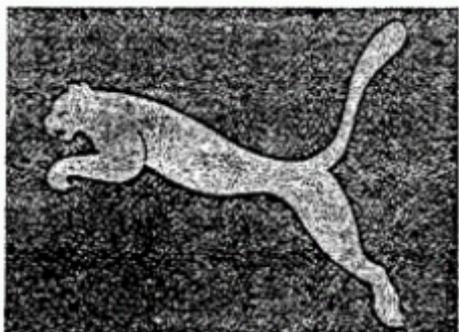


The General Court has confirmed a decision of OHIM's Third Board of Appeal (BoA) finding that a design registration for



filed by Danuta Budziewska (DB) was invalid under Articles 6 and 25 (1)(b) of the Community Design Regulation, no 6/2002 (CDR), on the basis that it lacked individual character finding the overall impression to be considerably the same of that of a number of earlier trade mark registrations, including IR no. 369072 for



registered by Puma SE, the intervener (Puma).

The Cancellation Division had found that the contested design registration was not valid due to an absence of individual character. This was on the basis that Puma's earlier trade marks, including an IR that had been registered since 1970, was a disclosure of the same design, as it did not differ in overall impression. This was confirmed by the BoA.

The BoA found that:

- i. The product to which the design was applied would be a logo
- ii. This should be reviewed from the perspective of the informed logotype user. Logos can have a range of different uses, and anyone could be a user. Whilst not being a design expert, the user would have acquired an experience in that particular sector, and would be aware of how logos are. When applied to sportswear, the assessment should take account of the impression made by the logo on the informed user in that sector.
- iii. The freedom of the designer should be taken into account when making the assessment.

- iv. In light of these factors, the general impression made by the design was not different from that made by Puma's earlier design, which consisted of a feline that was leaping to the left, and was a light coloured image on a dark background. The small details that differed did not influence the overall impression made by the two designs.

DB appealed the decision, on the grounds that, under Art 6(1) CDR, the BoA had been wrong to find that the design did not have individual character. This was refuted by OHIM and Puma.

The General Court considered the basic requirements for a registered Community design to be valid, and that under Art 4(1) CDR, a design must be novel and have an individual character. If it did not fulfil these requirements, it would be found invalid.

The individual character of a design is to be assessed from the global impression that it presents, from the perspective of the informed user, and this impression must be different to that produced on the informed user by all other disclosed designs, prior to its application or priority date. This is taking into account the design freedom of the designer, the product and its industry.

The General Court confirmed that individual character is assessed in 4 stages:

- 1) The sector of products to which the design is destined and its application or use.
- 2) The informed user of the particular products, and its degree of knowledge of the existing design corpus.
- 3) The extent of the designer's creative freedom.
- 4) Whether the global impression produced on the informed user by the design and the earlier art is different, taking into account the industry of application and/or use.

DB attempted to argue that its design registration was not invalid on the following grounds:

- 1) There was no prior art. DB argued that Puma's earlier rights were not designs, and therefore were not relevant. Whilst DB acknowledged the existence of the earlier rights, she maintained that they were trade marks and not designs that had been disclosed to the public.

The General Court disagreed, indicating that under the CDR, there is no requirement that "earlier art" is in the format of a design registration, and that the earlier IR was sufficient proof of disclosure of the design in question. This ground was refused.

- 2) The design had individual character, and that the designs presented a different overall impression.

DB argued that:

- a) The BoA, when assessing the two designs, had made a comparison of marks.

On the basis that DB did not provide any further substantiation of this argument, and that it was not sufficiently clear to defend, the General Court found this plea contrary to Art 21 of the CJEU statute, and Art 44(1)(c) of the General Court regulation; the plea was therefore not admitted.

- b) The design did have individual character. DB argued that there were substantial differences since “the puma was in the impulse phase”, whereas in the contested RCD, “the domestic cat was in the landing phase falling back on its paws”. This landing phase was highlighted by the fact the tail was up to direct the body and prevents it from falling when it lands.

The General Court disagreed, finding that the overall impression of the two designs was not different. The Court held that the overall impression of both was of a silhouette of a feline, leaping to the left, the silhouette being presented as a light colour on a dark colour. Even when considering DB’s arguments that her design was different in that it was a domestic cat instead of a puma, and showed both front and back legs instead of one, it still presented a feline animal in the same leaping position. The differences in the ears, paws and tails were insufficient to make the overall impression between the two different, as they were minor.

The General Court therefore refused DB’s appeal, and held that the BoA and cancellation division had been right to find DB’s design registration invalid.

This clearly demonstrates the alternative ways in which parties attempt to gain IP protection of marks that are similar or identical to those that already exist. In this case, it took nearly two years for the intervener to file an application for invalidation of the registration. This clearly illustrates the necessity for brand owners to also monitor the design registers for conflicting registrations, especially given that there is no initial substantive examination of designs, or notification of holders of earlier, potentially conflicting, rights.

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