



Press release dated September 19, 2022

BARDEHLE PAGENBERG routs Birkenstock in two preliminary injunction proceedings concerning copyrights for sandals

In each of two preliminary injunction proceedings, Birkenstock attacked four specific health sandal models of two Spanish family-owned companies (Penta Shoes S.L. and Calzados D'Simons S.L.) before the Regional Court of Cologne (Germany), arguing that the challenged sandals infringe its copyrights on its basic sandal models Madrid, Arizona, Boston, and Gizeh. Similar sandals have already been distributed by hundreds of companies for many years. Although only the question of infringement by eight specific sandal models was at issue in the present cases, the impact of these proceedings may go far beyond the specific subject matters.

Birkenstock, a German company purchased for allegedly approx. 4 billion Euros in 2021 by a global growth investor, is known for producing a broad range of various health sandals, *i.e.* sandals with a comfortable footbed and cork soles. Additionally, they are known for their aggressive conduct against other producers and resellers of health sandals. As regards its basic sandal models Madrid, Arizona, Boston, and Gizeh, they generally used to challenge competitors' health sandals on the basis of German unfair competition law in the past. Although they continued to raise claims based on unfair competition law regarding altered versions of these sandals, it seems that they no longer rely on unfair competition law regarding the original versions of the basic models. Notably, in May 2019, Birkenstock applied for three-dimensional EU trademarks, *inter alia* for those basic models, but for unknown reason withdrew these applications in February 2020 (reg. nos. 018061480, 018061481, 018061484, and 018061486).

However, in 2021, quite a while after the ECJ had rendered its Cofemel- and Brompton-decisions ([ECJ, judgement of September 12, 2019, C-683/17 – Cofemel](#); [ECJ, judgement of June 11, 2020, C-833/18 – Brompton](#)), Birkenstock started chasing competitors on the basis of copyright law. Since then, the Regional Courts of Cologne and Frankfurt am Main have ordered various preliminary injunctions in favor of Birkenstock, arguing that the challenged sandals infringed Birkenstock's copyrights. In contrast, the Regional Court of Hamburg had rejected Birkenstock's respective PI request – with a reasoning worth reading. However, this decision was overruled later by the Higher Regional Court of

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Hamburg. Thus, as far as known within the IP community, Birkenstock was successful without exceptions with its PI requests based on copyrights. This track record which, from the perspective of Birkenstock is outstandingly positive, has changed now:

On December 30, 2021, the Regional Court of Cologne granted a preliminary injunction in Birkenstock's favor, arguing that the four challenged sandals of the Spanish family-owned company Penta Shoes S.L. infringe Birkenstock's copyrights in the basic versions of its health sandal models Madrid, Arizona, Boston, and Gizeh. A first appeal ("Widerspruch") filed against this preliminary injunction with the same court remained without success. However, upon a further appeal ("Berufung") filed with the Higher Regional Court of Cologne, the Senate indicated in the hearing on August 19, 2022, that it tended to lift the PI and therefore reject Birkenstock's PI request. The Senate was of the opinion that Birkenstock had failed to prove that its four basic sandal models are qualified to claim copyright protection. It had not been proven that the sandal models were the result of an artistic-creative process and thus reached the necessary level of creation for a work of applied art. As a consequence, Birkenstock withdrew its PI request in the hearing, before the Senate rendered a decision regarding the appeal.

In the second PI proceedings – this time against the Spanish family-owned company Calzados D'Simons S.L – the Regional Court of Cologne (the same Chamber as in the above reported matter) had issued a PI on April 22, 2022, against four basic health sandal models allegedly infringing Birkenstock's copyrights in the above-mentioned four models. In the hearing of the appeal stage ("Widerspruch"), the Chamber indicated it would confirm the decision. Nevertheless, it was interested in the outcome of the case described in the paragraph above, and therefore set the date of rendering its decision to six days after the hearing before the appeal court in the other matter. In view of the outcome of respective proceedings, the defendant decided to file a request for preliminary stay of the enforcement proceedings two days before the announced date the decision was to be rendered. However, the Chamber did not have to decide about this request, because Birkenstock again withdrew its PI request on August 23, 2022.

In both cases, the reasoning of the PIs issued by the Regional Court of Cologne referred to expert opinions on technical issues and on legal issues that Birkenstock had filed together with their PI request. These expert opinions, however, were not mentioned in its warning letter sent to the defendants beforehand. In the course of the court proceedings, both parties filed further expert opinions, which allowed the courts a more thorough evaluation.

If you ever wondered why it is so difficult to find court decisions that are unfavorable for Birkenstock: It seems that part of Birkenstock's strategy is to withdraw their PI requests in cases where judges indicate that they will not render a decision in Birkenstock's favor. Nevertheless, this strategy is not applied in all kinds of proceedings. For example, only recently the German Federal Patent Court rendered a decision ordering the cancellation of Birkenstock's figurative trademark for the design of its outsole, the so called "bone-pattern" ("Knochenmuster") because it was not distinctive ([decision of June 17, 2022, case no. 29 W \(pat\) 10/19](#)). This decision is consistent with an earlier decision of the ECJ almost four years earlier, according to which this pattern is not qualified to claim trademark protection ([decision of September 13, 2018, case no. C-26/17](#)). Notably, in the PI cases described above, Birkenstock had also expressed the consideration that its bone-pattern could claim copyright protection – admittedly without explicitly claiming infringement thereof in the present proceedings. This was not decisive in the respective PI cases, but it will be interesting to see whether Birkenstock really wants to follow that route further and, accordingly, attack competitors based on alleged copyrights in a simple outsole pattern.

Despite the positive outcome for the defendants in the two reported PI cases, producers and resellers of basic health sandals should be prepared for the possibility that Birkenstock might nevertheless continue its strategy to send rather short warning letters and then file full steam PI requests. Thus, warning letters received from Birkenstock should be taken very seriously. As these recent cases have shown, despite the decisions of the German Constitutional Court in the last years focusing on the importance of the principle of equality of arms and the right to be heard in PI proceedings, under certain conditions German courts are still prepared to order preliminary injunctions without involving the defendant beforehand. Even without having received a warning letter, producers and resellers should consider filing protective briefs because gathering the required evidence and arguments might not be feasible within the deadline set by Birkenstock to respond to its warning letters.



Representatives of Penta Shoes S.L. and Calzados D'Simons S.L.:

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Representatives of Birkenstock:

Inhouse: Moritz Schumacher (Legal Counsel IP)

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SKW Schwarz (Munich, in court proceedings): Dr. Konstantin Wegner,

Pia Sökeland, Johanna Weiß, Dr. Anna Kellner

14th Civil Chamber of the Regional Court of Cologne:

Dr. Martin Koepsel (presiding judge)

6th Civil Senate of the Higher Regional Court of Cologne:

Hubertus Nolte (presiding judge)

BARDEHLE PAGENBERG combines the professional expertise of attorneys-at-law, patent attorneys, professional representatives before the European Patent Office, specialized trademark lawyers and qualified technical consultants. Our consulting services are tailored to our clients' individual needs and the specific circumstances of each case.

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