



# Overlap between RCDs and EUTMs

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Speaker:

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*\* This document contains the answers to questions submitted by the audience during the webinar that could not be answered during the live session.*

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## Questions and answers – Overlap between RCDs and EUTMs

Regarding the loudspeaker case, any design adds value to the appearance of a product, because this is the definition of a design. Why is the loudspeaker refused registration if it has individual character?

Please note that **registration was sought for the three-dimensional trade mark in this case, not a design.**

Therefore, **trade mark registrability criteria applied**, which were different from the ones that would be applicable to designs. The trade mark applied for was refused as it fell within **the scope of Article 7(1)(e)(iii) EUTMR** and thus **consisted of a shape**, or another characteristic, which gives substantial value to the goods. **This ground for non-registrability does not exist in design law.**

Please see **the General Court's judgment in T-508/08** for more information.

## Questions and answers – Overlap between RCDs and EUTMs

Would you say that what the US doctrine and law calls ‘trade dress’ should be most properly protected in the EU as a design, rather than as an EUTM?

**That depends on what we consider as a ‘trade dress’ and what exactly we want to protect and why.**

**The Wikipedia definition** notes that ‘trade dress is the characteristics of the visual appearance of a product or its packaging (or even the design of a building) that signify the source of the product to consumers’.

**This definition partly complies with the one we have in Art. 3 CDR**, as design is the appearance of product. However, **designs do not signify or otherwise distinguish the source of origin for consumers, this ‘source of origin’ function is alien to designs.**

In addition, it should be stressed that ‘trade dress’ would usually contain many elements of design protection (shape, colour, arrangements or numbers of various items), but if all protected as one design, the scope of protection would be very much limited.

**Other design criteria such as novelty or requirements for sets of articles would also apply. The choice between trade marks and designs also depends on business strategy.**

## Questions and answers – Overlap between RCDs and EUTMs

What are the plans for the EU design regulation modification in terms of representing screen displays and icons that are moving and not static?

Please see the **Commission's proposal for the new Designs Directive** and **the new Amending regulation** as made publicly available at the end of 2022.

They introduce **'digital designs'** and **allow, inter alia, design representation by dynamic views.**

## Questions and answers – Overlap between RCDs and EUTMs

Did you say that priority is 1 year?

According to the RCD guidelines and Paris convention it is 6 months.

In the presentation, we spoke about the 12-month **‘grace period’** under Art. 7(2) CDR. This is **not the same as ‘priority’** under Art. 41 CDR.

## Questions and answers – Overlap between RCDs and EUTMs

A question regarding the DIESEL design invalidation case: if a disclaimer for the word DIESEL is filed for the design, would the design survive?

Most likely it would survive.



## Questions and answers – Overlap between RCDs and EUTMs

Would the outcome of the CROC case have been different based on the EU design of a croc shoe?

We understand the question refers to **BoA, 06/06/2019, R 388/2018-3, Footwear.**

The relevant public would be the entire EU, so the possible meanings of the verbal element in other EU member states would have to be assessed.

If it were descriptive, it could perhaps have led to another outcome, although this would still be unlikely.

## Questions and answers – Overlap between RCDs and EUTMs

About the Crocs case: so the TM was not distinctive in the first place being just a basic shoe shape?

The **inherent distinctive character of the earlier mark was low**, as it consisted of a drawing that depicted the basic features of a clog and only departed from that basic shape of a clog with respect to the perforated cover and the vents on the side.

The **Board of Appeal** found that **consumers would perceive these features as a mere variant of the basic shape**. They do not generally perceive the shape of a product as distinctive, but rather focus on the verbal elements.

## Questions and answers – Overlap between RCDs and EUTMs

Do you expect any changes on the matter of overlapping between TMs and designs after the new Design Directive is approved?

We would need to see the **final version of the proposed Designs Directive** first, but obviously, if the representation requirements are amended and movement is allowed protection through the submission of, inter alia, video files, it could be expected that more designs would be protected.

This is because it could be assumed that due to the limited design representation requirements and well as also possibly unclear definitions, some products (especially moving and other virtual items, dynamic graphical user interfaces, virtual spaces) are currently protected as trade marks but not designs.

## Questions and answers – Overlap between RCDs and EUTMs

Have you found any case where a previous design could invalidate a trademark? I think all the presented cases were not successful.

I could not find any while preparing the presentation, but of course it's possible there could be a few.

## Questions and answers – Overlap between RCDs and EUTMs

Which should we apply for first ?

I understand the question **refers to designs and trade marks**.

The **decision is a strategic one** and **depends upon many factors**: prices, subject matter of protection, adherence to design and trade mark protection requirements and most importantly, business strategy of the applicant.

I touch upon this a bit in the presentation.

## Questions and answers – Overlap between RCDs and EUTMs

In the case of the Vespa Shape TM, shouldn't the post sale confusion be considered to invalidate the design?

Criteria as established in the law and developed by case law are to be applied to invalidate a design.

It was indeed the assessment of the possible likelihood of confusion in this case.

Please see the **judgment of the General Court of 24/07/2019, T-219/18, Motorcycles** for more details.

## Questions and answers – Overlap between RCDs and EUTMs

As a lipstick business owner, would you advise trade mark or design protection?

It all **depends on the business strategy** and **all the other** elements such as costs and the object of protection (e.g. is this lipstick new and does it have individual character?).

Obviously, **if the object of protection is worth it and the resources are available to obtain and maintain protection, it would be advisable to protect both.**

## Questions and answers – Overlap between RCDs and EUTMs

In the clogs case, was the filing date of the earlier TM not checked? If the design application for the clogs was filed more than a year after the TM then can the design be considered to no longer be novel at the time of filing?

In the **present case** the claim was raised on another ground, namely **Art. 25(1)(e) CDR**.

However, it **could be also raised under Arts. 5 and 6 CDR in conjunction with Art. 25(1)(b) CDR**, claiming that the contested design lacks novelty and individual character. **In such a scenario, the earlier trade mark should have been disclosed earlier and would serve as a prior art to invalidate the contested design.**



## Questions and answers – Overlap between RCDs and EUTMs

Is reputation of unregistered rights in the UK accrued pre-Brexit still valid in cancellation cases?

Please refer to the **EUIPO Guidelines** for a more detailed answer to this question.

## Questions and answers – Overlap between RCDs and EUTMs

Please clarify the individual character requirement for a design as compared to the distinctiveness requirement for trade marks.

Please refer to the **EUIPO Guidelines** on this particular question, it would be difficult to explain in in few paragraphs.

All in all, these two concepts are completely different and unrelated.

## Questions and answers – Overlap between RCDs and EUTMs

If an RCD is challenged on the basis of a LoC with an EUTM, are the RCD Locarno classes taken into account in the identity/similarity test for the relevant goods?

Please see the **EUIPO Guidelines**:

*The Office will examine for which goods the contested Community design is intended to be used (12/05/2010, T-148/08, Instruments for writing, EU:T:2010:190, § 108).*

*For the purpose of determining whether these goods and services are identical or similar, the Office will take into account the indication of the product(s) in which the design is intended to be incorporated or to which it is intended to be applied (Article 36(2) CDR), and also the design itself, insofar as it makes clear the nature of the product, its intended purpose or its function (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 56; 07/11/11, R 1148/2010-3, PACKAGING, § 34-37).*

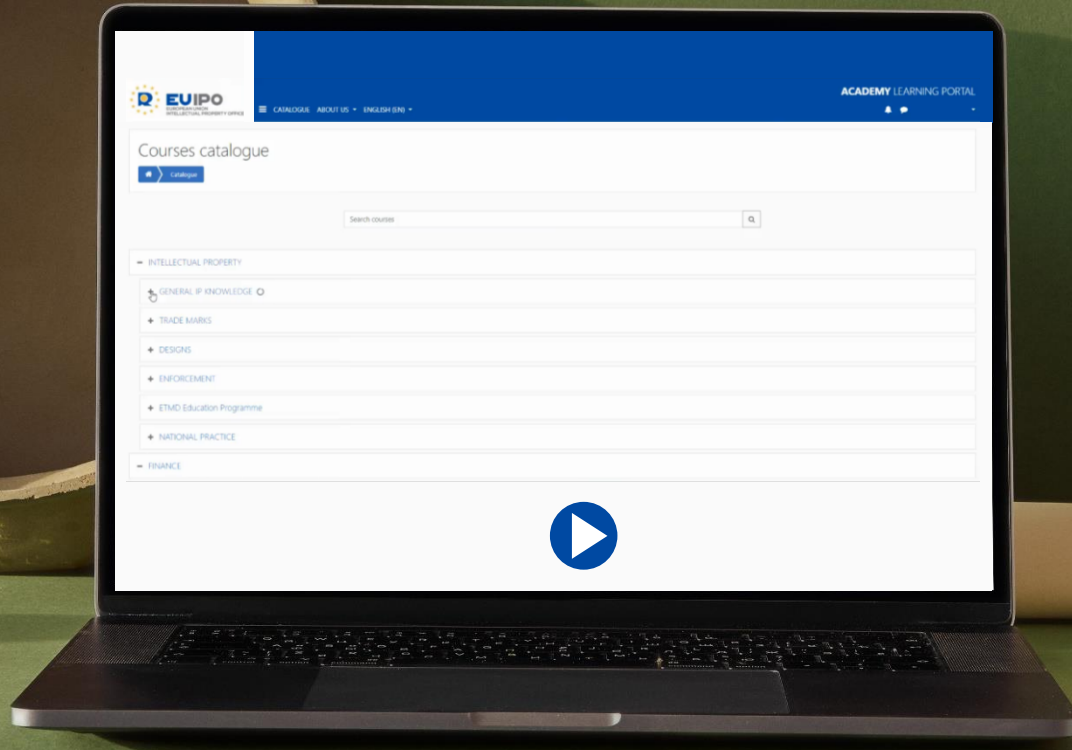
*Where the Community design is intended to be incorporated in two-dimensional ‘logos’, the Invalidity Division will consider that such logos may be applied to an infinite range of products and services, including the products and services in respect of which the earlier distinctive sign is protected (03/05/2007, R 609/2006-3, logo MIDAS, § 27).*

## Questions and answers – Overlap between RCDs and EUTMs

In the last slide would the shoe on the right be an RCD?

The shoe on the left is a contested RCD and the sign on the left is an earlier EUTM.

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