

The trade marks which are most likely to be conflicting with a design are the three-dimensional signs, in particular product shapes,⁴² product surfaces or trade dress. A further example are two dimensional signs, which will be in conflict upon the use in a two dimensional design, e.g. a pattern,⁴³ but also upon a reproduction of such mark in a three-dimensional design of a product.⁴⁴ The case law provides also examples of invalidation based on a prior word mark⁴⁵ and a figurative mark.⁴⁶ Due to the characteristics of a position mark,⁴⁷ which determines a specific use of a sign, it is also likely to be successfully used as ground for invalidation.

2. Signs protected under unfair competition law

a) General remarks

In some countries (e.g. France and Belgium) the distinctive signs are required to be registered if they are to be granted protection and no additional safeguard is available to protect a trader's reputation. Other regimes, e.g. British and Ger-

- 42 ICD 000007030 - *AM Denmark A/S v Kuan-Di Huang*, OHIM Invalidity Division Sept. 17, 2010, available at: <http://oami.europa.eu/ows/rw/pages/RCD/caseLaw/decisionsOffice/invalidity.en.do> under the ICD number; Case R 1310/2005-3 - *Galletas United Biscuits S.A. v Arluy S.L.*, OHIM Third Board of Appeal Nov. 28, 2006, available at: http://oami.europa.eu/search/legaldocs/la/EN_boa_index.cfm under the case number.
- 43 Case R 211/2007-3 - *Burberry Ltd. v Jimmy Meykranz*, OHIM Third Board of Appeal March 3, 2008, available at: http://oami.europa.eu/search/legaldocs/la/EN_boa_index.cfm under the case number.
- 44 e.g. GC Case T-148/08 - *Beifa Group Co. Ltd. v OHIM*, 2010 ECR II-01681.
- 45 Case R 137/2007-3 - *Zygmunt Piotrowski v Compagnie Gervais Danone*, OHIM Third Board of Appeal Sept. 18, 2007, available at: http://oami.europa.eu/search/legaldocs/la/EN_boa_index.cfm under the case number; ICD 000004133 - *Henkel KGaA v Jeas Polska Sp. z o. o.*, OHIM Invalidity Division Dec. 20, 2007, available at: <http://oami.europa.eu/ows/rw/pages/RCD/caseLaw/decisionsOffice/invalidity.en.do> under the ICD number; Case R 609/2006-3 - *Honeywell Analytics Ltd v Hee Jung Kim*, OHIM Board of Appeal May 3, 2007, available at: http://oami.europa.eu/search/legaldocs/la/EN_boa_index.cfm under the case number.
- 46 Case R 137/2007-3 - *Zygmunt Piotrowski v Compagnie Gervais Danone*, OHIM Third Board of Appeal Sept. 18, 2007, available at: http://oami.europa.eu/search/legaldocs/la/EN_boa_index.cfm under the case number; ICD 000003333 - *Calvin Klein Trademark Trust v Youssef el Jirari Ziani*, OHIM Invalidity Division Oct. 24, 2007, available at: <http://oami.europa.eu/ows/rw/pages/RCD/caseLaw/decisionsOffice/invalidity.en.do> under the ICD number.
- 47 Hager, *supra* note 24, 411.

man, allow for protection without registration, i.a. under unfair competition provisions.⁴⁸

This safeguard, unlike trade mark law, does not refer to any particular sign, but rather to the efforts of a market participant, his time and investment put into the creation of any subject-matter on the one hand and the behaviour of his competitor influencing that effort in an unfair way – on the other. The considerations here focus on the nature of the behaviour, the underlying achievement is protected only additionally⁴⁹ and due to the unfair competition rules having a character of general clauses, they are able to fill-in the gaps in protection provided for distinctive signs by IPRs.⁵⁰

Even though one of the basic rules governing exclusive rights prescribes the freedom of copying⁵¹ outside the limits of IP, the unfair competition law provides for its limitations.⁵² However such restriction, if applied too broadly, might limit the competition and as a result harm both the consumers and the market. Therefore the application of unfair competition provisions is limited to behaviours which are unfair. “Unfairness” of a behaviour is a term which each national legislation needs to define for itself. The harmonized notion of unfair competition codified in Art. 5 of Directive 2005/29/EC of the European Parliament and of the Council of 11 May 2005 concerning unfair business-to consumer commercial practices in the internal market, is a general clause, broad enough for national laws to incorporate their developed legal attitudes.

b) Signs protected under unfair competition that may conflict with a Community design

The object of protection under unfair competition provisions are i.a. products in which the customers are interested for their origin or reputation and able to rec-

48 William Cornish, David Llevelyn and Tanya Aplin, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* [2010] Sweet&Maxwell, 638-639 (hereinafter: Cornish/Llevelyn/Aplin).

49 Eckhart Gottschalk and Sylvia Gottschalk, *Das nicht eingetragene Gemeinschaftsgeschmacksmuster: eine Wunderwaffe des Designschutzes?* [2006] GRUR Int 461, 466 with further references (hereinafter: Gottschalk/Gottschalk).

50 Ansgar Ohly, *Designschutz im Spannungsfeld von Geschmacksmuster-, Kennzeichen- und Lauterkeitsrecht*, [2007] GRUR 2007, 731, 736 (hereinafter: Ohly 2007).

51 *Id.* 735.

52 Ansgar Ohly, *The Freedom of Imitation and its Limits – A European Perspective* [2010] IIC 505, 512.

ognize them due to their characteristics.⁵³ These have been defined in the case-law as products having a competitive individuality which as a whole or through their features are able to transfer to the consumers the message as to their origin or characteristics.⁵⁴ In the case of distinctive signs, most of them can be perceived either as a product or as its feature that possesses the competitive individuality.

The protection under unfair competition is in some respects broader than that under trade mark law.⁵⁵ Still, the underlying notion of both trade mark distinctiveness and competitive individuality is that the more uncommon the sign – the more likely it is to possess both distinctiveness and competitive individuality.⁵⁶

The existence of competitive individuality is a question of fact and is judged taking into account all the relevant circumstances, such as novelty, originality, recognisability among the relevant public, level of advertising or fame, and even costs and effort of promotion.⁵⁷ Therefore it can be inherent to a product due to its characteristics,⁵⁸ or it can be gained through time, similarly as secondary meaning in trade mark law.⁵⁹

3. Company symbols and work titles, §5 MarkenG

a) General remarks

Company symbols and work titles are protected under the German trade mark law.

According to §5(2) MarkenG company symbols are “signs used in the course of trade as names, trade names, or special designations of business establishment or enterprises. Business symbols and other signs intended to distinguish one

53 Dissmann in: Maximiliane Stöckel and Uwe Lügen, *Handbuch Marken- und Designrecht* [2006] Erich Schmidt Verlag 495 (hereinafter: Stöckel/ Lügen).

54 Ohly in: Henning Piper, Ansgar Ohly, Olaf Sosnitza, *Gesetz gegen den unlauteren Wettbewerb* [2010] C.H. Beck, §4 No.9, para. 9/32 (hereinafter: Piper/Ohly/Sosnitza); BGH GRUR 1997, 754, 756 - „grau/magenta”.

55 Ohly suggests that the unfair competition can protect the “small coins” of distinctive signs due to the lower requirement of competitive individuality, Ohly 2007, *supra* note 50, 738, though the taking unfair advantage of distinctiveness may be pursued only under trade mark law, BGH GRUR 2007, 795, 799 - *Handtaschen*.

56 Ansgar Ohly, *Die Europäisierung des Designrechts* [2004] ZEuP 296, 309 (hereinafter: Ohly 2004).

57 Ohly in: Piper/Ohly/Sosnitza *supra* note 54, §4 No.9 para. 9/44.

58 BGH GRUR 2008, 793, 796 - *Rillenkoffer*.

59 Dissmann in: Stöckel/ Lügen, *supra* note 53, 495.