

6 U 55/14
84 O 239/14
Cologne District Court

Annex to the transcript of the
announcement dated 31 October 2014
Pronounced on 31 October 2014

Agaczynski, Court Clerk
Registrar of the Court Registry

HIGHER REGIONAL COURT OF COLOGNE
IN THE NAME OF THE PEOPLE
JUDGMENT

In the proceedings for interim measures

of **riha Wesergold Getränke GmbH & Co. KG**, represented by the personally liable partner riha Richard Hartinger Getränke GmbH, represented by the managing director, Richard Hartinger jun., Behrenstraße 44-64, 31737 Rinteln

Defendant and appellant,

Counsel: Krohn Rechtsanwälte,
Esplanade 41, 20354 Hamburg,

v e r s u s

Deutsche SiSi Werke Betriebs GmbH, represented by the managing directors, Dr Hans-Peter Wild and Carsten Kaisig, Rudolf-Wild-Straße 107-115, 69214 Eppelheim,

Plaintiff and respondent,

Counsel: Rechtsanwälte Hermanns Wagner Brück,
Kaiser-Wilhelm-Ring 41, 40545 Düsseldorf,

the 6th Civil Senate of the Higher Regional Court of Cologne,
composed of its members Nolte, Dr Hohlweck and Boyke
having regard to the oral hearing held on 10 October 2014

r u l e s a s f o l l o w s :

The defendant's appeal against the judgment pronounced on 19 February 2014 by the 4th Commercial Chamber of Cologne District Court is dismissed.

The defendant bears the costs of the appeal proceedings.

G r o u n d s :

(instead of the facts of the case and the reasons on which the ruling is based pursuant to Section 540(1) of the German Code of Civil Procedure)

I.

The plaintiff manufactures the children's fruit drink "Capri-Sonne" in various flavours and sells it in stand-up pouches. The plaintiff invented "Capri-Sonne" in 1966 and has produced it at its headquarters in Eppelheim/Heidelberg since 1969. "Capri-Sonne" is produced in 23 countries and sold in 110 countries. The "Capri-Sonne" stand-up pouches are sold in boxes of 10 and also individually through smaller outlets. The "Orange" flavour is shown below as an example of the design:



The “Capri-Sonne” stand-up pouch – in its neutralised form – is the subject of the plaintiff’s three-dimensional trade mark no. 395 08 178 filed on 23 February 1995 and registered on 5 September 1996 in Class 32 for “non-alcoholic beverages, fruit drinks, fruit juices and fruit nectars”. The Senate refers to Annexes W 2 and W 3.

On 9 August 2013, the defendant requested that the German Patent and Trade Mark Office (DPMA) cancel the registration of the trade mark because of absolute grounds for refusal. With its decision of 21 August 2014 (case no. 39508178 – S 230/13 Lösch, Annex AG 14) – which is pending final judgment – the German Patent and Trade Mark Office cancelled the registration of the mark, stating by way of explanation that a ground for refusal exists as the shape is necessary to obtain a technical result, pursuant to Section 3(2)(2) of the Trade Mark Act. The plaintiff has appealed against this decision. On 9 April 2014 Den Haag Rechtbank (equivalent to a German district court) ruled, essentially on the same grounds, that the plaintiff’s basic mark be cancelled (case no. C/09/448299/HA ZA 13-873, Annex AG 13).

The defendant belongs to the riha WeserGold Beverage Group based in Rinteln and is one of Europe’s major fruit juice manufacturers.

There has already been a legal dispute before the District Court of Hamburg between the plaintiff and an undertaking from Wesergarten Getränke GmbH, the group of undertakings to which the defendant belongs, regarding the sale of fruit drinks of the “Sonniger” brand in orange and multivitamin flavours in boxes of 10 pouches to the Aldi Nord discount shop. For further details of the previous proceedings, please refer to the findings of the contested judgment.

The plaintiff later became aware that the defendant was supplying Aldi Netherlands with the stand-up pouches and boxes of 10 which had been the subject of the Hamburg proceedings. The plaintiff subsequently obtained a ban against the defendant from Braunschweig District Court. The Higher Regional Court of Braunschweig suspended the appeal proceedings by decision dated 10 June 2014 until the cancellation proceedings pending before the German Patent and Trade Mark Office have reached final conclusion (Annex AG 15).

At the Anuga trade fair, which took place in Cologne from 5 to 9 October 2013, the defendant exhibited a stand-up pouch with the associated box of 10 in the design depicted below:



On 27 February 2013 the defendant filed a German three-dimensional trade mark consisting of an S-shaped stand-up pouch; the mark was registered on 4 June 2013 under the number 302013019421.

The plaintiff also considers the amended design of the defendant's product to be a trade mark infringement within the meaning of Section 14(2)(2) of the Trade Mark Act. In addition, the plaintiff claims infringement of a well-known mark according to

Section 14(2)(3) of the Trade Mark Act or, in the alternative, protection against confusion according to Section 5(2) and deliberate obstruction of competitors according to Section 4(10) of the Act against Unfair Competition.

On 11 October 2013 the plaintiff was granted a preliminary injunction by the Chamber as set out in the contested judgment; reference is made to this and to all other findings of the judgment pursuant to Section 540(1)(1) of the Code of Civil Procedure. Following objection raised by the defendant, the district court upheld the preliminary injunction through the contested judgment.

The defendant has filed an appeal to seek the annulment of the contested judgment and the rejection of the request to grant a preliminary injunction. The defendant reiterates and elaborates the arguments it brought forward at first instance, taking the view that there is no ground for injunction due to the plaintiff's trade mark being manifestly ineligible for protection – at least according to the decision of the German Patent and Trade Mark Office – and the prospects of success in a possible main action being low. With regard to the claim for injunction under trade mark law, trade mark use must have occurred, which the defendant does not believe to be the case. The district court wrongly failed to consider whether stand-up pouches are common in the trade of products other than fruit drinks and the point of reference it chose was too narrow. The defendant argues that it is necessary to take into account at least the (liquid) food sector and, furthermore, to consider the identical stand-up pouches of the “Flipper” and “Plein Sud” brands. In addition, the defendant argues that the district court, in establishing trade mark use, wrongly held that the plaintiff's mark has above-average distinctiveness, as the identified association rates in excess of 50% are not sufficient to establish enhanced distinctiveness and the objections raised at first instance regarding the levels of association determined on the basis of the surveys have not been taken into account. In any event, the defendant believes that the inaccurate statements regarding the above-average distinctiveness of the protected shape of the plaintiff's product have been indiscriminately transferred to the contested infringing embodiment, despite the fact that this has considerably different design features, not to mention a manufacturer's label. With regard to the manufacturer's label, any association as a secondary brand can be excluded, according to the defendant. It claims that, apart from the fact that no trade mark use has occurred, there is no likelihood of confusion between the plaintiff's mark and the contested infringing embodiment.

The plaintiff defends the contested judgment by reiterating and elaborating the arguments it brought forward at first instance. With regard to the aspect of trade mark use, which the defendant is contesting for the first time, the plaintiff points out that this was not disputed at first instance. In addition, the plaintiff claims that the

registration of the defendant's trade mark proves that the shape of the stand-up pouch functions as an indication of origin. In the alternative, the plaintiff asserts its claims by referring to fair trading law, primarily Section 4(9) a) and b) of the Act against Unfair Competition, and further to the notion of protection against confusion pursuant to Section 5(2) of the Act against Unfair Competition as well as the aspect of deliberate obstruction of competitors pursuant to Section 4(10) of the Act against Unfair Competition.

For further details of the facts and nature of the dispute, reference is made to the content of the correspondence exchanged between the parties including annexes as well as the other documents in the case.

II.

The admissible appeal filed by the defendant is unfounded.

The district court rightly, and through essentially relevant reasoning, found that the contested stand-up pouches and covering boxes of the defendant infringe the plaintiff's rights with regard to the three-dimensional mark DE 39508178, which means the plaintiff may request an injunction according to Sections 4, 14(2)(2)(5) of the Trade Mark Act. In conclusion, the Senate endorses these findings also on the basis of the facts that had been submitted to it before the appeal proceedings.

1.

Ground for injunction exists, even in view of the decision made by the German Patent and Trade Mark Office on 21 August 2014 to cancel the mark, which is pending final judgment.

In accordance with the Senate's case-law, the ground for injunction is not assumed to be based on trade mark law and a weighing of interests relating to the individual case is therefore required. In cases where the mark of the party seeking an injunction is manifestly not eligible for protection, case-law exceptionally considers that no ground for injunction exists (cf. Hanseatic Higher Regional Court GRUR-RR 2008, 293, as cited by juris margin number 42 et seq.). This does not mean, however, that, in view of the jurisdiction of the German Federal Supreme Court as regards the proceedings on the substance, a cancellation of the plaintiff's trade mark which is pending final judgment may always be equated with manifest non-eligibility for protection in the course of the injunction proceedings; it does, however, require a very careful examination and assessment (cf. also Ingerl/Rohnke, MarkenG, 3rd

edition, Vor §§ 14-19 d paragraph 209 with further references; cf. also Senate GRUR 2005, 1070, as cited by juris).

In any event, the Senate cannot establish a significant degree of probability that the defendant will win the cancellation proceedings in the court of final appeal with its objection based on the ground for refusal pursuant to Section 3(2)(2) of the Trade Mark Act. The German Patent and Trade Mark Office based its decision to cancel the trade mark on the ground for refusal concerning shapes necessary to obtain a technical result, according to Section 3(2)(2) of the Trade Mark Act. The Patent and Trade Mark Office stated further that the characteristics determining the overall impression of the contested shape can be objectively considered as having the technical function of easy handling and/or durability of packaging for liquids. During the appeal proceedings, the plaintiff opposed the assumption that the essential functional characteristics of the packaging shape are attributable only to the technical result by way of substantial arguments, which will be the subject of the opposition proceedings before the Patent and Trade Mark Office. The Senate cannot foresee the outcome of these proceedings and therefore cannot rule out a successful outcome for the defendant, but it does not consider such outcome highly probable either. In any event, the outcome cannot be predicted with reasonable certainty within the meaning of the case-law of the Hanseatic Higher District Court as cited above. Therefore, the trade mark must currently be considered as being eligible for protection according to Section 4(1) of the Trade Mark Act due to its registration in the German trade mark register. The obligation to take the registration as binding also applies in principle in the injunction proceedings (Ingerl/Rohnke, loc. cit.). This is supported, at least indicatively, by the fact that the defendant's S-shaped stand-up pouch was registered as a three-dimensional mark in 2013.

2.

A claim for injunction exists for both the contested stand-up pouches and for the covering box according to Section 14(2)(2) of the Trade Mark Act.

a.

An act of infringement according to Section 14(2)(2) of the Trade Mark Act can in principle only be deemed to have occurred if the contested shape is used as a trade mark, i.e. if the average consumer, in the context of product sales, views the shape as distinguishing the goods of one undertaking from those of other undertakings (cf. BGH GRUR 2007, 780 paragraph 22 – Pralinenform I; GRUR 2010, 1103 paragraph 25 – Pralinenform II). The guarantee of origin as the essential function of the trade mark is jeopardised if a third party uses the sign for its goods or services in such a way that consumers are likely to interpret it as designating the origin of those goods or services (cf. EuGH GRUR 2007, 971 – Celine, as cited by juris margin number

27). Therefore, a three-dimensional mark is only protected against the use of aesthetic design characteristics by competitors for their own goods if consumers perceive the design of such goods as an indication of origin (cf. BGH GRUR 2007, 780 paragraph 22 et seq. – Pralinenform I). In this context, it must be borne in mind that consumers, according to experience, do not tend to perceive the shape of a product as an indication of origin in the same way as they perceive word and figurative marks to be, since the shape of a product is primarily designed for functional and aesthetic purposes. The special product shape is therefore linked to this factor rather than perceived as an intention to designate origin (cf. EuGH GRUR Int 2006, 842 paragraph 25 – Form eines Bonbons II; GBH GRUR 2005, 414 [416] – Russisches Schaumgebäck; GRUR 2007, 780 paragraph 26 – Pralinenform I; GRUR 2010, 1103 paragraph 30 – Pralinenform II; Senate, GRUR-RR 2014, 210 et seqq., as cited by juris margin number 63 – Bounty and Snickers).

The fact that the defendant itself has recently registered a parallel three-dimensional mark while claiming that the plaintiff's mark does not function as indication of origin does not in itself lead to the conclusion that the contested design has been used as a trade mark in the aforementioned sense. It is generally irrelevant whether the user subjectively intended to designate the commercial origin of the products or anticipated such perception (BGH, GRUR 1960, 126 [128] – Sternbild; Senate, loc. cit., Goldbär, as cited by juris margin number 36). When examining the question whether a certain product shape is used as a trade mark, i.e. whether it is seen as an indication of origin, account must be taken of the perception of the average consumer (cf. Senate, LMur 2012, 47, as cited by juris margin number 17). In this context, it is sufficient if legally relevant parts of the public also perceive the sign as an indication of origin (cf. also Ingerl/Rohnke, loc. cit., § 14 paragraph 144).

In its considerations, in which the district court provides a comprehensive view of the relevant legal aspects and applies these to the dispute by and large correctly, the district court finds that the contested stand-up pouch has been used as a trade mark in view of the fact that the plaintiff is the only manufacturer to use the stand-up pouches in their protected form in the relevant German market and has acquired a special status over the years, which is also shown by the Epsos-GmbH survey from 2012 and which has led to above-average distinctiveness of its mark. This is addressed unsuccessfully by the grounds of appeal:

aa.

The district court was correct in holding, in particular, that the shape of the plaintiff's stand-up pouch is not common in the trade but holds a unique status in the relevant market. An indication of origin can be attributed, in particular, to a shape which is

considerably different from those common in the trade (cf. BGH GRUR 2007, 780, as cited by juris paragraph 28 – Pralinenform).

The decision by the ECJ dated 12 January 2006 (GRUR 2006, 233, as cited by juris, in particular margin numbers 35, 36 – Deutsche SiSi-Werke) does not initially lead to the opposite conclusion, i.e. that stand-up pouches are a common and widely used packaging type in the food sector. The ECJ merely found that the sector used for comparison of what is common in the trade is defined as part of the assessment of facts and does not constitute a matter of law, which would fall within the jurisdiction of the ECJ. Consequently, this does not involve a positive determination of the relevant market.

Even if, when determining the customs of the trade for the purpose of this case, one referred not only the individual product under dispute (fruit drinks) but also to packaging shapes commonly used in related product areas (other liquid foods) (as expressly stated by Ströbele/Hacker, Markengesetz, 10th edition, § 8 paragraph 237), the result would be the same, taking into account the images submitted by the defendant on 3 December 2013 as Annexes AG 4 – AG 8 relating to the sector. This sector does not confirm the defendant's claim that comparable stand-up pouches in the area of liquid foods are common in the domestic trade. Of the aforementioned sets of annexes, the ones referring to products not containing liquid foods must be excluded from the outset; this applies, in particular, to packaging shown therein of instant soup, which is not liquid but packaged and marketed as dry food. The fact that baking ingredients, mini salamis, mushrooms, spice mixes, rice, sauerkraut, olives, sweets, cat and dog food or bathroom cleaner and soap do not constitute liquid foods requires no further explanation. The drink pouches submitted in the set of annexes AG 8, none of which are labelled in German, are not offered on the German market, according to the defendant, and must therefore be disregarded. The remaining images refer to other, more or less liquid foods such as smoothies, "multi-power drinks", fruit purees or sour cream. Apart from the fact that the defendant did not comment on their presence on the German market and thus on the extent of domestic use, the design of the packaging of the latter products is also considerably different from the stand-up pouches of the parties involved in the dispute.

In assessing what is common in the trade, the district court also rightly disregarded the identical stand-up pouches of the "Flipper" and "Plein Sud" brands. Third-party signs used by licensees of the trade mark proprietor must not be seen as weakening; they designate the same commercial origin and must not be held against the trade mark proprietor, who is merely exercising its legal rights (Section 30 of the Trade Mark Act), any more than its own additional marks (Ingerl/Rohnke, loc. cit., § 14

margin number 658). In this regard, it is not disputed that “Flipper” is a secondary brand and “Plein Sud” is a licensed product of the plaintiff.

bb.

When assessing whether the defendant used the contested shape as a trade mark, the district court was right in its approach of taking into account the distinctiveness of the plaintiff’s mark. The Senate believes – to this extent differing from the contested decision – that the plaintiff’s mark only has an average degree of distinctiveness. However, the assumption that the contested sign has been used as a trade mark is not necessarily conditional upon the plaintiff’s mark having enhanced distinctiveness (cf. BGH, BB 2014, 2369, as cited by juris margin number 29 – Gelbe Wörterbücher).

The starting point for assessing the distinctiveness of the plaintiff’s mark is the obligation of the infringement court to take the registration of the mark as binding (cf. BGH, GRUR 2010, 1103 = WRP 2010, 1508 [paragraph 19] – Pralinenform II). This does not mean that the infringement court must attribute a certain level of distinctiveness to the mark. It only means that the mark must not be denied any form of protection, while the level of distinctiveness must be determined independently by the infringement court (cf. BGH, GRUR 2010, 1071 = WRP 2007, 1461 [paragraph 24] Kinder II).

We distinguish between the following levels of distinctiveness: very high (considerably above-average), high (above-average), normal (average), low (below-average) and very low (considerably below-average) (cf. BGH, GRUR 2013, 833 = WRP 2013, 1038 [paragraph 55] – Culinaria /Villa Culinaria).

aaa.

If a sign was registered on grounds of acquired distinctiveness, it is generally deemed to have average distinctive character (cf. BGH GRUR 2007, 1066 paragraph 34; GRUR 2010, 1103 paragraph 40 – Pralinenform II). Although the registration certificate submitted as Annex W 2 to the application does not specify that the three-dimensional mark was registered on grounds of acquired distinctiveness, the plaintiff does not give any other explanation why the Patent and Trade Mark Office at first unequivocally refused to register the mark due to a lack of distinctiveness and only registered it once a survey report on the level of recognition had been submitted. In this regard, the defendant’s reference to the careless registration practice of the German Patent and Trade Mark Office cannot be denied, and other reasons for registration apart from acquired distinctiveness, which the Senate believes to be the case, have neither been submitted nor are they otherwise apparent.

bbb.

On the basis of the submissions made by the plaintiff and, in particular, the results of the 2012 Ipsos survey, the Senate has no reason to believe that the mark has enhanced, above-average distinctiveness.

In order to establish enhanced distinctiveness for a three-dimensional mark consisting of the shape of a product, it is not sufficient to determine the degree of recognition with regard to the design itself. What is required, instead, is an assessment that takes into account all relevant factors, in particular the inherent characteristics of the trade mark, the market share of the goods bearing the mark, the intensity, geographical spread and duration of use as well as advertising expenses (BGH GRUR 2007, 780, margin number 36 – Pralinenform I).

The result of the survey shows that 64.8% of all survey participants associate the packaging of the “Capril-Sonne” product with a certain undertaking. When determining the degree of distinctiveness, it is also necessary to take into account those consumers who believe the plaintiff’s mark designates a certain company, but are unable to name it (BGH GRUR 2010, 1103, margin number 34 – Pralinenform II). Even though, when asked an open question without being given any company names, the percentage of people who associated the pouch shape specifically with the name “Capri-Sonne” or even Sisi-Werke, at 58.6% (54.2% + 4.4%), was fairly high, these levels are not sufficient to establish above-average distinctiveness. With regard to word marks, which have a low degree of distinctiveness due to their highly descriptive elements, high percentages in terms of distinctiveness and association are required to establish enhanced distinctiveness (cf. BGH GRUR 2003, 1040, – Kinder; BGH GRUR 2004, 514, – “Telekom”). The same applies to the plaintiff’s shape mark in question, which was registered solely on grounds of acquired distinctiveness. The percentages achieved are too low to establish enhanced distinctiveness.

ccc.

Even though the plaintiff’s survey-based arguments do not provide sufficient evidence to establish enhanced, above-average distinctiveness, it must be taken into account that the identified degree of market acceptance is considerably above the 50% mark which is generally required to satisfy the acquired distinctiveness criterion (cf. BGH GRUR 2010, 138, as cited by juris margin number 41 – Rocher-Kugel). The district court was correct in dismissing the defendant’s objections, which were reiterated having already been raised at first instance, regarding the figures determined on the basis of the survey report. The association of the packaging with

the Capri-Sonne brand, in particular, is immaterial as it is equivalent to the indication-of-origin function of the mark. Following further submissions by the plaintiff and on the basis of the Senate's own expert knowledge, the Senate is, in any event, satisfied that the plaintiff's mark has a considerable reputation, which not only gives the packaging shape a unique status in the relevant market but also provides considerable evidence that trade mark use has occurred.

This is supported by further factors such as the sales figures and advertising expenses presented and substantiated by the plaintiff. In Mr Reutlin's affidavit dated 30 September 2013, which is contained in Annex W 1 to the application, the sales figures and advertising expenses are presented in detail and substantiated. It shows that the annual sales volumes of the "Capri-Sonne" product offered in the stand-up pouches in question are in the three-digit million range in Germany alone, and total advertising expenses, which have been substantiated by the W 5 set of annexes, amounted to more than € 40 million between 1994 and 2012.

The Senate concludes, also on the basis of its own expert knowledge, that the mark enjoys a considerable reputation (cf. Senate, GRURPrax 2014, 202, as cited by juris margin number 33 – Goldbär), since the Senate members, being part of the relevant trade circles, are aware that the "Capri-Sonne" product has been sold in the packaging registered as a shape mark for several decades and is still encountered by consumers in the target market today.

cc.

The Senate concurs with the district court in the conclusion that the unique status of the packaging in the relevant market, the average degree of distinctiveness of the plaintiff's mark and the considerable reputation of the stand-up pouch as an indication of origin designating the plaintiff, show that consumers also perceive the packaging shape, as part of the overall design of the infringing embodiment at dispute, as an indication of origin.

b.

Having provided a comprehensive presentation of the relevant legal principles, the district court rightly concluded that there was a likelihood of confusion between the conflicting signs within the meaning of Section 14(2)(2) of the Trade Mark Act.

The question of likelihood of confusion within the meaning of Section 14(2)(2) of the Trade Mark Act must be comprehensively assessed by taking into account all relevant factors of the case in question. The assessment of likelihood of confusion

depends, in particular, on the degree of recognition of the mark in the market, the level of association of the sign used or registered, as well as the degree of similarity between the mark and the sign and between the goods and services to which they are affixed (cf. BGH GRUR 2005, 427, 429 – Lila-Schokolade; BGHZ 169, 295 margin number 17 – Goldhase).

One important factor in this context is that the conflicting signs are used for identical products, i.e. fruit drinks. Overall, given the average distinctiveness of the plaintiff's mark and assuming a high degree of similarity between the signs, it is reasonable to conclude that a likelihood of confusion exists, since a legally significant proportion of consumers will gain the impression that the goods in question originate from undertakings which are linked, at least on a commercial level.

aa.

When assessing the similarity between the signs, account must be taken of the overall impression of the conflicting signs; in the case of compound signs, consideration must be given, in particular, to their distinctive and dominant elements (cf. BGH GRUR 2002, 171, Marlboro-Dach, as cited by juris, margin number 44; GBH GRUR 2011, 148, 151, paragraph 29 – Goldhase II; Senate, judgment of 30 March 2012, 6 U 159/11 – Ritter-Sport, as cited by juris, paragraph 26). This does not rule out the possibility that the overall impression created in the minds of consumers by a complex mark may, in certain circumstances, be dominated by one or more of its elements. Furthermore, it cannot be ruled out that a sign which is added to a compound mark or complex sign may maintain its distinctive character without dominating or having a significant impact on the appearance of the compound mark or complex sign (cf. BGH, GRUR 2013, 883, margin number 45 – Culinaria; BGH GRUR 2009, 766 margin number 34 – Stofffähnchen). If, in certain circumstances, consumers perceive an element of the contested sign as a secondary sign, the comparison may be restricted to this (cf. BGH WRP 2008, 236, margin number 33 – The Home Store; Senate, GRUR-RR 2012, 341, as cited by juris margin number 26 – Ritter-Sport).

We cannot support the earlier opinion of the Higher Regional Court of Frankfurt am Main that, when assessing the likelihood of confusion between the overall shape of a product's packaging registered as a three-dimensional mark and a contested packaging design, it is generally necessary to disregard all other sign elements not relating to the shape, such as non-similar word marks (cf. MarkenR 2000, 30, as cited by juris margin number 8 – Standbeutel). This opinion is incompatible with the basic rules that apply when assessing the likelihood of confusion based on all relevant factors of the individual case and the overall impression (cf. Ingerl/Rohnke, loc. cit., § 14 paragraph 991). Nonetheless, when assessing the similarity between

signs, the comparison in the present case is restricted to the plaintiff's mark on the one hand and the packaging shape of the contested design on the other without regard to any other characteristics such as the manufacturer's name or other word or figurative elements.

In such cases, it is essential to ascertain whether the relevant consumers perceive the contested design in context, as a sign as a whole, or whether – possibly due to certain advertising activities or certain identification habits, e.g. the frequent use of secondary brands, either in general or specifically in the relevant area of goods – consumers are used to perceiving individual elements which are part of an overall design, such as the contested packaging, as a distinguishing function that is separate from the distinguishing function of other elements (cf. BGH GRUR 2002, 171, as cited by juris margin number 48 – Marlboro-Dach; Ingerl/Rohnke, loc. cit., § 14 margin number 828 et seqq. with further references).

Due to the indication-of-origin function of the Capri-Sonne packaging shape, consumers will perceive this shape as a functionally independent element of the contested infringing embodiment and consider it to have a distinguishing function that is separate from the distinguishing function of other elements in the overall design. This general view is supported in the current dispute by the aforementioned reputation of the plaintiff's mark. Although this reputation does not lead to the conclusion that the mark has enhanced distinctiveness, it is considerably above the level required to establish acquired distinctiveness and justifies the assumption that the mark enjoys considerable reputation. This is supported, in particular, by the fact that the plaintiff has been the only manufacturer to use flexible stand-up pouches for beverages in the German market for 40 years and therefore has a unique position in this sector. When ascertaining whether consumers perceive the packaging shape as an independent distinctive element, account must be taken of the average, observant consumer (cf. Hanseatic Higher District Court of Hamburg, GRUR-RR 2006, 321, as cited by juris margin number 71). This consumer will notice the unique packaging shape, which is especially designed to attract his attention in a way that is considerably faster and more memorable than other design characteristics such as text, image and colour. Where, according to case-law, certain identification habits may indicate that a sign element has an independent distinguishing function, it must be taken into account that – regardless of whether this can be seen as common practice in the relevant market – consumers encounter and are familiar with the "Flipper" product, sold by the discounter "Aldi" as an identical drink pouch labelled as a secondary brand, and that "Lidl" sells a further licensed product of the plaintiff with an identical packaging shape. Insofar as the defendant is one of Europe's major fruit juice manufacturers, which is an undisputed fact, it is at least likely that the name "Wesergold" could have been used as a secondary brand in consumers' minds.

bb.

It follows from this that there is a high similarity between the plaintiff's mark on the one hand and the packaging shape of the contested sign on the other. The district court was correct in pointing out with accurate reasoning, to which the Senate refers, that neither the slightly different sizes of the stand-up pouches nor the slightly curved lateral edges ("S shape") lead to the contested stand-up pouch falling outside the scope of protection of the plaintiff's trade mark. The slightly amended shape, in particular, does not change the fact that the stand-up pouch tapers towards the bottom when viewed from the front and that its overall impression is the same as the protected stand-up pouch. Consumers encountering the contested stand-up pouch of the defendant will, indeed, assume that it is one of the plaintiff's pouches which has been merely pushed in at the side.

c.

Insofar as the district court upheld the claim for injunction under Section 14(2)(2) of the Trade Mark Act also concerning the contested covering box, the defendant, in its grounds of appeal, did not raise any separate objections in this regard. Trade mark infringement was caused by the depiction of an image of the protected three-dimensional shape on the covering box.

III.

The decision on costs is based on Section 97 of the German Code of Civil Procedure. The decision becomes effective upon its delivery according to Section 542(2)(1) of the German Code of Civil Procedure.

The sum in dispute for the appeal proceedings has been set at: € 500,000

Nolte

Dr Hohlweckh

Boyke