

marks - there exists a crossover of protection under the trade mark rules, §15 MarkenG, §37 HGB and §12 BGB.⁷¹

b) Names that may conflict with a Community design

Protection of names under §12 BGB covers any signs that may identify a person or entity as their name, therefore not only words (as under protection of trade names), but also figurative elements, such as emblems, seals or logos.⁷²

B. The notion of a Community Design

The design is a legal instrument for the protection of creations that form external shapes of products or their parts,⁷³ and result from the features of a product and/or its ornamentation, as long as they are new and have individual character.⁷⁴ It protects the visual appearance, which includes two-dimensional representations, such as get-up and typefaces. This protection is of an abstract character, not confined to a defined range of products.⁷⁵

The substantive requirements of novelty⁷⁶ and individual character⁷⁷ of a design have an essential bearing on the validity of the Community design as the existence of prior rights may lead to the destruction of the design's novelty or individual character and as a result – form a ground for declaration for its invalidity under Art. 25(1)(b) CDR.

Novelty under Art. 5 CDR is judged against an identical design that has been made available⁷⁸ prior to an unregistered Community design, or – in case of the

71 This multiple protection is accepted in §2 MarkenG. The relationship between the various provisions is examined more closely in Chapter III C. 2-5.

72 BGH GRUR 1993, 151, 153 - *Universitätsement*.

73 Casado Cerviño and Wahl in: Charles Gielen and Verena von Bomhard (eds.), *Concise European Trade Mark and Design Law* [2011] Wolters Kluwer, 360 (hereinafter: Gielen/ von Bomhard).

74 Art. 3 and Art. 4 CDR.

75 Charles-Henry Massa and Alain Strowel, *Community Design: Cinderella Revamped*, [2003] E.I.P.R. 68, 72.

76 Art. 5 CDR.

77 Art. 6 CDR.

78 The concept of making available referred to in Art. 5 and Art. 6 of CDR is clarified in Art. 7 CDR and is limited to events that could have reasonably become known to the specialized business circles in the Community. The discussion of this concept goes beyond the scope of this thesis. For more detailed analysis see: *Green Lane Products Limited v PMS International*

registered Community design – prior to the filing of the application for its registration or its claimed priority. Immaterial differences⁷⁹ between the Community design and the novelty-destroying design should be disregarded, while the assessment is made from an objective perspective, which, unlike copyright, excludes protection for designs that were independently created.⁸⁰

The design's individual character, similarly as novelty, is assessed against a single piece of prior art.⁸¹ However, the requirement it involves is on the one hand less stringent, on the other - more difficult to prove: if the Community design does not produce on the informed user a different overall impression than the prior design, it is lacking individual character and hence is eligible for invalidation under Art. 25(1)(b) CDR. The impression both designs make is judged from the perspective of an informed user, who is defined as a notional user of the designs at issue, who is “particularly observant and has some awareness of the state of the prior art, that is the previous designs relating to the product in question”.⁸²

The Community design system includes registered⁸³ and unregistered⁸⁴ Community designs. The unregistered Community design is granted protection upon the making available⁸⁵ and the registered Community design - upon registration in OHIM which however does not include a substantive examination, in particular of novelty and individual character.⁸⁶

Group [2008] EWCA Civ 358 and comments of Johanna Brückner-Hofmann in: Hatrwig, *Designschutz in Europa* [2009] Vol.3 Carl Heymanns Verlag 234, 251.

79 Such as difference in hue, but not in colour, according to Musker in: Gielen/ von Bomhard, *supra* note 73, 367.

80 Musker in: Gielen/ von Bomhard, *supra* note 73, 367.

81 *Id.* 368.

82 GC Case T-9/07 - *Grupo Promer Mon Graphic SA v OHIM*, 2010 ECR II-00981, para. 62. This decision was appealed to the CJEU and the judgment of the GC was confirmed by the Court in CJEU Case C-281/10P – *PepsiCo, Inc. v Grupo Promer Mon Graphic SA*, O.J. (C 362) 9, available at: http://curia.europa.eu/jcms/jcms/_6/, under the case number.

83 Art. 1(2)(b) CDR, Art. 35 et seq. CDR.

84 Art. 1(2)(a) CDR, Art. 11 CDR.

85 The making available is understood as a Community disclosure, Art. 11, Art. 110a CDR. For a detailed analysis see: Victor Sáez, *The Unregistered Community Design* [2002] E.I.P.R. 585, 588.

86 Art. 45, Art. 47 CDR, Casado Cerviño and Wahl in: Gielen/ von Bomhard, *supra* note 73, 361.

C. *The area of conflict between distinctive signs and the Community design*

Community designs protect the appearance of a product and cover i.a. three-dimensional objects, packaging, patterns, logos and typefaces. As has been shown above - all those objects of a design may be protected as distinctive signs. Since the existence and possible conflict with a prior sign are not part of the considerations made upon grant of protection for a Community design, the eligibility for such protection is in fact judged in invalidation proceedings instigated only by the interested market participants.⁸⁷

The conflict with a prior distinctive sign may lead to the invalidation of a Community design either on the basis of Art. 25(1)(b) CDR – when it can be shown that the sign forms part of the prior art and the Community design is either identical (in the case of asserted lack of novelty) or, though not being identical, does not produce a different overall impression on the informed user. The third ground for invalidation relevant for holders of distinctive signs is Art. 25(1)(e) i.e. situation where the owner of a prior right is able to show that the Community design in fact infringes his prior right, whereas this infringement claim may be based on any, Community or national, legal ground as long as it confers on the owner of the sign a right to prohibit the use of his sign.

If a design is not novel it will also not possess individual character.⁸⁸ However, even if the design is novel and possesses individual character, it might nevertheless infringe a prior distinctive sign (especially in cases where there is no likelihood of confusion between the signs but there exists a likelihood of association or where the prior sign has a reputation). As will be shown in the subsequent chapters, the ground for invalidation of a Community design on the basis of its conflict with a prior distinctive sign, grants its owner a broad selection of weapons against the design.

87 Anyone – in case of Art. 25(1)(b) CDR or the holder of a prior sign in case of Art. 25(1)(e) CDR, as prescribed in Art. 25(3) CDR.

88 Musker in: Gielen/ von Bomhard, *supra* note 73, 367.