

## Grace period use of trademarks

### **What is the meaning of grace period for use / compulsory use?**

According to nearly all Trademark Acts worldwide an owner of a trademark is required to use the mark during a certain period. The grace period for use allows the owner to take measures to establish the trademark on the market and secure market shares. During this period the owner is not obliged to prove the use of the mark. However, once the grace period for use has expired, use is compulsory in order to justify the permanent registration of a trademark.

### **When does the genuine use of a trademark become relevant?**

Once the grace period for use has expired, the genuine use of the trademark becomes relevant if you want to use your trademark as a basis, for instance, in cancellation proceedings, opposition proceedings, litigations in which the adverse party raises the objection that your mark has not been put to genuine use, or if a third party has applied for the cancellation of your mark for non-use.

### **How to prove the genuine use of a trademark?**

The genuine use of a trademark can be proven by submitting data and indications about the place, period, type and extent of the use of the trademark for the registered goods and services. Acceptable evidences are, inter alia, packagings, product images, labels, price lists, catalogues, invoices, advertisements showing the trademark.

The trademark has to be used in the form as registered in the Trademark Register. Modifications of the trademark are accepted only to a limited extent. Please find below our checklist.

### **What steps are required by you now?**

Nothing is required from you right now. But you should take internal steps to make sure that corresponding documents and information are available should it come to the question of having to submit evidence for the genuine use of your trademark. We recommend your archiving evidence of use in the past five years continuously, compiling sales figures and turnover figures on an annual basis, classifying the archived materials and data according to individual countries, and checking documents, in particular invoices, with regard to the goods and services stated there.

If you have any questions, please do not hesitate to contact us.

## Checklist concerning the genuine use of trademarks

1. A trademark has to be used by the owner or with the consent of the owner (license agreements)
2. Use of the trademark for the actually registered goods and services
3. General rule: Use of the trademark in the registered form!
4. Modification of word marks: As a rule, the following modifications are uncritical:
  - the use of capital/small letters (e.g.: „xyz“ instead of „XYZ“)
  - the use of medial capitals (e.g.: „xYz“ instead of „xyz“)
  - the use of varying typefaces (e.g.: „xyz“ instead of „XYZ“)
  - omitting or adding an individual letter or character (hyphen), provided it is not phonetically or conceptually relevant (e.g.: „Jeanette“ vs. „Jeannette“)
  - the exchange of letters, provided that neither phonetics nor the concept are changed (e.g.: „The“ vs. „Tee“)
  - omitting word elements if the relevant trade circles do not ascribe any individual special character to them (e.g.: „The Bridge“ vs. „Bridge“)
  - splitting commonly used word marks of which the meaning is in the foreground
  - adding purely descriptive terms which do not merge with the registered word mark to one single sign (e.g.: “natural mineral water”)
5. Modification of word/figurative marks: The following modifications are uncritical:
  - minor graphical deviations, stylistic modernizations, if the unchanged motif is in the foreground

Critical modifications are:

  - changing the emphasis from the figurative element to the word element
  - omitting a figurative element, unless it serves purely decorative purposes, is commonly used in advertising, or represents a purely descriptive indication
  - adding figurative elements
  - changing the form of the trademark (e.g. from a word mark to a word/figurative mark)

**Please note: This checklist is only a rough guide line and does not replace a consultation in the individual case**