

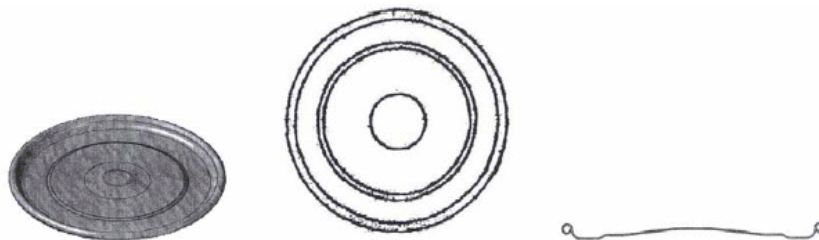


The General Court delivers its first judgment on the Community design

It annuls OHIM's decision to dismiss the application for a declaration of invalidity against PepsiCo's design for the shape of a 'rapper'

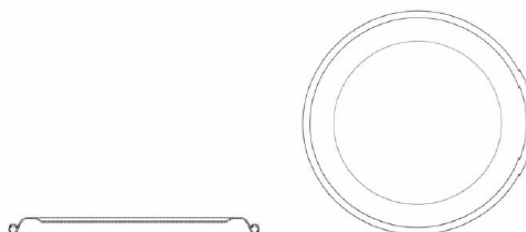
The Community design was created by a Community regulation¹. That regulation defines the Community design as 'the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.' Designs which are novel and have individual character may be protected. The proprietor of a design may prevent any third party not having his consent from using it. The scope of that protection covers any design which does not produce on the informed user a different overall impression. In assessing the scope of protection, the degree of freedom of the designer in developing his design must be taken into consideration. A Community design may be declared invalid if, among other reasons, it is in conflict with a prior design.

On 9 September 2003, PepsiCo filed an application for registration of a Community design at OHIM, the Community trade mark office which is also responsible for registering Community designs, for the shape of a 'rapper' (a small, flat or slightly curved disc on which colour images can be printed) represented as follows:



The Community design was registered for 'promotional item[s] for games'.

In February 2004, Grupo Promer Mon Graphic, a Spanish marketing and promotion company, filed an application for a declaration of invalidity against that design. In support of that application, the company relied on the existence of a prior right: a Community design, filed on 17 July 2003, for 'metal plate[s] for games', represented as follows:



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

OHIM dismissed the application for a declaration of invalidity, holding that the goods covered by the designs at issue concerned a particular category of promotional items, namely 'rappers' or 'tazos' (the Spanish name for 'rappers'), and that, therefore, the freedom of the designer of those promotional items was severely restricted. Accordingly, the Board of Appeal concluded that the difference in the profile of the designs at issue was sufficient to conclude that they produced a different overall impression on the informed user.

Grupo Promer Mon Graphic claimed that the Court should annul that decision.

The Court considers 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.

In this case, the Court finds that OHIM properly found that the product in question belonged, within the broad category of promotional items for games, to the particular category of game pieces known as 'pogs', 'rappers' or 'tazos'.

Similarly, OHIM was correct to find that the informed user could be a child in the approximate age range of 5 to 10 or a marketing manager in a company that makes goods which are promoted by giving away 'pogs', 'rappers' or 'tazos', the important point being that both those categories of person are familiar with the phenomenon of 'rappers'.

OHIM was also correct to find that the designer's freedom was severely restricted since he had to incorporate the common features of 'rappers' in his design. Moreover, the designer's freedom was also limited in so far as those items had to be inexpensive, safe for children and fit to be added to the products which they promote.

By contrast, OHIM erred in finding that the two designs produce a different overall impression on the informed user. The Court considers that some of the similarities between the two designs were not the result of a restriction of the designer's freedom. In particular, the central part did not have to be delineated by a circle; this could also have been done by a triangle, a hexagon or an oval. In addition, the designs are similar in that the rounded edge of the disc is raised in relation to the intermediate area of the disc between the edge and the raised central area, and the respective dimensions of the raised central part and the intermediate area of the disc, between the edge and the raised central part, are also similar.

Consequently, the Court annuls OHIM's decision to dismiss the application for a declaration of invalidity.

NOTE: An appeal, limited to points of law only, may be brought before the Court of Justice against the decision of the General Court within two months of notification of the decision.

NOTE: An action for annulment seeks the annulment of acts of the institutions of the European Union that are contrary to European Union law. The Member States, the European institutions and individuals may, under certain conditions, bring an action for annulment before the Court of Justice or the General Court. If the action is well founded, the act is annulled. The institution concerned must fill any legal vacuum created by the annulment of the act.

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The [full text](#) of the judgment is published on the CURIA website on the day of delivery

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