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für gewerblichen Rechtsschutz
und Urheberrecht e.V.

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Areas of Overlap between Trade Mark Rights, Copyright and Design Rights in German Law

Report of the German Association for the Protection of Intellectual Property (GRUR)

Dear Dr. Idris,

The German Association for the Protection of Intellectual Property (GRUR) is a scientific association; its statutory purpose is both to foster the scientific training and development concerning the law of intellectual property and the support of the legislative organs with regard to legislation in the respective area. The association unites members of all occupational groups, lawyers, judges, academic scholars, the executors of the specific public authorities as well as of the competent ministries dealing with the respective questions and further representatives of businesses.

We would hereby like to submit our report on the areas of overlap between trade mark rights, copyright and design rights in German law as addressed in point 15 and 16 (*Trademarks and Their Relation With Literary and Artistic Works*) of **WIPO-document SCT/16/8** initiating a paper for consideration by the SCT at its eighteenth session, based, *inter alia*, on submissions by SCT Members to be submitted to the Secretariat by the end of April 2007.

1. The statutory framework

1.1 Trade marks

1 The German **Trade Marks Act (Markengesetz – MarkenG) of 1994** aims at a **codification of the law of distinctive signs**. Thus, the MarkenG not only provides for the protection of registered trade marks, but also of unregistered trade marks, trade names, work titles and geographical indications of origin. As far as registered trade marks are concerned, the MarkenG implements the EC Trade Mark Directive (89/104/EC), including its optional provisions on the protection of well-known marks. Hence, the German provisions on registered trade marks, in particular on signs which may constitute trade marks (§ 3 MarkenG), on absolute grounds of refusal (§ 8 MarkenG), on conflicting earlier rights (§§ 9 et seq. MarkenG) and on trade mark infringement (§ 14 MarkenG) are similar to the respective provisions of the Trade Mark Directive (Art. 2-4) and have to be interpreted in accordance with the Directive and with the case-law of the European Court of Justice. German national trade marks can coexist with Community trade marks protected under Regulation 40/94 on the Community Trade Mark.

2 A trade mark may consist of any sign which is capable of distinguishing products (§ 3 (1) MarkenG). It can only be registered if it is capable of being represented graphically (§ 8 (1) MarkenG).[1] The **list of possible signs** in § 3 (1) MarkenG explicitly refers to words including personal names, designs, letters, numerals, acoustic signs (which are not explicitly mentioned in the Directive), three-dimensional forms including the shape of goods or of their packaging and colours. This list is not exhaustive. Tactile marks can be registered.[2] Smells are not as such excluded from protection,[3] but at present they cannot be registered because there is no clear and reliable form of graphical representation.[4] Shapes are excluded from trade mark protection if (1) they result from the nature of the goods themselves, (2) are necessary to obtain a technical result or (3) give substantial value to the goods (§ 3 (2) MarkenG = Art. 3 (1)(e) of the Directive).

3 § 8 (2) MarkenG lists 10 **absolute grounds of refusal**. The most important ones for the purpose of this report are lack of distinctiveness with respect to the products for which registration is sought (No. 1) – often referred to as “concrete

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1 Signs, which cannot be represented graphically, can – at least in theory – acquire trade mark status through use, § 4 No. 2 MarkenG.

2 BGH GRUR 2007, 148, para. 12 – *Tastmarke*.

3 ECJ, C-273/00, GRUR 2003, 145, para. 44 – *Sieckmann.*

4 ECJ, C-273/00, GRUR 2003, 145, paras 69 et seq. – *Sieckmann.*

distinctiveness" –, descriptive nature (No. 2), conflict with public policy or accepted principles of morality (No. 5) and applications made in bad faith (No. 10). The grounds of refusal set forth in No. 1-3 can be overcome if the mark has acquired distinctive character through use (§ 8 (3) MarkenG).

4 The Patent and Trade Mark Office does not conduct a search for earlier conflicting rights. These rights are treated as **relative grounds of refusal**, which render a mark liable to be declared invalid. Earlier rights which qualify as relative grounds of refusal and which can be enforced both in opposition and cancellation proceedings (§§ 42;[5] 51; 55 MarkenG) are prior registered marks (§ 9 MarkenG) and prior well-known marks in the sense of Article 6bis of the Paris Convention (§ 10). Other earlier rights can only be enforced in cancellation proceedings (§§ 51, 55 MarkenG) or relied upon as defences against infringement actions. Such rights are prior unregistered marks and trade names (§ 11 MarkenG) and **other earlier rights (§ 13 MarkenG) including copyright**, the right to one's name, the right to one's picture and industrial property rights of every kind.

5 The **scope of protection** is defined in § 14 MarkenG, the wording of which follows Article 6 of the Directive. Thus there are three types of infringement: (1) the use of an identical sign for identical products, (2) the use of an identical or similar sign for identical or similar products causing a risk of confusion and (3) the use of a sign identical with or similar to a well-known mark for products of any kind,[6] which without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark. In addition to the statutory elements of infringement, German courts require "trade mark use".[7] While under the pre-directive German law trade mark use was understood to mean use of another trader's mark as a designation for the infringer's own products,[8] the German Federal Supreme Court (Bundesgerichtshof) has recently adopted a loose definition of trade mark use. According to this definition, even the ornamental use of a mark can constitute trade mark use, if it evokes an association with the mark.[9] This broad definition was made in a case concerning the protection of a well-known mark. It is

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5 The specific protection for well-known marks, however, cannot be enforced in opposition proceedings, § 42 (2) No. 1 MarkenG.

6 According to its wording, § 14 (2) No. 3 MarkenG seems to be restricted to the use of the sign outside the area of similarity. However, the ECJ has held that the provision can also be applied to the use of well-known marks for similar products, see ECJ, C-292/00, GRUR 2003, 240, paras 24 et seq. – *Davidoff/Gofkid*, BGH GRUR 2004, 235 (238) – *Davidoff II*.

7 BGH GRUR 2002, 814 (815) – *Festspielhaus*; BGH GRUR 2005, 583 (584) – *Lila Postkarte*; BGH GRUR 2006, 329, para. 23 – *Gewinnfahrzeug mit Fremdemblem.*

8 See e.g. RGZ 149, 335 (342); BGH GRUR 1953, 175 (176) – *Kabel-Kennzeichnung*.

9 BGH GRUR 2005, 583 (584) – *Lila Postkarte,* referring to ECJ, C-408/01, GRUR 2004, 58 para. 39 – *Adidas/Fitnessworld*.

unclear whether it also applies to marks which are not well-known. The exceptions to trade mark infringement also follow the directive. In particular, § 23 MarkenG (use of name, descriptive use, spare parts) equals Art. 6 and § 24 MarkenG (exhaustion) corresponds to Art. 7 of the Directive.

1.2 Copyright

6 The German **Copyright Act of 1965 (Urheberrechtsgesetz – UrhG)** protects literary, artistic and scientific works (§ 1 UrhG). The categories of protected works listed in § 2 (1) UrhG include inter alia works of language (No. 1), musical works (No. 2) and works of visual art including works of applied art (No. 4). This list, however, is not exhaustive. The crucial condition of protection is provided in § 2 (2) UrhG, where the concept of "protected work" is defined as "personal intellectual creation". Unlike common law jurisdictions, which normally require a work to be "original", German law requires "**individuality**": the work must stand out from the ordinary and must be above pure routine or craftsmanship.[10] In practice, this requirement is not applied in a very strict way. Copyright law also protects works of little individuality, often referred to as the "small coin" of copyright. There is one important exception: the requirements for copyright protection of works of applied art are stricter (see para. 23, below). The reason is that generous copyright protection for works of this kind could undermine the conditions and limits of design law.

7 German copyright law is based on a **monistic perception**: economic rights and moral rights are inextricably intertwined. They are parts of one singular, monolithic right. Moral rights include the right to publication (§ 12 UrhG), the right to claim authorship (§ 13 UrhG) and the right to work integrity (§ 14 UrhG). Economic rights include the reproduction right (§ 16 UrhG), the resale right (§ 17 UrhG), the right to public performance (§ 19 UrhG) and the making-available right (§ 19a). The term of copyright has been harmonised by European law, it is 70 years post mortem auctoris.

1.3 Designs

8 The German **Designs Act of 2004 (Geschmacksmustergesetz – GeschmG)** implements the EC Directive on the Protection of Designs (98/71/EC). Thus, the conditions and the scope of designs protection in Germany follow European law. Designs are defined as the two- or three-dimensional appearance of the whole or a part of a product (§ 1 No. 1 GeschmG). The main conditions of protection are **novelty** and **individuality** (§ 2 (1) GeschmG). Features of appearance of a product which are solely dictated by its technical function are excluded from protection (§ 3

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10 BGH GRUR 1995, 673 (675) – *Mauerbilder*; *Schulze*, in: Dreier/Schulze, Urheberrechtsgesetz, 2nd ed. (2006), § 2, para. 18; *Loewenheim*, in: Schricker (ed.), Urheberrecht, 3rd ed. 2006, § 2, para. 23.

(1) No. 1 GeschmG). At present, German law contains a “must fit” exception (§ 3 (1) No. 2 GeschmG), but no “must match” clause.[11] German law only provides for registered designs. The term of protection is up to 25 years.

9 German national design rights can coexist with Community design rights protected under Regulation 6/2001 on Community Designs. Unlike German law, the Regulation not only provides for registered Community design rights, but also for an **unregistered Community design right**, which is protected against copying for three years from the date at which the design was first made available to the public within the Community (Art. 11).

1.4 Unfair Competition Law

10 In Germany, unfair competition law has a long tradition, and it is of high practical significance. The **Act against Unfair Competition of 2004 (Gesetz gegen den unlauteren Wettbewerb – UWG)** contains a broad prohibition of acts of unfair competition (§ 3 UWG), which is fleshed out by specific provisions against misleading advertising (§ 5 UWG), on comparative advertising (§ 6 UWG) and against harassment (§ 7 UWG) and by a non-exhaustive list of 11 examples of unfair competition (§ 4 UWG). Among these examples is a tort of **unfair product imitation** (§ 4 No. 9 UWG). This provision protects products which are of “**competitive originality**”, which means that the product features are either capable of indicating the product’s trade origin or of pointing to the product’s specific qualities.[12] Copying is not prohibited as such, but only on the condition that an **additional element of unfairness** is present. According to the non-exhaustive list in § 4 No. 9, product imitation is unfair, if (alternatively) it (a) causes confusion in the market place, (b) exploits or damages the goodwill attached to the imitated product or (c) the knowledge or the models necessary for the imitation have been acquired by improper means. The level of competitive originality and the elements of unfairness are interrelated: the more original the product, the lesser the burden of showing unfairness. In the past, German courts have in fact (although not always openly) repeatedly granted protection against product imitation as such, thereby filling gaps in the intellectual property system.[13] Whether such direct protection against copying can still be granted on the basis of the general prohibition of unfair competition (§ 3 UWG) is a moot point. The term of protection is not defined by

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11 But see the „freeze“-provision in § 67 GeschmG: design rights may not be relied upon in order to prevent acts which were permitted before the reform of design law.

12 BGH GRUR 2002, 629 (631) – *Blendsegel*; BGH GRUR 2006, 79, para. 21 – *Jeans I.*

13 See BGH GRUR 1973, 478 (480) – *Modeneuheit* (protection of fashion novelties before introduction of unregistered designs); GRUR 1999, 923 – *Tele-Info-CD* (protection of telephone directories before introduction of sui generic database right); *Sambuc*, in: Harte-Bavendamm/Henning-Bodewig (eds), UWG (2004); § 4, paras. 28 et sqq.

statute. Particularly where the imitation causes confusion in the market-place, protection has been held to be potentially unlimited.[14] In other cases, however, the courts have limited the term of protection to a shorter period of amortisation, which can be restricted to one season in the case of fashion novelties[15] or to a period which does not exceed the term of protection provided by comparable intellectual property rights.[16]

2. General principles and rules of conflict

2.1 Trade marks and copyright

11 Words, pictures, shapes or sounds can in theory attract **both trade mark and copyright protection**. Examples, which will be considered in more detail below, are word marks which consist of advertising slogans or fictitious names, picture marks of every kind (from simple logos or devices to works of art), three-dimensional shapes (product designs or even the outward appearance of a building) and sound marks.

12 In theory, the **conditions of protection differ** in both areas of law: whereas the central condition of copyright protection is individuality (see para. 6, above), the key condition of trade mark registration is distinctiveness (see para. 3, above). In practice, however, there is some degree of convergence, since both criteria are the more likely to be satisfied, the more the word, design or form in question differs from what is common in the particular field of trade.

13 In principle, it is generally acknowledged in German law that **copyright and trade mark rights may overlap**.[17] Both rights serve **different purposes**. Whereas copyright protects individual creations in order to reward the author for his creative effort and in order to promote cultural creativity, trade marks protect signs as indications of trade origin. Thus, both rights can co-exist, and earlier copyright protection does not as such create an absolute ground of refusal for trade mark applications.[18]

14 When the **same person or company owns the copyright and the trade mark**, he, she or it can – subject to the conditions of infringement and to possible

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14 BGH GRUR 1998, 477 (478) – *Trachtenjanker*; BGH GRUR 2006, 79, para. 24 – *Jeans I.*

15 BGH GRUR 1973, 478 (480) – *Modeneuheit*.

16 BGH GRUR 1986, 895 (897) – *Notenstichbilder*; BGH GRUR 2005, 349 (352) – *Klemmbausteine III.*

17 See *Jacobs*, in: Ohly et al. (eds), Festschrift für Gerhard Schricker (2005), p. 801 (807); *Axel Nordemann*, in: Loewenheim (ed.), Handbuch des Urheberrechts (2003), § 83, paras 33, 41; *Osenberg*, GRUR 1996, 101 (104); *Seifert*, WRP 2000, 1014 (1019).

18 See § 13 (2) No. 3 MarkenG and the following para.

exceptions from protection – enforce both rights. A case concerning one of the Harry Potter novels is an example in point. The media company which has been granted copyright licences by the author Joanne K. Rowling also owns various trade marks in the words "Harry Potter". The publication of a school book under the title "Literature Workshop for Elementary Schools on Joanne K. Rowling's 'Harry Potter and the Philosopher's Stone'" which contained an unauthorised adaptation of the novel was held to infringe both the copyright in the book and the "Harry Potter" trademark.[19]

15 When both rights have **different owners**, who have not licensed their rights to each other, the **earlier right will prevail**.[20] In the case of an earlier copyright, trade mark registration of the work is not excluded as such, but the mark is liable to be cancelled according to § 13 (2) No. 3 MarkenG. The use of the work for the purpose of the application will also amount to a copyright infringement according to §§ 16, 17 UrhG. Should an earlier trade mark be made a part of a copyrightable work, copyright protection is not excluded per se, but the use of the work may constitute trade mark infringement. However, several elements of trade mark protection require careful examination. First, the mark may not have been used in the course of trade.[21] Secondly, a purely artistic or ornamental use may not be regarded as trade mark use, although this criterion has recently been extended (see above, para. 5). Thirdly, the constitutional guarantee of the freedom of art (Art. 5 (3) GG[22]) may provide a defence, in particularly against claims for the infringement of well-known marks.[23]

16 Some concerns have been voiced that trade marks may be used as a tool to **(re-) monopolise works which are in the public domain**, either because the term of copyright has elapsed or because they have never been protected.[24] Cases in which individuals have been successful in registering well-known works of art (or, indeed, names of deceased persons of historical significance) have received extensive coverage in the press.[25] There has been some discussion about whether the title of a work which has entered the public domain still deserves protection. In another controversial case, the town of Querfurt, on whose territory the "Sky Disk of Nebra", a prehistoric artefact of great beauty and historic significance, had been

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19 LG Hamburg GRUR-RR 2004, 65 – *Literatur-Werkstatt Grundschule.*

20 See *Axel Nordemann* (note 17), § 83, para. 33.

21 Example: the use of the „mark" „Mordoro" (i.e. "Murderoro") in an anti-smoking campaign was held to fall outside the ambit of trade mark law: BGH GRUR 1984, 684 – *Mordoro*.

22 Grundgesetz = Basic Law = German Constitution.

23 BGH GRUR 2005, 583 (585) – *Lila Postkarte*.

24 *Osenberg*, GRUR 1996, 101 et seq.; *Seifert*, WRP 2000, 1014 et seq.

25 See *Axel Nordemann* (note 17), § 83, para. 49; *Seifert*, WRP 2000, 1014.

found, and the State of Saxonia-Anhalt, to which Querfurt belongs, filed conflicting applications for figurative marks depicting the disk. The State successfully applied for the cancellation of the town's marks on the basis of the State's purported earlier neighbouring right for the first public display of a hitherto unpublished work (§ 71 UrhG),[26] although the existence of this right is not free from doubt.[27] Some authors have argued that works, which are in the public domain, should generally be excluded from registration.[28] There have even been political initiatives aimed at exempting works from trade mark registration which form part of the nation's cultural heritage. So far, these initiatives have not been successful. According to the view prevailing among legal authors, the absolute grounds of refusal (see para. 3) and the limited scope of the trade mark right (see para. 5) sufficiently safeguard free access to works which are in the public domain.[29] This issue will be discussed in more detail with respect to figurative marks (see para. 25) and work titles (para. 22).

17 Another issue of overlap arises from the fact that there is **no general "fair use" exception** in either German copyright or trade mark law. While the **rights may overlap**, most of the detailed and well-defined **exceptions do not**, an issue sometimes referred to as "asymmetric convergence".[30] Examples in point are the *Dior/Evora* case decided by the ECJ[31] and a similar German case.[32] A manufacturer of perfumes sought to prevent the marketing of his perfumes by a trader who was not a member of the manufacturer's selective distribution agreement. The perfume was "genuine": it had first been marketed within the EU by the manufacturer or with his consent. The trade mark right was thus exhausted. However, the manufacturer claimed that (1) the flacon was protected by copyright, that (2) the depiction of the flacon in an advertising brochure amounted to a copyright infringement because (3) the reproduction right in copyright law was not subject to the **doctrine of exhaustion**. While there is general consensus that copyright should not be used as a device of by-passing the exceptions to trade mark protection, [33] it is not easy to find a doctrinally satisfactory solution.[34] The most

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26 LG Magdeburg GRUR 2004, 672.

27 See the controversy between *Eberl*, GRUR 2006, 1009 and *Götting/Lauber-Rönsberg*, GRUR 2006, 638, GRUR 2007, 303, see also *Thum*, in: Wandtke/Bullinger (eds), 2nd ed. (2006); § 71, paras 21, 27, 28.

28 *Klinkert/Schwab*, GRUR 1999, 1067 (1073); *Wandtke/Bullinger*, GRUR 1997, 573 (578).

29 See on this issue *Jacobs* (note 17), pp. 801 (807 et seq.); *Axel Nordemann* (note 17), § 83, paras 48 et seq.; *Osenberg*, GRUR 1996, 101 et seq.; *Seifert*, WRP 2000, 1014 et seq.

30 *Kur*, in: Schricker/Dreier/Kur (eds.), Geistiges Eigentum im Dienst der Innovation (2001), p. 23 (42). See also *Sosnitza*, in: Keller/Plassmann/von Falck (eds), Festschrift für Winfried Tilmann (2003), pp. 895 et seq.

31 ECJ GRUR Int 1998, 140 (143), paras 37 et seq. – *Dior/Evora*.

32 BGH GRUR 2001, 51 – *Parfumflakon.*

33 BGH GRUR 2001, 51 (53) – *Parfumflakon.*

convincing approach seems to be the extension of the exhaustion of the resale right (§ 17 UrhG) to advertising for the respective copies of the work. Similar issues can arise with respect to the descriptive use of a mark (§ 23 No. 2 MarkenG) and the use of a mark as an indication of the purpose of goods or services (§ 23 No. 3 MarkenG). In all of these situations, considerable efforts of statutory interpretation are necessary in order to fit one and the same public interest, which is in principle considered as prevailing, into the different "pigeon-holes" of the different intellectual property exceptions. The **freedom of parody** is a related issue. There is no explicit exception from either copyright or trade mark protection which would justify parodies. The courts use different approaches in both fields of law. Whereas in copyright law the use of a work for purposes of parodies is regarded as a "free use" (§ 24 UrhG) and distinguished from work adaptations covered by copyright (§ 23 UrhG),[35] the parody of a well-known trade mark may be justified (§ 14 (2) No. 3 MarkenG) by the constitutional guarantee of the freedom of the arts (Art. 5 (3) GG).[36]

2.2 Trade marks and designs

18 **Product shapes and graphic symbols** can be the object of both trade mark and design rights. An **overlap** between these rights is **common**. As in the case of copyright and trade marks, both rights serve different objectives. Whereas the design right protects both creativity and the market attraction of original appearances of products, trade marks serve as an indication of origin. However, both aspects may be difficult to separate, as consumers tend to distinguish products by their outward appearance. This overlap creates a dilemma. On the one hand successful designs are easily remembered by the public, which is an argument in favour of trade-mark protection. On the other hand, the **term of design protection** is limited to 25 years for registered designs and 3 years for unregistered Community designs. Overly generous standards of trade mark registration of product shapes can undermine this limitation. This issue will be considered in detail with respect to three-dimensional marks (para. 29).

2.3 Trade marks, designs and unfair competition

19 The **relationship between trade marks, designs and unfair competition** law is a particularly **intricate** one. On the one hand, both § 2 MarkenG and Art. 96 of the Community Designs Regulation explicitly state that additional protection on the

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34 See *Kur*, in: Schricker/Heath/Ganea (eds), Festschrift für Adolf Dietz (2001), pp. 253 et seq., *Schricker*, JZ 2001, 463 et seq.

35 See BGH GRUR 20003, 956 (958) – *Gies-Adler*; BGH GRUR 1994, 191 (193) – *Asterix-Persiflagen*; *Loewenheim*, in: Schricker (note 10), § 24, para. 22.

36 BGH GRUR 2005, 583 (584) – *Lila Postkarte*.

basis of other statutes shall not be excluded. On the other hand, the unrestricted application of unfair competition law would undermine the borders of intellectual property law. Since this issue mainly arises with respect to product shapes, it will be considered below (paras 30, 31).

3 Particular categories

3.1 Words, names, advertising slogans

20 **Words**, including names, are signs in the sense of § 3 (1) MarkenG and hence (subject to the other requirements of protection) eligible for trade mark protection. However, there is little potential for an overlap of rights in this regard, because **in most cases copyright protection will be lacking**. The courts have repeatedly decided that single words do not normally satisfy the copyright test of "individuality".[37] In an older judgment, an exception was made for particularly witty and intelligent anagrams.[38] Such exceptions, however, are extremely rare. Generally, even unusual word creations[39] and names of fictitious characters will not be protected by copyright.

21 **Advertising slogans** can be registered as trade marks, provided the application is not rejected on the basis of absolute grounds of refusal, in particular for lack of (concrete) distinctiveness (§ 8 II No. 1 MarkenG) or descriptiveness (§ 8 II No. 2 MarkenG).[40] Unlike former German practice, neither the OHIM nor the Federal Supreme Court requires a higher level of distinctiveness for advertising slogans compared to other word marks.[41] Descriptive words or advertising slogans which are common to the trade may lack distinctiveness, whereas short, original, ambivalent or pithy slogans are more likely to be considered distinctive. Slogans may be considered distinctive for some classes of goods, while they lack distinctiveness for others. For example, the slogan "Test it" has been held to lack distinctiveness for tobacco products while being distinctive for matches.[42] **Copyright protection**, however, will regularly be **unavailable**. Most advertising

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37 Copyright protection denied by OLG München UFITA 51 (1968), 375 (377) – *Minicar*; OLG Frankfurt WRP 1973, 162 (163) – *Orgware*; *Dallmann*, Nachahmungsschutz für Werbeschlagwörter und Werbeslogans (2005), pp. 56 et seq.

38 KG GRUR 1971, 368 (370) – *Buchstabenschütteln*.

39 Copyright protection denied for the combination of the words „Heidelberg" and „bear" to „Heidelbear" by LG Mannheim ZUM 1999, 659 (660) – *Heidelbär*.

40 See *Dallmann* (note 37), pp. 96 et seq.

41 See BGH GRUR 2000, 321 (322) – *Radio von hier*; *Ingerl/Rohnke*, Markengesetz, 2nd ed. (2003) § 8, para. 146.

42 BGH GRUR 2001, 735 (736).

slogans are too short to satisfy the test of "individuality",[43] and in virtually all more recent decisions[44] copyright protection has been denied.

22 An issue which has given rise to court judgments and to some discussion among legal authors is the relationship between trade mark protection and copyright protection for **work titles**. Titles of printed media, films, works of music or dramas are protected without registration by the **sui generis right** provided by § 5 (3) MarkenG. They may also be protected as **trade marks**, although titles which only circumscribe the subject-matter of the work may lack distinctiveness.[45] While work titles in theory might be protected by copyright, they regularly do not satisfy the individuality test in practice[46] for the reasons mentioned in the preceding paragraphs. Nevertheless there is an issue of overlap, as it could be argued that every type of **protection for work titles** should lapse once the work enters the **public domain**. The Federal Supreme Court has rejected this argument in an instructive case concerning the work title "Winnetou". Winnetou is a fictitious Apache chief, who has been a favourite with generations of German youngsters. The figure was devised by the author Karl May (1842-1912). Although his works are in the public domain, the Federal Supreme Court held that the title "Winnetou" was still protected under § 5 (3) MarkenG. The Court pointed out that the **sui generis right to work titles** did **not unduly restrict the public domain** for two reasons.[47] First, everyone is free to reprint books under the original title, once copyright protection has elapsed. The owner of the title right only retains the right to prevent the use of the title for other works. Secondly, the scope of the title right is rather narrow. A risk of confusion can be avoided by the addition of further words. Hence, an adaptation of the Winnetou story published under the title "Winnetou's Return" was held not to infringe the titles "Winnetou I, II or III". While **trade mark protection** is **arguably broader** in both respects, the application for the registration of the title "Winnetou" as a trade mark has been rejected for lack of distinctiveness (§ 8 (2) No. 1 MarkenG), as the Federal Supreme Court considered this name as a generic word designating the archetype of an honest and noble Indian chief.[48] It is not

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43 Copyright protection denied by OLG Braunschweig GRUR 1955, 205 (206) – Hamburg geht zu E…"; OLG Stuttgart GRUR 1956, 481 (482) – "JA…JACoBI; see also *Dallmann* (note 37), pp. 56 et seq.

44 Copyright protection approved by OLG Köln GRUR 1934, 758 (759) – *Biegsam wie ein Frühlingsfalter bin ich im Forma-Büstenhalter*; OLG Düsseldorf BB 1964, 447 f. (but explicitly left open by BGH GRUR 1966, 691 (692) on appeal – *Ein Himmelbett als Handgepäck*).

45 BGH GRUR 2000, 882 (883) – *Bücher für eine bessere Welt*; BGH GRUR 2001, 1042 (1043) – *REICH UND SCHÖN*; *Grabrucker/Fink*, GRUR 2007, 267 (273); *Heim*, Der kennzeichenrechtliche Schutz des Filmtitels (2003), pp. 184 et seq.

46 BGH GRUR 1958, 354 (357) – *Sherlock Holmes*; *Loewenheim*, in: Schricker (note 10), § 2, para. 69.

47 BGH GRUR 2003, 440 (441) – *Winnetous Rückkehr*.

48 BGH GRUR 2003, 342 (343) – *Winnetou*.

altogether clear whether titles of public domain works are generally excluded from registration for media products. Some judgments suggest that the public generally does not regard work titles as indications of commercial origin but only as descriptions of the content of the work.[49] This is a strong argument for rejecting the registration of titles (at least of public domain works)[50] on the ground of descriptiveness (§ 8 (2) No. 2 MarkenG). Other judgments, however, only seem to regard generic titles as descriptive.[51]

3.2 Pictures, logos, logotypes

23 **Logos, devices, logotypes and pictures of all kinds** (including portraits,[52] depictions of products or even of buildings[53]) are eligible for trade mark protection,[54] subject to the general requirements. There is an extensive case-law on the issues of distinctiveness and descriptiveness of devices and pictures, which needs not be recollected here. Pictures of any type may also attract copyright protection (§ 2 (1) No. 4 UrhG). However, according to the prevailing view there is an important distinction between **works of pure art and works of applied art.** As far as trade mark registrations are concerned, utilitarian designs such as logos and logotypes will be much more frequent. These works only attract copyright protection, if they reflect the author's artistic individuality and if their level of creativity is well above common craftsmanship.[55] Simple everyday-type logos and logotypes will regularly not satisfy this requirement.[56] However, design protection may be available, as graphic symbols and typographic typefaces are considered as "products" within the meaning of the EC Designs Directive 98/71/EC (Art. 1 (b)) and the German Designs Act (§ 1 No. 2 GeschmG). Works of pure art are works which have not been specifically created for a utilitarian purpose. For this category of works, the standard of originality is not very strict; the "small coin" of copyright is also protected. Although every case must be decided on its individual merits, works which have not

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49 BGH GRUR 1958, 354 (357) – *Sherlock Holmes*; BGH GRUR 1993, 692 (693) – *Guldenburg*; *Ingerl/Rohnke* (note 41); § 15, para. 104.

50 See *Ingerl/Rohnke* (note 41), § 5, para. 105.

51 BGH GRUR 2003, 342 (343) – *Winnetou*; BPatG GRUR 2006, 593 – *Der kleine Eisbär*; BPatG, 29 W (pat) 179/04 – *Petterson und Findus*.

52 Examples: BPatG GRUR 2006, 333 (portrait of Marlene Dietrich), BPatG, 29 W (pat) 81/98 (portrait of Michael Schumacher).

53 Example: BGH GRUR 2005, 257 – *Bürogebäude*. However, depictions of buildings are highly likely to lack distinctiveness, see OHIM R 1/2003-4, GRUR 2004, 1033.

54 *Ingerl/Rohnke* (note 41), § 3, para. 30.

55 BGH GRUR 1995, 581 (582) – *Silberdistel*. This distinction is criticised by some authors, see the references cited by *Loewenheim*, in: Schricker (note 10), § 2, para. 158.

56 OLG Hamburg MMR 2004, 607 (simple mobile phone logos not protected by copyright); LG Hamburg GRUR-RR 2005, 106 (logo of the former East German communist party not protected by copyright).

been created for the purpose of using them as trade marks or in advertising are much more likely to attract copyright protection than trade marks specifically designed by or for the applicant.

24 According to the general principles outlined above, trade mark protection, copyright protection and/or design protection can coincide in these cases. Apart from the specific issue of works which are in the public domain (see following paragraph), this overlap does not give rise to any difficulties. If the trade mark application is made by the author or with his consent, he or she can achieve dual protection. If, however, the author has not consented to the application, he or she can bring an action for cancellation of the mark (§§ 13 (2) No. 3, 51, 55 MarkenG) or rely on his or her copyright as a defence to a claim for trade mark infringement. The same applies to the relationship between the holder of a design right and the trade mark owner, as design rights count among the "other industrial property rights" classified as relevant earlier rights by § 13 (2) No. 6 MarkenG.

25 The issue of **trade mark protection for well-known works of art** has caused particular concern with respect to **famous paintings**. There is no hard and fast rule as to whether such works can be registered as trade marks. In many cases, the application will fail due to lack of (concrete) distinctiveness (§ 8 (2) No. 1 MarkenG). The Federal Patents Court (Bundespatentgericht) rejected the application of Leonardo's "Mona Lisa" as a trade mark for a wide range of products, arguing that reproductions of this painting were commonly used as product decorations in trade.[57] Since it was used as an eye-catching device, the public would not regard it as an indication of trade origin. In other cases, the application may be successful for some classes of products, but not for others: a depiction of Vermeer's "Girl with a pearl earring" may lack distinctiveness for jewellery, fashion and perfumes while being distinctive for technical devices.[58] As a thumb rule, it can be said that the better known the work is, the less likely it will be considered capable of distinguishing products.[59] While some authors criticise this practice as too restrictive,[60] the prevailing view agrees with the line of the courts. Some authors have gone further and argued that the protection of the public domain against monopolisation was a matter of public policy and that hence applications for registration of depictions of public-domain works always had to be rejected on the basis of § 8 (2) No. 5 MarkenG.[61] The Federal Patents Court has rejected this view,

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57 BPatG GRUR 1998, 1021 (1022).

58 Example given by *Jacobs* (note 17), p. 801 (810 et seq.).

59 *Jacobs* (note 17), p. 801 (809).

60 *Fezer*, Markenrecht, 3rd ed. (2001), § 8, para. 117 x et seq.

61 See note 28, above.

[62] as it would also deprive such trade mark owners of their rights who themselves commissioned the design of the mark. Finally, in extreme cases an application for registration of many works of art with the obvious intention of extorting licence fees from legitimate users of the work may be considered to have been made in bad faith (§ 8 (2) No. 10 MarkenG).

26 Should famous works of art be protected according to the principles outlined in the preceding paragraph, the **scope of protection** is nevertheless **restricted** in several important respects. **First**, as mentioned above (para. 5), only a **"trade mark use"** of the mark can constitute infringement. In many judgments the concept of "trade mark use" is understood as excluding the use of signs which does not indicate the commercial origin of products. This can be exemplified by a case in which a person had successfully applied for registration of the name and a famous portrait (painted by Elias Gottlob Haußmann) of Johann Sebastian Bach for a wide range of products, including china and glassware. The Meissen porcelain manufacture applied for a court declaration of non-infringement with regard to potential uses of the picture on china products. The declaration was granted on the ground that such use would be purely ornamental.[63] A more recent judgment, in which the Federal Supreme Court considered a purely ornamental use which evokes associations to the mark as "trade mark use" (see para. 5), casts some doubt on this approach. However, this recent judgment concerned a well-known word mark where such associations were likely. In cases concerning famous works of art the public will not normally associate the reproduction of the work with any trade mark. **Secondly**, the better known the work of art is, the less distinctive it is. Thus **protection against confusion** will be **limited** to cases of almost identical reproduction. **Thirdly**, while a work of art may be famous, it will **hardly ever become well-known as a trade mark** and will hence rarely qualify for the extended protection provided by Art. 5 (2) of the Directive or § 14 (2) No. 3 MarkenG, respectively.

3.3 Product shapes, packaging

27 The shape of a product or the shape of its packaging can be the object of a **design right**, if the shapes are new and original (see para. 8). They may also be **copyrightable** as works of applied art. In this category of works, however, the requirements of protection are stricter than for other types of work (paras 6, 23). Thus, only creations which are well above the general level of craftsmanship will be protected by copyright. Inter alia, copyright protection has been applied to pieces of design furniture,[64] to comic and toy figures[65] and to jewellery[66].

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62 BPatG GRUR 1998, 1021 (1023) – *Mona Lisa*.

63 OLG Dresden NJW 2001, 615 (616); *Götting*, GRUR 2001, 615 et seq.

64 BGH GRUR 1961, 635 (637) – *Stahlrohrstuhl*; BGH GRUR 1987, 903 – *Le-Corbusier-Möbel*.

28 Since the shape of a product or the shape of its packaging can constitute a "sign" in the trade mark sense, **trade mark rights** on the one hand and **design rights** or **copyright may well overlap** in this area. The Trade Mark Directive attempts to at least partially avoid this overlap by providing that a sign which consists exclusively of a shape which results from the nature of the goods themselves or of a shape which gives substantial value to the goods cannot be registered (Art. 3 (1) e = § 3 (2) No. 1, 3 MarkenG). These **absolute grounds of refusal**, if applied strictly, could exclude the majority of all attractive product designs from trade mark protection. The courts, however, have applied these grounds of refusal very sparingly[67] and have rather focussed on the distinctiveness of the product shape with respect to the goods for which protection is sought (Art. 3 (1) b of the Directive = § 8 (2) No. 1 MarkenG).[68] The reason may be that a lack of distinctiveness may be overcome by showing distinctiveness acquired through use (§ 8 (3) MarkenG),[69] whereas the strict exclusions concerning product shapes do not contain a comparable exception.

29 The conditions of protection of design law and trade mark law differ (see paras 3, 8).[70] Nevertheless, the same factors can be taken into account when determining novelty and originality on the one hand and distinctiveness on the other hand. In both cases shapes which belong to the common stock of trade will not be protected. However, in the last few years the European and German courts have tended to apply **rather strict criteria of distinctiveness** to applications for three-dimensional marks,[71] although some restrictive judgments of the Federal Patents Court have been overruled as too strict by the Federal Supreme Court.[72] While in theory the standard of distinctiveness required for three-dimensional marks is not higher than

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65 BGH GRUR 1960, 251 (252) – *Mecki-Igel II*; GRUR 1992, 697 (698) – *ALF*.

66 OLG Düsseldorf GRUR-RR 2001, 294 (296) – *Spannring*.

67 Most reported cases on Art. 3 (1) e of the Directive and § 3 (2) MarkenG concern the exclusion of shapes which serve a technical purpose, see ECJ, C-299/99, GRUR 2002, 804 – *Philips/Remington*; BGH GRUR 2006, 539 – *Rasierer mit drei Scherköpfen*; BPatG GRUR 2005, 333 – *Kraftfahrzeugteile.*

68 On the parallel application of Art. 3 (1) e and b see ECJ, C-53-55/01, GRUR 2003, 514, paras 66 et seq. – *Linde, Winward, Rado.* In the following cases German courts have considered product shapes not to be excluded from registration as such on the basis of § 3 (2) MarkenG, but have focussed on the issue of concrete distinctiveness: BGH GRUR 2004, 502 – *Gabelstapler II* (fork-lift truck); BGH GRUR 2004, 506 – *Stabtaschenlampen II* (torch); BGH GRUR 2004, 507 – *Transformatorengehäuse* (transformer box); BPatG GRUR 2005, 327 – *Waschmitteltablette* (detergent tab).

69 Example: BGH GRUR 2006, 679 – *Porsche Boxster*.

70 These differences are explored in detail by *Eichmann*, MarkenR 2003, 10 et seq.

71 See the most recent annual reports of the cases decided by the Federal Patents Court: *Grabrucker/Fink*, GRUR 2007, 267 (268 et seq.); GRUR 2006, 265 (267 et seq.).

72 BGH GRUR 2004, 239 – *Käse in Blütenform*; BGH GRUR 2004, 502 – *Gabelstapler II*; BGH GRUR 2004, 506 – *Stabtaschenlampen II.*

for other types of marks,[73] the courts also assume that the public frequently does not understand the shape of goods as a reference to their commercial origin.[74] It has also been stressed that there is a common interest in common shapes being freely available in trade.[75] Many common shapes such as the shape of a car,[76] a torch,[77] a detergent tab,[78] of carving-ski[79] or the flower-shape of cheese[80] have been held to lack distinctiveness or to be descriptive of the quality – namely the outward appearance – of the respective goods.[81] While it is difficult to generalise, it seems that the level of originality required for design protection is lower[82] than the level of distinctiveness required for trade mark protection. If this observation is right, it takes due account of the fact that the term of a design right is limited whereas a trade mark right is potentially permanent.

30 The matter is further complicated by the fact that the imitation of products which are of "competitive originality" may constitute **unfair competition**, if **additional factors of unfairness** are present (§ 4 No. 9 UWG, see para. 10). A product imitation will be considered unfair if it creates confusion as to the trade origin of the products which could have been avoided (§ 4 No. 9 (a)) or if the reputation of the imitated product is exploited or damaged (§ 4 No. 9 (b)). There is an obvious parallel between these factors and the elements of trade mark infringement. The relevant statues seem to assume that trade mark law, design law and unfair competition law can coexist freely, as both trade mark law (§ 2 MarkenG) and designs law (Art. 96 of the Community Design Law Regulation and Art. 16 of the Designs Directive) explicitly allow additional protection. The Federal Supreme Court, however, has repeatedly held that trade mark law takes priority over unfair competition law,[83] but

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73 ECJ, C-53-55/01, GRUR 2003, 514, para. 46 – *Linde, Winward, Rado;* BGH GRUR 2006, 679, para. 16 – *Porsche Boxster*.

74 ECJ, C-53-55/01, GRUR 2003, 514, para. 48 – *Linde, Winward, Rado;* BGH GRUR 2006, 679, para. 16 – *Porsche Boxster*.

75 ECJ, C-53-55/01, GRUR 2003, 514, para. 73 – *Linde, Winward, Rado;* BGH GRUR 2006, 679, para. 21 – *Porsche Boxster*.

76 BGH GRUR 2006, 679 – *Porsche Boxster.*

77 BPatG, 32 W (pat) 91/97 – *Taschenlampen II.*

78 BPatG GRUR 2005, 327 – *Waschmitteltablette*

79 BPatG, 26 W (pat) 342/03 and 343/03 – *Carving-Ski*.

80 BPatG, 28 W (pat) 95/99 – *Käse in Blütenform.*

81 Although this obstacle can be overcome if distinctiveness has been acquired through use, see para. 27.

82 See also *Eichmann*, in: Eichmann/v. Falckenstein, Geschmacksmustergesetz, 3rd ed. (2005), § 2, para. 13 (level for granting design protection should not be set too high).

83 BGH GRUR 1999, 161 (162) – *MAC Dog*; BGH GRUR 2002, 340 (342) – *Fabergé*; BGH GRUR 2002, 622 (623) – *shell.de*.

the exact scope of this principle of "priority of trade mark law" is far from clear.[84] In some cases, the Court has assumed without further analysis, that product imitation and trade mark infringement were two distinct issues[85] and that hence unfair competition protection was not excluded by trade mark law.

31 A case recently decided by the Federal Supreme Court highlights the considerable potential for overlap between the different regimes of protection.[86] A manufacturer of jeans, the design of which was original and distinctive, sought to prevent the sale of imitations. Although the claimant had apparently not applied for either a registered design right or a trade mark, both rights might have been available. The design of the jeans was original and it was probably also new.[87] Protection as a three-dimensional mark might also have been possible, in particular because there was evidence that consumers related the appearance of the jeans to one particular manufacturer. However, the Federal Supreme Court enjoined the offer of imitations on the basis of unfair competition law, as the jeans were of "competitive originality" and as there was a risk of consumers being misled with respect to the commercial origin of the jeans. The Federal Supreme Court considered the relationship between designs law and unfair competition law and held that the possibility of design protection did not exclude unfair competition protection. The Court particularly stressed that designs law did not protect against causing confusion among consumers as to the trade origin of the imitated goods. Surprisingly, however, the Court did not consider the relation between unfair competition law and trade mark law, although protection against confusion is the first and foremost purpose of trade mark law. While some commentators do not object to this **accumulation of designs law, trade mark law and unfair competition law**,[88] others argue that unfair competition protection should be treated as **subsidiary** to intellectual property law and should be excluded whenever intellectual property protection would have been available.[89] As for trade mark law, too generous protection against unfair competition could result in a de facto protection of signs where the registration of a three-dimensional mark would be excluded because of a lack of distinctiveness. As for designs, generous unfair competition protection,

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84 See *Bornkamm*, GRUR 2005, 97 et seq.; *Ingerl*, WRP 2004, 809 et seq., *Steinbeck* in: Ahrens/Bornkamm/Kunz-Hallstein (eds), Festschrift für Eike Ullmann (2007), pp. 409 et seq.

85 BGH GRUR 2003, 332 (336) – *Abschlussstück*; BGH GRUR 2007, 339, para. 19 – *Stufenleitern*.

86 BGH GRUR 2006, 79, para. 24 – *Jeans I.*

87 The Supreme Court did not examine novelty in a design law sense, thus the relevant facts have not established.

88 *Bartenbach/Fock*, WRP 2002, 1119 (1123); *Köhler*, in: Hefermehl/Köhler/Bornkamm, Wettbewerbsrecht, 25th ed. (2007), § 4, paras 9.8 et seq.; *Osterrieth*, in: Keller/Plassmann/v. Falck (eds.), Festschrift für Winfried Tilmann (2004), p. 221 (223); *Rahlf/Gottschalk*, GRUR Int. 2004, 821 (826).

89 See *Ohly*, in: Festschrift Ullmann (note 84), 795 (806 et seq.); *Piper*, in: Piper/Ohly, UWG, 4th ed. (2006), § 4, para. 9/6; see also *Sambuc*, in: Harte/Henning (note 13), § 4, paras. 29, 42.

which is not generally limited to a fixed period of time, runs the risk of undermining the three-year term provided for unregistered designs by the Regulation on Community Designs.

3.4 Sounds

32 Sounds may be registered as trade marks.[90] They can be represented graphically by written music,[91] whereas German law has abolished the possibility of filing sonograms.[92] Melodies may also attract copyright protection as works of music (§ 2 (1) No. 2 UrhG). Again, the crucial factor is the test of individuality. Single notes or very short combinations of notes (such as the four-note signal used by German Telekom in its television and radio advertisements) will regularly not qualify for copyright protection, whereas longer melodies may.

33 As with works of visual arts, the question arises whether **melodies** can be registered as sound marks, which are in the **public domain**. A case deciced by the ECJ,[93] in which the first few notes of Beethovens “Für Elise” had been registered, is an example in point. The ECJ, however, did not consider this issue but only laid down requirements for graphical representation. The principles outlined above also apply here: there is no general exclusion of registration, but distinctiveness may well be lacking since the public generally does not understand well-known melodies as indications of commercial origin.

3.5 Smells

34 At present, smells cannot be registered as trade marks. While they may, in principle, constitute “signs” in a trade mark sense and while they may in some cases even be capable of distinguishing products, there is no reliable way of representing smells graphically.[94] While the Dutch Supreme Court[95] has held that perfumes may be copyrightable, there is no German court decision on this point. Thus, an overlap between copyright and trade marks in this area seems highly unlikely.

4 Summary and key issues

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90 ECJ, C-283/01, GRUR 2004, 54, para. 41 – *Shield Mark/Kist.*

91 ECJ, C-283/01, GRUR 2004, 54, para. 62 – *Shield Mark/Kist.*

92 See § 11 (2) Markenverordnung.

93 See note 90.

94 See note 4.

4.1 First issue: conditions of protection

35 The first issue arises from the difference between the respective criteria of protection. Wherever two rights grant similar protection, generous criteria for the grant of one right may undermine stricter criteria which may exist for the grant of the other right.

36 As between **copyright** and **trade mark law**, the criteria of protection are quite different, which in part reduces the potential of overlap. Due to the copyright requirement of "individuality", the vast majority of all word marks is not copyrightable. Since German copyright law applies stricter criteria to works of applied art than to works of other categories, many figurative and three-dimensional marks will not be protected by copyright either. Only where works such as paintings or pieces of music have been created for non-trade mark purposes is there a considerable degree of overlap.

37 As for **product designs**, there are **evident parallels** between the criteria of protection in design law and in trade mark law. The more distinct a particular product shape is from the common stock of forms, the more likely it is to be considered **distinctive** in a trade-mark sense and **original** in a design-law sense. Recent case-law, however, suggests that stricter standards apply to the distinctiveness of three-dimensional signs in a trade marks sense than to originality in a design law sense.

38 The relationship between **trade-mark law** and **unfair competition law** is unclear. While in theory trade mark law takes precedence over unfair competition law, the courts have sometimes been prepared to protect distinctive product features against imitation without analysing in detail whether these product features would have satisfied the criteria of distinctiveness provided by trade mark law. Arguably this approach may in some cases undermine the criteria of trade mark protection.

4.2 Second issue: term of protection

39 The second issue arises from the different terms of protection. Whenever one intellectual property right expires, ongoing protection on the basis of another right has the potential of **unduly restricting the public domain**.

40 Copyright is limited to 70 years post mortem auctoris, design rights elapse after a maximum term of 25 years (registered designs) and 3 years (unregistered designs) respectively. Trade mark rights, on the other hand, can be extended infinitely. Unfair competition protection can also be granted without temporal restrictions, although in

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95 Dutch Supreme Court, judgment of 16 June 2006, AMI 2005/06, 161; *Cohen Jehoram* [2006] EIPR 629; copyright protection was denied, however, by the French Cour de Cassation, judgment of 13 June 2006, [2006] ECDR 380.

some cases the courts have restricted protection to a reasonable period of amortisation.

41 There is no general rule which would exclude **works** from trade mark registration **after the end of copyright protection** or render such trade marks liable to be cancelled. Indeed, the trade mark may have been specifically designed for the trade mark owner. However, there are **two ways of safeguarding the public domain** for works of literature and art. First, trade mark registration of works which were not specifically created for the purpose of distinguishing products may fail due to lack of distinctiveness. The more famous a work of art is, the less likely it will be considered capable of distinguishing products. Secondly, typical uses of works of art such as the display of a painting or the performance of a piece of music do not constitute trade mark use and hence do not infringe potential trade marks in the works. A specific issue which has given rise to some judgments is the protection of **work titles**, either as trade marks or under the sui generis regime provided by § 5 (3) MarkenG. Specific care must be taken that the titles of public domain works can be used without restriction. Arguably the titles of works cannot be protected as trade marks any more after the work has entered the public domain, either because distinctiveness is lacking or because the title is considered descriptive. The sui generis right will still be available, but it is not infringed by the use of the correct title for the correct work.

42 **Trade mark protection for three-dimensional marks** has a certain tendency to undermine the temporal limits of **design protection**. To some extent this is inevitable, as creative designs may well serve as an indication of commercial origin. Also the courts attempt to restrict this danger by applying strict standards to the distinctiveness of three-dimensional signs.

43 Since **unfair competition protection** against product imitation is not per se subject to a specified term, too generous a protection of product shapes after the expiry of a potential design right might undermine the statutory distinction between the three-year period of protection for unregistered Community designs and the 25-year-term of registered designs.

4.3 Third issue: exceptions from protection

44 German intellectual property law does **not** contain **broad fair use exceptions**. Exceptions are well-defined and only concern specific situations. **Most of the exceptions** made by trade mark law on the one hand and copyright law on the other hand are **incongruent**. The owner of overlapping rights in the same object may thus practically be able to avoid all exclusions by relying on the right whose exclusions do not apply. Sometimes it may be possible to give precedence to the same public interest on the basis of different exceptions, as in the case of parody,

which is considered as free use in copyright law whereas it may be regarded as “justified” in the sense of § 14 (2) No. 3 MarkenG. Nevertheless these cases pose intricate problems. It is submitted that an entirely satisfactory solution has not been found yet.

……	……
Dr. Hans Peter Kunz-Hallstein (President)	Dr. Michael Loschelder (Secretary General)