

EU Design Strategies: Maximising the Chances of Enforcement Success

Registered Community designs are granted pursuant to the EU Community Designs Regulation (6/2002). This provides that:

- “a design shall be protected by a Community design to the extent that it is new and has individual character” (Article 4);
- “‘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” (Article 3);
- “An application for a registered Community design shall contain a representation of the design suitable for reproduction” (Article 36);
- “The representation of the design shall consist in a graphic or photographic reproduction of the design, either in black and white or in colour” (Article 4 of Commission Regulation 2245/2002); and
- “The scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression” (Article 10).

Protection strategies

Grace period

Article 7(2) of the Community Designs Regulation provides that the disclosure of a design (by the designer, its successor in title or those acting on behalf of the designer/its successor in title) in the 12-month period leading up to filing the design (or the date of priority) will not be taken into account for the purpose of determining whether the design is new and has individual character. As Recital 20 of the regulation makes clear, the purpose of this is to allow designers to test their products in the marketplace before deciding whether to bear the cost of registering the design to gain the extra protection. In industries such as fashion, where designs can be short lived, it is often the practice to adopt this approach, with the added fallback (assuming qualification) of relying on unregistered Community design rights, which last for three years from - and will only arise from - first disclosure in the European Union. The practical implications are clear. If relying on the grace period, designers should record when and where they first disclose their design to the public (and be able to prove this later, if necessary). They should also (if required) ensure that a registered Community design is filed within a year from first disclosure, or at least that a first filing (within the meaning of the Paris Convention) is made within this period, with a priority Community filing made within six months. Disclosure in this context is international, except where:

- it could not have reasonably become known to specialised

individuals in the sector concerned operating within the European Union (an obscure disclosure); or

- the disclosure is abusive (eg, one made by a third party in breach of a confidentiality agreement).

As stated, the grace period will begin with the first disclosure anywhere in the world (unless it is obscure or abusive) - although only a first disclosure in the European Union will give rise to an unregistered Community design right to provide protection against infringement prior to filing for a registered Community design (the issue of what first disclosure in the European Union means in this context is now on referral to the Court of Justice of the European Union (CJEU) and is discussed opposite). A third-party disclosure of a design of the same overall impression in the interim would invalidate a later filed registered Community design, while an unregistered Community design right would not exist to prevent that third party from using the design in the European Union, unless the first disclosure had been made there.

Another possibility is that a third party attempts to effectively steal the rightful owner's design by filing its own registered Community design for the same design first. Such a filing, once published, would amount to a third-party disclosure sufficient to invalidate a subsequent registered Community design filed by the rightful owner (as defined by Article 14 of the Community Design Regulation). This leaves the rightful owner in a difficult position. It could seek to invalidate the third party's registered Community design at the EUIPO, or it can seek transferral of it at the court of a member state - a more costly and lengthy exercise, but one that ultimately leaves the rightful owner with a valid registered Community design.

Finally, there is also the key practical concern that if the design is a success and registration in the European Union and elsewhere is applied for towards the end of the grace period, any additional filings made in other jurisdictions that have no grace period, or where it lasts for only six months, may already be invalid.

For these reasons, relying on the grace period before filing a registered Community design is often best avoided. Instead, an attempt should be made early on to identify designs that are likely to have some longevity (and/or require wide protection), and a first filing should be made somewhere (perhaps in a low-cost jurisdiction) prior to first disclosure. This will give the rights holder six months to expand protection to other jurisdictions by filing further applications claiming priority (under the Paris Convention) from the first filing.

Unregistered design rights post-Brexit

Unregistered Community design rights will not apply to the United

Kingdom post-Brexit. However, in the event of 'no deal' or at the end of any transition period (if a deal is struck and there are no changes to the EU Exit Regulations), the UK government will bring into force a supplementary unregistered design right via the Designs and International Trademarks (Amendment) (EU Exit) Regulations 2019. This right will essentially be the same as the unregistered Community design right, except that it will apply in the United Kingdom only and will come into existence if the design is first disclosed in the United Kingdom or other qualifying countries (essentially, Hong Kong, New Zealand and UK-dependent countries). Designs that are first disclosed in the European Union will therefore not qualify for the new UK Unregistered design right; likewise, designs first disclosed in the United Kingdom will not qualify for unregistered Community design rights (as only designs first disclosed in the territory of the European Union will qualify for this right). This was at least the prevailing legal opinion (including of the EUIPO) until very recently. But in July 2019 the following question was referred to the CJEU by the Intellectual Property Enterprise Court (England & Wales) in *Beverly Hills Teddy Bear Company v PMS International Group* (EWHC/IPEC/2019/2419), precisely because of its relevance to Brexit:

1) For the protection of an unregistered Community design to come into being under art.11 of Council Regulation (EC) No. 6/2002 of 12 December 2001 ('the Regulation'), by the design being made available to the public within the meaning of art.11(1), must an event of disclosure, within the meaning of art.11(2), take place within the geographical confines of the Community, or is it sufficient that the event, wherever it took place, was such that, in the normal course of business, the event could reasonably have become known to the circles specialised in the sector concerned, operating within the Community (assuming the design was not disclosed in confidence within the terms of the final sentence of art.11(2)?)

The answer to this question is likely to be determinative in relation to not only how an unregistered Community design right can arise, but also how the new UK supplementary unregistered design right can arise. Until the CJEU has answered this question, rights holders should err on the side of caution and assume that the prevailing opinion as stated above will be confirmed by the court in due course. They should do so not least since, while UK law also provides for a UK unregistered design right (which protects the shape of an article for 10 years from first marketing), designers in the European Economic Area (EEA) who currently qualify for this right (by reference to qualifying country or country of first marketing by a qualifying person) will not qualify post-Brexit, as the EU Exit Regulations also provide that the list of qualifying countries will narrow so that only citizens or companies of the United Kingdom, Hong Kong, New Zealand and UK-dependent countries can qualify for the right. Designers or their employers in the EEA should thus be aware that as things stand they are unlikely to qualify for any form of unregistered design right in the United Kingdom post-Brexit, assuming first disclosure of their design in the European Union. The converse will apply to designers and their employers in the United Kingdom, unless they choose to make their first disclosure in the European Union, in which case they will qualify for a UK unregistered design right and the unregistered Community design right. Therefore, assuming that the CJEU follows the prevailing opinion and concludes that first disclosure must be in the physical territory of the European Union to give rise to unregistered Community design rights, those that have hitherto relied on unregistered design rights to protect

their designs in the European Union (including the United Kingdom) will need to change their protection strategy and may need to file for registration in at least one territory (where the design is not first disclosed) at least within the one-year grace period, which also applies in the United Kingdom. For EEA-based designers, this is likely to mean filing in the United Kingdom (where design registration is cheap), while UK-based designers will likely need to file for a registered Community design, unless they choose to first disclose in the European Union.

Design registration strategy - what to file to maximise enforcement success

The EUIPO does not substantively examine applications for a registered Community design; get the formalities right, and speedy registration is more or less guaranteed. However, this apparent simplicity places the onus on the applicant to ensure that what is protected is actually enforceable, while avoiding the traps into which others have fallen in the past.

General rule

The case most frequently cited case under English law is *Procter & Gamble Company v Reckitt Benckiser (UK) Ltd* ([2007] EWCA Civ 936). In that case, Lord Justice Jacob famously stated:

The most important things in a case about registered designs are:

i) The registered design; ii) The accused object; iii) The prior art. And the most important thing about each of these is what they look like.

Consistent with this, it is the representation of registered Community designs that is decisive in the assessment of their novelty and individual character, and thus often pivotal in the test for infringement. If the features in the representation are unclear, it will be difficult to determine the subject of the design in order to compare it to the prior art and it will be much harder to establish that a third-party design is of the same overall impression.

As the Community Design Regulation and EUIPO Design Guidelines make clear, the representation must:

- be able to impart an overall impression of the lines, contours, colours, shape, texture and/or materials of the product or part of it and/or its ornamentation;
- include sufficient detail that the design can be reproduced;
- be either in monochrome or in colour; and
- appear as a drawing, photograph, computer-made representation or any other form of graphic reproduction.

These factors then allow third parties to determine with clarity and precision the details of the design for which protection is sought. The design should also clearly demonstrate the features on which the owner will rely if required to enforce it. This must also be done within the confines of the requirements set out in the Community Design Regulation and the EUIPO Design Guidelines.

These establish that up to seven views per design are allowed, which must not include any wording or explanatory text (eg, view designations). Using all seven views is not compulsory - rights holders should use only as many as they need to best represent the subject of the design (its key features), although if the registered Community design will be a first filing and priority

filings are a possibility, it is worth remembering that some jurisdictions (eg, those in Asia) may require at least seven views. In practice, the seven views rule may cause difficulty when trying to depict very complex designs, or where claiming priority from first filings in jurisdictions that allow more than seven views - in which case the solution is usually to leave out those views that do not show key features, though it is sometimes necessary to file multiple design applications showing different embodiments of the same design. Finally, as the registered Community design will, once published, form part of the prior art, the view that best depicts the whole design (normally the perspective view) should be used first.

Applicants must indicate the product for which the design is to be applied and should normally indicate a Locarno class (or the EUIPO will assign one), although these do not affect the scope of the design.

Descriptions explaining the representations of the design are permitted, although are generally regarded as being of no value (at least for enforcement purposes) as “they will not affect the scope of the design as such” (Article 36(3)(a) of the Community Design Regulation). As verbal disclaimers are also not permitted, applicants must rely on visual disclaimers to identify the key features of the design that are claimed, and those that are not.

Decisions to be made include:

- Which, if any, lines, contours, colours, shape, texture and/or materials of the product or part of it and/or its ornamentation are part of the design which is said to be new and with individual character, and which are simply subsidiary.
- Whether the subsidiary features are to be disclaimed and how to do this in a way that is clear and precise.
- Whether the design includes various key features that themselves are best represented via various views. Is it better to file a multiple design application depicting the different features as separate designs (often it will be, particularly given that multiple designs can be filed in the same application), disclaiming the other features not being claimed?

How to disclaim features (or aspects) of the design

Blurring, colour shading, broken (or dotted) lines or other visual indicators

While written descriptions are allowed, they serve no purpose when it comes to enforcement. Only the representations themselves indicate the design and therefore any features of a representation for which protection is not sought should be disclaimed. A disclaimer can be achieved by using dotted lines, blurring or shading, provided that the disclaiming is clear and obvious and the same convention used in all views of the same design. Following the adoption of the Common Practice (CP6) of the European Trademark and Design Network by the EUIPO in its Design Guidelines in 2018, broken or dotted lines are preferred, with blurring and shading to be used if dotted lines cannot be used for technical reasons. The alternative is to include features of the design for which protection is claimed within a solid-line boundary, thus making it clear that no protection is claimed for anything that falls outside it. Prior to the adoption of these guidelines (which are still only guidelines and may not always be followed by the courts), these common forms of visual disclaimer have been found to mean different things in different cases.

For example, in *Sphere Time v OHIM & Punch SAS* (Case T-68/10,

[2011] ECDR 20), the applicant had registered a design that showed certain features in dotted lines. It tried to argue that the lines were solid, albeit less pronounced and not dotted. However, the General Court found that the lines were in fact dotted and therefore those features depicted in dotted lines did not form part of the elements that were protected by the contested design.

Contrast that with the success of Apple in *Samsung Electronics (UK) Ltd v Apple Inc* ([2012] EWCA 1339, [2013] FSR 9), where Apple argued that the guidelines relating to dotted lines were permissive and not mandatory and that features depicted by a dotted line in the design contested in this action were in fact protected. The High Court and subsequently the Court of Appeal agreed with Apple that the guidelines are not determinative and that each registration should be understood on its own merits. In this instance, a dotted line was used in the design registration to indicate a frame below a glass face. Samsung argued that the dotted line meant that the feature was not part of the design and therefore the fact that the Samsung device did have such a frame was to be disregarded. The Court of Appeal agreed with Apple that the dotted line was there to show a border below the shiny transparent surface and that the informed user would readily distinguish this.

In *Kohler Mira Ltd v Bristan Group Ltd* ([2013] EWPC 5), a case about shower units, the Intellectual Property Enterprise Court concluded that: “The Guidelines provide two possible interpretations for such [dotted] lines and to that extent are helpful but they are not the only possible interpretations. The proper construction of the design must be decided by considering the design registration itself.” The court went on to conclude that the dotted lines used in one of the registrations in suit indicated a transparent face and not an indication that what was shown inside the dotted lines (and behind the face) was what was being claimed. As a result, Bristan’s design was found not to infringe the registered Community design, although it was found to infringe Kohler Mira’s UK unregistered design right.

These cases demonstrate that applicants must be clear about whether a line is intended to be solid or dotted, and if dotted, why. Dotted lines should then be used in a way that makes their function obvious to third parties, with no room for ambiguity regarding what is being claimed.

Colours

Most drawings will be black and white. However, if a specific colour is part of the design, then the design should be registered in that colour. For example, the colour might be the feature which gives the design novelty and individual character. A tennis ball is a known design, but one coloured navy blue could be novel and individual. The holder of a registered design right for navy-blue tennis balls would not be able to rely on that registration to prevent the sale of yellow tennis balls even if they were an identical shape, because the design registration would be understood to require the navy-blue colour.

Toning

A similar rule applies to toning. Toning sometimes features in designs through omission rather than deliberately. For example, computer-aided design representations often incorporate toning and if these are used as the basis for a registration, then the rights granted might also incorporate toning. It is important to bear in mind that the court will take the toning as part of the design unless there is reason not to. For example, in *Magmatic Ltd v PMS International Group Plc* ([2014] EWCA Civ 181 (the Trunki

case)), the design registration showed the wheels of a suitcase in black while the body was in grey. The court held that these contrasting tones meant that the design claimed was not merely a specific shape, but a shape in two contrasting colours. This narrowed the scope of protection significantly and PMS's design was found not to infringe. Accordingly, applicants should be aware that computer-aided design representations will be interpreted in the same way as other illustrations, including any toning or other such effects.

Using photos

Photos are usually thought to be the easiest way to register a design - simply make a prototype, take a photo and register it. However, it is often difficult to disclaim non-key features of the design, which might not be part of the design's subject, other than by blurring the elements that are not claimed. Colour photos should be avoided (unless colour is a feature of the design), and care needs to be taken to ensure that a neutral background is used, otherwise this may be interpreted as being part of the design.

Conclusion

Rights holders should think carefully about when and where to

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first disclose and/or register a new design if protection is required in the United Kingdom and European Union post-Brexit. Think carefully if you are inclined to use the grace period and be aware that (subject to how the CJEU answers the question referred to it on the issue of first disclosure giving rise to unregistered Community design rights) you may no longer qualify for unregistered design rights in both the United Kingdom and the European Union post-Brexit.

When registration is used, careful thought is needed to ensure that the design is visually represented in such a way that the courts, and those looking at the register, will interpret the subject of the design (its key features) in the way that you want, without the need for further interpretation. Do this and you will have gone most of the way to ensuring that it is only the features of the design that are new and that have individual character which are protected, thus maximising the scope of the protected design and making it easier to enforce against infringers.

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