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the Act of 17 July 2017 (Federal Law Gazette I p. 2541).

Act on the Protection of Trade Marks and other Signs

Trade Mark Act

Act on the Protection of Trade Marks and other Signs of 25 October 1994 (Federal Law
Gazette [BGBl.] Part I p. 3082, as last amended by Art. 11 of the Act of 17 July 2017,
Federal Law Gazette (Bundesgesetzblatt) Part I p. 2541

Sections 119 to 125 entered into force with effect from 20 March 1996 in accordance with
the announcement of 24 April 1996, Federal Law Gazette Part I p. 682.

The Act was adopted by the Bundestag with the approval of the Bundesrat as Article 1 of the
Act (423-5-1) of 25 October 1994, Federal Law Gazette Part I p. 3082. It entered into force
with effect from 1 January 1995 in accordance with Art. 50 paragraph 3 of this Act pursuant
to paragraphs 1 and 2.

Part 1

Scope

Section 1

Protected trade marks and other signs

The following shall be protected in accordance with this Act:

1. trade marks,
2. commercial designations,
3. indications of geographical origin.

Section 2

Application of other provisions

The protection of trade marks, commercial designations and indications of geographical
origin in accordance with this Act shall not exclude the application of other provisions on the
protection of such signs.

Part 2

Preconditions, scope and restrictions of the protection of trade marks and commercial designations, transfer and licence

Chapter 1
Trade marks and commercial designations, precedence and seniority

Section 3
Signs eligible for protection as trade marks

(1) All signs, particularly words including personal names, designs, letters, numerals, sound marks, three-dimensional designs, the shape of goods or of their packaging as well as other wrapping, including colours and colour combinations, may be protected as trade marks if they are capable of distinguishing the goods or services of one enterprise from those of other enterprises.

(2) Signs consisting exclusively of a shape

1. which results from the nature of the goods themselves;
2. which is necessary to obtain a technical result; or
3. which gives substantial value to the goods

shall not be capable of being protected as trade marks.

Section 4
Accrual of trade mark protection

The following shall give rise to trade mark protection:

1. the entry of a sign as a trade mark in the Register kept by the German Patent and Trade Mark Office;
2. the use of a sign in trade in so far as the sign has acquired public recognition as a trade mark within the affected trade circles; or
3. a trade mark constituting a well-known mark within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property (Paris Convention).

Section 5
Commercial designations

(1) Company signs and titles of works shall enjoy protection as commercial designations.

(2) Company signs are signs used in trade as a name, company name or special designation of a business operation or an enterprise. Business signs and other signs intended to distinguish the business operation from other business operations which are regarded as signs of the business operation within affected trade circles shall be deemed equivalent to the special designation of a business operation.

(3) Titles of works are the names or special designations of printed publications, cinematic works, music works, stage works or other comparable works.

Section 6
Precedence and seniority

(1) If, in the case of a concurrence of rights within the meaning of sections 4, 5 and 13, their seniority is relevant in accordance with this Act for the purposes of establishing which rights take precedence, seniority shall be determined in accordance with subsections (2) and (3).

(2) The date of filing (section 33 (1)) or, if priority is claimed in accordance with section 34 or in accordance with section 35, the priority date shall be relevant for the purposes of establishing the seniority of trade marks that have been filed or registered.

(3) The point in time when the right was acquired shall be relevant for the purposes of establishing the seniority of rights within the meaning of section 4 no. 2 and 3 and sections 5 and 13.

(4) If rights in accordance with subsections (2) and (3) have the same date as their seniority, the rights shall have equal ranking, and shall not give rise to any rights against one another.

Chapter 2
Prerequisites for the protection of trade marks by means of registration

Section 7
Proprietorship

Proprietors of trade marks that have been filed or registered may be the following:

1. natural persons,
2. legal persons, or
3. partnerships in so far as they are equipped with the capacity to acquire rights and enter into liabilities.

Section 8
Absolute grounds for refusal

(1) Signs eligible for protection as a trade mark within the meaning of section 3 which cannot be depicted graphically shall be excluded from registration.

(2) The following trade marks shall not be registered

1. which are devoid of any distinctive character for the goods or services;
2. which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the services, or other characteristics of the goods or services;
3. which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services;
4. which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services;
5. which are contrary to public policy or to accepted principles of morality;
6. which contain state coats of arms, state flags or other state symbols or coats of arms of a domestic locality or of a domestic municipal or other local authority association;
7. which contain official signs or hallmarks indicating control or warranty;
8. which contain coats of arms, flags or other signs, seals or designations of international intergovernmental organisations;
9. the use of which can evidently be prohibited in the public interest in accordance with other provisions, or
10. which have been applied for in bad faith.

(3) Subsection (2) no. 1, 2 and 3 shall not apply if, prior to the point in time of the decision on registration, the trade mark has become established in the affected trade circles as a result of its use for the goods or services for which the application was filed.

(4) Subsection (2) no. 6, 7 and 8 shall also apply if the trade mark contains the imitation of a sign listed there. Subsection (2) no. 6, 7 and 8 shall not apply if the applicant is authorised to include in the trade mark one of the signs listed there, even if it can be confused with one of the other signs listed there. Subsection (2) no. 7 shall furthermore not apply if the goods or services for which the trade mark application was filed are neither identical with nor similar to those for which the official sign or hallmark indicating control or warranty has been introduced. Subsection (2) no. 8 shall further not apply if the trade mark applied for is not

suitable to create among the public the incorrect impression of a connection with the international intergovernmental organisation.

Section 9

Trade marks that have been filed or registered as relative grounds for refusal

(1) The registration of a trade mark may be cancelled

1. if it is identical to a trade mark applied for or registered which has older seniority and the goods or services for which it was registered are identical with the goods or services for which the trade mark with older seniority was filed or registered;
2. if the likelihood of confusion exists, including the likelihood of association between the trade marks, for the public because of its identity with or similarity to a trade mark applied for or registered with older seniority and owing to the identity or similarity of the goods or services covered by both trade marks; or
3. if it is identical with or similar to a trade mark applied for or registered with older seniority and has been registered for goods or services which are not similar to those for which the trade mark with older seniority has been filed or registered, if the trade mark with older seniority is a trade mark which has a reputation in Germany and the use of the registered trade mark would without due cause take unfair advantage of, or be detrimental to, the distinctive character or the repute of the trade mark which has a reputation.

(2) Applications for trade marks shall only constitute a ground for refusal within the meaning of subsection (1) if they are registered.

Section 10

Well-known marks

(1) A trade mark shall be excluded from registration if it is identical with or similar to a trade mark with older seniority that is well known in Germany within the meaning of Article 6bis of the Paris Convention and if the further prerequisites of section 9 (1) no. 1, 2 or 3 are met.

(2) Subsection (1) shall not apply if the applicant has been authorised to file an application by the proprietor of the well-known mark.

Section 11

Trade mark registered for an agent

The registration of a trade mark may be cancelled if the trade mark was registered without the consent of the trade mark proprietor for his agent or representative.

Section 12

Trade marks and commercial designations with older seniority acquired by virtue of use

The registration of a trade mark may be cancelled if another person has acquired rights to a trade mark prior to the date that is relevant for the seniority of the registered trade mark within the meaning of section 4 no. 2 or to a commercial designation within the meaning of section 5 and these entitle him to prohibit the use of the registered trade mark in the entire territory of the Federal Republic of Germany.

Section 13

Other earlier rights

(1) The registration of a trade mark may be cancelled if another person has acquired another right not listed in sections 9 to 12 prior to the date relevant for the seniority of the registered trade mark, and this entitles him to prohibit the use of the registered trade mark in the entire territory of the Federal Republic of Germany.

(2) The other rights within the meaning of subsection (1) shall include in particular:

1. rights to names,

2. the right of personal portrayal,
3. copyright,
4. names of plant varieties,
5. indications of geographical origin,
6. other industrial property rights.

Chapter 3
Scope of protection, infringements of rights

Section 14

Exclusive right of the proprietor of a trade mark, right to an injunction, compensation claim

- (1) The acquisition of trade mark protection in accordance with section 4 shall grant to the proprietor of the trade mark an exclusive right.
- (2) A third party shall be prohibited in trade, without the consent of the proprietor of the trade mark, from
1. using a sign which is identical to the trade mark for goods or services which are identical to those for which it enjoys protection;
 2. using a sign if the likelihood of confusion exists for the public because of the identity or similarity of the sign to the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, including the likelihood of association with the trade mark; or
 3. using a sign identical with or similar to the trade mark for goods or services which are not similar to those for which the trade mark enjoys protection if the trade mark is a trade mark which has a reputation in Germany and the use of the sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark which has a reputation.
- (3) If the prerequisites of subsection (2) are met, it shall in particular be prohibited
1. to affix the sign to goods or their wrappings or packaging;
 2. to offer goods under the sign, to put them on the market, or to stock them for the above purposes;
 3. to offer or provide services under the sign;
 4. to import or export goods under the sign;
 5. to use the sign in business papers or in advertising.
- (4) Third parties shall be furthermore prohibited in trade without the authorisation of the proprietor of the trade mark
1. to affix a sign that is identical to the trade mark or a similar sign on wrappings or packaging or on means of identification such as labels, tags, badges or the like,
 2. to offer, put on the market or stock for the listed purposes wrappings, packaging or means of identification which bear a sign that is identical to the trade mark or to a similar sign, or
 3. to import or export wrappings, packaging or means of identification which bear a sign that is identical to the trade mark or to a similar sign

if there is a risk that the wrappings or packaging are used to wrap or package, or that the means of identification are used to identify goods or services with regard to which third parties would be prohibited from using the sign in accordance with subsections (2) and (3). (5) Any person who uses a sign contrary to subsections (2) to (4) may, in the event of the risk of recurrent infringement, be sued by the proprietor of the trade mark for cessation and desistance. This right may also be asserted in the event of the risk of a first-time infringement.

(6) Any person who performs the act of infringement intentionally or negligently shall be obliged to compensate the proprietor of the trade mark for the damage incurred by the act of infringement. When assessing the compensation, consideration may also be given to the profit which the infringer has obtained by infringing the right. The claim for compensation may also be calculated on the basis of the amount which the infringer would have been required to pay as equitable remuneration if he had obtained permission to use the trade mark.

(7) If the act of infringement is performed in a business operation by an employee or agent, the right to an injunction and, in so far as the employee or agent acted intentionally or negligently, the claim for compensation may also be asserted against the proprietor of the operation.

Section 15

Exclusive right of the proprietor of a commercial designation, right to an injunction, compensation claim

(1) The acquisition of the protection of a commercial designation shall grant to its proprietor an exclusive right.

(2) Third parties shall be prohibited from using the commercial designation or a similar sign in trade, without authorisation, in a manner liable to cause confusion with the protected designation.

(3) If the commercial designation is a commercial designation which has a reputation in Germany, third parties shall be furthermore prohibited from using the commercial designation or a similar sign in trade if there is no likelihood of confusion within the meaning of subsection (2), in so far as the use of the sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the commercial designation.

(4) Any person who uses a commercial designation or a similar sign contrary to subsection (2) or subsection (3) may, in the event of the risk of recurrent infringement, be sued by the proprietor of the commercial designation for cessation and desistance. This right may also be asserted in the event of the risk of an infringement.

(5) Any person intentionally or negligently committing the act of infringement shall be liable to the proprietor of the commercial designation for compensation for the damage incurred thereby. Section 14 (6), second and third sentences, shall apply mutatis mutandis.

(6) Section 14 (7) shall apply mutatis mutandis.

Section 16

Representation of a registered trade mark in reference works

(1) If the representation of a registered trade mark in a dictionary, encyclopaedia or similar reference work gives the impression that the trade mark constitutes the generic name of the goods or services for which the trade mark is registered, the proprietor of the trade mark may require from the publisher of the work that the representation of the trade mark be accompanied by an indication that it is a registered trade mark.

(2) If the work has already been published, the right shall be restricted to the indication in accordance with subsection (1) being included in a new edition of the work.

(3) Subsections (1) and (2) shall apply mutatis mutandis if the reference work is sold in the form of an electronic database or if access is provided to an electronic database containing a reference work.

Section 17

Rights against agents or representatives

(1) If a trade mark has been filed or registered contrary to section 11 for the agent or representative of the proprietor of the trade mark without his consent, the proprietor of the trade mark shall be entitled to demand from the agent or representative the transfer of the right given rise to by the application for or registration of the trade mark.

(2) If a trade mark has been registered contrary to section 11 for an agent or representative of the proprietor of the trade mark, the proprietor may prohibit the use of the trade mark within the meaning of section 14 by the agent or representative if he has not consented to its use. If the agent or representative acts intentionally or negligently, he shall be obliged to compensate the proprietor of the trade mark for the damage incurred by the act of infringement. Section 14 (7) shall apply mutatis mutandis.

Section 18

Destruction and recall rights

(1) The proprietor of a trade mark or of a commercial designation may sue the infringer in cases falling under sections 14, 15 and 17 for destruction of the goods held or owned by the infringer that are unlawfully identified. The first sentence shall apply mutatis mutandis to materials and implements which are owned by the infringer which were predominantly used for unlawfully identifying the goods.

(2) The proprietor of a trade mark or of a commercial designation may sue the infringer in cases falling under sections 14, 15 and 17 for the recall of unlawfully identified goods or their final removal from the channels of commerce.

(3) The claims under subsections (1) and (2) shall be ruled out if such a claim is disproportionate in an individual case. When examining proportionality, consideration shall be given to the legitimate interests of third parties.

Section 19

Right to information

(1) The proprietor of a trade mark or of a commercial designation may sue the infringer in cases falling under sections 14, 15 and 17 for provision of information regarding the origin and the channels of commerce of unlawfully identified goods or services.

(2) In cases of an obvious legal infringement or in cases where the proprietor of a trade mark or of a commercial designation has brought an action against the infringer, the claim may also be asserted, without prejudice to subsection (1), against a person who, on a commercial scale,

1. had possession of infringing goods,
2. made use of infringing services,
3. provided services used for infringing activities, or
4. according to the information provided by a person referred to in no. 1, 2 or no. 3 participated in manufacturing, creating or distributing such products or participated in the provision of such services,

unless that person would be entitled under sections 383 to 385 of the Code of Civil Procedure (Zivilprozessordnung) to refuse to give testimony in proceedings against the infringer. In the event of assertion of the claim in judicial proceedings under the first sentence, the court may, upon motion, suspend the proceedings pending against the infringer until the proceedings on the claim concerning the provision of information have been concluded. The person obliged to provide the information may demand from the aggrieved party reimbursement of the expenditure for the provision of the information.

(3) The person obliged to provide the information shall give particulars of

1. the name and address of the manufacturers, suppliers and other previous holders of the goods or services as well as of the intended wholesalers and retailers, and
 2. the quantity of the goods manufactured, delivered, received or ordered as well as the prices paid for the goods or services concerned.
- (4) The claims under subsections (1) and (2) shall be ruled out if such a claim is disproportionate in an individual case.
- (5) If the person obliged to provide the information, while acting intentionally or grossly negligently, provides false or incomplete information, he shall be obliged to compensate the proprietor of a trade mark or of a commercial designation for the damage caused.
- (6) Any person who provides true information without having been obliged to do so in accordance with subsection (1) or subsection (2) shall be liable to third parties only if he knew that he was not obliged to provide the information.
- (7) In cases of an obvious legal infringement, the obligation to provide the information may be imposed by means of an injunction in accordance with sections 935 to 945 of the Code of Civil Procedure.
- (8) In criminal proceedings or in proceedings under the Act on Regulatory Offences (Gesetz über Ordnungswidrigkeiten), the findings may be used against one of the persons obliged on account of an act committed prior to the provision of the information or against a relative referred to in section 52 (1) of the Code of Criminal Procedure (Strafprozessordnung) only with the consent of the person obliged.
- (9) Where the information can be provided only by using traffic data (section 3 no. 30 of the Telecommunications Act [Telekommunikationsgesetz]), a court order regarding the admissibility of the use of the traffic data shall first have to be obtained upon motion by the aggrieved party. For issuance of this order, that regional court (Landgericht) in whose district the person obliged to provide the information has his residence, principal place of business or an establishment shall have exclusive jurisdiction, irrespective of the value in dispute. The civil division shall decide. The provisions of the Act on Proceedings in Family Matters and in Matters of Non-Contentious Jurisdiction (Gesetz über das Verfahren in Familiensachen und in den Angelegenheiten der freiwilligen Gerichtsbarkeit) shall apply to the proceedings mutatis mutandis. The costs of the court order shall be borne by the aggrieved party. An appeal from the decision of the regional court shall be an available remedy. The notice of appeal shall be lodged within a time limit of two weeks. The provisions concerning the protection of personal data shall otherwise remain unaffected.
- (10) The basic right to privacy of telecommunications shall be restricted (Article 10 of the Basic Law [Grundgesetz]) by subsection (2) in conjunction with subsection (9).

Section 19a

Claims for production and inspection

- (1) If there is sufficient likelihood of a legal infringement in accordance with sections 14, 15 and 17, the alleged infringer may be sued by the proprietor of a trade mark or of a commercial designation for production of a document or inspection of an item which lies in his control if this is necessary for the purpose of establishing the claims of the proprietor of a trade mark or of a commercial designation. Where there is sufficient likelihood of a legal infringement being committed on a commercial scale, the claim shall extend to the production of bank, financial or commercial documents. If the alleged infringer asserts that the information concerned is confidential, the court shall take the measures necessary to ensure the specific protection required in an individual case.
- (2) The claim in accordance with subsection (1) shall be ruled out if such a claim is disproportionate in an individual case.
- (3) The obligation to produce a document or to acquiesce to the inspection of an item may be imposed by means of an injunction in accordance with sections 935 to 945 of the Code of Civil Procedure. The court shall take the measures necessary to ensure the protection of

confidential information. This shall in particular apply to those cases where the injunction is issued without giving a prior hearing to the opposing party.

(4) Section 811 of the German Civil Code (Bürgerliches Gesetzbuch) and section 19 (8) shall apply mutatis mutandis.

(5) If there was no infringement or no risk of infringement, the alleged infringer may claim compensation for the damage caused to him by the production or inspection sought in accordance with subsection (1) from the person who sought the production or inspection.

Section 19b

Securing compensation claims

(1) In the event of a legal infringement being committed on a commercial scale in the cases referred to in section 14 (6), section 15 (5) as well as section 17 (2), second sentence, the infringer may be sued by the proprietor of a trade mark or of a commercial designation for production of bank, financial or commercial documents or provision of appropriate access to the relevant documents as are in the infringer's control and are necessary for enforcing the claim for compensation if there is doubt as to whether the claim for compensation will be satisfied in the absence of such production. Where the infringer asserts that the information is confidential, the court shall take the measures necessary to ensure the specific protection required in an individual case.

(2) The claim in accordance with subsection (1) shall be ruled out if such a claim is disproportionate in an individual case.

(3) The obligation to produce the documents referred to in subsection (1) may be imposed by means of an injunction in accordance with sections 935 to 945 of the Code of Civil Procedure in cases where there evidently is a claim to compensation. The court shall take the measures necessary to ensure the protection of confidential information. This shall in particular apply to those cases where the injunction is issued without giving a prior hearing to the opposing party.

(4) Section 811 of the German Civil Code and section 19 (8) shall apply mutatis mutandis.

Section 19c

Publication of judgments

Where an action has been brought under this Act, the successful party may be entitled in the judgment to make the judgment public at the expense of the unsuccessful party if the successful party demonstrates a legitimate interest. The nature and extent of the publication shall be laid down in the judgment. The entitlement shall lapse if it is not used within three months of the judgment becoming final. The pronouncement in accordance with the first sentence shall not be provisionally enforceable.

Section 19d

Claims under other statutory provisions

Claims under other statutory provisions shall remain unaffected.

Chapter 4

Restrictions of protection

Section 20

Limitation

The provisions of Book 1, Division 5 of the German Civil Code shall apply mutatis mutandis to limitation in respect of claims referred to in sections 14 to 19c. Where the person obliged has obtained something as a consequence of the infringement at the expense of the entitled person, section 852 of the German Civil Code shall apply mutatis mutandis.

Section 21

Forfeiting of rights

(1) The proprietor of a trade mark or of a commercial designation shall not be entitled to prohibit the use of a later registered trade mark for the goods or services for which it has

been registered in so far as he has acquiesced, for a period of five successive years, to the use of the trade mark while being aware of such use, unless the registration for the later trade mark was applied for in bad faith.

(2) The proprietor of a trade mark or of a commercial designation shall not be entitled to prohibit the use of a trade mark within the meaning of section 4 no. 2 or 3, of a commercial designation or of any other later right within the meaning of section 13 in so far as he has acquiesced, for a period of five successive years, to the use of this right while being aware of such use unless the proprietor of this right acted in bad faith at the time of acquisition of the right.

(3) In cases falling under subsections (1) and (2), the proprietor of the later right may not prohibit the use of the earlier right.

(4) Subsections (1) to (3) shall not affect the application of general principles regarding the forfeiting of rights.

Section 22

Exclusion of rights if the registration of a later trade mark is definitive

(1) The proprietor of a trade mark or of a commercial designation shall not be entitled to prohibit the use of a later registered trade mark for the goods or services for which it has been registered if a request for cancellation of the registration of the later trade mark has been refused or would have to be refused

1. because the earlier trade mark or commercial designation did not yet have a reputation within the meaning of section 9 (1) no. 3, of section 14 (2) no. 3 or of section 15 (3) on the date relevant for the seniority of the registration of the later trade mark (section 51 (3)),

2. because the registration of the earlier trade mark could have been cancelled because of revocation or because of absolute grounds for refusal on the date of the publication of the registration of the later trade mark (section 51 (4)).

(2) In cases falling under subsection (1), the proprietor of the later registered trade mark may not prohibit the use of the earlier trade mark or commercial designation.

Section 23

Use of names and descriptive indications, spare parts business

The proprietor of a trade mark or of a commercial designation shall not be entitled to prohibit a third party in trade

1. to use the third party's name or address,

2. to use a sign identical to the trade mark or commercial designation or a similar sign as an indication of characteristics or properties of goods or services, in particular their nature, quality, intended purpose, value, geographical origin or time of production or of rendering, or

3. to use the trade mark or the commercial designation as an indication of the intended purpose of a good, in particular as an accessory or spare part, or of a service in so far as the use is necessary therefor

if use does not contravene accepted principles of morality.

Section 24

Exhaustion

(1) The proprietor of a trade mark or of a commercial designation shall not be entitled to prohibit a third party from using the trade mark or the commercial designation for goods which have been put on the market under this trade mark or this commercial designation by him or with his consent in Germany, in one of the other Member States of the European Union or in another Contracting Party to the Agreement on the European Economic Area.

(2) Subsection (1) shall not apply if the proprietor of the trade mark or of the commercial designation opposes the use of the trade mark or of the commercial designation in connection with the further commercialisation of the goods for legitimate reasons, in particular if the condition of the goods has been changed or impaired after being put on the market.

Section 25

Exclusion of rights for lack of use

(1) The proprietor of a registered trade mark may not assert rights vis-à-vis third parties within the meaning of sections 14 and 18 to 19c if the trade mark has not been used in accordance with section 26 within the last five years prior to the assertion of the right for the goods or services which he invokes to establish his right, in so far as the trade mark has been registered for at least five years at this time.

(2) If rights within the meaning of sections 14 and 18 to 19c are asserted for an infringement of a registered trade mark by means of an action, the claimant must demonstrate in response to an objection by the defendant that the trade mark has been used in accordance with section 26 within the last five years prior to the lodging of the action for the goods or services he invokes in order to establish his right, in so far as the trade mark has been registered for at least five years at this time. If the five-year period of non-use ends subsequent to the lodging of the action, the claimant shall demonstrate in response to an objection of the defendant that the trade mark has been used in accordance with section 26 within the last five years prior to the conclusion of the oral hearing. The decision shall only take into consideration the goods or services for which use has been documented.

Section 26

Use of the trade mark

(1) Where the assertion of rights from a registered trade mark or the upholding of the registration depends on the trade mark having been used, it must have been seriously used in Germany by its proprietor for the goods or services in respect of which it is registered unless there are legitimate grounds for non-use.

(2) The use of the trade mark with the consent of the proprietor shall be deemed as use by the proprietor.

(3) The use of the trade mark in a form differing from the registration shall also constitute use of a registered trade mark in so far as the differing elements do not change the distinctive character of the trade mark. The first sentence shall also apply if the trade mark is also registered in the form in which it has been used.

(4) Use in Germany shall be deemed to also include the affixing of the trade mark on goods or their wrapping or packaging in Germany if the goods are exclusively intended for export.

(5) In so far as use within five years from the point in time of the registration is necessary, in cases in which an opposition has been lodged against the registration, the time of the registration shall be substituted by the point in time of the conclusion of the opposition proceedings.

Chapter 5

Trade marks as objects of property

Section 27

Transfer

(1) The right established by the registration of a trade mark, the use of a trade mark or the fact of being a well-known mark may be transferred or pass to others for all or for a part of the goods or services for which the trade mark enjoys protection.

(2) Where the trade mark is part of a business operation or of a component of a business operation, the right arising from the registration of the trade mark, the use of a trade mark or the fact of being a well-known mark shall in cases of doubt be covered by the assignment or

the transfer of the business operation or of the component of the business operation to which the trade mark belongs.

(3) The transfer of the right arising from the registration of a trade mark shall, upon the request of one of the parties, be recorded in the Register if proof thereof is furnished to the German Patent and Trade Mark Office.

(4) If the transfer only concerns one part of the goods or services for which the trade mark is registered, the provisions on the division of the registration shall apply *mutatis mutandis*, with the exception of section 46 subsections (2) and (3), first sentence.

Section 28

Presumption of proprietorship of the right, service on the proprietor

(1) It shall be presumed that the party recorded in the Register as the proprietor is entitled to the right arising from the registration of a trade mark.

(2) If the right arising from the registration of a trade mark has been transferred or has passed to another, the successor, in proceedings before the German Patent and Trade Mark Office, in appeal proceedings before the Federal Patent Court or in appeal on points of law proceedings before the Federal Court of Justice, may only assert the right to protection of this trade mark and the right arising from the registration from the time when the German Patent and Trade Mark Office has received the request for the registration of the transfer. The first sentence shall apply *mutatis mutandis* to other proceedings before the German Patent and Trade Mark Office, to appeal proceedings before the Federal Patent Court or to appeal on points of law proceedings before the Federal Court of Justice in which the proprietor of a trade mark is involved. If the successor takes on proceedings in accordance with the first or second sentence, the consent of the other parties to the proceedings shall not be required.

(3) Orders and decisions of the German Patent and Trade Mark Office which are required to be served on the proprietor of the trade mark shall be served on the person registered as the proprietor. If the German Patent and Trade Mark Office has received a request for the registration of a transfer, the orders and decisions referred to in the first sentence shall also be served on the successor.

Section 29

Rights in rem, levy of execution, insolvency proceedings

(1) The right arising from the registration of a trade mark, the use of a trade mark or the fact of being a well-known mark may be

1. pledged or form the object of another right in rem, or
2. the object of measures of levy of execution.

(2) Where the rights referred to in subsection (1) no. 1 or the measures referred to in subsection (1) no. 2 concern the right arising from the registration of a trade mark, they shall be recorded in the Register upon the request of one of the parties if proof thereof is furnished to the German Patent and Trade Mark Office.

(3) Where the right arising from the registration of a trade mark is involved in insolvency proceedings, this shall be recorded in the Register upon application of the insolvency administrator or request of the insolvency court. In the case of personal management (section 270 of the Insolvency Statute [Insolvenzordnung]), the insolvency custodian shall take the place of the insolvency administrator.

Section 30

Licences

(1) The right arising from the registration of a trade mark, the use of a trade mark or the fact of being a well-known mark may for all or for a part of the goods or services for which the trade mark enjoys protection form the subject-matter of exclusive or non-exclusive licences for the territory of the Federal Republic of Germany as a whole or part of this territory.

(2) The proprietor of a trade mark may assert the rights from the trade mark against a licensee who acts contrary to a provision of the licence agreement with regard to

1. the term of the licence,
2. the manner in which the trade mark may be used, as covered by the registration,
3. the nature of the goods or services for which the licence was issued,
4. the territory in which the trade mark may be affixed, or
5. the quality of the goods manufactured by them or of the services provided by them.

(3) The licensee may lodge an infringement action of a trade mark only with the consent of its proprietor.

(4) A licensee may, for the purpose of claiming compensation for damage suffered by him, intervene in an infringement action brought by the proprietor of the trade mark.

(5) A transfer of rights in accordance with section 27 or the grant of a licence in accordance with subsection (1) shall not affect licences previously granted to third parties.

Section 31

Trade marks applied for

Sections 27 to 30 shall apply mutatis mutandis to rights established by virtue of application for trade marks.

Part 3

Proceedings in the course of trade mark matters

Chapter 1

Registration proceedings

Section 32

Requirements concerning the application

(1) Applications for the registration of a trade mark in the Register shall be filed with the German Patent and Trade Mark Office. The application can also be filed through a patent information centre where this agency has been designated to receive trade mark applications on the basis of a notice published by the Federal Ministry of Justice and Consumer Protection in the Federal Law Gazette.

(2) The application shall contain:

1. information permitting to identify the applicant,
2. a representation of the trade mark, and
3. a list of the goods or services for which registration is being requested.

(3) The application must meet the other requirements for filing provided for by statutory instrument in accordance with section 65 (1) no. 2.

(4) (repealed)

Section 33

Date of filing, right to registration, publication of the application

(1) The date of filing of the application for a trade mark shall be the date on which the documents containing the information specified in section 32 (2) are received

1. by the German Patent and Trade Mark Office

2. or by a patent information centre if this agency has been so designated by notice published by the Federal Ministry of Justice and Consumer Protection in the Federal Law Gazette.

(2) The application for a trade mark whose date of filing has been established shall give rise to a right to a registration. The application for a registration shall be granted unless the prerequisites for application are not met or absolute grounds for refusal oppose the registration.

(3) The application for a trade mark which contains all the information pursuant to section 32 (2) shall be published including such information permitting to identify the applicant.

Section 34 Foreign priority

(1) The assertion of the priority of an earlier foreign application shall be governed by the provisions of the international agreements with the proviso that priority can also be claimed for services in accordance with the Paris Convention.

(2) If the earlier foreign application has been filed in a state with which no international treaty on the recognition of priority has been concluded, the applicant may claim a right of priority corresponding to the right of priority under the Paris Convention, in so far as, in accordance with a notice published by the Federal Ministry of Justice and Consumer Protection in the Federal Law Gazette, the other state grants a right of priority on the basis of the first application filed with the German Patent and Trade Mark Office which is comparable as regards the terms and conditions and content to the right of priority in accordance with the Paris Convention.

(3) Any person who claims priority in accordance with subsection (1) or (2) shall within two months after the date of filing indicate the date and state of the earlier application. If the applicant has submitted these particulars, the German Patent and Trade Mark Office shall invite him to indicate the file number of the earlier application and to submit a copy of the earlier application within two months of the service of the request. The particulars may be changed within these time limits. If the particulars are not submitted in due time, the right of priority shall be forfeited for this application.

Section 35 Exhibition priority

(1) Where the applicant for a trade mark has displayed goods or services under the trade mark applied for

1. at an official or officially recognised international exhibition falling within the terms of the Convention on International Exhibitions signed in Paris on 22 November 1928, or

2. at another domestic or foreign exhibition,

he may, if he files the application within a period of six months following the first display of the goods or services under the trade mark applied for, claim a right of priority from that date within the meaning of section 34.

(2) Notice of the exhibitions referred to in subsection (1) no. 1 shall be published by the Federal Ministry of Justice and Consumer Protection in the Federal Gazette (Bundesanzeiger).

(3) The exhibitions within the meaning of subsection (1) no. 2 shall be determined in each individual case by the Federal Ministry of Justice and Consumer Protection and notice thereof shall be published in the Federal Gazette.

(4) Any person who claims a priority in accordance with subsection (1) shall, within two months after the date of filing, indicate the date of the first display as well as the exhibition. If the applicant has provided this information, the German Patent and Trade Mark Office shall invite him to submit the documentation proving the display of the goods or services under the trade mark applied for within two months after the service of the request. If the

documentation is not submitted in due time, the right of priority shall be forfeited for this application.

(5) The exhibition priority in accordance with subsection (1) shall not extend the period of priority specified in section 34.

Section 36 **Examination of the conditions of filing**

(1) The German Patent and Trade Mark Office shall examine whether

1. the application for the trade mark satisfies the requirements for the accordance of a date of filing in accordance with section 33 (1);
2. the application complies with the other conditions of filing;
3. the sufficient amount of fees has been paid; and
4. the applicant may be a proprietor of a trade mark in accordance with section 7.

(2) If deficiencies ascertained in accordance with subsection (1) no. 1 are not remedied within a period set by the German Patent and Trade Mark Office, the application shall be deemed to have been withdrawn. If the applicant complies with the request of the German Patent and Trade Mark Office, the German Patent and Trade Mark Office shall accord as the date of filing the date on which the deficiencies noted were remedied.

(3) If class fees are not subsequently paid within a period set by the German Patent and Trade Mark Office, or are not paid in a sufficient amount, or if the applicant does not specify which goods or service classes are to be covered by the amount of fees paid, first the leading class and then the other classes shall be accounted for in the order of the classification. In other respects, the application shall be deemed to be withdrawn.

(4) If other deficiencies are not remedied within a period determined by the German Patent and Trade Mark Office, the German Patent and Trade Mark Office shall refuse the application.

(5) If the applicant cannot be a proprietor of a trade mark in accordance with section 7, the German Patent and Trade Mark Office shall refuse the application.

Section 37 **Examination for absolute grounds for refusal**

(1) If the trade mark is excluded from registration in accordance with section 3, 8 or 10, the application shall be refused.

(2) If the examination reveals that the trade mark (section 33 (1)) did not meet the prerequisites of section 8 (2) no. 1, 2 or 3 on the date of filing, but that the ground for refusal no longer applies subsequent to the date of filing, the application may not be refused if the applicant declares his agreement that, regardless of the original date of filing, and of any priority claimed for instance in accordance with section 34 or section 35, the date on which the ground for refusal ceased to apply is deemed to be the date of filing and is relevant for the purposes of establishing seniority within the meaning of section 6 (2).

(3) An application shall be refused in accordance with section 8 (2) no. 4 or no. 10 only if the deceptive nature or bad faith is evident.

(4) An application shall only be refused in accordance with section 10 if the authorities know of the fact that the earlier trade mark is well known and if the further prerequisites of section 9 (1) no. 1 or 2 apply.

(5) Subsections (1) to (4) shall apply mutatis mutandis if the trade mark has only been excluded from registration for a part of the goods or services for which the application was filed.

Section 38 **Accelerated examination**

The examination in accordance with sections 36 and 37 shall be expedited at the request of the applicant.

Section 39

Withdrawal, restriction and correction of the application

- (1) The applicant may withdraw the application at any time or restrict the list of goods and services contained in the application.
- (2) The content of the application may be altered at the request of the applicant to correct errors of wording or of transcription, or other obvious mistakes.

Section 40

Division of the application

- (1) The applicant may divide the application by declaring that the application for the trade mark shall continue to be dealt with as a divisional application for the goods and services listed in the declaration of division. The seniority of the original application shall be retained for each divisional application.
- (2) If the fee in accordance with the Patent Costs Act (Patentkostengesetz) for the division proceedings is not paid within three months after receipt of the declaration of division, the separated application shall be deemed to have been withdrawn. The declaration of division cannot be revoked.

Section 41

Registration, publication and trade mark information

- (1) If the application satisfies the requirements for application, and if it is not refused in accordance with section 37, the trade mark applied for shall be entered in the Register.
- (2) The registration shall be published. Publication may be in electronic format.
- (3) For further processing or use for the purposes of trade mark information, the German Patent and Trade Mark Office may transmit the information recorded in the Register to third parties in electronic format. The transmission shall not take place in so far as inspection is excluded pursuant to section 62 (4).

Section 42

Opposition

- (1) Within a three-month period after the date of the publication of the registration of the trade mark in accordance with section 41, the proprietor of an earlier trade mark or commercial designation may lodge an opposition against the registration of the trade mark.
- (2) The opposition may only invoke that the trade mark may be cancelled
 1. because of an earlier trade mark applied for or registered in accordance with section 9,
 2. because of an earlier well-known mark in accordance with section 10 in conjunction with section 9,
 3. because of its registration for an agent or representative of the trade mark proprietor in accordance with section 11, or
 4. because of an earlier trade mark not registered in accordance with section 4 no. 2 or of an earlier commercial designation in accordance with section 5 in conjunction with section 12.
- (3) (repealed)

Section 43

Objection of insufficient use, decision on the opposition

- (1) If the opposition has been lodged by the proprietor of an earlier registered trade mark, he shall, if the other party disputes the use of the trade mark, make a plausible case that he, within the last five years prior to the publication of the registration of the trade mark which is

targeted by the opposition, has been used in accordance with section 26 in so far as it has been registered for at least five years at this point in time. If the period of five years of non-use ends after the publication of the registration, the opponent, if the other party disputes the use, must make a plausible case that the trade mark has been used in accordance with section 26 within the past five years prior to the decision on the opposition. Only those goods or services shall be taken into consideration in the decision with respect to which a plausible case has been made for use.

(2) If the examination of the opposition reveals that the trade mark is to be cancelled for all or part of the goods or services in respect of which it is registered, the registration shall be cancelled in full or in part. If the registration of the trade mark cannot be cancelled, the opposition shall be refused.

(3) If the registered trade mark is to be cancelled because of one or several earlier trade marks, the proceedings on further oppositions may be suspended until a decision has been handed down with legal force on the registration of the trade mark.

(4) Section 52 (2) and (3) shall apply mutatis mutandis in the event of cancellation in accordance with subsection (2).

Section 44

Action for the grant of registration

(1) The proprietor of the trade mark may claim by means of an action against the opponent that he has a right to the registration despite the cancellation of the registration in accordance with section 43.

(2) The action in accordance with subsection (1) shall be lodged within six months after the decision with which the registration has been cancelled ceases to be subject to appeal.

(3) The registration on the basis of a decision in favour of the proprietor of the trade mark shall be effected preserving the seniority of the registration.

Chapter 2

Correction, division, duration of protection and renewal

Section 45

Correction of the Register and of publications

(1) Entries in the Register can be altered upon request or ex officio to correct errors of wording or of transcription, or other obvious mistakes. If the registration affected by the correction had been published, the corrected registration shall be published.

(2) Subsection (1) shall apply mutatis mutandis to the correction of publications.

Section 46

Division of the registration

(1) The proprietor of a registered trade mark may divide the registration by declaring that the registration of the trade mark for the goods or services listed in the declaration of division shall continue as a separated registration. The seniority of the original registration shall be retained for each divisional registration.

(2) The division may not be declared until after expiry of the time limit for the lodging of the opposition. The declaration shall only be admissible if an opposition pending at the time of its submission against the registration of the trade mark or an action pending at this time for cancellation of the registration of the trade mark would, after the division, only address one of the parts of the original registration.

(3) If the fee in accordance with the Patent Costs Act for the division proceedings is not paid within three months after receipt of the declaration of division, this shall be deemed to constitute surrender of the separated registration. The declaration of division cannot be revoked.

Section 47

Duration of protection and renewal

(1) The duration of protection of a registered trade mark shall commence on the date of filing (section 33 (1)) and shall end after ten years on the last day of the month corresponding in name to the month in which the date of filing falls.

(2) The duration of protection may be extended by ten years in each case.

(3) The renewal of the duration of protection shall be effected by payment of a renewal fee and, if the renewal is requested for goods and services falling in more than three classes of the classification of goods and services, payment of a class fee for each further class.

(4) If the fees only relate to a part of the goods or services for which the trade mark is registered, the duration of protection shall only be renewed for these goods or services. If only the required class fees are not paid, the duration of protection, unless the first sentence applies, shall be renewed only for the classes for which the fees paid suffice. If there is a leading class, it shall be accounted for first. In other respects, the classes shall be taken into account in the order of the classification.

(5) The renewal of the duration of protection shall become effective on the day after the expiry of the duration of protection. It shall be recorded in the Register and published.

(6) If the duration of protection is not renewed, the registration of the trade mark shall be cancelled with effect from the expiry of the duration of protection.

Chapter 3

Surrender, revocation and invalidity, cancellation proceedings

Section 48

Surrender

(1) At the request of the proprietor of the trade mark, the registration shall be cancelled in the Register at any time for all or for a part of the goods or services in respect of which it is registered.

(2) If a person is entered in the Register as the proprietor of a right to the trade mark, the registration shall only be cancelled with the consent of this person.

Section 49

Revocation

(1) The registration of a trade mark shall be cancelled on request because of revocation if the trade mark has not been used after the date of registration in accordance with section 26 within an uninterrupted period of five years. The revocation of a trade mark may however not be claimed if use of the trade mark in accordance with section 26 has been commenced or resumed after the end of this period and prior to the filing of the request for cancellation. If, however, use is commenced or resumed following an uninterrupted period of five years of non-use within three months prior to the filing of the cancellation request, it shall remain unconsidered in so far as the preparations for the first or renewed use did not take place until the proprietor of the trade mark became aware of the fact that a request for cancellation may be filed. If the request for cancellation is made to the German Patent and Trade Mark Office in accordance with section 53 (1), the request to the German Patent and Trade Mark Office shall remain relevant for the calculation of the three-month period in accordance with the third sentence if the action for cancellation in accordance with section 55 (1) is lodged within three months after service of the notice in accordance with section 53 (4).

(2) The registration of a trade mark shall furthermore be cancelled on request because of revocation

1. if, as a consequence of acts or inactivity of the proprietor, the trade mark has become the common name in the trade of the goods or services in respect of which it is registered;

2. if, as a consequence of the use made of the trade mark by the proprietor or with his consent in respect of the goods or services in respect of which it is registered, the trade mark is liable to mislead the public particularly as to the nature, quality or geographical origin of those goods or services;

3. if the proprietor of the trade mark no longer complies with the prerequisites set out in section 7.

(3) If a ground for revocation applies only to a part of the goods or services for which the trade mark has been registered, the registration shall only be cancelled for these goods or services.

Section 50

Invalidity because of absolute grounds for refusal

(1) The registration of a trade mark shall be cancelled on request because of invalidity if it has been registered contrary to sections 3, 7 or 8.

(2) If the trade mark has been registered contrary to sections 3, 7 or 8 (2) no. 1 to 9, the registration may only be cancelled if the ground for refusal still exists at the time of the decision on the request for cancellation. If the trade mark has been registered contrary to section 8 (2) no. 1, 2 or 3, the registration may furthermore only be cancelled if the request for cancellation is lodged within ten years since the date of registration.

(3) The registration of a trade mark may be cancelled ex officio if it has been registered contrary to section 8 (2) no. 4 to 10, and

1. the cancellation proceedings are initiated within a period of two years from the date of registration;

2. the absolute ground for refusal in accordance with section 8 (2) no. 4 to 9 continues to exist at the time of the decision on the cancellation; and

3. the registration has been manifestly made contrary to the provisions listed.

(4) If there is a ground for invalidity only for a part of the goods or services for which the trade mark has been registered, the registration shall only be cancelled for these goods or services.

Section 51

Invalidity because of the existence of earlier rights

(1) The registration of a trade mark shall be cancelled in response to an action because of invalidity if it is opposed by an earlier right within the meaning of sections 9 to 13.

(2) The registration may not be cancelled because of the registration of an earlier trade mark in so far as the proprietor of the earlier trade mark has tolerated the use of the later trade mark for the goods or services in respect of which it is registered during a period of five consecutive years in the knowledge of this use, unless the application for the later trade mark has been made in bad faith. The same shall apply to the proprietor of an earlier right to a trade mark acquired by use within the meaning of section 4 no. 2, in a well-known mark within the meaning of section 4 no. 3, in a commercial designation within the meaning of section 5 or in a name of a plant variety within the meaning of section 13 (2) no. 4. The registration of a trade mark may further not be cancelled if the proprietor of one of the rights listed in sections 9 to 13 with older seniority has consented to the registration of the trade mark prior to the filing of the request for cancellation.

(3) The registration may not be cancelled because of an earlier trade mark which has a reputation or of an earlier commercial designation which has a reputation if the trade mark or the commercial designation did not yet have a reputation within the meaning of section 9 (1) no. 3, of section 14 (2) no. 3 or of section 15 (3) on the date which is relevant for the seniority of the registration of the later trade mark.

(4) The registration may not be cancelled because of the registration of a trade mark with older seniority if the registration of the trade mark with older seniority could have been cancelled on the date of the publication of the registration of the later trade mark

1. because of revocation in accordance with section 49; or

2. because of absolute grounds for refusal in accordance with section 50.

(5) If there is a ground for invalidity only for a part of the goods or services for which the trade mark is registered, the registration shall only be cancelled for these goods or services.

Section 52

Impact of cancellation because of revocation or invalidity

(1) The effects of the registration of a trade mark shall be deemed not to have taken place from the point in time of the lodging of the action for cancellation to the extent to which the registration is cancelled because of revocation. In the decision, at the request of a party, an earlier point in time may be determined at which one of the grounds for revocation commenced to apply.

(2) The impact of the registration of a trade mark shall be deemed to not have taken effect from the outset to the extent to which the registration is cancelled because of invalidity.

(3) Subject to the provisions on compensation for the damage which has been caused by negligent or intentional conduct on the part of the proprietor of a trade mark as well as of the provisions on unjust enrichment, the cancellation of the registration of the trade mark shall not affect

1. decisions in infringement proceedings which have become final and have been executed prior to the decision on the cancellation request, and

2. contracts concluded prior to the decision on the cancellation request in so far as they have been performed prior to this decision. It may however be required that amounts paid in performance of the contract are refunded for reasons of equity in so far as the circumstances so justify.

Section 53

Cancellation by the German Patent and Trade Mark Office because of revocation

(1) The request for cancellation because of revocation (section 49) may be lodged with the German Patent and Trade Mark Office, without prejudice to the right to assert the request by means of an action in accordance with section 55.

(2) The German Patent and Trade Mark Office shall inform the proprietor of the registered trade mark of the request and shall invite him to inform the German Patent and Trade Mark Office whether he objects to the cancellation.

(3) If the proprietor of the registered trade mark does not object to the cancellation within two months of service of the notice, the registration shall be cancelled.

(4) If the proprietor of the registered trade mark objects to the cancellation, the German Patent and Trade Mark Office shall inform the applicant thereof, and shall inform him that the request for cancellation is to be asserted by means of an action in accordance with section 55.

Section 54

Cancellation proceedings before the German Patent and Trade Mark Office because of absolute grounds for refusal

(1) The request for cancellation because of absolute grounds for refusal (section 50) shall be lodged with the German Patent and Trade Mark Office. The request may be lodged by any person.

(2) If a request for cancellation is lodged, or if cancellation proceedings are initiated ex officio, the German Patent and Trade Mark Office shall inform the proprietor of the registered trade mark thereof. If he does not object to the cancellation within two months of service of the notice, the registration shall be cancelled. If he objects to the cancellation, the cancellation proceedings shall be implemented.

Section 55

Cancellation proceedings before the courts of ordinary jurisdiction

(1) The action for cancellation for revocation (section 49) or because of the existence of earlier rights (section 51) shall be brought against the party registered as the proprietor of the trade mark or his successor.

(2) The following shall be entitled to lodge the action:

1. in cases of a request for cancellation because of revocation, any person,
2. in cases of a request for cancellation because of the existence of earlier rights, the proprietors of the rights listed in sections 9 to 13,
3. in cases of a request for cancellation because of the existence of an earlier indication of geographical origin (section 13 (2) no. 5), the party entitled to assert rights in accordance with section 8 (3) of the Act Against Unfair Competition (Gesetz gegen den unlauteren Wettbewerb).

(3) If the action for cancellation has been lodged by the proprietor of a registered trade mark with older seniority, he shall document in response to an objection by the defendant that the trade mark has been used in accordance with section 26 within the last five years prior to the lodging of the action, in so far as it has been registered at this time for at least five years. If the five-year period of non-use ends after the action has been lodged, the claimant shall document in response to an objection on the part of the defendant that the trade mark has been used in accordance with section 26 within the last five years prior to the conclusion of the oral hearing. If the earlier trade mark had already been registered for at least five years on the date of the publication of the registration of the later trade mark, the claimant shall further prove in response to an objection on the part of the defendant that the registration of the earlier trade mark could not have been cancelled in accordance with section 49 (1) on this day. Only those goods or services for which use has been documented shall be taken into account in the decision.

(4) If prior to or subsequent to the lodging of the action the right arising from the registration of the trade mark has been transferred or passed to another person, the decision on the merits themselves shall also be effective and executable against the successor. Sections 66 to 74 and 76 of the Code of Civil Procedure shall apply mutatis mutandis to the power of the successor to accede to the legal dispute.

Chapter 4

General provisions for the procedures before the German Patent and Trade Mark Office

Section 56

Competences in the German Patent and Trade Mark Office

(1) Trade Mark Sections and Trade Mark Divisions shall be established at the German Patent and Trade Mark Office to conduct proceedings in trade mark matters.

(2) The Trade Mark Sections shall be competent for the examination of trade marks applied for and for taking decisions in the registration proceedings. The tasks of a Trade Mark Section shall be performed by a member of the German Patent and Trade Mark Office (examiner). The tasks may also be carried out by an official of the higher intermediate service or by a comparable employee. Officials of the higher intermediate service and comparable employees shall however not be entitled to order an oath to be sworn or to administer an oath or to address a request in accordance with section 95 (2) to the Federal Patent Court.

(3) The Trade Mark Divisions shall have jurisdiction for those matters which do not fall within the jurisdiction of the Trade Mark Sections. The tasks of a Trade Mark Division shall be carried out by a team composed of at least three members of the German Patent and Trade Mark Office. The chair of a Trade Mark Division may work alone on all matters falling within the jurisdiction of the Trade Mark Division, with the exception of the decision on the cancellation of a trade mark in accordance with section 54, or transfer such matters to a member of the Trade Mark Division for processing.

Section 57

Exclusion and objection

(1) Sections 41 to 44, 45 (2), second sentence, and sections 47 to 49 of the Code of Civil Procedure with regard to the exclusion of and objection to court personnel shall apply mutatis mutandis to the exclusion of and objection to the examiners and of the members of the Trade Mark Divisions as well as of the civil servants of the higher intermediate and intermediate service or employees entrusted with the handling of matters incumbent upon the Trade Mark Sections or the Trade Mark Divisions.

(2) A Trade Mark Division shall decide on the objection request in so far as a decision is necessary.

Section 58

Opinions

(1) The German Patent and Trade Mark Office shall be obliged to provide opinions at the request of the courts or of the public prosecution offices with regard to questions relating to trade marks filed or registered if divergent opinions have been submitted in the proceedings by more than one expert witness.

(2) In other respects, the German Patent and Trade Mark Office shall not be entitled without the permission of the Federal Ministry of Justice and Consumer Protection to take decisions or to provide opinions outside of its statutory scope of activities.

Section 59

Ascertaining the facts, legal hearing

(1) The German Patent and Trade Mark Office shall ascertain the facts ex officio. It shall not be bound by the pleadings and the motions to take evidence filed by the parties.

(2) If the decision of the German Patent and Trade Mark Office is to be based on circumstances which have not yet been communicated to the applicant or to the proprietor of the trade mark or to another party to the proceedings, he shall first be given the opportunity to comment within a specific time limit.

Section 60

Investigations, hearings, minutes

(1) The German Patent and Trade Mark Office may summon and hear the parties at any time, may examine witnesses, experts and parties under oath or not under oath, and may undertake further examination as necessary to examine the matter.

(2) Until the decision with which the proceedings are concluded, the applicant or proprietor of the trade mark or another party to the proceedings shall be heard on request if this is expedient. If the German Patent and Trade Mark Office does not consider a hearing to be expedient, it shall refuse the request. The decision to refuse the request shall not be independently contestable.

(3) Minutes shall be drawn up of the hearings and taking of evidence containing the essentials of the proceedings and the relevant statements made by the parties. Sections 160a, 162 and 163 of the Code of Civil Procedure shall apply mutatis mutandis. The parties shall receive a copy of the minutes.

Section 61

Decisions, instructions on appellate remedy

(1) Even if they have been delivered in accordance with the third sentence, the decisions of the German Patent and Trade Mark Office shall be reasoned and a copy thereof served on the parties ex officio; a certification of the copy is not required. Execution copies will only be issued at the request of one of the parties and only in paper format. If a hearing has taken place, they may also be delivered at the end of the hearing. The decision need not be reasoned if only the applicant or proprietor of the trade mark is party to the proceedings and his request is granted.

(2) Upon service of the decision, the parties shall be instructed on the appellate remedy which is available from the decision, on the authority with which the appellate remedy shall be filed, on the time limit for filing of an appellate remedy, and, where a fee is payable for the appellate remedy in accordance with the Patent Costs Act, on the fee. The time limit for filing the appeal only begins to run if the parties have been instructed in accordance with the first sentence. If the instruction has not been given or was given incorrectly, filing the appellate remedy shall only be admissible within one year following service of the decision, except in cases where the party has been instructed in writing that an appellate remedy is available. Section 91 shall apply mutatis mutandis. The first to fourth sentences shall apply mutatis mutandis to the appellate remedy special motion (Erinnerung) in accordance with section 64.

Section 62

Inspection of files, inspection of the Register

- (1) Upon request, the German Patent and Trade Mark Office shall grant inspection of the files of applications for trade marks if a legitimate interest is substantiated.
- (2) After the registration of the trade mark, inspection of the files of the registered trade mark shall be granted.
- (3) Inspection of the files in accordance with subsection (2) may also be granted via the Internet where the files are kept electronically.
- (4) The inspection of the files in accordance with subsections (1) to (3) shall be ruled out where it is precluded by a legal provision or where an interest meriting protection of the data subject within the meaning of Article 4 (1) of the Regulation (EU) 2016/679 of the European Parliament and of the Council of 27 April 2016 on the protection of natural persons with regard to the processing of personal data and on the free movement of such data, and repealing Directive 95/46/EC (General Data Protection Regulation (OJ L 119, 4 May 2016, p. 1, L 314, 22 November 2016, p. 72) in its respectively applicable version obviously prevails.
- (5) The Register may be inspected by any person.

Section 62a

Data protection

Insofar as the Register or publicly available electronic information services of the German Patent and Trade Mark Office contain personal data, the following shall not apply:

1. the right of access pursuant to point (c) of Article 15 para. 1 of Regulation (EU) 2016/679,
2. the notification obligation pursuant to the second sentence of Article 19 of Regulation (EU) 2016/679, and
3. the right to object pursuant to Article 21 para. 1 of Regulation (EU) 2016/679.

The right to obtain a copy pursuant to Article 15 para. 3 of Regulation (EU) 2016/679 shall be deemed to be satisfied where the data subject has been granted inspection of the Register or publicly available information services of the German Patent and Trade Mark Office.

Section 63

Costs of the proceedings

- (1) If several persons are involved in the proceedings, the German Patent and Trade Mark Office may determine in the decision that the costs of the proceedings, including the expenses of the German Patent and Trade Mark Office and the costs incurred by the parties, in so far as they were necessary for the appropriate defence of the claims and rights, be imposed on one of the parties in full or in part if this is equitable. This may also be determined if the party withdraws the special motion (Erinnerung), the application for the trade mark, the opposition or the request for cancellation in full or in part or if the registration of the trade mark is cancelled in full or in part in the Register because of surrender or because of non-renewal of the duration of protection. In so far as no determination is made as to the costs, each of the parties shall bear the costs incurred by him himself.

(2) Where a decision is taken pursuant to subsection (1), the German Patent and Trade Mark Office shall fix the value of the claim; section 23 (3), second sentence, and section 33 (1) of the Act on the Remuneration of Lawyers (Rechtsanwaltsvergütungsgesetz) shall apply mutatis mutandis. The decision on the value of the claim may be combined with the decision referred to in subsection (1).

(3) The German Patent and Trade Mark Office may order that the fee in accordance with the Patent Costs Act for the accelerated examination, for the opposition or cancellation proceedings shall be reimbursed in full or in part if this is equitable.

(4) The amount of the costs to be reimbursed shall be determined upon request by the German Patent and Trade Mark Office. The provisions of the Code of Civil Procedure concerning the procedure for the assessment of costs (sections 103 to 107) and compulsory enforcement based on orders assessing the costs (sections 724 to 802) shall apply mutatis mutandis. The appeal from the order assessing the costs shall be available instead of the appellate remedy provided for by the Code of Civil Procedure (Erinnerung). Section 66 shall apply with the proviso that the appeal shall be lodged within two weeks. The enforceable execution copy shall be issued by the registry clerk at the registry of the Federal Patent Court.

Section 64

Special motion (Erinnerung)

(1) The special motion (Erinnerung) shall be available against the decisions of the Trade Mark Sections and the Trade Mark Divisions which have been issued by a civil servant of the higher intermediate service or a comparable employee. The special motion (Erinnerung) shall have a suspensive effect.

(2) The special motion (Erinnerung) shall be filed with the German Patent and Trade Mark Office within one month of service of the decision.

(3) If the civil servant or employee whose decision is contested regards the special motion (Erinnerung) as well founded, he shall rectify his decision. This shall not apply if the party that lodged the special motion (Erinnerung) is opposed by another party to the proceedings.

(4) A member of the German Patent and Trade Mark Office shall decide on the special motion (Erinnerung).

(5) The Trade Mark Section or the Trade Mark Division may order that the fee to be paid in accordance with the Patent Costs Act for the special motion (Erinnerung) shall be reimbursed in full or in part.

(6) In place of the special motion (Erinnerung), the appeal in accordance with section 66 may be lodged. If, in proceedings in which several persons are involved, one party has lodged a special motion (Erinnerung), and another party has lodged an appeal against a decision, the party that lodged the special motion (Erinnerung) may also lodge an appeal. If the appeal of the party that lodged the special motion (Erinnerung) is not lodged within one month of service of the appeal of the other party in accordance with section 66 (4), second sentence, his special motion (Erinnerung) shall be deemed to have been withdrawn.

(7) It shall no longer be possible to rule on a special motion (Erinnerung) after an appeal has been lodged in accordance with subsection (6), second sentence, or in accordance with section 66 (3). A decision on a special motion (Erinnerung) nonetheless issued after an appeal has been lodged shall be null and void.

Section 64a

Costs arrangements in the proceedings before the German Patent and Trade Mark Office

The Patent Costs Act shall apply to the costs in the proceedings before the German Patent and Trade Mark Office.

Section 65

Authorisation to issue statutory instruments

(1) The Federal Ministry of Justice and Consumer Protection shall be authorised, by statutory instrument not requiring the consent of the Bundesrat,

1. to regulate the establishment and the business procedure, as well as the form taken by the proceedings in trade mark matters unless these have been regulated by statute,
2. to determine further requirements for the application for trade marks,
3. to determine the classification of goods and services,
4. to make detailed arrangements for the implementation of the examination, opposition and cancellation proceedings,
5. to make arrangements regarding the Register of registered trade marks and, where appropriate, separate provisions regarding the Register for collective marks,
6. to regulate the indications regarding registered trade marks to be included in the Register and to determine the extent and the nature of the publication of these indications,
7. to make arrangements regarding the other procedures before the German Patent and Trade Mark Office provided for in this Act, such as in particular the procedure in the division of applications and of registrations, the procedure to issue information or certificates, the procedure for the re-establishment of rights, the procedure to inspect files, the procedure regarding protection of international registrations and the procedure regarding the conversion of Community trade marks,
8. to make arrangements regarding the form in which requests and submissions are to be submitted in trade mark matters, including the transmission of requests and submissions by means of electronic data transmission,
9. to make arrangements regarding the form in which decisions, notices or other communications of the German Patent and Trade Mark Office in trade mark matters are to be transmitted to the parties, including transmission by means of electronic data transmission unless a specific form of transmission is prescribed by law,
10. to make arrangements regarding the cases in which and the circumstances under which submissions and documents in trade mark matters are considered in other languages than German,
11. to entrust civil servants of the higher intermediate service or comparable employees with carrying out matters which are incumbent on the Trade Mark Divisions and which by their nature do not pose any particular legal difficulties, with the exception of taking decisions on the cancellation of trade marks (section 48 (1) and sections 53 and 54), the submission of expert reports (section 58 (1)) and the decisions whereby the submission of an expert report is refused,
12. to entrust civil servants of the intermediate service or comparable employees with the carrying out of tasks which are incumbent on the Trade Mark Sections or Trade Mark Divisions and which by their nature do not pose any particular legal difficulties, with the exception of decisions on applications and oppositions,
13. to prescribe the indications to be included in the publication in accordance with section 33 (3), as well as to determine the scope and nature of the publication of these indications.

(2) The Federal Ministry of Justice and Consumer Protection may, by statutory instrument not requiring the consent of the Bundesrat, delegate the authorisation to issue statutory

instruments referred to in subsection (1), in whole or in part, to the German Patent and Trade Mark Office.

Chapter 5 Proceedings before the Federal Patent Court

Section 66 Appeal

(1) The appeal to the Federal Patent Court shall be available from the decisions of the Trade Mark Sections and the Trade Mark Divisions, without prejudice to the provision of section 64. The parties to the proceedings before the German Patent and Trade Mark Office shall be entitled to appeal. The appeal shall have suspensive effect.

(2) The appeal shall be filed in writing with the German Patent and Trade Mark Office within one month of service of the decision.

(3) If no decision has been taken regarding a special motion (Erinnerung) in accordance with section 64 within six months after its lodging, and if the party that lodged the special motion (Erinnerung) has made a request for a decision after expiry of this period, the appeal shall be admissible directly against the decision of the Trade Mark Section or the Trade Mark Division in derogation from subsection (1), first sentence, if no decision has been taken on the special motion (Erinnerung) within two months after receipt of the request. If the party that lodged the special motion (Erinnerung) is opposed in the special motion (Erinnerung) proceedings by another party, the first sentence shall apply with the proviso that the six-month time limit after the lodging of the special motion (Erinnerung) shall be replaced by a time limit of ten months. If the other party has also lodged a special motion (Erinnerung), the appeal in accordance with the second sentence shall require the consent of the other party. The written declaration of consent shall be enclosed with the appeal. If the other party does not also lodge an appeal within a period of one month after service of the appeal in accordance with subsection (4), second sentence, his special motion (Erinnerung) shall be deemed to have been withdrawn. The running of the periods in accordance with the first and second sentences shall be suspended if the proceedings are stayed or if a party is granted a time limit at his request or because of binding provisions. The remaining part of the periods in accordance with the first and second sentences shall commence after the ending of the suspension or after expiry of the time limit that has been granted. After the decision on the special motion (Erinnerung) has been taken, an appeal in accordance with the first and second sentences shall no longer be available.

(4) Copies for the other parties shall be enclosed with the appeal and all written pleadings. The appeal and all written pleadings containing substantive motions or the declaration of withdrawal of the appeal or of a motion shall be served on the other parties ex officio. Other written pleadings shall be informally communicated to them unless service is ordered.

(5) If the unit whose decision is contested regards the appeal as well founded, it shall rectify its decision. This shall not apply if the appellant is opposed by another party to the proceedings. The unit may order that the appeal fee in accordance with the Patent Costs Act be reimbursed. If the appeal is not allowed in accordance with the first sentence, it shall be remitted to the Federal Patent Court within one month and without comment as to its merit. The appeal shall be submitted to the Federal Patent Court promptly in cases falling under the second sentence. In proceedings with no third-party participation within the meaning of the second sentence, a request for the grant of legal aid for the appeal proceedings shall be submitted to the Federal Patent Court for a preliminary ruling without delay.

Section 67 Boards of Appeal, public nature of the hearing

(1) A Board of Appeal at the Federal Patent Court sitting in a composition of three legally qualified members shall decide on appeals within the meaning of section 66.

(2) Proceedings regarding appeals from decisions of the Trade Mark Sections and the Trade Mark Divisions, including delivery of the decisions, shall be public in so far as the registration has been published.

(3) Sections 172 to 175 of the Courts Constitution Act (Gerichtsverfassungsgesetz) shall apply mutatis mutandis, with the proviso that

1. the public may also be excluded from the proceedings at the request of one of the parties if there are concerns of a threat to the interests of the applicant meriting protection,
2. the public is excluded when the decisions are delivered until the publication of the registration.

Section 68

Participation of the President of the German Patent and Trade Mark Office

(1) The President of the German Patent and Trade Mark Office may, if he considers it appropriate to safeguard the public interest, make written declarations to the Federal Patent Court in the appeal proceedings, participate in the hearings and make statements in the course of the proceedings. Written declarations on the part of the President of the German Patent and Trade Mark Office shall be notified to the parties by the Federal Patent Court.

(2) The Federal Patent Court may provide the President of the German Patent and Trade Mark Office with the option to intervene in the appeal proceedings if it considers this to be suitable because of a legal issue which is of fundamental importance. Upon receipt of the declaration of intervention, the President of the German Patent and Trade Mark Office shall become a party.

Section 69

Oral proceedings

Oral proceedings shall take place if

1. one of the parties makes a request for them,
2. the Federal Patent Court takes evidence (section 74 (1)), or
3. the Federal Patent Court considers them to be expedient.

Section 70

Decision on the appeal

(1) A decision on the appeal shall be taken by order.

(2) The order by means of which an appeal is rejected as inadmissible may be given without oral proceedings.

(3) The Federal Patent Court may annul the contested decision without deciding on the merits if

1. the German Patent and Trade Mark Office has not yet decided on the merits,
2. the proceedings before the German Patent and Trade Mark Office suffer from a substantial defect, or
3. new facts or evidence become known which are essential for the decision.

(4) The German Patent and Trade Mark Office shall also base its decision on the legal assessment on which the annulment in accordance with subsection (3) was based.

Section 71

Costs of the appeal proceedings

(1) If several persons are involved in the proceedings, the Federal Patent Court may determine that the costs of the proceedings, including the costs incurred by the parties, in so far as they were necessary to appropriately safeguard the claims and rights, be imposed on

one of the parties in full or in part if this is equitable. If no arrangement is made as to the costs, each party shall bear the costs incurred by the party itself.

(2) Costs may be imposed on the President of the German Patent and Trade Mark Office only if he has made requests after intervening in the proceedings.

(3) The Federal Patent Court may order the reimbursement of the appeal fee in accordance with the Patent Costs Act.

(4) Subsections (1) to (3) shall also apply if the party withdraws the appeal, the application for the trade mark, the opposition or the request for cancellation in full or in part, or if the registration of the trade mark is cancelled in the Register in full or in part because of surrender or because of non-renewal of the duration of protection.

(5) In other respects, the provisions of the Code of Civil Procedure concerning the procedure for the assessment of costs (sections 103 to 107) and compulsory enforcement based on orders assessing the costs (sections 724 to 802) shall apply *mutatis mutandis*.

Section 72

Exclusion and objection

(1) Sections 41 to 44 and 47 to 49 of the Code of Civil Procedure shall apply *mutatis mutandis* to the exclusion of and objection to court personnel.

(2) Any person shall also be excluded from exercising the office of judge who was involved in the preceding proceedings before the German Patent and Trade Mark Office.

(3) That board of whom the judge objected to is a member shall decide on the objection to that judge. If the number of board members ceases to constitute a quorum on account of the member objected to, another Board of Appeal shall take the decision.

(4) The board in whose sphere of business the matter falls shall decide on the objection to a registry clerk.

Section 73

Investigation of the facts, preparation of the oral hearing

(1) The Federal Patent Court shall investigate the facts *ex officio*. It shall not be bound by the pleadings and the motions to take evidence filed by the parties.

(2) Before the oral proceedings or, if no oral proceedings are held, before the Federal Patent Court takes its decision, the presiding judge or a member of the boards to be determined by him shall issue all orders which are necessary to dispose of the matter in oral proceedings or in one session if at all possible. In other respects, section 273 (2), (3), first sentence, and (4), first sentence, of the Code of Civil Procedure shall apply *mutatis mutandis*.

Section 74

Taking of evidence

(1) The Federal Patent Court shall take evidence in the oral proceedings. In particular, it may carry out an inspection, hear witnesses, experts and parties, and consult documents.

(2) In appropriate cases, the Federal Patent Court may, even before the oral proceedings, have one of its members as a judge by commission take evidence or may request another court to take evidence by designation of the individual question regarding which evidence is to be taken.

(3) The parties shall be informed of all dates scheduled for the taking of evidence and may attend the taking of evidence. They may address relevant questions to witnesses and experts. Where a question is challenged, the Federal Patent Court shall decide.

Section 75

Summonses

(1) As soon as the date for oral proceedings has been scheduled, the parties shall be summoned with at least two weeks' notice. In urgent cases, the presiding judge may shorten this period.

(2) The notice of summons shall indicate that if a party fails to appear, the proceedings may be held and a decision taken in his absence.

Section 76
Course of the proceedings

- (1) The presiding judge shall open and conduct the oral proceedings.
- (2) After the case has been called up, the presiding judge or the reporting judge shall present the essential content of the files.
- (3) Then the parties shall be allowed to speak in order to bring and reason their motions.
- (4) The presiding judge shall discuss the facts and legal aspects of the case with the parties.
- (5) The presiding judge shall permit each member of the board on request to ask questions. Where a question is challenged, the board shall decide.
- (6) After discussing the case, the presiding judge shall declare the oral proceedings closed. The board may decide to reopen the oral proceedings.

Section 77
Minutes

- (1) A registry clerk of the registry shall act as recording clerk at the oral proceedings and the taking of the evidence. If, on the order of the presiding judge, no recording clerk is required, a judge shall draw up the minutes.
- (2) Minutes of the oral proceedings and any taking of evidence shall be drawn up. Sections 160 to 165 of the Code of Civil Procedure shall apply mutatis mutandis.

Section 78
Assessment of evidence, legal right to be heard

- (1) The Federal Patent Court shall decide according to its independent conviction gained as an overall result of the proceedings. The decision shall state the grounds by which the judges were guided in coming to their conviction.
- (2) The decision may be based only on facts and results of evidence on which the parties were able to comment.
- (3) If prior oral proceedings took place, a judge who was not present at the last session of the oral proceedings may participate in the taking of the decision only with the consent of the parties.

Section 79
Delivery, notification, grounds

- (1) Where oral proceedings were conducted, the final decisions of the Federal Patent Court shall be delivered at the session at which the oral proceedings were closed or at a session to be scheduled immediately. This session shall be scheduled not more than three weeks later unless important grounds so require, in particular the extent or the complexity of the case. Notification of the final decision shall be permissible instead of delivery. If the Federal Patent Court takes its decision without oral proceedings, delivery shall be replaced by notification to the parties. The final decisions shall be notified to the parties ex officio.
- (2) The decisions of the Federal Patent Court by means of which a motion is refused or a decision is taken on an appellate remedy shall be reasoned.

Section 80
Corrections

- (1) Errors of transcription, miscalculations and similar obvious mistakes in the decision shall be corrected by the Federal Patent Court at any time.
- (2) If the elements of the decision contain other mistakes or ambiguities, the correction may be requested within two weeks of service of the decision.
- (3) A decision on the correction in accordance with subsection (1) may be taken without prior oral proceedings.
- (4) The Federal Patent Court shall decide on the request for correction in accordance with subsection (2) by order without taking evidence. Only those judges shall be involved who participated in the decision whose correction has been requested.
- (5) The order for correction shall be noted in the decision and execution copies.

Section 81

Representation, power of attorney

- (1) The parties may pursue proceedings before the Federal Patent Court themselves. Section 96 shall remain unaffected.
- (2) The parties may be represented by a lawyer or patent attorney as agent. In addition, only the following may be entitled to represent the parties as agents before the Federal Patent Court:
1. employees of the party or of an associated company (section 15 of the Share Capital Companies and Partnerships Act [Aktiengesetz]); authorities and legal persons under public law, including associations formed by them for the fulfilment of their public duties, may also be represented by employees of other authorities or legal persons under public law, including associations formed by them for the fulfilment of their public duties;
 2. family members of full age (section 15 of the Fiscal Code [Abgabenordnung], section 11 of the Act on Registered Life Partnerships [Lebenspartnerschaftsgesetz]), persons qualified to hold judicial office and joined parties if the representation is not linked to a paid activity.

Agents who are not natural persons shall act through their organs and persons appointed to represent them in proceedings.

- (3) The court shall, by final order, refuse those agents who are not entitled to represent in accordance with subsection (2). Procedural acts by an agent who is not entitled to represent and notifications or communications to this agent shall be effective until the agent is refused. The court may, by final order, refuse the agents designated in subsection (2), second sentence, from further representation if they are unable to properly present the facts and the dispute.
- (4) Judges may not act as agents before the court of which they are member.
- (5) The authorisation shall be filed with the court in writing. It may be subsequently filed. The Federal Patent Court may determine a time limit for this purpose.
- (6) Deficiencies of the authorisation may be asserted at any stage of the proceedings. The Federal Patent Court shall give due consideration to the deficiencies of the authorisation ex officio unless a lawyer or a patent attorney is acting as agent.

Section 81a

Legal aid

- (1) In proceedings before the Federal Patent Court, a party shall receive legal aid upon request subject to the application, mutatis mutandis, of sections 114 to 116 of the Code of Civil Procedure.
- (2) In other respects, section 130 (2) and (3) as well as sections 133 to 137 of the Patent Act shall apply mutatis mutandis.

Section 82

Application of further provisions, contestability, inspection of files

- (1) Where this Act does not contain any provisions in respect of the proceedings before the Federal Patent Court, the Courts Constitution Act and the Code of Civil Procedure shall apply mutatis mutandis unless it is precluded by the special characteristics of the proceedings before the Federal Patent Court. Section 227 (3), first sentence, of the Code of Civil Procedure shall not apply. The Patent Costs Act shall apply to the fees in the proceedings before the Federal Patent Court; the Court Costs Act (Gerichtskostengesetz) shall apply to the expenses mutatis mutandis.
- (2) The decisions of the Federal Patent Court shall be contestable only in so far as this is permitted under this Act.
- (3) Section 62 (1) to (4) shall apply mutatis mutandis in respect of the grant of inspection of the files to third persons. The Federal Patent Court shall decide on the request.

Chapter 6
Proceedings before the Federal Court of Justice

Section 83

Appeals on points of law allowed and those not needing to be allowed

(1) An appeal on points of law may be filed with the Federal Court of Justice from the orders of the Boards of Appeal of the Federal Patent Court ruling on an appeal under section 66 if the Board of Appeal allowed the appeal on points of law in its order. The appeal on points of law shall have suspensive effect.

(2) The appeal on points of law shall be allowed if

1. a decision needs to be taken on a legal matter of fundamental importance; or
2. the development of the law or ensuring the consistency of court rulings requires a decision by the Federal Court of Justice.

(3) It shall not be required to allow an appeal on points of law if it is noted

1. that the court issuing the order did not sit in the composition required by law;
2. that a judge was involved in taking the decision who was excluded from exercising judicial office by operation of law or was successfully objected to if suspected of partiality;
3. that one of the parties was denied the right to be heard;
4. that one of the parties was not represented in the proceedings in accordance with the provisions set out in this Act, unless he explicitly or tacitly consented to the conduct of the proceedings;
5. that the order was issued on the basis of oral proceedings in which the provisions on the admission of the public to the proceedings were violated; or
6. that the order is not reasoned.

Section 84

Entitlement to lodge an appeal, grounds for appeal

(1) The appeal on points of law shall be open to the parties to the appeal proceedings.

(2) The appeals on points of law may only rely on the fact that the order is based on a violation of the law. Sections 546 and 547 of the Code of Civil Procedure shall apply mutatis mutandis.

Section 85

Formal prerequisites

(1) The appeal on points of law shall be filed in writing with the Federal Court of Justice within one month of service of the order.

(2) The provisions set out in section 142 on reduction of the value in dispute shall apply mutatis mutandis in the proceedings on the appeal on points of law before the Federal Court of Justice.

(3) The appeal on points of law shall be reasoned. The time limit for submission of the grounds is one month. This period shall begin to run upon the filing of the appeal on points of law and may be extended by the presiding judge upon request.

(4) The grounds for the appeal on points of law shall contain the following:

1. the declaration as to the extent to which the decision is being contested and its amendment or annulment is being requested;
2. the indication of the violated legal provision; and

3. if the appeal on points of law is based on the infringement of procedural provisions, the description of the facts which result in the defect.

(5) The parties shall be represented before the Federal Court of Justice by a lawyer as agent who has been admitted to practise before the Federal Court of Justice. At the request of one of the parties, his patent attorney shall be permitted to speak. In respect of the costs arising from the participation of a patent attorney, fees pursuant to section 13 of the Act on the Remuneration of Lawyers (Rechtsanwaltsvergütungsgesetz) as well as the necessary expenses of the patent attorney shall be reimbursed.

Section 86

Examination of admissibility

The Federal Court of Justice shall examine, ex officio, whether the appeal on points of law per se is an available remedy and whether it has been filed and reasoned in the statutory form and within the statutory time limit. If any of these requirements is not met, the appeal on points of law shall be rejected as inadmissible.

Section 87

Several parties

(1) If several persons are involved in the proceedings on the appeal on points of law, the notice of appeal and the statement of grounds of appeal shall be served on the other parties, inviting them to make any statements in writing to the Federal Court of Justice within a specific time limit after service. The date on which the appeal on points of law was filed shall be communicated when the notice of appeal is served. The appellant should submit the required number of certified copies together with the notice of appeal or the statement of grounds of appeal.

(2) If the President of the German Patent and Trade Mark Office is not involved in the proceedings on an appeal on points of law, section 68 (1) shall apply mutatis mutandis.

Section 88

Application of further provisions

(1) The provisions of the Code of Civil Procedure on the exclusion of and objection to court personnel (sections 41 to 49), on agents and advisers (sections 78 to 90), on notifications ex officio (sections 166 to 190), on summonses, hearings and time limits (sections 214 to 229), and on the re-establishment of rights (sections 233 to 238) shall apply mutatis mutandis in proceedings on the appeal on points of law. Section 91(8) shall apply mutatis mutandis in the case of the re-establishment of rights. Upon request, a party shall be granted legal aid subject to the application, mutatis mutandis, of section 138 of the Patent Act.

(2) Section 67(2) and (3) shall apply mutatis mutandis to the public nature of the proceedings.

Section 89

Decision on the appeal on points of law

(1) The decision on the appeal on points of law shall be given by order. The decision may be taken without oral proceedings.

(2) The Federal Court of Justice shall be bound in its decision by facts established in the contested order unless admissible and reasoned grounds for appeal on points of law are submitted in relation to these facts.

(3) The decision shall be reasoned and served on the parties ex officio.

(4) Where the contested order is annulled, the case shall be referred back to the Federal Patent Court for further proceedings and decision. The Federal Patent Court shall also base its decision on the legal assessment on which the annulment was based.

Section 89a

Remedy in case of an infringement of the right to be heard

Upon the filing of a notice of defect by the party adversely affected by the decision, the proceedings shall be continued if the court has violated this party's right to be heard in a

manner which has a decisive influence on the decision. A notice of defect shall not be an available remedy against a decision given prior to the final decision. Section 321a (2) to (5) of the Code of Civil Procedure shall apply mutatis mutandis.

Section 90 **Ruling on costs**

(1) If several persons are involved in the proceedings, the Federal Court of Justice may determine that the costs of the proceedings, including the costs incurred by the parties, in so far as they were necessary to appropriately safeguard the claims and rights, be imposed on one of the parties in full or in part if this is equitable. Such a determination may also be made if the party in full or in part withdraws the appeal on points of law, the application for the trade mark, the opposition or the request for cancellation, or if the registration of the trade mark is in full or in part cancelled in the Register because of surrender or because of non-renewal of the duration of protection. In so far as a determination on the costs is not made, each party shall bear the costs incurred by him himself.

(2) If the appeal on points of law is refused or rejected as inadmissible, the costs caused by the appeal on points of law shall be imposed on the appellant. If a party has caused costs through gross negligence, they shall be imposed on him.

(3) Costs may be imposed on the President of the German Patent and Trade Mark Office only if he has filed the appeal on points of law or brought motions in the proceedings.

(4) In other respects, the provisions of the Code of Civil Procedure concerning the procedure for the assessment of costs (sections 103 to 107) and compulsory enforcement based on orders assessing the costs (sections 724 to 802) shall apply mutatis mutandis.

Chapter 7 **Joint provisions**

Section 91 **Re-establishment of rights**

(1) Any person who through no fault of his own was prevented from observing a time limit vis-à-vis the German Patent and Trade Mark Office or Federal Patent Court, where non-observance of which causes a legal disadvantage in accordance with legal provisions, shall have his rights re-established upon request. This shall not apply to the time limit for filing an opposition and for paying the opposition fee (section 6 (1), first sentence, of the Patent Costs Act).

(2) The re-establishment of rights shall be requested within two months of removal of the cause of non-compliance.

(3) The request shall state the facts on which the re-establishment of rights is based. These facts shall be substantiated when the request is filed or in the proceedings concerning the request.

(4) The omitted act shall be completed within the period for making the request. Where this is done, the re-establishment of rights may also be granted without request.

(5) The re-establishment of rights can no longer be requested and the omitted act no longer be completed one year after the expiry of the period which was not observed.

(6) The unit competent to decide on the completed act shall decide on the request.

(7) The re-establishment of rights shall be final.

(8) Where the proprietor of a trade mark has his rights re-established, he may not invoke rights with regard to these acts vis-à-vis third parties who, in good faith, have put goods on the market or supplied services under a sign identical with or similar to the trade mark in the course of the period between the loss of the right in the registration of the trade mark and the re-establishment of rights.

Section 91a **Further treatment of the application**

- (1) Where the trade mark application has been refused upon failure to comply with a time limit set by the German Patent and Trade Mark Office, the decision shall become ineffective without the need for its express annulment if the applicant requests further processing of the application and completes the omitted act.
- (2) The request shall be filed within one month of service of the decision to refuse the trade mark application. The omitted act shall be subsequently carried out within this period.
- (3) Re-establishment of rights shall be ruled out in respect of non-observance of the period under subsection (2) and the period for payment of the further processing fee under section 6 (1), first sentence, of the Patent Costs Act.
- (4) The unit competent to decide on the completed act shall decide on the request.

Section 92

Obligation to tell the truth

In proceedings before the German Patent and Trade Mark Office, the Federal Patent Court and the Federal Court of Justice, the parties shall make their statements on facts and circumstances in full and truthfully.

Section 93

Official language and court language

The language before the German Patent and Trade Mark Office and the Federal Patent Court shall be German. In other respects, the provisions of the Courts Constitution Act on the court language shall apply.

Section 93a

Compensation of witnesses, remuneration of expert witnesses

Witnesses shall receive compensation and experts shall receive remuneration pursuant to the Justice Remuneration and Compensation Act (Justizvergütungs- und -entschädigungsgesetz).

Section 94

Service, authorisation to issue statutory instruments

(1) The provisions of the Act on Service in Administrative Procedures (Verwaltungszustellungsgesetz) shall apply to service in proceedings before the German Patent and Trade Mark Office subject to the following conditions:

1. Service on addressees who are staying abroad and who, contrary to the requirement under section 96, have not appointed a representative in Germany may be effected by posting a registered letter. The same shall apply mutatis mutandis to addressees who themselves are representatives in Germany within the meaning of section 96 (2). Section 184 (2), first and fourth sentences, of the Code of Civil Procedure shall apply mutatis mutandis.
2. Section 5 (4) of the Act on Service in Administrative Procedures shall apply mutatis mutandis to service on holders of a certificate of representation (section 177 of the Patent Attorney Code [Patentanwaltsordnung]).
3. Service on addressees for whom a post box has been set up at the German Patent and Trade Mark Office may also be effected by depositing the document in the addressee's post box. A record of the deposit shall be added to the files. A note shall be made on the document of the date when it was deposited. Service shall be deemed to have been effected on the third day following deposit in the post box.
4. Electronic documents shall be served by a transmission route which guarantees the authenticity and integrity of the data and which, when using generally accessible networks, ensures the confidentiality of the data to be transmitted by means of an encryption method. The Federal Ministry of Justice and Consumer Protection shall issue by statutory instrument, not requiring the consent of the Bundesrat, more detailed

provisions on the appropriate routes of transmission referred to in the first sentence as well as on the format of and the documentation proving electronic service.

(2) The provisions of the Code of Civil Procedure shall apply to service in proceedings before the Federal Patent Court.

Section 95

Judicial assistance

(1) The courts shall be obliged to provide judicial assistance to the German Patent and Trade Mark Office.

(2) In proceedings before the German Patent and Trade Mark Office, the Federal Patent Court shall, upon the request of the German Patent and Trade Mark Office, impose administrative penalties and measures of compulsion on witnesses or experts who fail to appear or who refuse to give evidence or to give evidence under oath. In like manner, a warrant shall be issued for a witness who has failed to appear to be brought before the court.

(3) A Board of Appeal at the Federal Patent Court sitting in a composition of three legally qualified members shall decide on the request in accordance with subsection (2). The decision shall be given by order.

Section 95a

Electronic conduct of proceedings, authorisation to issue statutory instruments

(1) In so far as the written form is required in proceedings before the German Patent and Trade Mark Office in respect of applications, requests or other acts, the provisions contained in section 130a (1), (2) first sentence, (5), and (6) of the Code of Civil Procedure shall apply *mutatis mutandis*.

(2) The case files of the Federal Patent Court and of the Federal Court of Justice may be kept in electronic form. The provisions of the Code of Civil Procedure on electronic documents, the electronic file and the electronic conduct of proceedings shall apply *mutatis mutandis* in other respects, unless otherwise provided by this Act.

(3) The Federal Ministry of Justice and Consumer Protection shall, by statutory instrument not requiring the consent of the Bundesrat, determine

1. the date from when electronic documents may be submitted to the German Patent and Trade Mark Office and the courts, the appropriate form for processing the documents, whether an electronic signature shall be used and the form of such signature;

2. the date from when the case files may be kept in electronic form in accordance with subsection (2), as well as the applicable general organisational and technical conditions for the creation, keeping and storage of the electronic case files.

Section 96

Domestic representative

(1) Any person who has neither their residence nor principal place of business nor an establishment in Germany may participate in the proceedings before the German Patent and Trade Mark Office or the Federal Patent Court which are regulated under this Act and assert the rights deriving from a trade mark only if he has appointed as his representative a lawyer or patent attorney who is entitled and authorised to represent him in proceedings before the German Patent and Trade Mark Office, before the Federal Patent Court and in civil litigation affecting this trade mark, as well as to file an application for criminal prosecution.

(2) The place where a representative appointed pursuant to subsection (1) has his commercial premises shall be deemed, within the meaning of section 23 of the Code of Civil Procedure, to be the place where the asset is located; if there are no such commercial premises, the place where the representative is residing in Germany shall be decisive or, if there is no such place, the place where the German Patent and Trade Mark Office has its seat.

(3) The legal termination of the appointment of a representative in accordance with subsection (1) shall not become effective until the German Patent and Trade Mark Office or

the Federal Patent Court has been informed of both the termination of this appointment and the appointment of another representative.

Section 96a

Legal protection in case of excessively long court proceedings

The provisions of the Seventeenth Title of the Courts Constitution Act shall apply mutatis mutandis to proceedings before the Federal Patent Court and the Federal Court of Justice.

Part 4

Collective marks

Section 97

Collective marks

(1) All signs eligible for protection as a trade mark within the meaning of section 3 may be registered as collective marks if they are liable to distinguish the goods or services of the members of the proprietor of the collective mark from those of other enterprises in terms of their origin from a given enterprise or their geographical origin, their nature, quality or other properties.

(2) The provisions of this Act shall apply to collective marks unless otherwise provided in this Part.

Section 98

Proprietorship

The proprietor of collective marks that have been filed or registered can only be associations with legal personality, including the umbrella associations and central associations with legal personality whose members themselves are associations. Legal persons under public law shall be deemed to be equivalent to these associations.

Section 99

Eligibility for registration of indications of geographical origin as collective marks

In derogation from section 8 (2) no. 2, collective marks may consist exclusively of signs or indications which, in trade, may serve as a designation of the geographical origin of the goods or services.

Section 100

Restrictions of protection, use

(1) In addition to the restrictions of protection emerging from section 23, the registration of an indication of geographical origin as a collective mark shall not provide for the proprietor the right to prohibit a third party from using such indications in trade in so far as the use corresponds to the accepted principles of morality and is not contrary to section 127.

(2) The use of a collective mark by at least one person authorised to do so, or by the proprietor of the collective mark, shall be deemed to constitute use within the meaning of section 26.

Section 101

Right of action, compensation

(1) Unless otherwise provided in the regulations governing use of the mark, a person authorised to use the collective mark may lodge an infringement action of a collective mark only with the consent of its proprietor.

(2) The proprietor of the collective mark may also demand compensation for the damage which was incurred by the persons entitled to use the collective mark from the unauthorised use of the collective mark or of a similar sign.

Section 102

Regulations governing use of the mark

(1) The application for the collective mark must include regulations governing use of the mark.

(2) The regulations governing use of the mark must contain at least:

1. the name and principal place of business of the association;
2. the purpose and representation of the association;
3. prerequisites for membership;
4. indications regarding the group of persons entitled to use the collective mark;
5. the prerequisites for the use of the collective mark; and
6. indications regarding the rights and obligations of the parties in the case of infringements of the collective mark.

(3) If the collective mark consists of an indication of geographical origin, the regulations must provide that any person whose goods or services originate from the corresponding geographical territory and comply with the conditions contained in the regulations governing use of the collective mark may become a member of the association and is to be included in the group of persons entitled to use the collective mark.

(4) The inspection of the regulations governing use of the mark shall be open to everyone.

Section 103

Examination of the application

The application for a collective mark shall also be refused, in addition to cases falling under section 37, if it does not comply with the prerequisites of sections 97, 98 and 102 or if the regulations governing use of the mark are contrary to public policy or to accepted principles of morality, unless the applicant amends the regulations governing use of the mark such that the ground for refusal no longer exists.

Section 104

Amendment of the regulations governing use of the mark

(1) The proprietor of the collective mark shall inform the German Patent and Trade Mark Office of any amendment to the regulations governing use of the mark.

(2) Sections 102 and 103 shall apply mutatis mutandis in the case of an amendment to the regulations governing use of the mark.

Section 105

Revocation

(1) The registration of a collective mark shall be cancelled for revocation on request in addition to the grounds for revocation listed in section 49

1. if the proprietor of the collective mark no longer exists;
2. if the proprietor of the collective mark does not take any suitable measures to prevent the collective mark from being used abusively in a manner contrary to the purposes of the association or the regulations governing use of the mark; or
3. if an amendment to the regulations governing use of the mark has been entered in the Register contrary to section 104 (2), unless the proprietor of the collective mark once more amends the regulations governing use of the mark such that the ground for cancellation no longer exists.

(2) Abusive use within the meaning of subsection (1) no. 2 shall in particular be considered to have been committed if the use of the collective mark by persons other than those entitled to use is liable to mislead the public.

(3) The request for cancellation in accordance with subsection (1) shall be made to the German Patent and Trade Mark Office. The proceedings shall be in accordance with section 54.

Section 106

Invalidity because of absolute grounds for refusal

The registration of a collective mark shall be cancelled on request, in addition to the grounds for invalidity listed in section 50, because of invalidity if it has been registered contrary to section 103. If the ground for invalidity relates to the regulations governing use of the mark, the registration shall not be cancelled if the proprietor of the collective mark amends the regulations governing use of the mark such that the ground for invalidity no longer exists.

Part 5

Protection of trade marks in accordance with the Madrid Agreement and in accordance with the Protocol Relating to the Madrid Agreement, Community trade marks

Chapter 1

Protection of trade marks in accordance with the Madrid Agreement

Section 107

Application of the provisions of this Act; language

- (1) The provisions of this Act shall apply mutatis mutandis to the international registration of trade marks in accordance with the Madrid Agreement Concerning the International Registration of Marks (Madrid Agreement) effected through the intermediary of the German Patent and Trade Mark Office or whose protection covers the territory of the Federal Republic of Germany unless provided otherwise in this Chapter or in the Madrid Agreement.
- (2) All requests as well as other communications in the proceedings for international registration and the list of goods and services shall be submitted in either French or English, at the choice of the person making the request.

Section 108

Application for international registration

- (1) The application for international registration of a trade mark entered in the Register in accordance with Article 3 of the Madrid Agreement shall be made with the German Patent and Trade Mark Office.
- (2) If the application for international registration is lodged prior to the registration of the trade mark in the Register, it shall be deemed to have been received on the date of the registration of the trade mark.
- (3) With the application, the list of goods and services, broken down into classes, shall be submitted in the order of the international classification of goods and services.

Section 109

Fees

- (1) If the application for international registration has been lodged prior to the entry of the trade mark in the Register, the national fee for the proceedings for international registration shall be due on the date of the registration.
- (2) The national fee in accordance with the Patent Costs Act for the international registration shall be payable within one month after the due date, which shall be governed by section 3 (1) of the Patent Costs Act or in accordance with subsection (1).

Section 110

Entry in the Register

The date and the number of the international registration of a trade mark entered in the Register shall be entered in the Register.

Section 111

Subsequent extension of protection

- (1) A request may be lodged with the German Patent and Trade Mark Office for subsequent extension of protection of an international registration in accordance with Article 3ter paragraph 2 of the Madrid Agreement.

(2) The national fee in accordance with the Patent Costs Act for the subsequent extension of protection shall be payable within one month of its becoming due (section 3 (1) of the Patent Costs Act).

Section 112

Effect of international registration

(1) The international registration of a trade mark whose protection in accordance with Article 3ter of the Madrid Agreement has been extended to the territory of the Federal Republic of Germany shall have the same effect as if the trade mark had been filed and registered on the date of the international registration in accordance with Article 3 paragraph 4 of the Madrid Agreement or on the date of the registration of subsequent extension of protection in accordance with Article 3ter paragraph 2 of the Madrid Agreement for entry in the Register kept by the German Patent and Trade Mark Office.

(2) The effect designated in subsection (1) shall be deemed not to have accrued if the international registration is refused protection in accordance with sections 113 to 115.

Section 113

Examination for absolute grounds for refusal

(1) International registrations shall be examined for absolute grounds for refusal in the same way as trade marks whose entry in the Register has been applied for in accordance with section 37. Section 37 (2) shall not apply.

(2) The refusal of protection shall take the place of the refusal of the application (section 37 (1)).

Section 114

Opposition

(1) For international registrations, publication in the Gazette published by the International Bureau of the World Intellectual Property Organization shall take the place of the publication of the registration (section 41 (2)).

(2) The time limit to lodge the opposition (section 42 (1)) against the granting of protection for international registrations shall commence on the first day of the month following the month stated as the issue month of the Gazette issue containing the publication of the international registration.

(3) Refusal of protection shall take the place of the cancellation of the registration (section 43 (2)).

Section 115

Subsequent withdrawal of protection

(1) For international registrations, the request or the action for withdrawal of protection shall take the place of the request or the action for cancellation of a trade mark for revocation (section 49) because of the existence of absolute grounds for refusal (section 50) or because of an earlier right (section 51).

(2) If a request for withdrawal of protection in accordance with section 49 (1) is made for lack of use, the date of the entry in the Register shall be taken by the date

1. on which the communication regarding approval of protection was received by the International Bureau of the World Intellectual Property Organization; or
2. on which the time limit contained in Article 5 paragraph 2 of the Madrid Agreement expired if at that time neither the communication in accordance with no. 1 nor a communication on provisional refusal of protection has been received.

Section 116

Opposition and request for cancellation because of an international registration

(1) If an opposition has been lodged against the registration of a trade mark because of an international registration, section 43 (1) shall apply with the proviso that the date referred to in section 115 (2) shall take the place of the date of the registration.

(2) If an action for cancellation of a registered trade mark is lodged in accordance with section 51 because of an international registration, section 55 (3) shall apply with the proviso that the date referred to in section 115 (2) shall take the place of the date of the registration.

Section 117

Exclusion of rights for lack of use

If rights within the meaning of sections 14 and 18 to 19c are asserted because of the infringement of an international registration, section 25 shall apply with the proviso that the date referred to in section 115 (2) shall take the place of the date of registration of the trade mark.

Section 118

Consent to transfers of international registrations

The German Patent and Trade Mark Office shall give to the International Bureau of the World Intellectual Property Organization the consent required in accordance with Article 9bis paragraph 1 of the Madrid Agreement in the case of the transfer of an international registration, regardless of whether the trade mark has been registered for the new proprietor of the international registration in the Register kept by the German Patent and Trade Mark Office.

Chapter 2

Protection of trade marks in accordance with the Protocol Relating to the Madrid Agreement

Section 119

Application of the provisions of this Act; languages

(1) The provisions of this Act shall apply mutatis mutandis to international registrations of trade marks in accordance with the Madrid Protocol of 27 June 1989 Relating to the Madrid Agreement Concerning the International Registration of Marks (Protocol Relating to the Madrid Agreement) which are effected through the intermediary of the German Patent and Trade Mark Office or whose protection covers the territory of the Federal Republic of Germany, unless provided otherwise in this Chapter or in the Protocol Relating to the Madrid Agreement.

(2) All requests as well as other communications in the proceedings of the international registration and the list of goods and services shall be submitted in French or English, at the choice of the person making the request.

Section 120

Application for international registration

(1) The application for the international registration of a trade mark for which an application has been made for entry in the Register or of a trade mark which is already entered in the Register in accordance with Article 3 of the Protocol Relating to the Madrid Agreement shall be lodged with the German Patent and Trade Mark Office. The application may also be lodged prior to the registration of the trade mark if the international registration is to be effected based on a trade mark entered in the Register.

(2) If the international registration is to be effected on the basis of a trade mark that has been entered in the Register, and if the application for international registration is lodged prior to the entry of the trade mark in the Register, it shall be deemed to have been received on the date of the registration of the trade mark.

(3) The list of goods and services shall be submitted with the application, broken down into classes, in the order of the international classification of goods and services.

Section 121

Fees

(1) If the international registration is to be effected in accordance with the Madrid Agreement and in accordance with the Protocol Relating to the Madrid Agreement on the basis of a

trade mark entered in the Register, and if the application for international registration has been lodged prior to the entry of the trade mark in the Register, the national fee in accordance with the Patent Costs Act for the international registration shall become due on the date of registration.

(2) The national fee in accordance with the Patent Costs Act for the international registration shall be payable within one month after it becomes due, this date being determined in accordance with section 3 (1) of the Patent Costs Act or in accordance with subsection (1).

Section 122

Note in the files, entry in the Register

(1) If the international registration has been effected on the basis of a trade mark for which an application has been made for entry in the Register, the date and the number of the international registration shall be noted in the files of the trade mark applied for.

(2) The date and the number of the international registration which has been effected on the basis of a trade mark that has been entered in the Register shall be entered in the Register. The first sentence shall also apply if the international registration was effected on the basis of a trade mark for which an application has been made for entry in the Register and the application for registration has been effected.

Section 123

Subsequent extension of protection

(1) The request for subsequent extension of protection of an international registration in accordance with Article 3ter paragraph 2 of the Protocol Relating to the Madrid Agreement may be lodged with the German Patent and Trade Mark Office. If the subsequent extension of protection is to be effected on the basis of a trade mark entered in the Register, and if the request is already lodged prior to the registration of the trade mark, it shall be deemed to have been received on the date of registration.

(2) Subsequent extension of protection on the basis of a trade mark entered in the Register may be effected both in accordance with the Madrid Agreement and in accordance with the Protocol Relating to the Madrid Agreement.

(3) The national fee in accordance with the Patent Costs Act for the subsequent extension of protection shall be payable within one month after becoming due (section 3 (1) of the Patent Costs Act).

Section 124

Application, mutatis mutandis, of the provisions on the effect of international registrations under the Madrid Agreement

Sections 112 to 117 shall apply mutatis mutandis to international registrations whose protection has been extended to the territory of the Federal Republic of Germany in accordance with Article 3ter of the Protocol Relating to the Madrid Agreement with the proviso that the place of the provisions of the Madrid Agreement listed in sections 112 to 117 shall be taken by the corresponding provisions of the Protocol Relating to the Madrid Agreement.

Section 125

Transformation of an international registration

(1) If a request is lodged with the German Patent and Trade Mark Office in accordance with Article 9quinquies of the Protocol Relating to the Madrid Agreement for transformation of a trade mark that has been cancelled in the International Register in accordance with Article 6 paragraph 4 of the Protocol Relating to the Madrid Agreement, and if the request is received by the German Patent and Trade Mark Office with the necessary indications prior to expiry of a three-month time limit after the date of the cancellation of the trade mark in the International Register, the date of the international registration of this trade mark in accordance with Article 3 paragraph 4 of the Protocol Relating to the Madrid Agreement or the date of the registration of the extension of protection in accordance with Article 3ter

paragraph 2 of the Protocol Relating to the Madrid Agreement, where appropriate with the priority claimed for the international registration, shall be relevant for the purposes of establishing seniority within the meaning of section 6 (2).

(2) The person making the request shall submit a certificate from the International Bureau of the World Intellectual Property Organization designating the trade mark and the goods or services for which the protection of the international registration extended to the Federal Republic of Germany prior to its cancellation in the International Register.

(3) The person making the request shall furthermore submit a German translation of the list of goods or services for which the registration is requested.

(4) In other respects, the request for transformation shall be treated in the same way as an application to register a trade mark. If, however, on the date of the cancellation of the trade mark in the International Register the time limit in accordance with Article 5 paragraph 2 of the Protocol Relating to the Madrid Agreement to refuse protection had already expired, and if no proceedings were pending on this day to refuse protection or for subsequent withdrawal of protection, the trade mark shall be directly entered in the Register in accordance with section 41 (1) with no prior examination. No opposition may be lodged against the registration of a trade mark in accordance with the second sentence.

Chapter 3 Community trade marks

Section 125a

Filing of Community trade marks with the German Patent and Trade Mark Office

Where applications for a Community trade mark are filed with the German Patent and Trade Mark Office in accordance with Article 25 paragraph 1 (b) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (codified version) (OJ L 78 p. 1), the German Patent and Trade Mark Office shall make a note on the application of the date of receipt and shall forward the application, without examination and without delay, to the Office for Harmonization in the Internal Market (Trade Marks and Designs).

Section 125b

Application of the provisions of this Act

The provisions of this Act shall apply to trade marks which have been filed or registered in accordance with the Regulation on the Community trade mark in the following cases:

1. For the application of section 9 (relative grounds for refusal), earlier Community trade marks filed or registered shall be deemed equivalent to the earlier trade marks filed or registered in accordance with this Act, but with the proviso that having a reputation in Germany in accordance with section 9 (1) no. 3 shall be replaced with having a reputation in the Community in accordance with Article 9 paragraph 1, second sentence, (c) of the Regulation on the Community trade mark.
2. In addition to the rights in accordance with Articles 9 to 11 of the Regulation on the Community trade mark, the proprietor of a registered Community trade mark shall be entitled to the same rights to compensation (section 14 (6) and (7)), destruction and recall (section 18), information (section 19), production and inspection (section 19a), securing of compensation claims (section 19b) and publication of judgments (section 19c) as the proprietor of a trade mark registered in accordance with this Act.
3. If rights from a registered Community trade mark are asserted against the use of a later trade mark registered in accordance with this Act, section 21 (1) (forfeiting) shall apply *mutatis mutandis*.
4. If an opposition to the registration of a trade mark (section 42) is based on an earlier registered Community trade mark, section 43 (1) (making a plausible case for use) shall apply *mutatis mutandis* with the proviso that the use of the earlier Community trade

mark in accordance with Article 15 of the Regulation on the Community trade mark shall take the place of the use of the earlier trade mark in accordance with section 26.

5. If a request to cancel the registration of a trade mark (section 51 (1)) is based on an earlier registered Community trade mark,

- a) section 51 (2), first sentence, (forfeiting) shall apply mutatis mutandis;
- b) section 55 (3) (documentation of use) shall apply mutatis mutandis with the proviso that the use of the Community trade mark in accordance with Article 15 of the Regulation on the Community trade mark shall take the place of the use of the earlier trade mark in accordance with section 26.

6. Requests for seizure on import and export may be lodged by proprietors of registered Community trade marks in the same manner as by proprietors of trade marks registered in accordance with this Act. Sections 146 to 149 shall apply mutatis mutandis.

Section 125c

Subsequent determination of the invalidity (Ungültigkeit) of a trade mark

(1) If the seniority of a trade mark that has been entered in the Register of the German Patent and Trade Mark Office has been claimed for a Community trade mark which has been filed or registered in accordance with Article 34 or 35 of the Regulation on the Community trade mark, and if the trade mark that has been entered in the Register of the German Patent and Trade Mark Office has been cancelled for non-renewal of the duration of protection in accordance with section 47 (6) or because of surrender in accordance with section 48 (1), on request the invalidity (Ungültigkeit) of this trade mark may be subsequently found for revocation or because of invalidity.

(2) The finding of invalidity (Ungültigkeit) shall take place subject to the same prerequisites as cancellation for revocation or because of invalidity. However, the invalidity (Ungültigkeit) of a trade mark for revocation in accordance with section 49 (1) may only be found if the prerequisites for cancellation in accordance with this provision also already applied at the time when the trade mark was cancelled because of non-renewal of the duration of protection or because of surrender.

(3) The proceedings for a finding of invalidity (Ungültigkeit) shall be in accordance with the provisions applicable to the proceedings for the cancellation of a registered trade mark, with the proviso that the place of the cancellation of the registration of the trade mark shall be taken by the finding of its invalidity (Ungültigkeit).

Section 125d

Conversion of Community trade marks

(1) If a request for conversion of a Community trade mark applied for or registered has been transmitted to the German Patent and Trade Mark Office in accordance with Article 109 paragraph 3 of the Regulation on the Community trade mark, the fee and the class fees in accordance with the Patent Costs Act for the conversion proceedings shall become due on receipt of the request for conversion by the German Patent and Trade Mark Office.

(2) If the conversion request relates to a trade mark which was not yet registered as a Community trade mark, the conversion request shall be treated in the same way as the application for entry of a trade mark in the Register of the German Patent and Trade Mark Office, with the proviso that the date of filing of the Community trade mark within the meaning of Article 27 of the Regulation on the Community trade mark or the date of a priority claimed for the Community trade mark shall take the place of the date of filing within the meaning of section 33 (1). If the seniority of a trade mark which has been entered in the Register of the German Patent and Trade Mark Office had been claimed for the application for the Community trade mark in accordance with Article 34 of the Regulation on the Community trade mark, this seniority shall take the place of the date that is relevant in accordance with the first sentence.

- (3) If the conversion request relates to a trade mark which was already registered as a Community trade mark, the German Patent and Trade Mark Office shall directly enter the trade mark in the Register with no further examination in accordance with section 41 (1), retaining its original seniority. No opposition may be lodged against the registration.
- (4) In other respects, the provisions of this Act for the application of trade marks shall apply to conversion requests.

Section 125e

Community trade mark courts, Community trade mark disputes

- (1) The regional courts shall have exclusive jurisdiction as Community trade mark courts of first instance for all actions for which, in accordance with the Regulation on the Community trade mark, the Community trade mark courts have jurisdiction within the meaning of Article 91 paragraph 1 of the Regulation (Community trade mark litigation), irrespective of the value in dispute.
- (2) The Community trade mark court of second instance shall be the higher regional court (Oberlandesgericht) in whose district the Community trade mark court of first instance has its seat.
- (3) The Land (federal state) governments shall be authorised to assign, by statutory instrument, Community trade mark litigation cases for the districts of more than one Community trade mark court to one such court. The Land governments may delegate this authorisation to the Land departments of justice by statutory instrument.
- (4) The Länder may, by agreement, delegate duties incumbent upon the Community trade mark courts of one Land to the competent Community trade mark court of another Land, in whole or in part.
- (5) Section 140 (3) and section 142 shall apply mutatis mutandis to proceedings before the Community trade mark courts.

Section 125f

Communication to the European Commission

The Federal Ministry of Justice and Consumer Protection shall communicate to the Commission of the European Communities the Community trade mark courts of first and second instance as well as any change in the number, name or territorial jurisdiction of the Community trade mark courts of first and second instance.

Section 125g

Territorial jurisdiction of the Community trade mark courts

Where, in accordance with Article 93 of the Regulation on the Community trade mark, German Community trade mark courts have international jurisdiction, those provisions shall apply mutatis mutandis to the territorial jurisdiction of these courts which would be applicable if the application was an application for a trade mark filed with the German Patent and Trade Mark Office or the trade mark was a trade mark registered in the Register of the German Patent and Trade Mark Office. Where jurisdiction is not established on this basis, then the court shall have territorial jurisdiction with which the claimant has his general venue.

Section 125h

Insolvency proceedings

- (1) If the insolvency court is aware that a Community trade mark applied for or registered is part of the insolvency estate, it shall request the Office for Harmonization in the Internal Market (Trade Marks and Designs) in the direct course of trade to register
1. the opening of the proceedings and, unless already contained therein, the order of a restriction on property transfers;
 2. the release or the sale of the Community trade mark or of the application for the Community trade mark;
 3. the final discontinuation of the proceedings; and

4. the stay on the proceedings, in the case of the supervision of the debtor however only after termination of this supervision, and of a restriction on property transfers

in the Register of Community trade marks or, if it is an application, in the files of the application.

(2) The entry in the Register of Community trade marks or in the application files may also be requested by the insolvency administrator. In the case of debtor's personal management (section 270 of the Insolvency Statute), the insolvency custodian shall take the place of the insolvency administrator.

Section 125i Order for enforcement

The Federal Patent Court shall have jurisdiction to issue the order for enforcement in accordance with Article 82 paragraph 2, second sentence, of the Regulation on the Community trade mark. The enforceable execution copy shall be issued by the registry clerk at the registry of the Federal Patent Court.

Part 6 Indications of geographical origin

Chapter 1 Protection of indications of geographical origin

Section 126

Names, indications or signs protected as indications of geographical origin

(1) Indications of geographical origin within the meaning of this Act shall be the names of places, areas, territories or countries as well as other indications or signs which are used in trade to identify the geographical origin of goods or services.

(2) Names, indications or signs within the meaning of subsection (1) which are generic names shall not be eligible for protection as indications of geographical origin. Designations shall be regarded as generic names which contain an indication of the geographical origin within the meaning of subsection (1) or are derived from such an indication, but which have lost their original significance and serve as the name of goods or services or as designations or indications of the nature, quality, variety or other properties or characteristics of goods or services.

Section 127

Scope of protection

(1) Indications of geographical origin may not be used in trade for goods or services which do not originate from the place, area, territory or country which is designated by the indication of geographical origin if it is likely to mislead concerning the geographical origin if such names, indications or signs for goods or services of different origin are used.

(2) If the goods or services marked by an indication of geographical origin have special properties or a special quality, the indication of geographical origin may only be used in trade for the corresponding goods or services of this origin if the goods or services have these properties or this quality.

(3) If an indication of geographical origin enjoys a particular reputation, it may not be used in trade for goods or services of a different origin even if it is not likely to mislead concerning the geographical origin if use provides without good cause an opportunity for goods or services of a different origin to take unfair advantage of or be detrimental to the reputation of the indication of geographical origin or its distinctive character.

(4) The above subsections shall also apply if names, indications or signs are used which are similar to the protected indication of geographical origin or if the indication of geographical origin is used with additions in so far as

1. in cases falling under subsection (1), despite the deviation or the additions, it is likely to mislead concerning the geographical origin; or
2. in cases falling under subsection (3), despite the deviation or the additions, it is suitable to take unfair advantage of or be detrimental to the reputation or the distinctive character of the indication of geographical origin.

Section 128

Rights because of infringement

- (1) Any person who, in trade, uses names, indications or signs contrary to section 127 may be sued by persons with an entitlement in accordance with section 8 (3) of the Act Against Unfair Competition to claim rights for an injunction in the event of the risk of recurrent infringement. The right may also be asserted in the event of the risk of an infringement. Sections 18, 19, 19a and 19c shall apply mutatis mutandis.
- (2) Any person intentionally or negligently acting contrary to section 127 shall be liable to pay compensation to the entitled party of the indication of geographical origin for the damage incurred by the infringement. In assessing the compensation, consideration may also be given to the profit which the infringer has obtained by infringing the right. Section 19b shall apply mutatis mutandis.
- (3) Section 14 (7) and section 19d shall apply mutatis mutandis.

Section 129

Lapse

Rights in accordance with section 128 shall lapse in accordance with section 20.

Chapter 2

Protection of geographical indications and designations of origin in accordance with Regulation (EU) No 1151/2012

Section 130

Proceedings before the German Patent and Trade Mark Office; national opposition proceedings

- (1) Applications for the registration of a geographical indication or of a designation of origin in the Register of protected designations of origin and of protected geographical indications which is maintained by the European Commission in accordance with Article 11 of the Regulation (EU) No 1151/2012 of the European Parliament and the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs (OJ L 343 of 14 December 2012, p. 1) in its respectively applicable version, shall be filed with the German Patent and Trade Mark Office.
- (2) The Trade Mark Divisions established at the German Patent and Trade Mark Office shall have competence for the proceedings as regulated in this Chapter.
- (3) When examining the application, the German Patent and Trade Mark Office shall ask for the opinions of the Federal Ministry of Food and Agriculture, of the competent specialist ministries of the Länder in question, of the interested public corporations as well as those of the interested associations and industry organisations.
- (4) The German Patent and Trade Mark Office shall publish the application. An opposition may be lodged with the German Patent and Trade Mark Office against the application within two months of publication by any person with a legitimate interest who is based or resides in the territory of the Federal Republic of Germany.
- (5) If the application meets the requirements of Regulation (EU) No 1151/2012 and complies with the provisions issued for its implementation, the German Patent and Trade Mark Office shall find this by decision. Otherwise, the application shall be refused by decision. The German Patent and Trade Mark Office shall publish the favourable decision. Should there be major alterations to the indications published in accordance with subsection (4), these shall be published together with the granting decision. The decision in accordance with the first

sentence and in accordance with the second sentence shall be served on the applicant and on those who lodged oppositions by the time limit.

(6) If it is found with legal force that the application complies with the requirements of Regulation (EU) No 1151/2012 and of the provisions issued for its implementation, the German Patent and Trade Mark Office shall inform the applicant hereof and shall transmit the application to the Federal Ministry of Justice and Consumer Protection with the necessary documents. Further, the German Patent and Trade Mark Office shall publish the version of the specification to which the positive decision refers. The Federal Ministry of Justice and Consumer Protection shall transmit the application to the European Commission with the necessary documents.

(7) If the specification has been amended during the registration procedure at the European Commission, the German Patent and Trade Mark Office shall publish the version of the specification on which the registration is based.

Section 131

Intergovernmental opposition procedure

(1) Notices of opposition in accordance with Article 51 (1) subparagraph 2 of Regulation (EU) No 1151/2012 against the intended entry of geographical indications or designations of origin in the Register kept by the European Commission of the protected designations of origin and of the protected geographical indications shall be lodged with the German Patent and Trade Mark Office within two months from the publication, which is effected in the Official Journal of the European Union in accordance with Article 50 (2) of Regulation (EU) No 1151/2012.

(2) The payment time limit for the opposition fee shall be determined in accordance with section 6 (1), first sentence, of the Patent Costs Act. There shall be no re-establishment of rights of the opposition time limit or of the time limit for payment of the opposition fee.

Section 132

Request for a change to the specification, cancellation proceedings

(1) Sections 130 and 131 shall apply mutatis mutandis to requests to change the specification of a protected geographical indication or of a protected designation of origin in accordance with Article 53 (2), first sentence, of Regulation (EU) No 1151/2012.

(2) Sections 130 and 131 shall apply mutatis mutandis to requests for the cancellation of a protected geographical indication or of a protected designation of origin in accordance with Article 54 (1) of Regulation (EU) No 1151/2012.

Section 133

Appellate remedies

The appeal to the Federal Patent Court and the appeal on points of law to the Federal Court of Justice shall be available against decisions taken by the German Patent and Trade Mark Office in accordance with the provisions contained in this Chapter. Those persons who have lodged an opposition against the application in due time or whose legitimate interest is affected by the granting decision on the basis of the altered indications published in accordance with section 130 (5), fourth sentence, shall be entitled to lodge an appeal against a decision in accordance with section 130 (5), first sentence. In other respects, the provisions of this Act on the appeal proceedings before the Federal Patent Court (sections 66 to 82) and on proceedings on the appeal on points of law before the Federal Court of Justice (sections 83 to 90) shall apply mutatis mutandis.

Section 134

Supervision

(1) The monitoring and controls required in accordance with Regulation (EU) No 1151/2012 and the provisions issued for its implementation shall be incumbent on the agencies competent in accordance with Land law.

(2) In so far as is necessary for supervision and verification within the meaning of subsection (1), the commissioners of the competent agencies may with operations marketing or

producing agricultural products or foodstuffs (section 3 no. 1 and 2 of the Food and Feed Code [Lebensmittel- und Futtermittelgesetzbuch]) or transferring, importing or exporting them within the European Union, during opening or operating hours

1. enter business premises and land, sales facilities and means of transport and carry out inspections there;
2. take samples in return for a receipt; at the request of the party, a part of the sample or, if it is indivisible, a second sample shall be left behind officially closed and sealed;
3. inspect and examine business documents;
4. request information.

These powers shall also cover agricultural products or foodstuffs which are put on the market in public places, in particular in markets, places and streets or by peddling.

(3) The proprietors or managers of the establishments shall be obliged to permit entry to the business premises and land, sales facilities and means of transport as well as the inspections to be carried out there, to present the agricultural products or foodstuffs to be inspected themselves or through others such that the inspection can be carried out properly, to provide the necessary assistance in inspections themselves or through others, to have the samples taken, to submit and have examined the corporate documents, and to provide the information.

(4) If the supervision takes place on import or export, subsections (2) and (3) shall apply *mutatis mutandis* also to the party who transfers, imports or exports the agricultural products or foodstuffs for the proprietor of the establishment within the EU.

(5) The party obliged to provide information may refuse to provide the information with regard to those questions whose answering would expose him or a relative designated in section 383 (1) no. 1 to 3 of the Code of Civil Procedure to the risk of criminal prosecution or of proceedings in accordance with the Act on Regulatory Offences.

(6) Cost-covering fees and expenses shall be charged for official acts which are to be carried out in accordance with Article 37 (1) of Regulation (EU) No 1151/2012 for the purposes of verification. The elements subject to a fee shall be determined by Land law.

Section 135

Rights because of infringement

(1) Any person who carries out acts in trade contrary to Article 13 of Regulation (EU) No 1151/2012 may be claimed against by the party entitled to assert rights in accordance with section 8 (3) of the Act Against Unfair Competition for an injunction if there is a risk of recurrence. This right may also be asserted in the event of the risk of a first-time infringement. Sections 18, 19, 19a and 19c shall apply *mutatis mutandis*.

(2) Section 128 (2) and (3) shall apply *mutatis mutandis*.

Section 136

Lapse

The rights in accordance with section 135 shall lapse in accordance with section 20.

Chapter 3

Authorisation to issue statutory instruments

Section 137

More detailed provisions on the protection of individual indications of geographical origin

(1) The Federal Ministry of Justice and Consumer Protection is herewith authorised to make more detailed provisions, in agreement with the Federal Ministry for Economic Affairs and Energy and the Federal Ministry of Food and Agriculture, by statutory instrument with the consent of the Bundesrat on individual indications of geographical origin.

(2) The statutory instrument can regulate

1. by referring to political or geographical borders, the region of origin;
2. the quality or other properties within the meaning of section 127 (2) as well as the circumstances relevant thereto, such as in particular the procedure or the nature of the manufacture or production of the goods or of the provision of the services or quality or other properties of the basic material used such as their origin; and
3. the nature of the use of the indication of geographical origin.

The previous fair practices, habits and customs in the use of the indication of geographical origin shall be taken into consideration when preparing regulations.

Section 138

Other provisions for the proceedings in applications and oppositions in accordance with Regulation (EU) No 1151/2012

(1) The Federal Ministry of Justice and Consumer Protection is herewith authorised to make more detailed provisions regarding the application, opposition, amendment and cancellation proceedings (sections 130 to 132) by statutory instrument not requiring the consent of the Bundesrat.

(2) The Federal Ministry of Justice and Consumer Protection may, by statutory instrument not requiring the consent of the Bundesrat, delegate the authorisation to the German Patent and Trade Mark Office, in whole or in part, to issue statutory instruments in accordance with subsection (1).

Section 139

Provisions transposing Regulation (EU) No 1151/2012; authorisation to issue statutory instruments

(1) The Federal Ministry of Justice and Consumer Protection is herewith authorised in agreement with the Federal Ministry for Economic Affairs and Energy and the Federal Ministry of Food and Agriculture by statutory instrument with the consent of the Bundesrat to regulate further details of the protection of designations of origin and geographical indications in accordance with Regulation (EU) No 1151/2012 in so far as the requirement therefor emerges from Regulation (EU) No 1151/2012 or from the provisions issued by the Council or the European Commission for its implementation. In particular, provisions relating to

1. the marking of agricultural products or foodstuffs,
2. the entitlement to use the protected designations, or
3. the prerequisites and the procedure in supervision or inspection in intra-Community transfer or in import and export

may be issued in statutory instruments in accordance with the first sentence. Statutory instruments in accordance with the first sentence may also be issued if the Member States are authorised in accordance with the provisions of Community law listed therein to issue supplementary provisions.

(2) The Land governments are herewith authorised by statutory instrument to assign the performance of the inspections necessary in accordance with Article 37 (1) of Regulation (EU) No 1151/2012 to approved private inspection agencies or to involve such agencies in the performance of these inspections. The Land governments may also regulate the prerequisites and the procedure for the approval of private inspection agencies by statutory instrument. They shall be authorised to assign the authorisation in accordance with the first and second sentences by statutory instrument to other authorities in whole or in part.

Part 7

Sign litigation proceedings

Section 140
Sign litigation

(1) The regional courts shall have exclusive jurisdiction, irrespective of the value in dispute, over all actions in which a claim from one of the legal relationships regulated under this Act is asserted (disputes on signs).

(2) The Land governments shall be authorised to assign, by statutory instrument, disputes on signs in whole or in part for the districts of more than one regional court to one such regional court in so far as this serves the factual advancement or more rapid conclusion of the proceedings. The Land governments may delegate this authorisation to the Land departments of justice. In addition, the Länder may, by agreement delegate duties incumbent upon the courts of one Land to the competent court of another Land, in whole or in part.

(3) In respect of the costs arising from the participation of a patent attorney in a dispute on a sign, fees pursuant to section 13 of the Act on the Remuneration of Lawyers as well as the necessary expenses of the patent attorney shall be reimbursed.

Section 141
Place of jurisdiction for claims under this Act and under the Act Against Unfair Competition

Claims in respect of legal relationships which are regulated under this Act and which are also based on the provisions of the Act Against Unfair Competition shall not require to be asserted at the court venue referred to in section 14 of the Act Against Unfair Competition.

Section 142
Reduction of the value in dispute

(1) Where a party substantiates in civil litigation in which by means of an action a claim is asserted from one of the legal relationships regulated in this that the burden of the costs of the proceedings based on the full value in dispute would pose a substantial risk to his economic situation, the court may, upon motion by that party, order that such party's obligation to pay court costs shall be proportionate to a part of the value in dispute as adjusted to his economic situation.

(2) The order in accordance with subsection (1) shall have the effect that the beneficiary shall also have to pay the fees of his lawyer only in relation to this part of the value in dispute. In so far as the costs of the proceedings are imposed on such party or the latter assumes these costs, the party shall reimburse the court costs paid by the opposing party and the fees of his lawyer only in relation to the part of the value in dispute. Where the extra-judicial costs are imposed on the opposing party or are assumed by that party, the beneficiary's lawyer may recover his fees from the opposing party in relation to such value in dispute as applies to the latter.

(3) The motion in accordance with subsection (1) may be declared before and recorded with the court registry. It shall be made before the court hearing on the merits. Thereafter, it shall be admissible only where the court subsequently increases the presumed or assessed value in dispute. The opposing party shall be heard before a decision is taken on the motion.

Part 8
Criminal and regulatory fine regulations, seizure on import and export

Chapter 1
Criminal and regulatory fine regulations

Section 143
Punishable infringement of signs

(1) Any person who, in trade, unlawfully

1. uses a sign contrary to section 14 (2) no. 1 or 2;

2. uses a sign contrary to section 14 (2) no. 3 with the intention of taking advantage of or impairing the distinctive character or the repute of a trade mark which has a reputation;
3. affixes a sign contrary to section 14 (4) no. 1 or offers, puts on the market, stocks, imports or exports contrary to section 14 (4) no. 2 or 3 a wrapping or packaging or a means of identification, in so far as to third parties the use of the sign
 - a) would be prohibited in accordance with section 14 (2) no. 1 or 2; or
 - b) would be prohibited to third parties in accordance with section 14 (2) no. 3 and the act is carried out with the intention of facilitating the taking advantage of or impairment of the distinctive character or the repute of a trade mark which has a reputation;
4. uses a designation or a sign contrary to section 15 (2); or
5. uses a designation or a sign contrary to section 15 (3) with the intention of exploiting or impairing the distinctive character or the repute of a commercial designation which has a reputation

shall be liable to imprisonment of up to three years or a fine.

(1a) (repealed)

(2) If the offender acts on a commercial basis or as a member of a gang formed for the purpose of the continued commission of such offences in cases coming under subsection (1), the penalty shall be imprisonment for between three months to five years.

(3) An attempt shall be punishable.

(4) In the cases referred to in subsection (1), the offence shall be prosecuted upon motion only, unless the criminal prosecution authorities consider ex officio intervention imperative on account of the particular public interest in criminal prosecution.

(5) Objects to which the criminal offence relates may be confiscated. Section 74a of the Criminal Code (Strafgesetzbuch) shall apply. Where the claims to destruction referred to in section 18 are upheld in proceedings pursuant to the provisions of the Code of Criminal Procedure governing compensation for the aggrieved person (sections 403 to 406c of the Code of Criminal Procedure), the provisions on confiscation (sections 74 to 74f of the Code of Criminal Procedure) shall not apply.

(6) Where a penalty is imposed, an order shall be made upon motion by the aggrieved party and upon demonstration of a legitimate interest to the effect that the conviction be made public upon demand. The nature of the publication shall be laid down in the judgment.

(7) (repealed)

Section 143a

Punishable infringement of a Community trade mark

(1) Any person who infringes the rights of the proprietor of a Community trade mark in accordance with Article 9 paragraph 1, second sentence, of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (codification) (OJ L 78 p. 1) by

1. using a sign that is identical to the Community trade mark for goods or services which are identical to those in respect of which it is registered;
2. using a sign if, because of the identity or similarity of the sign to the Community trade mark and the identity or similarity of the goods or services covered by the Community trade mark and the sign, there is a likelihood of confusion for the public, including the likelihood of association with the trade mark; or
3. using a sign which is identical with or similar to the Community trade mark for goods or services which are not similar to those for which the Community trade mark is registered if the latter has a reputation in the Community and the sign is used with the

intention without good cause to take unfair advantage of or be detrimental to the distinctive character or the repute of the Community trade mark

despite a prohibition and without the consent of the trade mark proprietor in trade, shall be liable to imprisonment of up to three years or a fine.

(2) Section 143 (2) to (6) shall apply mutatis mutandis.

Section 144

Punishable use of indications of geographical origin

(1) Any person who, in trade, unlawfully uses an indication of geographical origin, a name, an indication or a sign

1. contrary to section 127 (1) or (2), in each case also in conjunction with subsection (4), or of a statutory instrument in accordance with section 137 (1); or

2. contrary to section 127 (3), also in conjunction with subsection (4), or of a statutory instrument in accordance with section 137 (1), with the intention to exploit or impair the reputation or distinctive character of an indication of geographical origin

shall be liable to imprisonment of up to two years or a fine.

(2) The same punishment shall be imposed on any person who, contrary to Article 13 (1) (a) or (b) of Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs (OJ L 343 of 14 December 2012, p. 1) in trade

1. uses a registered name for a product listed therein, or

2. adopts or imitates a registered name.

(3) An attempt shall be punishable.

(4) In the case of a conviction, the court shall find that the unlawful marking of articles in the possession of the convict shall be removed or, if this is not possible, the articles shall be destroyed.

(5) Where a penalty is imposed, and if necessary in the public interest, an order shall be made to the effect that the conviction be made public. The nature of the publication shall be laid down in the judgment.

(6) (repealed)

Section 145

Provisions relating to regulatory fines

(1) Any person shall be deemed to have committed a regulatory offence who, in trade, unlawfully uses in an identical or imitated form

1. a coat of arms, a flag or other state symbol or a coat of arms of a domestic locality or of a domestic municipal or local authority association within the meaning of section 8 (2) no. 6;

2. an official sign or hallmark indicating control or warranty within the meaning of section 8 (2) no. 7; or

3. a sign, a seal or a designation within the meaning of section 8 (2) no. 8

to mark goods or services.

(2) Any person shall be deemed to have committed a regulatory offence who intentionally or negligently

1. contrary to section 134 (3), also in conjunction with subsection (4);

a) refuses to permit entry to business premises, land, sales facilities or means of transport or their inspection;

- b) does not present the agricultural products or foodstuffs to be inspected in such a way that the inspection can be carried out properly;
 - c) does not provide the necessary assistance in the inspection;
 - d) does not permit samples to be taken;
 - e) does not submit corporate documents, or not in their entirety, or does not permit them to be examined; or
 - f) does not provide information, or does not do so correctly, or not completely; or
2. acts contrary to a statutory instrument in accordance with section 139 (1) in so far as it refers to this provision on regulatory fines for a specific circumstance.
- (3) The regulatory offence may be sanctioned in cases falling under subsection (1) with a regulatory fine of up to two thousand and five hundred Euros, and in cases falling under subsection (2) with a regulatory fine of up to ten thousand Euros.
- (4) Section 144 (4) shall apply mutatis mutandis in cases falling under subsection (1).
- (5) The administrative authority within the meaning of section 36 (1) no. 1 of the Act on Regulatory Offences shall be the Federal Office of Justice in cases falling under subsection (1).

Chapter 2

Seizure of goods on import and export

Section 146

Seizure in case of infringements of rights to signs

- (1) Goods which are unlawfully affixed with a trade mark or commercial designation protected in accordance with this Act shall, in so far as there is no requirement to apply Regulation (EU) No 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights and repealing Council Regulation (EC) No 1383/2003 (OJ L 181 of 29 June 2013, p. 15), as amended, shall be subject, on request and in return for a security of the proprietor of the right, to seizure by the customs authority on their import or export in so far as the infringement of rights is manifest. This shall apply to transactions with other Member States of the European Union and with the Contracting Parties to the Agreement on the European Economic Area only to the extent that controls are carried out by the customs authorities.
- (2) Where the customs authority orders seizure, it shall without delay inform the person entitled to exercise the control and the person making the request. The origin, quantity and place of storage of the goods as well as of name and address of the person entitled to exercise the control shall be communicated to the person making the request. The privacy of correspondence and posts (Article 10 of the Basic Law) shall thus be restricted. The person making the request shall be given the opportunity to inspect the goods provided that this does not interfere with business or trade secrets.

Section 147

Confiscation, opposition, suspension of seizure

- (1) Where no objection is lodged in respect of the seizure before the expiry of a period of two weeks following service of the communication in accordance with section 146 (2), first sentence, at the latest, the customs authority shall order confiscation of the seized goods.
- (2) Where the person entitled to exercise the control objects to the seizure, the customs authority shall inform the person making the request without delay. The latter shall declare to the customs authority without delay whether he upholds the request in accordance with section 146 (1) in respect of the seized goods.
- (3) Where the person making the request withdraws his request, the customs authority shall revoke the seizure without delay. Where the person making the request upholds his request

and submits an enforceable court decision ordering the impounding of the seized goods or imposing a restriction on the control, the customs authority shall take the necessary measures.

(4) Where the cases referred to in subsection (3) do not apply, the customs authority shall revoke the seizure after the expiry of a period of two weeks following service of the communication to the person making the request in accordance with subsection (2). Where the person making the request proves that he has requested, but not yet received, a court decision in accordance with subsection (3), second sentence, the seizure shall remain in force for a maximum of a further two weeks.

Section 148

Competences, appellate remedies

(1) The request in accordance with section 146 (1) shall be made to the Central Customs Authority (Generalzolldirektion) and shall remain in force for one year unless the request has been made for a shorter duration. The request may be repeated.

(2) The person making the request shall be charged with the costs of official acts connected with the request subject to section 178 of the Fiscal Code.

(3) Seizure and confiscation may be contested using the appellate remedies admissible in respect of seizure and confiscation in regulatory fining proceedings in accordance with the Act on Regulatory Offences. The person making the request shall be heard in appeal proceedings. An immediate appeal may be filed from a local court (Amtsgericht) decision. The higher regional court shall decide on the immediate appeal.

Section 149

Compensation in case of unjustified seizure

Where the seizure proves to have been unjustified as from the outset and the person making the request has upheld the request in accordance with section 146 (1) in respect of the seized goods or did not without delay make a declaration (section 147 (2), second sentence), he shall be obliged to compensate the person entitled to exercise the control for the damage caused by the seizure.

Section 150

Proceedings in accordance with Regulation (EU) No 608/2013

For the proceedings in accordance with Regulation (EU) No 608/2013, section 148 (1) and (2) as well as section 149 shall apply mutatis mutandis, unless the Regulation contains any provisions which preclude this.

Section 151

Proceedings in accordance with German law with regard to indications of geographical origin

(1) Goods which have been unlawfully affixed with an indication of geographical origin protected in accordance with this Act or in accordance with legal provisions of the European Union, shall, unless Regulation (EU) No 608/2013 applies, be subject to seizure on their import, export or transit for the purpose of eliminating the unlawful marking in so far as the infringement of rights is manifest. This shall apply to transactions with other Member States of the European Union and with the Contracting Parties to the Agreement on the European Economic Area only to the extent that controls are carried out by the customs authorities.

(2) The seizure shall be carried out by the customs authority. The customs authority shall also order the measures necessary to eliminate the unlawful marking.

(3) If the orders of the customs authority are not complied with, or if the elimination is impracticable, the customs authority shall order the confiscation of the goods.

(4) Seizure and confiscation may be contested using the appellate remedies admissible in respect of seizure and confiscation in regulatory fining proceedings in accordance with the Act on Regulatory Offences. An immediate appeal may be filed from a local court decision. The higher regional court shall decide on the immediate appeal.

Part 9
Transitional provisions

Section 152
Application of this Act

Unless provided otherwise below, the provisions of this Act shall also apply to trade marks which were filed or registered prior to 1 January 1995 or which were acquired through use in trade or by being well known, and to commercial designations which were protected prior to 1 January 1995 in accordance with the provisions applicable until then.

Section 153

Restrictions for the assertion of infringement claims

(1) If the proprietor of a trade mark registered prior to 1 January 1995 or acquired through use or by being well known, or of a commercial designation in accordance with the provisions applicable until then, did not have any rights because of infringement against the use of the trade mark, of the commercial designation or of an identical sign, the rights from the trade mark or from the commercial designation in accordance with this Act may not be asserted against the further use of this trade mark, this commercial designation or this sign.

(2) Section 21 shall apply to rights of the proprietor of a trade mark registered prior to 1 January 1995 or acquired through use or by being well known or of a commercial designation with the proviso that the five-year time limit provided for in section 21 (1) and (2) shall commence to run on 1 January 1995.

Section 154

Rights in rem, levy of execution, bankruptcy proceedings

(1) If, prior to 1 January 1995, a right in rem was established in the right conferred by the application for or registration of a trade mark, or if the right given rise to by the application or registration has been the subject-matter of measures of levy of execution, these rights or measures may be entered in the Register in accordance with section 29 (2).

(2) Subsection (1) shall apply mutatis mutandis if the right given rise to through the application for or registration of a trade mark has been covered by bankruptcy proceedings.

Section 155

Licences

Section 30 shall apply to licences granted prior to 1 January 1995 under the right given rise to by the application for or registration of a trade mark, or by its use or by virtue of it being well known, with the proviso that these licences shall only benefit from the effect of section 30 (5) in so far as they are transfers of rights which took effect on 1 January 1995 or later or licences granted to third parties on 1 January 1995 or later.

Section 156

Cancellation of a registered trade mark because of absolute grounds for refusal

If proceedings were initiated ex officio prior to 1 January 1995 to cancel the registration of a trade mark because of the existence of absolute grounds for refusal in accordance with section 10 (2) no. 2 of the former Trade Mark Act, or if prior to this point in time a request for cancellation was lodged in accordance with this provision, the registration shall only be cancelled if the trade mark is eligible for protection neither in accordance with the provisions previously applicable, nor in accordance with the provisions of this Act. This shall also apply if proceedings in accordance with section 54 are initiated after 1 January 1995 to cancel the registration of a trade mark which was registered prior to 1 January 1995.

Section 157

Cancellation of a registered trade mark because of the existence of earlier rights

(1) If an action to cancel the registration of a trade mark was lodged prior to 1 January 1995 on the basis of an earlier trade mark applied for in accordance with section 11 (1) no. 1 of the former Trade Mark Act or on the basis of another earlier right, the registration shall only

be cancelled if the action is to be granted both in accordance with the provisions applicable previously, and in accordance with the provisions of this Act, unless provided otherwise in subsection (2). This shall also apply if after 1 January 1995 an action is lodged in accordance with section 55 for the cancellation of the registration of a trade mark which was registered prior to 1 January 1995.

(2) Section 51 (2), first and second sentences, shall not apply in cases falling under subsection (1), first sentence. Section 51 (2), first and second sentences, shall apply in cases falling under subsection (1), second sentence, with the proviso that the time limit of five years starts to run as per 1 January 1995.

Section 158 **Transitional provisions**

(1) Article 229 paragraph 6 of the Introductory Act to the German Civil Code (Einführungsgesetz zum Bürgerlichen Gesetzbuche) shall apply mutatis mutandis, with the proviso that section 20 in the version in force until 1 January 2002 shall be treated as equivalent to the provisions of the German Civil Code on limitation in the version in force until 1 January 2002.

(2) If the application was lodged prior to 1 October 2009, section 42 in the version valid up to 1 October 2009 shall apply to the opposition lodged against the registration.

(3) Sections 64 and 66 in the version valid until 1 October 2009 shall apply to special motions (Erinnerung) and appeals which were lodged prior to 1 October 2009. The date of the lodging of the appeal shall be relevant for the applicability of the listed provisions to multilateral proceedings in which one party has lodged a special motion (Erinnerung) and another party has lodged an appeal.

Section 164 **(repealed)**