



Client Information | December 2013

CHANGES OF THE GERMAN PATENT LAW

reported by Jochen Sties

Important changes to the German Patent Law will come into effect on 1st April 2014.

These changes will adjust some of the procedures surrounding patent applications filed with the German Patent and Trademark Office (GPTO) and bring them into line (not to mention into competition) with the procedures that currently surround filing applications before the European Patent Office (EPO).

The changes will allow applicants to establish a priority date by filing a patent application in a foreign language and use the GPTO as a Search Authority. As a result the GPTO will not only compete with the EPO for German applications but also for applications written in English or French.

The changes will also open up electronic file inspection in the very near future and extend the term for filing an opposition against granted German patents to 9 months.

This update will discuss both these and other related changes.

CHANGES IN THE LAW

1. Translation requirements

Filing Date – The GPTO will award a filing date for any foreign language application that meets their formal requirements, irrespective of whether the applicant plans to file a German translation of the application at a later date or not.

Under the current legislation, applications filed with claims and specification in any language other than German are deemed not to have been filed at all unless a German translation is provided within 3 months from the filing date of that application. As of 1st April 2014 it will be possible to establish a Convention priority date with an application filed with the GPTO, irrespective of the language in which the application is filed and without any translation costs and time pressure.

Time Limits – The time limit for filing a German translation of an application so as to allow prosecution before the GPTO will depend on the language of the application.

For applications in English or French, the time limit will be extended to 12 months from the filing date. The time limit for applications in any other language will remain 3 months from the filing date.

2. Extended Search Reports

The Search Reports provided by the GPTO will be improved by adding supplementary opinion on the patentability of an invention. This replaces the first Office Action in the event an examination request is filed later.

In addition, once the changes are in place, it will be possible for the Examiner to raise an objection if there is already a lack of unity in the search stages.

As a result the content of a German Search Report will pretty much replicate that of the existing European Search Report.

Better still, even though all these changes represent significant benefit for applicants, the search fee will only increase marginally, going up €50 to €300.

The final benefit is speed of turnaround. We expect the new Search Report will speed up German examination proceedings significantly.

3. Hearings in the Application Proceedings

Currently, the decision to allow a hearing in examination proceedings is at the discretion of the Examiner. In future the applicant will be entitled to discuss his case with an Examiner if no agreement on allowable claims can be reached in writing. This change will again allow the GPTO to mirror the practices of the EPO.

The immediate benefit for applicants is simple. Hearings are a more effective and more inexpensive way to discuss an invention with the Examiner in person. In the majority of cases a satisfactory agreement will be found allowing applicants to avoid costly appeal proceedings.

4. Time Limit for Oppositions

The time limit for filing an opposition will be increased from 3 month to 9 months. This means the limit will correspond exactly to the limit for filing an opposition against patents granted by the EPO.

The extension will give applicants and attorneys more time to analyze each case before making a decision on whether they will – or indeed should – file an opposition.

The new 9 month time limit applies at least to all patents for which the (old) 3 month time limit has not expired by 1st April, 2014. Based on the plain wording of the patent law, it should be possible as of 1st April, 2014 to file an opposition against those patents for which the (old) 3 month opposition term has lapsed, but the new 9 month term is still applicable. This will affect all patents granted after 1st July, 2013. The official position of the GPTO however is that any (3 month) opposition term which has ended under the old provisions cannot be restarted under the new provisions. It will probably be for the Federal German Patent Court to decide what happens during the transitional period.

5. Further Changes

Hearing in opposition proceedings – All hearings in opposition proceedings will be open to the public. This is an adaptation designed to match the existing practices of the European Patent Office and the German Patent Court.

Subsequent filing of drawings or parts of the specification – Apart from adding drawings, it will also be possible to file specific parts of a specification after the original filing date. However, please note that if additions are made, the original filing date will be changed to the date the belated documents are added.

Effective Date – As we said at the start of this update, all of these changes will come into force on 1st April, 2014.

6. Online File Inspection

The GPTO will offer online file inspection starting 7th January, 2014. Instead of having to wait for paper copies of a file's content to be prepared and shipped, the content of any published application and granted/registered IP right will be instantly accessible online.

IS IT TIME FOR YOU TO CONSIDER AN ALTERNATIVE FILING STRATEGY?

Together the relaxation of the translation requirements and the availability of more substantial Search Report creates an attractive opportunity for applicants filing in English or French.

An applicant will be able to use the GPTO as a Search Office – without having to pay any translation costs up front – while the Convention priority date for an invention is established.

The result will be that the GPTO will be able to compete directly with the EPO for applications filed in any of the EPO's three official languages.

We'd like to use a working example to put things into context:

An application is filed with the GPTO in English. It will be awarded a filing date (i.e. a priority date) and a search can be requested. This search will take about 9 months (currently the GPTO's expected processing time) and includes not only a list of potentially relevant prior art documents but also the Examiner's opinion on the patentability of the invention. This leaves 3 months for you to decide whether you wish to make any counterpart applications.

If you decide to continue with the German application, only then will you need to file a translation of the application documents into German. If you do not wish to pursue your application, it can be abandoned saving you any translation costs.

However, applications in other countries can be filed within the priority year and still reap the benefits of the early filing date of the first application filed with the GPTO.

This strategy allows applicants to use the GPTO as a cost-effective search authority that can deliver the required search results and provide an expert opinion on the patentability of the invention. Again the office fee for filing your search request is €300 and this cost will not incur any up-front translation expenses.

WOULD THIS BE A FILING STRATEGY FOR YOUR COMPANY?

If you would like to know more about how you and your company could take advantage of these changes, please contact Jochen Sties at j.sties@prinz.eu.

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