

# **Germany – IP Highlights Revision of Trademark Act**

**Marcus Ehnle  
MLaw (Lucerne), Dipl. Geophys.-Univ.  
Swiss and European Patent Attorney, German Patentassessor  
WIPO Mediator**

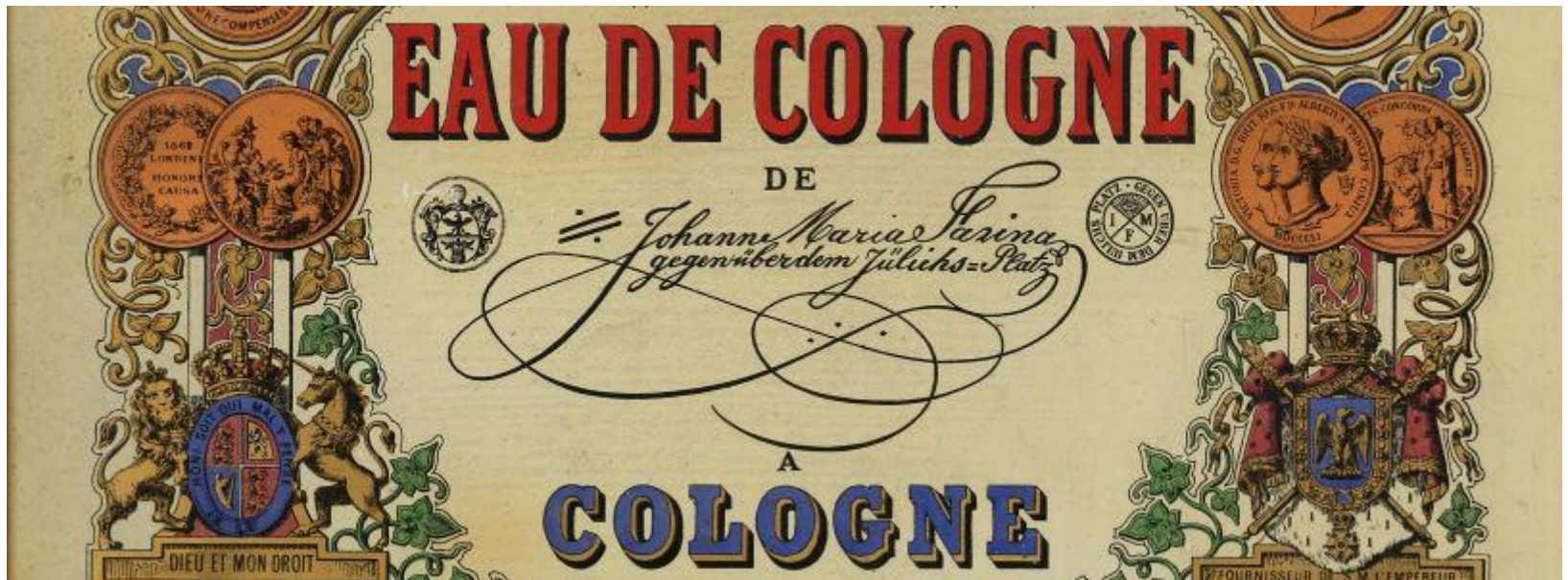
**M. Zardi & Co. SA  
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# In a nutshell

...from an IP perspective

- Effective protection mechanism for your products/services
  - Long history in Intellectual property
  - National IP system provides many protection possibilities in order to support your strategies
  - Germany is part of the European IP system
- Efficient and fast jurisdiction
  - IP specialized district courts
  - Basically, first instance decisions within one year
  - Qualcomm vs. Apple: Sales stop against Apple products in DE
    - Munich District court: likelihood that the Quorvo chip (Power Management) used in Apple iPhone 7 and 8 infringes Qualcomm patent rights
    - Apple exchanged the Quorvo chip in its products concerned

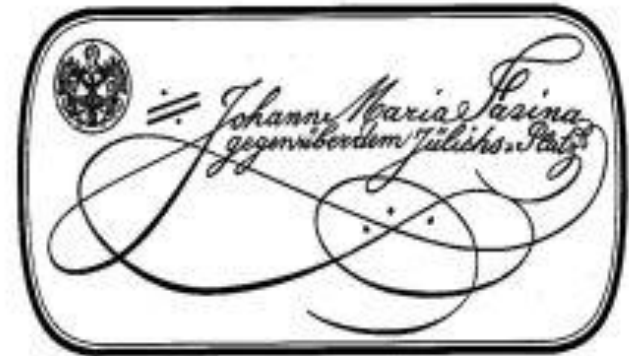
One of the world's oldest perfume manufacturer  
310 years of fighting imitators



- 13. July 1709, Cologne: Giovanni Battista Farina, Santa Maria Maggiore
- Johann Maria Farina (1685-1766) - fragrance water "aqua mirabilis", in honour of his adopted city "Eau de Cologne"

## “Inventor” of the brand perfume

- Constant high level of quality
  - sovereign purchasing policy for raw materials
  - well structured manufacturing operation
- New location: Obenmarspforten 23, gegenüber (opposite) Jülichs-Platz
  - “Farina gegenüber” became a “brand”
- Clients: Napoleon, Mozart, Queen Victoria, Goethe, Viktor Emanuel II, ...
- Dominated the perfumery market at least until end of 19<sup>th</sup> century



## Success aroused desire and called imitators

One became better known than the original

- When it comes to “Eau de Cologne”, people think first on “4711” today
- Wilhelm Mühlens named his company “Franz Maria Farina, Glockengasse 4711”
- Persons named Farina as Workers or Partners to give the plagiaristic company an appearance of justification
- 1873: Mühlens was finally forbidden to use “Farina” in the company name





# Farina Family – Pioneers in IP



- Jean Marie Farina (1809-1880) fought for decades for legal trademark protection
  - 1836: First corresponding submission to responsible Prussian ministerial bureaucracy
- 1875: First German Trademark Act entered into force
- Johann Maria Farina gegenüber dem Jülichs-Platz: first company in Cologne with registered trademarks

# Revision of the German Trademark Act

- EU trademark law based on coexistence of national and EU trade marks
  - First harmonisation in 1995
- EU Trade Mark Directive 2015/2436 (TMD) and EU Trade Mark regulation (EUTMR)
  - Further harmonisation in EU
  - Implementation of all mandatory and optional provisions of TMD into German law
  - Revised German trademark act entered into force on 14 January 2019

## Determinability – New types of trade marks

- Previously - capable of being represented graphically
- New – clearly and precisely determined
  - Meets market needs for modern trademark types and technical possibilities of representing a trade mark in electronic registers
  - sound marks, multimedia marks, holograms and others in suitable electronic formats
- Additional options of representing can be used in parallel
  - Graphic representation remains possible
- No international extension of protection possible
  - WIPO require a two-dimensional graphic representation

<https://euipo.europa.eu/ohimportal/en/trade-marks-examples>



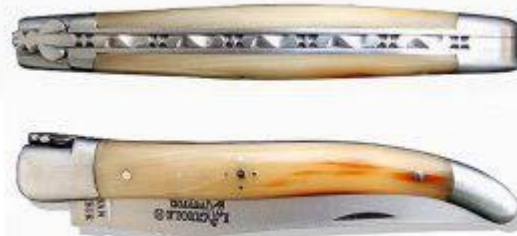
## National Certification Mark

- New trademark category
  - Focus on guarantee function instead of indication of origin
  - Quality seals or test labels of neutral certification companies
  - Extension of International marks to Germany possible
- Needs to be
  - described as such when filed
  - capable of distinguishing goods or services from those which are not certified which
  - certified in respect to material, mode of manufacture, quality, accuracy or other characteristics, accordingly
- Certifying character must result from representation of the sign
- Provide information in the mandatory regulations governing use of the trademark



## New absolute grounds of refusal

- Geographical indications and designations of origins
  - in particular foodstuffs, wines and spirits protected under national or European legislation
- Traditional terms for wine or specialities
  - trade marks containing such indications, directly or indirectly, may be registered only for goods expressly conforming to the specification



# Opposition proceedings

- Previously: opposition was only possible on one opposing sign
  - New: Several earlier rights may be lodged by a single opposition
- New, additional grounds for opposition
  - Protected geographical indications and protected designations of origin
- Facilitate negotiations: “Cooling-off” upon joint request
  - At least two months period may be extended by a joint request
- Proof of use is required (instead of making a plausible case)
  - Can be provided by means of an affirmation in lieu of an oath
  - Period begins five years before the filing date/priority date of the challenged trade mark (past: five years before the date of publication of registration)
  - In line with the European Union trade mark law
- Grace period (five years) for use begins on the date when no further opposition can be filed
  - Beginning and the end of the grace period has to be recorded in the Register



# Grazie!

**M. Zardi & Co. SA**  
Via G. B. Pioda, 6  
6900 Lugano

[www.zardi.ch](http://www.zardi.ch)