



Reports of Cases

Case T-326/20

(publication in extract form)

Bibita Group

v

European Union Intellectual Property Office

Judgment of the General Court (Fifth Chamber), 21 April 2021

(Community design – Invalidation proceedings – Registered Community design representing a beverage bottle – Prior international design – Ground for invalidity – Conflict with a prior design – Individual character – Informed user – Degree of freedom of the designer – Different overall impression – Article 6 and Article 25(1)(d)(iii) of Regulation (EC) No 6/2002)

- 1. Community designs – Grounds for invalidity – Conflict with a prior design – Concept – Design not producing on the informed user a different overall impression from that produced by the prior design*
(Council Regulation No 6/2002, recital 14, Art. 6 and Art. 25(1)(b) and (d))

(see paragraphs 30-32, 36, 37, 40)
- 2. Community designs – Grounds for invalidity – Conflict with a prior design – Design not producing on the informed user a different overall impression from that produced by the prior design – Criteria for assessment – Freedom of the designer*
(Council Regulation No 6/2002, Art. 6 and Art. 25(1)(d))

(see paragraphs 41, 53, 54)
- 3. Community designs – Grounds for invalidity – Conflict with a prior design – Design not producing on the informed user a different overall impression from that produced by the prior design – Representation of a beverage bottle*
(Council Regulation No 6/2002, Art. 6(1) and Art. 25(1)(d))

(see paragraphs 33, 49, 58, 64-71)
- 4. Community designs – Grounds for invalidity – Conflict with a prior design – Design not producing on the informed user a different overall impression from that produced by the prior design – Overall assessment of all the elements of the prior design*
(Council Regulation No 6/2002, Art. 6(1) and Art. 25(1)(d))

(see paragraphs 42, 61-63)

5. *Community designs – Grounds for invalidity – Conflict with a prior design – Design not producing on the informed user a different overall impression from that produced by the prior design – Informed user – Concept*
(Council Regulation No 6/2002, Art. 6(1) and Art. 25(1)(d))

(see paragraphs 45, 46)

Résumé

On 13 March 2017, Benkomers OOD filed an application for registration of a Community design representing a beverage bottle with the European Union Intellectual Property Office (EUIPO). Following registration of the design, the applicant, Bibita Group, filed an application for a declaration of invalidity of that design, in support of which it relied on Article 25(1)(d)(iii) of Regulation No 6/2002.¹ Bibita Group submitted that, since, in the context of Article 25(1)(d)(iii) of Regulation No 6/2002, the same criteria as for the assessment of individual character under Article 25(1)(b), read in conjunction with Article 6 of that regulation, should be applied, the contested design lacked individual character in relation to the design of which it was the holder, which had been protected from a date prior to the application for registration of the contested design. The application for a declaration of invalidity was rejected by the Invalidity Division and the Board of Appeal of EUIPO dismissed the appeal.

The Court dismisses the action brought by Bibita Group against the decision of the Board of Appeal and clarifies the concept of ‘conflict’ within the meaning of Article 25(1)(d) of Regulation No 6/2002.

Findings of the Court

First of all, the Court recalls that, according to settled case-law, Article 25(1)(d) of Regulation No 6/2002 must be interpreted as meaning that a Community design is in conflict with a prior design when, taking into consideration the freedom of the designer in developing the Community design, that design does not produce on the informed user a different overall impression from that produced by the prior design relied on.

Next, as regards the argument that the prior design enjoyed particularly broad protection, the Court states that, despite the reference in recital 14 of Regulation No 6/2002 to the existence of a ‘clear’ difference between the overall impressions produced by the designs at issue, the wording of Article 6 of that regulation is clear and unambiguous. Thus, a design is eligible for the protection afforded by the Community design if it produces on the informed user a different overall impression from that produced by a prior design.

¹ In accordance with Article 25(1)(d)(iii) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1), as amended, a Community design may be declared invalid if it is in conflict with a prior design which has been made available to the public after the date of filing of the application or, if priority is claimed, the date of priority of the Community design, and which is protected from a date prior to the said date by a design right registered under the Geneva Act of the Hague Agreement concerning the international registration of industrial designs, adopted in Geneva on 2 July 1999, which was approved by Council Decision 2006/954/EC of 18 December 2006 (OJ 2006 L 386, p. 28), and which has effect in the Community, or by an application for such a right.

Furthermore, the Court points out that, even if it were established that, at the date of its registration, the shape of the prior design would have been entirely new in the industrial sector concerned, the uniqueness of such a shape does not confer on the prior design broader protection than that which it enjoys under Regulation No 6/2002. Moreover, the allegedly unprecedented character or originality of the appearance of the prior design has no influence on the assessment of the individual character of the contested design.

Lastly, after recalling the criteria for assessing the individual character of a Community design, the Court carries out an assessment of the overall impression produced by the designs at issue on the informed user. It points out that the assessment to be made in that regard involves taking into account all the elements that distinguish the designs at issue, other than those which remain insufficiently significant to affect that overall impression. The designs at issue have significant differences.

Consequently, the Court holds that the Board of Appeal was correct in concluding that the contested design was not in conflict with the prior design within the meaning of Article 25(1)(d)(iii) of Regulation No 6/2002.