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**Novelty and Individual Character
in the Community Design Law**

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Summary

Design importance in product marketing has been dramatically increasing in the last few years. There is hardly a commodity available in the market which could escape the ever-growing design trend. Consumer design awareness is growing simultaneously and thus more and more companies choose to invest into researching possible design applications to their products. Currently where production costs are so low in the third world countries design is the key competitive tool for European industry to survive this battle.

Design protection varies greatly from one Member State to another in the Community. This on its own causes problems to free movement of goods and hinders the functioning of internal market.

Mainly for the above mentioned reasons the Community has introduced Community design protection that functions in parallel to the national systems and should hopefully in the near future outrun the national protection.

Within this thesis the author has chosen to discuss and analyze two important notions of novelty and individual character. These two notions form the protection requirements for the Community design. Each design in order to be protected under the Community design system will have to be new and have individual character. The author analyzes the legislative preparatory works and doctrine to give flesh to those two important notions. Such questions as when the design should be considered to be new and when it will be deemed to be similar to already known design are discussed. According to the individual character test the design will have individual character when it produces an overall different impression on the informed user. Who is the informed user and when one will have different overall impression is analyzed. Throughout understanding of these notions will enable one to grasp the boundaries of protection that Community design provides and thus recognize the benefits of using it.

A research to find case law on the Community designs is carried out and the results are shortly discussed.

At the end different interpretations are discussed and the author provides some proposals of how one or other issue could be handled.

Abbreviations

EC	European Community
ECJ	Court of Justice of the European Communities
EEC	European Economic Community
OHIM	The Office for Harmonization in the Internal Market (Trade Marks and Designs)
RCD	Registered Community design
TRIPS	Agreement on Trade-Related Aspects of Intellectual Property Rights
UCD	Unregistered Community design
WIPO	World Intellectual Property Organization

1 Introduction

On the March 6, 2002 we witnessed the birth of a new intellectual property right. Events of such magnitude are rare and should be given most of the attention. Especially when one talks about a right that gives protection throughout the whole European Union. Importance of design protection has become ever evident in the last few years. High-level industrial design has become a key competitive element in the battle between the third country industries, which enjoy relatively low production costs, and the European firms. Ever increasing consumer design awareness has forced the industry to make major investments into designing of their products. In order to protect those investments an adequate design protection system was needed. The Community has taken the difficult task to provide one.

1.1 Purpose

The purpose of this thesis is to examine notions of novelty and individual character in the Council Regulation on Community designs.¹ Within this thesis author has set a goal to give flesh to these notions and alert the reader of possible problems and different interpretations that are available. Author will in the end make proposals of how the novelty and individual character should be interpreted.

1.2 Method and material

In this thesis author has used the traditional legal dogmatics and described, examined and interpreted legislation, preparatory materials, legal principles and legal doctrine.

Novelty and Individual character has been studied from the European Community perspective. The Council Regulation and where appropriate the Directive was examined in detail. A detailed analysis of the preparatory works has been conducted to find more guidance for the interpretation of notions of novelty and individual character. Scholarly writings on the issue were consulted. Thereafter a research was undertaken to identify first cases dealing with the Community design. Results of the research have been presented. Finally an analysis of possible interpretations was conducted where the preferable interpretations were argued for and defended against their rivals.

When examining the Regulation and the Directive, as well as all the preparatory materials, the author has used the English versions of the text. Therefore for the purposes of this thesis discrepancies between different language versions of the texts are not examined.

¹ Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, [2002] O.J. L3.

1.3 Delimitations

In this thesis only a brief summary of Community design development will be provided. The purpose of which is to summarize the way to the current Council Regulation (EC) on the Community designs and remind the highly knowledgeable reader in the design field of the background. This thesis is not going to examine or provide in detail the reasons behind establishing a system of Community design. The main focus is to analyze novelty and individual character notions. For the purposes of this thesis author will discuss only areas that are directly related to novelty and individual character requirements. Analysis will be based on the Regulation and the preparatory works. The Directive will be analyzed only to the extent that is necessary to understand the interpretations given to the Regulation.

The relationship between the Community design and the TRIPS agreement is not discussed in this paper. Nor is the relationship between the recently developed WIPO Geneva Act that centralizes design application filling for global protection.

Decisions of the OHIM on the validity of Community designs shall not be examined for the purposes of this paper due to the time restrictions.

1.4 Definitions

It is important to note that throughout the thesis words Regulation and Directive refer to Council Regulation (EC) No 6/2002 on Community designs and to the Directive 98/71/EC of the European Parliament and of the Council respectively. Furthermore the words “prior design” the author uses for the purposes of this thesis should be held identical to a common expression of “prior art”.

2 Design

2.1 Prehistory of Community design

From the establishment of EEC, with Rome treaty, harmonization of intellectual property has been on the agenda. Member States had different laws on intellectual property rights and this was a major obstacle to the internal market. Due to the differences in intellectual property law, free movement of goods has been hindered. European Commission having sole right of initiative for legislative proposals in European Community has taken action to harmonize the field of patents, trademarks and designs. Probably the sensitivity of copyright field has led Commission to leave its harmonization for later stages.² Harmonization attempts in the field of patent and trademark law have seen some success. Currently European Community has already a working European Community Trademark system.³ In the patent field there is no European Community measure yet. However some degree of harmonization had been achieved through intergovernmental instruments such as European Patent Convention.⁴ Harmonization of Design law has been the slowest of the three. Working Party on Industrial Designs chaired by Sig. Roscioni produced a report⁵ in 1962, results of which were not encouraging. Working Party concluded that it would be almost hopeless to try to harmonize the design field in the Community because of such wide range of differences in legal systems of Member States. Nevertheless it proposed that autonomous Community design system could be set up. Patent and trademark legislation has been a priority over the design legislation in the early years of the Community and this is most likely to be the cause of the delay.

2.2 Development of the Regulation

Only in the early 1990's did the Commission succeed to present the Green Paper on the Legal Protection of Industrial Designs.⁶ The Green Paper was based⁷ on the Max Planck Institute's⁸ draft⁹ that was produced in 1990 in München. Industry warmly welcomed the initiative of the Commission.

² Green Paper on the Legal Protection of Industrial Designs – 111/F/5131/91-EN Brussels, June 1991, para. 3.8.3. p.37.

³ Council Regulation (EC) No 40/93 of December 20, 1993 on the Community trademark [1994] O.J. L11 p.1.

⁴ European Patents Convention of 5 October 1973.

⁵ Report of Sig. Roscioni on Industrial designs 2143/VI/62 of 17 December 1962.

⁶ Green Paper on the Legal Protection of Industrial Designs – 111/F/5131/91-EN Brussels, June 1991.

⁷ *ibid* para. 5.2.5. p.55.

⁸ Full name Max Planck Institute for Intellectual Property Competition and Tax Law.

⁹ ——— “Proposal of the Max Planck Institute for a European Design Law” (1991) 22 I.I.C. pp.523-537.

After a round of comments on the Green Paper,¹⁰ Commission brought out the proposals for Directive¹¹ and Regulation¹² on the Legal Protection of Designs. The Proposed Directive was there to harmonize existing national laws on the protection of designs and to prepare the ground for the proposed Regulation. A proposed Regulation would consequently establish a Community wide unitary protection system for designs that would function in parallel to the national protection. Both instruments are interrelated and reassemble the previous harmonization method used to create the European Community Trademark system.

However, this time, both instruments were presented simultaneously and had the same legal basis - the Article 100(a) [now Art. 95] of the ECT. Several Member States found it to be unacceptable and claimed that Regulation should be adopted under Article 235 [now Art. 308] of the ECT. Latter article requires a simple consultation procedure as opposed to the co-decision requirement under Article 100(a) [now Art. 95]. From decision making perspective, under the co-decision procedure, the European Parliament has strong influence over final outcome of the legislative act. European Parliament and Council must agree on the legislative act in order for it to be adopted. Whereas in a simple consultation procedure European Parliament is just a consultative body and its opinion is not binding. Consequently the Council does not share its power of adopting the legislative act with European Parliament.

This struggle for power ended up in the ECJ. An opinion 1/94 on the matter was issued by the ECJ in which it stated that "... at the level of internal legislation, the Community is competent, in the field of intellectual property, to harmonize national laws pursuant to Articles 100 and 100 a [now Art. 94 and 95] and may use Article 235 [now Art. 308] as the basis for creating new rights superimposed on national rights, as it did in Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trademark (OJ 1994 L 11, p. 1)..."¹³ Consequently the legal basis for the Regulation was changed to the Article 235 [now Art. 308] of the ECT. This was a loss for the European Parliament. Nevertheless the European Parliament retained much of its influence through actively participating in the adoption of the Directive.

Since both these instruments are very much interrelated it goes without saying that what will be agreed in the proposed Directive shall be transferred accordingly to the proposed Regulation. Much of the battle ground took place over the provisions of the proposed Directive where the European Parliament had greater influence. Only after a final version of the proposed Directive was agreed upon the proposed Regulation was looked into. To accommodate these changes the Commission brought two

¹⁰ Green Paper on the Legal Protection of Industrial Designs – 111/F/5131/91-EN Brussels, June 1991.

¹¹ Proposal for a European Parliament and Council Directive on the Legal Protection of Designs: COM(93) 344 final, December 3, 1993, [1993] O.J. C345/14.

¹² Proposal for a European Parliament and Council Regulation on the Legal Protection of Designs: COM(93) 342 final, December 3, 1993, [1994] O.J. C29/20.

¹³ Opinion 1/94 [1994] ECR I-5267.

successive revised proposals for Regulation in 1999¹⁴ and 2000¹⁵. Which then, were followed by the two Council drafts of April¹⁶ and November¹⁷ of the year 2001. Thereafter a Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (Hereinafter the “Regulation”) was adopted.¹⁸

2.3 Design Approach

“It is a common view that legal protection of industrial designs has to follow either a patent or a copyright approach.”¹⁹ Looking into different existing systems in the Community we find that this statement bears a lot of truth. Saez explains this phenomenon referring to two basic values in design that merit protection: “the value inherent in the creativity of the designer and the objective or ‘market’ value of the design.”²⁰ Former value falls under the protection of copyright and latter “[...] within a system of registration close to patents.”²¹ Jehoram on the other hand states that “Designs, of course, are quintessentially a subject for copyright protection [...]”²² Thus designing is an activity of human imagination and has nothing to do with technical inventions. That being said, Commission has chosen to reject above mentioned alternatives and have taken, as Kur²³ says, a “Design Approach”.²⁴

Designs are marketing tools for industry. Designs help the industry to sell its products. As Fryer points out “design performs an essential role in product development and marketing.”²⁵ The purpose of the mobile phone design is to sell the mobile phone whereas painting’s purpose is clearly not the sale of canvas. Designs create communication channels with the consumers. Consequently design is meant not to protect the individual expression of the author, as is the case with copyrights, but rather to protect the communication channel. On the other hand novelty requirement - streaming

¹⁴ Amendment proposal for the Council Regulation (EC) on Community Design: COM(1999) 310 final, [2000] O.J. C248 E/13-55.

¹⁵ Amendment proposal for the Council Regulation (EC) on Community Design: COM(2000) 660 final/2, [2001] O.J. C120 E.

¹⁶ Amendment proposal for the Council Regulation (EC) on Community Design: Council document 7400/01, April 18, 2001.

¹⁷ Amendment proposal for the Council Regulation (EC) on Community Design: Council document 13483/01, November 30, 2001.

¹⁸ Council Regulation (EC) on Community Design, [2002] O.J. L3.

¹⁹ A. Kur “The Green Paper’s “Design Approach” – What’s wrong with it” E.I.P.R. 1993, 15(10), p.374.

²⁰ V.M. Saez “The Unregistered Community Design” E.I.P.R. 2002, 24(12) p. 585.

²¹ *ibid* p.585.

²² H.C. Jehoram “The EC Green Paper on the Legal Protection of Industrial Design: Half Way Down the Right Track – A View from the Benelux” E.I.P.R. 1992, 14(3), p.76.

²³ Authors note: A member of the Max Plank Working Group consisting of Professor F. K. Beier, Dr. K. Haertel, Professor M. Levin and herself.

²⁴ A. Kur “The Green Paper’s “Design Approach” – What’s wrong with it” E.I.P.R. 1993, 15(10), p.376.

²⁵ W.T.Fryer “Optimizing Economic Benefits by Encouraging Use of Design Registrations and Patent Protection” Journal of the Patent and Trademark Office Society, October 2003, p.784.

from the patent law - has severe effects on design protection. Most designs will be tested on the market in order to assess the value they have and thus whether a registration for such design is plausible. This practice, however, will deprive the design of its novel character. There are industries that in short time develop substantial amount of designs (fashion, textile, shoes ect.), however only few of those designs in the end become a success. Costs of registering unsuccessful designs can be considerable for those industries. Therefore there is "no substantial reason for resorting to such a sever test: the Community design will protect only features of the shape and the situation is not comparable to the one prevailing in the patent field where there is an overriding interest of maintaining in the public domain already disclosed inventions."²⁶ Consequently the requirement of novelty used in the patent field is not a solution either. That being said only new designs should be registered for the purposes of preventing monopolization of designs which are known or widely used in the market. Furthermore requirement that designs must be new serves the purpose of preventing the re-registration of designs for which the protection period is about to expire. For above mentioned reasons an alternative "Design Approach" has been chosen.

The Max Planck Institute conducted a very comprehensive survey in 1972 in the Federal Republic of Germany to identify existing shortcomings of the design protection. About 500 responses were received from companies in the design field. Two trends have been identified. One group of industries requested for an immediate, inexpensive protection of a narrow nature which could be limited to few years of protection only. Whereas other group preferred a broader and long term protection accepting the higher costs and the risk of higher standards for the design. Possibility to choose between two of those protection systems was welcomed by majority of the surveyed companies.²⁷

The Regulation establishes a unitary Community design protection system. It will function in parallel to the existing national systems of the Member States. Regulation creates a two tier protection system composed of an Unregistered Community design (hereinafter the "UCD") and Registered Community design (hereinafter the "RCD").

UCD is protected from the moment when it is made available to the public. There are no formal requirements, no registration needed. The term of protection is 3 years. UCD gives the design owner only the right to prevent third parties from copying his or her design. This type of protection was favored by several industries where the lifespan of the products is relatively short and quantities of designed products are big. These industries prefer the economical advantages of no formalities and no fees over the long period of protection.

²⁶ Green Paper on the Legal Protection of Industrial Designs – 111/F/5131/91-EN Brussels, June 1991, para. 5.5.3. p.69.

²⁷ W.T. Fryer "Design users suggest national law changes, EC approach and strategy: Federal Republic of Germany surveys on design protection" E.I.P.R. 1990, 12(10), p.365.

RCD is protected from the date of filling the registration. There is an easy online registration system parallel to the regular paper version. The term of protection is 5 years which is renewable in blocks of 5 years for total term up to 25 years. RCD gives the holder exclusive rights over the use of the design, in particular, the making, offering, putting on the market, importing, exporting, using or stockpiling. RCD grants a monopoly right that can be used to prevent similar independently created designs from being used. This type of protection has been favored by larger companies.²⁸

2.4 Defining design

There is no universal definition of the notion of design. However a common pattern could be found amongst the modern definition of the design. It “tends to be less reliant on the notion of “decoration” or “ornamentation” applied to the product and instead to have the most intimate merger of functionalism and aesthetic value as its purpose”²⁹ Consequently the Commission agrees with common understanding in the industry “that design is a result of three elements:

- A functional improvement or technical innovation in the product;
- A creative contribution of aesthetic nature by the designer; and
- An investment by the manufacturer to develop the two preceding elements.”³⁰

That being said the Commission expressed that strict interpretation of this definition would limit the number of designs that could be protected. This is not the intention of the Commission and therefore this definition should be interpreted broadly allowing designs to be protected when they lack “one or other of those elements”³¹

Regulation provides a quite detailed definition of what a design is?

“...‘design’ means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colors, shape, texture and/or materials of the product itself and/or its ornamentation”³² Adding to that a quite broad definition of term product³³, design protection can be sought for quite wide range of items. “The idea was

²⁸ *ibid* p.365.

²⁹ Green Paper on the Legal Protection of Industrial Designs – 111/F/5131/91-EN Brussels, June 1991, para. 5.4.1. p.56.

³⁰ *ibid* para. 5.4.4.1. p.59.

³¹ *ibid*

³² Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, [2002] O.J. L3, Art. 3(a).

³³ “product means any industrial or handicraft item, including *inter alia* parts intended to be assembled into complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs.” Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, [2002] O.J. L3, Art. 3(b).

to cast the net as widely as possible and to concentrate the discussion on the protection requirements where they belong.”³⁴

To give just a few examples: Community design is “useful for protecting graphics of all kinds” such as a company logo, “style elements that create company’s image or get-up, which may not be registered as trademarks”. For computer graphics, registrations could be sought for animations, icons, layout of a web page. For mobile phones the downloadable symbols used on the displays.³⁵ Even environmental designs will be protected “whether interior (shop, restaurant, pub, club, TV set ...) or exterior (amusement park, garden ...).”³⁶ It is really more of the question “what do you want to protect?” rather than “what is protectable?”³⁷

2.5 Requirements for protection

Article 4 of the Regulation provides the requirements for protection. Paragraph one of this article shortly states that “design shall be protected by a Community design to the extent that it is new and has individual character”.³⁸ Recital 19 of the Regulation is almost identical in its wording: “A Community design should not be upheld unless the design is new and unless it also possesses an individual character in comparison with other designs”.³⁹ This creates twofold criteria that every design shall fulfill in order to benefit from protection under the Regulation. Every design has to be new and has to have individual character. It is a cumulative test thus if one of the criteria is not complied with design will not be protected.

A Grace period of 12 months is introduced to combat the above mentioned problems with regard to patent type novelty.⁴⁰ Consequently designers and companies can test their designs on the market within 12 months period and still comply with requirements of novelty.

Additional requirements are set for designs that are “applied to or incorporated in a product which constitutes a component part of a complex product...” Such designs shall be protected only if they “remain visible during normal use”⁴¹ and themselves fulfill the requirements of being new

³⁴ H.M.H. Speyart “The grand design: An update on the E.C. design proposals, following the adoption of a common position on the directive” E.I.P.R. 1997, 19(10), p.605.

³⁵ N. Cunningham “Community design registration: now freely available!” Wragge&Co, News & Views, http://www.wragge.com/files/IPNL_Feb04.pdf (April 23, 2005).

³⁶ C. H. Massa and A. Strowel “Community design: Cinderella revamped” E.I.P.R. 2003, 25(2), p.72.

³⁷ N. Cunningham “Community design registration: now freely available!” Wragge&Co, News & Views, http://www.wragge.com/files/IPNL_Feb04.pdf (April 23, 2005).

³⁸ Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, [2002] O.J. L3, Art. 4.1.

³⁹ Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, [2002] O.J. L3, Recital (19).

⁴⁰ See the Chapter “2.3 Design approach”.

⁴¹ Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, [2002] O.J. L3, Art. 4.2(a).

and having individual character.⁴² The Regulation provides definitions as to what is “complex product”⁴³ and “normal use”.⁴⁴

As already mentioned above novelty and individual character are the fundamental elements of the Regulation. These notions define whether designs fulfill the requirements needed to acquire Community design protection. Since notions of design and product are so broad they are likely not to form obstacles to design registration. Consequently the notions of novelty and individual character will be the crucial ones to limit the designs that are worthwhile protection. Due to their importance, these two notions will be the center of analysis in this paper. Understanding what those notions mean is crucial for legal certainty for the users of the Regulation and consequently the successfulness of the Regulation itself.

⁴² Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, [2002] O.J. L3, Art. 4.2(b).

⁴³ “complex product means a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product” Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, [2002] O.J. L3, Art. 3(c).

⁴⁴ “normal use [...] shall mean use by the end user, excluding maintenance, servicing or repair work” Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, [2002] O.J. L3, Art. 4.3.

3 Novelty

3.1 EC perspective on novelty

Article 5 of the Regulation defines the concept of novelty. Paragraph 1 states that “design shall be considered to be new, if no identical design has been made available to the public”:

- In case of UCD before the date when design has first been made available to the public.
- In case of RCD before the date of filling the application or alternatively the date of claimed priority.

Paragraph 2 states that “Designs shall be deemed to be identical if their features differ only in immaterial details”.

A Requirement that a design has to be new is common to most of the systems. As already mentioned above novelty requirement prevents one from monopolizing existing designs which are known and/or widely used. Furthermore the novelty requirement prevents one from re-registering a design when the term of protection is about to laps. On the other hand a grace period of 12 months will enable to test designs on the market before making a decision whether to register a design or not.

Novelty requirement has been “...interpreted and applied in very different ways in the various countries.”⁴⁵ However it could be separated into two groups known as “Subjective novelty” and “Objective novelty”. “Subjective novelty” requires proof that design has not been copied from other designers work.⁴⁶ Whereas, “Objective novelty” requires proof that design is not known (made available to the public) anywhere in the world.

3.1.1 Subjective novelty

“Subjective novelty” grants a right to the design owner to prevent third parties from copying the design he or she has developed. If however a fairly similar design has been achieved independently and there is reason to believe that designer could have not known about the former design, both designs will be granted protection and will coexist.

Survey conducted by Max Planck Institute indicated that overall preference was given to the “Objective novelty”. That being said there were industries such as cutlery, watches-jewelry and textile which strongly favored “Subjective novelty” test. It is interesting to note that smaller companies where more in favor of “Subjective novelty” whereas the big companies seemed to prefer the “Objective” one. This might be influenced by the

⁴⁵ Green Paper on the Legal Protection of Industrial Designs – 111/F/5131/91-EN Brussels, June 1991, para. 5.5.1.1. p.67.

⁴⁶ W.T. Fryer “Design users suggest national law changes, EC approach and strategy: Federal Republic of Germany surveys on design protection” E.I.P.R. 1990, 12(10), p. 362.

common “[...] concern among designers that only the large firms can use the “Objective novelty” standard effectively, researching the novelty status of a design. This fact leaves the smaller firms in doubt on the validity of their design registration protection under an “Objective novelty” standard.”⁴⁷

Furthermore some industries are very mature where design differences are slight or where designs are very much limited by the standardization, technical or physical restraints. In such areas there is a high risk of creating two designs independently that are essentially the same. In such industries “Subjective novelty” would not preclude both designers to market their products and enjoy design protection, because “Subjective novelty” requires only showing that design has not been copied. Whereas under the “Objective novelty” test, exclusive rights to the design would be granted for one designer only. It thus would preclude even independently created designs from being used. That being said it is worthwhile to note that 62% of the surveyed companies preferred to have a design protection system with two options to choose from.

- Patent-type protection with “Objective novelty”; and
- Imitation-type protection with “Subjective novelty”.⁴⁸

3.1.2 Objective novelty

“Objective novelty” is difficult to apply in practice because it is so resource exhaustive. According to the theory, in order to determine whether a design is new, one has to compare it with all designs available in the world throughout the history. Commission stated in the Green Paper that “...- at the present stage of technology -, no way exists in which a national authority [nor European Community]⁴⁹ can establish whether a design is ‘new’ in the sense of ‘universal, objective novelty’”.⁵⁰ The Economic and Social Committee in its Opinion expressed similar concerns where it held that assessing novelty at a worldwide level is a very difficult task to achieve in many of the fields. It singled out the textiles industry where “sellers of counterfeit products often obtain false certifications stating that the disputed design had already been created in a third country.”⁵¹ For above mentioned reasons a “Objective novelty” test in practice is usually somehow limited. Most common limitations are either time related or of geographical nature. To give an example, a country would choose to compare new design with all designs that have been known to public in last 20 years and/or to compare to the designs that are originating from one country.

⁴⁷ W.T. Fryer “Design users suggest national law changes, EC approach and strategy: Federal Republic of Germany surveys on design protection” E.I.P.R. 1990, 12(10), p.365.

⁴⁸ *ibid* p.365.

⁴⁹ Authors note.

⁵⁰ Green Paper on the Legal Protection of Industrial Designs – 111/F/5131/91-EN Brussels, June 1991, para. 5.5.1.1. p.67.

⁵¹ Economic and Social Committee Opinion adopted at 317th Plenary Session (meeting of 6th July 1994) [1994] O.J. C388/9.

The Commission rejected time and geographical area limitations finding them to be an “artificial solution”⁵² to the problem. It proposed a new solution according to which the novelty will be tested against the knowledge of “specialists operating within the Community in the sector of the marketable goods to which the design is intended to be applied.”⁵³ This was further developed to its current wording: “known in the normal course of business to the circles specialized in the sector concerned, operating within the Community.”⁵⁴ As Horton states “this is not strictly speaking a geographical limitation...”⁵⁵ Why is it so? The “experts”, whose opinion will be requested, as the Commission points out in the Green Paper, are specialists, designers, merchants, and manufacturers operating in the sector concerned.⁵⁶ Even though the “experts” have to operate in the Community their knowledge is not restricted territorially. Current advancements in the multimedia sector will certainly keep the trend of expanding their knowledge of foreign markets and thus the body of prior design.

Both adopted Directive and Regulation incorporate “Objective novelty”. Despite the fact that above mentioned survey conducted by Max Planck Institute indicates majority of the industry favoring an option to choose from RCD with “Objective novelty” and UCD with “Subjective novelty”.

3.2 Prior designs

Determining the scope of prior designs against which the new design shall be compared to is essential. Commission states in the Green Paper that “Designers do not limit their activity to designing products in the strict sense of the term” and thus designs protection should be separated from the product.⁵⁷ This has great influence over the spectrum of the prior designs which have been made available to the public, when one will have to compare them against the new design. Possibility to protect the “features”⁵⁸ of the appearance which can later be applied to variety of different products as opposed to protecting a design of one product, entitles the design right owner a wider scope of protection. The only requirement is that upon filling for RCD an application will have to “contain an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied.”⁵⁹ This indication shall be made according to the EUROLOCANO classification, with exception of designs that concern

⁵² Green Paper on the Legal Protection of Industrial Designs – 111/F/5131/91-EN Brussels, June 1991, para. 5.5.5.1. p.70.

⁵³ *ibid*

⁵⁴ Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, [2002] O.J. L3, Article 7.

⁵⁵ A.A. Horton “Industrial design law: The future for Europe” E.I.P.R. 1991, 13(12), p.444.

⁵⁶ Green Paper on the Legal Protection of Industrial Designs – 111/F/5131/91-EN Brussels, June 1991, para. 5.5.5.1. p.70.

⁵⁷ *ibid* para. 5.4.14. p.66.

⁵⁸ Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, [2002] O.J. L3, Art. 3(a).

⁵⁹ Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, [2002] O.J. L3, Art. 36.2.

ornamentation.⁶⁰ That being said, indications shall not in any way limit the scope of the products to which the design can be applied or incorporated into.⁶¹ Consequently registering a design which is indicated to be used for a product packaging shall also grant design owner a right to prohibit third parties from applying or incorporating the same design for a bus stop or a billboard.

Taking into account a broad definition of a term product one has to be alerted of the possible unintentional novelty destroying consequences this wide scope of protection might entail. A sketch of a concept car published in a well known automotive magazine circulated in the Community may destroy the novelty for a future car design.⁶² This might not be the best example because often the design of a car in the sketch will differ substantially from the final product. Most often this is due to technical requirements a car must meet. However this clearly illustrates that in the light of the Regulation both the magazine and the car are products that include the same design. Therefore disclosing a design in one product (magazine) can prevent it from being registered for other product (car). Consequently one should be alerted of the wide body of prior art that will be taken into consideration when comparing designs in order to establish the novelty. Furthermore a wide body of prior art does not preclude situations where, as Musker points out, "...a design of, for example, a crank-shaft could be anticipated by that of an electrical fuse."⁶³ How far one can stretch the body of prior art would be discussed in detail in the Discussion chapter.

3.3 Comparing designs

After establishing that "Objective novelty" test, limited to the knowledge of "experts" operating within the Community, has been the choice for the Regulation one has to analyze how this test is applied.

For the purposes of "Objective novelty" test "it is immaterial to establish whether the design is the result of an independent creation by the designer or has been copied."⁶⁴ Designs shall be considered new if there are no prior identical designs. Article 5 paragraph 2 defines that "designs shall be deemed to be identical if their features differ only in immaterial details"⁶⁵ Consequently in practice the features of the design shall be compared by the "experts". It is elaborated in the Green Paper that "experts" will have to "not

⁶⁰ M. Schlotelburg "The Community Design: First Experience with Registrations" E.I.P.R. 2003, 25(9), p.384.

⁶¹ Green Paper on the Legal Protection of Industrial Designs – 111/F/5131/91-EN Brussels, June 1991, para. 8.6.6. p.110.

⁶² Authors note: Provided that the registration for a car design is sought outside the "grace period", 12 months.

⁶³ D. Musker *Community Design Law: Principles and Practice* (Sweet & Maxwell, London 2002) p.25.

⁶⁴ Proposal for a European Parliament and Council Regulation on the Community Design (Explanatory Memorandum) COM (93) 342 final, December 3, 1993, [1994] O.J. C29/20 p.12.

⁶⁵ Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, [2002] O.J. L3, Art. 5.2.

only point out the ‘identical’ known designs [...] but also ‘substantially similar’ designs. [...] in judging whether the degree of similarity is sufficiently thin to permit the second design to be considered as ‘new’, the specialists would be in the position to spot differences which, given the constraints of the specific case, might represent a sufficiently creative development, even though they would pass unnoticed by an ordinary observer”⁶⁶ Thus “experts” will look for differences in details of two designs which are, overall, very similar.⁶⁷ Both stipulations are in line with the Explanatory Memorandum according to which “... only identical or near to identical anticipations, [...] destroy the novelty, whereas ‘overall impression of similarity’ is not enough to have this effect. Non-identical anticipations, however, may be needed to be considered for the purpose of assessing the individual character of the design.”⁶⁸ Consequently designs shall pass novelty test either by being:

- Not known to the “experts” operating in the Community; or
- They present “...sufficient differences from known designs to constitute a creative independent development.”⁶⁹

As the Green Paper points out “...judge will normally have to require expert guidance...” in order to assess novelty when the design validity is contested. Under what conditions will the court be able to abstain from asking “experts” for an opinion is not specified.

When comparing designs, real products, where design is incorporated or applied to, or their representations, shall be used. The Regulation states that upon filling a RCD one has to *inter alia* provide “a representation of the design suitable for reproduction. [Or under certain circumstances]⁷⁰ [...] representation of the design may be replaced by the specimen.”⁷¹ What methods of representation are allowed and what impact on the scope of protection they have is important to analyze.

A design can have a short description up to 100 words to explain the elements visible in the representation.⁷² “A design can be presented in up to seven views.”⁷³ A design can be exposed either in color or black and white, in photograph or in drawing. Three-dimensional designs do not have to be shown from all sides. What method of representation is chosen will

⁶⁶ Green Paper on the Legal Protection of Industrial Designs – 111/F/5131/91-EN Brussels, June 1991, para. 5.5.5.3. p.71.

⁶⁷ D. Musker *Community Design Law: Principles and Practice* (Sweet & Maxwell, London 2002) p.26.

⁶⁸ Proposal for a European Parliament and Council Regulation on the Community Design (Explanatory Memorandum) COM (93) 342 final, December 3, 1993, [1994] O.J. C29/20 p.12.

⁶⁹ Green Paper on the Legal Protection of Industrial Designs – 111/F/5131/91-EN Brussels, June 1991, para. 5.5.5.4. p.71.

⁷⁰ Authors note.

⁷¹ Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, [2002] O.J. L3, Art. 36.1(c).

⁷² *ibid* Art. 36.3(a).

⁷³ M. Schlotelburg “The Community Design: First Experience with Registrations” E.I.P.R. 2003, 25(9), p.385.

determine the scope of protection. As Schlotelburg points out, “applicants should be aware that the selection of the means for representing a design is equivalent to the drafting of the claims in a patent: including features means claiming them.”⁷⁴ Therefore design representation in color drawing shall mean that colors are claimed. Whereas if it is represented in black and white or in photograph it will mean that all colors are claimed. Photographs may claim surface structure and material of the design, whereas drawings omit these details. Most broad protection will likely to be granted to the designs that are represented from one side only in black and white where only the contours of the design are displayed. Consequently one has to choose carefully the way in which the design is represented. When representations are compared, designs exposed in such a vague and detail omitting manner will have much broader scope of protection. Since details of the design features are compared, it will be very difficult to establish that there is “sufficiently creative development”⁷⁵, because above mentioned representation will cover all possible details. To give an example a design of bottle represented in colored drawing will *inter alia* protect the nontransparent shade of silver applied to it. Whereas if it would have been represented in black and white drawing showing contours of the shape only it would protect not only the nontransparent shade of silver, but any other color, whether transparent or not, or even a bottle coated in the thin layer of rubber making it less slippery when it is wet from condensation. A black and white drawing showing contours of the shape is claiming all the colors, all the material that the bottle is made from, all the surface structure possible and the particular shape of the bottle. That being said such a vague representation in crowded field of designs may bring the new design too close to the previously available designs. Therefore despite having broad scope of protection one would be vulnerable to the Community design validity claims.

3.4 Conclusion

A novelty test is the first requirement for design protection under the Regulation. This test is tailored to exclude designs that are not new. Due to the fact that only immaterial differences from the previous design shall preclude the new design registration this initial test shall only remedy from slavish copying of the designs and prevent counterfeit products from entering the market. As already mentioned above careful selection of the manner in which the design is represented will enable designers to broaden the scope of protection and catch more designs that fail to fulfill the novelty requirement. That being said it is still a relatively narrow test. Consequently, as Levin states, there are many practitioners who find “design protection of many countries worthless in practice” just because of the fact that small deviations made to the “successful design will not constitute an infringement” and thus design being regarded as new.⁷⁶ Interpretations that

⁷⁴ *ibid*

⁷⁵ Green Paper on the Legal Protection of Industrial Designs – 111/F/5131/91-EN Brussels, June 1991, para. 5.5.5.3. p.71.

⁷⁶ M. Franzosi (ed) *European Design Protection Commentary to Directive and Regulation Proposals* (Kluwer Law International Hague 1996) p.67.

shall be given by the courts, to the notion of immaterial details, will define the precise scope of narrowness. However a novelty test alone would be deemed to face the difficulties pointed out above by Levin. Therefore in order to create a successful European design protection where creative and innovative designs are given sufficient protection an additional requirement is introduced under the name of individual character.

4 Individual character

4.1 EC perspective on individual character

Novelty and individual character tests have been constructed under two different articles in the Max Planck Institute draft.⁷⁷ The Commission in the Green Paper diverted from initial Max Planck Institute's proposal and included both notions in Article 4 named distinctive character.⁷⁸ However further developments have led to splitting the notions into two separate articles again.

Article 6 of the Regulation states that: "A design shall be considered to have individual character of the overall impression in produces on the informed user differs from overall impression produced on such a user by any design which has been made available to the public":

- In case of UCD before the date when design has first been made available to the public.
- In case of RCD before the date of filling the application or alternatively the date of claimed priority.

Moreover paragraph 2 of this article says that: "in assessing individual character the degree of freedom of the designer in developing the design shall be taken into consideration."

The Green paper talks about the "distinctive character" whereas in the Regulation one finds the notion "individual character". According to Levin "the deviation from 'distinctive' to 'individual' represents no mental change; it has it real grounds in a translation problem."⁷⁹ Other reason could

⁷⁷ — "Proposal of the Max Planck Institute for a European Design Law" (1991) 22 I.I.C. Art. 6 (Novelty) and Art. 7 (Individual Character) p.524.

⁷⁸ Article 4 (Distinctive character)

(1) A design shall be protected as Community Design to the extent that it has distinctive character.

(2) A design shall have a distinctive character if, at the relevant date,

- it is not known to the circles specialized in the sector concerned operating within the Community and,

- through the overall impression it displays in the eyes of the relevant public, it distinguishes itself from any other design known to such circles.

(3) The relevant date within the meaning of par. (2) shall be

(a) in the case of an Unregistered Community Design, the date on which it was first disclosed to the public,

(b) in the case of an Registered Community Design, the date on which the application for registration was filled, or the earlier priority date, if a priority has been claimed.

⁷⁹ More detailed explanation at M.Franzosi (ed) *European Design Protection Commentary to Directive and Regulation Proposals* (Kluwer Law International Hague 1996) p.68.

be the fact that notion “distinctive character” has been in use by CTM system.⁸⁰

The individual character test is there to emphasize that being just novel is not enough for Community design protection. It is very important how the design is perceived in the market. Designs worthy protection should be recognized for their differences and individuality against any previously known design. As Commission points out in the Green Paper “[...] what matters is the reaction of the ‘relevant public’ [...] this element of the test brings into the picture the opinion of the ordinary consumer of the products in question.”⁸¹ Consequently the design will be evaluated by those who are consuming the designed products, by those who are paying for it.

Initially the Commission has put the threshold of the individual character very high as a result of which designs would be given a broad scope of protection. According to the initial proposal only designs that produced on the informed user overall impression that differed significantly from overall impression produced to them by prior designs where worthwhile protection. Under pressure from textile industry and after a proposition from Economic and Social Committee⁸², European Parliament proposed to delete the word significantly and thus lower the threshold for individual character.⁸³ As a result of this change, the scope of protection is reduced as well. The logic is, the higher the threshold for individual character the broader protection for the design. European Parliament favored having more designs that could be protected which consequently reduces the scope of the protection for these designs. That being said Recital (13) in the Regulation requires that overall impression produced on the informed user must clearly differ from one produced by prior designs. Musker points out that European Parliament was also willing to delete the word “clearly” together with “significantly”, however as a result of political compromise it conceded to the Council in the final agreement.⁸⁴ Speyart finds that this will not affect the practical application of the test.”⁸⁵

Under the current wording of Article 6 of the Regulation designs have to produce just different overall impression in order to be found to have individual character. As Franzosi states “the solution offered by the Community is to assess a certain degree of distance between prior art [prior design]⁸⁶ and the design work. It requires qualified difference, an

⁸⁰ Author’s stipulation.

⁸¹ Green Paper on the Legal Protection of Industrial Designs – 111/F/5131/91-EN Brussels, June 1991, para. 5.5.6.2. p.72.

⁸² “3.2.3. The term ‘significantly’ has the effect of excluding numerous designs, particularly in textiles, from the proposed protection. It should therefore be deleted. Economic and Social Committee Opinion adopted at 317th Plenary Session (meeting of 6th July 1994) [1994] O.J. C388/9.

⁸³ Proposal for a European Parliament and Council Directive on the legal protection of designs (COM(93)0334 – C3-0513/93 – 00/0464(COD)) [1995] O.J. C287/158.

⁸⁴ D. Musker *Community Design Law: Principles and Practice* (Sweet & Maxwell, London 2002) pp.30-31.

⁸⁵ H.M.H. Speyart “The grand design: An update on the E.C. design proposals, following the adoption of a common position on the directive” E.I.P.R. 1997, 19(10), p.607.

⁸⁶ Authors note. Prior art is identical to Prior design for the purposes of this paper.

appreciable difference.”⁸⁷ The product to which the design is applied or incorporated to must look different to the degree that it gives different overall impression. Therefore designs that have some differences but give similar overall impression shall not be protected. There is no aesthetic evaluation involved which one could find in various national systems.⁸⁸ Consequently whether design is different to the better or worst is immaterial for defining individual character. What matters is the overall impression

4.2 Prior designs

Initially the body of prior designs for the purposes of individual character test had to be much narrower than that of novelty. As stated in the Explanatory Memorandum “Designs applied to products, which can no longer be found on the market – whether inside or outside of Community – shall not be taken into consideration” when determining the body of prior designs.⁸⁹ Real presence on the market was necessary where product was used actually and effectively.⁹⁰ An absolute restriction to marketed products would be incompatible with Paris Convention for the Protection of Industrial Property. Therefore RCD and national registered designs, during their validity period, were included into body of prior design irrespective of the fact whether they have been applied or incorporated to a product that has been marketed or not.⁹¹ As already discussed above, the threshold for individual character was reduced by deleting the word “significantly”. As a result of that the Commission felt compelled to drop the restriction imposed on the body of prior design as it held that such limitation would be counter productive.⁹² Thus limitation on the body of prior design has been abandoned. Whether any other limitations exist that would make the scope of prior design different for the individual character test compared to the novelty test is a matter for further investigation.

According to the Regulation new design shall be compared to any prior design that has been made available to the public. The moment from which designs shall be deemed to be made available for the public is the same as in novelty requirement.⁹³ Consequently the moment from which the prior

⁸⁷ M.Franzosi (ed) *European Design Protection Commentary to Directive and Regulation Proposals* (Kluwer Law International Hague 1996) p.59.

⁸⁸ Green Paper on the Legal Protection of Industrial Designs – 111/F/5131/91-EN Brussels, June 1991, para. 5.4.5. p.60.

⁸⁹ Proposal for a European Parliament and Council Regulation on the Community Design (Explanatory Memorandum) COM (93) 342 final, December 3, 1993, [1994] O.J. C29/20 p.13.

⁹⁰ M.Franzosi (ed) *European Design Protection Commentary to Directive and Regulation Proposals* (Kluwer Law International Hague 1996) p.61.

⁹¹ Proposal for a European Parliament and Council Regulation on the Community Design (Explanatory Memorandum) COM (93) 342 final, December 3, 1993, [1994] O.J. C29/20 p.13.

⁹² M.Franzosi (ed) *European Design Protection Commentary to Directive and Regulation Proposals* (Kluwer Law International Hague 1996) p.57.

⁹³ Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, [2002] O.J. L3, Article 7.

designs shall be considered for comparing is the same as in the novelty requirement.

A Requirement to compare design to any other design previously known is likely to indicate that one will not be limited to the designs of same type of product or even to certain industrial sector. Recital (14) of the Regulation uses the words “the existing design corpus” will be compared to the new design in order to assess the individual character of it. As already stated above⁹⁴ this could lead to situations where “...a design of, for example, a crank-shaft could be anticipated by that of an electrical fuse.”⁹⁵ Levin disagrees with this interpretation stating that “for fair appreciation of the design, clothes can not be judged by the same standards as tools and tools by not same standards as furniture, ect.”⁹⁶ The scope of prior design will depend on which approach is to be followed. This issue will be addressed at a later stage in the Discussions chapter.

4.3 Informed user

Individual character test, unlike the novelty one, expressly states who shall be the one to compare designs. This person is called an “informed user”. When comparing designs “informed user” will have to give its opinion whether new design is capable of producing overall impression that is different from any prior design’s overall impression. As the Commission points out in the Green Paper “... what matters is the reaction of the ‘relevant public’ [informed user]⁹⁷, i.e. of those persons who are supposed to be the purchasers of the products in which the design is or is going to be incorporated. They must not be misled by the similarity of the design with other existing designs and assume that products in hand are the same even if they show some minor differences or variations.”⁹⁸ Where “experts” will normally be able to spot even minor differences in details the end consumers may fail to do so.

Initially in the Green Paper the Commission proposed that “relevant public” will evaluate whether designs fulfill the individual character requirements. “Relevant public” was to be understood as purchasers of products or consumers.⁹⁹ That being said, the Commission has introduced some further developments in the initial proposal for the Regulation and Directive. “The person on whom an overall impression of dissimilarity must be made is an ‘informed user.’ This may be, but is not necessarily, the end consumer

⁹⁴ See Chapter “3.2 Prior designs”.

⁹⁵ D. Musker *Community Design Law: Principles and Practice* (Sweet & Maxwell, London 2002) p. 25.

⁹⁶ M. Franzosi (ed) *European Design Protection Commentary to Directive and Regulation Proposals* (Kluwer Law International Hague 1996) p.71.

⁹⁷ Authors note. “Relevant public” was changed to “informed user” for more see note 100.

⁹⁸ Green Paper on the Legal Protection of Industrial Designs – 111/F/5131/91-EN Brussels, June 1991, para. 5.5.6.2. p.72.

⁹⁹ *ibid*

[...].”¹⁰⁰ The terminology changes from “relevant public” to “informed user” where, according to the latter notion, not only the end consumers will be able to assess the differences of the designs in question. The Commission gives an example where “informed user” could be a mechanic replacing an internal part of the machine.

The Main criterion to understand the notion of “informed user” is that he or she is not an “expert” within the meaning of the novelty test. However “a certain level of knowledge or design awareness [from the “informed user”]¹⁰¹ is presupposed depending on the character of the design.”¹⁰²

“Informed user” is hardly a real person it is more of the fictional person that is a result of innovative law making. “Informed user” is a flexible person who besides being ordinary consumer should be acquainted to a certain degree with the prior designs and be able to understand how much freedom the designer has to develop the new design. However at the same time “informed user” can not have the knowledge of “skilled designer” and thus might, upon assessment of the design, not notice minor alterations made to the design that may be easily spotted by an “expert”.

The Commission has recognized “[...] that in certain intensively exploited sectors, where technical or marketing constraints leave very little freedom to designers, development can only take the form of minor alterations to pre-existing designs and it might be difficult for the ordinary purchaser to spot such differences.”¹⁰³ Consequently such designs could be precluded from being registered as not fluffing the requirements of individual character. It is therefore the Commission feels that industry must inform its consumers of the minor alterations to their designs and the benefits of those changes.¹⁰⁴ This indicates that “informed user” will have to be aware of the information that companies have made available to the public about their products and their design features. Companies and designers, on the other hand, should stress the importance of their developed design features through marketing campaigns and thus increase consumer knowledge in the field.

As already mentioned above “in assessing individual character the degree of freedom of the designer in developing the design shall be taken into consideration.”¹⁰⁵ Only rarely will the consumer have a true idea of the real freedom that is available to the designer.¹⁰⁶ Consequently “informed user” will have to become almost an “expert” in order to analyze the freedom that

¹⁰⁰ Proposal for a European Parliament and Council Regulation on the Community Design (Explanatory Memorandum) COM (93) 342 final, December 3, 1993, [1994] O.J. C29/20 p.12.

¹⁰¹ Authors explanatory note.

¹⁰² Proposal for a European Parliament and Council Regulation on the Community Design (Explanatory Memorandum) COM (93) 342 final, December 3, 1993, [1994] O.J. C29/20 p.12.

¹⁰³ Green Paper on the Legal Protection of Industrial Designs – 111/F/5131/91-EN Brussels, June 1991, para. 5.5.6.3. p.72.

¹⁰⁴ *ibid*

¹⁰⁵ Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, [2002] O.J. L3, Art. 6(2).

¹⁰⁶ D. Musker *Community Design Law: Principles and Practice* (Sweet & Maxwell, London 2002) p.32.

is available for designer to develop the new design. Here the “informed user” shall depart from the ordinary consumer perspective which clearly indicates the flexibility this fictional person must have.

According to the Commission in normal circumstances a judge could easily assess the distinctiveness “[...] as he can easily put himself in the place of the ordinary consumer. There might be, however, cases where the characteristics of the ‘relevant public’ are so peculiar that an expert opinion could have to be ordered [...].”¹⁰⁷

4.4 Comparing designs

Initially the Commission proposed that for the purposes of assessing individual character “common features shall, as a matter of principle, be given more weight than differences and the degree of freedom of the designer in developing design shall be taken into consideration.”¹⁰⁸ As the Commission further explained “what counts is not the unimportant variations, which a competitor has added to a reproduced design (“intelligent copy”) but the common features.”¹⁰⁹ The problem with this approach arises in the fields where design development is very much restricted by technical or marketing constraints. In such areas industry feels that even small variations should be enough to establish difference. Under proposed test common features would easily outweigh small differences. Consequently a limitation is introduced where freedom of the designer is taken into consideration when assessing the individual character of the design.

That being said the European Parliament proposed to change the wording so that common features of the design would be given same weight as differences.¹¹⁰ The Commission felt that if common features of the design are given same weight as differences there is no need to explicitly state that as it is obvious and thus deleted the sentence.

Freedom available for the designer to develop a new design shall be taken into consideration when comparing designs for the purposes of individual character. The Commission explains in the Green Paper that “provision expresses the principle that, the more limited the freedom of the designer is in developing his design due to technical or marketing constraints (standardization, mechanical or physical constraints, necessity of taking into account deep-rooted marketing requirements by the clients, features imposed by fashion), the more weight has to be given to the small

¹⁰⁷ Green Paper on the Legal Protection of Industrial Designs – 111/F/5131/91-EN Brussels, June 1991, para. 5.5.7. p.73.

¹⁰⁸ Proposal for a European Parliament and Council Regulation on the Community Design COM (93) 342 final, December 3, 1993, [1994] O.J. C29/20 Article 6(3).

¹⁰⁹ Proposal for a European Parliament and Council Regulation on the Community Design (Explanatory Memorandum) COM (93) 342 final, December 3, 1993, [1994] O.J. C29/20 p.16.

¹¹⁰ Proposal for a European Parliament and Council Directive on the legal protection of designs (COM(93)0334 – C3-0513/93 – 00/0464(COD)) [1995] O.J. C287/158.

differences or variations as constituting and independent development.”¹¹¹ It seems that the list of examples provided by the Commission in the brackets above is not an exhaustive one. Standardization, mechanical or physical constraints could be regarded to be objective criteria for judgment and thus not that difficult to apply. However what shall constitute a deep-rooted marketing requirement by the clients or features imposed by fashion that changes so rapidly is hard to predict. This could definitely be a playground for lawyers to argue that certain features of a challenged design are dictated by these constraints and thus narrow the scope of protection of the design that is being infringed.

When comparing the designs the overall impression they produce on the “informed user” is what matters. The Green Paper states that in order to assess overall impression “it requires the judge [“informed user”]¹¹² to proceed by synthetic approach, letting the design act on him as a whole and comparing this impression with the one produced by the similar design.”¹¹³ This is an opposite approach from the one used to identify novelty. Consequently designs that may be considered to have an impressive catalogue of differences under the novelty requirement may fail to fulfill the requirements of the individual character because “informed user” would not perceive them to produce different overall impressions. The Commission refers to a French term “déjà vu” to illustrate when the design in question should be held to lack the individual character.¹¹⁴ Based on this illustration and the fact that consumers will not always have the possibility to compare both designs against each other at the same time one could suggest that “informed user” will take this into consideration when comparing designs.

4.4.1 Design freedom

Design freedom is interesting notion of itself. In certain areas designs might have very broad freedom available; however at current state of design development this might not be revealed yet. As Musker points out “good design lies in discovering or revealing the freedom available.”¹¹⁵ Consequently it seems logical that the legislator meant to refer to design freedom that is currently known by the “informed user”. Therefore new designs shall be compared according to known design freedom. How will this affect the successful designers that will develop very novel designs and broaden the knowledge of design freedom? A designer who develops an innovative design in the field that has been regarded to have little freedom,

¹¹¹ Green Paper on the Legal Protection of Industrial Designs – 111/F/5131/91-EN Brussels, June 1991, para. 5.5.8.3. p.74.

¹¹² Authors note.

¹¹³ Green Paper on the Legal Protection of Industrial Designs – 111/F/5131/91-EN Brussels, June 1991, para. 5.5.8.2. p.73.

¹¹⁴ Proposal for a European Parliament and Council Regulation on the Community Design (Explanatory Memorandum) COM (93) 342 final, December 3, 1993, [1994] O.J. C29/20 p.16.

¹¹⁵ D. Musker *Community Design Law: Principles and Practice* (Sweet & Maxwell, London 2002) p.33.

according to Musker, will benefit from presumption that there is little freedom available.¹¹⁶ Innovative designs that will broaden the scope of freedom available to the designers will certainly have the different overall impression from existing design corpus. Consequently such designs shall rarely ever need to rely on the freedom available. The fact that they are so innovative and thus capable of broadening known design freedom will confer to them different overall impression. Therefore one should look at the freedom available to the designer as an evolutionary concept.

4.5 Conclusion

An individual character test is the second part of requirements needed for design protection under the Regulation. This test is tailored to catch everything what is beyond identical designs and slavish copying. Thus individual character test is a remedy against the “intelligent copies” that might fulfill the requirements of novelty. Furthermore it brings a consumer perspective into the test. Consequently the designs are compared at the level of ordinary consumers where differences of the designs are analyzed by those who purchase them. Individual character test grants design protection that is adequate for the needs of industry and stimulates further innovation. It tackles the common problem where investments in design were hard to protect and free riding on someone else’s design, as a result of minor alterations, was a common place.

¹¹⁶ *ibid* p. 34.

5 Research on the case law

The Community design regulation establishes a litigation system composed of the OHIM and Community Design Courts. The OHIM enjoys exclusive jurisdiction over RCD validity verification. Whereas Community Design Courts enjoy exclusive jurisdiction over verifying validity of UCD. Moreover for infringement actions and declarations of non-infringement of Community designs and finally for counterclaims for a declaration of invalidity of a Community design when raised in connection with infringement actions.¹¹⁷ The Member States are to designate Community design courts and inform the Commission about it no later than 6 March 2005. After that the list of Community Design Courts will be published in the Official Journal of the European Union.¹¹⁸ There is no official list to date however reliable sources have informed that there are only eight Member States that have designated Community Design Courts.¹¹⁹ For the Member States which have not designated Community Design Courts the court to have jurisdiction over Community Design shall be decided by principles of *ratione loci* and *ratione materiae* until they do not do so.

There have been already 21 decisions on the invalidity of the RCD made by the OHIM that are available on their home page for study.¹²⁰ There are currently 67 pending applications for declaration of invalidity of the RCD.¹²¹

It is however much more difficult to track the cases that deal with the Regulation in national systems at this early stage of Community design development. The Regulation was adopted on the 12th of December 2002 and entered into force on the 6th of March 2002. Protection for UCD has been available since the 6th of March 2002, however, the first RCD could be registered as of 1st April 2003. Consequently at the current state of time it is highly unlikely that any case would have reached the highest courts in the Member States. That being said it is usually the highest courts that have the practice of posting their judgments online, and unfortunately, this is not the case in all the Member States. Therefore highest probability to find cases dealing with the Regulation is currently in lower courts. In the Member States which have designated Community Design Courts the research is simplified. From the date of designation one can be certain to find the cases that deal with Regulation in the designated Community Design Courts. However for the period before that date and for those Member States which have not designated their Community Design Courts yet, area of research is broadened to any national courts that have jurisdiction according to the

¹¹⁷ Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, [2002] O.J. L3, Article 81.

¹¹⁸ *ibid* Article 80(4).

¹¹⁹ For the list of the Member States see the Supplement A.

¹²⁰ Decisions on Invalidity concerning Community Designs <http://www.ohim.eu.int/en/design/invalid.htm> (May 9, 2005).

¹²¹ Pending Applications for Declaration of Invalidity of the Registered Community Designs (Status 04/03/05) <http://www.ohim.eu.int/en/design/invalidpending.htm> (May 9, 2005).

above mentioned principles.¹²² Consequently in order to research current case law dealing with the Regulation one should contact all the above mentioned courts with the request to provide information. Taking into account the time constraints that have been set, a throughout research of such magnitude is beyond reach of this paper. An alternative method of research has been chosen that should provide non-exhaustive picture of the current situation.

All the Member States in one form or another have national patent and trademark registration offices that are usually also in charge of design registration. Under conducted research design departments of those institutions have been contacted with the purpose to inquire of their knowledge of national case law which has been decided on the Regulation. All the institutions in the 25 Member States have been contacted, however only 8 of them replied (U.K., Germany, Estonia, Slovenia, Czech Republic, Lithuania, Denmark and Hungary). None of the design departments have had knowledge of existing case law on the Regulation. Consequently professionals in the design field have been contacted to inquire of their knowledge of existing case law on the Regulation. Selection of those professionals was mainly based on their active participation in writing scholarly articles in various specialized intellectual property journals. As a result of this inquiry only one case that has been decided on the substantive law has been found.¹²³ This is a Swedish case on the infringement of UCD of Nokia's®¹²⁴ mobile phone cover designs and mobile phone button set designs. Author had to translate the case from Swedish to English. For the purposes of translation a fellow Master of European Law program students with outstanding knowledge of Swedish and intellectual property law were asked to help out.¹²⁵ Unfortunately no further clarifications on the notions of novelty or individual character have been given by the court in this case. Designs of mobile phone covers and button sets that are seen in the pictures enclosed in the case file are almost identical to those of Nokia®. Therefore the court decided that the designs in question did not produce a different overall impression compared to the impression produced by the Nokia's® designs. Nokia's® designs have been disclosed in the fair at Hanover and later registered under national design registration which the court recognized as appropriate to constitute "made available to the public".

To the authors knowledge there are two more cases that have reached courts, however, only interim decisions in these cases have been made.¹²⁶

¹²² Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, [2002] O.J. L3, Article 80(4).

¹²³ District Court of Stockholm T11050-03 Växjö T-1087-02 Sweden. Concerning infringement of UCD of Nokia® mobile phones. (courtesy of Lottie-Ann Hulth, "Albihns", Sweden)

¹²⁴ Authors note: Nokia® is a well known Finish mobile telecommunication company.

¹²⁵ Master of European Law students in University of Lund, Anna Meyrowitsch and Hafþís Olafsdóttir.

¹²⁶ District Court of Borås T1110-04 Sweden. Concerning infringement of UCD of kitchen utensils. (courtesy of Lottie-Ann Hulth, "Albihns", Sweden) District Court of Aarhus FS 20-9314/2003 Denmark. Concerning infringement of UCD of confectionary in a shape of sand clock. (courtesy of Knud Wallberg, "Sandel, Løje & Wallberg", Denmark)

Further developments in those cases are anxiously awaited. Some litigation regarding the Regulation has been settled before the judgment on the substantive part of the cases has been given.¹²⁷ That being said one could conclude that there are very few cases available at the current state of time and thus no interpretation of the notions of novelty and individual character can be made.

¹²⁷ Ex. Mattel Inc. v. Woolbro (Distributors) Limited, Simba Toys (Hong Kong) and Simba Toys GmbH & Co KG The High Court of Justice, Chancery Division, Patents Court, The Honorable Mr. Justice Laddie, 23rd October 2003.

6 Discussion

Understanding notions of novelty and individual character in detail is central to understanding the Regulation. Both these requirements have been studied in detail with help from preparatory legislative materials and opinions of commentators. Different views have been expressed on the issues and several open ended questions have been identified. Following analysis will reflect personal views of the author on how these issues should be dealt with and how the two notions should be understood.

6.1 Prior design

The scope of prior design is important for both the novelty and the individual character tests. As already stated above, the moment from which prior designs shall be taken for comparison with the new design is same for the novelty and individual character.¹²⁸ Although in the initial proposal the body of prior design was narrower in the case of a/the individual character test, currently both notions have identical limitations stemming from Article 7 of the Regulation. Therefore prior design in the case of novelty and individual character is limited to designs that have been made available to the public within the meaning of the above mentioned article. What the Community design protects is the features of the product. There is no limitation to what kind of products shall incorporate those features or to which products they shall be applied. Neither in the novelty requirement nor in the individual character requirement is there a single reference to the product. Designs with their features are the ones to be compared. Consequently one should presume that incorporation of the design into a product shall be immaterial for the purposes of comparing design. The wording of the individual character test: “[...] overall impression it produces on the informed user differs from the overall impression produced on such a user by *any* design [...]”¹²⁹ supports this anticipation. Therefore one could easily end up, as Musker points out, comparing a design of a crank-shaft to that of electrical fuse.¹³⁰ Stretching prior design to such an extreme might raise the threshold so high that very little if any designs will meet the requirements for protection. An opposite approach has been taken by Levin, who finds that if fair comparison of designs is anticipated then one should not judge clothes by the same standards as tools.¹³¹ Consequently limiting the prior design body to the same type of products against which the new design shall be compared or at least same industry or branch. This approach seems on the other hand to conflict with the idea that

¹²⁸ Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, [2002] O.J. L3, Article 7.

¹²⁹ *ibid*

¹³⁰ D. Musker *Community Design Law: Principles and Practice* (Sweet & Maxwell, London 2002) p.25.

¹³¹ M. Franzosi (ed) *European Design Protection Commentary to Directive and Regulation Proposals* (Kluwer Law International Hague 1996) p.71.

designs are to be compared irrelevant of the product they are applied to. The author finds that both approaches merit recognition; however, at the same time have some inherited flaws. An alternative interpretation is suggested that follows below.

“Experts” knowledge allows them to identify designs that are almost identical irregardless of the product on which they are applied to or incorporated in. “Experts” are thus capable of spotting the same design features that have been incorporated for example in the hull of the sailboat and in the vase, whereas “Informed user” might fail to do so. At the same time “experts” are design detail oriented and thus will prevent only the designs that are identical or that differ in immaterial details only.

On the other hand what matters for the “informed user” is the overall impression. If the design of the vase does not create in their minds a “déjà vu” of the hull of the sailboat, both designs should be deemed to have individual character. The more famous and distinctive the design of a sailboat hull is going to be the more likely will the “informed user” have the feeling of “déjà vu” when purchasing the vase. This is in line with general principles of intellectual property law, where more innovative designs should be granted wider protection. That being said proposed solution would allow both the designer of the vase and the sailboat hull to acquire Community design protection. One might argue that, since the Community design is not limited to any product, the scope of protection granted to the vase would extend to the hull of the sailboat and vice versa. Consequently this would enable the owner of the design of the vase to challenge the hull of the sail boat as infringing its design and vice versa. The author is of the opinion that this problem is solved by the “informed user”. The “informed user” will set the boundaries to the prior design. Thus, a new design that has to be compared to the body of prior design might have an individual character and thus be protected just because the products to which the design is incorporated are so remote that they do not produce on the “informed user” similar impressions. The problem with the argument set by Levin is that it does not take into account the interest of the very innovative designs. Under proposed solution by the author it will be for the “informed user” to define whether designs is so innovative that it does not produce overall different impression when it is applied to or incorporated in a products that are very remote. Consequently a bill-board in a shape of i-pod®¹³² shall be held by “informed user” not to produce different overall impression. Whereas a vase in the form of the hull of the sail boat might be regarded, by the “informed user”, as having a different overall impression, because in particular the hull of the sail boat is not that known. One could criticize that proposed solution is returning to the products comparison. However one should take into account that “informed user” is incorporating *inter alia* a person who is a potential consumer of the goods to which the design is incorporated or applied to. A consumer, when making a purchase, is comparing goods that incorporate designs and not the designs as such separately. The Author therefore thinks that the mere fact that design is

¹³² Authors note: i-pod® is a well known portable digital music player produced by Apple®.

applied to or incorporated in products so remote could be enough to give different overall impression on the “informed user”. For certain designs this might be more the case than for others. This approach brings in flexibility where more distinguished designs will be recognized in products that are very remote. Whereas, on the other hand, it will limit the scope of prior design in cases where design is not so innovative. Furthermore proposed solution would prevent situations where a crank-shaft would be compared to electrical fuse. Consequently concerns expressed by Levin of possible unjust comparison of designs would be remedied. If this approach is to be followed, the body of a prior design will be identical for novelty and individual character requirements. That being said in practice it will be for “informed user” to tailor the scope of a prior design in each individual case disregarding designs that are applied to or incorporated in very remote products.

6.2 “Experts” and the sector

In order to establish whether a design in question meets the novelty requirement “circles specialized in the sector”¹³³ shall be consulted. Initial wording of the Green Paper is almost identical: “[...] ‘unknown’ to experts operating in the Community in the sector concerned [...]”¹³⁴ Consequently the “experts” operating in the sector concerned shall be consulted for the purposes of establishing novelty. The Commission defines “experts” as: “specialists, designers, merchants and manufacturers operating in the sector concerned.”¹³⁵ One should presume that these are not the users in the strict sense but the designers themselves and other specialists that have high knowledge of the designs in their sector. Again the problem of protecting design as such, irrespective of the sector of products it is incorporated in or applied to, surfaces. When assessing novelty, designs in question can be from remote sectors. Thus a design which is very well known in one sector might be not known by the experts of the other sector. A logical approach to solve this problem is to examine the knowledge of the experts in the sector of prior design. Otherwise, as Musker points out, a certain sparkplug design that is well known to mechanics can be easily not known to jewelers.¹³⁶ Consequently if the knowledge of the jewelers should be used to assess the novelty, then one could validly register above mentioned spark plug and gain protection in the sparkplug sector as well. It is very unlikely that this was the intention of the legislator. Thus a design which was made available to the public earliest shall be used to define the sector from which the specialized circles shall be asked for their opinion. This opens up a

¹³³ Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, [2002] O.J. L3, Article 7.

¹³⁴ Green Paper on the Legal Protection of Industrial Designs – 111/F/5131/91-EN Brussels, June 1991, para. 5.5.5.1. p.70.

¹³⁵ *ibid*

¹³⁶ D. Musker *Community Design Law: Principles and Practice* (Sweet & Maxwell, London 2002) p.36.

possibility of abuse for competitors who can go and research the other sectors in order to find novelty destroying identical designs. However, taking into account the low threshold of novelty requirement, impact of such possible abuse is quite limited.

6.3 Immaterial details

When comparing designs the “experts” shall compare the features of the design. A detailed analysis of the designs is made. Only the designs that are identical or differ in immaterial details shall be regarded as not new. Understanding the scope of immaterial details is essential. The preparatory legislative material does not provide an answer of when a detail becomes immaterial. That being said, one could draw some interpretation from the purpose of this provision. Novelty requirement is there *inter alia* to prevent counterfeit products from entering the market and slavish or identical copying of designs. To achieve this goal it is enough to have narrow scope of immaterial details. At the end, however, it will be for the courts to decide the scope of immaterial details.

6.4 Individual character “clearly” and “significantly”

Reduction of the threshold and thus the scope of protection under the individual character test by deleting the word “significantly” has been discussed above. Under current wording an “informed user” shall compare designs in question and see whether an overall impression produced by one design is different from the one produced by other. Recital 14 however speaks of impression that must clearly differ from the one produced by the other design. Speyart finds it that this discrepancy in wording is not likely to produce significant role in the cases brought to trial. Musker on the other hand points out that “[...] ‘clearly’ means something qualitatively different from ‘significantly’ – a small difference may be ‘clear’ but not ‘significant’ [...]”.¹³⁷ That being said one should presume that the word clearly is capable of granting substance to the test if just because of the above mentioned interest of the Council to keep it. Clearly a different overall impression should be understood of something more than a different overall impression. In the authors opinion one should not overlook the word clearly in the Recital 14, because courts could use this word to interpret the provisions of Article 6 of the Regulation. Consequently one could interpret that threshold for individual character has been reduced from significantly different to clearly different. Therefore designs which are capable of producing different overall impression which is not clearly perceived, requiring, for example, more close examination should be held not to have individual character. It is

¹³⁷ *ibid* p. 31.

very important to understand that there has to be a significant distance between the novelty and individual character requirements for the Community design system to function properly and produce the effects industry and legislators expect it to do. Therefore individual character test should not be lowered any more than what has been agreed in the Regulation.

6.5 Boundaries of “informed user”

“Informed user” as discussed earlier is a legal invention. One could imagine the “informed user” being anyone from end consumer to almost an expert. It is a flexible person who has to put on a hat of a consumer and at the same time be in the shoes of almost an expert. Where almost an expert will define the freedom available to the designer to develop the design in particular field and the end consumer, having in mind the opinion of almost an expert, will have to give the opinion on the overall impression of the designs. In most of the cases the judge will be able to put on a hat of a consumer and conduct the test of individual character. However it is not excluded that certain type of expertise will be needed when the “informed user” shall be someone more than an end consumer. The author believes that almost an expert should be consulted to define the freedom available to the designer in the particular field. However, in assessing overall impression, one should be very careful to resort to the expertise of almost and expert. This could lead to another novelty test under the name of individual character. Consequently undermining the importance of the individual character test and thus lowering the scope of the Community design protection. An example given by the Commission where “informed user” is a mechanic replacing an internal part of the machine could be used for further interpretation. An end consumer would have a little if any knowledge of the design of the internal part of the machine. Therefore it is reasonable that he or she is not to give the opinion of overall impression the design in question produces. A mechanic on the other hand would have the knowledge required to evaluate the overall impressions produced by the designs in question. That being said, a mechanic, at the same time, can have the knowledge of an expert. A risk of repeating a novelty test surfaces again. The author believes that courts should look for “informed user” who is the closest to the end consumer and whose knowledge is just enough to give the opinion on overall impression. In other words it should look for a person who is using the product, in which the design is incorporated or applied to, for the most of the time. Consequently the individual character test would be capable to preserve its purpose even in the highly specialized sectors and grant appropriate level of protection.

6.6 “Same weight”

While comparing designs under the individual character test common features and differences are given the same weight. Initial proposal advocated for more weight to be given for common features as a matter of principle. The author believes that in practice this change is not likely to produce very different results in the case of designs that have little freedom available in their development. A requirement to take into account the freedom available to the designer to develop the design in particular sector will automatically differentiate the importance of the features to be compared.

6.7 Freedom of the designer

As stated in the Green Paper in the sectors where design freedom is limited due to technical or marketing constraints, the more it is limited “the more weight has to be given to small differences or variations as constituting an independent development”.¹³⁸ This sliding scale approach should bring objectivity to the evaluation performed by an “informed user”. Under what circumstances one should consider that there is some limitation imposed on the designer is noteworthy of further investigation. The Commission explains that these constraints could be “standardization, mechanical or physical constraints, necessity of taking into account deep-rooted marketing requirements by the clients, features imposed by fashion”.¹³⁹ Standardization as well as mechanical or physical constraints are likely not to cause many problems as they are more or less objectively definable. On the other hand the deep-deep rooted marketing requirements by the clients or features imposed by fashion are likely to be more subjective. How long does it take for marketing requirement to become deep-rooted? Who will be the authority to define which features are set by fashion and which are not? It will be for the courts to put a limit to these possible constraints. The author believes that one should depart from the standardization and mechanical or physical constraints when interpreting this provision. These are forces that are outside the scope of the designer’s influence. Consequently if there are special sectors where similar constraints are being imposed on designers, then these constraints must be taken into consideration when examining freedom available to the designer.

¹³⁸ Green Paper on the Legal Protection of Industrial Designs – 111/F/5131/91-EN
Brussels, June 1991, para. 5.5.8.3. p.74.

¹³⁹ *ibid*

6.8 Is novelty redundant in the view of individual character?

As a result of amendments introduced to the Regulation, Speyart believes that the novelty and the individual character tests have become redundant. If a design has individual character then it must differ in more than immaterial details. Consequently it is not likely that “informed user” will spot some differences that have been left unnoticed by an “expert”. Since the prior design body for both tests is the same and taking into account the principle of legislative quality, there is no longer a need for having a novelty test.¹⁴⁰ Musker proposes that there are two differences between the tests of individual character and novelty and thus they are not redundant *per se*. First being the test person. There could be situations where “enough individually immaterial differences might be assembled to lead to an overall different impression.”¹⁴¹ Consequently a design would fail under novelty test and at the same time it will be deemed to have the individual character. Second difference is in the stipulation that under the novelty test only visual differences are evaluated whereas under the individual character test what matters is the impression, which is not limited to sight and can also involve an element of touch. Consequently designs that have minor visual differences might have significant differences “[...] on the sense of touch; a weight or flexibility differences.”¹⁴² Thus a design will fail under the novelty requirement but be deemed to have individual character. This difference exists provided that novelty test does not include evaluation of touch, if it does, then the difference disappears. Identical line of argument is presented by Derclaye in her recently published article.¹⁴³ The author concurs with opinion of Musker and Derclaye and would like to add following. Novelty requirement as such enables fast proceedings in the courts against identical copying and counterfeit goods. According to the novelty test an “expert” opinion would be requested to identify the differences of two designs. This procedure is much shorter than establishment of the freedom available to the designer in the field and comparing overall impressions that designs produce on the “informed user”. Consequently novelty requirement in a two step protection system contributes effectiveness to the Community design system. Importance of which should not be underestimated.

¹⁴⁰ H.M.H. Speyart “The Grand Design: An Update on the E.C. Design Proposals, Following the Adoption of a Common Position on the Directive” E.I.P.R. 1997, 19(10), p.608.

¹⁴¹ D. Musker *Community Design Law: Principles and Practice* (Sweet & Maxwell, London 2002) p.27.

¹⁴² *ibid* p.28.

¹⁴³ E. Derclaye “The British Unregistered Design Right: Will It Survive Its New Community Counterpart to Influence Future European Case Law?” *Columbia Journal of European Law*, Spring 2004, p.280.

6.9 Conclusion

The Community design has gone a long way before seeing the light of the day. Now that it is there one should make use of it. The Community design provides a useful tool for designers to protect their designs in effective manner throughout the Community. UCD with automatic protection from the moment a design is made available to the public will provide protection for many designers who start thinking about protection only at the stage of infringement. Whereas RCD will make it much easier to obtain a Community wide protection under reasonable costs and within reasonable time for the companies or designers who seek long term protection. A grace period of 12 months will enable to test designs before registration is sought. During this period UCD will protect the designs placed in the market. Incentive to create new designs is certainly higher now when Community design protection is available. For the purposes of this thesis the author chose to analyze two core notions of the Regulation on the Community design. Notions of novelty and individual character form the requirements for protection under the Community design protection system. Understanding these notions is crucial for understanding the scope of protection Community design system provides. Within the whole thesis, but especially in the Discussion chapter, the author seeks to give flesh to the notions. A high threshold for individual character should be preserved as this part of the test defines the strength of the Community design protection. The industry was suffering from very low and in some cases nonexistent threshold of novelty. Therefore one should not repeat the mistake of bringing the individual character too close to the novelty requirement. The Courts should make use of the “informed user” to provide fair and objective evaluations of design similarity. Very innovative designs should be granted wider scope of protection thus fostering the incentive to develop new designs. There are still some unanswered questions in the interpretation of the two notions, however this will be for the Community design courts and the ECJ to provide the answers to. That being said the Community design protection system is promising much stronger protection than most of the national design systems at a fraction of cost throughout the Community.

Supplement A

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 - District Court Bratislava I,
 - District Court Banská Bystrica,
 - District Court Kosice I
 - Appeal under competence of the Regional Courts in those three cities;
- Denmark:
 - The Maritime and Commercial Court of Copenhagen, Bredgade 70, 1260 Copenhagen
 - Appeal under the Supreme Court, Prins Jorgens Gard 13, 1218 Copenhagen
- Netherlands:
 - Rechtbank te Den Haag
 - Appeal Gerechtshof te Den Haag
- Poland:
 - Sad Okregowy w Warszawie
 - Appeal Sad Aeplacyjny w Warszawie
- Lithuania:
 - Vilnius Regional Court
 - Appeal Court of Appeals of Lithuania
- Austria:
 - Vienna Commercial Court
 - Appeal Vienna Higher Regional Court
- Spain:
 - Juzgados de lo Mercantil de Alicante
 - Appeal Audiencia Provincial de Alicante
- Czech Republic:
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