Trademark Piracy

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Imitating successful distinguishing marks of others has reached unparalleled levels in the past twenty years and is threatening to increase even further given growing brand awareness and the increasing appreciation of logos by customers. Trademark protected products are gaining more and more importance as objects of prestige, but are frequently not affordable for everyone. It is therefore not surprising that the overwhelming majority of the products confiscated by customs authorities every year involve counterfeit brand-name products.[1] In 2007, the majority of articles seized by customs across Europe (92%) infringed a Community or national trademark and covered a wide variety across all product sectors.[2] The largest category of goods seized at the German border in 2007 was leisure wear (20.96%), in addition to accessories (e. g. purses) (12.81% of the total goods that were seized) as well as watches and jewelry (15.23%). In terms of value, accessories were in the lead by far in 2007 with a total value of EUR 108,745,884, no less than EUR 391,589,061 in 2006, followed by sportswear (EUR 73,380,344 in 2007 and EUR 218,238,594 in 2006), then watches and jewelry (EUR 287,850,703 in 2006) and shoes (EUR 67,057,647 in 2007).[3] In 2006, the total value of trademark-infringing products seized in Germany came up to EUR 1,175,018,615.[4]

Trademark piracy may be defined as offering cheap goods which are copies of original products using an identical label with the consumers being aware of the piracy offence or at least accepting that such products may infringe trademark rights or, in other words, trademark piracy does not dependently require consumer belief that a product labeled

1 87% of the products that were seized at external German borders overall involved trademark infringements according to the 2007 annual statistics of the customs office, available at http://www.zoll.de/e0_downloads/f0_dont_show/zgr_jahresstatistik_2007.pdf.; no less than 90% of the products seized by the customs office in 2006 involved trademark infringements.

2 Information in accordance with the Report on Community Customs Activities on Counterfeit and Piracy, available at http://ec.europa.eu/taxation_customs/resources/documents/customs/customs_controls/counterfeit_piracy/statistics2007.pdf.

3 Information in accordance with the 2007 annual statistics of the customs office, available at http://www.zoll.de/e0_downloads/f0_dont_show/zgr_jahresstatistik_2007.pdf, and the *Jahresbericht 2006 Gewerblicher Rechtsschutz des Bundesministerium der Finanzen* [2006 Annual Report on Commercial Legal Protection of the Federal Ministry of Finances], available at http://www.zoll.de/e0_downloads/d0_veroeffentlichungen/v4_gwr_jahresbericht_2006.pdf.

4 Information in accordance with the *Jahresbericht 2006 Gewerblicher Rechtsschutz des Bundesministerium der Finanzen* [2006 Annual Report on Commercial Legal Protection of the Federal Ministry of Finances], available at http://www.zoll.de/e0_downloads/d0_veroeffentlichungen/v4_gwr_jahresbericht_2006.pdf.

with a brand actually comes from the trademark owner.[5] The risk associated with trademark piracy is a damage to the brand image, combined with a loss of market share and a discreditation of the quality statements associated with the brand.[6]

Strong awareness among companies of the need to develop strategies at a very early stage to protect their trademark rights and to also actually implement these has therefore gained importance.

I. Legal Requirements for Trademark Protection under the German Trademark Act

A. Scope of Protection

In Germany, the protection of trademarks, business designations and indications of geographic origin is governed by the Markengesetz [MarkenG] [Trademark Act] (F. R.G.) which summarises them under the generic term of "marks".[7] In addition to corporate trademarks, titles of works are also considered business designations.

Section 3 MarkenG [Trademark Act] sets out the basic requirements for trademarks. It is essential for the mark to be capable of distinguishing goods or services of different companies from one another. Trademarks enable customers to distinguish products of a certain company from those of other companies. Further to the origin-related function of trademarks, a quality function is also attached to a trademark. Frequently, consumers associate certain quality expectations with a trademark. The latter constitutes a particular incentive for product pirates who attempt to exploit for themselves the good reputation of a trademark for their own purposes by deceiving consumers, i. e. they make them think the product comes from a certain – frequently prestigious – company by using identical or similar marks.

In general, any symbols, especially words including the names of persons, illustrations, letters, numbers, sound marks, three-dimensional structures including the form of a product or its packaging, as well as other presentations including colours or colour combinations, can be protected as trademarks. Only signs which consist exclusively of a shape (i) which results from the nature of the goods themselves; (ii) which is necessary to obtain a technical result; or (iii) which gives substantial value to the good are not capable of being protected as trademarks.[8]

5 *Fezer*, Markenrecht, § 14, No. 75.

6 *Fezer*, Markenrecht, § 14, No. 72.

7 MarkenG [Trademark Act] § 1 (F. R.G.).

8 MarkenG [Trademark Act] § 3 ¶ 2 (F. R.G.).

1. Trademarks

a. Words, Slogans and Letters

Words are capable of being protected as trademarks, to start with, according to the MarkenG [Trademark Act], regardless of whether German words, foreign words or purely made-up or fanciful words are involved, provided they are distinctive overall for some product or service.[9] As an example, the word "auto" may be distinctive for a product that has nothing to do with motor vehicles,[10] but it would not be capable of protection for motor vehicles.

Furthermore, entire sentences are also capable of being protected as trademarks. That is why advertising slogans are increasingly being protected as trademarks (e. g. *Partner with the Best*).[11] Whether the advertising slogan merely describes the product or whether it is distinctive (even only slightly) is decisive in determining if the slogan can be protected.[12] A lack of distinctiveness is assumed in the case of longer texts, for example.[13] The ability of so-called event marks to be protected is also largely rejected if they merely consist of a description of the event, for instance the designation "*FUSSBALL WM 2006*" [2006 SOCCER WORLD CUP], or of services associated with the event. This is owed to the need to keep purely functional information of that type available for public use.[14]

Letters are capable of serving as trademarks as a general principle, both in the form of individual letters[15] and in the form of a combination of letters,[16] regardless of whether they can be pronounced or not. However, a lower level of distinctiveness, and therefore a lesser degree of protection, may result depending on the design in individual cases.

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9 *Ingerl/Rohnke*, Markengesetz, § 3, No. 26.

10 *Ingerl/Rohnke*, Markengesetz, § 3, No. 26.

11 8 December 1999 BGH [Federal Supreme Court] [I ZB 21/97], MarkenR 2000, 50 (Partner with the Best); 8 December 1999 BGH [Federal Supreme Court] [1 ZB 2/97], GRUR 2000, 321, 322 (Radio von hier); also see 10 February 2000 BGH [Federal Supreme Court] [I ZB 37/97], GRUR 2000, 720, 721 f. (Unter Uns).

12 21 October 2004 ECJ [C-64/02 P], GRUR Int 2005, 224, 226 (The Principle of Convenience); *Fuchs-Wissmann*, Neuere Entwicklungen in der markenrechtlichen Rechtsprechung des Bundespatentgerichts und des Bundesgerichtshofs, MarkenR 2008, 1, 5.

13 *Ingerl/Rohnke*, Markengesetz, § 3, No. 26.

14 27 April 2006 BGH [Federal Supreme Court] [I ZB 96/05], GRUR 2006, 850, 853 (FUSSBALL WM 2006).

15 15 June 2000 BGH [Federal Supreme Court] [1 ZB 4/98], GRUR 2001, 161 (Buchstabe K); 19 December 2002 BGH [Federal Supreme Court] [I ZB 21/00], GRUR 2003, 343, 344 (Buchstabe Z); 8 December 2006 OHIM [R 394/2006-I], GRUR 2007, 429 (Buchstabe E).

16 5 October 2000 BGH [Federal Supreme Court] [I ZR 166/98], GRUR 2001, 344, 345 (DB Immobilienfonds).

b. Numbers

Numbers and number combinations, like letters, may also be protected as a general rule.[17] The German Federal Supreme Court *(Bundesgerichtshof)* has even regarded single-digit numbers as protectable.[18]

c. Names of Persons

Names of persons may further be protected as trademarks. There is a danger when registering a name as a trademark, though, that a person with that name will require cancellation of the trademark due to his or her own name rights.[19] A final decision has not yet been rendered in German case law as to whether so-called everyday names should be rejected as marks.[20] This risk of rejection can be prevented by adding the first name to a last name, provided that the first name itself is not also very common.

d. Illustrations

Illustrations of all types may be protected as trademarks, regardless of whether they are black and white or coloured.[21] Pictures, logos and lettering of all types can be protected, especially in a combination as a word mark/picture (device) mark. Having a trademark registered in black and white also bears the advantage that it is protected against any reproduction in colour.

e. Sound Marks

Sound marks can consist of melodies or other sounds or noises.[22] As an example, protecting a jingle of a company used for advertising purposes is not only possible but also very popular.[23] The authorisation of sound and noise marks was confirmed by the ECJ (European Court of Justice)[24] and the OHIM (Office of Harmonization for the Internal

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17 9 February 1995 BGH [Federal Supreme Court] [I ZB 21/92], GRUR 1997, 366, 367 (quattro II); 20 October 1999 BGH [Federal Supreme Court] [I ZR 110/97], GRUR 2000, 608, 610 (ARD-1); 18 April 2002 BGH [Federal Supreme Court] [I ZB 23/99], GRUR 2002, 970, 971 (Zahl „1").

18 18 April 2002 BGH [Federal Supreme Court] [I ZB 22/99], GRUR 2002, 970, 971 (Zahl „1"); 18 April 2002 BGH [Federal Supreme Court] [I ZB 22/99], MittdPA 2002, 423, 424 (Zahl „6").

19 MarkenG [Trademark Act], § 13 ¶ 2 No. 1 in combination with § 51 ¶ 1 (F.R.G.).

20 On this note: *Erdmann/Rohjahn/Sosnitza*, Handbuch des Fachanwalts Gewerblicher Rechtsschutz, chapter 5. B. No. 583; different view: *Ingerl/Rohnke*, Markengesetz, § 5, No. 37.

21 Cf. e. g. 5 April 2001 BGH [Federal Supreme Court] [I ZR 168/98], GRUR 2002, 171, 175 (Marlboro-Dach); *Lange*, Marken- und Kennzeichenrecht, § 3, No. 259.

22 *Lewalter*, Akustische Marken – Anmerkung zu EuGH "Shield Mark/Kist" und HABM "Roar of a Lion" und "HEXAL", GRUR 2006, 546.

23 Cf. e. g. 10 July 1996 BPatG [Federal Patent Court] [29 W (pat) 68/96], GRUR 1997, 60 (SWF-3-Nachrichten).

Market).[25] It can be inferred from the registration practice of the OHIM that different requirements apply depending on the national background against which a registration of a sound mark is applied for.[26] There is agreement, though, that the reproduction of the sound on CD, DVD, cassette, disk or MP3 can be included when applying for the registration of the relevant mark.[27]

Sound marks must be protectable in the abstract as well as distinctive. Furthermore, they have to be capable of being graphically portrayed (sec. 8, para. 1 MarkenG [Trademark Act]). Section 11, para. 2 Markenverordnung [MarkenVO] [Trademark Regulation] (F. R.G.)[28] specifies that the graphic presentation must be provided in the customary musical notation after the ECJ found that the graphic presentation could be provided with the aid of figures, lines or characters if it was clear, unambiguous, easily accessible and understandable.[29] Since then the German Patent and Trademark Office no longer accepts that sound marks be presented by means of a sonogram. Thus, the ability to register sound marks of a non-musical nature, such as noises in particular, could be problematic (e. g. the roaring of a lion or a whooshing waterfall). The only way to obtain protection of sound marks that cannot be described by using the customary musical notation may be via acquiring secondary meaning *(Verkehrsgeltung)*. See comprehensive information on trademarks having acquired secondary meaning under I. B. 2.

f. Three-Dimensional Structures

Three-dimensional structures are likewise capable of being protected. Both the form of a product[30] or its packaging[31] and imaginary forms are capable of being protected ("Emily", for instance, Rolls Royce's famous hood ornament). An exception applies to symbols with a shape that is exclusively determined by the type of product itself (cf. sec. 3, para. 2, No. 1 MarkenG [Trademark Act]), symbols having a shape that is necessary to achieve a technical effect (cf. sec. 3, para. 2, No. 2 MarkenG) [Trademark Act] or symbols which consist exclusively of a shape which gives substantial value to the goods (cf. sec. 3, para. 2, No. 2 MarkenG) [Trademark Act]. According to sec. 9, para. 2 MarkenVO [Trademark Regulation], a two-dimensional illustration of the symbol of either pho-

24 27 November 2003 ECJ [C-283/01], GRUR 2004, 54 f. (Shield Mark/Kist).

25 25 August 2003 HABM [OHIM] [R 781/1999-4], GRUR 2003, 1054 (Roar of a Lion); 8 Sepember 2005 HABM, [OHIM] [R 295/05-4] GRUR 2006, 343 (Arzneimittel Ihres Vertrauens).

26 Representative *Schmitz*, Zur grafischen Darstellbarkeit von Hörmarken: EuGH contra Freiheit des markenrechtlichen Schutzes?, GRUR 2007, 290, 291 f.

27 *Becker*, Kennzeichenschutz der Hörmarke, WRP 2000, 56, 57; *Schmitz*, Zur grafischen Darstellbarkeit von Hörmarken: EuGH contra Freiheit des markenrechtlichen Schutzes?, GRUR 2007, 290, 291.

28 Regulation of May 11, 2004 to implement the German Trademark Act.

29 27 November 2003 ECJ [C-283/01], GRUR 2004, 54, 58 (Shield Mark/Kist).

30 8 April 2003 ECJ [C-53/01 to C-55/01], GRUR 2003, 514, 517 (Linde/Winward/Rado).

31 cf. 12 February 2004 ECJ [C-218/01], GRUR 2004, 428, 430 (Henkel); *Lange*, Marken- und Kennzeichenrecht, § 3, No. 263.

tographs or graphical line drawings must be included when registering three-dimensional trademarks. Considering the ECJ decision in *Philips Remington*[32] it must be stated, however, that German case law in general increasingly rejects technical forms according to sec. 3, para. 2 MarkenG [Trademark Act]. The reason for this is that it should not be possible to circumvent the maximum period of protection for technical property rights such as patents and utility models by having a three-dimensional trademark registered.

g. Colour Marks

Colour combinations without contours are not capable of trademark protection in the abstract. Protection for a colour combination requires submission of a description of the specific usage, i. e., how the colour appears in combination with the product.[33] In addition, the colour combination must be suitable for distinguishing products or services of the registrant from those of other companies. Trademark protection may also be requested for a more general colour category, provided there is no absolute block to protection, i. e., the colour category does not have to be kept available for public use.[34]

h. Other Presentations

"Presentation" *(Aufmachung)* is understood to mean any other product accessories, e. g. individual, recurring design elements in business stationary or the presentation/design of business premises (in most cases a shop).[35] So-called position marks (i. e., protection for a specific method of attaching or arranging a symbol on a product) are also covered by this category.[36]

i. Scent Marks

Scent marks may be protected, again, provided that they are distinctive.[37] Scent marks are not readily amenable to graphic presentation. Whereas the ECJ presumes that a scent mark described by the words "*odeur de fraise mure*" (scent of a ripe strawberry) is

32 18 June 2002 ECJ [C-299/99], GRUR Int 2002, 842 (Philips ./. Remington).

33 24 June 2004 ECJ [C-49/02], GRUR 2004, 858, 859 (Heidelberger Bauchemie GmbH); 5 October 2006 BGH [Federal Supreme Court] [I ZB 86/05], GRUR 2007, 55, 56 (Farbmarke gelb/grün II).

34 10 December 1998 BGH [Federal Supreme Court] [I ZB 20/98], GRUR 1999, 491 (Farbmarke gelb/schwarz); 19 September 2001 BGH [Federal Supreme Court] [I ZB 3/99], GRUR 2002, 427, 429 (Farbmarke gelb/grün).

35 *Ingerl/Rohnke*, Markengesetz, § 3, No. 35.

36 *Fezer*, Markenrecht, § 3, No. 294a.

37 12 December 2002 ECJ [C-273/00], GRUR 2003, 145, 147 (Sieckmann Smell Mark); 27 October 2005 ECJ [T-305/04], GRUR 2006, 327, 328 (Scent of a Ripe Strawberry); order to refer the case to another authority/court 14 April 2000 BPatG [Federal Patent Court] [33 W (pat) 193/99], GRUR 2000, 1044, 1046 (Riechmarke).

prohibited by the absolute registration block of Art. 7, para. 1 lit. a) of the Community Trademark Regulation (Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community trademark) precisely because there is no graphic portrayal in the sense of Art. 4 of the Community Trademark Regulation,[38] the OHIM assumes that pure descriptions of scents may be sufficiently capable of graphical representation.[39] The practice of the OHIM will most likely be discontinued due to the ECJ ruling, however.

j. Other Forms

All other conceivable trademark forms such as touch marks,[40] taste marks and movement marks[41] are also permissible based on the non-exhaustive nature of sec. 3 MarkenG [Trademark Act].

2. Company Symbols

Company symbols are protected as business designations *(geschäftliche Bezeichnungen)* in accordance with sec. 5, para. 1 MarkenG [Trademark Act]. According to sec. 5, para. 2 MarkenG [Trademark Act], company symbols are symbols that are used as a name, company name or special designation of a business operation or enterprise in business relations. Provided that secondary meaning has been acquired, business signs and other symbols intended to distinguish a business enterprise from other business enterprises may be included.[42]

3. Titles of Work

Section 5, para. 3 MarkenG [Trademark Act] includes the names or special designations of documents, films, sound works, stage works or other comparable works among the titles of works that are likewise protected as business designations. Since the content of a creative work is frequently described by short and pithy titles that often have a descriptive character,[43] title protection may also be permissible in cases where trade-

38 27 October 2005 ECJ [T-305/04], GRUR 2006, 327, 328 (Scent of a Ripe Strawberry).

39 For instance according to 5 December 2001 OHIM [R 711/1999-3], GRUR 2002, 348 (The Scent of Raspberries); 11 February 2002 OHIM [R 156/1998-2], IIC 1999, 308, 309 (The Smell of Fresh Cut Grass).

40 5 October 2006 BGH [Federal Supreme Court] [I ZB 76/05], GRUR 2007, 148, 149 f. (Tastmarke).

41 With regard to the question of a movement mark, see 25 November 1999 OLG [Higher Regional Court] Frankfurt am Main [6 U 189/98], GRUR 2000, 1063, 1066 (SPEE-Fuchs) (answered in the negative there).

42 *Harte-Bavendamm*, Handbuch der Markenpiraterie in Europa, § 5, No. 26 under the reference to logos, advertising slogans or "corporate colors" of a company; for further details on secondary meaning cf. below under I. B. 2.

43 9 September 2004 OLG [Higher Regional Court] München [29 U 3870/03], MarkenR 2005, 149, 151 (Focus Money/Mon€y Spezialist).

mark registration would not be available.[44] Another example that is significant in practice – and also specifically a target of trademark pirates – involves the names of computer programs.[45]

4. Indications of Geographic Origin

In addition to classically pirated goods, food is increasingly targeted by counterfeiters, too. Whereas food with a value of around EUR 80,000 was seized by the German customs office in 2004, food confiscated by the customs office in 2006 already had a total value of EUR 305,928.[46]

According to sec. 126, para. 1 MarkenG [Trademark Act], the names of places, areas, regions, states and other information or symbols that are used in commerce to identify the geographic origin of goods or services, and food in particular, are protected within the general category of "indications of geographic origin" *(Geographische Herkunfsangaben)*. Examples of indications of geographic origin are Baden wine, Thüringer grilled sausage, Spreewälder pickles, Lübeck marzipan, French cognac or champagne. Only purely generic descriptions are excluded from this protection. Names or symbols that contain indications of the geographic origin or that are derived from indications of that type, but have lost their original meaning and serve as a name for goods or services or as designations or indications regarding the type, composition, grade or other characteristics or features of goods or services, are excluded.

Section 127 MarkenG [Trademark Act] differentiates between simple and qualified origin indications. Section 127, para. 1 MarkenG [Trademark Act] protects the market's expectations regarding an origin from a certain geographic area without considering any quality associations with the area. Section 127, para. 2 MarkenG [Trademark Act], in contrast, governs qualified indications of geographic origin. Here, it is intended that indications of geographic origin with special characteristics or special quality will only be permitted if the relevant goods or services actually show such special characteristics or quality. Thus, market expectations of a special quality for products originating from a particular geographic area are protected. Finally, cases where an indication of geographic origin has a special reputation, with the consequence that the indication may not be used for goods or services of a different origin, are covered by sec. 127, para. 3 MarkenG [Trademark Act] (aspect of the exploitation of the reputation of such goods).[47]

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44 *Ingerl/Rohnke*, Markengesetz, § 5, No. 88 with a reference to 7 May 1997 BPatG [Federal Patent Court] [29 W (pat) 122/96], BPatGE 38, 138 (Klassentreffen).

45 24 April 1997 BGH [Federal Supreme Court] [I ZR 44/95], GRUR 1998, 155 ff (PowerPoint); 24 April 1997 BGH [Federal Supreme Court] [I ZR 233/94], GRUR 1997, 902 ff. (FTOS); Cf. 27 April 2006 BGH [Federal Supreme Court] [I ZR 109/03], GRUR 2006, 594, 595 (SmartKey).

46 2007 Annual Statistics of the Customs Office, available at http://www.zoll.de/e0_downloads/f0_dont_show/zgr_jahresstatistik_2007.pdf.

47 17 January 2002 BGH [Federal Supreme Court] [I ZR 290/99], GRUR 2002, 426, 427 (Champagner bekommen, Sekt bezahlen).

Details on the protection of indications of geographic origin on a European level are also set out in Regulation (EC) 510/2006 (Council Regulation (EC) No 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs).[48] Whereas Regulation (EC) 510/2006 prevails over the national regulations in the case of qualified origin indications, protection according to national trademark law governs cases of simple indications of geographic origin.[49]

B. Creation of Trademark Protection

In addition to the registration of a trademark, trademark protection can also be created by acquiring secondary meaning *(Verkehrsgeltung)*. Furthermore, famous trademarks are protected in a quite different way.

1. Registration

There are three different systems for registering trademark rights: National trademark registrations, Community trademark (CTM) registrations (also referred to as EU trademarks) and international trademark registrations (IR trademarks). Applications for trademark registrations have to be filed with the German Patent and Trademark Office (DPMA) for German trademarks and IR trademarks (which are then registered with the WIPO (World Intellectual Property Organization) in Geneva) and with the OHIM (Office of Harmonization for the Internal Market) in Alicante (Spain) for EU trademarks.[50] An application is only rejected if absolute registration bars apply.[51] Otherwise, the trademark is registered and published in the trademark gazette of the respective trademark office. Once the trademark registration (respectively the trademark application in case of CTM) has been published, owners of earlier trademark registrations can file an opposition against the registration of the new trademark within a period of three months. Other than the mere application of a trademark (which, however, constitutes priority

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48 ABl. EU No. L 93, p.12.

49 With regard to the preceding Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, Official Journal of the European Communities 1992 No L 208/1 cf. *Ingerl/Rohnke*, Markengesetz, before §§ 130-136, No. 2.

50 Whereby it has to be noted that an application for an EU trademark can also be filed with the German Patent and Trademark Office, which then forwards it to the OHIM; for details see below under I. B.1.b.

51 For further details regarding absolute registration bars and the relevant regulations contained in the MarkenG [Trademark Act] (F. R.G.), cf. below under I. B.1.a.; the regulations as to absolute registration bars on an EU or international level can be found in Art. 7 ¶ 1 Community Trademark Regulation and in Art. 6quater Paris Convention (Paris Convention for the Protection of Industrial Property of 20 March 1883), which, however, are extensively identical to the provisions as set forth in the MarkenG [Trademark Act] (F. R.G.).

of a trademark), the registration of a trademark entitles the trademark owner to enforce his trademark rights vis-à-vis infringing parties.

a. German Trademarks

In Germany, national trademark protection is granted in accordance with sec. 4, No. 1 MarkenG [Trademark Act] by registering a symbol as a trademark in the register maintained by the German Patent and Trademark Office.[52] The period of protection of a German trademark begins on the day of registration[53] and lasts for ten years.[54] The registration may be renewed for subsequent ten year periods.

A trademark cannot be registered if any absolute registration bars apply. Absolute registration bars apply to trademarks which are identical to famous trademarks[55] or which are not capable of trademark protection according to sec. 3 para. 2 MarkenG [Trademark Act].[56] Additionally, absolute bars impede trademarks from being registered if they (i) entirely lack a distinctive character;[57] (ii) consist exclusively of symbols or indications that only describe the type, composition, quantity, value of the geographic origin or other characteristics of the goods or services;[58] or (iii) have become generic for describing the goods or services that characterise them,[59] to name the most important cases of sec. 8 MarkenG [Trademark Act].

An exception from these principles only applies to trademarks that have acquired distinctiveness in the relevant fields of trade *(Verkehrsdurchsetzung)*.[60] Whether distinctiveness has been acquired in the market, and, more importantly, whether such distinctiveness is accepted by the German Patent and Trademark Office when registering a trademark, may be determined on a case-by-case basis. Considerations include the market share of products protected by the trademark, sales volumes, frequency and type of use and/or marketing measures, the geographic coverage and finally the period of time the trademark has been used etc.[61] Distinctiveness is frequently determined in practice through survey reports. Consumer opinion polls on the familiarity with a trademark as

52 Online database of the German Patent and Trademark Office are available at https://dpinfo.dpma.de.

53 MarkenG [Trademark Act] § 33 ¶ 1 (F.R.G.).

54 MarkenG [Trademark Act] § 47 (F.R.G.).

55 MarkenG [Trademark Act] § 4 No. 3 (F.R.G.).

56 Cf. for details in this respect above under I. A.

57 MarkenG [Trademark Act] § 8 ¶ 2 No. 1 (F.R.G.); Cf. e.g. 1 March 2001 BGH [Federal Supreme Court] [I ZB 42/98], GRUR 2001, 1151, 1152 (marktfrisch).

58 MarkenG [Trademark Act] § 8 ¶ 2 No. "(F.R.G.); Cf. e.g. 17 July 2003 BGH [Federal Supreme Court] [I ZB 10/01], GRUR 2003, 882, 883 (Lichtenstein); 9 January 2001 BpatG [Federal Patent Court] [33 W (pat) 185/00], GRUR 2001, 509 (EUROTAX).

59 MarkenG [Trademark Act] § 8 ¶ 2 No. 3 (F.R.G.).

60 MarkenG [Trademark Act] § 8 ¶ 3 (F.R.G.).

61 Cf. e.g. 4 May 1999 ECJ [C-108 and 109/97], GRUR 1999, 723 (Chiemsee); 22 June 2006 ECJ [C-25/05 P], GRUR 2006, 1022 (Wicklerform).