

III. Art. 25 (1)(e) CDR as ground for invalidation of a Community design

A Community design will be declared invalid under Art. 25(1)(e) CDR if an earlier distinctive sign is used in this design and the Community law or the law of the Member States governing that sign confers on the rightholder of the sign the right to prohibit such use.

The analysis will therefore encompass the following considerations:

- whether the distinctive sign was used in the Community design (*infra* under A.);
- whether the distinctive sign is protected under the Community law or national law of a Member State (*supra* Chapter II.);
- whether the distinctive sign is prior to the Community design (*infra* under B.);
- whether the owner of the distinctive sign has the right to prohibit its use (*infra* under C.);
- whether there are any limitations to the protection of the distinctive sign (*infra* under D.).⁸⁹

A. Use of a distinctive sign in a subsequent design

As the OHIM Invalidity Division stated with regard to trade marks, “registered Community design is deemed to use a sign which is identical or similar to the sign of the earlier trade mark, where the following two conditions are met: (1) The registered Community design contains a feature which is perceived as a sign. (2) That sign is identical or similar to the sign of the trade mark. A feature of a registered Community design cannot be perceived as a sign where that sign is devoid of distinctive character”.⁹⁰ Hence, the starting point of the analysis is the existence of a feature in the design which has a distinctive character. If that requirement is fulfilled the second step is to establish whether this feature of the design is similar or identical to the sign that is seeking protection. Other ele-

89 Oliver Ruhl, *Gemeinschaftsgeschmacksmuster. Kommentar* [2007] Carl Heymanns Verlag 465 – 468 (hereinafter: Ruhl 2007).

90 ICD 000007030 - *AM Denmark A/S v Kuan-Di Huang*, OHIM Inv. Div. Sept. 17, 2010, available at: <http://oami.europa.eu/ows/rw/pages/RCD/caseLaw/decisionsOffice/invalidity.en.do> under the ICD number, para. 22.

ments of the design which do not form part of the allegedly used sign should be disregarded.⁹¹

The use of a sign in a subsequent Community design does not require an exact and detailed reproduction of that sign.⁹² Judging similarity or identity involves a comparison between the feature of the design and the sign as protected, i.e. in case of registered trade marks, the comparison must be between the design at issue and the mark as registered, not as used.⁹³ To assess whether a sign is used, Hager proposes a determination whether the feature corresponding to the sign “is swallowed up in the overall appearance to such an extent that it is only interpreted as part of the product like any other element or design feature”.⁹⁴ If so – then the design at issue will not use any feature that might conflict with a distinctive sign.

B. Prior distinctive sign and a subsequent design

The decision on whether the design is junior in relation to the distinctive sign boils down to comparing the date of begin of the Community design and the date of the commencement of the prohibiting effect of the distinctive sign.

Whether the distinctive sign has existed and provided its owner with the right to prohibit an unauthorised use of that sign prior to the design at question will be judged, in case of the registered rights, by the date of the publication of registration or application for registration⁹⁵ or, in the case of rights that do not require registration - under national laws regulating the protection of the respective distinctive sign.⁹⁶

The existence of a Community design begins in the case of the registered Community design on date of filing of the application for registration with the OHIM, a central industrial property office of a Member State or with the Bene-

91 Unlike assessment of novelty under Art. 5 CDR and of individual character under Art. 6 CDR where the design as a whole is compared with the prior sign.

92 Neville Cordell and Tim Austen, *European GC highlights conflict between trade marks and designs* [2010] 5 JIPLP 622, 623, *Community Design invalidity Manual*, *supra* note 15, C.7.2.

93 GC Case T-148/08 - *Beifang Group Co. Ltd. v OHIM*, 2010 ECR II-01681, para. 114; Hager, *supra* note 24, 413.

94 Hager, *supra* note 24, 411.

95 Art. 9(3) CTMR, §14(1) MarkenG.

96 §14(1) MarkenG for unregistered trade marks and company symbols; acquiring of competitive individuality – under unfair competition protection, Ohly in: Piper/Ohly/Sosnitzka, *supra* note 54, §4 No.9, para. 9/25; with the begin of the use or acquiring distinctiveness as name – under §12 BGB, Hildebrandt *supra* note 15, 449; with registration – under §29 HGB.