

# Recent Case Law in German Trademark Law



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## CONTENT

Foreword .....	2
I. Infringement proceedings	
1. A liable party subject to an injunction order is under no obligation to delete subsequent entries .....	3
<i>European Court of Justice, judgment of 02.07.2020, C-684/19 – mk advokaten/MBK Rechtsanwälte</i>	
2. No infringement of rights by storing infringing goods.....	6
<i>European Court of Justice, judgment of 02.04.2020, C-567/18 – Coty/Amazon</i>	
3. Cross-supplies within a selective distribution system .....	8
<i>Federal Court of Justice, judgment of 15.10.2020, I ZR 147/18 – Querlieferungen</i>	
4. Use of the ‘schufa-anwalt.de’ domain for legal services infringes rights to the SCHUFA trademark.....	10
<i>Munich I District Court, judgment of 25.06.2020, 17 HK O 3700/20</i>	
II. Eligibility for protection / cancellation proceedings / opposition proceedings	
5. Taking probable types of use into consideration when assessing the distinctiveness of a mark .....	12
<i>Federal Court of Justice, court order of 30.01.2020, I ZB 61/17 – #darferdas? II</i>	
6. Protectability of chocolate packaging .....	14
<i>Federal Court of Justice, court order of 23.07.2020, I ZB 42/19 – Quadratische Tafelschokoladenverpackung II</i>	
7. Bad faith constituted by applying for a trademark without any intention of using it .....	16
<i>European Court of Justice, judgment of 29.01.2020, C-371/18 – Sky ./.. SkyKick</i>	
8. An ‘X’ at the end makes no difference yet – The concept of genuine use in opposition proceedings, and assessing the similarity of signs involving highly descriptive elements.....	18
<i>Federal Court of Justice, judgment of 06.02.2020, I ZB 21/19 – INJEKT/INJEX</i>	
9. Descriptive name for ice cream to be kept available for general use (Plombir) .....	21
<i>Federal Patent Court, court order of 04.03.2020, 28 W (pat) 27/13</i>	

## FOREWORD

This issue of our 'Recent Case Law in German Trademark Law' is the fifth review, compiled by the attorneys in the Trademark Practice Group at EISENFÜHR SPEISER, of current court decisions relevant for practitioners in the field. The Trademark Practice Group pools the firm's competencies in the field of trademark law from and for the various offices and discusses new developments in case law and practice on a regular basis. Collectively, the Practice Group can draw on experience amassed over the past 50 years. Our clients benefit accordingly.

For the 2020 Case Law Review, we have compiled and prepared a total of nine current decisions with practical relevance. A personal assessment by the respective author is provided for each decision.

The decisions relate not only to judicial (infringement) cases, but also to cancellation proceedings and cases concerning the eligibility of trademarks. Among other issues, the courts had to deal again last year with the scope

of the claim to injunctive relief under trademark law, the liability of the various players in Internet trade, and the infringement of trademark rights by details provided on domains. The ECJ has also expressed its opinion on trademark applications made in bad faith, due to the lack of any intention to use them. With regard to eligibility for trademark protection, an issue in 2020 was the inclusion of probable forms of use when assessing the eligibility of a sign for protection, and the eligibility for protection of a well-known square packaging for chocolate. Other topics discussed include the concept of genuine use in opposition proceedings, and the need to keep a trademark free for competing undertakings when descriptive indications are involved.

We wish you an interesting read. If you have any questions or comments about individual decisions, please do not hesitate to contact us.

April 2021

**EISENFÜHR SPEISER**

# I. INFRINGEMENT PROCEEDINGS

## 1. A liable party subject to an injunction order is under no obligation to delete subsequent entries

*European Court of Justice, judgment of 02.07.2020, C-684/19 – mk advokaten/MBK Rechtsanwälte*

### BACKGROUND

In a number of recent decisions in the field of unfair competition and trademark law, the Federal Court of Justice has extended and specified in more detail the obligations of a party subject to a cease-and-desist order. In addition to merely refraining from (further) infringing acts, the party that must cease and desist also has obligations to take active steps to remedy the adverse impacts on the party obtaining the order. According to the aforementioned case law, the development of which we have reported on several times already here (see 'Recent Case Law in German Trademark Law, 2016', pp. 5 f. and 2018 pp. 8 f.), the obligations ensuing from the cease-

and-desist order may extend to an obligation to recall goods from the channels of distribution.

The present decision relates to a dispute between two law firms about advertising of legal services in breach of trademark law. In contrast to the case law mentioned above, it was not about recalling goods from the channels of distribution, but about removing advertisements on the Internet. However, the question raised here as well is the extent to which a liable party subject to an injunction has an obligation to take active steps to remove infringing content beyond its immediate area of control.

### DECISION

The party that obtained the injunction, a law firm in Mönchengladbach, is the proprietor of a German trademark, 'MBK Rechtsanwälte', which is registered for legal services, inter alia. The party ordered to cease and desist, likewise a law firm domiciled in Kleve, initially provided its services under the name 'mbk Rechtsanwälte' and its Dutch equivalent, 'mbk advokaten'. Following an application for injunction, the District Court in Düsseldorf ordered the respondent to refrain, in the course of trade, from using the name 'mbk' for legal services. This judgment has become final.

The respondent had registered an entry under said name in the online telephone directory called 'Das Örtliche'. After the judgment was handed down by the District Court in Düsseldorf, the respondent arranged for the entry to be deleted. However, the applicant for injunction subsequently discovered that a Google search using the term 'mbk Rechtsanwälte' still pointed to websites containing directory entries for the respondent. Following a request by the

applicant for injunction, the Düsseldorf District Court then imposed a fine on the respondent.

The District Court ruled that the liable party was obligated not only to delete the initial entry it had commissioned, but also all other entries in commonly used online directories that included the 'mbk' sign, because the advertisements included on the websites in question benefitted the liable party and were attributable to the initial entry that it had directly ordered. The party subject to the injunction lodged an appeal against the District Court decision.

The Düsseldorf Upper District Court referred the matter to the ECJ for a preliminary ruling. According to the established legal practice of German courts, a liable party that infringes the trademark rights of a third party by first use on the Internet not only has an obligation to delete the first entry in question, but must also investigate, with the help of common search engines, whether third-party websites have adopted that entry, even without its consent, and if

necessary make at least a serious attempt to arrange for deletion on those websites. The reason given for that view is that these subsequent entries are a result of the unlawful first entry by the liable party and also benefit the latter economically. The infringer, therefore, must bear the risk of unsolicited assimilation of entries by other websites, and for that reason must also accept the effort and expense of deletion.

The Upper District Court expresses doubts that this is consistent with the case law of the ECJ regarding the interpretation of Article 5 (1) of the Trademark Directive in the version applying at the time (now Article 10 of the Trademark Directive), according to which subsequent entries did not qualify as trademark-infringing acts of use by the liable party. "Use" in this sense involved active conduct. Independent acts by third parties could not be attributed to the person who merely ordered the initial entry on a particular website.

The ECJ confirms the doubts expressed by the Düsseldorf Upper District Court. The headnote of its decision reads:

*'Article 5 (1) of Directive 2008/95/EC [...] must be interpreted as meaning that a person operating in the*

*course of trade that has arranged for an advertisement which infringes another person's trade mark to be placed on a website is not using a sign which is identical with that trade mark where the operators of other websites reproduce that advertisement by placing it online, on their own initiative and in their own name, on other websites.'*

In its grounds for judgment, it argued that the expression 'use' within the meaning of the Directive involves active conduct and direct or indirect control of the act constituting the use. Use in this sense had therefore been made in respect of the first entry that the liable party itself had ordered with the 'Das Örtliche' directory. By contrast, it cannot be held liable for independent actions committed by other economic operators, such as those committed by the operators of the third-party websites with whom it has no direct or indirect connection and who do not act by order and on behalf of that person, but on their own initiative and in their own name. The provision cannot be interpreted to mean that, irrespective of its conduct, a person may be regarded as the user of a sign merely because such use might result in its financial benefit.

## ASSESSMENT

The ECJ decision is to be appreciated. It limits, a little at least, the far-reaching obligations imposed on the injunction debtor by the Federal Court of Justice. In trademark disputes, the liable party is therefore under no obligation to examine the websites of independent third parties to determine whether they have adopted the first entry without its consent.

The ECJ clearly states that this does not preclude a rights owner from claiming restitution for financial benefits from such third parties on the basis of national law and does not prejudice its right to bring an action against the operators of the third-party websites. However, if financial benefits accrue to the liable party, this alone does not justify treating the autonomous actions of independent third parties as acts of use by the liable party.

According to German case law, the party subject to an injunction who had trademark-infringing content on its website and who removed it because of its obligation to cease and desist, also has an obligation to request that Google and other commonly used search engines re-index the website, so that the trademark is no longer associated with the website in search results. The ECJ decision means that said obligation should not apply anymore in a situation, at least, where inclusion in the search results was not arranged by the obligor, but solely on the initiative of Google.

It is unlikely, in contrast, that the Federal Court of Justice will take this decision as an opportunity to correct the mushrooming obligations to recall products created by recent German case law. One reason is that some of this

case law relates to national competition law, not harmonised trademark law, another is that the factual situation is not entirely identical. The case differs from the recall situation in that an infringer who has placed infringing goods on the market maintains economic relations with its customers, at least. In other words, the condition that it 'has no direct or indirect dealings' with them is not met. It is conceivable, nevertheless, that the ECJ would not also ascribe without further ado the actions of independent customers to the party subject to an injunction – should that question be referred to it eventually.

Following this decision, the Düsseldorf Upper District Court had to examine whether the liable party had caused the subsequent entries by its own conduct, or whether the operators of those websites were acting on their own initiative and in their own name. With its decision of 13 October 2020, the Upper District Court has annulled the District Court's decision and refused the request for payment of a fine. There were no signs that the defendant had directly or indirectly caused the subsequent entries. (Kirschner)

## 2. No infringement of rights by storing infringing goods

*European Court of Justice, judgment of 02.04.2020, C-567/18 – Coty/Amazon*

### BACKGROUND

If goods that infringe trademark rights are distributed, the question that arises for the proprietor of the respective trademark is how to enforce its rights most effectively. The obvious idea that springs to mind to achieve that purpose is not to approach the individual sellers of the infringing goods, but to sue the party that stores or delivers the goods.

The question of the liability of the person storing the goods, which is quite a relevant one in practice, has not been ruled upon yet by the ECJ. In the case discussed

here, the Federal Court of Justice had an opportunity to refer to the ECJ the question of whether the warehouse operator acting in good faith is the 'possessor' of the stored goods. When determining 'possession', it is important to realise that Article 9 (3)(b) EUTMR is only applicable if the conditions specified in paragraph 2 are met. The crucial factor here is that there is 'use' of the trademark. The ECJ decision concerned the question as to whether the undefined term 'use' within the meaning of Article 9 (2) EUTMR also includes the mere storage of goods.

### DECISION

The decision is based on a dispute between Coty, for whom the Davidoff trademark (among others) is protected, and Amazon. A perfume had been offered for sale under that name on the Amazon Marketplace by a third party, in infringement of the plaintiff's trademark rights. Coty then took action against Amazon FC Graben GmbH, *inter alia*, the company responsible for storing and dispatching the goods. Coty takes the view that, by storing the trademark-infringing goods without being aware of the infringement, this Amazon subsidiary was committing an infringement of trademark rights because it 'possessed' the goods.

However, the ECJ ruled that storing the trademark-infringing goods did not constitute an infringement of rights, and in that respect concurred with the Federal Court of Justice and opposed the position taken by the Advocate General.

In its decision, the ECJ emphasises with reference to its *Daimler* decision (judgment of 03.03.2016, C-179/15, paras. 39, 40, 41), that a good protected under trademark law is only deemed to be 'used' if there is active behaviour and direct or indirect control of the act constituting the use. The legal consequences stipulated in the norm,

namely termination of the infringing act, cannot be meaningfully enforced unless the respondent actually has control over the act constituting the use.

In addition, the ECJ clarified that there is 'use' of a sign identical or similar to the trademark whenever the third party uses the sign for its own commercial communication, in any case. However, referring to its *Google* and *Google France* decisions (ECJ (Grand Chamber) judgment of 23.03.2010, C-236/08 to C-238/08), the ECJ clarified that such use does not exist already if customers are allowed to use a sign which is similar or identical to the goods or the sign of the trademark proprietor.

However, there is 'use' of the sign if goods bearing a sign protected as a trademark are imported, or handed to the warehouse keeper, by an economic operator for the purpose of placing them on the market. However, this principle does not necessarily apply as well to a person who, as a warehouse owner, merely performs the service of storing goods bearing signs protected by trademark law (with reference to ECJ judgment of 16.07.2015, C-379/14 – *TOP Logistics*). Citing the *Frisdranken Industrie Winters* decision (ECJ, judgment of 15.12.2011, C-119/10), the ECJ argues that merely creating the technical prerequisites for



'using' a sign does not mean, in any case, that the sign is being 'used'. The party providing that service does not itself use the sign.

The ECJ then emphasises, with reference to the wording of Article 9 (2)(b) EUTMR ('possession for those purposes'), that storing can only be considered to constitute 'use' if the party placing the goods in storage is pursuing the aim of offering the goods or placing them on the market. If that is not the case, there is neither any 'use' of the

goods themselves, nor any 'use' of the sign as part of the party's own commercial communication.

In the case under consideration, these conditions were not met because Amazon FC Graben was neither offering for sale nor placing on the market goods bearing a sign protected under trademark law.

## ASSESSMENT

In order to determine whether a trademark has been infringed by a warehouse keeper, the question that needs to be asked as a consequence of the decision is whether placement in storage is merely the service of storing, or whether the aim pursued by the party performing the storage is to offer for sale or to place on the market, of its own accord, the goods bearing the sign protected under trademark law.

The opinion expressed by the Advocate General, who wants to focus on the entire group in order to determine whether there is any 'use', is certainly interesting. If, as the ECJ has assumed in the case under consideration, it is only the individual subsidiary that needs to be considered in order to determine whether there is any act constituting use, the establishment of subsidiaries could make it more difficult to take legal action against trademark infringements.

The ECJ judgment does not let Amazon become a 'free rider', however. On the one hand, the ECJ emphasises that it seems perfectly possible that Amazon itself also possesses particular goods for its own purposes or offers them itself. On the other hand, the ECJ leaves the question unanswered whether the operator of an online marketplace might fall within the scope of Article 14 (1) of the e-Commerce Directive (2000/31), in other words that it qualifies as a hoster that is not always responsible for the content stored for the individual users, and should that not be the case, whether the operator is to be considered an 'intermediary' within the meaning of Article 11 of Directive 2004/48 (Enforcement of Intellectual Property Rights). (Eberhardt)

### 3. Cross-supplies within a selective distribution system

*Federal Court of Justice, judgment of 15.10.2020, I ZR 147/18 – Querlieferungen*

#### BACKGROUND

This dispute between heavyweights – the Coty Group on the plaintiff side (the world's largest manufacturer of perfumes for the mass market), Amazon group companies on the defendant side – concerned the sale of perfumes under the 'Joop!' trademark. The plaintiff is the trademark proprietor's licensee. It had made test purchases from the defendant on amazon.de. Although the products received were original products, the plaintiff claimed it had delivered the actual products to Dubai. The defendant countered that it had purchased the goods from an authorised dealer of a European undertaking belonging to the plaintiff's corporate group.

Coty had installed a selective distribution system in which distributors are only allowed to sell to final consumers or

to other distributors, and only in final consumer volumes, namely a maximum of three identical products (exclusion of wholesale business). This was limited to the states of the European Economic Area (the EU member states plus Iceland, Liechtenstein and Norway – 'EEA'). A sales partner was not allowed to either sell to customers outside that territory, or to purchase from them. Furthermore, the sales partners had to reach a specific annual purchase target, with products purchased from or sold to other sales partners not being counted towards those targets.

The Munich I District Court ordered the defendant to cease and desist and to provide information, and the judgment was upheld by the Munich Upper District Court.

#### DECISION

The Federal Court of Justice set aside the judgment and referred it back to the Munich Upper District Court for reconsideration.

The Federal Court of Justice established, first of all, that the plaintiff was entitled to claim injunctive relief on the basis of its licensing agreement, but not its claim to information. The purpose of the latter was to quantify the claim for damages. A licensee is not entitled to its own claim for damages. Nor had the courts established that the plaintiff had been authorised by the trademark proprietor to assert the claim for damages or that the claim had been assigned to it by the latter.

On the matter of injunctive relief, the Federal Court of Justice affirmed a trademark infringement because a product bearing an identical trademark for identical goods had been sold without the consent of the trademark proprietor.

However, the court deemed that it had been insufficiently established whether 'exhaustion' of protection had arisen in respect of the products sold. In European trademark law, exhaustion is a reason for ruling out any trademark claims. The trademark proprietor cannot, accordingly, prohibit third parties from using the trademark for goods that have been placed on the market in the EEA by the trademark proprietor itself (or with its consent). This is to ensure the free movement of original products within the European Single Market, so that national markets cannot be foreclosed by the trademark proprietor on the basis of trademark law (e.g. to achieve higher prices in individual states).

The defendant invoking the exhaustion rule generally has to furnish proof. According to the established legal practice of the Federal Court of Justice and the European Court of Justice, however, the burden of proof must be reversed if the rule of evidence might enable the trademark proprietor

to foreclose national markets. If the defendant had to disclose its source of supply, the trademark proprietor could exert its influence on that source within its distribution system to put a stop to such sales in future. There have therefore been supreme court rulings in the past that in the case of exclusive distribution systems (only one sales partner per state, to which sales are only allowed within that one state), all that the defendant needs to prove is that there is an actual risk of market foreclosure, in response to which the trademark proprietor must then prove that the products at issue were not original products that it had placed on the market within the EEA.

In the case under consideration, however, there was no such exclusive distribution system, but a selective distribution system – the sales partners were only allowed to sell to certain customers, but could do so within the EEA as a whole. The Munich Upper District Court accordingly held the distribution system to be sufficiently designed in such a way that there was no foreclosure of national markets.

The Federal Court of Justice took a different view: The distribution system under consideration could conceivably be seen as risking the foreclosure of national markets.

This was because, although sales were allowed between sales partners in different EEA states, sales on a wholesale scale were ruled out, and such sales were not counted towards the minimum purchase targets. This could have a restrictive effect on cross-border trade in goods and encourage the maintenance of price differences between Member States.

In the present case, the defendant had already argued in the previous instances that price differences for the relevant goods existed between the individual Member States and that the distribution system was capable of restricting trade. In the view of the Federal Court of Justice, the appeal court should have followed up on those statements. If, after the dispute was referred back to the referring court, the review showed that there were price differences between the Member States, this would substantiate the risk of a foreclosure of national markets, given the rules of the distribution system as described above. The plaintiff would have to prove, as a consequence, that these price differences were attributable to other causes or that it had placed the goods in question on the market outside the EEA.

## ASSESSMENT

The Federal Court of Justice extends the requirements for a 'exhaustion-compliant' distribution system such that not only are passive sales outside the assigned territory prohibited in any case – as ruled hitherto by established case law –, but also that cross-border sales within the EEA that are basically permitted may not be restricted by other contractual arrangements in such a way that it may

result in foreclosure of national markets and thus in maintenance of price differences. This case law must therefore be taken into account when creating selective distribution systems. Existing distribution systems should also be reviewed for compliance with this case law. (Brecht)

## 4. Use of the 'schufa-anwalt.de' domain for legal services infringes rights to the SCHUFA trademark

*Munich I District Court, judgment of 25.06.2020, 17 HK O 3700/20*

### BACKGROUND

The plaintiff, a well-known credit protection agency, is the proprietor of the SCHUFA trademark registered for such services. SCHUFA Holding AG issues credit rating reports, provides individuals and companies with copies of the data held on them, and erases negative data entries

when a legitimate request is made. The defendant is an attorney-at-law and offered legal services via his www.schufa-anwalt.de website, which included the removal of negative information kept by the plaintiff.

### DECISION

The District Court granted the plaintiff's application for a temporary injunction prohibiting the defendant from using the 'schufa-anwalt.de' domain, *inter alia*. The defendant lodged an appeal against the injunction order, basing his case on the exception specified in Section 23 (1) No. 2 of the Trademark Act (MarkenG) and arguing that the domain name was purely a descriptive reference to the legal services he offered to potential clients.

The District Court upheld the temporary injunction with regard to use of the domain name.

The Court affirmed, firstly, that the domain name was being used as a distinguishing mark. It served as an indication of origin in respect of the legal services performed by the defendant. Although a name is not being used as a trademark if it is used merely as a generic term, such that the relevant public would expect information about that generic term, the name 'SCHUFA' is not such a generic term. An infringement within the meaning of Section 14 MarkenG has thus been committed, as there is an

overlap in the respective services offered by the parties and because use of the 'schufa' element suggests that there is at least a business association between the parties. The plaintiff, furthermore, could claim protection based on the notoriety of its trademark.

The limit to protection imposed by Section 23 (1) MarkenG does not take hold. The reference to SCHUFA is made not merely to inform about the features of the legal services being offered, particularly since there is no specific field of law called 'Schufa law'. Nor is use of the SCHUFA trademark necessary in order to offer legal services relating to the removal of negative entries. Section 23 (2) MarkenG also stands in the way of such use, in any event, because such use is not consistent with honest practices in industry and commerce. The domain has a strong advertising impact, and the defendant, finally, uses its domain for its own product labelling.

### ASSESSMENT

Infringement claims based on a trademark can only be asserted in the case of an actively used website if the domain name is used as a distinguishing mark or trademark and is therefore understood as an indication of origin. Claims are

unfounded, in contrast, if the domain merely functions as an address, or if the relevant public views the name as a merely descriptive indication, in which case they expect information about the concrete statement, but not a special

product offering from a specific provider. The Federal Court of Justice did not see any distinctive function in the use of the 'zappa.com' domain, therefore, because the website offered nothing more than information about Frank Zappa, the musician (Federal Court of Justice, judgment of 31.05.2012, I ZR 135/10 – *ZAPPA*). A distinctive function would have required that products such as audio media or merchandise are also offered specifically on the website. So it is always a case-by-case decision when a domain name is used as a trademark.

The decisive argument set out by the Munich I District Court was that there is no such field of law as 'Schufa law', so the reference to the name SCHUFA in the domain name can only be understood as a trademark. A more in-depth rationale for the judgment would have been welcome here. The Hanseatic Upper District Court in Hamburg, for example, did not consider the domain name 'schufafreie-kredite.de' as constituting use of the name SCHUFA as a trademark. 'SCHUFA information' is a term in widespread use and can be understood as a descriptive term in the context of a loan being granted, which is why the primary issue is a special form of loan

without such information being involved. The present case can be delineated from the case before the Upper District Court in Hamburg, however, because the Hamburg case was about naming a 'formless' grant of loan, and the Munich case was about legal services being offered in connection with the SCHUFA trademark. The argument set out by the Munich I District Court regarding the possible authorisation of the defendant's legal services by the plaintiff is therefore worthy of note, indeed.

If it is established that a mark is used as a trademark, a further aspect to be considered is whether the limit to protection according to Section 23 (1) No. 2 MarkenG takes hold if the features or characteristics of a product are addressed as a descriptive indication. This rule is intended to allow all economic operators to use descriptive indications for their products. To do so, however, use of a third party's mark must specifically designate the features of the products in question. Whether this can be asserted in the case under consideration seems questionable, however, because it is not immediately apparent from the domain name what the specific services relating to SCHUFA might be. (Ebert-Weidenfeller)

## II. ELIGIBILITY FOR PROTECTION / CANCELLATION PROCEEDINGS / OPPOSITION PROCEEDINGS

### 5. Taking probable types of use into consideration when assessing the distinctiveness of a mark

*Federal Court of Justice, court order of 30.01.2020, I ZB 61/17 – #darferdas? II*

#### BACKGROUND

The discussion below follows on from previous discussions in the last couple of issues of our 'Recent Case Law in German Trademark Law', in which we discussed the Federal Court of Justice's order for referral and subsequently the ECJ judgment on distinctiveness of the '#darferdas?' mark. The Federal Court of Justice referred a question to the ECJ relating to interpretation of Article 3 (1)(b) of the Trademark Directive 2008 (now Article 4 (1)(b) of the Trademark Directive). The Federal Court of Justice wanted to know, in particular, whether a sign has distinctiveness when there are practically significant and obvious ways of using it as an indication of origin for the goods and services, even if this is not the most likely form in which the sign is used.

The basis for the order for referral was the refusal to register the '#darferdas?' trademark for various items of

clothing. The German Patent and Trademark Office and the Federal Patent Court both rejected the application due to lack of distinctiveness and on the grounds that the '#darferdas?' sign printed on the front of a T-shirt is understood as purely decorative, or as a topic of discussion on the question 'Darf er das?' ('Is he allowed to do that?'), and definitely not as an indication of origin. In its appeal on a point of law, the trademark applicant complained that the previous instances had only focused on one possible form of use, whereas no consideration was given to other forms of use, such as sewing on the mark in the form of labels. The question thus raised is whether consideration should also be given to such forms of use that, although not obvious in the specific case, may well be significant and plausible in connection with the sector concerned.

#### DECISION

Following the ECJ ruling that all the relevant facts and circumstances must be taken into consideration when registering a trademark, including all the likely types of use of the trademark for which application is filed, the Federal Court of Justice has now granted the trademark applicant's appeal on a point of law.

In line with the ECJ's observations, the Federal Court of Justice ruled that consideration must be given to all those uses that are of practical relevance for the respective industry. Uses which are either of no practical significance or which appear unlikely are basically ineligible for consid-

eration, in contrast. Given that, in addition to the decorative use of the '#darferdas?' mark, there may also be some other relevant use in the case under consideration, particularly in the form of a label as commonly used in the clothing industry, then that form of use must also be included in the overall assessment of the trademark's distinctiveness. That it is not actually obvious that the mark is being used on a label or the like, but that its use as a decorative element on the front of items of clothing seems far more obvious, is of no relevance when assessing eligibility for registration, however.

## ASSESSMENT

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If the distinctiveness of a mark is at issue, it is still not necessary to take every conceivable use into consideration, but only those for which there is a practically significant or obvious possibility or likelihood of the sign being used for the goods in question. When evaluating the individual case, it is also necessary to take the customs of the respective economic sector into consideration.

However, if registration is refused because a form of use is practically irrelevant, it is up to the proprietor of a trademark to prove that the use in question does indeed have the required relevance in practice, or that it is at least likely that the economic sector does in fact understand the specific form of use as a distinctive feature due to particular circumstances.

Whether or not the form of use – insofar as it is basically an obvious possible way of using the mark – seems unlikely in relation to the specific circumstances of the individual case is of no relevance, in contrast. If the trademark proprietor uses its trademark in a way that is purely decorative or is not indicative of origin in any other way, then this must be taken into account in the context of the assessment of genuine use, which is conditional on use as a trademark. In trademark disputes also, this point will then have to be given due consideration by examining for genuine use as a trademark. Trademark proprietors should also pay particular attention to this aspect where a mark can also or primarily be used for decorative purposes, so as to prevent any loss of the trademark and to also be able to assert the trademark in the event of infringement. (Holderied)

## 6. Protectability of chocolate packaging

*Federal Court of Justice, court order of 23.07.2020, I ZB 42/19 – Quadratische Tafelschokoladenverpackung II*

### BACKGROUND

Three-dimensional shapes may be protected as trademarks, in principle, unless the trademark consists exclusively of a shape that 'gives substantial value' to the goods. According to Section 3 II No. 3 of the Trademark Act (MarkenG), such goods are excluded from protection as a trademark if it is evident 'in view of objective and reliable aspects' that the decision by consumers to buy the goods in question is influenced to a large extent by this (artistic or decorative) value.

The question as to what role the shape of packaging plays for consumers, and what value is associated with it, was the subject of proceedings before the Federal Court of Justice in the long-standing legal dispute between Ritter Sport and Mondelez, the producer of Milka chocolate.

In 2001, Ritter, the chocolate manufacturer, applied for trademark protection of the famous square shape of its

Ritter Sport chocolate (registered as trademark No. 398 69 970). Mondelez, the American confectionery producer that owns Milka, submitted a request for cancellation of the trademark to the GPTO on 25 November 2010, on the grounds that the contested trademark consisted exclusively of a shape that was necessary to achieve a technical effect (Section 3 II No. 2 MarkenG). The GPTO dismissed that request for cancellation. Mondelez then withdrew its request for cancellation in accordance with Section 3 II No. 2 MarkenG and instead invoked the obstacles to protection pursuant to Section 3 (2) No. 2 MarkenG and Section 3 II No. 3 MarkenG in the re-opened appeal proceedings before the Federal Patent Court. Mondelez argued that the characteristic feature of Ritter Sport, namely its square shape, is determined by the nature of the product itself (Section 3 II No. 1 MarkenG) and gives it a substantial value (Section 3 II No. 3 MarkenG).

### DECISION

The Federal Patent Court granted Mondelez' request initially and ordered that the trademark must be cancelled because it was ineligible for protection pursuant to Section 3 II No. 1 MarkenG (BPatG GRUR 2017, 275 – *Quadratische Schokoladenverpackung*).

In 2017, however, the Federal Court of Justice took a different view and ruled that the shape of the chocolate per se had no benefit for a consumer and therefore was not an essential functional feature. Although Ritter Sport's contested 3D trademark was characterised by the square shape of the packaging, that feature of Ritter Sport chocolate did not constitute an essential 'functional characteristic' deriving from the nature of the product itself. Trademark protection was therefore affirmed initially, because the reason for refusal of protection pursuant to Section 3 II No. 1 MarkenG was not present (BGH GRUR 2018, 404 – *Quadratische Tafelschokoladenverpackung I*). At the

same time, the case was referred back to the Federal Patent Court for a decision on whether the square shape is the characteristic feature of Ritter Sport which 'gives substantial value' to the goods and substantiates the reason for refusal of protection pursuant to Section 3 II No. 3 MarkenG. The Federal Patent Court agreed with Ritter Sport and ruled that the contested shape did not differ significantly from the usual shape of such goods. Furthermore, the Federal Patent Court, in accordance with the Federal Court of Justice, found that there was no reason for refusal of protection pursuant to Section 3 II No. 1 MarkenG. The main use of chocolate consists in consuming the chocolate, and in that regard it is of secondary importance whether the packaging is square or rectangular.

The subject of the appeal proceedings before the Federal Court of Justice was finally confined to the reason for refusal of protection pursuant to Section 3 II No. 3 MarkenG.



The decision was based on assessment criteria such as the type of product category in question, the artistic value of the shape in question, its different nature compared to other shapes generally used on the respective market, a significant price difference compared to similar products, or the development of a marketing strategy that mainly emphasised the aesthetic qualities of the respective product. How the sign is perceived by the average consumer (public perception) is not a decisive factor when determining whether this reason for refusal of protection exists, even if this can be a useful criterion for assessing the essential features of the trademark.

The court ruled that the square shape of the contested packaging compared to rectangular packaging with sides of unequal length does not have any relevant artistic or design value and did not make the shape of the product significantly different. The shape does not differ significantly from the usual rectangular shape of chocolate bars and therefore corresponds to the relevant 'basic shape'; the square is a special form of the rectangle. The aesthetic value of such a product shape cannot be so significant, the court argues, that the primary function of the trademark, namely to indicate a specific commercial origin, is no longer performed. Consumers view the shape of the Ritter chocolate bars as an indication of the origin of the chocolate and its quality.

The fact that the square packaging is a design with special aesthetic impact does not stand in the way of the shape in question being protected as a trademark. The decision of consumers to buy the product in question is not determined to a decisive degree by this particular shape. The aesthetic design appears to consumers purely as an added ingredient to the product whereas the utility or intended use is based on other characteristics.

Mondelez' argument that the essential value of the contested shape derives from its high level of acquired distinctiveness and the ensuing competitive advantage for the trademark proprietor was not successful either. The fact that Ritter Sport pursues a marketing strategy with its advertising slogan 'Quadratisch. Praktisch. Gut.' ('Square-shaped. Practical. Good') that is specifically related to the contested shape of the product or the shape of the packaging is unimportant. The question as to whether the shape of the product has a special commercial value because it has established itself in the trade as an indication of the product's origin has no relevance in this context.

## ASSESSMENT

With its most recent decision, the Federal Court of Justice has countered Mondelez' argument that the acquired distinctiveness (Section 8 III MarkenG) of Ritter Sport's square packaging was an essential feature that gave value within the meaning of Section 3 II No. 3 MarkenG (in para. 46). A decision as desired by Mondelez might have produced a situation where shape marks, which are competitively very successful and, as a result of their use, particularly distinctive, would be liable to cancellation under Section 3 II No. 3 MarkenG on account of their commercial success. Commercially valuable trademarks based on the shape of a product would then be generally ineligible for protection. However, a new scope for interpretation is opened by the fact that the Federal Court of

Justice makes the refusal of protection pursuant to Section 3 II No. 3 MarkenG, among other factors, subject to the question which particular features exert a decisive influence on the consumer's decision to buy the product. The question as to how the essential value of a trademark is to be determined and which criteria are to be applied in future when decisions are made by the courts and trademark offices, has not by any means been finally resolved. It must be assumed that it will remain a challenge for the trademark offices and courts to elaborate clear-cut criteria for the individual barriers to protection, to apply those criteria and then to communicate them in a comprehensible manner to the parties involved. (Böhm)

## 7. Bad faith constituted by applying for a trademark without any intention of using it

*European Court of Justice, judgment of 29.01.2020, C-371/18 – Sky ./ SkyKick*

### BACKGROUND

The three plaintiffs, all of them members of Sky, the pay TV group, originally filed an action with the High Court of Justice (England and Wales) against two associated British companies by the name of SkyKick. Sky accused SkyKick of infringing various trademarks held by Sky. In retaliation, SkyKick filed counter-claims for cancellation and complained about the very broad list of goods and services to which the Sky trademarks in suit related. To put a point on it, SkyKick raised the question: May Sky populate the register in 22 classes for more than 8,000

terms, in some cases for registered goods that are quite obviously unrelated to the commercial purpose and without any intention of using the trademark in relation to those goods (whips, bleaching preparations, ...) and for extremely broad terms such as 'computer software' or 'telecommunications services'? As it was a matter of interpreting European law, the High Court referred the question to the European Court of Justice (ECJ) in a preliminary ruling procedure.

### DECISION

The ECJ answered the first referred question concerning the expansively broad lists of goods and services by ruling that a registered trademark cannot be cancelled solely on the basis of its broad and imprecise list of goods and services. This is not one of the reasons for cancellation as exhaustively listed in the EUTMR. Nor is the expansive list contrary to public order.

The second, more interesting question referred to the ECJ concerned bad faith due to the obvious lack of any intention to use the trademarks for certain goods or services, was answered by the ECJ as follows: It does not suffice for the presumption of bad faith that the trademark proprietor does not carry on a commercial activity involving the registered goods and services. However, an application filed with no intention of using the trademark may be in bad faith if there are also 'objective, relevant

and consistent' indicia showing that the applicant had the intention of either

- 'undermining, in a manner inconsistent with honest practices, the interests of third parties', or
- of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trademark.

The ECJ is also explicit in stating that bad faith may conceivably relate to only part of the list of goods and services.

After the matter was referred back to the High Court, the contested trademarks were subsequently cancelled in part.

The concept of bad faith when applying for a trademark is not defined by law. Various criteria have been elaborated in case law (e.g. verifiable awareness of the registered sign being used by a third party, where there is an intention to inflict harm without having any intention to use the sign oneself). If registration is based on commercial logic, this would suggest there is no bad faith. The question as to whether an applicant is acting in bad faith must always be examined on a case-by-case basis.

The answer to the first referred question concerning the continued permissibility of a broadly worded list of goods and services has prompted sighs of relief from trademark proprietors who were worried about having to work night shifts to check all their lists and make them more precise. Broad terms such as 'computer software' or 'telecommunications services' are still allowed (in contrast to jurisdictions such as the U.S.A., for example, where the USPTO routinely requires very precise wording).

The answer to the second referred question, on the other hand, gives rise to another set of cases where a trademark might be (partly) cancelled due to bad faith: although the decision emphasises the protective period for genuine use to be shown, in that it must be possible for a trademark applicant to register a broad list, (partial) cancellation is nevertheless possible – subject to high hurdles – if there is a verified lack of any intention to use the trademark, and there are further indications that the application is made in bad faith. This is the case, in particular, when trademark registration is pursued contrary to its function as an indication of origin, i.e. contrary to the purpose of marking goods and services with an indication of origin, but instead to inflict harm on third parties.

The logical consequence of this decision is that caution should certainly be exercised when registering an overly broad list of goods and services without commercial logic (e.g. as a defensive trademark). The criteria for cancellation due to bad faith as manifested by a lack of intention to use the trademark in relation to certain goods and services are tough, nevertheless: the list may still be broad in scope, but not totally absurd, or indiscriminately broad for no understandable reason. Even then, there is only a threat of cancellation in respect of that specific part of the list.

When asserting trademarks registered for a broad range of goods and services, the list should be carefully checked for any weaknesses, in any case – and the converse applies with regard to potential avenues of attack against opponents' trademarks.

The outcome of the '*Monopoly*' case currently pending before the Court of Justice of the European Union (case no.: T-663/19) will also be of particular interest. The issue in that case also is that of bad faith when filing a trademark application, but on the basis of repeat applications. It thus relates to the frequently occurring case, in practice, where a trademark application is filed once again shortly before or after expiry of the five-year protective period for genuine use to be shown, in order to artificially benefit from a further protective period. A decision is expected sometime in 2021. (Kampmann)

## 8. An 'X' at the end makes no difference yet – The concept of genuine use in opposition proceedings, and assessing the similarity of signs involving highly descriptive elements

*Federal Court of Justice, judgment of 06.02.2020, I ZB 21/19 – INJEKT/INJEX*

### BACKGROUND

In opposition proceedings, the Federal Court of Justice had to decide whether the signs 'INJEKT' and 'INJEX' are sufficiently similar to assume a likelihood of confusion in the case of identical goods, namely medical syringes. The German Patent and Trademark Office and the Federal Patent Court had dismissed the opposition. However, the Federal Court of Justice referred the matter back to the Federal Patent Court for reconsideration and thus assumes a likelihood of confusion. In the grounds for its de-

cision, the concept of genuine use in opposition proceedings is discussed in detail, in addition to some formal questions. Its subsequent comments concerning the similarity of signs involving highly descriptive sounds are of key importance. This all sounds like a straightforward matter, but when looked at in more detail, the decision highlights the relevance of some interesting and, above all, practical aspects of trademark law.

### DECISION

In 2012, B. Braun Melsungen AG (B. Braun) filed an opposition against the German brand INJEX, held by Injex Pharma AG (hereinafter 'Injex AG'), on the basis of its INJEKT trademarks, which were registered for medical instruments, inter alia. Its trademarks were also registered for medical instruments, especially needleless injection systems. In May 2015, insolvency proceedings were opened against the assets of Injex AG. Without interrupting the opposition proceedings, the German Patent and Trademark Office rejected the opposition in January 2016. During the appeal proceedings brought by B. Braun, the contested trademark INJEX was transferred to Injex GmbH (hereafter 'Injex'). As genuine use of the INJEKT trademark was contested, B. Braun presented extensive evidence. As a result, the Federal Patent Court concurred with the German Patent and Trademark Office's decision and dismissed the appeal due to dissimilarity of the signs.

With regard to the formal questions, the Federal Court of Justice clarifies that the insolvency was not an obstacle because the INJEX trademark was no longer part of the insolvency estate at the time of the oral proceedings. The change in party due to transfer of the INJEX trademark is

without effect, because Injex was able to join the proceedings unilaterally without the consent of the opponent, pursuant to Section 28 (2) of the Trademark Act (MarkenG). This is efficient and gives due consideration to the interests of the parties, since the new party must accept, in return, that all the procedural acts of the former trademark proprietor must now be considered its own.

In terms of substantive law, this results in some interesting comments on all three factors involved when examining for a likelihood of confusion, namely the distinctiveness of the opposing INJEKT trademark, the similarity of signs, and the similarity of goods.

When examining for similarity of goods, it is essential to assess the genuine use of the INJEKT trademark. A distinction must be made here between opposition/infringement proceedings on the one hand, and cancellation proceedings on the other. In cancellation proceedings, the concept of 'identical product range' applies. This commercial perspective is urgently required. An appropriate balance can then be struck between the general interest in keeping the register free of unused marks, and the trademark proprietor's interest in being able to develop

them within the same range of goods and to remain commercially flexible in that respect. In opposition or infringement proceedings, on the other hand, the term 'identical goods' applies. Only the goods that are specifically used are taken into account here, otherwise trademark proprietors who file a narrowly defined, precisely worded list of goods in the interest of a 'fair' register would be disadvantaged compared to those who submit a list containing broad generic terms. In this specific case, therefore, the sale of two-part disposable syringes was considered to be genuine use of 'medical syringes' as an identical specification of goods.

With regard to the second examination criterion, the question was whether the opposing trademark INJEKT can claim an enhanced distinctiveness. The opponent, B. Braun, had presented sales figures of approximately 12 million Euro over a period of years. However, there was a preponderant lack of conclusions concerning market shares. At that point, the descriptive nature of the INJEKT trademark, deriving from the English verb 'inject', plays an important role for the first time. Reading between the lines, this sounds as if the INJEKT trademark's eligibility for registration could also have been assessed differently if application had been filed in 2000. Once a trademark has been registered, it must be assumed that it is eligible for protection, particularly since the INJEKT trademark has been registered for more than ten years and therefore can no longer be contested on absolute grounds for refusal of protection (Section 50 MarkenG, end of sub-section (2)). The Federal Court of Justice concludes that the descriptive elements of the INJEKT trademark weaken its distinctiveness, which in turn was then enhanced, however, by the intensity of use that was shown. The conclusion to be drawn, therefore, is that an average distinctiveness is to be assumed.

Finally, the similarity of signs is evaluated as the third factor indicating a likelihood of confusion. The Federal Patent

Court negated such similarity, because the eligibility for protection of the opposing trademark INJEKT consisted solely in the replacement of the consonant 'C' in the verb 'inject' by a 'K'. This modification is not found in the contested trademark 'INJEX'; the last letter, 'T', is also missing. Instead, the younger sign contains the distinctive letter 'X'. The Federal Court of Justice rejects this assessment, because the identical beginnings with 'INJE' were masked out. However, it is not permissible, when comparing the signs, to disregard from the outset an element of a unitary or composite sign on account of its descriptive character. The assessment of eligibility for registration would otherwise be taken into consideration several times – through the back door, so to speak. The Federal Court of Justice is thus diverging somewhat from its established legal practice (judgment of 09.02.2012, I ZR 100/10 – *pjur/pure*) that a similarity of signs may be absent in such situations. The clear stipulations of the European Court of Justice in its *Roslagsöl* judgment (judgment of 12.06.2019, C-705/17) are thus being implemented.

It is important, therefore, for correct legal interpretation, that the identical descriptive element 'INJE' in the signs is not taken into consideration until the final overall assessment, and does not lead to negation of a similarity of signs. Not until the final analysis can the descriptive elements be given a lower weighting. A risk of confusion will not be established in many cases if the signs are identical solely in this one element. In the majority of cases, therefore, the shift in examination focus will not produce any different results. In this specific case, the Federal Court of Justice then suggests that the final consonants are also phonetically similar and that a conceptual similarity also results from the shared reference to the terms 'inject' or 'Injektion'. The matter was therefore referred back to the Federal Patent Court for reconsideration and a different decision.

The Federal Court of Justice decision takes us through some challenging areas of formal and substantive legal interest. For the practitioner, the formal issues involved when appeal proceedings are taken over, with simultaneous insolvency proceedings against one party and the transfer of trademark rights, are still routine legal matters. The substantive legal issues, in contrast, play a key role in day-to-day provision of legal advice, even at an early stage of the client relationship. The two central statements in the grounds for the decision should be taken into consideration early on, when selecting a new product name and filing the respective trademark application.

Firstly, it can be seen once again how important the wording of the list of goods and services is, not only for subsequent enforceability against third parties, but also for defence against third-party attacks on one's own trademark. The details in the list must be chosen with care. Consideration must be given to the legal concept of identical product range, in cancellation proceedings and in revocation proceedings due to a lack of genuine use, and to the criterion of identical goods in the case of opposition and infringement proceedings. A list should not only specify clearly and precisely the relevant products of the applicant, but should also list related generic terms, so as to be able to defend the similar range of goods in cancellation proceedings brought because of a lack of genuine use. This provides a list of goods and services with a 'sure footing' on a long-term basis, in the interests of the trademark proprietor.

Secondly, some interesting possibilities ensue from the case law confirmed by the European Court of Justice, namely that the scope of protection conferred by trademarks with highly descriptive elements may not be limited to the identical part. Slight linguistic modifications permit trademark registration in individual cases. This case law thus has beneficial impacts for the trade mark proprietor, first of all.

In infringement proceedings, the principle comes up against its limits in the form of the limitation on protection stipulated in Section 23 (1) No. 2 MarkenG. A third party

cannot be prohibited, as a basic principle, from using details that are descriptive of the relevant goods. Another limit to the principle that purely descriptive elements cannot be excluded from the outset from the assessment of sign similarity is encountered by trademarks consisting of several individual elements (e.g. Yoo Food), or composed of several elements forming a single word (e.g. Yoofood). The overall impression conveyed by these 'complex' signs may be dictated by a single element. In its court order of 09.07.2020, I ZB 80/19 – *YOOFODD/YO*, for example, the Federal Court of Justice ruled that the composite, single-word sign 'YOOFODD' is characterised by the single distinctive element 'YOO', because the simply descriptive element 'FOOD' can be disregarded as a mere reference. Even though descriptive elements cannot be disregarded from the outset, they are generally assigned a lower weight when examining for similarity of signs.

As a result, slight modifications of a directly descriptive indication – e.g. by changing individual letters to produce a 'distorted' text or phonetic sound – offer some interesting opportunities to register trademarks that are immediately understood by the relevant publics being addressed. The advantage of these designations in communication with customers is that they speak for themselves and do not require any further explanation. The scope of protection conferred by these 'self-explanatory' trademarks is minimal, by nature, but registration may well produce uncertainty among competitors. It is difficult for them to judge which language modification is sufficient to designate their own product, without infringing the registered trademark right. The fact that this is a question not of similarity of signs, but of the overall analysis of the likelihood of confusion, makes assessment even more precarious. To prevent the risk of trademark infringement, competitors often evade the issue by using different names. This broadens the scope of protection conferred by the trademark – not in legal, but in factual terms. This is certainly one reason why trademarks with highly descriptive elements will continue to play an important role in the course of trade and will continue to occupy the trademark offices and courts. (Ehlers)

## 9. Descriptive name for ice cream to be kept available for general use (Plombir)

*Federal Patent Court, court order of 04.03.2020, 28 W (pat) 27/13*

### BACKGROUND

This case related to the 'PLOMBIR' trademark, application for which was filed on 8 April 2009, and which was registered on 7 July 2009. 'PLOMBIR' is the trademark of a brand of ice cream that is well known to at least some groups of final consumers.

The applicant had requested cancellation of the trademark registration, inter alia in respect of 'eggs, milk, milk products, butter, cream, yoghurt, milk powder for nutritional purposes; desserts made of yoghurt, curd or cream; coffee, cocoa; chocolate and chocolate products; ice cream; flavourings for foods' and based that request on Section 8 (2) Nos. 1 and 2 of the German Trademark Act (MarkenG), as 'PLOMBIR' is the generic name for a

very popular and fatty ice cream in Russia that has to have a special composition.

The GPTO Trademark Division ordered that registration for these goods be revoked. The Federal Patent Court dismissed the appeal. The proprietor of the contested trademark lodged an appeal against that decision, which had to be heard without having to be admitted. In its court order of 6 July 2017, the Federal Court of Justice set aside the Federal Patent Court order and referred the case back to the latter court for a new decision. The appeal that was then lodged was also unsuccessful and the trademark is still cancelled.

### DECISION

The fact that the 'PLOMBIR' trademark is a combination of Russian words and that most of the domestic public probably does not know the exact meaning of the word 'PLOMBIR' does not preclude affirmation of the absolute reason for refusal pursuant to Section 8 (2) No. 2 MarkenG, because a descriptive name in Russian may have to be kept freely available even if it is not understood by a large proportion of the general domestic public, and not, in particular, by the majority of average consumers. The absolute reason for refusal pursuant to Section 8 (2) No. 2 MarkenG does not require any unanimous or predominant public perception; rather, a descriptive character is already relevant even if it is only recognised by specialised domestic circles involved in international trade. Even the knowledge held by a relatively small part of the involved public can thus prevent trademark registration in individual cases. This assumption has to be made regarding the 'PLOMBIR' sign and in respect of the trade public.

Ice cream is a product aimed at the general consumer and regularly purchased by the same, so the general food

trade is to be considered the relevant trade public. These specialised domestic circles involved in international trade can be assumed to be capable, in principle, of recognising clearly descriptive information in foreign languages as well. This is to be assumed, in any case, for languages of foreign countries with which trade relations exist in respect of the relevant goods and services.

Since it is sufficient, in view of the established case law of the ECJ, that the sign is a suitable indication on the domestic market, it is not even necessary that the relevant trade public also imports ice cream, and specifically Russian ice cream into Germany, or imported it at the time of registration. It is assumed, therefore, that the trader or buyer dealing with the Russian food trade knows the names used in the food sector there, regardless of whether he has already started to import these goods.

The 'PLOMBIR Sovjetskij' trademark was cancelled, accordingly, for all goods which are intended to be used as an ingredient in the production of ice cream.

## ASSESSMENT

The decision confirms that language skills even among small parts of the specialised circles may be sufficient to fulfil the absolute ground for refusal pursuant to Section 8 (2) No. 2 MarkenG. By reference to the language skills of the German professional circles, which are assumed to be abstract, it no longer matters whether and to what extent parts of the German population are actually proficient in the language concerned and recognize the descriptive content of the sign. It is sufficient, rather, to establish that there are trade relations with the country concerned in respect of the goods and services in question.

It can therefore be expected that, in the case of descriptive foreign-language names, an absolute reason for refusal of protection may be increasingly established ex

officio in future, or can be successfully asserted in the cancellation proceedings.

This argument can be used to prevent the kind of abuse of trademark law, where companies arrange for generic terms to be registered as trademarks with the intention of obstructing other suppliers, thereby exploiting the fact that examiners cannot easily recognise the descriptive character of such terms.

Now that the ECJ has also upheld the rejection of the application, in its judgment of 18.06.2020 (C-142/19) relating to the parallel European Union trademark application 'PLOMBIR', it can be assumed that there is established legal practice in this regard. (Förster)



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