



FEDERAL SUPREME COURT

DECISION

I ZB 28/23

of

12 October 2023

in the appeal proceedings

concerning the trademark application 30 2018 111 639.6

Reference book: yes

BGHZ: no

BGHR: yes

KÖLNER DOM/Cologne Cathedral

German Trademark Act (MarkenG) Section 8 para. 2 no. 1

- a) The ground for refusal of lack of distinctive character pursuant to Section 8 (2) No. 1 of the German Trademark Act (MarkenG) precludes the registration of a trademark for goods and services designated by a broad generic term even if it exists with regard to individual goods and services falling under the generic term.
- b) If the public perceives the sign consisting of the name of a place of interest - consisting of an adjective place name and a building name (here: Kölner Dom/Cologne Cathedral) - in connection with goods that can be considered as travel souvenirs or supplies, only as a designation of the place of interest and not as an indication of the commercial origin of these goods, the sign lacks any distinctive character within the meaning of Section 8 (2) No. 1 of the German Trademark Act (MarkenG) (holding BGH, decision of 8 March 2012 - I ZB 13/11, BGHZ 193, 21 - Neuschwanstein; delimitation to ECJ, judgment of 6 September 2018 - C-488/16, GRUR 2018, 1146 - Bundesverband Souvenir - Geschenke - Ehrenpreise/EUIPO [Neuschwanstein]).

Federal Supreme Court (BGH), decision of 12 October 2023 - I ZB 28/23 - Federal Patent Court

ECLI:DE:BGH:2023:121023BIZB28.23.0

On 12 October 2023, the I. Civil Senate of the Federal Supreme Court, composed of the presiding judge Prof. Dr Koch, the judge Dr Schwonke, the judge Feddersen, the judges Pohl and Dr Schmaltz

decided:

The appeal against the decision of the 25th Senate (Board of Appeal for Trademarks) of the Federal Patent Court of 19 January 2023 is dismissed at the applicant's expense.

Reasons:

1 A. On 18 October 2018, the applicant, Hohe Domkirche zu Köln, filed an application for registration of the sign "KÖLNER DOM" as a word mark in the register maintained by the German Patent and Trademark Office for various goods and services in classes 14, 16, 25 and 35.

2 By decision of 11 December 2020, the German Patent and Trademark Office rejected the trademark application - insofar as relevant for the appeal proceedings - due to a lack of distinctiveness with regard to the following goods and services:

Class 14:

Articles of jewelry; jewelry; watches, clocks and timepieces, their parts and accessories, included in Class 14; busts of precious metal; boxes of precious metal; cases of precious metal; figurines [statuettes] of precious metal; hat ornaments of precious metal; objets d'art of precious metal; medals; cuff links; coins; tie pins; key rings [imitation and jewelry]; jewelry boxes; shoe ornaments of precious metal;

Class 16:

Photographs; stationery; materials for artist; paintbrushes; papery articles; printed matter; calendars; stickers; decals; albums; pictures; books; nappies of paper or cellulose; containers for stationery; paperweights; bags, envelopes and pouches of paper or plastics; stamps; brochures; book covers; bookends; flags, pennants of paper; writing utensils; paper figurines [statuettes]; hymn books; advertising cards; greeting cards; stamps; office supplies; bookmarks; flower pot sleeves; notebooks; posters; leaflets; erasers; writing pads; paper napkins; paper placemats; paper tablecloths; paper coasters; paper pennants, flags; drawing supplies; newspapers; magazines;

Class 25:

Articles of clothing; headgear; handkerchiefs; football boots; sports shoes; walking boots; cleats for football boots; footbags [not electrically heated]; slippers; clogs; braces; trouser belts; bibs not of paper; ties; necktie cloths; manilets; sleeping masks; mitres; dressing gowns; muffs; sandals; slippers; aprons; socks; cloth shoes; garment bags; baby nappies of textile material;

Class 35:

Retail services (for a wide range of goods, including cosmetics, metal goods, musical instruments, electrical appliances, stationery, household goods, food, beverages and smoking products)

and

Wholesale services for music boxes, tuning forks, batons and drumsticks, cases and bags for musical instruments, picks, stationery, artist supplies, papery articles, printing letters.

3 The applicant's appeal against this was unsuccessful (BPatG, GRUR 2023, 815).

4 With its appeal admitted by the Federal Patent Court, the applicant continues to pursue its application for registration.

5 B. The Federal Patent Court found that the registration of the sign applied for, "KÖLNER DOM", was precluded by the ground of lack of distinctive character in respect of the goods and services in question in Classes 14, 16, 25 and 35.

6 C. The applicant's admissible appeal against this is unsuccessful.

7 I. An appeal admitted without being limited to a definable part allows the Court of Appeal to conduct a full legal review of the contested decision, without this being limited to the decision on the legal issues cited as grounds for admission (Federal Supreme Court (BGH), decision of 26 November 2020 - I ZB 6/20, GRUR 2021, 482 [juris para. 8] = WRP 2021, 336 - RETROLYMPICS, with further references).

8 II. After the date of application for registration of the sign in question on 18 October 2018, the law applicable in the dispute was amended by the Act implementing Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks of 11 December 2018 (BGBl. I p. 2357) with effect from 14 January 2019. This does not result in a change in the legal situation that is relevant for the assessment of the dispute. The ground for refusal of registration of lack of distinctive character from Art. 3 (1) (b) of Directive 2008/95/EC to approximate the laws of the Member States relating to trademarks is now found in Art. 4 (1) (b) of Directive (EU) 2015/2436 to approximate the laws of the Member States relating to trademarks and is implemented unchanged by Section 8 (2) No. 1 of the German Trademark Act (MarkenG).

9 III. The Federal Patent Court's assessment that the word mark applied for lacks any distinctive character within the meaning of Section 8 (2) No. 1 of the German Trademark Act (MarkenG) for the goods and services mentioned, with the consequence that the application must be rejected pursuant to Section 37 (1) of the German Trademark Act (MarkenG), stands up to legal scrutiny.

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1. Distinctive character within the meaning of Article 4(1)(b) of Directive (EU) 2015/2436 and Section 8 (2) No. 1 of the German Trademark Act (MarkenG) is the inherent (concrete) capacity of a trademark to be perceived by the public as a distinctive sign which identifies the goods or services in question as originating from a particular undertaking and thus distinguishes the goods or services from those of other undertakings. The main function of the trademark is to ensure the identity of origin of the designated goods or services (established case law; see only ECJ, judgment of 16 September 2015 - C-215/14, GRUR 2015, 1198 [juris para. 59 f.] = WRP 2015, 1455 - Nestlé/Cadbury [Kit Kat]; BGH, decision of 22 July 2021 - I ZB 16/20, GRUR 2021, 1526 [juris para. 16] = WRP 2021, 1566 - NJW-Orange; in each case with further references). Distinctiveness must be assessed separately with regard to each of the goods or services for which the sign claims protection. The perception of the relevant public is decisive. The presumed perception of a reasonably well-informed, reasonably observant and circumspect average consumer of the goods or services in question must be taken into account (ECJ, judgment of 19 September 2019 - C-541/18, GRUR 2019, 1194 [juris para. 20] = WRP 2019, 1444 - AS/DPMA [#darferdas?]; Federal Supreme Court (BGH), decision of 31 May 2016 - I ZB 39/15, GRUR 2016, 934 [juris para. 10] = WRP 2016, 1109 - OUI, mwN). The ability to distinguish goods or services according to their origin does not apply to indications that consist of common words or phrases in German or a known foreign language that are always understood by the public only as such and not as a means of differentiation (BGH, GRUR 2016, 934 [juris para. 12] - OUI; BGH, decision of 30 January 2020 - I ZB 61/16, GRUR 2020, 411 [juris para. 11] = WRP 2020, 586 - #darferdas? II; in each case mwN). When examining whether the ground for refusal of protection of lack of distinctiveness exists, it is necessary to take into account the labelling practices in the relevant product sector (ECJ,

GRUR 2019, 1194 [juris para. 24 and 33] - AS/DPMA [#darferdas?]; Federal Supreme Court (BGH), GRUR 2020, 411 [juris para. 13] - #darferdas? II).

- 11 2. The Federal Patent Court based its judgement on these legal standards. Its judgement that the sign "KÖLNER DOM" does not have the necessary distinctive character for the goods and services in question stands up to legal scrutiny.
- 12 a) The Federal Patent Court found that the sign applied for consisted of an adjectival indication of a place ("Kölner"/"Cologne") and a designation of a building ("Dom"/"Cathedral"), which were combined in a customary linguistic manner to form a generally used term for a large church in Cologne characterised by special architectural or artistic features or a particular historical significance. Kölner Dom/Cologne Cathedral is the name of the cathedral of the Archdiocese of Cologne, a world-famous church building which was classified by UNESCO in 1996 as a European masterpiece of Gothic architecture and declared a World Heritage Site. Kölner Dom/Cologne Cathedral is known as a church, cultural monument and tourist attraction.
- 13 b) The appeal unsuccessfully challenges the Federal Patent Court's assessment that the sign applied for, "KÖLNER DOM", lacks the necessary distinctive character for the goods and services in question.
- 14 aa) The Federal Patent Court rightly held that the sign applied for lacked the necessary distinctive character for the goods in Class 16 "Photographs; printed matter; calendars; albums; pictures; books; stamps; brochures; posters; leaflets; newspapers; magazines".

- 15 (1) The ground for refusal under Section 8 (2) No. 1 of the German Trademark Act (MarkenG) precludes the registration of a trademark for goods and services designated by a broad generic term even if it exists with regard to individual goods and services falling under the generic term (cf. BGH, decision of 2 December 2004 - I ZB 8/04, GRUR 2005, 578 [juris para. 28] = WRP 2005, 889 - LOKMAUS; decision of 10 June 2010 - I ZB 39/09, GRUR 2011, 65 [juris para. 26] = WRP 2011, 65 - Letter T with dash; decision of 8 March 2012 - I ZB 13/11, BGHZ 193, 21 [juris para. 17] - Neuschwanstein).
- 16 (2) The Federal Patent Court found that the designation "KÖLNER DOM" was not distinctive for the aforementioned goods in Class 16 which showed images of Kölner Dom/Cologne Cathedral or which dealt thematically with Kölner Dom/Cologne Cathedral or with religious buildings or tourist attractions in general. This does not indicate an error of law. It is obvious that the designation "KÖLNER DOM" for such goods is understood as a thematic indication and not as an indication of origin. The appeal does not challenge this judgement of the Federal Patent Court.
- 17 bb) The Federal Patent Court denied distinctiveness with corresponding considerations with regard to the goods in class 14 "Jewelry articles; jewelry; hat ornaments of precious metals; objects of art of precious metals; cuff links; tie pins; key rings (fancy and jewelry articles); shoe ornaments of precious metal" and class 16 "paperweights; bookends; stamps; etching articles". This is also not challenged by the appeal. No errors of law are apparent in this respect. The Federal Patent Court did not err in law in finding that such goods can be modelled on church buildings in their external shape. It correctly assumed that the affixing of the sign "KÖLNER DOM" on goods designed in this way would be perceived as a descriptive indication and not as an indication of their commercial origin.

18 cc) Even to the extent that the Federal Patent Court denied the distinctive character of the sign "KÖLNER DOM" for goods in classes 14, 16 and 25, which are regularly marketed as souvenir articles, its reasoning withstands the attacks of the appeal.

19 (1) The Federal Patent Court assumed that, in connection with all the other goods in question in classes 14, 16 and 25, the public would only see the imprint "KÖLNER DOM" as a motif-like reference to the well-known sight. This is obvious, firstly, because well-known buildings and tourist attractions are often used as a decoration or motif and, secondly, because the goods in question are products which are often provided with a decoration or motif. This applies in particular to goods that are regularly marketed as souvenirs. For this purpose, products are usually labelled with the image and/or name of the respective sight and sold by various suppliers as a reminder of the visit to the famous site. The better known an attraction is, the larger and more comprehensive the range of souvenir items is. Almost all of the goods claimed in classes 14, 16 and 25 are also commonly used as souvenirs, such as brochures, key rings, watches and jewelry and umbrellas with the name or image of Kölner Dom/Cologne Cathedral. Typical souvenir items also include bags and stationery. For example, offers of gym bags, shopping bags and ballpoint pens with Kölner Dom/Cologne Cathedral in words and pictures could be identified. Consumer goods such as shaving brushes or hair brushes, which fall under the brushes mentioned in class 16, are also decorated with the motif of Kölner Dom/Cologne Cathedral and are suitable as souvenirs. Even the mitres and maniplets claimed in class 25 are available as souvenirs and are purchased as such as souvenirs of religious events or souvenirs from travelling. It must therefore be

assumed that the public perceives such goods with the designation "KÖLNER DOM" as memorabilia relating to it and the designation itself not as an indication of the manufacturer. The latter could at best be considered in the case of the use of designations which are recognisable to the public as referring to the commercial entity behind them, such as "Archbishopric of Cologne" or "Cologne Cathedral Chapter". As far as the applicant argues that the targeted public is aware that the preservation of an architectural monument is associated with high costs and that it will therefore always conclude that the applicant is the supplier when encountering goods with the designation "KÖLNER DOM", this cannot be accepted. Such an understanding is contradicted by the large number of souvenir shops of various suppliers around places of interest, which regularly stock a similar range of goods with the image or the name of the place of interest. Accordingly, numerous such souvenir shops could also be researched around Kölner Dom/Cologne Cathedral, which were obviously operated by different, competing companies.

20 (2) The mere fact that the goods in question can be sold to tourists in the vicinity of Kölner Dom/Cologne Cathedral does not mean that the trademark "KÖLNER DOM" is devoid of any distinctive character for the goods in question. Rather, the decisive factor is whether the public perceives the use of the sign for these goods merely as a reference to Kölner Dom/Cologne Cathedral as a building or as a means of distinguishing the products (see BGHZ 193, 21 [juris para. 24] - Neuschwanstein). Any distinctive character is lacking if the targeted public only relates the word "KÖLNER DOM" to the building in connection with travel souvenirs and supplies due to the high profile of Kölner Dom/Cologne Cathedral and therefore does not perceive it as a product identifier (see BGHZ 193, 21 [juris para. 15] - Neuschwanstein). According to the findings of the Federal Patent Court,

this is the case with regard to the goods in question in Classes 14, 16 and 25.

21 (3) The Federal Patent Court rightly assumed that this assessment does not conflict with the decision of the Court of Justice of the European Union "Neuschwanstein" (ECJ, judgment of 6 September 2018 - C-488/16, GRUR 2018, 1146 - Bundesverband Souvenir - Geschenke - Ehrenpreise/EUIPO [Neuschwanstein]).

22 (a) The Court of Justice of the European Union has ruled that it is irrelevant for the assessment of the descriptive character of the term "Neuschwanstein" that the goods covered by such a sign are sold as souvenirs. The fact that a product is intended to function as a souvenir is not an objective characteristic inherent in the nature of the product, since this function depends on the free will of the buyer and is solely orientated towards his intentions. It cannot reasonably be expected that the memory to which the term "Neuschwanstein" refers indicates, in the eyes of the relevant public, a quality or an essential characteristic of the goods and services covered by the contested trademark (ECJ, GRUR 2018, 1146 [juris para. 44 and 46] - Bundesverband Souvenir - Geschenke - Ehrenpreise/EUIPO [Neuschwanstein]).

23 However, the appeal based on this judgement of the Court of Justice of the European Union is not successful. With these considerations, the Court of Justice of the European Union did not deal with the ground for refusal of protection of lack of distinctive character regulated in Article 7(1)(b) of Regulation No 207/2009 on the European Union trademark (EUTMR, old version). Rather, at this point in its decision, it had to review whether the attacks against the decision of the General Court of the European Union that the name "Neuschwanstein" was not descriptive

within the meaning of Art. 7 para. 1 lit. c EUTMR (old version). The Court of Justice of the European Union has thus exclusively ruled that the character of an article as a souvenir article is irrelevant for this assessment. This judgement has no direct relevance to the case in dispute. According to the case law of the Court of Justice of the European Union and the Senate, the grounds for refusal in Section 8 (2) nos. 1 and 2 of the German Trademark Act (MarkenG) (Art. 4 (1) lit. b and c of Directive (EU) 2015/2436), even if their areas of application overlap, must be examined independently and separately, whereby each ground for refusal must be interpreted in the light of the public interest underlying it (ECJ, judgment of 12 February 2004 - C-363/99, ECR 2004, I-1619 = GRUR 2004, 674 [juris para. 67 f.] - Postkantoor; BGHZ 193, 21 [juris para. 28] - Neuschwanstein). In the present case, it is not necessary to examine whether the sign "KÖLNER DOM" is descriptive of the goods in question and whether the ground for refusal under Section 8 (2) No. 2 of the German Trademark Act (MarkenG) applies. In the case in dispute, the Senate alone has to examine whether the Federal Patent Court affirmed the existence of the ground for refusal of the lack of distinctive character (Sec. 8 (2) No. 1 of the German Trademark Act (MarkenG)) without error of law.

24 (b) In the "Neuschwanstein" decision, the Court of Justice of the European Union also dealt with the ground for refusal of protection of lack of distinctive character pursuant to Article 7(1)(b) EUTMR (ECJ, GRUR 2018, 1146 [juris para. 61 to 71] - Bundesverband Souvenir - Geschenke - Ehrenpreise/EUIPO).

25 The General Court of the European Union had assumed that the contested trademark "Neuschwanstein" had distinctive character for the goods and services in question. It constituted a fanciful name with no descriptive reference to those goods and services. The Court of Justice of the European Union has reproduced the assessment of the General Court of the European Union in detail (ECJ, GRUR

1146 [juris para. 64 to 67] - Bundesverband Souvenir - Geschenke - Ehrenpreise/EUIPO [Neuschwanstein]).

26 However, the Court of Justice of the European Union did not subject this judgement of the General Court of the European Union to a legal review. In view of the grounds of appeal, it had only to examine whether the General Court of the European Union had given inadequate reasons for its decision. It answered this question in the negative with regard to the reasoning of the General Court of the European Union reproduced by it (ECJ, GRUR 2018, 1146 [juris para. 62 to 63 and 69] - Bundesverband Souvenir - Geschenke - Ehrenpreise/EUIPO [Neuschwanstein]). It also rejected the complaint that the reasoning of the General Court of the European Union was circular (ECJ, GRUR 2018, 1146 [juris para. 68] - Bundesverband Souvenir - Geschenke - Ehrenpreise/EUIPO [Neuschwanstein]). The complaint against the assessment of the General Court of the European Union that the contested trademark makes it possible to distribute the goods and provide services identified by it, the quality of which the trademark proprietor can control, was not subject to a substantive examination by the Court of Justice of the European Union because it considered it to be directed against an unsubstantiated auxiliary consideration (ECJ, GRUR 2018, 1146 [juris para. 70] - Bundesverband Souvenir - Geschenke - Ehrenpreise/EUIPO [Neuschwanstein]).

27 (c) The appeal rightly asserts that it must also be taken into account when examining the distinctive character of a sign applied for that there is no abstract product category of "souvenir articles" in the Nice classification system of goods and services for trademark applications. The decisive factor when examining distinctiveness in the context of application or invalidity proceedings is whether the sign applied for can be regarded by the relevant public as an indication

of the commercial origin of the goods or services in question for which the sign claims protection. However, the Federal Patent Court did not focus abstractly on a category of goods of "souvenir articles", but examined in each case in relation to the individual goods applied for whether the sign "KÖLNER DOM" is recognised as an indication of origin for goods that could be considered as souvenirs or travel necessities. In particular in the case of goods for which this is not immediately obvious, such as the goods in Class 25 "Mitren" and "Manipel", which it considered separately, the Federal Patent Court made findings which support its assessment. Insofar as the appeal asserts that these findings do not take sufficient account of the applicant's submissions contradicting this assessment and are contrary to life experience, it substitutes its assessment for that of the Federal Patent Court in a manner that is irrelevant in appeal proceedings without demonstrating an error of law.

28 dd) The assessment of the Federal Patent Court that for those goods which are not or rather rarely sold as souvenirs in souvenir shops, the target public will perceive the sign applied for as purely decorative or as a message to the environment, but not as a product identifier, also does not show any error of law.

29 (1) The Federal Patent Court assumed that with regard to those goods which were not or rather rarely sold as souvenirs in souvenir shops and which therefore did not constitute typical souvenir articles such as "baby nappies made of paper or cellulose; football boots; sports shoes; hiking boots; studs for football boots; baby nappies made of textile material", an exclusively factual understanding was also obvious. These goods are often provided with motifs which are either purely decorative or act as a message to the environment, but not as product identifier.

The former applies without further ado to baby nappies which are offered with colourful prints. The latter can be seen, for example, in football boots that are decorated by their wearers with confessions such as "Jesus in first place" or "La mano de Dios" or cross or crescent symbols.

30 (2) The Federal Patent Court has thus established that the public does not recognise the designation "KÖLNER DOM" on goods that are not considered to be souvenirs as an indication of commercial origin. The appeal does not raise any separate objections to this assessment.

31 ee) The appeal asserts without success that the Federal Patent Court did not examine all probable types of use of the trademark applied for. The applicant does not intend to use the trademark applied for exclusively for the sale of souvenirs.

32 (1) The distinctiveness of a sign applied for as a trademark must be assessed taking into account all relevant facts and circumstances, including all likely uses of the trademark applied for (see ECJ, GRUR 2019, 1194 [juris para. 33] - AS/DPMA [#darferdas?]; BGH, GRUR 2020, 411 [juris para. 15] - #darferdas? II). The usual labelling practices in the goods sector in question must be taken into account. If several types of use are practically significant in the relevant sector, all these different types of use must be taken into account when assessing distinctiveness in order to clarify whether the average consumer of the goods or services covered can perceive the sign as an indication of their commercial origin (see ECJ, GRUR 2019, 1194 [juris para. 25] - AS/DPMA [#darferdas?]; BGH, GRUR 2020, 411 [juris para. 15] - #darferdas? II). Therefore, whether a sign is understood by the relevant public as an indication of commercial origin in an individual case may depend on

the actual manner in which it is affixed to or in connection with the relevant goods or services. In registration and cancellation proceedings, the assumption of distinctiveness does not require that every conceivable use of the sign must be understood as an indication of commercial origin. It is sufficient if there are practically significant and obvious ways of using the sign in relation to the goods and services for which it claims protection in such a way that it is readily understood by the public as a trademark. However, the affixing of a sign in the form of a trademark on the goods, on labels of the goods in question or on the packaging does not invariably lead to the public understanding it as an indication of origin. Rather, even with this type of affixing, the answer to the question of whether the public regards the sign as an indication of origin may vary depending on the type of sign and the goods to which it is affixed. This may be the case, for example, if the public perceives the trademark word only in a descriptive sense due to a particular proximity to the possible uses of the goods, irrespective of the specific presentation on the goods, on labels, tags, patches or packaging, and therefore does not infer any indication of origin from it (see BGHZ 193, 21 [juris para. 20] - Neuschwanstein). The Federal Patent Court proceeded on the basis of these principles.

33 (2) The Federal Patent Court assumed that even if the sign "KÖLNER DOM" was applied in a manner typical of a trademark, the material reference of the designation "KÖLNER DOM", be it in the sense of a commemoration, be it as mere decoration or motif, was in the foreground for all the goods claimed. Even taking into account all practically significant and therefore probable types of use in connection with the goods claimed, the sign applied for is not perceived as a means of commercial differentiation. Neither in the case of a clearly visible placement on the

outside or front of the goods or their packaging, nor in the case of affixing in a place that is not immediately obvious, would the public assume that the designation of a world-famous landmark is an indication of commercial origin. Thus, the Federal Patent Court has not established a probable form of use for the goods in question in which the sign applied for is recognised as an indication of commercial origin.

34 ff) The appeal is also unsuccessful insofar as it challenges the Federal Patent Court's assessment that the sign applied for, "KÖLNER DOM", lacks the necessary distinctive character for the retail and wholesale services claimed.

35 aa) The Federal Patent Court assumed that the retail services covered a wide range of products from cosmetics, metal goods, musical instruments, electrical appliances, stationery and household goods to food, beverages and smoking goods. In this context, too, the public will only refer to the name "KÖLNER DOM" in relation to the building and the location. Insofar as the respective goods sold in the retail trade are souvenir articles or content-related or decorative products, the public will perceive the sign of application as a factual indication that provides information about the type and thematic orientation of the goods on offer. At the same time, it could designate the place of supply around Kölner Dom/Cologne Cathedral, which is a defining characteristic of the location-related services of the retail trade. The designation "KÖLNER DOM" conveys a sufficiently close factual reference, irrespective of the specific range of goods, since all goods offered in the context of retail trade, and thus also those which are neither typical souvenir or decorative articles nor content-related, can be sold in shops near Kölner Dom/Cologne Cathedral. Finally, the sign applied for is also limited to a purely factual indication

in relation to 'wholesale services for music boxes, tuning forks, batons and drumsticks, cases and bags for musical instruments, plectrums, stationery, artists' requisites, papery articles, printing letters'. These goods are souvenir articles. The sign applied for concretises the product range of the wholesaler to the effect that these are products which evoke or perpetuate the memory of Kölner Dom/Cologne Cathedral.

36 bb) This assessment does not reveal any legal error.

37 (1) Contrary to the opinion of the appellant, it is not apparent from this that the Federal Patent Court was influenced by the idea of a general need to keep the designation of buildings of outstanding cultural value free (see BGHZ 193, 21 [juris para. 26 and 29 f.] - Neuschwanstein).

38 (2) The mere fact that the services in question can be provided to tourists in the vicinity of a cultural and tourist attraction does not lead to the absence of any distinctive character (see BGHZ 193, 21 [juris para. 24] - Neuschwanstein). However, the Federal Patent Court did not base its decision on this. Rather, it correctly took into account the special nature of the sign at issue here. On the one hand, this sign consists of a concrete, adjectival indication of a place and the designation of a specific type of sacred building. It refers to a specific city in Germany and a church building which can be clearly identified in that city and which is located at a specific location within the city. In view of the nature of the sign applied for in this case, the Federal Patent Court could conclude without error

of law that the public would only understand its use for the services in question as a reference to the geographically localizable building "Kölner Dom/Cologne Cathedral" and not as a means of distinguishing the services in question.

39 IV. A referral to the Court of Justice of the European Union pursuant to Art. 267 (3) TFEU is not required.

40 1. No question of relevance to the interpretation of Union law arises which has not already been clarified by the case law of the Court of Justice or which cannot be answered beyond doubt (on this standard cf. ECJ, judgment of 6 October 1982 - 283/81, ECR 1982, 3415 [juris para. 21] = NJW 1983, 1257 - Cilfit and others; judgment of 6 October 2021 - C-561/19, NJW 2021, 3303 [juris para. 32 f.] - Consorzio Italian Management and Catania Multiservizi).

41 2. Insofar as the Court of Justice of the European Union in its decision on the protectability of the sign "Neuschwanstein" as an EU trademark (ECJ, GRUR 2018, 1146 - Bundesverband Souvenir - Geschenke - Ehrenpreise/EUIPO [Neuschwanstein]) came to a partially different decision than the Senate on the identical national trademark (BGHZ 193, 21 - Neuschwanstein), this circumstance does not require a request for a preliminary ruling.

42 It is true that the grounds for refusal in relation to EU trademarks and national trademarks must be interpreted in the same way. However, the case law of the Court of Justice of the European Union and that of the Senate are based on the same standards. Therefore, there are no unresolved questions regarding the interpretation of Union law.

43 The partially divergent assessment of the protectability of the sign "Neuschwanstein" by the Court of Justice of the European Union and the Senate is based on the fact that the Court of Justice of the European Union - just like the

Federal Supreme Court (BGH) - has to carry out a legal review in the registration proceedings alone and in doing so has to base its findings on the facts of the lower court. The European Union Intellectual Property Office and the Federal Patent Court had not made the same findings with regard to the public's understanding of the meaning of the sign "Neuschwanstein". Furthermore, on the basis of the findings of the Federal Patent Court, the Senate alone had to examine whether the latter had rightly affirmed the ground for refusal of the lack of distinctive character. With regard to this ground for refusal, the Court of Justice of the European Union only examined whether the General Court of the European Union had sufficiently substantiated its decision and did not carry out a legal review in this respect.

44 D. The decision on costs is based on Section 90 (2) sentence 1 of the German Trademark Act (MarkenG).

Koch

Schwonke

Feddersen

Pohl

Schmaltz

Previous instance:

Federal Patent Court, decision of 19 January 2023 - 25 W (pat) 526/21 -