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The tradition of non-traditional trademarks in Germany

Even before the implementation of the EU First Trademarks Directive in Germany in 1995, the German courts and the Patent and Trademark Office had begun to establish a tradition of registering and defending non-traditional marks. However, the use of such marks has challenged German trademark practice and raised new questions to be answered by the courts

Although non-traditional designations have been protected in Germany for some time under the Unfair Competition Law, the EU First Trademarks Directive (89/104/EEC), which was implemented in Germany by the Trademark Act 1995, qualified certain non-traditional designations as registrable as trademarks. Since then, all kinds of sign, including sounds, three-dimensional shapes and colours, can be registered as trademarks. However, the registration of non-traditional trademarks has challenged German trademark practice.

General requirements

In general, Sections 3 and 8 of the act require that to be registered a trademark must be capable of being represented graphically and distinguishing the goods or services of one undertaking from those of another. The German courts and the German Patent and Trademark Office (PTO) have acknowledged the ability of non-traditional trademarks to distinguish products. However, distinctiveness must be considered on a case-by-case basis.

Following the European Court of Justice (ECJ) decisions in *Sieckmann* and *Libertel*, for a graphical representation the sign must be capable of being reproduced in two-dimensional form in a clear, precise, self-contained, easily accessible, intelligible, durable and objective way. To the extent that certain elements of the sign cannot be graphically represented, the PTO will accept an indirect representation by way of additional written explanations.

The German practice of trademark registration

In Germany, trademark applications are examined in up to three instances by the PTO, the Federal Patent Court and the Federal Supreme Court of Germany.

The PTO and the Federal Patent Court usually issue more restrictive decisions on non-traditional trademarks than the Federal Supreme Court. However, such trademarks are generally acknowledged in Germany and it can be relatively easy to obtain trademark protection for non-traditional trademarks provided that certain conditions are taken into account in the application.

Colours

Single colours and colour combinations are acknowledged as trademarks in Germany. The requirements for a graphical representation of a single colour mark (ie, a sample in the application and a reference to an acknowledged colour coding system) are usually easily fulfilled. However, possible difficulties include colours that do not exactly match a colour code.

The graphical representation requirements are harder to meet in the case of colour combination marks. In a decision of October 5 2006 (I ZB 86/05), and following the ECJ *Heidelberger Bauchemie* decision, the Federal Supreme Court ruled that the allocation and order of the combined colours must be defined in the application by defining the proportion and the distribution order of the colours. However, the details of how to represent the proportion and distribution of the colours properly are still unclear. It is advisable to provide exemplary pictures of the products showing the colours as used.

The most critical aspect of colour marks is the proof of distinctiveness, for which the PTO usually requests survey evidence. It is advisable not only to use the colour, but also to use it in advertising as an indication of origin independent of traditional trademarks (eg, the word mark of the goods or services concerned).

Shapes

Although three-dimensional shapes can be registered as trademarks in Germany, protection may rest on whether the shape results from the nature of the goods themselves or from a technical effect, which could not be protected as a trademark pursuant to Section 3(2) of the act. In a decision of November 20 2003 (I ZB 48/98) the Federal Supreme Court held that, as a general rule, a three-dimensional trademark cannot be determined by its technical form if the product displays several design elements that are variable and not part of the product's technical function. Similarly, in a decision of July 19 2006 (28 W (pat) 98/00) the Federal Patent Court held that the shape of the Porsche Boxster car is not solely determined by its technical necessities; therefore, the shape can be protected as a trademark.

The distinctiveness of three-dimensional marks is often the crux of the examination, as the shape of a product is often regarded as a mere design element rather than an indication of origin. Therefore, in many cases the Federal Patent Court has concluded that a registration had to be rejected on the grounds of a lack of distinctiveness, no matter whether it was claimed to be inherent or acquired through intensive use. It is therefore advisable to promote the shape of a product as an independent indication of origin.

Touch marks

The restrictions set out in Section 3(2) of the act also apply to touch marks, as the tactile character of the sign must not result solely from shape or technical details. A key issue with touch marks is the graphical representation of the tactile impression. Although in a decision of April 6 2005 (28 W (pat) 228/03) the Federal Patent Court

requested that both the material and the tactile impression be described precisely, the Federal Supreme Court overruled this decision on October 5 2006 (I ZB 73/05) and held that a precise description of the felt material (ie, surface, dimension, form and structure) was sufficient. A description of the tactile impression is not mandatory. However, the court made it clear that a mere picture of the felt material and a rough description was insufficient for a graphical representation.

Sounds

Sound marks may be registered in Germany. According to the ECJ *Shield Mark* decision, the trademark must be declared as a sound mark. As a sign that is not in itself capable of being perceived visually, the sound must be represented graphically by means of clear and objective images, lines or characters. Rather than a mere written description of a sound, this requires that the sound is represented by notes. The representation requirements are satisfied where the sign is represented by a stave divided into measures and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals. In contrast to the practice of the Office of Harmonization for the Internal Market, the German PTO does not accept spectrograms as they are insufficiently intelligible.

Scents

In principle, scents may be registered as trademarks in Germany if they are distinctive. However, following the ECJ's *Sieckmann* decision, the German PTO has not yet found a way to represent olfactory signs graphically in the requisite clear, precise, self-contained, easily accessible, intelligible, durable and objective manner: a description of a scent in words is not objective, a chemical formula is insufficiently intelligible and a sample of the scent is not durable enough. At present, there is no reliable coding system for scents.

Defence of non-traditional trademarks

Although most of the existing decisions relate to the registration of non-traditional trademarks, there have been some decisions regarding their defence (ie, relating to colours and shapes). A key issue here is the relevance of other trademarks or elements used in addition to the colour, in particular word marks.

In the *UHU Stic Case* (29 W (pat) 255/03) the Federal Patent Court had to decide on the similarity between a coloured three-



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dimensional trademark registered for the shape of a glue stick and an older coloured word/device mark showing a two-dimensional representation of a glue stick with the word mark UHU on it. In its decision of October 18 2006 the court held that the signs posed no risk of confusion to the public. Although the protected shape and the shape representation in the two-dimensional word/device mark appeared similar in some aspects, the word 'UHU', together with the remaining differences in the shape, were sufficient to exclude a likelihood of confusion. However, on October 26 2006 the Federal Supreme Court ruled differently in *Lindt Goldhase* (I ZR 37/04), where the owner of the three-dimensional trademark for a chocolate bunny in a gold wrapper with the word mark LINDT sued the producer of a similar wrapped chocolate bunny. The Federal Supreme Court held that there is no rule according to which the overall visual appearance of a three-dimensional trademark is always dominated by the word mark, in this case LINDT. Therefore, the Federal Supreme Court remitted the case to the Court of Appeal to examine the relevance of the shape and colour for consumer recognition of the product.

Summary

The successful registration of non-traditional trademarks requires close attention to the graphical representation requirements developed by the courts. However, if the requirements are fulfilled and the mark is distinctive, both the registration of the mark and the defence of the mark against similar marks or elements can be easily achieved. Trademark owners should be encouraged to apply for the registration of non-traditional trademarks in Germany. Successful registration and defence in Germany can also make it easier to obtain protection of non-traditional trademarks in certain other EU member states that often look to the developments of German law. Although the legal grounds and requirements for the protection of non-traditional trademarks have changed over time, Germany has developed a tradition for non-traditional trademarks, and trademark owners should take the opportunity to benefit from this tradition. [WTR](#)