The influence of the design directive and the regulation on Community designs on the Benelux design law

I. Introduction

1. I’m very honored to have the opportunity to write a contribution in honor of Frank Gotzen. Frank Gotzen has left an indelible mark on my scientific career. When I decided in 1987 to write my Ph.D. on copyright contracts, Frank was almost the only copyright specialist who paid attention to copyright contracts in Belgium, and who had published about this issue. His publications did arise my interest in the problems of copyright contracts. As Frank told me some months ago that he always was very interested in design law, and always wanted to write a book about design law in the Benelux, I was very happy that the editors of this book asked me to write, in honor of Frank Gotzen, a contribution about the influence of the design directive and the regulation on Community designs on the Benelux design law.

2. The first part of my contribution will be the longer one and will deal with some effects of the design directive on the Benelux design law. In the second part I shortly want to discuss the influence of the design regulation on the Benelux design. It has to be made clear from the beginning that both directive and regulation had and have a significant impact on the Benelux design law.

II. The influence of the design directive on the Benelux design law

A. Introduction

3. The design directive was implemented in the Benelux by a Protocol of 20 June 2002. Analyzing the Common commentary of the three governments of the Benelux countries on the Protocol, it becomes clear, as will be proved further on in this contribution, that at the

---

3 Council Regulation (EC) Nº 6/2002 of 12 December 2001 on Community designs, O.J., 2002, L 3, 1, as amended. This regulation will be indicated further on in this contribution as ‘the (design) regulation’.
4 B.S., 14 March 2003, 12833. This Protocol will be indicated further on in this contribution as ‘the Protocol (of 20 June 2002)’. Although the directive had to be implemented not later than 28 October 2001 (art. 19, §1 directive), the Protocol of 20 June 2002 came into force on 1 December 2003 (B.S., 6 November 2003, 54056).
5 This common commentary of the three governments of the Benelux countries on the Protocol of 20 June 2002 can be found on the website of the Benelux Office for Intellectual Property (www.boip.int (under ‘Juridical’, ‘Regulations’, ‘Old regulations’)), and will be indicated further on in this contribution as ‘Common commentary’.
At the time of the implementation of the design directive\(^6\), the Benelux legislator considered that the major concepts used in the Uniform Benelux Design Law (BDL) could remain unchanged\(^7\). Today however it is clear, and this will also be proved by this publication, that the European harmonization of design protection changed the Benelux design law more fundamentally than the Benelux legislator had in mind in 2002. Some major concepts changed fundamentally. It is not possible, within the framework of this contribution, to discuss all changes arising as a result of the implementation of the design directive. I have chosen to discuss a limited number of important changes. Some of those changes were not really provided by the Benelux legislator.

4. Before analyzing some changes as a result of the European harmonization, another general remark concerning the influence of the design directive on the Benelux design law can be made. Even today, many judges in the Benelux are not aware of the important changes arising from the implementation of the design directive and they are not (yet) very acquainted with the European harmonized rules with regard to design law. I have seen this on the basis of my analysis of the Benelux jurisprudence of 2009 and 2010 with regard to design protection\(^8\). To give an example. As further indicated in this contribution, a design needs, to be protected under the European harmonized design rules, individual character. A design shall be considered to have individual character if the overall impression its produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing of the application for registration or, if priority is claimed, the date of priority\(^9\). Consequently, the condition of individual character should be assessed from the point of view of ‘an informed user’. This ‘informed user’ also has to be taken into account in assessing if a design infringement occurs. The infringement criterion after the implementation of the design directive is: ‘does the alleged infringing design produces on the informed user the same overall impression’\(^10\). The above-

\(^6\) At the time of the implementation of the design directive, the Uniform Benelux Design Law (BDL) was still into force. This Uniform Benelux Design Law has been replaced by the Benelux Treaty of 25 February 2005 relating to intellectual property (trademarks and designs)(B.S., 26 April 2006, 21867, as amended). This Treaty will be indicated further on in this contribution as the ‘BTIP’, and came into force on 1 September 2006 (art. 6.2, §1 BTIP and the Law of 22 March 2006 relating to the approval of the BTIP (B.S., 24 August 2006, 42140)).

\(^7\) See for instance: Common commentary, pag. 9 (protected object).

\(^8\) H. VANHEES, 2011, 3-49.

\(^9\) Art. 3.3, §2 BTI and art. 5, §1 design directive.

\(^10\) Art. 3.16, §1 BTI and art. 9, §1 design directive.
mentioned analysis of the Benelux jurisprudence with regard to 2009 and 2010 reveals that lots of judges in assessing if a design has an individual character or whether a design infringement occurs spend no attention to the ‘informed user’. They assess the individual character of a design and a design infringement without the delimitation of the ‘informed user’. This shows very clear the inexperience of many Benelux judges with the European harmonized rules with regard to designs.

B. Protection of the appearance of ‘a product’

5. Under the old Uniform Benelux Design Law protection was only given to the new appearance of an utensil. Products with a purely decorative function could not be protected as design. Paintings, etchings, statutes, etc. could only be protected by copyright if the conditions required for copyright protection were fulfilled. Of course, products with a user function but with a purely decorative appearance could receive protection as Benelux design. So a box decorated with a painting could be protected as Benelux design. Due to this condition of ‘user function’ works of art were in principle excluded from design protection. It has however to be mentioned that this condition, referred to by the Explanatory memorandum to the Uniform Benelux Design Law as a key for the application of the BDL, was interpreted narrowly. From the moment a product had any practical use and was not purely decorative, it was deemed to have a user function. For instance wall paper, post cards, stamps and wrapping paper could be protected as Benelux design. D. Verkade justly critized the ‘user function’. One of his remarks was that not the nature of the product determined the function of it, but its use. A brooch for instance can be used as a jewel by one person but as a means to close a shawl by another. D. Verkade also asked the question if ‘decoration’ could not be qualified as a user function.

6. The design directive does not contain the condition of ‘user function’. This has as consequence that since 1 December 2003 also products with a purely decorative function like

11 Art. 1 BDL. With ‘the old Uniform Benelux Design law’ is meant the Uniform Benelux Design Law as applicable before the implementation of the design directive, so before 1 December 2003.

12 Explanatory memorandum to the Benelux Treaty and the Uniform Benelux Design Law, II. Comments on the articles – art. 1 (hereafter indicated as: Memorandum to the BDL – art. 1).

13 See about this: H. VANHEES, 2006, 39-40, n° 78-79; Memorandum to the BDL – art. 1.

14 D. VERKADE, 1985, 32-33, n° 22.

15 Common commentary, pag. 6 (General part – 5. Consequences of the directive).
works of art can be protected as Benelux design. Paintings, etchings, statutes, jewels etc. can since that date without any doubt be protected as Benelux design, of course if the conditions of protection are fulfilled. Consequently, since 1 December 2003 the group of products that can be protected as Benelux design has increased, and of course the overlap between copyright protection and design protection has grown.

7. An important question that needs to be asked after the deletion of the condition of ‘user function’ is if, from 1 December 2003 on, a Benelux depot can be filed for a decoration applicable to various products. In other words, can protection be obtained for a decoration on itself? The common commentary of the three governments of the Benelux countries on the Protocol of 20 June 2002 answers this question negatively, and explicitly states that such a design is void. After the implementation of the design directive the product in or on which a design is applied or incorporated still has to be mentioned in the design application. But the question after this implementation remains if design protection is limited to the decoration as applied on or incorporated in the product mentioned in the design application or is extended to the decoration itself, despite the fact that the product on which it is applied or in which it is incorporated has to be mentioned in the application. The answer to this question is extremely important. If one creates a decoration, and design protection is limited to the decoration as applied on the product mentioned in the application, one has possible to file several design applications, and more specifically applications in which the decoration is each time applied on different products. If design protection is extended to the decoration itself, independently of the product that has to be indicated in the application, then one application is enough to receive a broad design protection. The question raised also arises for other types of designs (appearances) and will be treated in the next part of the text related to ‘the protected object’.

C. The protected object

8. Before 1 December 2003 Benelux design protection was only given to a well described appearance of a well indicated utensil. If one asked protection for the new appearance of an utensil, no protection was given for the new appearance (the design) itself. One only received

---

16 Common commentary, pag. 9 (article-commentary – art. 1).

17 Common commentary, pag. 6 (General part – 5. Consequences of the directive).

18 Common commentary, pag. 9 (article-commentary – art. 1).

19 Rule 2.1, sub 1, c of the implementing regulation of the BTIP (B.S., 19 July 2006, 36036, as amended)(indicated below as IRBTIP).
protection for the new appearance applied on the well described concrete utensil. The product and the user function had to be indicated when the design application was filed. The result of this system was very important. If someone used the same appearance for another utensil, no design infringement occurred. A consequence of this system was even that Benelux design protection could be claimed for the identical appearance applied on another utensil, of course if the conditions of protection were fulfilled. All this proves that according to the old Benelux design rules no protection was given to the appearance of a product on itself. Only the appearance applied to a well described product was protected, and the protection was limited to this appearance as applied to this well described product. Appearance, product and user function were closely connected to each other under the BDL. Due to this, a clear difference existed between copyright protection and design protection, since copyright protects the appearance of works on itself. When the copyright protected appearance of a work is applied to another work, a copyright infringement occurs. The Benelux legislator considered that the design directive would not change the existing system. In his opinion design protection remained connected with a product: due to the definitions of ‘design’ and ‘product’ design protection remained linked to a product, and using the same appearance for another product could give a different overall impression on the informed user. This view of the Benelux legislator can however be questioned.

9. In our view, after the implementation of the design directive, the appearance (the design) on itself is protected by design law, and not anymore the design as applied on a well described product. But does this mean that after this implementation one application will be enough to protect an appearance applied on multiple (all) products (with different user functions)? Shall the application for the appearance of a car also protect the application of this appearance on toy cars? It is clear that the design directive protects the appearance of a product. A design still has to be ‘expressed’ in a product. But the directive does not contain

---


21 Common commentary, pag. 9 (article-commentary – art. 1).

22 Common commentary, pag. 9 (article-commentary – art. 1).

23 A. Kur was surprised that this problem hardly was discussed during the preparation of the design directive (A. KUR, 2002, 662-663).

24 Cf. art 1 (a) of the design directive: “ ‘design’ means the appearance of the whole or a part of a product …”.
an obligation to identify the product when the application is filed. In the Benelux this obligation however still exists. Today it is still necessary in the Benelux to mention the product in or on which the design is applied. The same obligation exists under the regulation on Community designs. Art.36, §2 of this regulation stipulates that “The application shall further contain an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied”. We always considered that although it is the appearance on itself which is protected after the implementation of the design directive, the product in which this appearance is incorporated or to which it is applied, and which has to be indicated in the design application, still plays a major role. In our opinion it plays not only a major role in the assessment of the conditions of protection but also in the assessment of a design infringement. Let us illustrate this. When one must for instance assess if a design has an individual character, one has to compare the design for which protection is sought with designs which have been made available to the public before the date of filing of the application for registration or, if priority is claimed, before the date of priority. A design is made available to the public if it has become known in the normal course of business to the circles specialized in the sector concerned within the European Community (EU) or the European Economic Area (EEA) before the mentioned moment. The sector concerned is the professional circle that is engaged with the same branch of trade or industry and must be determined by also taking in consideration the product to which the design is applied or the industrial sector within which the design product circulates. In our view from this follows that for the assessment of the individual character, as is the case for the assessment of novelty, a comparison must be made between products belonging to the same sector. So the product in which an appearance is incorporated or to which it is applied still plays a major role.

25 D. MUSKER, 2002, 16 and 26, and U. SUTHERSANEN, 2000, 32. U Suthersanen even declares that in the design directive no indication can be found as to whether the design will have to be registered according to the Locarno classification system.

26 Cf. rule 2.1, sub 1, c IRBTIP.


28 Art. 3.3, §2 BTIP.

29 Art. 3.3, §2 BTIP.

30 Common commentary, pag. 12 (article commentary – art. 1bis).

31 U. SUTHERSANEN, 2000, 43.
10. Against our just defended view art. 36, §6 of the regulation on Community designs can be invoked. This art. 36, §6 stipulates that “The information contained in the elements mentioned in §2 (indication of the products in which the design is intended to be incorporated or to which it is intended to be applied)… shall not affect the scope of protection of the design as such.” This provision seems to suggest that although it is necessary at the moment of the application for a registered Community design (RCD) to identify the product in or on which the appearance will be applied, this product plays no role in the assessment of the conditions of protection and in the assessment of a design infringement. Art. 36, §6 of the regulation on Community Designs seems consequently to undermine the view defended by us above. From a decision of 18 March 2010 of the General Court of the EU⁵² can be derived that this is not the case. The Court stated that it follows from art. 36, §6 that, in order to ascertain the product in which the contested design is intended to be incorporated or to which it is intended to be applied, the relevant indication in the application for registration of that design should be taken into account, but also where necessary, the design itself, in so far as it makes clear the nature of the product, its intended purpose or its function. According to the Court, taking into account the design itself may enable the product to be placed within a broader category of goods indicated at the time of registration and, therefore, to determine the informed user and the degree of freedom of the designer in developing his design. In our opinion, from this decision it follows that the product in which a design is intended to be incorporated or to which it is intended to be applied plays a role in determining the informed user and the degree of freedom of the designer in developing his design. Consequently it plays a role in assessing the individual character of a design and in assessing if a design infringement occurs, because both in the assessment of the individual character and of a design infringement the informed user and the degree of freedom of the designer must be determined. The General Court however declares that although the product indicated in the application for registration of a design should be taken into account, the product that actually should be taken into account, possibly has to be determined more precisely. This will be the case in so far as the design itself makes clear the nature of the product, its intended purpose or its function.


⁵³ Cons. 56.
D. The condition of Individual character

11. New after the implementation of the design directive was the introduction of a second, in the Benelux until then unknown condition of protection for designs, namely the condition of ‘individual character’. To be protected a design needs an individual character and it shall be considered to have this individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing of the application for registration or, if priority is claimed, the date of priority. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

12. Quite rightly it is stated in the Common commentary of the governments of the Benelux countries on the Protocol of 20 June 2002 that the condition of individual character heightens the threshold of protection in design law. The condition of individual character is in our opinion not intended to protect the public against confusion. It requires rather of the creator an act of creation which creates a distance to already existing designs.

13. The condition of ‘individual character’ contains concepts that were not known in the Benelux. For instance the concept of the ‘informed user’ from whose point of view this condition of protection must be assessed. The Court of Justice and the General Court of the EU already brought some clarity about this informed user. The Court of Justice already stated that 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. According to the Court, 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.

In assessing the condition of individual character the degree of freedom of the designer in developing the design and the nature of the product to which the design is applied

---

34 Art. 3.3, §2 BTIP and art. 5 design directive.

35 Common commentary, pag. 6 (General part – 5. Consequences of the directive) and 10 (article commentary – art. 1bis).

36 In the same direction: A. ODLE, 2002, 61.


38 C.J., 20 October 2011, case C-281/10 (Pepsico), cons. 53 and 59.
or in which it is incorporated, and in particular the industrial sector to which it belongs has also to be taken into consideration\textsuperscript{39}. It should be noted that all this proves in our opinion that the condition of individual character must not be assessed by only comparing two designs with each other independent of the product to which the designs are applied or in which they are incorporated. This is also, among other things, confirmed by the fact that the assessment of the individual character takes place from the point of view of the informed user. He only can be informed regarding to designs in a specific sector, and he consequently relates his impression of a design to a product or a sector. He is informed about a design as applied to a specific product market. A comparison must therefore take place between designs belonging to the same sector. For our view we can find support in the jurisprudence of the General Court of the EU. In a decision of 22 June 2010 the General Court stated that the assessment of the individual character of a design must take into consideration the nature of the product in which it is incorporated\textsuperscript{40}.

E. Designs dictated by their technical function

14. Art. 2, §1 BDL stipulated before 1 December 2003 that what is necessary to obtain a technical effect is excluded from design protection. An unsolved question was if the word ‘necessary’ had to be explained in the sense that this exception only could be applied if no alternatives existed to obtain the same technical effect\textsuperscript{41}. After the European harmonization art. 3.2, §1, a BTIP stipulates that a design right shall not subsist in features of appearance of a product which are solely dictated by its technical function\textsuperscript{42}. The Common commentary of the governments of the Benelux countries on the Protocol of 20 June 2002 states that the changed text of this exception will not change anything in practice. One can read in this Common commentary that what is necessary to obtain a technical effect (the old criterion) is solely dictated by its technical function (the new criterion)\textsuperscript{43}. The European harmonization did not end the existing discussion in the Benelux. Even today one can find literature and

\textsuperscript{39} Art. 3.3, §2, second sentence BTIP, art. 5, §2 and cons. 13 design directive.

\textsuperscript{40} Gen. Court, 22 June 2010, case T-153/08 (Shenzhen v. OHIM), cons. 60.

\textsuperscript{41} See for doctrine and jurisprudence defending the view that the exception cannot find application in case alternatives to obtain the same technical effect exist: H. VANHEES, 2006, 47-48, n° 99. See about the opposite view defending that the existence of alternatives play no role for the application of the exception: T. VAN ENGELEN, 1994, 81.

\textsuperscript{42} Cf. art. 7, §1 Design directive.

\textsuperscript{43} Common commentary, pag. 13 (article-commentary – art. 2).
jurisprudence defending the view that if alternatives exist to obtain the same technical effect, the appearance of a product is not solely dictated by its technical function, and literature and jurisprudence defending the view that the existence of alternatives play no role: if the appearance of a product is dictated by a technical function, the exception finds application despite the fact that the same technical function can be obtained by alternatives.

15. Personally, we always defended the first mentioned view. In our opinion the existence of alternatives prevented the application of the exception foreseen in art. 3.2, §1, a BTIP. We felt supported by the opinion of Advocate General Colomer in the case Philips versus Remington. The Advocate General stated in his opinion with regard to art. 7, §1 of the design directive that: “… the level of 'functionality' must be greater in order to be able to assess the ground for refusal in the context of designs; the feature concerned must not only be necessary but essential in order to achieve a particular technical result: form follows function. This means that a functional design may, none the less, be eligible for protection if it can be shown that the same technical function could be achieved by another different form.”

The question is whether this view still can stand after the decision of the Court of Justice of 14 September 2010 in the Lego case. In this decision the Court of Justice argues with relation to the similar exception in trade mark law:

“45. First, the inclusion in Article 7(1) of Regulation No 40/94 of the prohibition on registration as a trade mark of any sign consisting of the shape of goods which is necessary to obtain a technical result ensures that undertakings may not use trade mark law in order to perpetuate, indefinitely, exclusive rights relating to technical solutions.

46. When the shape of a product merely incorporates the technical solution developed by the manufacturer of that product and patented by it, protection of that shape as a

---


46 H. VANHEES, 2006, 33-34, n° 68.


48 Cons. 34.

49 C.J., 14 September 2010, case C-48/09 P (Lego v. OHIM and Mega Brands).

50 Art. 7, §1, e, sub ii of the Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (O.J., 2009, L 78, 1. This regulation has replaced regulation n° 40/94 declares:

“1. The following shall not be registered: …

(e) signs which consist exclusively of:

(ii) the shape of goods which is necessary to obtain a technical result; …”.
trade mark once the patent has expired would considerably and permanently reduce the opportunity for other undertakings to use that technical solution. In the system of intellectual property rights developed in the European Union, technical solutions are capable of protection only for a limited period, so that subsequently they may be freely used by all economic operators. As OHIM pointed out in its argument summarized in paragraph 37 above, that consideration underlies not only Directive 89/104 and Regulation No 40/94, with regard to trade mark law, but also Regulation No 6/2002, in relation to designs."

Are these considerations an indication that the Court of Justice will interpret the exception in design law discussed here in the same way as the similar exception in trade mark law, so that the existence of alternatives plays no role for the application of the exception? Personally we are not convinced that this is the case. In our view, the only thing that can be derived from the cited considerations is that according to the Court of Justice in the European system of intellectual property it is unacceptable that a perpetual protection is granted to technical solutions. Where indeed this could be the case in trademark law, as trade mark protection can over and over again be renewed for new periods of 10 year, this can never be the case in design law as design protection only can exist for a maximum period of 25 years.

F. The protection of tactile designs

16. Art. 3.1, §2 BTIP stipulates that ‘design’ means the appearance of the whole or a part of a product. Art. 3.1, §3 BTIP adds to this that the appearance of a product is resulting from the features of in particular, the lines, contours, colors, shape, texture and/or materials of the product itself or its ornamentation. From art. 3.1, §3 BTIP clearly follows that the appearance of a product can be derived from the texture and/or materials of a product. Texture often can be represented visually but is mainly perceived by touch. Material mainly will be perceived by touch. Weight, flexibility and texture are properties of material mainly

---

51 A. Quaedvlieg writes that this possibly can be the case (A. QUAEDVLIEG, 2010, 424). See with regard to the jurisprudence of the Court of Justice in trade mark law: C.J., 18 June 2002, case C-299/99 (Philips v. Remington) and C.J., 14 September 2010, case C-48/09 P (Lego v. OHIM and Mega Brands).

52 See with regard to the term of protection in design law: art. 3.14, §1 and 2 BTIP and art. 12 design regulation (RCD).

53 Cf. art. 1, a design directive.

54 Cf. art. 1, a design directive.

55 D. MUSKER, 2002, 15, 1-017, who adds to this that texture has an appearance and can be visually represented although usually only by close inspection or enlarged representations.

perceptible by touch, rather than by eye. All this raises the question if tactile designs can be protected as Benelux design. From the cited provisions could be inferred that the answer to the question raised has to be positive. Some legal scholars were also inclined to answer this question positive. D. Musker wrote that “In my view, the word ‘appearance’ should be give the broader meaning covering vision and touch…” and A. Kur stated “So ist der Schutz grundsätzlich nicht auf visuelle wahrnehmbare Gestaltungselemente beschränkt. Damit wird prinzipiell die Möglichkeit des Schutzes für Tastmuster eröffnet (‘Oberflächenstruktur’)”.

Also the European Commission in its Green paper on the legal protection of industrial designs seemed positive to the protection of tactile designs. At the other side some recitals of the design directive can be read as a negative answer to the question raised. Recital 11 stipulates: “Whereas protection is conferred by way of registration upon the right holder for those design features of a product, in whole or in part, which are shown visibly in an application …”, and in recital 13 one can read: “Whereas the assessment as to whether a design has individual character should be based on whether the overall impression produced on an informed user viewing the design …”.

17. In the Benelux, the possible protection of tactile designs is totally new. Before the implementation of the design directive it was generally assumed that the protected appearance was supposed to consist of what was visible.

18. The view that also tactile designs can be protected by design law came recently under pressure. This view is not reconcilable with a recent decision of the General Court of the European Union.

---


58 D. MUSKER, 2002, 13-14, 1-012.

59 A. KUR, 2002, 663.

60 June 1991, doc III/F/5131/91-EN. In this paper one can read: “The Commission hopes that this definition can be interpreted in a sufficiently broad manner to cover some specific cases which deserve protection. One should think of certain textile textures which give a particular impression to the sense of touch.” (5.4.7.2)

61 For D. Musker recital 11 is only a guideline to the normal practice of registering visual representations of the appearance of a design (D. MUSKER, 2002, 13-14, 1-012).

62 D. Musker is of the opinion that recital 13 is using the term ‘viewing’ in an exemplary, rather than a limiting sense (D. MUSKER, 2002, 14, 1-012).
European Union of 18 March 2010. The General Court underlined in recital 50 of his decision that in the wording of art. 3, a of the design regulation and art. 1, a of the design directive a design is only the appearance of the whole or a part of a product, and that the infringement criterion is ‘another visual overall impression’. This recital suggests that the protection offered by European design law is limited to visual observable elements. The General Court seems to close the door for purely tactile designs. Only visual elements or elements which can be made visually presentable are eligible for protection.

G. The infringement criterion

19. Under the BDL the holder of a Benelux design had the exclusive right to oppose against the making, import, export, sale, offering for sale, rental, offering for rental, exhibition, delivery, use or stocking for these purposes, with industrial or commercial purposes, of a product with an identical appearance as the protected design or with an appearance containing only minor differences. Before the European harmonization the infringement criterion was: ‘does the alleged infringing design produce an identical appearance or an appearance containing only minor differences’. In fact, to assess whether a design infringement occurred, the criterion of ‘confusion’ was used. After the implementation of the design directive art. 3.16, §1 BTIP provides that the holder of a design right has the exclusive right to oppose against the use of a product in which the design is incorporated or to which it is applied and which produces an identical appearance as the protected design or the same overall impression on the informed user, taking into consideration the degree of freedom of the designer in developing his design. It is clear that after the European harmonization, the infringement criterion became ‘does the alleged infringing design produce on the informed user the same overall impression’. As already indicated, the General Court of the EU already stated very clearly that the actual infringement criterion is ‘the same overall visual impression’.

---


64 Art. 14, §1 BDL.

65 See H. VANHEES, 2006, 119-120, n° 269.

66 General Court, 18 March 2010, case T-9/07 (Mon graphic v. OHIM), cons. 50.
20. According to the Common commentary of the three governments of the Benelux countries on the Protocol of 20 June 2002 the infringement criterion after the implementation of the design directive is not much different from the infringement criterion being applied before this implementation\textsuperscript{67}. We cannot agree with this point of view. In our opinion the criterion of likelihood of confusion has been abandoned\textsuperscript{68}. The existence of likelihood of confusion, and consequently the existence of minor differences, is not necessary in order to create on the informed user the same overall impression. Indeed, in case of likelihood of confusion between designs, both designs will create the same overall impression on the informed user. But in our opinion, one can also have the situation that two designs contain clear differences, but produce the same overall impression on the informed user. The infringement criterion (‘the same overall impression on the informed user’) is in fact identical to the one of the conditions of protection, namely the condition of the ‘individual character’. As was indicated earlier in this contribution, this condition of protection is not intended to protect the public (the consumers) against likelihood of confusion. It rather wants to prevent that (small) changes to existing designs could lead to design protection\textsuperscript{69}.

21. An important question is whether in case of an alleged infringement one has only two compare two designs, independently of the products in which the designs are incorporated or to which they are applied, or whether these products have to be taken into account. Under the old Benelux design legislation one could only take action against a product having an identical appearance as the protected design, or an appearance containing minor differences, if this product had the same user function as the protected design. If the appearance of a car was protected as design, one could not take action on the basis of the BDL against a toy car containing the appearance of the protected car. A car and a toy car have different user functions\textsuperscript{70}. After the harmonization of the Benelux design law the question was whether the product still had to be taken into account in the assessment of a design infringement. Some legal scholars denied this. In their opinion the scope of protection after the European harmonization was not related nor limited to the products in which the designs were incorporated or to which they were applied by the designer or indicated in the application\textsuperscript{71}.

\textsuperscript{67} Common commentary, pag. 6 (General part – 5. Consequences of the directive).

\textsuperscript{68} Also: W. HOORNEMAN, 1999, 31-32.

\textsuperscript{69} Also: A. ODLE, 2002, 61.

\textsuperscript{70} See about this: H. VANHEES, 2006, 120, n° 270.

We cannot agree with this point of view, and we feel supported by an already discussed decision of the General Court of the EU. The General Court of the EU, in a decision of 22 June 2010\textsuperscript{72}, stated that for the assessment of the individual character of a design the nature of the product in which it is incorporated must be taken into consideration\textsuperscript{73}. So to find out if a design produces on the informed user a different overall impression, the nature of the product in which it is incorporated must be taken into consideration. As the infringement criterion is identical to the condition of ‘individual character’, the nature of the product in which the design is incorporated must consequently also be taken into consideration to find out if a design infringement occurred. This is very logical. One may never forget that the scope of protection has to be determined on the basis of the overall impression produced on the informed user. This overall impression however only can be determined objectively in relation to the product in which a design is incorporated or to which it is applied or to the sector to which the product belongs.

### III. The influence of the design regulation on Benelux design law

22. The regulation on Community designs introduced a registered and an unregistered Community design. Applications for a registered Community design (RCD) could be filed since 1 April 2003\textsuperscript{74} and the unregistered Community design (UCD) exists since 6 March 2002. Has the introduction of the registered and unregistered Community design had any effect on the Benelux design?

23. Looking to the statistics of the Benelux Office for Intellectual Property (BOIP), the answer to the question raised has to be positive. When one only considers the number of applications for a Benelux design after the entry into force of the UCD and the RCD in respectively 2002 and 2003, one can conclude that this number of applications fell by about half after this entry into force. Since 2005 the number of applications even decreased by approximately two thirds. The number of applications for a Benelux design are: 3461 applications in 1999, 3344 applications in 2000, 2909 applications in 2001, 3151 applications in 2002, 1955 applications in 2003, 1479 applications in 2004, 1086 applications in 2005, 1105 applications in 2006, 1036 applications in 2007, 844 applications in 2008, 987

\textsuperscript{72} Gen. Court, 22 June 2010, case T-153/08 (Shenzhen v. OHIM).

\textsuperscript{73} Cons. 60.

\textsuperscript{74} It was possible to file an application for a RCD from 1 January 2003 on, but applications between 1 January 2003 and 1 April 2003 were deemed to be done on 1 April 2003 (see H. VANHEES, 2006, 207, n° 451).
applications in 2009 and 1178 applications in 2010. Based on this figures it is undeniable that the Benelux design has become less attractive since the appearance of the RCD and the UCD. At the same time one can establish that since 2004 at the Office for harmonization in the internal market (trade marks and designs)(OHIM) every year more than 1000 applications for a RCD are received from Belgium and more than 2000 applications from the Netherlands.

What can cause this evolution? The cost of an application for a Benelux design is undoubtedly a disadvantage for this design. An application for a simple Benelux design costs 108 EUR, plus 10 EUR per publication of a representation. Under the system of the Community design, a single application (one RCD) costs 350 EUR (a registration fee of 230 EUR and a publication fee of 120 EUR). It is very clear that compared with the RCD, a Benelux design is quite expensive. For not much money more, one can receive protection in the 27 countries of the European Union (EU), whereas the Benelux design only offers protection in the three countries of the Benelux. In this context, one may also not forget that the conditions of protection in the Benelux are identical to those in the regulation on Community designs. Under both systems, to determine whether a design is new and has an individual character, the design will be compared with the same designs which have been made available to the public before the date of filing the application for registration, or if priority is claimed, before the date of priority. Indeed, both under the system of the BTIP and the regulation on Community designs one has to compare the design for which protection is sought with designs which have become known in the normal course of business to the circles specialized in the sector concerned, operating within the European Union. To receive protection in the Benelux the design for which protection is sought also has to be compared with designs which have been made available to the public in the whole European Union, and not only with designs which have been made available to the public in the Benelux.

24. Also the emergence of the UCD has undoubtedly a negative impact on the Benelux design. The benefits of the UCD are very clear: no formalities to fulfill, so one should not incur costs to receive design protection, and automatically one receives protection in the 27 member states of the EU. Of course the protection provided by the UCD has a shorter term of protection (the term of protection is three years as from the date on which the design was first


76 Cf. art. 3.1, §1 and art. 3.3, §1, 2, 3 and 4 BTIP and art. 4, §1, art. 5, 6 and 7 regulation on Community Designs.

77 Cf. art. 7, 1 regulation on Community designs and art. 3.3, §3 BTIP.
made available to the public within in the EU\textsuperscript{78}) and the scope of protection is more limited. One can only prevent any third party to use an identical design or a design which does not produce on the informed user a different overall impression, if this use results from copying the protected design\textsuperscript{79}. However, this protection is often sufficient for designers: the protected design will only be commercialized during a very short period, and one only seeks protection against pure imitation. It has to be underlined that the analysis of the recent Benelux jurisprudence concerning designs shows that the UCD is more widespread in the Netherlands than it is in Belgium. Belgian designers seem not so familiar with the UCD. Unlike the situation in the Netherlands, there are up to now only very few cases in Belgium in which protection of a design is claimed on the basis of a UCD\textsuperscript{80}.

25. Although the appearance of the UCD undoubtedly led to the reduction of the number of applications for a Benelux design, the UCD also has a positive effect for the holders of Benelux designs. As will be shown below, the UCD supports the protection offered by a Benelux design and even broadens this protection.

26. If one want to protect a design as Benelux design, it is not necessary to file an application before the design will be made available to the public. Art. 3.3, §4 BTIP contains a ‘grace period’. A design will not be deemed to have been made available to the public if it is made available to the public by the designer, his successor in title or a third person as a result of information provided or action taken by the designer or his successor in title during the 12-month period preceding the date of filing of the application or, if priority is claimed, the date of priority. Due to this grace period, a designer can first test his design on the market without losing the possibility to receive Benelux design protection afterwards, if it becomes clear that there is demand on the market for his design. He can first make his design available to the consumer concerned, and if it becomes clear that the consumer is interested in his design, he can still file an application for a Benelux design. However, as long as no application has been filed for the design and as long as this application has not been registered in the Benelux register, the designer can’t claim any design protection based on the BTIP. As a result of the implementation of the design directive a design can only be protected as Benelux design after

\textsuperscript{78} Art. 7, 1 regulation on Community designs.

\textsuperscript{79} Art. 19, 2, §1 regulation on Community designs.

\textsuperscript{80} See about this analysis of the recent Benelux jurisprudence concerning designs: H. VANHEES, 2011, 3-49.
the registration in the Benelux register of the application for a Benelux design. So if a design is first made available to the public and only after this making available to the public, a Benelux application is filed, no design protection based on the BTIP can be claimed for the period between the moment of making the design available to the public and the moment of the registration of the Benelux application. When moreover the design concerned is not protected by copyright, a designer risks to have no protection at all against infringers in that period. This danger, that existed in the past, has disappeared due to the appearance of the UCD. As the conditions of protection are identical for the Benelux design and Community designs, and as the protection offered by the UCD starts from the moment a design is first made available to the public within the EU, actions can be started against infringers from the moment a design is made available to the public, and thus before the moment of registration of the application for a Benelux design. Of course the protection offered until the moment the registration in the Benelux register has taken place, is the more restricted protection of the UCD. But based on the UCD, the designer can start proceedings against those who copied his design, and this kind of infringement occurs a lot.

IV. Conclusion

27. In the above contribution, we tried to prove that both the design directive and the regulation on Community designs had and has a very important influence on Benelux design law. Due to the design directive, the basis concepts in the Benelux design law changed more fundamentally than the Benelux legislator had in mind in 2002. Moreover, it is clear that much of these ‘new’ ‘European’ concepts still need further interpretation by the Court of Justice. In the above contribution we also proved that the influence of the regulation on Community designs had both positive and negative consequences for the Benelux design. It is clear that the introduction of the Community design did decrease the number of granted Benelux designs, and consequently affected the attractiveness of this design. On the other

---

81 Cf. the text of art. 3.5, §1 BTIP. Before the implementation of the design directive a designer could claim protection from the moment the application was filed. See about this: H. VANHEES, 2003, 634.

82 One may of course not forget art. 3.17, §6 BTIP that stipulates that once a designer obtained a Benelux design he can claim a reasonable compensation from those who had knowledge of his application and this for their acts that took place between the moment of the filing of the application and the moment of the registration of this application and could be qualified as infringements once the design protection is granted.

83 Cf. art. 11, 1 regulation on Community designs.
hand, due to the unregistered Community design, a design can already be protected in the Benelux before the moment of registration of the application for a Benelux design.

Bibliography


F. GOTZEN, ‘De uitgaveovereenkomst’, Auteursrecht/AMR, 1982, 60-69


