

## GERMANY



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## Absolute ground test crushes interlocutory injunction

Based on German 3-D-mark 399 06 072 (figure 1) registered for consumption-ready cereals and desserts in classes 29 and 30, German company Alois Müller GmbH & Co has obtained an interlocutory injunction against Italian company Milkon Alto Adige ordering it not to distribute in Germany its yoghurt product (figure 2), which also uses a two-chamber yoghurt cup (Civil Court Munich, file 4HK O 8370/08).

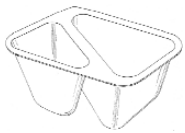


Figure 1



Figure 2

Against this decision Milkon filed an opposition arguing (1) that Müller's 3D mark is subject to cancellation according to paragraph 3 (2) Number 2 German Trade Mark Act (MarkenG), according to which a sign cannot be protected if it consists exclusively of a shape which is necessary to obtain a technical result, and (2) that the use of its two-chamber cup does not occur as a source indicator, but simply represents a *functional part* of its product.

Milkon relied on the Philips/Remington case of the ECJ (C-299/99) following which trade mark protection of shapes of goods is to be rejected based on Article 3 (1) e) EC regulation 89/104 if it can be shown that the essential functional features of such a shape only relate to its technical functionality, in which case it is of no relevance whether it can be shown that there exist alternative shapes which achieve the same technical function. Furthermore, Milkon produced a decision of the German Patent and Trade Mark Office (GPTO, 302 00 803 516.2) rejecting Milkon's own (allegedly infringing) 3D trade mark application for its own two-chamber cup, on the basis of the Philips/Remington argument.

Finally, and since in Germany only the GPTO and not the infringement court is competent to cancel a mark for reasons of absolute grounds, Milkon

had also filed a cancellation action against Müller's 3-D-mark.

The Civil Court of Munich followed Milkon's argument, holding that had Müller filed a main action for infringement, the action would have been stayed until a decision was rendered in the cancellation action before the GPTO against Müller's 3D mark. And while a stay of interlocutory injunction proceedings is not permissible, the Civil Court of Munich held that in view of the "drastic doubts" on the legal survival of Müller's 3D mark, the necessary criteria of "urgency" for upholding the injunction must be denied, and the injunction was lifted. The decision is not final and may be appealed by Müller.