Translation – statement of FSC A.C. to the hearing of 1st of september

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Landgericht Braunschweig
9. Zivilkammer
- 9 O 319/10 *039* -
Münzstraße 17
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In the legal case

of the Forest Stewardship Council

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the under the trade name Erobinia trading registered merchant Gerriet Harms

Az.: 9 O 319/10 *039*

the court uttered in the hearing of 01.09.2010 the opinion that the question of trademark-like use of the FSC logo by the defendant as well as the question of a danger of confusion could finally remain open. The chief judge justified this with the explanation that in regard to the trademark use by the defendant none of the unfair elements of a crime of § 6 Abs. 2 UWG (law against unfair competition) are on hand and therefore the plaintiff is denied to assert trademark legal claims. Insofar the civil division referred to the decision of the Federal Court of Justice (BGH), GRUR 2010, 161 – Gib mal Zeitung. In this decision, the BGH determined that the owner of a registered trademark is not authorized to forbid a third the use of a symbol identical with or similar to its trademark in a comparable advertisement that does not violate any of the elements of a crime named in § 6 Abs. 2 of the law against unfair competition.

From this decision the civil division draws the conclusion for the case to be judged that the question of a trademark-like use and a possible danger of confusion could finally remain open due to the competition legal judgement of the case. This cannot convince someone.

1. The conclusion drawn by the civil division for the case to be judged within this proceeding does not conform to the legal practice of the European Court of Justice for the proportion of trademark and competition law.

   Though the trademark owner is also denied an assertion to trademark claims according to the European Court of Justice (EuGH)if a case of admissible comparing advertisement is at hand. Notwithstanding it is acknowledged in the legal practice of the EuGH that a comparing advertisement is not admitted according to § 6 Abs. 2 of the law against unfair competition if all conditions for the existence of a trademark violation are given (EuGH GRUR 2008, 698 [699 f. - consideration reason 46 and 51] – O2/H3G). This by the way

results also from § 6 Abs. 2 no. 3 of the law against unfair competition, according to which a comparing advertisement is not admissible if between the advertiser and the competitor or between the trademarks, the goods or the services of the advertiser and the competitor any danger of confusion exists (EuGH GRUR 2008, 698 [700] – O2/H3G).

In the case of the BGH “Gib mal Zeitung” it was a case of a comparing advertisement intended by the advertiser. The TAZ advertised with a humorous and ironic allusion to a competitor and in comparison to its product for the own product. In this situation the BGH correctly noticed in the end of the decision and rather casually that if a case of an admitted comparing advertisement is given it must also be allowed to use the trademark of the competitor for commercial purposes. A condition for this argumentation is however that an explicitly admitted case of a comparing advertisement is given. This distinguishes the case “Gib mal Zeitung” from this one.

The reverse argument drawn by the civil division from the argumentation of the BGH is however not admissible. It is not that always if none of the unfair elements of a crime of § 6 Abs. 2 of the law against unfair competition are at hand, a trademark violation does not need to be considered any more. According to the underlying legal practice of the EuGH a case of an unfair advertisement under § 6 Abs. 2 of the law against unfair competition is in fact at hand if the conditions for a trademark violation are given. In the case BGH GRUR 2010, 161 – Gib mal Zeitung it was not the case. There were no trademark-like use, no restriction of the advertising impact of the used alien trademark and also no danger of confusion existent. For this reason it depends largely on this question of a trademark-like use in this case and the question cannot be left aside.

2. For this reason the decision in this case on the basis of the EuGH legal practice depends notably on whether the conditions of a trademark violation are existent. In this regard the civil division put straight in the hearing that there are no doubts about acting in business connections and a use of the FSC logo for services and goods.
Contrary to the opinion of the civil division the use of the FSC logo by the defendant however also meets the claims of a trademark-like use. According to the legal practice the question of a trademark-like use depends on that the use of a third symbol affects among other things the main function of the trademark, namely the source function. This is according to the conventional legal practice the case if the public may err in reference to the source of the concerning services or goods.
This is the case at the attacked use of the FSC logo by the defendant, because the public establishes a relationship to the plaintiff due to the use of the trademark by the defendant or alternatively may assume that the offers of the defendant are from the plaintiff. The use of the distorted FSC logo on the defendant's website “www.fragen-an-den-fsc.de” suggests that this website is a FAQ page of the plaintiff. The suggestion is strengthened by the fact that the logo is used next to the headline “Fragen an den FSC” (“questions to the FSC”). Insofar the impression may occur that this website would be an official website run by the plaintiff, especially a FAQ website on which the plaintiff answers general questions to its corporate purpose and accordingly its business activity.
The same – as already explained – applies to the use of the distorted logo in the form of a prohibition sign on the flyer. Here also the addressed public may get the impression that it would be a logo used by the plaintiff for the certification of non-certified enterprises. It is at least not impossible that the public gets such a wrong impression or rather that the public

assumes a commercial connection between the plaintiff and the defendant. A violation of the source function is therefore available.

Finally it needs to be noted that according to the newer legal practice of the EuGH it is sufficient for the assumption of a trademark-like use when the advertising function of a trademark is affected by the use of a third symbol (EuGH GRUR 2009, 756 [762] – L' Oréal). The advertising function of a trademark is the suggesting and attracting potential of a trademark, referring to its advertising value or rather its special image or its goodwill.

The threshold for an infringement of a known trademark is especially lowered under provision of § 14 Abs. 2 no. 3 of the trademark law. As already explained, the FSC logo used by the plaintiff possesses a very distinctive and strong advertising value and an independent goodwill. The plaintiff uses and licences its FSC trademark internationally and for most different end products. For example, the FSC logo can be found on every ticket of German Railways [Deutsche Bahn AG] and on all reservations. Everyone who travels by train knows this logo. It can be found in almost all paperbacks which are sold for the popular market. The FSC logo is on all tetra-paks sold in Germany (see also: “http://www.tetrapak.com”). Only for the national distribution the German sub-organization of the plaintiff, FSC Arbeitsgruppe Deutschland e.V., publishes on its website an overview of all products which are produced using FSC-certificated wood and therefore are labelled with the FSC logo. We add a print-out from the website “http://deutschland.fsc-products.org/products/index.php?lang=de” as an attachment. Behind the particular links hide the particular producers and products which are certificated with the FSC logo. On the background of the nationwide distribution of the FSC logo – known to the court – a general denial by the defendant must be prohibited. If the court should consider a further justification as necessary, we ask for an according instruction. The FSC logo therefore is known to the addressed consumer which is why the logo has an independent advertising value available, independent also from the source function. This applies not at least because not only the plaintiff itself but also all enterprises licensed by it use the FSC logo and the logo therefore stands for a certain quality of the products and goods distributed under this logo.

This advertising value is affected without further ado by the use of the distorted FSC logos of the defendant, because the defendant exploits the advertising effect of the known trademarks of the plaintiff to advertise its own services and goods. In addition, the defendant damages the distinctive character between his products and the products of the plaintiff (cf. Ingerl/Rohmke § 14 trademark law, RN 1271, 1274, ff.). Consequently a trademark-like use of the symbols by the defendant is at hand.

3. Because there is as explained a trademark legal danger of confusion between the trademark of the plaintiff and the symbols used by the defendant, all conditions for a trademark violation are at hand. According to the legal practice of the EuGH however with the existence of a danger of confusion also a commercially legal inadmissibility is given, as the term of confusion under provision of § 14 Abs. 2 trademark law and § 6 Abs. 2 no. 3 law against unfair competition must be interpreted uniformly (EuGH GRUR 2008, 689 – O2/H3G).

4. Finally it needs to pointed out that the argumentation of the court in the hearing on

01.09.2010 is also not correct because the advertisement with the distorted FSC logo of the defendant is precisely not admissible under provision of § 6 Abs. 2 no. 3 of the law against unfair competition. Under provision of § 6 Abs. 2 no. 3 an advertisement is not admissible if a confusion between the advertiser and its competitor or between the symbols used by them results. That the use of the distorted FSC logo by the defendant may result in confusions at the addressed public has already been extensively explained in the previous pleadings. But if there is the danger of confusion between the logo alienations and the trademark registered in favour of the plaintiff the comparing advertisement will not be admissible according to § § 6 Abs. 2 no. 3 of the trademark law. Insofar the law against unfair competition cannot, contrary to the legal opinion uttered by the court in the hearing, displace the trademark law or trademark law claims.

Therefore it is initiated that the court reconsiders its legal opinion uttered in the oral proceedings on 01.09.2010 and sentences the defendant according to the request or, if the court considers it as necessary, re-opens the oral proceedings.

Simple and certified copies added. The process attorney of the plaintiff immediately receives a copy of this pleading.

Dr. Osnabrügge
Lawyer