

Kluwer Trademark Blog

The German Federal Patent Court on a word mark's genuine use: When a monster is deprived of its claws

Kristina Wagner (Harmsen Utescher) · Wednesday, September 25th, 2024



In its decision of 23 August 2024, the German Federal Patent Court ruled, *inter alia*, on the question whether a word mark is put into genuine use when it is used as part of a logo and displayed in a unique font (case no. 30 W (pat) 78/21).


What happened? The opponent invoked, *inter alia*, its word mark “MONSTER” registered as an EU trademark for a variety of non-alcoholic beverages in class 32 against protection in Germany of IR 1 352 854 **MONSTER** for goods in class 9. The German PTO partially upheld the opposition based on the reputation of the trademark “MONSTER” for energy drinks. The applicant appealed and invoked the non-use defence also with respect to the non-alcoholic beverages in class 32 (which it had not done in the first instance; in German opposition proceedings, this can be done on appeal). The opponent furnished comprehensive materials showing use of “MONSTER” for energy drinks as shown above.

Not only did the Federal Patent Court consider that the stylized representation of the word MONSTER on the cans was not (identical) use of the word mark as such, it even considered that the stylization altered the distinctive character of the word mark, concluding that the use as shown


did not constitute use of the word mark at all:

a. First, the Federal Patent court deemed it likely that the public would perceive the claw-element



together with the -element as one designation only. Even though the claw-element is not pronounced, but rather visualizes the word element “MONSTER”, or emphasizes its first letter “M”, this combined sign should *massively influence* the word mark’s distinctive character, attributing a “ghost train image” to the mark.

b. But even irrespective of the claw-element, the Federal Patent Court did not consider that use of

the stylized word element  constituted use of the word mark “MONSTER”. While a different *standard font* would *usually* have been acceptable, the particular font, was held to be striking and to attribute a unique character to the mark due to its rune-like appearance. This was said to apply in particular to the letter “O” which is not immediately identifiable as a letter due to its vertical line but appears like a fantasy sign.

Even though it may be true that the particular font adds a layer of a unique characteristic to the logo, the Federal Patent Court’s conclusion, namely the alteration of the distinctive character of the word mark “MONSTER”, is firstly surprising and secondly raises questions as regards the nature and subject-matter of word marks.

The latter becomes apparent in the Court’s notion that, in general, a depiction of the mark in a different *standard font* would not have altered the mark’s distinctive character. This suggests that the Court perceives a word mark comparable with a complex mark, namely that the registered font forms part of the mark. If this were true, it would be unclear what differentiates the subject-matter of a word mark from a complex mark (e.g. a logo or a figurative mark consisting of a stylized word).

In addition to this rather dogmatic question, companies will face the challenge how to protect a word sign as such. Realistically, designations are most commonly embedded in graphical logos. If that does not constitute use of a word mark, probably 99% of all registered word marks are vulnerable to non-use cancellation – also because use of the word as a part of promotional text or within a domain name may not be considered to be trademark use. However, the mere fact that most word marks are used within a graphical logo cannot call into question that there is a legitimate interest in seeking protection for word marks as such, amongst others, to protect the often only pronounceable element of a logo. Considering these far-reaching consequences for word marks, fingers crossed that this decision will remain limited to its specifics so that this ‘monster’ is kept in its cage.

To make sure you do not miss out on regular updates from the Kluwer Trademark Blog, please [subscribe here](#).

Kluwer IP Law

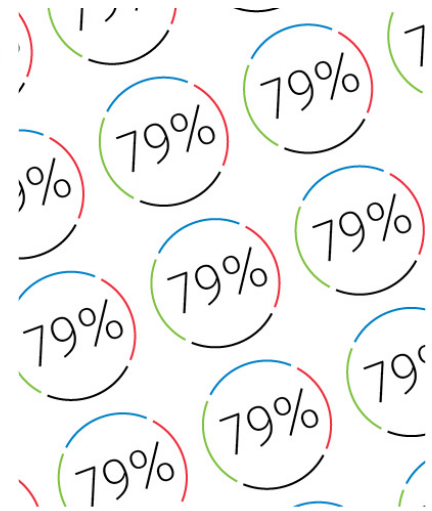
The **2022 Future Ready Lawyer survey** showed that 79% of lawyers think that the importance of legal technology will increase for next year. With Kluwer IP Law you can navigate the increasingly global practice of IP law with specialized, local and cross-border information and tools from every preferred location. Are you, as an IP professional, ready for the future?

Learn how **Kluwer IP Law** can support you.

79% of the lawyers think that the importance of legal technology will increase for next year.

Drive change with Kluwer IP Law.

The master resource for Intellectual Property rights and registration.



2022 SURVEY REPORT
The Wolters Kluwer Future Ready Lawyer
Leading change

This entry was posted on Wednesday, September 25th, 2024 at 8:39 am and is filed under [Case law](#), [A trade mark is considered to be used when it is used in the course of trade to indicate the origin of goods and services. There are various criteria determining whether use will be considered genuine use or not.](#)>Genuine use, Germany, Non Use

You can follow any responses to this entry through the [Comments \(RSS\)](#) feed. You can leave a response, or [trackback](#) from your own site.