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Testarossa - Still a trade mark or just a memory of the fancy 80s?

Oliver Löffel (Löffel Abrar) · Tuesday, August 22nd, 2017

"All I know about you is that you drive a Testarossa and you live on a boat", Christine von Marburg (Melanie Griffith) once said to Sonny Crockett (Don Johnson) in one of the popular TV-series of the 80s: Miami Vice. Testarossa is the name of one of Ferrari's cars. So far the history. On August 2, 2017 [media reported](#) that Miami Vice is getting a reboot and on the same day the Regional Court of Düsseldorf ruled that Ferrari is ordered to consent to the cancellation of its German trade mark registration "Testarossa", No 1158448 ([decision of August 2, 2017, 2a O 166/16](#)). However, Ferrari has neither lost the brand "Testarossa" nor to a German toy company yet, unlike [German](#) and [international media](#) reported incompletely (demonstrating that Litigation-PR can be important in order to avoid such misleading reports).

Ferrari's German trade mark "Testarossa" was registered in 1990 inter alia for *"apparatus for locomotion by land, air or water and components therefor"*. The German entrepreneur Kurt Hesse filed a German and an European Union trade mark application "Testa rossa" for Electric cycles and other products. Ferrari opposed against these trade marks both on the basis of the trade marks "Testarossa" and Mr. Hesse brought a cancellation action before the regional court of Düsseldorf against Ferrari's opposing trade mark "Testarossa". The Düsseldorf court ruled that the trade mark "Testarossa" had not been genuinely used for five years.

First, the court pointed out that the use of a trade mark, if not perceived as an indication of origin, cannot fulfil the genuine use requirements (see para. 31). The court held that the CJEU decisions in [L'Oréal](#), [Google France and Google](#) and [Interflora](#) do not support Ferrari's view that an alternative use in the context of other trade mark functions (such as the communication, investment or advertising function) may suffice to confirm genuine use.

Second, referring to CJEU-Ansul ([para. 40 and 41](#)), the court confirmed that the use of "Testarossa" only for spare parts and in combination with the repair and maintenance of cars and other related services could potentially be considered as genuine use of the contested goods, even if Ferrari does not offer cars any more. However, according to the judge's position, Ferrari has not proved sufficient use of the contested mark for repair and maintenance services and spare parts both in Germany and Switzerland (because of a German-Swiss agreement, a use of a German mark in Switzerland can

potentially be equivalent to use in Germany, see [CJEU-Rivella International](#)).

Third, the use of “Testarossa” for second-hand sports cars does not constitute genuine use for cars as the Testarossa sports cars had already been put on the market by Ferrari. An exhaustion of the rights conferred by the Testarossa mark in relation to certain cars blocks the genuine use of the mark for these cars by subsequent re-sale.

This decision should be a wakeup call for all trade mark owners. As it is in the public interest to keep the trade mark registers free from unused trade marks a non-use cancellation action can be filed by anyone, e.g. a customer who feels mistreated by a company, a competitor or (as in this case) a potential trade mark infringer firing back.

Still, the German Testarossa-case is far from being over yet. Ferrari can appeal the decision. In addition, Ferrari is also owner of the trade mark Testarossa with EU-protection for “automobiles” (IR [0910752](#), with protection for the EU) and it remains to be seen if the EU-extension will be cancelled. Further, there are a lot of tricky legal questions which may arise if a German company uses the name Testarossa e.g. for e-bikes ([as media reported](#)). Irrespective of registered trade mark rights in Germany, Ferrari may rely on the protection of a well-known mark Testarossa in Germany within the meaning of Article 6bis of the Paris Convention. In addition, the use of “Testarossa” for e-bikes could be misleading [within the meaning of Article 6 \(1\) a\) and Article 6 \(2\) a\) Directive 2005/29/EC](#) as “Testarossa” is still be inextricably linked to the name Ferrari, as [German newspaper Handelsblatt](#) rightly pointed out.

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