Recent Case Law in Trademark, Design, Unfair Competition and Copyright Law

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CONTENT

FOREWORD

Dear readers,

We are pleased to have been able to present you with interesting rulings from our practice area every year for the past 10 years. This year, too, we have compiled a selection that we hope will offer you inspiration and insights from the fields of trademark law, competition law, design law, and copyright law.

Two decisions from the European Court of Justice have made their way into this collection: In the area of copyright law, we examine the eagerly awaited guidance on the criteria for works of applied art (*Mio / konektra*), and in the area of design law, we explore the guidelines on the distinctive character of Community designs in the context of pre-existing design elements and fashion trends.

The focus of this issue, however, is on trademark law: The European Court of Justice examined the scope of an injunction extending beyond national borders and ruled on the bad faith of a trademark applicant who sought to extend the monopoly on a patented solution through a specific design of the colour trademark. Let's turn to Germany: In the *Hecht H 15* decision, the Federal Court of Justice addressed the use of a trademark to maintain its rights and the scope of its protection as a combination mark, as well as the protection of work titles for the names of fictional characters from film works (*Moneypenny*) and a trademark application filed in bad faith (*Testarossa*). The Higher Regional Court of Cologne issued a decision regarding geographical indications of origin, specifically *Dubai-Schokolade*.

An article comparing the procedural requirements for mandatory publication of judgments – examining the standards in Germany, Austria, and the Unified Patent Court – rounds out this comprehensive overview.

The following reports explain the background and key features of each decision, as well as the personal assessment of the respective author.

We hope you find this an interesting read. If you have any questions or comments regarding individual decisions or other topics in the areas of trademark law, competition law, design law, or copyright law, please feel free to contact us.

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I. TRADEMARK LAW

1. Use of a trademark to maintain rights to the registration and the scope of its protection as a composite mark

Federal Court of Justice, order of 20 November 2025, I ZB 30/25 – H15/Hecht H 15

BACKGROUND

In trademark opposition proceedings before the German Patent and Trademark Office, the earlier trademark "H 15", protected inter alia for "pharmaceuticals", is opposed by the younger trademark "Hecht H 15", which claims "food supplements".

In the lower instances before the Office and the Federal Patent Court (BPatG), the opponent was successful, and the cancellation of the applicant's trademark was ordered. The applicant lodged an appeal with the Federal Court of Justice (BGH).

DECISION

The applicant's appeal is successful. The applicant had validly contested the use of the earlier trademark "H 15". The opponent's evidence of use related to the distribution of an anti-inflammatory Ayurvedic product manufactured in India, labelled "H 15 Gufic Tablets", which was supplied to the German importer. The Federal Court of Justice first confirms that even a mere delivery to the domestic importer constitutes use preserving rights, and that the tablets delivered are also to be regarded as pharmaceuticals in view of the protected definition of the goods.

The Federal Court of Justice then confirmed that, although the use of the trademark "H 15" in the form "H 15 Gufic" deviates from the registered form, there is nevertheless no detrimental alteration to the distinctive character of "H 15". When two elements are used in combination, there are, in principle, two possible interpretations: It would initially seem obvious that the relevant public would perceive a composite, unified sign consisting of two parts – in which case it would not constitute use preserving the rights. In the specific case, however, the concrete combination may be seen as two distinguishable signs – in the sense of a secondary sign, it would then constitute use preserving the rights of the trademark "H 15". The Federal Court of Justice concludes that the second scenario applies because "Gufic" is a name of the company producing the medicines that is well known in the relevant public, or is derived from the manufacturer's details on the packaging. This preserves the distinctive character of the trademark.

However, the proof of use fails because it was not demonstrated to the Court's satisfaction that "H 15" could be regarded as use in the manner of a trademark in this specific case; rather, it is more likely that "H 15", as a combination of a letter and a number, merely represents a designation of the product within the manufacturer's range and not an independent trademark. The Federal Court of Justice therefore refers the matter back to the Federal Patent Court to clarify this point in more detail.

The Federal Court of Justice then also provides the Federal Patent Court with "guidance" in the event that the use of "H 15" as a trademark is confirmed on the basis of the circumstances of the individual case. In this regard, the Federal Court of Justice confirms that there is a likelihood of confusion between "H 15" and "Hecht H 15".

Firstly, the Federal Court of Justice confirms an average similarity of goods between food supplements and Ayurvedic medicines, as relevant similarities can be identified in distribution (possible via pharmacies) and in intended use (positive influence on physical well-being).

The Court ruled out a direct likelihood of confusion because the later mark contained the additional element "Hecht". Although this is the abbreviated form of the applicant's name, and the company name – which is clearly recognisable to the public – would normally take a back seat in the overall impression, the abbreviated form of the name does not take a back seat in the overall designation because both elements are of equal weight in this specific case. However, the Court assumes a likelihood of confusion in a broader sense. The element "H 15" occupies an independently distinctive character within the overall designation and is identical to the earlier trademark. The reason lies in the fact that the younger trademark has incorporated the earlier trademark into a composite sign that includes the applicant's company name, thereby creating the impression that the products in question originate from economically linked undertakings. Such a likelihood of confusion may – as the Federal Court of Justice clarifies – also exist in cases where the goods in question are not identical but sufficiently similar, which is affirmed in the present case.

ASSESSMENT

A trademark that combines a company slogan with a further element is subject to specific rules both with regard to use for the purposes of maintaining rights to the registration and with regard to the likelihood of confusion with a younger trademark.

On the basis of the important decision of the European Court of Justice in the *Thomson Life* case (judgment of 6 November 2005, C 120/04), a likelihood of confusion may exist if the disputed sign is formed by the combination of a company name and an element possessing normal distinctive character, and this element retains an independent distinctive position within the combined sign without, on its own, dominating the overall impression of the combined sign. Although this is an exceptional case, an indirect likelihood of confusion can nevertheless be well substantiated if the company slogan is clearly recognised as such and the other component of the sign is in any event not descriptive. This also applied to the present case, which strengthens the legal position of the proprietor of the earlier trademark, which is, as it were, usurped in the new combination. The Federal Court of Justice's decision is important because it confirms that this line of argument is also possible where the goods in question are not only identical but may also be merely similar.

Similar considerations apply to the further question of whether the use of a trademark containing a single element constitutes legitimate use where that element is linked to the proprietor's corporate slogan. The decisive factor here is whether this single element is sufficiently distinctive and can therefore function as a trademark. This may be problematic in the case under discussion. In any event, it is advisable for trademark proprietors to clearly emphasise the single element in such cases, for example by highlighting it through size or colour scheme, or by placing the ® symbol in isolation. (Ebert-Weidenfeller)

2. Misleading use of the name 'Dubai Chocolate' for a Turkish product – Strict protection of geographical indications despite social media hype

Cologne Higher Regional Court, judgment of 27 June 2025, 6 U 52/25 – Dubai-Schokolade

BACKGROUND

The proceedings essentially concerned the legal assessment of whether a chocolate product may be advertised and sold under the name "Dubai Chocolate" if the chocolate product was not manufactured in Dubai and has no other geographical connection to Dubai.

The applicant was a confectionery retailer who imported the Dubai-manufactured "L.-Dubai-Schokolade" from a Dubai-based company exclusively for the European market and sold it in Germany through wholesale and retail channels, as well as online at times.

The respondent imported and distributed the chocolate product "ALYAN Dubai Hand-made Chocolate" on the German market, which was advertised as "Dubai Chocolate" from 16 December 2024. In fact, however, the chocolate had been manufactured in Turkey.

The front of the packaging for the chocolate product "ALYAN Dubai Handmade Chocolate" featured, among other things, the product name with the word "Dubai" highlighted in larger type, as well as a product description in English. In addition, the Dubai skyline was depicted, including the silhouettes of the famous buildings "Burj al-Arab" and "Burj Khalifa". On the reverse of the packaging, however, the words 'Product of Turkiye' appeared in small print in the information on packaging disposal, and 'Turkiye' in the details regarding the manufacturer.

The applicant regarded this as an unauthorised use of a geographical indication of origin, which gave rise to a risk of misleading consumers as to the origin of the goods. He therefore applied for a preliminary injunction aimed at prohibiting the distribution and advertising of the chocolate product under the name "Dubai Chocolate", provided that it was not manufactured in Dubai and/or had no other geographical connection to Dubai.

The Regional Court of Cologne had dismissed the application for a preliminary injunction at first instance. In its reasoning, it stated that the relevant public no longer under-stood the term "Dubai" as an indication of origin, but rather as a reference to a specific chocolate recipe, namely one made from pistachios, angel hair (kadayif) and chocolate, or to a trendy product. In any event, there was no risk of confusion as to the geographical origin within the meaning of Section 127(1) of the German Trade Mark Act (MarkenG).

The applicant lodged an appeal against the judgment of the Regional Court of Cologne.

DECISION

The Higher Regional Court of Cologne has amended the judgment of the Regional Court and, by way of an interim injunction, prohibited the defendant from marketing a chocolate product bearing the designation 'Dubai Chocolate' in the course of trade in Germany and/or from advertising and/or having it marketed and advertised on, provided that the chocolate product was not manufactured in Dubai and/or has no other geographical connection to Dubai. In doing so, the Higher Regional Court of Cologne upheld a claim for an injunction or cease-and-desist order pursuant to Section 128(1) sentence 1 of the German Trade Mark Act (MarkenG) in conjunction with Section 8(3) No. 1 of the German Unfair Competition Act (UWG), Section 127(1) and Section 126 of the German Trade Mark Act (MarkenG). Pursuant to Section 128(1) sentence 1 of the German Trade Mark Act (MarkenG), any person who, in the course of trade, uses names, indications or signs contrary to Section 127 MarkenG may be subject to a claim for an injunction by those entitled to assert claims under Section 8(3) of the German Unfair Competition Act (UWG) where there is a risk of repetition.

Under Section 127(1) of the German Trade Mark Act (MarkenG), geographical indications of origin may not be used in the course of trade for goods or services that do not originate from the place, region, area or country designated by the geographical indication of origin, if the use of such names, indications or signs for goods or services of a different origin creates a risk of misleading the public as to the geographical origin.

The decisive factor for the infringement of Section 127(1) of the German Trade Mark Act (MarkenG) was therefore, in the first instance, that, in the opinion of the Higher Regional Court of Cologne, the designation 'Dubai Handmade Chocolate' constituted, from the outset and still does, a geographical indication of origin within the meaning of Section 126(1) sentence 1 of the German Trade Mark Act (MarkenG).

Under Section 126(1) of the German Trade Mark Act (MarkenG), geographical indications of origin are the names of places, regions, areas or countries, as well as other indications or signs used in trade to identify the geographical origin of goods or services.

The Higher Regional Court of Cologne clarified that the relevant public, i.e. the general consumer, would understand the designation "Dubai Handmade Chocolate" as an indication of origin, but not as a reference to the recipe, nor as a purely fanciful designation. In doing so, the Higher Regional Court of Cologne proceeded from the legal principle that designations which directly refer to a specific origin are to be regarded as designations of origin until it is established beyond doubt that their purpose is merely to serve as a quality indication detached from local origin or as a purely fanciful designation. In this respect, strict standards are to apply in favour of strong protection for geographical indications of origin.

The fact that consumers would perceive the designation "Dubai Handmade Chocolate" as an indication of origin is evident, inter alia, from the fact that the "hype" surrounding "Dubai chocolate" actually originated in Dubai, namely through the invention of the recipe there. Furthermore, "Dubai chocolate" had gained nationwide recognition in Germany through videos by two influencers who had each tasted the chocolate in Dubai. In the court's view, the particularly high prices and the initially limited availability of "Dubai chocolate" in Germany were also decisive factors in classifying it as a geographical indication of origin. Furthermore, the perception of it as a designation of origin was reinforced by the design of the product packaging.

The Higher Regional Court of Cologne ruled out a shift in meaning to a generic term pursuant to Section 126(2) of the German Trade Mark Act (MarkenG), citing the strict requirements applicable in this regard. It stated that there is a list of rules and exceptions between a geographical indication of origin and a generic term. The burden of proof for a shift in meaning to a generic term lies with the infringer.

In this specific case, it cannot be assumed that only a negligible proportion of the relevant public would still perceive the indication as a source identifier. Furthermore, the fact that only 10 months elapsed between the public perception of 'Dubai Schokolade' in Germany and the hearing does not support the argument that the term had subsequently become a generic description, as such a change typically takes place gradually.

Furthermore, the Higher Regional Court of Cologne affirmed that there was a risk of confusion regarding the geographical origin of the chocolate product within the meaning of Section 127(1) of the German Trade Mark Act (MarkenG). This is because a not insignificant proportion of the relevant consumers understood the designation as an indication of origin from Dubai and would be disappointed in this expectation, as the chocolate actually originated from Turkey. The references on the back of the packaging, 'Turkiye' and 'Product of Turkiye', were deemed insufficient to eliminate the risk of misleading consumers.

Furthermore, the Higher Regional Court of Cologne affirmed the relevance of the misleading nature of the indication to the decision to purchase. Indications of geographical origin are, in principle, relevant to the decision to purchase. In this specific case, the expected origin from Dubai was a key motive for purchase due to the associated sense of exclusivity and luxury.

In the view of the Higher Regional Court of Cologne, the prohibition on the use of an incorrect geographical indication of origin was also proportionate. It would be perfectly possible for the defendant to clarify, by adding a phrase such as ‘Dubai Style’, that its product merely draws on the original in terms of its recipe, but not in terms of its place of origin.

ASSESSMENT

The decision of the Higher Regional Court of Cologne highlights the strict protection afforded to geographical indications of origin under Sections 126 et seq. of the German Trade Mark Act (MarkenG) and the consistent application of these provisions even to products that are ‘hyped’ on social media. Even intensive media coverage and the emergence of a viral product trend are not sufficient to establish a generic term within the meaning of Section 126(2) of the German Trade Mark Act (MarkenG), as long as a proportion of consumers continue to assume an indication of origin. In this respect, it is generally regarded as detrimental to a generic term if 10%–15% of the target consumers still perceive it as an indication of origin, a point also highlighted by the Higher Regional Court of Cologne in its decision. Consequently, the designation is still regarded as a geographical indication of origin, even if a significant proportion of consumers are more likely to associate the designation with a specific recipe or a trend.

Noteworthy is the strong consideration given to actual market and communication conditions: the product’s origin in Dubai (product development and the birthplace of the hype), the significance of influencer videos on social media platforms with a wide reach, in which a chocolate product originating from Dubai is consumed in Dubai, the high price of the product and its limited availability in German retail outlets were used as factual assessment criteria for a geographical indication of origin within the meaning of Section 126(1) of the German Trade Mark Act (MarkenG).

Of great practical importance, too, are the strict requirements governing the design of ‘delocalising’ notices, which are intended to inform the relevant public of the true place of manufacture. Accordingly, information regarding the actual place of manufacture printed in very small type and placed in a rather inconspicuous location on the back of the product packaging is generally unlikely to be sufficient to eliminate the risk of misleading the public if there are strong indications of a geographical indication of origin on the front of the packaging. Such strong indications of a geographical indication of origin could include, for example, relevant graphic elements on the front of the packaging, as well as the use of the English language, which could suggest that the product is an import.

In practice, the ruling means that the names of places, regions, areas or countries, as well as other information or symbols indicating geographical origin, should only be used in conjunction with a clear qualifier such as ‘style’ if there is in fact no corresponding connection to the place of origin. Overall, the ruling of the Higher Regional Court of Cologne is likely to serve as an important precedent for future cases in which products linked to viral trends are advertised or sold using geographical names without being produced there. (Albertsen)

3. Possession of goods infringing trademark rights abroad – Tradeinn Retail Services

European Court of Justice, judgment of 1 August 2025, C-76/24 – Tradeinn Retail Services (Extreme Durable)

BACKGROUND

A German company is the proprietor of two German trademarks registered, inter alia, for diving apparatus and diving accessories.

The defendant is a company based in Spain which sells diving accessories bearing the identical trademarks via its own website and via Amazon. The listings also displayed images showing the goods on which the trademarks were affixed.

The German company brought an action against the Spanish company before the Regional Court (LG) of Nuremberg-Fürth, seeking, among other things, an injunction against the use of the trademarks in Germany. The application for an injunction was worded such that the defendant was to be prohibited from affixing the trademarks to diving accessories, offering, manufacturing, distributing or otherwise placing diving accessories on the market under these trademarks, advertising them for these purposes, or possessing them for the aforementioned purposes.

The defendant partially acknowledged the claim, specifically in relation to offering and advertising. In its judgment of 3 February 2022, the LG Nuremberg-Fürth ruled solely on the basis of this acknowledgement, namely, among other things, to refrain from offering for sale or advertising diving equipment bearing signs identical to the trademarks in question. The remainder of the claim was dismissed.

On appeal by the plaintiff, the Nuremberg Higher Regional Court ruled in its judgment of 29 November 2022 that the defendant was additionally prohibited from distributing diving accessories bearing the trademarks or from possessing them for the aforementioned purpose.

The defendant lodged an appeal against this decision with the Federal Court of Justice (BGH). The BGH referred two questions to the European Court of Justice regarding the interpretation of European law.

DECISION

The ECJ was asked to interpret the legal provision which lists the prohibited acts in a non-exhaustive manner ("in particular"), namely that it is prohibited "to offer goods for sale, to put them into circulation or to possess them for the aforementioned purposes under the sign", Section 14(3)(2) of the German Trademarks Act. This provision implements almost verbatim the requirement set out in the European Trademark Directive (Article 10(3)(b) of Directive (EU) 2015/2436).

With its first question, the Federal Court of Justice sought to ascertain whether the proprietor of a national trademark – i.e. one protected only in a single Member State – can prohibit a third party from possessing goods in another EU Member State that bear a sign identical to that trademark, on the grounds that those goods are intended to be offered for sale or placed on the market in the Member State where that trademark is protected. In other words: can the possession in Spain of goods intended to be offered for sale or placed on the market in Germany, and bearing a trademark protected only in Germany but not in Spain, be prohibited?

The ECJ did indeed recognise the territoriality principle of national trademark law, meaning that protection is, in principle, limited to the territory of the Member State in which the trademark is registered. However, it pointed out that it had already ruled that an online offer, where the supplier, or the website's server, or the goods themselves, are located outside the Member State in which trademark protection exists, may also be prohibited if the offer or advertising is directed at consumers within the territory of that Member State. Otherwise, given the prevalence of online trade today, the practical effectiveness of trademark protection would be undermined, as providers outside the relevant country would not be required to respect trademark rights. And because the legal provision to be interpreted prohibits possession only 'for such purposes', i.e. for the purpose of offering or placing on the market, the issue concerns only the possession of such goods as are intended to be offered in Germany in the specific case.

The ECJ therefore answered the first question by stating that the proprietor of a trademark is entitled to prohibit a third party from possessing the goods outside the territory of trademark protection if such possession constitutes a preliminary stage to the supply or execution of an offer, so that the possession can be regarded as being exercised for that purpose.

With its second question, the Federal Court of Justice sought to ascertain whether 'possession' within the meaning of the provision is to be interpreted as requiring direct and actual control over the goods, or whether it is sufficient to have supervisory or managerial authority over the person who has direct and actual control over the goods.

This is because German law distinguishes between 'direct possession' (direct and actual control) and 'indirect possession' (supervisory or managerial authority over the person in direct possession). In practical terms, this therefore means whether the possessor has the goods under their direct control (in short: in their own warehouse), or whether they are stored with a service provider, such as a freight forwarder.

The background to the question was that the provision in other EU languages does not refer to 'possess', but uses words that mean more along the lines of 'store', such as the English 'stocking'. Accordingly, from the perspective of storage, it would be understood to mean that direct control is decisive, whereas 'possess' could be interpreted somewhat more broadly.

Since the purpose of the provision is to put an end to a third party's unlawful use of a trademark, it therefore covers all persons who are directly or indirectly in a position to bring such use to an end.

Thus, according to the ECJ, 'possess' within the meaning of the provision covers not only cases where the third party has direct and actual control over the goods in question, but also cases of indirect, yet still actual, control over those goods, since the third party has supervisory or managerial authority over the person who holds direct and actual control over those goods. Otherwise, the provision could be circumvented by handing the goods over to a service provider for storage or transport.

ASSESSMENT

The ECJ's decision is consistently aimed at the effective enforcement of trademark protection. Thus, the relevant protection is to be guaranteed even where the infringer is based abroad and holds goods there that are intended for distribution in Germany.

Of course, the question of the enforceability of such a ban must be raised, as in most cases the goods themselves are labelled in such a way that they can be sold in several countries (multilingual or English-only packaging, instructions, etc.). However, it is entirely conceivable that an infringer might use different service providers, such as freight forwarders, for different markets, so that the goods in a specific freight forwarder's warehouse are undoubtedly intended solely for delivery to Germany (Brecht)

4. No copyright protection for the names of fictional characters from films

Federal Court of Justice, judgment of 4 December 2025, I ZR 219/24 – Moneypenny

BACKGROUND

The claimant is named in the copyright notice on copies of films from the James Bond series.

Since 1962, 25 James Bond films have been released, with the first films based on the novels by the British author Ian Fleming.

The character 'James Bond' is a secret agent working for the British secret service MI6; the character 'M' is the head of MI6 and 'James Bond's' superior; and the character 'Moneypenny' or 'Miss Moneypenny' is 'M's' secretary.

The claimant was the proprietor of the EU word mark No. 005247374 'MONEYPENNY', which was cancelled with effect from 14 May 2020, and on 18 November 2015 filed an application for the EU word mark 'MONEYPENNY' under the reference number cited, against which the second defendant filed an opposition against, which is currently still pending.

Defendant 1) was entered in the commercial register of the Local Court of T. on 19 November 2019 under the company name stated in the heading. Defendant 2) is the managing director and sole shareholder of Defendant 1). The object of Defendant 1)'s business is the holding and management of trademark rights, in particular, in relation to secretarial and assistance services for businesses, and the granting of rights of use thereto. Defendant 2) is the proprietor of the German word mark No. 302015103606 'MONEYPENNY' with a priority date of 19 June 2015.

The claimant asserts rights to the sign 'MONEYPENNY' and objects to the use of the sign on the websites www.my-money-penny.com, www.moneypenny-werden.com and www.my-moneypenny.de

The claimant bases its claims for an injunction primarily on competition law, in the alternative on protection of the title of a work, and in the further alternative on a trademark based on acquired distinctiveness through use. Furthermore, it has demanded removal, destruction, domain deletion, a change of company name, trademark cancellation, disclosure of information, an accounting of profits, a declaration of damages, and reimbursement of the costs of the market research reports it has submitted.

DECISION

The Federal Court of Justice (BGH) dismisses the plaintiff's appeal, holding that the Higher Regional Court (OLG) was correct in rejecting the plaintiff's claims under Section 15(1) and Section 5(1) and (3) of the German Trade Mark Act (MarkenG). The name of the fictional character 'Moneypenny' from the James Bond film series does not enjoy title protection under Section 5(1) and (3) of the German Trade Mark Act (MarkenG).

In principle, the name of a fictional character from a novel, play or film may also qualify for title protection as part of a work. Fictional characters generally constitute an intangible result of creative labour, manifested in their invented appearance and character. However, for a fictional character to be eligible for protection as a designation, the character itself must constitute a 'work' under trademark law. To this end, it must be regarded as an independent intangible result of creative labour and be perceived by the public as distinct from the underlying work. A certain degree of independence and distinct recognition of the character in relation to the underlying work is therefore required. Indications of this may include the character's distinctive visual design or particularly pronounced character traits, abilities or typical behaviours that individualise the character and its personality within the novel, stage play or film.

The Federal Court of Justice (BGH) found that these conditions were not met in the case of the character 'Moneypenny'. According to the findings of the lower courts, the character lacks sufficient individualisation. She exhibits neither a clearly recognisable visual design nor particularly distinctive character traits that set her apart from the work as a whole as an independent character. Rather, she is perceived by the public solely in connection with the James Bond film series. As a general rule, the eligibility of a fictional character for copyright protection implies that it qualifies as a work title. Referring to the judgement *Pippi Langstrumpf Kostüm I* (BGH GRUR 2014, 178), the Federal Court of Justice applies a strict standard and does not consider the mere description of a character's physical appearance or demeanour to be sufficient in itself. The fictional character of 'Mrs Moneypenny' is not eligible for copyright protection simply because there is no specific visual design for this character. By contrast, the combination of distinctive character traits and specific physical characteristics is decisive for obtaining protection under Section 5(3) of the German Trade Mark Act (MarkenG). The mere embodiment of the 'perfect secretary and the epitome of professionalism' is not sufficient. Even from the surveys submitted, it can only be inferred that 'Mrs Moneypenny' is associated with the James Bond films as a reference to, but not that it is independent of those films.

In the absence of sufficient originality on the part of the character, there is therefore no protection under copyright law for the designation 'Moneypenny'.

ASSESSMENT

This decision of the Federal Court of Justice (BGH) addresses the relationship between protection of a work's title and copyright protection of fictional characters. The BGH, however, proceeds on the basis of an 'independent concept of a work under trademark law' (para. 18, established case law), which 'encompasses all intangible results of work which … are capable of being designated according to common understanding' (para. 18), and thus, in principle, also includes fictional characters as parts of a work (paras. 24, 22). The public must perceive them as independent of the work in which they are contained. This requires a high degree of individualisation through a distinctive visual design combined with pronounced character traits and typical behaviours (para. 27). The Federal Court of Justice (BGH) rightly rejects the claim that the character Moneypenny possesses this necessary independence: the prototype of a perfect secretary is the antithesis of sufficient individualisation (para. 32). Consequently, the character 'Moneypenny' is not perceived as independent in legal transactions, but only as part of the James Bond films (para. 35). Attempts to give concrete form to the character and commercialise it outside the films do not alter this (paras. 36–40). (Böhm)

5. Federal Court of Justice on trademark applications made in bad faith: "Testa Rossa"

Federal Court of Justice, order of 11 September 2025, I ZB 6/25 – Testarossa

BACKGROUND

The "Testarossa" trademark has been the subject of legal disputes for years between Ferrari and a German entrepreneur in the toy and model car industry – even though the last new Testarossa car rolled off the production line over three decades ago. The dispute has already involved the European Court of Justice (ECJ), which clarified in a much discussed decision that the sale of used cars and spare parts can also constitute genuine use for the purposes of maintaining rights (ECJ, judgment of 22 October 2020 – C-720/18 and C-721/18).

In essence, the case concerns the following: Ferrari used the designation 'Testarossa' as early as the 1950s for a racing car and produced the legendary production models 'Testarossa', '512 TR' and 'F 512 M' from 1984 to 1996 – a total of over 7,000 vehicles. The trademark applicant is an entrepreneur who has been active in the toy and model car industry for around 50 years and has long been involved in disputes with car manufacturers over licensing claims regarding the reproduction of manufacturers' trademarks on model toys.

At the end of 2013, this entrepreneur applied for the German word mark "Testa Rossa" (registration number 302013070212) for a wide range of goods, including, amongst other things, drills, kitchen appliances, bicycles, model vehicles and toys (classes 7, 8, 12, 18, 21 and 28). In addition, he had seven further "Testa Rossa" trademarks registered with the DPMA and EUIPO. Ferrari applied for cancellation on the grounds of bad-faith registration. Both the DPMA and the Federal Patent Court (BPatG) rejected the application. Ferrari subsequently filed an appeal with the German Federal Court of Justice (BGH).

DECISION

The BGH dismissed the appeal. The contested trademark was not to be declared invalid on the grounds of bad faith.

The decision first refers to the three categories of bad faith established by case law (para. 31):

- Interference with a prior user's legitimate rights
- Misuse of the blocking effect as a means of competitive struggle
- Speculative trademark (hoarding of trademarks without a serious intention to use them)

The Federal Patent Court examined all three categories and found none to apply – nor did it find bad faith in the context of the final overall assessment. The Federal Court of Justice (BGH) emphasises that these categories are not exhaustive and that the outcome always depends on an overall assessment of all circumstances (para. 31, with reference to BGH GRUR 2016, 380 – *GLÜCKSPILZ* and BGHZ 207, 71 – *Goldbären*).

The Federal Court of Justice then clarifies, with reference to the relevant ECJ case law, that a trademark application made in bad faith always presupposes an intention to harm or hinder the interests of third parties. However, "a mere reference to a specific third party" is not required. The application for a trademark "with the intention of not using the sign in accordance with its function already, by its very nature, infringes the interests of third parties". In addition to the 'classic' functions of a mark, indicating origin and distinguishing goods or services, this also includes other functions, such as guaranteeing the quality of those goods or services, and the communicative, investment or advertising functions (ECJ, judgment of 18 June 2009 – C-487/07, ECR 2009, I-5185 – *L'Oréal u. a.*).

However, such bad faith can only be established if there are "conclusive and consistent objective indications of dishonest intent on the part of the applicant for the trademark in question at the time of its application". The burden of proof or of establishing this lies with the applicant in the invalidity proceedings (in this case, Ferrari). The dogmatic starting point is the presumption of good faith on the part of the trademark applicant, which remains in force until proven otherwise. However, as soon as the applicant presents circumstances capable of undermining the presumption of good faith, it is incumbent upon the trademark owner to provide plausible explanations regarding the objectives and economic rationale of their application.

The absence of concrete plans for the use of the trademark at the time of application is consistent with the system of the five-year grace period for use. A mark, even if licensed, is used in accordance with its primary function, namely the origin function. Ferrari's attempt to transfer the distribution of the burden of proof applicable to the demonstration of use for the purpose of maintaining rights to the bad faith assessment failed.

In the view of the Federal Court of Justice, the mere existence of earlier trademark rights – including those enjoying extensive protection on the basis of reputation – which Ferrari had invoked (referring to the General Court's *SIMCA* judgment, T-327/12), is not sufficient to establish bad faith. Whilst the application for a sign that bears a high degree of similarity to a well-known trademark may be an indication of bad faith, further circumstances must be present.

ASSESSMENT

The interplay of the presumption of good faith, the burden of proof on the applicant and a generous five-year grace period for use makes it difficult for proprietors of well-known trademarks to take action against deliberate imitations by way of invalidity proceedings.

The decision of the Federal Court of Justice is difficult to reconcile with the SIMCA judgment of the European General Court (EGC). The Federal Court of Justice itself questions this decision and justifies its scepticism on the grounds that the SIMCA doctrine contradicts the principle that trademarks only enjoy protection as long as they are used in a manner that preserves their rights (para. 81). However, the criticism does not sufficiently distinguish between relative grounds for refusal (compulsory use) and the absolute ground for refusal of bad faith, which has a different scope of protection.

The Federal Court of Justice's decision appears problematic, in particular, where it is applied to cases of blatant trademark piracy. The decision raises the question of whether the high standards required to prove bad faith are still appropriate in cases of obvious free-riding on another's trademark. (Venohr)

6. Relevant criteria for assessing whether the applicant acted in bad faith at the time of filing

European Court of Justice, judgment of 19 June 2025, C-17/24 – CeramTec

BACKGROUND

CeramTec GmbH (CeramTec), a German company specializing in technical ceramic components, filed three EU trademarks on 23 August 2011, including, in particular, a colour mark for the pink colouring of ceramic components used, inter alia, in medical implants such as hip or knee joints. This colouring was achieved by adding chromium oxide to the ceramic material. CeramTec had previously held a European patent for a corresponding ceramic composite material, which, however, expired on 5 August 2011.

After CeramTec brought an action in 2013 against Coorstek Bioceramics LLC (Coorstek) for trademark infringement and unfair competition on the grounds of imitation of the pink colour characteristic of CeramTec's products, Coorstek filed a counterclaim seeking a declaration of invalidity of the relevant EU trademarks. The Court of Appeal in Paris, which heard the case, ruled that the trademarks were invalid. It based its decision on the finding that CeramTec had filed the trademarks in bad faith, since the pink colour resulted on the technical effect of the added chromium oxide and CeramTec's primary intention in seeking trademark protection was to preserve its monopoly on this technical solution after the patent had expired and to exclude competitors from market access.

CeramTec lodged an appeal in cassation against this decision. The referring court stayed the proceedings and referred several questions to the ECJ concerning the interpretation of Regulation No 207/2009 on the EU trademark, in particular regarding the relationship between the absolute ground for refusal for technically determined shapes or features (Art. 7 (1)(e)(ii) of the EUTMR) and the ground for invalidity relating to a trademark application filed in bad faith (Article 52(1)(b) of the EUTMR). The main issue was the criteria to be applied in assessing the applicant's bad faith and to what extent circumstances arising after the trademark application was filed may also be taken into account.

DECISION

The Court of Justice first clarified that the absolute grounds for refusal under Article 7 of the EUTMR and the ground for invalidity based on bad faith in the trademark application under Article 52(1)(b) of the EUTMR are applicable independently of one another. A trademark may therefore be declared invalid on the grounds of bad faith even if it cannot be established that the sign falls under the technical ground for refusal under Article 7(1)(e)(ii) of the EUTMR. What is decisive, rather, is whether the trademark application was made with the intention of permanently monopolizing a technical solution and thereby circumventing the time limit on patent protection. The applicant's intention at the time of filing is decisive in this regard.

The bad faith of a trademark applicant must be assessed as part of an overall assessment of all relevant circumstances. The factors to be taken into account here include, in particular, the nature of the trademark applied for, the origin and prior use of the sign, the scope of the pre-existing patent protection, the economic rationale behind the trademark application, and the chronological sequence of events surrounding the application.

The Court further stated that, in order to establish bad faith, it is not necessary to prove that the sign applied for actually consists exclusively of a shape or a feature that is necessary to achieve a technical effect. Rather, the decisive factor is whether the circumstances indicate that the applicant filed the trademark application primarily in order to secure a continuing exclusive right and thus a monopoly on a technical solution.

The Court of Justice finally clarified that, as a general rule, the assessment of bad faith must be based on the date of the trademark application. Admittedly, circumstances arising at a later date may also be taken into account as evidence, provided that they allow conclusions to be drawn as to the applicant's intention at that time. By contrast, circumstances of which the applicant only became aware after the application was filed must not be taken into account, as they could not have influenced his intention at that time.

ASSESSMENT

Article 52(1)(b) of the EUTMR provides that an EU trademark may be declared invalid if the applicant acted in bad faith at the time of filing. The provision serves in particular to prevent abusive trademark applications intended to secure protection that is not, by its very nature, entitled under trademark law.

Against this background, the decision makes clear that trademark law must not be used to effectively extend the time-limited protection of technical inventions. It is true that the ground for refusal of registration for technically determined shapes under Article 7(1)(e)(ii) of the EUTMR is primarily intended to exclude technical solutions from trademark protection. However, the Court clarifies that, even independently of this, a trademark application may be regarded as made in bad faith if it is recognizably aimed at continuing to monopolize the economic effect of an expired patent.

The decision thus reinforces the functional separation between patent and trademark law. Whilst technical solutions are intended to be protected by patents only for a limited period, trademark law must not serve to indirectly perpetuate this protection. In practice, this means that, in particular, trademark applications filed in the immediate period following the expiry of a patent may be subject to a more rigorous examination if the sign applied for is closely linked to the previously patented technical solution. In similar cases, it can (and should) now be argued that the overall circumstances may well suggest the applicant's intention to abusively extend patent protection that is expiring or has already expired.

In the present case in particular, such a scenario was plausible, as the trademark application was filed shortly after the patent expired and related to a feature that had previously been used in connection with the patented solution. Whether this is in fact to be regarded as an application made in bad faith must, however, ultimately be assessed by the national court within the framework of the assessment criteria laid down by the Court of Justice as part of the necessary overall assessment. (Holderied)

II. DESIGN LAW

7. The distinctiveness of Community designs in the context of pre-existing design elements and fashion trends

European Court of Justice, judgment of 18 December 2025, C-323/24 – Deity Shoes

BACKGROUND

The Court of Justice of the European Union (CJEU) was called upon to interpret Regulation (EC) No 6/2002 on Community designs in the context of a request for a preliminary ruling. The central issue was the question of the conditions under which a design based on existing models or composed of pre-existing elements satisfies the requirements of novelty and individual character.

The claimant, Deity Shoes, brought claims before a Spanish court based on registered and unregistered Community designs for various shoe models. These are based on catalogues from Chinese trading companies, which allow individual design elements – such as colour, material or decorative details – to be combined according to predefined options and adapted to customer requirements.

The defendants contested the protectability of the designs and brought a counterclaim for a declaration of invalidity on the grounds of lack of novelty and individual character. They argued that the designs at issue were based on 'no innovation whatsoever', as Deity Shoes merely marketed products offered by Chinese trading companies.

The referring court asked, in particular, the following questions:

- Is genuine creative activity required for design protection, i.e. must the design be the result of an intellectual effort on the part of its designer?
- Can mere adaptations of existing models constitute individual character?
- Is it relevant that the components used are already taken from catalogues?
- To what extent do fashion trends influence design freedom and the assessment of the overall impression?

DECISION

The decision can be summarised as follows:

1. No requirement for a minimum level of design

The ECJ concluded that the holder or designer of a Community design need not prove, beyond the requirements of novelty and individual character, that the design is the result of a minimum level of creativity.

In doing so, the ECJ took into account that restrictions on design freedom – such as those arising from technical or legal requirements – are relevant only in the context of assessing the overall impression, but do not constitute an independent condition for protection.

In the ECJ's view, no requirement for a specific creative achievement can be inferred from the concept of the 'designer' either. Rather, this serves exclusively to determine the right holder.

Referring to the Advocate General's opinion, the ECJ also emphasises the distinction from copyright: "Whilst the concept of a 'work' presupposes that it is an original creation reflecting the personality of its author by expressing his free creative decisions, the protection of designs covers objects which, although new and individualised, are intended for use and mass production".

Consequently, the assessment is based on an objective comparison with the existing repertoire of designs, whereby the overall impression on the informed user is the sole determining factor.

2. Combination of pre-existing elements

The ECJ further states that distinctiveness does not arise from the relationships between individual design elements, but from a comparison with existing designs as a whole.

In this regard, the ECJ clarified that a design may still be eligible for protection even if it is composed of pre-existing elements or existing models. The sole decisive factor is whether the resulting design produces a different overall impression on the informed user.

Consequently, the fact that the designs at issue exhibit features based on models set out in suppliers' catalogues does not preclude recognition of their individual character. The same applies where the modifications made by the designer are merely selective and limited to components offered by the supplier.

Such circumstances do not preclude the assumption of individual character, provided that the overall impression differs from the existing repertoire of designs.

3. Role of fashion trends

Referring to the Advocate General's Opinion, the ECJ held that features influenced by fashion trends differ from those determined by technical functions or legal requirements. The latter are generally unavoidable and permanent, whereas fashion trends are, by their very nature, changeable and innovation-driven.

Furthermore, fashion trends cannot be regarded as inevitable in the sense that they necessarily predetermine the features of a product and that a designer does not have the freedom to innovate in order to override them.

The ECJ notes that the fact that the differences between the contested and the earlier designs are based on fashion trends does not, in principle, diminish the attention of the informed user. Rather, given their knowledge in the relevant field, a higher level of attention must be assumed.

Admittedly, the ubiquity of certain design elements – for example, as a result of trends adopted on a massive scale or identical designs by numerous suppliers – may influence aesthetic perception and commercial success. However, this is irrelevant for the assessment of distinctiveness.

The sole decisive factor is whether the overall impression differs from the existing repertoire of designs.

It follows that even features based on fashion trends are no less significant for the overall impression.

ASSESSMENT

The ruling thus makes it clear that design protection in the EU is deliberately designed to be accessible and is based not on creative achievement but on the perception of the informed user.

Of particular practical relevance is the Court's clarification that, in practice, design development is often based on the combination and further development of existing design elements. This does not limit design protection.

At the same time, the judgment has implications for the assessment of markets that are heavily influenced by trends. The fact that widely used design elements do not lose their significance prevents a simplistic argument that certain features should be disregarded solely because of their prevalence. This shifts the focus more strongly towards the specific perception of the informed user.

In practice, this leads to a more nuanced assessment: neither the degree of creative achievement nor the origin of individual elements is decisive, but rather their interaction in the specific overall appearance. This raises the bar for the argumentation, particularly when setting out differences in the overall impression.

Overall, the decision reinforces the significance of design law as an independent protection regime and adapts its application to the reality of modern, highly standardised and trend-driven markets. At the same time, this increases the risk of disputes, as even minor differences must be examined in detail in individual cases to determine whether they actually alter the overall impression. (Sopova)

III. COPYRIGHT LAW

8. Copyright protection for works of applied art

European Court of Justice, judgment of 4 December 2025, C-580/23 and C-795/23 – Mio v konektra

BACKGROUND

A topic that has been the subject of repeated and, more recently, increasingly heated debate for decades is the question of copyright protection for so-called works of applied art, i.e. the design of everyday objects that are often sold in large quantities, such as furniture, lighting, electrical appliances, clothing, shoes, etc. The tension arises primarily from the question of the relationship to design protection (now referred to as 'design protection' in German national law). Design protection is explicitly created to protect the 'appearance of products' (Art. 3(1)(a) of the Community Design Regulation), which in turn are defined as 'any industrial or handicraft product' (Art. 3(1)(a) of the Community Design Regulation), and is thus clearly aimed specifically at works of applied art – but has a maximum term of 25 years. Works protected by copyright, by contrast, enjoy this protection for a significantly longer period, namely for a term of 70 years from the death of the author.

Unlike design law, copyright law is also not harmonised at EU level by a separate directive or similar instrument that comprehensively regulates copyright issues. In this respect, case law in the individual countries has, so to speak, traditionally shown sometimes significant differences in how 'generous' or 'strict' it is when granting copyright protection to works of applied art. However, for some time now, copyright works have been mentioned in EU legislative acts, in particular in the so-called InfoSoc Directive (Directive 2001/29/EC on the harmonisation of certain aspects of copyright and related rights in the information society). On this basis, the ECJ has held that there is now an EU-wide harmonised definition of a work as a prerequisite for copyright protection (see, in particular, ECJ, judgment of 12 September 2019, *Cofemel*, C-683/17, para. 50). However, given that the courts of the Member States can only refer abstract questions of law or interpretation to the ECJ in this regard, the ECJ can only provide abstract answers and set out legal guidelines, but cannot rule on the specific individual case. In this regard, the ECJ has already emphasised on several occasions that a prerequisite for protection as a copyright work is that the design of the object in question is an expression of decisions reflecting the author's personality (see, for example, ECJ, judgment of 29 July 2019, *Pelham u. a.*, C-476/17, para. 39). However, the question of when this is the case in individual instances has continued to be handled very differently in the case law of the individual Member States.

Two national decisions from 2025 illustrate this: Thus, in line with the traditionally rather 'strict' approach of German case law regarding copyright protection for works of applied art, the Federal Court of Justice (BGH) had denied copyright protection for the design of Birkenstock sandals (BGH, judgment of 20 February 2025, I ZR 16/24; I ZR 17/24; I ZR 18/24). In this regard, the BGH delivered its judgment without seeing any need to refer the matter to the ECJ, as the BGH considers its line of case law to be in accordance with the ECJ's guidelines. Shortly afterwards, without prejudice to and in full knowledge of the BGH's decision, the Midden-Nederland District Court (Utrecht, Netherlands) ruled exactly the opposite, namely that the design of Birkenstock sandals is indeed protected by copyright (judgment of 12 November 2025, C/16/577582 / HA ZA 24-336). In doing so, this District Court follows the so-called 'traditional' line in Dutch case law of affirming copyright protection quite 'generously' even for works of applied art (although such works are then often granted only a narrow scope of protection). The District Court likewise saw no need to refer the matter to the ECJ, as it considered its decision to be (also) covered by the ECJ's guidelines.

There has therefore been, and continues to be, a significant discrepancy among the individual Member States regarding the question of when works of applied art enjoy copyright protection. In this respect, the ECJ's judgment in the Mio v konektra case was eagerly awaited.

DECISION

Put simply, the Mio / konektra case essentially concerns whether tables by Mio and sideboards/cabinets by USM Haller are protected by copyright. In this regard, a Swedish Court of Appeal and the German Federal Court of Justice (BGH) had referred a number of legal questions to the European Court of Justice (ECJ) for a ruling. The ECJ addressed these questions in its judgment of 4 December 2025. However, due to the nature of the referral system – which only permits the answering of rather abstract legal questions – it did not rule on the individual cases in question. The ECJ therefore made no statements as to whether, in its view, the furniture by Mio and USM Haller enjoys copyright protection.

Instead, it made only abstract statements to the effect that, for copyright protection to apply, the designs must be expressions of decisions that reflect the author's personality – in line with what the ECJ had already established in previous rulings. In this regard, the ECJ ruled as follows:

'A work [within the meaning of copyright law] is an object that reflects the personality of its author by expressing his or her free and creative decisions. Decisions which are not free and creative include both those dictated by various constraints, in particular technical ones, which bound the author in the creation of the object, and decisions which, although free, do not constitute an expression of the author's personality in that they do not confer a unique character on that object. Circumstances such as the author's intentions during the creative process, their sources of inspiration and the use of existing formal elements, the likelihood of an independent similar creation, or the recognition of the work within professional circles are, as such, neither necessary nor decisive for assessing the originality of the work for which protection is sought."

What is new compared to previous case law is the approach that, for copyright protection to be granted, the relevant creative decisions must 'endow the object with a unique aspect'. The ECJ further emphasises the criterion of uniqueness in paragraph 55 of the judgment:

"[…], since an author is required to create a unique work imbued with his personality, […]"

ASSESSMENT

Immediately following the publication of Mio v konektra, a battle for "interpretative supremacy" over the decision began in the relevant forums. Commentators who are "in favour of copyright protection" even see the judgment in some cases as a "revolution" that renders the Federal Court of Justice's (BGH) previous line of reasoning obsolete. Less "copyright-friendly" commentators, on the other hand, see the BGH's rather "strict" line of reasoning confirmed.

My assessment in this regard is therefore also that the national courts will each see their traditional lines of case law confirmed. For example, the Dutch courts in their rather 'generous' case law, and the German courts in their rather 'strict' case law. Genuine harmonisation is therefore likely to require action by the European legislator (if such harmonisation is indeed considered desirable). In the meantime, manufacturers of original products, for example, can take advantage of the differing approaches in the respective national case law and, for instance, take action against counterfeiters in the Netherlands on the basis of copyright law, whilst simultaneously pursuing a case in Germany for design infringement (as in this respect, it is significantly quicker and easier to obtain a preliminary injunction in Germany compared to the Netherlands) (Eberhardt)

IV. PROCEDURAL LAW

9. Publication of judgments – Can we get more out of this?

BACKGROUND

The right to have a judgment published is an often underestimated option for the prevailing party, as it can be very unpleasant for the losing party. For example, customers may become aware of a trademark infringement that would otherwise not have come to public attention. To date, publications in Germany have tended to be rather restrained. The ubiquity of the internet and social media could change this. It is therefore important to understand the purpose of this right following a conviction, to weigh up the respective interests, and to draw appropriate conclusions as to the nature and extent to which the publication of a judgment may be justified. It is interesting to look to neighbouring Austria, which has pursued a number of new approaches in recent years.

LEGAL FRAMEWORK

The relevant provision is almost identical for all industrial property rights (Section 12(2) UWG, Section 19c MarkenG, Section 103 UrhG, Section 140e PatG). The judgment may grant the prevailing party the authority to publish the judgment at the losing party's expense within three months of it becoming final, provided the prevailing party demonstrates a legitimate interest. The nature and scope of the publication are determined in the judgment.

According to established case law, a legitimate interest exists if the publication is objectively suitable and necessary to remedy a continuing disturbance. As mentioned at the outset, the publication may also result in significant disadvantages for the losing party. It is therefore necessary to carefully weigh up the interests of both parties. The following criteria must be taken into account:

- the nature, duration and extent of the infringement
- the degree of fault
- the time that has elapsed in the meantime
- the public's interest in information
- the consequences of publication for the losing party
- the extent of the disruption that is currently still ongoing

Germany

1. In the 2021 judgement ***Vorsicht Falle*** (I ZR 167/20), the issue to be decided was whether Company A was permitted to publish a judgement on its own website five years after it had become final, naming Party B – the losing party at the time – in full. The substance of the case concerned unfair statements made by Party B in the course of acquiring advertising clients. The Federal Court of Justice ruled that, despite the considerable lapse of time, publication was permissible due to the continuing public interest in the information. The naming of the party was also deemed necessary. This would deter the then defendant B from committing further infringements. Potential customers would be informed and could report infringements to company A, which could then enforce the judgment. The continuing public interest and the associated deterrent effect outweighed the interest of the then defendant B in protecting its commercial reputation. This impairment of economic standing was to be accepted following a comprehensive overall assessment. This conclusion is not precluded by the fact that Company A also pursues its

own economic interests through the publication. Nor is there a fixed time limit. The public's interest in information would only cease to apply once Party B is no longer active in the relevant business sector.

The judgment highlights the distinction between statements made under competition law on the one hand and statements concerning personal rights on the other. In the case of statements made under competition law, the public interest – which must be taken into account within the framework of the 'triad of rights' under the Unfair Competition Act (UWG) – may be decisive. Statements concerning personal rights under general tort law, by contrast, focus exclusively on the respective interests of the parties.

1. The Munich Regional Court (7 O 10571/20) drew on similar considerations in a case of patent infringement involving dental products. Due to the health-related nature of the case, there was a particular set of interests at stake that went beyond mere party interests. Because the products were used directly on patients, the interests of doctors and patients also had to be taken into account. Those affected needed to be certain that the products complied with legal requirements and that the availability of spare parts was guaranteed. A patent infringement in the field of medical treatment carries greater weight than in other areas, such as, for example, consumer electronics. The court granted a one-off publication of the judgment in two specialist dental journals. Patients then gained knowledge indirectly through consultations with their doctors. A three-time publication, however, was rejected as disproportionate.

2. Generally speaking, the parties in Germany tend to be cautious regarding the procedures for applications to publish judgments. In the case mentioned, it would have been interesting if the claimant had also applied for publication in a journal aimed at patients (e.g. 'Apotheken-Rundschau'), arguing that this was the only way to reach those directly affected.

Austria

1. A look at Austria shows that the publication of judgments has been a central issue in a number of important decisions there. The provision of the local Section 25 UWG requires – as in Germany – a legitimate interest. Under paragraph 7, the media operator who is required to publish the judgment in accordance with the decision is then under an obligation to comply. However, there is no legal definition of a media operator.

   Traditionally, media enterprises are publishers of newspapers and specialist journals. In recent years, however, Austrian courts have moved beyond this narrow understanding and have applied the so-called principle of retaliation. The talion principle describes the principle that the publication of the judgment must take place in the same form and presentation as the infringing act that was prosecuted. Put simply: the publication must take place in those media in which the defendant engaged in unfair advertising or where the infringement of intellectual property rights was committed.

2. Applying this broad interpretation, the Supreme Court ruled as early as 2002 (E4 Ob 174/02w – *Boss Zigaretten*) that publication must take place on the website where the unfair statements were made. The media operator within the meaning of the statutory provision may therefore be the operator of the website on which the infringement took place. The Higher Regional Court of Innsbruck confirmed this in 2005, even where the website had since been transferred and the owner was no longer the person who had made the unfair statements. The decisive factor is not who the domain owner is, but that the medium of publication corresponds to that of the infringement.

3. In 2010, the Vienna Commercial Court ruled for the first time in two judgements that the losing party

could be required to publish the judgement on their YouTube channel or on Facebook. The case arose from a dispute between two hairdressers. A former employee had opened his own hairdressing salon and published a promotional video on YouTube tagged with the name of his former employer. This constituted a trademark infringement. The judgment had to be displayed as a scrolling video on the YouTube channel for 30 days and read aloud. In addition, the judgment had to be included in the video description. Shortly afterwards, the former employee was convicted again. This time for a breach of competition law. He had published photos on his Facebook page that disparaged his former employer across the board. On this occasion, the Vienna Commercial Court ruled that a new photo album entitled 'Publication of the Judgment' must be created on the Facebook page. A scan of the judgment had to be displayed as an image for 30 days; the wording of the judgment had to be reproduced in the description.

In justifying the terms of the judgment publication, the Vienna Commercial Court referred to the principle of retaliation mentioned at the outset. The publication of the judgment must reach the same people who were aware of the infringement. In the case of infringements on the internet, this cannot be achieved by publication in a printed daily newspaper. The precise manner of publication was decisive for its effectiveness. For example, all fans of the Facebook page would have seen the publication of the judgment in their news feed. What was new about these decisions was that Facebook and YouTube were treated as if they were websites belonging to the convicted party.

4. Consequently, the publication of the judgment must be ordered to such an extent that the relevant public, against whom the infringement has taken effect, is informed of the breach of the law. The nature and scope of the medium in which the publication is to take place should generally correspond to that of the infringing act, but should not exceed it. A good overview of current practice is provided by Dr Meinhard Ciresa's 'Handbuch der Urteilsveröffentlichung' (Handbook on the Publication of Judgments), currently in its 4th edition, 2017.

Unified Patent Court

A broader understanding of 'legitimate interest' in the light of the principle of retribution is also evident in the first decisions of the local chambers of the Unified Patent Court (UPC). For example, the German Local Chamber in Düsseldorf (UPC_CFI_373/2023, decision of 31 October 2024; *SodaStream v. Aarke*) the application under Article 80 UPC for publication of the judgment, stating that publication involved an element of punishment and should only be granted if the claimant's protection was not effectively and sufficiently ensured by the other measures ordered. In the specific case, it was not apparent that the patent infringement had led to uncertainty amongst the small and highly specialised customer base for high-priced carbonators that would justify publication. The balancing of interests therefore focused on possible negative consequences for the defendant. In a decision by the Austrian Vienna Local Chamber (UPC_CFI_33/2024, decision of 15 January 2025), the above decision is first cited. Subsequently, however, the Vienna Local Chamber emphasises that the balancing of interests must take into account not only the punitive element, but also the purpose of deterring future infringers and raising public awareness. There would therefore also be a preventive interest extending beyond the specific case of infringement. In the specific case, nothing had been submitted on this point, but the supplementary remarks of the Vienna Local Chamber underline the desire for a more precise balancing of interests without a one-sided focus in favour of the losing party. It will be interesting to follow the case law and any convergence of views among the Local Chambers.

RECOMMENDATION

The decisions outlined should encourage greater creativity in applications for the publication of judgments:

1. Firstly, with regard to the 'whether'. Thus, aspects from the Munich Regional Court's judgment concerning a patent infringement in the field of medical treatment may potentially be applied to other product areas and intellectual property rights. If patients' interests must be taken into account because they are directly affected, this could also apply to products that have a particular impact on the environment and climate. In a ruling on advertising claiming climate neutrality (Federal Court of Justice, judgment of 27 June 2024, I ZR 98/23 – *klimaneutral*), the Federal Court of Justice reiterated that consumer interests have changed and that sustainability criteria have gained in importance in recent years. Misconceptions held by potential customers regarding the environment and climate carry particular weight. In the case of misleading statements and also in the event of an infringement of intellectual property rights that particularly affects this area, the public interest could then be decisive in granting a right to the publication of the judgment. This could even apply in the field of consumer electronics. There, too, public interests – particularly the sustainability of products – are becoming increasingly important. For instance, the Repair Regulation (EU Regulation 2024/1799) aims to extend the useful life of consumer goods and provide consumers with a high degree of transparency. Consequently, the public interests of consumers could, in principle, gain greater significance in the balancing of interests.

2. Secondly, with regard to the method. The principle of talion, which is central in Austria, rightly emphasises that the publication of a judgement is only effective if it can reach the same people who previously witnessed the infringing act. The nature and scope of the medium should therefore correspond. In the age of the internet and social media, new approaches – in particular publication on the losing party's website – appear to be called for in specific cases. A particularly harsh measure, and one conceivable only in extreme cases, would be publication on the homepage before the normal content appears. (Ehlers)

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