

**XXXIX** **2019** **abpi**  
INTERNATIONAL CONGRESS ON  
INTELLECTUAL PROPERTY | ABPI  
25|27  
AUGUST  
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# 「Enforcing intellectual property rights in Europe – tips and traps

ABPI, Congresso Internacional,  
Rio de Janeiro, August 27, 2019

**Dr. Philipe Kutschke**

Attorney-at-Law, Certified IP lawyer, Commercial Mediator (MuCDR),  
Partner, Bardehle Pagenberg, Munich, Germany」





## 「Relevance of company seat of right holder regarding EUTMs and RCDs



## Relevance of company seat of right holder regarding EUTMs and RCDs

### Infringement in Germany– enforcement in Germany

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- Defendant in Germany  
→ EU-wide injunction available, EU-wide annex claims (including EU-wide damages)
  - Defendant in other EU member state  
→ injunction only for Germany and respective annex claims
  - Defendant outside EU, but right holder in Germany  
→ EU-wide injunction, EU-wide annex claims (including EU-wide damages)
  - Defendant outside EU, right holder outside EU  
→ Injunction only for Germany and respective annex claims
- ⇒ Designs and trademarks should be held by an EU entity (e.g. Germany), particularly if infringement of rights by non-EU opponent expected





## Relevance of company seat of right holder regarding EUTMs and RCDs

### Infringement in other EU country – enforcement in Germany

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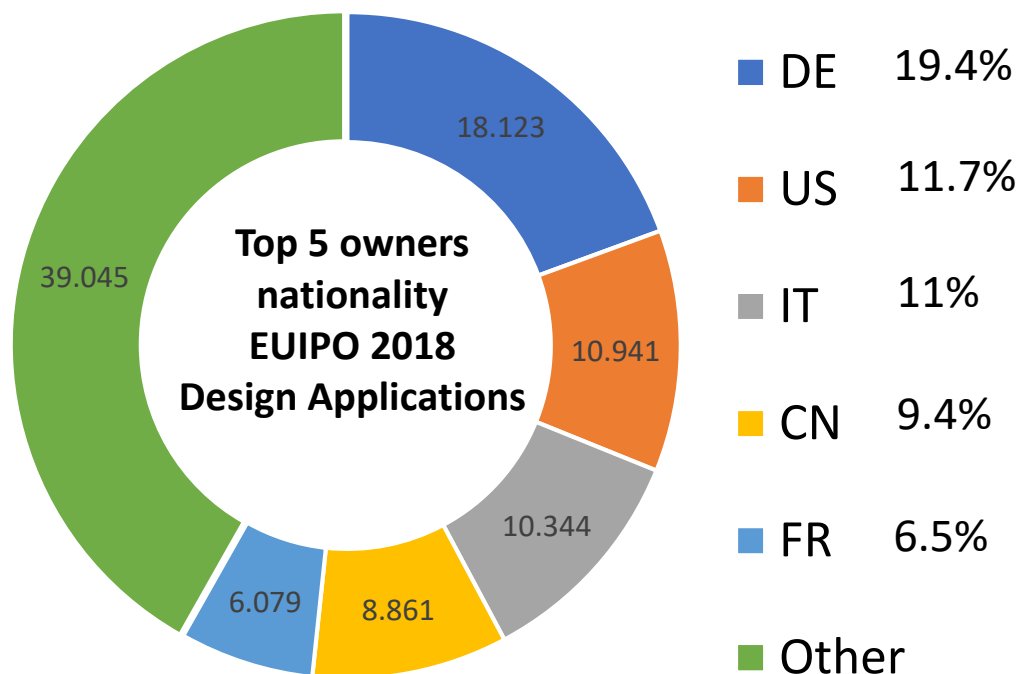


- Defendant in Germany  
→ EU-wide injunction, annex claims depending on facts of the case
- Defendant outside EU, but right holder in Germany  
→ EU-wide injunction, annex claims depending on facts of the case



# Relevance of company seat of right holder regarding EUTMs and RCDs

## Statistics – Top 5 Owners of EU Designs



Nr.	Owner Nationality	Number of design applications 2019 (as of July)	
1	German	9,673	16.9%
2	IT	6,967	12.1%
3	US	6,788	11.8%
4	CN	6,561	11.4%
5	FR	3,509	6.1%





## **Preliminary injunction („PI“) proceedings in Germany**

# └ Preliminary injunction („PI“) proceedings in Germany

## General requirements

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- Infringing act in Germany (if only seizure requested: infringing items in Germany)
- Matter urgent?
  - PI request must be filed shortly after first notice of infringing action in Germany (no precise deadline, Munich: within one month)
  - First notice of infringing act must be substantiated (usually by way of an affidavit)





# ┌ Preliminary injunction („PI“) proceedings in Germany

## Available claims

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- EU wide injunction?
- Information on extent of infringement?
- Seizure of infringing goods?
- Inspection?
- Seizure to secure claims for reimbursement of costs?
- Destruction, rendering of account, damages?
- Border seizure requests?



# Preliminary injunction („PI“) proceedings in Germany

Ex parte injunctions available?



- Most recent case law of Federal Constitutional Court:  
Defendant should in general be heard before rendering a PI, e.g.
  - Chance to comment to a warning letter sent out prior to PI request
  - Protective brief by defendant
  - Oral hearing
  - Exemption: PI would be thwarted otherwise (e.g. in trade show cases)
- For the defendant: Does it make sense to file a protective brief?
  - If you have good arguments: yes
  - If not: better refrain from filing a protective brief or limit content to reference of above mentioned case law of Federal Constitutional Court

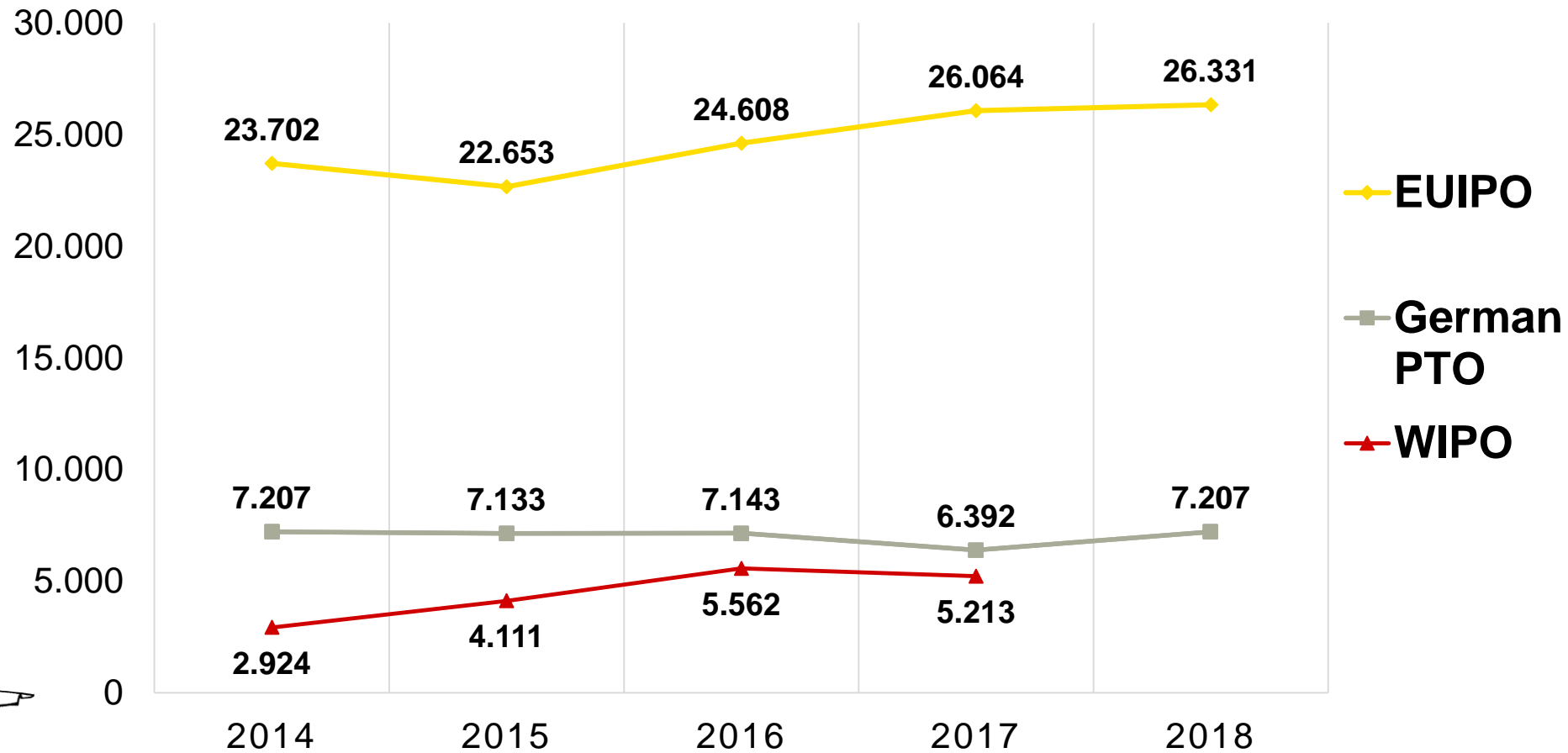




## └ Relevance of national IP rights

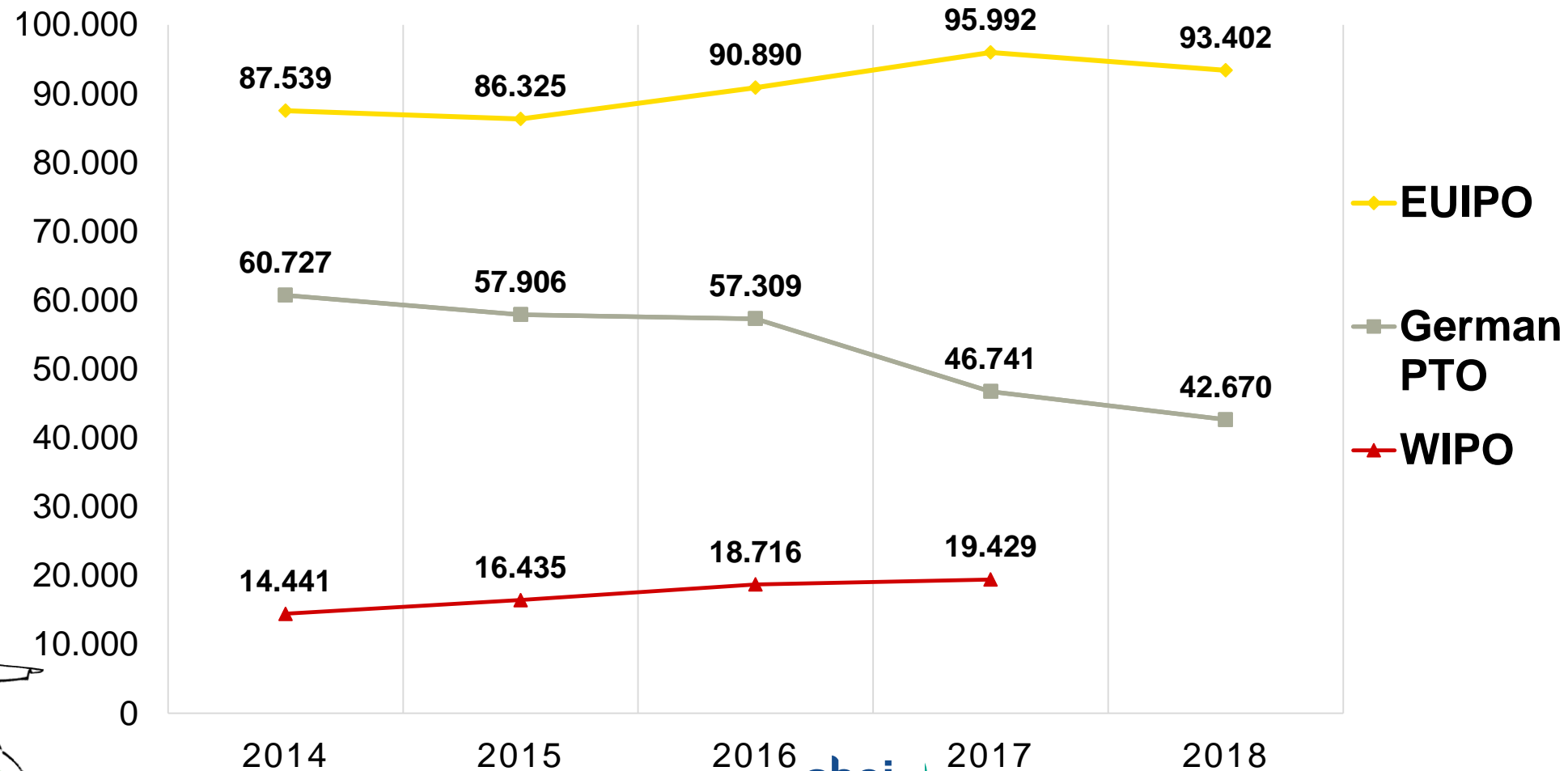
## Relevance of national IP rights

Statistics – Number of design applications filed with...



## Relevance of national IP rights

Statistics – Number of designs granted with...





## Relevance of national IP rights

### National trademarks needed?

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- As regards validity, requirements for right-preserving use should not be higher for an EU trademark than for a national trademark
  - EU trademark law and national trademark laws should be basically harmonised; however, different assessment by IP offices and courts in special cases cannot be ruled out completely
- ⇒ National trademark only needed to be on the very safe side, or to attain registered right within short time





## Relevance of national IP rights

National designs needed?

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- Helpful in cases expecting defensive argument of prior right to use by third party
  - In such a case, enforcement of a registered design against the use of this third party's design possibly unsuccessful
  - Risk can be mitigated if also German design is filed:  
Prior right to use re German design requires use / preparation in Germany
- Filing prerequisites re German design very similar to EU design
  - Filing of German design can be carried out very cost-efficiently





# └ Impact of Brexit





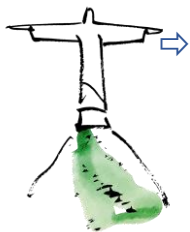
# Impact of Brexit

## Rules according to draft withdrawal agreement

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- EU trademarks will cease to be effective in the UK following Brexit
- However, they will be transformed automatically into “comparable UK trademarks”  
→ Note: right holders, not their representatives will be informed about renewal fees
- Right holders may generally opt out any day after Brexit
- Applications which are not yet granted on Brexit day will have to be re-filed with UK PTO within 9 months after Brexit in order to keep priority date of the EU counterpart
- Trademark use in the EU (other than UK) will also support validity of the comparable UK trademark
- UK court decisions before Brexit will be enforceable EU-wide afterwards
- Cases pending with a UK court on Brexit day will only have effect in the UK



⇒ Similar rules for EU designs





## Impact of Brexit

And in case of a no-deal Brexit?

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- In such a case, it should be up to the UK to set special rules for EU protective rights
- Currently, the UK envisages to accept a similar set of rules as provided in the draft withdrawal agreement





**Brazil joining the WIPO systems –  
effects on portfolio strategies?**



## Brazil joining the WIPO systems

### Trademarks – the Madrid system...

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a) ...in a nutshell

- Currently 105 member states
- Manages the „International Registrations“ („IRs“) which are a bundle of single national trademarks
- Protection in many countries around the world in three steps:
  - Application / registration of a national basic trademark
  - Application to the World Intellectual Property Organization (WIPO) and designation of countries that trademark protection is sought for
  - National IP offices will examine and register national trademarks according to their law





## Brazil joining the WIPO systems

### Trademarks – the Madrid system...

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#### b) Advantages and disadvantages

- Advantages:
  - Application and management of a bundle of trademarks with a single administrative process (in principle)
  - Invalidity of a single designated national trademark will not affect the other trademarks of the IR (except „central attack“)
- Disadvantages:
  - National representatives still have to be appointed in case of office actions, since respective national laws are fully applicable
  - If basic trademark is declared invalid with central attack, all single trademarks of the IR are invalidated





## Brazil joining the WIPO systems

### Designs – the Hague system...

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a)...in a nutshell

- Currently 70 member states
- Manages the „International Registrations“ („IRs“)
- Other than in trademark law, no basic national design needed





## Brazil joining the WIPO systems

### Designs – the Hague system...

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#### b) Advantages and disadvantages

- Similar to trademark IRs
- Specific advantage: no basic protective right on which all other protective rights depend regarding their validity
- Specific disadvantage: rules regarding scope and way of protection vary significantly between the member states
  - Still unclear whether IRs are fully enforceable if they do not meet deviating national requirements





## Brazil joining the WIPO systems

### Rule of thumb for portfolio management

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- Preparing national / EU registrations need more effort
- For important markets, it is generally worth to file national / EU applications
  - Application can be tailored according to national (or EU) rules, maximizing protection
  - Lower risk of rejection of application
  - Re national trademarks: No risk of full invalidation in case basic trademark is successfully attacked







## └ **New EU regulation on the transit of goods**



## New EU regulation on the transit of goods



- The old rules: Transit of goods cannot constitute EU trademark infringement if the goods were not intended to be made available in the EU
- New regulation: Even mere transit of goods may constitute infringement if trademark in suit is protected in country of final destination
  - Reasoning: “better balance between fight against counterfeiting and securing free trade”
  - Most suitable action: seizure requests with customs authorities re situations such as transshipment and warehousing, etc.
  - Possible liability risk: if final destination of goods is not known, trademark holder can only guess if his trademark is also protected at final destination





┌ **Thank you!**

[Philipe.Kutschke@bardehle.de](mailto:Philipe.Kutschke@bardehle.de)