

Community Designs – a Silver Bullet or a Rubber Dagger?

What is happening in the Community courts?

Last week, Linklaters' auditorium was filled by an audience eager to hear presentations on Community designs from Dr Henning Hartwig (Bardehle Pagenberg Dost Altenburg Geissler, Munich) and Henry Carr QC (11 South Square).

Dr Hartwig, one of the first lawyers to successfully enforce Community designs before a national court, has published a Europe-wide up-to-date collection of emerging national case law on Community designs, and Mr Carr was counsel for the successful party in *Proctor & Gamble Company v Reckitt Benckiser (UK) Ltd [2007] EWCA Civ 936*, the first UK trial in respect of a Community design. The ECJ is yet to give any guidance in this area.

Dr Hartwig opened the presentation with a review of selected cases from Germany, France and Switzerland to illustrate the principles and requirements adopted by certain Member States for enforcing and protecting a Community Design. While there were sometimes differing national standpoints, a clear tendency is emerging towards a more harmonized and reliable system.

Of particular interest was the analysis of Article 6 of Community Design Regulation 6/2002/EC (“**CDR**”) and the test for “individual character”. Dr Hartwig explained the correct test should be a one-to-one comparison of the registered application (as published in the OHIM bulletin and not as it is sold in the market) with the prior art, in particular the piece of prior art that comes closest to the claimant's design. As for what constitutes relevant prior art, it is anything “made available to the public” which given the accessibility of information through search engines, Dr Hartwig considered to have wide scope.

How to perform the one-to-one comparison is, however less clear: whether the court should consider first the similarities of two designs or the differences. Dr Hartwig preferred the former approach, and if sufficient similarity is found, infringement should only be denied if the differences are great enough.

Henry Carr asked the crowd to review the Proctor & Gamble “Febreze” product (the community design registration) and the Reckitt & Beckiser “Airwick” product (the alleged infringement and said to be one of the last in circulation). A show of hands revealed that the vast majority of the audience considered the Airwick design to infringe. Accordingly Mr Carr took on the task of persuading the audience that this was not the case.

First, Mr Carr set out the case for the respondent. Mr Wyand had argued that where there had been a significant departure from the prior art (the Febreze design had received industry awards for its unique shape) and plenty of design freedom (there were lot of aerosol sprayers in the prior art, very different to the product in issue), the scope of protection for a design should be wide.

My Wyand had also argued that this tied with the language of the Regulation, Recital 14 and Article 10 CDR which require a consideration of a “different overall impression” which being so worded should give rise to a wide scope of protection.

It was this consideration of “overall impression” however, which Mr Carr believed led to a “sea change” towards a decision for non-infringement.

Both parties had agreed that the scope of protection given by Article 10 CDR extended to designs which give the same overall impression. The assessment of overall impression involved, as Dr Hartwig had explained earlier, a detailed feature analysis, quite distinct from the “doctrine of imperfect recollection” in trade mark law. It was here that Mr Carr had played a “Gerald Ratner”

defence, describing how each feature of the Airwick design was “simply inferior” to the equivalent in the Febreze design. This argument had not only been amusing but persuasive. It was also consistent with Lewison J’s analysis of the Febreze design as having a “smooth and dynamic feel, flowing lines, and an elegant sense of movement” which if taken as Lewison J’s overall impression of the Febreze design, was very different to the “few kind words” about the alleged infringement. The expert for the respondent who was the designer of the Febreze design had also been quick to support Mr Carr’s disparaging remarks about the Airwick design (a lesson, Mr Carr added, not to call the designer as an expert unless one has to).

In the question and answer session that followed, Dr Hartwig commented that he did not think highly of the feature analysis applied by the Court of Appeal, remarking that it had been, at best, “unlucky” and with a better analysis of features, a German court would have been convinced of infringement.

However, Mr Carr also felt policy decisions had been significant to the decision. Mr Carr warned the audience that as Community designs are non-examined IP rights, given a wide scope of monopoly they would be “too powerful” as the onus would be on competitors to spend money and time invalidating them. Moreover, as Community designs can extend to functional features as well as aesthetic ones, their monopoly can be greater than that granted for patents: function need not even be inventive and the monopoly can last 25 years including renewals. Granting a wide scope of protection would be anti-competitive and would discourage innovation.

Mr Carr was also asked where such a narrow interpretation left unregistered design rights. Mr Carr considered these rights to still be dangerous given that a claimant can apply for protection of the whole as well as any aspect of a design. Even if a design gives a different overall impression to the design-in-issue, there may still be a strong case on a very limited important part.

A show of hands at the end of the session revealed few audience members had (or dared to admit that they had) been persuaded by Mr Carr’s arguments for non-infringement of the Febreze design. However, Mr Carr proposed that whether or not one finds infringement is essentially one of policy: how wide should the scope of Community design protection be? Whether the Community design should act as a rubber dagger or a silver bullet was the question left with the audience.