

# Article names in fashion - indications of origin?

**Kluwer Trademark Blog**

January 16, 2019

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*Please refer to this post as: Bettina Clefsen, 'Article names in fashion - indications of origin?', Kluwer Trademark Blog, January 16 2019, <http://trademarkblog.kluweriplaw.com/2019/01/16/article-names-in-fashion-indications-of-origin/>*

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It is longstanding practice in fashion to designate certain products not only by illegible article numbers, but by names. Many times male or female personal names are chosen. When there is a broad range of products, many names are needed by a fashion company. Many times these will not be needed for a long

time, as fashion changes quickly. Will those all have to be cleared and secured by trademark rights?

The answer for Germany is still yes. A recent decision by the Higher Regional Court Frankfurt confirmed that the public regards article names for fashion products not simply as means of individualizing certain products, but as indications of origin (Decision of 7 June 2018 in Case 6 U 94/17).

In the case before the Higher Regional Court Frankfurt, the defendant promoted its products online and used in the heading of its online offer the product designation "X female trousers MO" with X being (a placeholder for) its own trademark. The claimant is owner of the German trademark "MO" registered for female outer wear and trousers.

The Court found trademark infringement based on double identity. It initially confirmed that the sign "MO" was regarded as secondary brand next to the defendant's trademark "X", as the public is used to secondary brands being used side-by-side to main brands. The public would therefore perceive "MO" as the name of the trousers' model and "X" as the umbrella brand or company name.

The defendant argued that regardless of identity, there was no trademark infringement, as the public would not perceive "MO" in the attacked product designation as an indication of origin. It would rather take the sign "MO" only as an order reference or mere internal model designation. The Court pointed out that "MO" was already used in the product designation, and not only when it came to ordering the product. In addition, "MO" was not needed in the ordering process; for ordering, the customer only needed to click "add to my basket". In addition, a model number is indicated in the article description. Even the customer who does not order directly would not put down the name "MO" for ordering, but rather the model number. Also, in the invoice for a test purchase which was submitted in the proceedings, it reads "X female trousers MO walnut marl", followed in the line below by the article number.

Further appeal was not admitted, but a complaint against this decision has already been filed with the Federal Supreme Court (Court reference I ZR 108/18). This is not likely to be successful, as most Regional or Higher Regional Courts decisions in Germany confirm trademark infringement under similar circumstances. Only the Regional Court Düsseldorf held in a very detailed decision of 20 December 2017 in

Case 2a O 248/16 that no trademark infringement was given where the sign “SAM” was used as indication of a trousers model which was promoted online as “ALBERTO Slim Fit Trousers SAM”. The Court held in this case – where it was demonstrated that the claimant in this matter used a large number of different first names as model designations for its fashion products – that the claimant’s mark “SAM” was not used as a trademark. The Court held that under the particular circumstances of the case and under consideration of the customary use of first names in catalogues, price lists and decorations as mere product designations in the fashion industry, the public would not perceive the sign “SAM” as a trademark. It has to be added that the model name “SAM” was not used in the heading of the advertising, but merely as part of the article description.

For the time being, we can only recommend clearing model names in fashion prior to use in Germany (and presumably elsewhere in the EU).