



### Submission by the Delegation of Germany

At its twenty-first session, the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications asked the Secretariat to prepare a revised working document on grounds of refusal of all types of marks. SCT members were invited to present submissions on individual items of document SCT/21/2 concerning, in particular, trademark office practice in specific cases and, where available, specific graphic examples. In this regard, the Delegation of Germany would like to provide the following information.

*Absolute grounds for refusal under Section 8(2) German Trademark Law - 'Markengesetz'*

#### 1. Distinctiveness, Section 8(2) No. 1 Trademark Law

##### Definition:

Distinctiveness is the inherent capacity of a trademark to be perceived by the market participants as a means to distinguish the goods or services of an undertaking from those of other undertakings, thus allowing to attribute these goods or services to a particular commercial origin (case law reference: Federal Court of Justice [BGH], published in Gewerblicher Rechtsschutz und Urheberrecht [GRUR] 2006, p. 850 FUSSBALL WM 2006 - '2006 FIFA world cup'). A liberal standard is to be applied on principle. However, the examination must not be a minimal one. It must be a stringent and full examination (cf. European Court of Justice [ECJ] case C104/01 Libertel, para. 59).

Market participants usually perceive a sign, which is used as a trademark, in the way in which they are confronted with it as a whole and do not proceed to analyzing its details (cf. ECJ case 136/02 Maglite, para. 20; BGH GRUR 2001, p. 162, 163 RATIONAL SOFTWARE CORPORATION).

Where a trademark cannot be attributed a predominantly descriptive meaning for the relevant goods or services and where it is not a word pertaining to the German or another common foreign language which the market participants - for example, due to relevant use in

advertising - will always perceive as such and not as a means for identifying a commercial origin, there is no real reason for denying that a word, used as a trademark, may be suitable for identifying a trader and thus have distinctive character (cf. BGH, GRUR 2003, p. 1050 Cityservice).

In order to determine whether a trademark has the required distinctive character, it is appropriate to take the viewpoint of a reasonably well-informed and reasonably observant and circumspect average consumer in the area of the relevant goods and services (cf. ECJ case C-329/02 P SAT.2, para. 24).

Individual cases:

#### Combination of words

The trademark as a whole is relevant for assessing registrability. A combination of trademark elements which would not qualify for protection individually can be registrable if the overall impression produced exceeds the mere sum of the individual elements that are not eligible for protection. Merely bringing descriptive elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot confer protectability to a trademark (cf. ECJ case C-265/00 Biomild).

The design of a trademark need not present an 'additional element of imagination', a specific 'individual character' or 'originality' to be distinctive. It is merely required that the trademark is suitable for identifying the commercial origin (cf. ECJ case C-64/02 P DAS PRINZIP DER BEQUEMLICHKEIT, para. 31, 50; BGH GRUR 2001, p. 334, 336 et seq., Gabelstapler - '*fork lift*').

Where a sign contains at least one protectable element in addition to descriptive indications, it can be registered as a trademark.

#### Advertising slogans

Advertising slogans and other jingle-type word sequences must be treated just like any other word marks. Their eligibility for protection must not be subject to stricter requirements. However, the relevant public's perception is not necessarily the same for each of those categories. For this reason, it may prove more difficult to establish distinctiveness for certain categories of marks than for others. The European Court of Justice counts advertising

slogans among these categories. As a rule, market participants do not perceive an advertising slogan, which e.g. merely consists of a laudatory phrase, as identifying the source of the goods or services in question. For establishing distinctiveness it is mandatory that the relevant word sequence functions predominantly as a badge of origin. This function must take precedence over the advertising effect (cf. ECJ case C-64/02 P DAS PRINZIP DER BEQUEMLICHKEIT, para. 34 et seq.).

If an advertising slogan is short, has a certain originality and stringency, or if it is ambivalent and open to interpretation it might be suitable for identifying the goods or services of a particular manufacturer or trader. An advertising slogan will not be considered to be distinctive if it consists exclusively of descriptive indications or terms of praise and publicity statements of a general nature (BGH GRUR 2000, p. 321, 322 – Radio von hier - '*radio from here*'; BGH GRUR 2000, p. 323, 324 – Partner with the Best; BGH GRUR 2001, p. 1047, 1048 – LOCAL PRESENCE, GLOBAL POWER).

Examples of protectable marks:

Federal Patent Court [BPatG] GRUR 2001, p. 511 - Energie mit Esprit (power with esprit) for goods and services of a power provider.

ECJ case C-64/02 P – DAS PRINZIP DER BEQUEMLICHKEIT for furniture a.o.

Not eligible for protection:

BGH, published in Blatt für Patent-, Muster- und Zeichenwesen [Bl.f.PMZ] 2000, p. 331 – Bücher für eine bessere Welt (books for a better world) for books a.o.

BGH GRUR 2001, p. 1048 – LOCAL PRESENCE, GLOBAL POWER for services of a travel agent.

### Letters and numbers

Letters and numerals can, on principle, be distinctive. However, it is always necessary to assess the individual case with regard to the goods and services claimed. If a combination of letters or an individual letter is a common abbreviation of a descriptive indication, they are devoid of the required distinctiveness. Since numerals are frequently used to indicate prices, measurements or amounts, they tend to be regarded as technical indications and are often not seen as identifying the source.

Examples of protectable marks:

BPatG GRUR 2003, p. 345 – 'Z' for tobacco, cigarettes, etc. A descriptive meaning was not found.

BGH GRUR 2002, p. 970 - '1' for tobacco, cigarettes, etc. In the area of tobacco products, an isolated numeral (without any descriptive addition such as 'piece' or 'package') is normally not required to indicate numbers, sizes, or other data, at least outside customary package sizes.

Not eligible for protection:

BPatG GRUR 2003, p. 345 – 'K' for building material a.o. 'K' is also the symbol for 'Kelvin' which, in building physics, represents the heat transfer coefficient. 'K value' is a term commonly used in this field of technology.

BPatG GRUR 2003, p. 794 – '@' for miscellaneous goods and services. The sign is a general symbol of modernity. It signals that goods (e.g. print products) are available online or that goods can be ordered online.

### Event marks

Event marks are intended to guarantee sponsors of large events the exclusive commercial use of the name of the event. The requirements for protection of these marks are not lower than for other marks. In most cases, the respective names are definitely descriptive e.g. 'Meisterschaft' (championship) 'Großer Preis' (grand prix), 'Festspiele' (festival), 'Messe' (fair). Consequently, they are devoid of the required distinctiveness, if the market participants only perceive a descriptive connection of the claimed goods and services with the event, or if they merely associate the goods and services with the event as such. This is the case, in particular, where services relating to the organization and running of the event are concerned, or where goods and services are concerned that have a direct relation to the event (such as sports gear, musical instruments, print publications or other data media, clothing, games). In that case, the trademark will be perceived as identifying the contents or purpose of the event. The same applies to merchandizing and fan articles such as food, tobacco and beverages, cosmetics, fashion articles, stationery, mugs, bed linen.

When a sponsor uses an event mark for merchandizing articles, the public will not perceive this as an indication that these goods originate from the undertakings of the organizer, even if the mark is not directly descriptive for the relevant goods. Rather, the public will relate them to the event as such. It is contrary to experience to suppose that the relevant circumspect

average consumer assumes that the sponsor's merchandizing articles were produced under the control of the organizer and that the organizer was responsible for their quality. Rather, the relation of a sponsor to the event mark is generally seen as being limited to the fact that the organizer has authorized the sponsor to (exclusively) use the mark, in return for the latter's financial support.

Even a de facto monopoly position of the organizer does not change this situation. The monopoly does not have the effect that the public perceives the descriptive event mark as identifying the source of the goods or services. The public merely associates them with the organizer without automatically perceiving them as an indication of the source.

Not eligible for protection:

BGH GRUR 2006, p. 850 – FUSSBALL WM 2006 (2006 FIFA world cup)

BPatG case 29 W (pat) 20/08 - Deutschland 2006 (Germany 2006)

BPatG case 29 W (pat) 21/08 - Österreich – Schweiz 2008 (Austria - Switzerland 2008)

BPatG case 29 W (pat) 45/08 - Südafrika 2010 (South Africa 2010)

BPatG case 33 W (pat) 129/06 - combined word and figurative mark



International registration 798 562 – CHAMPIONS LEAGUE: total refusal of protection for the Federal Republic of Germany.

#### Celebrities and works of art

Names or pictures of famous historical figures can be devoid of the required distinctiveness if they are not perceived as identifying specific (present) undertakings, but are rather associated with the (deceased) person. In case of (living) well-known persons it is assumed that their

names have, per se, an individualizing character and are therefore capable of functioning as a badge of origin. Where the name of a person designates a type or property of goods or services (e.g. Diesel, Wankel and Otto for engines), it is devoid of any distinctiveness.

Works of art, in particular those that are frequently used as advertisement motifs, are usually perceived as such and not as indicating the commercial origin.

Examples:

BPatG GRUR 2008, p. 512 - 'Ringelnatz' is not protectable for data media, films, printed matter, entertainment, cultural activities, film production. Ringelnatz is the pseudonym of the German author Hans Bötticher, deceased in 1934. Even 70 years after the writer's death, the name 'Ringelnatz' is still commonly used to designate the author or his stories and poems. Against this background, the name 'Ringelnatz' can serve, in relation to the goods and services claimed, as an indication of the author or as an understandable description of the contents referring to the author and his works.

BPatG GRUR 1998, p. 1021 - application for figurative mark 'Mona Lisa'



The reproduction of the famous 'Mona Lisa' painting by Leonardo da Vinci is frequently used in relation to a large variety of consumer goods. The different kinds of use include printing on clothing, household appliances, jewelry, watches, etc. Consumers will not perceive it as identifying goods from a particular source but merely as an eye-catcher.

Under BPatG case 32 W (pat) 92/06, 'Maya Plisetskaya' is registrable for printed matter, entertainment, sports and cultural activities. In this case, a (living) artist (Maya Plisetskaya), who is a well-known and recognized ballet dancer, has her name commercially exploited through a foundation which she partners. The name constitutes an important feature of her personality. Trade mark protection must be granted even for products and services which - as in this case - cover media products and services in the fields of entertainment, sports and cultural activities. If this kind of protection was denied to well-known persons, this would mean, under the aspect of equal treatment, that these persons were treated less favourably than persons bearing an unknown name. It is true that the public associates the name of well-known artists not only with the person but also with the artistic performance or success. For this reason, the name might have a descriptive touch. This circumstance, however, justifies a

refusal of trade mark protection, at best, concerning the names of deceased artists (or authors), but not in relation to living persons.

Under BPatG case 32W(pat)388/02, 'R. W. Fassbinder' is registrable for film and TV productions, rental of films, cinema presentations; publication of products of a publishing house. In case of well-known persons it cannot be ruled out, from the outset, that their names might have individuality and can function as an indication of the commercial origin, all the more, since the public is used to the fact that e.g. top athletes or artists authorize certain undertakings to use their names for advertising purposes. Where the name of a deceased, but still commonly known person - in this case: film director Rainer Werner Fassbinder - is put to trademark use, it is not unlikely to assume that this is due to an initiative of the heirs or other persons entitled, or that these persons are in other ways involved in the mark.

#### Figurative and graphical representations

A specific figurative or graphical presentation of word elements, which are not distinctive, can have the effect that the sign is conceived as a badge of origin. The specific manner of presentation is all the more important if the relevant term has a low level of distinctiveness. Simple graphical presentations or ornamental lettering, commonly used in trade, cannot remove the descriptive character of a term.

The sign



('anti-lime') is not registrable for water softening preparations for washing machines and dishwashers, descaling detergents, decalcifying preparations for cooking utensils and beverage preparation machines (cf. BGH GRUR 2001, p. 1153).

The sign



is not registrable for cosmetics (cf. BPatG GRUR 2004, p. 336).

The sign



is registrable for clothing. It features a striking representation of the lettering, which has individual character. Protection cannot be denied on the grounds of lack of distinctiveness (cf. BGH GRUR 1991, p. 136).

### Non-Traditional Marks

Established trademark principles fully apply to non-traditional 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 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 (cf. ECJ, joined cases C-53/01 to C-55/01, Linde, Winward and Rado).

Like traditional signs, new types of signs may acquire distinctive character through use in the marketplace. 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 non-traditional marks:

### *Three-Dimensional Marks*

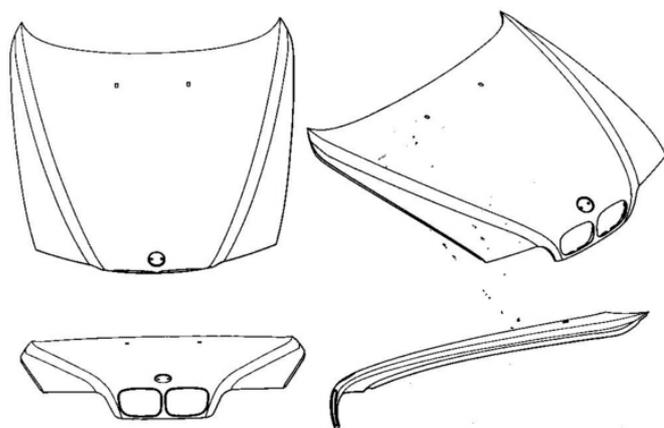
A three-dimensional mark is considered distinctive only if the shape departs substantially from the shapes normally used in the business practice of the sector concerned (cf. BPatG, published in: Wettbewerb in Recht und Praxis 2006, p. 1533 Taschenlampen II – *torches II*).

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 (cf. ECJ case C-218/01 - Henkel).

Not eligible for protection:

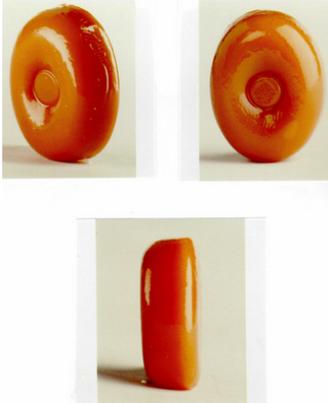
ECJ cases C-468/01 P to C-472/01 P - Washing machine and dishwasher tablets (Tabs II). As regards everyday consumer products, the level of attention paid by the average consumer is not high. The shape of a round tablet is one of the basic geometrical shapes and is an obvious one for a product intended for use in washing machines or dishwashers. Furthermore, the public concerned is used to seeing different colour features in detergent preparations (combination of various ingredients).

BGH GRUR 2008, p.71 - Fronthaube (front hood)



The consumers perceive the trademark merely as an exterior body part. Furthermore, the air inlet of the radiator grille does not vary at all from the known range of shapes.

ECJ case C-24/05 P - Shape of a sweet II



not eligible for protection for confectionery. The shape of the sweet consists of a combination of presentational features which come naturally to mind and which are typical of the goods in question. It seems like a variation of certain basic shapes commonly used in the confectionery sector and is not markedly different from other shapes for the goods in question which are commonly used for sweets.

### *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, a single color cannot readily be registered without a showing of distinctiveness acquired through use (cf. ECJ case C-104/01 - Libertel). 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.

The same rules apply to combinations of colors which are designated in the abstract and without contours (cf. ECJ case C-49/02 - Heidelberger Bauchemie GmbH).

Devoid of distinctive character:

BPatG case 29W(pat)146/06 - Rapsgeib (the yellow of oilseed rape) for Yellow Pages directories.

The public is not used to perceive colors *per se* as an indicator of trade origin with regard to business directories. Colors are used in manifold and arbitrary ways as decorative elements of business directories. The color is not used as a specific feature to highlight a certain sector/region or a publishing house. However, the trade mark concerned had acquired distinctiveness through use.

Eligible for protection:

BPatG case 29W(pat)33/08 - color mark yellow/red for garden tools



For many years, consumers have been used to identify the garden tools of a certain manufacturer by their colors. Since the products of a certain manufacturer are usually not compatible with those of another company, the consumers concerned know that when they buy a certain product they will have to stick to that brand. The color configuration shows the consumer the way to 'his/her' manufacturer. Accordingly, it was proved that color combinations were constantly used by numerous companies of the trade sector. The market participants have got used to the color combinations as an indication of trade origin and do not regard them as mere decoration.

## **2. Descriptiveness, Section 8(2) No. 2 German Trademark Law**

Trademarks which consist exclusively of signs or indications which may serve in trade to describe the respective goods and services shall not be registered. The underlying reason for this provision is the objective, which is in the public interest, to keep descriptive indications available for use by everybody and particularly competitors.

Frequently, the prohibition of registration of descriptive indications coincides with the obstacle to the protection due to lack of distinctive character. As a rule, descriptive signs and indications lack distinctive character. Nevertheless, completely unknown or foreign language technical terms are conceivable within Germany. Such terms are objectively descriptive but

German consumers will perceive them as fanciful designations with a distinctive character. Vice versa non-descriptive indications may indeed lack the capacity to identify the origin of a product e.g. advertising slogans.

#### Indications of geographical origin

Indications of geographical origin must often be kept free for general use, because the general public and competitors, in particular, have a great interest in indicating the geographical link of their products to a specific region or place.

It must be assessed whether there is currently an association in the mind of the relevant class of persons between a place and goods in question or whether it is reasonable to assume that such an association may be established in the future. Future economic developments which are not outside the realms of probability must also be considered for this assessment (ECJ case C-108/97 - Chiemsee, para. 31, 37).

For names of countries, regions, capitals or other economically important locations there is a basic presumption that they are liable to be used as indications of geographical origin of almost any category of goods (CFI case T-295/01 - OLDENBURGER, para. 37; BPatG GRUR 2000, p. 149, 150 - WALLIS).

Famous buildings and monuments may serve as indirect indications of geographical origin and therefore may not be eligible for protection.

Not eligible for protection:

CFI case T-295/01 – OLDENBURGER not eligible for the protection of milk and dairy products, ice cream a.o. The word OLDENBURGER derives directly, in its adjectival form, from the name Oldenburg, which designates a geographical region where relevant agricultural holdings are located and which is known for producing milk and dairy products.

BPatG GRUR 2000, p. 149 - WALLIS not eligible for the protection of cosmetics. Wallis is the name of the third largest Swiss canton so that the marketing of cosmetics is not outside the realms of probability, even more so, because this is a region where the chemical industry is already located.

BPatG GRUR 2005, p. 677 - Newcastle not eligible for protection of a.o. tea and packaging of tea.

BPatG case 27W(pat)35/06 - figurative mark



Not eligible for the protection of printed matter, glassware, porcelain ware and clothing. The towers of the Cologne Cathedral, as the symbol of the town Cologne, are merely a reference to the geographical origin of the goods, but not a reference to a manufacturer.

### **3. Customary designations, Section 8(2) No. 3 German Trademark Law**

There is an absolute ground for refusal of Section 8(2) No. 3 German Trademark Law, if the indication has become customary in the current language or in the bona-fide and established practices of the trade for designating the goods or services in respect of which registration is sought. When that provision is applied it is immaterial whether the sign describes the properties or characteristics of those goods or services (ECJ case C-517/99 – Bravo).

These cases do not occur frequently in practice, because the sign is mostly devoid of distinctive character or the sign is descriptive.

### **4. Likelihood of deception, Section 8(2) No. 4 Trademark Law**

Protection can only be refused under Section 37(3) Trademark Law, where there is an 'obvious' likelihood of deception. In this context, *obvious* does not mean that there is no examination and search activity whatsoever. Rather, it must be considered what is easily discernable for the examining staff from the application documents by using their expertise, the examination and search material and enquiries, if necessary, without extensive and time-consuming investigations.

The likelihood of deception must derive from the trademark itself. If a non-deceptive use of the trademark is possible, that ground for refusal cannot be applied. The mere possibility that the trademark is used for other goods which also fall under a generic term and which are not covered by the contents of the trademark does not constitute an obvious likelihood of deception to be taken into account as early as in the registration procedure (BPatG GRUR 1989, p. 593 – Molino; BGH Bl.f.PMZ 2002, p. 256 – OMEPRAZOK).

Likelihood of deception has to be considered if a substantial part of the relevant public (about 10%) is likely to be deceived.

Examples:

BPatG Bl.f.PMZ 2002, p. 571 – KOMBUCHA; deceptive for beers without added Kombucha. Kombucha is a tea fungus or a probiotic natural drink. It can be proved that Kombucha is used with water kefir and in bread, soups and yoghurt. So the consumer groups concerned have reason to assume that a (beer) drink designated in this manner does at least contain Kombucha. However, this is excluded pursuant to the list of goods.

BPatG case 26W(pat)216/03 – Alsterwasser; deceptive for whisky a.o. In large parts of Germany 'Alsterwasser' is a mixed drink of half beer and half lemonade. The consumer is deceived in his purchasing expectations. Even if it is clear from the form and the labelling of the bottles that the beverage sold is whisky, there is a likelihood of deception. The question as to whether a trademark is deceptive with regard to a certain product must be assessed exclusively in consideration of the designation as such and not on the basis of the type of use of the trademark.

## **5. Violation of public policy and accepted principles of morality, Section 8(2) No. 5 Trademark Law**

Public policy does not include every piece of German legislation. It must be a legal rule that is part of the essential principles of German law. First and foremost, immoral and religiously offensive trademarks fall under this ground for refusal.

Not eligible for protection:

BPatG case 24W(pat)132/00 - PUSSYTIME for diverse products: Considering the growing trend of moral liberalization, this provision shall be applied only restrictively. However, it is absolutely necessary to counteract the impression that trademarks with discriminatory

misogynist content will be granted legal protection. For this reason trademarks depicting women as ever-available sexual objects must be excluded from registration.

BPatG case 25W(pat)394/84 – Coran

BPatG GRUR 1994, p. 377 – Messias

BPatG case 24W(pat)140/01 – Dalailama

BPatG case 25W(pat)152/01 – urbi et orbi

BPatG case 28W(pat)66/06 – Buddha

BPatG case 26W(pat)117/06 - Pontifex

The purely commercial use of a religious term or of names and titles of the leaders of the big churches as trademarks and the grant of a statutory exclusive right to such trademarks will be perceived as offensive by a considerable part of the public concerned. Since the offensiveness, as a general rule, results from the commercial use, such applications may be refused irrespectively of the goods or services in respect of which registration is sought.

#### **6. Emblems of State and warranty signs, Section 8(2) Nos. 6, 7, 8 in conjunction with Section 8(4) German Trademark Law**

These include, for example, flags, armorial bearings and other emblems of State in Germany or other countries, official signs and hallmarks, indicating control and warranty, as well as armorial bearings, flags, or other signs, seals or designations, of international organizations and an imitation thereof. It is not only signs exclusively consisting of State emblems that are refused registration, but also signs which contain as an element a State emblem. However, that element must appear sufficiently clearly. Since a full examination is not possible during the registration procedure, only those signs can be taken into account for which the status of being an emblem of State can be identified from easily accessible publications, e.g. the WIPO database on Art. 6<sup>ter</sup> of the Paris Convention.

Usually, national colors are not regarded emblems of State. This applies where, owing to differing proportions and forms of display they do not give the impression of a flag as a national symbol, but at best refer to the geographical origin of the goods or services. Ultimately, it depends on whether the sign gives the impression of being a national emblem or whether it is exclusively used for decorative purposes without reference to an official legitimization.

Examples:

BPatG GRUR 2005, p. 679 – D-Info for a.o. software, telecommunication. Eligible for protection, since it is not an imitation of the German national flag. The national colors are used in the trademark only as a decorative figurative element.



CFI case T-127/02 for a.o. hardware, software, arranging and conducting of colloquiums, providing of tuition, instruction, training.



Not eligible for protection, because it is an imitation, from a heraldic point of view, of the circle of stars of the European emblem. The word element 'ECA' reinforces the impression that a connection exists between the applicant and the European Union.

## **7. Other legal prohibition on use, Section 8(2) No. 9 German Trademark Law**

The provision is to refuse registration of trademarks the use of which can be prohibited at any rate and obviously pursuant to other provisions in the public interest. It may be prohibited, for example, by national legislation or EU regulations in the fields of foodstuffs and tobacco.

An example of such prohibitive provisions is the law on the protection of the Olympic emblem and the Olympic names (Gesetz zum Schutz des olympischen Emblems und der olympischen Bezeichnungen), which entered into force on July 1, 2004. Under Section 3 of this law, third parties are prohibited from using the Olympic symbol and the Olympic terms 'Olympiade', 'Olympia', 'olympisch' alone or in combination with other words and the corresponding words or groups of words in other languages, without the authorization of the National and International Olympic Committees. However, pursuant to Section 8 of the same law, third party rights shall remain unaffected provided they already existed on August 13, 2003.

## 8. Trademarks filed in bad faith, Section 8(2) No. 10 German Trademark Law

Due to an amendment of the law which entered into force on June 1, 2004, the German Patent and Trademark Office examines *ex officio* whether the applicant acted in bad faith at the time of filing the application. However, an application shall only be refused where bad faith is 'obvious' (Section 37(3) Trademark Law). In cases in which there is clear evidence for the existence of a bad faith application, the examiners should not be obliged to register the trademarks knowingly, but be able to refuse the application.

Evidence for obvious bad faith:

- trademark protection is applied for the name of a living or recently deceased, famous person who has no connection whatsoever to the applicant;

Example: BPatG case 24W(pat)036/02 – Lady Di

The application was clearly filed with the intention to interfere with the economic exploitation of the popularity of Diana, Princess of Wales, by the entitled persons or to receive remuneration from these persons. The fact that the application was filed one day after the death of the bearer of the name is a clear indication of the intention to use the trademark as a 'blocking device' due to the higher merchandising value after her death.

- it is known to the office that the sign for which protection is sought is used by a third person, at the time when the application is filed;
- in individual cases the application of known objects of literature or art that have entered the public domain (after the expiry of copyrights). However, additional indications must exist e.g. a conspicuous frequency of such applications by a person.