

# Recent Case Law in Trademark, Design, Competition and Copyright Law



2024

# CONTENT

Foreword .....	2
<b>I. Trademark law</b>	
1. Adidas's three-stripe mark vs. Nike .....	3
<i>Düsseldorf Higher Regional Court, judgment of 28 May 2024, 20 U 120/23 – Adidas/Nike</i>	
2. Burden of proving the exhaustion of rights conferred by an EU trademark.....	6
<i>European Court of Justice, judgment of 18 January 2024, C-367/21 – Hewlett Packard Development Company LP/Senetic S.A.</i>	
3. No business name protection for the 'Neuschwanstein' sign.....	8
<i>General Court, judgment of 16 October 2024, T-506/23 - Neuschwanstein</i>	
4. Trademark dispute over 'Oktoberfest': EUIPO emphasises low level of distinctiveness.....	10
<i>EUIPO Board of Appeal, decision of 11 December 2024, R 1264/2024-2 – Oktoberfest</i>	
5. Merely filing a trademark application without intending to use it does not generally mean that the applicant is acting in bad faith.....	12
<i>European General Court, judgment of 4 September 2024, T-166/23 – DECOPAC</i>	
<b>II. Design law</b>	
6. Criteria of the General Court for the delimitation of functional characteristics on the basis of the ECJ judgments "Doceram" and "Papierfabriek Doetinchem" .....	14
<i>General Court, judgment of 4 June 2025, T-1061/23 – Decathlon</i>	
7. Reform of the Community Design Regulation .....	17
<i>Regulation (EU) 2024/2822 of 23 October 2024 amending Council Regulation (EC) No. 6/2002 on Community designs and repealing Commission Regulation (EC) No. 2246/2002</i>	
<b>III. Competition law</b>	
8. Greenwashing? Misleading advertising in broadly worded environmental statements.....	19
<i>Federal Court of Justice, judgment of 27 June 2024, I ZR 98/23 – klimaneutral</i>	
<b>IV. Copyright law</b>	
9. Copyright law and patent applications .....	21
<i>Federal Court of Justice, judgment of 21 November 2024, I ZR 10/24 – Cornea implant</i>	

## FOREWORD

Dear reader,

Last year's innovation of broadening the spectrum to include not only trade mark law but also design law, unfair competition law and copyright law was very well received.

We have therefore once again compiled a colourful bouquet of decisions for you this year, which we hope you will find informative and interesting to read.

Adidas and Nike argued about the Three-Stripes marking on sports trousers, the question of the burden of proof for the exhaustion of trade mark rights arose in proceedings brought by Hewlett Packard, and the question of the extent to which features of a design are determined solely by the technical function was discussed on the basis of a diving mask from Decathlon. The Federal Court of Justice had to clarify copyright issues in connection with the use of photographs in a patent application, and the European Court of Justice had

to deal with company trademark protection for the 'Neuschwanstein' sign.

You can also read articles on greenwashing, i.e. misleading advertising with general environmental claims, the distinctiveness of the term 'Oktoberfest' and the bad faith of the applicant when applying for a trade mark without the intention to use it.

We also look at the entry into force of the new European Community Design Regulation, which contains some revolutionary innovations in design law and will bring exciting developments in the coming years.

If you have any questions or comments about individual articles or other topics within the field of industrial property rights, please do not hesitate to contact us.

June 2025

**EISENFÜHR SPEISER**

# I. TRADEMARK LAW

## 1. Adidas's three-stripe mark vs. Nike

*Düsseldorf Higher Regional Court, judgment of 28 May 2024, 20 U 120/23 – Adidas/Nike*

### BACKGROUND

Adidas's three-stripe mark has been a defining feature in the sportswear field for decades. As the proprietor of German figurative mark no. 39912356, Adidas obtained protection for this simple yet striking design, which is registered for 'pants, in particular sports and leisure pants, including shorts'.



The placement of the three parallel stripes along the side seams of sports textiles is characteristic of adidas products and enjoys a high level of notoriety due to many years of intensive use.

In 2022, Nike Retail B.V., a Nike subsidiary, offered five different models of sports pants with stripe patterns on the side for sale in Germany. The pants also bore a well-known Nike mark (the 'swoosh' or 'jumpman' logo), each placed differently.



(1)



(2)



(3)



(4)



(5)

Adidas regarded that as an infringement of its trademark rights and applied to the Düsseldorf Regional Court for an interim injunction against the sale of such pants. Nike argued that the relevant public did not see the stripes mark as an indication of commercial origin, because the adidas mark does not conform to the labelling practices

of the industry as a whole. The 'three stripes' mark also had below average distinctiveness, according to Nike. The Regional Court granted the application for injunction and prohibited Nike from selling the models in question. Nike filed an appeal against that decision with the Düsseldorf Higher Regional Court.

## DECISION

For one of the five accused models of pants, namely the 'LA Lakers Courtside Pants', the 20th Civil Division of the Düsseldorf Higher Regional Court upheld the injunction order and hence the ban on offering it for sale, but set aside the injunction for the other four models.

With regard, firstly, to labelling practices in the clothing industry, the Higher Regional Court made the point that whether the public see a sign applied to an article of clothing as an indication of the article's origin, or merely as a decorative element, depends on the kind of sign and how it is positioned. Although the public 'occasionally' sees the stripes mark as an indication of origin (namely adidas), the respondent, Nike, showed sufficiently clearly that stripe patterns along the pants seam were often used for purely decorative purposes. In that respect, there is no characteristic unique feature, and it all depends on the specific overall design of the pants, which also includes other applied signs.

With regard to design 1), the Court established that, despite the different design of the stripes, a likelihood of confusion did exist due to the (slight) difference in visual

impression (with identity of goods). The Nike 'swoosh' logo applied to the pants does not alter that fact, as it is not sufficiently noticed due to its colouring and size. With regard to models 2 to 5, in contrast, the Higher Regional Court assumes that consumers perceive the design as decorative elements, which meant that the function of the trademark as an indicator of origin is not compromised. Referring to the three models of 'sportswear pants', the Higher Regional Court stated that these pants had only two parallel stripes and also bore a large, clearly visible Nike 'swoosh' logo. As regards the 'Paris St. Germain pants', the court found that this model has three parallel stripes, but that these appear as a 'unitary decorative ribbon' due to the small distance between the stripes and the fact that they are in the colours of the football club. An Air Jordan 'jumpman' logo was also applied to the pants. The Higher Regional Court found that this design did not prompt any association with adidas's three stripes mark.

Nor could any claims under the law against unfair competition be considered, given the aim of consistency between trademark law and fair competition law.

## ASSESSMENT

The decision handed down by the Düsseldorf Higher Regional Court sheds light on the complex challenges involved in protecting simple but well-known trademarks like adidas's three stripes mark.

Although the trademark undoubtedly enjoys a high level of notoriety, the judgment shows that not every stripe pattern applied to the side of clothing articles automatically constitutes an infringement of the trademark. What is required, rather, is a differentiated analysis of the specific design and the overall impression produced by the respective products.

The judgment departs, interestingly, from an earlier decision of the Federal Court of Justice dating from the 2000 (case no. I ZR 21/98), which established that consumers invariably associated certain stripe patterns with adidas, due to the considerable notoriety of the three stripes mark. At the time, the Federal Court of Justice concluded that there cannot *'be any doubt, due to the substantial notoriety of the marks in suit that must be assumed,'* that the public sees the stripes as an indication of origin and not just as decoration, *'because in view of the plaintiff's labelling practices, the public is accustomed to seeing an indication of origin in the get-up of the*

*clothing articles in question*'. The present decision, in contrast, suggests that adding another well-known trademark such as the Nike 'swoosh' logo can influence how the stripes are perceived as an indication of origin. In reaching its decision, the Federal Court of Justice focused exclusively on adidas's labelling practices. On the other hand, the Düsseldorf Higher Regional Court emphasises other labelling habits of the public, such as 'uniform trousers with lampasses' in general, and even the 'uniform trousers of the Bavarian police', in particular.

The question whether the mere presence of another well-known sign is actually sufficient to reduce the distinctiveness of the adidas stripes to a relevant extent

is worthy of discussion and remains unanswered after this court order, which relates to interim relief and is therefore unappealable. However, the decision could lead to competitors increasingly using similar patterns (such as two-stripe designs, or different widths of stripes), as long as some other prominent trademark is (clearly) visible, which would significantly weaken the three stripes mark. It also remains questionable whether an additional logo is always perceptible from every angle – particularly in the everyday life of the target group, which involves intensive movement. (Venohr)

## 2. Burden of proving the exhaustion of rights conferred by an EU trademark

*European Court of Justice, judgment of 18 January 2024, C-367/21 – Hewlett Packard Development Company LP/Senetic S.A.*

### BACKGROUND

Following a request for a preliminary ruling in a trademark infringement case, the ECJ has handed down a ruling on the burden of proving exhaustion of the rights conferred by EU trademarks.

The plaintiff in the referring case is Hewlett Packard, whose HP trademark is protected as an EU trademark for computer hardware. It sells its products through a selective distribution system in which dealers may only sell to final consumers and to other authorised dealers within the distribution system. The plaintiff's products are marked with serial numbers that enable the plaintiff to identify the market the goods were intended for with the aid of an IT tool.

The defendant trades in computer hardware, but is not a member of the plaintiff's distribution system. It imported products made by the plaintiff and bearing the plaintiff's trademarks into Poland. The goods were purchased in the EU or the European Economic Area (EEA) from several sellers who also were not among the plaintiff's officially authorised dealers. They gave the defendant assurances that the goods did not infringe the plaintiff's exclusive rights. The plaintiff sued the defendant for trademark infringement before a Polish court. The defendant claimed that the goods were placed on the market in the EU and the EEA with the consent of the plaintiff. However, the defendant's demands for verification of that fact from authorised dealers of the plaintiff were to no avail.

### DECISION

The question as to whether, in such a case, the burden of proving exhaustion of rights lay solely with the defendant in trademark infringement proceedings was referred to the ECJ by the Polish court.

According to Article 15 (1) of the EU Trademark Regulation, the rights conferred by an EU trademark are exhausted if the goods have been put on the market in the EEA with the consent of the trademark proprietor. There are no provisions in the EU Trademark Regulation relating to the burden of proof, so that aspect is governed by the procedural law of the respective Member State. That the party asserting an objection bears the burden of proof for that objection is basically compatible with EU law, according to ECJ case law.

To safeguard the freedom of movement of goods pursuant to Articles 34 and 36 TFEU when the rights of the trademark proprietor have already been exhausted, the national court must modify the burden of proof if it allows the trademark proprietor to foreclose national markets.

The ECJ concluded that the right conferred by Article 15 1 EUTMR, in conjunction with the freedom of movement of goods pursuant to Articles 34 and 26 TFEU, precludes the entire burden of proof being foisted on the defendant in the case under consideration. This is because the goods bearing the trademark are not marked in such a way that third parties can identify the market for which the goods are intended, and the goods are distributed through a selective distribution network that only allows resale to officially authorised dealers. The defendant purchased the goods in the EU or the EEA and was assured that the goods could be sold in the EEA in compliance with statutory regulations. Moreover, the trademark proprietor did not check the destination market, despite a request from the defendant to do so.

The ECJ took into account that it was very difficult for the defendant to prove exhaustion on the basis of the information provided by its suppliers. If the defendant is unable to prove exhaustion, the trademark proprietor operating a selective distribution network is able to prevent parallel imports and thus restrict the free

movement of goods in a way that is not legitimated by the right to the trademark. The trademark proprietor can also use the disclosed information to withdraw the ability to purchase from any member of the distribution network that has committed a breach of contract.

If the defendant is able to prove that there is an actual risk of national markets being foreclosed, the national court, in a case such as this one, must modify the burden of

proving that the rights conferred by the EU trademark have been exhausted. The trademark proprietor must then prove that the goods had been put on the market outside the EU or the EEA either by the proprietor or with its consent. Not until that proof has been furnished is it incumbent on the defendant to prove that the goods were subsequently imported into the EEA with the consent of the trademark proprietor.

## ASSESSMENT

This ECJ decision gives dealers who are outside selective distribution systems a stronger hand. The ECJ does not address the question of whether the trademark proprietor is able to provide proof, in the present case by means of an IT tool, that the goods in question were placed on the market outside the European Economic Area. This is

something that the Polish court will have to evaluate. If the trademark proprietor can indeed provide proof, the defendant must prove that the proprietor of the trademark gave its consent to the goods being put on the market within the European Economic Area. (Kröger)



### 3. No business name protection for the 'Neuschwanstein' sign

*General Court, judgment of 16 October 2024, T-506/23 - Neuschwanstein*

#### BACKGROUND

The Free State of Bavaria filed an application with the EUIPO for revocation of the EU word mark 'Neuschwanstein', which was filed claiming the priority date of 26 January 2016 and subsequently registered for the 'Federal Association for Souvenirs, Gifts and Honorary Awards' (Bundesverband Souvenir Geschenke Ehrenpreise e.V. (BSGE)). The application pursuant to Art. 53 (1) c) EUTMR in the 2009 version (current version: Art. 60 (1) c) EUTMR), 8 (4) EUTMR was submitted with regard to classes 14, 21 and 25 and invoked Bavaria's

acquired rights to the trade names 'Neuschwanstein' and 'Schloss Neuschwanstein', based on museum activities conducted since 1 August 1886. The EUIPO Cancellation Division initially granted the request, but the Board of Appeal set aside the decision and dismissed the request, primarily on the grounds that the Free State of Bavaria had failed to provide sufficient evidence that the trade names had the necessary acquired notoriety through use and that it had not acquired any rights to the sign under German law.

#### DECISION

The General Court upheld the Board of Appeal's decision and emphasised that the Free State had not proved that the names 'Neuschwanstein' and 'Schloss Neuschwanstein' were protected names within the meaning of Section 5 of the German Trademark Act (MarkenG) and therefore had inherent distinctiveness. Nor had notoriety through use been shown.

The fact that the relevant public sees the signs as an indication of the world-famous Schloss Neuschwanstein is evidence, first of all, that the signs are definitely not perceived as fantasy signs. A museum's business activities relating to the castle and using it as an object are basically descriptive, therefore.

In this respect also, the Free State of Bavaria failed to show that the signs had crossed the necessary threshold to notoriety. Neither a demoscopic expertise nor details of advertising expenditure supporting the assumption of notoriety had been presented. The visitor figures presented by the Free State did not allow any distinction to be made regarding how many visitors were from Germany and how many came from other countries. For the Court, the fact that the 'Neuschwanstein' and 'Schloss Neuschwanstein' signs had been used in museum operations since 1 August 1886 was not sufficient to show that the signs are also understood by at least 50% of the relevant German public as an indication of the museum's business operations.

#### ASSESSMENT

According to Article 8 (4) EUTMR, an application for revocation pursuant to Article to Art. 53. (1) c) EUTMR 2009 or Art. 60 (1) c) EUTMR requires that there is an earlier right to a trademark or sign and that the trademark or sign a) is used in the course of trade, b) has more than mere local significance, c) was acquired pursuant to Union legislation or the law of the Member State governing the sign, and d) confers on its proprietor the right to prohibit the use of a subsequent trademark. Only if the four aforementioned conditions are cumulatively met can an application for revocation (or an opposition)

based on Article 8 (4) EUTMR be successful. Proceedings based on a company's right to a sign or on a non-registered trademark are therefore reserved for the proprietors of such rights who can also prove, in addition to the actual use of those signs, that said rights have more than mere local significance and therefore cross a certain threshold, both geographically and economically, that justifies opposing an EU trademark or EU trademark application. It is therefore of particular importance to check, before filing such an application for revocation (or an opposition), whether the documents and proofs

necessary for such proceedings can be furnished. The Free State of Bavaria failed to present sufficient relevant proof in the case considered here, the General Court had

no choice but to reject the application for revocation. (Holderied)

## 4. Trademark dispute over 'Oktoberfest': EUIPO emphasises low level of distinctiveness

*EUIPO Board of Appeal, decision of 11 December 2024, R 1264/2024-2 – Oktoberfest*

### BACKGROUND

On 12 August 2022 the Munich state capital (Landeshauptstadt München) filed an application for registration of the figurative mark 'Oktoberfest München' for various services in Class 43, in particular: the provision of food and drink; catering services; hotel services, and lodging and boarding services. The trademark application was published on 27 October 2022.



On 17 January 2023, FCRB IMPEX SRL, a Romanian company, filed an opposition against registration on the basis of its national 'OKTOBERFEST PUB' trademark, which has been registered since 2009 for services in

Class 43, including food services, restaurants and catering, and operation of bars, clubs and pubs.



The Opposition Division at the EUIPO rejected the opposition on 26 April 2024 on the grounds that there was no likelihood of confusion within the meaning of Article 8(1)(b) EUTMR. FCRB filed an appeal against that decision on 21 June 2024.

### DECISION

The Second EUIPO Board of Appeal handed down its decision on 11 December 2024 and upheld the dismissal of the opposition. The main arguments and findings were as follows:

#### 1. Proof of use of the earlier mark

The Board assumed that the 'OKTOBERFEST PUB' trademark was genuinely used in Romania for the services invoked. However, the evidence submitted, which included invoices, contracts with third parties and advertising material, did not sufficiently prove that the earlier mark had an enhanced level of distinctiveness. No market research, press reports or statements by professional associations were submitted.

#### 2. Comparison of services

Both marks designate identical or closely related services in Class 43 (provision of food and drink, temporary accommodation services, catering services). The

services target the public at large, particularly visitors to restaurants, pubs and hotels. The degree of attention exercised by relevant consumers was considered average.

#### 3. Comparison of signs

Visual similarity: Both marks contain the verbal element 'Oktoberfest'. The signs differ in their additional elements, such as 'PUB' in the earlier mark and 'München' in the new application.

The opponent's figurative mark includes a stylised beer mug symbol with wings, whereas the applicant's mark has a different graphic design. Due to these differences, only a low degree of visual similarity was established.

Aural similarity: The two signs coincide in the word 'Oktoberfest', which results in aural similarity. The differences produced by the words 'PUB' and 'München' were seen as separating the two signs, with the

consequence that only very little aural similarity was assumed.

Conceptual similarity: The word 'Oktoberfest' is understood by the relevant public as a reference to the Munich beer festival, and generically for similar events worldwide. The words 'PUB' and 'München' each reinforce the association with pubs and restaurants and/or with geographical origin. A low level of conceptual similarity was established due to the general notoriety of the term 'Oktoberfest'.

#### *4. Distinctiveness of the earlier mark*

The opponent argued that its trademark is very well known in Romania and that it has a high level of distinctiveness. The General Court established that the evidence presented (e.g. invoices and collaboration agreements) were not sufficient to provide an above-average distinctive character. No market research, opinion surveys or evidence of media presence were presented. The Court therefore assessed the trademark's distinctiveness as 'normal'.

#### *5. Assessment of the likelihood of confusion*

The assessment examined whether there was a likelihood of confusion, despite possible similarity of the signs, and in doing so applied the principle of interdependence. The common 'Oktoberfest' element was considered to have weak distinctiveness, which meant that a likelihood of confusion could not be derived from that factor alone. The overall impressions produced by the signs were assessed as sufficiently different due to the additional verbal elements and the different figurative elements. The Court ruled out any likelihood of confusion for that reason.

#### *Decision as to costs*

The losing party, FCRB, was ordered to bear the applicant's costs. The total costs were fixed at EUR 850 (EUR 550 for the appeal proceedings and EUR 300 for the opposition proceedings).

## **ASSESSMENT**

This decision reiterates EUIPO's restrictive approach to the assessment of marks with weak distinctiveness. The key takeaways are that generic terms like 'Oktoberfest' are difficult to monopolise – widespread use of the term for beer festivals worldwide means that no trademark can have an exclusive claim to it. Additional distinctive elements are crucial for eligibility for protection – trademarks based on a well-known term should contain other, distinctive elements. The burden of proof for enhanced distinctiveness lies with the opponent – invoices and business activities alone are not sufficient to prove market penetration. What is required are sound market research, polls and independent market analyses.

The overall impression counts: the decision shows that even a certain aural or visual similarity does not automatically mean a likelihood of confusion when other distinctive elements are present.

This decision makes it clear that the mere presence of a well-known term in a trademark does not automatically provide a right to protection. It is essential, especially for companies that use generic terms as part of their trademark, to enhance the mark with additional and uniquely distinctive elements. This applies in particular to trademarks that refer to geographical or traditional terms.

All in all, the judgment reiterates EUIPO's strict interpretation of distinctiveness and shows that trademark protection is not granted thoughtlessly for terms that are generally well known. (Böhm)

## 5. Merely filing a trademark application without intending to use it does not generally mean that the applicant is acting in bad faith

*European General Court, judgment of 4 September 2024, T-166/23 – DECOPAC*

### BACKGROUND

The dispute relates to revocation proceedings, on grounds of bad faith, against the EU trademark registered in 1998 for the DECOPAC word mark. In addition to goods in Class 30, 'Edible and inedible decorations for cakes and pastries', the trademark proprietor had also registered the trademark for very broadly defined goods and services in Classes 29 and 35.

The Class 29 goods, in particular, were unrelated to bakery products. In earlier cancellation proceedings, the applicant for revocation, Dekoback GmbH, had applied for

cancellation of the trademark due to non-use. The application was granted for the goods and services in Classes 29 and 35, but was unsuccessful for the goods in Class 30. The applicant was now requesting cancellation for the goods in Class 30 also, due to bad faith on the part of the trademark proprietor at the time of filing the trademark application. However, that request was refused by the EUIPO and by the Board of Appeal. The applicant responded by bringing an action before the General Court.

### DECISION

The General Court upheld the decision of the Board of Appeal, with the consequence that cancellation of the trademark due to bad faith was denied.

The applicant's first argument with regard to bad faith was that the goods defined as 'inedible decorations for cakes and pastries' were explicitly registered by the trademark proprietor in Class 30, despite the fact that this class is reserved for edible products. However, this ran counter to the objective of the Trademark Register, namely to provide a quick overview of existing trademarks. The General Court disagreed. Classification in Class 30 was not correct, but the simple fact that the trademark proprietor specified that class of goods does not constitute a 'dishonest attitude or intention', at the time of the application, that could substantiate bad faith. Moreover, classification practices varied between different trademark offices at that time, so the trademark proprietor cannot be accused of incorrect classification in

Class 30, particularly since the EUIPO did not correct that error either. Classification ultimately serves administrative purposes only, which means that it does not affect the scope of protection conferred by the trademark.

The second argument brought by the applicant was that the trademark proprietor had no intention of using the goods and services in Classes 29 and 35. The General Court did not accept that argument, either. Even if the earlier cancellation proceedings due to non-use showed that the trademark proprietor had not used the trademark for goods and services in Classes 29 and 35, this did not allow any conclusions pertaining to the relevant date of the trademark application to be drawn. The applicant could not prove that there was any bad faith at that particular time. Its arguments were purely speculative and without substance.

### ASSESSMENT

The concept of bad faith is not defined in EU trademark law. There is, however, a body of CJEU case law that lays

down tough requirements for proving bad faith, and the DECOPAC decision is in line with that approach.

According to that established practice, the system of undistorted competition in the Union, in which every participant in the market must be in a position to bind customers through the quality of its goods or services, is the point of departure for defining and fulfilling the concept of bad faith. The purpose of allowing signs to be registered as trademarks is so that consumers are able to distinguish such goods or services from products of different origin, without any likelihood of confusion (the function of trademarks as an indicator of origin).

Bad faith, accordingly, does not exist unless it is apparent from relevant and consistent indicia that the proprietor of a trademark did not file the application for that trademark with the aim of engaging fairly in competition, but either with the intention of undermining the interests of third parties, or for purposes other than the essential function of indicating origin, without even targeting a specific third party. This means that the mere fact that there was no

intention at the time of filing the application to use the trademark is not sufficient evidence of bad faith, which only exists if there are specific circumstances, for example when the aim is to deliberately restrict a competitor or when new trademark applications are constantly being filed as soon the earlier identical trademark is subject to an obligation to use it. However, the burden of proving such circumstances lies with the applicant for cancellation, because good faith is assumed until the opposite is proven.

Established practice has set up major hurdles to be scaled before a trademark can be cancelled due to bad faith. That said, it is always worthwhile examining whether the behaviour of the trademark applicant at the time of filing differs to such an extent from customary business practice that it is possible to prove bad faith. (Ebert-Weidenfeller)

## II. DESIGN LAW

### 6. Criteria of the General Court for the delimitation of functional characteristics on the basis of the ECJ judgments “Doceram” and “Papierfabriek Doetinchem”

*General Court, judgment of 4 June 2025, T-1061/23 – Decathlon*

#### BACKGROUND

According to Article 8 (1) of the Community Design Regulation (CDR), a Community design shall not subsist in features of appearance which are solely dictated by its technical function. This means that if at least one of the features of appearance of the product in question is not solely dictated by the product’s technical function, the Community design cannot be declared invalid on the basis of Article 8 (1) of Regulation 6/2002, and confers protection on that feature if it is novel and produces a different overall impression from the existing design corpus. However, if all the features of appearance of the product in question are solely dictated by its technical function, the design must be declared invalid.

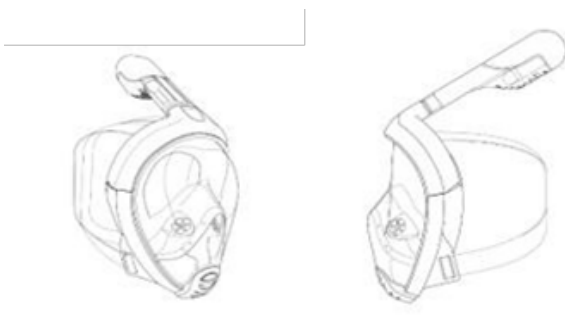
It is not easy in practice to make a distinction between technical and functional features, and features that are primarily based on design considerations and are therefore eligible for protection as European Union designs. The European Court of Justice laid down the

legal framework in this regard with its ‘Doceram’ (C-395/16) decision, which abandoned the ‘multiplicity of forms’ theory, and its ‘Papierfabriek Doetinchem’ decision (C-684/21), which specified the relevant objective circumstances for the identification of design features. In order to declare an EU design invalid on the grounds that the features of appearance of the product in question are dictated solely by its technical function, it is necessary to examine, on the basis of all the relevant objective circumstances, whether the features are determined solely by the technical function of the product, i.e. whether the need to perform a particular technical function is the only factor determining the selection of a design’s features, and that considerations concerning the visual appearance played no role.

In case T-1061/23, the Eighth Chamber of the General Court (GC) had an opportunity to apply the criteria laid down by the above decisions.

#### DECISION

On 30 March 2021, the applicant filed an application with EUIPO for a declaration of invalidity in respect of registered EU design no. 2526699-0001 for the snorkelling mask shown below:



The applicant claimed that the features of appearance of the product were dictated exclusively by its technical function. On 19 July 2022, the EUIPO Cancellation Division rejected the invalidation request. On 7 September 2022, the applicant filed an appeal with the EUIPO against the Cancellation Division’s decision. In the decision challenged here, the Board of Appeal dismissed the appeal on the grounds, inter alia, that the applicant had failed to prove that all the features of the contested design were determined exclusively by the product’s technical function.

In its appeal to the General Court, the applicant asserted that the essential features of the design were dictated

solely by the technical function of the design, including the rounded oval shape of the mask frame, which matches the anatomy of a human face, ensures as wide a field of vision as possible and has the optimised hydrodynamic shape. The GC was not convinced by this argument.

The applicant cited earlier patents and utility models which, in its view, include figures and representations that are largely identical to those of the contested design, and which describe the oval frame and the head strap of the product as technically advantageous. The GC rejected that argument.

In the view of the GC, both the shape of the mask frame and the shape of the head strap attachment have features that are based on considerations other than technical ones and which are characterised by aesthetic factors. So although it is true, as far as the mask frame is concerned, that its shape is one which is compatible with the user's face, consideration must also be given to the fact that it has an inverted teardrop shape that fully encloses the face and has rounded lines, without any protruding corners, which is particularly characteristic of the contested design. Compatibility with the user's face can also be ensured, moreover, by frames having more angular, triangular or circular shapes.

Although the (functional) purpose of the head strap is to secure the mask to the wearer's face, it also has a special 'X' shape with two narrow fastening straps joined in the middle, which shape is the result of a design decision. The mask could also have other, alternative shapes, however.

The earlier patents and utility models are not in themselves proof that the oval shape of the mask frame and the shape of the head strap attachment in the contested design are dictated solely by technical functions. According to established case law, the mere fact that a patent includes images similar to those of the contested design does not preclude non-technical considerations playing a role in the creation of the product. Drawings and descriptions in patents or utility models may be included in the 'relevant objective circumstances', but evaluation must also take into consideration that the descriptions of

patents do not necessarily focus on aspects relating to the appearance of a product. For that reason, patents or utility models cannot per se be proof that particular features of a design perform a technical function.

The Board of Appeal also referred, and correctly so in the view of the GC, to differences between the description of the features contained in the cited patents and utility models, on the one hand, and the contested design, on the other. In the view of the GC, the Board correctly established with regard to the frame of the mask in question that, although the stiffness and the need to enclose the face were features mentioned in the earlier patents and utility models, the latter did not provide any details regarding the shape of the frame, and the oval shape of the frame was chosen by the designer of the contested design regardless of technical considerations. As established by the Board of Appeal, moreover, the description of the French patent did not refer to the mask being fastened by two 'X'-shaped straps, but only to the fact that the straps can be easily fastened at the back of the head. It should also be noted that, although the patent mentions the 'X' shape of the elastic band, the representations of other snorkelling masks reproduced in the challenged decision show other variations of the 'X' shape, whereas they fulfil the same technical function. That, too, shows that the specific shape of the design is part of an aesthetic choice on the part of the designer.

The GC concludes, in agreement with the Board of Appeal, that the analysis of the earlier patents or utility models does not lead to the conclusion that the oval shape of the mask frame and the shape of the head strap and its fastening were dictated exclusively by the technical function of the snorkelling mask.

In answer to the applicant's claim that the Board of Appeal had not given sufficient consideration to the principles established in the *Doceram* decision and in particular that the Board of Appeal ascribed undue significance to the existence of alternative shapes of the frame and head strap of the snorkelling mask, the GC commented as follows: the applicant's assertion that the existence of alternative forms of the contested design did not play any role in the Board of Appeal's assessment in



its decision of whether the features of the contested design are dictated solely by its technical function is based on an erroneous interpretation of the 'Doceram' decision. The existence of alternative designs capable of fulfilling the same technical function is always a relevant objective circumstance for assessing the functionality and must be taken into consideration in the overall assessment.

The submitted evidence relating to the process of developing the mask design shows that aesthetic considerations were taken into account by its designers. In that respect, the mask prototype images clearly illustrate the visual and aesthetic development of the product. For example, even though the prototype obtained after commissioning a design company already fulfilled its function, it was nevertheless refined for aesthetic reasons to arrive at the final design. In fact, the design company proposed several versions not only for the shape of the mask frame, but also for the attachment of the head strap to the frame. The process of developing

the mask, including the different prototypes and the aesthetic decision made by the designer, is demonstrated in an advertising video ('Behind the Scenes of the Easybreath Mask Design').

All in all, the Board of Appeal and likewise the GC took account of the designer's statements as well as the advertising video in reaching their overall assessment. However, as the Board of Appeal established, the probatory force of such evidence is limited, as it reflects the subjective opinion of the party that has an interest, as the proprietor of the design, in the design's validity.

In view of the foregoing and on the basis of an overall assessment free of evaluation error, it was concluded by the Board of Appeal and confirmed by the General Court that at least the oval shape of the mask frame and the shape of the head strap attachment according to the contested design were part of an aesthetic choice by the designer and were not dictated solely by the technical function of the snorkelling mask.

## ASSESSMENT

Although the General Court, confirming the decision of the Board of Appeal, showed ways of establishing that the features are not based solely on technical considerations when there are identical drawings for the patents and the designs, using different drawing for patents and designs can only be recommended.

The GC has also confirmed once again that none of the latter evidence is sufficiently strong to establish that the features perform a technical function, and that the final conclusion will always depend on an overall assessment (Förster)

## 7. Reform of the Community Design Regulation

**Regulation (EU) 2024/2822 of 23 October 2024 amending Council Regulation (EC) No. 6/2002 on Community designs and repealing Commission Regulation (EC) No. 2246/2002**

### BACKGROUND

After more than ten years of planning, the revised European Community Design Regulation has finally entered into force and has been applicable (in parts) since 1 May 2025.

The objectives included modernising and simplifying the existing Regulation (as was done for trademark law some years ago), creating more legal clarity, and making it easier (and less expensive) to obtain Community designs.

### IMPLEMENTATION

The new Regulation (along with a new Directive harmonising the national laws to a large extent) was adopted by the European Council in October 2024 and entered into force on 9 December 2024. Terminologically, the term 'Community design' has been replaced by 'EU design' (and the German term 'Gemeinschaftsgeschmacksmuster' by 'Unionsgeschmacksmuster'), which is a logical step considering that the European Community has long ceased to exist. Unfortunately, the simplification to 'Design' instead of 'Geschmacksmuster' already implemented in German design law was not adopted, so we have to live with the fact that there is such a thing in German as a 'deutsches Design', whereas the EU design is now called an 'Unionsgeschmacksmuster'.

A substantive change was made to the definition of a 'design', which now includes the appearance of a whole or a part of a product resulting from the features, *'including the movement, transition or any other sort of animation of those features'*. Although movements could also be depicted to a very limited extent before now, this extended definition will mean that it must also be possible to file not only static images for registration, but also video formats, for example. However, the details of implementation will not be clear until adoption of the Implementing Regulation, which is expected at the end of 2025. We will not know before then what video formats are allowed, or how many images may be submitted with an application.

The definition of 'product' has also been extended so that it does not have to explicitly be a physical object. This

opens up scope for light projections, holograms and animations, for example. The interplay of these two extended definitions will ensure that the design will be explicitly freed in Europe, and globally uniquely, from its limitation to a few static views, thus allowing much easier protection of products that move, radiate, include digital elements, or any combination thereof.

When protection is now conferred on a design, this also includes the prohibition of creating and/or propagating templates for 3D printing of the design; the confiscation of infringing goods in transit through the EU has also been included as a possibility. Use of the design by third parties in order to identify it as the proprietor's, or to refer to the latter, and activities for the purpose of commenting, criticising or parodying have been explicitly removed from the scope of protection conferred by a registered design. Similarly to trademarks, it will now be possible to indicate by means of a sign (a 'D' inside a circle) that the design is protected as a registered design – although how exactly this can be practicably effected on the product itself will remain to be seen.

In the application procedure, filing a collective design remains an attractive option. Although the maximum number of designs in such an application has been reduced from 100 to 50, the singularity of the Locarno classification has been removed, with the consequence that an application for a collective design may also include different products from different Locarno classes. The cost structure has also been simplified: each additional design in a collective application will now cost EUR 125 in official fees.

## ASSESSMENT

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This reform of the Design Regulation was long awaited and is only to be welcomed. It closes a number of gaps and provides clarity. By extending the definition of what is eligible for protection, it strikes out in new and inspiring directions. The simplification of the cost structure, for example, ensures that design rights will continue to gain in attractiveness and should be a key element of the IP portfolio for most companies and creatives. Digital worlds, animations, projections and user interfaces, especially, can now be protected more easily and with greater precision.

These new options in the EU must be taken into account in any international strategy, because it will not be possible to extend designs filed in new formats in the EU to other countries simply on the basis of priority or as international designs, as their regulations are less flexible. However, this option should not be left unused in the EU, so do not hesitate to contact us if you have any questions about your specific products, graphical user interfaces or developments. (Brecht)

### III. COMPETITION LAW

#### 8. Greenwashing? Misleading advertising in broadly worded environmental statements

*Federal Court of Justice, judgment of 27 June 2024, I ZR 98/23 – klimaneutral*

##### BACKGROUND

In a case brought by the German Centre for Protection Against Unfair Competition (the 'Wettbewerbszentrale'), the Federal Court of Justice had to rule on whether a confectionery manufacturer was allowed to advertise a product using the blanket term 'klimaneutral' (climate neutral) on its packaging. The ClimatePartner logo was

placed ahead of the climate neutrality claim. ClimatePartner is a software platform that supports companies in calculating their CO<sub>2</sub> emissions and implementing in-house reductions, as well as financing climate protection projects as a way of offsetting CO<sub>2</sub> emissions.

##### DECISION

The outcome was that the Federal Court of Justice overturned the lower courts' judgments and affirmed that the advertising was misleading within the meaning of Section 8 (1) Sentence 1, Section 3 (1) and Section 5 (1) of the law against unfair competition (UWG). The grounds for decision referred to the increasing importance of climate protection for consumers and to the greater need for education and information. The strict examination criteria applying to health-related advertising, established for many years, must also apply to environmental statements. As noted in the European Climate Law (Regulation (EU) 2021/1119), consumers understand climate neutrality alternatively as (i) direct prevention of CO<sub>2</sub> emissions in production or (ii) financial compensation to certified third parties that flows into environmental protection projects, for example reforestation. However, the two alternatives are not equivalent to each other in the view of final customers.

The applicable principle, rather, is that reduction should take priority over compensation.

If a manufacturer uses the term 'climate neutral' in its advertising, it must therefore state clearly and unambiguously which of the two alternatives is meant.

Referring to a climate partner does not satisfy that requirement. Its involvement might also relate to climate-friendly production processes, as opposed to downstream offsetting of CO<sub>2</sub> emissions. Consumers cannot reasonably be expected to inform themselves in greater detail by looking at the climate partner's website. The argument that there is not enough space on the product packaging to provide the required information was not accepted by the Federal Court of Justice, due to the strict examination criteria.

##### ASSESSMENT

The lower courts had ruled that the advertising was not misleading within the meaning of Section 5 UWG, but that it did constitute a breach of the duty to inform pursuant to Section 5a UWG. Consumers associated the advertising message with the company and not with the specific product, and they assumed that climate neutrality

could also be achieved via financial compensation. The principle of CO<sub>2</sub> offsetting is familiar to consumers for some years already, above all from air travel.

In recent years, other courts had argued along similar lines in similar cases. The Higher Regional Court in

Düsseldorf, for example, ruled that the statements 'climate-neutral product' and 'naturally sustainably good' on a jam jar were not misleading, but did constitute a breach of duties to inform. The Higher Regional Court in Schleswig also denied that a star on bin liner packaging was misleading, and regarded it as sufficient to comply with the duty to inform pursuant to Section 5a UWG. The Federal Court of Justice has now clarified in its decision that ambiguous general statements such as 'climate neutral', 'CO2 neutral', 'climate friendly', 'sustainable',

'environmentally friendly', 'ecofriendly', 'ecological' or 'biodegradable' can be misleading. The crucial point in each specific case is whether consumers associate the advertising claim with the company or the particular product, and that consumers will generally assume that there is 'genuine' CO2 neutrality rather than any downstream financial compensation. In other words, if neutrality means 'only' compensation, then this must be communicated clearly and unambiguously. Referring to the certified partner does not suffice in that respect.

## OUTLOOK

The upshot is that vague environmental claims will be subjected to stricter assessment in future. This ruling from the Federal Court of Justice implements the strict requirements for transparency laid down in Directive (EU) 2024/825 on 'empowering consumers for the green transition through better protection against unfair practices and through better information'. The 'EmpCo' Directive, which takes its name from 'empowering consumers', will not be binding on Member States until 2026, but once it enters into force, case law on interpretational issues will be based on its wording.

The ultimate aim is that consumers can clearly contextualise advertising messages and can recognise whether (i) a product was itself manufactured in a climate-neutral way, (ii) the advertising company operates in a climate-neutral way on the whole or (iii) the climate neutrality is achieved via financial compensation. Only then is it possible for a customer to make sustainable and informed decisions as a consumer.

The EmpCo Directive is a piece of the 'green deal' mosaic, the objective of which is to ensure that the European Union is climate neutral by the year 2050. The focus shifted to the regulation of environmental advertising claims, because more than 40% of products are meanwhile advertised or labelled in one way or the other in terms of sustainability aspects. The second core element of the EmpCo Directive, moreover, is the

attempt to regulate the confusing abundance of more than 300 sustainability labels and to not allow any new ones.

Another piece of the EU climate effort mosaic is the proposed 'Green Claims' Directive, which was effectively endorsed by the European Parliament when it adopted its first-reading position. The Directive is aimed at regulating explicit climate-related claims and environmental labels. An analysis showed that about 40% of such claims are not backed up by scientific evidence. It is therefore planned to introduce a certificate of conformity for explicit environmental claims. A company would have to apply for prior examination to an authority newly created by the respective Member State and prove that the planned advertising is scientifically correct. If a competent national authority verifies the claim, it would be recognised across the Union. It was originally planned that both directives would enter into force at the same time, but the Green Claims Directive is now lagging behind. Trialogue negotiations between the Council of Member States, the European Commission and the European Parliament began in January 2025. Criticism is increasingly voiced that Brussels is always creating more and more rather than fewer rules, as well as new documentation requirements and even more authorities. However, it is expected that the Directive will be adopted, despite all the criticism. (Ehlers)

## IV. COPYRIGHT LAW

### 9. Copyright law and patent applications

*Federal Court of Justice, judgment of 21 November 2024, I ZR 10/24 – Cornea implant*

#### BACKGROUND

Correspondence with authorities and courts is legally privileged to the extent that some things may be presented there that would not be allowed in other forms of correspondence. The intention behind such privilege is to ensure the operation of legal protection: a person engaged in a dispute before authorities and/or courts must be free to present their case without being hampered in their right to legal protection, for example by third parties being able to prohibit a particular statement or argument by obtaining court orders and the like. In its '*Fischdosendeckel*' (tinned fish lid) decision, the Federal Court of Justice denied a legitimate interest for an action under competition law with which a company wanted to stop its technology being discussed in a competitor's patent application as disadvantageous prior art.

The company bringing the action was of the opinion that its products were being disparaged by such a discussion, and sought injunctive relief against such allegations. However, the Federal Court of Justice denied any legitimate interest in such legal action, on the grounds that the patent granting procedure governed by the rule of law may not be interfered with by seeking a prohibitory injunction under competition law.

The cornea implant decision discussed here concerns the question of how to apply these principles to the use of copyrighted images in a patent application.

#### DECISION

The parties had collaborated in a research and development project relating to the decellularisation of cornea implants. The 'supply contract' governing the project specified a particular allocation of rights to results from the project, depending on which party already held IP rights in the respective field. In simple terms, the project involved 'decellularising' porcine cornea tissue so that the tissue does not become opaque, but remains clear and transparent and can thus be used as an implant in the human eye. Various test series were carried out. In one test series, decellularisation was not successful. The tissue remained cloudy. According to the plaintiff, one of its employees took a photo of this unsuccessful outcome and sent it to the defendant.

The defendant later filed a patent for a decellularisation method, in which it used the photo referred to above as an example of a failed test in order to illustrate the difference from the result obtained with a method according to the invention. The plaintiff sued for

infringement of its copyrights to the photo and requested injunctive relief, information and damages.

The Regional Court dismissed the action as unfounded. The defendant had a right under the 'supply contract' to use the photo, which permitted it to use the photo as part of the patent application.

The Higher Regional Court took a different view and dismissed the action as inadmissible from the outset and referred thereby to the aforementioned 'tinned fish lid' decision by the Federal Court of Justice. The question ruled upon in the latter case, concerning some derogatory comments in a patent application about a competitor's products, was similar to the present one, where the question concerned an infringement of copyright by using a photo in a patent application.

The Federal Court of Justice disagreed. A legitimate interest in legal action cannot be denied in the present

case, because Section 45 of the German Copyright Act includes a provision in substantive law that specifically governs the present question of privileged use of copyrighted works in correspondence with authorities and courts. Thus, since there is already a special provision in substantive law governing this question, its scope of application cannot be curtailed by denying such a legitimate interest in protection at the procedural level with the result that Section 45 of the Copyright Right is not even brought to bear.

The Federal Court of Justice therefore overturned the Higher Regional Court's decision and referred the matter

back to said court for reconsideration. It drew the attention of the Higher Regional Court to the fact that, in the view of the Federal Court of Justice, a three-step test must be applied when assessing whether Section 45 of the Copyright Act applied. Exceptions from copyright protection may only be made in 'certain special cases' (first step) that 'do not conflict with a normal exploitation of the work' (second step) and that 'do not unreasonably prejudice the legitimate interests of the right holder' (third step). With regard to the latter step, the Federal Court of Justice points out that consideration must be given to the fact that the defendant's patent application did not name a source for the photo.

## ASSESSMENT

In its official headnote, the Federal Court of Justice refers to its decision as 'continuation' of its 'tinned fish lid' decision. However, it is actually difficult to explain why, for example in cases where personal rights are violated when statements are made to authorities and courts, defence of the injured party is precluded from the outset because the action lacks admissibility. In contrast, it is only in copyright law that such an action is supposedly admissible, and the use of copyrighted materials in such in such statements is to be assessed purely by reference to Section 45 of the Copyright Act, which according to the

Federal Court of Justice must be narrowly interpreted. That aside, anyone who makes statements to authorities or courts should familiarise themselves with the provision in Section 45 of the Copyright Act, and in particular should mention the respective source in such statements when using copyrighted materials (which also include screenshots of websites, for example). (Eberhardt)

*(Note: Eisenführ Speiser represented the defendant in the previous instances.)*

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Founded in 1966 in Bremen, the law firm of Eisenführ Speiser is specialised in the field of intellectual property (IP) and is one of the "Top Ten" IP firms in Germany. Besides patent, trademark and design law, services also cover copyright and competition law. The partners in Eisenführ Speiser include both patent attorneys and attorneys-at-law, whose close collaboration results in advanced expertise in litigation, licensing and contract law, IP portfolio analysis and IP due diligence.

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