



German Patent
and Trade Mark Office



Trade Marks

An information brochure on trade mark protection

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We protect your trade mark

The German Patent and Trade Mark Office (DPMA) is the national centre of excellence for industrial property protection in Germany. We are your service provider for trade mark protection – from the application to the registration of your trade mark to the administration of your trade mark after registration in our Register.

This brochure gives you a thorough insight into all issues that may be important to you in connection with the trade mark right and serves as a guide for your trade mark application.



Trade marks send out strong signals

They influence our purchasing decisions daily: trade marks give fresh impetus, trigger emotions, occupy market positions. Trade marks create distinctive features that allow to distinguish branded goods and services of an enterprise from the products offered by competitors. Trade marks are advertising tools that provide useful orientation in the endless stream of advertising messages through words and pictures, shapes and sounds.

It is the trade mark that turns an anonymous product into a unique branded article – and sometimes, a few letters or a sign even become a legend.

The German trade mark law revision

For more than 30 years it has been possible to use a protected sign to market services as well as goods. In the course of the 1995 German trade mark law revision, the term “Marke” (trade mark) was introduced. In its literal meaning a trade mark “marks” a product or a service, thus distinguishing it from the products offered by competitors.

Trade marks create trust

Every trade mark carries a promise of reliability of source and consistency of quality of a product, service or an enterprise.

Trade marks stand for special properties. They appeal to the needs of consumers, convey values and communicate ideas, thus creating credible identities that build trust and lasting customer relationships. This way they ensure the competitive edge of a company.

A strong trade mark converts every single communication measure into an investment that will generate lasting or even increasing market value. This opens long-term perspectives.

Trade marks protect ideas

“Any signs, particularly words, including personal names, designs, letters, numerals, sound marks, three-dimensional configurations, including the shape of goods or their wrapping as well as other packaging, including colours and combinations of colours, which are capable of distinguishing the goods or services of one undertaking from those of other undertakings may be protected as trade marks.” (Sec. 3(1) Trade Mark Act [*Markengesetz*]).

What types of trade marks are there?

In addition to word marks and figurative marks, which are the most frequent trade mark types, there are also combined word/figurative marks, sound marks, smell marks, slogans and three-dimensional marks. Combinations of different trade mark types are also conceivable, for example, three-dimensional signs with word or image.

Today, trade marks are omnipresent. They can stand for a single product (for example, Mars, file number: 604 636), for an entire product line (for example, Nivea, file number: 82 840) or for an enterprise (for example, E.ON, file number: 300 20 593). Within the meaning of trade mark law, trade marks distinguish only specific goods and services. For more detailed information see pages 9 to 11.

Domain names as trade marks?

As a rule, Internet domains can be registered as trade marks. The DPMA does not register domain names but recommends a trade mark search prior to choosing a domain name. Some domain names do not meet the requirements for registration in the Trade Mark Register. The registered domain can only be registered as a trade mark if the second level domain and/or the sub-domains, if any, satisfy the requirements for protection, in particular, if they are not merely descriptive terms or advertising statements.

And safeguard assets

In modern, ever faster changing markets, trade marks provide important orientation and decision-making confidence to customers and consumers. They reduce purchasing risks and enable identification with the products or services offered by a company. That is precisely why they are of inestimable value for the long-term success of a company. Strong trade marks help to build durable relationships between suppliers and customers.

Trade marks are assets

Today, the success of a company is closely linked to the prestige and value of its trade mark(s). In this context, important criteria are brand awareness, the trade mark image and market shares. For that reason, trade marks should not only be considered as a cost factor but also as important influencing factors that can increase the total value of a company.



Trade marks confer rights

Trade mark protection usually arises from the entry of the sign in the Register kept by the DPMA. It gives you the right to prohibit others from using an identical or confusingly similar sign in trade as a mark.

Entry of the trade mark in the Trade Mark Register makes it easier for you to enforce your legal claims to the trade mark. The registration certificate and the register extract are proof that you are entitled to the registered trade mark. The trade mark registration gives you a means to act against any unauthorised person who infringes your rights.

In case of wilful or negligent infringement of your trade mark rights, you can seek injunctive relief or may be entitled to damages. Unlawfully marked objects may also be seized and destroyed by customs authorities when the unlawfully marked goods are imported or exported.

Who can be the owner of a trade mark?

As a rule, any company or any private individual can apply for a trade mark for any type of goods or services. A business establishment is not necessary.

In business life, you may choose to use the ® symbol with registered trade marks. This indicates to others that the sign is a registered, protected trade mark.

The road to trade mark protection

Far more than 780,000 trade marks are registered in the Register of the DPMA – and new trade marks are being added daily. What signs are eligible for protection and what signs are not? What must be considered when filing an application? Our brochure aims at providing a quick overview of what is important with regard to registration and what rights your trade mark gives to you. Please bear in mind that trade mark law and practice are complex issues that require great care. This is true for the advance trade mark search, which is your responsibility, and also for the examination of the application and the registration performed by our experts.

We wish you success with your application.



No trade mark protection without classification: the list of goods and services

There is no across-the-board registration for trade marks. Rather, you must specify those goods and services for which you seek trade mark protection (list of goods and services). 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 (Nice Classification).

Therefore, the list of goods and services is an important component of the trade mark application; without such a list the application is incomplete.

A correct list of goods and services ensures fast processing of your application. Errors in drafting the list of goods and services are by far the most frequent cause for longer processing times for trade mark applications. In such cases, we clarify questions regarding the list with you. In order to avoid this extra work and be able to register trade marks faster in the interest of our customers, we offer a variety of tools that help customers to draw up lists of goods and services.

For online applications, you can select admissible goods and services terms by means of a shopping basket in the application.

You will also find a great number of terms, which are definite enough in all respects to refer to goods and services, in our search engine for goods and services. Please use it if you apply for a trade mark using the paper application form. If these terms are used, we can register the trade marks immediately – if there are no legal grounds for refusal.

Large applicants can draw up lists of goods and services in cooperation with our staff before filing. These “approved” lists can be adopted as they stand for further applications.



www.dpma.de/english/trade_marks/index.html

www.dpma.de/english/trade_marks/classification/goods_and_services/nice_classification

What has to be taken into account when classifying products:

- The scope of protection of a trade mark is determined by the goods and services for which it is protected.
- 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.
- Each additional class of goods and services that you claim increases the probability that owners of earlier trade marks will file oppositions to the registration of your trade mark.
- Furthermore, the Trade Mark Act prescribes the “compulsory use” of all goods and services claimed. This means that you must actually put to use the trade mark in trade in connection with all the goods and services claimed in order to fully and permanently maintain your right to the trade mark.

For detailed information see the following pages under the catchwords “application”, “compulsory use” and “opposition proceedings”.

www.dpma.de/english

<https://www.tmdn.org/network/home>

<http://www.euipo.europa.eu/ec2/?jsessionid=4F93F8A312F-196F56667A44E108DCA5D.ec-2t1?lang=en>

www.dpma.de/english/trade_marks

Nice Classification and Vienna Classification

All standardised and admissible terms that can be used for the list of goods and services of an application are contained in the 45 classes (34 for goods and eleven for services) of the “International Classification of Goods and Services for the Purposes of the Registration of Marks” – or Nice Classification for short.

However, the international classification for the figurative elements or images of marks is called “Vienna Classification”.

Harmonised classification database

Many national trade mark offices of the European Union have agreed on a list of approximately 60,000 classification terms, which are available in 28 languages and admissible in the participating countries. This database (TMclass) is more comprehensive than the list of the Nice Classification but uses the same taxonomy. It is available to you for online trade mark applications by means of a shopping basket. For more detailed information, visit our website.

Classes of the Nice Classification

| Class | Brief description |
|-------|--|
| 1 | Chemicals |
| 2 | Paints |
| 3 | Cleaning preparations |
| 4 | Oils, greases, fuels |
| 5 | Pharmaceuticals |
| 6 | Common metals and simple goods of metal |
| 7 | Machines, motors and engines |
| 8 | Hand tools |
| 9 | Electrical apparatus and instruments |
| 10 | Medical apparatus and instruments |
| 11 | Apparatus for heating, ventilating and sanitary purposes |
| 12 | Vehicles |
| 13 | Weapons |
| 14 | Jewellery, clocks and watches |
| 15 | Musical instruments |
| 16 | Office requisites, stationery |
| 17 | Insulating materials, semi-finished goods |
| 18 | Goods made of leather |
| 19 | Building materials (non-metallic) |
| 20 | Furniture |
| 21 | Small manually operated utensils |
| 22 | Ropes, string, sails |
| 23 | Yarns und threads |
| 24 | Woven textiles and covers |
| 25 | Clothing, footwear |
| 26 | Haberdashery and trimmings |
| 27 | Carpets, rugs, and wall hangings |
| 28 | Games, sporting articles |
| 29 | Food of animal origin |
| 30 | Food of plant origin |
| 31 | Agricultural and forestry products |
| 32 | Non-alcoholic drinks, also beers |
| 33 | Alcoholic drinks |
| 34 | Tobacco, smokers' articles |
| 35 | Advertising, business management |
| 36 | Insurances |
| 37 | Building construction, repair services |
| 38 | Telecommunications |
| 39 | Transport |
| 40 | Treatment of materials |
| 41 | Education, training, sporting / cultural activities |
| 42 | Scientific and technological services |
| 43 | Providing food and drink, temporary accommodation |
| 44 | Medical services |
| 45 | Legal services, security services |



The first step is the search. The Trade Mark Register

www.dpma.de/english/search/dpmaregister

We publish all trade marks applied for, registered and refused in Germany online in **DPMAregister**. For this reason, those interested in applying for the registration of a new trade mark should first conduct a search in the official Trade Mark Register. That way you can check in a first step whether your intended trade mark will infringe earlier national rights.

What should be considered when conducting a search?

Make sure that there is no trade mark in a similar or identical form. For further information on the search see pages 27 to 28.

Have you completed your trade mark search?

Then you should not wait much longer. An early application may have essential advantages from a legal point of view because trade mark law is governed by the principle of priority. That means that the trade mark with the earlier filing date usually has better chances to prevail in the case of conflict.

Trade mark search – not only for applicants

A trade mark search is not only useful before filing an application. Trade mark owners should also conduct searches after registration at regular intervals to protect their trade mark and, if necessary, to defend it effectively.



Your application

The first step to use the legal options of trade mark protection is a formally correct, complete and early application.

The applicant can be a natural person, a legal person or a partnership with legal capacity.

You must file a separate application for each trade mark.

Important:

- In any case your application must contain a representation (illustration) of the trade mark. The illustration must show the trade mark exactly as you wish to have it protected in the future.
- Indicate the type of trade mark (word mark, figurative mark, sound mark, et cetera).
- Indicate exactly the goods and services for which you intend to use the trade mark you are applying for. The number of requested classes determines the amount of the fee payable for the application.

For detailed information on this issue see the leaflet “Information for Trade Mark Applicants” available online.

www.dpma.de/english/trade_marks/application

Tip

If you draft your list of goods and services in accordance with the Nice Classification – sorted by classes and in ascending order – you will help to speed up the examination of the application (see also page 9).

Goods and services that are not available in the classification database may still be claimed with an electronically signed electronic application (DPMAdirekt) or with a trade mark application on paper (see page 14). However, we are able to process your application faster if you select terms from the database.

www.dpma.de/english/trade_marks/application

www.dpma.de/english/services/efiling/dpmadirektweb

www.dpma.de/english/services/efiling/dpmadirekt/downloads

Ways to apply

Written applications

If you choose to file a written application, please use the application form provided by the DPMA and file it with our office or a patent information centre authorised to accept trade mark applications. The application form can be downloaded any time from the Internet.

Online

If you choose the online option, you can file your application

- without an electronic signature and without a signature card over the Internet via our **DPMAdirekt Web** service with the shopping basket for goods and services. This requires no special software. You will be guided through the application process in seven steps.

- with a qualified electronic signature via our **DPMAdirekt** service. A list of suppliers of signature cards is available from the *Bundesnetzagentur* (Federal Network Agency for Electricity, Gas, Telecommunications, Post and Railway).

The online services smart card of the European Patent Office is also admissible.

Furthermore, you need the **DPMAdirekt** application software to prepare and validate application documents. You can download the **DPMAdirekt** software free of charge and find more information on our website.

Please note that it is not possible to apply for a trade mark by just sending an ordinary e-mail.



What happens after filing?

You receive a receipt with the official file number. The essential application data are entered into our in-house information system and will appear in the **DPMAREGISTER** online register, which is available to the public on our website.

www.dpma.de/english/search/dpmaregister

The filing date – what role does it play?

As mentioned in the section dealing with trade mark search (see page 12) the principle of priority applies in trade mark law. As a rule, the earlier trade mark – that means the trade mark with the earlier filing date – has better chances to succeed in case of conflict.

Check list for a successful trade mark application:

- Have you been creative when designing the trade mark? Avoid descriptive or deceptive terms, or terms that are often used in advertising.
- Make sure that there is no other trade mark similar or identical to your trade mark. Search for existing rights of third parties before filing an application.
- Make sure you used and completely filled out our official application form.
- Is the trade mark represented correctly?
- Does the list of goods and services correspond to the Nice Classification? Use the search engine on our website to check.

You can download application forms and find comprehensive information on the DPMA and on the formalities of an IP application on the Internet.

www.dpma.de/english

Our enquiry units also provide information on the filing routes, procedures and requirements. For contact details see the service section of this brochure on page 38.

Registration requirements

The DPMA performs an absolute grounds examination of your trade mark application. However, we do not examine whether your trade mark conflicts with the IP rights of others.

What exactly are absolute grounds for refusal?

Your trade mark can only be registered if there are no absolute grounds for refusal. These are, for example,

- lack of distinctiveness,
- descriptive terms that should be kept freely available for general use,
- obvious likelihood of confusion,
- offence against morality or public policy,
- emblem of state included in a trade mark.

Examples:

➤ general catchwords:

“for manpower services”, “super, extra, brilliant” – for various goods or services

➤ deceptive terms:

“Alsterwasser” for whisky

➤ morally offensive terms:

“Urbi et Orbi” for goods or services

➤ national emblems:

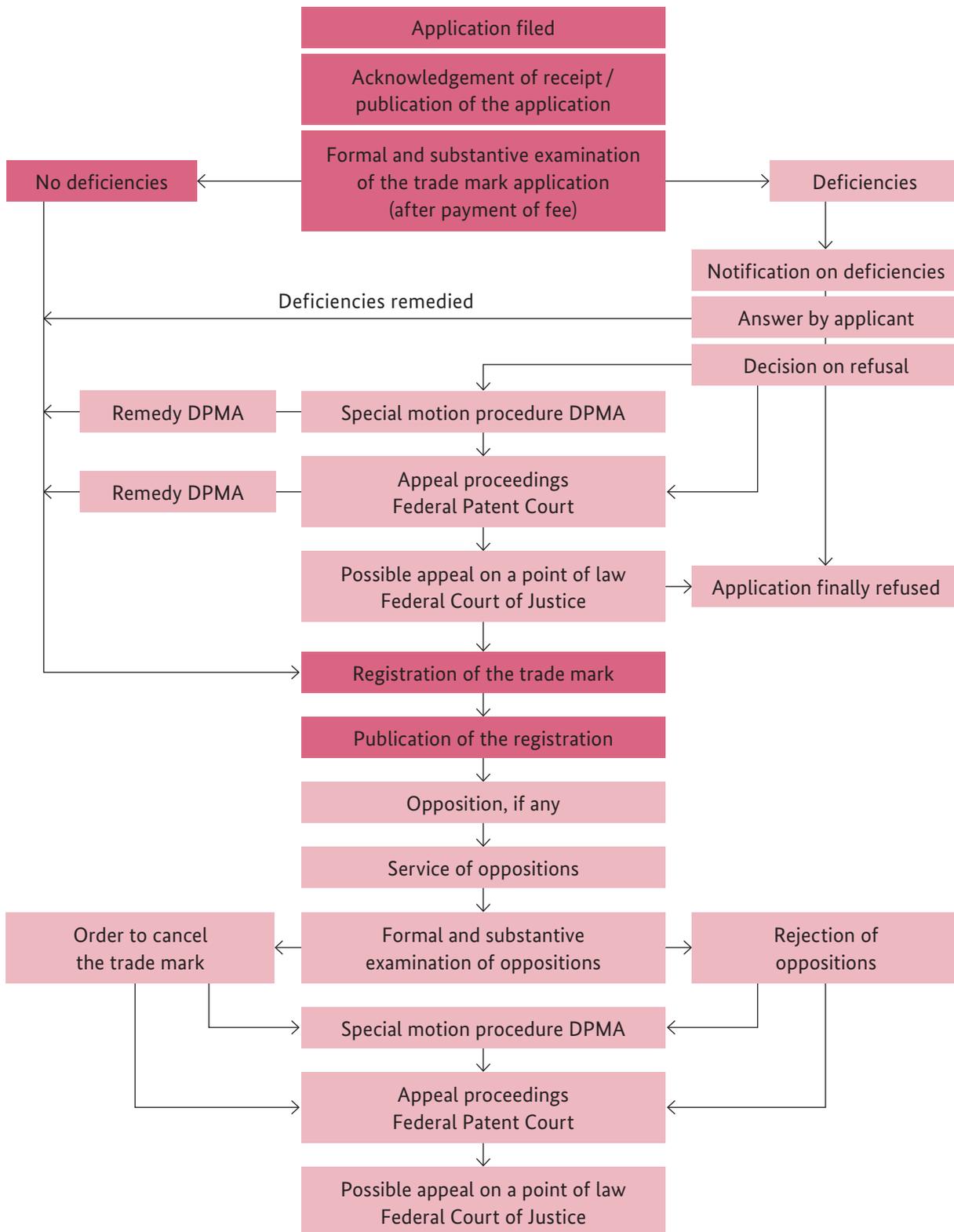
national flags, symbol of Europe (circle of stars)

As a rule, any sign capable of being represented graphically can be protected if it is capable of distinguishing your products or services from those offered by competitors, with the exception of signs that must be kept available for general use. The latter applies to such terms in particular that simply describe the type, quality or other properties and characteristics of the products claimed. For example, the word “Apple” is distinctive for computers but not for apples because as a descriptive indication it must be kept freely available for unrestricted use by competitors. The following are also excluded from registration: promotional statements, general advertising slogans and word sequences that have become customary in the current language as fixed expression.

Descriptions can be registered in exceptional cases if the sign, as a result of its use, has established itself as a trade mark in the entire territory of the Federal Republic of Germany for the goods and services claimed. That means that the sign can be identified by the targeted trade circles as coming from the applicant. In that case, it must be proved by appropriate documents and also a survey, if required, that the great majority of the trade circles associate the trade mark with a specific enterprise.

Registration process and costs

Examination procedure (schematic)



The registration procedure

After receiving the fees, which must be paid within three months after filing the application, the DPMA examines whether the application meets the formal requirements and whether there are absolute grounds for refusal of registration of the trade mark. If the fees are not paid in due time, the application is deemed withdrawn.

Overview of fees for application with registration

| | |
|---|------------------|
| Application fee (including class fee for up to three classes) | 300 euros |
| Application fee for online filing (including class fee for up to three classes) | 290 euros |
| Class fee upon filing the application (for each additional class from the fourth class) | 100 euros |
| Accelerated examination of the application | 200 euros |

www.dpma.de/english/trade_marks/examination_registration_and_renewal

If all the requirements are met, the trade mark is registered. You receive a certificate of registration and the corresponding extract from the Register. The registration of the trade mark is published in the official electronic Trade Mark Journal (*Markenblatt*). At special request and subject to payment of an additional fee, we can speed up processing of the application.

Trade mark without registration?

Under particular conditions, trade mark protection may also accrue without registration – either by long-term, intensive use in trade or if the trade mark has a very extraordinary reputation (a so-called “well-known mark”).

If grounds for refusal are identified during the examination of your application, you will be notified in writing about the deficiencies. Your answer will be examined. If it does not overcome all deficiencies stated in the notification, a decision will be taken to refuse the application (or possibly, part of the application). You have the opportunity to have this decision reviewed during special motion (*Erinnerung*) or appeal proceedings, for which a fee is charged.

Tip

If there is a change of name or address, a transfer of the seat of your company or a change of representative, arrange for an update of your entry in the Trade Mark Register.

Effect of protection and duration of protection

You obtain trade mark protection in the whole territory of the Federal Republic of Germany by registration of your trade mark in the German Trade Mark Register.

Ten years of protection – indefinite renewal

The duration of protection starts on the application date and ends after ten years, on the last day of the month of the application date.



In contrast to other IP rights, trade mark protection can be renewed for further periods of ten years, indefinitely, subject to the payment of the appropriate fees. You may renew the trade mark only in relation to some of the goods and services, and if you decide to abandon those classes which you no longer need, you might save on renewal fees.

The form for the renewal of a trade mark (extension of the duration of protection) and for changing the scope of protection can be downloaded from our website.

www.dpma.de/english/services/forms/trade_marks

Overview of renewal fees

| | |
|---|------------------|
| Renewal fee (including class fee for up to three classes) | 750 euros |
| Class fee upon renewal (for each additional class from the fourth class) | 260 euros |

If the trade mark owner does not extend the duration of protection in due time or does not pay the full amount of the renewal fees, the trade mark will lapse.

Compulsory use and defence

Even after your trade mark has been registered, you have to take into account some legal aspects to maintain lasting protection for your trade mark.

Registered trade marks must be put to use

The Trade Mark Act prescribes the so-called “compulsory use” of the trade mark for all claimed goods and services. This means that you must use your trade mark in trade for all claimed goods and services to maintain the right to the trade mark. If the trade mark is not used within a continuous period of more than five years, there is a danger of cancellation of the trade mark upon request by a third party. More information is available on page 26.

What trade mark owners should consider:

Applications for new trade marks received at the DPMA amount to approximately 60,000 each year. Consequently, the probability increases that newly registered trade marks will violate your IP right. Therefore, many trade mark owners actively monitor their trade marks and permanently observe the relevant trade mark registers with regard to possible conflicting trade marks. If necessary, seek the help of an expert, for example, a lawyer or a patent attorney to defend your trade mark.

In such cases, you as owner of the earlier trade mark can file a notice of opposition against the registration of a later trade mark.



If trade marks become generic terms

Over the years, successful trade marks may become generic terms – under certain conditions, trade marks, such as, for example, “Tesa” (adhesive tape), “Fön” (hairdryer), “Tempo” (paper tissues) and “Walkman” run the risk of becoming synonyms for the products. In those cases, the trade mark is in danger of being cancelled because it is used as a descriptive synonym and loses distinctiveness. For this reason, the owners of successful trade marks make the effort to indicate in the relevant publications (dictionaries, et cetera) that the relevant word constitutes a registered trade mark.

Opposition proceedings

Basically, the registration of your trade mark is a registered right which may be cancelled in certain cases. If your newly registered trade mark is identical or similar to other earlier applications or trade marks, the owners of those signs may lodge a notice of opposition against your trade mark. This also applies in the reverse case, of course: if your trade mark right is infringed by a newly registered trade mark, you can file a notice of opposition against it. If the opposition is successful, the trade mark will be cancelled in full or for some of the goods and/or services.

Opposition

Please take into consideration that a trade mark right does not only derive from registration (see page 18). This is why owners of unregistered trade marks can also lodge a notice of opposition against the registration of a trade mark.

Simple and cost-effective – opposition proceedings

A written notice of opposition must be filed within three months after the publication of the newly registered trade mark. Within this period of time, the opposition fee of 120 euros must be paid. It is not possible to extend this period. The opposition form can be downloaded from the Internet.

www.dpma.de/english/services/forms/trade_marks

During opposition proceedings, it is examined whether there is a likelihood of confusion between the trade marks. This assessment does not only take into account the similarity of the signs but also clarifies whether conflicting products and/or services are similar. Our trade mark examiners decide on the opposition (by decision). It is possible to have this decision reviewed. In case there is a likelihood of confusion, the registration of the later trade mark will be cancelled (possibly, in part).

When the parties reach an agreement

Part of opposition proceedings can be settled if the parties themselves reach an agreement. As owner of the later trade mark, for example, you can limit your list of goods/services or undertake to use your trade mark only for certain products or only in a certain form, while the owners of the earlier trade marks, in return, withdraw their opposition.

During opposition proceedings, under certain conditions, you can contest that the earlier trade mark was actually put to use by the opponent. Then, the owner of the conflicting trade mark must substantiate by *prima facie* evidence that they have put the trade mark to genuine use during the last five years. If they cannot provide sufficient proof, the opposition will be rejected on that basis alone.

In certain cases, the trade mark registration can still be cancelled after the conclusion of opposition proceedings (see page 26).

Keep an eye on the market.

It is important to keep informed on a regular basis about published applications and newly registered trade marks and to immediately act against detected copying or against misuse by later trade marks.



Transfer, licensing and giving as security

Trade marks can be bought and sold

During the entire duration of protection you can any time transfer your trade mark in full or in part to another person. This transfer of rights will be recorded in the Register, if you or the acquirer file a corresponding request for recording a transfer of ownership in the Register at the DPMA and submit documents (for example, a contract) showing that the trade mark right has been transferred.

You can also let others use your trade mark by granting a licence.

The right conferred by the trade mark registration may be given as security. Upon a corresponding request, which may be filed by you 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.

Collective marks

If several enterprises producing the same goods or rendering the same services want to use the same name for their products, they can also obtain trade mark protection as an association by applying for a collective mark (for example, *RAL-Gütezeichen*, *Bioland*).



Trade mark protection abroad

There are several options to extend trade mark protection to other countries: to countries of your choice, the whole of the European Union (EU) or beyond.

Trade mark protection in countries of your choice

You can directly file your trade mark application in the countries where you seek protection and claim the priority of a previous German application. It is by all means recommended that you consult a lawyer or a patent attorney qualified to practise in the respective country.

Trade mark protection in the European Union

If you intend to uniformly mark your products in the whole of the EU, you can request registration of a “European Union trade mark”, valid across the entire EU, by using a single registration procedure available at the European Union Intellectual Property Office (EUIPO) in Alicante (Spain).

Please note that not only any owner of an earlier European Union trade mark but also any owner of a national trade mark from those countries has the right to file a notice of opposition. If the opponent is successful, registration of your trade mark will be refused for the whole of the EU. Applications for European Union trade marks may be filed directly at the EUIPO or at the DPMA.

<https://euipo.europa.eu/ohimportal/en>

EUIPO – the organisation for European trade mark protection

The European Union Intellectual Property Office is located in Alicante, Spain. EUIPO is an agency of the EU in charge of the registration of trade marks and designs, valid in all countries of the EU.

International trade mark protection

If you want to extend trade mark protection even further, you can register your national trade mark at the World Intellectual Property Organization (WIPO) which is in charge of this international registration procedure.

Under certain conditions you may claim the priority of your national basic mark. You can obtain trade mark protection in almost 90 countries including not only the European countries but also countries of the Americas, Asia and Africa. In the countries designated by you the international mark will be treated just like a national trade mark application.

Your request for international registration may be filed directly at the DPMA. The request forms are available on the Internet.

www.wipo.int/madrid/en/forms

WIPO – the organisation for international trade mark protection

The World Intellectual Property Organization is located in Geneva, Switzerland. WIPO is a specialised agency of the United Nations (UN) responsible for the administration of international patent, trade mark and design applications.

www.wipo.int



Cancellation proceedings

As owner of a trade mark you can any time surrender your trade mark or request to have it cancelled in the Register. However, your trade mark can also be cancelled *ex officio* or upon request by others.

If cancellation proceedings are initiated in which your trade mark is challenged, the DPMA will notify you accordingly. If you oppose the request for cancellation in due time, the cancellation request will be examined. If you fail to oppose the request in time, your trade mark will be cancelled without substantive examination.

→ Cancellation at your own request

As trade mark owner you can any time surrender your trade mark or individual goods/services, for example, because you do no longer wish to use the trade mark or want to avoid that your trade mark conflicts with earlier trade marks.

→ Cancellation *ex officio*

A trade mark is cancelled *ex officio* if the required renewal fees have not been paid in time or if there are certain grounds for refusal (for example, violation of emblems of state, deception).

→ Cancellation upon request by a third party

Others may also file a request for the cancellation of your trade mark and can base this request on grounds for refusal (lack of distinctiveness, misleading or descriptive indications, bad faith, et cetera) or on non-use of the trade mark (cancellation on grounds for revocation).

→ Cancellation on grounds for revocation

A trade mark registration may be cancelled on grounds for revocation upon request by a third party if the trade mark has not been put to use during an uninterrupted period of five years.



Service

Trade mark search

A thorough advance trade mark search will create the best conditions for a successful trade mark. The DPMA will help you right from the start. We give you important information and valuable advice on your trade mark search and provide best possible access to the official Trade Mark Journal. All important trade mark terms are explained in detail in the glossary (page 29). Should you have any questions, our staff will be pleased to help you.

Tips for the trade mark search

The DPMA does not examine whether there are any identical or similar trade marks before registering your trade mark. It is your own responsibility to carry out a similarity and identity search. This will significantly raise your chances of obtaining a registered trade mark right that will last.

We recommend that you conduct searches not only in the databases of German national trade marks but also of European Union trade marks and international registrations. The databases indicated here are particularly useful for this purpose. Independently of each other, each register contains trade marks which are protected in Germany. Furthermore, names and logos, used in trade, may infringe other trade mark rights even if they were not entered in a trade mark register.

For this reason, you should also look for identical or similar names in Internet search engines, telephone directories, commercial registers, publications on titles of works and/or business directories or other product directories.

More detailed search information is available in our information leaflet "Trade Mark Searches – Online". You can order a free copy directly from the DPMA or download it from our website.

More information on trade mark searches is available on our website.

DPMAregister

Here you will find German national trade mark applications and German national trade marks that were registered, cancelled, withdrawn or refused.

www.dpma.de/english/search/dpmaregister

eSearch plus

In eSearch you will find European Union trade mark applications and registered, deleted, withdrawn or refused European Union trade marks, which are relevant for the EU and consequently also for Germany.

<https://euipo.europa.eu/eSearch/>

Madrid Monitor

In MADRID MONITOR you will find international applications and international registrations of marks.

www.wipo.int/madrid/monitor/en/index.jsp

www.dpma.de/english/trade_marks/trade_mark_search

Telephone enquiries

You can contact the central customer care and services of the DPMA to gain detailed information on the filing routes, procedures and application requirements. We are also pleased to send you forms and information brochures. The central customer care and services can be contacted via the phone number +49 89 2195-1000.

The central customer care and services is not authorised to give legal advice. Under the Act on Legal Counselling (*Rechtsdienstleistungsgesetz*), only patent attorneys and lawyers may provide legal advice.

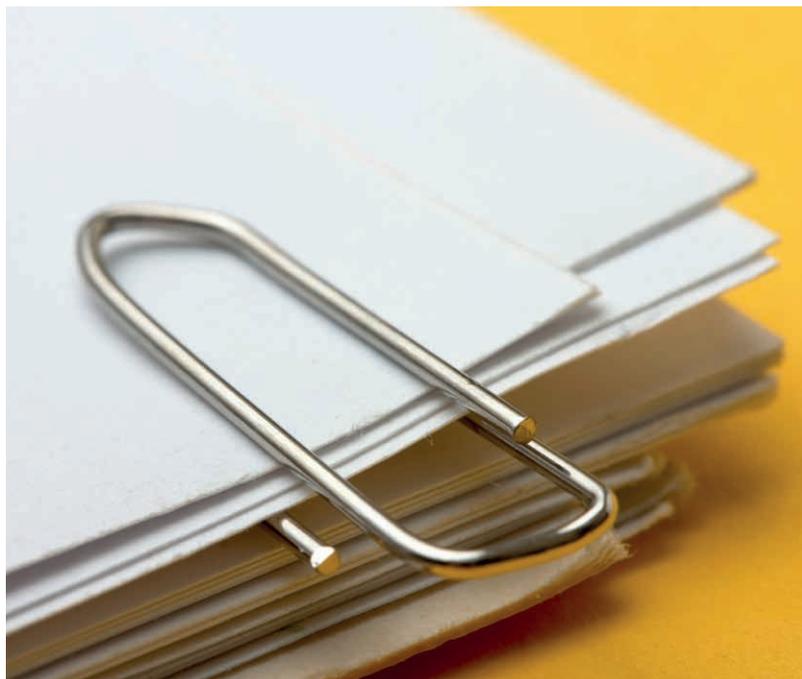
Assistance with trade mark searches

Searches for identical trade marks and complex similarity searches are also offered by patent attorneys, lawyers specialising in trade mark law, specialist IP lawyers, search agents and the patent information centres. They can also provide access to commercial trade mark databases to you.

Patent attorneys, lawyers specialising in trade mark law and specialist IP lawyers will help you to interpret the search results and answer your questions about likelihood of confusion.

[www.dpma.de/english/services/
customer_care_services](http://www.dpma.de/english/services/customer_care_services)

For address directories and links please contact our central customer care and services or go to our website.



Glossary

Under certain conditions, an appeal on a point of law from a decision of the Federal Patent Court can be brought to the Federal Court of Justice.

Appeal on a point of law before the Federal Court of Justice

If an examiner of the DPMA takes a decision to refuse registration of a trade mark, the applicant can appeal against the decision to the Federal Patent Court within one month after service of the decision on refusal (see also “Special motion proceedings”).

Appeal proceedings before the Federal Patent Court

The applicant is the person who applies for trade mark protection (the future trade mark owner). An applicant may be any natural or legal person or, under certain circumstances, a partnership.

Applicant

The date on which the DPMA receives the complete request for trade mark protection (trade mark application) is called “filing date” or “application date”. Normally, this filing date determines the priority of the application, that means it is essential for determining whether a conflicting trade mark has been filed earlier or later (see “Priority principle”).

Application date

see “Grounds for refusal”

Bar to registration

Trade marks can be cancelled on grounds for invalidity or revocation – or because the trade mark owner has surrendered the trade mark.

Cancellation

Combined word/figurative marks consist of a combination of word elements and graphical elements, or of words in lettering styles.

Combined word/figurative mark

If a sign is not capable of being protected, a decision will be taken to refuse registration of the trade mark (see “Grounds for refusal”).

Decision on refusal

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| Decision to reject application | see “Decision on refusal” |
| Emblem of state | State emblems are flags, banners, armorial bearings, badges and official seals symbolising sovereignty (for example, the federal eagle, the German flag, the police star badge). A sign cannot be protected if it includes, copies or misuses a state emblem. |
| European Union Intellectual Property Office (EUIPO) | The European Union Intellectual Property Office (EUIPO) is an official agency of the EU in charge of the registration of trade marks and designs that are valid in all countries of the EU. The EUIPO is located in Alicante (Spain). |
| European Union trade mark | By registering a trade mark at the European Union Intellectual Property Office (EUIPO), located in Alicante (Spain), the trade mark owner obtains protection in all countries of the European Union (EU, formerly, European Community). |
| Figurative mark | Figurative marks are pictures, graphical elements or images (without words or word elements). |
| Filing date | see “Application date” |
| Generic term | Successful trade marks run the risk of becoming synonyms for a whole category of products or services, for example <i>Tempo</i> for paper tissues or <i>Fön</i> for hairdryers. |
| German Patent and Trade Mark Office (DPMA) | The German Patent and Trade Mark Office is the national centre of expertise for industrial property in Germany. The staff of the office grant patents, register and manage trade marks, utility models and designs. They also provide information on industrial property rights to the public. |
| Grounds for refusal | A trade mark is only eligible for protection if no absolute or relative grounds for refusal apply. While absolute grounds for refusal (non-registrability as a trade mark, lack of distinctiveness, the need to keep a term freely available for use by others, public interest) are examined |

by the DPMA before entering the trade mark in the Register, relative grounds objections (prior IP rights of others, non-use) can only be raised in opposition proceedings.

Indications of geographical origin of agricultural products and food stuffs are product names that invoke a direct association with a geographical location (for example, *Nürnberger Bratwürste*) or are closely linked to a geographical region (for example, *Spreewälder Gurken*).

Trade marks registered in the international register of the World Intellectual Property Organization (see “World Intellectual Property Organization (WIPO)”).

see “Trade mark licence”

There is a likelihood of confusion for trade marks if the public is under the impression that the goods or services bearing the later trade mark come from the company of the owner of the earlier trade mark.

Trade marks identify products and services. Therefore, when applying for trade mark registration, the goods and services should be exactly indicated in a list of goods and services so that they can be clearly attributed to the appropriate classes of goods and services. This will help to clearly delimit the scope of protection of a trade mark in case of a later dispute.

Nice Classification is short for “International Classification of Goods and Services for the Purposes of the Registration of Marks”. The name derives from the agreement concluded at the diplomatic conference of Nice on 15 June 1957, stipulating the establishment of the classification. Its 45 classes (34 for goods and eleven for services) contain all standardised and admissible terms necessary for the list of goods and services of an application. The classes of goods are roughly divided into product groups and material groups; the classes of services are divided into branches of activities.

Indications of geographical origin

International registrations

Licence/licensing

Likelihood of confusion

List of goods and services

Nice Classification

| | |
|---|--|
| Non-use | If the trade mark is not put to actual use within a period of five years from the date of registration in the Register, it may be cancelled. This compulsory use means that the trade mark must be put to genuine use in Germany by the trade mark owners for identifying their goods and services in trade. |
| Notification on deficiencies | If the application contains formal deficiencies, the applicant will be notified in detail about the deficiencies identified and invited to remedy them. If the trade mark is not regarded as being capable of protection, the applicant will be sent a notification on deficiencies explaining the grounds for refusal before the trade mark is refused registration. |
| Special motion proceedings (Erinnerung) DPMA | The applicant may file a special motion against the decision to refuse registration of the trade mark. A second examiner (special motion examiner) will review the decision (see also “Appeal proceedings”). |
| Official (online) Trade Mark Journal | All new trade mark registrations and changes regarding existing trade mark registrations are published electronically in the Trade Mark Journal (<i>Markenblatt</i>). Individual issues of the Trade Mark Journal are available from the www.dpma.de/english/search/dpma-register online service at www.dpma.de/english for download. |
| Opposition | Within a period of three months after the day of publication of the trade mark registration, the owner of an earlier trade mark right or of a company name may give notice of opposition to the registration of the trade mark, if they think that their rights are being infringed. |
| Opposition proceedings | During opposition proceedings the DPMA examines whether two conflicting signs are likely to be confused with regard to their names and the respective goods and services protected. If this is found to be the case, the new trade mark registration can be fully or partly cancelled from the Trade Mark Register. |
| Priority principle | In case of conflicting trade mark rights, the earlier trade mark takes priority. This means that the trade mark owner who was the first to obtain protection for that trade mark may exclude others from claiming or using the same or a similar sign. |

All new trade mark registrations and changes regarding registered trade marks are published online in the Trade Mark Journal.

Publication

see “Trade Mark Register”

Register

After the examiner has examined the trade mark application and has not found any formal deficiencies or grounds for refusal, the trade mark will be registered in the national Trade Mark Register. The registration date is not identical with the filing date nor with the publication date of the trade mark.

Registration

The DPMA will send the owner of the trade mark a certificate of the registration of the trade mark in the Trade Mark Register.

Registration certificate

After expiry of the ten-year duration of protection, the trade mark can be renewed every ten years for a further ten years by payment of a renewal fee (750 euros for three classes, 260 euros for every additional class).

Renewal

A trade mark may be cancelled from the Register on grounds for revocation, for example, if it is not put to use, has become a generic term or is used in a misleading way.

Revocation

The trade mark owner has an exclusive right to the trade mark. A licensing contract may permit the use of the sign by another person.

Right of use

There are several options to challenge a decision or unfavourable legal status in order to have it changed or set aside. The following options are available in trade mark application procedures and opposition proceedings: special motion proceedings at the DPMA, appeal proceedings before the Federal Patent Court and, under certain conditions, proceedings with respect to appeals on points of law before the Federal Court of Justice.

Right to appeal

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|-------------------------------|---|
| Scope of protection | <p>The scope of protection of a trade mark is made up of</p> <ol style="list-style-type: none">the territorial scope of protection (the territory of the Federal Republic of Germany for a national trade mark registered in the Register kept at the DPMA),the distinctiveness, that means the trade mark's level of recognition by consumers (a trade mark having a high degree of distinctiveness usually has an average to above-average scope of protection),the number of goods and/or services for which the trade mark is registered. |
| Search | see "Trade mark search" |
| Sound mark | Sound marks are acoustic, audible marks, that means sounds, jingles, melodies or other tunes or noises. |
| Trade mark | Trade marks are signs that distinguish products and services of an enterprise from those of other enterprises. Words, pictures, sounds, three-dimensional shapes, colours or other signs can be registered as trade marks in the Register of the DPMA, provided they can be represented graphically. German trade marks last for ten years and can be renewed indefinitely thereafter. |
| Trade mark application | The trade mark application is a request for protection of a sign by registering the trade mark in the Trade Mark Register of the DPMA. The application contains information on the applicant, a representation (illustration) of the trade mark and the goods or services for which registration is requested. A trade mark application costs 300 euros including three classes. Each further class costs an extra 100 euros. |
| Trade mark certificate | see "Registration certificate" |
| Trade mark journal | see Official (online) Trade Mark Journal |
| Trade mark licence | By granting a trade mark licence, the trade mark owner can permit another person or company to use the trade mark – usually there is a licence charge. |

see “German Patent and Trade Mark Office (DPMA)” and “European Union Intellectual Property Office (EUIPO)”

Trade mark office

The Trade Mark Register is a register kept at the DPMA, which is publicly accessible at www.dpma.de/english/search/dpmaregister. It contains the following data: filing date and beginning of the duration of protection of a trade mark, representation (illustration) of the trade mark, the goods and services for which the respective trade mark is registered, trade mark number, applicant and owner of the trade mark, representative of the trade mark owner, whether the trade mark was registered because of its level of market recognition by trade circles, information as to whether the trade mark is subject of on-going opposition or cancellation proceedings.

Trade Mark Register

The DPMA does not check if there is another trade mark that is identical or similar to your sign. By performing a search for identical or similar trade marks before filing a trade mark application, the applicant should make sure that the trade mark chosen does not infringe third-party rights. The search should include national trade marks, European Union trade marks and international registrations.

Trade mark search

Just like other rights, a registered trade mark can be transferred, in full or in part, to a new owner (natural or legal person).

Transfer

Trade marks are classified according to the Vienna Classification to provide a means to search for figurative elements of trade marks and purely figurative marks, for example, in order to find conflicting earlier trade marks. The “Vienna Classification – International Classification of Figurative Elements of Marks” was adopted in Vienna in 1973. It constitutes a hierarchical system that proceeds from the general to the particular, dividing all figurative elements into categories, divisions and sections.

Vienna Classification

Word marks are trade marks that consist of words, letters, numbers or other characters that are part of the standard set of characters used by the DPMA.

Word mark

World Intellectual Property Organization (WIPO)

The World Intellectual Property Organization (WIPO) was established in 1967 to promote the protection of intellectual property throughout the world. Its headquarters are in Geneva (Switzerland).

An application for international registration requesting trade mark protection in several countries in the world can be sent to WIPO through the DPMA. However, the precondition is a “German basic mark”, that means a trade mark application or trade mark registration recorded in the German Trade Mark Register.

Do you have any questions?

We will be pleased to answer your questions and provide detailed information on the steps of a trade mark application. Visit us in Munich, Jena or Berlin. You are also welcome to contact us by phone, fax or e-mail at info@dpma.de.

www.dpma.de/english/services

More information and all the required application forms are available on our website.

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This information brochure aims at providing a first insight into the field of trade mark law. For this reason, it also contains simplified and generalised information. It does not attempt to provide a complete guide to or binding information on this complex matter. More detailed information is available on the website of the German Patent and Trade Mark Office (www.dpma.de/english).

