

Germany
Trade Mark Act

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Part 1 Scope

Section 1 Protected Trademarks and other symbols

The following shall be protected in accordance with this Act:

1. Trademarks,
2. business names,
3. indications of geographical origin.

Section 2 Application of other provisions

The protection of Trademarks, business names 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 Trademarks and business names, transfer and licence

Chapter 1 Trademarks and business names, priority and seniority

Section 3 Signs eligible for protection as Trademarks

(1) All signs, particularly words including personal names, designs, letters, numerals, sounds, 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 Trademarks if they are capable of distinguishing the goods or services of one enterprise from those of other enterprises.

(2) Symbols consisting exclusively of shapes or other characteristic features

1. which are due to the nature of the goods themselves,
 2. which are necessary to obtain a technical result or
 3. which give substantial value to the goods
- are not eligible for trademark protection.

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 German Patent and Trademark 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 Business names

(1) Company symbols and titles of works shall enjoy protection as business names.

(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 (2) and (3).

(2) The date of application (section 33(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 Trademarks 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 (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 Trademarks by means of registration

Section 7 Proprietorship

Proprietors of Trademarks 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 grounds for refusal

(1) Symbols which can be protected as a trademark within the meaning of Section 3 which cannot be represented in the register in such a way that the competent authorities and the public can clearly and unambiguously determine the subject of the protection shall be excluded from registration.

(2) The following Trademarks 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,
8. which contain coats of arms, flags or other symbols, seals or designations of international intergovernmental organisations,
9. which are excluded from registration under German law, under European Union legislation or under international agreements to which

the European Union or the Federal Republic of Germany is a party and which protect designations of origin and geographical indications,
10. which are excluded from registration under European Union legislation or international agreements to which the European Union is a party and which serve to protect traditional names for wines,
11. which are excluded from registration under European Union legislation or international agreements to which the European Union is a party and which serve to protect traditional specialties,
12. which consist of, or reproduce in their essential elements, a previous variety denomination registered in accordance with German law, European Union law or international agreements to which the European Union or the Federal Republic of Germany is a party, relating to plant variety rights and relating to plant varieties of the same species or closely related species,
13. the use of which can evidently be prohibited in the public interest in accordance with other provisions, or
14. which have been applied for in bad faith.

(3) (2) 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) (2) 6, 7 and 8 shall also be applied if the trade mark contains the imitation of a sign listed there. (2) 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. (2) 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. (2) 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 organization.

Section 9 Trademarks 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 Trademarks, 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 Trademarks, 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 Trademarks shall only constitute a ground for refusal within the meaning of (1) if they are registered.

(3) Goods and services shall not be considered similar solely because they appear in the same class according to the classification system (Nice Classification) established in the May 13, 1977 Geneva version of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957 (German Federal Law Gazette 1981 II p. 358, 359). Goods and services shall not be considered to be dissimilar solely because they appear in different classes of the Nice Classification.

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(1) 1, 2 or 3 are met.

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

Section 11 Trademarks registered in the name of an agent

The registration of a trademark may be cancelled if the trademark has been registered for the trademark owner's agent or representative without the consent of the owner, unless there is a justifiable reason

for the conduct of the agent or representative.

Section 12 Trademarks and business names 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 business name 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 (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 owner of a trademark, injunctive relief, claim for damages

(1) The acquisition of trademark protection pursuant to Section 4 grants the owner of the trademark an exclusive right.

(2) Third parties are prohibited, without the consent of the owner of the trademark, from using in the course of trade in relation to goods or services

1. a symbol that is identical to the trademark in relation to goods or services identical to those for which it enjoys protection,

2. a symbol if the symbol is identical or similar to a trademark and is used in relation to goods or services which are identical or similar to those covered by the trademark, and there exists a likelihood of confusion on the part of the public, which includes the likelihood of association between the symbol and the trademark; or

3. a symbol identical or similar to the trademark for goods or services if the trademark is a trademark with a reputation in the domestic market and the use of the symbol without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the reputed trademark.

Goods and services shall not be considered similar solely because they appear in the same class according to the classification system established in the Nice Classification. Goods and services shall not be considered to be dissimilar solely because they appear in different classes of the Nice Classification.

(3) If the prerequisites of (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. the symbol as a trade name or business name or as part of a trade name or business name,

6. the symbol in business documents or advertising,

7. the symbol in comparative advertising in a manner contrary to Directive 2006/114/EC of the European Parliament and of the Council of December 12, 2006 concerning misleading and comparative advertising

(OJ L 376, 12/27/2006, p. 21).

(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 (2) and (3).

(5) Anyone using a sign in contravention of (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 14a Goods under customs supervision

(1) The owner of a trademark or a business name shall be entitled to

prohibit third parties from bringing goods into the territory of the Federal Republic of Germany in the course of trade without releasing the goods into free circulation there, if the goods, including their packaging, originate from third countries and bear, without consent, a trademark or a business name which is identical with the trademark or business name registered for such goods or which cannot be distinguished in its essential aspects from that trademark or business name.

(2) The entitlement of the owner of the trademark or business name pursuant to paragraph 1 shall cease if, during proceedings to determine whether a registered trademark or business name has been infringed, initiated pursuant to Regulation (EU) No. 608/2013 of the European Parliament and of the Council of June 12, 2013 concerning the enforcement of intellectual property rights by customs authorities and repealing Council Regulation (EC) No 1383/2003 (OJ L 181, 06/29/2013, p. 15), the customs declarant or the owner of the goods proves that the owner of the registered trademark or business name is not entitled to prohibit the marketing of the goods in the country of final destination.

Section 15 Exclusive right of the proprietor of a business name, right to an injunction, compensation claim

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

(2) Third parties shall be prohibited from using the business name 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 business name is a business name which has a reputation in this country, third parties shall be furthermore prohibited from using the business name or a similar sign in the course of trade if there is no likelihood of confusion within the meaning of (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 business name.

(4) Anyone who uses a business name or a similar sign in contravention of (2) or (3) may be required to refrain therefrom by the proprietor of the business name 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 business name for compensation for the damage incurred thereby. Section 14 (6) sentences 2 and 3 shall apply mutatis mutandis.

(6) Section 14 (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, encyclopedia 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 (1) being included in a new edition of the work.

(3) (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 (7) shall be applied mutatis mutandis.

(3) Paragraphs 1 and 2 shall not apply if there are grounds for justifying the conduct of the agent or representative.

Section 18 Destruction and re-call rights

(1) The proprietor of a trade mark or of a business name 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 business name 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 (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 business name 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 business name has lodged an action against the infringer, the right shall also apply, regardless of (1), vis-a-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 No. 1, 2 or 3 was involved in the production, manufacture or commercialization 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 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 (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 business name with compensation for the damage incurred thereby.

(6) Anyone who has provided truthful information without having been obliged to do so in accordance with (1) or (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 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(1) of the Code of Criminal Procedure .

(9) If the information can only be provided using traffic data (section 3 No. 30 of the Telecommunications Act), 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 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) (2) in conjunction with (9) restricts the fundamental right of the privacy of telecommunications (Article 10 of the Basic Law).

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 business name 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 an 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 (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(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 (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 business name may also require the infringer in the event of an infringement of rights committed on a commercial scale in cases falling under section 14(6), section 15(5), as well as section 17(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 (1) shall be ruled out if the claim is disproportionate in the individual case.

(3) The obligation to submit the documents designated in (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(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 business name 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 business name shall not be entitled to prohibit the use of a trade mark within the meaning of section 4 No. 2 or 3, of a business name 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 (1) and (2), the proprietor of the right with younger seniority may not prohibit the use of the right with older seniority.

(4) (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 business name 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 declaration of invalidity of the trade mark with younger seniority has been rejected or would have to be refused

1. because the trade mark or business name with older seniority did

not yet have a reputation within the meaning of section 9(1) No. 3, of section 14(2) No. 3 or of section 15(3) on the date material for the seniority of the registration of the trade mark with younger seniority (section 51(3)),

2. because the registration of the trade mark with older seniority could have been cancelled or declared invalidity because of revocation or because of absolute grounds for refusal on the date of the publication of the registration of the trade mark with younger seniority (section 51(4)).

3. because on the date relevant for the seniority of the registration of the later trademark there was no likelihood of confusion within the meaning of Section 9(1) No. 2, Section 14(2) No. 2, or Section 15(2).

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

Section 23 Use of names and descriptive information; spare parts business

(1) The owner of a trademark or business name may not prohibit a third party from using the following in the course of trade:

1. the name or address of the third party, if the third party is a natural person,

2. a symbol identical or similar to the trademark or business name which is devoid of any distinctive character, or an identical symbol or similar symbol as an indication of characteristics or qualities of goods or services, such as, in particular, their kind, quality, intended purpose, value, geographical origin or the time of their production or rendering, or

3. the trademark or business name for purposes of identifying or referring to goods or services as those of the owner of the trademark, in particular when the use of the trademark is necessary as an indication of the destination of a good, in particular as an accessory or spare part, or of a service.

(2) Paragraph 1 shall apply only if the use by the third party is in accordance with honest practices in trade or commerce.

Section 24 Exhaustion

(1) The proprietor of a trade mark or of a business name shall not be

entitled to prohibit a third party from using the trade mark or the business name for goods which have been put on the market under this trade mark or this business name 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) (1) shall not apply if the proprietor of the trade mark or of the business name opposes the use of the trade mark or of the business name 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 claims for lack of use

(1) The owner of a registered trademark may not bring claims against third parties within the meaning of Sections 14 and 18 to 19c if the trademark has not been used pursuant to Section 26 for the goods or services on which it relies in support of its claim within the five years preceding the date on which the claim is brought, provided that at that date no opposition to the trademark had been possible for at least five years.

(2) Where claims within the meaning of Sections 14 and 18 to 19c are brought by way of action for infringement of a registered trademark, the plaintiff shall, upon objection by the defendant, establish that the trademark has been used pursuant to Section 26 for the goods or services on which it relies in support of its claim within the five years preceding the bringing of the action or that there are proper reasons for non-use, provided that, at the time when the action was brought, no opposition to the trademark had been possible for at least five years. If the period of five years of non-use ends after the action has been brought, the plaintiff shall, upon objection by the defendant, prove that the trademark has been used within the five years preceding the conclusion of the oral proceedings pursuant to Section 26 or that there were proper reasons for non-use. Only those goods or services for which use has been proven shall be considered in the decision.

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) Use of a registered trademark, regardless of whether the trademark in the form used is also registered in the name of the owner, shall also include use of the trademark in a form which deviates from the registration, provided that the deviation does not alter the distinctive character of the trademark.

(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) To the extent that use is required within five years from the date on which opposition to the trademark is no longer possible, the date on which the decision terminating the opposition proceedings has become final or the date on which the opposition has been revoked shall take the place of the expiry of the opposition period in cases where opposition to the registration has been submitted.

Chapter 5 Trademarks 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 trademark is held by a business or a part of a business, the right established by the registration, the use or the well-known character of the trademark shall, in case of doubt, be covered by the transfer or assignment of the business or the part of the business to which the trademark belongs. This shall apply mutatis mutandis to the legal obligation to transfer a business or part of a business.

(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 German Patent and Trademark 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(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 German Patent and Trademark Office, in appeal proceedings before the Federal 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 German Patent and Trademark Office has received the application for the registration of the transfer. Sentence 1 shall apply mutatis mutandis to other proceedings before the German Patent and Trademark Office, to appeal proceedings before the Federal 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 German Patent and Trademark 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 German Patent and Trademark 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 (1) No. 1 or the measures referred to in (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 German Patent and Trademark 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), 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 bring an action for infringement of a trademark only with the consent of its owner. Contrary to sentence 1, the owner of an exclusive license may bring an action for infringement of a trademark if the owner of the trademark, after being formally requested to do so, has not itself brought an action for infringement of a trademark within a reasonable period of time.

(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 (1) shall not affect the licences which have previously been issued to third parties.

(6) At the request of the owner of the trademark or the licensee, the German Patent and Trademark Office shall enter the granting of a license into the register if it is demonstrated that the other party has given its consent. The same applies to the amendment of a registered license. The registration shall be cancelled upon the request of the owner of the trademark or the licensee. The cancellation request by the owner of the trademark requires proof of the consent of the designated licensee at the time of registration or its legal successor.

Section 31 Trademarks applied for

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

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 German Patent and Trademark 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 and consumer protection in the Federal Law Gazette to accept trade mark applications.

(2) The application must contain:

1. an application for registration,
2. information which allows the identity of the applicant to be established,
3. a representation of the trademark which is not subject to the grounds for refusal pursuant to section 8(1), and
4. a list of goods or services for which registration is sought.

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

Section 33 Date of application, right to registration, publication of the application

(1) The submission date of a trademark shall be the date on which the applicant submits the application with the German Patent and Trade Mark Office with the information pursuant to section 32(2). Receipt of the application documents at a patent information center designated by notice of the Federal Ministry of Justice and Consumer Protection in the Federal Law Gazette to receive trademark applications shall be deemed as receipt by the German Patent and Trademark Office.

(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 which contains all the information

required by section 32(2) 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 and consumer protection in the Federal Law Gazette the other state on the basis of a first application to the German Patent and Trademark 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 (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 German Patent and Trademark 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 revoked.

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 recognized 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 (1) No. 1 shall be announced by the Federal Ministry of Justice and consumer protection in the Federal Gazette.

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

(4) Anyone claiming priority in accordance with (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 German Patent and Trademark 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 (1) shall not extend the priority period in accordance with section 34.

Section 36 Examination of the prerequisites for application

(1) the German Patent and Trademark 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(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 shortcomings in the application, established pursuant to paragraph (1)1, are not remedied within a period specified by the German Patent and Trade Mark Office, the application shall be deemed to be revoked. If the shortcomings found are remedied within the time limit, the submission date shall be the date on which the shortcomings were remedied.

(3) If class fees are not subsequently paid within a period set by the German Patent and Trademark 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 German Patent and Trademark Office, the German Patent and Trademark Office shall reject the application.

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

Section 37 Examination for absolute grounds for refusal

(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(1)) did not meet the prerequisites of section 8(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(2).

(3) An application shall be refused in accordance with section 8(2) No. 4 or No. 14 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(1) No. 1 or 2 apply.

(5) (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.

(6) Natural or legal persons as well as associations of manufacturers, producers, service providers, traders and consumers may submit written comments to the German Patent and Trademark Office before the trademark is registered, explaining the reasons why the trademark should not be registered. Persons and associations may also file written comments with the German Patent and Trademark Office explaining the reasons for which the application for a collective or certification trademark should be rejected. The persons and associations shall not be involved in the proceedings at the German Patent and Trademark Office.

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 separate application will be considered withdrawn under the German Patent Costs Act if the fee is not paid within three months of the receipt of the declaration of division. This declaration of division cannot be revoked.

Section 41 Registration, publication and trademark information

(1) The trademark applied for will be recorded in the register if the application complies with the registration requirements and has not been declined in accordance with section 37.

(2) The registration will be published. The publication can be issued in electronic format.

(3) For further processing or use for purposes of trademark information, the German Patent and Trademark Office may convey to third parties in electronic form any information entered in the register. This will not be transmitted, if an inspection is excluded in accordance with section 62(4).

Section 42 Opposition

(1) Within a period of three months from the date of publication of the registration of the trade mark pursuant to section 41(2), an opposition to the registration of the trademark may be submitted by the owner of a trademark or business name with earlier priority. Within this period, opposition to the registration of the trademark may also be submitted by persons entitled to claim rights under a protected designation of origin or a protected geographical indication with earlier priority.

(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 business name with older seniority in accordance with section 5 in conjunction with section 12.
5. on account of a designation of origin or geographical indication with earlier priority in connection with section 13.

(3) An opposition may be submitted on the basis of an earlier right or several earlier rights if these rights belong to the same owner.

(4) The parties to the opposition proceedings shall, at the request of both parties, be granted a period of at least two months in which to reach an amicable settlement.

Section 43 Objection of insufficient use, decision on the opposition

(1) If the opposition has been submitted by the owner of a registered trademark with earlier priority, it shall, if the opponent raises the objection of non-use, prove that the trademark has been used pursuant

to section 26 within the last five years preceding the submission date or priority date of the trademark against which the opposition is directed, provided that at that date no opposition to it has been possible for at least five years. Proof can also be provided by means of an affidavit. Only goods and services for which use has been proven will be considered in the decision.

(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 Trademarks 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(2) and (3) shall be applied mutatis mutandis in the event of cancellation in accordance with (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 (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) (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 be declared only after the end of the opposition submission deadline. The declaration shall be admissible only if an opposition to the registration to the trademark pending at the time of its submission or an action for revocation or declaration of invalidity which is pending at that time or an application for revocation or for a declaration of invalidity of the trademark submitted at that time would, after the division, be directed against only one of the parts of the original registration.

(3) Failure to pay the fee under the German Patent Costs Act for the division proceedings within three months of receipt of the declaration of division shall be deemed a waiver of the separate registration. The declaration of division cannot be withdrawn.

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(1)) and shall end ten Years after that.

(2) The registration of the trademark shall be renewed for ten-year periods at the request of the trademark owner or a person authorized to do so by law or contract, provided that the renewal fee has been

paid.

(3) Renewal of the duration of protection may be carried out by paying the extension fee and a class fee for each class to be extended from the fourth class of the classification of the goods and services. Receipt of the payment shall be deemed to be an application by the trademark owner or an authorized person pursuant to paragraph 2.

(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 priority. In other respects, the classes shall be taken into account in the order of the classification.

(5) The German Patent and Trademark Office shall notify the trademark owner at least six months in advance of the expiration of the term of protection. The German Patent and Trademark Office shall not be liable for any failure to inform.

(6) The application for renewal should be submitted within a period of six months before the end of the term of protection. The application may still be submitted within a grace period of six months after the end of the term of protection.

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

(8) 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 trademark shall be revoked and cancelled upon request if the trademark has not been used pursuant to section 26 within an uninterrupted period of five years after the date from which opposition thereto is no longer possible. However, revocation of a trademark may not be claimed if, after the end of that period and before the submission of the revocation application, use of the trademark pursuant to section 26 has begun or resumed. However, if the use begins or is resumed following an uninterrupted period of five years of non-use within three months prior to the submission of the revocation application, it shall be disregarded, provided that the preparations for the first or renewed use took place only after the owner of the trademark became aware that the revocation application may be submitted. If the revocation application pursuant to section 53(1) is submitted to the German Patent and Trademark Office, the application submitted to the German Patent and Trademark Office shall remain decisive for the calculation of the three-month period pursuant to sentence 3 if the revocation action pursuant to section 55(1) is submitted within three months after the notification pursuant to section 53(4) has been served.

(2) The registration of a trademark is declared lapsed and deleted upon request.

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 and deleted for these goods or services.

Section 50 Invalidity because of absolute grounds for refusal

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

(2) If the trademark has been registered contrary to section 3, 7 or 8(2)No. 1 to No. 13, the registration may be declared invalidity and cancelled only if the grounds for refusal still exists at the time of the decision on the application for invalidity. section 8(2) No. 1, No. 2 or No. 3 shall not apply in invalidity proceedings if, by the date of the application for invalidity, the trademark has become established with the relevant public as a result of the use which has been made of it in relation to the goods or services for which it was registered. If the trademark has been registered contrary to section 8(2) No. 1, No. 2 or No. 3, the registration may be cancelled only if the application for invalidity is submitted within ten years from the date of registration.

(3) The registration of a trade mark may be declared invalidity and cancelled if it has been registered in contravention of section 8(2) No. 4 to 14, and

1. the invalidity 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(2) No. 4 to 13 continues to exist at the time of the decision on the declaration of invalidity, 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 declared invalidity and cancelled for these goods or services.

Section 51 Invalidity because of the existence of earlier rights

(1) The registration of a trademark shall be declared invalidity and cancelled upon an action pursuant to section 55 or an application pursuant to section 53 if it is opposed by a right within the meaning of sections 9 to 13 with earlier priority. The application for a declaration of invalidity may also be based on several earlier rights held by the same owner.

(2) The registration may not be declared invalidity and 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 business name within the meaning of section 5 or in a name of a plant variety within the meaning of section 13(2) No. 4. The registration of a trade mark may further not be declared invalidity and 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 declaration invalidity and cancellation.

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

(4) Registration shall not be declared invalidity and cancelled on the basis of the registration of a trademark with earlier priority if the registration of the trademark with earlier priority could have been revoked or declared invalidity and cancelled on the submission date

or priority date of the trademark with later priority for the following reasons:

1. revocation pursuant to section 49 or
2. absolute grounds for refusal pursuant to section 50.

For the examination of the likelihood of confusion pursuant to section 9(1) No. 2, the distinctive character of the earlier trademark upon the submission date or priority date of the later trademark shall be taken into account.

(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 declared invalidity and cancelled for these goods or services.

Section 52 Effects of expiration and invalidity

(1) The effects of a registered trademark shall, to the extent that the trademark is revoked, be deemed not to have occurred from the application submission date (section 53) or submission of the revocation action (section 55). The decision may, at the request of a party, fix an earlier date on which one of the grounds for revocation occurred.

(2) The effects of a registered trademark shall be deemed not to have occurred from the beginning to the extent that the trademark has been declared invalidity.

(3) Subject to the provisions on compensation for damage caused by the negligent or intentional conduct of the owner of a trademark and the provisions on unjust enrichment, cancellation of registration on the grounds of revocation or invalidity of the trademark

1. shall not affect decisions in infringement proceedings which have become final and have been enforced prior to the decision on the application for revocation or invalidity

2. and contracts concluded prior to the decision on the application for revocation or invalidity to the extent that they have been effected prior to that decision. However, it may be necessary that amounts paid in performance of the contract be refunded on equitable grounds to the extent justified by the circumstances.

Section 53 Cancellation by the German Patent and Trademark Office because of revocation

(1) The application for cancellation because of revocation (section 49) may be lodged with the German Patent and Trademark Office, without prejudice to the right to assert the application by means of an action in accordance with section 55.

(2) The German Patent and Trademark Office shall inform the proprietor of the registered trade mark of the application and shall call on him/her to inform the German Patent and Trademark 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 German Patent and Trademark 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 German Patent and Trademark Office because of absolute grounds for refusal

(1) The application for cancellation because of absolute grounds for refusal (section 50) shall be lodged with the German Patent and Trademark 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 German Patent and Trademark 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 Revocation and declaration of invalidity proceedings before the courts of ordinary jurisdiction

(1) A revocation action (section 49) or a declaration of invalidity due to the existence of earlier rights (section 51) shall be brought against the person registered as owner of the trademark or its

successor in title. The action shall be inadmissible if the same subject of the dispute has already

1. been decided between the parties pursuant to section 53,
2. an application pursuant to section 53 has been submitted with the German Patent and Trademark Office.

section 325(1) of the German Code of Civil Procedure shall apply mutatis mutandis.

(2) The following shall be entitled to lodge the action:

1. in cases of an application for declaration of revocation, any person,
2. in cases of an application for declaration of invalidity 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 declaration of invalidity because of the existence of an indication of geographical origin with older seniority (section 13(2) No. 5), the party entitled to assert rights in accordance with section 8(3) of the Act Against Unfair Competition .

(3) Where action for a declaration of invalidity has been brought by the owner of a registered trademark of earlier priority, it shall, upon objection by the defendant, provide proof that the trademark has been used within the last five years preceding the action being brought pursuant to section 26, provided that at that time no opposition to it had been possible for at least five years. If the period of five years of non-use ends after the action has been brought, the plaintiff shall prove, upon objection by the defendant, that the trademark has been used within the five years preceding the conclusion of the oral proceedings pursuant to section 26. If the trademark with earlier priority had already been registered for at least five years on the submission date or priority date of the later trademark, the plaintiff must also prove, upon objection by the defendant, that the registration of the trademark with earlier priority could not have been declared invalidity and cancelled on that date pursuant to section 49(1). Only those goods or services for which use has been proven shall be considered 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 shall apply mutatis mutandis to

the power of the successor to accede to the legal dispute.

(5) The court shall notify the German Patent and Trademark Office of the submission date of the action. The German Patent and Trademark Office shall record the submission date of the action in the register. The court shall send a copy of the final judgment to the German Patent and Trademark Office. The German Patent and Trademark Office shall enter the result of the proceedings in the register with the date of legal effect.

Chapter 4 General provisions for the proceedings before the German Patent and Trademark Office

Section 56 Competences in the German Patent and Trademark Office

(1) Trade mark sections and trade mark divisions shall be established in the German Patent and Trademark 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 Trademarks 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 German Patent and Trademark 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(2) to the Federal 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 German Patent and Trademark 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 declaration of expiry or invalidity of a trade mark in accordance with section 53, 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(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 German Patent and Trademark 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 Trademarks 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 German Patent and Trademark office shall not be empowered without the consent of the Federal Ministry of Justice and consumer protection to give orders or to submit expert reports outside the scope of its statutory tasks.

Section 59 Ascertaining the facts, legal hearing

(1) The German Patent and Trademark 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 German Patent and Trademark 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 German Patent and Trademark Office may at any time summon and hear the parties involved, examine witnesses, experts and parties involved under oath or not under oath, examine the evidence, assess the probative value of a document submitted and carry out other investigations necessary to clarify the matter. The provisions of Book 2 of the German Code of Civil Procedure concerning such evidence shall apply mutatis mutandis.

(2) Until the decision closing the proceedings is made, the applicant for or owner of the trademark or any other party to the proceedings shall, upon request, be heard if this is relevant. If the German Patent and Trademark Office does not consider this party being heard to be relevant, it shall reject the request. The order rejecting the request shall not be subject to appeal in its own right. In revocation or invalidity proceedings, a hearing shall be held if requested by a party or if the German Patent and Trademark Office considers it

relevant.

(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) The decisions of the German Patent and Trademark Office must be justified and delivered to the parties ex officio in copy, even if they have been announced in accordance with clause 3; a certified copy will not be required. Any copies will only be issued upon request from one of the parties and will be issued in hard copy. This can also be announced at the end of a hearing if a hearing has taken place. The applicant or the owner of the trademark will not be required to give justification if they are involved in proceedings and their request has been granted.

(2) Upon notification of the decisions, the parties are to be instructed about the appeal against the decisions, about the place where the appeal is to be lodged, about the time limit for the appeal, and, about the fee if the appeal requires a fee under the Patent Costs Act. The time restriction for the appeal shall only commence if instructed by the participants pursuant to clause 1. An appeal may only be launched within one year of the decisions having been notified if the instruction has been omitted or issued incorrectly, unless the individual in question has been informed of the fact in writing that an appeal cannot be launched. section 91 shall apply accordingly. sections 1 to 4 shall apply mutatis mutandis to the remainder of the right of appeal under section 64.

Section 62 Inspection of files, inspection of the register

(1) The German Patent and Trademark office shall grant on request inspection of the files of applications for Trademarks 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.

(3) Inspection of the files in accordance with (2) may also be granted

via the Internet where files are kept electronically.

(4) The inspection of files pursuant to paragraphs 1 to 3 shall be excluded insofar as a legal provision precludes this or insofar as the protectable interest of the data subject within the meaning of Article 4 number 1 of Regulation (EU) 2016/679 of the European Parliament and of the Council of April 27, 2016 on the protection of natural persons with regard to the processing of personal data, on the free movement of such data and repealing Directive 95/46/EC, in the current version, clearly shall prevail.

(5) Inspection of the register shall be free to all persons.

Section 62a Data protection

To the extent that personal data is contained in the register or in publicly accessible electronic information services of the German Patent and Trademark Office,

1. the right of access pursuant to Article 15(1)(c) of Regulation (EU) 2016/679,
2. the obligation to notify pursuant to Article 19, sentence 2 of Regulation (EU) 2016/679 and
3. the right of opposition pursuant to Article 21(1) of Regulation (EU) 2016/679 shall not apply.

The right to obtain a copy pursuant to Article 15(3) of Regulation (EU) 2016/679 shall be satisfied by allowing the data subject to inspect the register or publicly accessible electronic information services of the German Patent and Trademark Office.

Section 63 Costs of the proceedings

(1) If several persons are parties to the proceedings, the German Patent and Trademark Office may determine in the decision that the costs of the proceedings, including the expenses of the German Patent and Trademark 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 declaration of revocation or invalidity 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 German Patent and Trademark Office shall establish the value of the object if a decision is made pursuant to (1); section 23(3) No. 2 and section 33(1) of the German Solicitor Fees Act shall also apply accordingly. The decisions on the object value may be linked to the decision made in accordance with (1).

(3) The German Patent and Trademark Office may arrange that the fee pursuant to the German Patent Costs Act for accelerated examination, opposition, revocation or invalidity proceedings be refunded in whole or in part if this is fair.

(4) The amount of the costs to be refunded shall be set on request by the German Patent and Trademark 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 Federal 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 German Patent and Trademark 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 German Patent and Trademark 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(4) No. 2, his/her objection shall be deemed to have been withdrawn.

(7) It shall no longer be possible to rule on an objection after an appeal has been lodged in accordance with (6) No. 2 or in accordance with section 66(3). A ruling on an objection nonetheless handed down after this time shall be invalidity and void.

Section 64a Costs arrangements in the proceedings before the German Patent and Trademark Office

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

Section 65 Empowerment to hand down legal ordinances

(1) The Federal Ministry of Justice and consumer protection 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 Trademarks,
3. to determine the classification of goods and services,
4. to set more detailed provisions for the conduct of the examination, opposition, revocation and invalidity proceedings,
5. to make provisions concerning the register of registered Trademarks and, where appropriate, separate provisions concerning the register of collective and certification Trademarks,
6. to regulate the information to be included in the register concerning registered Trademarks and opposition and invalidity proceedings, and to determine the scope and manner of publication of

such information,

7. to make provisions concerning the other proceedings before the German Patent and Trademark Office provided for in this Act, such as, in particular, the procedure for the division of applications and registrations, the procedure for the granting of information or certificates, the procedure for reinstatement, the procedure for inspection of files, the procedure concerning the protection of internationally registered Trademarks and the procedure concerning the conversion of EU trademarks,

8. to make provisions concerning the information to be included in the register concerning licenses,

9. 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,

10. to make arrangements regarding the form in which orders, notices or other communications of the German Patent and Trademark 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,

11. 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,

12. 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 trademarks due to surrender, revocation or invalidity (section 48(1) and sections 53), the submission of expert reports (section 58(1)) and the decisions whereby the submission of an expert report is refused,

13. 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,

14. to prescribe the indications to be included in the publication in accordance with section 33(3), as well as to determine the scope and nature of the publication of these indications.

(2) The Federal Ministry of Justice and consumer protection may transfer the empowerment to issue legal ordinances in accordance with (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.

Section 65a Administrative cooperation

The German Patent and Trademark Office shall cooperate effectively with other national trademark offices, the World Intellectual Property Organization and the European Union Intellectual Property Office in the areas of activity relevant to national, international and trademark protection in the European Union, and shall promote the harmonization of approaches and instruments relating to the examination, registration, administration and cancellation of Trademarks.

Chapter 5 Proceedings before the Federal Patent Court

Section 66 Appeal

(1) Notwithstanding the provisions of section 64, any appeal against decisions made by the trademark offices and the trademark divisions shall be submitted with the German Federal Patent Court. Appeal shall be available to the parties involved in the proceedings before the German Patent and Trademark Office. Appeals have a suspensive effect.

(2) The appeal shall be lodged with the German Patent and Trademark 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 (1) No. 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 (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 Federal Patent Costs Act. If the appeal is not remedied in accordance with sentence 1, it shall be submitted to The Federal Patent Court prior to expiry of one month without a factual statement. The appeal shall be submitted to the Federal 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 Federal 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 Federal 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 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 German Patent and Trademark Office

(1) The President of the German Patent and Trademark Office may, if he or she considers it appropriate to safeguard the public interest, make written statements to the German Federal Patent Court in the appeal proceedings, attend the hearings and make statements in them. Written statements by the President of the German Patent and Trademark

Office shall be communicated to the parties by the German Federal Patent Court.

(2) The German Federal Patent Court may, if it considers it appropriate because of a legal question of fundamental importance, order the President of the German Patent and Trademark Office to intervene in the appeal proceedings. Upon receipt of the joining declaration, the President of the German Patent and Trademark Office shall acquire 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 Federal Patent Court (section 74(1)),
or
3. the Federal 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 Federal Patent Court may quash the challenged decision without ruling on the merits themselves if

1. the German Patent and Trademark Office has not yet ruled on the merits themselves,
2. the proceedings before the German Patent and Trademark Office have a major defect, or
3. new facts or items of evidence have become known which are relevant to the decision.

(4) The German Patent and Trademark Office shall also use the legal assessment underlying the quashing in accordance with (3) as a basis for its decision.

Section 71 Costs of the appeal proceedings

(1) If several persons are involved in the proceedings, The Federal 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) The President of the German Patent and Trademark Office may be ordered to pay the costs only if he or she has applied for costs after intervening in the proceedings.

(3) The Federal Patent Court may order the repayment of the appeal fee in accordance with the Patent Costs Act.

(4) (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 declaration of revocation or invalidity, 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 German Patent and Trademark 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 Federal 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 Federal Patent Court, issue all orders which are necessary to conclude the matter if possible in one oral hearing or in one session. section 273(2), (3) sentence 1 and (4) sentence 1 of the Code of Civil Procedure shall apply mutatis mutandis in other respects.

Section 74 Taking of evidence

(1) The Federal 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 Federal 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 Federal 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 Federal 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 Federal 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 Federal 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 involved ex officio.

(2) The decisions of The Federal 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 Federal 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 (1) without a prior oral hearing.

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

(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 Federal 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 Federal 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); 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, section 11 of the Civil Partnerships Act), 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 (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 (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 Federal Patent Court may set a time limit for this.

(6) The lack of power of attorney can be asserted in every situation of the procedure. The Federal Patent Court has to consider the lack of power of attorney ex officio, unless a lawyer or a patent attorney acts as proxy.

Section 81a Legal aid

(1) On request, a party shall be awarded legal aid in the proceedings before The Federal Patent Court; sections 114 to 116 of the Code of Civil Procedure shall apply mutatis mutandis.

(2) Section 130(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 Federal 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 Court do not rule this out. section 227(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 Federal Patent Court; the Court Costs Act shall apply to the expenses mutatis mutandis.

(2) A challenge of the decisions of the Federal Patent Court shall only be available insofar as this Act thus permits.

(3) Section 62(1) and (2) shall be applied mutatis mutandis to the granting of the inspection of files to third persons. the Federal 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 Federal 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 an appeal on points of law.

(2) The appeal on points of law may only be based on the order being based on an 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 and furthermore the necessary expenses of the patent attorney shall be refunded.

Section 86 Examination of admissibility

The Federal Court of Justice shall examine ex officio 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 German Patent and Trademark Office is not a party to the proceedings on appeal, section 68(1) shall apply *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 *ex officio* (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(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(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 involved *ex officio*.

(4) In the case of the rescission of the challenged order, the case shall be referred back to The Federal Patent Court for a further hearing and decision. The Federal 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(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 German Patent and Trademark 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-a-vis the German Patent and Trademark Office or The Federal 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(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-a-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 German Patent and Trademark 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 (2) and the time limit to pay the further processing fee in accordance with section 6(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 German Patent and Trademark Office, The Federal 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 German Patent and Trademark Office and before The Federal 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.

Section 94 Service: statutory authorization

(1) The provisions contained in the Act on the Administrative Service of Documents shall apply to service in the proceedings before the German Patent and Trademark 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(2). Section 184(2) sentences 1 and 4 the Code of Civil Procedure shall apply mutatis mutandis.

2. Section 5(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).

3. Documents may also be served on recipients for whom a mail box has been established at the German Patent and Trademark Office by the document being deposited in the recipient's mail box. A 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.

4. A transmission method shall be deployed for delivering electronic documents which ensures the authenticity and the integrity of the data and which uses generally accessible networks to ensure the confidentiality of any information being transmitted by using an encryption method. The Federal Ministry of Justice and Consumer Protection will issue more detailed provisions regarding methods of transmission which are more suitable in accordance with clause 1 along with the form and the evidence of the electronic delivery should consent from the German Federal Assembly not be required.

(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 are obliged to provide legal assistance to the German Patent and Trademark Office.

(2) In proceedings before the German Patent and Trademark Office, the German Federal Patent Court shall, at the request of the German Patent and Trademark Office, impose administrative or coercive sanctions on witnesses or experts who fail to appear or refuse to give evidence or to be sworn in. Likewise, if a witness fails to appear, the production of that witness shall be ordered.

(3) With regard to the request in accordance with (2), a Board of Appeal of The Federal 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 German Patent and Trademark Office for applications, motions or other acts, the provisions contained in section 130a(1) and (2) sentences 1 and (5), as well as (6), of the Code of Civil Procedure shall apply mutatis mutandis.

(2) The files of the proceedings of The Federal 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 and consumer protection 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 German Patent and Trademark 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 (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) Any person or entity who or which has neither a domicile, a registered office, nor a place of business in Germany may participate in proceedings before the German Patent and Trademark Office or the German Federal Patent Court governed by this Act and assert the rights conferred by a trademark only if it has appointed a lawyer or patent attorney as its representative who is authorized and empowered to represent it in proceedings before the German Patent and Trademark Office, the German Federal Patent Court and in civil disputes concerning the trademark in question and to file criminal petitions.

(2) The place at which a representative who has been appointed in accordance with (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 German Patent and Trademark Office has its seat of business.

(3) The termination of the commissioning of a representative in accordance with (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 German Patent and Trademark Office or to The Federal Patent Court.

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

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

Part 4 Collective marks

Section 97 Collective marks

(1) All signs within the meaning of section 3 which are capable of distinguishing the goods or services of the members of the owner of the collective mark from those of other companies on the basis of their commercial or geographical origin, their nature, their quality or their other characteristics may be registered as collective marks. A collective mark must be designated as such when the application is submitted.

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

Section 98 Ownership

Owners of applied for or registered collective marks may only be associations of manufacturers, producers, service entrepreneurs or traders, including umbrella associations and umbrella associations whose members are themselves associations having the capacity to be rights holders and to hold obligations in their own names, to conclude contracts or to perform other legal acts and to sue and be sued in court. Legal entities under public law shall be treated as equivalent to these associations.

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

In derogation from section 8(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 protective barriers arising from section 23, the registration of a geographical origin indication as a collective mark does not grant its owner the right to prohibit a third party from using such indications in the course of trade, provided that such use is in accordance with morality and is not contrary to section 127. In particular, such a trademark cannot be held against a third party who is entitled to use a geographical name.

(2) The earnest 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 collective 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 the collective mark

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

(2) The regulations governing use of the collective 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 collective 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 collective mark statute shall be entered into the register.

(5) Any person is free to consult the collective mark statutes.

Section 103 Examination of the application

(1) The application for a collective mark shall also be refused, in addition to section 37, if it does not comply with the requirements of sections 97, 98 or 102 or if the collective mark statutes are contrary to public policy or morality.

(2) An application for a collective mark shall also be refused if there is a risk that the public may be misled as to the character or meaning of the trademark, in particular if the trademark may create the impression that it is something other than a collective mark.

(3) An application for a collective mark shall not be refused if the applicant amends the collective mark statute so that the grounds for refusal pursuant to paragraphs 1 and 2 no longer exist.

Section 104 Amendment of collective mark statutes

(1) The owner of the collective mark shall notify the German Patent and Trademark Office of any amendments to the collective mark statutes.

(2) In the event of an amendment to the collective mark statute, sections 102 and 103 shall apply mutatis mutandis.

(3) For the purposes of this Act, the amendment to the collective mark statute shall take effect only from the date on which the amendment is entered in the register.

(4) Third-party written comments pursuant to section 37(6) sentence 2 may also be submitted with respect to amended collective mark statutes.

Section 105 Revocation

(1) The registration of a collective mark shall be declared revocation and deleted 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 collective mark, or
3. if the manner in which the trademark has been used by authorized persons has had the effect of making it likely that the public will be misled within the meaning of section 103 (2), or

4. if an amendment to the regulations governing use of the collective mark has been entered in the register in contravention of section 104(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 (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 revocation pursuant to paragraph 1 shall be submitted to the German Patent and Trademark Office. The procedure shall be governed by section 53.

Section 106 Nullity due to absolute grounds for refusal

(1) The registration of a collective mark shall, except on the grounds of invalidity referred to in section 50, be declared invalidity and cancelled upon request if it has been registered contrary to section 103. If the ground for invalidity relates to the collective mark statute, the registration shall not be declared invalidity and cancelled if the owner of the collective mark amends the collective mark statute so that the grounds for invalidity no longer exists.

(2) The application for a declaration of invalidity pursuant to paragraph 1 shall be submitted to the German Patent and Trademark Office. The procedure shall be governed by section 53.

Part 5 Certification Trademarks

Section 106a Certification Trademarks

(1) The owner of the certification trademark guarantees the existence of one or more of the following characteristics for the goods and services for which it has applied:

1. the material,
2. the way of manufacturing the goods or providing the services,
3. the quality, accuracy or other characteristics other than geographical origin.

The trademark must be capable of distinguishing goods and services for which the guarantee exists from goods and services for which no such guarantee exists. A certification trademark must be designated as such when the application is submitted.

(2) The provisions of this Act shall apply to certification Trademarks, unless otherwise provided in this Part.

Section 106b Ownership and genuine use

(1) The owner of applied for or register certification Trademarks may be any natural or legal person, including institutions, public authorities and legal entities under public law, provided that they do not carry out any business activity involving the supply of goods or services covered by a guarantee.

(2) Genuine use of a certification trademark by at least one person authorized to do so shall be deemed use within the meaning of section 26.

Section 106c Standing; damages

(1) Unless otherwise provided in the certification trademark statute, a person entitled to use the certification trademark may only bring an action for infringement of the certification trademark if the owner of the certification mark consents to this action being brought.

(2) The owner of the certification trademark may also claim compensation for the damage suffered by the persons authorized to use the certification trademark as a result of the unauthorized use of the certification trademark or a similar symbol.

Section 106d Certification trademark statute

(1) The application for the certification trademark must be accompanied by the certification trademark statute.

(2) At a minimum, the certification trademark statute must contain:

1. the name of the owner of the certification trademark,
2. a declaration by the owner of the certification trademark not to engage personally in any activity involving the supply of goods or services for which a certification is given,
3. a representation of the certification trademark,
4. the specification of the goods and services for which a certification shall exist,
5. information about which characteristics of the goods or services are covered by the certification,
6. the conditions for the use of the certification trademark, in particular the conditions for sanctions,
7. information about the persons authorized to use the certification trademark,
8. information on the way in which the owner of the certification trademark must verify the properties covered by the certification and monitor the use of the trademark,
9. information on the rights and obligations of the parties in the event of infringement of the certification trademark.

(3) The certification trademark statute shall be entered into the register.

(4) Any person is free to inspect the certification trademark statute.

Section 106e Examination of the application

(1) The application for a certification trademark statute shall also be refused, in addition to section 37, if it does not comply with the requirements of sections 106a, 106b(1) or 106d or if the certification trademark statute is contrary to public policy or morality.

(2) An application for a certification trademark shall also be refused if it is likely that the public shall be misled as to the character or meaning of the trademark, in particular, if the trademark is likely to create the impression that it is something other than a certification trademark.

(3) The application shall not be rejected if the applicant amends the certification trademark statute so that the grounds for rejection in paragraphs (1) and (2) no longer exist.

Section 106f Amendment of the certification trademark statute

(1) The owner of the certification trademark shall notify the German Patent and Trademark Office of any amendments to the certification trademark statute.

(2) In the event of an amendment to the certification trademark statute, sections 106d and 106e shall apply mutatis mutandis.

(3) For the purposes of this Act, the amendment to the certification trademark statute shall take effect only from the date on which the amendment has been entered into the register.

(4) Third-party written comments pursuant to section 37(6) sentence 2 may also be submitted with respect to amended certification trademark statutes.

Section 106g Withdrawal

(1) The registration of a certification trademark shall, in addition to the grounds for revocation specified in section 49, be revoked and cancelled upon request in the following cases:

1. if the owner of the certification trademark no longer meets the requirements of section 106b,
2. if the owner of the certification trademark does not take appropriate measures to prevent the certification trademark from being misused in a manner contrary to the certification trademark statute,
3. if the certification trademark has been used by authorized persons in such a way that there is a risk that the public will be misled pursuant to section 106e(2), or
4. if an amendment to the certification trademark statute has been entered into the register in violation of section 106f(2) pursuant to section 106d(3), unless the owner of the certification trademark statute amends the certification trademark statute again so that the grounds for revocation no longer exists.

(2) Abusive use within the meaning of paragraph (1)2 shall be deemed to occur in particular if the use of the certification trademark by persons other than those authorized to use it is likely to mislead the

public.

(3) The application for revocation pursuant to paragraph 1 shall be submitted to the German Patent and Trademark Office. The procedure shall be governed by section 53.

Section 106h Invalidity due to absolute grounds for refusal

(1) Apart from the grounds for invalidity referred to in section 50, the registration of a certification trademark shall, upon request, also be declared invalidity and cancelled if it has not been rejected and registered, contrary to section 106e. If the ground for invalidity relates to the certification trademark statute, the registration shall not be declared invalidity and cancelled if the owner of the certification trademark amends the certification trademark statute so that the grounds for invalidity no longer exists.

(2) The application for a declaration of invalidity pursuant to paragraph 1 shall be submitted to the German Patent and Trademark Office. The procedure shall be governed by section 53.

Part 6 Protection of Trademarks under the Madrid Agreement and the Protocol Relating to the Madrid Agreement; EU Trademarks

Chapter 1 Protection of Trademarks under the Madrid Trademark Agreement

Section 107 Corresponding application of provisions of this Act; language.

(1) The provisions of this Act shall apply mutatis mutandis to international registrations of Trademarks under the Stockholm Act of July 14, 1967, of the Madrid Agreement of April 14, 1891, concerning the International Registration of Marks (German Federal Law Gazette 1970 II, pp. 293, 418) (Madrid Agreement), which are effected through the intermediary of the German Patent and Trademark Office or the protection of which extends to the territory of the Federal Republic of Germany, unless otherwise provided in this section or in the Madrid Agreement.

(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 German Patent and Trademark 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(1) of the Patent Costs Act or in accordance with (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 German Patent and Trademark 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(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 3 ter 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 German Patent and Trademark Office.

(2) The effect designated in (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 grounds for refusal

(1) Internationally-registered Trademarks shall be examined for absolute grounds for refusal in the same way as Trademarks whose entry in the register has been applied for in accordance with section 37.

Section 37(2) shall not be applied.

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

Section 114 Opposition to an internationally registered trademark

(1) The publication of the registration (section 41(2)) for internationally-registered Trademarks 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(1)) against the granting of protection for internationally-registered Trademarks 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(2)).

Section 115 Withdrawal of protection

(1) The application for the revocation of a trademark (Section 49) or for invalidity due to absolute grounds for refusal (Section 50) or earlier rights (Section 51) shall be replaced by the request for revocation of protection for internationally registered Trademarks.

(2) Where an application for revocation of protection pursuant to section 49(1) is submitted on the grounds of lack of use, the date from which opposition to the trademark is no longer possible

1. shall be replaced by the date on which the procedure for the extension of protection was completed or

2. by the date on which the period referred to in Article 5(2) of the Madrid Agreement expired, provided that by that date neither a notification of the granting of protection nor a notification of provisional refusal of protection has been received by the International Bureau of the World Intellectual Property Organization.

Section 116 Opposition based on an internationally registered trademark and application for a declaration of invalidity based on an internationally registered trademark

(1) Where an opposition to the registration of a trademark is submitted

on the basis of an internationally registered trademark, section 43(1) shall apply on condition that one of the dates referred to in section 115(2) take the place of the date from which opposition to the trademark was no longer possible.

(2) Where an application for a declaration of invalidity of a registered trademark is submitted pursuant to section 51 on the basis of an internationally registered trademark, section 53(5) shall apply on condition that one of the dates referred to in section 115(2) take the place of the date from which opposition to the trademark was no longer possible.

Section 117 Exclusion of claims due to lack of use

Where claims within the meaning of sections 14 and 18 to 19c are asserted on account of the infringement of an internationally registered trademark, section 25 shall apply on the condition that one of the dates referred to in section 115(2) take the place of the date from which opposition to the trademark was no longer possible.

Section 118 Consent to transfers of internationally-registered Trademarks

The German Patent and Trademark 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 German Patent and Trademark Office.

Chapter 2 Protection of Trademarks 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 Trademarks 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 German Patent and Trademark 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 German Patent and Trademark 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(1) of the Patent Costs Act or in accordance with (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 3 ter para. 2 of the Protocol Relating to the Madrid Agreement on Marks may be lodged with the German Patent and Trademark 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(1) of the Patent Costs Act).

Section 124 Application, mutatis mutandis, of the provisions on the effect of Trademarks internationally-registered in accordance with the Madrid Agreement on Marks

sections 112 to 117 shall be applied mutatis mutandis to internationally-registered Trademarks whose protection has been extended to the territory of the Federal Republic of Germany in accordance with Article 3 ter 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 German Patent and Trademark Office in accordance with Article 9 quinquies 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 German Patent and Trademark 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 3 ter 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(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(1) with no prior examination. No opposition may be lodged against the registration of a trade mark in accordance with sentence 2.

Chapter 3 EU Trademarks

Section 125b Application of the provisions of this Act

The provisions of this Act shall apply to Trademarks registered under Regulation (EC) No 207/2009 of February 26, 2009 on the EU trademark (OJ L 78, 24.3.2009, p. 1), in the version of Regulation (EU) 2015/2424 (OJ L 341, 12/24/2015, p. 21; L 71, 03/16/2016, p. 322; L 110, 04/26/2016, p. 4) (EU Trade Mark Regulation), shall apply directly in the cases of points 1 and 2 and mutatis mutandis in the cases of points 3 to 6 as follows:

1. for the purposes of the application of section 9 (relative grounds for refusal), EU Trademarks applied for or registered with earlier priority shall be treated in the same way as Trademarks applied for or registered with earlier priority under this Act, provided, however, that the reputation in the national territory pursuant to section 9(1)No. 3 is replaced by the reputation in the European Union pursuant to Article 9(2)(c) of the EU Trade Mark Regulation;
2. the owner of a registered EU trademark is entitled, in addition to the claims pursuant to Articles 9 to 11 of the EU Trademark Regulation, to claims for damages (section 14(7) and (8)), cancellation and recall (section 18), information (section 19), production and inspection (section 19a), securing of claims for damages (section 19b) and announcement of the decision (section 19c);
3. where claims based on a registered EU trademark are asserted against the use of a trademark with a later priority registered pursuant to this Act, section 21(1) shall apply mutatis mutandis;
4. where an opposition to the registration of a trademark (section 42) is based on a registered EU trademark with earlier priority, section 43(1) shall apply mutatis mutandis, provided that the use of the trademark with earlier priority pursuant to section 26 shall be replaced by the use of the EU trademark with earlier priority pursuant to Article 18 of the EU Trademark Regulation;
5. where an application for revocation or for a declaration of invalidity of the registration of a trademark (section 53(1)) is based on a registered EU trade mark of earlier priority,
 - a) section 51(2) sentence 1 shall apply mutatis mutandis;
 - b) section 53(6) shall apply mutatis mutandis on the condition that the use of the trademark with earlier priority pursuant to section 26 shall be replaced by the use of the EU trademark pursuant to Article 18 of the EU Trademark Regulation;

6. Applications for seizure on importation and exportation may be submitted by owners of registered EU Trademarks in the same way as by owners of Trademarks registered pursuant to this Act; sections 146 to 149 shall apply mutatis mutandis.

Section 125c Subsequent determination of invalidity of a trademark

(1) If the priority of a trademark registered in the Register of the German Patent and Trademark Office has been claimed for an EU trademark applied for or registered pursuant to Article 39 or Article 40 of the EU Trademark Regulation and if the trademark registered in the register of the German Patent and Trademark Office has been cancelled due to non-extension of the term of protection pursuant to section 47(6) or due to waiver pursuant to section 48(1), the invalidity of that trademark due to revocation or invalidity may be subsequently established upon request. In this case, priority shall have no effect.

(2) A declaration of invalidity shall be made under the same conditions as a declaration of revocation or invalidity. However, the invalidity of a trademark due to revocation pursuant to section 49(1) can only be established if the conditions for the declaration of revocation pursuant to this provision were already fulfilled at the time when the trademark was cancelled due to non-renewal of the term of protection or due to it being waived.

(3) The invalidity proceedings shall be governed by the provisions applicable to the revocation and invalidity proceedings of a registered trademark, provided that the revocation or cancellation of the trademark is replaced by a declaration of invalidity.

Section 125d Conversion of EU Trademarks

(1) If a request for the conversion of an applied for or registered EU trademark has been sent to the German Patent and Trademark Office pursuant to Article 139(3) of the EU Trademark Regulation, the fee and the class fees under the German Patent Costs Act for the conversion proceedings shall be due upon receipt of the request for conversion by the German Patent and Trademark Office.

(2) Where the request for conversion relates to a trademark which has not yet been registered as an EU trademark, the request for conversion shall be treated as an application for the registration of a trademark in the register of the German Patent and Trademark Office, provided

that the submission date pursuant to section 33(1) is replaced by the submission of the EU trademark pursuant to Article 32 of the EU Trade Mark Regulation or by the date of any priority claimed for the EU trademark. If the priority of a trademark registered in the register of the German Patent and Trademark Office pursuant to Article 39 of the EU Trademark Regulation had been claimed for the application for the EU trademark, that priority shall take the place of the relevant date pursuant to sentence 1.

(3) If the request for conversion relates to a trademark which has already been registered as an EU trademark, the German Patent and Trademark Office shall enter the trademark into the register directly without further examination pursuant to section 41(1), maintaining its original priority. No opposition may be submitted against the registration.

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

Section 125e EU trademark courts, EU trademark disputes

(1) For all actions in respect of which, pursuant to the EU Trademark Regulation, the EU trademark courts have jurisdiction within the meaning of Article 123(1) of the EU Trademark Regulation (EU trademark litigation), the regional courts shall have exclusive jurisdiction as EU trademark courts in the first instance, regardless of the amount in dispute.

(2) The EU trademark court of second instance shall be the Higher Regional Court in whose district the EU trademark 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 EU trademark disputes for the districts of several EU trademark 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 Lander may also transfer by agreement tasks incumbent on the EU trademark courts of one Land fully or in part to the EU trademark court which has jurisdiction in another Land.

(5) section 140 (3) and section 142 shall be applied mutatis mutandis to proceedings before the EU trademark courts.

Section 125f Notification of the Commission

The Federal Ministry of Justice and consumer protection shall communicate to the Commission of the EU trademark courts of first and second instance, as well as each and every alteration to the number, designation or territorial jurisdiction of the EU trademark courts of first and second instance.

Section 125g Local jurisdiction of the EU trademark courts

Where German EU trademark courts have international jurisdiction pursuant to Article 125 of the EU Trademark Regulation, the local jurisdiction of those courts shall be governed mutatis mutandis by the rules which would be applicable if the case concerned an application for a trademark submitted to the German Patent and Trademark Office or a trademark registered in the register of the German Patent and Trademark Office. If jurisdiction is not established thereafter, the court where the plaintiff has its general place of jurisdiction shall have local jurisdiction.

Section 125h Insolvency proceedings

(1) If the insolvency court is aware that the insolvency estate includes an EU trademark which had been applied for or registered, it shall request the EU Intellectual Property Office directly,

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 EU trademark or of the application for the EU trademark,
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 EU trademarks or, if it is an application, in the files of the application.

(2) The entry in the register for EU trademarks 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 German Federal Patent Court shall be competent to grant the enforcement order pursuant to Article 110(2) sentence 3 of the EU Trademark Regulation. The enforceable copy shall be issued by the clerk of the office of the German Federal Patent Court.

Part 7 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 (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 (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 (1), despite the deviation or the additions, it is likely to mislead concerning the geographical origin, or
2. in cases falling under (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(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(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 (EU) No. 1151/2012

Section 130 Proceedings before the German Patent and Trademark Office; the national objection procedure

(1) Any requests for registering a geographic information or a designation of origin in the Register of Protected Designations of Origin and Protected Geographic Information imposed by the European Commission pursuant to Article 11 of Regulation (EU) No. 1151/2012 drafted by the European Parliament and the Council dated November 21, 2012 on quality regulations for agricultural and food products in their most recent edition must be filed with the German Patent and Trademark Office.

(2) The procedures regulated in this section remain the responsibility for any trademark divisions recorded with the German Patent and Trademark Office.

(3) The German Patent and Trademark office will obtain any comments made by the Federal Ministry of Food and Agriculture, made by the relevant ministries of the states in question, and those made by interested public bodies as well as interested associations and business organizations as part of the review of the application.

(4) The German Patent and Trademark Office will publish the application. Any individual who has a legitimate interest or who is established or is resident within the territory of the Federal Republic of Germany may launch an appeal against the application with the German Patent and Trademark Office within a period of two months after it has been published.

(5) The German Patent and Trademark Office shall return a verdict provided that the application complies with requirements outlined in (EU) Regulation No. 1151/2012 and any requirements in place for it to be processed. Otherwise, the application will be rejected by a verdict. The German Patent and Trademark Office will publish the granting verdict. Any substantial changes made to the information published in accordance with (4) shall be published alongside the granting verdict. The applicant and those who launched an objection in due time will be informed of the verdict pursuant to clause 1 and clause 2.

(6) The German Patent and Trademark Office shall inform the applicant of this and forward the application along with any documents required to the Federal Ministry of Justice and Consumer Protection should there be legal grounds that the application complies with the requirements of Regulation (EU) No. 1151/2012 and the rules in place for these to be processed. In addition to this, the German Patent and Trademark Office will also publish a version of the specification in relation to the positive decision. The Federal Ministry of Justice and Consumer Protection will forward the application to the European Commission along with any documents which are required.

(7) If the specification has been amended during the registration process with the European Commission, the German Patent and Trademark Office publishes the version of the specification on which the registration is based.

Section 131 Inter-state objection procedures

(1) Any objections raised according to Article 51(1) sub-paragraph 2 of the Regulation (EU) No. 1151/2012 against the intended registration of geographic information or designations of origin in the Register of Protected Designations of Origin and Protected Geographic Information maintained by the European Commission shall be submitted to the German Patent and Trademark Office within two months of publication in the Official Journal of the European Union in accordance with Article 50(2) of the Regulation (EU) No. 1151/2012.

(2) The payment deadline for any objection fee is based on section 6(1) clause 1 of the Patent Costs Law. A reintroduction will not be permitted for any period of objection and for payment of the objection fee.

Section 132 Application for modifying the specification, removal procedure

(1) Articles 130 and 131 shall apply accordingly to any requests to amend the specification of a protected geographic information or a protected designation of origin pursuant to the Article 53(2) clause 1 of the Regulation (EU) No. 1151/2012.

(2) Articles 130 and 131 shall apply accordingly to any requests to remove a protected geographic information or a protected designation of origin pursuant to the Article 54(1) of the Regulation (EU) No.

1151/2012.

Section 133 Right of appeal

Any decisions returned by the German Patent and Trademark Office in accordance with the provisions of this section may be appealed against via the Federal Patent Court and by appealing to the Federal Court of Justice. Any appeal against a decision pursuant to section 130(5) clause 1 is entitled to those individuals who lodged an objection against the application within the deadline or to those whose legitimate interests remain affected by the granting verdict due to any amended information published pursuant to Article 130(5) clause 4. In addition, the provisions of this Act concerning the appeal proceedings before the Federal Patent Court (sections 66 to 82) and the appeal proceedings before the Federal Court of Justice (sections 83 to 90) must be applied accordingly.

Section 134 Supervision

(1) The supervision, monitoring and controls required in accordance with Regulation (EU) No. 1151/2012, 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 (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) 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, (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(1)No. 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) For acts to be carried out for control purposes in accordance with Article 37(1) of Regulation (EU) No 1151/2012, cost-covering fees and expenses shall be charged.

The chargeable facts are determined by the state law.

Section 135 Rights because of infringement

(1) Anyone who acts in commercial interests resulting in a breach of Article 13 of the Regulation (EU) No 1151/2012 may be subject to a claim to cease and desist made by individuals entitled to do so under Article 8(3) of the Unfair Competition Act in the case of risk of consistent breaches. The claim will also exist if there is an imminent breach for the first time. section 18, 19, 19a and 19c shall apply accordingly.

(2) section 128(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 EU trademark

Section 137 More detailed provisions on the protection of individual indications of geographical origin

(1) The Federal Ministry of Justice and Consumer Protection is authorized as part of an agreement with the Federal Ministries for Economics and Energy and for Food and Agriculture to introduce more detailed provisions on individual specifications of geographic location by drafting a bill with the consent of the German Federal Assembly.

(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(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 regulations governing the process for applications and appeals pursuant to the Regulation (EU) No. 1151/2012

(1) The Federal Ministry of Justice and Consumer Protection is authorized to introduce more detailed provisions on application, opposition, amendment and removal procedures (section 130 to 132) by drafting a bill without the consent of the German Federal Assembly.

(2) The Federal Ministry of Justice and Consumer Protection may delegate the authorization to issue statutory ordinances pursuant to (1) to the German Patent and Trademark Office by drafting a bill without the consent of the German Federal Assembly.

Section 139 Implementation conditions under the Regulation (EU) No. 1151/2012; statutory authorization

(1) The Federal Ministry of Justice and Consumer Protection is authorized as part of an agreement with the Federal Ministry of Economic Affairs and Energy and with the Federal Ministry of Food and

Agriculture under a bill which has been drafted with the consent of the German Federal Assembly to provide further details on protecting designations of origin and geographic information under the Regulation (EU) No. 1151/2012 to the extent that the requirement is included in the Regulation (EU) No. 1151/2012 or as part of any regulations introduced by the Council or by the European Commission for implementation purposes. In statutory regulations as per clause 1, in particular, regulations on

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 8 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 Lander 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) In order to secure the claims for injunctive relief specified in this Act, temporary injunctions may be issued even without the presentation and substantiation of the requirements specified in sections 935 and 940 of the German Code of Civil Procedure.

(4) 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 (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 (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 9 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(2) No. 1 or 2,
 2. uses a sign in contravention of section 14(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(4) No. 1 or offers, puts on the market, stocks, imports or exports in contravention of section 14(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(2) No. 1 or 2, or
 - b) would be prohibited to third parties in accordance with section 14(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(2), or
 5. uses a designation or a sign in contravention of section 15(3) with the intention of exploiting or impairing the distinctive character or the repute of a business name which has a reputation,
- shall be punished by up to three years' imprisonment or a fine.

(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 (1), the punishment shall be from three months' up to five years' imprisonment.

(3) The attempt shall be punishable.

(4) In cases falling under (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 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 on compensation for the injured party (sections 403 to 406c of the Code of Criminal Procedure), the provisions on seizure (section 74 to 74f of the Criminal Code) 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.

Section 143a Punishable infringement of a EU trademark

(1) Anyone who infringes the rights of the proprietor of a EU trademark in accordance with Article 9 § 1 sentence 2 of Council Regulation (EC) No. 207/2009 of 26 February 2009 on the EU trademark by

1. using a sign that is identical to the EU trademark 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 EU trademark and the identity or similarity of the goods or services covered by the EU trademark 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 EU trademark for goods or services which are not similar to those for which the EU trademark 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 EU trademark,

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(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(1) or (2), in each case also in conjunction with (4), or of a legal ordinance in accordance with section 137(1), or

2. in contravention of section 127(3), also in conjunction with (4), or of a legal ordinance in accordance with section 137(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) Similarly penalized will be those who, under violation of Article 13(1) letter a) or letter b) of the Regulation (EU) No. 1151/2012 of the European Parliament and the Council on November 21, 2012 on quality schemes for agricultural products and food products,

1. use a registered name for a commodity mentioned there in the course of trade, or;

2. appropriates or imitates a registered name.

(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.

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(2) No. 6,

2. an official certification marks or hallmarks within the meaning of section 8(2) No. 7, or

3. a symbol, a seal or a designation within the meaning of section 8(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(3), also in conjunction with (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(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 (1) with a regulatory fine of up to two thousand and five hundred Euros, and in cases falling under (2) with a regulatory fine of up to ten thousand Euros.

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

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

Chapter 2 Seizure of goods on import and export

Section 146 Seizure in case of infringements of rights to symbols

(1) Any goods provided illegally with a trademark or by using a trademark protected under this law shall be subject to seizure by customs authority during their import or export upon request and against deposition of security by the legal owner, provided that any violation of rights is obvious, insofar as Regulation (EU) No 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights and repealing Council Regulation (EC) No 1383/2003 in the respective applicable version is not to be applied by the customs authorities. This shall apply to any transaction among other member states of the European Union and with other contractual parties who have entered into an agreement with the European Economic Area, insofar as customs authorities conduct checks.

(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(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(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 (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 (2). If the applicant demonstrates that the court order in accordance with (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(1) shall be lodged with the Federal Finance Office 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(1) with regard to the seized goods or has not made a prompt statement (section 147(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 under the Regulation (EU) No. 608/2013

section 148(1) and (2) as well as section 149 of the Regulation (EU) No. 608/2013 shall apply accordingly for the proceedings under the aforementioned Regulation, insofar as the regulation does not include any contrary terms.

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 Union, shall, unless Regulation (EU) No. 608/2013 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 10 Transitional provisions

Section 152 Application of this Act

Unless provided otherwise below, the provisions of this Act shall also apply to Trademarks 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 business names 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 business name 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 business name or of an identical sign, the rights from the trade mark or from the business name in accordance with this Act may not be asserted against the further use of this trade mark, this business name 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 business name on the proviso that the five-year time limit provided for in section 21(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(2).

(2) (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(5) insofar as they are transfers of rights which took effect subsequent to 1 January 1995 or licences granted to third parties.

Section 156 Removal of a registered trademark on the basis of absolute grounds for refusal of protection

If, before 1 January 1995, an ex officio procedure for the cancellation of the registration of a trade mark for the existence of absolute grounds for refusal pursuant to section 10(2)(2) of the Law on Trademarks has been initiated or if a request for cancellation has been made in accordance with that provision before that date, the registration shall be canceled only if the mark is not protectable under both the current and the applicable law.

This shall also apply if, after 1 January 1995, a proceeding under section 54 to cancel the registration of a trade mark registered before 1 January 1995 is initiated.

Section 157 Cancellation of a registered trademark due to the existence of prior rights

(1) Where an action for cancellation of the registration of a trademark has been brought before January 1, 1995 on the basis of a trademark previously applied for pursuant to section 11(1)No. 1 of the Law on Trademarks or on the basis of another prior right, the registration shall, unless otherwise provided in subsection 2, be cancelled only if the action shall be permitted both under the provisions in force up to that date and under the provisions of this Act. This shall also apply if an action pursuant Section 55 for cancellation of the registration of a trademark has been submitted after January 1, 1995, or if an application pursuant to Section 53 for a declaration of revocation and invalidity of a trademark registered before January 1, 1995, is submitted after May 1, 2020.

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

Section 158 Transitional provisions

(1) Article 229 § 6 of the Introductory Act to the Civil Code 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 submitted before October 1, 2009, Section 42(1) and (2) in the version applicable until October 1, 2009 shall apply to the opposition submitted against the registration.

(3) If the application was submitted between October 1, 2009, and January 14, 2019, Section 42(1) and (2), as in effect until January 14, 2019, shall apply to the opposition submitted against the registration.

(4) If the opposition was submitted before January 14, 2019, Section 42(3) and (4) shall not apply.

(5) If, in proceedings relating to an opposition submitted before January 14, 2019, the use of the trademark in respect of which the opposition was submitted is contested, or if the use is contested in such opposition proceedings, Sections 26 and 43(1) shall continue to apply in the version applicable until that date.

(6) If the application for cancellation of a registered trademark because of revocation pursuant to Section 49 has been submitted before January 14, 2019, or if the action for cancellation because of revocation or because of prior rights pursuant to Section 51 has been submitted before that date, section 49(1), section 51(4)No. 1, section 55(3) and section 26 shall continue to apply in the version applicable until that date.

(7) section 8(2)No. 9 to No. 12 shall not apply to Trademarks for which an application has been submitted with the German Patent and Trademark Office before January 14, 2019.

(8) section 50(2) sentence 1 shall apply only to applications pursuant to section 50(1) submitted after January 14, 2019. If the application pursuant to section 50(1) was submitted before January 14, 2019, section 50(2) shall apply in its previous applicable version.

(9) For reminders and appeals submitted before October 1, 2009, sections 64 and 66 shall apply in the version applicable until October

1, 2009. For multilateral proceedings in which a reminder has been submitted by one party and an appeal has been submitted by another party, the appeal submission date shall be decisive for the applicability of said provisions.

(10) section 102(4) does not apply to collective marks registered before January 14, 2019.

Section 159 Term of protection and renewal

(1) The provisions of this Act relating to the term of protection and its renewal (section 47) shall apply to Trademarks registered before January 14, 2019, provided that, for the purpose of calculating the period after which the term of protection ends, section 47(1) shall continue to apply in the version in force until that date.

(2) For registered Trademarks whose term of protection pursuant to section 47(1) expires no later than twelve months after January 31, 2019, sections 3, 5 and 7 of the German Patent Costs Act of December 13, 2001 (German Federal Law Gazette I p. 3656), in the version of Article 13 of the Act of April 4, 2016 (German Federal Law Gazette I p. 558) shall continue to apply in the version in force up to that date.