CASE NOTE

Note that all case law is reported essentially verbatim; in some instances, commentary has been taken from online contributions. None of the text or related text represents a view, opinion or guidance from GRS, but is there simply for information to be interpreted as marketers or their legal advisors see fit

Case note re UWG 'imitation or replica' clause

Clause concerned UWG Section 6 (2) Unfairness shall have occurred where a person conducting comparative advertising uses a comparison which: 6. Presents goods or services as imitations or replicas of goods or services sold under a protected distinguishing mark.

- Notable examples, therefore, are imitation claims using phrases such as "smells like," concerning famous and well known perfumes. Key case-law: Imitation/ Replicas: See, e.g., BGH GRUR 2008, 628, 631 – Imitationswerbung; BGH GRUR 2010, 343, 345 – Oracle; BGH GRUR 2011, 1153, 1155¬ Creation Lamis. German law: case example: BGH GRUR 1985, 876 – Tchibo/Rolex.

- The German Bundesgerichtshof settled on a rather diffuse, but practically flexible formula: Principally, comparative advertising need not expressly use the term "imitation" or "replica" in order to be characterized a non-permissible claim. It may also comprise information that only implicitly transfers such a message. Yet, and this is where the problems begin, the prohibition on imitation and replication claims must not cover claims for equivalence or identity as such. In other words, even German judges seem to have learned a lesson of economic reason: a competitor must always be allowed to inform the marketplace about the features of a product. Since, without such information, competition would be impossible.

- When making a comparison, it is not permitted to present one's own product or service as an imitation of products/services that are sold under a protected trademark. Therefore: freedom of imitation unless product protected by IP rights. There is nothing wrong, therefore, in comparing 'no-name' products with well-known branded goods, but the advertiser must not create the impression that he is imitating these branded goods.

- The sense of this restriction is not quite clear: As long as it is permitted under competition law to imitate products - which is the case in principle in Germany in the case of products that are not protected by IP rights (*Baumbach/Hefermehl*, *Wettbewerbsrecht*, 21st ed. 1999, § 1, no. 439 et seq) – one could argue that truthfully informing consumers about the existence of such products is in their interest.

- One area in which it will probably be of special relevance is that of advertising for generic pharmaceutical products, which imitate branded products that are well established in the market and whose patent protection has expired.

.....