

### III. Germany and the European Union

#### A. Trade mark protection

##### 1. Protection in the national German framework

Trade mark law has been substantially harmonised throughout the European Union with the implementation of the Trade Mark Directive of 1995.<sup>51</sup> While the German system does offer protection for non-registered trade marks, it does so only in peculiar circumstances, most noteworthy that more than 50% of the public must be aware of the sign.<sup>52</sup> The vast majority of cases therefore require federal registration. As to the duration, trade marks are “potentially perpetual dependent upon continued use and distinctiveness”.<sup>53</sup>

Section 3 (1) of the German Trade Mark Act describes the signs eligible for trade mark protection: “All signs, particularly words including personal names, designs, letters, numerals, sound marks, three-dimensional designs, the shape of goods or their packaging, as well as other wrapping including colours and colour combinations, may be protected as trade marks if they are capable of distinguishing the goods and services of one enterprise from those of other enterprises.”<sup>54</sup> While this list of trade mark varieties is not exhaustive,<sup>55</sup> it does explicitly provide for the most significant means of character protection, namely the protection of the graphic representations and

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51 Directive 2008/95/EC, of the European Parliament and the Council of 22 October 2008 to approximate the Laws of the Member States Relating to Trade Marks, O.J. (L 299) 25 – “Trade Mark Directive”.

52 Gesetz über den Schutz von Marken und sonstigen Kennzeichen [Markengesetz] [MarkenG][Trade Marks Act], Jan 1<sup>st</sup> 1995, Bundesgesetzblatt [BGBI] 1 S 2302, 2310 as amended § 4 para. 2.

53 Graeme Dinwoodie, *Trademark and Copyright: Complements or Competitors?*, Proceedings of the ALAI Congress, June 13-17, 2001, 517.

54 *Id.* § 3 para. 1, translation provided by the German Federal Ministry of Justice, translation by Brian Duffett and Neil Mussett; *Cf.* Directive 2008/95/EC, Art 2.

55 Karl-Heinz Fezer, *Markenrecht* § 3 at 2 (4<sup>th</sup> ed. 2009).

names of characters.<sup>56</sup> Even the names of famous literary characters in the public domain are eligible for trade mark protection, with the exception of genericism of names, meaning cases in which a character's most characteristic personality features have become generic expressions for a certain kind of character.<sup>57</sup>

The protection of phonetic aspects of a character is limited by the fact, that the German trade mark system does not allow for sound marks in the form of spoken word, but only as non-lingual sounds perceivable by human ears.<sup>58</sup> Voices that are accompanied by background music are considered non-lingual in that sense. Additionally, the characteristics of a voice are eligible for protection.<sup>59</sup>

In order to be eligible for protection, signs must meet three general requirements: The mark has to (1) be a sign in the legal sense,<sup>60</sup> (2) possess abstract distinctiveness,<sup>61</sup> and (3) be able to be represented graphically.<sup>62</sup> While the question what a sign in the legal sense is, is disputed,<sup>63</sup> the most common approach – influenced by modern marketing theory – interprets trade marks as dynamic systems of communication between customers and undertakings, allowing for most signs to be eligible for trade mark protection.<sup>64</sup> This seems to be in accordance with the CJEU's recent jurisdiction, enabling a wide array of mark types.<sup>65</sup>

A further requirement is the uniformity of the sign: Signs that can be represented by more than one manifestation are not eligible pro-

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56 *Id.* § 15 at 259; *supra* note 8 at 131.

57 See *supra* note 55 § 8 at 292, e.g. Don Quichotte, Werther, Sherlock Holmes.

58 See also *supra* note 55 § 3 at 591.

59 See *supra* note 55 § 3 at 595.

60 Ger: "Zeichen im Rechtssinne".

61 Ger: "Abstrakte Unterscheidungseignung".

62 Ger: "Graphische Darstellbarkeit".

63 See *supra* note 55 § 3 at 324.

64 *Id.*

65 Cf. Case C-273/00, Ralf Sieckmann v. Deutsches Patent- und Markenamt, 2002 E.C.R. I-11737; Case C-299/99, Koninklijke Philips Electronics NV v. Remington Consumer Products Ltd, 2002 E.C.R. I-5475; Case C-104/01, Libertel Groep BV v. Benelux Merkenbureau, 2003 E.C.R. I-3793; Case C-283/01, Shield Mark BV v. Joost Kist, 2003 E.C.R. I-14313.

tection.<sup>66</sup> This slams the door shut on the protection of complex personality traits and accents, whose inherent nature is that they are not uniformly manifested, unless they are reduced to an overly simple, uniform and predetermined scheme. Aim of the graphical representation requirement is the unambiguous fixation of the mark's properties, to allow for publicity and identifiability of the sign.<sup>67</sup> The European Commission has recently published a proposal<sup>68</sup> to eliminate the latter requirement, and instead to demand the sign "being represented in a manner which enables the competent authorities and the public to determine the precise subject of the protection afforded to its proprietor." The realisation of this proposal would enshrine the uniformity requirement, as is already in force in Germany, in the rest of the Union, and limit personality trait's registrability to the above described minimum.

Section 14 of the Trade Marks Act directly transposes Art 5 of Directive 89/104 into German Law, by prohibiting third parties from using (1) identical signs for identical goods and services (so called "double identity"), (2) confusingly similar signs, and (3) diluting well-known signs in ways of blurring, tarnishment or free-riding. The CJEU has held that in cases of double identity, likelihood of confusion is not necessary for a behaviour to constitute infringement, as long as one of the trade mark's functions "such as, in particular, [the] function of communication, investment or advertisement" is affected.<sup>69</sup> Furthermore, trade mark infringement requires the use of the sign as a trade mark. According to recent jurisdiction of the CJEU and the

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66 See *supra* note 55 § 3 at 328; *cf. also* Case C-321/03 Dyson v. Registrar of Trade-marks, 2007 E.C.R. I-687 at 37 (CJEU).

67 See *supra* note 55 § 3 at 389 et seq.

68 Proposal for a Directive of the European Parliament and of the Council to Approximate the Laws of the Member States Relating to Trade marks, COM (2013) 162 final, 2013/0089 (COD), (proposed 2013).

69 Case C-487/07, L'Oréal v. Bellure, para 63.

BGH however, the threshold for trade mark use is rather low,<sup>70</sup> including every use of a sign for the purpose of the sale of goods or services, in connection with the mark's original function as a designator of origin.

In addition to conventional (and non-conventional) trade mark protection, the Trade Mark Act grants *sui generis* protection to the titles of works.<sup>71</sup> This protection, originally intended for the names of works of art, may extend to character names in the event that they are used as title of a publication, or in cases where a character, because of its originality and memorability, is as well-known as a title character.<sup>72</sup> Unlike trade mark protection, the emergence of this title-protection is independent of registrations, and solely based on publication.<sup>73</sup> As trade marks in general, title protection grants protection against likelihood of confusion in the broadest sense. This includes any use, that may lead to the assumption of a commercial relationship.<sup>74</sup>

Alterations to a trade mark are to be treated according to Section 26 of the Trade Mark Act that implements Art 10 (1-2) lit a of the Trade Mark Directive. An alternate use of a trade mark, *i.e.* a use different from the way that the trade mark has been filed, fulfils the trade mark use requirement, as long as in the course of trade, the altered sign does not form a distinctive sign, different from the original trade mark.<sup>75</sup> This of course is essential to maintain the ability to base claims on the older registration date. The essential question is, whether the hypothetic consumer will recognize the original trade

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70 Case C-206/01, Arsenal Football Club plc v. Matthew Reed, 2002 E.C.R. I-10273; Bundesgerichtshof [BGH] [Federal Court of Justice] Dec. 20, 2001, Gewerblicher Rechtsschutz und Urheberrecht [GRUR] 2002, 812 “Frühstücks-Drink II”; BGH Dec. 6, 2001, [GRUR] 2002, 814 “Festspielhaus”; BGH Dec. 5, 2002, [GRUR] 2003, 812, 332, 336 “Abschlussstück”.

71 Ger. Trade Marks Act §§ 5, 15; Ger.: “Werktitelschutz”.

72 Oberlandesgericht Hamburg [OLG Hamburg] [Higher Regional Court] Mar. 22, 2006, Gewerblicher Rechtsschutz und Urheberrecht – Rechtsprechungs-Report [GRUR-RR] 2006, 408 “OBELIX”.

73 See *supra* note 55 § 15 at 260.

74 See *supra* note 8 at 7.4.1.4.

75 BGH May 31, 1975, GRUR 1975, 135; BGH June 20, 1984, GRUR 1984, 872 “Wurstmühle”, BGH Apr. 17, 1986, GRUR 1986, 892 “Gaucho”; *see also* *supra* note 55 § 26 at 171.

mark as filed, when perceiving the altered sign.<sup>76</sup> Especially when taking into account the differences between the two signs, consumers should hold the two signs as equal. Insubstantial alterations, that is alterations that the public perceives as meaningless and exchangeable, are always to be considered maintaining the trade mark use.<sup>77</sup> This standard is practically identical to the one established by the GC in *Bainbridge*, according to which “the sign used in trade differs from the form in which it is registered only in negligible elements so that the two signs can be regarded as broadly equivalent”.<sup>78</sup>

In addition to the standard provided for by the Trade Mark Directive, Section 26 (3) adds that alterations that do not change the original character of the trade mark according to this doctrine are deemed to be use of the old trade marks, if the altered version as well has been registered.<sup>79</sup> That is to say trade mark owners who adapted their sign have the option of registering the new mark, without having to fear the loss of the old sign. This way, they can profit from the old mark's priority, while at the same time having the safety of a higher likelihood of protection upon the next modernization of the sign.

As the complex abovementioned standards for tolerable character adaptation let suspect, it is difficult to find a clear uniform criterion of to which extent changes are tolerable in existing case law. Also, it has to be kept in mind that this is a legal question that will be decided by courts on a case by case basis.<sup>80</sup> As to names, the change from “Jeanette” to “Jeannette” has been considered consistent with the

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76 BGH Dec. 13, 2007, GRUR 2008, 714; BGH Feb 8, 2007, GRUR 2007, 592; BGH Jan 20, 2005, GRUR 2005, 515; BGH Aug 28, 2003, GRUR 2003, 1047 “Kellogg's/Kelly's”; BGH Apr 13, 2000, GRUR 2001, 54 “SUBWAY/Subwear”; BGH Mar. 30, 2000, GRUR 2000, 1038; BGH Jul. 9 1998, GRUR 1999, 54; *see also supra* note 55 § 26 at 171.

77 Bundesgerichtshof [BGH] [Federal Court of Justice] July 13, 1979, Gewerblicher Rechtsschutz und Urheberrecht [GRUR] 1979, 856 “Flexiole”; BGH May 17, 1984 GRUR 1984, 813 “Ski-Delial”; BGH July 12, 1984 GRUR 1985, 46 “Idee Kaffee”; *see also supra* note 55 at § 26 Rn 171.

78 Case T-194/03, Il Ponte Finanziaria SpA v. OHIM et. al., 2006 E.C.R II-445 “Bainbridge”; aff'd in Case C-234/06, 2007 E.C.R. I-7333.

79 *See also supra* note 55 § 26 at 179.

80 *See supra* note 55 § 26 at 178.

original mark.<sup>81</sup> While no credible general prediction can be made, whether a complete overhaul or a modernisation of the graphic representation of a character will be consistent with the original mark, decisions concerning other non-conventional marks may provide some guidance. The coloration of a sign registered in black and white, without altering the sign's general impression has been considered consistent with the registration,<sup>82</sup> especially in cases where coloration has become associated in the mind of a significant portion of the public.<sup>83</sup> The CJEU further elaborated its rationale that “by avoiding imposing a requirement for strict conformity between the form used in trade and the form in which the trade mark was registered,... [is] to allow the proprietor of the mark... to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned”.<sup>84</sup> The addition of new features will likely be acceptable, if the new feature is an emphasis of a component already existing in the original sign.<sup>85</sup> The use of a different type of mark than the one registered will not be considered to be use of the original sign, e.g. the word mark “red line” is not in use by the mere application of red lines to a product.<sup>86</sup> Only for the sake of completeness it should be mentioned that infringement may subsist over the boundaries trade mark types.<sup>87</sup>

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81 Bundespatentgericht [BPatG] [Federal Patent Court] Feb 14, 1995, Entscheidungen des Bundespatentgerichts [BPatGE] 35, 40 “Jeannette”.

82 *See supra* note 55 § 26 at 199.

83 Case C-252/12, Specsavers Int'l Healthcare, Ltd. et. al. v. Asda Stores, Ltd., at 51 (Jul. 18, 2013) available at <http://curia.europa.eu>.

84 *Id.* at 29.

85 Bundespatentgericht [BPatG] [Federal Patent Court] Apr 11, 2000, Entscheidungen des Bundespatentgerichts [BPatGE] 43, 52 “COBRA BOSS”.

86 Bundespatentgericht [BPatG] [Federal Patent Court] Feb. 16, 2000, 28 W (pat) 80/99 – *Application of a red line to goods is not use of the word mark “red line”*.

87 Landgericht Köln [LG Köln] [Regional Court Cologne] Dec. 12, 2012, GRUR-RR 2013, 102; *prominently holding for dilution of the word mark “golden bear” by a product in the shape of a golden bear, “whose self-evident denomination amongst customers is identical with the word mark”*.

## 2. Protection in the Community Trade Mark framework

While most of the above stated also applies under this chapter, some peculiarities of the Community Trade Mark system are to be pointed out. Although not expressly mentioned in the CTMR,<sup>88</sup> the OHIM requires applicants filing a Community Trade Mark to chose a mark category.

„The categorisation of marks serves a number of functions. Firstly, it establishes the legal requirement for the mark to be represented; secondly, it can help the examiner understand what the applicant is seeking to register; and finally, it facilitates research in the OHIM database.“<sup>89</sup> Should the applicant fail to chose a mark type after a two month time limit set by the office, the examiner should choose the mark type he or she feels is appropriate.<sup>90</sup>

Marks particularly relevant for character protection include word marks for the name of the character, figurative marks and three-dimensional marks for its visual appearance and sound marks. As opposed to German sound marks, lingual components such as song-lyrics are eligible for registration,<sup>91</sup> as long as the fixation requirement is met. While CTMs, for the above mentioned reason are not apt to host complex personality traits, they may provide the means to protect certain behavioural patterns. For example a classic advertisement character testing the sensitivity of a toothbrush on a common tomato,<sup>92</sup> may be protected as a motion mark, described as: „The mark comprises a moving image consisting of a toothbrush moving towards a tomato, pressing onto the tomato without breaking the skin, and moving away from the tomato“.

Like German law, Art. 15 CTMR allows for trade mark alterations that still constitute use of the unaltered sign, given that the distinctive

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88 Commission Regulation EC No. 2868/95 of 13 December 1995, implementing Council regulation (EC) 40/94 on the Community Trade Mark O.J. (L 303).

89 OHIM – The Manual concerning Opposition: Examination of Formalities, Part B.2, at 8.

90 *Id.*

91 *Id.* at 8.4.

92 See CTM DR. BEST, Registration No. 9,742,974.

character of the trade mark is not altered. The GC further held that strict conformity between the sign as used and the sign registered is not necessary. However, the difference must be in negligible elements and the signs as used and registered must be broadly equivalent.<sup>93</sup> In order to decide whether this broad equivalence is fulfilled, courts will first establish which elements of the mark are negligible, and which are dominant, further verifying whether the dominant elements are still present in the altered mark.<sup>94</sup> The General Court has held that „the assessment of the distinctive or dominant character of one or more components of a complex trade mark must be based on the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark“.<sup>95</sup> Additions and omissions of dominant elements of the mark will likely result in discontinuity.<sup>96</sup> The public perception will not be taken into account.<sup>97</sup>

The results seem fairly casuistic, holding against continuity when abbreviating the name „Tony Hawk“ to „Tony“<sup>98</sup> while holding for continuity in the case of „BIFI“ despite dramatic changes in colour and typeface and the omission of a hyphen in the middle of the word.<sup>99</sup>

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93 Case T-194/03, Bainbridge 2006 E.C.R II-445 para 50. *See also supra* note 78.

94 See also OAMI The Manual Concerning Opposition, Part 6 – Proof of use at 7.3.

95 Case T-135/04 GfK AG v. OHIM, 2005 E.C.R. II-04865 “Online Bus” para 36.

96 *Id. See also* case T-353/07 Esber SA v. OHIM, 2009 E.C.R. II-226 “Coloris” paras 29 et seq., case T-482/08 Atlas Transport v. OHIM 2010 E.C.R. II-108 paras 36 et seq.

97 See *supra* note 93.

98 OHIM Opposition division, Quicksilver, Inc. v. Exori Import- Export GmbH & Co. KG, Ruling on Opposition B 1,034,208 (Oct. 14, 2008), *available at* <http://oami.europa.eu/LegalDocs/Opposition/2008/en/001034208.pdf>.

99 OHIM First Board of Appeal, Unilever N.V. v. Kaiku Corporacion Alimentaria, S.L., Case R 0877/2009-1, (April 29, 2010) *available at* [http://oami.europa.eu/LegalDocs/BoA/2009/en/R0877\\_2009-1.pdf](http://oami.europa.eu/LegalDocs/BoA/2009/en/R0877_2009-1.pdf).

B. Copyright

Germany

Copyright protects an author's "own intellectual creation in the literary, scientific and artistic domain"<sup>100</sup> for 70 years after the author's death.<sup>101</sup> General requirement for the protection under the German Copyright Act is that the work meets a minimum threshold<sup>102</sup> of originality – in the sense of a minimum degree of individuality, or a sufficient degree of creative originality<sup>103</sup> of the work<sup>104</sup> – to award copyright protection. While characters are not explicitly mentioned as a category of work under of the German Copyright Act,<sup>105</sup> their protection under several categories of works has been historically recognized. Even though the extent of originality actually needed under the German Copyright Act is disputed<sup>106</sup> and somewhat fuzzy, characters are prone to be more complex than the average works of authorship, thus likely to meet this requirement. The CJEU's recent tendency to take a very liberal approach to subject matter eligible for copyright protection further fortifies character protection under copyright law.<sup>107</sup>

Graphic representations may qualify as works of visual arts under Section 2 (1) Nr. 4 G.C.A. Besides to the individual expression of works of literature, the German copyright system also awards protection to the "fable", meaning the course of action in the work and

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100 Gesetz über Urheberrecht und Verwandte Schutzrechte – Urheberrechtsgesetz [UrhG][Copyright Act], Sept. 9, 1965 Bundesgesetzblatt [BGBI] S. 1273 as amended, § 2.

101 *Id.* § 65 et. seq.

102 Ger.: "Schöpfungshöhe".

103 Bundesgerichtshof [BGH] [Federal Court of Justice] Dec. 10, 1987, Gewerblicher Rechtsschutz und Urheberrecht [GRUR] 1988, 533 at 535.

104 Thomas Dreier & Gernot Schulze, Urheberrechtsgesetz: UrhG, (4th ed., 2013) § 2 at 20 et seq.

105 Copyright Act § 2.

106 *See supra* note 104 § 2 at 21.

107 Cf. Case C-5/08 Infopaq Int'l A/S v. Danske Dagblades Forening 2009 E.C.R. I-6569; Case C-393/09 Bezpečnostní softwarová asociace v. Ministerstvo kultury 2010 E.C.R. I- 13971 "BSA".

its arrangement,<sup>108</sup> which may cover certain behavioural patterns of characters.<sup>109</sup>

Furthermore, courts have granted copyright protection to characters *per se* in a number of cases where these characters fulfilled the above mentioned criteria for protection, and were personally imprinted elements determining the form of the original work, in which they appeared.<sup>110</sup>

As early as 1958, the BGH has awarded copyright protection to a visually depicted character beyond its concrete fixed expression, taking into account visual character features that were capable of implying the presence of certain personality traits.<sup>111</sup> The BGH further elaborated this doctrine in a second decision concerning the same character, stating “the protection extends to an anthropomorphic hedgehog-figure with original physiognomy, whose characteristic visual features make the impression of a personality, that in its core has a mischievous yet sweet-natured hedgehog-personality”.<sup>112</sup> In 1984, the Higher Regional Court Frankfurt followed the BGH, extending to entire categories of characters by holding (in a slightly more technical wording): “The Smurf is to be awarded copyright protection”.<sup>113</sup> However the BGH seemed to apply a somewhat contradictory approach to infringement analysis in his “Sherlock Holmes” decision, stating that no infringement could be found in cases where only the visual appearance of a character was imitated, without actually imitating the character in question.<sup>114</sup> The graphic representation thus

108 *Id.* § 24 at 22.

109 Ralph Graef, *Die fiktive Figur im Urheberrecht* [*The Fictitious Character in Copyright Law*], Zeitschrift für Urheber- und Medienrecht [ZUM] 2012, 108 at 109 (2012).

110 *Id.* at 111.

111 Bundesgerichtshof [BGH] [Federal Court of Justice] Apr. 1, 1958, Gewerblicher Rechtsschutz und Urheberrecht [GRUR] 1958, 500 “Mecki-Igel”.

112 Bundesgerichtshof [BGH] [Federal Court of Justice] Dec. 8, 1959, Gewerblicher Rechtsschutz und Urheberrecht [GRUR] 1960 251, 252 “Mecki II”.

113 OLG Frankfurt am Main [OLG FFM] [Higher Regional Court Frankfurt am Main] Feb. 23, 1984, Gewerblicher Rechtsschutz und Urheberrecht [GRUR] 1984, 520 “Schlümpfe”.

114 Bundesgerichtshof [BGH] [Federal Court of Justice] Nov. 15, 1957, Gewerblicher Rechtsschutz und Urheberrecht [GRUR] 1958, 54 “Sherlock Holmes”.

was being used as yardstick for copyright protection of a character, but was not subject of copyright protection.

In 1993, the BGH first formulated an impartial test to determine whether a character was protected by copyright or not,<sup>115</sup> demanding “a characteristic and unmistakeable combination of external qualities such as personality traits, skills and typical behavioural patterns”.<sup>116</sup> Consequently, several courts acknowledged the copyright protection for Astrid Lindgren's classic Figure “Pipi Longstocking”,<sup>117</sup> partially deviating from the Sherlock Holmes doctrine by granting protection to Pipi's flamboyant visual appearance *per se*.<sup>118</sup>

To determine whether a character is infringing older character rights<sup>119</sup> or whether it is covered by the “free use exception”,<sup>120</sup> the conceptual distance between the old work and the new work is decisive. For this purpose, courts have adapted<sup>121</sup> the “fading doctrine”,<sup>122</sup> according to which free use is granted only in cases where the content taken from the older work protected by copyright is being reduced to a role so marginal, that the old work fades to a weak and irrelevant state in the context of the new work.<sup>123</sup> Hence, a work can be considered “fair use”, if it is a complete new creation that was merely inspired by the original work.<sup>124</sup> Decisive in this context are the correlations between the two works, not the differences.<sup>125</sup> The stronger and more distinct the original character is, the larger is its

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115 *See also* supra note 109 at 111.

116 BGH Mar. 11, 1993, GRUR 1994, 191 at 192 “Asterix-Persiflagen”.

117 Landgericht Hamburg [LG Hamburg] [Regional Court Hamburg] Apr. 28, 2009, ZUM 2009, 581; Landgericht Berlin [LG Berlin] [Regional Court Berlin] Aug. 11, 2009 ZUM 2010, 69; Oberlandesgericht Köln [OLG Köln] [Higher Regional Court Köln] Oct. 14, 2011, 6 U 128/11 *available at* <http://justiz.nrw.de>.

118 Landgericht Kiel [LG Kiel] [Regional Court Kiel], Apr. 28, 2011, 15 O 22/11, *available at* Beck online.

119 § 23 German Copyright Act.

120 § 24 German Copyright Act.

121 *See supra* note 116 at 193.

122 Ger.: “Verblässens-Formel”.

123 Friedrich Fromm & Wilhelm Nordemann, *Urheberrecht* (10 ed. 2008) § 24 UrhG at 3.

124 *See supra* note 104 § 24 at 8.

125 *See also* supra note 109 at 114.

scope of protection.<sup>126</sup> However, in a recent decision on claimed infringement of a literary character by selling a carnival costume with resemblances to that character, the BGH held that even when a mental connection to a very distinctive characters is being created, mere allusions or the reception of minor elements from a character do not automatically rule out free use.<sup>127</sup>

Exceptions to this rule exist for cases of parody, in which the BGH tends to apply a less stringent standard, and is more likely to decide for free use.<sup>128</sup> Despite the fact that German copyright law does not allow for free assignability of works, the possibility to grant user rights, leading to a de facto assignment of rights, degrades this fact to a mere contracting problem.<sup>129</sup>

### C. Unfair Competition Law

#### Germany

The unauthorized use of a trade mark, and the unauthorized use of another undertaking's commercial indicator – including characters<sup>130</sup> – may qualify as anticompetitive hindrance<sup>131</sup> under Section 4, para. 10 of the German Unfair Competition Act.<sup>132</sup> This may result from

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126 *Id.*

127 Press release, BGH, Urheberrechtlicher Schutz einer literarischen Figur [Copyright Protection of a Literary Character] (concerning the unpublished judgement BGH July 17, 2013, I ZR 52/12), available at <http://juris.bundesgerichtshof.de>; see also BGH Mar. 11, 1993 GRUR 1994, 206 “Alcolix”; contra *supra* note 109 at 116.

128 *See supra* note 121 at 198.

129 *Id.* at 131.

130 Annette Kur, *Der wettbewerbliche Leistungsschutz – Gedanken zum wettbewerbsrechtlichen Schutz von Formgebungen, bekannten Marken und “Characters”* [Protection under Competition Law – Thoughts on the Protection of Shapes, Famous Marks and Characters], GRUR 1990, 1, 5.

131 Wolfgang Gloy, Michael Losschelder & Willi Edelmann, *Handbuch des Wettbewerbsrechts* § 56 IV at 91 (4 ed. 2010); Michael Enzinger, *Lauterkeitsrecht* at 415 et. seq. (2012), *with a comparison to the legal situation in Austria*.

132 Gesetz gegen den unlauteren Wettbewerb [UWG] [Unfair Competition Act], May 27, 1896, *Bundesgesetzblatt* [BGBl] I S 254, as amended.

imitation,<sup>133</sup> exploitation of goodwill,<sup>134</sup> or the “approach” to a well-known trade mark.<sup>135</sup> Anticompetitive hindrance may materialise in the endangerment of valuable signs by direct competitor, non-competitor, and in the protection of a secured legal position arising from the prior use of a sign.<sup>136</sup>

In general, the protection under the U.C.A. is subsidiary to trade mark protection.<sup>137</sup> Unfair competition protection thus applies only in cases, where the requirements for trade mark infringement are not met, most notably in the rare cases where the imitator is not using the sign as a trade mark.<sup>138</sup>

The protection of a secured legal position arising from the prior use of a sign is intended to cover cases, in which an undertaking used a certain sign in commerce, without acquiring trade mark protection for it. Due to the strict first to register system, a second comer could acquire a registration and highjack the mark on grounds of trade mark infringement.<sup>139</sup> Given that the first adopter has acquired a valuable interest in the sign, in the sense of a significant degree of market recognition, and given that the sign has acquired goodwill amongst the target group of the product the sign is used for, the enforcement of a later registered identical or confusingly similar trade mark can be fenced off on grounds of competition law. This exception to the strict registration requirement only applies, if the latter registrant was acting knowingly of the earlier sign, and is subject to a case-by-case decision, taking into account all the extent and intensity of all circumstances having impact on competition.

While this may seem like a very vague and weak form unregistered trade mark protection, it may bear substantial advantages in the protection of advertisement characters inherent to registration based trade

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133 BGH Dec 10, 1986, GRUR 1987, 903 at 905 “Le Courboisier Möbel”.

134 BGH Nov 8, 1984, GRUR 1985, 876 at 878 “Tchibo/Rolex”.

135 BGH Nov 29, 1999, GRUR 1991, 465 “Salomon”; BGH Dec 6, 1990, GRUR 1991, 609 “SL”; BGH Feb 10, 1994, GRUR 1994, 808 “Markenverunglimpfung”.

136 *See supra* note 131 at 92.

137 *See supra* note 131 at 93.

138 *See supra* chapter III.A.1.

139 *See supra* note 131 at 97.

mark systems. Features that require the proof of acquired distinctiveness are not eligible for trade mark protection right away. If such features deviate from the overall commercial expression of the mark, they exceed its scope, thus resulting in a “gap of protection” between the first adoption of the feature, and the acquisition of distinctiveness. Based on unfair competition law, mark owners are supplied with a possibility to bridge this gap of protection.<sup>140</sup>

Precondition for protection against “endangerment of signs” is that the sign has acquired a “high degree of fame or a particular prestige value and reputation”, embodying “a high, value to the owner, created by his own effort”. This is relevant especially in cases, where marketing characters are subject to libel by a competitor, but not used as a trade mark.

#### *D. Other forms of protection*

Protection via personality rights?

Under the German legal system, personality rights protect manifold elements encompassed by real persons, most notably a person's name, voice and image. Unlike the U.S., there is no distinction between the right to privacy and the right to publicity – personality rights are inalienable and can not be subject to licensing in the closer meaning of the word. While it is thinkable that the voice of a fictitious character overlaps with the voice of an individual, thus being protected under personality rights,<sup>141</sup> no case involving this scenario has been reported yet.

The Austrian legal system however, following an approach to personality protection very similar to that of Germany, has had a high profile supreme court case.<sup>142</sup> “MA2412” a popular television programme about the allegedly legendary laziness of Austrian public

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140 See *supra* chapter III.A.1.

141 Or more precisely: the right to one's voice.

142 Oberster Gerichtshof [OGH] [Supreme Court] Mar. 20, 2003, docket No, 6 Ob 270/01a, available at <http://ris.bka.gv.at> (Austria).

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servants, featured its principal characters talking in strongly exaggerated accents, and highly over-pitched voices. When imitations of these voices were used in a radio commercial, the actors sought to enjoin the use of “their” voices on grounds of personality protection. The Austrian Supreme Court affirmed the decision for the plaintiffs. Some commentators praised this decision as a fast and efficient way of enforcing the right to one's voice,<sup>143</sup> all despite fact, that it was not the actors' voices that were imitated, but much rather the characters'.<sup>144</sup>

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<sup>143</sup> *See supra* note 25.

<sup>144</sup> *See also* Feldman *supra* note 3 at 709.