

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 Lüken, *Handbuch Marken- und Designrecht* [2006] Erich Schmidt Verlag 495 (hereinafter: Stöckel/ Lüken).

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/ Lüken, *supra* note 53, 495.

business from another which are regarded within the affected circles as the distinctive signs of a business establishment, shall be equivalent to the special designation of a business establishment".⁶⁰ The difference between those signs and trade marks is that while marks refer to goods or services and only indirectly to their source, the company symbols convey a direct information on the origin.⁶¹

The company symbols come into existence with the begin of their use, regardless of registration, if they are inherently distinctive, or if that is not the case - when they acquire secondary meaning.⁶² Nevertheless the notion of company symbols includes trade names which require registration,⁶³ and which are protected as company symbols additionally to the protection provided for them by the HGB.

Under §5(3) MarkenG, work titles cover designations of printed publications and cinematographic, musical, dramatic or other works. Since they refer to the work itself, they may confer an information about origin only indirectly.

b) Company symbols that may conflict with a Community design

Company symbols include names, i.e. words which identify a person (natural or legal) or an object and can only be represented with words. Any other sign, including symbols,⁶⁴ logos, colours, or even slogans can be protected under §5(2) MarkenG, once they acquire a distinctive character among the relevant consumers as indicating the company.⁶⁵ Taking into consideration their characteristics, and the characteristics of work titles (§5(3) MarkenG) any of those symbols could potentially be used in a design.

60 §5(2) MarkenG, English translation taken from http://www.ip-firm.de/markeng_e.pdf (last visited June 5, 2012).

61 Lüken in: Stöckel/ Lüken, *supra* note 53, 251.

62 *Id.* 254.

63 §29 HGB.

64 BGH GRUR 2005, 419, 422 - *Räucherkatze*.

65 Lüken in: Stöckel/ Lüken, *supra* note 53, 254.

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).