Law on the Extension of Industrial Property Rights

(Extension Law–ErstrG)
of April 23, 1992*

(as last amended by the Law of August 30, 1994)

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* *German title:* Gesetz über die Erstreckung von gewerblichen Schutzrechten (Erstreckungsgesetz–ErstrG) vom 23. April 1992.

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PART 1
EXTENSION

Chapter 1
Extension to the Territory Designated in Article 3 of the Unification Treaty

Extension of Industrial Property Rights and of Applications for Industrial Property Rights

1.–

(1) The industrial property rights (patents, utility models, semiconductor rights, industrial designs and type faces, trademarks and service marks) and the applications for such rights already existing on May 1, 1992, in the Federal Republic of Germany, with the exception of the territory designated in Article 3 of the Unification Treaty, shall extend to the territory designated in Article 3 of the Unification Treaty and shall maintain their priority.

(2) The same shall apply to applications filed and rights that have been registered or granted on the basis of international agreements with effect for the Federal Republic of Germany, with the exception of the territory designated in Article 3 of the Unification Treaty.

Cancellation of Registered Trademarks

2.–

(1) A third party may also request cancellation under Section 11(1), item 1, of the Trademark Law of a trademark extended under Section 1 that has been registered on the basis of an application filed during the period from July 1 to October 2, 1990, inclusive, if the mark has been registered in his name on the basis of an application with earlier priority filed with the former Patent Office of the German Democratic Republic for the same or similar goods or services and has been extended under Section 4. Such registration shall have the same status as an internationally registered mark under the Madrid Agreement concerning the International Registration of Marks that has been extended under Section 4.

(2) Subsection (1) shall apply *mutatis mutandis* to requests for withdrawal of protection under Section 10 of the Ordinance on the International Registration of Trademarks from an internationally registered mark extended under Section 1.

Opposition to Registered Trademarks

3.–

(1) Opposition under Section 5(4) or Section 6a(3) of the Trademark Law against the registration of a mark filed with the German Patent Office between July 1 and October 2, 1990, inclusive, that has been extended under Section 1, may be lodged by any person who has filed an application with the former Patent Office of the German Democratic Republic with earlier priority, for the same or similar goods or services and which is the same as the mark applied for (Section 31 of the Trademark Law), that has been extended under Section 4. Such application shall have the same status as an internationally registered mark under the Madrid Agreement Concerning the International Registration of Marks that has been extended under Section 4.

(2) Where the German Patent Office has published a mark as referred to in subsection (1) in accordance with Section 5(2) of the Trademark Law and if the time limit for opposition under Section 5(4) or Section 6a(3) of the Trademark Law has not expired on May 1, 1992, opposition may be lodged on the basis of an earlier mark as referred to in subsection (1) within three months of that date.

(3) Subsections (1) and (2) shall apply *mutatis mutandis* to opposition under Section 2 of the Ordinance on the International Registration of Trademarks lodged against an internationally registered mark extended under Section 1.

Chapter 2
Extension of Industrial Property Rights Existing in the Territory Designated in Article 3 of the Unification Treaty to the Remaining Federal Territory

SUBCHAPTER 1
GENERAL PROVISIONS

Extension of Industrial Property Rights and Applications for Industrial Property Rights

4.–

(1) The industrial property rights (exclusive patents and economic patents, inventors' certificates and patents for industrial designs, marks) that were in existence on May 1, 1992, in the territory designated in Article 3 of the Unification Treaty and applications for such industrial property rights shall be extended to the remaining Federal territory and shall maintain their priority.

(2) The same shall apply to applications filed and rights registered or granted on the basis of international agreements with effect for the territory designated in Article 3 of the Unification Treaty.

(3) Sections 33 to 38 shall apply to indications of source registered or applied for with effect for the territory designated in Article 3 of the Unification Treaty.

Applicable Law

5.–

Notwithstanding the provisions below, the industrial property rights and the applications for industrial property rights extended under Section 4 shall be governed by the statutory provisions hitherto applicable to them (Annex I, Chapter III, Field E, Part II, item 1, Article 3(1) of the Unification Treaty of August 31, 1990, *Bundesgesetzblatt* (BGBl.) 1990 II, pp. 885, 961) only where they concern the qualifying requirements for protection and the term of protection. In all other cases they shall be governed by the provisions of Federal law transferred to them under the Unification Treaty.

SUBCHAPTER 2
SPECIAL PROVISIONS ON PATENTS

Effect of Granted Patents

6.–

The grant of a patent under the statutory provisions of the German Democratic Republic shall have the same status as the publication of the grant of a patent under Section 58(1) of the Patent Law.

6a.–

The term of patents extended under Section 4 that have not expired on December 31, 1995, shall be 20 years commencing on the day after the date of filing of the application.

Economic Patents

7.–

(1) Economic patents extended under Section 4 shall be deemed patents for which a declaration of willingness to grant licenses under Section 23(1), first sentence, of the Patent Law has been given. This shall also apply to economic patents that have been recognized as having effect in the territory designated in Article 3 of the Unification Treaty on the basis of the Agreement of December 18, 1976, on the reciprocal recognition of inventors' certificates and other titles of protection for inventions (*Gesetzblatt der Deutschen Demokratischen Republik* (GBl.) II, No. 15, p. 327).

(2) The owner of a patent that has been examined as to compliance with all requirements for protection may declare in writing at any time to the German Patent Office that the declaration of willingness to license under subsection (1) shall be deemed withdrawn. Notification of such declaration shall be published in the Patent Gazette. The amount by which the annual fees due since May 1, 1992, have been reduced shall be paid within one month after publication of the notification. Section 17(3), second and third sentences, of the Patent Law shall apply *mutatis mutandis* with the proviso that the one–month time limit referred to in the third sentence shall replace the due date.

(3) Anyone who, prior to publication of the notification of a declaration under subsection (2), second sentence, has informed the owner of the patent of his intention to use the invention and has begun such use or has made the necessary preparation for use, shall remain entitled to continue the use in the way stated by him in the communication.

Patents Not Available in German

8.–

(1) Where the patent extended under Section 4 has not been published in German, the owner of the patent may assert the rights under the patent only as from the day on which a German translation of the patent specification filed by him has been published at his request by the German Patent Office. The request shall be subject to payment of a fee in accordance with the schedule of fees. If the fee is not paid, the request shall be deemed not to have been made.

(2) A notification of publication of the translation shall be published in the Patent Gazette and noted in the Patent Register.

(3) If the translation of the patent specification contains errors, the owner of the patent may request publication of a corrected translation to be filed by him. Subsection (1), second and third sentences, and subsection (2) shall apply *mutatis mutandis*.

(4) The wording of the patent specification shall constitute the binding version. If the translation of the patent specification contains errors, anyone who has in good faith begun to use the invention or has made serious and effective preparations for using the invention shall still be entitled to use the invention after publication of the corrected translation for the needs of his own business in his own plant or workshops or the plant or workshops of others free of cost throughout the whole Federal territory if such use would not constitute an infringement of the patent in the faulty translation contained in the patent specification.

Rights of Use in Exclusive Patents

9.–

(1) The right afforded by Section 3(4), first sentence, of the Law amending the Patent Law and the Law on Distinctive Signs for Goods of the German Democratic Republic, of June 29, 1990 (GBl. I, No. 40, p. 571), to continue to use an invention protected by an economic patent that has been converted to an exclusive patent, shall be maintained and shall be extended to the remaining Federal territory. The owner of the patent shall be entitled to appropriate remuneration.

Patent Applications

10.–

(1) Where a patent application extended under Section 4 has not been subjected to an examination corresponding to the examination for obvious compliance under Section 42 of the Patent Law, such examination for obvious compliance shall be carried out.

(2) Where the application is not available in German, the German Patent Office shall require the applicant to file a German version of the application within three months. If the German version is not filed within the time limit, the application shall be deemed to have been withdrawn.

(3) If grant of a patent has not yet been decided in the case of a patent application extended under Section 4, free inspection of files shall be afforded under Section 31(2), item 2, and the application published as an unexamined patent application.

(4) If a request for examination has been duly filed with respect to an application extended under Section 4, the request shall be further processed. If examination has already begun *ex officio*, it shall only be continued if the applicant files a request for examination under Section 44(1) to (3) of the Patent Law.

Searching

11.–

At the request of the owner of the patent or of another person, the German Patent Office shall determine with respect to a patent extended under Section 4 the publicly available documents to be taken into consideration for assessing the patentability of the invention. A fee shall be paid together with the request in accordance with the schedule of fees. If the fee is not paid, the request shall be deemed not to have been filed. Section 43(3) to (6) and (7), first sentence, of the Patent Law shall apply *mutatis mutandis*.

Examination of Granted Patents

12.–

(1) A patent extended under Section 4 that has not been examined for compliance with all conditions of protection shall be examined, on request, by the Examining Section of the German Patent Office. The request may be filed by the owner of the patent or by any other person. Section 44(1), (3) and (5), first sentence, and Section 45 of the Patent Law shall apply *mutatis mutandis*; Section 44(4), first and second sentences, of the Patent Law shall apply *mutatis mutandis* where a request under Section 11 has been filed.

(2) A request for examination already duly filed with respect to a patent extended under Section 4 shall be further processed by the Examining Section. An examination that has been begun *ex officio* shall be continued.

(3) Examination under subsections (1) and (2) shall result in maintenance or revocation of the patent. Section 58(1), first and second sentences, of the Patent Law shall apply *mutatis mutandis*. Opposition to maintenance may be lodged under Section 59 of the Patent Law.

(4) Section 81(2) of the Patent Law shall not apply to patents within the meaning of subsection (1).

(5) Section 130 of the Patent Law shall apply *mutatis mutandis* to examination proceedings under subsections (1) and (2).

Opposition Proceedings in Special Cases

13.–

Where the German Patent Office confirms or grants a patent extended under Section 4 in accordance with Section 18(1) or (2) of the Patent Law of the German Democratic Republic, opposition may be lodged with the German Patent Office up to and including July 31, 1992. Sections 59 to 62 of the Patent Law shall apply.

Transfer of Correction Proceedings

14.–

Correction proceedings under Section 19 of the Patent Law of the German Democratic Republic still pending before the German Patent Office on May 1, 1992, shall be pursued, in the status in which they are, as limitation proceedings under Section 64 of the Patent Law.

Derivation

15.–

(1) The declaration under Section 5(1), first sentence, of the Utility Model Law may also be filed with respect to patents or patent applications extended under Section 4. This shall not apply to patents that have been granted or confirmed, after examination of compliance with all conditions of protection, by the former Patent Office of the German Democratic Republic.

(2) For those patents referred to in subsection (1), the declaration may be filed up to expiry of two months after the end of the month in which any examination proceedings or any opposition proceedings have been completed, but at most up to expiry of the tenth year after the filing date of the patent.

(3) Rights under Section 9, or based on Section 7(1) and (3), to use the invention on payment of appropriate remuneration and rights of continued utilization under Section 28 shall also apply with respect to a utility model derived under subsection (1).

SUBCHAPTER 3
SPECIAL PROVISIONS ON INVENTORS' CERTIFICATES AND INDUSTRIAL DESIGN PATENTS

Inventors' Certificates and Industrial Design Patents

16.–

(1) Inventors' certificates and industrial design patents extended under Section 4 shall be deemed designs within the meaning of the Designs Law. Section 5, first sentence, shall remain unaffected.

(2) For inventors' certificates extended under Section 4, the originating enterprise within the meaning of Section 4 of the Ordinance on Industrial Designs of January 17, 1974 (GBl. I, No. 15, p. 140), as amended by ordinance of December 9, 1988 (GBl. I, No. 28, p. 333), or its successor in title, shall be deemed the owner of the right.

Entitlement to Remuneration

17.–

Where the entitlement of a creator of a design or model to remuneration under the hitherto applicable provisions has already arisen, the remuneration shall be paid in accordance with these provisions.

Utilization Rights in Inventors' Certificates

18.–

Any person who has lawfully used a design or model, in accordance with the hitherto applicable provisions, protected by an inventor's certificate extended under Section 4 or in respect of which an inventor's certificate has been sought, may continue to use such design or model within the whole Federal territory. The owner of the right may require appropriate remuneration from the person entitled to use it with respect to its continued utilization.

Applications for Industrial Design Patents

19.–

(1) Where an application for an industrial design patent extended under Section 4 has been published under Section 10(1) of the Ordinance on Industrial Designs, this shall have the same status as the publication of the entry of an application in the Designs Register under Section 8(2) of the Design Law. Where the application has been entered, but has not yet been published, publication shall be effected in accordance with Section 8(2) of the Designs Law.

(2) Where the application has not yet been entered, also in those cases where examination of the requirements has already been effected under Section 9 of the Ordinance on Industrial Designs, processing of the application and its entry shall be effected in accordance with the provisions of the Designs Law; Section 10(3), second and third sentences, of the Designs Law shall not apply.

(3) If publication of an application has been deferred under Section 10(2) of the Ordinance on Industrial Designs and if the deferral period has not expired on May 1, 1992, publication shall be repeated in accordance with Section 8b(3) of the Designs Law, unless the owner of the design or the model has requested cancellation of the entry of the design or model, on expiry of the deferral period, but 18 months after October 3, 1990, at the latest. The German Patent Office shall notify the registered owner that the publication is to be repeated if no request for cancellation of the entry of the design or model is filed within one month of service of the notification.

(4) Any unfinished examination of the material requirements for protection under Section 11 of the Ordinance on Industrial Designs shall be terminated. The fee paid for the request for examination of the material requirements shall be refunded.

(5) Opposition under Section 10(3) of the Ordinance on Industrial Designs that has not yet been completed shall not be processed further by the German Patent Office.

SUBCHAPTER 4
SPECIAL PROVISIONS ON MARKS

Cancellation of Registered Marks Under
Section 10(2) of the Trademark Law

20.–

(1) Cancellation of a mark extended under Section 4 shall only be effected, either *ex officio* or on request under Section 10(2), item 2, of the Trademark Law, if the mark is not eligible for protection both under the hitherto applicable provisions and the provisions of the Trademark Law.

(2) Subsection (1) shall apply *mutatis mutandis* to requests for withdrawal of protection of a mark extended under Section 4 and that has been internationally registered in accordance with Section 10 of the Ordinance on the International Registration of Trademarks.

Cancellation of Registered Marks Under
Section 11 of the Trademark Law

21.–

(1) Cancellation of a mark extended under Section 4 and that has been entered on the basis of an application filed during the period from July 1 to October 2, 1990, inclusive, may also be requested by a third party under Section 11(1), item 1, of the Trademark Law if the mark has been entered in his name in the Trademark Register on the basis of an application with earlier priority for the same or similar goods and has been extended under Section 1. Such entry shall have the same status as an internationally registered mark under the Madrid Agreement Concerning the International Registration of Marks that has been extended under Section 1.

(2) Subsection (1) shall be applied *mutatis mutandis* to requests for withdrawal of protection for an internationally registered mark extended under Section 4 in accordance with Section 10 of the Ordinance on the International Registration of Trademarks.

Examination of Applications for Marks

22.–

(1) Trademark applications extended under Section 4 shall be subject to the provisions of the Trademark Law unless otherwise stipulated below.

(2) Entry may not be refused on the grounds that the sign applied for is a form of mark that may not be registered under the Trademark Law.

(3) Subsections (1) and (2) shall apply *mutatis mutandis* to internationally registered marks under the Madrid Agreement Concerning the International Registration of Marks that have been extended under Section 4.

Publication of Applications for Marks; Opposition

23.–

(1) Trademark applications extended under Section 4 shall be published in accordance with Section 5(2) or Section 6a(3) of the Trademark Law, even where examination has already been effected under the hitherto applicable provisions.

(2) Opposition may be lodged against entry of the application for marks referred to in subsection (1) in accordance with Section 5(4), first sentence, item 1, of the Trademark Law only by such persons who

1. have filed with the former Patent Office of the German Democratic Republic for the same or similar goods or services a mark with earlier priority, that has been extended under Section 4, that is the same as the mark applied for (Section 31 of the Trademark Law) or
2. in the event of the published sign having been filed with the former Patent Office of the German Democratic Republic in the period between July 1 and October 2, 1990, inclusive, have filed with the German Patent Office for the same or similar goods a mark with earlier priority, that has been extended under Section 1, that is the same as the mark applied for (Section 31 of the Trademark Law).

Internationally registered marks under the Madrid Agreement Concerning the International Registration of Marks that have been extended under Section 1 or Section 4 shall have the same status as the earlier applications referred to in items 1 and 2.

(3) Subsections (1) and (2) shall apply *mutatis mutandis* to opposition under Section 2 of the Ordinance on the International Registration of Trademarks where it is lodged against an internationally registered mark extended under Section 4.

Term of Protection

24.–

Section 9(1) of the Trademark Law shall apply for calculating the term of protection for marks extended under Section 4.

Transfer of Marks; Trademark Associations

25.–

(1) The transfer of rights in a trademark or trademark application extended under Section 4 shall be effective, notwithstanding Section 17(1), second sentence, of the Law on Distinctive Signs for Goods of November 30, 1984 (GBl. I, No. 33, p. 397), as amended by Section 2 of the Law of June 29, 1990 (GBl. I, No. 40, p. 571), without a corresponding entry in the Register.

(2) The cancellation of a collective mark extended under Section 1 or of a collective mark extended under Section 4 or the refusal of entry of such a mark may not be based on the fact that the association for which the mark was entered or filed does not have legal capability if such association was entered on May 1, 1992, in the Register of Associations under Section 7 of the Law on Distinctive Signs for Goods and if it or the person to whom the right in the application or entry of the sign has been transferred by the

association proves to the German Patent Office by April 30, 1993, at the latest, that he satisfies the requirements for filing an application for a collective mark under Section 17(1) or (2) and Section 18, first sentence, of the Law on Distinctive Signs for Goods; Section 20 of the Trademark Law shall not apply in such circumstances.

Chapter 3
Concurrent Rights; Rights of Prior Use and Continued Use

SUBCHAPTER 1
INVENTIONS, DESIGNS AND MODELS

Collision of Rights

26.–

(1) Where patents, patent applications or utility models extended under this Law to the territory designated in Article 3 of the Unification Treaty or to the remaining Federal territory are concurrent in their scope of protection and therefore collide as a result of extension, the owners of such titles or applications may not assert rights deriving from those titles or applications, irrespective of their priority, either against each other or against persons authorized by the owner of the other title or the other application to use them.

(2) However, the subject matter of the title or of the application may not be used or may only be used with restrictions in the territory to which the title or the application has been extended if unlimited use would lead to particular disadvantage for the owner of the other title or the other application or for persons he has authorized to use the subject matter of his title or his application and would be unreasonable when taking into account all the circumstances of the case and when weighing up the justified interests of those concerned.

(3) Subsections (1) and (2) shall apply *mutatis mutandis* where identical designs, inventors' certificates or industrial design patents or applications for such rights collide as a result of extension.

Rights of Prior Use

27.–

(1) If the effect of a patent or utility model extended under Section 1 or Section 4 is restricted by a right of prior use (Section 12 of the Patent Law, Section 13(3) of the Utility Model Law, Section 13(1) of the Patent Law of the German Democratic Republic), such right of prior use shall apply in the whole Federal territory with those limitations deriving from Section 12 of the Patent Law.

(2) Subsection (1) shall apply *mutatis mutandis* if the requirements for recognition of a right of prior use are satisfied in that territory in which the title did not hitherto apply.

Rights of Continued Use

28.–

(1) The effect of a patent or utility model extended under Section 1 or Section 4 shall not apply to any person who had lawfully begun to use the invention in that territory in which the title did not previously apply after the day that is operative for the priority of the application and prior to July 1, 1990. Such person shall be authorized to exploit the invention in the whole Federal territory for the needs of his own business in his own plant or workshops or the plant or workshops of others, on condition that the use does not cause particular prejudice to the owner of the title or the persons he has authorized to use the subject matter of his title and which would be unreasonable when taking into account all the circumstances of the case and when weighing up the justified interests of those concerned.

(2) In the case of a product manufactured abroad, the user shall only have a right of continued use under subsection (1) if use in Germany has led to a property situation that warrants protection and whose

non–recognition would represent an unreasonable hardship for the user, taking into account all the circumstances of the case.

(3) Subsections (1) and (2) shall apply *mutatis mutandis* to utility models, inventors' certificates and industrial design patents and semiconductor rights extended under Section 1 or Section 4.

Collision with Rights of Use Under **Section 23 of the Patent Law**

29.–

Where patents or patent applications for which a licensing declaration under Section 23 of the Patent Law has been made, or is deemed to have been made under Section 7, have a scope of protection identical with patents, patent applications or utility models and collide as a result of extension under this Law, the owners of the last–mentioned patents, applications or utility models may assert the rights in such titles of protection or such applications irrespective of the priority against the person entitled to use the invention under Section 23(3), fourth sentence, of the Patent Law. Section 28 shall remain unaffected.

SUBCHAPTER 2
TRADEMARKS AND OTHER DISTINCTIVE SIGNS

Trademarks

30.–

(1) Where a trademark extended under Section 1 to the territory designated in Article 3 of the Unification Treaty collides as a result of extension with an identical mark that has been extended under Section 4 to the remaining Federal territory, either mark may only be used in the territory to which it has been extended with the consent of the owner of the other mark.

(2) The mark may be used without the consent of the owner of the other mark in the territory to which it has been extended

1. for advertising in public announcements or in communications intended for a large number of persons where the dissemination of such public announcements or communications cannot reasonably be limited to the territory in which the mark previously applied,
2. if the owner of the mark can convincingly show that he is entitled, under the provisions of the Law on Property, to the return of the other mark or of the undertaking to which the other mark belongs,
3. if exclusion from use of the mark in that territory proves unreasonable taking into account all the circumstances of the case and weighing up the justified interests of those concerned and of the general public.

(3) In the cases referred to in subsection (2), items 1 and 3, the owner of the mark may require appropriate compensation from the person who uses the other mark where he suffers prejudice beyond an acceptable degree due to the use.

(4) Where the claim to return in the case of subsection (2), item 2, proves unfounded, the owner of the trademark shall be obliged to make good the damage suffered by the owner of the identical mark by reason of the fact that the mark has been used without his consent in the territory to which it has been extended.

Other Rights in Distinctive Signs

31.–

Where trademarks extended under this Law to the territory designated in Article 3 of the Unification Treaty or to the remaining Federal territory collide with a name, a company name, a special designation of an undertaking or other right in a distinctive sign that has been acquired by use, Section 30 shall apply *mutatis mutandis*.

Right of Continued Use

32.–

The effect of a registered mark or an application for a mark extended under Section 4 to the remaining Federal territory, which would be excluded from registration under Section 1 or Section 4(1) or (2), item 1, of the Trademark Law, shall not be assertable against a person who had already lawfully used before July 1, 1990, an identical mark for the same or similar goods or services in the remaining Federal territory. Such person shall be entitled to use the mark in the whole Federal territory insofar as use does not cause particular prejudice to the owner of the mark or to the persons he has authorized to use the mark, which would be unreasonable when taking into account all the circumstances of the case and when weighing up the justified interests of those concerned and of the general public.

PART 2
CONVERSION OF INDICATIONS OF SOURCE TO COLLECTIVE MARKS

Conversion

33.–

(1) The indications of source entered in the Register of Indications of Source and the indications of source for which entry in that Register has been applied for shall be converted, on request, to collective marks (Sections 17 to 23 of the Trademark Law) in accordance with the provisions below.

(2) Indications of source converted to collective marks shall enjoy in the remaining Federal territory the same priority as in the territory designated in Article 3 of the Unification Treaty.

Request for Conversion

34.–

(1) A request for conversion may only be filed by the associations with legal personality or public law legal persons referred to in Section 17 of the Trademark Law.

(2) A request for conversion must be filed by the close of April 13, 1993. The request shall not be subject to fees. There shall be no reinstatement of rights in the event of failure to comply with the time limit.

(3) If no request is made within the time limit stated in subsection (2), the right deriving from entry in the Register of Indications of Source or the right deriving from the application for an indication of source shall expire. Expiry shall be noted in the Register or in the application file.

(4) The expiry of rights under subsection (3) shall not prejudice the entitlement to assert claims with respect to the indications of source concerned under general rules of law.

Application of the Trademark Law

35.–

A request for conversion shall be dealt with, where not otherwise provided below, as an application for a collective mark under Sections 17 to 23 of the Trademark Law.

Collision of Converted Indications of Source and Trademarks

36.–

Sections 2 and 3, 20 to 24 and 30 to 32 shall apply *mutatis mutandis* to requests for conversion of indications of source to collective marks and to converted indications of source registered as collective marks.

Eligibility for Protection of Converted Indications of Source

37.–

Where the other requirements for registration of a collective mark are satisfied, the conversion to a collective mark of an indication of source that has been registered or applied for may not be refused on the grounds that it does not constitute an indication of source unless the designation has lost its original meaning as a geographical indication and the trade circles concerned throughout the whole Federal territory understand it exclusively as the name of goods or the designation of a type or variety of product.

Right of Continued Use

38.–

(1) Where an indication of source that has been converted to a collective mark collides in the remaining Federal territory with an identical designation that was lawfully used there prior to July 1, 1990, as a generic designation, the designation may continue to be used as a designation for identifying goods or packaging or in announcements, price lists, business letters, recommendations, invoices and the like for two years after the registration of the collective mark. Goods or packaging marked in such way or announcements, price lists, business letters, recommendations, invoices or the like still in stock on expiry of that period may continue to be sold or used up until expiry of a further two years.

(2) Where an indication of source that has been converted to a collective mark collides in the remaining Federal territory with an identical designation that had lawfully been used there prior to July 1, 1990, by an undertaking that has continued the tradition, with regard to the use of that designation, of a commercial undertaking originally located in the territory designated in Article 3 of the Unification Treaty, subsection (1) shall apply *mutatis mutandis* with the proviso that the time limit for continued use under the first sentence shall be 10 years.

PART 3
CONCILIATION PROCEDURE

Conciliation Board

39.–

(1) In civil law disputes arising from the collision of industrial property rights or rights of use extended under this Law, any of the parties may at any time appeal to the Conciliation Board.

(2) The Conciliation Board shall have the task of negotiating an amicable settlement between the parties in disputes of the type referred to in subsection (1).

(3) The Conciliation Board shall be established at the German Patent Office. It may also meet outside its headquarters.

Composition of the Conciliation Board

40.–

(1) The Conciliation Board shall comprise a Chairman, or his deputy, and two assessors.

(2) The Chairman and his deputy must possess the qualifications required for judicial office under the German Law on Judges and have experience in the field of industrial property. They shall be appointed by the Federal Minister of Justice at the beginning of each calendar year for the duration of that year.

(3) The assessors shall be appointed by the Chairman for each individual dispute from a list of assessors to be drawn up by the President of the German Patent Office each year for that calendar year. Appointment shall be with the consent of the parties. Where the parties make a mutually agreed proposal, the Chairman shall accept that proposal, as a rule, even if the proposed persons are not included in the list.

(4) Sections 41 to 43 and Section 44(2) to (4) of the Code of Civil Procedure shall apply *mutatis mutandis* to the exclusion and refusal of members of the Conciliation Board. The petition for refusal shall be heard by the Federal Patent Court.

Honorary Office; Supervision

41.–

(1) The members of the Conciliation Board shall carry out their activities in an honorary capacity. The Chairman and his deputy may also be appointed on a full–time basis.

(2) Prior to their first official duties, the Chairman and his deputy shall be bound by the Federal Minister of Justice, and the assessors shall be bound by the Chairman, to conscientious and impartial exercise of their office and to secrecy with regard to the facts that become known to them in their official capacity.

(3) Official supervision of the Conciliation Board shall lie with the Chairman and official supervision of the Chairman with the Federal Minister of Justice.

Proceedings Before the Conciliation Board

42.–

(1) Appeals to the Conciliation Board shall be lodged by means of a written petition. The petition shall contain a brief description of the facts together with the name and address of the other party.

(2) Sections 1035 and 1036 of the Code of Civil Procedure shall apply *mutatis mutandis* to proceedings before the Conciliation Board. Section 1034(1) of the Code of Civil Procedure shall apply *mutatis mutandis* with the proviso that patent attorneys, holders of certificates of representation and, in the framework of Section 156 of the Code of Patent Attorneys, patent assessors may not be refused by the Conciliation Board.

(3) In all other cases, the Conciliation Board shall determine its procedure itself. It may require the personal appearance of the parties.

Conciliation Proposal; Settlement

43.–

(1) The Conciliation Board shall take its decisions on a majority vote. Section 196(2) of the Judiciary Law shall apply.

(2) The Conciliation Board may submit the written conciliation proposal to the parties. The conciliation proposal may only be published with the consent of the parties.

(3) A settlement reached before the Conciliation Board shall be enforceable if it is recorded in a separate written document signed by the members of the Conciliation Board who participated in the negotiations and by the parties, bearing the date on which it was reached. Section 797a of the Code of Civil Procedure shall apply *mutatis mutandis.*

Interruption of Prescription

44.–

An appeal to the Conciliation Board shall interrupt prescription in the same way as the lodging of an appeal. Interruption shall continue until the proceedings before the Conciliation Board are terminated. If no settlement is reached, the Conciliation Board shall determine the time at which the proceedings are ended. The Chairman shall inform the parties thereof. Where appeal to the Conciliation Board is withdrawn, interruption of prescription shall be deemed not to have occurred.

Costs of Conciliation Proceedings

45.–

(1) A fee of DM 300 shall be paid together with the request for appeal to the Conciliation Board. If the fee is not paid, the request shall be deemed not to have been submitted.

(2) The Ordinance on Administrative Costs Before the German Patent Office shall apply *mutatis mutandis* to payment of the fee in accordance with subsection (1) and the determination of costs.

(3) The Conciliation Board shall endeavor to obtain amicable agreement of the parties on the liability for the costs incurred by the proceedings. This shall also apply where no agreement has been reached in the matter itself. Where no agreement is reached as to the sharing of costs, the Conciliation Board shall decide on the sharing of the costs incurred in accordance with subsection (2) at its discretion; in all other cases, each party shall itself bear the costs it has incurred.

(4) An appeal shall lie to the Federal Patent Court from decisions taken under subsection (2) and subsection (3), third sentence. The provisions of the Patent Law with regard to appeals procedure shall apply *mutatis mutandis*, with the exception of Sections 76 to 78.

Compensation of Members of the Conciliation Board

46.–

The members of the Conciliation Board acting in an honorary capacity shall receive compensation in accordance with Sections 2 to 5 and 9 to 11 of the Law on Compensation for Honorary Judges; the condition under Annex I, Chapter III, Field A, Section III, item 24, of the Unification Treaty of August 31, 1990 (BGBl. 1990, II, pp. 885, 936) shall not apply. The compensation shall be determined by the President of the German Patent Office. Section 12 of the Law of Compensation for Honorary Judges shall apply *mutatis mutandis*. The Federal Patent Court shall be competent for the judicial determination.

PART 4
AMENDMENT OF LAWS

Amendment of the Trademark Law

47. ....[1]

Amendment of the Law on the Fees of the Patent Office and of the Patent Court

48. ....[1]

PART 5
TRANSITIONAL AND FINAL PROVISIONS

Employee Inventions

49.–

The provisions of the Law on Employee Inventions shall apply to inventions made prior to October 3, 1990, in the territory designated in Article 3 of the Unification Treaty with regard to the

[1] Not reproduced here *(Editor's note)*.

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generation and due date of claims to remuneration in the case of unlimited use of a service invention, where the claim to remuneration has not arisen by May 1, 1992, as also the provisions on arbitration proceedings and on court proceedings. In all other cases, the provisions hitherto applicable shall remain applicable to them (Annex I, Chapter III, Field E, Section II, item 1, Article 11 of the Unification Treaty of August 31, 1990, BGBl. 1990 II, pp. 885, 962).

Transfer of Mediation Proceedings

50.–

Proceedings still pending before the mediation office for remuneration disputes of the German Patent Office on May 1, 1992, shall be transferred, in their current status, to the arbitration board set up at the German Patent Office under the Law on Employee Inventions.

Transfer of Appeal and Revocation Proceedings

51.–

(1) Proceedings still pending before an appeal instance or a revocation instance of the German Patent Office on May 1, 1992, shall be transferred, in their current status, to the Federal Patent Court.

(2) Proceedings still pending before a cancellation instance for trademarks of the German Patent Office on May 1, 1992, shall be pursued by the Trademark Division of the German Patent Office.

Time Limits

52.–

Where the subject matter of proceedings is a right that has been extended under Section 4, or an application for a right extended under Section 4, the course of any procedural time limit that has begun before May 1, 1992, shall be determined by the hitherto applicable provisions.

Fees

53.–

(1) Fees for rights and applications for rights extended under Section 4 that became due before May 1, 1992, shall be paid according to the hitherto applicable provisions.

(2) Where a fee that becomes due after May 1, 1992, has already been effectively paid prior to that date in accordance with the previous schedule of fees, the due fees shall be deemed to have been paid.

Application of the Law on Unfair Competition and of Other Statutory Provisions

54.–

Application of the Law on Unfair Competition and the general rules of law on the acquisition or exercise of rights, particularly those on the abuse of rights, shall not be effected by the provisions of this Law.

Entry Into Force

55.–

This Law shall enter into force on the first day of the calendar month following its promulgation.