

Jurius

Community trade mark WINNETOU not deleted

CJEU – The General Court upholds publisher Karl-May’s action against the EU Trademark Office’s decision to annul the Community trade mark WINNETOU. The Office should not have granted the application for a declaration of invalidity brought by Constantin Film without assessing, independently, whether the sign Winnetou was descriptive for the goods and services at issue. (Judgment T-501/13)

Category: News

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[Rz 1] Since 2003, the German publishing house Karl-May has been the proprietor of the Community word mark WINNETOU, inter alia for films, printed matter, jewellery, perfumes, cosmetic articles, goods made of leather, household articles, clothing, games, foodstuffs, events and holiday camp services and for the transport of persons, accommodation and catering for guests.

[Rz 2] Following an application for a declaration of invalidity brought by the German company Constantin Film Produktion GmbH, the European Union Trademark Office (OHIM) annulled that mark in 2013, except with regard to «printers' type» and «printing blocks». For the other goods and services, the Trademark Office took the view, with reference to Winnetou, the fictional, noble and good Native American chieftain who is the main character in a series of novels by the German author Karl May and the protagonist of films, radio or theatre plays, that that sign was both descriptive and devoid of any distinctive character, so that it could not be protected as a mark or, consequently, be monopolised.

[Rz 3] By judgment of 18 March 2016, the **General Court upholds the action brought by the publishing house Karl-May against the decision of the Trademark Office and annuls that decision.**

[Rz 4] According to the Court, **OHIM infringed the principles of autonomy and independence which govern Community trade marks.**

[Rz 5] Instead of assessing, independently, whether the sign Winnetou was descriptive for the goods and services in question, OHIM treated the decisions of the German courts – according to which that term was descriptive and could not, therefore, be protected as a mark – as binding. OHIM also repeated that error by finding lack of distinctive character on the basis of the assessments relating to descriptiveness.

[Rz 6] The Court observes, furthermore, that **the Trademark Office failed to give sufficient reasons for its decision.**

[Rz 7] In particular, OHIM did not sufficiently explain the reasons why the sign Winnetou would be perceived, beyond its concrete meaning as an evocation of a fictional character, as generally referring to concepts of «Native American» and «Native American Chieftain».

[Rz 8] Moreover, the reasoning in relation to the descriptive character of the goods which OHIM grouped together under the category of «merchandising» goods is excessively general and abstract. Those goods cannot be regarded as constituting a homogenous category; in addition, OHIM merely stated that, for those goods, the sign Winnetou indicates that the goods are connected to films or the book character with regard to which the consumer will assume that they are merely «Winnetou» advertising goods and will not deduce their origin. A specific analysis of the nature and characteristics of the goods in question is therefore lacking.

[Rz 9] Since the Court has, by judgment, annulled OHIM's decision, OHIM must now rule again on the application for a declaration of invalidity brought by Constantin Film, taking into account the grounds of the Court's judgment.

Judgement of the CJEU T-501/13 of 18 March 2016 Karl-May-Verlag GmbH v OHIM

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