

# Regulation on the implementation of the Trade Mark Act (Trade Mark Regulation – MarkenV)

MarkenV

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## Footnote

(+++ Proof of text from: 1.6.2004 +++)  
(+++ For application cf. §§ 10, 33, 34 +++)

## Input formula

On the basis of Paragraph 65(1)(2) to (10) and (13) and Article 138(1) of the Trade Marks Act of 25 October 1994 (BGBl. 1994 I p. 3084, 1995 I p. 156), of which Paragraph 65(1) was last amended by Article 2(9) of the Law of 12 March 2004 (BGBl. I p. 390), in conjunction with Paragraph 1(2) of the DPMA Regulation of 1 April 2004 (BGBl. I, p. 514), the German Patent and Trade Mark Office provides:

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## **Part 1 Scope**

### **§ 1 Proceedings in Trademark Matters**

(1) In addition to the provisions of the Trade Mark Act, the provisions of this Ordinance shall apply to the proceedings before the German Patent and Trademark Office (trade mark matters) regulated by the Trade Mark Act.

(2) DIN standards referred to in this Ordinance have been published in Beuth-Verlag GmbH, Berlin and Cologne, and recorded as archived by the German Patent and Trademark Office.

## **Part 2 Procedure until registration**

### **Section 1 Registrations**

#### **§ 2 Form of notification**

(1) The application can be submitted in writing or electronically. The form issued by the German Patent and

Trademark Office shall be used for the written application. For electronic filing, the Ordinance on Electronic Legal Transaction at the German Patent and Trademark Office is decisive.

(2) A separate application is required for each trade mark.

### **§ 3 Content of the application**

(1) The application must include:

1. Information on the applicant and, where applicable, his representative in accordance with § 5,
2. an indication of the shape of the trade mark pursuant to Section 6, a representation of the trade mark pursuant to Sections 7 to 12 and, in the cases referred to in Section 6b(2), a description of the trade mark; and
3. the list of goods and services for which the trade mark is to be registered pursuant to § 20.

(2) Will be included in the application

1. if the priority of a previous foreign application has been claimed, a declaration shall be made and the date and State of that application shall be indicated;
2. if an exhibition priority is invoked, a corresponding declaration must be made and the date of the first exhibition and the exhibition shall be indicated.

### **§ 4 Application for collective or warranty marks**

(1) If registration as a collective or warranty mark is requested, a corresponding declaration must be submitted to the application.

(2) Paper collective mark or warranty mark statutes must be submitted unbound.

(3) In the event of changes to collective mark or warranty mark statutes, an up-to-date version of the articles of association must be submitted.

(4) Paragraphs 2 and 3 shall also apply to amendments to the statutes after registration.

### **§ 5 Details of the applicant and its representative**

(1) The application must contain the following information to the applicant:

1. if the applicant is a natural person: First names and names or, if the registration is to be made under the applicant's company name, the company as entered in the trade register, as well as the address of the registered office or registered office (street, house number, postcode, city),
2. if the applicant is a legal person or a partnership:
  - a) Name or company name, legal form and address (street, house number, postal code, place) of the registered office of the legal person or partnership; the designation of the legal form may be abbreviated in the usual manner; where the legal person or partnership is registered in a register, the information shall correspond to the register entry;
  - b) in the case of a company under civil law, additionally name and address (street, house number, postal code, city) at least one authorised partner.

If the applicant is domiciled or domiciled abroad, the State shall also be indicated when specifying the address referred to in sentence 1, in addition to the place name. Further information about the district, province or state in which the applicant is domiciled or domiciled or whose legal system he is subject to is voluntary.

(2) The application may also include a mailing address different from the address of the applicant, a mailbox address as well as telephone numbers, fax numbers and e-mail addresses.

(3) Where the application is submitted by several persons or partnerships, paragraphs 1 and 2 shall apply to all notifying persons or partnerships.

(4) Where a representative is appointed, paragraphs 1 and 2 shall apply mutatis mutandis with regard to the particulars of the representative. If the German Patent and Trademark Office has assigned the number of a general power of attorney to the representative, it shall be indicated in addition.

### **§ 6 Information on the trade mark form**

The application must indicate whether the trade mark is

1. Word mark (§ 7),
2. Figurative mark (§ 8),
3. three-dimensional mark (§ 9),

4. Colour mark (§ 10),
  5. Sound mark (§ 11),
  6. Position mark, identification mark, pattern mark, movement mark, multimedia mark, hologram mark (§ 12) or
  7. other trade mark (§ 12a)
- to be entered in the register.

### **§ 6a Trademark presentation**

(1) The trade mark requires a representation that meets the requirements of Section 8(1) of the Trade Marks Act. The presentation can be submitted in paper form or on a data medium. The data carrier must be readable by the German Patent and Trademark Office. The data carrier types and formatting readable by the German Patent and Trademark Office will be announced on the website [www.dpma.de](http://www.dpma.de). Where this Regulation allows multiple views to be submitted, all views shall be included in a single file. If the data carrier is not readable, the presentation shall be deemed not to have been submitted.

(2) In the case of other trade marks which cannot be otherwise represented, a representation by text is possible as the sole means of representation, if the text makes the subject-matter of the protection of the trade mark clearly and unambiguously identifiable pursuant to § 8(1) of the Trade Marks Act. The text may contain up to 150 words, must be continuous and must not contain any graphic or other design elements.

(3) If the representation of a trade mark form is possible by various means, the applicant decides on the type of representation. If the same representation of the trade mark is submitted on paper and on a data carrier, the representation on a data carrier shall be decisive for the subject-matter of protection. In the cases of sentence 2, the means of presentation first filed shall be decisive for determining the date of filing.

### **§ 6b Trademark description**

(1) For all trade mark forms except word marks within the meaning of § 7, a trade mark description may be filed with the trade mark application to explain the trade mark representation.

(2) A trade mark description must be filed with the trade mark application if the subject-matter of the protection of the trade mark can only be determined. This applies in particular to the trade mark forms pursuant to § 12 and to other trade mark forms pursuant to § 12a.

(3) The description of the trade mark must objectively concretise the subject-matter of the protection of the trade mark.

(4) The brand description may contain up to 150 words and must be submitted on a separate sheet in the format 21 x 29.7 centimeters (DIN A4). It must consist of a continuous text and must not contain any graphic or other design elements.

### **§ 7 Word marks**

If the applicant states that the trade mark is to be registered in the usual typeface used by the German Patent and Trade Mark Office, the trade mark must be reproduced in the application in usual characters (letters, numbers or other signs). The characters customary at the German Patent and Trademark Office are published on the website [HYPERLINK "http://www.dpma.de"www.dpma.de](http://www.dpma.de).

### **§ 8 Figurative marks**

(1) If the applicant indicates that the trade mark should be registered as a word-picture trade mark or purely figurative mark, a graphic representation of the trade mark must be attached to the application. If the trade mark is to be registered in black and white, the graphic representation must be submitted in black and white. If the trade mark is to be registered in colour, the graphic representation in colour must be submitted and the colours must be indicated in the application.

(2) The representation of the trade mark must be permanently reproduced on paper and in shades and finish in such a way that it clearly shows in all details the components of the trade mark. Adhesives, coatings and coverings made with non-permanent paint are not permitted.

(3) For the representation of the trade mark, the form issued by the German Patent and Trade Mark Office should be used, on which the representation of the trade mark must be printed or glued. The representation of the mark must not be less than 8 centimeters in width or 8 centimeters in height. In the field provided for the representation of the trade mark, only the trade mark representation and the information referred to in paragraph 5 may be found. Other explanatory text, explanatory designations, symbols or dimensions shall not be included in the playback field.

(4) If the form referred to in paragraph 3 is not used for the representation of the trade mark, a sheet in the format

21 x 29.7 centimeters (DIN-A4) shall be used. The area used for the presentation (set mirror) shall not be greater than 26.2 x 17 centimeters and not less than 8 centimeters in width or 8 centimeters in height. The sheet must only be printed on one side. A margin spacing of at least 2.5 centimeters from the upper and left side edges of each leaf shall be maintained.

(5) The correct position of the trade mark must be marked by the words 'above' above the representation, unless this is self-evident.

(6) Section 6a remains unaffected.

#### **Footnote**

(+++ § 8: For application, see Sections 12(2), 12a(2) +++)

(+++ § 8(2) to (6): For application, see Sections 9(4), 10(3), 11(3) +++)

### **§ 9 Three-dimensional brands**

(1) If the applicant indicates that the trade mark is to be registered as a three-dimensional trade mark, the application must be accompanied by a representation of the trade mark which satisfies the requirements of Paragraph 8(1) of the Trade Mark Act. If the trade mark is to be registered in black and white, the representation must be submitted in black and white. If the trade mark is to be registered in colour, the representation in colour must be submitted and the colours must be indicated in the application.

(2) If a graphic representation is attached to the application, the representation may contain up to six different views and must be submitted on a sheet of paper in the format of § 8(3) or (4).

(3) If the graphic representation is represented by means of a line drawing, it must be carried out in lines that are not blurred and sharply limited. It may contain hatching and shades for displaying plastic details.

(4) Furthermore, Section 8(2) to (6) shall apply mutatis mutandis to the form of the presentation.

#### **Footnote**

(+++ § 9: For application, see Sections 12(2), 12a(2) +++)

### **§ 10 Colour marks**

(1) If the applicant indicates that the trade mark should be registered as a colour mark, a colour sample must be attached to the application for a single-colour abstract colour mark. The colour shall be designated by the number of an internationally recognised colour classification system.

(2) In the case of an abstract colour mark consisting of several colours, the application must, in addition to the requirements set out in paragraph 1, contain the systematic arrangement in which the colours concerned are connected in a defined and consistent manner.

(3) § 8(2) to (6) shall apply mutatis mutandis to the form of the representation of the colour sample.

#### **Footnote**

(+++ § 10: For application, see Sections 12(2), 12a(2) +++)

### **§ 11 Sound marks**

(1) If the applicant indicates that the trade mark should be registered as a sound mark, the application must be accompanied by a representation on a data medium or a graphic representation of the sound mark.

(2) The graphical representation has to be done in a usual notation.

(3) Furthermore, Section 8(2) to (6) shall apply mutatis mutandis to the form of the presentation.

#### **Footnote**

(+++ § 11: For application, see Sections 12(2), 12a(2) +++)

### **§ 12 Position marks, identification marks, sample marks, movement marks, multimedia marks, hologram marks**

(1) If the applicant indicates that the trade mark should be registered as a position mark, distinctive mark, design mark, motion mark, multimedia mark or hologram mark, the application must be accompanied by a representation of the trade mark which meets the requirements of Paragraph 8(1) of the Trade Mark Act.

(2) §§ 8 to 11 shall apply mutatis mutandis to the form of the presentation.

### **Section 12a Other trade mark forms**

(1) If the applicant applies for a trade mark which is not covered by the trade mark forms set out in Sections 7 to 12, the trade mark may be registered as a different trade mark. The application must be accompanied by a representation of the trade mark which

The requirements of Section 8(1) of the Trade Marks Act are satisfied. Under the conditions laid down in Section 6a(2), the presentation may also be made by text.

(2) Furthermore, Sections 8 to 11 shall apply mutatis mutandis to the form of the presentation.

### **§ 13 Patterns and models**

No designs or models of the trade mark objects or the trade mark itself may be attached to the application.

### **§ 14 (disappeared)**

### **§ 15 Foreign-language applications, representations with non-Latin characters**

(1) Applications filed in foreign language shall be granted a filing date pursuant to Section 33(1) of the Trade Marks Act, provided that the requirements of Section 32(2) of the Trade Marks Act are fulfilled.

(2) If the representation of the trade mark contains non-Latin characters, a German translation, a transliteration and a transcription of the non-Latin trade mark text shall be attached. The German Patent and Trademark Office may require the applicant to certify the translation, transliteration and transcription by a lawyer or patent attorney or to have it produced by a publicly appointed translator.

(3) A German translation of the other foreign-language content of the application, in particular the list of goods and services, shall be filed with the German Patent and Trade Mark Office within three months of receipt of the application. The German Patent and Trademark Office may, setting a reasonable period of time, request the applicant to authenticate the translation by a lawyer or patent attorney or to have it produced by a publicly appointed translator.

(4) If the translation pursuant to paragraph 3 sentence 1 is not submitted within the time limit, the application shall be deemed to have been withdrawn. If the translation, transliteration or transcription pursuant to paragraph 2 sentence 2 or paragraph 3 sentence 2 is not filed within the prescribed period, the application shall be refused.

(5) The examination of the application and all further proceedings before the German Patent and Trademark Office will take place on the basis of the German translation.

### **§ 16 Foreign language documents**

(1) German translations of foreign-language documents must be certified by a lawyer or patent attorney or by a publicly appointed translator.

(2) German translations of foreign-language priority documents and copies of previous applications (Section 34(3) sentence 2 of the Trade Mark Act) shall only be submitted at the request of the German Patent and Trade Mark Office. The German Patent and Trademark Office sets a reasonable deadline for subsequent submission.

(3) German translations of other documents that:

1. do not include the documents of the application; and
2. submitted in English, French, Italian or Spanish,

must be submitted only at the request of the German Patent and Trademark Office. The German Patent and Trademark Office sets a reasonable deadline for subsequent submission.

(4) If other documents other than those of the application are submitted in languages other than those listed in the first sentence of paragraph 3, no. 2, translations into the German language shall be submitted within one month of receipt of the documents.

(5) If the translation within the meaning of paragraphs 2 to 4 is submitted after the expiry of the time limit, the foreign-language document shall be deemed to have been received at the time of receipt of the translation. If no translation is submitted, the foreign-language document is deemed not to have been received.

### **§ 17 Reliance on a trade mark registered in the country of origin**

(1) If the applicant refers to a trade mark registered in the country of origin pursuant to Article 6 quinquies of the Paris Convention, the corresponding declaration may still be made after the application has been filed.

(2) The applicant shall submit a certificate of registration in the country of origin issued by the competent authority.

### **§ 18 Shift in seniority in traffic enforcement**

It is apparent from the examination that the conditions for the postponement of seniority pursuant to § 37 para. 2 of the Trade Marks Act, the German Patent and Trade Mark Office shall inform the applicant accordingly. The file of the application shall indicate the date which is relevant for determining seniority. The filing date pursuant to Section 33(1) of the Trade Marks Act shall remain unaffected.

## **Section 2**

### **Classification of goods and services**

#### **§ 19 Classification**

The classification of goods and services is based on the current version of the class classification and alphabetical lists of goods and services published in the Federal Gazette by the German Patent and Trade Mark Office in accordance with the classification system established in the Geneva version of 13 May 1977 of the Nice Agreement of 15 June 1957 on the International Classification of Goods and Services for the Registration of Marks (Federal Law Gazette 1981 II, p. 358, 359).

#### **§ 20 List of goods and services**

(1) The goods and services shall be designated in such a way that the classification of each individual good or service into a class classification under Paragraph 19 is possible.

(2) The goods and services in respect of which trade mark protection is sought must be indicated by the applicant in such a clear and unambiguous manner that the competent authorities and the public can determine the scope of protection applied for solely on that basis.

(3) For the information referred to in paragraph 2, the generic terms or other general terms contained in the class headings of the Nice Classification may be used, provided that they are clear and unambiguous.

(4) The goods and services must be specified by class in order of class classification.

(5) The use of general terms includes all goods or services which are clearly covered by the literal meaning of the term.

(6) The list of goods and services must be drawn up in the written application in lettering 11 point and with a line spacing of one and a half lines.

#### **§ 21 Decision on classification**

(1) If the goods and services are not correctly classified in the application, the German Patent and Trade Mark Office decides on the classification.

(2) The German Patent and Trade Mark Office defines as the leading class the class of class division on which the main focus of the application lies. It is not bound in this respect to an indication by the applicant about the lead class. The German Patent and Trade Mark Office takes into account a leading class specified by the applicant when paying fees.

#### **§ 22 (disappeared)**

## **Section 3**

### **Publication of the application**

#### **§ 23 Publications for registration**

(1) The publication of an application for a trade mark shall include the following information:

1. the file number of the application,
2. the date of receipt of the notification,
3. Information on the trade mark,
4. Information on a foreign priority claimed by the applicant (Section 34 of the Trade Marks Act), issue priority (§ 35 of the Trade Mark Act) or a seniority claimed by Article 35 of Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ L 78, 24.3.2009, p. 1), as amended by Regulation (EU) 2015/2424 (OJ L 341, 24.12.2015, p. 21),
5. the name, where applicable, the legal form, domicile or registered office of the applicant,
6. if a representative is appointed, the name and seat of the representative,



7. the address with an indication of the consignee; and
8. the lead class and, where applicable, other classes of the list of goods and services.

(2) If a trade mark applied for is not entered in the register, the publication shall also include the following information:

1. where a trade mark applied for is refused in whole or in part, an indication corresponding to the ground for refusal and of the goods and services as well as the classes to which the refusal relates;
2. where a trade mark application is withdrawn in whole or in part, an indication corresponding to the goods and services and the classes to which the withdrawal relates;
3. if an application is deemed to have been withdrawn because of non-payment of the fee (Section 6(2) of the Patent Costs Act) or due to a lack of minimum requirements for granting an application (Section 36(2) sentence 1 in conjunction with Section 36(1)(1), § 33(1) of the Trade Mark Act), a corresponding indication;
4. in the case of closed multiple applications, a corresponding indication.

(3) Publication may be made in electronic form.

### **Part 3**

#### **Register, document, publication**

##### **§ 24 Place and form of the register**

- (1) The register is kept at the German Patent and Trademark Office.
- (2) Since 1 August 1999, the register is operated in the form of an electronic database.

##### **§ 25 Contents of the register**

The following shall be entered in the register:

1. the registration number of the trade mark,
2. the file number of the application, if it does not match the registration number,
3. the representation of the trade mark,
4. the indication of the trade mark form,
5. in the case of trade marks registered in colour, the corresponding indication and designation of the colours,
6. where applicable, a description the Brand,
7. in the case of trade marks registered on the basis of proven market assertion (Section 8(3) of the Trade Mark Act), the corresponding indication,
8. for trade marks registered on the basis of a trade mark registered in the country of origin in accordance with Article 6 quinquies of the Paris Convention, an indication thereof;
9. where applicable, an indication that it is a collective or certification mark;
10. in the case of a trade mark whose seniority under Article 34 or Article 35 of Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ L 78, 24.3.2009, p. 1), as amended by Regulation (EU) 2015/2424 (OJ L 341, 24.12.2015, p. 21), has been claimed for an EU trade mark applied for or registered, the indication of the relevant file mark and, in the case of cancellation of the trade mark, the designation of the ground for revocation or invalidity,
11. the date of filing of the trade mark,
12. where applicable, the date which is relevant for determining the seniority of a trade mark pursuant to Section 37(2) of the Trade Marks Act,
13. the date, state and file number of a foreign priority claimed by the trade mark proprietor (Section 34 of the Trade Mark Act);
14. Information on an exhibition priority claimed by the trade mark proprietor (Section 35 of the Trade Mark Act),
15. the name, where applicable, the legal form and the domicile or registered office of the proprietor of the trade mark; in the case of a company under civil law, the name and domicile of the designated authorised partner;
16. if a representative is appointed, the name and seat of the representative,
17. the address with an indication of the consignee,
18. the list of goods and services, indicating the lead class and the other classes in grouped form,
19. the date of entry in the register,
20. the date of publication of the registration,
- 20a. the beginning and end of the grace period for use in accordance with Sections 26 and 43(1) of the Trade Mark Act,

21. if no opposition to the registration of the trade mark has been filed after the expiry of the opposition period, a corresponding indication,
22. if an objection has been lodged,
  - a) a corresponding statement,
  - b) Indications of the opposing sign on which the opposition is based,
  - c) the status of the contradiction,
  - d) the date of closure of the opposition proceedings,
  - e) in the event of complete cancellation of the trade mark, a corresponding indication,
  - f) in the event of partial cancellation of the trade mark, the goods and services to which the cancellation relates,
23. the extension of the term of protection;
24. where a third party has applied for a declaration of revocation or invalidity of a registered trade mark or has brought an action for revocation or invalidity of a registered trade mark,
  - a) in the event of an application for a declaration of revocation or invalidity pursuant to Sections 49 to 51 of the Trade Mark Act,
  - b) in the event of an action for a declaration of revocation or invalidity of a registered trade mark, the date of collection;
  - c) in the event of an application for a declaration of revocation or invalidity pursuant to Sections 49 to 51 of the Trade Mark Act, the conclusion of the revocation or invalidity proceedings,
  - d) in the event of an action for revocation or invalidity of a registered trade mark, the outcome of the proceedings with the date of res judicata;
  - e) in the event of a complete declaration of revocation or invalidity and cancellation of the trade mark, an indication indicating the grounds for revocation or invalidity,
  - f) in the case of partial declaration of revocation or invalidity and cancellation of the trade mark, an indication corresponding to the grounds for revocation or invalidity and of the goods and services to which the cancellation relates,
25. if invalidity proceedings are initiated ex officio,
  - a) in the event of a complete declaration of invalidity and cancellation of the trade mark, an indication indicating the ground for invalidity,
  - b) in the event of partial declaration of invalidity and cancellation of the trade mark, an indication indicating the ground for invalidity and the goods and services to which the cancellation relates,
26. in the event of complete or partial cancellation of the trade mark on the basis of a corresponding declaration by the proprietor of the trade mark, such as, in particular, an application for partial extension of the term of protection or a partial waiver, the corresponding indication under the designation of the grounds for cancellation and, in so far as it is a partial cancellation, the list of goods and services in the version as it appears after the cancellation has been completed,
27. Information on an application for registration pursuant to Section 44 of the Trade Mark Act, insofar as they have been notified to the German Patent and Trade Mark Office,
28. the date of receipt of a declaration of division,
29. in the case of the parent registration, the reference to the registration number of the separate registration as a result of a declaration of division,
30. in the case of the registration separated as a result of a declaration of division, the corresponding indication and the registration number of the parent registration;
31. the date and number of the international registration (Section 110(2) of the Trade Mark Act),
32. the transfer of a trade mark together with information on the successor and, where applicable, its representative in accordance with points 15, 16 and 17;
33. in addition, in the event of a transfer of the trade mark in respect of part of the goods and services, the information referred to in points 29 and 30;
34. Information on rights in rem (Section 29 of the Trade Mark Act),
- 34a. Information on licences, including the name, legal form and address of the licensee's domicile or registered office;
- 34b. Declarations of readiness to license or sell,
- 34c. Information on trademark statutes of collective or warranty marks,
35. Information on measures of foreclosure (Section 29(1)(2) of the Trade Marks Act) and the registration of the

- trade mark by insolvency proceedings (Section 29(3) of the Trade Marks Act);
36. Amendments to the information referred to in points 15, 16 and 17; and
  37. Corrections to entries in the register (Section 45(1) of the Trade Mark Act).

## **§ 26 Certificate, certificates**

In addition to the certificate of registration of the trade mark in the register pursuant to Section 25 of the DPMA Regulation, the proprietor of a trade mark receives a certificate of the information entered in the register. Non-graphic trade mark representations and brand statutes are replaced by a reference to the trade mark register.

## **§ 27 Publications on entries in the register**

- (1) Entries in the register pursuant to § 25 are published in regular overviews by the German Patent and Trademark Office.
- (2) Publication may be made in electronic form.
- (3) The publication of the registration shall include all the particulars entered in the register with the exception of the particulars referred to in Sections 25(20a), 22(b) and (c), 24(b) and (d), 31 and 34a to 34c.
- (4) The first publication of a registered trade mark must be accompanied by a reference to the possibility of opposition (Section 42 of the Trade Mark Act). This notice is repeated if the registered trade mark is republished due to significant defects in the initial publication. The notice may be made jointly for all trade marks published in accordance with sentences 1 and 2.

## **§ 28 (disappeared)**

### **Part 4**

### **Individual procedures**

#### **Section 1**

#### **Opposition proceedings**

##### **§ 29 Form of opposition**

- (1) A separate opposition is required for each trade mark, commercial designation, protected designation of origin or geographical indication on the basis of which opposition is filed against the registration of a trade mark (contradiction mark). If all opposition marks belong to the same proprietor, there is only one opposition.
- (2) The opposition should be filed using the form issued by the German Patent and Trademark Office.

##### **§ 30 Content of the opposition**

- (1) The opposition must contain information that makes it possible to establish the identity of the contested trade mark, the opposing mark and the opponent or the opponent. In the case of the opposition marks neither applied for nor registered, the type, presentation, form, seniority, subject-matter and proprietor of the claimed trade mark shall be indicated in order to identify them.
- (2) The opposition shall indicate, unless already necessary for the identification referred to in paragraph 1:
  1. the registration number of the trade mark against which the opposition is directed,
  2. the registration number of the registered opposition trade mark or the reference number of the opposition trade mark applied for or the dossier number of the protected designation of origin or geographical indication;
  3. the representation and designation of the shape of the opposing sign,
  4. if the opposing trade mark is an internationally registered trade mark, the registration number of the opposing trade mark and for internationally registered opposing marks registered before 3 October 1990 with effect for both the Federal Republic of Germany and the German Democratic Republic, the statement on which part of the opposition is based,
  5. the name and address of the holder of the opposition mark,
  6. where the opposition arising from a trade mark applied for or registered is raised by a person who is not registered as an applicant in the file of the application or registered in the register as the proprietor, the name and address of the opponent or the opponent and the date on which an application for a notice or registration of the transfer has been lodged,
  7. if the opponent has appointed a representative, the name and address of the representative,
  8. the name of the proprietor of the trade mark against whose registration the opposition is directed,
  9. the goods and services on which the opposition is based,

10. the goods and services against which the opposition is directed.

### **§ 31 Joint decision on several contradictions**

Several contradictions can be decided together.

### **§ 32 Suspension**

(1) The German Patent and Trade Mark Office may suspend the proceedings concerning an opposition, except in the cases referred to in Section 43(3) of the Trade Mark Act, even if this is relevant.

(2) A suspension is considered, in particular, if the opposition is likely to be upheld and the opposition has been based on a trade mark applied for or if revocation and invalidity proceedings are pending before the German Patent and Trade Mark Office.

## **Section 2**

### **Partial transfer, division of applications and registrations**

#### **§ 33 Partial transfer of a registered trade mark**

(1) Where the transfer of the right established by the registration of a trade mark concerns only part of the registered goods and services, the application for registration of the transfer shall indicate the goods and services to which the transfer relates pursuant to Section 28 of the DPMA Regulation.

(2) Moreover, Section 36(1) to (4) and (6) shall apply mutatis mutandis.

#### **§ 34 Transfer, rights in rem, insolvency proceedings and foreclosure measures for filings**

(1) The transfer of rights, rights in rem, measures of foreclosure or insolvency proceedings shall be recorded in the file of the application.

(2) In the case of transfers, only the person who is the proprietor of the trade mark at the time of registration will be entered in the register. A right in rem existing at the time of registration, a measure of foreclosure existing at that time or insolvency proceedings pending at that time shall also be entered in the register.

(3) Where the transfer of the right established by the application for a trade mark concerns only part of the goods and services in respect of which the trade mark has been applied for, the application for a partial transfer shall indicate the goods and services to which the transfer relates. Moreover, Section 35(1) to (4) and (6) shall apply mutatis mutandis.

#### **§ 35 Division of applications**

(1) Under Paragraph 40(1) of the Trade Mark Act, a trade mark applied for may be divided into two or more applications. A separate declaration of division is required for each separated part. The declaration of division is to be filed using the form issued by the German Patent and Trademark Office.

(2) The division declaration shall indicate the goods and services that are included in the separate application.

(3) The list of goods and services of the remaining parent application and the list of goods and services of the segregated application must be identical overall to the list of goods and services of the exit application existing at the time of receipt of the division declaration. Where the division relates to goods and services covered by a generic term, the generic term must be used both in the parent application and in the separate application and must be limited by corresponding additions in such a way that there are no overlaps between the lists of goods and services.

(4) The German Patent and Trademark Office produces a complete copy of the files of the exit application. This copy, together with the declaration of division, forms part of the file of the segregated declaration. The separate application will receive a new file number. A copy of the division declaration is taken to the files of the parent application.

(5) A representative of the applicant designated for the exit application shall also be deemed to be the applicant's representative for the separate application. The submission of a new power of attorney is not required.

(6) Applications filed with respect to the original application shall also continue to apply to the segregated application.

#### **§ 36 Division of registrations**

(1) Under Section 46(1) of the Trade Mark Act, a registered trade mark may be divided into two or more registrations. A separate division declaration shall be submitted for each separated part. The declaration of division

is to be filed using the form issued by the German Patent and Trademark Office.

- (2) The division declaration shall indicate the goods and services that are included in the separate registration.
- (3) The list of goods and services of the remaining parent registration and the list of goods and services of the segregated registration must be identical overall to the list of goods and services of the initial registration existing at the time of receipt of the division declaration. Where the division relates to goods and services covered by a generic term, the generic term shall be used both in the parent registration and in the separate registration and shall be limited by corresponding additions in such a way that there are no overlaps between the lists of goods and services.
- (4) The German Patent and Trademark Office produces a complete copy of the files of the initial registration. This copy, together with the declaration of division, forms part of the file of the segregated registration. The separate entry will be given a new registration number. A copy of the division declaration is taken to the file of the main registration.
- (5) A representative of the proprietor of the trade mark designated for the initial registration shall also be deemed to be the representative of the proprietor of the trade mark for the separate registration. The submission of a new power of attorney is not required.
- (6) Applications filed with respect to the original registration shall also continue to apply to the segregated registration.
- (7) If opposition has been filed against the registration of a trade mark whose division has been declared pursuant to Section 46 of the Trade Marks Act, the German Patent and Trade Mark Office shall request the opponent to explain which parts of the original registration the opposition is directed against. The proprietor of the registered trade mark may also, on his own initiative, submit a corresponding declaration by the opponent. If such a declaration is not made, the division declaration shall be rejected as inadmissible.

#### **Footnote**

(+++ § 36(1) to (4) and (6): For application, see § 33(2) +++)

### **Section 3 Prolongation**

#### **§ 37 Extension by fee payment**

When paying the renewal fees pursuant to Section 47(3) of the Trade Marks Act, the registration number and the name of the proprietor of the trade mark and the intended purpose must be indicated.

#### **§ 38 Application for partial extension**

- (1) If the extension of the term of protection of a registered trade mark is to be effected only in respect of part of the goods and services in respect of which the trade mark is registered, the proprietor of the trade mark may submit an application to that effect.
- (2) The application shall specify:
  1. the registration number of the trade mark whose term of protection is to be extended;
  2. the name and address of the proprietor of the trade mark,
  3. if a representative is appointed, the name and address of the representative,
  4. the goods and services for which the term of protection is to be extended.

### **Section 4 Renunciation**

#### **§ 39 Renunciation**

- (1) The application for complete or partial cancellation of a trade mark pursuant to Section 48(1) of the Trade Mark Act shall be made using the form issued by the German Patent and Trade Mark Office.
- (2) The application shall specify:
  1. the registration number of the trade mark to be deleted in whole or in part;
  2. the name and address of the proprietor of the trade mark,
  3. if a representative is appointed, the name and address of the representative,
  4. if partial deletion is requested, either the goods and services to be deleted or the goods and services for which the trade mark is not to be deleted.

## **§ 40 Consent of third parties**

For the consent of a holder of a right to the trade mark registered in the register pursuant to Section 48(2) of the Trade Mark Act, the submission of a declaration of consent signed by that person or his representative is sufficient. Certification of the declaration or signature is not required. Consent can also be proven in other ways.

## **Section 5 Erasure**

### **§ 41 Decay**

- (1) The application for a declaration of revocation of a trade mark pursuant to Section 53(1) of the Trade Mark Act shall be made using the form issued by the German Patent and Trade Mark Office.
- (2) The application shall specify:
  1. the registration number of the trade mark whose declaration of revocation is requested;
  2. the name and address of the applicant;
  3. if the applicant has appointed a representative, the name and address of the representative;
  4. where the declaration of revocation is requested only in respect of part of the goods and services in respect of which the trade mark is registered, either the goods and services in respect of which the declaration of invalidity is sought or the goods and services for which the declaration of invalidity is not sought, and
  5. the grounds for revocation pursuant to Section 49 of the Trade Marks Act.

### **§ 42 Invalidity due to absolute grounds for refusal and older rights**

- (1) Section 41 of this Ordinance shall apply mutatis mutandis to the application for invalidity on the grounds of absolute grounds for refusal and earlier rights pursuant to Section 53(1) of the Trade Marks Act.
- (2) In addition to the information referred to in Section 41(2), the following information shall be provided:
  1. in the case of an application for invalidity due to older rights pursuant to Section 53(1) of the Trade Marks Act: Information which makes it possible to establish the identity of the earlier right; and
  2. in the case of an application pursuant to Section 53(3) of the Trade Marks Act: Information enabling the holder of the earlier right to be identified.

In the case of no earlier rights applied for or registered, at least the nature, the representation, the form, seniority, the subject matter and the holder shall be indicated.

- (3) For the application for invalidity on the basis of earlier rights pursuant to Section 53(1) of the Trade Marks Act, the facts and evidence used for reasons must also be provided.
- (4) Unless already necessary for the identification of the earlier right pursuant to paragraph 2 sentence 1 number 1 or for the identification of the holder pursuant to subsection (2) sentence 1 number 2, please indicate for all applications:
  1. the registration number of an earlier registered trade mark, the reference number of an earlier trade mark applied for or the dossier number of the protected designation of origin or geographical indication;
  2. Information showing that the applicant, who is not the proprietor of the earlier right under Paragraph 53(3) of the Trade Marks Act, is entitled to invoke it in invalidity proceedings;
  3. the representation and designation of the form of the earlier right,
  4. if the earlier right is an internationally registered trade mark, its registration number as well as internationally registered earlier marks registered before 3 October 1990 with effect for both the Federal Republic of Germany and the German Democratic Republic, the declaration on which those registrations are based,
  5. the name and address of the holder of the earlier right.

## **Section 6 Licence**

### **Section 42a Registration of a licence**

- (1) The application for registration of the grant of a licence pursuant to Section 30(6) sentence 1 of the Trade Mark Act shall be made using the form provided by the German Patent and Trade Mark Office.
- (2) The application shall specify:
  1. the registration number of the trade mark under which the licence is to be entered;

2. the name of the trade mark proprietor,
3. Information about the licensee in accordance with § 5,
4. Whether it is an exclusive or a simple license,
5. Whether it is a sub-licence of the licensee registered in the register;
6. Information on a limitation in time, space or subject matter; if the licence has been limited to part of the goods and services, the goods and services for which the licence was granted.

(3) The consent of the trade mark owner or the licensee required pursuant to Section 30(6) of the Trade Mark Act shall be in writing.

#### **§ 42b Modification or cancellation of a license**

The application for amendment or cancellation of a licence registered in accordance with Section 30(6) of the Trade Mark Act must contain the registration number of the trade mark and the name of the licence to be amended or deleted.

#### **§ 42c Declaration of Licensing or Sale**

(1) The applicant or the trade mark proprietor registered in the register may declare in writing to the German Patent and Trademark Office its non-binding readiness to grant licences or to sell trademark law. The declaration shall be entered in the register.

(2) The declaration of willingness to grant licences is inadmissible as long as there is a note on the grant of an exclusive licence in the register or as long as there is an application for registration of such a note to the German Patent and Trade Mark Office.

(3) Declarations pursuant to paragraph 1 may be withdrawn in writing to the German Patent and Trademark Office at any time.

### **Part 5**

#### **International registrations**

##### **§ 43 (disappeared)**

##### **§ 44 Applications and other communications in the international registration procedure under the Protocol to the Madrid Trade Mark Agreement**

The official forms issued by the International Bureau of the World Intellectual Property Organisation shall be used for applications and other notifications in accordance with Article 3 of the Protocol to the Madrid Trade Mark Agreement issued by the International Bureau of the World Intellectual Property Organisation.

##### **§ 45 (disappeared)**

##### **§ 46 Refusal of protection**

(1) Where an internationally registered trade mark whose protection has been extended to the territory of the Federal Republic of Germany pursuant to Article 3ter of the Protocol to the Madrid Trade Mark Agreement is refused protection in whole or in part and such refusal is transmitted to the International Bureau of the World Intellectual Property Organisation for transmission to the holder of the international registration, the period within which a domestic representative must be appointed in order not to be definitively refused shall be fixed at four months from the date of dispatch of the notification of refusal by the International Bureau of the World Intellectual Property Organisation.

(2) If the refusal of protection becomes final because the proprietor of the internationally registered trade mark has not appointed a domestic representative, a reminder or appeal against the refusal of protection shall be lodged with the German Patent and Trade Mark Office within a further month after the expiry of the period referred to in paragraph 1. The refusal of protection must be accompanied by a corresponding notice of appeal. Section 61(2) of the Trade Marks Act shall apply mutatis mutandis.

## **Part 6**

### **Procedure under Regulation (EU) No 1151/2012**

#### **Section 1**

##### **Registration procedure**

##### **§ 47 Application for registration**

(1) The application for registration of a geographical indication or designation of origin pursuant to Article 49 of Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs (OJ L 343, 14.12.2012, p. 1), as amended, must be filed using the form issued by the German Patent and Trade Mark Office.

(2) The application shall specify:

1. the name and address of the applicant;
2. the legal form, size and composition of the association making the application;
3. where a representative has been appointed, the name and address of the representative,
4. the name to be protected as a geographical indication or designation of origin;
5. the type of agricultural product or foodstuff;
6. the specification referred to in Article 7(1) of Regulation (EU) No 1151/2012 in accordance with the form.

##### **§ 48 Publication of the application**

(1) The publication of the application (Section 130(4) of the Trade Marks Act) must state at least:

1. the name and address of the applicant;
2. where a representative has been appointed, the name and address of the representative,
3. the name to be protected as a geographical indication or as a designation of origin;
4. the type of agricultural product or foodstuff;
5. the specification referred to in Article 7(1) of Regulation (EU) No 1151/2012.

(2) The publication should refer to the possibility of opposition under Section 130(4) of the Trade Marks Act in conjunction with Article 49(3) of Regulation (EU) No 1151/2012.

##### **§ 49 National objection**

(1) The opposition pursuant to Section 130(4) of the Trade Marks Act in conjunction with Article 49(3) of Regulation (EU) No 1151/2012 shall be filed using the form issued by the German Patent and Trade Mark Office.

(2) The notice of opposition shall state:

1. the geographical indication or designation of origin against which the opposition is directed;
2. the name and address of the opponent,
3. where a representative has been appointed, the name and address of the representative,
4. the circumstances giving rise to the opponent's legitimate interest,
5. the grounds on which the opposition is based.

#### **Section 2**

### **Intergovernmental opposition proceedings pursuant to Section 131 of the Trade Marks Act**

##### **§ 50 Objection**

(1) The opposition pursuant to Section 131 of the Trade Marks Act in conjunction with the second subparagraph of Article 51(1) of Regulation (EU) No 1151/2012 shall be filed using the form issued by the German Patent and Trade Mark Office.

(2) The notice of opposition shall state:

1. the geographical indication or designation of origin against which the opposition is directed;
2. the EC number and the date of publication in the Official Journal of the European Union,
3. the name and address of the opponent,
4. where a representative has been appointed, the name and address of the representative,
5. the circumstances giving rise to the opponent's legitimate interest.



(3) The opposition shall be substantiated within two months of filing. The grounds referred to in Article 10(1) of Regulation (EU) No 1151/2012 on which the opposition is based shall be given.

### **§ 51 Opposition proceedings**

The German Patent and Trademark Office shall inform the Federal Ministry of Justice and Consumer Protection immediately after the expiry of the opposition period of the objections received by sending the objections with the required documents. Post-submitted grounds of opposition shall be forwarded immediately.

## **Section 3**

### **Amendments to the specification; Deletion; Access to files**

#### **§ 52 Amendments to the specification**

(1) The request for amendment of the specification pursuant to Article 53 of Regulation (EU) No 1151/2012 is to be filed using the form issued by the German Patent and Trade Mark Office.

(2) The application shall specify:

1. the registered geographical indication or designation of origin;
2. the name and address of the applicant;
3. Legal form, size and composition of the applicant association,
4. where a representative has been appointed, the name and address of the representative,
5. Circumstances giving rise to the applicant's legitimate interest;
6. the headings of the specification to which the amendments relate;
7. the proposed amendments and their justification.

(3) Furthermore, Sections 48 to 51 shall apply mutatis mutandis to applications pursuant to the first sentence of Article 53(2) of Regulation (EU) No 1151/2012.

#### **§ 53 Request for cancellation**

(1) The application for cancellation of a registered geographical indication or designation of origin pursuant to Article 54(1) of Regulation (EU) No 1151/2012 shall be filed using the form issued by the German Patent and Trade Mark Office.

(2) The application shall specify:

1. the geographical indication or designation of origin to be deleted;
2. the name and address of the applicant;
3. if a representative is appointed, the name and address of the representative,
4. Circumstances giving rise to the applicant's legitimate interest;
5. Reasons for deletion.

#### **§ 54 Access to files**

In the proceedings under Regulation (EU) No 1151/2012, the German Patent and Trade Mark Office grants access to the files.

#### **§ 55 (disappeared)**

## **Part 7**

### **Final provisions**

#### **§ 56 Transitional arrangements on the occasion of the entry into force of this Regulation**

Trade mark applications filed before the entry into force of this Regulation shall be subject to the provisions of the Trade Mark Ordinance of 30 November 1994 (BGBl. I p. 3555), as last amended by the Ordinance of 1 September 2003 (BGBl. I p. 1701).

#### **§ 57 Transitional arrangements for future amendments**

Trade mark applications filed prior to the entry into force of amendments to this Regulation shall be subject to the provisions of this Regulation, as amended until then.

**§ 58 Entry into force, expiry**

This Regulation shall enter into force on 1 June 2004.