

# Law on the Protection of Trade Marks and Other Signs (Trade Mark Law)\*

(Text of October 25, 1994, as last amended by the Law of July 16, 1998)

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## **PART 1 SCOPE**

### *Protected Trade Marks and Other Signs*

1. The following shall be protected under this Law:

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

### *Application of Other Provisions*

2. The protection of trade marks, commercial designations and indications of geographical origin under this Law shall not exclude the application of other provisions for the protection of these signs.

## **PART 2 PREREQUISITES, SCOPE AND LIMITS OF PROTECTION OF TRADE MARKS AND COMMERCIAL DESIGNATIONS; TRANSFER AND LICENSE**

### **Chapter 1**

#### **Trade Marks and Commercial Designations; Priority and Seniority**

### *Signs Capable of Being Protected as Trade Marks*

3.—(1) Any signs, particularly words, including personal names, designs, letters, numerals, sound marks, three-dimensional configurations, including the shape of goods or their wrapping as well as other packaging, including colors and combinations of colors, which are capable of distinguishing the goods or services of one undertaking from those of other undertakings may be protected as trade marks.

(2) Signs which consist exclusively of a shape

1. which results from the nature of the goods themselves;
  2. which is necessary to obtain a technical result; or
  3. which gives substantial value to the goods,
- shall not be capable of being protected as trade marks.

### *Accrual of Trade Mark Protection*

4. Trade mark protection shall accrue

1. by registration of a sign as a trade mark in the Register kept at the Patent Office;

2. through the use of a sign in the course of trade insofar as the sign has acquired a secondary meaning as a trade mark within the affected trade circles; or
3. by notoriety as a trade mark within the meaning of [Article 6bis](#) of the Paris Convention for the Protection of Industrial Property (Paris Convention).

### *Commercial Designations*

**5.**—(1) Company symbols and titles of works shall be protected as commercial designations.

(2) Company symbols are signs used in the course of trade as names, firm names or special designations of business establishments or enterprises. Business symbols and other signs intended to distinguish one business from another which are regarded within the affected trade circles as the distinctive signs of a business establishment, shall be equivalent to the special designation of a business establishment.

(3) Titles of works are the names or special designations of printed publications, cinematographic works, musical works, dramatic works or other comparable works.

### *Priority and Seniority*

**6.**—(1) Where, in the case of collision of rights within the meaning of [Sections 4, 5](#) and [13](#), the seniority of rights is relevant under this Law for determining the priority of such rights, seniority shall be determined pursuant to [subsections \(2\)](#) and [\(3\)](#).

(2) For filed or registered trade marks the date of filing ([Section 33\(1\)](#)) shall be relevant for determining seniority or, where priority has been claimed pursuant to [Section 34](#) or [Section 35](#), the date of priority.

(3) For rights within the meaning of [Section 4, Nos. 2](#) and [3](#), and [Sections 5](#) and [13](#), the date of the acquisition of such rights shall be relevant for determining seniority.

(4) Rights having the same seniority pursuant to [subsections \(2\)](#) and [\(3\)](#) due to the same date shall rank equally and shall not establish any rights in respect of each other.

## **Chapter 2**

### **Prerequisites for the Protection of Trade Marks by Registration**

#### *Proprietorship*

**7.** The following may be proprietors of registered and filed trade marks:

1. natural persons;
2. legal persons; or
3. partnerships having capacity to acquire rights and incur liabilities.

#### *Absolute Grounds for Refusal*

8.—(1) Signs that are capable of being protected as a trade mark within the meaning of [Section 3](#), but not capable of being represented graphically, shall not be registered.

(2) The following shall not be registered:

1. trade marks which are devoid of any distinctive character with respect to the goods or services;
2. trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of the rendering of the services, or to designate other characteristics of the goods or services;
3. trade marks 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 for designating goods or services;
4. trade marks which are of such a nature as to deceive the public, in particular, as to the nature, quality or geographical origin of the goods or services;
5. trade marks which are contrary to public policy or to accepted principles of morality;
6. trade marks which include armorial bearings, flags or other emblems of State, or armorial bearings of a locality, an association of communities or an association of other communal entities within the country;
7. trade marks which include official signs and hallmarks, indicating control and warranty, which, according to a notice published by the Federal Ministry of Justice in the Federal Law Gazette [*Bundesgesetzblatt*], cannot be validly registered as trade marks;
8. trade marks which include armorial bearings, flags or other signs, seals, or designations, of international intergovernmental organizations which, according to a notice published by the Federal Ministry of Justice in the Federal Law Gazette, cannot be validly registered as trade marks; or
9. trade marks the use of which can obviously be prohibited pursuant to other provisions in the public interest.

(3) [Subsection \(2\), Nos. 1, 2 and 3](#), shall not apply if the trade mark has, before the date of the decision on registration and following the use which has been made of it, established itself in affected trade circles as the distinguishing sign for the goods or services for which it has been filed.

(4) [Subsection \(2\), Nos. 6, 7 and 8](#), shall also apply if the trade mark includes the imitation of a sign specified therein. [Subsection \(2\), Nos. 6, 7 and 8](#), shall not apply where the applicant is authorized to include one of the signs specified therein in his trade mark even if it may be confused with another of the signs specified therein. Furthermore, [subsection \(2\), No. 7](#), shall not apply where the goods or services for which the application for registration of the trade mark has been filed are neither identical with nor

similar to those for which the sign or hallmark, indicating control or warranty, has been introduced. Furthermore, [subsection \(2\), No. 8](#), shall not apply where the trade mark filed is not of such a nature as to falsely suggest to the public that a connection exists between the trade mark and the international intergovernmental organization.

### *Filed or Registered Trade Marks as Relative Grounds for Refusal*

#### **9.—(1)** Registration of a trade mark may be canceled

1. if it is identical with an earlier filed or registered trade mark, and the goods or services for which the trade mark is registered are identical with the goods or services for which the earlier trade mark is filed or is registered;
2. if because of its identity with, or similarity to, the earlier filed or registered trade mark, and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the other trade marks; or
3. if it is identical with or similar to an earlier filed or registered trade mark, and has been registered for goods or services which are not similar to those for which the earlier trade mark is filed or registered, where the earlier trade mark has a reputation in the Federal Republic of Germany and where the use of the registered trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of such trade mark.

(2) Applications for trade marks constitute grounds for refusal within the meaning of [subsection \(1\)](#) only if they are registered.

### *Well-Known Trade Marks*

**10.—(1)** A trade mark shall not be registered if it is identical with or similar to an earlier trade mark well known in the Federal Republic of Germany within the meaning of [Article 6bis](#) of the Paris Convention and if the additional requirements under [Section 9\(1\), Nos. 1, 2 or 3](#), are met.

(2) [Subsection \(1\)](#) shall not apply if the applicant has been authorized to file the application by the proprietor of the well-known trade mark.

### *Trade Mark Registered in the Name of an Agent*

**11.** Where a trade mark is registered in the name of the agent or representative of a person who is the proprietor of the trade mark, without the proprietor's authorization, the registration of the trade mark may be canceled.

### *Trade Mark Acquired by Use and Commercial Designations Having Seniority*

**12.** The registration of a trade mark may be canceled where another person, prior to the date relevant for the seniority of the registered trade mark, has acquired rights to a

trade mark within the meaning of [Section 4, No. 2](#), or to a commercial designation within the meaning of [Section 5](#), and those rights confer on him the power to prohibit the use of the registered trade mark throughout the entire territory of the Federal Republic of Germany.

### *Other Earlier Rights*

**13.**—(1) The registration of a trade mark may be canceled where another person, prior to the date relevant for the seniority of the registered trade mark, has acquired a right other than the rights specified in [Sections 9 to 12](#), and that right confers on him the power to prohibit the use of the registered trade mark throughout the entire territory of the Federal Republic of Germany.

(2) The other rights within the meaning of [subsection \(1\)](#) include

1. rights in a name;
2. a right of personal portrayal;
3. copyrights;
4. names of plant varieties;
5. indications of geographical origin;
6. other industrial property rights.

## **Chapter 3**

### **Scope of Protection; Infringements of Rights**

#### *Exclusive Right of the Proprietor of a Trade Mark; Injunctive Relief; Damages*

**14.**—(1) The acquisition of trade mark protection pursuant to [Section 4](#) shall confer on the proprietor of the trade mark exclusive rights therein.

(2) Third parties shall be prohibited from using in the course of trade, without the consent of the proprietor of the trade mark,

1. any sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is protected;
2. any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public, including the likelihood of association between the sign and the trade mark; or
3. any sign which is identical with or similar to the trade mark in relation to goods or services which are not similar to those for which the trade mark is protected; where the trade mark has a reputation in the Federal Republic of Germany and where the use of that sign without due cause takes unfair

advantage of, or is detrimental to, the distinctive character or the repute of such trade mark.

(3) If the prerequisites specified in [subsection \(2\)](#) are met, the following, in particular, shall be prohibited:

1. affixing the sign to goods or to their packaging or wrapping;
2. offering the goods, putting them on the market or stocking them for these purposes under that sign;
3. offering or supplying services under that sign;
4. importing or exporting the goods under that sign;
5. using the sign on business papers or in advertising.

(4) Without having the consent of the proprietor of the trade mark, third parties shall be prohibited in the course of trade from

1. affixing a sign which is identical with or similar to the trade mark to packaging or wrappings or to means of marking such as labels, tags, sewn-on labels or the like;
2. offering packaging, wrappings or the means of marking under a sign which is identical with or similar to the trade mark, putting them on the market or stocking them for these purposes under that sign; or
3. importing or exporting packaging, wrappings or means of marking under a sign which is identical with or similar to the trade mark,

if there is a risk that the packaging or wrappings are being used for the packaging or the wrapping of goods or services, or the means of marking for marking goods or services, in respect of which, pursuant to [subsections \(2\)](#) and [\(3\)](#), third parties would be prohibited from using that sign.

(5) Any person who uses a sign in breach of [subsections \(2\) to \(4\)](#) may be sued by the proprietor of the trade mark to enjoin such use.

(6) Any person who undertakes such infringing action intentionally or negligently shall be liable for compensation to the proprietor of the trade mark for damage suffered therefrom.

(7) Where an employee or an authorized representative undertakes such infringing action in a business establishment, the proprietor of the business establishment may be sued by the proprietor of the trade mark to enjoin such use and, where the employee or authorized representative has undertaken such action intentionally or negligently, compensation for damages may also be claimed from the proprietor of the business establishment.

### *Exclusive Right of the Proprietor of a Commercial Designation; Injunctive Relief; Damages*

**15.—**(1) The acquisition of protection for a commercial designation shall confer on its proprietor an exclusive right.

(2) Third parties shall be prohibited from using in the course of trade, without authorization, the commercial designation or a similar sign in a manner capable of causing confusion with the protected designation.

(3) Where the commercial designation has a reputation in this country, third parties shall also be prohibited from using the commercial designation or a similar sign in the course of trade if there is no risk of confusion within the meaning of [subsection \(2\)](#), where the use of that 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 in breach of [subsections \(2\)](#) or [\(3\)](#) may be sued by the proprietor of the commercial designation to enjoin such use.

(5) Any person who undertakes such infringing action intentionally or negligently shall be liable for compensation to the proprietor of the commercial designation for damage suffered therefrom.

(6) [Section 14\(7\)](#) shall apply *mutatis mutandis*.

### *Reproduction of a Registered Trade Mark in Reference Works*

**16.—**(1) If the reproduction of a registered trade mark in a dictionary, encyclopedia, or similar reference work gives the impression that it constitutes the generic name of the goods or services for which the trade mark is registered, the proprietor of the trade mark is entitled to demand of 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, this claim shall be limited to incorporating the indication under [subsection \(1\)](#) into the next edition of the work.

(3) [Subsections \(1\)](#) and [\(2\)](#) shall apply *mutatis mutandis* if the reference work is marketed in the form of an electronic database, or if access is granted to an electronic database containing a reference work.

### *Claims Against Agents or Representatives*

**17.—**(1) Where, in breach of [Section 11](#) a trade mark has been filed or registered in the name of an agent or representative of the person who is the proprietor of that trade mark, without the proprietor's authorization, the latter shall be entitled to demand the assignment of the right conferred by the application or registration of the trade mark from the agent or representative.

(2) Where, in breach of [Section 11](#) a trade mark has been registered in the name of an agent or representative of the person who is the proprietor of the trade mark, the latter shall be entitled to prohibit the use of the trade mark within the meaning of [Section 14](#) by the agent or representative if he has not authorized such use. If the agent or representative undertakes such infringing action intentionally or negligently, he shall be liable for compensation to the proprietor of the trade mark for damage suffered therefrom. [Section 14\(7\)](#) shall apply *mutatis mutandis*.



### *Claim to Destruction*

18.—(1) Where the cases referred to in [Sections 14, 15 and 17](#) are applicable, the proprietor of a trade mark or a trade designation may require the destruction of the unlawfully marked products that are in the possession of the infringer or are in his property unless the infringing nature of the products can be removed in some other way and the destruction is disproportionate, in the individual case, for the infringer or the proprietor.

(2) [Subsection \(1\)](#) shall also apply *mutatis mutandis* to devices that are the property of the infringer and are used or intended exclusively or almost exclusively for the unlawful marking of a product.

(3) Further claims to destruction shall remain unaffected.

### *Claim to Information*

19.—(1) Where the cases referred to in [Sections 14, 15 and 17](#) are applicable, the infringer may be required by the proprietor of a trade mark or commercial designation to give information as to the origin and distribution channels of the unlawfully marked product, without delay, unless this is disproportionate in the individual case.

(2) The person required to give information under [subsection \(1\)](#) shall give particulars of the name and address of the manufacturer, the supplier and other prior owners of the product, of the trade customer or the principal, and also in respect of the quantity of products that have been manufactured, dispatched, received or ordered.

(3) In those cases where infringement is obvious, the obligation to provide information may be imposed by an injunction in compliance with the Code of Civil Procedure [*Zivilprozessordnung*].

(4) Such information may only be used in criminal proceedings or in proceedings under the Law on Administrative Offenses [*Gesetz über Ordnungswidrigkeiten*] against the person required to give information, or against a dependent person under [Section 52\(1\)](#) of the Code of Criminal Procedure [*Strafprozessordnung*], in respect of an act committed before the information was given, with the consent of the person required to give information.

(5) Further claims to information shall remain unaffected.

## **Chapter 4 Restrictions to Protection**

### *Limitation*

20.—(1) Claims for infringement of the rights referred to in [Sections 14 to 19](#) shall come under the statute of limitations after three years from the time when the claimant obtains knowledge of the infringement and of the identity of the infringer, and irrespective of such knowledge, after 30 years from the infringement.

(2) **Section 852(2)** of the Civil Code [*Bürgerliches Gesetzbuch*] shall apply *mutatis mutandis*.

(3) If the infringer has obtained anything through the infringement at the expense of the claimant, the said infringer shall be liable, even after expiration of the term of limitation, for the restitution in accordance with the provisions on restitution of unjust enrichment.

### *Forfeiture*

**21.**—(1) The proprietor of a trade mark or a commercial designation shall not be entitled to prohibit the use of a later registered trade mark in respect of the goods and services for which it is registered where he has acquiesced, for a period of five successive years, in the use of this trade mark while being aware of such a use, unless the application for the later trade mark was filed in bad faith.

(2) The proprietor of a trade mark or 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 another later right within the meaning of [Section 13](#) where he has acquiesced, for a period of five successive years, in the use of this right while being aware of such a use, unless, at the time of acquiring that right, the proprietor of that right had acted in bad faith.

(3) In the cases referred to in [subsections \(1\)](#) and [\(2\)](#), the proprietor of the later right shall not be entitled to prohibit the use of the earlier right.

(4) [Subsections \(1\) to \(3\)](#) shall not affect the application of general principles on the forfeiture of rights.

### *Exclusion of Claims Due to Legal Validity of Registration of a Later Trade Mark*

**22.**—(1) The proprietor of a trade mark or a commercial designation shall not be entitled to prohibit the use of a later registered trade mark in respect of the goods and services for which it is registered, where a request for cancellation of the registration of the later trade mark has been rejected or should be rejected on the grounds

1. that the earlier trade mark or earlier commercial designation has not yet acquired a reputation within the meaning of [Section 9\(1\), No. 3](#), [Section 14\(2\), No. 3](#), or [Section 15\(3\)](#) on the date relevant for the seniority of the registration of the later trade mark ([Section 51\(3\)](#));
2. that the registration of the earlier trade mark could have been canceled on the date of publication of the registration of the later trade mark due to revocation or absolute grounds for refusal ([Section 51\(4\)](#)).

(2) Where the cases referred to in [subsection \(1\)](#) are applicable, the proprietor of a later registered trade mark shall not be entitled to prohibit the use of an earlier trade mark or an earlier commercial designation.

### *Use of Names and Descriptive Indications; Trade with Spare Parts*

**23.** The proprietor of a trade mark or commercial designation shall not be entitled to prohibit third parties from using in the course of trade

1. his name or address;
2. signs which are identical with or similar to the trade mark or commercial designation as indications concerning characteristics or properties of the goods or services, in particular, the kind, quality, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the services; or
3. the trade mark or commercial designation where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts,

provided such use is not contrary to accepted principles of morality.

### *Exhaustion*

**24.—(1)** The proprietor of a trade mark or a commercial designation shall not be entitled to prohibit its use in relation to goods which have been put on the market in the Federal Republic of Germany, in another Member State of the European Union or in another Contracting State of the Convention concerning the European Economic Area under that trade mark or commercial designation by the proprietor or with his consent.

(2) [Subsection \(1\)](#) shall not apply where there exist legitimate reasons for the proprietor of the trade mark or the commercial designation to oppose further commercialization of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market.

### *Exclusion of Claims Due to Non-use*

**25.—(1)** The proprietor of a registered trade mark shall not be entitled to assert any claims against third parties within the meaning of [Sections 14, 18 and 19](#), if, within a period of five years preceding the assertion of the claims, the trade mark has not been put to use pursuant to [Section 26](#) in connection with the goods or services on which the grounds for those claims are based provided that the trade mark has, on that date, been registered for at least five years.

(2) Where a plaintiff asserts claims on grounds of infringement of a registered trade mark within the meaning of [Sections 14, 18 and 19](#) by bringing an action, he shall, in response to an objection by the defendant, establish proof that the trade mark has been put to use pursuant to [Section 26](#) within a period of five years before the bringing of the action, for the goods or services on which the grounds for his claims are based, provided that the trade mark has, on that date, been registered at least for five years. Where the period of five years of non-use ends after the bringing of the action, the plaintiff shall, in response to an objection by the defendant, establish proof that the trade mark has been put to use pursuant to [Section 26](#) within a period of five years preceding the conclusion of the oral proceedings. For the decision, only those goods or services shall be taken into account for which proof of use has been established.

## *Use of a Trade Mark*

**26.**—(1) Insofar as the assertion of claims resulting from a registered trade mark or the maintenance of the registration depends on the use of the trade mark, the proprietor must have put the trade mark to genuine use in this country in connection with the goods and services in respect of which it is registered, unless there are proper reasons for non-use.

(2) Use of the trade mark with the consent of the proprietor shall be deemed to constitute use by the proprietor.

(3) Use of the trade mark in a form differing from the form in which it was registered shall also be deemed to constitute use of a registered trade mark, provided that the differing elements do not alter the distinctive character of the trade mark. Sentence 1 shall also apply if the trade mark is also registered in the form in which it has been put to use.

(4) Affixing of the trade mark to goods or to their packaging or wrapping in this country solely for export purposes shall also be deemed to constitute use of the trade mark in this country.

(5) Where use within five years from the date of registration is required, the date of registration shall be replaced by the date of the conclusion of the opposition proceedings in the cases in which opposition to registration has been lodged.

## **Chapter 5 Trade Marks as Objects of Property**

### *Transfer*

**27.**—(1) The right conferred by the registration, use or notoriety of a trade mark may be transferred or assigned to another person in respect of some or all of the goods or services for which the trade mark is protected.

(2) Where the trade mark relates to a business establishment or to a portion of a business establishment, the transfer or assignment of the business establishment or of that portion of the business establishment to which the trade mark relates shall include in the case of doubt the right accruing from the registration, use or notoriety of the trade mark.

(3) On request of one of the parties the transfer of the right conferred by the registration of the trade mark shall be recorded in the Register, if proof thereof is furnished to the Patent Office.

(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.

[Amended by Law of July 19, 1996]

## *Presumption of the Proprietorship of a Right; Service on the Proprietor*

**28.**—(1) It is presumed that the person registered as proprietor in the Register is entitled to the right conferred by the registration of a trade mark.

(2) If the right conferred by the registration of a trade mark has been assigned or transferred to a third party, the successor in title shall, in proceedings before the Patent Office, appeal proceedings before the Patent Court or proceedings of appeal on a point of law before the Federal Court of Justice, be able to assert the claim for protection of this trade mark and invoke the right conferred by the registration only from the date of the receipt of the request for registration of the transfer at the Patent Office. Sentence 1 shall apply *mutatis mutandis* to other proceedings before the Patent Office, appeal proceedings before the Patent Court or proceedings of appeal on a point of law before the Federal Court of Justice to which the proprietor is a party.

(3) Orders and decisions of the Patent Office for which service to the proprietor of the trade mark is required, shall be served on the person registered as proprietor. If a request for registration of a transfer has been received at the Patent Office, the orders and decisions referred to in sentence 1 shall also be served on the successor in title.

## *Rights in rem; Levy of Execution; Bankruptcy Proceedings*

**29.**—(1) The right conferred by the registration, use or notoriety of a trade mark

1. may be given as security or be the subject of rights *in rem*; or
2. may be levied in execution.

(2) If the rights referred to in [subsection \(1\), No. 1](#), or measures referred to in [subsection \(1\), No. 2](#), concern the right conferred by the registration of a trade mark, they shall on request of one of the parties be recorded in the Register, if proof thereof is furnished to the Patent Office.

(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 at the request of the receiver or of the insolvency court. In the case of self-administration ([Section 270](#) of the Insolvency Code [*Insolvenzordnung*]), the administrator shall act in place of the receiver.

[Amended by Law of July 19, 1996]

## *Licensing*

**30.**—(1) The right conferred by the registration, use or notoriety of a trade mark may be the subject of an exclusive or nonexclusive license for some or all of the goods or services for which the trade mark is protected and for the whole or part of the Federal Republic of Germany.

(2) The proprietor of a trade mark may invoke the rights conferred by that trade mark against a licensee who contravenes any provision in his licensing contract with regard to

1. the duration of the license;

2. the form covered by the registration in which the trade mark may be used;
3. the kind of goods or services for which the license has been granted;
4. the territory in which the trade mark may be affixed; or
5. the quality of the goods manufactured or the services provided by the licensee.

(3) The licensee may bring an action for infringement of a trade mark only if the proprietor of the trade mark consents thereto.

(4) Any licensee shall, for the purpose of obtaining compensation for damage suffered by him, be entitled to intervene in infringement actions brought by the proprietor of the trade mark.

(5) The transfer pursuant to [Section 27](#) or the grant of a license pursuant to [subsection \(1\)](#) shall not affect licenses previously granted to third parties.

### *Trade Mark Applications*

**31.** [Sections 27 to 30](#) shall apply *mutatis mutandis* to rights conferred by trade mark applications.

## **PART 3 PROCEEDINGS IN TRADE MARK MATTERS**

### **Chapter 1 Registration Procedure**

#### *Requirements of the Application*

**32.—(1)** An application for registration of a trade mark in the Register shall be filed at the Patent Office.

(2) The application shall contain

1. information identifying the applicant;
2. a representation of the trade mark; and
3. a list of the goods or services in respect of which the registration is requested.

(3) The application must comply with the other requirements laid down in the legal ordinance under [Section 65\(1\), No. 2](#).

(4) A fee as prescribed by the schedule of fees shall be paid with the application. Where registration is requested for goods or services falling within more than three classes of the classification of goods and services, a class fee as prescribed by the schedule of fees shall be paid in addition for each additional class.

#### *Date of Filing; Right to Registration; Publication of Application*

**33.**—(1) The date of filing of a trade mark shall be the date on which the documents containing the information specified in [Section 32\(2\)](#) are received at the Patent Office.

(2) A trade mark application which has been accorded a date of filing shall confer a right to registration. The request for registration shall be granted, unless the application requirements are not complied with or registration is prejudiced by absolute grounds for refusal.

(3) A trade mark application which has been accorded a date of filing shall be published together with information identifying the applicant.

[Amended by Law of June 22, 1998]

### *Foreign Priority*

**34.**—(1) Claiming priority of a previous foreign application shall be governed by the provisions of the international agreements subject to the proviso that priority under the Paris Convention may also be claimed for services.

(2) Where the earlier foreign application has been filed in a State which is not bound by an international agreement on the recognition of priority, the applicant may claim a right of priority corresponding to that under the Paris Convention provided that, after publication by the Federal Ministry of Justice in the Federal Law Gazette, the other State grants a right of priority for a first filing with the Patent Office which is, according to its requirements and contents, comparable to that under the Paris Convention.

(3) Any person who claims priority, pursuant to [subsection \(1\)](#) or [\(2\)](#), shall, within a period of two months after the date of filing of the application, indicate the date and State of the earlier application. Where the applicant has provided these particulars, the Patent Office shall invite the applicant to indicate the file number of the earlier application and to file a copy of the said application within a period of two months after communication of the invitation. Particulars may be altered within those periods. Where particulars are not provided in due time, the priority claim for the application shall be forfeited.

### *Exhibition Priority*

**35.**—(1) If an applicant for the trade mark has displayed goods or services under the trade mark applied for,

1. at an official or officially recognized international exhibition falling within the terms of the Convention on International Exhibitions signed at Paris on November 22, 1928, or
2. at another exhibition in this country or abroad,

he may, if he files the application within a period of six months from the date of 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) The exhibitions referred to in [subsection \(1\), No. 1](#), are published by the Federal Ministry of Justice in the Federal Law Gazette.



(3) The exhibitions within the meaning of [subsection \(1\), No. 2](#), are designated in each case by the Federal Ministry of Justice in a notification on the protection of exhibitions in the Federal Law Gazette.

(4) Any person who, pursuant to [subsection \(1\)](#), claims priority shall, within a period of two months after the date of filing, indicate the date of the first display of the trade mark and the exhibition. Where the applicant has provided these particulars, the Patent Office shall invite the applicant to file, within a period of two months after communication of the invitation, evidence of the display of the goods or services under the trade mark applied for. Where evidence is not provided in due time, the priority claim for the application shall be forfeited.

(5) The exhibition priority pursuant to [subsection \(1\)](#) does not extend the period of priority laid down in [Section 34](#)

### *Examination of the Application Requirements*

**36.—**(1) The Patent Office shall examine whether

1. the trade mark application satisfies the requirements for according a date of filing in accordance with [Section 33\(1\)](#);
2. the application complies with the other application requirements;
3. the fees under [Section 32\(4\)](#) have been paid; and
4. whether the applicant may be the proprietor of a trade mark pursuant to [Section 7](#).

(2) If the deficiencies established pursuant to [subsection \(1\), No. 1](#), are not remedied within a period fixed by the Patent Office, the application shall be deemed not to have been filed. If the applicant complies with the Patent Office's request, the Patent Office shall accord as the date of filing of the application the date on which the deficiencies established are remedied.

(3) If the fees are not paid, the applicant shall be informed by the Patent Office that the application shall be deemed to have been withdrawn, unless the fees and a surcharge as prescribed in the schedule of fees are paid within a period of one month after the service of the notification. If, within this period, the application fee and the surcharge, but not the required class fees, are paid, sentence 1 shall not apply where the applicant indicates which classes of goods or services are to be covered by the amount of fees paid. Where there is no such indication, the leading class shall be taken into account first followed by the other classes in the sequence of the subdivision of classes.

(4) If other deficiencies are not remedied within a period fixed by the Patent Office, the Patent Office shall reject the application.

(5) Where, pursuant to [Section 7](#), the applicant may not be the proprietor of a trade mark, the Patent Office shall reject the application.

### *Examination as to Absolute Grounds for Refusal*



**37.**—(1) Where, under [Section 3](#), [8](#) or [10](#), a trade mark is not eligible for registration, the application shall be rejected.

(2) Where it is found in the examination that at the day of filing ([Section 33\(1\)](#)), the trade mark failed to comply with the requirements of [Section 8\(2\), No. 1, 2](#) or [3](#), but that the ground for refusal has ceased to exist after the date of filing, the application shall not be rejected, where the applicant has accepted that, notwithstanding the original date of filing and a priority claimed pursuant to [Section 34](#) or [35](#), the day on which the ground for refusal ceased to exist shall be considered the date of filing and be decisive for determining seniority within the meaning of [Section 6\(2\)](#).

(3) An application pursuant to [Section 8\(2\), No. 4](#), shall only be refused where there is an obvious likelihood of deception.

(4) An application shall only be rejected pursuant to [Section 10](#) where the notoriety of the earlier trade mark is known to the Patent Office and where the other prerequisites pursuant to [Section 9\(1\), No. 1](#) or [2](#), are met.

(5) [Subsections \(1\) to \(4\)](#) shall apply *mutatis mutandis* where the trade mark is not eligible for registration in respect of only some of the goods or services for which it has been applied for.

### *Accelerated Examination*

**38.**—(1) The examination pursuant to [Sections 36](#) and [37](#) shall be accelerated on request of the applicant.

(2) A fee according to the schedule of fees shall be paid with the request for accelerated examination. If the fee is not paid, the request shall be deemed not to have been made.

### *Withdrawal, Limitation and Correction of the Application*

**39.**—(1) The applicant may at any time withdraw the application or limit the list of goods and services contained therein.

(2) Upon request of the applicant, the content of the application may be amended by correcting errors of wording or of typing or other obvious mistakes.

### *Division of the Application*

**40.**—(1) The applicant may divide the application by declaring that, for the goods and services referred to in the declaration, the trade mark application should thenceforth be dealt with as a divisional application. The seniority of the original application shall continue to apply to each part of a divided application.

(2) The elements of the application required by [Section 32](#) shall be filed for the divisional application. Furthermore, a fee as prescribed in the schedule of fees shall be paid for the division. If the elements of the application are not filed within three months of receipt of the declaration of division, or the fee has not been paid within this period, the divisional application shall be deemed to have been withdrawn. The declaration of division cannot be revoked.

## *Registration*

41. Where an application meets the application requirements and is not rejected pursuant to [Section 37](#), the trade mark shall be recorded in the Register. The registration shall be published.

## *Opposition*

42.—(1) Within a period of three months following the date of publication of the registration of the trade mark pursuant to [Section 41](#), the proprietor of an earlier trade mark may give notice of opposition to registration of the trade mark.

(2) The opposition may only be based on the grounds that the trade mark may be canceled due to

1. an earlier filed or earlier registered trade mark pursuant to [Section 9\(1\), No. 1](#) or [2](#);
2. an earlier well-known trade mark pursuant to [Section 10](#) in conjunction with [Section 9\(1\), No. 1](#) or [2](#); or
3. its registration for an agent or representative of the proprietor of the trade mark pursuant to [Section 11](#)

(3) A fee as prescribed in the schedule of fees shall be paid within the time limit specified in [subsection \(1\)](#). If the fee is not paid, the opposition is deemed not to have been lodged.

## *Objection Due to Non-use; Decision on the Opposition*

43.—(1) If the proprietor of an earlier registered trade mark has given notice of opposition, he shall, if the other party contests the use of the trade mark, substantiate by *prima facie* evidence that, during the period of five years preceding the publication of the registration of the trade mark against which a notice of opposition has been given, the earlier registered trade mark has been put to use pursuant to [Section 26](#), provided the earlier trade mark has at that date been registered for not less than five years. If the period of five years of non-use ends after the publication of the registration, the opponent shall, if the other party contests that use, substantiate by *prima facie* evidence that, during the period of five years preceding the decision on the opposition, the trade mark has been put to use pursuant to [Section 26](#). In the decision, only those goods or services shall be considered of which use has been substantiated by *prima facie* evidence.

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

(3) If the registered trade mark has to be canceled because of one or several earlier trade marks, the proceedings with regard to further oppositions may be suspended until a decision on the registration of the trade mark has become final.

(4) In the case of cancellation pursuant to [subsection \(2\)](#), [Section 52\(2\)](#) and [\(3\)](#) shall apply *mutatis mutandis*.

### *Action for the Grant of Registration*

44.—(1) The proprietor of a trade mark may invoke against the opponent, by bringing an action, that he is entitled to claim registration pursuant to [Section 43](#) despite cancellation of the registration.

(2) The action pursuant to [subsection \(1\)](#) shall be brought within six months after the decision effecting the cancellation of the registration has become final.

(3) Registration on the grounds of a decision in favor of the proprietor of the trade mark shall be recorded while preserving seniority of the registration.

## **Chapter 2**

### **Correction; Division; Period of Protection and Renewal**

### *Correction of the Register and Publications*

45.—(1) Registrations in the Register may be amended upon request or *ex officio* by correcting errors of wording or of typing or other obvious mistakes. Where the registration affected by the correction has been published, the corrected registration shall also be published.

(2) [Subsection \(1\)](#) shall apply *mutatis mutandis* to the correction of publications.

### *Division of the Registration*

46.—(1) The proprietor of a registered trade mark may divide the registration by declaring that, for the goods or services referred to in the declaration, the trade mark registration should thenceforth be maintained as a divisional registration. The seniority of the original registration shall continue to apply to each part of the divided registration.

(2) The division may only be declared after the expiry of the time limit for giving notice of opposition. The declaration shall only be admissible where an opposition to the registration of a trade mark, pending at the time of declaration, or an action for cancellation of the registration of the trade mark, pending at the time of declaration, would, after the division, only be directed against one of the parts of the original registration.

(3) The documents required for the divisional registration shall be filed. Furthermore, a fee as prescribed in the schedule of fees shall be paid for the division. If the documents are not filed within three months of receipt of the declaration of division, or the fee has not been paid within this period, the divisional registration shall be deemed to have been renounced. The declaration of division cannot be revoked.

### *Period of Protection and Renewal*

47.—(1) The period of protection of a registered trade mark shall begin on the date of filing the application ([Section 33\(1\)](#)) and shall end 10 years after the last day of the month containing the date of filing.

(2) The period of protection may be renewed for further periods of 10 years.

(3) The period of protection shall be renewed through payment of the renewal fee and, where renewal is requested for goods and services falling within more than three classes of the classification of goods and services, for each additional class, a class fee as prescribed by the schedule of fees. The fees shall become due on the last day of the period of protection. Payment may be made within a period of one year before the fees fall due. If the fees are not paid in due time, the proprietor of the registered trade mark shall be informed by the Patent Office that the registration shall be canceled, unless the fees and a surcharge as prescribed in the schedule of fees are paid within a period of six months after the expiry of the month in which the notification was served.

(4) Where the fees are paid only in respect of some of the goods or services for which the trade mark is registered, the period of protection shall be renewed for those goods or services only. If, within the period specified in [subsection \(3\)](#), sentence 4, the renewal fee and the surcharge, but not the required class fees, are paid, the period of protection shall, unless sentence 1 applies, be renewed only for those classes of the classification of goods and services which are covered by the payment of fees. Where there is a leading class, it shall be taken into account first. The other classes shall be taken into account according to the sequence of the classification.

(5) The renewal of the period of protection shall take effect as from the day following the date of expiry of the period of protection. The renewal shall be recorded in the Register and published.

(6) If the period of protection is not renewed, the registration of the trade mark shall be canceled with effect as from the date of expiry of the period of protection.

### **Chapter 3**

#### **Surrender, Revocation and Nullity; Cancellation Procedure**

##### *Surrender*

48.—(1) The registration of the trade mark shall be canceled in the Register at any time upon request of the proprietor in respect of some or all of the goods or services for which it is registered.

(2) The registration shall be canceled only with the agreement of the proprietor of a right to the trade mark entered in the Register.

##### *Revocation*

49.—(1) The registration of a trade mark shall be canceled upon request on grounds of revocation if, within a continuous period of five years after the date of registration, the trade mark has not been put to use in accordance with [Section 26](#). However, no person may claim that the proprietor's rights in a trade mark should be revoked where, during

the interval between the expiry of the five-year period and the filing of the cancellation request, use of the trade mark in accordance with [Section 26](#) has been started or resumed. The commencement or resumption of use within three months preceding the filing of the cancellation request, subsequent to the expiry of a continuous period of five years of non-use shall, however, be disregarded where preparations for the commencement or resumption occur only after the proprietor of the trade mark became aware that the cancellation request may be filed. If the cancellation request is filed with the Patent Office under [Section 53\(1\)](#), the request filed with the Patent Office shall be decisive for the calculation of the period of three months according to sentence 3, provided that action for cancellation under [Section 55\(1\)](#) is lodged within three months after service of the notification under [Section 53\(4\)](#).

(2) The registration of a trade mark shall also be canceled upon request on grounds of revocation

1. if, in consequence of acts or inactivity of the proprietor, the trade mark has become the common name in the trade for the goods or services in respect of which it is registered;
2. if, in consequence of the use made of it by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the kind, nature or geographical origin of those goods or services; or
3. if the proprietor of the trade mark no longer satisfies the conditions laid down in [Section 7](#).

(3) Where a ground for revocation of rights exists in respect of only some of the goods or services for which the trade mark is registered, the registration shall be canceled in respect of those goods or services only.

### *Nullity Due to Absolute Grounds for Refusal*

**50.**—(1) Registration of a trade mark shall be canceled on request on the grounds of nullity

1. where it has been registered in breach of [Section 3](#);
2. where it has been registered in breach of [Section 7](#);
3. where it has been registered in breach of [Section 8](#); or
4. where the applicant was acting in bad faith when he filed the trade mark application.

(2) Where the trade mark has been registered in breach of [Section 3](#), [7](#) or [8](#), the registration may be canceled only if the ground for refusal still exists at the time when the decision on the cancellation request is made. Moreover, where the trade mark has been registered in breach of [Section 8\(2\), No. 1, 2](#) or [3](#), the registration may only be canceled if the cancellation request has been filed within a period of 10 years from the date of registration.

(3) The registration of a trade mark may be canceled *ex officio* where it has been registered in breach of [Section 8\(2\), Nos. 4 to 9](#), and

1. the cancellation procedure is initiated within a period of two years from the date of registration;
2. the ground for refusal still exists at the date when the decision on the cancellation is made; and
3. the registration has obviously been recorded in breach of the stated provisions.

(4) Where the ground for nullity exists in respect of only some of the goods or services for which the trade mark is registered, the registration shall be canceled in respect of those goods and services only.

### *Nullity Due to Earlier Rights*

**51.—**(1) The registration of a trade mark shall be canceled by bringing an action on the grounds of nullity if it is prejudiced by a right having seniority within the meaning of [Sections 9 to 13](#).

(2) The registration may not be canceled on the grounds of the registration of an earlier trade mark where the proprietor of the earlier trade mark has acquiesced, for a period of five successive years, in the use of the later trade mark for the goods or services for which it is registered, while being aware of such use, unless registration of the later trade mark was applied for in bad faith. The same shall apply to the proprietor of a right to a trade mark having seniority and acquired by use within the meaning of [Section 4, No. 2](#), to a well-known trade mark within the meaning of [Section 4, No. 3](#), to a commercial designation within the meaning of [Section 5](#), or to a plant variety name within the meaning of [Section 13\(2\), No. 4](#). Furthermore, registration of a trade mark may not be canceled if the proprietor of a right having seniority referred to in [Sections 9 to 13](#) has consented to the registration of the trade mark prior to the filing of the cancellation request.

(3) The registration may not be canceled on the grounds of an earlier trade mark with a reputation or an earlier commercial designation with a reputation if the trade mark or commercial designation has not acquired a reputation within the meaning of [Section 9\(1\), No. 3](#), [Section 14\(2\), No. 3](#), or [Section 15\(3\)](#) on the date relevant for the seniority of the registration of the later trade mark.

(4) The registration may not be canceled on the grounds of the registration of an earlier trade mark where the registration of the earlier trade mark could have been canceled on the date of the publication of the registration of the later trade mark

1. because of revocation under [Section 49](#) or
2. because of absolute grounds for refusal under [Section 50](#).

(5) Where a ground for nullity exists in respect of only some of the goods or services for which the trade mark is registered, the registration shall be canceled as regards those goods and services only.

### *Effects of Cancellation on Grounds of Revocation or Nullity*

**52.**—(1) Where the registration of a trade mark is canceled on grounds of revocation to any extent, the effects of that registration shall be deemed to have ceased to that extent as from the date of the bringing of the action for cancellation. 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) Where the registration of a trade mark is canceled on grounds of nullity to any extent, the effects of that registration shall be deemed to have been void to that extent *ab initio*.

(3) Subject to the provisions relating either to compensation for damage willfully or negligently caused on the part of the proprietor of the trade mark, or to unjust enrichment, the cancellation of the registration of the trade mark shall not affect

1. any decision in infringement proceedings which has acquired the authority of a final decision and been enforced prior to the decision on the cancellation request;
2. any contract concluded prior to the decision on the cancellation request insofar as it has been fulfilled before that decision; however, repayment, to an extent justified by the circumstances, of sums paid under the relevant contract, may be claimed on grounds of equity.

### *Cancellation by the Patent Office on Grounds of Revocation*

**53.**—(1) The cancellation request on grounds of revocation ([Section 49](#)) may be submitted to the Patent Office notwithstanding the right to assert the claim for cancellation by action pursuant to [Section 55](#)

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

(3) If the proprietor of the registered trade mark fails to object to the cancellation within two months after service of the notification, the registration shall be canceled.

(4) If the proprietor of the registered trade mark objects to the cancellation, the Patent Office shall notify accordingly the person filing the request and inform him that the cancellation request must be made by bringing an action pursuant to [Section 55](#).

### *Cancellation Procedure Before the Patent Office on Absolute Grounds for Refusal*

**54.**—(1) The request for cancellation because of absolute grounds for refusal ([Section 50](#)) shall be filed with the Patent Office. Any person may file such request.

(2) A fee as prescribed in the schedule of fees shall be paid at the same time. In the event of non-payment of the fee, the request shall be deemed not to have been filed.

(3) Where a cancellation request has been filed or a cancellation procedure has been initiated *ex officio*, the Patent Office shall notify the proprietor of the registered



trade mark accordingly. If he fails to object to the cancellation within two months after service of the notification, the registration shall be canceled. If he objects to the cancellation, the cancellation procedure shall be carried out.

### *Cancellation Proceedings Before Regular Courts*

**55.**—(1) An action for a cancellation request on grounds of revocation ([Section 49](#)) or because of earlier rights ([Section 5](#)) shall be brought against the person registered as proprietor of the trade mark or his successor in title.

(2) The following persons may bring an action:

1. any person in such cases where a cancellation request has been filed on the grounds of revocation;
2. the proprietors of the rights stated in [Sections 9 to 13](#) in such cases where a cancellation request has been filed on the grounds of rights having seniority;
3. the persons entitled to make claims under [Section 13\(2\)](#) of the Law Against Unfair Competition [*Gesetz gegen den unlauteren Wettbewerb*] in such cases where a cancellation request has been filed because of an indication of geographical origin having seniority ([Section 13\(2\), No. 5](#)).

(3) If the action for cancellation has been brought by the proprietor of an earlier registered trade mark, he shall, if the defendant has filed an objection, furnish proof that the earlier registered trade mark has been put to use pursuant to [Section 26](#) during a period of five years preceding the bringing of the action, provided the earlier trade mark has at this date been registered for not less than five years. If the period of five years of non-use ends after the bringing of the action, the plaintiff shall, if the defendant has filed an objection, furnish proof that the trade mark has been put to use pursuant to [Section 26](#) during the period of five years preceding the end of the oral proceedings. Where the earlier trade mark has been registered for a period of not less than five years at the date of publication of the registration of the later trade mark, the plaintiff shall also, if the defendant has filed an objection, furnish proof that, at that date, the registration of the earlier trade mark could not have been canceled under [Section 49\(1\)](#). In the decision, only those goods or services of which use has been proved shall be considered.

(4) Where before or after the bringing of the action the right based on the registration of the trade mark has been assigned or transferred to another person, the decision upon the merits is also effective and enforceable vis-à-vis the successor in title. With regard to the right of the successor in title to become a party to the proceedings, [Sections 66 to 74](#) and [76](#) of the Code of Civil Procedure shall apply *mutatis mutandis*.

## **Chapter 4**

### **General Provisions for Procedures Before the Patent Office**

#### *Competence*

**56.**—(1) Trade Mark Sections and Trade Mark Divisions shall be established in the Patent Office for implementing procedures in trade mark matters.



(2) The Trade Mark Sections shall be competent for examining trade mark applications and for taking decisions in registration procedures. The tasks of a Trade Mark Section shall be performed by a member of the Patent Office (examiner). The tasks may also be performed by an official of the higher intermediate grade of the civil service or by comparable employees. Officials of the higher intermediate grade of the civil service or comparable employees, however, shall not be authorized to order that evidence be given under oath, to administer an oath, or to put forward a request to the Patent Court under [Section 95\(2\)](#).

(3) The Trade Mark Divisions are competent for those matters which do not fall within the competence of the Trade Mark Sections. The tasks of a Trade Mark Division shall be performed by at least three members of the Patent Office. The Chairman of a Trade Mark Division may handle alone all matters falling within the competence of the Trade Mark Division, with the exception of decisions on the cancellation of trade marks pursuant to [Section 54](#), or he may delegate these matters to a member of the Trade Mark Division.

### *Exclusion and Challenge*

**57.**—(1) For the exclusion and challenge of examiners and members of the Trade Mark Divisions as well as officials of the higher and lower intermediate grades of the civil service or employees entrusted with the handling of matters within the competence of the Trade Mark Sections or Trade Mark Divisions, [Sections 41 to 44](#), [Section 45\(2\)](#), sentence 2, and [Sections 47 to 49](#) of the Code of Civil Procedure relating to the exclusion and challenge of members of the court shall apply *mutatis mutandis*.

(2) The decision on a challenge plea [*Ablehnungsgesuch*], insofar as the plea requires a decision, shall be made by a Trade Mark Division.

### *Expert Opinions*

**58.**—(1) The Patent Office shall be required to give opinions at the request of the courts or of the State Attorney's offices on questions concerning trade marks applied for or registered trade marks if there are divergent opinions by a number of experts in the proceedings.

(2) In other respects, the Patent Office shall not have power to make decisions or give opinions outside its sphere of activity as provided by the law without the permission of the Federal Ministry of Justice.

### *Investigation of the Facts; Right to Be Heard*

**59.**—(1) The Patent Office shall investigate *ex officio* the facts of the case. It shall not be bound to the factual statements and the offers of proof of the parties.

(2) Where the decision of the Patent Office is to be based upon factors which have not been communicated to the applicant or proprietor of the trade mark or to another party to the proceedings, the said party shall be given an opportunity to express their views thereon within a given period of time.

### *Examination of Facts; Hearing; Minutes*

**60.**—(1) The Patent Office may at any time summon and hear the interested parties, may examine witnesses, experts and the parties concerned, whether under oath or not, and may institute other inquiries necessary for clarification of the matter.

(2) Until such time as the decision concluding the procedure is made, the applicant or proprietor of a trade mark or another party concerned shall be given a hearing on request where appropriate. If the Patent Office does not consider a hearing to be appropriate, it shall reject the request. The decision whereby a request is rejected shall not be subject to interlocutory appeal.

(3) Minutes of hearings and the examination of witnesses shall be taken, which shall reproduce the essentials of the proceedings and contain the legally material declarations of the parties concerned. [Sections 160a, 162 and 163](#) of the Code of Civil Procedure shall apply *mutatis mutandis*. The parties shall receive a copy of the minutes.

### *Decisions; Information on the Right to Appeal*

**61.**—(1) The decisions of the Patent Office shall contain the grounds therefor, and shall be in writing and be communicated *ex officio* to all interested parties, even if they have been pronounced in accordance with sentence 2. If a hearing has taken place, pronouncement may also be given at the end of the hearing. Grounds need not be given if the applicant or the proprietor of the trade mark is the only party and his request has been allowed.

(2) The written execution shall be accompanied by a statement informing the parties concerned of the appeal which shall be permissible from the decision, of the authority where the appeal shall be filed, of the period for filing the said appeal, and the appeal fee, if any, to be paid. The period for filing the appeal shall begin to run only when the parties concerned have been so informed in writing. If they have not been informed, or incorrectly informed, the appeal may be filed only within one year from the time of the communication of the decision, except where the party concerned has been informed in writing that an appeal was not permissible; [Section 91](#) shall apply *mutatis mutandis*. Sentences 1 to 4 shall apply *mutatis mutandis* to the legal remedy of objection under [Section 64](#).

### *Inspection of Files; Inspection of the Register*

**62.**—(1) The Patent Office shall permit anyone so requesting to inspect the files of trade mark applications if legitimate interest has been substantiated by *prima facie* evidence.

(2) Subsequent to the registration of the trade mark, the files relating to such registered trade marks may be inspected on request.

(3) Anyone may freely inspect the Register.

### *Costs of the Proceedings*

**63.**—(1) When several persons are parties to the proceedings, the Patent Office may decide that the costs of the proceedings, including the expenses of the Patent Office and the costs incurred by the parties shall, to the extent that they were necessary for the

appropriate defense of their claims and rights, be borne in whole or in part by one of the parties if and to the extent that this is equitable. Such determination may also be made if the objection, the trade mark application, the opposition or the cancellation request is wholly or partly withdrawn or if, either in whole or in part, the registration of the trade mark is canceled in the Register due to surrender or non-renewal of the term of protection. Insofar as no such determination concerning the costs is made, each party shall individually meet the costs he has incurred.

(2) The Patent Office may order that the fee for opposition or for the cancellation request be wholly or partly refunded, if and to the extent that this is equitable.

(3) The amount of the costs to be refunded shall be determined by the Patent Office upon request. The provisions of the Code of Civil Procedure relating to the procedure for the assessment of costs and the execution of the decisions regarding the assessment of costs shall apply *mutatis mutandis*. Instead of an objection, an appeal shall lie from the decision regarding the assessment of costs. [Section 66](#) shall apply, provided that the appeal shall be filed within two weeks and no fee has to be paid for lodging the appeal. The executable copy shall be issued by the registrar of the Patent Court.

### *Objection [Erinnerung]*

**64.**—(1) Objection may be raised to the decisions of the Trade Mark Sections and Trade Mark Divisions issued by officials of the higher intermediate grade of the civil service or comparable employees. The objection shall have suspensive effect.

(2) The objection shall be filed with the Patent Office within one month after service of the decision.

(3) If the official or employee whose decision is contested considers the objection to be well founded, he shall rectify his decision. This shall not apply if the party raising the objection is opposed by another party to the proceedings.

(4) Decisions on the objection shall be made by a member of the Patent Office.

(5) After an appeal under [Section 66\(3\)](#) has been lodged, decisions on objections can no longer be made. If, in spite of this provision, a decision on an objection is made after an appeal has been lodged, it shall be irrelevant.

### *Power to Issue Legal Ordinances*

**65.**—(1) By legal ordinance and without the consent of the Council of the *Länder* [*Bundesrat*], the Federal Ministry of Justice shall have the power

1. to regulate the establishment and the business procedure of the Patent Office in trade mark matters;
2. to prescribe additional requirements for the application of trade marks;
3. to determine the classification of goods and services;
4. to make detailed provisions concerning the execution of examination, opposition and cancellation procedures;

5. to make provisions concerning the Register for registered trade marks and, where appropriate, separate provisions on the Register for collective marks;
6. to regulate the information on registered trade marks to be recorded in the Register and to determine the scope of information as well as the manner of publishing information;
7. to make provisions concerning other procedures before the Patent Office provided in this Law, in particular, the procedure concerning the division of applications and registrations, the procedure concerning the provision of information or certifications, the procedure concerning reinstatement, the procedure concerning the inspection of files, the procedure concerning the protection of international registrations of trade marks and the procedure concerning the conversion of Community trade marks;
8. to make provisions concerning the form of filing requests and submissions regarding trade mark matters, including the communication of requests and submissions via electronic data transmission;
9. to make provisions determining the required form of decisions, office actions or other notifications of the Patent Office relating to trade mark matters communicated to the parties concerned, including the communication via electronic data transmission, unless a specific form of communication is prescribed by law;
10. to make provisions determining the cases and the preconditions for taking into account submissions and documents relating to trade mark matters in other languages than German;
11. to entrust officials of the higher intermediate grade of the civil service or comparable employees with the handling of matters within the competence of the Trade Mark Divisions which by their nature present no particular legal difficulties, with the exception of decisions on the cancellation of trade marks ([Section 48\(1\)](#), [Sections 53](#) and [54](#)), the giving of opinions ([Section 58\(1\)](#)) and the decisions whereby the giving of an expert opinion is refused;
12. to entrust officials of the lower intermediate grade of the civil service or comparable employees with the handling of matters within the competence of the Trade Mark Sections or Trade Mark Divisions which by their nature present no particular legal difficulties, with the exception of decisions on applications, oppositions or other requests;
13. to prescribe the collection of administrative fees in order to cover the expenses of requests addressed to the Patent Office, insofar as provision therefor has not been made by law, in particular,
  - (a) to order that fees and expenses be collected for certifications, authentications, the inspection of files and the furnishing of information;

- (b) to establish rules concerning those who owe fees, the due date of payments, the obligation to pay in advance, exemptions from payment, limitation and the regulations and procedures for determining the costs;
14. to regulate the particulars to be included in the publication under [Section 33\(3\)](#) and to determine the manner of publication of those particulars.

(2) The Federal Ministry of Justice may delegate such power to issue legal ordinances under [subsection \(1\)](#) by legal ordinance in whole or in part to the President of the Patent Office without the consent of the Council of the *Länder*.

[Amended by Laws of July 19, 1996, June 22, 1998, and July 16, 1998]

## **Chapter 5**

### **Proceedings Before the Patent Court**

#### *Appeal*

**66.**—(1) An appeal from the decisions of the Trade Mark Sections and Trade Mark Divisions shall lie to the Patent Court, insofar as an objection ([Section 64\(1\)](#)) has not been raised. The appeal may be filed by the parties to the proceedings before the Patent Office. It shall have a suspensive effect.

(2) The appeal shall be filed with the Patent Office within one month after service of the decision.

(3) Where the decision on the objection under [Section 64](#) has not been made within six months from the date of filing, and where, after the expiry of this time limit, the person filing the objection has filed a request for decision, the appeal from a decision of the Trade Mark Section or Trade Mark Division is directly admissible, in derogation of [subsection \(1\)](#), sentence 1, if the decision on the objection is not made within a period of two months from the receipt of the request. If the person raising the objection is opposed by another party to the proceedings, sentence 1 shall be applicable provided that the period of six months after the objection was raised is replaced by a period of 10 months. If the other party has also raised an objection, the other party must give his consent to the appeal under sentence 2. The written declaration of consent shall be attached to the appeal. If the other party does not also lodge an appeal within one month after service of the appeal under [subsection \(4\)](#), sentence 2, his objection is deemed to have been withdrawn. The remaining periods of time under sentences 1 and 2 shall be interrupted if the proceedings are suspended or if, on request of a party to the proceedings, an extension of time has been granted. The remaining periods of time under sentences 1 and 2 shall recommence to run after the suspension of the proceedings has been terminated or the extension of time granted has expired. After a decision on the objection has been issued, an appeal under sentences 1 and 2 shall no longer be admissible.

(4) Copies of the appeal and of all written statements shall be attached for the other parties. The appeal and all written statements containing motions pertaining to the matter or the declaration of withdrawal of the appeal or of a motion shall be served *ex officio* upon the other parties. Other documents shall be communicated informally to the said parties, provided that *ex-officio* service has not been ordered.

(5) A fee as prescribed by the schedule of fees shall be paid for the appeal. If the fee for an appeal pursuant to [subsection \(1\)](#) is not paid within the period under [subsection \(2\)](#) or for an appeal pursuant to [subsection \(3\)](#) is not paid within the period of one month after receipt of the appeal, the appeal shall be deemed not to have been filed.

(6) If the authority whose decision is contested considers the appeal to be well founded, it shall rectify its decision. This shall not be applicable where the appellant is opposed by another party to the proceedings. The authority may order that the appeal fee be refunded. If the appeal is not rectified pursuant to sentence 1, it shall be remitted to the Patent Court before the expiration of one month, without comment as to its merits. In cases under sentence 2, the appeal shall be remitted to the Patent Court without delay.

### *Boards of Appeal; Public Oral Proceedings*

**67.**—(1) A Board of Appeal of the Patent Court shall decide on appeals within the meaning of [Section 66](#), composed of three legally qualified members.

(2) Proceedings concerning appeals from decisions by the Trade Mark Sections and Trade Mark Divisions, including the pronouncement of the decisions, shall be public if the registration has been published.

(3) **Sections 172 to 175** of the Judiciary Law [*Gerichtsverfassungsgesetz*] shall be applicable, *mutatis mutandis*, provided that

1. on the request of one of the parties, the public may also be excluded from the proceedings if publicity threatens to endanger the interests worthy of protection of the party making the request;
2. the public shall be excluded from the pronouncement of the decisions until the publication of the registration.

### *Intervention of the President of the Patent Office in Appeal Proceedings*

**68.**—(1) The President of the Patent Office may, if he considers it appropriate in order to safeguard the public interest, make written statements in appeal proceedings before the Patent Court, be present at hearings and make representations there. Written statements by the President of the Patent Office shall be communicated to the interested parties by the Patent Court.

(2) The Patent Court may, if it considers it appropriate on a legal question of basic importance, give the President of the Patent Office the opportunity to intervene in appeal proceedings. The President of the Patent Office shall become an interested party to the proceedings upon receipt of the notice of intervention.

### *Hearings*

**69.** A hearing shall take place if

1. one of the parties so requests;
2. evidence is to be taken before the Patent Court ([Section 74\(1\)](#)); or
3. the Patent Court considers it appropriate.

### *Decision in Respect of Appeals*

70.—(1) A decision shall be given on the appeal.

(2) The decision dismissing the appeal as inadmissible may be given without a hearing.

(3) The Patent Court may reverse the contested decision without deciding the case on its merits if

1. the Patent Office has not yet decided the case on its merits;
2. the proceedings before the Patent Office suffer from a substantial defect; or if
3. new facts or evidence have become known which are essential for the decision.

(4) The Patent Office must base its decision on the legal judgment on which the reversal pursuant to [subsection \(3\)](#) is based.

### *Costs of Appeal Proceedings*

71.—(1) When several persons are parties to the proceedings, the Patent Court may decide that the costs of the proceedings, including the costs incurred by the parties shall, to the extent that they can be reasonably considered to have been necessary for the appropriate defense of their interests and rights, be borne in whole or in part by one of the parties if and to the extent that this is equitable. Insofar as no such decision concerning the costs is made, each party to the proceedings shall meet the costs he has incurred.

(2) Costs may be imposed on the President of the Patent Office only if he has made petitions after his intervention in the proceedings.

(3) The Patent Court may order that the appeal fee ([Section 66\(5\)](#)) be refunded.

(4) [Subsections \(1\) to \(3\)](#) shall also be applicable if, either in whole or in part, the party withdraws the appeal, the trade mark application, the opposition or the cancellation request, or if, either in whole or in part, the trade mark registration is canceled in the Register due to surrender or non-renewal of the term of protection.

(5) In other respects, the provisions of the Code of Civil Procedure relating to the procedure for the assessment of costs and execution of the decisions regarding the assessment of costs shall apply *mutatis mutandis*.

### *Exclusion and Challenge*

72.—(1) For the exclusion and challenge of members of the court, [Sections 41 to 44](#) and [47 to 49](#) of the Code of Civil Procedure shall be applicable *mutatis mutandis*.

(2) Persons having participated in the previous proceedings before the Patent Office shall also be excluded from judicial office.

(3) The decision on the challenge of a judge shall be rendered by the Board to which the person who is challenged belongs. If, as a result of the elimination of the



member who has been challenged, the Board is unable to make a decision, another Board of Appeal shall render the decision.

(4) The decision on the challenge of a registrar shall be rendered by the Board to whose jurisdiction the matter belongs.

### *Investigation of Facts; Preparation of the Hearing*

**73.**—(1) The Patent Court shall investigate *ex officio* the facts of the case. It shall not be bound by the factual statements and the offers of proof of the parties.

(2) The presiding judge or a member of the Board appointed by him shall, before the hearing or, in the absence of a hearing, before the decision of the Patent Court, make all necessary arrangements for finally disposing of the matter, if possible in one hearing or in one session. In other respects, **Section 273(2), (3), sentence 1, and (4), sentence 1**, of the Code of Civil Procedure shall be applicable *mutatis mutandis*.

### *Taking of Evidence*

**74.**—(1) The Patent Court shall take evidence at the hearing. In particular, it may make inspections *in situ*, examine witnesses, experts and the parties, and order the consultation of documents.

(2) In appropriate cases, the Patent Court may, prior to the hearing, have evidence taken by one of its members as commissioned judge or, specifying particular questions of evidence, request another court to take such evidence.

(3) The parties shall be notified of all hearings in which evidence is taken and may attend such hearings. They may put relevant questions to witnesses and experts. If a question is objected to, the Patent Court shall decide.

### *Summons*

**75.**—(1) As soon as the date of the hearing is fixed, the parties shall be summoned with at least two weeks' notice. In urgent cases, the presiding judge may shorten this period.

(2) It shall be pointed out in the summons that if a party fails to appear, the case may be heard and decided in his absence.

### *Course of the Hearing*

**76.**—(1) The presiding judge shall open and conduct the hearing.

(2) After the case is called, the presiding judge or recording judge shall report on the essential contents of the files.

(3) Thereupon, the parties shall be given leave to speak in order to make and substantiate their motions.

(4) The presiding judge shall discuss with the parties the questions of fact and of law involved in the case.



(5) The presiding judge shall, upon request, permit each member of the Board to ask questions. If a question is objected to, the Board shall decide.

(6) After discussing the case, the presiding judge shall declare the hearing closed. The Board may decide to reopen the hearing.

### *Minutes*

77.—(1) At the hearing, and whenever evidence is taken, a registrar of the court shall be called in to act as minute-writer. If, by order of the presiding judge, no minute-writer is called in, one of the judges shall record the minutes.

(2) Minutes shall be taken of oral proceedings and of all taking of evidence. **Sections 160 to 165** of the Code of Civil Procedure shall apply *mutatis mutandis*.

### *Consideration of Evidence; Right to Be Heard Before the Court*

78.—(1) The Patent Court shall decide the case on the basis of its own conclusions freely reached in the light of the results of the proceedings as a whole. The decision must state the grounds which led the judges to form their conclusions.

(2) The decision may be based only on facts and the results of evidence on which the parties have had an opportunity to state their views.

(3) Where there has been a previous hearing, a judge not present at the last session of the hearing may participate in rendering the decision only if the parties consent.

### *Pronouncement; Service of the Decisions; Statement of Grounds*

79.—(1) Final decisions of the Patent Court shall, if a hearing has taken place, be rendered at the court session at which the hearing was concluded or at a session to be fixed forthwith. This deadline shall not be more than three weeks later except when important reasons, in particular the volume and the difficulty of the case, so require. Final decisions may be served upon the parties instead of being pronounced in court. If the Patent Court makes its decision without a hearing, pronouncement of the decision shall be replaced by service thereof upon the parties. Final decisions shall be served *ex officio* to the parties.

(2) Decisions of the Patent Court by which a motion is refused or a legal remedy is decided upon must state the grounds upon which the decision is based.

### *Corrections*

80.—(1) Typing errors, errors in calculation and similar obvious mistakes in the decision may at any time be corrected by the Patent Court.

(2) If the statement of facts as set out in the decision contains other mistakes or obscurities, correction may be requested within two weeks after service of the decision.

(3) The correction pursuant to [subsection \(1\)](#) may be decided by the Patent Court without a previous hearing.

(4) The Patent Court shall decide on the request for correction pursuant to [subsection \(2\)](#) without taking evidence. In such decisions, only judges who have taken part in rendering the decision whose correction is requested shall participate.

(5) The decision concerning the correction shall be recorded on the decision itself and the copies thereof.

### *Representation; Power of Attorney*

**81.**—(1) Any party may, at any stage of the proceedings, be represented before the Patent Court by an authorized representative. A decision may be made ordering the appointment of a representative. The provisions of [Section 96](#) shall not be affected.

(2) The power of attorney shall be filed in writing at the Court with the documents of the case. It may be filed later; for this purpose, the Patent Court may fix a time limit.

(3) The lack of power of attorney may be raised at any stage of the proceedings. The Patent Court shall *ex officio* consider the lack of a power of attorney if an attorney-at-law or patent attorney does not appear as the representative.

### *Application of Further Provisions; Appeals from Decisions; Inspection of Files*

**82.**—(1) In the absence of provisions in this Law concerning proceedings before the Patent Court, the Judiciary Law and the Code of Civil Procedure shall apply *mutatis mutandis* unless the special nature of the proceedings before the Patent Court does not so permit. [Section 227\(3\), sentence 1](#), of the Code of Civil Procedure shall not apply. In proceedings before the Patent Court, the Law on Court Costs [*Gerichtskostengesetz*] shall apply *mutatis mutandis* with respect to the expenses.

(2) Appeals from the decisions of the Patent Court shall lie only to the extent permitted under this Law.

(3) For the grant to third persons of permission to inspect the files of the case, [Section 62\(1\)](#) and [\(2\)](#) shall apply *mutatis mutandis*. The request for permission shall be decided upon by the Patent Court.

[Amended by Law of October 28, 1996]

## **Chapter 6**

### **Proceedings Before the Federal Court of Justice [*Bundesgerichtshof*]**

#### *Leave to Appeal on Points of Law*

**83.**—(1) An appeal on a point of law from the decisions of the Board of Appeal of the Patent Court in respect of an appeal under [Section 66](#) shall lie to the Federal Court of Justice if the Board of Appeal in its decision has given leave to appeal on the said point of law. An appeal on a point of law shall have suspensive effect.

(2) The appeal on a point of law shall be permitted if

1. a question of law of basic significance is to be decided; or

2. the further development of the law or the assurance of uniform judicial practice requires a decision by the Federal Court of Justice.

(3) Leave to appeal on a point of law shall not be required if one of the following procedural defects is denounced:

1. that the court which rendered the decision was not properly constituted;
2. that a judge having participated in rendering the decision was excluded by law from the exercise of judicial office or, because of the possibility of partiality, had been successfully challenged;
3. that one of the parties was denied the right to be heard in court;
4. that a party to the proceedings was not represented according to the provisions of the law, unless he expressly or tacitly agreed with the conduct of the proceedings;
5. that the decision was made on the basis of a hearing in which the provisions on the publicity of proceedings were violated; or
6. that the decision does not state the grounds therefor.

### *Right to Appeal; Basis for an Appeal*

**84.**—(1) The right to appeal on a point of law shall belong to the parties to the proceedings on appeal.

(2) The only basis for an appeal on a point of law shall be the argument that the decision is founded on a breach of the law. **Sections 550 and 551, Nos. 1 to 3 and 5 to 7**, of the Code of Civil Procedure shall apply *mutatis mutandis*.

### *Formal Requirements*

**85.**—(1) The appeal on a point of law shall be filed in writing with the Federal Court of Justice within one month after service of the decision.

(2) The provisions of [Section 142](#) on the reduction of the value in dispute shall apply *mutatis mutandis* in proceedings concerning appeals on points of law before the Federal Court of Justice.

(3) The appeal on a point of law shall state the grounds on which it is based. The period allowed for stating the grounds shall be one month; it shall commence with the filing of the appeal on a point of law and may, upon request, be extended by the presiding judge.

- (4) The statement of the grounds for the appeal on a point of law must contain
1. the declaration as to the extent to which the decision is contested and the modification or reversal thereof is requested;
  2. the indication of the violated rule of law; and

3. where the basis for the appeal on a point of law is the argument that the law was violated in respect of procedure, a statement of the facts constituting the defect.

(5) The parties must be represented before the Federal Court of Justice by an attorney-at-law, admitted to practice before the Court as authorized representative. Upon request of any party, the latter's patent attorney shall be given leave to speak. **Section 157(1) and (2)** of the Code of Civil Procedure shall not apply in this event. Of the costs arising from the collaboration of a patent attorney in the case, fees up to the amount of a full fee according to **Section 11** of the Federal Regulations on Fees for Attorneys-at-Law [*Bundesgebührenordnung für Rechtsanwälte*] shall be refunded, as well as the necessary expenses of the patent attorney.

[Amended by Law of July 16, 1998]

### *Examination of Admissibility*

**86.** The Federal Court of Justice shall examine *ex officio* whether the appeal on a point of law is in itself admissible and whether it has been filed and the grounds therefor have been stated in the form provided by law and within the prescribed time limit. If any of these requirements is lacking, the appeal on a point of law shall be dismissed as inadmissible.

### *Several Parties*

**87.—(1)** When several persons are parties to the proceedings in respect of an appeal on a point of law, the appeal and the statement of the grounds therefor shall be served upon the other parties, with the request to file declarations, if any, in writing with the Federal Court of Justice within a given period after service. The date on which the appeal was filed shall be communicated with the service of the appeal on a point of law. The appellant shall file the required number of certified copies together with the appeal or the statement of the grounds for the appeal.

(2) If the President of the Patent Office is not an interested party in an appeal on a point of law, [Section 68\(1\)](#) shall apply *mutatis mutandis*.

### *Application of Other Provisions*

**88.—(1)** In proceedings in respect of the appeal on a point of law, the provisions of the Code of Civil Procedure regarding exclusion and challenge of members of the court, authorized representatives and legal assistants, *ex-officio* service of documents, summonses, sessions and time limits, and reinstatement, shall apply *mutatis mutandis*. In the case of reinstatement, [Section 91\(8\)](#) shall apply *mutatis mutandis*.

(2) As to the publicity of the proceedings, [Section 67\(2\)](#) and [\(3\)](#) shall apply *mutatis mutandis*.

### *Decision on Appeals on a Point of Law*

**89.—(1)** The appeal on a point of law shall be the subject of a decision. Such decision may be rendered without a hearing.

(2) The Federal Court of Justice shall be bound, when rendering its decision, by the facts established in the decision appealed from, except when admissible and substantiated grounds for an appeal on a point of law are put forward in relation to such facts.

(3) The decision must state the grounds on which it is based and shall be served *ex officio* upon the interested parties.

(4) In the event of a reversal of the decision appealed against, the case shall be referred back to the Patent Court for a further hearing and decision. The Patent Court shall be bound to base its decision on the legal opinion on which the reversal is based.

### *Decision on Costs*

**90.**—(1) When several persons are parties to the proceedings, the Federal Court of Justice may decide that the costs of the proceedings including the costs incurred by the parties shall, to the extent that they were necessary for the appropriate defense of their claims and rights, be borne in whole or in part by one of the parties if and to the extent that this is equitable. Such determination may also be made if the appeal on a point of law, the trade mark application, the opposition or the cancellation request is wholly or partly withdrawn by the party or if, either in whole or in part, the registration of the trade mark is canceled in the Register due to surrender or non-renewal of the term of protection. Insofar as no such determination concerning the costs is made, each party shall individually meet the costs he has incurred.

(2) If the appeal on a point of law is rejected or dismissed as inadmissible, the costs arising from the appeal shall be awarded against the appellant. Costs arising from gross negligence of one of the parties shall be awarded against that party.

(3) Costs can only be imposed on the President of the Patent Office if he lodged the appeal on a point of law or made petitions in the proceedings.

(4) In other respects, the provisions of the Code of Civil Procedure relating to the procedure for the assessment of costs and execution of decisions regarding the assessment of costs shall apply *mutatis mutandis*.

## **Chapter 7 Common Provisions**

### *Reinstatement*

**91.**—(1) Any person who, through no fault of his own, has been prevented from observing a time limit before the Patent Office or the Patent Court, default of which is detrimental to his rights according to the provisions of the law, shall, on request, be reinstated. This provision shall not apply to the time limits for filing an opposition and paying the opposition fee.

(2) Reinstatement must be requested within two months after the removal of the impediment.

(3) The request must state the facts upon which the reinstatement may be based. These facts must be established by *prima facie* evidence at the time of filing the request or in the procedure relating thereto.

(4) The omitted act must be completed within the time limit for the request. If this is done, reinstatement may be granted without a request.

(5) After one year from the expiration of the time limit which has not been observed, reinstatement may no longer be requested and the omitted act may no longer be completed.

(6) A decision on the request shall be made by the authority which shall decide on the action to be made good.

(7) The decision on reinstatement shall not be appealable.

(8) If the proprietor of a trade mark is granted reinstatement and if, in the course of the period between the loss of rights to the trade mark registration and the reinstatement, third parties have placed goods on the market or rendered services in good faith with a sign identical with or similar to the trade mark, the proprietor of the trade mark shall not be entitled to assert any rights with regard to the said acts.

### *Duty to Tell the Truth*

**92.** In proceedings before the Patent Office, the Patent Court and the Federal Court of Justice the parties must make their statements on questions of fact fully and truthfully.

### *Official Language and Language in Court*

**93.** The language of the Patent Office and the Patent Court shall be German. In other respects, the provisions of the Judiciary Law concerning the language of the court shall be applicable.

### *Service of Documents*

**94.—(1)** For the purpose of the service of documents in proceedings before the Patent Office and the Patent Court, the provisions of the Law on Service in Administrative Procedures [*Verwaltungszustellungsgesetz*] shall apply subject to the following conditions:

1. service upon addressees residing abroad who have not appointed a representative in this country ([Section 96](#)) may also be effected by mail in accordance with [Sections 175](#) and [213](#) of the Code of Civil Procedure provided that it was possible for the addressee to recognize the necessity of appointing a representative in this country at the time of the service to be effected;
2. for the purpose of service upon holders of certificates of representation [*Erlaubnisscheininhaber*] ([Section 177](#) of the Patent Attorney Regulations [*Patentanwaltsordnung*]), [Section 5\(2\)](#) of the Law on Service in Administrative Procedures shall apply *mutatis mutandis*;

3. documents may also be served upon addressees for whom a mail box has been installed at the Patent Office or at the Patent Court, by depositing the said documents in the mail box of the addressee. A written statement relating to the deposit shall be added to the files of the case. The time of the deposit shall be recorded on the document. Service shall be deemed to have been effected on the third day after deposit in the mail box.

(2) [Section 9\(1\)](#) of the Law on Service in Administrative Procedures shall not apply if service marks the commencement of the period allowed for filing an objection [*Erinnerung*] ([Section 64\(2\)](#)), an appeal ([Section 66\(2\)](#)) or an appeal on a point of law ([Section 85\(1\)](#)).

### *Legal Assistance*

**95.**—(1) The courts shall be required to furnish legal assistance to the Patent Office.

(2) In proceedings before the Patent Office, the Patent Court shall, at the request of the Patent Office, impose subpoenas and coercive measures [*Ordnungs- oder Zwangsmittel*] against witnesses and experts who fail to appear or who refuse to give evidence or to give it under oath. Enforcement of the summons served on a witness who has failed to appear shall likewise be ordered.

(3) A Board of Appeal of the Patent Court composed of three legal members shall pronounce on the request made under [subsection \(2\)](#). Pronouncement in such case shall take the form of a decision.

### *Domestic Representative*

**96.**—(1) The proprietor of a filed or registered trade mark having neither a domicile nor a seat nor an establishment in this country may take part in proceedings before the Patent Office or the Patent Court regulated by this Law only if he has appointed a patent attorney or an attorney-at-law in this country as his representative.

(2) The representative appointed under [subsection \(1\)](#) shall be authorized to represent him in Patent Office and Patent Court proceedings and in civil litigation affecting the mark. The representative may also file requests for the institution of criminal proceedings.

(3) The place where the representative has his business premises shall be deemed, within the meaning of [Section 23](#) of the Code of Civil Procedure, to be the place where the assets are located. If there are no business premises, then the place where the representative has his domicile shall be relevant and, in the absence thereof, the place where the Patent Office has its seat.

(4) [Subsection \(1\)](#) shall apply *mutatis mutandis* to third parties participating in proceedings before the Patent Office or the Patent Court regulated by this Law.

## **PART 4 COLLECTIVE MARKS**

## *Collective Marks*

**97.**—(1) Any sign capable of being protected as a trade mark within the meaning of [Section 3](#) and capable of distinguishing the goods or services of the members of the proprietor of the collective mark from those of other undertakings according to their origin from a given enterprise or their geographical origin, their nature, quality or other properties may be registered as a collective mark.

(2) The provisions of this Law shall apply to collective marks unless otherwise provided for in this part of the Law.

## *Proprietorship*

**98.** Filed or registered collective marks may only be owned by associations having legal capacity including umbrella and head organizations having legal capacity and whose members are themselves associations. Legal persons governed by public law have the same status as these associations.

## *Registrability of Indications of Geographical Origin as Collective Marks*

**99.** In derogation from [Section 8\(2\), No. 2](#), signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute collective marks.

## *Restrictions on Protection; Use*

**100.**—(1) In addition to the restrictions of protection resulting from [Section 23](#), registration of an indication of geographical origin as a collective mark shall not entitle the proprietor to prohibit a third party from using such indications in the course of trade, provided such use is in accordance with the accepted principles of morality and does not contravene [Section 127](#).

(2) Use of a collective mark by at least one person who has authority to do so or by the proprietor of the collective mark shall be deemed to constitute use within the meaning of [Section 26](#).

## *Right of Action; Damages*

**101.**—(1) Unless otherwise provided in the regulations governing use of the collective mark, persons who have authority to use the collective mark may bring an action for infringement of a collective mark only with the consent of the proprietor.

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

## *Regulations Governing Use of the Mark*

**102.**—(1) The application for a collective mark must be accompanied by regulations governing use of the mark.



- (2) The regulations governing use of the mark shall at least specify
1. the name and the seat of the association;
  2. the purpose and representation of the association;
  3. the conditions of membership;
  4. information on the group of persons having authority to use the collective mark;
  5. the conditions of use of the collective mark;
  6. the rights and obligations of the parties concerned in the event of infringement of the collective mark.

(3) If the collective mark consists of an indication of geographical origin, the regulations governing use of the mark must provide that any person whose goods or services originate in the geographical area concerned and fulfill the conditions for use set out in the said regulations shall be authorized to become a member of the association and shall be admitted to the group of persons who have authority to use the mark.

- (4) Anyone may inspect the regulations concerning use of the mark.

### *Examination of the Application*

**103.** In addition to refusal under [Section 37](#) the application for a collective mark shall also be refused if it does not satisfy the requirements of [Sections 97, 98](#) and [102](#) or if the regulations governing use of the mark are contrary to public policy or to accepted principles of morality, unless the applicant amends the regulations concerning use of the mark in such a way that the ground for refusal ceases to exist.

### **Amendments of the Regulations Governing Use of the Mark**

**104.**—(1) The proprietor of the collective mark must communicate to the Patent Office any amendment to the regulations governing use of the mark.

(2) In the case of an amendment to the regulations governing use of the mark, [Sections 102](#) and [103](#) shall apply *mutatis mutandis*.

### *Revocation*

**105.**—(1) In addition to the grounds for revocation provided for in [Section 49](#), the registration of a collective mark shall upon request be canceled on the ground of revocation

1. if the proprietor of the collective mark no longer exists;
2. if the proprietor of the collective mark does not take reasonable steps to prevent the collective mark being wrongfully used in a manner incompatible with the purpose of the association or the regulations governing use of the mark; or
3. if an amendment to the regulations governing use of the mark has been entered in the Register in breach of the provisions of [Section 104\(2\)](#) unless

the proprietor of the mark further amends the said regulations in such a way that the ground for cancellation ceases to exist.

(2) Wrongful use within the meaning of [subsection \(1\), No. 2](#), shall in particular be deemed to exist if the collective mark is used by persons other than those authorized to use the collective mark in a manner suited to deceive the public.

(3) The request for cancellation under [subsection \(1\)](#) shall be filed with the Patent Office. The procedure shall be governed by [Section 54](#).

### *Nullity Because of Absolute Grounds for Refusal*

**106.** In addition to the grounds for nullity provided for in [Section 50](#), the registration of a collective mark shall upon request be canceled on the ground of nullity if it has been registered in breach of the provisions of [Section 103](#). If the ground for nullity relates to the regulations concerning use of the mark, the registration shall not be canceled if the proprietor of the collective mark amends the said regulations in such a way that the ground for nullity ceases to exist.

## **PART 5 PROTECTION OF MARKS UNDER THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE PROTOCOL RELATING TO THE MADRID AGREEMENT; COMMUNITY TRADE MARKS**

[Amended by Law of July 19, 1996]

### **Chapter 1 Protection of Marks Under the Madrid Agreement**

#### *Application of the Provisions of this Law*

**107.** The provisions of this Law shall be applicable *mutatis mutandis* to international registrations of marks under the Madrid Agreement Concerning the International Registration of Marks (Madrid Agreement) which are effected through the intermediary of the Patent Office or the protection of which extends to the territory of the Federal Republic of Germany unless otherwise provided in this Chapter or in the Madrid Agreement.

#### *Application for International Registration*

**108.—**(1) The application for international registration under [Article 3](#) of the Madrid Agreement of a registered mark shall be filed with the Patent Office.

(2) If the application for international registration is filed prior to the registration of the mark, the application shall be deemed to have been received on the date of the registration of the mark.

(3) The application for international registration shall be accompanied by a translation of the list of goods and services in the language prescribed for international registration. The list shall be arranged in the order of the classes of the International Classification of Goods and Services.

### *Fees*

**109.**—(1) The application for international registration shall be accompanied by a national fee as specified in the schedule of fees. If the application for international registration is filed prior to the registration of the mark, the fee shall become due on the date of registration. If the fee is not paid, the application shall be deemed not to have been filed.

(2) The international fees payable under [Article 8\(2\)](#) of the Madrid Agreement shall be paid directly to the International Bureau of the World Intellectual Property Organization.

### *Recordal in the Register*

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

### *Subsequent Territorial Extension*

**111.**—(1) If a request for subsequent territorial extension of the international registration of a mark is filed under [Article 3ter\(2\)](#) of the Madrid Agreement with the Patent Office, such request shall be accompanied by a national fee as specified in the schedule of fees. If the fee is not paid, the request shall be deemed not to have been filed.

(2) [Section 109\(2\)](#) shall apply *mutatis mutandis*.

### *Effect of International Registration*

**112.**—(1) The international registration of a mark the protection of which has been extended to the territory of the Federal Republic of Germany under [Article 3ter](#) of the Madrid Agreement shall have the same effect as if an application for the recordal of the mark in the Register kept by the Patent Office had been filed and the mark had been registered on the date of international registration under [Article 3\(4\)](#) of the Madrid Agreement or on the date of recordal of the subsequent territorial extension under [Article 3ter\(2\)](#) of the Madrid Agreement.

(2) The effect referred to in [subsection \(1\)](#) shall be deemed not to have accrued if the international registration of a mark is refused protection pursuant to [Sections 113 to 115](#).

### *Examination as to Absolute Grounds for Refusal*

**113.**—(1) International registrations of marks shall be examined as to absolute grounds for refusal under [Section 37](#) in the same way as marks in respect of which an application for registration has been filed. [Section 37\(2\)](#) shall not apply.

(2) Rejection of the application ([Section 37\(1\)](#)) shall be replaced by refusal of protection.

### *Opposition*

**114.**—(1) For the purpose of international registrations, publication of the registration ([Section 41](#)) shall be replaced by publication in the gazette published by the International Bureau of the World Intellectual Property Organization.<sup>1</sup>

(2) The time limit for lodging opposition ([Section 42\(1\)](#)) against the grant of protection for international registrations shall start on the first day of the month following the month indicated on the issue of the gazette containing the publication of the international registration.

(3) Cancellation of the registration ([Section 43\(2\)](#)) shall be replaced by refusal of protection.

### *Revocation of Protection a posteriori*

**115.**—(1) For the purpose of international registrations of marks the cancellation request or the action for cancellation on the ground of revocation ([Section 49](#)), the presence of absolute grounds for refusal ([Section 50](#)) or due to a prior right ([Section 51](#)) shall be replaced by the request or the action for revocation of protection.

(2) If a request for revocation of protection due to non-use under [Section 49\(1\)](#) is filed, the date of registration shall be replaced by the date on which the period according to [Article 5\(2\)](#) of the Madrid Agreement expired or, if the procedures under [Sections 113](#) and [114](#) have not yet been concluded upon expiry of this period, by the date of receipt of the final notification concerning the grant of protection by the International Bureau of the World Intellectual Property Organization.

### *Opposition and Request for Cancellation on the Basis of International Registrations*

**116.**—(1) If, on the basis of an international registration, opposition is lodged against the registration of a mark, [Section 43\(1\)](#) shall be applicable provided that the date of registration shall be replaced by the date specified in [Section 115\(2\)](#).

(2) If, on the basis of an international registration, an action for cancellation is brought under [Section 51](#), [Section 55\(3\)](#) shall be applicable provided that the date of registration shall be replaced by the date specified in [Section 115\(2\)](#).

### *Exclusion of Claims for Non-Use*

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<sup>1</sup> Gazette OMPI des marques internationales/WIPO Gazette of International Marks (published fortnightly) (Editor's note).

117. If claims within the meaning of [Sections 14, 18 and 19](#) are asserted because of infringement of an international registration, [Section 25](#) shall be applicable provided that the date of registration of the trade mark shall be replaced by the date specified in [Section 115\(2\)](#).

### *Consent to the Transfer of an International Registration*

118. The Patent Office shall give the International Bureau of the World Intellectual Property Organization the consent required under [Article 9bis\(1\)](#) of the Madrid Agreement in the event of the transfer of an international registration irrespective of whether the mark is recorded in the Register kept by the Patent Office for the new proprietor of the international registration.

## **Chapter 2 Protection of Marks Under the Protocol Relating to the Madrid Agreement**

### *Application of the Provisions of this Law*

119. The provisions of this Law shall apply *mutatis mutandis* to international registration of marks under the Madrid Protocol of June 27, 1989, Relating to the Madrid Agreement Concerning the International Registration of Marks (Protocol Relating to the Madrid Agreement) which are effected through the intermediary of the Patent Office or the protection of which extends to the territory of the Federal Republic of Germany unless otherwise provided in this Chapter or in the Protocol Relating to the Madrid Agreement.

### *Application for International Registration*

120.—(1) The application, under [Article 3](#) of the Protocol Relating to the Madrid Agreement, for international registration of a mark in respect of which an application for registration has been filed, or of a registered mark, shall be filed with the Patent Office. The application may be filed prior to the registration of the mark if the international registration is to be effected on the basis of a registered mark.

(2) If the international registration is to be effected on the basis of a registered mark and if the application for international registration is filed prior to the registration of the mark, the application for international registration shall be deemed to have been received on the date of registration of the mark.

(3) [Section 108\(3\)](#) shall be applicable *mutatis mutandis*.

### *Fees*

121.—(1) The application for international registration shall be accompanied by a national fee as specified in the schedule of fees.

(2) If the international registration is to be effected on the basis of a registered mark under the Madrid Agreement as well as according to the Protocol Relating to the Madrid

Agreement, a joint national fee as specified in the schedule of fees shall be paid for the application for international registration.

(3) If the international registration is to be effected on the basis of a registered mark and if the application for international registration was filed prior to the registration of the mark, the fee under [subsection \(1\)](#) or [subsection \(2\)](#) shall become due on the date of registration. If the fees under [subsection \(1\)](#) or [subsection \(2\)](#) are not paid, the application shall be deemed not to have been filed.

(4) The international fees payable under [Article 8\(2\)](#) or [Article 8\(7\)](#) of the Protocol Relating to the Madrid Agreement shall be paid directly to the International Bureau of the World Intellectual Property Organization.

### *Entry in the Files; Recordal in the Register*

**122.**—(1) If the international registration has been effected on the basis of an application for registration, the date and number of the international registration shall be entered in the file of the mark applied for.

(2) The date and number of the international registration effected on the basis of a registered mark shall be recorded in the Register. Sentence 1 shall also apply if the international registration has been effected on the basis of an application for registration and if the application has led to registration.

### *Subsequent Territorial Extension*

**123.**—(1) The request for subsequent territorial extension of the protection resulting from the international registration of a mark under [Article 3ter\(2\)](#) of the Protocol Relating to the Madrid Agreement shall be filed with the Patent Office. If the subsequent extension is to be effected on the basis of a registered mark and if the request has been filed prior to the registration of the mark, it shall be deemed to have been received on the date of registration.

(2) The request for subsequent territorial extension shall be accompanied by a national fee as specified in the schedule of fees. If the subsequent territorial extension on the basis of a registered mark is to be effected on the basis of the Madrid Agreement as well as on the basis of the Protocol Relating to the Madrid Agreement, the request for subsequent territorial extension shall be accompanied by a joint national fee as specified in the schedule of fees. If the fee under sentence 1 or sentence 2 is not paid, the application shall be deemed not to have been filed.

(3) [Section 121\(4\)](#) shall apply *mutatis mutandis*.

### *Analogous Application of the Provisions Concerning the Effect of International Registrations of Marks Under the Madrid Agreement*

**124.** [Sections 112 to 117](#) shall apply *mutatis mutandis* to international registrations of marks the protection of which has been extended to the territory of the Federal Republic of Germany under [Article 3ter](#) of the Protocol Relating to the Madrid Agreement provided that the provisions of the Madrid Agreement mentioned in

[Sections 112 to 117](#) shall be replaced by the corresponding provisions of the Protocol Relating to the Madrid Agreement.

### *Transformation of an International Registration*

**125.**—(1) Where an application under [Article 9quinquies](#) of the Protocol Relating to the Madrid Agreement for transformation of a mark canceled under [Article 6\(4\)](#) of the Protocol Relating to the Madrid Agreement is filed with and is received by the Patent Office with the necessary particulars prior to the expiry of a period of three months after the date of cancellation of the mark in the International Register, the date of the international registration of this mark under [Article 3\(4\)](#) of the Protocol Relating to the Madrid Agreement or the date of recordal of the territorial extension of protection under [Article 3ter\(2\)](#) of the Protocol Relating to the Madrid Agreement with the priority claimed for the international registration, if any, shall be decisive for the determination of seniority within the meaning of [Section 6\(2\)](#).

(2) The request for transformation shall be accompanied by a fee as specified in the schedule of fees. Where transformation 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 fees are not paid, [Section 36\(3\)](#) shall apply *mutatis mutandis*.

(3) The party filing the request shall present a certificate from the International Bureau of the World Intellectual Property Organization showing the mark and the goods or services in respect of which the protection of the international registration had effect in the Federal Republic of Germany prior to its cancellation in the International Register.

(4) In addition thereto, the party filing the request shall file a translation of the list of the goods or services in respect of which registration is sought.

(5) In all other respects, the request for transformation shall be treated as an application for the registration of a mark. Where, however, on the date of cancellation of the mark in the International Register, the period for refusal of protection under [Article 5\(2\)](#) of the Protocol Relating to the Madrid Agreement had already expired and no proceedings in respect of the refusal of protection or subsequent revocation of protection were pending on the said date, the mark shall be directly registered under [Section 41](#) without previous examination. No opposition shall be admissible against registration of a mark under sentence 2.

## **Chapter 3 Community Trade Marks**

[Chapter 3 added by Law of July 19, 1996]

### *Filing of Applications for Community Trade Marks with the Patent Office*

**125a.** If applications for Community trade marks are filed with the Patent Office under [Article 25\(1\)\(b\)](#) of Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community Trade Mark (*Official Journal of the European Communities* (OJEC) 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).

### *Application of the Provisions of this Law*

**125b.** The provisions of this Law shall apply to trade marks filed or registered under the Community Trade Mark Regulation in the following cases:

1. For the application of [Section 9](#) (relative grounds for refusal), earlier filed or registered Community trade marks shall be placed on an equal footing with earlier filed or registered trade marks under this Law with the proviso, however, that a reputation in the Community under [Article 9.1\(c\)](#) of the Community Trade Mark Regulation 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 Community Trade Mark Regulation, 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 opposition to 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* with the proviso that use of the earlier Community trade mark under [Article 15](#) of the Community Trade Mark Regulation shall be substituted for 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,
  - (a) [Section 51\(2\)](#), sentence 1 (forfeiture) shall apply *mutatis mutandis*;
  - (b) [Section 55\(3\)](#) (proof of use) shall apply *mutatis mutandis* with the proviso that use of the Community trade mark under [Article 15](#) of the Community Trade Mark Regulation 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*

**125c.**—(1) Where, in respect of a filed or registered Community trade mark, the priority of a trade mark recorded in the Register of the Patent Office has been claimed under [Article 34](#) or [35](#) of the Community Trade Mark Regulation and where the trade



mark recorded in the Register of the Patent Office has been canceled due to non-renewal of the period of protection under [Section 47\(6\)](#) or surrender under [Section 48\(1\)](#), the invalidity of the trade mark on grounds of revocation or nullity may be established later on 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 that 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 with 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*

**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 Community Trade Mark Regulation, 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 also 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 whether the request for conversion is admissible under [Article 108\(2\)](#) of the Community Trade Mark Regulation. 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, with the proviso that the date of filing of the Community trade mark within the meaning of [Article 27](#) of the Community Trade Mark Regulation or the priority date 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 priority of a trade mark recorded in the Register of the Patent Office is claimed under [Article 34](#) of the Community Trade Mark Regulation, that priority shall be substituted for the date in accordance with 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 priority. 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*

**125e.**—(1) For all actions for which the Community trade mark courts have jurisdiction within the meaning of **Article 91(1)** of the Community Trade Mark Regulation (Community trade mark litigation), the Provincial Courts [*Landgerichte*] shall have exclusive jurisdiction as Community trade mark courts of first instance without regard to the value in dispute.

(2) The Community trade mark court of second instance shall be the Higher Provincial Court [*Oberlandesgericht*] within whose jurisdiction the Community trade mark court of first instance is located.

(3) The governments of the *Länder* shall have the power to allot by statutory ordinance Community trade mark litigation for the areas of several Community trade mark courts to one such court. The governments of the *Länder* may transfer such power by statutory 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.

### *Informing the Commission*

**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 and 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*

**125g.** Where German Community trade mark courts have international jurisdiction under **Article 93** of the Community Trade Mark Regulation, such provisions concerning territorial jurisdiction shall apply *mutatis mutandis* as would be applicable to trade mark applications filed with the Patent Office or to trade marks recorded in the Register of the Patent Office. Where jurisdiction cannot be established under the above provisions, the court having territorial jurisdiction shall be the court where the plaintiff has his domicile.

### *Insolvency Proceedings*

**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 the Office for Harmonization in the Internal Market (Trade Marks and Designs) to record in the Community Trade Mark Register or, in the case of an application, in the files of the application

1. the opening of proceedings and, if not already contained therein, a restraint on disposal;
2. the release or realization of the Community trade mark or of the Community trade mark application;

3. the dismissal of proceedings; and
4. the annulment of proceedings, but in the case of control of the debtor, only after the control has been completed, and of any restraint on disposal.

(2) Recordal in the Community Trade Mark Register or in the files of the application may also be requested by the receiver. In the case of self-administration ([Section 270](#) of the Insolvency Code), the administrator shall act in place of the receiver.

## **PART 6**

### **INDICATIONS OF GEOGRAPHICAL ORIGIN**

#### **Chapter 1**

##### **Protection of Indications of Geographical Origin**

###### *Names, Indications or Signs Protected as Indications of Geographical Origin*

**126.**—(1) For the purposes of this Law, indications of geographical origin shall be names of places, areas, regions or countries as well as other indications or signs used in the course of trade to identify the geographical origin of goods or services.

(2) For the purposes of [subsection \(1\)](#), names, indications or signs of a generic nature shall not be eligible for protection as indications of geographical origin. Designations shall be considered to be of a generic nature which—although containing an indication of geographical origin within the meaning of [subsection \(1\)](#) or being derived therefrom—have lost their original meaning and serve as names of goods or services or as designations for or indications of the kind, nature, type or other properties or characteristics of goods or services.

###### *Scope of Protection*

**127.**—(1) Indications of geographical origin may not be used in the course of trade for goods or services which do not originate in the place, area, region or country designated by the indication of geographical origin if the use of such names, indications or signs for goods or services of a different origin entails the risk of misleading as to the geographical origin of the goods and services.

(2) If the goods or services marked by an indication of geographical origin show special properties or a special quality, the use of such indication of geographical origin in the course of trade for the respective goods or services of the said origin shall only be permitted if the goods or services have those properties or that quality.

(3) If an indication of geographical origin enjoys a special reputation, the use of such indication of geographical origin in the course of trade for goods or services of a different origin shall not be permitted even in the absence of a risk of misleading as to the geographical origin if the use for goods or services of a different origin is likely to take unwarranted and unfair advantage of, or be detrimental to, the reputation or the distinctive character of the indication of geographical origin.

(4) The above subsections shall also apply where names, indications or signs similar to the protected indication of geographical origin are used or where the indication of geographical origin is used with additions, provided that,

1. in the cases referred to in [subsection \(1\)](#), there is a risk of misleading as to the geographical origin in spite of the divergence or the additions; or
2. in the cases referred to in [subsection \(3\)](#), such use is likely to take unfair advantage of, or be detrimental to, the reputation or the distinctive character of the indication of geographical origin in spite of the divergence or the additions.

### *Injunctive Relief; Claim for Damages*

**128.**—(1) Persons entitled to assert claims pursuant to [Section 13\(2\)](#) of the Law Against Unfair Competition may claim an injunction against anyone who, in the course of trade, uses names, indications or signs in breach of [Section 127](#).

(2) Anyone who willfully or by negligence acts in breach of [Section 127](#) shall be liable to compensate for damages resulting therefrom.

(3) If the infringing act is committed in a business establishment by an employee or by an authorized person, the injunctive relief and, insofar as the employee or authorized person acted willfully or by negligence, the claim for damages may also be asserted against the owner of the business establishment.

### *Limitation*

**129.** Claims under [Section 128](#) shall come under the statute of limitations pursuant to [Section 20](#).

## **Chapter 2**

### **Protection of Geographical Indications and Designations of Origin Under Regulation (EEC) No. 2081/92**

### *Application for Registration of a Geographical Indication or Designation of Origin*

**130.**—(1) Applications for registration of a geographical indication or of a designation of origin in the Register of protected designations of origin and protected geographical indications kept by the Commission of the European Communities under Council Regulation (EEC) No. 2081/92 of July 14, 1992, on the Protection of Geographical Indications and Designations of Origin for Agricultural Products and Foodstuffs (OJEC), No. L 208, p. 1) in its applicable version shall be filed with the Patent Office.

(2) The application shall be accompanied by a fee as specified in the schedule of fees. If the fee is not paid, the application shall be deemed not to have been filed.

(3) If the examination of the application shows that the geographical indication or designation of origin filed for registration complies with the requirements specified in Regulation (EEC) No. 2081/92 and its implementing provisions, the Patent Office shall inform the applicant accordingly and transmit the application to the Federal Ministry of Justice.

(4) The Federal Ministry of Justice shall transmit the application with the required documents to the Commission of the European Communities.

(5) If the examination shows that the requirements for the registration of the filed geographical indication or designation of origin are not complied with, the application shall be rejected.

### *Request to Amend the Specification*

**131.** [Section 130](#) shall apply *mutatis mutandis* to requests to amend the specification of a geographical indication or of a designation of origin pursuant to [Article 9](#) of Regulation (EEC) No. 2081/92. No fee shall be payable.

### *Objections*

**132.**—(1) Objections under [Article 7\(3\)](#) of Regulation (EEC) No. 2081/92 to the registration of geographical indications and designations of origin in the Register of protected designations of origin and protected geographical indications kept by the Commission of the European Communities, or to amendments of the specification of a geographical indication or designation of origin, shall be filed with the Patent Office.

(2) A fee as specified in the schedule of fees shall be paid for the objection. If the fee is not paid in time, the objection shall be deemed not to have been raised.

### *Responsibilities in the Patent Office; Appeals*

**133.**—(1) The Trade Mark Divisions set up in the Patent Office shall be responsible for handling applications under [Sections 130](#) and [131](#) and objections under [Section 132](#).

(2) An appeal to the Federal Patent Court and an appeal on a point of law to the Federal Court of Justice shall lie from decisions taken by the Patent Office pursuant to the provisions specified in this Chapter. The provisions in Part 3 of this Law concerning appeal proceedings before the Patent Court and proceedings on appeals on a point of law before the Federal Court of Justice shall apply *mutatis mutandis*.

### *Supervision*

**134.**—(1) The supervision and inspection required under Regulation (EEC) No. 2081/92 and the provisions implementing the Regulation shall be incumbent upon the authorities responsible under *Land* law.

(2) As far as required for the supervision and inspection for the purposes of [subsection \(1\)](#), the agents of the responsible authorities may, in enterprises which produce or market agricultural products or foodstuffs ([Section 7\(1\)](#) of the Law on Foodstuffs and

Articles of Daily Use [*Lebensmittel- und Bedarfsgegenständegesetz*]) or which transfer, import or export such agricultural products or foodstuffs within the Community,

1. enter and inspect business premises and real properties, sales outlets and means of transport;
2. take samples against receipt; upon request of the party concerned, a part of the sample or, if the sample is indivisible, a second sample shall be left with him under official seal;
3. inspect and examine business records;
4. demand information,

during business or working hours. Such rights also extend to agricultural products or foodstuffs which are marketed in public areas, in particular markets, squares, streets or by peddling.

(3) Owners or managers of enterprises shall be liable to permit the entering and inspection of their business premises and real properties, sales outlets and means of transport, to display or have displayed the agricultural products or foodstuffs to be inspected in a way to enable the inspection in due form, to give or have given the necessary assistance during inspections, to allow the taking of samples, to submit their business records and to permit their examination as well as to supply information.

(4) If the supervision is effected during import or export, [subsections \(2\)](#) and [\(3\)](#) shall apply *mutatis mutandis* also to the person transferring, importing or exporting the agricultural products or foodstuffs within the Community on behalf of the owner of the enterprise.

(5) A person liable to supply information may refuse to give information in response to questions the answering of which would make him or one of the relatives specified in [Section 383\(1\), Nos. 1 to 3](#), of the Code of Civil Procedure liable to prosecution or proceedings under the Law on Administrative Offenses.

(6) For official acts to be performed under [Article 10](#) of Regulation (EEC) No. 2081/92 for inspection purposes, cost-covering fees and expenses shall be charged. The acts liable to fees shall be specified by *Land* law.

### *Injunctive Relief; Claim for Damages*

**135.**—(1) Persons entitled to assert claims under [Section 13\(2\)](#), of the Law Against Unfair Competition may claim an injunction against anyone who, in the course of trade, commits acts in breach of [Article 8](#) or [13](#) of Regulation (EEC) No. 2081/92.

- (2) [Section 128\(2\)](#) and [\(3\)](#) shall apply *mutatis mutandis*.

### *Limitation*

**136.** Claims under [Section 135](#) shall come under the statute of limitations according to [Section 20](#).

## **Chapter 3**

### **Authorization to Issue Legal Ordinances**

#### *Detailed Provisions for the Protection of Individual Indications of Geographical Origin*

**137.**—(1) The Federal Ministry of Justice shall have the power to lay down by legal ordinance detailed provisions concerning individual indications of geographical origin in agreement with the Federal Ministry of Economics, the Federal Ministry of Food, Agriculture and Forests and the Federal Ministry of Health, and with the consent of the Council of the *Länder*.

(2) The following may be laid down by legal ordinance:

1. the area of origin by reference to political or geographical borders;
2. the quality or other properties for the purposes of [Section 127\(2\)](#), and their relevant circumstances, in particular the process or method of manufacturing or producing the goods or of supplying the services, or the quality or other properties of the basic materials used, such as their origin; and
3. the way the indication of geographical origin is used.

In so doing, the existing fair practices and customs in using indications of geographical origin shall be taken into account.

#### *Other Provisions for the Procedure Concerning Applications, Requests and Oppositions Under Regulation (EEC) No. 2081/92*

**138.**—(1) The Federal Ministry of Justice shall have the power to lay down by legal ordinance detailed provisions concerning the application, request and opposition procedures ([Sections 130 to 133](#)) without the consent of the Council of the *Länder*.

(2) The power to issue legal ordinances under [subsection \(1\)](#) may be transferred in whole or in part by the Federal Ministry of Justice to the President of the Patent Office by legal ordinance without the consent of the Council of the *Länder*.

#### *Provisions Implementing Regulation (EEC) No. 2081/92*

**139.**—(1) The Federal Ministry of Justice shall have the power to lay down by legal ordinance further details of the protection of designations of origin and of geographical indications under Regulation (EEC) No. 2081/92 in agreement with the Federal Ministry of Economics, the Federal Ministry of Food, Agriculture and Forests and the Federal Ministry of Health and with the consent of the Council of the *Länder* as far as required in consequence of Regulation (EEC) No. 2081/92 or of its implementing provisions issued by the Council or the Commission of the European Union. By legal ordinance under sentence 1 may be laid down in particular provisions concerning

1. the marking of the agricultural products or of the foodstuffs;
2. the right to use the protected names; or



3. the requirements and the procedure for supervising and inspecting the transfer, import or export, within the Community.

Ordinances under sentence 1 may also be laid down if the Member States are authorized to issue supplementary provisions under the Community law provisions mentioned here.

(2) The governments of the *Länder* shall have the power to transfer by means of legal ordinance the carrying out of the inspections required under [Article 10](#) of Regulation (EEC) No. 2081/92 to approved private inspection bodies, or to involve such bodies in carrying out these inspections. The governments of the *Länder* may also lay down by legal ordinance the requirements and procedure for the approval of private inspection bodies. They shall be authorized to transfer the power under sentences 1 and 2 by legal ordinance in whole or in part to other authorities.

## PART 7

### PROCEDURE IN LITIGATION CONCERNING SIGNS

#### *Litigation Concerning Signs*

**140.**—(1) For all actions whereby a claim arising out of one of the legal relationships regulated under this Law is asserted (litigation concerning signs), the Provincial Courts shall have exclusive jurisdiction without regard to the value in dispute.

(2) The governments of the *Länder* shall have the power to designate by legal ordinance for the areas of several Provincial Courts one such court to be in whole or in part the competent court for litigation concerning signs, provided that such designation serves the advancement in substance or the faster conclusion of the proceedings. The governments of the *Länder* may transfer those powers to the Ministries of Justice of the *Länder*. The *Länder* may moreover transfer by agreement functions incumbent upon the courts of one of the *Länder* in whole or in part to the competent court of another *Land*.

(3) In cases of litigation concerning signs, the parties may also be represented before the court by attorneys-at-law admitted to practice in the Provincial Court before which the action, in the absence of a designation under [subsection \(2\)](#), would be heard. Sentence 1 shall apply *mutatis mutandis* in the case of representation before the Court of Appeal.

(4) Any additional costs incurred by a party through arranging to be represented, as provided in [subsection \(3\)](#), by an attorney-at-law not admitted to practice in the court hearing the case, shall not be refunded.

(5) Of the costs arising from the collaboration of a patent attorney in litigation concerning signs, fees up to the amount of a full fee according to [Section 11](#) of the Federal Fee Ordinance for Attorneys-at-law shall be refunded, as well as the necessary expenses of the patent attorney.

#### *Venue for Claims Under this Law and Under the Law Against Unfair Competition*



**141.** Claims concerning the legal relationships regulated under this Law and based on the provisions of the Law Against Unfair Competition shall not be required to be asserted before the forum provided for in **Section 24** of the Law Against Unfair Competition.

### *Reduction of the Value in Dispute*

**142.**—(1) If, in civil litigation whereby a claim arising out of one of the legal relationships regulated under this Law is asserted by a law suit, a party satisfies the court that the awarding of the costs of the case against him according to the full value in dispute would considerably endanger his financial position, the court may, at his request, order that the said party's liability to pay court costs be adjusted in accordance with a portion of the value in dispute that shall be appropriate to his financial position.

(2) As a result of the order under [subsection \(1\)](#), the favored party shall likewise be required to pay the fees of his attorney-at-law only in accordance with that portion of the value in dispute. To the extent that the costs of the case are awarded against him or to the extent to which he assumes such costs, he shall be required to refund the court fees paid by the opposing party and the fees of the latter's attorney-at-law only in accordance with that portion of the value in dispute. To the extent that the extrajudicial costs are ordered to be paid by the opposing party or are assumed by that party, the attorney-at-law of the favored party may recover his fees from the opposing party in accordance with the value in dispute applying to the latter.

(3) The request under [subsection \(1\)](#) may be declared before and recorded at the registrar's office of the court. It shall be presented before the substance of the case is heard. Thereafter, it shall only be admissible if the presumed or fixed value in dispute is subsequently increased by the court. Before the decision is given on the request, the opposing party shall be heard.

## **PART 8**

### **PROVISIONS GOVERNING OFFENSES PUNISHABLE WITH IMPRISONMENT OR FINES; SEIZURE ON IMPORT OR EXPORT**

#### **Chapter 1**

#### **Provisions Governing Offenses Punishable with Imprisonment or Fines**

### *Punishable Infringement of Signs*

**143.**—(1) Any person who, in the course of trade, unlawfully

1. uses a sign contrary to [Section 14\(2\), No. 1](#) or [2](#);
2. uses a sign with the intention of taking advantage of or of impairing the distinctive character or the repute of a mark which has a reputation contrary to [Section 14\(2\), No. 3](#);

3. affixes a sign contrary to [Section 14\(4\), No. 1](#), or offers for sale, puts on the market, stocks, imports or exports a packaging or wrapping or a means of marking contrary to [Section 14\(4\), No. 2](#) or [3](#), insofar as third parties would be prohibited from using the sign
  - (a) under [Section 14\(2\), No. 1](#) or [2](#);
  - (b) under [Section 14\(2\), No. 3](#), and the act is committed with the intention of allowing the distinctive character or the repute of a mark which has a reputation to be taken advantage of or to be impaired;
4. uses a designation or a sign contrary to [Section 15\(2\)](#); or
5. uses a designation or a sign contrary to [Section 15\(3\)](#) with the intention of taking advantage of or of impairing the distinctive character or the repute of a commercial designation which has a reputation,

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

(1a) Any person who infringes the rights of the proprietor of a trade mark protected under the statutory provisions of the European Community shall be liable to the same penalties insofar as a statutory order under [subsection \(7\)](#) refers to this penal provision in connection with a specific offense.

(2) If the offender acts on a commercial basis, he shall be punished by imprisonment of up to five years or by a fine.

(3) The attempt to commit such an offense shall be punishable.

(4) Where the cases referred to in [subsections \(1\)](#) and [\(1a\)](#) are applicable, the offense shall only be prosecuted upon request unless in the opinion of the prosecution authority *ex-officio* intervention is required in view of the particular public interest in criminal prosecution.

(5) Objects implicated in the offense may be confiscated. [Section 74a](#) of the Penal Code [*Strafgesetzbuch*] shall apply. Where the claims to destruction referred to in [Section 18](#) are upheld in proceedings under the Code of Criminal Procedure with regard to the compensation of the injured party ([Sections 403 to 406c](#) of the Code of Criminal Procedure), the provisions on confiscation shall not be applicable.

(6) In the case of conviction, the sentence shall be published if the injured party so requests and if he has a legitimate interest in so doing. The scope and nature of the publication shall be determined in the judgment.

(7) The Federal Ministry of Justice shall have power to determine by statutory order and without the consent of the Council of the *Länder* the offenses punishable as criminal offenses under [subsection \(1a\)](#) where required in order to implement the protection of trade marks afforded by the statutory provisions of the European Community.

[Amended by Law of July 19, 1996]

*Punishable Use of Indications of Geographical Origin*

**144.**—(1) Any person who, in the course of trade, unlawfully uses an indication of geographical origin, a name, an indication or a sign

1. contrary to [Section 127\(1\)](#) or [\(2\)](#), also in conjunction with [subsection \(4\)](#) or a statutory order under [Section 137\(1\)](#), respectively; or
2. with the intention of taking advantage of or of impairing the reputation or the distinctive character of an indication of geographical origin contrary to [Section 127\(3\)](#), also in conjunction with [subsection \(4\)](#) or a statutory order under [Section 137\(1\)](#),

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

(2) Any person who unlawfully uses, in the course of trade, a geographical indication or a designation of origin protected under the legal provisions of the European Community shall be punished in the same way insofar as an ordinance under [subsection \(6\)](#) refers to this penal provision in connection with a specific offense.

(3) The attempt to commit such an offense shall be punishable.

(4) In the case of conviction, the court shall order that the unlawful marking of the objects which are in the possession of the convicted person be removed or, if this is not possible, that the objects be destroyed.

(5) If a sentence is awarded, its publication shall be ordered if this is necessary in the public interest. The scope and nature of the publication shall be determined in the judgment.

(6) The Federal Ministry of Justice shall have power to determine by legal ordinance and without the consent of the Council of the *Länder* the offenses punishable as criminal offenses under [subsection \(2\)](#) insofar as this is necessary in view of implementing the protection of geographical indications and designations of origin provided in legal provisions of the European Community.

[Amended by Law of July 19, 1996]

### *Provisions Governing Fines*

**145.**—(1) An administrative offense shall be deemed to be committed by any person who, in the course of trade, uses for marking goods or services, in identical or counterfeit form,

1. armorial bearings, flags or other emblems of a State or the armorial bearings of a locality or an association of communities or an association of other communal entities within the country within the meaning of [Section 8\(2\), No. 6](#);
2. official signs and hallmarks within the meaning of [Section 8\(2\), No. 7](#); or
3. other signs, seals or designations within the meaning of [Section 8\(2\), No. 8](#).

(2) An administrative offense shall be deemed to be committed by any person who, willfully or negligently,

1. contrary to [Section 134\(3\)](#), also in conjunction with [subsection \(4\)](#),

- (a) does not permit the entering or inspection of business premises and real properties, sales outlets or means of transport;
  - (b) does not display the agricultural products or foodstuffs to be inspected so as to make it possible for the inspection to be carried out in due form;
  - (c) fails to provide the necessary assistance in the case of inspections;
  - (d) does not permit the taking of samples;
  - (e) does not submit business records or does not submit them in full or does not permit their examination; or
  - (f) fails to supply information or does not supply it correctly or fully; or
2. contravenes an ordinance issued under [Section 139\(1\)](#) provided it refers to this provision governing fines in connection with a specific offense.

(3) The administrative offense may be punished by a fine of up to DEM 5,000 in the cases referred to in [subsection \(1\)](#), and by a fine of up to DEM 20,000 in the cases referred to in [subsection \(2\)](#).

(4) In the cases referred to in [subsection \(1\)](#), [Section 144\(4\)](#) shall apply *mutatis mutandis*.

## **Chapter 2**

### **Seizure of Goods on Import or Export**

#### *Seizure in Case of Infringement of Rights to a Sign*

**146.**—(1) Goods which unlawfully bear a mark or a commercial designation protected by this Law shall be subject, upon request by the holder of the rights and against his security, to seizure by the customs authorities, on import or export, in those cases where the infringement is obvious and unless Council Regulation (EC) No. 3295/94 of 22 December 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 (OJEC No. L 341, p. 8) applies. This provision shall apply in trade with other Member States of the European Union as well as the other Contracting States of the Convention Concerning the European Economic Area only insofar as controls are carried out by the customs authorities.

(2) Where the customs authorities order a seizure, they shall advise the person entitled to the right of disposal and the petitioner thereof without delay. The origin, quantity and place of storage of the goods, together with the name and address of the person entitled to the right of disposal, shall be communicated to the petitioner. The secrecy of correspondence and mail (**Article 10** of the Basic Law [*Grundgesetz*]) shall be restricted to that extent. The petitioner shall be given the opportunity to inspect the goods where such inspection does not constitute a breach of commercial or trade secrecy.

[Amended by Law of July 19, 1996]

### *Confiscation; Opposition; Release of Goods Seized*

**147.**—(1) Where no opposition to the seizure is made, at the latest within two weeks of service of the notification under [Section 146\(2\)](#), sentence 1, the customs authorities shall order confiscation of the seized goods.

(2) If the person entitled to the right of disposal opposes seizure, the customs authorities shall inform the petitioner without delay. The petitioner shall be required to declare to the customs authorities without delay whether he maintains the request under [Section 146\(1\)](#) in respect of the seized goods.

(3) If the petitioner withdraws his request, the customs authorities shall lift the seizure without delay. If the petitioner maintains his request and submits an executable court decision ordering the impounding of the seized goods or limitation of the right of disposal, the customs authorities shall take the necessary measures.

(4) Where neither of the cases referred to in [subsection \(3\)](#) is applicable, the customs authorities shall lift the seizure on the expiry of two weeks after service of the notification on the petitioner under [subsection \(2\)](#). Where the petitioner can show that a court decision under [subsection \(3\)](#), sentence 2, has been requested, but has not yet been received, the seizure shall be maintained for a further two weeks at the most.

### *Competence; Remedies*

**148.**—(1) The request under [Section 146\(1\)](#) shall be submitted to the Regional Finance Office [*Oberfinanzdirektion*] and be effective for two years unless a shorter period of validity has been requested. The request may be repeated.

(2) The cost of official acts related to the request shall be charged to the petitioner in accordance with [Section 178](#) of the Fiscal Code [*Abgabenordnung*].

(3) Seizure and confiscation may be opposed by the legal remedies allowed by the fixed penalty procedure under the Law on Minor Offenses [*Gesetz über Ordnungswidrigkeiten*] in respect of seizure and confiscation. The petitioner shall be heard in the review proceedings. An immediate appeal shall lie from the decision of the Local Court [*Amtsgericht*]. The immediate appeal shall be heard by the Higher Provincial Court.

### *Damages in the Case of Unjustified Seizure*

**149.** Where the seizure proves to have been unjustified from the beginning and if the petitioner has maintained the request under [Section 146\(1\)](#) in respect of the seized goods or has not made a declaration without delay ([Section 147\(2\)](#), sentence 2), he shall be required to compensate the damages that seizure has occasioned to the person entitled to the right of disposal.

### *Seizure Under Regulation (EC) No. 3295/94*

**150.** In proceedings under the Regulation mentioned in [Section 146\(1\)](#), [Sections 146 to 149](#) shall apply *mutatis mutandis* unless otherwise provided by the Regulation.

[Amended by Law of July 19, 1996]

*Seizure in the Case of Unlawful Marking with Indications of Geographical Origin*

**151.**—(1) Goods which unlawfully bear an indication of geographical origin protected by this Law or by provisions of the European Community shall be subject, on import, export or in transit, to seizure for the purpose of removing the unlawful marking where the infringement is obvious. This provision shall apply in trade with other Member States of the European Union as well as the other Contracting States of the Convention Concerning the European Economic Area only insofar as controls are carried out by the customs authorities.

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

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

(4) Seizure and confiscation may be opposed by the legal remedies allowed by the fixed penalty procedure under the Law on Minor Offenses in respect of seizure and confiscation. An immediate appeal shall lie from the decision of the Local Court. The immediate appeal shall be heard by the Higher Provincial Court.

## **PART 9 TRANSITIONAL PROVISIONS**

*Application of this Law*

**152.** Unless otherwise provided herein below, the provisions of this Law shall also apply to trade marks in respect of which an application has been filed or which have been registered prior to January 1, 1995, or which have been acquired through use in the course of trade or through notoriety, and to commercial designations protected under the applicable provisions prior to January 1, 1995.

*Restrictions on the Assertion of Claims for Infringement*

**153.**—(1) Where the proprietor of a trade mark registered prior to January 1, 1995, or a trade mark or commercial designation acquired prior to this date through use or notoriety was not entitled under the provisions applicable at that time to any claims for infringement against the use of the trade mark, the commercial designation or an identical sign, the rights resulting from the trade mark or the commercial designation under this Law cannot be asserted against the continued use of the said trade mark, commercial designation or sign.

(2) [Section 21](#) shall apply to claims of the proprietor of a trade mark registered prior to January 1, 1995, or a trade mark or commercial designation acquired through use

or notoriety prior to this date provided that the period of five years specified in [Section 21\(1\)](#) and [\(2\)](#) shall begin on January 1, 1995.

### *Rights in rem; Enforcement; Proceedings in Bankruptcy*

**154.**—(1) Where, prior to January 1, 1995, the right conferred by the application for, or the registration of, a trade mark has become the subject of rights *in rem* or where the right conferred by the application or registration has been the subject of enforcement measures, the said rights or measures may be entered in the Register under [Section 29\(2\)](#).

(2) [Subsection \(1\)](#) shall apply *mutatis mutandis* if the right conferred by the application for, or registration of, a trade mark is implicated in proceedings in bankruptcy.

### *Licensing*

**155.** [Section 30](#) shall apply to licenses granted prior to January 1, 1995, under the right conferred by the application for, or the registration of a trade mark, by the use thereof or notoriety of a trade mark provided that the said licenses shall benefit from the effect of [Section 30\(5\)](#) only insofar as the rights were transferred, or the licenses were granted to third parties after January 1, 1995.

### *Examination of Trade Mark Applications as to Absolute Grounds for Refusal*

**156.**—(1) If a sign was filed prior to January 1, 1995, which under the provisions heretofore in force was excluded from registration for reasons the Patent Office had to take into account *ex officio*, but which is not excluded from registration pursuant to [Section 3](#), [7](#), [8](#) or [10](#) of this Law, the provisions of this Law shall be applied provided that the application shall be deemed to have been filed on January 1, 1995, and that, irrespective of the original filing date and of any claimed priority, January 1, 1995, shall be decisive for the determination of the seniority for the purposes of [Section 6\(2\)](#).

(2) If, upon examining the trade mark application, the Patent Office concludes that the requirements of [subsection \(1\)](#) are complied with, it shall notify the applicant accordingly.

(3) If the applicant notifies the Patent Office within a period of two months after the date of service of the notification under [subsection \(2\)](#) that he agrees to the postponement of seniority for the purposes of [subsection \(1\)](#), the application for the sign shall be further processed as an application for a trade mark under this Law.

(4) If the applicant notifies the Patent Office that he does not agree to a postponement of the seniority for the purposes of [subsection \(1\)](#), or if he does not make a statement within the period specified in [subsection \(3\)](#), the Patent Office shall reject the application.

(5) The applicant may also make the statement under [subsection \(3\)](#) in objection proceedings, appeal proceedings or proceedings on appeals on a point of law dealing with the rejection of the application and pending on January 1, 1995. [Subsections \(2\) to \(4\)](#) shall apply *mutatis mutandis*.



## *Publication and Registration*

**157.** If the publication of an application pursuant to [Section 5\(1\)](#) of the former Trade Mark Law was decided prior to January 1, 1995, but the application has not yet been published pursuant to [Section 5\(2\)](#), of the former Trade Mark Law [*Warenzeichengesetz*], the trade mark shall be registered pursuant to [Section 41](#) without previous publication. If the fee specified in [Section 6a\(2\)](#) of the former Trade Mark Law has already been paid for a request for accelerated registration filed after the decision to publish, the fee shall be refunded *ex officio*.

## *Opposition Proceedings*

**158.**—(1) If the application for a trade mark under [Section 5\(2\)](#) of the former Trade Mark Law or the registration of a trade mark under [Section 6a\(3\)](#) of the former Trade Mark Law in conjunction with [Section 5\(2\)](#) of the former Trade Mark Law was published prior to January 1, 1995, oppositions lodged within the period specified in [Section 5\(4\)](#) of the former Trade Mark Law may be based on the grounds for opposition under [Section 5\(4\)](#) of the former Trade Mark Law as well as on the grounds for opposition under [Section 42\(2\)](#). If no opposition is lodged within the period specified in [Section 5\(4\)](#) of the former Trade Mark Law, the trade mark shall be registered pursuant to [Section 41](#), unless the trade mark has been registered under [Section 6a\(1\)](#) of the former Trade Mark Law. Opposition under [Section 42](#) shall not lie from such registration.

(2) If opposition under [Section 5\(4\)](#) of the former Trade Mark Law was lodged prior to January 1, 1995, to the registration of a trade mark published under [Section 5\(2\)](#) of the former Trade Mark Law or registered under [Section 6a\(1\)](#) of the former Trade Mark Law, or if an opposition under [subsection \(1\)](#) is lodged after January 1, 1995, the grounds for opposition according to [Section 5\(4\)](#), [Nos. 2 and 3](#), of the former Trade Mark Law shall be further applied, provided that the opposition was based thereon. If the opposition was based on [Section 5\(4\)](#), [No. 1](#), of the former Trade Mark Law, the provision of [Section 42\(2\)](#), [No. 1](#), shall apply instead of this provision.

(3) If in proceedings concerning an opposition lodged prior to January 1, 1995, the use of the trade mark on the basis of which opposition was lodged has been contested or if use is contested in such opposition proceedings, [Section 43\(1\)](#) shall apply *mutatis mutandis* instead of [Section 5\(7\)](#) of the former Trade Mark Law. Sentence 1 shall also apply to appeal proceedings before the Patent Court in cases where such proceedings are pending on January 1, 1995. Sentence 1 shall not apply to appeals on a point of law pending on January 1, 1995.

(4) If the opposition is rejected, the trade mark shall be recorded in the Register pursuant to [Section 41](#) unless the trade mark has been registered pursuant to [Section 6a\(1\)](#) of the former Trade Mark Law. Opposition under [Section 42](#) shall not lie from such registration.

(5) If the opposition to an application published under [Section 5\(2\)](#) of the former Trade Mark Law is allowed, registration shall be refused. If the opposition to a trade mark registered under [Section 6a\(1\)](#) of the former Trade Mark Law is allowed, the registration shall be canceled under [Section 43\(2\)](#), sentence 1.



(6) In the cases referred to in [subsection \(1\)](#), sentence 2, and [subsection \(4\)](#), sentence 1, the application shall not be rejected because of grounds for refusal to be taken into account *ex officio*.

### *Division of an Application*

**159.** [Section 40](#) shall apply to the division of an application published prior to January 1, 1995, pursuant to [Section 5\(2\)](#) of the former Trade Mark Law, provided that the division may be declared only after the expiration of the time limit for lodging opposition and that the declaration shall only be admissible if an opposition pending on the filing date of the request would be directed after division only against one of the parts of the original application. The part of the original application not affected by opposition shall be registered pursuant to [Section 41](#) Opposition under [Section 42](#) shall not lie from such registration.

### *Period of Protection and Renewal*

**160.** The provisions of this Law concerning the period of protection and renewal of the registration ([Section 47](#)) shall also apply to trade marks registered prior to January 1, 1995, provided that, if the period of protection under [Section 9\(2\)](#) of the former Trade Mark Law expires prior to January 1, 1995, the provisions of [Section 9\(2\)](#) of the former Trade Mark Law shall still apply to the calculation of the time limit within which the fees for the renewal of the period of protection of a registered trade mark can effectively be paid before they fall due.

### *Cancellation of a Registered Trade Mark on the Grounds of Revocation*

**161.**—(1) If a request for cancellation of the registration of a trade mark under [Section 11\(4\)](#) of the former Trade Mark Law was filed with the Patent Office prior to January 1, 1995, and if the time limit for lodging opposition to the cancellation, specified in [Section 11\(4\)](#), sentence 3, of the former Trade Mark Law has not expired on January 1, 1995, the time limit shall be two months.

(2) If an action for cancellation of the registration of a trade mark under [Section 11\(1\), No. 3](#) or [4](#), of the former Trade Mark Law was instituted prior to January 1, 1995, the registration shall only be canceled if the action is allowed both under the provisions heretofore in force and under the provisions of this Law.

### *Cancellation of a Registered Trade Mark Because of Absolute Grounds for Refusal*

**162.**—(1) If the proprietor of a trade mark was notified prior to January 1, 1995, that the registration of the trade mark is to be canceled under [Section 10\(2\), No. 2](#), of the former Trade Mark Law, and if the time limit for lodging opposition to the cancellation specified in [Section 10\(3\)](#), sentence 2, of the former Trade Mark Law has not expired on January 1, 1995, this time limit shall be two months.

(2) If proceedings for cancellation of the registration of a trade mark because of the existence of absolute grounds for refusal under [Section 10\(2\), No. 2](#), of the former Trade Mark Law were instituted *ex officio* prior to January 1, 1995, or if a request for

cancellation under that provision was filed prior to that date, the registration shall only be canceled if the trade mark is not protectable under the provisions heretofore in force or under the provisions of this Law. This shall also apply to proceedings instituted after January 1, 1995, under [Section 54n](#) in view of the cancellation of the registration of a trade mark recorded prior to January 1, 1995.

### *Cancellation of a Registered Trade Mark Due to Earlier Rights*

**163.**—(1) If an action for cancellation of the registration of a trade mark was instituted prior to January 1, 1995, on the ground of an earlier application under [Section 11\(1\), No. 1](#), of the former Trade Mark Law, or on the ground of any other earlier right, the registration shall, unless otherwise provided in [subsection \(2\)](#), only be canceled if the action is allowed under the provisions heretofore in force as well as under the provisions of this Law. This shall also apply to an action instituted after January 1, 1995, under [Section 55](#) in view of the cancellation of the registration of a trade mark recorded prior to January 1, 1995.

(2) [Section 51\(2\)](#), sentences 1 and 2, shall not apply to the cases referred to in [subsection \(1\)](#), sentence 1. In the cases referred to in [subsection \(1\)](#), sentence 2, [Section 51\(2\)](#), sentences 1 and 2, shall apply provided that the time limit of five years shall commence on January 1, 1995.

### *Objection and Direct Appeal*

**164.** The provisions of this Law shall also apply to objections raised prior to January 1, 1995, provided that the time limits of six months and 10 months specified in [Section 66\(3\)](#), sentences 1 and 2, shall commence on January 1, 1995.

### *Transitional Provisions*

**165.**—(1) [Section 33\(3\)](#) shall not apply to applications filed with the Patent Office prior to January 1, 1998, for entry of a trade mark in the Register.

(2) Up to January 1, 1999, [Section 125h](#) shall apply with the proviso that bankruptcy proceedings shall be substituted for insolvency proceedings, bankruptcy court for insolvency court, bankruptcy assets for insolvency assets and receiver in bankruptcy proceedings for receiver in insolvency proceedings.

[Amended by Law of June 22, 1998]

*(This text replaces those previously published under code numbers 3-001 and 3-002.)*