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**Council for Trade-Related Aspects of
Intellectual Property Rights**

Original: English

**NOTIFICATION OF LAWS AND REGULATIONS
UNDER ARTICLE 63.2 OF THE TRIPS AGREEMENT**

GERMANY: ACT ON THE PROTECTION OF TRADE MARKS AND OTHER SIGNS
(TRADE MARK ACT)

Notifying Member	GERMANY
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Details of the notified legal text

Title	Act on the Protection of Trade Marks and other Signs (Trade Mark Act)
Subject matter	Trademarks
Nature of notification	<input checked="" type="checkbox"/> Main dedicated intellectual property law or regulation <input type="checkbox"/> Other law or regulation
Link to legal text*	https://ip-documents.info/2023/IP/DEU/23_11735_00_e.pdf
Notification status	<input type="checkbox"/> First notification <input type="checkbox"/> Amendment or revision to notified legal text <input checked="" type="checkbox"/> Replacement or consolidation of notified legal text(s)
Previous notification(s) referred to	IP/N/1/DEU/T/2 ; <i>(Agreement concerning the attached Law of 1996 Amending the Trade Mark Law)</i> IP/N/1/DEU/T/1 ; <i>(Protection of Trademarks and Other Signs (Trademark Law) of 25 October 1994)</i> IP/N/1/DEU/1 <i>(Order Concerning the Implementation of the Trademark Law of 30 November 1994)</i>

Brief description of the notified legal text

The Trademark Law Modernization Act (Markenrechtsmodernisierungsgesetz) introduced significant changes to German trademark law. The law came into force on January 14, 2019.

Overview of the most important changes:

- Determinability/new types of trademarks

Whereas trademarks in the register previously had to be capable of being represented graphically, now it will suffice if they can be clearly and precisely determined. This change in representation aims to meet the market needs for modern trademark types and also takes into account the technical possibilities of representing a trademark in electronic registers. For example, sound marks, multimedia marks, holograms and other types of trademarks in suitable electronic formats may also be registered as trademarks, provided there are no grounds for refusal.

- The national certification mark

The certification mark introduced a new trademark category into German trademark law. The main feature of the certification mark is that, unlike the individual trademark, it does not focus on the function of the trademark as an indication of origin but on the guarantee function.

A certification mark must be described as such when the trademark application is filed. It must be capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of material, mode of manufacture, quality, accuracy or other characteristics of goods or performance of services, from goods and services which are not certified accordingly. The certifying character of the mark must result from the representation of the sign. The trademark proprietor must provide information – in particular on the guaranteed characteristics of the goods, the conditions of use and the testing and monitoring measures – in the mandatory regulations governing use of the trademark.

The certification mark will enable neutral certification companies to obtain trademark protection in Germany for quality seals or test labels on the basis of which an international extension of protection will also be possible.

- A new name: cancellation proceedings renamed revocation/invalidity proceedings

"Cancellation proceedings" was renamed "revocation proceedings" or "invalidity proceedings". It is possible to claim relative grounds for refusal (earlier rights) in official invalidity proceedings in addition to absolute grounds for refusal, as currently possible. Furthermore, the current formal preliminary procedure with regard to revocation declarations was converted into revocation proceedings before the office.

- Important: new absolute grounds for refusal

Geographical indications and designations of origin, in particular for foodstuffs, wines and spirits protected under national or European legislation or conventions, have now been explicitly introduced into the Trade Mark Act as absolute grounds for refusal. In addition, protected traditional terms for wine as well as traditional specialities guaranteed with regard to foodstuffs will also have to be considered as absolute grounds for refusal during the application procedure or invalidity proceedings. Trademarks containing such indications, directly or indirectly, may be registered only for goods expressly conforming to the specification. In addition, variety denominations enjoying protection in Germany or the EU, under national or international legislation, may also conflict with the registration of an identical trademark or a trademark which represents the essential elements of the variety denomination.

- Registrability of licences/register entry about willingness to license or sell/transfer

Licences are entered in the register upon request. The entry includes information on the licensee, the type of licence and restrictions, if any. The registration, amendment and cancellation of a licence in the register will be subject to a fee. It is now also possible to record licences for trademarks for which protection was extended to Germany in the international register. The holder of an exclusive licence himself/herself may also bring an action before the ordinary courts for trademark infringement if the proprietor of the trademark himself/herself does not bring an action within a reasonable period of time after being formally requested to do so. In addition, upon request, trademark applicants and proprietors may have an entry included in the register about a non-binding declaration of their willingness to license or sell/transfer their trademark. The entry is free of charge and this willingness may be withdrawn at any time.

- Changes regarding term of protection and renewals

The German Patent and Trade Mark Office (DPMA) has brought the calculation of the duration of protection, pursuant to Section 47(1) of the Trade Mark Act (Markengesetz), into line with the practice of the European Union Intellectual Property Office (EUIPO).

The ten-year duration of protection of trademarks registered on or after 14 January 2019 starts on the day following the filing of the trademark application and, as a rule, ends on the expiry of the day which corresponds in designation or number to the filing date (e.g. application of 17 January 2019 – end of protection on 17 January 2029). For the duration of protection of a national trademark and a European Union trademark, a uniform method of calculation applies to this extent.

For trademarks registered before 14 January 2019, the duration of protection ends, as before, at the end of the month (Sec. 159(1) Trade Mark Act in conjunction with Sec. 47(1) Trade Mark Act, old version). The DPMA will inform the trademark proprietors eight months in advance of the expiry of the duration of protection of their trademark.

Since the entry into force of the Trade Mark Law Modernization Act (Markenrechtsmodernisierungsgesetz), the date of expiry of the duration of protection and the due date of payment of the renewal fee have differed. The request for renewal must be filed within a six-month period before the expiry of the duration of protection or within an additional period of six months after the end of the duration of protection. Accordingly, the renewal fees and, if applicable, the class fees for the following term of protection are due six months before the expiry of the duration of protection. If the renewal fee and class fees, if any, are only paid after expiry of the duration of protection, surcharges must be paid in addition to the renewal fee within the six-month additional period. The old version of the Patent Costs Act (Patentkostengesetz) is applicable for registered trademarks whose duration of protection expires twelve months after 31 January 2019, at the latest.

- Abolished: reclassification no longer takes place

Reclassification was abolished. If the division into classes of goods and services is altered after the filing date, the classification will not be adjusted upon renewal of the trademark, neither at the request of the proprietor nor *ex officio*.

- Many changes in the opposition proceedings

The system applied to opposition proceedings changed. Whereas in the past, filing an opposition was only possible on the basis of an opposing sign, the holder of several earlier rights is now able to assert them by lodging a single opposition. As before, it is possible to decide jointly on several oppositions. At the same time, the opposition options will be expanded. For example, protected geographical indications and protected designations of origin will constitute new, additional grounds for opposition.

The opposition fee was brought into line with the new system and the increased effort involved. As before, this amount covers one opposing sign. For each additionally asserted opposing sign, a further fee is payable.

In order to facilitate negotiations between the parties to the proceedings, a period of at least two months will be granted at their joint request to reach an amicable settlement ("cooling-off"). This period may be extended by a joint request.

The second objection of non-use with the moving period of use pursuant to Section 43(1), second sentence, of the Trade Mark Act is repealed. For these cases, however, cancellation proceedings due to revocation (new: "revocation proceedings") are still available. Proof of use is required instead of making a plausible case, but this can also be provided by means of an affirmation in lieu of an oath. This has so far also been the main means of making a plausible case. The five-year period for which proof of use of the opposing trademark must be furnished begins five years before the filing date or the priority date of the challenged trademark, instead of the five years before the date of publication of the registration of the challenged trademark, as currently applicable. Thus the period of use that must be proved corresponds to the rule in European Union trademark law.

The grace period for use will commence on the date when no further opposition can be filed against the registration of a trademark. This is either the day after expiry of the opposition period or the date on which the decision which concluded the opposition proceedings becomes final or the withdrawal of the (last) opposition. So far, the grace period for use began upon publication of the registration or – if an opposition was filed against the registration – at the date when the opposition proceedings were concluded. This means that the calculation of the grace period for use of the opposing trademark is in line with European Union trademark law. The beginning and the end of the grace period for use has to be recorded in the Trade Mark Register.

These changes will also apply to oppositions within the framework of the procedure for the extension of protection of international registrations of marks to the territory of the Federal Republic of Germany.

- Invalidity of a trademark due to absolute grounds for refusal (section 50 of the Trade Mark Act)

The invalidity proceedings conducted due to absolute grounds for refusal will remain substantially unchanged by the amendments applicable as from May 2020.

Upon request, the registration of a trademark is declared invalid and cancelled by the German Patent and Trade Mark Office due to absolute grounds for refusal if the trademark has been registered contrary to section 3, section 7 or section 8 of the Trade Mark Act; that means if it was not eligible for trademark protection, if the applicant was not capable of being the proprietor of a trademark or if there were absolute grounds for refusal and such ground for refusal continues to exist at the time the decision on invalidity is made. Further grounds for invalidity concerning collective marks are specified in sections 106, 103 of the Trade Mark Act; further grounds for invalidity concerning certification marks are specified in sections 106h, 106e of the Trade Mark Act.

The application for a declaration of invalidity due to absolute grounds for refusal can be filed by any natural or legal person as well as any group or body set up for the purpose of representing the interests of manufacturers, producers, suppliers of services, traders or consumers that can be a party to the proceedings (section 53 (2) of the Trade Mark Act).

The application for a declaration of invalidity must be filed in writing. In addition, section 53 (1) of the Trade Mark Act now provides that the facts and evidence in support of the statement of grounds must be indicated. For this reason, the application form concerning the invalidity proceedings due to absolute grounds for refusal (W 7442) has been changed accordingly. Please use the latest form! A fee of 400 euros must be paid within three months from filing the application. If the registration of the trademark has been applied for on or after 14 January 2019, the grounds for refusal under section 8 (2) nos. 9 to 12 of the Trade Mark Act (geographical indications and designations of origin, traditional terms for wine, traditional specialities, plant variety denominations) added by the Trade Mark Law Modernization Act can also be referred to.

The adversarial proceedings are conducted only if the proprietor of the registered mark objects to the declaration of invalidity and cancellation within two months of the receipt of the application for a declaration of invalidity (section 53 (5) of the Trade Mark Act). Otherwise, the trademark is declared invalid and cancelled from the Register.

If the application for a declaration of invalidity due to absolute grounds for refusal is granted, the effects of the trademark are deemed not to have taken place, as from the outset, to the extent that the trademark has been declared invalid (section 52 (2) of the Trade Mark Act).

The provisions set out above apply accordingly to the part of international registrations of marks that extends to Germany, section 115 of the Trade Mark Act.

- Invalidity of a trademark due to conflicting earlier rights (section 51 of the Trade Mark Act)

Starting from 1 May 2020, it is also possible to have the option to file an application for a declaration of invalidity and cancellation of a registered mark – or for invalidation of the part of an international registration that extends to Germany – due to any conflicting earlier right within the meaning of sections 9 to 13 of the Trade Mark Act. These proceedings could so far be conducted only before the ordinary courts.

The application for a declaration of invalidity because of earlier rights can be filed by the holder of the rights stipulated in sections 9 to 13 of the Trade Mark Act and by persons entitled to invoke rights resulting from a protected geographical indication or a protected designation of origin (section 53 (3) of the Trade Mark Act).

Such application can also be based on several earlier rights of the same holder (section 51 (1) of the Trade Mark Act). Section 51 (2) to (4) of the Trade Mark Act contains special provisions that exclude the declaration of invalidity because of conflicting earlier rights in certain cases (e.g. in case of acquiescence of the later trademark or non-use of the earlier trademark).

The application for a declaration of invalidity must be filed in writing and the facts and evidence in support of the statement of grounds must be indicated (section 53 (1) sentences 1 and 2 of the Trade Mark Act).

A fee must be paid within three months from filing the application. If the application for a declaration of invalidity is based on more than one earlier right, an additional fee must be paid with respect to each additional right. The adversarial proceedings are conducted only if the proprietor of the registered mark objects to the declaration of invalidity and cancellation within two months of the receipt of the application for a declaration of invalidity (section 53 (5) of the Trade Mark Act). Otherwise, the trademark is declared invalid and cancelled.

If the application for a declaration of invalidity because of conflicting earlier rights is granted, the effects of the trademark are deemed not to have taken place, as from the outset, to the extent that the trademark has been declared invalid (section 52 (2) of the Trade Mark Act).

The provisions set out above apply accordingly to the part of international registrations of marks that extends to Germany, section 115 of the Trade Mark Act.

- Revocation of a trademark (section 49 of the Trade Mark Act)

In the case of an application filed as from 1 May 2020, the revocation proceedings can be conducted fully at the German Patent and Trade Mark Office. The person filing the application has so far been required to pursue his application before the ordinary courts if the trademark proprietor has objected to the application for revocation and cancellation of his trademark.

Upon request, the registration of a trademark is revoked and cancelled if it has not been used within a period of five years, if it is of such a nature now, unlike at the time of its registration, as to deceive the public or if the proprietor ceases to meet the requirements of section 7 of the Trade Mark Act.

Further grounds for revocation concerning collective marks are specified in section 105 of the Trade Mark Act; further grounds for revocation concerning certification marks are specified in section 106g of the Trade Mark Act. Revocation proceedings concerning collective or certification marks can be conducted only at the German Patent and Trade Mark Office.

The application for revocation can be filed by any natural or legal person and by any group or body set up for the purpose of representing the interests of manufacturers, producers, suppliers of services, traders or consumers that can be a party to the proceedings (section 53 (2) of the Trade Mark Act).

The application for revocation must be filed in writing. In addition, section 53 (1) of the Trade Mark Act now provides that the facts and evidence in support of the statement of grounds must be indicated.

A fee must be paid within three months from filing the application. If the proprietor of the registered mark objects to the application for revocation in due time, within two months of the receipt thereof, the adversarial proceedings will, from now on, be conducted at the German Patent and Trade Mark Office provided that the person filing the request pays a fee for pursuing the application further.

If the proprietor of the registered mark does not object to the revocation and cancellation of his trademark, this trademark will – as before – be revoked and cancelled (section 53 (5) of the Trade Mark Act).

If the application for revocation is granted, the effects of the trademark are deemed not to have taken place, as from the date of the application – or, on request and where appropriate, even earlier – to the extent that the trademark has been revoked (section 52 (1) of the Trade Mark Act).

The provisions set out above apply accordingly to the part of international registrations of marks that extends to Germany, section 115 of the Trade Mark Act.

- Links between proceedings before the German Patent and Trade Mark Office and an action before the ordinary courts

Both the revocation of a trademark (other than a collective or certification mark) and its invalidity due to conflicting earlier rights can also be asserted by way of action before the ordinary courts (section 55 (1) sentence 1 of the Trade Mark Act).

An action is inadmissible if a request concerning the same matter disputed between the parties has been made to the German Patent and Trade Mark Office (section 55 (1) sentence 2 no. 2 of the Trade Mark Act); conversely, an application for a declaration of invalidity due to conflicting earlier rights or for revocation with the German Patent and Trade Mark Office is inadmissible if an action concerning the same matter in dispute is pending in the ordinary courts between the parties (section 53 (1) sentence 5 of the Trade Mark Act).

For this reason, an entry is made in the Register of the German Patent and Trade Mark Office if, as from 1 May 2020, an application for revocation or for a declaration of invalidity of a registered mark has been filed with the German Patent and Trade Mark Office or a relevant action has been brought to an ordinary court (section 25 no. 24 of the Trade Mark Ordinance).

- Additional changes in the revocation and invalidity proceedings

Option to intervene in proceedings, section 54 of the Trade Mark Act.

A person against whom proceedings are pending for trademark infringement or who has been requested to stop an alleged infringement of a trademark can intervene in revocation or invalidity proceedings against the same trademark within the time-limit specified in section 54 (1) sentence 2 of the Trade Mark Act since 1 May 2020, provided that a final and non-appealable decision has not yet been made.

Such intervention in the proceedings, just as an application for revocation or for pursuing the application further and an application for a declaration of invalidity, is subject to a fee and can be made even at the appeal stage.

Hearings, section 60 (2) sentence 4 of the Trade Mark Act:

Since 14 January 2019, hearings are held in revocation and invalidity proceedings if they are requested by a party to the proceedings or deemed expedient by the German Patent and Trade Mark Office.

Security, section 53 (1) sentence 3 of the Trade Mark Act in conjunction with section 81 (6) of the Patent Act.

Since 1 May 2020, persons filing an application for revocation or for a declaration of invalidity that do not have their habitual residence in a member State of the European Union or in a Contracting State to the Agreement on the European Economic Area must, at the request of the trademark proprietor, provide security for the costs of the proceedings, with the amount of security to be determined by the German Patent and Trade Mark Office.

Language(s) of notified legal text	English
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Notification details

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Agency or authority responsible	Federal Ministry of Justice - III B 5 Mohrenstr. 37 10117 Berlin Germany Email: IIIB5@bmj.bund.de

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