

Übersetzung durch Ute Reusch in Zusammenarbeit mit dem Deutschen Patent- und Markenamt.

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## **Act on the Legal Protection of Designs (Designgesetz, DesignG)**

Design Act as published on 24 February 2014 (Federal Law Gazette I p. 122)

This Act serves to implement Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs (OJ L 289, 28.10.1998, p. 28). It was adopted by the Bundestag as Article 1 of the Act of 12 March 2004 (Federal Law Gazette I p. 390). Pursuant to Article 6 paragraph 1 of that Act, it enters into force on 1 June 2004. Pursuant to Article 6 paragraph 2, section 26, section 52 (2) and section 63 (2) enter into force with effect from 19 March 2004.

### **Part 1 Protection requirements**

#### **Section 1 Definitions**

For the purposes of this Act,

1. “design” means the two-dimensional or three-dimensional appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product itself or its ornamentation;
2. “product” means any industrial or handicraft item, including packaging, get-up, graphic symbols, typographic typefaces and parts intended to be assembled into a complex product, but excluding computer programs;
3. “complex product” means a product which is composed of multiple components which can be replaced permitting disassembly and reassembly of the product;
4. “normal use” means use by the end user, excluding maintenance, servicing or repair;
5. the right holder is deemed to be the holder of the registered design as recorded in the Design Register.

#### **Section 2 Design protection**

(1) A design shall be protected as a registered design if it is new and has individual character.

(2) A design shall be deemed to be new if no identical design was disclosed prior to the date of filing of the application. Designs shall be deemed to be identical if their features differ only in immaterial details.

(3) A design shall have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been disclosed prior to the date of filing of the application. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

### **Section 3** **Exclusion from design protection**

(1) The following shall be excluded from design protection:

1. features of appearance of products which are solely dictated by their technical function;
2. features of appearance of products which must necessarily be reproduced in their exact form and their exact dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function;
3. designs which are contrary to public policy or the accepted principles of morality;
4. designs which constitute an improper use of any of the signs listed in Article 6<sup>ter</sup> of the Paris Convention for the Protection of Industrial Property or of other badges, emblems and escutcheons of public interest.

(2) Features of appearance within the meaning of subsection (1) no. 2 shall not be excluded from design protection if they serve the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system.

### **Section 4** **Components of complex products**

A design which is applied to or incorporated in a product which constitutes a component part of a complex product shall be deemed to be new and shall have individual character only if the component part, once it has been incorporated in such a complex product, remains visible during its normal use and these visible features of the component part in themselves fulfil the requirements as to novelty and individual character.

### **Section 5** **Disclosure**

A design is disclosed if it has been published, exhibited, used in trade or has been otherwise made available to the public, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community, before the date of filing of the application for the design. A design shall not be deemed to have been disclosed for the sole reason that it was made known to a third party under explicit or implicit conditions of confidentiality.

### **Section 6** **Grace period for novelty**

A disclosure shall not be taken into consideration for the purpose of applying section 2 (2) and (3) if a design was made available to the public during the twelve-month period preceding the date of filing of the application by the designer or his successor in title or by a third party as a result of information provided or action taken by the designer or his successor in title. The same shall apply if the design was disclosed as a consequence of an abuse in relation to the designer or his successor in title.

## **Part 2** **Entitled persons**

### **Section 7** **Right in the registered design**

(1) The right in the registered design shall belong to the designer or his successor in title. Where several persons have jointly created a design, the right in the registered design shall belong to them jointly.

(2) Where a design was created by an employee in the execution of his duties or following the instructions given by his employer, the right in the registered design shall belong to the employer, unless otherwise provided by contract.

#### **Section 8 Formal entitlement**

The applicant and the right holder shall be deemed to be entitled and obliged in proceedings in respect of a registered design.

#### **Section 9 Claims against non-entitled persons**

(1) Where a registered design has been registered in the name of a person who is not entitled in accordance with section 7, the entitled person can, notwithstanding other claims, demand the assignment of the registered design or consent to its cancellation. Where consent to cancellation is given, the registered design shall, to this extent, be deemed not to have had, as from the outset, protective effects. Any of several entitled persons who is not registered as right holder may demand to be granted joint ownership .

(2) The claims referred to in subsection (1) may be asserted by bringing an action only within an exclusion period of three years beginning from the publication of the registered design. This shall not apply where the right holder was acting in bad faith when filing the application or upon the assignment of a registered design.

(3) In the event of a complete change of ownership of the rights in accordance with subsection (1), first sentence, licences and other rights shall lapse upon the entering into the Register of the person entitled. If the previous right holder or a licensee has exploited the registered design or has made effective and serious preparations to do so, he may continue such exploitation if he requests a non-exclusive licence from the new right holder within a period of one month after the latter has been entered in the Register. The licence shall be granted for a reasonable period at reasonable terms. The second and third sentences shall not apply if the right holder or the licensee was acting in bad faith when he began exploitation or made preparations to do so.

(4) The institution of legal proceedings pursuant to subsection (2), the final decision issued in such proceedings, any other termination of such proceedings and any change in the ownership of rights as a consequence of such proceedings shall be recorded in the Register of Registered Designs (Register).

#### **Section 10 Citation of the designer**

The designer shall have the right vis-à-vis the applicant or the right holder to be cited as designer in proceedings before the German Patent and Trade Mark Office and in the Register. If the design is the result of teamwork, each individual designer may demand his citation.

### **Part 3 Registration procedure**

#### **Section 11 Application**

(1) The application for registration of a design in the Register shall be filed with the German Patent and Trade Mark Office. The application may also be filed through a patent information centre if this agency has been designated to receive design applications on the basis of a notice published by the Federal Ministry of Justice and Consumer Protection in the Federal Law Gazette.

(2) The application shall contain:

1. a request for registration,
2. information identifying the applicant and

3. a representation of the design which is suitable for publication.

Where a request is filed in accordance with section 21 (1), first sentence, the representation can be replaced by a specimen of a two-dimensional design.

(3) The application must contain an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied.

(4) The application must meet the other requirements for filing provided for by statutory instrument in accordance with section 26.

(5) In addition, the application may contain:

1. a description explaining the representation,
2. a request for deferment of publication of the representation in accordance with section 21 (1), first sentence,
3. a list of the class or classes of goods in which the design is to be classified,
4. information regarding the designer or designers,
5. information regarding a representative.

(6) The information required in accordance with subsection (3) and subsection (5) no. 3 shall have no influence on the scope of protection of a registered design.

(7) The applicant may withdraw the application at any time.

### **Section 12** **Multiple applications**

(1) Several designs may be combined in one application (multiple application). The multiple application may not comprise more than 100 designs.

(2) The applicant may divide a multiple application by declaration to the German Patent and Trade Mark Office. The division shall not affect the date of filing of the application. If the sum total of the fees which would have to be paid for each divisional application in accordance with the Patent Costs Act is higher than the application fees which have been paid, the differential amount shall be subsequently paid.

### **Section 13** **Date of filing**

(1) The date of filing of the application for a design shall be the date on which the documents containing the information specified in section 11 (2) are received

1. by the German Patent and Trade Mark Office
2. or by a patent information centre if this agency has been so designated by notice published by the Federal Ministry of Justice and Consumer Protection in the Federal Law Gazette.

(2) If a priority referred to in section 14 or section 15 is effectively claimed, then upon application of sections 2 to 6, section 12 (2), second sentence, section 21 (1), first sentence, section 33 (2), first sentence, no. 2 and section 41 the date of priority shall take the place of the date of filing.

### **Section 14** **Foreign priority**

(1) Any person who in accordance with an international treaty claims the priority of an earlier foreign application in respect of the same design shall indicate the date, country and file number of the earlier application before the expiry of a period of sixteen months from the date of priority and shall submit a copy of the earlier application. The particulars may be changed within that period.

(2) If the earlier application was filed in a state with which no international treaty on the recognition of priority has been concluded, the applicant may claim a right of priority which

corresponds to the right of priority under the Paris Convention for the Protection of Industrial Property, in so far as, in accordance with a notice published by the Federal Ministry of Justice and Consumer Protection in the Federal Law Gazette, the other state grants a right of priority on the basis of a first application filed with the German Patent and Trade Mark Office which is equivalent as regards the conditions and content to the right of priority under the Paris Convention for the Protection of Industrial Property; subsection (1) shall apply.

(3) If the particulars specified in subsection (1) are furnished in due time and if the copy is submitted in due time, the German Patent and Trade Mark Office shall record the priority in the Register. If the applicant has not claimed a priority until after publication of the registration of a design or has made changes to the particulars, the publication shall thus be done subsequently. If the particulars specified in subsection (1) are not furnished in due time or if the copy is not submitted in due time, the declaration concerning the claiming of priority shall be deemed not to have been made. This shall be determined by the German Patent and Trade Mark Office.

### **Section 15** **Exhibition priority**

(1) Where the applicant has displayed a design

1. at an official or officially recognised international exhibition falling within the terms of the Convention Relating to International Exhibitions signed in Paris on 22 November 1928 or

2. at another domestic or foreign exhibition,

he may, if he files the application within a period of six months following the first display, claim a right of priority from that date.

(2) Notice of the exhibitions referred to in subsection (1) no. 1 shall be published by the Federal Ministry of Justice and Consumer Protection in the Federal Gazette.

(3) The exhibitions within the meaning of subsection (1) no. 2 shall be determined in each individual case by the Federal Ministry of Justice and Consumer Protection and notice thereof shall be published in the Federal Gazette.

(4) Any person who claims a priority in accordance with subsection (1) shall, before the expiry of a period of sixteen months following the date on which the design was first displayed, indicate that date and the exhibition and submit proof of that display. Section 14 (3) shall apply *mutatis mutandis*.

(5) The exhibition priority in accordance with subsection (1) shall not extend the periods of priority specified in section 14 (1).

### **Section 16** **Examination of the application**

(1) The German Patent and Trade Mark Office shall examine whether

1. the application fees specified in section 5 (1), first sentence, of the Patent Costs Act have been paid and

2. the conditions for recognition of the date of filing of the application under section 11 (2) are met and

3. the application meets the other requirements for filing.

(2) If the application is deemed to be withdrawn due to non-payment of the application fees specified in section 6 (2) of the Patent Costs Act, this shall be determined by the German Patent and Trade Mark Office.

(3) If, in the case of insufficient fees having been paid, the application fees for a multiple application are not subsequently paid in sufficient amount within a period prescribed by the German Patent and Trade Mark Office or if the applicant does not determine which designs are to be covered by the fee amount paid, the German Patent and Trade Mark Office shall

determine which designs will be taken into consideration. In other respects, the application shall be deemed to be withdrawn. This shall be determined by the German Patent and Trade Mark Office.

(4) In the case of deficiencies in accordance with subsection (1) no. 2 and 3, the German Patent and Trade Mark Office shall request the applicant to remedy the deficiencies noted within a prescribed period. If the applicant complies with the German Patent and Trade Mark Office's request, the German Patent and Trade Mark Office shall, in the case of deficiencies in accordance with subsection (1) no. 2, accord as the date of filing in accordance with section 13 (1) the date on which the deficiencies noted were remedied. If the deficiencies are not remedied in due time, the German Patent and Trade Mark Office shall decide to refuse the application.

### **Section 17**

#### **Further processing of the application**

(1) If the design application has been refused upon failure to comply with a time limit set by the German Patent and Trade Mark Office, the decision on the refusal of the application shall become ineffective, without the need for its express setting aside, if the applicant requests further processing of the application and completes the omitted act.

(2) The request for further processing shall be filed within a period of one month following service of the decision on the refusal of the design application. The omitted act shall be completed within this period.

(3) Re-establishment of rights shall be ruled out in respect of non-observance of the period referred to in subsection (2) and the period for payment of the fee for further processing specified in section 6 (1), first sentence, of the Patent Costs Act.

(4) The unit competent to decide on the omitted act shall decide on the request.

### **Section 18**

#### **Grounds for non-registrability**

If the subject matter of the application is not a design within the meaning of section 1 no. 1 or if a design is excluded from design protection in accordance with section 3 (1) no. 3 or no. 4, the German Patent and Trade Mark Office shall refuse the application.

### **Section 19**

#### **Keeping of the Register and registration**

(1) The Register for Registered Designs shall be kept by the German Patent and Trade Mark Office.

(2) The German Patent and Trade Mark Office shall record the particulars of the applicant requiring registration in the Register without examining his entitlement to file the application and the correctness of the particulars furnished in the application, and shall determine which classes of goods are to be recorded.

### **Section 20**

#### **Publication**

Registration in the Register shall be published by the German Patent and Trade Mark Office together with a representation of the registered design. The publication shall be done without guarantee for the completeness of the representation and the recognisability of the features of appearance of the design.

### **Section 21**

#### **Deferment of publication**

(1) When filing the application, the deferment of publication of the representation may be requested for a period of thirty months following the date of filing of the application. Upon such request, the publication shall be confined to the registration of the design to be registered in the Register.

(2) The protection may be extended to the term of protection referred to in section 27 (2) if the right holder pays the extension fee in accordance with section 5 (1), first sentence, of the

Patent Costs Act within the deferment period. Where use has been made of the possibility referred to in section 11 (2), second sentence, a representation of the design to be registered shall also be submitted within the deferment period.

(3) Publication together with the representation in accordance with section 20 shall be subsequently done together with a reference to the publication in accordance with subsection (1), second sentence, upon the expiry of the deferment period or, upon request, at an earlier date.

(4) The term of protection ends upon expiry of the deferment period unless protection is extended in accordance with subsection (2). In the case of registered designs which were registered on the basis of a multiple application, the subsequent publication may be restricted to individual registered designs.

## **Section 22 Inspection of the Register**

(1) Any person shall be free to inspect the Register. The right to inspect the representation of a registered design and the files kept by the German Patent and Trade Mark Office in respect of the registered design shall exist if

1. the representation has been published,
2. the applicant or right holder has given his consent or
3. a legitimate interest is substantiated.

(2) Inspection of the files in accordance with subsection (1), second sentence, may also be granted via the internet where the files are kept electronically.

(3) Inspection of the files in accordance with subsections (1) and (2) shall be ruled out to the extent that such inspection is precluded by legal provision or to the extent that an interest meriting protection of the data subject within the meaning of section 3 (1) of the Federal Data Protection Act obviously prevails.

## **Section 23 Procedural provisions, appeal and appeal on points of law**

(1) One or several Design Units and Design Divisions shall be established at the German Patent and Trade Mark Office to conduct proceedings in design matters. The Design Units shall be competent for decisions in proceedings under this Act, with the exception of invalidity proceedings in accordance with section 34a, and shall be staffed with a legally qualified member within the meaning of section 26 (2), second sentence, of the Patent Act. Section 47 of the Patent Act shall apply mutatis mutandis.

(2) Decisions in invalidity proceedings in accordance with section 34a shall be taken by one of the Design Divisions in the German Patent and Trade Mark Office, each of which shall be staffed with three legally qualified members within the meaning of section 26 (2), second sentence, of the Patent Act. Where the case raises questions of a particularly technical nature, a technically qualified member within the meaning of section 26 (2), second sentence, of the Patent Act shall be consulted. The chair of the competent Design Division shall take the decision to consult a technically qualified member; this decision shall not be independently appealable.

(3) Sections 41 to 44, section 45 (2), second sentence, and sections 47 to 49 of the Code of Civil Procedure on the exclusion of and objection to court personnel shall apply mutatis mutandis to the exclusion of and objection to members of the Design Units and Design Divisions. Where a decision is required, such decision on the objection request shall be taken by another legally qualified member of the German Patent and Trade Mark Office whom the President of the German Patent and Trade Mark Office has generally appointed to take decisions of this nature. Section 123 (1) to (5) and (7) and sections 124, 126 to 128a of the Patent Act shall apply mutatis mutandis.

(4) The decisions of the German Patent and Trade Mark Office in proceedings under this Act may be appealed to the Federal Patent Court. A Board of Appeal at the Federal Patent Court sitting in a composition of three legally qualified members shall take the decision on the appeal; subsection (2), second and third sentences, shall apply mutatis mutandis. Sections 69, 73 (2) to (4), section 74 (1), section 75 (1), sections 76 to 80 and sections 86 to 99, section 123 (1) to (5) and (7), and sections 124, 126 to 128b of the Patent Act shall apply mutatis mutandis. Section 84 (2), second and third sentences, of the Patent Act shall apply mutatis mutandis in appeal proceedings against decisions issued in invalidity proceedings in accordance with section 34a.

(5) An appeal on points of law from the orders of the Boards of Appeal ruling on an appeal in accordance with subsection (2) may be filed with the Federal Court of Justice if the Board of Appeal has allowed the appeal on points of law. Section 100 (2) and (3), sections 101 to 109, section 123 (1) to (5) and (7), and sections 124 and 128b of the Patent Act shall apply mutatis mutandis.

#### **Section 24**

##### **Legal aid**

In proceedings in accordance with section 23 (1), the applicant shall receive legal aid upon request subject to the application, mutatis mutandis, of sections 114 to 116 of the Code of Civil Procedure where there is sufficient prospect of the design being registered in the Register. Upon request, a party to the proceedings in accordance with section 34a shall be granted legal aid subject to the application, mutatis mutandis, of section 132 (2) of the Patent Act. Upon the request of the right holder, legal aid may also be granted for the costs of extending protection in accordance with section 21 (2), first sentence, and for the renewal fees in accordance with section 28 (1), first sentence. Section 130 (2) and (3), sections 133 to 135, section 136, first sentence, and sections 137 and 138 of the Patent Act shall apply mutatis mutandis.

#### **Section 25**

##### **Electronic conduct of proceedings, authorisation to issue statutory instruments**

(1) In so far as the written form is required in proceedings before the German Patent and Trade Mark Office in respect of applications, requests and other acts, the provisions of section 130a (1), first and third sentences, and subsection (3) of the Code of Civil Procedure shall apply mutatis mutandis.<sup>1</sup>

(2) The case files 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 in respect of electronic documents, the electronic file and the electronic conduct of proceedings shall apply mutatis mutandis in other respects, unless otherwise provided by this Act.

(3) The Federal Ministry of Justice and Consumer Protection shall determine by statutory instrument not requiring the consent of the Bundesrat

1. the date from when electronic documents may be submitted to the German Patent and Trade Mark Office and to the courts, the appropriate form for processing the documents, whether an electronic signature shall be used and the form of such signature;

2. the date from when the case files may be kept in electronic form in accordance with subsection (2) as well as the applicable general organisational and technical conditions for the creation, keeping and storage of the electronic case files.

**Footnote 1:** Pursuant to Article 11 in conjunction with Article 26 paragraph 1 of the Act of 10 October 2013 (Federal Law Gazette I p. 3786), the following wording of section 25 (1) shall be applicable from 1 January 2018:

“(1) In so far as the written form is required in proceedings before the German Patent and Trade Mark Office in respect of applications, requests and other acts, the provisions of

section 130a (1), (2), first sentence, (5) and (6) of the Code of Civil Procedure shall apply mutatis mutandis.”

## **Section 26**

### **Authorisation to issue statutory instruments**

(1) The Federal Ministry of Justice and Consumer Protection shall regulate the following by statutory instrument not requiring the consent of the Bundesrat:

1. the establishment and course of business of the German Patent and Trade Mark Office as well as the form of the proceedings in design matters, unless provision has been made by law in respect thereof,
2. the form and the other requirements of the application and of the representation of the design,
3. the permissible dimensions of a specimen of the design attached to the application in accordance with section 11 (2), second sentence,
4. the content and scope of a description explaining the representation which is attached to the application,
5. the classification of the classes of goods,
6. the keeping and structure of the Register, including the facts to be recorded in the Register and the details regarding publication,
7. the treatment to be given to products included with the application for the purposes of the representation of the registered design following cancellation of the registration in the Register and
8. the procedure before the German Patent and Trade Mark Office for the protection of industrial designs under the Hague Agreement.

(2) The Federal Ministry of Justice and Consumer Protection shall be authorised, by statutory instrument not requiring the consent of the Bundesrat, to entrust civil servants of the upper and intermediate grades as well as comparable employees with the conduct of business in proceedings in matters concerning the Register which, by their nature, do not raise any particular legal difficulties. The following, however, shall be excluded:

1. the refusal in accordance with section 18 and the refusal of effects of an international registration in accordance with section 69,
2. the decisions in invalidity proceedings in accordance with section 34a and
3. the rectification of the decision or forwarding of an appeal (section 23 (4), third sentence) against a decision in proceedings under this Act.

(3) Section 23 (3), first and second sentences, shall apply mutatis mutandis to the exclusion of and objection to a person entrusted in accordance with the provisions in subsection (2), first sentence.

(4) The Federal Ministry of Justice and Consumer Protection may transfer the authorisations referred to in subsections (1) and (2) by statutory instrument not requiring the consent of the Bundesrat, in whole or in part, to the German Patent and Trade Mark Office.

## **Part 4**

### **Accrual and term of protection**

## **Section 27**

### **Accrual and term of protection**

(1) Protection shall accrue upon registration in the Register.

(2) The term of protection of the registered design shall be twenty-five years, calculated from the date of filing of the application.

#### **Section 28 Renewal**

(1) Renewal of protection shall be effected by payment of a renewal fee for the sixth to tenth, eleventh to fifteenth, sixteenth to twentieth and for the twenty-first to twenty-fifth year of the term of protection in each case. It shall be recorded in the Register and published.

(2) If, in the case of registered designs which were registered on the basis of a multiple application, the renewal fee is paid for only a part of the registered designs without furnishing further details, these shall be taken into consideration in the order of the application.

(3) If protection is not renewed, the term of protection ends.

### **Part 5 Registered designs as objects of property**

#### **Section 29 Succession in title**

(1) The right in a registered design may be assigned or transferred to other persons.

(2) Where the registered design belongs to an enterprise or a part of an enterprise, the registered design shall, in cases of doubt, be covered by the assignment or the transfer of the enterprise or the part of the enterprise to which the registered design belongs.

(3) The transfer of the right in the registered design shall, upon the request of the right holder or of the successor in title, be recorded in the Register if proof thereof is furnished to the German Patent and Trade Mark Office.

#### **Section 30 Rights in rem, levy of execution, insolvency proceedings**

(1) The right in a registered design may

1. be the subject of rights in rem, in particular it may be given as security, or
2. be levied in execution.

(2) The rights referred to in subsection (1) no. 1 or the levy of execution referred to in subsection (1) no. 2 shall be recorded in the Register upon the request of a creditor or of another entitled person if proof thereof is furnished to the German Patent and Trade Mark Office.

(3) Where the right in a registered design is involved in insolvency proceedings, this shall be recorded in the Register upon application of the insolvency administrator or request of the insolvency court. In the case of joint ownership of a registered design, the first sentence shall apply mutatis mutandis to the share of the joint owner. In the case of debtor-in-possession management (section 270 of the Insolvency Statute), the insolvency monitor shall take the place of the insolvency administrator.

#### **Section 31 Licensing**

(1) The right holder may grant licences for the whole or part of the territory of the Federal Republic of Germany. A licence may be exclusive or non-exclusive.

(2) The right holder may invoke the rights conferred by the registered design against a licensee who contravenes any provision of the licensing contract with regard to

1. the duration of the licence,
2. the form in which the registered design may be used,
3. the range of products for which the licence is granted,

4. the region for which the licence is granted or
5. the quality of products manufactured by the licensee.

(3) Notwithstanding the provisions of the licensing contract, the licensee may institute proceedings for infringement of a registered design only if the right holder consents thereto. This shall not apply to the holder of an exclusive licence if the right holder, after having been invited to do so, does not himself institute infringement proceedings within an appropriate period.

(4) A licensee may, for the purpose of claiming compensation for damage suffered by him, intervene in an infringement action brought by the right holder as a joined party.

(5) The succession in title in accordance with section 29 or the granting of a licence within the meaning of subsection (1) shall not affect licences previously granted to third parties.

### **Section 32 Design application**

The provisions of this Part shall apply mutatis mutandis in respect of those rights which are established by means of filing an application for designs.

## **Part 6 Invalidity and cancellation**

### **Section 33 Invalidity**

(1) A registered design shall be invalid if

1. the appearance of the product does not constitute a design within the meaning of section 1 no. 1,
2. the design is not new or does not have individual character,
3. the design is excluded from design protection in accordance with section 3.

(2) A registered design shall be declared invalid if

1. it constitutes unauthorised use of a work which is protected by copyright,
2. it falls within the scope of protection of a registered design with an earlier filing or priority date, even if this registered design was not disclosed until after the date of filing of the registered design which is to be declared invalid,
3. a distinctive sign with an earlier filing or priority date is used in it and the holder of the sign is entitled to prohibit the use.

The holder of the registered design may consent to cancellation due to invalidity.

(3) Invalidity shall be determined or declared by decision of the German Patent and Trade Mark Office or by judgment on the basis of a counterclaim in infringement proceedings.

(4) The registration of a design shall be deemed not to have had any protective effects as from the outset when the decision by the German Patent and Trade Mark Office determining that the design is invalid has become non-appealable or the judgment declaring the design invalid has become final and binding.

(5) Invalidity may also be determined or declared after the term of protection of the registered design has ended or the registered design has been surrendered.

### **Section 34 Entitlement to institute invalidity proceedings**

Any person shall be entitled to file an application for the determination of invalidity in accordance with section 33 (1). Only the holder of the right concerned shall be entitled to file an application for the declaration of invalidity in accordance with section 33 (2). The ground of invalidity provided for in section 33 (1) no. 3 in conjunction with section 3 (1) no. 4 may be

invoked solely by the person concerned by the use; ex officio assertion by the competent public authority shall remain unaffected.

**Section 34a**  
**Invalidity proceedings before the**  
**German Patent and Trade Mark Office**

(1) The application shall be filed in writing with the German Patent and Trade Mark Office. The facts and evidence in support of the grounds shall be indicated. Section 81 (6) and section 125 of the Patent Act shall apply mutatis mutandis. The application shall not be admissible if a non-appealable decision or a final and binding judgment has been taken on the same matter in dispute between the parties

(2) The German Patent and Trade Mark Office shall serve the application on the holder of the registered design and shall invite him to comment on the application within a period of one month of service of the application. If the right holder does not contest the application within this period, the invalidity shall be determined or declared.

(3) Where the application is contested in due time, the German Patent and Trade Mark Office shall inform the applicant that the application has been contested and shall make the orders necessary in preparation of the decision. A hearing shall be held upon request of a party or where the German Patent and Trade Mark Office deems it to be expedient. The hearing of witnesses and experts may be ordered; sections 373 to 401 and sections 402 to 414 of the Code of Civil Procedure shall apply mutatis mutandis. Minutes shall be drawn up of the hearings and taking of evidence containing the essential course of the proceedings and the relevant statements made by the parties; sections 160a, 162 and 163 of the Code of Civil Procedure shall apply mutatis mutandis.

(4) The decision shall be issued in writing. The substance of the decision may be delivered at the end of the hearing. The decision shall be reasoned and served on the parties. Section 47 (2) of the Patent Act shall apply mutatis mutandis.

(5) The decision shall include a decision on the costs of the proceedings; section 62 (2) and section 84 (2), second sentence, of the Patent Act shall apply mutatis mutandis. Section 23 (3), second sentence, and section 33 (1) of the Act on the Remuneration of Lawyers shall apply mutatis mutandis to the determination of the value in dispute. The decision regarding the value in dispute may be linked to the decision referred to in the first sentence.

**Section 34b**  
**Suspension**

Where, during invalidity proceedings, an action is or becomes pending whose decision is dependent on the legal validity of the registered design, the court may order the suspension of the action. Suspension shall be ordered where the court regards the registered design to be invalid. If the decision to reject the application for determination or declaration of invalidity has become non-appealable, the court shall be bound by this decision only if it has been issued between the same parties. Section 52b (3), third sentence, shall apply mutatis mutandis.

**Section 34c**  
**Intervention in invalidity proceedings**

(1) A third party may intervene in invalidity proceedings if a non-appealable decision has not yet been taken in respect of the application for the determination or declaration of invalidity and if he can substantiate that

1. proceedings for infringement of the same registered design are pending against him or
2. he has been requested to cease and desist from an alleged infringement of the same registered design.

The intervention may be declared within three months from institution of the proceedings referred to in the first sentence, no. 1 or from receipt of the cease and desist request referred to in the first sentence, no. 2.

(2) Intervention shall be effected by filing of a request; sections 34 and 34a shall apply mutatis mutandis. If the intervention occurs in the appeal proceedings before the Federal Patent Court, the intervening party shall be given the status of an appellent.

### **Section 35 Partial maintenance**

(1) A registered design may be maintained in amended form

1. by means of the determination of partial invalidity or declaration of partial disclaimer by the right holder if the invalidity is to be determined in accordance with section 33 (1) due to lack of novelty or individual character (section 2 (2) or (3)) or due to exclusion from design protection (section 3) or

2. by means of the declaration of partial invalidity as well as consent to the partial cancellation or declaration of a partial disclaimer if the declaration of invalidity can be demanded in accordance with section 33 (2), first sentence, no. 1 or 3,

in so far as the requirements for protection are met and the registered design retains its identity.

(2) A representation of the design in amended form within the meaning of section 11 (2), first sentence, no. 3 shall be submitted to the German Patent and Trade Mark Office.

### **Section 36 Cancellation**

(1) A registered design shall be cancelled

1. upon the expiry of the term of protection;

2. in the case of surrender upon the request of the right holder if the consent of other holders of rights in the registered design who have been recorded in the Register and of the claimant in the case of proceedings in accordance with section 9 is submitted;

3. upon the request of a third party if he submits with the request a public or publicly certified document with such declarations as are referred to in no. 2;

4. in the case of consent to cancellation in accordance with section 9 or section 33 (2), second sentence;

5. on the basis of a non-appealable decision or final and binding judgment in respect of the determination or declaration of invalidity.

The German Patent and Trade Mark Office may reject the cancellation by decision.

(2) If the right holder only partially disclaims the registered design in accordance with subsection (1) no. 2 and 3, if he declares his consent to cancellation of part of the registered design in accordance with subsection (1), no. 4 or if partial invalidity is determined in accordance with subsection (1), no. 5, then instead of cancellation of the registered design a corresponding entry shall be made in the Register.

## **Part 7 Protective effects and limitation of protection**

### **Section 37 Object of protection**

(1) Protection shall be conferred on those features of appearance of a registered design which are shown visibly in the application.

(2) Where, for the purposes of deferring publication, an application contains a specimen of a two-dimensional design in accordance with section 11 (2), second sentence, then in the case

of proper extension upon the expiry of the deferment in accordance with section 21 (2) the object of protection shall be determined in accordance with the submitted representation of the registered design.

**Section 38**  
**Rights conferred by the registered design**  
**and scope of protection**

(1) The registration of a design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. Such use shall cover, in particular, the making, offering, putting on the market, importing, exporting, using of a product in which the registered design is incorporated or to which it is applied, or stocking such a product for those purposes.

(2) The protection conferred by a registered design shall include any design which does not produce on the informed user a different overall impression. In assessing the scope of protection, the degree of freedom of the designer in developing the design shall be taken into consideration.

(3) During the period of deferment of publication (section 21 (1), first sentence) the protection referred to in subsections (1) and (2) shall presuppose that the design results from copying the registered design.

**Section 39**  
**Presumption of legal validity**

It shall be presumed, in the right holder's favour, that the requirements set for the legal validity of a registered design are met.

**Section 40**  
**Limitation of the rights conferred by the registered design**

The rights conferred by a registered design cannot be exercised in respect of

1. acts done privately and for non-commercial purposes;
2. acts done for experimental purposes;
3. acts of reproduction for the purposes of making citations or of teaching, provided that such acts of reproduction are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the registered design, and that mention is made of the source;
4. the equipment on ships and aircraft which are registered in another country and enter Germany only temporarily;
5. the import of spare parts and accessories for the purpose of repairing and the execution of repairs on ships and aircraft within the meaning of no. 4.

**Section 41**  
**Right of prior use**

(1) Rights provided for in section 38 shall not be exercised against a third party who, before the date of filing, has in good faith commenced use in Germany, or has made effective and serious preparations to that end, of an identical design which was developed independently of a registered design. The third party shall be entitled to use the design. The issuing of licences (section 31) shall be ruled out.

(2) The rights of the third party shall not be transferrable except where the third party operates an enterprise and the transfer occurs along with that part of the enterprise in the course of which the act of use was done or the preparations were made.

**Part 8**  
**Legal infringements**

**Section 42**  
**Removal, cessation and desistance,**  
**and damages**

(1) Any person who uses a registered design contrary to section 38 (1), first sentence, (infringer) can be sued by the right holder or another entitled person (aggrieved party) for removal of the impairment and, in the event of the risk of recurrent infringement, for cessation and desistance. This right to cessation and desistance may also be exercised in the event of the risk of a first-time infringement.

(2) Where the infringer acts intentionally or negligently, he shall be obliged to compensate the aggrieved party for the damage caused. In assessing the compensation, consideration may also be given to the profit which the infringer has obtained by infringing the right. The claim for damages may also be calculated on the basis of the amount which the infringer would have been required to pay as equitable remuneration if he had obtained permission to use the registered design.

**Section 43**  
**Destruction, recall and release**

(1) The aggrieved party may sue the infringer for destruction of the products held or owned by the infringer which were illegally manufactured, distributed or destined for unlawful distribution. The first sentence shall apply mutatis mutandis in the case of equipment owned by the infringer which primarily served to manufacture these products.

(2) The aggrieved party may sue the infringer for the recall of products which were unlawfully manufactured, distributed or destined for illegal distribution or for their final removal from the channels of commerce.

(3) As an alternative to the measures provided for under subsection (1), the aggrieved party can demand that the infringer release the products in his possession to the aggrieved party against equitable remuneration which may not exceed the manufacturing costs.

(4) The claims under subsections (1) to (3) shall be ruled out if the measure is disproportionate in an individual case. When examining proportionality, consideration shall also be given to the legitimate interests of third parties.

(5) Essential elements of buildings in accordance with section 93 of the German Civil Code as well as removable parts of products and equipment whose production and distribution is not unlawful shall not be subject to the measures provided for under subsections (1) to (3).

**Section 44**  
**Liability of the owner of an enterprise**

Where a registered design has been unlawfully infringed in an enterprise by an employee or representative, the aggrieved party shall also have the rights provided for in sections 42 and 43 against the owner of the enterprise, with the exception of the right to claim damages.

**Section 45**  
**Compensation**

Where the infringer acts neither intentionally nor negligently, he may, in order to avert the claims under sections 42 and 43, compensate the aggrieved party in money if fulfilling the claims would cause disproportionate damage to him and the aggrieved party can be reasonably expected to accept the pecuniary compensation. The amount to be paid in compensation shall be the amount which would have constituted equitable remuneration had the right been granted. Upon payment of the compensation the aggrieved party's consent shall be deemed to have been given to exploitation to the usual extent.

**Section 46**  
**Information**

(1) The aggrieved party may sue the infringer for provision of information, without delay, regarding the origin and the channels of commerce of the infringing products.

(2) In cases of an obvious legal infringement or in cases where the aggrieved party has brought an action against the infringer, the claim may also be asserted, without prejudice to subsection (1), against a person who, on a commercial scale,

1. had possession of infringing products,
2. made use of infringing services,
3. provided services used for infringing activities or
4. according to the information provided by a person referred to in no. 1, 2 or no. 3, participated in manufacturing, creating or distributing such products,

unless that person would be entitled under sections 383 to 385 of the Code of Civil Procedure to refuse to give testimony in proceedings against the infringer. In the event of assertion in judicial proceedings of the claim under the first sentence, the court may, upon motion, suspend the proceedings pending against the infringer until the proceedings on the claim concerning the provision of information have been concluded. The person obliged to provide the information may demand from the aggrieved party reimbursement of the expenditure for the provision of the information.

(3) The person obliged to provide the information shall give particulars of

1. the names and addresses of the manufacturers, suppliers and other previous holders of the products or of the users of the services as well as of the intended wholesalers and retailers and
2. the quantity of the products manufactured, delivered, received or ordered as well as the prices paid for the products or services concerned.

(4) The claims under subsections (1) and (2) shall be ruled out if such a claim is disproportionate in an individual case.

(5) If the person obliged to provide the information, while acting intentionally or grossly negligently, provides false or incomplete information, he shall be obliged to compensate the aggrieved party for the damage caused.

(6) Any person who provides true information without having been obliged to do so in accordance with subsection (1) or subsection (2) shall be liable to third parties only if he knew that he was not obliged to provide the information.

(7) ) In cases of an obvious legal infringement the obligation to provide the information may be imposed by means of an injunction in accordance with sections 935 to 945 of the Code of Civil Procedure.

(8) In criminal proceedings or in proceedings under the Act on Regulatory Offences the findings may be used against the person obliged on account of an act committed prior to the provision of the information or against a relative referred to in section 52 (1) of the Code of Civil Procedure only with the consent of the person obliged.

(9) Where the information can be provided only by using traffic data (section 3 no. 30 of the Telecommunications Act), a court order regarding the admissibility of the use of the traffic data shall first have to be obtained upon motion by the aggrieved party. For issuance of this order, that regional court in whose district the person obliged to provide the information has his residence, principal place of business or an establishment shall have exclusive jurisdiction, irrespective of the value in dispute. The civil division shall decide. The provisions of the Act on Proceedings in Family Matters and in Matters of Non-Contentious Jurisdiction shall apply to the proceedings mutatis mutandis. The costs of the court order shall be borne by the aggrieved party. An appeal from the decision of the regional court shall be the available remedy. The notice of appeal shall be lodged within a period of two weeks. The provisions concerning the protection of personal data shall otherwise remain unaffected.

(10) The basic right to privacy of telecommunications shall be restricted (Article 10 of the Basic Law) by subsection (2) in conjunction with subsection (9).

**Section 46a**  
**Production and inspection**

(1) Where there is sufficient likelihood of a legal infringement, the right holder or another entitled person may sue the alleged infringer for production of a document or inspection of an item which lies in his control if this is necessary for the purpose of establishing the claims of the right holder or another entitled person. Where there is sufficient likelihood of a legal infringement being committed on a commercial scale, the claim shall extend to the production of bank, financial or commercial documents. If the alleged infringer asserts that the information concerned is confidential, the court shall take the measures necessary to ensure the specific protection required in an individual case.

(2) The claim under subsection (1) shall be ruled out if such a claim is disproportionate in an individual case.

(3) The obligation to produce a document or to acquiesce to the inspection of an item may be imposed by means of an injunction in accordance with sections 935 to 945 of the Code of Civil Procedure. The court shall take the measures necessary to ensure the protection of confidential information. This shall in particular apply to those cases where the injunction is issued without giving a prior hearing to the opposing party.

(4) Section 811 of the German Civil Code as well as section 46 (8) shall apply mutatis mutandis.

(5) If there was no infringement or no risk of infringement, the alleged infringer may claim compensation for the damage caused to him by the production or inspection sought in accordance with subsection (1) from the person who sought the production or inspection.

**Section 46b**  
**Securing claims for damages**

(1) In the event of a legal infringement being committed on a commercial scale in the cases referred to in section 42 (2), the aggrieved party may also require the infringer to produce bank, financial or commercial documents or to provide appropriate access to the relevant documents as are in the infringer's control and are necessary for enforcing the claim for damages if there is doubt as to whether the claim for damages will be satisfied in the absence of such production. Where the infringer asserts that the information is confidential, the court shall take the measures necessary to ensure the specific protection required in an individual case.

(2) The claim under subsection (1) shall be ruled out if such a claim is disproportionate in an individual case.

(3) The obligation to produce the documents referred to in subsection (1) may be imposed by means of an injunction in accordance with sections 935 to 945 of the Code of Civil Procedure in cases where there evidently is a claim to compensation for damages. The court shall take the measures necessary to ensure the protection of confidential information. This shall in particular apply to those cases where the injunction is issued without giving a prior hearing to the opposing party.

(4) Section 811 of the German Civil Code and section 46 (8) shall apply mutatis mutandis.

**Section 47**  
**Publication of the judgment**

Where an action has been brought under this Act, the successful party may be entitled in the judgment to make the judgment public at the expense of the unsuccessful party if the successful party demonstrates a legitimate interest. The nature and extent of the publication shall be laid down in the judgment. The entitlement shall lapse if it is not used within three months of the judgment becoming final. The pronouncement in accordance with the first sentence shall not be provisionally enforceable.

**Section 48**  
**Exhaustion**

The rights conferred by the registered design shall not extend to acts in respect of a product in which a design falling under the scope of protection of a right in a registered design is incorporated or to which it is applied when the product has been put on the market in a Member State of the European Union or in another Contracting Party to the Agreement on the European Economic Area by the right holder or with his consent.

#### **Section 49 Limitation**

The provisions of Book 1, Division 5 of the German Civil Code shall apply mutatis mutandis to the limitation of the claims referred to in sections 42 to 47. Where the person obliged obtains something as a consequence of the infringement at the expense of the person entitled, section 852 of the German Civil Code shall apply mutatis mutandis.

#### **Section 50 Claims under other statutory provisions**

Claims under other statutory provisions shall remain unaffected.

#### **Section 51 Criminal provisions**

- (1) Any person who uses a registered design contrary to section 38 (1), first sentence, although the right holder has not consented thereto shall be liable to imprisonment for up to three years or a fine.
- (2) Where the offender acts on a commercial scale, the penalty shall be imprisonment for up to five years or a fine.
- (3) An attempt shall be punishable.
- (4) In the cases referred to in subsection (1), the offence shall be prosecuted upon motion only, unless the criminal prosecution authorities consider ex officio intervention imperative on account of the particular public interest in criminal prosecution.
- (5) Objects to which the criminal offence relates may be confiscated. Section 74a of the Criminal Code shall apply. Where the claims referred to in section 43 are upheld in proceedings pursuant to the provisions of the Code of Criminal Procedure governing compensation for the aggrieved person (sections 403 to 406c), the provisions on confiscation shall not apply.
- (6) Where a penalty is imposed, an order shall be made upon motion by the right holder and upon demonstration of a legitimate interest to the effect that the conviction be made public upon demand. The nature of the publication shall be laid down in the judgment.

### **Part 9 Proceedings in design litigation cases**

#### **Section 52 Design litigation cases**

- (1) The regional courts shall have exclusive jurisdiction, irrespective of the value in dispute, over all actions in which a claim from one of the legal relationships regulated under this Act is asserted (design litigation cases), with the exception of the determination or declaration of invalidity in accordance with section 33.
- (2) The Land (federal state) governments shall be authorised to assign, by statutory instrument, design litigation cases for the districts of more than one regional court to one such regional court provided this is expedient for promoting the proceedings *ratione materiae* or for accelerating the termination of the proceedings. The Land governments may delegate this authorisation to the Land departments of justice.
- (3) In addition, the Länder may, by agreement, delegate duties incumbent upon the design courts of one Land to the competent design court of another Land, in whole or in part.
- (4) In respect of the costs arising from the participation of a patent attorney in a design litigation case, fees pursuant to section 13 of the Act on the Remuneration of Lawyers as well as the necessary expenses of the patent attorney shall be reimbursed.

**Section 52a**  
**Assertion of invalidity**

A party may invoke the lack of legal validity of a registered design only by filing a counterclaim for the determination or declaration of invalidity or by filing an application in accordance with section 34.

**Section 52b**  
**Counterclaim for the determination or  
declaration of invalidity**

- (1) The design courts shall have jurisdiction for counterclaims for the determination or declaration of invalidity of a registered design in so far as these are filed in connection with actions in respect of infringement of the same registered design. Section 34 shall apply mutatis mutandis.
- (2) The counterclaim shall not be admissible if a non-appealable decision has been taken in invalidity proceedings (section 34a) on the same matter in dispute between the same parties.
- (3) Upon motion of the holder of the registered design the court may, after hearing the other parties, suspend the proceedings and invite the person filing the counterclaim to submit an application for the determination or declaration of invalidity of this registered design to the German Patent and Trade Mark Office within a time limit which the court shall determine. If the application is not made within the time limit, the proceedings shall continue; the counterclaim shall be deemed withdrawn. The court may issue injunctions for the duration of the suspension of the proceedings and take protective measures.
- (4) The court shall inform the German Patent and Trade Mark Office of the date on which the counterclaim was filed. The German Patent and Trade Mark Office shall record the date of filing in the Register. The court shall transmit a copy of the final judgment to the German Patent and Trade Mark Office. The German Patent and Trade Mark Office shall record the outcome of the proceedings, including the date on which the decision became final, in the Register.

**Section 53**  
**Place of jurisdiction for claims under this Act and  
under the Act Against Unfair Competition**

Claims in respect of legal relationships which are regulated under this Act and which are also based on the provisions of the Act Against Unfair Competition may, in derogation of section 14 of the Act Against Unfair Competition, be asserted before the court having jurisdiction for the design litigation case.

**Section 54**  
**Reduction of the value in dispute**

- (1) Where, in civil legal disputes in which by means of an action a right is asserted from one of the legal relationships regulated under this Act, a party substantiates that the burden of the costs of the proceedings based on the full value in dispute would pose a substantial risk to his economic situation, the court may, upon motion by that party, order that such party's obligation to pay court costs shall be proportionate to a part of the value in dispute as adjusted to his economic situation.
- (2) The order in accordance with subsection (1) shall have the effect that the beneficiary shall also have to pay the fees of his lawyer only in relation to this part of the value in dispute. In so far as costs of the proceedings are imposed on such party or the latter assumes these costs, that party shall reimburse the court fees paid by the opposing party and the fees of his lawyer only in relation to the part of the value in dispute. Where the extra-judicial costs are imposed on the opposing party or assumed by that party, the beneficiary's lawyer may recover his fees from the opposing party in relation to such value in dispute as applies to the latter.
- (3) The motion in accordance with subsection (1) may be declared before and recorded with the court registry. It shall be made before the hearing on the merits. Thereafter it shall be

admissible only where the court subsequently increases the presumed or assessed value in dispute. The opposing party shall be heard before the decision is taken on the motion.

**Part 10**  
**Provisions regarding measures taken**  
**by the customs authority**

**Section 55**  
**Seizure on import or export**

(1) Where an infringement in accordance with section 38 (1), first sentence, has obviously been committed, the relevant product shall be subject, upon request and security being given by the right holder, to seizure by the customs authority, on import or export, in so far as there is no requirement to apply Council Regulation (EC) No 1383/2003 of 22 July 2003 concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights (OJ L 196, 2.8.2003, p. 7), as amended. This shall apply to transactions with other Member States of the European Union and with other Contracting Parties to the Agreement on the European Economic Area only to the extent that controls are carried out by the customs authorities.

(2) Where the customs authority orders seizure, it shall without delay notify the person entitled to exercise control as well as the right holder. The right holder shall be informed of the origin, quantity and place of storage of the products as well as the name and address of the person entitled to exercise control; the privacy of correspondence and posts (Article 10 of the Basic Law) shall thus be restricted. The right holder shall be given the opportunity to inspect the products, provided this does not interfere with business or trade secrets.

**Section 56**  
**Confiscation, objection**

(1) Where no objection is lodged in respect of the seizure before the expiry of a period of two weeks following service of the communication in accordance with section 55 (2), first sentence, at the latest, the customs authority shall order confiscation of the seized products.

(2) Where the person entitled to exercise control objects to the seizure, the customs authority shall notify the right holder thereof without delay. The right holder shall declare to the customs authority without delay whether he upholds the request in accordance with section 55 (1) in respect of the seized products.

(3) Where the right holder withdraws his request, the customs authority shall revoke the seizure without delay. Where the right holder upholds the request and he submits an enforceable court decision ordering the impounding of the seized products or imposing a restriction on the control, the customs authority shall take the necessary measures.

(4) Where the cases referred to in subsection (3) do not apply, the customs authority shall revoke the seizure after the expiry of a period of two weeks following service of the communication to the right holder in accordance with subsection (2), first sentence. Where the right holder proves that he has requested, but not yet received, a court decision in accordance with subsection (3), second sentence, the seizure shall remain in force for a maximum of a further two weeks.

(5) Where the seizure proves to have been unjustified as from the outset and the right holder has upheld the request in accordance with section 55 (1) in respect of the seized products or did not without delay make a declaration (subsection (2), second sentence), he shall be obliged to compensate the person entitled to exercise control for the damage caused by the seizure.

**Section 57**  
**Jurisdictions, appellate remedies**

(1) The request in accordance with section 55 (1) shall be made to the Federal Finance Office and shall remain in force for one year in so far as no request has been made for a

shorter duration; the request may be repeated. The right holder shall be charged with the costs of official acts connected with the request subject to section 178 of the Fiscal Code.  
(2) Seizure and confiscation may be contested using the appellate remedies admissible in respect of seizure and confiscation in regulatory fining proceedings in accordance with the Act on Regulatory Offences. The right holder shall be heard in the appeal proceedings. An immediate appeal may be filed from a local court decision; the higher regional court shall decide on it.

**Section 57a**  
**Procedure in accordance with**  
**Council Regulation (EC) No 1383/2003**

- (1) Where, in accordance with Article 9 of Council Regulation (EC) No 1383/2003, the competent customs authority suspends the release of or detains goods, it shall inform the right holder thereof without delay as well as the declarant or the holder or the owner of the goods.
- (2) In the case referred to in subsection (1), the right holder may request the destruction of goods under the simplified procedure described below within the meaning of Article 11 of Council Regulation (EC) No 1383/2003.
- (3) The request must be made in writing to the customs authority within ten working days or, in the case of perishable goods, within three working days of receipt of the information in accordance with subsection (1). The request shall contain the information that the goods forming the subject of the proceedings infringe a right protected under this Act. The written consent of the declarant, the holder or the owner of the goods to destruction of the goods shall be attached. In derogation of the third sentence, the declarant, the holder or the owner may make the written declaration as to whether he does or does not consent to destruction directly to the customs authority. Before expiry and upon request by the right holder, the time limit referred to in the first sentence may be extended by a further ten working days.
- (4) Consent to destruction shall be deemed to have been given if the declarant, the holder or the owner of the goods has not objected to destruction within ten working days or, in the case of perishable goods, within three working days of receipt of the information in accordance with subsection (1). This fact shall be pointed out in the information in accordance with subsection (1).
- (5) The goods shall be destroyed at the expense and under the responsibility of the right holder.
- (6) The customs office may take over the organisational handling of the destruction. Subsection (5) shall remain unaffected.
- (7) The period of storage pursuant to Article 11 (1), second indent, of Council Regulation (EC) No 1383/2003 shall be one year.
- (8) In other respects, sections 55 to 57 shall apply mutatis mutandis, unless Council Regulation (EC) No 1383/2003 contains provisions which preclude this.

**Part 11**  
**Special provisions**

**Section 58**  
**Domestic representative**

(1) Any person who has neither their residence nor principal place of business nor an establishment in Germany may participate in the proceedings before the German Patent and Trade Mark Office or the Federal Patent Court which are regulated under this Act and assert the rights conferred by a registered design only if he has appointed a lawyer or patent attorney in Germany as his representative who is authorised to represent him in proceedings before the German Patent and Trade Mark Office, before the Federal Patent Court and in civil litigation affecting the registered design, as well as to file an application for criminal prosecution.

(2) Nationals of a Member State of the European Union or of another Contracting Party to the Agreement on the European Economic Area can be appointed as a representative within the meaning of subsection (1) for the purpose of providing a service within the meaning of the Treaty establishing the European Community if they are entitled to practise their professional activity under one of the professional titles referred to in the Annex to section 1 of the Act on the Activities of European Lawyers in Germany of 9 March 2000 (Federal Law Gazette I p. 182) or to section 1 of the Act on the Qualifying Examination for Admission to Practise as a Patent Attorney of 6 July 1990 (Federal Law Gazette I p. 1349, 1351), as amended.

(3) The place where a representative appointed pursuant to subsection (1) has his commercial premises shall be deemed, within the meaning of section 23 of the Code of Civil Procedure, to be the place where the asset is located; if there are no such commercial premises, the place where the representative is residing in Germany shall be decisive or, if there is no such place, the place where the German Patent and Trade Mark Office has its seat.

(4) The legal termination of the appointment of a representative in accordance with subsection (1) shall not become effective until the German Patent and Trade Mark Office or the Federal Patent Court has been informed of both the termination of this appointment and the appointment of another representative.

### **Section 59**

#### **Arrogation of a registered design**

Any person who uses a designation which is likely to create the impression that a product is protected by a registered design shall be obliged to provide information on demand regarding the registered design upon which use of the designation is based to any person having a legitimate interest in knowing the legal situation.

### **Section 60**

#### **Registered designs under the Extension Act**

(1) The provisions of this Act shall apply to all registered designs extended in accordance with the Act on the Extension of Industrial Property Rights (Extension Act) of 23 April 1992 (Federal Law Gazette I p. 938), as last amended by Article 2 paragraph 10 of the Act of 12 March 2004 (Federal Law Gazette I p. 390), unless otherwise provided under subsections (2) to (7).

(2) The term of protection for registered designs which did not lapse on 28 October 2001 shall end twenty-five years after the end of that month in which the date of filing falls. Renewal of the protection shall be effected by means of payment of a renewal fee for the sixteenth to twentieth year and for the twenty-first to twenty-fifth year, calculated from the date of filing.

(3) Where the claim for remuneration on account of the use of a registered design has already arisen in accordance with those statutory provisions which were applicable up until the entry into force of the Extension Act, the remuneration shall still be paid in accordance with these provisions.

(4) Any person who has lawfully commenced use of a registered design, in accordance with the statutory provisions applicable up until the entry into force of the Extension Act, which was protected by an inventor's certificate extended under section 4 of the Extension Act, as amended on 31 May 2004, or in respect of which an inventor's certificate had been sought, may continue to use it within the whole federal territory. The holder of the industrial property right may require appropriate remuneration from the person entitled to use the registered design with respect to its continued use.

(5) Where an application for a patent for an industrial design which was extended in accordance with section 4 of the Extension Act, as amended on 31 May 2004, was published in accordance with section 10 (1) of the Ordinance on Industrial Designs of 17 January 1974 (Law Gazette I No. 15 p. 140), as amended by the Ordinance of 9 December 1988 (Law Gazette I No. 28 p. 333), this shall be equal to publication of the registration of the

application in the Design Register (Musterregister) in accordance with section 8 (2) \* of the Design Act (Geschmacksmustergesetz) in the version applicable until midnight on 31 May 2004.

(6) In so far as registered designs extended under the Extension Act to the territory designated in Article 3 of the Unification Treaty or to the remaining federal territory are concurrent in their scope of protection and therefore collide as a result of extension, the holders of such titles or applications may not assert rights deriving from those titles or applications, irrespective of their filing or priority date, either against each other or against persons authorised by the holder of the other title or the other application to use them. However, the subject matter of the title or of the application may not be used or may only be used with restrictions in the territory to which the title or the application has been extended if unlimited use would lead to a particular disadvantage for the holder of the other title or of the other application or for persons he has authorised to use the subject matter of his title or of his application and would be unreasonable, when taking into account all the circumstances of the case and when weighing up the justified interests of those concerned.

(7) The effect of a registered design extended under section 1 or section 4 of the Extension Act, as amended on 31 May 2004, shall not apply to any person who had lawfully begun to use the registered design in the territory in which the title did not apply up until the entry into force of the Extension Act after the day which is operative for the filing or priority date of the application and prior to 1 July 1990. Such person shall be authorised to use the registered design in the whole of the federal territory for the needs of his own business in his own plant or workshops or the plant or workshops of others with the limitations resulting from the application, mutatis mutandis, of section 12 of the Patent Act, on condition that the use does not cause particular prejudice to the holder of the title or the persons he has authorised to use the subject matter of his title and would be unreasonable when taking into account all the circumstances of the case and when weighing up the justified interests of those concerned. In the case of a product manufactured abroad, the user shall only have a right to continued use under the first sentence if the use in Germany has led to a property situation which warrants protecting and whose non-recognition, taking into account all the circumstances of the case, would represent an unreasonable hardship for the user.

\* Translator's note: The German text erroneously refers to "Nr. 2".

## **Section 61**

### **Typographic typefaces**

(1) Legal protection shall be granted under this Act to all typographic typefaces registered in accordance with Article 2 of the Typefaces Act in the version applicable until midnight on 1 June 2004, unless otherwise provided in subsections (2) to (5).

(2) The provisions on the conditions of protectability shall continue to apply for applications filed before midnight on 31 May 2004 in accordance with Article 2 of the Typefaces Act in the version applicable on that date.

(3) Rights conferred by registered designs may not be exercised in respect of acts which were begun before 1 June 2004 and which the holder of the typographic typeface could not have prohibited in accordance with the provisions applicable on that date.

(4) Until such time as the typefaces referred to in subsection (1) are registered, their protective effects shall be determined by the Typefaces Act in the version applicable until midnight on 31 May 2004.

(5) In derogation of section 28 (1), first sentence, renewal fees shall be payable only from the eleventh year of the term of protection to maintain the term of protection for the typefaces referred to in subsection (1).

## **Part 12**

### **Community designs**

## **Section 62**

### **Forwarding of the application**

Where applications for a Community design are filed with the German Patent and Trade Mark Office in accordance with Article 35 (2) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ L 3, 5.1.2002, p. 1), the German Patent and Trade Mark Office shall make a note on the application of the date of receipt and shall forward the application, without examination and without delay, to the Office for Harmonisation in the Internal Market (Trade Marks and Designs).

## **Section 62a**

### **Application of the provisions of this Act to Community designs**

In so far as German law is applicable, the following provisions of this Act shall apply mutatis mutandis to the rights of the holder of a Community design protected under Council Regulation (EC) No 6/2002:

1. the provisions on rights to removal of the impairment (section 42 (1), first sentence), to compensation for damage caused (section 42 (2)), to destruction, to recall and release (section 43), to information (section 46), to production and inspection (section 46a), to securing claims for damages (section 46b) and to the publication of the judgment (section 47), along with the rights under Article 89 (1) (a) to (c) of Council Regulation (EC) No 6/2002;
2. the provisions on the liability of the owner of an enterprise (section 44), compensation (section 45), limitation (section 49) and on claims under other statutory provisions (section 50);
3. the provisions on requests for seizure on import or export (sections 55 and 57).

## **Section 63**

### **Community design litigation**

(1) The regional courts shall have exclusive jurisdiction as Community design courts of first instance for all actions for which the Community design courts within the meaning of Article 80 (1) of Council Regulation (EC) No 6/2002 have jurisdiction (Community design litigation), irrespective of the value in dispute.

(2) The Land governments shall be authorised to assign, by statutory instrument, Community design litigation cases for the districts of more than one Community design court to one of these courts. The Land governments may delegate this authorisation by statutory instrument to the Land departments of justice.

(3) The Länder may, by agreement, delegate duties incumbent upon the Community design courts of one Land to the competent Community design court of another Land, in whole or in part.

(4) Section 52 (4) and sections 53 and 54 shall apply mutatis mutandis to proceedings before the Community design courts.

## **Section 63a**

### **Communication to the European Commission**

The Federal Ministry of Justice and Consumer Protection shall communicate to the Commission of the European Communities which Community design courts of first and second instance have been designated in accordance with Article 80 (1) of Council Regulation (EC) No 6/2002 as well as of any change in the number, name or territorial jurisdiction of these courts.

## **Section 63b**

### **Territorial jurisdiction of the Community design courts**

Where, in accordance with Article 82 of Council Regulation (EC) No 6/2002, German Community design courts have international jurisdiction, those provisions shall apply mutatis mutandis to the territorial jurisdiction of these courts which would be applicable if the

application was an application for a design filed with the German Patent and Trade Mark Office or the registered design was a design registered in the Register of the German Patent and Trade Mark Office. Where jurisdiction is not established on this basis, then the court shall have territorial jurisdiction with which the claimant has his general venue.

### **Section 63c**

#### **Insolvency proceedings**

(1) If the insolvency court is aware that a Community design registered or applied for is part of the insolvency estate, it shall request the Office for Harmonisation in the Internal Market (Trade Marks and Designs), by direct communication, to record the following particulars in the Register of Community designs or, if it is an application, in the application files:

1. about the opening of the proceedings and, unless already contained in the Register, the order for restriction on property transfer,
2. about the release or sale of the Community design or the application for the Community design,
3. about the final and binding discontinuation of the proceedings,
4. about the final and binding termination of the proceedings, in the case of supervision of the debtor, however, only after such supervision has ended, and about a restriction on property transfer.

(2) The entry in the Register of Community designs or in the application files may also be requested by the insolvency administrator. In the case of debtor-in-possession management, the insolvency monitor shall take the place of the insolvency administrator.

### **Section 64**

#### **Order for enforcement**

The Federal Patent Court shall have jurisdiction to issue the order for enforcement in accordance with Article 71 (2), second sentence, of Council Regulation (EC) No 6/2002. The enforceable execution copy shall be issued by the registry clerk at the registry of the Federal Patent Court.

### **Section 65**

#### **Punishable infringement of a Community design**

(1) Any person who, contrary to Article 19 (1) of Council Regulation (EC) No 6/2002, uses a Community design although the holder has not given his consent shall be liable to imprisonment for up to three years or a fine.

(2) Section 51 (2) to (6) shall apply mutatis mutandis.

### **Part 13**

#### **Protection of industrial designs under the Hague Agreement**

### **Section 66**

#### **Application of this Act**

This Act shall apply mutatis mutandis to registrations of industrial designs under the Hague Agreement of 6 November 1925 Concerning the International Deposit of Industrial Designs (Hague Agreement) (Reich Law Gazette 1928 II p. 175, 203) and its amended versions signed in London on 2 June 1934 (Reich Law Gazette 1937 II p. 583, 617), in The Hague on 28 November 1960 (Federal Law Gazette 1962 II p. 774) and in Geneva on 2 July 1999 (Federal Law Gazette 2009 II p. 837) (international registrations) whose protection covers the territory of the Federal Republic of Germany, unless provided otherwise in this Part, in the Hague Agreement or its amended versions.

### **Section 67**

#### **Filing of the international application**

At the option of the applicant, the international application for industrial designs may be filed either directly with the International Bureau of the World Intellectual Property Organization (International Bureau) or through the German Patent and Trade Mark Office.

#### **Section 68**

##### **Forwarding of the international application**

Where international applications for industrial designs are filed with the German Patent and Trade Mark Office, the German Patent and Trade Mark Office shall make a note on the application of the date of receipt and shall forward the application, without examination and without delay, to the International Bureau.

#### **Section 69**

##### **Examination of grounds for non-registrability**

(1) International registrations shall be examined in respect of grounds for refusal in accordance with section 18 in the same manner as registered designs which have been filed for registration in the Register kept by the German Patent and Trade Mark Office. The refusal of the effects shall take the place of the refusal of the design application.

(2) Where the German Patent and Trade Mark Office finds in the course of the examination that there are grounds for non-registrability in accordance with section 18, it shall communicate to the International Bureau a notification of refusal of effects within six months from the date of publication of the international registration. The notification shall state all the grounds on which the refusal of effects is based.

(3) After the International Bureau has sent a copy of the notification of refusal of effects to the holder of the international registration, the German Patent and Trade Mark Office shall give the holder of the international registration the opportunity to respond to the refusal of effects and to renounce protection within a period of four months. Upon expiry of this period, the German Patent and Trade Mark Office shall decide whether or not to uphold the refusal of effects. If the German Patent and Trade Mark Office upholds the refusal of effects, the right holder shall have the same legal remedies against the decision as apply to the refusal of an application for registration of a registered design in the Register kept by the German Patent and Trade Mark Office. If the German Patent and Trade Mark Office does not uphold the refusal of effects or if it is finally determined that the protection was wrongfully refused, the German Patent and Trade Mark Office shall withdraw the refusal of effects without delay.

#### **Section 70**

##### **Subsequent withdrawal of protection**

(1) An application or a counterclaim for determination of invalidity of effects for the territory of the Federal Republic of Germany shall take the place of an application or a counterclaim for determination or declaration of invalidity in accordance with section 33 (1) or (2). An action for withdrawal of protection shall take the place of an action for consent to cancellation in accordance with section 9 (1). The court shall transmit to the German Patent and Trade Mark Office a copy of the final judgment. Section 35 shall apply mutatis mutandis.

(2) Where the German Patent and Trade Mark Office has been notified that the invalidity of effects of an international registration has been determined for the territory of the Federal Republic of Germany or that its protection has been withdrawn, it shall inform the International Bureau thereof without delay.

#### **Section 71**

##### **Effect of the international registration**

(1) An international registration whose protection refers to the territory of the Federal Republic of Germany shall have the same effect from the date of its registration as if it had been applied for as a registered design with the German Patent and Trade Mark Office and had been entered in its Register on that date.

(2) The effect referred to in subsection (1) shall be deemed not to have arisen if the international registration has been refused (section 69 (2)), the invalidity of its effects for the

territory of the Federal Republic of Germany has been determined (section 70 (1), first sentence) or protection has been withdrawn in accordance with section 9 (1) or section 34, first sentence (section 70 (1), second sentence).

(3) Where the German Patent and Trade Mark Office withdraws the notification of refusal, the international registration shall have retroactive effect for the Federal Republic of Germany from the date of its registration.

## **Part 14** **Transitional provisions**

### **Section 72** **Applicable law**

(1) In respect of registered designs for which an application was filed before 1 July 1988 in accordance with the Design Act (Geschmacksmustergesetz), as consolidated and published in the Federal Law Gazette III, Index No. 442-1, as last amended by Article 8 of the Act of 23 July 2002 (Federal Law Gazette I p. 2850), the provisions applicable until that date shall continue to apply.

(2) In respect of registered designs for which an application was filed or which were registered before 28 October 2001 the provisions on the conditions for protectability applicable on that date shall continue to apply. Rights conferred by these registered designs cannot be exercised if they concern acts within the meaning of section 38 (1) which were commenced before 28 October 2001 and which the aggrieved party could not have prohibited before that date in accordance with the provisions of the Design Act (Geschmacksmustergesetz), as consolidated and published in the Federal Law Gazette III, Index No. 442-1, in the version applicable on that date.

(3) For registered designs for which an application was filed before 1 June 2004 but which were not yet registered on that date, the provisions of the Design Act (Geschmacksmustergesetz), as consolidated and published in the Federal Law Gazette III, Index No. 442-1, as applicable until midnight on 31 May 2004 shall, up until registration, apply to the protective effects.

(4) Article 229 paragraph 6 of the Introductory Act to the Civil Code shall apply mutatis mutandis, with the proviso that section 14a (3) of the Design Act (Geschmacksmustergesetz), as consolidated and published in the Federal Law Gazette III, Index No. 442-1, as applicable until 1 January 2002, shall be equal to the provisions of the German Civil Code on limitation in the version applicable until 1 January 2002.

### **Section 73** **Limitations of rights**

(1) Rights conferred by a registered design cannot be exercised in respect of acts which concern the use of a component part for the repair of a complex product with a view to restoring its original appearance if these acts could not be prevented under the Design Act (Geschmacksmustergesetz), as consolidated and published in the Federal Law Gazette III, Index No. 442-1, in the version applicable until midnight on 31 May 2004.

(2) Section 31 (5) shall apply to existing licences for the right conferred by the application for or registration of a registered design which was granted before 1 June 2004 only if that right was transferred as of 1 June 2004 or the licence was granted as of that date.

(3) Rights to the citation of the designer in accordance with section 10 may be asserted only for registered designs for which an application was filed as of 1 June 2004.

(4) In respect of the protective effect of variations of basic designs in accordance with section 8a of the Design Act (Geschmacksmustergesetz), as applicable until midnight on 31 May 2004, the provisions of the Design Act (Geschmacksmustergesetz), as consolidated and published in the Federal Law Gazette III, Index No. 442-1, in the version applicable until midnight on 31 May 2004, shall apply. Section 28 (2) shall apply to the renewal of variations of a basic design, with the proviso that the basic designs shall be considered first.

**Section 74**

**Transitional provision on the Act to Modernise the  
Design Act (Geschmacksmustergesetz) and Amend  
the Regulations on Notifications of Exhibition Protection**

- (1) Designs which had been applied for or registered until the entry into force of the Act of 10 October 2013 (Federal Law Gazette I p. 3799) on 1 January 2014 shall be designated “registered designs” as of that date.
- (2) Section 52a shall apply only to design litigation proceedings which became pending after 31 December 2013.