the time is based on the time which applied at the seat of the US Patent Office in Alexandria (Virginia) or at the place of the act which led to the publication of the NK6. However, the latter view does not apply for the following reasons. Whether the first or second view is correct does not require a final decision, since both lead to the same result in the case of dispute.

- 92** aa) The first view is supported by the fact that the consistent use of the time zone of the patent office where the patent or priority application was filed excludes the possibility that a citation which has not been published before that period may constitute prior art. However, it has the disadvantage that it may be necessary, in particular for publications in time zones other than that of the patent office of the patent application or priority application, to determine the exact date of publication, since only after determining that date can it be determined whether the publication in the time zone of the patent office of the patent application or priority application forming the reference scale has already been published before or only on the date of the application. However, determining the exact time of a pre-publication can lead to difficulties, for example if only the day, but not the hour, of the pre-publication has been documented during the publication of a patent application.
- 93** bb) In contrast, the relevance of the calendar day (and not the time) of the application is based on the notion that a particular publication or use, which may be considered prior art, also took place at a particular place on a particular calendar day (after the time zone applicable after that place) prior to the filing date at a certain place. **In** contrast, the exact time and thus the ratio of calendar days applicable at different reference locations is irrelevant. The closest thing to this concept underlying the Paris Convention is to take account of the place and time zone where the action leading to the public accessibility of the technical information for the experts takes place, and thus, in the event of a dispute, of the uploading of the NK6 at a location in the Central European time zone, when making a technical teaching available to the public by means of a medium such as the Internet which enables immediate worldwide availability. This approach also has the advantage that the determination of the date of a publication as a reference depends solely on the determination of the date of publication in the time zone of the publication activity. For example, it is sufficient to establish on which day a patent application was published in the time zone of the respective patent office in order to determine whether this publication belongs to the prior art with regard to the filing date of another patent or priority application. This also corresponds to the provision in Art. 54 (3), 87 EPC, according to which the content of post-published European patent applications or priority applications claimed by them must be based on their filing date.
- 94** (cc) On the other hand, the plaintiff's argument must not be upheld. It extends the reference framework from the time zone in which the publication action took place to all time zones, without there being any reference to the publication action and thus no justifiable reason for such an extension. In addition, this approach also has the disadvantage that it may be necessary to calculate the exact hourly

The time of the publication can only be determined after its determination whether the publication has already been published in the time zone forming the reference scale of the Patent Office of the patent or priority application before or only on the date of the application.

- 95** d) According to all this, the NK6 does not belong to the state of the art since it was only published on the priority date.

- 96** (3) With regard to the other citations on which the plaintiff based its appeal against the patentability of the subject-matter of claims 1 and 12 as granted, namely the international application WO 2008/097544 (NK5), the UMTS standard (NK7) and the document relating to the UMTS standard '3GPP TS 125 322 v3.18.0" (D2), the European patent application 1 638 237 (D3LG) and the international application WO 2008/137594 (D3HTC), the plaintiff

neither has it been asserted nor, as discussed at the hearing, is there evidence to suggest that it might conflict with the patentability of the subject-matter of claims 1 and 12 as last defended.

V.

- 97** The decision on costs is based on Sec. 121 (2) Patent Law and Sec. 91 (1), Sec. 92 (1), Sec. 100, Sec. 101 (2), Sec. 516 (3) Sentence 1 ZPO.

Previous instance:

Federal Patent Court, decision of 20.09.2016 - 5 Ni 28/14 (EP) -

Quote suggestion:

BGH Urt. v. 4.9.2018 - X ZR 14/17, BeckRS 2018, 37254

**patronus**

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**From:** Wolfgang Mann <wmann@ausbio.de>  
**Sent:** Wednesday, June 19, 2013, 7:45 am  
**To:** patronus  
**Subject:** Further aspects regarding the first application  
**Enclosures:** Weitere Aspekte zur Anmeldung.docx<sup>1</sup>

Hello Bernhard,

We wanted to subsequently add a multiple application for "Sample Carrier Centrifuge" before August. I have listed some essential points. I will speak to Wolfgang Heimberg today and will then possibly add further points.

Maybe we could speak on the phone later this week; I will be in China for 10 days from next Tuesday.

Wolfgang

Dr. Wolfgang Mann  
CEO

---

AusBio R&D Europe GmbH.  
Fritz Hornschuch Str. 9  
95326 Kulmbach  
Germany  
phone: +49(0) 9221 827628830  
mobile: +49(0) 1752206131  
e-mail: [wmann@ausbio.de](mailto:wmann@ausbio.de)

[Enclosure: Further Aspects regarding the application "Sample Carrier Centrifuge" *not translated*]

---

<sup>1</sup> Translator's note: The title of the document translates as "Further aspects regarding the application.docx."

## ATTESTATION CLAUSE:

In my capacity as a translator for the English language, duly appointed, commissioned and sworn in by the Munich Regional Court I in the German federal state of Bavaria, I hereby certify to the best of my belief that the foregoing is a true and complete English translation of the original document in the German language submitted to me as a copy.

IN WITNESS WHEREOF I have hereunder set my hand and seal at

Munich, February 27, 2019

Denise Giles  
Kuenstraße  
81735 Munich  
Germany



patronus

---

Von: Wolfgang Mann <wmann@ausbio.de>  
Gesendet: Mittwoch, 19. Juni 2013 07:45  
An: patronus  
Betreff: weitere Aspekte zur ersten Anmeldung  
Anlagen: Weitere Aspekte zur Anmeldung.docx

Hallo Bernhard,

Wir wollten eine Sammelanmeldung nachschieben fuer " Sample Carrier Centrifuge" vor August. Ich habe mal wesentliche Punkte aufgelistet. Mit Wolfgang Heimberg spreche ich heute, dann schicke ich evtl. Weitere Punkte nach.

Vielleicht koennen wir dann Ende der Woche telefonieren, ab naechsten Dienstag bin ich fuer 10 Tage in China.

Wolfgang

Dr. Wolfgang Mann  
CEO

---

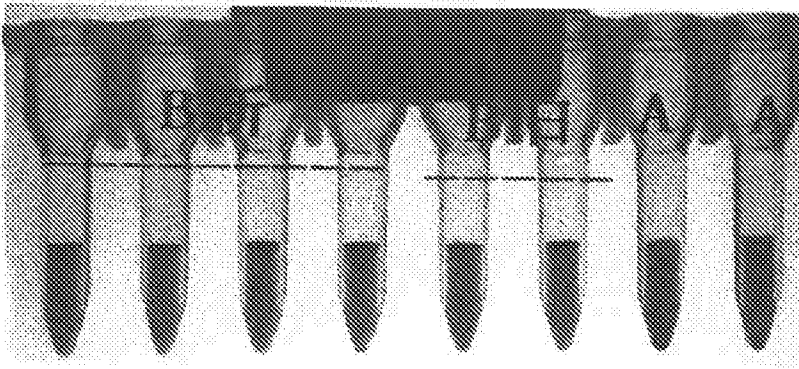
AusBio R&D Europe GmbH.  
Fritz Hornschuch Str. 9  
95326 Kulmbach  
Germany  
phone: +49(0) 9221 827628830  
mobile: +49(0) 1752206131  
e-mail: [wmann@ausbio.de](mailto:wmann@ausbio.de)



Weitere Aspekte zur Anmeldung "Sample Carrier Centrifuge"

1. Beim Zentrifugieren / Waschen von offenen Gefaessen, insbesondere Mikrotiterplatten, (96 oder 384 oder 1536 Kavitaeten) wird die Platte in horizontaler Ausrichtung in die Zentrifuge eingefuehrt. Dabei sind die Reaktionsraeume nach oben hin offen. Dann wird die Platte auf den Kopf gedreht. Dabei entleeren sich die Reaktionsraeume. Vorteilhaft ist eine schnelle Hin-und Herbewegung in dieser Position (moeglicherweise ruckartig, um dem haendischen Prozess nahezukommen) , sodass sich alle Reaktionsraeume leeren. Die Auslenkung betraegt wenige mm in beide Rotationsrichtungen. Dieser Vorgang wird zunehmend wichtig, je kleiner die Reaktionsraeume werden. Die Kapillarkraft wirkt der Schwerkraft entgegen.
2. Wenn nach dem Entleeren die letzten Reste der Fluessigkeiten per Zentrifugation entfernt werden, so besteht die Gefahr der Kontamination des Reaktionsraumes und damit die Gefahr, dass sich Material in anderen Reaktionsraeumen niederschlaegt und zu falschen Ergebnissen fuehrt. Daher muss der Reaktionsraum sehr schnell von Aerosolen befreit werden. Das kann durch einen Unterdruck passieren , Luft stroemt beim Beginn der Rotaionsbewegung zentral in den Reaktionsraum und wird peripher abgesaugt. Damit werden alle Aerosole von der Platte weg transportiert. Geschickte technische Anordnungen daefuer wird es einige geben. Sollten wir beschreiben.
3. Wenn Sedimente in Platten analysiert werden sollen, so enthaelt die Zentrifuge eine optische Einrichtung, so dass der Boden einer Mikrotiterplatte von unten analysiert werden kann.
4. Fuer bestimmte Anwendungen muss der Zentrifugenraum temperiert werden. Der Bereich kann 0-80 Grad C umfassen.
5. Gelkartensysteme (urspruengliche Idee der GelKartenzentrifuge) muessen unter bestimmten Temperaturen abgearbeitet werden. Heute stellt man sie dazu in Heizblocks (zwischen den Handlingsschritten). Wenn der Zentrifugenraum temperiert ist und der sample carrier (die Halterung fuer die GelKarte in der Zentrifuge) bewegt (geschuettelt) werden kann, dann fehlt nur noch eine Aufnahme (Bilddokumentation) nach der letzten Zentrifugation. Also sollten wir eine Zentrifuge schuetzen, die alle Funktionen enthaelt. Dann wuerde die Karte in der Zentrifuge abgearbeitet werden bis zum Foto. Robotarme waeren nur am Anfang und am Ende zum Bewegen und Positionieren notwendig. Die Zentrifuge wird zum Platz fuer die Analyse.
6. Die Karten werden heute durch spezielle Gripper angefasst und transportiert. Eine Karte, die als Aufsatz eine Vorrichtung enthaelt, die dem oberen Schaft einer Pipettenspitze enthaelt, wuerde den Gripper ueberfluessig machen. Eine solche GelKarte koennte von jedem Pipettierroboter, der Spitzen bearbeiten kann, benutzt werden. Ich hatte diesbezieglich schon einmal eine Skizze per e-mail geschickt.
7. Die Auslesung von GelKarten findet heute in transparentem Material statt. Gegenlicht bietet die besten Kontraste. Eine Karte bestehend aus 2 Komponenten (eine Haelfte weiss, damit die roten Banden der Blutkoerperchen gut gesehen werden koennen ) die Vorderseite nach wie vor transparent, damit ein Foto gemacht werden kann, ist sehr von Vorteil.

8. Wir bauen gerade eine Anbindung fuer eine Handy Camera (Android) , die statt einer 10,000CHF Version eingebaut werden soll. Dafuer waere diese Art der Karte deutlich einfacher zum lesen.  
Als Beispiel hier mal ein Bild der konventionellen Karte:



patronus

[handwritten: file?]

**From:** Wolfgang Mann <wmann@ausbio.de>  
**Sent:** Monday, July 29, 2013, 2:11 pm  
**To:** patronus  
**Subject:** Addendum

Bernhard,

I just thought of something else regarding the patent:

The vessel can also be an optical cuvette or the linear arrangement of several cuvettes in which beads are processed. After the wash steps, a reaction is initiated (e.g. chemiluminescence) and a light beam is sent through the cuvette for the detection thereof. The direction is then analogous to the reading of a gel card (i.e. horizontal light, the way a penetrating photometer (Durchstrahlphotometer) generally works). It is important to mention the geometry of the cuvette because that way quantitative assays are also included. This is because, according to the Beer-Lambert law, the geometry of the cuvette allows the concentration to be determined.

How can we include this (without exceeding 15 claims)?

Wolfgang

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IN WITNESS WHEREOF I have hereunder set my hand and seal at

Munich, February 27, 2019

Denise Giles  
Kuenstraße  
81735 Munich  
Germany



ack?

patronus

Von: Wolfgang Mann <wmann@ausbio.de>  
Gesendet: Montag, 29. Juli 2013 14:11  
An: patronus  
Betreff: Nachtrag

Bernhard,  
Mir ist noch etwas eingefallen zum Patent:  
Das Vessel kann auch eine optische Kuvette sein oder die lineare Anordnung mehrerer Kuevetten, in der beads prozessiert werden. Nach den Waschschrinen wird dann eine Reaktion initiiert (zB Chemielumineszenz), fuer deren Detektion ein Lichtstrahl durch die Kuevette geschickt wird. Die Richtung ist dann analog dem Herauslesen einer Gelkarte (also horizintales Licht wie typischerweise ein Durchstrahlphotometer funktioniert). Wichtig ist die Geometrie der Kuevette zu nennen, weil dann quantitative Assays mit erfasst sind. Die Kuevettengeometrie laesst naemlich nach Lambert Beer'schem Gesetz eine Konzentrationsbestimmung zu.

Wie bringen wr das noch unter (ohne ueber 15 Ansprueche zu kommen)?

Wolfgang

patronus

---

**From:** Wolfgang Mann <wmann@ausbio.de>  
**Sent:** Monday, June 30, 2014, 1:18 pm  
**To:** patronus  
**Cc:** Verena Doerfler  
**Subject:** RE: REMINDER: Your Ref.: Proben-träger-Zentrifuge II<sup>1</sup>; Our Ref.: AUS1003PEP

*[Translator's note: the following e-mail was already in English in the original document]*

Dear Bernhard,  
We want to follow your recommendation of a PCT.

Regards,

Wolfgang

---

**From:** patronus [mailto:patronus@patronus-ip.com]  
**Sent:** Monday, June 30, 2014 11:59 am  
**To:** wmann@ausbio.de  
**Subject:** REMINDER: Your Ref.: Proben-träger-Zentrifuge II; Our Ref.: AUS1003PEP

*[Translator's note: the following e-mail was already in English in the original document]*

FRIENDLY REMINDER

Dear Mr. Mann,

Please find enclosed our letter from June 10, 2014 and kindly let us have your instructions until

**July 7, 2014.**

**Kindly confirm safe receipt of this e-mail.**

Yours sincerely,

Yvonne NGUYEN (Ms.)  
Legal Secretary

**We moved! Our new contact details are mentioned below:**

---

Patronus IP Patent Attorneys and Lawyers  
Neumarkter Str. 18  
D-81673 München  
Germany  
Phone: +49 89 12 59 960-0  
Fax: +49 89 12 59 960-44  
E-Mail: [patronus@patronus-ip.com](mailto:patronus@patronus-ip.com)  
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**From:** patronus  
**Sent:** Tuesday, June 10, 2014 8:47 am  
**To:** wmann@ausbio.de  
**Subject:** Your reference: Proben-träger-Zentrifuge II; Our reference: AUS1003PEP; Priority

Dear Mr. Mann,

Please find enclosed our brief in the abovementioned matter.

---

<sup>1</sup> The reference translates as "Sample Carrier Centrifuge II"

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Munich, February 27, 2019

Denise Giles  
Kuenstraße  
81735 Munich  
Germany



(Denise Giles)

**patronus**

---

**Von:** Wolfgang Mann <wmann@ausbio.de>  
**Gesendet:** Montag, 30. Juni 2014 13:18  
**An:** patronus  
**Cc:** Verena Doerfler  
**Betreff:** RE: REMINDER: Your Ref.: Proben-träger-Zentrifuge II; Our Ref.: AUS1003PEP

Dear Bernhard,  
We want to follow your recommendation of a PCT.

Regards,

Wolfgang

---

**From:** patronus [mailto:patronus@patronus-ip.com]  
**Sent:** Monday, June 30, 2014 11:59 AM  
**To:** wmann@ausbio.de  
**Subject:** REMINDER: Your Ref.: Proben-träger-Zentrifuge II; Our Ref.: AUS1003PEP

**FRIENDLY REMINDER**

Dear Mr. Mann,

Please find enclosed our letter from June 10, 2014 and kindly let us have your instructions until

**July 7, 2014.**

**Kindly confirm safe receipt of this e-mail.**

Yours sincerely

Yvonne NGUYEN (Ms.)  
Legal Secretary

**We moved! Our new contact details are mentioned below:**

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Patronus IP Patent Attorneys and Lawyers  
Neumarkter Str. 18  
D-81673 München  
Germany  
Phone: +49 89 12 59 980-0  
Fax: +49 89 12 59 980-44  
E-Mail: [patronus@patronus-ip.com](mailto:patronus@patronus-ip.com)  
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**Von:** patronus  
**Gesendet:** Dienstag, 10. Juni 2014 08:47  
**An:** wmann@ausbio.de  
**Betreff:** Ihr Zeichen: Proben-träger-Zentrifuge II; Unser Zeichen: AUS1003PEP; Priorität

Sehr geehrter Herr Dr. Mann,

anbei senden wir Ihnen unser Schreiben in o. g. Sache.

Exhibit 24

1 Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/940,681

PATENT

Page 3 of 3

REEL: 049669 FRAME: 0212



patronus

---

**From:** Wolfgang Mann <wmann@ausbio.de>  
**Sent:** Friday, August 1, 2014, 4:38 am  
**To:** Bernhard Ganahl  
**Subject:** RE: Protocol for AusRod System.ppt<sup>1</sup>

I've asked and thought about it myself. That should be new. Johnson is looking through patents himself, but we can probably include this and proceed as you suggested.

I will know whether the Chinese found anything on Monday.

w.

---

**From:** Bernhard Ganahl [mailto:ganahl@patronus-ip.com]  
**Sent:** Thursday, July 31, 2014 6:15 pm  
**To:** Wolfgang Mann  
**Subject:** AW: Protocol for AusRod System.ppt

Hello Wolfgang,

In your email dated July 31, you said that the rod can be held by vacuum with the pipetting device of the Hamilton Robot. Are these rods already known? Is holding the rod by means of vacuum with a pipette tip already known. If this is new, we will include this in both AUS1003PWO (=PCT application for washing by means of a centrifuge) as well as in the new application AUS1009EP (Handling of various parts by means of a pipette tip). In this case, we should file both applications on the same day!!!

Regards,

Bernhard

Kind regards,

Bernhard Ganahl  
Patent Attorney

---

Patronus IP Patent- und Rechtsanwälte GbR

**Please note our new address in Munich, which is valid from April 1, 2014:**

Neumärkter Str. 18	Rudolfskai 48
81673 Munich	5020 Salzburg
Germany	Austria
Tel.: +49 89 1259960-0	+43 662 844 289
Fax: +49 89 1259960-44	+43 662 845 303

E-Mail: [patronus@patronus-ip.com](mailto:patronus@patronus-ip.com)  
VAT-ID: DE286847207  
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---

<sup>1</sup> Translator's note: The subjects of both e-mails were already in English in the original document.

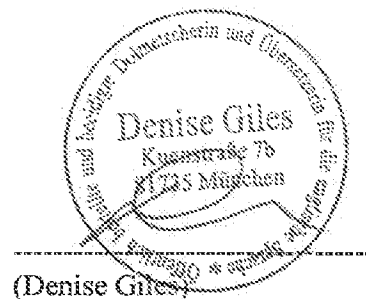
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IN WITNESS WHEREOF I have hereunder set my hand and seal at

Munich, February 27, 2019

Denise Giles  
Kuenstraße  
81735 Munich  
Germany



**patronus**

---

**Von:** Wolfgang Mann <wmann@ausbio.de>  
**Gesendet:** Freitag, 1. August 2014 04:38  
**An:** Bernhard Ganahl  
**Betreff:** RE: Protocol for AusRod System.ppt

Habe nachgefragt und selbst ueberlegt. Das sollte neu sein. Johnson schaut selbst Patente durch aber wahrscheinlich koennen wir das mit dazunehmen und so machen wie du vorschlaegst.

Am Montag kann ich sagen, ob die Chinesen etwas gefunden haben.

w.

---

**From:** Bernhard Ganahl [mailto:ganahl@patronus-ip.com]  
**Sent:** Thursday, July 31, 2014 06:15 PM  
**To:** Wolfgang Mann  
**Subject:** AW: Protocol for AusRod System.ppt

Hallo Wolfgang,

in Deiner email vom 31. Juli hast Du gemeint, dass mit der Pipettiereinrichtung des Hamilton Robot per Vakuum das Rod gehalten werden kann. Sind diese Rods schon bekannt? Ist das halten der Rods mittels Vakuum über eine Pipettenspitze schon bekannt. Wenn das neu ist, dann nehmen wir das sowohl in die AUS1003PWO (=PCT-Anmeldung zum Waschen mittels Zentrifuge) als auch in die neue Anmeldung AUS1009EP (Handling von diversen Teilen mittels Pipettenspitze) auf. Wir sollten dann beide Anmeldungen am selben Tag einreichen!!!

Gruss,

Bernhard

Mit freundlichen Grüßen

Bernhard Ganahl  
Patentanwalt

---

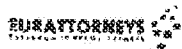
Patronus IP Patent- und Rechtsanwälte GbR

**Bitte unsere neue Adresse in München beachten, die ab dem 1. April 2014 gilt:**

Neumarkter Str. 18  
81673 München  
Deutschland  
Tel.: +49 89 1259960-0  
Fax: +49 89 1259960-44

Rudolfskai 48  
5020 Salzburg  
Österreich  
+43 662 844 289  
+43 662 845 303

E-Mail: [patronus@patronus-ip.com](mailto:patronus@patronus-ip.com)  
VAT-ID: DE286847207  
Member of EURATTORNEYS \*  
[www.eurattorneys.com](http://www.eurattorneys.com)



patronus

---

**From:** Wolfgang Mann <wmann@ausbio.de>  
**Sent:** Thursday, August 7, 2014, 2:41 pm  
**To:** patronus  
**Subject:** RE: Our Ref.: AUS1003PWO; "Centrifuge and Method for Centrifuging a Reaction Vessel Unit"<sup>1</sup>

As regards invoicing:  
Please use the following address

AusBio Laboratories Co., Ltd  
No.2 Huanshan Road, YEDA  
Yantai 264006, P.R. China

[handwritten: check mark] [handwritten: entered]

If it is sent to Kulmbach with the other documents by mail, that is ok. It is not necessary to send original copies to China.

Regards,

Wolfgang Mann

[Translator's note: The following e-mail was already in English in the original document]

---

**From:** patronus [mailto:patronus@patronus-ip.com]  
**Sent:** Thursday, August 7, 2014, 12:59 pm  
**To:** wmann@ausbio.de  
**Subject:** Our Ref.: AUS1003PWO; "Centrifuge and Method for Centrifuging a Reaction Vessel Unit"

Dear Mr. Mann,

We would like to inform you that we have filed the application in the name of AusBio R&D Europe GmbH and AusBio Laboratories Co., Ltd. With the European Patent Office on **August 6, 2014**.

The official reference is **PCT/EP2014/066947**.

Our detailed filing report together with our invoice will follow soon.

Kindly confirm safe receipt of this e-mail.

Yours sincerely

Yvonne NGUYEN (Ms.)  
Legal Secretary

**We moved! Our new contact details are mentioned below:**

---

Patronus IP Patent Attorneys and Lawyers  
Neumarkter Str. 18  
D-81673 München<sup>2</sup>  
Germany  
Phone: +49 89 12 59 960-0  
Fax: +49 89 12 59 960-44  
E-Mail: [patronus@patronus-ip.com](mailto:patronus@patronus-ip.com)  
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---

<sup>1</sup> Translator's note: The subject was already in English in the original document.

<sup>2</sup> Translator's note: "München" was the only German word used in this e-mail; it translates as "Munich".


## ATTESTATION CLAUSE:

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IN WITNESS WHEREOF I have hereunder set my hand and seal at

Munich, February 27, 2019

Denise Giles  
Kuenstraße  
81735 Munich  
Germany



Denise Giles  
Kuenstraße 7b  
81735 München

(Denise Giles)

patronus

---

Von: Wolfgang Mann <wmann@ausbio.de>  
Gesendet: Donnerstag, 7. August 2014 14:41  
An: patronus  
Betreff: RE: Our Ref.: AUS1003PWO; "Centrifuge and Method for Centrifuging a Reaction Vessel Unit"

Wegen der Rechnungsstellung:  
Koennen Sie bitte folgende Anschrift verwenden

AusBio Laboratories Co., Ltd  
No.2 Huanshan Road, YEDA  
Yantai 264006, P.R.China

*Wangjefl.*

Wenn das mit den anderen Unterlagen per Post nach Kulmbach kommt, ist das ok. Originale nach China zu schicken ist nicht notwendig.

Gruss,

Wolfgang Mann

---

From: patronus [mailto:patronus@patronus-ip.com]  
Sent: Thursday, August 07, 2014 12:59 PM  
To: wmann@ausbio.de  
Subject: Our Ref.: AUS1003PWO; "Centrifuge and Method for Centrifuging a Reaction Vessel Unit"

Dear Mr. Mann,

We would like to inform you that we have filed the application in the name of AusBio R&D Europe GmbH and AusBio Laboratories Co., Ltd. with the European Patent Office on August 6, 2014.

The official reference is PCT/EP2014/066947.

Our detailed filing report together with our invoice will follow soon.

Kindly confirm safe receipt of this e-mail.

Yours sincerely

Yvonne NGUYEN (Ms.)  
Legal Secretary

**We moved! Our new contact details are mentioned below:**

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**patronus**

---

**From:** Wolfgang Mann <wmann@ausbio.de>  
**Sent:** Tuesday, August 6, 2013, 6:16 pm  
**To:** Bernhard Ganahl  
**Subject:** RE: EP-7418

Thank you.

The invoice is to be addressed to Germany.

Wolfgang

---

**From:** Bernhard Ganahl [<mailto:ganahl@patronus-ip.com>]  
**Sent:** Tuesday, August 6, 2013, 11:12 pm  
**To:** [wmann@ausbio.de](mailto:wmann@ausbio.de)  
**Cc:** Wolfgang Heimberg  
**Subject:** EP-7418

Hello Wolfgang,

We filed the application today. Please find attached the application version and the acknowledgment of receipt.

Is the invoice to be addressed to AusBio Deutschland or are the costs being shared with AusBio China?

Regards,

Bernhard

Bernhard Ganahl  
Patent Attorney

---

Patronus IP Patent- und Rechtsanwälte GbR

Truderinger Str. 246	Rudolfskai 48
81825 Munich	5020 Salzburg
Germany	Austria
Tel.: +49 89 43 77 88 65	+43 662 844 289
Fax: +49 89 43 77 88 66	+43 662 845 303

E-Mail: [patronus@patronus-ip.com](mailto:patronus@patronus-ip.com)

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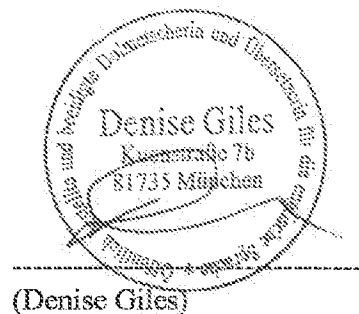
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Munich, February 27, 2019

Denise Giles  
Kuenstraße  
81735 Munich  
Germany





**patronus**

---

**Von:** Wolfgang Mann <wmann@ausbio.de>  
**Gesendet:** Dienstag, 6. August 2013 18:16  
**An:** Bernhard Ganahl  
**Betreff:** RE: EP-7418

Danke dir.

Die Rechnung geht an Deutschland.

Wolfgang

---

**From:** Bernhard Ganahl [<mailto:ganahl@patronus-ip.com>]  
**Sent:** Tuesday, August 06, 2013 11:12 PM  
**To:** [wmann@ausbio.de](mailto:wmann@ausbio.de)  
**Cc:** Wolfgang Heimberg  
**Subject:** EP-7418

Hallo Wolfgang,

wir haben heute die Anmeldung eingereicht. Anliegend die Anmeldefassung und die Empfangsbescheinigung.

Geht die Rechnung an AusBio Deutschland oder werden die Kosten mit der AusBio China geteilt?

Gruss,

Bernhard

Bernhard Ganahl  
Patentanwalt

---

Patronus IP Patent- und Rechtsanwälte GbR

Truderinger Str. 246	Rudolfskai 48
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patronus

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**From:** Wolfgang Mann <wmann@ausbio.de>  
**Sent:** Thursday, August 7, 2014, 2:41 pm  
**To:** patronus  
**Subject:** RE: Our Ref.: AUS1003PWO; "Centrifuge and Method for Centrifuging a Reaction Vessel Unit"<sup>1</sup>

As regards invoicing:  
Please use the following address

AusBio Laboratories Co., Ltd  
No.2 Huanshan Road, YEDA  
Yantai 264006, P.R. China

[handwritten: check mark] [handwritten: entered]

If it is sent to Kulmbach with the other documents by mail, that is ok. It is not necessary to send original copies to China.

Regards,

Wolfgang Mann

[Translator's note: The following e-mail was already in English in the original document]

---

**From:** patronus [mailto:patronus@patronus-ip.com]  
**Sent:** Thursday, August 7, 2014, 12:59 pm  
**To:** wmann@ausbio.de  
**Subject:** Our Ref.: AUS1003PWO; "Centrifuge and Method for Centrifuging a Reaction Vessel Unit"

Dear Mr. Mann,

We would like to inform you that we have filed the application in the name of AusBio R&D Europe GmbH and AusBio Laboratories Co., Ltd. With the European Patent Office on **August 6, 2014**.

The official reference is **PCT/EP2014/066947**.

Our detailed filing report together with our invoice will follow soon.

Kindly confirm safe receipt of this e-mail.

Yours sincerely

Yvonne NGUYEN (Ms.)  
Legal Secretary

**We moved! Our new contact details are mentioned below:**

---

Patronus IP Patent Attorneys and Lawyers  
Neumarkter Str. 18  
D-81673 München<sup>2</sup>  
Germany  
Phone: +49 89 12 59 960-0  
Fax: +49 89 12 59 960-44  
E-Mail: [patronus@patronus-ip.com](mailto:patronus@patronus-ip.com)  
Member of EURATTORNEYS \*  
[www.eurattorneys.com](http://www.eurattorneys.com)

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<sup>1</sup> Translator's note: The subject was already in English in the original document.

<sup>2</sup> Translator's note: "München" was the only German word used in this e-mail; it translates as "Munich".


## ATTESTATION CLAUSE:

In my capacity as a translator for the English language, duly appointed, commissioned and sworn in by the Munich Regional Court I in the German federal state of Bavaria, I hereby certify to the best of my belief that the foregoing is a true and complete English translation of the original document in the German language submitted to me as a copy.

IN WITNESS WHEREOF I have hereunder set my hand and seal at

Munich, February 27, 2019

Denise Giles  
Kuenstraße  
81735 Munich  
Germany



(Denise Giles)

patronus

---

Von: Wolfgang Mann <wmann@ausbio.de>  
Gesendet: Donnerstag, 7. August 2014 14:41  
An: patronus  
Betreff: RE: Our Ref.: AUS1003PWO; "Centrifuge and Method for Centrifuging a Reaction Vessel Unit"

Wegen der Rechnungsstellung:  
Koennen Sie bitte folgende Anschrift verwenden

AusBio Laboratories Co., Ltd  
No.2 Huanshan Road, YEDA  
Yantai 264006, P.R.China

*See page 11.*

Wenn das mit den anderen Unterlagen per Post nach Kulmbach kommt, ist das ok. Originale nach China zu schicken ist nicht notwendig.

Gruss,

Wolfgang Mann

---

From: patronus [mailto:patronus@patronus-ip.com]  
Sent: Thursday, August 07, 2014 12:59 PM  
To: wmann@ausbio.de  
Subject: Our Ref.: AUS1003PWO; "Centrifuge and Method for Centrifuging a Reaction Vessel Unit"

Dear Mr. Mann,

We would like to inform you that we have filed the application in the name of AusBio R&D Europe GmbH and AusBio Laboratories Co., Ltd. with the European Patent Office on August 6, 2014.

The official reference is PCT/EP2014/066947.

Our detailed filing report together with our invoice will follow soon.

Kindly confirm safe receipt of this e-mail.

Yours sincerely

Yvonne NGUYEN (Ms.)  
Legal Secretary

**We moved! Our new contact details are mentioned below:**

---

Patronus IP Patent Attorneys and Lawyers  
Neumarkter Str. 18  
D-81673 München  
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[www.eurattorneys.com](http://www.eurattorneys.com)

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### DECLARATION OF BERNHARD GANAHL

I, Bernhard Ganahl (hereinafter "Declarant"), having personal knowledge of the facts stated herein, and being of legal age and sound mind and memory, do hereby declare as follows:

1. I served as patent counsel for AusBio R&D Europe GmbH (hereinafter: "AusBio Europe") and Yantai AusBio Laboratories Co., Ltd. No. 2 Huashan Road, Yeda 264006, Yantai, China (hereinafter: "AusBio Yantai"), at the time of filing of the EP application No 13179437.2 (hereinafter: "EP Application") and the PCT application No. PCT/EP2014/066947 (hereinafter: "PCT Application").
2. Dr. Wolfgang Mann instructed me to file the EP Application and the PCT Application in the name of AusBio Europe and AusBio Yantai.
3. Dr. Wolfgang Heimberg knew of the filing of the EP Application (No. 13179437.2) in the name of AusBio Europe and AusBio Yantai prior to its filing.

I, the above-named Declarant, hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the

knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States.

Executed on this 25<sup>th</sup> day of February, 2019.

  
Bernhard Ganahl

**PCT REQUEST**

Print Out (Original in Electronic Form)

<b>0</b>	<b>For receiving Office use only</b>	
<b>0-1</b>	International Application No.	<b>PCT/EP2014/066947</b>
<b>0-2</b>	International Filing Date	<b>06 AUG 2014 (06.08.2014)</b>
<b>0-3</b>	Name of receiving Office and "PCT International Application"	<b>RO/EP</b>
<b>0-4</b>	<b>Form PCT/RO/101 PCT Request</b>	
<b>0-4-1</b>	Prepared Using	<b>PCT Online Filing Version 3.5.000.235 MT/FOP 20020701/0.20.5.20</b>
<b>0-5</b>	<b>Petition</b> The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty	
<b>0-6</b>	<b>Receiving Office (specified by the applicant)</b>	<b>European Patent Office (EPO) (RO/EP)</b>
<b>0-7</b>	<b>Applicant's or agent's file reference</b>	<b>AUS1003PWO</b>
<b>I</b>	<b>Title of Invention</b>	<b>Centrifuge and Method for Centrifuging a Reaction Vessel Unit</b>
<b>II</b>	<b>Applicant</b>	
<b>II-1</b>	This person is	<b>Applicant only</b>
<b>II-2</b>	Applicant for	<b>All designated States</b>
<b>II-4</b>	Name	<b>AusBio Laboratories Co., Ltd.</b>
<b>II-5</b>	Address	<b>No. 2 Huashan Road, Yeda Yantai, Shandong, China</b>
<b>II-6</b>	State of nationality	<b>CN*                      *RO/EP</b>
<b>II-7</b>	State of residence	<b>CN</b>
<b>III-1</b>	<b>Applicant and/or inventor</b>	
<b>III-1-1</b>	This person is	<b>Applicant only</b>
<b>III-1-2</b>	Applicant for	<b>All designated States</b>
<b>III-1-4</b>	Name	<b>AusBio R&amp;D Europe GmbH</b>
<b>III-1-5</b>	Address	<b>Fritz Hornschuch Straße 9 95326 Kulmbach Germany</b>
<b>III-1-6</b>	State of nationality	
<b>III-1-7</b>	State of residence	<b>DE</b>

## PCT REQUEST

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<b>III-2</b>	<b>Applicant and/or inventor</b>	
III-2-1	This person is	<b>Inventor only</b>
III-2-3	Inventor for	
III-2-4	Name (LAST, First)	<b>MANN, Wolfgang</b>
III-2-5	Address	<b>Hornungsreuth 22a 95512 Hornungsreuth Germany</b>
<b>III-3</b>	<b>Applicant and/or inventor</b>	
III-3-1	This person is	<b>Inventor only</b>
III-3-3	Inventor for	
III-3-4	Name (LAST, First)	<b>WANG, Zhaoqiang</b>
III-3-5	Address	<b>No. 2 Huashan Road Yantai, 246006 China</b>
<b>IV-1</b>	<b>Agent or common representative; or address for correspondence</b>	
	The person identified below is hereby/ has been appointed to act on behalf of the applicant(s) before the competent International Authorities as:	<b>Agent</b>
IV-1-1	Name	<b>PATRONUS IP Patent- und Rechtsanwälte</b>
IV-1-2	Address	<b>Neumarkter Str. 18 81673 München Germany</b>
IV-1-3	Telephone No.	<b>089/12599600</b>
IV-1-4	Facsimile No.	<b>089/125996044</b>
IV-1-5	e-mail	<b>patronus@patronus-ip.com</b>
<b>V</b>	<b>DESIGNATIONS</b>	
<b>V-1</b>	<b>The filing of this request constitutes under Rule 4.9(a), the designation of all Contracting States bound by the PCT on the international filing date, for the grant of every kind of protection available and, where applicable, for the grant of both regional and national patents.</b>	
<b>VI-1</b>	<b>Priority claim of earlier regional application</b>	
VI-1-1	Filing date	<b>06 August 2013 (06.08.2013)</b>
VI-1-2	Number	<b>13179437.2</b>
VI-1-3	Regional Office	<b>EP</b>



## PCT REQUEST

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<b>VI-2</b>	<b>Incorporation by reference :</b> where an element of the international application referred to in Article 11(1)(iii)(d) or (e) or a part of the description, claims or drawings referred to in Rule 20.5(a) is not otherwise contained in this international application but is completely contained in an earlier application whose priority is claimed on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, that element or part is, subject to confirmation under Rule 20.6, incorporated by reference in this international application for the purposes of Rule 20.6.		
<b>VII-1</b>	<b>International Searching Authority Chosen</b>	<b>European Patent Office (EPO) (ISA/EP)</b>	
<b>VIII</b>	<b>Declarations</b>	Number of declarations	
VIII-1	Declaration as to the identity of the inventor	—	
VIII-2	Declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent	—	
VIII-3	Declaration as to the applicant's entitlement, as at the international filing date, to claim the priority of the earlier application	—	
VIII-4	Declaration of inventorship (only for the purposes of the designation of the United States of America)	—	
VIII-5	Declaration as to non-prejudicial disclosures or exceptions to lack of novelty	—	
<b>IX</b>	<b>Check list</b>	Number of sheets	Electronic file(s) attached
IX-1	Request (including declaration sheets)	<b>4</b>	✓
IX-2	Description	<b>28</b>	✓
IX-3	Claims	<b>4</b>	✓
IX-4	Abstract	<b>1</b>	✓
IX-5	Drawings	<b>18</b>	✓
IX-7	TOTAL	<b>55</b>	
	<b>Accompanying Items</b>	Paper document(s) attached	Electronic file(s) attached
IX-8	Fee calculation sheet	—	✓
IX-18	PCT-SAFE physical media	—	—
<b>IX-20</b>	<b>Figure of the drawings which should accompany the abstract</b>		
<b>IX-21</b>	<b>Language of filing of the international application</b>	<b>English</b>	

**PCT REQUEST**

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<b>X-1</b>	<b>Signature of applicant, agent or common representative</b>	<b>(PKCS7 Digital Signature)</b>
<b>X-1-1</b>	Name	<b>AusBio Laboratories Co., Ltd.</b>
<b>X-1-2</b>	Name of signatory	<b>Bernhard Ganahl 33788</b>
<b>X-1-3</b>	Capacity (if such capacity is not obvious from reading the request)	<b>(Applicant)</b>

**FOR RECEIVING OFFICE USE ONLY**

<b>10-1</b>	<b>Date of actual receipt of the purported international application</b>	<b>06 AUG 2014 (06.08.2014)</b>
<b>10-2</b>	<b>Drawings:</b>	<b>✓</b>
<b>10-2-1</b>	Received	
<b>10-2-2</b>	<del>Not received</del>	
<b>10-3</b>	<b>Corrected date of actual receipt due to later but timely received papers or drawings completing the purported international application</b>	
<b>10-4</b>	<b>Date of timely receipt of the required corrections under PCT Article 11(2)</b>	
<b>10-5</b>	<b>International Searching Authority</b>	<b>ISA/EP</b>
<b>10-6</b>	<b>Transmittal of search copy delayed until search fee is paid</b>	

**FOR INTERNATIONAL BUREAU USE ONLY**

<b>11-1</b>	<b>Date of receipt of the record copy by the International Bureau</b>	
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## Request for grant of a European patent

<i>For official use only</i>		
1 Application number:	<input type="text" value="MKEY"/>	MKEY - EP13179437.2
2 Date of receipt (Rule 35(2) EPC):	<input type="text" value="DREC"/>	DREC - 06 Aug 2013
3 Date of receipt at EPO (Rule 35(4) EPC):	<input type="text" value="RENA"/>	
4 Date of filing:		

5 Grant of European patent, and examination of the application under Article 94, are hereby requested. ☒

5.1 The applicant waives his right to be asked whether he wishes to proceed further with the application (Rule 70(2)) ☐

Procedural language:

Description and/or claims filed in:

6 Applicant's or representative's reference

### Applicant 1

7-1 Name: AusBio R&D Europe GmbH  
8-1 Address: Fritz Hornschuch Straße 9  
95326 Kulmbach  
Germany  
10-1 State of residence or of principal place of business: Germany

### Applicant 2

7-2 Name: AusBio Laboratories Co., Ltd.  
8-2 Address: No. 2 Huashan Road,  
Yeda Yantai, Shandong  
China  
10-1 State of residence or of principal place of business: China

**Representative 1**

15-1

Name:

PATRONUS IP Patent- und Rechtsanwälte

16-1

Address of place of business:

Truderinger Str. 246  
81825 München  
Germany

17-1

Telephone:

089/43778865

17-1

Fax:

089/43778866

17-1

e-mail:

patronus@patronus-ip.com

**Inventor(s)**

24 Title of invention

Title of invention:

Centrifuge and Method for Centrifuging a  
Reaction Vessel Unit

25 Declaration of priority (Rule 52)

A declaration of priority is hereby made for the following applications

25.2 This application is a complete translation of the previous application

☐

25.3 It is not intended to file a (further) declaration of priority

☐

26 Reference to a previously filed application

27 Divisional application

☐

28 Article 61(1)(b) application

☐

29 Claims

Number of claims:

15

29.1

☒

as attached

29.2

☐

as in the previously filed application (see Section 26.2)

29.3

☐

The claims will be filed later

30 Figures

It is proposed that the abstract be published together with figure No.

12

**31 Designation of contracting states**

All the contracting states party to the EPC at the time of filing of the European patent application are deemed to be designated (see Article 79(1)).

**32 Different applicants for different contracting states**

**33 Extension of the European patent**

This application is deemed to be a request to extend the European patent application and the European patent granted in respect of it to all non-contracting states to the EPC with which extension agreements are in force on the date on which the application is filed. However, the request is deemed withdrawn if the extension fee is not paid within the prescribed time limit.

- 33.1** It is currently intended to pay the extension fee(s) for the following states:

**34 Biological material**

**38 Nucleotide and amino acid sequences**

The European patent application contains a sequence listing as part of the description

☐

The sequence listing is attached in computer-readable format in accordance with WIPO Standard ST.25

☐

The sequence listing is attached in PDF format

☐

**Further indications**

- 39** Additional copies of the documents cited in the European search report are requested

Number of additional sets of copies:

- 40** Refund of the search fee under to Article 9 of the Rules relating to Fees is requested

☐

Application or publication number of earlier search report:

**42 Payment**

Mode of payment

Debit from deposit account

The European Patent Office is hereby authorised, to debit from the deposit account with the EPO any fees and costs indicated on the fees section below.

Currency:

EUR

Deposit account number:

28001934

Account holder:

PATRONUS IP Patent- und Rechtsanwälte

**43 Refunds**

Any refunds should be made to EPO deposit account:

28001934

Account holder:

PATRONUS IP Patent- und Rechtsanwälte

<b>Fees</b>	Factor applied	Fee schedule	Amount to be paid
001 Filing fee - EP direct - online	1	115.00	115.00
002 Fee for a European search - Applications filed on/after 01.07.2005	1	1 165.00	1 165.00
015 Claims fee - For the 16th to the 50th claim	0	225.00	0.00
015e Claims fee - For the 51st and each subsequent claim	0	555.00	0.00
501 Additional filing fee for the 36th and each subsequent page	7	14.00	98.00
<b>Total:</b>		<b>EUR</b>	<b>1 378.00</b>

**44-A Forms**

Details:

System file name:

A-1

Request

as ep-request.pdf

**44-B Technical documents**

Original file name:

System file name:

B-1

Specification

Specification.pdf

Description; 15 claims; 16 figure(s); abstract

SPECEPO-1.pdf

**44-C Other documents**

Original file name:

System file name:

45

General authorisation:

**46 Signature(s)**

Place:

München

Date:

06 August 2013

Signed by:

, Bernhard Ganahl 33788

Capacity:

(Applicant: AusBio R&amp;D Europe GmbH )

Function of person signing:

Patentanwalt

## Oberlandesgericht Düsseldorf, I-2 U 39/12

**Datum:** 28.02.2014  
**Gericht:** Oberlandesgericht Düsseldorf  
**Spruchkörper:** 2. Zivilsenat  
**Entscheidungsart:** Urteil  
**Aktenzeichen:** I-2 U 39/12  
**ECLI:** ECLI:DE:OLGD:2014:0228.I2U39.12.00

**Vorinstanz:** Landgericht Düsseldorf, 4b O 43/11

**Tenor:** I. Auf die Berufung der Klägerin wird das am 22. März 2012 verkündete Urteil der 4b Zivilkammer des Landgerichts Düsseldorf teilweise abgeändert. Der Beklagte wird – über den Ausspruch zu I. des landgerichtlichen Urteils hinaus – verurteilt, den Anspruch auf Erteilung des deutschen Patents DE 2010 0128XX.X und die Rechte aus der deutschen Patentanmeldung DE 2010 0128XX.X an die Klägerin abzutreten.

II.

Der Beklagte ist des eingelegten Rechtsmittels der Berufung verlustig, nachdem er seine Berufung gegen das vorbezeichnete Urteil des Landgerichts Düsseldorf zurückgenommen hat.

III.

Die Kosten des Rechtsstreits erster und zweiter Instanz hat der Beklagte zu tragen.

IV.

Das Urteil ist vorläufig vollstreckbar. Dem Beklagten wird nachgelassen, die Zwangsvollstreckung der Klägerin durch Sicherheitsleistung in Höhe von 375.000,00 EUR abzuwenden, falls nicht die Klägerin zuvor Sicherheit in gleicher Höhe leistet.

V.

Die Revision wird nicht zugelassen.

VI.

Der Streitwert für das Berufungsverfahren wird für die Zeit bis zum 18. Dezember 2013 auf 500.000,00 EUR, wovon auf die Berufung der Klägerin 375.000,00 EUR und auf die Berufung des Beklagten 125.000,00 EUR entfallen, und für die Zeit danach auf 375.000,00 EUR festgesetzt.

### Gründe:

Exhibit 32

1

Petition Pursuant to 37 CFR 1.46(B)(2)

Festbrennstofffeuerungsanlage zur Erzeugung von thermischer Energie zu verwenden.

2. Der Klägerin steht ein sich aus dem Gesellschaftsverhältnis ergebender Anspruch auf Abtretung der Rechte aus der diese Erfindung betreffenden deutschen Patentanmeldung DE 2010 0128XX.X gegen den Beklagten als ihren Gesellschafter und früheren Geschäftsführer zu, weil die Erfindung erst nach der Gründung der Klägerin in ihrem Unternehmensbereich im Zuge der Entwicklung und des Aufbaus der gemeinsam geplanten Ölmühle zustande gekommen ist. Im Einzelnen gilt Folgendes:

66

a) Es ist anerkannt, dass sich aus dem Geschäftsführeranstellungsvertrag eine Pflicht des Geschäftsführers ergeben kann, seine Erfindung der Gesellschaft zu überlassen – sei es im Sinne einer vollständigen Rechtsübertragung, sei es im Sinne der Einräumung einer einfachen oder ausschließlichen Lizenz (Senat, GRUR 2000, 49, 50 – Geschäftsführer-Erfindung). Sofern der Geschäftsführervertrag keine ausdrücklichen Regelungen zur Anbieterspflicht des Geschäftsführers (und dementsprechend korrespondierend zum Übernahmeanspruch der Gesellschaft) enthält, ist nach den Grundsätzen der ergänzenden Vertragsauslegung der hypothetische Parteiwille zu erforschen. Zu berücksichtigen sind insoweit die gesamten Umstände des Falles (Senat, GRUR 2000, 49, 50 – Geschäftsführer-Erfindung; Bartenbach/Volz, ArbNErfG, 5. Aufl., § 1 Rdnr. 72). Für eine Anbieters- und Übertragungspflicht spricht es dabei, wenn der Geschäftsführer nach dem Inhalt des Anstellungsvertrages für den technischen Bereich eingesetzt ist, ggf. sogar mit dem erklärten Ziel, auf technische Neuerungen bedacht zu sein, und die Erfindung überwiegend auf Mitteln, Erfahrungen und Vorarbeiten des Unternehmens beruht (vgl. Senat, GRUR 2000, 49, 50 – Geschäftsführer-Erfindung; Bartenbach/Volz, a.a.O., § 1 Rdnr. 74; Bartenbach/Fock, GRUR 2005, 384, 385 jew. m. w. Nachw.). Besteht eine vertragliche Anbieterspflicht des Geschäftsführers, ist des Weiteren zu klären, ob die Übertragung unentgeltlich verlangt werden kann oder ob die Gesellschaft, wenn sie die Erfindung übernimmt, hierfür eine besondere Erfindervergütung zu zahlen hat (Senat, GRUR 2000, 49, 50 – Geschäftsführer-Erfindung). Letzteres ist regelmäßig der Fall, wenn es sich bei der Erfindung um eine überobligationsmäßige (und deshalb durch die vereinbarten Geschäftsführerbezüge noch nicht abgegoltene) Sonderleistung handelt (Senat, GRUR 2000, 49, 50 – Geschäftsführer-Erfindung). Im Allgemeinen ist insoweit davon auszugehen, dass der Geschäftsführer nicht selbst verpflichtet ist, sich um die Entwicklung technischer Neuerungen zu bemühen (Senat, GRUR 2000, 49, 50 – Geschäftsführer-Erfindung). Entsprechend seiner Stellung als Organ der Gesellschaft hat er vielmehr (lediglich) die erforderlichen organisatorischen Maßnahmen dafür zu treffen, dass in dem ihm unterstellten Aufgaben- und Verantwortungsbereich die personellen und sachlichen Voraussetzungen für angestrebte Innovationen gegeben sind. Seine dienstvertragliche Pflicht ist es, die obersten Leitungsfunktionen des Unternehmens wahrzunehmen, d. h. die Gesellschaft nach außen zu vertreten und die Bedingungen für die Verwirklichung des Unternehmenszwecks zu gewährleisten. Eigene Erfindungen liegen mit Rücksicht darauf in der Regel außerhalb des Bereichs der Geschäftsführerplichten und stellen dementsprechend vergütungspflichtige Sonderleistungen dar (Senat, GRUR 2000, 49, 50 – Geschäftsführer-Erfindung; Urteil vom 08.06.2006 – I-2 U 28/05, NJOZ 2007, 1583, 1586; LG Düsseldorf, Entscheidungen 1, 3, 7 f. – Ozonerzeuger; Urteil v. 10.02.2005 – 4a 150/04, juris Rz. 33). Sind allerdings dem Geschäftsführer kraft Anstellungsvertrages z. B. eigene Forschungs- und Entwicklungstätigkeiten zugewiesen, so ist die Erfindung keine überobligationsmäßige Sonderleistung, sondern das Resultat der vertraglich geschuldete Dienstleistung und folglich bereits durch die vereinbarten Geschäftsführerbezüge honoriert (Senat, GRUR 2000, 49, 50 f. – Geschäftsführer-Erfindung; Bartenbach/Fock, GRUR 2005, 384, 386 f.). Eine Pflicht, die Erfindung der Gesellschaft unentgeltlich anzubieten und zu überlassen, besteht demgemäß regelmäßig dann, wenn dem Geschäftsführer nach dem Anstellungsvertrages Forschungs- und Entwicklungstätigkeiten zugewiesen sind (Senat, GRUR 2000, 49, 50 f. – Geschäftsführer-Erfindung). Maßgebend sind aber jeweils die Umstände des Einzelfalles. Fehlt es an einer ausdrücklichen Regelung, bieten vor allem der Sinn des betreffenden Dienstverhältnisses oder der Zweck der den Geschäftsführer anstellenden Gesellschaft, die vom Geschäftsführer in der Gesellschaft im Einzelnen übernommenen Funktionen, seine Treuepflicht der Gesellschaft gegenüber sowie die rechtliche Behandlung früherer Erfindungen taugliche Anhaltspunkte für das mit der

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Petition Pursuant to 37 CFR 1.46(B)(2)



Anstellung tatsächlich als gewollt Erklärte (vgl. BGH, GRUR 2000, 788, 790 – Gleichstromsteuerschaltung; GRUR 1955, 286, 289 – Schnellkopiergerät; GRUR 1965, 302, 304 – Schellenreibungskupplung; Jestaedt, FS für Rudolf Nirk, 1992, 493, 500 f.).

Die vorstehenden Rechtsgrundsätze gelten sinngemäß auch für Gesellschafter (Bartenbach/Volz, a.a.O., § 1 Rdnr. 74; vgl. a. Benkard/Melullis, PatG/GebrMG, 10. Aufl., § 6 PatG Rdnr. 27e). So kann für eine Pflicht des Gesellschafters zur Übertragung einer Erfindung sprechen, dass er für den technischen Bereich verantwortlich ist oder auch dort eingesetzt wurde, ggf. sogar mit dem Ziel, auf technische Neuerungen bedacht zu sein (vgl. Bartenbach/Volz, a.a.O., § 1 Rdnr. 74). Ebenso kann der Sinn und Zweck der Gesellschaft für eine dahingehende Verpflichtung sprechen (vgl. BGH, GRUR 1955, 286, 289 – Schnellkopiergerät; GRUR 2000, 788, 790 – Gleichstromsteuerschaltung; GRUR 1991, 127, 129 – Objektträger; Bartenbach/Volz, a.a.O., § 1 Rdnr. 74 m. w. Nachw.; vgl. a. Benkard/Melullis, a.a.O., § 6 PatG Rdnr. 27e; Busse/Keukenschrijver, PatG, 7. Aufl., § 6 PatG Rdnr. 30). Auch kann sich – je nach den Umständen des Einzelfalles – aus der Treuepflicht mitunter eine Pflicht des Gesellschafters zur Übertragung bzw. Rechteinräumung ergeben (BGH, GRUR 1955, 286, 289 – Schnellkopiergerät; GRUR 2000, 788, 790 – Gleichstromsteuerschaltung; Bartenbach/Volz, a.a.O., § 1 Rdnr. 74 m. w. Nachw.), insbesondere wenn die Erfindung überwiegend auf Mitteln, Erfahrungen und Vorarbeiten des Unternehmens beruht (Bartenbach/Volz, a.a.O., § 1 Rdnr. 74 m. w. Nachw.; vgl. a. Benkard/Melullis, a.a.O., § 6 PatG Rdnr. 27e). Liegen keine besonderen Umstände vor, wird sich allein aus dem Gesichtspunkt der Treuepflicht des Gesellschafters ein Anspruch der Gesellschaft auf Übertragung der Erfindung des Gesellschafters allerdings regelmäßig nicht herleiten lassen, weil ein Gesellschafter andernfalls stets zur Übertragung verpflichtet wäre. Selbst der persönlich haftende Gesellschafter einer Personengesellschaft ist nach der Rechtsprechung des Bundesgerichtshofs aber nicht ausnahmslos verpflichtet, über die Erfindung zugunsten der Gesellschaft zu verfügen (vgl. BGH, GRUR 1955, 286, 289 – Schnellkopiergerät; GRUR 1991, 127, 129 – Objektträger). Entscheidend sind auch hier letztlich jeweils die Umstände des Einzelfalles.

b) 69

Ist der Geschäftsführer – wie hier der Beklagte – zugleich Gesellschafter, soll er nach einer in der Literatur vertretenen Auffassung auf Grund seiner gesellschaftsrechtlichen Geschäftsführerpflichten dazu angehalten sein, jede Erfindung im Geschäftsführungs- und Unternehmensbereich der Gesellschaft anzubieten und zu übertragen. Dies soll vor allem aus der Pflicht des Organs resultieren, in allen die Gesellschaft berührenden Sachverhalten deren Wohl und nicht nur den eigenen Nutzen zu besorgen (Bartenbach/Fock, GRUR 2005, 384, 386; vgl. auch Gaul, GmbHR 1992, 101, 102 f., Scholz, GmbHG, 10. Aufl., § 35 Rdnr. 246, Marsch-Barner in: GKommGmbHG, § 35 Rdnr. 55, die eine Anbieterpflicht des Geschäftsführers annehmen). Ob dem in dieser Allgemeinheit zu folgen ist, bedarf vorliegend keiner Entscheidung. Jedenfalls auf Grund der hier gegebenen Umstände bestand eine aus dem Gesellschaftsverhältnis folgende Anbieterpflicht des Beklagten. 70

Zwar enthält der Gesellschaftsvertrag der Klägerin keine Regelungen in Bezug auf Erfindungen. Auch war die Entwicklung und/oder Verwertung von Erfindungen nach dem Gesellschaftsvertrag nicht Gegenstand des Unternehmens. Dass der Gesellschaftsvertrag gerade in der Erwartung geschlossen wurde, dass in Verfolgung des Gesellschaftszwecks Erfindungen entstehen, ist ebenfalls nicht feststellbar. 71

Es ist jedoch zu beachten, dass es Sinn und Zweck der Gesellschaft war, eine Ölmühle neu zu errichten, um in dieser Rapsöl zu produzieren. Gesellschafter und Geschäftsführer der Klägerin waren nur der Beklagte und sein Mitgesellschafter C. Beide Gesellschafter waren zu gleichen Teilen an der Klägerin beteiligt. Sie investierten beide Geld in das gemeinsame Projekt und brachten sich jeweils in dieses ein. Ihre Aufgaben hatten die Gesellschafter der Klägerin hierbei einvernehmlich dahin untereinander aufgeteilt, dass dem Mitgesellschafter C der kaufmännische Teil oblag, wohingegen der Beklagte für den technischen Bereich zuständig war (vgl. Sitzungsprotokoll v. 18.07.2013, Bl. 277/278 GA). Eine 72

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Petition Pursuant to 37 CFR 1.46(B)(2)

**Higher Regional Court of Düsseldorf I-2 U 39/12**

**Date:** February 28, 2014  
**Court:** Higher Regional Court of Düsseldorf  
**Panel:** 2nd Civil Senate  
**Type of decision:** Judgment  
**Docket number:** I-2 U 39/12  
**ECLI:** ECLI:DE:OLGD:2014:0028:I2U39.12.00

**Lower court:** Regional Court of Düsseldorf, 4b O 43/11

**Operative provisions:** I. In reaction to the appeal by the Plaintiff, parts of the judgment rendered by the Civil Chamber 4b of the Regional Court of Düsseldorf on March 22, 2012 are amended. To an extent that exceeds the dictum in item I. of the judgment passed by the Regional Court, the Defendant is ordered to assign the entitlement to the grant of the German Patent DE 2010 0128XX.X and the rights arising from the German patent application DE 2010 0128XX.X to the Plaintiff.

**II.**

The Defendant has forfeited the right to the remedy of an appeal after having withdrawn its appeal against the judgment mentioned above rendered by the Regional Court of Düsseldorf.

**III.**

The Defendant shall bear the costs of the litigation in the first and second instance.

**IV.**

The judgment is provisionally enforceable. The Defendants may avert the Plaintiff's enforcement proceedings by providing a security in the amount of EUR 375,000.00 if the Plaintiff has not previously provided a security in the same amount.

**V.**

An appeal on points of law is not permitted.

**VI.**

The value in dispute of the appeal proceedings is set at EUR 500,000.00 for the period until December 18, 2013, EUR 375,000.00 of which account for the Plaintiff's appeal and EUR 125,000.00 of which account for the Defendant's appeal, and at EUR 375,000.00 for the time afterwards.

**Grounds:**

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[marginal nos. 2 through 66]

a) The fact that a managing director employment agreement may establish an obligation for the managing director to assign their invention to the partnership – be it within the meaning of a complete assignment of rights, be it within the meaning of granting a non-exclusive or exclusive license, is recognized (Senate, GRUR 2000, 49, 50 – Geschäftsführer-Erfindung [invention by the managing director]). If the managing director agreement does not include any explicit provisions on an obligation of the managing director to offer (and, accordingly, on a corresponding right to acquisition of the partnership), the principles of supplementary interpretation of agreements dictate that the hypothetical intention of the parties is to be explored. In this context all and any circumstances of the case are to be taken into consideration (Senate, GRUR 2000, 49, 50 – Geschäftsführer-Erfindung; Bartenbach/Volz, ArbNErfG [German Employee Inventor Act], 5th edition, Sec. 1, marginal no. 72). If the managing director is deployed in the technical field under the content of the employment agreement, possibly even with the declared aim of intended technical innovations, and the invention mainly is based on the means, experience and previous work of the company, this suggests an obligation to offer and assign (cf. Senate, GRUR 2000, 49, 50 – Geschäftsführer-Erfindung; Bartenbach/Volz, loc. cit., Sec. 1, marginal no. 74; Bartenbach/Fock, GRUR 2005, 384, 385 each with further references.) If the managing director has a contractual obligation to offer, what requires further clarification as well is whether a free-of-charge assignment can be demanded or whether the partnership has to pay a particular compensation to the inventor when acquiring the invention (Senate, GRUR 2000, 49, 50 – Geschäftsführer-Erfindung). The latter regularly is the case if the invention is an extra performance exceeding the obligations (and, therefore, is not paid for by the agreed earnings of the managing director) (Senate, GRUR 2000, 49, 50 – Geschäftsführer-Erfindung). Insofar, it can generally be assumed that the managing director is not obligated themselves to strive for the development of technological innovations (Senate, GRUR 2000, 49, 50 – Geschäftsführer-Erfindung). Rather, corresponding to their capacity as a body of the partnership, they (merely) have to take the required organizational measures to ensure that the conditions for the intended innovations in terms of human resources and material are met in the field of their duties and area of their responsibility. It is their obligation under the employment agreement to embrace the top leadership role in the company, i.e. to represent the partnership vis-à-vis third parties and

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[http://www.justiz.nrw.de/nrwe/ogs/duesseldorf/2014/I\\_2\\_U\\_39\\_12\\_Urteil.html](http://www.justiz.nrw.de/nrwe/ogs/duesseldorf/2014/I_2_U_39_12_Urteil.html) Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/910,681

PATENT

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safeguard the conditions for the achievement of the object of the company. Considering this, inventions of their own are usually not covered by the obligations of managing directors and, accordingly, are extra performances subject to remuneration (Senate, GRUR 2000, 49, 50 – Geschäftsführer-Erfindung; judgment dated June 8, 2006 – I-2 U 28/05, NJOZ 2007, 1583, 1586; Regional Court of Düsseldorf, decisions 1, 3, 7 et seq. – Ozonerzeuger; judgment dated February 10, 2005 – 4a 150/04, juris marginal no. 33). However, if research and development activities are assigned to the managing director in person by virtue of the employment agreement, for example, the invention is not an extra performance exceeding the obligations, but the result of the service owed under the agreement and, thus, already covered by the agreed earnings of the managing director (Senate, GRUR 2000, 49, 50 et seq. – Geschäftsführer-Erfindung; Barlenbach/Fock, GRUR 2005, 384, 386 et seq.). This means that an obligation to offer and assign the invention to the partnership free of charge regularly exists if research and development activities are assigned to the managing director under the employment agreement (Senate, GRUR 2000, 49, 50 et seq. – Geschäftsführer-Erfindung). However, what is decisive are the respective circumstances of each individual case. If there is no explicit provision, above all, the purpose of the concerned labor relations or the object of the company employing the managing director, the specific capacities the managing director assumes in the partnership, their obligation of loyalty towards the partnership as well as the manner in which earlier inventions were handled in legal terms provide suitable indications of the actual intent declared by means of the employment (cf. German Federal Court of Justice, GRUR 2000, 788, 790 – Gleichstromsteuerschaltung; GRUR 1955, 286, 289 – Schnellkopiergerät; GRUR 1965, 302, 304 – Schellenreibungskupplung; Jestaedt, Festschrift für Rudolf Nirk, 1992, 493, 500 et seq.).

[marginal nos. 68 through 87]

As an English translator duly appointed and sworn by the Regional Court of Munich I, I certify that, to the best of my knowledge and belief, the above translation is a true and correct translation of the German document presented to me.

Munich, February 25, 2019

  
Saskia Ettling



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[http://www.justiz.nrw.de/nrwe/olgs/duesseldorf/I/2014/I\\_2\\_U\\_39\\_12\\_Urteil\\_20140226.html](http://www.justiz.nrw.de/nrwe/olgs/duesseldorf/I/2014/I_2_U_39_12_Urteil_20140226.html)

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## Düsseldorf Higher Regional Court, I-2 U 39/12

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**Date:** 28.02.2014  
**Court:** Düsseldorf Higher Regional Court  
**formation of the court:** 2nd Civil Senate  
**type of decision:** judgment  
**reference number:** I-2 U 39/12  
**ECLI:** ECLI:DE:OLGD:2014:0228.I2U39.12.00

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**Previous instance:** Düsseldorf Regional Court, 4b O 43/11

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I. On the plaintiff's appeal, the judgment of the 4b Civil Chamber of the Düsseldorf Regional Court delivered on 22 March 2012 is amended in part. The defendant is ordered - in addition to the statement in I. of the judgment of the Regional Court - to assign to the plaintiff the claim to grant of the German patent DE 2010 0128XX.X and the rights from the German patent application DE 2010 0128XX.X.

**II.**

The defendant has lost the appeal on appeal after having withdrawn his appeal against the aforementioned judgment of the Regional Court of Düsseldorf.

**III.**

The costs of the proceedings at first and second instance shall be borne by the defendant.

**IV.**

The judgment is provisionally enforceable. The defendant is permitted to avert the plaintiff's execution by providing security in the amount of EUR 375,000.00 if the plaintiff has not previously provided security in the same amount.

**V.**

The revision is not permitted.

**VI.**

The amount in dispute for the appeal proceedings is fixed at EUR 500 000.00 for the period up to 18 December 2013, EUR 375 000.00 of which for the plaintiff's appeal and EUR 125 000.00 for the defendant's appeal, and EUR 375 000.00 for the period thereafter

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**Reasoning:**

I.

The plaintiff demands from the defendant the assignment of the rights from a German patent application. It also sought a declaration that a license agreement relating to that patent application was invalid. 3

The plaintiff was founded by the Dipl.-Kfm. C and the defendant by notarial agreement dated 29.08.2007 under its former company B GmbH. Both shareholders hold equal shares in the plaintiff. By resolution of the shareholders, also passed on August 29, 2007, both shareholders were appointed as managing directors of the plaintiff with sole power of representation and exempt from the restrictions of Section 181 of the German Civil Code (BGB). 4

The plaintiff originally planned to build an oil mill in D. However, a plot of land acquired by the plaintiff for this purpose proved to be too small. The plaintiff then planned a project in Haldensleben with an investment volume of around EUR 46 million. *The* object of this project was the construction of a new oil mill on a plot of land of approx. 65,000 m<sup>2</sup> on the Mittellandkanal. The oil mill was to have an initial seed processing capacity of 400,000 tonnes per year. It was planned to focus on the processing of rape (see Annex 17 of the plaintiff). 5

Contrary to an earlier intention of the defendant, the plant should not produce biofuels but oils for the food market. In connection with the project, the plaintiff placed orders with E GmbH (hereinafter 'E') and F AG (hereinafter 'F'). The required production energy was to be generated from biomass in a separate power plant. The plans were accompanied by witness K. The latter had mediated the contact between the plaintiff's shareholders after he had been asked by the defendant to help him find an investor. As an expert, Witness Dr. G, who had already accompanied the development phase of a large number of oil mills, was called in. The plaintiff applied for public funding for the project (see Annexes 15 - 19 of the plaintiff). The application for funding was prepared by shareholder C in consultation with witnesses H and Dr. I, who advised the plaintiff as tax consultants, and essentially with the defendant. On 18.03.2010, the plaintiff received a test report according to which the incineration of peeling fractions was possible and permissible. 6

On 7 May 2009 (Annex B 13), the plaintiff filed a patent application with the German Patent and Trade Mark Office entitled "Process for conditioning oilseeds in a conditioning device and device for carrying out the process" (Annex B 14). This patent application, which received the No. DE 10 2009 002 9XX.Y, proved not to be patentable. 7

On 25.03.2010, the defendant filed in his name a patent application (Annex B 3) with the German Patent and Trade Mark Office entitled "Procedure for peeling rapeseeds", which was given the number DE 10 2010 012 8XX.Z (hereinafter referred to as "patent application in dispute") and which was disclosed on 29.09.2011. The defendant named himself the inventor. This patent application, for which a German patent has not yet been granted, was commissioned from the patent law firm J, which had already processed the previous application. 8

The patent application in dispute comprises 13 patent claims. Claims 1, 11 and 12 are as follows: 9

1.

A process for peeling rape seeds comprising at least the following 10

- Steps: 11

- *Provision of rapeseed seeds from rapeseed grains comprising a shell portion and Core meat,*
- *Insert the rape seeds into an impact mill (1),*
- *mechanical breaking of the rape seed shells in the impact mill (1),*
- *The material to be ground is fed out, consisting of broken shell and core meat portions, from the impact mill (1),*
- *Introduction of the material to be ground into a sifting device (2) and separation of the shell parts*
- *of the nuclear flesh,*
- *removing the shell portions and the core portions from the sifting device (2),*
- *Inserting the shell parts into a sieving device (3) for further separation of*
- *The pit flesh remains from the peel parts,*
- *Separate discharge of shell and core meat from the sieving device*

11.           *Device for carrying out the method according to one or more of the following preceding claims comprising at least one impact mill (1), a classifying device (2) and a screening device (3).* 13

12.           *Use of the shell components obtained from the process according to a or more of claims 1 to 9, characterized in that the shell portions are used as biomass for a solid fuel combustion plant for generating thermal energy.* 14

The following subscription is taken from the disclosure document 10 2010 012 8XX.Z and shows a schematic diagram of a flow diagram of the rapeseed through the individual components of the invention-made device for peeling rapeseed. 15

On 25.03.2011, the defendant also filed a European patent application concerning this invention at the European Patent Office, for which it was granted EP 2 16 550 XYX. In addition, it filed a PCT application, which was filed on 29.09.2011 under the international publication number WO 2011/117XYX. 16

At the time of filing the patent application, investment costs amounting to of at least EUR 598,838.11 was incurred. The shareholders had granted loans in this amount to the plaintiff, namely shareholder C in the amount of EUR 394,345.78 and the defendant in the amount of EUR 204,492.33 (cf. draft balance sheet as at 30 April 2010, Annex 20 of the plaintiff). 17

In the name of the plaintiff, the defendant concluded an agreement with itself as a contractual partner on the license agreement dated 27.04.2010, drafted by patent attorney law firm J, by which he granted the plaintiff a simple license to the subject-matter of the patent action in question. 18

With the fee invoice dated 27.04.2010 (Annex 9 of the plaintiff), the patent attorney law firm J invoiced the plaintiff an amount of EUR 4,182.85 for 'consultancy services in patent matters, in particular in proceedings relating to rape seed; consultancy on licence agreements ...'. By invoice dated 26.04.2010 (Annex 10 of the plaintiff), the defendant was invoiced by the patent attorneys an amount of EUR 470.00 for official fees relating to the patent application in dispute. 19

In April 2010, the plaintiff experienced liquidity problems. On the occasion of a shareholders' meeting on 10 May 2010, shareholder C called on the defendant to sell his share in the company and threatened to withdraw liquidity from the plaintiff. In a letter dated 12.05.2010, the defendant announced that in the case of the efforts to procure sufficient liquidity fail by 30 May 2010, the company will apply for insolvency. Such an application was received by the insolvency court on 09.06.2010; after a capital increase of EUR 120,000 by shareholder C, the insolvency court considered the insolvency proceedings on the basis of a 20

withdrawal of application as done. In the following period there were several shareholders' meetings. Two resolutions passed at meetings in June 2010, including the dismissal of the defendant as managing director and his exclusion as shareholder, were declared null and void by the Regional Court of Münster on 22 March 2012 (Ref.: 25 O 102/10) as a result of the withdrawal of the plaintiff's appeal. The Düsseldorf Regional Court partially granted an action for nullity brought by the defendant against resolutions passed at a further shareholders' meeting on 15 October 2010 in a legally binding judgment dated 22 March 2011 (4b O 4/11); it dismissed the action for nullity insofar as it was also directed against resolutions passed at this shareholders' meeting regarding the dismissal of the defendant as managing director and the assertion of claims for damages against the defendant.

At the end of June 2010, it turned out that invoices from E to the plaintiff amounting to approximately EUR 21 99,000.00 were outstanding. By judgment of the Regional Court of Münster (25 O 143/10) - which was not final - the plaintiff was ordered to pay EUR 99,560.37 to E in this respect. In the legal dispute there, a statement of the defendant dated 09.09.2010 was submitted (Annex 31 of the plaintiff), with which he confirmed that he had commissioned E with planning work regarding the oil mill in the name of and on behalf of the plaintiff. Also on 9 September 2010, three engineers of E made a declaration (Annex 30 of the plaintiff) that they had not made any creative or inventive contribution to the invention disclosed in the patent application. In the subsequent period, the plaintiff's shareholders filed reciprocal applications for punishment. With a fee note dated 04.10.2010 (Annex B 4), patent attorney law firm J invoiced the defendant an amount of EUR 2,856.00 in respect of the patent application in dispute. On 06.12.2010, the patent attorneys cancelled the fee invoice of EUR 4,182.85 of 27.04.2010 addressed to the plaintiff (cf. Annexes 12 and 13 of the plaintiff).

The plaintiff relied at first instance on the following pleas:

The patent application in dispute is a further development of the first patent application. The patent attorney law firm J had originally intended to file the patent application in its name - that of the plaintiff - but, at the defendant's intervention, indicated the defendant as the plaintiff. Although the defendant filed the application for registration on its own behalf, it wished to leave the bulk of the costs to it. With regard to the question of who is the proprietor of the patent, the cost accounting of the patent attorneys addressed to the defendant of 04.10.2010 are only an irrelevant correction of the previous invoice of 27.04.2010. The plaintiff claims that it was the contracting authority. All its advisers and its shareholder C had assumed that the patent application would be made in their favour. The plaintiff also submits that E agreed only with an application for registration in its name - that of the plaintiff. It was the idea of their shareholder C to produce edible oils instead of biofuels. In the course of the development phase, the idea arose to use a so-called partial fractionation to produce rapeseed shells as fuels, after it had become apparent that there was not enough wood of the category A2 available on the market. In this context, there had been a large number of discussions, which had ultimately been based on the idea that rapeseed should be replaced by to peel the metal in a collision. The witness, Dr. G, had persuaded the defendant to consider whether fuels could be generated from the shells of rapeseed. It was clear to Dr. G that he was working for the plaintiff. At the beginning of the project, the defendant did not want to know anything about the burning of the rapeseed shells; the idea originating from Dr. G only arose when wood fuels were excreted due to scarcity of raw materials. The defendant had found the idea exciting and had taken it up. In the course of the proceedings one found that, prior to the intervention of other companies, about 40 % of the rapeseed shells were needed to cover the total energy requirements of the oil mill. There had been several proposals as a solution. From a certain point in time, the defendant had kept the witness Dr. G away from further development. It is not disputed that the defendant did not submit any drawings or the like at the time.



It had been the aim of their company to obtain a corresponding patent. In the discussions, it was clear to everyone that it was entitled to the patent. All the contracts in question were also awarded and financed on its behalf. There was agreement between the partners that it should be the patent proprietor. The witness Dr. I had made it clear in a number of conversations that this was a condition for the further development of the project. The defendant wrongly appears to think that he has a claim to the patent as a source of ideas, leaving party agreements completely out of the question. The defendant is obliged, at least according to the so-called business opportunity theory, to assign to it the rights from the patent application.

The plaintiff claims that the Court should:

1. order the defendant to assign to the plaintiff the rights conferred by the patent application filed with the German Patent Office No: DE 2010 0128XX.X;
2. declare that the license agreement of 27.04.2010 between the defendant and the defendant is invalid.

The defendant has applied for  
dismiss the action.

The defendant claimed to be the inventor of the invention on which the patent application was based. In 2005, he had already started to consider how the extraction of rapeseed oil could be optimized. At that time he had recorded his considerations in various drawings (Annex B 1). As a result of his considerations, he had drawn a prototype in 2005 (Annex B 2). At that time he had carried out his first experiments with the peeling and sieving of rape seeds at home. The Patent application and drafting of the patent specification, discussion of the technical details and the specifications for the drawing and the patent specification had come exclusively from him and had been discussed with the patent attorneys. The invention did not play a role in the establishment of the plaintiff. The aim of the company was also not patenting; the purpose of the company had nothing to do with the invention. A patent development by the plaintiff did not take place. Nor did the plaintiff bear all the costs of patent development. The engineers of E would not have made any creative contributions to the invention. Even witness K had nothing to do with the invention. The talks with the witness Dr. G had also only been about the construction of the oil mill, but not about the patent development. The oil mill had been planned completely independently of the invention. The power plant was to be operated with wood chips. In the course of the planning, he - the defendant - came up with the idea of making his invention from 2005 usable. Since the plaintiff wanted to make use of his invention within the framework of the project in D, the tests were commissioned by E. It had carried out investigations as to whether its invention could be used on a commercial scale in oil mills.

In its ruling of 22.03.2012, the Regional Court determined that the license agreement of 27.04.2010 is ineffective. The further action was dismissed. In support of its decision, the Regional Court essentially explained that the appeal proceedings were still of significance:

The plaintiff is not entitled to an assignment of the rights arising from the application of the patent in dispute from any legal point of view; in particular, such a claim does not arise from Sec. 8 Patent Law. It could not be established that the plaintiff was a (co-)beneficiary of the invention at issue. The plaintiff's submissions do not allow the finding that any natural person other than the defendant made any creative contribution to the invention. It is therefore irrelevant whether co-inventor shares resulting from such contributions were transferred to the plaintiff. The plaintiff's arguments in relation to Dr G do not show that Dr G is at least to be regarded as a co-inventor. Even if Dr. G actually had the idea.

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The fact that he had made a contribution to the invention does not mean that he had separated the rapeseed shells and used them as fuel for the power station. There is no connection whatsoever with the solution according to the invention according to the patent claims. It was all the more undeniable that other natural persons had been creatively active in relation to the invention. A contractual agreement to transfer the rights of the defendant arising from his invention to the defendant could not be established. It is irrelevant that the defendant should at some point have expressed the intention to register the invention together with shareholder C. The plaintiff submits that the defendant has not filed a patent application for the invention. The defendant was also not obliged to transfer the rights arising from the invention according to the so-called business opportunity theory. It is not possible to establish that the defendant made the invention during his capacity as shareholder/managing director of the plaintiff; the assertion that the invention had already been made in 2005 has not been refuted. It would go beyond the fiduciary duties of a shareholder manager to transfer, free of charge, the rights to which he was entitled to industrial property rights dating from a period prior to the existence of the company.

For further details of the reasoning, reference is made to the judgment of the Regional Court. 33

Both parties have appealed against this judgment. The defendant withdrew its appeal by its brief of 16 December 2013. 34

By its appeal, the plaintiff is pursuing its claim, dismissed by the Regional Court, for assignment of the rights from the patent application. Repeating and supplementing her presentation at first instance, the plaintiff asserts: 35

The relevant development of the method for peeling rapeseed took place in its business division. The idea of peeling the rape seed and using the shells as fuel only arose in the course of numerous discussions between shareholder C and the defendant with knowledgeable witnesses. The decision had been made to carry out the peeling process by means of the impact of the seed on metal instead of rolling or blowing out the seed. The procedure had then initially been carried out and tested by commissioning, among others, E and F. Subsequently, various series of tests were carried out in which the combustion of the separated rapeseed shells was tested for compatibility with emission control law. The Regional Court overlooked the fact that an obligation of the defendant to transfer the right to grant the patent arises from its obligation under company law as its shareholder and from a supplementary interpretation of the management contract. As managing partner, the defendant had taken over the technical management of the business operations, while shareholder C was mainly responsible for the commercial and accounting areas. It was the defendant's task to take over the technical implementation of the oil mill through the development of efficient oil extraction to promote. This included perfecting the peeling process for rapeseed. The significant development of the process took place in its company; in this case, the involvement of the abovementioned companies led to corresponding trials and machines for carrying out the partial fractionation process were developed. It had been concluded that the most effective way to peel rapeseed was by hitting the metal with the seed. The plaintiff also argues that test series concerning the incineration of rapeseed were carried out on its behalf and at its expense. It had borne all the costs of the patent developments. Against this background a supplementary interpretation of the contract of the shareholder or employment contract results in, that the defendant is obliged to transfer the rights to the invention to them. Under no circumstances was it the case that the defendant had already had a ready-made invention ready for patenting before the start of his shareholder or managing director activities. On the contrary, the defendant used its financial resources and employees to carry out the process of peeling rapeseed seeds using to develop and optimize the execution of many test series. 36

The plaintiff **claims that the Court should:** 37

modify the judgment of the Regional Court in so far as the action has been dismissed, and order the defendant to assign to the plaintiff the rights conferred by the patent application filed with the German Patent Office No: DE 2010 0128XX.X, 38

in the alternative, set aside the judgment of the Regional Court in so far as the action was dismissed and refer the case back to the Regional Court for retrial. 39

The defendant **claims that the Court should:** 40

dismiss the plaintiff's appeal. 41

The defendant defends the judgment of the Regional Court in so far as the Regional Court has dismissed the action, and opposes the plaintiff's arguments on appeal, arguing that it is wrong, but also irrelevant, that the idea of peeling the rape seed and burning the shells arose in the course of numerous discussions. The idea of peeling rapeseed is not a "new invention"; this has been known for a long time. The burning of the shells was also not a new idea or invention, but merely a consequence of his invention, in which the shells remained as a residual product. The tests carried out only showed that his invention could be used for the purposes of the plaintiff. The result had shown that his invention also worked "on a large scale". It is wrong that the plaintiff was established for the purpose of further developing technical processes for the energy-saving production of rapeseed oil and for patenting a newly developed process. The plaintiff wanted to build an oil mill. The major part of the costs of a good EUR 500,000.00 had been spent on the relevant planning, expert opinions, funding documents and architectural services. Only in a later phase did the participants come up with the idea of using his invention for the oil mill in Haldensleben in order to increase overall economic efficiency. The project works even without its invention. 42

In accordance with the decision of the Senate of 23.07.2013 (pp. 282 - 283 GA) to take evidence, the Senate has taken evidence by questioning the witnesses Dr. Claus I, Walter H, Frank K, Dr. Ernst Wilhelm G and Carsten L. Reference was made to the minutes of 19.12.2013 for the outcome. 43

Because of the further details of the facts and dispute, the content of the court files together with annexes. 44

**II.** 45

After the defendant had lodged his appeal against the judgment of the Regional Court in a brief of 16.12.2013, the appeal of the plaintiff is now the only way to decide. This is permissible and justified. The plaintiff contests the view that of the Regional Court a claim for assignment of the rights from the German Patent application DE 10 2010 012 8XX.Z against the defendant. 46

1) The patent application in dispute concerns, inter alia, a process for peeling rape seed. 47

Rapeseed essentially consists of a shell fraction and a core fraction. 48

Usually the seed as a whole is industrially processed to produce oil and what is known as meal. However, the processing of the shell fraction brings disadvantages in the process and the end products. In addition, the crude fibre content of the shells represents only a low to low value in the meal.

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The German Disclosure Document 2010 012 8XX.Z A1 (hereinafter only: Disclosure Document) states in its introduction that the state of the art has already led to the development of processes for peeling of rapeseed. Thus DE 40 41 XYZ B4 describes a procedure and a Device for peeling fresh rapeseed, the rapeseed being pre-shelled is subjected to cleaning and classification for the separation of small sizes, and is then peeled using successive processing steps. First, a potential difference in the water content between the shell and core of the seed is produced by reducing the water content of the seed by 0,6 to 2,0 % by drying with a seed residence time of five minutes at a temperature of 95° C. The water content of the shell and core of the seed is then reduced by 0,6 to 2,0 % by drying with a seed residence time of five minutes at a temperature of 95° C. The water content of the shell and core of the seed is then reduced by 0,6 to 2,0 % by drying with a residence time of five minutes at a temperature of 95° C. Pressure treatment is then carried out by rolling using a roller peeler with a rolling gap which is 0.2 to 0.4 times the mean value. This is followed by the impact release of the broken shells from the core meat by pneumatic conveying. This is followed by air separation to separate the fractions of unpeeled cores. This is followed by the sifting and separation of the shells from the cores by electro separation.

With this well-known method, it is problematic that the rapeseed is fed before the peeling process must first be subjected to cleaning or a classification to separate smaller sizes. These additional processing steps reduce the efficiency of the process and make it more expensive. In addition, only a certain grain size of rapeseed can be broken through the defined rolling gap.

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Against this background, the task of the patent application in dispute has been to provide a method and apparatus for peeling rapeseed which does not require upstream drying and sorting and thereby permits improved process efficiency.

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In order to solve this problem, the patent claim 1 filed first of all suggests a method for peeling rapeseed comprising at least the following steps:

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(1) Provision of rapeseed seeds from rapeseed grains, comprising a shell portion and core flesh

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(2) Introduction of the rape seeds into an impact mill.

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(3) Mechanical breaking of the rape seed shells in the impact mill.

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(4) The material to be ground is removed from the impact mill, consisting of broken shell and core meat portions.

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(5) The ground material is fed into a sifting device and the shell portions are separated from the core meat portions.

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(6) Removal of the shell parts and the core parts from the sifting device.

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(7) Inserting the shell portions into a sieving device for further separation of core meat remains from the shell portions.

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(8) Separate discharge of shell portions and core meat portions from the sieving device.

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The further proposal to solve the problem underlying the patent application has the device for carrying out the method of content. According to patent claim 11 has this device:

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(a) at least one impact mill (1),

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(b) a sifting device (2) and

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(c) a sieving device (3).

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Claim 12 finally proposes to remove the shell parts resulting from the procedure under one or more of Claims 1 to 9 are obtained as biomass for a solid fuel combustion plant for the generation of thermal energy.

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2) The plaintiff is entitled to a claim arising from the company relationship to assignment of the rights from the German patent application DE 2010 0128XX.X relating to this invention against the defendant as its shareholder and former managing director, because the invention only comes about after the establishment of the plaintiff in its corporate division in the course of the development and establishment of the jointly planned oil mill. The following applies in detail

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a) The fact that a managing director employment agreement may establish an obligation for the managing director to assign their invention to the partnership — be it within the meaning of a complete assignment of rights, be it within the meaning of granting a non-exclusive or exclusive license, is recognized (Senate, GRUR 2000, 49, 50 — Geschäftsführer-Erfindung [invention by the managing director]). If the managing director agreement does not include any explicit provisions on an obligation of the managing director to offer (and, accordingly, on a corresponding right to acquisition of the partnership), the principles of supplementary Interpretation of agreements dictate that the hypothetical intention of the parties is to be explored. In this context all and any circumstances of the case are to be taken into consideration (Senate, GRUR 2000, 49, 50 — Geschäftsführer-Erfindung; BartenbachNolz, ArbNErfG [German Employee Inventor Act], 5th edition, Sec. 1, marginal no. 72). If the managing director is deployed in the technical field under the content of the employment agreement, possibly even with the declared aim of intended technical innovations, and the invention mainly is based on the means, experience and previous work of the company, this suggests an obligation to offer and assign (cf. Senate, GRUR 2000, 49, 50 — Geschäftsführer-Erfindung; BartenbachNolz, loc. cit., Sec. 1, marginal no. 74; Bartenbach/Fock, GRUR 2005, 384, 385 each with further references.) If the managing director has a contractual obligation to offer, what requires further clarification as well is whether a free-of-charge assignment can be demanded or whether the partnership has to pay a particular compensation to the inventor when acquiring the invention (Senate, GRUR 2000, 49, 50 — Geschäftsführer-Erfindung). The latter regularly is the case if the invention is an extra performance exceeding the obligations (and, therefore, is not paid for by the agreed earnings of the managing director) (Senate, GRUR 2000, 49, 50 — Geschäftsführer-Erfindung). Insofar, it can generally be assumed that the managing director is not obligated themselves to strive for the development of technological innovations (Senate, GRUR 2000, 49, 50 — Geschäftsführer-

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Erfindung). Rather, corresponding to their capacity as a body of the partnership, they (merely) have to take the required organizational measures to ensure that the conditions for the intended innovations in terms of human resources and material are met in the field of their duties and area of their responsibility. It is their obligation under the employment agreement to embrace the top leadership role in the company, i.e. to represent the partnership vis-a-vis third parties and safeguard the conditions for the achievement of the object of the company. Considering this, inventions of their own are usually not covered by the obligations of managing directors and, accordingly, are extra performances subject to remuneration (Senate, GRUR 2000, 49, 50 — Geschäftsführer-Erfindung; judgment dated June 8, 2006 — 1-2 U 28/05, NJOZ 2007, 1583, 1586; Regional Court of Düsseldorf, decisions 1, 3, 7 et seq. — Ozoneerzeuger; judgment dated February 10, 2005 — 4a 150/04, juris marginal no. 33). However, if research and development activities are assigned to the managing director in person by virtue of the employment agreement, for example, the invention is not an extra performance exceeding the obligations, but the result of the service owed under the agreement and, thus, already covered by the agreed earnings of the managing director (Senate, GRUR 2000, 49, 50 et seq. — Geschäftsführer-Erfindung; Bartenbach/Fock, GRUR 2005, 384, 386 et seq.). This means that an obligation to offer and assign the invention to the partnership free of charge regularly exists if research and development activities are assigned to the managing director under the employment agreement (Senate, GRUR 2000, 49, 50 et seq. — Geschäftsführer-Erfindung). However, what is decisive are the respective circumstances of each individual case. If there is no explicit provision, above all, the purpose of the concerned labor relations or the object of the company employing the managing director, the specific capacities the managing director assumes in the partnership, their obligation of loyalty towards the partnership as well as the manner in which earlier inventions were handled in legal terms provide suitable indications of the actual intent declared by means of the employment (cf. German Federal Court of Justice, GRUR 2000, 788, 790 — Gleichstromsteuerschaltung; GRUR 1955, 286, 289 — Schnellkopiergerät; GRUR 1965, 302, 304 — Schellenreibungskupplung; Jestaedt, Festschrift für Rudolf Nirk, 1992, 493, 500 et seq.).

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The above legal principles also apply mutatis mutandis to shareholders (Bartenbach/Volz, loc. cit., § 1 paragraph 74; see loc. cit. Benkard/Melullis, PatG/GebrMG, 10th edition, § 6 PatG paragraph 27e). For example, a shareholder's obligation to transfer a share of the invention, that it is responsible for the technical field or was also used there, possibly even with the aim of being aware of technical innovations (cf. Bartenbach/Volz, loc. cit., § 1 para. 74). The sense and purpose of the company can also speak in favour of an obligation to this effect (see BGH, GRUR 1955, 286, 289 - Fast copying device; GRUR 2000, 788, 790 - Direct current control circuit; GRUR 1991, 127, 129 - Object slides; Bartenbach/Volz, loc. cit., § 1 marginal no. 74; cf. also Benkard/Melullis, loc. cit., Sec. 6 PatG, No. 27e; Busse/Keukenschrijver, PatG, 7th edition, Sec. 6 PatG, No. 30). Also, depending on the circumstances of the individual case, the obligation of the shareholder to transfer or transfer the shares to a third party (BGH, GRUR 1955, 286, 289 - Quick copy device; GRUR 2000, 788, 790 - Direct current control circuit; Bartenbach/Volz, loc. cit., § 1 marginal no. 74 with further evidence.) in particular if the invention is based predominantly on means, experience and preparatory work of the enterprise (Bartenbach/Volz, loc. cit.; see also Benkard/Melullis, loc. cit., Sec. 6 PatG, No. 27e). However, in the absence of special circumstances, a claim of the company to the transfer of the invention of the shareholder cannot normally be derived solely from the point of view of the shareholder's duty of loyalty, because otherwise a shareholder would always be obliged to transfer. Even the personally liable partner of a partnership is, according to the case law of the Federal Court of Justice, not without exception obliged to dispose of the invention in favour of the partnership (cf. BGH, GRUR 1955, 286, 289 - Schnellkopiergerät; GRUR 1991, 127, 129 - Objektträger).

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Ultimately, the circumstances of the individual case are decisive here as well.

b)

If the managing director - as here the defendant is - is at the same time a shareholder, according to the literature on the basis of its corporate law and its duties towards the company the managing director has to make sure that every invention in the field of management is offered and transferred to the Company. The main purpose of this is to result from the duty of the governing body to act in all matters affecting the Company, and to provide their well-being and not only their own use (Bartenbach/Fock, GRUR 2005, 384, 386; see also Gaul, GmbHR 1992, 101, 102 f., Scholz, GmbHG, 10th ed., § 35 marginal no. 246, March-Barnier in: GKommGmbHG, § 35 marginal no. 55, which imposes an obligation to offer the managing director). Whether this is to be followed in this generality, requires in this case no decision. In any case, due to the circumstances here given, one consisted of the obligation of the defendant to offer the goods in accordance with the company relationship.

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It is true that the plaintiff's articles of association do not contain any provisions concerning inventions. Nor was the development and/or exploitation of inventions the object of the company under the articles of association. The fact that the articles of association were concluded precisely in the expectation that inventions would arise in pursuit of the purpose of the company cannot be established either.

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However, it should be noted that the purpose of the company was to build an oil mill new to produce in this rapeseed oil. Only the defendant and his co-partner C were shareholders and managing directors of the plaintiff. Both shareholders held equal shares in the plaintiff. They both invested money in the joint project and each contributed to it. The shareholders of the plaintiff had divided their tasks amicably among themselves in such a way that the co-shareholder C was responsible for the commercial part, whereas the defendant was responsible for the technical part (cf. minutes of the meeting of 18.07.2013, p. 277/278 GA). Both shareholders did not receive executive remuneration; on the contrary, both shareholders initially acted free of charge in the expectation that after the start of the business operations as a shareholder to benefit financially from the company (minutes of the meeting of 18.07.2013, p. 278 GA). They thus rendered their services in anticipation of later profits for the company from the operation of the new oil mill to be built. Among the defendant's tasks was the technical implementation of the joint project. The defendant was thus not only responsible for the technical area, but also for the technical equipment of the oil mill, which was still to be built. In this respect, it is obvious that in order to achieve this goal, which is also supported by the early involvement of Witness Dr. G as technical advisor, he should also consider technical innovations that should enable efficient production in the new plant to be built. Against this background, there is every reason to believe that bona fide contracting parties, if they had been aware of the problem of the allocation of inventions, it would have been agreed that inventions arising in the context of the development and construction of the oil mill should not be the responsibility of the defendant responsible for the technical field, but of the joint company. This is all the more true since, even if the tests and investigations carried out by E in the course of the project had served only to test the invention which had already been completed, it was the defendant's intention that the costs of the subsequent commissioning of E in the course of the project should be borne solely by the plaintiff; according to the statement of the defendant (Annex 31 of the plaintiff), the defendant had commissioned E on behalf of the plaintiff. Finally, the fact that the first patent application DE 10 2009 002 9XX.Y entitled "Process for conditioning oilseeds in a conditioning device and device for carrying out the process", even if its subject matter was attributable to both shareholders, was applied for in person by the plaintiff and

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not by the two shareholders, also speaks in favour of the fact that inventions of the joint company arising in the course of the development and construction of the oil mill should be due to the joint company.

c)According to the outcome of the taking of evidence at second instance, the Senate is convinced that, according to the patent application, the invention only came about after the plaintiff had founded its business in the context of the oil mill project. This results in particular from the credible statements of witnesses K and Dr. G.

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Witness K, who had established contact between the plaintiff's shareholders and, in his capacity as architect, was in charge of the architectural planning of the project and the coordination of the specialist engineers involved, described very clearly, on the basis of the minutes available to him, that since 2007 there have been repeated rounds of talks between the persons involved in the plaintiff's project in which, among others, the defendant, the witness Dr. G and he himself took part. According to him, witness K has always been up to date with the project because of these meetings. The witness testified that the idea of peeling the rape seed came up in a meeting on 13.08.2008. At the time, it was thought about how the quality of the cold-pressed oil could be improved. In this context, the idea was to peel the rape seeds in order to separate the shell fraction and thus produce a higher quality oil during the pressing process. Then the idea came to the fore that this could also be done for hot pressing or that the shell fraction could generally be separated and then possibly recycled. At some point, one had the idea to carry out the peeling during hot pressing and to burn the peels in the power station. Various procedures had been discussed. Among other things, there had been the idea of speeding up the sowing of rapeseed and causing it to burst by impact. The ideas raised in the discussion should have been examined, although the subject - possibly because of the change of location - had not been dealt with further for the time being. After it had been declared in a meeting with the investment bank that the procurement of wood chips for the planned power plant was difficult or too cost-intensive to the extent necessary to supply the oil mill with energy, the idea of peeling rape seed was taken up again in 2009 and appropriate peeling and firing tests were then carried out. According to Witness K, the basic idea of separating the shell fraction from the core fraction was not discussed until the round table discussion on 13.08.2008. According to Witness K, the possibility of wind sifting was also clarified by Witness Dr. G in this discussion. According to Witness K, this meeting was an open discussion in which various ideas arose or were discussed. On the basis of the information provided by Witness K, it was by no means the case that the defendant had presented a finished invention or a process for peeling rape seed which he had developed or even only considered on the occasion of this meeting. Nor can it be inferred from the statements of Witness K that the defendant in this conversation in any way expressed that one could fall back on earlier ideas of his. The witness Dr. I, who advised the plaintiff in his capacity as tax consultant and auditor, also did not remember any remark of the defendant to that effect.

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The witness Dr. G, who was responsible for the oil mill project on behalf of the plaintiff as technical consultant said that he himself, perhaps in 2008, had raised the question of whether rape shells could be used to generate energy. He has also said that he had discussed the peeling of rape for several hours with the defendant, and that he - the witness - had brought in his experiences and explained how the peels could actually be separated quite well. Even according to the testimony of the witness Dr. G, the defendant did not note on these occasions that it was possible to fall back on an idea which he - the defendant - had already had for some time for the fractionation of the

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rapeseed, and he also did not submit any earlier drawings or other documents originating from him. According to the statements of the witness Dr. G, it was rather the case that suggestions were received from him - the witness Dr. G - and that these were to realize.

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On the basis of the statements made by Witnesses K and Dr. G, the Senate is convinced that both the invention-based process for peeling rapeseed with process steps (1) to (8) and the device for carrying out this process with features (a) to (c) were developed only after the plaintiff was founded in the course of the oil mill project and that the idea of using the shell parts as biomass for a solid fuel combustion plant for the generation of thermal energy only arose in this course. If the defendant had previously had the idea of peeling rapeseed according to the invention procedure, he would have been expected to express this in the discussions between the parties. But he didn't. It is not disputed that at the time he did not show to any of the persons involved in the project the drawings referred to in Annexes B 1 and B 2 submitted by him in the present case. After the result of the taking of evidence, he also neither reported on his own earlier attempts nor expressed in any other way that it was possible to fall back on an idea which he had had for some time. Had the defendant actually already had such an idea, however, this would have been to be expected. Above all, it would have been obvious to present the procedure according to the invention to the witness Dr. G, who was called in as technical advisor, and to ask him for his expert opinion on this procedure. The defendant does not show a plausible reason why he did not do such a thing and such a reason is also not apparent. Against this background, the Senate considers it to be a pretext that the defendant had already developed the inventive process for peeling rapeseed with all its sophisticated characteristics before the plaintiff was founded. According to the statements of Witnesses K and Dr. G, it can rather be assumed that the inventive process - irrespective of the question of who ultimately contributed what - was only developed in the course of the oil mill project. In any event, the defendant did not claim that he also had the idea of using the shell components as biomass for the solid fuel plant for the generation of thermal energy, for which the independent patent claim 12 claims protection as a claim for use. In its appeal statement of defense of 30.11.2012 (page 2, p. 244a GA) the defendant claimed that this use is merely a consequence of his invention, whereby he obviously meant by invention only the process for peeling the rape seed in accordance with the invention. The fact that the defendant had the idea of using the separated rapeseed shells as biomass for the production of energy was not, moreover, stated by witness L either.

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However, witness L has testified that the method according to the patent application in dispute was known to him approximately since 2005. The defendant had carried out tests at his home in an outbuilding and had shown him the experimental set-up there. There had been a kind of sack in which rapeseed grains had been stored, and from that sack the grains had trickled into a mill. The shells of these grains were then blown away by a fan and the grains were collected in a container. The system consisted of food buckets and a clothes horse. This account does not convince the Senate; the testimony of witness L is not credible. Witness L is the managing director of a GmbH belonging to the defendant and, according to his own statements, maintains a friendly relationship with the defendant. The witness replied only reluctantly to questions from the Senate about his relationship with the defendant.

At first, he even said that he could not answer the question of whether they would visit each other, go dancing or play golf together. While his statements whether he had a friendly relationship with the defendant or not, turned out to be monosyllabic, the information he gave about his visit to the defendant and the experimental set-up described by him gave the impression as if the witness had memorized it. Moreover, the accounts of witness L are not plausible. Since the witness could not give any convincing reason why the defendant should have told him of his alleged idea or shown him an experimental set-up at home. The M GmbH, whose managing director is the witness, is a service enterprise in the range of the fire and water damage reorganization and thus on a completely different area active. Nor does witness L engage in any other private activity concerning the processing of rapeseed or the like. According to his testimony, the witness is friends with the defendant. The friendship goes, as the Senate has learned on repeated demand, but not so far that one undertakes, for example, common leisure activities. Also one obviously does not visit each other at home. The experimental setup, which the witness L claims to have seen, is said to be in the outbuilding on the defendant's private property at the defendant's home. According to the information provided by witness L, M GmbH has a different place of business. Against this background, it is not plausible why the defendant should have shown the witness a test setup at his home. To the extent that witness L suspected that the defendant could have done this out of pride in his achievement, this is not convincing: On the one hand, the defendant did not pursue his alleged "achievement" in the subsequent period, in particular did not initially apply for patent protection, whereby a reason for this is neither proven nor apparent. On the other hand, the defendant - as already stated - did not present his alleged idea later to the plaintiff at the meeting on 13.08.2008, although this time he would have had reason to do so. Ultimately, it is also incomprehensible how the experimental arrangement described by Witness K was used to peel the rape seeds. According to the invention, the rape seeds are introduced into an impact mill in which the shell parts are mechanically broken up. A sufficient impact for the rapeseed grains must be produced so that the shells can be broken open and detached from the core flesh. Only then can the mechanical breaking of the shells succeed. It is not clear how this was achieved by merely trickling the rapeseed grains down into a device which was not described in detail and which witness K considered to be a "mill" or a "peeling apparatus". The Senate therefore assumes that the information given by witness L does not correspond to the truth, but that the witness cannot have seen any order with which the procedure according to the invention could be carried out in accordance with patent claim 1 of the patent application in dispute.

The non-admitted written statement of the defendant received after the end of the oral hearing does not give rise to a different assessment nor to a reopening of the oral hearing (§§ 296a, 156 ZPO). As far as the defendant now for the first time points to friendly relations between the Managing Partner C and, among other things, the witnesses Dr. I and K, he could have questioned the witnesses himself at the evidence hearing. Irrespective of this, the Senate considers the statements of Witnesses K and Dr. I to be credible, even taking into account the relationships now alleged by the defendant.

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With regard to the witness Dr. G, on whose testimony the Senate also relies, the defendant does not claim such connections anyway. Based on the statements of the witnesses the Senate is still convinced that the invention came about before the plaintiff was founded. In that regard, the defendant continues not to claim that it has merely implied to any of the persons involved in the project that it is possible to revert to its earlier ideas. Insofar as he now tries to justify this for the first time by stating that no confidentiality agreement had been concluded with the witness Dr. G, this is not convincing. On the one hand one could have made such an agreement without further ado with the witness Dr. G - and if necessary also with the other witnesses -. Secondly, this does not explain why the defendant did not at least inform C shareholder about an allegedly already existing invention, on which one can rely. It does not matter who made what contribution to the invention.

d) Since the invention on which the application for a patent in dispute is based, according to the result of the taking of witness evidence, was carried out after the plaintiff was founded, the defendant, even if he were to be regarded as the sole inventor, which could be presumed in his favour, was obliged to offer the invention to the plaintiff and to transfer the full right to it to him. He could not and cannot claim compensation from the plaintiff for the transfer of the invention. This follows from the fact that the invention came about as part of a joint project and that the defendant and his co-partner C were equal partners. Each of the two partners contributed his labour to the area assigned to him and waived remuneration for this. Both shareholders were to benefit from the mutual benefits through the plaintiff. Thus, the results of the defendant's activities in the technical field - through the joint company - should also benefit the co-partner C. If the honest contracting parties had thought of the question of the classification of inventions, which was not regulated in the articles of association, they would have agreed against this background that in any event inventions of the company arising within the framework of the development and construction of the oil mill should be due free of charge to the company. Against this background, the plaintiff's memorandum and articles of association are interpreted according to the principles of supplementary interpretation of the contract as meaning that such an invention must be left to the plaintiff. In any case, a corresponding claim to surrender arises here from the duty of loyalty of the defendant. In accordance with the nature and content of the cooperation between the plaintiff's shareholders, it could be expected in good faith (§ 242 BGB) that the success of the defendant's work as managing director and shareholder without payment of any remuneration is due to the joint company and thus to the plaintiff.

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f) The defendant therefore is obliged to assign to the plaintiff the rights arising from the patent application in dispute including the claim to the grant of the German patent. As in the case of the vindication claim under Sec. 8 PatG (see Busse/Keukenschrijver, loc. cit., Sec. 8 para. 11; Benkard/Melullis, loc. cit., Sec. 8 PatG para. 11), the claim asserted, since the defendant has not yet received a patent on the German patent application, is directed to the assignment of the claim to grant of the patent and the rights from the patent application. That is how the plaintiff's appeal must be interpreted. The fact that the plaintiff did not expressly seek assignment of the right to the grant of the (German) patent is harmless;

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it clearly also requests the assignment of the claim to grant the German patent 10 2010 012 8XX.Z, i.e. the procedural position of the defendant as patent plaintiff established by the German patent application. As a precaution, the Senate points out that the subject matter of the appeal pursued by the plaintiff - as it has been the request filed at first instance - is the German patent application 10 2010 012 8XX.Z alone; the Senate is bound by this application (§ 308 German Code of Civil Procedure).

### III.

The decision on costs follows from §§ 91 para. 1, 516 para. 3 sentence 1 ZPO.

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The statement relating to the defendant concerning the loss of the claimant's claim  
The appeal is based on § 516 (3) sentence 1 ZPO.

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The decision on provisional enforceability results from Sections 708 No. 10, 711, 10884.  
Paragraph 1 sentence 1 ZPO.

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There is no reason to admit the revision, because the provisions of § 543 ZPO<sup>85</sup>  
the prerequisites set out above are not met. As an individual decision,  
the case has no fundamental significance within the meaning of § 543  
(2) No. 1.

84

ZPO still require the assurance of a uniform jurisdiction or the further training<sup>86</sup>  
of the law a revision court decision in the sense of § 543 para. 2 no. 2 ZPO.

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Y

Z

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# Geschäftsführeranstellungsvertrag

zwischen

der AusBio R&D Europe GmbH

Fritz Hornschuch Str. 9

95325 Kulmbach

(im folgenden: Gesellschaft)

und

Herrn

Dr. Wolfgang Mann

Hornungsgreuth 22a

95512 Neudrossenfeld

(im folgenden: GF)

## § 1 Pflichten des Geschäftsführers

Der GF führt die Geschäfte der Gesellschaft und hat die verantwortliche Leitung des gesamten Geschäftsbetriebs. Er vertritt die Gesellschaft nach Maßgabe des Gesetzes, des Gesellschaftsvertrages, dieses Anstellungsvertrages und der Weisungen der Gesellschafter.

Bei seiner Tätigkeit hat GF für die wirtschaftlichen, finanziellen und organisatorischen Belange von der Gesellschaft in bester Weise Sorge zu tragen. Er hat die ihm obliegenden Pflichten mit der Sorgfalt eines ordentlichen Kaufmannes wahrzunehmen und ist für die Einhaltung der bestehenden gesetzlichen Verpflichtungen verantwortlich.

GF ist an Weisungen der Gesellschafter gebunden.

An bestimmte Arbeitszeiten ist GF nicht gebunden. Er ist allerdings gehalten, jederzeit zur

Dienstleistung zur Verfügung zu stehen, wenn und soweit das Wohl der Gesellschaft dies verlangt.

## § 2 Vertragsdauer

Der Vertrag tritt am 01. April 2013 in Kraft.

Der Vertrag endet mit Ablauf des 14. August 2016, ohne dass es einer weiteren Kündigung bedarf.

Das Arbeitsverhältnis ist vor diesem Zeitpunkt nur in beiderseitigem Einvernehmen kündbar.

Nach Ausspruch einer Kündigung ist die Gesellschaft berechtigt, GF von der Verpflichtung zur Arbeitsleistung bei Weiterzahlung der Bezüge freizustellen. Ein eventuell noch zustehender Urlaub ist auf die Freistellung anzurechnen.

## § 3 Bezüge

GF erhält ein Jahresgehalt in Höhe von [REDACTED] brutto, zahlbar am jeweiligen Monatsletzen.

Gesellschaft und GF verpflichten sich, über eine Anpassung der Gehaltsvereinbarung zum 1. Januar eines Jahres jeweils zu verhandeln.

Im Krankheitsfall oder bei sonstiger unverschuldeter Verhinderung gelten die gesetzlichen Regelungen.

## § 4 Spesen, Firmenfahrzeug

GF werden angemessene Reisen und Spesenauslagen in dem Umfang erstattet, in dem sie steuerlich anerkannt werden, belegt und tatsächlich ausgelegt worden sind.

#### § 5 Urlaub

Der GF hat Anspruch auf sechs Wochen (30 Arbeitstage) bezahlten Urlaub im Geschäftsjahr. Der Zeitpunkt des Urlaubs ist so einzurichten und erforderlichenfalls abzustimmen, daß den Bedürfnissen der Gesellschaft in jeder Weise Rechnung getragen wird.

#### § 6 Treuepflicht, Betriebsgeheimnisse

GF verpflichtet sich, Dritten gegenüber Stillschweigen über alle ihm anvertrauten oder sonst bekannt gewordenen geschäftlichen, betrieblichen oder technischen Informationen und Vorgänge zu wahren, welche die Gesellschaft betreffen und die internen oder vertraulichen Charakter haben. Diese Pflicht besteht nach Beendigung des Anstellungsverhältnisses fort.

Geschäftliche und betriebliche Unterlagen aller Art einschließlich persönlicher Aufzeichnungen über dienstliche Angelegenheiten dürfen nur zu geschäftlichen Zwecken verwendet werden. Derartige Unterlagen sind sorgfältig aufzubewahren und auf Verlangen jederzeit, spätestens bei Beendigung des Anstellungsverhältnisses auszuhandigen.

#### § 7 Schlußbestimmungen

Änderungen und Ergänzungen dieses Vertrages bedürfen der Schriftform.

Sollten einzelne Bestimmungen dieses Vertrages ganz oder teilweise rechtsunwirksam sein oder werden, so wird hierdurch die Gültigkeit der übrigen Vertragsbestimmungen nicht berührt. Die unwirksame Bestimmung ist dann durch eine rechtsgültige Bestimmung zu ersetzen, die dem erkennbar angestrebten wirtschaftlichen Zweck so nah kommt, als dies rechtlich zulässig ist. Entsprechendes gilt, wenn bei Durchführung dieses Vertrages ergänzungsbedürftige Lücken offenbar werden.

§ 2 Gerichtsstand

Gerichtsstand für beide Vertragspartner ist das für den Sitz der Firma zuständige  
Amtsgericht.

Kulmbach, den

11.04.2013

Gesellschafter

Johnson Z. Wang

AusBio Laboratories Ltd., Yantai

Geschäftsführer

Wolfgang Mann

AusBio R&D Europe GmbH



*[Beginning of certified translation from the German language]*

**Managing Director Employment Agreement**

between

AusBio R&D Europe GmbH

Fritz Hornschuch Str. 9

95326 Kulmbach, Germany  
(hereinafter: Company)

and

Dr. Wolfgang Mann

Hornungsgreuth 22a

95512 Neudrossenfeld, Germany

(hereinafter: Managing Director)

**1. Obligations of the Managing Director**

The Managing Director shall manage the Company's affairs and be responsible for leading the entire business operations. He shall represent the Company in accordance with law, the articles of association, this Employment Agreement and the instructions of the shareholders.

In the scope of his function, the Managing Director shall use his best efforts to handle the economic, financial and organizational affairs of the Company. He shall fulfill his obligations with due commercial care and be responsible for observing the existing statutory obligations.

The Managing Director shall be bound by the instructions of the shareholders.

The Managing Director shall not be bound by certain working hours. However, he shall be

required to be prepared for performing his duties at any time if and to the extent required to inure the benefit of the Company.

## **2. Term of the Agreement**

The Agreement shall enter into force as of April 1, 2013.

The Agreement shall terminate with the expiry of April 14, 2016, without any further notice of termination being necessary.

Before that date, the employment relationship shall solely be terminable by mutual consent.

Upon notice of termination, the Company shall be entitled to release the Managing Director from the obligation to perform his duties and continue to pay remuneration. Any remaining leave entitlements shall be added to the release period.

## **3. Remuneration**

The Managing Director shall receive an annual gross salary in the amount of [REDACTED] payable on the last day of the respective month.

The Company and the Managing Director undertake to negotiate adjustment of remuneration on January 1 of each year.

In the event of sickness or any other inability of the Managing Director to carry out his duties through no fault of his own, the statutory provisions shall apply.

## **4. Expenses, Company Vehicle**

The Managing Director shall be compensated for any reasonable travel and other expenses to the extent recognized for tax purposes, proven and actually disbursed.

## **5. Leave Entitlements**

The Managing Director shall be entitled to six weeks (30 working days) of paid leave per business year. The dates when leave is taken shall be planned and, if necessary, coordinated in such a way that the needs of the Company are met in all respects.

## **6. Obligation of Loyalty, Business Secrets**

The Managing Director undertakes to keep confidential towards third parties any business, operational or technical information and processes which have been entrusted to him or of which he has become aware otherwise and which pertain to the Company and are of internal or confidential nature. This obligation shall continue after termination of the employment relationship.

Any business and operational documents of any kind including personal records on business matters must only be used for business purposes. Such documents shall be kept in a safe place and handed over upon request at any time, at the latest upon termination of the employment relationship.

## **7. Final Provisions**

Any amendments to this Agreements shall be made in writing.

Should individual provisions of this Agreement or parts thereof be or become legally ineffective, this shall not affect the validity of the remaining provisions. The invalid provision shall then be replaced with another valid provision most closely approximating the intended economic purpose of the invalid provision to the extent legally permissible. The same shall apply if any omissions requiring amendment become apparent during the performance of this Agreement.

#### 8. Venue

The venue for both parties to the Agreement shall be the Local Court having jurisdiction over the place of the Company's registered office.

Kulmbach, this [Handwritten: March 2013]

Shareholder

Managing Director

Johnson Z. Wang [Signature: illegible]

[Signature: illegible]  
Wolfgang Mann

AusBio Laboratories Ltd., Yantai

AusBio R&D Europe GmbH

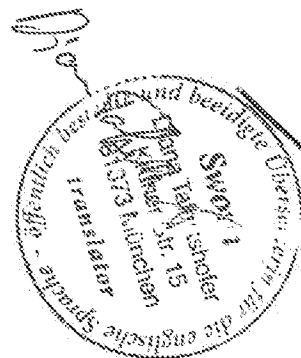
[End of certified translation from the German language]

As translator for the English language duly appointed and sworn in by the President of the Regional Court of Munich I, I certify that the foregoing is, to the best of my knowledge and belief, a true and correct translation of the scanned copy of the German document presented to me.

Munich, this 23<sup>rd</sup> day of August 2018



Diana Tafertshofer



PATRONUS IP • Truderinger Str. 246 • 81825 München

AusBio R&D Europe GmbH  
Fritz Hornschuch Str. 9  
95326 Kulmbach  
Deutschland

Ihr Zeichen  
Your Ref.:

Unser Zeichen  
Our Ref.: **EP-7418 GA/as**

Datum  
Date: **08/07/2013**

**INVOICE NO. 2013-0586**

**European Patent Application: EP13179437.2**  
**Title: Centrifuge and Method for Centrifuging a Reaction Vessel Unit**  
**Applicants: AusBio Laboratories Co., Ltd., AusBio R&D Europe GmbH**

Preparing application text; filing European patent application with the European Patent Office on August 6, 2013; requesting for European Search; paying official fees; reporting to you with our letter of August 7, 2013; disbursements	5,640.00 €
Official fees: -filing fee (115.00 €) -search fee (1,165.00 €) -additional filing fee for the 36th and each subsequent filing (98.00 €)	1,378.00 €

TOTAL (without VAT):	7,018.00 €
VAT:	1,071.60 €
<b>TOTAL (with VAT):</b>	<b>8,089.60 €</b>

  
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Dipl.-Ing.

Rechtsanwältin  
Nadine Friesse

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Dipl.-Chemikerin

Dr. Isabella Schumann  
Dipl.-Biologin

Georg Schmitz  
Dipl.-Ing. (Biotechn.)

Rechtsanwalt  
Stephan Blaschke

member of  
**EURATTORNEYS**

Exhibit 34

Petition Pursuant to 37 CFR 1.46(b)(2)  
Application No. 14/940,681

REEL: 049669 FRAME: 0267

PATRONUS IP · Neumarkter Str. 18 · 81673 München

Yantai AusBio Laboratories Co., Ltd.  
No. 2 Huashan Road, Yeda  
264006 Yantai  
China

Ihr Zeichen

Your Ref.: **Probenträger-Zentrifuge II**

Unser Zeichen

Our Ref.: **AUS1003PWO GA/yn**

Datum

Date: **08/08/2014**

**INVOICE NO. 2014-0686**

**PCT-Application: PCT/EP2014/066947**

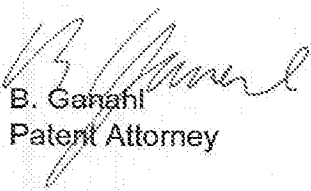
**Title: Centrifuge and Method for Centrifuging a Reaction Vessel Unit**

**Applicant: AusBio Laboratories Co., Ltd., AusBio R&D Europe GmbH**

Taking over the representation of an International patent application; 3,490.00 €  
Revising the European priority application;  
Preparing the formal filing documents;  
Filing the application with the EPO on August 6, 2014;  
Claiming one priority;  
Designating the inventors;  
Requesting search;  
Report to you with our letter of today;  
Disbursements

Official fees: 3,226.00 €  
Transmittal fee (130.00 €);  
Search fee (1,875.00 €);  
Application fee (1,084.00 €);  
Fee for extra pages (300.00 €);  
Reduction for electronic filing (-163.00 €)

**TOTAL (attorney's fee): 3,490.00 €**  
**TOTAL (official fee): 3,226.00 €**  
**TOTAL (with VAT): 6,716.00 €**

  
**B. Ganahl**  
Patent Attorney

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Dr. Isabella Schumann  
Dipl.-Biologin

Georg Schmitz  
Dipl.-Ing. (Biotechn.)

Rechtsanwalt  
Stephan Blagosch

member of  
**EURATTORNEYS** 

**Exhibit 35**

Petition Pursuant to 37 CFR 1.45(B)(2)

Application No. **PA-14-0686**  
www.patronus-ip.com

**REEL: 049669 FRAME: 0268**



BeckRS 9998, 16078

**BGH, Urteil vom 16. 10. 1997 - IX ZR 164-96 (Nürnberg)****Titel:**

Bedeutung nachträglichen Verhaltens im Bürgschaftsrecht

**Normenketten:**

BGB §§ 133, 157; AGBG §§ 1, 24?a; ZPO § 296?a

**Leitsätze:****Zur Bedeutung des nachträglichen Verhaltens der Vertragspartner für die Auslegung ihres Bürgschaftsvertrags.****Tatbestand (gekürzt):**

Die Kl. nimmt den Bekl. als Bürgen in Anspruch wegen Verbindlichkeiten der S-GmbH (fortan: GmbH oder Hauptschuldnerin), deren Geschäftsführer und Mehrheitsgesellschafter der Bekl. war. In der von der Kl. vorbereiteten, vom Bekl. unterzeichneten "Bürgschaftsurkunde" vom 28. 4. 1994 heißt es u.ä.: Die (Kl.) als "Auftragnehmer" und die GmbH als "Auftraggeber . . . schließen Baustoff-Lieferungsverträge für jeweils genannte Bauvorhaben ab. Als Sicherheit für die vertragsgemäße Erfüllung der Zahlungspflicht ist dem Auftragnehmer eine Bürgschaft in Höhe von 100 % der Auftrags--Abrechnungs-Summe (einschließlich) Mehrwertsteuer) zu stellen. Dies vorausgeschickt, übernehme ich . . . (Name und Anschrift des Bekl.) hiermit für den Auftraggeber die unwiderrufliche, selbstschuldnerische Bürgschaft und verpflichten uns, jeden Betrag bis zu einer Gesamthöhe von 817350,41 DM . . . an den Auftragnehmer auf erstes Anfordern zu zahlen. Auf die Einreden der Anfechtung, der Aufrechnung und der Vorausklage gem. §§ 768, 770 und 771 BGB wird verzichtet. § 776 BGB kommt nicht zur Anwendung." Damals bestanden Kaufpreisforderungen der Kl. gegen die Hauptschuldnerin aus Baustofflieferungen in Höhe des Bürgschaftsbetrags. Nach Übernahme der Bürgschaft lieferte die Kl. an die Hauptschuldnerin weitere Baustoffe für mehrere Bauvorhaben. Dafür berechnete die Kl. 647108,73 DM, die nach Ansicht des Bekl. nicht verbürgt worden sind. Über das Vermögen der Hauptschuldnerin wurde 1995 das Konkursverfahren eröffnet.

Das LG hat die streitige Bürgschaftsforderung wegen der Rechnungen, die die Kl. nach der Bürgschaftserklärung erteilt hat, zuerkannt, das OLG hat die Klage insoweit abgewiesen. Mit ihrer Revision begehrte die Kl., das Urteil des LG wiederherzustellen. Die Revision führte insoweit, als die Klage abgewiesen worden ist, zur Aufhebung des Berufungsurteils und zur Zurückverweisung der Sache (§§ 564, 565 I 1 ZPO); von der Möglichkeit des § 565 I 2 ZPO hat der Senat Gebrauch gemacht.

**Entscheidungsgründe (gekürzt):**

I. Das BerGer. hat ausgeführt: Dem Wortlaut der Bürgschaftsurkunde könne die verbürgte Verbindlichkeit nicht zweifelsfrei entnommen werden. Die Auslegung ergebe mit Rücksicht auf die Entstehungsgeschichte und den Zweck der Bürgschaft, daß diese nur die bei Übernahme bestehende Forderung von 817350,41 DM umfasse. Der Bekl. habe die ihm von der Kl. übersandte Bürgschaftserklärung unterzeichnet, weil die Kl. mit Schreiben vom 19. 4. 1994 einen Zah-

Exhibit 36

Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/910,681

<https://beck-online.beck.de/Print/CurrentMagazine?vpath=bibdata%5Cents%5Cbeckp%5C1022019>

REEL: 049669 FRAME: 0269

lungsaufschub in Aussicht gestellt habe. Der spätere Schriftwechsel zwischen der Kl. und der Hauptschuldnerin sei nicht zu berücksichtigen.

II. Diese Erwägungen halten einer rechtlichen Nachprüfung nicht stand.

1. Nach dem vorliegenden Sach- und Streitstand hat das BerGer. den Bürgschaftsvertrag der Parteien zu Recht als individuelle Vereinbarung und nicht als Formularvertrag i.S. des § 1 I AGBG ausgelegt (vgl. zum verschiedenen Auslegungsmaßstab: BGH, NJW-RR 1996, 375 = LM H. 5-1996 StBGebV Nr. 1). Die Parteien haben nicht vorgetragen, daß der von der Kl. verwendete Entwurf einer Bürgschaftserklärung für eine Vielzahl von Verträgen aufgestellt worden sei. Der für einen bestimmten Vertrag ausgearbeitete Entwurf fällt, soweit – wie hier – § 247a AGBG noch nicht anzuwenden ist, nicht unter AGB gem. § 1 I AGBG (BGH, NJW 1988, 57 = LM § 1 AGBG Nr. 10 = WM 1987, 1430 [1431]; NJW 1989, 2683 [2685] = LM § 622 BGB Nr. 6).

2. Weiterhin ist das BerGer. nach dem Zusammenhang seiner Ausführungen zutreffend davon ausgegangen, daß die Parteien trotz des Wortlauts der Urkunde keine Bürgschaft auf erstes Anfordern, sondern eine schlichte selbstschuldnerische Bürgschaft vereinbart haben (vgl. BGH, NJW 1992, 1446 = LM H. 8-1992 § 765 BGB Nr. 81). Etwas anderes haben auch die Parteien nicht geltend gemacht.

3. Die tatrichterliche Auslegung des Umfangs der Bürgschaftsverpflichtung der Parteien bindet den Senat nicht. Die Revision rügt mit Erfolg, daß das BerGer. wesentliche Tatsachen rechtsfehlerhaft außer acht gelassen hat. Der Bürge muß seine Erklärung so gegen sich gelten lassen, wie sie aus der Sicht des Gläubigers mit Rücksicht auf die ihm erkennbaren Umstände aufzufassen ist. Für diesen objektiven Erklärungswert ist in erster Linie der Wortlaut der Bürgschaftsurkunde maßgeblich. Begleitumstände können in die Auslegung einbezogen werden, soweit sie für den Gläubiger einen Schluß auf den Sinngehalt der Bürgschaftserklärung zulassen (BGH, NJW-RR 1993, 945 = LM H. 10-1993 § 765 BGB Nr. 85 = WM 1993, 1141).

a) Das BerGer. hat zutreffend angenommen, daß die Bürgschaftserklärung des Bekl. der Auslegung bedarf. Entgegen der Ansicht der Revision ergibt der Wortlaut nicht eindeutig, daß – neben der damals bestehenden Forderung der Kl. gegen die Hauptschuldnerin – auch künftige Kaufpreisansprüche wegen weiterer Baustofflieferungen bis zum angegebenen Höchstbetrag verbürgt worden sind. Die Bürgschaftssumme von 817350,41 DM kann darauf hindeuten, daß nur die entsprechende, bei Abschluß des Bürgschaftsvertrags bestehende Forderung der Kl. gegen die Hauptschuldnerin verbürgt worden ist. In der Urkunde fehlt auch die Bezeichnung "Höchstbetragsbürgschaft". Andererseits kann für die Verbürgung künftiger Forderungen folgendes sprechen: Als Anlaß ist vom Bürgen "vorausgeschickt" worden, daß die Hauptschuldnerin und die Kl. Verträge über Baustofflieferungen für jeweils genannte Bauvorhaben "abschließen" (nicht: abschlossen) und als Sicherheit für die vertragsmäßige Erfüllung der Zahlungsverpflichtung der Kl. eine Bürgschaft in Höhe der vollen Auftrags- und Abrechnungssumme zu stellen ist. In seiner Bürgschaft hat sich der Bekl. verpflichtet, "jeden Betrag bis zu einer Gesamthöhe von 817350,41 DM" an die Kl. zu zahlen.

Das BerGer. hat – dies ist zulässig – abgestellt auf die Entstehungsgeschichte des Bürgschaftsvertrags (vgl. dazu BGH, NJW 1987, 2437 [2438] = LM § 15 GmbHG Nr. 22) sowie auf den Zweck und die damit verbundene Interessenlage (vgl. BGHZ 109, 19 [22] = NJW 1990, 441 = LM § 847 BGB Nr. 81). Die Schreiben der Kl. vom 11. und 19. 4. 1994 konnten von der Hauptschuldnerin dahin gewertet werden, daß die Kl. Zug um Zug gegen die Bürgschaftsübernahme ihre damals bestehende Forderung stunden und von gerichtlichen Maßnahmen absehen wollte. Allerdings kann sich bei der gebotenen Gesamtwürdigung aller Umstände ergeben, daß der im Schreiben der Kl. vom 19. 4. 1994 angebotene "Zahlungsaufschub von 14 Tagen" nicht der einzige Zweck der Bürgschaft gewesen ist. Ein solches Entgegenkommen hätte der Bekl. als zu ge-

Exhibit 36

Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/910,681

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ring für eine Bürgschaft ansehen können. Deswegen ist es nicht ausgeschlossen, daß die Parteien einen weitergehenden Zweck mit der Bürgschaft verbunden haben.

b) Die Revision entnimmt vor allem dem Schriftwechsel zwischen der Kl. und der Hauptschuldnerin nach der Bürgschaftsübernahme, daß Zweck der Bürgschaft gewesen sei, die weitere Belieferung der Hauptschuldnerin mit Baustoffen – für mehrere Bauvorhaben – zu sichern. Das nachträgliche Verhalten von Vertragspartnern kann zwar den bei Vertragsschluß zum Ausdruck gebrachten objektiven Gehalt der wechselseitigen Vertragserklärungen nicht mehr beeinflussen (BGH, NJW 1988, 2878 [2879] = LM § 133 [B] BGB Nr. 30). Es kann aber für die Auslegung bedeutsam sein, weil es Anhaltspunkte für den tatsächlichen Vertragswillen enthalten kann (BGH, LM H. 5–1994 § 44 LwAnpG Nr. 22 = WM 1994, 267 [268]; NJW 1993, 1325 = LM H. 9–1993 § 675 BGB Nr. 185 = WM 1993, 1197 [1200]?).

In ihren Schreiben an die Kl. vom 13., 15. und 28. 7. 1994 – also etwa drei Monate nach der Bürgschaftsübernahme – hat die Hauptschuldnerin eindeutig zum Ausdruck gebracht, daß die Bürgschaft die "Warenkreditlinie" sichere, die die Kl. – gemäß

ihrem Schreiben vom 13. 7. 1994 – der Hauptschuldnerin "nach wie vor" in Höhe von 407000 DM eingeräumt hatte. Dementsprechend hat die Hauptschuldnerin in ihrem Schreiben an die Kl. vom 13. 12. 1994 die Inanspruchnahme aus der Bürgschaft abgelehnt, weil durch Lieferungsverzögerungen und mangelhafte Ausführung erhebliche Kosten entstanden seien, nicht aber, weil die Bürgschaft künftige Forderungen nicht gesichert habe. Diese Mitteilungen sprechen für den von der Kl. behaupteten Vertragsinhalt, falls die Schreiben vom Bekl. als Geschäftsführer der Hauptschuldnerin stammen oder von diesem gebilligt worden sind. Der Bekl. hat bisher nicht erläutert, aus welchem Grunde diese Schreiben ohne sein Wissen und seine Zustimmung herausgegangen sein sollen (§ 138 ZPO). Die Revision rügt zu Recht, daß das BerGer. diese Umstände rechtsfehlerhaft außer acht gelassen hat.

Entgegen der tatrichterlichen Feststellung hat die Kl. – im ersten Rechtszuge – hinreichend zum Ausdruck gebracht, der Bekl. habe die Schreiben der Hauptschuldnerin vom 13. und 28. 7. 1994 veranlaßt. Für die Richtigkeit dieser Behauptung kann folgendes sprechen: Diese Mitteilungen und das Schreiben der Hauptschuldnerin vom 15. 7. 1994 tragen die Überschrift "Geschäftsleitung". Die Schreiben der Hauptschuldnerin vom 13. und 28. 7. 1994 sowie vom 13. 12. 1994 sind "i. d. A." unterzeichnet worden; das letztgenannte Schreiben enthält das Diktatzeichen "HGS" des Bekl. Die Mitteilung der Hauptschuldnerin vom 15. 7. 1994 wurde von "G S" unterschrieben.

Das BerGer. durfte dieses Vorbringen der Kl. nicht gem. § 296a ZPO zurückweisen. Entgegen seiner Ansicht war es unschädlich, daß die Kl. auf diesen Vortrag in ihrer Berufungserwiderung nur allgemein Bezug genommen hat. Nachdem die Kl. im ersten Rechtszuge obsiegt hatte, durfte sie darauf vertrauen, daß das BerGer. auf seine abweichende Beurteilung rechtzeitig hinwies und, falls dies unterblieb, ihr erstinstanzliches Vorbringen berücksichtigte und, soweit erforderlich, Gelegenheit zur Ergänzung gab (§§ 139, 278 III ZPO; vgl. BGH, NJW 1981, 1378; NJW 1982, 581 = MDR 1982, 29). Ein solcher Hinweis des BerGer. ergibt sich weder aus den Protokollen noch aus dem übrigen Akteninhalt. Der in der Sitzung am 22. 2. 1996 geschlossene – widerrufene – Vergleich spricht gegen einen Hinweis.

c) Aus demselben Grunde durfte das BerGer. die weitere erstinstanzliche, unter Beweis gestellte Behauptung der Kl., der Bekl. habe bei einer Besprechung am 26. 7. 1994 erklärt, seine Bürgschaft beziehe sich auch auf die nach deren Übernahme entstandenen Verbindlichkeiten der Hauptschuldnerin, nicht gem. § 296a ZPO unberücksichtigt lassen.

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Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/910,681

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d) Demnach ist zur Feststellung des Vertragsinhalts noch zu klären, ob der Bekl. gemäß dem – streitigen Klagevortrag zum Ausdruck gebracht hat, er habe auch künftige Forderungen der Kl. aus Baustofflieferungen an die Hauptschuldnerin verbürgt.

4. Sollte die Gesamtwürdigung der erwiesenen maßgeblichen Umstände einen solchen weiten Sicherungszweck der Bürgschaft ergeben, so wären die verbürgten künftigen Verbindlichkeiten der Hauptschuldnerin aus den bei Abschluß des Bürgschaftsvertrags vorgesehenen weiteren Baustofflieferungen der Kl. genügend bestimmt gewesen (§ 765 II BGB; vgl. BGHZ 25, 318 [319] = NJW 1957, 1873 = LM § 765 BGB Nr. 2). Außerdem hätte dann die verbürgte Hauptschuldnerin einen hinreichenden Niederschlag in der Bürgschaftsurkunde gefunden; aus den ersten drei Absätzen ergäbe sich ein solcher Bürgschaftsgegenstand in einer wenigstens individuell bestimmbaren Weise, wie bereits dargelegt worden ist (§ 766 S. 1 BGB; vgl. BGH, NJW 1995, 1886 = LM H. 9–1995 § 766 BGB Nr. 29). Gegen die Rechtswirksamkeit einer Bürgschaft des Bekl. mit einer solchen weiten Zweckerklärung bestünden keine Bedenken. Der Geschäftsführer und Mehrheitsgesellschafter einer GmbH, der sich für deren künftige Verbindlichkeiten verbürgt, bedarf des Schutzes des § 767 I 3 BGB nicht, weil er eine Erweiterung seines Haftungsrisikos vermeiden kann (Vgl. BGHZ 130, 19 [30] = NJW 1995, 2553 = LM H. 11–1995 § 765 BGB Nr. 99 – 101; BGH, NJW 1996, 3205 = ZIP 1997, 449).

Dann bliebe noch zu prüfen, ob die Hauptschuldnerin gegen den Vergütungsanspruch der Kl. wegen Baustofflieferungen, die nach der Bürgschaftsübernahme des Bekl. vorgenommen worden sind, mit den Forderungen in Höhe von 147011,91 DM rechtswirksam aufgerechnet hat, die im Schreiben der Hauptschuldnerin an die Kl. vom 10. 11. 1994 sowie wegen einer Vertragsstrafe infolge Lieferungsverzugs geltend gemacht worden sind. Nach der Feststellung des LG sind die "Geschäftsbedingungen" der Kl. Bestandteil der Lieferverträge geworden. Der in Nr. 7 dieser AGB enthaltene vollständige Ausschluß einer Aufrechnung für den Fall, daß die Vertragspartner – wie hier – Kaufleute sind, ist unwirksam (§§ 9, 11 Nr. 3, 24 S. 2 AGBG; vgl. BGHZ 91, 375 [383ff.] = NJW 1984, 2404 = LM § 366 BGB Nr. 14; BGHZ 92, 312 [315ff.] = NJW 1985, 319 = LM § 9 [C] AGBG Nr. 3). Die Kl. hat den zur Aufrechnung gestellten Gegenanspruch in Höhe von 17000 DM anerkannt. Im übrigen wäre zu klären, ob die weitergehenden Gegenforderungen bestehen. Der im Bürgschaftsvertrag vereinbarte Verzicht auf die "Einrede . . . der Aufrechnung" hindert die von der Hauptschuldnerin erklärte Aufrechnung nicht, weil er nur das Recht des Bürgen betrifft, selbst die dem Hauptschuldner zustehenden Einreden gegen die Bürgschaftsforderung geltend zu machen (§ 768 BGB; vgl. BGHZ 107, 210 [214] = NJW 1989, 1853 = LM § 550?b BGB Nr. 1).

5. Sollte der Bekl. nur für die bei Abschluß des Bürgschaftsvertrags bestehende Forderung der Kl. gegen die Hauptschuldnerin eintreten müssen, so wäre er – entgegen der Ansicht der Revision – in der Folgezeit nicht nach Treu und Glauben (§ 242 BGB) gehalten gewesen, die Kl. darauf hinzuweisen, daß sie rechtsirrtümlich einen weitergehenden Bürgschaftsumfang annahm.

Zitiervorschlag:

BGH Ur. v. 16.10.1997 – IX ZR 164–96, BeckRS 9998, 16078

**German Federal Court of Justice, judgment dated October 16, 1997 - IX ZR 164-96 (Nuremberg)**

**Title:**

Significance of subsequent conduct in guarantee law

**Provisions:**

German Civil Code Secs. 133, 157; German Law on General Terms and Conditions Secs. 1, 24 lit. a;  
German Code of Civil Procedure Sec. 296 lit. a

**Head notes:**

On the significance of subsequent conduct by contractual parties for the interpretation of their guarantee agreement.

**Statement of fact (abridged):**

The Plaintiff asserts claims against the Defendant, in its role as guarantor, due to liabilities of S-GmbH (referred to as GmbH or principal debtor hereinafter); the Defendant was the latter's managing director and majority partner. The instrument of guarantee prepared by the Plaintiff and signed by the Defendant, dated April 28, 1994, states, among other things: The (Plaintiff), in its capacity as the "contractor", and the GmbH, in its capacity as the "customer", ... conclude agreements on the supply of construction materials for building development projects specifically mentioned in each case. A guaranty for 100% of the job order sum (VAT included) shall be provided to the contractor as a security for the performance of the obligation to pay under the agreement. NOW THEREFORE, in consideration of the foregoing, I ... (name and address of the Defendant) hereby assume the irrevocable guarantee for the customer, creating a primary liability, and undertake to pay ... to the contractor any amount up to a total amount of DM 81,350,41 upon first request. The defenses of voidability, set-off and unexhausted remedies pursuant to Secs. 768, 770 and 771 German Civil Code (BGB) are waived. Sec. 776 German Civil Code does not apply." Back then, the Plaintiff had claims from purchase prices against the principal debtor in the amount covered by the guarantee which had originated in deliveries of construction materials. After the guarantee was assumed, the Plaintiff supplied the principal debtor with additional construction materials for several building development projects. The Plaintiff charged DM 64,108,73 for these materials; in the Defendant's opinion, no

guarantee had been assumed for said amount. The insolvency proceedings with regard to the assets of the principal debtor were initiated in 1995.

The *Regional Court* awarded the claim from the guarantee at issue based on the invoices which the Plaintiff issued after the statement of guarantee; the *Higher Regional Court* dismissed the complaint in this regard. With its appeal on points of law, the Plaintiff sought to restore the judgment rendered by the *Regional Court*. Insofar as the complaint was dismissed, the appeal on points of law rescinded the judgment in the appeal proceedings and referred the matter back (Secs. 564, 565 (I) (1) German Code of Civil Procedure); the *Senate* used the option of Sec. 565 (I) (2) German Code of Civil Procedure.

**Grounds for the decision (abridged):**

I. The appellate court elucidated: The guaranteed liability cannot be gathered beyond any doubt from the wording of the instrument of guarantee. Taking the history of its origin and the purpose of the guarantee into account, the interpretation results in the conclusion that it only covers the debt in the amount of DM 81,350,41 which existed at the time the guarantee was assumed. The Defendant signed the statement of guarantee sent to them by the Plaintiff because the Plaintiff offered the possibility of granting deferred payment in its letter dated April 19, 1994. The correspondence that took place later between the Plaintiff and the principal debtor is not to be taken into consideration.

II. These considerations do not withstand legal review.

1. According to the present facts and status of the dispute, the appellate court correctly interpreted the agreement on the guarantee between the parties to be an individual agreement instead of a standard-form agreement within the meaning of Sec. 1 (I) German Law on General Terms and Conditions (AGBG) (for the different standard regarding interpretation, cf.: German Federal Court of Justice, NJW-RR 1996, 375 = LM H. 5--1996 StBGebV no. 1). The parties did not submit that the draft of a statement of guarantee used by the Plaintiff was prepared for a plurality of agreements. The draft prepared for a specific agreement is not classified as general terms and conditions pursuant to Sec. 1 (I) German Law on General Terms and Conditions if it does not fall under Sec. 24 lit. a German Law on General Terms and Conditions – as is the case here (German Federal Court of Justice, NJW 1988, 57 = LM Sec. 1 German Law on General Terms and Conditions no. 10 = WM 1987, 1430 [1431]; NJW 1989, 2683 [2685] = LM Sec. 622 German Civil Code no. 6).

2. Furthermore, according to the context of its explanations, the appellate court correctly assumed that the parties did not agree on a guarantee upon first request in spite of the wording of the instrument, but merely a simple guarantee creating a primary liability (cf. German Federal Court of Justice, NJW 1992, 1446 = LM H. 8--1992 § 765 German Civil Code no. 81). The parties did not assert anything else either.

Exhibit 36

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3. The interpretation by the judge adjudicating on the facts of the scope of the obligation of guarantee of the parties is not binding for the *Senate*. The statement of appeal on points of law successfully criticizes that the appellate court failed to consider essential facts in a manner which is erroneous in law. The guarantor has to accept its statement in the way it is understood from the perspective of the creditor considering the circumstances discernible for the latter. The wording of the instrument of guarantee is primarily relevant for this objective nature of declaration. Accompanying circumstances may be considered regarding interpretation insofar as they enable the creditor to draw any conclusion regarding the meaning of the statement of guarantee (German Federal Court of Justice, NJW-RR 1993, 945 = LM H. 10-1993 Sec. 765 German Civil Code no. 85 = WM 1993, 1141).

a) The appellate court correctly assumed that the Defendant's statement of guarantee requires interpretation. Contrary to the opinion stated in the appeal on points of law, it cannot unambiguously be gathered from the wording that a guarantee for future claims for purchase prices due to additional deliveries of construction material up to the indicated maximum amount was also assumed – in addition to the claim the Plaintiff had against the principal debtor at that time. The guaranteed amount of DM 81,350.41 may suggest that a guarantee was only assumed for the corresponding claim which the Plaintiff had against the principal debtor at the time the guarantee agreement was concluded. The term "guarantee limited in amount" is also missing from the instrument. However, the following may suggest that a guarantee was assumed for future claims: The guarantor stated in the preamble that the principal debtor and the Plaintiff "conclude" (not have concluded) agreements on the supply of construction materials for building development projects specifically mentioned in each case and that a guarantee in the amount of the entire job order sum shall be provided to the Plaintiff as a security for the performance of the obligation to pay under the agreement. In its guarantee, the Defendant undertook to pay to the Plaintiff "any amount up to a total amount of DM 81,350.41".

The appellate court based its decision on the history of the origin of the guarantee agreement (in this regard, cf. German Federal Court of Justice, NJW 1987, 2437 [2438] = LM Sec. 15 German Limited Liability Companies Act (GmbHG) no. 22) and on the objective and the associated situation of interests (cf. German Federal Court of Justice in Civil Matters 109, 19 [22] = NJW 1990, 441 = LM Sec. 847 German Civil Code no. 81) – which is admissible. The principal debtor could assess the Plaintiff's letters dated April 11 and 19, 1994 in such a manner that the Plaintiff wanted to grant deferral of repayment of the claim that existed at the time contemporaneously with the assumption of the guarantee and abstain from taking judicial action. If, however, all circumstances are assessed, which is imperative, this may show that the "grant of deferring payments for 14 days" offered in the Plaintiff's letter dated April 19, 1994 was not the only objective of the guarantee. The Defendant may have deemed such concessions to be insufficient in exchange for a guarantee. Therefore, it cannot be excluded that the parties attached a further object to the guarantee.

b) The statement of appeal on points of law mainly bases its statement that the objective of the guarantee was securing the continued supply of construction materials to the primary debtor -- for several building development projects -- on the correspondence that took place between the Plaintiff and the principal debtor after the assumption of the guarantee. The subsequent conduct of contractual parties admittedly cannot have a retroactive influence on the objective content of the mutual contractual declaration expressed when the agreement was concluded (German Federal Court of Justice, NJW 1988, 2878 [2879] = LM Sec. 133 [B] German Civil Code no. 30); however, it may be significant for interpretation because it may contain indications of the actual intention of the contracting parties (German Federal Court of Justice, LM H. 5--1994 Sec. 44 LwAnpG no. 22 = WM 1994, 267 [268]; NJW 1993, 1325 = LM H. 9--1993 Sec. 675 German Civil Code no. 185 = WM 1993, 1197 [1200]).

In its letters to the Plaintiff dated July 13, 15 and 28, 1994 -- i.e. about three months after the guarantee had been assumed -- the principal debtor unambiguously expressed that the guarantee secures the "line of commodity loans" in the amount of DM 40,000 which the Plaintiff had "still" granted the principal debtor according to its letter dated July 13, 1994.

Accordingly, in its letter to the Plaintiff dated December 13, 1994, the principal debtor opposed the assertion of claims arising from the guarantee, stating that considerable costs had been incurred due to delays in delivery and deficient performance, not because the guarantee did not cover future claims. These communications support the Plaintiff's allegations regarding the content of the agreement if the letters originate from, or were approved by, the Defendant in its capacity as the managing director of the principal debtor. Thus far, the Defendant did not elucidate why these letters were supposedly sent without the Defendant's knowledge and consent (Sec. 138 German Code of Civil Procedure). The statement of appeal on points of law correctly criticizes that the appellate court failed to consider these relevant facts in a manner which is erroneous in law.

Contrary to the declaration of the judge adjudicating on the facts, in the first instance, the Plaintiff sufficiently stated that the Defendant prompted the letters of the principal debtor dated July 13 and 28, 1994. The following aspects suggest that this allegation is correct: These communications and the letter by the principal debtor dated July 15, 1994 bear the heading "management". The letters by the principal debtor dated July 13. and 28., 1994 and dated December 13, 1994 signed "I.A." [by proxy]; the letter mentioned last contains the Defendant's abbreviation "HGS". The communication of the principal debtor dated July 15, 1994 was signed by "G S".

It was not admissible for the appellate court to reject this submission by the Plaintiff pursuant to Sec. 296 lit. a German Code of Civil Procedure. Contrary to its opinion, the fact that the Plaintiff only made general reference to this submission in its response to the appeal was innocuous. After the Plaintiff had prevailed in the first instance, it could trust that the appellate court would indicate a



deviating assessment in due time or, in case this did not happen, would take the Plaintiff's submissions in the first instance into consideration and provide it with the opportunity of supplementing such submissions, if necessary (Secs. 139, 278 (III) German Code of Civil Procedure; cf. German Federal Court of Justice, NJW 1981, 1378; NJW 1982, 581 = MDR 1982, 29). Such an indication by the appellate court cannot be gathered from the minutes or the remaining content of the files. The settlement concluded during the hearing on February 22, 1996 -- and revoked later -- suggests that no indication was given.

c) For the same reason, the appellate court was not allowed to refuse, pursuant to Sec. 296 lit. a German Code of Civil Procedure, to consider the Plaintiff's further allegation in the first instance, for which evidence was provided, that the Defendant declared during a meeting on July 26, 1994 that their guarantee also covers the liabilities of the principal debtor incurred after the guarantee was assumed.

d) So, what needs to be clarified in order to determine the content of the agreement is whether, in accordance with the disputed submission in the complaint, the Defendant expressed that they also assumed a guarantee for claims the Plaintiff would have in the future from deliveries of construction materials to the principal debtor.

4. Should the assessment of all proven relevant circumstances lead to the conclusion that the guarantee also had the purpose of providing such additional security, the future liabilities of the principal debtor, for which a guarantee was assumed, would have been sufficiently defined based on the further deliveries by of construction materials by the Plaintiff provided when the guarantee contract was concluded (Sec. 765 (II) German Federal Court of Justice; cf. German Federal Court of Justice in Civil Matters 25, 318 [319] = NJW 1957, 1873 = LM Sec. 765 German Civil Code no. 2). Moreover, in that case, the primary debt, for which a guarantee was assumed, would have been sufficiently reflected by the instrument of guarantee; such subject matter of the guarantee would arise from the first three paragraphs in a manner which can at least be determined individually, as elucidated above (Sec. 766 sentence 1 German Civil Code; cf. German Federal Court of Justice, NJW 1995, 1886 = LM H. 9-1995 Sec. 766 German Civil Code no. 29). There would not be any concerns about the legal effectiveness of a guarantee by the Defendant with such an additional debt-securing agreement. The managing director and majority partner of a GmbH assuming a guarantee for the partnership's future liabilities does not require the protection of Sec. 767 (I) (3) German Civil Code because they may avoid an expansion of their risk of liability (cf. German Federal Court of Justice in Civil Matters 130, 19 [30] = NJW 1995, 2553 = LM H. 11-1995 Sec. 765 German Civil Code no. 99 -- 101; *German Federal Court of Justice*, NJW 1996, 3205 = ZIP 1997, 449).

What would still need to be examined is whether the principal debtor set off in a legally effective manner the claims in the amount of DM 14,011.91 from Plaintiff's compensation claim due to

deliveries of construction materials which were performed after the guarantee was assumed by the Defendant; said amount was claimed in the letter from the principal debtor to the Plaintiff dated November 10, 1994 and due to a contractual penalty for delayed delivery. According to the declaration of the *Regional Court*, the Plaintiff's "general terms and conditions" have become a part of the supply agreements. The complete exclusion of a set-off in case the contractual partners are merchants – as is the case here – included in no. 7 of these general terms and conditions is invalid (Secs. 9, 11 no. 3, 24 sentence 2 German Law on General Terms and Conditions; cf. German Federal Court of Justice in Civil Matters 91, 375 [383 lit. f.] = NJW 1984, 2404 = LM Sec. 366 German Civil Code no. 14; German Federal Court of Justice in Civil Matters 92, 312 [315 et seq.] = NJW 1985, 319 = LM Sec. 9 [C] German Law on General Terms and Conditions no. 3). The Plaintiff acknowledged the counterclaim in the amount of DM 1,000 demanded for offsetting it. Apart from that, what would need to be clarified is whether further counter demands exist. The waiver of the "defense...of set-off" agreed in the guarantee agreement is not an obstacle to setting off according to the declaration of the principal debtor because it only concerns the guarantor's right to assert the defenses to which the principal debtor is entitled against the claim from the guarantee (Sec. 768 German Civil Code; cf. German Federal Court of Justice in Civil Matters 107, 210 [214] = NJW 1989, 1853 = LM Sec. 550 lit. b German Civil Code no. 1).

5. Should the Defendant only be liable for the Plaintiff's claims against the principal debtor existing at the time of conclusion of the guarantee agreement – contrary to the opinion postulated in the appeal on points of law – they would not have been obliged in good faith (Sec. 242 German Civil Code) to point out to the Plaintiff later that it assumed a broader scope of the guarantee in a manner erroneous in law.

Proposal for citation:

German Federal Court of Justice, judgment dated October 16, 1997 – IX ZR 164–96, BeckRS 9998, 16078

As an English translator duly appointed and sworn by the Regional Court of Munich I, I certify that, to the best of my knowledge and belief, the above translation is a true and correct translation of the German document presented to me.

Munich, February 25, 2019



Saskia Ettling



Exhibit 36



Übersetzung des Bürgerlichen Gesetzbuches durch ein Übersetzer-Team des Langenscheidt Übersetzungsservice. Laufende Aktualisierung der Übersetzung durch Neil Mussett und in seiner Nachfolge durch Samson Übersetzungen GmbH, Dr. Carmen v. Schöning.

Translation provided by the Langenscheidt Translation Service. Translation regularly updated by Neil Mussett and most recently by Samson Übersetzungen GmbH, Dr. Carmen v. Schöning.

Stand: Die Übersetzung berücksichtigt die Änderung(en) des Gesetzes durch Artikel 4 Abs. 5 des Gesetzes vom 1. Oktober 2013 (BGBl. I S. 3719).

Version information: The translation includes the amendment(s) to the Act by Article 4 para. 5 of the Act of 1 October 2013 (Federal Law Gazette I p. 3719).

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## German Civil Code

### BGB

Full citation: Civil Code in the version promulgated on 2 January 2002 (Federal Law Gazette [Bundesgesetzblatt] I page 42, 2909; 2003 I page 738), last amended by Article 4 para. 5 of the Act of 1 October 2013 (Federal Law Gazette I page 3719)

This statute serves to transpose into national law the following directives:

1. Council Directive 76/207/EEC of 9 February 1976 on the implementation of the principle of equal treatment for men and women as regards access to employment, vocational training and promotion, and working conditions (OJ L 39 of 14 February 1976, p. 40),
2. Council Directive 77/187/EEC of 14 February 1977 on the approximation of the laws of the Member States relating to the safeguarding of employees' rights in the event of transfers of undertakings, businesses or parts of businesses (OJ L 61 of 5 March 1977, p. 26),
3. Council Directive 85/577/EEC of 20 December 1985 to protect the consumer in respect of contracts negotiated away from business premises (OJ L 372 of 31 December 1985, p. 31),
4. Council Directive 87/102/EEC for the approximation of the laws, regulations and administrative provisions of the Member States concerning consumer credit (OJ L 42 of 12 February 1987, p. 48, last amended by Directive 98/7/EC of the European Parliament and of the Council of 16 February 1998 amending Directive 87/102/EEC for the approximation of the laws, regulations and administrative provisions of the Member States concerning consumer credit (OJ L 101 of 1 April 1998, p. 17),
5. Council Directive 90/314/EEC of 13 June 1990 on package travel, package holidays and package tours (OJ L 158 of 23 June 1990, p. 59),
6. Council Directive 93/13/EEC of 5 April 1993 on unfair terms in consumer contracts (OJ L 95 of 21 April 1993, p. 29),

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7. Directive 94/47/EC of the European Parliament and of the Council of 26 October 1994 on the protection of purchasers in respect of certain aspects of contracts relating to the purchase of the right to use immovable properties on a timeshare basis (OJ L 280 of 29 October 1994, p. 82),
8. Directive 97/5/EC of the European Parliament and of the Council of 27 January 1997 on cross-border credit transfers (OJ L 43 of 14 February 1997, p. 25),
9. Directive 97/7/EC of the European Parliament and of the Council of 20 May 1997 on the protection of consumers in respect of distance contracts (OJ L 144 of 4 June 1997, p. 19),
10. Articles 3 to 5 of Directive 98/26/EC of the European Parliament and of the Council of 19 May 1998 on settlement finality in payment and securities settlement systems (OJ L 166 of 11 June 1998, p. 45),
11. Directive 1999/44/EC of the European Parliament and of the Council of 25 May 1999 on certain aspects of the sale of consumer goods and associated guarantees (OJ L 171 of 7 July 1999, p. 12),
12. Articles 10, 11 and 18 of Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market ("Directive on electronic commerce" OJ L 178 of 17 July 2000, p. 1),
13. Directive 2000/35/EC of the European Parliament and of the Council of 29 June 2000 on combating late payment in commercial transactions (OJ L 200 of 8 August 2000, p. 35).

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## **Book 1 General Part**

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### **Division 1 Persons**

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#### **Title 1 Natural persons, consumers, entrepreneurs**

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#### **Section 1 Beginning of legal capacity**

The legal capacity of a human being begins on the completion of birth.

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#### **Section 2 Beginning of majority**

Majority begins at the age of eighteen.

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#### **Sections 3 – 6 (repealed)**

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#### **Section 7 Residence; establishment and termination**

(1) A person who settles permanently in a place establishes his residence in that place.

(2) There may be a residence in more than one place at the same time.

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The provisions relating to transfer of claims are applied with the necessary modifications to the transfer of other rights unless otherwise provided by law.

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## Division 6 Assumption of debt

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### Section 414 Contract between obligee and transferee

A debt may be assumed by a third party by contract with the obligee in such a way that the third party steps into the shoes of the previous obligor.

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### Section 415 Contract between obligor and transferee

(1) If the assumption of the debt is agreed between the third party and the obligor, its effectiveness is subject to ratification by the obligee. Ratification may only occur when the obligor or the third party has informed the obligee of the assumption of the debt. Until ratification, the parties may alter or cancel the contract.

(2) If ratification is refused, assumption of the debt is deemed not to have occurred. If the obligor or the third party requests the obligee, specifying a period of time, to make a declaration relating to the ratification, the ratification may only be declared before the end of the period of time; if it is not declared it is deemed to be refused.

(3) As long as the obligee has not granted ratification, then in case of doubt the transferee is obliged to the obligor to satisfy the obligee in good time. The same applies if the obligee refuses ratification.

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### Section 416 Assumption of a mortgage debt

(1) If the acquirer of a plot of land assumes a debt of the alienor for which there is a mortgage on the land, by contract with the latter, the obligee may only ratify the assumption of the debt if the alienor notifies him of it. If six months have passed since receipt of the notice, the ratification is deemed to have been granted unless the obligee has previously refused it to the alienor; the provision of section 415 (2) sentence 2 does not apply.

(2) Notice by the alienor may only be made when the acquirer has been entered in the Land Register as owner. It must be made in writing and must include the statement that the transferee steps into the shoes of the previous obligor unless the obligee declares his refusal within that period of six months.

(3) The alienor must, on the demand of the acquirer, notify the obligee of the assumption of debt. As soon as the grant or refusal of the ratification is definite, the alienor must inform the acquirer.

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### Section 417 Objections of the transferee

(1) The transferee may raise against the obligee the objections that arise from the legal relationship between the obligee and the previous obligor. He may not set off a claim to which the previous obligor is entitled.

(2) The transferee may not derive objections relating to the obligee from the legal relationship between the transferee and the previous obligor on which the assumption of debt is based.

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German Federal Court of Justice: Questions of evidence in disputes over the authenticity of the content of a document

NJW 1988, 2741

## Questions of evidence in disputes over the authenticity of the content of a document

German Code of Civil Procedure (ZPO), Secs. 292, 416, 440 II, 445 II

**1. The rule of evidence pursuant to Sec. 416 German Code of Civil Procedure only applies if the – disputed – authenticity of the content of the document has been established.**

**2. Evidence to the contrary of the statutory presumption of authenticity of the writing above the signature of a private document can be provided by means of a request for the adversary to be heard; Sec. 445 II German Code of Civil Procedure is not applicable to this request.**

German Federal Court of Justice, judgment dated April 13, 1988 - VIII ZR 274/87 (Frankfurt)

### Regarding the facts and circumstances:

The parties met in September 1985 due to a newspaper advertisement posted by the Plaintiff. They soon decided to get married. For the wedding preparations, the Plaintiff gave the Defendant DM 10,000, the receipt of which the Defendant confirmed in writing. The Plaintiff is in possession of two further receipts amounting to DM 18,000 and DM 16,500 that bear the signature of the Defendant and are dated November 12 and November 26, 1985. However, according to the allegation of the Plaintiff, they were issued on November 19, 1985. The receipt dated November 12, 1985 reads as follows:

"hereby certifies that DM 18,000, eighteen thousand D-Mark, was received for the rugs listed below." Below the following signature, four Persian rugs are listed with respective unit prices. The receipt dated November 26, 1985 states that the Defendant received DM 16,500 for thirteen oil paintings. In December 1985, the Plaintiff called off the engagement. With the present complaint, he asserts claims for payment amounting to a total of DM 49,086.59 plus interest against the Defendant. With regard to the two receipts dated November 12 and November 26, 1985, he claimed that he had purchased the items listed therein from the Defendant and paid her the amounts listed on the receipt as the purchase price. However, the Defendant allegedly refused to give him the items. The Defendant denied having concluded any purchase agreements with the Plaintiff and having received any money for these. She claimed to have signed the two receipts in blank because the Plaintiff had pretended to need her to do this in order to comply with formalities of the planned wedding in Gretna Green. The Plaintiff is said to have falsified the receipts

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Furthermore, dismissing the remainder, the Regional Court upheld the complaint to the extent of the sum of the three receipts (a total of DM 44,500). The Higher Regional Court rejected the Defendants' appeal on points of facts and law. The appeal on points of law with which the Defendant further pursued her desire for the complaint to be dismissed insofar as she was ordered to pay more than DM 10,000 that she received for planning the wedding, lead to the judgment being reversed and the matter being referred back to the court of lower instance.

The fact that the Defendant had submitted corresponding written declarations is said to be decisively in favor of this. The signatures on both documents dated November 12 and November 26, 1985 were rendered by the Defendant. The court of appeal thus found that, pursuant to Sec. 416 German Code of Civil Procedure, it is proven that the declarations contained in the documents regarding the receipt of the payment as consideration for handing over the rugs and paintings were made by her. It continues by stating that the Defendant did not provide any admissible substantial evidence for her allegation that, contrary to the rule of evidence pursuant to Sec. 416 German Code of Civil Procedure, she merely rendered certain blank signatures for other purposes. The same is said to apply to her submission that she was prompted to sign the documents by means of malicious deceit. The court of appeals further states that, since, according to the statutory regulation of Sec. 416 German Code of Civil Procedure, it is to be considered as proven that the Defendant also made the declarations contained in the receipts, the hearing of the Plaintiff as a party requested by the Defendant in order to prove the contrary is inadmissible pursuant to Sec. 445 II German Code of Civil Procedure. It continues that, as it has therefore been proven that the declarations regarding the receipt of DM 18,000 and DM 16,500 for the rugs and paintings that were to be handed over were made by the Defendant, these declarations also provided decisive evidence for the correctness of the Plaintiff's submission in this regard. It is said to have also been "significantly relevant" for this that the Defendant stated a different purpose for her alleged blank signature prior to the proceedings than during the litigation itself. Since it is thus said to have been established that the Defendant received DM 34,500 from the Plaintiff as purchase price for rugs and paintings, the requested hearing of the Plaintiff as a party pursuant to Sec. 445 II German Code of Civil Procedure could not be considered as evidence for the fact that the content of the

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3. Therefore, the contested judgment could not be maintained. The appellate court will have to subsequently conduct the hearing of the Plaintiff as a party, which it failed to do beforehand and, based on the results of the evidence in this regard, must once again legally assess both parties' statements of fact. By referring the case back to the court of lower instance, the Senate made use of the possibility provided for in Sec. 565 I 2 German Code of Civil Procedure.

### Editor's note:

An overview of the burden of proof is provided by Musielak, JuS<sup>3</sup> 1983, 198.

<sup>3</sup> Translator's note: JuS stands for "Juristische Schulung" and is a journal that appears monthly.

## ATTESTATION CLAUSE:

In my capacity as a translator for the English language, duly appointed, commissioned and sworn in by the Munich Regional Court I in the German federal state of Bavaria, I hereby certify to the best of my belief that the foregoing is a true and complete English translation of the original document in the German language submitted to me as a copy.

IN WITNESS WHEREOF I have hereunder set my hand and seal at

Munich, March 5, 2019

Denise Giles  
Kuenstraße 7b  
81735 Munich  
Germany



(Denise Giles)

## BGH: Beweisfragen bei Streit über Echtheit des Urkundentextes

NIW 1988, 2741

## Beweisfragen bei Streit über Echtheit des Urkundentextes

ZPO §§ 292, 416, 440 II, 445 II

**1. Die Beweisregel des § 416 ZPO greift erst ein, wenn die - bestrittene - Echtheit des Urkundentextes feststeht.**

**2. Der Beweis des Gegenteils der gesetzlichen Vermutung der Echtheit der über der Unterschrift stehenden Schrift einer Privaturkunde kann durch den Antrag auf Parteivernehmung des Gegners geführt werden; § 445 II ZPO ist auf diesen Antrag nicht anwendbar.**

BGH, Urteil vom 13-04-1988 - VIII ZR 274/87 (Frankfurt)

**Zum Sachverhalt:**

Die Parteien lernten sich im September 1985 aufgrund einer vom Kl. aufgegebenen Zeitungsannonce kennen. Sie kamen alsbald überein, die Ehe miteinander einzugehen. Zur Hochzeitsvorbereitung übergab der Kl. der Bekl. 10000 DM, deren Empfang diese schriftlich bestätigte. Der Kl. ist im Besitz zweier weiterer Quittungen über 18000 DM und 16500 DM, die die Unterschrift der Bekl. tragen und vom 12. bzw. 26. 11. 1985 datieren, nach der Behauptung des Kl. aber am 19. 11. 1985 ausgestellt worden sein sollen. Die Quittung vom 12. 11. 1985 lautet: "DM 18 000 Achtzehntausend D-Mark für die nachbenannten Teppiche erhalten zu haben, bescheinigt hiermit." Im Anschluß an die folgende Unterschrift sind vier Perserteppiche mit Einzelpreisen aufgeführt. Die Quittung vom 26. 11. 1985 hat zum Inhalt, daß die Bekl. 16500 DM für dreizehn Ölgemälde erhalten habe. Im Dezember 1985 löste der Kl. das Verlöbniß. Mit der vorliegenden Klage hat er die Bekl. auf Zahlung von insgesamt 49086,59 DM nebst Zinsen in Anspruch genommen. Zu den beiden Quittungen vom 12. und 26. 11. 1985 hat er vorgebracht, er habe die darin aufgeführten Gegenstände von der Bekl. gekauft und ihr die Quittungsbeträge als Kaufpreis gezahlt. Die Bekl. habe sich jedoch geweigert, ihm die Gegenstände zu übergeben. Die Bekl. hat bestritten, mit dem Kl. Kaufverträge abgeschlossen und dafür Geld erhalten zu haben. Sie habe - so hat sie behauptet - die Unterschrift auf den beiden Quittungen blanko geleistet, weil der Kl. ihr vorgespiegelt habe, sie zur Erfüllung von Formalitäten für die geplante Hochzeit in Gretna Green zu benötigen. Der Kl. habe die Quittungen gefälscht, indem er absprachewidrig über ihre Unterschriften den Text gesetzt habe, den die Urkunden jetzt enthielten. Dieses Vorbringen hat die Bekl. durch den Antrag auf Vernehmung des Kl. als Partei unter Beweis gestellt. Außerdem hat sie ihre Unterschriftsleistung wegen arglistiger Täuschung angefochten.

Das LG hat der Klage unter ihrer Abweisung im übrigen in Höhe der drei Quittungsbeträge (= insgesamt 44500 DM) stattgegeben. Die Berufung der Bekl. hat das OLG zurückgewiesen. Die Revision, mit der die Bekl. ihr Klageabweisungsbegehren insoweit weiterverfolgt, als sie zur Zahlung von mehr als 10000 DM verurteilt worden ist, die sie zur Hochzeitsvorbereitung erhalten hat, führte zur Aufhebung und Zurückverweisung.

**Aus den Gründen:**

I. Das BerGer. hat ausgeführt, nach seiner Überzeugung habe die Bekl. die quittierten Beträge von 18000 DM und 16500 DM als Kaufpreis für dem Kl. zu übereignende Teppiche und Gemälde erhalten.

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Dafür streite entscheidend, daß die Bekl. entsprechende schriftliche Erklärungen abgegeben habe. Die Unterschriften auf den beiden Urkunden vom 12. und 26. 11. 1985 stammten von der Bekl. . Daher sei gem. § 416 ZPO bewiesen, daß auch die in den Urkunden enthaltenen Erklärungen über den Empfang der Gelder als Gegenleistung für die Überlassung der Teppiche und Gemälde von ihr abgegeben worden seien. Die Bekl. habe keinen zulässigen erheblichen Beweis für ihre Behauptung angetreten, entgegen der Beweisregel des § 416 ZPO lediglich für andere Zwecke bestimmte Blanko-Unterschriften geleistet zu haben. Das gleiche gelte für ihr Vorbringen, zur Abgabe ihrer Unterschriften durch arglistige Täuschung veranlaßt worden zu sein. Da nach der gesetzlichen Regelung des § 416 ZPO als erwiesen zu erachten sei, daß die Bekl. auch die in den Quittungen enthaltenen Erklärungen abgegeben habe, sei die von ihr zum Beweis des Gegenteils beantragte Vernehmung des Kl. als Partei gem. § 445 II ZPO unzulässig. Die damit erwiesenermaßen von der Bekl. stammenden Erklärungen über den Erhalt von 18000 DM und 16500 DM für von ihr zu übereignende Teppiche und Gemälde lieferten auch entscheidenden Beweis für die Richtigkeit des diesbezüglichen Kl. Vorbringens, für die ferner "grundlegend ins Gewicht" gefallen sei, daß die Bekl. vorprozessual eine andere Darstellung über die Zweckbestimmung ihrer angeblich geleisteten Blanko-Unterschriften gegeben habe als im Rechtsstreit selbst. Da mithin feststehe, daß die Bekl. vom Kl. 34500 DM als Kaufpreis für Teppiche und Gemälde erhalten habe, komme die beantragte Parteivernehmung des Kl. gem. § 445 II ZPO auch nicht zum Beweis dafür in Betracht, daß der Inhalt der von der Bekl. abgegebenen Erklärungen nicht der Wirklichkeit entspreche. Nachdem die Bekl. "die Kaufverträge über die Teppiche und Gemälde" ernsthaft und endgültig verweigert habe, könne der Kl. nach § 326 BGB einen Betrag als Schadensersatz wegen Nichterfüllung verlangen, der den von ihm geleisteten Zahlungen entspreche.

II. Diese Ausführungen halten der rechtlichen Nachprüfung nicht stand. Die Revision rügt zu Recht, daß die Annahme des BerGer., zwischen den Parteien seien die streitigen Kaufverträge abgeschlossen worden, und die Bekl. habe vom Kl. 34500 DM als Kaufpreis erhalten, auf einem Verstoß gegen beweisrechtliche Vorschriften beruhe.

1. Der Kl., der Schadensersatz wegen Nichterfüllung der von ihm behaupteten Kaufverträge beansprucht, hat deren Zustandekommen zu beweisen. Diesen Beweis kann er mit allen in der ZPO vorgesehenen Beweismitteln führen. Dazu gehört auch die Beibringung von Privaturkunden. Diese begründen, sofern sie vom Aussteller unterzeichnet sind, nach § 416 ZPO vollen Beweis dafür, daß die in ihnen enthaltenen Erklärungen von dem Aussteller abgegeben sind. Die so formell bewiesenen Erklärungen sind - je nach ihrem Inhalt - auch geeignet, allein oder im Zusammenhang mit weiteren Umständen die Überzeugung davon zu verschaffen, daß die in der urkundlichen Erklärung bezeugten Tatsachen oder Vorgänge der Wirklichkeit entsprechen.

2. Von diesen Grundsätzen ist das BerGer. zwar ausgegangen. Es hat aber übersehen, daß die Beweisregel des § 416 ZPO nur eingreift, wenn die vom Beweisführer beigebrachten Privaturkunden echt sind (vgl. RGZ 73, 276 (279); Thomas-Putzo, ZPO, 15. Aufl., § 116 Anm. 2; Zöller-Stephan, ZPO, 15. Aufl., § 440 Anm. 1; Baumbach-Lauterbach-Albers-Hartmann, ZPO, 46. Aufl., § 416 Anm. 2 A und Vorb. § 437 Anm. 1; Rosenberg-Schwab, ZPR, 14. Aufl., § 122 III 1; Winkler, DNotZ 85, 227), die Echtheit der durch den Kl. vorgelegten Privaturkunden aber nicht feststeht.

a) Echt ist eine Privaturkunde i. S. des § 416 ZPO, wenn die Unterschrift dem Namensträger zuzuordnen ist und die über der Unterschrift stehende Schrift vom Aussteller selbst stammt oder mit dessen Willen dort steht (vgl. BGH, WM 1965, 1062 (1063); RGZ 64, 406 (407); Rosenberg-Schwab, § 122 III 1; Baumbach-Lauterbach-Albers-Hartmann, § 440 Anm. 3).

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b) Die Bekl. hat die auf den beiden Urkunden befindlichen Unterschriften als ihre eigenen anerkannt; sie sind daher echt.

Mit ihrem Vorbringen, sie habe die Unterschriften blanko zur Erledigung von Formalitäten für die geplante Heirat in Gretna Green erteilt, und der Kl. habe die Blankette abredewidrig dazu benutzt, nachträglich die jetzt vorhandenen Erklärungen über ihre Unterschrift zu setzen, hat sie jedoch die Echtheit des Urkundentextes bestritten (vgl. BGH, NJW 1986, 3086 u. II 2 c = WM 1986, 1238; Stein-Jonas-Schumann-Leipold, ZPO, 19. Aufl., § 416 Anm. IV, § 440 Anm. III). Denn damit hat sie geltend gemacht, daß die über ihren Unterschriften stehende Schrift weder von ihr selbst stamme noch mit ihrem Willen dort stehe. Ist indessen die Echtheit von Privaturkunden bestritten, so bedarf sie des Beweises (§ 440 I ZPO).

c) Diesen hat grundsätzlich derjenige zu erbringen, der sich als Beweisführer auf die Urkunden beruft. Steht allerdings - wie hier - die Echtheit der Namensunterschrift fest, so hat nach § 440 II ZPO die über der Unterschrift stehende Schrift die Vermutung der Echtheit für sich. Das gilt auch für Blanko-Unterschriften und selbst bei einem Blankettmißbrauch, wie er hier von der Bekl. behauptet worden ist (vgl. BGH, WM 1965, 1062; NJW 1986, 3086 ( 2 d); RGZ 64, 406 (407, 408)). Die Vermutung erstreckt sich in diesem Falle darauf, daß die nachträgliche Ausfüllung des Blanketts durch dessen Empfänger vereinbarungsgemäß erfolgte (vgl. Rosenberg-Schwab, § 122 II 2b), also inhaltlich dem Willen des Unterzeichners entspricht. Hierdurch wird der (Urkunden-) Beweisführer des Nachweises der Echtheit (zunächst) enthoben. Es ist Sache desjenigen, der die Echtheit der Schrift bestreitet, die Vermutung des § 440 II ZPO gem. § 292 ZPO durch den Beweis des Gegenteils, hier also des Blankettmißbrauches zu entkräften (BGH, NJW 1986, 2086 ( 2 d)). Er kann, was § 292 S. 2 ZPO ausdrücklich hervorhebt, auch durch Antrag auf Parteivernehmung nach § 445 ZPO geführt werden (a. A. Rosenberg, Die Beweislast, 4. Aufl., S. 221 Fußn. 1, der aber entgegen der h. M. leugnet, daß § 440 II ZPO eine Vermutung i. S. des § 292 ZPO aufstellt).

d) In diesem Sinne hat sich die Bekl. zum Beweis der Hergabe von Blanketten an den Kl. und deren abredewidrige Ausfüllung auf die Vernehmung des Kl. als Partei berufen.

Diesem Beweisantrag hat das BerGer. zu Unrecht nicht ent-

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sprochen. Soweit er sich gegen die Vermutung der Echtheit (§ 440 II ZPO) richtet, hat es ihn verfahrensfehlerhaft gem. § 445 II ZPO als unzulässig behandelt. Nach dieser Vorschrift ist der Antrag auf Vernehmung des Beweisgegners zwar nicht zu berücksichtigen, wenn er Tatsachen betrifft, deren Gegenteil das Gericht für erwiesen erachtet. Letzteres durfte das BerGer. hier aber nicht unter Heranziehung der Beweisregel des § 416 ZPO annehmen. Der Beweis des Gegenteils i. S. des § 445 II ZPO kann nicht mit Hilfe einer Beweisregel als geführt angesehen werden, wenn sich der Antrag auf Parteivernehmung gerade auf eine Tatsache erstreckt, bei deren Erweislichkeit - hier der Unechtheit der Urkunden - die Anwendung dieser Beweisregel ausgeschlossen ist. Zudem greift § 445 II ZPO im Anwendungsbereich des § 292 S. 2 ZPO ohnehin nicht ein. Diese Vorschrift stellt für den Beweis des Gegenteils gegen eine gesetzliche Vermutung eine Ausnahme von § 445 II ZPO dar (Zöller-Stephan, ZPO, § 292 Rdnr. 2; Thomas-Putzo, § 445 Anm. 3). Wäre dem nicht so, würde sie leerlaufen. Soweit das BerGer. zur Rechtfertigung seiner abweichenden Meinung auf das Urteil des RG vom 30. 10. 1985 (RGZ 15, 373) und das Urteil des BGH vom 22. 6. 1965 (NJW 1965, 1714 = MDR 1965, 818) verweist, hat es übersehen, daß in diesen Entscheidungen abgesehen davon, daß sie öffentliche Urkun-

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den betreffen, die Parteivernehmung nur deshalb für unzulässig erachtet wurde, weil mit ihr ein Beweis gegen die formelle Beweiskraft der Urkunden geführt werden sollte. Darum geht es hier aber nicht. Vorliegend bezweckt die Parteivernehmung des Kl., die Echtheit von Urkunden zu klären, ohne deren Nachweis den Urkunden von vornherein keine formelle Beweiskraft zukommt.

3. Da angefochtene Urteil konnte demnach keinen Bestand haben. Das BerGer. wird die unterlassene Vernehmung des Kl. als Partei nachzuholen und auf der Grundlage des diesbezüglichen Beweisergebnisses den beiderseitigen Sachvortrag erneut rechtlich zu würdigen haben. Bei der Zurückverweisung hat der Senat von der in § 565 I 2 ZPO vorgesehenen Möglichkeit Gebrauch gemacht.

N.

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**Anm. d. Schriftlfg.:**

Einen Überblick über die Beweislast gibt Musielak, JuS 1983, 198.

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7. Undertakings of the contractual parties (Kausalgeschäft) and transaction relating to performance (Vollzugsgeschäft) - beck-online

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**7. Undertakings of the contractual parties (Kausalgeschäft) and transaction relating to performance (Vollzugsgeschäft)<sup>1</sup>**

15, 16

When assessing the legal relationships between the parties involved in the transaction, a distinction is to be made between the main agreement (Grundgeschäft) – **the undertakings of the contractual parties (Kausalgeschäft)** – and the **transaction relating to performance (Vollzugsgeschäft)**. The assignment in rem of the right (invention, application or patent) is to be distinguished from the mere obligation to assign the right. In practice, the two legal transactions coincide. Assignment as an abstract disposition is generally dependent on the validity of the undertakings of the contractual parties (Kausalgeschäft). In the individual case, the validity of the undertakings of the contractual parties (Kausalgeschäft) may be a condition of the transaction relating to performance (Verfügungsgeschäft). If the undertakings of the contractual parties breach provisions of antitrust law, this may result in the transaction relating to performance (Verfügungsgeschäft) – assignment of the improvement invention – becoming invalid, Higher Regional Court of Düsseldorf, GRUR 66, 521.

Proposals for citation:

Benkard PatG/Ullmann/Deichfuß German Patent Act Sec. 15 marginal no. 15-16

Benkard PatG/Ullmann/Deichfuß German Patent Act, 11<sup>th</sup> ed. 2015 Sec. 15 marginal no. 15-16

<https://beck-online.beck.de/Print/CurrentDoc?vpath=bibdata%5Ckomm%5CBenkard...> February 14, 2019

<sup>1</sup> Translator's note: In German law, the undertakings of the contractual parties (Kausalgeschäft or Verpflichtungsgeschäft) and the transaction relating to performance (Vollzugsgeschäft or Verfügungsgeschäft) have to be treated as two independent legal transactions. This is called the abstraction principle (Abstraktionsprinzip).

Exhibit 39

Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/940,681

PATENT Page 1 of 3

REEL: 049669 FRAME: 0292



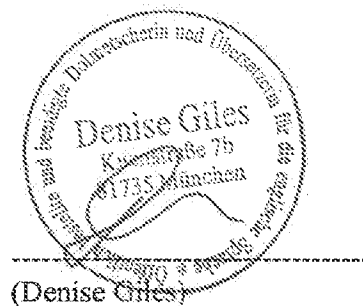
## ATTESTATION CLAUSE:

In my capacity as a translator for the English language, duly appointed, commissioned and sworn in by the Munich Regional Court I in the German federal state of Bavaria, I hereby certify to the best of my belief that the foregoing is a true and complete English translation of the original document in the German language submitted to me as a copy.

IN WITNESS WHEREOF I have hereunder set my hand and seal at

Munich, February 27, 2019

Denise Giles  
Kuenstraße  
81735 Munich  
Germany



PatG § 15 [Übertragbarkeit des Rechts; Lizenzen]	Ullmann/Deichfuß	Benkard, Patentgesetz 11. Auflage 2015	Rn. 15-16
--	------------------	--	-----------

## 7. Kausal- und Vollzugsgeschäft

Bei der Beurteilung der Rechtsbeziehungen der an der Übertragung Beteiligten ist zwischen dem Grundgeschäft – **Kausalgeschäft** – und dem **Vollzugsgeschäft** zu unterscheiden. Die dingliche Übertragung des Rechts (Erfindung, Anmeldung oder Patent) ist von der bloßen Verpflichtung zur Übertragung des Rechts zu unterscheiden. Praktisch fallen beide Rechtsgeschäfte häufig zusammen. Grundsätzlich ist die Übertragung als abstrakte Verfügung von der Wirksamkeit des Kausalgeschäfts unabhängig. Im Einzelfall kann die Wirksamkeit des Kausalgeschäfts Bedingung für die Wirksamkeit des Verfügungsgeschäfts sein. Ein Verstoß des Verpflichtungsgeschäfts gegen kartellrechtliche Regelungen kann zur Unwirksamkeit des Vollzugsgeschäfts – Abtretung der Verbesserungserfindung – führen, OLG Düsseldorf, GRUR **66**, 521. 15, 16

Zitiervorschläge:

Benkard PatG/Ullmann/Deichfuß PatG § 15 Rn. 15-16

Benkard PatG/Ullmann/Deichfuß, 11. Aufl. 2015, PatG § 15 Rn. 15-16

**patronus**

---

**From:** Stefan Andrasic <S.Andrasic@hti-bio-x.com>  
**Sent:** Thursday, September 11, 2014, 10:03 am  
**To:** patronus  
**Subject:** AW: Our reference: AUS1003PWO\_CAD files  
**Enclosures:** 5.jpg

Good morning Ms. Nguyen,

Please find attached the first revised page as was instructed to me by Mr. Heimberg.  
Does it look ok to you or are there certain "norms" with respect to font, size etc.  
Likewise, I took over the arrangement from your pdf file -- is it mandatory?

CAD files? Do you want the complete construction?

Thank you very much.

Kind regards,  
Stefan Andrasic

Phone: 08092/2092-40  
Fax: 08092/2092-28  
[s.andrasic@hti-bio-x.com](mailto:s.andrasic@hti-bio-x.com)  
[www.hti-bio-x.com](http://www.hti-bio-x.com)

HTI bio-X GmbH  
Am Forst 6  
85560 Ebersberg  
Germany  
Managing Director: Dr. Wolfgang Heimberg  
Local Court of Munich  
HRB 143635

---

**From:** Wolfgang Heimberg  
**Sent:** Wednesday, September 10, 2014, 10:32 am  
**To:** Stefan Andrasic  
**Subject:** WG: Our reference: AUS1003PWO\_CAD files

---

**From:** patronus [<mailto:patronus@patronus-ip.com>]  
**Sent:** Thursday, August 7, 2014, 2:27 pm  
**To:** Wolfgang Heimberg  
**Subject:** Our reference: AUS1003PWO\_CAD files

Dear Mr. Heimberg,

In the abovementioned matter we forward the figures we filed with the European Patent Office.

However, the final drawings still have to be prepared and filed later. Therefore, we want to ask whether it is possible for you to provide us with the CAD files of the figures attached.

Exhibit 40

Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/910,681

**PATENT**  
Page 1 of 3

**REEL: 049669 FRAME: 0295**

## ATTESTATION CLAUSE:

In my capacity as a translator for the English language, duly appointed, commissioned and sworn in by the Munich Regional Court I in the German federal state of Bavaria, I hereby certify to the best of my belief that the foregoing is a true and complete English translation of the original document in the German language submitted to me as a copy.

IN WITNESS WHEREOF I have hereunder set my hand and seal at

Munich, February 27, 2019

Denise Giles  
Kuenstraße  
81735 Munich  
Germany



-----  
(Denise Giles)

**atronus**

---

**Von:** Stefan Andrasic <S.Andrasic@hti-bio-x.com>  
**Gesendet:** Donnerstag, 11. September 2014 10:03  
**An:** patronus  
**Betreff:** AW: Unser Zeichen: AUS1003PWO\_CAD-Dateien  
**Anlagen:** 5.jpg

Guten Tag Frau Nguyen,

im Anhang finden Sie mal die erste überarbeitete Seite, wie es mir Herr Heimberg gesagt hatte.  
Ist dies für Sie ok, oder gibt es bezüglich der Schriftart, Größe usw. gewisse "Normen"  
Ebenso die Anordnung wurde von mir aus Ihrem pdf übernommen - ist diese verpflichtend?

CAD - Daten? Sie wollen die komplette Konstruktion?

Vielen Dank.

Mit freundlichen Grüßen  
Stefan Andrasic

Tel.: 08092/2092-40  
Fax: 08092/2092-28  
[s.andrasic@hti-bio-x.com](mailto:s.andrasic@hti-bio-x.com)  
<http://www.hti-bio-x.com>

HTI bio-X GmbH  
Am Forst 8  
85660 Ebersberg  
Geschäftsführer: Dr. Wolfgang Heimberg  
Amtsgericht München  
HRB 143635

---

**Von:** Wolfgang Heimberg  
**Gesendet:** Mittwoch, 10. September 2014 10:32  
**An:** Stefan Andrasic  
**Betreff:** WG: Unser Zeichen: AUS1003PWO\_CAD-Dateien

---

**Von:** patronus [<mailto:patronus@patronus-ip.com>]  
**Gesendet:** Donnerstag, 7. August 2014 14:27  
**An:** Wolfgang Heimberg  
**Betreff:** Unser Zeichen: AUS1003PWO\_CAD-Dateien

Sehr geehrter Herr Heimberg,

in oben genannter Angelegenheit übersenden wir Ihnen Figuren, welche wir beim Europäischen Patentamt eingereicht haben.

Hierzu müssen jedoch noch Reinzeichnungen erstellt und nachgereicht werden. Daher möchten wir nachfragen, ob es Ihnen möglich wäre, uns zu den in der Anlage beigefügten Figuren die CAD-Dateien zu übersenden.

**PATENT ASSIGNMENT COVER SHEET**

Electronic Version v1.1

Stylesheet Version v1.2

<b>SUBMISSION TYPE:</b>	NEW ASSIGNMENT
<b>NATURE OF CONVEYANCE:</b>	ASSIGNMENT
<b>CONVEYING PARTY DATA</b>	
<b>Name</b>	<b>Execution Date</b>
AUSBIO R&D EUROPE GMBH	01/16/2015
<b>RECEIVING PARTY DATA</b>	
<b>Name:</b>	YANTAI AUSBIO LABORATORIES CO., LTD.
<b>Street Address:</b>	NO. 2 HUASHAN ROAD
<b>Internal Address:</b>	YEDA
<b>City:</b>	YANTAI
<b>State/Country:</b>	CHINA
<b>Postal Code:</b>	264006
<b>PROPERTY NUMBERS Total: 1</b>	
<b>Property Type</b>	<b>Number</b>
<b>Application Number:</b>	14910681
<b>CORRESPONDENCE DATA</b>	
<b>Fax Number:</b>	
<b>Email:</b>	jmd@usiplaw.com
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.</i>	
<b>Correspondent Name:</b>	EDELL SHAPIRO & FINNAN LLC
<b>Address Line 1:</b>	9801 WASHINGTONIAN BLVD.
<b>Address Line 2:</b>	SUITE 750
<b>Address Line 4:</b>	GAITHERSBURG, MARYLAND 20878
<b>ATTORNEY DOCKET NUMBER:</b>	0996.0002C
<b>NAME OF SUBMITTER:</b>	MARK J. DEBOY
<b>Signature:</b>	/Mark J. DeBoy/
<b>Date:</b>	03/12/2019

Exhibit 41

Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/910,681

PATENT

Page 1 of 2

REEL: 049669 FRAME: 0298

5/12/2019, 1:40 PM

**Total Attachments: 1**

source=Declaration of Assignment of PCT from AusBio R&amp;D Europe to Yantai AusBio Laboratories#page1.tif

**RECEIPT INFORMATION****EPAS ID:** PAT5416915**Receipt Date:** 03/12/2019

Exhibit 41  
Petition Pursuant to 37 CFR 1.46(B)(2)  
Application No. 14/910,681

**PATENT**  
Page 2 of 2  
**REEL: 049669 FRAME: 0299**



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	TOT CLAIMS	IND CLAIMS
14/910,681	02/05/2016	1774	1320	0996.0002C	31	3

**CONFIRMATION NO. 4497**  
**UPDATED FILING RECEIPT**

27896  
EDELL, SHAPIRO & FINNAN, LLC  
9801 Washingtonian Blvd.  
Suite 750  
Gaithersburg, MD 20878



Date Mailed: 01/17/2019

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

**Inventor(s)**

Zhaoqiang Wang, Yantai, CHINA;  
Wolfgang Mann, Neudrossenfeld, GERMANY;  
Wolfgang Heimberg, Ebersberg, GERMANY;

**Applicant(s)**

YANTAI AUSBIO LABORATORIES CO., LTD., Shandong, CHINA;

**Assignment For Published Patent Application**

Yantai AusBio Laboratories Co., Ltd., Yantai, Shandong, CHINA

**Power of Attorney:** The patent practitioners associated with Customer Number 27896

**Domestic Priority data as claimed by applicant**

This application is a 371 of PCT/EP14/66947 08/06/2014

**Foreign Applications** (You may be eligible to benefit from the **Patent Prosecution Highway** program at the USPTO. Please see <http://www.uspto.gov> for more information.)  
EUROPEAN PATENT OFFICE (EPO) 13179437.2 08/06/2013

**Permission to Access Application via Priority Document Exchange:** Yes

**Permission to Access Search Results:** Yes

Applicant may provide or rescind an authorization for access using Form PTO/SB/39 or Form PTO/SB/69 as appropriate.

**Projected Publication Date:** Not Applicable



**Non-Publication Request:** No

**Early Publication Request:** No

**\*\* SMALL ENTITY \*\***

**Title**

CENTRIFUGE AND METHOD FOR CENTRIFUGING A REACTION VESSEL UNIT

**Preliminary Class**

494

**Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications:** No

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Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

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For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4258).

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**Title 37, Code of Federal Regulations, 5.11 & 5.15**

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---

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Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	TOT CLAIMS	IND CLAIMS
14/910,681	02/05/2016		1250	PAT001	31	3

CONFIRMATION NO. 4497

FILING RECEIPT

50571  
THE HARRIS FIRM  
922 N STREET , NW STE . 101  
WASHINGTON, DC 20001



Date Mailed: 03/24/2016

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

**Inventor(s)**

Zhaoqiang Wang, Yantai, CHINA;  
Wolfgang Mann, Neudrossenfeld, GERMANY;

**Applicant(s)**

YANTAI AUSBIO LABORATORIES CO., LTD., Shandong, CHINA;

**Assignment For Published Patent Application**

Yantai AusBio Laboratories Co., Ltd., Yantai, Shandong, CHINA

**Power of Attorney:** None

**Domestic Priority data as claimed by applicant**

This application is a 371 of PCT/EP14/66947 08/06/2014

**Foreign Applications** (You may be eligible to benefit from the **Patent Prosecution Highway** program at the USPTO. Please see <http://www.uspto.gov> for more information.)  
EUROPEAN PATENT OFFICE (EPO) 13179437.2 08/06/2013

**Permission to Access Application via Priority Document Exchange:** Yes

**Permission to Access Search Results:** Yes

Applicant may provide or rescind an authorization for access using Form PTO/SB/39 or Form PTO/SB/69 as appropriate.

**If Required, Foreign Filing License Granted:** 03/23/2016

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 14/910,681**

**Projected Publication Date:** 06/30/2016

**Non-Publication Request:** No

**Early Publication Request:** No

**\*\* SMALL ENTITY \*\***

**Title**

CENTRIFUGE AND METHOD FOR CENTRIFUGING A REACTION VESSEL UNIT

**Preliminary Class**

**Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications:** No

## **PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES**

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The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

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---

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使用申请信息表 (37 CFR 1.76) 申请实用专利或设计专利的声明 (37 CFR 1.63)  
DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN APPLICATION  
DATA SHEET (37 CFR 1.76)

发明名称  
Title of Invention CENTRIFUGE AND METHOD FOR CENTRIFUGING A REACTION VESSEL UNIT

作为下述署名的发明人，本人以此声明：  
As the below named inventor, I hereby declare that:

本声明是：  
This declaration is directed to:  
☐ 随附的申请，或  
The attached application, or

☒ 美国专利申请 PCT (国际) 申请号 14910681 提交于 February 5, 2016  
United States application or PCT international application number 14910681 filed on February 5, 2016

上述申请由本人发明或授权他人发明。  
The above identified application was made or authorized to be made by me.

本人相信，本人是该申请中一项发明的原始发明人或共同发明人。  
I believe that I am the original inventor or an original joint inventor of a claimed invention in the application.

本人以此声明，此声明中若有任何故意或过失的虚假陈述，本人将依据 18 U.S.C. 1001 的规定被处以罚款或五年(5)年以下有期徒刑，或者两者兼施。  
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发明人的法定名称  
LEGAL NAME OF INVENTOR

发明人: Zhaoqiang Wang  
Inventor: Zhaoqiang Wang

日期(选项): Mar. 5, 2016  
Date (Optional):

签名:  
Signature:

注意: 此表格必须随同 PTO/AIA/14 或同等表格一起提交。或者此表格必须随同 PTO/AIA/01 一起提交。其随同发明人的其他信息 PTO/AIA/01 一起提交。

Note: An application data sheet (PTO/AIA/14 or equivalent), including naming the entire inventive entity, must accompany this form or must have been previously filed. Use an additional PTO/AIA/01 form for each additional inventor.

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<b>Title of Invention</b>	CENTRIFUGE AND METHOD FOR CENTRIFUGING A REACTION VESSEL UNIT		
This statement is directed to:			
<input type="checkbox"/> The attached application,			
OR			
<input checked="" type="checkbox"/> United States application or PCT international application number <u>14/910,681</u> filed on <u>February 5, 2016</u>			
<b>LEGAL NAME of inventor to whom this substitute statement applies:</b>			
(E.g., Given Name (first and middle (if any)) and Family Name or Surname)			
Wolfgang Mann			
Residence (except for a deceased or legally incapacitated inventor):			
City	Neudrossenfeld	State	Country DE
Mailing Address (except for a deceased or legally incapacitated inventor):			
Hornungsreuth 22A			
City	Neudrossenfeld	State	Zip 95512 Country DE
I believe the above-named inventor or joint inventor to be the original inventor or an original joint inventor of a claimed invention in the application.			
The above-identified application was made or authorized to be made by me.			
I hereby acknowledge that any willful false statement made in this statement is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.			
Relationship to the inventor to whom this substitute statement applies:			
<input type="checkbox"/> Legal Representative (for deceased or legally incapacitated inventor only),			
<input type="checkbox"/> Assignee,			
<input type="checkbox"/> Person to whom the inventor is under an obligation to assign.			
<input checked="" type="checkbox"/> Person who otherwise shows a sufficient proprietary interest in the matter (petition under 37 CFR 1.46 is required), or			
<input type="checkbox"/> Joint Inventor.			

[Page 1 of 2]

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Exhibit 45

Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/910,681

PATENT

Page 1 of 2

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**SUBSTITUTE STATEMENT**

Circumstances permitting execution of this substitute statement:

- ☐ Inventor is deceased,
- ☐ Inventor is under legal incapacity,
- ☐ Inventor cannot be found or reached after diligent effort, or
- ☒ Inventor has refused to execute the oath or declaration under 37 CFR 1.63.

If there are joint inventors, please check the appropriate box below:

- ☒ An application data sheet under 37 CFR 1.76 (PTO/AIA/14 or equivalent) naming the entire inventive entity has been or is currently submitted.

OR

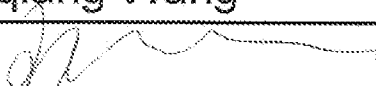
- ☐ An application data sheet under 37 CFR 1.76 (PTO/AIA/14 or equivalent) has not been submitted. Thus, a Substitute Statement Supplemental Sheet (PTO/AIA/11 or equivalent) naming the entire inventive entity and providing inventor information is attached. See 37 CFR 1.64(b).

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**PERSON EXECUTING THIS SUBSTITUTE STATEMENT:**

Name: **Zhaoqiang Wang** Date (Optional):

Signature: 

**APPLICANT NAME AND TITLE OF PERSON EXECUTING THIS SUBSTITUTE STATEMENT:**

If the applicant is a juristic entity, list the applicant name and the title of the signer:

**Yantai AusBio Laboratories Co., Ltd.**

Applicant Name:

Title of Person Executing  
This Substitute Statement: **CEO**

The signer, whose title is supplied above, is authorized to act on behalf of the applicant.

**Residence of the signer (unless provided in an application data sheet, PTO/AIA/14 or equivalent):**

City State Country

**Mailing Address of the signer (unless provided in an application data sheet, PTO/AIA/14 or equivalent)**

City State Zip Country

Note: Use an additional PTO/AIA/02 form for each inventor who is deceased, legally incapacitated, cannot be found or reached after diligent effort, or has refused to execute the oath or declaration under 37 CFR 1.63.

[Page 2 of 2]

Exhibit 45  
Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/940,681

**PATENT**  
Page 2 of 2  
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**SUBSTITUTE STATEMENT IN LIEU OF AN OATH OR DECLARATION FOR UTILITY  
OR DESIGN PATENT APPLICATION (35 U.S.C. 115(d) AND 37 CFR 1.64)**

Title of Invention	CENTRIFUGE AND METHOD FOR CENTRIFUGING A REACTION VESSEL UNIT		
This statement is directed to:			
<input type="checkbox"/> The attached application,			
OR			
<input checked="" type="checkbox"/> United States application or PCT international application number <u>14/910,681</u> filed on <u>February 5, 2016</u>			
LEGAL NAME of inventor to whom this substitute statement applies:			
(E.g., Given Name (first and middle (if any)) and Family Name or Surname)			
Wolfgang Heimberg			
Residence (except for a deceased or legally incapacitated inventor):			
City	Ebersberg	State	Country DE
Mailing Address (except for a deceased or legally incapacitated inventor):			
Am Forst 6			
City	Ebersberg	State	Zip 85560 Country DE
I believe the above-named inventor or joint inventor to be the original inventor or an original joint inventor of a claimed invention in the application.			
The above-identified application was made or authorized to be made by me.			
I hereby acknowledge that any willful false statement made in this statement is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.			
Relationship to the inventor to whom this substitute statement applies:			
<input type="checkbox"/> Legal Representative (for deceased or legally incapacitated inventor only).			
<input type="checkbox"/> Assignee,			
<input type="checkbox"/> Person to whom the inventor is under an obligation to assign,			
<input checked="" type="checkbox"/> Person who otherwise shows a sufficient proprietary interest in the matter (petition under 37 CFR 1.46 is required), or			
<input type="checkbox"/> Joint Inventor.			

[Page 1 of 2]

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Petition Pursuant to 37 CFR 1.46(B)(2)  
Application No. 14/910,681  
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- ☐ Inventor cannot be found or reached after diligent effort, or
- ☒ Inventor has refused to execute the oath or declaration under 37 CFR 1.63.

If there are joint inventors, please check the appropriate box below:

- ☒ An application data sheet under 37 CFR 1.76 (PTO/AIA/14 or equivalent) naming the entire inventive entity has been or is currently submitted.


OR

- ☐ An application data sheet under 37 CFR 1.76 (PTO/AIA/14 or equivalent) has not been submitted. Thus, a Substitute Statement Supplemental Sheet (PTO/AIA/11 or equivalent) naming the entire inventive entity and providing inventor information is attached. See 37 CFR 1.64(b).

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**PERSON EXECUTING THIS SUBSTITUTE STATEMENT:**

Name: <b>Zhaoqiang Wang</b>	Date (Optional):
Signature: 	

**APPLICANT NAME AND TITLE OF PERSON EXECUTING THIS SUBSTITUTE STATEMENT:**

If the applicant is a juristic entity, list the applicant name and the title of the signer:

**Yantai AusBio Laboratories Co., Ltd.**

Applicant Name:

Title of Person Executing  
This Substitute Statement: **CEO**

The signer, whose title is supplied above, is authorized to act on behalf of the applicant.

Residence of the signer (unless provided in an application data sheet, PTO/AIA/14 or equivalent):

City	State	Country	
Mailing Address of the signer (unless provided in an application data sheet, PTO/AIA/14 or equivalent)			
City	State	Zip	Country

Note: Use an additional PTO/AIA/02 form for each inventor who is deceased, legally incapacitated, cannot be found or reached after diligent effort, or has refused to execute the oath or declaration under 37 CFR 1.63.

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Exhibit 46

Petition Pursuant to 37 CFR 1.46(B)(2)

Application No. 14/940,681

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