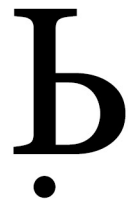


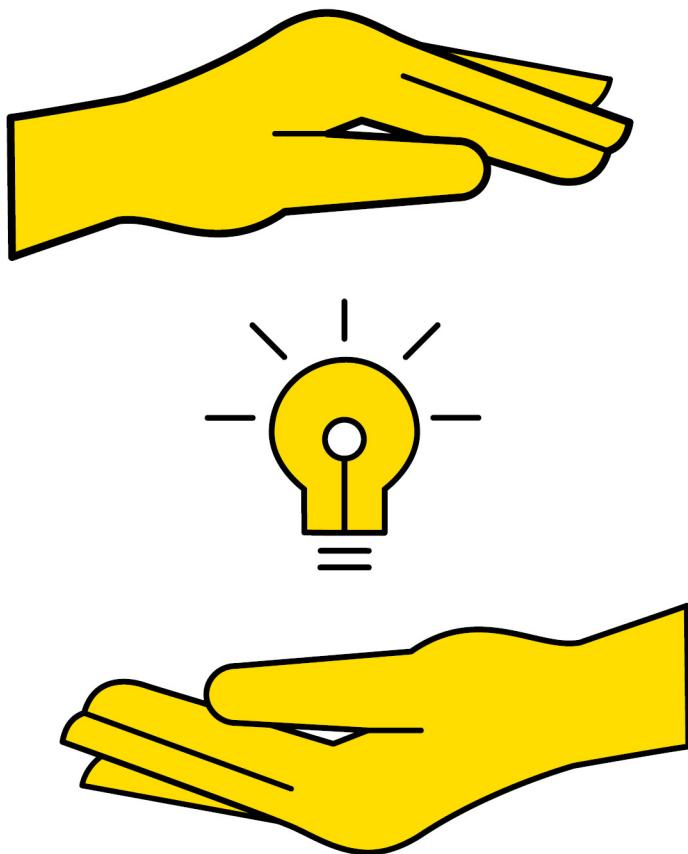
# Protection against Product Imitation without Registered Intellectual Property Rights



## Protection against Imitation under Unfair Competition Law

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# Protection against Product Imitation under Unfair Competition Law

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Henning Hartwig

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The manufacturer of a product and their exclusive distribution partner do not require registered industrial property rights in order to protect the product against imitations. In Germany, the legal system also grants a product protection against imitation even if it is not protected by copyright, or by a registered design, trademark, utility model or patent.

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# 1. Significance of protection against imitation under competition law

Even in cases where a product (but not an intangible product idea) is protected neither as a registered design, nor as a work in the copyright sense, nor as a three-dimensional trademark, nor as a utility model or patent, the product may nevertheless be protected against imitations. The legal basis is the German Act against Unfair Competition, which protects the product against imitations if such are capable of generating in the purchaser an incorrect notion as to the origin of the product and if the imitator had reasonable opportunities to avoid such an error. This protection against imitation by Unfair Competition Law also takes effect if the imitation exploits the repute of the product or is capable of impairing the repute of the original.

The protection against imitation under Unfair Competition Law has considerable significance and can look back on decades of tradition in German legal practice.

Its effectiveness is easily comparable with that of registered intellectual property rights. In particular, this protection against imitation is a possibility:

- if the manufacturer has failed to file their product as a registered design in good time,
- if the product is not sufficiently original in order to establish copyright protection, which requires a relatively high degree of originality in utilitarian objects,
- if the protection of a product as a 3-D or other trademark in the shape of the product has been denied or is impossible, or
- if the imitation circumvents the patent claim that covers the product.

In all these cases, protection against imitation by Unfair Competition Law can take effect, granting a scope of protection that can, in the final analysis, be equivalent to that of a registered design, a copyrighted work, or a product shape trademark.

Protection against imitation by Unfair Competition Law is by no means subsidiary to these special IP rights, but instead exists alongside them. In particular, protection against imitation by Unfair Competition Law can exist even if the short period of protection of an unregistered Community design has expired, and if the term of

protection of a registered right has expired. Upon expiry of the protective period of these special rights, imitation protection does not necessarily end, but can continue under competition law.

## **2. Preconditions for protection against imitation under Unfair Competition Law**

The judicial practice of the German Appeal Courts and the Federal Supreme Court has been highly differentiated for decades on the individual preconditions for protection against imitation under competition law. In most cases of dishonest imitation, this judicial practice allows a generally reliable assessment of the prospects of success.

### **2.1 No need for market recognition of the original manufacturer**

First of all, according to judicial practice, protection against imitation by Unfair Competition Law on the grounds of an avoidable deception as to origin does not require that the public knows the manufacturer of the product by name. Instead, it is sufficient if it knows that the product has been put into circulation by a specific manufacturer, whoever he may be. As a rule, judicial practice upholds the existence of such a belief on the part of the public if the product is individual and is clearly distinguished from other similar products.

### **2.2 Imitator's knowledge of the original**

However, a positive precondition is that the contested product is an imitation and that the manufacturer was aware of the original as a model when they manufactured the contested product. According to judicial practice, however, this is to be assumed if the contested product came onto the market later than the original product.

### **2.3 Individual character of the original**

A further essential precondition for protection against imitation by Unfair Competition Law is that the product is individual and is obviously distinguishable from comparable products. For this it is necessary (and, as a rule, sufficient) to present an overview, at

least of examples, of rival products on the market. It is sufficient if the product differs from other comparable products on the German market; any individuality at international level is not necessary. There can therefore also be protection against imitation in Germany if the product does not constitute anything particular on foreign markets.

Nor is it necessary for the design features of the product to be new. A product is also regarded as individual and can therefore claim protection against imitation by Unfair Competition Law if its individual design features are known and are not new. It is sufficient for competition law protection if the combination of the design features of the product is new. The combination of known design features to create a new product can grant the latter competitive individuality if the combination of these design features was not previously known on the market.

It is also worth noting that individuality can result from design features that are necessary for technical purposes. Technically necessary design features or their combination can give a product individuality and establish protection against imitations under competition law. Only design features that are absolutely necessary and cannot be replaced by other equivalent design possibilities must be ignored and do not establish protection against imitation by Unfair Competition Law.

## **2.4 Notoriety of the original product**

A further precondition is a certain minimum notoriety of the product on the German market. For this, it is sufficient if the product is marketed in not entirely insignificant quantities. It may also be sufficient to exhibit the product regularly and over a longer period of time at trade fairs with a German public, or to advertise it in other advertising media that reach a not insignificant percentage of purchasers on the German market.

There is no requirement that the product must have acquired market recognition or, even less, that it has become famous. However, according to establish judicial practice, an increased notoriety means that the scope of protection of the product is extended and can also apply against somewhat more remote imitations.

## **2.5 Similarity between original and imitation**

A further precondition for the protection of a product against imitation by Unfair Competition Law is that the imitation must have a sufficient degree of similarity to the original. The decisive factor is whether the overall impression created by the imitation corresponds to the overall impression of the original product. Correspondences in individual features that are not decisive for the overall impression of the product are not sufficient. Conversely, differences in individual features of the execution of the product are of no significance and do not prevent protection against imitation if these features fade into the background in the overall impression. There is sufficient similarity for protection against imitation if the imitation corresponds with the original in the combination of decisive design features and otherwise is devoid of any additional characteristic features.

Differences in details of execution that are only identifiable in a comparative examination of the imitation and the original are, as a rule, no obstacle to imitation protection. According to judicial practice, the assessment of similarity is to be based on the impression of the original that the purchaser recalls when they encounter the imitation and typically do not have the opportunity to compare the original and imitation directly.

## **2.6 Protection even if the trademark is changed**

Merely omitting the trademark of the original product in the imitation does not, as a matter of principle, exclude protection against imitation. Nor, however, does the application of a different trademark to the imitation overcome the protection of the original in many cases. In any event, this is the case if the different trademark is not permanently and inseparably affixed to the imitation. The different trademark does not circumvent the protection of the original even if the different trademark is not easily identifiable or if the public in the market sector concerned generally makes its decisions on the basis of features other than the trademark.

However, even if the trademark is applied permanently and visibly to the imitation, and even if the purchasers also make their decisions on the basis of the trademark in the market sector in question, the original may still enjoy protection against such imitation. This applies in particular if it is not unusual in the trade sector in question to market products in the same or a modified form under a second trademark.

## **2.7 Avoidability of the deception as to origin**

A further precondition for protection against imitation is that the imitator could reasonably be expected to use a different design. In this respect, it is, as a rule, sufficient if the manufacturer presents an overview of the market (in extracts) to show the variety of designs in the product category in question.

## **3. Claims, litigation possibilities, strategy**

### **3.1 Claim to injunction, information, damages**

In the event of an infringement of the provisions concerning protection against imitation by Unfair Competition Law, the manufacturer or the dealer entitled to exclusively market the original product can prohibit the marketing of the imitation in the Federal Republic of Germany. They can demand information about the marketing channels of the imitation, the rendering of accounts concerning the extent of the marketing and damages.

However, the applicant cannot claim destruction or confiscation.

### **3.2 Preliminary protection**

The claim to an injunction can be enforced by the manufacturer and the exclusive dealer by means of preliminary injunction proceedings that may permit the issue of a prohibition within only a few days. The issue of a preliminary injunction, however, requires rapid action on the part of the manufacturer or the sole distributor; as a rule, no more than one month may elapse between acquiring knowledge of the unlawful marketing of the imitation and the filing of an application for the issue of a preliminary injunction.



### **3.3 Evidence**

It is vital for a claim to protection against imitation by Unfair Competition Law to provide details concerning the presence and design alternatives of other products in the same product category in Germany and details about the period of time and scope of the marketing of the original product in Germany, its advertising and other details that indicate a certain minimum notoriety. Details concerning any award of prizes for the products may also play a role, as does information about any special technical features.

### **3.4 Preventing the weakening of protection**

In order to maintain protection, it is necessary to consistently prosecute imitations and prohibit their marketing. Otherwise, the individuality of the product, which is a precondition for protection against imitation by Unfair Competition Law (see above, 2.3), can be lost.

Where a larger number of imitations appear simultaneously, however, the manufacturer of the original, or their exclusive distributor, is not required to take judicial measures against all of them at the same time, but can, under certain circumstances, depending on the nature of the facts of the case, also proceed successively. Nor, as a rule, is the protection of the original damaged if measures are not taken against an imitation that was obviously only on the market for a short period of time and in small quantities. For the rest, however, the maintenance of the protection of the original requires a consistent and rapid enforcement of the rights in order to prevent a weakening of the individuality of the original.

This also involves the prosecution of borderline cases. As long as a borderline imitation is on the market, there is the risk that it will be regarded as a factor that weakens the individuality of the original. This risk no longer applies if its marketing has been prohibited. Nor, however, does it apply if it has been unsuccessfully contested by the original manufacturer and a court has denied protection against the marginal imitation on the grounds that, in the final analysis, it did not regard the products as being sufficiently similar. Imitations that have been held by the court to have a dissimilar overall impression do not weaken the individuality of the original.



# Contact

## Munich

Prinzregentenplatz 7  
81675 München  
T +49.(0)89.928 05-0  
F +49.(0)89.928 05-444  
info@bardehle.de

## Barcelona

Avenida de Diagonal 598, 3º 1ª  
08021 Barcelona  
T +34.(0)93.4 57 61 94  
F +34.(0)93.4 57 62 05  
info@bardehle.es

## Duesseldorf

Breite Straße 27  
40213 Duesseldorf  
T +49.(0)211.478 13-0  
F +49.(0)211.478 13-31  
info.duesseldorf@bardehle.de

## Paris

50 Square Opéra  
5 rue Boudreau  
75009 Paris  
T +33.(0)1.53 05 15-00  
F +33.(0)1.53 05 15-05  
info@bardehle.fr

## Hamburg

Bohnenstraße 4  
20457 Hamburg  
T +49.(0)40.271 4468-0  
F +49.(0)40.271 4468-50  
F +49.(0)40.271 4468-50  
info.hamburg@bardehle.de

## Yusarn Audrey Singapore Office

4 Shenton Way  
#14-03, SGX Centre 2  
Singapur 068807  
T +65.(0)63.58 28 65  
F +65.(0)63.58 28 64  
enquiries@yusarn.com

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