

International Comparative Legal Guides



Practical cross-border insights into designs law

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1 Relevant Authorities and Legislation

1.1 What is the relevant Design authority in your jurisdiction?

The German Patent and Trademark Office (“GPTO”) is the relevant design authority.

1.2 What is the relevant Design legislation in your jurisdiction?

The German Act on Legal Protection of Designs (“Design Act”) is the relevant design legislation.

2 Application for a Design

2.1 What can be registered as a Design?

According to Sec. 1 No. 1 Design Act, the subject matter of protection of a registered design is “a design”, which is defined as any two- or three-dimensional appearance of the whole or part of a product resulting from features such as, in particular, the lines, contours, colours, shape, texture or materials of the product itself or its ornamentation. A “product” can be any industrial or hand-
craft item, including packaging, graphic symbols, typographic typefaces, but excluding computer programs.

The two basic substantive requirements for protection of a registered design are novelty and individual character. By contrast, as mentioned above, designs no longer need to have an aesthetic quality in order to be protectable by a registered design.

A design is considered new if no identical design (only differing in immaterial details) has been made available to the public before the filing date of the design application (or the priority date, if applicable).

A design is considered to have individual character if its overall impression differs from the overall impression of any prior design that has been made available to the public before the filing date or priority date.

2.2 What cannot be registered as a Design?

The following cannot be registered as a design:

- (1) Features of products that are strictly dictated by their technical function.
- (2) Features of products that must necessarily be reproduced in their exact form and dimensions in order that the product in which the design is incorporated or to which it is applied

may be mechanically assembled with or connected to or placed in, on or around another product so that both products perform their function.

- (3) Designs that are contrary to public order or morality.
- (4) Designs that constitute improper use of any of the signs listed in Art. 6ter of the Paris Convention for the Protection of Industrial Property or of other insignia, emblems and coats of arms of public interest.

2.3 What information is needed to register a Design?

An application for a registered design must contain (1) a request for registration, (2) information identifying the applicant, (3) at least one representation of the design that is suitable for publication, and (4) an indication of the products in which the design is incorporated. Further, applicants who have neither a domicile nor a registered office or subsidiary in Germany need to indicate a patent attorney or attorney-at-law who is licensed in Germany as their representative. Lastly, application fees must be paid within three months from the filing date.

2.4 What is the general procedure for Design registration?

Applications for registered designs may either be filed directly with the GPTO or through the International Bureau of the World Intellectual Property Organization (“WIPO”) and designating Germany. Before the GPTO, the application can either be filed on conventional paper forms or electronically via the GPTO website. Upon receipt of an application, the GPTO checks whether the application meets all formal requirements. Furthermore, it is examined whether: (1) the subject matter of the application actually constitutes a design according to the Design Act; (2) the design is contrary to public policy or the accepted principles of morality; and (3) the design constitutes improper use of any state emblems or other signs of public interest. By contrast, the GPTO does not examine any further substantive requirements, e.g., novelty and/or individual character of the design. If the application fulfils the aforementioned requirements, the design is recorded in the design register, usually within two to four weeks after receipt of the application fee. In general, on the next day, the registration is published in the electronic register and a month later in the Design Gazette (“*Designblatt*”).

2.5 How is a Design adequately represented?

When applying for a registered design, at least one representation of the design must (and up to 10 representations of the design

may) be submitted. Photographs, drawings or other graphical representations are accepted. The representations should only show one embodiment of a product (not several embodiments) without any further objects, and in front of a neutral background. In the event that only part of a product shall be protected by the registered design, the unclaimed parts must be clearly marked by way of a graphical disclaimer. The GPTO explicitly recommends the use of broken lines but also accepts colour shading, blurring and outlining as graphical disclaimers.

2.6 Are Designs registered for specific goods or products?

No; however, an indication of the product must be given at the time of filing.

2.7 Is there a "grace period" in your jurisdiction, and if so, how long is it?

The Design Act provides a 12-month grace period of novelty.

2.8 What territories (including dependents, colonies, etc.) are or can be covered by a Design in your jurisdiction?

A German design covers Germany only.

2.9 Who can own a Design in your jurisdiction?

As a rule, the right to a registered design vests in the designer (or his successor in title) or, if two or more persons have jointly developed the design, in those designers jointly. If the design was developed by an employee in the execution of his duties or following the instructions given by his employer, the employer is entitled to the registered design, unless contractually agreed otherwise. However, regardless of the substantive ownership of a design, the applicant or the registered owner of the design, respectively, shall be deemed entitled and obliged in proceedings concerning a registered design.

2.10 How long on average does registration take?

Most applications are processed within a few weeks.

2.11 What is the average cost of obtaining a Design in your jurisdiction?

The GPTO's application fee for an electronically filed individual application is EUR 60. For an electronically filed multiple application, the fee is EUR 6 per design (with a minimum fee of EUR 60).

2.12 Is there more than one route to obtaining a registration in your jurisdiction?

It is possible to obtain registration by filing:

- an application via the GPTO for a German registered design;
- an international application via WIPO, designating Germany;
- an international application via WIPO, designating the EU; and

- an application via the European Union Intellectual Property Office ("EUIPO") for a registered community design.

2.13 Is a Power of Attorney needed?

A written Power of Attorney must only be submitted if the representative is not a lawyer or patent attorney.

2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No, a Power of Attorney does not require notarisation or legalisation.

2.15 How is priority claimed?

Priority can be claimed as follows:

- (1) Foreign priority: applicants must file an application with the GPTO within six months, claiming the seniority of the previous application. Claiming internal priority (a prior application in Germany) is not provided for design applications.
- (2) Exhibition priority: if the design was exhibited at a domestic or foreign exhibition, applicants may claim a priority right from the date of first exhibition (within a period of six months).

2.16 Can you defer publication of Design applications in your jurisdiction? If so, for how long?

It is admissible to request publication in the design application. When applying for a registered design, the applicant may request the deferment of publication for up to 30 months, whereby it is admissible to request publication at any time before expiration of that term.

3 Grounds for Refusal

3.1 What are the grounds for refusal of registration?

Grounds for refusal include:

- (1) Missing basic requirements when filing the application for registration.
 - (2) Inconsistent or inadequate representations.
- In addition, the application must comply with further requirements that result in detail from design laws and regulations.

3.2 What are the ways to overcome a grounds objection?

The applicant will receive a notice of objection and can respond thereto in writing to overcome a grounds objection raised by the Examiner. If the applicant does not remedy the existing deficiencies in due time, the GPTO will reject the application.

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

An appeal against the refusal of the application by the GPTO is admissible under Sec. 23 (4) Design Act.

3.4 What is the route of appeal?

An appeal against a decision of the GPTO is to be filed with the German Federal Patent Court (“*Bundespatentgericht*”).

A further appeal can be filed with the Federal Court of Justice (“FCJ”), if the GPTO has explicitly allowed the appeal or in case the FCJ accepts the appeal.

4 Opposition

4.1 Can a Design application be opposed, and if so, on what grounds?

No; opposition proceedings against a design application are not possible, but cancellation proceedings after registration are available.

4.2 Who can oppose the registration of a Design in your jurisdiction?

This is not applicable.

4.3 What is the procedure for opposition?

This is not applicable.

5 Registration

5.1 What happens when a Design is granted registration?

Registration with the GPTO grants the exclusive right to use the design and prohibits third parties from using it without the applicant’s consent.

Only the applicant has the authority to “put the design on the market”, grant licences and transfer the right. Third parties are prohibited from using the registered design without the consent of the owner, in particular from manufacturing, offering, putting on the market, importing, exporting, using or possessing it for any of these purposes, unless there are restrictions on protection (Sec. 40 *et seqq.* Design Act).

5.2 From which date following application do an applicant’s Design rights commence?

Design rights commence from the registration date.

5.3 What is the term of a registered Design right?

The maximum term of protection for registered designs is 25 years from the filing date. Protection is initially granted for five years and can be extended four times for additional five-year periods.

5.4 How is a Design renewed?

The maintenance of protection must be effected by the timely payment of the respective renewal fees.

6 Registrable Transactions

6.1 Can an individual register the assignment of a Design?

Yes, an individual is entitled to register the assignment of a design (Sec. 29 Design Act).

6.2 Are there different types of assignment?

Yes. It is admissible to acquire by conclusion of a legal contract (Sec. 398 German Civil Code) or legal succession (Sec. 1922 German Civil Code), or by court order.

6.3 Can an individual register the licensing of a Design?

No, they cannot.

6.4 Are there different types of licence?

A distinction must be made between an exclusive licence and a simple licence. While, in the case of an exclusive licence, the licensee alone may use the design and the granting of further licences by the design owner is excluded, the licensee’s right of use in the case of a simple licence is not exclusive. Rather, the owner may grant further licences to third parties and may also continue to use the design himself.

In contrast, a sole licence (“*Alleinlizenz*”) is when the owner of the design may not grant any further licence in addition to a granted licence, but he remains entitled to use the design *vis-à-vis* the (sole) licensee.

6.5 Are there any laws that limit the terms upon which parties may agree a licence?

Specific laws within the Design Act that limit the terms upon which parties may agree a licence do not exist. However, the general principles of civil law that apply to contracts in general do apply.

6.6 Can Designs be the subject of a compulsory licence (or licences of right), and if so, in what circumstances does this arise and how are the terms settled?

No, they cannot.

6.7 Can a Design licensee sue for infringement?

Only the exclusive licensee may sue for infringement in his own right. The simple licensee requires the consent of the design owner.

6.8 Are quality control clauses necessary in a licence?

No, quality control clauses are not necessary.

6.9 Can an individual register a security interest under a Design?

In principle, security interests can exist in a design, but these are form-free, so no registration is possible.

6.10 Are there different types of security interest?

Yes, lien and usufruct are possible (Sec. 30 Design Act).

7 Invalidity

7.1 What are the grounds for invalidity of a Design?

The grounds for invalidity of a registered design can be divided into two categories: absolute grounds for invalidity; and relative grounds for invalidity.

Absolute grounds for invalidity are the following: (1) the appearance of the product is not a “design” in accordance with the Design Act; (2) the design lacks novelty or individual character; or (3) the design is excluded from design protection because, for example, every essential feature of the design is solely dictated by the technical function of the product, or the design is contrary to public policy or the accepted principles of morality.

As relative grounds for invalidity, the owner of the respective earlier right may invoke that: (1) the design constitutes unauthorised use of a work protected by copyright law; (2) the design is in conflict with a prior registered design or a prior registered community design; or (3) an earlier distinctive sign is used in the design, and the owner of the sign has the right to prohibit such use.

7.2 What is the procedure for invalidation of a Design?

An application for the declaration of invalidity must be filed in written form with the GPTO. Upon filing, the prescribed official fee must be paid. The application must specify the grounds for invalidity and comprise all necessary facts and supporting evidence. Furthermore, the conflicting earlier designs or other rights must be indicated precisely.

This is of particular importance since the GPTO is bound to the asserted grounds for invalidity stated in the application. The Design Unit of the GPTO serves the invalidity application on the owner of the challenged design, who may contest the application within one month. If the owner does not contest, the Design Unit declares the registered design to be invalid. If the owner does contest, the Design Unit continues the proceedings and decides on the basis of the facts and evidence submitted by the parties. In the event that the registered design is found to be invalid, it will be cancelled from the register and will be deemed void from the beginning.

7.3 Who can commence invalidation proceedings?

Absolute grounds for invalidity can be invoked by any natural or legal person, and relative grounds for invalidity can only be invoked by the owner of the respective earlier right.

7.4 What grounds of defence can be raised to an invalidation action?

The Design Unit serves the invalidity application on the owner of the challenged design, who may contest the application within

one month. If the owner does not contest, the Design Unit declares the registered design to be invalid. If the owner does contest, the Design Unit continues the proceedings and decides on the basis of the facts and evidence submitted by the parties.

7.5 What is the route of appeal from a decision of invalidity?

The decision of the Design Unit can be appealed to the Federal Patent Court. Under specific circumstances, a further appeal to the Federal Supreme Court is also available.

8 Design Enforcement

8.1 How and before what tribunals can a Design be enforced against an infringer?

Registered designs can be enforced within an infringement proceeding before the competent civil courts.

8.2 Are the issues of validity and infringement heard in the same proceedings or are they bifurcated?

The invalidity of a registered design can either be claimed within invalidity proceedings before the GPTO or by way of a counterclaim within infringement proceedings before the competent civil courts. The possible grounds for invalidity are the same, whether the registered design is challenged before the GPTO or before the civil courts.

Within main proceedings, the defendant can defend themselves by attacking the validity of the asserted design. There are two options for this counterattack: in the course of an invalidity counterclaim within the same infringement proceedings before the same court; or by way of separate invalidity proceedings before the GPTO. In the first case (invalidity counterclaim), the court uniformly decides on the validity of the asserted design as well as its infringement. If found invalid by an unappealable court decision, the registered design will be deleted from the design register (the infringement claim, as the logical consequence, being rejected). In the second case (separate invalidity proceedings before the GPTO), the court may suspend infringement proceedings at its discretion (and must suspend proceedings, if the court itself considers the design to be invalid).

Within main proceedings, the respondent is limited to these two optional counterattacks regarding the validity of the asserted design. If he neither files an invalidity counterclaim nor initiates separate invalidity proceedings, the court must regard the asserted design as being valid.

Within preliminary injunction proceedings, nullity counterclaims or suspensions of preliminary injunction proceedings due to separate invalidity proceedings are not available to the defendant. However, it is nevertheless admissible to argue nullity of the registered design and thus, it is advisable to present relevant prior art in order to object to the assumed validity or at least weaken the scope of protection of the registered design.

8.3 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

There are no mandatory pre-trial measures to be taken. Nevertheless, it is generally advisable to send a warning letter to the potential infringer before initiating court proceedings. The

reason for this is that there is otherwise a potential risk of immediate acknowledgment by the potential infringer, which leads to the plaintiff's obligation to bear the costs.

However, in case it is unclear whether the potential infringer has substantial defensive arguments, it is advisable to send a "soft" letter, asking why the other side believes themselves to be authorised to use the respective design ("authorisation request"), instead of a warning letter. Such letter does not bear the risk of counterattack for having sent an unlawful warning letter.

As regards the timeline, such prior correspondence does not significantly delay the start of court proceedings. In general, court proceedings can be initiated within a few weeks after becoming aware of the potentially infringing acts.

The duration of main, first instance proceedings varies from court to court, but it usually takes around nine to 12 months before a decision is issued by the Regional Court in the first instance. Appeal proceedings usually take slightly longer, i.e., around one-and-a-half years, before a decision is issued by the Higher Regional Court. A further appeal to the FCJ is only available in cases of particular interest.

Preliminary injunction proceedings are significantly less time-consuming. In case of *ex parte* injunctions (i.e., without an oral hearing and without involvement of the defendant), a preliminarily enforceable first instance decision is issued within a few days, sometimes hours, or within few weeks in case of *inter partes* injunctions. Appeal proceedings take approximately three months.

8.4 Are (i) preliminary, and (ii) final injunctions available, and if so, on what basis in each case?

In urgent cases, German procedural law offers the rights holder the opportunity to assert certain claims by way of expedited proceedings, i.e., preliminary injunction proceedings. The advantage of preliminary injunction proceedings lies within the possibility to obtain a (preliminarily enforceable) restraining order against the infringer within a significantly shorter amount of time compared to main proceedings – i.e., generally within a few days in case of *ex parte* injunctions (without prior oral hearing of the defendant) and within a few weeks in case of *inter partes* injunctions (including exchange of further briefs and/or an oral hearing before issuing a decision). However, considering the recent decisions of the German Federal Constitutional Court, such *ex parte* injunctions without a prior warning letter and/or involvement of the defendant are expected to become rarer.

At the same time, preliminary injunction proceedings must be initiated within a certain deadline starting from first awareness of the infringing acts concerned. The exact deadlines have been established by settled German case law and vary between the different court districts. While the Higher Regional Court of Munich, for example, grants a deadline of one month as of first knowledge, other Higher Regional Courts, such as Berlin and Düsseldorf, accept broader deadlines of up to two months. If the rights holders miss this urgency deadline, the court may reject a request for a preliminary injunction, but main proceedings will still be available. Thus, the different urgency deadlines can sometimes affect the choice of court.

Preliminary injunction proceedings primarily serve to enforce injunction claims, but may, under certain circumstances, also be available for the assertion of information claims (about the origin of the infringing goods and/or commercial customers) and custody claims (in order to preliminarily secure destruction claims). Rights holders must substantiate their claims with facts and thus demonstrate why the alleged infringing design constitutes an infringement of their design. These facts must be

substantiated through *prima facie* evidence (instead of full proof as required in main proceedings).

With regard to the validity of the asserted design, German design law grants a presumption rule to the benefit of the rights holder, according to which courts must consider a registered design – despite being an unexamined registered intellectual property right – to fulfil any validity requirements. Nevertheless, many courts ask for the presentation of at least the most relevant prior art known to the rights holder before issuing a preliminary injunction (*ex parte*). In many cases, the defendant presents such prior art in their pre-procedural reply to a warning letter (such responses must be presented to the court as well). If not, it is advisable to present a range of the most relevant prior art together with the request for a preliminary injunction right away. This should also include designs of the rights holders themselves.

As a served preliminary injunction is preliminarily enforceable, it is generally advisable to comply with the injunction (unless the defendant does not want to risk enforcement measures such as penalty payments). At the same time, the defendant has the following options to react to a preliminary injunction issued against them:

- (1) Oppose the decision ("*Widerspruch*", in case of an *ex parte* preliminary injunction), which would then be reviewed by the court including an oral hearing (the preliminary injunction, however, remains in force and is preliminarily enforceable during opposition proceedings). Generally, there is no deadline for such objection.
- (2) Appeal against the decision ("*Berufung*", in case of an *inter partes* preliminary injunction), which would then be reviewed by the next judicial instance.
- (3) Force the applicant to initiate main proceedings (the preliminary injunction, however, remains in force until the determination of main proceedings).
- (4) Request to annul the decision due to changed circumstances.
- (5) Accept the decision as final and binding between the parties by way of a so-called "final declaration" (this final declaration includes a waiver of the judicial remedies, thus terminating the proceedings between the parties).

Main proceedings are an alternative to preliminary injunction proceedings (but may run simultaneously). Within main proceedings, rights holders are able to enforce any of their claims, including further information claims about turnover, damage and cost reimbursement (not being enforceable within preliminary injunction proceedings).

8.5 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary, and if so, how?

Within German civil procedure, both parties must introduce the facts and offer evidence supporting their claims and arguments. There is no *ex officio* investigation by the court (in contrast to German criminal or administrative proceedings). Accordingly, the court examines only the evidence provided, if the corresponding facts are contested by the other party. If not, the court must treat these facts as true.

Within preliminary injunction proceedings, facts merely have to be substantiated through *prima facie* evidence (instead of full proof as required within main proceedings). Here, affidavits are admissible as evidence (instead of the hearing of witnesses).

8.6 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

According to German procedural law, the following five forms of evidence are admissible:

- (1) Hearing of a witness.
- (2) Hearing of the parties.
- (3) Expert opinions.
- (4) Visual inspection.
- (5) Documents/certificates.

8.7 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes, infringement proceedings can be stayed.

8.8 Is there any alternative shorter, flexible or streamlined procedure available? If so, what are the criteria for eligibility and what is the impact on procedure and overall timing to trial?

No, there is no alternative procedure available.

8.9 Who is permitted to represent parties to a Design dispute in court?

Attorneys at law are permitted to represent parties.

8.10 After what period is a claim for Design infringement time-barred?

The standard three-year time-barring period applies. This period begins at the end of the year in which the infringement occurred.

8.11 Are there criminal liabilities for Design infringement?

Criminal law regulations can be found in Sec. 51 Design Act.

8.12 If so, who can pursue a criminal prosecution?

The prosecution is initiated by the state prosecutor's office. The state prosecutor's office can either act on a criminal complaint or on its own initiative. If there is no commercial activity, however, either a criminal complaint is required or there must be a special public interest in criminal prosecution.

8.13 What, if any, are the provisions for unauthorised threats of Design infringement?

In the case of unauthorised threats of design infringement, a claim for injunctive relief pursuant to Sec. 42 (1) Design Act may be considered. This can also be considered if such an infringement is threatened for the first time. In contrast to a claim for damages, no fault is required for a claim for injunctive relief.

9 Defences to Infringement

9.1 What grounds of defence can be raised by way of non-infringement to a claim of Design infringement? For example, are there "must match" and/or "must fit" defences or equivalent available in the jurisdiction?

In order to establish non-infringement, it may be argued that the acts were carried out in the private sphere for non-commercial purposes (Sec. 40 No. 1 Design Act), or for experimental purposes (Sec. 40 No. 2 Design Act). Reproductions for the purpose of citation or teaching are also permissible under certain conditions (Sec. 40 No. 3 Design Act). In addition, design infringements cannot be asserted against equipment in ships and aircraft registered abroad and entering Germany only temporarily (Sec. 40 No. 4 Design Act). It is also permissible to carry out repairs on ships and aircraft as defined in No. 4 (Sec. 40 No. 5 Design Act).

Non-infringement may also be given on the basis of a right of prior use (Sec. 41 Design Act), or on the basis of a licence.

"Must match" parts, unlike "must fit" parts, are not exempt from design protection under German design law. In this respect, successful defence against an infringement allegation can only be considered if the products are "must fit" parts.

9.2 What grounds of defence can be raised in addition to non-infringement?

This depends on what type of procedure it is. For example, it can be argued in relation to requests for preliminary injunctions that the necessary urgency is lacking. In addition, admissibility of the action can be challenged in these proceedings, just as in regular main proceedings.

9.3 How does your jurisdiction deal with Design protection for spare parts?

Since December 2, 2020, Sec. 40a Design Act has been a legal regulation dealing with design protection for spare parts. According to this section, a design does not exist for a design incorporated in or applied to a product that 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 said component is put on the market is something other than the repair of the complex product. However, this rule applies only if consumers are properly informed of the origin of the product used for repair purposes through the use of labelling or other appropriate means, so that they can make an informed choice among competing products for repair purposes.

10 Relief

10.1 What remedies are available for Design infringement?

German design law offers the rights holder the following remedies against infringers:

- Cease-and-desist claim: the cease-and-desist claim includes the infringer's obligation to eliminate the current infringement as well as to refrain from using the design in the future.
- Damage claim: provided that the infringer acted either intentionally or negligently, the rights holder is entitled to

assert claims for damages. The rights holder can choose from three options for the calculation of damages: (1) surrender of the infringer's profit; (2) compensation of the rights holder's lost profit; and (3) appropriate remuneration according to the so-called "licence analogy". The latter does not necessarily require an established licence practice by the rights holder, but is rather based on a fictional calculation. The advantage of this fictional calculation (for both sides) can be the fact that internal figures do not need to be disclosed.

- Information claims: the rights holder can ask the infringer for extensive information about the origin and distribution channels of the infringing goods. This includes, *inter alia*, information about the manufacturers, suppliers and commercial buyers, as well as the number of goods ordered, received and distributed, including purchase prices and sales prices. In the case of obvious infringements, the rights holder is likewise entitled to assert these information claims against third parties, such as those in possession of infringing goods or service providers whose services have been used in the course of the infringing action. In order to be able to calculate damages, the rights holder may further ask for the rendering of accounts about realised turnovers and profits.
- Destruction claim: the infringer must destruct any infringing goods he owns or possesses. This also includes any objects that have been primarily used for manufacturing the infringing goods. As an alternative, the rights holder may ask the infringer to hand over the infringing goods in exchange for appropriate remuneration (limited to the construction costs).
- Right to recall: the rights holder is likewise entitled to ask the infringer to recall the infringing goods from their distribution channels. This does not include a recall from private consumers. According to recent case law of the German Federal Supreme Court, the lack of adequate recalling measures may even constitute a violation of cease-and-desist obligations.
- Cost compensation for attorneys' fees: if an attorney becomes active on the rights holder's side by way of a pre-procedural warning letter, the infringer is also obliged to compensate the rights holder for the attorneys' fees incurred. The amount of these fees is legally determined and ultimately depends on the so-called "value in litigation".

10.2 Are damages or an account of profits assessed with the issues of infringement/validity or separately?

First of all, nullity proceedings and infringement proceedings are separate in Germany. The GPTO is responsible for invalidity proceedings, while the regular courts are responsible for infringement proceedings.

The existence and amount of damages can be dealt with in infringement proceedings before the ordinary courts. However, the existence of an infringement can also initially be established alone, without a concrete claim for damages already being made.

10.3 On what basis are damages or an account of profits assessed?

The so-called "*Dreifache Schadensberechnung*" ("triple damage calculation") is used. The creditor can choose whether to calculate the damage in concrete figures, demand a fictitious licence fee, or skim off the profit accrued by the infringer.

10.4 Are punitive damages available?

No, punitive damages are not available.

10.5 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Only the costs of the party that wins the legal dispute are recoverable. The losing party must regularly bear both the costs of the legal dispute and the statutory costs of the opposing counsel plus his expenses.

11 Appeal

11.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

In Germany, appeals ("*Berufung*", cf. Sec. 511 *et seqq.* German Code of Civil Procedure) are not limited to points of law. The grounds for an appeal are either that the decision is based on a violation of law or on a wrongful assessment of the underlying facts (Sec. 513 German Code of Civil Procedure).

11.2 In what circumstances can new evidence be added at the appeal stage?

The possibility of adducing new evidence at the appeal stage is governed by the general procedural requirements. Accordingly, new evidence is to be admitted if it:

- relates to a point of view that was recognisably overlooked or considered irrelevant by the court of first instance (Sec. 531 (2) sentence 1 No. 2 German Code of Civil Procedure);
- was not raised at first instance as a result of a procedural defect (Sec. 531 (2) sentence 1 No. 3 German Code of Civil Procedure); or
- was not asserted at first instance without this being due to negligence on the part of the party (Sec. 531 (2) sentence 1 No. 3 German Code of Civil Procedure).

Whether new evidence is always admissible at the appeal stage in the area of preliminary injunction proceedings is controversial. However, unless general admissibility is assumed, only very low requirements for negligence are regularly set.

12 Border Control Measures

12.1 Is there a mechanism for seizing or preventing the importation of infringing articles and, if so, how quickly are such measures resolved?

Pursuant to Sec. 55 (1) Design Act, an infringing product is subject to seizure by the customs authorities upon request and against provision of security by the rights holder upon its importation or exportation. This does not apply if Regulation (EU) No. 608/2013 is applicable. In addition, for traffic with other EU Member States and contracting states to the Agreement on the European Economic Area, this only applies insofar as controls are carried out by the customs authorities.

13 Other Related Rights

13.1 To what extent are unregistered Design rights enforceable in your jurisdiction?

There is no unregistered national design. In contrast, the Community Design Regulation provides for an unregistered design that is also enforceable before German courts.

13.2 What is the term of unregistered Design rights enforceable in your jurisdiction?

The term of unregistered community design rights is three years from first publication in Europe.

13.3 What, if any, are the key differences between unregistered and registered Design rights in your jurisdiction?

A registered design obtains protection from the date of registration, while an unregistered design obtains protection from the date of publication in the EU. Furthermore, unregistered designs exist in Germany only according to the Community Design Regulation; national law is not applicable.

The term of protection of an unregistered design is three years and therefore much shorter.

13.4 If unregistered Design protection is available in your jurisdiction, is protection cumulative or mutually exclusive?

There is no unregistered national design under German law.

13.5 Is copyright available to protect industrial Designs?

Yes, copyright is available.

14 Current Developments

14.1 What have been the significant developments in relation to Designs in the last year?

There have been no significant developments in relation to designs in the last year.

14.2 Please list three important judgments in the Designs sphere that have been issued within the last 18 months.

Three important judgments issued within the last 18 months include:

- FCJ, Decision of March 24, 2022 – I ZR 16/21 – *Schneidebrett*.
- FCJ, Decision of October 7, 2020 – I ZR 137/19 – *Papierspender*.
- CJEU, Decision of October 28, 2021 – C-123/20 – *Ferrari SpA/Mansory Design Holding GmbH*.

14.3 Are there any significant developments expected in the next year?

In its order for reference dated July 1, 2021, the FCJ referred various questions to the CJEU for a preliminary ruling. The main question was whether a component is already visible within the meaning of Art. 3 III of Directive No. 98/71/EC if it is objectively possible to recognise the design when the component is installed, or whether it is the visibility under certain conditions of use or from a certain viewer perspective that is important. The CJEU's answer has implications for when a creation is denied design protection based on Sec. 4 Design Act.

The area of conflict between design and other intellectual property rights also continues to be the subject of case law.

14.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

No, there are none.



Philippe Kutschke's practice encompasses all litigious and non-litigious matters relating to trademark, design, copyright, and competition law, as well as the protection of business secrets.

In addition to offering strategic advice on the development and management of, and applications relating to, transnational IP portfolios, Dr. Kutschke's work also focuses on overall consulting and representation in both court proceedings and out-of-court proceedings relating to the enforcement of IP rights in both a national and international context, as well as (parallel) protest procedures and nullity and cancellation proceedings before the German Patent and Trademark Office and the EUIPO.

Dr. Kutschke advises and represents start-ups, medium-sized companies, and international corporations alike. With many years of cross-sector experience, he is able to efficiently offer a sensible economic solution to even the most complex international litigation. He frequently provides advice and support throughout the innovation process – from the initial concept through to market launch and subsequently thereto.

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BARDEHLE PAGENBERG is one of the leading IP law firms in Europe and has pooled the strengths and competences of patent attorneys and attorneys-at-law for more than 40 years, clearly setting itself apart from many other IP law firms.

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