

4. Firma (trade name), §17 HGB

a) General remarks

Trade name is a registered name of a merchant which he uses in his commercial activities.⁶⁶ It identifies the trader (a natural or legal person) in his activities on the market, thereby allowing for the recognition of the market participants and their activities. Trade name differs from commercial symbols in that it points to a person or entity rather than to a commercial activity, therefore a trader can have only one trade name, while at the same time owning different commercial symbols, identifying different activities that he exercises.⁶⁷

b) Trade names that may conflict with a Community design

Trade names must be distinctive and capable of identifying their owner and may not include information that might be misleading for the market participants.⁶⁸ Therefore they can consist only of words and symbols possessing a recognised meaning that can be pronounced (e.g. &).⁶⁹ As such – they might be used in a Community design, especially of a pattern or logo.

5. Names §12 BGB

a) General remarks

§12 BGB regulates the protection of names, i.e. designations which allow for an individualization of natural or legal persons and other entities,⁷⁰ allowing them to act against unauthorised uses of those names by others, potentially also use in a Community design. Since trade names are seen as names, and names – may be seen as company symbols, while at the same time they all may constitute trade

⁶⁶ §17, §29 HGB.

⁶⁷ Heidinger in: *Münchener Kommentar zum HGB* [2010] C.H. Beck §17 para. 35.

⁶⁸ §18 HGB.

⁶⁹ Heidinger in: *Münchener Kommentar zum HGB* [2010] C.H. Beck §17 para. 12.

⁷⁰ Thomas Nägele *Das Verhältnis des Schutzes geschäftlicher Bezeichnungen nach §15 MarkenG zum Namensschutz nach §12 BGB* [2007] GRUR 2007, 1007, 1008 (hereinafter: Nägele).

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 - *Universitätsementel*.

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*