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The Trademark Prosecution Review

2027

Germany: trademark procedures before the DPMA

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Germany: trademark procedures before the DPMA

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Summary

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IN SUMMARY

This article outlines trademark procedures in Germany before the German Patent and Trademark Office (DPMA), including application and registration as well as opposition and cancellation proceedings. Requirements for proof of use are also discussed. The article also describes enforcement against infringements, changes of ownership, licensing, online domain disputes and additional protections under German copyright and trade practices.

DISCUSSION POINTS

- Requirements and criteria for registration of trademarks, as well as reasons for non-eligibility.
- Overview of the application, DPMA examination, appeals, oppositions, publication and registration.
- Use requirements and non-use revocation.
- Enforcement and remedies.

REFERENCED IN THIS ARTICLE

- German Patent and Trademark Office (DPMA)
- Federal Patent Court (BpatG)
- Federal Court of Justice (BGH)
- Federal Act of Criminal Procedure (StPO)
- Act on the Remuneration of Lawyers (RVG)
- German Unfair Practices Act (UWG)
- DENIC eG
- German Customs Office
- World Intellectual Property Organization
- Paris Convention
- Act on the Protection of Trade Marks and other Signs 1994

FIVE KEY NEED-TO-KNOWS

- DPMA examines absolute grounds for refusal, particularly lack of distinctiveness. There is no refusal ex officio based on older conflicting trademarks.
- Germany is a first-to-file country.
- Three-month period after publication of registration in which to file an opposition, based on older rights.
- Trademarks must be put to genuine use within five years or they can be subject to revocation, but only on request and not ex officio.
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Company names are protected against newer identical or confusingly similar trade designations and trademarks once they are first used in Germany (without registration).

LEGAL FRAMEWORK

National Law

German trademarks, EU trademarks and German trademarks based on international registrations, names and non-registered trade designations are all enforceable in Germany. German trademarks are governed by the Act on the Protection of Trade Marks and other Signs 1994 (Trademark Act), which implements the EU Trade Marks Directive (2015/2436).

EU trademarks are governed by the EU Regulation (2017/1001), the EU Commission Delegated Regulation (2018/625) and the EU Commission Implementing Regulation (2018/626). International registrations that extend to Germany are governed by the Madrid Protocol, the Madrid Agreement and the Trademark Act. Names and non-registered commercial designations are governed by the Civil Code and the Trademark Act.

International Treaties

Germany has also acceded to several multilateral and bilateral international treaties. These include the Paris Convention for the Protection of Industrial Property, the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks and the Agreement on Trade-Related Aspects of Intellectual Property Rights.

Unregistered Marks

Commercial designations are protected against newer identical or confusingly similar trade designations and trademarks once they are first used in Germany. However, details of this protection can be complex. The protection may be locally restricted, for example, or there may be coexistence in the case of natural persons with the same name.

Unregistered trademarks and other commercial designations (eg, business symbols) are protected against newer identical or confusingly similar trademarks and commercial designations only from the date on which they acquire a sufficient degree of public recognition in the specific German market. The required minimum threshold is determined on a case-by-case basis. If the sign is distinctive, a degree of recognition of between 20% and 25% of relevant consumers is typically sufficient to pass the threshold test. However, if the sign is descriptive or not distinctive for other reasons, it must also have acquired distinctiveness through its use in Germany. The recognition threshold for this is typically set at least 50%. Unregistered trademarks used only outside Germany to the required substantial degree may be afforded protection in accordance with article 6-***bis*** of the Paris Convention only if the mark is well known. This will usually require between 60% and 70% recognition. These requirements must be proved by opinion polls conducted in accordance with requirements established by precedent. However, it should be noted that the aforementioned recognition thresholds are only guidelines that may vary from case to case and do not constitute rigid limits. Case law emphasises the importance of taking a flexible approach and considering all the relevant circumstances of the individual case.

Registered Marks

Any natural or legal person may apply for and own a trademark. While representation is not necessary before the German Patent and Trademark Office (DPMA) or the Federal Patent Court (BpatG) – which has jurisdiction over certain trademark matters (although not infringement cases) – applicants or owners with no domicile, seat or commercial establishment in Germany must appoint a German representative. German attorneys at law and German patent attorneys must be duly empowered, although no power of attorney need be submitted to the DPMA or the Patent Court. Other representatives must submit a power of attorney in writing (either in German, or the original with a German translation). No notarisation is required; however, foreign applicants and owners may need to comply with their local formal requirements.

Registration may be applied for a mark that consists of any sign capable of being represented clearly and in a definitively determinable way (not necessarily by graphic representation). This includes, in particular, words, numbers, graphical devices and three-dimensional shapes. The represented sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings in a legal manner.

Signs are not eligible for registration if, among other things, they:

- are devoid of any distinctive character;
- are descriptive;
- are used by competitors to describe their goods and services;
- consist exclusively of the shape that results from the nature of the goods as such, are necessary to obtain a technical result or give substantial value to the goods;
- are contrary to public policy or accepted principles of morality;
- could potentially deceive the public – for example, in regard to the nature, quality or geographical origin of the goods or services;
- consist of legally protected signs and have not been authorised by the competent authorities; or
- have been applied for in bad faith.

However, the grounds mentioned under the first three of these points may be overcome by acquiring around 50% distinctiveness.

PROCEDURES

The DPMA will examine the trademark application with regard to formalities (eg, correct classification of the goods or services and full payment of the application fees) and absolute grounds for refusal. It does not conduct an ex officio search for older conflicting trademarks. Any deficiency will be raised by the DPMA in an official action that grants the applicant at least one month in which to reply. These periods are extendable on request. This decision may in turn be appealed within one month of notification, either by an administrative appeal to the DPMA or by a direct full appeal to the Patent Court, depending on the status of the person at the DPMA who first issued the decision. A decision of a DPMA appeal division may be appealed to the Patent Court. On rare occasions, decisions of this court may be appealed to the Federal Court (BGH). Publication and registration of a trademark occur when the DPMA has issued the allowance. Without any official action, this is likely to be completed between

three and six months from the application, although the actual time can vary greatly. The trademark has effect from the date on which it is recorded in the Trademark Register.

An opposition may be filed within three months from the day of publication of the trademark registration, provided that the corresponding fees are also paid. The rights on which the opposition is based, and the scope of that opposition, must be clearly indicated. An additional fee must be paid for each right to which the newer mark is opposed. An opposition may be based on older German trademarks and EU trademarks, international trademarks in force in Germany and trade designations that are protected in Germany. It is also possible to base an opposition on older trademark applications. If and to the extent that an opposition succeeds, the opposed trademark will be expunged from the register once the ruling is final and binding.

Oppositions can also be based on protected geographical indications and protected designations of origin. Generally, opposition proceedings are documentary proceedings with no oral hearing. A typical case will involve one or two rounds of short submissions. Currently opposition proceedings before the DPMA can take at least a year for the first decision to be reached. An admissible opposition that is based on older rights will succeed if the newer mark or the goods and services claimed in its specification are identical or confusingly similar to the older right on which the opposition is based. This includes a danger of association with the older mark. In general, the scope of protection afforded to older well-known, famous or notorious trademarks will be broader. Finally, an opposition can also be based on the grounds that the opposed trademark was registered in bad faith, particularly in the name of an agent or other representative of the (normally foreign) trademark owner.

To support settlement negotiations between the parties to the proceedings, the DPMA may grant a cooling off period of at least two months within which to try to reach an amicable settlement. This period may be extended by a further joint request by the two parties.

The owner of the contested application may defend by requesting proof of use of the opposing trademark. The DPMA requires proof of use rather than simply the putting forward of a plausible case. However, in place of full proof, affirmation in lieu of an oath is still permitted pursuant to section 43(1) of the Trademark Act. The five-year period for which proof of use of the opposing trademark must be furnished will begin five years before the filing date or priority date of the challenged trademark.

The grace period for using the trademark on which the opposition is based (the period during which the use of the trademark does not have to be proven) begins essentially on the date on which the opposition period expires. In the case an opposition is filed, the commencement date of the grace period is the date on which the final decision of opposition proceedings becomes final and binding or the date of withdrawal of all oppositions. For trademarks whose application was filed with the DPMA after 14 January 2019, the beginning and end of the grace period for use is entered in the Trademark Register (section 25 (20a) of the Trademark Ordinance). An opposition will also be rejected if the younger opposed trademark was filed during the period during which the older trademark was not in genuine use. This applies even if the older trademark was subsequently put to genuine use by the owner and the lack of use cured regarding other third parties.

A trademark that is not put to genuine use within five years of the day following the expiration of the opposition period or the final decision or the withdrawal of the opposition in opposition proceedings is deemed invalid. However, if maintenance fees are paid, the mark will continue to exist on the public records, because no declaration or evidence of use is required. After

the five-year grace period for commencing genuine use, any third party may file a request for revocation at any time. If the owner does not object to this within two months, the mark will be revoked. In case of an opposition, the third party is informed and may then proceed with revocation proceedings before the DPMA by paying another official fee within a month of notification or file a revocation action based on non-use with the German regional court that has special jurisdiction in the subject. If the owner can prove that it has commenced genuine use before the revocation request is filed, the trademark will not be revoked. This is the case even if the trademark had not been used for more than five years. However, use that commences less than three months before the cancellation request after the owner became aware of its potential filing will not be considered.

Any party may file a request for revocation, and the trademark may be cancelled, if:

- there are absolute grounds for refusing trademark protection (usually overlooked by the DPMA during examination), if:
    - the absolute ground of refusal still exists at the time that the decision on the application for cancellation is made; and
    - cancellation is requested within 10 years of the registration date;
- the trademark has become the common name in the trade for the goods or services in respect of which it is registered as a consequence of acts or the inactivity of the owner; or
- use made of the mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

In respect to the enumerated number of statutory absolute grounds, a trademark may be cancelled ex officio by the DPMA if the procedure is commenced during the first two years after the registration date and the registration manifestly contravenes a finite number of provisions. These grounds may apply only to some of the goods and services for which the trademark is registered. In this case, the cancellation will concern only that part of the trademark.

As an alternative to opposition proceedings, especially after the expiry of the non-extendable three-month opposition period, the owner of older rights may file at any time a request for cancellation based on its older trademark or trade designation standing in force in Germany (ie, relative grounds). However, even if the relative grounds are proven to exist, the registration may not be cancelled if the owner of the older mark has knowingly tolerated the use of the newer mark for the goods or services in respect of which it is registered for a period of five consecutive years – unless the newer mark was obtained in bad faith or the owner of the older right has consented to registration and use of the younger mark. Further, cancellation is not possible if the older mark could have been cancelled on the date of publication of registration of the younger trademark.

Cancellation requests based on original or subsequent absolute grounds for refusal, lack of standing to own a trademark, lack of genuine use or because of the existence of earlier rights (only by the owner of such rights) may be filed with the DPMA. An action for cancellation for revocation or because of the existence of earlier rights may also be commenced before the competent higher regional court.

In adverse proceedings before the DPMA or the Federal Patent Court, each party typically bears its own costs, but the DPMA or the Federal Patent Court may issue a cost award if it is equitable that one party should bear whole or part of the costs.

The trademark may be renewed 10 years after the application filing for some or all of the goods and services for which it is registered by payment of the applicable maintenance fee. All renewals and deletions will be recorded in the register, which may be accessed online at www.register.dpma.de. Any owner may at any time relinquish their trademark completely or regarding certain goods or services by filing a corresponding written request with the DPMA.

ENFORCEMENT

Civil infringement proceedings may be based on a conflict with older rights. Typically, infringement claims will first be asserted against the infringer in the form of a letter that asks them to cease and desist and to pay a contractual penalty in case of contravention. The latter requirement is a unique feature of the German legal system and is intended to disperse the danger of repeated infringement. Unless the infringer gives such an undertaking, the action requesting an order to cease and desist will remain admissible.

The rights holder may seek an interlocutory injunction from the competent regional higher court if the matter is urgent, which is legally presumed. (The competence of specific chambers is concentrated on the state level in a few courts in each state.) The petitioner must request injunctive relief soon after learning about the infringement. This period is not legally defined, although it is generally agreed to be within one month. Some courts grant a period of up to two months, but longer periods are granted only under special circumstances. Unless the infringer acknowledges the court order as final and binding, the petitioner will have to institute normal infringement proceedings.

The following remedies are available in civil infringement proceedings:

- claims to cease and desist, which do not depend on the infringement being culpable;
- claims for actual damages, which may be demonstrated via three alternative methods:
    - licence analogy;
    - actual damages suffered by the rights holder; and
    - profits made by the infringer that are attributable to the infringement, or unjust enrichment;
    - claims for destruction and recall, or permanent removal from sale, unless this would be disproportionate – in order to secure the enforcement of such claims, under certain circumstances a sequestration can be ordered by interlocutory injunction;
    - claims for information concerning the origin and sales channels of unlawfully marked goods or services (in special cases, these claims may also exist against certain third parties);
    - claims that the infringer submits or allow access to banking, financial or commercial documents where these are required for the assertion of the compensation claim, unless this would be disproportionate – the court has the power to guarantee confidentiality protection;

- information claims, which, under certain circumstances, may be granted through an ex parte interlocutory injunction; and
- claims for the publication of the final judgment.

Reasonable attorneys' fees and court fees are awarded, depending on the extent to which a party prevails. Court and attorney fees are assessed on the basis of fee statutes that provide for lump sums and cap recoverable amounts. German attorneys at law are not permitted to charge fees below such amounts.

Wilful trademark infringement is a crime and may be punished. The local public prosecutor's office is empowered by the Federal Act of Criminal Procedure (StPO) to commence proceedings on its own initiative or upon receiving a complaint. The abilities of the rights holder to influence the investigation, including the speed at which it is conducted, are limited.

Both the seizure and eventual destruction of imported counterfeit goods in Germany are possible under German and EU regulations. Detailed information regarding this is available from the German Customs Office.

OWNERSHIP CHANGES AND RIGHTS TRANSFERS

A change of ownership regarding a German trademark takes place outside the register either through the operation of law (eg, legal succession) or on the basis of an agreement (eg, assignment). While it is not mandatory to record such a change in the register, this is highly recommended in order to ensure that rights can be enforced without delay. The validity and the form of such a change of ownership depend on the applicable law. There are no formal requirements regarding a registered trademark. A German representative who is a German attorney at law or patent attorney may request the recording of a change of ownership in the register without submitting a copy or original of the underlying legal instrument. In all other cases, documentary proof must be submitted.

Trademark licences are also granted outside the register. A licensee may themselves start infringement proceedings only with the consent of the licensor or owner of the licensed right. There is no statutory requirement to register a licence. Trademark licences are entered in the Register at the request of the proprietor of the trademark (licensor) or of the licensee if the respective other party consents. The entry contains information about the licensee, the type of licence and any restrictions. A fee is charged for the registration, amendment and cancellation of a licence in the Register. It is also possible to have licences for trademarks for which protection has been extended to Germany recorded in the International Register.

Commercial designations and names are regarded as being inextricably associated with the relevant business operation or company and may not be transferred without the business operation as such or licensed to another company. The related legal issues are complex.

RELATED RIGHTS

A trademark that is an individual and sufficiently original creative work may also be protected by copyright. This applies not only to device marks, but, on rare occasions, may also include slogans that meet a high standard of originality. Further, there may be a nexus between trademark infringement and the German Unfair Trade Practices Act (UWG). This legal area is mapped out by many precedents and is highly complex. To a certain extent, enforcement resembles trademark infringement matters, but claims differ substantially.

ONLINE ISSUES

The country code top-level domain ".de" is managed by DENIC eG. A dispute concerning a ".de" domain name may be registered with DENIC to prevent its transfer. Disputes must be resolved amicably or, if this is not possible, in court. A substantial body of trademark case law applies equally to cyberspace as it does to the offline world. For example, a domain name that is similar or identical to a registered trademark also requires use for identical or similar goods or services for a trademark-based claim to succeed. Cases of famous marks or bad-faith domain name registration may be different. Bearing this in mind, precedents have established that metatags can be infringing. AdWords usage, on the other hand, will not normally constitute infringement unless the displayed advertisement contains something that is infringing.

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