



K. Identifiers

Vorlesung Grundlagen des privaten Wirtschaftsrechts
-
Grundbegriffe des Wettbewerbsrechts
Sommersemester 2024



Basics

"From the human point of view, the debt which society owes to the 'inventor' of the name 'Prep Good Morning' is certainly not of the same nature, to say the least, as that which humanity owes to the discoverer of penicillin." (AG *Dutheillet de Lamothe*, Conclusions in ECJ 40/70, 1971 ECR 69, 88 - Sirena)



Basics

- No protection of invention in identifiers!
- “The **essential function** of the trade mark is to **guarantee the identity of the origin** of the marked goods or service to the consumer or end user by **enabling him, without any possibility of confusion, to distinguish the goods or service from others** which have another origin (see, inter alia, Case C-39/97 Canon [1998] ECR I-5507, paragraph 28, and Case C-517/99 Merz & Krell [2001] ECR I-6959, paragraph 22). For the **trade mark to be able to fulfil its essential role in the system of undistorted competition** which the EC Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have been **produced under the control** of a single undertaking which is **responsible for their quality** (Canon, paragraph 28). .“ (ECJ C-371/02 – Bostongurkä, 2004, ECR I-5791, para. 20)



Basics

- No protection of invention in identifiers!
- Protection of attribution
- True protection of commercial performance only with respect to acquired good will/reputation/secondary meaning (cf. ECJ – *L'Oréal*)



Development

1. Protection of firms in Commercial law
2. Trade mark protection in Germany
 - a) MSchG 1874
 - b) Gesetz zum Schutz der Warenbezeichnungen 1894
 - c) WZG 1936
 - d) MarkenG 1994
 - e) MaMoG 2019



Legal Grounds for Protection

1. Names, secs. 12, 823 para. 1 Civil Code
2. Firms, secs. 17, 37 Commercial Code
3. Company symbols, sec. 5 para. 2, 1, sec. 1 no. 2 Trade Mark Act
4. Work titles, sec. 5 para. 3, 1, sec 1 no. 2 Trade Mark Act
5. Trade Marks, sec. 3, sec. 1 no. 1 Trade Mark Act
6. Geographical indications, secs. 126, 1 no. 3 Trade Mark Act
- 7.+ protection of trade marks possible as Union Trade Mark



Names

1. Name

- a) Mandatory names
- b) Chosen names, e.g. pseudonyms

But: only names of persons, not: buildings, pets etc.

2. Infringement

- a) Contestation of a name
- b) Accroachment
 - (1) Name must be used
 - (2) unjustified



Business Names

1. Business Name („firm“)

- a) Name under which merchant does business
- b) Object of registration
- c) Duty to use business name

2. Infringement

- a) Unauthorised use, sec. 37(2) Commercial Code
 - (1) Name must be used
 - (2) Unauthorised
 - (3) „Law of identical names“



Trade Mark

1. Functions

a) Attribution:

(1) identification

(2) indication of commercial origin

(3) distinction

b) Origin/guarantee

c) Communication



Trade Mark

1. Functions of trade marks

2. Shapes of trade marks

- Word marks, e.g. „Rothaus“, DPMA no. 30108102
- Pictorial marks
- Word-picture marks
- Colour marks
- Three dimensional marks
- Olfactory marks
- Auditive marks
- etc.



Trade Mark

1. Functions of trade marks

2. Shapes of trade marks

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- Pictorial marks, e.g. DPMA no. 356545
- Word-picture marks
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- etc.

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Trade Mark

1. Functions of trade marks

2. Shapes of trade marks

- Word marks, e.g. „Rothaus“, DPMA no. 30108102
- Pictorial marks, e.g. DPMA no. 356545
- Word-picture marks, e.g. DPMA no. 002591659
- Colour marks
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- etc.

Rothaus



Trade Mark

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- etc.





Trade Mark

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- Word-picture marks, e.g. DPMA no. 002591659
- Colour marks, e.g. DPMA no. 39552630
- Three dimensional marks: e.g. DPMA no. 30505861
- Olfactory marks
- Auditive marks
- etc.





Trade Mark

3. Structure of trade mark protection

- a) Protected trade mark; assumption of validity of registered trade marks in infringement proceedings
- b) infringement
- c) justification



Trade Mark

4. Protected trade mark

a) Creation of trade mark protection

- (1) entry in the trade mark register, sec. 4 no. 1 Trade Mark Act
- (2) use with acquisition of public recognition, sec. 4 no. 2 Trade Mark Act
- (3) well-known marks under Art. 6^{bis} Paris Convention, sec. 4 no. 3 Trade Mark Act



Trade Mark

4. Protected trade mark

a) Creation of trade mark protection

b) Requirements

(1) Capable of distinguishing products

i. abstract

ii. concrete ability related to specific products,
sec. 8(2) no. 1 Trade Mark Act



Trade Mark

4. Protected trade mark

- a) Creation of trade mark protection
- b) Requirements
- c) Obstacles to protection
 - (1) technical requirements, sec. 3(2) Trade Mark Act
 - (2) indicative character, sec. 8(2) nos. 2, 3 Trade Mark Act
 - (3) public order, sec. 8(2) nos. 4, 5 Trade Mark Act
 - (4) imperative public interest, sec. 8(2) nos. 6 – 9 Trade Mark Act
 - (5) conflict with other provisions, sec. 8(2) nos. 10 -14 Trade Mark Act



Trade Mark

4. Protected trade mark

- a) Creation of trade mark protection
- b) Requirements
- c) Obstacles to protection
- d) Possibility to overcome obstacles based on lack of distinctive quality by secondary meaning, sec. 8(3) Trade Mark Act
- e) Prior rights only relative obstacles: objection, sec. 42 Trade Mark Act, required
- f) End of a trade mark: lack of use over five years, sec. 49 Trade Mark Act



Trade Mark

5. Infringement

- a) Use as a trade mark: negatively affecting trade mark functions
- b) Protection against identical use, sec. 14(2) no. 1 TMA
- c) Protection against risk of confusion, sec. 14(2) no. 2 TMA
 - (1) Risk of confusion
 - (2) Similarity of products
 - (3) Assessment of risk of confusion



Trade Mark

5. Infringement

- a) Use as a trade mark: negatively affecting trade mark functions
- b) Protection against identical use, sec. 14(2) no. 1 TMA
- c) Protection against risk of confusion, sec. 14(2) no. 2 TMA
- d) Protection of well-known trade marks against dilution, exploitation and detriment to reputation, sec. 14(2) no. 3 TMA



Trade Mark

6. Justification

7. National, Union and International trade mark playing together

