



Overlap and Conflict Designs and Trade Marks

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Ministerialrat a.D., Vice-President of OHIM, 1994-2005



Overview

The issues

Examples

Conclusions

The issues

Subject-matter of protection (validity)

Scope of protection (infringement)

Enforcement

Subject-matter of protection

Trade marks

Distinctive signs: words, names, devices, colours, shapes, sounds, ...

Exclusions: non-distinctive signs; technical and aesthetic functionality

Issues: Does earlier patent or design (or copyright) preclude trade mark protection; “double protection”; unfair competition protection

Subject-matter of protection

German trade mark No. 1 - 1894

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Klasse 4.

Beleuchtungs-, Heizungs-, Koch- und Ventilations-
Apparate und Geräthe.

Nr. 1. Carl Holz,
Berlin, Oranienstr. 23a. An-
meldung vom 1. 10. 94. Ein-
tragung am 16. 10. 94.

Geschäftsbetrieb:
Lampenfabrication.

Warenverzeichnis: Lampen und Lampentheile.

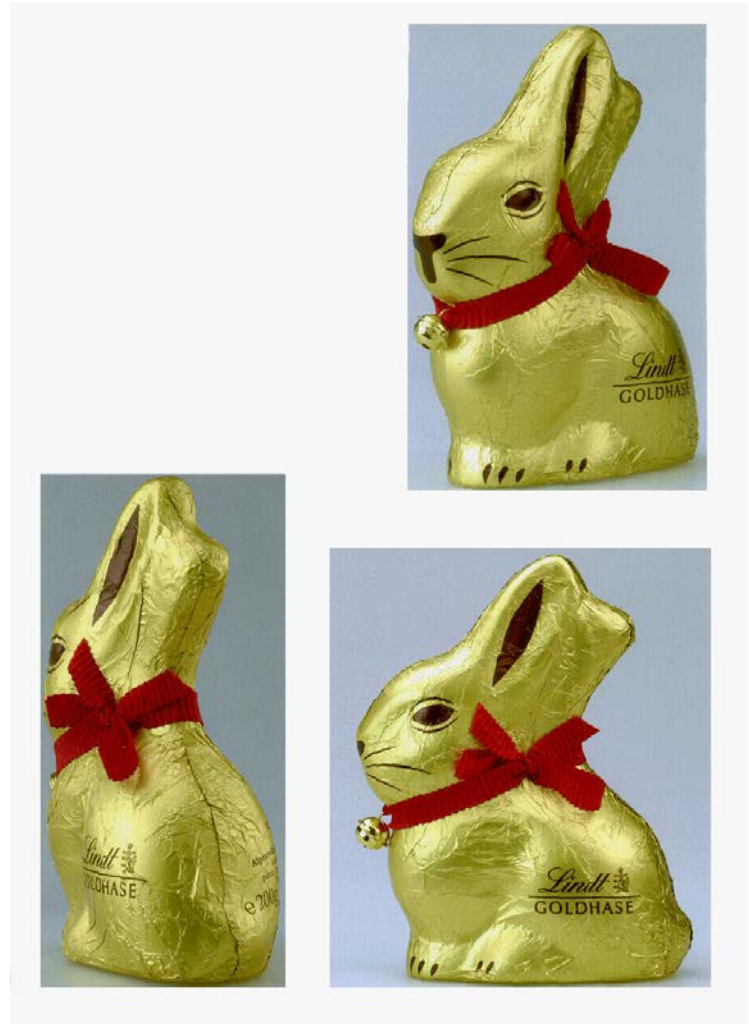
PERKÊO

Erstes, beim
Kaiserlichen Patentamt
angemeldetes Warenzeichen

Subject-matter of protection

CTM “Goldhase”, Chocoladefabriken Lindt & Sprüngli

b.



Subject-matter of protection

Trade marks: examples

b.

Quelle: IfM Institut für Markenwert



Subject-matter of protection

Trade marks: examples

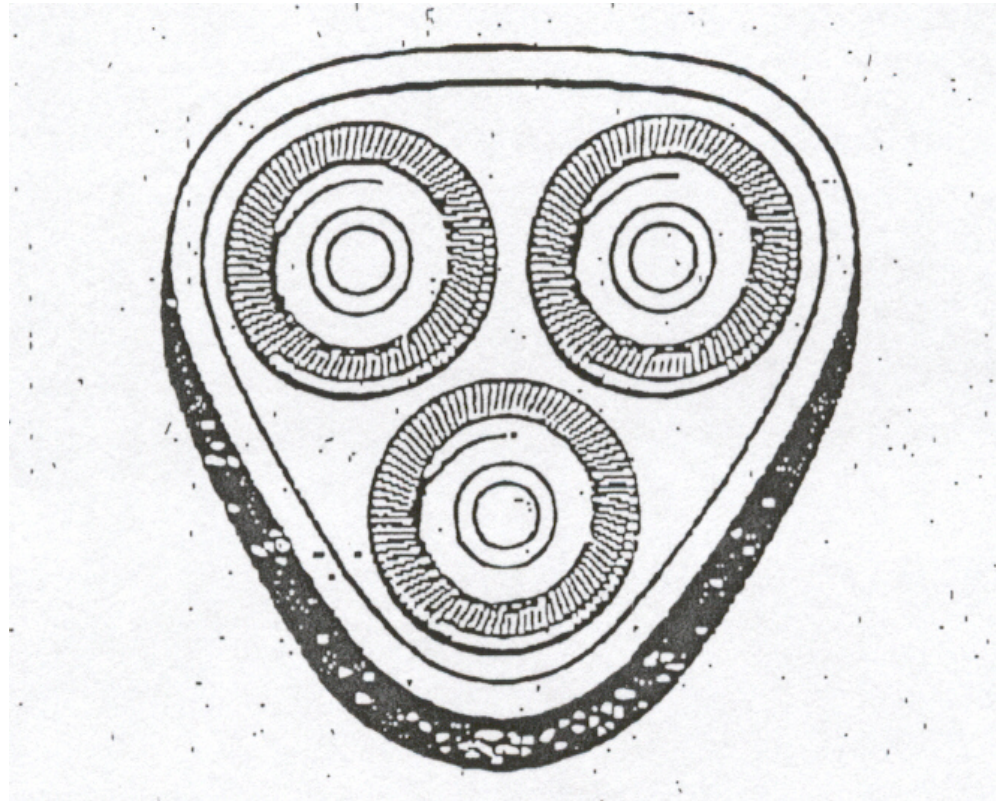
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Subject-matter of protection

Technical functionality, U.K. trade mark at issue in *Philips v. Remington*, C-299/99

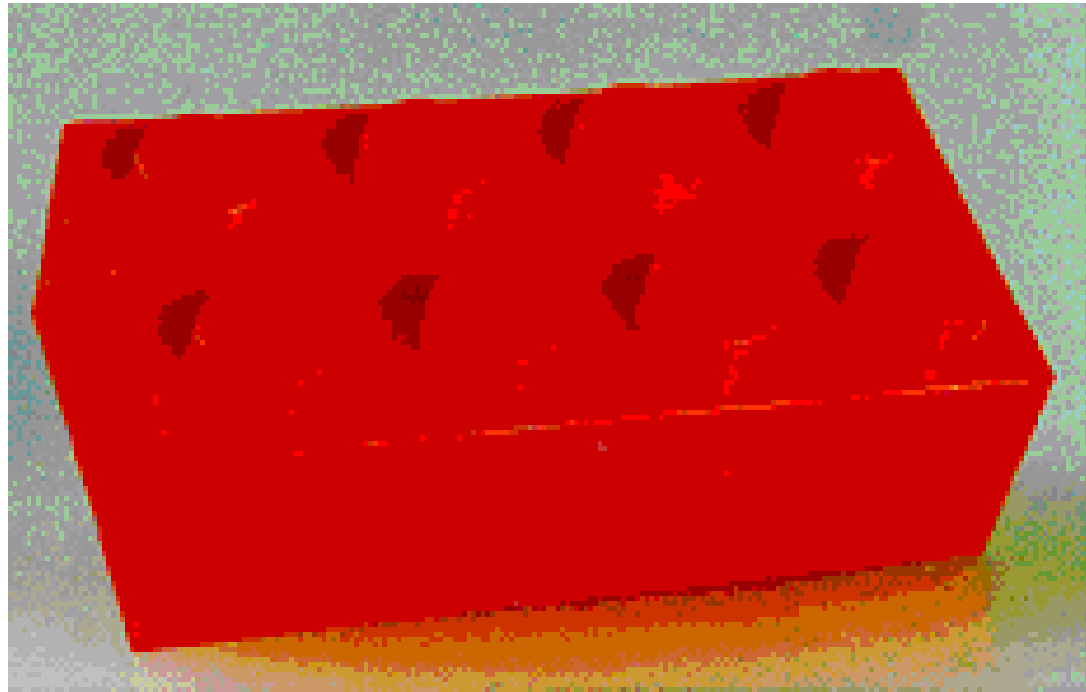
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Subject-matter of protection

CTM “Lego Brick”, at issue in Lego v. OHIM, C-48/09 P

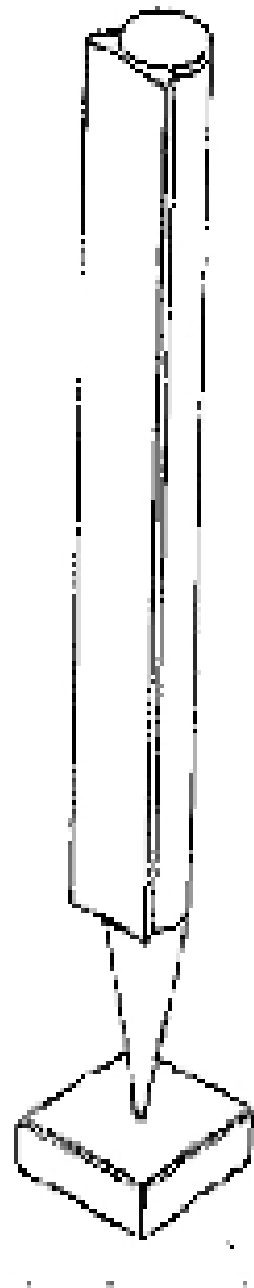
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Subject-matter of protection

CTM “Loudspeaker”, at issue in Bang & Olufsen v. OHIM,
T-508/08

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b.

Subject-matter of protection

Designs

Visually perceptible appearance of a product or part of a product

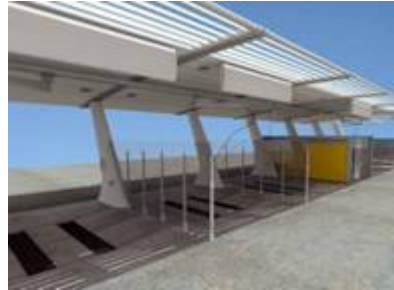
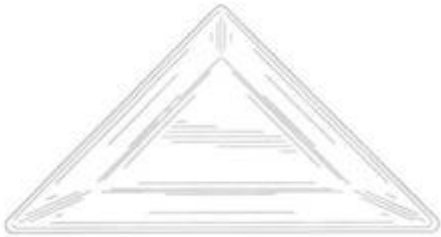
Novelty and individual character

Exclusions: technical necessity, must-fit (except “Lego” type products), parts of complex product not visible under normal use

Issues: Does earlier patent preclude design protection; “overlap” with copyright; parallel protection as trade mark; protection under unfair competition

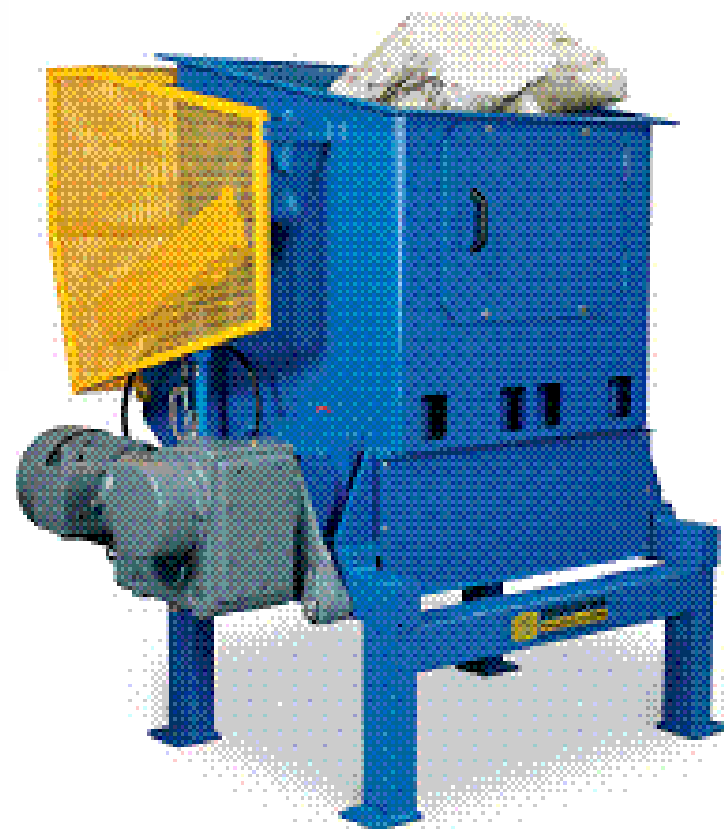


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Subject-matter of protection

RCD “Chaff Cutter”, at issue in Case R 690/2007-3, Lindner Recyclingtech GmbH



Scope of protection

Trade marks: identity of signs and goods/services

Likelihood of confusion

Reputation

Degree of distinctiveness

Proximity of signs and goods/services

Attention of the public

Scope of protection

When enforcing trade mark rights against design:
infringement of trade mark is required

Procedural setting:

Design invalidity

Trade mark infringement

Defense of non-use? Other attacks on mark?

Use as a mark

“règle de la spécialité”

Scope of protection

Designs:

No different overall impression on the informed user

Issues

“Degree of individuality”

Freedom of designer of allegedly infringed design

Weight to be given to features which are common

Weight to be given to features which are technical

Weight to be given to features which are also found in the design corpus

Scope of protection

When enforcing design rights against trade marks:
infringement of design is required

Procedural setting:

Trade mark invalidity

Design infringement

Use of the mark in the sense of “design use”

Relevance of product indication

Enforcement

Trade marks and designs

National trade marks and design

Community trade marks and designs

Territorial scope of protection

Relief (injunction, damages, destruction ...)

Applicable law

Examples

**Conflicts between “products” protected
by trade mark law, design law, or
copyright law**

TRIPP TRAPP Chair, protected by copyright and trade mark



TRIPP TRAPP®

STOKKE®

The Stokke high chair (“Tripp Trapp” Stuhl)



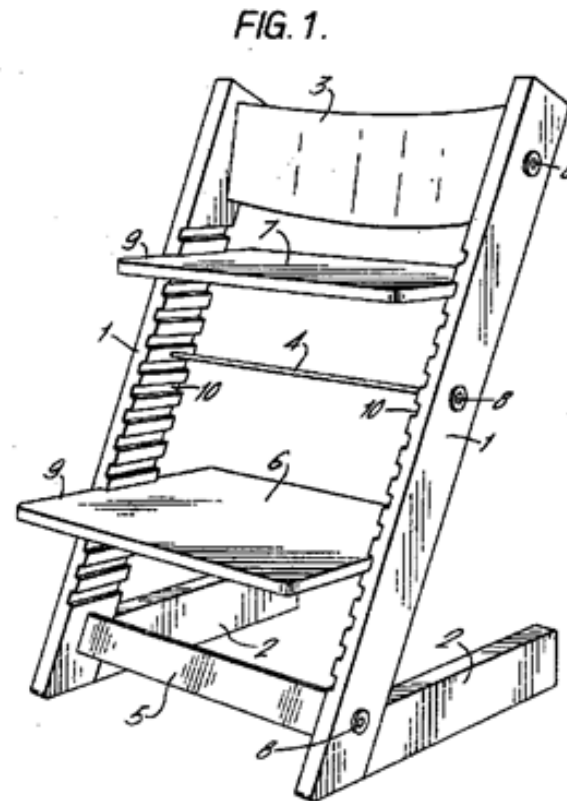
The original
Infringement under trade mark law
and copyright law



The Stokke high chair (“Tripp Trapp” Stuhl)



The patent



The Stokke high chair (“Tripp Trapp” Stuhl)

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The infringements



The Stokke high chair (“Tripp Trapp” Stuhl)

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The infringements
(copyright Norway)



The Stokke high chair (“Tripp Trapp” Stuhl)

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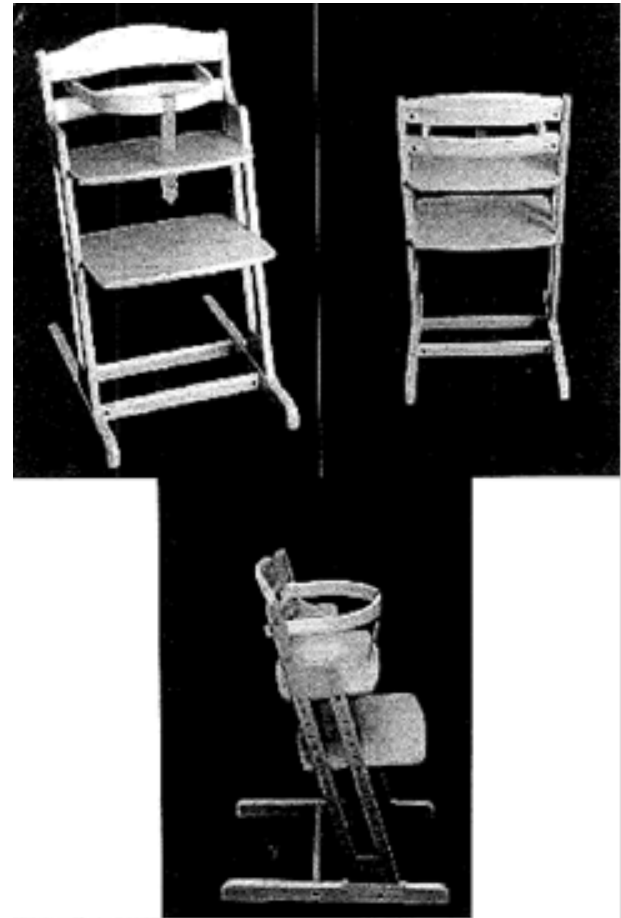
The infringements



The Stokke high chair (“Tripp Trapp” Stuhl)

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The infringements (Germany, copyright)



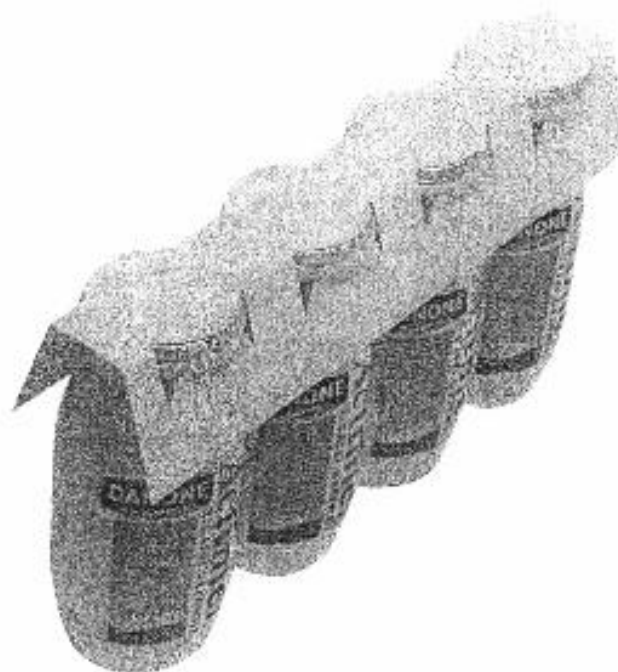
Example: “Danone Actimel”

OHIM Board, 18.9.2007, R 267/2007-3

Earlier mark



Later design



Example: “Nike”

OHIM Board, 18.1.2012, R 1341/2010-3, design
invalid on absence of individual character

Earlier Spanish mark (of a third party)



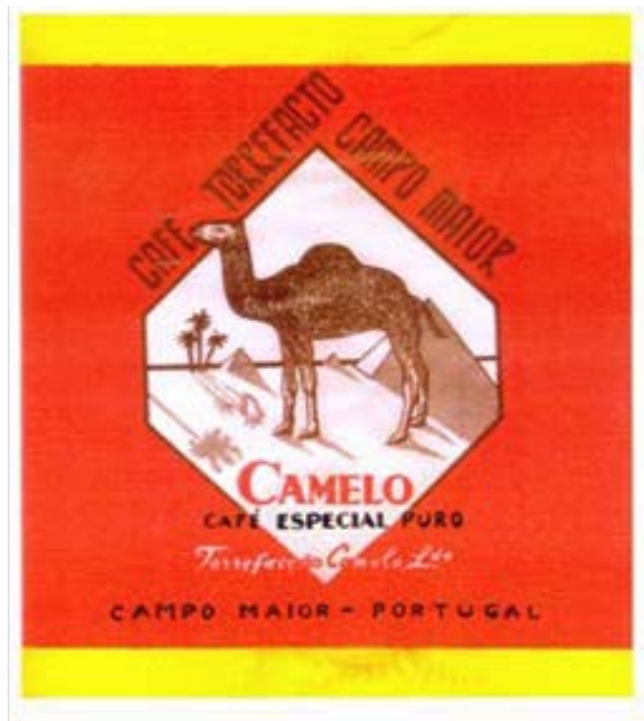
Later design



Example: “Camelo”

OHIM Board, 17.4.2012, R 2378/2013-3,
design valid

Earlier mark



Later design



Example: “Diesel”

OHIM Board, 26.9.2012, R 849/2011-3,
design invalid

Earlier mark

DIESEL



Later design

Example: the “sitting figure”

ECJ 18.10.2012, C-101 & 102/11 P, Neuman & Baena, design
not invalid – different overall impression

The earlier mark



The later design



Conclusions



Filing strategy

Access to protection, trade mark or design

Price

“Speed”

Enforcement strategy

Legal basis

Forum

Applicable law

Customs enforcement



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