

Community Design: Cinderella Revamped

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This article aims to give a cursory assessment of the advantages and the drawbacks of the new Community design compared with the Community trade mark and 15 national copyrights. Beforehand, the authors briefly review a few controversial features or basic tenets of Council Regulation 6/2002 on Community designs which may affect the design's attractiveness and accordingly carry weight in the intended comparison. By way of background, the introduction sets the framework for protecting the shape of a product within the European Union.

The European New Deal and the Cornucopia

If a designer seeks to protect his or her latest product's design,¹ a cornucopia, still enriched by the European new deal, offers him or her a wide choice among at least seven potential protections:

- European Community protections: (1) Community unregistered design; (2) Community registered design; (3) Community trade mark;
- national or regional (in the Benelux) protections: (4) national or Benelux design; (5) national or Benelux trade mark;
- national protections: (6) copyright, and possibly (7) unfair competition.

Indeed, the European new deal comprises four main lines:

- The Directive² approximates (or “harmonises”) most substantive provisions of national (or

Benelux) design laws; it was to be implemented by Member States not later than October 28, 2001.³

—The Regulation⁴ creates a unitary Community *unregistered* design right (“UCD”); this has effect since the Regulation entered into force on March 6, 2002.

—The Regulation also creates a unitary Community *registered* design right (“RCD”), for which the OHIM⁵ in Alicante, Spain, is to receive applications; its effect was subject to implementing rules which came into force over Christmas 2002.⁶

—Above all, the Directive and the Regulation both allow design right to overlap (or “cumulate”) with national copyright⁷ and other national forms of protection⁸; in practice, national copyright protection will remain vital.

The substantive provisions of Regulation 6/2002 are modelled on the Design Directive 98/71, while its formal provisions are modelled on the Community Trade Mark Regulation 40/94.⁹

The Regulation in Three Keywords: Twofold, Unitary and Cumulative

A twofold Community design: unregistered v registered (UCD v RCD)

Unregistered and registered Community designs may be cumulated and are subject to the same requirements for protection.¹⁰ Apart from the registration aspect, UCD and RCD differ in four major respects:

Commencement and term

UCD subsists for a period of three years as from the date on which the design was first made available to the public within the Community.¹¹ RCD subsists for a period of five years as from the date of the filing (not registration) of the application; the rightholder may have the term of protection renewed for one or more periods of five years each, up to a total term of 25 years

3 Only three Member States, Italy, France and Denmark, met the deadline—the United Kingdom and Ireland were slightly late. Since October 28, 2001, litigants in the 10 Member States lagging behind are entitled to invoke the famous *Marleasing* jurisprudence whereby inconformant national laws are, as far as possible, to be construed consistently with an unimplemented Directive.

4 Council Regulation 6/2002 of December 12, 2001 on Community designs [2002] O.J. L03/1.

5 Office for Harmonisation in the Internal Market (Trade Marks and Design). See Arts 102–106 of the Regulation.

6 See Commission Regulation 2245/2002 of October 21, 2002 implementing Council Regulation 6/2002 on Community designs [2002] O.J. L341/28 and Commission Regulation 2246/2002 of December 16, 2002 on the fees payable to the OHIM in respect of the registration of Community designs [2002] O.J. L341/54. It is understood that the filing of RCD applications might commence after Christmas 2002, but with effect as of April 1, 2003.

7 Art.96.2 of the Regulation and Art.17 of the Directive.

8 Art.96.1 of the Regulation and Art.16 of the Directive.

9 Council Regulation 40/94 of December 20, 1993 on the Community Trade Mark [1994] O.J. L011/1.

10 See below.

11 Art.11 of the Regulation. As to such a vague commencement date, see below.

1 Throughout this article, “design” takes on either of the following meanings according to context: (1) outer appearance of a product; or (2) intellectual property right subsisting in (1).

2 Directive 98/71 of the European Parliament and of the Council of October 13, 1998 on the legal protection of designs [1998] O.J. L289/28–35.

from the date of filing.¹² But by definition, RCD may only be relied on once it is registered (following filing). Note that the dates of UCD (Community) disclosure and RCD filing are also used in assessing their novelty and individual character.¹³

Invalidity (in connection with registration)

UCD may only be declared invalid by a Community design court ("CDC"), *i.e.* a specialised national court,¹⁴ on application to such a court or on the basis of a counterclaim in infringement proceedings.¹⁵ RCD may be declared invalid either on application to the OHIM, which has exclusive jurisdiction on such direct claim, or by a CDC on the basis of a counterclaim in infringement proceedings.¹⁶

Infringement

UCD is a right only to prevent copying, not independent work by designers who are reasonably unfamiliar with the design¹⁷; UCD also covers secondary infringements as it extends to trade in products embodying infringing designs,¹⁸ regardless of good faith.¹⁹ RCD is an exclusive right against the whole world, including independent designers²⁰ save (bona fide) personal right of prior use.²¹ Unlike UCD, a RCD holder enjoys (rebuttable) presumptions of ownership²² and validity²³ in infringement proceedings.

Dealings and rights in rem

Transfer and rights *in rem* are regulated as for RCD only.²⁴ However, either Community design may be licensed.²⁵

A unitary Community design and the resources of forum-shopping

Recital 5 of the Regulation states the basic aim of creating a Community design, which is directly applicable in each Member State, so as "to obtain, through one application made to the OHIM in accordance with a single procedure under one law [if RCD], one design right for one area encompassing all Member States [whether UCD or RCD]".

Art.1.3 of the Regulation accordingly sets out the fundamental tenet of the Community design (whether unregistered or registered), similarly to the Community trade mark:

"A Community design shall have a unitary character. It shall have equal effect throughout the Community. It shall not be registered, transferred or surrendered or be the subject of a decision declaring it invalid, nor shall its use be prohibited, save in respect of the whole Community. This principle and its implications shall apply unless otherwise provided in this Regulation."

Such a unitary character entails important corollaries, in particular:

(1) *Registration is procedurally centralised, albeit substantively very partially unified. In this connection, invalidity is substantively unified, albeit procedurally very partially centralised.*

(a) Registration is procedurally centralised as solely taking place with the OHIM (and national offices are to forward applications²⁶) (Art.35 of the Regulation).

(b) Registration is substantively very partially unified owing to the virtual lack of substantive examination at the OHIM stage—only definition and public policy, not the novelty and individual requirements (Arts 45 & 47 of the Regulation).

(c) Invalidity is substantively unified since the grounds for invalidity are enshrined in one law (Art.25 of the Regulation) and Community design courts ("CDC"), *i.e.* specialised national courts,²⁷ are bound to apply the provisions of the Regulation (Art.88.1 of the Regulation).

In practice, this substantive unification is achieved by European-wide *res judicata*, *i.e.* binding effect, of final decisions as to invalidity of Community designs.

—OHIM final decisions are binding on CDC (Art.86.5 of the Regulation); conversely,

—CDC final decisions are binding on the OHIM (Art.52.3 of the Regulation, procedurally enhanced by Art.86.4); and furthermore,

—CDC final decisions are binding on other CDC (and other courts) in all Member States (Art.87 of the Regulation).

By the same token, *res judicata* also comes into play, as regards infringement, between Community design and national design rights (Art.95.2–3 of the Regulation).

(d) Invalidity is procedurally very partially centralised. Pursuant to Art.24 of the Regulation,²⁸ the OHIM's centralised jurisdiction only applies to RCD, not UCD. Besides, RCD invalidity may be declared either on application to the OHIM (Art.52 of the Regulation) or by a CDC on the basis of a counterclaim in infringement proceedings (Arts 84–87 of the Regulation). In practice, jurisdiction often turns on which party wins the race to court for Art.91, items 1 and 2 of the Regulation lays down crucial quasi-obligations ("unless special grounds") on respectively CDC and the OHIM to stay the proceedings when second seised of a

12 Art.12 of the Regulation.

13 See below.

14 Arts 80 *et seq.* of the Regulation. See below.

15 Art.24.3 of the Regulation.

16 Art.24.1 of the Regulation referring to either Arts 51–61 (especially 52) of the Regulation or Arts 79–94 (especially 84–87) of the Regulation.

17 Art.19.2 of the Regulation.

18 Recital 21 of the Regulation.

19 Contrary to an earlier draft.

20 Art.19.1 of the Regulation.

21 Art.21 of the Regulation.

22 Art.17 of the Regulation.

23 Art.85.1 of the Regulation.

24 Arts 28–29 of the Regulation. As for UCD, refer to the national law designated by Art.27.

25 Art.32 of the Regulation.

26 Beware of the pitfall in Art.38.2 of the Regulation as to the date of filing. Two months delay in forwarding cancels out the first filing date.

27 Arts 80 *et seq.* of the Regulation. See below.

28 Quoted above while comparing UCD with RCD.

related action. Cynical strategies may be elaborated²⁹ but in a nutshell, either party is well advised to kick off on its own ground!

There is more. Broadly, Art.95.1 of the Regulation provides for a *strict* obligation for any national court (whether a CDC or not) to decline jurisdiction in favour of the first seised national court, where one is seised on the basis of a Community design and the other on the basis of a parallel national design right.³⁰

Finally, on all matters not covered by the Regulation, a CDC shall apply its national law, including its private international law (Art.88.2).

(2) *In certain cases, pan-European injunctions or pan-European provisional, including protective, measures are available from specialised national courts called "Community design courts".*

"Community design courts" (CDCs) are specialised national courts designated (not later than March 6, 2005, hopefully earlier) by each Member State³¹ which have exclusive jurisdiction:

- (a) for infringement actions and—if they are permitted under national law—actions in respect of threatened infringement of Community designs;
- (b) for actions for declaration of non-infringement of Community designs, if they are permitted under national law;
- (c) for actions for a declaration of invalidity of an unregistered Community design;
- (d) for counterclaims for a declaration of invalidity of a Community design raised in connection with actions under (a)".³²

29 The natural plaintiff (design holder) should briskly take infringement action (in particular by claiming threatened infringement) before the most favourable CDC having jurisdiction before the defendant may apply for a declaration of invalidity to the OHIM (otherwise Art.91.1 shall apply). Then both invalidity and infringement issues will be swiftly dealt with by that first seized CDC unless this wishes to stay the proceedings on either party's request pending second seised OHIM's decision on invalidity (Art.91.2, second sentence)—if the court so stays, make sure that you request provisional, including protective, measures for the duration of the stay (Art.91.3).

The natural defendant (alleged infringer) should briskly apply for a declaration of invalidity to the OHIM before it is being sued before a CDC (otherwise Art.91.2, first sentence shall apply). It may then take advantage of the "appeals pyramid" (Board of Appeal, Court of First Instance, possibly European Court of Justice—Arts 55–61 of the Regulation) to create a judicial "quagmire" with a view to settling out of court. Where already sued, the defendant should apply to the OHIM (or be joined under Art.54) and have a go with Art.91.2, second sentence before the first seised CDC as, after all, that provision is quite legitimately aimed at European-scale uniformity.

30 So litigants may even engage in unbridled European forum-shopping on the basis of parallel national design rights! It remains to be seen whether all national courts will be prepared to comply with that strict obligation in case of blatantly abusive forum-shopping.

31 Art.80 of the Regulation.

32 Art.81 of the Regulation. Forum-shopping enthusiasts will note the references to national laws in respect of threatened infringement under 81(a). Note, in contrast, that "torpedoes" under Art.81(b) are getting damp owing to both Art.84.4 (validity cannot be challenged) and, crucially, Art.91.1 (the second seised court is under no obligation to stay proceedings).

Therefore CDCs have exclusive jurisdiction for any action relating to a Community design except for actions (as opposed to counterclaims) for a declaration of invalidity of a registered (not unregistered) Community design, which fall within the OHIM's exclusive jurisdiction.³³

In the absence of an agreed forum (which has to be a CDC),³⁴ CDCs may have international jurisdiction in accordance with two alternative sets of connecting factors:

- (1) "Domicile scale": Member State of the defendant's domicile or establishment; failing that (*e.g.* US defendant), Member State of the plaintiff's domicile or establishment; failing that, Spain.³⁵
- (2) Act or threat of infringement.³⁶

Such alternative connecting factors entail quite different scopes of jurisdiction:

- (1) If "domicile scale" or contractual forum: the CDC has jurisdiction in respect of acts of infringement committed or threatened within any of the Member States³⁷;
- (2) If act or threat of infringement: the CDC has solely jurisdiction on its territory.³⁸ This is, however, without prejudice to the co-defendants rule embedded in Art.6.1 of the Regulation 44/2001³⁹ under which the CDC may have jurisdiction to order measures having effect in any of the Member States where a co-defendant is domiciled.

Where the CDC finds against the defendant in infringement proceedings, it is *obliged*,⁴⁰ unless special reasons are given, to order the basic uniform sanctions laid down in Art.89 of the Regulation: (1) injunction (also in case of *threatened* infringement⁴¹); (2) seizure of infringing products; and (3) where actual or constructive knowledge, seizure of materials. Any other appropriate remedy under the national law of the place of infringement, including damages or an *astreinte* (penalty for non-compliance), may also be granted. Thus a CDC may sanction differently infringing acts committed in several Member States.

In addition, Art.90.1 of the Regulation provides that *territorial* provisional, including protective, measures ("PPM") may be applied for to any national court (whether a CDC or not) in any Member State (irrespective of jurisdiction on the merits). Moreover, pursuant to Article 90.3, a CDC whose jurisdiction is based on Article 82(1–4) ("domicile scale" or contractual forum)

33 Art.24 of the Regulation.

34 Art.82.4 of the Regulation.

35 Art.82.1–3 of the Regulation. For example, a Belgian company may sue before a Belgian court a US corporation only infringing in the United Kingdom.

36 Art.82.5 of the Regulation.

37 Art.83.1 of the Regulation.

38 Art.83.2 of the Regulation.

39 Council Regulation 44/2001 of December 22, 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters [2001] O.J. L12/1.

40 Thus, unlike an interlocutory judge, he or she cannot strike a balance of convenience.

41 If national law so permits. See Art.81(b).

has jurisdiction to grant *extra-territorial* PPM which, subject to recognition and enforcement under the Brussels Convention of September 27, 1968,⁴² are applicable in any Member State.

To sum up, both pan-European injunctions (Arts 83.1 and 89(a)) and pan-European provisional and protective measures (Art.90.3) are available before any Community design court having jurisdiction under Art.82(1–4), (“domicile scale” or contractual forum) whether on the basis of a registered or unregistered design. By way of comparison, copyright holders seeking Community-wide injunctions or provisional measures would have to file 15 national suits.

Cumulation with national laws and the resources of protection-shopping

Prior to the Directive, the overlap between national design rights and copyrights was subject to a patchwork of regimes. Three trends emerged:

- Full cumulation : France with its “*unité de l’art*”⁴³ theory, joined by the Benelux following the benchmark *Screenoprints*⁴⁴ ruling.
- Partial cumulation: Germany and most Member States.
- Prohibited cumulation: Italy and its “*scindibilità*”⁴⁵ principle.

The harmonising Directive only affects the latter regime and the idiosyncratic “*scindibilità*” rule has now been repealed.⁴⁶ Apart from the “upgrading” of Italian copyright, the disparities remain unaffected.

Art.96 of the Regulation, mirroring both Arts 16 and 17 of the Directive, is twofold. Art.96.1 merely permits Member States to allow design right to cumulate with other rights. Further than merely authorising overlaps, Art.96.2 renders cumulation mandatory as a matter of law. This precludes Member States from excluding Community design subject-matter from national copyright protection.⁴⁷ Thus neither does Community design right *per se* give rise to copyright nor does it exclude copyright *a priori*—design right and copyright are strictly independent from each other. Beyond this, requirements for⁴⁸ and scope of copyright protection

are left to national legislators’ discretion and appreciation of facts is, of course, left to national judges’ wisdom.

The Regulation: Outline and Selected Issues

Subject-matter (and scope)—definitions and exclusions

These absolute grounds for refusal or invalidity are subject to substantive examination by the OHIM as for RCD and specialised national courts (CDC) as for UCD.

Definition (and scope) of a design—Arts 3(a), 10, 19 and 36.6

“Design” means “the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation”.⁴⁹ Thus the appearance may be that of a part of a product; it may be visual or tactile.

Here a fundamental issue arises in connection with infringement. Is the cornerstone of the definition “the appearance” or “a product”? The answer is to be found somewhere between subject-matter and scope of protection.

—Indeed, Article 3(a) entitled “Definitions”, speaks of “appearance of (the whole or a part of) a product”, which suggests that design subject-matter is an appearance in so far as it is incorporated in or applied to one single product (line). Thus design may arguably protect one single product viewed from the angle of its outer appearance and possibly similar products.

—In contrast, Article 10, entitled “Scope of protection”, speaks of “any design which does not produce on the informed user a different overall impression”, which suggests that design scope of protection extends to one product market comprising all substitutable products for the informed user. Thus design may arguably protect one appearance as it is used in one product market, though regardless of the specific product embodying the design.

—Furthermore, Article 19 entitled “Rights conferred by the Community design”, speaks of “using of a product in which the design is incorporated or to which it is applied”, which suggests that using any such product is infringing. Thus design may arguably protect one appearance regardless of the product embodying it. This goes far beyond any “speciality of goods” principle.

—Finally, Articles 10 and 19 must be read in conjunction with Article 36.6 as to application for registration: “The information contained in the elements mentioned in paragraph 2 [*i.e.* an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied] and in paragraph 3(a) [*i.e.* a description explaining the representation or the specimen] and (d) [the classification of the aforementioned products according to class] shall not affect the scope of

42 Actually, this reference to the Brussels Convention must be updated since Regulation 44/2001 (see above) entered into force on March 1, 2002, replacing the Brussels Convention in respect of all Member States but Denmark.

43 Fine arts and applied arts are indistinguishable.

44 Benelux Court of Justice, May, 22 1987, [1988] R.C.J.B. 567. The “marked [or clear] artistic character” requirement for copyright to subsist in Benelux designs was equated to a mere originality threshold. After remittal a copyright claim for car sunscreens was accordingly upheld.

45 Functional or utilitarian features (design) and aesthetic or ornamental features (copyright) are severable.

46 By Government Decree 95/2001, which brought Italian law in line with Directive 98/71 and entered into force on April 19, 2001.

47 Apparently this is only aimed at economic, not moral, rights.

48 Including the originality threshold.

49 Art.3(a) of the Regulation.

protection of the design as such.” The wording “as such” is shrouded in mystery.

Therefore, as interpretations dictate, design scope will be confined to the appearance of one single product or will further extend to any similar product or any substitutable product or any product whatsoever. By way of comparison, copyright unquestionably protects one form (fixating an original creation) abstractly, in all its embodiments, rather than concretely, as embodied in one or a range of product(s). On the contrary, most trade marks are subject to the “speciality of goods” principle. The resolution of this issue will thus be crucial for the practical value of design as compared with copyright and trade mark.

Definition of product—Article 3(b-c)

“Product” means “any industrial or handicraft item, including *inter alia* parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs”.⁵⁰

This catalogue allows certain overlaps of protections while apparently banning another such overlap. Authorised overlap: in practice, Community design will prove particularly useful for protecting packaging and get-up, which, though included within Community trade mark subject-matter,⁵¹ do not demonstrate inherent distinctiveness so easily. Prohibited overlap: computer programs are excluded from design right and solely protected by copyright as literary works; yet icons and menus are included. Moreover, “products” should encompass environmental designs, whether interior (shop, restaurant, pub, club, TV set . . .) or exterior (amusement park, garden . . .).

In addition, “complex product” means “a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product”.⁵² The intricate issues which revolve around component parts of complex products will not be dealt with here, save for saying that their protection is subject to

—a requirement of visibility during normal use (thereby excluding “under the bonnet” parts)⁵³ on top of novelty and individual character; and
—a transitional provision to the effect that “until [the Regulation is amended], protection as a Community design shall not exist for a design which constitutes a component part of a complex product used . . . for the purpose of the repair of that complex product so as to restore its original appearance”.⁵⁴ Thus this defence to infringement for the purpose of repair (as distinct from a blanket exclusion from protection) may be invoked right from the start, unlike earlier proposals for a three-year-

delayed repair clause or compulsory licensing schemes.

Exclusion for technical function—Article 8

A general exclusion is laid down for “features of appearance of a product which are solely dictated by its technical function”.⁵⁵ This, of course, does not entail that a design must have an aesthetic quality.⁵⁶ Two expressions nevertheless warrant some clarification. How broad is “technical function” intended to be? This clearly extends beyond patent-protected features so as to include technical constraints. But that “technical function” further extends to economic or marketing constraints, cannot be ruled out. And how strict is the “solely dictated” link intended to be? In the authors’ view, the Benelux and French “multiplicity of shapes” criterion, rather than the UK *Amp v Utilux*⁵⁷ test, should be applied. Accordingly, if one shape necessarily performs a technical result but alternative shapes perform the same result as well, none of these shapes is indispensable to that result and all of them may be protected. The exclusion applies only where a specific technical result dictates adopting one specific shape.

There is also a specific “must fit” exclusion for mechanical fittings which are necessary to interoperability.⁵⁸ Though much debated, it hardly has an independent scope except perhaps for the car industry and the reprography sector—but it expressly does not cover modular systems.⁵⁹ Unlike under UK law, there is no “must match” exclusion from subject-matter—for the same subject-matter, there is instead a transitional exception to infringement.⁶⁰

Exclusion for public policy or morality—Article 9

Intriguingly, public policy is part of the OHIM substantive examination (as for RCD). Failing harmonisation at Community level, it is to be feared that public policy of one single Member State may suffice to exclude protection.

Requirements for protection—absolute grounds for invalidity

The so-called “requirements for protection” in fact solely constitute absolute grounds for invalidity, as distinct from relative grounds. Those absolute grounds are novelty and individual character, both to be relatively⁶¹ assessed against a prior art or “design corpus”⁶² circumscribed by an evanescent concept of disclosure known to Community circles. Neither functional nor ornamental character are required.

Novelty and individual character—Arts 5 and 6

Novelty consists in an objective non-identity exceeding immaterial details.⁶³ Individual character consists in a

50 Art.3(b) of the Regulation.

51 Art.4 of the CTM Regulation 40/94.

52 Art.3(c) of the Regulation. The criterion of permitted disassembly and re-assembly seems overly broad. A higher degree of technical integration should be required so as still to include fitted bathrooms and kitchens yet not personal computers or hi-fi systems.

53 Art.4.2–3 of the Regulation.

54 Art.110.1 of the Regulation.

55 Art.8.1 of the Regulation.

56 Recital 10 of the Regulation.

57 House of Lords [1972] R.P.C. 103.

58 Art.8.2 of the Regulation.

59 Art.8.3 of the Regulation, the “Lego” clause.

60 Art.110.1 of the Regulation. See above.

61 Obviously relativity here relates to novelty, not invalidity as above.

62 See Recital 14.

63 Art.5.2 of the Regulation.

difference in overall impression on the informed user.⁶⁴ Classically, overall similarities should matter more than local differences. Individual character seems to be more demanding than novelty as it refuses protection to overall *déjà vu*, regardless of materially differing details. In practice, individual character is thus likely to absorb novelty. The reference date for novelty and individual character is

- as for UCD, disclosure, *i.e.* making available to the public of the asserted design; or
- as for RCD, filing of application or priority date.⁶⁵

Novelty is clear-cut (in theory) but individual character is elusive. As a starting point the “informed user” who serves as a reference should be more informed (and thus more perceptive of possible differences) than the average consumer, yet less so than the expert or the man skilled in the art—he or she is a connoisseur, yet not an initiate. Thence we could follow a four-stage approach suggested by Uma Suthersanen,⁶⁶ hereby roughly outlined:

- (1) identify the concerned sector (having regard to classes⁶⁷ of products indicated in the application (if any) and, in any case, market structure⁶⁸);
- (2) assess (1)’s informed user’s knowledge and perceptiveness (using expert witnesses or market surveys as evidence);
- (3) circumscribe the “design corpus” or prior art of earlier designs⁶⁹;
- (4) compare the overall impressions on (2) of both the asserted design and any element of (3).

An additional factor in assessing individual character, “the degree of freedom of the designer in developing the design”⁷⁰ conjures up subjective originality. But Recital 14 provides further precision: just as the industrial sector, that degree of freedom is only one particular element defining the nature of the product, which itself helps assess individual character. So the designer’s room for manoeuvre between technical or marketing constraints should not tinge the individual character objective test with subjectivity. The reference person is the informed user, not the creator; individual character is to be more objective than originality. This has been harmonised by several copyright Directives⁷¹ as a standard meaning “its author’s own intellectual creation”, irrespective of the prior art.

That being said, individual character may well turn out to be interpreted as unconfessed “original novelty”. In theory, there is no oxymoron in associating novelty and originality as both standards may perfectly well supplement each other. But in law, the conjunction “or” separating novelty and originality in Art.25.1 of

the TRIPs constitutes an insuperable obstacle to *blatantly* blending them.

Disclosure and grace period—Article 7

Interestingly, disclosure destroying novelty and individual character is less defined by its *fact* (quite vaguely resulting from registration, exhibition, use in trade *or otherwise*), which may have taken place anywhere anytime, than its disclosing *effect*, which must be felt within the Community at the reference date. On the contrary, disclosure giving rise to UCD is apparently⁷² defined by its fact taking place within the Community. Thus a disclosure outside the Community may destroy novelty of RCD without giving rise to any UCD.

More precisely, disclosure here means making available to the public “except where [this] could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community”.⁷³ Nebulous though as this proviso may be, the basic idea is clear. Novelty and individual character are relative, not absolute. They are to be assessed against a “design corpus” circumscribed by the reasonable knowledge among the Community circles concerned. Yet such collective memory constantly varies over time as it is subject to both random-access and obsolescence. In practice, expert witnesses battles are thus to be expected. Focusing on the internet, unless otherwise proved, a web page should only be deemed to be known to Community circles where it was specifically aimed at, not just accessible to, such circles. However tenuous it may appear, that relativity will not be futile to sectors which draw inspiration from “ethnic” designs, such as fashion, furniture or decorative arts.

Finally, it is worth noting that, under the Directive, prior art in respect of national design rights is equally Community knowledge thus defined.⁷⁴ So absolute grounds for invalidity are the same at Community or national level, as opposed to relative grounds.⁷⁵

By way of exception, “disclosures of the design by the designer or his successor in title, or abusive disclosures during a period of 12 months prior to the date of the filing of the application [or priority date] for a registered Community design should not be prejudicial in assessing the novelty or the individual character of the design in question”.⁷⁶ Such a 12-month grace period is aimed at allowing the designer to test a range of products embodying the design in the market-place before electing the promising products for which a registered Community design is desirable; abusive disclosures are equally neutralised. The grace period incidentally allows UCD and RCD to coexist peacefully as UCD-triggering disclosures do not sabotage RCD’s novelty. It is only one among the practical attractions of the new regime.⁷⁷

64 Art.6.1 of the Regulation.

65 Arts 5.1 and 6.1 Regulation.

66 See U. Suthersanen, *Design Law in Europe* (2000), at p.39.

67 Though this is never to be decisive. See Art.36.6 above.

68 See also Recital 14.

69 See below as to disclosure.

70 Art.6.2 of the Regulation.

71 Computer programs (Art.2), Duration (Art.6 as to photographs) and Databases (Art.3).

72 This is criticised below.

73 Art.7.1 of the Regulation.

74 Art.6.1 of the Directive.

75 See below.

76 Recital 20 and Art.7.2 of the Regulation.

77 See below.

Formalities

UCD : First disclosure within the Community—Article 11

Article 11.1 reads: “A design which meets the requirements under Section 1 [Arts 3–9] shall be protected by an unregistered Community design for a period of three years as from the date on which the design was first made available to the public within the Community”. Turning to Article 11.2, by mirroring Article 7.1 and referring to reasonable knowledge by the Community circles, it is misleading for the context is altogether different. Unlike Article 7.1, the effect of Community knowledge here is an *additional* requirement to the fact of first making available to the public within the Community. However, the fact of disclosure has the same—vague—meaning in both provisions.

This basic requirement of first Community disclosure sparks off controversies. One certainty: a fact taking place outside the Community gives rise to no UCD, unlike copyright—a design created in, say, the United States is protected by copyright in the whole (Berne Convention) world as soon as it is created but a design disclosed in the United States is not protected in the Community by a UCD.

But doubt crops up⁷⁸: should the first disclosure ever take place in the Community or could it suffice that Community disclosure will take place at some (later) stage? In other words: first disclosure outside the Community certainly entails no positive effect (it gives birth to no UCD) but furthermore it is apparently intended to entail a negative effect (it arguably sterilises Community disclosure, thus preventing any future birth of UCD). Let us not delude ourselves: the provision has probably some “protectionist flavour”. As a practical precaution, the authors accordingly advise designers to disclose in the Community before anywhere else⁷⁹ and to keep evidence of such disclosure in view of subsequent UCD-based proceedings. But as a theoretical argument, one should submit a teleological interpretation of Art.4 of the Paris Convention: the ground for claiming priority rights may not be restricted to the filing, now seen as mere example, and might embrace any disclosing formality. If Community disclosure is really to be seen as a “formality”,⁸⁰ then so is any disclosure outside the Community. Conversely, first disclosure within the Community can found no priority right in third countries—unless the above interpretation is followed.

For all that, UCD constitutes a marvellous innovation for short-cycled products such as clothes, cosmetics, footwear or toys. It is not the only “designer-friendly” device.

RCD: “Designer-friendly” registration

Designer-friendliness is proclaimed as a fundamental objective of the Regulation.⁸¹ This indeed provides for some notable attractions:

- Prior to registration, *unregistered Community design* protecting the design against copying for three years as from its disclosure within the Community⁸²;
- 12-month grace period* safeguarding the novelty of a future application for a *registered* Community design⁸³;
- six-month right of priority* based on foreign applications⁸⁴;
- possibility of combining several designs in one *multiple application* (if they all belong to the same class under the Locarno Agreement)⁸⁵;
- no substantive examination* of requirements for protection on registration⁸⁶; in this connection, no opposition proceedings;
- as a result, *swift* registration and (relatively) *low* fees⁸⁷;
- facility of *deferment of publication* for a period of up to 30 months⁸⁸;
- six-month grace period for renewal* (against additional fee)⁸⁹; and
- restitutio in integrum*, i.e. restoration of a right despite non-compliance with time limit (under strict conditions).⁹⁰

Designers will be entitled to claim priority rights in third countries on the basis a RCD filing with the OHIM, unlike UCD disclosure. Note that most registration features have been tackled in relation to other issues (such as term and subject-matter).

Relative grounds for invalidity

Art.25.1 Regulation sets out an exhaustive catalogue of seven grounds for invalidity. It may be outlined as follows:

- (a) definition (Art.3(a));
- (b) requirements (Arts 4–9);
- (c) rightholder not entitled (Art.14);
- (d) conflict with a prior design which
 - has been *disclosed after* filing (or priority) of the asserted Community design, and
 - was *protected prior* to filing (or priority) by a registered, or an *application* for a, Community, or *Member State*, design⁹¹;

78 See Amended Proposal for a Council Regulation (EC) on Community Design, COM/99/0310 final—CNS 93/0463, [2000] O.J. C248/3. The explanation as to Art.12 (at the time) is unclear.

79 The best solution may consist in disclosing on the internet and simultaneously notifying both foreign and Community circles by email.

80 See the Amended Proposal, n.78 above, Explanation as to Art.1: “Paragraph 2 a. specifies that contrary to a copyright approach (under which a creation is protected independently of any “formalities”), the unregistered design must fulfil a condition in order to benefit from the protection: the design must have been made available to the public.”

81 See Recital 24 of the Regulation.

82 Art.11 of the Regulation.

83 Art.7.2 of the Regulation.

84 Art.41 of the Regulation.

85 See Art.37 of the Regulation for details.

86 Arts 45–47 of the Regulation.

87 The fees for 1 design in 1 class are: 230€ for registration + 120€ for publication (+40€ for deferment of publication).

88 See Art.50 of the Regulation for details. Note Art.50.6 as to communication to the defendant in legal proceedings.

89 Art.13.3 of the Regulation.

90 Art.67 of the Regulation.

91 How about UCD? See Víctor Sáez, “The Unregistered Community Design” [2002] E.I.P.R. 585, at 590.

- (e) infringement of a Community, or *Member State*, distinctive sign (including a trade mark but also a trade name . . .);
- (f) infringement of *Member State* copyright;
- (g) infringement of emblems (Art.6ter of the Paris Convention or national law).

Items (d), (e) and (f) strikingly permit the invalidation of a Community design on the grounds of a right other than a design (a distinctive sign or copyright) and/or other than a Community one (Member State protection).

Who has standing to sue (or bring a counterclaim) depends on the ground for invalidity.⁹¹ Nullity may be invoked either:

- by anyone: (a) and (b); or
- by the appropriate national authority (where so provided) or by a specific private person: (d) and (g); or
- by a specific private person: (c), (e) and (f).

It must be recalled that Community design courts' final decisions on invalidity are binding on all courts in all Member States,⁹² no matter whether the ground for invalidity is absolute or relative. Any national design (d), distinctive sign (e) or copyright (f) may therefore render a Community design invalid. However, a registered Community design which has been declared invalid pursuant to grounds (b), (e), (f) or (g) may be maintained in an amended form if the identity of the design is retained.⁹³ "Identity" here cannot mean "difference in immaterial details"⁹⁴—this would be ineffective. Instead, identity should refer to the design's underlying idea—the amendments cannot be aimed at broadening the design scope but only at rendering it valid so as to keep its filing date.

Be that as it may, designers will be well advised to continue filing applications for national designs as fall-back positions should their Community design be invalidated on a purely national ground.

Ownership and dealings

Qualification for Community design is not restricted to EU nationals or residents. Yet the first Community disclosure requirement as for UCD may put foreigners at a disadvantage.⁹⁵

Community design vests in the designer or his successor in title.⁹⁶ Nevertheless, designs made for hire vest in the employer "unless otherwise agreed or specified under national law"⁹⁷; thus the last word rests with contract or national law.⁹⁸ The wordings "in the execution of his duties" or "following the instructions" should be construed more strictly than just "in the course of the employment relationship": a specific duty or instruction should be carried out or followed when

developing the design. By contrast, commissioners seem to enjoy no presumption of ownership.

Entitlement to a Community design may be claimed within three years of UCD disclosure or RCD publication; the three-year bar does not apply if the person non entitled was acting in bad faith.⁹⁹ National courts other than CDC also have jurisdiction.¹ As the Regulation solely applies to invalidity proceedings (see ground (c)²), entitlement proceedings are governed by national law.

Perhaps correspondingly, unless otherwise provided by the Regulation, a Community design, or its application, as an object of property shall be dealt with in its entirety, and for the whole area of the Community, as a national design right of the Member State of (1) the holder's seat or domicile on the "relevant date"³; or (2) failing (1), the holder's establishment; or (3) failing (2), as a Spanish design.⁴ That provision aims to preserve the unitary character of Community design. Transfer, rights *in rem*, levy of execution, insolvency proceedings and licensing in respect of such a national right are then somewhat regulated.⁵

Infringement

Scope and use—Articles 10 and 19

Design scope of protection⁶ has already been dealt with in relation to subject-matter and individual character. First, design scope helps define its subject-matter. It has been submitted above that design may not be subject to any "speciality of goods" principle.⁷ Secondly, design scope logically mirrors individual character.⁸ For an infringed design must be valid and an infringing design cannot be valid. Actually, it seems that the high individual character threshold is meant to counterbalance the wide scope of protection. By analogy with stronger and weaker trade marks, it is submitted that highly individual designs should enjoy a wider protection than barely individual ones.

The catalogue of infringing uses is so wide as to include—self-referentially—any "using" or any stocking for that purpose.⁹ Let us recall that UCD further requires proof of copying—so does RCD as long as publication is deferred.¹⁰ Threatened infringement is also sanctioned.¹¹

91 Art.25.2–5 of the Regulation.

92 Art.87 of the Regulation.

93 Art.25.6 of the Regulation.

94 As in Art.5.2 of the Regulation.

95 See above.

96 Art.14.1 of the Regulation.

97 Art.14.3 of the Regulation.

98 It is not clear whether this national law is the *lex contractus* (as it should be) or the *lex fori*.

99 Art.15 of the Regulation. Then national statutes of limitations presumably apply.

1 See Art.93 of the Regulation.

2 Art.25.1(c) of the Regulation.

3 Presumably the date on which an agreement, if any, is entered into.

4 Arts 27 and 34 of the Regulation.

5 Arts 28–33 of the Regulation.

6 Art.10 of the Regulation.

7 Compare with the *Kinderkapperstoel* ruling, Dutch Hoge Raad, March 10, 1995 [1995] N.J. 670.

8 Apart from the unwarranted insertion of the adjective "visual".

9 Art.19.1 of the Regulation.

10 Art.19.2–3 of the Regulation.

11 See the above description of the remedies offered by Art.89.

Exceptions—Articles 20 to 23

Exceptions are provided for

- (1) acts done privately and for non-commercial purposes;
- (2) acts done for experimental purposes;
- (3) acts of reproduction for the purpose of making citations or of teaching, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and that mention is made of the source.¹²

The former two defences are classic in patent law and should be interpreted along the same lines. The latter draws inspiration from copyright; it oddly exempts reproduction but not other uses; it is subject to specific purposes as well as a Berne-style three-step test.¹³ Other classic defences include Community (though not international) exhaustion¹⁴ and, as for RCD, a personal right of prior use (in good faith).¹⁵

Community Design v National Copyrights

Advantages

Compared with 15 national copyrights, one single Community design offers a huge procedural advantage.

Pan-European injunctions and provisional measures

European-scale copyright litigation requires filing 15 national suits. True, encircling manoeuvres may ultimately lead to amicable settlements in minor countries. Also true, certain national courts are prepared to grant cross-border injunctions. But there is, as yet, no such thing as a European system of copyright enforcement.

Design enjoys a huge procedural advantage. Its holder may seek relief before one single specialised national court among the “Community design courts”. If jurisdiction is based on (whoever’s) domicile, pan-European provisional measures are available and where the court finds infringement, it is *obliged* to issue a pan-European injunctive order. If jurisdiction is based on place of infringement, the order will apply in that territory, without prejudice to the co-defendants rule.¹⁶

Infringement and onus of proof

First, copyright infringement is subject to proving derivation and substantial copying. Although UCD is also a right only to prevent copying,¹⁷ RCD is an exclusive right against the whole world, including independent designers.¹⁸ Secondly, unlike both copyright and UCD, a RCD holder enjoys (rebuttable) presumptions of ownership¹⁹ and validity²⁰ in infringement proceedings.

Thirdly, while under most copyright laws threat to infringe will not be enjoined, the holder of a design (whether registered or not) may seek injunctive relief as soon as infringement is threatened if national law so permits.²¹ This crucially enables the design holder to negotiate a licence with the alleged infringer at an early stage of the dispute.

Rights in rem

More appropriately than copyright and UCD, RCD may be given as security or be the subject of rights *in rem*.²²

Ownership

Both regimes will ultimately depend on national laws.²³ Employers will prefer design’s presumption of ownership to *droit d’auteur* rules favouring creative employees.

Drawbacks

Compared with copyright, designs present shortcomings.

Commencement (formalities) and term

The protection of both unregistered and registered designs starts after and lapses before copyright protection. Their later subsistence is due to some kind of formality, while copyright is subject to none.

As for copyright, Article 1 of the Duration Directive 93/98/EC,²⁴ which by now has been implemented into all national laws, deserves full quotation: “The rights of an author of a literary or artistic work within the meaning of Article 2 of the Bern Convention²⁵ shall run for the life of the author and for 70 years after his death, irrespective of the date when the work is lawfully made available to the public.” This makes clear that copyright term is 70 years *post mortem auctoris*. Copyright commencement is not so explicitly stated. It is clearly to be understood that copyright runs from creation, meaning fixation of an original work in a (material) form, without any formalities. Such an absence of formalities is not only time— but also cost-saving.

As for UCD, this runs from the first making available to the public within the Community²⁶ (*i.e.* necessarily following creation) and lapses after three years (*i.e.* possibly more than one century before copyright).²⁷ As for RCD, its term runs from the filing of the application (*i.e.* much later than copyright) for a period of five years which may renewed up to a total of 25 years (*i.e.* much earlier than copyright).²⁸ It is definitely worth noting that, although registration for Community design will

12 Art.20 of the Regulation.

13 See also Art.26.2 of TRIPs.

14 Art.21 of the Regulation.

15 Art.22 of the Regulation. This right was inadvertently “omitted” in the Directive.

16 Arts 80, 82, 83 and 89 of the Regulation and Art.6.1 of Regulation 44/2001.

17 Art.19.2 of the Regulation.

18 Art.19.1 of the Regulation.

19 Art.17 of the Regulation.

20 Art.85.1 of the Regulation.

21 Arts 81(a) and 89 of the Regulation.

22 Art.29 of the Regulation.

23 See above.

24 Council Directive 93/98 of October 29, 1993 harmonising the term of protection of copyright and certain related rights [1993] O.J. L290/9–13.

25 This includes “works of applied art”.

26 Whatever that means. See above.

27 Art.11 of the Regulation.

28 Art.12 of the Regulation.

not be free and instant like copyright subsistence, it will be less costly and lengthy than for any other industrial property right.

International protection

As soon as a work is created, it is protected by copyright in all Member States of the Berne Union without any formalities. Indeed, the national treatment and automatic protection principles automatically qualify foreign authors for copyright protection without discrimination in every unionist country.

Like its UK forerunner, UCD is not internationally mature. First, foreign designers are hampered by its "formality" in disguise (first disclosure within the Community). Conversely, European designers may not rely on UCD to qualify for equivalent foreign protection.

Requirements for protection

Copyright's substantive criterion is subjective originality. This has been harmonised by several Community Directives as meaning that the work must be "its author's own intellectual creation". Consequently, similarity with the prior art does not necessarily destroy originality. Moreover, a creation's disclosure does not adversely affect its protection.

Design's substantive criteria are objective novelty and individual character. Similarity with the prior art known to Community circles destroys, if not novelty, individual character as it is *déjà vu*. But the destructive effect on RCD of self-anticipation through disclosure is mitigated by a 12-month grace period.²⁹

Conversely, certain mundane, unoriginal artifacts may arguably be novel and individual.

Community Design v Community Trade Mark

Advantages

Compared with trade marks, designs offer a great deal of advantages.

Formalities and procedure

Securing design protection is quicker and less burdensome, compared with trade marks. First, trade marks necessarily arise from registration following application. As for UCD, this is not so: UCD subsists in a design from its first making available to the public within the Community.³⁰ Secondly, trade mark registration is subject to substantive examination and possibly opposition proceedings.³¹ As for RCD, it is hardly subject to any substantive examination at the registration stage (save for definition and public policy or morality).³² By the same token, there is no possibility for interested parties to institute opposition proceedings against a design

being registered. Those parties have to bring an invalidity claim or counterclaim subsequently.

Requirements for protection (in part) and exclusions

Granting trade mark protection is arguably a more subjective exercise, compared with upholding or granting design protection. Moreover, exclusions to trade marks are wider in scope.

A trade mark must have distinctive character. This assessment relies on the perception by the targeted public, slightly objectified as a reasonable average consumer. And nowadays, appraising distinctiveness increasingly turns into woolly thinking. This holds especially for three-dimensional marks, as evidenced by the *Mag Lite* CFI judgment.³³ As regards three-dimensional marks, there is an additional conundrum as to whether a shape is (and indeed continues to be) perceived as a trade mark distinguishing a product or simply as the product itself.³⁴ A design must be new and have individual character.³⁵ Novelty is an objective test and individual character is, by and large, an objective test as well, referring to the informed user.

Moreover, trade mark is subject to an exclusion for signs which consist exclusively of: "(i) the shape which results from the nature of the goods themselves; or (ii) the shape of goods which is necessary to obtain a technical result; or (iii) the shape which gives substantial value to the goods".³⁶ Design has no exclusion (iii) since those shapes are precisely design subject-matter. Trade mark exclusion (ii)³⁷ was construed more strictly than the corresponding design exclusion³⁸ by Advocate General Colomer in his opinion in *Philips v Remington*.³⁹ A.G. Colomer argued that "multiplicity of shapes" applies to designs but not trade marks, so that alternative shapes necessarily producing the same technical result may save designs yet not three-dimensional trade marks.⁴⁰ The European Court of Justice has

33 T-88/00, *Mag Instrument v OHIM*, February 7, 2002. Mag Instrument had had its Mag Lite torch shape registered as a 3-D trade mark in the Benelux, France, Germany, Switzerland, the United Kingdom, the United States, etc. The OHIM examiner nevertheless refused its Community application on the ground that the torch shape was devoid of inherent distinctiveness (Art.7(1)(b) of CTM Regulation 40/94). The Board of Appeal dismissed Mag's appeal. The (EC) Court of First Instance upheld that decision. Broadly, the CFI found that the shape's aesthetic qualities and its unusually original design appeared as variants of a common torch shape because after all, the Mag Lite torch had a cylindrical shape like all torches and a cylinder was an indication as to the nature, not the origin, of the product. The CFI rightly dismissed some use factors as only being relevant under Art.7(3) of the CTM Regulation (as to secondary meaning).

34 As recalled by the CFI in *Mag Lite*, *ibid.* at 38: "although the average consumer of the goods in question habitually perceives a word mark as a sign that identifies the goods, the same is not necessarily true of a mark consisting of the shape of the goods themselves".

35 Art.4.1 of the Regulation.

36 Art.7.1(e) of Regulation 40/1994.

37 Art.7.1(e)(ii) of Regulation 40/1994.

38 Art.8.1 of Regulation 6/2002. See above.

39 C-299/99, *Philips Electronics NV v Remington Consumer Products Ltd*. Opinion delivered on January 23, 2001.

40 *ibid.* at 30-42. Though providing an appropriate solution for these extreme facts, this all-encompassing view is questionable when applied to more plausible three-dimensional trade marks.

29 Art.7.2 of the Regulation.

30 See above Art.11 of the Regulation.

31 Arts 41-43 of Regulation 40/1994.

32 Arts 45-47 of Regulation 6/2002.

recently followed that opinion as to trade marks, saving designs for later delights.⁴¹

Scope of protection

Design scope is less fickle, compared with trade marks. First, most trade marks are subject to the “speciality of goods” principle, although the aristocracy of famous trade marks is protected across the board. Design may arguably not be subject to any such speciality rule.⁴² Secondly, trade mark scope varies according to its use by the holder and its perception by the public. Although Art.36.6 of the Regulation⁴³ gives more leeway than strict patent claims, design scope is in theory invariable.

Revocation

Trade marks are frail angels—they may be revoked for non-use or “degeneration” (fall into the hell of common signs).⁴⁴ Designs are not so precarious—they may not be revoked.

Drawbacks

Compared with trade marks, designs present shortcomings.

Requirements for protection (in part)

Design prior art is much wider in both material and geographical terms. First, relative grounds for refusal of a trade mark only refer to earlier trade marks and other signs.⁴⁵ Design grounds for invalidity refer to prior designs, distinctive signs (thus not only registered trade marks), works protected under copyright law as well as emblems and the like.⁴⁶ Secondly, relative grounds for refusal of a trade mark must be European (in a broad

sense, both Community and national) marks and signs, apart from “well known” trade marks.⁴⁷ Design novelty may be destroyed by foreign prior designs provided they could “reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community”.⁴⁸

In addition, time may sometimes work in a trade mark’s, but never a design’s, favour. However, this third difference is not relevant for a direct comparison with designs.⁴⁹

Term of protection

Like diamonds, trade marks (if renewed and not revoked) are forever. Like Socrates, designs are mortal.

A Community trade mark is registered for a period of 10 years from the date of filing of the application. Registration may be renewed for further periods of 10 years to infinity.⁵⁰ Let us recall that RCD subsists for a period of five years as from the date of the filing of the application provided that the rightholder may have the term of protection renewed for one or more periods of five years each, up to a total term of 25 years from the date of filing.⁵¹ Note, however, that UCD, though only for a period of three years, commences earlier than trade mark (first disclosure within the Community).⁵²

Conclusion

At least in jurisdictions where copyright generously bestows its favours, (e.g. the Benelux), design was sometimes scorned as being the poor relative within the intellectual property family. But fairy “European Community” has now endowed this Cinderella with charms that should not be disregarded, such as Arts 11 and 83.1 of the Regulation. Revamped at Community level, the new design is definitely more attractive than it used to be—it should not remain a hidden treasure.

41 C-299/99, *Philips Electronics NV v Remington Consumer Products Ltd*, June 18, 2002. See at paras 78–84, especially 84: “... a sign consisting exclusively of the shape of a product is unregistrable ... if it is established that the essential functional features of that shape are attributable only to the technical result. Moreover, the ground for refusal or invalidity of registration ... cannot be overcome by establishing that there are other shapes which allow the same technical result to be obtained”.

42 See above.

43 See above.

44 Art.50 of Regulation 40/1994.

45 Art.8 of Regulation 40/1994.

46 Art.25.2 of Regulation 6/2002.

47 Art.8 of Regulation 40/1994.

48 See above, Art.7 on disclosure.

49 Secondary meaning (or *inburgering* in Dutch, meaning acclimatisation) means that a trade mark may acquire distinctive character through use. However, signs excluded under Art.7.1(e) of the CTM Regulation may never acquire distinctiveness through use since Art.7.3 only cross-refers to Art.7.1(b-d), not (e). Obviously a design may not acquire novelty or individual character (as defined above) over time, quite the contrary.

50 Art.46 of Regulation 40/1994.

51 Art.12 of the Regulation.

52 Art.11 of the Regulation.