

Re-designing design in Europe?

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Summary

- Introduction and recap: how design is protected in the EU
- Design registrations: a review of EU examination practice
- Copyright, and the recent EU case law in Cofemel and Brompton
- National case law
- Conclusions and takeaways

Legal tools for protecting shapes and aesthetic features of products

- Registered and unregistered design (EU and member States, WIPO)
- Copyright (EU and member States, Vienna Convention)
- 3D trademarks (EU, member States, WIPO)
- Unfair competition (only on a country-by-country basis)

EUIPO Design Examination Practise Representation of the Design (consistency, visual disclaimers, amendments)

Substantive examination is limited to two grounds of non-registrability: **non-compliance with the definition of design** (Art 3(a) CDR), **non-compliance with public policy and morality** (Art. 9 CDR), whereas the formality examination focusses, among others, on the **requirements regarding the graphic representation of the design** (dictated by the requirement of legal certainty).

Any deficiency relating to the graphic representation of the design will have no bearing on the granting of a filing date, but if the deficiencies are not remedied within the time limit set by the Office, the application will be refused completely (Art 46(3) CDR) or partially (Art 11(3) CDIR).

As a matter of principle, **the graphic representation of the design may not be altered after filing**.

- submission of additional views or withdrawal views will not be accepted (Art.12(2) CDIR), unless expressly allowed or required by the Office.
- the initially filed views may not be replaced with better-quality ones.
- the initially filed views may not be amended to correct deficiencies of consistency.
- inconsistent views may be cancelled or made the subject of a separate design, if allowed by the examiner in a “deficiency letter”.

The **very limited possibilities of amendment** after filing make it **imperative to adequately prepare the figures before filing** the EU design application.

The following slides show some exemplary graphic representation requirements.

Representation of the Design – Number of views, Consistency of views

Number of views

- the design can be represented by a **maximum of seven views** (Art 4(2) CDIR).
- the views may be plan, in elevation, cross-sectional, in perspective or exploded.
- if more than seven views are filed, the Office will consider the views in the order numbered by the applicant (Art 4(2) CDIR) and will disregard any extra view for registration and publication purposes.

Consistency of views

The views must relate to the same design, i.e. to the appearance of one and the same (part of) product.

Combination of different visual formats or colors

- a design should be represented using **only one visual format** (e.g. a line drawing or a photograph).
- different visual formats are frequently inconsistent with one another, e.g.:
 - different perspective contour shapes
 - different surface features
- different visual formats should be filed each one as a separate design, e.g. in a multiple application.
(e.g. one design as line drawing, a further design as photograph)



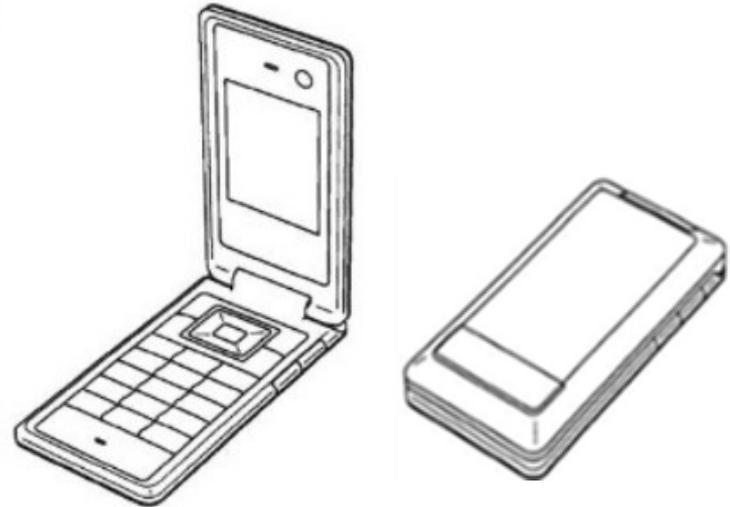
Amendment options in case of inconsistency:

- withdrawing some views or converting the application into a multiple application for different designs,
- paying the corresponding fees.

Representation of the Design – Consistency - Alternative positions

Products that can be modified into various configuration

- views showing **different configurations** of the design are acceptable provided **no parts have been added or deleted**.
- the **alternative positions** of the movable or removable parts of a design must be shown **in separate views**.



- **different configurations** may result in **different products** (different Locarno classifications), such as in a bag convertible into a towel.
- In this case it may be suggestible to additionally file individual design registrations for the different products (separate priority documents for future foreign applications).

Amendment options in case of parts added or deleted:

- withdrawing some views or converting the application into a multiple application for different designs,
- paying the corresponding fees.

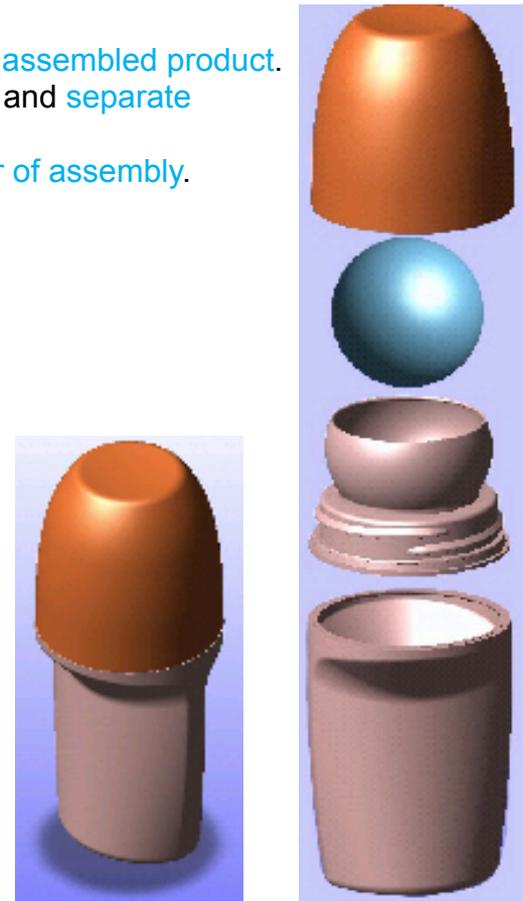
Representation of the Design – Consistency - Exploded views

Products and their individual parts fitted together

- exploded views are accepted only if combined with **at least one view of the assembled product**.
- in the exploded views, **all the product's parts** must be shown disassembled and **separate** from each other **without overlap**.
- in the exploded views, the disassembled parts must be shown in their **order of assembly**.

Amendment options in case of lack of assembled product view:

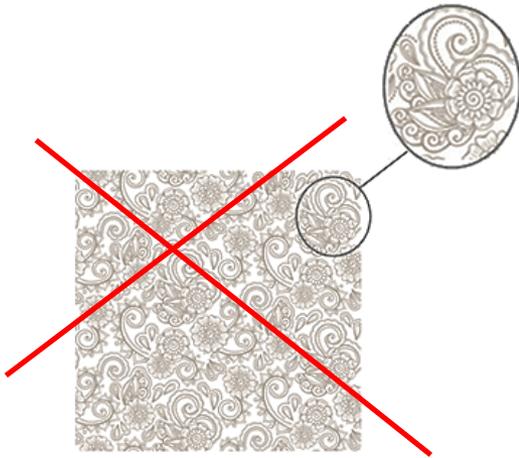
- the examiner will invite the applicant to **submit an assembled product view**.
- the subsequently filed assembled product view **must not** contain features that are not visible in the originally filed exploded views.
- the original **filing date will be retained**.



Representation of the Design – Consistency - Magnified details

Views showing magnified parts of a design

- **Enlarged views** showing one part or detail of an overall design are acceptable only if the enlarged detail is already visible **in one of the other views in the same scale as the overall design**
- the **enlarged part** or detail of the design must be presented in a **separate single view**.



Amendment options:

- cancellation of an unacceptable view



tile



Representation of the Design – Consistency – Partial views

Views showing parts of a product in isolation

- views showing only an isolated part of a product are acceptable **only if combined with at least one view of the assembled product** in which the different parts must be connected to each other.
- views showing only an isolated part may be **magnified**.



Air filter and air filter housing, for a motor

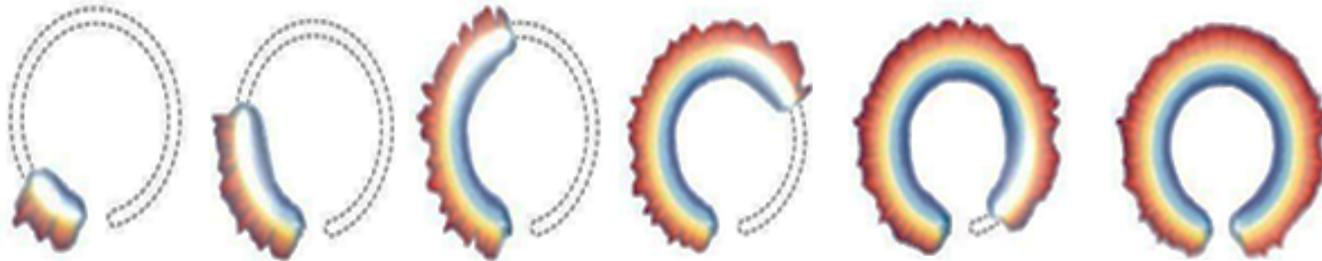
Amendment options in case of lacking assembled product view:

- If isolated parts belong to the **same class of products** (Locarno classification), converting individual part views in **separate designs of a multiple application** and paying the corresponding fees.
- If isolated parts do **not meet the unity** of class, converting each individual part view in **a separate application**, and paying the corresponding fees.
- Limiting the application to only one design by **withdrawing the views** representing other designs.

Representation of the Design – Consistency – Animated designs

Views showing a sequence of screen shots (animated icon or graphical user interface)

- a sequence of separate views showing a single animated design is acceptable only if:
 - all views are visually related, i.e. they must have features in common
 - all views are ordered in a way to give a clearly understandable progression
- Maximum seven separate sequence views.



Amendment options in case of lacking common features or lacking understandable progression:

- Converting individual screen shot views into separate designs of a multiple application and paying the corresponding fees.
- Limiting the application to only one design by withdrawing the views representing other screen shots.

Representation of the Design – Consistency – Set of articles

Views showing a set of articles that belong together and are used together

- a set of articles, which are not mechanically connected, can be represented in a single design application, e.g. sets of playing cards, sets of cutlery, etc.
- among the maximum seven views, **at least one view must show the set of articles in its entirety.**



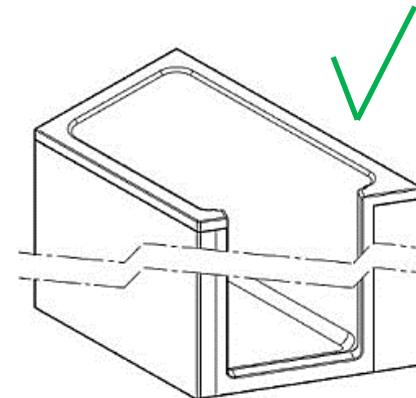
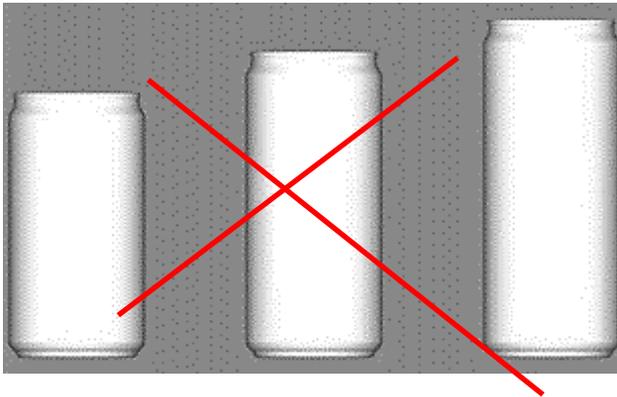
Amendment options in case of lacking view showing the entire set:

- If individual articles belong to the **same class of products** (Locarno classification), converting individual article views in **separate designs of a multiple application** and paying the corresponding fees.
- If individual articles do **not meet the unity** of class, converting each individual article view in a **separate application**, and paying the corresponding fees.
- Limiting the application to only one design by **withdrawing the views** representing other designs.

Representation of the Design – Consistency – Variations of a design

Views showing different embodiments of the same concept

- different embodiments of the same concept cannot be grouped in a single application, e.g. food container in different dimensions, etc.
- Possible disclaiming a precise proportion or length by broken line separations (indeterminate length).



Amendment options in case the views relate to more than one design:

- If individual designs belong to the same class of products (Locarno classification), converting individual design views in separate designs of a multiple application and paying the corresponding fees.
- If individual designs do not meet the unity of class, converting each individual design view in a separate application, and paying the corresponding fees.
- Limiting the application to only one design by withdrawing the views representing other designs.

Representation of the Design – Visual disclaimers

No written disclaimers

The Community Design Regulation and Implementing Regulations do **not provide for** the possibility of including in the application **a written disclaimer** to any exclusive right to one or more features in the views.

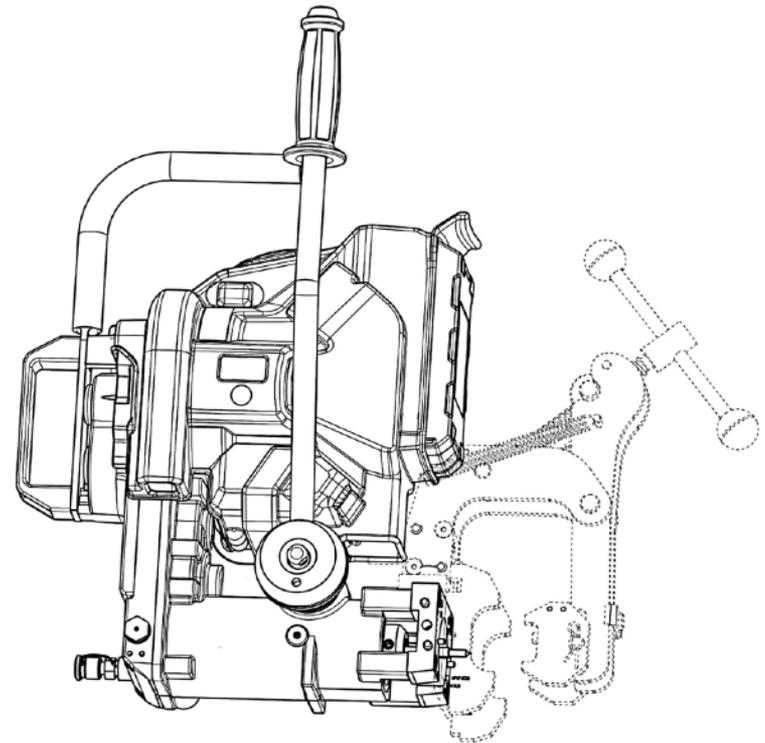
Visual disclaimers

Disclaimers must therefore be **apparent from the representation** of the design itself, by:

- by excluding features for which protection is not sought with **broken lines**, **blurring** or **colour shading**; or
- by including features for which protection is sought within a **boundary**,

In designs represented by more than one view, the **visual disclaimer must be shown** consistently **in all views** where the disclaimed features appear.

Broken lines are recommended.

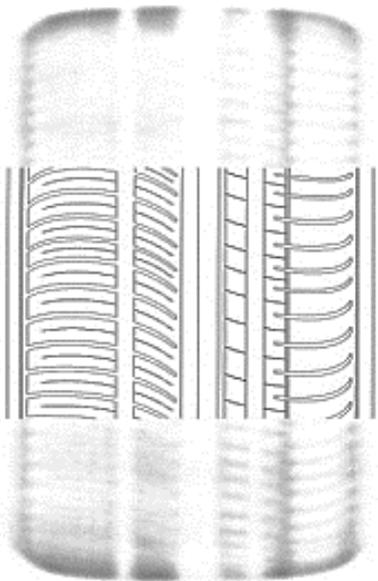


Rail drill

Representation of the Design – Visual disclaimers

Alternative visual disclaimers

Where broken lines cannot be used due to technical reasons (on photographs or in presence of stitching on clothing or interrupted line patterns), other visual disclaimers may be used.



tyre tread - blurring



hand tool – boundary



car body parts – colour shading

BREXIT - Impact on registered Community design

- At the end of the BREXIT transition period (**31 December 2020**), all **Registered Community Designs** (RCDs) and International designs designating EU **will no longer afford protection in the UK**, but will continue to be valid in the remaining 27 EU Member States.
- With effect from **1 January 2021**, all **published Registered Community Designs**, and EU designations of International Designs will be **automatically cloned** by the UKIPO into corresponding **national UK design registrations** which will be treated as if they had been applied for and registered under the UK national law.
- The cloned national UK designs will retain the **same priority-, application-, registration- and renewal dates** of the original EU designs.
- For the cloned registered UK designs, as of 2021 a **separate UK national renewal fee** will apply in addition to the renewal fees of the original EU or International design registration. The renewal fees due in 2021 can be validly paid, without penalty fee, until 6 months after the deadline.
- The proprietors of the converted UK national designs have the possibility to “OPT OUT”, i.e. abandon the right in UK and eliminate any effect thereof, by requesting OPT OUT after 31 December 2020.

BREXIT - Impact on not yet published community design applications/registrations

- The EU designs which are not yet published or registered at the end of the transition period (31 December 2020) will **NOT be automatically converted** into corresponding UK design applications.
- The owners will enjoy a 9 months period **starting from 1 January 2021 to re-apply in the UK for an equivalent UK design** maintaining the same relevant dates of the EU or International design application, but subject to the UK national fees for filing and prosecution.
- **Deferment of publication** of the re-filed **UK design applications** will be possible, but only to a **maximum of 12 months** from the re-filing date in the UK.

Required action:

Inhouse IP departments and Law Firms:

- update the design database by entering the cloned national UK design registrations
- enter and monitor the deadlines for the separate UK renewals
- enter and monitor the deadlines for re-filing of pending/non-published EU designs as UK design applications
- appoint representative for the cloned and re-filed UK designs (where required)
- re-assign representation for EU designs, where required (UK will fall out of the EEA European Economic Area)

Right holders:

- budgeting additional costs for UK national renewals and (where applicable) re-filing in the UK
- if renewal of designs are instructed through separate channels, inform the renewal provider about the additional UK national rights to be maintained.

Copyright

Legal basis: EU Directive 98/71, art. 17: *“... in the absence of harmonisation of copyright law, it is important to establish the principle of cumulation of protection under specific registered design protection law and under copyright law, whilst leaving Member States free to establish the extent of copyright protection and the conditions under which such protection is conferred”*.

France, Benelux in favour, Austria and Germany stricter, UK and Ireland opposed

Art. 2.7 Berne Convention: *«... it shall be a matter for legislation in the countries of the Union ... to determine the extent of the application of their laws to works of applied art and industrial designs and models, as well as the conditions under which such works, designs and models shall be protected. Works protected in the country of origin solely as designs and models shall be entitled in another country of the Union [constituted by that Convention] only to such special protection as is granted in that country to designs and models; however, if no such special protection is granted in that country, such works shall be protected as artistic works”*.

C - 683/17 – The Cofemel case - Sociedade de Vestuário SA *vs* G-Star Raw CV

G-Star - Cofemel



G- Star - Cofemel



Copyright

Under Portuguese law: protection is given to «Works of applied art, industrial designs and works of design which constitute an artistic creation, irrespective of the protection relating to industrial property»

Portuguese courts held copyright infringement, by relying on CJEU case law (Infopaq International (C-5/08) and Painer (C-145/10), «as meaning that copyright protection extended to works of applied art, industrial designs and works of design, provided that such subject matter was original, in other words that it was the result of the author's own intellectual creation, there being no requirement that it had any particular degree of aesthetic or artistic value».

The Supreme Court referred two questions to the CJEU

Copyright

Remarks by the CJEU

The concept of ‘work’ that is the subject of all those provisions constitutes, as is clear from the Court’s settled case-law, **an autonomous concept of EU law which must be interpreted and applied uniformly**, requiring two cumulative conditions to be satisfied. First, that concept entails that there exist an original subject matter, in the sense of being the author’s own intellectual creation. Second, classification as a work is reserved to the elements that are the expression of such creation

If a subject matter is to be capable of being regarded as original, it is both necessary and sufficient that the subject matter reflects the personality of its author, as an expression of his free and creative choices

This necessarily entails the existence of a subject matter that is identifiable with sufficient precision and objectivity

IT IS NOT SUFFICIENT that the product has a specific, aesthetically significant visual effect

C-833/18 –Brompton Bicycle Ltd *vs* Chedech/Get2Get

The Brompton bicycle



The Chedech/Get2Get bicycle



Brompton



PATENT SPECIFICATION (11) **1 580 048**

(21) Application No. 18950/76 (22) Filed 7 May 1976
 (23) Complete Specification Filed 6 May 1977
 (44) Complete Specification Published 26 Nov. 1980
 (51) INT. CL.⁷ B62K 15/00
 (52) Index at Acceptance
 B7E 102 109 CF
 (72) Inventor: ANDREW WILLIAM RITCHIE

(19)



(54) IMPROVEMENTS IN OR RELATING TO FOLDING BICYCLES

(71) We, **BROMPTON BICYCLE LIMITED**, a British Company of 26 Bow-erham Street, London, SW6, do hereby declare the invention, for which we pray that a patent may be granted to us, and the method by which it is to be performed, to be particularly described in and by the following statement:

The present invention concerns folding bicycles.

It has for an object to provide a folding bicycle which can be folded in a relatively simple manner into an extremely compact configuration.

Accordingly the present invention consists in a folding bicycle comprising a foldable main frame member having front and rear parts interconnected by hinge means, a steerable front wheel assembly carried by said front part, a rear wheel assembly including a rear wheel, pivot means interconnecting said rear part of said main frame member and said rear wheel assembly whereby said rear wheel assembly can pivot relative to said main frame member in the plane of said rear wheel into a folded position in which the axle of said rear wheel is located beneath said main frame member, the position of said pivot means being such that the rear wheel moves to a position when folded which lies between the positions occupied by the front and rear wheels when the bicycle is unfolded; and said hinge means interconnecting said front and rear parts of said main frame member enabling said front wheel assembly to be moved by folding of the main frame

In order that the present invention may be more readily understood an embodiment thereof will now be described by way of example and with reference to the accompanying drawings, in which:

Figure 1 is a side elevation of a bicycle constructed in accordance with the present invention;

Figure 2 is a similar view showing the bicycle folded;

Figure 3 is a diagrammatic end view of the front of the bicycle of Figure 2 showing how the handlebars of the bicycle fold;

Figures 4a, b and c are diagrammatic views showing various stages in the folding of the bicycle;

Figure 5 is a side elevation, and Figures 6 and 7 sections on lines VI-VI and VII-VII respectively, of one type of clamp used in the bicycle of Figure 1;

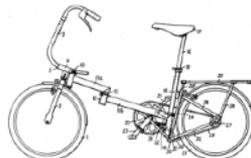
Figures 8 and 9 are a side elevation and on line VIII-VIII section through a second type of clamp.

The folding bicycle shown in the accompanying drawings has a front wheel assembly comprising a front wheel 1 mounted on a fork 2 above which is mounted a pair of handlebars 3 each of which can be folded downwards so as to lie alongside the wheel 1. Each handlebar 3 has a tubular portion 5 extending into a sleeve 6 of circular cross-section carried above the fork 2 so that it can pivot within the sleeve relative to the fork and front wheel. In the unfolded position a stop 7 and located between the joints of the handlebars 3 prevents them from moving one another beyond the position in which they are in position by a link 8. The link 8 is of one end and flexibility secured at its end to one of the handlebars. The other end of the link 8 can be hooked to the saddlebar so as to extend between the length of the link 8 being such that the handlebars 3 are fixed slightly towards

United States Patent (11) **4,182,522**
Ritchie (12) **Jan. 8, 1980**

FOREIGN BICYCLES
 (74) Inventor: Andrew W. Ritchie, 21 Eganston Court, London, England, 1976
 (21) Appl. No.: 79,427
 (22) Filed: March 1, 1977
 (23) Foreign Application Priority Date: May 7, 1976 (GB) United Kingdom: 1976/76
 (51) Int. Cl. B62K 15/00
 (52) U.S. Cl. 280/770, 282/317
 (53) Field of Search: 280/770, 282/317
 (54) Reference Cited
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 3,262,000 1/1968

9 Claims, 11 Drawing Figures



Chedec



Copyright

Remarks by the CJEU

- A subject matter satisfying the condition of originality may be eligible for copyright protection, even if its realization has been dictated by technical considerations, provided that its being so dictated has not prevented the author from reflecting his personality in that subject matter, as an expression of free and creative choices.
- It is for the referring court to determine whether, through that choice of the shape of the product, its author has expressed his creative ability in an original manner by making free and creative choices and has designed the product in such a way that it reflects his personality.
- It is for the referring court to take account of all the relevant aspects of the present case, as they existed when that subject matter was designed, irrespective of the factors external to and subsequent to the creation of the product.

Copyright

Cofemel, Brompton (as well as Infopaq and previous decisions ...):

Those cases pertain to products for which the requirements of artistic value is not an issue, and not particularly high threshold for copyright protection was examined.

Referring courts limit the scope of the case before the CJEU, yet some guidance can be derived from incidental remarks made by the Court, ie:

- a) Artistic value is mainly neglected, as it seems absorbed by originality
- b) The concept of «work» must be autonomous and homogenous within the EU
- c) Creativity must be assessed at the time of conception of the product – regardless of any further circumstance

CJEU has not stated as suggested by many comments, that artistic value is not or cannot be a requirement; yet its scope is now reduced

Potential impact on national case law, especially where higher thresholds for protection are required by local Courts

Copyright

National law(s)

Italian Copyright Act, art. 2, n. 10 «***works of industrial design (are protected by copyright) when they possess in themselves creative character and artistic value***»

Italian case law and artistic value:

«qualitative» criteria; the work must be able to be perceived as an *artwork*, not only as a *product*, ie beyond commercial circles

Evidence of artistic value: exhibitions in museums, public or private art collections, awards to authors (beyond the specific field of activity), economic value of the work as such etc.



Copyright

Cases before Cofemel ...

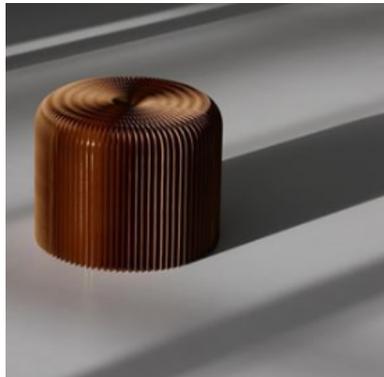
The Vespa case (Court of Appeal of Turin)

"... born as an object of industrial design, however, over the decades, it has acquired such a large amount of recognition from the artistic environment that it has greatly celebrated its creative and artistic qualities that it has become an icon symbol of Italian costume and artistic design (...) underlining how the creative and artistic character of the Vespa is confirmed by the multiple and exceptional awards from numerous and important cultural institutions that include it among the most relevant expressions of design, and that just as the collective recognition should be evaluated the creative and artistic character of a design work".

Copyright – Italian cases

Case law *post* Cofemel

Court of Milano, Molo Design/Exhibo (ord. 29 May 2020)



Creativeness – expression of the author's personality

Artistic value – evidence through MoMA presence, articles, awards

Conclusions and takeaways

- Need for uniform application of copyright protection – is the CJEU really addressing the issue?
- National Courts bound by CJEU rulings, hence ...
- Potentially lower threshold for copyright protection

- Registered design still provide stronger and safer scope of protection

- When drafting design agreements – keep in mind the different nature and scope of design rights and copyright, different rules on transfer of rights