

# Commercial Designations

## 1. General

According to Sec. 5 (1) MarkenG commercial designations are subdivided into company signs, Sec. 5 (2) MarkenG, and titles of works, Sec. 5 (3) MarkenG.

## 2. Company Signs

Pursuant to Sec. 5 (2) 1 MarkenG, company signs are signs used in trade as a name, company name or special designation of a business operation or an enterprise. They must be distinctive and enjoy protection from the time of use.

Signs which are not distinctive do not obtain protection until they have acquired a reputation in the relevant public as the designation of a particular undertaking (BGHZ 21, 85, 89 - *Spiegel*).

### a) Name

The name corresponds in content to Sec. 12 BGB. This includes not only the family name of natural persons, but also the artist's name and the pseudonym. By analogous application, figurative signs which have a traditional name function, such as a coat of arms or a landmark, are also covered (BGH, GRUR 2002, 917, 918 – *Düsseldorfer Stadtwappen*; GRUR 1976, 644, 646 - *Kyffhäuser*; GRUR 1993, 151, 153 - *Universitätseblem*; GRUR 1994, 844, 845 – *Rotes Kreuz*). Names of legal entities under private and public law are also protected (BGH, GRUR 1976, 644, 646 - *Kyffhäuser*; GRUR 1993, 151, 153 - *Universitätseblem*).

## **b) Business Name**

The company name within the meaning of Sec. 5 (2) 1 MarkenG is the business name according to Sec. 17 et seq. HGB (Commercial Code), i.e. the name under which a merchant conducts his business.

## **c) Special designation of a business operation**

A special designation of a business operation is understood to be an identifier used by an entrepreneur to distinguish his business from the businesses of others. In contrast to the name and business name, the designation does not refer to the company owner, but to the organizational unit.

For example, all letter combinations with a name function fall within the scope of protection, unless they are exceptionally generic or descriptive (BGHZ 21, 85, 88 - *Spiegel*). It is not necessary that the sign is pronounceable (BGH, GRUR 2001, 344, 345 - *DB- Immobilienfonds*). The Federal Court of Justice has denied the name function for the illustration of a building (BGH, GRUR 2005, 419, 422 - *Räucherkatze*), but according to the literature this should not apply to illustrations in general (*Ingerl/Rohnke*, 3rd ed. 2010, Sec. 5 MarkenG, para. 29).

## **d) Business signs**

Pursuant to Sec. 5 (2) 2 MarkenG, business signs and other signs intended to distinguish the business operation from other business operations, which are regarded as signs of the business operation within affected trade circles shall be deemed equivalent to the special designation of a business operation.

They serve to distinguish the business from other businesses in a way other than by means of a name (BGH, GRUR 2005, 419, 422 - *Räucherkatze*). According to this, e.g.

pictures, figures, symbols, ornaments and colors may be protected. Furthermore, also words that do not have the effect of names.

### **3. Titles of works**

The term "work" is to be considered independently of the term "work" under copyright law. Titles of works are the names or special designations of printed publications, cinematic works, music works, stage works or other comparable works, Sec. 5 (3) MarkenG.

If a title of work has the required distinctive character, protection begins with the use of the title, otherwise only with the acquisition of reputation. Depending on the category of work, case law applies different standards to the distinctive character.

The mere intention to use a title does not constitute use of the title. Title protection may arise prior to actual use through public announcement of the work under its title as is customary in the industry, e.g. through the "Titelschutz-anzeiger". However, the announcement only has effect if the work appears under the title within a reasonable period of time.

### **4. Negative right of exclusion**

The negative right of exclusion under Sec. 15 MarkenG largely corresponds to that for trade marks under Sec. 14 MarkenG.

However, in contrast to the trade mark, the protection under Sec. 15 (1) MarkenG may be geographically limited. Whereas the protection of the trade mark exists nationwide, the protection for commercial designations, *if* the company is only known locally, also applies only in this particular place or the closely related economic territory.

Although the similarity of the business activities is not a prerequisite for a right to exclude under Sec. 15 (2) MarkenG, there is a correlation between the degree of similarity of the commercial designations and the degree of proximity to the industry (BGH, WRP 1991, 568, 569 - *Avon*).