

TRADEMARKS

Germany



Trademarks

Consulting editors

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Quick reference guide enabling side-by-side comparison of local insights, including legal framework; registration and use; licensing and assignment; enforcement; and recent trends.

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UPDATE AND TRENDS

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LEGAL FRAMEWORK

Domestic law

What is the primary legislation governing trademarks in your jurisdiction?

The primary legislation governing trademarks in Germany is the Act on the Protection of Trade Marks and other Signs, Trademark Act. Furthermore, specific procedural issues are laid down in the Ordinance Implementing the Trademark Act, Trademark Ordinance.

Law stated - 17 August 2022

International law

Which international trademark agreements has your jurisdiction signed?

Germany has signed the Paris Convention for the Protection of Industrial Property 1883 and the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) 1994. Germany is party to the Madrid Agreement since 1 December 1922 and of the Madrid Protocol since 20 March 1996. Germany also signed the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks 1957.

Law stated - 17 August 2022

Regulators

Which government bodies regulate trademark law?

The German Patent and Trademark Office (GPTO) is the governing body for trademark applications, oppositions and cancellation actions. Infringement proceedings will be dealt with by the German courts.

Law stated - 17 August 2022

REGISTRATION AND USE

Ownership of marks

Who may apply for registration?

According to section 7 of the Trademark Act any natural persons, legal persons or partnerships in so far as they are equipped with the capacity to acquire rights and enter into liabilities can apply for registration.

Law stated - 17 August 2022

Scope of trademark

What may and may not be protected and registered as a trademark?

According to section 3 of the Trademark Act, all signs, particularly words including personal names, designs, letters, numerals, sounds, three-dimensional designs, the shape of goods or of their packaging as well as other wrapping, including colours and colour combinations, may be protected as trademarks if they are capable of distinguishing the goods or services of one undertaking from those of other undertakings. Since 14 January 2019, it has also been possible to apply for trademarks that cannot be represented graphically, as long as they are sufficiently clearly defined

for third parties to be able to recognise their scope of protection. This means that modern forms of trademarks, such as multimedia marks, motion marks, sound marks and hologram marks, can also be registered in the Register of the German Patent and Trademark Office (GPTO). Collective and certification marks can also be registered provided that the applicant submits regulations governing the use and other requirements. A trademark can be registered for goods and services, there is no distinction between service marks and marks protected for goods. Section 8 of the Trademark Act provides a catalogue of absolute grounds for refusal, including descriptiveness and non-distinctiveness.

Law stated - 17 August 2022

Unregistered trademarks

Can trademark rights be established without registration?

Under particular conditions, trademark protection may also accrue without registration – by long-term, intensive use in trade or if the trademark has a very extraordinary reputation (what is called a well-known mark'. Section 4 of the Trademark Act provides that trademark protection may accrue if the sign has acquired public recognition as a trademark within the affected trade circles or constitute a well-known mark within the meaning of article 6-bis of the Paris Convention for the Protection of Industrial Property (Paris Convention).

Law stated - 17 August 2022

Famous foreign trademarks

Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What proof is required? What protection is provided?

A famous foreign trademark is not afforded protection if it has not been used domestically.

Law stated - 17 August 2022

The benefits of registration

What are the benefits of registration?

Although trademark protection may also accrue without registration, obtaining a trademark registration is beneficial for the following reasons: use of a registered trademark needs not to be proven unless the trademark is subject to the use requirement. In infringement proceedings, it will be assumed that the registered owner of a trademark is entitled to the right conferred by the registration, section 28 of the Trademark Act. Moreover, registered rights can be subject to border seizure applications under Council Regulation (EC) No. 608/2013. Unregistered rights may only be subject to a national customs application.

With regard to the courts, unregistered and registered trademark rights can be litigated. However, with regard to unregistered rights, the burden of proof lies with the plaintiff.

Law stated - 17 August 2022

Filing procedure and documentation

What documentation is needed to file a trademark application? What rules govern the representation of the mark in the application? Is electronic filing available? Are trademark searches available or required before filing? If so, what procedures and fees apply?

The minimum requirements for filing a trademark are the name and address of the applicant, a representation of the trademark that shows exactly what should be protected and a list of goods and/or services. Neither a power of attorney nor a certificate of corporate good standing is required. Applicants without a domicile, seat or establishment in Germany have to appoint an attorney-at-law or patent attorney. The rules governing the representation of the mark in the application are laid down in section 6a of the Trademark Ordinance. According to this provision, the trademark must be represented in a manner that satisfies the requirements of section 8 (1) of the Trademark Act. The representation may be filed on paper or on a data carrier. Electronic filing is available, either online (without signature) or electronically (with a signature). A trademark search can be conducted in the register of the GPTO that includes European Union Trademarks and International Registrations enjoying protection in Germany. Although a search is not required before filing, it is highly recommended to avoid conflicts with prior registered rights. The search in the register of the GPTO is free of charge.

Law stated - 17 August 2022

Registration time frame and cost

How long does it typically take, and how much does it typically cost, to obtain a trademark registration? When does registration formally come into effect? What circumstances would increase the estimated time and cost of filing a trademark application and receiving a registration?

After receiving the fees within three months after filing the application, the German Patent and Trademark Office (GPTO) examines whether the application meets the formal requirements and whether there are any absolute grounds for refusal of registration of the trademark. If all requirements are met, the trademark is registered and a certificate of registration will be issued. The registration of the trademark is published in the official electronic Trade Mark Journal (Markenblatt). A trademark application including class fee for up to three classes costs €290. For each additional class from the fourth class a class fee of €100 has to be paid. Attorney's fees might be added as well in the case a legal representative is appointed. Once the trademark has been registered, protection is obtained in the whole territory of the Federal Republic of Germany. At special request and subject to payment of an additional fee of €200, processing of the application is accelerated.

Law stated - 17 August 2022

Classification system

What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed? Are multi-class applications available and what are the estimated cost savings?

The GPTO follows the Nice Classification (ie, goods and services are categorised in different classes according to the International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement). The initial class fee covers up to three classes. Any additional class requires payment of an additional fee. Therefore, multi-class applications are available and more cost-effective than single applications covering only one class.

Law stated - 17 August 2022

Examination procedure

What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? Are letters of consent accepted to overcome an objection based on a third-party mark? May applicants respond to rejections by the trademark office?

The GPTO performs an examination as to absolute grounds for refusal during the application procedure, but it does not examine whether the trademark conflicts with earlier signs of others. Therefore, letters of consent are neither required nor accepted. If grounds for refusal are identified during the examination of the application, the applicant or the appointed representative will be notified in writing about the deficiencies. The applicant may respond to the objections within a time limit of two or three months. If the deficiencies cannot be remedied, the trademark application will be refused in part or in its entirety.

Law stated - 17 August 2022

Use of a trademark and registration

Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

Use of a trademark has not to be claimed before registration is granted or issued. Therefore, no proof of use has to be submitted to the GPTO at this stage. However, after registration a trademark has to be used for all registered goods and services. If the trademark is not used within a continuous period of more than five years, there is a danger of cancellation of the trademark upon request by a third party or the owner's own trademark rights cannot be enforced because use of the trademark is disputed (eg, in opposition proceedings or court proceedings). A 'grace period for non-use' exists for German trademarks. The grace period for non-use begins on the day on which filing an opposition against the registration of a trademark is no longer possible. This is either the day after the expiry of the opposition period or the date on which the decision concluding opposition proceedings becomes final or the date of withdrawal of the (last) opposition. However, if the grace period for non-use has expired, third parties may file a revocation request on the next day. That means that any trademark owner should start using the trademark in good time before this period will expire. The applicant may claim the priority of one or more previous trademark applications or registrations within a period of six months from the date of the first filings in accordance with the Paris Convention.

Law stated - 17 August 2022

Markings

What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

Trademark marking is not mandatory in Germany. However, if the trademark is registered as a national German Trademark or a European Union Trademark, the symbol ® may be used. The benefit of using such marking is that competitors and customers know that a specific designation is protected as a trademark. Incorrect use of trademark markings may be subject to misleading advertising under German unfair competition law.

Appealing a denied application

Is there an appeal process if the application is denied?

If the application is denied, the applicant may either have the opportunity to have this decision reviewed during a special motion at the GPTO or appeal proceedings with the German Federal Patent Court. Both proceedings are subject to a fee. The chances of success that the GPTO reconsiders the case in the favour of the applicant are rare. Therefore, better chances exist by way of filing an appeal to the Federal Patent Court. If requested, the Federal Patent Court can also schedule a date for an oral hearing.

Law stated - 17 August 2022

Third-party opposition

Are applications published for opposition? May a third party oppose an application prior to registration, or seek cancellation of a trademark or service mark after registration? What are the primary bases of such challenges, and what are the procedures? May a brand owner oppose a bad-faith application for its mark in a jurisdiction in which it does not have protection? What is the typical range of costs associated with a third-party opposition or cancellation proceeding?

In Germany, the registration of the trademark is published for opposition, not the application. A registered trademark can be opposed within three months after the publication of the registration. This period of time cannot be extended. In addition, third parties may file a cancellation action against a registered trademark based on the existence of earlier rights. Oppositions can be based on prior registered trademarks protected in Germany, unregistered trademarks or commercial designations. Furthermore, it is possible to invoke rights arising from the enlarged protection of trademarks that are well known in Germany (section 42(2) Trade Mark Act). Moreover, the opposition may also be based on a protected geographical indication and a protected designation of origin, provided that the application for the trademark in respect of which the opposition has been lodged was filed on or after 14 January 2019. The opposition procedure starts with the filing of a written notice of opposition. A detailed substantiation of grounds to the opposition can be filed together with the notice of opposition or afterwards. Filing a substantiation of grounds to the opposition is compulsory, not mandatory. After the exchange of written submissions, the GPTO will take a decision whether there is a likelihood of confusion between the signs. The GPTO can either reject the opposition or cancel the registered trademark in its entirety or in part. This assessment does not only take into account the similarity of the signs but also clarifies whether conflicting products and/or services are similar and the level of distinctiveness of the opposing trademark. Bad-faith is not a valid ground for opposition, but may be subject to an invalidity proceeding. The registration of a trademark may be declared invalid and cancelled ex officio if it has been registered in bad faith. The invalidity proceedings have to be initiated within a period of two years of the date of registration. With regard to the costs, the opposition fee of €250 must be paid. It includes the opposition on the basis of one opposing sign. If an opposition is based on several earlier opposing signs of the same proprietor, an additional fee of €50 must be paid for each additional opposing sign. In cancellation proceedings due to the existence of earlier rights, a fee of €400 must be paid within three months from filing the application. If the application for a declaration of invalidity is based on more than one earlier right, an additional fee of €100 must be paid with respect to each additional right. If an attorney represents the opponent or cancellation applicant, attorney's fees must be added as well.

Law stated - 17 August 2022

Duration and maintenance of registration

How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?

A registered trademark is protected for 10 years and can be indefinitely renewed for further periods of 10 years if the appropriate renewal fees have been paid. Proving use is not required for its maintenance. Use is only subject to a revocation proceeding.

Law stated - 17 August 2022

Surrender

What is the procedure for surrendering a trademark registration?

A trademark owner can surrender the trademark in total or in part for individual goods and services. A respective request can be filed with the GPTO at any time.

Law stated - 17 August 2022

Related IP rights

Can trademarks be protected under other IP rights?

A three-dimensional trademark, a word or figurative trademark or a figurative trademark can be subject to a registered design or unregistered Community design. It can also be copyright protected provided that it fulfils the requirements of copyright-protected work. Furthermore, trademarks are also subject to unlawful behaviours according to German unfair competition law.

Law stated - 17 August 2022

Trademarks online and domain names

What regime governs the protection of trademarks online and domain names?

A domain name with the top-level domain '.de' can be registered with the Deutsche Network Information Center (DENIC eG). In Germany, there is no specific regime governing the trademarks online and domain names. It largely depends on how the domain names are used. They can be used as a work title, trademark or company name.

Law stated - 17 August 2022

LICENSING AND ASSIGNMENT

Licences

May a licence be recorded against a mark in the jurisdiction? How? Are there any benefits to doing so or detriments to not doing so? What provisions are typically included in a licensing agreement?

Licences will be entered in the Register upon request, although such entry is not necessary for the validity of the

licence, but only has a declaratory effect. A fee is charged for the entry, amendment and cancellation of a licence in the Register. Applicants are required to use a form provided by the GPTO. The benefit of registering a licence is that the holder of an exclusive licence may bring an action before the ordinary courts for trademark infringement if the trademark proprietor does not bring an action within a reasonable period of time after being formally requested to do so. The following provisions are typically included in a licensing agreement:

- preamble;
- grant clause;
- rights and liabilities;
- royalties clause;
- quality control clause;
- termination clause;
- governing law clause;
- dispute resolutions clause;
- insurance clause; and
- confidentiality clause.

Furthermore, trademark proprietors can now have a non-binding declaration of their willingness to license, sell or transfer their trademark included in the register. A request is required for this purpose, which is free of charge. The declarations of willingness may be withdrawn at any time.

Law stated - 17 August 2022

Assignment

What can be assigned?

A trademark as such can be assigned and the goodwill will be automatically assigned as well as part of the trademark. The assignment can refer to all or some of the registered goods and services. No other business assets must be assigned to make it a valid transaction.

Law stated - 17 August 2022

Assignment documentation

What documents are required for assignment and what form must they take? What procedures apply?

Upon request, the assignment shall be entered in the files of the application. Applicants are required to use the forms as provided by the GPTO. A notarisation or legalisation is not required.

Law stated - 17 August 2022

Validity of assignment

Must the assignment be recorded for purposes of its validity?

No, the assignment must not be recorded for purposes of its validity.

Security interests

Are security interests recognised and what form must they take? Must the security interest be recorded for purposes of its validity or enforceability?

The right conferred by the trademark registration may be given as security. Upon a corresponding request, which may be filed by the proprietor or by the recipient of the security, such a right of lien will lead to the entry of a restraint on disposal in the register of the GPTO. Applicants are required to use the forms as provided by the GPTO. A notarisation or legalisation is not required. The security interest must not be recorded for purposes of its validity or enforceability.

Law stated - 17 August 2022

ENFORCEMENT**Trademark enforcement proceedings**

What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

Out of court, the trademark owner can send a warning letter demanding that the infringer provides a written cease and desist undertaking, including an obligation to pay a contractual fine for any case of future violation of the declaration. In court, a trademark owner can enforce the rights against an alleged infringer or dilutive use of a trademark before the regular courts in Germany by a preliminary injunction or a main action. There are 21 regional courts with jurisdiction to hear trademark infringement cases in the first instance: Stuttgart, Mannheim, Munich I, Nuremberg/Fürth, Berlin, Bremen, Hamburg, Frankfurt/Main, Rostock, Braunschweig, Bielefeld, Bochum, Cologne, Düsseldorf, Koblenz, Frankenthal, Saarbrücken, Leipzig, Magdeburg, Kiel and Erfurt. These courts have specialised chambers for trademark matters.

Infringing a trademark intentionally is a criminal offence according to sections 143, 143a, 112 and 124 Trademark Act. Punishment is a fine or imprisonment for up to three years. If the infringer acted commercially, punishment is a fine or imprisonment for up to five years. Unless the infringer acted commercially, punishment and criminal investigations require a criminal complaint by the trademark holder. Border enforcement measures are also available.

Law stated - 17 August 2022

Procedural format and timing

What is the format of the infringement proceeding?

The format of a typical trademark infringement proceedings usually starts with the filing of the complaint by the claimant, specifying the relief sought, presenting the facts of the case and the legal arguments. After serving the complaint on the defendant by the court, the defendant must file a defence letter presenting counterarguments. After pleadings have been exchanged there is an oral hearing. Oral hearings can be used to hear live testimony through witnesses and/or experts, if the court has ordered that evidence must be taken. Within a few weeks of the hearing, the court orally announces its decision. The written decision is served on the parties a few weeks later. The decision is made by a chamber of the court, which consists of three professional judges. The chamber can assign the case to one

of its members. A discovery is not allowed. Generally, in the first instance, proceedings take about 10 to 12 months from filing of the complaint until the court issues its decision. There are no ways to expedite this process or agree a binding timetable for the proceedings. The court determines the procedural dates and deadlines. Criminal proceedings may be initiated by the trademark owner. However, the criminal proceedings will be conducted by the public prosecutor and before different criminal courts.

Law stated - 17 August 2022

Burden of proof

What is the burden of proof to establish infringement or dilution?

The burden of proof lies with the plaintiff to establish infringement or dilution. The court must be convinced by a degree of certainty that leaves no reasonable doubt that an infringement exists. In preliminary injunction proceedings, the trademark owner only has to substantiate all requirements for the validity of his trademark, for example, registration and usage, and the infringing act.

Law stated - 17 August 2022

Standing

Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

The trademark owner has the right to sue for trademark infringement. Exclusive or non-exclusive licensees and distributors are not entitled to sue for trademark infringement unless the trademark holder has authorised them to sue. In addition, it must be in their own economic interest to sue for infringement. Such authorisation is generally included in the licence agreement. Unless the infringer acted commercially, punishment and criminal investigations require a criminal complaint by the trademark holder.

Law stated - 17 August 2022

Border enforcement and foreign activities

What border enforcement measures are available to halt the import and export of infringing goods? Can activities that take place outside the country of registration support a charge of infringement or dilution?

Under the Customs Enforcement Regulation, a trademark holder can apply for customs monitoring and seizures for goods imported from or exported to countries that are not member states of the European Union (EU) or the European Economic Area (EEA). Under German law, the trademark holder can apply for customs monitoring and seizures of goods imported from or exported to member states of the EU or EEA. In practice, proceedings under the Customs Enforcement Regulation are far more common than national proceedings, as cross-border trade in the EU or EEA is generally no longer subject to customs control. Activities that happen outside Germany and have no impact to the territory of Germany, cannot support infringement or dilution proceedings in Germany.

Law stated - 17 August 2022

Discovery

What discovery or disclosure devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

In Germany, a pretrial discovery is not permitted. Each party has to obtain the evidence it needs itself. Under certain strict conditions, the trademark owner may request the court to implement measures obliging the infringer to present particular documents or submit to the inspection of products under his control. If there is sufficient probability of an infringement the owner of a trademark or commercial designation can require the alleged infringer to submit a document or tolerate the inspection of an object at his disposal if this is required to establish the trademark owner's rights. If there is sufficient probability of an infringement on a commercial scale, this right also includes the submission of banking, financial or trade documents. If the alleged infringer claims that this is confidential information, the court will take necessary measures to provide the protection required. The court can order a party to submit a document or submit to the inspection of an object through a preliminary injunction, on request of the trademark owner.

Law stated - 17 August 2022

Timing

What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?

If a preliminary injunction is issued ex parte, it takes about two or three days. In case the alleged infringer files an opposition against the preliminary injunction or the court decides to schedule a date for an oral hearing, it will happen within three to six weeks. The length of regular litigation proceedings varies from court to court, but takes about 10 to 12 months from filing the complaint until a decision will be issued. Appeal proceedings before a court of appeal usually last between 15 and 18 months. A further appeal before the Federal Supreme Court usually takes about two to three years.

Law stated - 17 August 2022

Limitation period

What is the limitation period for filing an infringement action?

The limitation period for filing an infringement action is three years beginning at the end of the year in which the claim has arisen and the trademark owner obtained knowledge of the infringement or has been grossly negligent in failing to gain such knowledge. Irrespective of his knowledge or gross negligence in his failure to obtain knowledge, potential claims for trademark infringement are time-barred after 10 years from the time the claim has arisen.

Law stated - 17 August 2022

Litigation costs

What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

The amount of court fees and statutory lawyers' fees depends on the value in dispute. The value in dispute is the estimated economic interest of the claimant, but is not equal to the estimated damages. The minimum amount in

trademark proceedings is €50,000 and may be range between €100,000 and €1 million. Fees for taking evidence or settlements may also be incurred. Fees for appeal proceedings are higher. This also applies in preliminary injunction proceedings. Due to its preliminary nature, some courts have held the value in dispute to be about 30 per cent to 50 per cent lower than for a main action. The losing party must reimburse the winning party for all court fees and statutory lawyer's fees.

Law stated - 17 August 2022

Appeals

What avenues of appeal are available?

In main infringement proceedings the District Court's decision can be appealed to the Higher Regional Court of Appeal, which reviews the facts and the law. A decision of the Higher Regional Court of Appeal can be further appealed to the Federal Supreme Court if admitted by the Higher Regional Court of Appeal in its judgment or the Federal Supreme Court allows to take decision. This further appeal is limited to a review of questions of law. A preliminary injunction granted after a hearing can be appealed directly to the Higher Regional Court of appeal. If the court decided without a hearing, the defendant can file an opposition. In this case, the District Court that issued the preliminary injunction will schedule an oral hearing and then decide whether it upholds its preliminary injunction. The District Court's decision following the hearing can then be further appealed to the Higher Regional Court of appeal. Further, the Higher Regional Court of Appeal hears appeals against decisions of the District Court rejecting an application for a preliminary injunction. There is no further appeal available against the Higher Regional Court of Appeal's decision in preliminary injunction proceedings.

Law stated - 17 August 2022

Defences

What defences are available to a charge of infringement or dilution, or any related action?

The most important defence of the alleged infringer is the denial of trademark infringement. In addition, the alleged infringer may claim that the trademark is not genuinely used according to section 25 of the Trademark Act. The alleged infringer may argue a reasonable interest in free use of his own name or address or descriptive indications concerning characteristics of the goods and services, such as the kind, quality, quantity, intended purpose, value, geographical origin and time of production. A trademark can be used where its use is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts according to section 23 of the Trademark Act. The alleged infringer can claim exhaustion of trademark rights according to section 24 of the Trademark Act and may raise the defence that claims for trademark infringement are time-barred or subject to forfeiture according to section 21 of the Trademark Act. The alleged infringer may also claim abuse of legal rights, for example, if the trademark owner applied for the trademark in bad faith. If the defendant owns prior rights that might be viewed as confusingly similar to the plaintiff's rights, he may file a cancellation actions against the plaintiff's rights.

Law stated - 17 August 2022

Remedies

What remedies are available to a successful party in an action for infringement or dilution, etc?

What criminal remedies exist?

There is a final injunction to cease and desist that can only be enforced against the defendant in the infringement

action. The trademark owner can recover damages compensation or unjust enrichment (if there is no intent or negligence by the defendant). There is a relief for a recall of the infringing products or final withdrawal of them from the distribution channel and for the destruction of infringing goods. There are the remedies of rendering information by the infringer (distribution chain, sales numbers and turnover) and in certain circumstances rendering of information by third parties. There is also a claim for presentation of bank, financial and commercial documents in the possession of the infringer to secure enforcement of a claim for damages compensation in commercial infringements. Finally, there is a relief for publication of the court decision. Criminal remedies are a fine or imprisonment.

Law stated - 17 August 2022

ADR

Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?

Arbitration and ADR methods are rarely used in Germany. However, they are possible in trademark infringement matters and an arbitral award in such cases has the same effect as a court decision. A registered trademark cannot be invalidated by an arbitral award.

Law stated - 17 August 2022

UPDATE AND TRENDS

Key developments of the past year

Are there any emerging trends, notable court rulings, or hot topics in the law of trademark infringement or dilution in your jurisdiction?

The Trade Mark Law Modernisation Act has been entered into force on 14 January 2019. This brought a number of significant changes into the German Trademark Law. The change in representation of a trademark application aims to meet the market needs for modern trademark types and also takes into account the technical possibilities of representing a trademark in electronic registers. Therefore, sound marks, multimedia marks, holograms and other types of trademarks in suitable electronic formats may also be registered as trademarks. The certification mark has been introduced into German Trademark Law. The main feature of the certification mark is that, unlike the individual trademark, it does not focus on the function of the trademark as an indication of origin but on the guarantee function. The certification mark will enable neutral certification companies to obtain trademark protection in Germany for quality seals or test labels on the basis of which an international extension of protection will also be possible. It is now possible to claim relative grounds for refusal (earlier rights) in official invalidity proceedings in addition to absolute grounds for refusal, as currently possible. Furthermore, the current formal preliminary procedure with regard to revocation declarations will be converted into revocation proceedings before the German Patent and Trademark Office (GPTO). Licences are entered in the register upon request. In addition, upon request, trademark applicants and proprietors may have an entry included in the register about a non-binding declaration of their willingness to license or sell or transfer their trademark. The GPTO has now brought the calculation of the duration of protection into line with the practice of the European Union Intellectual Property Office.




The 10-year duration of protection of trademarks registered on or after 14 January 2019 starts on the day following the filing of the trademark application and, as a rule, ends on the expiry of the day that corresponds in designation or number to the filing date. For trademarks registered before 14 January 2019, the duration of protection ends, as before, at the end of the month. The system applied to opposition proceedings has changed. In the past, filing an opposition was only possible on the basis of an opposing sign, the holder of several earlier rights is now able to assert them by lodging a single opposition.

In order to facilitate negotiations between the parties to the proceedings, a period of at least two months will be granted at their joint request to reach an amicable settlement (cooling-off). This period may be extended by a joint request. The five-year period for which proof of use of the opposing trademark must be furnished begins five years before the filing date or the priority date of the challenged trademark, instead of the five years before the date of publication of the registration of the challenged trademark, as currently applicable. Thus, the period of use that must be proved corresponds to the rule in European Union Trademark law. The grace period for use will commence on the date when no further opposition can be filed against the registration of a trademark. This is either the day after expiry of the opposition period or the date on which the decision that concluded the opposition proceedings becomes final or the withdrawal of the (last) opposition.

Law stated - 17 August 2022

Jurisdictions

	Angola	RCF – Protecting Innovation
	Austria	Barger Piso & Partner
	Brazil	Bhering Advogados
	Canada	Bereskin & Parr LLP
	China	Jones & Co
	Colombia	OlarteMoure
	Denmark	Accura Advokatpartnerselskab
	European Union	Noerr PartGmbB
	Germany	Meissner Bolte
	Guatemala	Palacios & Asociados/Sercomi
	India	ANA Law Group
	Indonesia	Affa Intellectual Property Rights
	Israel	Reinhold Cohn Group
	Italy	Spheriens
	Japan	Anderson Mōri & Tomotsune
	Macau	RCF – Protecting Innovation
	Mexico	Uhthoff, Gómez Vega & Uhthoff SC
	New Zealand	PIPERS
	Peru	Estudio Colmenares & Asociados
	Portugal	RCF – Protecting Innovation
	Romania	Cabinet M Oproiu Patent & Trademark Attorneys
	Saint Lucia	Goddard-Dorville Legal
	Singapore	Ella Cheong LLC
	South Africa	Spoor & Fisher
	South Korea	Bae, Kim & Lee LLC

 Switzerland	Wenger Vieli Ltd
 United Kingdom	AA Thornton
 USA	Kilpatrick Townsend & Stockton LLP