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Comments of the GRUR Committee for Design Law on the request for a Preliminary Ruling in Case C-323/24 – Deity Shoes, S.L. v Mundorama Confort, S.L. and Stay Design, S.L.¹

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A. FACTS OF THE CASE

- [1] Deity Shoes S.L. (“Deity”) brought actions for infringement of both registered and unregistered Community designs for various models of shoes against Mundorama Confort S.L. (“Mundorama”) and Stay Design S.L. (“Stay”) before the Juzgado de lo Mercantil Número 1 de Alicante, Spain (“referring court”).
- [2] Mundorama and Stay are, for certain models, relying on the right of prior use pursuant to Article 22 (1) Council Regulation (EC) No 6/2002 of 12 December

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2001 (Community Designs Regulation “CDR”), and, with regard to the points relevant in the present case, by way of counterclaims seeking declarations of invalidity of the Deity models on the ground of lack of novelty and individual character.

[3] The parties operate in the same sector in the marketing of footwear, and they both purchase footwear in China.

[4] The Deity models are customized models based on the models offered by the Chinese trading undertakings through their catalogues.

[5] The process of production of the respective products has been described as follows:

(i) the parties’ suppliers are trading undertakings located entirely in China, and they cover for them the entire operation of production and exportation of the products;

(ii) the Chinese trading undertakings transfer to the relevant staff of the parties – usually sales and marketing staff – various product sample books;

(iii) the staff members concerned analyse the products in the sample books and propose to the suppliers specific modifications of their features (such as colour, some materials, the location of the buckles, laces and other decorative elements);

(iv) once the characteristics of the final product have been agreed on, the Chinese trading undertakings produce the goods in China and send them to Spain together with the appropriate certificates detailing the process of customization of the footwear.

[6] In case of the Deity models, no certificates of customization have been produced to enable the referring court to determine what changes have been made by Deity to each of the models.

[7] It has not been established that Deity has a design team or that the designs that it claims to have been infringed have been the subject of genuine design activity.

[8] Besides these facts of the case, the referring court submits the following own conclusions and additional facts:

[9] The described design process leads to the conclusion that the features of appearance of the Deity’s shoe models are mostly predetermined by the model

offered by the Chinese trading undertakings, with the effect that modifications of certain elements must be considered ad hoc and incidental (such as, for example, colour, some materials, the location of buckles, laces, and other decorative elements).

[10] Price is a very important factor in that sector and any change to the basic model, involving greater customization, leads to an increase in costs that reduces the margins of the European marketing undertakings.

[11] There is therefore no real incentive to make substantial changes to the basic models offered by the Chinese trading undertakings.

[12] Changes to specific elements such as colour, some materials, the sole, the location of the buckles, laces and other decorative elements are also shown in the catalogue offered by the Chinese trading undertaking.

[13] Lastly, the registered designs and unregistered designs do not have any fashion component at all.

[14] In fact, they are inspired by known fashion trends that make it possible to secure the sale of the large orders placed with factories in China.

[15] In that respect, it may be understood that, in a sector in which the main factors to be taken into account are volume and price, the designer's degree of freedom is limited in comparison with other types of footwear with a fashion component that lasts several seasons, since there is no investment in innovation.

[16] The models in question must therefore reproduce aesthetic trends that are well known in the world of fashion; they are mass-produced by the Chinese trading undertakings at low cost for subsequent marketing on the EU market.

B. QUESTIONS REFERRED FOR A PRELIMINARY RULING

[17] The referring Court referred the following questions to the Court of Justice of the European Union ("CJEU") pursuant to Article 267 TFEU for a preliminary ruling:

[18] The first question is as follows:

In order for a design to be covered by the system of protection under Council Regulation (EC) No 6/2002 of 12 December 2001, is it necessary for there to be a genuine design activity in such a way that the

design is the result of the intellectual effort of its creator? And, in that regard, may a combination of components on the basis of models whose features of appearance are for the most part predetermined by the trading undertakings, with the effect that modifications to certain features are to be regarded as ad hoc and incidental, be regarded as a genuine design activity?

[19] The second question is as follows:

In the light of the foregoing, may all or some of the feature[s] of appearance of a product resulting from the customization of designs that are offered by Chinese trading undertakings, in accordance with those undertakings' catalogues, be regarded as having individual character within the meaning of Article 6 [of] Council Regulation (EC) No 6/2002 of 12 December 2001, where the activity of the owner of the design is limited to marketing those designs in the EEA without modification or with specific modifications of components (such as soles, rivets, laces, buckles and so forth) and the features of appearance are predetermined for the most part by the trading undertakings? In that regard, is it relevant that the components are not designed by the European marketing undertaking either, but are components offered by the trading undertaking itself in its catalogue?

[20] The third question is as follows:

Must Article 14 [of] Council Regulation (EC) No 6/2002 of 12 December 2001 be interpreted as meaning that a person may be regarded as the designer in relation to a design where, on the basis of a design offered by trading undertakings in accordance with a catalogue, he or she has merely customized that prior design by modifying components also offered by the trader, and those components have not been designed by the European marketing undertaking? In that regard, is it necessary to prove a specified degree of customization in order to demonstrate that the final form departs significantly from the original design and thus that authorship may be claimed?

[21] The fourth question is as follows:

Without prejudice to the foregoing, in a case such as the present case, in view of the particular characteristics of footwear designed on the basis of trading operators' sample books and, in so far as the 'design' is limited to selecting existing designs from a sample book and, where

appropriate, to varying some of their components, from those in the catalogue which the manufacturer itself (the trading undertaking) offers, all in accordance with fashion trends, must it be understood that those fashion trends: (a) restrict the designer's freedom in such a way that minor differences between the registered (or unregistered) design and another model are sufficient to give a different overall impression or, conversely, (b) detract from the individual character of the registered (or unregistered) design with the effect that those elements or components are of less importance in the overall impression they produce on the informed user in so far as they result from known fashion trends when compared with another model?

C. THE APPLICABLE LAW

- [22] Article 3 (a) CDR provides that, for the purpose of Regulation No 6/2002, "design" means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.
- [23] Article 3 (b) CDR provides that "product" means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;
- [24] Article 4 (1) CDR provides that a design shall be protected by a Community design to the extent that it is new and has individual character.
- [25] Article 5 (1) CDR provides that a design shall be considered to be new if no identical design has been made available to the public:
- a) in the case of an unregistered Community design, before the date on which the design for which protection is claimed has first been made available to the public;
 - b) in the case of a registered Community design, before the date of filing of the application for registration of the design for which protection is claimed, or, if priority is claimed, the date of priority.
- [26] Article 5 (2) CDR provides that designs shall be deemed to be identical if their features differ only in immaterial details.

- [27] Article 6 (1) CDR provides that a design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public:
- a) in the case of an unregistered Community design, before the date on which the design for which protection is claimed has first been made available to the public;
 - b) in the case of a registered Community design, before the date of filing the application for registration or, if a priority is claimed, the date of priority.
- [28] Article 6 (2) CDR provides that in assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.
- [29] According to Article 14 (1) CDR, the right to the Community design shall vest in the designer or his successor in title.
- [30] Article 14 (2) CDR provides that if two or more persons have jointly developed a design, the right to the Community design shall vest in them jointly.
- [31] According to Article 14 (3) CDR, where a design is developed by an employee in the execution of his duties or following the instructions given by his employer, the right to the Community design shall vest in the employer, unless otherwise agreed or specified under national law.
- [32] Article 25 (1) CDR provides that a Community design may be declared invalid in the following cases:
- a) if the design does not correspond to the definition under Article 3(a);
 - b) if it does not fulfil the requirements of Articles 4 to 9;
 - c) if, by virtue of a court decision, the right holder is not entitled to the Community design under Article 14;
- [33] According to Article 25 (2) CDR, the ground provided for in paragraph (1)(c) may be invoked solely by the person who is entitled to the Community design under Article 14.

D. THE REFERRING COURT'S AND THE PARTIES' OPINIONS

[34] The referring court does not disclose its own opinion regarding the issues raised. However, the Court summarizes the parties' opinion as follows:

I. Deity

[35] As regards the first question, Deity points out, that, where a design is considered to comply with the requirements of novelty and individual character, it cannot be denied that there is an 'intellectual effort' or a 'genuine design activity' behind it.

[36] Deity suggests that the question be rephrased as follows:

"Does Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs require a designer, in order to benefit from the protection it confers, to make an intellectual effort additional to that of configuring the appearance of the whole or a part of a product, resulting from the specific features relating, in particular, to the lines, configuration, colour, shape, texture and/or materials of the product itself or of its decoration?"

[37] As regards the second question, Deity states that it is irrelevant that the modifications are made using options 'from those in the trading undertaking's own catalogue'.

[38] Deity further states that it is a well-known fact that footwear components are designed and manufactured by the ancillary component industry and are rarely sold on an exclusive basis.

[39] In order to answer the question, the type and number of components offered by the hypothetical trading undertaking must be taken into account, as well as the possibility for the designer to incorporate third-party components, as no manufacturer or supplier of footwear components has an unlimited catalogue, nor does the catalogue limit the options available to the designer to incorporate third-party components.

[40] Moreover, it should be borne in mind that a limited catalogue of components may give rise to an infinite number of theoretical possibilities, just as combinations of 27 letters make it possible to form all the words in the Spanish language.

[41] Deity therefore submits that there is no need to refer the second question for a preliminary ruling.

- [42] As regards the third question, Deity argues that as regards the requirement for a specified degree of 'customization', the RCD already provides that the condition to be fulfilled by a combination of features or components is that the combination of components must be new, that is to say, must not have previously been made public, and that it must have an individual character, that is to say, the overall impression produced by the design on informed users must differ from the overall impression produced by any other design which has been made available to the public.
- [43] In that respect, it is unclear why the case of an undertaking that obtains its supplies from a Chinese trading undertaking should be treated differently from any other design which combines isolated components or features of known designs, whether or not they are in a catalogue, from China or any other country, or which otherwise form part of the portfolio of standard shapes.
- [44] As regards the final question referred, Deity submits that the fact that the design is obtained by combining different components included by an undertaking in its catalogue does not restrict the designer's freedom; the designer may seek an overall impression that differs from the overall impression produced by any other footwear model that has been made available to the public, either by seeking a different combination of components, which is new and has an individual character, or by modifying one of those components.
- [45] In Deity's opinion that is the case for all footwear designers.

II. Mundorama and Stay

- [46] As regards the first question, Mundorama and Stay maintain that it is indeed necessary to refer that question for a preliminary ruling in so far as the substance of the question is whether the RCD has the flexibility to allow access to protection for any designs, irrespective of whether or not they are the result of a prior creative process constituting a 'genuine design activity'.
- [47] They recognise, that Articles 4 (1) and 25 (1) (b) CDR have nothing to say regarding the creative process and that the wording of the regulation itself does not seem to require a creative process.
- [48] However, in their view, such a requirement cannot be ruled out on the basis of textual interpretation.
- [49] Mundorama and Stay submit that the first question should be:

“Does Regulation (EC) No 6/2002 require that a design, in order to fall within the scope of the protection conferred by the regulation on both registered and unregistered designs, must be the result of the intellectual effort of its designer and not a product that is developed on the basis of known trends with minor modifications taken from the Chinese trading undertaking’s own catalogue, and with no fashion component?”

[50] With regard to the second question, Mundorama and Stay argue that the substance of that question, which is closely linked to the first, is to be found in the question whether (i) the RCD has the flexibility to allow access to protection for any designs that have (or have not) undergone mere ‘customization’ of their components; and (ii) it is relevant that those components are also not the result of ‘a genuine design activity’ but are offered by Chinese trading undertakings to all operators in the sector.

[51] In that respect, Mundorama and Stay argue that the second question should be rephrased as follows:

“For the purposes of protecting the appearance of all or part of a product under Regulation (EC) No 6/2002 on Community designs, is it relevant that none of its components is the result of the intellectual effort of its creator, but the components are offered in a supplier’s catalogue where the catalogue is not offered exclusively to an undertaking but is offered to all operators in the sector? Or, on the other hand, is it relevant, for the purposes of protecting the appearance of all or part of a product under Regulation (EC) No 6/2002, that the applicant for or holder of protection, on the basis of a prior design offered by suppliers, merely customised that prior design by modifying components also offered by the supplier in its catalogue to the various operators in the sector?”

[52] As regards the third question, Mundorama and Stay consider that it should be rephrased as follows:

“Is Article 14 of the regulation to be interpreted as meaning that a person who, on the basis of a prior design offered by Chinese trading undertakings, has merely customised that prior design by modifying components also offered by the Chinese trading undertaking that have not been designed by the European marketing undertaking, may be regarded as the owner of the design? In that regard, is it necessary to prove a specified degree of customisation in order to be able to claim ownership of the design?”

[53] As regards the fourth question, the defendants essentially agree with the content of the question referred.

III. The Referring Court

[54] The referring court asks the Court of Justice about the “scope of protection” of Community designs and ownership of designs in the case of footwear undertakings that have merely chosen between various options offered by a trading undertaking’s catalogue, where the features of appearance are largely predetermined by the model offered by the Chinese trading undertaking, with the effect that modifications of certain elements must be regarded as ad hoc and ancillary. However, none of the four questions relates to Article 10 CDR.

[55] By the first question, the Court of Justice is asked what the requirements are for a “design” to exist, and, in particular, whether the analysis must be limited to the elements of novelty and individual character or whether there are additional requirements in order for the designer to be able to claim ownership.

[56] Specifically, the question is whether there is an implicit requirement in EU law concerning the need for “genuine design activity”.

[57] That is to say, whether it is necessary, in order for a design to be covered by the system of protection under the CDR, for there to be a genuine design activity, and that the design is therefore required to be the result of the intellectual effort of its creator and not a product that is developed on the basis of known fashion trends?

[58] The referring court considers that it is necessary to determine whether protection may be accorded to the appearance of all or part of a product that is the result of the customization of designs offered by Chinese trading undertakings in accordance with those undertakings’ catalogues, where the activity of the owner of the design is limited to marketing those designs in the EEA without modifications or with modifications of components (such as soles, rivets, laces, buckles and so forth) based on options in the catalogue offered by the trading undertaking.

[59] In that regard, it asks whether it is relevant that none of the components is genuinely designed by the undertaking marketing the final product but the components are offered by the Chinese trading undertaking in the catalogue, where the catalogue is not offered exclusively to one undertaking but is offered to all operators in the sector.

- [60] With regard to the second question, the Court of Justice is asked about the concept of ‘individual character’ in a case such as the present one, where the design is based on a model offered in a Chinese trading undertaking’s catalogue, which not only follows general and well-known fashion trends but is the result of the ad hoc alteration of components also offered in a catalogue by trading undertakings, without a fashion component.
- [61] In models of that type, the fact that inspiration is taken from known fashion trends is relevant, as that is what makes it possible to secure the sale of large volumes of orders.
- [62] In products of that type, it seems that the differential element is not the design but the price of the product, as that is what makes orders and subsequent marketing profitable.
- [63] By its third question, the referring court asks about the concept of ‘designer’ such that, in the event of a dispute as to the existence of a design, the owner of the design must prove the existence of a specified degree of customization in order to be able to claim authorship.
- [64] By its fourth question, the referring court reproduces the case-law of the Spanish Supreme Court set out in the judgment of Civil Section 1 of 25 June 2014, STS 2804/2014 – ECLI:ES:TS:2014:2804, and asks whether, given the particular characteristics of the footwear described in the terms set out in the fourth question, which follows fashion trends, those fashion trends should be regarded as (a) restricting the designer’s freedom in such a way that minor differences are sufficient to give a different overall impression or, conversely, (b) detracting from the distinctiveness of the design with the effect that those elements or components are of less importance in the overall impression they produce on the informed user in so far as they result from known fashion trends.

E. THE GRUR COMMITTEE’S OPINION ON THE FIRST QUESTION REFERRED FOR A PRELIMINARY RULING

- [65] With its first question, the referring court wants to know whether a design, to be covered by the system of protection under the Community Designs Regulation, requires a genuine design activity in the sense of an intellectual effort of its creator. More precisely, the referring court asks, whether the analysis must be limited to the requirements of novelty and individual character ac-

ording to Article 4 (1) CDR or whether there is an additional implicit requirement, namely a genuine design activity.

- [66] The referring court considers that it is necessary to determine whether protection may be accorded to the appearance of a product that is the result of the customization of designs offered by Chinese trading undertakings in accordance with the catalogues of those undertakings, where the activity of the owner of the design is limited to marketing those designs in the EEA without modifications or with modifications of components (such as soles, rivets, laces, buckles and so forth) based on options in the catalogue offered by the trading undertaking.
- [67] In that regard, the referring court asks whether it is relevant that none of the components is genuinely designed by the undertaking marketing the final product, but the components are offered by the Chinese trading undertaking in the catalogue, where the catalogue is not offered exclusively to one undertaking but is offered to all operators in the sector.
- [68] The GRUR Committee's opinion is that the requirements for design protection are, conclusively, laid down in Article 4 (1) CDR. Neither Article 4 (1) CDR, nor any other provision applicable in connection with the protection requirements of a Community design impose or allow the – explicit or implicit – requirement of a genuine design activity.
- [69] The protection requirements of a Community design are laid down in Title II (The Law relating to designs), Section 1 (Requirements for protection). Within this section, Article 4 (1) CDR particularly defines the protection requirements for a Community design, whereas Article 3 (a) and (b) CDR stipulate definitions of the basic requirements "design" and "product".
- [70] Pursuant to Article 4 (1) CDR, a design shall be protected by a Community design to the extent that it is new (novelty requirement) and has individual character (individual character requirement). The novelty requirement is met according to Article 5 (1) CDR if no identical design has been made available to the public prior to the registration or priority date of a registered Community design, or the publication date of an unregistered Community design, respectively (so-called prior designs). According to Article 6 (1) CDR a design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any prior design.

- [71] Thus, both the novelty requirement (Article 5 (1) CDR) as well as the individual character requirement (Article 6 (1) CDR) apply an objective comparison of the appearance of the design seeking protection on the one hand with the appearance of the prior designs on the other hand, irrespective of the design process and irrespective of the design activity of the rights holder. In other words: The comparison is based exclusively on the design results, not on the design development process.
- [72] The same follows from the general definition of a “design” in Article 3 (a) CDR. Pursuant to that provision, a “design” means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation. This definition, likewise, imposes an objective assessment based on the “visual impression” of the product design, again irrespective of the process of the development of the design leading to this “visual impression”.
- [73] The definition of a “product” provided in Article 3 (b) CDR, comprising any industrial or handicraft item, does not require or mention any relevance as to the design development process either.
- [74] Likewise, none of the other provisions included in Section 1 (“Requirements for protection”) of Title II (“The Law relating to designs”) give rise to the assumption that the design development process should be of any relevance in determining whether a design fulfils the protection requirements of a Community design. This objective and result-oriented assessment of designs reflects the difference between design protection on the one hand and copyright protection on the other hand, the latter explicitly requiring a personal intellectual creation.
- [75] This issue has also already been considered during the legislative process for design protection in the European Union. In the Green book, the Commission explicitly stated (in Para. 5.6.1.4.) that while a design to be eligible for protection must be the result of human activity, no such requirement has been included in the Regulation to avoid introducing a “condition of “subjective novelty”, which would inevitably clash with the “objective” requirement of distinctive character.”
- [76] Thus, in accordance with the objective and result-oriented assessment standard following from Article 4 (1), in connection with Article 5 (1), Article 6 (1) and Article 3 (a), (b) CDR, a Community design does not require for its protection any “genuine design activity” of the designer.

- [77] This means the following for the situations described by the referring court:
- [78] *First*, a design developed on the basis of known fashion trends needs to create a different overall impression from that of any prior design, in order to be protectable. If this requirement is met, it is irrelevant if the design is developed on the basis of known fashion trends.
- [79] *Second*, a design which is a combination of (modified or unmodified) components designed and offered by a third party in a catalogue, the catalogue not being offered exclusively to one undertaking but to all operators in the sector, must create a different overall impression from that of any prior design, in order to be protected. If this requirement is met, it is irrelevant if a design was developed as a result of combined (modified and unmodified) components. Finally, even banal designs or customized designs with or without modifications, whether or not the result of intellectual efforts – can be protected by way of a Community design, as long as they meet the requirement of producing a different overall impression from that of any prior design.
- [80] However, if a Community design that does not meet the requirements laid down in Articles 4 (1), 5 (1), 6 (1) CDR or does not correspond to the definition under Article 3 (a) CDR, may be declared invalid pursuant to Article 25 CDR.
- [81] In conclusion, the GRUR Committee is of the opinion that the first question raised by the referring court should be answered as follows:

“Protection of a design, under Council Regulation (EC) No 6/2002 of 12 December 2001, does not require any genuine design activity in such a way that the design is the result of an intellectual effort of its designer. Therefore, it is irrelevant whether the specific design results from the combination of features of appearance based on previous designs even if the features of appearance of these designs are for the most part predetermined by the trading undertakings so that modifications to certain features are to be regarded as ad hoc and incidental.”

F. THE GRUR COMMITTEE’S OPINION ON THE SECOND QUESTION REFERRED FOR A PRELIMINARY RULING

- [82] The second question follows on from the first question and focuses on the “individual character” requirement.

- [83] In essence, the Court of Justice is asked whether a design can show “individual character” where the design is the result of the mere alteration, modification, or combination of components of designs, offered by Chinese trading undertakings in their catalogue.
- [84] To the referring court, it seems that the differentiating element in products of that type is not the design but the price of the product, as that is what makes orders and subsequent marketing profitable. It appears that the referring court tends to consider that these designs do not fulfil the individual character requirement.
- [85] The GRUR Committee considers that the second question of the referring court, again, reveals an incorrect examination standard of the individual character requirement laid down in Article 6 CDR.
- [86] First of all, the referring court asks whether all or some of the *feature[s] of appearance* of a product resulting from the customization of designs that are offered by Chinese trading undertakings (...) may be regarded as *having individual character* within the meaning of Article 6 CDR.
- [87] However, Article 6 (1) CDR states that a design shall be considered to have individual character if the overall impression *it* produces on the informed user differs from the overall impression produced on such a user *by any (prior) design*. Thus, the individual character requirement is not linked to individual features of appearance of that design, but to the overall impression of a design being composed of (several) features of appearance.
- [88] Thus, a design’s overall impression (as a whole) must be compared individually with each and every earlier design’s overall impression (as a whole).
- [89] In particular, novelty and individual character of a Community design cannot be defeated by combining features taken in isolation and drawn from a number of earlier designs, but by one or more earlier designs, taken individually (21/09/2017, C-361/15 P and C-405/15 P, Shower drains, EU:C:2017:720, § 69; 19/06/2014, C-345/13, Karen Millen Fashions, EU:C:2014:2013, § 23-35; 22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 23-24).
- [90] A combination of already disclosed features is therefore eligible for protection as a Community design, provided that the combination, forming the overall impression of the design, is novel and has individual character compared to each prior design.

- [91] At the same time, it is true that, in assessing individual character, the degree of freedom of the designer in developing the design will be taken into consideration (Article 6(2) CDR). If a design happens to be the result of the (mere) modification or combination of designs or components thereof, included in a catalogue, such self-chosen limitation may be an expression of unused design freedom (actually being broader than defined by the catalogue). However, the questions whether such potentially unused design freedom leads to a lack of individual character must be determined objectively based on an individual comparison of the individual character of the Community design with the individual character of each prior design.
- [92] Therefore, it is generally irrelevant whether or not a design is the result of the ad hoc alteration of components also offered in a catalogue by trading undertakings, without a fashion component.
- [93] It is also irrelevant if the inspiration for the design is taken from known fashion trends.
- [94] Likewise, the sale of large volumes of orders or the price of the product is not a relevant factor when assessing individual character.
- [95] Finally, the requirement of individual character in Article 6 CDR does not refer to the person, the origin or the contribution of the designer, but only to an objective comparison between the overall impression of the design for which protection is sought and the overall impression of (any) earlier design. Any question concerning the designer and his contribution to a Community design becomes relevant in a different context, namely the question of who has the right to such a (protected) Community design (governed by Article 14 CDR). However, this question stands alone and does not affect the question of the existence or protectability of the RCD as such.
- [96] In conclusion, the GRUR Committee is of the opinion that the second question raised by the referring court should be answered as follows:

“For finding individual character within the meaning of Article 6 Council Regulation (EC) No 6/2002 of 12 December 2001, it is irrelevant whether all or some of the features of appearance of the product result from the customization of designs that are offered by trading undertakings, in accordance with those undertakings’ catalogues, even if the activity of the owner of the design is limited to marketing those designs in the EEA, either without modification or with specific modifications, or with features of appearance that might be considered as pre-

determined for the most part by the trading undertakings. In that regard, it is likewise irrelevant whether the products are designed by European undertakings or offered by Chinese trading undertakings.”

G. THE GRUR COMMITTEE’S OPINION ON THE THIRD QUESTION REFERRED FOR A PRELIMINARY RULING

- [97] By its third question, the referring court asks about the concept of ‘designer’ according to Article 14 CDR, and specifically whether, in the event of a dispute as to the existence of a design, the owner of the design must prove a specified degree of customization in order to demonstrate that the final form departs significantly from the original design in order to be able to claim authorship.
- [98] The GRUR Committee’s opinion is that the concept of ‘designer’ is conclusively regulated in Article 14 CDR.
- [99] Article 14 (1) CDR provides that the right to the Community design shall vest in the designer, or, in case of two or more persons, it shall vest in them jointly pursuant to Article 14 (2) CDR.
- [100] The CDR does not provide a definition of the ‘designer’. Also, the Court of Justice has so far not adopted a definition of the “designer”. However, the Court of Justice held that the concept of designer is a concept of European Union law and must be interpreted autonomously (CJEU 02/07/2009, C-32/08 para. [63 and 64](#) – FEIA/Cul de Sac).
- [101] Pursuant to Article 14 (2) and 14 (3) CDR, the designer is the one who developed the design.
- [102] According to Article 3 (a) CDR a ‘design’ means the appearance of a product resulting from its features. Therefore, the designer is the person who creates these features which form the appearance of a product. The designer must materialize these features of the product in order to be a designer according to Article 14 (1) CDR. The creative idea as such does not yet represent a design. We would like to add that the design as an intellectual property right is different from the product in which the design is incorporated or to which it is applied. However, the definition in Article 3 CDR takes the finished product as the starting point even though a design is protected regardless of whether or not a product according to the design is actually produced.

- [103] Such appearance can also be formed if he or she has merely customized a prior design by modifying components.
- [104] Once the features of a design have been created, even by mere customization of known components, and hence a design has been developed, the person creating these features is the designer under Article 14 (1) or (2) CDR. Article 14 CDR does not require a specified degree of design development.
- [105] The concept of the 'designer' in design law differs from the concept of the 'authorship' in copyright law.
- [106] In order for a "work" to be protected by copyright law, it must be an original work in the sense that it is the result of the author's own intellectual creation (ECJ 13/11/2018, C-310/17 para. [36](#) – Levola Hengelo; ECJ 12/09/2019, C-683/17 para. [29](#) – Cofemel; ECJ 11/06/2020, C833/18 – Brompton Bicycle).
- [107] A "work" is an original if it reflects the personality of its author by expressing his free creative decisions.
- [108] Classification as a work is reserved for elements that express such creation (ECJ 13/11/2018, C-310/17 para. [36](#) – Levola Hengelo; ECJ 12/09/2019, C-683/17 para. [29](#) – Cofemel; ECJ 11/06/2020, C833/18 – Brompton Bicycle).
- [109] Neither Article 14 CDR nor other provisions included in Title II, Section 3 ("Right to the Community design") give rise to the assumption that the owner of the design must prove the existence of a specified degree of customization in order to be able to claim authorship.
- [110] It is indeed another question as to whether a single designer developed the design, or the design is the result of a teamwork. Whether there is one single designer or instead one or more designers who jointly developed a design has to be assessed on a case-by-case basis by weighing each contribution to the development of the design.
- [111] Even if a creative idea as such does not constitute a design, the contribution of such creative ideas, which then have been materialized by another person, can justify the status of co-designer by joint development. In exceptional cases such person can even have the status of the sole designer if the execution of the creative idea followed clearly defined rules.
- [112] In conclusion, the GRUR Committee is of the opinion that the third question raised by the referring court should be answered as follows:

“Article 14 Council Regulation (EC) No 6/2002 of 12 December 2001 is to be interpreted as meaning that a person has to be regarded as the designer in relation to a design where he or she has merely customized a prior design by modifying components; for the finding of who was the designer of a particular design it is not necessary to prove a specified degree of customization in order to demonstrate that the final form departs significantly from the original design. Whether a design has been developed alone or jointly in a situation where a design was merely customized by modifying components of a prior design offered by a trading company by way of a catalogue must be assessed on a case-by-case basis by weighing each contribution to the development of the design.”

H. THE GRUR COMMITTEE’S OPINION ON THE FOURTH QUESTION REFERRED FOR A PRELIMINARY RULING

[113] By its fourth question, the referring court reproduces the case-law of the Spanish Supreme Court set out in the judgment of Civil Section 1 of 25 June 2014, and asks whether, given the characteristics of the footwear described in the terms set out in the fourth question, which follows fashion trends, those fashion trends should be regarded as

a) restricting the designer’s freedom in such a way that minor differences are sufficient to give a different overall impression or, conversely,

b) detracting from the distinctiveness of the design with the effect that those elements or components are of less importance in the overall impression they produce on the informed user in so far as they result from known fashion trends.

[114] The GRUR Committee’s opinion is that the designer’s degree of freedom depends on the nature and intended purpose of the product in which the contested design will be incorporated, as well as on the industrial sector to which the product belongs.

[115] According to well-established case-law, and as reflected in the Design Guidelines of the EUIPO, the designer’s degree of freedom in developing the design is limited, *inter alia*, by the constraints of the features imposed by the technical function of the product or an element thereof, or by statutory requirements applicable to the product.

- [116] These constraints result in a standardization of certain features, which will thus be common to the designs applied to the product concerned (13/11/2012, T-83/11 & T-84/11, Radiatori per riscaldamento, EU:T:2012:592, § 44).
- [117] In contrast, the designer's degree of freedom was not considered to be restricted in a number of cases (13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 79), in particular when the shape of the product into which the design is incorporated may vary considerably (21/11/2013, T-337/12, Sacacorchos, EU:T:2013:601, § 36-39) and for instance come in any combination of colours, patterns, shapes and materials (05/07/2017, T-306/16, Door handles, EU:T:2017:466, § 45-47). This may also be the case where the constraints of a functional nature concerning the presence of certain essential features are not liable to affect to a significant extent the form or overall appearance of the product, since they may take various forms and be arranged in various ways (13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 79; 04/07/2017, T-90/16, Measuring instruments, apparatus and devices, EU:T:2017:464, § 61).
- [118] Furthermore, the designer's degree of freedom is not affected by the fact that similar designs coexist on the market and form a 'general trend' or coexist on the registers of industrial property offices (22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 58; 01/06/2012, R 89/2011-3, Sacacorchos, § 27; 06/06/2019, T-209/18, Kraftfahrzeuge, EU:T:2019:377, § 59).
- [119] The greater the designer's freedom in developing the challenged design, the less likely it is that minor differences between the designs at issue will be sufficient to make a different overall impression on an informed user.
- [120] Conversely, the more the designer's freedom in developing the registered Community design is restricted, the more likely it is that minor differences between the designs at issue will be sufficient to make a different overall impression on the informed user (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 67, 72).
- [121] Therefore, if the designer enjoys a high degree of freedom in developing a design, this reinforces the conclusion that designs that do not have significant differences make the same overall impression on an informed user (09/09/2011, T-10/08, Internal combustion engine, EU:T:2011:446, § 33).

[122] In conclusion, the GRUR Committee is of the opinion that the fourth question raised by the referring court should be answered as follows:

“Article 6 Council Regulation (EC) No 6/2002 of 12 December 2001 must be interpreted as meaning that fashion trends do not limit the degree of freedom of the designer in developing the design, regardless of the fact that the design has been developed based on a sample book or catalogue or is limited to selecting existing designs from a sample book or to varying some of their components taken from a catalogue. In assessing whether a design has individual character features of appearance of a design which result from existing fashion trends must be assessed in the same way as other features when comparing the overall impression produced by the design on the informed user with a previous design.”