



JONES DAY COMMENTARY

EUROPEAN COURT OF JUSTICE DEFINES THE “INFORMED USER” RELEVANT IN COMMUNITY DESIGN REGISTRATION MATTERS

On October 20, 2011, the Court of Justice of the European Union (“ECJ”) rendered its first substantive decision on a design patent case. The ECJ handed down its decision on an invalidity action in the *Grupo Promer* case (case C-281/10P).

BACKGROUND

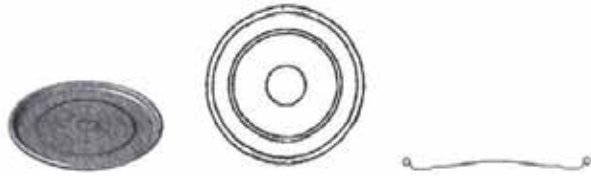
The ECJ, seated in Luxembourg, is the highest judicial authority in the European Union. With regard to intellectual property matters, it is the final resort in construing the Community Design Regulation (and also the Community Trade Mark Regulation); national courts also may refer questions to the court when a case before them relates to harmonized Community law, such as set forth in Directives in the fields of design registrations (and, again, trademarks).

Council Regulation (EC) No. 6/2002 of December 12, 2001 on Community designs (OJ 2002 L 3, p. 1), the Community Design Regulation (“CDR”), provides for a pan-EU design protection for both registered and unregistered designs. Registered designs are administered by the Alicante-based Office for Harmonization in the Internal Market (Trade Marks and Designs) (“OHIM”).

Decisions made by OHIM can be appealed before the Boards of Appeal of OHIM. When faced with an adverse decision on appeal, an action against OHIM can be brought before the General Court of the European Union (“GC”) in Luxembourg, whose judgment finally can be appealed before the ECJ.

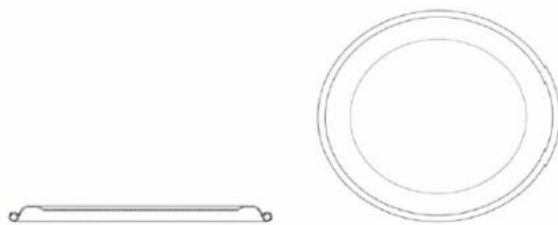
CASE HISTORY

The case relates to a Registered Community Design (“RCD”) for the goods “promotional item[s] for games” represented as follows (“contested RCD”):



An application for a declaration of invalidity was filed against this design, which is for “tazos.” By way of background: Among children in Spain, giveaways in the form of *tazos* (in English, “pogs” or “rappers”) are popular. *Tazos* are circular disks that are often packaged with potato chips or cookies, for example, and the idea behind *tazos* is that each contains a score value, and a game is played to “win” them from other players.

The main basis for the claim was the alleged conflict with a prior RCD of the claimant registered for “metal plate[s] for games” represented as follows (“prior RCD”):



The Invalidity Division of OHIM upheld the application for a declaration of invalidity on the basis of the conflict with the prior RCD. However, on appeal, the Third Board of Appeal of OHIM annulled this decision and rejected the request, mainly on the basis that it negated a relevant conflict of the RCDs in question.

An action against this decision brought before the GC was successful, and in essence the court upheld the plea that a conflict between the RCDs under dispute should be accepted.

THE ECJ DECISION

In its appeal decision of October 20, 2011, the ECJ confirmed the view of the GC and dismissed the appeal with costs. The ECJ confirmed that the contested RCD was in conflict with the prior RCD.

Pursuant to art. 25 (1) (d) CDR, an RCD may be declared invalid if it is in conflict with a prior design. The scope of protection conferred by an RCD includes any design that does not create in the informed user a different overall impression (art. 10 (1) CDR).

The case gave rise to two specific issues: Who is the “informed user” whose perception is relevant, and what is his level of attention?

THE CONCEPT OF THE “INFORMED USER”

The Board of Appeal of OHIM in this case identified two categories of “informed users”: a child in the age range of between five and 10 years (the *tazo* aficionado), and a marketing manager in a company. The General Court pointed out that “informed users” are those that at least know of the phenomenon of *tazos*.

The ECJ confirmed the view of the GC. The “informed user,” according to the ECJ, has knowledge that lies somewhere in an intermediate range. On the one hand, it is exceeding the knowledge and perception of the well-informed and reasonably observant and circumspect average consumer relevant for trademark law questions. On the other hand, it is less than the knowledge of a sectoral expert, which is someone with detailed technical expertise. Therefore, the “informed user” will not observe in detail minimal differences that may exist between designs in conflict:

Thus, the concept of the informed user may be understood as referring, not to a user of average attention, but to a particularly observant one, either because of his personal experience or his extensive knowledge of the sector in question. (paragraph 53)

DIRECT OR INDIRECT METHOD OF COMPARISON?

In trademark law conflict matters, it is considered that the relevant average consumer will not necessarily view the mutual trademarks side by side but has to rely on his partially imperfect recollection of them.

It was argued in appeal proceedings that the “informed user” relevant for RCD matters will have a chance to consider the designs under dispute side by side and therefore has the chance to make a direct comparison between them. Therefore, it was argued, the “informed user” would have easily found two significant differences between the mutual designs: the two additional concentric circles clearly visible on the surface of the contested design and the curved shape of the contested design, as opposed to the complete flatness (apart from the brim) of the prior design.

The ECJ considered that the CDR made no direct comment on the question of whether the assessment of RCDs in conflict should be limited to a direct comparison. It concluded that the very nature of the “informed user” means that, when possible, he will make a direct comparison between the RCDs in conflict. This thumb rule, according to the Court, at the same time means that there may be circumstances where there is no direct comparison possible or likely:

However, it cannot be ruled out that such a comparison may be impracticable or uncommon in the sector concerned, in particular because of specific circumstances or the characteristics of the devices which the designs at issue represent. (paragraph 55)

As regards the specific level of attention, the ECJ pointed out:

Thus, the qualifier “informed” suggests that, without being a designer or a technical expert, the user knows the various designs which exist in the sector concerned,

possesses a certain degree of knowledge with regard to the features which those designs normally include, and, as a result of his interest in the products concerned, shows a relatively high degree of attention when he uses them. (paragraph 59)

THE BOTTOM LINE

Design law in the EU now has an independent notion of the relevant “informed user.” The knowledge of this fictitious person lies somewhere between the knowledge of the average consumer (relevant for trademark law) and the knowledge of the person skilled in the art (relevant for patent law). This underpins the strength of design patents because minimal differences between designs in conflict will not suffice to exclude infringement claims. It also means that design cases will not be overburdened with expert evidence because the “average designer” will not be the one whose perception is relevant at the end of the day.

Further, it will always be a case-by-case finding whether the designs in conflict will be assessed by the “informed user” side by side or whether the special circumstances will not allow this to be the practical or useful approach of the “informed user.”

LAWYER CONTACT

For further information, please contact your principal Firm representative or the lawyer listed below. General email messages may be sent using our “Contact Us” form, which can be found at www.jonesday.com.

Andreas Ebert-Weidenfeller

Frankfurt

+49.69.9726.3983

aebert@jonesday.com