



Standing Committee on Patents
Questionnaire on the Publication of Patent Applications

National Group: Germany

Reporter: Karsten KOENIGER

Date: 31 August 2016

Germany

Questions

Groups are invited to answer the following questions under their national laws:

I. Analysis of current law and case law

1. Please provide a brief description of your law concerning publication of patent applications and identify the statute, rule or other authority that establishes this law.

German patent applications are published by the German Patent and Trade Mark Office 18 months after the priority date (Sections 32, 31 German Patent Act). If the applicant agrees, the application is published earlier.

2. Does publication of patent applications occur automatically in your jurisdiction? If so, when does publication take place? If not, what are the requirements to effect publication?

Yes, the publication occurs automatically. The publication takes place 18 months after the priority date.

3. If a patent application claims priority from or the benefit of an earlier application how, if at all, does this affect the timing of publication?

Yes, the 18 months period begins as from the claimed priority date.

4. Is there a specific point in time up to which the applicant can withdraw its application without it being published?

According to Section 32 paragraph 4 German Patent Act the patent application is published even in cases where the application is withdrawn or refused or deemed to be withdrawn after the technical preparations for publication had been completed. The German Patent and Trade Mark Office has communicated that the publication can be stopped if the withdrawal takes place 8 weeks before the intended publication date. Therefore, it can be said that the point in time up to which the applicant can withdraw its application without being published is 16 months as from the priority date.

5. What parts of a pending patent application are published?

Claims, description and drawings.

6. Does a published pending patent application give rise to provisional rights (or

Germany

any type of interim protection) in your jurisdiction and, if so, to what extent?

A published German or a published European patent application does not give rise to injunctive relief in Germany. However, according to Section 33 of the German Patent Act, as from the publication the applicant can claim compensation which is reasonable in the circumstances from any person who used the subject-matter of the application although he knew or should have known that the invention he used formed the subject-matter of the application.

7. Does an unpublished pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?

No.

8. Is 'early publication' allowed in your jurisdiction? If so, what are the conditions for such early publication? How is the request for early publication made? What is the effect of an early publication on a pending patent application?

Yes (Section 31 paragraph 2 German Patent Act). The applicant has to file a request (and the name of the inventor has to be specified before).

The effect of an early publication is the same as the effect of a normal publication.

9. Is non-publication possible in your jurisdiction? In other words, can a pending patent application remain confidential? If so, under what conditions is such allowed? How is the request for non-publication made?

A non-publication is only possible if the invention constitutes a state secret or if the invention is kept secret by a foreign state for defence reasons and entrusted to the Federal Government, with its consent, on condition that it be kept secret (Section 50 German Patent Act).

10. Will a lapsed, abandoned or withdrawn patent application be published? If not, is that automatic or by the request of the applicant? If it would otherwise be published, can the applicant request non-publication?

If the patent application is not pending anymore, a publication does not take place (see question 4, however).

11. What is the position in your jurisdiction regarding the publication of continuation, continuation-in-part and divisional applications?

Germany

Divisional patent applications are published if 18 months have passed since the priority date.

II. Policy considerations and proposals for improvements to your current system

The following questions are not answered because, for reason of time, it was not possible to discuss and agree on these questions within the German group.

12. Should there be a requirement for automatic publication of pending applications by a particular deadline?
13. Should there be a right for the patentee to request early publication? If so, on what basis and with what consequence?
14. If your answer to question 13 is yes, should all the applications deriving from the same priority application be subject to the early publication if one application is published early?
15. Should there be a right for the patentee to withdraw the application before publication?
16. If your answer to question 15 is yes, what should be the consequence of such withdrawal:
 - a. with respect to the patentee's own subsequent patent applications; and
 - b. with respect to third party patent applications?
17. If your answer to question 15 is yes, should the patent office be required to provide its initial assessment of the validity of the patent (if granted) before the applicant is required to decide whether to withdraw?
18. In light of your answers to the previous policy questions, what would be appropriate time limits for:
 - a. the patent office to provide the results of its initial assessment?;
 - b. the applicant to decide whether to withdraw the application?; and
 - c. the application to be published?

Germany

19. Should there be any exceptions to automatic publication, and if so what on what grounds, for example:
 - a. on the initiative of the patentee;
 - b. on the initiative of the patent office; or
 - c. on the initiative of third parties (such as other governmental agencies)?
20. If your answer to question 19 is yes, who should decide on whether such exception is applied?
21. Should there be different rules for the publication of continuation, continuation-in-part and divisional applications?
22. What proposals would you make to improve your current system?

III. Proposals for harmonization

Groups are invited to put forward proposals for the adoption of harmonized rules in relation to the publication of patent applications. More specifically, the Groups are invited to answer the following questions:

23. Should patent offices be required to provide examination results or at least search results prior to publication so that applicants can make an informed decision whether to pursue obtaining a patent or to withdraw the application and protect the invention idea as a trade secret?
24. Should there be any exception to publication of applications, for example by the applicant's opt-out?
25. How should exceptional circumstances be defined, e.g., public order, morality or national security where the patent office delays or suppresses publication? To what extent should these exceptional circumstances be specifically defined?
26. What is an appropriate period for publication after filing an application or after the priority date? Is 18 months an appropriate period?
27. Please make any other comments or proposals for harmonization in relation to publication of patent applications that you consider appropriate.

Germany

Procedure

It would be most helpful if the National Groups would fill out the Questionnaire and send in their answers to the General Secretariat of AIPPI (StandingCommittees@aippi.org) by 3 August 2016.

For inquiries, please contact either of the following members of the Standing Committee on Patents.

Tim Iserief

NautaDutilh N.V.
Strawinskylaan 1999
1077XV Amsterdam
The Netherlands
T +31 20 7171 460
F +31 20 7171 335

E: tim.iserief@nautadutilh.com

Andrew Meunier

Meunier Carlin & Curfman LLC
999 Peachtree Street NE, Suite 1300
Atlanta, GA 30309
United States of America
T + 1 404 645 7700
F + 1 404 645 7707

E: dmeunier@mcciplaw.com