

Recent EU case-law on design validity

by Professor Răzvan Dincă, PhD, Vice Dean,
Faculty of Law, University of Bucharest

NOVELTY. PROOF FOR DISCLOSURE.

JUDGMENT OF THE GENERAL COURT (Fourth Chamber) 27 February 2018 (*) In Case T-166/15, Claus Gramberg v EUIPO

“22 According to case-law, a design is therefore deemed to have been made available once the party relying thereon has proven the events constituting disclosure. In order to rebut that presumption, the party disputing disclosure must establish to the requisite legal standard that, in the circumstances of the case, it cannot reasonably be assumed that those events have become known in the normal course of business to the specialist circles in the sector concerned (judgment of 21 May 2015, *Senz Technologies v OHIM — Impliva (Umbrellas)*, T-22/13 and T-23/13, EU:T:2015:310, paragraph 26).

23 The disclosure of an earlier design cannot be proven by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence of actual disclosure of the earlier design on the market (see judgment of 9 March 2012, *Coverpla v OHIM — Heinz-Glas (Flacon)*, T-450/08, not published, EU:T:2012:117, paragraph 24 and the case-law cited).”

NOVELTY. PROOF FOR DISCLOSURE.

JUDGMENT OF THE GENERAL COURT (Second Chamber)

23 October 2018 (*) in Case T-672/17, Mamas and Papas Ltd v EUIPO

“48 Therefore, in the course of the examination of the lack of novelty of a design, an overall assessment must be carried out which takes into account all the relevant factors in the particular case. In addition, the elements of evidence provided by the invalidity applicant must be assessed in relation to each other. Whilst some of that evidence might be insufficient on its own to prove the disclosure of an earlier design, the fact remains that, when combined or read in conjunction with other documents or information, it may nevertheless contribute to establishing disclosure. Lastly, in order to assess the evidential value of a document, it is necessary to verify the plausibility and the accuracy of the information which that document contains. Account must be taken of, inter alia, the origin of the document, the circumstances of its preparation and its recipient, and whether it seems from the content to be sensible and reliable (see judgment of 14 July 2016, Decorative graphical symbols, T-420/15, not published, EU:T:2016:410, paragraph 27 and the case-law cited).”

NOVELTY. DISCLOSURE TO THE PUBLIC.

JUDGMENT OF THE COURT (Fourth Chamber)

**21 September 2017 (*) in Joined Cases C-361/15 P and C-405/15 P,
TWO APPEALS, respectively, Easy Sanitary Solutions BV, EUIPO**

“102 It follows from the travaux préparatoires for Regulation No 6/2002 that the purpose of the exception in Article 7(1) of that regulation, relating to cases in which certain events, listed in that provision, cannot constitute a disclosure to the public, is to ensure that events that are difficult to verify and that occur in a third country are not capable of constituting such disclosure, and not to make a distinction between various business sectors within the European Union and to exclude the possibility that events that relate to a business sector that cannot reasonably be known to the specialised circles of another sector within the European Union may constitute a disclosure to the public.”

“128 When a design is considered to have been made available to the public, within the meaning of Article 7(1) of Regulation No 6/2002, that disclosure is valid for the purposes of the assessment both of novelty, within the meaning of Article 5 of that regulation, of the design to which the disclosed design is compared, and of the individual character of that first design, within the meaning of Article 6 of that regulation.”

NOVELTY. DISCLOSURE TO THE PUBLIC.

JUDGMENT OF THE COURT (Fourth Chamber)

**21 September 2017 (*) In Joined Cases C-361/15 P and C-405/15 P
TWO APPEALS, respectively, Easy Sanitary Solutions BV, EUIPO**

“129 In addition, as follows from paragraphs 98 to 103 of this judgment, the ‘sector concerned’, within the meaning of Article 7(1) of Regulation No 6/2002, is not limited to that of the product in which the contested design is intended to be incorporated or to which it is intended to be applied.

130 The General Court’s finding, set out in paragraph 132 of the judgment under appeal, amounts to saying that, for the purposes of examining the individual character of a design, within the meaning of Article 6(1) of Regulation No 6/2002, the earlier design, whose disclosure to the public has been proved, within the meaning of Article 7(1) of that regulation, must be known to the informed user of the contested design.

131 However, nothing in Article 7(1) permits the conclusion that it is necessary for an informed user of the product in which the contested design is incorporated or to which it is applied to know the earlier design when it is incorporated in a product in an industry sector that differs from the relevant sector for the contested design, or is applied to such a product.”

INDIVIDUAL CHARACTER. OVERALL IMPRESSION.

JUDGMENT OF THE GENERAL COURT (First Chamber)

13 June 2017 (*) in Case T 9/15

Ball Beverage Packaging Europe Ltd v EUIPO

“76 The overall impression referred to concerns an overall visual impression produced by the visible characteristics of the design at issue. That finding follows from Article 3(a) of Regulation No 6/2002, which defines ‘design’ as ‘the appearance of a product or part of it, resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation’. That finding follows also from Article 10(1) of Regulation No 6/2002, which in all the language versions, refers to an overall impression, which, as the General Court has already held, can only be visual (see judgment of 18 March 2010, Grupo Promer Mon Graphic v OHIM — PepsiCo (Representation of a circular promotional item), T-9/07, EU:T:2010:96, paragraph 50).”

“78 According to the case-law, the individual character of a design results from an overall impression of difference or lack of ‘déjà vu’, from the point of view of an informed user, in relation to any previous presence in the design corpus, without taking account of any differences that are insufficiently significant to affect that overall impression, even though they may be more than insignificant details, but taking account of differences that are sufficiently marked so as to produce dissimilar overall impressions

79 The comparison of the overall impressions produced by the designs must be synthetic and may not be limited to an analytic comparison of a list of similarities and differences. That comparison must relate solely to the elements actually protected, without taking account of characteristics excluded from the protection.”

**INDIVIDUAL CHARACTER.
THE NOTION OF INFORMED USER.
JUDGMENT OF THE GENERAL COURT (Fifth Chamber)
29 November 2018 (*), in Case T-651/17
Sata GmbH & Co. KG v EUIPO**

“20 The notion of informed user 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 rule, makes no direct comparison between the trade marks at issue, and the sectoral expert, who is an expert with detailed technical expertise. Thus, the notion 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 (see judgment of 15 October 2015, Part of door, T-251/14, not published, EU:T:2015:780, paragraph 43 and the case-law cited).”

“54 In accordance with case-law, although saturation of the state of the art cannot be said to limit the freedom of the designer, it may, once proven, make the user more attentive to the differences of detail between the conflicting designs. Consequently, a design may, due to saturation of the state of the art, have individual character resulting from features which, in the absence of saturation, would not tend to give rise to a different overall impression for an informed user(see judgment of 29 October 2015, Single control handle faucet, T-334/14, not published, EU:T:2015:817, paragraph 83 and the case-law cited).”

INDIVIDUAL CHARACTER
DEGREE OF FREEDOM OF THE DESIGNER.
JUDGMENT OF THE GENERAL COURT (Fifth Chamber)

4 July 2017, in Case T-90/16

**Thomas Murphy v EUIPO, intervener before the General Court, being
Nike Innovate CV**

“36 The degree of freedom of the designer of a design is determined by, inter alia, 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 to which the design is applied. Those constraints result in a standardisation of certain features, which will thus be common to the designs applied to the product concerned (see judgment of 10 September 2015, Handbags, T-525/13, EU:T:2015:617, paragraph 28 and the case-law cited).

37 Consequently, the greater the freedom of the designer in developing a design, the less likely it is that minor differences between the designs being compared will be sufficient to produce a different overall impression on an informed user. Conversely, the more the freedom of the designer in developing a design is restricted, the more likely it is that minor differences between the designs being compared will be sufficient to produce a different overall impression on an informed user. Therefore, if the designer enjoys a high degree of freedom in developing a design, that reinforces the conclusion that the designs being compared, which do not display significant differences, will produce the same overall impression on an informed user (see judgment of 10 September 2015, Handbags, T-525/13, EU:T:2015:617, paragraph 29 and the case-law cited).”

INDIVIDUAL CHARACTER. FREEDOM OF THE DESIGNER.

JUDGMENT OF THE GENERAL COURT (Fourth Chamber)

18 July 2017 (*)

In Case T 57/16

Chanel SAS v EUIPO

“31 However, it must be borne in mind that the factor relating to the freedom of the designer cannot on its own determine the assessment of the individual character of a design, but that it is, however, a factor which has to be taken into consideration in that assessment. It is a factor which makes it possible to moderate the assessment of the individual character of the contested design, rather than an independent factor which determines how different two designs have to be for one of them to demonstrate individual character. Consequently, the factor relating to the designer’s degree of freedom may reinforce or, a contrario, moderate the conclusion as regards the overall impression produced by each design at issue.”

TEHNIICAL FUNCTION.

JUDGMENT OF THE COURT (Second Chamber)

8 March 2018 (*)

REQUEST for a preliminary ruling under Article 267 TFEU from the Higher Regional Court, Düsseldorf, Germany

“31 In light of the foregoing, it must be held that Article 8(1) of Regulation No 6/2002 excludes protection under the law on Community designs for features of appearance of a product where considerations other than the need for that product to fulfil its technical function, in particular those related to the visual aspect, have not played any role in the choice of those features, even if other designs fulfilling the same function exist.

32 Therefore, the answer to the first question is that Article 8(1) of Regulation No 6/2002 must be interpreted as meaning that in order to determine whether the features of appearance of a product are exclusively dictated by its technical function, it must be established that the technical function is the only factor which determined those features, the existence of alternative designs not being decisive in that regard.”

TEHNICAL FUNCTION.

JUDGMENT OF THE COURT (Second Chamber)

8 March 2018 (*)

**REQUEST for a preliminary ruling under Article 267 TFEU from the
Higher Regional Court, Düsseldorf, Germany**

“33 By its second question, the referring court asks essentially whether Article 8(1) of Regulation No 6/2002 must be interpreted as meaning that in order to determine whether the relevant features of appearance of a product are exclusively dictated by its technical function, that finding must be based on the perception of the ‘objective observer’.”

“36 In that connection, having regard to the objective pursued by Regulation No 6/2002, which, as is clear from paragraph 28 of the present judgment, consists, in particular, in creating a Community design directly applicable and protected in all the Member States, it is for the national court, in order to determine whether the relevant features of appearance of a product are covered by Article 8(1) thereof, to take account of all the objective circumstances relevant to each individual case.”

Thank you!

razvan.dinca@razvandinca-legal.ro