

BrownBags «Metaverse»

Markenrechte im Metaverse

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JAN
31
ZOOM

🕒 13:00

🕒 14:00

V EBLAW
ACADEMY

AGENDA

1. Was ist das Metaverse?
2. Markenrechtliche Fragestellungen
 - Was für Probleme haben sich bislang gestellt?
 - Was sagen die Markenämter?
 - Welche Fälle gibt es bereits?
3. Empfehlungen

1.

Was ist das Metaverse?

Quelle: EvgeniyShkolenko/iStock



WAS IST DAS METAVERSE?

«Ein kollektiver, virtueller 3D-Raum, in dem sich Menschen in Form von individuellen Avataren frei bewegen und miteinander interagieren können»

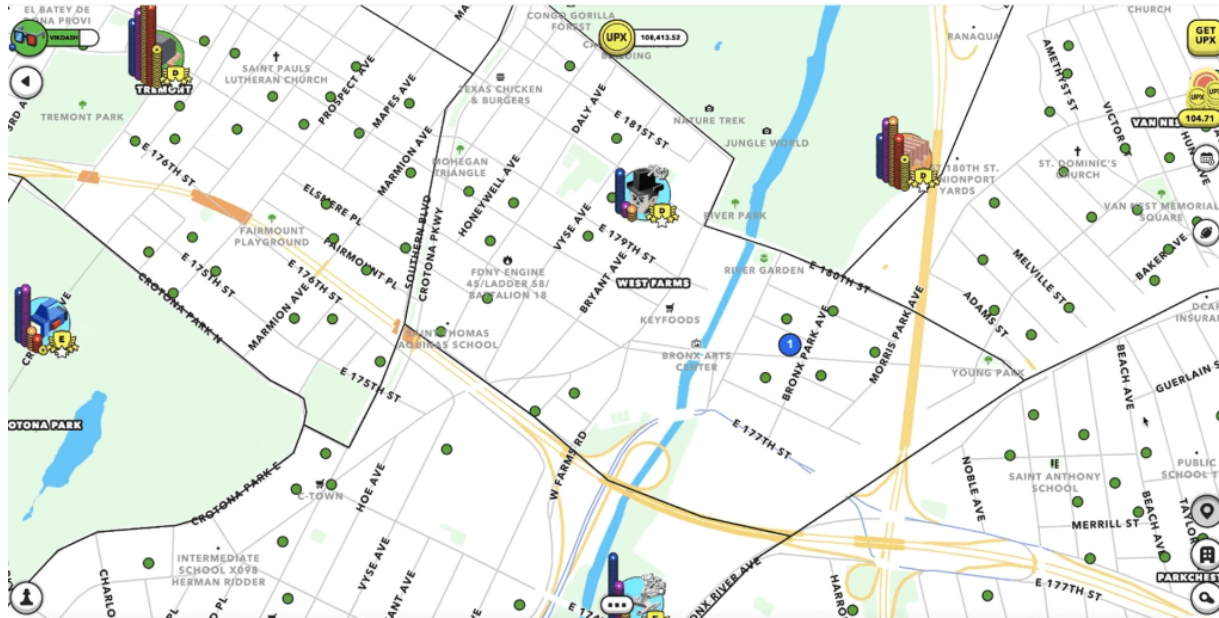
«The metaverse is an embodied internet that you're inside of rather than just looking at.» (Mark Zuckerberg)

WAS IST DAS METAVERSE?

- Offen, in Echtzeit, dezentral und interoperabel
- AR und VR sind nicht zwingend notwendig
- Verknüpfung von realer und digitaler Welt mit Blockchain-Technologie
- Verknüpfung von Phantasie und daily business.

WAS IST DAS METAVERSE?

- Beispiele: Upland



Quelle: Upland

WAS IST DAS METAVERSE?

- Beispiele: The Sandbox



Quelle: The Sandbox Alpha/Florian Heide

WAS IST DAS METAVERSE?

- Beispiele: Decentraland



Quelle: Decentraland

WAS GESCHIEHT IM METAVERSE UND WO TAUCHEN MARKEN AUF?


- Sozialisierung, virtuelles Arbeiten
- Individualisierung der Avatare (digitale Mode und Gadgets)
- Virtuelle Shops, Galerien, Modenschauen, Auktionen (z.B. Sotheby's)
- Digitale Produkte oder Dienstleistungen aller Art (auch als Substitut für reale Produkte)
- Werbung im Metaverse

WAS PASSIERT BISHER?

- Marken-Eldorado? Mißbräuchliche Anmeldungen, Nachanmeldungen, zB Nike beim EUIPO, Virtuelle Markenpräsenz



Graphic representation



Goods and services

Deutsch (de)

9 Herunterladbare virtuelle Waren, nämlich, Computerprogramme mit Schuhwaren, Bekleidungsstücken, Kopfbedeckungen, Brillen, Taschen, Sporttaschen, Rucksäcken, Sportausrüstungen, Kunst, Spielzeug und Zubehör zur Verwendung online und in virtuellen Online-Welten.

35 Einzelhandelsdienstleistungen in Bezug auf die folgenden Waren: Virtuelle Waren, nämlich, Schuhwaren, Bekleidungsstücke, Kopfbedeckungen, Brillenerzeugnisse und Kontaktlinsen Sporttaschen, Rucksäcke, Sportausrüstungen, Kunst, Spielzeug und Accessoires. Alle vorgenannten Waren zur Verwendung online; Online-Einzelhandelsdienstleistungen in Bezug auf die folgenden Bereiche: Virtuelle Handelsware, nämlich, Schuhwaren, Bekleidungsstücke, Kopfbedeckungen, Brillenerzeugnisse und Kontaktlinsen, Taschen, Sporttaschen, Rucksäcke, Sportausrüstungen, Kunst, Spielzeug und Accessoires.

41 Dienstleistungen im Bereich Unterhaltung, nämlich, Online-Bereitstellung von nicht herunterladbaren virtuellen Schuhwaren, Bekleidungsstücken, Kopfbedeckungen, Brillen, Taschen, Sporttaschen, Rucksäcken, Sportausrüstungen, Kunst, Spielzeug und Zubehör zur Verwendung in virtuellen Umgebungen.

Quelle: EUIPO

Quelle: Gucci Town/Roblox

WAS PASSIERT BISHER?

HERMES

Word Mark
Goods and
Services

HERMES

IC 009. US 021 023 026 036 038. G & S: Downloadable mobile applications for providing access to virtual, augmented, or mixed reality environments; downloadable mobile applications for creating, collecting, trading, exchanging, purchasing, renting, sharing, viewing, displaying, operating, using, storing, interacting with, and/or managing virtual goods, namely, computer programs featuring clothing, woven fabrics, footwear, headwear, gloves, rings for scarves, scarves, ties as clothing, riding helmets, hair pins, hair scrunchies, clothing belts, belt clasps, buttons, beach towels, fragrance and perfumery, non-medicated toiletry preparations, creams for leather, cosmetics, eyewear, jewelry, medals, pendants, precious metals, precious stones, jewelry cases, clocks, watches, watch straps, watch cases, hairbrushes, cigar boxes and cases, carry-all bags, suitcases, briefcases, purses, purse charms, charms for shoes, business card cases, key rings, umbrellas, wallets, passport holders, wood boxes, leather boxes, metal locks for bags, metal padlocks, binoculars, magnifying glasses, directional compasses, electric storage batteries, computers, tablet computers, smartphones, covers for portable telephones, covers for tablet computers, headphones, memory cards, electronic agendas, pet accessories, candles, metal silverware and cutlery, support bandages, standard lamps, light shades, flashlights, bicycles, automobiles, boats, airplanes, music boxes, bags of textile for packaging, paper bags, wrapping paper, stationary, printed agendas, desk file trays, trays for domestic purposes, pencils, pens, paper weights, mouse pads, desk blotters, pen or pencil holders, waste baskets, paint brushes, drawings and photographs, stickers, maps, picture frames, photo albums, household or kitchen containers, ashtrays, beverage glassware, tableware of porcelain, vases, display boards, wallpaper, carpets, household linen, furniture, decorations for Christmas trees, saddlery, balls for games, plush toys, toy building blocks, infant toys, kites, electronic learning toys, smart robot toys, and board games for use online and for use in online virtual worlds; downloadable mobile applications for creating, collecting, trading, exchanging, purchasing, renting, sharing, viewing, displaying, operating, using, storing, interacting with, and/or managing digital animated and non-animated designs and characters, avatars, digital overlays and skins for access and use in online environments, virtual online environments, and extended reality virtual environments; downloadable multimedia file containing artwork relating to computer programs featuring clothing, woven fabrics, footwear, headwear, gloves, rings for scarves, scarves, ties as clothing, riding helmets, hair pins, hair scrunchies, clothing belts, belt clasps, buttons, beach towels, fragrance and perfumery, non-medicated toiletry preparations, creams for leather, cosmetics, eyewear, jewelry, medals, pendants, precious metals, precious stones, jewelry cases, clocks, watches, watch straps, watch cases, hairbrushes, cigar boxes and cases, carry-all bags, suitcases, briefcases, purses, purse charms, charms for shoes, business card cases, key rings, umbrellas, wallets, passport holders, wood boxes, leather boxes, metal locks for bags, metal padlocks, binoculars, magnifying glasses, directional compasses, electric storage batteries, computers, tablet computers, smartphones, covers for portable telephones, covers for tablet computers, headphones, memory cards, electronic agendas, pet accessories, candles, metal silverware and cutlery, support bandages, standard lamps, light shades, flashlights, bicycles, automobiles, boats, airplanes, music boxes, bags of textile for packaging, paper bags, wrapping paper, stationary, printed agendas, desk file trays, trays for domestic purposes, pencils, pens, paper weights, mouse pads, desk blotters, pen or pencil holders, waste baskets, paint brushes, drawings and photographs, stickers, maps, picture frames, photo albums, household or kitchen containers, ashtrays, beverage glassware, tableware of porcelain, vases, display boards, wallpaper, carpets, household linen, furniture, decorations for Christmas trees, saddlery, balls for games, plush toys, toy building blocks, infant toys, kites, electronic learning toys, smart robot toys, and board games for use online and for use in online virtual worlds; downloadable software for generating non-fungible tokens (NFTs) used with blockchain technology, namely, digital media with blockchain technology for representing a collectible item; downloadable virtual goods, namely, computer programs featuring clothing, woven fabrics, footwear, headwear, gloves, rings for scarves, scarves, ties as clothing, riding helmets, hair pins, hair scrunchies, clothing belts, belt clasps, buttons, beach towels, fragrance and perfumery, non-medicated toiletry preparations, creams for leather, cosmetics, eyewear, jewelry, medals, pendants, precious metals, precious stones, jewelry cases, clocks, watches, watch straps, watch cases, hairbrushes, cigar boxes and cases, carry-all bags, suitcases, briefcases, purses, purse charms, charms for shoes, business card cases, key rings, umbrellas, wallets, passport holders, wood boxes, leather boxes, metal locks for bags, metal padlocks, binoculars, magnifying glasses, directional compasses, electric storage batteries, automobiles, boats, airplanes, music boxes, bags of textile for packaging, paper bags, wrapping paper, stationary, printed agendas, desk file trays, trays for domestic purposes, pencils, pens, paper weights, mouse pads, desk blotters, pen or pencil holders, waste baskets, paint brushes, drawings and photographs, stickers, maps, picture frames, photo albums, household or kitchen containers, ashtrays, beverage glassware, tableware of porcelain, vases, display boards, wallpaper, carpets, household linen, furniture, decorations for Christmas trees, saddlery, balls for games, plush toys, toy building blocks, infant toys, kites, electronic learning toys, smart robot toys, and board games for use online and for use in online virtual worlds; downloadable software for creating, purchasing, and interacting with interactive characters, avatars and skins for use online and for use in online virtual worlds; downloadable software for managing hardware wallets of virtual goods, places or characters, digital collectibles and non-fungible tokens (NFTs); virtual, augmented or mixed reality headsets; wearable computer hardware, namely, wearable computer peripherals; peripherals adapted for use with computers regarding virtual reality; wearable digital electronic devices, namely, near-eye display devices in the nature of virtual reality glasses; wearable digital electronic devices consisting of software and display screens, namely, wearable computers; peripherals adapted for use with computers regarding virtual reality; wearable digital electronic devices, namely, near-eye display devices in the nature of virtual reality glasses; smart glasses, namely, virtual augmented reality glasses and virtual reality glasses; three dimensional (3D) glasses, namely, virtual augmented reality headsets and virtual reality headsets; ocularly; hologram apparatus; holograms; security tokens (encryption devices); shirts fitted with sensors for use with computers regarding virtual reality; gloves fitted with sensors for use with computers regarding virtual reality; virtual reality gloves; downloadable computer files for accessing, creating, collecting, trading, exchanging, purchasing, renting, sharing, viewing, displaying, operating, using, storing, interacting with and/or managing virtual goods, places or characters, digital collectibles and non-fungible tokens (NFTs); downloadable virtual goods, namely, computer programs featuring digital collectibles and non-fungible tokens (NFTs) for use online and in virtual environments; downloadable augmented reality game software; downloadable virtual reality game software; downloadable electronic game software; downloadable computer software for managing transactions using blockchain technology; downloadable computer software for trading, viewing, storing and/or managing virtual goods, digital collectibles, cryptocurrencies and non-fungible tokens (NFTs); downloadable computer game software featuring virtual goods, namely, digital collectibles and non-fungible token for use in online virtual worlds; downloadable computer software for the creation, production and modification of digital animated and non-animated designs and characters, avatars, digital overlays and skins for access and use in online environments, virtual online environments, and extended reality virtual environments

Quelle: USTPO

Quelle: Gucci Town/Roblox



2. Markenrechtliche Fragestellungen

MARKENRECHTLICHE PROBLEME

- Rechtsbegründung
 - *Bestehender Markenschutz oder Neuanmeldung?*
 - *Gefahr durch Zwischenrechte im Markenregister*
- Rechtserhaltung
 - *Wie findet Rechtserhaltende Benutzung im Metaverse statt?*
- Rechtsverletzung
 - *Wie sehen Markenbenutzungen im Metaverse aus (virtuelle Gucci-Tasche)?*
 - *Markenmäßige Verwendung*
 - *Anwendbarkeit Erschöpfungsgrundsatz*
 - *Verwechslung von virtuellen und physischen Waren*
 - *Reichweite des Markenschutzes / **Anwendbares Recht** / Gerichtsstand*
- Rechtsdurchsetzung

MARKENRECHTLICHE PROBLEME

- Bestehender Markenschutz oder Neuanmeldung?
- Zwischenrechte beachten!
- Waren-/Dienstleistungsverzeichnis genau erstellen

RECHTSERHALTUNG

- Wie funktioniert hier die rechtserhaltende Benutzung?
 - *Nur digital, nur physisch, oder beides?*
 - *Was ist das relevante Gebiet, in dem die Benutzung stattfindet?
Deutschland, EU, USA, China?*

RECHTSDURCHSETZUNG

- Reichweite des Markenschutzes (§ 14 MarkenG, Art. 9 UMV) -> Territorialitätsprinzip
- Gerichtsstand
 - *Deutsche Marke: § 12 ZPO, Art. 7 Nr. 2 EuGVVO -> Handlungs- und Erfolgsort (EuGH – Wintersteiger) Schweiz: Lugano Übereinkommen*
 - *UM: Art. 125 I und V UMV: Beklagtenwohnsitz, (nur) Handlungsort (EuGH – Coty Germany)*
- Anwendbares Recht
 - *Art. 8 I Rom-II-VO -> Schutzlandprinzip*
 - *Problem: Streudelikte*

RECHTSDURCHSETZUNG

- Wie sieht eine markenmäßige Verwendung im Metaverse aus?
- Inwiefern gilt der Erschöpfungsgrundsatz?
 - «Ware»?
 - «Inverkehrbringen»?
- Gibt es Besonderheiten bei der Begründung der Verwechslungsgefahr?

USE CASE: HERMÈS / MASON ROTHSCHILD

- Markenrechtsverletzung oder Kunst?
- Hermès' Argumentation:
 - Markenverwässerung
 - Cybersquatting
 - Rufausbeutung („*if this wasn't called Birkins, would it get any attention?*“)
- Rothschilds Argumentation
 - Keine markenmäßige Benutzung
 - Kunst, die ein Markenprodukt darstellt
- „*first virtual art world black market goods*“



Quelle: MetaBirkins

USE CASE: NIKE GEGEN STOCKX

- StockX bietet NFTs zu auf der Plattform angebotenen Waren an, hier Nike Jordan 1.
- Nike wirft vor:
 - *Markenverletzung*
 - *Rufausbeutung*
 - *Vermeidbare Herkunftstäuschung*
 - *Irreführende Werbung*
 - *Produktfälschung*
- StockX antwortet:
 - *Beschreibende Nutzung*



Quelle: <https://stockx.com/de-de/chunky-dunky-vault-nft>



3.

Was sagen denn die
Markenämter dazu?

EUIPO: BISHERIGE ERKENNTNISSE


Asset Publisher

◀

Virtual goods, non-fungible tokens and the metaverse

June 23, 2022 - [practice_tips](#)

Virtual goods, non-fungible tokens and the metaverse

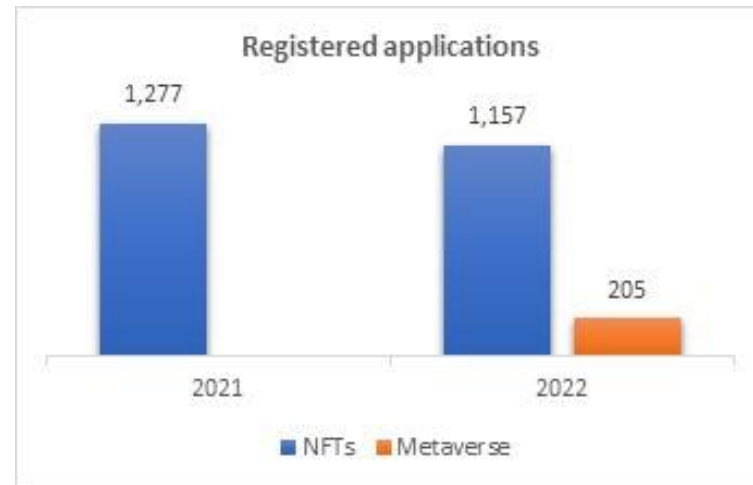


The Office is increasingly receiving applications containing terms relating to **virtual goods** and **non-fungible tokens** (NFTs). This is the approach that the Office is taking for classification purposes.

- Virtual goods are proper to Class 9 because they are treated as digital content or images. However, the term *virtual goods* on its own lacks clarity and precision so must be further specified by stating the content to which the virtual goods relate (e.g. *downloadable virtual goods, namely, virtual clothing*).
- The 12th Edition of the Nice Classification will incorporate the term *downloadable digital files authenticated by non-fungible tokens* in Class 9. NFTs are treated as unique digital certificates registered in a blockchain, which **authenticate** digital items but are distinct from those digital items. For the Office, the term *non fungible tokens* on its own is not acceptable. The type of digital item authenticated by the NFT must be specified.

Services relating to virtual goods and NFTs will be classified in line with the established principles of classification for services.

The Office's approach is set out in the 2023 draft Guidelines on which a range of stakeholders have until 3 October this year to comment.



Quelle: EUIPO

EUIPO: OFFENE FRAGEN

- Ist die Verkehrsanschauung im Metaverse die gleiche?
- Inwiefern sind die Grundsätze zur Unterscheidungskraft und zum beschreibenden Gehalt auf virtuelle Waren übertragbar?
- Wie erbringt man den Benutzungsnachweis?
- Wie vergleicht man virtuelle und physische Waren?

USPTO: WAS SCHON BEANTWORTET WIRD

- Cybersquatter-Anmeldungen zurückgewiesen (Gucci, Prada)
- Einzelhandelsdienstleistungen umfassen virtuelle Produkte (je nach Wording)
- Virtuelle und physische Produkte sind verwechselbar

PRADA

Word Mark	PRADA
Goods and Services	IC 009. US 021 023 026 036 038. G & S: Downloadable virtual goods, namely, computer programs featuring footwear, clothing, headwear, eyewear, handbags, laptop bags, backpacks, luggage, briefcases, art, toys, jewelry, watches, hair accessories, pet collars, accessories and charms for use in online virtual worlds IC 035. US 100 101 102. G & S: Retail store services featuring virtual goods, namely, footwear, clothing, headwear, eyewear, handbags, laptop bags, backpacks, luggage, briefcases, art, toys, jewelry, watches, hair accessories, pet collars, accessories and charms for use in online virtual worlds IC 041. US 100 101 107. G & S: Entertainment services, namely, providing on-line, non-downloadable virtual footwear, clothing, headwear, eyewear, handbags, laptop bags, backpacks, luggage, briefcases, art, toys, jewelry, watches, hair accessories, pet collars, accessories and charms for use in virtual environments created for entertainment purposes
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	97112054
Filing Date	November 6, 2021
Current Basis	1B
Original Filing Basis	1B
Owner	(APPLICANT) MOHAMMED, REATH INDIVIDUAL UNITED STATES 7536 BULLER ROAD PATTISON TEXAS 77423

Quelle: USPTO

USPTO: WAS NOCH PROBLEMATISCH IST



Quelle: The Fashion Law



4.

Fazit

TAKEAWAY

- Markenreview sehr empfehlenswert -> reicht bisheriges Wording aus?
- Im Zweifel: Nachanmelden (+ Kollisionsrecherchen)
- Gedanken über Benutzungsnachweise machen, auch für die USA



Fabian Reinholz

Partner | Fachanwalt für Gewerblichen Rechts-
schutz

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