

Siebeke Lange Wilbert

# A bespoke approach to distinctiveness

## The German Patent and Trademarks Office continues to retain a restrictive approach when assessing the distinctiveness of an application

Applicants applying for trademark protection in Germany are likely to perceive the German Patent and Trademarks Office (GPTO) as an accessible institution which takes a reasonably cooperative approach to the registration process. For example, wherever possible, applicants will be informed of any objections that the GPTO may have at an early stage in the proceedings, so that they can clarify uncertainties or submit observations to defend the application.

In addition, the GPTO allows the submission of specifications for the list of goods and services before rendering a provisional refusal. The GPTO is also quite generous in extending the deadlines that it sets.

In addition to this general interaction with the GPTO during application proceedings, applicants must consider carefully the degree of substantial examination and the thresholds that must be met in order to obtain protection.

### General requirements

According to German law, a sign must be capable of being represented graphically in order to qualify for protection as a mark.

In addition, the GPTO examines whether absolute grounds for refusal exist. With regard to relative grounds for refusal (ie, prior registrations by third parties), the GPTO neither examines whether such obstacles exist nor notifies the owner of such prior registrations of any potentially conflicting applications. Therefore, the onus is on trademark owners to watch new applications and to file oppositions to prevent the registration of conflicting marks. Implementing a trademark watch for all relevant signs, as well as conducting a search before filing, is indispensable for the efficient protection of a mark.

Regarding absolute grounds for refusal, the GPTO conducts a thorough analysis, mostly relying on the European Court of Justice's (ECJ) *Libertel* ruling (C-104/01, para 59), according to which the examination carried out at the time of application for registration must not be minimal, but must consist of a stringent and full examination. As a result, the number of marks that are formally refused is quite high. For example, in 2009 only about 70% of all German national applications were successfully registered, whereas the corresponding Community trademark office (the Office for Harmonisation in the Internal Market) rate is 92%.

Unsurprisingly, most rejected applications fall down due to a lack of distinctiveness. The GPTO examines thoroughly, particularly through internet searches, whether any indications of descriptive use can be detected, and makes these results available to the applicant. It is worth scrutinising these print-outs closely, since they frequently do not fully cover the goods or services in question.

According to German practice, the crucial test for establishing distinctiveness concentrates on a trademark's independence from the product and its features, allowing it to indicate the commercial origin of goods or services. The criteria for assessing distinctive character are the same for all categories of mark. However, depending on the individual trademark category, it can be difficult to prove that an application carries the necessary degree of distinctiveness and will be perceived by the relevant public as such.

### Word and figurative marks

Word marks and figurative marks are the most common types of mark, making up about 90% of all applications.

Word marks can be registered provided

that they do not consist of a mere description of the goods or services for which they claim protection. Essentially, any application must be capable of serving as an indication of origin to individualise the related goods and services.

In order to reject an application, the GPTO need not show that a descriptive use exists; the mere potential to serve as a description is sufficient to justify a refusal. Consequently, the fact that the mark applied for does not accord with German grammar rules or has not previously been used in a particular combination or spelling does not entitle the applicant to register a mark. In case of ambiguities, the GPTO will – in line with existing ECJ case law – reject an application if one of the various meanings could be construed as being descriptive of the relevant goods or services.

The GPTO is also rather strict with regard to applications for marks using a descriptive meaning in a language other than German. While the examination of such applications must be based on the perception in the German market, the GPTO assumes that the German public, or at least the relevant parts of it (eg, experts), will understand the descriptiveness of the term. Therefore, applications in English, French and even Turkish have been rejected based on an alleged understanding of their meaning by the German public.

To avoid rejection, proprietors frequently resort to adding figurative elements to their applications. This may increase the chances of successfully obtaining protection, provided that the additions are not limited to simple graphic illustrations and carry some degree of distinctiveness in themselves. In a recent ruling the Federal Court of Justice confirmed a decision refusing protection for the word 'Hey' filed in a specific typeface

and surrounded by quotation marks. Therefore, while it may be advisable to file such combined marks, particularly as a means of deterrence, the proprietor should not overestimate the scope of protection inferred from such right: in infringement proceedings the courts have often narrowed the scope of protection of such marks significantly, leaving the proprietor confused as to the real value of the mark.

However, following a rather lenient recent ECJ ruling on slogans (C-398-08), applicants may hope that the GPTO will take a less restrictive approach with regard to this category of mark.

### Numbers

Numerical trademarks can also enjoy trademark protection. In this context, the trademark protection essentially depends on the custom in the particular sector. For example, the numeral '1' has no distinctive character in the context of radio and television broadcasting. However, with regard to cigarettes, the Federal Court of Justice ruled in favour of the registrability of the numeral '1'. Numerals may also be subject to a refusal based on an alleged ability to mislead consumers if these can be construed as a date in the past. According to GPTO practice, such figures may imply that a product or service marked with the number has been marketed since that date.

### Three-dimensional marks

As the public's perception of mere shapes as an indication of origin is not necessarily the same as in the case of a word or figurative mark, a three-dimensional mark can be registered on condition that the depicted goods depart from the norm in the relevant sector. Features necessary to attain technical effects must not be taken into account when assessing the distinctiveness of a three-dimensional mark. The trademark application shall consist of a graphical reproduction (up to six views) showing all features of the mark. Both drawings and photographs can be used for this purpose. Depending on the individual features of the product, design protection or unfair competition law may provide the more appropriate IP right, and complement or even replace trademark protection.

### Colour marks

In principle, single colour trademarks can also be registered as trademarks in Germany. The application shall consist of a colour sample (eg, a reproduction of the colour on paper) and the designation of the colour according to the internationally recognised identification



**Tim Kleinevoss**

Partner

[kleinevoss@siebeke.com](mailto:kleinevoss@siebeke.com)

Tim Kleinevoss specialises in trademarks, designs, competition issues and copyright. He provides strategic advice to many well-known German and international companies and represents clients on a range of issues, from filing to infringement litigation. Dr Kleinevoss studied law at the Universities of Dusseldorf and Edinburgh and currently teaches national and international trademark law at the University of Dusseldorf. He has been a partner at Siebeke since 2009.

code. However, in most cases a single colour trademark will lack distinctiveness. For example, the colour green was rejected for environmentally friendly services. With reference to the ECJ's jurisdiction, the GPTO held that a sign consisting of a single colour will not be perceived by the public in the same way as a word or figurative mark, thus rendering it nearly impossible to obtain trademark protection for a single colour without claiming acquired distinctiveness based on past use.

### Other marks

Position marks can be subject to trademark registration in Germany provided that the presentation of such a mark consists of a graphical reproduction of the sign along with a detailed description of its position on the goods concerned. The goods bearing the position mark must be represented in the application only if this is necessary to indicate the exact positioning of the sign. A position trademark is likely to have distinctive character if it departs from the customs of the trade.

In principle, musical and other sounds are protectable as trademarks in Germany, but so far this category is of only rather

academic interest. Those determined to obtain protection for sounds should observe that a literal description of the sound (eg, 'the cry of an animal') is insufficient to prove that it can be registered. It is crucial to submit a graphical form allowing for the reproduction of the sound; therefore, notes and sheet music should be filed.

Additionally, the sign must carry some degree of distinctiveness in order to qualify for trademark protection.

In contrast to sound marks, olfactory trademarks are not capable of registration since they cannot be represented graphically in the Trademark Register. This also applies to touch marks, no examples of which have been registered to date due to the problems involved in their graphical representation. A verbal description of a specific smell or feel cannot be as precise and clear as a visual perception of a sign.

### Summary

While the GPTO cites the ECJ's guidelines, according to which the criteria for assessing distinctive character are the same for all categories of mark, in practice significant distinctions exist between the various types of mark. In the near future, it is fair to assume that the GPTO will retain this rather restrictive approach when assessing the distinctiveness of an application. [WTR](#)