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Litigating non-traditional trademarks in Germany: why market context matters for color and shape marks

Eckhard Ratjen of BOEHMERT & BOEHMERT examines the challenges of enforcing non-traditional trademarks in Germany. Focusing on recent case law, he explores how courts assess color and shape marks in practice, highlighting the critical role of market context and consumer perception in determining whether such signs function as indicators of origin.



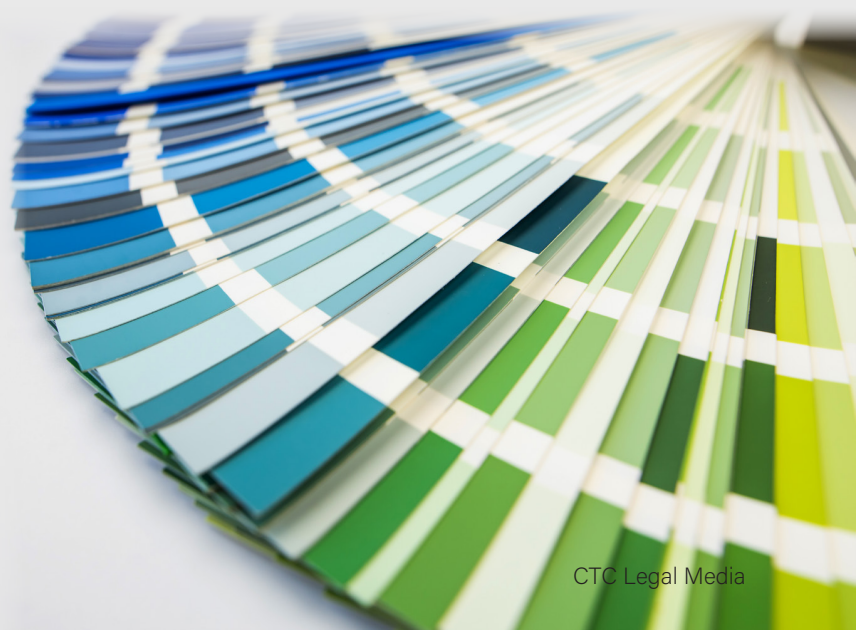
Eckhard Ratjen

“Owners of non-traditional marks frequently face a more demanding path in litigation than owners of word marks or logos.”

Trademark owners increasingly rely on non-traditional signs such as colors and product shapes to distinguish their goods from those of competitors. In many sectors, these elements are not merely decorative. They form part of a brand's commercial identity and can become highly recognizable in the market. This is particularly true where the same color or shape is used consistently over many years and appears prominently in product presentation, advertising, and distribution.

At the same time, enforcing such rights in Germany remains difficult. In infringement proceedings, the decisive hurdle is often not the existence of the registration itself, but whether the sign at issue is perceived by the relevant public as an indication of origin. Courts are generally cautious in this respect. Colors are often seen merely as design choices. Product shapes are typically regarded as functional or aesthetic features of the goods themselves. The result is that owners of non-traditional marks frequently

face a more demanding path in litigation than owners of word marks or logos. Claims based on 3D marks often fail already at the requirement of trademark use, while courts are likewise very reluctant to assume trademark use of colors.



Recent German case law nevertheless shows that enforcement is possible. Two recent Higher Regional Court decisions are particularly instructive: the Hamburg “Zinc Yellow” case on an abstract color mark for high-pressure cleaners, and the Düsseldorf “Smiley” case on a 3D EU trademark for smiley-shaped frozen potato products. Both decisions confirm that the decisive issue is the same: market context and the perception of the relevant public. Where the claimant can show that the sign stands out in the relevant market and is perceived as an indicator of origin, courts may be prepared to grant relief.

The challenge of enforcing non-traditional marks

Under German and EU trademark law, infringement requires use of the contested sign in the course of trade in a manner capable of affecting the functions of the mark, above all its origin function. For traditional marks, that requirement is usually straightforward. If a defendant uses a sign as a brand name or logo, trademark use will often be clear.

The position is different for colors and shapes. German courts start from the proposition that consumers do not usually see product colors or product forms as trademarks. In the case of abstract color marks, the courts are especially cautious where the color appears on packaging, in advertising, or on the product itself. In the case of 3D marks, the public normally attributes the shape of the goods to an attempt to create a functional or visually appealing product, rather than to indicate commercial origin.

This does not mean that such signs cannot be enforced. It means that owners must do more work. In practice, they must show why the sign is perceived differently in the specific sector at issue. That assessment depends on several factors: the labelling habits in the relevant market, the degree to which the sign differs from customary product presentation, the strength of the claimant’s sign, and the identity of the relevant public. These aspects run through both of the recent decisions discussed below.

Color marks: the Hamburg “Zinc Yellow” decision

In August 2024, the Higher Regional Court of Hamburg decided a dispute concerning a German abstract color mark for “Zinc Yellow” (RAL 1018) registered for motor-driven high-pressure cleaning devices. The claimant objected to the defendants’ use of yellow on high-pressure cleaners marketed in Germany. The defendants had argued, among other things, that there was no trademark use. The Court rejected the appeal and confirmed infringement.

The Court’s reasoning is notable because it spells out what must be shown when an abstract color mark is enforced. It held that, for color marks, proper trademark use

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presupposes that the autonomous character of the color mark remains sufficiently visible so that the color as such is seen as an independent indication of origin. The Court added that a high degree of acquired distinctiveness of the color strongly supports such a finding. If a significant part of the relevant public associates the color with a particular undertaking, there is, in principle, trademark use.

That was exactly what the claimant could show here. It relied on several consumer surveys from 2005, 2018, and 2022. According to the Court, those surveys showed that the degree of recognition and attribution had increased significantly over time. In 2022, the adjusted recognition level of “Zinc Yellow” in connection with high-pressure cleaners was 83% among owners and users of such devices, 76% among potential owners and users, and 54.6% among the general public. The Court expressly noted that the relevant attribution level clearly exceeded the 50% threshold generally required for acquired distinctiveness of color marks.

The Court also looked closely at how the color appeared on the defendants’ products. It considered that the defendants used a highly similar yellow in a manner highly similar to the claimant’s own products. The presence of black, dark grey, or light grey did not change that conclusion. Those colors were regarded as typical basic colors in the high-pressure cleaner sector and therefore not origin-indicating. By contrast, the yellow was the only central accent color and decisively shaped the appearance of the products. The Court further stated that a single-color mark does not need to be used alone in order to retain an origin-indicating function; other colors may appear alongside it, provided that the protected color is still used in a way that consumers understand as distinctive.

This part of the decision is especially useful for practice. Many owners of color marks do not use the protected shade in isolation. They use it together with black, grey, white, or other functional design elements. The Hamburg court makes clear that this does not, by itself, defeat infringement. The real question is whether the protected color still appears as a central and autonomous origin-indicating feature. It also accepted that the color could operate as a secondary sign, even where a separate word sign was also used on the product. The fact that the defendants had additionally used their own branding did not push the yellow into the background. The relevant public could still understand the color as an independent indication of origin.

Shape marks: the Düsseldorf “Smiley” decision

The Higher Regional Court of Düsseldorf addressed similar issues in December 2024 in a case concerning a 3D EU trademark for smiley-shaped frozen potato products. The claimant, a supplier of frozen potato products for retail and gastronomy, relied on a registered three-dimensional EU trademark covering pre-fried frozen potato croquettes and mashed potato products. The defendant had presented similar smiling-face potato products at a trade fair accessible only to trade visitors in the catering sector. The Court upheld the injunction.

The Düsseldorf court began with the standard premise: consumers usually do not perceive the shape of the goods themselves as an indication of origin, but as a functional or aesthetic feature. That starting point is fully in line with the commentary, which states that rights from a 3D mark against a three-dimensional form often fail already because the public sees the shape merely as the form of the product rather than as an indicator of origin.

However, the Court then turned to the specific market context and reached the opposite conclusion on the facts before it. It stressed that the relevant public consisted exclusively of professional buyers, because the presentation took place at a trade fair not open to the general public. These professional customers, such as purchasers and operators of catering businesses, were the relevant audience. The perception of end consumers receiving the product in a restaurant was therefore not decisive.

That distinction mattered. The Court held that the smiley shape was unusual in the relevant market for frozen potato products supplied to gastronomy businesses. While smiley or emoji forms may be widespread elsewhere in the food sector, especially for sweets or snack products, the relevant comparison market here was narrower.



In that market, conventional forms such as fries, croquettes, rösti, and dumplings dominated. The Court noted that, apart from the claimant, there were only very limited examples of face-like frozen potato products, and those differed significantly in presentation and target market. On that basis, the Court considered the smiley form not merely decorative, but so unusual and distinctive that the relevant public would attribute an origin function to it.

The Court also emphasized that the shape was not simply a functional manufacturing choice. Forming potato mass into a smiley with cut-outs required a certain production effort. Moreover, the expressive facial design was seen as a deliberate creative choice that stood out particularly strongly from standard potato-product forms. The Court considered this a design decision that the relevant public would perceive as innovative and memorable.

A further point of practical importance is the Court's treatment of the relevant public. It expressly accepted that professional purchasers in the sector generally have a good market overview and deeper knowledge of products and suppliers. That higher level of familiarity made it more plausible that they would perceive an unusual product shape as a trademark. In other words, the same product shape might be assessed differently depending on whether the target group is the general public or specialized trade buyers.

Practical guidance

The two decisions offer several practical lessons for owners seeking to enforce color marks or shape marks in Germany.

First, market context is decisive. Claimants should not argue in the abstract that a color or shape is distinctive. They should define the relevant market as precisely as possible and show how the sign stands out within that market. In the Hamburg case, the decisive issue was not yellow in general, but yellow for high-pressure cleaners. In the Düsseldorf case, the decisive comparison was not the whole food market, but the specific market for frozen potato products for professional catering buyers. That framing can make the difference between success and failure.

Second, evidence of recognition is crucial, particularly for color marks. Survey evidence was central in Hamburg. The Court relied on repeated surveys over time and treated them as a strong indication that the color had become a source identifier in the market. Owners of abstract color marks should therefore consider whether they have sufficient evidence before filing suit. Where possible, it is advisable to compile not only registration documents, but also

market studies, turnover figures, advertising evidence, catalogues, and historical product materials showing consistent color use.

Third, the cases show that non-traditional marks can operate as secondary signs. A color or shape does not lose its trademark function merely because a word sign or logo also appears on the product. That is commercially realistic. In many sectors, the public is accustomed to encountering several signs at once. A litigation strategy should therefore not concede too quickly that the presence of house marks excludes trademark use of the color or shape. The stronger argument is often that the contested element operates as an additional badge of origin.

Fourth, the identity of the relevant public matters. Claimants should think carefully about who actually encounters the contested sign and in what setting. The Düsseldorf case is a good example: because the products were displayed at a trade fair for professionals, the court focused on the perception of trade buyers, not restaurant guests or retail consumers. In some sectors, a professional audience may be more likely to recognize distinctive design features as source indicators because it has a better overview of available products and suppliers.

Finally, owners should prepare for the courts' underlying skepticism. Experience makes clear that the normal starting point remains unfavorable to claimants: product forms are usually seen as form, and colors are only exceptionally seen as marks. That means claimants should front-load their case with concrete facts showing why the present market is different. It is usually not enough to rely on the registration and a bare comparison of signs. The better approach is to explain why the relevant public in the relevant market has learned to see the sign as origin-indicating.

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Conclusion

Recent German case law confirms that enforcing non-traditional trademarks is difficult, but far from impossible. Courts remain cautious, especially where colors and product shapes are concerned. Yet the Hamburg and Düsseldorf decisions also show that claimants can succeed where they focus on the right issue: not the sign in the abstract, but the sign in its market setting.

For trademark owners and litigators, the key takeaway is clear. In Germany, successful enforcement of color marks and 3D marks will usually depend on two things above all: a persuasive account of the relevant market context and solid evidence of how the relevant public perceives the sign. Where those elements can be demonstrated, even signs that are often dismissed as merely decorative may function as enforceable trademarks.

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RÉSUMÉ
Eckhard Ratjen is a partner at BOEHMERT & BOEHMERT. He advises German and international clients on all aspects of intellectual property law. For almost 15 years, he has been representing clients in trademark, trade dress, copyright disputes, and unfair competition matters.

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