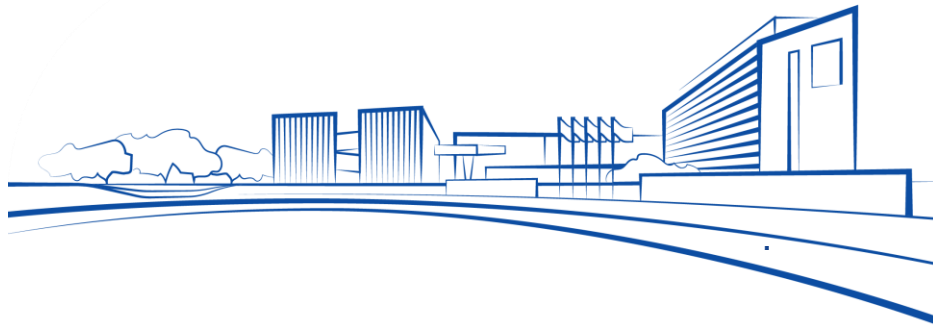


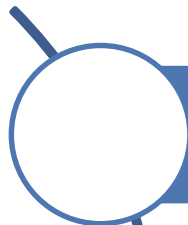
Recent EU case law on designs and update on Design Legal Reform

Alexandra Kusturovic
Boards of Appeal Head of Cabinet, EUIPO

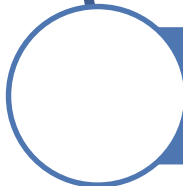
25 October 2024
ERA Conference



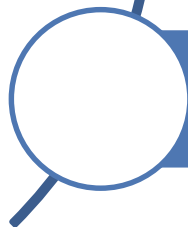
Summary



GC judgments



Key BoA decisions



Highlights on the DLR

Recent GC judgments

15/03/2023, T-89/22, Chairs, EU:T:2023:132 (R0837/2020-3)

Evidence of disclosure

Extract from the German Amazon platform

- ID: Application for declaration of invalidity rejected
- BoA: Annulled ID decision, RCD declared invalid for lack of individual character
- GC: Annulled BoA decision
- BoA: Dismissed the appeal

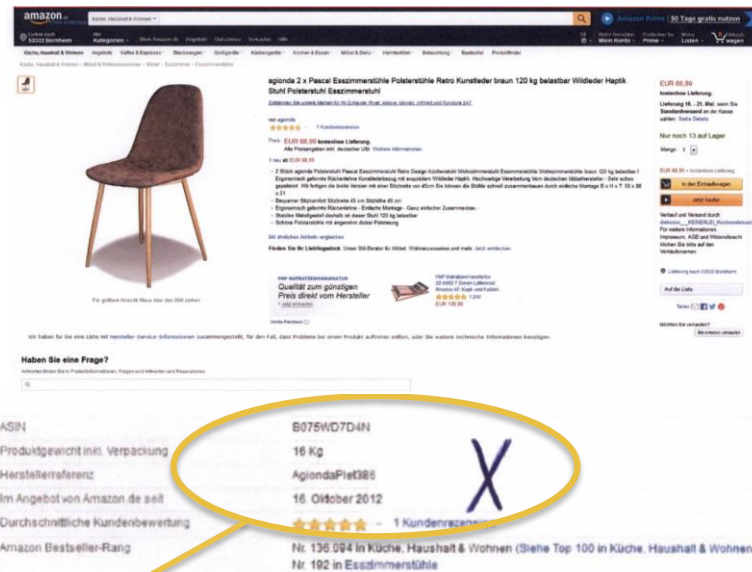


RCD

vs



Prior design



ASIN number &
First Availability date

15/03/2023, T-89/22, Chairs, EU:T:2023:132 (R0837/2020-3)

General Court judgment (on disclosure):

- The ASIN number is unique and assigned to each item offered for the first time in Amazon
§ 37
- Abstract possibility of manipulation is insufficient to undermine the credibility of the Amazon extract § 40
- The single user's review does not does not necessarily imply low reliability for the Amazon extract § 41

06/03/2024, T-647/22, Shoes, EU:T:2024:147 (R0726/2021-3)

Evidence of disclosure

- Three Instagram posts from Rihanna's account
- Several articles reproducing these posts

- ID: Disclosure proven, RCD lacked individual character
- BoA: Dismissed the appeal

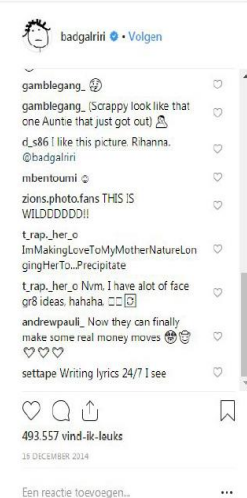


VS



RCD

Prior design



06/03/2024, T-647/22, Shoes, EU:T:2024:147 (R0726/2021-3)

BoA reasoning:

- Posts included : source ✓ prior design ✓ date ✓ ➡ The display of a picture on the internet constitutes a disclosure event § 37
- The disclosure of the prior design as shown in the Instagram posts was further supported by numerous articles from independent sources. These publications constitute disclosure events in themselves § 38-39
- DH disputes quality (§ 40), credibility (§ 41), as well as that these events of disclosure could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned operating within the EU (§ 43)

06/03/2024, T-647/22, Shoes, EU:T:2024:147 (R0726/2021-3)

GC: dismissed the action

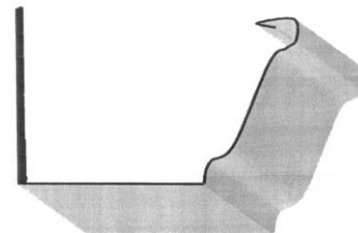
- The alleged existence of bad faith, of a possible infringement of a contractual obligation by the invalidity applicant or of the alleged abusive character of the invalidity application is irrelevant § 15.
- The photos posted on Instagram are of sufficient quality to allow all the features of the prior design to be recognized § 46. In addition, it is common knowledge that a photo shown on Instagram could be zoomed in on § 51.
- Simply on account of the [well-known] fact that Rihanna was a world-famous pop star, both her fans and the circles specialised in the fashion sector developed a particular interest in the shoes that she wore on the day she became the RCD holder's creative director § 53. This photograph is, in itself, a disclosure event § 60.

03/07/2024, T-329/22 Bajantes para la recogida de aguas; canalones (R1122/2021-3)

Evidence of disclosure: price catalogues dated April 2004

The Invalidity Division: Sufficient proof of disclosure (use in trade).

The Board of Appeal: decision confirmed. Indication of prices for April 2004 pre-date the filing of the contested design. It is sufficient that the disclosure has taken place at a time that can be identified with reasonable certainty as being prior to the filing or priority date of the contested design (§ 22).



No arguments from the design holder to demonstrate that the design would not reasonably have known to the relevant circles in the EU.

Appeal to the GC: price catalogues do not provide any precise and complete information on the exact date of the alleged disclosure.

03/07/2024, T-329/22 Bajantes para la recogida de aguas; canalones (R1122/2021-3)

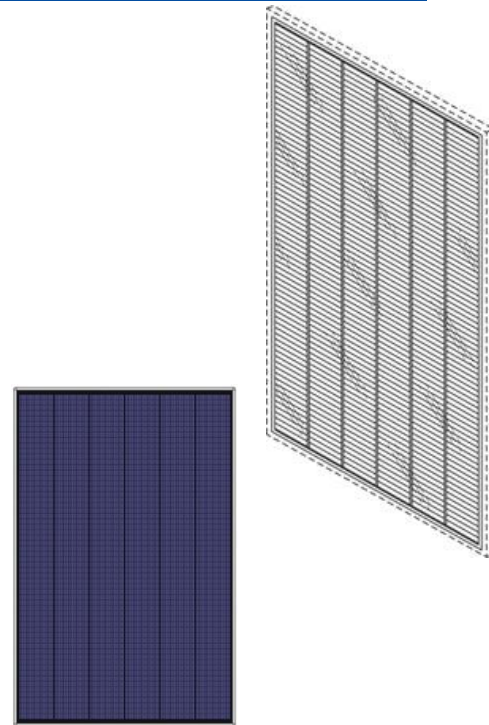
The General Court: decision confirmed:

- The price catalogues have been published by a third party (§ 26) and disclosed to the public since the invalidity applicant could produce them (§ 30).
- The price catalogues contain **all relevant information**: image of the prior design, and the indication ‘April 2004’ on their cover page, which establishes that they pre-date 17 June 2005 (§ 29).
- It is sufficient that the disclosure took place at **a time which can be identified with reasonable certainty as being prior** to the filing date or priority date of the contested design, even if the exact date of disclosure is not known (§ 31).
- There is no presumption of validity of a registered Community design in invalidity proceedings, but only in infringement proceedings (§ 38).

10/04/2024, T-62/23 & T-63/23, Solar panels (part of-), EU:T:2024:225 (R1588/2021-3 & R1589/2021-3)

Ø Facts :

- o The contested design was registered for 'Solar panels (part of-).
- o The application for a declaration of invalidity was based on Article 25(1)(b) CDR in conjunction with Articles 5, 6 CDR (lack of novelty and individual character) and 8 CDR (technical function).
- o The Invalidity Division upheld the application for a declaration of invalidity on that the contested design was devoid of individual character.
- o The BoA confirmed ID decision:
 - ✓ the outer frame of the contested design, represented in broken lines, is disclaimed so it cannot be taken into account for the purposes of assessing the individual character of that design;
 - ✓ The point of reference is the contested design; consequently the outer frame and the colours in the prior design cannot be taken into account.



10/04/2024, T-62/23 & T-63/23, Solar panels (part of-), EU:T:2024:225 (R1588/2021-3 & R1589/2021-3)

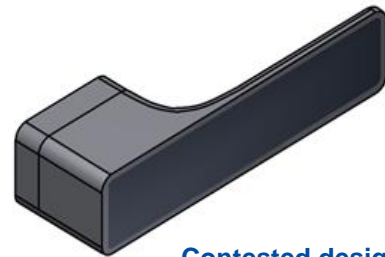
The General Court: decision confirmed:

- Experts and specialists in the relevant field are excluded from the definition of the informed user § 34-35.
- When the concept of informed user includes several groups of people, the fact that one of those groups perceives the designs at issue as producing the same overall impression is sufficient for a finding that the contested design lacks individual character § 36.
- Since the contested design is registered in black and white, any colour used in the earlier design is not relevant for the purpose of their comparison, given that no colour has been claimed for the contested design § 41.
- The fact that the upper and lower parts of the designs at issue are distinguished either by a thickening of the inner frame or by the presence of 'bars' and that they represent rectangles whose proportions are not perfectly identical is not sufficient to confer individual character to the contested design § 48.

10/04/2024, T-654/22, Door and window handles, EU:T:2024:223 (R0029/2022-3)

BoA reasoning:

- The contested design is to be applied to door handles. The informed user the informed user is whoever habitually purchases door handles, puts them to its intended use § 21.
- The freedom of the designer when developing door handles is restricted insofar as this must have an operating mechanism, a grip, and be able to be mounted onto a door. However the designer has a high degree of freedom § 25, 26.
- Both designs show a door handle consisting of a lever in a flat, rectangular shape, a grip in a cuboid shape and a thin profile. The differences are limited to the curvity of the edges and the shape of the neck (transition between the lever and grip) which, however, are insufficient to cause distinct overall impressions on the informed user § 32.



Contested design



Earlier design

10/04/2024, T-654/22, Door and window handles, EU:T:2024:223 (R0029/2022-3)

The General Court: decision annulled

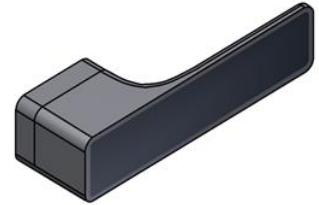
- The concept of ‘informed user’ does not refer to a professional quality linked to the product concerned. Furthermore, the informed user is neither an expert nor a specialist, such as a sectoral expert § 27.
- the Board of Appeal’s assessment is consistent with the case-law of the Court according to which the degree of freedom of the designer of a door handle with a grip is high, on account of the fact that that handle can be made in a significant variety of shapes, colours and materials § 35.
- The differences are sufficiently significant to produce a different overall impression of the designs at issue § 59.



- The overall impression produced on the informed user by a design must necessarily be determined in the light of the manner in which the product in question is normally used § 49 and on the ease to use the product § 50

cf. 04/02/2014, T-339/12, Armchairs, EU:T:2014:54, § 26, 30

- The differences in the angles of the grip and the neck are neither marginal nor minor variations of one and the same design. A more rounded shape generally results in a softening of the lines of the neck and grip, which has a significant effect both on the **overall appearance** and on the **ease of use** of the door handle. It is therefore an element which attracts the informed user's attention. § 58.



Contested design



Earlier design

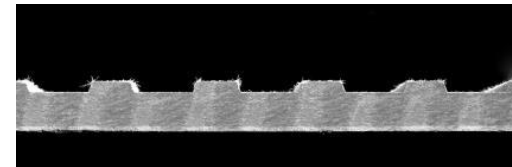
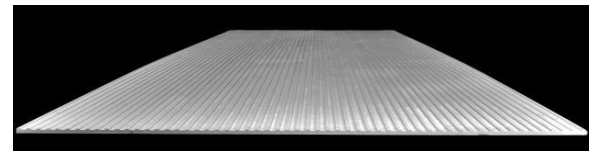
Key BoA decisions

05/02/2020, R 1661/2018-3, Panels

BoA reasoning:

- Products: building panels used by the construction industry.
- Informed user: a professional in the construction industry with a relatively high degree of attention.
- Freedom of the designer: considerable degree of freedom with regard to surface types, forms, colours and patterns.
- Overall impression: both designs show a panel characterised by the same shape and arrangement of its parts, namely a flat linear, striped surface containing multiple parallel ridges and valleys. The minor differences do not suffice to create a different overall impression.

Therefore, the contested design lacks individual character within the meaning of Article 6 CDR.



Contested design

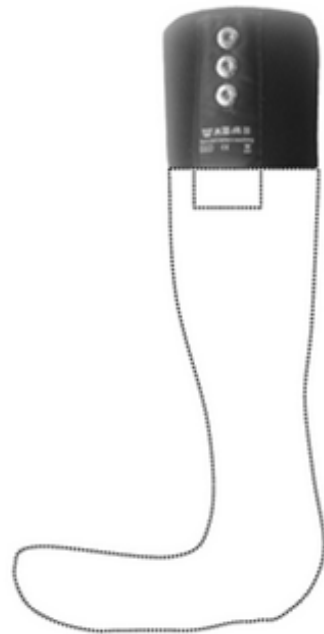


Earlier design

17/02/2023, R 878/2022-3, Strümpfe [heating sock]

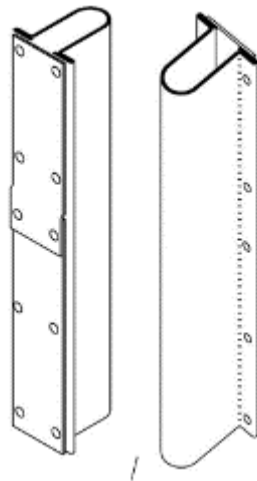
BoA reasoning:

- Component part of complex product / Article 4(2) CDR: the invalidity applicant did not show that all features of the contested RCD are invisible during 'normal use' (16/02/2023, C-472/21, Monz, EU:C:2023:105).
- Technical function / Article 8(1) CDR: the mere existence of a patent is not sufficient to prove that exclusively technical and no aesthetic considerations were taken into account. The patent's claims do not show that the number (two or three) and arrangement (vertical) of the press stud eyelets as well as the concrete design of the rectangular fabric part on the sock fabric (size, shape) would be exclusively dictated by the technical function (to warm the feet).
- Interconnections / Article 8(2) CDR: it was not demonstrated that the other features of appearance of the design fall under this provision.



12/06/2023, R 2068/2019-3, Posts (remittal after 19/10/2022, T-231/21, Posts, EU:T:2022:649)

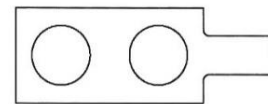
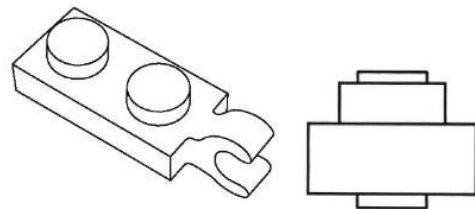
- 55 From the overall analysis of the evidence provided, and, therefore, from the objective circumstances relevant to the present case, and, in particular, from the expert opinions, the existence of alternative designs, and the fact that the product concerned is visible to the public and is very large, it is apparent that two of the three features of appearance of the product concerned, namely, the flange and open channel and the ‘U-shaped profile’, were not solely dictated by the technical function of that product and that the visual aspect of the product concerned was taken into account by its designer (19/10/2022, T-231/21, Posts, EU:T:2022:649, § 49 to 54).
- 56 It follows from all of the foregoing that the invalidity applicant failed to prove that all the features of appearance of the contested design had been solely dictated by the technical function of the product concerned.
- 57 The fact that not all the features of the contested RCD are purely technical is sufficient to rule out the application of Article 8(1) CDR.



25/09/2024, R 0162/2023-3, Building blocks from a toy building set

BoA reasoning:

- The designs coincide in a plate with a cylindrical solid stud on its upper side, smooth surfaces and a crescent-shaped clamp placed at the centre of and perpendicular to the end wall.
- The designs produce similar overall impressions.
- The additional stud in the contested RCD will be perceived as a mere repetition of the identical stud already present in the prior design.
- The difference in the relief forming the verbal element 'LEGO' in the prior design, will be perceived by the informed user as a trade mark and, therefore, will not pay particular attention to this feature in the overall impression.



Contested design



Earlier design

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<https://www.euipo.europa.eu/fr/boards-of-appeal/publications>

Absolute Grounds

Relative Grounds

Designs

Procedure and Registry

Title of procedure ↑	Date	Languages
Assessment of individual character (Article 6 CDR)	2024 May	EN
Designer's degree of freedom (Article 6(2) CDR)	2023 June	EN ES DE FR IT
Identification of the features of a design under Article 8(1) CDR	2022 January	EN ES DE FR IT
Identification of the product	2022 October	EN ES DE FR IT
Proof of a technical function of a design under Article 8(1) CDR	2022 January	EN ES DE FR IT
The informed user (Article 6(1) CDR)	2023 March	EN ES DE FR IT

Highlights on DLR

State of play

- Compromise texts published on December 2023
- Final texts adopted by Parliament (September 2024) and Council (October 2024)
- Next step: publication and entry into force (mid November - TBC)
- Applicability date: + 4 months (Phase I)
+ 36 months (Phase II)
- Update of the Boards of Appeal Rules of proceedings

TERMINOLOGY

- 'Community design' - - - - - ➔ 'European Union design' ('EU design')
- 'Community design court' - - - - ➔ 'EU design court'
- The Office - - - - - ➔ 'The European Union Intellectual Property Office'
- The Community Design Regulation ➔ 'The European Union Design Regulation ('EUDR')'

DEFINITIONS AND OBJECT OF DESIGN PROTECTION

- **Design definition** broadened to explicitly state that animation, transition and movement are protected
- **Product definition** tailored to allow for non-physical design protection and broadened to explicitly mention certain product examples (sets of articles, spatial arrangements of items intended to form an interior or exterior environment, and parts intended to be assembled into a complex product, as well as graphic works or symbols, logos, surface patterns and graphical user interfaces)
- **Object of protection** defined by the features of appearance which are shown visibly in the application for registration

EXCLUSIVE RIGHTS

- The scope of **exclusive rights expanded** to allow the design holder to:
 - stop counterfeited products **transiting through EU territory** or being placed in another **customs situation**
 - act against the **abuse of 3D printing** when distributing the recorded design to others in any medium
- Exhaustion of rights concept is now limited to the **European Economic Area** rather than the European Union
- **Design symbol:** a design notice consists of a letter D in a closed circle



SPARE PARTS

Transitional repair clause converted into a **permanent provision**

'Repair clause' make **design rights unenforceable** where the design of the component part of a complex product is used for the purpose of the **repair** of a complex product **to restore its original appearance**

Manufacturers and sellers will have the following obligations:

- **to duly inform consumers** about the commercial origin, and the identity of the manufacturer
- **to ensure that these parts are used for repair, but no guarantee** that this is the case



FILING AND EXAMINATION

- **Abolishment of filings via the national offices** - All EU Design Applications to be filed **directly at the EUIPO**
- **Filing date and formal requirements**
 - ❑ The **payment of the application fees** becomes a **filing date** requirement
 - ❑ The application fees must be paid within one month of filing instead of together with the application
 - ❑ The applicant's right to indicate a **Locarno subclass** is formalised
 - ❑ The possibility of submitting a specimen is eliminated
- **Multiple applications**
 - ❑ **Unity-of-class** requirement is abolished
 - ❑ The number of designs in a multiple application is limited to 50
- **Deferment of publication** – must be explicit

FEE LEVELS AND STRUCTURE

	Old fee		New fee
Registration	EUR 230	Application	EUR 350
Publication	EUR 120		none
Multiple applications		Multiple applications	
Registration (mult.) 2nd to 10th design 11th design onwards	EUR 115 EUR 50	Additional application fee in respect of each additional design included in a multiple application	EUR 125
Publication (mult.) 2nd to 10th design 11th design onwards	EUR 60 EUR 30	Deleted	
Additional fee for deferment of publication (mult.): 2nd to 10th design 11th design onwards	EUR 20 EUR 10	Additional fee for deferment of publication (mult.):	EUR 20
Fee for deferment of publication	EUR 40	Fee for deferment of publication	EUR 40

	Old fee		New fee
Renewal fee per design, included or not in a multiple registration 1st renewal 2nd renewal 3rd renewal 4th renewal Fee for the late payment of the renewal fee or the late submission of the request for renewal	EUR 90 per design EUR 120 per design EUR 150 per design EUR 180 per design 25 % of the renewal fees	Renewal fee: 1st renewal 2nd renewal 3rd renewal 4th renewal Fee for late payment of the renewal fee	EUR 150 per design EUR 250 per design EUR 400 per design EUR 700 per design 25 % of the renewal fee
International Registration Individual designation fee for an international registration Individual renewal fee for an international registration 1st renewal 2nd renewal 3rd renewal 4th renewal	EUR 62 per design EUR 31 per design EUR 31 per design EUR 31 per design EUR 31 per design	Individual designation fee for an international registration Individual renewal fee for an international registration 1st renewal 2nd renewal 3rd renewal 4th renewal	EUR 62 per design EUR 62 per design EUR 62 per design EUR 62 per design EUR 62 per design

	Old fee		New fee
Fee for the application for a declaration of invalidity	EUR 350	Fee for the application for a declaration of invalidity	EUR 320
N/A	N/A	Fee for continuation of proceedings	EUR 400
Appeal fee	800 EUR	Appeal fee	EUR 720
Fee for the registration of a licence or another right for a registered Community design: Grant of a licence Transfer of a licence Creation of a right in rem Transfer of a right in rem Levy of execution (*) subject to a maximum of EUR 1000 if multiple requests are submitted in the same application for registration of the transfer or simultaneously	EUR 200 EUR 200 EUR 200 EUR 200 EUR 200	Fee for the registration of a licence or another right in respect of a registered EU design referred to: Grant of a licence Transfer of a licence Creation of a right in rem Transfer of a right in rem Levy of execution (*) up to a maximum of EUR 1000 where multiple requests are submitted in the same application for registration of a licence or another right or at the same time.	EUR 200 EUR 200 EUR 200 EUR 200 EUR 200

27/02/2024, C 382/21 P, Turn- oder Sportgeräte und -artikel, EU:C:2023:576

Annulled judgment 14/04/2021, T 579/19, Turn- oder Sportgeräte und -artikel, EU:T:2021:186

- The right of priority to file an application for an RCD is governed by Article 41 CDR, without economic operators being able to rely directly on Article 4 of the Paris Convention § 69.
- An international application filed under the PCT can form the basis of a right of priority, pursuant to Article 41(1) CDR, solely provided that firstly (i) the subject of the international application in question is a utility model and, secondly (ii) the time period in which to claim that right on the basis of such an application is that of **six months** § 78.

Preliminary ruling: 16/02/2023, C-472/21, Monz Handelsgesellschaft International, EU:C:2023:105

Interpretation of Article 3(3) and (4) CDR / component parts of complex products

- The visibility of a component part of a complex product during its 'normal use' by the **end user** must be assessed from the perspective of that user as well as from the perspective of an **external observer**.
- The '**normal use**' must cover acts performed during the principal use of a complex product as well as acts which must customarily be carried out by the end user [e.g. storage, transportation], with the exception of maintenance, servicing and repair work.



Contested design

Preliminary ruling: 28/10/2021, C-123/20, Ferrari SpA, EU:C:2021:889

Disclosure of an unregistered design for a component part of a complex product

- The conditions for protection of a Community design, whether registered or not, namely novelty and individual character, within the meaning of Articles 4 to 6 CDR are the same for products and parts of a product § 33.
- The part of the product or component part of the complex product at issue must be visible and defined by features which constitute its particular appearance, namely by particular lines, contours, colours, shapes and texture. That presupposes that the appearance of that part of the product or that component part of a complex product is capable, in itself, of producing an overall impression and cannot be completely lost in the product as a whole § 50.





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