Trademark Protection in Europe

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IP Brochure

Trademark protection is available for any sign which is capable of distinguishing the goods and services of one enterprise from those of others. These signs include, inter alia, words, including personal names, letters and numerals, figurative signs (“device marks”), colours and colour combinations, three-dimensional shapes, including the shape of the goods or their packaging.

Different from registered trademark rights, protection of use-based trademark rights has not been harmonised in Europe and is thus subject to the laws of each Member State. Trademark protection is the most significant part of the law relating to the protection of distinctive signs. Distinctive signs include, in addition to trademarks, trade names, which identify and distinguish undertakings, trade dress, which provides for the protection of the overall appearance, presentation or get-up of a product, and geographical indications, which identify and distinguish goods or services as to their geographical origin.

Trademarks are IP rights often constituting some of the most important and valuable assets of their proprietors. Furthermore, trademarks represent the goodwill of the enterprise which makes use of them. Trademarks are essential in market economies as, on the one hand, they foster market transparency and permit their owners to create a direct link with consumers and, on the other hand, allow consumers to identify and memorise the products and services they prefer. Therefore, trademarks contri-bute to a system of fair and undistorted competition.

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1. Requirements for trademark protection in Europe

Trademark law in Europe comprises both European Union (EU) legislation and the national laws of the 27 Member States of the Union on the protection of marks.

The European Union Trademark Regulation (EUTMR) of June 2017 (Regulation (EU) 2017/1001) allows for the registration of EU trademarks offering EU-wide protection.EU trademarks are administered by the EU's trademarks and designs office, the European Union Intellectual Property Office (EUIPO), located in Alicante, Spain. The EUTMR coexists with national trademark laws, which have been substantially harmonised as regards substantive law in 1988 by the First Directive to approxi-mate the laws of the Member States relating to trademarks (Trademarks Directive: codified as Directive 2008/95/EC in 2008 and recast as Directive (EU) 2015/2436 in 2015). With the three Benelux countries having established a common trademark system in 1970, there are 25 different national trademark regimes in the European Union. The German Trademark Act of 1994 has implemented the Directive but is, in addition, a comprehensive law providing for protection of all distinctive signs.

The requirements for obtaining trademark protection through registration in Europe are substantially the same in all Member States and in the EU trademark system.

Trademark protection is available for all kinds of signs capable of distinguishing goods or services of one undertaking from those of others. These signs include traditional marks such as words, names, and figurative marks, but also shapes and colours and colour combinations, and even non-visible signs such as sounds. A trademark had to be capable of being represented graphically. Case law has interpreted this condition strictly and required the representation to be clear, precise, self-contained, easily accessible, intelligible, durable and objective. As from January 14, 2019, the requirement of graphical representation of a trademark has been removed. Now legislation requires that a trademark needs to be represented in a manner that enables the competent authorities and the public to determine the clear and precise subject matter of the protection.

Registration is not available for marks which are devoid of distinctive character, which are merely descriptive of characteristics of the goods or services, such as their nature, quality or geographical origin, or which are generic. Whether these conditions

are met is examined by taking into account the perception of the public addressed by the mark and the goods or services for which protection is claimed. A mark that is excluded from protection as not distinctive, descriptive or generic may nevertheless be protected if distinctiveness has been acquired through use (“secondary meaning”). For EU trademarks, distinctiveness through use must be shown for those parts of the EU where the grounds of refusal existed. Furthermore, protection is excluded for marks which are deceptive or against public order or morality, or where a mark conflicts with an earlier protected geographical indication or appellation of origin.

No protection is available for three-dimensional shapes resulting from the nature of the goods themselves, for shapes necessary to obtain a technical result and for shapes giving sub-stantial value to the goods for which they are sought to be registered.

In addition to these “absolute” grounds of refusal, earlier rights, i.e., rights acquired prior to the filing or priority date of the later mark, constitute “relative grounds” of refusal or invali-dation. These earlier rights are earlier registered trademarks, earlier trademarks acquired on the basis of use and other trade identity rights such as trade names and trade dress, as well as any other earlier right that may conflict with a trademark, such as rights in names or images, design rights or copyrights.

The EU trademark system is based on the principle of the unitary character of an EU trademark. Thus, any absolute ground existing in a part of the EU will result in a refusal or invalidation, as will any earlier right of either Union-wide or Member State-wide scope. In the national systems, earlier EU trademarks constitute earlier rights; in other respects, the grounds of refusal must exist in the Member State in question. Accordingly, a mark not registrable as an EU trademark or in a particular Member State because of its descriptive character may well be registrable in other Member States where a different language is spoken.

In this IP Brochure we will cover European and German trademark law.

2. Overlap of trademark law and other IP rights

Many signs, such as logos, shapes and images, may, in addition to trademark protection, qualify for other IP rights, particularly copyright and design protection. For example, the shape of a bottle or a device that may be registered as a trademark may also be protected as a design under the European Designs Regulation provided that it is new and has individual character.

Trademarks may also fall within the subject matter of copyright law. Whether that can be the case, depends on the applicable laws of the Member States of the EU. Contrary to design or trademark law, there is no European-wide copyright law and the requirements for copyright protection are not harmonised.

However, copyrights are subject to various regulations that apply throughout the EU. For this reason, the European courts have played a significant role in defining the criteria for determining when a “work” is protected by copyright, and their judgments are binding in all member states. As a rule, for a trademark to constitute a “work” protected under copyright law, the mark must be the result of a personal intellectual endeavour which exhibits the imprint of its author’s personality. The question of when these requirements are met is therefore always a matter of individual circumstances and cannot be assessed in general terms. This generally implies a high threshold for protection by requiring a relatively high standard of originality.

3. International trademark law

Protection of trademarks may also be obtained by means of an international registration.

The 1989 Protocol to the Madrid Agreement for the International Registration of Marks has replaced the earlier 1891 Madrid Agreement. The Madrid system is administered by the International Bureau of the World Intellectual Property Organization (WIPO). An international registration must be based on an application or registration of the same mark in one of the Madrid Union members and must be filed through the office of origin. Protection may be requested in any other Member State of the Madrid Union. All EU member States (except Malta) belong to the Madrid system.

The EU joined the Madrid Protocol in 2004. Thus, protection for the EU as a whole as well as for all of its Member States which belong to the Madrid System may be obtained through the registration of trademarks at the International Bureau of WIPO. Moreover, the EU as well as its Member States are Members of the World Trade Organization (WTO) and hence have to adhere to the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS Agreement) which also contains minimum standards on the protection of trademarks. The EUTMR and the Trademarks Directive are in compliance with the TRIPS requirements.

4. Procedure for obtaining trademark rights

In order to obtain a registration of an EU trademark an application must be filed, either directly at EUIPO, located in Alicante, Spain, or through a national office in one of the Member States. The application must contain the mark and a list of goods or services grouped in accordance with the international classification of goods and services established under the Nice Agreement. Applications may claim the priority date of an earlier filing in a Paris Convention or WTO Member. The application fee, and additional class fees for classes beyond the second class, must be paid within one month of the filing date.

Applicants without residence or establishment in the EU must appoint a professional representative authorised to represent in trademark matters in one of the Member States.

Applications are examined *ex officio* for compliance with formal requirements and absolute grounds upon request. EUIPO also carries out a search for earlier EU trademarks and informs the applicant and the proprietors of earlier rights. Several national offices in the Member States also carry out such searches in their registers, which applicants can request there. After publication of the application, proprietors of earlier rights may oppose the registration. The opposition period amounts to three months. Proprietors of earlier rights invoking earlier registered trademarks must prove use of their marks if use is challenged by the applicant and the earlier mark has been registered for more than five years. If no opposition is brought or if the opposition proceedings are concluded without rejection of the application, the mark

is registered, and the registration is published.

Appeals against refusals by EUIPO's examiners and opposition divisions are available to EUIPO's Boards of Appeal, quasi-judicial bodies established within EUIPO. Further appeals may be brought in first instance to the General Court (EGC) and in second instance on points of law to the Court of Justice of the European Union (CJEU). EU trademark protection is a preferred method of obtaining protection in Europe because it is easily accessible, relatively inexpensive, provides unitary protection throughout Europe and can be enforced EU-wide in specially designated EU trademark courts.

In Germany, applications must be filed at the German Patent and Trademark Office (GPTO), located in Munich. The registration procedure is very similar to that at EUIPO. However, the GPTO does not carry out searches for earlier marks. Also, opposition proceedings in Germany are available only after registration, and a successful opposition results in a cancellation rather than refusal of the opposed mark. Office decisions may be appealed to the Federal Patent Court, also established in Munich, which conducts a de novo examination. An appeal to the German Federal Court of Justice ("Bundesgerichtshof", BGH), located in Karlsruhe, may be brought for a review of questions of law, provided the appeal is allowed by the Federal Patent Court ("Bundespatentgericht", BPatG) or the losing party claims an infringement of basic substantive or procedural rights.

Both EUIPO and the GPTO provide compre-hensive online services, including for filing and access to registration data. EU trademark registrations as well as German registrations will initially last for ten years from the date of filing the application; they can be renewed indefinitely for further periods of ten years.

5. Exclusive rights conferred by -registration

By registering a mark, the proprietor obtains the exclusive right to use it in the course of trade. The rights conferred by EU trademarks and by German marks are the same.

However, the territory in which protection is granted is the whole territory of the European Union for EU trademarks, and the territory of Germany for German marks.

The proprietor is entitled to prevent third parties from using in the course of trade:

- any sign which is identical with the registered mark in relation to goods or services which are identical with those for which the mark is registered;
- any sign where, because of its identity with, or similarity to, the registered mark and the identity or similarity of the goods or services covered by the mark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trademark;
- any sign which is identical with, or similar to, the registered mark in relation to any – identical, similar, or dissimilar – goods or services where the registered mark has a reputation in the EU (in case of EU trademarks) or in Germany (in case of German marks) and where use of that sign without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the registered mark.

6. Trademark protection through registration or use

An EU trademark can only be acquired through registration. However, all Member States must provide protection without use for well-known marks. Also, many countries, like Germany, award protection on the basis of use in commerce. In Germany, protection is granted when the mark has become established in the trade, which requires knowledge of the mark by a significant proportion of the relevant public (“Verkehrsgeltung”).

7. Cancellation proceedings against registered EU trademarks or German trademarks on grounds of invalidity or revocation

The grounds for revocation of registered trademarks or for declaring them to be invalid for EU trademarks and for German marks are the same. Revocation grounds are: Absence of genuine use, development into a generic or deceptive indication. Invalidity grounds are all absolute and relative grounds which lead to refusal of registration, as well as any additional earlier rights in conflict with the registered

mark. Furthermore, bad faith application is a ground for invalidity.

Revocation and invalidity proceedings against EU trademarks may be brought by applying to EUIPO. Decisions of EUIPO's cancellation divisions are subject to appeal to the Boards of Appeal and thereafter to the General EGC and the CJEU. Revocation or invalidity actions may also be brought as counterclaims to an infringement action initiated by the EU trademark proprietor. For these actions, the EU trademark courts have exclusive jurisdiction.

For German trademarks, cancellation due to invalidity or revocation can either be applied for at the GPTO or brought before the civil courts. Both bodies are competent in this respect and the applicant or plaintiff has the right to choose between them (the only exception is invalidity due to absolute grounds for refusal; in this case, the application for cancellation must be filed with the GPTO; the civil courts are not competent in this specific matter).

8. Enforcing trademark rights in Europe (main proceedings)

EU trademarks (including Madrid marks effective in the EU) have "unitary character" and "equal effect throughout the EU" (Article 1 [2] EUTMR) and therefore cover the whole territory of the EU. Accordingly, it is established case law that a claim for a cease-and-desist order (injunctive relief) on the grounds of an EU trademark infringement applies, as a rule, to the entire territory of the EU, because an infringement committed anywhere in the EU establishes, in principle, a risk of repeated infringement for the entire territory of the EU.

German trademarks as well as international (Madrid) registrations with effect in Germany cover Germany and infringement actions may be undertaken to obtain injunctive relief and any other relief with effect for Germany.

8.1 Competent courts and jurisdiction

In Germany, organization of the courts is a matter for the 16 German federal states ("Länder"). Thus, the degree of specialization of the courts differs greatly from federal state to federal state. In many infringement cases the claimant has the choice of the court where proceedings are brought. They may choose the defendant's domicile or, alternatively, any court where acts of infringement have been committed or

threatened (*forum delicti commissi*). Trademark infringement cases are heard in up to three instances: In first instance by the District Courts ("Landgericht"), in second instance by the Courts of Appeal ("Oberlandesgericht") and in third instance by the German Federal Court of Justice ("Bundesgerichtshof", BGH). Civil chambers in first instance are composed of three professional judges. Cases may also be brought before Commercial chambers, composed of one professional and three lay judges.

All German states have concentrated the jurisdiction for trademark matters on only one or in any event a limited number of courts in each state. Claimants have a tendency to go to the courts which are known for their expertise and for handling a large number of trademark cases, such as the District Courts of Dusseldorf, Hamburg, Frankfurt, Mannheim and Munich. Lawyers may appear before any of these courts, regardless of their location.

Judgments of the District Courts can be appealed to the Courts of Appeal. These courts of second instance basically evaluate whether the first instance judgment correctly considered the facts and evidence, and correctly applied the law. However, the appeal instance does not perform a full *de novo* trial. New facts may only be submitted under certain conditions, *e.g.* if the claimant or defendant did not act negligently when failing to introduce these facts in the first instance. Therefore, it is very important to assert all the relevant facts and defences already in the first instance. New legal arguments may be submitted at any time, including at second instance.

A further appeal to the Federal Court of Justice (BGH) can be allowed by the Court of Appeal if the matter is of fundamental importance or a decision by the BGH is called for in order to further develop the law. In practice, the Courts of Appeal rarely allow a further appeal. Dissatisfied parties may also request the BGH to admit a further appeal in spite of the Court of Appeal's refusal to allow an appeal. Such "non-admittance" appeals are only rarely successful. If the appeal has been allowed by the Court of Appeal or the "non-admittance" motion is successful, the case will be taken to judgment by the BGH. This further appeal is for a review issues of law only. The parties have to be represented by a special attorney admitted to act before the BGH.

Very rarely, a case may be brought to the Fed-eral Constitutional Court ("Bundesverfassungsgericht") in Karlsruhe. The Constitutional Court does not serve as a regular court of appeals from lower courts or as a sort of "super-appellate court" for the BGH on any violation of federal laws. Its jurisdiction is limited to issues of constitutional law, including fundamental individual rights such as freedom of speech.

The Infringement of EU trademarks belongs to the competence of EU trademark courts. These are national courts designated by the Member States to deal with EU trademark cases. In Germany, as a matter of principle, the same courts that are competent for hearing German trademark cases have also been designated as EU trademark courts. EU trademark courts have EU-wide competence when the case is brought in the Member State where the defendant is domiciled or established, or, failing this, where the claimant is domiciled or established. If neither claimant nor defendant are domiciled or have an establishment in the EU, the EU trademark court in Alicante (the seat of EUIPO) has EU-wide competence. In addition, actions may also be brought before the courts of a Member State where acts of infringement have been committed or are threatened. In that situation the competence of the court is limited to the territory of the Member State where it is established (*forum delicti commissi*). In second instance, the Courts of Appeal of the district where the District Court is situated are competent. Further appeals on points of law are, as already outlined, available to the BGH.

In cases regarding infringement relating to German marks and relating to EU trademarks, the lower courts may, and the Supreme Court must, refer questions of interpretation of EU law to the CJEU for a preliminary ruling. Since the adoption of the Trademark Directive and the EUTMR, more than 100 decisions have been taken by the ECJ. German courts have frequently resorted to such references.

8.2 Main procedural principles

An infringement case is usually started by sending a warning letter with a cease-and-desist declaration containing a contractual penalty in case of violation. Should the matter not be resolved as a result of such a warning letter, the proprietor of a trademark (or any other IP right) will usually file proceedings for a preliminary injunction (see below).

A complaint must be filed at a competent District Court. The parties must be represented in infringement proceedings by an attorney-at-law ("Rechtsanwältin/Rechtsanwalt") admitted to a German bar, optionally cooperating with a patent attorney ("Patentanwältin/Patentanwalt"). Non-EU nationals who act as claimants in proceedings brought before German courts must, upon application by the defendant, give security for costs and lawyers' fees. The claimant has to present evidence of all facts which are relevant for finding infringement. Discovery is generally not available in German court proceedings. Any facts which cannot be proven by documentary evidence may be dealt with in a taking of evidence by hearing witnesses in oral testimony. Many cases, however, are decided on the basis of written presentations by the parties and in subsequent oral hearings in which the presiding judge explains the views of the court and gives the parties an opportunity to present their arguments and observations. Formal taking of evidence in trademark infringement proceedings is mainly limited to proving distinctiveness acquired through use, or enhanced distinctiveness, or reputation; likelihood of confusion is generally judged by the court as an issue of law.

8.3 Claims on the merits in proceedings (remedies)

The legal tools at the disposal of the claimant in infringement proceedings include claims for cease-and-desist (injunctive relief), for destruction of the infringing products and for detailed information and rendering of account about infringement activities by the defendant, as well as for damages which may be calculated based on the accounting rendered (account of sales, profits, etc.). Furthermore, and following the implementation of the IP Rights Enforcement Directive (2004/48/EC) into German law, the German Trademark Act provides:

- claims for preservation of evidence;
- claims for recall and definitive removal of infringing products from the channels of commerce;
- claims for securing damages (submission of bank, financial or commercial documents) in certain circumstances;

- claims for the publication of judicial decisions;
- claims for inspection;
- an extension of existing claims for destruction of counterfeit goods and implements principally used in the creation or manufacture of infringing goods; and
- an extension of existing claims for information.

As regards damages, the claimant may choose between three alternatives for calculating damages: lost profits, infringer's profits, or reasonable royalty. Punitive damages are not awarded. While a reasonable royalty typically provides the least burdensome of these alternatives for calculating damages, the calculation according to the infringer's profit is applied more and more frequently, since the case law now allows the infringer to deduct costs and expenses from the sales figures only if (and to the extent that) they can, in exceptional cases, be directly attributed to the objects infringing the IP right. As a consequence, only the variable costs of the manufacture and marketing of the product may be deducted from the infringer's amount of sales made. Additionally, in determining the amount of profit made from the infringement, the infringing party cannot claim that such profit is partly due to its own particular distribution activities. This means that general overhead costs can no longer be used to reduce the infringer's profits. However, the question remains whether the infringer‘s profits are caused by the trademark infringement or by other circumstances, like good client relationships, a dominant market position, effective advertising or good service. The same question arises if the trademark owner claims lost profits, which would frequently result in the highest damages awards. Here, an additional obstacle occurs if the market included other competitors than the claimant and the defendant, so that a third party could to some extent have replaced the infringing sales of the defendant in the absence of defendant‘s infringing activities.

When actions for the infringement of EU trademarks are brought, Article 130 EUTMR provides for the sanction of injunctive relief. In addition, the courts apply all the sanctions provided for in the law of the country where the infringement took place. If a German EU trademark court deals with infringements committed in Germany, the sanctions applicable in cases of infringement of German trademarks are applicable.

8.4. Length of proceedings and time limits

The length of proceedings in trademark infringement cases will differ from court to court and vary with the court‘s work load. Main proceedings for trademark infringement are likely to take between six and nine months in first instance, from filing of the complaint until rendering of the judgment. Depending on the practice of the court, there may be one or two hearings in a typical case. If the court orders the taking of evidence, there may be one further session of the court for hearing witnesses or experts, and in that case the proceedings will typically take another three months. Appeal proceedings are likely to take approximately nine to twelve months on average, with usually only one court hearing. If evidence is taken at the appeal stage, approximately three months should be added. If a further appeal to the BGH is admitted, the proceedings before that Court would likely take one and a half to two years.

The first instance proceedings start with the claimant filing a comprehensive complaint, stating all relevant facts of the case. The defendant then has to reply within about six to eight weeks. An oral hearing will be held within another one or two months. The decision is typically rendered about one month after the oral hearing. There is no automatic enforcement of the decision if an appeal is lodged against it. A special order may authorise preliminary enforcement.

An appeal must be lodged within one month from the receipt of the written first instance decision. A comprehensive reasoning has to be filed within a further month. The Court of Appeal may extend this deadline. Typically, the appellee has a few months to respond to the appeal reasoning. A reply of the appellant is then to be expected about two months later. An oral hearing will be held about three months later. The decision is rendered within one more month. There is no automatic enforcement of the decision if a further (legal) appeal is lodged. A preliminary enforcement of the decision may be allowed, but its temporary execution usually requires the deposit of a security.

A further appeal on points of law can be lodged within one month from the notification of the second instance decision. A comprehensive reasoning has to be filed within one further month. The BGH may extend this deadline.

8.5 Costs

The cost risk in trademark litigation usually includes fees for parties' attorneys and (optional) patent attorneys, plus the court fees and expenses for witnesses and travelling, etc. It is difficult to give a general estimate for litigation costs at first or second instance. To give an idea of the order of magnitude of the litigation costs, one should focus on statutory lawyer's fees, according to the German statutory fee regulation ("Rechtsanwaltsvergütungsgesetz") and court fees. These fees are calculated on the basis of the value in litigation, which reflects the claimant's interest in the disputed matter. The value in dispute is fixed at the court's discretion but is essentially based on the parties' sales figures. In a typical case, value in dispute may be in the range of EUR 250,000. The sum of fees for both parties' representatives plus the court fees represents the statutory cost risk, because the losing party has to pay the costs of the winning party as well. The statutory cost risk is if, as just described, a value in dispute of EUR 250,000 is used as a basis, approximately EUR 25,000 in first instance and approximately EUR 30,000 in second instance.

As most other firms in trademark and other IP matters, BARDEHLE PAGENBERG generally bills on an hourly basis, which can, depending on the actual work load, lead to attorney fees which may be higher than the attorney fees according to the statutory fee regulation. Since the losing party only needs to reimburse the statutory fees, the winning party may still incur an amount of costs which is not reimbursable.

9. Enforcing trademark rights in Europe (preliminary proceedings)

Enforcing IP rights in Germany including cross-border litigation has a long-standing tradition, particularly by way of proceedings for a preliminary injunction. Notably the interim enforcement of registered rights is very popular amongst rights owners. What follows applies equally to the enforcement of German trademark rights and of EU trademark rights.

9.1 General remarks

German courts are prepared to grant a preliminary injunction *ex parte* if the petitioner shows evidence as to ownership and validity of his trademark right, sufficient likelihood of infringement and urgency of the matter. The petitioner may file declarations ("affidavits") as evidence in the specific procedure. Moreover, German courts also tend to grant preliminary injunctions on the grounds of unregistered rights if specific requirements are fulfilled.

The petitioner may assert a claim for a cease-and-desist order as well as for the disclosure of information about the infringing act and a preliminary seizure order. Following the implementation of the IP Rights Enforcement Directive (2004/48/EC) into German law, preliminary proceedings, in general, allow the assertion of claims for preservation of evidence, inspection or securing damages (submission of bank, financial or commercial documents).

This preliminary enforcement, however, renders petitioners potentially liable for any damage suffered by the defendant as a consequence of the preliminary enforcement if the case is later decided against the petitioner. For this reason, the petitioner is sometimes ordered to provide a bond (cash or bank guarantee) to cover this risk before the preliminary enforcement can take place. The amount of this bond will be determined by the court, depending on the value in litigation and potential damages which may be caused by preliminary enforcement.

Preliminary relief is also available in the case of infringement of EU trademarks. In addition to EU trademark courts, all other courts competent for hearing trademark cases have jurisdiction. However, only EU trademark courts with EU-wide jurisdiction may issue orders or grant relief extending beyond the borders of the Member State where the court is located.

9.2 Specific procedural principles and timing

In Germany, many contentious matters are decided in preliminary proceedings. Decisions of the District Courts may be appealed to the Courts of Appeal. There is no further appeal in such cases to the Federal Court of Justice.

A request for a preliminary injunction before an infringement court requires the matter to be considered "urgent". Therefore, the petitioner must request preliminary relief shortly after having become aware of the allegedly infringing activity, one or two

months at the utmost, calculated from the time when the right holder first obtained knowledge of all the relevant circumstances.

Preliminary relief may be granted by the court *ex parte* without first holding a hearing to which the alleged infringer would be called as well. In spite of the more recent case law on the procedural right to equality of arms by the German Federal Constitutional Court, *ex parte* injunctions are still possible, even though petitioners have to meet stricter requirements. Petitioners should ensure that their submission in the request for the preliminary injunction is also entirely covered by the preceding warning letter. Once the court's order has been issued *ex parte*, the petitioner must serve the injunction within another month in order not to lose the rights flowing from the order.

Furthermore, as the preliminary injunction does not have permanent character, the petitioner is required to file for a main action if the defendant does not accept the interim injunction as final.

The potential infringer, who may be aware of an impending request for preliminary relief, for example as the result of having been served with a warning letter, may consider the option of fi-ling a so-called protective brief ("Schutzschrift") with the German courts.

Once a preliminary injunction has been issued by the court, the alleged infringer is obliged to comply with the injunction but has the opportunity to file an objection with the court having issued the injunction in order to achieve a review and possibly a revocation of the preliminary injunction. The decision taken on review as well as any preliminary judgment issued after an oral hearing may be appealed to the Court of Appeal.

9.3 Preliminary injunctions and main actions

The concept of enforcing IP rights in Germany by way of proceedings for a preliminary injunction is, for obvious reasons, very attractive for the rights holder, as demonstrated by numerous decisions taken by German courts of first instance and the appeal courts. How, then, does a preliminary injunction compare to a main action? The fundamental conceptual difference between the two proceedings is that main proceedings provide for a conclusive and final resolution of the matter (including information on account of profits and damages), whereas, the preliminary injunction focuses on a preliminary and selected result with the consequence that infringements

are stopped immediately. In broad terms, a preliminary injunction does not require extensive evidence (such as hearing of witnesses), while complex cases should be brought to court by way of a main action.

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