

PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1
Stylesheet Version v1.2

EPAS ID: PAT8314863

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	LEGAL MEMORANDUM DEMONSTRATING PROOF OF PROPRIETARY INTEREST BY APPLICANT UNDER MPEP 409.05

CONVEYING PARTY DATA

Name	Execution Date
HELLA GMBH & CO KGAA ON BEHALF OF THE DECEASED (NIKOLAUS DECIUS)	12/04/2023

RECEIVING PARTY DATA

Name:	HELLA GMBH & CO KGAA
Street Address:	RIXBECKER STRASSE 75
City:	LIPPSTADT
State/Country:	GERMANY
Postal Code:	59552

PROPERTY NUMBERS Total: 1

Property Type	Number
Application Number:	17170400

CORRESPONDENCE DATA**Fax Number:**

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.

Email: mailroom@mg-ip.com
Correspondent Name: MUNCY GEISLER OLDS & LOWE, P.C
Address Line 1: 215 S. ROYAL ST.
Address Line 4: ALEXANDRIA, VIRGINIA 22314

ATTORNEY DOCKET NUMBER:	1060/0230PUS1
NAME OF SUBMITTER:	INDRE USELMANN
SIGNATURE:	/Indre Uselmann/
DATE SIGNED:	12/06/2023

Total Attachments: 7

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: DECIUS, Nikolaus	Examiner: THUY-VI THI NGUYEN
Application No.: 17/170,400	Art Unit: 3664
Filed: 8 Feb 2021	Confirmation Number: 6622
Title: CONTROL SYSTEM FOR A MOTOR VEHICLE AND METHOD FOR DIAGNOSING A FAILURE IN A CONTROL SYSTEM	
Attorney Docket No.: 1060/0230PUS1	

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

SUBMISSION OF LEGAL MEMORANDUM IN LIEU OF ASSIGNMENT

Dear Sir:

Attached hereto is a Legal Memorandum demonstrating proof of proprietary interest by the Applicant under MPEP 409.05.

The attached Legal Memorandum from the German Law firm CBH clearly shows that the full rights to the invention of the deceased employee, Nikolaus DECIUS, belong to the Applicant (who was his employer), namely, Hella GmbH & CO KGaA, as a matter of law.

Additionally attached is an Employer declaration, a literal translation of the CBH letter, and a verified statement of translation of such.

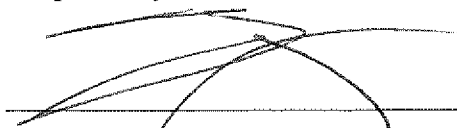
Should there remain unresolved issues that require action, it is respectfully requested that the Examiner telephone Martin R. Geissler, Applicants' Attorney, at 703.621.7140 so that such issues may be resolved as expeditiously as possible.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 50-3828 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; in particular, extension of time fees.

Date: December 6, 2023

Muncy, Geissler, Olds & Lowe, P.C.
125 S Royal St
Alexandria, VA 22314
Tel. 703.621.7140
mailroom@mg-ip.com

Respectfully submitted,


Martin R. Geissler
Attorney/Agent for Applicant(s)
Reg. No. 51,011

DECLARATION

I, Gregor Behr-Wenning, hereby declare the following:

1. The inventor of U.S. Application number 17/170,400, namely Nikolaus DECIUS, has deceased prior to signing the declaration,
2. Nikolaus DECIUS was an employee of Hella GmbH & CO. KGaA at the time the invention was made.
3. I hereby declare that at no point in time has Hella GmbH & CO. KGaA ever given permission for the inventor or co-inventors to release the rights to the invention as described in U.S. 17/170,400.
4. Thus, Hella GmbH & CO. KGaA, by the laws of Germany, owns all of the rights to the invention shown in U.S. Application number 17/170,400.

All statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true. Further, 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 Code and that such willful false statements may jeopardize the validity of the application, or any patent issued thereon.

Date: 04.12.2023



Name: Gregor Behr-Wenning

Title: Head of Patent Department

CBH Rechtsanwälte | Bismarckstraße 11-13 | 50672 Köln

Muncy, Geissler, Olds & Lowe, P.C.
Herrn Patentanwalt Martin R. Geissler
4000 Legato Road, Suite 310, Fairfax
VA 22033
USA

KÖLN
BERLIN
BRÜSSEL
HAMBURG
MÜNCHEN

Registernummer	Telefon	Telefax	E-Mail	Ansprechpartner
30-00188/20/30 lo	+49 221 95 190-83	+49 221 95 190-93	j.kunzmann@cbh.de	Jens Kunzmann

Köln, den 24. November 2020

Muncy Geissler Olds & Lowe - Beratung ArbEG
Rechtsslage nach dem ArbEG bei Erfindungsmeldung und Inanspruchnahme

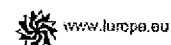
Sehr geehrter Herr Kollege Geissler,

Sie bitten mich, die Rechtsslage nach dem deutschen ArbEG in Bezug auf die Zuordnung der Erfindungsrechte darzustellen.

1. Mit dem Eingang einer ordnungsgemäßen Erfindungsmeldung nach § 5 Abs. 2 Satz 1 und Satz 3 ArbEG erhält der Arbeitgeber nach § 6 Abs. 1 ArbEG das Recht zur Inanspruchnahme. Für alle seit dem 01.10.2009 gemeldeten Dienstervindungen gilt die gesetzliche Inanspruchnahmefiktion nach § 6 Abs. 2 ArbEG, d. h. die Inanspruchnahme gilt kraft Gesetzes als erklärt, wenn der Arbeitgeber die Dienstervindung nicht binnen vier Monaten nach Eingang der Erfindungsmeldung gegenüber dem Arbeitnehmer ausdrücklich durch Erklärung in Textform freigibt.

KÖLN	Bismarckstraße 11-13 50672 Köln T +49 221 95 190-0 koeln@cbh.de
BERLIN	Frankfurterstraße 28/29 10587 Berlin T +49 30 89 67 25-60 berlin@cbh.de
BRÜSSEL	Avenue de Cothenbergh 52 1000 Brüssel Belgien T +32 2 808 69 41 brussels@cbh.de
HAMBURG	Texdopfschloß 8 20148 Hamburg T +49 40 41 42 99-0 hamburg@cbh.de
MÜNCHEN	Ismaninger Straße 65a 81675 München T +49 89 24 88 200-50 muenchen@cbh.de

CBH Rechtsanwälte
Cornelius Bartenbach-Kaesemann & Partner
Partnerschaft von Rechtsanwälten mbB
Amtsgericht Essen PR 3164
www.cbh.de



Neben dieser Inanspruchnahmefiktion hat der Arbeitgeber auch die Möglichkeit, vor Ablauf der Frist von vier Monaten die Inanspruchnahme gegenüber dem Arbeitnehmererfinder ausdrücklich zu erklären.

Nach § 7 Abs. 1 ArbEG bewirkt die Inanspruchnahme – gleich, ob infolge einer ausdrücklichen Inanspruchnahmeerklärung oder aufgrund der gesetzlichen Inanspruchnahmefiktion –, dass alle vermögenswerten Rechte an der Diensterfindung auf den Arbeitgeber übergehen. Damit ist der Arbeitgeber alleiniger Berechtigter, d. h. er kann über die Diensterfindung frei verfügen,

2. Bei Fehlen einer ordnungsgemäßen Erfindungsmeldung wird nach der Ansicht des Bundesgerichtshofs (BGH) die Inanspruchnahmefrist jedenfalls mit einer vom Arbeitgeber angestrebten Schutzrechtsanmeldung unter Nennung sämtlicher beteiligter Erfinder ausgelöst, da der Arbeitgeber durch diese Anmeldung seine Kenntnis über den Erfindungsgegenstand und die daran beteiligten Erfinder zum Ausdruck bringt und damit der Zweck des § 5 ArbEG erfüllt ist. (vgl. zum alten Recht BGH v. 04.04.2006, GRUR 2006, 754 – Hafteticket u. v. 14.02.2017, GRUR 2017, 504 – Lichtschutzfolie). Diese Grundsätze gelten unseres Erachtens für die Frist der Inanspruchnahmefiktion des § 6 Abs. 2 ArbEG entsprechend (vgl. Bartenbach/Volz, KommArbEG, § 6 ArbEG n. F. Rn. 129 f. m. w. N.; Busse/Keukenschrijver, PatG, § 6 ArbEG Rn. 11 m. w. N.).
3. In diesem Fall gehen die Erfindungsrechte auf den Arbeitgeber über, soweit dieser innerhalb von vier Monaten ab Einreichung einer Schutzrechtsanmeldung durch den Arbeitgeber unter Nennung aller beteiligten Erfinder nicht ausdrücklich die Freigabe in Textform erklärt.

Mit freundlichen kollegialen Grüßen



Jens Kunzmann
Rechtsanwalt

Cologne, November 24th, 2020

Muncy Geissler Olds & Lowe - Consultation ArbEG (German Employee Invention Act)
Legal position according to the ArbEG with respect to invention disclosure and claiming of an invention

Dear Mr. Geissler,

You have asked me to present the legal position according to the German ArbEG in respect of the assignment of the rights to the invention.

1. With the receipt of a proper invention disclosure according to § 5 para. 2 clause 1 and clause 3 ArbEG, the employer has the right to claim the invention according to § 6 para. 1 ArbEG. For all service inventions registered as from 1 October 2009, the statutory Fiction of Claiming according to § 6 para. 2 ArbEG applies, i.e. by force of law, the invention can be assumed to have been claimed if the employer does not expressly release the service invention to the employee in writing within four months after receipt of the invention disclosure.

In addition to this Fiction of Claiming, the employer also has the option of expressly claiming the employee inventor's invention before the expiry of the period of four months.

According to § 7 para. 1 ArbEG, the claiming of the invention – whether as a result of explicitly claiming the invention or due to statutory Fiction of Claiming – causes all proprietary rights with regard to the service invention to transfer to the employer. Thus, the employer is the sole beneficiary, i.e. said employer alone can freely dispose of the service invention.

2. In the absence of a proper invention disclosure, according to the opinion of the German Federal Court of Justice (BGH), the claiming period is in any case triggered by an IP application brought by the employer naming all participating inventors, since by registering this application, the employer expresses they are aware of the subject matter of the invention and the inventors involved therein, thus fulfilling the purpose of § 5 ArbEG. (*cf. to previous law BGH from 04/04/2006, GRUR 2006, 754 - adhesive label and from 02/14/2017, GRUR 2017, 504 - light protective film*). In our opinion, these principles apply accordingly for the fiction of claiming period of § 6 para. 2 ArbEG (*cf. Bartenbach/Volz, KommArbEG, § 6 ArbEG n. F. Rn. 129 f. m. w. N.; Busse/Keukenschrijver, PatG, § 6 ArbEG Rn. 11 m. w. N.*).

3. In this case, the rights to the invention transfer to the employer, as long as said employer does not expressly release said invention in writing within a period of four months, starting from the filing of an IP application by the employer and naming all participating inventors.

Yours sincerely,

Verified Statement of Translation

I, Martin R. Geissler, hereby declare the following:

I am knowledgeable in **German** and English. I have reviewed the English translation of the Legal Memorandum provided by the law firm CBH, dated November 24, 2020, and believe the attached document to be an accurate translation thereof.

All statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true. Further, 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 Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: December 6, 2023

/Martin R. Geissler/
Martin R. Geissler
Reg. No. 51,011