



beau de Loménie

THE GERMAN PATENT SYSTEM

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How to obtain a German National Patent or Utility Model

Patent protection in Germany can be obtained by filing either an application for a German National Patent, or by designating Germany, be it in a European Patent application or in a PCT application. Utility models are also available.

German National Patent

Filing

The application may be filed in any language. If a foreign language other than English or French is used, a German translation must be filed within three months. It must be filed within 12 months from filing and 15 months from the earliest priority date for applications filed in English or French¹. It is even possible to get such application examined prior to filing a translation (see below, chapter "Examination").

It is possible to obtain a filing date even if no claims are filed. However, the applicant is then invited to file claims.

A filing date can be obtained by mere reference to an earlier-filed application in a Paris Convention country, provided that the country, number and filing date of the earlier application are provided to the German Patent and Trademark Office (DPMA). However, within four months the applicant must submit a certified copy of the earlier patent application and its translation into German.

The inventors must be designated no later than 15 months after the application date or the (earliest) priority date.

No power of attorney is needed if the application is filed through a registered patent attorney.

Priority

If the priority of an application filed abroad is claimed under the Paris Convention the German application should be filed within 12 months of the earliest priority date. Two months from filing are available for claiming a priority and within 16 months date, country, filing number and a copy from the priority of the priority application(s) should be submitted.

No certified copy of the priority application is needed. It is sufficient to file a simple copy of the application within 16 months of the earliest priority date.

Formalities Examination

Upon receipt of the application, only formal requirements are checked by the German Patent Office to ensure that the application is complete, i.e. that all parts are present (incl. abstract, designation of inventors etc.) and that it is in a condition for publication (e.g. quality of drawings). If some formalities are not met, the Office will send an invitation to correct such deficiencies within 15 months from filing or priority date.

Publication of the Application

All German national patent applications are published 18 months after the filing date or the (earliest) priority date, if any. Early publication can be requested.

¹ As the option to file in any language exists upon filing a PCT application, no additional "translation period" is granted for national phases of PCT application. Hence, the national phase has to be entered in German within the prescribed 31-month term.

Search and Examination Procedure

It is possible to directly file a request for examination or to file a request for search only first. The only requirement is that examination is requested within seven years from the actual filing date. The search report is issued in a format similar to a European or International Search report. However, no time limit is triggered by the report and no response to the search report is required. Search and/or examination can be requested by anybody.

Also a third party may file a request for examination.

Upon search/examination, the examiner checks whether the claimed invention is of a patentable nature in general and whether the claims cover one invention only (see below "Unity"). The definition of patentable inventions given in the German Patent Act is the same as the one given in the EPC. In particular, computer programs as such (not the technical method implemented by the program) and business methods are generally not patentable. The examiner also checks if the claimed invention is novel and based on an inventive step.

Unity of invention

While the provisions regarding unity of invention are the same as in the EPC, and unity of invention requires all claims to be linked by a common inventive concept, a specific provision limiting the number of independent claims per category like in the EPC does not exist.

It is possible to include in a same application independent claims directed for example to a product, a process to obtain such a product and a use of that product. The common inventive concept may lie in the original features of the product. It is also possible to include several independent claims of the same category, such as several product claims. A common inventive concept will then be recognized when the claims show a same set of features which, when taken in combination, show a distinction over the prior art.

Without an objection for lack of unity in formal examination and upon request for search only, all claims are searched.

If lack of unity is found upon a request for examination, the applicant is invited to limit the parent application to one invention and to file a divisional application. A divisional application is possible while the parent application is pending and within a subsequent 1 month period for appeal.

Amendments

Amendments are possible from receipt of the examination request until a decision for grant, where adequate support can be found in the application as filed, and no new matter is introduced.

Acceleration of Examination/PPH

Accelerated handling can be requested upon reasoned request.

PPH (Patent Prosecution Highway) is available in Germany based on a bilateral agreement with China and on participation in the Global PPH system which covers over a number of patent offices (<https://www.jpo.go.jp/e/toppage/pph-portal/network.html>), including those of Canada, Germany, Japan, South-Korea and the USA.

Observations by third parties

Third parties may file observations at any time from publication to grant, such observations being limited to patentability objections.

Opposition

Opposition is available within 9 months from publication of grant.

Post-Grant Limitation

Limitation of either a national patent or the national part of a granted EP patent is available for the patent owner. The request is examined as in the case of a patent application and it is verified that the changes made indeed consist in a limitation.

Invalidation

Full or partial invalidation is no counter claim in a patent infringement suit but may be requested before the Federal Patent Court.

Utility Models

Basis of the utility model application

Utility model application is available in the form of:

- a first filing,
- a utility model application claiming priorities of an earlier patent or utility model application,
- a national phase of an international application, or
- a derivation from a patent application filed for Germany, be it a national, international or European application.

In particular an applicant of a patent application with effect for Germany (**e.g. a European or PCT** patent application) is entitled to claim the filing date and maintain a priority date of this patent application for a German utility model application

- within 10 years from the filing date of the patent application and
- until expiry of **two months from the end of the month**,
 - in which the patent application has been finally rejected or granted or
 - in which opposition proceedings were closed.

(§5(1) Gebrauchsmustergesetz, derivation of a utility model).

Novelty and prior art

A 6-month grace period applies to German utility models: a disclosure made by the applicant no more than 6 months before the filing date or the priority date is not opposable.

Also, prior public use only counts as the prior art if it occurred in Germany.

Subject-matter of a utility model

A utility model may be registered for **product claims** but not for method claims. In a peculiar case (concerning drugs) the Supreme Court has also allowed registration of a use claim (BGH, "Arzneimittelgebrauchsmuster" in BGHZ 164, 220 und GRUR 2006, 135).

Deriving a utility model is similar to claiming priority: everything disclosed in the prior patent application can be made subject to a utility model application, and this may even be done more than once. Hence, it is possible to "customize" different utility models to different infringing products based on one and the same patent application.

Duration

A maximum duration of a derived utility model is **10 years** from expiry of the last day of the month of the filing date of the patent application (§23(1) Gebrauchsmustergesetz).

Unexamined registered right

A utility model application is registered after approval in formal examination without substantive examination (in particular without examination for novelty and inventive step). Validity may be challenged by a defendant in an infringement suit or by a third party with cancellation proceedings. A valid utility model confers the same rights as a patent, i.e. the rights defined in Art. 28(1)(a) TRIPS and also protection against contributory infringement.

German national phases of PCT applications

The above also applies to German phases of PCT applications, except as regards the filing requirement. The time limit for entering the PCT national phase (Art. 22(1) PCT) is 31 months from the priority date. The German phase entry may be via a patent application and/or a utility model.

Conclusion

The German national route provides flexibility, with options to "slow-down" or accelerate prosecution. In particular deriving a utility model can be a strategy of accelerating and tailoring the establishment of rights to be enforced.