German Patent
and Trade Mark Office

Important Notices

of the German Patent and Trade Mark Office 2017

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

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Notice of 30 June 2017

on the Act Implementing the Directive on the Recognition of Professional Qualifications and Amending Other Provisions in the Field of Professions Providing Legal Advice of 12 May 2017

On 17 May 2017, the Act Implementing the Directive on the Recognition of Professional Qualifications and Amending Other Provisions in the Field of Professions Providing Legal Advice (*Gesetz zur Umsetzung der Berufsanerkennungsrichtlinie und zur Änderung weiterer Vorschriften im Bereich der rechtsberatenden Berufe*) of 12 May 2017 was promulgated in the Federal Law Gazette (Bundesgesetzblatt - BGBl. I p. 1121). Its main purpose is to implement the Directive 2005/36/EC of the European Parliament and of the Council on the recognition of professional qualifications, which, above all, contains provisions on the freedom to provide services and on the freedom of establishment. The Act entered into force on 18 May 2017.
The following areas contain important changes concerning the German Patent and Trade Mark Office (DPMA):

- 1. Training for patent attorneys in the field of IP protection (Article 4 of the Act: amendment of the Patent Attorney Code (*Patentanwaltsordnung*)

- 2. Provisions on the activities of patent attorneys from the European Union, the European Economic Area and Switzerland (Article 5: Act on the Activities of European Patent Attorneys in Germany (*Gesetz über die Tätigkeit europäischer Patentanwälte in Deutschland*)

- 3. Amendments in IP acts concerning applicants of IP rights having neither a residence nor a principal place of business nor an establishment in Germany (provision concerning domestic representatives, Articles 13-17)

The changes in detail:

No. 1: Training for patent attorneys - Recognition of periods of training in the field of IP protection conducted abroad
Periods of practical training in the field of IP protection conducted abroad of up to twelve months - instead of formerly six - can now be recognised as periods of training under the supervision of a patent attorney or a patent agent (Patentassessor) (Sec. 7(2), first sentence, Patent Attorney Code).
Guidelines on the requirements for the organisation and contents of the training as well as on the requirements to be met by the supervisor of the training will be published by the DPMA on its website (Sec. 7(2a) Patent Attorney Code).

No. 2: Patent attorneys from the European Union, the European Economic Area and Switzerland (European patent attorneys)
a. Examination of professional qualifications for admission to practise as patent attorney (Sec. 1 Act on the Activities of European Patent Attorneys in Germany):
The conditions under which patent attorneys from the European Union, the European Economic Area and Switzerland can practise in Germany have been comprehensively revised

in the new Act on the Activities of European Patent Attorneys in Germany. The previous Act on the Qualifying Examination for Admission as a Patent Attorney (*Gesetz über die Eignungsprüfung für die Zulassung zur Patentanwaltschaft*) no longer applies.

European patent attorneys who seek admission as patent attorneys in Germany must apply to the DPMA for a declaration of equivalence of their (foreign) professional qualifications in comparison with the professional qualifications required for the practice of the profession of patent attorney in Germany (Sec. 1 Act on the Activities of European Patent Attorneys in Germany). For this purpose, training and qualification certificates (generally from the country of origin) must be submitted to the DPMA. Now, among those entitled to apply under certain conditions are also those patent attorneys who come from member states in which the profession of patent attorney is not regulated.

Insofar as the DPMA does not directly determine the equivalence of the professional qualifications, the European patent attorney - as before - has the option to take a qualifying examination. The qualifying examination in its new form will be conducted by the DPMA for the first time in June 2018 (Sec. 30 Act on the Activities of European Patent Attorneys in Germany). New rules on the contents of the examination will be included in the newly revised Patent Attorney Training and Examination Ordinance (*Patentanwaltsausbildungs- und prüfungsverordnung*), which is currently being prepared.

b. Partial access to the profession of patent attorney (Sec. 12 Act on the Activities of European Patent Attorneys in Germany):
It is now also possible to gain partial access to the profession of patent attorney. This option is particularly relevant if different patent attorney professions (patent law, trade mark law) exist in the country of origin – e.g. in France and Italy. It is intended to allow those patent attorneys to perform correspondingly limited activities in Germany as well. For the protection of those seeking legal advice, the patent attorneys with partial access must work under the professional title of their country of origin, translated into German.

c. European patent attorney providing services (Secs. 13, 15 Act on the Activities of European Patent Attorneys in Germany):
For the first time, there are rules governing the freedom to provide services of European patent attorneys. Prior to their first professional activity in Germany, they must notify the Chamber of Patent Attorneys (*Patentanwaltskammer*) and repeat this notification annually. The Chamber of Patent Attorneys checks whether those patent attorneys are entitled to practise in Germany and exercises supervision. For this purpose, the Chamber maintains a register of patent attorneys of EU member states providing services, which is open to public inspection.

No. 3: Domestic representative
Applicants of IP rights who have neither their residence nor their principal place of business nor an establishment in Germany must appoint a domestic representative. The requirement that a domestic representative must be a national of an EU member state or a state party to the EEA does no longer apply. The corresponding provisions in Section 25(2) Patent Act, Section 28(2) Utility Model Act, Section 96(2) Trade Mark Act and Section 58(2) Design Act were repealed.

The appointment of a domestic representative continues to be a mandatory procedural requirement for processing pending proceedings involving a party based abroad. In future, lawyers or patent attorneys from the European Union, the European Economic Area or Switzerland will also be admitted as domestic representatives provided that they are "entitled and authorised to represent parties in proceedings before the Patent Office, before the Patent Court and in civil disputes affecting the patent, as well as to file an application for criminal prosecution" (Sec. 25(1) Patent Act (new version), Sec. 28(1) Utility Model Act (new version), Sec. 96(1) Trade Mark Act (new version), Sec. 58(1) Design Act (new version)).

The entitlement is based on the relevant provisions concerning access to the professions of lawyer and patent attorney as well as on the provisions concerning temporary services. Thus, European patent attorneys practising in Germany either as admitted patent attorneys (Secs. 1, 12 Act on the Activities of European Patent Attorneys in Germany) or as service-providing patent attorneys (Section 13 Act on the Activities of European Patent Attorneys in Germany) will also be admitted in future. European lawyers (with the exception of European lawyers providing services and in-house counsels) or patent attorneys who lawfully practise in Germany are published by the German Chambers (the Chamber of Lawyers and the Chamber of Patent Attorneys) in registers, which are open to public inspection.

Links for further information:

Official Nationwide Register Of Lawyers by the German Chamber of Lawyers (https://www.bea-brak.de/bravsearch/search.brak)

Official Nationwide Register of Patent Attorneys (https://www.patentanwaltsregister.de/(X(1)S(scdxcx45mrcm3huzck5mwe33))/Suche.aspx?lang=en)

Register of Patent Attorneys of the EU-Member State providing services (https://www.patentanwalt.de/en/chamber/patent-attorneys-of-the-eu-member-state-providing-services/register-of-patent-attorneys-of-the-eu-member-state-providing.html)

Gesetz zur Umsetzung der Berufsanerkennungsrichtlinie vom 12.05.2017 (in German) (Act Implementing the Directive on the Recognition of Professional Qualifications of 12 May 2017) ((https://www.dpma.de/docs/dpma/veroeffentlichungen/gesetzzurumsetzungderberufsanerkennungsrichtliniel.pdf)

Notice of 2 October 2017

Modernised: Patent Attorney Training and Examination

On 1 October 2017, the revised "Ordinance Concerning the Training and Examination of Patent Attorneys" (*Verordnung über die Ausbildung und Prüfung der Patentanwälte*) entered into force (Federal Law Gazette I, p. 3437 et seqq.). The ordinance aims at streamlining the patent attorney training and simplifying administrative processes. The former Ordinance Concerning Patent Attorney Training and Examination had remained largely unchanged since its entry into force in 1967.

Overview of the main changes

Training:

- For the first time, the duration of the training at a patent law firm or a patent department is limited to a maximum of three years (Section 7, no. 1 Ordinance Concerning the Training and Examination of Patent Attorneys).

- During the training, 30 instead of 24 days of recreational leave per training year are taken into account for the training period (Sec. 11 Ordinance Concerning the Training and Examination of Patent Attorneys). The ordinance contains also further provisions on the recognition of vacation and sick leave periods.

- For the first time, Section 9 of the Ordinance Concerning the Training and Examination of Patent Attorneys prescribes that, after an interruption of the training, previous training periods will, as a rule, be recognised if the training has not been interrupted for more than one year and the training objective can still be achieved.

- The interest rate on the maintenance loan to which patent attorney candidates are entitled during their training at a patent litigation court, at the German Patent and Trade Mark Office and at the Federal Patent Court as well as during their examination period will be reduced from 6% to 3% per annum (Sec. 66 Ordinance Concerning the Training and Examination of Patent Attorneys).

Patent attorney examination:

To enhance legal certainty many questions about the procedure are explicitly stipulated in the Ordinance Concerning the Training and Examination of Patent Attorneys.

The patent attorney examination in accordance with the new provisions will take place for the first time at the examination date in June 2018 (Secs. 33 et seqq., 77 (4) Ordinance Concerning the Training and Examination of Patent Attorneys).

- The prospective patent attorneys sit four written examinations in total (two four-hour examinations and two three-hour examinations).

- In future, the examinations will be evaluated according to the 18-point system known from the lawyers' training.

- The examination fee is tailored towards the new examination system and was increased for the first time in 28 years. It amounts to 650 euros as of 1 June 2018 (so far 260 euros, see Sections 37, 77 (3) Ordinance Concerning the Training and Examination of Patent Attorneys).

Further information

More detailed information on the patent attorney training and examination is available at https://www.dpma.de/english/our_office/about_us/further_duties/patent_attorney_training/index.html.

Qualifying examinations for foreign patent attorneys

In addition, the qualifying examination procedure for foreign patent attorneys will be revised. The former Act on the Qualifying Examination for Admission to Practise as a Patent Attorney (*Gesetz über die Eignungsprüfung für die Zulassung zur Patentanwaltschaft*) was already replaced, with effect from 18 May 2017, by the Act on the Activities of European Patent Attorneys in Germany (*Gesetz über die Tätigkeit europäischer Patentanwälte in Deutschland*, Federal Law Gazette I, pp. 1121,1137), in which the qualifying examination is now regulated in Sections 2 et seqq. These provisions are supplemented and more clearly defined by Sections 67 to 75 of the Ordinance Concerning the Training and Examination of Patent Attorneys. However, Sections 5, 6 of the Act on the Activities of European Patent Attorneys in Germany and Sections 69 to 72 of the Ordinance Concerning the Training and Examination of Patent Attorneys will not be applied until 1 June 2018.

More information is available in our *Hinweis zur Berufsanerkennungsrichtlinie* (information about the Directive on the recognition of professional qualifications) (in German).

Notice of 14 November 2017

on the handling of requests for extension of time limits and comments in opposition proceedings

An opposition may result in the - or, in the event of the rejection of the opposition - in the trade mark registration being sustained. In order to reach a decision, as quickly as possible, on whether or not to sustain the trade mark registration, the DPMA is working intensively towards fast execution of opposition proceedings. On the other hand, it is also important to give parties in opposition proceedings sufficient scope for negotiating delimitations and for well-founded comments on legal issues arising.

In this context, the following should be noted:

A first extension of the time limit (of normally two months) may be granted if sufficient reasons are presented (Sec. 18(2) DPMA Ordinance).

For all further extensions of the time limit, a prima facie legitimate interest and consent of the parties concerned must be shown (Sec. 18(3) DPMA Ordinance). In future, these extensions of time limits will be granted for up to a maximum period of six months. If the negotiations on delimitations have not yet been concluded when the period expires, a further request for extension of the time limit can be furnished.

Each formal written statement will be sent to the other party to the proceedings (principle of the right to be heard). However, the DPMA assumes that the parties to the proceedings provide a comprehensive comment in their respective first formal written statement. Therefore, subsequently, further formal written statements will be served by the DPMA inviting the recipients to make a final comment.