

# DEUTSCHES PATENT- UND MARKENAMT

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## Information for Trade Mark Applicants

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### **Introduction**

The requirements for the application of a trade mark are governed by the following provisions:

1. the Law on the Protection of Trade Marks and Other Signs (Trade Mark Law) of 25 October 1994 (Federal Law Gazette\* I p. 3082), last amended by Article 3 of the law on the simplification and modernisation of patent law (*Gesetz zur Vereinfachung und Modernisierung des Patentrechts*) of 31 July 2009 (Federal Law Gazette I p. 2521);
2. the Patent Costs Law of 13 December 2001 (Federal Law Gazette I, p. 3656) last amended by Article 6 of the law amending patent opposition proceedings and the Patent Costs Law (*Gesetz zur Änderung des patentrechtlichen Einspruchsverfahrens und des Patentkostengesetzes*) of 21 June 2006 (Federal Law Gazette I p. 1318) and the Patent Costs Payment Ordinance of 15 October 2003 (Federal Law Gazette I p. 2083);
3. the Ordinance Implementing the Trade Mark Law (Trade Mark Ordinance) of 11 May 2004 (Federal Law Gazette I p. 872), last amended by Article 1 of the Ordinance Amending the Trade Mark Ordinance of 15 October 2008 (Federal Law Gazette I p. 1995);
4. the Ordinance Concerning the German Patent and Trade Mark Office of 1 April 2004 (Federal Law Gazette I p. 514), last amended by Article 2 of the ordinance concerning the revision of electronic legal transactions with the German Patent and Trade Mark Office (*Verordnung über die Neuregelung des elektronischen Rechtsverkehrs beim Deutschen Patent- und Markenamt*) of 26 September 2006 (Federal Law Gazette I p. 2159).

### **What is a trade mark?**

A **trade mark** is a sign which can distinguish the goods and services of one undertaking from those of another. Words, letters, numbers, and pictures, sounds and three-dimensional configurations and other packaging may be protected as trade marks, provided they comply with the provisions of the Trade Mark Law.

### **What requirements must be met for the registration of a trade mark?**

A sign can be protected as a trade mark by recording it in the register kept at the German Patent and Trade Mark Office (DPMA) (Sec. 4 No. 1 Trade Mark Law). In order to apply for registration it is necessary to file a request giving certain details.

The request **must** be filed on the **form** ([W 7005](#) - in German) **issued by the DPMA**. (Alternatively, another form may be used provided it has the same contents and a comparable format, particularly forms created and processed by means of electronic data processing). Before completing the application form please read the following sections carefully (the numbers in brackets refer to the corresponding sections):

#### **Address for service (1)**

Please fill in the complete postal address to which the DPMA will send all correspondence.

The address for service may differ from the address of the person who is to be the proprietor of the trade mark (applicant).

Please note that some of the communications sent by the DPMA to the stated address will start important time limits - therefore please ensure that you can be contacted at this address.

#### **Box next to "Telefax vorab" (fax in advance)**

If you transmit your application by fax to the DPMA before sending it by mail, please check this box. Please enter the date of the fax here. This will help us to identify the documents going together and avoid unnecessary double applications.

#### **Section (2)**

Please give your internal reference (if any), your telephone number/s, fax number and the current date.

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\* Bundesgesetzblatt (BGBl.)

### Trade mark applicant (3)

The **applicant** must be indicated. Otherwise the application is not effective and does not establish a filing date for determining the seniority of the trade mark.

The **applicant** may be a natural person or a legal person or a partnership with legal capacity (Sec. 7 Trade Mark Law).

The information on the applicant must comprise the **name** and **address**.

Where the trade mark is to be registered for a company, the trade name of the company as registered in the commercial register must be provided.

If an applicant is registered as legal person in a register, the name must be indicated in a form corresponding to that of the register entry.

If the application is to be filed for more than one person, the names and addresses of residence of all individuals must be given.

For associations not registered in the commercial register or register of associations, the names and addresses of all members must be stated in the application (Sec. 5 (3) Trade Mark Ordinance). A partnership under the Civil Code can be registered in the Trade Mark Register, if the name and address of at least one partner entitled to act as representative are indicated (Sec. 5 (1) No. 2, second sentence, Trade Mark Ordinance).

If the application for registration is for a limited liability company in formation (*GmbH i. G.*), an uncertified copy of the company agreement must be attached.

### Representative (3)

If you appoint a representative, for example, an attorney-at-law or a patent attorney to deal with your application for you, provide **name** and **address** of the representative here. It is permissible to confer authority on an association of representatives, indicating the name of this association.

A **power of attorney** signed by the client must be submitted to the DPMA only, if the representative is neither an attorney-at-law nor a patent attorney (Sec. 15 (4) Ordinance Concerning the German Patent and Trade Mark Office). The person given power of attorney must have the capacity to sue or be sued. The power of attorney must indicate his/her civil name.

Applicants having a domicile, a seat or an establishment in Germany **do not** have to appoint a representative for the procedure before the DPMA. Applicants (also German nationals) having neither a domicile nor a seat or an establishment in Germany must appoint an attorney-at-law or a patent attorney in Germany as representative (Sec. 96 (1) Trade Mark Law). Under certain conditions, attorneys-at-law or patent attorneys from countries party to the European Union or European Economic Area may also act as representatives before the DPMA (see Sec. 96 (2) Trade Mark Law).

### Request for international registration (4)

Please check this box **only** if you submit a request for international registration simultaneously with the national application. However, it is useful to furnish the request only after communication of the file number of the national application (for example, after receiving an acknowledgement of receipt), because processing of the request for international registration cannot start before. In this context, we **strongly** recommend that you carefully read the information on international registration

under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to the Madrid Agreement ([M 8940](#) - in German).

### Representation of the trade mark (5) and form of the trade mark (6)

The application must contain the representation of the trade mark. Otherwise the application is not effective and does not establish a filing date for determining the seniority of the trade mark.

A separate application must be filed for each trade mark.

The trade mark applied for cannot be changed after the application form has been sent to the DPMA.

The trade mark for which protection is sought shall be shown in the request exactly as it is intended to be protected.

If the representation of the trade mark does not fit in the space provided in the application form, please use an additional sheet. Please attach the extra sheet to the form and check the box marked "siehe Anlage" (see attachment).

For all trade marks, except for word marks (see section (6) below), two identical **graphic representations of the trade mark** shall be attached to the application (Sec. 8 (1) Trade Mark Ordinance).

An electronic data carrier (CD or DVD - for details on the data carrier formats cf.

<http://www.dpma.de/marke/anmeldung/datentraegerformate/index.html>) containing the representation of the trade mark can be submitted additionally (for details cf. Sec. 8 (5) Trade Mark Ordinance).

The sheets used for the representations of the mark must not be exceed A4 size (height: 29.7 cm, width: 21 cm) and the space for representation of the trade mark (type area) must not be exceed 26.2 cm x 17 cm. The sheets must be typed on one side only. The minimum size of the trade mark representation must be 8 cm in width or 8 cm in height (Sec. 8 (3) Trade Mark Ordinance). Please ensure that you leave at least 2.5 cm margin on top of the sheet and on the left side.

Please write "top" or "bottom" on each representation to indicate the correct position of the trade mark, if it is not obvious.

For the application of a three-dimensional shape to be registered as a trade mark (**three-dimensional mark**) a maximum of six different views of the trade mark (two copies each) can be filed. All views must be represented on one sheet of the size indicated above and the type area must not be larger than indicated above. The representations must sufficiently specify the subject matter of protection and clearly show all essential features.

If the trade mark is to be registered in **colour** instead of black and white, the respective colours must be named (eg red, green, yellow). The use of RAL, Pantone or HKS colour codes is not sufficient. For applications for trade marks in colour filed **by fax** the applicant can obtain the receipt date of the fax as filing date only, if the allocation of colours can be clearly identified on the fax.

If a sound is to be applied for as a trade mark (**sound mark**), a sound representation of the trade mark on an electronic data carrier (CD or DVD - for details on the data carrier formats cf.

<http://www.dpma.de/marke/anmeldung/datentraegerformate/index.html>) must be attached to the application in

addition to the graphic representation of the trade mark (represented by a music notation system) (for details cf. Sec. 11 (5) Trade Mark Ordinance).

Except for word marks, a **description** may also be attached to the application.

**In section (6) the form of the trade mark applied for must be indicated.**

**Word marks** (Sec. 7 Trade Mark Ordinance) are trade marks which may consist of words, letters, numbers or other characters and can be typed or printed using the DPMA's standard font.

**Figurative marks** (Sec. 8 Trade Mark Ordinance) are pictures, graphic elements or images (with or without word elements).

**Combined word/ figurative marks** consist of a combination of word elements and graphic elements, or of words that are represented graphically. They form a sub-group of the figurative mark.

**Three-dimensional marks** (Sec. 9 Trade Mark Ordinance) are concrete objects ie they consist of a three-dimensional shape.

**Sound marks** (Sec. 11 Trade Mark Ordinance) are acoustical, audible marks consisting of sounds, for instance, a short melody.

**Tracer marks** (Sec. 10 Trade Mark Ordinance) are usually coloured stripes or threads fastened to certain products (mostly cables, wires or hoses).

**Other forms of trade marks** (Sec. 12 Trade Mark Ordinance) are marks not falling within the above mentioned categories of trade marks. For example, a colour mark *per se* that is composed of one colour or several colours, regardless of any specific shape or configuration falls within the category, other forms of trade marks.

### **Request for accelerated examination (7)**

The request for accelerated examination (Sec. 38 Trade Mark Law) can be made in order to expedite the decision on the requirements of registration (Sections 36, 37 Trade Mark Law). Its aim is to ensure that a trade mark is registered within a period of 6 months, if it complies with all registration requirements. Registration of the trade mark within this period is particularly important, for instance, if the applicant intends to have this trade mark registered internationally and intends to claim the priority of the German trade mark.

A special fee of EUR 200.- must be paid for the accelerated examination.

### **List of goods and services (8)**

*The application must by all means list all goods and services on which the mark is intended to be used. Without such a list of goods and services the application is not effective and does not establish a filing date for determining the seniority of the trade mark.*

*After the application has been received by the DPMA **no** goods and services can be **added to** the list. However, restrictions are possible any time.*

The scope of protection of a trade mark is determined by the goods and services for which it is protected. All goods and services are divided into 45 classes on the basis of the "International Classification of Goods and Services for the Purposes of the Registration of Marks". The amount of the fee payable for the application depends on the number of classes claimed.

The goods and services intended to bear the trade mark must be **expressed in words** on the form - it is not sufficient to give only the numbers of the classes (eg "12, 22, 36"). If the space provided on the form is not sufficient, further sheets may be attached to the application form. In that case please check the box "*siehe Anlage*" (see attachment).

Furthermore **two copies** of the list of goods and services must be attached to the application. The lists must be in font size 11 and 1,5 line spacing.

Please note that applications must contain a list of goods/services presented **in grouped form**, that means that the applicant must separately list the goods/services belonging to each class and the classes must be given in ascending numerical order. Applications with lists of goods and services that are not at all arranged in groups may result in considerable delay in processing or even lead to the rejection of the entire application, if the applicant does not subsequently file a list that is arranged into groups.

**Detailed information** on how to arrange the lists of goods and services into groups is provided in the leaflet "*Klasseneinteilung der Waren und Dienstleistungen*" (W 7733), also available at:

[http://www.dpma.de/english/trade\\_marks/forms/w7733](http://www.dpma.de/english/trade_marks/forms/w7733).

The goods and services must be **indicated exactly** so that they can be attributed to the correct class of goods and services, allowing to clearly define the scope of protection of the trade mark in later disputes. General terms such as "equipment" or "systems" are not sufficiently precise.

If the terms used are too vague, the application procedure may be delayed considerably.

Information in German on how to prepare the list of goods and services is provided in the leaflet "*Klasseneinteilung der Waren und Dienstleistungen*" (W 7733). The terms listed there should preferably be used, since they constitute the admissible standardised terminology. Only those terms of the official list that have a **grey background** have to be explained according to the recommendations.

Admissible terms for goods and services may also be found in the "Alphabetical List of the International Classification of Goods and Services under the Nice Agreement".

*The **search engine** for goods and services of the DPMA (<http://www.dpma.de/service/klassifikationen/nizzaklassifikation/suche/suchen.html> - in German) may also be of assistance for preparing a list of goods and services. It contains the terms of the classification and the alphabetical list of the international classification and also many other terms generally accepted by the DPMA for registration.*

### **Note**

Each additional class of goods and services claimed will increase the probability of objections by proprietors of earlier trade marks to the registration of the trade mark.

Furthermore, the Trade Mark Law prescribes the compulsory use of the goods and services claimed. This means that the trade mark must actually be put to use in trade in connection with all the goods and services claimed in order to maintain the right.

Consequently, the applicant should draft the list of goods/services based on the real circumstances of his company, his business plans or his other commercial

activities, even if this means that he does not claim all three classes covered by the application fee.

### **Proposal on a leading class by the applicant and reference to lists of goods and services already registered in identical form (8)**

The applicant can suggest a leading class. It is true that this proposal is not binding, but usually the DPMA will go along with it.

In case of insufficient payment of fees, the amount received will cover the fees of the leading class first.

Furthermore, the leading class of the filed application determines which examiner is in charge of processing the application.

You can refer to a **list of goods and services** already registered **in identical form** by indicating the corresponding file number. This may expedite the processing of your application. However, it will not constitute a claim for re-entering the list in the same form, above all, if the version of the Nice Classification, on which the original application is based, has changed or if the German Patent and Trade Mark Office has changed its view on how to classify the goods/services.

### **Registration of a collective mark (9)**

The collective mark is a sign that an industrial or trade association may use to gain protection for its members (enterprises). A collective mark can only be registered for a **legally established association** or a **public law entity**.

When filing an application for a collective mark, the provisions of Sections 97 et seq. Trade Mark Law must be observed.

### **Foreign priority and exhibition priority (10)**

The day of receipt of the application documents at the DPMA is usually relevant for the seniority of a trade mark.

In certain cases, however, an **earlier date** can be claimed.

#### **a) Foreign priority**

**If the trade mark has already been applied for or registered in a foreign country**, the seniority of this previous foreign application may be claimed within six months of the previous application for a later German application (Sec. 34 Trade Mark Law), provided there exists an agreement under international law with the foreign country concerned.

For this purpose, the earlier foreign application must be completely identical with the later German application.

In this case the box "*ausländische Priorität*" (foreign priority) must be checked and the filing date, the country and the reference number of the earlier foreign application must be indicated. This declaration can still be made within a period of two months after filing the German trade mark application.

#### **b) Exhibition priority**

**If the applicant has already displayed goods and services bearing the trade mark at an exhibition** within the preceding six months, the date of the first display of the goods and services may be claimed as the date of priority provided the exhibition was published by the Federal Ministry of Justice (Sec. 35 Trade Mark Law). The designated exhibitions are published at regular intervals in the Federal Law Gazette and the Official Gazette of the DPMA (*Blatt für Patent-, Muster- und Zeichenwesen*).

In this case the box "*Ausstellungspriorität*" (exhibition priority) must be checked. In this context, you can use our new form [W 7708](#) "*Ausstellungsbescheinigung*" (exhibition certificate). Please specify, in particular, the name and place of the relevant exhibition or fair and the date of the first time display of the goods or services under the trade mark applied for. This certificate, signed / stamped by the fair management or the service responsible for the protection of intellectual property at the exhibition, can still be filed within a period of two months after filing the trade mark application.

### **Series of trade mark applications (11)**

If you apply to register several trade marks in one single consignment, this can be treated by the DPMA as a series of trade mark applications that will be processed by one trade mark section.

It ensures a uniform examination in cases where formal questions have to be clarified, for example, as regards the admissibility of the terminology used in the list of goods and services. All applications will in general be processed simultaneously. Inquiries on the applications will be answered by one contact person.

A series of applications must comply with the following **conditions**:

- All applications have the same applicant and the same proposal on a leading class.
- A request for accelerated processing has been filed for all applications or for none of the applications.
- Each application is made on a separate application form ([W 7005](#) - in German) and the total number of (individual) applications as well as the number of the current application is given in section 11 of the application form.
- The applicant has completely filled in the form "*Vorblatt zu einer Serie von Anmeldungen*" ([W 7002](#) - in German).

#### **Please note:**

- All future correspondence and documents must be separately filed for the respective applications.

The applicant has **no legal claim** that his (individual) applications will be treated as a series.

However, even if all requirements for a series of applications are met, the DPMA reserves the right to process the (individual) applications - due to the technical and organisational reasons - according to its internal distribution of business.

### **Fees, payment of fees (12)**

Please refer to the Information Concerning Costs, Fees and Expenses of the DPMA and Federal Patent Court ([A 9510.1](#)) for the applicable amounts of the fees.

For the application of a trade mark, an **application fee** must be paid **which includes the class fees covering up to three classes**. If the trade mark application comprises goods and services in more than three classes of the classification of goods and services, an **additional class fee** must be paid for **each class exceeding three**. These fees are due when filing the application. They can neither be deferred nor waived. The applicant will receive an information on the amount of the fees payable sent out together with an acknowledgement of receipt. No further invitation to pay the fees stated will be issued.

**If the full amount of the application fee is not paid within three months from filing the application, the**

**application is deemed to be withdrawn** (Sec. 6 (1) Patent Costs Law). The statutory period runs independently of receiving an acknowledgement of receipt. If the applicant fails to pay the class fees or part of the class fees within the three-month period, the leading class will be covered first by the amount paid followed by the other classes in the sequence of the list of classes, unless the applicant has indicated which classes of goods and services should be covered by the payment. With respect to the goods and services in the other classes, the application is deemed to be withdrawn (Sec. 36 (3) Trade Mark Law).

Where the accelerated examination under Sec. 38 Trade Mark Law is requested, the fee must also be paid within three months from filing the request. If the fee is not paid or not paid in due time, the request for acceleration is deemed to be with-drawn (Sec. 6 (1) Patent Costs Law) and normal processing of the application will follow.

The payment of fees is governed by the Ordinance on Payment of Costs of the German Patent and Trade Mark Office and of the Federal Patent Court (Patent Costs Payment Ordinance). Under these provisions fees may be paid as follows:

- a) in **cash** (at the paying offices of the German Patent and Trade Mark Office, in the Munich or Jena offices and in the Technical Information Centre in Berlin);
- b) by **transfer** to the account of Bundeskasse Weiden (account no. 700 010 54, bank sort code: 700 000 00);
- c) by **payment (by cash)** to the account of Bundeskasse Weiden at a national or foreign financial institution (account no. 700 010 54, bank sort code: 700 000 00);
- d) by handing in or sending a **direct debiting mandate** for an account in Germany. It is strongly recommended to use the official form ([A 9507](#) - in German) in order to avoid mistakes and delays in crediting the fee.

Forms are also available on the Internet at: [http://www.dpma.de/english/service/forms\\_brochures/forms/index.html](http://www.dpma.de/english/service/forms_brochures/forms/index.html).

Please note:

The following day is considered the date of payment:

- a) for cash payment: the day of paying in the amount,
- b) for transfer: the day when the amount is credited to the account of Bundeskasse Weiden,
- c) for payment (by cash): the day of paying in the amount,
- d) for debiting advice mandate: the day of receipt of the debiting advice mandate at the German Patent and Trade Mark Office, provided the paying office of the DPMA is the beneficiary of debiting transaction.

*All payments must indicate the purpose of the payment and the official file number, if it is known, otherwise the name of the applicant and the filing date.*

If you intend to pay fees by transfer from a foreign country or pay in the fees by cash from a foreign country, please give the following details:

Beneficiary: Bundeskasse Weiden  
Name of the bank: BBk München (= Deutsche Bundesbank Filiale München)  
Account number: 700 010 54  
Bank sort code: 700 000 00  
BIC (SWIFT Code): MARKDEF1700  
IBAN: DE84 7000 0000 0070 0010 54

IBAN and BIC codes help to reduce duration and minimise costs of cross-border payments.

Note that this will not extend the periods for payment. Important: All bank charges must be met by the payer who should instruct the bank accordingly. If the amount received by the DPMA does not cover the fees due, this will lead to the legal consequences of insufficient payment.

### Signature

The original of the application for registration of a trade mark shall be signed by the applicant or applicants (a facsimile stamp is not acceptable!) Each applicant must **personally** sign the application.

Where the applicant is a company, the signature of the person authorised to sign on behalf of the company is required. The authorisation should be shown clearly by the stamp of the company and the corresponding addition.

### “Telle-quelle” protection

Where a trade mark applied for has already been registered in a Member State of the Paris Union, it is possible to apply for the so-called “telle-quelle” protection for this trade mark application in Germany (see Article 6quinquies of the Paris Convention). In this case, registration of the filed trade mark may only be refused under particular circumstances. However, those applications can also be rejected, where absolute grounds for refusal exist, or may be cancelled after opposition proceedings.

Telle-quelle protection is only relevant for very few applications. Please consult a patent attorney or attorney-at-law for information on this matter.

### Filing a trade mark application in electronic form

You can file your trade mark application also in electronic form at the German Patent and Trade Mark Office. For completing and verifying your application documents you will need the DPMAdirekt software, formerly PaTrAS, which can be ordered or downloaded free of charge at:

<http://www.dpma.de/english/service/e-services/dpmadirekt/index.html>

For electronic filing you must have an enhanced electronic signature. Providers of qualified certificates are listed at:

<http://www.dpma.de/english/service/e-services/dpmadirekt/index.html>.

Please check carefully whether you can file an electronic trade mark application in due form or whether you choose to file your application in paper form (fax, letter), which is also still valid.

### What happens after filing the application?

After receipt of the application the DPMA allots a file number. The Office identifies the correct classes for the goods and services claimed. Immediately afterwards an acknowledgement of receipt together with the information on fees is sent to the applicant. The trade mark application for which a filing date has been established, will be published in the DPMAregister, the electronic industrial property information system of the DPMA (<http://register.dpma.de>) (Sec. 33 (3) Trade Mark Law).

## Examination of the application as to absolute grounds for refusal

Processing of the trade mark application will be continued only after the payment of the application fee and class fees, if any, (Sec. 5 (1) Patent Costs Law). The consequences of non-payment or late payment of fees are explained above in the section "Fees, payment of fees (12)".

The application will be checked for compliance with the **formal application requirements** and the existence of so-called **absolute grounds for refusal** impeding the registration of the application (Sections 36, 37 Trade Mark Law).

The DPMA **does not** examine whether **similar or identical trade marks** have already been registered. Proprietors of earlier trade marks may give notice of opposition only after registration of the trade mark (see below, "Opposition").

At first, it is examined whether the **conditions for obtaining a filing date** are fulfilled (Sec. 32 (2) Trade Mark Law) determining seniority of the trade mark application. For meeting the conditions the application must contain information identifying the applicant, a representation of the trade mark and a list of goods and services for which registration is requested.

Where these or **other formal requirements** are not met, the applicant will receive an invitation to remedy the defects within a time limit. If he fails to remedy the defects within this time limit the application is deemed withdrawn, where the requirements for obtaining a filing date are not complied with (Sec. 36 (2), first sentence, Trade Mark Law). Where other formal requirements are not met, a decision to reject the application will be issued (Sec. 36 (4) Trade Mark Law). If the trade mark application has been rejected following a failure to observe a time limit fixed by the German Patent and Trade Mark Office, the applicant may request further processing of the application within one month after notification of the decision to reject the application (Sec. 91a Trade Mark Law). Within the one-month period the fee for further processing of EUR 100.- shall be paid and the omitted act shall be completed. The section in charge of deciding on the subsequently completed act shall decide on the request for further processing.

Furthermore, the office examines the existence of **absolute grounds for refusal** within the meaning of **Section 8 Trade Mark Law**. Under this provision, signs are not eligible for registration if they simply describe the type, quality and other properties and characteristics of the claimed goods and services.

Where an absolute ground for refusal is identified the applicant will receive an information on the defects. He will get the opportunity to comment within a time limit fixed in this information.

If the absolute ground for refusal persists despite the comment made by the applicant, **a decision to reject the application** will be issued.

The **period** for lodging an appeal is **one month**.

It is possible to lodge a legally effective appeal in electronic form (electronic appeal). For lodging an electronic appeal certain technical conditions of data processing must be fulfilled. **It is important to observe the detailed requirements for lodging an electronic appeal** which you can find at <http://www.dpma.de/english/service/e-services/dpmadirekt/index.html>).

For example, it is **not** sufficient to send the appeal documents by e-mail to the DPMA. If the **requirements are not met**, the appeal is **not made effectively**. Please check carefully whether you are able to duly make an appeal in electronic form or whether you wish to make an appeal on paper which is still admissible.

Where all formal requirements are met, the fees paid and no absolute ground for refusal identified, the **trade mark applied for will be recorded in the register** and the **registration published** in the Trade Mark Journal. The proprietor will receive a certificate on the registration (as of 1 November 2008, colour certificates are issued for colour representations of the trade marks) and a document certifying all the other data recorded in the register.

## Benefits of a trade mark registration

Registration of a trade mark gives the proprietor of the mark an exclusive right (Sec. 14 (1) Trade Mark Law). This means that in case of infringement of these rights, the proprietor may bring an action for damages or apply for an injunction of the infringing acts (Sec. 14 et seq. Trade Mark Law).

**However, it should be noted that the trade mark may be cancelled subsequent to opposition proceedings on the basis of earlier trade mark rights. This means that, at first, only a provisional right is granted.**

## Opposition

**After publication** of the trade mark registration, the proprietor of an earlier trade mark applied for or registered, the proprietor of a trade mark acquired by use and the proprietor of a commercial designation may, **within** a period of three months following publication, give notice of **opposition** (Sec. 42 Trade Mark Law).

If one or several notices of opposition are received, the DPMA informs the proprietor of the challenged trade mark, who has the opportunity to make a comment. After both, the opposing party and the proprietor of the challenged trade mark, had the opportunity to make comments, a decision on the opposition is taken. The opposition is successful and the later trade mark cancelled, if due to the identity or similarity of the later trade mark/sign to the earlier trade mark, and the identity or similarity of the goods and services covered by the two signs or the proximity of sectors, there is a likelihood of confusion (Sec. 9 (1) No. 2 and Sec. 12 Trade Mark Law). Otherwise the opposition is rejected.

The special protection for trade marks having a reputation under Sec. 9 (1), No. 3, Trade Mark Law may also be claimed.

In order to prevent oppositions, as far as possible, you should check before applying for the registration of a trade mark whether identical or similar trade marks have already been registered. You can search for registered trade marks yourself by using the DPMAregister search system of the DPMA (<http://register.dpma.de>) on the Internet or in the public search room of the DPMA in Munich, the Technical Information Centre in Berlin or a patent information centre or you can ask an attorney-at-law or a patent attorney or a professional information service for help with your search.

It is also useful to conduct a general (Internet) search for earlier trade marks acquired by use and commercial designations, because it is not possible to search for these signs in DPMAregister.

### **Cancellation of the trade mark in the register**

As proprietor of a registered trade mark you may any time renounce the trade mark in full or in respect of some of the goods/services (Sec. 48 Trade Mark Law).

Furthermore, the registered trade mark may be revoked upon request by any person on the grounds prescribed in Sec. 49, 53 Trade Mark Law or declared invalid due to absolute grounds for refusal (Sec. 50, 54 Trade Mark Law). In addition, the registration may be cancelled after the conclusion of cancellation proceedings before the civil courts due to revocation of the trade mark or due to existing earlier rights (Sections 49, 51, 55 Trade Mark Law).

### **How long is the period of protection of the trade mark?**

The period of protection of a registered trade mark shall begin on the date of filing the application (Sec. 33 (1) Trade Mark Law) and shall end ten years after the last day of the month containing the date of filing (Sec. 47(1) Trade Mark Law).

The period of protection may be renewed for additional periods of ten years (Sec. 47(2) Trade Mark Law).

For the renewal of the registered trade mark, the renewal fee must be paid, and if the renewal is applicable for goods and services falling into more than three classes, then the class fees must also be paid. The fees for the following term of protection fall due on the last day of the month in which the term of protection of the mark ends (Sec. 3 (2) Patent Costs Law). They may be paid in advance no more than one year before the due date. They must be paid until the expiry of the second month after the due date. After that date the registered trade mark can only be renewed if the fees and a surcharge for late payment are paid before the expiry of a period of 6 months after the due date (Sec. 7 (1) Patent Costs Law).

In order to save costs the proprietor of a trade mark is strongly advised to pay the renewal fees in time without surcharge or to declare the surrender of the trade mark (in full or in part) (Sec. 48 (1) Trade Mark Law), if he or she does not intend to renew the period of protection.

### **Note**

The application may be withdrawn at any time during the procedure before the German Patent and Trade Mark Office. It is also possible to limit the list of goods/services or declare the division of the filed or registered trade mark.

Further details on trade mark applications by **fax** and **foreign language applications** see Sec. 11 Ordinance Concerning the German Patent and Trade Mark Office and Sec. 15 Trade Mark Ordinance.

The application **form** for the registration of a trade mark ([W 7005](#) - in German only) is available at the German Patent and Trade Mark Office. The application form and other forms and factsheets can be obtained from the DPMA website at: <http://www.dpma.de>.

If you have any further questions please contact:

the **Information Service of the German Patent and Trade Mark Office in Munich:**

Tel.: (+49 89) 21 95 - 34 02

the **Information Service of the Technical Information Centre of the German Patent and Trade Mark Office in Berlin:**

(+49 30) 25 992 - 220

the **Information Service of the Jena Sub-Office of the German Patent and Trade Mark Office:**

Tel.: (+49 3641) 40 - 54