



WTRTM

EUIPO Filing Elite

2021

**Meissner Bolte Patentanwälte
Rechtsanwälte Partnerschaft mbB**

KAY RUPPRECHT, GERNOT H
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Meissner Bolte

Q. In terms of the management of your trademark practice, what lessons have been learnt during the covid-19 pandemic?

A. Think long term and do not give up IP rights for short-term savings!

Competition is getting tougher, especially in these difficult economic times due to covid-19. Pirates at home and abroad copy the companies established in the market even more heavily and want to profit from their success. The costs of a defence strategy without owning trademark rights are many times higher than the costs of trademark applications or renewals. At the same time, trademark portfolios should be kept permanently up to date. Covid-19 is forcing many companies to develop new products or digitise existing products. Therefore, check whether the existing lists of goods and services still provide sufficient protection! Covid-19 has shaken up the

business world and has not stopped at trademark portfolios. Companies thinking strategically in the long-term are adjusting their trademark practices in response.

Q. The firm runs a continuous education programme for its professional and support staff in the form of regular training, seminars and workshops. Can you expand a little on these and the importance for both staff and clients?

A. Meissner Bolte has a well-established internal programme for education at the highest level and for continuous learning in all areas of intellectual property.

Our patent attorneys are educated in IP law including German and EU trademark law for the German patent attorney and European patent attorney qualifications and as qualified IP attorneys at law. In addition, our staff are educated as qualified paralegals.

Changes of law are monitored rigorously. We have special teams to implement important aspects and changes of IP law into our daily practice, our data system and our templates and to share the information in-house.

Everyone is trained regularly in the use of our digital tools and applications.

Continuous learning is supported by the documentation of our knowledge and processes in our digital manual, intranet and implemented workflows and templates. Newcomers can thus be integrated very quickly.

These measures guarantee consistent processes at the highest quality for our clients and for our staff.

Q. What are the developments/cases that trademark practitioners need to be following with respect to the European and German trademarks landscape?

A. As of 1 January 2021 the United Kingdom is no longer covered by EU trademarks regime.

In Germany, invalidity proceedings based on earlier rights are available in addition to court proceedings.

With regard to cases, practitioners should be aware of the following:

- Case I ZB 21/19, where the German Federal Supreme Court held that descriptive elements of a sign should also be included in the examination of a likelihood of confusion as conflicting signs should be considered as a whole when compared with one another.



Kay Rupprecht, LLM, Partner, Patent Attorney

- Case C-371/18, where the European Court of Justice decided that a lack of intention to use a trademark could constitute bad faith. The German court confirmed the cancellation of a repeat application for Monopoly (Case T-633/19).
- Case T-668/19, where the German court held that an audio file containing the sound of a drinks can being opened, cannot be registered as a trademark

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Gernot H Schroer, LL.M., Partner, Patent Attorney



Oliver Nilgen, Counsel, Lawyer

Q. What would you say is the one key factor to success when managing a trademark and designs filing practice?

A. In our opinion, there are at least two key factors that characterise a successful trademark and design practice. First and foremost, a team of experts that know the law by heart but that also have a deep understanding of the client's business needs. Advice on trademark and design matters has a direct impact on the business. In particular, this includes an understanding of all national and international aspects, such as expansion strategies, key competitors and ongoing disputes. This is required by all team members so that we can provide the best legal advice in the context of the business needs of our clients. As is so often, communication is key.

The second factor is being able to provide our service at scale. Many clients have portfolios of

trademarks around the world. This necessitates the right technological infrastructure so that each team member has all the relevant information at hand, when needed.

Q. Finally, what one piece of advice would you give young lawyers keen to develop a filing practice?

A. There is no better piece of advice than that given by Winston Churchill: "Blood, toil, tears and sweat!"

MEISSNER BOLTE