

**International
Comparative
Legal Guides**



Trade Marks

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1 Relevant Authorities and Legislation

1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant trade mark authority in Germany is the *Deutsche Patent- und Markenamt* in Munich (DPMA).

1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant trade mark legislation in Germany is the *Gesetz über den Schutz von Marken und sonstigen Kennzeichen* (the Trade Mark Act, or MarkenG) and the *Verordnung zur Ausführung des Markengesetzes* (the Trade Mark Ordinance).

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

Which signs are eligible for protection as trade marks is determined by Sec. 3 MarkenG: all signs, particularly words including personal names, designs, letters, numerals, sounds, three-dimensional designs, the shape of goods or of their packaging as well as other wrapping, including colours and colour combinations, may be protected as trade marks if they are capable of distinguishing the goods or services of one undertaking from those of other undertakings. Signs consisting exclusively of shapes or other characteristics that result from the nature of the goods themselves, which are necessary to obtain a technical result or which give substantial value to the goods, shall not be capable of being protected as trade marks.

Since 14 January 2019, the graphic representability of the sign is no longer required. It is sufficient if the mark can be represented in the Register in such a way that the DPMA and the public can clearly and unambiguously determine the subject matter of the protection. This means that sound marks, multimedia marks, pattern marks, motion marks, holograms and other forms of marks in suitable electronic formats are now also eligible.

In addition, collective and certification marks can be registered if the applicant submits regulations governing the use of the certification mark which will be recorded in the Register.

2.2 What cannot be registered as a trade mark?

Sec. 8 MarkenG provides absolute grounds for refusal: signs which are not capable of being represented on the Register in

a manner that enables the competent authorities and the public to determine the clear and precise subject matter of protection cannot be registered as a trade mark. Furthermore, trade marks which are devoid of any distinctive character for the goods or services or are descriptive shall not be registered.

2.3 What information is needed to register a trade mark?

The minimum contents required to be granted a filing date are provided in Sec. 32 para. 2 MarkenG: a request for registration; information permitting to identify the applicant; a representation of the trade mark, which is not subject to the catalogue of absolute grounds for refusal; and a list of goods and services for which registration is being requested.

2.4 What is the general procedure for trade mark registration?

The general procedure is to file an application with the DPMA. The application can be filed by mail, fax or online (with or without a qualified electronic signature) and in person. The DPMA provides the corresponding forms for application.

The application has to meet the minimum requirements (name and address of the applicant, a representation of the trade mark that shows exactly what should be protected and a list of goods and/or services).

Trade mark research is not required before filing but is highly recommended to avoid conflict with prior registered trade marks and can be carried out in the DPMA's Register free of charge.

2.5 How is a trade mark adequately represented?

Since 14 January 2019, the graphic representability of the sign is no longer required. It is sufficient if the trade mark can be represented in the Register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of protection, Sec. 8 para. 1 MarkenG.

2.6 How are goods and services described?

The goods and services have to be described according the Nice Classification (which categorises the goods and services in different classes according to the International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement).

2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Please see question 2.1.

2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

No. German law does not know the requirement to provide proof of use upon registration or renewal. Use is only subject to a revocation proceeding. After registration, a trade mark has to be used for all registered goods and services. If the grace period of five years for non-use has expired and the trade mark is not used within a continuous period of more than five years, there is a high risk of the trade mark's cancellation upon request by a third party or that the proprietor's own trade mark rights cannot be enforced because use of the trade mark is disputed.

2.9 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Once the German trade mark has been registered at the DPMA, protection is obtained in the whole territory of the Federal Republic of Germany.

2.10 Who can own a trade mark in your jurisdiction?

Natural persons, legal persons or partnerships insofar as they are equipped with the capacity to acquire rights and enter into liabilities can be proprietors of trade marks, Sec. 7 MarkenG.

2.11 Can a trade mark acquire distinctive character through use?

Yes, under certain circumstances: according to Sec. 8 para. 1 MarkenG, trade marks that are devoid of any distinctive character for the goods or services shall not be registered. This shall not apply if, prior to the point in time of the decision on registration, the trade mark has become established in the affected trade circles in consequence of the use made of it with respect to the goods or services for which the application was filed, Sec. 8 para. 3 MarkenG.

2.12 How long on average does registration take?

This depends on whether the DPMA has any objections with regard to the application, e.g., the distinctive character of the sign or the list of goods and services. If the application meets the formal requirements, there are no absolute grounds for refusal (especially if the term is distinctive and not descriptive) and the fees are paid, it may take only a few weeks until registration.

2.13 What is the average cost of obtaining a trade mark in your jurisdiction?

A trade mark application including class fees for up to three classes costs €290 (for electronic filing). For the fourth and each additional class, a class fee of €100 has to be paid. Attorneys'

fees may also be added in case a legal representative is appointed. At special request and subject to payment of an additional fee of €200, processing of the application is accelerated.

2.14 Is there more than one route to obtaining a registration in your jurisdiction?

No. To obtain registration of a German trade mark, an application must be filed with the DPMA. Trade mark protection in Germany can also be achieved through an EU trade mark or an International Registration designating Germany or the European Union (EU).

2.15 Is a Power of Attorney needed?

No, in general a Power of Attorney is not required. Applicants without a domicile, seat or establishment in Germany have to appoint a lawyer (*Rechtsanwalt*) or patent attorney.

2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

No, they do not.

2.17 How is priority claimed?

Any person who claims priority has within two months after the date of filing to indicate the date and state of the earlier application, Sec. 34 para. 3 MarkenG. Within another two months after service of the invitation by the DPMA, the applicant has to indicate the file number of the earlier application and submit a copy of the earlier application. The particulars may be changed within these time limits. If the particulars are not submitted in due time, the right of priority shall be forfeited for this application. If priority is wrongly claimed and not waived, the application as a whole is rejected, not only the priority claim. Thus, there is a risk of loss of rights.

2.18 Does your jurisdiction recognise Collective or Certification marks?

Yes, collective and certification marks can be registered if the applicant submits regulations governing the use of the certification mark, which will be recorded in the Register.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

Absolute grounds for refusal include:

- lack of distinctiveness;
- use of descriptive terms that must be kept freely available for general use;
- danger of deceiving the public;
- an emblem of state included in the trade mark;
- an offence against public policy or accepted principles of morality; and
- signs that do not determine the clear and precise subject matter of protection.

For further absolute grounds for refusal, please see Sec. 8 para. 1 MarkenG.

3.2 What are the ways to overcome an absolute grounds objection?

An absolute grounds objection can be overcome by:

- replying to the objection at the DPMA;
- filing a special motion or appeal against the objection; and
- appealing on points of law to the German Federal Supreme Court (BGH).

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Different legal remedies are available against a decision of refusal:

- Against a decision of the Trade Mark Sections and Trade Mark Divisions that has been issued by a civil servant of the higher intermediate service or a comparable employee, a so-called “special motion” (*Erinnerung*) shall be available as well as an appeal to the Federal Patent Court, Sec. 64 paras 1, 6 MarkenG.
- Against a decision of a legal examiner, only an appeal to the Federal Patent Court is available, Sec. 66 para. 1 MarkenG.

3.4 What is the route of appeal?

A special motion shall be filed within one month from the date of notification of the decision, Sec. 64 para. 2 MarkenG. It must be filed in writing and is subject to a fee.

If the civil servant or employee whose decision is contested regards the special motion as well founded, he or she shall rectify his decision, Sec. 64 para. 3 MarkenG. In case the civil servant or employee does not agree with the special motion, he or she shall file to the legal examiner for further proceedings to decide on the special motion, Sec. 64 para. 4 MarkenG. The legal examiner may annul the first decision in whole or in part as far as he or she considers the special motion to be well founded. In case the legal examiner considers the special motion to be unfounded, he or she will reject it.

The appeal shall be filed in writing with the German Patent and Trade Mark Office within one month of service of the decision, Sec. 66 para. 2 MarkenG. The appeal must be filed with the DPMA in writing or electronically with a signature and is also subject to a fee.

If the unit whose decision is contested regards the appeal as well founded, it shall rectify its decision. If the appeal is not allowed, it shall be remitted to the Federal Patent Court within one month and without comment as to its merit, Sec. 66 para. 5 MarkenG.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

According to Sec. 9 para. 1 MarkenG, the registration of a trade mark may be cancelled:

1. if it is identical to an earlier trade mark applied for or registered and the goods or services for which it was registered are identical with the goods or services for which the earlier trade mark was applied for or registered (so-called “double identity”);
2. if a likelihood of confusion exists, including the likelihood of association between the trade marks, for the public because of its identity with or similarity to an earlier trade

mark applied for or registered and owing to the identity or similarity of the goods or services covered by both trade marks; or

3. if it is identical with or similar to an earlier trade mark applied for or registered if the earlier trade mark is a trade mark which has a reputation in Germany and the use of the registered trade mark would without due cause take unfair advantage of, or be detrimental to, the distinctive character or the repute of the trade mark which has a reputation.

4.2 Are there ways to overcome a relative grounds objection?

These relative grounds for refusal of registration are usually asserted by the proprietor of an earlier trade mark by means of an opposition or later in nullity proceedings. The DPMA does not examine trade mark applications for possibly conflicting earlier trade marks.

If double identity does exist, there is usually nothing to oppose this, because the likelihood of confusion is not a prerequisite for cancellation. If there is identity or similarity in the terms and the goods or services covered by both trade marks, the only way to overcome an objection is to present arguments against the similarity, and especially the likelihood of confusion.

4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Please see question 3.3.

4.4 What is the route of appeal?

Please see question 3.4.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

In principle, opposition can be filed if the proprietor fears that there is a likelihood of confusion with one’s own earlier applied-for or registered trade mark, unregistered trade mark or commercial designation, Sec. 42 para. 1 MarkenG.

Opposition can also be raised on the basis of earlier rights acquired by use. Furthermore, it is possible to invoke rights arising from the enlarged protection of trade marks that are well known in the territory of Germany. However, this provision only applies to oppositions raised against the registration of trade marks applied for on or after 1 October 2009.

The opposition may also be based on a protected geographical indication and a protected designation of origin, provided that the application for the trade mark in respect of which the opposition has been lodged was filed on or after 14 January 2019.

5.2 Who can oppose the registration of a trade mark in your jurisdiction?

The proprietor of an earlier trade mark can oppose registration. The trade mark licensee is only entitled to oppose if he has been authorised to do so by the proprietor of the trade mark.

5.3 What is the procedure for opposition?

A notice of opposition must be filed in writing within three months after the publication of the registration with the filing of a written notice of opposition. A detailed substantiation of grounds to the opposition can be filed together with the notice of opposition or afterwards.

An opposition fee of €250 must be paid within the three-month period. This includes the opposition on the basis of one opposing sign. If an opposition is based on several earlier opposing signs of the same proprietor, an additional fee of €50 must be paid for each additional opposing sign. If the proprietors are not identical, this means that there are several oppositions, and €250 must be paid for each.

After the proprietor of the newly registered trade mark is also given the opportunity to submit his arguments, the DPMA decides whether there is a likelihood of confusion between the signs and can either reject the opposition or cancel the registered trade mark in its entirety or in part.

6 Registration

6.1 What happens when a trade mark is granted registration?

The DPMA registers the trade mark and issues a (digital) certificate of registration. The registration is published in the official digital Trade Mark Journal (*Markenblatt*). With registration, the trade mark obtains protection in the whole territory of the Federal Republic of Germany. The acquisition of trade mark protection grants an exclusive right to the proprietor of the trade mark.

6.2 From which date following application do an applicant's trade mark rights commence?

The exclusive right of the proprietor of a trade mark commences with acquisition of trade mark protection, namely on the day of registration.

In the event of concurrence with other trade marks or commercial designations, it is a matter of precedence. This is determined by the seniority: either the date of filing, or, if priority is claimed, the priority date is relevant.

6.3 What is the term of a trade mark?

A registered trade mark is protected for 10 years and can be indefinitely renewed for further periods of 10 years in each case. The renewal shall become effective on the day following the expiry of the previous term of protection. Renewal fees must be paid for each renewal. German law does not know the requirement to provide proof of use upon renewal. Use is only subject to a revocation proceeding.

6.4 How is a trade mark renewed?

A trade mark is completely renewed by request of the proprietor of the trade mark and paying the renewal fee. Receipt of payment is deemed a request for renewal. If the trade mark is to be renewed only for parts of the registered goods and services, the owner or his representative shall use the form provided by the DPMA. The request for renewal shall be submitted in the six-month period prior to the expiry of the duration of

protection and can be paid within these six months without surcharges. Within a grace period of six months after the expiration of the duration of protection, a renewal can also still be requested, but a surcharge must then be paid.

7 Registrable Transactions

7.1 Can an individual register the assignment of a trade mark?

Yes. The application for transcription can be submitted by both an individual and a legal entity.

In the case of a registered trade mark, the transfer shall be entered in the Register at the request of one of the parties if the transfer is proved to the DPMA.

It should be noted that the assignment has only a procedural significance; it has no substantive significance. This means that a transaction in the Register is not a prerequisite for effective acquisition of a trade mark.

7.2 Are there different types of assignment?

Yes. On the one hand, a trade mark can be expressly transferred, as described above. On the other hand, there is also the presumed transfer of rights pursuant to Sec. 27 para. 2 MarkenG. If a trade mark belongs to a business operation and this is transferred, it must be assumed that the trade mark is automatically transferred as well.

Furthermore, according to Sec. 27 para. 1 MarkenG, only a partial transfer of the trade mark is possible. This means that the trade mark is transferred for a part of the goods and services for which it is protected. The prerequisite here is that the list of goods and services of the remaining registration and the list of the separated registration are congruent at the time of the request for division. If the division concerns goods and services that fall under a generic term, the generic term must be limited in both the remaining registration and the divisional registration in such a way that there is no overlapping of the goods and services.

7.3 Can an individual register the licensing of a trade mark?

Yes. However, licences are merely registered upon request. Such entry is not necessary for the validity of the licence and has only a declaratory effect.

7.4 Are there different types of licence?

Yes. There exist exclusive and non-exclusive licences.

7.5 Can a trade mark licensee sue for infringement?

Exclusive or non-exclusive licensees and distributors are not entitled to sue for trade mark infringement unless the proprietor has authorised them to sue. In addition, it must be in their own economic interest to sue for infringement. Such authorisation is generally included in the licence agreement.

7.6 Are quality control clauses necessary in a licence?

Quality control clauses are not necessary, but they can be included in a licence and are highly recommended.

7.7 Can an individual register a security interest under a trade mark?

Since trade marks constitute rights *in rem*, trade marks, just like other assets in which rights *in rem* exist, may be pledged pursuant to Sec. 29 para. 1 MarkenG. Upon a corresponding request, which may be filed by the proprietor 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 if proof thereof is furnished to the DPMA, Sec. 29 para. 2 MarkenG.

7.8 Are there different types of security interest?

Yes. Trade marks can be the object of a contractual as well as a statutory lien or of another right *in rem*. Furthermore, trade marks can be the object of measures of levy of execution.

8 Revocation

8.1 What are the grounds for revocation of a trade mark?

The grounds for revocation of a trade mark are set out in Sec. 49 MarkenG. The registration of a trade mark shall be revoked and cancelled on application if the trade mark has not been used within an uninterrupted period of five years in accordance with Sec. 26 MarkenG, after the date from which opposition is no longer possible. The registration of a trade mark shall furthermore be revoked and cancelled on application if, as a consequence of acts or inactivity of the proprietor, the trade mark has become the common name in the trade of the goods or services in respect of which it is registered, if, as a consequence of the use made of the trade mark by the proprietor or with his consent in respect of the goods or services in respect of which it is registered, the trade mark is liable to mislead the public particularly as to the nature, quality or geographical origin of those goods or services, or if the proprietor of the trade mark no longer complies with the prerequisites set out in Sec. 7 MarkenG.

8.2 What is the procedure for revocation of a trade mark?

The registration of a trade mark shall be revoked and cancelled on application if one of the above-mentioned grounds applies. The application can be filed with the DPMA, must be made in writing and must state the facts and evidence serving as justification, Sec. 53 para. 1 MarkenG.

In proceedings before the DPMA, there is no requirement to be represented by a lawyer.

Upon receipt of the application for revocation, the trade mark proprietor will be informed of the revocation proceedings initiated. If the proprietor files no opposition against this within two months, the trade mark will be cancelled without substantive examination of the request, Sec. 53 para. 4 MarkenG.

Alternatively, an action for revocation can be brought against the party registered as the proprietor of the trade mark before the courts of ordinary jurisdiction, Sec. 55 para. 1 MarkenG.

8.3 Who can commence revocation proceedings?

According to Sec. 53 para. 1 and 2 MarkenG, the application for revocation may be filed with the DPMA by any natural or legal person and any group or body set up for the purpose of

representing the interests of manufacturers, producers, suppliers of services, traders or consumers, and which may be party to the proceedings.

Any person is entitled to file an action in case of an application for revocation, Sec. 55 para. 2 No. 1 MarkenG.

8.4 What grounds of defence can be raised to a revocation action?

Grounds of defence include proof that the trade mark has been used, proof that the trade mark has not become a common name in the trade of the goods or services for which it is registered as a consequence of acts or inactivity of the proprietor, or proof that the trade mark is not liable to mislead the public particularly as to the nature, quality or geographical origin of those goods or services as a consequence of the use made of the trade mark by the proprietor or with his consent in respect of the goods or services in respect of which it is registered.

8.5 What is the route of appeal from a decision of revocation?

The special motion is available against the decisions of the Trade Mark Sections and Trade Mark Divisions of the DPMA, according to Sec. 64 MarkenG. The special motion shall be filed with the DPMA within one month of service of the decision. Please see question 3.4.

The DPMA's decisions may alternatively be appealed by means of an appeal to the Federal Patent Court according to Sec. 64 para. 6, Sec. 66 MarkenG.

In case the action for revocation has been brought and come to a final judgment by the court of first instance, appeals are the available remedy, Sec. 511 para. 1 German Code of Civil Procedure (ZPO).

An appeal shall be admissible only if the value of the subject matter of the appeal is greater than €600 or if, in its ruling, the court of first instance has granted leave to appeal.

9 Invalidity

9.1 What are the grounds for invalidity of a trade mark?

A trade mark may only be cancelled on grounds of invalidity under Sec. 50 para. 1 MarkenG if it lacks the capacity to be a trade mark (Sec. 3 MarkenG), if there are absolute grounds for refusal (Sec. 8 MarkenG) or if the applicant could not be the proprietor of a trade mark (Sec. 7 MarkenG), Sec. 50 para. 1 MarkenG.

In addition, a trade mark shall be cancelled on grounds of invalidity if it is opposed by earlier rights, Sec. 51 para. 1 MarkenG.

9.2 What is the procedure for invalidation of a trade mark?

For cancellation of a trade mark due to absolute grounds for refusal under Sec. 50 MarkenG, an application must be filed with the DPMA.

Invalidity due to the existence of earlier rights is asserted by means of an action before the court or an application to the DPMA, Sec. 51 para. 1 MarkenG.

The application for a declaration of invalidity due to absolute grounds for refusal (Sec. 50) and earlier rights (Sec. 51) shall be filed in writing with the DPMA. The facts and evidence serving as grounds shall be stated, Sec. 53 para. 1 MarkenG.

The DPMA shall inform the proprietor of the registered trade mark thereof and request him to declare his position on the request or the proceedings initiated *ex officio* within two months from the date of notification. If the proprietor does not oppose the cancellation on grounds of revocation or invalidity within the said period, the invalidity and the registration shall be cancelled. If the application for revocation is opposed within the time limit, the DPMA shall notify the applicant of the opposition. If the application for revocation is opposed within the time limit, the DPMA shall serve the opposition on the applicant. The revocation proceedings shall be continued only if the fee for the further prosecution of the revocation proceedings is paid within one month after service of the opposition. Otherwise, the revocation proceedings shall be deemed concluded, Sec. 53 paras 4, 5 MarkenG.

9.3 Who can commence invalidation proceedings?

The application for a declaration of invalidity on the grounds of absolute grounds for refusal may be filed by any natural or legal person, as well as by any association of interests of manufacturers, producers, service providers, traders or consumers which may be a party to the proceedings, Sec. 53 para. 2 MarkenG.

The application for a declaration of invalidity due to the existence of earlier rights may be filed by the proprietor of the rights referred to, Sec. 53 para. 3 MarkenG. The (potential) proprietor of the earlier rights is authorised to declare the action, Sec. 55 para. 2 No. 2 MarkenG.

9.4 What grounds of defence can be raised to an invalidation action?

This depends entirely on the individual grounds for invalidity put forward. These must be argued against accordingly.

9.5 What is the route of appeal from a decision of invalidity?

The declaration of invalidity and the associated deletion of the trade mark from the Register shall be ordered by the Trade Mark Division by way of a decision. This can be challenged by means of a special motion pursuant to Sec. 64 para. 1 MarkenG or by appeal to the Federal Patent Court pursuant to Sec. 66 para. 1 MarkenG.

10 Trade Mark Enforcement

10.1 How and before what tribunals can a trade mark be enforced against an infringer?

A trade mark can be enforced by its proprietor against an infringer before the regular courts in Germany by a preliminary injunction or a main action. According to Sec. 140 MarkenG, the Regional Courts have exclusive jurisdiction, irrespective of the value in dispute, over all actions in which a claim from one of the legal relationships regulated under this Act is asserted.

10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Out of court, the proprietor should send a warning letter demanding that the infringer ceases the infringement instantly

and provides a written cease-and-desist undertaking. This undertaking shall include the obligation to pay a contractual fine in and for any case of future violation of the undertaking.

If a preliminary injunction is to be applied for, the application for the injunction must be submitted within approximately one month, within the so-called “urgency period”, after the infringement has become known. Such an order of injunction can be issued very quickly without a hearing. If the court schedules a hearing, this will usually take place only a few weeks after the application is filed, given the urgency of the matter.

When the main action comes to court depends on the trade mark proprietor. There is no rigid deadline for this. However, the main action should be filed before the claims become time-barred, because otherwise the main action will be dismissed on the corresponding plea of the infringer.

In the main action, the duration of when it comes to a hearing depends on the individual case. In most cases, the court orders preliminary proceedings conducted in writing in which the parties exchange their arguments. It can take from a few weeks to a few months until the first hearing.

10.3 Are (i) preliminary, and (ii) final injunctions available and if so, on what basis in each case?

Yes. A trade mark infringement can be countered by way of preliminary injunction. The application for the injunction must be submitted within approximately one month, within the so-called “urgency period”, after the infringement has become known. If this deadline is not met, the matter would not be considered urgent by the court, and the application would be rejected.

A main action against trade mark infringement can be taken anytime. There is no rigid deadline for this. However, the main action should be filed before the claims become time-barred, because otherwise the main action will be dismissed on the corresponding plea of the infringer.

In the preliminary injunction, it is possible to obtain a quick decision, albeit a provisional one, since the main action may not be anticipated. In this way, a cease-and-desist order can be obtained. Claims for information and rendering account as well as claims for damages can only be asserted in the main action.

10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so, how?

This is rarely the case under German procedural law. It is conceivable that a corresponding order for evidence will be issued if, although party A bears the onus of proof, party A is unable to provide the relevant information or documents because, given the situation of the case, only party B has access to them.

In that case, party A must file a corresponding request for an order for evidence, stating and proving the relevant circumstances.

10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

The claimant has to file the complaint in writing. The defendant shall submit both the intention to defend and the statement of defence in writing. In most cases, the court orders preliminary proceedings conducted in writing in which the parties exchange their arguments.

German procedural law does not recognise cross-examination of witnesses (like in the U.S., for example).

10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

This possibility exists, but only under strict conditions. According to Sec. 148 ZPO, the court may, if the decision of the dispute depends either wholly or in part on the existence or non-existence of a legal relationship that is the subject of another pending dispute or is to be determined by an administrative agency, direct that the hearing be suspended until the other legal dispute has been dealt with and terminated or until the administrative agency has issued its decision.

However, in order to prevent the potential infringer from suspending the infringement action only by means of a simple cancellation action, a suspension of proceedings pursuant to Sec. 148 ZPO may be considered with regard to pending cancellation proceedings according to the jurisdiction of the BGH only if the cancellation of the trade mark is precedent and there is a certain probability for the cancellation of the trade mark in the registration proceedings that justifies the delay of proceedings associated with the suspension.

10.7 After what period is a claim for trade mark infringement time-barred?

Claims for trade mark infringement become time-barred after three years, according to Sec. 20 MarkenG, Sec. 195 German Civil Code (BGB). This three-year period begins at the end of the year in which the claim arose and the trade mark proprietor obtains knowledge of the circumstances giving rise to the claim and of the identity of the infringer, or would have obtained such knowledge if he had not shown gross negligence, Sec. 199 para. 1 BGB. Notwithstanding knowledge or a grossly negligent lack of knowledge, claims for trade mark infringement become time-barred 10 years after they arise, Sec. 199 para. 3 BGB.

10.8 Are there criminal liabilities for trade mark infringement?

Yes. According to Secs 143, 143a, 112, 124 MarkenG, intentional trade mark infringement is a criminal offence and shall be liable to imprisonment of up to three years or a fine. If the infringer acts on a commercial basis or as a member of a gang, the penalty shall be imprisonment of between three months and five years.

10.9 If so, who can pursue a criminal prosecution?

Punishable trade mark infringement shall be prosecuted upon motion only (except if the infringer has acted on a commercial basis or as a member of a gang), unless the criminal prosecution authorities consider *ex officio* intervention imperative on account of the particular public interest in criminal prosecution.

10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

Should the trade mark proprietor have issued an unjustified warning letter, there is the risk of a counter-warning for which the trade mark proprietor must bear the costs, as well as the risk that claims for damages will be asserted. If an infringement action is unfounded, the trade mark proprietor as plaintiff bears the costs of the action. At the same time, there is the risk that the opponent will assert claims for damages, depending on the situation in the individual case.

11 Defences to Infringement

11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Here, it can be argued that there is no likelihood of confusion between the (allegedly) infringed trade mark and the (allegedly) infringing trade mark as there is no similarity between both marks and/or no similarity between the claimed goods and services.

11.2 What grounds of defence can be raised in addition to non-infringement?

It is recommended to try to proceed against the (allegedly) infringed trade mark and to attack it. For example, one can proceed by means of an application for invalidity (see section 9). Besides that, trade mark registration can be revoked and cancelled upon request if the trade mark has not been used within a period of five years after registration, Sec. 49 MarkenG. The alleged infringer may argue a reasonable interest in free use of his own name, address or descriptive indications concerning characteristics of the goods and services, such as the kind, quality, quantity, intended purpose, value, geographical origin and time of production, Sec. 23 MarkenG. The alleged infringer may raise the defence that claims for trade mark infringement are time-barred or subject to forfeiture according to Sec. 21 MarkenG and can claim exhaustion of trade mark rights according to Sec. 24 MarkenG. In case the defendant owns prior rights that might be viewed as confusingly similar to the plaintiff's rights, he may file a cancellation action against the plaintiff's rights, among other possibilities.

12 Relief

12.1 What remedies are available for trade mark infringement?

There is a final injunction to cease and desist that can only be enforced against the defendant in the infringement action. The trade mark proprietor can recover damages compensation or unjust enrichment (if there is no intent or negligence by the defendant). There is relief for a recall of the infringing products or final withdrawal of them from the distribution channel and for the destruction of infringing goods. There also exist remedies of rendering information by the infringer (distribution chain, sales numbers and turnover) and, in certain circumstances, rendering of information by third parties. There is also a claim for presentation of bank, financial and commercial documents in the possession of the infringer to secure enforcement of a claim for damages compensation in commercial infringements. Finally, there is relief for publication of the court decision. Criminal remedies are a fine or imprisonment.

12.2 Are costs recoverable from the losing party and if so, how are they determined and what proportion of the costs can usually be recovered?

Yes. According to Sec. 91 ZPO, the party that has not prevailed in the dispute is to bear the costs of the legal dispute, in particular any costs incurred by the opponent, to the extent these costs were required in order to bring an appropriate action or to appropriately defend against an action brought by others. The compensation of costs also comprises compensation of the

opponent for any necessary travel or for time the opponent has lost by having been required to make an appearance at hearings. Where each of the parties has prevailed for a part of its claim but has not been able to enforce another part of its claim in the dispute, the costs are to be cancelled against each other or shared proportionately. Which party is to be reimbursed for which costs is determined in the cost assessment order.

13 Appeal

13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

An appeal with the Higher Regional Court is admissible against judgments of the District Courts in trade mark cases (first instance), Sec. 511f. ZPO. This is not limited to the mere review of legal infringements. It can also be taken into account that facts and circumstances that have been used as a basis justify a different decision.

13.2 In what circumstances can new evidence be added at the appeal stage?

In principle, the submission of new evidence cannot be raised in the appeal if it could already have been raised in the first instance (preclusion). According to Sec. 531 para. 2 ZPO, new means of attack and defence are only admissible under the following conditions:

1. a point of view is involved that was recognisably overlooked or considered irrelevant by the court of first instance;
2. the new plea in law was not raised at first instance as a result of a procedural defect; or
3. the new plea was not raised at first instance at no fault of a party.

14 Border Control Measures

14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and if so, how quickly are such measures resolved?

Under the Customs Enforcement Regulation, a trade mark proprietor can apply for customs monitoring and seizure of goods imported from or exported to countries that are not Member States of the EU or the European Economic Area (EEA). Under German law, a trade mark proprietor can apply for customs monitoring and seizure of goods imported from or exported to Member States of the EU or EEA. In practice, proceedings under the Customs Enforcement Regulation are far more common than national proceedings, as cross-border trade in the EU or EEA is generally no longer subject to customs control. Activities that happen outside Germany and have no impact on German territory cannot support infringement or dilution proceedings in Germany.

15 Other Related Rights

15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Apart from registration, trade mark protection may arise from the use of a sign in the course of trade, provided that the sign has acquired a reputation as a trade mark among the public

concerned, or from the well-known character of a trade mark within the meaning of Article 6*bis* of the Paris Convention for the Protection of Industrial Property, Sec. 4 Nos 2, 3 MarkenG.

Although trade mark protection may also accrue without registration, obtaining a trade mark registration is beneficial for, *inter alia*, the following reasons: use of a registered trade mark is not necessary to be proven (unless the trade mark is subject to the use requirement). It shall be presumed that the party recorded in the Register as the proprietor is entitled to the right arising from the registration of a trade mark, Sec. 28 para. 1 MarkenG. Regarding litigation, in case of unregistered rights, the burden of proof lies with the plaintiff.

15.2 To what extent does a company name offer protection from use by a third party?

Company names are also protected, Sec. 1 No. 2, Sec. 5 paras 1, 2 MarkenG. In principle, protection arises automatically from the first use of the name in the course of trade; an entry in the Register is not necessary. A prerequisite in all cases is that the designation has distinctive character. This requirement is not fulfilled if the company name is only formed from purely descriptive industry terms.

The acquisition of protection for a company name confers an exclusive right on its proprietor: third parties are prohibited from using the company name or a similar sign in the course of trade without authorisation in a manner that is likely to cause confusion with the protected name. If the company name is a well-known company name in Germany, third parties shall also be prohibited from using the company name or a similar sign in the course of trade if there is no likelihood of confusion, provided that use of the sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute of the company name. A person who uses a company name or a similar sign may be sued by the proprietor of the company name for injunctive relief if there is a risk of repetition. Anyone who commits the act of infringement intentionally or negligently is obliged to compensate the proprietor of the commercial designation for the resulting damage, Sec. 15 MarkenG.

However, if two identical or confusingly similar company names are used side by side for years and no objections are raised by either side, the possibility of enforcing one's own rights to the company name may be forfeited. In addition, all persons are entitled to use their family name in a fair manner as a commercial designation in business dealings. Therefore, in such a case, a previously existing company name with the same name cannot be given priority without further ado; the principle of priority is limited in this respect. In such cases, a balance of interests must be achieved between the entitled parties. As a rule, the party having priority must do everything necessary to avoid confusion or reduce it to a reasonable level. In principle, business signs, i.e., names, companies and commercial designations, are protected throughout Germany. Something else applies if the company's field of activity is limited to a certain place or region. This is usually the case in particular with restaurants, hotels, pharmacies, smaller local retailers or regionally active service providers.

15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Yes, further commercial designations such as titles of works, Sec. 1 No. 2, Sec. 5 No. 3 MarkenG, or indications of geographical origin, Sec. 1 No. 3, Sec. 126f. MarkenG.

16 Domain Names

16.1 Who can own a domain name?

A domain name with the top-level domain “.de” can be registered with the Deutsche Network Information Center (DENIC eG). Since, in the case of registration, a contractual relationship always arises between the domain holder and DENIC as the registry, only those who have legal personality can register a domain: natural persons, legal persons or partnerships, insofar as they are equipped with the capacity to acquire rights and enter into liabilities. If the future domain holder is not domiciled in Germany, he or she must appoint an authorised recipient who is resident or has business premises in Germany.

16.2 How is a domain name registered?

Registration of a “.de” domain can be carried out by any provider who is either a member of DENIC itself or who cooperates with one of its members. Direct registration with DENIC is also possible.

16.3 What protection does a domain name afford *per se*?

No protection *per se*. It depends on the domain name’s use. The domain name can be used as a trade mark, company name or work title.

16.4 What types of country code top-level domain names (ccTLDs) are available in your jurisdiction?

For Germany, the only available ccTLD is “.de”.

16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Yes. If a “.de” domain name is considered infringing, application can be made to DENIC for a so-called “DISPUTE entry”.

The effect of a DISPUTE entry is that the domain cannot be transferred to a third party, but that the person who has applied for and received the DISPUTE entry automatically succeeds as the holder in the event of the domain being deleted.

The prerequisites for the DISPUTE entry are that, within one month prior to application for the DISPUTE entry, an inquiry must have already been made to DENIC about the holder of the domain and that the dispute with the domain holder is already ongoing or will start shortly.

The request must be submitted to DENIC by means of a form or the online form. The application must be accompanied by information about the current domain holder and documents that provide evidence that the applicant has a right to the domain, such as an excerpt from the Trade Mark Register or the Commercial Register.

DENIC checks the application and – if approved – informs the applicant of when the DISPUTE entry is valid until, a maximum of one year. An extension can be requested if the dispute with the domain holder continues and the DISPUTE holder can prove this.

A DISPUTE entry is free of charge.

17 Current Developments

17.1 What have been the significant developments in relation to trade marks in the last year?

The Trade Mark Law Modernisation Act entered into force on 14 January 2019 and brought about a number of significant changes in German trade mark law. The change in representation of a trade mark application aims to meet market needs for modern trade mark types and also takes into account the technical possibilities of representing a trade mark in electronic registers. Therefore, sound marks, multimedia marks, holograms and other types of trade marks in suitable electronic formats may also be registered as trade marks. Furthermore, the certification mark has been introduced into German trade mark law. The main feature of the certification mark is that, unlike the individual trade mark, it does not focus on the function of the trade mark as an indication of origin but on the guarantee function.

The certification mark enables neutral certification companies to obtain trade mark protection in Germany for quality seals or test labels on the basis of which an international extension of protection will also be possible. It is now possible to claim relative grounds for refusal (earlier rights) in official invalidity proceedings in addition to absolute grounds for refusal. Furthermore, the former formal preliminary procedure with regard to revocation declarations has been converted into revocation proceedings before the DPMA. Licences are entered in the Register upon request. In addition, upon request, trade mark applicants and proprietors may have an entry included in the Register about a non-binding declaration of their willingness to license, sell or transfer their trade mark. The DPMA has now brought the calculation of the duration of protection in line with the practice of the European Union Intellectual Property Office. The 10-year duration of protection of trade marks registered on or after 14 January 2019 starts on the day following the filing of the trade mark application and, as a rule, ends on the expiry of the day that corresponds in designation or number to the filing date. For trade marks registered before 14 January 2019, the duration of protection ends, as before, at the end of the month. Furthermore, the system applied to opposition proceedings has changed. In the past, filing an opposition was only possible on the basis of an opposing sign; the holder of several earlier rights is now able to assert them by lodging a single opposition.

In order to facilitate negotiations between the parties to the proceedings, a period of at least two months will be granted at their joint request to reach an amicable settlement (cooling-off). This period may be extended by a joint request. The five-year period for which proof of use of the opposing trade mark must be furnished begins five years before the filing date or the priority date of the challenged trade mark, instead of the five years before the date of publication of the registration of the challenged trade mark, as currently applicable. Thus, the period of use that must be proved corresponds to the rule in EU trade mark law. The grace period for use will commence on the date when no further opposition can be filed against the registration of a trade mark. This is either the day after expiry of the opposition period, the date on which the decision that concluded the opposition proceedings becomes final, or withdrawal of the (last) opposition.

17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

- BGH, judgment dated 13 October 2022 – I ZB 59/19 – *Kosten des Patentanwalts VII*: additional patent attorney fees in legal

trade mark disputes are only reimbursable if involvement of the patent attorney was necessary for appropriate legal proceedings.

- BGH, judgment dated 12 January 2023 – I ZR 86/22 – *DACHSER*: this case concerned whether the use of a logistics company’s trade mark by printing it on realistic replicas of model lorries and a model warehouse infringed the logistics company’s trade mark rights. The BGH stated that although the trade mark was exploited, this exploitation was not unfair. There is a legitimate interest in reproducing a vehicle that exists in reality; “unfair advantage” within the meaning of Sec. 14 para. 2 sentence 1 No. 3 MarkenG only applies if an attempt is made to exploit the reputation of the well-known trade mark for advertising purposes in a way that goes beyond the mere true-to-life representation. However, the Higher Regional Court of Hamburg (OLG Hamburg) took a different view.
- OLG Hamburg, judgment dated 26 January 2023 – 5 U 61/21 – *VW Bulli*: the court affirmed not only the likelihood of confusion pursuant to Sec. 14 para. 2 sentence 1 No. 2 MarkenG, but also unfair exploitation of reputation pursuant to Sec. 14 para. 2 sentence 1 No. 3 MarkenG with regard to the use of VW’s shape mark “Bulli” for toy cars. Due to the great popularity of the “Bulli” as “the cult transporter” from the company of the plaintiff, the targeted public, if it encounters the two-dimensional sign, for example, on printed products, keyrings or toys (in a trade mark-like manner), will obviously draw a direct conclusion as to the manufacturer of the “Bulli”, thus (also) perceiving the sign as a company reference. Significant parts of the relevant public would expect licence relationships, which is sufficient for the assumption of a likelihood

of confusion and the impairment of the function of origin. There is no legitimate interest of the toy manufacturer to use the car manufacturer’s trade mark without licensing. An appeal against this decision has been lodged with the BGH.

17.3 Are there any significant developments expected in the next year?

Since a major reform of trade mark law took place in 2019, comparably significant developments are not expected for the time being.

Nevertheless, the (European) Artificial Intelligence Act will of course keep us busy in the trade mark sector.

17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

Following the BGH’s ruling at the end of 2022 that the obligee can reject a cease-and-desist undertaking and thus the risk of recurrence remains (see previous issue), the BGH has now dealt with another aspect that is relevant in practice: the BGH found (BGH, judgment of 12 January 2023, I ZR 49/22, GRUR 2023, 742) that a signed cease-and-desist undertaking, which a merchant sent by email as a PDF file rather than the original in the context of his commercial business, is effective and sufficient to eliminate the risk of recurrence (if the obligee accepts the declaration). The written form requirement does not exist if the cease-and-desist undertaking is made by a merchant in the context of his commercial business.



Bettina Hart advises and represents national and international clients in areas of intellectual property law, with a focus on unfair competition and trade mark law as well as employee invention compensation law.

Her activities include out-of-court and in-court enforcement of trade mark infringements and prohibitions of unfair business practices, also by way of interim relief.

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Meissner Bolte is a fully integrated IP boutique providing legal services in all areas of intellectual property. For many years, Meissner Bolte has been one of the leading applicants for European trade marks, international applications and designs as well as one of the leading country representatives for European trade marks, international applications and designs at EUIPO. Meissner Bolte is one of the largest specialised IP boutiques in Germany. A team of currently four highly specialised Attorneys-at-Law (*Rechtsanwältinnen*) and 10 Paralegals around Oliver Nilgen comprehensively advises clients on trade mark and design law issues. It is not without reason that Meissner Bolte is one of the most active applicants at EUIPO in Europe. With a total of 350 employees, Meissner Bolte is able to handle trade mark and design portfolios of any size.

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