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Office de la propriété intellectuelle du Canada



DOING BUSINESS ABROAD

Protecting your IP in Germany



Canada

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ISED Citizen Services Centre
Innovation, Science and Economic
Development Canada
C.D. Howe Building
235 Queen Street
Ottawa, ON K1A 0H5
Canada

Telephone (toll-free in Canada): 1 800 328 6189
Telephone (international): 613 954 5031
TTY (for hearing impaired): 1 866 694 8389
Business hours: 8:30 a.m. to 5:00 p.m. (Eastern Time)
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PI en Allemagne*.





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DOING BUSINESS ABROAD

Protecting your IP in Germany

Intellectual property (IP) is a valuable asset that can support your business expansion abroad. A Canadian patent, trademark, or industrial design does not secure your rights outside Canada. You should consider obtaining IP protection in the countries where you plan on doing business, including selling products over the Internet and/or manufacturing products overseas.

Canada and Germany enjoy a strong and diverse commercial relationship that covers trade, investment, and science and technology¹. Canadian exports in the European market have significantly increased in the last few years and continue to grow. Germany is a key market for Canada and our economic ties continue to deepen, including through the Canadian-European Union Comprehensive Economic and Trade Agreement. Germany is Canada's largest destination for merchandise exports in the European Union (EU) and fourth overall source for imports after the United States, China, and Mexico². It is therefore important to know how to recognize, register and enforce your IP rights in Germany. For the most part, the protection and registration process for IP in Germany is similar to that in Canada. However, there are certain differences that you should familiarize yourself with by reading this guide.

In Germany, you can apply for patent, utility model, trademark, and design protection. If you wish to enter

the German market or are already doing business in Germany, you should apply to protect your IP rights as soon as practically possible. Depending on your interests and needs, this will involve engaging with the German Patent and Trade Mark Office (DPMA), the European Patent Office (EPO), or the European Union Intellectual Property Office (EUIPO).

Canadian IP professionals are knowledgeable about IP rules and trends in many regions, including Europe, or have partnerships with counterparts abroad if they need to investigate further. More importantly, your Canadian IP professional can coordinate strategies as related applications move through multiple international offices, which can lead to cost savings. If you are interested in protecting your IP rights in Germany or elsewhere, seek advice from your trusted local advisor as early as possible.

¹ Global Affairs Canada, "Canada-Germany relations," (2018), available online.

² Trade Commissioner Service, "Germany: Market Overview," (2019), available online.





Where is IP registered?

The DPMA is the agency responsible for the administration and registration of patents, utility models, trademarks, and designs. It is the largest national IP office in Europe with several offices throughout the country. Its headquarters is located in Munich. The DPMA operates within the Federal Ministry of Justice and Consumer Protection portfolio.

Applications for patents, utility models, trademarks, and designs can be filed electronically at www.dpma.de. The DPMA's website also offers online searchable databases. A good first step is to search existing IP to check whether your anticipated IP use may conflict with or infringe on someone's prior rights.

Trademarks

- In Germany a trademark is a combination of letters, words, symbols and/or designs that distinguish your company's goods and services from those of others in the marketplace. The DPMA also accepts applications for non-traditional trademarks such as holograms and sounds.
- Trademarks can be filed directly through the DPMA if you are only seeking protection in the jurisdiction of Germany. You can also seek protection for a "European Union trademark" by filing for a trademark with the EUIPO. A European Union trademark can provide trademark protection in all EU member states, including Germany.
- European Union trademarks offer protection in all 27 EU member states. The EUIPO follows an "all-or-nothing" principle, which means that if opposable grounds exist in one of the member states, the trademark cannot be registered as a European trademark.

- The European Union, like Canada, is a member of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (the Madrid System). The Madrid System offers businesses the possibility of obtaining trademark protection in a number of countries by filing a single international application in 1 language, and 1 overall payment in 1 currency with the World Intellectual Property Organization (WIPO).



- The EU trademark system and the Madrid System are interlinked. If you already have a trademark registration in Canada, you can in turn designate the EU in an international application with WIPO. This route will be optimal if in addition to Germany and other EU member states, there are other non-EU countries in which you wish to seek trademark protection through a single international application.
- In Germany, it is possible to enforce trademark rights acquired through the use in the marketplace. This means that whoever used the mark first in the German marketplace and acquired recognition as a trademark will own the rights to it even if the mark is not registered, and will be able to enforce those rights under certain circumstances. However, you should still consider registering your trademark with the DPMA or the EUIPO as registered trademarks are easier to enforce and have a number of other important advantages over trademarks that are not registered.
- Both a European Union trademark and a national trademark in Germany are registered for 10 years and can be renewed every 10 years.
- If a trademark is not used within 5 years of registration, it can be cancelled upon request.
- **For more information** on trademarks and the German trademark application process, visit www.dpma.de.



Patents

- The DPMA issues and publishes patents, which are granted for inventions for a period of 20 years. In order to be patentable, an invention must meet the criteria of novelty, inventive step, and industrial applicability.
- In Germany, patent protection can be granted for inventions in any field of technology and is distinguished between products and processes.
- A product patent will protect all types of objects such as machines and their parts, arrangements of individual parts, electronic circuits, chemical substances and pharmaceuticals. Process patents protect, for example, processes for manufacturing products, work processes or also the utilisation of a product for a certain purpose.
- In Germany certain inventions are not patentable, including, scientific theories, mathematical models, methods of doing business, and computer programs.
- Under certain conditions computer-implemented inventions can be patented. However, the invention must solve a specific technical problem and it must include an inventive step.
- Germany's Patent Act also excludes from patentability inventions contrary to morality or "ordre public"; plants and animal varieties (though plant breeders' rights can be granted by Germany's Federal Plant Variety Office); processes for human cloning and modifying the human genetics.
- Germany has a "first to file" system. If 2 or more persons have made the invention independently of each other, the right shall belong to the person who is the first to file the application in respect of the invention with the DPMA.
- Germany is a member of both the Patent Cooperation Treaty (PCT) and the European Patent Convention (EPC), so you can apply for a European patent under the EPC or an international patent under the PCT.

- A European patent has the same effect as having multiple national patents conferred by individual countries that are members of the EPO. A European patent application can be filed centrally with the EPO and the decision on a patent grant is also taken by that office. However, the national offices (such as DPMA) are in charge of patent administration until the expiry of the term of protection. For more information on a European patent process, visit epo.org.
- Under the PCT, you can obtain the effects of national applications in all PCT contracting states by filing a single international application. You can file your international application directly with a national or regional office of a contracting state, such as the DPMA or the Canadian Intellectual Property Office (CIPO). The receiving office will confirm certain formal filing requirements and transmit your application to WIPO. For more information on the PCT process, visit wipo.int.
- These international treaties make it possible to secure patent rights in a large number of countries by filing a single “international” application instead of filing several separate applications. However, note that the granting of a patent in Germany on the national route remains the responsibility of the DPMA, and a patent granted in Germany is only valid in that jurisdiction.
- If an inventor publicly discloses his/her invention, in Germany as in the EU, he or she generally does not have a priority right to apply for a patent on that invention. However, there is a 6-month grace period exception under the EPC and German patent law, which applies to publications resulting from the applicant publishing the invention at an international exhibition. Only very specific international exhibitions may qualify for the grace period in Germany, namely an international exhibition falling within the terms of the Convention Relating to International Exhibitions signed in Paris on November 22, 1928 (c.f. section 3 (5) no. 2 Patent Act).
- Germany also provides the option of filing a utility model application. Utility models are described by the DPMA as “fast IP rights”. Examination and grant of a patent usually take several years. A utility model, on the other hand, can be entered in the Register within a few weeks after receiving the application, provided the documents filed comply with the requirements of Germany’s Utility Model Act.
- The Patent Prosecution Highway (PPH) may be used by Canadian applicants to speed up the examination process for corresponding patent applications filed in Germany. Under CIPO’s PPH pilot program with the DPMA, applicants have the option of making a request to 1 office based on the work product (e.g. a decision to grant, notice of allowance, etc.), including the PCT work products, from the other office.
- In Germany, a utility model is initially provided for a period of 3 years, which can be extended to a maximum of 10 years (unlike a patent, which is granted for a maximum of 20 years). Technical, chemical and biological processes can be patented in Germany, but cannot be protected as utility models.
- **For more information** on patents and the German patent application process, visit www.dpma.de.

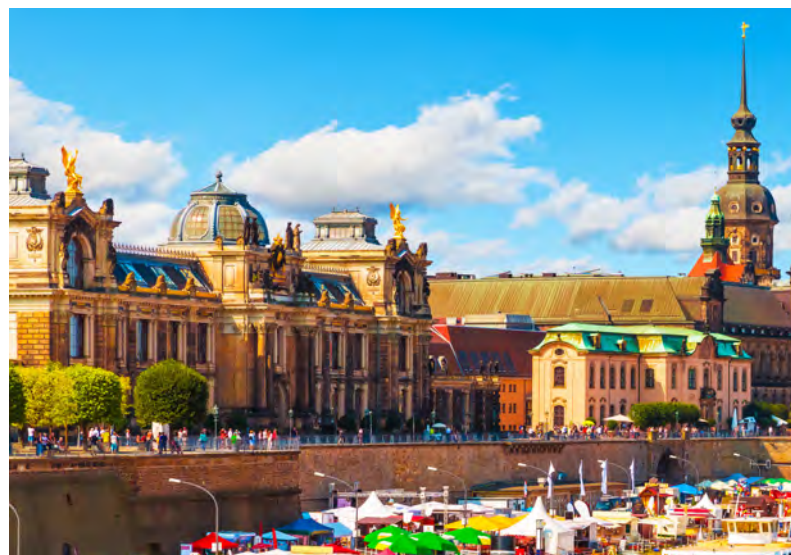
Copyright

- In Germany, as in the EU, copyright protects individual intellectual creations such as literary, dramatic, musical, and artistic works.
- Like in Canada, there is no formal requirement to obtain copyright protection. It arises from the creation of the work.
- According to the German Copyright Act (“Urheberrechtsgesetz”), neither a registration of a work nor any other formality is required as a prerequisite for copyright protection.

- There is no authority in Germany that can issue a copyright registration certificate. However, under the Act on Collective Management Organisations (CMO Act), the DPMA is responsible for the Register of Anonymous and Pseudonymous Works and the Register of Out-of-Commerce Works. The purpose of these registers is to ensure the duration of copyright protection is recorded in a register.
- The term for copyright protection in Germany is the life of the author plus 70 years after the author's death.
- Unlike other EU countries, it is not possible to register a copyright in Germany. The DPMA maintains the Register for Anonymous and Pseudonymous Works and the Register of Out-of-Commerce Works to ensure that the standard protection for copyright is applied even if the rights holder is not directly involved. The DPMA is also involved in the European Orphan Works Database.
- In Germany, collective management organizations manage the rights of the authors of copyrighted works. They grant licenses, monitor the use of the works, collect royalties, and distribute revenue to the rights holders.
- The Arbitration Board under the CMO Act mediates disputes between the collective copyright management organizations and the users of copyrighted works.
- Germany is a party to the Marrakesh Treaty to Facilitate Access to Published Works for Persons Who Are Blind, Visually Impaired, or Otherwise Print Disabled. The Treaty establishes international norms that require countries to provide exceptions in their national laws to facilitate the availability of works in accessible formats, such as Braille and audiobooks, for persons who are blind, visually impaired, or print-disabled.
- **For more information** on copyrights in Germany, visit www.dpma.de.

Designs

- In Germany, designs protect the 2 or 3-dimensional features (including the shape, pattern and colour) of the whole or a part of a product.
- Designs in Germany preserve the designer's rights to the novel and unique character of their product's design.
- Designs can be registered directly with the DPMA if you are only seeking protection in the jurisdiction of Germany.
- Alternatively, if you also require protection outside of Germany, protection can be obtained by applying for a Europe-wide Community design through the EUIPO. A Community design through the EUIPO will provide protection in all EU member states, including Germany.
- You can also apply for design protection in Germany by applying for an international registration under the Hague Agreement Concerning the International Registration of Industrial Designs (the Hague System).
- If you already have an industrial design registration in Canada, you can designate the EU in an international application under the Hague System.
- Designs registered in Germany are granted protection for an initial 5 years from the date of filing of the application.
- You can also choose to defer the publication of the design representation, if you wish to keep the design secret for a period of time. In the case of deferment of publication, the initial period of protection lasts for



30 months from the date of filing of the application or the date of priority if priority is effectively claimed.

- Please note that during the initial registration, the DPMA does not assess the novelty or individual character of the design. These requirements for protection are only examined where there is an invalidity proceeding before the Design Division at the DPMA or a dispute in civil court. Thus, it is important to search the design register before applying to register your design.
- In Germany, design registration can be renewed up to 4 times for a maximum term of protection of 25 years.
- Germany uses a “first to file” system for the protection of designs, meaning that the first person to file an application will have priority against later applications.
- Applicants can claim priority for a design if the design was previously filed within 6 months in another country that is a member of the Paris Convention or the World Trade Organization. Where a design is filed in Germany by virtue of a right of priority based on the filing of a patent, the period of priority is 12 months.
- **For more information** on designs and for the German design application process, visit www.dpma.de.

Geographical Indications

- A geographical indication (GI) is an IP right that informs consumers of the geographical source of a product and also has a quality, reputation, or other characteristics that are essentially attributable to that place of production.
- The EU provides GI protection for wines, spirits,

agricultural products and foods (e.g. meats, fruits, breads, cheeses, and pastries).

- GIs are protected on an EU-wide basis, and cannot be registered in a single EU member state.
- In order to apply for GI protection for a Canadian GI in the EU, you must first protect your product in Canada. CIPO administers GI protection in Canada. To learn more on how to protect your GI in Canada visit, cipo.gc.ca.
- For a GI to be protectable in the EU, at least 1 of the production steps must take place in the geographical area of origin and the quality, the reputation or another characteristic of the product must be attributable to its geographical origin.
- Once a product is protected in Canada, you can send an application for protection in the EU directly to the European Commission. Obtaining protection with the European Commission will provide protection in all EU member states, including Germany.
- There are many benefits to securing GI protection. In the EU, GIs protect your products against misuse or imitation of the protected name and guarantee the true origin of the product to customers. Additionally, GIs have the ability to create consumer confidence regarding both the geographical origin of a product, and, more significantly, the quality of a product. To this end, GIs function as a valuable tool to differentiate competing goods on the market.
- **For more information** on the filing requirements for GI applications relating to agri-foods, wines, and spirits, visit ec.europa.eu/info/food-farming-fisheries/food-safety-and-quality/certification/quality-labels/registration-name-quality-product_en.
- **For more information** on GI protection in Europe, visit europa.eu/youreurope/business/running-business/intellectual-property/geographical-indications/index_en.htm.







IP enforcement

There are several ways to enforce your rights
against unauthorized use of your IP in Germany:

- Enforcement is administered on a country-by-country basis. Therefore, you must monitor the German marketplace for any unauthorized use of your IP. Enforcement of your IP rights is your responsibility.
- Germany's Central Customs Authority provides anti-counterfeiting services to businesses, that may help you to enforce your IP rights in Germany.
- If you believe your IP rights are being infringed upon in Germany, you should consult your trusted local IP professional to discuss next steps. Your Canadian IP professional can coordinate work with an IP professional based in Germany, where required. Additionally, Canada's Trade Commissioner Service can also help you by providing a list of lawyers practising in Germany.
- It is important to understand that the Government of Canada generally cannot enforce IP rights owned by private individuals in Germany. It is the responsibility of the rights holders to register, protect and enforce their rights and, where relevant, retain counsel and advisors.
- In Germany, patents are enforced in regional courts rather than patent offices or other government agencies. There are 12 regional courts that have jurisdiction to hear patent infringement cases in the first instance.
- Germany's regional and higher regional courts have exclusive jurisdiction over patent litigation matters, whereas Germany's Federal Patent Court has exclusive jurisdiction over first instance invalidity proceedings. The German Federal High Court of Justice has exclusive jurisdiction over appeals related to patents.
- In infringement proceedings, each party must be represented by a lawyer licensed to practice in Germany. Patent agents do not have a right of audience in infringement proceedings and therefore cannot represent a client before an infringement court without a lawyer.
- If you suspect infringement, your lawyer can send a "cease and desist" letter to the alleged infringer informing them that you believe they have infringed on your IP rights and advising them to refrain from committing the infringement.
- If you choose to enforce your rights through formal court proceedings, be aware of the costs and time associated with this adversarial route. Germany's courts can award varying remedies in IP disputes, including monetary damages, imprisonment, fines, a temporary or permanent injunction, and search and seizure orders. If you pursue a legal battle and win, there is always a chance that you will receive less money than you could receive through settlement proceedings.



Tips: Important notes

- IP rights are important, so take the time to determine what IP can be registered and what rights can be enforced.
- Remember that the protection of IP rights (such as patents, trademarks, and industrial designs) registered in Canada does not extend to Germany.
- Align your IP strategy with your business strategy. Identify business goals, protectable IP, regional requirements, potential partners, and the capacity to expand into your target markets.
- Routinely monitor the marketplace for unauthorized use of your IP.
- Before proceeding with any of the enforcement methods outlined above, consider contacting a qualified legal representative to discuss options, including a “cease and desist” letter.

For more help

- For information about IP protection in Germany, check out the DPMA website at www.dpma.de.
- For doing business in Germany, visit the Canadian Trade Commissioner website at <https://www.tradecommissioner.gc.ca/germany-allemagne>.
- For IP tools, resources and information for businesses, visit Canada.ca/ip-for-business.
- For more information on going global with your IP, visit Canada.ca/export-ip or consult your local IP professional.
- Find more programs and support for Canadian businesses and innovators at innovation.canada.ca.

*The information provided above is meant as an educational resource only and should not be construed as legal advice.

Canada.ca/export-IP

