

Law Concerning Copyright in Industrial Designs

(Designs Law)

(of January 11, 1876, as last amended by the Law on the Reform of the Professional Statute of Attorneys and Patent Attorneys of September 2, 1994, and the Trade Mark Reform Law of October 25, 1994)*

Sec. 1.–

(1) The right to imitate an industrial design, in whole or in part, shall belong exclusively to the author thereof.

(2) Only new and original products shall be regarded as industrial designs within the meaning of this Law.

Sec. 2.–

Where industrial designs have been produced by draftsmen, painters, sculptors, and the like, employed in a domestic industrial establishment, on commission or for the account of the owner of the industrial establishment, the latter shall be deemed the author of the industrial design, where not otherwise provided by contract.

Sec. 3.–

The author's rights shall pass to his heirs. Such rights may be assigned to other persons, with or without restriction, by way of contract or of testamentary disposition.

Sec. 4.–

The free use of individual elements of a design to produce a new design shall not be deemed a copy.

Sec. 5.–

Any copy of an industrial design made without the consent of the entitled person (Sections 1 to 3) with the intention of distributing such design as also the distribution of such copy shall be prohibited. The following shall also be considered prohibited copies:

1. where such copy is produced by means of a process differing from that used for the original work or where the copy is intended for a different branch of industry than the original;
2. where the copy is produced in spatial dimensions or in colors differing from the original or where it differs from the original solely in such modifications as can be perceived only by paying special attention;
3. where the copy is not made directly from the original work but indirectly from an imitation thereof.

Sec. 6.–

The following shall not be deemed prohibited copies:

1. an individual copy of a design where it has been produced in the private sphere without any intention of distribution and exploitation by way of trade;
2. the inclusion of copies of individual designs in a work of writing.

* *Official title:* Gesetz betreffend das Urheberrecht an Mustern und Modellen (Geschmacksmustergesetz).

Entry into force (of the latest amendment): January 1, 1995, except Section 15(3) [see footnote 2, below].

Note: Translation by the International Bureau of WIPO.

Source: Communication from the German authorities.

Sec. 7.—

(1) The author of a design or his successor in title may obtain protection against copying only if he files his design with the Patent Office for registration in the Designs Register.

(2) Protection against copying may not be obtained through an application if publication of the design or distribution of a copy would be contrary to public policy or morality; such act shall not be deemed to be so contrary merely because the distribution of a copy of a design is prohibited by law or regulation.

(3) Applications shall contain:

1. a written request for registration;
2. a photographic or other graphic representation of the design which clearly and fully discloses those features for which protection under this Law is sought.

(4) Where protection under this Law is sought solely for the surface design of a product, the design may be represented by a two-dimensional sample of the product itself or of a part thereof in place of a photographic or other graphic representation.

(5) Where protection under this Law is sought for both the three-dimensional design and the surface design of a product, the application may contain a representation that complies with the requirements of subsection (3), item 2, in respect of the three-dimensional design and the requirements of subsection (4) in respect of the surface design.

(6) Where the applicant demonstrates, by submitting a photographic or other graphic representation of a design together with an embodiment of the design, that a photographic or other graphic representation of the design is not capable of disclosing clearly and fully those features for which protection under this Law is sought, the Patent Office may accept the embodiment of the design as the representation in accordance with subsection (3), item 2, in place of the photographic or other graphic representation. In such case, an additional fee shall be paid according to the schedule of fees.

(7) A representation may be accompanied by an explanatory description.

(8) The application may be accompanied by a list setting out the classes of goods in which the design shown in the representation is to be classified. Where the applicant intends to embody the design in products belonging to other classes of goods, such classes shall also be stated.

(9) A number of designs may be grouped together in a multiple application. A multiple application may not contain more than 50 designs. They must all belong to the same class of goods.

(10) The applicant may divide a multiple application. Each divisional application shall continue to enjoy the date of the original application and any priority claimed therefor. A complementary fee shall be paid in addition to the application fees already paid, corresponding to the difference between those fees and the sum of minimum fees to be paid for each divisional application in accordance with the schedule of fees.

Sec. 7a.—

Where the applicant or his predecessor in title has made a product available to the public within six months preceding the day which determines the priority of the application, that fact shall not be taken into consideration when assessing novelty and originality (Section 1(2)) if the applicant files the same product without modification as a design.

Sec. 7b.—

(1) An applicant who claims, under an international treaty, the priority of an earlier foreign application for the same design shall be required to state the date and country of the earlier application within two months of the date of application. Once the applicant has stated the date and country of the earlier application, the Patent Office shall invite him to state, within two months of service of the request, the file number of the earlier application and to file a copy of the earlier application, where not already done. The particulars may be amended within the time limits.

(2) If the earlier foreign application has been filed in a State with which no treaty on the recognition of priority exists, the applicant may claim a priority right corresponding to the priority right under the Paris Convention subject to the Federal Ministry of Justice having notified in the Federal Law Gazette that such other State affords a priority right on the basis of an initial application with the Patent Office whose

conditions and content are comparable with the priority right under the Paris Convention; subsection (1) shall be of application.

(3) Where the statements under subsection (1) are not made in good time or the copy is not filed in good time, the declaration concerning the claim to priority shall be deemed not to have been made. The Patent Office shall establish this fact and shall refuse entry of the priority in the Designs Register.

Sec. 8.—

(1) The Designs Register shall be kept by the Patent Office.

(2) The Patent Office shall make known the registration of an application in the Designs Register, together with a reproduction of the representation, and any extension of the term of validity, by publishing them once only in the Designs Gazette [*Geschmacksmusterblatt*]. In the cases referred to in Section 7(4) to (6), the reproduction of the representation or of the product itself required for publication shall be arranged for by the Patent Office. Publication shall not imply a guarantee as to the completeness of the reproduction or the recognizability of the features protected under this Law. The costs of publication shall be charged as expenses.

Sec. 8a.—

(1) Where the applicant has stated in the request for registration that a design designated by him within a multiple application is to be treated as a basic design and further designs as variations thereof, the Patent Office shall enter such statement in the Designs Register and shall publish only the reproduction of the basic design in the publication under Section 8(2), together with a reference to registration of the statement.

(2) An applicant who has filed a statement under subsection (1), or his successor in title, may not claim that a variation, by reason of its differing characteristics, is also new and original in relation to the basic design.

(3) The protection of variations shall end with the expiry of the basic design. Section 7(10) shall not apply to applications in respect of which a statement has been filed under subsection (1).

Sec. 8b.—

(1) A request may be made in the application that publication of a reproduction of the representation of the design be deferred by 18 months computed from the day following that on which the application was filed. Where such a request is made, publication shall be limited to entry of the application in the Designs Register. The term of protection shall end with the expiry of the period of deferment.

(2) Protection shall extend for the period laid down in Section 9(1) if the owner of the design pays the fee in accordance with the schedule of fees within 12 months following the application. Where the fee is not paid in due time, extension of protection shall apply when the fee is paid together with the additional fee according to the schedule. On expiry of the time limit, the Patent Office shall advise the registered owner of the design that the term of protection will lapse on expiry of the period of deferment unless the fee, together with the additional fee laid down in the schedule of fees, is paid within the period of deferment.

(3) Where protection is extended to the end of the term of protection under Section 9(1), deferred publication of a reproduction of the representation shall be effected together with a reference to publication under the second sentence of subsection (1). The third and fourth sentences of Section 8(2) shall apply *mutatis mutandis*.

Sec. 8c.—

(1) An application fee in accordance with the schedule of fees shall be paid together with the application. Where deferred publication of a reproduction is requested, the fee for such request in accordance with the schedule of fees shall be paid together with the application fee.

(2) Where the applicant omits to pay the application fee or the fee for the request for deferment of publication of a reproduction, the Patent Office shall notify him that the application will be deemed not to have been filed unless the fee is paid within one month of service of the notification.

Sec. 9.—

(1) Protection shall be for five years beginning with the day following that on which the application was filed.

(2) The term of protection may be extended by periods of five years or a multiple thereof up to a maximum of 20 years. Extension of the term of protection shall be entered in the Designs Register.

(3) Extension shall be obtained by paying the fee in accordance with the schedule of fees prior to expiry of the term of protection. Where the fee is not paid in good time, the additional fee in accordance with the schedule of fees shall be payable. Two months after expiry of the term of protection at the earliest, the Patent Office shall notify the registered owner that the entry of the design in the Designs Register will be cancelled due to expiry of the term of protection unless the fee, together with the additional fee, is paid within four months of service of the notification.

(4) The Patent Office may postpone dispatch of the notification at the request of the registered owner if the latter proves that he cannot reasonably be expected to make payment in view of his present circumstances. The Patent Office may make postponement conditional on payment of installments within specified time limits. Where an installment is not paid in due time, the Patent Office shall notify the registered owner that the entry in the Designs Register will be cancelled due to expiry of the term of protection unless the balance outstanding is paid within one month of service of the notification.

(5) Where no request has been made to postpone dispatch of the notification, it shall still be possible to defer payment of the fee and additional fee by proving that payment may not be reasonably expected, even after service of the notification, where such request is made within 14 days of service and the previous omission is satisfactorily explained. Deferment may also be authorized subject to the payment of installments. If a deferred sum is not paid in due time, the Patent Office shall repeat the notification, whereby the whole of the balance outstanding shall be demanded. After service of the second notification, no further deferment shall be possible.

(6) A notification that has been postponed on request (subsection (4)) or that must be repeated following deferment (subsection (5)) shall be dispatched not later than two years after the due date of the fee. Any installments already paid shall not be refunded if the entry in the Designs Register is cancelled due to failure to pay the balance outstanding.

Sec. 10.—

(1) Decisions of the Patent Office in proceedings under this Law shall be taken by a legal member within the meaning of the second sentence of Section 26(1) of the Patent Law.¹ For the exclusion and challenge of that member of the Patent Office, Sections 41 to 44, 45(2), second sentence, and 47 to 49 of the Code of Civil Procedure relating to exclusion and challenge of members of a court shall apply *mutatis mutandis*. The decision on a challenge plea, where a decision is necessary, shall be taken by a different legal member of the Patent Office who has been generally designated for decisions of such kind by the President of the Patent Office.

(2) The Patent Office shall determine those classes of goods that are to be entered and published. It shall further enter in the Designs Register those particulars of the applicant that are required to be registered without examining whether the applicant is entitled to file an application or whether the facts stated in the application are correct. In those cases covered by Section 7(2), the Patent Office shall establish the fact that protection has not been obtained for the design contained in the application and shall refuse registration.

(3) Where the requirements stipulated by this Law or by a statutory order under Section 12(1) as regards a correct application have not been met, the Patent Office shall advise the applicant of the defects and invite him to remedy them within a period of two months after service of the notification. Where the defect is remedied within the time limit, the date of receipt of the document at the Patent Office shall be deemed the date of the application for the design. The Patent Office shall establish that date and advise the applicant thereof.

¹ See Industrial Property Laws and Treaties, GERMANY – Text 2-001 (Editor's note).

(4) Where the defects referred to in subsection (3) are not remedied within the time limits or where the application fee is not paid within the time limit under Section 8c(2), the application shall be deemed not to have been filed; the Patent Office shall establish this fact and refuse registration.

(5) Sections 123(1) to (5), 124 and 126 to 128 of the Patent Law shall apply *mutatis mutandis*.

Sec. 10a.—

(1) Appeals from decisions of the Patent Office in proceedings under this Law shall lie to the Federal Patent Court. Appeals shall be heard by a Chamber of Appeal of the Patent Court composed of three legal members. A fee in accordance with the schedule of fees shall be paid for appeals; if the fee is not paid within the period allowed for lodging appeals, the appeal shall be deemed not to have been lodged. Sections 69, 73(2), (4) and (5), 74(1), 75(1), 76 to 80 and 86 to 99, 123(1) to (5), 124 and 126 to 128 of the Patent Law shall apply *mutatis mutandis*.

(2) An appeal on a point of law from a decision of the Chamber of Appeal in respect of an appeal under subsection (1) shall lie to the Federal Court of Justice if the Chamber of Appeal has given leave to appeal on that point of law. Sections 100(2) and (3), 101 to 109, 123(1) to (5) and 124 of the Patent Law shall apply *mutatis mutandis*.

Sec. 10b.—

In proceedings under Sections 10 and 10a, an applicant shall, on request, subject *mutatis mutandis* to Sections 114 to 116 of the Code of Civil Procedure, be granted legal aid if there are adequate prospects of registration in the Designs Register. Payments shall be made to the Federal Treasury. Sections 129, second sentence, 130(2), (3) and (6), 133 and 134, 135(1), first sentence, subsection (2), first sentence, (3) and 136 to 138 of the Patent Law shall apply *mutatis mutandis*.

Sec. 10c.—

(1) The registration of a design shall be cancelled

1. on expiry of the term of protection,
2. at the request of the registered owner, or
3. at the request of another person who produces together with the request an official or officially certified document in which the registered owner renounces the design or gives his consent to cancellation of the entry of the design in the Designs Register.

(2) Consent to cancellation can be demanded from the registered owner in legal proceedings where

1. the registered design was not entitled to protection on the day of the application,
2. the applicant was not entitled to file an application.

(3) In the cases covered by subsection (2), item 2, the Court may, on request, grant to the plaintiff, where he is entitled to file an application in respect of the design, the authorization in the event of a renewed application for the same design to claim the priority of the application filed by the person not entitled.

Sec. 11.—

Anyone may inspect the Designs Register. This shall also apply to the representation of a design or to the files held by the Patent Office in respect of a design for which an application has been filed,

1. where the reproduction of the representation has been published,
2. where and to the extent that the registered owner has declared to the Patent Office his consent to inspection, or
3. where and to the extent that a legitimate interest has been satisfactorily proved.

Sec. 12.—

(1) The Federal Minister for Justice shall regulate the establishment and the business procedure of the Patent Office as the designs registration authority and shall determine by statutory order, insofar as provision therefor has not been made by law, the requirements for applications for designs, the form and other requirements for the representation of the design, the admissible dimensions of the product used to represent the surface design or the product itself, the content and scope of any description accompanying the representation, the classification of goods, the keeping and form of the Designs Register, the particulars to be

entered in the Designs Register and the details of publication, including production by the Patent Office of the representation of the design in the cases covered by Section 7(4) to (6), the expenses to be charged to cover the cost of publication and the treatment of products accompanying an application for its representation following cancellation of the entry in the Designs Register (Section 10c). He may delegate these powers to the President of the Patent Office by statutory order.

(2) The Federal Minister for Justice shall have power to prescribe by statutory order, to the extent that provision therefor has not been made by law, the collection of administrative fees to cover the costs incurred by use of the services of the Patent Office and may, in particular

1. order that fees be charged for certificates, authentication's, inspection of files and information as well as for expenses incurred,
2. issue provisions on the person liable for costs, due date of costs, requirements on advance on costs, exemption from costs, statutory limitation and the procedure for determining costs.

Sec. 12a.—

(1) The Federal Minister for Justice shall have the power to entrust, by statutory order, officials of the higher intermediate and lower intermediate grades with the handling of certain matters in proceedings concerning the Designs Register where these matters involve no legal difficulties. However, this shall not apply to:

1. the establishment of facts and refusals under the second sentence of Sections 7b(3), second sentence, and 10(4) for reasons that have been contested by the applicant;
2. the establishment of facts and refusal of entry under the third sentence of Section 10(2);
3. cancellation under Section 10c(1), No. 3;
4. the decision on the classes of goods to be entered in the Register and to be published where they differ from those claimed by the applicant (Section 7(8));
5. the remedy or submission of an appeal (fourth sentence of Section 10a(1)) from a decision taken in the proceedings under this Law.

(2) The Federal Minister for Justice may delegate the powers under subsection (1) to the President of the Patent Office by statutory order.

(3) The second and third sentences of Section 10(1) shall apply *mutatis mutandis* to the exclusion and challenge of an official of the higher intermediate or lower intermediate grades.

Sec. 13.—

The person who has filed the design for registration in the Designs Register in accordance with Section 7 shall be deemed to be its author unless proved otherwise.

Sec. 14.—

(1) Any person who, contrary to Section 5, produces a copy of a design without the consent of the entitled person with the intention of distributing such copy or any person who distributes such copy shall be liable to imprisonment of up to three years or to a fine.

(2) Where the offender acts by way of trade, he shall be liable to imprisonment of up to five years or to a fine.

(3) The attempt to commit such an offense shall be punishable.

(4) Offenses under subsection (1) shall only be prosecuted on complaint unless the prosecuting authorities deem that *ex officio* prosecution is justified in view of the particular public interest.

(5) The provision of the Copyright Law on confiscation (Section 110) shall apply *mutatis mutandis*.

(6) In the event of conviction, the sentence shall be published if the injured party so requests and can show a legitimate interest in so doing. The nature of the publication shall be set out in the judgment.

Sec. 14a.—

(1) Any person who infringes the author's rights in a design by unlawfully producing a copy or distributing such copy may be sued by the injured party for removal of the prejudice, for injunction to desist where there is a risk of repetition and for damages where the infringer has acted intentionally or negligently. In

lieu of damages, the injured party may require surrender of the profit obtained by the infringer through the copy or its distribution and rendering of accounts in respect of such profit. Where the infringer is guilty of slight negligence only, the court may award compensation, in lieu of damages, within the limits of the prejudice suffered by the injured party and the advantage that has accrued to the infringer.

(2) Claims deriving from other statutory provisions shall remain unaffected.

(3) The provisions of the Copyright Law on claim to destruction and similar measures (Sections 98 to 101), claim to information in respect of third parties (Section 101a), prescription (Section 102), publication of judgment (Section 103) and measures by the customs authorities (Section 111a) shall apply *mutatis mutandis*.

Sec. 15.—

(1) For all actions whereby a claim arising out of one of the legal relationships regulated in this Law is asserted (industrial designs litigation), the first instance courts [*Landgerichte*] shall have exclusive jurisdiction without regard to the value in dispute.

(2) The provincial governments [*Landesregierungen*] shall have the power to allot by statutory order industrial designs litigation for the areas of several first instance courts to one such court insofar as this is procedurally expedient. The provincial governments may delegate these powers to the provincial justice administrations.

(3) Where an appeal is lodged against a decision of the court in industrial designs litigation, the parties may also be represented before the Court of Appeal by attorneys-at-law admitted to practice before the Provincial High Court that would have heard the appeal in the absence of a ruling under subsection (2).²

(4) Any additional costs incurred by a party due to representation under subsection (3) by an attorney-at-law not admitted to practice in the court hearing the case shall not be refunded.

(5) Of the costs arising from the participation of a patent attorney in industrial designs litigation, fees up to the amount of a full fee according to Section 11 of the Federal Ordinance on the Fees of Attorneys-at-Law, as well as the necessary expenses of the patent attorney, shall be refunded.

Sec. 16.—

A person who has neither a domicile nor an establishment in the Federal Republic of Germany may take part in proceedings under this Law before the Patent Office or the Patent Court and assert rights deriving from a design protected according to the provisions of this Law only if he has appointed a patent attorney or an attorney-at-law in the Federal Republic of Germany as his representative. The latter shall be authorized to represent him in proceedings before the Patent Office and the Patent Court and in civil litigation in respect of the design; he may also file requests for the institution of criminal proceedings. The place where the representative has his business premises shall be deemed, within the meaning of Section 23 of the Code of Civil Procedure, to be the place where the assets are located; if there are no business premises, the place where the representative has his domicile shall be relevant or, in the absence thereof, the place where the Patent Office has its seat.

Sec. 17.—

(1) This Law shall enter into force on April 1, 1876. It shall apply to all industrial designs created after its entry into force.

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² Subsection (3) will enter into force on January 1, 2000, for the following *Länder* of Germany: Baden-Württemberg, Bavaria, Berlin, Bremen, Hamburg, Hessen, Lower Saxony, North-Rhine Westphalia, Rhineland Palatinate, Saarland and Schleswig-Holstein; it will enter into force on January 1, 2005, for the other *Länder* (*Editor's note*).

³ Obsolete provisions.