

New Law on Design Patents in Germany

1. General information

The need to protect product designs is gaining ever increasing importance.

On 26.03.2003 the German Federal Cabinet therefore agreed on a bill to reform the law on design models. The new law will replace the 125 year old law on design models and will both provide greater protection of designs in Germany as well as strengthening the position of holders of protective rights. The bill converts into national law Directive 98/71/EG on the legal protection of designs and models, issued by the European Parliament and Council on 13th October 1998.

Design models protect external images such as for example the industrial design of coffee pots, fabrics, cars, computers or furniture. These external images must be new and possess special characteristics, i.e. a design must differ in its overall impression from known shapes.

Individual parts of a whole product, such as for example parts of a car body, can in future only be protected if they are visible when being used according to specification. This restriction results from harmonisation within the EU.

Protection of visible individual parts has so far not been harmonised within the EU. Until a uniform regulation has been agreed upon throughout Europe, the bill therefore retains the currently valid legal provisions. These are that visible replacement parts such as wings, car bonnets or bumpers may be protected as design models inasmuch as they fulfil the protective requirements as individual parts too.

In the past decades a free market for spare parts has set itself up beside that of the car manufacturers. The car manufacturers have explicitly agreed not to restrict the free market in the future by making inappropriate claims to protective rights. This agreement is the basis for retaining the current regulations and ensures that both sides are able to coexist satisfactorily. The person who benefits most from such price competition is the consumer.

The new law on the protection of designs is therefore not expected to have any effect on price levels, in particular on consumer price levels. Businesses will also not incur any additional costs. The fees and costs involved in registering and publishing a design are set down in the Law on Patent Office and Patent Court Fees as well as in the Regulation on Administrative Charges of the German Patent and Trademark Office. No increase in charges is planned.

It is not known exactly when the new law on design models will come into force, however it will probably be in the first half of 2004.

2. Definition of a design model

There is no legal definition of the term "design model" in the currently valid law on design models. Court practice has defined the design model as a design which is both appropriate to and aimed at the taste of the observer (Federal Supreme Court – BGH - Society for the Protection of Industrial Property and Copyright – GRUR - 1980, 235). This means in the long run that every manifestation of a product – particularly if based on shape and/or colour – may be considered to be a design model.

**PATENTANWÄLTE
REINHARD SKUHRA
WEISE & PARTNER**

Friedrichstrasse 31
D-80801 München
Tel: 0049/89/381610-0
Fax: 0049/89/3401479
<http://www.isarpatent.com>
RSW@isarpatent.com

Our Team

Electrical Engineering:

Udo Skuhra
Dr. Stephan Barth
Glyndwr Charles
Oliver Hassa
Frank Waitzhofer
Daniel Papst

Mechanics:

Reinhard Weise
Udo Skuhra
Jürgen Metzler

Biotechnology:

Dr. Werner Behnisch
Wolfgang Sandmann

Chemistry:

Dr. Werner Behnisch

Physics:

Dr. Stephan Barth
Ralf Peckmann
Dr. Tobias Kleimann

Trademarks:

Reinhard Weise
Udo Skuhra
Dr. Werner Behnisch
Wolfgang Sandmann
Christine Fluhme
Michaela Wöhrle



In § 1 No. 1 the bill adopts the definition of a "design" contained in clause 1a of the Directive as the image of a whole product or of a part of it, which arises in particular from characteristics such as contour, outline, colour, shape, surface structure or materials used in the product itself or in its decoration. The addition of "two-dimensional or three-dimensional" images in the bill makes it clear that flat designs and three-dimensional models remain protected.

The product itself is defined in § 1 No. 2 of the bill as each or every object made industrially or by a craftsman, including packaging, fittings, graphic symbols and typographic scripts as well as all individual parts intended to be assembled to form a complex product.

As far as the definition of a design model is concerned therefore, there are no essential differences between the currently valid and the new law on design models.

Registration
without prior
examination

3. The right to register without a prior substantive examination

The currently valid law on design models incorporates a so-called "right to register", whereby fulfilment of the material requirements for protection is not verified by the German Patent and Trademark Office during the registration procedure. In this respect the bill will introduce no change, inasmuch as the German Patent and Trademark Office will continue to desist from verifying the fulfilment of novelty and individuality - material prerequisites to protection - in a design for which protection has been applied, and will not check whether there are grounds for exclusion from design model protection in accordance with § 3 Section 1 Nos. 1 and 2. The German Patent and Trademark Office will continue only to check certain formal prerequisites.

The fulfilment of material requirements, such as novelty and individuality, prior to protection is not verified until possible infringement proceedings at a later date. The court is then responsible for such verification.

Evaluation by
European
Community
designers

4. Novelty and individuality – prerequisites to protection

In accordance with § 1 Section 2 of the law on design models, only new and characteristic products enjoy protection as designs or models. The bill adopts the constituent prerequisite of novelty and - as required in the Directive - replaces the further currently valid prerequisite to protection, the existence of a so-called characteristic feature, with the requirement for individuality.

According to § 2 Section 2 of the bill, a design is to be considered new if no identical design has been disclosed prior to the day of application. Designs are to be considered identical if their characteristic elements differ only in minor details.

In accordance with § 5 of the bill however, undisclosed designs may not be taken into consideration if they could not have been known to specialists in the relevant field in their everyday run of business prior to the day of application. This ruling is therefore in keeping with the currently valid law on design models according to which a design model is new – under the relatively objective definition of novelty in § 1 Section 2 of the currently valid German law on design models – if the characteristic elements of design which form the basis of its characteristic features are, at the time of application, neither known to specialists in the national field nor could they reasonably be expected to be known to them (Federal Supreme Court – BGH - Society for the Protection of Industrial Property and Copyright – GRUR - 1969, 90). The new law on design models extends this decisive criterion inasmuch as the new law is focussed not on national designers but rather on designers working within the Community. In view of the movement of goods within the domestic market of the EU member States however, it is unlikely that this new regulation will have any other outcome.

According to § 2 Section 3 of the bill, a design possesses individuality if the general impression it creates in the mind of the informed user differs from the general impression created by another design which was disclosed prior to the day of application. In contrast to this, court practice deems

that the constituent "characteristic feature" - as a prerequisite to protection under § 1 Section 2 of the old law on design models - is present if the elements determining the aesthetic effect of the design make it appear to be the result of a highly personal activity which is creative in both shape and colour and which surpasses the average ability of a designer knowledgeable in the specialized field involved (Federal Supreme Court – BGH - Society for the Protection of Industrial Property and Copyright – GRUR - 1969, 90, 95).

Strengthening of design model protection



5. Protection with powers of prohibition

The design model as a commercial and industrial protective right is strengthened considerably by means of its prohibiting powers.

§ 5 of the currently valid, old law on design models only provides legal protection against a protected design model being imitated and circulated. The presence of an imitation is however only constituted if the infringing party knew the protected design model or a visual representation of such and has adopted its characteristic features into his design model. On the contrary, § 38 Section 1 of the bill stipulates that in the case of an infringement it is not the infringer's knowledge of the protected design model which counts. Rather, the design model provides the legal holder of such with the exclusive right to use the design model and to forbid third parties from using the protected right without his permission.

Thus, the protective powers of a design model are strengthened by the bill.

Extension of duration of protection



6. Beginning and duration of protection

Under the terms of the bill, protection of a design model only begins when it is recorded in the register of the German Patent and Trademark Office whereas under current law, protection already begins with application for registration of a design. The later point of time designated in the bill for the beginning of protection of a design model results from an understanding - originating in the Directive - of design model law as an independent commercial protective right which can only come into existence once the design model has been recorded in the Register. The duration of protection of a design model is increased from the current 20 years from the day of application to 25 years.

Extension of period of grace



7. Period of grace

§ 6 of the bill contains a rule concerning the period of grace. The disclosure of a design will therefore not be considered detrimental, when determining novelty and individuality of a design, if the design in question was disclosed during the 12 months prior to the date of application or the date of priority - should priority have been claimed - by the designer or his legal successor, or by a third party as a result of information from or acts carried out by the designer or his legal successor. The same applies if the design is made available to the public as a result of an improper act carried out against the designer or his legal successor. The current law on design models only permits - in § 7a - a six month period of grace. The new bill therefore clearly improves matters for the designer.

Ascertainment of invalidity by the court



8. Invalidity of a design model

Under § 10 Section 2 of the old law on design models, a petition to court for consent to the cancellation of a design model is permitted - for example - in the case of a design or model not having the right to protection. § 31 Section 1 of the bill determines however that the invalidity of a design model is to be ascertained by court judgement if the product is no design, the design is not new or does not possess individuality or the design is excluded from protection as a design model.



On the basis of a final judgement no longer subject to appeal, cancellation from the Register can be obtained under § 36 Section 1 No. 5.

The new bill differs from current practice on design models in that the old law on design models does not provide the means for a court to ascertain the invalidity of a design model.

Regulation for older designs

9. Applicability of the new law on design models to older designs

§ 66 Section 1 of the bill proposes that the new regulations should not apply to design models registered prior to 1st July 1988 at the local district court ("Amtsgericht"). The regulations valid then should continue to be applied to such design models.

On the other hand, all design models applied for or registered following 1st July 1988 should be subject to the regulations of the new law on design models unless otherwise determined.

Currently valid and new law

10. Comparison

	Currently valid law on design models	New law on design models
Beginning of protection :	From date of application	From date of entry in Register
Duration of protection :	Up to 20 years at most from date of application	Up to 25 years at most from date of application
Period of grace :	6 months	12 months
Scope of protection :	Protection against imitation	Exclusive rights

11. Summary

In summary: the legal protection of design in Germany will be distinctly improved by the new law on design models.

→ The major advantage of the new design model is that in the case of an infringement the infringing party's awareness of the protected design model no longer matters. Further advantages are the extension of the period of grace from 6 months at present to 12 months under the new law as well as the prolongation of the possible total duration of protection from 20 to 25 years.

→ Furthermore, we would like to point out that following the introduction of the Regulations for Community Design Models on 6th March 2002, design models may now also enjoy protection throughout Europe.

Should you have specific questions on this subject, please feel free to contact me by email or at the address below.



Stephan Barth
Dr. sc. nat. (ETH), Dipl. Physicist
Patent Attorney
of
Reinhard Skuhra Weise & Partner,
Patent Attorneys