

Draft of a new Trademark Act (Markenrechtsmodernisierungsgesetz)

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On 3. February 2017 the German Federal Ministry of Justice and Consumer Protection presented a draft of an act to implement Directive (EU) 2015/2436 of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (Gesetz zur Umsetzung der Richtlinie (EU) 2015/2436 des Europäischen Parlaments und des Rates vom 16. Dezember 2015 zur Angleichung der Rechtsvorschriften der Mitgliedstaaten über die Marken – Markenrechtsmodernisierungsgesetz – MaMoG). The draft closely follows the provisions of the Directive and merely fulfills its aims. The only change that is not mandatory due to the Directive is a proposal for a new fee structure similar to that of the EUIPO. The Ministry hopes to adopt this law before the next German Bundestag is elected in autumn 2017. In detail:

- Extension of the possibilities of representation of a sign in an electronic register

The reformed German trademark law foregoes the requirement of graphical representation (so far in § 8 (1) MarkenG). This requirement will be replaced by flexible criteria that offers possibilities of representation for unconventional trademark forms. Thereby the trademark register is adapted to the needs of our modern technological world.

- Provision of a national guarantee mark

In the course of implementation of the Directive the guarantee mark is for the first time provided in the German trademark act. This new trademark form takes account of the importance of quality labels for the market players. Guarantee marks are characterized by the fact that, compared with individual trademarks, they not so much protect the function of origin as the guarantee function. Guarantee marks are governed by the principles of neutrality and transparency as well as by duties of examination and monitoring.

- Implementation of an administrative procedure for revocation or declaration of invalidity of the German patent and trademark office (DPMA)

Additionally to the existing procedures for revocation due to absolute grounds, in the future it will be possible to pursue relative grounds for invalidity (older rights) and revocation in an administrative procedure at the German patent and trademark office (DPMA). This new provision serves the purpose to pool the competences of the DPMA. The German courts will only decide about revocation or declaration of invalidity in the course of a counterclaim by a party in an infringement proceeding.

I personally hope this provision will be partially cancelled during the legislation process. It would be better to let the plaintiff choose between an administrative procedure and a court procedure while attacking newer rights; otherwise the plaintiff might have to start two proceedings.

- Implementation of provisions for goods under customs control

The case law of the CJEU and the Bundesgerichtshof assumes that only the import or export of goods that are labelled with a trademark being protected in Germany are liable to infringe the specific subject-matter of the trade mark and may therefore be forbidden by the trademark owner. All other custom related situations are not subject to legal prohibition. For example, in the case of transit this means

that pirated goods may only be stopped that are or at least should be subject of a commercial action addressing the public in Germany. In consequence, the trademark owner bears the full burden of proof that the goods will likely been put on the German market. This requirement sometimes is an obstacle to effectively fighting piracy and counterfeiting. In order to ease this fight the draft provides a two-step procedure to stop goods under customs control (new § 14a MarkenG draft). The new provision attempts to achieve a mutual balance of the interests of the customs administration, of the persons responsible for the transit of goods and of the right holders.

- Implementation of a new fee structure

The new fee structure enables the application of a budget-friendly “newbie trademark” with only one class for an official fee of 250,- EUR. As a result, small and medium-sized firms will benefit.