

From Ferraris to Barbie doll heads: Dilemmas of designs of part products

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Overview

- Definitions and examples
- Barbie doll heads: Validity of registered designs for part products
- Ferraris: Disclosure of unregistered designs for part products
- Questions

Definitions and examples

Article 3 **Definitions**

For the purposes of this Regulation:

(a) "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/or materials of the product itself and/or its ornamentation;

Definitions and examples

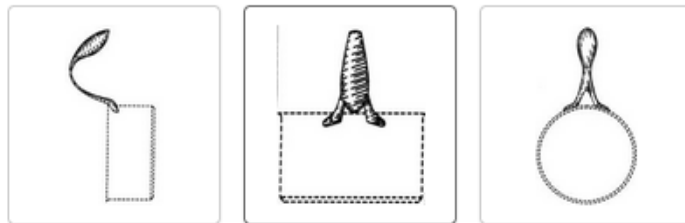
Examples of registered designs:



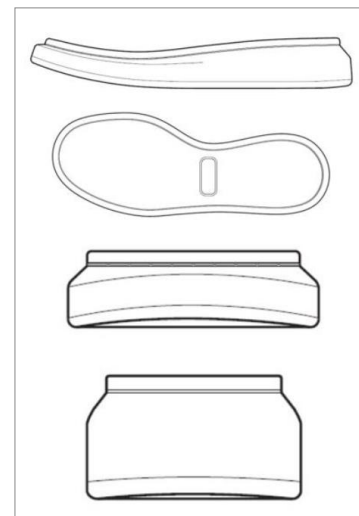
RCD 2459701-0001
Dolls' heads



RCD 4352300-0012
Carrier bags (part of -)



RCD 123013-0001
Saucepan handles



RCD 2711093-0004
Shoe soles

Validity of registered designs for part products

Part vs. entire product – How is individual character assessed?



Contested registered design



Prior art invoked

Validity of registered designs for part products

R 2021/2019-3 of 14/12/2020

Contested design declared invalid

- Informed user is the person using dolls
 - Design freedom in developing doll heads is wide
 - Designs coincide in shape and colour of the face, eyes, eyebrows, lips, the smile and the position of these features
- Contested design lacks individual character



Designs compared

Validity of registered designs for part products

T-84/21 of 01/12/2021

Declaration of invalidity confirmed



- Features and their position create impression of an identical face
 - Informed user will notice that the designs show doll heads of an oval shape, identical features and proportions, very similar make-up and same expression
- Same overall impression

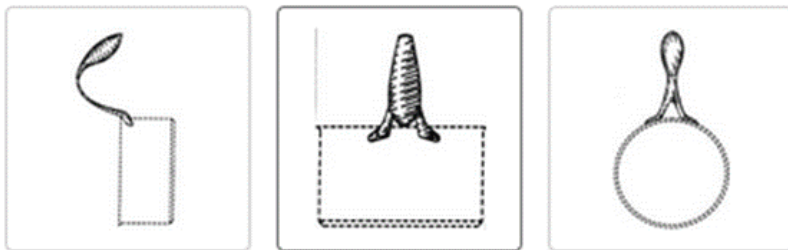
Validity of registered designs for part products

Part vs. entire product – How is novelty assessed?

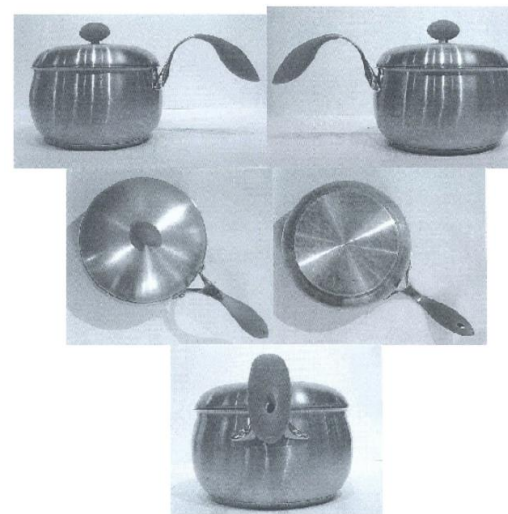
R 196/2008-3 of 02/09/2008

Contested design declared invalid

- Handles differ in immaterial details only
- Contested design lacks novelty



Contested registered design



Prior design

Disclosure of unregistered designs for part products



Prior unregistered designs as disclosed

Alleged infringing use

Disclosure of unregistered designs for part products

C-123/20 of 28/10/2021 Reference for preliminary ruling

The question asked:

25 Ferrari then brought an appeal on a point of law before the Bundesgerichtshof (Federal Court of Justice, Germany). That court, which declared the appeal admissible, considers that the outcome of the appeal depends on the interpretation of Regulation No 6/2002, in particular the circumstances in which the appearance of a part of a product, in the present case that claimed by Ferrari on part of the FXX K model, may, under that regulation, be protected as an unregistered Community design.

Disclosure of unregistered designs for part products

C-123/20 of 28/10/2021, §§ 30 - 49

The answer:

- Art. 3(a) CDR: appearance is the decisive factor
- Making available of a part product requires that the part is **clearly identifiable**
- Art. 11 (2) CDR does **not require designers to make available separately each of the parts of a product** in order to benefit from protection of an unregistered design
- Such requirement would be **contrary to the objective of simplicity and rapidity** and disregard the equilibrium between registered and unregistered designs
- Part product must be **clearly visible** in order to allow for the assessment of its overall impression
- ‘Part of a product’ under Art. 3(a) CDR to be understood as in everyday language as **a section of the ‘whole’** that is the product

Disclosure of unregistered designs for part products

50 It follows that, in order to assess the conditions for protection as a Community design, the part of the product or component part of the complex product at issue must be visible and defined by features which constitute its particular appearance, namely by particular lines, contours, colours, shapes and texture. That presupposes that the appearance of that part of the product or that component part of a complex product is capable, in itself, of producing an overall impression and cannot be completely lost in the product as a whole.

Questions

Should these findings be applied in the assessment of novelty and individual character?

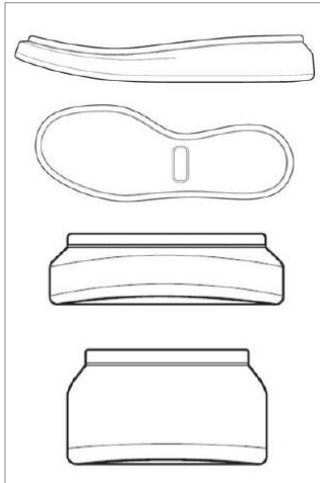
In particular:

- Is “being capable, in itself, of producing an overall impression and not being completely lost in the product as a whole” a relevant criterion to identify a part within the product as a whole?



Questions

- Should the part product be identified by the Board?



Contested design

R 810/2021-3 of 17/04/2022



Prior designs invoked



Prior designs examined

Questions

- Should the part product be identified by the invalidity applicant?

R 530/2023-3 of 26/09/2023



Contested design



Prior designs invoked



Prior designs disclosed

Possible answers

- Principle that designers cannot be required to **“make available separately each of the parts of a product”** should apply **to prior art** invoked in invalidity proceedings. Invalidity applicants should not be obliged to prove separate disclosure of the part.
- Capability of **“producing an overall impression and not being completely lost in the product as a whole”** should be a criterion **to identify a part product** within the whole product as disclosed
- Assessment of validity should be based on the part products **as identified by the invalidity applicant**

Possible answers

Looking forward to your questions!





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THANK YOU