

The European General Court decides its first registered design case

A European Community design registration may be invalid if the design includes a third party's trade mark. This is to avoid a competitor frustrating a trade mark owner's activities by including the mark in a registered design.

Beifa Group Co. Ltd obtained a community design registration for a highlighter pen. A competitor, Schwan-Stabilo Schwanhaußer, applied to cancel the registration because it had a trade mark for a highlighter pen. OHIM – the authority which administers community designs – cancelled the design registration.

After its subsequent appeal failed, Beifa took the case to the European general court – the first such case to be heard by the court.

A [decision](#) has now issued and Beifa was successful, chiefly on a technicality. Schwan-Stabilo had applied to cancel the registration on the basis of its “figurative” trade mark registration. However, both the OHIM and the appeal board wrongly based their decisions on a different, 3-D, trade mark. A figurative trade mark registration of a design gives narrower protection than a 3-D registration.

The General Court deemed this to be an error of law and overturned the cancellation.

For the design registration to be invalid, the trade mark in the design must be identical or bear a similarity to the registered trade mark. For there to be similarity, there must be a likelihood that the public would be confused.

The court confirmed that, if the trade mark registration is over 5 years old, during such an action the design owner can require the trade mark owner to prove that they have actually used the mark.

If you would like any further information, please contact your usual Forresters representative.