

# Training programme on examination of national and international design application

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1. Internet disclosure
2. Technical function
3. Freedom of designer

## Examination of Community design applications by EUIPO:

### 1. Grounds for non-registrability

- Not corresponding to the definition of “design”
- Against public policy and accepted principles of morality

### 2. Formalities (e.g. product indication/classification, fees, representative)

### 3. Representation of the design (good quality, neutral background)

## Examination of invalidity applications by EUIPO:

- (a) **not a design;**
- (b) does not fulfil one of the following requirements:
  - **lack of novelty and individual character;**
  - non-visible component parts of complex products;
  - **technical function;**
  - interconnections ('must fit');
  - **against public policy and morality;**
- (c) lack of entitlement;
- (d) conflict with a prior design;
- (e) conflict with a distinctive sign;
- (f) unauthorised use of a work protected under the copyright law;
- (g) improper use of any of the items listed in Article 6ter of the Paris Convention and badges, emblems or escutcheons of particular public interest.

ABSOLUTE

RELATIVE

**Court of Justice of the European Union**



**General Court of the European Union**



**Boards of Appeal of EUIPO**



**Decisions of invalidity division of EUIPO**

# 1. Internet disclosure

Article 5(1) CDR  
Novelty

*“A design shall be considered to be new if no identical design has been **made available to the public** [...] before [the date of filing (or priority) of the contested Community design]”.*

Article 6(1) CDR  
Individual character

*“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** [...] before the date of filing (or priority) of the contested Community design”.*

Disclosure is **a preliminary step** before assessment of novelty and individual character.

## Art. 7(1) CDR Disclosure

*“A design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed [...], **EXCEPT** where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community”.*



## I. Establishing an event of disclosure:

- (i) The **source** of the design's disclosure – WHERE?
- (ii) The **design** invoked – WHAT?
- (iii) The **date** when the design was disclosed – WHEN?

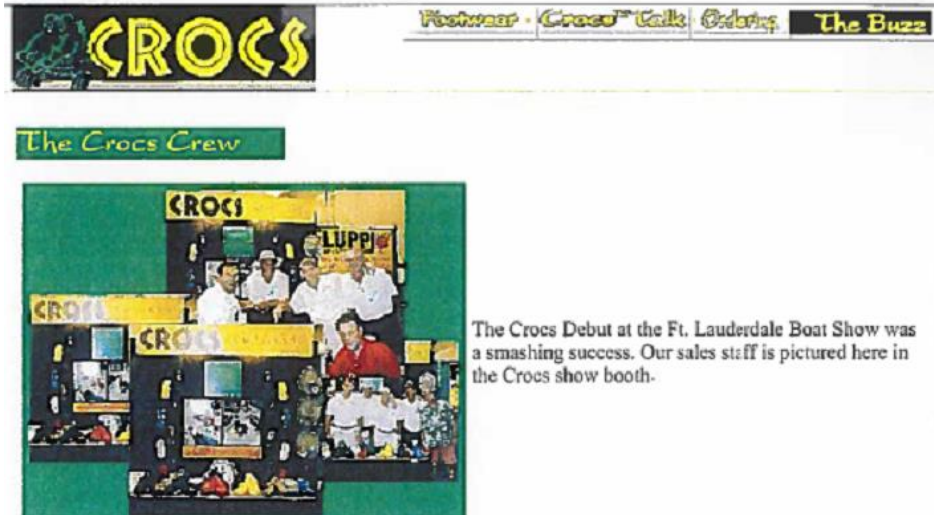
## (i) The source of design's disclosure – WHERE?

Art. 7(1) CDR: “[...] published following registration or otherwise, or exhibited, used in trade or otherwise disclosed [...],

A design can be disclosed **anywhere in the world**, including in the **internet**.

There is no requirement for the events constituting disclosure to have taken place within **the European Union** in order for a design to be deemed to have been made available to the public (13/02/2014, C-479/12, “Athen” gazebo, EU:C:2014:75, § 33).

Offering a product incorporating a design for sale in the **internet** generally constitutes an event of disclosure (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 49-51).



## (ii) The design invoked – WHAT?

The assessment of the individual character must be conducted in relation to one or more **specific, individualised, defined and identified designs** from among all the designs which have been disclosed previously ((19/06/2014, *C-345/13, Karen Millen Fashions*, *EU:C:2014:2013*, § 25).

It is immaterial whether or not an earlier design enjoys or enjoyed **legal protection** (as a design, trade mark, copyright work, patent, utility model or otherwise) (21/05/2015, *T-22/13 & T-23/13, UMBRELLAS*, *EU:T:2015:310*, § 24).

A Community design cannot be regarded as having individual character **even if the disclosed earlier design relates to a different product**. The fact that the protection granted to a design is not limited only to the products in which it is intended to be incorporated or to which it is intended to be applied must therefore mean that the assessment of the individual character of a design must also not be limited to those products alone (21/09/2017, *C-361/15 P & C-405/15 P, Shower drains*, *EU:C:2017:720*, § 133).

Where the views of the earlier design submitted **do not enable its comparison** with the contested Community design, this does not amount to a disclosure (*10/03/2008, R 586/2007-3, Barbecues, § 22*).



### (iii) The date when the design was disclosed – WHEN?

It is enough that the disclosure took place at a point in time that can be identified **prior** to the filing date or priority date of the contested Community design **even if the exact date of disclosure is unknown** (14/06/2011, *T-68/10, Watches*, EU:T:2011:269, § 31-32; 13/06/2019, *T-74/18, Informationstafeln für Fahrzeuge*, EU:T:2019:417, § 34).

The date of disclosure is when a product to which a design is applied, or in which it is incorporated, **was made publicly available** and not when the circles specialised in the sector concerned actually became aware of such disclosure (17/11/2016, *R 1426/2015-3, Tiles*, § 42).



## Types of evidence for proving an event of disclosure in the internet:

- Printouts and screenshots
- URL addresses
- Videos
- Emails
- Etc.

## II. Proving exceptions to disclosure:

Art. 7(1) CDR: [...] could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union.

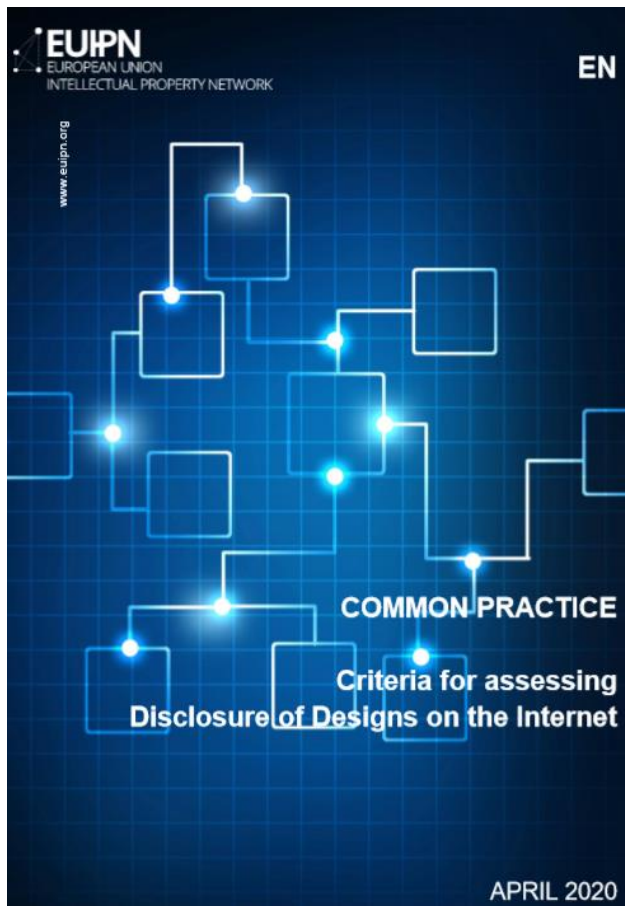
[...] is a **question of fact**; the answer to that question is dependent on the assessment of the **particular circumstances of each individual case** (13/02/2014, C-479/12, “Athen” gazebo, EU:C:2014:75, § 27).

It must be examined whether it is appropriate to consider that it was **not actually possible** for the circles specialised in the sector concerned to be aware of the events constituting disclosure, whilst **bearing in mind what can reasonably be required** of those circles in terms of being aware of prior art [...]. (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 56).



Admittedly, the applicant is right in arguing that it **cannot be expected to prove a negative fact**. However, far from being required to prove negative facts, the applicant could have adduced **positive proof** relating, in the present case, for instance, to data showing that, notwithstanding the fact that its website was accessible worldwide, there was **no, or very little, actual traffic from users originating in the European Union**, [...] or also that the distribution and retail network for the clogs to which the contested design had been applied was not actually operational and that no order had been placed using that network (*14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 71*).

What matters is whether the circles specialised in the sector concerned have had an **opportunity to have access to the design irrespective of the number that actually seized this opportunity** and might have encountered the disclosed design (*14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 73*).



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QUESTIONS?

## 2. Technical function

## Recital 10 CDR

Technological innovation should not be hampered by granting design protection to **features dictated solely by a technical function**. It is understood that this does not entail that a design must have an aesthetic quality.

## Article 8(1) CDR

Community design shall not subsist in features of appearance of a product which are **solely dictated by its technical function**.

## “Multiplicity of forms” theory v. “Causality” theory

Shall be excluded from protection the features of appearance of a product where **considerations other than the need for that product to fulfil its technical function, in particular those related to the visual aspect, have not played any role** in the choice of those features, even if other designs fulfilling the same function exist (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 31).



*RCD No.*  
*242730 – 0001*



*RCD No.*  
*242730 – 0007*



*RCD No.*  
*242730 – 0012*

If it is established that **one or some of the features** of the design are exclusively functional, those features shall be denied design protection and thus **will not be taken into consideration** when assessing whether other features of the design fulfil the requirements for protection (Recital 10 CDR).

In case it is concluded that Article 8(1) CDR applies in respect of **all the identified features**, that design shall be **declared invalid as a whole**,

unless it is apparent that the particular **arrangement** of those features was dictated by aesthetic considerations, creating, in particular, an overall visual impression going beyond mere technical function (18/11/2020, T-574/19, Fluid distribution equipment, EU:T:2020:543, § 25).

Assessment must be made, in particular, having regard to the **design at issue**, the **objective circumstances dictating the choice of features of appearance of the product concerned**, and/or **information on its use or the existence of alternative designs** that fulfil the same technical function, provided that the circumstances, data, or information as to the existence of alternative designs are supported by reliable evidence (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 36-37).

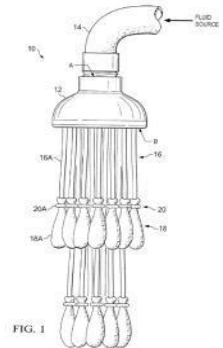
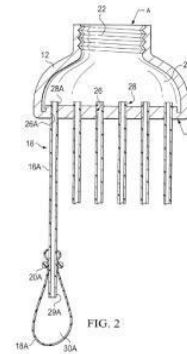
The existence of **patent or utility model** for the same product is a strong indication that all its features are solely functional (18/11/2020, T-574/19, Fluid distribution equipment, EU:T:2020:543, § 96).



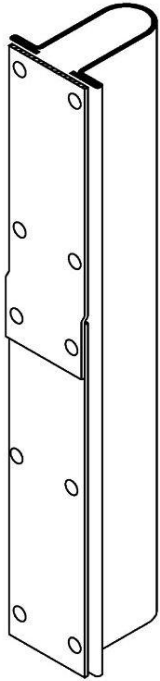
## 18/11/2020, T-574/19, “Fluid distribution equipment”



**Contested design**



## 15/02/2021, R 2068/2019, “Posts” (appeal pending)



**Contested design**

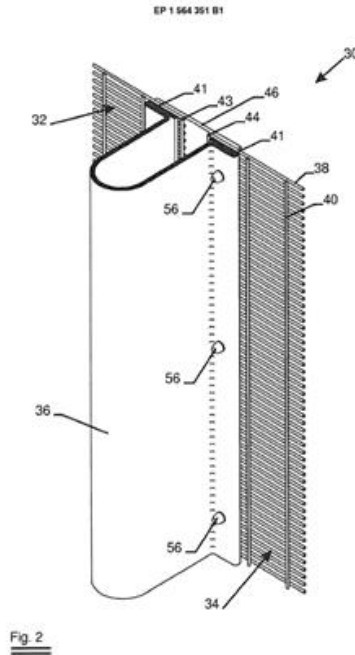


Fig. 2

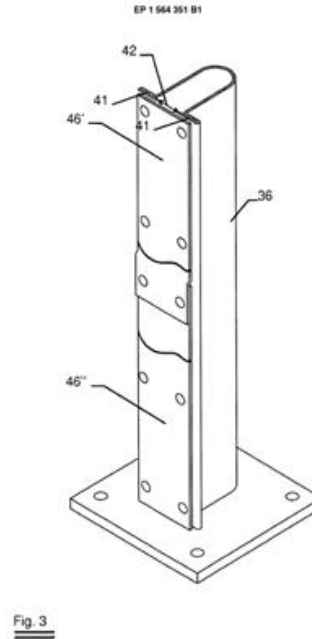


Fig. 3

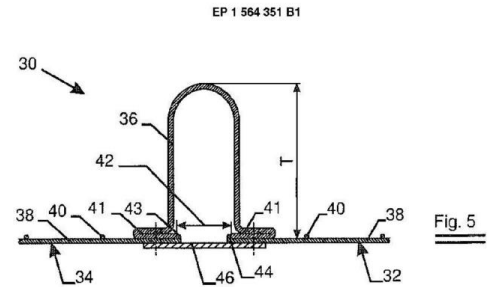
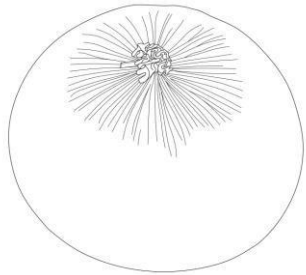
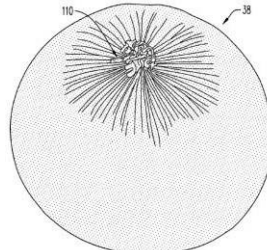


Fig. 5

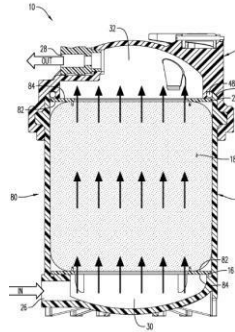
## 26/02/2020, R 740/2018, “Water purifiers” (appeal pending)



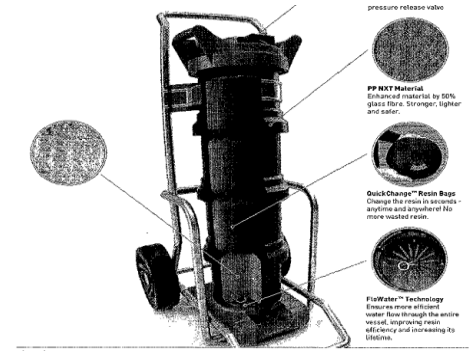
**Contested design**



**FIG. 12**



**FIG. 3**



QUESTIONS?

## 3. Freedom of designer

## Article 6(1) CDR Individual character

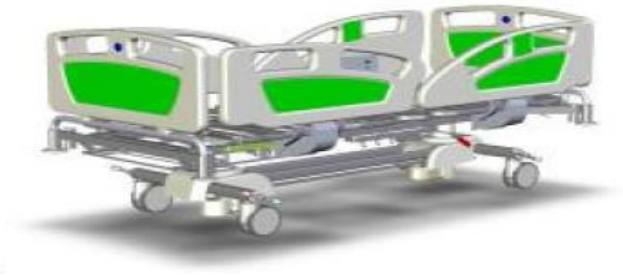
1. A design shall be considered to have individual character if the **overall impression** it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public.
2. In assessing individual character, **the degree of freedom of the designer** in developing the design shall be taken into consideration.

**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. Conversely, the more the designer's freedom in developing the 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).

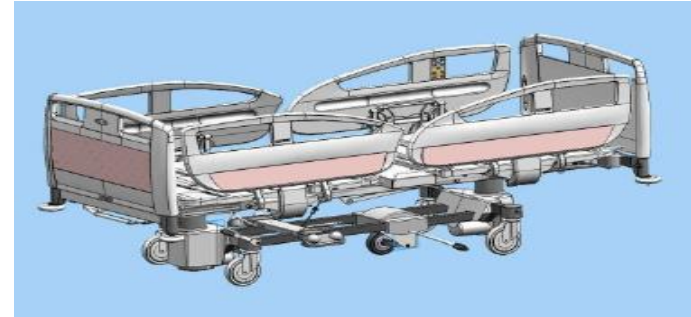
The designer's degree of freedom in developing its design is established, inter alia, by the constraints of the features imposed by **the technical function** of the product or an element thereof, or by **statutory requirements** applicable to the product. Those constraints result in a **standardisation** 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).

## Statutory requirements applicable to the product

*17/12/2014, R 2091/2012 “Nursing beds”*



**Contested design**



**Prior design**



## Features imposed by the technical function to the product

*29/11/2018, T-651/17, “Spray guns for paint”*



**Contested design**



**Prior design**

SATA (Germany)



DeVilbiss (USA)



Iwata (Japan)



Sagola (Spain)



## Design trend does not limit the freedom of designer

*06/06/2019, T-209/18, “Vehicles”*



**Contested design**



**Prior design**



QUESTIONS?

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Thank you