

ALLEN & OVERY



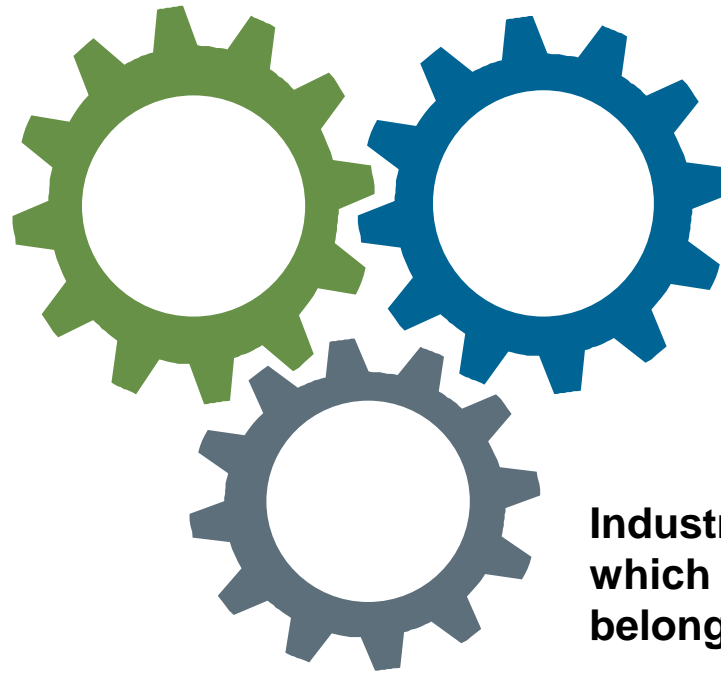
A Suggested New Approach to Design Freedom

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Design Freedom is relevant to the assessment of Individual Character: Recital 14 of the Designs Regulation

Degree of freedom of the designer



Nature of Product

Industry Sector to which the product belongs

Only design freedom is enacted into the text of the Design Regulation

Design freedom plays a role in assessing validity

In order to be valid, a Community design must

have **individual character** (Art. 6 of Designs Regulation), i.e. the overall impression on the informed user must differ from the overall impression produced on such a user by any design which has been made available to the public

In assessing individual character, **the degree of freedom of the designer** in developing the design shall be taken into account (Art 6(2) of Designs Regulation)

There are identical provisions in the Designs Directive

Design freedom plays a role in enforcement

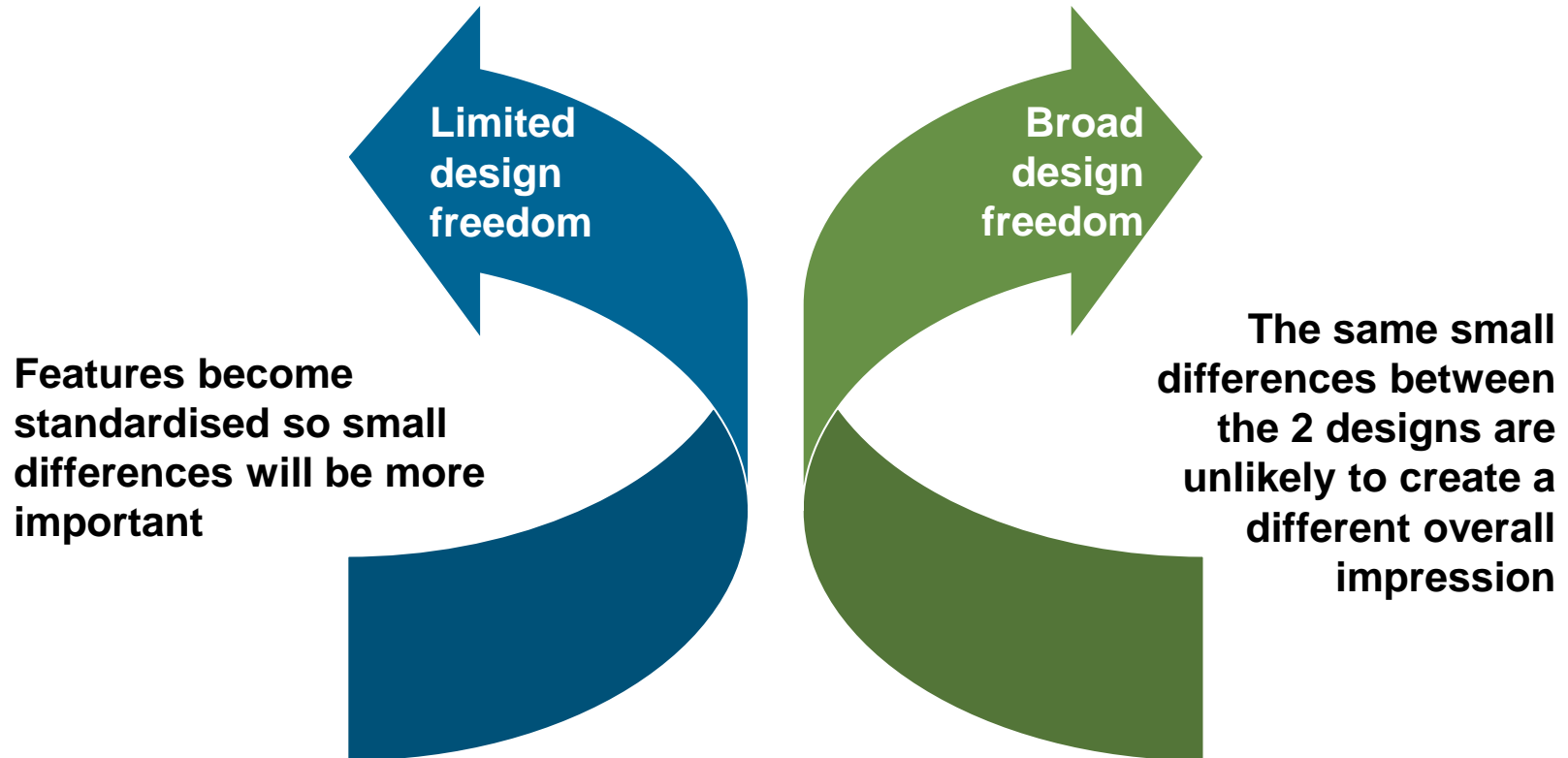
The scope of protection of a Community Design includes:

Any design which does not produce on the informed user a different overall impression (Art 10(1))

In assessing the scope of this protection, the degree of freedom of the designer in developing his design shall be taken into account (Art 10(2))

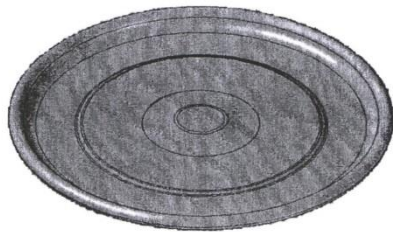
There are identical provisions in the Designs Directive

Freedom of designer in developing the design may have an impact on the outcome of a design dispute



Early case: *PepsiCo v Grupo Promer Mon Graphic* (C-281/10P and T-9/07)

RCD No. 000074463-0001



Invalidity Division considered technical restrictions and market expectations

Board of Appeal: “a rapper that does not possess [characteristics to make noise when child presses the centre of the disk] is unlikely to be accepted in the marketplace”

General Court: designer’s freedom was severely restricted – promotional item in the form of a rapper

- Relatively small differences suffice to create a different overall impression

Advocate General rejected wide interpretation of design freedom but thought the only relevant constraints were those “*dictated by the need for the goods to fulfil a certain function*”.

- more than pure technical function?

Assessing the product category

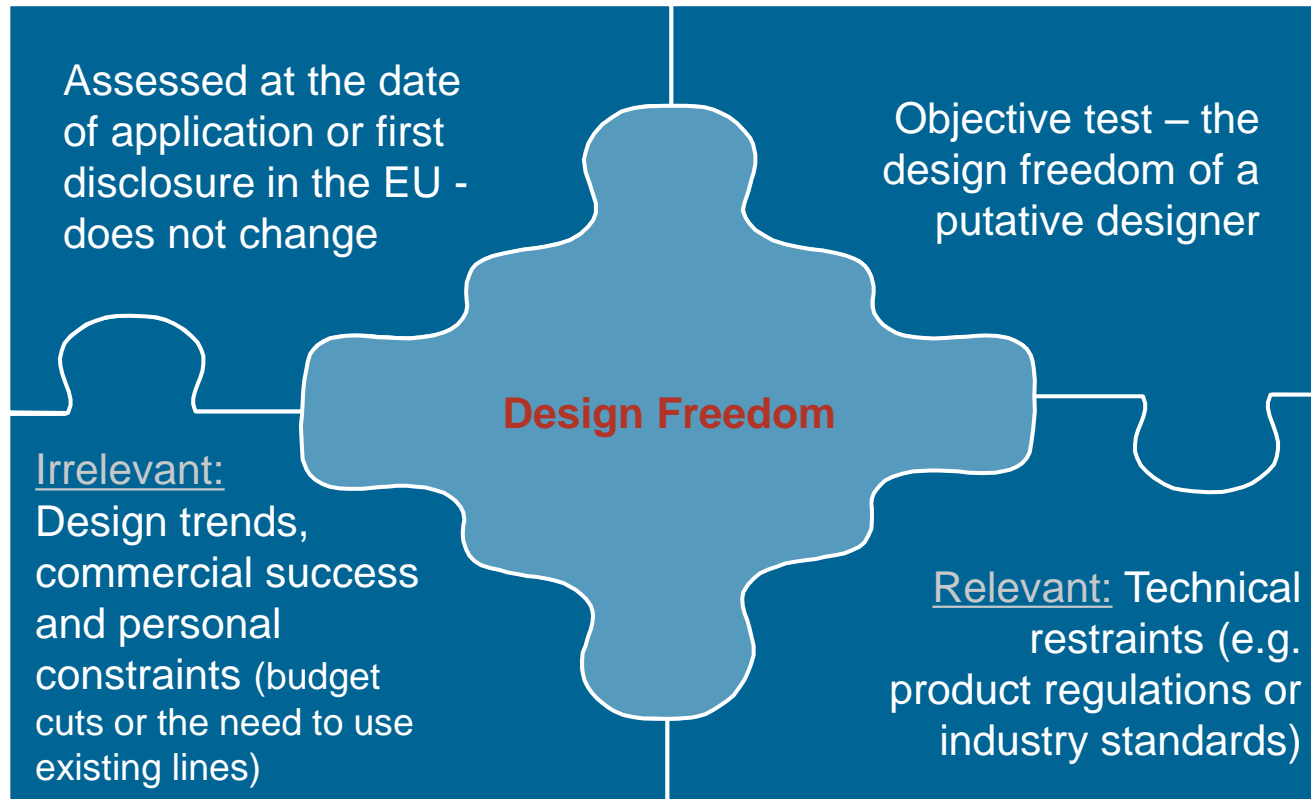
Sinochem Ningbo v Delta-Sport

RCD No. 000640990-0001



- When validity challenged, holder argued that there was limited design freedom because the “two-ring structure” was necessary to make a foldable lounge rocking chair
- BOA: relevant design sector was rocking-chairs, not foldable lounge rocking-chairs
 - Nothing in the representation of the design suggests it is to be applied to foldable rocking-chairs only

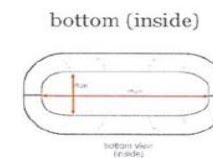
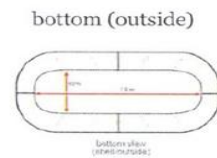
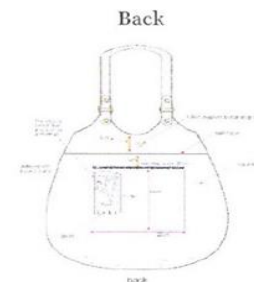
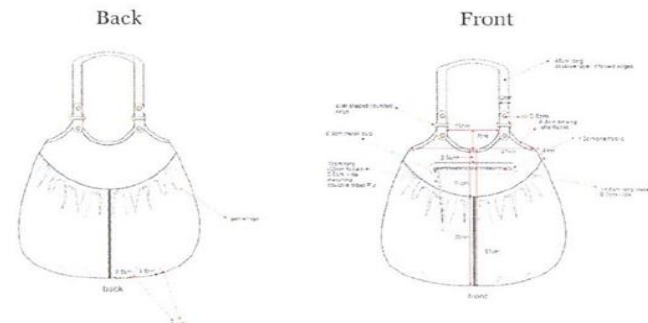
Design Freedom: Points to be drawn from the case law



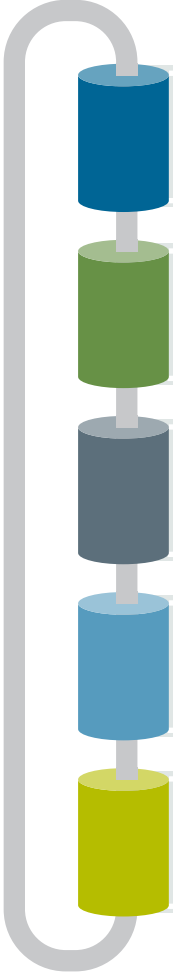
Broad design freedom: *H&M v Yves Saint Laurent* (T-525/13 and T-526/13)

RCD 613294-0001

Prior Design



Broad design freedom: *H&M v Yves Saint Laurent* (T-525/13 and T-526/13)



The degree of freedom of the designer of handbags is high

Freedom of designer cannot on its own determine individual character
- it is one factor to be taken into consideration as part of a multifactorial assessment

Rejected a mathematical application of design freedom – look at the “overall impression”

Rejected “reciprocity” – there is some interdependence between freedom of the designer and the strictness of the assessment of individual character – but no systematic relationship

What matters is how two designs differ. Designs which show “clear blue water” have broad protection

Limited design freedom

Heijan Yu v Leina-Werke (R-979/2011/ 13)

RCD No. 000466578-0001

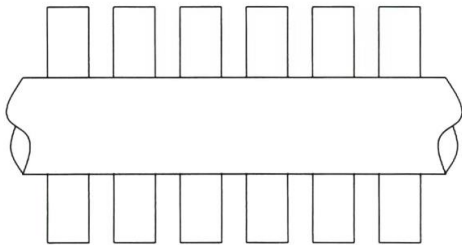


- Not lawful to sell a warning triangle with different appearance
- BOA: Smallest of differences ought to have been sufficient to create a different overall impression but preferable not to grant monopoly in a design that ought to have no real scope of protection

Design freedom and saturated design corpus

Antrax v The Heating Company (T-83/11 and T-84/11)

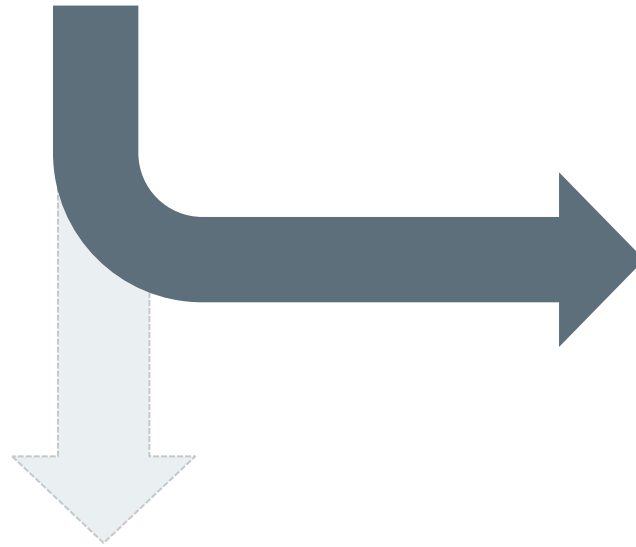
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- General Court: There was no restriction on design freedom – no technical or statutory constraints. General design trends are not restrictions.
- But there was a saturated design corpus so the informed user would pay more attention to small differences

Restrictions on the freedom of the designer will be rare and restricted to technical and statutory constraints

Design freedom in the future: A lesser role?



Restricted design freedom

- RARE (only because of technical or statutory restraints)
- 2 designs can be close without creating the same overall impression

“Broad” design freedom

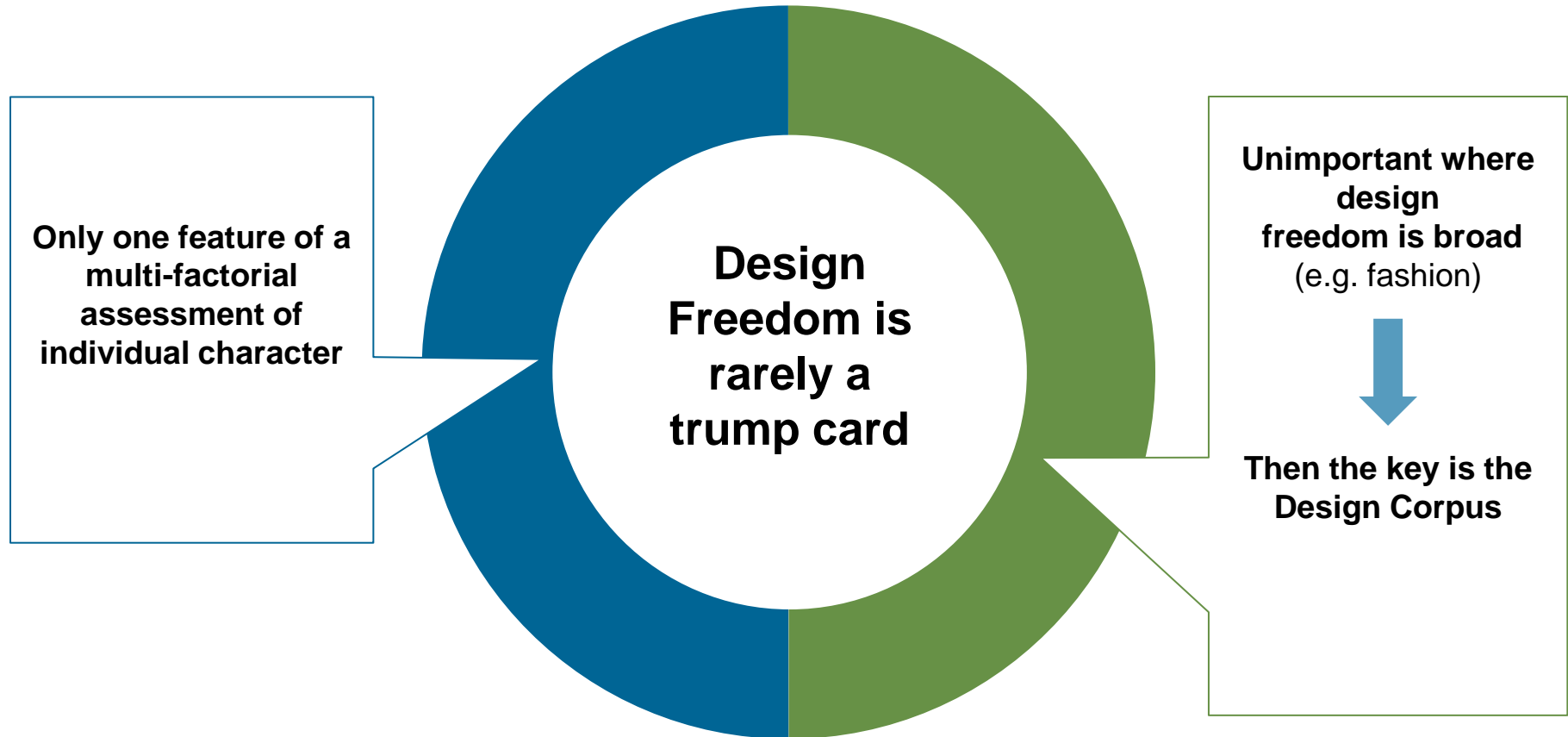
- Default position – designers are rarely restricted (and can redesign)
- Does not mean 2 designs need to be further apart

DESIGN CORPUS becomes key

Crowded Design Corpus

- Informed user pays close attention to small details
- 2 designs can be closer together but still create a different overall impression on the informed user

Design freedom in the future: A lesser role?



Questions?

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