

TRADEMARKS

The trademark with which a product can be advertised is the most important non-technical protective right. In recent years it has become increasingly relevant as it can constitute a considerable value for the trademark proprietor.

In Germany trademark protection comes about through registering a design as a trademark in the register kept by the German Patent and Trademark Office (DMPA). In addition to this register mark there is another possibility of obtaining trademark protection. This so-called usage right comes about through intensive trademark-like usage of the design in commerce through which the design acquires public recognition in the participating circles. The determination of public recognition is usually carried out via opinion surveys and is therefore an expensive matter. The register mark should therefore be given priority.

For the trademark registration a reproduction of the design must be submitted with the application and a list of goods and services formulated in which the goods and services are indicated for which trademark protection should apply. In order to obtain protection of a trademark in Germany the Office's fees must be paid in time and the statutory provisions fundamentally regulated in the trademark law must be observed. The Trademark Act (new), which replaced the older version of the Trademark Act, has been in force since 01 January 1995. Since then all trademarks, in particular words, including personal names, illustrations, letters, numbers, audible trademarks, three-dimensional shapes including the shape of a product or its packaging as well as other appearance, including colours and colour combinations can be protected. In addition to these trademark forms, all manifestations accessible to the human senses, e.g. smell, taste, touch and movement trademarks are since recently protectable.

Common to all these different trademark forms is that the application requirements must be fulfilled and no absolute obstacles to protection must stand in the way of registration. These preconditions are checked by the Office during the registration

proceedings. The most important absolute obstacles to protection are a need to remain available and/or lack of distinctiveness.

Need to remain available means the need of the competitors to also be able to use the mark intended or registered as a trademark to label their goods and services. For example the brand "Tractor" would be refused registration as a logo for the product "hauling machine", whereas "Tractor" could be registered for the product "cleaning agent" as there would be no need for it to remain available here.

- Distinctiveness is the specific, inherent aptitude of a trademark to be able to allow the involved domestic commercial circles to distinguish the origin of the registered goods and services of a company from those of other companies. In this way the operational allocation of these goods and services is made possible. As a rule the commercial circle of end consumers to whom the product is sold is used.

◀ If in the official view there are no absolute obstacles to protection present the trademark is registered and the registration published in the Trademark Journal published by the German Patent and Trademark Office. With a period of three months of the date of publication, a proprietor of trademark with older priority can lodge opposition to the registration of the younger trademark which can lead to deletion or partial deletion of the younger trademark. For the opposition an opposition fee is payable to the German Patent and Trademark Office by the opponent.

- In most cases the opposition is based on relative obstacles to protection which in Germany are not official checked until registration. A relative obstacle to protection is present if the older trademark (= opposing trademark) and the younger trademark (= opposed trademark) are identical or similar and the associated goods and services also exhibit identity or similarity so that for the public there is a risk of confusion. However, it is very rare for an older trademark to oppose the younger trademark for which identical goods and services are registered, especially after search has been carried out before the trademark application.

If opposition is lodged, the German Patent and Trademark Office informs the proprietor of the opposed trademark who is then given the opportunity to submit a statement. If a statement is not submitted within the deadline the opposed trademark can be deleted.

If no opposition is lodged or the trademark is not deleted through the opposition proceedings, the protection duration of the trademark is not restricted as long as the trademark is regularly prolonged every ten years after the date of application through the payment of the prolongation fee. A further precondition for the continued existence of the trademark is that the trademark must be commercially used as the uninterrupted non-use of the trademark over a period of five years can lead to the deletion of the trademark if an effective request by a third party for expiry of the trademark is submitted.

The acquisition of trademark protection guarantees the proprietor of a German trademark an exclusive right in the entire territory of the Federal Republic of Germany so that third parties are prohibited from commercially using an identical or similar mark for identical or similar goods and services without the consent of the trademark proprietor. Injunctive relief and damages claims are applicable in the event of infringement.

Trademark protection exists not only in Germany but also abroad. In addition to the national foreign application, to simplify trademark registration a number of countries have joined the Madrid system which is based on the Madrid Agreement on the International Registration of Trademarks (MMA) and the Protocol to this Agreement (PMMA). Through this, international registration, which is carried out by the World Intellectual Property Organisation (WIPO) in Geneva, Switzerland, is also possible through a so-called international mark (IR mark) which must be based on a basic trademark application or a basic trademark.

In addition to the German trademark, the national foreign trademarks and the IR mark there is also the Union trademark which can be registered at the European Union Intellectual Property Office in Alicante, Spain and is effective for all states of the European Union.

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