

Yearbook

2021/2022

A global guide for practitioners

Germany
COHAUSZ & FLORACK

Erik Schäfer, Ulrike Alice Ulrich and Reinhard Fischer

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Legal framework

National law

The following are enforceable in Germany: German trademarks, EU trademarks and German trademarks based on international registrations, names and non-registered trade designations.

German trademarks are governed by the Trademark Act, which implements the EU Trademark Directive 2015/2436.

EU trademarks are governed by the EU Trademark Regulation (2017/1001), the EU Trademark Delegated Regulation (2018/625) and the EU Trademark 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, such as 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 (see www.wipo.int/wipolex/en/ and www.dpma.de/english/index.html).

Unregistered marks

Commercial designations are protected against newer identical or confusingly similar trade designations and trademarks once they are first used in Germany, but details of this protection can be complex (eg, the protection may be locally restricted and 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,

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Ulrike Alice Ulrich has been with COHAUSZ & FLORACK since 1999 and became a partner in 2002. She taught trademark law at Heinrich-Heine-University in Düsseldorf between 2000 and 2007. Since starting her career as an attorney in 1996, Ms Ulrich has worked comprehensively and exclusively in IP law and related fields, specialising in matters relating to trademark law and other signs, unfair competition law and design rights. She represents national and international companies, focusing on the enforcement of trademark rights and their defence, the evaluation of business activities pertaining to the rules of competition, the assessment of the registrability of trademarks and support in application procedures worldwide, questions concerning trademark strategy and their implementation in the competitive market and the management of large trademark portfolios.

a degree of recognition from between 20% and 25% of relevant consumers is 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 use in Germany. Accordingly, the threshold for this is set at 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.

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 – which has jurisdiction over certain trademark matters (although not infringement cases) – applicants or owners with no domicile, seat or commercial



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Reinhard Fischer joined COHAUSZ & FLORACK in 2014 after working for another law firm since 2005. He specialises mainly in IP and IT law, as well as unfair competition law. Dr Fischer's areas of practice cover IP rights prosecution and litigation, as well as the drafting, examination and negotiation of IP and IT agreements, particularly licence agreements, IP purchase agreements, R&D agreements, software agreements and confidentiality agreements. Further, he has participated in several M&A projects and conducted due diligence as a legal adviser for IP and IT matters. In 2008 Dr Fischer received his PhD from Cologne University, with a thesis comparing contracts for the international sale of goods law to non-uniform German contract law.

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 – particularly 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 which 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 to third points above 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. No *ex officio* search for older conflicting trademarks is carried out by the DPMA. Any deficiency will be raised by the DPMA in an official action granting 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, by either an administrative appeal to the DPMA or 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. Decisions of the court may, on rare occasions, be appealed to the Federal Court.



An opposition may be filed three months after a trademark registration is published, provided that the corresponding fees are also paid

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 can vary greatly). The trademark has effect with regard to third parties from the date on which it is recorded in the Trademark Register.

An opposition may be filed three months after a trademark registration is published, provided that the corresponding fees are also paid. The rights on which the opposition is based and its scope must be clearly indicated.

An additional fee must be paid for each right on the basis of which the newer mark is opposed. Generally, opposition proceedings are documentary proceedings with no oral hearing. A typical case will involve one or two rounds of short submissions. Currently, it can take at least a year for the first decision in opposition proceedings before the DPMA.

An opposition may be based on older German trademarks and EU trademarks, international trademarks in force in Germany and trade designations which are protected in Germany. It is also possible to base an opposition on older trademark applications.

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. Basically, the scope of protection afforded to older well-known, famous or notorious trademarks will be broader.

In order to support settlement negotiations between the parties to the proceedings, a period of at least two months will be granted by the DPMA at their joint request to reach an

amicable settlement (ie, cooling off). This period may be extended by a further joint request.

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 putting forward a plausible case. However, in place of full proof, affirmation in lieu of an oath is still permitted pursuant to Section 43(1) (second sentence) 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 use will commence on the date when no further opposition is possible against the registration of a trademark:

- the date from which an opposition can no longer be lodged due to the expiration of the opposition period;
- the date on which the decision that concluded the opposition proceedings becomes final; or
- the date on which the opposition was withdrawn.

The beginning and end of the grace period for use will be 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, even if the older trademark was subsequently put to genuine use by the owner and the lack of use cured *vis-à-vis* other third parties.

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.

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.

A trademark that is not put to genuine use within five years of expiration of the opposition period or, as the case may be, the final decision in opposition proceedings is deemed invalid. However, as long as 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 *ratio materiae*. If the owner can prove that it has commenced genuine use before the revocation request is filed, the trademark will not be revoked even if it 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 which 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



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

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.

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 relinquish its trademark completely or with regard to certain goods or services by filing a corresponding written request with the DPMA at any time.

Enforcement

Civil infringement proceedings may be based on a conflict with older rights. Typically, infringement claims will first be asserted against the infringer by sending a cease and desist letter that requests the infringer to henceforth cease and desist and pay a contractual penalty in case of contravention. The necessity of requiring a contractual penalty to disperse the danger of repeated

infringement is a unique feature of the German legal system. 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 (the competence of specific chambers is concentrated on the state level in a few courts in each state) if the matter is urgent, which is legally presumed. 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, while 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 which 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



The necessity of requiring a contractual penalty to disperse the danger of repeated infringement is a unique feature of the German legal system

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 submit 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.

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 to commence proceedings on its own initiative or upon receiving a complaint. The possibilities of the rights holder to influence the investigation, including the speed at which it is conducted, are limited.

The seizure and eventual destruction of imported counterfeit goods in Germany are possible under German and EU regulations, in regard to which detailed information is available from the German Customs Office at www.zoll.de/english_version/d0_protection_property/a0_trademark/index.html.

Ownership changes and rights transfers

A change of ownership with regard to a German trademark takes place outside the register 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. With regard to a registered trademark as such, there are no formal requirements. A German representative who is a German attorney at law or patent attorney may request the recordal 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 of the register. A licensee may itself start infringement proceedings only with the consent of the licensor/owner of the licensed right. There is no statutory requirement to register a licence.

Commercial designations and names are regarded as being inextricably associated with the relevant business operation or company (eg, goodwill) 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 not only applies 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. This legal area is mapped out by many precedents and is highly complex. Enforcement resembles trademark infringement matters to a certain extent, but claims differ substantially.

Online issues

The ccTLD '.de' is governed by DENIC eG. A dispute concerning a '.de' domain name may be registered with DENIC in order 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 to cyberspace, just 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 in order 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. AdWord usage, on the other hand, will not normally constitute infringement unless the displayed advertisement contains something that is infringing. **WTR**

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Examination/registration

Representative requires a power of attorney when filing? Legalised/notarised?

No: if attorney at law or patent attorney admitted in Germany.



Examination for relative grounds for refusal based on earlier rights?

No



Registrable unconventional marks

If representable in such a way that they can clearly and unambiguously determined.



Unregistered rights

Protection for unregistered rights?

Yes



Specific/increased protection for well-known marks?

Yes



Opposition

Opposition procedure available? Term from publication?

Yes: three months from publication.



Removal from register

Can a registration be removed for non-use? Term and start date?

Yes: following five years' non-use from later of registration or end of opposition.



Are proceedings available to remove a mark that has become generic?

Yes



Are proceedings available to remove a mark that was incorrectly registered?

Yes



Enforcement

Specialist IP/trademark court?

Yes



Punitive damages available?

No



Interim injunctions available? Time limit?

Yes: urgency required.



Ownership changes

Is registration mandatory for assignment/licensing documents?

No



Online issues

National anti-cybersquatting provisions?

No special provisions; however, general provisions apply.



National alternative dispute resolution policy (DRP) for local ccTLD available?

No

