



**International Conference WIPO-ROSPATENT
“Industrial Designs: Past, Present and Future”**

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***Advantages of the Hague System from the Users’
Point of View***

Bernard Volken
Attorney-at-Law, Switzerland

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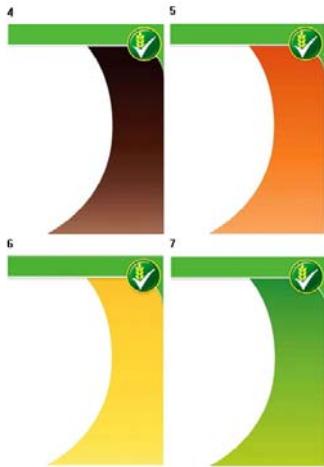
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Introduction: what is a design?

„An industrial design is the ornamental or aesthetic aspect of an article. The design may consist of three-dimensional features, such as the *shape or surface* of an article, or of two-dimensional features, such as patterns, lines or color”.

Trade dresses – unfair competition and design?

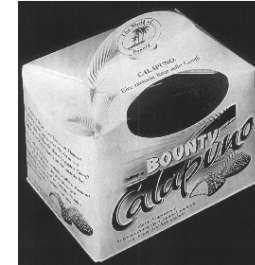
Several sectors of industry (e.g. cosmetics, nutrition etc.) are more focusing also on the shape/packaging:



Nestlé DM/077205



DM/050155 Mars



DM/050888 Mars

Protection of Logos: new Locarno class 32-00

- 9th edition of the Locarno classification entered into force on 1st January 2009.

- New Class 32-00:

„graphic symbols and logos, surface patterns, ornamentation“.

- Some Trademark Offices were reserved regarding logo-filings, what now is no longer the case. As a matter of fact, the number of logo applications in Switzerland already significantly increased since 2009.

Design registered Logos



DM/078389

BUNDESREPUBLIK
DEUTSCHLAND

1



DM/071679 Unilever

Design registered Logos

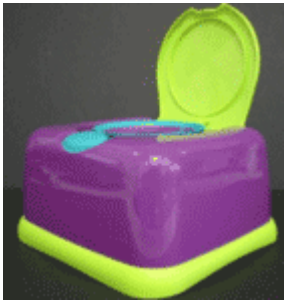


DM/078399



TM IR 1124274

Comparison with the 3D mark

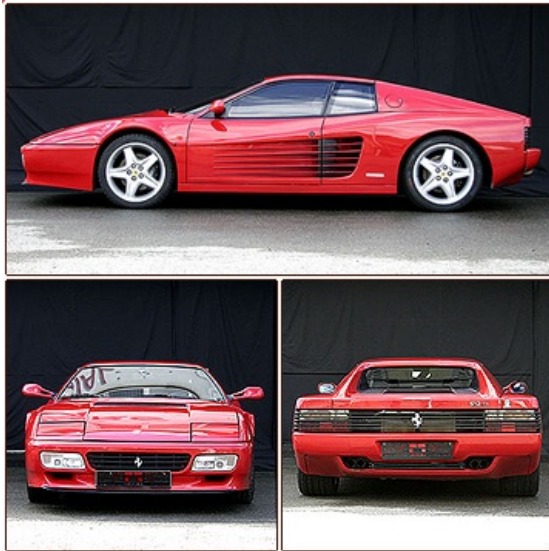


Advantages – no principle of speciality

Art. 2 I Locarno Classification:

- “Subject to the requirements prescribed by this Agreement, the international classification shall be solely of an administrative character. Nevertheless, each country may attribute to it the legal scope which it considers appropriate (*). In particular, the international classification shall not bind the countries of the Special Union as regards the nature and scope of the protection afforded to the design in those countries.”
- In Switzerland, no such declaration (*) was made. This means: no principle of speciality!

*Advantages –
no use requirements*



Let's assume: the Ferrari Testarossa form is filed as a three dimensional mark for class 12 (cars)

Advantages – no use requirements

The Ferrari Testarossa form is filed as a three dimensional mark for class 12 (cars):

- This cannot prohibit chocolate-marketed in the Ferrari Testarossa form (exception: well-known mark).
- Even if a trademark holder thinks he is being clever by also filing this mark in class 30 (chocolate), he will, at the latest, have a problem after 5 years due to the non-use of this mark.

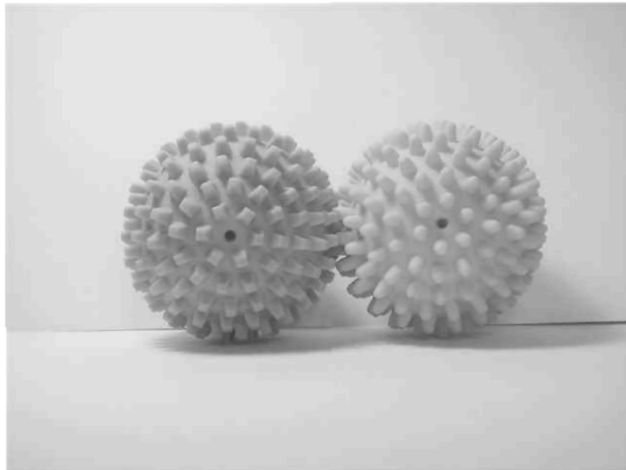
Advantages – no use requirements

The Ferrari Testarossa form is filed as a three dimensional mark for class 12 (cars):

- In contrast to this, the design enjoys protection without being limited to any area/class. Thus, the scope of protection is huge.
- In contrast to trademark law, design protection is limited to 25 years, however, in design matters this is quite a long period.
- Should these 25 years not be sufficient, the holder can then apply for a three dimensional mark by arguing that this form has acquired distinctiveness through intensive use (25 years should be sufficient for most jurisdictions).

*Examples from jurisprudence – RCD Invalidity
decision by the UK Court of Appeals (23. April 2008!)*

Spiky balls for use as laundry
aids, and obtained registered
designs under Nos.
000217187-0001 – 004;
application date 2004:



Sold and used as a
massage ball since
2002:



*Examples from jurisprudence – RCD Invalidity
decision by the UK Court of Appeals (23. April 2008!)*

The parties settled the case amicably. However, one of the judges argued:

“...whilst I am strongly in favour of the encouraging compromise and simply endorsing any settlement of claims between litigating parties where only their private or commercial interests are involved, this case gives rise to points of law of general importance which have an impact on those not directly engaged in this particular dispute. Where our judgment may clarify that which has been moot and the result is of wider public interest, I take the view that we should make our conclusions known and so I have been in favour in this case of handing down this judgment.”

*Examples from jurisprudence – RCD Invalidity
decision by the UK Court of Appeals (23. April 2008!)*

The Court stated:

“But of even more fundamental significance is this: the [Registered Community Design] right gives a monopoly over any kind of goods according to the design. It makes complete sense that the prior art available for attacking novelty should also extend to all kinds of goods, subject only to the limited exception of prior art obscure even in the sector from which it comes”.

Advantages in case of conflict: legal presumption of validity (I)

Design registration = legal presumption of being a valid registration, as long as no existing court decision entered into force to the contrary.

This is an important advantage in case of conflict

- for sending cease and desist letters,
- in case of a civil action: defending a design based on copy rights and/or unfair competition is – according to my experience - a “very delicate adventure”:

*Advantages in case of conflict:
legal presumption of validity (II) – proof hurdle*

- In several jurisdictions, the bar for designs to reach copy right requirements is quite high.
- With a design registration, the right holder must not prove that the design is valid. Rather, the opponent must prove that formal and/or material novelty is missing.
- In contrast to this, with copy rights the holder has to prove that the concerned work meets the requirements. This is a difficult challenge.

Specific issues

- Deferment of Publication
- Possibility of Refusal

Deferment of Publication

Advantages

- it preserves the secrecy longer and avoids the fake being faster than the original,
- Maximum of 30 months (depending of the act)
= a long period for a design, that is why in the case of a multiple application often only some of the originally filed designs will be published, which saves money.

Deferment of Publication

Disadvantage

- In some jurisdictions (for example Switzerland), third parties good faith use cannot be prohibited in case of deferment of publication.
- If not several design of the same multiple application are copied, then this is an disadvantage and a too big mortgage: in case of conflict the right holder has to prove that the infringer acted in bad faith, was is according to experience nearly impossible!
- Recommendation: “take the bull by the horns” and do not renounce on the publication, if not absolutely necessary due to specific circumstances.

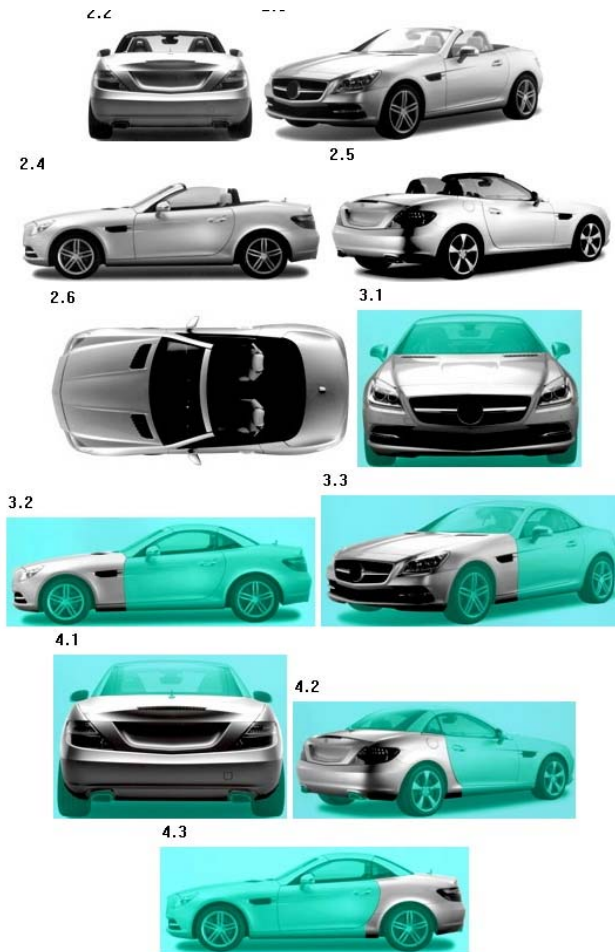
Grounds for refusal

According to experience, refusals are often based on the following grounds:

- Federal Law on the protection of Coats of Arm and other public Insignia.
- Narcotics law (example: “I love Cocaine ...”)
- Antiracism law
- Protection of personal rights and dignity (example: disrespectful picture of the pope)
- Protection of public morality

*Parameter for a tailor-made filing
strategy*

Combination “different perspectives” + disclaimer



DM/070912
Daimler AG

Specific issues: disclaimers



DM/076650 Daimler AG

“The blue marked areas are not coming into the scope of protection, they have the function of a disclaimer”

15.2



DM/076222 The blue marked parts of designs 8, 9, 10, 11, 12, 13 and 14 are not coming into the scope of the industrial design (disclaimer)

Specific issues: disclaimers

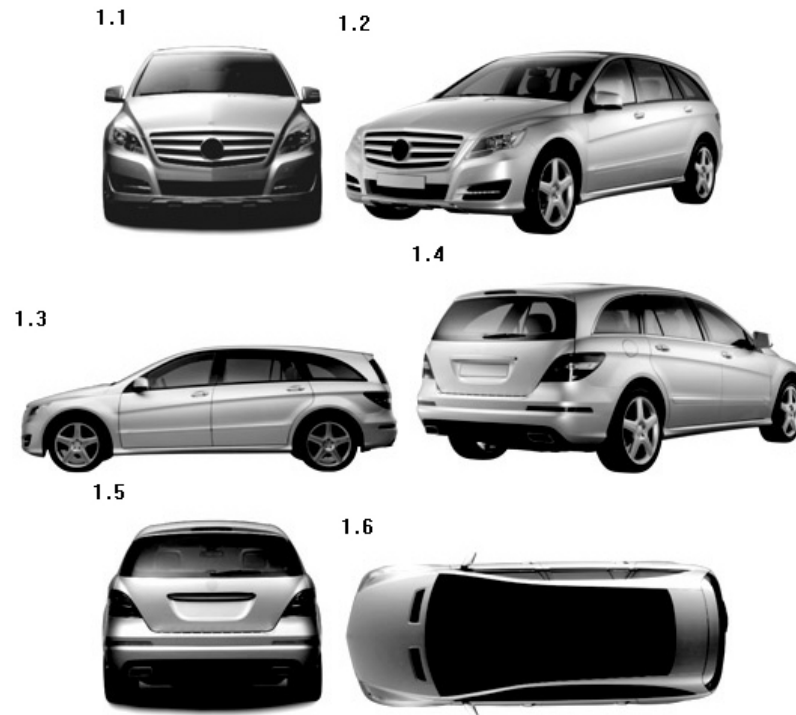
1



DM/075740

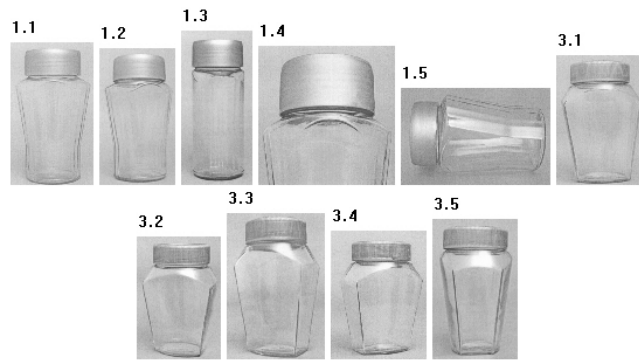


Specific issues: different perspectives

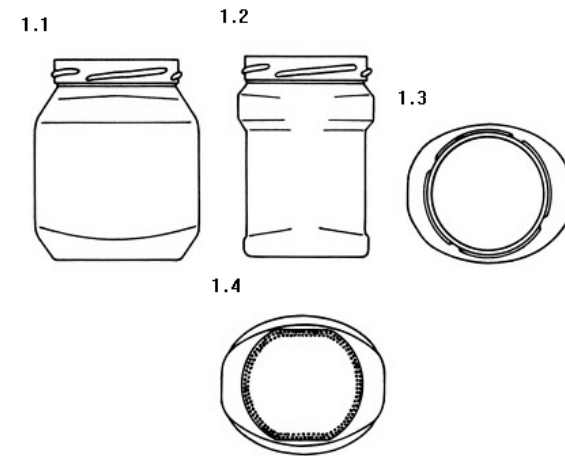


DM/071034
Daimler AG

Photography or graphical reproduction?

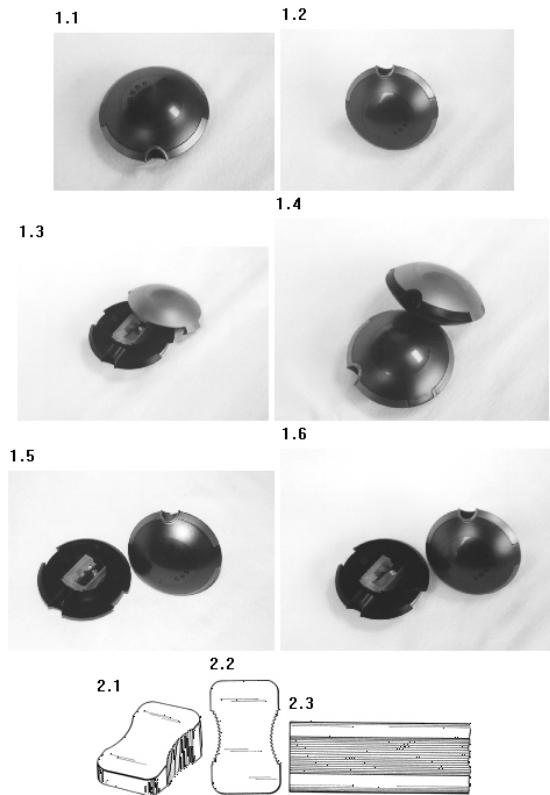


DM/066980 (15); Lidl, DE



DM/066875 (15), Lidl, DE

Photography or graphical reproduction?

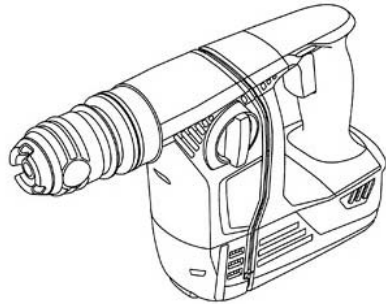


DM/052026 (15);
EISEN GMBH, DE

Color and/or black and white?



3.1

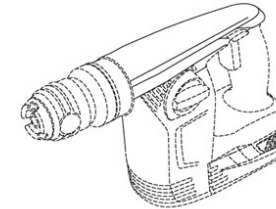


3.2

DM/075961 (15); Hilti, LI



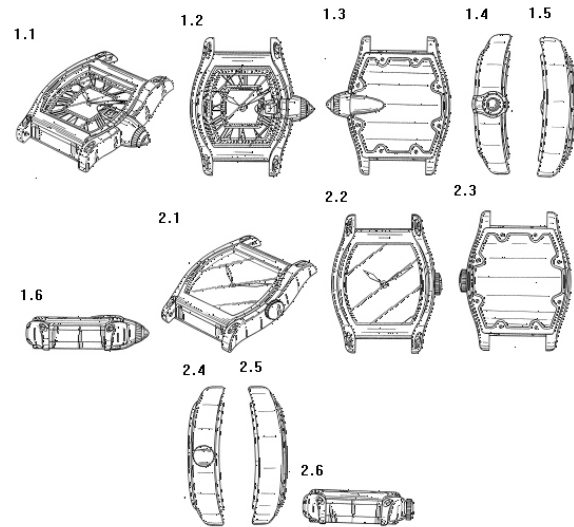
2.1



2.2

DM/076048 (15); Hilti, LI

Whole product and/or parts thereof?



DM/047327 (15); Cartier; CH



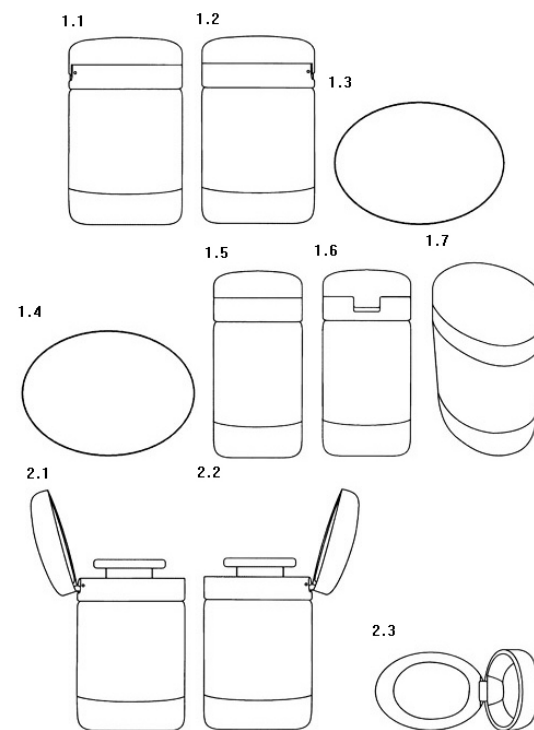
DM/071188 (15); Cartier; CH

Description?

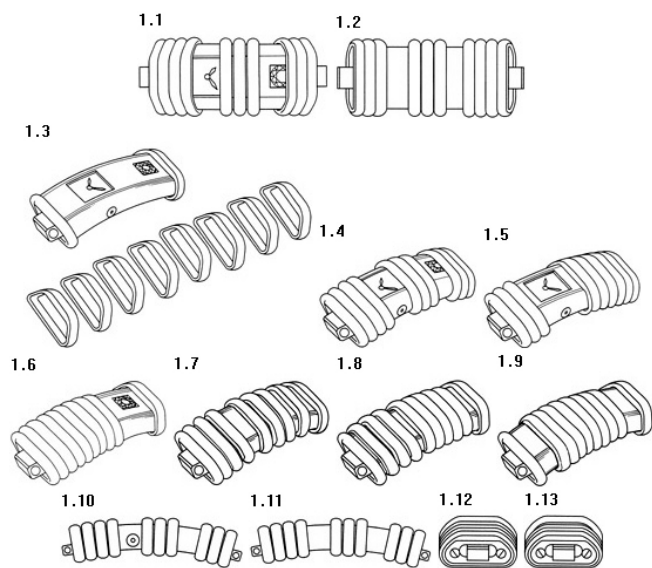
(11) DM/075296 (15) 10.02.2011 (18) 10.02.2016

(22) 03.11.2010 (73) **CARTIER** CREATION STUDIO S.A., Boulevard James-Fazy 8, CH-1201 Genève (CH) (86)(87)(88)(85) CH (89) CH (74) GRIFFES CONSULTING SA Route de Florissant 81, CH-1206 Geneva (CH) (28) 8 (51) Cl. 09-01, 07 (54) 1.-4. Perfume bottles; 5.-8. Caps for perfume bottles / 1.-4. Flacons de parfum; 5.-8. Bouchons pour flacons de parfum / 1.-4. Frascos de perfume; 5.-8. Tapas de frascos de perfume (57)(55)

Design 1: bottle of perfume with its cap closed; the bottle with its cap forms an overall oval cylinder; the bottle cap is linked to the main cylinder by a single binding element; the top part of the cap is domed; the bottle features a horizontal line on its lower part; Design 2: bottle of perfume with its cap open; the bottle forms an overall oval cylinder; the open bottle's cap shows a large and flat topped sprayer that has an oval shape; the base of the sprayer is narrow compared to its upper part; the top part of the cap is domed; the bottle features a horizontal line on its lower part; Design 3: bottle of perfume with its cap closed; the bottle with its cap closed forms an overall oval cylinder; the bottle's cap which is domed on its top part is linked to the main cylinder by a single binding element; Design 4: bottle of perfume with its cap open; the bottle forms an overall oval cylinder; the bottle's cap which is domed on its top part is linked to the main cylinder by a single binding element; the open bottle's cap shows a large and flat topped sprayer that has an oval shape; the base of the sprayer is narrow compared to its upper part; Design 5: cap closed for a bottle of perfume; the cap forms an oval cylinder; the upper part of the cap is domed; the cap is linked to the main cylinder by a single binding element; Design 6: open cap for a bottle of perfume; the cap forms an oval cylinder; the upper part of the cap is domed; the cap is linked to the main cylinder by a single binding element; the open cap shows a large and flat topped sprayer that has an oval shape; the base of the sprayer is narrow compared to its upper part; Design 7: cap



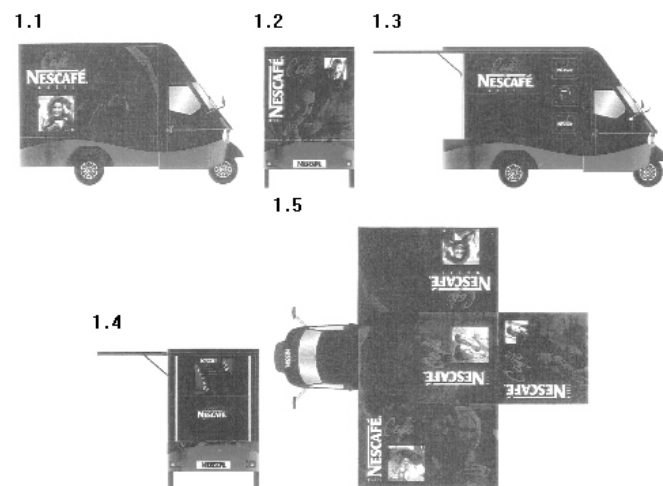
“Graphical description”



One picture can say more than 100 words.

DM/062910 (15); Cartier, CH

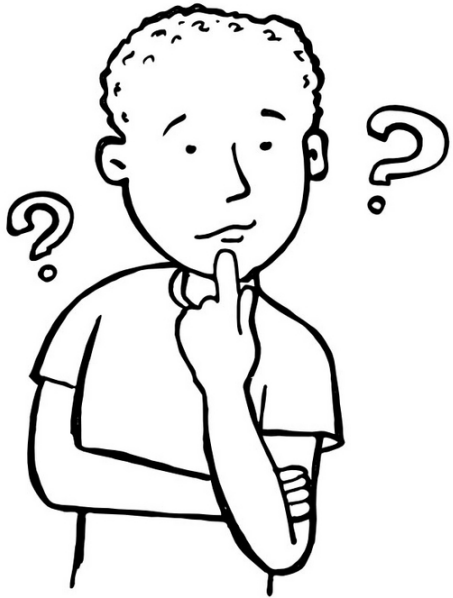
“Graphical description”



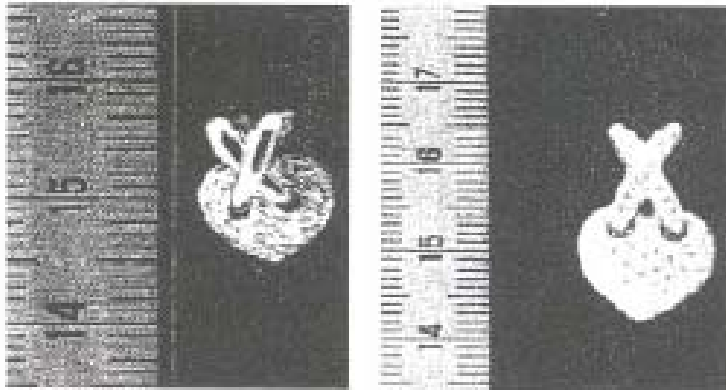
*One picture can say more
than 100 words.*

DM/047707 (15); Nestlé, CH

Does it work in practice - what about jurisdiction?



Examples from jurisprudence

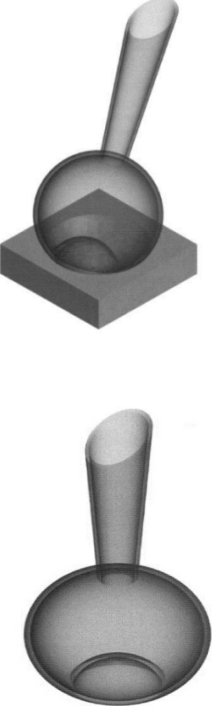



*Swiss Federal Court,
July 13, 2004*

“Pendant”
(published in *sic!* 2004,
943)

Statement of the Federal Court

- The special combination of a heart shaped piece of jewelry with two crossed bands deserves protection as an original creation.
- Based on this, design infringement was affirmed by the court.
- Who would have bet on this outcome?

<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
<p>BGH</p> <p>(8 March 2012, No. I ZR 124/10)</p>			<p>Infringement denied.</p> <p>Plaintiff's Design Registrations</p> <ul style="list-style-type: none"> •7 pictures of wine carafe. •4 with socket •3 without socket <p>Parts or elements of a Design Registration are not protected separately. As a result: the design protection covers “carafe with socket” and not its part (= carafe without socket).</p> <p>Be careful of the filing strategy!! Two filings: actions would have affirmed!</p>

<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
BGH (12 July 2012, No. I ZR 102/11)	Dorel Industries Inc  “ZAPP”	Babywelt Produktions- und Vertriebsgesellschaft GmbH  “Fit+”	Infringement denied. Different overall impressions. Informed user takes note of the difference of the chassis frame and guider.

<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
<p>Oberlandsgericht Düsseldorf</p> <p>(24 July 2012, No. I-20 U 52/12)</p>	<p>Dr. Oetker reg. design:</p>  <p>Trade dress:</p> 	<p>Aldi Infringing product:</p>  <p>Trade dress:</p> 	<p>Infringement denied.</p> <p>Different overall impressions: “Spiral element/movement impression” of the plaintiff design is missing.</p> <p>Limited scope of protection of the plaintiff’s design?</p>

*Decision of the Oberlandgericht Hamm (Germany)
dated February 24, 2011*

Plaintiff



Left: Defendant, right: plaintiff



*Decision of the Oberlandgericht Hamm (Germany)
dated February 24, 2011*

- The court affirmed the validity of the respective Design-registration from 2001. It also affirmed its copy right character.
- However, the Court argued with different overall impressions, due to differences in nose, face, paw.
- My conclusion: validity of design registration is quite easy to obtain. However, the scope of protection is another issue and there is not motive protection in Design- and Trademark Law.

Italian Supreme Court decision dated February 21, 2011 reinforcing protection of design products



- Article 517 Italian Criminal Code forbids the sale of industrial products under false *signs* that could mislead buyers as to the origin, provenance or quality of the product.
- The Supreme Court overruled its prior case law and confirmed that the above provision also be applied to fake design products whether or not these products actually bear a trade mark.
- Conclusion: this decision strengthens the criminal remedies of Design Law in Italy.

Decision BGH dated April 7, 2011

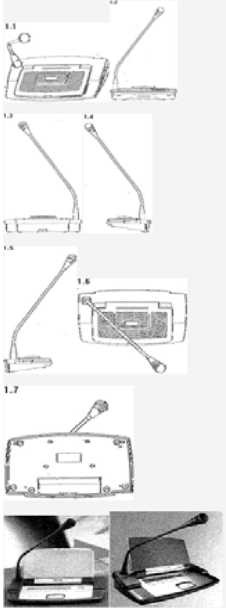
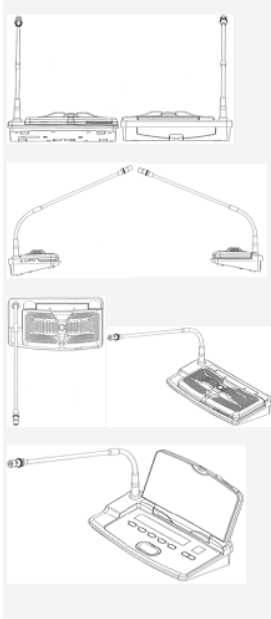



- No qualified use required for design infringement.
- No general fair use exemption.
- Exemption of citations not fulfilled.

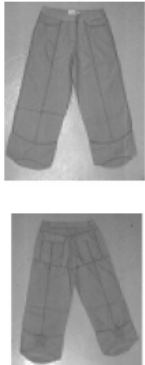
Brand Citation – Trade Mark







- Decision January 25, 2007, Adam Opel AG / Autec AG
- Trade mark infringement requires “third party’s use that affects or is liable to affect the functions of the trade mark“, ECJ C-48/05 Adam Opel AG/Autec AG.
- Fair use provisions can also apply.


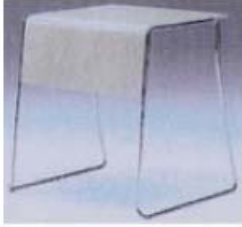
<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
Court General	Bosch Security Systems BV	Shenzhen Taiden Industrial Co., Ltd	Design declared invalid
22 June 2010			<p>- same overall impression on the informed user</p> <p>- contested design lacked individual character</p>


<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
<p>Copenhagen Maritime and Commercial Court</p> <p>(22 May 2008, No. V-0052-7)</p>	<p>Reisenthel Accessoires</p> 	<p>Zebra A/S</p> 	<p>Infringement affirmed. Defendant has to pay damages.</p>



<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
<p>Copenhagen Maritime and Commercial Court</p> <p>(25 Jan 2008, No. V. 68/06)</p>	<p>Staff ApS</p> 	<p>Marc Lauge A/S</p> <p>Confusingly similar trousers</p>	<p>Infringement affirmed. Defendant has to pay damages.</p>



<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
<p>Copenhagen Maritime and Commercial Court</p> <p>(22 Nov 2006, No. V-78-05)</p>	<p>Reisenthel Accessoires</p> 	<p>Zebra A/S</p> 	<p>Cars are different. Thus, the plaintiff's design rights were not infringed.</p> <p>However, overall appearance (placement of sponsor ads etc.) similar, what is against „good marketing practice“. Based on this, sale was forbidden.</p>

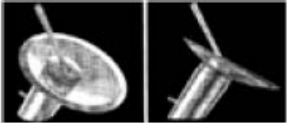

<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
<p>High Court of Ireland</p> <p>(21 Dec 2007)</p>	<p>Karen Millen Ltd</p> 	<p>Dunnes Stores & another</p> 	<p>Design valid and infringed.</p>

<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
District Court the Hague (22 Oct 2008)	HOWE A/S 	Casala Meubelen Nederland BV 	Plaintiff = unregistered design. These rights were infringed.



<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
District Court Amsterdam (16 Oct 2008)	G-Star International BV 	Bestseller A/S and Bestseller Retail Benelux BV 	The differences are too obvious. Claim dismissed.

<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
Provisions judge of District Court The Hague (7 Oct 2008)	Bayerische Motoren Werken Aktien- gesellschaft 	Inter Tyre Holland BV 	Design rights infringed. Claim allowed.



<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
Provisions judge of District Court The Hague (4 Sept 2008)	Bonnie Doon Europe BV 	Angro Hosiery BV, Angro Bv and Angro Retail BV 	Design rights infringed. Claim allowed.



<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
Provisions judge of District Court The Hague (8 Jul 2008)	Hansa Metalwerke AG 	Aqua Farm 	Design rights infringed. Claim allowed.



<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
District Court the Hague (12 Jun 2008)	MM Exclusief BV 	Sikombi BV 	Lack of novelty. Design invalid. Claim dismissed.



<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
<p>District Court the Hague</p> <p>(4 Jun 2008)</p>	<p>Dedon GmbH</p> 	<p>Qmarfelfe Holding BV</p> 	<p>Design rights infringed. Claim allowed.</p>



<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
Provisions judge of District Court The Hague (20 May 2008)	Dedon GmbH 	Qmarfelfe Holding BV 	Design rights infringed. Claim allowed.

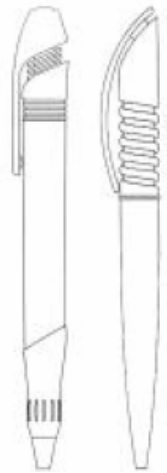

<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
<p>Provisions judge of District Court The Hague</p> <p>(11 Mar 2008)</p>	<p>SEB S.A.S.</p> 	<p>Koninklijke Philips Electronics NV</p> 	<p>Appearance depend on technicalities. Claim dismissed.</p>

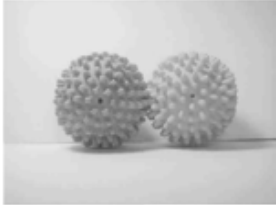

<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
District Court the Hague (10 Dec 2007)	Implivia BV 	Senz Umbrellas BV and Senz Technologies BV 	Design rights assumed being valid. Cancellation action dismissed.

<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
Provisions judge of District Court The Hague (17 Jun 2007)	Paletti Collections BV 	X (also using the name Juul & Jonah) 	Plaintiff bases on unregistered design rights. These rights are infringed. Claim allowed.

<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
District Court the Hague (7 May 2007)	Paletti Collections BV 	Shoebly Fashion BV and Shoebly Franchise BV 	Plaintiff has unregistered design rights. These rights are infringed. Claim allowed.

<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
<p>Provisions judge of District Court The Hague</p> <p>(2 Nov 2006)</p>	<p>Tom Tom International</p> 	<p>Garmin International</p> 	<p>No infringement, due to the different overall impression by the two systems. The similarity in the front is due to the technical features of the touch-screen. Claim dismissed.</p>

<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
<p>Community Trademarks and Industrial Designs Court in Warsaw ref. no XXII GWwp 1/07 (17 Mar 2008)</p>	<p>Dariusz Libera “DreamPen”</p> 	<p>MPM Quality sp. z o.o. and AXPOL Trading A. Wojtczak sp. j.</p> 	<p>Claim allowed. Defendant had to destroy infringing products and to publish apologies.</p>

<i>Court</i>	<i>Plaintiff</i>	<i>Defendant</i>	<i>Decision</i>
<p>Court of Appeal of England & Wales</p> <p>(23 Apr 2008)</p>	<p>Green Lane Products Ltd</p> 	<p>PMS International Group Plc & others</p> 	<p>Prior art available for attacking novelty must extend to all kind of goods.</p>

Conclusion

Design protection is an important “trump” within your IP-strategy,

- if the advantages of the Hague System in particular,
- and of design protection in general,

are recognized and applied!

