



Intellectual Property and Licenses

Recommendations for
Exhibitors in the Case of
Conflicts during and after
Tradeshows

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Introduction

It is not rare to see legal disputes arise at trade shows, either between exhibitors among themselves or between third parties and the exhibitors. These disputes often concern alleged or factual cases of trademark counterfeiting and product piracy, or the existence and scope of licensing agreements. Sanctions may be imposed for such violations under criminal law and under civil law.

The present brochure is intended to give you a few general indications of how you could forearm yourself, in preparing for a tradeshow, against any emerging legal conflicts, while it also sets out the options available to you if such legal disputes arise in the course of the tradeshow. By their nature, these guidelines cannot take the place of consultations with an attorney. That is why you will find, at the end of the brochure, a list of the law firms we recommend who are specialists in the field of intellectual property law.

What can be done in preparing for a tradeshow?

It is important to protect your intellectual property before presenting it at a tradeshow, both in order to safeguard it against counterfeiters and by way of defending yourself against unjustified attacks.

- First, you might consider registering your own patents, trademarks, utility models or designs with the Deutsches Patent- and Markenamt (DPMA, German Patent and Trade Mark Office) in due time prior to the tradeshow. Under certain circumstances, it may be worthwhile to register a European patent with the European Patent Office (EPO), or as a Community trademark or a Community design with the Trademarks and Design Registration Office of the European Union (Office for Harmonisation in the Internal Market (Trade Marks and Designs)(OHIM)). In addition to the designs registered, any Community design will be protected also without such registration if it is made available to the public for the first time in the territory of the European Union (such as at tradeshow). The contact information of DPMA, EPO and OHIM as well as other useful links has been set out at the end of the brochure under "Contact information of important authorities and institutions".
- Both for the event that you need to take action against someone, or that you need to defend yourself, you should take to the tradeshow all original documents, or copies certified by a notary, proving your legal status (trademark and patent deeds, licensing agreements, rulings, and affidavits / statutory declarations where applicable) and have these stored in a place from where they can be quickly procured. Should any rights be derived from licenses, particular care must be taken to ensure that the chain of rights is complete. For example, should your company have been granted a right under a sublicense, you will also have to submit the main license or demonstrate otherwise in a satisfactory way that this exists.
- Should a dispute under civil law develop with parties purporting to hold certain rights (for example by a warning letter being sent immediately prior to the tradeshow, or by difference of opinion as to the existence or scope of a licensing agreement), you have the opportunity to have a protective letter (Schutzschrift) be lodged with the courts to defend against any injunctions that may be threatened by such parties; specialist attorneys will take care of such matters. The protective letter should set out why there is no risk of any intellectual property rights being violated, and should provide a reasoning for this statement. Corresponding satisfactory evidence must be submitted to the court (excerpts from the Patent or Trade Mark Register, license agreements etc.). The advantage of a protective letter is on the one hand that, subject to certain conditions, it may protect you against an injunction being issued by a court, while any proper documentation of the intellectual property rights that you prepare will reduce the time and effort expended by your attorney in the matter, and thus your costs.

- Should there be indications that a preliminary investigation under criminal law has been initiated, and should you have the concern that the goods you are displaying may be confiscated by customs or the public prosecutor's office, you should likewise consult an attorney who may contact the responsible governmental authority, perhaps even before the tradeshow, and will be able to lodge a letter of protection with it on your behalf. While German criminal law does not explicitly provide for such letters of protection, the public prosecutor's office in Berlin has not objected to their being lodged.
- By contrast, should you come to the realization, in the final weeks and days prior to a tradeshow, or even while you are setting up your stand, that your intellectual property rights are at risk of being violated, you should collect all evidence suitable as evidence for such violation. In this way, you will be able to obtain an injunction from a civil court prior to the tradeshow, which the sheriff/bailiff (Gerichtsvollzieher) will then serve, during the tradeshow, on the party violating your rights (for further details, please see Part I, 1: Line of action against product pirates (in cases in which you are the plaintiff).
- Should any products be imported from non-EU countries ("non-Community goods"), it is possible to file an application (free of charge) prior to the tradeshow with the Zentralstelle Gewerblicher Rechtsschutz (ZGR, Central Office for the Protection of Intellectual Property) to have a Grenzbeschlagnahme (border seizure) initiated in accordance with the Produktpiraterieverordnung (Product Piracy Ordinance) in order to prevent any plagiarized products from entering Germany, thus ensuring that they are not presented at the tradeshow. It should be noted that in spite of the term, such "border seizures" can be made everywhere, not only at the German border but anywhere else in the country as well, in other words, also at the tradeshow in Berlin. The application must be processed within thirty days. Since September 1st, 2008, German law permits the destruction of the confiscated goods in the course of what is referred to as a "simple destruction process" (einfaches Vernichtungsverfahren), should the rightholder apply to have this done. Should the owner or possessor of the confiscated goods fail to object to the petition filed in this regard within ten (10) work days, his consent shall be deemed to have been granted and the goods so confiscated may be destroyed.

What options under law are available for legal disputes arising in the course of a tradeshow?

As stated in the introduction, two forms of legal disputes are conceivable. Either a dispute under civil law arises between exhibitors, or between an exhibitor and a third party, or a preliminary criminal investigation is initiated against an exhibitor because a third party or another exhibitor has filed a corresponding complaint. In both of these proceedings, under civil law and under penal law, it can be expected that enforcement measures will be taken while the tradeshow is still under way.

I. Civil law

Because we as the tradeshow host are under obligation to remain neutral, Messe Berlin GmbH may not intervene in any legal dispute for or against any party. In these events, solely the courts, attorneys or the police are the appropriate points of contact. Please find below some general information on what action to take and how to react in the event of disputes under civil law:

1. Line of action against product pirates (in cases in which you are the plaintiff)
 - In the event a patent, utility model, trademark, name, design or copyright of a party is infringed, the party whose rights are violated may procure not only that sanctions under civil law are imposed, it may also take recourse to the civil courts. Usually, this is achieved by obtaining an injunction.

No court (or judge) responsible exclusively for cases arising at a tradeshow is available at the tradeshow hosted by Messe Berlin GmbH. As a general rule, petitions for court injunctions are to be addressed to the Regional Court of Berlin:

**Landgericht Berlin, Littenstraße 12,
10179 Berlin-Mitte.**

- In such cases, only attorneys may file the corresponding petitions. The court may hand down, in summary proceedings, a preliminary cease-and-desist order (einstweilige Unterlassungsverfügung), and may additionally order the "sequestration" of the infringing goods. In the latter event, a sheriff/bailiff (Gerichtsvollzieher) will secure the pirated products.
- As a general rule, this procedure requires that it be demonstrated to the court in a satisfactory way that your company is the lawful holder of the corresponding rights. This means that your company either itself holds the trademark, patent, model or copyright in question, for which proof is to be submitted, for example in the form of

excerpts from the trademark register or patent register. Your company may also have derived such rights from one or several third parties, proof of which must also be submitted in the form of licensing agreements (make sure to have a complete chain of rights!); under certain circumstances, an affidavit / statutory declaration will need to be made.

- The attorney you will retain will also establish whether you need to send a warning letter prior to filing your complaint with the court since the matter may also be dealt with by the other party declaring that it will cease and desist from the infringement and that it agrees to pay liquidated damages should it fail to do so (vertragsstrafenbewehrte Unterlassungserklärung).
- The court may issue such injunctions within a few hours – often without having heard the opposing party! All that remains to be done is to have such injunctions enforced by a sheriff/bailiff (Gerichtsvollzieher), who is to be commissioned separately by the petitioner. The enforcement is carried out by serving the injunction (order to cease and desist) and/or by the “sequestration”, i.e. the seizure, of the pirated goods by the sheriff/bailiff.
- The minimum costs of bringing such an action (attorney’s fees and court costs) to settle tradeshow disputes will be a four-digit amount (Euros). It should be noted that in Germany, the costs incurred in bringing an action are imposed on the losing party.

2. Defending against judicial measures (in cases in which you are the defendant)

Often, people will allege that a product has been pirated or that a license agreement has been violated, although nothing of the sort has been done. In such cases, you must ensure that the court does not issue any orders against you. As already stated, an injunction may also be issued without the court having heard the opposing party; this means that any enforcement measures will come upon you unexpectedly.

- Should you become aware of a dispute developing already prior to a tradeshow (for example by someone alleging that you have pirated their products or that you have violated a licensing agreement, or by that party sending you a warning letter, etc.), you have the opportunity of defending yourself against any injunction that may be petitioned of the court. This is achieved by lodging a so-called protective letter (Schutzschrift) with the court before any petition

for an injunction is even filed. Only attorneys may lodge such protective letters with the Landgericht (Regional Court). The protective letter should set out why there is no risk of any intellectual property rights being violated, and should provide a reasoning for this statement. In this case as well, evidence satisfactory to the court must be presented (excerpts from the patent register or trademark register, licensing agreements, etc.).

- Often, if such a protective letter has been filed, the courts will not hand down a ruling without having heard the parties. This may very well mean that you will gain valuable time and that you will not be hindered by judicial measures, at any rate for the duration of the tradeshow.
- However, if an injunction is issued and served to you during the tradeshow, you must initially accept the measures taken by the sheriff/bailiff (service of the document, seizure of articles). The sheriff/bailiff is a judicial officer and does not represent the petitioner. He or she has powers that are reserved exclusively for the authorities. Should this be required, the sheriff/bailiff may call in the police. Therefore, you should not impede the sheriff/bailiff in his / her work. Rather, in such cases, it is highly recommended that you immediately consult a lawyer. In spite of the injunction having been served, or the measures having been taken by the sheriff/bailiff, it is still possible to lodge an objection. Since often, the results of an objection procedure are obtained too late for the tradeshow, your attorney could also contact the party that has obtained the injunction against you, in the interests of settling the matter outside of court, or to negotiate a "truce" at least for the duration of the tradeshow. Whatever happens, you should make sure you have the original copy of the court injunction shown to you, or that you at least note down the reference number of the judicial proceedings as well as the reference number used by the sheriff/bailiff.
- If you are served with a cease-and-desist order, you must comply with it immediately (regardless of whether or not it is justified and of whether or not you intend to object to it). Any violation is subject to a substantial fine determined by the court. Make sure to read the injunction served upon you carefully and to comply with every one of its stipulations, to the letter, once it has been served!
- If articles are seized, have the sheriff/bailiff give you a detailed list setting out the exact designations of the articles.

II. Criminal law

It may be that in the course of the tradeshow, you will be surprised by unexpected searches and seizures performed by governmental authorities (customs authority, tax investigation department, competition authority, police, public prosecutor's office, etc.). Due to the monopoly of governmental power and the state's authority to carry out investigations, solely the courts, the public prosecutor's offices, the customs officials or the Federal Police will be your contacts in formal terms. Messe Berlin GmbH is under obligation of accepting searches performed on its premises; it is what is called an innocent bystander. You should be aware that if the premises of a commercial enterprise are searched or articles are seized, this does not prove any criminal offense has been committed by its officers, nor does it prove any involvement of the company. The following sections will provide you with some general information on your options in taking action against or reacting to various situations governed by penal law:

1. Fundamentals

If premises are searched or articles are seized, there is hardly anything you can do at that particular moment. It is possible to lodge the remedy called an "appeal" (Beschwerde) with the competent Amtsgericht (Local Court) only after the fact, in order to have the court review whether the measure taken was in fact legal.

Likewise, there is nothing you can do to prevent documents and/or articles from being seized at the time this is being done. Here as well, the only remedy available to you is to lodge an appeal, which you may do only after the fact. The local court that has issued the order to have your premises searched or your goods seized is also initially responsible for your appeal.

Only rarely will the public prosecutor responsible for the investigation be present at such searches. Thus, discussing legal issues at this juncture (such as the evidence of a criminal offence etc.) will generally not serve any purpose.

If anyone attempts to prevent or to impede the search/seizure, the police may arrest that individual.

2. Recommended conduct

It is recommended that you follow the pointers set out below in order to enable matters to progress properly, and to safeguard your rights in the best possible way.

- The employee of your company having the highest rank should identify himself or herself to the investigating authorities as their point of contact. That employee should also approach the officer in charge and ask for their business card.
- You should make sure that in spite of the stressful and perhaps even emotional situation, a calm and friendly atmosphere prevails.
- Ask for the court order to search your stand or to seize your goods. Make sure you study it carefully.
- Searches and seizures are performed in the interests of discovering incriminating evidence. They may cause people to make spontaneous remarks or statements as witnesses that, at a later time, may turn out to have incriminated the company being investigated. In these situations, you should make it a principle to “listen – don’t speak!”
- Practical experience shows that introducing exonerating material to the investigation at an early time generally will have no effect whatsoever and is thus a wrong idea. Due to the strictures of time, the officers involved in the investigation will normally not be able to correctly assess the importance of this material. On the other hand, submitting a written statement to the investigating authorities at the right time may be a factor deciding the outcome of the investigation.
- When employees of the company being investigated are examined as witnesses by the police and/or public prosecutor’s office and/or judge, neither the company management nor representatives of its legal department have the right to be present at the examination. The situation is different for the defense attorney and for any legal counsel assisting a witness. For this reason, it is urgently recommended that you contact an attorney immediately.
- Do not allow any witnesses to be examined at the stand on the tradeshow (the public prosecutor’s office and the police departments all have examination rooms of their own); do not assist the investigating authorities just to be nice; do not make any spontaneous statements the effects of which you cannot assess.
- No witness, no suspect, no party charged with a crime is under obligation to make a statement to the police or to the tax investigation department. It is not required that such party avoid incriminating himself or herself in order to remain silent; they may simply refuse to make a statement. It is different for witnesses being examined

by the public prosecutor's office or by officers assisting the public prosecutor's office: unless they run the risk of incriminating themselves, they must make a statement. It is always better, in all cases, to forgo making an oral statement and to refer all inquiries to your attorney.

- It bears noting that neither the members of a company's board of management nor its employees must remain on site for the entire duration of the search.
- Nor is there any obligation to inform the police officer performing the search of where in the company or on the stand he or she will find something. You may do so, but you need not.
- Under certain circumstances, you may be able to procure that important documents are copied prior to being seized, to ensure you are able to continue your business operations.
- It is not permissible to seize computers that are being used as a work tool, nor may cell phones be seized. It is usual procedure to secure and seize computer files by mirroring the hard disks or by downloading data onto USB memory sticks. Should they contain confidential data, it may be possible, under certain circumstances, for you to procure that the data will be inspected only after the confidential files have been removed.
- Should the authorities not take any documents and/or objects with them, and instead "seal" them on site, in order to prevent them from being accessed further or modified, the responsibility of Messe Berlin GmbH in spatial terms ends at that point. Measures taken by governmental authorities supersede the right of the owner of premises to their undisturbed possession, meaning that Messe Berlin GmbH is no longer responsible. Should any damages occur after the documents and/or objects have been sealed, the authority responsible or, respectively, the government agency this authority represents will be the party to contact.
- Following the search, a list will be prepared of those documents / objects that are to be "taken along". Make sure that by way of exercising the utmost precaution, you object to the documents / object being taken along, in order to ensure that they must be seized. This is important because only in the event of a seizure does the company have any remedies available to it. If you permit the authorities to take the documents / objects with them, they will have "secured" them, and it will hardly be possible to review the circumstances of this measure after it has been taken.

Contact information of the responsible authorities and institutions

Deutsches Patent- and Markenamt
(German Patent and Trade Mark Office)
Zweibrückenstrasse 12, 80331 Munich
Phone: +49 (0)89 2195-0
Fax: +49 (0)89 2195-2221
E-mail: info@dpma.de
Website: www.dpma.de

European Patent Office (EPO)
Main office Munich
Erhardtstrasse 27, 80469 Munich
Fax: +49 (0)89 2399-4465 or
Bayerstrasse 34, 80335 Munich
Fax: +49 (0)89 2399-4465
For other offices of the EPO, please see the address list posted on their website
Switchboards:
Munich: +49 (0)89 2399-0
The Hague: +31 (0)70340-2040
Berlin: +49 (0)30 25901-0
Vienna: +43 (0)1 52126-0
Website: www.epo.org

Office of Harmonization for the Internal Market (OHIM)
Avenida de Europa, 4, E-03008 Alicante
Spain
Phone: +34 (0)965 139 100
Telefax: + 34 (0)965 131 344
E-Mail: information@oami.europa.eu
Website: www.oami.europa.eu

Bundesfinanzdirektion Südost
Zentralstelle Gewerblicher Rechtsschutz (ZGR, Central Office for the Protection of
Intellectual Property)
Sophienstrasse 6, 80333 Munich
Phone + 49 (0)89 5995-2349
Telefax: +49 (0)89 5995-2317
E-Mail: zgr@ofdm.bfinv.de
Website: www.ipr.zoll.de

Industrie- and Handelskammer Berlin
(IHK, Berlin Chamber of Commerce and Industry)
Fasanenstrasse 85, 10623 Berlin
Phone: +49 (0)30 315 10 - 0
Fax: +49 (0)30 315 10 - 166
E-mail: service@berlin.ihk.de
Website: www.ihk-berlin24.de

Rechtsanwaltskammer Berlin
(Berlin Chamber of Attorneys)
Littenstrasse 9, 10179 Berlin
Phone: +49 (0)30 30 69 31 0
Fax: +49 (0)30 30 69 31 99
Email: info@rak-berlin.de
Website: www.rak-berlin.de

Patentanwaltskammer
(Chamber of Patent Attorneys)
Tal 29, 80331 Munich
Phone: +49 (0)30 242278-0
Fax: +49 (0)30 242278-24
E-mail: dpak@patentanwalt.de
Internet: www.patentanwalt.de

Bundesministerium für Wirtschaft and Technologie
(Federal Ministry of Economics and Technology)
Website: www.patentserver.de

Recommended attorneys

Should you require the assistance of an attorney before the tradeshow or during it, we recommend the following law firms:

BMH BRÄUTIGAM & PARTNER, Schlüterstr. 37,
10629 Berlin, www.bmh-partner.com;
Phone: +49 (0)30 889 19-0, Fax: +49 (0)30 889 19-100;
your contacts are Dr. Benedikt Bräutigam, attorney and notary, and
Johannes Wolf, attorney.

BOEHMERT & BOEHMERT, Meinekestr. 26,
10719 Berlin, www.boehmert.de,
Phone: +49 (0)30 31 50 51 50, Fax: +49 (0)30 31 50 51 51;
your contacts are Dr. Christian Czychowski, attorney, specialist attorney for
information and technology law, specialist attorney for copyright and media
law, and Dipl.-Phys. Dr. rer. nat. Thomas L. Bittner, patent attorney.

BREHM & v. MOERS, Anna-Louisa-Karsch-Str. 2,
10178 Berlin, www.bvm-law.de,
Phone: +49 (0)30 269395-0, Fax: +49 (0)30 269395-15;
your contacts are Dr. Benedikt Wemmer, attorney, and
Prof. Dr. Alexander Freys, attorney and notary.

HERTIN ANWALTSSOZIETÄT, Kurfürstendamm 54/55,
10707 Berlin, www.hertin.de,
Phone: +49 (0)30 885 929-0 / Fax: +49 (0)30 885 929-29; your contacts are
Dr. Hermann-Josef Omsels, attorney, and Dr. Sven Lange, patent attorney,
European Trademark and Design Attorney.

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Leipziger Platz 10, 10117 Berlin, www.knauthe.com;
Phone: +49 (0)30 20670-1634, Fax: +49 (0)30 20670-1699; your contacts
are Prof. (NNU) Dr. Frank A. Hammel, Director IP Law Institute Nanjing,
attorney and specialist attorney on the protection of industrial and
intellectual property rights, and Ms. Tara Schollemann, attorney.

NÖRR STIEFENHOFER LUTZ, Charlottenstr. 57,
10117 Berlin, www.noerr.com;
your contacts are Dr. Ulrich Michel, Head of IP and Media Practice,
Phone: +49 (0)30 20942062 (assistant),
+49 (0)30 20942005 (direct dial), +49 (0)170 9264986
(mobile) or Dr. Tobias Frevert, IP Expert,
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