

It has been recognised by the case-law that those rights must be of an economic nature.²⁶²

5. Scope of protection of names

The protection under §12 BGB is pre-empted by the possibility to rely on trade mark law.²⁶³ Therefore in the context of design infringement it is not likely to be relied on in many instances and is prone to be called upon in the cases of use in a design of a sign which by its owner is not used commercially and therefore is protected neither as a trade mark nor as a company symbol.²⁶⁴ This general clause allows for sufficient flexibility to cover double identity, likelihood of confusion and protection of names with reputation.²⁶⁵

Finding of an infringement under §12 BGB requires an unauthorised use of a name in such a way that infringes the legitimate interests of the owner of that name. The provision protects the identification function of a name and therefore use that can be prohibited by the owner of the protected name must be such that it influences the association of the name with its owner²⁶⁶ and has been described not as likelihood of confusion as to source but rather as ability to cause such confusion.²⁶⁷ As a result – the protection under §12 BGB requires a lower threshold of proof on confusion as it seems to be judged in more abstract terms than the likelihood of confusion closely connected to the judgement of the relevant public.

The requirement of infringement of legitimate interests of the owner of the name goes beyond the protection against the likelihood of confusion, likelihood of association and dilution of his name, whereas, differently as under §15(2) MarkenG, the protection against likelihood of confusion does not require the proximity of the fields of activity between the proprietor of a name and the alleged infringer.²⁶⁸ Furthermore, depending on whether the name for which the protection is claimed is a name of a natural or a legal person, it is required that

262 II ZR 259/90 [1991] BGH Apr. 8, 1991, NJW 1991, 2023.

263 Ingerl/Rohnke, *supra* note 24, Nach §15 para. 3.

264 Ingerl/Rohnke, *supra* note 24, Nach §15 para. 7; opposite view presented by Nägele in: Nägele, *supra* note 70, 1009, himself being of the opinion that the applicability of §15 MarkenG or §12 BGB should depend on the rationale of protection under each of the provisions and giving examples of such factual configurations, *id.* 1013.

265 Lüken in: Stöckel/ Lüken, *supra* note 53, 255.

266 BGH GRUR 1993, 151, 153 – *Universitätseblem*.

267 Nägele, *supra* note 70, 1008.

268 *Id.* 1008-1009.

the infringed interests are of personal or of purely economic²⁶⁹ nature respectively.²⁷⁰ The OHIM presents a different approach, including in the scope of distinctive signs only those names that are trade or business-related and not merely personal,²⁷¹ which consequently would allow for invalidation of a Community design only if the owner of a right to a name invokes his economic, and not personal interests against the design right.

D. The limits of protection of distinctive signs

1. The limits of protection of trade marks

In infringement proceedings under the trade mark law, the defendant has a range of defences that, if they prove successful, render his behaviour legal. Since the invalidation of a Community Design under Art. 25 (1)(e) CDR is based on the concept of infringement of the prior distinctive sign, the question can be posed, whether these defences can be called upon in invalidation proceedings by the holder of the design.

The most far reaching defence strategy is challenging the validity of the prior mark or accusing it of being subject to revocation (Art. 99(3) CTMR, Art. 11(3) TMD²⁷²) and furnishing a proof of lapse of the right (e.g. due to lack of payment of the renewal fees, Art. 46 and 47 CTMR), as a non-existing right is unenforceable.

Challenging the validity of the prior trade mark in the design invalidity proceedings has not been accepted. The registered rights are subject to the presumption of validity²⁷³ and there is no legal ground that would allow challenging such presumption in the design infringement proceedings. If the validity of a distinctive sign is contested – the Invalidity Division may suspend its proceedings on invalidation,²⁷⁴ however OHIM will not of itself inquire into the question of existence or validity of the sign on which the invalidation application is based and

269 BGH GRUR 1998, 696, 697 - *Rolex-Uhr mit Diamanten*.

270 Ingerl/Rohnke, *supra* note 24, Nach §15 para. 19-20.

271 Manual of Trade Mark Practice, available at: http://oami.europa.eu/ows/rw/resource/documents/CTM/legalReferences/partc_nonregisteredrights.pdf (last visited June 5, 2012), C.4.5.3.1.

272 Art. 11(3) TMD provides for optional harmonisation.

273 Art. 99(1) CTMR.

274 Art. 2.6 OHIM Guidelines on Invalidation of Registered Community Design; *Community Design Invalidation Manual*, *supra* note 15, B.1.6.2, providing a list of situations in which the proceedings can be suspended and stressing the OHIM's discretion in the decision on suspension.