



German Patent
and Trade Mark Office

Trade Marks

An information brochure
on trade mark protection





Content

I. Introduction

We protect your trade mark	4
Trade marks send out strong signals.	5
Trade marks create trust.	5
Trade marks protect ideas	6
And safeguard assets	8
Rights conferred by trade marks	9

II. The road to trade mark protection 10

No trade mark protection without classification:	
The list of goods and services	11
First comes the search. The trade mark register	14
Your application	15
Registration requirements	18
Registration process and costs	19
Effect of protection and term of protection	21
Compulsory use and defence	22
Opposition proceedings	23
Transfer, licensing and giving as security	25
Trade mark protection abroad	26
Cancellation procedure	28

III. Service 29

Tips for the trade mark search	30
Glossary	32
We will be pleased to help you	38

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 useful guide for your trade mark application.

We are also happy to answer your questions and give you more detailed information – either by phone (+49 [0] 89 2195-3402), e-mail (info@dpma.de) or online at www.dpma.de.



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: through words and pictures, shapes and sounds they provide useful orientation in the endless stream of communication messages.

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.

What makes trade marks unique?

A memorable name, an appealing sign, a unique image, a catchy sound, but also the messages that the trade mark conveys, the promises it makes. All that enhances its credibility, raises its profile and makes it unique. Establishing and developing a strong trade mark is a long-term effort and an investment in the future.

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 Law).

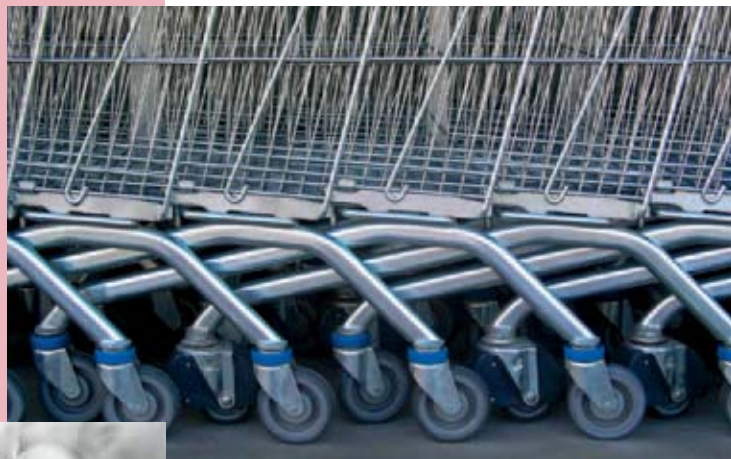
Today, trade marks are omnipresent. They can stand for a single product (for example, Mars, file number: 604 636), for an entire product line (for example, Nivea, file number: 82 840) or for an enterprise (for example E.ON, file number: 300 20 593). Within the meaning of trade mark law, trade marks distinguish only specific goods and services. For more detailed information see pages 11 to 13.

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.

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 consumer. 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.

Rights conferred by trade marks

Trade mark protection usually arises from the entry of the sign in the register kept by the German Patent and Trade Mark Office. 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.

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.

Who can be the owner of a trade mark?

On principle, 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.

The road to trade mark protection

Far more than 750 000 trade marks are registered in the register of the German Patent and Trade Mark Office – 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? This brochure of the German Patent and Trade Mark Office 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.

The list of goods and services	11
Classes of the Nice Classification	13
The trade mark register	14
Your application	15
Registration requirements	18
Registration process and costs	19
Effect of protection and term of protection	21
Compulsory use and defence	22
Opposition proceedings	23
Transfer, licensing and giving as security	25
Trade mark protection abroad	26
Cancellation procedure	28

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. You will find admissible terms for a list of goods and services at: www.dpma.de/english/trade_marks/application/index.html. If these terms are used in the application, we can register the trade mark immediately – provided that there are no legal bars.

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.

Further information is available at www.dpma.de.



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 Law 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”.

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 11 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”.

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

All trade marks applied for, registered and refused in Germany are published in **DPMAregister** at: www.dpma.de. 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 29 to 30.

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.

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 16).

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



Ways to apply

Basically, you have two options:

- If you choose to file a written application please use the application form provided by the German Patent and Trade Mark Office (as shown on this page) and file it at our Office or at a patent information centre authorised to accept trade mark applications. The application form can be downloaded any time at www.dpma.de/english/trade_marks/application/index.html.

- If you choose the online option your application must bear a qualified electronic signature allowing to clearly authenticate you as sender of the application. A qualified signature card with the corresponding card reader is necessary for this purpose. A list of suppliers of signature cards is available from Bundesnetzagentur.

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. At www.dpma.de you will find more information and can download the **DPMAdirekt** software free of charge.

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

The image shows a detailed German patent application form from the Deutsches Patent- und Markenamt (DPMA). The form is titled 'DEUTSCHES PATENT- UND MARKENAMT' and 'Anmeldung zur Eintragung einer Marke in das Register'. It contains various sections for applicant information, fee payment, and application details. A large number '3' is prominently displayed in the top right corner of the form's header area.

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 at www.dpma.de.

The filing date – what role does it play?

As mentioned in the above section “Trade mark search” 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 at www.dpma.de to check.

At www.dpma.de you can download application forms and find comprehensive information on the German Patent and Trade Mark Office and on the formalities of an IP application. The enquiry units of the German Patent and Trade Mark Office 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
- the trade mark includes an emblem of state.

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

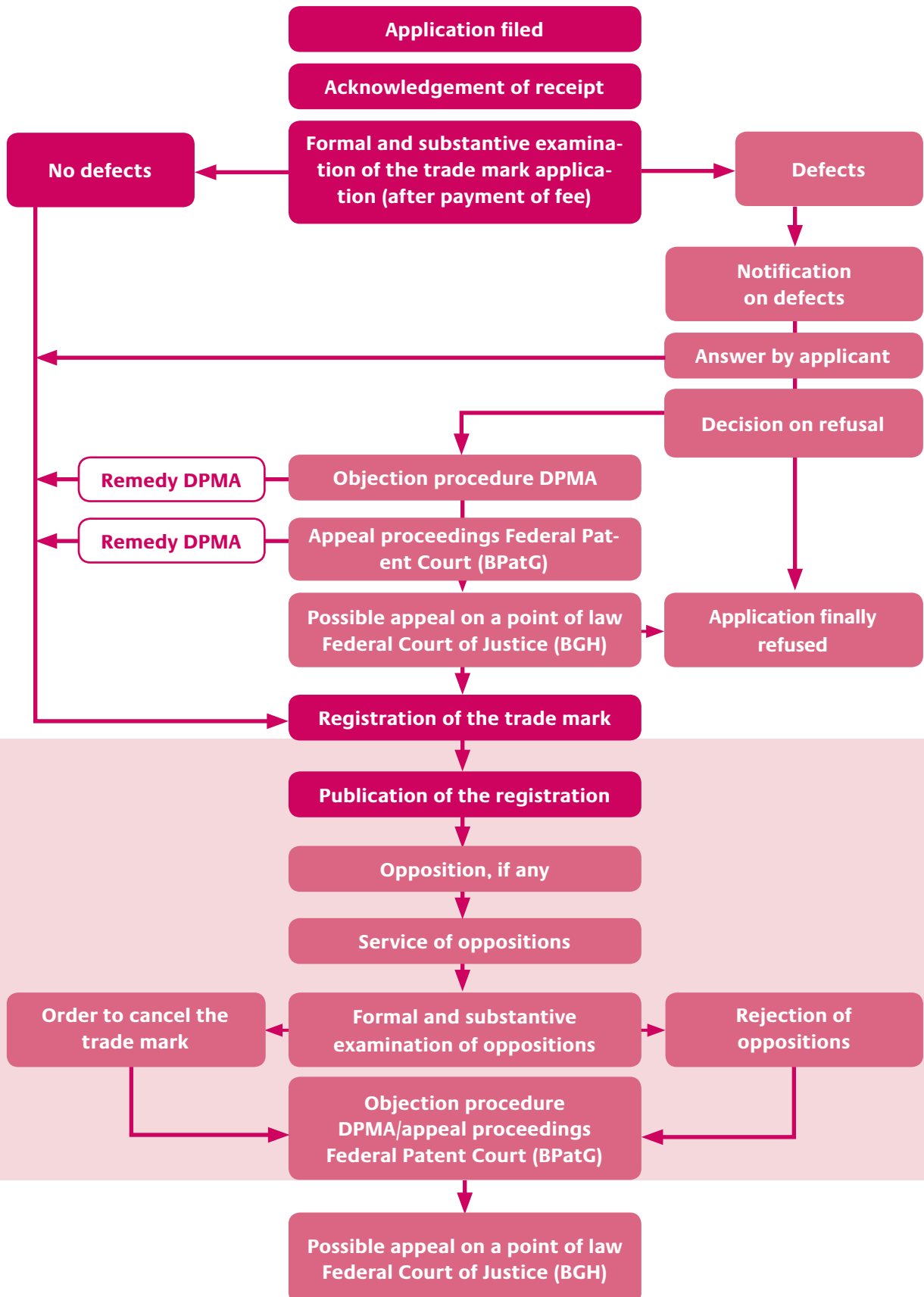
available for unrestricted use by competitors. The following are also excluded from registration: promotional statements, general advertising slogans and word sequences that have become customary in the current language as fixed expression.

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)

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



The registration procedure

After receiving the fees, which must be paid within three months after filing the application, the German Patent and Trade Mark Office 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.

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 <http://register.dpma.de>.

At special request and subject to payment of an additional fee, we can speed up processing of the application.

If grounds for refusal are identified during the examination of your application, you will be notified in writing about the defects. 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 an objection procedure (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.

Overview of fees for application with registration

Application fee (including class fee for up to three classes)	300 Euro
Application fee for online filing including class fee for up to three classes)	290 Euro
Class fee upon filing the application (for each additional class from the 4th class)	100 Euro
Accelerated examination of the application	200 Euro

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).

Effect of protection and term 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 protection – indefinite renewal

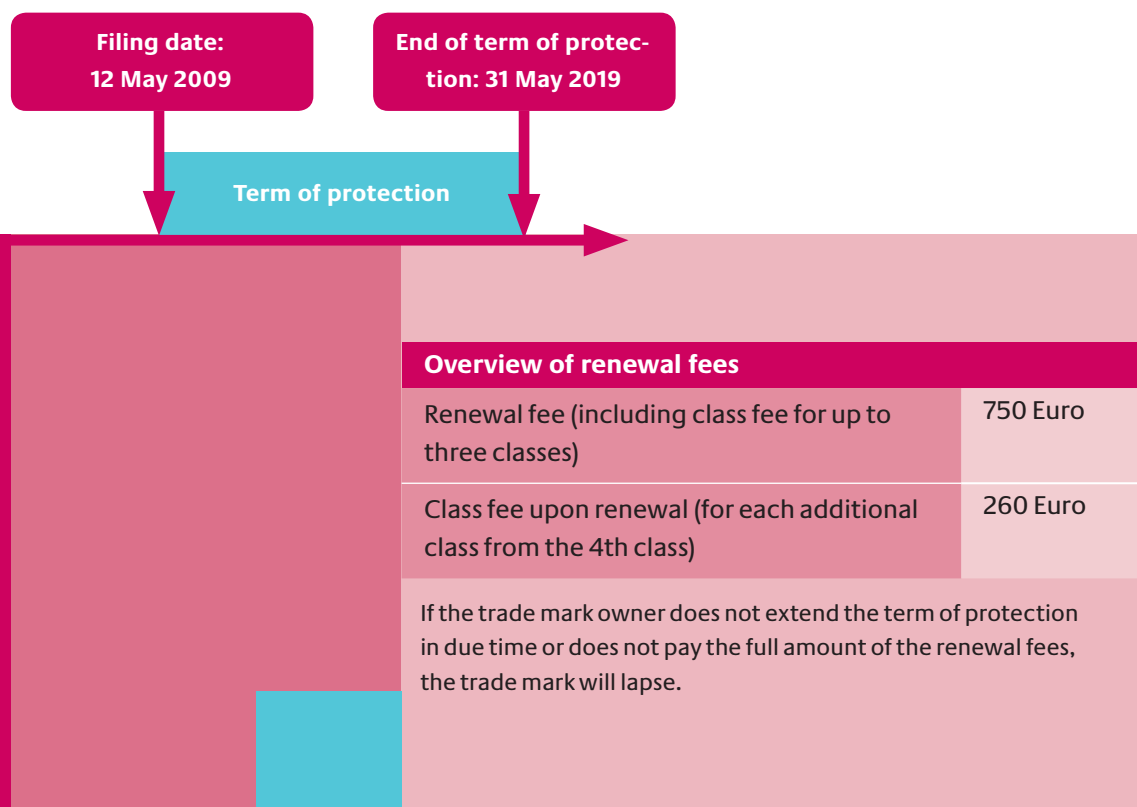
The term of protection starts on the application date and ends after ten years, on the last day of the month of the application date.

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 term of protection) and for changing the scope of protection can be downloaded from:

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



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 Law 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 28.

What trade mark owners should consider:

Applications for new trade marks received at the DPMA amount to 75 000 to 80 000 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”, “Fön”, “Tempo” 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.

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 Euro must be paid. It is not possible to extend this period.

The opposition form can be downloaded at: www.dpma.de/english/trade_marks/forms/index.html.

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).

Opposition

Please take into consideration that a trade mark right does not only derive from registration (see page 18 and 20). This is why owners of an unregistered trade mark can also lodge a notice of opposition against the registration of a trade mark.

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 he has put the trade mark to genuine use during the last five years. If he 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 28.

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 period 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 register entry of a restraint on disposal.

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 so-called 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 so-called Community trade mark, valid across the entire EU, by using a single registration procedure available at the Office for Harmonization in the Internal Market in Alicante (Spain).

Please note that not only any owner of an earlier Community 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 Community trade marks may be filed directly at the Office for Harmonization (<http://oami.europa.eu>) or at the German Patent and Trade Mark Office.

OHIM – the organisation for European trade mark protection

The Office for Harmonization in the Internal Market is located in Alicante, Spain. OHIM is an agency of the European Union in charge of the registration of trade marks and designs, valid in all 27 countries of the EU. More at www.oami.europa.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 which is in charge of this international registration procedure (<http://www.wipo.int>). Under certain conditions you may claim the priority of your national basic mark. You can obtain trade mark protection in up to

80 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 German Patent and Trade Mark Office (request forms available at <http://www.wipo.int/madrid/en/forms/>).



WIPO – the organization for international trade mark protection

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

Cancellation procedure

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 a cancellation procedure is 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	Cancellation ex officio	Cancellation upon request by a third party
<p>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.</p>	<p>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).</p>	<p>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).</p>

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 German Patent and Trade Mark Office 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 (Markenblatt). All important trade mark terms are explained in detail in the glossary (page 32). Should you have any questions our staff will be pleased to help you.



Tips for the trade mark search

The German Patent and Trade Mark Office 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 Community 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 German Patent and Trade Mark Office or online at: www.dpma.de/english/trade_marks/search/index.html.

DPMAregister

<http://register.dpma.de/DPMAregister/Uebersicht>

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

CTM-Online

<http://oami.europa.eu/en>

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

ROMARIN

<http://www.wipo.int/romarin>

In the ROMARIN database you will find international applications and international registrations of marks.

**We will be pleased to help you
Do you have any questions?**

More information on trade mark searches is available on our website at:

http://www.dpma.de/english/trade_marks/search/index.html

Telephone enquiries

You can contact the enquiry units of the DPMA in Munich, the Jena sub-office and the Technical Information Centre (TIZ) in Berlin to gain detailed information on the filing routes, procedures and application requirements. We are also pleased to send you forms and information brochures. The enquiry units can be contacted via the central phone number +49 (0) 89 2195-3402.

The enquiry unit is not authorised to give legal advice. Under the law on legal counselling, only patent attorneys and attorneys-at-law 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 for 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.

For address directories and links please contact our enquiry unit or go to the website of the German Patent and Trade Mark Office.



Glossary

Appeal on a point of law Federal Court of Justice (BGH)	Under certain conditions, an appeal on a point of law from a decision of the Federal Patent Court (BPatG) can be brought to the Federal Court of Justice (BGH).
Appeal proceedings Federal Patent Court (BPatG)	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 (BPatG) within one month after service of the decision on refusal.
Applicant	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.
Application date (filing date)	The date on which the DPMA receives the complete request for trade mark protection (trade mark application) is the so-called “filing 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
Bar to registration	see Grounds for refusal
Cancellation	Trade marks can be cancelled on grounds for nullity or revocation – or because the trade mark owner has surrendered the trade mark.
Combined word and figurative mark	Combined word and figurative marks consist of a combination of word elements and graphical elements, or of words in lettering styles.
Community trade mark	By registering a trade mark at the Office for Harmonization in the Internal Market (OHIM), the “European trade mark office” located in Alicante (Spain), the trade mark owner obtains protection in all 27 countries of the European Union (formerly, European Community).
Decision on refusal	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 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.
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 “Tempo” for paper tissues or “Fön” for hair dryers.
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	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, champagne).
International registrations	Trade marks registered in the international register of the World Intellectual Property Organization. see World Intellectual Property Organization (WIPO)
Licence/licensing	see Trade mark licence
Likelihood of confusion	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.

List of goods and services	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	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 11 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.
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 defects	If the application contains formal defects, 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 defects explaining the grounds for refusal, before the trade mark is refused registration.
Objection procedure (Erinnerung) DPMA	The applicant may raise objection (Erinnerung) against the decision to refuse registration of the trade mark. A second examiner (objection examiner) will review the decision.
Office for Harmonization in the Internal Market (OHIM)	The Office for Harmonization in the Internal Market (OHIM) is an official agency of the European Union in charge of the registration of trade marks and designs that are valid in all 27 countries of the EU. OHIM is located in Alicante (Spain).
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 (Markenblatt). Individual issues of the trade mark journal are available from the DPMAregister online service at www.dpma.de 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 he thinks that his 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.
Publication	All new trade mark registrations and changes regarding registered trade marks are published online in the trade mark journal (Markenblatt).
Register	see Trade mark register
Registration	After the examiner has examined the trade mark application and has not found any formal defects 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 certificate	The DPMA will send the owner of the trade mark a certificate of the registration of the trade mark in the trade mark register.
Renewal	After expiry of the ten-year term of protection, the trade mark can be renewed every ten years for a further ten years, by payment of a renewal fee (750 Euro for three classes, 260 Euro for every additional class).
Revocation	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.
Right of use	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 to appeal	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: the objection (Erinnerung) procedure at the DPMA, appeal proceedings before the Federal Patent Court (BPatG) and, under certain conditions, proceedings with respect to appeals on points of law before the Federal Court of Justice (BGH).

Scope of protection	<p>The scope of protection of a trade mark is made up of</p> <ul style="list-style-type: none"> a) 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), b) 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), c) 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 10 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 Euro including three classes. Each further class costs an extra 100 Euro.
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.
Trade mark office	see German Patent and Trade Mark Office (DPMA) and Office for Harmonization in the Internal Market (OHIM)

Trade mark register	The trade mark register is a publicly accessible register kept at the DPMA, which can be viewed at http://register.dpma.de/DPMAregister/uebersicht . It contains the following data: filing date and beginning of the term 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 search	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, Community trade marks and international registrations.
Transfer	Just like other rights, a registered trade mark can be transferred, in full or in part, to a new owner (natural or legal person).
Vienna Classification	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.
Word mark	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.
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.

We will be pleased to help you

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.

More information and all the required application forms are available at: www.dpma.de.

Addresses and telephone numbers

Munich

Deutsches Patent- und Markenamt
Zweibrückenstraße 12
80331 München
Germany
Switchboard Operator +49 (0) 89 2195-0
Fax +49 (0) 89 2195-2221
Public search room +49 (0) 89 2195-3403
or -2504

Jena

Deutsches Patent- und Markenamt
Dienststelle Jena
Goethestraße 1
07743 Jena
Germany
Switchboard Operator +49 (0) 3641-4054
Fax +49 (0) 3641-405690

Berlin

Deutsches Patent- und Markenamt
Technisches Informationszentrum Berlin
Gitschiner Straße 97
10969 Berlin
Germany
Switchboard Operator +49 (0) 30 25992-0
Fax +49 (0) 30 25992-404
Public search room +49 (0) 30 25992-230
or -231

General telephone numbers:

Enquiry unit +49 (0) 89 2195-3402
Helpline for database users
+49 (0) 89 2195-3435

Internet www.dpma.de

Press and public relations

+49 (0) 89 2195-3222
presse@dpma.de
<http://presse.dpma.de>

Imprint

Published by:

Deutsches Patent- und Markenamt
Zweibrückenstraße 12
80331 München
Germany

Phone: +49 (0) 89 2195-0
www.dpma.de

Last update:

July 2010

Text:

Robert Botz, www.buerobotz.de

Design:

www.designlevel2.de

Picture credits

Title page: Fotolia.com/silviaantunes

Page 2: Corbis/Matthieu Spohn/PhotoAlto

Page 4: panthermedia.net/Markus Hoetzel

Page 7: left: Fotolia.com/proffelice, right: Fotolia.com/Carlos Caetano

Page 8: iStockphoto.com/saffetucuncu

Page 11: Fotolia.com/pgm

Page 15: iStockphoto.com/Alisa Foytik

Page 17: Fotolia.com/biomind

Page 24: left: iStockphoto.com/Ed Bock 2008 All Rights Reserved,
right: iStockphoto.com/Yvan Dubé

Page 25: Fotolia.com/Carlos Caetano

Page 27: iStockphoto.com/Jyeshern Cheng

Page 29: iStockphoto.com/Bjorn Rasmussen

Page 31: Fotolia.com/lunamarina

Page 39: iStockphoto.com/Tatiana Popova





Deutsches Patent- und Markenamt
Zweibrückenstraße 12
80331 München
Germany

www.dpma.de

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).