A new era for trademarks in Germany

An initial assessment from a practitioner's point of view

By Dr. Boris Uphoff

The Trademark Law Modernization Act *(MaMoG)* introduces new types of trademarks and expands protection for trademark owners. The new act has been in force for nearly nine months. This article represents a practitioner's view of the act's advantages and limitations.

Effective January 14, 2019, the *MaMoG* fundamentally reformed German trademark law, aligning it with European standards following the EU Trade Mark Directive 2015/2436. The *MaMoG* contains a reaction to recent technological developments and strengthens the rights of trademark owners within the parallel systems of national trademarks and European Union trademarks. A significant change to section 8 of the German Trademark Act *(MarkenG)* has considerably broadened the range of signs eligible for protection. The reform aims to provide protection for trademarkable content that previously failed to meet the strict standards of "graphical representability." Now, video sequences, characteristic sounds and even scents can be protected (at least theoretically).

The origin of trademarks in the brewing industry

The first German trademarks in today's sense developed with the increasing economic role of the brewing industry. The first German law regarding the protection of trademarks came into force on May 20, 1875, when the first trademark, Meißner Porzellan, was registered. The best-known German trademark still is the Eau de Cologne with its flagship perfume 4711. Other well-known early trademarks are Coca-Cola (1896), Maggie (1897), Dr. Oetker Original Backin' baking powder and Wrigley's (both 1893), as well as the champagne Monopole (1895). The economic upswing in Germany after World War II set the foundation for a fast-growing range of branded products. When well-known brands became increasingly associated with whole product groups and started to serve as synonyms for common products – such as Uhu for glue, Hansaplast for adhesive bandages and Tempo for tissues – the product labels increased in economic value for the trademark owners. A comprehensive protection of trademarks thus became essential.

Trademarks will likely be slightly more diverse in the future; but in most cases, the objects of protection will still be represented graphically.

Until now, the distinctiveness of a trademark that uses a logo to identify a product like a soft drink, a bag of chips or a pair of tennis shoes was assessed according to its graphical represent- →

ability in the media. According to the former wording of section 8 of the *MarkenG*, a trademark's graphical representability was a prerequisite for its protection: "Signs that cannot be represented graphically ... are excluded from registration as protected trademarks." However, as globalization and digitalization accelerated, it became increasingly clear that trademark protection regulations would need to be adjusted to reflect modern communication technologies. The hard and fast concept of a trademark's graphical representability had to be left behind, and a broader definition of the requirements for registration had to be established. The new wording in the *MaMoG* reads: "Signs that cannot be depicted in the [trademark] registry in a way that allows the respective authorities and the public to clearly and unambiguously recognize the subject under protection [...] are excluded from registration as protected trademarks."

Entirely new types of trademarks are now possible

The elimination of the previous requirement of graphical representability is an obvious change under the MaMoG. Not quite as obvious are the new possibilities that have now emerged for businesses. With the elimination of the graphical representability requirement, entirely new types of trademarks are now registrable. This was, after all, the main purpose of the new regulation. Movements, sounds and even video sequences can now be registered as trademarks. However, it is still required that "the object under protection in the trademark registry can be recognized clearly and unambiguously." In the aforementioned examples, this criterion can be met using common data formats for filing the trademark in the electronic trademark registry. The German Patent and Trade Mark Office has published a list of possible types of trademarks that expands beyond the classic categories of words, figurative marks and position marks that the European Court of Justice (ECJ) already mentioned in 2018: pattern marks, motion marks, hologram marks and multimedia marks are just a few examples.

The red sole of the shoe

An interesting case that came before the ECJ, won by fashion designer Christian Louboutin against a competitor in 2018, is a vivid example of the difficult questions concerning possible trademark infringements that pre-existed the reform. Van Haren, a Dutch shoe chain that belongs to the Deichmann Group, had released a shoe that very strongly resembled an exclusive and widely successful Louboutin product. The French designer specializes in high-class shoes with an eye-catching detail: the red sole. Louboutin has managed to establish the red sole of his shoes as a symbol known worldwide. His high heels have become some of the most popular on the market and have secured the Louboutin brand a high level of recognition value. Similar to the cases involving Nivea blue, Langenscheidt yellow and Milka purple, the ECJ acknowledged Louboutin red as a "contourless single-colour mark." However, this does not mean any specific color can be registered as a trademark on its own. Although the ECJ does not explicitly state this, the combination of a specific color located in a certain position will continue to play a crucial role when the court is deciding whether the trademark in question is distinctive enough to be protected. This will not be the case with every color-position combination. In the Louboutin high heels case, the ECJ regards this requirement as fulfilled: "Position marks that define the position of a certain color at a certain position of the object in question are generally registrable," the ECJ states.

With the elimination of the restrictive graphical representability requirement under the new *MaMoG*, it is now possible, for example, to register an advertising jingle as a protected trademark without providing a written sequence of the musical notes used in the jingle. This used to be required under the old law so that the melody could be depicted graphically. However, the change addresses more than just a matter of convenience. As the sequence of musical notes is no longer required, it is now also possible to register sounds as a "sound mark" that would be impossible to depict as a sequence of notes.

For example, a company might use custom-made packaging that generates a sound when opened in order to set its products apart from those made by competitors. Such a trademark would not have been registrable under the old *MarkenG*. But with the new *MaMoG* reform, it is now sufficient to provide an audio file with the desired sound for registration.

However, even the new possibilities under the *MaMoG* have their limits. Even a sound that cannot be captured in musical notes, for example, can be objectivized using a sonogram (a spectrogram that shows the time on the x-axis and the respective frequencies in hertz [Hz] on the y-axis). Registering a taste as a trademark, however, is still problematic. A recipe cannot convey a taste exactly as it →

is perceived by consumers. In that case, how can a taste be depicted permanently and unambiguously? Measurement of a tester's neuronal reaction to a specific taste will not sufficiently distinguish the taste. Filing a registered design or a sample is unlikely to do the job either. Even if it did, how can it be guaranteed that the initially filed taste remains unchanged over the course of the whole period of protection – 10 years or even longer? At this point, the challenge of conserving tastes has not yet been mastered.

Apart from broadening the range of types of trademarks, the *MaMoG* also introduced certification marks, a whole new category of trademark believed to have an important role to play in the future market. Quality seals and eco-labels can now be licensed for companies or products. Certification marks are intended to put an end to the unchecked and illegal use of unregulated quality seals for organic foods and fair-trade products. If a trademark owner guarantees his or her products have certain features (such as the use of certain materials, production methods, services or quality standards), his or her products need to be distinguishable from products without such a guarantee from the manufacturer.

No lengthy and costly proceedings

Another change under the new *MaMoG* concerns opposition procedures in what are known as nullity proceedings before the German Patent and Trade Mark Office. Previously, if a trademark owner appeared not to have used his or her trademark in practice, the options for filing an opposition were limited. Starting May 1, 2020, it will also be possible to justify an opposition with relative grounds for invalidity or the upcoming expiry of a trademark's protection. These new possibilities are intended to shorten proceedings and lower costs, at least in theory. This would be a welcome improvement for trademark owners who need a fast option for checking on their trademark's protection status, as well as for opposing parties who want to avoid lengthy and costly proceedings.

Outlook

It remains to be seen whether the new trademark law will indeed result in fundamental changes regarding the practical application of the *MarkenG*. Trademarks will likely be slightly more diverse in the future, but in most cases, the objects of protection will still be represented graphically.

There are a few reasons for this: First, the ways of delineating an object of protection "clearly and unambiguously" in a legally secure manner are limited. Secondly, graphical representation will, in most cases, be the easiest and most effective way to ensure protection. Thirdly, attorneys will advise that companies use a method proven effective in the past, which equates to graphical representation of the object of protection. It will take years before new methods of representing objects of protection will prove equally safe as graphical representation. It will therefore also take years before public perception of trademarks expands beyond graphically representable objects. ←

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