

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

Translation provided by Ute Reusch in cooperation with the German Patent and Trade Mark Office

Stand: Die Übersetzung berücksichtigt die Änderung(en) des Gesetzes durch Artikel 10 des Gesetzes vom 10. August 2021 (BGBl. I S. 3490)

Version information: The translation includes the amendment(s) to the Act by Article 10 of the Act of 10 August 2021 (Federal Law Gazette I p. 3490)

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Act on the Legal Protection of Designs (Designgesetz – DesignG)

Design Act in the version published on 24 February 2014 (Federal Law Gazette I, p. 122), as last amended by Article 10 of the Act of 10 August 2021 (Federal Law Gazette I, p. 3490)

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 (1) of that Act, it enters into force on 1 June 2004. Pursuant to Article 6 (2), section 26, section 52 (2) and section 63 (2) enter into force with effect from 19 March 2004.

Division 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 is protected as a registered design if it is new and has individual character.
- (2) A design is deemed to be new if no identical design was disclosed prior to the date of filing of the application. Designs are deemed to be identical if their features differ only in immaterial details.
- (3) A design has 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 is taken into consideration.

Section 3

Exclusion from design protection

(1) The following are 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 6ter 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 are not 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 is deemed to be new and has 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 is not 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 is not taken into consideration for the purpose of applying section 2 (2) and (3) if a design was made available to the public during the 12-month period preceding the date of filing of the application by the designer or the designer's successor in title or by a third party as a result of information provided or action taken by the designer or the designer's successor in title. The same applies if the design was disclosed as a consequence of an abuse in relation to the designer or the designer's successor in title.

Division 2
Entitled persons

Section 7
Right in registered design

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

(2) Where a design is created by an employee in the execution of his or her duties or following the instructions given by the employee's employer, the right in the registered design belongs to the employer, unless otherwise provided by contract.

Section 8
Formal entitlement

The applicant and the right holder are 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 under section 7, the entitled person can, notwithstanding other claims, demand assignment of the registered design or consent to its cancellation. If consent to cancellation is given, the registered design is, to this extent, deemed not to have had, as from the outset, protective effects. Any one 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 does 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) sentence 1, licences and other rights 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 or she may continue such exploitation if a request is made for 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 is to be granted for a reasonable period at reasonable terms. Sentences 2 and 3 do not apply if the right holder or the licensee was acting in bad faith when the exploitation began or preparations to do so were made.

(4) The institution of legal proceedings under the terms of 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 are recorded in the Register of Registered Designs (Register).

Section 10
Citation of designer

The designer has 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 their citation.

Division 3
Registration procedure

Section 11
Application

(1) The application for registration of a design in the Register is to 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 must 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) sentence 1, 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) sentence 1,
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 as required by subsection (3) and subsection (5) no. 3 has 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 does 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 (*Patentkostengesetz*) is higher than the application fees which have been paid, then the differential amount is to be subsequently paid.

Section 13

Date of filing

(1) The date of filing of the application for a design is 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) sentence 2, section 21 (1) sentence 1, section 33 (2) no. 2 and section 41 the date of priority takes 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 is required to indicate the date, country and file number of the earlier application before the expiry of a period of 16 months from the date of priority and to 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, insofar 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) applies.

(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 records 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 is thus 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 is deemed not to have been made. This is determined by the German Patent and Trade Mark Office.

Section 15 **Exhibition priority**

(1) If 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,

then, if the application is filed within a period of six months following the first display, the applicant may claim a right of priority from that date.

(2) Notice of the exhibitions referred to in subsection (1) no. 1 is 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 are determined in each individual case by the Federal Ministry of Justice and Consumer Protection and notice thereof is published in the Federal Gazette.

(4) Any person who claims a priority as per subsection (1) is required to indicate, before the expiry of a period of 16 months following the date on which the design was first displayed, that date and the exhibition and to submit proof of that display. Section 14 (3) applies accordingly.

(5) The exhibition priority under subsection (1) does not extend the periods of priority specified in section 14 (1).

Section 16 **Examination of application**

(1) The German Patent and Trade Mark Office examines whether

1. the application fees specified in section 5 (1) sentence 1 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, 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 determines which designs will be taken into consideration. In other respects, the application is deemed to be withdrawn. This is determined by the German Patent and Trade Mark Office.

(3) In the case of deficiencies as referred to in subsection (1) nos. 2 and 3, the German Patent and Trade Mark Office requests 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, then, in the case of deficiencies as specified in subsection (1) no. 2, the German Patent and Trade Mark Office accords, 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 decides to refuse the application.

Section 17

Further processing of 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 becomes 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 is to be filed within a period of one month following service of the decision on the refusal of the design application. The omitted act is to be completed within this period.

(3) Re-establishment of rights is 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) sentence 1 of the Patent Costs Act.

(4) The unit competent to decide on the omitted act decides 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 refuses the application.

Section 19

Keeping of Register, registration and design information

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

(2) The German Patent and Trade Mark Office records the applicant's particulars requiring registration in the Register without examining that applicant's entitlement to file the application and the correctness of the particulars furnished in the application, and it determines which classes of goods are to be recorded.

(3) The German Patent and Trade Mark Office may transmit the particulars entered in the Register to third persons in electronic form for further processing or use for the purposes of providing design information. Such transmission is not made where inspection is ruled out under section 22 (3).

Section 20

Publication

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

(2) Publication may be made in electronic form.

Section 21

Deferment of publication

(1) When filing the application, the deferment of publication of the representation may be requested for a period of 30 months following the date of filing of the application. Upon such request, the publication is confined to the registration of the design 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) sentence 1 of the Patent Costs Act within the deferment period. Where use has been made of the possibility referred to in section 11 (2) sentence 2, a representation of the design is also to be submitted within the deferment period.

(3) Publication together with the representation as referred to in section 20 is to be subsequently done together with a reference to the publication as referred to in subsection (1) sentence 2 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 Register

(1) Any person is 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 exists if

1. the representation has been published,
2. the applicant or right holder has consented thereto or
3. a legitimate interest is substantiated.

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

(3) Inspection of the files in accordance with subsections (1) and (2) is ruled out to the extent that

1. it is precluded by legal provision,
2. an interest meriting protection of the data subject within the meaning of Article 4 no. 1 of Regulation (EU) 679/2016 of the European Parliament and of the Council of 27 April 2016 on the protection of natural persons with regard to the processing of personal data and on the free movement of such data, and repealing Directive 95/46/EC (General Data Protection Regulation) (OJ L 119, 4.5.2016, p. 1; L 314, 22.11.2016, p. 72; L 127, 23.5.2018, p. 2), as amended, obviously prevails, or
3. it relates to content in the files which is obviously contrary to public order or good morals.

Section 22a

Data protection

Insofar as the Register or publicly available electronic information services of the German Patent and Trade Mark Office contain personal data, the following does not apply:

1. the right of access pursuant to Article 15 (1) (c) of Regulation (EU) 2016/679,
2. the notification obligation pursuant to Article 19 sentence 2 of Regulation (EU) 2016/679, and

3. the right to object pursuant to Article 21 (1) of Regulation (EU) 2016/679.

The right to obtain a copy pursuant to Article 15 (3) of Regulation (EU) 2016/679 is deemed to be satisfied where the data subject has been granted inspection of the Register or publicly available information services of the German Patent and Trade Mark Office.

Section 23

Procedural provisions, appeal and appeal on points of law

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

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

(3) Sections 41 to 44, section 45 (2) sentence 2 and sections 47 to 49 of the Code of Civil Procedure (*Zivilprozessordnung*) on the exclusion of and objection to court personnel apply accordingly to the exclusion of and objection to members of the Design Units and Design Divisions. If a decision is required, such decision on an objection request is 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 apply accordingly.

(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 takes the decision on the appeal. Subsection (2) sentence 2 and 3 applies, with the proviso that the Board of Appeal sitting in a composition of three legally qualified members takes a decision by non-appealable order as regards enlarging the panel; section 100 (3) no. 1 of the Patent Act does not apply to the enlargement or non-enlargement of the panel. Sections 69, 70 (2), 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 apply accordingly. Section 84 (2) sentence 2 and 3 of the Patent Act applies accordingly 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 under 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 apply accordingly.

Section 24

Legal aid

Applying sections 114 to 116 of the Code of Civil Procedure accordingly, the applicant receives legal aid in proceedings in accordance with section 23 (1) upon request if there is sufficient prospect of the design being registered in the Register. Applying section 132 (2) of the Patent Act accordingly, a party to the proceedings in accordance with section 34a is to be granted legal aid upon request. 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) sentence 1

and for the renewal fees in accordance with section 28 (1) sentence 1. Section 130 (2) and (3) as well as sections 133 to 138 of the Patent Act apply accordingly.

Section 25

Electronic conduct of proceedings, authorisation to issue statutory instruments

- (1) Insofar 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) and (2) sentence 1, (5) and (6) of the Code of Civil Procedure applies accordingly.
- (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 apply accordingly in other respects, unless otherwise provided under this Act.
- (3) The Federal Ministry of Justice and Consumer Protection determines, by statutory instrument not requiring the approval 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 is to 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.

Section 26

Authorisation to issue statutory instruments

- (1) The Federal Ministry of Justice and Consumer Protection regulates the following by statutory instrument not requiring the approval 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) sentence 2,
 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,
 8. the procedure before the German Patent and Trade Mark Office for the protection of designs under the Hague Agreement,
 9. the procedure before the German Patent and Trade Mark Office on the determination or declaration of invalidity of a registered design as per section 34a, and
 10. the taking into account of public holidays in relation to time limits and deadlines for all the offices of the German Patent and Trade Mark Office.

(2) The Federal Ministry of Justice and Consumer Protection is authorised, by statutory instrument not requiring the approval 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, are 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) sentence 4) against a decision in proceedings under this Act.

(3) Section 23 (3) sentence 1 and 2 applies accordingly to the exclusion of and objection to a person entrusted in accordance with subsection (2) sentence 1.

(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 approval of the Bundesrat, in full or in part, to the German Patent and Trade Mark Office.

Division 4

Accrual and term of protection

Section 27

Accrual and term of protection

(1) Protection accrues upon registration in the Register.

(2) The term of protection of a registered design is 25 years, calculated from the date of filing of the application.

Section 28

Renewal

(1) Renewal of protection is effected by payment of a renewal fee for the 6th to 10th, 11th to 15th, 16th to 20th and the 21st to 25th year of the term of protection in each case. It is 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 are taken into consideration in the order of the application.

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

Division 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) If the registered design belongs to an enterprise or a part of an enterprise, then in cases of doubt the registered design is covered by the assignment or the transfer of the enterprise or the part of the enterprise to which the registered design belongs.

(3) Upon the request of the right holder or of the successor in title, the transfer of the right in the registered design is 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 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 is 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) If the right in a registered design is involved in insolvency proceedings, this is 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, sentence 1 applies accordingly to the share of the joint owner. In the case of debtor-in-possession management (section 270 of the Insolvency Code (*Insolvenzordnung*)), the insolvency monitor takes 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 does not apply to the holder of an exclusive licence if the right holder, after having been invited to do so, does not institute infringement proceedings within an appropriate period.

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

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

Section 32

Design application

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

Division 6

Invalidity and cancellation

Section 33

Invalidity

(1) A registered design is 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 under section 3.

(2) A registered design is 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.

(3) Invalidity is 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 is 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.

(6) In the case of invalidity pursuant to subsections (1) and (2), the holder of the registered design may consent to cancellation by making a declaration to the German Patent and Trade Mark Office. The registration of a design which is to be cancelled is deemed not to have had any protective effects as from the outset.

Section 34

Entitlement to institute invalidity proceedings

Any person is entitled to file an application for the determination of invalidity in accordance with section 33 (1). Only the holder of the right concerned is 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 remains unaffected.

Section 34a

Invalidity proceedings before German Patent and Trade Mark Office

(1) The application is to be filed in writing with the German Patent and Trade Mark Office. The facts and evidence in support of the grounds are to be indicated. Section 81 (6) and section 125 of the Patent Act apply accordingly. The application is not 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 serves the application on the holder of the registered design and invites the holder to comment on the application within a period of one month following service of the application. If the right holder does not contest the application within this period, the invalidity is determined or declared. If the parties declare the proceedings in the main action terminated or the applicant withdraws the application, the proceedings are terminated by decision; the decision, with the exception of the decision on the costs of the proceedings as referred to in subsection (5), is non-appealable.

(3) If the application is contested in due time, the German Patent and Trade Mark Office informs the applicant that the application has been contested and makes the orders necessary in preparation of the decision. A hearing is held upon request of one of the parties or if the German Patent and Trade Mark Office deems it to be expedient. For the purposes of taking evidence, the examination of witnesses and experts as well as the examination or hearing of parties may be ordered, visual inspection may be made or the probative value of a submitted document assessed; the provisions of Book 2 of the Code of Civil Procedure regarding such evidence apply accordingly. Section 128a of the Code of Civil Procedure applies accordingly. Minutes are to 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 apply accordingly.

(4) The decision is issued by way of an order. The substance of the decision may be delivered at the end of the hearing. The decision must be reasoned and a copy served on

the parties ex officio; the copy need not be certified. Execution copies are only made upon the application of one of the parties and only in paper form. Section 47 (2) of the Patent Act applies accordingly.

(5) The decision includes a decision on the costs of the proceedings; section 62 (2) and section 84 (2) sentence 2 of the Patent Act apply accordingly. In the cases referred to in subsection (2) sentence 2 and 3, the German Patent and Trade Mark Office decides on the costs of the proceedings upon application only; the decision on the costs may be issued by separate decision. Such application may be made as follows:

1. in the case referred to in subsection (2) sentence 2, up until the expiry of one month after the decision on the determination or declaration of invalidity has become non-appealable,
2. in the case referred to in subsection (2) sentence 3, up until the expiry of one month following service of the decision to terminate the proceedings.

If no decision is taken as to costs, each of the parties bears their own costs arising.

(6) A determination as to the value in dispute is made by decision upon application. Where a decision is given on the costs, a decision on the value in dispute may be given ex officio. The decision on the value in dispute may be combined with the decision on the costs. Section 23 (3) sentence 2 and section 33 (1) of the Lawyer's Remuneration Act (*Rechtsanwaltsvergütungsgesetz*) apply accordingly to the determination as to the value in dispute.

Section 34b Suspension

If, 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 is to be ordered if 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 is bound by this decision only if it has been issued between the same parties. Section 52b (3) sentence 3 applies accordingly.

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 that third party can substantiate that

1. proceedings for infringement of the same registered design are pending against them or
2. they have 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 sentence 1 no. 1 or from receipt of the cease and desist request referred to in sentence 1 no. 2.

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

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) no. 1 or no. 3,

insofar 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) sentence 1 no. 3 is to be submitted to the German Patent and Trade Mark Office.

Section 36 Cancellation

(1) A registered design is 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 a public or publicly certified document with such declarations as are referred to in no. 2 is submitted with the request;
4. in the case of consent to cancellation in accordance with section 9 or section 33 (6) sentence 1;
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) nos. 2 and 3, if the right holder declares his or her 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 is made in the Register.

Division 7 Protective effects and limitation of protection

Section 37 Object of protection

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

(2) If, for the purposes of deferring publication, an application contains a specimen of a two-dimensional design as referred to in section 11 (2) sentence 2, then in the case of proper extension upon the expiry of the deferment under section 21 (2) the object of protection is determined in accordance with the submitted representation of the registered design.

Section 38 Rights conferred by registered design and scope of protection

(1) The registration of a design confers on its holder the exclusive right to use it and to prevent any third party not having consent from using it. Such use covers, 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 includes 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 is taken into consideration.

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

Section 39

Presumption of legal validity

It is 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 rights conferred by 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 40a

Repairs clause

(1) Protection as a design does not exist for a design incorporated in or applied to a product which constitutes a component part of a complex product used for the sole purpose of enabling the repair of that complex product so as to restore its original appearance. This does not apply if the main purpose for which the aforementioned component is put on the market is other than the repair of the complex product.

(2) Subsection (1) only applies if consumers are duly informed, by means of an identification mark or in other appropriate form, about the origin of the product used for repair purposes so that they are able, with full knowledge of the facts, to make an informed choice between competing products.

Section 41

Right of prior use

(1) Rights provided for in section 38 cannot 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 is entitled to use the design. The issuing of licences (section 31) is ruled out.

(2) The rights of the third party are not 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.

Division 8

Legal infringements

Section 42

Removal, cessation and desistance, and damages

(1) Any person who uses a registered design contrary to section 38 (1) sentence 1 (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) If the infringer acts intentionally or negligently, he or she is 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 the infringer 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. Sentence 1 applies accordingly 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 or her possession to the aggrieved party against equitable remuneration which may not exceed the manufacturing costs.

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

(5) Essential elements of buildings as defined in section 93 of the Civil Code (*Bürgerliches Gesetzbuch*) as well as removable parts of products and equipment whose production and distribution is not unlawful are not subject to the measures provided for under subsections (1) to (3).

Section 44

Liability of owner of enterprise

If a registered design has been unlawfully infringed in an enterprise by an employee or representative, the aggrieved party also has 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

If the infringer acts neither intentionally nor negligently, then, in order to avert the claims under sections 42 and 43, the infringer may compensate the aggrieved party in money if fulfilling the claims would cause disproportionate damage to him or her and the aggrieved party can be reasonably expected to accept the pecuniary compensation. The amount to be paid in compensation is the amount which would have constituted equitable remuneration had the right been granted. Upon payment of the compensation the aggrieved party's consent is 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, no. 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 sentence 1, 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 is required to 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) are 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, that person is 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 (2) is liable to third parties only if they knew that they were 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 (*Ordnungswidrigkeitengesetz*) 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) If the information can be provided only by using traffic data (section 3 no. 70 of the Telecommunications Act (*Telekommunikationsgesetz*)), a court order regarding the admissibility of the use of the traffic data must first 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 or her residence, principal place of business or an establishment has exclusive jurisdiction, irrespective of the value in dispute. The civil division decides. The provisions of the Act on Proceedings in Family Matters and in Matters of Non-Contentious Jurisdiction (*Gesetz über das Verfahren in Familiensachen und in den Angelegenheiten der freiwilligen Gerichtsbarkeit*) apply accordingly to the proceedings. The costs of the court order are borne by the aggrieved party. An appeal from the decision of the regional court is the available remedy. The notice of appeal is to be lodged within a period of two weeks. The provisions concerning the protection of personal data otherwise remain unaffected.

(10) The basic right to privacy of telecommunications (Article 10 of the Basic Law) is restricted 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 or her 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 extends to the production of bank, financial or commercial documents. If the alleged infringer asserts that the information concerned is confidential, the court takes the measures necessary to ensure the specific protection required in an individual case.

(2) The claim under subsection (1) is 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 takes the measures necessary to ensure the protection of confidential information. This in particular applies to those cases where the injunction is issued without giving a prior hearing to the opposing party.

(4) Section 811 of the Civil Code and section 46 (8) apply accordingly.

(5) If there was no infringement or no risk of infringement, the alleged infringer may claim compensation for the damage caused to him or her 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. If the infringer asserts that the information is confidential, the court takes the measures necessary to ensure the specific protection required in an individual case.

(2) The claim under subsection (1) is 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 takes the measures necessary to ensure the protection of confidential information. This in particular applies to those cases where the injunction is issued without giving a prior hearing to the opposing party.

(4) Section 811 of the Civil Code and section 46 (8) apply accordingly.

Section 47

Publication of 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 are laid down in the judgment. The entitlement lapses if it is not used within three months after the judgment becomes final. The pronouncement in accordance with sentence 1 is not provisionally enforceable.

Section 48

Exhaustion

The rights conferred by the registered design do 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 if 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 or her consent.

Section 49

Limitation

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

Section 50

Claims under other statutory provisions

Claims under other statutory provisions remain unaffected.

Section 51

Criminal provisions

(1) Any person who uses a registered design contrary to section 38 (1) sentence 1 although the right holder has not consented thereto is liable to imprisonment for up to three years or a fine.

(2) If the offender acts on a commercial scale, the penalty is imprisonment for up to five years or a fine.

(3) An attempt is punishable.

(4) In the cases referred to in subsection (1), the offence is 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 (*Strafgesetzbuch*) applies. Where the claims referred to in section 43 are upheld in proceedings pursuant to the provisions of the Code of Criminal Procedure (*Strafprozeßordnung*) governing compensation for the aggrieved person (sections 403 to 406c), the provisions on confiscation (sections 74 to 74f of the Criminal Code) do not apply.

(6) Where a penalty is imposed, an order is to 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 is to be laid down in the judgment.

Division 9

Proceedings in design litigation cases

Section 52

Design litigation cases

(1) The regional courts 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* governments are 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 on the design courts of one *Land* to the competent design court of another *Land*, in full or in part.

(4) In respect of the costs arising from the participation of a patent attorney in a design litigation case, fees as set out in section 13 of the Lawyers' Remuneration Act and the patent attorney's necessary expenses are to 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. Sentence 1 does not apply to the assertion of invalidity of a registered design in injunction proceedings under sections 935 to 945 of the Code of Civil Procedure.

Section 52b

Counterclaim for determination or declaration of invalidity

- (1) The design courts have jurisdiction for counterclaims for the determination or declaration of invalidity of a registered design insofar as these are filed in connection with actions in respect of infringement of the same registered design. Section 34 applies accordingly.
- (2) The counterclaim is inadmissible 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 to be determined by the court. If the application is not made within the time limit, the proceedings continue; the counterclaim is deemed withdrawn. The court may issue injunctions for the duration of the suspension of the proceedings and may take protective measures.
- (4) The court informs the German Patent and Trade Mark Office of the date on which the counterclaim was filed. The German Patent and Trade Mark Office records the date of filing in the Register. The court transmits a copy of the final judgment to the German Patent and Trade Mark Office. The German Patent and Trade Mark Office records the outcome of the proceedings, including the date on which the decision was taken, 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 (*Gesetz gegen den unlauteren Wettbewerb*) may, in derogation from section 14 of the Act Against Unfair Competition, be asserted before the court having jurisdiction for the design litigation case.

Section 54

Reduction of value in dispute

- (1) If, 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 their economic situation, the court may, upon motion by that party, order that such party's obligation to pay court costs is proportionate to a part of the value in dispute as adjusted to their economic situation.
- (2) The order referred to in subsection (1) has the effect that the beneficiary also has to pay the fees of his or her lawyer only in relation to this part of the value in dispute. Insofar as costs of the proceedings are imposed on such party or the latter assumes these costs, that party is required to reimburse the court fees paid by the opposing party and their lawyer's fees only in relation to the part of the value in dispute. If the extra-judicial costs are imposed on the opposing party or assumed by that party, the beneficiary's lawyer may recover his or her fees from the opposing party in relation to such value in dispute as applies to the latter.
- (3) The motion referred to in subsection (1) may be declared before and recorded with the court registry. It is to be made before the hearing on the merits. Thereafter it is admissible only where the court subsequently increases the presumed or assessed value in dispute. The opposing party is to be heard before the decision is taken on the motion.

Division 10
Provisions regarding measures taken by customs authority

Section 55
Seizure on import or export

(1) Where an infringement as per section 38 (1) sentence 1 has obviously been committed, the relevant product is subject, upon request and security being given by the right holder, to seizure by the customs authority, on import or export, insofar as there is no requirement to apply Regulation (EU) No 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights and repealing Council Regulation (EC) No 1383/2003 (OJ L 181, 29.6.2013, p. 15), as amended. This applies 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) If the customs authority orders seizure, it without delay notifies the person entitled to exercise control as well as the right holder. The right holder is to 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) is thus restricted. The right holder is to be given the opportunity to inspect the products, provided this does not interfere with business or trade secrets.

Section 56
Confiscation, objection

(1) If no objection is lodged in respect of the seizure before the expiry of a period of two weeks following service of the communication referred to in section 55 (2) sentence 1, at the latest, then the customs authority orders confiscation of the seized products.

(2) If the person entitled to exercise control objects to the seizure, the customs authority notifies the right holder thereof without delay. The right holder is required to declare to the customs authority without delay whether he or she upholds a request made in accordance with section 55 (1) in respect of the seized products.

(3) If the right holder withdraws the request, the customs authority revokes the seizure without delay. If the right holder upholds the request and submits an enforceable court decision ordering the impounding of the seized products or imposing a restriction on the control, the customs authority takes the necessary measures.

(4) If the cases referred to in subsection (3) do not apply, the customs authority revokes the seizure after the expiry of a period of two weeks following service of the communication to the right holder as referred to in subsection (2) sentence 1. If the right holder proves that he or she has requested, but not yet received, a court decision in accordance with subsection (3) sentence 2, the seizure remains in force for a maximum of two more weeks.

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

Section 57
Jurisdictions, appellate remedies

(1) A request as referred to in section 55 (1) is to be made to the Central Customs Authority and remains in force for one year insofar as no request is made for a shorter duration; the request may be repeated. The right holder is charged with the costs of official acts connected with the request subject to section 178 of the Fiscal Code (*Abgabenordnung*).

(2) Seizure and confiscation may be contested using the appellate remedies admissible in respect of seizure and confiscation in regulatory fining proceedings under the Act on Regulatory Offences. The right holder is to be heard in the appeal proceedings. An immediate appeal may be filed from a local court decision; the higher regional court decides on it.

Section 57a

Procedure under Regulation (EU) No 608/2013

Section 56 (5) and section 57 (1) apply accordingly to the procedure under Regulation (EU) No 608/2013, unless that Regulation contains provisions which preclude this.

Division 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 they have appointed a lawyer (*Rechtsanwalt*) or patent attorney (*Patentanwalt*) as their representative who is entitled and authorised to represent them 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) The place where a representative appointed in accordance with subsection (1) has his or her commercial premises is 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 is decisive or, if there is no such place, the place where the German Patent and Trade Mark Office has its seat.

(3) The legal termination of the appointment of a representative as referred to in subsection (1) does not become effective until the German Patent and Trade Mark Office or the Federal Patent Court has been informed both of the termination of this appointment and of the appointment of another representative.

Section 59

Arrogation of registered design

Any person who uses a designation which is likely to create the impression that a product is protected by a registered design is 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 Extension Act

(1) The provisions of this Act apply to all registered designs extended in accordance with the Extension Act (*Erstreckungsgesetz*) of 23 April 1992 (Federal Law Gazette I, p. 938), as last amended by Article 2 (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 ends 25 years after the end of that month in which the date of filing falls. Renewal of protection is effected by means of payment of a renewal fee for the 16th to 20th year and for the 21st to 25th year, calculated from the date of filing.

(3) If 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 still has to 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 (*Verordnung über industrielle Muster*) 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 is 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) Insofar as registered designs extended under the Extension Act to the territory designated in Article 3 of the Unification Treaty (*Einigungsvertrag*) 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 who have been authorised to use the subject matter of the title or of the 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, does 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 is authorised to use the registered design in the whole of the federal territory for the needs of their own business in their own plant or workshops or the plant or workshops of others with the limitations resulting from applying section 12 of the Patent Act accordingly, on condition that the use does not cause particular prejudice to the holder of the title or the persons who have been authorised to use the subject matter of the 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 only has a right to continued use under sentence 1 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.

Section 61

Typographic typefaces

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

(2) The provisions on the conditions of protectability continue to apply to 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 under the provisions applicable on that date.

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

(5) In derogation from section 28 (1) sentence 1, renewal fees are payable only from the 11th year of the term of protection to maintain the term of protection for the typefaces referred to in subsection (1).

Division 12 Community designs

Section 62 Forwarding of 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 makes a note on the application of the date of receipt and forwards the application, without examination and without delay, to the Office for Harmonisation in the Internal Market (Trade Marks and Designs).

Section 62a Application of provisions of this Act to Community designs

Insofar as German law is applicable, the following provisions of this Act apply accordingly 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) sentence 1), 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 seizure on import or export (sections 55 to 57).

Section 63 Community design litigation

- (1) The regional courts 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 are 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 on the Community design courts of one *Land* to the competent Community design court of another *Land*, in full or in part.
- (4) Section 52 (4) and sections 53 and 54 apply accordingly to proceedings before the Community design courts.

Section 63a Communication to European Commission

The Federal Ministry of Justice and Consumer Protection communicates 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 any change in the number, name or territorial jurisdiction of these courts.

Section 63b

Territorial jurisdiction of 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 apply accordingly 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. If jurisdiction is not established on this basis, then the court with which the claimant has general venue has territorial jurisdiction.

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 requests the Office for Harmonisation in the Internal Market (Trade Marks and Designs), by direct communication, to record in the Register of Community designs or, if it is an application, in the application files the following particulars:

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 takes the place of the insolvency administrator.

Section 64

Order for enforcement

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

Section 65

Punishable infringement of 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 consented thereto is liable to imprisonment for up to three years or a fine.

(2) Section 51 (2) to (6) applies accordingly.

Division 13

Protection of registered designs under Hague Agreement

Section 66

Application of this Act

This Act applies accordingly to registrations of designs under the Hague Agreement of 6 November 1925 Concerning the International Deposit of 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 and 2016 II, p. 59) (international registrations) whose protection covers the

territory of the Federal Republic of Germany, unless otherwise provided under this Part, the Hague Agreement or its amended versions.

Section 67

Filing of international application

At the option of the applicant, the international application for 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 international application

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

Section 69

Examination of grounds for non-registrability

(1) International registrations are examined in respect of grounds for refusal set out in section 18 in the same manner as designs which have been filed for registration in the Register kept by the German Patent and Trade Mark Office. The refusal of the effects takes 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 as defined in section 18, it communicates to the International Bureau a notification of refusal of effects within six months from the date of publication of the international registration. The notification states 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 is required to 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 decides 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 has the same legal remedies against the decision as apply to the refusal of an application for registration of a 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 withdraws 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 takes 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 takes the place of an action for consent to cancellation in accordance with section 9 (1). The court transmits to the German Patent and Trade Mark Office a copy of the final judgment. Section 35 applies accordingly.

(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 informs the International Bureau thereof without delay.

Section 71

Effect of international registration

(1) An international registration whose protection refers to the territory of the Federal Republic of Germany has 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) is 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) sentence 1) or protection has been withdrawn in accordance with section 9 (1) or section 34 sentence 1 (section 70 (1) sentence 2).

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

Division 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 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 continue to apply. Rights conferred by such 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, apply to the protective effects up until registration.

(4) Article 229 section 6 of the Introductory Act to the Civil Code (*Einführungsgesetz zum Bürgerlichen Gesetzbuche*) applies accordingly, 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, is equal to the provisions of the 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 40a does not apply to existing rights conferred by a registered design for which an application was filed before 2 December 2020.

(3) Section 31 (5) applies 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.

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

(5) 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, apply. Section 28 (2) applies to the renewal of variations of a basic design, with the proviso that the basic designs are considered first.

Section 74

Transitional provisions relating to the Act to Modernise the Design Act (*Geschmacksmustergesetz*) and to Amend the Regulations on Notifications of Exhibition Protection (*Gesetz zur Modernisierung des Geschmacksmustergesetz sowie zur Änderung der Regelungen über die Bekanntmachungen zum Ausstellungsschutz*)

(1) Designs which had been applied for or registered up until the entry into force of the Act of 10 October 2013 (Federal Law Gazette I, p. 3799) on 1 January 2014 are designated 'registered designs' as of that date.

(2) As from the entry into force of the Act of 10 October 2013 (Federal Law Gazette I, p. 3799) on 1 January 2014, the provisions on invalidity proceedings before the German Patent and Trade Mark Office in Division 6 apply accordingly to registered designs within the meaning of section 72 (3). Section 72 (3) continues to apply to the assessment of the protectability of these designs.

(3) Section 52a applies only to design litigation proceedings which became pending after 31 December 2013.