
German Federal Supreme Court: Proof of acquired distinctiveness – Requirement of “use as a trademark” – Defining the product category and subject matter for opinion surveys (decision of July 9, 2015 – Case I ZB 65/13 – Nivea-Blau/Nivea Blue)
Reported by Prof. Dr. Alexander von Mühlendahl

The German company Beiersdorf AG is proprietor of the German trademark No 305 71 072, registered in 2007 on the basis of acquired distinctiveness, consisting of a single colour, blue, defined as Pantone 280C, and represented as follows:



The mark is registered for skin and body care products in class 3. Unilever, a competitor, requested cancellation of the registration as having been granted erroneously.

In first instance the Cancellation Division of the German Patent and Trademark Office granted the request. The German Federal Patent Court, in a decision of March 19, 2013, confirmed the cancellation. The Federal Patent Court considered that the degree of public recognition of the mark, as evidenced by a survey carried out in 2006, which showed a degree of recognition of 58 %, was not sufficient. Rather, for a single colour the degree of recognition should be at least 75 %. In its decision of July 9, 2015, the German Federal Supreme Court reversed and remanded.

The Federal Supreme Court decided that a degree of public recognition of above 50 % was sufficient to show acquired distinctiveness. The Court referred to a decision of the Court of Justice of the European Union of June 19, 2014, in Case C-217/13, *Deutscher Sparkassen und Giroverband & Oberbank/ Banco Santander – “Sparkassen-Rot”*, where the Court of Justice had confirmed its earlier rulings that no distinction should be made between categories of marks as regards the requirements for showing acquired distinctiveness, and had rejected the notion that in all cases of single colour marks at least 70 % of the public must recognize the colour as a mark (see BARDEHLE PAGENBERG IP-Report II/2014).

As regards the requirement that the use made of a mark to prove acquired distinctiveness must be use “as a trademark”, the German Supreme Court held that where there was proof of more than 50 % public recognition by means of a proper survey this would allow the conclusion that the use made of the mark – here the colour blue – was made not as decoration or ornamentation or background, but as a trademark. The Court referred to its earlier case law on the same issue when three-dimensional marks were involved. The same rules must apply to abstract colour marks.

The case was remanded to the Federal Patent Court with additional instructions as to the examination of acquired distinctiveness of abstract single colour marks.

First, as regards the colour itself, it would be required to show the interviewees the colour itself, and not as reproduced on a white



*Prof. Dr. Alexander
von Mühlendahl,
J.D., LL.M.
Attorney-at-Law*

BARDEHLE PAGENBERG
Partnerschaft mbB
Patentanwälte Rechtsanwälte

Prinzregentenplatz 7
81675 Munich
T +49.(0)89.928 05-0
F +49.(0)89.928 05-444
info@bardehle.de
www.bardehle.com

ISO 9001 certified

sheet of paper which left a white margin. This was required because it could not be excluded that the combination of white and blue, rather than the single colour blue, was identified by the interviewees.

Second, the product category “skin and body care products” was too broad a category, because it comprises many diverse sub-categories, such as hair care, skin care, dental

care, cosmetics, shower and bath products, deodorants, soaps, and after shave products. These products are so diverse that they cannot be grouped together as a single market. Asking in a survey for the broad category may not be appropriate to prove acquired distinctiveness in all these sub-categories.

Remarks

The “Nivea-Blau” decision faults the Federal Patent Court for setting too high barriers for the recognition of acquired distinctiveness (“secondary meaning”) for single colour marks. However, the Federal Supreme Court does not question the manner of proving acquired distinctiveness by means of an opinion survey. This remains the “best evidence” in German practice, regardless of the scepticism expressed by the Court of Justice originally in the “Chiemsee” decision (decision of May 4, 1997, Joined Cases C-108 & 109/97) and again repeated in the “Sparkassen-Rot” decision (decision of June 19, 2014, Case C-217/13).

Of practical relevance are the instructions given to the Federal Patent Court on remand. They are relevant because the Federal Patent Court actually did not go into the details of the opinion survey evidence relied upon by Beiersdorf because it considered the 58 % to be insufficient.

In a new survey, which will in any event be necessary, the broad product category (skin and body care products) will have to be broken down. Also, the colour shown to the interviewees must not have white visible. This is significant in the present case because Beiersdorf is using Nivea products usually with a blue and white get-up, but the registration is for blue only (called “Nivea Blue”).