

**Law
to Revise the Rules on Costs
in the Field of Intellectual Property**

of 13 December 2001

The Bundestag [Federal Parliament] has passed the following Law:

Articles 1 to 6 ...

Article 7

Amendment of the Patent Law

(420-1)

The Patent Law in the version published on 16 December 1980 (Federal Law Gazette 1981 I p. 1), last amended by Article 5 paragraph 20 of the Law of 26 November 2001 (Federal Law Gazette I p. 3138), shall be amended as follows:

1. The wording "Part XII: Transitional Provisions Section 147" shall be added to the Table of Contents.
2. ...
3. Section 16a shall be amended as follows:
 - a) In subsection (1), second sentence, the words "in accordance with the schedule of fees" shall be deleted.
 - b) In subsection (2), the words "(Sections 17 (2) to (6), 18 and 19)" shall be replaced by the words "(Section 17 (2))".
4. Section 17 shall be amended as follows:
 - a) In subsection (1), the words "as prescribed in the schedule of fees" shall be deleted.
 - b) Subsections (3) to (6) shall be repealed.
5. Section 18 shall be repealed.
6. Section 19 shall be repealed.
7. Section 20 (1), No. 3, shall be worded as follows:

"3. the annual fee or the differential amount are not paid in due time (Section 7 (1), Section 13 (3) or Section 14 (2) and (5) of the Patent Costs Law, Section 23 (7), fourth sentence, of this Law)."
8. Section 23 shall be amended as follows:

- a) Subsection (1) shall be worded as follows:

"(1) If the applicant for a patent or the person recorded as patentee in the Register (Section 30 (1)) declares to the Patent Office in writing that he is prepared to allow anyone to use the invention in return for reasonable compensation, the annual fees falling due after receipt of the declaration shall be reduced to one half. The effect of a declaration made in respect of a main patent shall extend to all its patents of addition. The declaration shall be recorded in the Register and published in the Patent Gazette."

- b) In subsection (2), the words "in the Register of Patents" shall be replaced by the words "in the Register".

- c) Subsection (3), second sentence, shall be worded as follows:

"Notification shall be deemed to have been effected if it has been dispatched by registered mail to the person recorded in the Register as patentee or to his registered representative or to the person authorized by him to receive service of documents (Section 25)."

- d) Subsection (4) shall be worded as follows:

"(4) The compensation shall be assessed by the Patent Division at the written request of a party. Sections 46, 47 and 62 shall apply *mutatis mutandis* to the proceedings. The request may be directed against more than one party. In assessing the compensation, the Patent Office may order that the costs of assessment proceedings be reimbursed in whole or in part by the opponent of the request."

- e) Subsection (5) shall be amended as follows:

aa) The second sentence shall be repealed.

bb) The words "the first to fourth sentences of" shall be deleted from the third sentence.

- f) Subsection (7), fourth sentence, shall be worded as follows:

"If the differential amount is not paid within the period provided for in the third sentence, it may be paid before expiry of a further period of four months along with a late surcharge."

9. Section 25 shall be worded as follows:

"Section 25

(1) A person who has neither domicile, seat nor establishment in the Federal Republic of Germany may take part in proceedings under this Law before the Patent Office or the Patent Court and assert rights deriving from a patent only if he has appointed as his representative a patent attorney or an attorney-at-law in the Federal Republic of Germany who is authorized to represent him in Patent Office and Patent Court proceedings and in civil litigation in respect of the patent as well as to file requests for the institution of criminal proceedings.

(2) Citizens of a Member State of the European Union or of another Contracting Party to the Agreement on the European Economic Area can be appointed as a representative within the meaning of subsection (1) for the purpose of provision of a service within the meaning of the Treaty establishing the European Community if they are entitled to practice their professional activity under one of the professional titles referred to in the Annex to Section 1 of the Law on Professional Practice by European Attorneys-at-Law in Germany of 9 March 2000 (Federal Law Gazette I p. 182) or to Section 1 of the Law on the Examination of Aptitude for Admission to Practice as a Patent Attorney of 6 July 1990 (Federal Law Gazette I p. 1349, 1351) in the respective version in force. In this case, proceedings may, however, only be pursued if an attorney-at-law or patent attorney has been appointed in the Federal Republic of Germany as the person authorized to receive service of documents.

(3) The place where the representative appointed pursuant to subsection (1) 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 in the Federal Republic of Germany shall be relevant and, in the absence thereof, the place where the Patent Office has its seat.

(4) The legal termination of the appointment of a representative under subsection (1) shall not become effective until the Patent Office or the Patent Court has been notified of both the termination of this appointment and the appointment of another representative."

10. In Section 27 (5), second sentence, the words "the President of the Patent Office" shall be replaced by the words "the German Patent and Trade Mark Office".

11. Section 28 shall be amended as follows:

- a) The subsection reference "(1)" shall be deleted.
- b) Subsection (2) shall be repealed.

12. Section 29 (3) shall be worded as follows:

"(3) The Federal Ministry for Justice may, in order to make the documentation of the Patent Office available to the public, prescribe by statutory order that the Office will provide information on the state of the art, without guarantee that the information is complete, without requiring the approval of the Federal Council. In this regard, it shall be authorized to determine the manner in which the information shall be given, the volume of information and the technical fields involved. The Federal Ministry for Justice may delegate such authority to the Patent and Trade Mark Office without requiring the approval of the Federal Council."

13. Section 30 shall be amended as follows:

- a) Subsection (1), first sentence, shall be worded as follows:

"The Patent Office shall maintain a Register in which shall be recorded the titles of patent applications, the files of which may be inspected by any person, and of granted patents and supplementary certificates of protection (Section 16a) as well as the names and addresses of applicants or of patentees and their representatives

and persons authorized to receive service of documents appointed pursuant to Section 25, if any, whereby an entry relating to a representative or person authorized to receive service of documents shall suffice."

b) ...

c) Subsection (3) shall be worded as follows:

"(3) The Patent Office shall record in the Register a change in the identity of the person, in the name or in the address of the applicant or the patentee or his representative or person authorized by him to receive service of documents, if proof thereof is furnished to it. Until such time as the change has been recorded, the former applicant, patentee, representative or person authorized to receive service shall continue to have the rights and obligations as provided under this Law."

d) ...

e) Subsection (5) shall be repealed.

14. ...

15. Section 32 shall be amended as follows:

a) The following sentence shall be added at the end of subsection (1):

"Publication may take electronic form."

b) ...

16. Section (34) shall be amended as follows:

a) Subsection (6) shall be repealed.

b) In subsection (7), second sentence, and subsection (9), second sentence, the words "the President of the Patent Office" shall be replaced by the words "the German Patent and Trade Mark Office" in each instance.

c) The previous subsections (7) to (9) shall become subsections (6) to (8).

17. In Section 39 (2), second sentence, the words "fee under Section 43" shall be replaced by the words "fee under the Patent Costs Law for a search pursuant to Section 43".

18. In Section 42 (1), second sentence, the words "(Section 34 (7))" shall be replaced by the words "(Section 34 (6))".

19. Section 43 shall be amended as follows:

a) In subsection (1), first sentence, the word "(search)" shall be inserted following the word "filed".

b) Subsection (2), fourth sentence, shall be repealed.

c) Subsection (4), third sentence, shall be worded as follows:

"The fee paid under Section 43 for the search as prescribed in the Patent Costs Law shall be refunded."

20. Section 44 shall be amended as follows:

- a) Subsection (3) shall be repealed.
- b) In subsection (4), second sentence, the words "Section 43 (2), second, third and fifth sentences" shall be replaced by the words "Section 43 (2), second to fourth sentences".
- c) The previous subsections (4) and (5) shall become subsections (3) and (4).

21. In Section 47 (2), the part of the sentence ", if any," shall be deleted.

22. Section 49a shall be amended as follows:

- a) Subsection (3), first sentence, shall be worded as follows:

"Section 34 (6) shall apply."

- b) Subsection (4) shall be repealed.

23. ...

24. Section 57 shall be repealed.

25. In Section 58 (3), the words "(Section 17)" shall be replaced by the words "(Section 7 (1) of the Patent Costs Law)".

26. The following sentence shall be added to the end of Section 62 (1):

"The Patent Division may order that the opposition fee as prescribed in the Patent Costs Law be refunded in whole or in part if and to the extent that this is equitable".

27. Section 63 shall be amended as follows:

- a) ...

- b) Subsection (4) shall be amended as follows:

aa) In the first sentence, the words "The Federal Minister for Justice" shall be replaced by the words "The Federal Ministry for Justice".

bb) In the second sentence, the word "He" shall be replaced by the word "It" and the words "the President of the Patent Office" shall be replaced by the words "the Patent and Trade Mark Office".

28. Section 64 (2), second sentence, shall be repealed.

29. In Section 67 (1) the words "in cases under Section 73 (3) and" shall be replaced by the words "in cases in which the application is rejected or in which a decision is made as to maintenance, revocation or limitation of a patent, and".

30. Section 73 shall be amended as follows:

- a) Subsection (3) shall be repealed.

- b) The previous subsections (4) and (5) shall become subsections (3) and (4).

- c) In the new subsection (3), second sentence, the words "under the Patent Costs Law" shall be inserted after the word "appeal fee".
 - d) In the new subsection (4), the words "subsection (4)" shall be replaced by the words "subsection (3)".
31. In Section 80 (3) the words "(Section 73 (3))" shall be replaced by the words "under the Patent Costs Law".
32. Section 81 shall be amended as follows:
- a) ...
 - b) Subsection (6) shall be repealed.
 - c) The previous subsection (7) shall become subsection (6).
33. Section 85 (2), first sentence, shall be repealed.
34. Section 98 shall be repealed.
35. Section 130 shall be amended as follows:
- a) The following second sentence shall be inserted into subsection (1):
 "On request by the applicant or the patentee, legal aid may also be granted for the annual fees pursuant to Section 17 (1)."
 - b) In subsection (4), the words "or the patentee" shall be inserted after the words "applicant for the patent".
 - c) Subsection (5) shall be worded as follows:
 "(5) On request, as many annual fees shall be included in the legal aid as are necessary to avoid a limitation opposing a grant of legal aid under Section 115 (3) of the Code of Civil Procedure. The installments paid shall be set off against the annual fees only when the costs of the patent granting procedure, including costs possibly arising for an appointed representative, are covered by the payment of the installments. To the extent that the annual fees shall be considered paid by the payment of the installments, Section 5 (2) of the Patent Costs Law shall apply *mutatis mutandis*."
36. In Section 143 (5), the words "up to the amount of a full fee" shall be deleted.
37. Section 147 shall be amended as follows:
- a) The previous wording shall become subsection (1).
 - b) The following subsections (2) and (3) shall be added after subsection (1):
 "(2) For deferment of patent annual fees or maintenance fees granted up to 31 December 2001 pursuant to the version of Section 18 applicable until this date, the provisions heretofore in force shall remain applicable.

(3) In derogation of Section 61 (1), first sentence, the Chamber of Appeal of the Patent Court shall decide on an opposition under section 59, if

1. the time limit for lodging an opposition commences after 1 January 2002 and the opposition has been lodged before 1 January 2005, or
2. the opposition has been lodged before 1 January 2002, a party requests this by 31 December 2004 and the Patent Division has not yet served a summons to an oral hearing or the decision on the opposition within a period of two months after receipt of the request for a decision by the Patent Court.

Sections 59 to 62, with the exception of Section 61 (1), first sentence, shall apply *mutatis mutandis* for opposition proceedings before the Chamber of Appeal of the Patent Court. The Chamber of Appeal shall decide in the composition of one technical member as presiding judge, two further technical members and one legal member. An appeal on a point of law from decisions of the Chambers of Appeal shall lie to the Federal Court of Justice pursuant to Section 100."

Article 8

Amendment of the Utility Model Law

(421-1)

The Utility Model Law in the version published on 28 August 1986 (Federal Law Gazette I p. 1455), last amended by Article 5 paragraph 21 of the Law of 26 November 2001 (Federal Law Gazette I p. 3138), shall be amended as follows:

1. Section 4 shall be amended as follows:
 - a) In subsection (4), second sentence, the words "the President of the Patent Office" shall be replaced by the words "the German Patent and Trade Mark Office".
 - b) Subsection (5) shall be repealed.
 - c) The previous subsections (6) to (8) shall become subsections (5) to (7).
 - d) In the new subsection (7), second sentence, the words "the President of the Patent Office" shall be replaced by the words "the German Patent and Trade Mark Office".
2. Section 7 shall be amended as follows:
 - a) In subsection (1), the word "(search)" shall be inserted at the end of the sentence after the words "or the utility model".
 - b) Subsection (2), fourth sentence, shall be repealed.
3. Section 8 shall be amended as follows:
 - a) ...
 - b) Subsection (2) shall be worded as follows:

"(2) The registration shall contain the name and address of the applicant as well as of any representative and any person authorized by him to receive service of documents appointed in accordance with Section 28, together with the date of filing of the application."

- c) The following second sentence shall be added at the end of subsection (3):

"Publication may take electronic form."

- d) Subsection (4) shall be worded as follows:

"(4) The Patent Office shall record in the Register a change in the identity of the proprietor of the utility model or of his representative or person authorized by him to receive service of documents, if proof thereof is furnished to it. Until such time as the change has been recorded, the former proprietor and his former representative or person authorized to receive service shall continue to have the rights and obligations as provided under this Law."

- e) ...

4. ...

5. In Section 10 (2), second sentence, the words "the President of the Patent Office" shall be replaced by the words "the German Patent and Trade Mark Office".

6. Section 16 shall be amended as follows:

- a) The third sentence shall be repealed.

- b) In the previous fourth sentence, the words "Section 81 (7)" shall be replaced by the words "Section 81 (6)".

7. Section 18 shall be amended as follows:

- a) Subsection (2) shall be repealed.

- b) The previous subsections (3) to (5) shall become subsections (2) to (4).

- c) In the new subsection (3), the following sentence shall be inserted after the second sentence:

"The second sentence shall apply *mutatis mutandis* to appeals from decisions on requests for the grant of legal aid."

8. Section 23 shall be worded as follows:

"Section 23

(1) The term of protection of a registered utility model shall commence on the day of application and shall end ten years after expiry of the month in which the day of application falls.

(2) Maintenance of protection shall be effected by means of payment of a maintenance fee for the fourth to sixth, seventh and eighth as well as for the ninth and

tenth years, calculated from the day of application. The maintenance shall be recorded in the Register.

(3) The utility model shall lapse if

1. the person registered as proprietor waives the utility model by means of written declaration to the Patent Office, or
 2. the maintenance fee is not paid in good time (Section 7 (1), Section 13 (3) or Section 14 (2) and (5) of the Patent Costs Law)."
9. In Section 27 (5), the words "up to the amount of a full fee" shall be deleted.
10. Section 28 shall be worded as follows:

"Section 28

(1) A person who has neither domicile, seat nor establishment in the Federal Republic of Germany may take part in proceedings under this Law before the Patent Office or the Patent Court and assert rights deriving from a utility model only if he has appointed as his representative a patent attorney or an attorney-at-law in the Federal Republic of Germany who is authorized to represent him in Patent Office and Patent Court proceedings and in civil litigation in respect of the utility model as well as to file requests for the institution of criminal proceedings.

(2) Citizens of a Member State of the European Union or of another Contracting Party to the Agreement on the European Economic Area can be appointed as a representative within the meaning of subsection (1) for the purpose of provision of a service within the meaning of the Treaty establishing the European Community if they are entitled to practice their professional activity under one of the professional titles referred to in the Annex to Section 1 of the Law on Professional Practice by European Attorneys-at-Law in Germany of 9 March 2000 (Federal Law Gazette I p. 182) or to Section 1 of the Law on the Examination of Aptitude for Admission to Practice as a Patent Attorney of 6 July 1990 (Federal Law Gazette I p. 1349, 1351) in the respective version in force. In this case, proceedings may, however, only be pursued if an attorney-at-law or patent attorney in the Federal Republic of Germany has been appointed as the person authorized to receive service of documents.

(3) The place where the representative appointed pursuant to subsection (1) 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 in the Federal Republic of Germany shall be relevant and, in the absence thereof, the place where the Patent Office has its seat.

(4) The legal termination of the appointment of a representative under subsection (1) shall not become effective until the Patent Office or the Patent Court has been notified of both the termination of this appointment and the appointment of another representative."

11. Section 29 shall be amended as follows:

a) The subsection reference "(1)" shall be deleted.

- b) Subsection (2) shall be repealed.

Article 9

Amendment of the Trade Mark Law

(423-5-2)

The Trade Mark Law of 25 October 1994 (Federal Law Gazette I p. 3082, 1995 I p. 156, 1996 I p. 682), last amended by Article 5 paragraph 22 of the Law of 26 November 2001 (Federal Law Gazette I p. 3138), shall be amended as follows:

1. The Table of Contents shall be amended as follows:
 - a) In Part 3 Chapter 4, the words "Section 64a Rules on Costs in Proceedings before the Patent Office" shall be inserted following the words "Section 64 Objection".
 - b) In Part 5 Chapter 3, the following words shall be inserted following the words "Section 125h Insolvency Proceedings":
"Section 125i Issue of an Order for Enforcement".
 - c) In Part 8 Chapter 1, the following words shall be inserted following the words "Section 143 Punishable Infringement of Signs":
"Section 143a Punishable Infringement of a Community Trade Mark".
2. Section 27 (4) shall be worded as follows:
"(4) Where the transfer of rights concerns only some of the goods or services for which the trade mark is registered, the provisions concerning the division of the registration shall apply *mutatis mutandis* with the exception of Section 46 (2) and (3), first and second sentences."
3. The following sentence shall be added at the end of Section 28 (2):
"If the successor in title takes over proceedings under the first or second sentences, the consent of the other parties to the proceedings is not required."
4. Section 32 (4) shall be repealed.
5. Section 36 shall be amended as follows:
 - a) Subsection (1), No. 3, shall be worded as follows:
"3. the appropriate amount has been paid in fees, and".
 - b) In subsection (2), first sentence, the words "not to have been filed" shall be replaced by the words "to have been withdrawn".
 - c) Subsection (3) shall be worded as follows:
"(3) If, within a time period set by the Patent Office, there is a failure to pay any arrears or the appropriate amount of arrears of the required class fees, or if the

applicant fails to indicate which goods or services are to be covered by the amount paid in fees, the leading class shall be taken into account first, followed by the other classes in the sequence of the subdivision of classes. Otherwise, the application shall be deemed to have been withdrawn."

6. Section 38 shall be amended as follows:

- a) The subsection reference "(1)" shall be deleted.
- b) Subsection (2) shall be repealed.
- c) The previous subsection 1 shall become the first sentence.

7. Section 40 (2) shall be amended as follows:

- a) The second sentence shall be repealed.
- b) In the previous third sentence, the words "under the Patent Costs Law for division proceedings" shall be inserted after the word "fee".

8. Section 42 (3) shall be repealed.

9. Section 46 (3) shall be amended as follows:

- a) The second sentence shall be repealed.
- b) In the previous third sentence, the words "under the Patent Costs Law for division proceedings" shall be inserted after the word "fee".

10. Section 47 shall be amended as follows:

- a) Subsection (1) shall be worded as follows:

"(1) The period of protection of a registered trade mark shall commence on the day of application (Section 33 (1)) and shall end ten years later on the last day of the month with the same name as that month in which the day of application falls."

- b) Subsection (3) shall be amended as follows:

aa) In the first sentence, the words "as prescribed by the schedule of fees" shall be deleted.

bb) The second to fourth sentences two shall be repealed.

- c) Subsection (4), second sentence, shall be worded as follows:

"If there is a failure to pay merely the required class fees, the period of protection shall, unless the first sentence applies, only be renewed for those classes which are covered by the payment of fees."

11. Section 54 shall be amended as follows:

- a) Subsection (2) shall be repealed.
- b) The previous subsection (3) shall become subsection (2).

12. In Section 61 (2), the words "fee, if any, to be paid" shall be replaced by the words "fee under the Patent Costs Law, if any, to be paid".

13. Section 63 (2) shall be worded as follows:

"(2) The Patent Office may order that the fee under the Patent Costs Law for accelerated examination, for opposition proceedings or for cancellation proceedings be wholly or partly refunded, if and to the extent that this is equitable."

14. Section 64 shall be amended as follows:

a) After subsection (4), the following new subsection (5) shall be inserted:

"(5) The Trade Mark Section or the Trade Mark Division may order that a fee under the Patent Costs Law for the objection be wholly or partly refunded."

b) The previous subsection (5) shall become subsection (6).

15. The following Section 64a shall be inserted following Section 64:

"Section 64a

Rules on Costs

in Proceedings before the Patent Office

In proceedings before the Patent Office, the Patent Costs Law shall apply in respect of the costs."

16. Section 65 shall be amended as follows:

a) Subsection (1) shall be amended as follows:

aa) In No. 12, the words "applications, oppositions or other requests" shall be replaced by the words "applications and oppositions".

bb) No. 13 shall be repealed. The former No. 14 shall become No. 13.

b) In subsection (2), the words "President of the Patent Office" shall be replaced by the words "German Patent and Trade Mark Office".

17. Section 66 shall be amended as follows:

a) In subsection (2), the words "in writing" shall be inserted after the words "Patent Office".

b) Subsection (3), sixth sentence, shall be worded as follows:

"The remaining periods of time under the first and second sentences shall be interrupted if the proceedings are suspended or if an extension of time has been granted to one of the parties on his request or as a result of peremptory provisions."

c) Subsection (5) shall be repealed.

d) The previous subsection (6) shall become subsection (5).

- e) In the new subsection (5) the words "under the Patent Costs Law" shall be inserted after the word "appeal fee" in the third sentence.
- 18. In Section 71 (3) the words "(Section 66 (5))" shall be replaced by the words "under the Patent Costs Law".
- 19. Section 82 (1), third sentence, shall be worded as follows:

"In proceedings before the Patent Court, the Patent Costs Law shall apply *mutatis mutandis* with respect to the fees; the Court Costs Law shall apply *mutatis mutandis* with respect to the expenses."
- 20. In Section 85 (5), fourth sentence, the words "up to the amount of a full fee" shall be deleted.
- 21. In Section 91 (1), second sentence, the words "(Section 6 (1), first sentence, of the Patent Costs Law)" shall be inserted after the words "opposition fee".
- 22. Section 96 shall be worded as follows:

"Section 96

Domestic Representative

(1) A person who has neither domicile, seat nor establishment in the Federal Republic of Germany may take part in proceedings under this Law before the Patent Office or the Patent Court and assert rights deriving from a trade mark only if he has appointed as his representative a patent attorney or an attorney-at-law in the Federal Republic of Germany who is authorized to represent him in Patent Office and Patent Court proceedings and in civil litigation in respect of this trade mark as well as to file requests for the institution of criminal proceedings.

(2) Citizens of a Member State of the European Union or of another Contracting Party to the Agreement on the European Economic Area can be appointed as a representative within the meaning of subsection (1) for the purpose of provision of a service within the meaning of the Treaty establishing the European Community if they are entitled to practice their professional activity under one of the professional titles referred to in the Annex to Section 1 of the Law on Professional Practice by European Attorneys-at-Law in Germany of 9 March 2000 (Federal Law Gazette I p. 182) or to Section 1 of the Law on the Examination of Aptitude for Admission to Practice as a Patent Attorney of 6 July 1990 (Federal Law Gazette I p. 1349, 1351) in the respective version in force. In this case, proceedings may, however, only be pursued if an attorney-at-law or patent attorney in the Federal Republic of Germany has been appointed as the person authorized to receive service of documents.

(3) The place where the representative appointed pursuant to subsection (1) 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 in the Federal Republic of Germany shall be relevant and, in the absence thereof, the place where the Patent Office has its seat.

(4) The legal termination of the appointment of a representative under subsection (1) shall not become effective until the Patent Office or the Patent Court has been notified of both the termination of this appointment and the appointment of another representative."

23. Section 109 shall be worded as follows:

"Section 109

Fees

If the application for international registration is filed prior to the registration of the mark in the Register, the national fee for the international registration procedure shall become due on the date of registration."

24. Section 111 shall be worded as follows:

"Section 111

Subsequent Territorial Extension

A request for subsequent territorial extension of the international registration of a mark may be filed under Article 3ter (2) of the Madrid Agreement with the Patent Office."

25. Section 121 shall be worded as follows:

"Section 121

Fees

If the international registration is to be effected under the Madrid Agreement and according to the Protocol Relating to the Madrid Agreement on the basis of a registered mark, and if the application for international registration was filed prior to the registration of the mark, the national fee under the Patent Costs Law for international registration shall become due on the date of registration."

26. Section 123 shall be amended as follows:

a) Subsection (1), first sentence, shall be worded as follows:

"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 may be filed with the Patent Office."

b) Subsection (2) shall be worded as follows:

"(2) Subsequent territorial extension on the basis of a registered mark may be effected under the Madrid Agreement as well as according to the Protocol Relating to the Madrid Agreement."

c) Subsection (3) shall be repealed.

27. Section 125 shall be amended as follows:

a) Subsection (2) shall be repealed.

b) The previous subsections (3) to (5) shall become subsections (2) to (4).

28. Section 125d (1) shall be worded as follows:

"(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 fee and the class fees as specified in the Patent Costs Law for the conversion procedure shall become due on receipt of the request for conversion by the Patent Office."

29. The following Section 125i shall be inserted following Section 125h:

"Section 125i

Issue of an Order for Enforcement

Competence for issuing an order for enforcement pursuant to Article 82 (2), second sentence, of the Community Trade Mark Regulation lies with the Patent Office. The enforceable copy shall be issued by the registrar of the Patent Court."

30. Section 130 shall be amended as follows:

- a) Subsection (2) shall be repealed.
- b) The previous subsections (3) to (5) shall become subsections (2) to (4).

31. Section 132 shall be amended as follows:

- a) In subsection (1), the words "within four months after publication in the Official Journal of the European Communities pursuant to Article 6 (2) of Regulation (EEC) No. 2081/92" shall be inserted after the words "with the Patent Office".
- b) Subsection (2) shall be worded as follows:

"(2) Reinstatement in respect of the time limit for filing an objection shall not be permissible."

32. In Section 138 (2), the words "the President of the Patent Office" shall be replaced by the words "the German Patent and Trade Mark Office".

33. In Section 140 (5), the words "up to the amount of a full fee" shall be deleted.

34. Section 143 shall be amended as follows:

- a) Subsection (1a) shall be repealed.
- b) In subsection (4), the words "referred to in subsections (1) and (1a)" shall be replaced by the words "referred to in subsection (1)".
- c) Subsection (7) shall be repealed.

35. The following Section 143a shall be inserted following Section 143:

"Section 143

Punishable

Infringement of a Community Trade Mark

(1) Any person who infringes the rights of the proprietor of a Community trade mark as laid down in Article 9 (1), second sentence, of Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 No. L 11 p. 1) by, in the course of trade and in spite of a prohibition and without the consent of the trade mark proprietor,

1. using a sign identical with the Community trade mark for goods or services which are identical with those for which it is registered,
2. using a sign if, because of its identity with, or similarity to, the Community trade mark, and the identity or similarity of the goods or services covered by the Community trade mark and the sign, there exists a likelihood of confusion on the part of the public, including the likelihood of association of the sign with the trade mark; or
3. using a sign identical with or similar to the Community trade mark for goods or services which are not similar to those for which the Community trade mark is registered, where the this trade mark has a reputation in the Community and where the sign is used with intent, without due cause, to take unfair advantage of, or have detrimental effect on, the distinctive character or the repute of such Community trade mark,

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

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

36. In Section 145 (3), the words "DEM 5,000" shall be replaced by the words "EUR 2,500" and the words "DEM 20,000" shall be replaced by the words "EUR 10,000".

37. The following subsections (4) to (7) shall be added to Section 165:

"(4) In derogation of Section 64 (1), first sentence, and subsection (5), first sentence, an appeal can also be filed instead of an objection during the period from 1 January 2002 to 31 December 2004.

(5) In derogation of Section 66 (1), first and second sentences, and subsection (3), the following shall apply for the period from 1 January 2002 until 31 December 2004:

1. Parties to proceedings before the Patent Office shall be entitled to file an appeal from the decisions of the Trade Mark Sections and Trade Mark Divisions.
2. If one party has filed an objection and another party has filed an appeal from a decision of the Trade Mark Sections or Trade Mark Divisions in respect of which it is also possible to file an objection, the party who has filed the objection may also file an appeal. If the appeal of the party who has filed the objection fails to file his appeal within a time-period of one month after service of the appeal of the other party

pursuant to Section 66 (4), second sentence, his objection shall be deemed to have been withdrawn. No further appeal fee shall be payable for the appeal of the party who has filed the objection.

(6) Sections 64 and 66 in the version in force until 1 January 2002 shall be applicable to objections and appeals filed before 1 January 2002. For proceedings involving several parties which become pending up to 31 December 2004, the applicability of subsections (4) and (5) shall be determined according to the date the appeal is filed.

(7) Section 96 in the version in force until 1 January 2002 shall be applicable to proceedings as referred to in Section 96 which became pending before 1 January 2002."

Articles 10 to 13 ...

Article 14

Amendment of the Semiconductor Protection Law

(426-1)

The Semiconductor Protection Law of 22 October 1987 (Federal Law Gazette I p. 2294), last amended by Article 5 paragraph 23 of the Law of 26 November 2001 (Federal Law Gazette I p. 3138), shall be amended as follows:

1. The abbreviation " – HalblSchg" shall be inserted in the title following the words "Semiconductor Protection Law".
2. Section 3 shall be amended as follows:
 - a) In subsection (3), second sentence, the words "the President of the Patent Office" shall be replaced by the words "the German Patent and Trade Mark Office".
 - b) Subsection (5) shall be worded as follows:

"(5) If the defects mentioned in subsection (4) have not been remedied within the time limit mentioned in subsection (4), the application shall be deemed to have been withdrawn."
3. ...
4. Section 8 (4) shall be amended as follows:
 - a) The third sentence shall be repealed.
 - b) In the fourth sentence, the words "Section 81 (7)" shall be replaced by the words "Section 81 (6)".

Article 15**Amendment of the Law Against Unfair Competition**

(43-1)

In Section 6 (2), second sentence, of the Law Against Unfair Competition in the revised version published in the Federal Law Gazette Part III, No. 43-1, last amended by Article 5 paragraph 24 of the Law of 26 November 2001 (Federal Law Gazette I p. 3138), the words "DEM 10,000" shall be replaced by the words "EUR 5,000".

Article 16**Amendment of the Copyright Law**

(440-1)

The Copyright Law of 9 September 1965 (Federal Law Gazette I p. 1273), last amended by Article 5 paragraph 25 of the Law of 26 November 2001 (Federal Law Gazette I p. 3138), shall be amended as follows:

1. In Section 26 (1), second sentence, the words "DEM 100" shall be replaced by the words "EUR 500".
2. In Section 66 (2), second sentence, the words "Register of Authors" shall be replaced by the words "Register of Anonymous and Pseudonymous Works".
3. Section 138 shall be amended as follows:
 - a) The heading shall be replaced by "Register of Anonymous and Pseudonymous Works".
 - b) In subsection (1), first sentence, the words "Register of Authors" shall be replaced by the words "Register of Anonymous and Pseudonymous Works".
 - c) Subsection (4) shall be worded as follows:

"(4) Any person may inspect the Register. Extracts from the Register shall be issued on request."
 - d) Subsection (5) shall be amended as follows:
 - aa) In No. 1, the words "the Register of Authors" shall be replaced by the words "the Register".
 - bb) No. 2, second sentence, shall be repealed.

4. The Annex to Section 54d shall be amended as follows:

"Annex

(to Section 54d (1))

Rates of Remuneration

I. Remuneration under Article 54 (1)		
The remuneration due to all owners of rights shall be		
1.	for each audio recording appliance	EUR 1.28
2.	for each audio recording appliance for whose operation separate mediums (item 5) are not required	EUR 2.56
3.	for each video recording appliance with or without audio recording	EUR 9.21
4.	for each video recording appliance for whose operation separate mediums (item 6) are not required	EUR 18.42
5.	in respect of audio recording mediums, for each hour of playing time in normal utilization	EUR 0.0614
6.	in respect of video recording mediums, for each hour of playing time in normal utilization	EUR 0.0870
II. Remuneration under Article 54a		
1.	Remuneration due to all owners of rights under Article 54a (1) shall be, for each reproduction appliance with a capacity of	
	a) up to 12 copies a minute	EUR 38.35
	if polychrome photocopies can be made	EUR 76.70
	b) from 13 to 35 copies a minute	EUR 51.13
	if polychrome photocopies can be made	EUR 102.26
	c) from 36 to 70 copies a minute	EUR 76.70
	if polychrome photocopies can be made	EUR 153.40
	d) more than 70 copies a minute	EUR 306.78
	if polychrome photocopies can be made	EUR 613.56
2.	Remuneration due to all owners of rights under Article 54a (2) shall be, for each DIN A4 page of photocopying	
	a) for photocopies made from books intended exclusively for school use and approved by a Land authority as school books	
	monochrome	EUR 0.0256
	polychrome	EUR 0.0512
	b) for all other photocopies	
	monochrome	EUR 0.0103
	polychrome	EUR 0.0206
3.	These rates of remuneration shall be applied <i>mutatis mutandis</i> to other reproduction processes having a comparable effect."	

Article 17**Amendment of the Copyright Administration Law**

(440-12)

In Section 21 of the Copyright Administration Law of 9 September 1965 (Federal Law Gazette I p. 1294), last amended by Article 5 paragraph 25a of the Law of 26 November 2001 (Federal Law Gazette I p. 3138), the words "DEM 10,000" shall be replaced by the words "EUR 5,000".

Article 18**Amendment of the Designs Law**

(442-1)

The Designs Law in the revised version published in the Federal Law Gazette Part III, No. 442-1, last amended by Article 5 paragraph 27 of the Law of 26 November 2001 (Federal Law Gazette I p. 3138), shall be amended as follows:

1. Section 7 shall be amended as follows:
 - a) In subsection (6), the second sentence shall be repealed.
 - b) In subsection (10), third sentence, the words "in accordance with the schedule of fees" shall be deleted.
2. Section 8 (2) shall be amended as follows:
 - a) In the first sentence, the word "extension" shall be replaced by the word "maintenance".
 - b) The following sentence shall be added after the first sentence:

"Publication may take electronic form."
3. Section 8b shall be amended as follows:
 - a) Subsection (2) shall be worded as follows:

"(2) The term of protection shall lapse unless the owner of the design pays the extension fee within the period of deferment."
 - b) In subsection (3), third sentence, the words "third and fourth sentences" shall be replaced by the words "fourth and fifth sentences".
4. Section 8c shall be repealed.
5. Section 9 shall be worded as follows:

"Section 9

(1) The term of protection of a registered design shall commence on the day of application and shall end twenty years after expiry of the month in which the day of application falls.

(2) Maintenance of protection shall be effected by means of payment of a maintenance fee for the sixth to tenth, eleventh to fifteenth as well as for the sixteenth to twentieth years, calculated from the day of application.

(3) If, in the case of a multiple application (Section 7 (9)), the maintenance fee is paid only in respect of some of the designs without specification, the designs shall be taken into account according to the sequence of application. If variations of a basic design have been registered (Section 8a (1)), the basic designs shall be taken into account first."

6. Section 10 shall be amended as follows:

- a) In subsection (3), first sentence, the words "Section 12 (1)" shall be replaced by the words "Section 12".
- b) The previous subsections (4) and (5) shall be replaced by the following subsections (4) to (6):

"(4) If, within a time period set by the Patent Office, there is a failure to pay the appropriate amount of arrears of application fees, or if the applicant fails to indicate which designs are to be covered by the amount paid in fees, the Patent Office shall determine which designs shall be taken into account. Otherwise, the application shall be deemed to have been withdrawn.

(5) Where the defects referred to in subsection (3) are not remedied within the time limit specified in subsection (3), first sentence, the application shall be deemed to have been withdrawn.

(6) Section 123 (1) to (5) and (7) as well as Sections 124 and 126 to 128 of the Patent Law shall apply *mutatis mutandis*."

7. Section 10a (1) shall be amended as follows:

- a) The third sentence shall be repealed.
- b) In the previous fourth sentence, the words "73 (2), (4) and (5)" shall be replaced by the words "73 (2) to (4)".

8. Section 10b shall be amended as follows:

- a) The following second sentence shall be inserted after the first sentence:

"On request by the registered owner, legal aid may also be granted for the maintenance fees pursuant to Section 9 (2)."

- b) In the previous third sentence, the words "130 (2), (3) and (6)" shall be replaced by "130 (2), (3) and (5)".

9. Section 10c (1), No. 1, shall be amended as follows:

"1. on expiry of the term of protection or if the maintenance fee is not paid in good time (Section 7 (1), Section 13 (3) or Section 14 (3) and (5) of the Patent Costs Law),".

10. Section 12 shall be worded as follows:

"Section 12

The Federal Ministry for Justice shall regulate the establishment and the business procedure of the German Patent and Trade Mark Office as the designs registration authority and shall, insofar as provision therefor has not been made by law, determine by statutory order, without requiring the approval of the Federal Council, the form and other requirements for applications for designs, the form and other requirements for the representation of the design, the admissible dimensions of the product used to represent the surface design or the product itself, the content and scope of any description accompanying the representation, the classification of goods, the keeping and form of the Designs Register, the particulars to be entered in the Designs Register and the details of publication, including production by the Patent Office of the representation of the design in the cases covered by Section 7 (4) to (6) and the treatment of products accompanying an application for its representation following cancellation of the entry in the Designs Register (Section 10c). It may delegate these powers to the German Patent and Trade Mark Office by statutory order."

11. In Section 12a (2), the words "the President of the Patent Office" shall be replaced by the words "the German Patent and Trade Mark Office".

12. Section 13 shall be worded as follows:

"Section 13

(1) The person who has filed the design for registration in the Designs Register in accordance with Section 7 shall be deemed to be its author until proved otherwise.

(2) Changes in the name or in the address of the applicant, owner or representative should be communicated to the Patent Office without delay. The Patent Office shall record the change in the Designs Register.

(3) The request for registration of a change in the identity of the person of the applicant or owner shall be accompanied by written proof thereof."

13. In Section 15 (5), the words "up to the amount of a full fee" shall be deleted.

14. Section 16 shall be worded as follows:

"Section 16

(1) A person who has neither domicile, seat nor establishment in the Federal Republic of Germany may take part in proceedings under this Law before the Patent Office or the Patent Court and assert rights deriving from a design protected according to the provisions of this Law only if he has appointed as his representative a patent attorney or an attorney-at-law in the Federal Republic of Germany who is authorized to

represent him in Patent Office and Patent Court proceedings and in civil litigation in respect of the design as well as to file requests for the institution of criminal proceedings.

(2) Citizens of a Member State of the European Union or of another Contracting Party to the Agreement on the European Economic Area can be appointed as a representative within the meaning of subsection (1) for the purpose of provision of a service within the meaning of the Treaty establishing the European Community if they are entitled to practice their professional activity under one of the professional titles referred to in the Annex to Section 1 of the Law on Professional Practice by European Attorneys-at-Law in Germany of 9 March 2000 (Federal Law Gazette I p. 182) or to Section 1 of the Law on the Examination of Aptitude for Admission to Practice as a Patent Attorney of 6 July 1990 (Federal Law Gazette I p. 1349, 1351) in the respective version in force. In this case, proceedings may, however, only be pursued if an attorney-at-law or patent attorney in the Federal Republic of Germany has been appointed as the person authorized to receive service of documents.

(3) The place where the representative appointed pursuant to subsection (1) 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 in the Federal Republic of Germany shall be relevant and, in the absence thereof, the place where the Patent Office has its seat.

(4) The legal termination of the appointment of a representative under subsection (1) shall not become effective until the Patent Office or the Patent Court has been notified of both the termination of this appointment and the appointment of another representative."

Article 19

Amendment of the Type Face Law

(442-4)

Article 2 of the Type Face Law of 6 July 1981 (Federal Law Gazette 1981 II p. 382), last amended by Article 3 of the Law of 18 December 1986 (Federal Law Gazette I p. 2501), shall be amended as follows:

1. Subsection (1) shall be amended as follows:

a) No. 4 shall be worded as follows:

"4. The term of protection for registered type faces shall commence on the day of application and shall end twenty five years after expiry of the month in which the day of application falls. Maintenance of protection shall be effected by means of payment of a maintenance fee for the eleventh to fifteenth, sixteenth to twentieth and twenty first to twenty fifth years respectively, calculated from the day of application."

b) In No. 5, first and second sentences, the words "Patent Office" shall be replaced by the words "Patent and Trade Mark Office" in each instance.

2. In subsection (2), second sentence, the words "the President of the Patent Office" shall be replaced by the words "the German Patent and Trade Mark Office".

Article 20

Amendment of the Plant Variety Protection Law

(7822-7)

The Plant Variety Protection Law in the version published on 19 December 1997 (Federal Law Gazette I p. 3164), last amended by Article 5 paragraph 33 of the Law of 26 November 2001 (Federal Law Gazette I p. 3138), shall be amended as follows:

1. In Section 34 (2), the words "a fee shall be payable in accordance with the Law on the Fees of the Patent Office and the Patent Court" shall be replaced by the words "an appeal fee shall be payable in accordance with the Patent Costs Law".
2. In Section 38 (4), the words "up to the amount of a full fee" shall be deleted.
3. In Section 40a (1), first sentence, the words "or pursuant to Council Regulation (EC) No. 2100/94 of 27 July 1994 on Community plant variety rights (OJ No. L 227 p. 1)" shall be inserted after the word "within the country".

Article 21

Further Amendments of the Patent Costs Law, the Patent Law, the Utility Model Law, the Trade Mark Law, the Semiconductor Protection Law and the Designs Law

...
(2) The following Section 123a shall be inserted following Section 123 of the Patent Law in the version published on 16 December 1980 (Federal Law Gazette 1981 I p. 1), last amended by Article 7 of this Law:

"Section 123a

(1) If, upon failure to observe a time limit determined by the Patent Office, the patent application is refused, this decision shall be ineffective without requiring express reversal if the applicant requests that the application continue to be processed and makes good the action in default.

(2) The request shall be filed within a time limit of one month following service of the decision on refusal of the patent application. The action in default shall be made good within this time limit.

(3) Reinstatement in respect of failure to observe the time limit specified in subsection (2) shall not be permissible.

(4) A decision on the request shall be taken by the authority that is required to decide on the action to be made good."

(3) In Section 21 (1) of the Utility Model Law in the version published on 28 August 1986 (Federal Law Gazette I p. 1455), last amended by Article 8 of this Law, the words "further processing of the application (Section 123a)," shall be inserted after the words "(Section 123),".

(4) The Trade Mark Law of 25 October 1994 (Federal Law Gazette I p. 3082, 1995 I p. 156, 1996 I p. 682), last amended by Article 9 of this Law, shall be amended as follows:

1. In Part 3 Chapter 7 of the Table of Contents, the words "Section 91a Further Processing of the Application" shall be inserted following the words "Section 91 Reinstatement".
2. The following Section 91a shall be inserted following Section 91:

"Section 91a

Further Processing of the Application

(1) If, upon failure to observe a time limit determined by the Patent Office, the trade mark application is refused, this decision shall be ineffective without requiring express reversal if the applicant requests that the application continue to be processed and makes good the action in default.

(2) The request shall be filed within a time limit of one month following service of the decision on refusal of the trade mark application. The action in default shall be made good within this time limit.

(3) Reinstatement in respect of failure to observe the time limit specified in subsection (2) shall not be permissible.

(4) A decision on the request shall be taken by the authority that is required to decide on the action to be made good."

(5) In Section 11 (1) of the Semiconductor Protection Law of 22 October 1987 (Federal Law Gazette I p. 2294), last amended by Article 14 of this Law, the words "further processing of the application (Section 123a)," shall be inserted after the words "(Section 123),".

(6) In Section 10 (6) of the Designs Law in the revised version published in the Federal Law Gazette Part III, No. 442-1, last amended by Article 18 of this Law, the words "Sections 124" shall be replaced by the words "Sections 123a, 124".

Articles 22 to 29 ...

Article 30

Entry into Force

(1) Except as provided in subsections (2) and (3), this Law shall enter into force on 1 January 2002.

(2) On the day following promulgation,

1. Article 3, No. 5 (c) and No. 6,
2. Article 5,
3. Article 9, Nos. 29, 34 and 35,
4. Article 10, No. 6, and
5. Provisions contained in Articles 1 to 20 of this Law which authorise the issuance of statutory orders

shall enter into force.

(3) Article 21 shall enter into force on 1 January 2005.

The constitutional rights of the Federal Council have been heeded.

The above Law is hereby executed and shall be promulgated in the Federal Law Gazette.

Berlin, 13 December 2001

The Federal President
Johannes Rau

The Federal Chancellor
Gerhard Schroeder

The Federal Minister of Justice
Daeubler-Gmelin