

TOP LAW FIRMS 2010

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The number of German trade mark applications stagnated in 2010 – this is what even the top law firms with regard to filings had to realize throughout the year. An overall trend towards the Community Trademark has been noted. German trade marks remain of importance though, in particular when used as a basis for International trade mark registrations.

INVENTIVENESS, RESEARCH AND CREATIVITY remain important business drivers in Germany. Hence, German law firms last year again filed numerous applications for the protection of their clients' ideas at the German Patent and Trade Mark Office (DPMA). However, the number of applications stagnated in comparison with the previous year. In total 69 072 trade marks were applied for; in 2009 the figure was 69 069. Seemingly, filing activity has not regained its previous strength after the economic crisis. Commercial as well as law firms increasingly also rely on European trademark protection.

TREND TOWARDS COMMUNITY TRADEMARK APPLICATIONS

The number of CTM applications in the Office of Harmonisation in the Internal Market (OHIM) in Alicante increased in 2010 by almost 15 % compared to the previous year - from 69 678 to 80 064 applications. An application for a so-called Community Trademark claims protection for all 27 member states of the European Union simultaneously.

Dr. Holger Gauss, attorney at Grünecker Kinkeldey Stockmair & Schwanhäusser explains the increasing popularity of the Community Trademark amongst others by the comparatively high cost of national trade marks when protection is required for a number of countries: "A Community Trademark, as does a Community Design, offers the possibility to obtain protection Europe-wide at a relatively low cost. The costs of a Community Trademark are known to be much lower than the costs of only a few national trade mark applications."

Dr. Nils Weber, specialist attorney for intellectual property at Jonas Rechtsanwaltsgesellschaft, confirms that even when protection is required in only two member states of the European Union, the EU trade mark is more cost-effective than most corresponding national trade marks. While a registration as a Community Trademark after the cost reduction in 2009 now costs only €900.00 in official fees, these are €300.00 in Germany alone.

This is an important factor, considering that by trade value EU member states remained the most important markets for goods “Made in Germany”. In particular after the liberalisation of the Internal Market many medium-sized enterprises today no longer concentrate exclusively on Germany, but increasingly on Europe. As a result many small and medium-sized trademark applicants, who traditionally preferred national German trade marks, now have an increased interest in EU-wide trademark protection.

A further argument in favour of the Community Trademark is the practice of the European Trademark Office, which favours trade mark registration. Weber confirms that “In particular in the case of Germany we notice that standards for registration of certain marks are somewhat more generous than those of the DPMA.”

Top 50 Law Firms by German Trademark Applications in 2010

| Rank | Law Firm | Applications 2010 | Thereof. Registrations (Status 6/2011) | Applications 2009 | Changes in % |
|------|--|----------------------|--|----------------------|-----------------|
| 1 | BEUKENBERG, Hannover | 818 | 449 | 616 | 33 |
| 2 | BOEHMERT & BOEHMERT, Bremen | 412 | 340 | 433 | -5 |
| 3 | PREHM UND KLARE, Kiel | 403 | 348 | 384 | 5 |
| 4 | ZIMMER, Berlin | 352 | 127 | 785 | -55 |
| 5 | LOVELLS, Hamburg | 283 | 200 | 451 | -37 |
| 6 | F200 A/S/G GMBH, Berlin | 266 | 202 | 269 | -1 |
| 7 | EISENFÜHR, SPEISER & PARTNER, Bremen | 252 | 200 | 165 | 53 |
| 8 | MEISSNER BOLTE, Munich | 247 | 196 | 237 | 4 |
| 9 | CMS HASCHE SIGLE, Cologne/Hamburg | 239 | 189 | 197 | 21 |
| 10 | GRÜNECKER, KINKELDEY, STOCKMAIR & SCHWANHÄUSSER, Munich | 200 | 156 | 189 | 6 |
| 11 | IHR ANWALT 24 ZIERHUT & GRAF AG, Munich | 193 | 153 | 189 | 2 |
| 12 | MAXTON LANGMAACK & PARTNER, Cologne | 181 | 144 | 35 | 417 |
| 13 | FPS FRITZE WICKE SEELIG, Hamburg | 180 | 143 | 97 | 86 |
| 14 | WEICKMANN & WEICKMANN, Munich | 173 | 137 | 135 | 28 |
| 15 | GRAMM, LINS & PARTNER GBR, Braunschweig | 167 | 130 | 168 | -1 |
| 16 | LORENZ SEIDLER GOSSEL, Munich | 158 | 134 | 112 | 41 |
| 17 | SCHNEIDERS & BEHRENDT, Bochum | 156 | 122 | 170 | -8 |
| 18 | HARMSSEN & UTESCHER, Hamburg | 151 | 124 | 214 | -29 |
| 19 | TAYLOR WESSING, Munich/Frankfurt/Duesseldorf/Hamburg | 137 | 105 | 139 | -1 |
| 20 | JONAS MBH, Cologne | 119 | 98 | 106 | 12 |
| 20 | VON KREISLER, SELTING, WERNER, Cologne | 119 | 83 | 108 | 10 |

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|----|---|-----|----|-----|-----|
| 22 | HUCKE, STEPHAN, Pulheim | 118 | 77 | 73 | 62 |
| 23 | UEXKÜLL & STOLBERG, Hamburg | 116 | 94 | 90 | 29 |
| 24 | MEISSNER & MEISSNER, Berlin | 114 | 99 | 105 | 9 |
| 25 | JABBUSCH SIEKMANN & WASILJEFF, Oldenburg | 112 | 89 | 114 | -2 |
| 26 | SKW SCHWARZ, Munich/Hamburg | 110 | 87 | 164 | -33 |
| 27 | WEBER & SAUBERSCHWARZ, Duesseldorf | 109 | 89 | 72 | 51 |
| 28 | FRIEDRICH GRAF VON WESTPHALEN, Freiburg | 107 | 78 | 83 | 29 |
| 29 | COHAUSZ & FLORACK, Duesseldorf | 106 | 82 | 116 | -9 |
| 30 | MAUCHER & PARTNER, Freiburg | 105 | 94 | 68 | 54 |
| 31 | BREUER UND KOLLEGEN, Munich | 104 | 74 | 13 | 700 |
| 32 | BIRD & BIRD LLP, Munich/Duesseldorf | 101 | 72 | 119 | -15 |
| 32 | WHITE & CASE LLP, Hamburg | 101 | 87 | 108 | -6 |
| 34 | HABEL & HABEL, Muenster | 99 | 59 | 131 | -24 |
| 35 | BUSSE & BUSSE PARTNERSCHAFT, Osnabrueck | 98 | 64 | 114 | -14 |
| 35 | LUTHER MBH, Cologne | 98 | 82 | 102 | -4 |
| 35 | MÜLLER SCHUPFNER & PARTNER, Munich | 98 | 78 | 44 | 123 |
| 38 | ADVOTEC, Würzburg | 97 | 78 | 71 | 37 |
| 38 | LÜBECK GBR, Frankfurt | 97 | 86 | 115 | -16 |
| 40 | RECHTSANW. KRAUSE, BETTINA, Tutzing | 96 | 75 | 86 | 12 |
| 41 | MÜLLER FOTTNER STEINECKE, Munich | 95 | 82 | 81 | 17 |
| 42 | HANSMANN & VOGESER, Munich | 94 | 74 | 89 | 6 |
| 43 | CHARRIER RAPP & LIEBAU, Augsburg | 90 | 80 | 78 | 15 |
| 43 | GÖRG, Cologne | 90 | 71 | 54 | 67 |
| 45 | MITSCHERLICH & PARTNER, Munich | 89 | 74 | 127 | -30 |
| 46 | BRP RENAUD & PARTNER, Stuttgart | 87 | 72 | 70 | 24 |
| 46 | LICHTENSTEIN, KÖRNER & PARTNER, Stuttgart | 87 | 66 | 122 | -29 |
| 46 | LINDNER BLAUMEIER, Nuremberg | 87 | 71 | 92 | -5 |
| 46 | SIEBEKE LANGE WILBERT, Duesseldorf | 87 | 71 | 58 | 50 |
| 50 | NESSELHAUF, Hamburg | 86 | 62 | 132 | -35 |

Source: [S.M.D. Markeur](http://www.s.m.d.markeur.com)

GERMAN TRADE MARKS REMAIN AN IMPORTANT BASIS

Nevertheless, German trademarks remain important in particular for German enterprises. “They can form the basis for International registrations, although these are now also possible on the basis of a CTM. Since an International registration provides more opportunity for attack than a German mark, German marks remain popular“, explains Susanne Karow, partner and trade mark attorney at Hogan Lovells International in Hamburg. Professor Dr. Jan Bernd Nordemann of Boehmert & Boehmert confirms this: “German trade marks are essentially of interest if a product is specifically designed for the German market. Further, where a trade mark is used internationally German trade marks are applied for by German clients for use as basic marks for purposes of International Registrations.”

Attorney Karsten Prehm of Kanzlei Prehm & Klare is of the opinion that the German trademark will continue to hold its own against the EU trade mark - and not only for reasons of the EU trade mark taking comparatively longer to register. In Alicante the opposition period (3 months) forms part of the application procedure, while German trade marks can only be opposed after registration.

One firm which could increase its application numbers at the DPMA by 40% in the previous year is Lorenz Seidler Gossel. This firm's applications had regressed in 2009. Dr. Dieter Laufhütte explains that the regression has been more than compensated. Since a major portion of the firm's clients come from the capital goods sector and operate worldwide, applications increased again markedly after the end of the economic crisis. Clients in the consumer goods sector have also become more active. The Bremen firm Eisenführ, Speiser & Partner was also able to increase the number of German trade mark applications by more than 50%. Attorney Christian Spintig ascribes this to better economic conditions, but also to the fact that the firm was able to acquire new clients and larger mark portfolios.

HIGH REGISTRATION RATE THROUGH GOOD RESEARCH

More than 80% of Eisenführ, Speiser & Partners' trade mark applications proceeded to registration. Christian Spintig explains the success rate as follows: "Good advice starts with proper thought about the subject application and with discussing this with the client, not with following the instruction blindly."

Boehmert & Boehmert has also achieved a registration rate of over 80%. Dr. Nordemann stresses that the respective sign has to be considered as to its registrability in detail ahead of the filing of the application - in particular as to its capability to distinguish. Additionally, the firm checks, before filing, whether there are conflicting prior marks in the names of other parties which may obstruct registration. Weber confirms: "The basis for the success of a trade mark application is a qualified judgement of the chances of successful registration." Searches on the availability of marks are invariably conducted. A trade mark application with a specifically drafted description of goods / services is only filed in the event that adequate chances of successful registration are foreseen.

The importance of comprehensive legal advice ahead of filing a trade mark application is also stressed by Dr. Laufhütte, Lorenz Seidler Gossel. "Applicants who save on advice often later make the "painful experience that the costs related to changing a product name are considerably higher than the costs associated with comprehensive legal advice ahead of the trade mark application."

Trade mark applications apparently often fail because the applied for terms and logos are refused on absolute grounds. In particular large clients at times apply for such signs in any event, without regard. This is confirmed by Maxton: "The success rate of registration of only 80% can be ascribed to the fact that some marks, in particular those of bigger clients, are borderline cases for registrability and are

applied for deliberately to in an attempt to see whether the particular mark is registrable in the opinion of the DPMA.”

Susanne Karow of Hogan Lovells International confirms this view. The remaining percentage of refused applications are generally cases where the client’s signs are in its own opinion borderline cases, but where it wishes to protect itself against a possible assertion of third party rights through confirmation by the DPMA that the mark is unregistrable.

IS THE IR MARK LOSING ITS IMPORTANCE?

It is interesting to note that some of the top German law firms file for significantly fewer IR than EU marks. The so-called IR marks – in terms of the Madrid Trademark system – enable a trade mark proprietor to seek protection on the basis of its national registration in up to 85 member states.

Dr. Laufhütte recalls that many applicants mistrusted OHIM’s registration practice in the initial stages of the EU trade mark system and feared opposition from the quarters of national trade marks of other EU member states. In those days the EU mark was rarely chosen to gain protection in Europe. At the time a considerable number of German applicants preferred the IR mark to the EU mark. “Since then, however, the EU mark has become generally accepted”, he states. In this context, Jochen Maxton points out that the costs of a Community Trademark application are less than the costs associated with an IR mark for only a few EU member states. He says, the advantage of a Community Trademark is that the registrability of a EU mark is examined exclusively by the EU Trademarks Office. Community Trademark opposition proceedings are also only conducted there, and not before a number of national offices, which leads to a uniform practise.

NO GENERAL RESERVATION

In case of the IR mark, the international organisation responsible for the protection of intellectual property (WIPO) initially registers the IR mark. The mark is then granted, alternatively refused, within 6 to 18 months in those countries for which protection has been claimed. As opposed to a EU mark, a IR mark has to be used after 5 years in all countries for which protection has been claimed for it to remain in force. In the case of a EU mark, use in all member countries of the EU is not required.

While the EU mark currently apparently partly serves as a substitute for a German trade mark application, the IR mark is used by German clients rather in those instances where they are active in non-European member states of the Madrid System, such as China, Japan or the USA. A general reservation against IR marks is not apparent in Germany.

METHODOLOGY

This research refers to German trade mark applications filed at the German Patent and Trade mark Office (DPMA) during 2010, irrespective of their current status. The data was researched in July 2010. Current figures may deviate from historical data due to changes in representative, different spellings, etc. In the case of law firms with more than one location the office with the most applications is listed in the ranking and allocated the total applications of the particular firm.

The registration rate answers the question which percentage of trade marks filed in the relevant year proceeded to registration, irrespective of the current status of the marks. Accordingly, it is only considered whether a registration was obtained at the time of our research, even if the mark is no longer registered (for example because of cancellation).

In the case of the application rate in 2010 a certain downward deviation has to be considered due to the fact that the time to registration can be up to 1½ years. In particular, trade mark applications filed towards the end of 2010 may still find themselves in the application stage. Since representatives are not allocated identification numbers but are identified by the names appearing in the applications, different spellings may lead to departures from the figures provided. For the same reason changes of name of representatives, as well as mergers and separations during 2010 were not taken into account. Applications were considered as per date of filing. Changes in representation of earlier found marks were not taken into account.

The data was searched with www.markenfacts.de and the CEDELEX search software of S.M.D. Markeur, which are based on the official data of the OHIM.

Filing may only constitute a small part of the firms' economic activity. The ranking cannot and does not represent a statement on the economic success or value of the firms listed.

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Total German Filings and Registrations, 2002-2010

| Year | Filings | Originated from Germany | Related to Service Classes | Registrations under Sec. 41 Trade Mark Law |
|------|---------|-------------------------|----------------------------|--|
| 2002 | 57 416 | 53 817 | 23 923 | 51 730 |
| 2003 | 62 041 | 58 731 | 25 728 | 51 295 |
| 2004 | 65 918 | 62 576 | 27 650 | 48 401 |
| 2005 | 70 926 | 67 208 | 30 181 | 50 798 |
| 2006 | 72 321 | 68 810 | 33 164 | 51 124 |
| 2007 | 76 165 | 72 788 | 36 082 | 54 534 |
| 2008 | 73 903 | 70 074 | 35 349 | 50 259 |
| 2009 | 69 069 | 65 714 | 34 071 | 49 817 |
| 2010 | 69 072 | 65 505 | 32 441 | 48 794 |

Source: German Patent and Trade Mark Office (DPMA)

Filings by German Federal States in 2010



Source: German Patent and Trade Mark Office (DPMA)