

Absolute Grounds for Refusal

Absolute grounds for refusal must be examined ex officio prior to registration of the trade mark pursuant to Sec. 37 (1) MarkenG. These are in the following:

1. Not capable of being represented on the register, Sec. 8 (1) MarkenG, Art. 3 MRL

The mark must be capable of being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of protection.

Materially, the so-called "Siekmann" criteria apply: The representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective (ECJ, GRUR Int. 2003, 449 - *Siekmann*).

2. Devoid of distinctive character, Sec. 8 (2) No. 1 MarkenG, Art. 4 I lit. b) MRL

Trademarks which are devoid of any distinctive character are excluded from registration. The subject matter of Sec. 8 (2) No. 1 MarkenG is the concrete distinctiveness, cf. slide Distinctiveness.

Any distinctive character, however slight, is sufficient to overcome this ground for refusal (BGH, GRUR 1999, 1096 - *Absolut*).

Cases of lack of distinctiveness are:

Figurative marks:

Simple geometric shapes; lifelike renderings of products or product packaging.

Word marks:

Generic product designations or common words of the German or a known foreign language (BGH, GRUR 1999, 1089 - *YES*; GRUR 1999, 1093 - *FOR YOU*; GRUR 2000, 97 - *Fünfer*).

The same principles apply to slogans (ECJ, GRUR 2010, 228 - *Audi*, para. 35). An imaginative surplus or an independently identifying element, such as a company sign, are not required (BGH, GRUR 2002, 1070, 1071 - *Bar jeder Vernunft*). Merely descriptive statements or praise and advertising statements of a general nature are not sufficient (BGH, WRP 2000, 301 - *Partner with the Best*). Indications for the distinctiveness of slogans can be brevity, a certain originality and conciseness of a word sequence as well as ambiguity and need for interpretation (BGH, GRUR 2002, 1070, 1071 - *Bar jeder Vernunft*). Longer word sequences are generally devoid of any distinctive character (BGH, GRUR 2010, 935 - *Die Vision*).

Color marks:

ECJ, GRUR Int. 2003, 638 para. 55, 65 - *Libertel Groep ("Color Orange")*: A color mark is not necessarily perceived by the relevant public in the same way as a word or figurative mark.

Consumers are not in the habit of making assumptions about the origin of goods from the color of goods or their packaging without graphic or word elements.

In addition, there is an increased general interest in the free availability of colors.

Shape marks:

If the three-dimensional mark is consistent with the external appearance, this is not regularly perceived by the public as an indication of origin in the same way as a word or figurative mark. Such an indication only exists if the shape departs significantly from the norm or customs of the sector (see ECJ, GRUR 2003, 514, 517 - *Linde*; ECJ, GRUR 2004, 428, 431 - *Henkel*; ECJ, GRUR Int. 2004, 631, 633 - *Procter & Gamble*; ECJ, GRUR Int. 2005, 135, 137 para. 31 - *Mag Instrument*).

Tactile marks:

With regard to the indication of origin, there is a parallel to three-dimensional marks. Thus, even in the case of a beverage packaging that conveys "the rough feeling of fine sandpaper", the public will only assume a "functional or aesthetically pleasing design of the goods packaging" (BPatG, GRUR 2008, 348, 350 - *Tastmarke*).

3. Descriptive indications, Sec. 8 (2) No. 2 MarkenG, Art. 4 I lit. c) MRL

According to Sec. 8 (2) No. 2 MarkenG, trademarks consisting exclusively of descriptive indications are excluded from registration (often overlapping with Sec. 8 (2) No. 1 MarkenG). In the case of these indications, there is a general interest that they may be freely used by anyone.

The need to keep products free is also cited by the Federal Court of Justice (BGH) to protect the "freedom to design products", which could be jeopardized if common designs of products are to be registered as shape marks (e.g. BGH, GRUR 2008, 1000 - *Käse in Blütenform II*).

4. Customary designations, Sec. 8 (2) No. 3 MarkenG, Art. 4 I lit. d) MRL

Trade marks are excluded from registration under Section 8 (2) No. 3 MarkenG if they have become customary designations.

A distinction must be made between generic designations and non-proprietary signs. Generic designations already fall under Sec. 8 (2) No. 1 and 2 MarkenG. Non-proprietary signs are originally distinctive signs which are used by several companies to designate certain goods or services and are therefore no longer understood by the public as signs (BGH, GRUR 1999, 1090 - *YES*).

The provision is to be interpreted very restrictively, since otherwise the trade mark would become a victim of its own success (e.g. "Uhu", "Tempo" and "Aspirin" are not yet nonproprietary marks; however, the Austrian OGH held "Walkman" to have become customary, WRP 2002, 841).

5. Deceptive designations, Sec. 8 (2) No. 4 MarkenG, Art. 4 I lit. g) MRL

Pursuant to Sec. 8 (2) No. 4 MarkenG, designations which are of such a nature as to deceive the public, in particular as to the nature, quality or geographical origin of the goods or services, are excluded from registration as trade marks. In this case, an application will only be refused if the suitability for deception is obvious (Sec. 37 (3) MarkenG).

Examples include a cow head or butter churn for margarine or a bull image for imitation leather.

6. Designations contrary to morality, Sec. 8 (2) No. 5 MarkenG, Art. 4 I lit. f) MRL

Pursuant to Sec. 8 (2) No. 5 MarkenG, trademarks shall not be registered if they are contrary to public policy or accepted principles of morality. A trade mark is immoral if it significantly offends the moral or ethical sensibilities of a wide public, e.g. "Ready to fuck" (BGH, GRUR 2013, 729) or "Headfuck" (BPatG, GRUR-RR 2013, 253).

An infringement of public policy requires a violation of the essential principles of German law (BGH, GRUR 1987, 525, 526 - *LITAFLEX*), e.g. "Dalailama" (BPatGE 46, 66 - *Dalailama*).

7. Other obstacles according to Sec. 8 (2) MarkenG:

Not registrable are domestic state emblems, state coats of arms, state flags, including those of municipalities, as well as coats of arms, flags or other signs of international intergovernmental organizations, Sec. 8 (2) No. 6, 8 MarkenG, Art. 4 I lit. h) MRL, e.g. "D-Info" in federal colors (BPatG, MarkenR 2005, 279).

Not registrable are official test or guarantee marks, Sec. 8 (2) No. 7 MarkenG, Art. 4 III lit. a) MRL, e.g. a calibration stamp.

According to Sec. 8 (2) No. 9 - 12 MarkenG, Art. 4 I lit. i) - l) MRL, certain protected designations are not registrable, namely

- geographical indications of origin,
(cf. Sections 126 et seq. MarkenG, Regulation No. 1151/2012)
- traditional designations for wines,
(cf. VO 1308/2013)
- traditional specialties (cf. VO 1151/2012) and
- Plant variety designations (cf. SortG)

Also not registrable are trade marks whose use may be prohibited under other provisions in the public interest, Sec. 8 (2) No. 13 MarkenG, Art. 4 III lit. c) MRL, e.g. "Reefer" (= marijuana cigarette) because of Sec. 30 BtMG (prohibition of advertising) for cigarettes (BPatGE 38, 127, 129 - *REEFER*).

Finally, trademarks whose application was filed in bad faith are not registrable, Sec. 8 (2) No. 14 MarkenG, Art. 4 II 2 MRL. Bad faith must be obvious to the DPMA under Sec. 37 (3) MarkenG. The purpose is to prevent the emergence of unjustified monopolies, e.g. by so-called blocking marks, by which only the use by third parties is to be prevented.

8. Well-known marks, Sec. 10 MarkenG

Trade marks are excluded from registration if they are identical with or similar to a trade mark that is well known in Germany within the meaning of Article 6^{bis} of the Paris Convention and if the other requirements of Sec. 9 (1) No. 1, 2 or 3 MarkenG are met, Sec. 10 (1) MarkenG.

According to Sec. 37 (4) MarkenG the authorities must know of the fact that the earlier trade mark is well known and the requirements of Sec. 9 (1) No. 1 or 2 MarkenG must be fulfilled. The relative grounds for refusal under Sec. 9 MarkenG correspond to the negative rights of exclusion under Sec. 14 (2) MarkenG.