

"BLACK FRIDAY" - Now Freely Usable for Promotions in Austria

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Black Friday is unquestionable one of the most profitable and busiest days of the year for the retail industry, particularly online. Worldwide almost all online stores offer sales or other promotions on Black Friday or Cyber Monday. However, after this practice has been established online, a trademark for "*BLACK FRIDAY*" was registered in Germany back in 2013. In 2016, a Chinese company acquired the trademark and then filed for its extension to Austria in 2017. Based on the registered trademark, it granted exclusive rights to an Austrian company, which licensed usage rights to various partner stores against remuneration. Further, an exclusive "*Black Friday-Cooperation Program*" was established. Non-partners who used the event name or trademark were prosecuted and requested to either pay a license fee or refrain from running Black Friday promotions. Some followed the request and entered into license agreements. Eventually some, however, did challenge the validity of the trademark. Austrian courts now held that the trademark "**BLACK FRIDAY**" is not protected in Austria:

The court held that the word "**BLACK FRIDAY**" cannot be monopolised in Austria, since it **lacks distinctiveness**. The term is mere generic. Therefore, the international registration for Austria has been refused. The decision is final and enforceable. **Thus, anyone may use the popular advertising term "BLACK FRIDAY" in Austria for free without the need of entering into license agreements and to pay remuneration.** If a company entered into a license agreement in the past, one may possibly challenge the payment obligation thereunder. However, the decision covers only the word trademark, not any word-figurative trademarks. Further, no one is entitled to make the impression to be member of the *Black Friday-Cooperation Program* without having entered into a respective agreement. Thus, any promotion using the term Black Friday should be checked to comply with the outlined framework.

The decision is also limited to Austria. In other jurisdictions, the trademark might still be enforceable, although also challenged. In Germany, for example, the basis mark is challenged in court proceedings, which are now pending before the Federal Patent Court as court of appeal. Thus, one has to be cautious with typical cross border marketing campaigns, so as to not to infringe (still) valid registrations in other jurisdictions.

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