ECTA

32nd Annual Conference
June 2013
Bucharest

THE JURY IS STILL OUT
Current References from Germany and The Impact of Recent CJEU decisions on German Jurisprudence

Marianne Grabrucker, Presiding Judge
29th Trade Mark Board, Federal Patent Court (FPC)
• Pending Preliminary Questions at the Court Justice European Union (CJEU) from Germany
First

• Expanding the CJEU Judgement on Praktiker (C-418/02; 7. July 2005) in respect of retail services

• Trade dress of a store, applied for retail services with computers, mobiles and accessories

• FPC, 29 W (pat) 518/13; 8th May 2013
Questions:

1...Should art. 2 of the Directive be interpreted to mean that the extent of protection for "the get-up of a product" includes the get-up in which a service is embodied?

2...Should art. 2 and art. 3 sec. 1 a) be interpreted to mean that a sign, showing the get-up, which embodies the service can be registered as a trade mark?

3...Should art. 2 be interpreted to mean that the requirement of graphical representation is fulfilled either by a drawn representation, or with additions such as a description of the get-up or absolute measurements in metrics or relative proportional data?

4...Should art. 2 be interpreted to mean that the extent of protection conferred by the retail trade-mark extends to the products actually produced by the retailer?
Second
Retail Services, applied for services, as delivering gift coupons, travelling services, advertising, entertainment....
29 W(pat) 573/12, 8th May 2013.
Questions:

1. Should art. 2 of the Directive be interpreted to include the retail of services under the term services under the Directive?
2. If question 1 is answered in the affirmative: Should art. 2 be interpreted to mean that the services offered by the retailer must be substantiated in the same way in terms of content as the goods sold by the retailer?

   For the substantiation of the services, is it sufficient to name a) only the service sector, or generic terms, bb) only the classes or cc) every service specifically?
3. Are these specifications bound to the filing date or is it possible to substitute them or add to them in case generic terms or classes are named? a) If question 1 is answered in the affirmative: Should art. 2 be interpreted to mean that the extent of protection conferred by the retail trade mark for services extends to services provided by the retailer itself?
THIRD

Invaliditation Proceeding on an abstract colour mark

FPC, 33 W(pat) 33/12 = C-218/13
FPC, 33 W(pat) 103/09 = C-217/13

RED (HKS 13)
Acquired distinctiveness by use referring to an abstract colour mark RED (HKS 13)

1. Is an interpretation of national law according to which in case of an abstract colour mark (here: red HKS 13), claimed for services in the financial sector, a consumer survey must show a percentage of 70% to show acquired distinctiveness by use contrary to article 3 section 1 and 3 of the Directive?

2. Should article 3 section 3, first sentence be interpreted to mean that the filing date of the trade mark is decisive - rather than the date of registration - even if the trade mark's owner submits - in nullity proceedings - that the trade mark has acquired distinctiveness by use in the three years following the filing, but before its registration?

3. In case the date of filing is deemed decisive in the circumstances outlined above:

   Should the trade mark be declared invalid if it is unclear - and cannot now be ascertained - whether it has acquired distinctiveness by use at the time of the filing? Or does the declaration of invalidity require the applicant in the nullity proceeding to prove that the trade mark did not attain distinctiveness by use at the time of the filing?
Decisions of the CJEU and their Impact on German Jurisprudence
Word mark IP TRANSLATOR applied for Class 41 (Education; providing of training; entertainment; sporting and cultural activities)

Judgement: ...an applicant... who uses all the general indications of a particular class heading.. Must specify whether its application for registration is intended to cover all the goods.. Included in the alphabetical list of the class or only some of those goods... If the application concerns only some of those goods..., the applicant is required to specify which of the goods.. In that class are intended to be covered.

Practice in German Patent Office:

class headings terms are to be interpreted literally –

• MEANS WHAT IT SAYS
Judgement:

“A CTM is put to “genuine use” when it is used ...of maintaining or creating market share within the EU for the goods...covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking in account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods...and the territorial extent and the scale of the use as well as its frequency and regularity.”

Opinion of the General Advocat: use is not necessarily linked to national borders.
German Decisions:

FPC, 30 W(pat) 58/11, 25th April 2013

vs

D-Linksoft  D-Link

Use of a CTM in Germany and Austria is sufficient
Tomtec /

- FPC, 30 W(pat) 1/10 ; 14th April 2011

- Germany is the country within the EU with the highest national gross product of all Member States. Therefore genuine use of a trade mark within its borders is sufficient as proof of use as a CTM.
Falcon vs. Falcuun

FPC, 26 W(pat) 512/12, 12th Dec. 2012 (Both registered in class 32)

- The CTM’s business volume for beer in Sweden may only have been 0,2% in respect of the overall turnover of all breweries within the EC. However, a market share of 26% in Sweden was deemed sufficient evidence of use as a CTM.
Freixenet

Judgment - 20. 10. 2011 - C-344/10 P, C-345/10 P

- surface of a bottle for alcoholic drinks

- Applied in the category „OTHER“ mark, consisting
- of the shape of a product;
- Description:
- „a white polished bottle which when filled with sparkling wine takes on a golden matt (black matt) appearance similar to a frosted bottle.......protection is not wanted for the shape but for the specific appearance of its surface“

- Judgement:
- „..it is wrong to assess to custom in trade that no bottle is sold without a label or an equivalent (producer’s name); Instead it must be established whether the mark varied significantly from the norms or customs of the sector“.
Touch Mark in Germany

„Touch of a Car Seat Side“

German FCJ (order: 5th oct. 2006, I ZB 73/05; GRUR 2007,148):

*in principle possible, as long as a norm or scale is given to describe the touch objective, but not as a subjective feeling*

Whereas protection was not granted for

„Touch of Rough Abrasive Paper“ – Freixenet;

FPC, 26 W(pat)3/05

The applicant described exactly the details of the DIN-Norms to which he referred for the sign.
• „Other Mark“ in the CJEU’s judgement is equivalent to the Freixenet touch mark application in Germany.

• German Jurisdiction on this category of non-conventional trade marks has to change in future
OHIM vs Frosch Touristik (invalidation-case)
Order - 23.04.2010 - C-332/09 P

• Word mark: FLUGBÖRSE
• registered on 29th oct. 1998 as CTM in Classes 16, 39 und 42
  (in 1998 the word is not used or known in the applied branch)
• Application for invalidity Art. 51 I a; 3 april 2004
• Application on the grounds of revocation Art. 50 I b on 7th april 2004 (has become the common name)

• Date of decision: OAMI-Board of Appeal, 9. 11. 2004 (the word is used within the branch):
  • invalid, only descriptive and not distinctive
  • Appeal: GJ dismissed because basis for the OAMIs decision is date of filing and not of decision.
• CJEU:
  • „The particular date for examining distinctiveness in this case of nullification through the Court is the filing date and not the date of the office‘s decision.“

• Differing judicial principle in Germany: only the date on which the final decision is handed down is relevant.
• An Appeal on legal remedies on this point is pending at the German Federal Court of Justice in the case „Aus Akten werden Fakten“ (FPC, 30 W(pat) 40/11, 10 July 2012). Application in Sept. 2007; Research on the point how common the slogan is in April 2012. Decision in Sept. 2012).
Red Ankle On Shoe - Deichmann

Order, 26.04.2012, C-307/11 P

• CTM – applied for shoes

• Not registerable; it is only seen as a decorative element.
Federal Patents Court: 29 W(pat) 147/03;

Final Order: Federal Court of Justice, 31 March 2010 - I ZB 62/09

Applied for (et alt) clothing, shoes, etc.

FPC dismissed registration on the ground that it is seen only as a picture for advertising and merchandising;
On appeal the judgement was set aside through the FCJ:
*there might be protection as a trade mark, if the sign is fixed on the product in a way or on a certain spot where the public will see it as a sign of commercial origin because it estimates on a specific spot usually the trademark. As long as it might be fixed according to such a custom – which the court has to find out – it can’t be refused from registration.*
The CJEU stated, when the applicant referred to German Marlene decision:

*It has to be focussed on the aspect that the court is not obliged to look for different possibilities of fixing a trade mark on the product.*
• The FPC tried to combine both assessments in the Marc Twain – Case of MontBlanc (29 W(pat) 75/12, 15th May 2013):

• As names of famous historical persons are normally used in the sector of pens as „hommages“ and there is no common spot on pens for historical names where those are habitually fixed as trade marks, the Court is not obliged to research or to focus on the theoretical possibility that the public will relate the name of Marc Twain to a sign of commercial origin.
Chocolate Mouse: CJEU, 6th Sept. 2012 – C-96/11P

CTM: Not distinctive
Ornamental stitching

FPC, order: 31.1.2012, 27 W(pat) 586/10;
applied für trousers and skirts
not distinctive; nothing other than an ornamental, decorative element
Fine-liner

FPC, Order: 24th April 2013, 29 W(pat) 506/13

distinctive:

the abstract colour combination „orange/white/orange“ is already registered and due to this registered element in the applied feature of a fine-liner, which is a significant part of the sign in its overall impression, the applied sign is of commercial origin and cannot be refused from registration.
Horizontal Colour-combination GREY/RED of German Railway
Order - 07.12.2011 - C-45/11 P

• CTM applied for class 39 (carriage of passengers and goods);
• GREY(RAL 7035)/RED(RAL 3020)/GREY(7035);
• proportion 7 : 1: 2
Affirmation of the GC’s judgement refusing registration

(T-405/09P):

As measured by the overall impression of the applied sign

the color-combination is not obviously different from those colours commonly used in the field of carriage services;

it is used for traffic signs and railway crossing gates;

Usually, horizontal stripes in this trade sector are nothing more than decorative elements;

Horizontal stripes might be used as caution stripes to warn of the gap between carriage and train platform, specifically red stripes.
RED(HKS 14)/WHITE
abstract colour-combination mark : proportion 2:1, applied for „flying rescue services“;
FPC, order, 18th May 2012, 26 W(pat 52/11).

• Not distinctive:

• In the field of rescue services the applied colour combination is common.
• The applied scale number of RED in HKS 14 is very similar to RAL 3020, which is the colour of traffic red used in rescue services as sign of caution.
BUT
RED(HKS 14)/WHITE on JET-Aircraft
three-dimensional coloured get-up of a jet-aircraft applied for rescue services;
FPC, order 26th Jan. 2012; 30 W(pat) 66/10: distinctive
Helicopter in abstract color combination red/white FPC, order, 30 W(pat) 65/10: distinctive
Distictive:

In the field of rescue services, the colour-combination on cars for road traffic is common, but not for air traffic.

Rescue Services by air is a very specific sector, in which only two providers are known in Germany. One is using the colour YELLOW, the other one is using the colours RED/WHITE. The latter is the applicant.

Therefore the targeted public will see in this get-up a sign of commercial origin.
THANK YOU FOR YOUR ATTENTION