



# Fact sheet

## Community designs

A design is an intellectual property right which protects the appearance of a product. Regulation No 6/2002<sup>1</sup> provided the European Union with its own system of protection by creating the Community design.

A Community design has unitary character and has equal effect throughout the European Union. It thus confers on its holder, in the territory of the European Union, the exclusive right to use it and to prevent any third party not having the holder's consent from using it. The term of protection is 5 years and may be extended up to a total term of 25 years.

Community designs are registered by the European Union Intellectual Property Office (EUIPO), which is also competent to hear applications for a declaration of invalidity of registered Community designs. EUIPO decisions may be appealed to the Boards of Appeal of EUIPO. The General Court of the European Union hears actions for annulment of decisions of those Boards of Appeal. Appeals against decisions of the General Court may be brought before the Court of Justice, the examination of which is subject to the admission procedure. In addition, an application for a declaration of invalidity of a registered Community design may be made at national level to a Community design court on the basis of a counterclaim in infringement proceedings.

Furthermore, Regulation No 6/2002 also provides for the protection of unregistered Community designs. They are protected for a period of 3 years as from the date on which they were first made available to the public within the European Union.

This fact sheet provides an overview of the case-law on Community designs.

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<sup>1</sup> Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1).

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<sup>2</sup> This table of contents essentially follows the structure of the ‘Community designs’ section of the Digest of the case-law.

# I. Requirements for protection and grounds for invalidity

## 1. Definition of the design

### a) Requirement of a representation of the design

- [Judgment of 5 July 2018, Mast-Jägermeister v EUIPO \(C-217/17 P, EU:C:2018:534\)](#)<sup>3</sup>

Mast-Jägermeister SE filed applications for registration of two Community designs. Protection was sought for 'beakers', but the representations filed showed a beaker and a bottle.

EUIPO considered that no date of filing could be attributed to those applications, since it was not possible to determine from the representation of those designs whether protection was being sought for the beaker, for the bottle, or for a combination of the two. The General Court dismissed the action against that decision.

The Court of Justice dismisses the appeal and holds that the representation of the design contained in the application for registration must enable the matter for which protection is sought to be clearly identified.

First, that conclusion is apparent from an analysis of the wording of Article 36(1)(c) of Regulation No 6/2002, which provides that the application for registration of a design must contain a 'representation of the design suitable for reproduction'. The concept of representation encompasses, in itself, the idea that the design must be clearly identifiable. In addition, whilst Article 4(1)(e) of Regulation No 2245/2002 does not add substantive requirements to that of Article 36(1)(c) of Regulation No 6/2002, it states, inter alia, that the representation must be of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished.

Next, that literal interpretation is confirmed by the teleological interpretation of Article 36(1)(c) of Regulation No 6/2002, which must contribute to the proper functioning of the system of registration of designs. Accordingly, the function of the graphic representation requirement is, in particular, to define the design itself in order to determine the precise subject of the protection afforded by the registered design to its proprietor.

In that regard, the Court notes that the entry of a design in a public register has the aim of making it accessible to the competent authorities and the public, particularly to economic operators. On the one hand, the competent authorities must know with clarity and precision the nature of the constituent elements of a design in order to be able to fulfil their obligations in relation to the prior examination of applications for registration and to the publication and maintenance of an appropriate and precise register of designs. On the other hand, economic operators must be able to acquaint themselves, with clarity and precision, with registrations or applications for registration made by their current or potential competitors and thus to obtain relevant information about the rights of third parties. Such a requirement is intended to ensure legal certainty for third parties.

<sup>3</sup> See also judgment of 9 February 2017, [Mast-Jägermeister v EUIPO \(Beakers\)](#) (T-16/16, EU:T:2017:68).

Moreover, the fact that the date of filing enables that right of priority to be obtained justifies in itself the requirement that the representation must not lack precision as regards the design for which registration is sought. An imprecise application for registration would give rise to the risk that a design in respect of which the matter to be protected is not clearly identified would obtain excessive protection under the right of priority.

Lastly, with regard to contextual analysis, the Court notes that Article 12(2) of Regulation No 2245/2002 provides that a correction of the application for registration cannot change the representation of the design concerned. That necessarily implies that, before the application for registration can obtain a date of filing, it must contain a representation that enables the matter for which protection is sought to be identified.

Accordingly, the representation of a design for which registration is sought must clearly identify that design. It follows from Article 46(2) of Regulation No 6/2002 that an application which contains deficiencies relating to the requirements referred to in Article 36(1) of that regulation that have not been remedied within the prescribed period is not to be dealt with as an application for a registered Community design and that, consequently, no date of filing is attributed to it.

#### **b) Requirement of visibility**

- [Judgment of 21 September 2017, Easy Sanitary Solutions and EUIPO v Group Nivelles \(C-361/15 P and C-405/15 P, EU:C:2017:720\)](#)<sup>4</sup>

Easy Sanitary Solutions BV was the holder of a Community design representing a shower drainage channel. I-Drain, the predecessor of Group Nivelles NV, lodged an application with EUIPO for a declaration of invalidity of the contested design, based inter alia on the lack of novelty. The Board of Appeal of EUIPO held that the contested design was new. That decision was annulled by the General Court.

The Court dismisses the appeals brought by Easy Sanitary Solutions and EUIPO. It holds that the fact that a characteristic of a design is visible is an essential feature of that protection.

The Court emphasises that, when an applicant for a declaration of invalidity refers to the ground of invalidity set out in Article 25(1)(b) of Regulation No 6/2002, it is for that applicant to provide evidence to demonstrate that the contested design does not fulfil the requirements of Articles 4 to 9 of that regulation.

Moreover, the assessment of the novelty of a design must be conducted in relation to one or more specific, individualised, defined and identified designs from among all the designs which have been made available to the public previously.

In that regard, it should be noted that, according to Article 3(a) of Regulation No 6/2002, a design is defined as being 'the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the

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<sup>4</sup> See also the headings '1. 2. Novelty' and '1. 4. a. Disclosure – Criteria for assessment', as well as the judgment of 13 May 2015, [Group Nivelles v OHIM – Easy Sanitary Solutions \(Shower drainage channel\)](#) (T-15/13, EU:T:2015:281).

product itself and/or its ornamentation'. It follows that, in the context of the system set out by that regulation, appearance is the decisive factor of a design.

Consequently, the fact that a characteristic of a design is visible is an essential feature of that protection. It is stated in recital 12 of Regulation No 6/2002 that the protection of designs should not be extended to those component parts which are not visible during normal use of a product, nor to those features of such part which are not visible when the part is mounted and that those characteristics should not, for those reasons, be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection.

It follows from the foregoing that it is essential that the departments of EUIPO have an image of the earlier design that makes it possible to see the appearance of the product in which the design is incorporated and to identify the earlier design precisely and with certainty, so that they may assess the novelty and individual character of the contested design.

Thus, it is for the applicant for a declaration of invalidity to identify and reproduce for EUIPO precisely and entirely the design that is allegedly earlier in order to demonstrate that the contested design cannot be validly registered.

### c) Concept of 'product' and scope of the description

- [Judgment of 13 June 2017, Ball Beverage Packaging Europe v EUIPO – Crown Hellas Can \(Cans\) \(T-9/15, EU:T:2017:386\)](#)

Ball Beverage Packaging Europe Ltd was the holder of a design, representing cans, registered with EUIPO pursuant to Regulation No 6/2002. The Invalidity Division had rejected the application for a declaration of invalidity of that design submitted by Crown Hellas Can SA. That decision was, however, annulled by the Board of Appeal, which declared the design invalid on the ground that it did not have individual character, without ruling on novelty.

Hearing an action, which it dismisses, against the decision of the Board of Appeal, the Court provides useful clarification concerning the nature of the registration procedure for Community designs, the concept of 'product', within the meaning of Article 3(a) of Regulation No 6/2002, and the scope of the description of the contested design contained in the application for registration pursuant to Article 36(3)(a) of that regulation.

First of all, the Court observes that, in so far as the definition of the subject matter of the protection afforded by the design at issue forms part of the substantive examination of the registration of the design, a position taken by EUIPO on that question during the registration process cannot bind the Board of Appeal, given the essentially formal and expeditious nature of the review carried out by EUIPO during that registration process.

Next, the Court rejects the complaint that the Board of Appeal had erred in finding that the contested design, namely the representation of three cans of different sizes, did not constitute a product within the meaning of Article 3(1) of Regulation No 6/2002. In that regard, the Court notes that the subject matter of a design can only constitute a single unit, that article expressly referring to the appearance of 'a product'. Furthermore, according to the Court, a group of articles may constitute 'a product' within the meaning of that provision if they are linked by

aesthetic and functional complementarity and are usually marketed as a unitary product. Thus, the Court holds that it is clear that the three cans represented in the contested design do not perform a common function in the sense of a function that could not be performed by each of them individually as is the case, for example, of table cutlery or a chess board and chess pieces.

Last, the Court observes that the description which may be contained in the application for registration cannot influence the substantive assessments relating to the novelty or individual character of the design at issue. According to the Court, that description may also not influence the question of what is the subject matter of the protection afforded by the design at issue, which is clearly connected with the assessments relating to novelty and individual character.

## 2. Novelty

- [Judgment of 21 September 2017, Easy Sanitary Solutions and EUIPO v Group Nivelles \(C-361/15 P and C-405/15 P, EU:C:2017:720\)](#)<sup>5</sup>

In this judgment, the factual and legal context of which has been set out above,<sup>6</sup> the Court of Justice, on appeal, notes that Article 5(1)(b) of Regulation No 6/2002 does not mean that the novelty of a design is dependent on the products in which it is capable of being incorporated or to which it is capable of being applied. In addition, in accordance with Article 10(1) of Regulation No 6/2002, the protection conferred by a Community design is to include ‘any design’ which does not produce on the informed user a different overall impression.

Furthermore, it follows from both Article 36(6) and Article 19(1) of Regulation No 6/2002 that 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.

Therefore, a Community design cannot be regarded as being new if an identical design has been made available to the public, even if that earlier design was intended to be incorporated into a different product or to be applied to a different product. The fact that the protection granted to a design is not limited only to the products in which it is intended to be incorporated or to which it is intended to be applied must therefore mean that the assessment of the novelty of a design must also not be limited to those products alone.

- [Judgment of 6 June 2013, Kastenholz v OHIM – Qwatchme \(Watch dials\) \(T-68/11, EU:T:2013:298\)](#)<sup>7</sup>

Qwatchme A/S was the holder of a Community design, representing watch dials, registered with OHIM [now EUIPO] pursuant to Regulation No 6/2002. The Board of Appeal, upholding the decision of the Invalidity Division, rejected the application for a declaration of invalidity filed by

<sup>5</sup> See also the headings ‘1. 1. b. Definition of the design – Requirement of visibility’ and ‘1. 4. a. Disclosure – Criteria for assessment’, as well as the judgment of 13 May 2015, [Group Nivelles v OHIM – Easy Sanitary Solutions \(Shower drainage channel\)](#) (T-15/13, EU:T:2015:281).

<sup>6</sup> As regards the factual and legal context of the dispute, see the heading ‘1. 1. b. Definition of the design – Requirement of visibility’, p. 4.

<sup>7</sup> A summary of the judgment can be found in the 2013 Annual Report, p. 137. The appeal brought against that judgment was dismissed by the order of 17 July 2014, [Kastenholz v OHIM](#) (C-435/13 P, not published, EU:C:2014:2124).

Mr Erich Kastenholtz, on the ground that the contested design and the earlier designs were indeed distinct because of differences between the discs.

Hearing an action, which it dismisses, against the decision of the Board of Appeal, the Court holds that the designs at issue are not identical because their features differ not only in immaterial details.

This judgment deals, in particular, with the requirements as to novelty and individual character on which the protection of Community designs depends. The Court notes that, according to Article 5(2) of Regulation No 6/2002, 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. In that regard, the Court holds that the wording of Article 6 of Regulation No 6/2002 goes beyond that of Article 5 of the regulation. Consequently, the differences observed between the designs at issue in the context of Article 5 may, especially if they are slight, not be sufficient to produce on an informed user a different overall impression within the meaning of Article 6 of that regulation. In that case, the contested design may be regarded as being new within the meaning of Article 5 of Regulation No 6/2002, but will not be regarded as having individual character within the meaning of Article 6 of the regulation.

On the other hand, to the extent that the requirement laid down in the latter article goes beyond that laid down in Article 5, a different overall impression on the informed user within the meaning of Article 6 can be based only on the existence of objective differences between the designs at issue. Those differences must therefore be sufficient to satisfy the requirement of novelty in Article 5 of Regulation No 6/2002.

### **3. Individual character**

#### **a) Criteria for assessment**

- [Judgment of 19 June 2014, Karen Millen Fashions \(C-345/13, EU:C:2014:2013\)](#)

Karen Millen Fashions Ltd designed and placed on sale in Ireland a striped shirt and a black knit top. Dunnes Stores and Dunnes Stores (Limerick) Ltd purchased examples of those garments and then had copies of the garments manufactured outside Ireland and put them on sale in their Irish stores. Asserting itself to be the holder of unregistered Community designs relating to those garments, Karen Millen Fashions commenced proceedings in which it claimed, inter alia, injunctions restraining Dunnes from using those designs, and damages. Hearing the dispute, the Supreme Court (Ireland) referred questions to the Court of Justice for a preliminary ruling on the assessment of the individual character of a Community design.

The Court rules that Article 6 of Regulation No 6/2002 must be interpreted as meaning that, in order for a design to be considered to have individual character, the overall impression which

that design produces on the informed user must be different from that produced on such a user not by a combination of features taken in isolation and drawn from a number of earlier designs, but by one or more earlier designs, taken individually.

The reference to the overall impression produced on the informed user by 'any design' which has been made available to the public indicates that Article 6 must be interpreted as meaning that the assessment as to whether a design has individual character must be conducted in relation to one or more specific, individualised, defined and identified designs from among all the designs which have been made available to the public previously.

- [Judgment of 21 November 2013, El Hogar Perfecto del Siglo XXI v OHIM – Wenf International Advisers \(Corkscrew\) \(T-337/12, EU:T:2013:601\)](#)

El Hogar Perfecto del Siglo XXI, SL, was the holder of a Community design representing a corkscrew. Wenf International Advisers Ltd filed an application for a declaration of invalidity of that design on the ground, inter alia, that it lacked individual character. OHIM [now EUIPO] granted the application for a declaration of invalidity.

The Court dismisses the action and notes that the individual character of a design is to be assessed, in accordance with Article 6 of Regulation No 6/2002, by comparing the overall impressions produced by the designs at issue on the informed user and by taking into consideration the degree of freedom of the designer. Thus, the criterion relating to the disadvantages and various operational difficulties of the earlier design which have allegedly been resolved in the contested design, is not among those which may be taken into account for the purposes of assessing the individual character of a design. Moreover, as is apparent from Articles 1 and 3 of Regulation No 6/2002, the law on designs seeks to protect the appearance of a product and not its methods of use or operation.

- [Judgment of 16 June 2021, Davide Groppi v EUIPO – Viabizzuno \(Table lamp\) \(T-187/20, EU:T:2021:363\)](#)<sup>8 9</sup>

On 16 July 2014, Davide Groppi Srl filed an application for registration of a Community design representing a table lamp with EUIPO. Following the registration of the design, Viabizzuno Srl filed an application for a declaration of invalidity, in support of which it relied on Article 25(1)(b) of Regulation No 6/2002,<sup>10</sup> read in conjunction with Article 6 of that regulation,<sup>11</sup> relating to an earlier design of 22 September 2011. That earlier design was declared invalid on 30 October 2018.

<sup>8</sup> The appeal against the judgment was not allowed to proceed (order of 26 November 2021,  [Davide Groppi v EUIPO](#), C-490/21 P, not published, EU:C:2021:968).

<sup>9</sup> See also the heading 'I. 3. b. Individual character – Industrial sector of the product concerned'.

<sup>10</sup> In accordance with Article 25(1)(b) of Regulation No 6/2002, as amended, a Community design may be declared invalid only if it does not fulfil the requirements of Articles 4 to 9.

<sup>11</sup> In accordance with Article 6(1) of Regulation No 6/2002, entitled 'Individual character', a design is to 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 before the date of filing of the application for registration or, if a priority is claimed, the date of priority. Furthermore, Article 6(2) states that, in assessing individual character, the designer's degree of freedom in developing the design must be taken into consideration.

On 22 November 2018, the Invalidity Division declared Davide Groppi's design invalid on the ground that it did not have individual character within the meaning of Article 6 of Regulation No 6/2002. The Board of Appeal upheld that decision and held that the fact that the earlier design had been declared invalid was irrelevant, since the only thing that mattered was whether that design had been disclosed.

The Court dismisses the action for annulment brought before it by Davide Groppi. First, the Court notes that the fact that the earlier design, relied on in support of an application for a declaration of invalidity of a design based on Article 25(1)(b) of Regulation No 6/2002, was declared invalid during the administrative procedure is inconsequential. Furthermore, it explains that the nature of the products in which designs are incorporated plays a limited role in the examination of a ground for invalidity based on that provision.

The Court points out that the fact that the earlier design has been declared invalid is irrelevant given that it has been disclosed. The aim of Article 25(1)(b) of Regulation No 6/2002 is not to protect earlier designs, but to prevent the registration of designs which do not fulfil the requirements for protection, in particular the requirements as to their 'individual character', within the meaning of Article 6 of that regulation. In that regard, it points out that the grounds for invalidity set out in that article do not follow the rationale of the protection of an earlier right – which is given only to the holder of that right, and which, if declared invalid, would render the invalidity proceedings against the Community design devoid of purpose – but may, in principle, be relied on by any person. As regards, more specifically, the assessment as to whether a design has individual character under Article 25(1)(b) and Article 6 of Regulation No 6/2002, the Court states that it is apparent from recital 14 of that regulation that that assessment should be based on whether the overall impression produced on an informed user viewing the design clearly differs from that produced on him or her by the existing design corpus. It explains that the sole function of the earlier design is to reveal the state of the prior art, that is to say the corpus of previous designs relating to the product in question that were disclosed on the date of filing of the design concerned. Therefore, it holds that the only thing that matters is the fact that the earlier design has been disclosed, and not the scope of the protection afforded to that design once the validity of its registration has been established.

#### **b) Industrial sector of the product concerned**

- [Judgment of 22 June 2010, Shenzhen Taiden v OHIM – Bosch Security Systems \(Communications equipment\) \(T-153/08, EU:T:2010:248\)](#)<sup>12</sup>

Shenzhen Taiden Industrial Co Ltd was the holder of a Community design, representing communications equipment, registered with OHIM [now EUIPO] pursuant to Regulation No 6/2002. The Invalidity Division had rejected the application for a declaration of invalidity of that design submitted by Bosch Security Systems BV. That decision was, however, annulled by the Board of Appeal, which found that the contested design lacked individual character on the

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<sup>12</sup> See also the heading '1. 3. c. Individual character – Informed user'.

ground that the differences between that design and the prior international design were not sufficiently noticeable to produce a different overall impression on the informed user.

Hearing an action, which it dismisses, against the decision of the Board of Appeal, the Court points out that, as is apparent from recital 14 of Regulation No 6/2002, when assessing whether a design has individual character, account should be taken of the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs.

- [Judgment of 16 June 2021, Davide Groppi v EUIPO – Viabizzuno \(Table lamp\) \(T-187/20, EU:T:2021:363\)](#)<sup>13</sup>

In this judgment, the factual and legal context of which has been set out above,<sup>14</sup> the Court, after finding that the registration of the contested design refers generally to lamps, points out that, although the determination of the sector of the products is a relevant consideration when determining the informed user and his or her level of attention, when determining the designer's degree of freedom in developing the design and, possibly, when comparing the overall impressions produced on that informed user, it cannot, however, imply that the products concerned by the designs at issue are similar or belong to the same sector. In that regard, it points out that Article 25(1)(b) of Regulation No 6/2002 does not lay down any requirement of similarity between the goods, and that if the protection of a design were made dependent on the nature of the product, such protection would be limited only to the designs belonging to a specific sector.

- [Judgment of 10 November 2021, Eternit v EUIPO – Eternit Österreich \(Building panel\) \(T-193/20, EU:T:2021:782\)](#)

Following an application filed with EUIPO, Eternit (Belgium) obtained the registration of a Community design representing a building panel. Eternit Österreich GmbH submitted an application for a declaration of invalidity of that design, inter alia, on the ground that it did not have individual character<sup>15</sup> in relation to the earlier design representing a panel for a noise-reduction wall. EUIPO declared the design at issue invalid, taking the view that it lacked individual character because, to the informed user, it was similar overall to the earlier design.

The Court dismisses Eternit's action against the decision of EUIPO. In this case, first, the Court clarifies, in relation to the designs at issue, that it is appropriate to define the sector concerned, the informed user and the degree of freedom of the designer. Second, it specifies whether the goods actually marketed in which the designs at issue are incorporated or to which they are applied are relevant to the assessment of the individual character of the contested design.

In the first place, the Court recalls that the assessment of the individual character of a design at issue is the result, in essence, of a four-stage examination. In that regard, it states that the first

<sup>13</sup> See also the heading '1. 3. a. Individual character – Criteria for assessment'.

<sup>14</sup> As regards the factual and legal context of the dispute, see the heading '1. 3. a. Individual character – Criteria for assessment', p. 9.

<sup>15</sup> For the purposes of Article 25(1)(b) of Regulation No 6/2002, read in conjunction with Article 6 of that regulation, a Community design may be declared invalid if it does not have individual character, such that the overall impression it produces on the informed user does not differ from that produced on such a user by any design which has been made available to the public.

three stages of the analysis, namely the determination of the sector concerned, the informed user and the designer's degree of freedom, must be carried out only in relation to the design at issue. Given that the earlier design may fall within a completely different sector, characterised by a separate informed user and a separate freedom of the designer, it is not relevant for the purposes of those first three stages of the analysis. By contrast, the fourth stage, consisting of the comparison of the overall impressions produced by the designs at issue, requires both the contested design and the earlier design to be taken into account.

In the second place, the Court notes that, in the context of the assessment of individual character, account may be taken, in certain circumstances, of the goods actually marketed in which the designs at issue are incorporated or to which they are applied. It states that the goods actually marketed or the way in which they are used are relevant if the graphic or photographic representation of the design at issue does not, on its own, make it possible to determine which aspects of it are visible or the way in which the design will be perceived visually. The goods actually marketed may be taken into consideration only for illustrative purposes in order to determine the visual aspects of the designs. Thus, a product which is actually marketed may not be taken into account if the design applied to it or incorporated in it differs from the design as registered or if it displays features which are not clearly apparent from the graphic representation of that design.

### c) Informed user

- [Judgment of 20 October 2011, PepsiCo v Grupo Promer Mon Graphic \(C-281/10 P, EU:C:2011:679\)](#)<sup>16</sup>

PepsiCo Inc. was the holder of a Community design representing a circular promotional item. Grupo Promer Mon Graphic SA filed an application with EUIPO for a declaration of invalidity of that design, based inter alia on the existence of a prior design. The Board of Appeal of EUIPO found that the designs at issue produced a different overall impression on the informed user and therefore that the contested design was not in conflict with the prior right invoked. The General Court, hearing an action, annulled that decision and held that the differences observed by the Board of Appeal were insufficient for the contested design to produce an overall impression on the informed user that differed from that produced by the prior design.

Hearing an appeal, which it dismisses, the Court of Justice clarifies the concept of informed user. The very nature of the informed user means that, when possible, he will make a direct comparison between the designs at issue. However, it is conceivable 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 represent. In the absence of any precise indications to that effect in the context of Regulation No 6/2002, the EU legislature cannot be regarded as having intended to limit the assessment of potential designs to a direct comparison.

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<sup>16</sup> See also the 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), under the heading '1. 7. Conflict with a prior design'.

As regards the informed user's level of attention, although the informed user is not the well-informed and reasonably observant and circumspect average consumer who normally perceives a design as a whole and does not proceed to analyse its various details, he is also not an expert or specialist capable of observing in detail the minimal differences that may exist between the designs in conflict. Thus, the qualifier 'informed' suggests that, without being a designer or a technical expert, the user knows the various designs which exist in the sector concerned, possesses a certain degree of knowledge with regard to the features which those designs normally include, and, as a result of his interest in the products concerned, shows a relatively high degree of attention when he uses them.

- [Judgment of 22 June 2010, Shenzhen Taiden v OHIM – Bosch Security Systems \(Communications equipment\) \(T-153/08, EU:T:2010:248\)](#)<sup>17</sup>

In this judgment, the factual and legal context of which has been set out above,<sup>18</sup> the Court clarifies the concept of informed user, noting that the status of 'user' implies that the person concerned uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended, and that the qualifier 'informed' suggests that, without being a designer or a technical expert, the user knows the various designs which exist in the sector concerned, possesses a certain degree of knowledge with regard to the features which those designs normally include, and, as a result of his interest in the products concerned, shows a relatively high degree of attention when he uses them. However, that factor does not imply that the informed user is able to distinguish, beyond the experience gained by using the product concerned, the aspects of the appearance of the product which are dictated by the product's technical function from those which are arbitrary.

- [Judgment of 14 June 2011, Sphere Time v OHIM – Punch \(Watch attached to a lanyard\) \(T-68/10, EU:T:2011:269\)](#)<sup>19</sup>

Sphere Time was the holder of a Community design, representing watches attached to a lanyard, registered with OHIM [now EUIPO] pursuant to Regulation No 6/2002. The Invalidity Division, granting the application for a declaration of invalidity submitted by Punch SAS, had declared the contested design invalid on the ground that it lacked individual character since it produced the same overall impression as the prior designs.

Hearing an action, which it dismisses, against the decision of the Board of Appeal upholding the decision of the Invalidity Division, the Court points out that, in relation to promotional items, the concept of informed user includes, first, a professional who acquires them in order to distribute them to the final users and, secondly, those final users themselves. It concludes that the fact that one of those 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.

<sup>17</sup> See also the heading '1. 3. b. Individual character – Industrial sector of the product concerned'.

<sup>18</sup> As regards the factual and legal context of the dispute, see the heading '1. 3. b. Individual character – Industrial sector of the product concerned', p. 10.

<sup>19</sup> See also the headings '1. 3. e. Individual character – Overall impression' and '1. 4. d. Disclosure – Grace period'.

- [Judgment of 13 June 2019, Visi/one v EUIPO – EasyFix \(Display holder for vehicles\) \(T-74/18, EU:T:2019:417\)](#)<sup>20</sup>

Visi/one GmbH was the holder of Community designs, representing display holders, signboards for vehicles, registered with EUIPO pursuant to Regulation No 6/2002. The Invalidity Division of EUIPO, granting the application for a declaration of invalidity submitted by EasyFix GmbH, had declared the contested design invalid for lack of individual character.

Hearing an action, which it dismisses, against the decision of the Board of Appeal upholding the decision of the Invalidity Division, the Court considers that the differences between the contested design and the prior design are insufficiently significant to produce, on their own, a dissimilar overall impression on the informed user.

As regards an informed user's degree of knowledge and level of attention, the Court considers that it follows in particular from the case-law that, even if the relevant person has a certain degree of knowledge as regards the different designs that exist in the sector concerned and displays a relatively high level of attention and particular vigilance when he or she uses them, he or she is also not an expert or specialist, such as a sectoral expert [in patent law], capable of observing in detail the minimal differences that may exist between the designs at issue.

#### d) Degree of freedom of the designer

- [Judgment of 13 November 2012, Antrax It v OHIM – THC \(Radiators for heating\) \(T-83/11 and T-84/11, EU:T:2012:592\)](#)

Antrax It Srl was the holder of eight Community designs, two of which were contested in this case, representing radiators for heating, registered with OHIM [now EUIPO] pursuant to Regulation No 6/2002. The Invalidity Division, granting the application for a declaration of invalidity submitted by The Heating Company, had declared the contested designs invalid for lack of novelty. The Board of Appeal, annulling the decision of the Invalidity Division for failure to provide an adequate statement of reasons, in turn declared the contested designs invalid for lack of individual character.

Hearing the actions against the decisions of the Board of Appeal, the Court annuls those decisions in so far as they declared the contested designs invalid and dismisses the actions as to the remainder.

This case provided an opportunity for the Court to clarify the criteria for determining the degree of freedom of the designer in developing a design in the assessment of the individual character of that design. The Court observes that such a degree of freedom 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 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. Therefore, the greater the designer's freedom in developing a design, the less likely it is that minor differences between the designs being

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<sup>20</sup> See also the heading '4. a. Disclosure – Criteria for assessment'.

compared will be sufficient to produce a different overall impression on an informed user. Conversely, the more the designer's freedom 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 have significant differences produce the same overall impression on an informed user. In that context, any saturation of the state of the art, deriving from the existence of other designs which have the same overall features as the designs concerned, is relevant, in that it may be liable to make the informed user more aware of the differences in the internal proportions of those different designs.

- [Judgment of 10 September 2015, H&M Hennes & Mauritz v OHIM – Yves Saint Laurent \(Handbags\) \(T-525/13, EU:T:2015:617\)](#)

Yves Saint Laurent SAS was the holder of a Community design, representing handbags, registered with OHIM [now EUIPO] pursuant to Regulation No 6/2002. The Board of Appeal, upholding the decision of the Invalidity Division, dismissed the application for a declaration of invalidity filed by H&M Hennes & Mauritz BV & Co. KG, based on a prior design, on the ground that the degree of freedom of the designer was high, but did not, from the point of view of the informed user, cancel out the significant differences between the designs at issue.

Hearing an action, which it dismisses, against the decision of the Board of Appeal, the Court clarifies the concept of the degree of freedom of the designer.

In this judgment, the Court recalls that the degree of freedom of the designer of a design is determined, inter alia, by the constraints of the features imposed by the technical function of the product or of an element thereof, or by statutory requirements applicable to the product. Those constraints result in a standardisation of certain features, which will thus be common to the designs applied to the product concerned. Therefore, the greater the designer's freedom in developing a design, the less likely it is that minor differences between the designs at issue will be sufficient to produce different overall impressions on an informed user. Conversely, the more the designer's freedom in developing a design is restricted, the more likely it is that minor differences between the designs at issue will be sufficient to produce different overall impressions on an informed user. The Court therefore considers that if the designer enjoys a high degree of freedom in developing a design, that reinforces the conclusion that designs that do not have significant differences produce the same overall impression on an informed user.

Furthermore, the Court states that Article 6 of Regulation No 6/2002, concerning the assessment of individual character, lays down, in paragraph 1, the criterion of the overall impression produced by the designs at issue and provides, in paragraph 2, that the degree of freedom of the designer must be taken into consideration for those purposes. It is apparent from those provisions that the assessment of the individual character of a Community design is the result, in essence, of a four-stage examination. That examination consists in deciding upon, first, the sector to which the products in which the design is intended to be incorporated or to which it is intended to be applied belong; second, the informed user of those products in accordance with their purpose and, with reference to that informed user, the degree of

awareness of the prior art and the level of attention in the comparison, direct if possible, of the designs; third, the designer's degree of freedom in developing his design; and, fourth, the outcome of the comparison of the designs at issue, taking into account the sector in question, the designer's degree of freedom and the overall impressions produced on the informed user by the contested design and by any earlier design which has been made available to the public. Thus, although 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, on the other hand the assessment of the degree of freedom does not constitute a preliminary and abstract step in the comparison of the overall impressions produced by the designs at issue.

In the case in point, the Court concludes that the Board of Appeal had therefore not erred in stating that the factor relating to the freedom of the designer could not on its own determine the assessment of the individual character of a design, but that it was, however, a factor which had to be taken into consideration in that assessment. According to the Court, the Board of Appeal had therefore been correct to find that that factor was a factor which made it possible to moderate the assessment of the individual character of the contested design, rather than an independent factor.

- [Judgment of 6 June 2019, Porsche v EUIPO – Autec \(Motor vehicles\) \(T-209/18, EU:T:2019:377\)](#)<sup>21</sup>

In this judgment, the Court dismisses the action seeking annulment of the decision of the Board of Appeal of EUIPO, by which the latter declared the registered Community design representing the design of the 991 series Porsche 911 car to be invalid on the ground of lack of individual character within the meaning of Article 6(1) of Regulation No 6/2002.

Specifically, this case concerned the legal issue of the existence of individual character capable of justifying protection where the design concerned was merely an 'update' of a shape that was already in existence and was already protected. In the present case, the issue was whether the design of the 991 series Porsche 911 was sufficiently different from the earlier design of the 997 series to be protected as such. Since Regulation No 6/2002 limits the maximum duration of protection to 25 years, granting protection to an 'updated' earlier design would, in addition, be likely to extend the protection of the original design. That was the subject matter of the dispute between Porsche and a toy manufacturer who used the Porsche 911 design for the manufacture and marketing of scale models.

The Court finds that the differences between the two series of the Porsche 911 are not so sufficiently marked that each of the two designs produced a different overall impression in the mind of the informed user, namely a user of cars in general rather than solely a sports car user. Accordingly, all the views of the designs in question show that those designs are effectively the same as regards their shape and bodywork silhouette, both with regard to dimensions and proportions and to the shape and arrangement of the windows and doors, in terms of their fundamental features.

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<sup>21</sup> The appeal brought against that judgment was not allowed to proceed (order of 24 October 2019, [Porsche v EUIPO](#), C-613/19 P, EU:C:2019:905).

In that regard, the Court holds that, contrary to what is claimed by Porsche, the degree of freedom of the designer, within the meaning of Article 6 of Regulation No 6/2002, could not have been limited by the expectations of consumers, who in the present case would have expected to find in each subsequent series the creative idea of the original prototype, as such expectations do not constitute a statutory constraint. Those expectations relate to neither the nature nor the purpose of such a product, in which the design is incorporated, namely a motorised vehicle, and a designer of motor cars, independently of aesthetic or commercial considerations, is not obliged to meet them in order to ensure the functioning of the product to which the design in question is intended to be applied.

#### e) Overall impression

- [Judgment of 14 June 2011, Sphere Time v OHIM – Punch \(Watch attached to a lanyard\) \(T-68/10, EU:T:2011:269\)](#)<sup>22</sup>

In this judgment, the factual and legal context of which has been set out above,<sup>23</sup> the Court states that, in the specific assessment of the overall impression, the graphic representation of prior designs should not be examined in isolation and exclusively: instead all the elements presented should be subject to a global assessment allowing the overall impression produced by the design at issue to be determined in a sufficiently precise and certain manner.

In relation, in particular, to a design that has been used, without having been registered, it may be the case that there is no graphic representation of the design showing its relevant details, comparable to the application for registration. According to the Court, it is therefore unreasonable to require the applicant for a declaration of invalidity to provide such a representation in all cases.

- [Judgment of 10 November 2021, Sanford v EUIPO – Avery Zweckform \(Labels\) \(T-443/20, EU:T:2021:767\)](#)<sup>24</sup>

Sanford LP was the holder of a Community design, representing labels, registered with EUIPO pursuant to Regulation No 6/2002. The Invalidity Division had rejected the application for a declaration of invalidity submitted by Avery Zweckform GmbH. However, the Board of Appeal, annulling the decision of the Invalidity Division, declared the contested design invalid on the ground that it lacked individual character, since it produced the same overall impression on the informed user as the prior design on which the applicant for a declaration of invalidity relied.

Hearing an action, which it dismisses, against the decision of the Board of Appeal, the Court points out that, in the comparison of the overall impressions during the assessment of individual character, the trade marks and distinctive signs on the designs are irrelevant.

It finds that the differences between the designs at issue, which are limited to the size of the label, the height of the roll, and the number, position and size of the black prints marks, are insufficient to produce a different overall impression in the mind of the informed user.

<sup>22</sup> See also the headings 'I. 3. c. Individual character – Informed user' and 'I. 4. d. Disclosure – Grace period'.

<sup>23</sup> As regards the factual and legal context of the dispute, see the heading 'I. 3. c. Individual character – Informed user', p. 13.

<sup>24</sup> See also the heading 'III. 2. d. Application for a declaration of invalidity and invalidity proceedings – Evidence not submitted in due time'.

In addition, it points out that the word and figurative elements on the designs at issue are marks or distinctive signs affixed to the product to indicate its origin.

Those elements do not constitute features of the product giving the goods concerned their appearance and are therefore irrelevant in the comparison of the overall impressions. The Court adds that, even though those elements could be regarded as relevant, it will be clear to the informed user that their purpose is to indicate the origin of the goods, with the result that, in the overall impression, that user will not attach importance to them.

- [Judgment of 27 April 2022, Group Nivelles v EUIPO – Easy Sanitary Solutions \(Shower drainage channel\) \(T-327/20, EU:T:2022:263\)](#)

In this judgment, the factual and legal context of which is the same as that in Case C-361/15, as set out above,<sup>25</sup> the Court has before it an action for annulment of a new decision adopted by EUIPO following the annulment, which has the force of *res judicata*, of a first decision.<sup>26</sup> In the new decision, the Board of Appeal of EUIPO rejected the application for a declaration of invalidity on the ground that the contested design possessed individual character and was, a fortiori, new. Hearing an action, which it dismisses, against the Board of Appeal's decision, the Court has the opportunity to specify the relevant factors taken into account in assessing the individual character of the contested design.

The Court confirms that the contested design has individual character. First of all, it points out that an earlier design incorporated into a product other than the one to which the contested design relates is, in principle, an earlier design which is relevant for the purposes of assessing individual character. Next, it states that any errors made by the Board of Appeal concerning the features of the earlier designs representing only one element of a shower drainage channel have no bearing on the legality of the decision, since no errors were made in the comparison between the contested design and the whole designs. Since an earlier design must be an earlier whole design, only the designs representing complete shower drainage channels are relevant. Lastly, in view of the elegant and minimalist appearance of the contested design, the overall impression it produces differs from that of the earlier design, with features which are more functional and not decorative.

## 4. Disclosure

### a) Criteria for assessment

- [Judgment of 13 February 2014, H. Gautzsch Großhandel \(C-479/12, EU:C:2014:75\)](#)

Münchener Boulevard Möbel Joseph Duna GmbH had marketed in Germany the design for a canopied gazebo, created in 2004. Claiming the protection granted to unregistered Community designs for its design, that company had brought an action for infringement against H. Gautzsch Großhandel GmbH & Co. KG which, since 2006, has marketed a gazebo manufactured by an undertaking established in China. Münchener Boulevard Möbel Joseph Duna argued that that

<sup>25</sup> As regards the factual and legal context of the dispute, see the heading '1. b. Definition of the design – Requirement of visibility', p. 4.

<sup>26</sup> See judgment of 13 May 2015, [Group Nivelles v EUIPO – Easy Sanitary Solutions \(Shower drainage channel\) \(T-15/13, EU:T:2015:281\)](#).

gazebo was a copy of its own design, which appeared in leaflets that had been distributed to the sector's largest retailers.

The Court of Justice, to which a question had been referred for a preliminary ruling, rules on the scope of the concept of 'disclosure' and, in that regard, holds that, on a proper construction of Article 11(2) of Regulation No 6/2002, it is possible that an unregistered design may reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union, if images of the design were distributed to traders operating in that sector, which it is for the Community design court to assess, having regard to the circumstances of the case before it.

On a proper construction of the first sentence of Article 7(1) of Regulation No 6/2002, for its part, it is possible that an unregistered design may not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union, even though it was disclosed to third parties without any explicit or implicit conditions of confidentiality, if it has been made available to only one undertaking in that sector or has been presented only in the showrooms of an undertaking outside the European Union, which it is for the Community design court to assess, having regard to the circumstances of the case before it.

- [Judgment of 21 September 2017, Easy Sanitary Solutions and EUIPO v Group Nivelles \(C-361/15 P and C-405/15 P, EU:C:2017:720\)](#)<sup>27</sup>

In this judgment, the factual and legal context of which has been set out above,<sup>28</sup> the Court of Justice, on appeal, holds that it is not necessary to compare one design with another to establish both the novelty and the individual character of the first design, unless the second has been made available to the public. When a design is considered to have been made available to the public, that disclosure is valid for the purposes of the assessment both of novelty and of individual character.

In addition, 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.

Accordingly, nothing 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.

- [Judgment of 13 June 2019, Visi/one v EUIPO – EasyFix \(Display holder for vehicles\) \(T-74/18, EU:T:2019:417\)](#)<sup>29</sup>

In this judgment, the factual and legal context of which has been set out above,<sup>30</sup> the Court clarifies that in order to establish that a prior design has been disclosed, it is necessary to carry

<sup>27</sup> See also the headings '1. 1. b. Definition of the design – Requirement of visibility' and '1. 2. Novelty', as well as the judgment of 13 May 2015, [Group Nivelles v OHIM – Easy Sanitary Solutions \(Shower drainage channel\)](#) (T-15/13, EU:T:2015:281).

<sup>28</sup> As regards the factual and legal context of the dispute, see the heading '1. 1. b. Definition of the design – Requirement of visibility', p. 4.

<sup>29</sup> See also the heading '1. 3. c. Individual character – Informed user'.

out an analysis in two stages. In the first place, it must be examined whether the evidence submitted in the application for a declaration of invalidity shows, on the one hand, facts constituting disclosure of a design and, on the other hand, that that disclosure occurred earlier than the date of filing or priority of the design at issue. In the second place, where the holder of the design at issue has claimed the contrary, it must be examined whether those facts could reasonably become known in the normal course of business to the circles specialised in the sector operating within the European Union, failing which a disclosure will be considered to have no effects and will not be taken into account.

In the present case, the Court finds that, while it is regrettable that EUIPO's administrative services communicated to the applicant the two catalogues produced in Annex B to the application for a declaration of invalidity with non-continuous numbering that did not correspond to the order of the pages of the original catalogues, such a circumstance cannot call into question the legality of the contested decision as regards proof of the constituent facts and the priority of the disclosure of the display holder for vehicles reproduced in paragraph 4 of the contested decision in connection with Annex B and, in particular, the probative value of those documents for the purpose of establishing the disclosure of the prior design. Furthermore, the applicant has not demonstrated or even claimed that the circumstances of the present case could reasonably prevent those facts from becoming known in the normal course of business to the circles specialised in the sector concerned operating within the European Union. Given the absence of indications to the contrary that would have made it possible to consider that those catalogues had not been distributed within those specialised circles, the Board of Appeal did not err when it concluded that there had been a disclosure of the prior design.

#### **b) Presumption of disclosure**

- [Judgment of 21 May 2015, \*Senz Technologies v OHIM – Impliva \(Umbrellas\)\* \(T-22/13 and T-23/13, EU:T:2015:310\)](#)

Senz Technologies BV was the holder of two Community designs, representing umbrellas, registered with OHIM [now EUIPO] pursuant to Regulation No 6/2002. The Invalidity Division, granting the application for a declaration of invalidity submitted by Impliva BV, had declared the contested designs invalid on the ground that, despite their novelty, they lacked individual character in relation to an earlier patent that had been disclosed.

Hearing an action, which it upholds, against the decision of the Board of Appeal upholding the decision of the Invalidity Division, the Court recalls that a design is deemed to have been made available once the party relying thereon has proven the events constituting disclosure and that that presumption applies irrespective of where the events constituting disclosure took place.

According to the Court, the question whether events taking place outside the European Union could reasonably have become known to the persons forming part of the circles specialised in the sector concerned is a question of fact; the answer to that question is dependent on the assessment of the particular circumstances of each individual case. In order to carry out that

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<sup>30</sup> As regards the factual and legal context of the dispute, see the heading 'I. 3. c. Individual character – Informed user', p. 14.

assessment, it must be examined whether, on the basis of the facts, which must be adduced by the party challenging the disclosure, it is appropriate to consider that it was not actually possible for those circles to be aware of the events constituting disclosure, whilst bearing in mind what can reasonably be required of those circles in terms of being aware of prior art. Those facts may concern, for example, the composition of the specialised circles, their qualifications, customs and behaviour, the scope of their activities, their presence at events where designs are presented, the characteristics of the design at issue, such as their interdependency with other products or sectors, and the characteristics of the products into which the design at issue has been integrated, including the degree of technicality of the product concerned. In any event, a design cannot be deemed to be known in the normal course of business if the circles specialised in the sector concerned can become aware of it only by chance.

In addition, the Court observes that Article 7(1) of Regulation No 6/2002 does not impose any requirement that the prior design must have been used for the manufacture or marketing of a product. However, the fact that a design has never been incorporated into a product is significant only where the applicant has established that the circles specialised in the sector concerned do not generally consult patent registers or that the circles specialised in the sector concerned do not generally attach any weight to patents.

### c) Proof of disclosure

- [Judgment of 27 February 2018, Gramberg v EUIPO – Mahdavi Sabet \(Case for a mobile phone\) \(T-166/15, EU:T:2018:100\)](#)

Mr Sabet obtained the registration of a Community design representing a case for a mobile telephone. Mr Gramberg submitted to EUIPO an application for a declaration of invalidity of that design on the ground of lack of novelty. In order to prove disclosure of that design, he produced screenshots of the 'amazon.de' website. The Board of Appeal of EUIPO dismissed the application for a declaration of invalidity on the ground that the evidence was insufficient to prove disclosure.

Hearing an action, which it upholds, the Court rules on the probative value of the evidence taken from an online sales website, relied on to demonstrate the disclosure of a design.

First, it emphasises that a design is 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. 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.

The evidence provided by the applicant for a declaration of invalidity must be considered in its entirety. If some of that evidence may be insufficient in itself to demonstrate the disclosure of an earlier design, the fact nonetheless remains that, when it is associated or read with other documents or information, it may contribute to forming proof of the disclosure. In addition, 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. It is necessary to take account of, inter alia, the origin of the document, the circumstances in which it came into being, the person to whom it was addressed and whether, on its face, the document appears to be sound and reliable.

It follows from the EU legislation in force which is applicable to Community designs that, first, the applicant for a declaration of invalidity is free to choose the evidence which it considers useful to submit to EUIPO in support of its application for a declaration of invalidity and, second, EUIPO is required to examine all evidence submitted in order to establish whether it actually proves disclosure of the earlier design.

Secondly, as regards the probative value of screenshots of a website, the Court notes that, even though it might seem reasonable to consider that the content of a website can be altered at any time and that that content can be difficult to verify a posteriori, such considerations cannot be applied to screenshots taken from the 'amazon.de' online sales website containing, immediately before the reference to the availability date of the offer on that website, the ASIN (Amazon Standard Identification Number), which is a unique reference number assigned to each item in the catalogue which enables the item on the Amazon online sales platform to be identified.

Furthermore, to apply automatically the presumption that the content of a website or of any other electronic document can be altered at any time, in the absence of serious and substantiated doubts that the evidence was altered in a specific case, would deprive of all effect the principle established in EU case-law that the evidence provided by the applicant for a declaration of invalidity must be considered in its entirety.

- [Judgment of 6 June 2019, Rietze v EUIPO – Volkswagen \(Motor vehicle VW Caddy\) \(T-192/18, EU:T:2019:379\)](#)

In this judgment, the Court upholds the decision of EUIPO that the design representing the VW Caddy vehicle is new within the meaning of Article 5 of Regulation No 6/2002 and enjoys individual character within the meaning of Article 6 of that Regulation. This case arises from invalidity proceedings brought by the applicant, Rietze, a German company which marketed miniature cars. The contested design was that for the VW Caddy motor vehicle put on the market by Volkswagen in 2011. In order to prove the disclosure of a prior design, the applicant had referred to a previous model of that car, namely the VW Caddy (2K) Life model, which was put on the market in 2004.

In the first place, the Court rejects the applicant's argument that EUIPO should have, first, weighted the characteristics of the designs at issue, second, analysed their commonalities, and, third, distinguished between their aesthetic and technical characteristics.

In the second place, the General Court rejects the applicant's argument that EUIPO had failed to take into account certain elements of evidence containing an illustration of the earlier design. The Court recalls that it is for the party who lodged the application for a declaration of invalidity to provide accurate and complete reproductions of the earlier design and that the Board of Appeal cannot be required to combine different representations of the product in which the

earlier design was incorporated, or even to replace an element which appears in most representations with an element which appears in only one representation.

- [Judgment of 20 October 2021, JMS Sports v EUIPO – Inter-Vion \(Spiral hair elastic\) \(T-823/19, EU:T:2021:718\)](#)

JMS Sports sp. z o.o. was the holder of the Community design representing a spiral hair elastic, filed on 24 June 2010 with EUIPO. Inter-Vion S.A. had filed an application for a declaration of invalidity of that design, on the ground, inter alia, that it lacked novelty. In order to prove disclosure of the prior designs, it had produced website screen captures, dated 2009.

The Board of Appeal of EUIPO considered that disclosure of the prior designs, identical to the contested design, had been proved. Accordingly, it concluded that the contested design lacked novelty.

Hearing an action, which it dismisses, against the decision of the Board of Appeal, the Court specifies the probative value of the evidence taken from websites, relied on to demonstrate the date of disclosure of a design.<sup>31</sup>

First of all, the Court declares inadmissible the evidence, produced for the first time before it, obtained through the use of free access tools such as the Google search engine and the Wayback Machine. After all, they do not fall within the factual context of the dispute as it existed before the Board of Appeal and cannot therefore be taken into account for the purposes of the review of the legality of the contested decision.

Next, after having recalled that the applicant for a declaration of invalidity is free to choose the evidence, the Court notes that the appearance of the image of a design on the Internet constitutes an event which may be classified as ‘publication’ and which is therefore tantamount to ‘disclosure to the public’. It indicates that the probative value of the screen captures is not limited.

In the case at hand, it finds that the screen captures from websites clearly showed designs identical to the contested design, the complete URL<sup>32</sup> addresses of those websites as well as the dates of disclosure to the public, prior to the date on which the application for registration of the contested design was filed. In addition, a screen capture showed other timestamp information, consisting of comments from Internet users and demonstrating disclosure to the public on 1 November 2009.

Furthermore, the Court emphasises that the mere abstract possibility of the content or date of a website being manipulated is not a sufficient ground for calling into question the credibility of the evidence consisting of the screen capture of that website. That credibility can be called into question only by the adducing of facts that concretely suggest a manipulation. Furthermore, even though the screen capture produced by the Wayback Machine does not contain an image of the product, it is a relevant source of information corroborating the reliability of the screen

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<sup>31</sup> Within the meaning of Article 7(1) of Regulation No 6/2002.

<sup>32</sup> Uniform Resource Locator.

capture of one of the websites in question. Accordingly, the Court holds that disclosure has been proved.

Last, as regards the allocation of the burden of proof, the Court states that, given that the applicant for a declaration of invalidity submitted evidence taken from the Internet demonstrating disclosure of prior designs, it was for the holder of the contested design to demonstrate the lack of credibility of that evidence. In that regard, it was not required to demonstrate the manipulation of a website but to indicate specific circumstances that would be credible evidence of manipulation, such as obvious signs of falsification, indisputable contradictions in the information submitted or clear inconsistencies justifying the existence of doubts as to the authenticity of the screen captures.

#### d) Grace period

- [Judgment of 14 June 2011, Sphere Time v OHIM – Punch \(Watch attached to a lanyard\) \(T-68/10, EU:T:2011:269\)](#)<sup>33</sup>

In this judgment, the factual and legal context of which has been set out above,<sup>34</sup> the Court makes the application of Article 7(2) of Regulation No 6/2002 in invalidity proceedings subject to the condition that the holder of the design in respect of which the application for a declaration of invalidity has been made must establish that he is either the designer of the design upon which that application is based or the successor in title to that designer. As a reminder, Article 7(2) of Regulation No 6/2002 allows disclosure to be disregarded if a design for which protection is claimed has been made available to the public 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, during the 12-month period preceding the date of filing of the application for registration or the date of priority.

## 5. Design which constitutes a component part of a complex product

#### a) Requirements for protection

- [Judgment of 9 September 2014, Biscuits Poult v OHIM – Banketbakkerij Merba \(Biscuit\) \(T-494/12, EU:T:2014:757\)](#)

Biscuits Poult SAS was the holder of a Community design, representing biscuits, registered with OHIM [now EUIPO] pursuant to Regulation No 6/2002. The Board of Appeal, annulling the decision of the Invalidity Division that rejected the application for a declaration of invalidity submitted by Banketbakkerij Merba BV, declared the contested design invalid on the ground that it lacked individual character.

Hearing an action, which it dismisses, against the decision of the Board of Appeal, the Court considers that the non-visible characteristics of the product at issue, which do not relate to its

<sup>33</sup> . See also the headings '1. 3. c. Individual character – Informed user' and '1. 3. e. Individual character – Overall impression'.

<sup>34</sup> As regards the factual and legal context of the dispute, see the heading '1. 3. c. Individual character – Informed user', p. 13.

appearance, could not be taken into account in the determination of whether the contested design could be protected.

In this judgment, the Court clarifies that Article 4(2) of Regulation No 6/2002 lays down a particular rule applying specifically to a design applied to or incorporated in a product which constitutes a component part of a complex product within the meaning of Article 3(c) of that regulation. Under that rule, this type of design is protected only if, first, the component part, once it has been incorporated into the complex product, remains visible during normal use of that product and, secondly, the visible features of the component part fulfil in themselves the requirements as to novelty and individual character. Given the particular nature of components of a complex product within the meaning of Article 3(c) of Regulation No 6/2002, which may be produced and marketed separately from the complex product, it is reasonable for the legislature to provide for the possibility of having them registered as designs, subject to their being visible after incorporation into the complex product and only in respect of the visible parts of the components in question at the time of normal use of the complex product and in so far as those parts are new and have individual character. The Court infers that, provided that a product – in the case in point a biscuit – is not a complex product within the meaning of Article 3(c) of Regulation No 6/2002, because it is not composed of multiple components which can be replaced permitting disassembly and re-assembly, the Board of Appeal did not err in taking the view that the non-visible features of the product, which do not relate to its appearance, cannot be taken into account in the determination of whether the design at issue can be protected.

- [Judgment of 3 October 2014, Cezar v OHIM – Poli-Eco \(Insert\) \(T-39/13, EU:T:2014:852\)](#)

Cezar Przedsiębiorstwo Produkcyjne Dariusz Bogdan Niewiński was the holder of a Community design, representing skirting boards, registered with OHIM [now EUIPO] pursuant to Regulation No 6/2002. The Invalidity Division, granting the application for a declaration of invalidity submitted by Poli-Eco Tworzywa Sztuczne sp. z o.o, declared the design invalid on the ground that it was not new.

Hearing an action, which it upholds, against the decision of the Board of Appeal upholding the decision of the Invalidity Division, the Court considers that the novelty and individual character of a Community design cannot be assessed by comparing that design with an earlier design which, as a component part of a complex product, is not visible during normal use of that product.

The criterion of visibility as set out in recital 12 of Regulation No 6/2002, according to which the protection afforded to Community designs should not be extended to those component parts which are not visible during normal use of a product, nor to those features of such a part which are not visible when the part is mounted, therefore applies to the prior design.

- [Judgment of 28 October 2021, Ferrari \(C-123/20, EU:C:2021:889\)](#)

On 2 December 2014, Ferrari SpA had presented to the public for the first time the top-of-the-range FXX K car model, in a press release containing two photographs showing, respectively, a side view and a front view of that vehicle.

Since 2016, Mansory Design & Holding GmbH ('Mansory Design'), established in Germany, had produced and marketed sets of personalisation accessories, known as 'tuning kits', designed to alter the appearance of another road-going Ferrari model, produced in a series, in such a way as to make it resemble the appearance of the Ferrari FXX K.

Ferrari had brought an action for infringement and related claims against Mansory Design, on account of an alleged infringement of the rights conferred by three unregistered Community designs in respect of parts of the FXX K model, namely components of its bodywork. Those Community designs arose at the time of the publication of the press release of 2 December 2014.

The Landgericht Düsseldorf (Regional Court, Düsseldorf, Germany) dismissed those applications in their entirety. Following an appeal brought before the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany), that court dismissed Ferrari's appeal, holding that the first and second designs claimed never existed, since Ferrari had not shown that the minimum requirement of a certain autonomy and consistency of form had been satisfied, whereas the third design claimed did indeed exist, but had not been infringed by Mansory Design.

The Court of Justice, to which a question had been referred for a preliminary ruling, rules on whether the making available to the public of images of a product, such as the publication of photographs of a car, could lead to the making available to the public of a design on a part or a component part of that product and, if so, to what extent the appearance of that part or component part must be independent of the product as a whole in order for it to be possible to examine whether that appearance has individual character.

The Court holds, *inter alia*, that EU law 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, results in the making available to the public of a design on a part of that product or on a component part of that product, as a complex product, provided that the appearance of that part or component part is clearly identifiable at the time that design is made available.<sup>35</sup>

In the first place, the Court notes that the material conditions required for the protection of a Community design to arise, whether registered or not, namely novelty and individual character, are the same for both products and parts of a product.<sup>36</sup> Provided that those material conditions are satisfied, the formal condition for giving rise to an unregistered Community design is that of making available to the public within the meaning of Article 11(2) of Regulation No 6/2002.<sup>37</sup> In order for the making available to the public of the design of a product taken as a whole to entail the making available of the design of a part of that product, it is essential that

<sup>35</sup> Within the meaning of Article 3(a) and (c), Article 4(2) and Article 11(2) of Regulation No 6/2002.

<sup>36</sup> Within the meaning of Articles 4 to 6 of Regulation No 6/2002.

<sup>37</sup> In accordance with that article, 'a design shall be deemed to have been made available to the public within the European Union 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 [European Union].'

the appearance of that part is clearly identifiable when the design is made available. However, that does not imply an obligation for designers to make available separately each of the parts of their products in respect of which they seek to benefit from unregistered Community design protection.

In the second place, the Court points out that the concept of 'individual character', within the meaning of Article 6 of Regulation No 6/2002,<sup>38</sup> governs not the relationship between the design of a product and the designs of its component parts, but rather the relationship between those designs and other earlier designs. In order for it to be possible to examine whether the appearance of a part of a product or a component part of a complex product satisfies the condition of individual character, it is necessary for that part or component part to constitute a visible section of the product or complex product, clearly defined by particular lines, contours, colours, shapes or texture. That presupposes that the appearance of that part or component part is capable, in itself, of producing an overall impression and cannot be completely lost in the product as a whole.

#### **b) Repair of a complex product**

- [Judgment of 20 December 2017, Acacia and D'Amato \(C-397/16 and C-435/16, EU:C:2017:992\)](#)

Audi and Porsche were the holders of several Community designs of original alloy car wheel rims. Acacia produced and sold replica wheel rims, often aesthetically or functionally identical to the original wheel rims. Audi and Porsche had brought actions, before the Tribunale di Milano (District Court, Milan, Italy) and the Landgericht Stuttgart (Regional Court, Stuttgart, Germany) respectively, seeking a declaration that Acacia's manufacture and sale of the wheel rims at issue constituted an infringement of their Community designs. Hearing appeals against those two decisions, the Italian and German referring courts stayed proceedings in order to refer questions to the Court of Justice for a preliminary ruling on the interpretation of the 'repair' clause laid down in Article 110(1) of Regulation No 6/2002.

Under that clause, protection as a Community design does not exist for a design which constitutes a component part of a complex product used for the purpose of the repair of that complex product so as to restore its original appearance.

When asked whether Article 110(1) of Regulation No 6/2002 makes the exclusion of protection provided for in that article subject to the condition that the protected design of the component part at issue is dependent upon the appearance of the complex product into which it is incorporated, the Court draws attention to the objective pursued by Article 110(1) of Regulation No 6/2002, which is to avoid the creation of captive markets in certain spare parts and, in particular, to prevent a consumer who has bought a long-lasting and perhaps expensive product from being indefinitely tied, for the purchase of external parts, to the manufacturer of the complex product. From that point of view, and applying a literal and teleological interpretation,

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<sup>38</sup> Article 6(1) of Regulation No 6/2002 provides that a design is to 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.

the Court holds that the scope of that provision is not limited to component parts of a complex product 'upon whose appearance the protected design is dependent', pointing out that that interpretation contributes to the objective of the 'repair' clause to limit the creation of captive markets in spare parts.

Also asked about the conditions governing the application of the exclusion provided for in the 'repair' clause, the Court first of all points out that that exclusion is applicable only to component parts which are protected as a Community design and which, therefore, satisfy the conditions for protection laid down in particular in Article 4(2) of Regulation No 6/2002. Under that provision, a product which constitutes a component part of a complex product is to be protected where, first, the component part, once it has been incorporated into a complex product, remains visible during normal use of that product and, secondly, the visible features of the component part fulfil in themselves the requirements as to novelty and individual character set out in Article 4(1) of that regulation. This applies to the Community designs of car wheel rims of which the manufacturers concerned are the holders.

Next, the Court considers those wheel rims to be 'component parts of a complex product' within the meaning of Article 110(1), such a wheel rim being a component of a car, without which that product could not be subject to normal use. As regards the condition that the component part at issue be 'used ... for the purpose of the repair of that complex product', the Court points out that the 'repair' clause excludes any use of a component part for reasons of preference or purely of convenience, such as, *inter alia*, the replacement of a part for aesthetic purposes or customisation of the complex product, but rather that it requires that its use be necessary for the repair of a complex product that has become defective. Finally, the Court considers that the repair had to be carried out so as to restore the complex product to its original appearance. In that regard, the Court draws attention to the need for a component part that is used to repair the appearance of the complex product within the meaning of that provision to be visible. In the light of those considerations, the Court concludes that Article 110(1) of Regulation No 6/2002 applies only to component parts of a complex product that are visually identical to original parts, which is not the case if the replacement part does not correspond, in terms of its colour or its dimensions, to the original part, or if the appearance of a complex product has changed since it was placed on the market.

Finally, when asked whether eligibility for the exclusion provided for in Article 110(1) of Regulation No 6/2002 requires the manufacturer or seller of a component part of a complex product to ensure that the component part can be purchased exclusively for repair purposes, and if so, how, the Court makes clear that the manufacturer or seller of a component part of a complex product which seeks to benefit from the derogation provided for in that provision is under a duty of diligence. In that connection, such a manufacturer or seller must, in particular, inform the downstream user, through a clear and visible indication on the product, on its packaging, in the catalogues or in the sales documents, that the component part concerned incorporates a design of which they are not the holder and that the part is intended exclusively to be used for the purpose of the repair of the complex product so as to restore its original appearance. It is also required to ensure, through appropriate means, in particular contractual means, that downstream users do not intend to use the component parts at issue in a way that does not comply with the conditions prescribed by Article 110(1) of Regulation No 6/2002 and,

furthermore, to refrain from selling such a component part where they know or ought reasonably to know that the part in question will not be used in accordance with the prescribed conditions.

## **6. Designs dictated by their technical function and designs of interconnections**

- [Judgment of 8 March 2018, DOCERAM \(C-395/16, EU:C:2018:172\)](#)

DOCERAM GmbH was the holder of several registered Community designs for centring pins for welding. That company had brought an action for an injunction against CeramTec GmbH, which also manufactured and sold centring pins in the same variants as those protected by those designs. Following a counterclaim for a declaration of invalidity, those designs were declared invalid on the ground that the features of appearance of the products in question were dictated solely by their technical function.

Hearing the case, the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany) decided to refer a question to the Court of Justice for a preliminary ruling and asked it whether the existence of alternative designs is decisive in assessing whether features of appearance of a product are solely dictated by its technical function.

The Court rules, first, 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 solely 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.

First of all, from a literal point of view, the Court finds that Article 8(1) of Regulation No 6/2002 does not lay down any criterion for determining whether the relevant features of appearance of a product are solely dictated by its technical function and that it does not follow from any provision of that regulation that the existence of alternative designs which fulfil the same technical function as that of the product concerned is the only criterion for determining the application of that article.

Next, from a contextual point of view, the Court observes that Article 8(1) of Regulation No 6/2002 appears in Section 1 of Title II thereof, entitled 'Requirements for protection', and refers to cases in which protection is not conferred by a Community design on the features of appearance of a product where they are dictated solely by its technical function. Furthermore, according to recital 10 of that regulation, it does not follow from the exclusion of protection in that case that a design must have an aesthetic quality. The Court infers therefrom that it is not essential for the appearance of the product in question to have an aesthetic aspect to be protected under that regulation.

However, it recalls that appearance is the decisive factor of a design and that such a finding supports an interpretation of Article 8(1) of Regulation No 6/2002 according to which that provision excludes from the protection conferred by that regulation a case in which the need to fulfil a technical function of the product concerned is the only factor determining the choice by

the designer of a feature of appearance of that product, while considerations of another nature, in particular those related to its visual aspect, have not played a role in the choice of that feature.

Finally, the Court finds that that interpretation is supported by the objective pursued by Regulation No 6/2002. It is clear from recitals 5 and 7 that that regulation aims to create a Community design which is directly applicable in each Member State which is protected in one area encompassing all Member States, encouraging the innovation and development of new products as well as investment in their production by offering enhanced protection for industrial design. As regards, in particular, Article 8(1) of Regulation No 6/2002, read in the light of recital 10 thereof, that provision intends to prevent technological innovation from being hampered by granting design protection to features dictated solely by a technical function of a product.

Secondly, the Court rules that, in order to determine whether the relevant features of appearance of a product are solely dictated by its technical function, the national court must take account of all the objective circumstances relevant to each individual case and that, in that regard, there is no need to base those findings on the perception of an 'objective observer'.

It states that such an assessment must be made, in particular, having regard to the design at issue, the objective circumstances indicative of the reasons which dictated the choice of features of appearance of the product concerned, or information on its use or the existence of alternative designs which fulfil the same technical function, provided that those circumstances, data, or information as to the existence of alternative designs are supported by reliable evidence.

- [Judgment of 18 November 2020, Tinnus Enterprises v EUIPO – Mystic Products and Koopman International \(Fluid distribution equipment\) \(T-574/19, EU:T:2020:543\)](#)<sup>39</sup>

Tinnus Enterprises LLC was the holder of the Community design filed on 10 March 2015 with EUIPO and intended to be applied to the product 'fluid distribution equipment'. On 7 June 2016 and 19 April 2017, Mystic Products Import & Export SL and Koopman International BV, respectively, had submitted an application for a declaration of invalidity in respect of the contested design. They relied, in particular, on Article 8(1) of Regulation No 6/2002, according to which a Community design is not to subsist in features of appearance of a product which are solely dictated by its technical function.

By a confirmatory decision of 12 June 2019, the Board of Appeal of EUIPO declared that the design at issue was invalid, concluding that it was based on features of appearance of a product, namely fluid distribution equipment, solely dictated by the technical function of that product.

Hearing an action, which it dismisses, against the decision of the Board of Appeal, the General Court interprets, for the first time, Article 8(1) of Regulation No 6/2002, according to which a Community design is not to subsist in features of appearance of a product which are solely

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<sup>39</sup> The appeal brought against that judgment was not allowed to proceed (order of 5 May 2021, [Tinnus Enterprises v EUIPO](#) (C-29/21 P, not published, EU:C:2021:357).

dictated by its technical function, thereby supplementing the Court of Justice's analysis in the judgment of 8 March 2018, *DOCERAM*.<sup>40</sup>

First of all, the Court recalls that, according to the judgment in *DOCERAM*, in order to assess whether features of appearance of a product are solely dictated by its technical function, it has to be established that the technical function is the only factor which has determined those features, the existence of alternative designs not being decisive in that regard. The assessment must be made in three stages, namely determining the technical function of the product concerned, assessing the features of appearance of that product and examining whether, in the light of all of the relevant objective circumstances, those features are solely dictated by the technical function of the product concerned. The Court specifies that, if at least one of the features of appearance of the product concerned is not solely dictated by the technical function of that product, the design remains valid and protects that feature.

Furthermore, the Court observes that if all the features of appearance of the product concerned are solely dictated by its technical function, a design will not be valid, unless it is apparent that the arrangement of those features was dictated by considerations not concerned solely with the need to fulfil the technical function of the product concerned, creating, in particular, an overall visual impression going beyond mere technical function.

Next, after recalling that the identification of the features of appearance of a product must be carried out on a case-by-case basis either by means of a simple visual analysis of the design, or by a detailed examination of that design, the Court confirms the approach taken by EUIPO and finds that the fact that the features of appearance of the product concerned coincide with its individual component parts does not mean that EUIPO erred in the identification of those features.

Furthermore, the Court recalls that, according to the judgment in *DOCERAM*, the existence of alternative designs which fulfil the same technical function constitutes a relevant objective circumstance that has to be taken into consideration in the assessment as to whether the features of appearance of the product concerned are solely dictated by its technical function. In that regard, the Court considers that EUIPO correctly took into account, in its assessment of the design at issue, not only the existence of other designs held by Tinnus Enterprises, but also other relevant objective circumstances, in particular its European patent application, in order to conclude that all the features of appearance of the product at issue were solely dictated by its technical function.

Finally, the Court finds that EUIPO took into account all the relevant objective circumstances, supported by reliable evidence, in order to conclude that the appearance of the product at issue is not the result of a specific arrangement of its features determined by aesthetic considerations but is solely dictated by the technical functions of that product.

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<sup>40</sup> See judgment of the Court of Justice of 8 March 2018, *DOCERAM* (C-395/16, EU:C:2018:172), set out in this fact sheet under the heading '1. 6. Designs dictated by their technical function and designs of interconnections', p. 30.

## 7. Conflict with a prior design

- [Judgment of 18 March 2010, Grupo Promer Mon Graphic v OHIM – PepsiCo \(Representation of a circular promotional item\) \(T-9/07, EU:T:2010:96\)](#) <sup>41</sup>

PepsiCo was the holder of a Community design, representing promotional items for games, registered with OHIM [now EUIPO] pursuant to Regulation No 6/2002. The Board of Appeal, annulling the decision of the Invalidity Division that granted the application for a declaration of invalidity submitted by Grupo Promer, held that the contested design was not in conflict with a prior design.

Hearing an action, which it upholds, against the decision of the Board of Appeal, the Court annuls that decision, holding that the differences between the designs at issue were insufficient to produce a different overall impression on the informed user.

The Court states that the list of grounds on which a Community design may be declared invalid established by Article 25(1) of Regulation No 6/2002 must be regarded as exhaustive and does not include bad faith on the part of the holder of the contested Community design. The Court also defines certain fundamental concepts of Regulation No 6/2002. As regards the concept of 'conflict', the Court observes that Article 25(1)(d) of Regulation No 6/2002 must be interpreted as meaning that a Community design is in conflict with a prior design when, taking into consideration the freedom of the designer in developing the Community design, that design does not produce on the informed user a different overall impression from that produced by the prior design relied on. Moreover, the Court clarifies the scope of the concepts of 'the degree of freedom of the designer in developing his design', of 'informed user' and of 'overall impression'. As regards a designer's degree of freedom in developing his design, the Court holds that it must be 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.

- [Judgment of 21 April 2021, Bibita Group v EUIPO – Benkomers \(Beverage bottle\) \(T-326/20, EU:T:2021:208\)](#)

On 13 March 2017, Benkomers OOD had filed an application for registration of a Community design representing a beverage bottle with EUIPO. Following registration of the design, the applicant, Bibita Group, had filed an application for a declaration of invalidity of that design, in support of which it relied on Article 25(1)(d)(iii) of Regulation No 6/2002. Bibita Group submitted that, since, in the context of Article 25(1)(d)(iii) of Regulation No 6/2002, the same criteria as for the assessment of individual character under Article 25(1)(b), read in conjunction with Article 6 of that regulation, should be applied, the contested design lacked individual character in relation to the design of which it was the holder, which had been protected from a date prior to the application for registration of the contested design. The application for a declaration of

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<sup>41</sup> The appeal brought against that judgment was dismissed by the judgment of 20 October 2011, [PepsiCo v Grupo Promer Mon Graphic](#) (C-281/10 P, EU:C:2011:679), which can be found under the heading '1. 3. c. Individual character – Informed user'.

invalidity<sup>42</sup> was rejected by the Invalidity Division and the Board of Appeal of EUIPO dismissed the appeal.

In this judgment, the Court dismisses the action brought by Bibita Group against the decision of the Board of Appeal and clarifies the concept of 'conflict' within the meaning of Article 25(1)(d) of Regulation No 6/2002.

First of all, it recalls that, according to settled case-law, Article 25(1)(d) of Regulation No 6/2002 must be interpreted as meaning that a Community design is in conflict with a prior design when, taking into consideration the freedom of the designer in developing the Community design, that design does not produce on the informed user a different overall impression from that produced by the prior design relied on.

Next, as regards the argument that the prior design enjoyed particularly broad protection, the Court states that, despite the reference in recital 14 of Regulation No 6/2002 to the existence of a 'clear' difference between the overall impressions produced by the designs at issue, the wording of Article 6 of that regulation is clear and unambiguous. Thus, in accordance with the case-law relating to that provision, it must be borne in mind, for the purposes of applying Article 25(1)(d) of that regulation and assessing whether there is a conflict between the designs at issue, that a design is eligible for the protection afforded by the Community design if it produces on the informed user a different overall impression from that produced by a prior design.

Furthermore, the Court points out that, even if it were established that, at the date of its registration, the shape of the prior design would have been entirely new in the industrial sector concerned, the uniqueness of such a shape does not confer on the prior design broader protection than that which it enjoys under Regulation No 6/2002. Moreover, the allegedly unprecedented character or originality of the appearance of the prior design has no influence on the assessment of the individual character of the contested design.

Lastly, after recalling the criteria for assessing the individual character of a Community design, the Court carries out an assessment of the overall impression produced by the designs at issue on the informed user. It points out that the assessment to be made in that regard involves taking into account all the elements that distinguish the designs at issue, other than those which remain insufficiently significant to affect that overall impression.

The designs at issue have significant differences. Consequently, the Court holds that the Board of Appeal was correct in concluding that the contested design was not in conflict with the prior design within the meaning of Article 25(1)(d)(iii) of Regulation No 6/2002.

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<sup>42</sup> In accordance with Article 25(1)(d)(iii) of Regulation No 6/2002, as amended, a Community design may be declared invalid if it is in conflict with a prior design which has been made available to the public after the date of filing of the application or, if priority is claimed, the date of priority of the Community design, and which is protected from a date prior to the said date by a design right registered under the Geneva Act of the Hague Agreement concerning the international registration of industrial designs, adopted in Geneva on 2 July 1999, which was approved by Council Decision 2006/954/EC of 18 December 2006 (OJ 2006 L 386, p. 28), and which has effect in the Community, or by an application for such a right.

## 8. Use of a distinctive sign in a subsequent design

- [Judgment of 12 May 2010, Beifa Group v OHIM – Schwan-Stabilo Schwanhäüßer \(Instrument for writing\) \(T-148/08, EU:T:2010:190\)](#)

Beifa Group Co. Ltd. was the holder of a Community design, representing instruments for writing, registered with OHIM [now EUIPO] pursuant to Regulation No 6/2002. Hearing an application for a declaration of invalidity submitted by Schwan-Stabilo Schwanhäüßer GmbH & Co. KG, the proprietor of an earlier three-dimensional mark, the Invalidity Division had declared the contested design invalid. In essence, it had found that the earlier mark was used in the contested design, with the result that that design was similar to that mark. Since the products covered by the contested design were identical to those covered by the earlier mark, there was – in the view of the Invalidity Division – a likelihood of confusion on the part of the public targeted by those products.

Hearing an action, which it upholds, against the decision of the Board of Appeal upholding the decision of the Invalidity Division, the Court annuls that decision and clarifies the interpretation of Article 25(1)(e) of Regulation No 6/2002, which provides that a Community design may be declared invalid only if a distinctive sign is used in a subsequent design, and Community 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. According to the Court, that article also covers the situation of similarity between signs and not only that of identity, so that the Board of Appeal did not err in law by interpreting the provision as meaning that the proprietor of a distinctive sign may rely on that provision for the purposes of applying for a declaration of invalidity in respect of a subsequent Community design, where use is made in that design of a sign similar to its own.

The Court also examines the issue of the procedure for requesting proof of genuine use to be followed by the holder of the Community design in respect of which an application for a declaration of invalidity has been brought, in the absence of specific provisions in that regard in Regulation No 6/2002. The Court observes that that request must be submitted to EUIPO expressly and in due time. On the other hand, a request for proof of genuine use of the earlier sign relied on in support of an application for a declaration that a Community design is invalid cannot be made for the first time before the Board of Appeal.

- [Judgment of 24 September 2019, Piaggio & C. v EUIPO – Zhejiang Zhongneng Industry Group \(Mopeds\) \(T-219/18, EU:T:2019:681\)](#)<sup>43</sup>

Zhejiang Zhongneng Industry Group Co. Ltd was the holder of a Community design, representing mopeds and motorcycles, registered with EUIPO pursuant to Regulation No 6/2002. The Board of Appeal of EUIPO, annulling the decision of the Invalidity Division that granted the application for a declaration of invalidity submitted by Piaggio & C. SpA, held that the contested design did not lack novelty or individual character.

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<sup>43</sup> See also the heading '1. 9. Unauthorised use of a work protected by copyright'.

Hearing an action, which it dismisses, against the decision of the Board of Appeal, the Court holds that the Board of Appeal did not make an error of assessment in taking the view that there was no likelihood of confusion on the part of the relevant public, which included the likelihood of association, for the purposes of the application of Article 25(1)(e) of Regulation No 6/2002.

In this judgment, the Court clarifies the scope of and concepts relating to the ground for invalidity of a registered Community design based on the use, in a design, of an earlier distinctive sign in breach of Article 25(1)(e) of Regulation No 6/2002.

In that regard, the Court takes the view that due to (i) the overall visual impression produced by the earlier mark relied on by Piaggio & C., constituted by the three-dimensional scooter shape which is also protected by the earlier design, which is different from that emanating from the contested design, and (ii) the importance of aesthetics in the decision which he makes, the average consumer, who displays a high level of attention, will rule out the possibility that the earlier mark may be used in the contested design, despite the fact that the goods concerned are identical.

More specifically, the Court points out that when he observes the three-dimensional scooter shape protected by the earlier mark and that of the contested design, the average consumer, who is not an expert with in-depth technical skills, will not be able to spontaneously identify the 'X' shape between the rear fairing and the under-seat assembly or the inverted 'Ω' shape between the under-seat assembly and the front shield, nor will he automatically notice the arrow shape of the front shield, even when displaying a high level of attention. As to the fairing, he will rather notice the difference between the tapered shape of the fairing of the earlier mark, where that of the contested design looks more like a semicircle. More generally, the average consumer, who displays a high level of attention, will perceive the style, lines and look which characterise the three-dimensional scooter shape protected by the earlier mark as different, visually, from those of the contested design.

## 9. Unauthorised use of a work protected by copyright

- [Judgment of 23 October 2013, Viejo Valle v OHIM – Établissements Coquet \(Cup and saucer with grooves and soup dish with grooves\) \(T-566/11 and T-567/11, EU:T:2013:549\)](#)

Viejo Valle, SA, was the holder of Community designs representing a cup and saucer with grooves and a soup dish with grooves. The intervener, Établissements Coquet, submitted applications for a declaration of invalidity of those designs based on Article 25(1)(f) of Regulation No 6/2002. It relied on two items of crockery for which it claimed copyright protection under French law. OHIM [now EUIPO] declared the contested designs invalid.

Hearing an action, which it dismisses, against the decision of the Board of Appeal, the Court states that Article 25(3) of Regulation No 6/2002 and Article 28(1)(b)(iii) of Regulation No 2245/2002 require that the applicant for a declaration of invalidity of a Community design on the basis of a copyright protected under the law of a Member State be the holder of that copyright and that it provide EUIPO with particulars establishing that fact.

The question of whether the applicant for a declaration of invalidity is the holder of the copyright, within the meaning of that provision, and the question of proving that right before the Office, cannot be answered without having regard to the law of the Member State, in the present case French law, which is relied on in support of the application for a declaration of invalidity. The law of the relevant Member State serves in particular, in that context, to define the procedures for acquiring and proving copyright of the work relied on in support of the application for a declaration of invalidity.

- [Judgment of 24 September 2019, Piaggio & C. v EUIPO – Zhejiang Zhongneng Industry Group \(Mopeds\) \(T-219/18, EU:T:2019:681\)](#)<sup>44</sup>

In this judgment, the factual and legal context of which has been set out above,<sup>45</sup> the Court holds that the Board of Appeal did not make an error of assessment in considering, on the basis of the evidence available to it, that the scooter design corresponding to the earlier design, protected by Italian and French copyright, was not the subject of an unauthorised use in the contested design for the purposes of the application of Article 25(1)(f) of Regulation No 6/2002.

In that regard, the Court points out that under Italian copyright, the use of the artistic and creative core constituted by the features of shape of the scooter design corresponding to the earlier design cannot be discerned in the contested design. Between the rear fairing and the under-seat assembly and between the under-seat assembly and the front shield, the lines of the contested design rather have an angular look. Its pointed front shield represents a 'necktie' up to the mudguard, rather than an arrow. As to the fairing, the shape of that of the contested design is not tapered, unlike the teardrop shape of the fairing of the earlier design.

Moreover, according to the Court, neither can the specific overall look and particular shape, which has a 'rounded, feminine and "vintage" character', of the earlier design be found in the contested design, which is characterised by straight lines and angles, so that the impressions which emanate from the work corresponding to the earlier design and from the contested design are different.

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<sup>44</sup> See also the heading '1. 8. Use of a distinctive sign in a subsequent design'.

<sup>45</sup> As regards the factual and legal context of the dispute, see the heading '1. 8. Use of a distinctive sign in a subsequent design', p. 36.

## II. Rights conferred by designs

### 1. Ownership of the right to the design

- [Judgment of 2 July 2009, FEIA \(C-32/08, EU:C:2009:418\)](#)

The Fundación Española para la Innovación de la Artesanía ('the FEIA') had designed the D'ARTES project, in which skilled workshops could produce, by means of a design project executed by a professional, a family of objects to be placed on the market. AC&G SA, as organiser of the project, was responsible for selecting the designers and concluding agreements with them. It had entered into an oral agreement with Cul de Sac Espacivaio Creativo SL ('Cul de Sac'), which was not subject to the Spanish Labour Code, under which Cul de Sac was responsible for developing a design with a view to the creation of a new collection of products.

Cul de Sac had designed a series of wall clocks (cuckoo clocks), which were manufactured and released as part of the D'ARTES project. Cul de Sac and Acierta Product & Position SA had subsequently produced and placed on the market the cuckoo clocks. An action for infringement had been brought against them before the Juzgado de lo Mercantil nº 1 de Alicante y nº 1 de Marca Comunitaria (Commercial Court No 1 of Alicante and Community Trade Mark Court No 1, Spain) by the FEIA, which argued that it owned the unregistered Community designs for the cuckoo clocks at issue.

The Court of Justice, to which questions had been referred for a preliminary ruling regarding the ownership of a Community design that has been produced as a result of a commission, rules that Article 14(3) of Regulation No 6/2002, which provides that the right to the Community design vests in the employer where a design is developed by an employee in the execution of his duties or following the instructions given by his employer, unless otherwise agreed or specified under national law, does not apply to a Community design that has been produced as a result of a commission.

Indeed, the Community legislature intended to define the special system set out in Article 14(3) of the regulation by reference to a specific type of contractual relationship, namely that of an employment relationship, which precludes the application of Article 14(3) to other contractual relationships, such as that relating to a Community design that has been produced as a result of a commission.

Where, on the one hand, there are unregistered Community designs produced as a result of a commission, and on the other, the national legislation does not deem such designs to be the same as designs developed in the context of an employment relationship, Article 14(1) of Regulation No 6/2002 must be interpreted as meaning that the right to the Community design vests in the designer, unless it has been assigned by way of contract to his successor in title.

The possibility of assigning by way of contract the right to the Community design from the designer to his successor in title within the meaning of Article 14(1) of the regulation both stems from the wording of that article and is consistent with the aims of the regulation. In that regard, adapting the protection of Community designs to the needs of all sectors of industry in the Community by means of a contractual assignment of the right to the Community design is likely

to help to achieve the essential objective of the enforcement of the rights conferred by a Community design in an efficient manner throughout the territory of the Community. Moreover, enhanced protection for industrial design not only promotes the contribution of individual designers to the sum of Community excellence in the field, but also encourages innovation and development of new products and investment in their production.

It is, however, for the national court to ascertain the contents of such a contract and in that regard to determine whether the right to the unregistered Community design has in fact been transferred from the designer to his successor in title, by applying, in the context of that assessment, the law on contracts in order to determine who owns the right to the unregistered Community design, in accordance with Article 14(1) of the regulation.

## 2. Effects of the right to the design

- [Judgment of 16 February 2012, Celaya Empananza y Galdos International \(C-488/10, EU:C:2012:88\)](#)

Celaya Empananza y Galdos Internacional SA was the holder of a Community design consisting of a beacon-like marker used for traffic signalling purposes, filed with EUIPO on 26 October 2005. In 2007, Proyectos Integrales de Balizamiento SL had marketed a beacon-like marker. In 2008, it had obtained, before EUIPO, registration of a Community design consisting of that marker. Considering that that marker did not produce an overall impression different from that of its design, Celaya Empananza y Galdos Internacional brought infringement proceedings before the Juzgado de lo Mercantil nº 1 de Alicante y nº 1 de Marca Comunitaria (Commercial Court No 1 of Alicante and Community Trade Mark Court No 1, Spain). Proyectos Integrales de Balizamiento contended that, until such time as the registration of its design was cancelled, it enjoyed a right of use, so that the exercise of that right could not be deemed to be an infringement.

On a request for a preliminary ruling, the Court rules that Article 19(1) of Regulation No 6/2002 must be interpreted as meaning that, in a dispute relating to infringement of the exclusive right conferred by a registered Community design, the right to prevent use by third parties of the design extends to any third party who uses a design that does not produce on informed users a different overall impression, including the third party holder of a later registered Community design, irrespective of the intention or conduct of the third party.

The provisions of the regulation must be interpreted in the light of the priority principle, under which the earlier registered Community design takes precedence over later registered Community designs. It follows in particular from Article 4(1) of the regulation that a design is to be protected by a Community design to the extent that it is new and has individual character. However, where two registered Community designs are in conflict with each other, the design that was registered first is deemed to have met those conditions for obtaining protection before the design that was registered second. Thus, the holder of the later registered Community design may be afforded the protection conferred by the regulation only if he can demonstrate that the earlier registered Community design fails to meet one of those conditions, by seeking a declaration of invalidity, where appropriate by way of counterclaim.

Under the procedure for the registration of Community designs, governed by Articles 45 to 48 of Regulation No 6/2002, EUIPO is to examine whether an application complies with the formal requirements for filing, as laid down in that regulation. If the application satisfies those requirements, corresponds to the definition of a design under Article 3(a) of the regulation and is not contrary to public policy or to accepted principles of morality, EUIPO is to register the application in the Community design Register as a registered Community design. That procedure therefore amounts to an essentially formal, expeditious check, which, as indicated in recital 18 of the regulation, does not require any substantive examination as to compliance with the requirements for protection prior to registration, and which, unlike the registration procedure under Regulation No 207/2009 on the Community trade mark, does not provide for any stage during which the holder of an earlier registered design can oppose registration. In those circumstances, only an interpretation of the term 'any third party' within the meaning of Article 19(1) of the regulation as encompassing the third party holder of a later registered Community design is capable of ensuring attainment of the objective of effective protection of registered Community designs pursued by the regulation, as well as the effectiveness of infringement proceedings.

- [Judgment of 22 June 2016, Thomas Philipps \(C-419/15, EU:C:2016:468\)](#)

Grüne Welle Vertriebs GmbH was the exclusive licensee for Germany for a Community design for laundry balls. That licence had not been entered in the register of Community Designs. Thomas Philipps GmbH distributed promotional items including a laundry ball. Taking the view that that product was a copy of the registered Community design for laundry balls and that it was empowered by the rightholder of that design to bring all claims arising from the design in its own name, Grüne Welle Vertriebs sent a letter before action to Thomas Philipps demanding that it refrain from selling the laundry balls and brought an action for damages.

Hearing the case, the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany) raised the question, first, whether Grüne Welle Vertriebs was entitled to bring proceedings although it was not entered on the register as a licensee and, second, whether it could claim damages for its own loss.

On a request for a preliminary ruling, the Court rules that, first, the first sentence of Article 33(2) of Regulation No 6/2002 must be interpreted as meaning that the licensee may bring proceedings alleging infringement of a registered Community design which is the subject of the licence although that licence has not been entered in the register of Community designs. Second, Article 32(3) of Regulation No 6/2002 must be interpreted as meaning that the licensee can claim damages for its own loss in proceedings for infringement of a Community design brought by it in accordance with that provision.

In the first place, the Court states, first of all, that Article 33(2) and (3) of Regulation No 6/2002 is intended to govern the enforceability of the legal acts referred to in Articles 28, 29 and 32 of the regulation in respect of third parties who have, or are likely to have, rights in the registered Community design.

Next, all the articles in Title III of Regulation No 6/2002, which is entitled 'Community designs as objects of property', including Article 33 of that regulation, contain rules relating to Community

designs as objects of property. This is the case with regard to Articles 28, 29 and 32 of the regulation which relate to acts the purpose or effect of which is to create or transfer a right in respect of the design.

Finally, in the first sentence of Article 32(3) of Regulation No 6/2002, the licensee's right to bring proceedings for infringement of a Community design, without prejudice to the provisions of the licensing contract, is subject only to the consent of the holder of that design.

Furthermore, according to Article 32(5) of Regulation No 6/2002, the licence is to be entered in the register at the request of one of the parties. However, that article, like Article 29 of the regulation, does not contain any provision analogous to that of Article 28(b) of the regulation, under which 'as long as the transfer has not been entered in the register, the successor in title may not invoke the rights arising from the registration of the Community design'.

Moreover, Article 28(b) of Regulation No 6/2002 would serve no useful purpose if Article 33(2) of that regulation had to be interpreted as precluding reliance, *vis-à-vis* all third parties, on all of the legal acts referred to in Articles 28, 29 and 32 of the regulation unless they have been entered in the register.

Furthermore, the lack of effects, *vis-à-vis* third parties, of the legal acts referred to in Articles 28, 29 and 32 of that regulation which have not been entered in the register is intended to protect a person who has, or may have, rights in a Community design as an object of property. It follows that the first sentence of Article 33(2) does not apply to a situation such as that in the main proceedings, in which the licence holder complains that a third party, by infringing the design, infringes the rights conferred by the registered Community design.

In the second place, the Court notes that Article 32(3) and (4) of Regulation No 6/2002 establish a system of legal remedies open to the licence holder of a Community design against the infringer of that Community design. Those provisions allow the licensee to bring proceedings either by way of an action, by bringing infringement proceedings with the consent of the design holder or, in the case of an exclusive licence, if having been given notice the rightholder does not itself bring infringement proceedings within an appropriate period, or by way of intervention in infringement proceedings brought by the rightholder in a Community design. The latter route is the only one available to the holder of a non-exclusive licence who does not obtain the consent of the rightholder of the design to act alone.

Whilst the licensee may seek damages for the loss it has incurred by intervening in the infringement proceedings brought by the rightholder of the Community design, nothing prevents it from also doing so where it brings the infringement proceedings itself with the consent of the rightholder of the design, or, if it is the holder of an exclusive licence, without that consent in the case of inaction by that rightholder after having given it notice to bring proceedings.

The system of legal remedies open to the licence holder would, moreover, lack coherence if the licensee could defend its own interests only by joining an action brought by the rightholder of the Community design when he may act alone by way of an action with the consent of that rightholder, or without its consent in the case of an exclusive licence, to defend their common interests.

### III. Procedure and disputes

#### 1. Application for registration and registration procedure – Reference date of the examination

- [Judgment of 16 February 2017, Antrax It v EUIPO – Vasco Group \(Thermosiphons for radiators\) \(T-828/14 and T-829/14, EU:T:2017:87\)](#)

Antrax It Srl was the holder of two Community designs, representing thermosiphons, registered with EUIPO pursuant to Regulation No 6/2002. The Board of Appeal, annulling the decision of the Invalidity Division that granted the applications for a declaration of invalidity submitted by the predecessor to Vasco Group NV for failure to provide an adequate statement of reasons, had declared the contested designs invalid on the ground that they lacked individual character.

Hearing an action against that first decision of the Board of Appeal, the Court had annulled that decision on the ground that it failed to state reasons on the issue of saturation of the state of the art.<sup>46</sup> The cases were then remitted to the Board of Appeal which again declared the contested designs invalid.

Hearing the actions, which it dismisses, against the new decisions of the Board of Appeal, the Court provides clarification as to the date by reference to which the individual character of a design must be examined and a determination made as to whether there is saturation of the state of the art within the meaning of Article 6(1) of Regulation No 6/2002. The applicant claimed that the Board of Appeal had erred as to when the assessment of the saturation of the state of the art is to be carried out in taking the date of delivery of the contested decisions as the correct point in time, whereas it should have been assessed by reference to the time when the application for registration of the contested designs was filed.

In that regard, the Court states that it is by reference to the date on which the application for registration of the design is filed that the individual character of the contested design must be assessed under Article 6(1) of Regulation No 6/2002 and a determination made as to whether there is saturation of the state of the art. It therefore holds that the Board of Appeal erred in law as to the date by which a determination is to be made as to whether there is saturation of the state of the art. However, it finds that that error was not such as to entail annulment of the contested decisions.

<sup>46</sup> Judgment of 13 November 2012, [Antrax It v OHIM – THC \(Radiators for heating\)](#), (T-83/11 and T-84/11, EU:T:2012:592), set out in this fact sheet under the heading '1. 3. d. Individual character – Degree of freedom of the designer', p. 14.

## 2. Application for a declaration of invalidity and invalidity proceedings

### a) Admissibility of the application for a declaration of invalidity

- [Judgment of 17 May 2018, Basil v EUIPO – Artex \(Bicycle baskets\) \(T-760/16, EU:T:2018:277\)](#)

Basil BV was the holder of a Community design representing bicycle baskets. Artex SpA had filed an application for a declaration of invalidity of that design with EUIPO, on the ground that it lacked individual character. Basil contended that that application for a declaration of invalidity was inadmissible because, in an earlier decision, EUIPO had already dismissed an application for a declaration of invalidity relating to the contested design.

EUIPO found the application for a declaration of invalidity to be admissible and declared the contested design invalid.

Hearing an action, which it dismisses, against the decision of the Board of Appeal, the Court recalls that, as regards the question of the admissibility of an application for a declaration of invalidity of a design, in respect of which EUIPO has already rejected such an application in an earlier decision, under Article 52(3) of Regulation No 6/2002, an application for a declaration of invalidity brought before EUIPO will not be admissible if an application relating to the same subject matter and cause of action, and involving the same parties, has been adjudicated on by a Community design court and has acquired the authority of a final decision. Accordingly, it rules that those provisions, which relate only to the decisions of Community design courts, do not apply to a decision of EUIPO.

In the first place, it follows from the provisions of Article 80 of Regulation No 6/2002 that a Community design court is a national court of a Member State. Article 52(3) of Regulation No 6/2002 therefore does not apply when the matter has already been adjudicated on by EUIPO, but only when it has been adjudicated on by the national court of a Member State.

In the second place, Article 86(5) of Regulation No 6/2002, according to which no counterclaim for a declaration of invalidity of a registered Community design may be made if an application relating to the same subject matter and cause of action, and involving the same parties, has already been determined by EUIPO in a decision which has become final, does not govern proceedings before EUIPO and, in particular, its Boards of Appeal, but proceedings before Community design courts.

In the third place, Article 52(3) of Regulation No 6/2002 cannot be applied by analogy to cases where EUIPO has already adjudicated on an application for a declaration of invalidity. That is because it has not been established that there is an omission in Article 52(3) of Regulation No 6/2002 that is incompatible with a general principle of law which could be remedied by an application by analogy.

### b) Subject matter of the application for a declaration of invalidity

- [Judgment of 27 April 2022, Group Nivelles v EUIPO – Easy Sanitary Solutions \(Shower drainage channel\) \(T-327/20, EU:T:2022:263\)](#) <sup>47</sup>

In this judgment, the factual and legal context of which has been set out above, <sup>48</sup> the Court had the opportunity to clarify the conditions for determining the subject matter of an application for a declaration of invalidity.

After observing that the application for a declaration of invalidity did not contain a representation of the earlier design examined by the adjudicating bodies which had made the previous decisions, the Board of Appeal of EUIPO took into account, as an earlier design, only the designs referred to in that application. It rejected that application on the ground that the contested design possessed individual character and therefore that it was, a fortiori, new.

In that regard, the Court recalls that the earlier design must be identified when the application for a declaration of invalidity is submitted, because the subject matter of the dispute is defined in the application. Accordingly, the discretion conferred on EUIPO to take into account facts or evidence which are not submitted in due time is applicable only to facts and evidence, and not to the indication and the reproduction of the earlier designs. Although further evidence may be taken into account, in addition to the earlier designs already relied on, to expand the factual context of the application for a declaration of invalidity, it may not however be used to extend the legal context of that application, since the scope of that application was definitively determined when the application was submitted, by identifying the earlier design relied on. Consequently, only the earlier designs identified in the application for a declaration of invalidity must be examined.

### c) Extent of the examination of the application for a declaration of invalidity

- [Judgment of 10 June 2020, L. Oliva Torras v EUIPO – Mecánica del Frío \(Vehicle couplings\) \(T-100/19, EU:T:2020:255\)](#)

In this judgment, the Court defines the extent of the examination to be carried out by EUIPO in the context of an application for a declaration of invalidity of a Community design based on Article 25(1)(b) of Regulation No 6/2002 and rules on the extent of EUIPO's obligation to state reasons in that regard.

The Court annuls the decision of the Board of Appeal of EUIPO relating to invalidity proceedings between L. Oliva Torras and Mecánica del Frío with regard to the registered Community design representing a coupling to hitch refrigeration or air conditioning equipment to a motor vehicle.

In the first place, the Court notes that Article 25(1)(b) of Regulation No 6/2002 confers on the adjudicating bodies of EUIPO, in the context of the examination of an application for a declaration of invalidity, the competence to monitor compliance with the essential requirements for protection of the Community design, which are laid down in Articles 4 to 9 of that regulation.

<sup>47</sup> The appeal brought against that judgment was dismissed by the order of 16 December 2022, [Group Nivelles v EUIPO](#) (C-419/22 P, not published).

<sup>48</sup> As regards the factual and legal context of the dispute, see the heading 'I. 3. e. Individual character – Overall impression', p. 18.

In that regard, the Court points out that those requirements are cumulative, so that the failure to comply with only one of them could lead to the design at issue being declared invalid. Furthermore, those provisions entail the implementation of different legal criteria. Consequently, the Court rules that the wording of Article 25(1)(b) of that regulation, read in the light of its context and objectives, must be interpreted as meaning that it does not necessarily imply an examination of compliance with all the requirements set out in Articles 4 to 9 of that regulation, but may imply, on the basis of the facts, evidence and observations submitted by the parties, an examination solely of compliance with only one or some of those requirements.

In the second place, the Court points out that it is in the light of the matters of fact and of law put forward in support of the application for a declaration of invalidity that the Board of Appeal has to determine which of the requirements laid down in Articles 4 to 9 of Regulation No 6/2002, the failure to comply with which has been relied on in the case at hand and which the Board of Appeal has to examine, taking into account, where appropriate, well-known facts and matters of law that have not been raised by the parties, but which are necessary for the application of the relevant provisions. Thus, the Court holds that the Board of Appeal erred in holding that, as the applicant's application for a declaration of invalidity was based on Article 25(1)(b) of Regulation No 6/2002, the applicant had intended to rely on the failure by the contested design to comply with all the requirements set out in Articles 5, 6, 8 and 9 of that regulation.

In the third place, the Court upholds the applicant's claim that the Board of Appeal had failed to decide on whether the contested design referred to a component part of a complex product which, once incorporated into that product, remained visible during the normal use of the product within the meaning of Article 4(2) and (3) of Regulation No 6/2002, even though that issue had been addressed in the communication of 16 May 2018<sup>49</sup> and in the subsequent observations of the parties.

In that regard, it notes, first of all, that the conclusions of the Board of Appeal with regard to the application of that article do not clearly follow from the reasoning of the contested decision, either for the parties or for the EU judiciary. In particular, the Court states that the grounds relied on by EUIPO for the first time before the EU judiciary and alleging that the applicant had not requested the application of Article 4(2) and (3) of Regulation No 6/2002 cannot remedy the lack of reasoning in the contested decision.

Next, the Court points out that, first, the question of whether Article 4(2) and (3) of Regulation No 6/2002 is applicable in the case at hand was likely, in principle, to be of decisive importance in the context of the contested decision in the light of the potential impact of that question on the grounds and operative part thereof. Second, according to the Court, it is apparent from the communication of 16 May 2018 that the Board of Appeal took the view, at that stage of the procedure, that the claims made by the parties and the evidence provided in support of those claims proved that the requirements laid down in Article 4(2) and (3) of Regulation No 6/2002 were not fulfilled.

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<sup>49</sup> Communication addressed to the parties by the Board of Appeal stating that the contested design should be declared invalid, as the requirements set out in Article 4 of Regulation No 6/2002 were not complied with.

In that regard, the Court concludes that, although the Board of Appeal could not be considered to be bound by its communication of 16 May 2018, it was nevertheless for the Board of Appeal to properly state the reasons why it considered that it should depart from the conclusions of that communication, as that communication and the subsequent observations of the parties formed part of the context in which the Board of Appeal had adopted the contested decision. The Court points out, in particular, that it is not for it to act in lieu of the Board of Appeal in carrying out the examination of the arguments, facts and evidence submitted by the applicant, an examination which the Board of Appeal had to carry out for the purposes of determining whether the application of Article 4(2) and (3) of Regulation No 6/2002 was at issue in the dispute before it. In the light of all the foregoing, the Court annuls the contested decision. However, it rejects, on the basis of the ‘Edwin’ case-law, the applicant’s request for alteration.

#### d) Evidence not submitted in due time

- [Judgment of 10 November 2021, Sanford v EUIPO – Avery Zweckform \(Labels\) \(T-443/20, EU:T:2021:767\)](#)<sup>50</sup>

In this judgment, the factual and legal context of which has been set out above,<sup>51</sup> the Court applies, in relation to Community designs, the principles relating to the admissibility of evidence submitted out of time.

In that regard, it notes that EUIPO has a broad discretion, as regards the admissibility of evidence submitted out of time, because it may disregard evidence which the parties have not submitted in due time.<sup>52</sup> The Court points out that, where EUIPO is called upon to adjudicate in invalidity proceedings, the taking into account of evidence submitted out of time may be justified where that evidence is relevant to the outcome of the application for a declaration of invalidity, the circumstances do not preclude this and the evidence is submitted by way of complement to the evidence submitted within that time limit.

In the present case, the Court finds that the Board of Appeal made appropriate use of its discretion. The evidence submitted for the first time to the Board of Appeal was intended to demonstrate that the prior design had been disclosed. Furthermore, that evidence is in addition to the evidence which had already been submitted to the Invalidity Division and considered insufficient to establish disclosure. That evidence was therefore relevant to the outcome of the dispute and could validly complement the evidence already submitted.

Furthermore, the admissibility of the evidence at issue did not infringe the applicant’s right to be heard, since it was able to submit observations in that regard before the Board of Appeal.

<sup>50</sup> See also the heading ‘1. 3. a. Individual character – Criteria for assessment’.

<sup>51</sup> As regards the factual and legal context of the dispute, see the heading ‘1. 3. e. Individual character – Overall impression’, p. 18.

<sup>52</sup> Under Article 63(2) of Regulation No 6/2002.

### e) Maintenance in an amended form

- [Order of 25 October 2021, 4B Company v EUIPO – Deenz \(Pendant \(jewellery\)\) \(T-329/20, EU:T:2021:732\)](#)

A was the holder of the right to a Community design representing a pendant in the shape of a heart on which the word 'pianegonda' was engraved. 4B Company Srl had filed an application for a declaration of invalidity of that design with EUIPO, on the ground that in that design an earlier distinctive sign was used. That application was based on the use of its EU word mark PIANEGONDA registered for goods falling within the category of jewellery.

In the invalidity proceedings, A had requested that the contested design be maintained in an amended form, in accordance with Article 25(6) of Regulation No 6/2002, without the engraving of the word corresponding to the word mark PIANEGONDA. 4B Company had opposed the maintenance of the design in an amended form on the ground that, in its view, the removal of the mark did not make it possible to retain the identity of the design. That design was subsequently assigned to Deenz Holding Ltd.

The Invalidity Division of EUIPO dismissed the application to have the contested design maintained in an amended form and declared it invalid in its entirety. Following the appeal brought by Deenz Holding, the Board of Appeal of EUIPO declared the contested design invalid in so far as it used the word mark PIANEGONDA and granted the application for maintenance in an amended form.

The Court dismisses the action brought by the applicant for a declaration of invalidity on the ground that it has no interest in bringing proceedings in an application for maintenance of the registration of the contested design in an amended form, following the annulment of that design.

In the first place, the Court notes, first of all, that the system put in place for the registration of Community designs is based on the principle that all applications which satisfy formal requirements are to be entered in the Register of Community designs. It is only following an application for a declaration of invalidity of a Community design which has been registered that the design may be declared invalid, on application by the proprietor of the sign, inter alia, if use is made of an earlier distinctive sign, such as, in the present case, an EU word mark owned by the applicant for a declaration of invalidity.

Next, the Court observes that Article 25(6) of Regulation No 6/2002 allows registration of a Community design to be maintained by removing the element vitiated by irregularity. That possibility, as an alternative solution to the invalidity of the design in its entirety, ensures that the sanction is proportionate. The maintenance of the contested design, to the extent to which that maintenance is conditional on a partial disclaimer, is intended both to protect the interests of the holder of the right to that design and those of the holder of the right to the sign the use of which has led to the design being annulled.

Lastly, the Court notes that the Invalidity Division ruled on two applications, namely, first, the application for a declaration of invalidity submitted by the applicant for a declaration of invalidity,

which in this case was granted, and, second, the application submitted by the holder of the right to the contested design to have it maintained in an amended form, which was dismissed.

It holds that that second part of the decision cannot be regarded as a decision granting the first application.

Therefore, since the Board of Appeal acceded to the application submitted by the applicant for a declaration of invalidity, its action before the Court cannot procure any advantage for it.

In the second place, the Court holds that the applicant for a declaration of invalidity cannot seek annulment of the decision of the Board of Appeal in so far as it upheld the application for the contested design to be maintained in an amended form. To allow such a possibility would amount to allowing the applicant for a declaration of invalidity to interfere in the part of the proceedings concerning the application of the holder of the right to the contested design. By claiming an infringement of Article 25(6) of Regulation No 6/2002, whereas its application for a declaration of invalidity had been based on Article 25(1)(e) of that regulation, the applicant for a declaration of invalidity seeks to alter the subject matter of its application for a declaration of invalidity and the grounds relied on in support of that application.

In the third place, the fact that the applicant for a declaration of invalidity would like to have the design declared invalid in its entirety cannot constitute a vested and present interest in having the decision of the Board of Appeal annulled. Consequently, the Court finds that the applicant for a declaration of invalidity has no interest in having that decision annulled.

### **3. Action before the EU judicature – Scope of judicial review**

- [\*Judgment of 18 October 2012, Neuman and Galdeano del Sel v Baena Grupo \(C-101/11 P and C-102/11 P, EU:C:2012:641\)\*](#)

Baena Grupo was the holder of a Community design representing a seated figure. Mr Neuman and Mr Galdeano del Sel filed an application with EUIPO for a declaration of invalidity of that design. EUIPO had declared the contested design invalid on the ground that it lacked individual character. Hearing an action for annulment, the General Court noted that the contested design produced on the informed user an overall impression that differed from that produced by the earlier mark and annulled EUIPO's decision.

Hearing an appeal, in which EUIPO claimed that the General Court had exceeded the limits of its power of review, the Court of Justice dismisses that appeal and the appeals brought by the other parties and rules on the scope of the judicial review carried out by the General Court.

It holds that, in the context of an action for annulment brought against a decision of EUIPO, the General Court can carry out a full review of the legality of the decisions of EUIPO's Boards of Appeal, if necessary examining whether those boards have made a legal classification of the facts of the dispute or whether their assessment of the facts submitted to them was flawed. Where it is called upon to assess the legality of a decision of the Board of Appeal of EUIPO, the General Court cannot be bound by an incorrect assessment of the facts by that board, since that assessment is part of the findings whose legality is being disputed before the General Court.

However, the General Court may afford EUIPO some latitude, in particular where EUIPO is called upon to perform highly technical assessments, and restrict itself, in terms of the scope of its review of the Board of Appeal's decisions in industrial design matters, to an examination of manifest errors of assessment.

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