

## Invalidity of Registered Community Designs: Conflict between Designs

### 1. The meaning of "conflict" and when it can arise

1.1 A Registered Community Design ("RCD") is a unitary right which provides protection for designs across the European Union.

1.2 In the context of Community (registered and unregistered) designs, "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<sup>1</sup>.

1.3 One of the cases in which a Community design may be declared invalid<sup>2</sup> is if the Community design is in conflict with a prior design which has been made available to the public after the date of filing of the application or, if a priority is claimed, the date of priority of the Community design, and which is protected from a date prior to the relevant date by a registered Community design or an application for such a design, or by a registered design right of a Member State, or by an application for such a right<sup>3</sup>, provided that this ground is invoked by the applicant for or holder of the earlier right<sup>4</sup>.

1.4 The term "conflict" is not defined as such in Regulation (EC) No. 6/2002 ("the Regulation"). However, in a recent judgment<sup>5</sup>, the General Court has sought to provide some clarification of this concept.

1.5 The case concerned an action brought against the decision of a Board of Appeal of the Office for Harmonization in the

<sup>1</sup> Article 3(a) of Regulation (EC) No. 6/2002

<sup>2</sup> The seven cases in which a Community design may be declared invalid are itemised in Article 25(1) of Regulation (EC) No. 6/2002

<sup>3</sup> Article 25(1)(d) of Regulation (EC) No. 6/2002

<sup>4</sup> Article 25(3) of Regulation (EC) No. 6/2002

<sup>5</sup> [Case T-9/07 Grupo Promer Mon Graphic SA v OHIM \(defendant\) & PepsiCo Inc. \(intervener\)](#)

Internal Market (OHIM) relating to invalidity proceedings between Grupo Promer Mon Graphic SA ("Grupo Promer") and PepsiCo Inc. ("Pepsi").

1.6 Pepsi filed an application for an RCD ("the contested design") on 09 September 2003, which claimed priority from a Spanish application for registration of a design that was filed on 23 July 2003.

1.7 Grupo Promer sought to invalidate the contested design on a number of grounds including the ground that the contested design was in conflict with a prior design belonging to it. The prior design was an RCD having a filing date of 17 July 2003, which claimed priority from a Spanish application for registration of a design that was filed on 08 July 2003.

1.8 As to whether the contested design was in conflict with the prior design, the General Court concluded that Article 25(1)(d) of the Regulation "must be interpreted as meaning that a Community design is in conflict with a prior design when, taking into consideration the freedom of the designer in developing the Community design, that design does not produce on the informed user a different overall impression from that produced by the prior design relied on"<sup>6</sup>. In concluding thus, the General Court approved the interpretation adopted by the Board of Appeal in the contested decision.

1.9 The General Court noted that this interpretation of Article 25(1)(d) of the Regulation "is the only one which can ensure that the rights of the proprietor of a prior design that is referred to in that provision is protected against any infringement of the design resulting from the coexistence of a subsequent Community design that produces the same overall impression on the informed user."<sup>7</sup>

1.10 The Board of Appeal had found that the contested design and the prior design produced different overall impressions on the informed user.

1.11 However, the General Court held that the differences observed by the Board of Appeal were insufficient for the contested

<sup>6</sup> Paragraph 52 *ibid.*

<sup>7</sup> Paragraph 53 *ibid.*

