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## Germany: Weak trademarks and their enforcement

Bettina Clefsen (b/cl IP) · Friday, April 12th, 2019

The question of how far descriptive or non-distinctive trademarks which somehow managed to be registered may be enforced is of particular relevance in jurisdictions like Germany which acknowledge their incontestability ten years after registration.

The more recent approach of the European Court of Justice (ECJ) was that it accepted likelihood of confusion also in a number of cases where the similarity of marks was only caused by very weak elements (see for instance decisions of the [ECJ of 8 November 2016 in Case C-43/15 P - KOMPRESSOR](#) - or of [19 November 2015 in Case C-190/15 P - Solid-Floor / SOLID Floor](#)).

In a recent decision the Federal Patent Court deviated from this case law of the ECJ, granting a more limited enforcement to weak marks in Germany ([Decision of the Federal Patent Court of 1 March 2019 on Case 28\(W\) pat 29/16](#)).

The Federal Patent Court had to decide on an appeal relating to an opposition based on the German trademark registration and the International Registration **“INJEKT”** registered in Class 10 and used for medical injections against the German trademark registration **“INJEX”** for needleless injections systems and apparatus in Class 10. The German trademark had been registered for more than 10 years at the time of the opposition proceedings.

The German Patent and Trademark Office had rejected the opposition due to lack of likelihood of confusion. As the use requirement was still no issue in the proceedings before the Office, it confirmed identity between the goods for which the opposing marks were registered, namely “surgical, medical, dental and veterinary instruments, apparatus and utensils” and the various needleless injections systems and apparatus and accessories protected by the opposed trademark. However, the Office concluded that the very low degree of distinctiveness of the earlier INJEKT-marks and the distinct ways both signs differed from the merely descriptive English term “inject” made them sufficiently dissimilar.

The opponent appealed this decision arguing that there was likelihood of confusion when correctly considering the enhanced distinctiveness of the opposing marks due to their extensive use in Germany in relation to disposable syringes as well as the identity of goods and the high degree of similarity between the signs. It added that according to the ECJ case law, also the coincidence in descriptive elements could

result in likelihood of confusion.

The Federal Patent Court confirmed that the opposing marks possessed per se a very low degree of distinctiveness. It confirmed – following a request for proof of use – genuine use of the opposing marks for “medical syringes” and on the basis of the evidence provided by the opponent, even accepted that the distinctiveness of the opposing mark was moved to a medium degree. However, in spite of the only small differences between the signs, the Court only considered the marks to be remotely similar visually and aurally and confirmed that these differences excluded a likelihood of confusion. It underlined that when comparing signs which are close to descriptive terms, in particular those elements had to be considered which were differing from the descriptive term. It should be open for competitors to get close to descriptive signs in different ways. The use of the ‘X’ at the end of the opposed mark was according to the Court sufficiently different from the opposing marks which simply exchanged the letter ‘C’ in the descriptive term “inject” with the letter ‘K’.

The Court confirmed that with this decision it deviated from the case law of the ECJ, as expressed in the [decision of 8 November 2016 in Case C-43/15 P - KOMPRESSOR](#). The ECJ held in this decision that the distinctive character of an earlier mark was only one factor among others to be taken into account when assessing likelihood of confusion and that likelihood of confusion could not be precluded where the distinctive character of the earlier mark was weak.

The Federal Patent Court does not support this line of argument. According to its view, the comparison of signs without any normative rectification leads to a privilege of weak marks which is incompatible with absolute grounds for refusal. This cannot necessarily be avoided by means of invalidity proceedings based on absolute grounds for refusal, in particular not in cases where the marks have become incontestable (as may be the case under German law), or were the marks have a minimum degree of distinctiveness.

The Court therefore allowed the further appeal to the Federal Supreme Court which will in case of an appeal likely consider a reference for a preliminary ruling to the ECJ.

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