

DESIGNS

Germany



Designs

Quick reference guide enabling side-by-side comparison of local insights, including into the legal framework; registered and unregistered designs; registration and opposition procedures; enforcement; assignment and licensing; and recent trends.

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Germany



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LEGAL FRAMEWORK

Relevant legislation

What is the relevant legislation?

Designs in Germany are protected by the Act on the Legal Protection of Designs (within the German Design Act).

The German Design Act is nearly fully harmonised with Council Regulation (EC) No. 6/2002 (EU Community Design Regulation), which is an alternative way of obtaining design protection for the territory of Germany and the other EU member states.

At the international level, design protection is also available in Germany through the international registration of designs pursuant to the Hague Agreement on the International Registration. The Hague Agreement is administered by the International Bureau of the World Intellectual Property Organization.

Nature of system

Are design rights considered to be distinct or treated as patent rights?

Design rights in Germany are considered to be distinct and they are not treated as patent rights. A design right is a fully independent intellectual property (IP) right with independent legislations and its own scope of protection, which only partially overlaps with patents or other IP rights, or both.

Agency

Which agency is responsible for registration and grant of design rights?

National German designs have to be filed with the German Patent and Trademark Office (GPTO). The GPTO is responsible for the registration and grant of national design rights.

Overlap with other rights

Is there any overlap between design rights and other rights?

In most cases, a design right protects the appearance of a product and or its shape. Such shape or a part of it may, at the same time, qualify for protection under other IP rights, particularly under:

- unfair competition;
- trademark; or
- copyright law (most likely).

Although not technically deriving from IP rights, claims for unfair one-to-one copying of product designs are regularly affirmed by German courts, even if the subject matter of the litigation is not protected by a separate design right.

Device marks may also be registered as a design, and the three-dimensional appearance of a product, which can be protected as a design, may – under special circumstances – also be registered as a trademark. Logos, in principle, can be protected as designs and trademarks.

German copyright law grants the author or creator exclusive rights to exploit his or her work. Such 'work' may also be a

special product design and or a logo. There is no register for copyrights in Germany, but they come into existence at the moment of creation and are enforceable by the responsible civil courts.

UNREGISTERED DESIGNS

Protection

What protection and rights are there for unregistered designs?

The German Design Act does not grant protection for unregistered designs on a national level.

However, unregistered design rights may arise on the basis of Council Regulation (EC) No. 6/2002 (EU Community Design Regulation), which is directly applicable in Germany. Protection through use is acquired through the first publication or other use within the European Union of a design fulfilling the conditions of protection. It is important to note that first disclosure or use outside of the European Union does not create any (unregistered) design rights in Europe.

The unregistered design provides only limited protection. The designer only has the right to prohibit others from copying its design provided that the infringer had knowledge of the prior design. Independent parallel creations cannot be challenged. Further, the duration of protection is limited to three years. It is essential to document the disclosure of the design.

Use requirements

How much use is generally required to establish unregistered design rights?

Protection is automatically conferred by way of disclosure and not by a certain amount of use. Disclosure means when the design is first made available to the public within the European Union. A design is disclosed to the public by exhibiting it, offering it or otherwise publishing it. A single act of disclosure may be sufficient.

Exclusions

What exclusions apply to unregistered design rights?

Protection is limited to three years. Also, protection is limited as the enforcement of unregistered designs requires that the challenged product is the result of copying the original, which involves establishing subjective elements such as knowledge of the original.

REGISTERED DESIGNS

Ownership

Who can apply for and own a design?

Ownership of a design is not limited to the creator or designer, or both. Any natural person, as well as legal entities or partnerships having legal capacity, may own a design in Germany.

Scope

What may and may not be protected?

There are unlimited and uncountable possibilities of what may be protected as a design. The German Design Act provides that the two- or three-dimensional appearance of a product (or parts of it), resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product itself or its ornamentation can be registered as a design. This includes classical product design, graphical user interfaces as well as logos.

However, there are certain limits to the protection of designs. The following are excluded from registered design protection, pursuant to article 3 of the German Design Act:

- design features that arise exclusively from their technical function;
- design features that must be copied in an exact form and measurements to connect the product on which the design is used or into which it is incorporated to another product;
- designs that violate the rules of public order or principles of morality; and
- designs that abusively use badges, signs or emblems of public interest.

Section 4 of the Design Act includes another significant exclusion from design protection. A design that is used on or incorporated into a product that is an element of a complex product can only be enforced if the element remains visible during its originally intended use.

With respect to 'spare parts', it means that they are generally registrable, but might not be fully enforceable if they fall under one of the above categories. In Germany, all visible components of a car have so far been protected from being copied if covered by a registered design. This aspect is particularly important for consumers when it comes to shape-related, 'must-match', parts of complex products. These are parts that are fitted into a complex product (eg, doors or mudguards on a car). 'Must-match' means that the spare part must have the same shape as the original part. This is particularly the case for doors or mudguards because a significant number of consumers would not accept a spare part that differs from the original part. If there is no exception from design protection for such spare parts, consumers would have to rely on the original manufacturer in the case of damage, since they could only buy a matching spare part from the manufacturer. But it is different, for example, when it comes to wheel rims, which are generally not considered as 'must-match' because consumers accept numerous shapes that are offered on the market. Such kind of products are referred to as 'must-fit' products, as they must fit to the complex product, but can have a different look.

On 10 September 2020, the Act on the Promotion of Fair Competition was adopted in Germany, which liberalises competition on the spare parts market, particularly in the field of the automotive industry. In future, protection can still be claimed for individual components according to German and EU design laws, if – when used as intended – they remain visible in complex products, and the visible characteristics meet the requirements as to novelty and individual character. The repair clauses will only become relevant when it comes to the enforcement of design rights. The repair clause introduced in section 40a, paragraph 1, sentence 1 of the German Act on the Legal Protection of Designs provides that there shall be:

In this context, there is an exception to the exception, namely section 40a, paragraph 1, sentence 2 of the German Act on the Legal Protection of Designs, according to which, the exception shall not be valid:

According to the grounds of the law, this wording is to clarify that the exception in paragraph 1, sentence 1 can only be applied to 'must-match' spare parts, ie, to such spare parts whose individual character is pre-defined by the shape of the original. Also, there is another limitation of the repair clause: according to section 40a, paragraph 2 of the German Act on the Legal Protection of Designs, the exception according to section 1 will only be applied:

On the one hand, paragraph 2 is to protect consumers from deception and misleading offers, and on the other hand, it enables design owners to take action against third parties who sell products that are not only intended for repair purposes. Moreover, paragraph 2 might also be due to a decision of the Court of Justice of the European Union, according to which – within the framework of the repair clause – a manufacturer may only produce and sell a component if it is indeed used for repair purposes, and the component must include clear and visible information that it has not been produced by the original manufacturer (*Acacia v Audi and Porsche* (Case C-397/16)). This information must be attached in a clear any visible manner, either to the component itself or its packaging, or must be apparent from catalogues or sales documents. Shortly after this EU decision, Germany's Federal Supreme Court also had to deal with labelling requirements of spare-part manufacturers (I ZR 226/14, 26 July 2018). In this case, the spare-part manufacturer had only indicated its own company name and the English-language note 'Not OEM'. However, according to the German Federal Supreme Court, this information was not regarded as sufficient. Instead, the information regarding the spare parts must be given in those languages that are generally spoken by consumers in the countries where the parts are offered. In Germany, it is not sufficient to indicate in English on the German-language website that the products are non-original or similar products. In any case, the manufacturer of the spare parts would have had to indicate this information in German.

Costs

What are the costs involved in registration?

Registration fees are not high in Germany. The German Patent and Trademark Office (GPTO) charges €60 for applications filed electronically and €70 for applications filed on paper. If an application covers several designs (multiple design application), each additional design costs €6 if filed electronically and €7 if filed on paper. The latest fees are available on the GPTO website .

Grace period

Is there a grace period for filings?

The German Design Act also provides a grace period of 12 months for own prior use and publication before the filing date or priority date. The novelty grace period is a privilege granted to the designer of a design to enable them to predict market success.

Further, the German Design Act provides an exhibition priority for presentation on an exhibition admitted by the German Ministry of Justice in the Federal Law Gazette for providing protection at exhibitions and an exhibition priority.

PROCEDURES

Application

What is the application process?

To register a German design, an application form must be filed with the German Patent and Trademark Office (GPTO), which has to contain the name and address of the applicant, a representation of the design that is suited for publication and an indication of the product for which the design is intended to be applied. The goods are classified in accordance with an international classification system established by the Locarno Agreement.

The representation of the design consists of up to 10 photographic or other graphic illustrations (reproductions) of the design. Each illustration must not show more than one view of the design. For example, for this purpose, the design can be photographed from different angles. All features for which protection is sought must be clearly visible. Drawings or computer graphics are also possible. It is important to note that it is also possible to file just one singly illustration (eg, front view only). By doing this, a rather narrow scope of protection is claimed and it is possible to enforce the design against products, which look similar or even identical from this view, but might have a different appearance from the rear side.

Examination and appeals

How are the examination and appeals procedures conducted?

The GPTO examines whether or not the application contains formal defects, whether or not the design applied for is eligible for design protection at all and whether the design complies with public policy and accepted principles of morality. It is very important to note that the GPTO does not examine whether the design for which protection is sought actually fulfils the substantial requirements for protection, this being novelty and individual character.

The decisions of the GPTO can be appealed to the Federal Patent Court in accordance with article 23 of the German Design Act.

Opposition

What are the opposition rules?

There are no opposition proceedings in Germany. However, should it become apparent, after registration, that, for example, a design lacks novelty and or individual character, a third party can file an application for the determination of invalidity. If the registered design is invalid, it will be cancelled from the Design Register after the conclusion of invalidity proceedings. The registration will be deemed not to have had any protective effect from the outset.

The 'application for the determination of invalidity' relates to absolute grounds for invalidity (the appearance of the product does not constitute a design, lack of novelty or individual character, exclusion from design protection). Anybody may file this application.

The 'application for the declaration of invalidity' relates to relative grounds for invalidity (works protected by copyright, registered designs or distinctive signs with an earlier filing or priority date). The application can only be filed by the right holder concerned.

Registration time frame

What are the registration time frames?

If the application meets the legal requirements, the design is recorded in the register kept by the GPTO. The registration

is then published in the electronic register service and published in the Design Gazette. In straightforward cases, registration may take place within a few days.

Removal from register

In what instances does removal from the register occur?

Removal from the register occurs if a third party successfully filed an 'application for the determination of invalidity' or an 'application for the declaration of invalidity'. In most cases, this will happen if the registered design lacks novelty and or individual character. Novelty means that the design must be new at the date of filing the application. No design that is identical or differing only in immaterial details must have been published, exhibited or otherwise used in trade, before the date of filing or the priority date. Another requirement is that the design must have individual character. Its overall impression must differ from known designs. In this context, neither the view of a layman nor the opinion of a product designer is decisive. Rather it is the overall impression produced by the design on an 'informed user' that is relevant.

ENFORCEMENT

Grounds for a claim

What are the key causes of action?

The key causes of action are alleged infringements like one-to-one copies of the registered design.

Procedures

What enforcement procedures are available?

Infringement of German registered designs can be challenged by filing a normal action with a court that is competent to hear design cases. Most German states have concentrated the jurisdiction for design matters on only one court in each state. Claimants tend to go to the courts that are known for handling a large number of design cases, such as the District Courts of Dusseldorf, Cologne, Frankfurt, Hamburg, Mannheim and Munich.

In addition to this, designs are frequently enforced not only by way of normal actions, but also through preliminary injunction proceedings in urgent cases. This procedure is only available for a limited period of time (usually one month) from the date of knowledge, whereby the exact period of time is assessed differently from court to court.

A normal writ of complaint (as well as requests for a preliminary injunction) must provide the court with all facts necessary to determine the question of infringement. Plaintiffs must provide the court with a detailed description of both the allegedly infringed design and the allegedly infringing product. It is recommended that the plaintiff provides the court with copies of the protected design and a sample of the allegedly infringing products, so that the required comparisons can be made.

Remedies

What remedies are available?

Remedies in cases of design infringement are in practice primarily civil remedies (cease and desist, providing information and account, damages, removal of the impairment, destruction and cost compensation), although penal remedies exist as well, as do administrative remedies such as border seizure. As regards damages, the claimant may

choose between three alternatives for calculating damages:

- lost profits;
- infringer's profits; or
- reasonable royalty.

Enforcement time frame

What are the time frames for the resolution of enforcement actions for registered and unregistered rights?

This depends from case to case, as each case is different. Also, some courts are quicker than others. However, as a general rule, it can be said that in most cases a decision in first instance is rendered after six to nine months. Depending on the practice of the court, there may be one or two hearings in a typical case. If the court orders the taking of evidence, there may be one further session of the court for hearing witnesses or experts, and in that case, the proceedings will typically take another three months. In more complex or complicated cases, it can also be more than a year.

Recent cases

What key cases from the past 18 months should rights holders be aware of?

The KaiKai Company Jaeger Wichmann v EUIPO (T-579/19)

In this decision, the General Court of the European Union confirmed that priority in a design application may also be claimed from a Patent Cooperation Treaty patent application. More importantly, the General Court also ruled that the deadline to claim priority in such cases is 12 months and not six months (like in cases where priority is claimed from a prior design filing).

The Higher Regional Court of Frankfurt decision on compensation costs (6 W 15/20)

In this decision, the Court decided that the losing party does not only have to compensate the costs of the attorney of law of the winning party, but also the costs of the patent attorney. According to the Court, the winning party can request compensation, if the assistance of the patent attorney has been 'necessary to achieve the purpose of the lawsuit' and if the patent attorney conducted typical tasks of a patent attorney (like searching the register).

Porsche v EUIPO – Autec (T-209/18)

In this case, a cancellation action was filed with the European Union Intellectual Property Office by the Nuremberg model construction company Autec against two designs of the 911 model series by the car manufacturer Porsche. Autec essentially argued that the contested designs lacked both novelty and individual character, which would eventually prevent them from being capable of protection. Autec claimed that the design and layout of the newer model would not visibly differ from the Porsche 911 models that have been on the market since the original version of the 911 model from 1963.

The Court confirmed the Board of Appeal's decision in almost all regards and, in particular, denied the necessary individual character of the later 911 model. Finally, the General Court concluded that the designs to be compared were so similar that the renewed elements were not sufficient to cause a different overall impression in the perception of the

informed user.

OWNERSHIP CHANGES AND RIGHTS TRANSFERS

Assignment and licensing

What are the rules surrounding assignment and licensing of design rights?

The right in a registered design can be assigned to other persons in accordance with article 29 of the German Design Act. The transfer of the right shall be recorded in the register if evidence is provided to the German Patent and Trademark Office.

With respect to licensing, the rights holder may grant licences for the design (article 31 of the German Design Act), but there is no possibility to register the licensing in the register.

Licences of right

Are licences of right available?

Yes, they are available. The German Design Act differentiates between exclusive and non-exclusive licences. A non-exclusive licence may also be constructed in the way that the design owner agrees to license to anyone who requests. However, in most cases, the design owner will ask for some requirements to be met to grant the licence.

UPDATE AND TRENDS

Key developments and future prospects

What were the key judicial, legislative, regulatory and policy developments of the past year in relation to the protection and enforcement of designs? What are the prospects for future developments?

On 10 September 2020, the Act on the Promotion of Fair Competition was adopted in Germany, which is to liberalise competition on the spare parts market, in particular, in the field of the automotive industry. Thus, the Act includes the introduction of a repair clause in section 40a of the German Act on the Legal Protection of Designs. This repair clause is to limit the design protection for visible spare parts, especially outer parts of automobile bodies, which are used for repair purposes. In particular, the repair clause is to open up the market for visible automobile spare parts for repair purposes.

According to the grounds of the law, the introduction of the repair clause within the German Act on the Legal Protection of Designs and the resulting 'opening of the market are expected to probably result in a slight reduction in consumer prices for visible automobile spare parts'.

This has been a key development during the past year and will likely influence the future development of design case law in Germany.

Jurisdictions

	Australia	Cooper IP
	Brazil	Kasznar Leonardos
	European Union	Berggren Oy
	Germany	KUHNEN & WACKER Intellectual Property Law Firm
	Greece	Dr Helen G Papaconstantinou and Partners Law Firm
	India	LexOrbis
	Israel	Naschitz Brandes Amir
	Italy	GLP Intellectual Property Office