relatedness respectively) to brand value. Hence, the objectives of focussing on the examination of possible implications of certain trade mark law issues on brand value, thereby keeping the introduction of the relevant laws as short as possible, and of providing sufficient background knowledge on these laws are balanced.[619]

For purposes of clarity, the order in which legal issues will be discussed hereafter roughly follows the system in which trade mark law is laid down in Germany and on the European level. It does not indicate a graduation of importance of the respective points.

The following aspects will be, as a default, evaluated with respect to registered trade marks, since this work's focus lies on harmonised European trade mark law, which in large part governs registered trade marks (for instance, trade marks acquired through use[620] are, on the European level, merely taken into account in terms of the relationship between them and registered trade marks[621]).[622] Some issues in the legal dimension would have to be added or ommitted in case a well-known[623] mark, a trade mark acquired through use[624], a mark with a reputation[625] or a trade mark application[626] has to be assessed.

619 In consequence, the following analysis does and cannot serve the purpose of discussing trade mark law in every detail. There are numerous publications providing an adequately particularised overview of German and European trade mark law should the reader wish more detailed information. Cf. e.g. *Bender*, Europäisches Markenrecht. Einführung in das Gemeinschaftsmarkensystem; *Berlit*, Markenrecht; *Bingener*, Markenrecht; *Davies*, Sweet & Maxwell's European trade mark litigation handbook; *Fezer*, Markengesetz (commentary); *Gold*, The Community Trade Mark Handbook; *Hildebrandt*, Marken und andere Kennzeichen; *Ingerl/Rohnke*, Markengesetz (commentary); *Lange*, Marken- und Kennzeichenrecht; *Nordemann*, Wettbewerbsrecht Markenrecht.

620 § 4 no. 2 MarkenG (Verkehrsgeltung).

621 Fourth Recital CTMD.

622 Furthermore, registered trade marks constitute the lion's share of all trade marks, arg. e *von Bomhard*, Lovells Intellectual Property Newsletter January 2008, p. 12, stating that most owners of well-known marks have a registration anyway.

623 Art. 6bis Paris Convention. Cf. below at 5.7.2 and 5.12.3.

624 *Infra* at 5.7.3.

625 *Infra* at 5.12.2.

626 A trade mark application per se is capable of developing a value, since the applicant has a right to be granted a registration if all requirements are met. As a consequence, more of the below issues would have to be assessed by way of prognosis than with regard to a registered trade mark. In addition to that, the evaluation system would need to be customised for trade marks which have not accrued legal protection through registration but through use or notoriety, e.g. by excluding all points relating to trade mark registration.

5.2 Qualitative Scope of Protection: Distinctiveness, Non-descriptiveness and Graphical Representation

5.2.1 Introductory Remarks

A sign is protectable as a trade mark if it is distinctive (in both an abstract and a concrete sense), non-descriptive and graphically representable.[627]

The issues of distinctiveness and non-descriptiveness are central points in the realm of trade mark protection. They allude to the core function and raison d' être of every mark: the origin function, i.e. the ability to distinguish goods or services of one source from those of a different one, thereby signalling the specific origin of the marked products or services.

Graphical representation has been introduced in order to provide legal certainty, especially for competitors and others, with regard to what exactly is covered by the registered trade mark in question.[628] In contrast to distinctiveness and non-descriptiveness, it is a formal criterion.

All trade mark offices examine absolute grounds for refusal of trade mark protection, including the qualitative scope of protection, in the course of the registration procedure. This examination, however, does not constitute a guarantee that these points will never again be questioned once the trade mark is registered. It merely offers a rebuttable presumption of validity of the mark with respect to the examined grounds. For this reason, the proprietor enjoys some degree of but not full legal certainty with regard to the non-existence of absolute grounds for refusal of trade mark protection.

Each of these absolute grounds listed in Art. 7(1) CTMR is independent and must therefore be examined separately.[629] In the course of such examination, they are to be interpreted in light of the respective underlying general interest.[630] In case of Art. 7(1)(b)-(e) CTMR (wich include non-distinctiveness

627 Strictly speaking, the law distinguishes between abstract distinctiveness as part of eligibility for trade mark protection and lacking concrete distinctiveness as an absolute ground of refusal of protection. However, from a valuation point of view, this difference does not significantly influence value or the valuation process. Rather, it seems expedient to combine these issues under the heading of qualitative scope of protection. Hereby, two thematically related issues are dealt with under the same heading.

628 *Ströbele/Hacker*, Markengesetz, § 3 no. 12.

629 ECJ, above fn. 125 - *DAS PRINZIP DER BEQUEMLICHKEIT*, para. 39.

630 ECJ, judgment of 16 September 2004, Case C-329/02 P, [2004] ECR I-8317, SAT.1