
Protectability of a design, the representations of which show different embodiments of a product – Federal Court of Justice, decisions dated December 20, 2018, docket nos. I ZB 25/18 – *Sporthelm* [sports helmet] and I ZB 26/18 – *Sportbrille* [sports glasses]

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In two groundbreaking decisions that change the settled case law, the Federal Court of Justice continues the trend of the last years: The representations of a design must, in the interest of the legal certainty of third parties, reveal in a clear and unambiguous manner what is exactly protected by the respective design. This requirement sets clearer limits to the previous, highly validity-friendly interpretation of the representations of a design (at European level, see already ECJ, judgment of 5.7.2018, C-217/17 P - *Mast-Jägermeister*). The core of both cases, which were already decided by the Federal Court of Justice at the end of last year, but were only published recently, was the question of whether a registered design, the representations of which show different embodiments of a product, is valid according to the previous, so-called “intersection theory” [“Schnittmengentheorie”] of the Federal Court of Justice (cf. FCJ, judgment of 15.2.2001, I ZR 333/98 – *Sitz-Liegemöbel* [loungers]), or – in line with the European case law – is invalid. The Federal Court of Justice opted for the latter alternative and, thus, gave up its previous case law.

Facts of the case

Subject matter of the two decisions of the First Civil Chamber of the Federal Court of Justice were two separate designs of the same owner. For the German Design no. 40200800132-0001 (hereinafter “sports helmet design”) that was filed on February 28, 2008 and registered on July 16, 2008, the design owner had filed seven representations, all of which being black and white photographs. These seven representations each showed a sports helmet. However, each sports helmet had different features (e.g., different straps, with or without an equestrian knob, different color contrasts and patterns). For the second German Design no. 402008001031-0001 that was also filed on February 28, 2008 but was only registered on July 23, 2008 (hereinafter: “sports glasses design”), the design owner had filed five representations, once again all of them being black and white photographs. Each of these representations showed skiing glasses or elements of skiing glasses. However, in this case as well, the individual representations depicted glasses with different color schemes, hence, not one and the same product. Thus, as regards both the sports helmet design as well as the skiing glasses design, the applicant had filed different sports helmets or skiing glasses, respectively, as a single design.

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The applicant had applied for the declaration of invalidity of both designs, arguing that they lacked protectability because they did not disclose a uniform subject matter.

The German Patent and Trademark Office rejected the applications. The applicant then filed complaints against these decisions with the Federal Patent Court – without success.

As regards the sports helmet design, the Federal Patent Court had found that the design's seven representations show seven different helmets and that the differences are decisive for the respective aesthetic overall impression. However, applying the earlier case law of the Federal Court of Justice, it affirmed the protectability of the design on the ground that the subject matter of the design could be determined by creating an intersection of the features of the seven different helmets (so-called "intersection theory" ["Schnittmengentheorie"]). All of the representations of the sports helmet design coincided insofar as that they depicted an identically shaped helmet shell.

On similar grounds, the Federal Patent Court also affirmed the protectability of the sports glasses design, whereby in this case, according to the Federal Patent Court, the filed representations depicted seven different views of the same product. The different color schemes did not lead to another result, as, in the opinion of the Federal Patent Court, protection was sought for an abstract black and white contrast of two different shades of grey. Furthermore, the Federal Patent Court argued that, even if one would assume that the representations 1 to 3 depicted two different pairs of

skiing glasses and the representations 4 and 5 showed parts of a glasses frame that were independently eligible for design protection, the design would still reveal a unitary subject matter. In order to determine this subject matter, one would, again, just need to create an intersection of the coinciding features of the representations. In the present case, representations 1 to 3 showed glasses with an identically shaped frame. Representations 4 and 5 only served the purpose of clarifying the two-piece structure of the glasses frame.

By way of appeals on points of law, the applicant further pursued its applications for declaration of invalidity of both designs and was successful in both cases.

The decisions of the Federal Court of Justice

The Chamber grants both appeals on points of law and lifts both decisions of the Federal Patent Court. However, given that the Federal Court of Justice is not entitled to decide on the merits, it remitted the cases to the Federal Patent Court (Sec. 23 (5) of the German Design Act [DesignG] in conjunction with Sec. 108 (1) of the German Patent Act [PatG]). In view of the very clear reasoning of both decisions, it appears likely that it will declare both of the attacked designs to be invalid.

The starting point of the two decisions is that Sec. 1 no. 1 of the German Design Act [DesignG] stipulates two requirements to assume protectability of a design: First, the subject matter of a design must be the appearance of a "product" in the sense of Sec. 1 no. 2 of the German Design Act

[DesignG], thus, the appearance of an industrial or handicraft item (which could, in the present cases, be answered in the affirmative without any difficulties). Second, the subject matter of a design can – as long as it does not have any abstractions – only be the appearance of “one” design (and not of several designs), because, otherwise, the subject matter of the design could not be determined clearly and unambiguously. In the event that one of these requirements is not met, the design is invalid pursuant to Sec. 33 (1) no. 1 of the German Design Act [DesignG].

Insofar, the present decisions are in accordance with the Chamber’s earlier case law (cf. FCJ, judgment of 8.3.2012, I ZR 124/10 – *Weinkaraffe [wine carafe]*), according to which a design application is not only a procedural step, but also a declaration of intent. If a single design application contains several representations of a design and it is questionable whether the design application represents the appearance of “one” design, the protected subject matter must be determined by way of interpretation of the application. However, in favor of the legal certainty of third parties, the Federal Court of Justice now defines clear boundaries for the validity-friendly interpretation: The representations must clearly reveal what the applicant seeks protection for. Should an unequivocal interpretation in this respect not be possible, the design is invalid. Moreover, when interpreting a design application, neither the intention of the designer or the applicant, nor the understanding of the informed user is decisive. Rather, the application must be interpreted from the standpoint of the specialist circles in the respective sector. In this context, it is to be welcomed that the Federal Court

of Justice (again) explicitly states that, when interpreting a design application, not only the representations, but also other circumstances of the case should be taken into account, in particular the (optional) description of the representations, the (obligatory) indication of the product and the (optional) list of the class(es) of goods the product is assigned to.

Referring to the necessary legal certainty for third parties and the principle of the clarity of the register, the Federal Court of Justice sets clear limits to such an interpretation and (finally) gives up its previous, so-called “intersection theory” [“Schnittmengentheorie”] (cf. FCJ, judgment of 15.2.2001, I ZR 333/98 – *Sitz-Liegemöbel [loungers]*), which the Federal Patent Court had used as a basis for its two decisions. Hence, according to the two decisions of the Federal Court of Justice, in cases in which the representations of one single design show different embodiments of a product having different design features, the subject matter of the design cannot be determined by creating an intersection of those features that are contained in all representations. Instead, the design is to be declared invalid. According to the Chamber, this is because a subject matter that was created by way of abstraction, only exists in the imagination of the observer. However, only the features that are clearly revealed in the representations can be comprised in the scope of protection of a design (Sec. 37 (1) of the German Design Act [DesignG]). Furthermore, the principle of the clarity of the register is not adequately safeguarded, if the subject matter for which protection is sought must be explored in several mental steps.

Against this background, the Federal Patent Court's interpretation of the two attacked design applications did not withstand the revision by the Federal Court of Justice. First, with respect to the sports helmet design, the Chamber states that the Federal Patent Court correctly found that the submitted representations show seven different helmets and not seven different views of one and the same helmet. Also, with regard to the sports glasses design, the Federal Patent Court correctly came to the conclusion that the representations that were filed along with the application showed several features of the appearance of the depicted product that were incompatible with one another. However, the Federal Court of Justice corrects the results of both decisions of the Federal Patent Court (thereby giving

up its own earlier case law). Now taking greater account of the wording of Sec. 1 no. 1 of the German Design Act [DesignG], the Chamber consequently comes to the conclusion that the representations of the two designs do not unequivocally show the appearance of "one" design and, therefore, the two designs must be declared invalid.

Nevertheless, the Chamber emphasizes once more that, regarding black and white photographs that show a color contrast in different shades of grey, the visible light and dark contrast takes part in the scope of protection of a design, not however, a specific color scheme (in this respect, it is indeed still possible that one design protects more than the appearance of "one" product).

Remarks

It is to be highly welcomed that, with its two decisions, the Federal Court of Justice now clarifies that the interpretation of design applications can only go as far as the principle of the clarity of the register, that serves the legal certainty of third parties, is not infringed. Giving up the "intersection theory" ["Schnittmengentheorie"] was logical and long overdue.

With this change of case law, the two decisions of the Federal Court of Justice are in line with the recent case law of the European Court of Justice, in particular its "Mast-Jägermeister" decision. Even if the European design regime is comparatively liberal with regard to the type and amount of representations, the validity-friendly interpretation does have limits (cf. ECJ,

judgment of 5.7.2018, C-217/17 P – *Mast-Jägermeister*).

Moreover, it is very positive that the Federal Court of Justice again (cf. also FCJ, judgment of 8.3.2012, I ZR 124/10 – *Weinkaraffe* [wine carafe]) expressly – and also in accordance with the case law of the European General Court of Justice and the General Court of the European Union (cf., for example, ECJ, judgment of 8.3.2018, C-395/16 – *DOCERAM/CeramTec*; ECJ, judgment of 20.10.2011, C-281/10 – *PepsiCo*) – states that, when interpreting a national German design (the same applies for a registered Community design) not only the representations, but also other circumstances from outside the register should be taken into account (such as, for example,

the real products that are manufactured based on the design). Now, it remains to be seen whether these principles of interpretation are going to be applied by the offices and courts more consequently than in the past. In this respect, it also remains to be seen whether the requirement established by the European Court of Justice, according to which it must not only be clearly distinguishable from the representations what is protected, but also what is not protected (cf. ECJ, judgment of 5.7.2018, C-217/17 P – *Mast-Jägermeister*), will be applied.

At the same time, the two decisions of the Federal Court of Justice illustrate the pitfalls of unexamined protective rights and the necessity to already act strategically and thoroughly when filing the design application. Whereas, in the last five years, an average of approximately 10 % of the German design applications (and, on average, approximately 5 % of the registered Community designs) have not been registered, the present two decisions could possibly even increase the rejection rate and/or invalidation rate. However, although registered designs are not subject to comprehensive examination, at least the EUIPO evaluates, *inter alia*, whether or not the representations are consistent. Thus, if the discrepancies between the representations are already noticed during the application procedure, the office invites the applicant to either delete individual representations, or to divide the design into two (or more) designs. Hence, provided that the applicant reacts reasonably to a respective office action, the invalidity can be prevented. In the event that the applicant is stubborn and insists on maintaining the representations, however, he or she must expect the rejection of the application (cf. ECJ, judgment of

5.7.2018, C-217/17 P – *Mast-Jägermeister*). As the case may be, the applicant may also consider refiling the designs within the twelve-month grace period of novelty.

In the present cases, it is unknown whether the applicant actually intended to apply the Federal Court of Justice's "intersection theory" ["Schnittmengentheorie"] when filing the contradictory representations. It also appears to be reasonable to assume that the applicant made a mistake insofar as, instead of filing a multiple application with different designs (which would have been possible without any difficulties), he or she just put all the available representations into one single design application. In any case, particularly with regard to unexamined protective rights, it makes sense to seek advice from experts beforehand in order not to end up losing the registered design rights, as will presently most likely be the case.

For the sake of completeness, however, it should be noted that, from the wording of Sec. 1 no. 1 of the German Design Act [DesignG] ("one" design), it cannot be concluded that it is inadmissible to use disclaimers, but only that the representations cannot be contradictory insofar as that they show different variations of one and the same feature (such as, for example, an ornament or a pattern). On the contrary, it is still admissible to protect "several" embodiments of a product by one single design by abstracting the color or using disclaimers, for example.