

# COMMUNITY DESIGNS

## INFRINGEMENT AND INVALIDITY DECISIONS

Rainer Bertram  
Partner of Grünecker, Kinkeldey, Stockmair & Schwanhäusser

The Community design system entered into force on March 6, 2002. Meanwhile, the first decisions on the questions of infringement and invalidity have been issued and provide first impressions as to how the system is applied by the Courts and the Office of Harmonisation.

### 1. Infringement decisions

The High Court of Justice in London ruled in October 2003 that a toy manufacturer stops making and selling dolls in the European Union infringing an unregistered Community design right of Mattel, Inc. Mattel was awarded an interim payment of £ 450,000. Although the decision is based on an unregistered Community design, it has to be remarked that the owner has filed a registered Community design after the legal proceedings have been started. It was registered after the decision was issued. This demonstrates that the short term protection of an unregistered Community design is not considered as appropriate protection for products of ordinary lifetime.

A Spanish shoe making company, Emboga, S.A., obtained a seizure of counterfeit products in different shops in Barcelona infringing Emboga's registered Community design. The subsequent infringement action was filed in Barcelona.

The Assen district Court in the Netherlands granted temporary relief in interlocutory proceedings between two Dutch toy retailers based on an unregistered Community design. The Court ordered the defendant to cease & desist from further use.

In another case, the Court of The Hague dismissed an action for infringement of registered Community designs. The Court was of the opinion that the accused products gave, to the eyes of an informed

user, a different overall impression from that of the plaintiff.

The recent cases show that the infringement courts have well adopted the Community design system. Unregistered Community designs are rather used for products of short market life and if no other intellectual property right is available. Sometimes it is used if the proprietor has forgotten to file a registered Community design. But the unregistered Community design confers the rights only if the contested use results from copying. The proprietor has to demonstrate the copying. Therefore, it is much more convenient to have a registered Community design in which the rights are independent of copying.

### 2. Invalidity decisions

Article 24 of the Regulation provides the possibility to apply for a declaration of invalidity to the Office. This opportunity is well used despite the fact that invalidity can also be claimed on the basis of a counter claim in infringement proceedings.

The applications for a declaration of invalidity are decided by Invalidity Divisions at the Office in the first instance. An appeal can be filed to the Boards of Appeal of the Office. The following decisions have been issued by the Invalidity Divisions and appeals might be pending.

In one case, the application for declaration of invalidity is based on two catalogues respectively showing designs alleged to challenge novelty and individual character of the registered Community design. The catalogues bear the markings "Edition 1991" and "© NICCOLAI TRAFILE 1997" respectively. In the opinion of the division, these markings might prove a date of creation of the catalogues, however, they do not prove that the catalogues had been published, or exhibited, used in trade or otherwise disclosed to a third person. As the applicant did not provide further evidence proving the publication, the application to declare invalidity was rejected.

In several cases, the Invalidity Divisions have paid very good attention to the question as to whether features or structures of a design are a consequence of its functionality and concluded that the informed user focuses his attention on the features not necessarily implied by this function. In one case, the head of a medical device was considered not to have a specific form in order that the device can fulfil its function. By contrast, a stem serving as a handle for the head was considered less significant due to its technical function. The head of the medical device was then used to establish a different overall impression of the registered design in contrast to the alleged prior art designs and the request to declare invalidity was finally rejected.

Several decisions confirm this principle according to which features governed of their necessary technical character are considered less important in the assessment of the overall impression. This reflects Article 6 (2) of the Regulation according to which the degree of freedom of the designer in developing the design shall be taken into consideration.

Most applications for declaration of invalidity are based on one prior art design which is individually compared with the registered design. In Article 6 (1) of the Regulation individual character is defined

as the overall impression which the design produces on the informed user being different from the overall impression produced on such a user by any design which has been made available to the public. This makes it even questionable as to whether a combination of a plurality of prior art designs is admissible in assessing individual character.

These first decisions regarding infringement and invalidity give the impression that the Community design system provides sufficient legal security with the appropriate scope to the proprietors of Community designs.