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## **Act on the Protection of Trade Marks and other Signs (Trade Mark Act – MarkenG)**

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 Article 14 of the Act of 8 October 2023, Federal Law Gazette (Bundesgesetzblatt) 2023 Part I no. 272

### **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, sounds, 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 undertaking from those of other undertakings.

(2) Signs consisting exclusively of shapes or other characteristics

1. which result from the nature of the goods themselves;
  2. which are necessary to obtain a technical result; or
  3. which give 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 nos. 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 are not capable of being represented on the Register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of protection 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. which are excluded from registration, pursuant to German law, to European Union legislation or to international agreements to which the European Union or the Federal Republic of Germany is party, providing for protection of designations of origin and geographical indications;
10. which are excluded from registration pursuant to European Union legislation or international agreements to which the European Union is party, providing for protection of traditional terms for wine;
11. which are excluded from registration pursuant to European Union legislation or international agreements to which the European Union is party, providing for protection of traditional specialities guaranteed;
12. which consist of, or reproduce in their essential elements, an earlier plant variety denomination registered in accordance with German law or European Union legislation, or international agreements to which the European Union or the Federal Republic of Germany is party, providing for protection of plant variety rights, and which are in respect of plant varieties of the same or closely related species;
13. the use of which can evidently be prohibited in the public interest in accordance with other provisions, or
14. which have been applied for in bad faith.

(3) Subsection (2) nos. 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 in consequence of the use made of it with respect to the goods or services for which the application was filed.

(4) Subsection (2) nos. 6, 7 and 8 shall also apply if the trade mark contains the imitation of a sign listed there. Subsection (2) nos. 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 an earlier trade mark applied for or registered and the goods or services for which it was registered are identical with the goods or services for which the earlier trade mark was applied for or registered;
2. if a likelihood of confusion exists, including the likelihood of association between the trade marks, for the public because of its identity with or similarity to an earlier trade mark applied for or registered 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 an earlier trade mark applied for or registered if the earlier trade mark 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.

(3) Goods and services shall not be regarded as being similar to each other merely on the ground that they appear in the same class under the classification system (Nice Classification) provided for in the Geneva Act of 13 May 1977 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957 (Federal Law Gazette [BGBl.] 1981 II, p. 358, 359). Goods and services shall not be regarded as being dissimilar from each other merely on the ground that they appear in different classes under the Nice Classification.

### **Section 10**

#### **Well-known marks**

(1) A trade mark shall be excluded from registration if it is identical with or similar to an earlier trade mark 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, unless there is a reason justifying the action of the agent or representative.

### **Section 12**

#### **Earlier trade marks and commercial designations 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, claim for injunctive relief, 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, with regard to goods or services, 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 sign is identical or similar to a trade mark and is used for goods or services that are identical or similar to those covered by the trade mark and there is a likelihood of confusion on the part of the public, including the likelihood of association between the sign and the trade mark; or
3. using a sign identical with or similar to the trade mark for goods or services 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.

Goods and services shall not be regarded as being similar to each other merely on the ground that they appear in the same class under the classification system prescribed in the Nice Classification. Goods and services shall not be regarded as being dissimilar from each other merely on the ground that they appear in different classes under the Nice Classification.

(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 as a trade name or commercial designation or part of a trade name or commercial designation;
6. to use the sign in business papers or in advertising;
7. to use the sign in comparative advertising in a manner that is contrary to Directive 2006/114/EC of the European Parliament and of the Council of 12 December 2006 concerning misleading and comparative advertising (OJ L 376 of 27 December 2006, p. 21).

(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 injunctive relief. 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 committed in a business operation by an employee or agent, the claim for injunctive relief 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 business operation.

## **Section 14a**

### **Goods under Customs Surveillance**

(1) The proprietor of a trade mark or a commercial designation shall be entitled to prevent all third parties from bringing goods, in the course of trade, into the territory of the Federal Republic of Germany without being released for free circulation there, where such goods, including packaging, come from third countries and bear without authorisation a trade mark or commercial designation which is identical with the trade mark or commercial designation registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark or commercial designation.

(2) The entitlement of the proprietor of the trade mark or commercial designation pursuant to subsection (1) shall lapse if, during the proceedings to determine whether a registered trade mark or commercial designation has been infringed, initiated in accordance with Regulation (EU) No 608/2013 of the European Parliament and 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), evidence is provided by the declarant or the holder of the goods that the proprietor of the registered trade mark or the commercial designation is not entitled to prohibit the placing of the goods on the market in the country of final destination.

## **Section 15**

### **Exclusive right of the proprietor of a commercial designation, claim for injunctive relief, 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 injunctive relief. 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) sentences 2 and 3, shall apply accordingly.
- (6) Section 14 (7) shall apply accordingly.

## **Section 16**

### **Reproduction of a registered trade mark in reference works**

- (1) If the reproduction 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 reproduction 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 accordingly 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 accordingly.
- (3) The subsections (1) and (2) shall not apply if there are reasons justifying the action of the agent or representative.

## **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. Sentence 1 shall apply accordingly 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 sentence 1, 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 interim 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. 70 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 accordingly. 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 interim 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 interim 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 accordingly.

(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) sentence 2, 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 interim 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 interim 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 accordingly.

#### **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 sentence 1 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 accordingly 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 accordingly.

#### **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 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) sentence 1 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 revoked or declared invalid and 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)),
3. because there was no likelihood of confusion within the meaning of section 9 (1) no. 2, of section 14 (2) sentence 1 no. 2 or of section 15 (2) on the date relevant for the seniority of the registration of the later mark.

(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**

(1) The proprietor of a trade mark or of a commercial designation may not prohibit a third party in trade to use the following:

1. the third party's name or address if the third party is a natural person,
2. a sign identical or similar to the trade mark or commercial designation which is not distinctive or an identical 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. the trade mark or the commercial designation for the purposes of identifying or referring to goods or services as those of the proprietor of that trade mark, in particular, where the use of that trade mark is necessary to indicate the intended purpose of a product or service, in particular as an accessory or spare part.

(2) Subsection 1 shall only apply if the use made by the third party is in accordance with honest practices in industrial or commercial matters.

## **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 non-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 at that time an opposition against the trade mark has not been possible for at least five years.

(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 filing of the action for the goods or services he invokes in order to establish his right or that there are proper reasons for non-use, in so far as, at the date of filing of the action, an opposition against the trade mark has not been possible for at least five years. 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 or that there were proper reasons for non-use. 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, regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor, in so far as the differing element does not alter the distinctive character of the trade mark.

(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 is necessary within five years from the date from which an opposition against the trade mark is no longer possible, in cases in which an opposition has been filed against the registration, the expiry of the period for entering an opposition shall be substituted by the date on which the decision concluding opposition proceedings became final or the opposition was withdrawn.

## **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. This provision shall apply accordingly to the contractual obligation to transfer the business operation or a component of the business operation.

(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 accordingly, with the exception of section 46 subsections (2) and (3) sentence 1.

## **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. Sentence 1 shall apply accordingly 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 sentence 1 or 2, 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 sentence 1 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 file proceedings for infringement of a trade mark only with the consent of its proprietor. By way of derogation from sentence 1, the holder of an exclusive licence may file proceedings for infringement of a trade mark if the proprietor of the trade mark, after formal notice, does not himself bring proceedings for infringement of a trade mark within an appropriate period.

(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.

(6) At the request of the proprietor of the trade mark or the licensee, the German Patent and Trade Mark Office shall enter the grant of a licence in the Register if proof is furnished to it that the other party has given its consent. This shall apply accordingly to the modification of a registered licence. The registration shall be cancelled at the request of the proprietor of the trade mark or the licensee. The request for cancellation by the proprietor of the trade mark shall be subject to proof of the consent of the licensee named upon registration or his successor in title.

### **Section 31**

#### **Trade marks applied for**

Sections 27 to 30 shall apply accordingly 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. a request for registration,
2. information permitting to identify the applicant,
3. a representation of the trade mark, which is not subject to the ground for refusal specified in section 8 (1), and
4. 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 applicant has filed the application containing the information specified in section 32 (2) at the German Patent and Trade Mark Office. The receipt of the application documents by a patent information centre which has been designated to accept trade mark applications by notice published by the Federal Ministry of Justice and Consumer Protection in the Federal Law Gazette shall be deemed as receipt by the German Patent and Trade Mark Office.

(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. The German Patent and Trade Mark Office may refrain from the publication insofar as the application concerns a trade mark that is obviously contrary to public policy or to accepted principles of morality.

#### **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 of the application 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 deficiencies ascertained are remedied within that period, the date on which the deficiencies were remedied shall be accorded as the date of filing.

(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; observations by third parties**

(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. 14 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 accordingly if the trade mark has only been excluded from registration for a part of the goods or services for which the application was filed.

(6) Before registration of the trade mark, any natural or legal person and any group or body representing manufacturers, producers, suppliers of services, traders or consumers may submit to the German Patent and Trade Mark Office written observations, explaining on which grounds the trade mark should not be registered ex officio. Persons and groups or bodies may also submit to the German Patent and Trade Mark Office written observations, explaining on which grounds the application for a collective mark or certification mark is to be refused. Persons and groups or bodies shall not be parties to the proceedings before the German Patent and Trade Mark Office.

### **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 file an opposition against the registration of the trade mark. Within that period, persons entitled to invoke rights deriving from an earlier protected designation of origin or protected geographical indication may file 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,
  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, or
  5. because of an earlier designation of origin or geographical indication in conjunction with section 13.
- (3) An opposition may be filed on the basis of one or more earlier rights if these rights belong to the same proprietor.
- (4) The parties to opposition proceedings shall, at the request of both parties, be granted a period of at least two months to enable them to reach a friendly settlement.

### **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 files an objection of non-use, furnish proof that the trade mark, within the last five years prior to the date of filing or priority of the trade mark which is targeted by the opposition, has been used in accordance with section 26 in so far as an opposition against it has not been possible for at least five years at that point in time. Proof may also be provided by an affirmation in lieu of an oath. Only those goods and services shall be taken into consideration in the decision with respect to which use has been proved.
- (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 accordingly 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 accordingly 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 filing 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 revocation of rights or for a declaration of invalidity or an application for revocation of rights or for a declaration of invalidity of the trade mark, filed at that time, 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 be ten years, calculated from the date of filing the application (section 33 (1)).

(2) The registration of the trade mark shall be renewed for a further ten years, at the request of the proprietor of the trade mark or any person authorised to do so by law or by contract, provided that the renewal fee has been paid.

(3) The renewal of the duration of protection may also be effected by payment of a renewal fee and a class fee for each class to be renewed as from the fourth class of the classification of goods and services. Receipt of payment is deemed to be a request by the proprietor of the trade mark or an authorised person in accordance with subsection (2).

(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 sentence 1 applies, shall be renewed only for the classes for which the fees paid suffice. If there is a leading class, it shall be given priority. In other respects, the classes shall be taken into account in the order of the classification.

(5) The German Patent and Trade Mark Office shall inform the proprietor of the trade mark of the expiry of the duration of protection at least six months before the said expiry. Failure to give such information shall not involve the liability of the German Patent and Trade Mark Office.

(6) The request for renewal shall be submitted in the six-month period prior to the expiry of the duration of protection. Failing this, the request may be submitted within a further period of six months following the expiry of the duration of protection.

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

(8) 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 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 revoked and cancelled on application if the trade mark has not been used within an uninterrupted period of five years in accordance with section 26, after the date from which opposition to it is no longer possible. 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 application for revocation. 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 application for revocation, 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 an application for revocation might be filed. If the application for revocation is made to the German Patent and Trade Mark Office in accordance with section 53 (1), the application to the German Patent and Trade Mark Office shall remain relevant for the calculation of the three-month period in accordance with sentence 3 if the action for revocation 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 revoked and cancelled on application

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 be revoked and cancelled in respect of those goods or services only.

#### **Section 50 Invalidity because of absolute grounds for refusal**

(1) The registration of a trade mark shall be declared invalid and cancelled on application if it has been registered contrary to sections 3, 7 or 8.

(2) If the trade mark has been registered contrary to section 3, 7 or 8 (2) nos. 1 to 13, the registration may only be declared invalid and cancelled if the ground for refusal still exists at the time of the decision on the application for a declaration of invalidity. Section 8 (2) no. 1, 2 or 3 shall not be applicable in invalidity proceedings if, before the application for a declaration of invalidity, the trade mark has become established in trade as a consequence of the use which has been made of it in relation to the goods and services for which it was registered, in the relevant section of the affected trade circles. If the trade mark has been registered contrary to section 8 (2) no. 1, 2 or 3, the registration may only be cancelled if the application for invalidity is lodged within ten years since the date of registration.

(3) The registration of a trade mark may be declared invalid and cancelled ex officio if it has been registered contrary to section 8 (2) nos. 4 to 14, and



1. invalidity 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) nos. 4 to 13 continues to exist at the time of the decision on the declaration of invalidity; 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 declared invalid and 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 declared invalid and cancelled in response to an action in accordance with section 55 or an application in accordance with section 53 if it is opposed by an earlier right within the meaning of sections 9 to 13. The application for a declaration of invalidity may also be based on several earlier rights of the same proprietor.
- (2) The registration may not be declared invalid and 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 declared invalid and cancelled if the proprietor of one of the earlier rights listed in sections 9 to 13 has consented to the registration of the trade mark prior to the filing of the application for a declaration of invalidity.
- (3) The registration may not be declared invalid and 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) sentence 1 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 declared invalid and cancelled because of the registration of an earlier trade mark if the registration of the earlier trade mark could have been revoked or declared invalid and cancelled on the date of filing or date of priority of the later trade mark for the following reasons:

1. revocation in accordance with section 49; or
2. absolute grounds for refusal in accordance with section 50.

For the purposes of the examination of likelihood of confusion under section 9 (1) no. 2, the distinctive character of the earlier trade mark on the date of filing or date of priority of the later trade mark shall be taken into account.

- (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 declared invalid and cancelled for these goods or services.

### **Section 52**

#### **Consequences of revocation or invalidity**

- (1) The effects of a registered trade mark shall be deemed not to have taken place, as from the date of the application (section 53) or of filing the action (section 55) for revocation, to the extent to which the trade mark has been revoked. An earlier date, on which one of the grounds for revocation occurred, may be fixed in the decision at the request of one of the parties.

(2) The effects of a registered trade mark shall be deemed to not have taken place, as from the outset, to the extent that the trade mark has been declared invalid.

(3) Subject to the provisions on compensation for the damage caused by negligence 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 due to revocation or invalidity of the trade mark shall not affect

1. decisions in infringement proceedings which have become final and have been enforced prior to the decision on the application for revocation or a declaration of invalidity, and

2. contracts concluded prior to the decision on the application for revocation or a declaration of invalidity in so far as they have been performed prior to this decision. However, repayment, to an extent justified by the circumstances, of sums paid under the relevant contract may be claimed on grounds of equity.

### **Section 53**

#### **Revocation and invalidity proceedings before the German Patent and Trade Mark Office**

(1) The application for revocation (section 49) and a declaration of invalidity because of absolute grounds for refusal (section 50) and the existence of earlier rights (section 51) shall be filed in writing with the German Patent and Trade Mark Office. The facts and evidence which serve as grounds shall be given. Section 81 (6) of the Patent Act (*Patentgesetz*) shall apply accordingly to the provision of security. The application shall be inadmissible to the extent that a decision by final order or final judgment has already been taken on the same subject matter of dispute between the parties. This shall also apply if an action pursuant to section 55 is pending at law concerning the same subject matter of dispute between the parties. Section 325 (1) of the Code of Civil Procedure (*Zivilprozessordnung*) shall apply accordingly. If several applications are filed between the same parties in accordance with sentence 1, they may be combined and may be decided on by order in one procedure.

(2) The application for revocation or a declaration of invalidity because of absolute grounds for refusal may be filed by any natural or legal person and any group or body set up for the purpose of representing the interests of manufacturers, producers, suppliers of services, traders or consumers, and which may be party to the proceedings.

(3) The application for a declaration of invalidity because of the existence of earlier rights may be filed by the proprietor of the earlier rights listed in sections 9 to 13 and persons entitled to assert the rights based on a protected geographical indication or a protected designation of origin.

(4) If an application for revocation or a declaration of invalidity is filed or invalidity proceedings are initiated *ex officio*, the German Patent and Trade Mark Office shall serve a notice thereof on the proprietor of the registered trade mark and shall invite him to make a statement on the application or the proceedings initiated *ex officio* within two months of service of the notice.

(5) If the proprietor does not object to the cancellation because of revocation or a declaration of invalidity within the period stated in subsection (4), the trade mark shall be revoked or declared invalid and the registration shall be cancelled. If the application for a declaration of invalidity is objected to within the time limit, the German Patent and Trade Mark Office shall notify the applicant of the objection. If the application for revocation is objected to within the time limit, the German Patent and Trade Mark Office shall serve the objection on the applicant. The revocation proceedings shall only be continued if the fee to pursue the revocation proceedings further pursuant to the Patent Costs Act (*Patentkostengesetz*) is paid within one month after service of the objection. Otherwise, the revocation proceedings are deemed to be concluded.

(6) If the application for a declaration of invalidity because of the existence of earlier rights has been filed by the proprietor of an earlier registered trade mark, he shall prove in

response to an objection on the part of the person objecting to the application that the trade mark has been used in accordance with section 26 within the last five years prior to the filing of the application, in so far as an opposition against the trade mark has not been possible for at least five years at that date. If an opposition was filed, the period of five years is calculated as from the date on which the decision ending the opposition proceedings became final or the opposition was withdrawn. If the period of five years of non-use ends after the filing of the application, the applicant shall prove in response to an objection on the part of the person objecting to the application that the trade mark has been used in accordance with section 26 within the last five years prior to the decision. If the earlier trade mark was already registered for at least five years on the filing date or priority date of the later trade mark, the applicant shall also prove in response to an objection on the part of the person objecting to the application that, on that date, the registration of the earlier trade mark could not have been declared invalid pursuant to section 49 (1). Only those goods or services for which use has been proved shall be taken into account in the decision. Proof may also be provided by an affirmation in lieu of an oath.

(7) If the right arising from the registration of the trade mark has been transferred or passed on 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 accordingly to the power of the successor to accede to the legal dispute.

#### **Section 54**

##### **Intervention in revocation and invalidity proceedings**

(1) A third party may intervene in revocation or invalidity proceedings if a final decision on the application for revocation or a declaration of invalidity has not yet been taken and if the third party can substantiate that

1. proceedings for infringement of the same registered trade mark are pending against him; or
2. he was required to cease and desist from an alleged infringement of the same registered trade mark.

The intervention may be requested within three months from initiating proceedings pursuant to sentence (1) no. (1) or from receipt of the request to cease and desist pursuant to sentence (1) no. (2).

(2) For filing the request, section 53 (1) to (3) shall apply accordingly. If the intervention occurs in appeal proceedings before the Federal Patent Court, the intervening party shall become a party to the appeal.

#### **Section 55**

##### **Revocation and invalidity proceedings before the courts of ordinary jurisdiction**

(1) The action for revocation (section 49) or a declaration of invalidity 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. The action shall be inadmissible if, concerning the same subject matter of dispute between the parties,

1. a decision in accordance with section 53 has already been taken,
2. an application in accordance with section 53 has been filed with the German Patent and Trade Mark Office.

Section 325 (1) of the Code of Civil Procedure shall apply accordingly.

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

1. in cases of an application for revocation, any person,
2. in cases of an application for a declaration of invalidity because of the existence of earlier rights, the proprietors of the rights listed in sections 9 to 13,

3. in cases of an application for a declaration of invalidity 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 a declaration of invalidity has been lodged by the proprietor of a registered earlier trade mark, he shall prove 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 filing of the action, in so far as an opposition has no longer been possible at this date for at least five years. If the five-year period of non-use ends after the action has been lodged, the claimant shall prove 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 filing or date of priority 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 revoked and cancelled in accordance with section 49 (1) on this day. Only those goods or services for which use has been proved 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 accordingly to the power of the successor to accede to the legal dispute.

(5) The court shall notify the German Patent and Trade Mark Office of the date on which the action was brought. The German Patent and Trade Mark Office shall note the date of bringing the action in the Register. The court shall send a copy of the final judgment to the German Patent and Trade Mark Office. The German Patent and Trade Mark Office shall enter the result of the proceedings in the Register together with the date on which the judgment became final.

## **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 revocation or a declaration of invalidity of a trade mark in accordance with section 53, 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) sentence 2, and sections 47 to 49 of the Code of Civil Procedure with regard to the exclusion of and objection to court personnel shall apply accordingly 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, right to be heard**

- (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, take visual evidence, evaluate the evidentiary value of a furnished document and may undertake further examination as necessary to examine the matter. The provisions of Book 2 of the Code of Civil Procedure concerning such evidence and section 128a of the Code of Civil Procedure shall apply accordingly.
- (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. In revocation or invalidity proceedings, a hearing shall be held if one of the parties so requests or if it is deemed expedient by the German Patent and Trade Mark Office.
- (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 accordingly. 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 sentence 3, 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 sentence 1. 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 accordingly. Sentences 1 to 4 shall apply accordingly 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

1. it is precluded by a legal provision;
2. the 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, L 127 of 23 May 2018, p. 2) in its respectively applicable version obviously prevails; or
3. it refers to contents of the files that are obviously contrary to public policy or to accepted principles of morality.

(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 sentence 2 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 application for revocation or a declaration of invalidity 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) sentence 2, and section 33 (1) of the Act on the Remuneration of Lawyers (Rechtsanwaltsvergütungsgesetz) shall apply accordingly. 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, revocation or invalidity 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 accordingly. 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) sentence 2, 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) sentence 2, 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, revocation and invalidity proceedings,
5. to make arrangements regarding the Register of registered trade marks and, where appropriate, separate provisions regarding the Register for collective marks and certification marks,
6. to regulate the indications regarding registered trade marks and regarding opposition and invalidity proceedings 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 European Union trade marks,
8. to make arrangements regarding indications concerning licences to be included in the Register,
9. 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,
10. 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,
11. 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,
12. 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 due to surrender, revocation or invalidity (section 48 (1) and section 53), the submission of expert reports (section 58 (1)) and the decisions whereby the submission of an expert report is refused,

13. 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,

14. 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,

15. to create rules on the public holidays to be taken into account for time limits in trade mark matters which apply to all offices of the German Patent and Trade Mark Office.

(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.

#### **Section 65a**

##### **Administrative cooperation**

The German Patent and Trade Mark Office shall cooperate effectively with other national trade mark offices, the World Intellectual Property Organization and the European Union Intellectual Property Office in the fields of activity relevant to national, international trade mark protection and trade mark protection in the European Union and shall promote the convergence of practices and tools in the fields of examination, registration, administration and cancellation of trade marks.

#### **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) sentence 1, 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, sentence 1 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 sentence 2 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) sentence 2, his special motion (Erinnerung) shall be deemed to have been withdrawn. The running of the periods in accordance with sentences 1 and 2 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 sentences 1 and 2 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 sentences 1 and 2 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 sentence 1, 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 sentence 2. In proceedings with no third-party participation within the meaning of sentence 2, 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 accordingly, 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 or she 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 application for revocation or a declaration of invalidity 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 accordingly.

### **Section 72**

#### **Exclusion and objection**

- (1) Sections 41 to 44 and 47 to 49 of the Code of Civil Procedure shall apply accordingly 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 or her 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) sentence 1, and (4) sentence 1, of the Code of Civil Procedure shall apply accordingly.

#### **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 accordingly.

#### **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) sentence 2, 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, accordingly, 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 accordingly.

#### **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 accordingly unless it is precluded by the special characteristics of the proceedings before the Federal Patent Court. Section 227 (3) sentence 1 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 accordingly.

(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 accordingly 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 accordingly.

#### **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 accordingly 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 accordingly.

#### **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 accordingly in proceedings on the appeal on points of law. Section 91(8) shall apply accordingly in the case of the re-establishment of rights. Upon request, a party shall be granted legal aid subject to the application, accordingly, of section 138 of the Patent Act.

(2) Section 67(2) and (3) shall apply accordingly 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 accordingly.

### **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 application for revocation or a declaration of invalidity, 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.

(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 or she 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 accordingly.

## **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) sentence 1 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) sentence 1 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 accordingly to addressees who themselves are representatives in Germany within the meaning of section 96 (2). Section 184 (2) sentences 1 and 4, of the Code of Civil Procedure shall apply accordingly.
2. Section 5 (4) of the Act on Service in Administrative Procedures shall apply accordingly 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 sentence 1 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) sentence 1, (5), and (6) of the Code of Civil Procedure shall apply accordingly.
- (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 accordingly 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 accordingly 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. A collective mark shall be described as such when the mark is applied for.
- (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 of manufacturers, producers, suppliers of services, or traders, including the umbrella associations and central associations whose members themselves are associations which have the capacity in their own name to have rights and obligations, to make contracts or accomplish other legal acts and to sue and be sued in a court of law. 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. In particular, such a mark shall not be invoked against a third party who is entitled to use a geographical name.

(2) The genuine 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 collective 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 collective mark**

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

(2) The regulations governing use of the collective 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 regulations governing use of the collective mark shall be recorded in the Register.

(5) Inspection of the regulations governing use of the collective mark shall be open to everyone.

### **Section 103**

#### **Examination of the application**

(1) 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 section 97, 98 or 102 or if the

regulations governing use of the collective mark are contrary to public policy or to accepted principles of morality.

(2) The application for a collective mark shall also be refused if the public is liable to be misled as regards the character or the significance of the mark, in particular if it is likely to be taken to be something other than a collective mark.

(3) The application for a collective mark shall not be refused if the applicant amends the regulations governing use of the collective mark such that the grounds for refusal of subsections 1 and 2 no longer exist.

#### **Section 104**

##### **Amendment of the regulations governing use of the collective 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 collective mark.

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

(3) For the purposes of this act, the amendment of the regulations governing use of the collective mark shall only take effect as from the date when the amendment is entered in the Register.

(4) Written observations by third parties in accordance with section 37 (6) sentence 2 may also be filed with respect to amended regulations governing use of the collective mark.

#### **Section 105**

##### **Revocation**

(1) The registration of a collective mark shall be revoked on application and cancelled 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 collective mark;
3. if the manner in which the mark has been used by the authorised persons has caused it to become liable to mislead the public in the manner referred to in section 103 (2); or
4. if an amendment to the regulations governing use of the collective 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 application for revocation in accordance with subsection (1) shall be made to the German Patent and Trade Mark Office. The proceedings shall be governed by section 53.

#### **Section 106**

##### **Invalidity because of absolute grounds for refusal**

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

(2) The application for a declaration of invalidity in accordance with subsection (1) shall be filed with the German Patent and Trade Mark Office. The procedure shall be governed by section 53.

## **Part 5**

### **Certification marks**

#### **Section 106a**

##### **Certification marks**

(1) The proprietor of the certification mark shall certify in respect of the goods and services for which it was applied for, one or more of the following characteristics:

1. the material;
2. the mode of manufacture of goods or performance of services;
3. the quality, accuracy or other characteristics, with the exception of geographical origin.

The mark shall be capable of distinguishing goods and services which are certified from goods and services which are not so certified. A certification mark shall be described as such when the mark is applied for.

(2) The provisions of this Act shall apply to certification marks to the extent that this Part does not provide otherwise.

#### **Section 106b**

##### **Proprietorship and genuine use**

(1) Any natural or legal person, including institutions, authorities and bodies governed by public law, may be proprietor of certification marks applied for or registered provided that such person does not carry on a business involving the supply of goods or services of the kind certified.

(2) The genuine use of a certification mark by at least one person who has authority to use it shall be regarded as use within the meaning of section 26.

#### **Section 106c**

##### **Right of action, compensation**

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

(2) The proprietor of the certification mark shall also be entitled to claim compensation for the damage which the persons who have authority to use the certification mark have sustained in consequence of the unauthorised use of the certification mark or of a similar sign.

#### **Section 106d**

##### **Regulations governing use of the certification mark**

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

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

1. the name of the proprietor of the certification mark;
2. a declaration by the proprietor of the certification mark that he does not carry on a business involving the supply of goods or services of the kind certified;
3. a representation of the certification mark;
4. indications regarding the goods and services to be certified;
5. indications regarding the characteristics of the goods or services to be covered by the certification;

6. prerequisites for use of the certification mark, in particular, sanctions;
  - 7 indications regarding the group of persons who have authority to use the certification mark;
  8. indications regarding how the proprietor of the certification mark has to test the characteristics covered by the certification and to supervise the use of the mark;
  9. indications regarding the rights and obligations of the parties in the case of infringements of the certification mark.
- (3) The regulations governing use of the certification mark shall be recorded in the Register.  
(4) Inspection of the regulations governing use of the certification mark shall be open to everyone.

#### **Section 106e**

##### **Examination of the application**

- (1) The application for a certification mark shall also be refused, in addition to cases falling under section 37, if it does not comply with the prerequisites of sections 106a, 106b (1) or 106d or if the regulations governing use of the certification mark are contrary to public policy or to accepted principles of morality.
- (2) The application for a certification mark shall also be refused if the public is liable to be misled as regards the character or the significance of the mark, in particular if it is likely to be taken to be something other than a certification mark.
- (3) The application for a certification mark shall not be refused if the applicant amends the regulations governing use of the certification mark such that the grounds for refusal of subsections 1 and 2 no longer exist.

#### **Section 106f**

##### **Amendment of the regulations governing use of the certification mark**

- (1) The proprietor of the certification mark shall inform the German Patent and Trade Mark Office of any amendment to the regulations governing use of the certification mark.
- (2) Sections 106d and 106e shall apply accordingly in the case of an amendment to the regulations governing use of the certification mark.
- (3) For the purposes of this Act, the amendment of the regulations governing use of the certification mark shall only take effect as from the date on which the amendment is entered in the Register.
- (4) Written observations by third parties in accordance with section 37 (6) sentence 2 may also be filed with respect to amended regulations governing use of the certification mark.

#### **Section 106g**

##### **Revocation**

- (1) The registration of a certification mark shall be revoked on application and cancelled in the following cases, in addition to the grounds for revocation listed in section 49
1. if the proprietor of the certification mark does no longer comply with the requirements of section 106b;
  2. if the proprietor of the certification mark does not take any suitable measures to prevent the certification mark from being used abusively in a manner contrary to the regulations governing use of the certification mark;
  3. if the manner in which the certification mark has been used by the authorised persons has caused it to become liable to mislead the public pursuant to section 106e (2); or
  4. if an amendment to the regulations governing use of the certification mark has been entered in the Register contrary to section 106f (2) in accordance with section 106d

(3), unless the proprietor of the certification mark once more amends the regulations governing use of the certification mark such that the ground for revocation 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 certification mark by persons other than those who have the authority to use is liable to deceive the public.

(3) The application for revocation in accordance with subsection (1) shall be filed with the German Patent and Trade Mark Office. The proceedings shall be governed by section 53.

#### **Section 106h**

##### **Invalidity because of absolute grounds for refusal**

(1) The registration of a certification mark shall be declared invalid on application and cancelled, in addition to the grounds for invalidity listed in section 50, if it has not been refused and has been registered contrary to section 106e. If the ground for invalidity relates to the regulations governing use of the certification mark, the registration shall not be declared invalid and cancelled if the proprietor of the certification mark amends the regulations governing use of the certification mark such that the ground for invalidity no longer exists.

(2) The application for a declaration of invalidity in accordance with subsection (1) shall be filed with the German Patent and Trade Mark Office. The procedure shall be governed by section 53.

#### **Part 6**

##### **Protection of trade marks in accordance with the Protocol Relating to the Madrid Agreement; European Union trade marks**

#### **Chapter 1**

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

#### **Section 107**

##### **Application of the provisions of this Act; languages**

(1) The provisions of this Act shall apply accordingly to international registrations of marks in accordance with the Protocol of 27 June 1989 Relating to the Madrid Agreement Concerning the International Registration of Marks (Federal Law Gazette 1995 II, p. 1016, 1017), last amended by the Ordinance of 24 August 2008 (Federal Law Gazette 2008 II, p. 822)

(Protocol Relating to the Madrid Agreement) which are effected through the intermediary of the German Patent and Trade Mark Office or whose protection extends to 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 108**

##### **Application for international registration**

(1) The application for the international registration of a 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 filed with the German Patent and Trade Mark Office. The application may be filed 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 filed 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) The list of goods and services shall be submitted with the application, grouped into classes, in the order of the international classification of goods and services.

### **Section 109**

#### **Fees**

(1) If the international registration is to be effected on the basis of a trade mark entered in the Register, and if the application for international registration has been filed 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. The due date is determined in accordance with section 3 (1) of the Patent Costs Act or in accordance with subsection (1).

### **Section 110**

#### **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. Sentence 1 shall also apply if the international registration was effected on the basis of a trade mark for which an application has been filed for entry in the Register and the application has resulted in a registration.

### **Section 111**

#### **Subsequent extension of protection**

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

(2) 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 112**

#### **Effect of the international registration and the subsequent extension of protection**

(1) The international registration or the subsequent extension of protection of a mark whose protection in accordance with Articles 3 and 3<sup>ter</sup> of the Protocol Relating to 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 for recording and registered on the date of the international registration in accordance with Article 3 (4) of the Protocol Relating to the Madrid Agreement or on the date of the registration of subsequent extension of protection in accordance with Article 3<sup>ter</sup> (2) of the Protocol Relating to the Madrid Agreement in the Register kept by the German Patent and Trade Mark Office.

(2) The effect referred to 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 accordance with section 37 in the same way as trade marks whose recordal in the Register has been applied for. 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 against an international registration**

- (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 file the opposition (section 42 (1)) against the grant of protection for international registrations shall start 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) sentence 1).

#### **Section 115**

##### **Invalidation**

- (1) For international registrations, the request or the action for invalidation shall take the place of the application (section 49) or the action (section 55) for revocation of a trade mark or the application for a declaration of invalidity because of absolute grounds for refusal (section 50) or the application or the action for a declaration of invalidity because of the existence of earlier rights (section 51).
- (2) In the case of the request or the action for invalidation for non-use in accordance with section 49 (1) or section 55,
1. the date on which the procedure of extension of protection was concluded or
  2. the date on which the time limit contained in Article 5 (2a) of the Protocol Relating to the Madrid Agreement expired if at that time neither a statement of grant of protection nor a notification of provisional refusal of protection has been received by the International Bureau of the World Intellectual Property Organization
- shall take the place of the date from which opposition to the trade mark is no longer possible.

#### **Section 116**

##### **Opposition because of an international registration and application or action for a declaration of invalidity because of an international registration**

- (1) If an opposition has been filed against the registration of a trade mark because of an international registration, section 43 (1) shall apply provided that one of the dates referred to in section 115 (2) shall take the place of the date from which opposition to the trade mark was no longer possible.
- (2) If an application for a declaration of invalidity of a registered trade mark is filed in accordance with section 51 or such an action is brought because of an international registration, section 53 (6) and section 55 (3) shall apply provided that one of the dates referred to in section 115 (2) shall take the place of the date from which opposition to the trade mark was no longer possible.

#### **Section 117**

##### **Exclusion of rights for non-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 provided that one of the dates referred to in section 115 (2) shall take the place of the date from which opposition to the trade mark was no longer possible.

#### **Section 118**

##### **Transformation of an international registration**

- (1) If an application is filed with the German Patent and Trade Mark Office in accordance with Article 9*quinquies* 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 (4) of the Protocol Relating to the Madrid Agreement, and if the application is

received by the German Patent and Trade Mark Office with the necessary indications within a period of three months after the date of the cancellation of the trade mark in the International Register, the date of the international registration of this mark in accordance with Article 3 (4) of the Protocol Relating to the Madrid Agreement or the date of the registration of the subsequent extension of protection in accordance with Article 3<sup>ter</sup> (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 filing the application 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 filing the application shall furthermore submit a German translation of the list of goods or services for which the registration is requested.

(4) In other respects, the application 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 (2a) 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 invalidation, the trade mark shall be directly entered in the Register in accordance with section 41 (1) with no prior examination. No opposition may be filed against the registration of a trade mark in accordance with sentence 2.

## **Chapter 2**

### **European Union trade marks**

#### **Section 119**

##### **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 Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ L 154 of 16 June 2017, p. 1) in the cases of nos. 1 and 2 directly and in the cases of nos. 3 to 6 accordingly as follows:

1. For the application of section 9 (relative grounds for refusal), earlier European Union 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 European Union in accordance with Article 9 (2) (c) of Regulation (EU) 2017/1001.
2. In addition to the rights in accordance with Articles 9 to 13 of Regulation (EU) 2017/1001, the proprietor of a registered European Union trade mark shall be entitled to the 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).
3. If rights from a registered European Union trade mark are asserted against the use of a later trade mark registered in accordance with this Act, section 21 (1) shall apply accordingly.
4. If an opposition to the registration of a trade mark (section 42) is based on an earlier registered European Union trade mark, section 43 (1) shall apply accordingly with the proviso that the use of the earlier European Union trade mark in accordance with Article 18 of Regulation (EU) 2017/1001 shall take the place of the use of the earlier trade mark in accordance with section 26.

5. If an application (section 53 (1)) or an action (section 55 (1)) for revocation or a declaration of invalidity of the registration of a trade mark is based on an earlier registered European Union trade mark,

- a) section 51 (2) sentence 1 shall apply accordingly;
- b) section 53 (6) and section 55 (3) shall apply accordingly with the proviso that the use of the European Union trade mark in accordance with Article 18 of Regulation (EU) 2017/1001 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 filed by proprietors of registered European Union trade marks in the same manner as by proprietors of trade marks registered in accordance with this Act; sections 146 to 149 shall apply accordingly.

### **Section 120**

#### **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 in accordance with Article 39 or 40 of the Regulation on the European Union trade mark for a European Union trade mark which has been filed or registered, and if the trade mark that has been entered in the Register of the German Patent and Trade Mark Office has been cancelled because of non-renewal of the duration of protection in accordance with section 47 (8) or because of surrender in accordance with section 48 (1), on request the invalidity (Ungültigkeit) of this trade mark may be subsequently found because of revocation or because of invalidity. In this case, the seniority has no effect.

(2) The finding of invalidity (Ungültigkeit) shall take place subject to the same prerequisites as revocation or a declaration of invalidity. However, the invalidity (Ungültigkeit) of a trade mark because of revocation in accordance with section 49 (1) may only be found if the prerequisites for revocation 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 revocation and invalidity proceedings of a registered trade mark, with the proviso that the finding of its invalidity (Ungültigkeit) shall take the place of revocation or a declaration of invalidity.

### **Section 121**

#### **Conversion of European Union trade marks**

(1) If a request for conversion of a European Union trade mark applied for or registered has been transmitted to the German Patent and Trade Mark Office in accordance with Article 139 (3) of the Regulation on the European Union 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 European Union 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 European Union trade mark in accordance with Article 32 of the Regulation on the European Union trade mark or the date of a priority claimed for the European Union trade mark shall take the place of the date of filing in accordance with section 33 (1). If the seniority of a trade mark entered in the Register of the German Patent and Trade Mark Office had been claimed for the application for the European Union trade mark in accordance with Article 39 of the Regulation on the European Union trade mark, this seniority shall take the place of the date that is relevant in accordance with sentence 1.

(3) If the conversion request relates to a trade mark which was already registered as a European Union 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 122**

### **European Union trade mark disputes; European Union trade mark courts**

(1) The regional courts shall have exclusive jurisdiction as European Union trade mark courts of first instance for all actions for which, in accordance with the Regulation on the European Union trade mark, the European Union trade mark courts have jurisdiction within the meaning of Article 123 (1) of the Regulation on European Union trade marks (European Union trade mark litigation), irrespective of the value in dispute.

(2) The European Union trade mark court of second instance shall be the higher regional court (Oberlandesgericht) in whose district the European Union trade mark court of first instance has its seat.

(3) The Land (federal state) governments shall be authorised to assign, by statutory instrument, European Union trade mark litigation cases for the districts of more than one European Union 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 European Union trade mark courts of one Land to the competent European Union trade mark court of another Land, in whole or in part.

(5) Section 140 (4) and section 142 shall apply accordingly to proceedings before the European Union trade mark courts.

## **Section 123**

### **Communication to the European Commission**

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

## **Section 124**

### **Territorial jurisdiction of the European Union trade mark courts**

Where, in accordance with Article 125 of the Regulation on the European Union trade mark, German European Union trade mark courts have international jurisdiction, those provisions shall apply accordingly 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 125**

### **Insolvency proceedings**

(1) If the insolvency court is aware that a European Union trade mark applied for or registered is part of the insolvency estate, it shall request the European Union Intellectual Property Office 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 European Union trade mark or of the application for the European Union 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 European Union trade marks or, if it is an application, in the files of the application.

(2) The entry in the Register of European Union 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 125a** **Order for enforcement**

The Federal Patent Court shall have jurisdiction to issue the order for enforcement in accordance with Article 110 (2) sentence 3, of the Regulation on the European Union trade mark. The enforceable execution copy shall be issued by the registry clerk at the registry of the Federal Patent Court.

### **Part 7** **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 entitled to assert claims in accordance with section 8 (3) of the Act Against Unfair Competition for injunctive relief 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 accordingly.
- (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 accordingly.
- (3) Section 14 (7) and section 19d shall apply accordingly.

### **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 sentence

1 and in accordance with sentence 2 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) sentence 1 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 accordingly to requests to change the specification of a protected geographical indication or of a protected designation of origin in accordance with Article 53 (2) sentence 1 of Regulation (EU) No 1151/2012.

(2) Sections 130 and 131 shall apply accordingly 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) sentence 4 shall be entitled to lodge an appeal against a decision in accordance with section 130 (5) sentence 1. 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 accordingly.

### **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 (1) no. 1 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 accordingly 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) nos. 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 sued for injunctive relief if there is a risk of recurrence. This right may also be asserted in the event of the risk of a first-time infringement. The following shall be entitled to the rights in accordance with sentence 1:

1. parties entitled to assert rights in accordance with section 8 (3) of the Act Against Unfair Competition;
2. groups within the meaning of point 2 of Article 3 of Regulation (EU) No 1151/2012;
3. recognised producer organisations, recognised associations of producer organisations and recognised interbranch organisations within the meaning of Regulation (EU) No 1308/2013 of the European Parliament and of the Council of 17 December 2013 establishing a common organisation of the markets in agricultural products and repealing Council Regulations (EEC) No 922/72, (EEC) No 234/79, (EC) No 1037/2001 and (EC) No 1234/2007 (OJ L 347 of 20 December 2013, p. 671; L 189 of 27 June 2014, p. 261; L 130 of 19 May 2016, p. 18; L 34 of 9 February 2017, p. 41; L 106 of 6 April 2020, p. 12), last amended by Regulation (EU) 2021/2117 (OJ L 435 of 6 December 2021, p. 262), in its applicable version if their objective also includes the protection against infringements referred to in Article 13 of Regulation (EU) No 1151/2012.

Sections 18, 19, 19a and 19c shall apply accordingly.

(2) Section 128 (2) and (3) shall apply accordingly.

### **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 sentence 1. Statutory instruments in accordance with sentence 1 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 sentences 1 and 2 by statutory instrument to other authorities in whole or in part.

## **Part 8**

### **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 order to secure the claims for injunctive relief specified in this Act, interim injunctions may also be issued without presentation and substantiation of the requirements specified in sections 935 and 940 of the Code of Civil Procedure.

(4) 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 9**

### **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) sentence 1 no. 1 or 2;
2. uses a sign contrary to section 14 (2) sentence 1 no. 3 with the intention to take advantage of or be detrimental to 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) sentence 1 no. 1 or 2; or
  - b) would be prohibited in accordance with section 14 (2) sentence 1 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 to take advantage of or be detrimental to 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 European Union trade mark**

(1) Any person who infringes the rights of the proprietor of a European Union trade mark in accordance with Article 9 paragraph 1 of the Regulation on the European Union trade mark by using, in trade, despite a prohibition and without the consent of the trade mark proprietor,

1. a sign that is identical to the European Union trade mark for goods or services which are identical to those in respect of which it is registered;
2. a sign if, because of the identity or similarity of the sign to the European Union trade mark and the identity or similarity of the goods or services covered by the European Union 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. a sign which is identical with or similar to the European Union trade mark for goods or services which are not similar to those for which the European Union 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 European Union trade mark

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

(2) Section 143 (2) to (6) shall apply accordingly.

#### **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 take advantage of or be detrimental to 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 objects in the possession of the convict shall be removed or, if this is not possible, the objects 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 accordingly 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) sentence 1, 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) sentence 2 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 to the seized goods or did not without delay make a declaration (section 147 (2) sentence 2), 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 accordingly, 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 10**

##### **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 accordingly 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 was filed, in accordance with section 55, for the cancellation of the registration of a trade mark or, after 1 May 2020 in accordance with Section 53, an application for revocation and a declaration of invalidity was filed for a trade mark which was registered prior to 1 January 1995.

(2) Section 51 (2) sentences 1 and 2, shall not apply in cases falling under subsection (1) sentence 1. Section 51 (2) sentences 1 and 2, shall apply in cases falling under subsection (1) sentence 2, 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 Gesetzbuch) shall apply accordingly, 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 filed prior to 1 October 2009, section 42 (1) and (2) in the version valid up to 1 October 2009 shall be applicable to the opposition filed against the registration.

(3) If the application was filed between 1 October 2009 and 14 January 2019, section 42 (1) and (2) in the version valid up to 14 January 2019 shall be applicable to the opposition filed against the registration.

(4) If the opposition was filed before 14 January 2019, section 42 (3) and (4) shall not apply.

(5) If, in proceedings relating to an opposition filed before 14 January 2019, the use of the trade mark on which the opposition is based is disputed, or if such use is disputed in such opposition proceedings, sections 26 and 43 (1) in the version valid up to that date shall continue to be applicable.

(6) If the request for cancellation of a registered trade mark because of revocation under Section 49 was filed before 14 January 2019 or the action for cancellation because of revocation or earlier rights under section 51 was brought before that date, section 49 (1),

section 51 (4) no. 1, section 55 (3) and section 26 in their version valid up to that date shall continue to be applicable.

(7) Section 8 (2) nos. 9 to 12 shall not apply to trade marks which have been applied for at the German Patent and Trade Mark Office before 14 January 2019.

(8) Section 50 (2) sentence 1 shall apply only to applications pursuant to section 50 (1) that were filed after 14 January 2019. If the application under section 50 (1) was filed before 14 January 2019, section 50 (2) in its previous version shall be applicable.

(9) 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.

(10) Section 102 (4) shall not apply to collective marks registered before 14 January 2019.

### **Section 159**

#### **Duration of protection and renewal**

(1) The provisions of this Act concerning the duration of protection and its renewal (section 47) shall be applicable to trade marks registered before 14 January 2019, with the proviso that section 47 (1) in the version valid up to that date shall continue to be applicable to the calculation of the period after which the duration of protection ends.

(2) For registered trade marks whose duration of protection under section 47 (1) ends 12 months after 31 January 2019, at the latest, sections 3, 5 and 7 of the Patent Costs Act of 13 December 2001 (Federal Law Gazette [BGBl.] I, p. 3656), as last amended by Article 13 of the Act of 4 April 2016 (Federal Law Gazette [BGBl.] I, p. 558), shall continue to be applicable in the version valid up to that date.

### **Sections 160 to 163 (repealed)**

### **Section 164 (repealed)**