

German Federal Patent Court: Unitary character of the EU trademark: Yes, but... - OXFORD CLUB

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Bettina Clefsen (b/cl)

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A recent decision of the Federal Patent Court in Germany (Decision of 1 March 2016 on Case 29 W (pat) 33/13) shows that the unitary character of an EU trademark (EUTM) does not necessarily mean that it enjoys the same level of protection in all EU member states. In opposition proceedings in Germany, the Federal Patent Court held that an earlier EUTM registered on the basis of acquired distinctiveness could well enjoy only a low degree of distinctiveness in Germany where the two marks were colliding.

The opponent, Oxford University Press (OUP), could not succeed with its opposition against the German trademark "Oxford Club" based on its earlier EUTM "Oxford" before the German Patent and Trademark Office. The German PTO rejected the opposition although the attacked mark covered goods partially identical or similar to the goods protected by the earlier mark. It argued that the opposing mark "Oxford" enjoyed only a low degree of distinctiveness and extensive use in Germany enhancing the distinctiveness had not been shown. The evidence which the opponent had submitted for proving the enhanced distinctiveness largely related to use of its trade name / trademark "Oxford University Press". The use of

“Oxford” per se as indication of the place of publication was not deemed to qualify as trademark use. Also, the turnover and sales numbers which the opponent relied upon did not distinguish between use of “Oxford” and “Oxford University Press” and, moreover, only related to the UK. Due to the low degree of distinctiveness, the addition of the element “Club” in the attacked mark was held to be sufficient to make the signs dissimilar visually, aurally and conceptually. “Oxford Club” would be perceived as a coherent term and there was no reason to believe that the public would focus solely on the element “Oxford”.

The opponent’s appeal against this decision before the Federal Patent Court was unsuccessful. The Federal Patent Court confirmed that the mark only enjoyed a low degree of distinctiveness. Per se the mark was not distinctive, as “Oxford” is known as a big English university town and a seat for many publishing houses. This is also confirmed by the fact that the opposing EUTM as well as other EUTMs cited by the opponent were only registered based on acquired distinctiveness. Trademarks which are registered due to acquired distinctiveness are generally awarded a normal degree of distinctiveness in German case law. However, in this case the opponent could not show that EUIPO’s decision had been based on evidence which supported extensive use in most of the EU, in particular also in Germany. In the opposition proceedings, the opponent had failed to submit any evidence showing that the trademark “Oxford” had indeed acquired a normal or even high degree of distinctiveness through use in Germany.

Contrary to earlier decisions, the Federal Patent Court decided that the relevant territory for proving that the trademark had acquired an enhanced degree of distinctiveness was not the entire EU, but only the territory where the two marks were colliding; in this case Germany. Although it may be concluded from the decision of the CJEU in “be impulsive / Impulse” (Judgment of 3 September 2015 in Case C-125/14) that for relying on an enhanced distinctiveness / reputation it is sufficient that a commercially significant part of the public is familiar with the mark, an intensive use and level of recognition of the mark only in other EU countries is not sufficient. The Court confirmed that the evidence submitted did not support an enhanced degree of distinctiveness in Germany and, on that basis, confirmed the decision of the PTO.

OUP has taken the matter to the German Supreme Court (BGH) and it is yet to be seen how the BGH decides – so the last word has not been spoken.