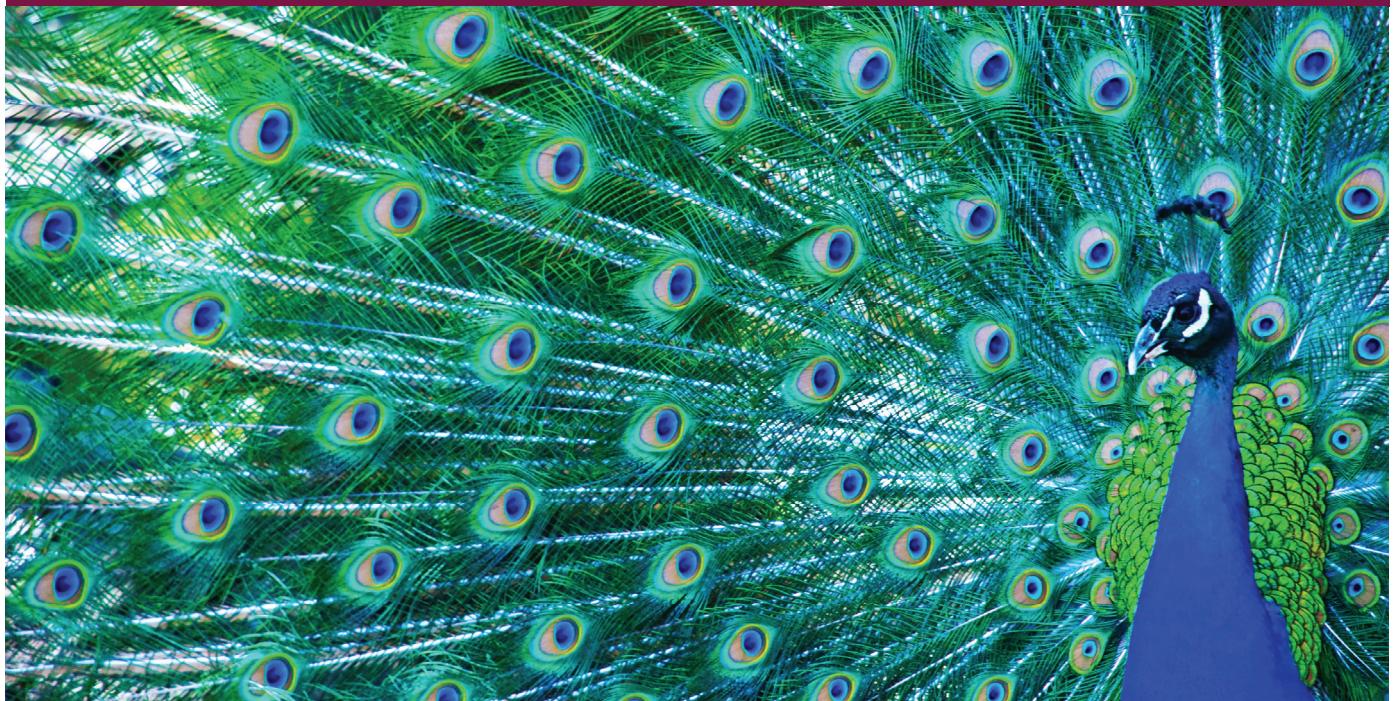


IP-NEWS

Az. I ZR 219/06 – “Thermoroll”.

Federal Court of Justice decides on Use of Intellectual Property Right Notices under German Trade Mark Law.



In its on 26 February 2009 announced decision (Az. I ZR 219/06 – “Thermoroll”) the Federal Court of Justice held that the use of a sign in connection with the symbol ® (“R in a circle”) without being the owner or the licensee of an accordant trade mark, is in principle misleading within the meaning of the German Unfair Competition Act. Consumers understand the ® Symbol in the way that a trade mark of exactly that form exists and that the user has a right to use this trade mark.

## Background

The symbols ®, ™ or © which can often be seen on products and in advertisements are intended to indicate existing intellectual property rights or intellectual property rights in the process of being created. The use of these intellectual property right notices is not expressly regulated by statute in Germany, but merely supplements the legal protection of (registered) trade marks, patents, registered designs, utility models or copyrights. The use of these notices in connection with the corresponding intangible goods law is not a mandatory precondition for asserting these rights vis-à-vis third parties, but does offer some advantages. Nevertheless, it has to be observed that the customers are not misled by the way the symbols are used.

### Intellectual Property Right Notices in trade mark law and copyright law

- The intellectual property right notices used in connection with trade marks, ® (“R in a circle”) and ™ (“TM in superscript”) have their origins in Anglo-American law. While ® stands for a registered trade mark, i. e. a trade mark registered with the (respective) trade mark office, the ™ (“trade mark”) is a non-registered trade mark whose protection is solely based on its use in the course of business.
- In copyright law the symbol © is in use worldwide. This too has its origins in American law and stands for “copyright”. However, the © symbol is only used for visual perceptible copies, while phonorecords display the indication ® (“P in a circle”), which stands for “phonogram”. These two notices are also accompanied by the copyright owner’s name and the year of the first publication.

### Advantages of using Intellectual Property Right Notices

Even though the use of these symbols is not obligatory to proceed against an infringement of the respective intellectual property right, it has considerable advantages:

- The deterrent effect of the symbols can be conducive to prevent imitations. Further, they have advertising effect as many customers associate particular qualities and special features with a product protected by a trade mark.
- Moreover, it is notable that in case of the usage of a protected symbol it is easier to fulfill ones obligation to deliver evidence for the default of the infringing party. The successful claim for damages requires knowledge of the existing right by the infringing party. If the product of an enterprise is labeled with an intellectual property right notice, the infringing party is subject to a duty to enquire about existing rights. If he fails to take these search measures, fault on the part of the infringing party can be asserted.
- Through the use of the symbol ®, the trade mark owner makes it clear that the sign is used as a “trade mark”, which can also enable proof that the sign is genuinely used in such way as to maintain corresponding rights. Accordingly, the use of the ® notice can increase the relevant sector of the public’s perception of the sign as trade mark, and thus facilitate proof of notoriety and degree of acceptance among the relevant business circles.
- The use of the symbol ® is particularly to be recommended if trade marks with an increasing notoriety are in danger of losing their distinctiveness and degenerating to a general description in trade for a product or service for which it is registered (e. g. “Walkman”).
- In the absence of a register for works protected by copyright, Section 10 Copyright Act (UrhG) makes it easier for the author to prove copyright and thus assert his rights in case a copyright notice in the usual manner (see above) appears on the work.

## Limits of the Use of Intellectual Property Right Notices

Within the scope of using these symbols, the owner of rights should especially observe the following limits set by competition law:

- The notice must be positioned in such a way that it is clear for the consumer what part of the sign is protected.
- Therefore, particularly the ® symbol should always follow the complete registered trade mark. It is inadmissible to arrogate a trade mark which does not exist at all or not in this form.
- Mere slight differences in a trade mark, which would not prevent a genuine use, are in principle not deceptive as the Federal Court of Justice recently decided (in its "Thermoroll" decision).
- In principle the symbol can be used solely for the goods and services for which the trade mark enjoys protection.
- Within the European Economic Area the use of the trade mark notice ® besides the trade mark is already admissible if the trade mark is only registered in one Member State.
- Putting a product into circulation with the ™ symbol for an unregistered trade mark is regarded as misleading within the meaning of the Unfair Competition Act, as a not inconsiderable part of the German public believes this sign stands for a foreign registered trade mark.
- Additionally, copyright indications should only be used if the work does not clearly lack the requirements necessary for protection.

If you have any questions or if you require more detailed information, please do not hesitate to contact us.

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