



Reports of Cases

OPINION OF ADVOCATE GENERAL
WATHELET
delivered on 2 April 2014¹

Case C-345/13

**Karen Millen Fashions Ltdv
Dunnes Stores,
Dunnes Stores (Limerick) Ltd**

(Request for a preliminary ruling from the Supreme Court (Ireland))

(Intellectual and industrial property — Assessment of the individual character of an unregistered Community design — Burden of proof)

1. This request for a preliminary ruling from the Supreme Court (Ireland) concerns the interpretation of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs.²
2. It has been made in proceedings brought by Karen Millen Fashions Ltd ('KMF') against Dunnes Stores and Dunnes Stores (Limerick) Ltd ('Dunnes'), in order to obtain injunctions to restrain Dunnes from using designs of which it claims to be the holder.

I – Legal framework

A – The TRIPs Agreement

3. The Agreement on Trade-Related Aspects of Intellectual Property Rights ('the TRIPs Agreement') forms Annex 1 C to the Agreement establishing the World Trade Organisation (WTO), signed in Marrakech on 15 April 1994 and approved by Council Decision 94/800/EC of 22 December 1994 concerning the conclusion on behalf of the European Community, as regards matters within its competence, of the agreements reached in the Uruguay Round multilateral negotiations (1986-1994).³
4. In Section 4, entitled 'Industrial Designs', of Part II of the TRIPs Agreement, entitled 'Standards Concerning the Availability, Scope and Use of Intellectual Property Rights', Article 25, entitled 'Requirements for Protection', provides:
 - '1. Members shall provide for the protection of independently created industrial designs that are new or original. Members may provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features. Members may provide that such protection shall not extend to designs dictated essentially by technical or functional considerations.

1 — Original language: French.

2 — OJ 2002 L 3, p. 1.

3 — OJ 1994 L 336, p. 1.

...'

B – Regulation No 6/2002

5. Recitals 9, 14, 16, 17, 19 and 25 in the preamble to Regulation No 6/2002 state:

'(9) The substantive provisions of this Regulation on design law should be aligned with the respective provisions in Directive 98/71/EC.

...

(14) 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 clearly differs from that produced on him by the existing design corpus, taking into consideration the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs and the degree of freedom of the designer in developing the design.

...

(16) Some of those sectors produce large numbers of designs for products frequently having a short market life where protection without the burden of registration formalities is an advantage and the duration of protection is of lesser significance. On the other hand, there are sectors of industry which value the advantages of registration for the greater legal certainty it provides and which require the possibility of a longer term of protection corresponding to the foreseeable market life of their products.

(17) This calls for two forms of protection, one being a short-term unregistered design and the other being a longer term registered design.

...

(19) A Community design should not be upheld unless the design is new and unless it also possesses an individual character in comparison with other designs.

...

(25) Those sectors of industry producing large numbers of possibly short-lived designs over short periods of time of which only some may be eventually commercialised will find advantage in the unregistered Community design. Furthermore, there is also a need for these sectors to have easier recourse to the registered Community design. Therefore, the option of combining a number of designs in one multiple application would satisfy that need. However, the designs contained in a multiple application may be dealt with independently of each other for the purposes of enforcement of rights, licensing, rights *in rem*, levy of execution, insolvency proceedings, surrender, renewal, assignment, deferred publication or declaration of invalidity.'

6. Under Article 1 of Regulation No 6/2002:

'1. A design which complies with the conditions contained in this regulation is hereinafter referred to as a "Community design".

2. A design shall be protected:

- (a) by an “unregistered Community design”, if made available to the public in the manner provided for in this Regulation;

...’

7. According to Article 4(1) of Regulation No 6/2002, a design is to be protected by a Community design to the extent that it is new and has individual character.

8. Article 5 of that regulation provides:

‘1. A design shall be considered to be new if no identical design has been made available to the public:

- (a) in the case of an unregistered Community design, before the date on which the design for which protection is claimed has first been made available to the public;
- (b) in the case of a registered Community design, before the date of filing of the application for registration of the design for which protection is claimed, or, if priority is claimed, the date of priority.

2. Designs shall be deemed to be identical if their features differ only in immaterial details.’

9. Article 6 of the regulation provides:

‘1. A design shall be considered to have 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:

- (a) in the case of an unregistered Community design, before the date on which the design for which protection is claimed has first been made available to the public;
- (b) in the case of a registered Community design, before the date of filing the application for registration or, if a priority is claimed, the date of priority.

2. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.’

10. Article 11 of the regulation is worded as follows:

‘1. A design which meets the requirements under Section 1 shall be protected by an unregistered Community design for a period of three years as from the date on which the design was first made available to the public within the Community.

2. For the purpose of paragraph 1, a design shall be deemed to have been made available to the public within the Community if it has been published, exhibited, used in trade or otherwise disclosed in such a way that, in the normal course of business, these events could reasonably have become known to the circles specialised in the sector concerned, operating within the Community. A design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.’

11. Under Article 19 of the regulation:

‘1. A registered Community design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. The aforementioned use shall cover, in particular, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.

2. An unregistered Community design shall, however, confer on its holder the right to prevent the acts referred to in paragraph 1 only if the contested use results from copying the protected design.

The contested use shall not be deemed to result from copying the protected design if it results from an independent work of creation by a designer who may be reasonably thought not to be familiar with the design made available to the public by the holder.

...’

12. Finally, Article 85 of the regulation, ‘Presumption of validity — defence as to the merits’, states:

‘1. In proceedings in respect of an infringement action or an action for threatened infringement of a registered Community design, the Community design court shall treat the Community design as valid. Validity may be challenged only with a counterclaim for a declaration of invalidity. However, a plea relating to the invalidity of a Community design, submitted otherwise than by way of counterclaim, shall be admissible in so far as the defendant claims that the Community design could be declared invalid on account of an earlier national design right, within the meaning of Article 25(1)(d), belonging to him.

2. In proceedings in respect of an infringement action or an action for threatened infringement of an unregistered Community design, the Community design court shall treat the Community design as valid if the right holder produces proof that the conditions laid down in Article 11 have been met and indicates what constitutes the individual character of his Community design. However, the defendant may contest its validity by way of a plea or with a counterclaim for a declaration of invalidity.’

II – Facts of the dispute in the main proceedings

13. KMF is a company incorporated under the law of England and Wales which carries on the business of producing and selling women’s clothing.

14. Dunnes is a substantial retailing group in Ireland which, among other things, sells women’s clothing.

15. In 2005 KMF designed and placed on sale in Ireland a striped shirt (in a blue and a stone brown version) and a black knit top (‘the KMF garments’).

16. Examples of the KMF garments were purchased by representatives of Dunnes from one of KMF’s Irish outlets. Dunnes subsequently had copies of the garments manufactured outside Ireland and put them on sale in its Irish stores in late 2006.

17. Asserting itself to be the holder of unregistered Community designs relating to the garments, on 2 January 2007, KMF commenced proceedings in the High Court in which it claimed, inter alia, injunctions restraining Dunnes from using the designs, and damages.

18. The High Court upheld that action.

19. Dunnes brought an appeal against the judgment of the High Court before the referring court.
20. That court states that Dunnes does not dispute that it copied the KMF garments and acknowledges that the unregistered Community designs of which KMF claims to be the holder are new designs.
21. However, it is clear from the order for reference that Dunnes disputes that KMF is the holder of an unregistered Community design for each of the KMF garments on the grounds, first, that the garments do not have individual character within the meaning of Regulation No 6/2002 and, secondly, that that regulation requires KMF to prove, as a matter of fact, that the garments have individual character.
22. It was in those circumstances that the Supreme Court decided to stay the proceedings and to refer two questions to the Court for a preliminary ruling.

III – The request for a preliminary ruling and the procedure before the Court

23. By decision of 6 June 2013, received at the Court on 24 June 2013, the Supreme Court therefore stayed the proceedings and referred the following questions to the Court of Justice for a preliminary ruling pursuant to Article 267 TFEU:

- ‘1. In consideration of the individual character of a design which is claimed to be entitled to be protected as an unregistered Community design for the purposes of [Regulation No 6/2002], is the overall impression it produces on the informed user, within the meaning of Article 6 of that regulation, to be considered by reference to whether it differs from the overall impression produced on such a user by:
- (a) any individual design which has previously been made available to the public, or
 - (b) any combination of known design features from more than one such earlier design?
2. Is a Community design court obliged to treat an unregistered Community design as valid for the purposes of Article 85(2) of [Regulation No 6/2002] where the right holder merely indicates what constitutes the individual character of the design or is the right holder obliged to prove that the design has individual character in accordance with Article 6 of that regulation?’

24. KMF, Dunnes, the United Kingdom Government and the European Commission have all submitted written observations.

25. On conclusion of the written part of the procedure, the Court considered that it had sufficient information to rule without holding a hearing (in accordance with Article 76(2) of the Rules of Procedure of the Court of Justice).

IV – Analysis

A – The first question

26. By its first question, the national court asks, in substance, whether Article 6 of Regulation No 6/2002 is to be interpreted as meaning that, in order for a design to be regarded as having individual character, the overall impression which that design produces on the informed user must be different from that produced on such a user by an earlier design taken individually, or by a combination of features drawn from several designs that have previously been made available to the public.

27. As Dunnes summarises it in its written observations, in a situation where there are, for example, three earlier designs (X, Y and Z), the question is intended to establish whether the design at issue has individual character in that the overall impression which it produces on an informed user is different from the overall impression produced by the earlier designs X, Y and Z taken separately, or does not have individual character because certain features of X, Y and Z (such as a stripe or a stitch or a combination of colours) taken together create an overall impression that is not different from that created by the design at issue.

28. Dunnes alone supports the latter interpretation. KMF, the United Kingdom Government and the Commission take the view that it is the former interpretation that must be accepted.

29. In support of its assertion, Dunnes relies on recitals 14 and 19 in the preamble to Regulation No 6/2002 and on Article 25 of the TRIPs Agreement.

30. It is true that, according to recital 14, '[t]he 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 clearly differs from that produced on him by the existing design *corpus*'.⁴

31. Moreover, it is not irrelevant that the approach to individual character reflected in this formulation is similar to that endorsed by Article 25 of the TRIPs Agreement, which stipulates that the parties to the agreement 'may provide that designs are not new or original if they do not significantly differ from known designs *or combinations of known design features*'.⁵

32. Nevertheless, those two factors cannot be decisive for the interpretation of Article 6 of Regulation No 6/2002.

33. First of all, although recital 14 in the preamble to the regulation refers to the 'existing design corpus', it must be observed that that concept is not then used in the provisions of the regulation.

34. In so far as recital 19 in the preamble to that regulation is concerned, that merely states that '[a] Community design should not be upheld unless the design is new and unless it also possesses an individual character in comparison with other designs'. I therefore fail to see how that could suggest the notion of a comparison between the design at issue and an assortment of features from a number of other designs.

35. On the contrary, while recital 19 does refer to several designs in stating that a design should not be upheld unless it 'is new and unless it also possesses an individual character *in comparison with other designs*',⁶ that reference seems to me to imply a comparison with other individual designs and the overall impression they each create, rather than with a number of specific or isolated features taken from several other designs.

36. Secondly, the only obligation imposed by Article 25 of the TRIPs Agreement is to provide for a system of protection of independently created industrial designs that are new or original. That obligation flows from the use of the verb form 'shall provide'.

37. In so far as Article 25 then goes on to mention 'combinations of known design features', that merely sets out an *option* which is left to the discretion of the parties to the agreement.⁷

4 — My emphasis.

5 — My emphasis.

6 — My emphasis.

7 — Regarding Article 25, G. Tritton has written: '[a]s emphasised above, the first sentence of the Article is mandatory whereas the second and third sentences are optional. ... The effect of the above is that Member States are permitted a considerable degree of latitude as to requirements for protection of industrial designs' (Tritton, G., *Intellectual Property in Europe*, 3rd edition., Sweet & Maxwell, London, 2008, No 5-006).

38. Aside from those considerations, the wording of Article 6 of Regulation No 6/2002 seems to me in any event to require the identification of one or more earlier designs that may be compared with the design at issue.

39. Irrespective of the language version considered, the individual character of the design at issue must be compared with a single other design (in the German version, for example),⁸ several designs (in the Dutch version, for example),⁹ or a potential body of designs (in the Spanish,¹⁰ English,¹¹ French¹² and Italian¹³ versions).

40. None of these versions, however, seems to me to permit the abstraction of certain specific features from one or more earlier designs in order to create a theoretical object of comparison, that is to say, something that does not actually exist in real life.

41. As I suggested earlier in connection with recital 19 in the preamble to Regulation No 6/2002, while certain language versions of Article 6 (which the Commission classifies as ‘neutral’) convey the notion of a comparison with a *body* of designs, that reference seems to me to imply a comparison with precisely defined objects.

42. There is nothing in the wording of that provision which appears to me to authorise the creation, *a posteriori* and solely to meet the requirements of the particular case, of an amalgam of certain specific features of previously identified designs.

43. I concur with the interpretation suggested by KMF, the United Kingdom Government and the Commission that, in order for a design to be regarded as having individual character, the overall impression which that design produces on the informed user must be different from that produced on such a user by one or more earlier designs taken individually, rather than by a combination of features drawn from several designs previously made available to the public.

44. That interpretation seems to me also to accord with the approach adopted by the Court in the case-law on establishing the individual character of a design.

45. On at least two occasions, the Court has held that ‘where possible, [the informed user] will make a direct comparison between the designs at issue’.¹⁴

46. Admittedly, the Court was careful to state that it could not 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’.¹⁵

8 — ‘Ein Geschmacksmuster hat Eigenart, wenn sich der Gesamteindruck, den es beim informierten Benutzer hervorruft, von dem Gesamteindruck unterscheidet, den ein anderes Geschmacksmuster bei diesem Benutzer hervorruft, das der Öffentlichkeit zugänglich gemacht worden ist, und zwar’. My emphasis.

9 — ‘[D]e algemene indruk die bij die gebruiker wordt gewekt door modellen die voor het publiek beschikbaar zijn gesteld’. My emphasis.

10 — ‘[L]a impresión general producida por cualquier otro dibujo o modelo que haya sido hecho público’. My emphasis.

11 — ‘[T]he overall impression produced on such a user by any design which has been made available to the public’. My emphasis.

12 — ‘[L]’impression globale qu’il produit sur l’utilisateur averti diffère de celle que produit sur un tel utilisateur tout dessin ou modèle qui a été divulgué au public’. My emphasis.

13 — ‘[I]mpressione generale suscitata in tale utilizzatore da qualsiasi disegno o modello che sia stato divulgato al pubblico’. My emphasis.

14 — C-281/10 P *PepsiCo v Grupo Promer Mon Graphic*, EU:C:2011:679, paragraph 55. See also, to that effect, C-101/11 P and C-102/11 P *Neuman and Others v José Manuel Baena Grupo*, EU:C:2012:641, paragraph 54.

15 — *PepsiCo v Grupo Promer Mon Graphic*, EU:C:2011:679, paragraph 55. See also, to that effect, *Neuman and Others v José Manuel Baena Grupo*, EU:C:2012:641, paragraph 54.

47. It also added that the EU legislature could not be regarded as having intended to limit the assessment of potential designs to a direct comparison between designs, in the absence of any precise indication to that effect in Regulation No 6/2002.¹⁶

48. However, it is clear from the case-law in question that, whilst an indirect comparison may be based on a *recollection* of given designs, it may not, in any event, be based on an amalgam of various features from several different designs.

49. As Advocate-General Mengozzi explained in point 49 of his Opinion in *PepsiCo v Grupo Promer Mon Graphic*, ‘the regulation is silent on [the type of comparison which the informed user may make between the designs at issue]. Accordingly, the comparison could, in principle, be either an indirect comparison, *based on recollection*, as generally happens in the field of trade marks, or a direct comparison made by viewing the goods side by side.’¹⁷

50. The Court adopted the same approach, holding, first, that the General Court of the European Union had not made an error, even if its ‘formulation ... that “similarity would not be remembered by the informed user in the overall impression of the designs at issue” might indicate, when taken out of context, that the General Court [had] based its reasoning on an indirect method of comparison based on an imperfect recollection’¹⁸ and, secondly, that ‘the General Court [had] not [erred] in law by basing its reasoning ... on the informed user’s imperfect recollection of the overall impression produced by the two silhouettes’.¹⁹

51. Consequently, given that the indirect nature of the comparison refers not to any amalgam of various features from several designs but to the physical absence of the object of comparison, a direct comparison will, *a fortiori*, imply the comparison of two designs that are each viewed as a whole.

52. As the General Court correctly summarised in *Shenzhen Taiden v OHIM — Bosch Security Systems (Communication equipment)*,²⁰ ‘[s]ince Article 6(1) of Regulation No 6/2002 refers to a difference between the overall impressions produced by the designs at issue, the individual character of a Community design cannot be examined in the light of specific features of various earlier designs’. On the contrary, ‘a comparison should be made between, on the one hand, the overall impression produced by the contested Community design and, on the other, the overall impression produced by each of the earlier designs legitimately relied on by the party seeking a declaration of invalidity’.²¹

53. In light of those considerations, I am of the opinion that Article 6 of Regulation No 6/2002 must be interpreted as meaning that, in order for a design to be regarded as having individual character, the overall impression which that design produces on the informed user must be different from that produced on such a user by one or more earlier designs taken individually and viewed as a whole, not by an amalgam of various features of earlier designs.

16 — *PepsiCo v Grupo Promer Mon Graphic*, EU:C:2011:679, paragraph 57, and *Neuman and Others v José Manuel Baena Grupo*, EU:C:2012:641, paragraph 56.

17 — Opinion in *PepsiCo v Grupo Promer Mon Graphic*, EU:C:2011:302. My emphasis.

18 — *PepsiCo v Grupo Promer Mon Graphic*, EU:C:2011:679, paragraph 58.

19 — *Neuman and Others v José Manuel Baena Grupo*, EU:C:2012:641, paragraph 57.

20 — Case T-153/08, EU:T:2010:248, paragraph 23.

21 — *Shenzhen Taiden v OHIM — Bosch Security Systems (Communications equipment)*, EU:T:2010:248, paragraph 24.

B – *The second question*

54. By its second question, the national court asks whether a Community design court must necessarily treat an unregistered Community design as valid for the purposes of Article 85(2) of Regulation No 6/2002 where the right holder merely indicates what constitutes the individual character of the design or whether, on the contrary, the right holder must prove that the design has individual character in accordance with Article 6 of that regulation.

55. KMF, the United Kingdom Government and the Commission contend that the former view is correct and Dunnes the latter.

56. In order to give the national court a useful answer, it seems to me to be appropriate to examine generally the scope of the presumption of validity established by Article 85(2) of Regulation No 6/2002.

57. Article 85 of the regulation is entitled ‘Presumption of validity — defence as to the merits’. Paragraph 2 of Article 85 provides that ‘[i]n proceedings in respect of an infringement action or an action for threatened infringement of an unregistered Community design, the Community design court shall treat the Community design as valid if the right holder produces proof that the conditions laid down in Article 11 have been met and indicates what constitutes the individual character of his Community design’. It goes on to state that the defendant may contest its validity by way of a plea or with a counterclaim for a declaration of invalidity.

58. It follows from that provision that, in order for a design to be treated as valid, the holder of that design must both produce proof that the conditions laid down in Article 11 of Regulation No 6/2002 have been met and indicate what constitutes the individual character of his design.

1. Proof that the conditions laid down in Article 11 of Regulation No 6/2002 have been met

59. Under Article 11(1) of the regulation, ‘[a] design which meets the requirements under Section 1 shall be protected by an unregistered Community design for a period of three years as from the date on which the design was first made available to the public within the Community’.

60. That requirement of having been made available to the public is further specified in Article 11(2), according to which ‘a design shall be deemed to have been made available to the public within the Community if it has been published, exhibited, used in trade or otherwise disclosed in such a way that, in the normal course of business, these events could reasonably have become known to the circles specialised in the sector concerned, operating within the Community. A design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.’

61. In order to benefit from the presumption of validity established by Article 85(2) of Regulation No 6/2002, therefore, the holder of the design at issue must first of all prove the first disclosure of the design to the public within the European Union, which must not have taken place more than three years earlier, otherwise the design will no longer be protected.

62. According to Dunnes, since Article 11 of Regulation No 6/2002 refers to the requirements under Section 1 of that regulation, the holder of the design at issue must also, in his infringement action or action for threatened infringement, prove that the design which he alleges to be protected is new and individual in character, those requirements being laid down in Article 4 of the regulation, which falls within Section 1.

63. Such an interpretation seems to me to be contrary to the wording of Article 85(2) of Regulation No 6/2002 and the objective pursued by the legislature.

64. First, if the holder of an unregistered Community design were required to prove not only the date of first disclosure but also that the design is new and individual in character, what would be the point of the second requirement laid down at the end of the first sentence of Article 85(2) of Regulation No 6/2002, which is that the holder of the design must '[indicate] what constitutes the individual character of his Community design'?

65. Moreover, as the Commission pertinently remarked in its written observations, if the Court were to adopt Dunnes' interpretation, the holder of an unregistered Community design would be required to prove not only that the design is new and individual in character, but also that all the other requirements under Section 1 of Regulation No 6/2002 (the visibility required by Article 4(2), the non-functional nature of the design referred to in Article 8, or the design's consistency with public policy and morality as provided for in Article 9) have also been met.

66. Such a burden of proof would, without question, not be consistent with the objective pursued by the legislature.

67. As is stated in recital 16 in the preamble to Regulation No 6/2002, '[s]ome ... sectors produce large numbers of designs for products frequently having a short market life where protection without the burden of registration formalities is an advantage and the duration of protection is of lesser significance. On the other hand, there are sectors of industry which value the advantages of registration for the greater legal certainty it provides and which require the possibility of a longer term of protection corresponding to the foreseeable market life of their products.' It is the difference between those two situations which, as stated in recital 17, justifies the two forms of protection provided for in the regulation, 'one being a short-term unregistered design and the other being a longer term registered design'.

68. Consequently, it would appear to me to be contrary to the objectives of simplicity and speed which underlie the protection of unregistered Community designs to impose on the holder of an unregistered design who wishes to bring an action for infringement or threatened infringement a burden of proof that is not imposed on the holder of a registered Community design and which would go beyond the need to identify the design at issue.

69. The difference in treatment between those two classes of right holder which is brought about by Article 85 of Regulation No 6/2002 is, in fact, solely explained by the need to determine the object of protection and the date from which it might be protected.

70. While that information is easy to ascertain in the case of a registered design, as a direct consequence of the formality of registration, it is necessarily not so for an unregistered design. That explains why Article 85(1) of Regulation No 6/2002, unlike Article 85(2), attaches no condition to the presumption of the validity of a registered Community design.

71. Secondly, imposing on the holder of an unregistered Community design, in an action for infringement or threatened infringement, the burden of proving all the elements which constitute an unregistered Community design would conflict with the legislature's decision to deal with the matter in a single provision entitled '*Presumption of validity* — defence as to the merits'.²² Such a requirement of proof would be incompatible with the very notion of presumption.

22 — My emphasis.

72. Thirdly, that interpretation would also render the option allowed the defendant by Article 85(2) of Regulation No 6/2002 of contesting validity by way of a plea or with a counterclaim for a declaration of invalidity largely meaningless.

73. If an applicant were required to prove that the unregistered design of which he claims to be the holder is new and of individual character he would, in effect, be under an obligation to prove its validity. As a result, the defendant would no longer necessarily need to make a counterclaim for a declaration of invalidity (or contest validity by way of a plea) in order to dispute the validity of the unregistered design in question. He could, if he wished, merely take issue, in his defence, with the evidence put forward by the applicant in support of his action.

74. I would add in conclusion that, while not being very extensive on the issue, legal theory adopts the interpretation according to which the burden of proof on the holder of an unregistered Community design in an action for infringement or threatened infringement is limited to proving the disclosure of his design.²³

2. The holder of an unregistered Community design must indicate what constitutes the individual character of his design

75. The wording of the second condition laid down in Article 85(2) of Regulation No 6/2002 in order for an unregistered Community design to benefit from the presumption of validity is, in my view, unambiguous.

76. Under the first condition, the legislature requires ‘the right holder [to produce] proof that the conditions laid down in Article 11 have been met’. Under the second condition, it merely requires the right holder to ‘[indicate] what constitutes the individual character of his Community design’.

77. The stringency of the requirement must be different, otherwise there would have been no need to use a different verb after the conjunction ‘and’.

78. As the Commission pertinently explained in its written observations, by indicating what constitutes the individual character of his design, an applicant specifies the object of the protection which he is claiming. By doing so, he defines the scope of the comparison with the contested design and enables the defendant, if he so wishes, to prepare a suitably specific counterclaim for a declaration of invalidity. That difference in treatment, compared to the holder of a registered Community design, is once again explained by the absence of the formality of registration.

79. Moreover, the *travaux préparatoires* confirm that the difference between the requirement to produce proof of disclosure, on the one hand, and the mere indication of the individual character of an unregistered Community design, on the other, is not fortuitous.

23 — See, in particular, Stone, D., *European Union Design Law — A Practitioners’ Guide*, Oxford University Press, 2012, nos 18.18 and 18.25; Saez, V. M., ‘The unregistered Community design’, *European Intellectual Property Review*, 2002, vol. 24, no 12, pp. 585 to 590, especially p. 589; Otero Lastres, J. M., ‘Concepto de diseño y requisitos de protección en la nueva ley 20/2003’, in *Actas de derecho industrial y derecho de autor*, Tomo XXIV, Instituto de derecho industrial (Universidad de Santiago de Compostela), Madrid — Barcelona, 2004, pp. 54 to 90, especially p. 90; Llobregat Hurtado, M.-L., ‘Régimen jurídico de los dibujos y modelos registrados y no registrados en el Reglamento 6/2002 del Consejo, del 12 de diciembre de 2001, sobre dibujos et modelos comunitarios’, in *La marca comunitaria, modelos y dibujos comunitarios. Análisis de la implantación el Tribunal de marcas de Alicante, Estudios de Derecho Judicial*, no 68, Madrid, 2005, pp. 119 to 198, especially pp. 172 and 176.

80. While Article 89 of the Commission's amended proposal for a Council Regulation (EC) on Community Design provides that the presumption should apply 'if the right holder *presents evidence* to sustain his claim that the design has an individual character,²⁴ the European Parliament proposed that the right holder should '*establish in detail* that the design has an individual character'.²⁵

81. While that wording was retained by the Commission in some language versions of its new amended proposal for a Council Regulation on Community Design,²⁶ the text finally adopted merely provided for an indication of the elements which give the design an individual character.

82. For those reasons, it seems to me that to require the holder of an unregistered Community design to produce proof of the individual character of his design would run counter to the development of the legislative intention as it may be inferred from the preparatory work and from the changes made to the text during the legislative process.

83. Consequently, I am of the opinion that a Community design court must necessarily treat an unregistered Community design as valid, for the purposes of Article 85(2) of Regulation No 6/2002, if the holder both proves when his design was first made available to the public and indicates the elements of his design which give it individual character.²⁷

V – Conclusion

84. In light of all the foregoing considerations, I propose that the Court of Justice answer the questions referred for a preliminary ruling by the Supreme Court as follows:

- (1) Article 6 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs is to be interpreted as meaning that, in order for a design to be considered to have individual character, the overall impression which that design produces on the informed user must be different from that produced on such a user by one or more earlier designs taken individually and viewed as a whole, not by an amalgam of various features of earlier designs.
- (2) In order for a Community design court to treat an unregistered Community design as valid, for the purposes of Article 85(2) of Regulation No 6/2002, the right holder need only prove when his design was first made available to the public and indicate the element or elements of his design which give it individual character.

24 — COM/1999/310/final, OJ 2000 C 248 E, p. 3. My emphasis.

25 — Amendment 18 of the Parliament, OJ 2001 C 67, p. 340. Emphasis in the original document.

26 — See, to that effect, the French version, OJ 2001 C 62 E, p. 173.

27 — See, to that effect, Stone, D., *op. cit.*, nos 18.23 and 18.25.