
European Court of Justice: No limitation of relevant prior art to certain product categories // Taking notice of relevant prior art by the informed user not required (Judgment of September 21, 2017, consolidated cases C 361/15 P and C 405/15 P – shower drainage channel). October 2017

Report by Dr. Philippe Kutschke und Simon Schopper

The Dutch company Easy Sanitary Solutions (ESS) filed the registered Community design (RCD) No. 00107834-0025 with the EUIPO on November 28, 2003. The design was published on March 9, 2004 including the indication of product “Doucheputten” (shower drains). The design-in-suit shows a cover plate with a circular shower drain including a drainpipe. Upon a corresponding request by the Belgian competitor I Drain (now Group Nivelles, GN), the EUIPO declared the design in suit invalid due to lack of novelty. Upon an appeal by ESS, the 3rd Board of Appeal of the EUIPO lifted the decision (docket no. R2004/2010 3). Upon the complaint lodged by GN against this decision, the GC then again lifted the decision by the Board of Appeal due to flawed comparison of the designs (docket no. T-15/13). The appeal lodged by ESS and the EUIPO against the GC’s decision was unsuccessful.

In the present judgment, the ECJ makes detailed comments on three aspects which are probably significant in almost every design law case: To begin with, the Court clarifies that, due to the principles of party presentation applying to invalidity proceedings, it is not the EUIPO’s task as part of the assessment of novelty to combine different elements of an earlier design which were published separately from each other in

order to assess their relevance. In addition, the Court of Justice elaborates on why the nature of a product, into which an earlier design is incorporated, is immaterial for the assessment of its relevance, despite Article 7 CDR making reference to “*to the circles specialised in the sector concerned, operating within the Community*”. Furthermore, the Court of Justice describes why the question whether the informed user took (actual) notice of the respective prior art is not relevant in this context.

The GC was of the opinion that the EUIPO erred in law by not identifying the relevant prior art on its own among the facts presented. Moreover, it held that the EUIPO should have combined the single elements of the relevant earlier design on its own. The Office objected that the principle of *ex officio* examination does not apply to invalidity proceedings (Article 63 (3) CDR). Therefore, it is the responsibility of the invalidity applicant to provide the necessary details, particularly to precisely and comprehensively designate any earlier design (Article 52 (1), (2), Art. 53 (1), (2) CDR). The ECJ reasoned accordingly, contrary to the assessment of the GC.

By contrast, the ECJ followed the GC’s finding that a design also constitutes relevant prior art if it is incorporated into a product belonging to a different sector than the product specified in the product indication of the RCD. It states that nothing else results from the reference to the “*circles specialised*



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in the sector concerned” in Article 7 (1) CDR. According to the ECJ, this provision is an exception which is to be interpreted restrictively. The Court of Justice continues that the provision is meant to adequately consider the difficulties with examining the actual circumstances regarding acts of disclosure and, thus, with relying on the possibilities of taking note of the circles specialized in the sector concerned operating within the Community. According to the Court, a limitation of the relevant prior art to certain sectors is not associated with the provision and was not intended by the regulator, either.

However, the ECJ also clearly rejected the GC’s assumption that an earlier design is

relevant to the evaluation of individual character only if the informed user was (actually) aware of the earlier design. According to the ECJ, such awareness by the informed user is neither relevant to examining novelty nor to assessing individual character of the design-in-suit. Otherwise, the implication in law of Article 7 CDR would not only require that an act of disclosure has not only taken place, but was also evidently known to the informed user. However, the text of the regulation gives no indication of such an extension of the requirements. Hence, the invalidity applicant is still only required to prove that an act of disclosure has taken place, not that the informed user took notice of the respective prior art.

Remarks

The ECJ made it pleasantly clear that a product indication of an RCD is to be taken into account when the subject matter of protection is determined, but does not limit the relevant prior art (or scope of protection). Once again, the ECJ confirmed the principle of reciprocity, according to which the assessment of validity and infringement follow the same principles: The question whether the attacked product (respectively the product known before the priority date) corresponds to the product indication of the RCD is neither relevant for the assessment of infringement regarding the attacked product, nor for the assessment of validity regarding the relevance of the prior art (cf. already England and Wales Court of Appeal, Judgment of April 23, 2008, published in Hartwig, DesignE 3, 234 paragraphs 10 et seq., 27, 47, 50, 70, 79 – *Green Lane/PMS*).

Certainly, invalidity applicants will be relieved that the ECJ made it also clear that it is not relevant whether the informed user (actually) took notice of the respective prior art does admittedly correspond to the previous ECJ case law.

The decision is also of significance insofar as it clarifies once more that it is not sufficient to file huge volumes of documents comprising prior art, but that one is also obliged to explain and illustrate it. Thereby, every piece of prior art is to be assessed individually (in this regard, cf. also ECJ, Judgment of June 19, 2014, case C 345/13 paragraph 24 et seq. – *Karen Millen Fashions*).