

Trade Mark Use

The infringement provisions of Sec. 14 (2) MarkenG require use as a trade mark in the sense of the function of origin. Accordingly, the trade mark must be used to distinguish goods and services as those of a particular undertaking (ECJ, GRUR Int. 1999, 438, para. 38 - *BMW*).

Use as a trade mark also exists if another's trade mark is used to make services distinctive, e.g. to refer to the repair of a certain vehicle brand (ECJ, GRUR Int. 1999, 438 - *BMW*). A reference to one's own undertaking is not necessary, the reference to the origin of the product from another undertaking is sufficient (ECJ, GRUR 2008, 698, para. 36 - *O2 Holdings and O2 (UK)*; BGH, GRUR 2005, 423, 425 - *Staubsaugerfiltertüten*).

1. Special cases:

Toy cars (ECJ, WRP 2007, 299, para. 23 - *Adam Opel AG*; LG Nürnberg-Fürth, WRP 2007, 840, 842 - *Opel ./ Autec*): The public is used to similarity to the original and even attaches importance to it, but also knows that there is no relationship between model and car manufacturer.

Color marks (BGH, GRUR 2004, 154 - *Farbmarkenverletzung II*): As a rule, the average consumer is not yet accustomed to the use of a color as a distinctive sign.

However, an exception exists if the color is emphasized in such a way that it is understood as a means of identification.

Shape marks (BGH, GRUR 2005, 414 - *Russisches Schaumgebäck*): The consumer regularly sees in the shape only the product itself and not yet an indication of the origin from a certain undertaking.

Metatags (BGH, GRUR 2007, 65 - *Impuls*): Although the user does not take note of the sign in the source text of the website, there is trade mark use because the hit rate in search engines is increased and the user is thus referred to the advertiser's offer.

Keyword advertising (ECJ, GRUR 2010, 445 - *Google and Google France*): As a keyword, the trade mark is the trigger for the appearance of the advertisement.

2. Referential use

Since, according to the case law of the ECJ, no distinction is made as to whether the goods or services in question are those of the user of the trade mark or those of a third party, the term "use as a trade mark" also includes referential use, where it is unambiguously clear to the addressee that the mention of the trade mark is not intended to identify the goods or services of the user of the trade mark, but only those of a third party, namely precisely those of the trade mark owner. The main cases of this referential use are

- brand critique,
- brand parody and
- comparative advertising.

With the reform of 2015, the limitation provision of Sec. 23 (1) No. 3 MarkenG was supplemented for these cases by the wording "for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark". Even before this amendment, special principles applied to comparative advertising. Use as a trade mark is assumed regardless of whether the comparative advertising complies with the requirements of unfair competition law (ECJ, GRUR 2008, 698, para. 36 - *O2 Holdings and O2 (UK)*; GRUR 2009, 756, para. 53 - *L'Oréal*). However, the use cannot be prohibited if the comparative advertising fulfills the requirements of Sec. 6 (2) UWG or Article 4 RL 2006/114/EC. Conversely, a likelihood of confusion under trade mark law leads to inadmissibility under unfair competition law (ECJ, GRUR 2008, 698, para. 46, 50 - *O2 Holdings and O2 (UK)*).