



## ABSTRACT

### THE IMPACT OF RECENT ECJ-DECISIONS ON GERMAN JURISPRUDENCE AND ACTUAL PRELIMINARY QUESTIONS FROM GERMANY

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#### References for a Preliminary Ruling to the ECJ from Germany

**A. Expanding the ECJ's judgement on PRAKTIKER with regard to retail services, which was topic in ECTA Conference, Helsinki 2002 (C-418/02, July 2005)**

**1 Concerning the GET-UP of a retail-store for retail with computers, mobile phones and accessories as a shape trade mark (29 W(pat) 518/12; 8<sup>th</sup> of May 2013)**

- 1. Should art. 2 of the Directive be interpreted to mean that the scope 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 scope of protection of a retail trade-mark extends to the products actually produced by the retailer?*

**2 Concerning the word mark "Netto" applied for retail services with services as....(29 W(pat) 573/12; 8th of May 2013)**

- 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 aa) 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 scope of protection of the retail trade mark for services extends to services provided by the retailer itself?*



**B. Concerning problems in respect of acquired distinctiveness by use referring to an abstract colour mark RED (33 W(pat) 33/12; 22 of Jan. 2012)**

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?*

**C. The Impact of Recent ECJ Decisions on German Jurisprudence**

**1. The ECJ's decision on „IP-Translator“ (C-307/10):**

*“An applicant must specify whether its application for registration is intended to cover all the goods or services included in the alphabetical list of that class or only some of those goods or services. If the application concerns only some of those goods or services, the applicant is required to specify which of the goods or services in that class are intended to be covered”.*

*The German office is continuing its practice as before the ECJ's answer: Class Headings terms are to be interpreted literally (means what it says). This is applied for the general terms which are normally provided, even if the applicant is using the class headings. In such a case, the application refers only to those goods and services which are clear and precise enough to specify, the applied for product or service provided, to be literally interpreted and cannot refer to all products or services of a class. The statement „all goods and services are applied for“ is unremarkable. The applicant has to specify precisely and in detail what the application should be registered for.*

**2. The ECJ's answer on ONEL/OMEL (C-149/11):**

*“Art 15 (1) of the Regulation must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to „genuine use in the Community“ within the meaning of that provision. .... It is for the referring court to assess whether the conditions are met in the main proceedings, taking into account all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity”.*



Accordingly German jurisprudence stated in its judgement TOMTEC vs TOLTEC (30 W(pat) 1/10): Germany is a Member State with the highest level of 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. The same conclusion was reached for use of the CTM FALCON vs FALCUUN (IR-Trade Mark) –both in class 32 (26 W(pat) 512/12). 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.

### **3. The ECJ's judgement in Freixenet – Surface of a bottle (C-344, 345/10 P):**

*Core-point was the registrability of the surface of a bottle as tm in the category "OTHER". It was claimed the colour „golden matt“ (black matt) and described the mark as a „white polished bottle which when filled with sparkling wine takes on a golden matt appearance similar to a frosted bottle“. It is not applied protection for the shape of the packaging but for the specific appearance of its surface“. The ECJ pointed out that the GC's assessments were wrong. Instead of establishing whether the marks for which registration is sought varied significantly from the norm or customs of the sector, the GC merely stated in a general manner, that since no bottle had been sold without label or an equivalent, only that word element could determine the origin of the sparkling wine, so that the colour or matting of the glass of the bottle could not function as a trade mark. Such an assessment means that marks consisting of the appearance of the packaging of the product itself that do not contain an inscription or a word element would be excluded automatically from the protection that may be conferred by the Regulation. The ECJ set aside the GC's judgements and annulled the decisions of the OHIM.*

According to this German Jurisprudence on „touch mark“ has to be changed. In the German Freixenet-case a touch mark was claimed, „touch of rough abrasive paper“. The FPC had refused protection on almost the same grounds like the General Court. #

### **4. The judgement on the nullification case Flugbörse vs Froschtouristik (C-332/09 P)**

This judgement caused a highly controversial discussed problem in Germany. The ECJ had stated, that in the case of invalidation (Art. 51 Council Reg on CTM) the particular point of time for examining distinctiveness is the filing date and not the date of the office's decision. On the other hand, it is a German principle of public law that distinctiveness even in cases of invalidation is judged by the day of the final decision as relevant. In a procedure on the slogan „Aus Akten werden Fakten“ (30 W(pat)40/11; July 2012) the board adhered to the German point of view, which was decisive for the judgement. An appeal to the Court of Justice in Germany is now pending on the grounds of legal remedies.

### **5. The judgement „Ankle on Shoe“ (C-307/1)**

This judgement is very controversial seen in Germany as well. A judgement from the FCJ on the „Marlene Dietrich Portrait trademark“ (for clothing) focussed on the point, that a sign could not be judged only as subject of merchandising or advertising when in a particular sector a specific spot is common to fix the trademark label. Therefore the average consumer will notice the sign as a trade mark obviously. Whereas the ECJ when the appellant brought forward this argument in respect of the ankle, focussed on the aspect that the court is not obliged to look for different possibilities of fixing a trade mark on the product. Some judgements in Germany try to combine both possibilities (29 W(pat) 75/12 – Marc Twain), some insist on the ECJ's ruling solely (25 W(pat) 539/11, May 2012 - Get it Right).