

Shop talk

It pays to do your homework when protecting designs on the EU stage, says Richard Dissman

The ongoing legal battle between Apple and Samsung about, among other things, the design of their respective tablet computer products has demonstrated that a legal dispute relating to design law can be truly multi-jurisdictional in nature. This case originated in the US, but spread to courts in Germany, Japan, South Korea, the Netherlands and the UK. With more than 50 proceedings pending and billions of euros in damages claimed between the parties, the legal conflict has been aptly named the “battle of the tablets”.

Because of the high-profile nature of the parties and their products and the inevitable ensuing publicity, the general public has become more aware than ever before that the design of a product is capable of receiving legal protection, and that this protection can be enforced through the courts. The case has also demonstrated that courts in different jurisdictions can apply different approaches to a case and reach different results.

In this article, I will explore the phenomenon of “forum shopping” in the context of design law in Europe, how it can be used effectively and its practical effects.

Interlocking options

First, it is important to remember that there is no single Designs Act that regulates the protection of designs across the European Union (EU). Instead, there are several different overlapping and interlocking legal options for the protection of designs.

The most important right for the protection of designs is probably the Community Design, which is a unitary pan-EU right administered by OHIM and available both as a registered right (the Registered Community Design or “RCD”) and as an unregistered right (the Unregistered Community Design or “UCD”). The legal basis for the Community Design is Council Regulation (EC) No 6/2002. While

the UCD has a period of protection of three years from the date the design was first made available to the public within the Community, the RCD is valid for an initial period of five years from the date of filing of the application and can be renewed for up to four successive periods of five years, giving a total potential period of protection of 25 years. The main advantages of the Community Design are that it is straightforward to obtain, and both the registered and unregistered rights offer protection in every EU Member State and, with that, the possibility to obtain pan-EU injunctive relief.

Member States also have national legislation in force to protect national designs, for example the German Geschmacksmustergesetz (“Design Act”) or the UK’s Registered Design Act 1949. Belgium, the Netherlands and Luxembourg have formed a joint protection system for national designs.

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For most, but not all, of the national design regimes, policy and procedure are aligned with the EU rules applicable to the Community Design regime.

In addition to the regimes specifically implemented for protection of designs, other national and Community regimes may also be applicable to designs. For instance, in many EU Member States, some designs can be protected by copyright. A product’s design can also, in certain circumstances, be protected under unfair competition or passing-off law in some countries. Counterfeiting or imitation of the design of a product

can be considered a violation of fair trade practices and therefore as an infringement.

Finally, but of increasing importance, designs can also be protected as three-dimensional (3D) trade marks under the national or Community Trade Mark regimes, provided that the form is not dictated by a technical need or by the product itself. However, once these legal requirements are satisfied, applicants for 3D trade marks can often struggle to show that the shape of their product is sufficiently distinctive that it can act as an indication of trade origin, and the competent granting offices tend to be strict in applying these requirements (so as to avoid copyright or design protection through the back door). But, if such obstacles can be overcome, 3D trade mark protection for a product's design is a potentially valuable tool for those with highly distinctive product designs.

This multitude of means for protecting a design opens up a number of legal options for a claimant when looking for a legal venue in which to bring a case. The claimant can, for example, sue a defendant on the basis of a Community Design in one country, on the basis of copyright in a second country, and on the basis of unfair competition law in a third country – all at the same time. Since design law, copyright law and unfair competition law also grant slightly different means and scope of protection, the results of these multiple cases are independent of one another and in practice may very well differ.

In addition to the various legal rights that can be asserted, there are also many types of proceedings available. Each EU Member State has its own procedural system, and the mechanics and timing of these proceedings may differ significantly, even when the same legal right is being considered. In the *Apple v Samsung* cases, for instance, the results of this are evident. In the Netherlands, the Samsung tablet was held not to infringe Apple's RCD in the preliminary proceedings of the first instance court and upon appeal. Therefore, no preliminary injunction (PI) was granted. In Germany, however, Apple successfully obtained a PI with effect throughout the entire EU. This PI was, however, later reduced in scope to Germany only and the legal basis for the injunction was changed from the RCD to German unfair competition law. The UK court then reached the same

conclusion as the Dutch court and ruled that the Samsung tablet did not infringe.

This series of events demonstrates the advantages and risks of forum shopping in the context of design law. While forum shopping is possible between EU Member States (for instance, choosing between the UK and German courts for the most sympathetic forum in which to commence, say, an infringement action), it is also sometimes possible within a given Member State. For instance, in Germany, it would be possible to sue an alleged infringer based on an RCD in

'In the *Apple v Samsung* case, the judgment of the UK High Court that was unfavourable to Apple led to a reversal of previous favourable German decisions'

one court, based on a national design in another court, based on copyright protection in a third court and based on unfair competition in a fourth court. Each of these courts would assess the case before it (while being aware of the other pending cases) and make an independent judgment on it. For the rights owner, this can be a very interesting option, because it only requires one of the four courts to grant an injunction to achieve its commercial goal of stopping the defendant from selling its products.

Of course, there are limitations to such practices. One important limitation is that if there is a main action pending with

respect to an RCD in one Member State, another main action based on an identical national design would no longer be possible. However, unlike in trade mark law, where such situations happen more often, in design law the obstacle of a *lis pendens* in another country is rather rare. A more relevant factual obstacle is that negative decisions in one country may backfire on the rights owner and influence the courts in other jurisdictions, which, until then, had been more inclined to grant protection. In the *Apple v Samsung* case, the judgment of the UK High Court that was unfavourable to Apple led to a reversal of previous favourable German decisions. Thus, a rights owner who wants to leverage the options of pan-European forum shopping must also understand the potential risks involved.

In that context, it is crucial to have an international team of enforcement experts who are familiar with cross-border litigation strategies and who can advise on the opportunities and pitfalls of an international enforcement strategy. If such strategies are implemented properly, they can offer a substantial advantage to the rights owner. Defendants may also benefit from adding forum shopping to their defence strategy. ■



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The design dossier

ITMA authors reveal the latest EU decisions that touch upon the subject of designs



Austria Colour and material as distinguishing features

The Austrian Supreme Court rarely takes on design cases, but in a case (17 Ob 4/10b, 31 August 2010) concerning a dispute between producers of double-walled glasses it confirmed that the Claimant's Community designs were novel and had individual character. With respect to individual character, it held that a Community design has individual character if one of its distinguishing features is not included in any of the pre-existing designs.

The Court went on to say that the same standard applies to the infringement of a Community design. If a distinguishing feature of the conflicting design is not included in the Community design, the conflicting design does not infringe the Community design.

According to the Supreme Court, the colour of the Community design can be a distinguishing feature. If the representation of the Community design is in a certain colour, designs in a different colour that are otherwise identical may not infringe the Community design. However, in the case before the Supreme Court, the representations of the Claimant's Community designs were in black and white. Therefore, the Supreme Court concluded that the colour was not a distinguishing feature.

Similarly, the use of a certain material can be a distinguishing feature. The Supreme Court considered that the representations of some of the Claimant's Community designs showed that the material was "shine-through", whereas the Defendant's glasses were made of clear

and transparent material. The Supreme Court held that the use of clear and of shine-through material on the one hand and of transparent material on the other were distinguishing features. It concluded that the Defendant's clear and transparent glasses did not infringe the Claimant's Community designs for double-walled glasses made of shine-through material.

This decision underlines that it is up to the applicant to decide the scope of protection of a Community design. If the representation of the Community design is in colour or shows that the object is made of a certain material, designs in a different colour or material that are otherwise identical may not infringe the Community design. On the other hand, if the representation of the Community design is in black and white or does not show the material, colour and material are not distinguishing features and the scope of the Community design is much wider.

Gabriela Staber, CMS Reich-Rohrwig Hainz



Belgium Shedding new light on design issues

Friesland v Incopack, President of the Commercial Court of Brussels, 17 November 2010

Dutch company Friesland is a producer of dairy products, including whipped cream sold in spray bottles/aerosol cans. Friesland was, *inter alia*, the holder of European patent EP 1916931 for an aerosol can with a nozzle with several technical features. Friesland filed the design of its nozzle as Community design number 595947-0001.

The design of the whole aerosol can was filed as Community design number 595947-0002. The two Friesland designs are as follows:



Incopack is also a producer of whipped cream sold in aerosol cans and used a design for its aerosol can that allegedly infringed Friesland's design rights.

Friesland brought injunctive relief proceedings against Incopack before the President of the Commercial Court of Brussels.

The President of the Court decided that essential features of appearance, even if they are new and have individual character, cannot be protected by a Community design if they are dictated solely by their technical function. The President of the Court made a comparison with trade mark law and referred to the CJEU case of Philips v Remington, in which trade mark protection for the shape of a razor was considered.

The President of the Court went on to state that it was irrelevant that other shapes may exist that would achieve the same technical result. The features of appearance of a product will be deemed to be dictated solely by their technical function if these features of appearance of the shape have been patented. The features of appearance will not be deemed to be dictated solely by their technical function if the design extends beyond the purely technical aspect, but this was not the case here.

The President of the Court also decided that the question of whether the features of

appearance of the aerosol can with a nozzle had acquired distinctive character was irrelevant in assessing the validity of the Community design. The President referred here to the CJEU Lego case (C-48/09P, 14 September 2010).

Second, the President of the Court ruled that Friesland’s Community designs lacked novelty and individual character. Incopack demonstrated that several competitors in Germany and Austria have marketed aerosol cans and nozzles that created the same overall impression with informed users.

Finally, the President of the Court considered whether technical and functional elements of a design can be protected by copyright law. He decided that they can in theory but, in this case, the designs of the aerosol can and nozzle were dictated merely by their technical function and therefore lacked originality. As a result, copyright protection was refused.

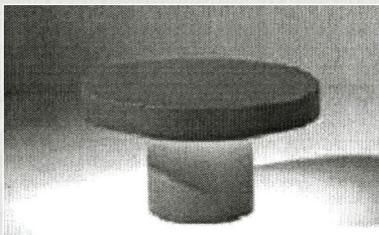
The President granted the counterclaim that was initiated by Incopack and ordered the cancellation of Friesland’s Community design registrations. Friesland has appealed this decision, however, and the appeal will be heard by the Brussels Court of Appeal.

Pits v Modular Lighting Instruments, Court of Appeal of Brussels, 26 June 2012

In this case, the Court of Appeal confirmed the validity of the Claimant’s registered Community design and the Court found the Defendant to have infringed the Claimant’s rights.

The design holder, Pits, had registered Community designs 602487-0001 and 0002 (shown below).

Pits noticed that Belgian public broadcaster VRT used lamps in a popular



television show that were copies of its registered design. Because the broadcaster did not want to replace the lamps, Pits sued both the broadcaster and its supplier, Modular Lighting Instruments. The Court of Appeal had to decide whether the lamps used in the television show constituted an infringement of the Community Design rights and the copyrights of Pits.

The Court ruled that, even if the freedom of the designer is limited by functional requirements, a design can have individual character through differences with earlier designs. Several small differences between lamps can lead to an overall impression that gives a lamp individual character. In that case, the overall impression on the informed user by earlier designs will be different.

The Court of Appeal confirmed the validity of the registered Community designs and examined whether the lamps used by the broadcaster infringed the design rights. The Court found that the lamps used in the television show differed only slightly from the protected design; they were smaller, but this did not create a different overall impression. The Court therefore found the lamps’ design to be an infringement of Pits’ rights.

‘The Court ruled that, even if the freedom of the designer is limited by functional requirements, a design can have individual character through differences with earlier designs’

Because the lamps had been used in a public broadcast, the designer also claimed copyright protection and alleged that there had been a communication to the public of his copyright-protected work without consent.

The Court of Appeal agreed, ruling that the design of the lamps was the personal and original creation of the author. The author had made free creative choices that gave his work the personal touch that is required for an original work

of authorship to be protected by copyright law.

The Court of Appeal ordered the Defendants to discontinue sales of the infringing lamps and ordered them to publish part of the Court decision on their websites to inform the public about the infringement. The Court ordered the broadcaster to stop using the infringing lamps in its television show.

Pommier Furgocar v Boyriven, Commercial Court of Mons, 29 March 2013

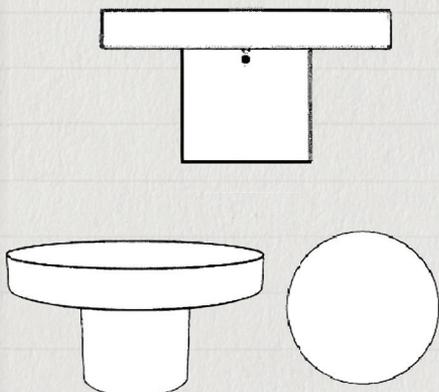
In this case, the Plaintiff, Pommier Furgocar, was the owner of registered international design number 061766 for locks that are used to restrict access to trucks. When the Plaintiff noticed that a competitor was offering similar locks for sale, it filed an *ex parte* request with the President of the Commercial Court and applied for a “descriptive seizure”. The Plaintiff asked the President to block all allegedly counterfeiting products and to designate an expert to describe the alleged counterfeit products and report on the quantities sold. The President granted the request and the Plaintiff blocked the stock of more than 500 locks. It subsequently brought the case on the merits before the Commercial Court.

The Court examined the different locks that were found during the descriptive seizure. One was found to be a prototype that was never commercialised. It had been published on a website for more than a year before the case was initiated and the statute of limitations barred the claim in relation to this prototype. The Court found

that several other types of locks did infringe the design rights of Pommier Furgocar.

The Court rejected the claims of Pommier Furgocar that were based on copyright law. The locks were not found to have been original works of authorship for which copyright protection could be claimed.

Online option: In September 2012, the Benelux Office opened its database for free online searches at BOIP.int, which allows online searches for data and images of registered Benelux designs. The database



includes all designs that were valid on 1 January 2012 or that were subsequently registered.

Tom Heremans and Lisbeth Depypere, CMS DeBacker, Brussels



Finland

Scope of protection expanding

Traditionally, Finnish court practice was to grant quite a narrow scope of protection to Finnish designs. Compared to Finnish case law established prior to the implementation of the EC Directive on Designs (98/71/EC), more recent case law and a precedent of the Supreme Court in particular have broadened the scope of the protection of registered designs in Finland.

By issuing the said judgment, the Finnish Supreme Court has established a judicial precedent regarding the basis used when assessing whether the overall impression produced by the product is different from the overall impression produced by the registered design (KKO 2007:103, Finnish Supreme Court, 31 December 2007).

The national Copyright Council (which issues non-binding opinions on the application of the Copyright Act in Finland) has also issued several written opinions on copyright protection of three-dimensional objects.

More recently, the Helsinki Appeal Court has issued judgments on design rights, for instance in a case concerning designs relating to waste containers (nr 10, S 10/207, Helsinki Appeal Court,

5 January 2011). In this case the designs were protected but no infringement was found since the actual products were different from the protected designs. The Court held that the overall impression produced by the product was different from the overall impression produced by the registered design.

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France

Couture clash

Christian Dior Couture/ Ash Distribution (No 11/02407), Paris Court of Appeal, 8 February 2013

Christian Dior Couture claimed to have created, in the autumn of 2006, a model of shoes named “Extrême Dior”, which it marketed and offered for sale in 2007. Dior discovered that Ash Distribution was selling a “knock-off” of this model and filed an action before the Paris Court against the latter for infringement of both its copyright and its unregistered Community design (UCD) right in this design.

The Paris Court of Appeal granted Dior’s claims in respect of both the copyright and the UCD-based actions. The judgment provides a good picture of French case law with regard to the respective criteria for protection by copyright and UCD, as well as the rules for presuming ownership in copyright and UCD rights.

The ruling is particularly clear with regard to the ownership of both rights claimed by Dior. With regard to copyright, the Court ruled, in accordance with settled case law, that in the absence of any claim of ownership in the design in question by its author, a corporate entity

that markets a work under its own name (here, Dior) is presumed to be the owner of the copyright of such work.

The Court also found that Dior should be considered the owner of the claimed UCD right through the application of Articles 14 (particularly paragraph 3) and 15 (particularly paragraph 1) of the European Community Design Regulation 6/2002, and through the absence of any claim made by an employee of Dior or other person claiming ownership of the design in question.

The ruling also offers a good opportunity to compare the standards for protection through copyright (under French law) and UCD (under the European Community Design Regulation), respectively. As regards copyright, the Court found that the design in question met the “originality” requirement set forth under French law. It held that the design was the result of a creative effort by its author, mainly through a unique combination of elements commonly known by the public, despite the fact that the said elements may lack any such originality in themselves. With regard to UCD, the Court stated that the only applicable criteria were those set out under Articles 5 and 6 of the European Community Design Regulation: novelty and individual character. More

‘The judgment in the Dior case provides a good picture of French case law with regard to the respective criteria for protection by copyright and its UCD’

specifically, the Court emphasised that contrary to what was claimed by Ash, the novelty requirement did not imply the need to show any “creative effort” and therefore was not equal to originality. As Ash did not bring any evidence of a prior disclosure in the Community of a design that was likely to destroy the novelty or individual character of the UCD claimed by Dior, the Court found that the UCD should be held valid.

This judgment serves as a helpful reminder that copyright and UCD regimes should not be confused when filing infringement actions before the French

Courts. Accordingly, each action should be considered separately and filed only if the applicable requirements are met.

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Germany

Questions could affect
many Member States

In connection with its decision on *Gartenpavillon* (Garden Pavilion, I-ZR 74/10, 16 August 2012), the German Federal Court of Justice (BGH) submitted six questions concerning the interpretation of the Community Design Regulation (CDR) to the Court of Justice of the European Union (CJEU). The CJEU response is likely to affect the application of substantive law in numerous Member States.

The Claimant held the Defendant liable for infringement of an unregistered Community design that refers to the outer appearance of a garden pavilion.

As set forth in Article 11 of the CDR, an unregistered Community design comes into being once it has been made available to the public within the Community. Such disclosure has to be effected in such a way that the design could reasonably have become known in the normal course of business to the relevant individuals who specialise in the sector concerned operating within the Community. According to the Claimant, the unregistered Community design came into being by way of the first distribution of illustrations to wholesalers. The question of whether the distribution of illustrations to wholesalers suffices so that the design in question could reasonably have become known in the normal course of business to the specialised circles operating within the Community was

answered inconsistently in Germany. For example, according to an opinion widely held in Germany, simple dealers belong to specialised circles in terms of Article 11(2) of the CDR only in exceptional cases because they are usually involved neither in the creation of the design nor in the development or manufacture of products in accordance with the design. The BGH, however, tends to hold the view that the normal course of business of the specialised circles also includes monitoring the market to take the competitive situation and new trends into account when developing products. It thus asked the CJEU whether, under Article 11(2) of the CDR, a distribution of the design to dealers suffices for the assumption that the design could reasonably have become known

'An unregistered Community design comes into being once it is available to the public within the Community'

in the normal course of business to the individuals specialising in the sector concerned operating within the Community.

The Defendant argues that the Claimant's design lacks novelty due to prior publication with reference to: (i) a presentation of the contested, largely identical pavilion in the showrooms of its manufacturer in China, and (ii) the sending of an offer to a Belgian company.

According to the BGH, a presentation in a showroom of the manufacturer is outside the scope of usual market monitoring and can thus reasonably not have become known to the specialised circles operating in the Community. Nor could the occasional disclosure to a Belgian company reasonably have become known in the normal course of business to the specialised circles in the Community. According to the Court, disclosure to a broader circle is usually required in order for specialised circles to obtain knowledge. For final clarification in this regard, however, the BGH submitted to the CJEU the question of whether Article 7(1), sentence 1, of the CDR was to be interpreted to such effect that although a design had been made available to a third party without explicit or implicit conditions of

confidentiality, it could reasonably not have become known in the normal course of business to the circles specialising in the sector concerned operating within the Community if: (i) it was made available to only one company of the specialised circles, or (ii) it was displayed in a showroom of a company in China that was located outside the usual market monitoring.

Subsequently, the BGH turned to the question of property right infringement and ascertained that it was required pursuant to Article 19(2) of the CDR that the contested use resulted from copying. According to the BGH, it is the Claimant that bears the burden of proof under general civil procedure principles that the contested use is to be considered copying. The burden of proof could be reversed, however, if the designs matched in material aspects. *Prima facie* evidence suggested in such cases that the designer had been familiar with the contested design during creation. The BGH also asked the CJEU whether Article 19(2) of the CDR was to be interpreted to such effect that the holder of an unregistered Community design bore the burden of proof that the contested use results from copying the protected design and - if this question were answered in the affirmative - whether the burden of proof was reversed or the holder of an unregistered Community design could benefit from an easing of the burden of proof if the design and the contested use matched in material aspects.

Further aspects critical for deciding the case were whether the Claimant's cause of actions were time-barred or forfeited. While national law in Germany does provide for statutes in this regard, the CDR does not regulate the issue of

'It is the Claimant that bears the burden of proof under general civil procedure'

the requirements for the cease and desist entitlement pursuant to Article 19(2), Article 89(1)(a) of the CDR concerning an unregistered Community design becoming time-barred or forfeited. According to the BGH, this question should be answered consistently within the Community and not be subject to national law. That is why it submitted

these questions to the CJEU for response as well.

Finally, the BGH submitted another question – extremely relevant to practice – to the CJEU for response. The CJEU response to this will affect not only the interpretation of the CDR, but also that of the Community Trademark Regulation. The question arose of whether a court competent as a Community design court with Community-wide power to ascertain and rule on actual facts (*Kognitionsbefugnis*) had to apply its respective *lex fori* or the law of all Member States with regard to asserted annex claims that were not explicitly regulated in the CDR (information, compensation, destruction, etc). The BGH tends to share the latter view.

The CJEU decision on these questions will be awaited with great interest.

**Dr Carsten Menebröcker, LL.M (NYU),
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current efforts of Greek courts to be less lenient toward postponement and more understanding towards providing fast relief (by all legal means available, including temporary restraining orders and various injunctions) mean there is a more favourable picture emerging in the Greek jurisdiction when it comes to the protection of design rights (in sync with the efforts affecting the protection of the entire spectrum of IP Rights in Greece – reforms that have been a welcome by-product of the economic turmoil in Greece over recent years).

In relation to case law, a recent highlight on the aspect of protection of designs is a decision (case 7233/2011, Multi-Member Court of First Instance, Thessaloniki, 21 March 2011) related to a famous design of a white salty cheese sold in Greece that was copied by a competitor. The competitor was found to be infringing and was ordered to cease the particular use of its similar design, notwithstanding the various alleged side-differences between the two designs.

All in all, developments in Greece based on the recently amended legislation and case law point towards a positive handling of matters for IP rights-holders, including those holding design rights.

Eleni Lappa, IPWORK.GR, Athens

application to registration, and proved such lack of novelty with internal documents and information sheets and an article published externally.

As the design was registered with a priority date of 3 September 1998, the Hungarian Intellectual Property Office (HIPO) had to decide the case pursuant to the Law-Decree 28 of 1978 (“Law-Decree” had been adopted by the Presidential Committee of Hungary with the force of acts adopted by the Parliament, prior to 1989). This provided that a design had to be deemed new in cases in which it has not been made available to the extent it could be produced by anyone (section 1, paragraph 2 thereof). The new Designs Act – Act 48 of 2001 – expands the requirement by stating that the designs shall be deemed to have been made available to the public when they are made accessible through publication, other communication, exhibition, commercial distribution or otherwise, unless such activities, within the normal course of business, could not reasonably result in disclosure to professionals operating in the European Community.

HIPO refused the application and found that even though the designs were identical, MÁV had not proven that the design had been installed on public trains. HIPO further concluded that closed distribution channels and production-on-order may have restricted access to the given design, and dismissed the claims that the design served merely functionality.

The court of review, the Capital Court, substantially disagreed with HIPO and stated that if anyone within a business activity had the right and capacity to produce the design the novelty requirement cannot be established. The Capital Court found that MÁV had not established confidentiality when it first produced the security locks, and as such, the design had to be considered to be publicly available during the course of the business of MÁV – resulting in the lack of novelty and ineligibility for initial registration. The Capital Court also concluded that all parts of the design served some technical function, and it had not been a result of designer activity.

The case was finally decided by the Capital Court of Appeal, which adopted the original reasoning of HIPO. First, the Capital Court of Appeal stated that the existence of designer activity in relation



Greece
Reform rejuvenates
design legislation

Greek legislation on designs has recently changed as per the relevant provisions of Law No 3966/2011 (Article 53) and the main provisions of the new Trademark Act No 4072/2012 put in force in October 2012.

These amendments have been welcomed by both those in industry and legal practitioners as being positive towards right holders and stricter on infringers by introducing faster recourse and harsher penalties than those previously available. These stricter penalties, coupled with the



Hungary
Novelty and functionality:
a case study

The content and meaning of “novelty” and “functionality” was decided in the case initiated by the Hungarian Railway Company (MÁV) and presented to the Capital Court of Appeal (Fővárosi Ítéltábla) in 2012 (case 8.Pkf.25.381/2012/5).

MÁV applied for the deletion of a design registered to the Proprietor under the name “Security lock”, on the basis of lack of novelty, further claiming the design was a mere consequence of the product’s technical purposes. MÁV claimed that the design had been made available prior to

to designs that are already known to the public had to be considered to decide whether the design is novel. Such a determination shall be made in the light of the public's overall impression of the exterior of the design. The Court concluded that as the challenged design and MÁV's design were essentially the same, the exact time of public availability had to be established. The Capital Court of Appeal subsequently concluded that MÁV could not prove the date the security locks had actually been installed, which was to the benefit of the Proprietor of the challenged design. The Court further found that the mere fact that a design serves functionality cannot automatically result in ineligibility for protection, as many different designs may serve the same function while preserving originality and individuality. According to the Capital Court of Appeal, MÁV failed to successfully prove that the design had been created solely to fulfil technical purposes.

As a result of the three-tier interpretation, the challenged "security lock" design remained effectively registered.

**Dóra Petrányi and András Losonci,
CMS Cameron McKenna LLP, Budapest**



Italy
IKEA features
in key cases

Angelika Morlein v IKEA ITALIA Retail SRL, Design Authority (Design Self-Regulation Code), 9 October 2012

This case deals with the alleged infringement of articles 4 and 5 of the Design Self-Regulation Code, relating to

unfair competition and the unauthorised exploitation of third parties' industrial design works.

In this particular case, the designer, Angelika Morlein, alleged that IKEA infringed her collection of reading lamps named "Post scriptum" (characterised by particular lampshades representing female dresses), and applied to the Design Authority to prevent IKEA from further distributing the allegedly infringing products and effect their withdrawal from the market.

On 9 October 2012, the Design Authority held that IKEA was not liable for unfair competition, since its disputed products were a reproduction of an older collection by IKEA that was commercialised a few years prior to the Claimant's designs. Furthermore, as a matter of fact, the Authority agreed that lamps shaped like a human body had been available on the Italian and international markets for many years. Thus, Morlein's creations could not be considered as having the necessary requirements of creative character and artistic value expressly provided by Article 2.10 of the Italian Copyright Law.

Titi Fabiani and IFT company v IKEA ITALIA Retail SRL, Specialised Section in Intellectual Property Matters at the Court of Venice, 25 May 2012

The Claimants, who manufacture and distribute bookshelves named "BOOK", applied for a preliminary injunction against IKEA, alleging that the latter's "Billy" bookcase infringed the Claimants' copyright under Article 2.10 of the Italian Copyright Law. The Claimants also claimed unfair competition for slavish imitation.

At first instance, the Court held that even if the "BOOK" bookshelf possessed a "personal author elaboration" that expressed a certain level of originality as required by the law, the Claimants' claim for copyright infringement would have been rejected since the enforced creation lacked the necessary "artistic value". However, the Judge considered that IKEA was liable for unfair competition under Article 2958.1 of the Italian Civil Code and held that the products were confusingly similar.

On appeal, the Appeal Section of the same Court reversed the previous order (decision dated 8 August 2012), affirming that: "In order to depict unfair competition for slavish imitation it is mandatory that the

imitation/repetition concerns exactly the features of the product that have distinctive and personal character, which therefore distinguish the enforced item from similar products, identifying it as originating from a certain manufacturer, in light of both the evaluations of the consumer and through a global appraisal." The Appeal Section also specified that "the so-called 'functional shape', as well as the shape that is necessary for the nature of the product because of its technical or aesthetic profile and those that are standard, cannot be considered as provided with the necessary distinctive character".

The proceedings on the merits are currently pending.

Licia Garotti, Bird & Bird LLP, Milan



 **The Netherlands**
Reminder of the importance
of a good design registration

In a case that emphasises the importance of filing strategy in relation to design rights, on 13 December 2011 the Court of Appeal in The Hague rendered a judgment in a design infringement case between Slewe and the Groove Garden with respect to flowerpots such as those depicted on page 28.

Slewe was the holder of a registered Community design (RCD) on the BLOOM flower pot, which is both an oversized flowerpot and a lamp.

The Groove Garden marketed the GG-Pot and Slewe lodged infringement proceedings against it. The District Court dismissed the claims of Slewe at first instance and considered that the GG-Pot did not infringe the RCD