German Patent
and Trade Mark Office

Important Notices

of the German Patent and Trade Mark Office 2018

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

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Notice of 19 January 2018

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 three years until 22 January 2021.

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 and close cooperation with SIPO. In addition to the bilateral PPH agreement with SIPO the DPMA takes part in the Global PPH pilot, in which 25 offices in total are participating.

More information on the PPH programme with SIPO is available on our webpage "Patent Prosecution Highway".

Notice of 24 April 2018

DPMA has revised encryption technology for data traffic on the Internet

The German Patent and Trade Mark Office (DPMA) has revised its encryption technology for data traffic on the Internet and will no longer use the previous transport layer security encryption methods TLS 1.0 and TLS 1.1. From now on, only so-called "cipher suites" with TLS protocol 1.2 are used on the public web servers of the DPMA, which comply with the requirements of Technical Guideline TR-0212-2 "Kryptographische Verfahren: Empfehlungen und Schlüssellängen, Teil 2 – Verwendung von Transport Layer Security (TLS)" ("Cryptographic Procedures: Recommendations and key lengths, Part 2 - Use of Transport Layer Security (TLS)") of the Bundesamtes für Sicherheit in der Informationstechnik (Federal Office for Information Security). A cipher suite comprises standardized cryptographic encryption procedures (algorithms and key lengths), which are intended in particular to make data traffic to and from government institutions more secure.

In order to facilitate the changeover for users of the DPMA website and the online services of the Office (DPMAconnect, DPMAregister, DPMAdatenabgabe, DEPATISnet, DEPATISconnect, Depatis externer Client, DPMAfachdatenbanken, TMView), the DPMA has tested various browsers and tools supporting the TLS protocol 1.2. Information on this can be found on the help page in DPMAregister. Information on other browsers that work with the new encryption can be found on the website of Qualys, a provider of security systems. Users can also try at https://ref-tmview.dpma.de/tls_v12.html to test whether their self-developed clients (e.g. Java clients) can establish an encrypted connection to the DPMA.

Please note: DPMA customers who use self-generated Java clients based on Oracle Java 1.7.x or older can no longer search the online services of the DPMA with these Java clients.

Notice of 14 December 2018

on the Act implementing Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (Trade Mark Law Modernisation Act) of 11 December 2018

On 14 January 2019, the Trade Mark Law Modernisation Act (*Markenrechtsmodernisierungsgesetz*) and thus the amendment of the Trade Mark Act (*Markengesetz*) comes into force. The Act implements the EU Trade Mark Law Directive 2015/2436 of 16 December 2015 (MRL) into national law and introduces the following significant changes to the Trade Mark Act, the Trade Mark Ordinance (*Markenverordnung*) and the Patent Costs Act (*Patentkostengesetz*):

1. Abolition of graphic representation – determinability and new types of trade marks

Whereas trade marks in the register previously had to be capable of being represented graphically, in future it will suffice if they can be clearly and precisely determined. This change aims to meet the market needs for modern trade mark types and also takes into account the technical possibilities of representing a trade mark in the electronic register. In the future, for example, sound marks, multimedia marks or holograms in suitable electronic formats and other types of trade marks may be registered, provided they are eligible for protection.

2. The national certification mark

The certification mark is introduced into German trade mark law as a new trade mark category. Unlike the individual trade mark, the certification mark focuses on the guarantee function, not on the function of a mark as an indication of origin. A certification mark must be capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of material, mode of manufacture, quality, accuracy or other characteristics of goods or performance of services, from goods and services which are not certified accordingly. The certifying character of the mark must result from the representation of the sign. In the mandatory regulations governing use of the trade mark, the trade mark proprietor must, for example, provide information on the guaranteed characteristics of the goods, the conditions of use as well as on the testing and monitoring measures.

3. New name and fee: cancellation proceedings become revocation or invalidity proceedings

Cancellation proceedings are renamed "revocation proceedings" or "invalidity proceedings". From 14 January 2019, the fee for invalidity proceedings is 400 euros.

4. New absolute grounds for refusal in the Trade Mark Act

Protected geographical indications and protected designations of origin, in particular for foodstuffs, wines and spirits protected under national or European legislation or agreements, are included as absolute grounds for refusal. In addition, protected traditional terms for wine, traditional specialities guaranteed with regard to foodstuffs have to be

considered as absolute grounds for refusal during the application procedure or invalidity proceedings. Trade marks containing such indications, directly or indirectly, can only be registered for goods that are explicitly conforming to the specification. Plant variety denominations enjoying protection in Germany or the EU in accordance with national or international legal provisions may now prevent the registration of an identical or an essentially identical trade mark.

5. Registration of licences/register entry about willingness to license or sell/transfer

Licences will in future be entered in the register upon a written request. The entry includes information on the licensee, the type of licence and restrictions, if any (Sec. 42a Trade Mark Ordinance). The registration, amendment and cancellation of a licence in the register will be subject to a fee (50 euros each). In addition, upon request, trade mark applicants and proprietors may have an entry included in the register about a non-binding declaration of their willingness to license or sell/transfer their trade mark. The entry is free of charge. This willingness may be withdrawn at any time.

6. Changes regarding term of protection and renewals

The term of protection for trade marks registered on or after 14 January 2019 will end exactly ten years after the filing date and not, as previously, ten years after the end of the month in which the trade mark was applied for. For trade marks already registered the old provision continues to apply. The DPMA will inform the trade mark proprietors eight months in advance of the expiry of the term of protection of their trade mark.

In future, the date of expiry of the term of protection and the due date of payment of the renewal fee will differ. The request for renewal must be filed within a six-month period before the end of the term of protection or within an additional period of six months after the end of the term of protection. Accordingly, the renewal fees and, if applicable, the class fees for the following term of protection are due six months before the expiry of the term of protection. If the renewal fee and class fees, if any, are only paid after expiry of the term of protection, surcharges must be paid in addition to the renewal fee within the additional six-month period. The old version of the Patent Costs Act (*Patentkostengesetz*) is applicable for registered trade marks whose term of protection expires twelve months after 31 January 2019, at the latest.

7. Reclassification abolished

If the division into classes of goods and services is altered after the filing date, the classification will not be adjusted upon renewal of the trade mark, neither at the request of the proprietor nor *ex officio*.

8. Changes in the opposition proceedings

The system applied to opposition proceedings will change: Whereas in the past, filing an opposition was only possible on the basis of one opposing sign, the holder of several earlier rights will now be able to assert them by lodging a single opposition. Protected geographical indications and protected designations of origin are introduced as new, additional grounds

for opposition.
The opposition fee will be brought into line with the new system and the increased effort involved and is now 250 euros for one opposing sign instead of 120 euros previously. For each additionally opposing sign asserted, a further 50 euros are now due.
In order to facilitate negotiations between the parties to the proceedings, a period of at least two months will be granted at their joint request to reach an amicable settlement ("cooling-off"). This period may be extended by a joint request.

The second objection of non-use with the moving period of use pursuant to Section 43(1), second sentence, of the Trade Mark Act is repealed. For these cases, however, cancellation proceedings due to revocation (new: "revocation proceedings") are still available. In future, proof of use will be required instead of making a plausible case. However, the affirmation in lieu of an oath is still allowed pursuant to Section 43(1), second sentence, of the Trade Mark Act. In future, the five-year period for which proof of use of the opposing trade mark must be furnished will begin five years before the filing date or the priority date of the challenged trade mark, instead of the five years before the date of publication of the registration of the challenged trade mark, as previously applicable.

In future, the grace period for use will commence on the date when no further opposition is possible against the registration of a trade mark. This is either the date from which an opposition can no longer be lodged due to the expiry of the opposition period, or the date on which the decision which concluded the opposition proceedings becomes final or the date on which the opposition was withdrawn. The beginning and end of the grace period for use shall be entered in the Trade Mark Register (Sec. 25 no. 20a Trade Mark Ordinance).

These changes will also apply to oppositions within the framework of the procedure for the extension of protection of international registrations of marks to the territory of the Federal Republic of Germany.

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