

Intellectual Asset Management

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Options for trademark opposition brought into line with international practice

COHAUSZ AND FLORACK - Germany

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As of 1st October 2009, an opposition to a newer trademark registration at the German Patent and Trademark Office need no longer be based on a registered trademark or trademark application. It is now possible to base such an opposition on:

- work titles;
- marks that have been used but not registered; and
- business signs (eg, the name or logo of a company).

Previously, the only way to assert rights in such non-registered signs against later German trademark registrations was by way of cancellation proceedings in court. Compared to opposition proceedings, this approach was more expensive and posed additional risks. Thus, the amendment is good news for owners of unregistered rights. It was part of the recently passed Bill for the Simplification and Modernisation of Patent Law, and is designed to bring the German provisions for opposition proceedings into line with those applicable to the Community trademark.

The timeframe for opposition remains the same: an opposition must be filed within three months of publication of the registration of the younger trademark.

Many companies already have active monitoring policies in place to detect new registrations of trademarks that are identical or similar to their own registered trademarks. Due to the short time periods for opposition, the amendments make it expedient to extend this monitoring to business signs and work titles. Of these, actual company names or logos are particularly important.

Conversely, a prospective applicant for a new trademark will have to extend its search for prior rights to the same categories of non-registered mark in order to minimise the risk of opposition proceedings.

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