

ments of the design which do not form part of the allegedly used sign should be disregarded.<sup>91</sup>

The use of a sign in a subsequent Community design does not require an exact and detailed reproduction of that sign.<sup>92</sup> Judging similarity or identity involves a comparison between the feature of the design and the sign as protected, i.e. in case of registered trade marks, the comparison must be between the design at issue and the mark as registered, not as used.<sup>93</sup> To assess whether a sign is used, Hager proposes a determination whether the feature corresponding to the sign “is swallowed up in the overall appearance to such an extent that it is only interpreted as part of the product like any other element or design feature”.<sup>94</sup> If so – then the design at issue will not use any feature that might conflict with a distinctive sign.

### B. *Prior distinctive sign and a subsequent design*

The decision on whether the design is junior in relation to the distinctive sign boils down to comparing the date of begin of the Community design and the date of the commencement of the prohibiting effect of the distinctive sign.

Whether the distinctive sign has existed and provided its owner with the right to prohibit an unauthorised use of that sign prior to the design at question will be judged, in case of the registered rights, by the date of the publication of registration or application for registration<sup>95</sup> or, in the case of rights that do not require registration - under national laws regulating the protection of the respective distinctive sign.<sup>96</sup>

The existence of a Community design begins in the case of the registered Community design on date of filing of the application for registration with the OHIM, a central industrial property office of a Member State or with the Bene-

91 Unlike assessment of novelty under Art. 5 CDR and of individual character under Art. 6 CDR where the design as a whole is compared with the prior sign.

92 Neville Cordell and Tim Austen, *European GC highlights conflict between trade marks and designs* [2010] 5 JIPLP 622, 623, *Community Design invalidity Manual*, *supra* note 15, C.7.2.

93 GC Case T-148/08 - *Beifa Group Co. Ltd. v OHIM*, 2010 ECR II-01681, para. 114; Hager, *supra* note 24, 413.

94 Hager, *supra* note 24, 411.

95 Art. 9(3) CTMR, §14(1) MarkenG.

96 §14(1) MarkenG for unregistered trade marks and company symbols; acquiring of competitive individuality – under unfair competition protection, Ohly in: Piper/Ohly/Sosnitza, *supra* note 54, §4 No.9, para. 9/25; with the begin of the use or acquiring distinctiveness as name – under §12 BGB, Hildebrandt *supra* note 15, 449; with registration – under §29 HGB.

lux Design Office,<sup>97</sup> and of the unregistered Community design – on the date on which the design was first made available to the public in the Community.<sup>98</sup> Hence those respective dates will be taken into account when judging whether the design is “subsequent” within the meaning of Art. 25 (1)(e) CDR. In the context of Art. 8(4) CTMR the General Court has expressed the view that the existence or protection of a prior sign invoked under the provisions of the UK law of passing off must be established at the time of the filing of the contested trade mark rather than on the date when the goods or services bearing the contested mark were offered on the market.<sup>99</sup> It is submitted that these considerations are adequate also in the Community design context.

### C. *Right to prohibit the use of a prior distinctive sign*

Not every use of a prior distinctive sign in a Community design will lead to its invalidity. It is necessary that the owner of the prior sign has the right to prohibit the use, i.e. that the design falls into the scope of protection of the sign and infringes the owner’s rights.

The scope of protection of trade marks, company symbols and work titles, trade names, names and unfair competition provisions, with the view on the potential conflict with a design right are described below.

#### 1. The scope of protection of trade marks

The provisions on scope of protection of the CTMR mirror those of the TMD, and hence should be interpreted in the same way.<sup>100</sup> Therefore the protection for trade marks based on the CTMR and harmonized national laws will be described simultaneously, with a reference to the relevant provisions of both texts. Additionally, Art. 8 CTMR and Art. 4 TMD use substantially identical terms as Art. 9 CTMR and Art. 5 TMD respectively, accordingly the interpretation given by the

97 Art. 12 and 34 CDR, however if the documents from the national office reach OHIM later than 2 months after the national filing – the date of receiving the documents by OHIM counts as the filing date. Remarkably, the priority does not influence the term of protection of the registered Community design, Art. 43 CDR, Suthersanen, *supra* note 21, 147-148.

98 Art. 11 and 110a CDR.

99 GC Case T-303/08 - *Tresplains Investments v OHIM*, O.J. (C 30) 35, available at: [http://curia.europa.eu/jmcs/jmcs/j\\_6/](http://curia.europa.eu/jmcs/jmcs/j_6/) under the case number, para. 98-99.

100 Comish/Llevelyn/Aplin, *supra* note 48, 708.