

Bird & Bird & Design Writes

April 2014

protect packaging graphic brand service architecture growth product market furniture lifecycle
manufacture interaction opportunities brand growth product design protect graphic
interior enforcement fashion web product design protect opportunities
market interior concept service lifecycle manufacture interaction
product transport furniture packaging packaging concept packaging
user experience growth brand market protect web
design graphic growth fashion brand concept web
user experience graphic growth fashion brand concept web product
growth service web interaction opportunities enforcement
process service web interaction opportunities enforcement
fashion service lifecycle and user experience interior
manufacture and opportunities innovation sign pro

Welcome to the third edition of DesignWrites

At Bird & Bird we're passionate about design. DesignWrites will unravel and explore the seemingly complex world of design protection, offering practical advice by looking at recent design cases, hearing from industry experts and sharing stories from the wider design community.

If you would like advice on how best to protect your designs or take action to stop copycats, please contact Ewan Grist via ewan.grist@twobirds.com for a complimentary consultation.

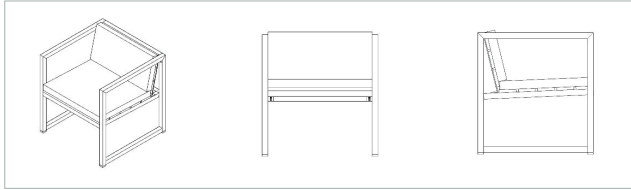


In this edition...

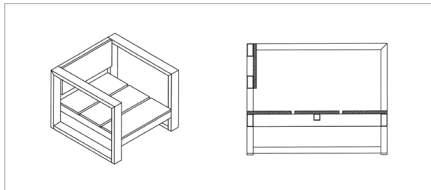
Armchair design found to have individual character	3	Q&A with designer Julia Landsiedl	18
The new German Design Act: more than just a new name? ...	4	Registered Community design for corkscrew invalid due to earlier design	20
For the love of fashion: protecting the beauty of fashion through Community design rights	6	No design right protection for heart-shaped tomatoes.....	21
Benelux: online design applications now possible.....	9	Italy special report: protecting your rights at Il Salone del Mobile of Milan	22
Court of Appeal overturns first instance decision in Trunki design case	10	Design Museum: Designs of the Year 2014.....	24
Registered UK design for a beer glass infringed	12	Upcoming industry events and awards	26
Copyright protection of papercuttings	14	Contacts	28
When is a design made available to the public?	16		

Armchair design found to have individual character

In the recent case of *Gandia Blasco SA v OHIM; Sachi Premium-Outdoor Furniture LDA*¹, the General Court (“GC”) has upheld the validity of the following registered Community design (“RCD”) for armchairs and loungers belonging to Sachi:



Gandia Blasco applied to invalidate this design based on their earlier RCD for armchairs, as follows:



Gandia argued that Sachi’s design lacked individual character; in particular, it stated that the overall impression of Gandia’s earlier design did not differ from the overall impression produced by Sachi’s design.

The OHIM Invalidity Decision rejected Gandia’s application to invalidate Sachi’s design. They found that, contrary to Gandia’s submissions, Sachi’s design was new and had individual character. This was confirmed by the OHIM Board of Appeal. Gandia then appealed this decision to the GC of the EU.

The GC agreed with the Board of Appeal that the informed user, by reference to which the individual character of Sachi’s design was to be assessed, was any person who habitually purchases armchairs and puts them to their intended use and who has acquired information on the subject, for example by browsing catalogues and the internet.

The GC also agreed with the Board of Appeal that the freedom of the designer of armchairs is almost



By Nick Boydell,
London

nick.boydell@twobirds.com

unlimited; the GC found that the only design limitation on armchairs is that they must be functional, that is they must include a seat, a backrest and two armrests.

Gandia claimed that the two designs produced the same overall “cube” impression. The GC disagreed, finding that the two sides of the armchairs are squares in the Sachi’s design but rectangles in Gandia’s earlier design. The fact that the earlier design had a lower seat was an important factor, since a user would notice this and the overall impression of a design must be determined in light of the way the design is used.

The GC pointed out further differences, such as the inclined seat and seat back in Sachi’s design, and the presence of an open space between the seat and the armchair in the earlier design. The fact that underneath the cushion, Sachi’s design was composed of plates similar to those in the earlier design was of little importance, since this similarity is outside the user’s field of vision.

The GC found that these differences would not escape the attention of an informed user and that two designs produced different overall impressions.

Therefore Gandia’s application for invalidity was dismissed.

Comment

The fact that the designer had almost unlimited design freedom was not sufficient to affect the conclusion that the registered design created a different overall impression on the informed user to that of the prior art design.

¹ Case T-339/12

The new German Design Act: more than just a new name?

The German Design Act was amended as of 1 January 2014.

The most important changes are:

New name

For many decades, German designs were called “*Geschmacksmuster*”. This rather old-fashioned term has now been replaced by the modern name “*eingetragenes Design*” (registered design), which is also easily understood on an international level.

However, this modernisation only applies to German national designs but not to Community designs which are still called “*Gemeinschaftsgeschmacksmuster*”. So far, no revision has been announced.

Time will tell whether right holders consider the new name more attractive and whether they will use proprietary notices like “*geschützt durch ein eingetragenes Design*” (protected by a registered design) more often.

Multiple applications

Multiple German design applications, which may comprise up to 100 single designs, do not now have to concern designs falling within the same product class. Therefore, a multiple application may now contain for example watches, jewellery and clothing.

This change might lead to considerable cost savings for applicants that file a higher number of designs for different products. However, this advantage does not apply to Community designs.



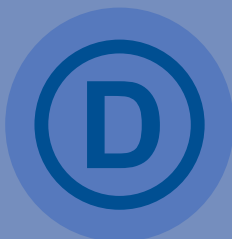
By Jana Bogatz,
Munich

jana.bogatz@twobirds.com

Invalidity proceedings with the German PTO

In the past, all invalidity proceedings against German designs had to be initiated with the competent civil court. As of January 2014, a special Division of the German Patent and Trade Mark Office (PTO) is responsible for any kind of invalidity proceedings against registered designs, except for counterclaims in design infringement proceedings. The invalidity decisions rendered by the German PTO can be appealed to the Appeal Senate of the Federal Patent Court, and in some cases to the Federal Supreme Court.

As before, design invalidity claims can be based on absolute grounds (e.g. lack of novelty or individual character) or relative grounds (i.e. earlier third party rights). The new proceedings resemble OHIM’s invalidity proceedings against registered Community designs.



However, the reform also introduces a new mechanism, which is known from non-use revocation proceedings against German trade marks: if an invalidity motion is filed with the German PTO and the design owner does not object thereto within one month from the service of this motion, the design will be cancelled without any further examination.

It will be interesting to see whether the lower costs will encourage more defendants in invalidity proceedings or even unrelated third parties to initiate invalidity proceedings against registered designs.

Infringement proceedings

In design infringement proceedings, there is now a presumption that the registered design is valid, comparable to the respective rules for Community designs. Therefore, in such a case, the defendant cannot simply defend himself by challenging the validity of the registered design. For that purpose, he must now file a counterclaim for declaration of the invalidity of the registered design or an invalidity motion with the German PTO.

If invalidity proceedings are pending at the German PTO, the court may suspend the infringement proceedings if it considers the design as null and void. In this respect, the proceedings resemble the proceedings regarding Community designs.

Conclusion

Besides the new terminology and some changes in the formal application process, the transfer of the responsibilities for the invalidity proceedings to the German PTO is the most relevant change introduced by the new German Design Act. Time will tell whether the new invalidity proceedings are indeed less costly, quicker and more efficient.



TM



SM



For the love of fashion: protecting the beauty of fashion through Community design rights



While most fashion trends may come and go in a heartbeat, some never go out of style. The Birkin bag, Cartier's L@Ve bracelet, Chanel's classic flap bag - all unique, timeless, classic designs that have become synonymous with the brands that created them.

The fashion industry invests significant resources to create new and original designs each season to entice the public. Despite this substantial investment, not enough use is made of design rights to register and protect the aesthetics of these vibrant and creative designs. Design rights protect both the 2D and 3D appearance of a product or part of that product, whether that be a fabric pattern or the shape of a shoe for example.

Why protect your design?

Designs are potentially extremely valuable property rights. Design rights can, for instance, be transferred (sold) or given in pledge to a bank as part of your company's assets. They can also be licensed to third parties, such as retailers. In the fashion industry, successful designs of jewellery, watches, clothing, handbags, shoes and sunglasses are often copied. Even though copying is endemic in this industry, intellectual property law offers a raft of rights to fashion designers to stop others from unfairly benefiting from the designer's creativity and craftsmanship.

Protecting your design in the European Union: the Community design

There are two different types of design rights in the European system of design protection; the protection of registered designs and of unregistered designs. The laws relating to these design rights are harmonised and a single Community design offers protection in all 28 countries of the European Union.

To enjoy protection, the design has to be "new" and has to have an "individual character". The design is regarded as new if, on the date of filing, no identical design (being a design whose features differ only in immaterial details) has been made available to the public. Publicly disclosing your designs prior to registration, for instance by having your designs appear in fashion magazines or at a fashion show may result in having lost the ability to protect those designs. Fortunately, in Europe, a designer has 12 months from first disclosure of a design to apply for registration (known as the *grace period*). This grace period can also be used to assess whether a particular design is likely to warrant the additional protection afforded by registration.

A design is considered to have 'individual character' if the overall impression it produces on the 'informed user' differs from the overall impression produced on said user by any design which has been made available to the public previously. The informed user is a particularly observant user who, without being an expert or designer, will be aware of the various designs which exist in the sector concerned, possesses a certain degree of knowledge regarding the usual features of designs and, as a result of his/her interest in the products concerned, shows a relatively high degree of attention when using them. For example in a case concerning handbag designs, it would be someone who knows and can differentiate

between brands and styles of handbags, but not the handbag designer. The informed user might be for instance a fashionista or fashion blogger.

A registered Community design is obtained through registration with the Office for Harmonisation in the Internal Market (OHIM), which is a quick and relatively inexpensive procedure. Registration initially protects your design for five years from the date the application was filed. The design registration can be renewed for additional periods of five years with a maximum term of 25 years. For unregistered Community designs on the other hand, protection arises automatically and is effective as soon as the design has been made available, i.e. disclosed, to the public within the Community. An unregistered Community design provides protection for a period of just only years.

Unregistered Community designs are often unfairly overlooked in the intellectual property armoury of rights. They provide a useful and cost-effective tool especially for fashion designs which have a relatively short product life cycle. The unregistered Community design provides important protection to fashion designers who struggle to realise return on their creative investments, particularly up and coming designers.

Enforcement of design rights

By registering your designs, you can take action against infringing designs made by third parties. Specifically, the design owner can stop the use (which includes the manufacture, provision, trade, sale, supply, rental, import and export) of a product in which the design is incorporated and which is identical to, or creates the same overall impression as, the protected design.

Another important difference between enforcing a registered Community design and an unregistered Community design is that in respect of the unregistered design right the designer must show that copying has taken place, whereas no such requirement exists for the registered right. It is therefore often easier to enforce the registered right.

Finally, when determining infringement all that matters is the overall impression created by the two designs, not the exact number of changes that might have been made. It is important for designers to know that the persistent misconception that if you make seven changes to a design, it becomes a new design and does not infringe the original design is incorrect.

Filing strategy tips and tricks

For the reasons mentioned above, there is no doubt that the legal protection conferred by a registered design is stronger and serves as a greater deterrent than the corresponding unregistered right. In the fast moving and seasonal world of the fashion industry, it can of course be a costly to register every new design before putting it on the market. The unregistered right therefore has an extremely important role to play and may be the better strategic choice for your business.

It is important for the industrial and commercial interests of the fashion industry to develop a suitable design protection/filing strategy and it is worth keeping the following tips in mind:

- Check prior art as a design is only protectable if it is new and has individual character;
- For each design, establish/estimate the lifespan of the product in order to decide which route of protection (registered or unregistered design) is most suitable;
- Ownership: have clarity on the ownership of the designs that you create by entering into contracts with employees, free-lancers, etc which spell out who owns the designs;
- Make sure you date, store and archive drawings, sketches, mood-boards and other items that are part of the design history and process so that you can prove the existence and ownership of your unregistered rights;

- From a cost efficiency perspective: consider filing multiple applications which allows you to include several designs in one application;
- Consider deferment: a Community design must be published, however publication may be delayed for up to 30 months which means that your product can be kept confidential until you are ready to disclose it (for instance just before a catwalk show);
- Be cautious of ‘over-filing’ as one design might be detrimental to the novelty of a (very) similar later design application;
- Be clear on dotted lines. Features of a Community design which are marked with dotted lines are excluded from the scope of protection, unless it is made clear that protection is also sought in respect of such features;
- Be clear with colours: if you include colour in your design, that colour will form part of your protected design. If you wish to protect your design in *any* colour, consider filing black and white line drawings as well.

In this article, we have focused exclusively upon Community design protection. Designers should however be aware that other rights may be available to protect their work including national design rights, copyright and trade mark rights. Whether such rights are available or appropriate will depend on the nature of the work in question and the country in which protection is sought.



By Lara van Huizen and Linda Brouwer,
The Hague

lara.van.huizen@twobirds.com
linda.brouwer@twobirds.com



Benelux: online design applications now possible

As part of a broader initiative to improve its services for designers, the Benelux Office for Intellectual Property (BOIP) has introduced the option to submit design right applications online.

As of 27 January 2014, the procedure has become available on the website www.boip.int, and registrations can be applied for and managed via a personal account ("My BBIE"). Filing for Benelux design online is quite straightforward, leading to faster and simpler registrations:

- rather than having to print out forms, annexes and/or explanatory notes, and returning them by mail or fax, or submitting them in person, designs can be filed electronically;
- the applicant is provided with guidance throughout the five step application process, thereby reducing the risk of deficient filings;
- online filing allows for better graphical quality. In a system where the importance of clear and correct representation of the design cannot be overstated, this offers obvious benefits;

- the registration process will take about four months and, for a simple design, the official fees of the BOIP are €108 plus €10 per representation; and
- the applicant receives confirmation once the application is received by the BOIP. Assuming all formalities are met, the BOIP will provide proof of actual registration, and the Benelux design right will then be protected.

Whereas traditional methods of applying for Benelux designs remain available, it is to be expected that online filing will soon take over almost completely, just as it did upon introduction of the online filing system for registered Community designs (almost 80% of which is now filed online).



By Domien Op de Beeck,
Brussels

domien.op.de.beeck@twobirds.com



Court of Appeal overturns first instance decision in Trunki design case

On 28 February 2014, the Court of Appeal handed down its decision in *Magmatic Ltd v PMS International Limited*², finding that PMS' Kiddee Cases did not infringe Magmatic's registered Community design ("RCD") for its Trunki children's suitcases, thereby reversing the decision of Arnold J in the High Court from July 2013.

At first instance, Arnold J held that the RCD protected the shape of the case only and therefore the proper comparison was with the shape of the Kiddee Case. Other aspects of the design of the Kiddee Case, such as its surface decoration, were to be ignored. Applying this interpretation, Arnold J held that the Kiddee Case infringed Magmatic's RCD as it created the same overall impression on the informed user.

Judgment

The Court of Appeal found (with Kitchen LJ giving the leading judgment) the Judge's reasoning to be flawed in two respects:

- the Judge failed to appreciate that the RCD is a design for a suitcase which, considered as a whole, looks like a horned animal; and
- although the RCD representations were monochrome (as shown above) meaning that the design was not limited to particular colours, and thus PMS could not point to the colour of the Kiddee Case as being a point of distinction, nevertheless each of the representations showed a distinct contrast in colour between the wheels and the strap on the one hand, and the rest of the suitcase on the other.

The Court of Appeal went on to explain how these errors in characterising the RCD carried through into the comparison made by the Judge between the RCD and the Kiddee Case.

Firstly, the global assessment of the RCD and the Kiddee Case requires a consideration of the visual impression they each create. The surface decoration of the Kiddee Case significantly affects how its shape strikes the eye, and thus the overall impression made, and so it should not have been disregarded by the Judge. For example, with regard to the Kiddee Case shown above, the whiskers and stripes make it clear that it looks like a tiger with ears, and not a horned animal, which was the impression created by the Trunki RCD.



Magmatic's RCD



Magmatic's Trunki case



PMS' Kiddee Case

Secondly, the Court of Appeal held that the colour contrast between the wheels and the body of the RCD was a striking feature which was not present in the Kiddee Case design.

In light of the errors in the Judge’s analysis, the Court of Appeal reapplied the assessment of similarity and found that overall impression created by the two designs on the informed user was “very different”. Kitchin LJ concluded as follows: *“The impression created by the RCD is that of a horned animal. It is a sleek and stylised design and, from the side, has a generally symmetrical appearance with a significant cut away semicircle below the ridge. By contrast the design of the Kiddee Case is softer and more rounded and evocative of an insect with antennae or an animal with floppy ears. At both a general and a detailed level the Kiddee Case conveys a very different impression.”*

Accordingly the Kiddee Case was found not to infringe Magmatic’s RCD.

Comment

This case reinforces the principle that the scope of a registered design is to be determined from the representations in the registration. Furthermore, the Court of Appeal approved the principle that, where a design is in black and white, it protects the shape of the product in whatever colour it may be. In this case however, whilst the representations were in monochrome, the Court of Appeal distinguished them from simple black and white line drawings indicating shape, instead describing them as: *“computer generated three dimensional images which show the suitcase from different perspectives and angles and show the effect of light upon its surfaces.”* Ultimately, the sophistication of the representations led the Court of Appeal to conclude that RCD comprised more than just its shape; it included contrasts in (unspecified) colours as well. A simple black and white line drawing representation may in fact have afforded the Trunki RCD a wider scope of protection although of course an overly simplistic representation could put the validity of the RCD at risk.

This case also makes clear that even when the RCD comprises monochrome representations without any surface decoration, it does not necessarily follow that all surface decoration on the allegedly infringing design should be disregarded.



By Ewan Grist and Will Smith,
London

ewan.grist@twobirds.com
will.smith@twobirds.com

*The Court of Appeal
reapplied the
assessment of similarity
and found that overall
impression created
by the two designs
on the informed user
was “very different”.*

² [2014] EWA Gv 181

Registered UK design for a beer glass infringed

In *Utopia Tableware v BBP Marketing*³, the Judge held that Utopia's UK unregistered design right in the shape of the profile of the outer surfaces of its 'Aspen' beer glass design was valid and had been infringed by BPP's 'Aspire' beer glass. The Aspire was also found to infringe Utopia's UK registered design for the Aspen.

Utopia's main design drawing and the registered design are shown on the right.

Validity

The court held that UK unregistered design right subsisted in the following features of the Aspen glass which were original and not commonplace:

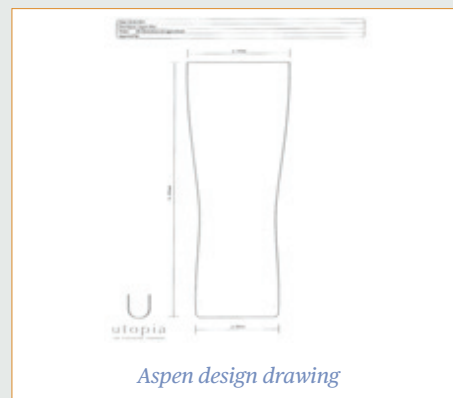
- The shape of the profile of the outer surfaces of the glass, including a waisted section, an elongated tulip shaped section which tapers inwardly as it approaches the rim;
- The shape of the profile of the inner surfaces;
- The shape of the rim connecting the inner and outer surfaces; and
- The thickness of the base.

The court held that the informed user was unlike many beer drinkers in the real world, some of which paid little attention to the design of their glass

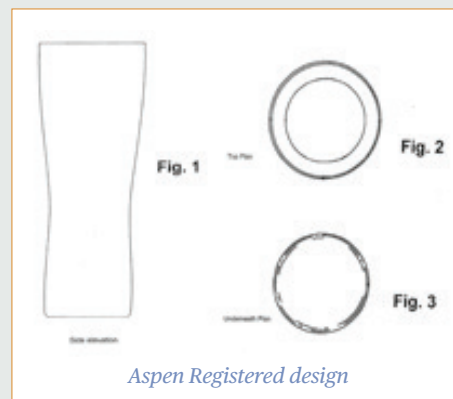


Emily Mallam,
London

emily.mallam@twobirds.com



Aspen design drawing



Aspen Registered design

³ [2013] EWHC 3483 (IPEC); 12.11.13

The overall impression created by the Aspire glass was the same as the registered design and therefore also infringed the registered design. The fact that the Aspire glass was made of a different material to the Aspen glass was irrelevant since the registered design did not specify any material.

With regard to the registered design, the court held that the informed user was a person who had knowledge of the existing design corpus, was interested in the products concerned, showed a relatively high degree of attention when using them and conducted a direct comparison of the designs in issue unless there were specific circumstances which made it impractical or uncommon to do so. He held that the informed user was unlike many beer drinkers in the real world, some of which paid little attention to the design of their glass. Finding that the registered design had the necessary individual character, the court considered that designers of tall waisted beer glasses had only a limited degree of freedom (the glasses in question had to be tall and have a waist). Therefore, even minor differences were sufficient to confer individual character. Aspects which could be varied included the position and diameter of the waist, which were all features that the informed user would notice. Considering the overall impression created by the prior art as against the registered design, the registered design was found to have individual character.

Infringement

The court held that BPP's Aspire glass was plainly made substantially to the unregistered design right subsisting in the Aspen glass and so was infringing. Furthermore, the overall impression created by the Aspire glass was the same as the registered design and therefore also infringed the registered design. The fact that the Aspire glass was made of a different material to the Aspen glass was irrelevant since the registered design did not specify any material.



Copyright protection of papercuttings

Suzy Taylor v Alison Maguire⁴

The English court has recently found that Maguire had infringed Taylor's copyright in original artistic works comprising various papercut letters and other designs.

Taylor was a relatively well known artist in the medium of papercutting and sold her work from a Facebook page in the name of Folk Paper Arts. Maguire produced papercutting works which she exhibited and sold from a Facebook page in the name of PAPERTastic.

Taylor claimed that the defendant had infringed the copyright in her works by creating, replicating, possessing and dealing in various papercut works, some of which are shown on the right (Taylor's work on the left, Maguire's work on the right in each): Maguire denied copyright infringement on the basis that her works had been independently created (i.e. they had not been copied), Taylor's works were not original, and/or any similarities between Taylor's and Maguire's works were not substantial.

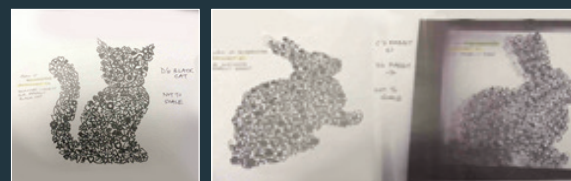
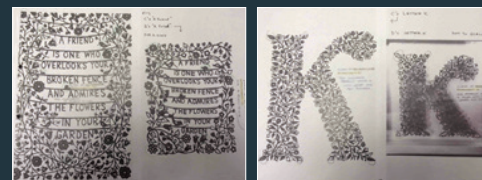
The court held that a papercut work could be protected by copyright as an artistic work (under the Copyright, Designs and Patents Act 1988) and that the claimant's works were original and so enjoyed copyright protection. In so finding, the court took into account that in creating each of the works, Taylor made detailed choices including the overall shape of the design, the structure of stems and branches to give them a plant-like appearance and the infill of designs with flowers, birds and insects.

The Judge went on to compare each of Taylor's and Maguire's works side by side, concluding that there were sufficient similarities between each to find that Maguire had infringed Taylor's copyright by copying at least a substantial part of the protected works.



Emily Mallam,
London

emily.mallam@twobirds.com



⁴ [2013] EWHC 3804 (IPEC)

The court held that a papercut work could be protected by copyright as an artistic work and that the claimant's works were original and so enjoyed copyright protection.



When is a design made available to the public?

In its recent decision in *H.Gautzsch Großhandel v Münchener Boulevard Möbel Joseph Duna*⁵, the CJEU considered the meaning of Articles 7(1) and 11(2) of the Community Design Regulation (“CDR”)⁶, concerning the circumstances in which an unregistered design is deemed to have been made available to the public.



By Will Smith,
London

will.smith@twobirds.com

Background

The dispute concerned a gazebo marketed in Germany by MBM Joseph Duna which was designed in the autumn of 2004. Gautzsch Großhandel marketed a similar gazebo, manufactured in China by a company called Zhengte, and Joseph Duna brought an action for infringement of its unregistered Community design right.

To qualify for protection, a design must be new and have individual character compared to any designs which have previously been made available to the public within the Community.

Under Article 7(1) of the CDR, a design is made available to the public when it has “been published... or exhibited, used in trade or otherwise disclosed... except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community”.

The period of protection for an unregistered design (three years) begins from the date on which it was first made available to the public within the Community, which is considered to be under Article 11(2) when it “has been published, exhibited, used in trade or otherwise disclosed in such a way that, in the normal course of business, these events could reasonably have become known to the circles specialised in the sector concerned, operating within the Community”.

Joseph Duna relied on 300-500 leaflets it published and distributed to various traders in April and May 2005, which contained an image of the gazebo, as being a first disclosure.

Gautzsch Großhandel claimed that its own gazebo had appeared in Zhengte’s Chinese showrooms, and had

been presented to European customers, in March 2005, prior to the publication of Joseph Duna’s leaflets. It also sent a model to a Belgian company in June 2005.

Judgment

The CJEU was asked to determine whether either of the acts of Joseph Duna or Gautzsch Großhandel could amount to ‘making available to the public’ within the meaning of the CDR. The key question raised was: at what point does a design become known to “circles specialised in the sector”? Does this include traders as opposed to manufacturers? Does it extend to activities outside the EU? Is it engaged by disclosure to a single undertaking in the EU?


Having considered these questions, the CJEU would not rule out that any of these actions could amount to ‘making available to the public’. However whether they actually did so was a question of fact and circumstance for the national court to determine.

Comment

The CJEU’s judgment leaves open the possibility that even a very limited disclosure could, in certain circumstances, amount to ‘making available to the public within the Community’. Designers should therefore continue to exercise caution when disclosing their designs, especially if they wish to apply for registered design protection, as an earlier disclosure could unintentionally invalidate this registration. Where there are concerns about inadvertently making a design available to the public, designers should consider disclosing under the protection of a confidentiality agreement.

⁵ C-479/12

⁶ EC No. 6/2002



The key question raised was: at what point does a design become known to “circles specialised in the sector”?

Q&A with designer Julia Landsiedl

Julia Landsiedl started her design career with a Master's in Law - as a copywriter in advertising and branding. She went on to study Product and Process design in Vienna and Berlin, before working for the design consultancy, IDEO, in Silicon Valley. However, she has now returned to Vienna to open her own studio in 2008 and since then has been working on a variety of projects and products. Julia's main focus is three dimensional storytelling - developing and staging the stories, services and spaces that surround an object or a brand. Julia's awards include the Nespresso Sustainability Design (2nd prize) and the BMUKK outstanding artist award for experimental design.



Julia Landsiedl

www.jeplus.at



“I think most people do not really know what “Intellectual Property” means. That is problematic.”

Images reproduced with kind permission of Julia Landsiedl

Left: Endemites (jewellery)

Photo credit: J Landsiedl for A. E. Köcherl Juweliere

Above right: Old Pot New Top

Bottom right: Eraser Lamp

Photo credit: Myrzik + Jarisch/moree (design with Steffen Kehrlé)



Do you have a signature style and/or specific approach to your work?

It's analytical yet playful with a peculiar passion for humble everyday objects. Some might say, I design stories not things.

What's your favourite design object or product (excluding your own) and why?

Drop action pencils - I love the sound!

Which trends do you think have an influence on design today?

Are shrinking resources a trend? If not the key words would be "DIY", "sustainability" and "social". Let's hope that lasts.

What is the biggest challenge that you, as a designer, are currently facing in relation to your work?

Design has to seem light and effortless, but is often the result of hard work. It's something clients need to learn (and learn to pay for).

Some people say "imitation is the highest form of flattery" - do you agree?

No I don't. But as far as the formal aspect of a product is concerned, there simply is (almost) nothing new under the sun. Luckily design is about much more than shape.

It is common practice for designers to look to a variety of sources for inspiration. Sometimes there is a fine line between inspiration and copying. How do you deal with this challenge?

Eclecticism, thus I take the world apart and re-assemble it. No one ever complained.

Does Intellectual Property have an effect on your work?

I think most people do not really know what "Intellectual Property" is/means. That is problematic.

What's your experience with the exploitation of design as Intellectual Property?

Nowadays a lot of design work happens in varying, project-specific teams. Often there is no formal contract concerning those collaborations and their outcome. People are more like "Hey, let's work together and see what happens!", which can be problematic as soon as there is something to exploit. Personally I prefer more formal collaborations.

For more information about Julia, please visit www.jeplus.at

Registered Community design for corkscrew invalid due to earlier design



Ning-Ning Li,
London

ning-ning.li@twobirds.com

In the recent case of *El Hogar Perfecto del Siglo XXI, SL v OHIM; Wenf International Advisers Ltd*, The General Court (“GC”) has upheld the Board of Appeal’s findings that a Community design for a corkscrew was invalid under Articles 4, 6(1)(b) and 25(1)(b) of the Community Designs Regulation⁷.

El Hogar was the owner of the Community design in question (representations of which are shown below left).

Wenf International applied for a declaration of invalidity, relying on its earlier Spanish registered design for bottle openers (representations of which are shown below right).



El Hogar RCD



Wenf earlier design

Informed user

The GC held that the BoA had correctly found that the informed user for the purposes of assessing the individual character of the contested design could be both a private individual and a professional (e.g. waiter, sommelier). Such a user would be knowledgeable about wine and related accessories and possess a degree of knowledge as to wine-bottle openers on the market.

The GC rejected El Hogar’s submissions that the informed user was exclusively a ‘person who works with wine and/or in the supply thereof’, and in any event El Hogar had failed to establish that limiting the definition to professionals would affect the BoA’s finding on this issue.

Degree of freedom of the designer

The GC held that the general appearance of a corkscrew was not determined by the existence of technical constraints and may vary considerably. In relation to the handle in particular, it was not dictated by functionality, was the central and biggest element of the corkscrew and may take various forms and vary in size. The BoA was correct to find that the designer’s degree of freedom with respect to corkscrews was high.

Overall impression produced on user

The GC held that the differences between the designs at issue highlighted by El Hogar (slight differences between the handles, the size of the small blade, the material and colour of the helical screw and the support notches in the double lever) were either irrelevant or insignificant.

The alleged functional advantages of the contested design compared to the earlier design, even if established, were irrelevant for the purpose of proving the individual character of the design.

The contested design and earlier design did not produce different overall impressions on the informed user, who would not go beyond a certain level of examination, and therefore the design lacked individual character.

⁷ T-337/12

No design right protection for heart-shaped tomatoes

In 2013, OHIM's Board of Appeal ruled that living organisms as such do not meet the definition of a Community design⁸. The applicant sought to register a heart-shaped tomato as a Community design for vegetables and fruit.

OHIM refused the registration as it found that the heart-shaped tomato did not comply with the definition of a design. According to the Community Design Regulation, '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 'product' means any industrial or handicraft item (...).

In appeal, the applicant inter alia argued that the design is unique and is a result of an industrial, handicraft process and that by rejecting the design, technological developments in the global agricultural sector are disregarded.

OHIM's Board of Appeal set the applicant's arguments aside and took the same approach as the examiner. The Board considered that living organisms as such are not 'products', i.e. they are not considered industrial or handicraft items, and concluded that a design with the appearance of a tomato in its natural state, should in principle be refused.

The claim that the shape of the tomato is unique and engineered did not appear to make any difference, as the Board furthermore found that even if the shape differs from a common tomato, nothing indicates that the shape results from an industrial or manual treatment and not from a special plant variety. According to the Board, even if the shape of the tomato would actually be unique, this would still not mean that the design is the result of an industrial or handicraft process.

So much for design registration of heart-shaped tomatoes.



By Richella Soetens,
The Hague

richella.soetens@twobirds.com



*OHIM rejected
RCD 1943283-0001*

⁸ OHIM Appeal Decision, 18 February 2013, R 595/2012-3. The decision is only available in Dutch and has only recently been published in OHIM's newsletter.

Italy special report: protecting your rights at Il Salone del Mobile of Milan



By Licia Garotti,
Milan

licia.garotti@twobirds.com

From 8-13 April 2014, Il Salone Internazionale del Mobile will be held in Milan. With more than the 68% of foreign operators, it is considered one of the most important global showcases in the design furnishing industry. Of course, whilst it is on, Milan becomes alive with fashion and design shows in every corner of the city.

If you are planning on attending to showcase your design, you need to be well prepared against possible infringements. The following suggestions may help.

- Some questions need to be answered in advance of the fair. Firstly, is my product protected against possible copying? In other words, is it covered by intellectual property rights?
- The owner of an intellectual property right (including registered and unregistered designs and trade marks) is entitled to file an application with the Company Specialized Section of the Court of Milan seeking for an order of judicial description (descrizione giudiziale) of the suspected infringing items being displayed at the fair. If considered well grounded (i.e. if the Court agrees about the likelihood of the enforced right being both valid and infringed), the Court bailiff, together with an expert appointed by the Court, is invited to access the fair and “describe” the suspected infringing products, taking pictures and possibly taking other available evidence of the infringement. This will allow the right owner to take possible enforcement action for the infringement (including getting a preliminary injunction and seizure of the infringing products).
- So, if it is possible that you might need to enforce a registered intellectual property right, such as a Community or Italian registered design, you should make sure that you have with you all relevant documents and information, including copies of the registrations (or indeed applications which can also be enforced in Italy). The same applies if you have an International Design designating the Italian territory.
- If your product design is not registered, it may still be protected as unregistered Community design if first disclosed less than three years ago, but you would need to be able to demonstrate that this was the case.
- Moreover, you should also consider whether you can prove that, before your product was first made available to the public, no prior identical design was already known and that your design has individual character (i.e. it produces a different overall impression on the informed user than any other previously existing design)? In this regard, get as much as information as possible about the history of the product design: how it originated, what inspired the designer, how it was developed, and so on.
- Remember that an unregistered design disclosed less than one year ago may still be registered as a Community design.
- If you prefer to wait and to build a case, be proactive: gather any available evidence of the suspected infringement, such as brochures and leaflets, pictures demonstrating the exhibitions of the product during the fair and any written offer of the product.
- One last recommendation: bring an umbrella - Il Salone del Mobile without rain is almost unknown!

Did you know that...

... the first showcase of your product at a fair can be the date of the first disclosure of your design for the purposes of the relevant protection as unregistered design?

Make sure that you collect and keep evidence of it!



Milan Design Week: facts and figures 2013

- The last event was attended by 285,698 trade operators, with 193,024 visiting from outside Italy
- Over 38,000 members of the general public and 6,578 communication operators attended
- A total of 1,269 exhibitors were present, almost 25% of these being non-Italian
- The event was well attended by the media with over 5,000 journalists joining

Design Museum: Designs of the Year 2014

Designs of the Year 2014 is a great moment to celebrate original talent and cutting-edge innovation, and also to take stock of recent developments in design practice. The annual competition and accompanying exhibition at the Design Museum showcase the very best in global Architecture, Digital, Fashion, Furniture, Graphic, Product and Transport design. That this year's competition brings together Kate Moss's favourite app, a floating school in a Nigerian lagoon, friendly lamp posts, virtual mountain rescue teams, and a recoiling mudguard, gives an idea of incredibly diverse range of designs on show.

The broad reach of Designs of the Year allows for an overview of emerging trends and common themes from across different design disciplines. This year the ubiquity of the smartphone is particularly apparent, as is the disruptive effect of crowd-funding sites such as Kickstarter. More than ever, designers are seeking to blur boundaries between the digital and physical worlds with new ideas like the calendar made of Lego that syncs with your computer/phone diary and the fire alarm that texts to let you know that everything's ok.

The nominees include international design stars such as Zaha Hadid, John Pawson, Stephen Jones, David Chipperfield and Miuccia Prada, alongside crowd-funded start ups and student projects. A distinguished panel of experts will chose a winner from each category and an overall winner later in the spring; but the Design Museum is keen for everyone visiting the exhibition, and the millions of design-loving tweeters and facebookers across the world, to pick their own favourite designs from this year's crop through the Visitor Vote and the new Social Vote.

The Visitor Vote takes place in the exhibition throughout its run, while the Social Vote sees two nominations fight it out each day through the Designs of the Year online Social Vote platform. Broadcast to over one million of the Design Museum's Twitter and Facebook followers, the Social Vote will be a great opportunity to get involved even if you can't make it to Shad Thames to see the exhibition itself.

Designs of the Year is famous for pitting the ingeniously amusing against the admirably innovative. This year is no exception, as addictive games compete against lifesaving medical equipment and futuristic cars square up to catwalk gowns. The conversation, debate, and (hopefully good-natured) arguments that result from placing these hugely different designs alongside each other are some of the richest outcomes of Designs of the Year as a whole.





A selection of this year's designs

Top left:

ME.WE: Forward-Thinking Car

Designed by Massaud and Toyota ED2

Photograph by Small Dots

Top right:

Makoko Floating School

Designed by NLÉ, Makoko Community Building Team

Photo by NLÉ

Bottom left:

Lego Calendar

Designed by Adrian Westaway, Clara Gaggero,

Duncan Fitzsimons, Simon Emberton

Photograph by Adrian Westaway

**Bird & Bird is proud to support
'Designs of the Year 2014'**

Upcoming industry events and awards

Design Week Portland

4 - 11 October 2014
Portland, USA

Design Week is a celebration of Portland as a city of design. The event explores everything about design, from process to practice.

<http://www.designweekportland.com/>

Domaine de Boisbuchet

22 June - 13 September 2014
Boisbuchet, France

This event sees architects and designers coming together to host interactive workshops for professionals and students with a keen interest in the creative process of design.

<http://www.boisbuchet.org/workshops/>

Barcelona Design Week

2 - 14 June 2014
Barcelona, Spain

Barcelona Design Week is an international event featuring exhibitions and networking sessions. The event is organised by BCD Barcelona Design Centre and focuses on design and creativity.

<http://www.barcelonadesignweek.com/en/page.asp?id=542>

Save the date, September 2014:

Bird & Bird's London office will be holding a 3D Printing Forum, taking a look at how 3D printing is influencing a range of different industries.

If you are interested in receiving an invitation, please contact Lindsay Gibbons:
lindsay.gibbons@twobirds.com

São Paulo Design Weekend

14-17 August 2014
São Paulo, Brazil

The largest international design event in Latin America, Design Weekend is a celebration of Latin American design.

<http://www.designweekend.com.br/>

London Design Festival

13 - 21 September 2014
London, UK

During the annual London Design Festival, there are hundreds of events where leading brands and new designers gather to showcase their new products. The festival is a celebration of London as the design capital of the world.

<http://www.londondesignfestival.com/>

DMY Berlin

28 May - 1 June 2014
Berlin, Germany

The annual DMY International Design Festival Berlin brings together both celebrated and up-and-coming designers for workshops and symposia. Throughout the festival, delegates explore the current topics and look to the future trends in design.

<http://dmy-berlin.com/>

Furniture China

10 - 14 September 2014
Shanghai, China

The 20th China International Furniture Expo featuring contemporary and classic furniture designs.

<http://www.furniture-china.cn/en-us/>

Downtown Design Dubai

28 - 31 October 2014
Dubai, UAE

An international design trade fair organised by the team behind Art Dubai and Design Days Dubai—two of the region's most successful annual fairs. Downtown Design showcases the top new technologies, furniture, textiles, lighting and accessories.

<http://www.downtowndesign.com/>

Il Salone Internazionale del Mobile

8 - 13 April 2014
Milan, Italy

Since 1961, the Salone del Mobile has been an exclusive platform for the Home Furnishing Sector. The event promotes Italian furniture and furnishings, setting the global benchmark for the world of furniture design and production.

<http://www.cosmit.it/en/>

World Architecture Festival

1 - 3 October 2014
Singapore

The largest architectural awards programme in the world, this event sets the standard for architectural excellence. Talented architects from around the world gather to celebrate construction design.

<https://www.worldarchitecturefestival.com/>

Melbourne Indesign

22 - 23 August 2014
Melbourne, Australia

Since 2004, Melbourne Indesign has been held biannually, highlighting the most ground-breaking ideas and new products.

<http://www.melbourneindesign.com.au/>

Contacts

For further information please contact:



Ewan Grist

ewan.grist@twobirds.com

T: +44 (0)20 7415 6000



Manon Rieger-Jansen

manon.rieger.jansen@twobirds.com

T: +31 (0)70 353 8800

Follow us

 [@twobirdsIP](https://twitter.com/twobirdsIP)

 www.linkedin.com/company/318488?trk=tyah

twobirds.com

Abu Dhabi & Beijing & Bratislava & Brussels & Budapest & Copenhagen & Dubai & Düsseldorf & Frankfurt & The Hague & Hamburg & Helsinki & Hong Kong & London & Lyon & Madrid & Milan & Munich & Paris & Prague & Rome & Shanghai & Singapore & Skanderborg & Stockholm & Warsaw

Bird & Bird is an international legal practice comprising Bird & Bird LLP and its affiliated and associated businesses.

Bird & Bird LLP is a limited liability partnership, registered in England and Wales with registered number OC340318 and is authorised and regulated by the Solicitors Regulation Authority. Its registered office and principal place of business is at 15 Fetter Lane, London EC4A 1JP. A list of members of Bird & Bird LLP and of any non-members who are designated as partners, and of their respective professional qualifications, is open to inspection at that address.