Recent case law of the General Court on designs:  
The trade mark and copyright dimension

Introduction

There is a potential for overlap between designs and Community trade marks (CTMs). This potential overlap stems from the definitions of a ‘design’ and a ‘product’ taken in combination – and ‘signs of which a Community trade mark may consist’. Logos, packaging, get up, colours and shapes are among the most common examples of this overlap. Individual character and novelty requirements are supposed to filter out undesirable designs through inter partes proceedings. Similarly, there are two main filters for keeping trade marks free of designs: first, the inherent ability of a sign to distinguish goods and services of one undertaking from those of another; and, second, the requirements of Article 7(1)(e) CTMR.

But the filters are imperfect and many ask why be content with ‘one string to your bow’, when you may get away with having two? Inevitably, signs creep onto various trade mark registers that look very much like designs and some objects of design protection may well look like they could be trade marks.

Unsurprising some of the more ‘creative’ counterfeiters have jumped at the potential for overlap and have sometimes sought to imitate the trade marks of others in their designs. To combat this possibility the CDR provides that a prior trade mark may be relied upon to invalidate the subsequent design, where the national law or the law of the EU governing that trade mark allows the right holder to prohibit such use.

Designs also overlap with objects of copyright protection. The 32nd recital of the CDR specifically contemplates this cumulation of protection. It is therefore logical that the relevant legislation also foresees the possibility of conflict between these two rights and thus the opportunity for an earlier copyright holder to invalidate a later design where

1 Article 3 CDR states:
(a) ‘design’ means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation;
(b) ‘product’ means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;

2 Article 4 CTMR states: ‘A Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.’

3 Article 7.1. ‘The following shall not be registered:

(e) signs which consist exclusively of:
   (i) the shape which results from the nature of the goods themselves;
   (ii) the shape of goods which is necessary to obtain a technical result;
   (iii) the shape which gives substantial value to the goods’.

4 Article 25(1)(e) CDR.

5 ‘(32) In the absence of the complete harmonisation of copyright law, it is important to establish the principle of cumulation of protection under the Community design and under copyright law, whilst leaving Member States free to establish the extent of copyright protection and the conditions under which such protection is conferred.’
‘the design constitutes an unauthorised use of a work protected under the copyright law of a Member State’.

Given the prevailing circumstances, the climate is ripe for conflicts between trade marks, designs and copyright. What is surprising is that earlier designs and copyright are not often invoked as a ground for cancelling CTMs before OHIM.

On the other hand, in five of the cases on designs that have come before the General Court in the past twelve months, from appeals of decisions from OHIM, there has been an issue of trade mark or copyright holders seeking to invalidate a registered Community design (RCD), and in a sixth case the Court has been criticized for having taken an overly trade mark oriented approach to judging a pure design issue. Considering that a total of only eleven judgments involving RCDs were handed down by the General Court on appeal from OHIM in this period, these figures give some indication of the importance of the matter.

I-TRADE MARKS

Cleaning device

The RCD holder obtained a registration for a component of a ‘cleaning device’ (shown below):

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6 Article 25(1)(f) CDR
7 Article 53(2)(c) and (d) CTMR.
8 Judgment of 25 April 2013, T-80/10, ‘Montres’,
   Judgment of 25 April 2013, T-55/12, ‘Cleaning devices’,
   Judgment of 27 June 2013, T-608/11, ‘Instruments for writing’
   Judgment of 21 November 2013, T-337/12, ‘Sacacorchos’
   Judgments of 4 February 2014, T-339/12, T-357/12, ‘Armchairs’,
9 Judgment of 25 April 2013, T-55/12, ‘Cleaning Device’.
The RCD was subsequently challenged under Article 25(1)(e) CDR on the basis that there was a likelihood of confusion in the sense of Article 9(1)(b) CTMR between that design and an earlier three-dimensional Community trade mark (see below) covering, *inter alia*, ‘equipment and containers for cleaning, including sponges, brushes, wipes, dusting cloths, mops’ in Class 21.

Both the Invalidity Division and OHIM’s Board of Appeal agreed to invalidate the RCD. The General Court upheld these findings.

First, the Court found that ‘use’ under Article 25(1)(e) CDR ‘does not necessarily presuppose a full and detailed reproduction of an earlier distinctive sign in a subsequent Community design. Even if the contested Community design lacks certain features of the sign in question or has different, additional features, there may be “use” of that sign, particularly where the omitted or added features are of secondary importance’. A full and detailed reproduction of the earlier sign is not required because the relevant public will retain only an imperfect memory of the signs and, thus, will not notice minor differences. The Court therefore endorsed the Board’s finding ‘... *that the geometric form and dimensions of the earlier mark and of the contested design are highly similar and identical in part...*’.

Accordingly, there was ‘use’ in the sense of Article 25(1)(e) CDR and a sufficient degree of similarity in terms of shape between the mark and the design (‘compact rectangular body rounded at the edges which houses a spray device and a cylindrical sponge’) to bring into play Article 9(1)(b) CTMR. Although differences existed, these were judged to be of secondary importance.

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10 See *supra*.

11 1. A Community trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

...;

(b) any sign where, because of its identity with, or similarity to, the Community trade mark and the identity or similarity of the goods or services covered by the Community trade mark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;

12 See para. 23 of the judgment.

13 These were ‘limited to a transparent cap, a transparent bottom part on both sides of the main body, and a thin plastic cover placed around the sponge. OHIM rightly notes that, in view of their secondary importance, those additions and differences cannot dominate the impression left by the contested design’ (para. 27 of the judgment).
As regards the comparison of goods, the Court noted that the contested RCD designated ‘cleaning devices’ and that these were included in the list of goods covered by the earlier mark. The goods were therefore held to be identical in the sense of Article 9 (1)(b) CTMR.

Given the everyday nature of the goods concerned, the relevant public was found to be the reasonably well-informed and reasonably observant and circumspect average consumer throughout the European Union.

On a visual level, a comparison of the earlier mark and the contested RCD showed that their geometric form, dimensions and shape were partly highly similar and partly identical, despite small differences and, even though the earlier mark only had a ‘minimum degree’ of overall distinctiveness.

The RCD holder disputed the validity of the earlier CTM but did so without filing an invalidity application. That argument was dismissed by the Court because, in accordance with its established case law, a separate invalidity application would have been necessary since, without it, the Court is bound by the Office’s finding of distinctive character.

Nevertheless, the General Court found that the shape of the challenged RCD was sufficiently unusual and striking for cleaning products to be capable of fulfilling the essential function of a trade mark. Given the identical nature of the goods and the high degree of similarity between the signs, there was a likelihood of confusion.

Importance

This case shows the difficulties that arise from the Court’s refusal to revisit inherent distinctive character in an inter partes context. Multiplication of procedures is the order of the day. If in doubt, a defence strategy should automatically include an application for cancellation of the earlier mark on the ground of lack of distinctiveness. That would be coupled with a request to stay proceedings in the trade mark/RCD invalidity proceedings.

Treating RCDs as if they were trade marks is fraught with problems. An RCD is supposed to protect the outward appearance of a product or part thereof or its ornamentation. A trade mark is protecting the identification of the commercial origin of goods and services. Yet despite these differing roles, the Court seems to have put the burden of proof on the defendant (the RCD holder) to demonstrate that the relevant public will not perceive the shape of the challenged design as an indication of origin (a trade mark).

The message this case sends is that it is definitely worth trying to obtain a three-dimensional registration of something that would normally fall under the remit of design law. Here the presence of the letters ‘am’ in the earlier mark were held not even to be recognizable to the general public. Nevertheless, this shows the attraction of adding elements to an otherwise non-distinctive sign in order to obtain registration and create another potential weapon in the holder’s arsenal.
Instruments for writing\textsuperscript{14}

The holder of an earlier German mark (see below) sought a declaration of invalidity against an RCD (shown below) on the basis of Article 25(1)(b) CDR \textit{(inter alia, lack of distinctive character)} and Article 25(1)(e) CDR \textit{(a distinctive sign that is used in a subsequent design, and Community law or the law of the Member State governing that sign confers on the right holder of the sign the right to prohibit such use).}

\begin{figure}[h]
\centering
\includegraphics[width=0.5\textwidth]{earlier_mark_challenged_rcd}
\caption{Earlier mark \hspace{1cm} Challenged RCD}
\end{figure}

Both the Invalidity Division and the Board of Appeal declared the RCD invalid. The RCD holder lodged an appeal before the General Court.

By Judgment of 12 May 2010\textsuperscript{15}, the General Court annulled this decision because the Board had based its decision on an earlier three-dimensional mark while referring explicitly to an earlier figurative mark (the same sign was protected by two distinct trade mark registrations in Germany, one as a figurative and the other as a three-dimensional mark).

The case was referred back to the Board which confirmed that the contested RCD was invalid, first, because there was a likelihood of confusion with the earlier three-dimensional mark (as depicted above) within the meaning of Paragraph 14(2)(2) of the \textit{Markengesetz}\textsuperscript{16} (thus triggering the application of Article 25(1)(e) CDR), and, second, because of the lack of individual character (Article 25(1)(b) CDR).

An appeal was subsequently lodged by the RCD holder and the case came back to the General Court. The first ground of appeal was that the Board had breached Article 61(6) CDR\textsuperscript{17} by re-examining ab initio the case, including aspects which were not discussed before the General Court, such as the lack of individual character under Article 25(1)(b) RCD. That claim was swiftly dismissed: the annulment of the Board’s decision implied the duty to take another decision, but not necessarily on the same legal basis as that analysed by the Court, provided the (new) legal basis relied on by the Board had been invoked by the invalidity applicant in the application for a declaration of invalidity\textsuperscript{18}.

\textsuperscript{14} Judgment of 27 June 2013, T-608/11, ‘Instruments for writing’.
\textsuperscript{15} Case T-148/08 and see \url{http://fordhamipconference.com/wp-content/uploads/2011/04/Humphreys-Paper.pdf}.
\textsuperscript{16} The relevant German trade mark law in the context of Article 25(1)(e) CDR.
\textsuperscript{17} Article 61(6) CDR: ‘The Office shall be required to take the necessary measures to comply with the judgment of the Court of Justice.’
\textsuperscript{18} Para. 36-37 of the judgment.
Moreover, this approach did not violate the RCD applicant’s right to be heard under Article 62 CDR because it had ample opportunity throughout the administrative proceedings to express its opinion on the invalidity applicant’s claim that the contested RCD lacked individual character\(^{19}\). Even the fact that the Board’s rapporteur had asked the parties to take a position in writing on two issues relating to the General Court’s judgment could not give the RCD holder the assurance that the legal basis for the decision would remain the same\(^{20}\).

On the violation of Article 25\((1)(e)\) CDR, the RCD holder claimed that this provision could not be relied on where the sign used in the subsequent design is only similar to the earlier one. The General Court confirmed that the application of Article 25\((1)(e)\) CDR is not limited to cases in which the earlier distinctive sign is reproduced identically in the contested design\(^{21}\). It is enough that the dominant features of the earlier sign be discernible in the contested design, from the perspective of the perception of an average consumer having an imperfect recollection\(^{22}\).

Next, the RCD holder claimed that, in the absence of any peremptory time limit provided for in the CDR and the CDIR, the admissibility of its request for proof of use (which, having been submitted for the first time before the Board, had been held by the Board to have been submitted out of time) should have been examined under Article 63\((2)\) CDR (that is, the exercise of discretionary power when adjudicating on the admissibility of belated facts and arguments). The General Court dismissed this argument holding that, in conformity with settled case law in the context of Article 42\((2)\) and \((3)\) CTMR, a request for proof of use must be submitted before the Invalidity Division, failing which it is automatically inadmissible\(^{23}\). In the Court’s opinion, Article 42\((2)\) and \((3)\) CTMR applies also, by analogy, to requests for proof of genuine use made in the context of RCD invalidity proceedings\(^{24}\).

Regarding the plea that the Board had failed to examine the extent to which the challenged RCD and the three-dimensional mark were similar, the General Court confirmed that the Board had assessed the existence of a likelihood of confusion correctly. The General Court confirmed that the identity of the goods and the similarity of the signs led to a finding of likelihood of confusion\(^{25}\). Moreover, the Board had been correct to find that the indentations in the contested RCD were secondary features, in view of their purpose (allowing a better grip), which left intact the impression that the signs are similar overall\(^{26}\).

The final plea of the RCD holder was that Article 25\((1)(b)\) CDR (individual character) had been incorrectly applied. However, the General Court simply noted that even if that plea were held to be well founded, it could not secure annulment of the Board’s decision because of the finding that had already been reached on the application of Article 25\((1)(e)\) CDR to invalidate the challenged RCD\(^{27}\).

\(^{19}\) Para. 47 of the judgment.
\(^{20}\) Para. 49-50 of the judgment.
\(^{21}\) In so holding, the Court maintained its previous finding that similarity of the mark and the design in trade mark terms is sufficient as per its judgment of 12 May 2010, Case T-148/08, para. 50-59.
\(^{22}\) Para. 82 of the judgment.
\(^{23}\) Para. 87 of the judgment.
\(^{24}\) Para. 89-90 of the judgment.
\(^{25}\) Para. 93-95 of the judgment.
\(^{26}\) Para. 101 of the judgment.
\(^{27}\) Para. 107 of the judgment.
Importance

This case confirms the important procedural point that once a ground of invalidity has been raised it is fair game at any stage of the proceedings, even after the case has been remitted to the Board by the Court. It is the procedural equivalent of ‘all is fair in love and war’.

As for the issue of ‘use’ of an earlier sign in a design, this case clarifies that the sign used does not have to be identically reproduced. The standards applied are taken from infringement of trade marks, with imperfect recollection playing a potentially important role. However, this is an awkward situation in these types of cases because the reproduced sign has not been used ‘in the course of trade’. One is merely considering the design as it appears on the register and not as used in commerce. However, the Court quite reasonably does not regard this as a hurdle to applying Article 25(1)(e) CDR in these circumstances.

In this case the Court did not have any problem in comparing the products and goods which were both for ‘writing instruments’. However, difficulties can arise where designs are for products that are different to those covered by the earlier mark. Should designs just be regarded as applying to all products and therefore, by definition, be regarded as identical, or similar, to any goods and services of the earlier mark?28 Or, is there a case for partial invalidity of designs where only certain of the goods and products compared are similar?29

In addition, the issue of proof of use in a trade mark – design context is an interesting one. Had the trade mark owner been required to prove its use, it would have had the complicated task of showing use of a three-dimensional mark. Whether the presence of word elements on the mark would have acted as an obstacle to showing such use is hard to tell in the light of recent trade mark case law30. Nevertheless, it is clear that the proof of use dimension brings in another layer of complication in these circumstances.

Jumping feline logo31

The Polish company, Danuta Budziewska, obtained an RCD (see below) for ‘logos’ in Class 32 on 2 May 2007.

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28 According to Article 36(6) CDR the indication of the product ‘...shall not affect the scope of protection of the design a such’.
29 This approach has been followed by the Board of Appeal in its recent decision in Representation of a Seated Figure, which is currently on appeal to the General Court (Case T-28/14).
30 See, for example, judgment 18 April 2013, Case C-12/12, ‘Levis Red Label’.
On 26 February 2009, Puma AG Rudolf Dassler Sport filed an application for a declaration of invalidity based on absence of novelty; lack of individual character and unauthorized use of distinctive sign under Article 25 (1) (e) CDR, based on various earlier international trade mark registration (including the one shown below). Particular emphasis was placed on the common characteristics that the feline images shared, including their upward pointing tails.

The Invalidity Division found the challenged RCD to be invalid on the basis of Article 6 CDR (lack of individual character). The Board upheld that decision finding, first, that the international trade mark of Puma constituted a disclosed design within the meaning of Article 7 (1) CDR (which the RCD did not dispute).

Second, the Board considered that the informed user was the user of logos. Since logos have various different uses, the informed user is equally varied: an entrepreneur, a manufacturer, a retailer, a bank, a public entity, an artist, a political party, etc. Since the earlier right had been disclosed inter alia for the clothing sector and sports material, the overall impression on the informed user was to be taken into consideration for those sectors.

Third, according to Article 6 (2) CDR, in assessing individual character, the degree of freedom of the designer in developing the design is to be taken into consideration. In the case of logos for clothing and sports material, the degree of freedom was assessed by the Board to be very broad. It is well-known that logos come in all sorts of different colours, shapes, or styles and the RCD holder could have chosen a design that was further away from the earlier Puma logo.

Fourthly, the overall impression is very similar, given that both designs have numerous aspects in common: both represent a light-coloured, left facing, jumping feline, with an upward pointing tail represented on a dark background. The Board concluded that such differences were in the muzzles, ears, paws and tail, but were minor.

On appeal to the General Court, the RCD holder claimed that the earlier logo was a mark and not an earlier disclosed design in the sense of Article 6(1)(b) CDR. The Court rejected that argument on the basis that the earlier mark had been disclosed through registration in the 1970s and therefore was an earlier disclosed design.

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32 Article 6(2): ‘a design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public’. 
Next, the RCD holder argued that the Board had made a trade mark analysis in considering the overall impression of the mark and the design. Also, the earlier mark concerned a leaping puma whereas the later design was of a domestic cat landing on all four paws. Other differences included the position of the ears, the visibility of all the paws and the position of the tail, which led to creating two different individual characters. However, the General Court rejected the claim that the Board had assessed the designs like trade marks as being unsubstantiated and found that whether the image of the challenged RCD was that of a domestic cat or puma, the overall impression produced on the informed user (the definition of whom given by the Board was not disputed) was in any case that of a feline. Moreover, the Court pointed out that the claim that the felines were in different jumping phases was not valid since a landing feline would touch the ground first with its front legs, and not back legs whereas both felines had their hind legs on the ground. The overall impression was therefore the same, namely that of a jumping feline.

The General Court therefore dismissed the appeal and upheld the decision of the Board.

Importance

The intervener in the appeal to the General Court (the Puma company) had requested that Article 25(1)(e) RCD be considered. In the event, this was not necessary as the Court found that the RCD gave the same overall impression as the earlier mark. The Court was thus spared a further case of applying likelihood of confusion tests to designs. This also had specific advantages in terms of avoiding a comparison of products and goods and the consequent difficulties of assessing what products logos would cover.

Interestingly, the RCD holder criticized the Board for a trade mark oriented approach to overall impression. Yet this allegation was not substantiated and, given that the RCD holder itself feigned a lack of awareness that an earlier trade mark could count as prior art for the purposes of assessing the absence of individual character of the challenged RCD, one cannot but wonder if the RCD holder really had a grasp of the differences between trade mark and design tests. In any event, it seems clear that the Court was totally correct in finding that the overall impression of the RCD was the same. Moreover, the fact that the informed user was so diverse – given the diversity of the products on which logos may be applied – it would seem that not too much importance should be attached to the informed user in such circumstances. At the end of the day, the fact was that the RCD was just too close to the earlier mark. Whether a likelihood of confusion type test or an individual character test was applied, the result would probably have been the same.

Perhaps what may be concluded from this case is that when there is a choice between Article 25(1)(e) and Article 6(1)(b) CDR, it is easier and safer to invalidate the design on the basis of lack of individual character.

33 Para. 40 of the judgment.
II-COPYRIGHT

Watchdials\textsuperscript{34}

An RCD was obtained for the black and white representation shown below:

\begin{center}
\begin{tikzpicture}
% Add your TikZ code here to draw the diagram
\end{tikzpicture}
\end{center}

The RCD was in Locarno Class 10-07 for ‘watch dials, parts of watch dials, hands of dials’. The design was subsequently challenged for (1) unauthorized use of a protected work under German copyright and (2) lack of novelty and individual character. Both grounds referred, \textit{inter alia}, to the prior art shown below:

\begin{center}
\begin{tikzpicture}
% Add your TikZ code here to draw the diagram
\end{tikzpicture}
\end{center}

The General Court dismissed the claim for copyright infringement because the invalidity applicant had not adduced the Applicant ‘any information as to the scope of copyright protection in Germany, in particular as to whether, under German law,

\textsuperscript{34} Judgment of 6 June 2013, T-68/11, ‘Watch-dials’.
copyright protection prohibits the unauthorized reproduction of the idea underlying the earlier works of art, and [was] not limited to protecting the configuration or features of those works.'

While the judgment is not particularly enlightening on the copyright-design antagonism, it is quite useful on the relationship of novelty and individual character.

As regards the alleged lack of novelty, the Court sought to explain the relationship between lack of novelty and individual character. The Court noted that the wording of Article 6 (individual character) is wider than that of Article 5 (novelty). Thus, ‘the differences observed between the designs at issue in the context of Article 5 may, especially if they are slight, not be sufficient to produce on an informed user a different overall impression within the meaning of Article 6. In that case, the contested design may be regarded as being new within the meaning of Article 5 but will not be regarded as having individual character within the meaning of Article 6’.

On the other hand, in so far as the requirement of individual character ‘goes beyond that laid down’ for novelty, ‘a different overall impression on the informed user within the meaning of Article 6 can be based only on the existence of objective differences between the designs at issue’ that would be ‘sufficient to satisfy the requirement of novelty’. Consequently, ‘the requirements of novelty and individual character overlap to some extent’.

The Court held that there were, from an objective point of view, ‘significant differences’ for the purposes of establishing novelty, and that the assessment of those differences did not depend on ‘their consequences for the overall impression produced on the informed user’. Thus, the difference constituted by the fact that the contested design was in black and white and the prior art in colour was not ‘irrelevant’ for novelty.

For assessing individual character, the Court found that watch dials would be worn visibly on the wrist and that the informed user would pay particular attention to their appearance. Thus, any variation in the intensity of the colours would not be insignificant to the informed user.

Given the fact that the degree of freedom of the designer is ‘limited only by the need to track and display the changing hours’, the existing differences were found to have a significant impact on the overall impression of the designs at issue. Thus the Court confirmed the Board’s finding that the challenged RCD had individual character.

Importance

The copyright claim never ‘got off the ground’. The reason for this was that the invalidity applicant had provided insufficient details regarding the scope of German copyright and its application in the case in point.

35 Para. 38 of the judgment.
36 Para. 39 of the judgment.
37 Para. 39 of the judgment.
This area is particularly fraught with difficulty. In its latest pronouncement on rights and obligations flowing from national law\textsuperscript{38}, the Court has reaffirmed that the invalidity applicant must not only provide OHIM with particulars showing that he satisfies the necessary conditions, in accordance with the national law of which he is seeking application, to prohibit use of the contested right by virtue of an earlier right, but also particulars establishing the content of that law\textsuperscript{39}.

OHIM must assess the authority and scope of the particulars submitted by the invalidity applicant in order to establish the content of the rule of national law that he relies on. However, such national law is not ‘a purely factual matter, the existence of which OHIM and the Court merely establish on the basis of the evidence before them’. Therefore, they must do more than just examine the documents submitted by the applicant and must establish the content of the applicable national law by verifying the relevance of the law invoked\textsuperscript{40}.

Particularly, ‘where the competent OHIM bodies are called upon to rule, initially, on an application for a declaration of invalidity of … based on an earlier copyright protected by a rule of national law, their decision may have the effect of depriving the proprietor of [of a challenged RCD] of a right that has been granted to him. The scope of such a decision necessarily implies that the authority which takes it is not limited to the role of mere validation of the national law as submitted by the applicant for a declaration of invalidity\textsuperscript{41}.

It is therefore important that OHIM - ‘of its own motion and by whatever means considered appropriate — obtain information about the national law of the Member State concerned, where such information is necessary for the purposes of assessing the applicability of a ground for invalidity relied on before it and, in particular, for the purposes of assessing the accuracy of the facts adduced or the probative value of the documents submitted\textsuperscript{42}.

In short, there is now much more onus on OHIM to look into national law than was the case previously. However, if woefully inadequate indications of national copyright are given from the outset, OHIM need not investigate further.

Cup and saucer with grooves and soup dish with grooves\textsuperscript{43}

Two RCDs were obtained for the following designs for crockery:

\textsuperscript{38} Judgment of 27 March 2014 in Case C-330/12P, National Lottery v OHIM.
\textsuperscript{39} Para. 34 of the judgment, citing judgment of 5 July 2011, C-263/09 P, ‘Elio Fiorucci’, para. 51.
\textsuperscript{40} Para. 38-42 of the judgment.
\textsuperscript{41} Para. 42 of the judgment.
\textsuperscript{42} Para. 45 of the judgment.
\textsuperscript{43} Judgments of 23 October 2013 in Cases T-0566/11 and T-0567/11.
The Invalidity Division upheld a request for a declaration of invalidity based on Article 25(1)(f) CDR and this decision was confirmed by the Board.

In its appeal to the General Court, the RCD holder first argued that the invalidity applicant had breached Article 28(1)(b)(iii) CDIR by failing to specify the dates on which the protected works were created and by omitting the identity of the natural person who actually created the work. The Court held that Article 25(3) CDR and Article 28(1)(b)(iii) CDIR require the applicant for a declaration of invalidity of an RCD based on earlier copyright to be the holder of that copyright and to provide OHIM with particulars establishing that fact. These matters depend on the law of the Member State (in this case, French law) in which the copyright is protected. In particular, national copyright law will define the procedures for acquiring and proving copyright of the work relied on in support of the application for a declaration of invalidity.

Applying those principles, the General Court held that the only relevant issue was to identify the holder of the copyright, who will be, in the absence of a claim by the natural person who created the work, the natural or legal person in whose name that work is disclosed. The Court went on to find that the information provided was sufficient.

On the second plea, alleging that the Board had incorrectly held that the contested designs constituted unauthorised use of a prior copyright, the Court considered that the only relevant issue was whether the invalidity applicant was the holder of a copyright under French law and whether that copyright was the subject of unauthorised use in the contested designs. Therefore, unlike the test for individual character, it was not appropriate to compare the designs at issue as a whole, but only to determine whether the work protected by copyright was used in the later designs. In other words, it had to

44 Article 25(1) CDR: ‘A Community design may be declared invalid only… (f) if the design constitutes an unauthorised use of a work protected under the copyright law of a Member State…’.
45 Article 25 CDIR states: ‘1. An application to the Office for a declaration of invalidity pursuant to Article 52 of Regulation (EC) No 6/2002 shall contain:
(b) as regards the grounds on which the application is based:
(iii) …in the case of an application pursuant to Article 25(1)(e) or (f) of Regulation (EC) No 6/2002, the representation and particulars identifying the distinctive sign or the work protected by copyright on which the application for a declaration of invalidity is based and particulars showing that the applicant is the holder of the earlier right pursuant to Article 25(3) of that Regulation…’.
46 Article 25(3) CDR: ‘The grounds provided for in paragraph (1)(d), (e) and (f) may be invoked solely by the applicant for or holder of the earlier right’.
be determined whether the presence of that work could be noted in those designs. This meant that differences relied on by the appellant, such as the shape of the cup or the design of its handle or the shape of the bowl of the soup dish, were irrelevant.

The Court confirmed that “it is undeniable that the decoration of the disputed designs greatly resembles the decoration of the intervener’s items of crockery, both as concerns the identical nature of the covered surfaces and as concerns the concentric nature, regularity and narrowness of the grooves. The greater thickness and the more pronounced character of the grooves, claimed by the applicant, are not sufficient to obscure that similarity”. The appeal was dismissed and the Board’s finding was confirmed that the decoration of the items of crockery was protected under French copyright law and that decoration had been the subject of an unauthorised use in the disputed designs.

Importance

This case demonstrates that both the procedure and substance of national copyright law are paramount in bringing a successful action under Article 25(1)(f) CDR. National law will identify who may bring the action and will show how copyright is protected against unauthorised use. To ensure success, invalidity applicants must properly document their case and not just rely on OHIM making further research into national law.

Despite the ruling of the Court of Justice in the National Lottery judgment\textsuperscript{48}, litigants in inter partes cases cannot expect OHIM to do all their work for them. If they only give the basics and fail to argue properly their case there is even the risk of misunderstandings or misinterpretations of national law with which some members of OHIM may not be fully conversant.

A further point of interest is that the design is not looked at as a whole but is evaluated for the purposes of checking whether it contains, in certain features, unauthorized reproduction of a protected work. It therefore does not bring into play any of the considerations of informed user or relevant consumer but is a purely objective and comparative assessment.

Conclusion

Cases involving conflicts between designs and other earlier IP rights, although probably still in their infancy, are starting to come before the General Court. Counterfeitters have shown a keen interest in using earlier trade marks in RCDs but the trade mark infringement tests developed in this area sit uncomfortably with designs. Showing unauthorized use of a copyrighted work in an RDC is possibly a more straightforward matter. However, invalidity applicants must be vigilant in bringing forward the necessary evidence of national law and not expect OHIM to do their job for them.

\textsuperscript{48} See supra.
Gordon Humphreys\textsuperscript{49}

Alicante, April 2014

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\textsuperscript{49} Member of the OHIM Boards of Appeal. The views expressed in this paper are those held personally by the author and do not necessarily reflect those of OHIM.