

Submission by the Delegation of Germany

At its sixteenth session, the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications asked the Secretariat to develop a working document on the representation and description of new types of marks and a working document on the application of trademark principles to new types of marks, to be based on submissions from SCT Members. In this regard, the Delegation of Germany would like to provide the following information.

1) Representation and Description of New Types of Marks

According to German law, a sign must be capable of being represented graphically in order to constitute a mark. In line with the criteria which the European Court of Justice developed in a number of cases pertaining to new types of marks, the graphical representation, in general, must be clear, precise, self-contained, easily accessible, intelligible, durable and objective.¹

Where the mark is a three-dimensional mark, a single color, a combination of colors, a hologram, a motion or multimedia sign, a position mark, a gesture mark, a sound mark or a touch mark, an application filed with the German Patent and Trademark Office is required to contain a statement to that effect.

a) Visible Signs

Three-Dimensional Marks

Three-dimensional shapes can be registered as trademarks in Germany. A three-dimensional mark may consist, for instance, of product packaging or product shape. The representation of the mark shall consist of a graphical reproduction which clearly shows all features of the mark. For this purpose, drawings or photographs can be used. The German office admits up to six views of the three-dimensional shape.

Single Color

A color *per se* can be registered as a trademark in Germany. In accordance with the decision of the European Court of Justice in case C-104/01 *Libertel Groep BV vs. Benelux-Merkenbureau*, the representation of the mark shall consist of a color sample, such as a reproduction of the color on paper, and a designation of the color according to an internationally recognized identification code, such as the RALTM or PantoneTM code. An example would be the registration of a specific shade of purple for chocolate.

Combinations of Colors

A combination of colors, designated in the abstract and without contours, can be registered as a trademark in Germany. In accordance with the decision of the European Court of Justice in case C-49/02 *Heidelberger Bauchemie GmbH*, the combination must be represented

¹ See European Court of Justice, cases C-273/00 (*Ralf Sieckmann*), C-104/01 (*Libertel Groep BV vs. Benelux-Merkenbureau*), C-283/01 (*Shield Mark BV vs. Joost Kist h.o.d.n. Memex*).

graphically in shades which are named in words by reference to a color sample and specified according to an internationally recognized color classification system. Moreover, the application for registration must include a systematic arrangement associating the colors concerned in a predetermined and uniform way.

Holograms

Holograms can be registered as trademarks in Germany. However, as there have been only very few applications so far, an established office practice has not yet emerged in this regard. The presentation of such marks shall consist of graphical reproductions and a description of the mark. The reproductions should provide views of the hologram from all angles that reveal different pictures. The description serves the purpose of defining precisely the subject matter for which protection is sought. It may specify the different angles from which the pictures of the hologram can be seen, or contain a description like, for instance, “iridescent in the colors of a rainbow”.

Slogans and Titles of Films and Books

Slogans and titles of films or books can be registered as trademarks in Germany. The length of a slogan or title that would be accepted by the German office is limited by the general rule that a mark must give a uniform, coherent impression. Only signs that can be perceived as a unity can be considered a mark. The complete text of a novel, for instance, would not meet this requirement. To date, however, problems have not arisen in this regard.

Motion or Multimedia Signs

Motion or multimedia signs can be registered as trademarks in Germany. As there have been very few applications so far, an established office practice has not yet emerged in this regard. The presentation of such marks shall consist of a reproduction of the sequence of images and a description of the sign. The description must specify the chronological order of the images. As to the number of images, a limitation follows from the practical requirement that the images must still be perceivable as a uniform protected sign when published on a sheet in DIN A4 format.

Position Marks

Position marks can be registered as trademarks in Germany. They may be figurative or three-dimensional signs. The presentation of such marks shall consist of a graphical reproduction of the sign and a description of its position on the goods concerned. A sketch of the sign's positioning may be used to define the mark precisely. The goods bearing the position mark must only be represented insofar as necessary to indicate the positioning of the sign. However, they need not be reproduced in detail and do not become protected subject matter.² An example would be the graphical reproduction of a button and the indication that it is positioned in the ear of cuddly toys, or the graphical reproduction of a red stripe and the indication that it is positioned in the heel of shoes.

² For a more detailed discussion, see Bingener, *Das Wesen der Positionsmarke oder Wo die Positionsmarks hingehört*, *Markenrecht* Vol. 10 2004, p. 377.

b) Non-visible signs

Sound Marks

In principle, musical and other sounds can be registered as trademarks in Germany. In accordance with the decision of the European Court of Justice in case C-283/01 *Shield Mark BV vs. Joost Kist h.o.d.n. Memex*, however, it is not sufficient to represent a sound sign graphically by means of a description using the written language, such as an indication that the sign consists of the notes going to make up a musical work. An indication that it is the cry of an animal, or a graphical representation by means of a simple onomatopoeia or a sequence of musical notes, would also be insufficient. The requirement of graphical representation, however, can be met 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. Besides such a musical notation, the applicant must file a sound reproduction on compact disc. He or she may furthermore file a description.

Olfactory Marks

In accordance with the decision of the European Court of Justice in case C-273/00 *Ralf Sieckmann*, the requirement of graphical representation cannot be fulfilled in respect of an olfactory sign by a chemical formula, a description in written words or the deposit of an odor sample or a combination of these elements. To date, olfactory signs cannot be registered as trademarks in Germany because a form of graphic representation satisfying the criteria defined in the *Sieckmann* case has not been found.

Texture or Feel Marks

In a recent decision concerning the handle of a car chair, the German Federal Patent Court (Bundespatentgericht) held that touch or feel impressions, in general, cannot be represented graphically.³ On appeal, however, this general statement has been rejected.⁴ It seems that texture or feel marks might be capable of meeting the general requirements of graphical representation. To date, it is not clear in which cases this is possible.

2) Application of Trademark Principles

Established trademark principles fully apply to new types of marks. In particular, the basic requirement of distinctiveness must be fulfilled. The test of distinctiveness is not handled in a stricter way than in the case of traditional marks. As average consumers are not necessarily in the habit of making assumptions about the origin of goods or services based on new types of marks, it might nevertheless prove more difficult to establish distinctive character than in the case of a word or figurative mark. Like traditional marks, new types of signs, moreover, may not be descriptive or have become customary in trade. The German office would refuse, for instance, a three-dimensional shape which consists exclusively of signs and indications that

³ See German Federal Patent Court, decision published in: *Gewerblicher Rechtsschutz und Urheberrecht* 2005, page 770.

⁴ See German Federal Court of Justice (Bundesgerichtshof), decision I ZB 73/05 of October 5, 2006.

may serve to designate the characteristics of goods or services. In the public interest, these elements must be kept freely available for all traders in the market concerned.⁵

Like traditional signs, new types of signs may acquire distinctive character through use in the marketplace.⁶ This is of particular importance in the case of registrations concerning single color or combinations of colors (see below). The criteria for acquiring distinctiveness are not defined in German legislation. As a general rule, the mark in question should be established in a considerable part of the affected trade circles (degree of familiarity of not less than 50%). Acquired distinctiveness can be proven by giving evidence of use or presenting opinion polls.

In certain areas, specific rules have been developed with regard to new types of marks:

Three-Dimensional Marks

According to German legislation, shapes are excluded from trademark protection if they result from the nature of the goods, are necessary to obtain a technical result or give substantial value to the goods.⁷ The rationale of this provision is to prevent trademark protection from granting a trademark owner a monopoly on technical solutions or functional characteristics of a product which, in the public interest, must be kept freely available in order to allow competition with the trademark owner. The exclusion of technically-dictated shapes also prevents the use of trademark registrations as a means to acquire or perpetuate exclusive rights relating to technical solutions. The European Court of Justice has underlined these principles in a case concerning the registration of a three-headed shaver as a trademark.⁸ In the case of product packaging, a three-dimensional mark is considered distinctive only if the shape departs substantially from the shapes normally used in the business practice of the sector concerned.⁹

When applying the aforementioned provision to goods that do not have a shape themselves, the German office assimilates the shape of the packaging to the shape of the goods. In the case of liquids, for instance, the relevant shape to consider would thus be the shape of the packaging. The same rule is applied for determining whether the shape serves to designate characteristics of the packaged goods. This practice follows the decision of the European Court of Justice in a case concerning liquid wool detergent.¹⁰

Colors

Only in exceptional circumstances, a color *per se* can be regarded as being distinctive without any prior use. Such exceptional circumstances may arise where registration is sought for very limited goods or services in a very specific market segment. As a rule, however, single color cannot readily be registered without a showing of distinctiveness acquired through use.¹¹ The

⁵ Cf. European Court of Justice, joined cases C-53/01 to C-55/01 (Linde, Winward and Rado vs. Deutsches Patent- und Markenamt).

⁶ Cf. European Court of Justice, *ibid.*

⁷ See section 3(2) of the German Trademark Act (Markengesetz) which implements article 3(1)(e) of EC Directive 89/104/EEC.

⁸ See European Court of Justice, case C-299/99 (Koninklijke Philips Electronics NV vs. Remington Consumer Products Ltd.).

⁹ See German Federal Patent Court (Bundespatentgericht), decision Taschenlampen II, published in: Wettbewerb in Recht und Praxis 2006, page 1533.

¹⁰ See European Court of Justice, case C-218/01 (Henkel vs. Deutsches Patent- und Markenamt).

¹¹ Cf. European Court of Justice, case C-104/01 (Libertel Groep BV vs. Benelux-Merkenbureau).

color orange, for instance, would not be qualified as rare for seed products and seed processing machines. It could not be registered without proof of acquired distinctiveness.¹² In assessing the potential distinctiveness of a given color, the German office has regard to the general interest in not unduly restricting the availability of colors for other traders offering goods or services in the area of trade concerned.¹³

The same rules apply to combinations of colors which are designated in the abstract and without contours.¹⁴

¹² See European Court of Justice, case C-447/02 (KWS Saat vs. Office for Harmonization in the Internal Market).

¹³ Cf. European Court of Justice, case C-104/01 (Libertel Groep BV vs. Benelux-Merkenbureau).

¹⁴ Cf. European Court of Justice, case C-49/02 (Heidelberger Bauchemie GmbH).