

# **INTRODUCTION TO INTELLECTUAL PROPERTY RIGHTS IN THE EU**

**IOANNA MAMALI JUDGE AT THE COURT OF  
APPEAL OF PIRAEUS**

# What IP is about

- **The IP system is very broad.** It covers **industrial property** (patents, designs, trademarks, etc.), **copyright and related rights**, **personality rights**, **rights to a business name**, **database rights**, **plant variety rights** and **trade secret** (know-how)
- **The principle of IP rights** stipulates that the author, in return for disclosing the essence of his solution, is granted a monopoly e.g. on its production, which will help him obtain specific financial gains. The public, for its part, may use the protected innovation, as it surely contributes to technical progress and serves the needs of society.
- **Exclusive rights are very often cumulated.** One product may include technical solutions in the form of inventions protected by patents, whose market power is reinforced by a trademark, that is well known and appreciated by consumers, and by the utility and aesthetics of the product achieved through modern industrial design. This increases the market value of the product.
- **Example** The solutions adopted in a mobile phone may be patented as inventions. The view of the main screen may be registered as a design, and the name of the company that produced the phone is a trademark. Discovering all functions and the ability to smoothly use the device constitutes a specific know-how of its user, while the instruction accompanying the phone may be a work subject to copyright protection.

# IP RIGHTS

## A LONG, BUT EXHAUSTIVE, LIST

- **Patents;** technical inventions, patentable if they are characterized by novelty, inventive step and industrial applicability, protection up to 20 years
- **Utility models;** minor invention relating to 3D objects, must be new and utile, doesn't have to involve inventive step, protection up to 10 years
- **Trademarks;** brand names and other identifications of products or services (product identifiers), protection up to 10 years, with possible extension for further 10 year-periods
- **Non registered marks** including **company names;** these are similar to trademarks, save that they are not registered in a certain registry (product identifiers)

- **Designs;** aesthetic features of products, like the surface design of clothing, protection up to 25 years
- **Copyright;** rights relating to literary and artistic work, music, software, films, etc.
- Special quasi copyright rights over **software** and **data bases**
- **Supplementary Protection Certificates;** special IP rights relating to pharmaceutical inventions

- **Special IP Rights over Semiconductor Topography Designs**
- **Plant Varieties**; special IP rights over plant hybrids
- **Protected Geographical Indications and Protected Appellations of Origin**; quasi IP rights over names of alcoholic or agricultural products and names of places where such products are produced; i.e. Champagne
- **Trade secrets** know-how

# Types of legal protection (quasi legal monopoly)

## Patents, Copyright:

Legal protection against unauthorized use, copying, imitating, etc., in the course of trade.

## Trademarks:

Legal protection against:

- Likelihood of confusion / association,
- Likelihood of dilution (free riding on reputation),
- Deception

# Characteristics of IP Rights

- **Intangible rights;** the subject matter of the right is an intangible asset;
- **Exclusive rights;** the owner is entitled to prohibit third parties from commercially exploiting the subject matter of the right; so IP rights grant a legal monopoly.

- **Territorial rights; Territoriality principle.** IP Rights are obtained in each jurisdiction separately. The same subject matter (i.e. the same patent or trademark) may be protected in more jurisdictions simultaneously, but the IP Right in each jurisdiction is distinct and separate.

*(with the exception of Copyright)*

- Hence IP Rights are usually difficult and costly to be obtained and maintained. You need to take action in each jurisdiction separately.

- **Priority in terms of time prevails; Priority principle.** In case of many IP Rights with the same subject matter usually the one that precedes the other in terms of time prevails.
- So, if one party obtains a patent over a production method, other parties who may have possibly developed the same production method independently cannot obtain a patent.

- **Registration and Disclosure.** In most cases IPRs are obtained by way of registration in a public registry; registration inevitably results to disclosure.
- Disclosure is important in connection to technical inventions (patents).
- Disclosure is established in favor of third parties.
- Third parties are entitled to rely on what is recorded in a public registry.

**Intellectual property is a term used to describe the field of law dealing with the commercial exploitation of applications of ideas.**

**Only specific applications of ideas are the subject matter of protection, not ideas as such.**

**Ideas are free to be exploited by anybody (public domain). It is the specific application of ideas which is the subject matter of legal protection.**

## Three basic distinctions

Applications of ideas – ideas  
Intellectual property – public domain  
Exclusive rights – free competition

- IP rights are **exclusive rights** over the exploitation of applications of ideas
- IP rights are **negative rights**: rights to prohibit other from exploiting certain applications of ideas

## **FREE COMPETITION**

**Freedom to make use and commercially exploit (freedom to copy) for profit elements of the public domain. In principle, it is supposed that ideas and innovations, once disclosed to the public, are part of the public domain.**

**Social welfare is best advanced by free competition, because under a free competition legal regime prices are pushed down to the interest of consumers at a level where manufacturers can enjoy a reasonable and proportionate profit and remain financially viable at the same time.**

## **PUBLIC DOMAIN**

- **Public domain is the rule and IPRs (i.e. exclusive rights) is the exception. Patents, trademarks and copyright are exceptions to the public domain regime.**
- **An idea or innovation is regarded to fall within the public domain, unless it is proved that it is covered by an exclusive IP Right.**
- **The party alleging that it enjoys an exclusive right has to prove its entitlement to an IP right. The copying party does not need to prove that what it is using is part of the public domain.**
- **Laws granting exclusive IP Rights do not put things into the public domain, but instead they take them out of the public domain – A thing is in the public domain, if not covered by an exclusive rights.**

# **FREE COMPETITION and EXCLUSIVE IP RIGHTS**

**The law tries to strike a fair balance among exclusive IP Rights and free competition.**

***Why such a balance is needed?***

# WHY DO WE NEED IP ?

## Justification based on ethics and legal norms

- Reasons relating to ethics and legal norms

## Economic Justification

- To encourage and reward research and innovation and artistic and literary creation.
- To allow consumers obtain information about the products circulating on the market and choose among similar products – to enhance competition.
- To encourage manufacturers to invest in product quality – to enhance competition.

## Political Justification

- IPRs contributed to the development of capitalism and democracy

# PROTECTION OF IP RIGHTS - QUIZ

**1. For what period is a patent granted?**

- a. 20 years
- b. 25 years
- c. 15 years

**2. Is it possible to extend protection of one subject of industrial property? Which one?**

- a. Design
- b. Utility model
- c. Trademark

**3. How long is the term of protection of a trademark?**

- a. 70 years with possible extension
- b. 10 years with possible extension
- c. 25 years with possible extension

**4. Original product design can be protected with?**

- a. A Patent
- b. A Utility model
- c. An Industrial design

# PROTECTION OF IP RIGHTS - QUIZ

**5. Which of the sentences is true?**

- A. the costs of IP protection result only from its duration, and not from the territorial scope
- B. the costs of IP protection result only from its the territorial scope, and not from duration
- C. the costs of IP protection are impacted by both its the territorial scope and duration

**6. Which of the sentences is true?**

- A. IP rights protect only creative ideas
- B. IP rights protect only ideas that are original and one of a kind
- C. IP rights do not protect ideas, only their concrete, physical manifestations.

**7. "Small invention" is the common name for:**

- a. A design
- b. A utility model
- c. A technical formula

**8. Which of the sentences is false?**

- a. Utility model is a new and utile solution that does not require an inventive step
- b. Inventive step means that a solution is not obvious for an expert in a given field of technology
- c. IP rights do not extend to new plant varieties

# **INTRODUCTION TO EU DESIGN LAW**

# DESIGNS

- **Industrial design** is the act of shaping a product's form and features in advance of producing it – is what gives products their visual appeal and influences consumers in choosing one product over another. Well-designed products therefore create an important competitive advantage for producers.
- **Industrial design rights** protect the appearance of a product.
- To encourage innovation and the creation of new product design in the digital age, there is a growing need for accessible, future-proofed, effective and consistent **legal protection of design rights**.
- From an **economic point of view**, design-intensive industries substantially contribute to the EU economy. In 2017-2019, they accounted for almost 16% of EU GDP and 13% of all jobs in the EU.

# LEGAL FRAMEWORK

**Directive EU 2024/2823** on the legal protection of designs (came into force on 08.12.2024 and the member states have until 08.12.2027 to transpose it)

**Regulation EU 2024/2822** amending Council Regulation (EC) No 6/2002 on Community designs and repealing Commission Regulation (EC) No 2246/2002 (will apply from 01.05.2025, with a few articles applying from 01.07.2026),

**Directive 98/71/EC** on the legal protection of designs (**Design Directive**)

**Regulation EC 6/2002** on Community Designs (**Community Design Regulation**)

**Directive EC 2004/48** on the enforcement of IP Rights

**Regulation EU 608/2013** on Customs Enforcement of IP Rights

# SYSTEMS OF DESIGN PROTECTION

**NATIONAL DESIGNS** are registered by the intellectual property (IP) offices of the Member States (24 national offices and 1 regional office – the Benelux Office for IP).

National designs generally serve users seeking registration in one, or a limited number of countries, and users that want to obtain much broader protection in geographical terms but are not able or willing to opt for a Community design.

**EUROPEAN UNION DESIGNS (prior COMMUNITY DESIGNS)**, available in registered (abbreviated **REUD** prior **RCD**) and unregistered form (abbreviated **UEUD** prior **UCD**), grant their proprietors a unitary IP right with an equal effect throughout the entire EU.

While the **Unregistered EU Design right** simply arises by virtue of first disclosure without registration, the **Registered EU Design** is registered and administered by the **European Union Intellectual Property Office (EUIPO)**.

The **Registered EU Design** does not replace national design systems, but provides an additional legal Office (EUIPO), and an additional legal framework for obtaining a single design registration valid in the territory of all 27 EU Member States.

# SYSTEMS OF DESIGN PROTECTION

The **EUROPEAN UNION DESIGNS** protection system is more than 20 years old.

The EU Member States' laws relating to industrial design protection were partially harmonised by **Directive 98/71/EC**.

Alongside the national design protection systems, **Council Regulation (EC) No 6/2002** established a stand-alone system for the protection of design rights, which has equal effect throughout the EU in the form of Registered Community Designs (RCDs) and Unregistered Community Designs (UCDs).

The ongoing review of the Design Directive and the Community Design Regulation, which together constitute the EU legislation on design protection, seeks to address **two key challenges**:

- the disruption of the internal market for repair spare parts (e.g. bumpers, radiator grills, doors in cars)
- the continuing discouragement of businesses from seeking design protection at EU or national level because of high costs, burdens and delays in obtaining protection.

# SYSTEMS OF DESIGN PROTECTION

**INTERNATIONAL DESIGNS** are administered by the **World Intellectual Property Organisation (WIPO)**, and allow their proprietors to secure worldwide protection through the **Hague System for the International Registration of Industrial Designs ('Hague System')** by designating several countries or regions (e.g. the EU) with a single application.

The national, European Union and International design **systems coexist** and are complementary to each other.

Once the Design Directive established the **principles harmonising the national legal frameworks**, the conditions for obtaining protection of registered designs became uniform in all Member States.

According to **individual business needs** which will depend on the territorial scale of economic activity, the design proprietor can therefore either opt for a national or European Union-wide or international registered design right, or apply for and maintain parallel protection within the same territory through both the national and European Union registration systems, as well as the international system.

# SYSTEMS OF DESIGN PROTECTION

**The EU design legislation** has proven its effectiveness in design protection by helping to foster innovation and competition. However, significant **shortcomings** include:

- a patchwork of **diverging national regimes** partly providing design protection **for spare parts** and partly not (right holders are granted a genuine monopoly on the spare parts aftermarket in the Member States concerned)
- lack of alignment of **design protection to the digital transition** and to technological progress
- outdated or overly complicated **procedural rules** with a registration procedure for EU design that involves a sub-optimal RCD fee system
- different **national-level proceedings** for design registration and design invalidity

# UNREGISTERED COMMUNITY DESIGN

While registered designs were already provided for by national laws, [Regulation EC 6/2002](#) implemented a new sui generis design right: the **Unregistered Community Design**.

Therefore, **Unregistered Community Designs** apply only to designs disclosed for the first time in the European Union after the date Regulation EC 6/2002 came into force [on 6 March 2002](#). No Unregistered Design Right can ever subsist for designs disclosed in the European Union on or before 5 March 2002.

While there are important differences between Registered and Unregistered Community Design rights in terms of existence, length and extent of protection, the requirements for protection are similar.

Applicants for a [Registered Community Design](#) must file an application with the EUIPO and pay the corresponding fees. The registration of a Community design is not subject to substantive examination, as examination concerns only formalities, such as payment of fees or the quality of the drawings and that the design is not contrary to public policy or morality. There is no search for earlier rights in order to determine novelty.

[Registered Community designs](#) have a longer period of protection than unregistered Community designs. They are protected for an initial term of five years from the date of filing the application, with the possibility of renewal for up to 25 years ([article 25 Regulation EU 2024/2822](#)).

# UNREGISTERED COMMUNITY DESIGN

**Unregistered Community Designs**, by contrast, arise automatically once a design is made available to the public within the European Union (**article 11(1) of the Regulation EC 6/2002**), provided that it meets certain legal requirements. There is no need to register the design or to notify EUIPO in order for protection to exist.

However, the simplicity of the **Unregistered Community Design** right is also its weakness, as rights holders may have difficulty in demonstrating the existence of their rights.

Therefore, when creating a new design, it is advisable for designers to document evidence (e.g. dated brochures) of the date on which the design was made available to the public.

A design shall be deemed to have been made available to the public within the EU if it has been published, exhibited, used in trade or otherwise disclosed in such a way that, in the normal course of business, these events could reasonably have become known to the circles specialised in the sector concerned, operating within the EU (**article 11(2) of the Regulation EC 6/2002**).

The **Unregistered Community Design** owner must not only prove disclosure, but also disclosure in such a way that in the normal course of business, these events could reasonably have become known to the circles specialised in the sector concerned, operating within the EU.

# UNREGISTERED COMMUNITY DESIGN

In **Case C-345/13 Karen Millen Fashions Limited v Dunnes Stores and Another** ECLI:EU:C:2013.2013, the Court of Justice held that to benefit from the presumption of validity, the unregistered Community design owner need only indicate what constitutes the individual character of the design, that is to say, indicates what, in his view, are the elements of the design concerned which gives it its individual character.

Requiring an Unregistered Community Design owner to prove that its design could, in the normal course of business, reasonably have become known to the circles specialised in the sector concerned, operating within the EU, would run directly counter to the objectives of simplicity and expeditiousness identified by the Court of Justice as pillars of the system.

Protection for **Unregistered Community Designs** lasts for only three years from the date on which the design was first published within the Community (**article 11(1) of the Regulation EC 6/2002**).

Despite this, **Unregistered Community Designs** are extremely useful for protecting short-life products (e.g. products within the fashion industry), for which the registration process is too time consuming and expensive.

# UNREGISTERED COMMUNITY DESIGN

A **Registered Community Design** confers on its holder broader protection than an unregistered Community design, notably in terms of infringement assessment.

Holders have the exclusive right to use the design and to prevent any unauthorized third party from making, offering, putting on the market, importing or exporting products in which the design is incorporated or to which it is applied.

This exclusive right also applies to any design that does not produce a different overall impression on the informed user. Thus, rights holders are entitled to enforce their rights against any design that fails to produce a different overall impression, even if such a design is the result of independent work.

Holders of **Unregistered Community Designs** can prevent only infringing acts that are the result of copying (**article 19(2) of the Regulation EC 6/2002**). This means that if a third party has independently conceived an identical design, it will not be considered as having infringed a design.

Whether or not an alleged infringer has copied an Unregistered Community Design is a question of fact which will be determined on the evidence. A rights holder must prove that the defendant actually copied its design by demonstrating the defendant's knowledge of the design's existence. There is no additional requirement to prove that copying was in bad-faith.

# UNREGISTERED COMMUNITY DESIGN

In **Case C-479/12 Gautzsch Grosshandel GMBH & Co KG v Munchener Boulevard Mobel Joseph Duna GMBH** ECLI:EU:C:2014.75, the Court of Justice held that the holder of the protected design must bear the burden of proving that the contested use results from copying that design. The Court of Justice also held that the onus of proving that the contested design is an independent work of creation rests with the alleged infringer. However, the Court of Justice recognized that proving copying may be difficult, particularly in Member States without civil procedure for disclosure/discovery or the cross - examination of witnesses. In such cases the unregistered Community design owner is left relying on the closeness of the designs and a presumption that the designs are too close for the allegedly infringing design to be an act of independent creation.

Therefore, the Court of Justice relied on the principles of equivalence and effectiveness to ensure that it is not too difficult for owners of unregistered Community designs to assert their rights, and that the court is required to use all procedures available to it under national law to counter that difficulty and that the court may, where appropriate, apply rules of national law which provide for the burden of proof to be adjusted or lightened.

# COMMUNITY DESIGNS AND OTHER IP RIGHTS - PATENTS

**Article 96 of the Regulation EC 6/2002**, expressly mandates overlap with national copyright laws and allows overlap with other forms of intellectual property protection.

The introduction of Community design rights, and the harmonization of the law in relation to national and Benelux registered design rights, does not increase or lessen the protection available under other intellectual property laws, EU-wide or national.

**Article 95 of the Regulation EC 6/2002**, expressly provides for litigation based on a design which has both RCD and national or Benelux registered design right protection. The overlap with unfair competition is important in many of the European Union's member states and will often be pleaded alongside design infringement.

Patent and design protection can be complementary as patents protect the inside of products (their technical solutions), while the outside (their appearance) is protected by design rights.

Any features of a product that are solely dictated by its technical function or a shape that permits the product to perform a specific function are expressly excluded from Community design protection.

However, Community designs potentially offer protection for features with functional purposes, provided that these features are not dictated solely by a technical function.

# COMMUNITY DESIGNS AND OTHER IP RIGHTS - TRADEMARKS

Many rights holders seem to believe that trademark rights are the most efficient tool for protecting their IP assets. Because of the absence of any novelty requirement and the appealing ability to renew trademark rights indefinitely, the general trend is to seek trademark registration rather than protection under design rights, even when the asset meets the requirements for both trademark and design registration.

However, the situation is not quite so straightforward. First, one must bear in mind that trademarks are governed by **the principle of specialty**. This means that, except for well-known marks, trademarks cannot be used as grounds for infringement claims where the sign has been used for products and services other than those specified in the trademark registration.

Design protection, on the other hand, is not limited to specific goods and services. Design rights protect the design as applied to any article. A Registered Community Design confers on its holder the exclusive right to use the relevant design in all types of products, and not only in the product indicated in the application for registration **Case C-361/15 P & C-405/15 P, Shower drains**, EU.C.2017.720

Trademarks must fulfil their **specific function as indicators of the product's origin**. Thus, there are significant risks that non-conventional marks, such as trademarks consisting of the shape of a product, will be refused registration or declared invalid, as the sign will be perceived as functional or aesthetic only, and not as an indication of origin.

When intellectual assets meet the requirements for both trademark and design registration, for example logos, stylized words, packaging shapes, both types of IP right registration should be considered.

# COMMUNITY DESIGNS AND OTHER IP RIGHTS - COPYRIGHT

In most Member States, the author of a work enjoys, by the mere fact of its creation, an exclusive right to the work. The only requirement for a work of authorship to be protected under copyright law is generally that it be original.

A Community Design, Registered or Unregistered is, in principle, also eligible for protection under copyright, as [article 96\(2\) of the Regulation EC 6/2002](#) provides that “A design protected as an EU design shall also be eligible for protection by copyright as from the date on which the design was created or fixed in any form, provided that the requirements of copyright law are met.”

The possibility of obtaining cumulative protection from design rights and copyright depends on the standards of originality required by each Member State.

For example, in France, where ‘originality’ has been defined by the courts as the “expression of the author’s personality”, the originality requirement is low and can be met easily, allowing double protection from design rights and copyright. In certain other Member States, the level of originality required for copyright protection is much higher (e.g. industrial creations are sometimes excluded from protection). In such cases, design rights protection will be the sole solution for creators.

The Court of Justice in [Case C-683/17, Cofemel — Sociedade de Vestuário SA G-Star Raw CV](#), ECLI:EU:C:2019:721 ruled that although the protection of designs and the protection associated with copyright may, under EU law, can be granted cumulatively to the same subject matter, that concurrent protection can be envisaged only in certain situations.

# COMMUNITY DESIGNS AND OTHER IP RIGHTS - COPYRIGHT

Unregistered Community Designs can be particularly useful for companies creating a wide range of works, including seasonal works. As no registration is needed, there are no application fees and no formalities to follow. This enables creators of numerous designs to enjoy automatic protection once their designs are made public.

However, even in Member States where cumulative protection through copyright and design rights is fully recognized, Community design rights still offer a number of advantages over copyright protection.

As Registered Community Design rights arise from registration as opposed to the creation of the work, as is the case with copyright, they help to prove the exact date of creation, which can be particularly useful when rights are in dispute. They also create a presumption of ownership to the benefit of the holder.

The equivalent provision in [article 17 of the Directive 98/71/EC](#), was examined by the Court of Justice in [Case C-168/09 Flos SpA v Semeraro Casa e Famiglia SpA](#) ECLI:EU:C:2011.29, involving reproductions of the famous Arco lamp, Flos claiming to own copyright in the Arco lamp and bringing proceedings against Semeraro for marketing a similar lamp in Italy, where it was held that it is clear from the wording of article 17 of the Directive, and particularly from the use of the word “also” in the first sentence thereof, that copyright protection must be conferred on all designs protected by a design right registered in or in respect of the Member State concerned.

# DEFINITION OF DESIGN

An updated definition of ‘design’ in [article 3\(1\) of the Regulation EC 2024/2822](#), to make it fit for the digital age.

The appearance of the whole or a part of a product resulting from the features, in particular the lines, contours, colours, shape, texture and/or materials, of the product itself and/or of its decoration, including the movement, transition or any other sort of animation of those features.

This intentionally **broad definition** accommodates all aspects of the appearance of a product or part of a product.

The list of features comprising a design is **not exhaustive** and others may be identified by the Court of Justice in due course.

The term “design” should be given **a community – wide interpretation** and it includes both two and three-dimensional items.

The design must **take visible form** in order to be protected. Design rights do not protect thoughts, dreams, or ideas unless and until given visible, physical form. Design rights also do not protect design concepts, or methods of use or operation.

The legislation protects only appearance, it is **the sense of sight** that is relevant to design rights. Form and colour are both detected by the sense of sight, no other sense is relevant. Therefore, unlike EU trade marks and harmonized EU-wide trade mark law, there is no possibility of design protection for **sounds, smells or tastes**.

# DEFINITION OF DESIGN

**“Colours”** are one of the listed features of the appearance of a product in which design rights may subsist.

A **single colour** may of course be an element of a design, but on its own it does not comply with the definition of a design because it does not constitute the “appearance of a product”.

**Combinations of colours** may be accepted if it can be ascertained from the contours of the representation that they relate to a product such as, for instance, a logo or a graphic symbol in Class 32 of the Locarno Classification. Clearly, more complex two-dimensional combinations of colours, such as textile and wallpaper patterns, can be protected.

A practice has developed whereby a Registered Community Design, and an Unregistered Community Design, represented in black and white protects against use of the design in any colour.

**The texture and the materials** of a design are protected only to the extent that they are a feature of appearance of a product or part of a product. Clearly, the eye can perceive the difference between a glass bottle and an aluminium bottle. Thus, materials can be protected by a Community design to the extent that they can be seen, but no more.

There is **no requirement that a design be beautiful or pleasing to the eye or exhibit any creativity**. The legislator specifically avoided any requirement that a design have aesthetic quality, to draw a clear distinction from the national laws then prevailing in some Member States.

Designs of **screen displays and icons, graphic user interfaces** and other kinds of visible elements of a computer program are eligible for registration (**Class 14-04 of the Locarno Classification**).

# DEFINITION OF DESIGN

Design law protects **the appearance** of a product or part of a product regardless of its size. Thus, the comparative dimensions of the design will be relevant, for example, it is twice as tall as it is wide, but its absolute dimensions will not **Joined Cases T-83/11 and T-84/11 Antrax It Sri v OHIM—The Heating Company** ECLI.EU.T.2012. 592.

As regards **the appearance at time of purchase**, the General Court in **Case T-494/12 Biscuits Poult SAS v OHIM—Banketbakkerij Merba BV** ECLI.EU.T.2014.757, involving the RCD for a photographic reproduction in colour of half a chocolate chip biscuit, showing a creamy chocolate centre, where the layer of chocolate filling inside the cookie became visible only if the cookie was broken, held that the non-visible characteristic of the product does not relate to the appearance and cannot be taken into account in the examination of the requirements to fulfil for register a design.

**Mere words per se and sequences of letters** (written in standard characters in black and white) do not comply with the definition of a design because they do not constitute the appearance of a product.

The use of fanciful characters and/or the inclusion of a figurative element render the design eligible for protection either as a logo/graphic symbol (**Class 32 of the Locarno Classification**) or as the ornamental representation of a part of any product to which the design will be applied.

**Music and sounds per se** do not constitute the appearance of a product and do not comply with the definition of a design.

However, the graphical representation of a musical composition, in the form of musical notation, would qualify as a design, if applied for as, for example, other printed matter in **Class 19-08** or graphic symbols in **Class 32 of the Locarno Classification**.

**A photograph per se** constitutes the appearance of a product and, therefore, complies with the definition of a design, irrespective of what it discloses.

# DEFINITION OF PRODUCT

An updated definition of 'product' in **article 3(2) of the Regulation EC 2024/2822**, to make it fit for the digital age and for future technological developments, by replacing 'digital' by 'non-physical'.

Any industrial or handicraft item, other than a computer program, regardless of whether it is embodied in a physical object or materialises in a non-physical form, including (a) packaging, 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, (b) graphic works or symbols, logos, surface patterns, typographic typefaces, and graphical user interfaces.

The definition of product is **very broadly worded** and **not intended to be exhaustive**.

**Blueprints, technical drawings, plans for houses or other architectural plans** of interior or landscape designs (e.g. gardens) will be considered 'products' and will only be accepted with the corresponding indication of other printed matter in Class 19-08 of the Locarno Classification.

The EUIPO has registered a number of **built structures** as Registered Community Designs, including modular elements (architecture), walkways, architectural mouldings.

The EUIPO has accepted Registered Community Designs which indicate **sculptures and paintings** in **Class 11-02 of the Locarno Classification**.

**Teaching materials** such as graphs, charts, maps, etc. can be representations of products in **Class 19-07 of the Locarno Classification**.

# DEFINITION OF PRODUCT

**Living organisms are not “products”**, that is, industrial or handicraft items. A design that discloses the appearance of plants, flowers, fruits etc. in their natural state will, in principle, be refused.

However, no objection will be raised if it is apparent from the representation that the product does not show a living organism or if the indication of the product specifies that the product is artificial.

Although the human body is excluded from protection, **adornments or additions to the body** made by humans are not excluded from protection, such as surgical implants, artificial limbs, teeth, eyes, tattoos, false eyelashes and nails, wigs.

Community design rights protect not only the design of the products themselves, but also **the design of packaging of all sorts**.

The EUIPO has accepted Registered Community Design applications for bags, boxes cartons, bottles, sachets, blister packs, crates, and pallets. Parts of packaging are also included, for example, the design for the seal for a container.

**The term “get-up”** must be given a Community meaning and must be interpreted as going beyond packaging, and therefore is likely to include the design of point-of-sale material, including **the appearance of shop fit-out** and the like.

The EUIPO has accepted Registered Community Design applications which use “get-up” as the indication of the product, such as **shop interiors, a bank foyer and a hotel meeting room**.

# DEFINITION OF PRODUCT

The definition of “product” expressly includes “**graphic symbols**”. Many “graphic symbols” have been registered as Community designs in addition to being registered as trademarks. The Regulation expressly provides for overlapping protection, as already mentioned.

The EUIPO allows the registration of **a set of products** in a single Registered Community Design if the articles making up this set are linked by aesthetic and functional complementarity and are, in normal circumstances, sold altogether as one single product, like a chess board and its pieces or sets of knives, forks and spoons.

The EUIPO requires that **at least one view must show the set of articles together**. However, filing a Registered Community Design for a set of products may give a limited scope of protection, since the allegedly infringing design would need to create the same overall impression on the informed user as the whole of the set. Filing for the parts of the set separately, whilst more costly, is likely to give a broader scope of protection.

**Computer programs** are specifically excluded from protection by European Union design law, since they are more appropriately protected by copyright. However, **the results of a computer program**, such as a graphical user interface, webpage, or computer icon are protectable as designs, and indeed, the EUIPO has registered a number of these.

In this way, by copying a computer program to produce a computer icon, the copyist may infringe both copyright and a design right. However, if the icon is recreated using different computer programming, copyright in the computer code will not be infringed, but design right and copyright in the icon may be infringed. **Computer-generated designs** are also protected.

# COMPONENT PARTS OF COMPLEX PRODUCTS

The definition of “**part of a product**” in [article 3\(3\) of the Regulation EC 2024/2822](#) does not refer to spare parts.

A product that is composed of multiple components which can be replaced, permitting disassembly and reassembly of the product.

The legislation uses “**component part**” of a complex product to refer to **spare parts**. The difference is important. A part of a product can be protected by European Union design law even if not visible whilst in normal use.

European Union design law protects the appearance of the **product itself**, the appearance of **parts of the product**, the appearance of **visible component parts of a complex product** and the **appearance of any ornamentation**.

Thus, different design rights may subsist in the product (a car), in parts of the product (the rear half of the car), visible component parts (a hub cap), and/or the ornamentation on the product (a logo on the car) or on its parts (a logo on a hub cap). European Union design law does not protect non-visible component parts (such as a car engine).

[Article 3\(3\)](#) must be **narrowly construed** and consequently a design must not be regarded as constituting a component part of a complex product unless that is the only reasonable way in which to use it [Case T-39/13 Cezar Przedsiębiorstwo Produkcyjne Dariusz Bogdan Niewiński v OHIM - Poli-Eco Tworzywa Sztuczne sp. z o.o.](#), ECLI:EU:T:2014:852

# COMPONENT PARTS OF COMPLEX PRODUCTS

Under [article 4\(2\) of the Regulation EC 6/2002](#) “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: (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter; and (b) to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character”.

The aim of article 4(2) is to **exclude from protection the design of component parts of complex products which cannot usually be seen**. This article is clearly intended to subvert what could otherwise be a monopoly for non-visible spare parts, particularly for motor vehicles.

In [Case C-123/20 Ferrari SpA v Mansory Design Holding GmbH](#) ECLI:EU:C.2021.889 the Court of Justice held that in order for the appearance of the component part of a complex product to be protected as a design, it must, by definition, 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 component part cannot be completely lost in the product as a whole..

# COMPONENT PARTS OF COMPLEX PRODUCTS

To be protected, the component part of the complex product must remain visible, whilst the complex product is in normal use. It is not necessary for the whole of the component part to be visible, it is sufficient if a portion of the component part is visible during normal use of the complex product **Case T 3469-09 JOST-Werke GmbH v VGB Group AB, Case T-10/08 Kwang Yang Motor Co Limited v OHIM—Honda Giken Kogyo Kabushiki Kaisha** ECLI:EU:T.2011.446.

**Article 4(3) of the Regulation EC 6/2002** defines “normal use” as follows: “**Normal use**” within the meaning of paragraph (2)(a) shall mean use by the end user, excluding maintenance, servicing or repair work”. Therefore, normal use is defined to be use by the end user and specifically excludes maintenance, servicing, or repair work **Case T-39/13 Cezar Przedsiębiorstwo Produkcyjne Dariusz Bogdan Niewiński v OHIM - Poli-Eco Tworzywa Sztuczne sp. z o.o.**, ECLI:EU:T:2014:852.

The visibility of a component part incorporated into a complex product, cannot be assessed solely from the perspective of the end user of that product. In that regard, the visibility of such a component part to an external observer must also be taken into consideration **Case C-472/21 Monz Handelsgesellschaft International mbH & Co. KG v Büchel GmbH & Co. Fahrzeugtechnik KG**, ECLI:EU:C:2023:105.

# COMPONENT PARTS OF COMPLEX PRODUCTS

Normal use does not include the offer for sale of the component part as a separate item, were it otherwise, the exclusion would be meaningless [Case T-615/13 Aic SA v OHIM—ACV Manufacturing](#) ECLI:EU:C:2015.3.

The Court of Justice held that 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 in connection with such use, with the exception of maintenance, servicing and repair work [Case C-472/21 Monz Handelsgesellschaft International mbH & Co. KG v Büchel GmbH & Co. Fahrzeugtechnik KG](#), ECLI:EU:C:2023:105.

Whether or not a design is a component part of a complex product and, for that matter, whether it is visible in normal use, will be a finding of fact which requires evidence. An applicant for invalidity on this ground should therefore prepare and file cogent evidence to demonstrate how the design is used in practice. Conversely, the design owner should adduce evidence showing that the design is a stand-alone product, or, if a component part of a complex product, remains visible whilst in normal use [Case T-615/13 Aic SA v OHIM—ACV Manufacturing](#) ECLI:EU:C:2015.31, [Case T-39/13 Cezar Przedsiębiorstwo Produkcyjne Dariusz Bogdan Niewinski v OHIM—Poli-Eco Tworzywa Sztuczne Sp zoo](#) ECLI:EU:T:2014.85

# COMPONENT PARTS OF COMPLEX PRODUCTS

In [Case C-123/20 Ferrari SpA v Mansory Design Holding GmbH](#) ECLI:EU:C:2021:889, the Court of Justice held that an Unregistered Community Design may subsist in a part of a product or in a component part of a complex product if certain criteria are met (must be visible and defined by features constituting its particular appearance, i.e. by particular lines, contours, colors, shapes and texture). Also ruled that the publication of a “design” must be interpreted as meaning that the making available to the public of images of a product, such as the publication of photographs of a car, entails the making available to the public of a design of a part of that product, provided that the appearance of that part or component is clearly identifiable at the time the design is made available.

The Court of Justice’s decision in the Ferrari case provides an interesting additional tool for rights holders and manufacturers of products, as it confirms the institute of protection for individual parts of a product or component parts of a complex product as unregistered Community design, whereas some national courts in the EU, e.g. the German Federal Court of Justice in its judgment of 8 March 2012 ([Case No. I ZR 124/10 – Weinkaraffe](#)), had expressly denied protection.

Therefore, rights holders and manufacturers can now invoke the registered design for products and parts of the products, if registered separately, but also claim design protection for its unregistered products and also parts thereof, if the above conditions specified by the Court of Justice are met.

# EXCLUSIONS FROM PROTECTION – DESIGNS DICTATED BY THEIR TECHNICAL FUNCTION

Under [article 8\(1\) of the Regulation EC 6/2002](#) “a Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function”. The purpose of this article would appear to be that technical function is more properly protected under patent law.

As an exception to the broad protection granted by the Regulation and the Directive, the exception should be **interpreted narrowly** [Case C-465/04 Honnyven Informazioni Commerciali SLR v Mariella de Zotti](#) ECLI.EU.C.2006.199

**Two tests** for determining whether or not a feature of appearance of a product is “solely dictated by technical function”.

**The multiplicity of forms test** is to ask 'can the technical function be achieved by any other configuration?' If the designer had a choice of at least one other configuration, then the design of that feature is not *solely* dictated by technical function and design right may subsist. Few features and even fewer designs will be invalid, because there will, in most instances, be at least one other way of achieving the technical function. This test has found support in an early invalidity decision of the EUIPO, German literature and courts, the courts of France, Italy, Sweden, the United Kingdom and Spain and in the comments of the Advocate General in a trade mark [Case C-299/99 Koninklijke Philips Electronics NV v Remington Consumer Products Limited](#) ECLI.EU.C.2001.52 (Advocate General).

# EXCLUSIONS FROM PROTECTION – DESIGNS DICTATED BY THEIR TECHNICAL FUNCTION

Under **the no aesthetic considerations' test**, the question is asked 'in designing that feature of appearance, did the designer have in mind any function other than a technical function?' If that feature achieves no other function, then the design of the feature is solely dictated by technical function, and no design right can subsist. This test will have the practical effect of removing protection from many more features of appearance. This test has been used by the Boards of Appeal and by courts in the Netherlands.

In **Case C-395/16 DOCERAM GmbH v CeramTec GmbH**, EU:C:2018:172, the Court of Justice held that in order to determine whether the relevant features of appearance of a product are solely dictated by its technical function, within the meaning of Article 8(1) of the CDR, the national court must take account of all the objective circumstances relevant to each individual case. In that regard, there is no need to base those findings on the perception of an 'objective observer'.

Whether a feature of a design is solely dictated by technical function is a question for the tribunal, not the informed user **Case T-153/08 Shenzhen Taiden Industrial Co Limited v OHIM—Bosch Security Systems BV** *ECLI:EU:T:2010:248*

The level of technical expertise required to make the assessment will be closer to that of the 'sectoral expert' and will be beyond even the 'particularly observant user' **Case C-281/10P PepsiCoLnc v OHIM—GrupoPromerMon GraphicSA** *ECLI:EU:C:2011:679*.

Those features of a design which are solely dictated by technical function will need to be excluded from any relevant designs before considering novelty (on a validity assessment) and before assessing individual character (for assessment of validity or infringement). The intention of the actual designer is irrelevant, since technical function is an objective test.

# EXCLUSIONS FROM PROTECTION – DESIGNS DICTATED BY THEIR TECHNICAL FUNCTION

The whole design will be invalid only if each and every feature of appearance is excluded from protection. If only one feature is not dictated by the technical function of the product concerned, the invalidity application has to be rejected. Consequently, it will be rare for a whole design to be declared invalid under **article 8(1) of the Regulation**.

The assessment must be carried out on a case-by-case basis, taking account of all the objective circumstances of the case. In particular, the objective circumstances indicative of the reasons which dictated the choice of features of appearance of the product concerned, information on the use of the product and the existence of alternative designs which fulfil the same technical function are relevant provided that those circumstances, data, or information as to the existence of alternative designs are supported by reliable evidence **Case C-395/16 DOCERAM GmbH v CeramTec GmbH**, EU:C:2018:172

The burden of proof lies with the invalidity applicant who must provide evidence that the identified features of the contested design are solely dictated by the technical function of the product concerned **Case C-361/15 P & C-405/15 P, Shower drains**, EU:C:2017:720

The most common evidence submitted by the invalidity applicant in proceedings based on article 8(1) is documentation referring to patent or utility model applications or granted patents or utility models filed by the design holder or, less often, by a third party.

The existence of a patent or utility model does not automatically prove the technical function of the features of appearance of the product.

# EXCLUSIONS FROM PROTECTION – DESIGNS DICTATED BY THEIR TECHNICAL FUNCTION

Information on the use of the product, in particular that of technical nature, may serve to illustrate its functioning, including that of its individual features. Such information may be contained in the description of the product, its

The invalidity applicant can also submit articles referring to the same product as the one covered by the design. Promotional material, such as catalogues and brochures, referring primarily to the technical characteristics of the product concerned is a strong indication that only technical considerations were at play in the designing process images and also videos showing its use.

Expert opinions are usually submitted by the design holder. However, they can be provided by the invalidity applicant in order to demonstrate that the features were only dictated by the technical function.

In order to rebut the claim of the technicality of the design, the design holder can demonstrate that other considerations, in particular aesthetic ones, played a role in the creation of the contested design. The design holder can provide any means of evidence, among them the more common are written statements from the designer, proof of existence of alternative designs, expert opinions and promotional materials. Furthermore, all evidence submitted can be relevant in order to assess aesthetic considerations, including the evidence submitted by the invalidity applicant.

# EXCLUSIONS FROM PROTECTION – DESIGNS DICTATED BY THEIR TECHNICAL FUNCTION

A written statement by the designer of the product has a limited evidential value in so far as it presents the personal and subjective opinion of that designer and in so far as that designer has a personal interest in the validity of the design **Case T-574/19, Fluid distribution equipment**, EU:T:2020:543

In **Case C-395/16 DOCERAM GmbH v CeramTec GmbH**, EU:C:2018:172 the Court of Justice held that the mere existence of alternative designs which fulfil the same technical function cannot in itself exclude the finding that all the features of appearance of a product are solely dictated by its technical function. Nevertheless, the existence of alternative shapes may be a relevant indication that considerations other than the technical function of the product have played a role in the choice of features.

In **Case T-325/20, Water purifiers**, EU:T:2022:23 the General Court stated the fact that an alternative design is offered on the market is one of the factors to be taken into account, but not sufficient, in itself, to rebut the technicality of the design.

In **Case C-684/21 Papierfabrik Doetinchem BV v Sprick GmbH Bielefelder Papier- und Wellpappenwerk & Co**, ECLI:EU:C:2023:141, the Court of Justice held that if the holder of a registered design also holds registrations for numerous alternative designs, this does not on its own provide an indication that a design is not dictated solely by technical function.

# EXCLUSIONS FROM PROTECTION – DESIGNS DICTATED BY THEIR TECHNICAL FUNCTION

**Expert opinions** normally provide information on the technicality of the product and on the aesthetic considerations of the features of the design. Nevertheless, that evidence must be carefully examined and contrasted with the other evidence on the file.

**Promotional material**, such as catalogues and brochures, can also be provided in order to prove that aesthetic considerations played a (key) role in the creation of the design concerned. That material is particularly useful if it highlights the visual appearance and aesthetic qualities of the product in order to prove that other than purely technical considerations, in particular aesthetic considerations, contributed to the choice of the relevant features.

Promotional material merely referring, in a visually attractive manner, to general technical information about the product cannot establish such aesthetic considerations. Marketing material usually refers to general information within the framework of displaying, in an attractive manner, the respective collection of products.

The fact that the product in question received **a design award** or, at least, was one of the nominees, strongly suggests that an aesthetic element was present when designing it. However, awards that are not specifically related to product design should be assessed with caution as it should be established that that product's appearance was one of the relevant criteria for granting the award. In addition, references made to the design in design literature and displays in museums could also be relevant.

The **success of a product** on the market does not mean that considerations that are not related purely to the need to fulfil its technical function were taken into account by the designer **Case T-574/19, Fluid distribution equipment**, EU:T:2020:543102

# EXCLUSIONS FROM PROTECTION – DESIGNS OF INTERCONNECTIONS

Under [article 8\(2\) of the Regulation EC 6/2002](#), 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.

This article explicitly excludes from design protection features of appearance that must fit with another product. There is, however, an exception to the exception for modular systems, apparently introduced at the request of Denmark to protect LEGO and DUPLO.

The purpose of this article would appear to be to encourage the interoperability of products produced by different traders, and to free up the spare parts market. This purpose should be taken into account when interpreting the article.

As with any exception to the protection offered by the legislation, **the “must fit” exception should be interpreted narrowly** [Case C-465/04 Honyven Informazioni Commerciali SLR v Mariella de Zotti](#) ECLI.EU.C.2006.199,

The 'must fit' exception is **not a defense to infringement**. It is a requirement for validity. Whilst the EUIPO does not examine for validity on this ground, it will take it into account *ex officio* if invalidity proceedings are commenced on another ground, and there is sufficient evidence from the parties to enable the Office to do so.

The interconnection exception only excludes from design protection those 'features of appearance' that meet the established criteria. Thus, the whole design will be invalid only if each and every feature of appearance is excluded from protection.

# EXCLUSIONS FROM PROTECTION – DESIGNS CONTRARY TO PUBLIC POLICY OR MORALITY

Under [article 9 of the Regulation EC 6/2002](#), a Community design shall not subsist in a design which is contrary to public policy or to accepted principles of morality. The concepts of public policy and morality may **vary from one country to another**. A restrictive measure based on public policy or morality may be based on a conception which is not necessarily shared by all Member States. It is enough that a design be found contrary to public policy in at least part of the European Union for this design to be refused. This finding can be supported by the legislation and administrative practice of certain Member States.

It is not necessary that the use of the design would be **illegal and prohibited**. However, illegality of the use of the design under European or national legislation is a strong indication that the design should be refused.

The safeguard of public policy may be relied on to refuse a Community design application only if there is a genuine and sufficiently serious **threat to a fundamental interest of society**. Designs which portray or promote violence or discrimination based on sex, racial or ethnic origin, religion or belief, disability, age or sexual orientation will be refused on that account ([Article 10 of the Treaty on the Functioning of the European Union](#)).

The safeguard of morality may be relied on to refuse a Community design application if the design is perceived as sufficiently obscene or offensive from the perspective of a **reasonable person of normal sensitivity and tolerance**. Bad taste, as opposed to contrariety to morality, is not a ground for refusal. What is contrary to public policy and accepted principles of morality **will change over time**. However, there are at two types of designs that ought to be rejected. First, those designs which are objectionable **because of the image that they send** (e.g. Non-political statements that go beyond the puerile and into the offensive or unlawful). Second, those designs which are objectionable **because of what they are** (e.g. Cluster bombs, ivory products, illegal drug paraphernalia and other products which are outlawed within the territory of the European Union). Where the boundaries lie will need to be determined on a case-by-case basis, taking into consideration all the facts of each case.

# EXAMINATION OF THE SUBSTANTIVE REQUIREMENTS

The EUIPO carries out an examination of the **substantive protection requirements**, which is limited to two grounds for non-registrability. An application will be refused if the design does not correspond to **the definition** set out in article 3(1) of the Regulation EC 2024/2822 or if it is **contrary to public policy or to accepted principles of morality** pursuant to article 9 of the Regulation EC 6/2002.

The following are excluded from protection as Community designs, in addition to designs contrary to public policy or morality: (a) designs that constitute a component part of a complex product which is not visible during normal use (b) designs that are dictated by their technical function and (c) designs of interconnections.

Whether the product claimed is **actually made or used, or can be made or used**, in an industrial or handicraft manner will not be examined. Whether a design discloses the appearance of the whole or a part of a 'product' will be examined in the light of the design itself, insofar as it makes clear the nature of the product, its intended purpose or its function, and of the indication of the products in which the design is intended to be incorporated or to which it is intended to be applied.

A design application will be refused where **the representation is of a product that is simply one example amongst many of what the applicant wishes to protect**. An exclusive right cannot be granted to a 'non-specific' design that is capable of taking on a multitude of different appearances. This is the case where the subject matter of the application relates, inter alia, to a concept, an invention or a method for obtaining a product.

# EXAMINATION OF THE SUBSTANTIVE REQUIREMENTS

The design application must contain **a representation of the design** that enables the matter for which protection is sought to be identified, before a date of filing can be obtained ([article 36\(1\) Regulation EU 2024/2822](#)).

**Graphic or photographic representations** showing only the claimed design are preferred.

However, to understand the features of the design for which protection is sought, it may be helpful to show the design in context. In such cases the **use of visual disclaimers** may be necessary.

The visual disclaimer must be clear and obvious from the representation of the design.

There must be a clear distinction between the claimed and the disclaimed features.

It's the applicant's responsibility to disclose the features of the design as completely as possible. This is most likely to be achieved by using **aspect views of the design**. The applicant may provide complementary/additional views in order to further disclose the features of the design.

It's not obligatory for the applicant to file **a certain number of views or a certain or a certain type of view** as long as the features of the design can be clearly perceived by the submitted representation(s), e.g. one view may be sufficient. Applicants may file one or more views of the design. In case of products consisting of several parts, at least one view must present the **whole product**.

The holder of a registered EU design may inform the public that the design is registered by displaying on the product in which the design is incorporated or to which it is applied the letter D enclosed within a circle. Such design notice may be accompanied by the registration number of the design or hyperlinked to the entry of the design in the Register ([article 26a of the Regulation EU 2024/2822](#)).

# PRIOR DESIGNS - DISCLOSURE

Under [article 4\(1\) of the Regulation EC 2024/2822](#) a design shall be protected by a Community design to the extent that it is new and has individual character.

Both requirements can be assessed by comparing the design to any other design made available to the public anywhere in the world before the date on which the application for registration was filed or, if priority is claimed, before the date of priority, in the case of a registered Community design, or the design was first made available to the public, in the case of an unregistered Community design.

[Article 7\(1\) of the Regulation EC 6/2002](#) deals with disclosure by providing that a design can be made available to the public if published or used in a product, exhibited or disclosed in such a way that, in the normal course of business, these events could reasonably have become known to the sector concerned, operating within the European Union. This is an element to which rights holders should pay particular attention, as the requirements of novelty and individual character can be lost through any kind of disclosure anywhere in the world.

**The act of disclosure is a question of fact.** Disclosure, or making a design available to the public may occur in many ways: (a) published following registration, (b) published other than following registration, such as in a magazine or catalogue, (c) exhibited, (d) used in trade, or (e) otherwise disclosed. The list of potential methods of disclosure is not exhaustive.

# PRIOR DESIGNS - DISCLOSURE

**The methods of disclosure** are very broadly defined and the EUIPO has now accepted a vast array of types of disclosure, which have in common: the representation of the design in a physical form and the making public of the design. Therefore, being made available to the public can occur by any means whatever in any part of the world.

The disclosure itself can happen anywhere in the world (**concept of absolute world-wide novelty**), so long as those events could reasonably have become known in the normal course of business in the circles specialized in the sector concerned, operating within the European Union **Case C-479/12 H Gautzsch Grofhandel GmbH & Co KG v Münchener Boulevard Möbel Joseph Duna GMBH**, ECLI.EU.C.2014.75.

The disclosure does not need to be of a product itself, but could be, and often is, a photograph, drawing, or image of the design or of a product made to the design.

Prior designs which were never commercialized, should be taken into account when assessing novelty and individual character **Joined Cases T-22/13 and T-23/13 Senz Technologies BV v OHIM – Impliva BV**, ECLI.EU.T. 2015.320

# PRIOR DESIGNS - DISCLOSURE

A prior disclosure anywhere in the world will be a relevant disclosure, unless it is too obscure. **The onus of proving obscurity rests with the design holder.** Very rarely will a prior design be too obscure, or the risk is the remonopolization of old rights.

When assessing whether a prior design is too obscure, the relevant circles are those of the design in question. Whether a prior design is too obscure, is an objective question and a question of fact.

The formulation given to obscure disclosures was disclosures that “could not reasonably have become known in the normal course of business to the circles specialized in the sector concerned, operating within the Community”. Designs should be found to be too obscure only in exceptional circumstances.

The following disclosures have been held to be relevant disclosures:

- (a) A **published RCD application**. Unpublished RCD applications have not been disclosed because they cannot be accessed without the consent of the applicant (article 74(1) of the Regulation EC 6/2002).
- (b) Disclosure of the design in **the official journal of the Japanese Patent Office**, one of the world's most important industrial property offices in terms of volume of applications and registrations of designs. Publication of a **US design patent** was held to have a similar effect, taken into account the fact that the United States Patent and Trademark Office's databases are available online.

# PRIOR DESIGNS - DISCLOSURE

- (c) **Foreign disclosures** are more likely to be found to be relevant where the foreign jurisdiction is important to the manufacture or purchase of the goods in question.
- (d) **A published trade mark application in a Member State**. Filing a trade mark application is not considered to disclose any design shown in the application, the design will be disclosed only on publication of the trade mark application.
- (e) **A published international patent application** and publication of an Australian patent application.
- (f) **Showing the product at a fair**.
- (g) **Publication in newspapers and magazines** within the European Union.
- (h) **A video**—there is no requirement that the prior design is a still image.
- (i) Pictures included in **a trade brochure and a magazine**.
- (j) **A court application** is not evidence of disclosure without evidence that the document was disclosed to the public and evidence of the date of disclosure,

# PRIOR DESIGNS - DISCLOSURE

## (k) Disclosures on the internet.

The disclosures are not obscure in the sense in which the limitation of the absolute novelty in article 7(1) of the Regulation EC 6/2002 was intended. It is not a case of design disappearing from human memory over time and being available only in a local museum or traded on a remote local market.

An obscure design on the internet would have to be irretrievable or hardly retrievable by regular browsers, which is not the case of the prior designs. It does not matter if the internet site is password protected or requires payment for access.

However, the internet is a source of information that is not physically robust, as it concerns data and images that are put on line and made accessible solely by means of computers. Its content may be modified at any moment and, as a consequence, the utmost caution must be used when assessing evidence printed out from this source of information.

Merely producing a page printed from a website cannot automatically be relied upon in terms of its content, particularly when this content is from the past – and is therefore difficult to verify a posteriori – in the absence of additional evidence, such as certification as to the content, issued by the administrator of the website in question or by organisations, such as the Internet Archive, that provide search services on the history of websites, commonly known under the name Wayback Machine.

Case law concerning EU trade marks has already accepted extracts from the Wayback Machine as a valid source of evidence, especially when corroborated by other pieces of evidence, e.g. leaflets, invoices and web pages. There is no reason why this should not also apply to evidence provided in a case concerning designs.

# PRIOR DESIGNS - DISCLOSURE

In order to establish the disclosure of a prior design, **an overall assessment must be made taking into account all the relevant circumstances of the particular case.**

The disclosure cannot be proved by means of probabilities or suppositions but must be demonstrated **by solid evidence.**

Such **evidence must be considered in its entirety.** While some elements of the evidence considered on their own may be insufficient to demonstrate the disclosure of a prior design, the fact remains that when combined or in conjunction with other documents or information, they can contribute to the proof of disclosure.

For example, the publication of photographs on the design holder's Facebook page, even when proven by two certified reports, was not considered an event that could have reasonably become known in the normal course of business to the relevant circles of designers, manufactures and traders.

The Boards of Appeal found that posting of an image of a design on a blog may not, under the circumstances in which it was made, amount to an event that could reasonably have become known in the normal course of business to the circles specialized in the sector concerned, operating within the Union. The existence of the blog was also unlikely to become known the relevant circles for a second reason, namely the personal profile of the blogger.

Neither restricting access to a limited circle of people e.g. by password protection, nor requiring payment for access, analogous to purchasing a book or subscribing to a journal, prevents a design on a webpage from being found to have been disclosed.

# PRIOR DESIGNS - DISCLOSURE

Disclosure is related to **the sector concerned, operating within the European Union**. This notion is construed broadly and a broad interpretation of '**circles specialized in the sector**' is undoubtedly the correct one. The word 'specialised' implies a degree of expertise beyond, for example, the informed user. This might suggest designers and other specialists in the sector concerned. However, the use of 'circles' likely broadens the concept out again.

Whether events constituting disclosure could reasonably have become known in the normal course of business to the circles specialized in the sector concerned, operating within the EU, is **a question of fact**, the answer being dependent on the assessment, by the Community Design Court, of the particular circumstances of each individual case [Case C-479/12 H Gautzsch Grofhandel GmbH & Co KG v Miinchener Boulevard Mobel Joseph Duna GMBH](#), ECLI:EU:C.2014.75.

The sector concerned may either consist of **the sector of the challenged Community design**, to be determined according to the indication of product, which, however, shall not affect its scope of protection as such ([article 36\(6\) of the Regulation EC 6/2002](#)), or of the sector of the prior art. Therefore, the sector concerned within the meaning of article 7(1), is not limited to that of the product in which the contested design is intended to be incorporated or applied.

The circles concerned are those operating within the European Union. This does not necessarily suggest that the relevant circles need to be based within the EU - it would be conceivable that they might be based elsewhere - but they must operate within the EU [Case T-68/10 Watches](#) ECLI:EU:T:2011.269, [Case T-15/13 Shower Drains](#), ECLI:EU:T:2015.281.

# PRIOR DESIGNS - DISCLOSURE

The test is whether the disclosure could not reasonably have become known to the relevant sectors operating within the European Union. The test is objective.

An applicant or counterclaimant for invalidity has the onus of proving any prior disclosure on which it wishes to rely. Having satisfactorily proved the prior disclosure, the onus shifts to the design holder to prove that the disclosure was too obscure to count as a prior design and that the disclosure could not reasonably have become known in the normal course of business to the circles specialized in the sector concerned, operating within the EU **Joined Cases T-22/13 and T-23/13 Senz Technologies BV v OHIM—Impliva BV** ECLI:EU:T:2015.310

**Confidential disclosures** **Article 7(1) of the Regulation EC 6/2002** provides that a design shall not be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.

Explicit conditions of confidentiality will be clear, involving usually a form of confidentiality agreement or a relationship, such as an attorney/client relationship, that is clearly a relationship of confidentiality.

Implicit conditions of confidentiality may be less clear, e.g. a design disclosed during contractual negotiations to be subject to confidentiality, even though there was no express confidentiality agreement

# PRIOR DESIGNS - DISCLOSURE

**Grace period** Under [article 7\(2\) of the Regulation EC 2024/2822](#), a disclosure shall not be taken into consideration for the purpose of applying Articles 5 and 6 if the disclosed design, which is identical with or does not differ in its overall impression from the design for which protection is claimed under a registered EU design, has been made available to the public: (a) 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 (b) during the 12-month period preceding the date of filing of the application or, if a priority is claimed, the date of priority.

A designer is given a grace period of **12 months** in which to disclose his or her design and attempt to commercialize it. During that time, the designer's disclosure does not count as a prior disclosure for the purposes of the validity of any later registered Community design registration.

If the design has been a success within 12 months, the designer may choose to apply for a registered Community design or a national or Benelux registered design. If the design has not been a success, the designer may choose to save the filing fee, and instead rely only on unregistered Community design right for the three years from first disclosure within the European Union. Consequently, no grace period applies to unregistered Community designs.

The grace period enables a designer to test the waters to determine if the design sells and is therefore worth the costs of registered protection. The grace period is a particularly useful tool for small businesses.

# PRIOR DESIGNS - DISCLOSURE

The grace period provides protection for the registered design owner from potential invalidity caused by self-disclosure, while it does not move the filing/priority date earlier by 12 months.

The prior disclosure must be by the designer or his/her successor in title in order to benefit from the grace period. Disclosure by a third person as a result of information provided or action taken by the designer, includes third parties acting on behalf of the designer or his/her successor in title, such as advertising agencies, promoters, or licensees.

**Article 7(3) of the Regulation EC 6/2002** excludes abusive disclosures from those prior designs considered for the purposes of novelty and individual character of registered Community designs.

An abusive disclosure will not count as a prior disclosure only if it is within 12 months of the application date for the registered design. The Regulation does not specify or define further what it means by 'abuse'. Rather, the Boards of Appeal has suggested that it will need to be assessed on a case-by-case basis.

The term is likely to include at least disclosures in breach of implied or explicit confidentiality or against the lawful instructions of the designer, as well as disclosures as a result of an unlawful act, such as a burglary.

# NOVELTY

Novelty is assessed from the relevant date.

**Article 5(1), (2) of the Regulation EC 6/2002** provides that a design shall be considered to be new if no identical design has been made available to the public: (a) in the case of an unregistered Community design, before the date on which the design for which protection is claimed has first been made available to the public, (b) in the case of a registered Community design, 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, and that designs shall be deemed to be identical if their features differ only in immaterial details.

This article broadens **the meaning of 'identical'** to include designs whose 'features differ only in immaterial details'. Whether two designs are identical is a question of fact, to be determined by the tribunal. Two designs are either identical or they are not - there is no room in the Regulation for degrees of identity. If the applicant for invalidity seeks to adduce expert or consumer evidence, the designs are probably not identical.

Whether or not two designs are identical should be obvious. If not obvious, the tribunal should turn to Article 6 of the Regulation or Article 5 of the Directive, and examine individual character.

Novelty is an objective test **Case C-32/08 Fundacion Espanola para la Innovacion de la Artesania v Cul de Sac Espacio Creative SL and Another** ECLI:EU:C:2009:418.

The informed user therefore plays no role in the assessment of identity. Identity should remain a strict test, divorced from the informed user's role in assessing individual character.

The General Court in **Case T-651/16 Crocs v EUIPO - Giffi Diffusion**, ECLI:EU:T:2018:137 took a two-step approach to novelty destroying disclosure, namely, it looked at, in the first place, whether the evidence produced by the intervener showed that the contested design had been disclosed before the relevant period started and, in the second place, whether the applicant was able to demonstrate that the disclosure events thus claimed by the intervener could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union.

# NOVELTY – IMMATERIAL DETAILS

In order to determine whether a detail is immaterial, it's necessary to conduct a feature analysis to determine in what details the two designs differ. An assessment can then be made of whether those differences are immaterial. The Boards of Appeal has indicated that, where lack of novelty is claimed for a registered Community design, the Invalidity Division should first list any perceived differences between the registered Community design and each prior design, and then analyse and explain why these differences relate to immaterial details.

No helpful definition of 'immaterial details' has yet emerged.

The Boards of Appeal in [Case R 1451/2009-3 Antrax It Sri v The Heating Company BVBA](#) ruled that a detail is 'immaterial' if it does not invest in the project as such, but is 'outside' or accessory to it. An immaterial detail may be, for example, the presence of a sign printed on a template, such as a product code or brand quality. Thus, if two designs differ only in the presence of that sign - and it is clear that the marking is not part of the project - they must be considered, despite such difference, identical.

The General Court in [Case T-41/14 Argo Development and Manufacturing Limited v OHIM – Clapbanner Limited](#) ECLI:EU:T:2015:53 noted that a difference will not be immaterial if it is 'perceptible when the earlier design and the contested design are placed side by side'.

In [Case T-68/11 Erich Kastenholtz v OHIM— Qwatchme A/S](#) ECLI:EU:T:2013:298, the General Court noted that 'two designs are to be deemed to be identical if their features differ only in immaterial details, that is to say, details that are not immediately perceptible and that would not therefore produce differences, even slight, between those designs. A contrario, for the purpose of assessing the novelty of a design, it is necessary to assess whether there are any, even slight, non-immaterial differences between the designs at issue'.

# NOVELTY – IMMATERIAL DETAILS

The tests for novelty and individual character are different tests, and should not be conflated.

The two tests should not be elided. In [Case R 887/2008-3 Normann Copenhagen ApS v Paton Calvert Housewares Limited](#) the Boards of Appeal held that 'in spite of the overlap between novelty and individual character, there are certain differences between the two requirements. "When assessing the novelty, the Board simply has to decide whether two designs are identical. The only area where difficulties of interpretation might arise is in relation to the term 'immaterial details'. On the other hand, when assessing the individual character, the Board is required to take into account the overall impression on the informed user, having regard to the degree of freedom of a designer in developing the design. If the designer had relatively little freedom in developing the design, especially on account of technical constraints, even small differences in relation to earlier designs may be sufficient to endow the design with individual character. Novelty and individual character are different tests. It is true that they overlap to some degree (because a design that lacks novelty will also lack individual character), but they are to be assessed differently.'

In [Case R 1285/2008-3 Erich Kastenholtz v Qwatchme A/S, confirmed on appeal Case T-68/11 Erich Kastenholtz v OHIM— Qwatchme A/S](#) ECLI:EU:T:2013:298, the Boards of Appeal noted that 'obviously, if two designs produce a different overall impression on the informed user, they cannot be identical for the purposes of Article 5 of the Regulation'. Therefore, whilst there are designs that create a different overall impression on the informed user but are not identical, all identical designs will create the same overall impression on the informed user.

# INDIVIDUAL CHARACTER

Under **article 6(1) (2) of the Regulation EC 6/2002**, 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: (a) in the case of an unregistered Community design, before the date on which the design for which protection is claimed has first been made available to the public; (b) in the case of a registered Community design, before the date of filing the application for registration or, if a priority is claimed, the date of priority. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

This article introduced to EU-wide law four new concepts:

- (a) the **'informed user'** in intellectual property matters,
- (b) the **'overall impression'** test, which must take into account,
- (c) the **'degree of freedom of the designer'**,
- (d) all together, these three tests are used to assess the fourth, **of 'individual character'** of a design.

The relevant date for assessing individual character is the same as for the assessment of novelty.

# INDIVIDUAL CHARACTER – THE TERM INFORMED USER

**The term 'informed user'** appears three times in the Regulation EC 6/2002: in Recital 14, in article 6 and in article 10. However, the expression is not defined and it should be given an EU-wide meaning [Case C-32/08 Fundacion Espanola para la Innovation de la Artesania v Cul de Sac Espacio Creativo SL and Another](#) ECLI:EU:C:2009:418.

The informed user will be aware of the design corpus, so as to enable a comparison of the design in issue with the prior designs or alleged infringement against the backdrop of the design corpus. The informed user will also be aware of the industrial sector to which the product belongs, and of the degree of freedom of the designer in developing the design [Case T-339/12 Gandia Blasco SA v OHIM - Sachi Premium-Outdoor Furniture](#), L<sup>da</sup> ECLI:EU:T:2014:54.

How the informed user is determined will have a significant influence on the outcome of both invalidity proceedings and infringement litigation.

If an informed user is found to have very detailed product knowledge and experience, even minor differences between products may well create a different overall impression and many designs will be valid but few will be infringed. This would create limited monopolistic rights for lots of small innovations.

If the informed user has insufficient knowledge, then a broader range of products will create the same overall impression and few designs will be valid, but those that are, are likely to be infringed. This would create wide monopolies for a limited number of designs. The balance must be found somewhere between the two positions.

# INDIVIDUAL CHARACTER – THE TERM INFORMED USER

**The informed user is a legal fiction.** The informed user lies somewhere between the average consumer in trade mark law and the sectoral expert from patent law. The informed user is thus not a designer or a technical expert, but rather someone with a professional or personal interest in the design. The informed user shows a high degree of attention and is particularly observant. The informed user has a relatively high degree of knowledge of the sector in question [Case T-339/12 Gandia Blasco SA v OHIM - Sachi Premium-Outdoor Furniture, L<sup>da</sup>](#) ECLI:EU:T:2014:54. Therefore, the informed user is not the informed user of the design itself, but rather the informer user of a product in which the design is incorporated or to which the design has been applied.

The Court of justice ruled in [Case C-281/10 P PepsiCo Inc v OHIM— Grupo Promer Mon Graphic SA](#) ECLI:EU:C:2011:679, the first case on the meaning of individual character, that the Regulation does not define the concept of the 'informed user' and that, however, that concept must be understood as lying somewhere between that of the average consumer, applicable in trade mark matters who need not have any specific knowledge, and who, as a general rule, makes no direct comparison between the trade marks in conflict, and the sectoral expert who is an expert with detailed technical expertise. Thus, the concept of the 'informed user' may be understood as referring, not to a user of average attention, but to a particularly observant one, either because of his personal experience, or his extensive knowledge of the sector in question.

# INDIVIDUAL CHARACTER – THE TERM INFORMED USER

In a number of cases before the General Court, reference has been made to there **being more than one informed user**. For example, in [Case T-68/10 Sphere Time v OHIM—Punch SAS](#) ECLI:EU:T:2011:269 the General Court assessed the informed user of promotional watches attached to lanyards as either the professional who acquires them in order to distribute them or the end user.

The General Court took a similar view in [Case T-9/07 Grupo Promer Mon Graphic SA v OHIM—PepsiCo Inc](#) ECLI:EU:T:2010:96 with the informed user of a rapper being found to be a 5 to 10 year - old child or a marketing manager.

In both cases, the General Court held that it did not matter, as the perception of the designs by the two groups did not differ. In [case Sphere Time v OHIM – Punch](#), the General Court ruled that the fact that one of the two groups of informed users perceives the designs at issue as producing the same overall impression is sufficient for a finding that the contested design lacks individual character.

The informed user uses the product in accordance with its purpose. It is not necessary or relevant to adduce evidence from a witness who meets the criteria of the informed user. Neither are surveys likely to be relevant.

# INDIVIDUAL CHARACTER – THE DEGREE OF FREEDOM OF THE DESIGNER

**The degree of freedom of the designer** in developing the design may have a significant impact on the outcome of any design dispute.

Constraints on a designer result in standardization of certain features, which will consequently be common to products of that type made by different designers [Case T-10/08 Kwang Yang Motor Co Limited v OHIM - Honda Giken Kogyo Kabushiki Kaisha](#), ECLI:EU:T. 2011.446.

Therefore, where the designer's freedom is limited, small differences may be sufficient to create a different overall impression on the informed user. However, where the designer's design freedom is wide open, the same small differences are unlikely to create a different overall impression on the informed user [Case T-9/07 Grupo Promer Mon Graphic SA v OHIM—PepsiCo Inc](#) ECLI:EU:T:2010:96.

Establishing the degree of design freedom may therefore be key to both invalidity and infringement claims.

The designer's degree of freedom cannot by itself determine whether or not two designs produce the same overall impression on the informed user within the meaning of article 6(1) of the Regulation EC 6/2002, but it is a factor that may reinforce or, a contrario, moderate the assessment of the overall impression produced by each design at issue [Case T-193/20 Eternit v EUIPO](#) EU:T:2021:782.

# INDIVIDUAL CHARACTER – THE DEGREE OF FREEDOM OF THE DESIGNER

**Technical constraints should be taken into account** [Case T-10/08 Kwang Yang Motor v OHIM – Honda Giken Kogyo](#) ECLI:EU:T:2011:446. These might include product safety or the requirements of industry standards.

However, features of appearance typically found in the products at hand, which do not result from technical or legal constraints, cannot affect the determination of the designer's degree of freedom. Nevertheless, they may play a role in the overall assessment of the impression produced by the designs [Case T-662/20, Muratbey Gida v EUIPO – M. J. Dairies](#), ECLI:EU:T:2021:843.

**Product trends** do not restrict the freedom of the designer. The General Court in [Case T-9/07 Grupo Promer Mon Graphic SA v OHIM—PepsiCo Inc](#) ECLI:EU:T:2010:96, ruled about design freedom that 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 standardization of certain features, which will thus be common to the designs applied to the product concerned. In essence the General Court has combined both the technical requirements with the market expectations for the common features of the product in question.

As the General Court has pointed out in [Case T-357/12 Saehi Premium-Outdoor Furniture Lda v OHIM—Gandia Blasco SA](#) ECLI:EU:T:2014:55, product trend is not a restriction on the freedom of the designer “the designer's degree of freedom may be limited by the constraints of the features imposed by the technical function of the product or by statutory requirements applicable to the product.

# INDIVIDUAL CHARACTER – THE DEGREE OF FREEDOM OF THE DESIGNER

However, a **general design trend** cannot be regarded as a factor that restricts the designer's freedom **Joined Cases T-83/11 and T-84/11 Antrax It v OHIM—THC (Radiators for heating)** [2012] ECR.

Design freedom is **an objective test**—it is the design freedom of a putative designer of the design concerned, not the particular designer who designed the design. Constraints personal to a particular designer, such as budget cuts or the desire to re-use existing production lines, do not form part of the assessment of design freedom. Being a necessary condition for the assessment of individual character, the designer's degree of freedom is determined as **a matter of law**.

The **burden of proving a limited design freedom lies with the design holder** while, on the other hand, it is for the invalidity applicant to establish a high degree of freedom. Given that there are no provisions in the Regulation EC 6/2002 that specify the kind or quantity of evidence required in order to establish the designer's degree of freedom, the party can freely choose the evidence that it considers useful to submit in support of its claim.

There are a **number of ways of evidencing degree of design freedom**. Experts' reports can be prepared, and may be particularly useful for designs in sectors with complex technical or regulatory requirements. The General Court in **Case T-43/18 Rietze v EUIPO - Volkswagen** ECLI:EU:T:2019:376 confirmed that legal constraints can also be taken into account on the basis of a well-known fact for specific products, such as motor vehicles.

For registered designs, design freedom is assessed as at the **date of application or any earlier priority date**. For unregistered Community designs, design freedom is assessed as at the date of first disclosure of the design in the European Union.

# INDIVIDUAL CHARACTER – THE DEGREE OF FREEDOM OF THE DESIGNER

In **validity cases**, the challenged design, registered or unregistered, is tested against prior disclosed designs. To be valid under **article 4 of the Regulation EC 6/2002** the challenged design must have individual character.

The challenged design will not have individual character if it creates the same overall impression on the informed user as the prior design (**article 6 of the Regulation EC 6/2002**). In assessing individual character of the challenged design, the degree of freedom of the designer in developing the design shall be taken into consideration. Thus, it will not matter if the challenged design and the prior design are for the same product and were contemporaneously designed.

In **infringement cases**, a product will infringe a design, registered or unregistered, if it falls within the scope of protection of the earlier design (**article 10(1) of the Regulation EC 6/2002**). In assessing the scope of protection of the earlier right, the degree of freedom of the designer in developing his design is taken into consideration. It is the allegedly infringed design that is relevant to design freedom, not the allegedly infringing design

Thus, the degree of freedom of the designer refers, in both validity and infringement cases, to the designer of the design in issue, not any prior design or any later alleged infringement. The assessment is made as at the date of the design in issue, for registered designs, either its filing or priority date if earlier, for unregistered Community designs, its first disclosure in the European Union. As a result, the degree of freedom of a designer does not change, as it is fixed at the date of filing or priority date if earlier, for registered designs and at the date of first disclosure in the European Union for unregistered Community designs **Case T-193/20 Eternit v EUIPO** ECLI:EU:T:2021:782.

# INDIVIDUAL CHARACTER – THE DEGREE OF FREEDOM OF THE DESIGNER

For assessing design freedom, any **indication of product** recorded with the registered design may play a role, but the more important role is the design freedom of the design for the product to which the design is applied or in which it is incorporated, as seen in the registration.

Where the contested design concerns an integral part of a product, the designer's degree of freedom will be defined in relation to this part, and not in relation to the entire product. For example, the Boards of Appeal in **Case R 2021/2019-3, Jieyang DAefa Idustry v EUIPO – Mattel**, decision confirmed by the General Court (not assessing this particular aspect) **Case T-84/21, Jieyang DAefa Idustry v EUIPO – Mattel** ECLI:EU:T:2021:844, assessed the designer's degree of freedom in relation to the head of the doll, and not the entire doll.

Under **article 6(2) of the Regulation EC 6/2002**, the degree of freedom of the designer must be taken into consideration in the assessment of individual character. Thus, there is a certain degree of interdependence between the degree of freedom of the designer and the strictness of the assessment of individual character. However, there is no “reciprocity” as such, nor any systematic relationship between the two. Although the degree of freedom of the designer must be taken into account, the assessment of individual character of a design must primarily be founded on the impression it produces on the informed user **Case R 207/2012-3 H&M Hennes & Mauritz v Yves Saint Laurent**, decision confirmed by the General Court **Case T-525/13 H&M Hennes & Mauritz BV v Yves Saint Laurent SAS**, ECLI:EU:T:2015:617

# INDIVIDUAL CHARACTER – OVERALL IMPRESSION

**Overall impression** Having identified the informed user and assessed the degree of freedom of the designer, it is then necessary to establish the overall impression created on the informed user.

The General Court held in [Case T-9/07 Grupo Promer Mon Graphic SA v OHIM—PepsiCo Inc](#) ECLI:EU:T:2010:96 that the overall impression must be a visual one, as the European Union design law relates to the appearance of a product, so the only human sense relevant is sight.

To make the comparison, the informed user will use the design as registered or, in the case of unregistered Community designs, disclosed, but may also look at a product made to the design to confirm the conclusion already drawn.

The Court of Justice in [Case C-281/10 P PepsiCo Inc v OHIM—Grupo Promer Mon Graphic SA](#) ECLLEU: C:2011:679 held that “it is not mistaken, in the assessment of the overall impression of the designs at issue, to take account of the goods actually marketed with correspond to those designs”.

Thus, a comparison is to be made between the designs at issue, but goods which correspond to the design can, as a matter of law, be viewed to confirm the conclusion already drawn.

When making the comparison, the informed use will compare like with like and, in effect, ignore additional material, such as branding, that appears in the allegedly infringing product, but not in the design being enforced.

When considering validity, the comparison is made between the design at issue, registered or unregistered, and separately each prior design, not an amalgam of features [Case T-153/08 Shenzhen Taiden Industrial Company Limited v OHIM—Bosch Security Systems BV](#) ECLI:EU:T:2010:248.

# INDIVIDUAL CHARACTER – OVERALL IMPRESSION

The Court of Justice in [Case C-345/13 Karen Millen Fashions Limited v Dunnes Stores and Another](#) ECLI:EU:C:2014:206 rejected the “**amalgam theory**” by ruling that “there is nothing in the wording of Article 6 of [the Regulation] to support the view that the overall impression referred to therein must be produced by such a combination”. The Court of Justice cited its own case law referring to the impression produced on the informed user by “earlier individualized and defined designs, as opposed to an amalgam of specific features or parts of earlier designs”.

When comparing two designs, the comparison should take place side by side, unless it is impractical to do so. Comparison side by side is important to maintain the balance established by the definition of the informed user. The 'informed' nature of the informed user will be negated if the comparison is not done side by side. Introducing notions of imperfect recollection places the assessment too close to the reasonably well-informed consumer in trade mark law, a test already rejected by the Court of Justice in [Case C-281/10 P PepsiCo Inc v OHIM—Grupo Promer Mon Graphic SA](#) ECLLEU: C:2011:679.

Moreover, the Court of Justice held that “it is true that the very nature of the informed user as defined above means that, when possible, he will make a direct comparison between the designs at issue. However, it cannot be ruled out that such a comparison may be impracticable or uncommon in the sector concerned, in particular because of specific circumstances or the characteristics of the devices which the designs at issue represent”.

The occasions on which a direct comparison is not made should be rare. With photographic technology as it is, even if two buildings cannot be compared side by side, two or more photographs of the buildings can be so compared. What matters is that the comparison is to be a detailed one, with no scope for imperfect recollection from trade mark law. Therefore, the notion of imperfect recollection ought to play no part in the informed user’s assessment of the overall impression.

# INDIVIDUAL CHARACTER – OVERALL IMPRESSION

The impression is determined in light of the manner in which the product is used. Hence some features may be less important to the informed user.

The General Court ruled in [Joined Cases T-22/13 and T-23/13 Senz Technologies BV v OHIM—Impliva BV](#) ECLI:EU:T:2015:310, that even if the user sees certain products from only a limited perspective when using them, he or she will be aware of all the other perspectives at the time of use.

There is **no place for issues of consumer confusion** in design law. Design law is to protect designers - not consumers. Therefore, there is no point in the tribunal assessing whether consumers would be confused between two designs, and the court need not look at differences between pricing, packaging, functionality, technical capabilities, or channels of sale to determine infringement. How the product is purchased is irrelevant to design law, which protects designers, not consumers.

Whilst the issue of identity of designs arises in validity assessment, it does not arise in the test for infringement. Identical designs will obviously create the same overall impression to the informed user, but identity of the design and products is not required for a finding of infringement.

# INDIVIDUAL CHARACTER – OVERALL IMPRESSION

It is not necessary to describe **the 'overall impression' in words**. A design is by definition an aspect of appearance. The overall impression created on the informed user will be the impression created by seeing the design. The Court of Justice in [Case C-281/10 P PepsiCo Inc v OHIM—Grupo Promer Mon Graphic SA](#) ECLLEU: C:2011:679 has assessed overall impression without the need to describe in words what the two overall impressions were.

Similarity in respect of features imposed by design constraints will have less importance in the assessment of overall impression, as they will not attract the informed user's attention.

Similarity in respect of areas where the designer was free to develop the design will attract the informed user's attention, particularly where they are the aspects that are most visible to the user.

Differences that are not easily perceived by the informed user borne out by the goods actually marketed will have less impact on the informed user.

The General Court in [Case T-9/07 Grupo Promer Mon Graphic SA v OHIM—PepsiCo Inc](#) ECLI:EU:T:2010:96 held that as regards the assessment of the overall impression produced by the designs at issue on the informed user, the latter will automatically disregard elements that are totally banal and common to all examples of the type of product in issue and will concentrate on features that are arbitrary or different from the norm. However, the General Court in [Joined Cases T-22/13 and T-23/13 Senz Technologies BV v OHIM – Impliva BV](#), ECLI:EU:T. 2015.320 cautioned against focusing on just one dominant feature and ignoring other more common or more functional features (**the “banal features” approach**).

# INDIVIDUAL CHARACTER – OVERALL IMPRESSION

The issue of interaction of design freedom with a crowded design corpus, or what has been called the “**saturation of the state of the art**”, has arisen in a series of cases involving radiators, where the General Court upheld the Boards of Appeal’s finding on design freedom and noted that the finding that the designer’s freedom was not restricted by technical or statutory constraints in no way dealt with the question whether, de facto, there was a “saturation of the state of the art”, by reason of the existence of other designs for thermosiphons or radiators which have the same overall features as the designs at issue, a saturation of the state of the art which could be capable of making the informed user more attentive to the differences in the internal proportion of those different designs. Thus, the General Court in [Joined Cases T-83/11 and T-84/11 Antrax It Sri v OHIM— The Heating Company BVBA](#) ECLI:EU:T:2012:592, by affirming the Boards of Appeal, highlighted that restrictions on the freedom of the designer will be rare and restricted to technical or statutory constraints, while for most designs the design freedom will be broad. Nevertheless, we must not jump to the conclusion that for those designs, small differences will not be enough to create a different overall impression on the informed user. To the contrary, where the design corpus is crowded, the informed user will be able to tell the difference between designs that are actually quite close and will be looking for those differences.

Finally, whereas the “**banal features**” analysis removes small, commonplace features from the design and thus broadens its scope, the “**saturation of the state of the art**” doctrine tends to increase their importance, as the absence of large differences makes the informed user more attentive to small ones. It is also clear that the “banal features” analysis introduces the same danger of granting an enormous margin of discretion on part of judges. To the (very considerable) extent to which the two approaches are capable of conflicting, it is suggested that the “saturation of the state of the art” doctrine was envisaged by the legislator, has long been enshrined in national design law, is more in line with the assessment of the overall impression and is, therefore, a better tool than the “banal features” analysis.

# GROUNDS FOR INVALIDITY

Article 25 of the Regulation EU 2024/2822 sets out all the grounds for invalidity for Registered EU Designs and Unregistered EU Designs. The list of grounds is exhaustive—there are no other grounds for invalidity Case T-9/07 Grupo Promer Mori Graphic SA v OHIM—PepsiCo Inc ECLI:EU:T:2010:96.

Pursuant to article 25(1) of the Regulation EU 2024/2822, an EU design may be declared invalid only in the following situations: (a) the EU design does **not correspond to the definition under Article 3(1)**; (b) the EU design does **not fulfil the requirements of Articles 4 to 9**; (c) by virtue of a decision of competent court or authority, **the right holder is not entitled to the EU design under Article 14**; (d) if the **EU design is in conflict with a prior design** which has been made available to the public prior to or after the date of filing of the application, or if priority is claimed, the date of priority of the EU design, and which is protected from a date prior to the date of filing of the application, or if priority is claimed, the date of priority of the EU design; i) by a registered EU design, or an application for such a design subject to its registration, ii) by a registered design right of a Member State, or by an application for such a right subject to its registration, or iii) by a design right registered under the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs of 1999 (“the Geneva Act”), which has effect in the Union, or by an application for such a right subject to its registration; (e) a distinctive sign is used in a subsequent design, and Union law or the law of the Member State governing that sign confers on the right holder of the sign the right to prohibit such use; (f) the design constitutes an **unauthorised use of a work protected under the copyright law** of a Member State; (g) the design constitutes an **improper use of any of the items listed in Article 6ter of the Paris Convention for the Protection of Industrial Property** (“the Paris Convention”), or of badges, emblems and escutcheons other than those covered by that Article and which are of particular public interest in a Member State, and the consent of the competent authorities to the registration has not been given.

# GROUNDS FOR INVALIDITY

In relation to **Registered EU Designs**, invalidity can be tested either by **application to the EUIPO**, or by way of **counterclaim in infringement proceedings** before an EU Design Court. In relation to **Unregistered EU Designs**, validity can be tested by **application to the EU Design Court**, or by way of **counterclaim in infringement proceedings** before an EU Design Court.

**Bad faith is not a ground of invalidity.** At first blush, this could be considered a lacuna in the legislation; after all, bad faith is a ground of invalidity in EU-wide trade mark law. However, a more thorough examination suggests that all the potential occurrences of bad faith are dealt with under other articles. For example, if a third party applies in bad faith to register a design that it has previously seen disclosed, then anyone will be able to invalidate it on the basis of the prior disclosure, and the owner will be able to seek an order in a national court that it is the owner of the registered Community design. If a third party applies in bad faith to register a design which has not been publically disclosed, for example, the design applicant saw the design when under a duty of confidentiality.

This appears to have been the situation **in Case T-9/07 Grupo Promer Mori Graphic SA v OHIM—PepsiCo Inc** ECLI:EU:T:2010:96, where the rightful owner was able to invalidate PepsiCo's registered Community design application on the basis of an earlier registered Community design filing that had not been disclosed at the time of PepsiCo's application. Alternatively, Grupo Promer could have applied to a national court for a ruling on ownership under Article 14 of the Regulation EC 6/2002.

# GROUNDS FOR INVALIDITY

Lack of novelty and/or individual character are the two most frequent invalidity grounds invoked before the EUIPO or in counterclaim before an EU Design Court.

The Regulation EU 2024/2822 does not provide for invalidity of an EU design on the basis that it falls within the scope of protection of **an earlier patent**. Once it is published, a patent will constitute a prior design for the purposes of article 25(1)(b) invalidity.

Invalidity of an EU design, registered or unregistered, is **ex tunc** – once declared invalid by the EUIPO or an EU Design Court, rights in the design evaporate, and are deemed never to have existed.

Pursuant to article 26(1) of the Regulation EU 2024/2822, a Community design shall be deemed not to have had, as from the outset, the effects specified in this Regulation, to the extent that it has been declared invalid.

Article 26(2)(a) of the Regulation EC 6/2002 provides that the invalidity of a Community design **does not affect an earlier decision** which has acquired the authority of a final decision and been enforced.

Article 26(2)(a) of the Regulation EC 6/2002 provides that the invalidity of a Community design **does not affect any contract concluded prior to the invalidity decision**, in so far as it has been performed before the decision; however, repayment, to an extent justified by the circumstances, of sums paid under the relevant contract may be claimed on grounds of equity.

# INFRINGEMENT

Under the Regulation EC 6/2002 and harmonized European Union law under the Directive, the scope of protection of designs includes any design which does not produce on the informed user a different overall impression. Thus, to infringe a design, the allegedly infringing design must create on the informed user the same overall impression.

In any infringement action, or action for threatened infringement in those Member States that allow such an action, the EU Design Court starts with a presumption that the EU design is valid. The presumption of validity also applies in a national court dealing with an EU Design.

**Article 85(1) of the Regulation EC 6/2002** provides that in proceedings for infringement, or threatened infringement, of a Registered EU design, the EU Design Court shall treat the Registered EU design as valid. Validity may only be challenged with a counterclaim for invalidity.

**The presumption of validity** applies to Registered EU designs only once they are registered and it does not apply to applications for Registered EU designs.

# INFRINGEMENT

There are **four ways to rebut the presumption of validity** of a registered Community design:

First, many claims for infringement will be met with counterclaims for invalidity so that the presumption of invalidity will be removed, and the court will be required to assess the validity of the design under the counterclaim.

Second, in provisional measures cases, the presumption of validity can be lifted by a mere plea, without the need to file a counterclaim (**article 90(2) the Regulation EC 6/2002**). In such cases, the alleged infringer may argue invalidity without filing a counterclaim, and the EU Design Court may take the validity of the Registered EU design into account in deciding whether or not to grant provisional measures. Any finding of the court in relation to validity does not affect the status of the Registered EU design at the EUIPO - that is, the EU Design Court cannot, in a provisional measures case, declare the registered Community design to be invalid.

Third, the presumption of validity is also lifted if the alleged infringer owns 'an earlier national design right' within the meaning of **Article 25(1)(d)**. In such a case, a plea of invalidity is sufficient, without the need for a counterclaim.

Fourth, the presumption of validity can be lifted by challenging the validity of the Registered EU design at the EUIPO. This is likely to invoke **Article 91 of the Regulation EC 6/2002**, with either the EUIPO or the EU Design Court staying its proceedings, depending on which was filed first and whether there are special grounds.

# INFRINGEMENT

Unlike the Registered EU designs, for Unregistered EU designs there is no starting presumption of validity brought about by the act of registration. In order to take advantage of the presumption of validity of Unregistered EU designs, the rights holder must first produce proof that the conditions laid down in [Article 11 of the Regulation](#) have been met and indicate what constitutes the individual character of the Unregistered EU design ([article 85\(2\) of the Regulation EC 6/2002](#)).

The Court of Justice in [Case C-345/13 Karen Millen Fashions Limited v Dunnes Stores and Another](#) ECLI:EU:C:2014:206 noted that “Although, given the lack of registration formalities for this category of design, it is necessary for the holder of the design at issue to specify what he wants to have protected under [the Design Regulation], it is sufficient for him to identify the features of his design which give it individual character”. Therefore, if the unregistered Community design holder proves first disclosure of the design in the European Union and indicates the individual character of the design, the presumption of validity arises.

As with Registered EU designs, the presumption of validity of Unregistered EU designs can be contested by way of plea or with a counterclaim for declaration of invalidity ([article 85\(2\) of the Regulation EC 6/2002](#)). The results are slightly different, as a plea may result only in a finding *inter partes*, whereas a declaration of invalidity following a counterclaim is *contra mundum*. [Article 90\(2\) of the Regulation EC 6/2002](#) enables any presumption of validity of an Unregistered EU design to be lifted by a plea in preliminary measure cases, without the requirement for a counterclaim.

# INFRINGEMENT – RIGHTS CONFERRED

**The rights conferred** by an EU design, registered and unregistered, are described in [Article 19 of the Regulation EU 2024/2822](#).

[Article 19\(1\)](#) confers on the holder of a Registered EU design the exclusive right to use the design and to prevent any third party, not having his/her consent, from using it. Use in this context covers, in particular, the 'making, offering, putting on the market, importing, exporting, or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes'.

Holders of Unregistered EU designs are afforded the same rights under [article 19\(2\) of the Regulation EC 6/2002](#), with one important qualification. The holder of an Unregistered EU design is only entitled to prevent such uses of the design if they result from the 'copying' of the protected design.

These rights only last for the duration of the Registered or Unregistered EU design in question.

The issue of whether a Registered EU design is a right to use or a right to prevent third party use was decided by the Court of justice in the [Case C-448/10 Celaya Emparanza y Galdos Internacional SA v Proyectos Integrales de BalizamientoSL](#) ECLI:EU:C:2012:88, where it was held that a registered Community design does not confer a right to use, but it only confers a right to the design holder to prevent third parties from using the design, and any design which does not create a different overall impression on the informed user.

[Article 19\(1\) of the Regulation EU 2024/2822](#) sets out those acts which a Registered EU design holder may prevent, but the list is not exhaustive. There may be other ways of using a design which are elucidated by the Court of Justice over time.

# INFRINGEMENT – RIGHTS CONFERRED

The Registered EU design holder is entitled to prevent making, offering, putting on the market, importing, exporting, or using the infringing product or stocking the product for those purposes. It is submitted that the legislator intended to cover the whole supply chain. The manufacturer within the European Union or importer from outside the European Union; the warehouser (stocking for putting on the market); the wholesaler and retailer; a rental or hiring agency; an exporter sending the product outside the European Union; and the end user.

The **Regulation EC 6/2002** does not include any notion of **innocent infringement or intention to infringe**. The scope of protection set out in **Article 10(1)** is clear. A design that creates the same overall impression on the informed user as a registered Community design will infringe. The intention of the allegedly infringing party is irrelevant.

Unlike EU trade mark law, under the Regulation EC 6/2002, **there is no requirement to prove use of an EU design, or a national or Benelux registered design**, in order to be able to enforce it. Therefore, the monopoly for Registered EU designs and national and Benelux registered designs can be maintained for up to 25 years without ever having to prove that the design has been used or put to 'genuine use'. Taking into account the fact that designs protect designers, not consumers, there is no requirement to commercialize a design in order to protect it or maintain its protection **Case 06/07360 La Societe Reckitt Benckiser France v La Societe Procter et Gamble PIBD 2007 856 (Cour d' Appel de Paris)**.

# DEFENSES TO INFRINGEMENT

The main **defenses to infringement of an EU design** are: (a) that the design rights are exhausted, (b) that the allegedly infringing use commenced prior to the Registered EU design filing, (c) that the design is a visible component part of a complex product being used to restore its original appearance (currently not a defense in all member states), (d) uses by governments of member states for essential defense and security needs.

In addition, the **Regulation EC 6/2002** puts limits on the enforcement of EU design rights against certain uses that would, in other circumstances, constitute infringement: (a) acts done privately and for non-commercial purposes, (b) acts done for experimental purposes, (c) acts done for citation or teaching, (d) ships and aircraft registered outside the European Union on a temporary visit, (e) spare parts and accessories for repairing such craft and (f) the execution of repairs to such craft.

It should be noted that invalidity of the design right relied on, is not a defense to infringement. Nevertheless, in reality, a counterclaim for invalidity will form part of the response to the commencement of most EU and national or Benelux registered design infringement proceedings. The onus rests on the defendant to prove invalidity, either in a counterclaim or an invalidity action before the EUIPO.

# DEFENSES TO INFRINGEMENT

**a) Exhaustion of design rights** Article 21 of the Regulation EU 2024/2822 provides that the rights conferred by an EU design shall not extend to acts relating to a product in which a design included within the scope of protection of the EU design is incorporated or to which it is applied, when the product has been put on the market in the European Economic Area by the holder of the EU design or with his consent.

According to this provision, which is relevantly identical to EU-wide law on trade marks, once a product incorporating a design or to which a design has been applied, has been put on the market within the European Economic Area (EEA) by the design holder, or with his/her consent, the design holder cannot object to the re-marketing of the product within the EEA. Once sold within the EEA for the first time, the design holder's rights are said to be 'exhausted'. The design holder is, in effect, only entitled to the benefit of his/ her voluntary first marketing of the product.

Exhaustion only applies on an EEA-wide basis. A design holder can still prevent the importation of a genuine product from outside the EEA, so long as he/she has not consented to the importation of the product into the EEA, in which case, the product will be put on the EEA market with the consent of the design holder. Consent must be clear and express.

# DEFENSES TO INFRINGEMENT

**b) Prior use** Article 22 of the Regulation EC 6/2002 provides that “1. A right of prior use shall exist for any third person who can establish that before the date of filing of the application, or, if a priority is claimed, before the date of priority, he has in good faith commenced use within the Community, or has made serious and effective preparations to that end, of a design included within the scope of protection of a registered Community design, which has not been copied from the latter. 2. The right of prior use shall entitle the third person to exploit the design for the purposes for which its use had been effected, or for which serious and effective preparations had been made, before the filing or priority date of the registered Community design. 3. The right of prior use shall not extend to granting a licence to another person to exploit the design. 4. The right of prior use cannot be transferred except, where the third person is a business, along with that part of the business in the course of which the act was done or the preparations were made.

This article provides a prior user with rights to continue prior use in certain limited circumstances, despite otherwise infringing a later filed Registered EU design. The right of prior use applies only to Registered EU designs, and not to Unregistered. As infringement of Unregistered EU designs requires proof of copying, it would not be sensible to provide for a right of prior use. Any third party acting in good faith cannot have copied an existing Unregistered EU design, and so infringement of the unregistered right does not arise.

This defense will arise rarely, since a prior user would prefer to invalidate the registered Community design in question by invoking a relevant prior disclosure.

# DEFENSES TO INFRINGEMENT

As this defense is an exception to registered Community design protection, it is submitted that Article 22 should be interpreted narrowly **Case C-465/04 Honyvem Informazioni Commerciali Srl v Mariella De Zotti** ECLEEU: 2006:199.

**The prior use must be in 'good faith', and not in bad faith.** There must also be 'use' according to the broad definition given to 'use' in **article 19(1) of the Regulation EC 6/2002**. The use claimed must be in the EU. Use outside the EU will not give rise to an article 22 defense, but it may be a relevant disclosure, destroying novelty.

As an alternative to proving good faith prior use in the EU, the alleged infringer will also have a defense if it can prove that good faith serious and effective preparations have been made. As preparations to use are more unlikely to be novelty destroying than actual use, it is possible that good faith preparations are more regularly relied on than good faith prior use. Unlike prior use, the preparations do not need to be in the EU, but they must be preparations to *use* in the EU.

The right to prior use cannot be granted under a license to a third party (**article 22(3) of the Regulation EC 6/2002**), nor can it be assigned, given away or otherwise transferred, except alone with that part of the business in the course of which the prior acts were done (**article 22(4) of the Regulation EC 6/2002**).

# DEFENSES TO INFRINGEMENT

**c) repair of complex products** While design rights may subsist in component parts of complex products which are visible during normal use, as above-mentioned, those rights are not enforceable against a third party repairing the complex product so as to restore its original appearance.

According to Recital 13 of the Regulation EC 6/2002 “Full-scale approximation of the laws of the Member States on the use of protected designs for the purpose of permitting the repair of a complex product so as to restore its original appearance, where the design is applied to or incorporated in a product which constitutes a component part of a complex product upon whose appearance the protected design is dependent, could not be achieved through Directive 98/71/EC.

Contradictory interests were at stake: on one side, manufacturers (the car industry in particular) were unwilling to allow sales of replica parts (e.g. spare parts that are replicas of the original parts) so as not to lose their market, while on the other, consumers and other industries were willing to enable sales of such replicas to guarantee true competition and lower prices. In addition, EU consumers are currently spending €415-664 million annually on the purchase of visible automotive spare parts.

To resolve the issue, an interim compromise solution – **a freeze plus clause** – was adopted. Under this clause, which is still in force today, Member States are obliged to retain their existing laws on whether spare parts should benefit from protection until amendments to the Directive are adopted on a proposal from the Commission. They can only change these laws if their aim is to liberalise the market. Competition in spare parts is currently allowed in 12 Member States.

The **Community Design Regulation** temporarily introduced a sort of repair clause in its **Article 110**, which excluded spare parts from the requirement to obtain design protection.

# DEFENSES TO INFRINGEMENT

As an exception to the protection of design rights, Article 110 should be interpreted narrowly **Case C-465/04 Honyvem Informazioni Commerciali Srl v Mariella De Zotti** ECLI:EU:C: 2005:199.

The Court of Justice introduced a number of clarifications to **the repair clause** in the **Joined Cases C-397/16 and C-435/16, Acacia Srl Pneusgarda Srl, in insolvency, Audi AG (C-397/16) and Acacia Srl, Rolando D'Amato Dr. Ing. h.c. F. Porsche AG (C-435/16)**, ECLI:EU:C:2017:992, by confirming that the clause covered all spare parts without limitations, regardless of shape, provided the repair served to restore the original appearance, namely that: i) it covers all spare parts (i.e. that it applies to both fixed (e.g. wing mirrors) and non-fixed (e.g. wheel rims) spare parts); ii) it only covers spare parts that are necessary for the normal use of the complex product, such as wheel rims; iii) it only covers parts used to repair the complex product so as to restore its original appearance; iv) spare parts manufacturers must inform the downstream user that the part is intended exclusively to be used for repairing the complex product to restore its original appearance. Furthermore, they must ensure that downstream users comply with this requirement.

**Article 19** of the **Directive 2024/2823** and **Article 20a** of the **Regulation EU 2024/2822** addressed the **repair clause**, by making it clear that the holder of a design relating to a spare part cannot exercise a monopoly and cannot prevent a third party from placing on the market spare parts destined for repairing a product or restoring it to its original appearance. The repair clause also provided that designs already granted protection would remain covered for a transitional period of 10 years.

# DEFENSES TO INFRINGEMENT

**(d) government use** Pursuant to [article 23 of the Regulation EC 6/2002](#) any provision in the law of a Member State allowing use of national designs by or for the government may be applied to EU designs, but only to the extent that the use is necessary for essential defense or security needs.

The defense is drafted in broad terms and includes any provisions of national law which allow use 'by or for the government'. However, there are several restrictions which suggest that the defense may not be as broadly drafted as all that.

First, Article 23 only allows the extension of laws relating to national designs. Thus, a member state cannot treat EU designs less favourably to rights holders than it treats national designs. Article 23 is not restricted to existing national laws. Consequently, a Member State could introduce new laws, but the new laws would have to apply to both national and EU designs.

Second, the use must be 'necessary' for defense or security needs. This would appear to be an objective question of fact, although a court may well rely on the Member State's government's view of what is 'necessary'.

Third, the defense and security needs must be 'essential'. This would also appear to be an objective question of fact.

Fourth, article 23 does not require that the use of the Community design be allowed free of charge and the national law may provide for appropriate compensation for the community design holder.

# LIMITATION OF RIGHTS

**Limitation of the rights conferred by a Community design** Pursuant to [article 20 of the Regulation EU 2024/2822](#) “1. The rights conferred by an EU design shall not be exercised in respect of: (a) acts carried out privately and for non-commercial purposes; (b) acts carried out for experimental purposes; (c) acts of reproduction for the purpose of making citations or of teaching, (d) acts carried out for the purpose of identifying or referring to a product as that of the design right holder, (e) acts carried out for the purpose of comment, critique or parody, (f) the equipment on ships and aircraft that are registered in a third country and that temporarily enter the territory of the Union, (g) the importation into the Union of spare parts and accessories for the purpose of repairing ships and aircraft referred to in point, (h) the execution of repairs on ships and aircraft referred to in point (f). 2. Paragraph 1, points (c), (d) and (e), shall only apply where the acts are compatible with fair trade practices and do not unduly prejudice the normal exploitation of the design, and in the case referred to in point (c), where mention is made of the source of the product in which the design is incorporated or to which the design is applied.

In these instances, EU design rights, registered and unregistered, will still subsist, but will be unenforceable against defendants who meet these requirements. As exceptions to the right to enforce a registered or unregistered Community design, they should be interpreted narrowly [Case C-465/04 Honyvem Informazioni Commerciali Sri v Mariella De Zotti](#) ECLI:EU:C: 2005:199.

# LIMITATION OF RIGHTS

**Good faith use** is not a defense to infringement. For Unregistered EU designs copying will need to be proved, but no bad faith is required. For Registered EU designs, the knowledge of the prior design or intention of the alleged infringer to infringe, is irrelevant.

**Freedom of expression** Defenses to infringement set out in the Regulation would appear to constitute an exhaustive list. However, in the [Case 3895261 KG ZA 11-294 Plesner Joensen v Louis Vuitton Malletier SA](#) ECLI:NL:RBSGR: 2011:BQ3525, the court declined to enforce a registered Community design against an artist using the holder's design for political purposes. Both parties relied on their fundamental rights as set out in the European Convention on Human Rights and accompanying protocols. The artist Plesner pleaded that her work was protected by the article 10 guarantee of freedom of expression and the registered Community design holder Louis Vuitton relied on Article 1 of Protocol 1 relating to the protection of property, including intellectual property. The court held that the interest of Plesner to continue to be able to express her artistic opinion through the work 'Simple Living' should outweigh the interest of Louis Vuitton in the peaceful enjoyment of its possession. Opposite Louis Vuitton's fundamental right to peaceful enjoyment of its exclusive rights to the use of the design, there is, according to established case law of the European Court of Human Rights, the fundamental right of Plesner that is high in a democratic society's priority list to express her opinion through her art.

# THE PROPOSED REFORMS TO THE EU LEGAL FRAMEWORK FOR DESIGN PROTECTION

The EU design legislation has proven its effectiveness in design protection by helping to foster innovation and competition.

However, **significant shortcomings** include:

- a patchwork of diverging national regimes partly providing design protection for spare parts and partly not (right holders are granted a genuine monopoly on the spare parts aftermarket in the Member States concerned);
- lack of alignment of design protection to the digital transition and to technological progress;
- outdated or overly complicated procedural rules with a registration procedure for EU design that involves a sub-optimal RCD fee system;
- different national-level proceedings for design registration and design invalidity.

The **main strategic objective** of the [revision of the Community Design Regulation](#) and the parallel proposal for [recasting the Design Directive](#) is to promote design excellence, innovation and competitiveness in the EU. Achieving this depends on ensuring that the overall design protection system is updated to meet the demands of the digital age, substantially more accessible and efficient for individual designers, SMEs and design intensive industries in terms of lower costs and complexity, increased speed, greater predictability and legal certainty.

# THE PROPOSED REFORMS TO THE EU LEGAL FRAMEWORK FOR DESIGN PROTECTION

**Proposed reforms common to both proposals include:**

1. Amending the definitions of “design” and “product” in response to technological advancements such as NFTs and the metaverse and providing greater legal certainty and clarity as to the eligible subject matter of design protection. In particular, a “design” will also extend to the movement, transition or any other sort of animation of the design’s features. The definition of “product” will also be updated to include products not embodied in physical objects and products that materialize in a digital form, as well as spatial arrangement of items intended to form an interior environment and graphical user interfaces;
2. Adding a specific provision whereby design protection is conferred only on those features of appearance, which are shown visibly in the application for registration;
3. Adjusting the scope of rights conferred by a registered design to include 3D printing technologies, by subjecting to the right holder’s authorization the creation, downloading, copying and making available of any medium or software recording the design for the purpose of reproducing a product that infringes the design;
4. Permitting rights holders to prevent counterfeit products transiting through EU territory or being placed in another customs situation without being released for free circulation there;

# THE PROPOSED REFORMS TO THE EU LEGAL FRAMEWORK FOR DESIGN PROTECTION

5. Enshrining the existing case law of the Court of Justice of the European Union by adding permissible uses such as “referential use” and “critique and parody”;
6. Aligning the formerly transitional “repair clause” with the case law of the Court of Justice and including it as a permanent provision, by excluding protection for a design which constitutes a component part of a complex product for the purpose of the repair of that complex product so as to restore its original appearance. This clause can be used as a defense against infringement claims only if consumers are duly informed of the origin of the product to be used for repairing the complex product;
7. Including the possibility of a design notice, so that rights holders can inform the public that a design was registered.

Both proposals introduced **broader definitions for the terms 'product' and 'design'**, to ensure modernisation and greater legal certainty. The definition of product included a technology update of the design framework by taking into account the advent of new designs that are not embodied in physical products and objects that materialise in digital form. The **proposals clarified the 'visibility requirement'**, by conferring design protection only on those features of appearance that are shown visibly in the application for registration. The proposals provided **a wider scope of rights to fight design infringement and counterfeiting in the context of the deployment of 3D printing technologies** facilitating copying of protected designs; and the placement of counterfeit products in customs procedures (in line with the EU legislation on trademarks).

# THE PROPOSED REFORMS TO THE EU LEGAL FRAMEWORK FOR DESIGN PROTECTION

## **Proposed reforms specific to the Community Design Regulation include:**

1. Replacing the old term “Registered Community Design” with the new term “Registered EU Design”;
2. Including several amendments to further streamline registered design proceedings before the EUIPO and ensure consistency with the EU trade mark regime;
3. Reducing the level of application fees to make design registrations cheaper for individual designers and simplifying the schedule of registration fees to increase transparency.

## **Proposed reforms specific to the Design Directive include:**

1. Limiting design protection under national laws to registered design protection and revoking the earlier permission for Member States to include protection for unregistered designs;
2. Clarifying that design protection only commences with design registration, to avoid inconsistencies;

# THE PROPOSED REFORMS TO THE EU LEGAL FRAMEWORK FOR DESIGN PROTECTION

3. Including **a presumption of ownership**, in alignment with the existing Articles 14 (vestige of title) and 17 (presumption in favour of the registered design holder) of the Community Design Regulation;
4. **Exhaustively listing the grounds for non-registrability**, to minimize costs and difficulties connected to procedures for the obtention of registered design rights;
5. **Including a presumption of validity**, to bring the Design Directive in alignment with the Community Design Regulation;
6. **Granting the formerly transitional repair clause (unlimited) instant legal effect only for the future**, while safeguarding protection of existing rights for a transitional 10-year period;
7. Including **a right of prior use as a good faith defense against infringement**, to bring the Design Directive in alignment with the Community Design Regulation;
8. Requiring national laws to provide for an **administrative procedure for challenging the validity of a design registration** to be handled by their intellectual property offices, instead of reserving invalidity proceedings to national courts.

# MAIN PROVISIONS OF THE REFORMS TO THE EU LEGAL FRAMEWORK FOR DESIGN PROTECTION

**Repair clause for spare parts** The reforms aimed to make it clear that the holder of a design relating to a spare part cannot exercise a monopoly and cannot prevent a third party from placing on the market spare parts destined for repairing a product or restoring it to its original appearance.

**Simplified and streamlined design registration procedure** The reforms aimed to make it easier to submit design registration applications by using electronic means (e.g. by submitting video files). In addition, **Article 27 of the Design Directive** and **Article 37 of the Design Regulation** abolished the '**unity of class requirement**', by providing for the possibility to combine several designs in one application (e.g. multiple design applications with a maximum cap of 50 designs). This will change the current procedure requiring that the combined designs concern products of the same class from the **Locarno Classification**.

**Adjustment of EU design fees** The amended Community Design Regulation repeals the existing Fees Regulation (**Regulation (EC) No 2246/2002**). In addition, it adjusts and optimises the level and structure of fees payable for RCDs. More specifically, it reduces the level of the application fee and simplifies the schedule of fees to make design protection more affordable (e.g. merging the registration and publication fees as well as introducing a flat bulk discount for multiple applications).

# CONCLUSIONS

European Union-wide design law has only been in place for 20 years, since **Regulation EC 6/2002** entered into force on 6 March 2002. In this short time, a substantial and remarkable **jurisprudence under Regulation EC 6/2002** has developed by the Boards of Appeal, the General Court and the Court of Justice, as well as the national courts and the Community Design Courts in Member States.

The **Designs Directive** and **Community Design Regulation** have just been reformed. It should be noted that, in general, the legislative initiatives package fulfils its primordial aims to modernise provisions, make design protection more efficient and accessible in the digital age.

Specifically, it tailors design and product definitions to allow for the protection of digital designs, including virtual spaces, graphical user interfaces, and clarifies the subject matter of design protection. It expands the scope of design rights to fight infringement and counterfeiting in the areas of 3D printing and the placement of counterfeit products in customs situations. It also adjusts the fee structure and levels to make EU designs more affordable for SMEs and individual designers. Furthermore, it finally opens up the spare parts aftermarket for competition. It adds some principal procedural rules to the already existing substantive ones in order to ensure harmonisation of design protection across the EU and thus complementarity and interoperability between the European and national design systems.