German Patent
and Trade Mark Office

Important Notices

of the German Patent and Trade Mark Office 2016

Please note: The links in the notices no longer work.

Table of contents

Notice of 21 January 2016

Chinese and German offices extend Patent Prosecution Highway (PPH) pilot 2

Notice of 21 March 2016

Notice on the change of name of the Office for Harmonization in the Internal Market to European Union Intellectual Property Office 3

Notice of 31 May 2016

in view of the earthquakes in the south-west region of Japan and their impact 4

Notice of 15 July 2016

on the Common Communication of the European Union Intellectual Property Office (EUIPO) and national offices on the common practice of the requirements for graphic representation of designs 5

Notice of 29 September 2016

on the Common Communication on the Common Practice on the General Indications of the Nice Class Headings and on the Common Communication on the Implementation of 'IP Translator' 6

Notice of 21 January 2016

Chinese and German offices extend Patent Prosecution Highway (PPH) pilot

Since 23 January 2012, patent applicants have been able to request accelerated examination of their applications at the German Patent and Trade Mark Office (DPMA) and at the State Intellectual Property Office of the People's Republic of China (SIPO). This option will continue to be available. The DPMA and SIPO have extended the pilot programme's duration by a further two years until 22 January 2018. Otherwise, it would have run out on 22 January 2016.

The PPH allows the applicant to file a request for accelerated examination as soon as at least one patent claim has been found to be patentable by the partner office. The DPMA will then carry out an independent search on the basis of the partner office's work results. The applicant benefits from the sharing of work results between the offices. This can even further expand prior art search.

The DPMA has had a long-standing relationship of close cooperation with SIPO. In addition to the bilateral PPH agreement with SIPO the DPMA takes part in the Global PPH pilot, in which 21 offices in total are participating.

More information on the PPH programme with SIPO at https://www.dpma.de/english/patents/protection_outside_germany/pph/index.html.

Notice of 21 March 2016

Notice on the change of name of the Office for Harmonization in the Internal Market to European Union Intellectual Property Office

Amendments to the Community trade mark regulation of the European Union will enter into force on 23 March 2016 (EU Regulation no. 2015/2424). As from that date, the Office for Harmonization in the Internal Market (OHIM) in Alicante, Spain, will change its name to European Union Intellectual Property Office (EUIPO). Community trade marks will then be called European Union trade marks. OHIM's emblem will be kept as the distinctive image of the office, only the name and the abbreviation will be replaced.

The Amending Regulation is part of the EU trade mark reform legislative package that also includes the replacement of the existing EU Trade Mark Directive (Directive 2008/95/EC of the European Parliament and of the Council). The name of the basic Regulation changes from Community Trade Mark Regulation (CTMR) to European Union Trade Mark Regulation (EUTMR). All existing Community trade marks (CTMs) and Community trade mark applications will automatically become European Union trade marks or applications for a European Union trade mark from the entry into force. The Amending Regulation also changes the fees payable to the office, including an overall reduction in their amounts, particularly significant in the case of renewals, and the adoption of a one-class-per-fee system.

The change of name also affects the online presence and the e-mail addresses of the EUIPO. From 23 March the e-mail addresses will change to "forename.surname@euipo.europa.eu", the Internet address to "www.euipo.europa.eu". The German Patent and Trade Mark Office will change any reference to 'OHIM' to read 'EUIPO' on its website and the print publications as soon as possible.

Information on the amendments to the Community trade mark regulation is available at EU trade mark regulation.

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Notice of 31 May 2016

in view of the earthquakes in the south-west region of Japan and their impact

In view of the earthquakes in the south-west region of Japan and their impact, the German Patent and Trade Mark Office draws attention to the following:

The German Patent and Trade Mark Office will take the current situation in Japan into account in managing IP procedures, within the scope of legal options.

This applies specifically to granting requests for the extension of time limits set by the German Patent and Trade Mark Office. The German Patent and Trade Mark Office cannot extend time limits specified by law. However, the German Patent and Trade Mark Office draws attention to the option of re-establishment of rights. Any person who, owing to the current situation in Japan, has not observed a time limit imposed by law without any fault on his part can subsequently have their rights re-established upon request. They will then be in the same position as if they had observed the time limit. The unit in charge will check in the individual case whether the conditions are met.

Please refer to the relevant provisions in the individual IP laws for the detailed requirements and the scope of application of re-establishment of rights. The German texts are available at www.gesetze-im-internet.de.

The provisions concerning re-establishment of rights are set out for procedures

- in patent matters in Section 123 of the German Patent Act (Patentgesetz)
- in trade mark matters in Section 91 of the German Trade Mark Act (Markengesetz)
- in design matters in Section 23(3), third sentence, of the German Design Act (Designgesetz) in conjunction with Section 123(1) to (5) and (7) of the Patent Act
- in utility model matters in Section 21(1) of the German Utility Model Act (Gebrauchsmustergesetz) in conjunction with Section 123 of the Patent Act
- in semiconductor matters in Section 11(1) of the German Semiconductor Protection Act (Halbleiterschutzgesetz) in conjunction with Section 123 of the Patent Act

Notice of 15 July 2016

on the Common Communication of the European Union Intellectual Property Office (EUIPO) and national offices on the common practice of the requirements for graphic representation of designs

Within the framework of the Convergence Programme of the EUIPO and national offices for a common practice, a project was launched to develop guidelines for the requirements for graphic representation of designs, which were published in a Common Communication of 15 April 2016.

The scope of this project included the development of a common practice and common guidelines for the requirements in the application procedure concerning the graphic representation of designs. Focus was on the disclaimers as well as the acceptable types of views and rules to assess if a background is neutral.

The guidelines of the Communication will be implemented by the German Patent and Trade Mark Office in the design registration procedure from 15 July 2016.

Please refer to the Common Communication for contents and results of the project.

Notice of 29 September 2016

on the Common Communication on the Common Practice on the General Indications of the Nice Class Headings and on the Common Communication on the Implementation of 'IP Translator'

Within the framework of the Europe-wide harmonisation of the classification, convergence on the interpretation of the Nice class headings was achieved. Following the CJEU's judgment 'IP Translator' (C-307/10 of 19 June 2012), the class headings were examined with regard to whether the general indications are sufficiently clear and precise for the competent authorities as well as the economic operators to be able to determine the scope of trade mark protection exclusively on the basis of the general indications. The outcome was that five terms of the class headings were deemed to be too vague. Please refer to the Common Communication on the Common Practice on the General Indications of the Nice Class Headings of 28 October 2015 for the reasons why the terms are non-acceptable.

Anyone using Nice class headings obtains protection only for descriptions that cover the literal meaning of the class headings. Some European trade mark offices had a different practice with regard to this issue. The Common Communication on the Implementation of 'IP Translator' of 24 September 2016 contains a complete overview of the practices of all European IP offices before and after the 'IP Translator' judgment.

Please also refer to the DPMA notice on the 'IP Translator' judgment of 12 November 2012 (available in German only).

Also relevant in this connection:

- Non-acceptable general indications of the Nice class headings
- Interpretation of the implementation of the CJEU's judgment 'IP Translator'
- Non-acceptable general indications of the Nice class headings
- Interpretation of the implementation of the CJEU's judgment 'IP Translator'

The CJEU has determined that general indications of Nice class headings can be used in lists of goods and services if the indication is sufficiently clear and precise. The CJEU did not comment as to which of those general indications are sufficiently clear and precise within this meaning.

Classification experts of the EUIPO and of numerous European trade mark offices have discussed this question and examined all of the Nice class headings. They have come to the conclusion that five general indications of the class headings are not sufficiently clear and precise; all other general indications can be used for lists of goods and services.

The following terms of the Nice class headings may not be used on their own in the list of goods and services of a trade mark:

- Class 7 - machines

- Class 37 - repair
- Class 37 - installation services
- Class 40 - treatment of materials
- Class 45 - personal and social services rendered by others to meet the needs of individuals