

Law of 1996 Amending the Trade Mark Law*

The Bundestag has adopted the following Law:

Article 1 Amendment of the Trade Mark Law*

The Trade Mark Law of October 25, 1994 (BGBl. I p. 3082, 1995 I p. 156) shall be amended as follows:

1. Section 27(4) shall read as follows:
“(4) Where the transfer of rights concerns only some of the goods or services for which the trade mark is registered, a fee as prescribed in the schedule of fees shall be paid with the request for recordal of the transfer. If the fee is not paid, the request shall be deemed not to have been filed. In other respects, the provisions concerning the division of the registration shall apply *mutatis mutandis* with the exception of Section 46(2) and (3), sentences 1 to 3.”
2. Section 29(3) shall read as follows:
“(3) Where the right conferred by the registration of a trade mark is involved in insolvency proceedings, an entry to this effect shall be made in the Register on request of the administrator in insolvency proceedings or the insolvency court. In case of self-administration (Section 270 of the Order Concerning Insolvency Proceedings), the administrator in self-administration proceedings shall take the place of the administrator in insolvency proceedings.”
3. In Section 65(1) No. 7 there shall be substituted a comma for “and” after “inspection of the files”. The words “trade marks” shall be followed by “and the procedure concerning the conversion of Community trade marks”.
4. There shall be added to the heading of Part 5 a semicolon followed by “Community Trade Marks”.
5. There shall be inserted after Section 125 the following new chapter:

“Chapter 3 Community Trade Marks

Filing of Applications for Community Trade Marks with the Patent Office

Sec. 125a.— If applications for Community trade marks are filed with the Patent Office under Article 25(1) (b) of the Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community trade mark (OJ EC No. L 11, p. 1), the Patent Office shall mark the application with the date of its receipt and transmit it immediately and without examination to the Office for Harmonization in the Internal Market (Trade Marks and Designs).

* German title: Markenrechtsänderungsgesetz 1996 Entry into force: July 25, 1996

Source: Bundesgesetzblatt, No. 36 of July 24, 1996

Note: English translation by the German Patent Office, communicated by the German authorities

Application of the Provisions of this Law

Sec. 125b.— The provisions of this Law shall apply to trade marks filed or registered under the Council Regulation on the Community trade mark in the following cases:

1. In view of the application of Section 9 (relative grounds for refusal), earlier filed or registered Community trade marks shall have equal status as earlier trade marks filed or registered under this Law subject, however, to the proviso that a reputation in the Community under Article 9(1) (c), sentence 2, of the Council Regulation on the Community trade mark shall be substituted for a reputation in the Federal Republic of Germany under Section 9(1), No. 3.
2. In addition to the rights under Articles 9 to 11 of the Council Regulation on the Community trade mark, the proprietor of a registered Community trade mark shall have the same rights to compensation for damages (Section 14(6) and (7)), destruction (Section 18) and information (Section 19) as the proprietor of a trade mark registered under this Law.
3. If rights resulting from a registered Community trade mark are asserted in respect of the use of a later trade mark registered under this Law, Section 21(1) (forfeiture) shall apply *mutatis mutandis*.
4. If an opposition against the registration of a trade mark (Section 42) is based on an earlier registered Community trade mark, Section 43(1) (prima facie evidence of use) shall apply *mutatis mutandis* subject to the proviso that the use of the earlier Community trade mark under Article 15 of the Council Regulation on the Community trade mark shall be substituted for the use of the earlier trade mark under Section 26.
5. If a request for cancellation of the registration of a trade mark (Section 51(1)) is based on an earlier Community trade mark, the following shall apply *mutatis mutandis*:
 - (a) Section 51(2), first sentence (forfeiture);
 - (b) Section 55(3) (proof of use) subject to the proviso that use of the Community trade mark under Article 15 of the Council Regulation on the Community trade mark shall be substituted for use of an earlier trade mark under Section 26.
6. Requests for seizure on import or export may be filed by the proprietors of registered Community trade marks in the same way as by the proprietors of trade marks registered under this Law. Sections 146 to 149 shall apply *mutatis mutandis*.

Later Invalidation of a Trade Mark

Sec. 125c.—

- (1) Where, in respect of a filed or registered Community trade mark, the seniority of a trade mark recorded in the Register of the Patent Office has been claimed under Article 34 or 35 of the Council Regulation on the Community trade mark and where the trade mark recorded in the Register of the Patent Office has been cancelled due to non-renewal of the period of protection under Section 47(6) or surrender under Section 48(1), the invalidity of the said trade mark on grounds of revocation or nullity may be established later upon request.
- (2) Invalidity shall be established on the same conditions as cancellation on grounds of revocation or nullity. However, the invalidity of a trade mark on grounds of revocation under Section 49(1) may only be established if the conditions for cancellation under the said provision were already fulfilled at the date of cancellation of the trade mark due to non-renewal of the period of protection or surrender.
- (3) The invalidation procedure shall be governed by the provisions applicable to the procedure for cancellation of a registered trade mark subject to the proviso that the establishment of invalidity of a trade mark shall be substituted for the cancellation of its registration.

Conversion of Community Trade Marks

Sec. 125d.—

- (1) If a request for conversion of a filed or registered Community trade mark has been transmitted to the Patent Office under Article 109(3) of the Council Regulation on the Community trade mark, the applicant

shall pay a fee as specified in the schedule of fees within a period of two months from the receipt of the request for conversion by the Patent Office. Where conversion is requested in respect of goods or services coming under more than three classes of the Classification of goods and services, a class fee as specified in the schedule of fees shall be payable for each further class. If the fee is not paid in time, the request for conversion shall be deemed not to have been filed.

(2) The Patent Office shall examine if the request for conversion is admissible under Article 108(2) of the Council Regulation on the Community trade mark. If the request for conversion is inadmissible, it shall be refused.

(3) Where the request for conversion concerns a trade mark not yet registered as a Community trade mark, the request for conversion shall be treated as an application for the recordal of a trade mark in the Register of the Patent Office subject to the proviso that the date of filing of the Community trade mark within the meaning of Article 27 of the Council Regulation on the Community trade mark or the date of a priority claimed in respect of a Community trade mark shall be substituted for the date of filing within the meaning of Section 33(1). If the seniority of a trade mark recorded in the Register of the Patent Office is claimed under Article 34 of the Council Regulation on the Community trade mark, the said seniority shall be substituted for the relevant date under sentence 1.

(4) Where the request for conversion concerns a trade mark already registered as a Community trade mark, the Patent Office shall directly record the trade mark in the Register under Section 41 without further examination while maintaining its original seniority. Opposition to the registration shall not be admitted.

(5) In other respects, the provisions of this Law concerning the application for trade marks shall apply to requests for conversion.

Community Trade Mark Courts; Community Trade Mark Litigation

Sec. 125e.–

(1) For all actions for which the Community trade mark courts have jurisdiction within the meaning of Article 91(1) of the Council Regulation on the Community trade mark (Community Trade Mark Litigation), the District Courts (Landgerichte) shall have exclusive jurisdiction as Community trade mark courts of first instance without regard to the value in dispute.

(2) Community trade mark court of second instance shall be the Higher Regional Court (Oberlandesgericht) in the district of which the Community trade mark court of first instance is located.

(3) The governments of the Länder shall have the power to allot by legal ordinance Community trade mark litigations for the areas of several Community trade mark courts to one such court. The governments of the Länder may transfer those powers by legal ordinance to the Ministries of Justice of the Länder.

(4) The Länder may transfer by agreement, in whole or in part, the functions incumbent upon the Community trade mark courts of one Land to the competent Community trade mark court of another Land.

(5) Section 140(3) to (5) shall apply *mutatis mutandis* to proceedings before the Community trade mark courts.

Information of the Commission

Sec. 125f. The Federal Ministry of Justice shall notify the Commission of the European Communities of the Community trade mark courts of first and second instance as well as of any change in the number, names or territorial jurisdiction of the Community trade mark courts of first and second instance.

Territorial Jurisdiction of the Community Trade Mark Courts

Sec. 125g. Where German Community trade mark courts have international jurisdiction under Article 93 of the Council Regulation on the Community trade mark, such provisions concerning territorial jurisdiction shall apply *mutatis mutandis* as would be applicable to trade mark applications filed with the Patent Office or

trade marks recorded in the Register of the Patent Office. Where jurisdiction has not been established accordingly, the court having territorial jurisdiction shall be the court where the plaintiff has his general venue.

Insolvency Proceedings

Sec. 125h.–

(1) Where it is known to the insolvency court that a filed or registered Community trade mark is among the insolvency assets, it shall directly request of the Office for Harmonization in the Internal Market (Trade Marks and Designs) the recordal in the Community Trade Mark Register or, in case of an application, in the files of the application of

1. the opening of the proceedings and, insofar as it is not contained therein, the order of a limitation of the right of disposal;
2. the release or realization of the Community trade mark or of the Community trade mark application;
3. the final stay of proceedings and
4. the final cancellation of the proceedings in case of control of the debtor, however, only after the conclusion of control, and the limitation of the right of disposal.

(2) The recordal in the Community Trade Mark Register or in the files of the application may also be requested by the administrator in insolvency proceedings. In case of self-administration (Section 270 of the Order Concerning Insolvency Proceedings), the administrator in self-administration proceedings shall take the place of the administrator in insolvency proceedings.”

6. Section 143 shall be amended as follows:

(a) There shall be inserted a new subsection (1a):

“(1a) Any person who infringes the rights of the proprietor of a trade mark protected under the legal provisions of the European Community shall be punished in the same way insofar as a legal ordinance under subsection (7) refers to this penal provision in connection with a specific offense.”

(b) In subsection (4), “in subsections (1) and (1a)” shall be substituted for “in subsection (1)”.

(c) There shall be added the following subsection (7):

“(7) The Federal Ministry of Justice shall have power to determine by legal ordinance and without the consent of the Federal Council the offenses punishable as criminal offenses under subsection (1a) insofar as this is necessary in view of implementing the protection of trade marks in legal provisions of the European Community.”

7. Section 144(1) shall be amended as follows:

(a) In No. 1 “also in conjunction, respectively, with subsection (4) or a legal ordinance under Section 137(1)” shall be substituted for “also in conjunction with subsection (4)”.

(b) In No. 2, “or a legal ordinance under Section 137(1)” shall be inserted after the indication “subsection (4)”.

8. In Section 146 subsection (1), sentence 1, “Council Regulation (EEC) No. 3295/94 of December 22, 1994, Laying Down Measures to Prohibit the Release for Free Circulation, Export, Re-export or Entry for a Suspensive Procedure of Counterfeit and Pirated Goods (OJ EC No. L 341, p. 8)” shall be substituted for “Council Regulation (EEC) No. 3842/86 of December 1, 1986, Laying Down Measures to Prohibit the Release for Free Circulation of Counterfeit Goods (OJ EC No. L 357, p. 1)”.

9. In the heading of Section 150, the indication “Regulation (EEC) No. 3295/94” shall be substituted for the indication “Regulation (EEC) No. 3842/86”.

10. There shall be added the following Section 165:

**“Transitional Provision in View
of the Revision of Insolvency Law**

Sec. 165. Until January 1, 1999, Section 125h shall apply subject to the proviso that bankruptcy proceedings shall be substituted for insolvency proceedings, bankruptcy court for insolvency court, bankruptcy assets for insolvency assets and administrator in bankruptcy proceedings for administrator in insolvency proceedings.”

Article 2

Amendment of the Judiciary Law

In Section 95(1) No. 4(c) of the version of the Judiciary Law notified on 9 May 1975 (Federal Law Gazette [BGBl.] Part I p. 1077), which was lastly amended by Article 2 of the Act dated 16 June 1995 (Federal Law Gazette Part I p. 818), the words “of trade marks and other signs, as well as designs and models” shall be substituted for the words “of trade names, designs and models”.

Article 3

Amendment of the Code of Criminal Procedure

In Section 374(1) No. 8 of the Code of Criminal Procedure as published on April 7, 1987 (BGBl. I, p. 1074, 1319), last amended by Article 9(2) of the Law of August 21, 1995 (BGBl. I, p. 1050) the indication “and (1a)” shall be inserted after “Section 143(1)”.

Article 4

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

The annex to Section 1 (Schedule of Fees) of the Law Concerning the Fees of the Patent Office and the Patent Court of August 18, 1976 (BGBl. I, p. 2188) last amended by Article 20 of the Law of October 25, 1994 (BGBl. I, p. 3082) shall be amended as follows:

1. In Nos. 131 700 and 133 400, “or transfer in part” shall be inserted after “division”, respectively.
2. The words “or a Community trade mark” shall be added to the heading preceding No. 135 100.
3. In Nos. 135 100 to 135 300, the indication “Sec. 125d (1)” shall be inserted after the indication “Sec. 125(2)”, respectively.

Article 5

Amendment of the Law Dealing
with Copyright and Related Rights

Section 111a of the Law Dealing with Copyright and Related Rights of September 9, 1965 (BGBl. I, p. 1273) last amended by the Law of June 23, 1995 (BGBl. I, p. 842) shall be amended as follows:

1. In subsection (1), sentence 1, “insofar as the Council Regulation (EEC) No. 3295/94 of December 22, 1994, Laying Down Measures to Prohibit the Release for Free Circulation, Export, Re-Export or Entry for a Suspensive Procedure of Counterfeit and Pirated Goods (OJ EC No. L 341, p. 8) is not applicable in its applicable version” shall be inserted after “the copies”.
2. There shall be added the following new subsection (8):
“(8) In proceedings under the Council Regulation (EEC) No. 3295/94 subsections 1 to 7 shall apply *mutatis mutandis* unless otherwise provided by the Council Regulation.”

Article 6
Entry into Force

- (1) Article 1 No. 2 of this Law shall enter into force on January 1, 1999.
 - (2) In other respects this Law shall enter into force on the day following its promulgation.
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