

Use of a Trade Mark to invalidate a Registered Community Design

1. Use of a distinctive sign

1.1 A Registered Community Design ("RCD") is a unitary right which provides protection for designs across the European Union.

1.2 In the context of Community (registered and unregistered) designs "design" means the appearance of the whole or a part of a product remitting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation¹.

1.3 One of the cases in which a Community design may be declared invalid² is if a distinctive sign is used in a subsequent design, and Community law or the law of the Member State governing that sign confers on the right holder of the sign the right to prohibit such use. This ground must be invoked by the right holder of the sign³.

1.4 In a recent case⁴ the General Court had to consider this situation. In this case, Beifa Group Co. Ltd ("Beifa") had applied to annul OHIM's decision to invalidate its RCD for a highlighter pen. The earlier right, *i.e.* distinctive sign, relied upon was a German trade mark registration belonging to Schwan-Stabilo Schwanh u ber ("Stabilo") which showed a figurative drawing of a highlighter pen.

1.5 Thus, the General Court had to conduct a comparison between Beifa's RCD and Stabilo's earlier German registered trade mark.

1.6 Broadly, it was held that Stabilo's trade mark was used in Beifa's RCD, but that the trade mark and the RCD were not

identical. Nevertheless, since the trade mark bore a similarity to the RCD, it conferred on Stabilo the right to prohibit use of the trade mark in the RCD only where, because of this similarity and because of the identity or similarity of the goods or services (highlighter pens) covered by the trade mark and those covered by the RCD, there exists a likelihood of confusion on the part of the public.

1.7 In accordance with established European jurisprudence, the question whether there is a likelihood of confusion on the part of the public must be assessed globally, account being taken of all factors relevant to the case⁵.

1.8 In this case, however, the decision being appealed, in which it was held that Stabilo's trade mark invalidated Beifa's RCD, was annulled on a technicality because the Cancellation Division had erred by comparing a different trade mark from that which was actually pleaded.

1.9 As an interesting aside, it should be noted that it was held that Beifa would have been entitled to ask for proof of genuine use of the earlier trade mark. However, it should have done so at first instance, *i.e.* before the Cancellation Division. Beifa's later request was deemed to be inadmissible.

2. Practice points

2.1 This is a useful reminder to trade mark owners that in some circumstances trade mark rights may be employed to invalidate competitors' subsequently filed RCDs.

2.2 Article 25(1)(e) of Regulation (EC) No. 6/2002 refers to a distinctive sign and in the UK this will relate to unregistered as well as registered trade mark rights. Figurative and/or three-dimensional trade marks may be useful in this regard, since RCDs can be used to protect the appearance of products, packaging and also the design of logos. In addition, passing off rights, *e.g.* in the shape of packaging and/or products could also be brought into play.

¹ Article 3(a) of Regulation (EC) No. 6/2002.

² The seven cases in which a Community design may be declared invalid are itemised in Article 25(1) of Regulation (EC) No. 6/2002

³ Article 25(3) of Regulation (EC) No. 6/2002.

⁴ [T-148/08 Beifa Group Co. Ltd. v OHIM \(defendant\) & Schwan-Stabilo Schwanh u ber \(intervener\)](#)

⁵ [Case C-251/95 SABEL \[1997\] ECR I-6191.](#)

2.3 Of course, the interplay between registered designs and registered trade marks can be exploited in registration of rights as well as invalidation. For instance, new branding or logos may be protected both as a registered design and as a registered trade mark with the two types of protection providing a degree of interplay. In this regard, the rights conferred by a design registration may assist a new brand or logo having borderline trade mark registrability in acquiring distinctiveness as a trade mark, prior to application for trade mark registration.

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