

World Trademark Review *Daily*

Misleading use of ® symbol clarified
Germany - Maiwald Patentanwalts GmbH

Unfair use

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The German Federal Supreme Court has held that use of a trademark in conjunction with the ® symbol by a party who is not the owner or licensee of the mark, or is not otherwise authorized to use the mark, is “significantly misleading” and constitutes an unfair commercial practice under Section 5 of the Unfair Competition Act (I ZR 219/03, February 26 2009, published only recently).

In the United States, the ® symbol indicates that a mark is registered with the [US Patent and Trademark Office](#). Use of the ® symbol allows the trademark owner to claim certain types of damages in infringement actions. In Germany, use of the ® symbol is not mandatory to assert such claims. However, the ® symbol has been established by means of promotion: the German consumers understand that a sign followed by this symbol is a registered trademark that is protected within the German territory.

In the present case, a company used the sign THERMOROLL®, instead of the licensed trademark TERMOROL. The court found that:

- use of the double 'L' resulted in a different pronunciation; and
- the addition of the letter 'H' strengthened the association between the sign and the word 'thermo' (and, consequently, the notion of heat).

The court concluded that use of THERMOROLL in conjunction with the ® symbol was “significantly misleading” and violated Section 5 of the act.

The court stated that such use would be authorized only if:

- the user was the owner of a registered trademark that was similar to the sign used in conjunction with the ® symbol; and
- use of the sign could be considered as a “genuine use” of the registered trademark under Article 26 (3) of the [Trademark Act](#).

The court also pointed out that the differences between the mark as used and the mark as registered must not alter the distinctive character of the registered trademark. The addition or doubling of letters might be allowed if they do not result in phonetic or conceptual changes.

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