



Client Information | August 2019

FEDERAL SUPREME COURT ABANDONS “OVERLAP THEORY” IN DESIGN LAW

WHAT IS NEW AT PRINZ & PARTNER?

Dr. Adrian Kleinheyer

Federal Supreme Court abandons “overlap theory” in design law

German and European design law stipulates that the subject-matter of a design may only be the appearance of a product or part thereof. It is not permitted to represent several manifestations of a product (e.g. different colour variants) within one design. The possibility provided under German design law of submitting up to ten (EU: up to seven) representations with different views per design serves the purpose of clarifying the object of protection by reproducing the design from different angles or in different states. It does not serve the purpose of combining different embodiments of a product in a single application. In order to protect different embodiments, it is necessary to file separate designs, possibly by means of a multiple application.

Although this provision is clear and unambiguous, it has been interpreted generously by the courts so far: The representation of different variants of a product within one design was sometimes considered admissible if all variants had at least one common basic form. The interpretation of the application could lead to the conclusion that deviations of the representations must not be taken into account when determining the subject-matter of the design and that the subject-matter of the designs consist of the overlap of the features common to all representations.

In a recently published decision the Federal Supreme Court has now abandoned his „overlap theory“, finding that the representation of several variants of a product in a single design is inadmissible (BGH, decision of 20 December 2018, Case No. I ZB 25/18).

Specifically, the decision concerned the representation of several designs of a protective helmet for children with different colour combinations and decorations within one design registration. In accordance with the "overlap theory", the Federal Patent Court had affirmed the validity of the design by stating that all variants of the helmet had the same basic form. The Federal Supreme Court, however, overruled this decision by abandoning its previous case law and referring to the wording of the applicable provisions of the German Designs Act. Accordingly, the Court referred the case back to the Federal Patent Court for a new decision.

In practice, this means that in future design applicants will have to be even more aware of which components and facets of their product they wish to have protected as design. If a product is sold in different variants (e.g. with different imprints or interchangeable attachments), the basic design should be made subject of a design and the variants subject of further separate designs. For reasons of cost, it is advisable to combine all designs in a multiple application, as the applicant thus benefits from a depression of fees.



QUESTIONS?

If you have any questions regarding this topic, please feel free to get in touch with your personal contact or Dr. Adrian Kleinheyer at (a.kleinheyer@prinz.eu).

Prinz & Partner ranked in Financial Times

Prinz & Partner has been added to the list of 142 "Europe's Leading Patent Law Firms" by the Financial Times. We are very pleased to receive this recommendation, which was awarded to patent law firms by the Financial Times for the first time in 2019. The list was made on the basis of recommendations from over 2.700 clients and peers.

Further information on the ranking can be found under the following link:

[Europe's Leading Patent Law Firms](#)

Two colleagues qualified as European Patent Attorneys

Two of our junior colleagues have passed the European Qualifying Examination EQE and now hold the title “European Patent Attorney”. We congratulate Dr. Tobias Philipp and Tobias Sorg on passing the bar exam and are delighted that they have achieved this new qualification.

CONTACT DETAILS



Dr. Tobias Philipp

Dipl.-Ing., Ingénieur Diplômé (ECP)
European Patent Attorney
Phone: +49 (0) 89 / 59 98 87-105
Fax: +49 (0) 89 / 59 98 87-211
t.philipp@prinz.eu



Tobias Sorg

Dipl.-Phys., B.Sc. Industrial Engineering
European Patent Attorney
Phone: +49 (0) 89 / 59 98 87-112
Fax: +49 (0) 89 / 59 98 87-211
t.sorg@prinz.eu

Prinz & Partner mbB
Rundfunkplatz 2
80335 München

Phone: +49 (0) 89 / 59 98 87-0
Fax: +49 (0) 89 / 59 98 87-211
E-mail: info@prinz.eu