

I. Introduction - The General Court of the European Union's decisions "PORSCHE"

The fact that a design of a product is very popular with consumers and certain design features are, therefore, at least one essential reason for its economic success, may lead to successor products only being further developed within certain design limits and only being partially revised. This can be further enhanced by expectations of consumers that the "design idea" of a product – which might be even perceived as "iconic" – will be maintained.

However, in two decisions of 6 June 2019 (T-209/18 and T-210/18), the General Court of the European Union (GCEU) declared two Registered Community Designs (RCD), each showing a different model of the Porsche 911 sports car, to be invalid due to lack of individual character. The decisions became final after the Court of Justice of the European Union (CJEU) did not allow the appeal (CJEU decisions of 24 October 2019, C-613/19 P and C-614/19 P).

Art. 6 of the Council Regulation (EC) No. 6/2002 of 12 December 2001 on community designs (CDR) reads:

1. *A design shall be considered to have individual character if the overall impression it produces on the **informed user** differs from the overall impression produced on such a user by any design which has been made available to the public:*
 - (a) *in the case of an unregistered Community design, before the date on which the design for which protection is claimed has first been made available to the public;*
 - (b) *in the case of a registered Community design, before the date of filing the application for registration or, if a priority is claimed, the date of priority.*
2. *In assessing individual character, the **degree of freedom of the designer** in developing the design shall be taken into consideration.*

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The GCEU essentially stated with regard to Art. 6 CDR:

- The category of products and not the product specifically covered by a registered community design (RCD) must be taken into account so that the informed user of a Porsche 911 is not relevant, but that of passenger cars, in general, is relevant (para. 39/42).

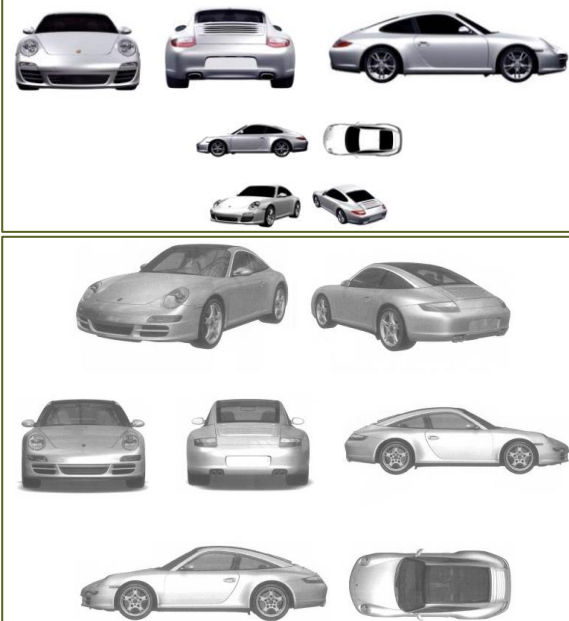

- The term “informed user” refers to a fictitious person since that legal term, created precisely for the purpose of examining the individual character of a design on the basis of Art 6 CDR, can be defined only generally as referring to a person with standard characteristics and not on a case-by-case basis in relation to the specific design in question (para. 37/40). Consequently, the generally defined attention of the informed user cannot be empirically reviewed (para. 41/44).
- The freedom of design is restricted by the technical function of a vehicle, which serves to transport persons and goods. Therefore, vehicles must e.g. have wheels and a body. Furthermore, the freedom of design is subject to legal requirements, in particular in the field of road safety, which concerns *inter alia* the fitting of headlights, rear lights or side mirrors. However, there are no restrictions on the freedom of design as regards the specific configuration of those elements (para. 50/52).
- Consumer expectations do not constitute a normative requirement that necessarily restricts the freedom of the designer of a passenger car since they are related neither to the nature, nor the intended purpose of the product covered by the contested RCD, nor to the industrial sector thereof (para. 57/58).

Against the background of this case law and the uncertainties that may arise for applicants of registered designs, in particular when filing an application for a successor product that differs only slightly in terms of design from the predecessor product, the following remarks are intended to provide both an examples of the case law within the European Union to date, addressing design applications for iterations and to illustrate alternative filing strategies in order to obtain protection for these iterations. However, the applicant should always be aware of the basic requirement that a design can only be protected by an RCD to the extent that it is new (Art. 5 CDR) and has individual character (Art. 6 CDR) and that a design already lacks novelty if the design features differ only in immaterial details from previously disclosed designs (see Art. 5 (2) CDR).

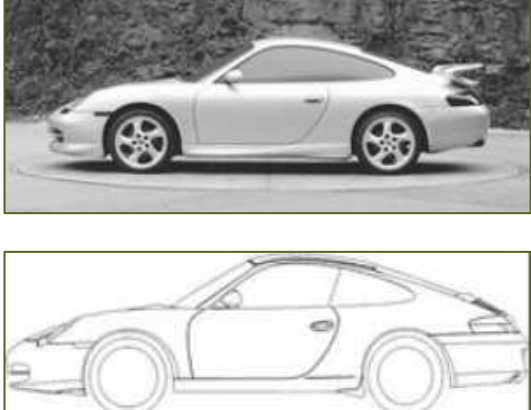

II. Case law examples – Design application for iterations

1. European Institutions

– GCEU, 6 June 2019, T-209/18



Prior Art	Contested RCD
	
<p>Outcome: Contested RCD declared invalid for lack of individual character, Art. 6 CDR.</p>	

– GCEU, 6 June 2019, T-210/18



Prior Art	Contested RCD
	
<p>Outcome: Contested RCD declared invalid for lack of individual character, Art. 6 CDR.</p>	

THE FUTURE OF DESIGN PROTECTION OF ITERATIONS

– GCEU, 6 June 2019, T-192/18

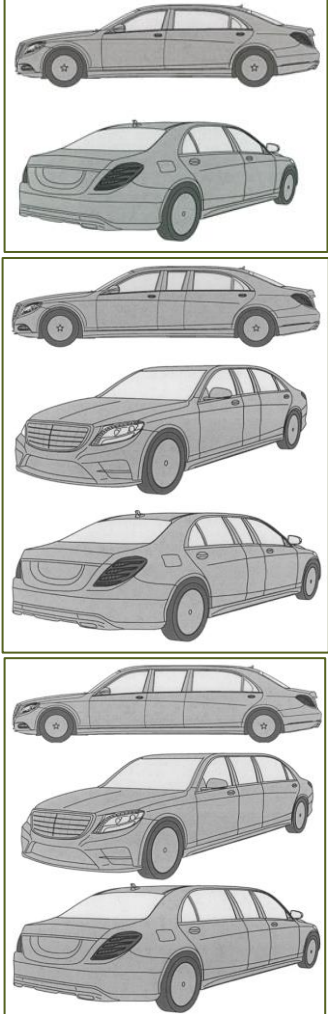
Prior Art	Contested RCD
	
<p>Outcome: Individual character of the contested RCD confirmed, Art. 6 CDR.</p>	

– GCEU, 24 September 2019, T-219/18

Prior Art	Contested RCD
	
<p>Outcome: Individual character of the contested RCD confirmed, Art. 6 CDR.</p>	

2. Belgium

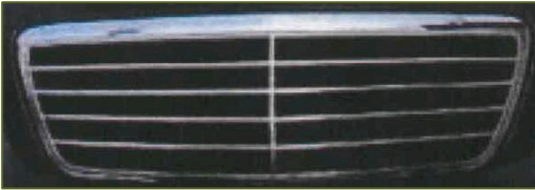

- Tribunal de Commerce francophone de Bruxelles, 24 April 2016, RG A/15/04227 VC

Prior Art	Contested RCDs
<p>Mercedes S Class W222 extended by 50, 65 or 120 cm [not shown in the decision]</p>	
<p>Outcome: Contested RCDs declared invalid for lack of individual character, Art. 6 CDR.</p>	

3. Germany



- Federal Patent Court, 11 July 2019, 30 W (pat) 812/16

In this decision the Federal Patent Court (FPC) took a position slightly different from the GCEU. According to the FPC, the informed user is sensible with regard to face lifting of cars.

Prior Art	Contested German design
	
<p>Outcome: Individual character of the contested design confirmed.</p>	

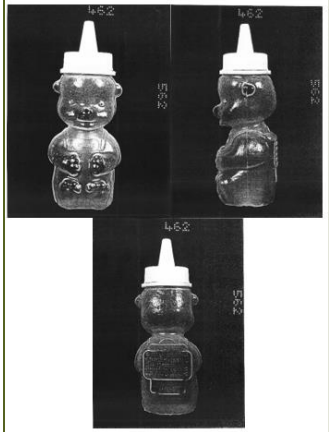
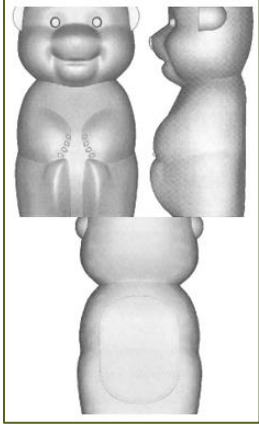
According to the FPC, this is particularly true with regard to radiator grills. Radiator grills constitute the “face of the car.” As opposed to the GCEU, the FPC considered that even a more general car user as the informed user was aware that radiator grills constitute the “face of the car” and, hence, would be more sensible in this regard. The FPC reconfirmed this opinion in its recent decision of 18 February 2021, 30 W (pat) 806/18 with regard to the design of car rims.

- Federal Patent Court, 18 February 2021, 30 W (pat) 806/18

Prior Art	Contested German design
	
<p>Outcome: Individual character of the contested design confirmed.</p>	

4. Hungary

- Judgement of the Supreme Court No. Pfv.IV.21.044/2012/7, dated 3 October 2012

Prior Art	Contested Hungarian design
	
<p>Outcome: Contested design declared invalid for lack of individual character.</p>	

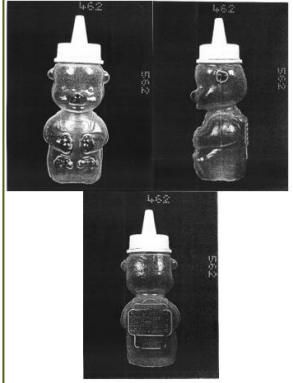

The Hungarian IP Office declared the contested design invalid since it lacks individual character. The Metropolitan Court, Metropolitan Court of Appeal and the Supreme Court upheld the resolutions with a similar reasoning.

The IP Office established that

- the prior design is the iconic bear shaped honey container, the main characteristics (the bear shape, the smile, the position of hands and legs, the ratio of width and height) determining the two designs are very similar.
- the designer's freedom is not restricted since honey containers can be manufactured in various forms.
- the Supreme Court established that the characteristics dictated by market constraints are irrelevant.

THE FUTURE OF DESIGN PROTECTION OF ITERATIONS

- Resolution of the Hungarian IP Office No. D1000028/21, dated 23 May 2019

Prior Art	Contested Hungarian design
	
<p>Outcome: Contested design declared invalid for lack of individual character.</p>	

The Hungarian IP Office declared the coloured design invalid, since it lacks individual character and established that

- the group of informed users is composed of both honey distributors and the children eating honey;
- the designer's freedom is not restricted since honey containers can be manufactured in various forms;
- the differences of are not sufficient to produce different overall impression.

On the basis of these decisions, it can be established that the Hungarian IP Office and the courts are strict on adjudging the individual character of designs differing only slightly from the predecessor product.

III. Alternative filing strategies for iterations

1. Design protection through applications for parts

Initially, the characteristics of the applicant's "design idea" or the applicant's "design language" should be clarified, e.g. by answering the following questions:

- Which design features of the predecessor product create a recognition value?
- What are the consumer expectations with regard to the design of the successor product?
- What changed design features does the successor product have?
- Is the successor product a complex product, i.e. a product composed of multiple components that can be replaced, allowing the product to be taken apart and reassembled?
- Can the evolved design features of the successor product be reasonably separated from the complex product in terms of design?

Against this background, only individual parts of the successor product, apart from the product as a whole, may be considered for filing.

Generally, the graphical representation of the design application must display all features of the design. The EUIPO allows up to ten different views representing the design, seven protected and three non-protected views. The applicant can use plain, in elevation, cross-sectional, in perspective or exploded views for the graphical representation. Both 3D and static images can be used. If the graphical representation shows a complex product, at least one of the views must show the complex product in assembled form (Art. 4 Community Design implementing regulation – CDIR; EUIPO Design guidelines: No. 5 Additional Requirements Regarding the Representation of the Design).

However, if the application of a single part of the successor product is not recommendable for any reason and also its position, proportion and use in relation to the overall product is relevant, so-called identifiers may be used to highlight certain parts or to exclude features from protection (EUIPO Design Guidelines: No. 5.4 Use of visual disclaimers to exclude features from protection). The EUIPO accepts the following identifiers:

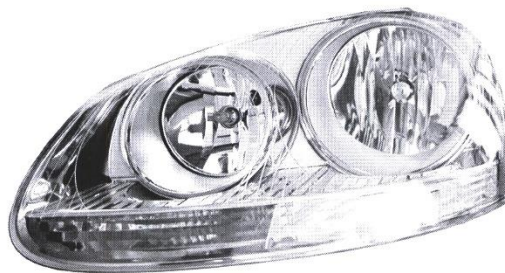
- Broken lines for indicating elements for which no protection is required.
- Boundaries for outlining features of the design for which protection is claimed.
- Colour shading and blurring for excluding a number of features from protection
- Separations for indicating that the precise length of the design is not claimed.

Even though no explanatory text, wording or additional symbols may be used in the graphical representation itself, a separate description not exceeding 100 words explaining the representation of the design may be added to the design application. The optional description does not replace the mandatory Locarno Classification and must relate only to those features which appear in the graphical representation. It must not contain statements as to the purported novelty or individual character of the design or its technical value (see Art. 36 (3) (a) CDR, Art. 1 (2) (a) CDIR). The optional description does not affect the scope of protection of the design as such (see Art. 36 (6) CDR).

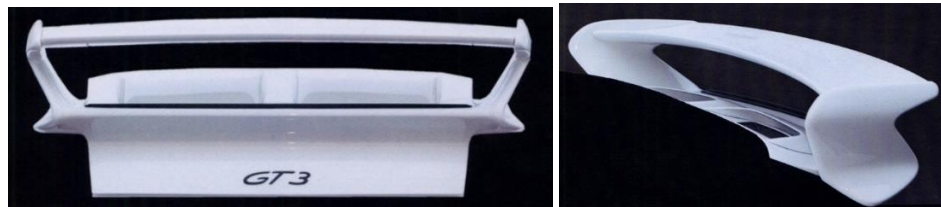
Examples:

1.1. Graphical representation of a single part

- RCD 000060876-0001 (Locarno 26.06 “Headlights for vehicles”)

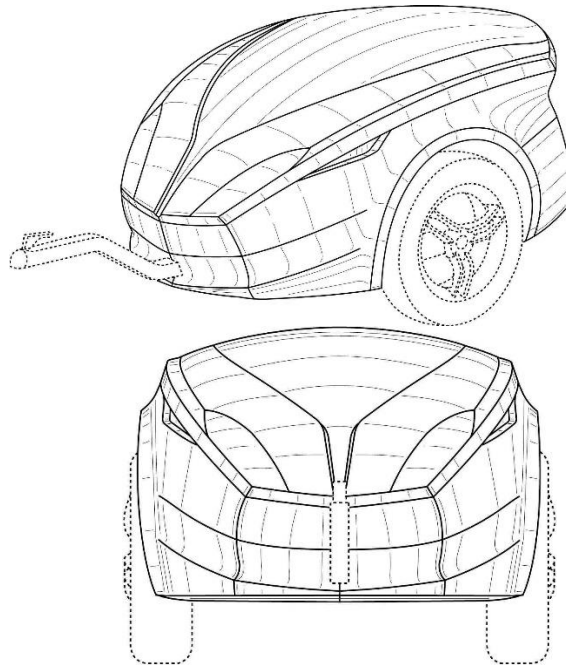


- RCD 000316740-0001 (Locarno 12.16 “Spoilers for vehicles”)

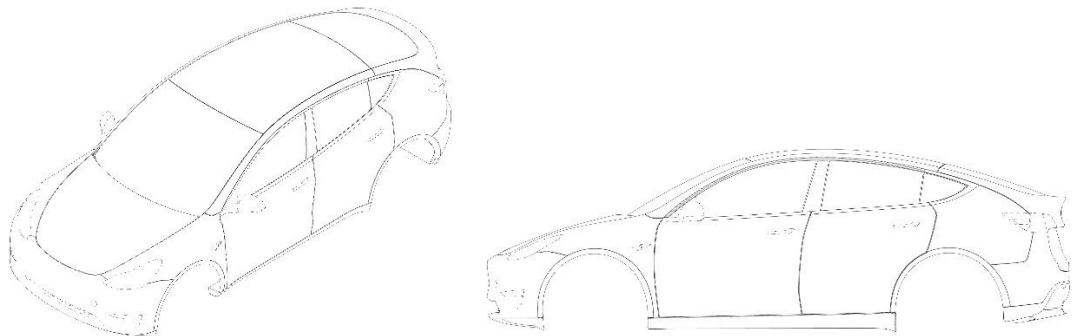


1.2. Graphical representation by broken lines

- RCD 001060321-0001 (Locarno no. 12.10 “Trailers”)



- RCD 006868618-0001 (Locarno 12.08 “Cars (part of -)”)

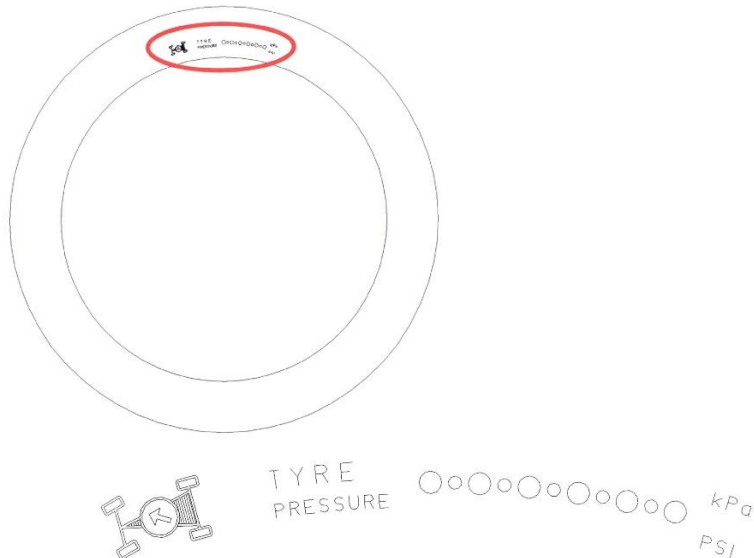


1.3. Graphical representation by boundaries

- RCD 001873688-0003 (Locarno 02.04 "Soles for footwear")



- RCD 000244520-0003 (Locarno 12.15 "Tyres for vehicle wheels, pneumatic (part of -)")

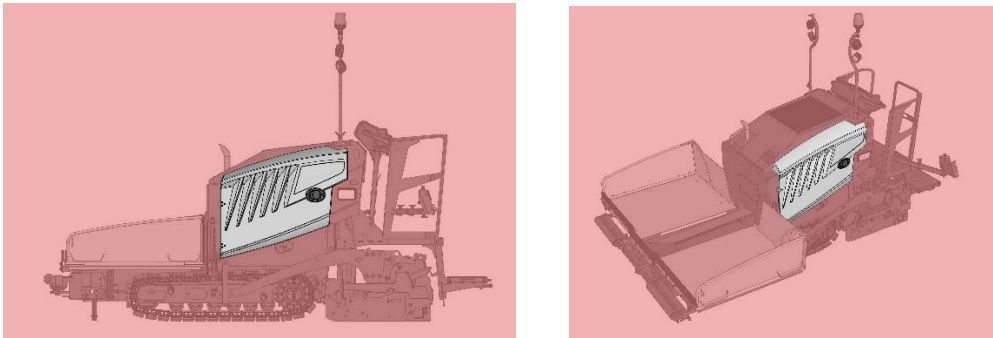


1.4. Graphical representation by colour shading and blurring

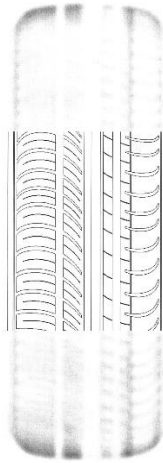
- RCD 000910146-0004 (Locarno 12.08 “Automobiles (part of -)”)



- RCD 005295680-0009 (Locarno 15.04 “Road making machines (part of -)”)

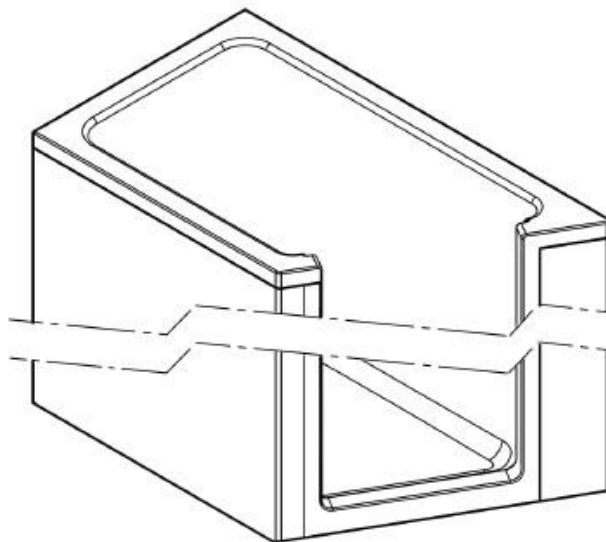


- RCD 000244520-0002 (Locarno 12.15 “Tyres for vehicle wheels, pneumatic”)



1.5. Graphical representation by separations

- RCD 002509430-0001 (Locarno 23.02 “Bath tubs”)



2. Trade mark protection as a 3D-mark

Trade mark protection as 3D-mark is, in principle, highly attractive for design iterations of iconic forms, given that it is the only IP right that does not have any time limitations. Compared to design protection, there are the following advantages/disadvantages:

Advantages:

- Protection as 3D-mark does not require novelty/individual character. Therefore, the successor products – for example “facelifts” of iconic car designs – can be subject to protection in principle regardless of the question of whether the amendments lead to a new design with individual character compared to the original model.
- Protection lasts forever, provided that the mark is renewed and used.
- The perspective of the target group is relevant for the assessment of the likelihood of confusion, with regard to end customer products the average consumer. Given that this consumer only rarely has the chance to make a direct comparison, the imperfect recollection of the marks in question is decisive.

Disadvantages:

- Trade mark protection is limited to identical/similar goods and services and the likelihood of confusion requires this similarity. Even as far as proof is provided that the 3D-mark has reputation and, thus, protection is granted beyond similar goods and services, this protection presupposes that the younger sign takes unfair advantage and/or is detrimental to the repute and distinctiveness of the senior mark.
- According to the case-law established by the GCEU and CJEU, the threshold to obtain protection as a 3D-mark is quite high, since the more closely the shape for which registration is sought resembles the product in question, the greater the likelihood of the shape being devoid of any distinctive character (CJEU decision of 29 April 2004, C-456/01 P and C-457/01 P, para 39). Only products which deviate significantly from the norm or customs are eligible for trade mark protection. In addition to these criteria, a value judgement is required that the applied for 3D-mark is distinctive.

Most recently, the CJEU confirmed the GCEU's view that the below shape of a bottle fulfils this requirement. According to the grounds, it seems that the CJEU does not require that the EUIPO specifies in a general and abstract manner every shape which corresponds to the standard and customary practice in the sector concerned, and rather accepts that the differences are stated (CJEU decision of 12 December 2019, C-783/18, para. 31, 32):



Even if distinctiveness is denied, applicants can try obtaining trade mark protection by relying on Art. 7 (3) EUTMR claiming that the shape has become distinctive as a consequence of the use which has been made of it. However, the hurdles are high as proof has to be provided for all EU countries (CJEU decisions of 25 July 2018, C-84/17 P, C-85/17 P and C-95/17 P). Hence, filing of a national trade mark might be considered.

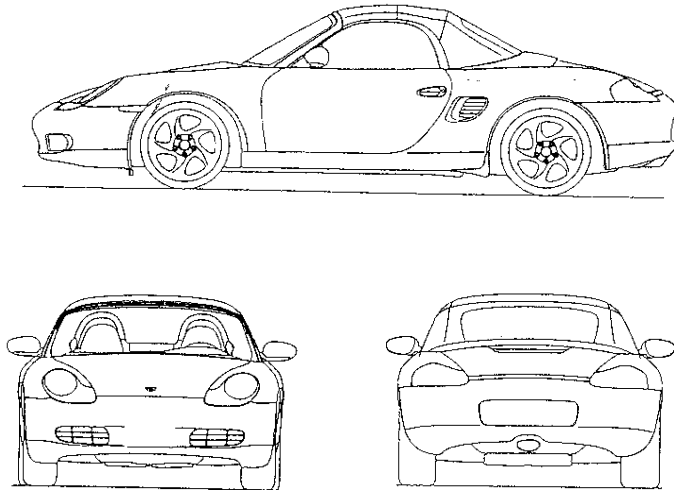
Shapes which exclusively result from the nature of the goods, which are necessary to obtain a technical result, or which give substantial value to the goods cannot be subject to trade mark protection. These obstacles cannot be overcome by arguing that the mark has become distinctive as a consequence of the use which has been made of it.

Examples:

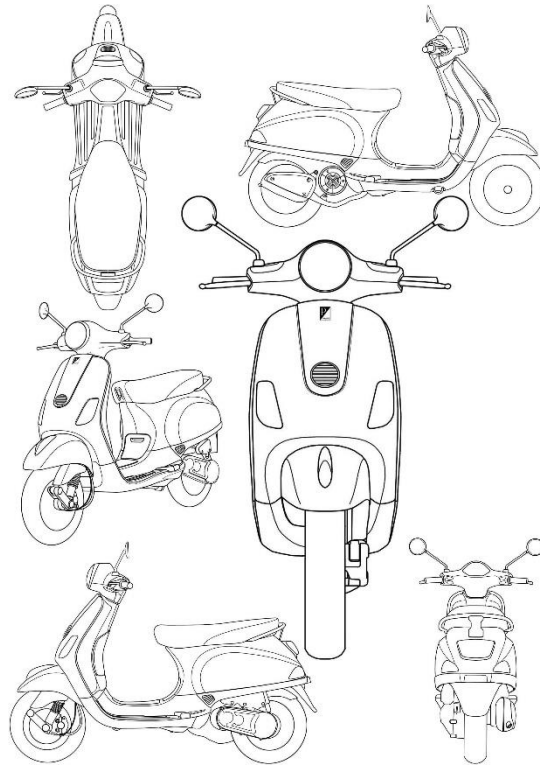
- EUTM 006542931



- EUTM 002765972



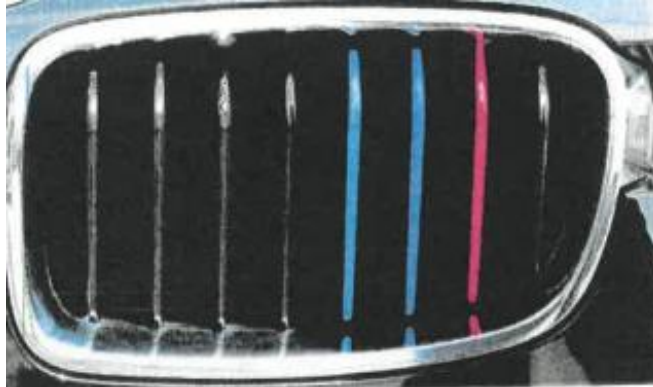
- EUTM 011686573



3. Trade mark protection as a colour-trade mark

Advantages:

- Registrations in the case of the 3-colours-combination might not need extensive use as a condition for registration. This is, for instance, the case with the so-called “M” colours (blue, violet, red), which indicate the origin of sports cars from Bayerische Motoren Werke AG (see, Regional Court Munich I, judgment of 22 January 2018, case No. 4 HK O 11014/17).



- As mentioned above protection lasts forever, provided that the mark is renewed and used.

Disadvantages:

- The scope of protection for colour marks is limited, even if there is a reputation for the colours or colour combination. Features of design icons can only be protected if the copy reproduces the same or similar colours. For instance, with regard to the “M” colours, there would be no trade mark protection if the colours were changed by the third parties. Thus, colour mark protection is, as opposed to 3D-protection, only of limited effectiveness for the protection of design icons against iterations. The situation may be different if proof can be provided that the colour mark has a reputation.

Examples:

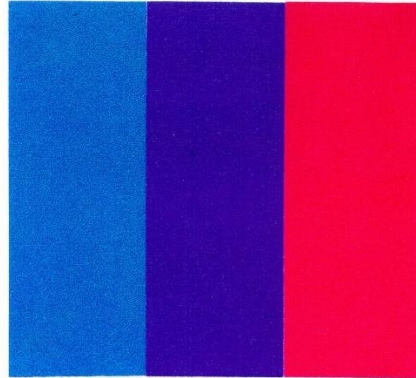
- [EUTM 000063289](#)



Description: The vehicle body is green; the wheels are yellow.

Colour: Green: Munsell 9.47 GY3.57/7.45; Yellow: Munsell 5.06 Y7.63/10.66

- [EUTM 002467876](#)



Description: Combinations of the colours blue, violet, red.

Colour: Blue, violet, red.

4. Design protection beyond registered rights

Another option for protecting an iterative design might be an unregistered right. Namely, the right holder might also pick from unregistered community design right, copyright, or protection by unfair competition law if certain conditions are met.

Compared to registered design rights, Community Design Regulation provides a short-term protection for unregistered community designs. Protection lasts for a period of three years and starts when a new design is made available to the public in such a way that the interested circles within the European Union could be aware of its appearance. Unregistered community designs must fulfil the same prerequisites as registered designs, such as those pertaining to novelty and individual character, for which the designer bears the burden of proof. Unlike a registered design, it is not necessary to file an application to obtain protection. Therefore, an unregistered community design right may be favourable for those market participants, who change their product appearance very often. The scope of protection granted to a registered design is much broader since unregistered community designs only protect against copying.

Furthermore, the CJEU has decided that unregistered design protection also extends to parts of a product or to component parts of that product, as a complex product, even in case the product was made publicly available only in its entirety. However, in order for it to be possible to examine whether that appearance satisfies the condition of individual character, it is necessary that the part or component part constitute a visible section of the product or complex product, clearly defined by particular lines, contours, colours, shapes, or texture (CJEU decision of 28 October 2021, C-123/20, Ferrari SpA v Mansory Design & Holding GmbH [Front-Kit]).

The authors of original iterations might also rely on copyright protection since, in certain cases, design rights and copyright can be granted cumulatively to the same object under EU law. Similarly to unregistered community designs, it is not necessary to file an application to obtain copyright protection and copyright also only protects against copying. However, the enforcement on the basis of copyright infringement may be problematic, since proving the eligibility for copyright protection might be difficult in certain cases, in particular as originality might lack due to the small iterative step.

Lastly, an iterative product appearance may also be protected via unfair competition law. Unfair competition law enforcement is designed to prevent misrepresentation in the course of trade to the public, for example, that there is some sort of association between the businesses of two traders. However, such protection is not harmonised on an EU level and national law applies in respect of the conditions that need to be met for the right to be successfully exercised.

IV. Conclusion

In light of the GCEU's "Porsche"-decisions, it will become more difficult for manufacturers, who have protected a new series or a "facelift" of an already known product by a RCD, to enforce such RCDs or to defend them against applications for a declaration of invalidity, if the RCD shows only minor differences in relation to the already known product. This applies to all kinds of industries, however, decisions relating, in particular, to the car manufacturing industry have been published. Nevertheless, two further decisions of the GCEU on a RCD of Volkswagen AG (GCEU decision of 6 June 2019, T-192/18) and of a Chinese Vespa manufacturer (GCEU decision of 21 September 2019, T-219/18) show that, under very similar conditions to those in the Porsche cases, the individual character of a RCD can be still affirmed and, thus, no uniform line of the jurisdiction of the GCEU has yet been established.

The appearance of iterations of a product may be protected by other IP rights than RCDs, such as a registered 3D-mark, a registered colour mark, an unregistered Community design or even by copyright or under unfair competition law. However, as has been shown, the threshold to obtain protection by such other IP rights may be quite high (see above for 3D-marks and colour marks), or practical problems may arise in proving eligibility for protection (see above for unregistered Community Design and copyright) and, even if protection is obtained, the scope of protection may be very narrow (see above for 3D-marks, colour marks and unregistered Community Design), or may even vary from EU Member State to EU Member State (see copyright and unfair competition law).

Manufacturers may, therefore, consider alternative strategies for obtaining protection for the appearance of iterations of their products.

Since no uniform line of case law of the GCEU with regard to the validity/enforceability of RCDs registered for iterations seems to have been established yet, manufacturers may still file an RCD application for the successor product as such. In addition, they may consider filing an RCD application for only the individual parts of the successor product. To save application fees, they may include the designs of the individual parts within the design application for the product as such by means of a multiple design application, provided that the product as such as well as the individual parts belong to the same main Locarno Class (they do not have to belong to the same subclass). If the position of the single part of the successor product and its use in relation to the overall product is relevant, identifiers may be used to highlight certain parts or to exclude features from protection.

ECTA, which was formed in 1980, is an organisation concerned primarily with trade marks and designs. ECTA has approximately 1,500 members, coming from all the Member States of the EU, with associate Members from more than fifty other countries throughout the world.

ECTA brings together those practicing in the field of IP, in particular, trade marks, designs, geographical indications, copyright and related matters. These professionals are lawyers, trade mark and patent attorneys, in-house lawyers concerned with IP matters, and other specialists in these fields. ECTA does not have any direct or indirect links to, and is not funded by, any section of the tobacco industry.

The extensive work carried out by the Association, following the above guidelines, combined with the high degree of professionalism and recognised technical capabilities of its members, has established ECTA at the highest level and has allowed the Association to achieve the status of a recognised expert spokesman on all questions related to the protection and use of trade marks, designs and domain names in and throughout the European Union, and for example, in the following areas:

- Harmonization of the national laws of the EU member countries;
- European Union Trade Mark Regulation and Directive;
- Community Design Regulation and Directive;
- Organisation and practice of the EUIPO.

In addition to having close links with the European Commission and the European Union Intellectual Property Office (EUIPO), ECTA is recognised by WIPO as a non-Government Organisation (NGO).

ECTA does also take into consideration all questions arising from the new framework affecting trade marks, including the globalization of markets, the explosion of the Internet and the changes in the world economy.