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Act on the Protection of Trade Marks and other Symbols

Trade Mark Act

Full citation: Act on the Protection of Trade Marks and other Symbols of 25 October 1994 (Federal Law Gazette [BGBl.] Part I p. 3082, as last amended by Art. 3 of the Act of 19 October 2013, Federal Law Gazette (Bundesgesetzblatt) Part I p. 3830
Sections 119 to 125 entered into force with effect from 20 March 1996 in accordance with the announcement of 24 April 1996, Federal Law Gazette Part I p. 682.
The Act was adopted by the Federal Parliament with the approval of the Federal Council as Article 1 of the Act (423-5-1) of 25 November 1994, Federal Law Gazette Part I p. 3082. It entered into force with effect from 1 January 1995 in accordance with Art. 50 para. 3 of this Act pursuant to paras. 1 and 2.

Part 1 Scope

Section 1

Protected trade marks and other symbols

The following shall be protected in accordance with this Act:

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

Section 2

Application of other provisions

The protection of trade marks, commercial designations and indications of geographical origin in accordance with this Act shall not exclude the application of other provisions on the protection of such symbols.

Part 2

Preconditions, scope and restrictions of the protection of trade marks and commercial designations, transfer and licence

Chapter 1

Trademarks and commercial designations, priority and seniority

Section 3

Signs eligible for protection as trade marks

(1) All signs, particularly words including personal names, designs, letters, numerals, sound marks, three-dimensional designs, the shape of goods or of their packaging, as well as other wrapping, including colours and colour combinations, may be protected as trade marks if they are capable of distinguishing the goods or services of one enterprise from those of other enterprises.

(2) Signs consisting 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 amenable to protection as a trade mark.

Section 4 Accrual of trade mark protection

The following shall give rise to trade mark protection

1. the entry of a sign as a trade mark in the register kept by the Patent Office,
2. the use of a sign in the course of trade insofar as the sign has acquired public recognition as a trade mark within affected trade circles, or
3. a trade mark constituting a well-known mark within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property (Paris Convention).

Section 5 Commercial designations

(1) Company symbols and titles of works shall enjoy protection as commercial designations.

(2) Company symbols are signs used in the course of trade as a name, company name or special designation of a business operation or an enterprise. Business symbols and other signs intended to distinguish the business operation from other business operations which are regarded as symbols of the business operation within involved trade circles shall be deemed equivalent to the special designation of a business operation.

(3) Titles of works are the names or special designations of printed publications, cinematic works, music works, stage works or other comparable works.

Section 6 Priority and seniority

(1) If, in the case of a concurrence of rights within the meaning of sections 4, 5 and 13, their seniority is material in accordance with this Act for the determination of the priority of the rights, seniority shall be determined in accordance with subs. 2 and 3.

(2) The date of application (section 33 subs. 1) or, if priority is claimed in accordance with section 34 or in accordance with section 35, the priority date shall be relevant for the determination of the seniority of trade marks that have been filed or registered.

(3) The point in time when the right was acquired shall be material for the determination of the seniority of rights within the meaning of section 4 Nos. 2 and 3 and sections 5 and 13.

(4) If rights in accordance with subs. 2 and 3 have the same date as their seniority, the rights shall have equal ranking, and shall not give rise to any rights against one another.

Chapter 2 Prerequisites for the protection of trade marks by means of registration

Section 7 Proprietorship

Proprietors of trade marks that have been filed or registered may be the following:

1. natural persons,

2. legal persons, or
3. partnerships insofar as they are equipped with the capacity to acquire rights and enter into liabilities.

Section 8 **Absolute obstacles to protection**

(1) Signs eligible for protection as a trade mark within the meaning of section 3 which cannot be depicted graphically shall be excluded from registration.

(2) The following trade marks shall be excluded from registration

1. those which are devoid of any distinctive character for the goods or services,
2. which consist exclusively of signs or indications which may serve, in the course of trade, to designate the nature, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the services or to designate other characteristics of the goods or services,
3. which consist exclusively of signs or indications which have become customary in the current usage or in the bona fide and established practices of the trade to designate the goods or services,
4. which are of such a nature to mislead the public, in particular with regard to the nature, the quality or the geographical origin of the goods or services,
5. which are contrary to public policy or to accepted principles of morality,
6. which contain state coats of arms, state flags or other sovereign state symbols or coats of arms of a domestic locality or of a domestic municipal or other local authority association,
7. which contain official certification marks or hallmarks which are excluded from registration as a trade mark in accordance with a notice made by the Federal Ministry of Justice in the Federal Law Gazette (BGBl.),
8. which contain coats of arms, flags or other symbols, seals or designations of international intergovernmental organisations which are excluded from registration as a trade mark in accordance with a notice made by the Federal Ministry of Justice in the Federal Law Gazette,
9. the use of which can evidently be prohibited in the public interest in accordance with other provisions, or
10. which have been applied for in bad faith.

(3) Subs. 2 Nos. 1, 2 and 3 shall not apply if, prior to the point in time of the decision on registration, the trade mark has become established in the trade circles involved as a result of its use for the goods or services for which the application was filed.

(4) Subs. 2 Nos. 6, 7 and 8 shall also be applied if the trade mark contains the imitation of a sign listed there. Subs. 2 Nos. 6, 7 and 8 shall not be applied if the applicant is empowered to include in the trade mark one of the signs listed therein, even if it can be confused with one of the other signs listed therein. Subs. 2 No. 7 shall furthermore not be applied if the goods or services for which the trade mark application was filed are neither identical with nor similar to those for which the certification mark or hallmark has been introduced. Subs. 2 No. 8 shall further not be applied if the trade mark applied for is not suitable to create among the public the incorrect impression of a connection with the international intergovernmental organisation.

Section 9 **Trade marks that have been filed or registered as relative obstacles to protection**

(1) The registration of a trade mark may be cancelled

1. if it is identical to a trade mark applied for or registered which has older seniority and the goods or services for which it was registered are identical with the goods or services for which the trade mark with older seniority was filed or registered,
2. if the likelihood of confusion exists, including the likelihood of association between the trade marks, for the public because of its identity with or similarity to a trade mark applied for or registered with older seniority and owing to the identity or similarity of the goods or services covered by both trade marks, or
3. if it is identical with or similar to a trade mark applied for or registered with older seniority and has been registered for goods or services which are not similar to those for which the trade mark with older seniority has been filed or registered, if the trade mark with older seniority is a trade mark which has a reputation in this country and the use of the registered trade mark would without due cause take unfair advantage of, or be detrimental to, the distinctive character or the repute of the trade mark which has a reputation.

(2) Applications for trade marks shall only constitute an ground for refusal within the meaning of subs. 1 if they are registered.

Section 10 Well-known marks

(1) A trade mark shall be excluded from registration if it is identical with or similar to a trade mark with older seniority that is well known in this country within the meaning of Article 6bis of the Paris Convention and if the further prerequisites of section 9 subs. 1 Nos. 1, 2 or 3 are met.

(2) Subs. 1 shall not apply if the applicant has been empowered to file an application by the proprietor of the well-known mark.

Section 11 Unauthorised filing of the proprietor's trade mark

The registration of a trade mark may be cancelled if the trade mark was registered without the consent of the trade mark proprietor for his/her agent or representative.

Section 12 Trade marks and commercial designations with older seniority acquired by virtue of use

The registration of a trade mark may be cancelled if another person has acquired rights to a trade mark prior to the date that is material for the seniority of the registered trade mark within the meaning of section 4 No. 2 or to a commercial designation within the meaning of section 5 and these entitle him/her to prohibit the use of the registered trade mark in the entire territory of the Federal Republic of Germany.

Section 13 Other earlier rights

(1) The registration of a trade mark may be cancelled if another person has acquired another right not listed in sections 9 to 12 prior to the date material to the seniority of the registered trade mark, and this entitles him/her to prohibit the use of the registered trade mark in the entire territory of the Federal Republic of Germany.

(2) The other rights within the meaning of subs. 1 shall include in particular:

1. rights to names,
2. the right of personal portrayal,
3. copyright,

4. names of plant varieties
5. indications of geographical origin,
6. other industrial property rights.

Chapter 3 **Scope of protection, infringements of rights**

Section 14

Exclusive right of the proprietor of a trade mark, right to an injunction, compensation claim

- (1) The acquisition of trade mark protection in accordance with section 4 shall grant to the proprietor of the trade mark an exclusive right.
- (2) A third party shall be prohibited, without the consent of the proprietor of the trade mark in the course of trade, from
1. using a sign which is identical to the trade mark for goods or services which are identical to those for which it enjoys protection,
 2. using a sign if the likelihood of confusion exists for the public because of the identity or similarity of the sign to the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, including the likelihood of association with the trade mark, or
 3. using a sign identical with or similar to the trade mark for goods or services which are not similar to those for which the trade mark enjoys protection if the trade mark is a trade mark which has a reputation in this country and the use of the sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark which has a reputation.
- (3) If the prerequisites of subs. 2 are met, it shall in particular be prohibited
1. to affix the sign to goods or their wrappings or packaging,
 2. to offer goods under the sign, to put them on the market, or to stock them for the above purposes,
 3. to offer or provide services under the sign,
 4. to import or export goods under the sign,
 5. to use the sign in business papers or in advertising.
- (4) Third parties shall be furthermore prohibited without the authorisation of the proprietor of the trade mark in the course of trade
1. to affix a sign that is identical to the trade mark or a similar sign on wrappings or packaging or on means of identification such as labels, tags, badges or the like,
 2. to offer, put on the market or stock for the listed purposes wrappings, packaging or means of identification which bear a sign that is identical to the trade mark or to a similar sign, or
 3. to import or export wrappings, packaging or means of identification which bear a sign that is identical to the trade mark or to a similar sign
- if the danger exists that the wrappings or packaging are used to wrap or package, or that the means of identification are used to identify goods or services with regard to which third parties would be prohibited from using the sign in accordance with subs. 2 and 3.

(5) Anyone using a sign in contravention of subs. 2 to 4 may be required by the proprietor of the trade mark to refrain therefrom if there is a danger of recurrence. The right shall also exist if there is a risk of a contravention occurring for the first time.

(6) Anyone committing the act of infringement intentionally or negligently shall be liable to the proprietor of the trade mark to compensate for the damage incurred by the act of infringement. The profit which the infringer has made through the infringement of the right may also be taken into account when assessing the compensation. The compensation claim may also be calculated on the basis of the amount which the infringer should have paid as a suitable remuneration if he/she had obtained authorisation to use the trade mark.

(7) If the act of infringement is committed in a business operation by an employee or agent, the right to an injunction and, insofar as the employee or agent acted intentionally or negligently, the compensation claim, may also be asserted against the proprietor of the operation.

Section 15

Exclusive right of the proprietor of a commercial designation, right to an injunction, compensation claim

(1) The acquisition of the protection of a commercial designation shall grant to its proprietor an exclusive right.

(2) Third parties shall be prohibited from using the commercial designation or a similar sign in the course of trade without authorisation in a manner liable to cause confusion with the protected designation.

(3) If the commercial designation is a commercial designation which has a reputation in this country, third parties shall be furthermore prohibited from using the commercial designation or a similar sign in the course of trade if there is no likelihood of confusion within the meaning of subs. 2, insofar as the use of the sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the commercial designation.

(4) Anyone who uses a commercial designation or a similar sign in contravention of subs. 2 or subs. 3 may be required to refrain therefrom by the proprietor of the commercial designation if there is a danger of recurrence. The right shall also exist if a contravention is threatened.

(5) Anyone intentionally or negligently committing the act of infringement shall be liable to the proprietor of the commercial designation for compensation for the damage incurred thereby. Section 14 subs. 6 sentences 2 and 3 shall apply mutatis mutandis.

(6) Section 14 subs. 7 shall be applied mutatis mutandis.

Section 16

Representation of a registered trade mark in works of reference

(1) If the representation of a registered trade mark in a dictionary, encyclopaedia or similar reference work gives the impression that the trade mark constitutes the generic name of the goods or services for which the trade mark is registered, the proprietor of the trade mark may require from the publisher of the work that the representation of the trade mark be accompanied by an indication that it is a registered trade mark.

(2) If the work has already been published, the right shall be restricted to the indication in accordance with subs. 1 being included in a new edition of the work.

(3) Subs. 1 and 2 shall be applied mutatis mutandis if the work of reference is sold in the shape of an electronic database or if access is provided to an electronic database containing a work of reference.

Section 17

Rights against agents or representatives

(1) If a trade mark has been filed or registered in contravention of section 11 for the agent or representative of the proprietor of the trade mark without his/her consent, the proprietor of the trade mark shall be entitled to demand from the agent or representative the transfer of the right given rise to by the application for or registration of the trade mark.

(2) If a trade mark has been registered in contravention of section 11 for an agent or representative of the proprietor of the trade mark, the proprietor may prohibit the use of the trade mark within the meaning of section 14 by the agent or representative if he/she has not consented to its use. If the agent or representative acts intentionally or negligently, he/she shall be obliged to compensate the proprietor of the trade mark for the damage incurred by the act of infringement. Section 14 subs. 7 shall be applied mutatis mutandis.

Section 18 Destruction and re-call rights

(1) The proprietor of a trade mark or of a commercial designation may claim against the infringer in cases falling under sections 14, 15 and 17 requiring the destruction of the goods owned or held by the infringer that are unlawfully identified. Sentence 1 shall apply mutatis mutandis to the supplies and equipment held by the infringer which have primarily served to unlawfully identify the goods.

(2) The proprietor of a trade mark or of a commercial designation may claim against the infringer in cases falling under sections 14, 15 and 17 requiring the re-call of unlawfully-identified goods or their permanent removal from sale.

(3) The rights in accordance with subs. 1 and 2 shall be ruled out if the claiming is disproportionate in individual cases. The legitimate interests of third parties shall also be taken into account when examining proportionality.

Section 19 Right to information

(1) The proprietor of a trade mark or of a commercial designation may demand from the infringer in cases falling under sections 14, 15 and 17 to be promptly informed of the origin and the sales channels of unlawfully-identified goods or services.

(2) In cases of manifest infringements of rights, or in cases in which the proprietor of a trade mark or of a commercial designation has lodged an action against the infringer, the right shall also apply, regardless of subs. 1, vis-à-vis a person who on a commercial scale

1. had possession of right-infringing goods,
2. availed him/herself of right-infringing services,
3. provided services used for right-infringing activities, or
4. in accordance with the indications provided by a person listed in Nos. 1, 2 or No. 3 was involved in the production, manufacture or commercialisation of such goods or in the provision of such services,

unless the person would have been entitled in accordance with sections 383 to 385 of the Code of Civil Procedure (Zivilprozessordnung) to refuse to testify in the trial against the infringer. In cases of the right in accordance with sentence 1 being asserted in court, the court may suspend the legal dispute pending against the infringer on request until completion of the legal dispute being pursued with regard to the right to information. The person obliged to provide information may demand from the injured party compensation for the expenditure required to provide the information.

(3) The party obliged to provide indications shall provide information regarding

1. the name and address of the manufacturers, suppliers and other previous proprietors of the goods or services, as well as of the commercial purchasers and points of sale for whom they were intended, and
2. the quantity of the goods manufactured, delivered, received or ordered, as well as the prices paid for the goods or services in question.

(4) The rights in accordance with subs. 1 and 2 shall be ruled out if claiming is disproportionate in the individual case.

(5) If the person obliged to provide the information provides incorrect or incomplete information either intentionally or with gross negligence, he/she shall be obliged to provide the proprietor of a trade mark or of a commercial designation with compensation for the damage incurred thereby.

(6) Anyone who has provided truthful information without having been obliged to do so in accordance with subs. 1 or subs. 2 shall only be liable to the third party if he/she knew that he/she was not obliged to provide the information.

(7) In cases of a manifest infringement of rights, the obligation to provide the information may be ordered by means of an injunction in accordance with sections 935 to 945 of the Code of Civil Procedure.

(8) The information may only be used with the consent of the party obliged to provide the information in criminal proceedings or in proceedings in accordance with the Act on Regulatory Offences (Gesetz über Ordnungswidrigkeiten) because of an offence committed prior to the provision of the information against the party obliged to provide the information or against a relative designated in section 52 subs. 1 of the Code of Criminal Procedure (Strafprozessordnung).

(9) If the information can only be provided using traffic data (section 3 No. 30 of the Telecommunications Act [Telekommunikationsgesetz]), a prior judicial order regarding the permissibility of the use of the traffic data shall be required for their provision which is to be applied for by the injured party. The Regional Court shall have exclusive jurisdiction for the issuance of this order in whose district the party obliged to provide the information has his/her place of residence, his/her seat of business or a branch office, regardless of the value at dispute. The decision shall be taken by the civil chamber. The provisions contained in the Act on the Procedure in Family Matters and in Matters of Non-contentious Jurisdiction (Gesetz über das Verfahren in Familiensachen und in den Angelegenheiten der freiwilligen Gerichtsbarkeit) shall apply to the proceedings mutatis mutandis. The costs of the judicial hearing shall be borne by the injured party. An appeal shall be admissible against the decision of the Regional Court. The appeal must be lodged within a two-week period. The provisions on the protection of personal data shall remain unaffected in other respects.

(10) Subs. 2 in conjunction with subs. 9 restricts the fundamental right of the privacy of telecommunications (Article 10 of the Basic Law [Grundgesetz]).

Section 19a

Rights of submission and inspection

(1) If there is sufficient probability of an infringement of rights in accordance with sections 14, 15 and 17, the proprietor of a trade mark or of a commercial designation may require the putative infringer to submit a document or to tolerate the inspection of an object which is at his/her disposal if this is required to establish his/her rights. If there is sufficient probability of a infringement of rights having been committed on a commercial scale, the right shall also encompass the submission of banking, financial or trade documents. Insofar as the putative infringer claims that this is confidential information, the court shall take the necessary measures to provide the protection required in the individual case.

(2) The right in accordance with subs. 1 shall be ruled out if the claim is disproportionate in the individual case.

(3) The obligation to submit a document or to tolerate the inspection of an object may be ordered by means of an injunction in accordance with sections 935 to 945 of the Code of Civil Procedure. The court shall take the necessary measures to guarantee the protection of confidential information. This shall apply in particular in cases in which the injunction is issued without a prior hearing of the opponent.

(4) Section 811 of the Civil Code, as well as section 19 subs. 8, shall apply mutatis mutandis.

(5) If no infringement was committed or threatened, the putative infringer may demand from the party which requested the submission or inspection in accordance with subs. 1 compensation for the damage incurred by him/her as a result of the request.

Section 19b Securing compensation claims

(1) The proprietor of a trade mark or of a commercial designation may also require the infringer in the event of an infringement of rights committed on a commercial scale in cases falling under section 14 subs. 6, section 15 subs. 5, as well as section 17 subs. 2 sentence 2 to submit banking, financial or commercial documents or to tolerate suitable access to corresponding documents which are at the disposal of the infringer and which are required for the assertion of the compensation claim if the satisfaction of the compensation claim is questionable without such submission. Insofar as the infringer asserts that this is confidential information, the court shall take the necessary measures in order to guarantee the protection required in the individual case.

(2) The right in accordance with subs. 1 shall be ruled out if the claim is disproportionate in the individual case.

(3) The obligation to submit the documents designated in subs. 1 may be ordered by means of an injunction in accordance with sections 935 to 945 of the Code of Civil Procedure if the right to compensation is manifest. The court shall take the necessary measures in order to guarantee the protection of confidential information. This shall apply in particular in cases in which the injunction is issued without a prior hearing of the opponent.

(4) Section 811 of the Civil Code, as well as section 19 subs. 8, shall apply mutatis mutandis.

Section 19c Announcement of judgments

If an action has been lodged on the basis of this Act, the power may be conferred on the winning party in the judgment to announce the judgment in public at the expense of the losing party if it puts forward a legitimate interest. The nature and scope of the announcement shall be determined in the judgment. The power shall cease to apply if it is not put to use within three months after entry into final force of the judgment. The dictum in accordance with sentence 1 shall not be enforceable on an interim basis.

Section 19d Rights from other statutory provisions

Rights from other statutory provisions shall remain unaffected.

Chapter 4 Restrictions of protection

Section 20 Lapse

The provisions of Chapter 5 of Book 1 of the Civil Code shall apply mutatis mutandis to the lapse of the rights designated in sections 14 to 19c. Section 852 of the Civil Code shall apply mutatis mutandis if the liable party has acquired something by virtue of the infringement at the expense of the authorised party.

Section 21 Forfeiting of rights

(1) The proprietor of a trade mark or of a commercial designation shall not be entitled to prohibit the use of a registered trade mark with younger seniority for the goods or services for which it has been registered insofar as he/she has acquiesced, for a period of five successive years, in the use of the trade mark while being aware of such use, unless the registration for the trade mark with younger seniority was applied for in bad faith.

(2) The proprietor of a trade mark or of a commercial designation shall not be entitled to prohibit the use of a trade mark within the meaning of section 4 No. 2 or 3, of a commercial designation or of any other right within the meaning of section 13 with younger seniority insofar as he/she has acquiesced, for a period of five successive years, in the use of this right while being aware of such use unless the proprietor of this right acted in bad faith at the time of acquisition of the right.

(3) In cases falling under subs. 1 and 2, the proprietor of the right with younger seniority may not prohibit the use of the right with older seniority.

(4) Subs. 1 to 3 shall not affect the application of general principles regarding the forfeiting of rights.

Section 22

Exclusion of rights if the registration of a trade mark with younger seniority is definitive

(1) The proprietor of a trade mark or of a commercial designation shall not be entitled to prohibit the use of a registered trade mark with younger seniority for the goods or services for which it has been registered if an application for cancellation of the registration of the trade mark with younger seniority has been rejected or would have to be refused

1. because the trade mark or commercial designation with older seniority did not yet have a reputation within the meaning of section 9 subs. 1 No. 3, of section 14 subs. 2 No. 3 or of section 15 subs. 3 on the date material for the seniority of the registration of the trade mark with younger seniority (section 51 subs. 3),
2. because the registration of the trade mark with older seniority could have been cancelled because of revocation or because of absolute obstacles to protection on the date of the publication of the registration of the trade mark with younger seniority (section 51 subs. 4).

(2) In cases falling under subs. 1, the proprietor of the registered trade mark with younger seniority may not prohibit the use of the trade mark or of the commercial designation with older seniority.

Section 23

Use of names and descriptive indications, spare parts business

The proprietor of a trade mark or of a commercial designation shall not be entitled to prohibit a third party in the course of trade

1. to use their name or address,
2. to use a sign identical to the trade mark or commercial designation or a similar sign as an indication of characteristics or properties of goods or services, in particular their nature, quality, intended purpose, value, geographical origin or time of production or of rendering, or
3. to use the trade mark or the commercial designation as an indication of the intended purpose of a good, in particular as an accessory or spare part, or of a service insofar as the use is necessary therefor

if use does not contravene accepted principles of morality.

Section 24

Exhaustion

(1) The proprietor of a trade mark or of a commercial designation shall not be entitled to prohibit a third party from using the trade mark or the commercial designation for goods which have been put on the market under this trade mark or this commercial designation by him/her or with his/her consent in this country, in one of the other Member States of the European Union or in another Contracting Party to the Agreement on the European Economic Area.

(2) Subs. 1 shall not apply if the proprietor of the trade mark or of the commercial designation opposes the use of the trade mark or of the commercial designation in connection with the further commercialisation of the goods for legitimate reasons, in particular if the condition of the goods has been changed or impaired after being put on the market.

Section 25

Exclusion of rights for lack of use

(1) The proprietor of a registered trade mark may not assert rights vis-à-vis third parties within the meaning of sections 14 and 18 to 19c if the trade mark has not been used in accordance with section 26 within the last five years prior to the assertion of the right for the goods or services which he/she invokes to establish his/her right, insofar as the trade mark has been registered for at least five years at this time.

(2) If rights within the meaning of sections 14 and 18 to 19c are asserted for an infringement of a registered trade mark by means of an action, the plaintiff must demonstrate in response to an objection by the defendant that the trade mark has been used in accordance with section 26 within the last five years prior to the lodging of the action for the goods or services he/she invokes in order to establish his/her right, insofar as the trade mark has been registered for at least five years at this time. If the five-year period of non-use ends subsequent to the lodging of the action, the plaintiff shall demonstrate in response to an objection of the defendant that the trade mark has been used in accordance with section 26 within the last five years prior to the conclusion of the oral hearing. The decision shall only take into consideration the goods or services for which use has been documented.

Section 26

Use of the trade mark

(1) Where the assertion of rights from a registered trade mark or the upholding of the registration depends on the trade mark having been used, it must have been seriously used in this country by its proprietor for the goods or services in respect of which it is registered unless there are legitimate grounds for non-use.

(2) The use of the trade mark with the consent of the proprietor shall be deemed as use by the proprietor.

(3) The use of the trade mark in a shape which deviates from the registration shall also be deemed to constitute use of a registered trade mark insofar as the deviations do not change the distinctive character of the trade mark. Sentence 1 shall also be applied if the trade mark is also registered in the shape in which it has been used.

(4) Use in this country shall be deemed to also include the affixing of the trade mark on goods or their wrapping or packaging in this country if the goods are exclusively intended for export.

(5) Insofar as use within five years from the point in time of the registration is necessary, in cases in which an opposition has been lodged against the registration, the time of the registration shall be substituted by the point in time of the conclusion of the opposition proceedings.

Chapter 5

Trade marks as an object of property

Section 27

Transfer

(1) The right established by the registration, the use or the fact of it being a well-known trade mark may be transferred or pass to others for all or for a part of the goods or services for which the trade mark enjoys protection.

(2) If the trade mark is part of a business operation or of a component of a business operation, the right arising from the registration, the use or the fact of it being a well-known trade mark shall in cases of doubt be included in the assignment or the transfer of the business operation or of the component of the business operation to which the trade mark belongs.

(3) The transfer of the right created by the registration of a trade mark shall be entered in the register on request by a party if it is documented to the Patent Office.

(4) If the transfer only concerns one part of the goods or services for which the trade mark is registered, the provisions on the division of the registration shall be applied mutatis mutandis, with the exception of section 46 subs. 2 and 3 sentences 1 and 2.

Section 28

Presumption of proprietorship of the right, service on the proprietor

- (1) It shall be presumed that the party recorded in the register as the proprietor is entitled to the right arising from the registration of a trade mark.
- (2) If the right arising from the registration of a trade mark has been transferred or has passed to another, the successor, in proceedings before the Patent Office, in appeal proceedings before the Patent Court or in appeal on points of law proceedings before the Federal Court of Justice, may only assert the right to protection of this trade mark and the right arising from the registration from the time when the Patent Office has received the application for the registration of the transfer. Sentence 1 shall apply mutatis mutandis to other proceedings before the Patent Office, to appeal proceedings before the Patent Court or to appeal on points of law proceedings before the Federal Court of Justice in which the proprietor of a trade mark is involved. If the successor takes on proceedings in accordance with sentence 1 or 2, the consent of the other parties to the proceedings shall not be required.
- (3) Orders and decrees of the Patent Office which are required to be served on the proprietor of the trade mark shall be served on the person registered as the proprietor. If the Patent Office has received an application for the registration of a transfer, the orders and decrees referred to in sentence 1 shall also be served on the successor.

Section 29

Rights in rem, levy of execution, insolvency proceedings

- (1) The right arising from the registration, the use or the fact of being a well-known trade mark may be
1. pledged or form the object of another right in rem, or
 2. the object of measures of levy of execution.
- (2) If the rights referred to in subs. 1 No. 1 or the measures referred to in subs. 1 No. 2 concern the right arising from the registration of a trade mark, they shall be entered in the register at the request of a party if they are documented to the Patent Office.
- (3) If the right arising from the registration of a trade mark is covered by insolvency proceedings, this shall be entered in the register at the request of the insolvency administrator or at the request of the insolvency court. In the case of personal management (section 270 of the Insolvency Statute [Insolvenzordnung]), the custodian shall take the place of the insolvency administrator.

Section 30

Licences

- (1) The right arising from the registration, the use or the fact of being well known of a trade mark may for all or for a part of the goods or services for which the trade mark enjoys protection form the subject-matter of exclusive or non-exclusive licences for the territory of the Federal Republic of Germany as a whole or part of this territory.
- (2) The proprietor of a trade mark may assert the rights from the trade mark against a licensee who acts in contravention of a provision of the licence agreement with regard to
1. the term of the licence,
 2. the manner in which the trade mark may be used, as covered by the registration,
 3. the nature of the goods or services for which the licence was issued,
 4. the territory in which the trade mark may be affixed, or
 5. the quality of the goods manufactured by them or of the services provided by them.

(3) The licensee may lodge an action for infringement of a trade mark only with the consent of its proprietor.

(4) Each licensee may accede to an action for infringement lodged by the proprietor of the trade mark in order to claim compensation for damage incurred by him/her.

(5) A transfer in accordance with section 27 or the issuance of a licence in accordance with subs. 1 shall not affect the licences which have previously been issued to third parties.

Section 31

Trade marks applied for

Sections 27 to 30 shall apply mutatis mutandis to rights established by virtue of application for trade marks.

Part 3

Proceedings in the course of trade mark-related matters

Chapter 1

Registration proceedings

Section 32

Requirements concerning the application

(1) The application to enter a trade mark in the register shall be submitted to the Patent Office. The application may also be submitted via a Patent Information Centre if this agency has been designated by a notice of the Federal Ministry of Justice in the Federal Law Gazette to accept trade mark applications.

(2) The application must contain the following:

1. indications permitting to verify the identity of the applicant,
2. a representation of the trade mark, and
3. a list of the goods or services for which registration is being applied.

(3) The application must meet the further prerequisites for application which have been determined in a legal ordinance in accordance with section 65 subs. 1 No. 2.

(4) (repealed)

Section 33

Date of application, right to registration, publication of the application

(1) The date of application of a trade mark is the date on which the documents containing the indications in accordance with section 32 subs. 2 were received

1. by the Patent Office
2. or, if this agency has been designated by virtue of a notice of the Federal Ministry of Justice in the Federal Law Gazette, by a Patent Information Centre.

(2) The application for a trade mark whose date of application has been established shall give rise to a right to a registration. The application for a registration shall be granted unless the prerequisites for application are not met or absolute grounds for refusal oppose the registration.

(3) The application for a trade mark whose date of application has been established shall be published including such indications permitting the verification of the identity of the applicant.

Section 34

Foreign priority

(1) The assertion of the priority of a prior foreign application shall be governed by the provisions of the international agreements on the proviso that priority can also be claimed for services in accordance with the Paris Convention.

(2) If the prior foreign application has been lodged in a state with which no international treaty exists on acknowledgement of priority, the applicant may claim a right of priority

corresponding to the right of priority in accordance with the Paris Convention, insofar as in accordance with a notice of the Federal Ministry of Justice in the Federal Law Gazette the other state on the basis of a first application to the Patent Office grants a right of priority which in terms of its prerequisites and content is comparable to the right of priority in accordance with the Paris Convention.

(3) Anyone claiming priority in accordance with subs. 1 or 2 shall within two months after the date of application state the time and state of the prior application. If the applicant has provided these indications, the Patent Office shall call on him/her to state the reference of the prior application and to submit a duplicate of the prior application within two months of the service of the request. The indications may be altered within these periods. If the indications are not provided in good time, the priority claim for this application shall be forfeited.

Section 35 Exhibition priority

(1) If an applicant for a trade mark has displayed goods or services under the trade mark applied for

1. at an official or officially-recognised international exhibition within the terms of the Convention on International Exhibitions signed in Paris on 22 November 1928, or
2. at another domestic or foreign exhibition,

he/she may if he/she 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 designated in subs. 1 No. 1 shall be announced by the Federal Ministry of Justice in the Federal Gazette.

(3) The exhibitions in accordance with subs. 1 No. 2 shall be determined in individual cases by the Federal Ministry of Justice and announced in the Federal Gazette.

(4) Anyone claiming priority in accordance with subs. 1 must within two months after the date of application state the date of the first display, as well as the exhibition. If the applicant has provided these indications, the Patent Office shall request him/her to submit the documentation proving the display of the goods or services under the trade mark applied for within two months after the service of the request. If the documentation is not submitted in good time, the priority claim for this application shall be forfeit.

(5) The exhibition priority in accordance with subs. 1 shall not extend the priority period in accordance with section 34.

Section 36 Examination of the prerequisites for application

(1) The Patent Office shall examine whether

1. the application for the trade mark satisfies the prerequisites for the award of a date of application in accordance with section 33 subs. 1,
2. the application satisfies the other prerequisites for application,
3. the sufficient amount of fees has been paid, and
4. the applicant may be a proprietor of a trade mark in accordance with section 7.

(2) If defects ascertained in accordance with subs. 1 No. 1 are not remedied within a period set by the Patent Office, the application shall be deemed to have been withdrawn. If the applicant complies with the request of the Patent Office, the Patent Office shall grant as the date of application the date on which the defects ascertained are remedied.

(3) If class fees are not subsequently paid within a period set by the Patent Office, or are not paid in a sufficient amount, or if the applicant does not specify which goods or service

classes are to be covered by the amount of fees paid, first and foremost the leading class and then the other classes and then the other subclasses shall be accounted for in the order of the classification. The application shall be deemed to have been withdrawn in other respects.

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

(5) If the applicant cannot be an proprietor of a trade mark in accordance with section 7, the Patent Office shall reject the application.

Section 37

Examination for absolute obstacles to protection

(1) If the trade mark is excluded from registration in accordance with section 3, 8 or 10, the application shall be refused.

(2) If the examination reveals that the trade mark (section 33 subs. 1) did not meet the prerequisites of section 8 subs. 2 No. 1, 2 or 3 on the date of application, but that the obstacle to protection no longer applies subsequent to the date of application, the application may not be refused if the applicant declares his/her agreement that, regardless of the original date of application, and of any priority claimed for instance in accordance with section 34 or section 35, the date on which the obstacle to protection ceased to apply is deemed to be the date of application and is material to the determination of seniority within the meaning of section 6 subs. 2.

(3) An application shall be refused in accordance with section 8 subs. 2 No. 4 or No. 10 only if it is likely mislead or if bad faith is evident.

(4) An application shall only be refused in accordance with section 10 if the fact that the earlier trade mark is well known is known to the authorities and if the further prerequisites of section 9 subs. 1 No. 1 or 2 apply.

(5) Subs. 1 to 4 shall be applied mutatis mutandis if the trade mark has only been excluded from registration for a part of the goods or services for which the application was filed.

Section 38

Accelerated examination

The examination in accordance with sections 36 and 37 shall be expedited at the request of the applicant.

Section 39

Withdrawal, restriction and correction of the application

(1) The applicant may withdraw the application at any time or restrict the list of goods and services contained in the application.

(2) The content of the application may be altered at the request of the applicant to correct errors of wording or of copying, or obvious mistakes.

Section 40

Division of the application

(1) The applicant may divide the application by declaring that the application for the trade mark shall continue to be dealt with thenceforth as a divisional application for the goods and services listed in the declaration of division. The seniority of the original application shall be retained for each sub-application.

(2) The application documents required in accordance with section 32 shall be submitted for the divisional application. If the application documents are not submitted within three months after receipt of the declaration of division, or if the fee in accordance with the Patent Costs Act (Patentkostengesetz) for the division proceedings is not paid within this period, the divisional application shall be deemed to have been withdrawn. The declaration of division may not be revoked.

Section 41

Registration

If the application satisfies the prerequisites for application, and if it is not refused in accordance with section 37, the trade mark applied for shall be entered in the register. The registration shall be published.

Section 42 Opposition

(1) Within a three-month period after the date of the publication of the registration of the trade mark in accordance with section 41, the proprietor of a trade mark or of a commercial designation with older seniority may lodge an opposition against the registration of the trade mark.

(2) The opposition may only invoke that the trade mark may be cancelled

1. because of a trade mark applied for or registered with older seniority in accordance with section 9,
2. because of a well-known mark with older seniority in accordance with section 10 in conjunction with section 9,
3. because of its registration for an agent or representative of the trade mark proprietor in accordance with section 11, or
4. because of a trade mark not registered with older seniority in accordance with section 4 No. 2 or of a commercial designation with older seniority in accordance with section 5 in conjunction with section 12.

(3) (repealed)

Section 43 Objection of insufficient use, decision on the opposition

(1) If the opposition has been lodged by the proprietor of a registered trade mark with older seniority, he/she shall, if the other party disputes the use of the trade mark, make a plausible case that he/she, within the last five years prior to the publication of the registration of the trade mark which is targeted by the opposition, has been used in accordance with section 26 insofar as it has been registered for at least five years at this point in time. If the period of five years of non-use ends after the publication of the registration, the opponent, if the other party disputes the use, must make a plausible case that the trade mark has been used in accordance with section 26 within the past five years prior to the decision on the opposition. Only those goods or services shall be taken into consideration in the decision with respect to which a plausible case has been made for use.

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

(3) If the registered trade mark is to be cancelled because of one or several trade marks with older seniority, the proceedings on further objections may be suspended until a decision has been handed down with legal force on the registration of the trade mark.

(4) Section 52 subs. 2 and 3 shall be applied mutatis mutandis in the event of cancellation in accordance with subs. 2.

Section 44 Action for the grant of registration

(1) The proprietor of the trade mark may claim by means of an action against the opponent that he/she has a right to the registration despite the cancellation of the registration in accordance with section 43.

(2) The action in accordance with subs. 1 shall be lodged within six months after the decision with which the registration has been cancelled ceases to be subject to appeal.

(3) The registration on the basis of a decision in favour of the proprietor of the trade mark shall be carried out preserving the seniority of the registration.

Chapter 2 **Correction, division, duration of protection and renewal**

Section 45 **Correction of the register and of publications**

(1) Entries in the register can be altered upon request or ex officio to correct errors of wording or of copying, or obvious mistakes. If the registration affected by the correction had been published, the corrected registration shall be published.

(2) Subs. 1 shall be applied mutatis mutandis to the correction of publications.

Section 46 **Division of the registration**

(1) The proprietor of a registered trade mark may divide the registration by declaring that the registration of the trade mark for the goods or services listed in the declaration of division is to continue as a divisional registration. The seniority of the original registration shall be retained for each sub-registration.

(2) The division may not be declared until after expiry of the time limit for the lodging of the opposition. The declaration shall only be admissible if an opposition pending at the time of its submission against the registration of the trade mark or an action pending at this time for cancellation of the registration of the trade mark would, after the division, only address one of the parts of the original registration.

(3) The necessary documents shall be submitted for the divisional registration. If the documents are not submitted within three months after receipt of the declaration of division, or if the fee in accordance with the Patent Costs Act for the division proceedings is not paid within this period, this shall be deemed to constitute surrender of the divisional registration. The declaration of division cannot be revoked.

Section 47 **Duration of protection and renewal**

(1) The duration of protection of a registered trade mark shall commence on the date of application (section 33 subs. 1) and shall end after ten years on the last day of the month corresponding in name to the month in which the date of application falls.

(2) The duration of protection may be extended by ten years in each case.

(3) The renewal of the duration of protection shall be effected by payment of a renewal fee and, if the renewal is requested for goods and services falling in more than three classes of the classification of goods and services, payment of a class fee for each further class.

(4) If the fees only relate to a part of the goods or services for which the trade mark is registered, the duration of protection shall only be renewed for these goods or services. If only the required class fees are not paid, the duration of protection, unless sentence 1 applies, shall be renewed only for the classes for which the fees paid suffice. If there is a leading class, it shall be accounted for first. In other respects, the classes shall be taken into account in the order of the classification.

(5) The renewal of the duration of protection shall become effective on the day after the expiry of the duration of protection. It shall be entered in the register and published.

(6) If the duration of protection is not renewed, the registration of the trade mark shall be cancelled with effect from the expiry of the duration of protection.

Chapter 3 **Surrender, revocation and invalidity, cancellation proceedings**

Section 48 **Surrender**

(1) At the request of the proprietor of the trade mark, the registration shall be cancelled in the register at any time for all or for a part of the goods or services in respect of which it is registered.

(2) If a person is entered in the register as the proprietor of a right to the trade mark, the registration shall only be cancelled with the consent of this person.

Section 49 Revocation

(1) The registration of a trade mark shall be cancelled on request because of revocation if the trade mark has not been used after the date of registration in accordance with section 26 within an uninterrupted period of five years. The revocation of a trade mark may however not be claimed if use of the trade mark in accordance with section 26 has been commenced or resumed after the end of this period and prior to the filing of the application for cancellation. If however use is commenced or resumed following an uninterrupted period of five years of non-use within three months prior to the filing of the cancellation application, it shall remain unconsidered insofar as the preparations for the first or renewed use did not take place until the proprietor of the trade mark became aware of the fact that an application for cancellation may be filed. If the application for cancellation is made to the Patent Office in accordance with section 53 subs. 1, the application to the Patent Office shall remain material for the calculation of the three-month period in accordance with sentence 3 if the action for cancellation in accordance with section 55 subs. 1 is lodged within three months after service of the notice in accordance with section 53 subs. 4.

(2) The registration of a trade mark shall furthermore be cancelled on request because of revocation

1. if as a consequence of acts or inactivity of the proprietor, the trade mark has become the common name in the trade of the goods or services in respect of which it is registered;

2. if as a consequence of the use made of the trade mark by the proprietor or with his/her consent in respect of the goods or services in respect of which it is registered, is liable to mislead the public particularly as to the nature, quality or geographical origin of those goods or services;

3. if the proprietor of the trade mark no longer complies with the prerequisites set out in section 7.

(3) If a ground for revocation applies only to a part of the goods or services for which the trade mark has been registered, the registration shall only be cancelled for these goods or services.

Section 50 Invalidity because of absolute obstacles to protection

(1) The registration of a trade mark shall be cancelled on request because of invalidity if it has been registered in contravention of sections 3, 7 or 8.

(2) If the trade mark has been registered in contravention of sections 3, 7 or 8 subs. 2 Nos. 1 to 9, the registration may only be cancelled if the obstacle to protection still exists at the time of the decision on the application for cancellation. If the trade mark has been registered in contravention of section 8 subs. 2 No. 1, 2 or 3, the registration may furthermore only be cancelled if the application for cancellation is lodged within ten years since the date of registration.

(3) The registration of a trade mark may be cancelled ex officio if it has been registered in contravention of section 8 subs. 2 Nos. 4 to 10, and

1. the cancellation proceedings are initiated within a period of two years from the date of registration,

2. the absolute obstacle to protection in accordance with section 8 subs. 2 Nos. 4 to 9 continues to exist at the time of the decision on the cancellation, and

3. the registration has been manifestly made in contravention of the provisions listed.

(4) If there is a ground for invalidity only for a part of the goods or services for which the trade mark has been registered, the registration shall only be cancelled for these goods or services.

Section 51

Invalidity because of the existence of earlier rights

(1) The registration of a trade mark shall be cancelled in response to an action because of invalidity if it is opposed by a right within the meaning of sections 9 to 13 with older seniority.

(2) The registration may not be cancelled because of the registration of a trade mark with older seniority insofar as the proprietor of the trade mark with older seniority has tolerated the use of the trade mark with younger seniority for the goods or services in respect of which it is registered during a period of five consecutive years in the knowledge of this use, unless the application for the trade mark with younger seniority has been made in bad faith. The same shall apply to the proprietor of a right with older seniority to a trade mark acquired by use within the meaning of section 4 No. 2, in a well-known mark within the meaning of section 4 No. 3, in a commercial designation within the meaning of section 5 or in a name of a plant variety within the meaning of section 13 subs. 2 No. 4. The registration of a trade mark may further not be cancelled if the proprietor of one of the rights listed in sections 9 to 13 with older seniority has consented to the registration of the trade mark prior to the filing of the application for cancellation.

(3) The registration may not be cancelled because of a trade mark which has a reputation or of a commercial designation which has a reputation with older seniority if the trade mark or the commercial designation did not yet have a reputation within the meaning of section 9 subs. 1 No. 3, of section 14 subs. 2 No. 3 or of section 15 subs. 3 on the date which is material to the seniority of the registration of the trade mark with younger seniority.

(4) The registration may not be cancelled because of the registration of a trade mark with older seniority if the registration of the trade mark with older seniority could have been cancelled on the date of the publication of the registration of the trade mark with younger seniority

1. because of revocation in accordance with section 49, or

2. because of absolute obstacles to protection in accordance with section 50.

(5) If there is a ground for invalidity only for a part of the goods or services for which the trade mark is registered, the registration shall only be cancelled for these goods or services.

Section 52

Impact of cancellation because of revocation or invalidity

(1) The effects of the registration of a trade mark shall be deemed not to have taken place from the point in time of the lodging of the action for cancellation to the extent to which the registration is cancelled because of revocation. In the decision, at the request of a party an earlier point in time may be determined at which one of the grounds for revocation commenced to apply.

(2) The impact of the registration of a trade mark shall be deemed to not have taken effect from the outset to the extent to which the registration is cancelled because of invalidity.

(3) On the proviso of the provisions on compensation for the damage which has been caused by negligent or intentional conduct on the part of the proprietor of a trade mark, as well as of the provisions on undue enrichment, the cancellation of the registration of the trade mark shall not affect

1. decisions in infringement proceedings which have become final and have been executed prior to the decision on the cancellation application, and
2. contracts concluded prior to the decision on the cancellation application insofar as they have been performed prior to this decision. It may however be required that amounts paid in performance of the contract are refunded for reasons of equity insofar as the circumstances so justify.

Section 53

Cancellation by the Patent Office because of revocation

- (1) The application for cancellation because of revocation (section 49) may be lodged with the Patent Office, without prejudice to the right to assert the application by means of an action in accordance with section 55.
- (2) The Patent Office shall inform the proprietor of the registered trade mark of the application and shall call on him/her to inform the Patent Office whether he/she objects to the cancellation.
- (3) If the proprietor of the registered trade mark does not object to the cancellation within two months of service of the notice, the registration shall be cancelled.
- (4) If the proprietor of the registered trade mark objects to the cancellation, the Patent Office shall inform the applicant thereof, and shall inform him/her that the application for cancellation is to be asserted by means of an action in accordance with section 55.

Section 54

Cancellation proceedings before the Patent Office because of absolute obstacles to protection

- (1) The application for cancellation because of absolute obstacles to protection (section 50) shall be lodged with the Patent Office. The application may be lodged by any person.
- (2) If an application for cancellation is lodged, or if cancellation proceedings are initiated ex officio, the Patent Office shall inform the proprietor of the registered trade mark thereof. If he/she does not object to the cancellation within two months of service of the notice, the registration shall be cancelled. If he/she objects to the cancellation, the cancellation proceedings shall be implemented.

Section 55

Cancellation proceedings before the courts of ordinary jurisdiction

- (1) The action for cancellation for revocation (section 49) or because of the existence of earlier rights (section 51) shall be brought against the party registered as the proprietor of the trade mark or his/her successor.
- (2) The following shall be entitled to lodge the action:
 1. in cases of an application for cancellation because of revocation, any person,
 2. in cases of an application for cancellation because of the existence of rights with older seniority, the proprietors of the rights listed in sections 9 to 13,
 3. in cases of an application for cancellation because of the existence of an indication of geographical origin with older seniority (section 13 subs. 2 No. 5), the party entitled to assert rights in accordance with section 8 subs. 3 of the Act Against Unfair Competition (Gesetz gegen den unlauteren Wettbewerb).
- (3) If the action for cancellation has been lodged by the proprietor of a registered trade mark with older seniority, he/she shall document in response to an objection by the defendant that the trade mark has been used in accordance with section 26 within the last five years prior to the lodging of the action, insofar as it has been registered at this time for at least five years. If the five-year period of non-use ends after the action has been lodged, the plaintiff shall document in response to an objection on the part of the defendant that the trade mark has been used in accordance with section 26 within the last five years prior to the conclusion of

the oral hearing. If the trade mark with older seniority had already been registered for at least five years on the date of the publication of the registration of the trade mark with younger seniority, the plaintiff shall further prove in response to an objection on the part of the defendant that the registration of the trade mark with older seniority could not have been cancelled in accordance with section 49 subs. 1 on this day. Only those goods or services for which use has been documented shall be taken into account in the decision.

(4) If prior to or subsequent to the lodging of the action the right arising from the registration of the trade mark has been transferred or passed to another, the decision on the merits themselves shall also be effective and executable against the successor. Sections 66 to 74 and 76 of the Code of Civil Procedure (Zivilprozeßordnung) shall apply mutatis mutandis to the power of the successor to accede to the legal dispute.

Chapter 4

General provisions for the proceedings before the Patent Office

Section 56

Competences in the Patent Office

(1) Trade mark sections and trade mark divisions shall be established in the Patent Office to implement the proceedings in the course of trade mark-related matters.

(2) The trade mark sections shall have jurisdiction for the examination of trade marks applied for and for handing down orders in the registration proceedings. The tasks of a trade mark section shall be performed by a member of the Patent Office (examiner). The tasks may also be carried out by an official of the higher intermediate service or by a comparable employee. Officials of the higher intermediate service and comparable employees shall however not be entitled to order an oath to be sworn or to administer an oath or to address a request in accordance with section 95 subs. 2 to the Patent Court.

(3) The trade mark divisions shall have jurisdiction for those matters which do not fall within the jurisdiction of the trade mark sections. The tasks of a trade mark division shall be carried out by a team composed of at least three members of the Patent Office. The chairperson of a trade mark division may work alone on all matters falling within the jurisdiction of the trade mark division, with the exception of the decision on the cancellation of a trade mark in accordance with section 54, or transfer such matters to a member of the trade mark division for processing.

Section 57

Exclusion and rejection

(1) Sections 41 to 44, 45 subs. 2 sentence 2 and sections 47 to 49 the Code of Civil Procedure with regard to the exclusion and rejection of court personnel shall apply mutatis mutandis to the exclusion and rejection of the examiners and of the members of the trade mark divisions, as well as of the civil servants of the higher intermediate and intermediate service or employees entrusted with carrying out matters which are incumbent on the trade mark sections or the trade mark divisions

(2) A trade mark division shall decide on the rejection request insofar as there is a need for a decision.

Section 58

Expert reports

(1) The Patent Office shall be obliged to submit expert reports at the request of the courts or of the public prosecution offices with regard to questions relating to trade marks filed or registered if expert reports have been submitted in the proceedings by several expert witnesses which deviate from one another.

(2) In other respects, the Patent Office shall not be empowered without the consent of the Federal Ministry of Justice to give orders or to submit expert reports outside the scope of its statutory tasks.

Section 59

Ascertaining the facts, legal hearing

- (1) The Patent Office shall ascertain the facts *ex officio*. It shall not be bound by the submissions and the applications for the taking of evidence of the parties.
- (2) If the decision of the Patent Office is to be based on circumstances which have not yet been notified to the applicant or to the proprietor of the trade mark or to another party by the proceedings, it shall be afforded the opportunity in advance to make a statement thereon within a specified period.

Section 60

Investigations, hearings, record

- (1) The Patent Office may at any time summons and hear the parties, may question witnesses, expert witnesses and parties, whether under oath or not, as well as carry out other investigations required to clear up the case.
- (2) Until the order with which the proceedings are concluded, the applicant or proprietor of the trade mark or another party to the proceedings shall be heard on request if this is expedient. If the Patent Office does not consider a hearing to be expedient, it shall reject the application. The order by means of which the application is refused shall not be subject to separate challenge.
- (3) Minutes shall be taken of hearings and questioning which shall reproduce the essentials of the hearing and should contain the legally-material statements of the parties. Sections 160a, 162 and 163 of the Code of Civil Procedure shall be applied *mutatis mutandis*. The parties shall receive a copy of the record.

Section 61

Orders, information on appeals

- (1) Even if they have been pronounced in accordance with sentence 2, the orders of the Patent Office shall be drawn up in writing, reasoned and served on the parties *ex officio*. If a hearing has taken place, they may also be pronounced at the end of the hearing. No grounds shall be required if only the applicant or the proprietor of the trade mark is involved in the proceedings and his/her application is granted.
- (2) A declaration shall be enclosed with the written copy with which the parties are informed of the appeal which is available against the order, of the authority to which the appeal is to be submitted, of the time limit for the appeal, and where a fee is payable for the appeal in accordance with the Patent Costs Act, of the fee. The time limit for the appeal shall only begin to run if the parties have been informed in writing. If the information has not been provided or was incorrect, the lodging of the appeal shall only be permissible within one year from service of the order, except if the party has been informed in writing that no appeal is available. Section 91 shall be applied *mutatis mutandis*. Sentences 1 to 4 shall apply *mutatis mutandis* to the appeal of objection in accordance with section 64.

Section 62

Inspection of files, inspection of the register

- (1) The Patent Office shall grant on request inspection of the files of applications for trade marks if a legitimate interest is made plausible.
- (2) After the registration of the trade mark, inspection of the files of the registered trade mark shall be granted on request.
- (3) Inspection of the files in accordance with subs. 1 and 2 may also be granted via the Internet where files are kept electronically.
- (4) Inspection of the files in accordance with subs. 1 to 3 shall be ruled out where it is opposed by a legal provision or where the interest of the data subject which is to be protected within the meaning of section 3 subs. 1 of the Federal Data Protection Act (*Bundesdatenschutzgesetz*) obviously outweighs this.
- (5) Inspection of the register shall be free to all persons.

Section 63

Costs of the proceedings

- (1) If several persons are parties to the proceedings, the Patent Office may determine in the decision that the costs of the proceedings, including the expenses of the Patent Office and the costs incurred by the parties, insofar as they were necessary for the appropriate defence of the claims and rights, are charged to one party fully or partly if this is equitable. This may also be determined if the party withdraws the opposition, the application for the trade mark, the objection or the application for cancellation fully or in part or if the registration of the trade mark is cancelled fully or in part in the register because of surrender or because of non-renewal of the duration of protection. Insofar as no determination is made as to the costs, each of the parties shall bear the costs incurred by him/her him/herself.
- (2) The Patent Office may order that the fee in accordance with the Patent Costs Act for the accelerated examination, for the opposition or cancellation proceedings is repaid fully or in part if this is equitable.
- (3) The amount of the costs to be refunded shall be set on request by the Patent Office. The provisions contained in the Code of Civil Procedure on the cost setting proceedings (sections 103 to 107) and the levy of execution from cost setting orders (sections 724 to 802) shall be applied mutatis mutandis. The appeal against the cost setting order shall take the place of the objection. Section 66 shall be applied on the proviso that the appeal is to be submitted within two weeks. The executable copy shall be issued by the registrar of the Patent Court.

Section 64

Objection

- (1) The objection shall be available against the orders of the trade mark sections and the trade mark divisions which have been issued by a civil servant of the higher intermediate service or a comparable employees. The objection shall have a suspensive effect.
- (2) The objection shall be lodged with the Patent Office within one month after service.
- (3) If the civil servant or employee whose order is being challenged considers the objection to be well-founded, he/she shall remedy it. This shall not apply if the objecting party is opposed by another party to the proceedings.
- (4) A member of the Patent Office shall rule on the objection by order.
- (5) The trade mark section or the trade mark division may order that the fee in accordance with the Patent Costs Act for the objection is refunded in full or in part.
- (6) In place of the objection, the appeal in accordance with section 66 may be lodged. If in proceedings in which several persons are involved one party has lodged an objection, and another party has lodged an appeal against an order, the objecting party may also lodge an appeal. If the appeal of the objecting party is not lodged within one month after service of the appeal of the other party in accordance with section 66 subs. 4 sentence 2, his/her objection shall be deemed to have been withdrawn.
- (7) It shall no longer be possible to rule on a objection after an appeal has been lodged in accordance with subs. 6 sentence 2 or in accordance with section 66 subs. 3. A ruling on an objection nonetheless handed down after this time shall be null and void.

Section 64a

Costs arrangements in the proceedings before the Patent Office

The Patent Costs Act shall apply to the costs in the proceedings before the Patent Office.

Section 65

Empowerment to hand down legal ordinances

- (1) The Federal Ministry of Justice is empowered by legal ordinance not requiring the consent of the Federal Council

1. to regulate the establishment and the business procedure, as well as the form taken by the proceedings in the course of trade mark-related matters unless these have been regulated by statute,

2. to determine further requirements for the application for trade marks,
 3. to determine the classification of goods and services,
 4. to make detailed arrangements for the implementation of the examination, opposition and cancellation proceedings,
 5. to make arrangements regarding the register of registered trade marks and where appropriate separate provisions regarding the register for collective marks,
 6. to regulate the indications regarding registered trade marks to be included in the register and to determine the extent and the nature of the publication of these indications,
 7. to make arrangements regarding the other procedures before the Patent Office provided for in this Act, such as in particular the procedure in the division of applications and of registrations, the procedure to issue information or certificates, the procedure for the re-establishment of rights, the procedure to inspect files, the procedure regarding protection of internationally-registered trade marks and the procedure regarding the conversion of Community trade marks,
 8. to make arrangements regarding the form in which applications and submissions are to be submitted in the course of trade mark-related matters, including the transmission of applications and submissions by means of electronic data transmission,
 9. to make arrangements regarding the form in which orders, notices or other communications of the Patent Office in the course of trade mark-related matters are to be transmitted to the parties, including transmission by means of electronic data transmission unless a specific form of transmission is prescribed by law,
 10. to make arrangements regarding the cases in which and the circumstances under which submissions and documents in the course of trade mark-related matters are considered in other languages than German,
 11. to entrust civil servants of the higher intermediate service or comparable employees with carrying out matters which are incumbent on the trade mark divisions and which by their nature do not pose any particular legal difficulties, with the exception of handing down orders on the cancellation of trade marks (section 48 subs. 1 and sections 53 and 54), the submission of expert reports (section 58 subs. 1) and the decisions whereby the submission of an expert report is refused,
 12. to entrust civil servants of the intermediate service or comparable employees with the carrying out of tasks which are incumbent on the trade mark sections or trade mark divisions and which by their nature do not pose any particular legal difficulties, with the exception of decisions on applications and opposition,
 13. to prescribe the indications to be included in the publication in accordance with section 33 subs. 3, as well as to determine the scope and nature of the publication of these indications.
- (2) The Federal Ministry of Justice may transfer the empowerment to issue legal ordinances in accordance with subs. 1 by means of a legal ordinance without the consent of the Federal Council fully or in part to the German Patent and Trade Mark Office.

Chapter 5 **Proceedings before the Patent Court**

Section 66 **Appeal**

- (1) The appeal to the Patent Court shall be available against the orders of the trade mark sections and the trade mark divisions, regardless of the provision contained in section 64. The appeal shall be available to the parties to the proceedings before the Patent Office. The appeal shall have a suspensive effect.
- (2) The appeal shall be lodged with the Patent Office in writing within one month after service of the order.
- (3) If no decision has been taken regarding an objection in accordance with section 64 within six months after its lodging, and if the objecting party has made an application for a decision after expiry of this period, the appeal shall be admissible directly against the order of the trade mark section or the trade mark division in derogation from subs. 1 sentence 1 if no decision has been taken on the objection within two months after receipt of the application. If the objecting party is opposed in the objection proceedings by another party, sentence 1 shall be applied on the proviso that the six-month time limit after the lodging of the objection shall be replaced by a time limit of ten months. If the other party has also lodged an objection, the appeal in accordance with sentence 2 shall require the consent of the other party. The written declaration of consent shall be enclosed with the appeal. If the other party does not also lodge an appeal within a period of one month after service of the appeal in accordance with subs. 4 sentence 2, his/her objection shall be deemed to have been withdrawn. The running of the periods in accordance with sentences 1 and 2 shall be suspended if the proceedings are stayed or if a party is granted a time limit at his/her request or because of binding provisions. The remaining part of the periods in accordance with sentences 1 and 2 shall commence after the ending of the suspension or after expiry of the time limit that has been granted. After the decision on the objection has been taken, an appeal in accordance with sentences 1 and 2 shall no longer be available.
- (4) Copies for the other parties should be enclosed with the appeal and all written statements. The appeal and all written statements containing applications related to the object of action or the declaration of withdrawal of the appeal or of an application shall be served on the other parties ex officio. Other written statements shall be transmitted to them informally unless service is ordered.
- (5) If the authority whose decision is being challenged considers the appeal to be well founded, it shall remedy it. This shall not apply if the appellant is opposed by another party by the proceedings. The agency may order the repayment of the appeal fee in accordance with the Patent Costs Act. If the appeal is not remedied in accordance with sentence 1, it shall be submitted to the Patent Court prior to expiry of one month without a factual statement. The appeal shall be submitted to the Patent Court promptly in cases falling under sentence 2. In proceedings with no third-party participation within the meaning of sentence 2, an application for the grant of legal aid for the appeal proceedings shall be submitted to the patent court for a preliminary ruling without delay.

Section 67

Boards of Appeal, public nature of the hearing

- (1) A Board of Appeal of the Patent Court shall rule on appeals within the meaning of section 66 composed of three members who are versed in the law.
- (2) The hearing regarding appeals against orders of the trade mark sections and the trade mark divisions, including the pronouncement of the decisions, shall be public insofar as the registration has been published.
- (3) Sections 172 to 175 of the Courts Constitution Act (Gerichtsverfassungsgesetz) shall apply mutatis mutandis on the proviso that
1. the public may also be excluded from the hearing at the request of a party if it gives rise to fear of a danger to interests of the applicant which are eligible for protection,
 2. the public is excluded for the pronouncement of the decisions until the publication of the registration.

Section 68

Participation of the President of the Patent Office

- (1) The President of the Patent Office may, if he considers it appropriate to safeguard the public interest, make written declarations to the Patent Court in the appeal proceedings, participate in the hearings and make statements thereat. Written declarations on the part of the President of the Patent Office shall be notified to the parties by the Patent Court.
- (2) The Patent Court may suggest to the President of the Patent Office to join the appeal proceedings if it considers this to be suitable because of a legal issue which is of fundamental significance. Once the joining declaration is received, the President of the Patent Office shall take on the status of a party.

Section 69

Oral hearing

An oral hearing shall take place if

1. one of the parties applies for it,
2. evidence is taken before the Patent Court (section 74 subs. 1), or
3. the Patent Court considers it to be expedient.

Section 70

Decision on the appeal

- (1) A decision shall be made regarding the appeal by means of an order.
- (2) The order by means of which an appeal is rejected as inadmissible may be handed down without an oral hearing.
- (3) The Patent Court may quash the challenged decision without ruling on the merits themselves if
1. the Patent Office has not yet ruled on the merits themselves,
 2. the proceedings before the Patent Office have a major defect, or
 3. new facts or items of evidence have become known which are relevant to the decision.
- (4) The Patent Office shall also use the legal assessment underlying the quashing in accordance with subs. 3 as a basis for its decision.

Section 71

Costs of the appeal proceedings

- (1) If several persons are involved in the proceedings, the Patent Court may determine that the costs of the proceedings, including the costs incurred by the parties, insofar as they were necessary for the appropriate defence of the claims and rights, shall be charged fully or in part to a party if this is equitable. If no arrangement is made as to the costs, each party shall bear the costs incumbent on them themselves.
- (2) Costs may only be imposed on the President of the Patent Office if he/she has made applications after joining the proceedings.
- (3) The Patent Court may order the repayment of the appeal fee in accordance with the Patent Costs Act.
- (4) Subs. 1 to 3 shall also be applied if the party fully or in part withdraws the appeal, the application for the trade mark, the opposition or the application for cancellation, or if the registration of the trade mark is cancelled in the register fully or in part because of surrender or because of non-renewal of the duration of protection.
- (5) In other respects, the provisions of the Code of Civil Procedure on the determination of cost proceedings (sections 103 to 107) and on the levy of execution from cost determination orders (sections 724 to 802) shall apply mutatis mutandis.

Section 72

Exclusion and rejection

- (1) Sections 41 to 44 and 47 to 49 of the Code of Civil Procedure shall apply mutatis mutandis to the exclusion and rejection of court personnel.
- (2) Persons shall also be excluded from executing the office of judge who were involved in the prior proceedings before the Patent Office.
- (3) The Board shall rule on the rejection of a judge to which the rejected judge belongs. If the Board becomes non-quorate by virtue of the departure of the rejected member, another Board of Appeal shall rule.
- (4) The Board within whose portfolio the matter falls shall rule on the rejection of a registrar.

Section 73

Investigation of the facts, preparation of the oral hearing

- (1) The Patent Court shall investigate the facts proprio motu. It shall not be bound by the submission and the applications for the taking of evidence of the parties.
- (2) The presiding judge or a member of the Board to be determined by him/her shall, prior to the oral hearing, or if none takes place then before the decision of the Patent Court, issue all orders which are necessary to conclude the matter if possible in one oral hearing or in one session. Section 273 subs. 2, subs. 3 sentence 1 and subs. 4 sentence 1 of the Code of Civil Procedure shall apply mutatis mutandis in other respects.

Section 74

Taking of evidence

- (1) The Patent Court shall take evidence in the oral hearing. It may in particular make inspections in situ, question witnesses, expert witnesses and the parties and consult certificates.
- (2) The Patent Court may already take evidence in suitable cases before the oral hearing by one of its members as a commissioned judge, or, designating the individual evidential questions, request another court to take evidence.
- (3) The parties shall be informed of all dates for the taking of evidence, and may attend the taking of evidence. They may address relevant questions to witnesses and expert witnesses. If a question is objected to, the Patent Court shall decide.

Section 75

Summonses

- (1) As soon as the oral hearing date has been set, the parties shall be summonsed with at least two weeks' notice. The presiding judge may shorten this period in urgent cases.
- (2) The summons shall notify that should a party fail to attend, the hearing can also be carried out and a ruling handed down without them.

Section 76

Course taken by the hearing

- (1) The presiding judge shall open and conduct the oral hearing.
- (2) Once the case has been called, the presiding judge or the reporting judge shall present the essential content of the files.
- (3) Thereupon, the parties shall be afforded the opportunity to make and substantiate their motions.
- (4) The presiding judge shall discuss the case with the parties in factual and legal terms.
- (5) The presiding judge shall permit each member of the Board on request to ask questions. If a question is objected to, the Board shall rule.
- (6) After the matter has been discussed, the presiding judge shall declare the oral hearing to be closed. The Board may order it to be reopened.

Section 77

Minutes

(1) A registrar of the registry shall attend the oral hearing and any taking of evidence as minute-writer. If the presiding judge orders the consultation of the minute-writer to be dispensed with, a judge shall take the minutes.

(2) A record shall be taken of the oral hearing and of any taking of evidence. Sections 160 to 165 of the Code of Civil Procedure shall be applied mutatis mutandis.

Section 78

Assessment of evidence, legal right to be heard

(1) The Patent Court shall rule in accordance with its free conviction gained from the overall outcome of the proceedings. The decision shall state the grounds which led the judges to reach such conviction.

(2) The decision may only be based on facts and the outcome of evidence on which the parties were afforded an opportunity to make a statement.

(3) If an oral hearing has previously taken place, a judge who was not present at the last oral hearing may only contribute towards the drawing up of the order if the parties consent thereto.

Section 79

Pronouncement, service, grounds

(1) If an oral hearing has taken place, the final decisions of the Patent Court shall be pronounced at the hearing in which the oral hearing is closed, or in a hearing which is to be scheduled immediately. This should only be scheduled more than three weeks later if important reasons so require, in particular the scope or the difficulty of the case. In place of the pronouncement, the service of the final decision shall be admissible. If the Patent Court decides without an oral hearing, the pronouncement shall be supplemented by service on the parties. The final decisions shall be served on the parties proprio motu.

(2) The decisions of the Patent Court by means of which a motion is refused or a decision is made on an appeal shall be reasoned.

Section 80

Corrections

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

(2) If the facts of the decision contain other mistakes or ambiguities, the correction may be applied for within two weeks of the decision being served.

(3) It shall be possible to rule on the correction in accordance with subs. 1 without a prior oral hearing.

(4) The Patent Court shall rule on the application for correction in accordance with subs. 2 by means of an order without taking evidence. Only those judges shall be involved here who have participated in the decision whose correction has been applied for.

(5) The correction order shall be noted on the decision and on the copies.

Section 81

Representation, power of attorney

(1) The parties may pursue the legal dispute before the Patent Court themselves. Section 96 shall remain unaffected thereby.

(2) The parties may have themselves represented by a lawyer or patent attorney as having power of attorney. Over and above this, only the following shall be authorised to act as representatives with power of attorney before the Patent Court

1. employees of the party or of an enterprise affiliated with the same (section 15 of the Share Capital Companies and Partnerships Act [Aktengesetz]); authorities and legal persons established under public law, including the combinations formed by them to carry out their public tasks, may also have themselves represented by employees of other authorities or legal persons established under public law, including of the combinations formed by them to carry out their public tasks,

2. adult relatives (section 15 of the Tax Code [Abgabenordnung], section 11 of the Civil Partnerships Act [Lebenspartnerschaftsgesetz]), persons with a qualification for judicial office and joint litigants if the representation is not connected with a remunerated activity. Persons having power of attorney who are not natural persons shall act through their organs and representatives commissioned to represent them in the proceedings.
- (3) The court shall reject persons having power of attorney who are not authorised to act as a representative in accordance with the requirements of subs. 2 by means of an order for which no challenge shall be available. Procedural acts on the part of a representative who does not have the power of attorney, and service on or communications to this proxy, shall be effective until his/she is rejected. The court may prohibit to the proxy designated in subs. 2 sentence 2 by means of an order for which no challenge shall be available any further representation if they are unable to present the facts and circumstances of the dispute sufficiently well.
- (4) Judges may not act as persons having power of attorney before the court to which they belong.
- (5) The power of attorney shall be submitted in writing for the record of the court. It may be submitted subsequently. The Patent Court may set a time limit for this.
- (6) An objection may be raised against the lack of a power of attorney at any stage of the proceedings. The Patent Court shall take the lack of a power of attorney into account proprio motu if no lawyer or patent attorney appears as a person having power of attorney.

Section 81a **Legal aid**

- (1) On request, a party shall be awarded legal aid in the proceedings before the patent court; sections 114 to 116 of the Code of Civil Procedure shall apply mutatis mutandis .
- (2) Section 130 subs. 2 and 3, as well as sections 133 to 137, of the Patent Act shall apply mutatis mutandis in other respects.

Section 82

Application of further provisions, availability of challenge, inspection of files

- (1) Insofar as this Act does not contain any provisions on the proceedings before the Patent Court, the Courts Constitution Act and the Code of Civil Procedure shall be applied mutatis mutandis if the particularities of the proceedings before the Patent Court do not rule this out. Section 227 subs. 3 sentence 1 the Code of Civil Procedure shall not be applied. The Patent Costs Act shall apply to the fees in the proceedings before the Patent Court; the Court Costs Act (Gerichtskostengesetz) shall apply to the expenses mutatis mutandis.
- (2) A challenge of the decisions of the Patent Court shall only be available insofar as this Act thus permits.
- (3) Section 62 subs. 1 and 2 shall be applied mutatis mutandis to the granting of the inspection of files to third persons. The Patent Court shall decide on the application.

Chapter 6 **Proceedings before the Federal Court of Justice**

Section 83

Appeals on points of law admitted and those exempt from admission

- (1) The appeal on points of law to the Federal Court of Justice shall be available against the orders of the Boards of Appeal of the Patent Court by means of which an appeal in accordance with section 66 is decided on if the Board of Appeal has admitted the appeal on points of law in the order. The appeal on points of law shall have the effect of suspending the proceedings.
- (2) The appeal on points of law shall be admitted if
1. a legal issue of fundamental significance is to be decided on, or

2. the further development of the law or the safeguarding of uniform case-law necessitates a decision of the Federal Court of Justice.
- (3) No admission to submit the appeal on points of law shall be required if it is complained
1. that the court handing down the ruling was not constituted in accordance with the regulations,
 2. that a judge participated in the order who was excluded by law from the exercise of judicial office or had been successfully rejected because of concern about partiality,
 3. that a party was denied a legal hearing,
 4. that one of the parties in the proceedings was not represented in accordance with the provision of the law insofar as he/she has not explicitly or tacitly concurred with the conduct of the proceedings,
 5. that the order was handed down on the basis of an oral hearing in which the provisions on the public nature of the proceedings were infringed, or
 6. that the order is not reasoned.

Section 84

Entitlement to lodge an appeal, grounds for appeal

- (1) The parties in the appeal proceedings shall be entitled to file a appeal on points of law.
- (2) The appeal on points of law may only be based on the order being based on a infringement of the right. Sections 546 and 547 the Code of Civil Procedure shall apply mutatis mutandis.

Section 85

Formal prerequisites

- (1) The appeal on points of law shall be submitted to the Federal Court of Justice in writing within one month of service of the order.
- (2) The provisions contained in section 142 on reduction of the value at dispute shall apply mutatis mutandis in the appeal on points of law proceedings before the Federal Court of Justice.
- (3) The appeal on points of law shall be reasoned. The time limit period for the grounds shall be one month. It shall commence on the lodging of the appeal on points of law and may be renewed by the presiding judge on request.
- (4) The grounds of the appeal on points of law must contain the following
 1. the declaration of the degree to which the order is challenged and its amendment or rescission is requested,
 2. the designation of the legal provision that has been infringed, and
 3. if the appeal on points of law is based on the infringement of procedural provisions, the designation of the facts giving rise to the defect.
- (5) The parties must have themselves represented before the Federal Court of Justice as a person having power of attorney by a lawyer who is admitted to the Federal Court of Justice. At the request of a party, his/her patent attorney shall be permitted to speak. Of the costs incurred by the participation of a patent attorney, the fees in accordance with section 13 of the Practising Lawyers' Remuneration Act (Rechts-anwalts-vergütungs-gesetz) and furthermore the necessary expenses of the patent attorney shall be refunded.

Section 86

Examination of admissibility

The Federal Court of Justice shall examine proprio motu whether the appeal on points of law per se is permissible and whether it has been lodged and reasoned in the statutory form and within the time limit. If the prerequisites are not met, the appeal on points of law shall be rejected as inadmissible.

Section 87

Several parties

- (1) If several persons are involved in the proceedings on the appeal on points of law, the written appeal and the grounds for the appeal shall be served on the others concerned, requesting them to make any statements in writing to the Federal Court of Justice within a specific time limit after service. When the written complaint is served, the point in time is to be stated when the appeal on points of law was lodged. The appellant should submit the necessary number of certified copies with the written appeal or the grounds for the appeal.
- (2) If the President of the Patent Office is not involved in the proceedings on the appeal on points of law, section 68 subs. 1 shall be applied mutatis mutandis.

Section 88

Application of further provisions

- (1) The provisions of the Code of Civil Procedure on the exclusion and rejection of court personnel (sections 41 to 49), on persons having power of attorney and counsel (sections 78 to 90), on service proprio motu (sections 166 to 190), on summonses, time limits and periods (sections 214 to 229) and on restitutio in integrum (sections 233 to 238) shall apply mutatis mutandis in the proceedings on the appeal on points of law. Section 91 subs. 8 shall apply mutatis mutandis in the case of restitutio in integrum. On request, a party shall be awarded legal aid; section 138 of the Patent Act shall apply mutatis mutandis.
- (2) Section 67 subs. 2 and 3 shall apply mutatis mutandis to the public nature of the proceedings.

Section 89

Decision on the appeal on points of law

- (1) The decision on the appeal on points of law shall be handed down by means of an order. The decision may be taken without an oral hearing.
- (2) The Federal Court of Justice shall be bound in its decision by facts established in the challenged order unless admissible, reasoned grounds for appeal on points of law are submitted in relation to these facts.
- (3) The decision shall be reasoned and served on the parties proprio motu.
- (4) In the case of the rescission of the challenged order, the case shall be referred back to the Patent Court for a further hearing and decision. The Patent Court shall also base its decision on the legal evaluation on which the rescission is based.

Section 89a

Remedy in case of an infringement of the right to a legal hearing

In response to the complaint by the party aggrieved by the decision, the proceedings shall be continued if the court has infringed the right of this party to a legal hearing in a manner that is material to the ruling. No complaint shall be available against a decision preceding the final ruling. Section 321a subs. 2 to 5 of the Code of Civil Procedure shall be applied mutatis mutandis.

Section 90

Ruling on costs

- (1) If several persons are involved in a set of proceedings, the Federal Court of Justice may determine that the costs of the proceedings, including the costs incurred by the parties, insofar as they were necessary for appropriately safeguarding the claims and rights, are imposed on a party fully or in part if this is equitable. Such a determination may also be handed down if the party fully or in part withdraws the appeal on points of law, the application for the trade mark, the opposition or the application for cancellation, or if the

registration of the trade mark is fully or partly cancelled in the register because of surrender or because of non-renewal of the duration of protection. Insofar as a determination on the costs is not handed down, each party shall bear the costs incurred by him/her him/herself.

(2) If the appeal on points of law is refused or dismissed as inadmissible, the costs caused by the appeal on points of law shall be imposed on the appellant. If a party has caused costs by means of gross negligence, these shall be imposed on him/her.

(3) Costs may only be imposed on the President of the Patent Office if he/she has submitted the appeal on points of law or made applications in the proceedings.

(4) The provisions of the Code of Civil Procedure on the cost determination proceedings (sections 103 to 107) and levy of execution of cost determination orders (sections 724 to 802) shall apply mutatis mutandis in other respects.

Chapter 7

Joint provisions

Section 91

Re-establishment of rights

(1) A party who through no fault of its own was unable to observe a time limit vis-à-vis the Patent Office or the Patent Court the missing of which provision entails a legal disadvantage in accordance with a statutory, shall have his/her rights re-established. This shall not apply to the time limit to lodge the opposition and to pay the opposition fee (section 6 subs. 1 sentence 1 of the Patent Costs Act).

(2) The application for the re-establishment of rights must be filed within two months from the removal of the cause of non-compliance.

(3) The application must contain a statement of the facts giving rise to the re-establishment of rights. These facts shall be made plausible on lodging the application or in the proceedings on the application.

(4) The omitted act shall be subsequently carried out within the application time limit. If this has taken place, re-establishment of rights may also be granted without an application.

(5) One year after expiry of the missed time limit, the re-establishment of rights may no longer be applied for and the omitted act may no longer be subsequently carried out.

(6) The department competent to decide on the subsequently completed act shall decide upon the application.

(7) The re-establishment of rights shall not be appealable.

(8) Where the proprietor of a trade mark has his/her rights re-established, he/she may not invoke rights with regard to these acts vis-à-vis third parties who, in good faith, have put goods on the market or supplied services under a sign identical with or similar to the trade mark in the course of the period between the loss of the right in the application or to the trade mark and the re-establishment of rights.

Section 91a

Further treatment of the application

(1) If the trade mark application has been refused after missing a time limit set by the Patent Office, the order shall become ineffective without its explicit rescission being required if the applicant applies for the further processing of the application and subsequently carries out the omitted act.

(2) The application shall be lodged within a period of one month after service of the decision on the refusal of the trade mark application. The omitted act shall be subsequently carried out within this period.

(3) There shall be no re-establishment of rights available against the missing of the time limit in accordance with subs. 2 and the time limit to pay the further processing fee in accordance with section 6 subs. 1 sentence 1 of the Patent Costs Act.

(4) The application shall be ruled on by the agency which has to rule on the act subsequently carried out.

Section 92
Obligation to tell the truth

In the proceedings before the Patent Office, the Patent Court and the Federal Court of Justice, the parties shall submit their statements regarding factual circumstances fully and truthfully.

Section 93
Official language and court language

The language before the Patent Office and before the Patent Court shall be German. The provisions of the Courts Constitution Act on the court language shall apply in other respects.

Section 93a
Compensation of witnesses, remuneration of expert witnesses

Witnesses shall receive compensation and expert witnesses shall receive remuneration in accordance with the Justice Remuneration and Compensation Act (Justizvergütungs- und -entschädigungsgesetz).

Section 94
Service

(1) The provisions contained in the Act on the Administrative Service of Documents (Verwaltungs-zustellungs-gesetz) shall apply to service in the proceedings before the Patent Office subject to the following provisos:

1. Service may be carried out by registered letter by sending by post to recipients who are abroad and who, in contravention of the requirement of section 96, have not appointed a domestic representative. The same shall apply mutatis mutandis to recipients who themselves are a domestic representative within the meaning of section 96 subs. 2. Section 184 subs. 2 sentences 1 and 4 the Code of Civil Procedure shall apply mutatis mutandis.
2. Section 5 subs. 4 of the Act on the Administrative Service of Documents shall be applied mutatis mutandis to service to licence-holders (section 177 of the Patent Attorneys Regulations [Patentanwaltsordnung]).
3. Documents may also be served on recipients for whom a mail box has been established at the Patent Office by the document being deposited in the recipient's mail box. A written record shall be included in the files regarding such deposit. It shall be noted on the document when it was deposited. The service shall be deemed to have been carried out on the third day after deposit in the mail box.

(2) The provisions of the Code of Civil Procedure shall apply to service in the proceedings before the Federal Patent Court.

Section 95
Mutual assistance

- (1) The courts shall be obliged to render mutual assistance to the Patent Office.
- (2) In the proceedings before the Patent Office, the Patent Court shall, at the request of the Patent Office, determine measures to maintain public order or means of coercion against witnesses or expert witnesses who fail to appear or refuse to testify or to be placed under oath. Equally, a witness who failed to appear shall be ordered to be brought before the court.
- (3) With regard to the request in accordance with subs. 2, a Board of Appeal of the Patent Court composed of three members versed in the law shall decide. The decision shall be handed down by an order.

Section 95a
Electronic proceedings, empowerment to hand down an order

(1) Insofar as the written form is provided in proceedings before the Patent Office for applications, motions or other acts, the provisions contained in section 130a subs. 1

sentences 1 and 3, as well as in subs. 3, of the Code of Civil Procedure shall apply mutatis mutandis.

(2) The files of the proceedings of the Patent Court and of the Federal Court of Justice may be kept in electronic form. The provisions of the Code of Civil Procedure on electronic documents, the electronic file and the further conduct of electronic proceedings shall apply mutatis mutandis unless this Act provides otherwise.

(3) The Federal Ministry of Justice shall determine by means of a legal ordinance without the consent of the Federal Council

1. the point in time from when electronic documents may be submitted to the Patent Office and to the courts, the form liable for processing the documents, whether an electronic signature is to be used and what form such signature is to take;

2. the point in time from when the files of the proceedings may be kept in electronic form in accordance with subs. 2, as well as the organisational and technical conditions applicable thereto for the creation, keeping and storage of the electronic files of the proceedings.

Section 96 Domestic representative

(1) Anyone who has neither a place of residence, a seat of business nor a branch office in this country may only participate in proceedings before the Patent Office or the Patent Court regulated by this Act and assert the rights from a trade mark if he/she has appointed in this country a lawyer or patent attorney as a representative who has power of attorney to represent them in the proceedings before the Patent Office, before the Patent Court and in civil disputes relating to this trade mark, as well as to file criminal complaints.

(2) Nationals of a Member State of the European Union or of another Contracting Party to the Agreement on the European Economic Area may be appointed to provide a service within the meaning of the Treaty establishing the European Economic Community as a representative within the meaning of subs. 1 if they are entitled to exercise their professional activities under one of the occupational titles listed in the Annex to section 1 of the Act on the Activities of European Lawyers in Germany (Gesetz über die Tätigkeit europäischer Rechtsanwälte in Deutschland) of 9 March 2000 (Federal Law Gazette Part I p. 182) or to section 1 of the Act on the Qualifying Examination for Admission to Practise as a Patent Attorney (Gesetz über die Eignungsprüfung für die Zulassung zur Patentanwaltschaft) of 6 July 1990 (Federal Law Gazette Part I pp. 1349 and 1351) in their respectively valid versions.

(3) The place at which a representative who has been appointed in accordance with subs. 1 has his/her business premises shall be deemed within the meaning of section 23 of the Code of Civil Procedure to be the place at which the asset is located. If there are no such business premises, the place shall be relevant at which the representative has his/her place of residence in this country, and if there is no such place, the place at which the Patent Office has its seat of business.

(4) The termination of the commissioning of a representative in accordance with subs. 1 in terms of a legal transaction shall not become effective until both this termination and the commissioning of another representative is notified to the Patent Office or to the Patent Court.

Section 96a Legal protection in case of excessively long court proceedings

The provisions of the Seventeenth Title of the Courts Constitution Act (Gerichtsverfassungsgesetz) shall be applied mutatis mutandis to proceedings before the Patent Court and the Federal Court of Justice.

Part 4 Collective marks

Section 97 Collective marks

(1) All signs eligible for protection as a trade mark within the meaning of section 3 may be registered as collective marks if they are liable to distinguish the goods or services of the members of the proprietor of the collective mark from those of other enterprises in terms of their origin from a given enterprise or their geographical origin, their nature, quality or other properties.

(2) The provisions of this Act shall be applied to collective marks unless otherwise provided in this Part.

Section 98 Proprietorship

The proprietor of collective marks that have been filed or registered can only be associations with legal capacity, including the umbrella associations and central associations with legal capacity whose members themselves are associations. Legal persons established under public law shall be deemed to be equivalent to these associations.

Section 99 Eligibility for registration of indications of geographical origin as collective marks

In derogation from section 8 subs. 2 No. 2, collective marks may consist exclusively of signs or indications which in the course of trade may serve as a designation of the geographical origin of the goods or services.

Section 100 Restrictions of protection, use

(1) In addition to the restrictions of protection emerging from section 23, the registration of an indication of geographical origin as a collective mark shall not provide for the proprietor the right to prohibit a third party from using such indications in the course of trade insofar as the use corresponds to the accepted principles of morality and does not contravene section 127.

(2) The use of a collective mark by at least one person empowered to do so, or by the proprietor of the collective mark, shall be deemed to constitute use within the meaning of section 26.

Section 101 Empowerment to act, compensation

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

(2) The proprietor of the collective mark may also demand compensation for the damage which was incurred by the persons entitled to use the collective mark from the unauthorised use of the collective mark or of a similar sign.

Section 102 Regulations governing use of the mark

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

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

1. the name and seat of business of the association,
2. the purpose and representation of the association,
3. prerequisites for membership,
4. indications regarding the group of persons entitled to use the collective mark,
5. the prerequisites for the use of the collective mark, and

6. indications regarding the rights and obligations of the parties in the case of infringements of the collective mark.

(3) If the collective mark consists of an indication of geographical origin, the regulations must provide that any person whose goods or services originate from the corresponding geographical territory and comply with the conditions contained in the regulations governing use of the mark for the use of the collective mark may become a member of the association and is to be included in the group of persons entitled to use the collective mark.

(4) The inspection of the regulations governing use of the mark shall be open to everyone.

Section 103

Examination of the application

The application for a collective mark shall also be refused, in addition to cases falling under section 37, if it does not comply with the prerequisites of 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 governing use of the mark such that the ground for refusal no longer exists.

Section 104

Amendment of the regulations governing use of the mark

(1) The proprietor of the collective mark shall inform the Patent Office of all and any amendments to the regulations governing use of the mark.

(2) Sections 102 and 103 shall be applied mutatis mutandis in the case of an amendment to the regulations governing use of the mark.

Section 105

Revocation

(1) The registration of a collective mark shall be cancelled for revocation on request in addition to for the grounds for revocation listed in section 49

1. if the proprietor of the collective mark no longer exists,

2. if the proprietor of the collective mark does not take any suitable measures to prevent the collective mark being used abusively in a manner contrary to the purposes 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 contravention of section 104 subs. 2, unless the proprietor of the collective mark once more amends the regulations governing use of the mark such that the ground for cancellation no longer exists.

(2) Abusive use within the meaning of subs. 1 No. 2 shall in particular be considered to have been committed if the use of the collective mark by persons other than those entitled to use is liable to mislead the public.

(3) The application for cancellation in accordance with subs. 1 shall be made to the Patent Office. The proceedings shall be in accordance with section 54.

Section 106

Invalidity because of absolute obstacles to protection

The registration of a collective mark shall be cancelled on request, in addition to for the grounds for invalidity listed in section 50, because of invalidity if it has been registered in contravention of section 103. If the ground for invalidity relates to the regulations governing use of the mark, the registration shall not be cancelled if the proprietor of the collective mark amends the regulations governing use of the mark such that the ground for invalidity no longer exists.

Part 5

Protection of trade marks in accordance with the Madrid Agreement on Marks and in

**accordance with the Protocol Relating to the Madrid Agreement Concerning the
International Registration of Marks, Community trade marks**

Chapter 1

Protection of trade marks in accordance with the Madrid Agreement on Marks

Section 107

Application of the provisions of this Act; language

(1) The provisions of this Act shall be applied mutatis mutandis to the international registration of trade marks in accordance with the Madrid Agreement Concerning the International Registration of Marks (Madrid Agreement on Marks) carried out through the intermediary of the Patent Office or whose protection covers the territory of the Federal Republic of Germany unless provided otherwise in this Chapter or in the Madrid Agreement on Marks.

(2) All and any applications, as well as other communications in the proceedings for international registration and the list of goods and services, shall be submitted in either French or English, at the choice of the applicant.

Section 108

Application for international registration

(1) The application for international registration of a trade mark entered in the register in accordance with Article 3 of the Madrid Agreement on Marks shall be made with the Patent Office.

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

(3) With the application, the list of goods and services, broken down into classes, shall be submitted in the order of the international classification of goods and services.

Section 109

Fees

(1) If the application for international registration has been lodged prior to the entry of the trade mark in the register, the national fee for the proceedings for international registration shall be due on the date of the registration.

(2) The national fee in accordance with the Patent Costs Act for the international registration shall be payable within one month after the due date, which shall be governed by section 3 subs. 1 of the Patent Costs Act or in accordance with subs. 1.

Section 110

Entry in the register

The date and the number of the international registration of a trade mark entered in the register shall be entered in the register.

Section 111

Subsequent territorial extension of protection

(1) An application may be lodged with the Patent Office for subsequent territorial extension of protection of an internationally-registered trade mark in accordance with Article 3ter para. 2 of the Madrid Agreement on Marks.

(2) The national fee in accordance with the Patent Costs Act for the subsequent territorial extension shall be payable within one month of its becoming due (section 3 subs. 1 of the Patent Costs Act).

Section 112

Effect of international registration

(1) The international registration of a trade mark whose protection in accordance with Article 3ter of the Madrid Agreement on Marks has been extended to the territory of the Federal Republic of Germany shall have the same effect as if the trade mark had been filed and

registered on the date of the international registration in accordance with Article 3 para. 4 of the Madrid Agreement on Marks or on the date of the registration of subsequent territorial extension in accordance with Article 3ter para. 2 of the Madrid Agreement on Marks for entry in the register kept by the Patent Office.

(2) The effect designated in subs. 1 shall be deemed not to have accrued if the internationally-registered trade mark is refused protection in accordance with sections 113 to 115.

Section 113

Examination for absolute obstacles to protection

(1) Internationally-registered trade marks shall be examined for absolute obstacles to protection in the same way as trade marks whose entry in the register has been applied for in accordance with section 37. Section 37 subs. 2 shall not be applied.

(2) Refusal of protection shall take the place of the refusal of the application (section 37 subs. 1).

Section 114

Opposition

(1) The publication of the registration (section 41) for internationally-registered trade marks shall be substituted by publication in the Information Notice published by the International Bureau of the World Intellectual Property Organisation.

(2) The time limit to lodge the opposition (section 42 subs. 1) against the granting of protection for internationally-registered trade marks shall commence on the first day of the month following the month stated as the issue month of the edition of the Information Notice containing the publication of the internationally-registered trade mark.

(3) Refusal of protection shall take the place of the cancellation of the registration (section 43 subs. 2).

Section 115

Subsequent withdrawal of protection

(1) For internationally-registered trade marks, the application or the action for withdrawal of protection shall take the place of the application or the action for cancellation of a trade mark for revocation (section 49), because of the existence of absolute obstacles to protection (section 50) or because of an earlier right (section 51).

(2) If an application for withdrawal of protection in accordance with section 49 subs. 1 is made for lack of use, the date of the entry in the register shall be substituted by the date

1. on which the communication regarding approval of protection was received by the International Bureau of the World Intellectual Property Organisation, or
2. on which the time limit contained in Article 5 para. 2 of the Madrid Agreement on Marks expired if at that time neither the communication in accordance with No. 1 nor a communication on provisional refusal of protection has been received..

Section 116

Opposition and application for cancellation because of an internationally-registered trade mark

(1) If an opposition has been lodged against the registration of a trade mark because of an internationally-registered trade mark, section 43 subs. 1 shall be applied on the proviso that the date of the registration is substituted by the date referred to in section 115 subs. 2.

(2) If an action for cancellation of a registered trade mark is lodged in accordance with section 51 because of an internationally-registered trade mark, section 55 subs. 3 shall be applied on the proviso that the date of the registration is substituted by the date referred to in section 115 subs. 2.

Section 117

Exclusion of rights for lack of use

If rights within the meaning of sections 14 and 18 to 19c are asserted because of the infringement of an internationally-registered trade mark, section 25 shall be applied on the proviso that the date of registration of the trade mark shall be substituted by the date referred to in section 115 subs. 2.

Section 118

Consent to transfers of internationally-registered trade marks

The Patent Office shall give to the International Bureau of the World Intellectual Property Organisation the consent required in accordance with Article 9bis para. 1 of the Madrid Agreement on Marks in the case of the transfer of an internationally-registered trade mark, regardless of whether the trade mark has been registered for the new proprietor of the internationally-registered trade mark in the register kept by the Patent Office.

Chapter 2

Protection of trade marks in accordance with the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

Section 119

Application of the provisions of this Act; languages

(1) The provisions of this Act shall be applied mutatis mutandis to international registrations of trade marks in accordance with the Madrid Protocol of 27 June 1989 Relating to the Madrid Agreement Concerning the International Registration of Marks (Protocol Relating to the Madrid Agreement on Marks) which are carried out through the intermediary of the Patent Office or whose protection covers the territory of the Federal Republic of Germany, unless provided otherwise in this Chapter or in the Protocol Relating to the Madrid Agreement on Marks.

(2) All and any applications, as well as other communications in the proceedings of the international registration, and the list of goods and services, shall be submitted in French or English, at the option of the applicant.

Section 120

Application for international registration

(1) The application for the international registration of a trade mark for which an application has been made for it to be entered in the register or of a trade mark which is already entered in the register in accordance with Article 3 of the Protocol Relating to the Madrid Agreement on Marks shall be lodged with the Patent Office. The application may also already be lodged prior to the registration of the trade mark if the international registration is to be carried out based on a trade mark entered in the register.

(2) If the international registration is to be carried out on the basis of a trade mark that has been entered in the register, and if the application for international registration is lodged prior to the entry of the trade mark in the register, it shall be deemed to have been received on the date of the registration of the trade mark.

(3) The list of goods and services shall be submitted with the application, broken down into classes, shall be submitted in the order of the international classification of goods and services.

Section 121

Fees

(1) If the international registration is to be carried out in accordance with the Madrid Agreement on Marks and in accordance with the Protocol Relating to the Madrid Agreement on Marks on the basis of a trade mark registered in the register, and if the application for international registration has been lodged prior to the entry of the trade mark in the register, the national fee in accordance with the Patent Costs Act for the international registration shall become due on the date of registration.

(2) The national fee in accordance with the Patent Costs Act for the international registration shall be payable within one month after it becomes due, this date being determined in accordance with section 3 subs. 1 of the Patent Costs Act or in accordance with subs. 1.

Section 122

Note in the files, entry in the register

(1) If the international registration has been carried out on the basis of a trade mark for which an application has been made for entry in the register, the date and the number of the international registration shall be noted in the files of the trade mark applied for.

(2) The date and the number of the international registration which has been carried out on the basis of a trade mark that has been entered in the register shall be entered in the register. Sentence 1 shall also be applied if the international registration was carried out on the basis of a trade mark for which an application has been made to be entered in the register and the application for registration has been carried out.

Section 123

Subsequent territorial extension of protection

(1) The application for subsequent extension of protection of an internationally-registered trade mark in accordance with Article 3ter para. 2 of the Protocol Relating to the Madrid Agreement on Marks may be lodged with the Patent Office. If the subsequent extension of protection is to be carried out on the basis of a trade mark registered in the register, and if the application is already lodged prior to the registration of the trade mark, it shall be deemed to have been received on the date of registration.

(2) Subsequent extension of protection on the basis of a trade mark entered in the register may be carried out both in accordance with the Madrid Agreement on Marks and in accordance with the Protocol Relating to the Madrid Agreement on Marks.

(3) The national fee in accordance with the Patent Costs Act for the subsequent extension of protection shall be payable within one month after becoming due (section 3 subs. 1 of the Patent Costs Act).

Section 124

Application, mutatis mutandis, of the provisions on the effect of trade marks internationally-registered in accordance with the Madrid Agreement on Marks

Sections 112 to 117 shall be applied mutatis mutandis to internationally-registered trade marks whose protection has been extended to the territory of the Federal Republic of Germany in accordance with Article 3ter of the Protocol Relating to the Madrid Agreement on Marks on the proviso that the provisions of the Madrid Agreement on Marks listed in sections 112 to 117 shall be substituted by the corresponding provisions of the Protocol Relating to the Madrid Agreement on Marks.

Section 125

Conversion of an international registration

(1) If an application is lodged with the Patent Office in accordance with Article 9quinquies of the Protocol Relating to the Madrid Agreement on Marks for conversion of a trade mark that has been cancelled in the international register in accordance with Article 6 para. 4 of the Protocol Relating to the Madrid Agreement on Marks, and if the application is received by the Patent Office with the necessary indications prior to expiry of a three-month time limit after the date of the cancellation of the trade mark in the international register, the date of the international registration of this trade mark in accordance with Article 3 para. 4 of the Protocol Relating to the Madrid Agreement on Marks or the date of the registration of the extension of protection in accordance with Article 3ter para. 2 of the Protocol Relating to the Madrid Agreement on Marks, where appropriate with the priority claimed for the international registration, shall be material for the determination of seniority within the meaning of section 6 subs. 2.

(2) The applicant shall submit a certificate from the International Bureau of the World Intellectual Property Organisation designating the trade mark and the goods or services for which the protection of the international registration extended to the Federal Republic of Germany prior to its cancellation in the international register.

(3) The applicant shall furthermore submit a German translation of the list of goods or services for which the registration is requested.

(4) The application for conversion shall in other respects be treated in the same way as an application to register a trade mark. If however on the date of the cancellation of the trade mark in the international register the time limit in accordance with Article 5 para. 2 of the Protocol Relating to the Madrid Agreement on Marks to refuse protection had already expired, and if no proceedings were pending on this day to refuse protection or for subsequent withdrawal of protection, the trade mark shall be directly entered in the register in accordance with section 41 with no prior examination. No opposition may be lodged against the registration of a trade mark in accordance with sentence 2.

Chapter 3 Community trade marks

Section 125a

Filing of Community trade marks with the Patent Office

If applications are lodged with the Patent Office for Community trade marks in accordance with Article 25 para. 1 (b) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (codification) (OJ EC No. L 78 of 24 March 2009, p. 1), the Patent Office shall note the date of receipt on the application, and shall forward the application without examination promptly to the Office for Harmonization in the Internal Market (trade marks and designs).

Section 125b

Application of the provisions of this Act

The provisions of this Act shall be applied to trade marks which have been filed or registered in accordance with the Regulation on the Community trade mark in the following cases:

1. For the application of section 9 (relative obstacles to protection), Community trade marks filed or registered with older seniority shall be deemed equivalent to the trade marks filed or registered in accordance with this Act with older seniority, but on the proviso that having a reputation in this country in accordance with section 9 subs. 1 No. 3 shall be replaced with having a reputation in the Community in accordance with Article 9 para. 1 sentence 2 (c) of the Regulation on the Community trade mark.
2. In addition to the rights in accordance with Articles 9 to 11 of the Regulation on the Community trade mark, the proprietor of a registered Community trade mark shall be entitled to the same rights to compensation (section 14 subs. 6 and 7), destruction and re-call (section 18), information (section 19), submission and inspection (section 19a), securing of compensation claims (section 19b) and announcement of judgments (section 19c) as the proprietor of a trade mark registered in accordance with this Act.
3. If rights from a registered Community trade mark are asserted against the use of a trade mark registered in accordance with this Act with younger seniority, section 21 subs. 1 (forfeiting) shall be applied *mutatis mutandis*.
4. If an opposition to the registration of a trade mark (section 42) is based on a registered Community trade mark with older seniority, section 43 subs. 1 (making a plausible case for use) shall be applied *mutatis mutandis* on the proviso that the use of the trade mark with older seniority in accordance with section 26 shall be substituted by the use of the Community trade mark with older seniority in accordance with Article 15 of the Regulation on the Community trade mark.

5. If an application to cancel the registration of a trade mark (section 51 subs. 1) is based on a registered Community trade mark with older seniority,

a) section 51 subs. 2 sentence 1 (forfeiting) shall be applied mutatis mutandis;

b) section 55 subs. 3 (documentation of use) shall be applied mutatis mutandis on the proviso that the use of the trade mark with older seniority in accordance with section 26 shall be substituted by the use of the Community trade mark in accordance with Article 15 of the Regulation on the Community trade mark.

6. Applications for seizure on import and export may be lodged by proprietors of registered Community trade marks in the same manner as by proprietors of trade marks registered in accordance with this Act. Sections 146 to 149 shall be applied mutatis mutandis.

Section 125c

Subsequent determination of the invalidity of a trade mark

(1) If the seniority of a trade mark that has been entered in the register of the Patent Office has been claimed for a Community trade mark which has been filed or registered in accordance with Article 34 or 35 of the Regulation on the Community trade mark, and if the trade mark that has been entered in the register of the Patent Office has been cancelled for non-renewal of the duration of protection in accordance with section 47 subs. 6 or because of surrender in accordance with section 48 subs. 1, on request the invalidity of this trade mark may be subsequently found for revocation or because of invalidity.

(2) The finding of invalidity shall take place subject to the same prerequisites as cancellation for revocation or because of invalidity. However, the invalidity of a trade mark for revocation in accordance with section 49 subs. 1 may only be found if the prerequisites for cancellation in accordance with this provision also already applied at the time when the trade mark was cancelled because of non-renewal of the duration of protection or because of surrender.

(3) The proceedings for a finding of invalidity shall be in accordance with the provisions applicable to the proceedings for the cancellation of a registered trade mark, on the proviso that the cancellation of the registration of the trade mark shall be substituted by the finding of its invalidity.

Section 125d

Conversion of Community trade marks

(1) If an application for conversion of a Community trade mark applied for or registered has been transmitted to the Patent Office in accordance with Article 109 para. 3 of the Regulation on the Community trade mark, the fee and the class fees in accordance with the Patent Costs Act for the conversion proceedings shall become due on receipt of the application for conversion by the Patent Office.

(2) If the conversion application relates to a trade mark which was not yet registered as a Community trade mark, the conversion application shall be treated in the same way as the application for entry of a trade mark in the register of the Patent Office, on the proviso that the date of application within the meaning of section 33 subs. 1 shall be replaced by the date of application of the Community trade mark within the meaning of Article 27 of the Regulation on the Community trade mark or the date of a priority claimed for the Community trade mark. If the seniority of a trade mark which has been entered in the register of the Patent Office had been claimed for the application for the Community trade mark in accordance with Article 34 of the Regulation on the Community trade mark, this seniority shall substitute the date that is relevant in accordance with sentence 1.

(3) If the conversion application relates to a trade mark which was already registered as a Community trade mark, the Patent Office shall directly enter the trade mark in the register with no further examination in accordance with section 41, retaining its original seniority. No opposition may be lodged against the registration.

(4) The provisions of this Act for the application of trade marks shall be applied to conversion applications in other respects.

Section 125e

Community trade mark courts, Community trade mark disputes

(1) For all actions for which in accordance with the Regulation on the Community trade mark the Community trade mark courts have jurisdiction within the meaning of Article 91 para. 1 of the Regulation (Community trade mark disputes), the Regional Courts shall have exclusive jurisdiction as Community trade mark courts of first instance, regardless of the value at dispute.

(2) The Community trade mark court of second instance shall be the Higher Regional Court in whose district the Community trade mark court of first instance has its seat of business.

(3) The Land governments shall be empowered to assign by means of a legal ordinance the Community trade mark disputes for the districts of several Community trade mark courts to one of these courts. The Land governments may transfer this empowerment to the Land administrations of justice by means of a legal ordinance.

(4) The Länder may also transfer by agreement tasks incumbent on the Community trade mark courts of one Land fully or in part to the Community trade mark court which has jurisdiction in another Land.

(5) Section 140 subs. 3 and section 142 shall be applied mutatis mutandis to proceedings before the Community trade mark courts.

Section 125f

Notification of the Commission

The Federal Ministry of Justice shall communicate to the Commission of the European Communities the Community trade mark courts of first and second instance, as well as each and every alteration to the number, designation or territorial jurisdiction of the Community trade mark courts of first and second instance.

Section 125g

Territorial jurisdiction of the Community trade mark courts

If German Community trade mark courts have international jurisdiction in accordance with Article 93 of the Regulation on the Community trade mark, the provisions shall apply mutatis mutandis to the territorial jurisdiction of these courts which would be applied if it was an application for a trade mark submitted to the Patent Office or a trade mark entered in the register of the Patent Office. If this does not give rise to jurisdiction, the court at which the plaintiff has his/her court venue shall have territorial jurisdiction.

Section 125h

Insolvency proceedings

(1) If the insolvency court is aware that a Community trade mark applied for or registered is part of the insolvency estate, it shall request the Office for Harmonization in the Internal Market (trade marks and designs) in the direct course of trade to register

1. the opening of the proceedings and, unless already contained therein, the order of a restriction on property transfers,
2. the release or the sale of the Community trade mark or of the application for the Community trade mark,
3. the final discontinuation of the proceedings, and
4. the stay on the proceedings, in the case of the supervision of the debtor however only after termination of this supervision, and of a restriction on property transfers

in the register for Community trade marks or, if it is an application, in the files of the application.

(2) The entry in the register for Community trade marks or in the files of the application may also be applied for by the insolvency administrator. In the case of personal management (section 270 of the Insolvency Statute), the custodian shall take the place of the insolvency administrator.

Section 125i

Issuance of the enforcement clause

The Patent Court shall have jurisdiction for the issuance of the enforcement clause in accordance with Article 82 para. 2 sentence 2 of the Regulation on the Community trade mark. The enforceable copy shall be issued by the registrar of the registry of the Patent Court.

Part 6

Indications of geographical origin

Chapter 1

Protection of indications of geographical origin

Section 126

Names, indications or signs protected as indications of geographical origin

(1) Indications of geographical origin within the meaning of this Act shall be the names of places, areas, territories or countries, as well as other indications or signs which are used in the course of trade to identify the geographical origin of goods or services.

(2) Names, indications or signs within the meaning of subs. 1 which are generic names shall not be eligible for protection as indications of geographical origin. Designations shall be regarded as generic names which contain an indication of the geographical origin within the meaning of subs. 1 or are derived from such an indication, but which have lost their original significance and serve as the name of goods or services or as designations or indications of the nature, quality, variety or other properties or characteristics of goods or services.

Section 127

Scope of protection

(1) Indications of geographical origin may not be used in the course of trade for goods or services which do not originate from the place, area, territory or country which is designated by the indication of geographical origin if it is likely to mislead concerning the geographical origin should such names, indications or signs for goods or services of different origin be used.

(2) If the goods or services marked by an indication of geographical origin have special properties or a special quality, the indication of geographical origin may only be used in the course of trade for the corresponding goods or services of this origin if the goods or services have these properties or this quality.

(3) If an indication of geographical origin enjoys a particular reputation, it may not be used in the course of trade for goods or services of a different origin even if it is not likely to mislead concerning the geographical origin if use provides without good cause an opportunity for goods or services of a different origin to take unfair advantage of, or be detrimental to, the reputation of the indication of geographical origin or its distinctive character.

(4) The above subsections shall also apply if names, indications or signs are used which are similar to the protected indication of geographical origin or if the indication of geographical origin is used with additions insofar as

1. in cases falling under subs. 1, despite the deviation or the additions, it is likely to mislead concerning the geographical origin, or

2. in cases falling under subs. 3, despite the deviation or the additions, it is suitable to take unfair advantage of, or be detrimental to, the reputation or the distinctive character of the indication of geographical origin.

Section 128

Rights because of infringement

(1) Anyone who in the course of trade uses names, indications or signs in contravention of section 127 may be claimed against by persons with an entitlement in accordance with section 8 subs. 3 of the Act Against Unfair Competition to claim rights for an injunction if there is a danger of recurrence. The right shall also exist if a contravention is threatened. Sections 18, 19, 19a and 19c shall apply mutatis mutandis.

(2) Anyone intentionally or negligently acting in contravention of section 127 shall be liable to pay compensation to the entitled party of the indication of geographical origin for the damage incurred by virtue of the contravention. The profit which the infringer made by virtue of the infringement of the right may also be taken into consideration when assessing the compensation. Section 19b shall apply mutatis mutandis.

(3) Section 14 subs. 7 and section 19d shall apply mutatis mutandis.

Section 129

Lapse

Rights in accordance with section 128 shall lapse in accordance with section 20.

Chapter 2 Protection of geographical indications and designations of origin in accordance with Regulation (EC) No. 510/2006

Section 130

Proceedings before the Patent Office; objection against the application

(1) Applications for the registration of a geographical indication or of a designation of origin in the register of protected designations of origin and of protected geographical indications which is maintained by the Commission of the European Communities in accordance with Article 7 para. 6 of Council Regulation (EC) No. 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ EU No. L 93 p. 12) in its respectively applicable version, shall be submitted to the Patent Office.

(2) The trade mark divisions established in the Patent Office shall have competence for the proceedings as regulated in this Chapter.

(3) When examining the application, the Patent Office shall ask for the opinions of the Federal Ministry of Food, Agriculture and Consumer Protection, of the competent specialist ministries of the Länder in question, of the interested public corporations, as well as those of the interested associations and industry organisations.

(4) The Patent Office shall publish the application in the Trade Mark Journal. An objection may be lodged with the Patent Office against the application within two months of publication in the Trade Mark Journal by any person with a legitimate interest who is based or resides in the territory of the Federal Republic of Germany.

(5) If the application meets the prerequisites of Regulation (EC) No. 510/2006 and complies with the provisions issued in its transposition, the Patent Office shall find this by order. Otherwise, the application shall be refused by order. The Patent Office shall publish the favourable decision in the Trade Mark Journal. Should there be major alterations to the indications published in accordance with subs. 4, these shall be published in the Trade Mark Journal together with the granting order. The order in accordance with sentence 1 and in accordance with sentence 2 shall be served on the applicant and on those who lodged objections by the time limit.

(6) If it is found with legal force that the application complies with the prerequisites of Regulation (EC) No. 510/2006 and of the provisions issued in its transposition, the Patent Office shall inform the applicant hereof and shall transmit the application to the Federal Ministry of Justice with the necessary documents. Further, the Patent Office shall publish in

the Trade Mark Journal the version of the specification to which the positive decision refers. The Federal Ministry of Justice shall transmit the application to the Commission of the European Communities with the necessary documents.

Section 131

Objection against the intended registration

(1) Objections in accordance with Article 7 para. 2 of Regulation (EC) No. 510/2006 against the intended entry of geographical indications or designations of origin in the register kept by the Commission of the European Communities of the protected designations of origin and of the protected geographical indications shall be lodged with the Patent Office within two months of publication, which is carried out in the Official Journal of the European Communities in accordance with Article 6 para. 2 of Regulation (EC) No. 510/2006.

(2) The payment time limit for the objection fee shall be determined in accordance with section 6 subs. 1 sentence 1 of the Patent Costs Act. There shall be no re-establishment of rights of the objection time limit, or of the time limit for payment of the objection fee.

Section 132

Application for a change to the specification, cancellation proceedings

(1) Sections 130 and 131 shall apply mutatis mutandis to applications to change the specification of a protected geographical indication or of a protected designation of origin in accordance with Article 9 para. 2 sentence 1 of Regulation (EC) No. 510/2006. No fee shall be payable.

(2) Sections 130 and 131 shall apply mutatis mutandis to applications for the cancellation of a protected geographical indication or of a protected designation of origin in accordance with Article 12 para. 2 of Regulation (EC) No. 510/2006.

Section 133

Appeals

The appeal to the Federal Patent Court and the appeal on points of law to the Federal Court of Justice shall be available against decisions taken by the Patent Office in accordance with the provisions contained in this Chapter. Those persons who have lodged an objection against the application in good time or whose legitimate interest is affected by the granting order on the basis of the altered indications published in accordance with section 130 subs. 5 sentence 4 shall be entitled to lodge an appeal against a decision in accordance with section 130 subs. 5 sentence 1. The provisions contained in this Act on the appeal proceedings before the Federal Patent Court (sections 66 to 82) and on the appeal on points of law proceedings before the Federal Court of Justice (sections 83 to 90) shall be applied mutatis mutandis in other respects.

Section 134

Supervision

(1) The supervision, monitoring and controls required in accordance with Regulation (EC) No. 510/2006, and the provisions issued to transpose them, shall be incumbent on the agencies competent in accordance with Land law.

(2) Insofar as is necessary for supervision and verification within the meaning of subs. 1, the commissioners of the competent agencies may with operations marketing or producing agricultural products or foodstuffs (section 3 Nos. 1 and 2 of the Foodstuffs and Fodder Code [Lebensmittel- und Futtermittelgesetzbuch]) or transferring, importing or exporting them within the EU, during opening or operating hours

1. enter business premises and land, sales facilities and means of transport and carry out inspections there,
2. take samples in return for a receipt; at the request of the party, a part of the sample or, if it is indivisible, a second sample shall be left behind officially closed and sealed,

3. inspect and examine business documents,
4. request information.

These powers shall also cover agricultural products or foodstuffs which are put on the market in public places, in particular in markets, places and streets or by peddling.

(3) The proprietors or managers of the establishments shall be obliged to permit entry to the business premises and land, sales facilities and means of transport, as well as the inspections to be carried out there, to present the agricultural products or foodstuffs to be inspected themselves or through others such that the inspection can be carried out properly, to provide the necessary assistance in inspections themselves or through others, to have the samples taken, to submit and have examined the corporate documents, and to provide the information.

(4) If the supervision takes place on import or export, subs. 2 and 3 shall apply *mutatis mutandis* also to the party who transfers, import or exports the agricultural products or foodstuffs for the proprietor of the establishment within the EU.

(5) The party obliged to provide information may refuse to provide the information with regard to those questions the answering of which would expose him/herself or a relative designated in section 383 subs. 1 Nos. 1 to 3 of the Code of Civil Procedure to the danger of criminal prosecution or of proceedings in accordance with the Act on Regulatory Offences.

(6) Cost-covering fees and expenses shall be levied for official acts which are to be carried out in accordance with Article 11 of Regulation (EC) No. 510/2006 for the purposes of verification. The for-a-fee elements shall be determined by Land law.

Section 135

Rights because of infringement

- (1) Anyone who carries out acts in the course of trade in contravention of Article 8 or Article 13 of Regulation (EC) No. 510/2006 may be claimed against by the party entitled to assert rights in accordance with section 8 subs. 3 of the Act Against Unfair Competition for an injunction if there is a danger of recurrence. The right shall also exist if a contravention is threatened for the first time. Sections 18, 19, 19a and 19c shall apply *mutatis mutandis*.
- (2) Section 128 subs. 2 and 3 shall apply *mutatis mutandis*.

Section 136

Lapse

The rights in accordance with section 135 shall lapse in accordance with section 20.

Chapter 3

Empowerments to issue legal ordinances

Section 137

More detailed provisions on the protection of individual indications of geographical origin

- (1) The Federal Ministry of Justice is herewith empowered to make more detailed provisions, in agreement with the Federal Ministry of Economics and Technology and the Federal Ministry of Food, Agriculture and Consumer Protection, by means of a legal ordinance with the consent of the Federal Council on individual indications of geographical origin.
- (2) The legal ordinance can regulate

1. by referring to political or geographical borders, the region of origin
2. the quality or other properties within the meaning of section 127 subs. 2, as well as the circumstances relevant thereto, such as in particular the procedure or the nature of the manufacture or production of the goods or of the provision of the services or quality or other properties of the basic material used such as their origin, and
3. the nature of the use of the indication of geographical origin.

The previous fair practices, habits and customs in the use of the indication of geographical origin shall be taken into consideration when preparing regulations.

Section 138

Other provisions for the proceedings in applications and objections in accordance with Regulation (EC) No. 510/2006

- (1) The Federal Ministry of Justice is herewith empowered to make more detailed provisions regarding the application, objection, amendment and cancellation proceedings (sections 130 to 132) by means of a legal ordinance without the consent of the Federal Council.
- (2) The Federal Ministry of Justice may transfer to the German Patent and Trade Mark Office, fully or in part, the empowerment to issue legal ordinances in accordance with subs. 1 by legal ordinance without the consent of the Federal Council.

Section 139

Provisions transposing Regulation (EC) No. 510/2006

(1) The Federal Ministry of Justice is herewith empowered in agreement with the Federal Ministry of Economics and Technology and the Federal Ministry of Food, Agriculture and Consumer Protection by means of a legal ordinance with the consent of the Federal Council to regulate further details of the protection of designations of origin and geographical indications in accordance with Regulation (EC) No. 510/2006 insofar as the requirement herefor emerges from Regulation (EC) No. 510/2006 or from the provisions issued by the Council or the Commission of the European Communities for their transposition. In particular, provisions relating to

1. the marking of agricultural products or foodstuffs,
2. the entitlement to use the protected designations, or
3. the prerequisites and the procedure in supervision or inspection in intra-Community transfer or in import and export

may be issued in legal ordinances in accordance with sentence 1. Legal ordinances in accordance with sentence 1 may also be issued if the Member States are empowered in accordance with the provisions of Community law listed therein to issue supplementary provisions.

(2) The Land governments are herewith empowered by means of a legal ordinance to assign the performance of the inspections necessary in accordance with Article 11 of Regulation (EC) No. 510/2006 to approved private inspection agencies or to involve such agencies in the performance of these inspections. The Land governments may also regulate the prerequisites and the procedure for the approval of private inspection agencies by legal ordinance. They shall be empowered to assign the empowerment in accordance with sentences 1 and 2 by legal ordinance to other authorities fully or in part.

Part 7

Proceedings in disputes on symbols

Section 140

Disputes on symbols

- (1) The Regional Courts shall have exclusive jurisdiction for all actions by means of which a right from one of the legal relationships regulated in this Act is claimed (disputes on symbols), regardless of the value at dispute.
- (2) The Land governments are herewith empowered by means of a legal ordinance to assign disputes on symbols altogether or in part for the districts of several Regional Courts to one of them insofar as this serves the factual advancement or more rapid conclusion of the proceedings. The Land governments may assign this empowerment to the Land administrations of justice. The Länder may furthermore by agreement assign tasks

incumbent on the courts of one Land altogether or in part to the court of another Land which has jurisdiction.

(3) Of the costs incurred by virtue of the involvement of a patent attorney in a dispute on a symbol, the fees in accordance with section 13 of the Practising Lawyers' Remuneration Act, and furthermore the necessary expenses of the patent attorney, shall be refunded.

Section 141

Court venue for rights in accordance with this Act and the Act Against Unfair Competition

Rights which relate to the legal relationships regulated in this Act and which are based on provisions of the Act Against Unfair Competition shall not require to be asserted at the court venue of section 14 of the Act Against Unfair Competition.

Section 142

Reduction of the value at dispute

(1) If a party makes a plausible case in civil legal disputes in which by means of an action a right is asserted from one of the legal relationships regulated in this Act to the effect that the burden with the legal costs in accordance with the full value at dispute would gravely endanger their economic situation, the court may order at the party's request that the obligation incumbent on this party to pay court costs is to be assessed in accordance with a proportion of the value at dispute corresponding to its economic situation.

(2) The consequence of an order in accordance with subs. 1 shall be that the favoured party also only needs to pay the fees of their lawyer in accordance with this proportion of the value at dispute. Insofar as costs of the legal dispute are imposed on such party, or insofar as it takes these on, it must refund the court fees paid by the opponent and the fees of its lawyer only in accordance with the proportion of the value at dispute. Insofar as the out-of-court costs are imposed on the opponent or assumed by him/her, the lawyer of the favoured party may collect his/her fees from the opponent in accordance with the value at dispute applicable to such opponent.

(3) The application in accordance with subs. 1 may be placed on the record of the court registry. It shall be made prior to the hearing on the merits of the case. Subsequently, it shall only be admissible if the value at dispute which has been presumed or found is later increased by the court. The opponent shall be heard prior to the decision on the application.

Part 8

Criminal and regulatory fine regulations, seizure on import and export

Chapter 1

Criminal and regulatory fine regulations

Section 143

Punishable infringement of symbols

(1) Anyone who in the course of trade unlawfully

1. uses a sign in contravention of section 14 subs. 2 No. 1 or 2,
2. uses a sign in contravention of section 14 subs. 2 No. 3 with the intention of taking advantage of or impairing the distinctive character or the repute of a trade mark which has a reputation,
3. affixes a sign in contravention of section 14 subs. 4 No. 1 or offers, puts on the market, stocks, imports or exports in contravention of section 14 subs. 4 No. 2 or 3 a wrapping or packaging or a means of identification, insofar as to third parties the use of the sign
 - a) would be prohibited to third parties in accordance with section 14 subs. 2 No. 1 or 2, or

b) would be prohibited to third parties in accordance with section 14 subs. 2 No. 3 and the act is carried out with the intention of facilitating the taking advantage of or impairment of the distinctive character or the repute of a trade mark which has a reputation,

4. uses a designation or a sign in contravention of section 15 subs. 2, or

5. uses a designation or a sign in contravention of section 15 subs. 3 with the intention of exploiting or impairing the distinctive character or the repute of a commercial designation which has a reputation,

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

(1a) (repealed)

(2) If the offender acts on a commercial basis or as a member of a gang formed for the purpose of the continued commission of such offences in cases coming under subs. 1, the punishment shall be from three months' up to five years' imprisonment.

(3) The attempt shall be punishable.

(4) In cases falling under subs. 1, the offence shall only be prosecuted on request unless the criminal prosecution authority considers an ex officio intervention to be required because of the particular public interest in prosecution.

(5) Items to which the criminal offence is related may be confiscated. Section 74a of the Criminal Code (Strafgesetzbuch) shall be applied. Insofar as the rights to destruction designated in section 18 are granted in the proceedings in accordance with the provisions of the Code of Criminal Procedure (Strafprozeßordnung) on compensation for the injured party (sections 403 to 406c the Code of Criminal Procedure), the provisions on seizure shall not be applied.

(6) If a punishment is handed down, if the injured party so requests and puts forward a legitimate interest, it shall be ordered that the sentence shall be made public on request. The nature of the publication shall be determined in the judgment.

(7) (repealed)

Section 143a

Punishable infringement of a Community trade mark

(1) Anyone who infringes the rights of the proprietor of a Community trade mark in accordance with Article 9 § 1 sentence 2 of Council Regulation (EC) No. 207/2009 of 26 February 2009 on the Community trade mark (codification) (OJ L 78 of 24 March 2009, p. 1) by

1. using a sign that is identical to the Community trade mark for goods or services which are identical to those in respect of which it is registered,

2. using a sign if because of the identity or similarity of the sign 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 is a likelihood of confusion for the public, including the likelihood of association with the trade mark, or

3. using a sign which is 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 if the latter has a reputation in the Community and the sign is used with the intention without good cause to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the Community trade mark,

despite a prohibition and without the consent of the trade mark proprietor in the course of trade, shall be punished with up to three years' imprisonment or a criminal fine.

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

Section 144

Punishable use of indications of geographical origin

(1) Anyone who in the course of trade unlawfully uses an indication of geographical origin, a name, an indication or a sign

1. in contravention of section 127 subs. 1 or 2, in each case also in conjunction with subs. 4, or of a legal ordinance in accordance with section 137 subs. 1, or
2. in contravention of section 127 subs. 3, also in conjunction with subs. 4, or of a legal ordinance in accordance with section 137 subs. 1, with the intention to exploit or impair the reputation or distinctive character of an indication of geographical origin

shall be punished with up to two years' imprisonment or with a criminal fine.

(2) The same punishment shall be imposed on anyone who, in contravention of Article 13 § 1 (a) or (b) of Council Regulation (EC) No. 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ EU No. L 93 p. 12) in the course of trade

1. uses a registered designation for a product listed therein, or
2. adopts or imitates a registered designation.

(3) The attempt shall be punishable.

(4) In the case of a conviction, the court shall find that the unlawful marking of articles in the possession of the convict shall be removed or, if this is not possible, the articles shall be destroyed.

(5) If sentence is passed, and if necessary in the public interest, it shall be ordered that the conviction be made public. The nature of the publication shall be determined in the judgment.

(6) (repealed)

Section 145

Provisions relating to regulatory fines

(1) Anyone shall be deemed to have committed a regulatory offence who, in the course of trade, unlawfully uses in an identical or imitated form

1. a coat of arms, a flag or other sovereign state symbol or a coat of arms of a domestic locality or of a domestic municipal or local authority association within the meaning of section 8 subs. 2 No. 6,
2. an official certification marks or hallmarks within the meaning of section 8 subs. 2 No. 7, or
3. a symbol, a seal or a designation within the meaning of section 8 subs. 2 No. 8 to mark goods or services.

(2) Anyone shall be deemed to have committed a regulatory offence who intentionally or negligently

1. in contravention of section 134 subs. 3, also in conjunction with subs. 4,
 - a) refuses to permit entry to business premises, land, sales facilities or means of transport or their inspection,
 - b) does not present the agricultural products or foodstuffs to be inspected in such a way that the inspection can be carried out properly,
 - c) does not provide the necessary assistance in the inspection,
 - d) does not permit samples to be taken,
 - e) does not submit corporate documents, or not in their entirety, or does not permit them to be examined, or

f) does not provide information, or does not do so correctly, or not completely,
or

2. acts in contravention of a legal ordinance in accordance with section 139 subs.
1 insofar as it refers to this provision on regulatory fines for a specific circumstance.

(3) The regulatory offence may be sanctioned in cases falling under subs. 1 with a regulatory fine of up to two thousand and five hundred Euros, and in cases falling under subs. 2 with a regulatory fine of up to ten thousand Euros.

(4) Section 144 subs. 4 shall be applied mutatis mutandis in cases falling under subs. 1.

(5) The administrative authority within the meaning of section 36 subs. 1 No. 1 of the Act on Regulatory Offences (Gesetz über Ordnungswidrigkeiten) shall be the Federal Office of Justice in cases falling under subs. 1.

Chapter 2

Seizure of goods on import and export

Section 146

Seizure in case of infringements of rights to symbols

(1) Goods which are unlawfully affixed with a trade mark or commercial designation protected in accordance with this Act shall, unless the respectively valid version of Council Regulation (EC) No 1383/2003 of 22 July 2003 concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights (OJ EU No. L 196 p. 7) is to be applied, shall be subject, on request and in return for a security of the proprietor of the right, to seizure by the customs authority on their import or export insofar as the infringement of rights is manifest. This shall apply to trade with other Member States of the European Union, as well as with the other Contracting Parties to the Agreement on the European Economic Area only insofar as checks are carried out by the customs authorities.

(2) If the customs authority orders seizure, it shall promptly inform the party entitled to dispose, as well as the applicant. The applicant shall be informed of the origin, quantity and place of storage of the goods, as well as of the name and address of the party entitled to dispose. The privacy of correspondence and posts (Article 10 of the Basic Law) shall be restricted in this respect. The applicant shall be afforded the opportunity to inspect the goods unless this encroaches on commercial or trade secrets.

Section 147

Confiscation, opposition, suspension of seizure

(1) If the seizure is not objected to at the latest after expiry of two weeks after the service of the notice in accordance with section 146 subs. 2 sentence 1, the customs authority shall order the confiscation of the seized goods.

(2) If the party entitled to dispose of the articles objects to the seizure, the customs authority shall inform the applicant thereof promptly. The latter shall promptly state to the customs authority whether he/she upholds the application in accordance with section 146 subs. 1 with regard to the seized goods.

(3) If the applicant withdraws the application, the customs authority shall promptly suspend the seizure. If the applicant upholds the application and submits an executable court order which orders the impounding of the seized goods or a limitation on the power of disposal, the customs authority shall take the necessary measures.

(4) If no case under subs. 3 applies, the customs authority shall suspend the seizure on expiry of two weeks after service of the notice on the applicant in accordance with subs. 2. If the applicant demonstrates that the court order in accordance with subs. 3 sentence 2 has been applied for, but that he/she has not yet received it, the seizure shall be maintained for a maximum period of two further weeks.

Section 148

Competences, appeals

- (1) The application in accordance with section 146 subs. 1 shall be lodged with the Federal Finance Office (Bundesfinanzdirektion) and shall be effective for one year unless a shorter period of validity is applied for. The application may be repeated.
- (2) For the official acts linked with the application, costs shall be levied on the applicant in accordance with section 178 of the Tax Code.
- (3) Seizure and confiscation may be challenged with the appeals which are admissible in the regulatory fine proceedings in accordance with the Act on Regulatory Offences against seizure and confiscation. The applicant shall be heard in the appeal proceedings. An immediate complaint shall be admissible against the decision of the Local Court. The Higher Regional Court shall rule on the immediate complaint.

Section 149 **Compensation in case of unjustified seizure**

If the seizure proves to have been unjustified from the outset, and if the applicant has upheld the application in accordance with section 146 subs. 1 with regard to the seized goods or has not made a prompt statement (section 147 subs. 2 sentence 2), he/she shall be obliged to compensate the party with the right of disposal for the damage incurred by virtue of seizure.

Section 150 **Proceedings in accordance with Regulation (EC) No. 1383/2003**

- (1) If the competent customs office suspends release of the goods or detains them in accordance with Article 9 of Regulation (EC) No. 1383/2003, it shall inform the right-holder thereof promptly, as well as the applicant or the holder or the owner of the goods.
- (2) In cases falling under subs. 1, the right-holder may apply to have the goods destroyed in the simplified proceedings described below within the meaning of Article 11 of Regulation (EC) No. 1383/2003.
- (3) The application must be lodged in writing with the customs authority within ten working days or, in the case of perishable goods, within three working days of receipt of the notice in accordance with subs. 1. It must contain the information that the goods forming the subject-matter of the proceedings are in infringement of a right protected in accordance with this Act. The written consent of the applicant, of the holder or of the proprietor of the goods to their destruction shall be enclosed. In derogation from sentence 3, the applicant, the holder or the proprietor may submit the written declaration stating whether or not he/she consents to destruction directly to the customs authority. The time limit mentioned in sentence 1 may be extended by ten working days prior to expiry at the request of the right-holder.
- (4) Consent to destruction shall be deemed to have been issued if the applicant, the holder or the proprietor of the goods does not object to destruction within ten working days or, in the case of perishable goods, within three working days of receipt of the notice in accordance with subs. 1. This circumstance shall be referred to in the notice in accordance with subs. 1.
- (5) The destruction of the goods shall be effected at the expense and on the responsibility of the right-holder.
- (6) The customs office may take on the organisational handling of the destruction. Subs. 5 shall remain unaffected thereby.
- (7) The period for keeping in accordance with Article 11 § 1 second indent of Regulation (EC) No. 1383/2003 shall be one year.
- (8) Sections 146 to 149 shall apply mutatis mutandis in other respects unless Regulation (EC) No. 1383/2003 contains provisions to the contrary.

Section 151 **Proceedings in accordance with German law with regard to indications of geographical origin**

- (1) Goods which have been unlawfully affixed with an indication of geographical origin protected in accordance with this Act or in accordance with legal provisions of the European Community, shall, unless Regulation (EC) No. 1383/2003 is to be applied, be subject to

seizure on their import, export or transit for the purpose of eliminating the unlawful marking insofar as the infringement of rights is manifest. This shall apply to trade with other Member States of the European Union, as well as with the other Contracting Parties to the Agreement on 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 authority. The customs authority shall also order the measures necessary to eliminate the unlawful marking.

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

(4) Seizure and confiscation may be challenged with the appeals which are admissible in the regulatory fine proceedings against seizure and confiscation in accordance with the Act on Regulatory Offences. The immediate complaint shall be admissible against the decision of the Local Court. The Higher Regional Court shall rule on the immediate complaint.

Part 9 Transitional provisions

Section 152 Application of this Act

Unless provided otherwise below, the provisions of this Act shall also apply to trade marks which were filed or registered prior to 1 January 1995 or which were acquired through use in the course of trade or by being well known, and to commercial designations which were protected prior to 1 January 1995 in accordance with the provisions applicable until then.

Section 153 Restrictions for the assertion of infringement claims

(1) If the proprietor of a trade mark registered prior to 1 January 1995 or acquired through use or by being well known, or of a commercial designation in accordance with the provisions applicable until then, did not have any rights because of infringement against the use of the trade mark, of the commercial designation or of an identical sign, the rights from the trade mark or from the commercial designation in accordance with this Act may not be asserted against the further use of this trade mark, this commercial designation or this sign.

(2) Section 21 shall be applied to rights of the proprietor of a trade mark registered prior to 1 January 1995 or acquired through use or by being well known or of a commercial designation on the proviso that the five-year time limit provided for in section 21 subs. 1 and 2 shall commence to run on 1 January 1995.

Section 154 Rights in rem, levy of execution, bankruptcy proceedings

(1) If, prior to 1 January 1995, a right in rem was established in the right conferred by the application for or registration of a trade mark, or if the right given rise to by the application or registration has been the subject-matter of measures of levy of execution, these rights or measures may be entered in the register in accordance with section 29 subs. 2.

(2) Subs. 1 shall be applied mutatis mutandis if the right given rise to through the application for or registration of a trade mark has been covered by bankruptcy proceedings.

Section 155 Licences

Section 30 shall be applied to licences granted prior to 1 January 1995 under the right given rise to by the application for or registration of a trade mark, or by its use or by virtue of it being well known, on the proviso that these licences shall only benefit from the effect of section 30 subs. 5 insofar as they are transfers of rights which took effect subsequent to 1 January 1995 or licences granted to third parties.

Section 156 Examination of trade marks applied for to identify absolute obstacles to protection

- (1) If a sign has been filed prior to 1 January 1995 which in accordance with the provisions applicable until then was excluded from registration for reasons which the Patent Office had to consider ex officio, but which is not excluded from being registered in accordance with section 3, 7, 8 or 10 of this Act, the provisions of this Act shall be applied with the proviso that the application shall be deemed to have been lodged on 1 January 1995 and that, regardless of the original date of application and of any claimed priority, 1 January 1995 is material to the determination of seniority within the meaning of section 6 subs. 2.
- (2) If the Patent Office reaches the conclusion when examining the sign applied for that the prerequisites of subs. 1 are met, it shall inform the applicant accordingly.
- (3) If the applicant notifies the Patent Office within a two-month time limit after service of the notice in accordance with subs. 2 that he/she agrees to the postponement of seniority within the meaning of subs. 1, the application for the sign shall continue to be treated as an application for a trade mark in accordance with this Act.
- (4) If the applicant informs the Patent Office that he/she is not in agreement with a postponement of seniority within the meaning of subs. 1, or if he/she does not submit a declaration within the time limit contained in subs. 3, the Patent Office shall reject the application.
- (5) The applicant may also submit the declaration in accordance with subs. 3 in objection proceedings, in appeal proceedings or in appeal on points of law proceedings on the refusal of the application which is pending on 1 January 1995. Subs. 2 to 4 shall be applied mutatis mutandis.

Section 157

Announcement and registration

If the notice of an application in accordance with section 5 subs. 1 of the former Trade Mark Act (Warenzeichengesetz) was adopted prior to 1 January 1995, but the application has not yet been announced in accordance with section 5 subs. 2 of the former Trade Mark Act, the trade mark shall be entered in the register with no further notice in accordance with section 41. If the fee provided for in section 6a subs. 2 of the former Trade Mark Act for an application for an accelerated registration lodged after the order of the announcement notice has already been paid, it shall be refunded ex officio.

Section 158

Opposition proceedings

- (1) If the application for a trade mark has been announced prior to 1 January 1995 in accordance with section 5 subs. 2 of the former Trade Mark Act or the registration of a trade mark in accordance with section 6a subs. 3 of the former Trade Mark Act in conjunction with section 5 subs. 2 of the former Trade Mark Act, oppositions within the time limit contained in section 5 subs. 4 of the former Trade Mark Act may be based both on the grounds for opposition contained in section 5 subs. 4 of the former Trade Mark Act and on the grounds for opposition contained in section 42 subs. 2. If no opposition is lodged within the time limit contained in section 5 subs. 4 of the former Trade Mark Act, the trade mark shall be entered in the register in accordance with section 41 unless it is a trade mark registered in accordance with section 6a subs. 1 of the former Trade Mark Act. No opposition shall be available in accordance with section 42 against such a registration.
- (2) If, prior to 1 January 1995, an opposition was lodged in accordance with section 5 subs. 4 of the former Trade Mark Act against the registration of a trade mark announced in accordance with section 5 subs. 2 of the former Trade Mark Act or registered in accordance with section 6a subs. 1 of the former Trade Mark Act, or if after 1 January 1995 an opposition is lodged in accordance with subs. 1, the grounds for opposition contained in section 5 subs. 4 Nos. 2 and 3 of the former Trade Mark Act shall continue to be applied insofar as the opposition has been based thereon. If the opposition has been based on section 5 subs. 4 No. 1 of the former Trade Mark Act, the provision contained in section 42 subs. 2 No. 1 shall be applied in place of this provision.

(3) If the use of the trade mark because of which an opposition has been lodged has been disputed in proceedings relating to an opposition that was lodged prior to 1 January 1995, or if its use is disputed in such opposition proceedings, section 43 subs. 1 shall be applied mutatis mutandis in place of section 5 subs. 7 of the former Trade Mark Act. Sentence 1 shall also apply to the appeal proceedings before the Patent Court if such proceedings are pending on 1 January 1995. Sentence 1 shall not apply to appeals on points of law which are pending on 1 January 1995.

(4) If the opposition is refused, unless it is a registered trade mark in accordance with section 6a subs. 1 of the former Trade Mark Act, the trade mark shall be entered in the register in accordance with section 41. There shall be no opposition in accordance with section 42 against such a registration.

(5) If the opposition is granted against an application announced in accordance with section 5 subs. 2 of the former Trade Mark Act, the registration shall be refused. If the opposition is granted against a trade mark registered in accordance with section 6a subs. 1 of the former Trade Mark Act, the registration shall be cancelled in accordance with section 43 subs. 2 sentence 1.

(6) In cases falling under subs. 1 sentence 2 and subs. 4 sentence 1, there shall be no rejection of the application because of grounds for refusal that are to be considered ex officio.

Section 159

Division of an application

Section 40 shall be applied to the division of an application announced prior to 1 January 1995 in accordance with section 5 subs. 2 of the former Trade Mark Act on the proviso that the division cannot be declared until after expiry of the opposition time limit and that the declaration is only admissible if an opposition that is pending at the time of its submission would, after the division, only target one of the parts of the original application. The part of the original application not targeted by any opposition shall be entered in the register in accordance with section 41. There shall be no opposition in accordance with section 42 against such a registration.

Section 160

Duration of protection and renewal

The provisions of this Act regarding the duration of protection and the renewal of the duration of protection (section 47) shall also be applied to trade marks registered prior to 1 January 1995 on the proviso that the provisions of section 9 subs. 2 of the former Trade Mark Act shall continue to be applied to the calculation of the time limit within which the fees for the renewal of the duration of the protection of a registered trade mark may be effectively paid prior to the due date if the duration of protection in accordance with section 9 subs. 2 of the former Trade Mark Act expires prior to 1 January 1995.

Section 161

Cancellation of a registered trade mark because of revocation

(1) If an application for cancellation of the registration of a trade mark in accordance with section 11 subs. 4 of the former Trade Mark Act was lodged with the Patent Office prior to 1 January 1995, and if the time limit contained in section 11 subs. 4 sentence 3 of the former Trade Mark Act for the opposition against the cancellation has not yet expired on 1 January 1995, this time limit shall be two months.

(2) If an action was lodged prior to 1 January 1995 for cancellation of the registration of a trade mark in accordance with section 11 subs. 1 No. 3 or 4 of the former Trade Mark Act, the registration shall only be cancelled if the action is to be granted both in accordance with the provisions applicable until then and in accordance with the provisions of this Act.

Section 162

Cancellation of a registered trade mark because of absolute obstacles to protection

(1) If the proprietor of a trade mark was informed prior to 1 January 1995 that the registration of the trade mark is to be cancelled in accordance with section 10 subs. 2 No. 2 of the former Trade Mark Act, and if the time limit of section 10 subs. 3 sentence 2 of the former Trade Mark Act for the opposition against the cancellation has not yet expired on 1 January 1995, this time limit shall be two months.

(2) If proceedings were initiated ex officio prior to 1 January 1995 to cancel the registration of a trade mark because of the existence of absolute obstacles to protection in accordance with section 10 subs. 2 No. 2 of the former Trade Mark Act, or if prior to this point in time an application for cancellation was lodged in accordance with this provision, the registration shall only be cancelled if the trade mark is eligible for protection neither in accordance with the provisions previously applicable, nor in accordance with the provisions of this Act. This shall also apply if proceedings in accordance with section 54 are initiated after 1 January 1995 to cancel the registration of a trade mark which was registered prior to 1 January 1995.

Section 163

Cancellation of a registered trade mark because of the existence of earlier rights

(1) If an action to cancel the registration of a trade mark was lodged prior to 1 January 1995 on the basis of an earlier trade mark applied for in accordance with section 11 subs. 1 No. 1 of the former Trade Mark Act or on the basis of another earlier right, the registration shall only be cancelled if the action is to be granted both in accordance with the provisions applicable previously, and in accordance with the provisions of this Act, unless provided otherwise in subs. 2. This shall also apply if after 1 January 1995 an action is lodged in accordance with section 55 for the cancellation of the registration of a trade mark which was registered prior to 1 January 1995.

(2) Section 51 subs. 2 sentences 1 and 2 shall not be applied in cases falling under subs. 1 sentence 1. Section 51 subs. 2 sentences 1 and 2 shall be applied in cases falling under subs. 1 sentence 2 on the proviso that the time limit of five years starts to run as per 1 January 1995.

Section 164 (repealed)

Section 165

Transitional provisions

(1) Article 229 § 6 of the Introductory Act to the Civil Code (Einführungsgesetz zum Bürgerlichen Gesetzbuche) shall apply mutatis mutandis on the proviso that section 20 in the version valid up to 1 January 2002 is placed on the same footing as the provisions of the Civil Code on lapse in the version valid up to 1 January 2002.

(2) If the application was lodged prior to 1 October 2009, section 42 in the version valid up to 1 October 2009 shall apply to the opposition lodged against the registration.

(3) Sections 64 and 66 in the version valid until 1 October 2009 shall apply to objections and appeal which were lodged prior to 1 October 2009. The date of the lodging of the complaint shall be material for the applicability of the listed provisions to multilateral proceedings in which one party has lodged an objection and another party has filed a complaint.