

BIOTECH BUZZ

International Subcommittee

January 2015

Contributor: **Dr. Michaela Elbel**

Recent Patent Law Changes in Germany:

The German Patent and Trademark Office (GPTO) Becomes more attractive for cost-sensitive international applicants who are seeking patent protection in a small number of European countries

The unitary patent (EU patent) will come into force in the near future, even though ratification of European law into the jurisdictions of the individual member states is currently slowing down the process. The unitary patent will be valid in more than 20 member states, however, Italy and Spain are unlikely to be on board. The European Patent Office (EPO), besides being responsible for search, examination and grant, will also be responsible for collecting, administering and remitting renewal fees for unitary patents. It is still not exactly known, how much the annuity fees for the unitary patent will be, but the cost will sure be higher than the current annuity fees for just two or three countries (e.g. UK, Germany and France).

Budgets are tight all over the world, patentees are cost sensitive, and there is a tendency to reduce patent protection in Europe and spend the money in Asia, particularly in China and South Korea instead. This is why the German Patent and Trademark Office (GPTO), the world's 5th largest patent office, with a long history in patent search, examination and grant, backed-up by the low-priced, in general *pro-patentee* infringement jurisdiction of Germany's courts, initiated and pushed the latest German patent law change (German *Patentrechtsnovelle*) in 2014 – with an enormous and immediate effect.

Applicants may file a national German patent application (with or without claiming a Paris Convention Priority) in English. If the application is to be kept in force, the deadline for filing a German translation has been extended from three to twelve months. Even if no translation is filed, the applicant has now two major advantages: (i) the application will only be deemed to be withdrawn instead of treated as if never filed in the past. This means that the priority right of the English language application may be used at any patent office world wide to claim its priority for e.g. an international patent application; (ii) the applicant will receive a substantive search report, supplemented with a preliminary examination report in English within the priority year. This report is comparable to the extended European search report (EESR) provided by the EPO for priority applications. The report may form a good basis for the decision on whether an international PCT application shall be filed. The official fees for filing the application with the GPTO including the search fee are about the same as for a UK application, and about 25% of the cost for a comparable EP application.

A good command of the English language is a job requirement for a German patent examiner. The German examiners all have a technical university diploma or master's degree, several years of practical experience in industry and have either acquired their language skills in an English speaking country or during extensive study and training at a university or in industry. Additionally, most of the prior art is in English. Thus, the German patent examiners now combine the thorough German search with a high quality English language examination report – for the benefit of international applicants.

If the applicant seeks European patent protection in just a few countries, and Germany is among them, he may file a German national phase entry including a German translation of the application based on a PCT application filed anywhere in the world. The deadline is 30 months from the earliest claimed priority date (PCT30 as in the US). Let's assume that the priority application was filed in English with the GPTO, the German examiner established the preliminary examination report, and the claims of the PCT application are still in line with the claims of the priority

application. Under these circumstances, the chances for a quick German grant are very high if the applicant complies with the objections mentioned in the preliminary examination report. In other words, the applicant will already know within the priority year of his first application how his future German patent may look like.

German and European patent law are fully harmonized. However, there are differences in details. German jurisdiction tends to grant stronger patents, and the scope of protection tends to be broader than e.g. of UK patents. Therefore, the person skilled in the art may know a little more than in Europe, however, non-unitary objections, e.g. in biotechnology applications, are less likely.

The next big step in German patent law would now be allowing national phases in Germany (PCT30) from English PCT applications without the requirement to file a German translation.

In summary, the GPTO and national German patents may be a great alternative for international applicants who are seeking patent protection in just some European countries.

Nothing herein should be construed as legal advice or legal representation. *Click here for an expanded disclaimer.*

Dr. Michaela Elbel is a partner of PATERIS Patent Attorneys

<http://www.pateris.de/en/your-consultants-in-munich.html>