

3. Scope of protection of company symbols and work titles

The scope of protection of company symbols and work titles under §15 MarkenG, resembles closely that of trade mark. Although §15 MarkenG does not include double identity, the protection against confusion as to source (§15(2) MarkenG) and protection of indicia with reputation (§15(3) MarkenG) cover most cases of infringement.²⁵¹ These provisions are regarded as *lex specialis* towards §12 BGB and therefore this general clause cannot be a ground for protection for a distinctive sign whenever there are grounds for the owner to rely on §15 MarkenG.²⁵² On the other hand, HGB provisions can be relied on additionally.²⁵³

Company symbols and work titles are protected against confusion. However, instead of comparison of goods or services for which the sign is used, under protection of company symbols it is rather the comparison of the scope of activities of the owner of the sign seeking protection and the design proprietor. Whereas the complete identity of those fields is not required, it is sufficient that both fields show some crossovers.²⁵⁴ The interdependent factors that need to be taken into account, include an assessment of identity or similarity of the signs, the level of distinctiveness of the prior sign and the fields of activity in which both signs are used.²⁵⁵ Therefore in this case the comparison seems more straightforward than under trade mark law – regardless of goods or services for which the symbol and the design are used, it is the field of activity of their owners that needs to be taken into account and hence, unlike trade mark law, the corresponding factual situations are being compared. Of course, when establishing the field of activities, it is necessary to take into account the goods offered or the services rendered by both entities, however these will not be the only circumstances under assessment.

MarkenG in §15(3) provides for protection of company symbols and work titles with reputation. It corresponds to the provision of §14(2) No 3 MarkenG,²⁵⁶ and so it has been submitted in the literature that due to the fact that company symbols usually constitute also the company's trade mark or are at least signs eligible for trade mark protection, the applicability of §15(3) MarkenG should correspond closely to that of §14(2) No 3 MarkenG. In addition, because of the broad understanding of the concept of confusion under §15(2) MarkenG, the

251 Lükken in: Stöckel/ Lükken, *supra* note 53, 255.

252 BGH GRUR 1998, 696, 697 - *Rolex-Uhr mit Diamanten*.

253 Ingerl/Rohnke, *supra* note 24, §15 para. 27, Nach §15 para. 164.

254 Lükken in: Stöckel/ Lükken, *supra* note 53, 255.

255 Hacker, *supra* note 19, 296, citing decisions of the BGH.

256 Implementing Art. 5(2) TMD.

practical importance of protection of company symbols with reputation is relatively low.²⁵⁷ For this reason for a detailed analysis of the scope of protection it is referred to the analysis regarding protection of marks with reputation in Chapter III C. 1. f.

4. Scope of protection of trade names (Firma)

The protection under §37 HGB requires that the Firma is used as a trade name and without the authorisation of the proprietor, §37(2) HGB requires further that the applicant's rights are infringed by that use. This general clause is sufficiently broad to cover double identity, likelihood of confusion and protection of trade names with reputation.²⁵⁸

Use as trade name has been defined as “any action that has a direct relation to the operation of one's business and can be understood as an expression of the user's intention to use the sign as his own trade name”.²⁵⁹ Whether this is the case is judged from the point of view of the commercial circles that encounter the sign. It has been recognised that use as a trade name is given in situations in which a trade name is usually utilised and therefore the public expects that such a name will be used.²⁶⁰ Accordingly it seems that in an application for invalidation of a Community design the evidence must be produced that the use of the accused design infringes the rights to a trade name. The registration of a design as such does not lead to use as a trade name, the context of use and possible impression among the public need to be shown.

With respect to an infringement of rights to a trade name by a design, a recent decision of the Higher Court in Cologne²⁶¹ provides for a relevant guidance. According to this decision, since under §18 HGB the trade name must be able to characterise its owner and possess a distinguishing character, it must not include any figurative elements and like other names can be composed only of words. Therefore the use of the trade name with additional elements, for example as part of a logo, might lead to lack of use as a trade name and consequently – not be infringing under §37 HGB.

The protection of a trade name under §37(2) HGB requires further that the rights of the applicant for the invalidation of a Community design are infringed.

257 Ingerl/Rohnke, *supra* note 24, §15 para. 79-80.

258 Lüken in: Stöckel/ Lüken, *supra* note 53, 255.

259 BGH NJW 1991, 2023, 2024 - Case II ZR 259/90.

260 Ingerl/Rohnke, *supra* note 24, Nach §15 para. 166.

261 6 U 67/10 [2010] OLG Köln, Nov. 5, 2010 with comments by Fabian Zigenaus, GRUR-Prax 2011, 10.