

## Why automotive companies in the connected car and autonomous driving industry need to review their trademark portfolios

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With the momentum building in the trend towards connected and autonomously driven vehicles, automotive companies should review their trademark portfolios to ensure that their key marks are covered for goods and services in this space.

Dr. Andreas Renck, Alicante Office Managing Partner at Hogan Lovells, sees the established practice of classification of goods and services provided under a given brand as the foundation of any trademark portfolio. Companies in the United States and Europe use the World Intellectual Property Office's Nice Classification (NCL) to classify their trademarks and thus ensure their protection. NCL comprises 45 categories under which applications can be classified; Classes 1 through 34 are for products, and 35 through 45 are for services. Under these classes, each mark must be designated for specific products and/or services.

In this [hoganlovells.com](http://hoganlovells.com) interview, Dr. Renck discusses emerging issues that are impacting the traditional trademark registration process, and offers tips to help automotive companies protect their brands as the automotive and mobility industry continues to expand.

### How are connected cars and autonomously driven vehicles changing the way automotive companies register their trademarks?

**Renck:** Of the NCL 45 classes, automotive companies have tended to register their brands only in a few classes that are clearly related to the sector. Traditionally, automotive model brands have been registered in Class 12 for vehicles and 37 for repair services alongside a few other related classes such as 7 for motors and engines, 9 for batteries, 11 for headlights, or 39 for rental. However, if we open up to autonomous driving and e-mobility, a number of additional classes need to be considered. Electronic equipment and related vehicle tracking services, for example, fall into Class 9 and 39. Similarly, Class 38 coverage should be assessed, which is for telecommunications and would normally be occupied by telecommunications companies. Even if the class number is already included under existing registrations, further items under that class may need adding.

Companies in this space may need to review their portfolios periodically. The constant evolution

in the sector means it's not 100 percent clear how autonomous driving will function in the future. As I mentioned, at some stage automotive companies may, in part, be operators of telecommunications systems within their own autonomous driving services.

A further key consideration when assessing classification is trademark hijackers, who will also be attempting to register automotive brands in bad faith for classes that could one day be a piece of the puzzle, with the sole intention of financial gain in return for transferring the trademark ownership.

## You said that car companies had registered primarily for Classes 12 and 37. What do those Classes cover?

**Renck:** Let's be clear that this is a historical perspective. Class 12 covers vehicles — specifically, apparatus for locomotion by air, land, and water but even in the past it did not give cover-all protection as the class excludes certain key parts for the automotive industry. Of course, when our team works with an automotive portfolio we don't just have cars and trucks in mind, evolving tech in the sector such as drones are also covered as well as construction vehicles, other aviation, and nautical craft, etc. Then you have Class 37, which covers building construction, repair, installation, and maintenance services that can be closely related to this business sector.

## Patent troll litigation is a hot issue in the United States. If automotive manufacturers don't properly protect their trademark portfolios, do you expect similar challenges?

**Renck:** There is a parallel scenario, for example, where an automotive manufacturer's brand or house mark is "hijacked" by a third party for unprotected goods or services, the manufacturer is no longer able to stop the third party from using the trademark through litigation-based IP registration ownership.

To give a concrete example, an automotive manufacturer could in the future offer car-sharing services, but what if they don't register their house brand for car-sharing services? Then they risk encountering issues in offering that type of service in a certain jurisdiction. Jurisdiction is a big consideration here; even if the services are protected in the United States or Europe, other jurisdictions — specifically in South America, where trademark hijacking is very common — the manufacturer can avoid issues through extending protections there.

Granted, filing trademarks in those jurisdictions can be much more expensive than in the U.S. or Europe, so companies must assess risk around the world in the context of their business model and hit a balance of protection to avoid such issues in the future.

## What service offerings do you provide to help companies review their brand portfolios?

**Renck:** Companies come to us, we look at their portfolios, and we identify gaps for certain marks and classes in the different jurisdictions. We can do a global search of their portfolio and see whether they cover the most important classes in the actual e-mobility or self-driving space. We also talk to clients before conducting this search and re-examine which business areas they are developing in this sector and how far each of these brands may be used for that type of good or service. A very specific search is carried out in relation to each of the brands they have and may use. Of course, review does not always imply further filing. Some of the company's brands may not ever be used for autonomous driving, e-mobility, or connected vehicles and will actually be limited to a specific use. This said, the house brand should always be protected as broadly as possible.

## Beyond brand hijacking, are there any other risks that automotive companies should know about to ensure their portfolio protection program is adequate?

**Renck:** Yes, another area that will be important once the portfolio is put in place is to ensure that companies register new trademarks or marks with extended protection with the relevant customs offices around the world. Any offerings in this space that infringe the trademark rights of a given automotive brand can then be stopped at the borders, even where the brand has not yet been fully rolled out for autonomous driving, e-mobility, or connected vehicles.

This is an integral part of our service: filing customs applications for clients around the world to enable customs enforcement agencies to seize infringing products.

## Should automotive companies review their existing coexistence agreements?

**Renck:** Yes, this is another issue that comes to mind that automotive companies should include when they're moving into new areas of the mobility space. Where parties own similar or identical trademarks, but operate in different business areas, coexistence agreements can avoid infringement actions. For example one party may agree to only use the mark for vehicles, and the other party only for electronic products. Previously, agreements were based on the traditional automotive classes as mentioned but now companies in the automotive space could encounter problems if for example, they agree not to use a trademark for communications and this then becomes a key service in their offering.

With this in mind, automotive companies should closely review current coexistence agreements to make sure that if they expand into new areas, especially in relation to their house mark, they don't infringe those previously signed agreements.

### About Dr. Andreas Renck

Andreas Renck has been advising on intellectual property law, particularly EU trademark and

community design law, international IP prosecution, and litigation for a number of international clients. Having been involved in thousands of application and opposition proceedings before the European trademark office (EUIPO) in Alicante, his knowledge and skills also span from representing clients in major cases before the General Court and Court of Justice in Luxembourg, to coordinating litigation proceedings in various European countries. In addition, Renck has been coordinating worldwide or regional IP settlements. He has been recognized as one of the best experts on EU trademark law by WTR (World Trademark Review).

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