

Information Sheet "Trademark Application National"

I. General Information

The success of a product does not only depend on its price or quality, but rather to a great extent on its image. The reputation of the product and its producer respectively are especially important when the qualitative or technical standards of competing products have reached the same level.

A trademark is a means to distinguish competing products or services from each other. The trademark of a company represents a palpable "business card" to the customer and serves him as an orientation in a complex product assortment. Thus, the trademark enables a customer to recognize a specific product and enables him to buy more of it. The trademark is also a profit-promoting hallmark which guarantees consistent and original good quality. The more well-known a trademark is, the more competitors will have an incentive to copy or approximate it. These intentions can only be foiled if trademarks are timely filed for registration.

Without a registration, the legitimate user of the trademark is unprotected: when a competitor enters the market with a comparable product with the same trademark, usually the "creator" of the trademark is unable to prohibit the use of the plagiarism. An even worse scenario is the following: if the imitator has this unprotected trademark registered for himself, he may, under certain circumstances, even prohibit the original creator of trademark from any further use.

The registration of a trademark offers the holder significant advantages: thus, third parties are prohibited to use in commerce a sign identical or confusingly similar to the registered trademark for identical or similar goods or services as the ones for which the registered trademark is protected.

After successful registration of a trademark, the owner or his licensee is allowed to use his trademark marked with the symbol "®" which is perceived by customers as a sign of quality on the one hand, and by competitors and potential plagiarists as a deterrent warning sign on the other hand.

Companies providing services such as hotels, travel agencies, banks, driving schools or transportation companies may have their signs registered as a servicemark.

II. Signs acceptable for registration

A trademark registration may be obtained for signs used by companies for distinguishing their goods and services such as word marks, design marks or combinations thereof.

Thus, signs consisting of letters and numerals and their combination, words (especially personal names), graphical representations, characteristic melodies, trade dress such as colors and color combinations as well as three-dimensional designs including the shape of the product and its packaging can be protected. In this manner, almost all types of signs can be protected from misuse through competitors by registration as a trademark.

A few examples: the word mark "Harley-Davidson", the Mercedes star logo or Lufthansa's crane logo, the Bayer-cross which consists of a combination of word and design elements, well-known radio melodies framing traffic announcements as sound marks, the McDonald's "M" design mark, the numerals "4711" for eau-de-Cologne ("Kölnisch Wasser").

III. Signs unacceptable for registration

Word signs that are simply describing a characteristic trait of the product for which they are used may not be registered, such as "waterproof" or "compact flash" (cameras) and generally advertising terms, such as "super" or "top". Basic geometrical shapes such as circles, squares, and triangles are not allowed for registration on their own either.

Prior to filing a trademark application for you we will examine the projected trademark on this point as well as on the other so-called 'absolute grounds for refusal'. Unfortunately, a certain amount of risk that a trademark application will be rejected on absolute grounds of refusal can never be fully eliminated.

To our experience, the minimum requirements for a sign to be registered as a trademark have been lessened by the competent official examining authorities during the last few years. Therefore, it is possible that trademarks that have been rejected a couple of years ago, now may be admitted for registration. Please let us know if you are interested in receiving more information on this matter.

IV. Validity

The registration of trademarks is initially valid for ten years from the date of filing the application and may be subsequently extended every ten years upon payment of the prescribed renewal fee.

V. Registration Procedure and Costs

Trademarks are territorial IP rights that are registered with the national Patent and Trademark Offices, e.g. the German Patent and Trademark Office DPMA, the UK Intellectual Property Office UKIPO, or the Intellectual Property Office of Singapore IPOS. Apart from a graphical representation of the trademark itself, the trademark application includes a classified list of the goods and services for which the trademark is or is going to be used.

After examination by the IP Office, the trademark is registered and published in the Official Trademarks Gazette.

For costs of national trademark applications, please refer to our individual fee schedules.

Please note that higher expenses may be incurred if more goods and services are claimed, if more than one simple Office action has to be responded to, or if an opposition against the registration is raised by a third party etc.

VI. Search for Elder Rights of Third Parties

In order to reduce the risk of an unsuccessful trademark application, we strongly recommend carrying out a search for possibly conflicting elder trademark registrations prior to the filing of a new trademark application.

Such a search for prior rights of third parties is also advisable, because the use of a trade mark may infringe elder rights of third parties whereby the holder exposes himself to claims against him, especially cease-and-desist claims. A slight negligence on the holder's side is already sufficient to constitute claims for damages as well. In this context, the courts generally hold that already the filing of a trade mark application constitutes a sufficient menace of actual use of the sign applied for and therefore a trade mark infringement.

If you need information about trademark searches, please feel free to contact us.

VII. International Registration

A six-month priority period begins with the date of filing of the first trademark application. If subsequent identical applications are filed abroad during this period, then the date of filing of the first registration may be claimed as priority date for subsequent applications. Because of this limited timeframe, the international applications should best be filed simultaneously with the application for the national trademark or shortly after it.

The possibility to apply for a European Trademark registration, the European Union's Community Trademark, represents an attractive possibility to cover the entirety of the European Union (now 25 European countries) with a single trademark registration. Apart from a national trademark, the Community Trademark is a first-class option for expanding firms, as it provides its holder with the possibility to expand his business activity bit by bit over the whole EU market under the protection of a single trademark. This is possible because a valid use of a Community Trademark in just one of the EU member states maintains validity of this trademark in all other EU member states. Because of the territorial character of trademark rights, single trademarks registered nationally in several EU member states would have necessarily to be used in every single country. Otherwise, the trademark registration may successfully be challenged by third parties on grounds of subsequent non-use and consequently be cancelled.

If you are interested in further information about International Registrations or EU trademark registrations, we would be pleased to provide you with our information leaflet about International Trademark Applications.

VIII. Internet Domains

It is also possible to apply for an internet domain such with a second level domain identical to your trademark, as e.g. "www.yourtrademark.de" or "www.yourtrademark.com". We would be pleased to supply you with further information about this possibility upon request.

In case that you are interested in an internet domain, please let us know as soon as possible. In the past, it has often been a matter of only a few days whether an internet domain was still available for registration or not.

Finally, we would like to draw your attention to the fact that if you have an internet domain reserved and connected for you in cooperation with a so-called internet provider, you should be completely sure that you yourself are registered as the owner of the internet domain and not a third party. If you do not have this kind of expertise available to you, we would strongly suggest that you make use of legal assistance when you an internet domain reserved, connected and administered, so that your rights and interests are protected.