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Industrial property rights

**A counterfeit has been discovered on a stand
– what to do?**

Industrial property rights

The innovations that have cost a lot of brainwork and money are usually presented for the first time at trade fairs and exhibitions. All the more distressing, when copies or product counterfeits turn up on another exhibitor's stand.

Comprehensive general economic and political strategies and measures are necessary to fight "product piracy". NürnbergMesse GmbH also feels responsible for supporting its exhibitors and visitors in the battle against plagiarism.

The legal protection of intellectual property is, however, the concern of the inventor or exhibitor of the product. Although the protection of "industrial property rights" cannot prevent copies or plagiarism, the **industrial protection rights** do enable their owner to take rapid and effective action against the violation of his intellectual property, if necessary with the aid of a lawyer. And this is what counts at an exhibition. It is therefore very helpful if industrial property rights for the innovation have already been applied for before the exhibition. "**Exhibition priority**", which is obtainable at some exhibitions, secures the first day of the exhibition as the date of application for a subsequent registration of a trademark or design (design protection).

What possibilities are available in Germany for safeguarding products, trademarks and ideas to protect them against counterfeiting?

Industrial property rights in Germany

Patents

A patent can be used to protect **technical** inventions that

- are new,
- embody a sufficient inventive achievement and
- are commercially useful.

Utility model

Utility models can be used to protect objects that are already known, but incorporate **technical innovation** of features. The remaining criteria correspond to those of patents.

Registered design

Registered designs protect the new and proprietary **design** of a product.

Trademarks

Trademarks are usually **product markings, trade names as well as business identifiers** and may comprise words, illustrations, letters and numbers, three-dimensional designs and colours. Advertising slogans can also be protected and even the products and their actual outfit.

German Patent and Trademark Office

Further information, forms and fees can be found in the publications and on the Internet site of the German Patent and Trademark Office:

Deutsches Patent- und Markenamt
Zweibrückenstraße 12
80331 München

Tel +49 (0)89.21 95-0
Fax +49 (0)89.21 95-22 21
www.dpma.de
info@dpma.de

Lawyers

Pitfalls can be avoided and deadlines observed by calling in a lawyer experienced in the protection of industrial property rights. Information is obtainable from the respective chamber of lawyers:

Nuremberg Chamber of Lawyers
Rechtsanwaltskammer Nürnberg
Fürther Straße 115
90429 Nürnberg

Tel +49 (0)911.9 26 33-0
Fax +49 (0)911.9 26 33-33
www.rak-nbg.de
rak.nbg@t-online.de

Munich Chamber of Patent Lawyers
Patentanwaltskammer
Tal 29
80331 München

Tel +49 (0)89.242278-0
Fax+49 (0)89.242278-24
www.patentanwalt.de
dpak@patentanwalt.de

The fees associated with the appointment of a lawyer are based on the complexity of the facts of the case and the time required for obtaining or asserting the industrial property rights. To obtain industrial property rights abroad, it is basically essential to consult lawyers located in the country concerned.

Exhibition priority

We issue priority certificates for some of our fairs. You present your product for the first time at the exhibition and we confirm this. The date of this confirmation certificate will be accepted as application date by the German Patent and Trademark Office, provided this certificate is used to apply for protection after the fair within 6 months of the date your product was first exhibited. This gives you a time lead over counterfeiters, as the chronological order of the application grants the older trademark priority over the newer trademark and utility model oder registered design. Exhibition priority is recognized by many worldwide patent and trademark offices. Information about the respective regulations can be obtained from a patent lawyer or a lawyer specializing in the protection of industrial property rights. Please note, however, that in Germany exhibition priority does not apply to patent applications.

Information about exhibition priority

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A counterfeit has been discovered on a stand – what to do?

There are many questions on the subject of product piracy and plagiarism – on both sides. The consultant lawyer of NürnbergMesse, Heidrun Lindner, has compiled the following FAQs on this subject:

Brief information

- If you have discovered a counterfeit of your product: Questions 1, 3, 4 and 10
- If a counterfeit has been discovered on your stand: Questions 2, 4, 5, 6 and 18

1. How should I proceed if I discover a counterfeit of my product at the exhibition?

The first step is to **document** the counterfeit (if applicable with photos or statements by witnesses). You are then advised to have documents of the imitated product available (e.g. photos, samples, trademark rights and/or patents).

The next step is to issue a **warning** to the exhibitor of the counterfeit product. You can request the exhibitor to remove the product from the stand. If the exhibitor refuses to remove the product from the stand, you should call in a lawyer experienced in industrial property rights or a patent lawyer.

In the case of a justified warning (you can prove your claim by presenting photos, samples, trademark rights and/or patents for your product), the other exhibitor must also pay the costs of your lawyer. If action is taken against a counterfeiter based abroad, however, it must be increasingly expected that he will not voluntarily pay the costs and it may not be possible to carry out the third step of serving an **injunction** (which your lawyer can seek from a locally responsible court, if sufficient time remains for this). You will then have to bear the costs after all.

2. What happens if a counterfeit is discovered on my stand?

You face a sales and advertising ban, possibly by means of an **injunction**. You must also provide **information** about the person from whom you obtained the goods and about the commercial customers to whom you have passed the goods. In particular, you must disclose the name and address of the commercial customers, so that claims can also be asserted against them for receiving the goods. You also risk receiving substantial **claims for damages**. The counterfeiter is usually very interested in reaching a quick agreement with the owner of the industrial property rights. The costs of the lawyer serving the notice and the court costs are frequently considerable and are borne by the counterfeiter. The existing goods may have to be handed over for destruction.

3. How does an injunction work and what does it cost?

An injunction, which can only be obtained from a court by your lawyer, gives you an effective means of taking quick action against the exhibitor of a counterfeit product. You can force him to stop presenting the counterfeit immediately under threat of a substantial penalty.

In Germany, it is possible for injunctions to be granted by a court within hours and served by a bailiff while the exhibition is still running. The losing party always bears the costs in Germany. The costs of lawyers and court costs are limited by law, unless other arrangements are agreed. On the other hand, lawyers abroad usually charge by the hour and each party basically pays his own costs. Only in exceptional cases are costs borne by the losing party.

4. Which local lawyer can help me?

NürnbergMesse can provide the names of lawyers engaged in the protection of international industrial property rights and who speak English for cases involving foreign countries. The names are obtained via the chambers of lawyers and patent lawyers.

5. Am I as trader also liable for counterfeit products of a manufacturer?

Anyone who manufactures, sells or advertises the counterfeit product in the protected area is liable. Any other arrangement would mean that the industrial property rights could not be effectively enforced. Here the legislators have effectively cracked down at international level. For this reason, all claims can also be asserted against the trader, i.e. particularly claims for restraint, information, damages and destruction.

6. The products are only displayed at the exhibition, not supplied to the German market. Do I still contravene German industrial property rights as exhibitor?

Yes, the exhibiting and advertising of products in German territory contravenes the industrial property rights effective in Germany, even if the exhibition is an international event. You must therefore check that you are entitled to advertise and sell your articles in Germany and use your trademark and company designations in Germany.

7. How can I find out what is already protected in a country?

It is possible to make inquiries in all industrial countries. Trademark inquiries are possible in almost every country in the world at relatively low cost, whereas patent inquiries are frequently very complex and can thus be associated with considerable costs.

8. How do I obtain industrial property rights for my product?

By submitting an application to the responsible patent and trademark office. Here you are also advised to consult a lawyer experienced in the protection of international industrial property rights.

9. What is exhibition priority?

If you possess exhibition priority for your product, the first day of displaying your product at the exhibition will be entered as the date of your application when you apply for industrial property rights, provided your application is submitted to the patent office within 6 months of the date your product was first exhibited. This gives you a lead over counterfeiters.

10. The product is not protected by industrial property rights (e.g. trademark, registered design, patent). Are there any other legal possibilities of taking action against a counterfeit?

Yes, in certain cases. Copyright and the so-called "unregistered Community design" also provide protection without the need to formally lodge industrial property rights. Claims are also frequently allowed under fair trade law.

11. Do industrial property rights give me territory protection?

Yes. Industrial property rights mean you can stop production, sale, installation and importation. You can obtain a ban on advertising.

12. The company logo is on the package; must I protect this as well?

Yes.

13. In which countries do I need protection?

You essentially need protection for your products in the countries in which you manufacture or have your products manufactured and to which you export them. An economic consideration is very advisable here, so do not immediately register every product in every country.

14. What does it actually mean if my trademark is rejected in a country because older trademark rights exist?

You are then not allowed to label your products with the trademark, advertise the trademark or use it for selling or producing. Otherwise you are a trademark pirate and must expect to receive claims for restraint, information and damages.

15. How do I find a lawyer for this subject abroad?

Small and medium patent and law firms usually co-operate with lawyers abroad who also specialize in this very specific legal field. In this respect they frequently differ from large law firms.

16. My distributor sells my product in my own territory although this is not allowed. What can I do about it?

This depends on whether your products are reimported within the EU or imported from outside the EU. If necessary, you can use your industrial property rights to prohibit the import.

17. Can I save money by appointing my distributor to protect trademarks and products locally?

This is very short-sighted, as your trademarks then belong to the distributor. If you separate later, for example, because the distributor has found a cheaper manufacturer, you are not allowed to market your products under your trademark in this country in the future. Trademarks and industrial property rights should always be registered directly by the manufacturer himself in all countries. Especially small and medium patent and law firms have suitable logistics for this. For example, a German lawyer can apply for trademark protection for a single trademark in over 80 countries without having to call in another lawyer.

18. My goods have been seized by customs; what can I do?

Your lawyer should immediately lodge an objection to the seizure, if it is unjustified. Claims for damages exist in the event of unjustified seizure. If the goods were seized because of the exhibition, it may even be possible to assert claims for loss of sales.

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