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# EUROPEAN UNION DESIGN LAW

A Practitioners' Guide

DAVID STONE

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*Simmons & Simmons LLP*



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*For Andrew*

## FOREWORD

International design protection has existed for a long time. Since the Paris Convention of 1883 there has been a requirement for protection of industrial property rights in general and the specific obligation to protect designs was included in the Lisbon revision of the Convention in 1958.

However, the precise definition of the design, the appreciation of its novelty, and the minimum duration of its protection are still not included in the Paris Convention today. Because it is not harmonized internationally, design law has long been the 'poor child' of intellectual property protection. Even the nature of the protection is largely left to the parties of the Paris Convention. As a result, countries can either create a specific regime to protect designs or apply other intellectual property laws to them. All possible legal regimes exist in the world. Some countries apply patent law, others copyright or unfair competition.

Not only does the nature of the right differ from jurisdiction to jurisdiction, but its efficiency changes in scope and strength. Many jurisdictions currently only protect designs against slavish copying, or accept that identical designs are equally protected unless copying is proved. Combining design rights with other intellectual property rights is also treated differently. Some countries accept that a design can be protected at the same time through a registered design and a copyright (*droit d'auteur*). Other traditions do not accept such combinations.

The absence of international harmonization also has a major advantage: it allows contracting parties to invent new laws that give adequate protection, fully taking into account new realities. This is exactly what the EU legislature did. The adoption of the Design Directive harmonizing the laws of the Member States and the Regulation on the Community Design was a milestone in the intellectual property policy of the EU and beyond. It was based on the recognition that 'design' has become ever more important for product differentiation and product appeal in general.

The legislation was initiated by the Max Planck Institute in Munich, which made a study of the legal protection of design in the member states. This study strongly advocated the need for a new, harmonized, modern, and flexible design law as well as the creation of a unitary Community design. The new Community design that emerged is a two-tier system with, on the one hand, an unregistered design right and, on the other hand, a registered design.

After long debate, the new right introduced major legal novelties. The notion of individual character, for example, allows for the protection of creations that really constitute an addition to the prior art. At the same time this notion allows a broader scope of protection for designs.

This book by David Stone gives an historic overview of the genesis of the legislation, allowing the reader to understand better the context of the lawmaking and the importance of its results. It also provides a precise and authoritative view of the law as it is understood by the legislature and applied by both OHIM and judges. All aspects of the complex new legislation are studied.



David is one of the most influential and knowledgeable specialists of design law in Europe. He also possesses the rare gift of being able to communicate his enthusiasm for everything related to design with others—something that makes him a pleasure to work with.

It is no surprise, therefore, to find that this book is not a theoretical paper meant to satisfy the academic—even if experts will also find a lot to learn from it. On the contrary, it gives documented and readily understandable answers to central questions any practitioner or designer may be confronted with. It also gives a good view of the sometimes different approaches given by IP offices and judges. The two case studies in Chapter 22 illustrate this superbly.

Successful handbooks are meant to be updated regularly as the practice evolves. I warmly wish this work all the success it deserves so that its author will continue to keep us updated on design law in the European Union.

António Campinos  
President, OHIM

## PREFACE

The introduction of a new intellectual property right is an event to be celebrated. Some ten years on from the harmonization of registered design law across the European Union, and nearly ten years from the first acceptance by OHIM of applications for registered Community designs, the celebration continues, as the new rights are found to be cost-effective, enforceable, and hence valuable. Any entity trading in the European Union would be unwise to continue to ignore them.

This book is about Community design rights, and harmonized pan-EU law on registered designs. It does not deal with other rights that may protect the appearance of a product, such as trade marks, copyright, and unfair competition/passing off. Nor does it attempt to deal with national procedure for registration or enforcement of design rights. However, there is now a sufficient body of jurisprudence from OHIM, the General Court, and courts in member states to begin to tease out the meaning of many of the neologisms in the Regulation and the Directive.

That task, however, is complicated by the difficulty in accessing decisions, and dealing with 27 different legal regimes and 23 official languages. The further availability of national decisions in key languages will assist greatly in harmonization of practice and procedure, the development of the law, and consistency of decisions.

Many issues covered in the Regulation and the Directive remain unlitigated, or guidance has not yet been provided by superior tribunals. This text therefore suggests provisional answers based on a purposive reading of the legislation. There are also areas where decisions differ: for example, the debate around 'solely dictated by technical function' is intense, and will now only likely be resolved by the Court of Justice. Some national courts have been slow to slough off their learnings under their unharmonized design law and some need more readily to embrace the new pan-EU regime. This will happen in time.

It has, however, been a great pleasure to delve deeply into the law that is available, and, where it is not, to suggest what the answer might one day be found to be.

Thanks are due to many: to Jeremy Phillips, who first planted the seeds of this project; to Luke Adams, my original commissioning editor, and to Ruth Anderson, Senior Commissioning Editor, and Faye Judges of Oxford University Press for their guidance and patience; to my colleagues on the MARQUES Designs Team for their work on four editions of *A Review of RCD Invalidity Decisions* (MARQUES, 2007, 2008, 2009, and 2011); to Angus McLean, my co-author of the infringement and defences chapters of the *CIPA/ITMA Community Designs Handbook* (Sweet and Maxwell, London, 2012); to António Campinos for his kind words; to Anne Steeb for her very welcome translations; to Helen Cheesman for her generous assistance; and to my colleagues Rafi Allos, Katherine Arden, Will Corbett, Laurens Kamp, Bronagh Kealey, Gavin Lawson, and Holly Windle for their helpful comments on earlier drafts. I would also like to thank my family for their love and support.



All errors remain mine, and I would appreciate your letting me know of any at david.stone@simmons-simmons.com.

The law is stated as of 1 May 2012.

David Stone  
Paris  
June 2012

## COMPARATIVE TABLE OF THE DIRECTIVE AND THE REGULATION

Many of the substantive provisions in the Directive have an equivalent or similar provision in the Regulation, and should be interpreted accordingly.

Directive		Regulation	
<b>Recitals</b>	1	<b>Recitals</b>	None
	2		None
	3		None
	4		None
	5		None
	6		None
	7		31
	8		32
	9		None
	10		None
	11		None
	12		12
	13		14
	14		10
	15		11
	16		None
	17		None
	18		None
	19		13
	20		None
	21		None
<b>Articles</b>	1	<b>Articles</b>	3
	2		None
	3(1)		None
	3(2)–(4)		4(1)–(3)
	4		5
	5		6
	7		8
	8		9
	9		10
	10		12
	11(1)–(7)		25
	11(8)		None
	11(9)		24(2)
	12(1)		19(1)
	12(2)		None
	13		20
	14		None
	15		21
	16		96(1)
	17		96(2)
	18		110
	19		None
	20		111
	21		None

## LIST OF ABBREVIATIONS

Brussels Convention	Convention of 27 September 1968 on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters, now replaced by the Brussels Regulation
Brussels Regulation	Council Regulation (EC) 44/2001 of 22 December 2000 on jurisdiction and the enforcement of judgments in civil and commercial matters
CTM	Community trade mark: an EU-wide registered right pursuant to the CTM Regulation
CTM Regulation	Council Regulation (EC) 207/2009 of 26 February 2009 on the Community trade mark, codifying Council Regulation (EEC) 40/94 of 20 December 1993 on the Community trade mark and the amendments thereto
Directive	Council Directive (EC) 98/71 of 13 October 1998 on the legal protection of designs
EC Treaty	Treaty Establishing the European Community
EEA	European Economic Area: the member states of the European Union, plus Iceland, Liechtenstein, and Norway
Enforcement Directive	Directive (EC) 2004/48 of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights
Examination Guidelines	Guidelines for the Examination of Community Designs, published by OHIM
Fees Regulation	Commission Regulation (EC) 2246/2002 of 16 December 2002 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) in respect of the registration of Community designs
Green Paper	Green Paper on the Legal Protection of Industrial Design, EC Commission Working Document, III/F/5131/91-EN, June 1991
Hague Agreement	Hague Agreement Concerning the International Deposit of Industrial Designs
Implementing Regulation	Commission Regulation (EC) 2245/2002 of 21 October 2002 implementing Council Regulation (EC) 6/2002 on Community designs
Invalidity Guidelines	Guidelines for the Proceedings Relating to a Declaration of Invalidity of a Registered Community Design, published by OHIM
Manual	Manual concerning the Examination of Design Invalidity Applications
Max Planck Institute	Max Planck Institute for Foreign and International Patent, Copyright and Competition Law, now the Max Planck Institute for Intellectual Property and Competition Law
OHIM	Office for Harmonization in the Internal Market (Trade Marks and Designs). Also called OAMI in Spanish, HABM in German, OHMI in French, and UAMI in Italian

## *List of Abbreviations*

RCD	Registered Community design
Register	Register of Community designs maintained by OHIM
Regulation	Council Regulation (EC) 6/2002 of 12 December 2001 on Community designs
Renewal Guidelines	Registered Community Design Renewal Guidelines, published by OHIM
Trade Marks Directive	Directive (EC) 2008/95 of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to Trade Marks, codifying Council Directive (EEC) 89/104 of 21 December 1988 and the amendments thereto
TRIPs	Agreement on Trade-Related Aspects of Intellectual Property
WIPO	World Intellectual Property Organization

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