



## Amendments to the German Trademark Act by the Trademark Law Modernization Act

### I. Overview

The Trademark Law Modernization Act serves to approximate the respective trademark laws of the EU Member States and contains significant amendments to German trademark law. The majority of the new provisions already entered into force on 14 January 2019, the rest will probably follow on 1 May 2020.

### II. The Most Important Amendments

#### 1) Determinability as New Requirement for Protection of a Trademark

The former requirement of the graphic representability of a sign for the registration as a trademark is replaced by a registration in suitable electronic formats that allow the competent authorities and the public to determine the precise subject matter of the protection of a sign. Thus more possibilities of representation, particularly for unconventional types of trademarks like position, multimedia or motion marks are offered.

#### 2) Introduction of the National Certification Mark

Furthermore, the national certification mark, that certifies product characteristics and focusses on the guarantee function, is introduced as a new category in the German Trademark Act. For reasons of neutrality, the proprietor of the certification mark may not be a manufacturer/producers/supplier of the claimed goods/services. Further, the application of a certification mark must include regulations governing the use of the certification mark, which provide inter alia information regarding the certified product characteristics, the conditions of use, as well as the testing and supervision measures.

#### 3) New Absolute Grounds for Refusal

The amendment introduces new absolute grounds for refusal including protected designations of origin, protected geographical indications, traditional specialties guaranteed, traditional wine terms and protected plant variety denominations protected under national or European legislation or convention, that are to be taken into account in the application proceedings and/or the invalidity proceedings.

#### 4) New Official Proceedings for the Cancellation of Registered Trademarks

The previous "cancellation proceedings" will in future be referred to as "revocation or invalidity proceedings". From probably 1 May 2020, in addition to the present possibilities, relative grounds for refusal and also non-use of a German trademark can be asserted also in official proceedings and not exclusively by means of a legal action before the ordinary courts.

### **5) Registrability of licences/register entry about willingness to license or sell/transfer**

On request, licenses, information regarding licensees, the type of license and any restrictions can be entered in the register. There is also the option to have a non-binding willingness to license or sell a trademark entered in the register. Further, the proprietor of an exclusive license is permitted without joint representation with the proprietor to file a legal action before the ordinary courts regarding an infringement of a trademark if the proprietor of the trademark, after formal notice, does not himself bring a legal action within an appropriate period.

### **6) Changes to the Duration of Protection and Renewals**

There are also changes to the calculation of the ten-year duration of protection for all new trademarks registered after 14 January 2019. In contrast to previously, the duration of protection now ends precisely ten years from the date of filing of the application. For trademarks expiring by 31 January 2020, the “old” rules for paying the renewal fees apply. For trademarks expiring as of 1 February 2020 new rules for paying the renewal fees apply. Currently, the GPTO has however not yet issued reliable guidelines regarding the payment of the renewal fees under the new rules. We will therefore update this section upon receipt of reliable information from the GPTO.

### **7) Changes to Opposition Proceedings**

Protected geographic indications and designations of origin will constitute additional grounds for opposition. Oppositions on the basis of these “new” grounds are possible against trademarks filed as of 14 January 2019. Parties to opposition proceedings may also jointly request a cooling-off period of at least two months, which can also be extended, in order to reach an amicable settlement.

Further, proprietors of several earlier rights are now allowed to assert their rights in one single opposition. A decision regarding these several oppositions will then be reached in joint proceedings. The opposition fee will cost in future EUR 250.00 and will include - as before - a sign cited in opposition. A further EUR 50.00 shall be due for each additional sign.

In future, the objection of non-use with the so-called “wandering” period of use shall no longer apply, which affects all oppositions filed as of 14 January 2019. In addition proof of use - instead of the previously required prima facie evidence - will also have to be provided, but affidavits are still permitted. Furthermore, the calculation of the grace period of non-use will begin on the day upon which no further opposition can any longer be filed against the registration or on which the judgment concluding the opposition proceedings has acquired the authority of a final decision, or with the withdrawal of the last opposition. The grace period of non-use will be shown in the register.

### **8) New Proceedings regarding Cancellation of Trademarks before the GPTO**

Lastly, a new assumption of urgency for trademark law is introduced. The assumption of urgency has applied since 14 January 2019. However, as a result, only the substantiation and presumptive proof for the ground for an injunction can be dispensed with. The time limits of urgency which vary among judicial districts shall continue to apply without change.



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