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**COMMENTS ON THE DECISION OF THE GENERAL  
COURT OF THE EUROPEAN UNION**

**Grupo Promer / PepsiCo: Invalidation because of Design Infringement according to Article 25(1)(d) of Regulation No 6/2002**

**Judgment of the General Court (Fifth Chamber) of the European Union (formerly the Court of First Instance) of 18 March 2010 in Case T-9/07 concerning an action brought against the Third Board of Appeal of OHIM (Office for Harmonisation in the Internal Market) of 27 October 2006 (Case R 1001/2005-3) relating to invalidity proceedings between Grupo Promer Mon Graphic SA and PepsiCo Inc.**

**COMENTÁRIOS À DECISÃO DO TRIBUNAL GERAL  
DA UNIÃO EUROPÉIA**

**Grupo Promer / PepsiCo: Invalidação decorrente de infração a desenho de acordo com o artigo 25(1)(d) do Regulamento Nº 6/2002**

**Julgamento do Tribunal Geral (Quinta Seção) da União Européia (antigo Tribunal de Primeira Instância) de 18 março 2010 no âmbito do Caso T-9/07, a respeito de ação ajuizada contra o Terceiro Conselho de Apelação do OHIM (*Office for Harmonisation in the Internal Market*) em 27 de outubro de 2006 (Caso R 1001/2005-3) relativo a procedimentos de invalidação entre Grupo Promer Mon Graphic SA e PepsiCo Inc.**

*Christoph Gasser*

*Abstract:* Eight years after the enactment of the EC Council Regulation on Community Design («EC Design Regulation»), the General Court of the European Union (formerly the Court of First Instance) was offered the opportunity to adjudicate upon main issues of validity and violation of a Community design. The General Court concluded that a Community design registered for «promotional item[s] for games» was in conflict with an earlier filed Community design. Even in consideration of the designer's severely restricted degree of freedom, the similarities between the two designs at issue were so manifest that no different overall impression was produced.

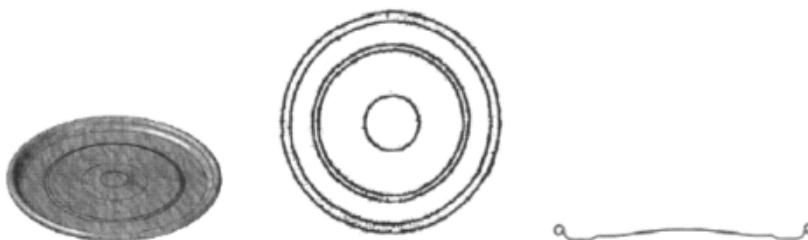
*Keywords:* Intellectual Property. Design. European Community Council Regulation on Community Design. Validity and violation of a community design. Decision of the General Court of the European Union.

*Resumo:* Oito anos após a edição, pelo Conselho da União Européia, do Regulamento relativo aos desenhos ou modelos comunitários, o Tribunal Geral da União Européia (antigo Tribunal de Primeira Instância) teve a oportunidade de decidir sobre questões essenciais relativas à validade e violação de desenho industrial comunitário. O Tribunal Geral da União Européia decidiu que um desenho industrial comunitário registrado para “artigo promocional para jogos” estava em conflito com um desenho industrial comunitário previamente arquivado. Mesmo que considerado o grau de liberdade severamente restrito dos designers, as similaridades entre os dois desenhos industriais em questão eram tão manifestas que nenhuma diferença substancial foi verificada.

*Palavras-chave:* Propriedade Intelectual. Desenho Industrial. Regulação para Desenho Industrial Comunitário, do Conselho da Comunidade Européia. Validade e violação de um desenho industrial comunitário. Decisão do Tribunal Geral da União Européia.

## I. Facts and Legal Framework

On 9 September 2003, the intervener, PepsiCo Inc. («PepsiCo»), filed an application for registration of a Community design at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) pursuant to Regulation No 6/2002<sup>1</sup>. When the registration was applied for, priority was claimed for Spanish design No 157156, which had been filed on 23 July 2003 and whose application for registration was published on 16 November 2003. The Community design was registered under number 74463-0001 for the following goods: «promotional item[s] for games». It is represented as follows:



On 4 February 2004, the applicant, Grupo Promer Mon Graphic SA («Grupo Promer»), filed an application for a declaration of invalidity against design No 74463-0001 («the contested design») pursuant to Article 52 of Regulation No 6/2002.

Grupo Promer's application for a declaration of invalidity was based on registered Community design No 53186-0001 («the prior design»), which has a filing date of 17 July 2003 and in respect of which priority is claimed for Spanish design No 157098, which was filed on 8 July 2003 and whose application for registration was published on 1 November 2003. The prior design is registered for «metal plate[s] for games». It is represented as follows:

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<sup>1</sup> Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs (OJ 2002 L 3, p. 1).



The grounds relied on in support of the application for a declaration of invalidity alleged the lack of novelty and individual character of the contested design for the purposes of Article 25(1)(b) of Regulation No 6/2002, and the existence of a prior right for the purposes of Article 25(1)(d) thereof. On 20 June 2005, the Invalidity Division of OHIM declared that the contested design was invalid on the basis of Article 25(1)(d) of Regulation No 6/2002.

On 18 August 2005, PepsiCo filed a notice of appeal with OHIM, pursuant to Articles 55 to 60 of Regulation No 6/2002, against the decision of the Invalidity Division. By decision of 27 October 2006 («the contested decision»), the Third Board of Appeal of OHIM annulled the decision of the Invalidity Division and dismissed the application for a declaration of invalidity. After rejecting Grupo Promer's argument concerning the intervener's bad faith, the Board of Appeal held, in essence, that the contested design was not in conflict with Grupo Promer's prior right and that the conditions set out in Article 25(1)(d) of Regulation No 6/2002 had not therefore been fulfilled. In that connection, the Board of Appeal held that the goods covered by the designs at issue concerned a particular category of promotional items, namely «tazos» or «rappers», and that, therefore, the freedom of the designer of those promotional items was severely restricted. Accordingly, the Board of Appeal concluded that the difference in the profile of the designs at issue was sufficient to conclude that they produced a different overall impression on the informed user<sup>2</sup>.

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2 See HARTWIG Henning, *Designschutz in Europa. Design Protection in Europe*, Vol. 2, Cologne et al. 2008, 281 et seq. – Grupo Promer/PepsiCo, with comments by TRAUB Florian.

Grupo Promer claimed that the General Court should annul the contested decision.

## **II. Reasoning Rendered by the General Court of the European Union**

Grupo Promer invoked three grounds to support its action: Firstly PepsiCo's alleged bad faith and an overly restrictive interpretation of Regulation No 6/2002, secondly lack of novelty of the contested design, and thirdly a violation of Article 25(1)(d) of Regulation No 6/2002.

As a first step, the General Court refused Grupo Promer's arguments related to PepsiCo's alleged bad faith and overly restrictive interpretation of Regulation No 6/2002:

«The Court observes that Article 25(1) of Regulation No 6/2002 lists the grounds on which a Community design may be declared invalid. That list must be regarded as exhaustive, since Article 25 provides that a Community design may be declared invalid only on one of the grounds specified therein. It must be noted that there is no reference there to the bad faith of the proprietor of a contested design<sup>3</sup>.

Moreover, it must be recalled that, in support of its application for a declaration of invalidity, the applicant relied on the lack of novelty and individual character of the contested design for the purposes of Article 25(1)(b) of Regulation No 6/2002 and the existence of a prior right for the purposes of Article 25(1)(d) thereof. Therefore, in examining those grounds for invalidity, the question of the alleged bad faith of the intervener is irrelevant, since it is not a matter of ruling on the conduct of the proprietor of a contested design<sup>4</sup>.

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<sup>3</sup> Paragraph 30.

<sup>4</sup> Paragraph 31.

Lastly, contrary to the applicant's claims, the date on which the design relied on in support of the application for a declaration of invalidity is made available to the public is one of the conditions for the application of Article 25(1)(b) and (d) of Regulation No 6/2002. The applicant states that the prior design was «disclosed» to the intervener on a private and confidential basis, by a letter of 21 February 2003 and made available to the public on 1 November 2003. Therefore, it must be found that the design was not made available to the public on 21 February 2003 and that that «disclosure» cannot be relied on for the purpose of applying Article 25(1)(b) and (d) of Regulation No 6/2002<sup>5</sup>.

Consequently, the plea in law alleging the bad faith of the intervener and a restrictive interpretation of Regulation No 6/2002 must be rejected<sup>6</sup>.

As a next step, the General Court examined the alleged violation of Article 25(1)(d) of Regulation No 6/2002 and explained:

«Under Article 25(1)(d) of Regulation No 6/2002, a Community design may be declared invalid if it is in conflict with a prior design which has been made available to the public after the date of filing of the application or, if a priority is claimed, the date of priority of the Community design, and which is protected from a date prior to the said date by a registered Community design or an application for such a design, or by a registered design right of a Member State, or by an application for such a right<sup>7</sup>.

Since «conflict» is not defined as such in Regulation No 6/2002, it is necessary to clarify that concept. At paragraphs 14 and 15 of the contested decision, the Board of Appeal found, like the Invalidity Di-

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5 Paragraph 32.

6 Paragraph 33.

7 Paragraph 47.

vision, that a conflict arose between two designs when they produced the same overall impression on the informed user, and that in that connection the degree of freedom of the designer in developing the contested design had to be taken into account<sup>8</sup>.

For the purposes of the interpretation of Article 25(1)(d) of Regulation No 6/2002, it must be recalled that, in accordance with Article 10 of Regulation No 6/2002 in the case of a Community design, and Article 9 of Directive 98/7<sup>9</sup> in the case of a design registered in a Member State, the scope of the protection conferred by a design is to include any design which does not produce on the informed user a different overall impression and that, in assessing the scope of that protection, the degree of freedom of the designer in developing his design is to be taken into consideration<sup>10</sup>.

In that connection, it must be noted, first of all, that in the vast majority of the language versions, the wording of Article 10(1) of Regulation No 6/2002, like that of Article 9(1) of Directive 98/71, indicates that the issue is one of a «different overall impression». Two language versions (namely the French and Romanian language versions) in the case of Article 10 of Regulation No 6/2002, and one language version (namely the French language version) in the case of Article 9 of Directive 98/71, state that the issue is one of a «different overall visual impression». However, since, under Article 3(a) of Regulation No 6/2002 and Article 1(a) of Directive 98/71, a design is only the appearance of the whole or a part of a product, it must be found that the overall impression to which Article 10(1) of Regulation No 6/2002 and Article 9(1) of Directive 98/71 refer must be a visual one. Thus, the difference in wording between the language versions does not confer a different meaning in that respect on that provision<sup>11</sup>.

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8 Paragraph 48.

9 Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs (OJ 1998 L 289, p. 28).

10 Paragraph 49.

Next, it is apparent from Article 10(2) of Regulation No 6/2002 and from Article 9(2) of Directive 98/71 that, in assessing whether a design is in conflict with a prior design, the designer's freedom in developing his design is to be taken into consideration<sup>12</sup>.

Consequently, Article 25(1)(d) of Regulation No 6/2002 must be interpreted as meaning that a Community design is in conflict with a prior design when, taking into consideration the freedom of the designer in developing the Community design, that design does not produce on the informed user a different overall impression from that produced by the prior design relied on. The Board of Appeal was therefore correct to adopt such an interpretation<sup>13</sup>.

That interpretation of Article 25(1)(d) of Regulation No 6/2002 is the only one which can ensure that the rights of the proprietor of a prior design that is referred to in that provision is protected against any infringement of the design resulting from the coexistence of a subsequent Community design that produces the same overall impression on the informed user. If Article 25(1)(d) of Regulation No 6/2002 were not interpreted in that manner, the proprietor of a prior right would be precluded from applying for a declaration of invalidity in respect of a subsequent Community design that produces the same overall impression and be deprived of the actual protection conferred by his design under Article 10 of Regulation No 6/2002 or Article 9 of Directive 98/71<sup>14</sup>.

– The product in which the contested design is intended to be incorporated or to which it is intended to be applied

The applicant challenges the contested decision inasmuch as the Board of Appeal defined the category of goods identified by the

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11 Paragraph 50.

12 Paragraph 51.

13 Paragraph 52.

14 Paragraph 53.

designs at issue as being that of «pogs», «rappers» or «tazos», whereas those products are not a homogeneous category of goods. The applicant submits that the Board of Appeal ought to have taken into consideration the category of promotional items for games<sup>15</sup>.

The Court observes that, under Article 3(a) of Regulation No 6/2002, a design is the appearance of a product, and Article 36(2) of that regulation requires that an application for a registered Community design is to contain an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied. However, it must be pointed out that, although the indication of those products in the application for a registered Community design is compulsory, that information does not, by virtue of Article 36(6) of Regulation No 6/2002, affect the scope of protection of the design as such<sup>16</sup>.

Accordingly, it follows from Article 36(6) of Regulation No 6/2002 that, in order to ascertain the product in which the contested design is intended to be incorporated or to which it is intended to be applied, the relevant indication in the application for registration of that design should be taken into account, but also, where necessary, the design itself, in so far as it makes clear the nature of the product, its intended purpose or its function. Taking into account the design itself may enable the product to be placed within a broader category of goods indicated at the time of registration and, therefore, to determine the informed user and the degree of freedom of the designer in developing his design<sup>17</sup>.

It must be recalled that, at paragraphs 16 and 20 of the contested decision, the Board of Appeal found that the products in which the designs at issue are intended to be incorporated or to which they

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15 Paragraph 54.

16 Paragraph 55.

17 Paragraph 56.

are intended to be applied were known as «pogs» or «rappers» in English, or «tazos» in Spanish, whereas the Invalidity Division had taken into consideration the category «promotional items for games»<sup>18</sup>.

In the present case, the contested design was registered for the following goods: «promotional item[s] for games»<sup>19</sup>.

Although the parties agree that the contested design is intended to be applied, like the prior design, to promotional items for games, an examination of the design shows that it belongs to a particular category of those promotional items. In addition, as the Board of Appeal noted at paragraph 17 of the contested decision, the intervenor submitted evidence to the Board of Appeal concerning the goods in question, in particular evidence concerning «tazos», which it has been marketing since 1995. Thus, the Board of Appeal was entitled to find that the intervenor had thereby enabled the nature and function of the goods, game pieces known as «pogs», «rappers» or «tazos», actually to be determined. Moreover, at paragraph 16 of the contested decision, the Board of Appeal stated that those specific promotional items for games were intended for young children and that they were generally used to promote biscuits or potato snacks, which is agreed by the parties<sup>20</sup>.

Accordingly, it must be concluded that the Board of Appeal properly found that the product in question belonged, within the broad category of promotional items for games, to the particular category of game pieces known as «pogs», «rappers» or «tazos»<sup>21</sup>.

– The informed user

The applicant challenges the contested decision inasmuch as the Board of Appeal found that the informed user could also be a

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18 Paragraph 57.

19 Paragraph 58.

20 Paragraph 59.

21 Paragraph 60.

marketing manager, whereas, in the present case, the informed user is a child in the approximate age range of 5 to 10<sup>22</sup>.

It must be found that the informed user is neither a manufacturer nor a seller of the products in which the designs at issue are intended to be incorporated or to which they are intended to be applied. The informed user is particularly observant and has some awareness of the state of the prior art, that is to say the previous designs relating to the product in question that had been disclosed on the date of filing of the contested design, or, as the case may be, on the date of priority claimed<sup>23</sup>.

In that connection, although the Board of Appeal did not define the informed user precisely in the present case, it did not, contrary to the applicant's claims, rule out the possibility that he could be a child in the approximate age range of 5 to 10<sup>24</sup>.

The Board of Appeal was correct to find, at paragraphs 16 and 17 of the contested decision, that the informed user could be a child in the approximate age range of 5 to 10 or a marketing manager in a company that makes goods which are promoted by giving away «pogs», «rappers» or «tazos». It follows from the definition of the informed user as set out at paragraph 62 above that, in the present case, since the products to which the contested design is intended to be applied are «pogs», «rappers» or «tazos», the informed user must be regarded as having some awareness of the state of the prior art thereof. In addition, since the game pieces are intended more specifically for children, the informed user may, as the Board of Appeal stated in the contested decision, be a child in the approximate age range of 5 to 10, which neither OHIM nor the intervener disputes. However, since the goods are also promotional items, in the present case the informed user could also be a marketing manager in a company that uses that type of goods in order to promote its own products<sup>25</sup>.

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22 Paragraph 61.

23 Paragraph 62.

24 Paragraph 63.

As the Board of Appeal made clear at paragraphs 16 and 17 of the contested decision, it makes little difference whether the informed user is a child in the approximate age range of 5 to 10 or the marketing manager in a company that makes products which are promoted by giving away «pogs», «rappers» or «tazos»; the important point is that both those categories of person are familiar with the phenomenon of «rappers»<sup>26</sup>.

– The degree of freedom of the designer

Proceeding on the basis that the contested design relates to the general category of promotional items, the applicant challenges the contested decision inasmuch as the Board of Appeal concluded at paragraph 20 thereof that in the present case the freedom of the designer was severely restricted<sup>27</sup>.

In that connection, it must be noted that the designer's degree of freedom in developing his 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<sup>28</sup>.

At paragraph 18 of the contested decision, the Board of Appeal stated that all the «rappers» or «tazos» examined in the present case consisted of small, flat or slightly curved discs which may be made of plastic or metal. Accordingly, it concluded, at paragraph 20 of that decision, that the freedom enjoyed by the designer responsible for designing a product of that kind was severely restricted, because, for that type of product, «[t]he paradigm is a small flat or nearly flat

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25 Paragraph 64.

26 Paragraph 65.

27 Paragraph 66.

28 Paragraph 67.

disk on which coloured images can be printed [and o]ften the disk [is] curved toward[s] the centre, so that a noise [is] made if a child's finger presses the centre of the disk», and «[a] rapper that does not possess these characteristics is unlikely to be accepted in the marketplace»<sup>29</sup>.

In that connection, it must be noted that «pogs», «rappers» or «tazos» are circular in shape and that, on the date of filing of the application for registration of the contested design, in this case on the date of priority claimed for the design, «pogs», «rappers» or «tazos» had those common features which the designer had to take into account, as set out at paragraphs 18 and 20 of the contested decision and reiterated at paragraph 68 above. That finding is not, moreover, contested by the parties<sup>30</sup>.

Therefore, it must be held that the Board of Appeal was correct to find in the contested decision that, on the date of priority claimed for the contested design, the designer's freedom was severely restricted since he had to incorporate those common features in his design for the product in question. Moreover, as the Board of Appeal pointed out at paragraph 20 of the contested decision, the designer's freedom was also limited in so far as those items had to be inexpensive, safe for children and fit to be added to the products which they promote<sup>31</sup>.

– Overall impression produced by the designs at issue on the informed user

The applicant challenges the Board of Appeal's finding in the contested decision that the designs at issue produce a different overall impression on the informed user<sup>32</sup>.

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<sup>29</sup> Paragraph 68.

<sup>30</sup> Paragraph 69.

<sup>31</sup> Paragraph 70.

<sup>32</sup> Paragraph 71.

In the specific assessment of the overall impression of the designs at issue on the informed user, who has some awareness of the state of the prior art, the designer's degree of freedom in developing the contested design must be taken into account. Thus, as the Board of Appeal pointed out at paragraph 19 of the contested decision, in so far as similarities between the designs at issue relate to common features, such as those described at paragraph 67 above, those similarities will have only minor importance in the overall impression produced by those designs on the informed user. In addition, the more the designer's freedom in developing the contested design is restricted, the more likely minor differences between the designs at issue will be sufficient to produce a different overall impression on the informed user<sup>33</sup>.

As has been reiterated at paragraph 68 above, after establishing, at paragraphs 18 and 20 of the contested decision, the constraints on the designer in developing the contested design, the Board of Appeal found that the designer's freedom was in the present case severely restricted<sup>34</sup>.

At paragraph 19 of the contested decision, the Board of Appeal also stated that, as regards the assessment of the overall impression produced by the designs at issue on the informed user, the latter will automatically disregard elements «that are totally banal and common to all examples of the type of product in issue» and will concentrate on features «that are arbitrary or different from the norm»<sup>35</sup>.

Next, at paragraphs 21 to 24 of the contested decision, the Board of Appeal compared the designs at issue, describing the prior design and then the contested design, before concluding that there was a «difference in the contours of the raised area in the centre of the

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33 Paragraph 72.

34 Paragraph 73.

35 Paragraph 74.

disks». Accordingly, it found, at paragraph 24 of that decision, that, given the limited degree of freedom of the designer in developing the contested design, that difference in the profile was sufficient to conclude that the designs produced a different overall impression on the informed user<sup>36</sup>.

The designs at issue must be compared by reference to the criteria set out at paragraph 72 above, by examining their similarities and their differences, in order to ascertain, taking into account the degree of the designer's freedom in developing the contested design, whether the Board of Appeal was entitled, without committing any error, to conclude that the designs at issue created a different overall impression on the informed user<sup>37</sup>.

As regards the similarities between the designs at issue, first, the Board of Appeal noted, at paragraph 22 of the contested decision, that both designs consisted of small discs that are almost flat. However, since, on the date of priority claimed for the contested design, that was a feature common to the designs for the goods of the type of product at issue, as noted by the Board of Appeal at paragraphs 18 and 20 of the contested decision, that similarity would not be remembered by the informed user in the overall impression of the designs at issue<sup>38</sup>.

Second, the Board of Appeal also observed at paragraph 22 of the contested decision that the designs at issue both had a concentric circle very close to the edge intended to convey the idea that the disc curls over all the way round the edge. It must be noted that the designs at issue may be applied to a metal product, which is not disputed by the applicant or the intervener. Since the product is intended for children in particular, that rounded edge may therefore constitute

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<sup>36</sup> Paragraph 75.

<sup>37</sup> Paragraph 76.

<sup>38</sup> Paragraph 77.

a constraint for the designer, linked to safety requirements, so that the product does not have a sharp edge if made of metal or even of plastic or cardboard. Thus, since that similarity between the designs at issue in respect of one of their features may constitute a constraint on the designer, it will not attract the informed user's attention<sup>39</sup>.

Third, the designs at issue both contain a concentric circle approximately one third of the way from the edge to the centre. At paragraph 22 of the contested decision, the Board of Appeal noted that similarity, stating that that circle was intended to convey the idea that the central part of the disc is raised slightly. However, the Court finds that that central part could have been delineated by a shape other than a circle. For it is apparent from the application for registration of the contested design, included in OHIM's file forwarded to the Court, that the contested design claims the priority of a Spanish design No 157156 which comprises three variants, and that that raised central part is, depending on the variant, delineated by a circle, a triangle or a hexagon. In addition, that finding cannot be called into question by the argument put forward by OHIM, at the hearing, that the shape had to be elementary in order not to distort the image which may cover the disc, since a triangular, hexagonal, or even a square or oval shape instead of circular one would not have distorted the image any more. Furthermore, that finding cannot be called into question by OHIM's argument that a circle had to be used so that that raised central part might be curved, because, inter alia, an oval shape could have been used<sup>40</sup>.

Fourth, the designs at issue are similar in that the rounded edge of the disc is raised in relation to the intermediate area of the disc between the edge and the raised central area<sup>41</sup>.

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39 Paragraph 78.

40 Paragraph 79.

41 Paragraph 80.

Fifth, the respective dimensions of the raised central part and the intermediate area of the disc, between the edge and the raised central part, are similar in the designs at issue<sup>42</sup>.

In the absence of any specific constraint imposed on the designer, the similarities noted in paragraphs 79 to 81 above relate to elements in respect of which the designer was free to develop the contested design. It follows that those similarities will attract the informed user's attention, all the more so because, as the intervener itself stated, the upper surfaces are, in the present case, the most visible surfaces for that user<sup>43</sup>.

As regards the differences between the designs at issue, as the Board of Appeal observed at paragraph 23 of the contested decision, when viewed from above, the contested design has two additional circles compared with the prior design. In profile, the two designs differ in that the contested design is more curved. However, it must be found that since the degree of curvature is slight, and the discs are thin, that curvature will not be easily perceived by the informed user, in particular when viewed from above, and this is borne out by the goods actually marketed, as contained in OHIM's file forwarded to the Court<sup>44</sup>.

In the light of the similarities noted in paragraphs 79 to 81 above, it must be held that the differences observed by the Board of Appeal at paragraph 23 of the contested decision (see paragraph 83 above) are insufficient for the contested design to produce a different overall impression on the informed user from that produced by the prior design<sup>45</sup>.

It follows from all the above considerations that the Board of

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<sup>42</sup> Paragraph 81.

<sup>43</sup> Paragraph 82.

<sup>44</sup> Paragraph 83.

<sup>45</sup> Paragraph 84.

Appeal erred in finding in the contested decision that the designs at issue produced a different overall impression on the informed user and that they were not in conflict within the meaning of Article 25(1)(d) of Regulation No 6/2002. Accordingly, the contested decision was adopted in breach of that provision and must therefore be annulled, it not being necessary to examine the final plea of annulment raised by the applicant<sup>46</sup>.»

### **III. Final Remarks**

In its first judgment on main issues related to the validity and violation of a Community design, the General Court approved the action for Community design infringement. The similarities between the two designs at issue were so manifest, that just no different overall impression was produced. However, the second instance, the Third Board of OHIM, had concluded, also in difference to the first instance, the Invalidity Division of OHIM, that the general impression were different, in spite of certain similarities, and had rejected the action for Community design violation.

In the course of its scrutiny of the Community design infringement, the General Court established at first that the term «conflict», even though mentioned in Article 25(1)(d) of Regulation No 6/2002, is not defined in this Regulation<sup>47</sup>. However, the General Court found an easy way to define the term «conflict» by referring to Article 10 of Regulation No 6/2002 which deals with the scope of design protection<sup>48</sup>: The scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression (Article 10(1) of Regulation No

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<sup>46</sup> Paragraph 85.

<sup>47</sup> Paragraph 48.

<sup>48</sup> Paragraph 49.

6/2002), whereas in assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration (Article 10(2) of Regulation No 6/2002). Moreover, the General Court added in view of the different language versions of Regulation No 6/2002 that Article 10(1) refers exclusively to a «*different overall visual impression*» and not to any general impression defined in any other way<sup>49</sup>.

The General Court faced difficulties to determine the freedom of the designer and the consequences to be concluded therefrom on the scope of design protection. The General Court relied on the freedom of the designer of the younger design<sup>50</sup> – and hence, apparently, on the freedom of the designer at the time of the development of the younger design although it may be created, depending on the circumstances, years after the prior design. As a result, later publications as well as provisions<sup>51</sup> entering into force between the priority date of the prior design and the development of the younger design, provided that they influence the freedom of the designer, retroactively impact the scope of design protection. They lead to a dynamic scope of protection as accepted in general in trademark law<sup>52</sup>.

On the one hand, this opinion of the General Court is not in compliance with that legal doctrine which prefers a static scope of protection under European Community design law. This doctrine asserts that, although the freedom of the designer of the younger design shall be relevant, the relevant date to determine such freedom shall be the priority day of the prior design<sup>53</sup>. «As the scope of protection of

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<sup>49</sup> Paragraph 50.

<sup>50</sup> See paragraphs 49, 52, 56.

<sup>51</sup> E.g., security provisions or other statutory requirements applicable to the product (see paragraphs 67, 70).

<sup>52</sup> See HARTWIG Henning, General Court: Three key lessons from the Court's first decision on validity of a registered Community design (decision of March 18, 2010 – Case T-9/07 – Grupo Promer Mon Graphic SA v OHIM and PepsiCo Inc), The Bardehle Pagenberg IP Report 2010/1, 21.

a Community design shall be set on the priority day and not grow or shrink thereafter»<sup>54</sup>. On the other hand, this dynamic conception as apparently chosen by the General Court is in accordance with a legal doctrine on Swiss<sup>55</sup> and German law<sup>56</sup> which prefers to measure the freedom of the designer based on the point in time when the younger design was created.

Furthermore, the General Court defined the «informed user» according to Article 10(1) of Regulation No 6/2002 against the background of the present case. The «informed user» could be a child in the approximate range of 5 to 10 or a marketing manager in a company that makes goods which are promoted by giving away «pogs», «rappers» or «tazos»<sup>57</sup>, provided that both those categories of person are

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53 RUHL Oliver, Gemeinschaftsgeschmacksmuster, Treatise, 2<sup>nd</sup> ed., Cologne 2010, GGVO 10 N 39; concurring HARTWIG Henning, Das Prinzip der Reziprozität im Geschmacksmusterrecht, GRUR-RR 2009, 201, 203.

54 RUHL (fn. 53), GGVO 10 N 7: «Denn der Schutzzumfang eines Gemeinschaftsgeschmacksmusters sollte mit dem Prioritätstag feststehen und danach nicht mehr wachsen oder schrumpfen.» – «As the scope of protection of a Community design shall be set on the priority day and not grow or shrink thereafter.»

55 HEINRICH Peter, DesG/HMA, Schweizerisches Designgesetz. Haager Musterschutzabkommen, Treatise, Zurich 2002, DesG 8 N 17 («Was gilt, wenn der Grad der Gestaltungsfreiheit mit der Zeit ändert? Dies kann vorkommen, wenn z.B. neue Rechtsnormen oder technische Normen eingeführt werden. Es müsste auf den Zeitpunkt der Beurteilung ankommen, nicht auf den Anmelde- oder Prioritätstag.» – «What matters if the degree of the freedom of the designer changes after some time? This may happen, e.g., in case of new provisions or technical rules. The point in time of the judgment would be relevant, not the application day or priority day.»). However, WANG Markus, Designrecht, in: VON BÜREN Roland/DAVID Lucas (eds.), SIWR VI, Basel 2007, 226, 234, opts for a static design scope of protection, without adding conclusions to the relevant point in time to determine the freedom of the designer.

56 EICHMANN Helmut/VOGEL VON FALCKENSTEIN Roland, Geschmacksmustergesetz, Treatise, 3<sup>rd</sup> ed., Munich 2005, GeschmMG 38 N 28 («Massgeblich für die Beurteilung des Schutzzumfangs ist der Zeitpunkt, in dem das beanstandete Muster entworfen worden ist. Bis zu diesem Zeitpunkt können nach dem für die Beurteilung der Eigenart massgeblichen Zeitpunkt weitere Gestaltungen so offenbart worden sein, dass sie sich auf den Gestaltungsspielraum einengend auswirken können.» – «The point in time of the development of the contested design is relevant to assess the scope of protection. Up to this point in time and after the time relevant to assess the individual character of the design, additional creations may be disclosed in a way which may narrow the freedom of the designer.»).

familiar with the phenomena of «rappers»<sup>58</sup>. The General Court did not respond to the criticism raised in the legal doctrine (with respect to the corresponding reasoning in the previous decision of the Third Board of Appeal of OHIM), according to which a child and a manager might hardly have the same perception as the former «*clearly focuses on fun and play factor of the rappers, whereas a manger will – at least additionally – also look at the marketing features of the promotional item*»<sup>59</sup>.

In the case at issue, neither the prior nor the contested design was registered for «pogs», «rappers» or «tazos»; the former was rather registered for «metal plate[s] for games», the latter for «promotional item[s] for games» (cf. Article 36(2) of Regulation No 6/2002). However, the General Court concluded *that, in order to ascertain the product in which the contested design is intended to be incorporated or to which it is intended to be applied, the relevant indication in the application for registration of that design should be taken into account, but also, where necessary, the design itself, in so far as it makes clear the nature of the product, its intended purpose or its function. Taking into account the design itself may enable the product to be placed within a broader category of goods indicated at the time of registration and, therefore, to determine the informed user and the degree of freedom of the designer in developing his design*<sup>60</sup>.

Although Article 36(6) of Regulation No 6/2002 states that the indication of products in the application for a design does not affect the scope of protection of the design as such, the General Court therewith created a connection between the indication of products in the application of the prior design (Article 36(2) of Regulation No 6/2002) and the informed user (Article 10(2) of Regulation No 6/2002). This at

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57 Paragraph 64; see also paragraph 62.

58 Paragraph 64–65.

59 TRAUB (fn. 2), 291–292.

60 Paragraph 56.

least triggers the question whether and to which extent the General Court, contrary to Article 36(6) of Regulation No 6/2002, goes for a concrete conception of design protection (so-called «principle of speciality»)<sup>61</sup>.

However, the legal doctrine on European design law predominantly opts for an abstract conception of design protection, in particular, by reference to Article 36(6) of Regulation No 6/2002, the evident lack of indication of products in case of unregistered Community designs, and the Design Directive 98/71<sup>62</sup> which neither requires the indication of a product in case of design applications. The doctrine maintains that the objective to be protected would be the shape of the design, not the product as such<sup>63</sup>. Though, this abstract conception does not exclude that the informed user of the contested design is regarded as the informed user pursuant to Article 10(2) of Regulation No 6/2002<sup>64</sup>.

As a result, the judgment of the General Court may indeed strengthen design protection in general. In view of rather modest differences between the designs to be considered, the General Court recognized a design infringement even though few variations are possible in case of simple products such as the metal plates at issue and, hence, the freedom of the designer is «*severely restricted*». Still, European design case, in particular related to the abstract or concrete development of design protection, awaits its further development.

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61 Cf. HARTWIG (fn. 52), 21.

62 See fn. 9.

63 Regarding these issues in general see RUHL (fn. 53), GGVO 3 N 6, GGVO 6 N 77 et seq., GGVO 10 N 49–50, with further references. – The abstract conception is also accepted by the England and Wales Court of Appeal (2008), EWCA, Civ. 358, consid. 6 et seq., 54–55 (see HARTWIG Henning, *Designschutz in Europa. Design Protection in Europe*, Vol. 3, Cologne 2009, 234 et seq. – Green Lane/PMS, with comments by BRÜCKNER-HOFMANN Johanna).

64 RUHL (fn. 53), GGVO 10 N 49.