

Design features

Spring 2018



IN THIS ISSUE

Three Major Court of Justice Design Cases

This has been the year the European Court of Justice decided some rather fundamental design law issues, in three major cases. In each, they balance the rather ambiguous wording of the design Regulation and Directive against larger policy issues. The first concerns the defence of functionality and the second and third concern the scope of legitimate competition in parallel markets.

EU and UK negotiate for IP Rights to continue in the UK after Brexit

The EU Commission published its Draft Withdrawal Agreement on 28 February 2018, providing that holders of registered EU trademark rights, Community Design rights or Community plant variety rights shall become holders of corresponding rights in the UK after Brexit.

See page 2 for full story

News UK Joins Hague Convention

The UK is taking steps to get its IP ducks in line in time for Brexit. In our sister publication **Patent issues**, we report on ratification of the Unified Patent Court Agreement. Here we report on ratification of the Hague Agreement on industrial designs

See page 3 for full story

CJEU

- **Doceram – clarity or confusion on functional designs?**
Pages 4-5
- **Nintendo v Bigben:** an over-broad defence for accessory-makers
Pages 6-7
- **Acacia, Audi and others:** a broad defence for spare part makers – with strings attached
Pages 8-9

UK CASES

- **“Magnitone™” electronic facial skin care devices infringe L’oreal’s RCD**
Pages 10-11
- **High court issues guidance on how to shorten design trials**
Pages 12-13

Germany

- **Sucker blow for thread lifter**
Page 14

Benelux

- **“Dictated by technical character”**
defence fails before court in Brussels
Page 15

EU AND UK NEGOTIATE FOR IP RIGHTS TO CONTINUE IN THE UK AFTER BREXIT

BY HUGH DUNLOP

Continued from page 1



Hugh Dunlop

On 19 March 2018 the negotiating parties exchanged a colour-coded version of the draft text indicating that much of the text has been agreed.

A proprietor of an EU IP right on 31 December 2020 (the end of the Brexit transition period) *will be entitled to a new UK IP right on 1 January 2021* that is equivalent in every way to the EU IP right. It seems that the UK government is not holding out for a veto right to refuse to allow a EUTM registration onto the UK register, e.g. for EUIPO marks that have previously been refused by the UKIPO. What is not yet agreed is the extent to which the cost of implementing the new IP right will fall on the UK Government, the rightholder and the EU.

The Commission's draft proposes that registration of corresponding UK rights will be free of charge and will require no administrative procedure, including no requirement for a UK address-for-service, at least up to first renewal of the right (draft Art 51). This is sometimes referred to as the "Montenegro" model. The UK Government has not yet agreed to make this happen free of charge and may require an opt-in (sometimes referred to as the "Tuvalu" model) or may simply unilaterally deem that the EU rights have effect in the UK (referred to as the "Jersey" model).

Designations of the EU in a Madrid system or Hague system application before the end of the transition period shall enjoy "grandfathered" protection in the UK for their marks or designs (draft Art 52). This too is *agreed*.

Unregistered Community design rights will become enforceable UK rights (agreed draft Art 53). Database rights will likewise become enforceable UK rights (agreed draft Art 54).

It is also *agreed* (draft Art 55) that pending applications for EU trade mark rights shall be dealt with by giving rise to an ad hoc right of priority in the UK for the same mark in respect of the same or similar goods or services, for a 6-month period from the end of the transition period. Applications for Community plant variety rights are dealt with in a similar way.

Where an application for an SPC is made in the UK before the end of the transition period but the procedure for grant of the certificate is ongoing at the end of that period, the Commission proposes that the applicable EU SPC regulations shall apply, and any subsequent granted certificate shall have the level of protection provided for by those regulations (draft Art 56). This is not yet agreed.

Rights that were exhausted in the EU and the UK before the end of the transition period will remain exhausted (agreed draft Art 57).

An area over which there may remain some negotiating is in geographical indications, designations of origin and designations of traditional specialties. The Commission proposes that these will be grandfathered to become equivalent UK rights (Art 50(2)). The EU currently recognizes non-EU geographical indications and will continue to do so. Accordingly, businesses relying on UK geographical indications (e.g. "Scotch" whisky) should continue to benefit from protection in the EU system, whatever the result of the negotiation.

UK RATIFIES THE HAGUE AGREEMENT

BY TIM PENDERED



Tim Pendered

The UK is taking steps to get its IP ducks in line in time for Brexit. In our sister publication *Patent issues*, we report on ratification of the Unified Patent Court Agreement. Here we report on ratification of the Hague Agreement on industrial designs.

The UK instrument of ratification of the Hague Agreement was deposited in Geneva on 13 March 2018 and will come into effect on **13 June 2018**. From that date, applicants from participating states can use the system for industrial design protection in the UK, and *vice-versa*.

At present, UK businesses have access to the Hague Agreement system of design registration, but only via the EU's membership. With Brexit looming there is a need for the UK to join in its own right (though the decision to join had already been taken before the Brexit referendum).



UK Ambassador, Julian Brathwaite and WIPO Director General, Francis Gurry, at WIPO HQ Geneva

If UK is designated, publication will not be deferred

There is a practical twist for applicants of the system extending to the UK. Whereas applicants from most Hague Agreement countries can elect to defer publication for 30 months from filing, UK domestic law does not provide for such a long deferment, so the UK has implemented a deferment of only 12 months. Accordingly, if you designate UK you have to accept a shorter deferment for **everywhere**.

It is at present not clear whether existing designations of the EU will be deemed in future to include a national GB designation, or whether there will be a need to "convert" to a national UK design.

DOCERAM – CLARITY OR CONFUSION ON FUNCTIONAL DESIGNS?

BY DAVID MUSKER



Prof. Dave Musker

The CJEU decision in the reference in Case C-395/16 *Doceram v Ceramtec* (ceramic weld-centering pins) was intended to determine how to assess whether a design is excluded as functional. Instead, it clarifies how not to do so, whilst leaving considerable leeway to the national EU courts.

The present case concerned the design of a ceramic weld-centering pin registered in 2004, in several variants, as RCD 242730-0001 to -0017 by Doceram, a German company making technical ceramics. According to their literature it “enables optimal centering of the welding nut over the sheet hole”. Doceram sued Ceramtec, a competitor, who counterclaimed for invalidation, in the District Court (LG) of Düsseldorf.

On appeal (I-20 U 124/15 (*Schweisszentrierstiften-Doceram*)) the Higher Regional Court of Düsseldorf reviewed the contradictory case law and decided to refer the issue to the Court of Justice of the EU. The European Commission and the Greek and United Kingdom Governments joined the action.

Background – the “Multiplicity of Forms” test for functional features

National and EU-level design law in Europe exclude protection for features of a design which are “solely dictated” by the technical function of the product to which the design is applied. However, the case law has been divided on the appropriate test to apply:

1. Under the former UK law, the House of Lords had held (in *Amp v Utilux*) that a design was invalid where the designer was concerned only with technical function and not with the visual appeal of the product;
2. In a trade mark case (C-299/99 *Philips v Remington*), an EU Advocate-General made an *obiter* comment that the exclusion to be applied to designs should be narrower than that used for trade marks, and that the exclusion should only apply where a design could be made only in a single shape. This is often called

the “multiplicity-of-forms” approach – where a product can be made in multiple forms, any of the corresponding designs is registrable. Some EU courts have since then followed this approach;

3. In a later design case (R 690/2007-3 *Lindner v Fransson* (Chaff Cutters)), an EUIPO Board of Appeal held that this was incorrect, and that the exclusion applied when “*aesthetic considerations are completely irrelevant*”. However, this was not to be assessed by the designer’s actual intention (in that case, the designer had – rather implausibly – given evidence that he was concerned about aesthetics) but to be assessed from the standpoint of an undefined “reasonable observer”. This judgment was often applied at EUIPO, and by some national courts;

4. The EUIPO Board of Appeal in a different constitution (R2081/2011-3, Pallet, R2869/2014-3 Flower boxes, R2098/2014-3, Saws (machines)) subsequently applied the test whether “design freedom” was absent, ignoring the question of aesthetics.

One of the criticisms made of the “multiplicity-of-forms” approach which led to its rejection at EUIPO is **that if a limited number of shapes are possible, an applicant might seek to register them all** and thus monopolise the function of the product by way of its design portfolio. In the present case, by registering 17 somewhat similar variant designs, Doceram laid themselves open to this accusation by the defendant Ceramtec.



One of the DOCERAM registrations

Defendants proposed an alternative test

Ceramtec therefore proposed that the Court should instead use the “reasonable observer” test, with that person being the “informed user” of EU case law (a non-expert), taking account of:

- the specific objective of the manufacturer at the time of design,
- advertising of the product which focuses on accentuating the design,
- whether all the conceivable alternative appearances would result in a different or lesser technical functionality,
- any distinction or particular reputation of the design among the relevant public, and
- the designer's intention on the creation of the product.

The Court's decision first deals with the need, or otherwise, for aesthetics in a design. They held that **“it is not essential for the appearance of the product in question to have an aesthetic aspect to be protected”**. That is a clear and important finding, which will require most national courts (and the EUIPO) to reconsider their approach to the benefit of applicants. However, technical considerations alone do not make a design; a design is invalid unless *“considerations of another nature, in particular those related to its visual aspect, have not played a role in the choice”*.

They then conclude that “the existence of alternative designs” – the **multiplicity of forms approach – is not decisive**, and that the analysis “does not require the perception of an ‘objective observer’ to be taken into account”.

The court or tribunal judging a design case must “take account of all the objective circumstances relevant to each individual case”. These include:

- the design at issue,
- the objective circumstances indicative of the reasons which dictated the choice of features of appearance of the product concerned,
- or information on its use,
- or the existence of alternative designs which fulfil the same technical function, provided that those circumstances, data, or information as to the existence of alternative designs are supported by reliable evidence.

Comment

Where does this restrained judgment leave applicants? Common sense suggests that consumer products (unlike the weld centring pins in this case) will almost always be chosen somewhat for their visual aspect, and will almost always have alternative shapes. See for example the Philips Air Fryer case discussed in this newsletter.

Industrial products are also often designed for visual aspect as well as function, and in ruling out the need for aesthetics, this judgment also keeps the door open for registration of such products (at least at EUIPO, where the issue is not examined before registration).

Designs which, although highly technical, succeed in the market against technically equivalent competitors because of their visual aspect should be entitled to protection.

NINTENDO V BIGBEN: AN OVER-BROAD DEFENCE FOR ACCESSORY-MAKERS

BY DAVID MUSKER

Joined Court of Justice Cases C-24/16 and C-25/16, *Nintendo v Bigben*, were referrals from the Dusseldorf district court concerning unlicensed accessories for Nintendo's famous Wii games console.

Bigben sell these in packaging indicating that they are intended to work with Wii consoles. They do so both by referring to the Wii trade mark, and by depicting genuine Wii controllers on the packaging. Nintendo sued them for infringement of their design registrations for the depicted controller.



Bigben charger for Wii controller, advertised on Amazon

It appears to have been accepted by the Court that a two-dimensional depiction of a three-dimensional design could in principle infringe. Bigben however raised a defence under Article 20(c) of the design regulation, which excuses – “acts of reproduction for the purpose of making citations or of teaching, provided that such acts are

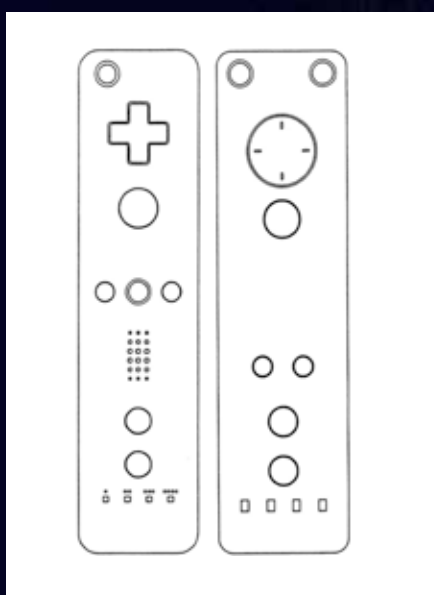
- compatible with fair trade practice, and
- do not unduly prejudice the normal exploitation of the design,
- and that mention is made of the source.”

In the English language, advertising does not sound much like “making citations”. However, in the French language, the term “illustration” is used instead of “citation”. In line with the French text, the Court took a broad view of the defence. They noted also that elsewhere in its text, the Regulation makes provision for the supply of interoperable products (e.g. accessories). On this basis, they concluded that *“a third party that lawfully sells goods intended to be used with specific goods corresponding to Community designs and reproduces the latter in order to explain or demonstrate the joint use of the goods it sells and a product corresponding to a protected design carries out an act of reproduction for the purpose of making ‘citations.’”* There was therefore a potential defence to infringement.

The Court ruled on the nature of “fair trade practice”, a necessary element of the defence

An act of reproduction of a protected design for the purpose of making citations or of teaching is not compatible with fair trade practice where:

- it is done in such a manner that it gives the impression that there is a **commercial connection** between the third party and the holder of the rights conferred by those designs, **or**
- where the party who wishes to rely on the defence is selling associated goods that are **themselves an infringement, or**
- where that third party takes **unfair advantage** of the holder’s commercial repute.



Nintendo RCDs 000483631-0001 and 000483631-0007, front views only

Comment

The Court’s interpretation is controversial, and has been criticised by several authors. In the interests of competition, the Court has handed a significant advantage to makers of unlicensed accessories – but to stay within this defence, it is clear that they must not stray into trade mark infringement or “passing off”.

As the only possible mention of source of the design (another element of the defence) was the use of Nintendo’s trade mark, the Court of Justice referred back to Dusseldorf the question “whether such a mention is in compliance with the legislation on trademarks”. In other words, the design defence does not carry with it a parallel trade mark defence.

ACACIA, AUDI AND OTHERS: A BROAD DEFENCE FOR SPARE PART MAKERS – WITH STRINGS ATTACHED

BY DR JOHN PARKIN

Joined Court of Justice Cases C-397/16 and C-435/16 *Acacia v Audi & Porsche* were referrals from Italian and German Courts concerning third-party aftermarket replica alloy wheel rims for cars, which were essentially identical to the designs registered by several major German carmakers.

Design Protection for Replacement Parts

As the European design code is not harmonised in its application to the aftermarket, a word of preliminary explanation may be useful.

Europe's national design laws were harmonised between 1998 and 2001 by Directive 98/71. At that time, the national European governments were divided, some favouring an open spare parts market and some favouring protection by design for spare parts. They could only agree to differ, and as a result, in Europe today spare parts can be protected and enforced under national design law in Germany, France, the Czech Republic, Slovakia, Romania, and the Scandinavian countries (though with a shorter lifetime in the last-named), but cannot be enforced in

the UK, Italy, Spain, Poland Hungary, and the Benelux countries, with intermediate approaches in other countries such as Greece.

As a separate matter, a Community Design system was established in 2002 by Regulation 6/2002. Here, to protect the status quo, it was agreed to introduce a temporary "repair clause", in the form of Article 110 of the Regulation, allowing the free supply of spare parts without infringement of Community designs. The intention was to replace this with a final negotiated settlement of the question within a few years.

However, the legislative proposal introduced by the EU Commission in 2004 could not be agreed by all parties and was finally withdrawn in 2014. Since that date, the major German carmakers have brought a significant number of test cases in countries across Europe (including Germany, the UK, the Netherlands, Spain and Italy) to determine the scope of the current national and EU repair provisions. In their judgement on these referrals the Court of Justice casts some light on at least the Community Design provisions of Article 110.

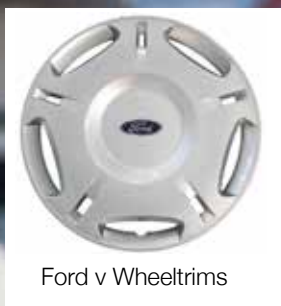
Article 110 of EU Regulation 6/2002 provides that "*a design which constitutes a component part of a complex product*" cannot be enforced against uses "*for the purpose of the repair of that complex product so as to restore its original appearance*". However, Recital 13 (which runs parallel to Article 110) applies only to designs of "*a component part of a complex product upon whose appearance the design is dependent*". This "dependency" test (i.e. spare part designs where the appearance of the part depends on the appearance of

the whole) is sometimes referred to as a "**must-match**" test, like its UK predecessor.

Several EU national courts, including the UK High Court in the 2012 case *BMW v Round & Metal*, considered that the wording in the Recital had been omitted from the Article, and should be "read back in". That would limit the scope of the defence under Article 110, excluding parts such as alloy wheels where the appearance of the part (wheel) is unrelated to that of the rest of the car.

The Court of Justice, however, considered that the legislative history indicated an intention to drop the "must match" restriction before the Regulation was finalised. They therefore declined to traverse the intention of the legislator by reading the limitation back in. As a result, the "repair clause" defence of Article 110 applies to any kind of part of a product, not merely those parts where the aftermarket supplier has no choice but to copy.

Their judgment is consistent with their longstanding preference for free



Ford v Wheeltrims



Acacia v Audi



competition over the rights of intellectual property owners, at least in related markets such as those for accessories and spare parts. So far, then, a victory for the spare part makers (though one which Pneusgardia, one of the parties, will find it difficult to enjoy as they are in insolvency).

But it is not quite that simple

There are two strings attached. The first concerns the circumstances under which the defence can be invoked. The Court make it clear that *persons relying on that derogation* must “*contribute, so far as possible, to ensuring strict compliance, particularly by the end user, with the conditions laid down in Article 110(1)*”. Thus, it is not enough merely to make or sell spare parts – “*a manufacturer or seller is ... under a duty of diligence as regards compliance by downstream users with those conditions.*”

These conditions include that “*the replacement part must have an identical visual appearance to that of the part which was originally incorporated into the complex product when it was placed on the market.*” In other words, the part must not be intended for use as an upgrade, but **only as a one-for-one repair**.

The second concerns the use of any **trade marks** which may be attached to the part concerned. One might suppose that making a replacement part with “*an identical visual appearance to that of the part which was originally incorporated*” would necessarily involve reproducing such a trade mark.

Trade Marks

In the case of C-500/14 *Ford v Wheeltrims* the Court of Justice had already ruled that the conditions in Article 110(1) “*must be interpreted as not allowing ... a manufacturer of replacement parts and accessories for motor vehicles, such as wheel covers, to affix to its products a sign identical to a trade mark registered for such products ... on the ground that the use thus made of that trade mark is the only way of repairing the vehicle concerned, restoring to that complex product its original appearance.*” Thus, copying the trade mark might well be trade mark infringement, whereas removing it might take the competitor outside the scope of the defence since the replacement part would no longer be “identical”

The Opinion of the Advocate-General in Joined Cases C-397/16 and C-435/16 *Acacia v Audi & Porsche* sought to argue that the presence or absence of a trade mark would not change the question whether the part was “identical”, but the Court of Justice declined to repeat his comment. As a practical matter, then, **branded parts may be much more difficult to replicate** in the aftermarket.

TRIPS Compatible?

The judgment begins with a citation of Article 26(2) of TRIPS, which provides that “*Members may provide limited exceptions to the protection of industrial designs, provided that such exceptions do not unreasonably conflict with the normal exploitation of protected industrial designs and do not unreasonably prejudice the legitimate interests of the owner of the protected design, taking account of the legitimate interests of third parties.*” Some writers had questioned whether a repair defence could ever be compatible with TRIPS. The answer of the Court appears to be that it can, but only where the actions of the competing spare part suppliers are channelled narrowly into the repair channel.



Dr John Parkin

Stronger protection through national design registrations

The Court of Justice decision affects only Community Designs. It will still be possible for manufacturers – and not just automakers – to protect their spare parts via the national systems of Germany, France and many other EU countries. Devising the right protection strategy calls for expertise and experience of the design systems of Europe.

“MAGNITONE™” ELECTRONIC FACIAL SKIN CARE DEVICES INFRINGE L'OREAL'S RCD

BY KATIE CAMERON

In our sister publication *Patent issues*, we discuss the patents aspects of an interesting suit brought by L'Oréal, makers of a range of range of Clarisonic™, skin cleansing brush products, against RN Ventures in relation to its competing Magnitone™ product.

L'Oréal sued for patent infringement and registered community design (RCD) infringement and won on both counts. ([2018] EWHC (Ch)) Here we review the case for design infringement, as it is an excellent case study in how the UK Patents Court assesses the scope of protection of a registered design.

The RCD infringement claim

A comparison between the L'Oréal RCD and RN Ventures' Magnitone™ products is shown below.

Mr Justice Henry Carr assessed the RCD from the perspective of the informed user, whose identity and attributes were set out in *Samsung Electronics v Apple*. In particular, unlike the average consumer of trade mark law, the informed user

- is particularly observant;
- has knowledge of the design corpus and of the design features normally included in the designs existing in the sector concerned; and neither

- merely perceives the designs as a whole and does not analyse details nor
- observes in detail minimal differences which may exist.

Henry Carr J explained that if the differences between the registered design and the pre-existing design corpus were small, then small differences might avoid infringement. However, if the differences were great, then the scope of the protection was likely to be wider, and small differences might not avoid infringement. The same logic applied to design freedom:

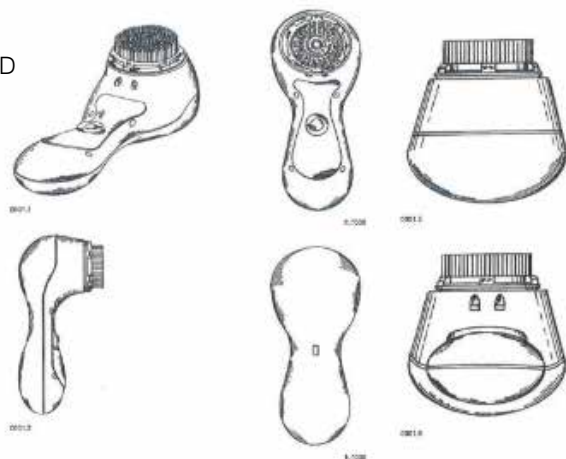
- the greater the designer's freedom, the wider the scope of the monopoly;
- conversely, the more limitations on design freedom, the narrower the scope of the monopoly.

In his view, the informed user in the present case was the “observant user of powered skin brushes”.

Although the Magnitone™ products and the RCD differed in some details, the question was one of overall impression. L'Oréal and RN Ventures presented single sheets that depicted images of products said fairly to reflect the design corpus, which was then compared with images from the RCD.

Henry Carr J accepted that all of the powered skin brushes shown overleaf were part of the design corpus (apart from a manual scrubbing brush included in RN Venture's selection, which was undated and excluded from consideration).

L'Oréal RCD



RN Ventures' Magnitone™





Katie Cameron

He confirmed that following the CJEU's decision in *Easy Sanitary*:

it is not necessary for it to be established that the informed user would know of an item of prior art for it to be considered as part of the design corpus.

As Henry Carr J noted, the design corpus showed "a variety of shapes of powered skin brushes" which, "at a high level of generality", were "cylindrical or wedge-shaped devices, with a single brush head, with elongated handles with straight or slightly waisted sides, with some form of attachment area for the brush head". In contrast, "the Design is of a sculpted shape which narrows in the middle into an hourglass with a very distinctive bulbous head with curved sides and castellations around the brush".

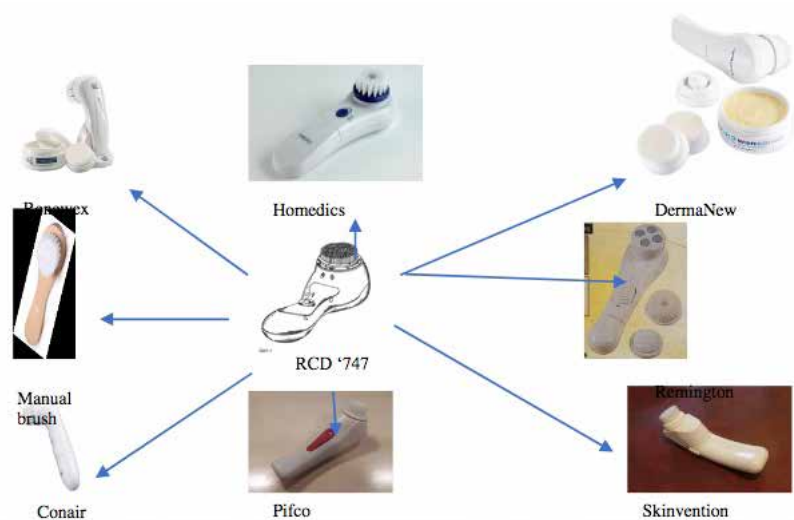
He found that the RCD was significantly different from the design corpus, and the expert evidence confirmed that there was a "wide degree of design freedom".

Following these findings, Henry Carr J reached the conclusion that each of the Magnitone™ products created the same overall impression as the RCD, and therefore infringed it.

Comment

Rights holders will find some encouragement in this finding of infringement of L'Oréal's design, as it runs against a current of recent rulings from the higher courts that have been less than sympathetic to design owners, in particular:

- Apple's iPad shape, whose registered design was found to be valid but not infringed by the Court of Appeal (*Samsung Electronics v Apple* [2012] EWCA Civ 1339);
- Procter & Gamble's Febreze™ air freshener spray shape, whose registered design was found to be valid but not infringed *Procter & Gamble v Reckitt Benckiser* [2007] EWCA Civ 936 and
- Magmatic's Trunki™ children's suitcase, whose registered design was held valid but not infringed by the Supreme Court (*PMS International Group v Magmatic* [2016] UKSC 12, reported in Summer 2016 **Design features**).



RN Ventures' design corpus comparison

HIGH COURT ISSUES GUIDANCE ON HOW TO SHORTEN DESIGN TRIALS

SPIN MASTER LTD VS PMS INTERNATIONAL GROUP

BY ANDREW VAN DEN BENT KELLEY

The High Court has outlined steps that should be taken in order to achieve shorter trials for cases concerning registered designs, following a Case Management Conference (CMC) in which the Judge expressed concern at the costs and timeframe involved.

The CMC in question concerned a claim for infringement of a Community Registered Design by the claimant, Spin Master Limited. The defendant, PMS International Group, subsequently lodged a counterclaim for unjustified threats of infringement.

Spin Master, a Canadian toy manufacturer, registered a design for their “Bunchems” product at the EUIPO in 2015. The toy, which the claimant alleged had been extremely successful and had sparked something of a craze, was named “Activity Toy of the Year” in 2016. Spin Master also added that the product was a substantial departure from the design corpus, and that the visual impact it had on the informed user was significant.

PMS produce a construction toy called “Clingabeez”, which comprises

individual balls with hook projections. The balls can be combined to create larger structures. Although the claimant argued that this toy created an identical overall impression to their registered design, the defendant pleaded that certain features were dictated by function and in respect of other features, design freedom was restricted.

According to the Judge, Mr Justice Henry Carr, both the claim and the counterclaim raised straightforward disputes that were commonplace for cases of this nature. It was noted that

the counterclaim would stand or fall based on the outcome of the original claim.

Given this, the Judge stated that both the defendant and claimant had wildly overestimated the necessary costs and time needed to complete the trial. PMS estimated that four days, including reading time, were required, while Spin Master had suggested six days were necessary.

The defendant had allocated themselves a budget of £336,000, but even this was dwarfed by the claimant's total of £776,000, a figure



Andrew Van Den Bent Kelley



the Judge branded “far too much given the simplicity of the issues.”

Henry Carr J voiced his concern that lessons had not been learned from previous registered design cases before the Court of Appeal, namely *Procter & Gamble Co v Reckitt Benckiser (UK) Limited* [2007] EWCA Civ 936; [2008] Bus LR 801 and *Dyson Ltd v Vax Ltd* [2011] EWCA Civ 1206; [2013] Bus LR 328. The key points were as follows:

1. Registered design cases are concerned with the overall impression of the registered design, the alleged infringement and the design corpus. It is easier to see this than to describe it in words.
2. Admissible evidence in such cases is very limited, and is most likely to comprise technical evidence about design constraints. Such evidence is unlikely to require substantial cross-examination. It should be possible to decide a registered design case in a few hours.
3. If permission for expert evidence is to be given, then the precise ambit of that evidence should be defined. The expert should be told what question to address and the evidence should be confined to those questions.
4. It is clear law that whether the defendant has copied is irrelevant. It is equally irrelevant for the defendant to prove or to give disclosure about how their design was arrived at.

Henry Carr J went on to add that although he appreciated the parties’ desire to have their say and recognised that completing a trial in a few hours would not give either side enough time to present their arguments, it was important to respect the needs of other users of the court. He stated that “there is no reason why registered designs cases should last for days, when one understands what really matters.”

Henry Carr J concluded his judgment by outlining eight key steps that should be undertaken in order to achieve shorter trials:

1. The parties should, in appropriate cases, produce images at an early stage to show the differences or similarities upon which they rely, and in the case of the defendant, those features which are wholly functional or in which design freedom is said to be limited. Requests for further information are unlikely to be helpful.
2. Claimants should not try to introduce or seek disclosure in relation to copying. The parties should carefully consider why, if at all, disclosure is necessary, rather than agreeing to standard or even issue based disclosure.
3. Expert evidence as to whether the alleged infringement produces on the informed user the same or a different overall impression as the registered design should not be included in cases concerning consumer products.
4. The parties should try to limit the length of expert evidence to an agreed number of pages.
5. If any evidence of fact is to be introduced, the court will need to be satisfied of its relevance.
6. The parties should be prepared at the pre-trial review to identify issues on which cross-examination is necessary, and to explain why.
7. Where multiple designs, or multiple infringements, are alleged, the parties should each select a limited number of samples on which the issues can be tested.
8. The parties should give careful thought to those issues which can be postponed to a damages enquiry, which will only need to be considered if liability is established.

SUCKER BLOW FOR THREAD LIFTER

CASE T-174/16 *WESSEL-WERK V EUIPO & WOLF*

BY HUGH DUNLOP

Registered Community Design No. 725932-0004

We report on a design battle between two competing manufacturers and suppliers of vacuum cleaner accessories in Germany. The dispute initiated in the EUIPO over a simple design for a “thread lifter” element of a vacuum cleaner nozzle and was elevated to the Court of First Instance of the CJEU when the registration was revoked by the Office.

We select this case to illustrate the limits of scope for registration of product parts that are largely (but not necessarily “solely”) dictated by function.

On 18 May 2007 Wessel-Werk GmbH, registered a Community Design for a “Suction nozzle for vacuum cleaner”. The design was published on 18 May 2007.

On 15 November 2013, Wolf PVG GmbH applied for annulment of the design, on grounds, *inter alia* that it lacked novelty *vis-à-vis* earlier Community design No. 493945-0002.

By decision of 19 June 2014, the Cancellation Division dismissed all the grounds for invalidity and Wessel-Werk appealed to the EUIPO Board of Appeal. Two years later (18 February 2016), the Third Board of Appeal of EUIPO upheld the appeal and declared the Design to be void.

CFI dismisses appeal

Wessel-Werk appealed with the EUIPO as defendant and Wolf as an intervener. The Court of First Instance dismissed the appeal and upheld the annulment of the registration.

The term “informed” implies that the user, without being a creator or a technical expert, knows various designs that exist in the economic sector concerned, that he has some knowledge of the elements that these designs usually have, and that he uses these products with considerable attention. The peculiarity of a design derives from an overall impression of the difference or a lack of *déjà vu* from the point of view of the informed user in relation to anything that has gone before.

The informed user:

- does not take into account differences that are not sufficiently pronounced to have an effect on this overall impression into account even if they go beyond insignificant details but
- does take into account those differences which are sufficiently pronounced to give rise to dissimilar overall impressions.

In assessing the overall impression that a design has on the informed user, it is necessary to consider the way in which the product represented by the design is used.

The informed user would have considered that the thread lifter covered by the design was part of a vacuum cleaner. He did not isolate the thread lifter. He attributed only minor significance to it.

By decision of 14 March 2017 the CFI found that there was no different overall impression. According to the Court, the Board had conducted that assessment without error and the annulment should be upheld.

Decision of the Board of Appeal of the EUIPO

The informed user was a person who uses vacuum cleaners, and not a designer or technical expert. That person is aware that these products usually have a thread lifter.

The degree of design freedom of the designer of the thread lifter is somewhat limited. The dimensions must suit the nozzle and it must be made of a material suitable for picking up threads and fibers and give sufficient traction.

There were no restrictions on colour, but difference between the brown color of the registered design and the red color of the older design did not create a different overall impression to the informed user.



Prior Registered Community Design No. 493945-0002

“DICTATED BY TECHNICAL CHARACTER” DEFENCE FAILS BEFORE COURT IN BRUSSELS

BY HUGH DUNLOP



Hugh Dunlop

Before the CJEU gave its ruling in *Doceram v Ceramtech*, the Brussels commercial court was faced with an invalidity defence based on Article 8(1) CDR (“solely dictated by technical character”) in relation to assertion by Koninklijke Philips of design rights relevant to its Airfryer™ product (shown on the left) against the marketing of a competitor product (shown on the right). (Case reference A/17/0079)



Decision

The court dismissed the invalidity counterclaim.

It is up to the defendant to prove that a feature is solely dictated by its function and in this case the defendant failed to meet that burden of proof.

The defendant made reference to a patent for the internal technical structure of the Philips product and argued that the external shape was dictated by the internal technical structure.

The court found that, although heat circulation and other technical factors played a role, the external design did not coincide with the internal structure and Philips enjoyed a substantial degree of freedom in the developing of the design.

Nothing in the later CJEU decision would have changed this finding, because the Brussels court held that the determining factors in the Philips designs were aesthetic considerations.

Out and about - external event attendance

Who	Details	When
Katie Cameron, Tim Pendered, Felix Rummler, Kana Enomoto, Handong Ran, Dr. Kei Enomoto, Nicole Ockl, Tim Young	INTA, Seattle, Washington	19 – 23 May
Dr. Fiona Kellas	BIODundee International Conference, Dundee, Scotland	22 – 23 May
Reuben Jacob, Dr. Fiona Kellas, Dr. Edward Rainsford	BIO International Convention 2018, Boston, USA	4 – 7 June
Trade Mark Team	ECTA 37th Annual Conference, Athens, Greece	13 – 16 June
Handong Ran, Alec Clelland, Dr. Edward Rainsford	China Patent Annual Conference (CPAC), Beijing	30 – 31 August
Joanne Ling	MARQUES 32nd Annual Conference, Paris	18 – 21 September
Reuben Jacob, Phil Treeby	AIPPI World Congress, Cancun, Mexico	23 – 26 September
Katie Cameron, Kana Enomoto	PTMG Autumn Conference, Dubrovnik, Croatia	3 – 6 October
Nicole Ockl	ECTA 76th Autumn Council and Committee Meetings, Geneva, Switzerland	18 – 20 October
Maucher Jenkins Team	AIPLA Annual Meeting, Washington, USA	25 – 27 October
Reuben Jacob, Dr. Fiona Kellas, Dr. Edward Rainsford	MEDICA Düsseldorf, Germany	12 – 15 November
Phil Treeby, Dr. Kei Enomoto	APAA, New Delhi, India	17 – 21 November

Maucher Jenkins hosted events

Dr. Cornelius, Mertzluft-Paufler, Johannes Lange	Free consultation for inventors, IHK Südlicher Oberrhein in Lahr, Germany	17 May 19 July
Dr. Cornelius, Mertzluft-Paufler	IP Showcase, Basel, Switzerland	4 June
Dr. Cornelius, Mertzluft-Paufler, Dr. Manuel Kunst, Henrich Börjes-Pestalozza,	Free consultation for inventors, IHK Südlicher Oberrhein in Freiburg	2 August 6 September 4 October
Felix Rummler, Kana Enomoto, Sascha Zieglmeier, Nicole Ockl, Georg Messerle	IP Day, Munich, Germany	October (TBC)

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