

10th GRUR meets Brussels Workshop

The Future of Intellectual Property in the EU – Ideas from Academia

EU Design Practice
Considerations of a Practitioner

Christian Spintig
Brussels, 5 December 2019

Inconsistency of views

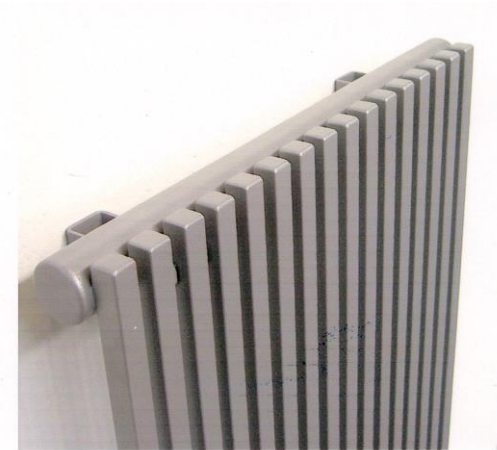
■ The status quo in respect of registered Community designs (RCDs)

- EUIPO § 5.2 Design Ex. Guidelines: Where the views are inconsistent and relate to more than one design, the applicant will be invited either to withdraw some views or to convert the application into a multiple application for different designs, and pay the corresponding fees.
- If a given inconsistency is overlooked by the examiner, and the application proceeds to registration, the question is whether third parties may successfully file an invalidity application based on Article 25(1)(a) CDR because the design does not correspond to the definition under Article 3(a) CDR (“.... *the whole or a part of **a** product...*”).

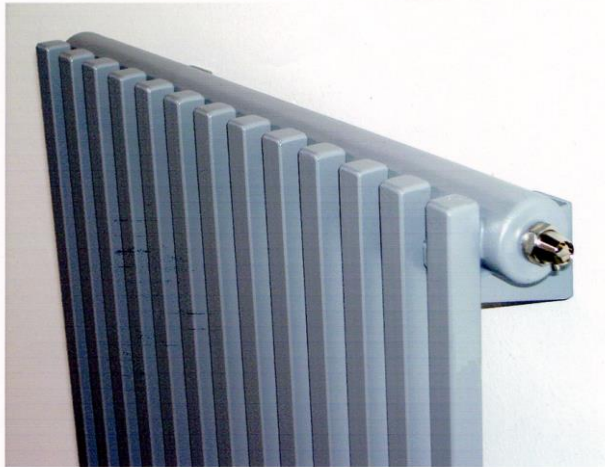
Inconsistency of views

■ Examples I

- RCD registration No. 002124511-0005 (radiators for heating):



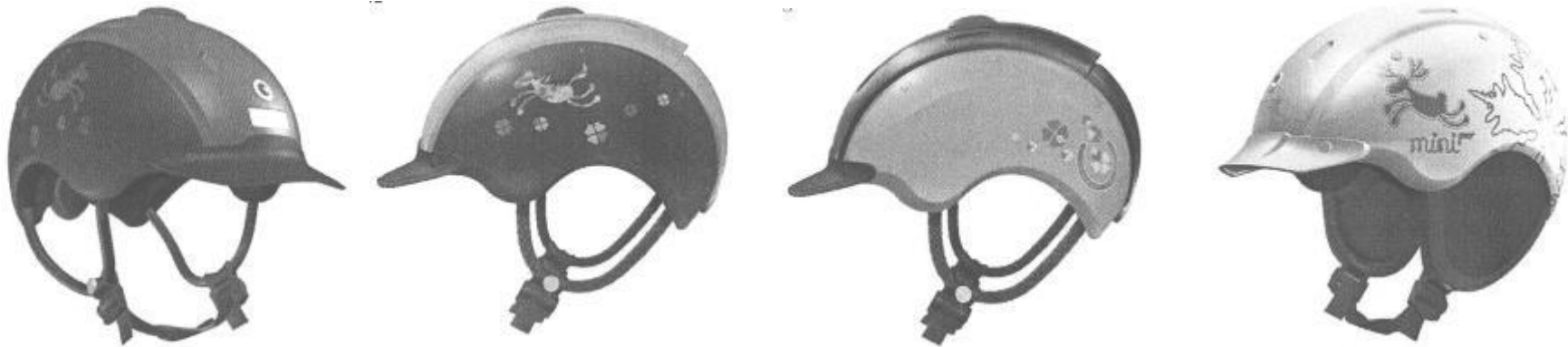
(13 v 16 pipes)



Inconsistency of views

■ Examples II

- German registered design No. 402008001032-0001 (Sports helmets), 4 of 7 views:



- German registered design No. 402008001031-0001 (Sports glasses), 5 views:



Inconsistency of views

■ Case-law I

- EUIPO BoA (07/03/2007, R 592/2007-3, *Radiators for Heating*): Decision to invalidate the RCD lifted as the Invalidity Division had, in the opinion of the Board, committed a clear error, confusing the concept of Design (Article 3 CDR) with the figure of multiple applications (Article 37 CDR). The element “a” in the expression “the appearance (...) of a product” is, according to the Board, an indeterminate article and not, as the Invalidity Division had found, (also) a numerical adjective. Consequence: The RCD holder may request a correction (Article 39 CDIR).
- EUIPO BoA, 03/12/2013, R 1332/2013-3, *Adapters*, §§ 14 et seq.): It is the applicant’s responsibility to submit a correct and complete application (including representations of the design). The Office is not entitled to remedy any deficiencies in respect of incongruent views once the Community design is registered and published. If an examiner overlooks a discrepancy, the applicant’s omission does not transform into an error to be attributed to the Office within the meaning of Article 20 CDIR.

Inconsistency of views

■ Case-law II

- CJ (05/07/2018, C-217/17P, Mast-Jägermeister SE v EUIPO, Beakers):

(52) (...), the function of the graphic representation requirement is, in particular, to define the design itself in order to determine the precise subject of the protection afforded by the registered design to its proprietor (...)

(53) In that regard, it should be noted that the entry of a design in a public register has the aim of making it accessible to the competent authorities and the public, particularly to economic operators. On the one hand, the competent authorities must know with clarity and precision the nature of the constituent elements of a design in order to be able to fulfil their obligations in relation to the prior examination of applications for registration and to the publication and maintenance of an appropriate and precise register of designs (...). (54) On the other hand, economic operators must be able to acquaint themselves, with clarity and precision, with registrations or applications for registration made by their current or potential competitors and thus to obtain relevant information about the rights of third parties (...). Such a requirement (...) is intended to ensure legal certainty for third parties.

- German Bundesgerichtshof (BGH – Federal Supreme Court, 20/12/2018, I ZB 25/18 and 26/18, *Sports Helmets and Sports Glasses*): Designs **invalid** according to national provision implementing Article 1(a) Design Directive (~ Article 3(a) CDR).

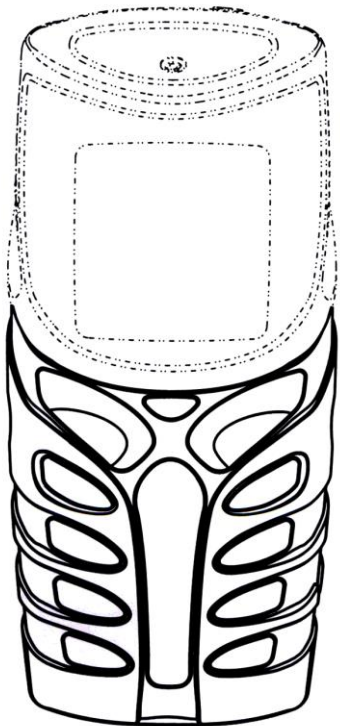
Inconsistency of views

■ Conclusions

- Based on recent case-law and EUIPO Practice, an inconsistent RCD registration is at risk of being invalidated on the basis of Article 25(1)(a) CDR.
- Once registered and published, the RCD holder cannot escape from invalidation by requesting a correction.
- It is therefore extremely important to have RCD applications double-checked on examination, so careful examination by the EUIPO is of essence.
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Practitioner's Wish List (1/3)

■ Use of non-continuous lines (broken, dashed or dotted lines)



RCD No. 000030606-0005

- EUIPO § 5.3 Design Ex. Guidelines: In accordance with the Common Practice (CP6), visual disclaimers indicate that protection is not being sought, and registration has not been granted, for certain features of the design shown in the representation. Thus, they indicate what is not intended to be protected. Broken lines consist of a trace made up of dots or dashes (or a combination of both), and are used to indicate that no protection is sought for features shown using the interrupted trace.
- Rules are not binding for national offices and Courts; EU position is extremely unclear and divergent.
- Legal Review on industrial design protection in Europe (MARKT2014/083/D) (Design Study) : Recommendation that national offices and the EUIPO employ the Convergence Programme to agree on the exact meaning of non-continuous lines, and that the convergence exercise is extended to judicial practices being harmonised where judges sit in designated Community design courts.

Practitioner's Wish List (2/3)

■ Animated designs and graphical user interfaces (GUIs)



RCD No. 004530640-0026

- Article 4(2) CDIR: Maximum of seven different views.
- EUIPO § 3.3.1 Design Ex. Guidelines: 3D computer-animated design generating motion simulation are only considered as an additional technical means of viewing the design and does not replace conventional static views.
- Design Study: Recommendation to allow higher/unlimited number of representations.
- Status?

Practitioner's Wish List (3/3)

■ Extension of EUIPO's online tools

- Full access to RCD files (as is applied in respect of EUTMs)
- Use of online tool for design invalidity proceedings

Thank you!

www.heuking.de

Berlin

Unter den Linden 10
10117 Berlin/Germany
T +49 30 88 00 97-0
F +49 30 88 00 97-99

Cologne

Magnusstrasse 13
50672 Cologne/Germany
T +49 221 20 52-0
F +49 221 20 52-1

Frankfurt

Goetheplatz 5-7
60313 Frankfurt a. M./Germany
T +49 69 975 61-415
F +49 69 975 61-200

Munich

Prinzregentenstrasse 48
80538 Munich/Germany
T +49 89 540 31-0
F +49 89 540 31-540

Brussels

Rue Froissart 95
1040 Brussels/Belgium
T +32 2 646 20-00
F +32 2 646 20-40

Chemnitz

Weststrasse 16
09112 Chemnitz/Germany
T +49 371 38 203-0
F +49 371 38 203-100

Düsseldorf

Georg-Glock-Straße 4
40474 Düsseldorf/Germany
T +49 211 600 55-00
F +49 211 600 55-050

Hamburg

Neuer Wall 63
20354 Hamburg/Germany
T +49 40 35 52 80-0
F +49 40 35 52 80-80

Stuttgart

Augustenstrasse 1
70178 Stuttgart/Germany
T +49 711 22 04 579-0
F +49 711 22 04 579-44

Zurich

Bahnhofstrasse 3
8001 Zurich/Switzerland
T +41 44 200 71-00
F +41 44 200 71-01