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Effective use of Community designs  
Christian Thomas, Kuhnen & Wacker

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*Building IP value  
in the 21st century*

# Effective use of Community designs

By **Christian Thomas**, Kuhnen & Wacker

The Community design and the harmonised design laws of EU member states have become increasingly popular in the field of prosecution and law enforcement.

In addition to the possibility of a design being eligible for protection, the question of enforceability is important. There has been a significant rise in the number of infringement actions involving designs over the last few years. When comparing designs to technical rights and trademark rights, designs have many advantages which make them increasingly attractive when it comes to practical law enforcement and which have led to them being described as a 'silver bullet'.

Designs are unique when compared to other industrial property rights. While it is easy for an owner to obtain a design right, it is difficult to have the design of an actual or alleged infringer revoked. As there is no examination process or substantive requirements for protection, designs confer a nearly irrevocable IP right on the holder. Although a pure registration right, designs are treated in the same way as examined IP rights when it comes to infringement proceedings. It is up to defendants to prove that the protection requirements of the claimed design have not been met.

However, rights holders should bear in mind that a design can be used effectively only if the scope of protection is clearly defined. It is also true that a design is only as good as its original application. Past case law clearly shows that it is not possible to take action, even in cases of clear infringements, if there are deficiencies in the original application which cannot be remedied.

Such situations can easily be avoided, since the preconditions for a design application are generally not very high. However, the first step

for effective use is a well-thought-out and well-designed application.

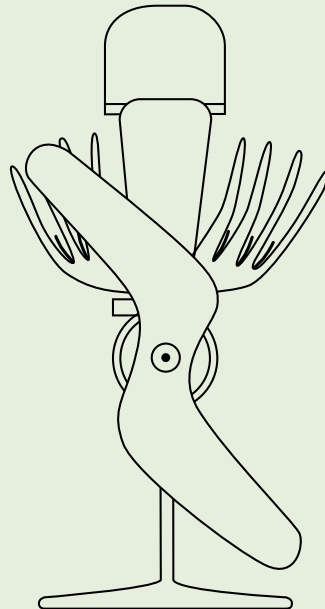
In this regard, it is important to know which general preconditions must be fulfilled when filing a design application and which requirements must be met by the applicant.

## General requirements

### Novelty

A design shall be considered new if no identical design has been disclosed before the application date. According to the prevailing opinion, a design is considered to be new if

Figure 1. **Example of a clear and precise graphic representation of a design**



it has not already been made available to the public. It is true that designs are regarded as identically pre-disclosed if their essential features – which are necessary to determine their individual character – differ only insignificantly from prior designs. However, in practice, the slightest deviations from another design are sufficient to affirm a design's novelty. Therefore, novelty does not constitute a real protective threshold for a design.

### Individual character

This situation is similar to that which applies for a design's individual character. A design shall be considered to have individual character if the overall impression it produces on an informed user differs from the overall impression produced on such a user by any design which has previously been made available to the public. The smaller the creative leeway, the lower the requirements for the degree of distinctiveness. Against this background, the difference between novelty and individual character is of a gradual nature. While differences in detail are sufficient when determining novelty, the dissimilarity of the respective overall impression is crucial in terms of individual character. Designs must be compared to each other with reference to their individual features and the effect of these features on the overall impression. Nevertheless, the requirements for individual character remain relatively low. Therefore, the protection threshold of individual character is also low.

### Novelty and individual character are assumed

One of the biggest benefits of a design when it comes to enforcement is that, according to Article 85(1) of the Community Design Regulation, EU courts must assume the validity of a Community design, meaning that the defendant has no opportunity to challenge or refute the novelty and/or individual character of the design by way of a simple objection. Instead, a defendant can challenge the validity of a registered Community design only with a counterclaim for a declaration of invalidity. This is explained in terms of the general public interest, which is best served not only by a design's invalidity being declared *inter*

Figure 2. Example of an only partial claim for protection



*partes*, but also by a Community design which is judged ineligible for registration being removed from the design register.

### Clarity of the application

A design's successful enforcement depends on the original application. It is crucial to have a high-quality application in order to enforce the rights deriving therefrom successfully.

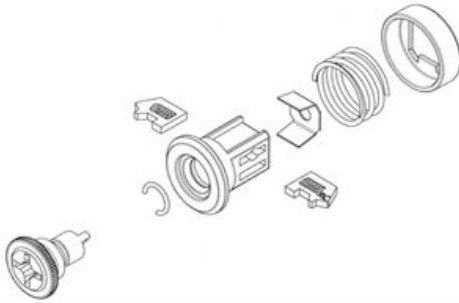
### Graphic representations of the design

It is essential to use precise drawings and pictures of the product for which protection is sought. In general, it is advisable to use computer drawings and/or sketches and to restrict oneself to the essential features, such as those in figure 1.

The Office for Harmonisation in the Internal Market (OHIM) describes the purpose of the graphic representations to be filed as follows in its guidelines:

*The purpose of the graphic representation is to disclose the features of the design for which protection is sought. The graphic representation must be self-contained in order to determine with clarity and precision the subject-matter of the protection afforded by the registered Community design to its proprietor. This rule is dictated by the requirement of legal certainty. It is the applicant's responsibility to disclose as thoroughly*

Figure 3. **Example of a complex product**



*as possible the features of its design. The Office will not examine whether additional views would be required to fully disclose the appearance of the design.*

No more than seven different views can be filed in order to represent the design (Article 4(2) CDIR). The views may be plain, in elevation, cross-sectional, in perspective or exploded.

Further, the scope of protection of designs can be significantly influenced when it comes to preparing graphical representations. This is particularly true if the following two aspects are taken into consideration.

#### **Broken lines and boundaries**

Applicants should take advantage of broken lines which may be used to indicate either the elements for which no protection is sought (eg, ornamentation applied to the surface of a given product whose shape is disclaimed) or portions of the design which are not visible in that particular view (ie, non-visible lines). The main purpose of broken lines is to show the environment in which the claimed features are placed.

This can be crucial for a judge, who must determine the scope of protection as well as the actual infringement situation.

#### **Neutral background**

A neutral background should be used on the pictures and/or descriptions. This should be no problem with computer

sketches. However, a neutral background is particularly important when it comes to pictures of the product. Unfortunately, representations of numerous registered designs have been found to include furnished rooms in the background.

The scope of protection afforded to such designs is thus reduced to nil.

#### **Take advantage of multiple applications**

The possibility of filing multiple applications gives rights holders the chance at more than one bite of the cherry – they can not only file an application for a comprehensive view of the product, but also seek protection for each component in a cost-effective manner. This additional protection for each individual component and feature can be crucial, in particular when it comes to subsequent legal prosecutions. According to the present legal opinion of some courts, there is a danger that a certain component of a complex product which is basically eligible for registration will not be protected if it has not been filed as an independent design. In practical effect, a key feature of a product will be treated as a part of the same and will be protected only if it has (also) been applied for and registered separately as an individual component part, and not (only) as a complex product. It remains to be seen whether the refusal of this partial protection by, in particular, the German Supreme Court must actually be largely understood in that way. However, this problem is relatively easy to avoid if the following aspects are taken into consideration when filing an application.

#### **Complex products**

A complex product is a product composed of multiple components which can be replaced, meaning that the product can be disassembled and reassembled. When filing for design protection of a complex product, applicants should submit at least one view showing the complex product in its assembled as well as in its disassembled form.

Each component part can in itself be a 'design'. Therefore, in many cases it is recommended that a multiple application be filed showing all separate designs for each component, including one design showing

the whole of the complex product. The main reason for this is that it will then be possible to go after an infringer which copies just a certain component part and not the whole complex product.

### **Details of products**

The same recommendation applies to a design which is not intended to be incorporated in a complex product where the views show only individual details which cannot be related to the appearance of the product as a whole. Each of the individual details of the product can in itself be a design.

Therefore, where all the views disclose different detailed features without showing these features connected to each other, it is again recommended that applicants take advantage of the possibility of a multiple application. Cross-sectional views showing interior parts of a product may be employed to clarify some features of the design.

### **Sets of articles**

The difference between a complex product and a set of articles is that, in contrast to a complex product, the articles of a set of articles are not mechanically connected. However, it must be clear from the representation that protection is sought for a design resulting from the combination of the articles making up the set. Applicants should submit at least one view showing the set of articles in its entirety.

A design for an entire set does not enjoy protection against the reproduction of (only) individual component parts. These are (again) protected only by means of individual applications within multiple applications.

### **Variety of articles**

Anyone seeking to obtain protection for product variants – that is, various products of a product line which follow the same design vocabulary, but which differ in detail (eg, a series of cases) – must file individual designs. This is comparatively easy to do using multiple applications.

### **Enforcing design rights**

The imitation of successful products involves industrial sectors beyond classic

luxury goods, such as watches, clothing and jewellery. National economies are being considerably damaged because of the associated weakened incentive for investment. Due to the trade in counterfeit goods, producers of original goods face not only losses in sales, but also damage to their brand image and liability risks.

Fortunately, the EU Community Design Regulation – in conjunction with the national regulations of individual EU member states – provides suitable and effective possibilities in order to prosecute design infringements. A claim for cease and desist (injunctive relief) on the grounds of a Community design infringement applies to the entire EU territory, because an infringement committed anywhere in the European Union establishes, in principle, a risk of repeat infringement for the entire EU territory.

Remedies in case of design infringement are primarily civil (eg, injunction or damages), although there are also penal remedies, as well as administrative remedies such as border seizures.

### **Main procedural principles**

An infringement case is usually started by sending a warning letter with a cease-and-desist declaration specifying a contractual penalty in case of violation. Should such a letter fail to resolve the matter, the rights holder will usually file proceedings for a preliminary injunction (see below).

The claimant must present evidence of all facts which are relevant for a finding of infringement. Occasionally, the courts may require a design expert to speak about the novelty or individual character of the asserted design. Many cases are decided on the basis of written presentations by the parties and in subsequent oral hearings in which the presiding judge explains the views of the court and gives the parties an opportunity to present their arguments and observations. Formal taking of evidence is an exception in design infringement proceedings.

### **Claims on the merits in proceedings**

The legal tools available to claimants in infringement proceedings include claims for cease and desist (injunctive relief),

destruction of the infringing products and detailed information and rendering of accounts about infringement activities by the defendant, as well as damages, which may be calculated based on the accounts rendered (eg, account of sales or profits). When actions for the infringement of Community designs are brought, Article 89 of the Community Design Regulation provides for injunctive relief, the seizure of infringing products and the seizure of materials and implements

predominantly used in order to manufacture the infringing products.

### Preliminary proceedings

Some courts in Europe, especially German courts, are prepared to grant a preliminary injunction *ex parte* if the claimant can provide evidence of ownership and validity of its design right, as well as sufficient likelihood of infringement and urgency. The claimant may assert claims for cease and desist, as well as for the disclosure of information about the infringement and a preliminary seizure order.

## Contributing profiles



**Christian Thomas**  
Partner  
[crt@kuhnen-wacker.com](mailto:crt@kuhnen-wacker.com)

Christian Thomas is a partner with renowned IP law firm Kuhnen & Wacker. He specialises in IP-related litigation and prosecution (in particular trademarks, domain names, unfair competition, copyright, designs and product piracy). Dr Thomas studied law at Ludwig-Maximilians-University in Munich and joined the Bar Association in 2005. He was awarded his PhD from the University of Salzburg in 2009.

Before joining Kuhnen & Wacker, Dr Thomas worked for a law firm in Australia. He frequently lectures and writes on IP-related matters. He represents parties before the German civil courts, the German Patent and Trademark Office, the Office for Harmonisation in the Internal Market, the Federal German Patent Court and the general courts, as well as the European Court of Justice. Dr Thomas is a member of the International Association for the Protection of Intellectual Property, the German Association for the Protection of Intellectual Property and the International Trademark Association.

### Conclusion

The Community design is an unexamined right which helps to secure absolute protection for any design (whether banal or complex). The applicant should be aware of and take advantage of all possibilities available at the time of filing (eg, filing multiple designs and/or using detailed views and/or sets of articles). In addition, it should make sure to use high-quality computer drawings or pictures that clearly show the essential characteristics of the design. This will help with enforcement of the design at a later stage.

The fact that novelty and individual character are legally assumed and simulated means that registered designs enjoy the effect of examined property rights. This is a great advantage for rights holders and should be duly exploited. However, as ever, it remains for the courts to limit the content and scope of IP rights correctly and to avoid allocating over-expansive property rights which impede free competition. *iam*



**KUHLEN & WACKER**  
Intellectual Property Law Firm

### Kuhnen & Wacker

Prinz-Ludwig-Str 40A  
85354 Freising/Munich  
Germany

**Tel** +49 8161 608 0

**Fax** +49 8161 608 100

**Web** [www.kuhnen-wacker.com](http://www.kuhnen-wacker.com)