

## Legal Action

Of Forestship Stewardship Council AC, Avenida Hidalgo 502, Oaxaca, Mexico

- plaintiff -

Authorized proxy: Pauly & Partner, Kurt-Schumacher-Straße 16, 53113 Bonn

against

Enterprise Eurobinia, represented by the registered merchant Mr. Gerriet Harms,  
Einsteinstraße 17, 26133 Oldenburg

- Defendant –

Due to: trademark infringement and violation of the law against unfair competition  
Interim object value: 50 000.00€

By the name of and on behalf of the plaintiff we take action and ask for an arrangement  
of a date for a hearing, in which we will apply for:

1. The defendant is sentenced, on pain of an administrative fine up to 250.000,00€  
defined on the part of the court for the case of violation or alternatively arrest for  
contempt of court up to six months, to omit to:
  - a) use the labels presented below in trading,



- b) to promote its goods and services, traded under its business trademark  
“Eurobinia”, on its website “fragen-an-den-fsc.de” by installing a link to its  
further websites “eurobinia.de”, “eurobinia.net”, “robinie.de” and “robinie.net”, as  
well as

- c) promote its goods and services, traded under its business trademark “Eurobinia”, with the help of the website “fragen-an-den-fsc.de”, also run on the part of the defendant by linking the websites “eurobinia.de”, “eurobinia.net”, “robinie.de” and “robinie.net” to it.
2. The defendant is sentenced to disclose to the plaintiff, in which volume, in which print run and with which distribution list it distributed or distributes the as attachment K1 added flyer, which it offers in English and German language on its websites for download.
3. It is decided that the defendant is obligated to compensate the plaintiff for the damages that arose and will arise from the actions nearer described under digit 1
4. The defendant bears the costs of the process.

Reasons:

### I. Explanations in facts

1. The plaintiff is an international non-for-profit organization with national working groups in 43 countries. Its aim is to implement the requirements on a sustainable forestry, adopted at the Conference on Environment in Rio de Janeiro. A special relevance has the equal consideration of social, ecological and economical aspects of the usage of natural goods. For this purpose the plaintiff has established obligatory principles and criteria for a good forestry, which compliance it acknowledges with awarding a certificate – the so-called FSC label – as pictured below:



The mark figured above is registered as a figurative trademark of the plaintiff under the number 002974905 at the Office of Harmonization for the Internal Market.

Evidence: Print-out of the trademark index, attachment K 2

According to the certification criteria of the plaintiff, the whole manufacturing and trading progress from the forest to the wholesaler must be certificated completely. Certificated enterprises are then exclusively allowed to label their products with the FSC label named above.

Evidence: Extract from the plaintiff’s web appearance, attachment K 3

2. The defendant is speciality retailer for wood, whose products and enterprises are not certificated according to the principles of the plaintiff.

The defendant runs various websites, inter alia “eurobinia.de” (.net), “robinie.de” (.net), on which it promotes its products, as well as the internet platform “fragen-an-den-fsc.de”. On these websites it offers in each case a flyer to download,

which presents under the headline “Eurobinia: quality timber from transparent forestry”/ “Eurobinia: Gutes Holz aus transparenter Produktion” for which reasons the defendant does not let its products be certified according to the plaintiff’s principles. On page 1 of this flyer the defendant uses for that matter the registered figurative trademark of the plaintiff, supplemented with a red frame and a red line running diagonally to the top, similar to the German parking prohibited sign.



Evidence: Flyer of the defendant, attachment K 1

Furthermore, the defendant has installed a link from the websites “eurobinia.de” and “robinie.de”, run for the purpose of evaluating its products in trade, to the website “fragen-an-den-fsc.de”, also run by the defendant. Under the latter domain the defendant runs a platform, which analyses the plaintiff’s services critically.

Evidence: Extract from the internet appearance of the defendant, attachment K 4

In the same way there is a link from the website “fragen-an-den-fsc.de”, which analyses critically the principles of certification of the plaintiff, to the websites of the defendant, “eurobinia.de” and “robinie.de”.

Evidence: Extract from the internet appearance of the defendant, ibid.

The plaintiff gave the defendant a legal written warning from 03.12.2009 after notice of the circumstances and demanded the execution of a penalty based declaration of omission and obligation as well as the grant of disclosure.

Evidence: Legal writing of the plaintiff from 03.12.2009, attachment K 5

The penalty based declaration of omission and obligation was delivered to the defendant according to the letter status report of the Deutsche Post AG on 04.12.2009.

Evidence: Print-out of the letter status of the Deutsche Post AG, attachment K 6

The defendant neither executed the declaration of omission demanded on the part of the plaintiff until the deadline nor ceased the usage of the figurative trademark registered by the plaintiff and accordingly the usage of the distorted form of the registered trademark as well as it continued the linking between the defendant’s websites “eurobinia.de” and “robinie.de” and the defendant’s critical internet portal “fragen-an-den-fsc.de”. Therefore a legal help is now necessary.

## II. Pleadings

1. The plaintiff's due against the defendant is the claim for omission of using the registered figurative trademark (number 002974905 at the Office of Harmonization for the Internal Market) as well as using the distorted form of this figurative trademark.

The symbol is registered as a figurative trademark in favour of the plaintiff and therefore underlies an independent trademark right. The illegal use of the symbol by the defendant violates the plaintiff's trademark rights.

According to § 14 Abs. 2 MarkenG the trademark's owner's due is not only the claim for omission against the violator if the violator uses a identical symbol for identical services and goods but also for the cases in which the violator uses a similar symbol for identical or similar services and goods, as long as there is the abstract danger of confusion of the addressed public (BGH GRUR 2004, 860,863). The danger is insofar sufficient as the addressed Verkehrskreis associates the used symbol with the trademark of the owner (BGH, as above). As long such an abstract danger of confusion exists for the addressed Verkehrskreis in particular cases, it is prohibited under provision of § 14 Abs. 2 Nr. 5 MarkenG to use the symbol in business documents or advertisement. For that matter, all kinds of advertisement are included (Ströbele/Hacker, MarkenG, § 14 Rz.139; BGH 1960, 33 36).

In the case at hand the defendant used a distorted form of the plaintiff's registered figurative trademark in its flyer, with which it argues against the FSC certification system of the plaintiff and promotes its own products at the same time. Because the registered symbol of the plaintiff is clearly identifiable despite the alienation, it is not evident without further warning for the addressed Verkehrskreis that the used symbol is *not* belonging to the plaintiff but to a third person, to the defendant. Therefore a violation of §14 Abs. 2 Nr. 5 MarkenG is existent.

In addition, there is a violation of §14 Abs. 2 Nr. 3 MarkenG. The rule also contains the satirically distorted use of other trademarks in favour of the own product sales. The registered figurative trademark of the plaintiff is worldwide used and therefore known, legally protected symbol. At least according to the content of the flyer – which expresses high criticism on the plaintiff's FSC certification system – there is a risk that the addressed Verkehrskreis notice the alienation and Verballhornung of the plaintiff's figurative trade, with which they may have a familiar ring at first sight. The owner of a trademark does not have to accept such a damage to the plaintiff's reputation by distorting the registered trademark.

2. The linking of the websites "eurobinia.de" and "robinie.de", organized on the part of the defendant which promotes its products with them, to the FSC-critical website "fragen-an-den-fsc.de" causes that the addressed Verkehrskreis see the flyer and the included distorted presentation of the plaintiff's figurative trademark as a purposeful degradation of the competition in purpose of bringing the own sales forward. Such a behaviour is an anticompetitive act under provision of §§ 1,4 N.1 and 10 of the law against unfair competition, and it obliges to omit. Under provision of § 4 Nr.1 the one who takes action which are able to restrict the consumer's freedom of decision by an inadequate irrelevant impact, acts unfairly in business. The elements of a crime of an inadequate impact are supposedly far to interpret. It implies in any case that the consumer's ability to judge is significantly restricted (Hefermehl/Köhler/Köhler UWG § 4

Rdn. 1.35). Due to the critical presentation of the FSC certificated products and the satirical, distorted modification of the plaintiff's registered trademark here the addressed Verkehrskreise are influenced in an inadequate and irrelevant way.

Under provision of § 4 Nr.10 UWG an unfair act is given if competitors are hindered purposeful. A meeting of the two case groups Nr. 1 and Nr. 10 is generally on hand if – as above – an advertisement which misleads the consumer and impairs the competitor is taken out. At hand, the addressed consumers are restricted in their ability to judge by the distorted imitation of the plaintiff's figurative trademark used for advertising purposes. The defendant obviously intends with the degrading presentation of the plaintiff's figurative trademark to convince the consumers of a pretended low quality to assure its own competitive advantages. This is a no longer acceptable pure imitation of advertisement beyond the trademark right protection.

3. Because among trademark claims also such under the law against unfair competition are claimed, is under provision of § 141 MarkenG the otherwise exclusive legal venue of § 14 UWG not relevant. The local jurisdiction of the appealed court results from § 140 MarkenG in combination with § 21 ZPO.

Simple and certified transcriptions are enclosed.

Dr. Osnabrügge  
Lawyer