

THE INDIVIDUAL CHARACTER FOR DESIGN'S PROTECTION ACCORDING TO ROMANIAN LAW

Andreea LIVĂDARIU*

Abstract

The design means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation. A design shall be protected to the extent that it is new and has individual character.

How should be examined the individual character, who is the person to whom may be related the overall impression it produces a product, what are the features of the informed user? This are the topics of the paper below, according to Romanian designs law, European regulation and case laws.

Keywords: *designs, condition of protection, overall impression, experienced/informed user.*

1. Introduction

According to Law no. 129/1992 (art.2 letter d) – hereinafter referred to as the Legal Protection of Designs and Models Law, a design or a model means the appearance of the whole or a part of a product, shown in two or three dimensions, resulting from the main features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation. Considering the definition and the whole regulation of designs, we may ask ourselves why are so important the designs? How could influence our lives the registration the appearance of a product? Why would an entrepreneur chose to registrate the appearance of a product made by itself or by a person who concedes the copyright? Are such important the designs for everyday life, for our evolution?

The answer may be find in the decision of European Union to bring into force the Directive no. 98/71/EC on the legal protection of designs. The named directive had the purpose of cancelling the differences in the legal protection of designs offered by the legislation of the Member States, which were regarded as directly affecting the establishment and functioning of the internal market as regards goods embodying designs. According to Preamble, an uniform legislation was necessary to cancel the differences which could distort competition within the internal market.

Does Romania give the same importance to designs (and models)? From the point of view of the regulation, the answer may be „yes”. But not from the point of view of the awareness, too. The OSIM statistics¹ available for the period between 2003-2014 highlight that in 2003 were registrated in Romania 1.496 applications for 6616 designs/models (791 by non-residents and 705 by

residents), whereas în 2014 were registrated only 381 applications for 1171 designs/models (35 by non-residents and 346 by residents).

The alarmingly decline of the number of registrations should be an important and worrying sign which should have as result a strategy aimed to rise the awareness of the importance and the advantages of intellectual property in our lives.

2. The conditions of protection the designs and models according to Legal Protection of Designs and Models Law. The individual character.

The protection of a design or a model is given only if the object of application (registration) answers to the following requirements provided by law: **i)** the object of the registration, as appearance of the whole or a part of a product, is shown in two or three dimensions and results from the main features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentations new; **ii)** the object of the registration is new; **iii)** the object of the registration has an individual character; **iv)** the object of the registration should not be exclusively determined by a technical function; **v)** the object of the registration must not be contrary to public order and good manners.

Our intention is to examine the condition consisting in the individual character, according to art.6 para (4) and (5) of Legal Protection of Designs and Models Law, to art.24 para.(4) of the Regulation no.211/27.02.2008 for implementing the Legal Protection of Designs and Models Law, to European Court of Justice and Romanian courts case laws.

But first of all, we want to make an observation regarding the condition of not be contrary to public order and good manners. The national and European

* PhD Candidate, Faculty of Law, "Nicolae Titulescu" University of Bucharest (e-mail: andreea.livadariu@rvsa.ro).

¹ http://www.osim.ro/despre_noi/capitolul_statistici.php#

rulement didn't define the notions, but the European Court did when analysing trademarks contrary to public order and good manners. The **good manners** have been defined by the Court as being subjective values, which must be applied as objectively as possible by the examiner. Examples of contrary to the good manner designs or models would be the blasphemous, racist or discriminatory ones, but only if the meaning is clearly conveyed by the design or model in an unambiguous manner and the standard to be applied is that of an informed user with average sensitivity and tolerance thresholds.²

Coming back to the condition regarding the individual character of a design or a model, considering the interpretation of art.6 para (4) and (5) of Legal Protection of Designs and Models Law, to art.24 para.(4) of the Regulation no.211/27.02.2008 for implementing the Legal Protection of Designs and Models Law, we may see the following:

- the individual character exists only if the overall impression it produces on the experienced/informed user viewing the design/model clearly differs from the overall impression produced on such a user by any design/model which has been made available to the public before the date of filing of the application for registration or, if priority is claimed, the date of priority;

- when analysing the individual character, it must be taken into consideration the degree of freedom of the designer in developing the design/model;

- the analysis of the individual character is made by comparing the overall impression produced by the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation which define the aesthetic appearance.

In fact, what the law protects is not the product itself, but the appearance, the aesthetic feature made in two or three dimension. That is because the protection offered by law is a visual one, a protection of the exterior ornamentation which is attached to the product³.

3. The examination, in practice, of individual character. European Court of Justice Case-laws regarding the individual character. The Case T-68/11 Kastenzholz – Qwatchme - OHIM

As we have seen, the examination of individual character is made by detecting the overall impression produced on the experienced/informed user, and not by analysing each feature which creates the

appearance of the product. But in practice, a different overall impression on the informed user can be based only on the existence of objective differences between the designs at issue, differences which must therefore be sufficient to satisfy the requirement of novelty.

We must also, consider the directions given by the European Regulation on Community Design, according to which *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*⁴.

We may say that in practice, at this point, the individual character and the novelty are interacting. In fact, the European Court of Justice decided that the evaluation of the individual character of an European design or model shall be made in four steps (Case T-666/11, Budziewska/OHMI - Puma – Félin bondissant; Case T-9/07, Grupo Promer Mon Graphic v OHMI - PepsiCo – Représentation d'un support promotionnel circulaire):

Firstly, it is determined the field of the product (their nature) in which it is incorporated the design or the model;

Secondly, it is defined the informed user of the products determined in the first step, according to the nature, the field and the purpose of the product. Then it is determined, on the one hand, the level of knowledge in the field from which the products belong and, on the other hand, the level of attention when directly comparing the designs and models.

Thirdly, it is determined the degree of freedom of the designer in developing the design/model;

Forthly, it is determined the result of comparing the design/models, taking account the field in which are commercialized the products, the degree of the freedom of the designer in developing the design/model and the overall impression produced by the designs/models.

In the Case T-68/11 Kastenzholz, having to decide „the conflict” between a dial that changes continuously with the movement of the hands and in which each hand was fixed to a coloured, semi-transparent disc that generated different colours each time the hands were superposed and another one, claimed to not answer the novelty and individual character conditions, European Court of Justice decided as follows:

² Case T-417/10 form 09.03.2012 – “Que bueno ye! Hijoputa”, para 21 in *Guidelines for Examination in the Office for Harmonization in the Internal Market (Trademarks and Designs) on Community Trademarks*, version dated 01.08.2015, page 7.

³ Denis COHEN, *Le droit des dessins et modèles*, Editura Economica, Paris, 2009, p.2.

⁴ Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community designs.

„Contrary to what the applicant claims, the Board of Appeal did not take account of the difference in colour between the designs at issue for the purpose of assessing the individual character of the contested design. As stated in paragraph 49 above, the Board of Appeal based its assessment on the fact that, **in the case of the earlier designs, the graded sequence of the discs that compose [those designs] was able to produce a wide spectrum of colours, the combination and intensity of which changed with the time, whereas in the case of the contested design, only two uniform colours were displayed in the 12 o'clock and 6 o'clock positions or four colours in the positions for other hours with no variation in intensity.** The Board of Appeal's reasoning is thus based on the ability of the designs at issue to produce a more or less wide spectrum of colours, and a permanent change in tones, and not on the difference in colour between them.

Even if, as the applicant claims, the differences between the designs at issue could be regarded as slight, **they will easily be perceived by the informed user.** Further, when assessing whether a design has individual character, **account should be taken of 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** (Communications Equipment, paragraph 43). In the present case, concerning watch dials, parts of watch dials and hands of dials, **the view must be taken that they are intended to be worn visibly on the wrist and that the informed user will pay particular attention to their appearance.** Indeed, he will examine them closely and will therefore be able to see, as was stated in paragraph 56 above, that **the earlier designs produce a larger combination of colours than the contested design and, unlike the latter, a variation in the intensity of the colours.** Given the importance of the appearance of those products to the informed user, the differences, even if assumed to be slight, will not be regarded by him as being insignificant.”⁵

The Court decided, hence, that the differences mentioned above „had a significant impact on the overall impression produced by the designs at issue, so that they produce a different overall impression from the point of view of an informed user.”⁶

The European Court of Justice also defined the most important concepts used when observing the individual character of a design or model, which are the „informed user” and „freedom of the designer in developing the design/model”.

We won't find in Law no. 129/1992 a definition for the **informed user**, but we will find one by examining the judgements of European Court of Justice according to which an informed user is a combination between the “average consumer” related to trademarks (meaning the consumer who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparison between marks and must instead rely upon the imperfect picture of them) and that of an expert, a specialist who has thorough technical knowledge. So, the informed user may be understood as being an user who has not an average attention, but a specific awareness due to either his personal experience or knowledge in the field.⁷

So, the informed user, as defined above, will make a direct comparison of the designs or models with a special attention, even though he does not have specific technical background.

At the same time, the informed user with the meaning of article no. 6 (2) from Legal Protection of Designs and Models Law and with the meaning of article 6 of Regulation No 6/2002, „**does not refer to either a manufacturer or a seller of the product in which the design concerned is intended to be incorporated or to which it is intended to be applied. The informed user is a person who is particularly observant and has some awareness of the state of the prior art, that is to say, the previous designs relating to the product in question that had been disclosed on the date of filing of the design concerned**”⁸.

The **freedom of the designer in developing the design/model** is defined by referring to the technical function of the product or to the technical function of a part of the product or to the instructions of the product. Referring to the freedom of the designer, The European Court of Justice said that, in fact, the limits of the freedom prone to standardize some characteristics which become common to the designs and the models belonging to a field.⁹

In the same Case T-68/11 *Kastenholz*, the European Court said that „*the degree of freedom of the designer was limited only by the need to track and display the changing hours.*”

Therefore, European Court decided in the Case *Antrax It Srl against OHIM and The Heating Company relative to designs for thermosiphons which were intended to be applied to 'radiators for heating'* (Class 23.03 of the Locarno Agreement Establishing an International Classification for Industrial Designs of 8 October

⁵ Case T-68/11 from 6.06.2013 *Kastenholz – Qwatchme – OHIM*, points 61-62.

⁶ Case T-68/11 from 6.06.2013 *Kastenholz – Qwatchme – OHIM*, point 63.

⁷ Case T-9/07 from 20.10.2011, *Grupo Promer Mon Graphic v OHMI - PepsiCo – Représentation d'un support promotionnel circulaire*, point 53.

⁸ Cases T-83/11 and T-84/11 from 13.11.2012, *Antrax It Srl – OHIM - The Heating Company (THC)*, point no. 36.

⁹ Case T-11/08 from 9.09.2011, *Kwang Yang Motor v OHMI - Honda Giken Kogyo – Moteur à combustion interne avec ventilateur sur le dessus*, point 32.

1968) that „the greater the designer’s freedom in developing a design, the less likely it is that minor differences between the designs being compared will be sufficient to produce a different overall impression on an informed user. Conversely, the more the designer’s freedom in developing a design is restricted, the more likely it is that minor differences between the designs being compared will be sufficient to produce a different overall impression on an informed user. Therefore, if the designer enjoys a high degree of freedom in developing a design, that reinforces the conclusion that the designs being compared which do not have significant differences produce the same overall impression on an informed user”.¹⁰

4. Conclusions

We all agree that, as it is said in the Preamble of Council Regulation (EC) no. 6/2002 on Community designs, the protection of a design or a model 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”.

That is why the protection of a design or a model is given only if the appearance of the whole or a part of a product, is shown in two or three dimensions and results from the main features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentations; if it is new, has an individual character, is not exclusively determined by a technical function and is not contrary to public order and good manners.

And when the conditions for protection are satisfied, there is no reason not to protect the design or the model, because an enhanced protection for this field of intellectual property not only promotes the contribution of individual designers to the intellectual patrimony, but also encourages innovation, excellence, development of new products, investment in production and, finally, in the economy.

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- www.osim.ro

¹⁰ Cases T-83/11 and T-84/11 from 13.11.2012, Antrax It Srl – OHIM - The Heating Company (THC), point no. 45.