

HINTE

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Protection of Industrial Property Rights

A counterfeit product has been discovered on an exhibition stand.
What action should be taken?

Trade fair priority:

Issuing of a Certificate of Priority

PROTECTION OF INDUSTRIAL PROPERTY RIGHTS

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Trade fairs and exhibitions are the main markets for innovations which have often cost the exhibitor or inventor a great deal of time and money. Apart from innovations, your current products may also be subject to counterfeiting, product piracy and brand piracy which can have a very bad effect on your own investments, turnover and profit and also ultimately lead to job losses in your company.

HINTE GmbH will help you to combat product and brand piracy (imitations, counterfeit products) by issuing a Certificate of Priority for the innovations you exhibit. You should defend yourself – but in good time!

Under German law, you have various industrial property rights in this respect: A patent protects technical inventions if they are new, involve an inventive step and can be used commercially. Commercially applicable technical innovations are protected as utility models. New models and models based on an individual character are protected as registered designs; the English word "design" has been adopted into the German language in this case. The names of products or services of a company, the company's trading name and its logos can be protected as trade marks which distinguish the company from other firms. Apart from a few exceptions, the decisive factors regarding the protection of industrial property rights are their registration and their chronological order. Exceptions primarily apply to unregistered community designs, to copyright to works of art, literature and science, to the avoidable deceptive mark of origin under competition law and to company names used in good time. Patents, utility models, trade marks and registered designs can be acquired by sending an application for registration to the

German Patent and Trade Mark Office:

Deutsches Patent- und Markenamt
Zweibrückenstrasse 12
D-80331 München
Tel: +49 (0)89 2195 - 0
Fax: +49 (0)89 2195 - 22 21
E-Mail: info@dpma.de
Internet: <http://www.dpma.de>

You can find additional information, forms, fee tables, etc. on the homepage of the German Patent and Trade Mark Office. It is recommended that specialist lawyers be used to register industrial property rights. These lawyers can also provide you with valuable assistance in securing your rights and prosecuting trade mark and product pirates.

HINTE GmbH can recommend for following lawyers' office in Karlsruhe, which specialise in these areas:

Müller-Hof | Rechtsanwälte

Beethovenstraße 5
D-76133 Karlsruhe
Tel: +49 (0)7 21 9 85 67-0
Fax: 49 (0)7 21 9 85 67-77
E-Mail: anwaelte@mueller-hof.de
Internet: <http://www.mueller-hof.de>

You can also obtain further information from:

Rechtsanwaltskammer Karlsruhe

Reinhold-Frank-Str. 72
D-76133 Karlsruhe
Tel: +49 (0)721 25340
Fax: +49 (0)721 26627
E-Mail: info@rak-karlsruhe.de

Patentanwaltskammer

Tal 29
D-80331 München
Tel: +49 (0)89 242278-0
Fax: +49 (0)89 242278-24
E-Mail: dpak@patentanwalt.de
Internet: <http://www.patentanwalt.de>

Useful information on this topic is also available from the Association of the German Trade Fair Industry (AUMA) in the Internet at: <http://www.auma.de> and German Customs at: <http://www.zoll.de>.

Issued industrial property rights also involve territorial protection to a certain extent.

Conversely, this also naturally applies to a foreign country to which a company may not export goods under its own trade mark if this trade mark or a confusingly similar trade mark is already protected in that country for another company. Finally, it must be pointed out that protection exists even without a patent, trade mark, utility model or registered design and that a right may be infringed if, for example, an individual original design of a product enjoys copyright protection as an original personal creation or a non-registered European design. This also applies to plans, computer programmes and similar objects. Comparable protection is available under competition law if objects are imitated without any technical need for the imitating design and if an avoidable deceptive mark of origin and, thus, a danger of confusion are created.

Here at HINTE GmbH, we can also provide you with a special service in the form of temporary protection through so-called exhibition priority. In this case we issue exhibitors with a so-called Certificate of Priority to the effect that they can exhibit certain products at one of our trade fairs or exhibitions. With the exception of patents, this gives exhibitors a time lead for the above-mentioned industrial property rights. They can then finally apply for industrial property rights within a period of 6 months and enjoy a time lead from the date of issue of the Certificate of Priority compared with those applicants who applied for industrial property rights after the date of the exhibition.

You can obtain information on exhibition priority from:

HINTE GmbH

Bannwaldallee 60
D-76185 Karlsruhe
Tel: +49 (0)721 / 93133 - 0
Fax: +49 (0)721 / 93133 - 110
E-Mail: info@hinte-messe.de

Here are some tips on how to deal with trade mark and product pirates:

If you discover imitations or counterfeit products on an exhibition stand, you should consider first of all that being right is not very helpful if you cannot provide proof. Your first step must therefore be to thoroughly document the counterfeit products and imitations for evidence purposes, for example in the form of photos, brochures and witness statements. Extensive documentation may also be the only way to legally enforce your rights. It is also always recommended that you have documentation of your own rights (certificates from the German Patent and Trade Mark Office) to hand along with photos, drawings and descriptions of your own product.

The first step to be taken against the imitator would be to issue a so-called warning, i.e. a request – possibly also in writing – that the exhibitor of the counterfeit product remove the illegally identified or imitated product from public view as quickly as possible and to no longer display or sell it. However, since even a successful warning does not represent a secure means of preventing repetition at a different exhibition or even the same exhibition at a different time or preventing the continued commercial distribution of the product, it is recommended that a simple warning be replaced by a more stringent form, i.e. a warning with a so-called declaration of discontinuance with a penalty clause. This declaration must be signed by the imitator. The imitator is hereby obliged to pay a certain sum as a contractual penalty for every case involving a repeat infringement of industrial property rights. This contractual penalty is enforced by a court. However, it is recommended that a lawyer/patent lawyer be engaged at this point in time in order to correctly formulate the wording of the declaration of discontinuance so that the contractual penalty can be properly enforced in the event of any infringement of industrial property rights.

If the imitator is not voluntarily prepared either to make a declaration of discontinuance with a penalty clause or remove the counterfeit product, the only possible remedy then is to take legal action to quickly prevent any further infringements of industrial property rights. An application for a temporary injunction may be made in this case to the regional court responsible for the exhibition venue. In this case the court prohibits the imitator from committing acts of infringement, which must be described in exact terms. Exact documentation of one's own rights and documentation of the infringement by the imitator become mandatory at the latest at this point in time. Due to the urgent need to speed up the proceedings, an application for a temporary injunction will only be successful with evidence - for example photos, affidavits from witnesses, plans, brochures, etc. - which proves to the judge that industrial property rights have been infringed. By virtue of law, a lawyer must be engaged for these proceedings. If the temporary injunction is granted, action may be taken against the imitator in the form of an administrative fine or, in an extreme case, by means of a threat of arrest or the issue of an arrest warrant. The above-mentioned lawyers can also be used for these summary legal proceedings.

Another effective legal remedy is border seizure. You can apply to the customs authorities (HINTE GmbH will be pleased to give you the name of the contact person) to seize a product which has temporarily been imported from a third country for a trade fair or exhibition if it infringes one of your industrial property rights. In this case the exhibition of goods infringing industrial property rights can therefore also be prohibited in Germany and not just at the external borders of the European Union.

In addition to the HINTE GmbH contact person, questions relating to customs matters at trade fairs and exhibitions can be addressed to

Handelskammer Karlsruhe
Lammstraße 13-17
D-76133 Karlsruhe
Tel: +49 (0)721 174-0
Fax: +49 (0)721 174-240
E-Mail: info@karlsruhe.ihk.de

Finally, it should also be mentioned that you should, in your own interest, confirm the authenticity of exhibited products which you have not manufactured. Even if you have unknowingly imported counterfeit products and only exhibit them, you may be infringing existing industrial property rights.

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CERTIFICATE

Protection of utility models,
registered designs, copyright and trade marks
at trade fairs and exhibitions

It is hereby certified that the company / Mr. / Ms.

exhibited the product shown in the attached and stamped picture and description at

the trade fair ----- held at the trade fairgrounds of Messe ----- from ----- to -----.

Attached enclosures:

Pictures:

pages / piece

Description:

pages

Place, date

(Company stamp and legally binding signature of applicant)

Place, (date)

(Stamp and legally binding signature of trade fair management)