

Bird & Bird & Design Writes

March 2015

A word cloud featuring various terms related to design, business, and user experience. The words are arranged in a dense, overlapping pattern. The most prominent words, shown in larger fonts, include 'design', 'concept', 'enforcement', 'market', 'product', 'growth', 'web', 'user experience', 'interior', 'brand', 'service', 'package', and 'manufacture'. Other visible words include 'opportunity', 'interaction', 'lifecycle', 'concept', 'market', 'web', 'product', 'growth', 'user experience', 'interior', 'brand', 'service', 'package', and 'manufacture'. The words are rendered in different shades of blue, grey, and white against a dark background.

Welcome to the fifth 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.

Get in touch

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



In this edition...

The role of dotted lines in registered Community designs	01	Focus on the automotive industry: the protection of spare parts using Community designs.....	14
Calculating the infringer's profits in the UK	07	The importance of proving copying of unregistered rights in fabric designs in the UK	18
The 'cookies' decision - only visible elements determine the scope of protection of registered designs	08	Women Fashion Power at the Design Museum	21
Considering the validity of Community design for a component part of a complex product.....	10	Industry news	23
Spanish Supreme Court confirms the lack of standing of distributors to claim compensation for design infringement.....	12	Upcoming industry events and awards	24

The role of dotted lines in registered Community designs

According to the OHIM Guidelines¹, there are a number of permissible ways to exclude certain features from the scope of protection afforded to a registered design. A designer may wish to do this because certain features, whilst not sufficiently intrinsic to the design for which protection is sought to warrant inclusion, may still be useful to illustrate the context of the design or environment in which it is used. The OHIM Guidelines permit the use of boundaries, colouring/shading and dotted/broken lines for this purpose. Of these, the use of dotted lines seems to be the most widely utilised.

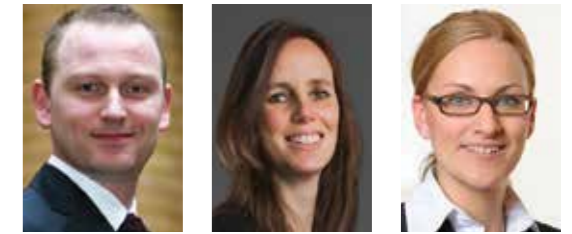
However, the interpretation given to features demarcated in dotted lines by various courts has proven to be less straightforward than might have been expected. In particular, there has been an unhelpful divergence between OHIM's approach and the approach taken by certain national courts when construing registered designs containing such features for the purposes of determining infringement. In this article, we explore this divergence and offer some practical guidance on how dotted lines can best be used to enhance the protection offered by registered designs.

OHIM's approach to dotted lines

According to the OHIM Guidelines² dotted lines 'may be used in a view either to indicate the elements for which no protection is sought (for example, ornamentation applied to the surface of a given product whose shape is disclaimed) or to indicate portions of the design that are not visible in that particular view, that is, non-visible lines.' In this regard, OHIM provide the following illustration of the principle³:



RCD 30606-0005
Source: OHIM Guidelines.



By Ewan Grist, Manon Rieger-Jansen and Jana Bogatz

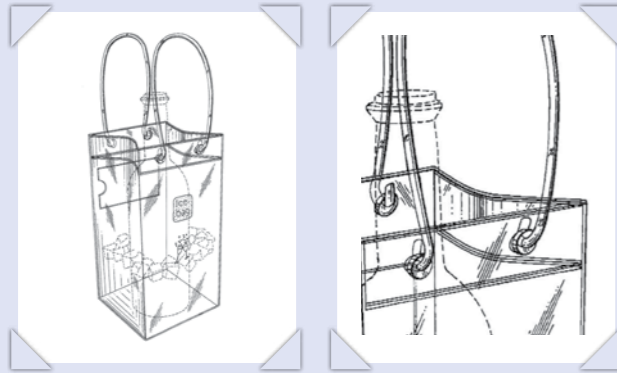
London, The Hague and Munich
ewan.grist@twobirds.com
manon.rieger.jansen@twobirds.com
jana.bogatz@twobirds.com

¹ Guidelines for Examination in the Office for Harmonization in the Internal Market (Trade Marks and Designs) on Registered Community Designs: Examination of Applications for Registered Community Designs

² Paragraph 5.3.1

³ RCD 30606-0005

The inclusion of features in dotted lines tends to be for illustrative purposes. Dotted lines may for instance indicate the context of the design by showing its intended purpose or its scale. In this regard dotted lines can be limiting even if the features depicted in dotted lines do not form part of the protected design themselves. See for instance, the bottle below depicted in dotted lines in the design for a portable wine chiller bag which indicates both intended purpose, scale and size (RCD 616057-0001):

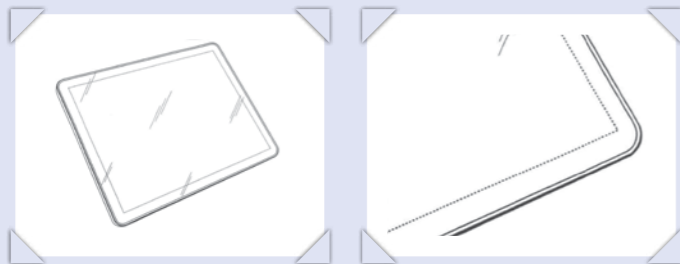


RCD 616057-0001

Source: Gimex International Groupe Import Export v The Chillbag Company Limited & Others, [2012] EWPC 34.

The English Court's approach

The water has however been muddied in the *Apple v Samsung* case⁴. Apple's Registered Community Design (181607-0001) for a handheld computer featured an inner border demarcated by a dotted line:



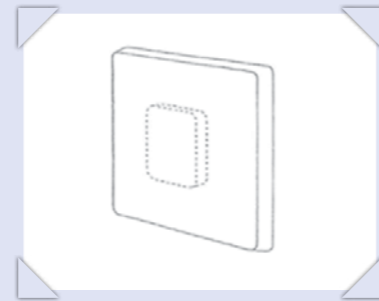
RCD 181607-0001

Source: Samsung Electronics (UK) Ltd v Apple Inc, [2012] EWHC 1882 (Pat), [2012] EWCA Civ 1339.

⁴ Samsung Electronics (UK) Ltd v Apple Inc, [2012] EWHC 1882 (Pat), [2012] EWCA Civ 1339

One issue facing the High Court was how this dotted line should be interpreted when determining the scope of protection afforded to the design as a whole. Samsung argued that the dotted line indicated an element for which no protection was claimed (as per the OHIM Guidelines). Apple argued that in fact the dotted lines instead indicated the presence of a visible border under the screen, which therefore formed part of the protected design.

The court found that the OHIM Guidelines were just that: there was no mandatory rule that dotted lines must be interpreted in a particular way. The court recognised that in most cases dotted lines will have been used to indicate a disclaimed portion of the design, but that will not always be the case. With regard to Apple's design, the court was willing to accept that the dotted line would be understood as showing a border visible underneath a transparent screen. By contrast, when considering a prior art design shown below, the court was happy to conclude that the protruding unit shown in dotted lines was intended to show that matter of design law, that aspect was not claimed:



Source: Samsung Electronics (UK) Ltd v Apple Inc, [2012] EWHC 1882 (Pat), [2012] EWCA Civ 1339.

The court's finding that the dotted line region in the Apple design in fact showed a border visible underneath a transparent screen is questionable. The scope of a registered design, and what it does or does not protect, should be assessed objectively based on the representations filed alone as perceived by the informed user. The intention of the designer is therefore irrelevant. It is difficult to see how the court, when faced with these representations and aware of the clear OHIM guidelines on the use of dotted lines, could have reached the conclusion that the dotted line in fact represented something other than a disclaimed feature without giving some weight to the purported intentions of the designer who prepared the representations, which arguably it was not entitled to do.

Nonetheless, the Court of Appeal upheld the High Court's finding, noting that Samsung's argument (that the dotted line indicated an element for which no protection was claimed) was akin to a notice-board reading 'Ignore this notice'. The Court of Appeal regarded Samsung's contention as being that the position would be exactly the same if there were no dotted lines as if they were there, and found this to be 'faintly absurd'.

The Court of Appeal's reasoning here is questionable as well. A design in which a feature is shown in dotted lines arguably should not be interpreted in the same way as a design in which this feature was absent altogether. In the former case (i.e. showing the disclaimed feature) it does not matter for the purposes of infringement whether the allegedly infringing design also has this feature or not. In the latter case however (i.e. with the feature simply absent altogether), the design will rightly be construed as *not* having that feature, and hence the presence of the feature on the allegedly infringing design would be a clear point of difference, pointing towards a finding of non-infringement. Hence, including a disclaimed feature, even though not within the protected scope of the design, arguably gives a broader scope of protection than simply not including it at all.

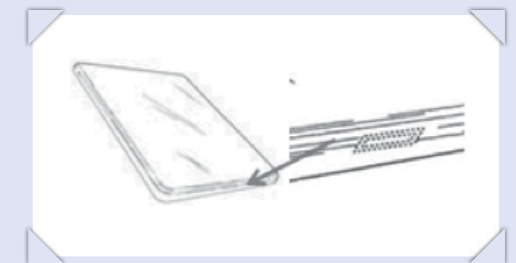
It is hoped that the courts will provide clearer guidance on the relevance of dotted lines in the near future.

The Dutch Court's approach

The issue has been addressed by the Court of Appeal of The Hague in the Dutch *Apple v Samsung* proceedings. The Dutch Court held, similarly to the English Court, that the dotted lines in design registration should be interpreted as part of the design. The court noted from the prior art that it was normal for screens of electronic devices to have a border in the position where dotted line feature in Apple's design was located. The informed user would therefore interpret the dotted line feature as a border visible beneath a transparent surface. Whilst the Supreme Court did not formally deal with this issue when the case was appealed, the Advocate-General in his conclusion agreed with the Court of Appeal, noting that the position set out in the OHIM Guidelines was at most a 'starting point' and not binding.

The German Court's approach

In the German *Apple v Samsung* proceedings, the Higher Regional Court of Düsseldorf held that it was for the informed user to decide what the dotted lines signified in the context of the particular design in question. In relation to the inner border demarcated by a dotted line in the Apple registration, it would be taken to mean that this feature was partially visible or visible only under certain circumstances. Further, the court indicated that the connector port feature, also shown in dotted lines below, meant that the exact positioning was not yet determined and was not to be taken into account in the design.



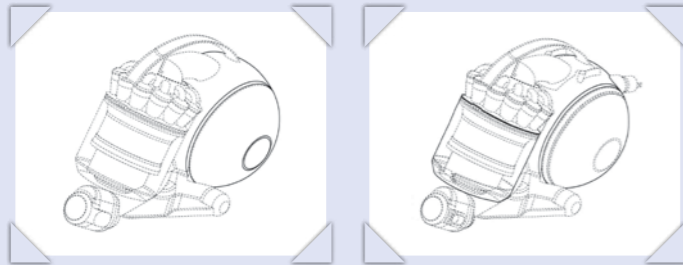
RCD 181607-0001

Source: Samsung Electronics (UK) Ltd v Apple Inc, [2012] EWHC 1882 (Pat), [2012] EWCA Civ 1339.

Using dotted lines in filing strategies

Increasingly, there is a trend for designers to file a series of registered designs (usually by way of multiple applications) for a single central design, each with a different feature or combination of non-essential features 'dotted out'. The aim is to create a thicket of registrations capable of catching third party designs which copy the underlying central design concept but are perhaps missing one or more less important features.

For instance, Dyson has filed a series of registrations (nine in total) all protecting its cylinder vacuum product, each differing in which features are depicted using dotted lines. Two of this series are shown below.



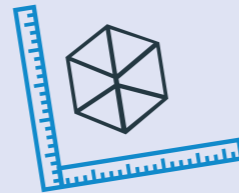
RCD 1237127-0002

Source: OHIM database.

RCD 1237127-0004

Source: OHIM database.

Whilst filing a series of registrations with various non-essential features disclaimed is certainly a sensible strategy to give the widest scope of protection, it can also be taken too far. It is all too easy to find registrations in which the vast majority of the design has been disclaimed, with only a commonplace, non-essential or unimportant feature left in. Such extreme cropping is likely to result in designs which are either invalid or given such a narrow scope of protection as to be unenforceable against anything other than an exact copy.





Calculating the infringer's profits in the UK

Where the claimant succeeds in showing that his design has been infringed by the defendant, the claimant is entitled to recover either damages for the loss suffered or an account of the defendant's profits arising from the infringing acts.



By Sara Nielsen

London

sara.nielsen@twobirds.com

In a case relating to the infringement of registered and unregistered design rights in a contact lens cleaning container *Ifejika v Ifejika*⁵, the UK Intellectual Property Enterprise Court (IPEC) laid down guidelines to be applied where an account of profits is elected by the claimant in a design infringement case.

Unlike damages, there is no requirement for the claimant to prove the extent of his loss, only that the defendant used the infringing IP rights in a way that results in significant profits.

A claimant is not entitled to recover all of the profits that result from an enterprise including both infringing acts and lawful acts; the recoverable profits must derive from the infringing act alone. The judge assessed the total net profit from the sales of the defendant's product which incorporated the infringing feature to be £790,000, but noted that the infringing feature was just one of 12 design features comprising the product. The court took a 'broad brush' approach in calculating the proportion of the profit that might be attributable to the infringing design feature. The judge agreed with the claimant that it was not appropriate to assess the proportion of profits solely by reference to the physical proportion of the infringing feature compared to the whole product; it was functional importance that was relevant, i.e. the judge considered the significance of the role played by the infringing feature in the whole product and concluded that 2% of the net profits was 'about right', giving the sum of £15,800.

Under section 237 of the Copyright, Designs and Patents Act 1988, any person is entitled to a licence (settled by the Comptroller) in the last five years of the UK unregistered design right term, to do anything that would otherwise infringe that design right. The court found that the fact licences of right were available during the period the infringing product was being sold was irrelevant - even if the defendant had taken such a licence, there would be no realistic prospect of it being settled at less than 1% of the net profits.

Comment

This is a rare example of a case in which the successful claimant sought an account of profits, rather than an inquiry as to damages. It demonstrates the court's willingness to grapple with the nebulous question of what proportion of profits are attributable to a particular design feature, despite there being no scientifically rigorous means for analysing this. Given the relatively small sums involved, the court was sensibly prepared to take a broad brush approach.

⁵ [2014] EWHC 2625 (IPEC)



The 'cookies' decision - only visible elements determine the scope of protection of registered designs



By Jana Bogatz

Munich

jana.bogatz@twobirds.com

Background

In 2009, the claimant registered a Community design (RCD) showing a broken cookie (Picture 1) for 'cookies'.

In February 2010, the intervener initiated invalidity proceedings against the RCD at OHIM. In its application for a declaration of invalidity, the intervener alleged that the RCD was not new and had no individual character and also that its appearance was dictated by its technical function. In support of its application, the intervener referred to various earlier designs, including the cookies shown in Picture 2.

OHIM's Invalidity Division dismissed the application for a declaration that the contested RCD was invalid.

In a decision on 2 August 2012, OHIM's Third Board of Appeal (BoA) declared⁶ the contested RCD invalid due to lack of individual character. The BoA held that the layer of filling inside the cookie could not be taken into consideration for the assessment of the individual character of the contested RCD, as it did not remain visible during normal use of the product.

Further, the BoA considered that the outer appearance of the contested RCD was the same as some of the earlier cited designs and so the BoA found that the RCD did not produce a different overall impression on an informed user (who regularly consumes that type of cookie) than that produced by the earlier designs, given the broad design freedom for this type of product.

⁶ T-494/12, Biscuits Poult v OHIM - Banketbakkerij Merba

The General Court decision

The General Court (GC) has now confirmed the decision of the BoA that the RCD lacks individual character and is therefore invalid. All of its characteristics (namely the irregular, rough surface on the outside of the cookie, golden colour, round shape and the presence of chocolate chips) are characteristics which are common to the conflicting designs (Picture 2).

Further, the layer of chocolate filling inside the cookie does not become visible during normal use but only when the cookie is broken. Consequently, this characteristic does not relate to the appearance of the product at issue and cannot be taken into consideration when assessing the individual character of the RCD.



Picture 1

Source: T-494/12, Biscuits Poult v OHIM - Banketbakkerij Merba



Picture 2

Source: T-494/12, Biscuits Poult v OHIM - Banketbakkerij Merba



Comment

According to Article 3(a) Community Designs Regulation (CDR), 'design' means the appearance of a product, arguably excluding the appearance which is only visible after an irreversible intervention in the product or only with special technical aids. The provisions of the Community Design Regulation do not require external visibility when used as intended. Therefore, a design may for example comprise the inner part of a suitcase. Further, designs may protect different states of a design (e.g. open and closed state of a cabriolet) if the various states are shown in the design application. In the case of cookies, their filling is normally only visible as result of an irreversible intervention and also does not constitute one of various states. Therefore, the filling of cookies usually cannot be considered as part of the appearance of the cookie.

In this case, the claimant's RCD only shows a broken biscuit so that the claimant sought protection for this specific broken biscuit with the specific filling shown. Since the subject of protection of a registered design is defined by its representations (in combination with the description, if available), the GC should arguably have taken into consideration the filling of the cookie as well. Ultimately, the GC would probably have come to the same end result: since some of the earlier designs also show a cookie with a layer of filling, they would probably produce the same overall impression on the informed user as the contested RCD, and thus would probably be a lack of novelty.

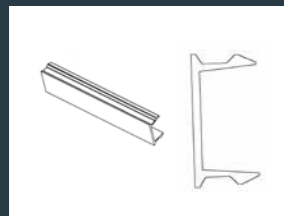
Considering the validity of Community design for a component part of a complex product

In a recent case handed down by the General Court (GC), the GC annulled the BoA's finding that a registered Community design (RCD) for skirting boards was invalid under Articles 4(2)(a) & (b), 6(1)(b) and 25(1)(b) of the Community Designs Regulation (CDR)⁷.

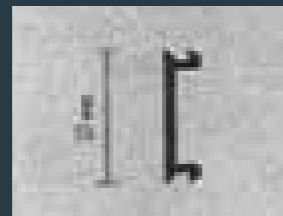
Cezar was the owner of the RCD shown in Picture 1. Poli-Eco applied for a declaration of invalidity, relying on various earlier designs including the design shown in Picture 2.

Component part of complex product

The GC upheld the BoA's finding that the RCD constituted a component part of a complex product, the complex product consisting of (i) a skirting board with a recess designed to accommodate cables and (ii) the contested design itself, which was an insert intended to cover that recess.



Picture 1



Picture 2

Source: T-39/13, Cezar Przedsiębiorstwo Produkcyjne Dariusz Bogdan Niewiński v OHIM; Poli-Eco Tworzywa Sztuczne sp. zo.o.



By Ning Ning Li and Ewan Grist

London
ning-ning.li@twobirds.com
ewan.grist@twobirds.com

Visible features of the RCD

The GC held that the only use of the RCD that could be taken into account was its use as an insert to cover a recess in a skirting board or wall. During such normal use, the BoA found that only the flat front surface of the RCD remained visible.

Earlier design

According to the GC, the BoA had erred in its finding that, during normal use, the only visible feature of the earlier design was the flat front surface. In the catalogue in which the earlier design was shown, it was to be attached to the back part of a skirting board.

As a result, the earlier design was not visible during normal use of the complex product of which it was a part. The BoA had therefore made an error of assessment when comparing the designs in question; since a design constituting a component part of a complex product which is not visible during normal use of that product cannot be protected under Article 4(2)(a) of the Community Designs Regulation, it was held by analogy that the novelty and individual character of an RCD should not be assessed by comparing it with an earlier design which, as a component part of a complex product, was not visible during normal use. As a consequence, Poli-Eco's application for a declaration of invalidity could not succeed based on this earlier design.

Comment

The GC's reasoning raises two difficulties.

Firstly, when assessing novelty and individual character of an RCD, there is no express requirement in the Community Designs Regulation as to the visibility during normal use or otherwise of the earlier design. Arguably it should not matter whether the earlier design was a component part of a complex product or not, or whether it was visible during normal use or not; if the earlier design is identical (or differs in only immaterial details) to the RCD or creates the same overall impression as it, the RCD should be invalid. In its decision, the GC appears to have introduced a requirement that, where the RCD is for a component part of a complex product, it can only be invalidated by an earlier design of a component part of a complex product if that earlier design was itself visible during normal use. The rationale for this new requirement is unclear.

Secondly, in relation to the RCD, the GC held that only the flat front surface remained visible during normal use. Therefore it is this 'flat surface' which would need to itself fulfil the requirements of novelty and individual character in order to be a valid design (Art 4(2)(b)).

By ultimately upholding the validity of the contested design, the GC appears to be saying that the flat surface alone satisfies these requirements. If that is the case, it arguably follows the RCD would now need to be found invalid if challenged with an earlier design simply for a flat surface.



⁷ T-39/13, Cezar Przedsiębiorstwo Produkcyjne Dariusz Bogdan Niewiński v OHIM; Poli-Eco Tworzywa Sztuczne sp. zo.o.

Spanish Supreme Court confirms the lack of standing of distributors to claim compensation for design infringement

In this case, the German company, Hansgrohe AG, and its Spanish subsidiary, Hansgrohe, S.A., brought design infringement proceedings against Grifería Tres, S.A. for the infringement of an international registered design for a tap.

The dispute was assigned to the Commercial Court of Barcelona, which held there was infringement and awarded compensation to Hansgrohe AG as the owner of the registered design. However, the court rejected the standing (i.e. the legal right to bring a claim) of Hansgrohe, S.A. to be co-plaintiff, as there was no license granted by the Germany parent company to its subsidiary.

This judgment was appealed by the defendant to the Court of Appeal of Barcelona, and also by Hansgrohe, S.A. in order to challenge the lack of standing and therefore be able to claim compensation from the infringing acts carried out in Spain.

Contrary to the decision at the first instance, the court upheld the appeal filed by Grifería Tres and revoked the judgment, declaring non-infringement and therefore releasing the Grifería Tres from the obligation to pay damages on the basis that the taps manufactured by it created a different overall impression to the registered design. Additionally, the appeal filed by Hansgrohe, S.A. was dismissed, thus confirming the decision taken by the Commercial Court on this specific point.



By Jose Angel Garcia-Zapata

Madrid

joseangel.garcia-zapata@twobirds.com

The claimants appealed to the Supreme Court, arguing that the subsidiary had sufficient standing- as a result of an implied license due to its relationship as the parent's distributor company in Spain. Interestingly, the claimants stated that the degree of freedom of the designer in the field of the taps is only limited by its technical function and not by the market trends, contrary to what had been found by the Court of Appeal.

The Supreme Court handed down its decision by judgment on 25 June 2014, confirming the lack of standing of the Spanish subsidiary (Hansgrohe S.A.) to sue Grifería Tres, as no license had in fact been granted to it. The court ruled a subsidiary does not obtain a licence merely from its relationship with a parent company (even where the subsidiary is 100% owned by the parent company). Likewise, the subsidiary could not be considered an indirect owner or co-owner of the registered design.

Hansgrohe had argued that Article 13 of the IP Rights Enforcement Directive (2004/48/EC) allows injured parties to claim damages, but the Supreme Court stated that this provision refers exclusively to the right holder (i.e. the design owner) and does not include other injured parties (...to pay the rightholder damages appropriate to the actual prejudice suffered by him/her as a result of the infringement), in line with Articles 53 and 55 of the Spanish Law on Designs (Law 20/2003). Although Article 61.2 of the Spanish Law allows the licensees to take part in infringement proceedings in order to claim compensation, Hansgrohe, S.A. had failed to prove that it was a licensee and therefore its appeal was dismissed.

In connection with the degree of freedom of designers for products like taps, the Supreme Court agreed with the claimant that it was not limited by the market trends but only by technical function. It also noted that a general design trend cannot constitute restraint on design freedom since it is precisely that freedom on the part of the designer which allows him to discover new shapes or trends or even to innovate in the context of an existing trend⁸.

The Supreme Court recognised that the influence of market trends can however contribute to the individual character of designs (therefore determining the scope of protection granted) and determine the necessary degree of differentiation from competitors in order to create a different overall impression.

Thus, if those trends were present when the application for the design was filed (if the design followed the trends), its singular character decreases, so the comparison between the registered design and an allegedly infringing product needs to take into account the elements derived from those trends: if their similarities derive from the trends, they will have a lower importance in the overall impression created on the informed user and a lesser degree of differentiation will be enough to create a different overall impression. On the other hand, if the registered design was innovative at the filing date (i.e. it broke from existing trends to create a new trend), third parties marketing products with a similar design creating the same overall impression should not be entitled to argue that their design freedom was limited by the need to follow that new trend.

Finally, the appeal filed by Hansgrohe AG was also dismissed by the Supreme Court in connection to the comparison between the design and the contested product, stating that there were significant differences between them, irrespective of the degree of freedom of the designer.



⁸ As per General Court's comments in T-153/08 and joined cases T-83/11 and T-84/11.

Focus on the automotive industry: the protection of spare parts using Community designs

In the automotive industry, design rights are an important tool to protect the overall look of a car. In addition to the design of a car as a whole, spare parts (such as alloy wheels, bumpers or the grill of a car) can in certain circumstances also enjoy protection as Community designs, as long as the designs are visible to the user in ordinary use and fulfil the prerequisites of ‘novelty’ and ‘individual character’.

However, since the 1990s there has been a significant debate across the European Union on whether certain spare parts should be excluded from design right protection. The discussions largely focus on the battle in the automotive industry between the car manufacturers and the independent spare part manufacturers: car manufacturers want a high level of protection for their spare part designs in view of the lucrative after-sales market, whereas the independent spare part manufacturers wish to see liberalisation of the spare parts market.

As a result of this battle, the general principle that spare parts are eligible for design right protection is restricted to some extent by the statutory exceptions for ‘must fit’ and ‘must match’ designs.

No protection for ‘must fit’ spare parts

According to Article 8(2) of the Community Design Right Regulation (CDR), a design cannot enjoy protection if it comprises features of the appearance of a product, which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against (i.e. must fit with) another product so that either product may perform its function.



By Roman Brtka and Richella Soetens

Munich and The Hague
roman.brtka@twobirds.com
richella.soetens@twobirds.com

This exclusion from protection is motivated by the objective of preventing technological innovation being hampered by granting design protection to features dictated solely by a technical functionality (see also Article 8(1) CDR) and to guarantee the interoperability of products of different origin. However, the ‘must fit’ clause only covers designs for which there are technically no alternatives as regards to the shape of the design. If there are alternative forms for the design, then this design can generally be protected as a Community design. In plain terms: no alternative in design, no protection. With regard to the automotive industry, commonly the form of exhaust pipes or coupling sleeves are cited as examples for ‘must fit’ designs.

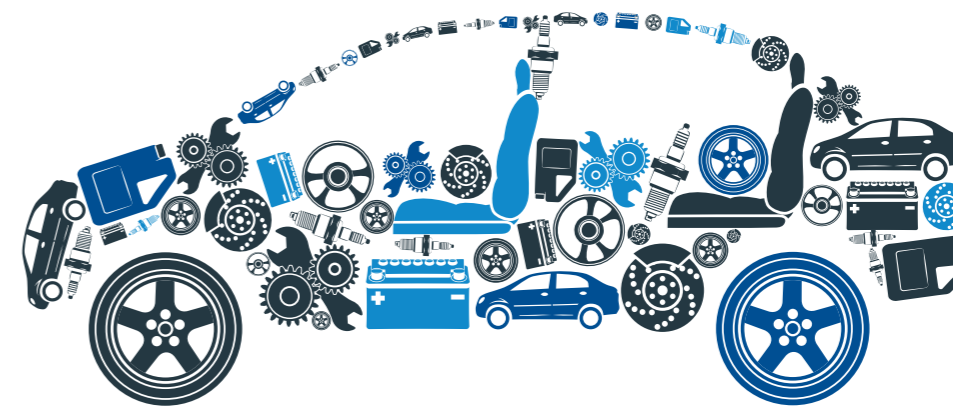
The scope of this exception turns out to be rather limited as component parts that are not visible whilst normal use or parts which are solely dictated by technical function are in any event already excluded from Community design protection (Articles 4(2) and 8(1) CDR).

‘Must match’ parts and the repair clause

A more controversial issue (which nearly prevented the harmonisation of the national design laws between EU Member States) is the protection of ‘must match’ spare parts. These are spare parts, whose shape and configuration is dependent on the shape and configuration of a complex product (which consists of various parts and is demountable, e.g. a car), yet, there does exist an alternative in design. However, this does not rely on the functionality of spare parts, but more on their appearance.

Full-scale approximation as regards the use of protected designs for the purpose of permitting the repair of a complex product so as to restore its original appearance could not be achieved between the Member States of the European Union. Understandably, car manufacturers are concerned about a possible limitation in their ability to recover their production and development costs, whereas the manufacturers of spare parts want their share of the profitable production of ‘crash parts’ as well.

Under these circumstances, the European Union decided that until a common understanding between the Member States could be reached for a transitional period and until the Council has decided its policy on this issue on the basis of a Commission proposal, it would not be appropriate to confer any Community design protection for a design which constitutes a component of a complex product used for the repair of that complex product to restore its original appearance. This was codified in Article 110 CDR, the so called ‘repair clause’. So, whereas the ‘must fit’ clause is directed to specific parts (mostly mechanical parts) necessary to provide a connection with another product, ‘must match’ parts basically relate to spare parts that are used for the purpose of repair in order to restore a product to its original appearance.





Unfortunately, at the moment a certain degree of uncertainty exists as regards the application of the repair clause, due in part to contradictory jurisprudence between the EU Member States. The Design Directive only prescribes that if the Member States wish to change their national laws, such changes may only be introduced if the purpose is to liberalise the market for spare parts. As a consequence some countries have introduced a national repair clause.

Objective necessity

In order to invoke the repair clause it is fundamental for the manufacturer of 'must match' car spare parts to show that there is an objective necessity to imitate the original spare part to enable the restoration of the original appearance of the car.

For example, in a case on counterfeited alloy wheels, the County Court of Stuttgart ruled that a necessity to imitate the original spare part would only be acknowledged, if a spare part, which causes a divergent appearance, would be unsellable. However, as held by the County Court of Stuttgart in the respective case, such an objective necessity was lacking since the design of the alloy wheels and the car's design were independent from each other.

The influence on the exterior design was limited because it was mainly characterised by the car body and the change of alloy wheels did not have any influence on the latter. Even though this decision is to be welcomed from the position of the car manufacturer, the 'impossibility to sell' should not be the decisive factor when determining objective necessity, as it depends partly on the potential customer's subjective assessment. Rather, the focus should be placed on the question of whether a 'must match' spare part must be identical with the original part in order to enable restoration, although there is no technical need to imitate the original product. This interpretation would correspond with the wording of Article 110 CDR, giving less room for speculation. In the case decided by the County Court of Stuttgart, the result would have been the same.

Both the UK High Court and the Audiencia provincial de Alicante take this approach as well and have rejected a defence based on Article 110 CDR in relation to alloy wheels, considering that the wheels did not need to match the car. Only if the design is dependent on the original appearance of the car would the exception apply.

For the purpose of repair

The second prerequisite of Article 110 CDR is that the manufacturer imitates the original product for the purpose of permitting the repair of a complex product (e.g. a car).

The manufacturer of the spare part has to provide evidence regarding his intention. In this respect, the manufacturer of the spare parts carries the burden of proof. Since this is a subjective element, this task could be very difficult to fulfil. Moreover, there exists a certain risk that a manufacturer of spare parts untruthfully claims to have acted for this purpose.

In the UK alloy wheel case mentioned above, the UK High Court considered that it should be determined what the spare part is normally used for. If the spare part is not normally used for repair when the part is broken, damaged or worn, but is for instance used for upgrading the car, this spare part should not fall under the exception.

In addition, the requirement 'so as to restore to its original appearance' should only relate to the car as provided by the manufacturer or authorised dealer, but not to a different appearance created by a previous owner. Especially with regard to alloy wheels, the German Courts tend to be even stricter when considering whether the repair clause is applicable as their influence on the exterior design is considered to be rather limited because it was mainly characterised by the car body and the change of alloy wheels did not have any influence on the latter.

In order to protect the owner of Community design rights, manufacturers of 'must match' spare parts should only be allowed to deliver respective spare parts to car repair shops, which use the spare part exclusively for repairing purposes. The distribution to private customers or resellers may not be protected by Article 110 CDR. Ultimately the scope of Article 110 RCD may be rather narrow and obliges manufacturers of 'must match' spare parts to take extensive precautionary measures.

The battle continues

As 'must fit' and 'must match' spare parts are - under certain conditions - excluded from design protection, the extent to which spare car parts are protected by design rights has been somewhat limited. However, the scope of these exceptions is narrow. Consequently, very few spare car parts may actually fall under the 'must fit' and 'must match' clauses, and less still once the spare car parts market is liberalised further.

As efforts to harmonise European design law (at least as regards the repair clause) have not as yet succeeded (the Commission's proposal on this issue having recently been withdrawn), the battle between the car manufacturers and spare part suppliers looks set to continue.



The importance of proving copying of unregistered rights in fabric designs in the UK

John Kaldor (JK) is a design house which makes and designs fabrics and supplied a sample of fabric (the 'JK Fabric', shown below) to Lee Ann (LA), a company which makes and designs garments.



JK Fabric

LA showed various fabrics to Marks & Spencer for possible inclusion in its Spring/Summer 2013 Per Una collection. JK subsequently became aware of a dress sold by Marks & Spencer in its Per Una range made from a fabric supplied by LA (the 'LA Fabric'), shown to the right.

JK alleged that the LA Fabric was a copy of the JK Fabric and brought copyright and unregistered Community design right infringement proceedings against LA⁹. In order to prove infringement of copyright or unregistered design, JK had to show that LA had copied the JK Fabric (independent creation would not suffice)¹⁰. As a practical matter, it is often difficult for the claimant to obtain evidence that a design has been

⁹ *John Kaldor Fabricmaker UK Ltd v Lee Ann Fashions Ltd* [2014] EWHC 3779 (IPEC)

¹⁰ Unlike the position for registered designs, where copying does not need to be shown



By Nick Boydell

London

nick.boydell@twobirds.com



LA Fabric

copied - any such evidence is likely to be in the knowledge or possession of the defendant. Therefore, where the court is asked to decide whether copying has taken place, if there is sufficient similarity between the respective designs and there was sufficient opportunity to copy, this will raise a rebuttable presumption that copying did indeed take place, unless the defendant can show that the design was created independently.

JK alleged that LA had copied the JK Fabric in one of three ways: (i) conscious copying, in other words LA knowingly copied the JK Fabric; (ii) subconscious copying, by which LA's designer had seen the JK Fabric and subconsciously copied it when she was designing the LA Fabric; and (iii) indirect copying, by which LA's designer had not actually seen the JK Fabric but had created the fabric based on a telephone conversation which another LA employee who had seen the design. JK alleged that the designs were sufficiently similar to give rise to a presumption of copying. The greater the similarity, the stronger the evidence of independent design needs to be.

However, LA's designer was able to give evidence that the design was created independently following instructions to create a 'tribal print', including showing:

- The starting point for the design which was one of a series of tribal prints previously created by the designer;
- Elements of this design being taken and then manipulated by computer, and converted into a repeating pattern; and
- Various colour variations which were created, one of which was chosen by Marks & Spencer.

Even bearing in mind the alleged similarity between the designs, and the opportunity to copy, the judge was persuaded by the evidence that the LA Fabric design had been created independently, and therefore found that there had been no copying. Accordingly, both the copyright and unregistered Community design right claims had to fail.

This case demonstrates the approach English Court will take when deciding whether copying has taken place. It also demonstrates the importance to the designer (whether the claimant or the defendant in infringement proceedings) of keeping complete, contemporaneous records of the design creation process.





Margaret Thatcher suit courtesy of Christie's

Women Fashion Power at the Design Museum

The Design Museum's new Women Fashion Power exhibition looks at the different ways in which influential women have used fashion to define and enhance their position in the world.



That this exhibition has already inspired discussions on both BBC's flagship Newsnight programme and ITV's daytime staple Loose Women is proof that the debate around women and the clothes they wear strikes a chord with a huge cross section of people. Inspired by the rise of women into contemporary society's most powerful roles, across sectors and around the globe, Women Fashion Power is particularly timely as more professional women are now engaging with contemporary fashion and no longer feel the need to follow strict rules and conventions.

Bringing together clothing, accessories, photography, archive footage and interviews, the exhibition celebrates exceptional women from the spheres of politics, culture, business and fashion - forward thinkers who have had an impact on our wardrobes and the world stage. As well as an historical assessment of the past 150 years of women's social and fashion history, the exhibition features outfits loaned from twenty-six contemporary women including: Camila Batmanghelidjh, Founder and Director of Kids Company; Shami Chakrabarti, Director of Liberty; Diane von Fürstenberg, Founder and Co-chair of Diane von Fürstenberg; HSH Princess Charlène of Monaco and Dame Zaha Hadid, Founder and Director of Zaha Hadid Architects - Hadid is also the exhibition's designer. All of the women invited to contribute to the exhibition were chosen

because they are leaders in their field, who understand that the clothes they wear are a part of the way that they communicate with the world.

As Donna Loveday, Head of Curatorial at the Design Museum comments 'today we see the evolution of a new power dress code - professional women are engaging with contemporary fashion as a way to express individuality, a sense of style and project empowerment. The women in this exhibition demonstrate their individual approaches to fashion - in their own words'.

Alongside contemporary outfits the Design Museum has secured a number of significant historical loans for the exhibition, which include an Edwardian riding habit, Suffragette costumes, an iconic suit famously worn by Margaret Thatcher on the day she was elected leader of the Conservative party in 1975, a 'Le Smoking' suit designed by Yves Saint Laurent in 1966, and a dress designed by Jacques Azagury for Princess Diana which she wore on the occasion of her 36th birthday.



Women Fashion Power is on show at the Design Museum until 26 April 2015.

Industry News



By Lindsay Gibbons
London
lindsay.gibbons@twobirds.com

Windowless planes - the future of aircraft design?

A new generation of 'windowless planes' have been proposed as the next step towards improving fuel efficiency by reducing the weight of a plane, as well as creating a new and exciting way to experience flying. The Centre for Process Innovation (a UK based technology innovation centre) is looking to work alongside the aerospace industry and designers to bring this idea to life.

Windowless does not mean that there won't be anything to see - the outside view would be projected onto flexible screens all around the fuselage, including possibly on the individual entertainment screens on the back of seats so that no matter where you sit, you can have the same experience. Passengers could be shown any external view they wanted from around the aircraft - could this however cause a problem if in turbulence or storms? Have they thought through the design proposal and the actual consumers?

With the fear of flying affecting millions of people (up to 20-25% estimated by some), will this be taken into consideration by airlines who may be contemplating a 'windowless' fleet in the future? Or is it better to (literally) face your fears?

For more details on windowless planes, go to:

<http://www.designweek.co.uk/latest-opportunities/blue-sky-thinking-designers-sought-to-create-windowless-aeroplanes/3039299.article>

And:

<http://www.uk-cpi.com/windowless-fuselage/#.VGOKgjSsXTq>

Inflatable baby incubator design wins the 2014 James Dyson Award

A young designer, James Roberts, from the UK has created a low cost, inflatable incubator for use in the developing world. The innovative design features a 24 hour battery, ceramic heating elements and is fully collapsible for transporting, making it even easier to send to those in need. The MOM incubator costs just £250 rather than the £30,000 cost of existing technology - a figure that many hospitals in the developing world could only dream of affording.

As the winner of the James Dyson Award, Roberts has been awarded £30,000 to further test the project. He aims to get the MOM incubator into mass production, hopefully helping to save many lives in the process.

Find out more about the design features here:

<http://www.designweek.co.uk/news/low-cost-baby-incubator-wins-james-dyson-award/3039348.article>

Upcoming industry events and awards

A world map with a light beige background and a subtle wavy pattern. Four orange circular markers are placed on the map, each connected by a curved orange line to a dark grey callout box. The callout boxes contain text about upcoming industry events and awards. The events are: 3D Printshow New York (USA), PD&I (UK), Red Dot Award: Product Designs (Germany), and Design Days Dubai (UAE).

3D Printshow New York
15-19 April 2015
New York City, USA
Showcasing 3D printed products and equipment.
<http://3dprintshow.com/new-york-2015/>

PD&I
20 - 21 May 2015
London, UK
Product Design and Innovation's fifth conference, bringing together the international design community and promote innovation.
<http://www.pdesigni.com/>

Red Dot Award: Product Designs
29 June 2015
Germany
Manufacturers and designers all over the world are invited to participate in the Red Dot Awards: Product Designs 2015. Submit your entry by February 2015 and join the awards ceremony in June 2015.
<http://red-dot.de/pd/?lang=en>

Design Days Dubai
16-20 March 2015
Dubai, UAE
The Gulf's biggest design event where designers exhibit their latest creations.
<http://www.designdaysdubai.ae/>

Contacts

For further information please contact:



Ewan Grist

ewan.grist@twobirds.com

Tel: +44 (0)20 7415 6000



Manon Rieger-Jansen

manon.rieger.jansen@twobirds.com

Tel: +31 (0)70 353 8800

Follow us

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

 www.linkedin.com/company/318488

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 & Sydney & 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.