INTELLECTUAL PROPERTY

IP-GÖTZ®

PATENT ATTORNEYS
Dipl.-Ing. Georg Götz
Dipl.-Phys. Thomas Till

ATTORNEY AT LAW
Jürgen Veh *Certified IP Lawyer*

PATENT PROFESSIONAL
Dr. Ph.D. Dirk Bokern

In cooperation with
PATENT ATTORNEY
Dipl.-Ing. Steffen Baur

Königstraße 70
Am Literaturhaus
90402 **Nuremberg**
Telefon: (0911) 89138-0
Telefax: (0911) 89138-29

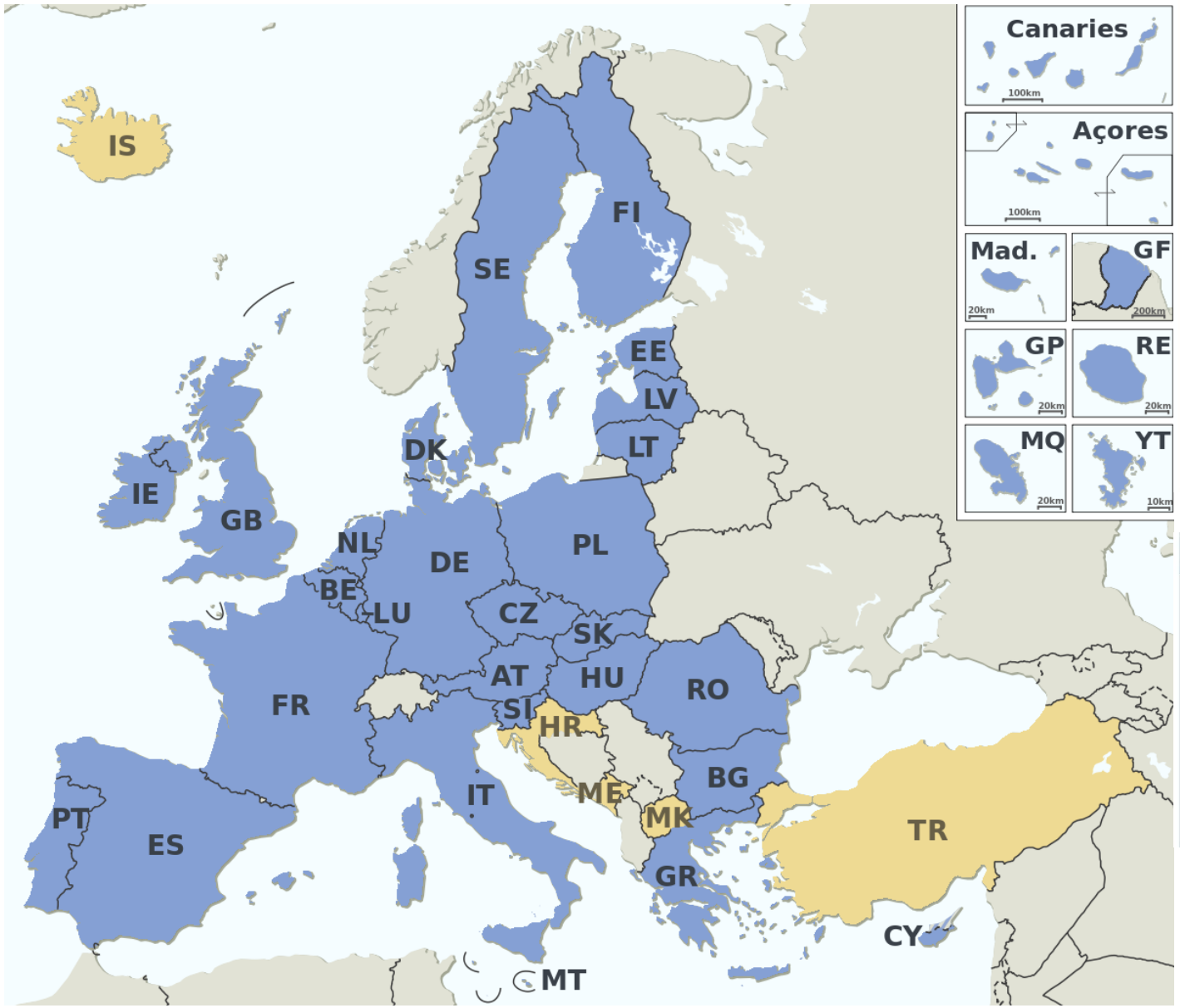
Am Stein 12
D-97080 **Würzburg**
Telefon: (0931) 286410
Telefax: (0931) 282597

E-Mail: info@ip-goetz.de
Internet: www.ip-goetz.de

OVERVIEW AND PRACTICAL ASPECTS OF THE EUROPEAN COMMUNITY TRADEMARK AND COMMUNITY DESIGN

Speaker: Attorney at Law Jürgen VEH
Certified IP-Lawyer
Intellectual Property IP-Götz
Patent- und Rechtsanwälte
Nuremberg - Würzburg

THE EUROPEAN COMMUNITY 2011



Member states of the EU (year of entry)

- Austria (1995)
- Belgium (1952)
- Bulgaria (2007)
- Cyprus (2004)
- Czech Republic (2004)
- Denmark (1973)
- Estonia (2004)
- Finland (1995)
- France (1952)
- Germany (1952)
- Greece (1981)
- Hungary (2004)
- Ireland (1973)
- Italy (1952)
- Latvia (2004)
- Lithuania (2004)
- Luxembourg (1952)
- Malta (2004)
- Netherlands (1952)
- Poland (2004)
- Portugal (1986)
- Romania (2007)
- Slovakia (2004)
- Slovenia (2004)
- Spain (1986)
- Sweden (1995)
- United Kingdom (1973)

Candidate countries

- Croatia
- Former Yugoslav Republic of Macedonia
- Iceland
- Montenegro
- Turkey

Source: europa.eu

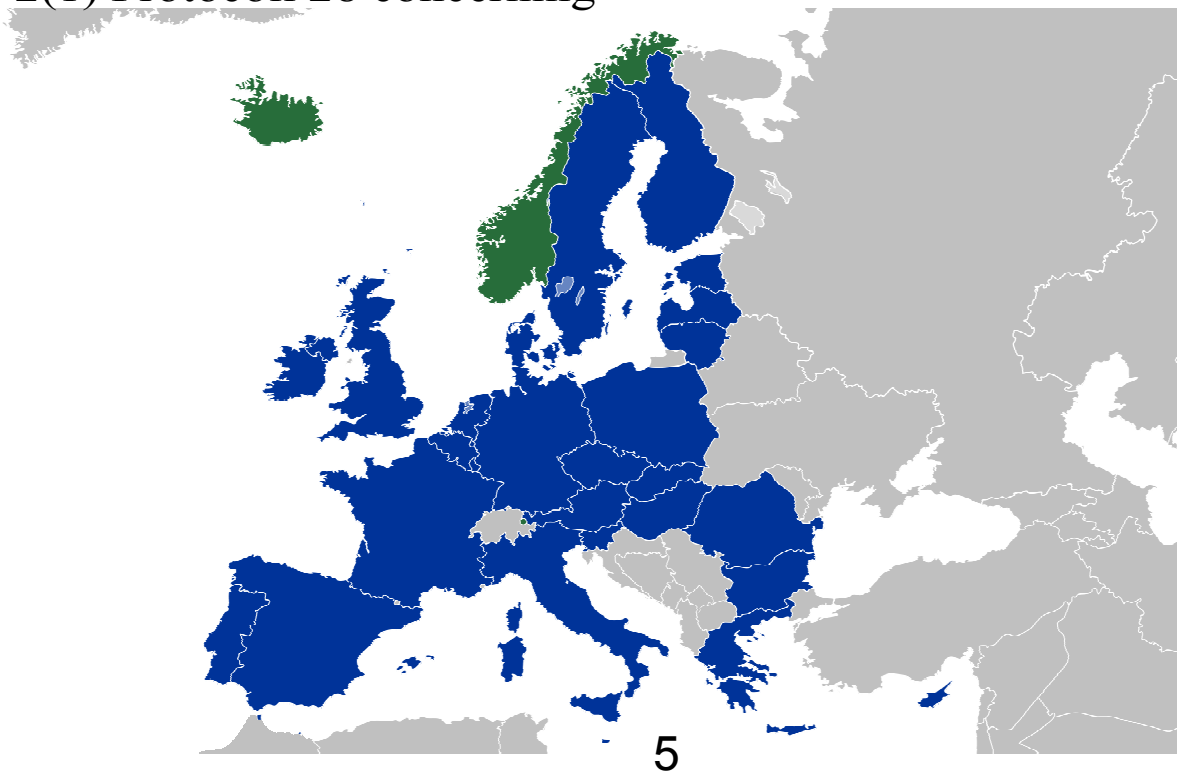
© European Union

WHAT THE COMMUNITY TRADEMARK AND DESIGN SYSTEM HAVE IN COMMON

- UNIFORM LAW
- EXISTING PARALLEL TO NATIONAL TRADEMARK AND DESIGN LAW
- VALID FOR THE WHOLE EUROPEAN COMMUNITY
  (but not other European states like CH, NO, etc.)
- VALUE
  - a single application
  - a single language
  - a single administrative centre
  - a single file to be managed / renewal fees
  - right enforcement
  - automatic extension to new member states without formality fee/request in case of enlargement of EC
- DOWNSIDE
  - deletion requests concern the CTM or RCD as a whole (at the first place)

EXHAUSTION OF RIGHTS

- not worldwide but for the whole EC (Article 13 CTM Regulations / Artikle 21 CD Regulations)
- and for the EEA (European Economic Area) including **Iceland, Norway, and Liechtenstein** (Article 65 (2) EEA Treaty + Article 2(1) Protocoll 28 concerning intellectual property rights)



THE COMMUNITY TRADEMARK SYSTEM

ARTICLE 6

A Community trade mark shall be obtained by registration.

TRADEMARK BY USE AND OR REPUTATION AND OTHER IP-RIGHTS LIKE COMPANY NAME RIGHTS, WORK TITLES, etc. ARE SUBJECT TO NATIONAL LEGISLATION ONLY (AND HAVE NOT BEEN SUBJECT TO HARMONIZATION)

NEITHER USE NOR INTENTION TO USE IS REQUIRED FOR REGISTRATION

- COMMUNICATION NO 4/03 OF THE PRESIDENT (JUNE 2003):

> ...The 34 classes for goods and the 11 classes for services comprise the totality of all goods and services. As a consequence of this the use of all the general indications listed in the class heading of a particular class constitutes a claim to all the goods or services falling within this particular class...

Trade mark name : MERCEDES BENZ
Trade mark No : 000140400
Trade mark basis: CTM
Date of receipt : 30/03/1996
Number of results: 7 of 9

Request an inspection

Trade mark

Filing date: 01/04/1996
Date of registration: 01/12/1998
Expiry Date: 01/04/2016
Nice Classification: 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42 (Nice classification)
Trade mark: Individual
Type of mark: Figurative
Vienna Classification: 1.1.2, 1.1.8, 5.3.20, 24.3.7 (Vienna Classification)
Acquired distinctiveness: No
Applicant's reference: 28
Status of trade mark: Registered (Glossary)
Publication of registration
(Publication B1 or Publication B2)
(History of statuses)
Filing language: German
Second language: English

Graphic representation

List of goods and services	Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.
Nice Classification: **List of goods and services**	4 Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles, wicks.
Nice Classification: **List of goods and services**	5 Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants.
Nice Classification: **List of goods and services**	6 Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of metal, included in class 6; ores.
Nice Classification: **List of goods and services**	7 Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements; incubators for eggs.
Nice Classification: **List of goods and services**	8 Hand tools and implements (hand operated); cutlery; side arms; razors.
Nice Classification: **List of goods and services**	9 Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.
Nice Classification: **List of goods and services**	10 Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials.
Nice Classification: **List of goods and services**	11 Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.
Nice Classification: **List of goods and services**	12 Apparatus for locomotion by land, air or water.
Nice Classification: **List of goods and services**	13 Firearms; ammunition and projectiles; explosives; fireworks; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware (included in class 21).

5 YEAR PERIOD FOR ASSESSING GENUINE USE

IF AND FOR THOSE GOODS AND SERVICES FOR WHICH THE CTM HAS NOT BEEN PUT TO GENUINE USE WITHIN 5 YEARS AFTER REGISTRATION (GRACE PERIOD) OR FOR LONGER THAN 5 CONSECUTIVE YEARS

- THE CTM IS VULNERABLE TO REVOCATION REQUESTS AND
- CAN NOT BE ENFORCED AGAINST THIRD PARTIES

HOWEVER:

- PUTTING THE CTM TO GENUINE USE IS POSSIBLE AT ANY TIME
- USE IN A MAJOR PART OF THE EC IS SUFFICIENT (recently application lodged at the Registry of the Court of Justic)

SENIORITY CLAIM

Pursuant to Articles 34 and 35 CTMR the applicant/proprietor of a CTM may claim seniority of an earlier national trademark registration in a member state within 2 months from filing or following the registration of the CTM.

REQUIREMENT: TRIPLE IDENTITY

- Where the owner of the earlier national trademark surenders or allows it to lapse, he shall be deemed to continue to have the same rights as he would have had if the earlier national trademark had continued to be registered.
- Seniority effect takes place only after deletion of older national trademark unless deletion is subject to successful attack against the national trademark

CONVERSION

By request to the OHIM owner/applicant may ask for conversion into national trademark applications (Article 112 (1) CTMR

- OHIM will forward the request to the national offices concerned and delete the CTM/application
- National office will handle converted CTM like national application
    - Payment of national application fee
    - Translation where applicable
    - Indication of address for services
- No conversion possible
    - where revokation of the CTM is based on non-use or
    - where revokation of the CTM is based on an older right, which is also valid for the concerned member state

THE COMMUNITY DESIGN

Article 1 Community design

2. A design shall be protected:

(a) by an "**unregistered Community design**", if made available to the public in the manner provided for in this Regulation;

(b) by a "**registered Community design**", if registered in the manner provided for in this Regulation.

REGISTERED COMMUNITY DESIGN (RCD)	UNREGISTERED COMMUNITY DESIGN (UCD)
5-25 years from filing date	3 years from disclosure
	First disclosure must take place within EC (Article 11, 1)
Protection against any younger design with the same overall impression (except where publication is deferred = Art. 19 Nr. 3)	Protection only in case of copying – Art. 19 Nr. 2 (knowledge + intention)
Protection of parts of the design only if the parts are also registered	Protection of parts of the design

REQUIREMENTS OF PROTECTION

A design shall be protected to the extent that it is **new** and has **individual character** (Article 4).

- A design is **new** if no identical design has been made available to the public (Article 5).

- A design has **individual character** if the overall impression it produces on the informed user differs from the overall impression of an earlier design (Article 6).

Important:

- Novelty and individual character are not examined during registration proceeding.
- Assessment is not based on a combination of older designs;

THE OVERALL IMPRESSION

DISCLOSURE

Article 7

Paragraph 1.

- For the purpose of applying Articles 5 and 6, a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, before the date referred to in Articles 5(1)(a) and 6(1)(a) or in Articles 5(1)(b) and 6(1)(b), as the case may be,
- except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community.
- The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.

Problems:

- How to define the „specialised circles“?

- „Specialised circles“ concerning the older or the younger design?

- „normal course of business“?
(Internet, a US or CA fair; local distribution?)

12 MONTH GRACE PERIOD

Article 7 Disclosure

Paragraph 2.

A disclosure shall not be taken into consideration for the purpose of applying Articles 5 and 6 and if a design for which protection is claimed under a registered Community design has been made available to the public:

(a) by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer or his successor in title; and

(b) during the 12-month period preceding the date of filing of the application or, if a priority is claimed, the date of priority.

12 MONTH GRACE PERIOD

- THE GRACE PERIOD IS NOT TO BE CONFUSED WITH THE PRIORITY CLAIM OF ARTICLE 4 PARIS CONVENTION

- UNSOLVED PROBLEMS:

- **Prototype/preliminary model**
- **Effect on scope of protection of "only similar disclosures"**

(*Article 10, Paragraph 2 = In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration*)

- **Effect on priority claim for later non-EU design applications**

- RECOMMENDATION:

- **Make use of 12 month grace period only if not avoidable**
- **Make a collective application and register the prototype and the end product**

MULTIPLE APPLICATIONS

Article 37 Paragraph 1

Several designs may be combined in one multiple application for registered Community designs. Except in cases of ornamentation, this possibility is subject to the condition that the products in which the designs are intended to be incorporated or to which they are intended to be applied all belong to the same class of the International Classification for Industrial Designs.

MULTIPLE APPLICATIONS

REQUIREMENT - SAME LOCARNO CLASS

(except ornamentations)

COSTS:

Costs of a Community Design Application

a) Without deferment of the publication

	Official Fees	Attorney´s Fees	**Total estimate per design**
1. Design	350,00	500,00	**850,00**
2.-10 Design, each	175,00	100,00	**275,00**
11-X Design, each	80,00	50,00	**130,00**

b) With deferment of the publication

	Official Fees	Attorney´s Fees	**Total estimate per design**
1. Design	270,00	500,00	**770,00**
2.-10 Design, each	135,00	50,00	**185,00**
11-X Design, each	60,00	25,00	**85,00**

Not later than after 30 months, it is required to remargin the publication fee for the designs that are to be maintained.

	Official Fees	Attorney´s Fees	**Total estimate per design**
1. Design	120,00	50,00	**170,00**
2.-10 Design, each	60,00	50,00	**110,00**
11-X Design, each	30,00	25,00	**55,00**

21 000389986-0001
25 DE - EN
22 23/08/2005
15 23/08/2005
45 04/10/2005
11 000389986-0001
73 Günter Brötzmann
Kleinharbach 9
D-97215 Uffenheim
ALEMANIA
74 INTELLECTUAL PROPERTY GÖTZ PATENT- UND RECHTSANWÄLTE
Färberstr. 20
D-90402 Nürnberg
ALEMANIA
51 30 - 02
54 ES - Pajareras

CS - Voliéry

DA - Volierer

DE - Volieren

ET - Lindlad

EL - Πτηνοτροφεία·

EN - Aviaries

FR - Volières

IT - Voliere

LV - Putnu mājas

LT - Paukštidės

HU - Madárröptetők

MT - Guvi

NL - Volières

PL - Ptaszarnie

PT - Aviários

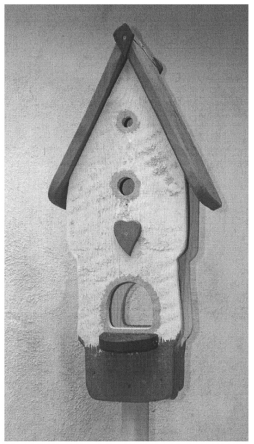
SK - Voliéry

SL - Ptičnice

FI - Suuret lintuhäkit

SV - Fågelhus

55



0001.1

0001.2

MULTIPLE APPLICATION

RCD-ONLINE - Design consultation service - List of results

International registrations of industrial designs administered by WIPO can now provide protection for the entire EC. Consult the Hague Express Database by clicking here.

Search results: 28

1 000389986-0001

Name of owner: Brötzmann, Günter
Filing date: 23/08/2005
Locarno class-subclass: 30.02
Verbal element:
Indication of the product: Aviaries
Status: Registered and fully published (A1)

2 000389986-0002

Name of owner: Brötzmann, Günter
Filing date: 23/08/2005
Locarno class-subclass: 30.02
Verbal element:
Indication of the product: Aviaries
Status: Registered and fully published (A1)

3 000389986-0003

Name of owner: Brötzmann, Günter
Filing date: 23/08/2005
Locarno class-subclass: 30.02
Verbal element:
Indication of the product: Aviaries
Status: Registered and fully published (A1)

4 000389986-0004

Name of owner: Brötzmann, Günter
Filing date: 23/08/2005
Locarno class-subclass: 30.02
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Indication of the product: Aviaries
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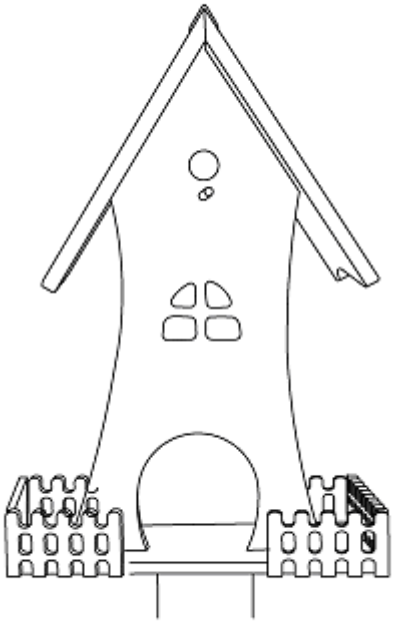
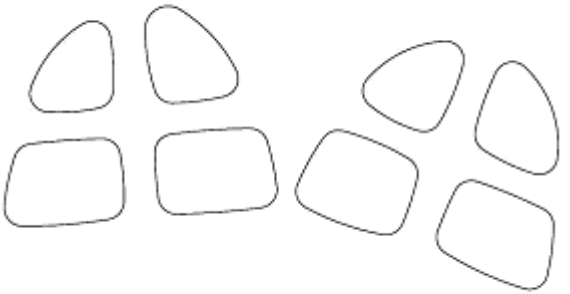
MULTIPLE APPLICATION





Deferment of publication

Article 50 Paragraph 1

The applicant for a registered Community design may request, when filing the application, that the publication of the registered Community design be deferred for a period of 30 months from the date of filing the application or, if a priority is claimed, from the date of priority.

Costs of a Community Design Application

a) Without deferment of the publication

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INTELLECTUAL PROPERTY

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Thank you for your attention!

Internet: www.ip-goetz.de

ENLARGEMENT OF THE EUROPEAN COMMUNITY

ARTICLE 165 CTM COUNCIL REGULATION + ARTICLE 110a CD COUNCIL REGULATIONS

Article 165
Provisions relating to the enlargement of the Community
1. As from the date of accession of Bulgaria, the Czech Republic, Estonia, Cyprus, Latvia, Lithuania, Hungary, Malta, Poland, Romania, Slovenia and Slovakia (hereinafter referred to as 'new Member State(s)'), a Community trade mark registered or applied for pursuant to this Regulation before the respective dates of accession shall be extended to the territory of those Member States in order to have equal effect throughout the Community.

Article 110a
Provisions relating to the enlargement of the Community

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