

21 Sep
2020

Achtung! German applicant fails to defend its trademark before the CJEU

European Union - [BOEHMERT & BOEHMERT Anwaltspartnerschaft mbB](#)

- The General Court upheld a decision of the Board of Appeal of the EUIPO finding that the figurative mark ACHTUNG! lacked distinctive character
- The CJEU held that the General Court had correctly found that consumers would perceive the mark as an advertising message
- The General Court did not fail to examine prior decisions of the EUIPO in similar cases

In [achtung! GmbH v European Union Intellectual Property Office](#) (EUIPO) (Case C-214/19 P, 3 September 2020), the Court of Justice of the European Union (CJEU) (10th Chamber) has dismissed an action against the judgment of the General Court of 10 January 2019 in [Case T-832/17](#). The General Court had confirmed a decision of the Fourth of Board of Appeal of the EUIPO denying protection to an international figurative mark designating the European Union due to a lack of distinctive character.

Background

German advertising agency *achtung! GmbH* designated the European Union in International Registration No 1297443 for the figurative mark ACHTUNG! (depicted below) for various goods and services in several classes, including computer software, stationery, and advertising and telecommunication services:

achtung!

Both the examiner and the Board of Appeal of the EUIPO refused to grant protection to the mark for the requested goods and services, invoking a lack of distinctive character (Article 7(1)(b) of [Regulation 207/2009](#)). German-speaking end consumers and professionals would perceive the mark only as a promotional message which simply sought to attract attention. Moreover, the sign did not contain any figurative element that was sufficiently distinctive to function as an indication of origin.

The General Court dismissed the German company's action for annulment of the Board of Appeal's decision, endorsing the board's reasoning that *achtung! GmbH* had failed to demonstrate the distinctive character of the mark.

CJEU decision

In its appeal before the CJEU, *achtung! GmbH* unsuccessfully raised two pleas in law.

First, the court rejected the claim that there had been an error in law concerning the assessment of the distinctive character of the figurative mark ACHTUNG!. The contested decision had rightfully found that:

- according to the reference dictionary for the German language, the *Duden*, the term '*Achtung*' is defined as, among other things, an "exclamation or inscription calling for caution or attention"; and
- this word was used in advertising to attract the attention of consumers and persuade them to buy goods and services of a high quality or at a favourable price.

Consequently, it was rightfully concluded that consumers would not perceive this word as an indication of origin, but as an advertising message. Therefore, the mark lacked distinctive character.

Further, it was irrelevant that the word '*achtung*' - with the first letter in lower case being perceived as a common spelling mistake in the German language, and not as conferring distinctive character to the sign - might have several meanings, including "respect, high estimation". This was not only based on the fact that the distinctiveness of a sign must be assessed by taking into account all the possible ways in which a trademark might be used - the General Court had concluded, after an overall assessment, that the sign would be exclusively perceived as a promotional advertising message, especially given the combination of the word element '*achtung*' with an exclamation mark.

As the General Court had correctly found that the mark lacked distinctiveness, the fact that it had made an error in law in its assessment of descriptiveness was irrelevant as it had no effect on the outcome of the decision.

With regard to the second plea, the CJEU found that there had been no infringement of the principles of equal treatment and sound administration, and that the General Court had not failed to examine prior decisions of the EUIPO in similar cases. Settled case law establishes not only that the EU trademark regime is an autonomous system that applies independently of any national system, but also that the EUIPO is not bound by prior decisions.

Comment

The CJEU's conclusion that the figurative mark ACHTUNG! lacks distinctiveness - confirming the decisions of all lower instances - is convincing. However, the fact that identical or highly similar prior trademarks have been registered by the German and Swiss office - and even the EUIPO - shows, once more, the existence of inconsistencies in the assessment of the absolute grounds for refusal.

Florian Schwab

Boehmert & Boehmert

TAGS

[Enforcement and Litigation](#), [Portfolio Management](#), [Media & Telecoms](#), [Europe](#), [European Union](#)