PAULY & PARTNER
Rechtsanwälte | Fachanwälte für Arbeitsrecht

Pauly & Partner | Kurt-Schumacher-Strasse 16 | D-53113 Bonn

Landgericht Braunschweig
9. Zivilkammer
- 9 O 319/10 *039* -
Münzstrasse 17
38100 Braunschweig

In the legal action
Forest Stewardship Council AC
./.
Gerriet Harms the registered merchant acting trading under the name of company eurobinia,

Az.: 9 O 319/10 *039*

we thank you initially for the granted extension of time.

We announce that on the day of the oral proceedings we will present the application editorial as follows:

1. The defendant is sentenced to, on pain of penalties from court in any case of infringement either of a certain amount of administrative fine up to 250.000,00€, alternatively an arrest for contempt of court, or the arrest for contempt of court up to six month, to refrain from

   a) using the following marks for commercial transactions

b) promoting goods and services presented by the commercial mark “eurobinia” on the website www.fragen-an-den-fsc.de by using the following symbol

or installing links on further owned websites such as www.eurobinia.de, www.eurobinia.net, www.robinie.de, or www.robinie.net, and

c) installing a link through the symbol

on the defendant's websites www.eurobinia.de, www.eurobinia.net, www.robinie.de, or www.robinie.net to the website www.fragen-an-den-fsc.de, which is equally operated by the defendant, and thereby promoting goods and services, presented as the commercial "eurobinia".

2. The defendant is sentenced to provide the plaintiff with information about in what amount, what edition, and with the help of what allocator he distributed or, as the case may be, still distributes the flyer, which is attached as **Attachment K1**, that the defendant offered as download on his website in both German and English language.

3. It is decided that the defendant is obliged to replace the plaintiff's disadvantage that resulted from and that will result from the defendant's actions as stated in clause 1.

4. The defendant bears the charges for this trial.

Concerning the statement of defence from April 24, 2010 we comment as follows:

A. Preliminary remark

The pleadings of the defendant make the impression that he would want to administrate a political campaign against the plaintiff which would solely be based on a dispute about trademark names. The defendant already criticises the plaintiff's certification system on his website www.fragen-an-den-fsc.de. The defendant obviously tries to see the local trial as a commercial opportunity in order to lead the allegation concerning the plaintiff's certification system unauthorised to a jurisdiction and to expose and convict the alleged wrong

impression of the plaintiff in a trial about trademark names. This impression is strengthened by the fact that the plaintiff writes about the local trial on his website www.fragen-an-den-fsc.de and even publishes the not obliterated original of the lawsuit on it.

Evidence: A copy of an excerpt from the defendant's website www.fragen-an-den-fsc.de as **Attachment K7**.

This proceeding astonishes just like the fact, that the defendant feels called in a trademark-based dispute to provide the obtaining of an expert evidence for the issue whether the certification systems of the plaintiff guarantee an ecological forest management. At this point it should be noted that, in line with this lawsuit, the only matter to be settled is to what extent the utilization of the plaintiff's trademark name "FSC" by the defendant has to be accepted by the plaintiff. The political instrumentalisation is to be omitted.

B. Facts

Therefore, regarding the pleadings of the defendant concerning the facts of the case, only those should be commented that contain accumulated issues by the defendant that seem substantial to the final judgment of this legal dispute.

1. First of all we convey the summonable address of the plaintiff. The plaintiff has by now changed her registered head quarters to the following address:

   Calle Margarita Maza de Juárez # 422
   Col. Centro
   68000 Oaxaca, Oaxaca
   Mexico

   Evidence: Excerpt from the website www.fsc.org, Attachtment K8.

As far as the defendant challenges the plaintiff's legal form, her agency agreement and an effective Court authorisation, the plaintiff comments as follows:

The plaintiff is an internationally active, non-profit organization domiciled in Oaxaca, Mexico. The plaintiff runs national work groups in more than 50 countries around the world. In addition, the plaintiff runs several local offices. The plaintiff is formed as "Associatión civil". This form corresponds to a registered association in Germany, which – in contrast to a capital company – permits a broad basis shareholding.

Evidence:
1. Excerpt of the home page of the plaintiff's website www.fsc.org as Attachment K9.
2. Excerpt of the website www.fsc.org with "Corporate Information" as Attachment K8.

The plaintiff is managed by a board of directors that comprises 9 members and that appoints among others a "sitting executive" for the functional business, de facto a chief executive officer of the board. Sitting executive of the board is Mr. Andre Giacini de Freitas. The board of the plaintiff gave general power of attorney for cases to the above named sitting executive as well as to Mr. Robert Waack and Ms Guillermina Garza del Toro, that can be claimed from all the fully authorised representatives together or of each fully authorised representative alone.

Evidence: Presentation of a translated excerpt of the "Bezeugung über die Ernennung eines amtierenden Direktors und Erteilung einer Generalvollmacht durch den Forest Stewardship Council A.C", copy as Attachment K10.

The proxy of the prosecution were authorised by Ms Guillerma Garza del Toro, who is also a fully authorised representative.

Evidence: Presentation of full authorisation of the prosecution, copy as Attachment K11.

2. The plaintiff is undisputed owner of the registration code 002974905 of the trademark "FSC" which is registered at the Office of Harmonization for the Internal

Market. The claim of the defendant that the plaintiff would not use the registered symbol, is incorrect.

The plaintiff uses the graphic symbol “FSC”, which is protected in her interest, on her own, and additionally licenses her subsidiary companies and their members to use it. Following in detail:

The plaintiff uses the trademark “FSC”, that is registered in her interest, for her total commercial activity and performs with this symbol in commercial communications. The graphic symbol is for instance applied on the website www.fsc.org as well as on every page that is linked to this domain.

Evidence: Excerpt from the plaintiff’s website www.fsc.org as **Attachment K12**.

Furthermore, the plaintiff uses the graphic symbol, that is protected in her interest for advertisment for her activities as well as for advertising products that were published by members using the “FSC” trademark. The cover pages of several pocket books, the company information in many newspapers etc. show this.

In addition, the plaintiff licences the use of the graphic mark “FSC” to certified retailers, forest companies, processing plants, merchants and her subsidiary company FSC Global Development GmbH. As long as a particular member complies with the certification standard of the plaintiff, the plaintiff permits the particular member to use the symbol “FSC” to advertise their products. The certified companies are therefore put in a position by the plaintiff that allows them to apply the “FSC” symbol to their products. The licencing of the “FSC” symbol to certified members of the plaintiff aims at that consumers can easily and clearly identify that the products carrying the “FSC” symbol were produced in “FSC” standard.

Evidence:
1. Excerpt from the plaintiff’s website, **Attachment K13**
2. Excerpt from the website www.fsc-deutschland.de, **Attachment K14**.

The fact that certified companies use the “FSC” logo of the plaintiff for their wood

products is not what the defendant strongly puts into question. The defendant himself enlists in his statement of defence several times that the “FSC” trademark, which is protected in the plaintiff’s interest, is used as an identification mark on wood products that are certified by the plaintiff. For instance on page 9 of the statement of defence it is written that “products certified by the FSC are labeled by the disputable word- and graphic trademark FSC”.

Furthermore, the plaintiff has licenced the graphic symbol “FSC” to her subsidiary company Global Development GmbH. The subsidiary company FSC Global Development GmbH owns an international licence based on a licence agreement with the plaintiff that enables the subsidiary company to apply and use the registered trademark “FSC”, which is predominantly related to utilization, further licensing and the protection of the trademark.

Evidence: copy of the original licence agreement between the plaintiff and FSC Global Development GmbH, **Attachment K15**.

3. As long as the defendant pleads that the flyers, which are shown in Attachment K1 and Attachment K4, are only distributed on the defendant’s non-commercial and solely private website www.fragen-an-den-fsc.de, we comment that as follows:

Contrary to the pleading of the defendant, the websites www.fragen-an-den-fsc.de and www.fragen-an-den-fsc.info are not at all run in a non-commercial or solely private way. In fact, the defendant himself runs the domains stated above. This is indicated by the information about the operator of the above stated website, which is the defendant’s enterprise. In addition, the address of the website’s domain operator as stated on the information page is the business address of the defendant, which is Einsteinstraße 17, 26133 Oldenburg, Germany, as well as the respective telephone and fax number (Tel.: 0441 – 936 130, Fax: 0441 – 936 1320), which belong to the defendant.

Evidence:
1. Excerpt from the database of Denic concerning the domain www.fragen-an-den-fsc.de, **Attachment K16**.
2. Information from the web portal Markonet concerning the domain www. fragen-an-den-fsc.info, **Attachment K17**

3. Company details of the website www.eurobinia.de, **Attachment K18**.

The claim, the web portal would be a solely private portal, is therefore obviously a attempt to justify one's behaviour.

Also in other respects it cannot be doubted that the defendant uses the affected symbol

himself. Irrespective of the question about the owner of the internet domain www.fragen-an-den-fsc.de, it is clear that the defendant uses the litigious symbol on the published flyers that are presented as **Attachment K1** and **K4**. This flyer is, apart from the fact that it is available on the website www.fragen-an-den-fsc.de, unambiguously from the defendant to account for. The flyer is, on the one hand, labeled with the defendant's product identification name "Eurobinia", and on the other hand there is the copyright consideration "Eurobinia" in the right hand corner of the flyer, as well as the information of the website www.eurobinia.net. Given that the total circular relates to the enterprise Eurobinia and that on the second page of the flyer it is announced that further information about eurobinia can be found on the website www.eurobinia.de, the flyer can be fully ascribed to the defendant. Not least because of the Copyright instruction is it obvious that the enterprise Eurobinia, and thus the defendant, is the publisher of the flyers.

Furthermore, the defendant uses the litigious symbol also on his websites www.eurobinia.de (.net) and www.robinie.de (.net). In each case it can be found at the end of the homepage beside several product labels like for instance the emblem of the "Gesamtverband Holzhandel e.V." or the "Ökoportal" emblem. The defendant amended the symbol of the plaintiff by adding a red frame and a red diagonally

running upwards line.

Evidence: Excerpt from the defendant's website www.eurobinia.de, **Attachment K19**.

In addition, the above described symbol on the defendant's website www.eurobinia.de can be used as a link to the defendant's website www.fragen-an-den-fsc.de on which one has access to the flyer that is presented as **Attachment K1** and **K4**.

Furthermore, the defendant uses the affected symbol on his website www.eurobinia.de, namely on the site "certification" which is a subitem on the site "about us". In case an internet user clicks on "certification", there is a subpage on which the "FSC" symbol of the defendant is presented centred and highlighted.

Evidence: Excerpt from the "certification" part of the website www.eurobinia.de, **Attachment K20**.

Finally, the defendant uses the graphic symbol, which is registered in the plaintiff's interest, on his website www.fragen-an-den-fsc.de in a, as below presented, modified style.

Evidence: Excerpt from the defendant's website www.fragen-an-den-fsc.de, already presented as **Attachment K7**.

On the website www.fragen-an-den-fsc.de, the defendant still offers the flyers, as presented in **Attachment K1** and **K4**, to be found in the section "**Seiten** Downloads Eurobinia vs. FSC" and named "First distributed Flyer of Eurobinia: Correction of

some FSC-arguments" ("Erster verteilter Flyer von Eurobinia: Richtigstellung einiger FSC-Argumente").

Evidence: Excerpt from the defendant's website www.fragen-an-den-fsc.de, **Attachment K21**.

C. Legal Assessment

I. Trademark Entitlements

The utilisation of the marks

by the defendant accounts for a likelihood of confusion related to the trademark that is registered by the plaintiff.

In addition, there is the risk that the approached target group may associate the modifed

marks with the trademarked symbols of the plaintiff for the purpose of §14 Abs. 2 Nr. 3 MarkenG. The plaintiff is therefore (according.§14 Abs. 2 in connection with §14 Abs. 5 MarkenG.) entitled to the lodged injunctive relief against the defendant.

1. Utilisation of the trademark "FSC" by the plaintiff

Because the defendant traverses the utilization of the registered trademark by the plaintiff, it was demonstrated in line with the actual carrying out, that the plaintiff uses the graphic symbol "FSC" on the one hand herself, and on the other hand she licences the trademark in a large degree to certified companies. The licence holders use the "FSC" symbol for all of the registered goods and services, especially for paper and paper products, furniture and wood products. The utilisation of the graphic symbol "FSC" by the licence holders is to be imputed to the plaintiff. Due to. §26 Abs. 2 MarkenG, the utilisation of a trademark with certification from the owner is considered as an utilisation by the owner of the trademark.

2. Utilisation of the trademark "FSC" by the defendant

The defendant uses symbols that are confusingly similar to the trademark "FSC", that is registered the plaintiff's interest, in such a way, that the trademark laws of the plaintiff regarding the symbol "FSC" are violated. The utilization of the confusingly similar symbol "FSC" by the defendant takes place via commercial communication, as well as for "goods and services" and constitutes a trademark utilization. Following in detail:

a) Utilisation as commercial transactions

The defendant uses the affected symbols "FSC" in commercial transactions. As it was demonstrated in line with the actual carrying out, the defendant uses the affected symbols on his website as well as on the flyers which he published (see **Attachment K1** and **K4**). These utilizations take place in the commercial transactions.

The term commercial transactions can be construed extensively. It comprises every commercial activity that serves the advancement of any own or

different business purpose, whereat profit motivation or compensation are not a conceptual necessity. Not part of commercial transactions are solely private, scientific, political, official or consumer-explaining activities, as well as actions that follow exclusively ideational purposes. However, if a pecuniary reward appears to charitable or ideational activity, or if the activity indirectly serves promotional purposes, the action is usually commercial, disregarding of the profit motivation or compensation.

Given this terminology, the utilization of the affected symbols by the defendant clearly demonstrates commercial transactions. The defendant uses the modified “FSC” logos on his commercial websites www.eurobinia.de, and accordingly on the pages www.eurobinia.net and www.robinie.de (.net), on which he advertises the sales of wood products.

First of all, the defendant uses the following symbol

on his websites www.eurobinia.de, www.eurobinia.net and www.robinie.de (.net) on which he advertises the wood products he distributes. On the one hand, the symbol shown above is enlisted beside other product trademarks on the bottom of this pages; on the other hand, the symbol can be found on the subitem “certification” of the defendant’s website. In addition, the defendant uses the symbol presented above on the flyers which he published (**see Attachment K1** and **K4**) and which advertise the sales of robinia wood products.

Furthermore, the defendant uses the following symbol on the website www.fragen-an-den-fsc.de, which he operates:

Again, with regard to this website, an act with commercial transactions can be assumed. Because on that website the defendant offers the in **Attachment K1** and **K4** presented flyer for download, which he uses to promote the robinia wood products he runs. Additionally, the defendant's website www.fragen-an-den-fsc.de is linked to the other websites www.eurobinia.de (.net) and www.robinie.de (.net), which are registered in the defendant's interest, so that therefore an own or different business purpose is at least indirectly assisted.

Especially the utilisation of the modified "FSC" symbol on the flyers that carry the title "Eurobinia: Gutes Holz aus transparenter Produktion", which the defendant published, demonstrates by implication an activity in commercial transactions. Because, as the title "Eurobinia: Gutes Holz aus transparenter Produktion" and the other content of the flyers clarify, it is advertising for the defendant's wood products on the promotional flyers. Therefore, the flyer follows at least indirectly advertising purposes.

Similarly, the defendant cannot invoke that the website www.fragen-an-den-fsc.de, on which the flyers are offered, is, on the first impression, not a matter about an internet portal that serves commercial means. First of all it was demonstrated already with the actual statements that the website www.fragen-an-den-fsc.de is operated by the defendant. In addition, commercial transactions can be affirmed without further ado in line with the content of the website www.fragen-an-den-fsc.de, as this website serves at least indirectly a personal or different business purpose, which is the promotion of the defendant's wood products. By offering the flyer, which the defendant published (see **Attachment K1** and **K4**), as a download on this website, the operator of the website serves an own business purpose. The

defendant therefore disguises by saying that he wanted to report neutrally on the plaintiff,since the flyer is obviously set out to advertise products by the defendant.

Finally, it needs to be considered that a content-filled website already serves commercial means when the content of the website refers in any way to the commercial business of the domain owner or reveals a promotional function. This is regularly the case when the website, which can be reached via a domain name, displays business-related content or when by all means the owner of the domain name is a person with merchant properties (*Hoeren/Sieber/Viefhus*, Handbuch Multimediarecht, Kapitel 6, Rn. 60).

These requirements are instantly also given. Owner of the website “www.fragen-an-den-fsc.de” is the defendant. The content of the website “www.fragen-an-den-fsc.de” relates to the business activity of the defendant, given that on this website the flyer “Eurobinia: gutes Holz aus transparenter Produktion”, which is undisputably published by the company Eurobinia, can be downloaded. Additionally, the website is linked to other websites of the defendant. As demonstrated above, the “FSC” symbol which the defendant uses is enlisted between other product trademarks and was made into a hyperlink in the deployed area. The internet user is transferred to the website www.fragen-an-den-fsc.de as soon as he clicks the symbol. Therefore, the utilisation of the website www.fragen-an-den-fsc.de serves at least indirectly a pecuniary reward.

Because of this concrete linking, the content of the website that was linked to the original one becomes part of the owner’s internet presentation. From a hypothetical point of view, it seems as if the linked websites also belong to the same owner: The matter, whether by using such a hyperlink an attribution of the different webpage’s content comes into consideration, depends on the impression the internet user gets by acknowledgement of the hyperlink. It depends in this respect on whether the hyperlink -similar to a quotation- is perceived as an own content of the person who made the link, or whether it is recognized like a footnote, which is merely a note to another’s information (Hoeren/Sieber/Viefhus, Handbuch Multimediarecht, Kapitel 18.2, Rn. 196).

The hyperlink which the defendant chose is designed in a way that the internet user expects own content of the defendant when he presses the link. This applies instantly especially because the installed link itself promotes by its graphic design and the add-on “better without” already the linked content. Thereby the impression is given that the defendant unites with the content of the websites by establishing a link. Thus, the defendent is liable for the linked content as he is for his own according to §7 Abs. 1TMG.

b) Utilization for goods and services

The defendant also uses the affected symbols for “goods and services” for the purpose of § 14 Abs. 2 MarkenG. A utilization for goods and services is existent for all actions in relation with sales of goods and a supply of a service, thus for actions that establish a reference between the symbol and certain goods and services (Ströbele/Hacker, MarkenG §14, Rn.44). Precondition for the assumption of a trademark infringement is therefore, that the third uses the symbol in a close and designative context with exactly those products or similar goods and services, for which the trademark is protected.

This precondition is also given instantly. The defendant does advertising with a promotional flyer on which the litigious symbol is displayed large-scale, as well as with his websites for the robinia wood products which he sells. The litigious symbol is therefore used for the supply and promotion of wood products, which is goods and services, for which the trademark of the plaintiff is protected.

c) Utilization as a trademark

The defendant uses the litigious product additionally as a trademark. He applies the symbol for advertising products which he offers. The way which the defendant uses to apply the symbol, that is protected in the plaintiff's interest, namely on products which he offers and on his websites, demonstrates a conventional form of trademark utilization, which is only allowed by the companies that have been certified by the plaintiff. By using

the symbol this way, there is a violation of function of the trademark as an indication of origin as well as of the advertising function.

Finally it needs to be taken into consideration that the symbol, that is protected in the plaintiff's interest, is an established trademark for the purpose of §14 Abs. 2 Nr. 3 MarkenG. Regarding established trademarks, there is an infringement of a trademark as soon as one can associate the modified symbol with the established trademark according to §14 Abs. 2 Nr. 3 MarkenG (EUGH GRUR 2004, 58 [60] – Adidas/Fitnessworld; EUGH GRUR 2008, 503 [505] – Adidas/Marca Mode). Since the trademark of the plaintiff is established, it suffices for the assumption of an infringement of a trademark that the modified symbol can be associated with the established trademark. This is the case because the trademark, which is protected in the plaintiff's interest, is fully contained in the altered symbol.

3. Danger of confusion according to §14 Abs. 2 Nr. 2 MarkenG.

The utilization of the affected symbols by the defendant demonstrates an infringement of a trademark for the purpose of §14 Abs. 2 Satz 2 MarkenG. Regarding the graphic symbol, that is registered in the plaintiff's interest

and the symbols used by the defendant

and

there is a danger of confusion for the purpose of §14 Abs. 2, Nr. 2 MarkenG.

Decisive criteria for the existence of a danger of confusion are the similarity between the symbols, the distinctiveness of the trademark and the close relation between the products. The degree of similarity depends on the interaction of these criteria; the degree of similarity can for instance be smaller the bigger the distinctiveness of the trademark is and the other way around (EUGH GRUR Int. 2000, 899 [901]-Marca/Adidas).

a) Similarity of goods

The products which the defendant promotes by using the “FSC” symbol are identical to the products which the “FSC” trademark of the plaintiff is registered and used for. Therefore, sameness of good presently exists.

The defendant advertises his own robinia wood products by using the “FSC” symbols. The trademark “FSC”, which is registered in the plaintiff’s interest, is among others protected for furniture, wood products and the manufacturing of wooden materials. The trademark “FSC”, which is registered in the plaintiff’s interest, may be used by companies that have been certified by the plaintiff or members of the plaintiff, who are allowed to use the trademark “FSC”, for furniture, wood products as well as for the manufacturing of wooden materials, and comparable goods and services. The corresponding utilizations of the license holders are to be imputed to the plaintiff according

to §26 Abs. 2 MarkenG. Therefore, it exists total sameness of goods and services.

b) Similarity of symbols

In case of equal goods and services offered, there has to be a greater graphic separation between the modified symbol and the registered trademark in order to eliminate a danger of confusion. This is especially the case, if -as presented- the trademark has a higher distinctiveness. The „FSC“ symbols which the defendant uses do not maintain the required graphic distance from the registered trademark „FSC“, which is necessary due to the product identity. In fact, the symbols are so similar that there exists a serious danger that they might be confounded. When assessing the danger of confusion, it has to be geared to the registered, or rather, used symbols.

aa) Hereby the trademark „FSC“, which is registered in the plaintiff's interest (Az.: 002974905)

is confronted with the symbol used by the defendant

These symbols are self-explanatorily similar. The graphic symbol „FSC“, which is protected in the plaintiff's interest, is fully and identical contained

in the defendant‘s symbol. The defendant‘s symbol only differs from the plaintiff‘s because the plaintiff‘s symbol was added by a frame and a line that runs up.

Hereby, however, the danger of confusion is not eliminated. In fact, because the plaintiff‘s symbol is fully and identical contained in the affected symbol, there is a great danger that there is confusion among the addressed public. It can be suspected that the public assumes that the defendant‘s symbol is another trademark which is registered in the plaintiff‘s interest, which the plaintiff uses to indicate products that do not comply with the certification standards. It therefore exists the danger that the public might associate the products which the defendant offers and promotes by using his symbol with the plaintiff‘s company or that they assume that the defendant‘s symbol is licensed by the plaintiff.

bb) On the other hand, the registered trademark „FSC“

is confronted with the symbol used by the defendant on his website www.fragen-an-den-fsc.de..

Between these symbols as well, there is a trademark-relevant similarity. The defendant has adopted the distinctive graphic component of the

plaintiff's trademark identically in his symbol. The omission of the trademark component „FSC" alone cannot eliminate a danger of confusion, as the graphic component of the symbol is a known, distinctive feature which is famous to the public even without the letter combination „FSC". The defendant employs the symbol on the website www.fragen-an-den-fsc.de in a similar way to how the plaintiff uses her trademark on her own websites. Therefore, the substantial danger of confusion exists that the addressed target group assumes at first perception of the defendant's website, that this is another official website of the plaintiff.

4. High profile according to §14 Abs. 2 Nr. 3 MarkenG

The plaintiff is also entitled to the asserted injunctive relief according to §14 Abs. 2 Nr. 3 in conjunction with §14 Abs. 5 MarkenG. The trademark, which is registered in the plaintiff's interest, is a very famous product identification which is without much ado well-known to the predominant part of the target group.

A high profile trademark is existent, when it is familiar to a „significant part" of the public. This is decided with the help of all factors of the individual case, some of which are the market share of the trademark, the intensity, length of time, and geographic dimensions of the employment, as well as the investments which the company made for promoting the trademark (EuGH GRUR Int. 2000, 73 [75] – Chevy; Ströbele/Hacker § 14 MarkenG, Rn. 215)..

The trademark „FSC", which is registered in the plaintiff's interest, complies with the requirements for a high profile trademark by implication. The plaintiff is widely known and is internationally seen as one of the most important initiatives for the advancement of responsible forestry. The certification procedure developed by the plaintiff are internationally recognised and the „FSC" symbol, which was established by the plaintiff, also has an international reputation and a global -independent- high profile. The plaintiff is organised with overall 50 international work groups around the world and is therefore globally known. In addition, the plaintiff has spent a substantial advertising effort to make the trademark „FSC", which the plaintiff established, known on the market.

Since it is to come from a high-profile trademark, the criteria for a danger of confusion are clearly lowered. Regarding a high-profile trademark, it suffices for the elements of a crime of §14 Abs. 2 Nr. 3 MarkenG, if the addressed public associates the affected symbol with the registered trademark. This is presently the case, because the trademark, that is registered in the plaintiff's interest, is identically contained in the symbol which the defendant uses. Therefore the danger exists that the public associates the products which the defendant publishes and promotes by using the symbol with the plaintiff's company.

By the utilisation of the affected symbol, the distinctiveness and the valuation of the „FSC" trademark, which is registered in the plaintiff's interest, is exploited and damaged in a dishonest way and without justification. The plaintiff can therefore demand an omission of utilisation of the affected symbol by the defendant according to §14 Abs. 2 Nr. 3 i.V.m. §14 Abs. 5 MarkenG.

5. No appeal to Artikel 5 GG

The intervention into the trademark rights of the plaintiff, which are accounted for the defendant, cannot be justified by a critical or satirical examination of the plaintiff's trademark. The trademark infringement by the defendant is especially not justified by the freedom of opinion which is protected according to Art. 5 GG.

a) Regarding trademark parodies or satires, there still exists a trademark utilisation of the symbol when an indication of origin can be extracted from the symbol, so that §14 Abs. 2 Nr. 2 MarkenG applies. For this, an acutal association suffices (BGH GRUR 1995, 57 [60] – Markenverunglimpfung II; Ströbele/Hacker, § 14 MarkenG, RN. 156).. Because when a trademark is parodied in order to distribute own, identical or similar goods with the modified symbol, then a confusion of origin is at least accepted (Stroebele/Hacker, § 14 MarkenG, RN 156; Ingerl/Rohnke, § 14 Marken G, Rn. 173 f.).

It is the same with the present case. The defendant has deliberately used a symbol which is similar to the plaintiff's trademark to publish his own identical

goods. At this, the defendant intended to attract attention with a confusingly similar symbol and prompt the public to acquire his wood products. The utilisation of a symbol similar to the plaintiff's trademark by the defendant therefore consciously intends a confusion of origin.

For the existence of a trademark infringement pleads additionally that it cannot be excluded that a not unremarkable part of commerce assumes that the products which the defendant attached with the plaintiff's modified symbol, would in fact be products that were certified by the plaintiff. But as soon as the addressed target group may develop the impression that the trademark owner stands behind the symbol, then a utilisation of graphic trademark infringement is to be affirmed (BGH GRUR 1995, 57 [60] – Narkenverunglimpfung II; Ströbele/Hacker, $ 14 MarkenG, Rn. 156; Ingerl/ Rohnke, § 14 MarkenG, Rn. 174).

Regarding the precise utilisation of the affected symbol by the defendant it cannot be excluded from the outset, that the public does not assign the affected symbol to the plaintiff. Because corresponding to the jurisdiction of the BGH, the public is inclined to account a name by label-like usage, the more the name is known as a label, especially when the public is directly and even highlighted confronted with the symbol on a product (BGH GRUR 1995, 57 [60] – Markenverunklimpfung II). Based on these principles, a label-like utilisation of the symbol by the defendant is existent.

b) Additionally, it is not clear and noticeable on first impression for the public, that the affected symbol of the defendant is a referring parody or criticism, because the defendant uses the highlighted „FSC“ symbol on his flyers and websites. Beyond that, the defendant has totally adopted the design of the plaintiff's trademark. The addressed public will therefore first notice the „FSC“ symbol and associate this because of its great similarity to the plaintiff's trademark with the plaintiff.

For that reason, the defendant cannot plead freedom of opinion of Art. 5 GG. Pleading the protection of the freedom of opinion only comes into consideration when the affected trademark utilisation contains a dispute with

regards to content. Precondition is therefore, that the affected form of utilisation procures itself criticism or dispute with regards to content with the known trademark. However, if the different trademark is not parodied or criticised, but the parody or criticism can only be learned from the content of the products which are published with the symbol, then the affected trademark employment contains itself no statement of judgemental or opinion-leading content that goes beyond the mere business advertising or rather the commercial utilisation of a different trademark (OLG Köln NJWE-Wettb 2000, 242 [243]). Thus, if the affected trademark utilisation itself does not contain a judgmental examination with a company and/or its products, it leaves in the first place the scope of protection of Art. 5 Abs. 1 GG.

This is the present case. The affected utilisation of the „FSC“ symbol by the defendant does not contain a dispute with regards to content with the „FSC“ trademark which is registered in the plaintiff‘s interest. Solely the adding of the red frame does not demonstrate a dispute with regards to content, because no parody or criticism can be seen in it. The dispute with regards to content of the plaintiff‘s products can only be found in the text of the flyer, which was published under the affected symbol, as well as on the defendant‘s website. Furthermore, the defendant published his flyer *„Eurobinia: Gutes Holz aus transparenter Produktion“* first and foremost not to deal with the content-related matters of the plaintiff‘s products that were published with her trademark, but to promote his own robinia wood products.

The same applies to the utilisation of the „FSC“ symbol on the defendant‘s website www.fragen-an-den-fsc.de. Here, as well, no dispute with regards to content are revealed solely between the modified symbol and the plaintiff‘s trademark. The addition „fragen an den fsc“ also does not let one see a dispute with regards to content. In fact, this addition is suggestive of the false assumption that this website is operated by the plaintiff who there answers questions about the plaintiff‘s activity.

Intention of the defendant is therefore first and foremost the merely commercial utilisation of the plaintiff‘s trademark in order to bring his own products, which would otherwise be slow-selling or impossible to sell, to

market (BGH GRUR 1994, 808 [810] – Markenverunglimpfung I).. Thus, it should be retained that the affected utilisation of the „FSC“ symbol by the defendant does not indicate a dispute with regards to content with the plaintiff's trademark that could be covered with the freedom of opinion according to Art. 5 GG.

This was probably already noticed by the defendant. In the meantime, the defendant has reorganised the utilisation of the „FSC“ symbol on the flyers which he publishes.

Evidence: Presentation of the defendant's current flyer „Gegen greenwashing-Zertifikate von FSC und Co.“, copy as **Attachment K22**.

On the henceforth and additionally published flyer-versions by the defendant there is a written indication under the „FSC“ symbol which says: „Gegen greenwashing-Zertifikate von FSC und Co.“ Herefrom it becomes clearer – in contrast to the previous utilisations of the FSC-symbols by the defendant – that the services offered through the „FSC“ symbol and by the defendant, critically deal with „FSC“-labelled wood products.

In summary it is to be assessed that the affected utilisation of the „FSC“ symbol by the defendant violated the trademark rights of the plaintiff according to §14 Abs. 2 MarkenG. The graphic design which the defendant chose is without further ado very similar to the plaintiff's „FSC“ trademark. Therefore, a substantial danger exists that the addressed public associates the defendant's symbol with the plaintiff. The trademark utilisation is also not justifiable by Art. 5 GG, since the defendant chose the trademark violating similarity of the graphic symbol design solely for merchandising purposes. In any case the aim of merchandising outweighs in an unnecessary way so much that it can be expected from the defendant in relation to the total trademark rights position of the plaintiff to preserve a greater distance.

II. Entitlements in terms of competition laws

The claimes lodged in the legal action of the plaintiff can also be based on regulations in

terms of competition laws §4 Nr. 1, Nr. 7 und Nr. 10 UWG.

Between the plaintiff and the defendant a precise competitive relationship is existent according to §2 Abs. 1 Nr. 3 MarkenG. A precise competitive relationship exists when the confronted companies try to market similar goods or services within the same clientele and with the consequence that the objectionable commercial activity interferes with the other corporation (trade rival), i.e. hinders or violates the marketing. This requires that the involved corporations function on the same objective, areal and temporal relevant market. At this it is insignificant that the participants belong to different industry sectors or that they act on different stages in the economic process, as long as they approach the same clientele (Hefermehl/Köhler/Bornkamm, § 2 UWG, Rn. 105 ff.).

Corresponding to this definition, a precise competitve relationship is existent between the plaintiff and the defendant. The plaintiff licences the trademark, which is registered in her interest, to corporations that publish among others furniture and other wood products. The defendant is a wood specialty retailer and sells wood products made of robinia wood. The trademark, which is used by the plaintiff, and the symbol used by the defendant are therefore confronted on the same market, namely the market for wood products. It is hereby irrelevant that the plaintiff and the defendant belong to different stages in the economic process.

The remaining conditions of §4 Nr. 1, Nr. 7 and Nr. 10 UWG are also given. By utilising the modified „FSC“ symbol and through the content which was spread on the defendant‘s websites and promotional material, the defendant tries specifically to hinder the plaintiff. This is especially the case, when – as present – the advertising of a trade rival is deliberately hindered or disabled, as different advertising efforts are imitated and the addressed consumers are mislead. Because of the alienated imitation of the plaintiff‘s graphic symbol for promotional purposes by the defendant, the approached consumers were influenced in their discernment at the expense of the plaintiff.

A dishonest and targeted interference is moreover existent when an external symbol is removed or degraded. Because of the alienated depiction of the plaintiff‘s trademark, the defendant tries to convince consumers of an alleged inferior quality of the plaintiff‘s products in order to secure himself and his product offering a competitive advantage. This is a matter of interference with other‘s advertising efforts, which is, in terms of competitive

laws, not permissible.

III. Subsequent claim

As a result of the designated trademark infringements, the plaintiff is according to §19 MarkenG and §242 BGB entitled to a claim of disclosure against the defendant as to the facts which were stated in the petition at section 2. The claim of disclosure is necessary for an estimate of indemnity claim, especially regarding any adequate licence fee and the suspected damage due to the confusion of the market.

The plaintiff is entitled to an indemnity claim against the defendant from §15 Abs. 5 MarkenG on whose identification she has legitimate interest. The utilisation of the affected symbol by the defendant violates – as above presented – the trademark rights of the „FSC“ symbol that the plaintiff is entitled to. These violations occur culpably since the defendant contained the utilisation of the confusingly similar symbols, although he had knowledge about the conflicting trademark rights of the plaintiff.

The plaintiff has a not yet quantifiable disprofit after the principles of calculation in terms of licensing analogy, which can only be quantifiable after the implementation of the claim of disclosure. The interest of seeking a determination is due to the circumstance that indemnity claims of trademark infringements are only very hard to calculate and its assertion therefore takes a long time. There would be a danger of lapse of time if these entitlements were not already assessed on principle. For the rest, a determination of compensation liability would facilitate a later extrajudical settlement.

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