

# THE REQUIREMENTS FOR PROTECTION OF THE COMMUNITY DESIGN

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## ABSTRACT

*This paper aims at showing the key issues underlying the requirements for protection of the community design. According to the Council Regulation (EC) No 6/2002, a design must satisfy two main conditions to be protected by a Community design: novelty and individual character. A further consideration is the requirement of visibility, but only when it comes to register component parts of a complex product. Three main types of subject matters are excluded from protection: first, a Community design cannot relate to characteristics of the appearance of a product that are exclusively dictated by its technical function; second, the situation referred to as “must fit” and “must match” cases and, third, a design applied to or incorporated in a component part of a complex product if the component part does not remain visible during the normal use of the complex product. Also, Community designs contrary to public policy or to accepted principles of morality are excluded from protection.*

*One special interest of the paper is the recent jurisprudence of the community design courts in this field. A core element of the protection system is the role of the community court’s jurisdiction in matters of community design. These are courts of Member States that have been designated by them as community courts, which have exclusive jurisdiction to decide on cases of breaches of rights of community designs. The evolving and contradictory decisions of the national instances implies that with respect to the evolution of a homogeneous case law on unified Community industrial property, the European Court of Justice has had and still has to fulfil its exclusive mission of informing national courts as to the direction, in which European Union law is to develop.*

**KEY WORDS:** *community design, individual character, informed user, solely dictated by technical function, European Court of Justice*

## I. INTRODUCTION

The Community Design Regulation (CDR)<sup>2</sup> states, in articles 4 to 9, that a design shall be protected by a Community design to the extent that it is *new* and has *individual character*. A further consideration is the requirement of *visibility*, but only when it comes to register component parts of a complex product. In addition, Community designs contrary to *public policy* or to accepted principles of *morality* are excluded from protection. The requirements for protection of community design mentioned above are circumstantiated using notions that entail further consideration and analysis. The present paper highlights, in the context of community design, these concepts and attempts to clarify them

The significance of the studied matter is relevant in outlining the protection conferred for the community design. The requirements for protection regarding novelty and individual character, actually, constitute absolute grounds for invalidity<sup>3</sup>.

The paper illustrates that there are conflicting views over the clarification of this legal norms in the jurisprudence of the national instances, designated as European design courts and in the decisions of the Board of Appeal of the Office. Therefore, depending on the understanding of the notions mentioned above the validity of design will be established.

To clarify the concepts of novelty and individual character, it will be carry out an examination of the legal norms governing the issue, art 4-9 of the Regulation 6/2002. The attempt is to compare

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<sup>2</sup> Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, *OJ L 3, 5.1.2002, p. 1–24*

<sup>3</sup> Massa, Charles-Henry, and Alain Strowel. “Community Design: Cinderella revamped.” *EIPR* (2003): 68-78.

and study these terms in light of the programmatic documents of the European Commission, the opinions of scholars, the recent decision of the Office for Harmonization in the Internal Market and the few existing judgements of the European General Court. One special attention is granted to the jurisprudence of the European design courts.

The issue of harmonization and unification of the legislation on design law, at the European Union, is a constant concern of the doctrine. Since the planning stage, proposals for a directive on the harmonization of national legislation on the design and the creation of the Community Design Regulation enjoyed an in depth comparative analysis, in an attempt to anticipate the possible interpretations of legal text (Mario Franzosi, 1996), (David Musker, 2002). It is recognized that design protection crosses all aspects of intellectual property rights (Uma Suthersanen, 2000; 2010)<sup>4</sup> and advantages and drawbacks of community design is considered (Massa and Strowel, 2003). The coverage of the legal norms governing the community design is present in the Romanian doctrine (Viorel Roș, 2003)<sup>5</sup>, (Constantin Duvac and Ciprian Paul Romițan, 2009)<sup>6</sup>, (Alice Mihaela Postăvaru and Gheorghe Bucșă)<sup>7</sup>. Access to the decisions of competent national law courts is not simple. Some court decisions are published in annual collections, receiving annotations. (Henning Hartwig, 2007, 2008, 2009).

## II. Novelty

Under article 5(1) of the Regulation "a design shall be considered to be new if *no identical design* has been made available to the public". Novelty is identified with the absence of identical designs publicly disclosed prior a reference date. Designs are considered identical if their features differ only in *immaterial details*<sup>8</sup>. In other words, according to Massa and Strowel, novelty consists in an objective non-identity exceeding immaterial details.

In the case of the protection of community design, the Commission did not intend to adopt the system of "novelty" within the meaning of patent law protection, although the drafting norm displays similarities, but to create a specific concept<sup>9</sup>.

In this context, the Green Paper<sup>10</sup> indicates a two-step test presented below. In the first stage of the test, the design must not to have been anticipated by a design which appears as identical or substantially similar *to the circle of specialists* in the field and in the second stage, must be distinguished from other designs commonly known *in the eyes of an ordinary consumer*. The result of this first stage of the test would, therefore, be that designs which are not known by experts operating within the Community would be eligible for protection either because they are completely different from anything known by them at the specific point in time, or because they present, according to the assessment by an expert eye, sufficient differences from known designs to constitute creative independent development.

The second stage involves the evaluation of the test indicated by the "relevant public". While the Commission acknowledges that the differences can be less perceptible to an ordinary consumer, it

<sup>4</sup> Suthersanen, Uma. Design law in Europe: an analysis of the protection of artistic, industrial, and functional designs under copyright, design, unfair competition, and utility model laws in Europe, including a review of the E.C. Design Regulation, the E.C. Design Directive, and international design protection. London: Sweet & Maxwell, 2000 (2<sup>nd</sup> ed., September 2010)

<sup>5</sup> Roș, Viorel. Dreptul proprietății intelectuale. Dreptul de autor și drepturile conexe, Editura ALL Beck, 2005

<sup>6</sup> Duvac, Constantin, and Ciprian Paul Romițan. *Protecția juridico-penală a desenelor și modelelor*. București: Universul Juridic, 2009

<sup>7</sup> Postăvaru, Alice Mihaela, and Gheorghe Bucșă. *Designul comunitar. Ghid*. București: Ed. OSIM, 2007

<sup>8</sup> Art. 5(2) of the Regulation

<sup>9</sup> Commission of the European Communities. Green Paper on the Legal Protection of Industrial Design: Working Document of the Services of the Commission, Brussels, 1991. parag. 5.5.1.3.

<sup>10</sup> Commission of the European Communities. Green Paper on the Legal Protection of Industrial Design: Working Document of the Services of the Commission, Brussels, 1991. parag. 5.5.5.4

points out the design rationale protection, which must be perceived as something different at the market level, where it plays its role in competition between products, and not at the more sophisticated level of the world of the experts.

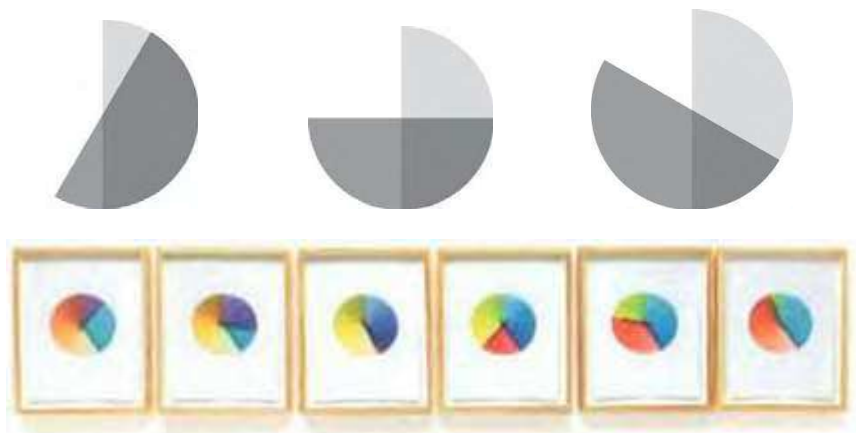
As regards the interpretation of the expression *immaterial details*, the Board of Appeal of the Office considered, that as the only difference is "a slight variation in the shade of the colour pattern in the contested design, this amounts to no more than a hardly noticeable difference in a detail"<sup>11</sup>

A recent decision of the OHIM Board of Appeal of 2 November 2010, in Case R 1086/2009-3, *Erich Kastenholtz*, concern a contested RCD registered for 'watch-dials' (represented below in grey scale). The invalidity applicant claimed that the RCD was not new since an identical design of a clock-face with the technique of overlapping coloured foils had been shown and published by an artist in exhibitions and catalogues between 2000-2005.

The board held that in the case of the RCD "the intensity of the colours does not change gradually with the change of time" and that, "by contrast, the clock-face of the earlier design is able to produce a wide spectrum of colours"

*The differentiating features mentioned have a significant impact on the overall impression produced by the two designs and lead to a different perception by the informed user. The contested RCD, therefore, possesses individual character.*

*The two designs are not identical. It is clear that novelty and individual character, although presented as separate requirements in Articles 4 to 6 CDR, overlap to some extent. Obviously, if two designs produce a different overall impression on the informed user, they cannot be identical for the purposes of Article 5 CDR.<sup>12</sup>*



It is considered that for establish novelty, the specific elements that confers the design its particular character should be taken into account, and not the general ones. A design should be considered new if its specific matter are different from the status quo of "the existing design corpus" (prior art).

The reference date for novelty is stated in article 7(a) of the Regulation no. 6/2002. A design shall be deemed to have been made available to the public if it has been published before the date on which the design for which protection is claimed *has first been made available to the public*<sup>13</sup> (in the

<sup>11</sup> OHIM, Decision of the Third Board of Appeal of 28 July 2009 In case R 921/2008-3 *Věra Šindelářová*. *Blažek Glass s r.o* (Nail files), parag. 25

<sup>12</sup> OHIM, DECISION of the Third Board of Appeal of 2 November 2010, In Case R 1086/2009-3, *Erich Kastenholtz v. qwatchme a/s* (Watch-dials), parag. 25-27

<sup>13</sup> Articles 5(1)(a) and 6(1)(a) of the Regulation

case of an unregistered Community design) or before *the date of filing of the application for registration* of the design for which protection is claimed, or, if priority is claimed, *the date of priority*<sup>14</sup>. Publication can be achieved as a result of registration, or exhibited, used in trade or otherwise disclosed<sup>15</sup>.

However, a design is not considered publicly disclosed where these events could not have become known in the normal course of business to the *circles specialized*<sup>16</sup> in the sector concerned, operating within the Community<sup>17</sup>. Sherman and Bently point out that this is a "safeguard clause" aimed at preventing a design from being unregistrable on the basis of prior obscure disclosures. The precise impact of this clause is difficult to predict, not at least because its wording presents a number of ambiguities<sup>18</sup>.

As regards the interpretation of this provision of the regulation, can be reported the decision of the British courts in the case *Green Lane Products v PMS International*<sup>19</sup>. The case concerned infringement of a Community Design, registered for products indicated as "flatirons and washing, cleaning and drying equipment" by Green Lane Products and the trial was on a preliminary point: namely, which disclosures constituted prior art. The question here was, which was the "sector concerned": the sector of the prior art (i.e. massage balls) or the sector of the design (i.e. laundry balls). The judge held that the design would be infringed whatever the product, so that the registration did not merely cover "flat irons and washing, cleaning and drying equipment", but any product whatsoever. The judge concluded that the "sector concerned" was the sector of the prior art.

The Hamburg District Court held, in the case *Gebäckpresse I*<sup>20</sup> that

*"an unregistered Community design acquires protection by being made available to the public for the first time within the territorial borders of the Community. A design registration of the same object published by the holder in a foreign country (China) prior to the disclosure of the unregistered Community design is not detrimental to novelty"*<sup>21</sup>.

Also is not considered to have been made available to the public a design that was disclosed only to a third party in explicit or implicit conditions of confidentiality. A disclosure shall not be taken into consideration for the purpose of applying Articles 5 and 6 and if a design for which protection is claimed under a registered Community design has been made available to the public by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer or his successor in title; and *during the 12-month period preceding the date of filing of the application or, if a priority is claimed, the date of priority*.

In the case *Gebäckpresse I*<sup>22</sup>, Hamburg District Court decided that:

*"The presentation of the design in the context of contractual negotiations is subject to confidentiality even without explicit agreement on this point, and therefore does not constitute a fact detrimental to novelty"*.

In the Case R 608/2009-3, *Reinhold Gerstenmeyer AB*, the Board of Appeal of the Office<sup>23</sup> stated that "since it has been established that the prior design, which is identical to the RCD, was

<sup>14</sup> Articles 5(1)(b) and 6(1)(b) of the Regulation

<sup>15</sup> OAPI, Decizia Camerei a treia de recurs din 26 martie 2010 in Cauza R 9/2008-3 *Crocs V. Holey Soles Holdings Ltd Inc*

<sup>16</sup> Commission of the European Communities. *Green Paper on the Legal Protection of Industrial Design: Working Document of the Services of the Commission*. Brussels, 1991. parag. 5.5.5.2 "the specialists, designers, merchants, and manufacturers operating in the sector concerned"

<sup>17</sup> *Green Paper*, parag. 5.5.5.2 "The circle of relevant persons is limited to those operating within the Community, but their knowledge is not subject to any territorial limitation"

<sup>18</sup> Bently, Lionel, and Brad Sherman. *Intellectual property law*. Oxford ; New York: Oxford University Press, 2004, pag. 629

<sup>19</sup> *Green Lane Products Ltd. v PMS International Group Plc*, Court of Appeal (UK), [2008] ECDR 15

<sup>20</sup> Landgericht Hamburg – *Gebäckpresse I*, Urteil vom 20. Mai 2005 – 308 O 182/04

<sup>21</sup> Hartwig, Henning. *Designschutz in Europa*. Köln ; München [u.a.]: Heymann, 2007, pag.243

<sup>22</sup> Landgericht Hamburg – *Gebäckpresse I*, Urteil vom 20. Mai 2005 – 308 O 182/04

disclosed in 2004 well before the 12-month period preceding the date of priority claimed of 7 December 2006”, “it is of no relevance who the designer of the prior design was”.

The rationale for the existence of this warranty clause is contained in the Preamble, which specified that the author should have the opportunity “to test the products embodying the design in the market place before deciding whether the protection resulting from a registered Community design is desirable”<sup>24</sup>.

The same applies if the design has been made public following *abusive conduct*<sup>25</sup> against the author or his successor in title. The characteristic of an *abusive* conduct is underlined by the OHIM Board of Appeal in the decision of 8<sup>th</sup> March 2010, in Case R 1775/2008-3, *European Citizen's Band Federation* where it concludes that

*The objection about the ineffectiveness of disclosure of the RCD under Article 7, paragraph 3, is unfounded. Disclosure is not the consequence of any abuse and does not, therefore, in this case described in paragraph 3 of Article 7 CDR*<sup>26</sup>.

### III. Individual character

Article 6(1) provides that “a design shall be considered to have *individual character* if the *overall impression* it produces *on the informed user* differs from the overall impression produced on such a user *by any design* which has been made available to the public”. It is specified that in assessing individual character, *the degree of freedom of the designer* in developing the design shall be taken into consideration<sup>27</sup>.

As explained in the preamble “the assessment as to whether a design has individual character should be based on whether the overall impression produced on an informed user viewing the design *clearly* differs from that produced on him by the existing design corpus, taking into consideration the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs and the degree of freedom of the designer in developing the design”.

Individual character is thus a difference in the overall impression on the informed user. Individual character seems to be more demanding than novelty as it refuses protection to overall *déjà vu*. In practice, individual character is likely to absorb novelty<sup>28</sup>.

The approach used to implement the trademark test of distinctiveness appears more appropriate than the patent approach, in view of the stated intention to protect the marketing functions of designs. In each case, the test is based on the reaction of the consumers to the design relative to the prior art, whereas the patent test of inventive step is based on a peer review approach by designers rather than consumers<sup>29</sup>.

<sup>23</sup> OHIM, DECISION of the Third Board of Appeal of 11 December 2009, In Case R 608/2009-3, Reinhold Gerstenmeyer AB v. B-NU Limited

<sup>24</sup> Point (20), preamble of the Regulation : “It is also necessary to allow the designer or his successor in title to test the products embodying the design in the market place before deciding whether the protection resulting from a registered Community design is desirable. To this end it is necessary to provide that disclosures of the design by the designer or his successor in title, or abusive disclosures during a period of 12 months prior to the date of the filing of the application for a registered Community design should not be prejudicial in assessing the novelty or the individual character of the design in question.

<sup>25</sup> Franzosi, Mario. *European design protection : commentary to directive and regulation proposals*. The Hague ; Boston: Kluwer Law International, 1996, pag.81

<sup>26</sup> OHIM, DECISIONE della Terza Commissione di ricorso del 8 marzo 2010 Nel procedimento R 1775/2008-3, EUROPEAN CITIZEN'S BAND FEDERATION (ECBF) contro European Citizen's Band Federation, parag. 58

<sup>27</sup> Article 6(2) of the Regulation

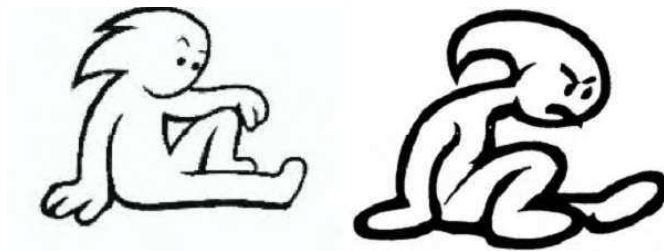
<sup>28</sup> Massa, Charles-Henry, and Alain Strowel. “Community Design: Cinderella revamped.” *EIPR* (2003): 68-78.

<sup>29</sup> Musker, David. *Community Design Law: Principles and Practice*. London: Sweet & Maxwell, 2002, pag. 29

The Office admitted<sup>30</sup> the existence of some criticism, expressed when the Community Design Regulation came into force, because it does not require a Community design to “clearly differ”<sup>31</sup> from the prior art in order to have individual character as a pre-requisite for protection. In fact, all it specifies is that the Community design produces a different overall impression on an informed user than any prior design.

In the case R 860/2007-3, *Wuxi Kipor vs. Honda Motor*, the Boards had to compare the subject matter of the contested Community design RCD 171178-0004 concerning inverter generators with a prior design. Despite the many differences between the two opposing designs, the Boards found that “the differences are not sufficient to affect the overall impression that the two designs produce on the informed user”, because “*the informed user* is more likely to be impressed by *the overall aspect* of the generator rather than *the various details* that characterise mechanical devices in general.” The Board held that, “according to the case-law of this Board, *the informed user is identified on the basis of the class of products* within which, according to the application for registration, the design itself is intended to be incorporated. (...) The informed user against whom individual character of the contested RCD should be measured is therefore whoever *habitually purchases* such an item and puts it to *its intended use* and has become *informed on the subject by browsing* through catalogues of such generators, visiting the relevant stores, downloading information from the internet”. The Board underlines that the two designs concern products having a high technical content and, consequently, “are products for which technical characteristics and safety considerations – ease of use, protection against hazards – are of such importance that the informed user’s overall impression of the aspect of the product is more likely to be *influenced by the general appearance* (arrangement of component parts, size, overall shape of components) *than by relatively immaterial details*”<sup>32</sup>

In its recent decision, from 16 December 2010, in Case T-513/09 *José Manuel Baena Grupo, SA v. OHIM*<sup>33</sup>, the European General Court considered a dispute against the validity of a registered Community design (RCD 426895-0002, on the left) brought on the basis of an earlier Community trade mark (CTM 1312651).



Whilst the Board of Appeal (and before it the cancellation division of OHIM) considered the registered design to be sufficiently close to the Community trade mark so as to decline individual character to the design, the General Court held that it did produce a different overall impression on the informed users and, therefore, that it did have the necessary individual character. As regards *the*

<sup>30</sup> Decision of the Third Board of Appeal of 17 April 2008, Case R 860/2007-3, *Wuxi Kipor Power Co., Ltd. vs. Honda Motor Co., Ltd.*

<sup>31</sup> The Office mentions that “during the drafting process of the CDR the term “clearly” has been deleted in the definition of individual character. The fact that it was forgotten to delete the term in the preamble of the Regulation has led to some confusion”

<sup>32</sup> Decision of the Third Board of Appeal of 17 April 2008, Case R 860/2007-3, *Wuxi Kipor Power Co., Ltd. vs. Honda Motor Co., Ltd.*, emphasis added

<sup>33</sup> Case T-513/09, Judgment of the General Court of 16 December 2010 - *Baena Grupo v OHIM* - Neuman and Galdeano del Sel (Seated figure)

identity of the informed user, the General Court considered it to be teenagers who were presumed to be the consumers of the T-shirts, stickers and other items for which the design was registered. The Court also emphasises the *different facial expressions* depicted in the two competing character designs and consider that

*In this case, it should be noted that the overall impression created by the two conflicting figures on the informed user is determined largely by the facial expression of each thereof.*<sup>34</sup>

It is, however, controversial the fact that the different facial impression is sufficient for considering the contested design as having individual character.

Bently and Sherman believe, however, that the elaborated definition of "individual character" does not demand a "personality" of its own of the design, and merely focuses on the difference of impression<sup>35</sup>.

This view was confirmed in case the national design courts. The Court of Appeal of Berlin, in the case *Sal de Ibiza*<sup>36</sup>, said that

*"contrary to section 1(2) German design act- former version-, there is no minimum 'particular individuality' required for the Community design. In particular, it does not necessarily have to demonstrate any aesthetic content. Therefore, a high degree of originality is not required. Primarily, distinctiveness is determining, not creativeness".*

As regards interpretation of the concept of "informed user", the Court held recently in *Shenzhen Taiden*<sup>37</sup> decision, issued on 22 June 2010 that

*"With regard to the interpretation of the concept of informed user, the status of 'user' implies that the person concerned uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended. The qualifier 'informed' suggests in addition that, without being a designer or a technical expert, the user knows the various designs which exist in the sector concerned, possesses a certain degree of knowledge with regard to the features which those designs normally include, and, as a result of his interest in the products concerned, shows a relatively high degree of attention when he uses them."*<sup>38</sup>

Competent national courts have had occasion to rule, before the above decision of the Court, on the interpretation of the term "informed user".

In the first case concerning the registered Community design that has come before the Court of Appeal in England and Wales, *Procter & Gamble Company v Reckitt Benckiser (UK) Ltd*<sup>39</sup>, Lord Justice Jacob, by decision of 10 October 2007, stated that "the informed user is not the same as the "average consumer"<sup>40</sup> of trade mark law"<sup>41</sup>, so "is alert to design issues and is better informed than

<sup>34</sup> Case T-513/09, 16 December 2010, Baena Grupo, parag. 21

<sup>35</sup> Bently, Lionel, and Brad Sherman. *Intellectual property law*. Oxford; New York: Oxford University Press, 2004, pag. 635

<sup>36</sup> Kammergericht Berlin – *Sal de Ibiza*, Beschluss vom 19. November 2004 – 5 W 170/04

<sup>37</sup> Case T-153/08, Judgment of the General Court of 22 June 2010 — *Shenzhen Taiden v OHIM — Bosch Security Systems* (Communications Equipment), *OJ C 209*, 31.7.2010, p. 34–34

<sup>38</sup> Case T-153/08, Judgment of the General Court of 22 June 2010 — *Shenzhen Taiden v OHIM — Bosch Security Systems* (Communications Equipment), *OJ C 209*, 31.7.2010, p. 34–34, parag. 46–47

<sup>39</sup> *Procter & Gamble Company v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936, comentat de Carboni, Anna. "Design validity and infringement: feel the difference." *European Intellectual Property Review* 30.3 (2008): 111–117

<sup>40</sup> For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96 *Gut Springenheide and Tuský* [1998] ECR I-4657, paragraph 31). However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.

<sup>41</sup> *Procter & Gamble Company v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936, parag. 24

the average consumer in trade mark law<sup>42</sup>. "The "informed user" will have more extensive knowledge than an "average consumer in possession of average information, awareness and understanding" in particular he will be open to design issues and will be fairly familiar with them".

In *Bailey & Anor v Haynes & Ors* the enquiry on the informed user focuses on "those having a practical interest in the use to which the *product* incorporating the design is to be put"<sup>43</sup>.

In its decision of 21 December 2007, the High Court of Ireland, in the case *Karen Millen Ltd. v Dunnes Stores & Anor*<sup>44</sup>, follows the decision *Procter & Gamble Company v. Reckitt Benckiser (UK) Ltd* (2007) and considers that the informed user is "an "end user" of the products to which the design relates", "is aware of similar designs which form part of the relevant design corpus", "he will be alert to design issues and better informed than the average consumer in trade mark law", "he must be considered to be familiar with the functional or technical requirements of the design or, perhaps more precisely, the product for which the design is intended", and "he is not considered to have extensive technical knowledge appropriate to a manufacturer of the product".

An additional factor in assessing the individual character is, under Article 6 (2) of Regulation no. 6/2002, *the degree of freedom of the designer* in developing the design. This provision must be considered in the context of the Preamble, which along with the degree of freedom of the designer in developing the design, evaluation takes into "consideration the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs"<sup>45</sup>.

The test of the "degree of freedom of the designer" indicates that where the possibility of differences is small, the smallest difference from the previous drawing will be sufficient to give an individual character<sup>46</sup>.

Court stated in its Judgement of 18 March 2010 in Case *Grupo Promer Mon Graphic* that in this respect,

*"it must be noted that the designer's degree of freedom in developing his design is established, inter alia, by the constraints of the features imposed by the technical function of the product or an element thereof, or by statutory requirements applicable to the product. Those constraints result in a standardisation of certain features, which will thus be common to the designs applied to the product concerned"*<sup>47</sup>.

Massa and Strowell notes that the requirement of individual character could be interpreted as "unconfessed original novelty" and that, in theory, there is no oxymoron in associating novelty and originality as both standards may perfectly well supplement each other. In law the conjunction "or" separating novelty and originality in article 25.1 of the TRIPs constitutes an insuperable obstacle to associate them<sup>48</sup>.

<sup>42</sup> Ibidem, parag. 28

<sup>43</sup> *Bailey & Anor v Haynes & Ors* [2006] EWPCC 5 (02 October 2006), Patents County Court (England and Wales), parag. 55

<sup>44</sup> *Karen Millen Ltd. v Dunnes Stores & Anor.* [2007] IEHC 449 (21 December 2007)

<sup>45</sup> Punctul (14), Preambul, Regulamentul (CE) nr. 6/2002

<sup>46</sup> Musker, David, op.cit, pag. 33

<sup>47</sup> Judgment of the General Court (Fifth Chamber) of 18 March 2010, *Grupo Promer Mon Graphic, SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-9/07, European Court reports 2010 Page 00000

<sup>48</sup> Pentru o discuție asupra art. 25 TRIPs, a se vedea: Reichman, Jerome H. (1995) *Universal Minimum Standards of Intellectual Property Protection under the TRIPs Component of the WTO Agreement*. International Lawyer, 29 . pp. 345-388, <http://eprints.law.duke.edu/687/>



#### IV. Visibility of the constitutive elements

Article 4(2) of the regulation provides that "a design applied to or incorporated in a product which constitutes a *component part of a complex product* shall only be considered to be new and to have individual character: if the component part, once it has been incorporated into the complex product, remains *visible* during *normal use* of the latter; and to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character"<sup>49</sup>.

As regards the visible character, OHIM Board of Appeal has ruled that

*"The Board concludes none the less that the requirements of Article 4(2)(a) CDR are satisfied. That provision does not require a component part to be clearly visible in its entirety at every moment of use. It is sufficient if the whole of the component can be seen some of the time in such a way that all its essential features can be apprehended."*<sup>50</sup>

"Normal use" shall mean use by the end user, excluding maintenance, servicing or repair.

Musker underlies that the notion of *normal use* could imply that even an attractive component, perhaps visible at point of purchase, can be denied protection if invisible in "normal use". The issue is apparently not whether the article is bought for its appearance, but whether it is used for its appearances<sup>51</sup>.

Issues covered in this article are particularly used parts"for the purpose of the repair of that complex product so as to restore its original appearance"<sup>52</sup>, the spare parts.

The debates that took (and still) occur in connection with the opportunity to protect spare parts forced the adoption of a temporary solution for the Community design protection. As stated in the preamble" (...) under these circumstances, it is appropriate *not to confer any protection* as a Community design for a design which is applied to or incorporated in a product which constitutes a component part of a complex product upon whose appearance the design is dependent and which is used for the purpose of the repair of a complex product so as to restore its original appearance, until the Council has decided its policy on this issue on the basis of a Commission proposal"<sup>53</sup>.

Regulation no. 6/2002 has, therefore, a transitional provision that "are not granted protection as a Community design to a design that is one part of a complex product, until a later date when is foreseen an amendment to the Regulation, on a Commission proposal. According to Regulation no. 6/2002<sup>54</sup>, the proposal from the Commission shall be submitted together with, and take into consideration, any changes which the Commission shall propose on the same subject pursuant to Article 18 of Directive 98/71/EC. In 2004, the Commission submitted a controversial<sup>55</sup> proposal<sup>56</sup> to amend Art. 14 of the Directive that excluded spare parts from design protection afforded by national legislation. To the extent that this proposal will be adopted, it will have a direct impact on the Regulation on Community design.

<sup>49</sup> Point (12) Preamble of the regulation" Protection should not be extended to those component parts which are not visible during normal use of a product, nor to those features of such part which are not visible when the part is mounted, or which would not, in themselves, fulfil the requirements as to novelty and individual character. Therefore, those features of design which are excluded from protection for these reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection".

<sup>50</sup> OHIM, DECISION of the Third Board of Appeal of 22 October 2009 in Case R 690/2007-3 Lindner Recyclingtech GmbH v. Franssons Verkstäder AB, parag. 21

<sup>51</sup> Musker, David. *Community Design Law: Principles and Practice*. London: Sweet & Maxwell, 2002, pag.24

<sup>52</sup> Article 110 (1) of the Regulation

<sup>53</sup> Point (13) Preamble of the Regulation

<sup>54</sup> Article 110(2) of the Regulation

<sup>55</sup> Straus, Joseph: Design Protection for Spare Parts Gone in Europe? Proposed Changes of the EC Directive: Commission's Mandate and its Doubtful Execution. in: EIPR, 2005, p. 391 - 404.

<sup>56</sup> Proposal for a Directive of the European Parliament and of the Council amending Directive 98/71/EC on the legal protection of designs, COM/2004/0582 final

## V. Products that cannot be protected

### 1. Public policy or morality

Article 9 of the regulation provides that "a Community design shall not subsist in a design which is contrary to public policy or to accepted principles of morality." This is similar to the corresponding provision of the Directive<sup>57</sup>. However, it raises different issues because the Directive does not impose a European level of morality, leaving this to the discretion of each state. Phillips believes that a design may be completely unacceptable in a Member State, although it could be considered a masterpiece in another state<sup>58</sup>.

As stressed by Musker, the importance of identifying this problem appears in the context in which, apart from the definition of design, it is the only basis for evaluating formal application for a registered Community design<sup>59</sup>. It is equally a ground for invalidity. It is possible that the protection should be refused if the design is contrary to public order and morality, in no more than in one Member State<sup>60</sup>. Examples brought are a swastika decorating a product or drawing of anti-personnel mines<sup>61</sup>.

Duvac and Romițan expressed the opinion that in case the community design should have a unitary character at European level, it is necessary that the notions of public order or morality to be cleared at EU level<sup>62</sup>.

### 2. Technical features

Article 8(1) of the Regulation provides that "a Community design shall not subsist in features of appearance of a product which are *solely dictated by its technical function*". To assess the area of exclusion, clarification is needed on the terms "*technical*" and "*solely dictated*". The following questions arise: how broad is "technical function" intended to be and how strict is the "solely dictated" link intended to be<sup>63</sup>.

This provision excludes from protection certain technical aspects. According to the declared legislative intent<sup>64</sup>, the purpose of regulation is to protect both functional and aesthetic designs. Apparently, this provision is contrary to this purpose. Paragraph (10) of the Preamble explains that the exclusion from protection is intended *not to hampered technological innovation* and that *this does not entail that a design must have an aesthetic quality*<sup>65</sup>.

<sup>57</sup> Art. 8, Directiva 98/71/CE

<sup>58</sup> Phillips în Franzosi, Mario. European design protection: commentary to directive and regulation proposals. The Hague ; Boston: Kluwer Law International, 1996, pag.52

<sup>59</sup> Musker, David, op.cit, pag. 104

<sup>60</sup> Massa, Charles-Henry și Strowel, Alain, *Community Design: Cinderella revamped*, 2003, EIPR, pag. 68-78, pag.72

<sup>61</sup> Commission of the European Communities. *Green Paper on the Legal Protection of Industrial Design: Working Document of the Services of the Commission*. Brussels., 1991. parag. 8.9.2.

<sup>62</sup> Romițan, Ciprian Paul, and Constantin Duvac. *Protectia juridico-penală a desenelor și modelelor*. București: Universul Juridic, 2009; for an in depth view of morality and public order in the protection of community design, pag 90-101.

<sup>63</sup> Massa, Charles-Henry și Strowel, Alain, *Community Design: Cinderella revamped*, 2003, EIPR, pag. 68-78, pag. 72

<sup>64</sup> Commission of the European Communities. *Green Paper on the Legal Protection of Industrial Design: Working Document of the Services of the Commission*. Brussels., 1991. Parag 5.4.4.2

<sup>65</sup> Paragraph (10) Preamble of the regulation "Technological innovation should not be hampered by granting design protection to features dictated solely by a technical function. It is understood that this does not entail that a design must have an aesthetic quality. Likewise, the interoperability of products of different makes should not be hindered by extending protection to the design of mechanical fittings. Consequently, those features of a design which are excluded from protection for those reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection."

As observes Bently and Sherman, the term "technical" is not clarified in the context of the Regulation on Community design, although it believes it has become a key concept of European patents law<sup>66</sup>. Although the functionality is a concept known in national law, each state has (had) different standards<sup>67</sup>.

The interpretation of Article 8(1) CDR (and of the corresponding provision in Article 7(1) of Council Directive 98/71/EC on the legal protection of designs) is highly controversial. One view holds that a technical necessity exception, such as that contained in Article 8(1) CDR applies only if the technical function cannot be achieved by any other configuration; if the designer has a choice between two or more configurations, the appearance of the product is not solely dictated by its technical function. That theory – known as the multiplicity-of-forms theory – is defended by some German authors<sup>68</sup> and was formerly followed by the French courts.

According to another view ("causal approach"), a design will be imposed by the function depending on whether it was created purely with functional intentions (even if the function could be satisfied through other forms).

Regarding the decisions of national courts, in *Landor & Hawa against Azure Designs*<sup>69</sup>, English Court of Appeal confirmed in the decision of 2006, that the design that serve a functional purpose may be protected under European Union legislation on industrial designs. Exclusions from protection on the grounds "dictated solely by technical function" and "method or principle of construction" must be interpreted restrictively so as not to unduly restrict the availability of protection to non-aesthetic designs. Under ancient law of Great Britain, established by interpretation of the decision *Amp against Utilux*<sup>70</sup> [1972], the exclusion was understood in an extensive way: "dictated solely by function" meaning "attributed to or caused by function".

The Court held, in *Landor & Hawa against Azure Designs* that decisions on the Directive on the Community trade mark cannot be safely relied on in a case involving the community design, invoking Advocate General Colmer, in *Philips v Remington*<sup>71</sup>:

*the level of functionality must be greater in order to be able to assess the ground for refusal in the context of designs; the feature concerned must not only be necessary but essential in order to achieve a particular technical result: form follows function.*

Recently, the Supreme Court of England and Wales decision, from 29 July 2010, *Dyson Ltd v Vax Ltd*<sup>72</sup>, returns to the interpretation given by the decision *Amp against Utilux*, in terms of understanding the concept of "solely dictated by technical function", distancing over the multiplicity

<sup>66</sup> Bently, Lionel, și Brad Sherman. *Intellectual property law*. Oxford ; New York: Oxford University Press, 2004, pag. 618

<sup>67</sup> Phillips în Franzosi, Mario. *European design protection : commentary to directive and regulation proposals*. The Hague ; Boston: Kluwer Law International, 1996, pag. 86

<sup>68</sup> Ruhl, Oliver, and Martin Schötelburg. "Gemeinschaftsgeschmacksmuster: Kommentar." Carl Heymanns Verlag, Köln-Berlin-München 2007, pag. 169, cited in OHIM, DECISION of the Third Board of Appeal of 22 October 2009 in Case R 690/2007-3 Lindner Recyclingtech GmbH v. Franssons Verkstädter AB, parag. 28

<sup>69</sup> *Landor & Hawa International Ltd v Azure Designs Ltd* [2006] EWCA Civ 1285; [2006]

<sup>70</sup> *Amp Inc v Utilux Pty Ltd* [1972] R.P.C. 103 (HL)

<sup>71</sup> Opinion of Mr Advocate General Ruiz-Jarabo Colomer delivered on 23 January 2001, *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd*. Case C-299/99, *European Court reports 2002 Page I-05475* "The wording used in the Designs Directive for expressing that ground for refusal does not entirely coincide with that used in the Trade Marks Directive. That discrepancy is not capricious. Whereas the former refuses to recognise external features which are solely dictated by its technical function, the latter excludes from its protection signs which consist exclusively of the shape of goods which is necessary to obtain a technical result. In other words, the level of functionality must be greater in order to be able to assess the ground for refusal in the context of designs; the feature concerned must not only be necessary but essential in order to achieve a particular technical result: form follows function. This means that a functional design may, none the less, be eligible for protection if it can be shown that the same technical function could be achieved by another different form".

<sup>72</sup> *Dyson Ltd v Vax Ltd* [2010] EWHC 1923 (Pat) (29 July 2010)

of forms theory. The court judgment was based on the decision of the Office of Harmonization in the Internal Market on 22 October 2009, in the case *Lindner Recyclingtech*<sup>73</sup>.

In this case, the Board of Appeal of the Office chose not to follow the Advocate General of the Court of Justice in *Philips v Remington* case or the decision of the UK Court of Appeal in the *Landor & Hawa against Azure* and the adoption of the multiplicity of forms theory supported by a large part of the doctrine, adopting instead *the designer's intention theory*. Thus, in the case *Lindner Recyclingtech against Franssons Verkstäder*, Office Board of Appeal stated that the drafting of Art. 8 (a) of Regulation 6/2002,

*"do not, on their natural meaning, imply that the feature in question must be the only means by which the product's technical function can be achieved. On the contrary, they imply that the need to achieve the product's technical function was the only relevant factor when the feature in question was selected."*<sup>74</sup>

According to article 8 of Regulation no. 6/2002, are the excluded from protection designs of interconnections. The argument presented is that interoperability should not be disturbed by products of different makes<sup>75</sup>.

Consequently,"a Community design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function"<sup>76</sup>. Article 8 of Regulation no. 6/2002 requires exclusion seemingly<sup>77</sup> committed to free market competition by encouraging interoperability of products of different makes<sup>78</sup>. It is considered that the main problem, however, is the automotive industry and automotive spare parts issue.

In article 8(3) of Regulation no. 6/2002 is foreseen an exception to exclusion of protection of interconnections products for modular products. Thus,"a Community design (...) shall subsist in a design serving the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system". The argument presented in the preamble is that"the mechanical fittings of modular products may nevertheless constitute an important element of the innovative characteristics of modular products and present a major marketing asset, and therefore should be eligible for protection".

This provision is similar to the "must-fit" exclusion of British law.<sup>79</sup> It is considered that the term refers to modular product type of LEGO<sup>80</sup> or Duplo. This provision is considered from a part of the doctrine as an exception to principles of free competition<sup>81</sup>.

<sup>73</sup> OHIM, DECISION of the Third Board of Appeal of 22 October 2009 in Case R 690/2007-3 Lindner Recyclingtech GmbH v. Franssons Verkstäder AB

<sup>74</sup> OHIM, DECISION of the Third Board of Appeal of 22 October 2009 in Case R 690/2007-3 Lindner Recyclingtech GmbH v. Franssons Verkstäder AB, parag 32

<sup>75</sup> Paragraph (10) Preamble of the Regulation , (...) Likewise, the interoperability of products of different makes should not be hindered by extending protection to the design of mechanical fittings. Consequently, those features of a design which are excluded from protection for those reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection.

<sup>76</sup> Article 8(2) of the Regulation

<sup>77</sup> Phillips in Franzosi, Mario. *European design protection: commentary to directive and regulation proposals*. The Hague; Boston: Kluwer Law International, 1996, pag. 88

<sup>78</sup> Case 53/87, Consorzio italiano della componentistica di ricambio per autoveicoli and Maxicar v Régie nationale des usines Renault, Judgment of the Court of 5 October 1988, European Court reports 1988 Page 06039

<sup>79</sup> *British Leyland Motor Corporation Ltd. v Armstrong Patents Ltd.* [1984] FSR 591.

<sup>80</sup> Case T-270/06 , Lego Juris A/S v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM, ) Judgment of the Court of First Instance (Eighth Chamber) of 12 November 2008, European Court reports 2008 Page II-03117

<sup>81</sup> Phillips in Franzosi, Mario, op. cit., pag. 88

## VI. CONCLUSIONS

The key concepts identified as structuring requirements for protection of the community design are: novelty, immaterial details, the existing design corpus (prior art), the sector concerned, the circles specialized, individual character, overall impression, the informed user, the degree of freedom of the designer, a component part of a complex product, to remain visible during normal use, technical features, solely dictated by technical function.

The paper illustrates for each of the terms above that there still are ambiguities and tensions in their understanding from the point of view of the Board of Appeal of OHIM and, more relevant, in the judgement of the competent national courts. As such, the unitary character of the community design is uncertain. This issue is even more significant as the reference is to the absolute grounds for invalidity. Moreover, the rules established by the Regulation 6/2002 seem to establish an exception to the general rule that national courts do not have jurisdiction to ascertain the invalidity of acts of an EU institution. A national court is competent to annul a design conferred by the Office for Harmonization in the Internal Market. Given that these decisions have a European wide effect, the demand for unitary interpretation is compulsory.

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