State Supreme Court Rejects Trademark Claim to the Name "Johann Sebastian Bach"

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[1] On April 4, 2000, the Lower Saxony *Oberlandesgericht* (state Supreme Court) sitting in Dresden issued a decision, the importance of which quickly spread among intellectual property lawyers and other professionals in the Art Scene. The case was not published until recently, however, and *German Law Journal* reports on the case at this late date because it because it continues to stir considerable debate about trademark claims made on names, images or other fixtures of cultural heritage.

[2] The Court had before it a suit that was little more than an ordinary trademark case, except for the fact that the disputed registered mark was the name "Johann Sebastian Bach." The defendant had, in early 1999, registered the name as a trademark and soon thereafter demanded that the plaintiff, arguably Europe's oldest porcelain manufacturer, stop making references to or using the name, image or other identifying means connected with the composer (1685-1750) until it had paid a "user's fee." The porcelain manufacturer sued to secure its right to use the "Bach" trademark without paying the fee demanded by the defendant.

[3] The Court reached the only sensible conclusion, denying the defendant's allegation that the plaintiff's use of the name or image of J.S. Bach constituted a violation of the defendant's recently registered "Bach" trademark. The Court emphasized from the beginning that the plaintiff's use of Bach's name and image is not one that can be subsumed under the protections afforded trademarks. The Court especially drew on the decision of the Court of Justice of the European Communities in the *BMW/Deenik Case,* published in *EuzW* 1999, p. 244 and *Juristenzeitung* 1999, p. 835. In that case the ECJ stressed that trademark protection is to be extended only if the mark is being used to differentiate the product of one firm from similar products of another firm. While a wider understanding of a "mark" has generally been accepted within the intellectual property law community, the relationship to a product and a firms efforts at distinguishing and promoting that product still lie at the center of trademark law. In order to be recognized as a mark-related use of a name or image, the mark must identify the product as being from a specific manufacturer. The State Supreme Court, in the present case, held that where the mark exploits current events or uses the name or image of a *Personen der Zeitgeschichte* (persons of common/public knowledge), the mark is not being used to identify a certain product. The Court reasoned that the consumer market would not understand the use of the name "Johann Sebastian Bach" to be the identifying mark of a specific manufacturer. Furthermore, the Court had a strong normative objection to assigning trademark protection to the name "Johann Sebastian Bach," fearing that such protection would endanger the free process of interpreting, discussing and informing about Bach.

[4] The Court further held that, even if the defendant were to create a specific product line under the trademark "Johann Sebastian Bach," this still would not lead to a danger of confusion between the parties' products. The Court concluded that the mark "Bach" much too weakly identifies a single product, a line of products or a manufacturer and therefore the defendant could not claim that a clear link between its products will be violated by the plaintiff's use of the name "Bach." The name "Bach," the Court said, is part of the common cultural *aquis* and as such bears little originality or specificity. Bach being as famous as he is, the Court reasoned there can be no more than negligible identifying value in a firm's use of his name. Rather than serving to specifically identify a product line, the Court wondered if the use of a mark like "Bach" would have the opposite effect of suggesting that the products have very different origins.

[5] Ultimately, the Court found that the public holds a strong interest in keeping the name "Bach" free of mark related monopolization by any one person or entity. If there had been a wide and reinforced use of the mark "Bach" by the plaintiff, there might be the possibility of a small, historic, identifying function between the composer's name/image and the plaintiff's porcelain products. The Court concluded that the plaintiff has not made such extensive use of the mark "Bach" nor is it expected to do so in the future.

[6] Even while undermining any claim the plaintiff might have to trademark protection to the name "Bach," the Court undertook its own, brief, analysis concerning the defendant's potential *Rechtsmißbrauch* (abuse of process -- *see* Section 242 of the German Civil Code). In light of the fact that the defendant registered a number of other "celebrities" as trademarks along with "Bach," the Court questioned the defendant's motives, suspecting that they are aimed entirely at hindering the commercial activities of others. While frowning on such practice, the Court correctly noted that the *Markengesetz* (German Federal Trademark Law) does not strictly require the plaintiff to pursue a commercial activity in connection with the registered mark. (*See* "DaimlerChrysler Beats Trademark Speculators in Federal Court of Justice," *German Law Journal,* Vol. 2; No. 02/2001, 31 January 2001).

[7] The decision is hardly a surprise, considering the absurdities that would result from any other judgment in the

case. The Court's claim that the name "Bach" belongs to the cultural heritage resonates, but the case shows that there will be - again and again - the need to define the boundaries of private commercial activities in the name of the public's interest.

For more information:
Decision of the Oberlandesgericht Dresden, April 4, 2000 - 14 U 3611/99, published in Neue Juristische Wochenschrift (NJW) 2001, pp. 615-618.

Full text of the German Federal Trademark Law (Markengesetz) (German) on-line:
www.transpatent.com

Brief comment on Dresden's porcelain history (English) on-line:
www.dreseden.de/rooteng/economy/01/0101.html