

# Kluwer Patent Blog

## Amendments to the German Patent Act and their Impact on Everyday Practice

Thorsten Bausch (Hoffmann Eitle) · Friday, January 31st, 2014

Owing to the amendments to the German Patent Act (GPA) passed with the so-called Patent-Act Amendment Act of October 19, 2013 (Federal Gazette 2013, 3830), a number of user-friendly changes have been implemented. The most important ones, including electronic file inspection, early first patent examination during search proceedings and improvements in patent opposition proceedings, as well as their entry into force are outlined in the following.

### 1) Electronic File Inspection

Up until now, despite the fact that IP files have been stored electronically at the GPTO since 2011, inspection of an IP file handled by the GPTO had to be requested in writing. The applicant could choose between asking for copies of excerpts from the file or to personally inspect the file at the GPTO.

With the GPA amendment, a legal basis for for electronic file inspection of patents, utility models, trademarks and designs has been provided and has entered into force already in October 2013. An electronic file inspection may now be performed by anyone, except in cases where files are not available to the general public or where information is not available owing to data-protection laws.

In practice, the electronic inspection of patent and utility model files has been possible since January 7, 2014 [via the GPTO register](#) (as PDFs and free of charge). The files available at present are restricted to patents granted and published as of 21 January 2013, utility models registered by this date, and patent or utility model applications that were filed on or after that date and have already been published.

For trademarks and designs it is expected that the technical requirements for electronic file inspection will be implemented in the near future. It is further noteworthy that the GPA amendment has introduced the legal basis for filing trademarks and designs as signature-free electronic applications; albeit it is not clear when this amendment will be put into practice.

### 2) Amendments to the Patent Application Proceedings

With the amendments to the Patent Act, substantive examination will now begin at an earlier date, while at the same time payment of relevant fees (in particular translation fees) may be deferred to a later date. This should assist applicants in early stage strategic planning of whether an application should indeed be prosecuted. Briefly:

– Currently the GPTO upon request searches for the relevant prior art of a patent application. The search report, however, does not include any statements with regard to patentability of the claimed subject matter. Such statements are often provided at a considerably later date, i.e. with the first examination report, thus delaying a reliable estimate of patentability for the applicant.

As of April 1, 2014, this practice will change and a first (preliminary) assessment of the patentability will be provided together with the search report, thus providing a better basis for future decisions.

At the same time, the search fee will increase from €250 to €300. Nevertheless, this remains considerably less than the search fee for International (PCT) or European patent applications. Thus, on the basis of the inexpensive, preliminary assessment of patentability provided with the search report, it might become more attractive to file at the GPTO a first (priority) application and to decide later on the filing of further applications in other countries.

Concurrent with the above changes third parties will no longer have the (rarely used) possibility to file a search request under Sec.43 GPA. They will still, however, be able to file a request for examination pursuant to Sec. 44 GPA.

– For a patent application filed in a foreign language a German translation of the application text, which can be substantial in costs, presently must be filed within three months from the filing date (Sec. 35 GPA). As of April 1, 2014 the time limit for applications originally filed in English or French will be extended to 12 months (but at the most 15 months from the priority date). If, however, a request for a search or examination is filed within this time limit, the Examiner can at his discretion require that a translation be filed earlier. Applications filed in other foreign languages remain subject to the current three month time limit. This is an amendment which will probably be welcomed by many foreign companies.

– Up until now, examiners could grant or refuse requests for hearings in patent examination proceedings at their discretion. As of April 1, 2014 applicants will be given the right to a hearing during examination proceedings (Sec. 46 GPA), i.e. a request for a hearing made before a decision is issued as to the grant or rejection of a patent application must be granted.

### **3) Amendments to Patent Opposition Proceedings**

Currently, a patent can be opposed within three months of the date of grant. This time limit was often found to be too short. Therefore, the time limit will be extended to nine months for lodging an opposition, resulting in more time for gathering evidence and for preparing the opposition statement. The correspondingly amended Sec. 59 GPA will enter into force on April 1, 2014. According to a statement recently published by the GPTO, the new nine-month time limit shall be applied to all granted patents for which the current three-month time limit has not yet expired on April 1, 2014. This relates to all publications of grant dated January 1, 2014 or later.

In addition, oral hearings in opposition cases in the future (again as of April 1, 2014) will be open to the public.

### **4) Outlook**

The amendments of the GPA modernize the German patent proceedings and create more harmony with the EPO practice. The electronic IP file inspection and the future publicity of patent

opposition hearings should make it easier for third parties to become/remain informed of any proceedings at the GPTO of interest to them.

The amendments will make the pre- and post-grant patent proceedings at the GPTO more attractive and more transparent. It will be interesting to see whether these amendments will affect the number of patent applications filed at the GPTO and/or oppositions filed against German patents.

Matthias Wolf/Stephan Kutik

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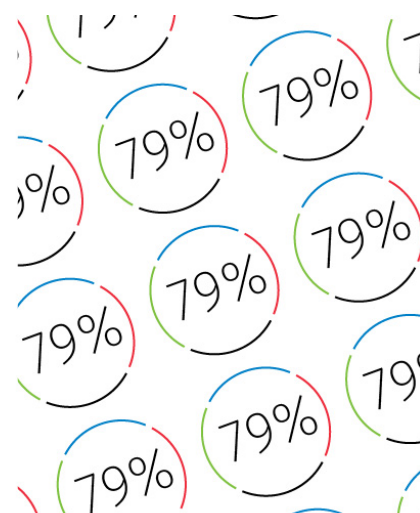
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