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Celebrity Names in Class 16

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With decision of 25th February 2019, the German Federal Patent Court (*Bundespatentgericht*) has ruled on the registrability of a celebrity name for inter alia publications in class 16. The Bundespatentgericht is the appeals court for decisions of the German Patent and Trademark Office (DPMA).

Franziska van Almsick, one of the most successful swimmers of recent times, applied for the registration of her name "Franziska van Almsick" as a word mark for several goods and services with publications in class 16 among them.

Rejection by DPMA

The DPMA rejected the application for goods and services in classes 9, 16 and 41. According to the DPMA, the name is devoid of distinctiveness. A name lacks distinctiveness not only if it is a description of certain goods such as "Diesel" for engines or "Röntgen" for imaging machines. A name can also lack distinctiveness if it is used for goods or services which convey certain intellectual content, such as publications. The public connects the name of a well-known person not only with the person him/herself, but also with their biography and success. In such cases, the name is not suited as a sign of origin. For goods like publications, names of well-known persons are most likely to be perceived as a title describing their contents.

Reversal by Bundespatentgericht

The Bundespatentgericht has reversed the DPMA's decision and has admitted the registration of FRANZISKA VAN ALMSICK for classes 9, 16 and 41. According to the Bundespatentgericht, names are, in general, prototypical marks. They lack distinctiveness, only if there is a sufficiently immediate and specific connection to the goods or services or their features. The Bundespatentgericht refers to the jurisprudence upon which the DPMA relied, whereby, in the eyes of the public, names of celebrities are connected with their biography and their success and, thus, can serve to describe the contents of publications or similar media. In its decision, the Bundespatentgericht declares this jurisprudence to be incorrect:

Focus: Customary Position of Trademarks on Publications

The Bundespatentgericht's central point is that distinctiveness largely depends on how and where trademarks are usually used in the relevant market. This shapes the way the public perceives trademarks. If a sign is affixed on goods in a position customary for trademarks, there is a stronger

assumption that the consumer will perceive the sign as a trademark than if the sign is affixed in a non-customary position. In that respect, the Bundespatentgericht refers to the jurisprudence of the Federal Supreme Court (BGH), whereby a sign, in order to be registrable, does not have to be perceived as a trademark in any possible situation. It is sufficient if there are practically relevant ways of use perceived as trademark use by the public (see the recent ECJ reference by the BGH in the #darferdas case). Under that premise, the Bundespatentgericht establishes the following customary practices regarding books and magazines:

The title and the names of the author and the publisher are usually affixed at certain positions. The public concludes from that position, whether something is the title, the author or the publisher. The author's name and the title are usually highlighted graphically and are found in the upper two-thirds of a cover. The publisher's name, i.e. the actual sign of origin, is almost always featured in small-print at the lower margin. If the public is used to these customs, it will necessarily perceive the sign at the lower margin of a cover as a sign of origin, while the signs featured above are perceived as title and author and not as a sign of commercial origin. Because of this perception, shaped by customary practice, the trademark owner cannot forbid the use of a registered name as a title, again because that use is not considered as trademark use by the public.

Reality Finds Its Way into Trademark Law

The Bundespatentgericht's decision marks another shift from the traditional, abstract approach to registrability to an approach which recognises the circumstances of markets. One might say that reality finds its way into trademark law. The growing relevance of market circumstances raises procedural questions, especially whether and to what extent the DPMA or the Bundespatentgericht can make findings about market circumstances simply based on their own knowledge or assumptions and how the applicant can challenge these findings, should they lead to the applicant's disadvantage.

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