

Trademark industry in Germany



Germany has a well established trademark system and since 1995 German businesses are using it in its fullness, together with the Community trademarks (CTMs), Community designs (CDs), and international Madrid registrations, noted by Paul-A. Wacker, senior founding partner at KUHNNEN & WACKER. A broad combination of reasonably priced goods and services allows the industry, the traders and the service providers to defend successfully against counterfeiters. CTMs can now be published and often registered in a much shorter time frame.

Germany has a stricter examination procedure, so that from 10 cases rejected under absolute grounds there is still a chance to get 6 of them successfully registered at CTMs after claiming priority, according to Mr. Wacker. "The only problem is," he said, "an extremely negative case law in the European Union and in Germany against the 3-dimensional marks, which are somehow seen as a protection for new designs, that do not belong to the trademarks. The judges often ignore the fact that the shape of goods can have an even higher value of recognition and identification of the origin of a specific business than most of other types of trademarks."

Compared to technical protection with patents and utility models it is easy and quick to stop infringers of trademarks and designs in Germany. Mr. Wacker explained: "Sometimes forum shopping is a must, when the reputation of a trademark is endangered by 'only' a similar mark, which tries to be as close as possible to benefit from the reputation of the established mark. Preliminary judgments can be obtained within a few hours. Even the German customs are very sensitive to identify counterfeits and to immediately inform the registered patent attorney."

He added that with the community trademark and the related courts handling CTMs it is easy to sue infringers also on a cross-border scale. Often issues are brought up by customs. "A strongly used involvement in counterfeits of clients and related databases are of great help to trace interrelation of counterfeiters to enable fast counteractions," said Mr. Wacker.

Nevertheless, he also noted that even though major corporations and hidden champions are aware that all kinds of IPRs have to be taken care of in the full range, trademarks are still not as much in the focus, especially for those businesses with a fast pace of technical developments.

Mr. Wacker commented: "Without a regular check of the IPR portfolio it happens frequently that the quality of a trademark portfolio has grown poor and has opened chances for competitors and counterfeiters. This is true for all kind of businesses and more dependent on the management than on the specific kind of product or services."

When asked about current trends in the trademarks industry, Mr. Wacker said: "Some jurisdictions do not keep pace with the fast

progress of some markets and the related know-how of judges in relation to trademarks should be improved. Secondly, there is a new tendency to interpret the scope of protection of trademarks much narrower with respect to the wording of the list of goods and with respect to the relation of other trademarks in the portfolio. Furthermore, it is necessary that judges are prepared to spend several hours every day on an ongoing fair with a remote access to their court files."

Mr. Wacker continued: "It can be found that with the increasing volume of products traded on the internet, especially young customers have become much more trademark oriented. This fact is often used by counterfeiters and therefore clients must cooperate with their law firms which can react quickly against those infringers."

KUHNNEN & WACKER is a full service intellectual property law firm which was established more than 35 years ago in Freising close to the Munich airport. The firm represents SMEs as well as major corporate and global technical innovators.

The group consists of 85 people, 17 of whom are attorneys focusing on a proactive trademark policy for clients. KUHNNEN & WACKER has protected thousands of trademarks and created all kinds of trademarks including those which have become famous.

"We have successfully acted against trademark-trolls who have tried to bribe some of our clients with unfaithful acquired marks and business designations with amounts reaching the range of millions of Euros," commented Mr. Wacker. "Furthermore, our continuous assistance in creating new trademarks and negotiating trademark conflicts has resulted in some very strong and well received trademark portfolios."

Mr. Wacker concluded: "We are prepared to react quickly and properly, especially to each trademark case as trademark business often has to be dealt with faster than any other task in IPRs. Our very modern office organisation gives us a distinct advantage when working on trademark matters."

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