



Important Notices of the German Patent and Trade Mark Office 2020

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

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Notice of 1 January 2020

on the version 2020 of the eleventh edition of the international Nice Classification (valid from 1 January 2020) and on the publication of the lists of classes and the alphabetical lists of goods and services in the Bundesanzeiger

On 1 January 2020, version 2020 of the eleventh edition of the "International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification)" (NCL 11-2020) entered into force.

In addition to the new editions of the Nice Classification, which are published every five years, there have been annual versions since 1 January 2013, which may provide for new entries or deletions and modifications of existing entries. They do not contain major structural amendments (changes of classes); these are reserved for the editions, which are issued every five years.

The version of the list of classes and the alphabetical lists of goods and services based on the Nice Classification to be applied from 1 January 2020 in procedures before the German Patent and Trade Mark Office (DPMA) pursuant to Section 19 of the Trade Mark Ordinance (Markenverordnung) has been published in the Bundesanzeiger (Federal Gazette – Bundesanzeiger).

The version of the list of classes and the alphabetical lists of goods and services published in the Bundesanzeiger is also available on our Trade Marks page "Goods and Services".

Notice of 1 January 2020

on the update of the twelfth edition of the Locarno Classification (classification for registered designs)

The German translation of the product terms contained in the twelfth edition of the Locarno Classification is part of the alphabetical list of goods for designs, which is published by the German Patent and Trade Mark Office together with the list of the classes and subclasses in the Federal Gazette (Bundesanzeiger).

The current publication is also available on our webpage "Designs".

The German Patent and Trade Mark Office offers an online search engine (in German) for searching existing product terms.

For the electronic filing of design applications by means of DPMAdirektWeb, the current list of goods for designs is provided when selecting the product indication. The current version of the list of goods is also available for the DPMAdirektPro software, provided the update function of the software is used.

Notice of 24 January 2020

concerning the search report for a patent application according to section 43 of the Patent Act (Patentgesetz)

Upon request, the German Patent and Trade Mark Office (DPMA) identifies the state of the art with respect to a patent application and makes a preliminary assessment of the patentability of the invention applied for. The DPMA informs the applicant of the result of this assessment in a search report pursuant to section 43 of the Patent Act.

Since 24 January 2020, a revised form has been used for this search report. What prompted the redesign of the form was that applicants wanted a compact and clear presentation of the search results while retaining the informative content. Therefore, in particular, the structure of section "D" containing the preliminary assessment of patentability of the invention applied for is now much more user-friendly.

With a view to a speedy examination procedure, the DPMA now requests those applicants who file a request for examination under section 44 of the Patent Act on the basis of the available search results to seize the suggestions contained in the search report and to file (if applicable, together with the request for examination) a substantive comment and/or amended claims or documents.

Notice of 10 March 2020

in view of the spread of the coronavirus Sars-CoV-2 and its impact

In view of the spread of the coronavirus Sars-CoV-2 and its 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 into appropriate 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, has not observed a time limit imposed by law without any fault on his part can subsequently have their procedures 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 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 matter in Section 23 (3), third sentence, of the German Design Act (*Designgesetz*) in conjunction with Section 123 (1) to (5) and (7) of the German Patent Act
- in utility model matters in Section 21 (1) of the German Utility Model Act (*Gebrauchsmustergesetz*) in conjunction with Section 123 of the German Patent Act and
- in semiconductor matters in Section 11 (1) of the German Semiconductor Protection Act (*Halbleiterschutzgesetz*) in conjunction with Section 123 of the German Patent Act.

Notice of 18 March 2020

concerning delays in IP procedures in view of the spread of the coronavirus (COVID-19) and their impact

As a rule, the German Patent and Trade Mark Office is able to continue to provide its services and to perform the patent, utility model, trade mark and design procedures by using the electronic means available to it.

However, many of our staff are affected by the restrictions currently imposed, such as quarantine measures, so that delays will affect all fields of work. In particular, this affects any paper-based mail and fax copies to be received and any paper-based mail to be sent by the German Patent and Trade Mark Office, which our staff will, for the time being, not be able to process without delays because the presence of our staff at the office is reduced.

Please use our e-filing systems DPMAdirektPro and DPMAdirektWeb to file your IP applications and take any further actions related to the procedure – particularly with respect to national and international procedures subject to time limits. By using these e-filing options, you make sure that we receive everything you send.

There may also be delays in issuing certificates – particularly documents, register extracts, apostilles and certificates of origin – and in issuing priority documents. We recommend that you make your request for such certificates and documents as early as possible.

The dates of publication of the IP gazettes may be different from the scheduled dates.

With regard to all pending IP procedures, time limits granted by the German Patent and Trade Mark Office are extended, and no decision will be made because of the expiration of any time limit, until 4th May 2020. Separate notices concerning the extensions of time limits will not be issued. In addition, the time limits to be set by the German Patent and Trade Mark Office will be as generous as the situation requires.

The German Patent and Trade Mark Office is not authorized to extend time limits provided for by law. In this respect, reference is made to the option of re-establishment of rights (see also Notice of the German Patent and Trade Mark Office of 3rd March 2020).

The below policies apply to hearings and oral proceedings:

- Summons to appear in hearings or oral proceedings will no longer be issued, whether the proceedings are unilateral or multilateral.
- Hearings and oral proceedings that have been scheduled will not take place until further notice and are cancelled ex officio. Cancellation ex officio will be notified in writing.

The immediate transfer of international design applications to the International Bureau of the World Intellectual Property Organization cannot be guaranteed either. Therefore, we recommend that you file such applications directly with the WIPO.

Notice of 1 April 2020

concerning European cooperation in the field of trade mark law – harmonisation of the practice regarding the distinctiveness of three- dimensional marks containing other elements

Within the context of what are known as convergence programmes, the trade mark offices of the EU member states and the European Union Intellectual Property Office (EUIPO) have been making considerable efforts since 2012 to achieve effective harmonisation of their decision-making practices. The German Patent and Trade Mark Office (DPMA) has been actively involved in almost all convergence projects, also in the interest of our German users. The purpose of the convergence programmes is to ensure transparency, legal certainty and predictability of the decision-making practice. A further convergence project in the trade mark sector has now been completed; the principles of the common practice developed in this project will take effect on 1 April 2020. The project concerns the distinctiveness of three-dimensional marks (shape marks) containing verbal elements and/or figurative elements when the shape is not distinctive in itself.

Detailed information, explanations and examples are provided in the principles of the common practice. A summary of the main results including examples is available in the Common Communication (https://www.dpma.de/docs/english/hinweis/cp9_en.pdf).

The common practice and the guidelines will be implemented by the DPMA as of 1 April 2020. The result of this project complies with our previous practice so that in practice there will be no change for our customers.

Further information is also available at <https://euipo.europa.eu/ohimportal/en/european-cooperation>.

Notice of 1 April 2020

concerning the Common Communication of the European Intellectual Property Office (EUIPO) and of the national offices on the common practice for assessing disclosure of designs on the Internet

Within the context of the convergence programme of the EUIPO and the national offices, a common practice and common guidelines for assessing disclosure of designs on the Internet have been developed as well as recommendations thereof (hereinafter "common practice"). These were published in a Common Communication on 1 April 2020.

The common practice lists criteria for assessing disclosure of designs on the Internet and provides recommendations on the following aspects:

- possible sources of design disclosure on the Internet;
- types of evidence used for proving disclosure on the Internet;
- different means for establishing the date of disclosure;
- the exceptions to the availability of designs on the Internet.

The common practice is intended to be applicable irrespective of the specific proceedings (e.g. ex officio examination of novelty, invalidity proceedings) or the status of the design (i.e. registered or unregistered). Therefore, it might also serve as guidance for designers or other right holders when disclosing their designs on the Internet or proving such disclosure.

The common practice and guidelines of the Communication will be implemented by the German Patent and Trade Mark Office in design invalidity proceedings as of 1 April 2020.

Contents and results of the project are available in the Common Communication (https://www.dpma.de/docs/english/hinweis/cp10_en.pdf).

Notice of 20 July 2020

Information for IP right owners and applicants having financial difficulties in paying annual, maintenance, extension and renewal fees due to the COVID-19 pandemic

The spread of the coronavirus has led to restrictions on public life throughout Germany, which can pose economic difficulties for IP right owners. If, for this reason, proprietors of patents, utility models, designs and trade marks are not able in individual cases to pay annual, maintenance, extension or renewal fees in time, an IP right may lapse.

Important information:

Annual fees for patents, maintenance fees for utility models and maintenance and extension fees for registered designs

- After the expiry of the time limit for payment not subject to a surcharge for late payment (until the expiry of the second month following the due date), you can pay annual fees for *patents and patent applications*, maintenance fees for *utility models* and maintenance fees for registered *designs* together with a surcharge for late payment of 50 euros per IP right within a *grace period of four months, i.e. until the expiry of the sixth month following the due date at the latest* (section 7 (1) sentences 1 and 2 of the Patent Costs Act).
- The extension fee for registered designs must be paid within 30 months from the date of filing or priority (section 7 (2) of the Patent Costs Act, section 21 (2) of the Design Act).
- Please note that the DPMA cannot extend time limits specified by law (including the statutory time limits for payment). However, the DPMA draws attention to the option of a re-establishment of rights (see Notice of 10 March 2020).
- If, in view of your financial situation due to the COVID-19 pandemic, you are not able to pay your annual, maintenance or extension fees, you can, under certain conditions, submit a request for *legal aid* (sections 129 et seq. of the Patent Act; section 21 (2) of the Utility Model Act in conjunction with sections 129 et seq. of the Patent Act; section 24 sentence 1 and sentence 3 of the Design Act in conjunction with sections 114 to 116 of the Code of Civil Procedure). This also applies if you can pay your fees only in part or by instalments. You must demonstrate, and may be required to *substantiate*, that the requirements for legal aid (especially your personal and financial situation) are fulfilled by using form A9541.

If you submit a request for the grant of legal aid *before the expiry of the time limit for the payment of a fee*, the expiry of such time limit will be suspended (section 134 of the Patent Act; section 21 (2) of the Utility Model Act in conjunction with section 134 of the Patent Act; section 24 sentence 4 of the Design Act in conjunction with section 134 of the Patent Act). If the request for legal aid is rejected, the time limit applies again one month after the receipt of the relevant decision. Information on legal aid is available in the "Information on Legal Aid Before the German Patent and Trade Mark

Office" (*Merkblatt über Verfahrenskostenhilfe vor dem Deutschen Patent- und Markenamt (A 9540)*).

- Information on the reduction of your annual fees by making a binding declaration of your willingness to grant licences concerning your patent or your patent application pursuant to section 23 (1) and (6) of the Patent Act is available in the "Information for Patent Applicants" (p. 13, item 3.).

Renewal fees for trade marks

- After the expiry of the time limit for payment not subject to a surcharge for late payment, you can pay the renewal fee and any class fees for *trade marks* within a *grace period of six months after the expiry of the term of protection* (section 7 (3) sentences 1 and 2 of the Patent Costs Act). The surcharge for late payment is 50 euros for the basic fee and 50 euros for the class fees for the fourth class and each additional class.
- If, in view of your financial situation due to the COVID-19 pandemic, you are not able without any fault on your part to pay renewal fees for trade marks within the grace period, a later payment, together with a *re-establishment of rights*, is possible if the following requirements are fulfilled:
 - When your financial situation permits it, you must pay the renewal fee plus the surcharge for late payment and file a request for re-establishment of rights within two months (section 91 (2) and (3) sentence 1 of the Trade Mark Act)
 - Upon filing the request or in the proceedings concerning the request, you must substantiate that, without any fault on your part, you were not able to observe the grace period (section 91 (3) sentence 2 of the Trade Mark Act). In the case of financial difficulties caused by the pandemic, you must *demonstrate* that you got into financial difficulties due to measures taken in view of the COVID-19 pandemic (e.g. long closing of your business ordered by the authorities, considerably reduced turnover/sales) and that, despite your efforts to receive financial support (e.g. request for state aid), you were not able to pay the renewal fee within the grace period of six months. It is necessary that you disclose your financial situation to the DPMA. For the purposes of *substantiation*, the DPMA can request different documents and affirmations in lieu of an oath.
 - A re-establishment of rights is possible only if your request has been filed and the renewal fee and the surcharge for late payment have been paid *within one year after the expiry of the time limit not observed* (section 91 (5) of the Trade Mark Act).

Further information is available in the "Guideline for the Examination of Trade Mark Applications and the Keeping of the Register" (*Richtlinie für die Prüfung von Markenmeldungen und für die Registerführung*) (pp. 29 to 30, item 4.).

Notice of 15 October 2020

concerning European cooperation in the field of trade mark law - harmonisation of the decision-making practice regarding right- preserving use of a trade mark in a form differing from the one registered

Within the context of what are known as convergence programmes, the trade mark offices of the EU member states and the European Union Intellectual Property Office (EUIPO) have been making considerable efforts since 2012 to achieve effective harmonisation of their decision-making practices. The DPMA has been actively involved in almost all convergence projects, also in the interest of our German users. The purpose of the convergence programmes is to ensure transparency, legal certainty and predictability of the decision-making practice.

A further convergence project in the trade mark sector has now been completed; the principles of the common practice developed in this project will take effect on 15 October 2020.

The project concerns the use of a trade mark in a form differing from the one registered.

Detailed information, explanations and examples are provided in the principles of the common practice. A summary of the main results including examples is available in the Common Communication (https://www.dpma.de/docs/english/hinweis/common_communication_cp8.pdf).

The common practice and the guidelines will be implemented by the German Patent and Trade Mark Office as of 15 October 2020. The result of this project complies with our previous practice so that there will be no practical change for our customers.

Further information is also available at <https://euipo.europa.eu/ohimportal/en/european-cooperation>.