



**WIPO | HAGUE**

The International  
Design System

# Viewpoint of a Private Practitioner Regarding a Possible Filing Strategy

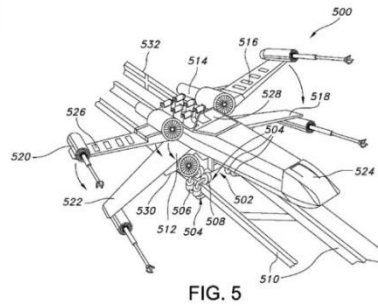
Seminar on the Hague System for the International  
Registration of Industrial Designs

Bernard Volken, Berne/Switzerland  
volken@fmp-law.ch

**Geneva,  
April 9, 2015**

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U.S. Patent  
Sep. 26, 2018  
Sheet 9 of 18  
US 7,987,523 B2



# 1. Introduction

- Patent (in most jurisdictions): examined
- However: no guarantee for validity
- Nevertheless: tendency to consider the patent as barely destructible

## 1. Introduction

- Design (in most jurisdictions) = not examined
- However: no guarantee of invalidity
- tendency: design considered as easily destructible

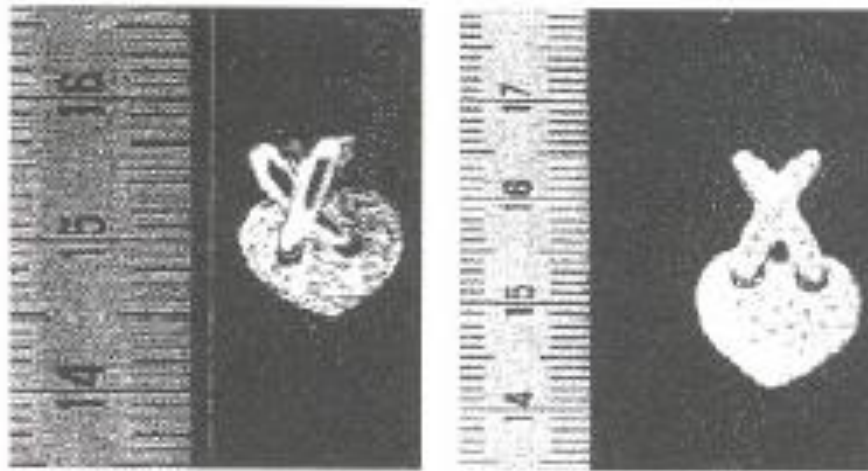


- Design protection is clearly underestimated
  - Why: legal presumption of validity
- turn of the burden of prove





*Swiss Federal Court, July 13, 2004 - “Pendant”*

Plaintiff // Defendant





*Design infringement affirmed!*

- Plaintiff failed in *proving lack of novelty*.
- Lack of novelty is irrelevant if not proved by plaintiff.
- “Missing examination” is partially “compensated” by this legal presumption.

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



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

# *General Court C-345/13*

## *Karen Millen vs. Dunnes, Decision 19 June 2014*

Karen Millen

Dunnes

(Savida label)



Karen Millen

Dunnes

(Savida label)



In 2007 Karen Millen brought proceedings against Dunnes in the Irish High Court claiming they had infringed their unregister Community design rights.

*General Court C-345/13*

*Karen Millen vs. Dunnes, Decision 19 June 2014*

“The right holder of a design is not required to prove that it has individual character”.



*= right holder is released from burden of prove regarding existing novelty!*

Finally, legal presumption is also important advantage in case of conflict

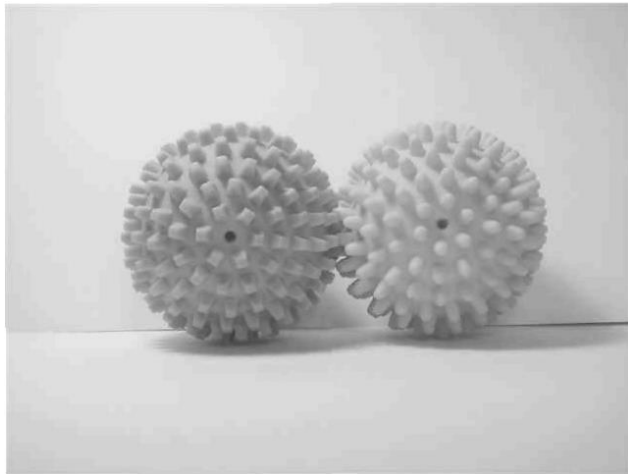
- for sending cease and desist letters,
- and in case of preliminary injunctions

## 2. *No principle of specialty*

Art. 2 I Locarno Classification: “Subject to the requirements prescribed by this Agreement, the international classification shall be solely of an administrative character. Nevertheless, each country may attribute to it the legal scope which it considers appropriate. In particular, the international classification shall not bind the countries of the Special Union as regards the nature and scope of the protection afforded to the design in those countries.”

## *Decision by the UK Court of Appeals (23. April 2008)*

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



Sold and used as a  
massage ball since  
2002:



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

“...this case gives rise to points of law of general importance which have an impact on those not directly engaged in this particular dispute. Where our judgment may clarify that which has been moot and the result is of wider public interest, I take the view that we should make our conclusions known and so I have been in favour in this case of handing down this judgment.”



*The Court stated:*

“the right gives a monopoly over any kind of goods according to the design. It makes complete sense that the prior art available for attacking novelty should also extend to all kinds of goods”.



### *3. No use requirements!!*

*Trademark registered for 45 classes: often confronted with “defensive trademark jurisdiction”*

*Problem solved with design:*

- no principle of specialty
- no use obligation!
- No (barely) room for bad faith argumentation!

# *Monopoly – “corrective against abuse”*

## *Design*

- no “principle of specialty”, no “use obligation” = huge scope of protection
- → Corrective: time limitation.

## *Trademark*

- Timely unlimited
- → corrective: “principle of specialty” and “use obligation”

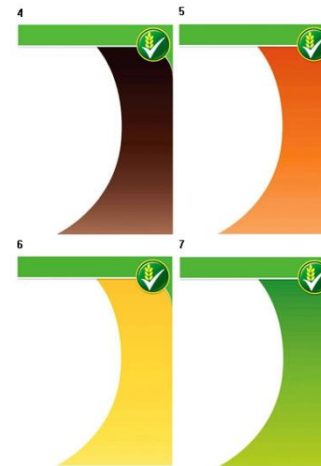
## 4. *Protection of Trade dresses and logos*

“An industrial design may consist of three dimensional features, such as the shape of an article, ...”.

(<http://www.wipo.int/designs/en>)

## 4. Trade dresses – unfair competition and design protection

For several sectors of industry (e.g. cosmetics, nutrition etc.) shape/packaging has strategic importance.



Nestlé DM/077205

## *Protection of Logos: Locarno class 32-00*

- 9<sup>th</sup> Locarno edition (1st January 2009): „*graphic symbols and logos*“.
- Some Trademark Offices were reserved regarding logo-filings, what now is no longer the case. As a matter of fact, the number of logo applications significantly increased since 2009 in most jurisdictions.



DM/078389

BUNDESREPUBLIK  
DEUTSCHLAND

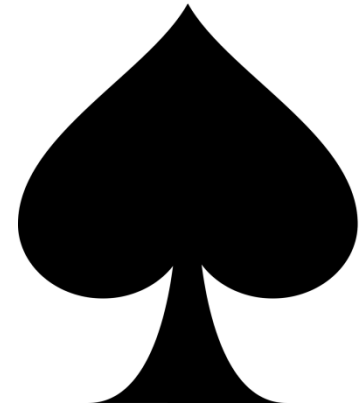


DM/078399



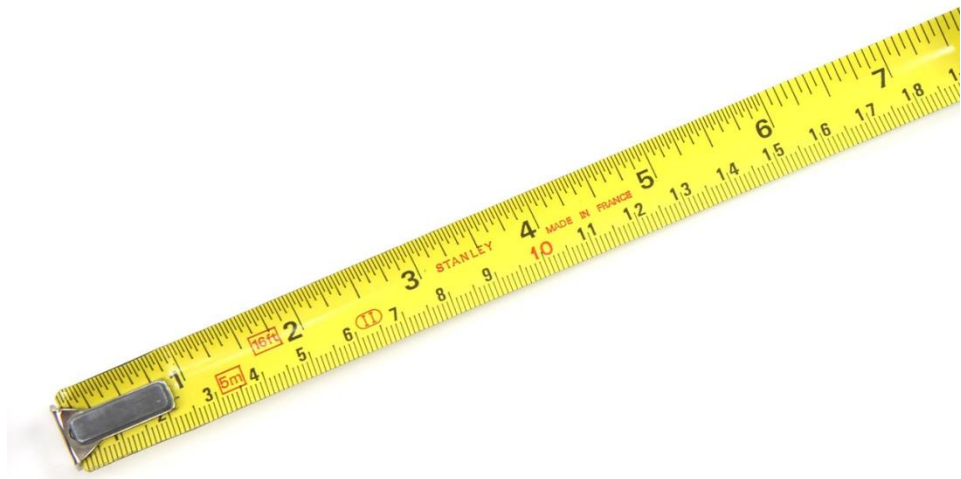
TM IR 1124274

no principle of specialty  
+  
no use requirement  
+  
legal presumption  
+  
tailor made filing strategy  
=  
*strong IP right / trump*

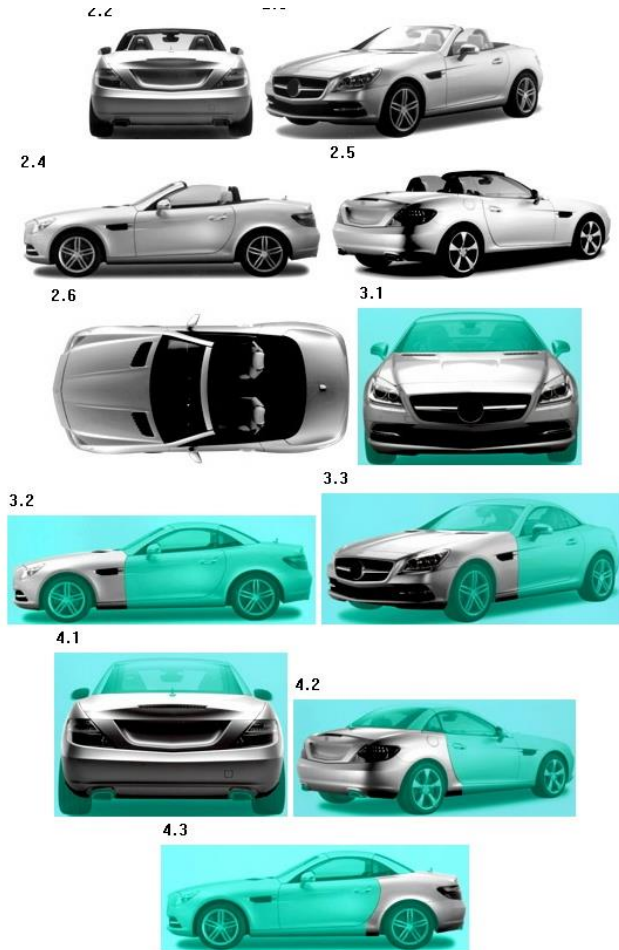




## *5. Parameter for a tailor-made filing strategy*



# Combination “different perspectives” + disclaimer



DM/070912  
Daimler AG

# *disclaimer*



DM/076650 Daimler AG

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

15.2



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

1



DM/075740



# *different perspectives*

1.1



1.2



1.4



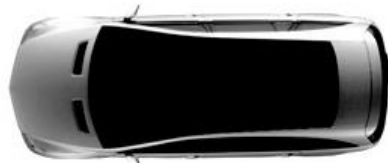
1.3



1.5

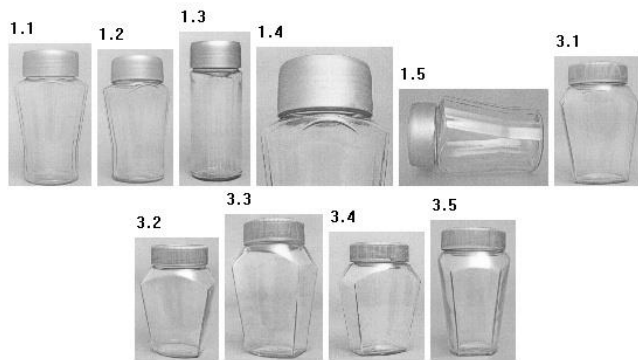


1.6

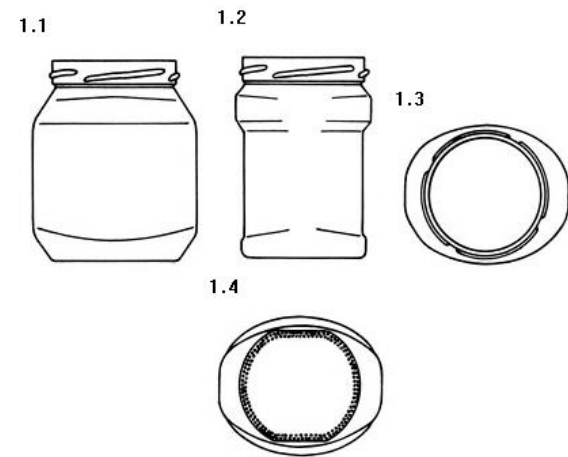


DM/071034  
Daimler AG

# *Photography or graphical reproduction?*



DM/066980 (15); Lidl, DE



DM/066875 (15), Lidl, DE

# *Combination of photography and graphical reproduction!*

1.1



1.2



1.3



1.4



1.5



1.6



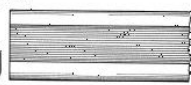
2.1



2.2



2.3

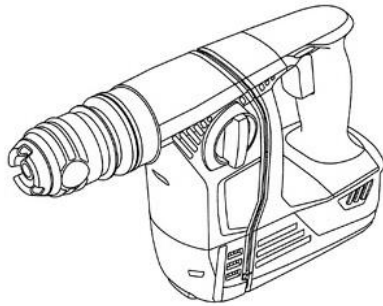


DM/052026 (15);  
EISEN GMBH, DE

# *Color and/or black and white?*



3.1

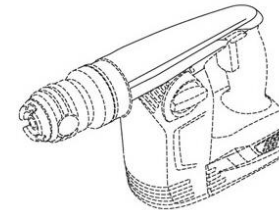


3.2

DM/075961 (15); Hilti, LI



2.1

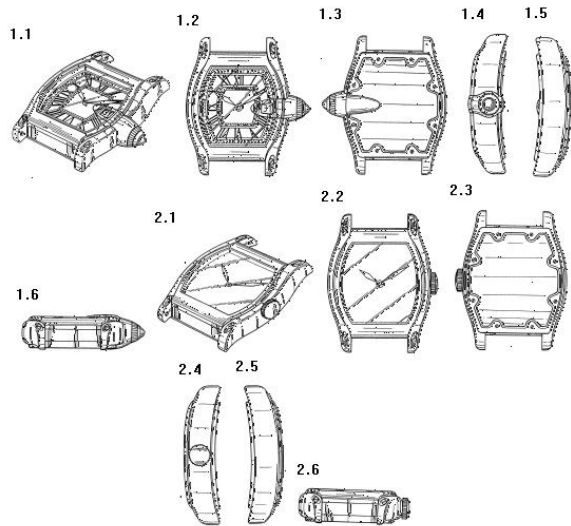


2.2

DM/076048 (15); Hilti, LI



# *Whole product and/or parts thereof?*



DM/047327 (15); Cartier; CH

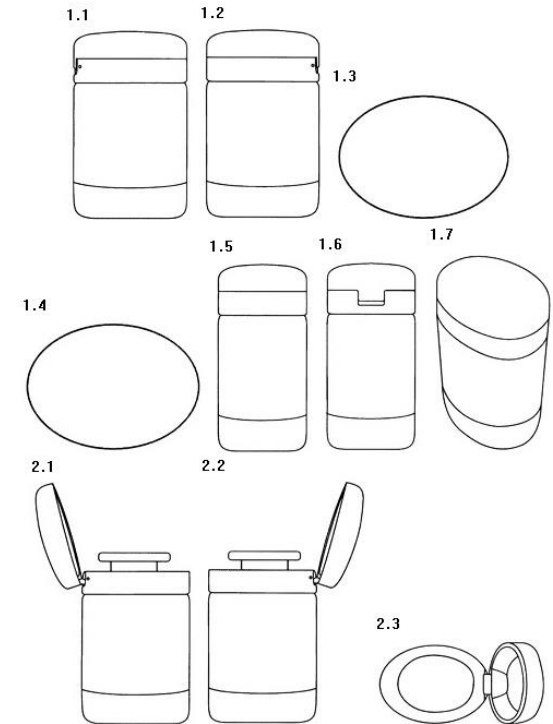
DM/071188 (15); Cartier, CH

# 100 words description?

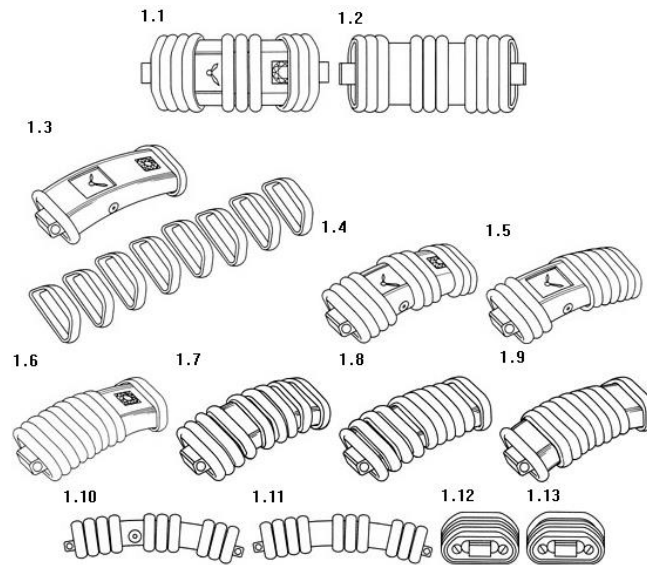
(11) DM/075296 (15) 10.02.2011 (18) 10.02.2016

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

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

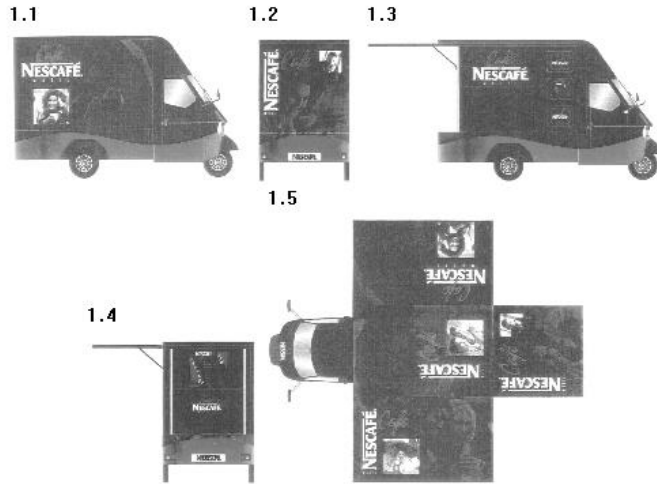


*One picture can say more than 100 words.*



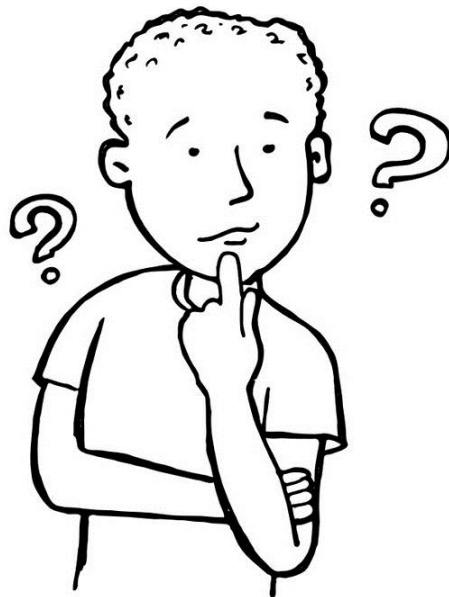
DM/062910 (15); Cartier, CH

*One picture can say more than 100 words.*



DM/047707 (15); Nestlé, CH

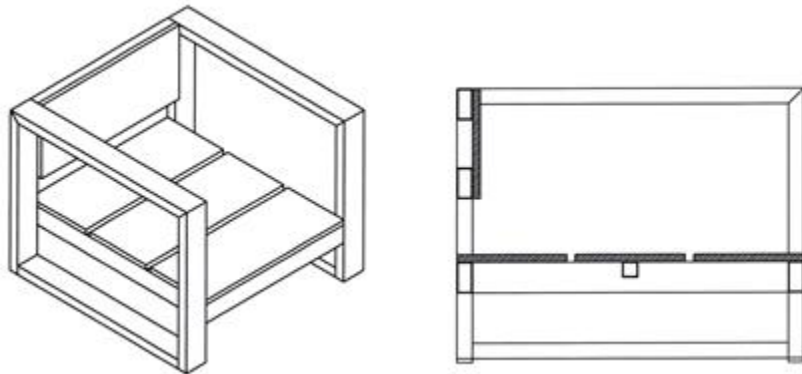
## *6. Does it work in practice - what about jurisdiction?*



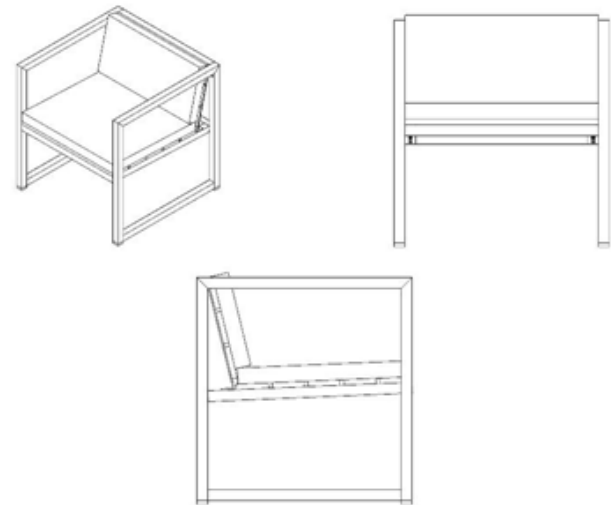
# *General Court T-339/12*

## *Fauteuil cubique, Decision dated 4 February 2014*

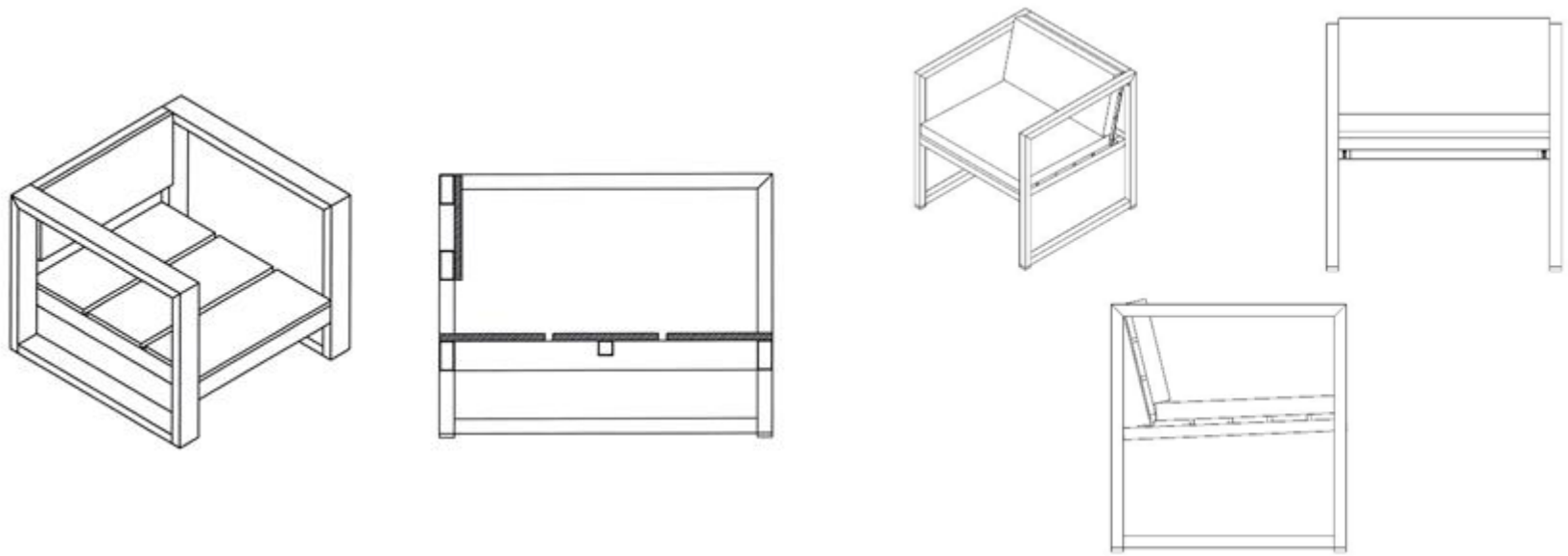
Earlier design



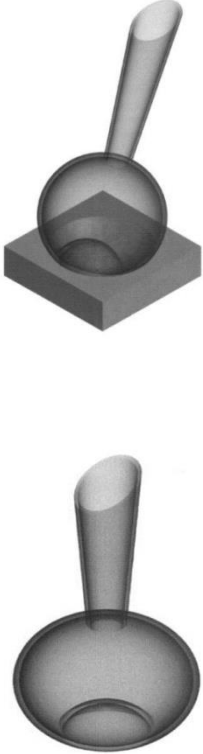

Contested design



→ Differences in: seat height, seat and back inclination.



Overall impression produced on the informed user must be determined based on **how the product is used**: differences in design lead to “**different level of comfort**” ...

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



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

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

plaintiff



Defendant



- The court affirmed the validity of the respective Design-registration from 2001. It also affirmed its copy right character.
- However, the Court argued with different overall impressions, due to differences in nose, face, paw.

# *Conclusion*



Design protection is like a unicycle:

not easy to ride, but if you manage it, it's a lot of power and flexibility!

**Thank you!**

