

# Intellectual Asset Management

## International reports



### Amendments to Patent Act and other IP laws on the way

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After the 2009 reform of the nullity and nullity appeal proceedings, the long-awaited next amendment to the Patent Act is expected to be proclaimed shortly. New rules regarding electronic file inspection will enter into force on the day after proclamation, while the remaining rules will enter into force on the first day of the sixth month after proclamation.

The new law will make procedures more efficient and transparent for both users and the German Patent and Trademark Office (GPTO). It also aims to align the GPTO's procedures with those at the European Patent Office (EPO).

The most important changes will be:

- The option to inspect files electronically over the Internet.
- Extension of the period for filing notice of opposition from three months to nine months.
- Introduction of a preliminary opinion on patentability to accompany the search report.
- Preservation of the priority date in case of failure to file the translation of the application documents in time.
- An extended period of 12 months from the filing date or 15 months from the priority date for filing the translation where the patent application documents are filed in English or French.

According to the existing law, it is possible to apply for a so-called 'patent of addition' under Section 16 of the act if the invention relates to the improvement or further development of a first-patented invention. The term of such a patent of addition ends at the same time as the term of the patent for the first invention. No renewal fees need be paid for a patent of addition. Under the new law, patents of addition will be discontinued – such patents require major administrative effort, but applicants apply for them in only a limited number of cases.

Until now, inspection of GPTO files has been possible via post only. Under the new law, it will be possible to carry out inspection of files electronically via the Internet. Electronic file inspection via the Internet has been available at the EPO for many years, facilitating file inspection and reducing costs for both users and the EPO.

Under the new law, electronic file inspection will be available not only for patents, but also for utility models, trademarks and designs.

At present, a patent can be granted before designation of the inventor. The new law will strengthen the inventor's right to be designated and no patent shall be granted without designation of the inventor.

Under the new law, the opposition period will be the same as for a European patent granted by the EPO – that is, nine months from the publication of the grant. The extension of the opposition period from three months to nine months will give opponents more time to prepare the notice of opposition. Particularly in cases where the coordination of several parties or parties within an international corporation is necessary, the extended nine-month opposition period will be helpful.

In addition, oral proceedings in opposition proceedings will generally be public, in contrast to the present situation. However, oral proceedings shall be kept private at the request of a party if such party can show a legitimate interest in excluding the public. This new rule is in line with EPO practice.

Another adaptation by the GPTO to EPO practice is the introduction of a preliminary opinion on patentability to accompany the search report. To compensate for the additional work to be done by the examiners, the lack of unity objection may be raised during the search. In case of lack of unity, the GPTO will search only the invention first mentioned in the claims. In contrast to EPO practice, the applicant need not respond to the preliminary opinion. Accordingly, the new search report including the preliminary opinion will be an interesting way for the applicant to assess its chances of success without having to initiate the examination procedure. While any third party can file a request for examination, only the applicant can file a request for search under the new law. The search fee will increase from €250 to €300 under the new law.



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Another important change in the law relates to the hearing during the examination procedure. While such a hearing is at the discretion of the examiner under the existing law, the new law will make a hearing mandatory at the applicant's request.

According to the new law, the applicant will not lose the priority date of a German first filing if the application was filed in a foreign language, but the necessary German translation was not filed within the prescribed period. Under the existing law, a missing German translation means that the application is deemed not to have been filed, whereas under the new law a missing German translation will result in the application being deemed to have been withdrawn.

Further, if the German patent application is filed in English or French, the German translation can still be filed within 12 months of the date of filing if no priority is claimed, or within 15 months of the priority date if priority is claimed. However, if a request for search or examination is filed, the GPTO can request the applicant to file the German translation earlier. The extended time limits for filing a German translation are expected to make the German patent system more attractive for foreign applicants.

Under the existing law, after the filing date it is possible to file missing drawings which are referred to in the application documents as filed, with the consequence that the filing date will be the date on which the missing drawings are filed. Under the new law, this possibility will also be available for any missing parts of the description.

Finally, with regard to claim fees for a Patent Cooperation Treaty (PCT) application, if a German patent application is based on an international PCT application, the number of claims filed with the PCT application determines the claim fees (€30 for the 11th and each subsequent claim) to be paid when entering the national phase in Germany. If the number of claims increase during the international phase, additional claim fees must be paid.

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