



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Sixth Chamber)

24 September 2019*

(Community design – Invalidity proceedings – Registered Community design representing a moped – Earlier Community design – Ground for invalidity – Individual character – Different overall impression – Informed user – Article 6 and Article 25(1)(b) of Regulation (EC) No 6/2002 – Interpretation of Article 6 of Regulation No 6/2002 in conformity with EU law – No use of an unregistered earlier national three-dimensional mark in the registered design – Article 25(1)(e) of Regulation No 6/2002 – No unauthorised use of a work protected under the copyright law of a Member State in the registered design – Article 25(1)(f) of Regulation No 6/2002)

In Case T-219/18,

Piaggio & C. SpA, established in Pontedera (Italy), represented by F. Jacobacci, B. La Tella and B. Lucchetti, lawyers,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by L. Rampini and J. Crespo Carrillo, acting as Agents,

defendant,

the other party to the proceedings before the Board of Appeal of EUIPO, intervener before the General Court, being

Zhejiang Zhongneng Industry Group Co. Ltd, established in Taizhou (China), represented by M. Spolidoro, M. Gurrado, S. Vereá and M. Balestrieri, lawyers,

ACTION brought against the decision of the Third Board of Appeal of EUIPO of 19 January 2018 (Case R 1496/2015-3), relating to invalidity proceedings between Piaggio & C. and Zhejiang Zhongneng Industry Group,

THE GENERAL COURT (Sixth Chamber),

composed of G. Berardis, President, S. Papasavvas and O. Spineanu-Matei (Rapporteur), Judges,

Registrar: E. Hendrix, Administrator,

having regard to the application lodged at the Registry of the General Court on 30 March 2018,

having regard to the response of EUIPO lodged at the Court Registry on 9 July 2018,

* Language of the case: Italian.

having regard to the response of the intervener lodged at the Court Registry on 9 July 2018,
further to the hearing on 27 February 2019,
having regard to the order of 30 April 2019 reopening the oral part of the procedure,
having regard to the Court's written question to the parties and their responses to that question lodged at the Court Registry on 16 and 17 May 2019,
having regard to the decision of 20 May 2019 closing the oral part of the procedure,
gives the following

Judgment

Background to the dispute

- 1 On 19 November 2010 the intervener, Zhejiang Zhongneng Industry Group Co. Ltd, filed an application for registration of a Community design with the European Union Intellectual Property Office (EUIPO), pursuant to Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1).
- 2 The design in respect of which registration was sought is represented as follows in the six views below:



- 3 In accordance with Articles 41 to 43 of Regulation No 6/2002, the intervener invoked, in its application for registration, a right of priority for the contested design, based on an earlier application for registration of the same design, filed with the competent Chinese authority on 13 July 2010.
- 4 The goods into which the contested design is intended to be incorporated are in Class 12-11 of the Locarno Agreement Establishing an International Classification for Industrial Designs of 8 October 1968, as amended, and correspond to the following description: 'Mopeds; motorcycles'.

- 5 The design application was published in *Community Designs Bulletin* No 2010/265 of 23 November 2010. The design was registered under No 1783655-0002, with a registration date of 19 November 2010 and priority from 13 July 2010.
- 6 On 6 November 2014 the applicant, Piaggio & C. SpA, filed an application with EUIPO for a declaration of invalidity in respect of the contested design, pursuant to Article 52 of Regulation No 6/2002, for the goods referred to in paragraph 4 above.
- 7 The grounds relied on in support of the application for a declaration of invalidity were those referred to in Article 25(1)(b), (e) and (f) of Regulation No 6/2002.
- 8 In the first place, with regard to the ground for invalidity referred to in Article 25(1)(b) of Regulation No 6/2002, the applicant argued, in its application for a declaration of invalidity, that the contested design lacked novelty and individual character for the purposes of Articles 5 and 6 of that regulation. In support of its claims, the applicant chose the earlier design marketed under the name Vespa LX ('the earlier design'), the disclosure of which it demonstrated using the images which appeared in the specialist magazines *Motociclismo* of May 2005, *In sella* of April 2005 and *City-X* of June 2009. Those images and the information which accompanied them are reproduced below:



- 9 According to the applicant, the contested design was substantially identical to the earlier design and produced the same overall impression as that design, which ruled out its being new and having individual character for the purposes of Articles 5 and 6 of Regulation No 6/2002.
- 10 In the second place, with regard to the ground for invalidity referred to in Article 25(1)(e) of Regulation No 6/2002, the applicant argued that the scooter shape into which the earlier design was intended to be incorporated was also protected, by Italian law, as an unregistered three-dimensional 'de facto mark', used in Italy since 2005 ('the earlier mark'). According to the applicant, that trade mark has become highly distinctive through use, inasmuch as the distinctive features of the

three-dimensional scooter shape which it protects have remained substantially the same since the creation and first marketing of the Vespa scooter by the applicant, both of which date back to 1945 and 1946. According to the applicant, the distinctive features in question are as follows:

- the ‘X’ shape between the rear fairing and the under-seat assembly, illustrated below:



- the inverted ‘Ω’ shape between the under-seat assembly and the front shield, illustrated below:



- the arrow shape of the front shield, illustrated below:



- 11 The applicant maintained that it had provided evidence of the well-known use of the earlier mark and of the likelihood of confusion on the part of the relevant public with the earlier mark created by the contested design.
- 12 In the third place, with regard to the ground for invalidity referred to in Article 25(1)(f) of Regulation No 6/2002, the applicant argued that the earlier design was protected by Italian and French copyright. According to the applicant, the earlier design, as an intellectual work, was unfairly used in the contested design.
- 13 By decision of 23 June 2015, the Invalidity Division recognised that the contested design was new for the purposes of Article 25(1)(b) of Regulation No 6/2002, read in conjunction with Article 5 of that regulation. Relying on the earlier design, it nevertheless granted the application for a declaration of invalidity in respect of the contested design, on the ground that that design lacked individual character for the purposes of Article 25(1)(b) of Regulation No 6/2002, read in conjunction with Article 6 of that regulation. Since it concluded that the contested design was invalid due to the failure to satisfy that condition required by Regulation No 6/2002 for its protection, the Invalidity Division took the view that it was not necessary to examine the other grounds for invalidity relied on by the applicant, namely those referred to in Article 25(1)(e) and (f) of that regulation.

- 14 On 27 July 2015 the intervener filed a notice of appeal with EUIPO, pursuant to Articles 55 to 60 of Regulation No 6/2002, against the Invalidity Division's decision.
- 15 By decision of 19 January 2018 ('the contested decision'), the Third Board of Appeal of EUIPO upheld the intervener's appeal, annulled the Invalidity Division's decision and rejected the application for a declaration of invalidity. In essence, first of all, it took the view that the differences between the designs at issue were sufficient to preclude a finding that the contested design lacked novelty in view of the earlier design for the purposes of Article 25(1)(b) of Regulation No 6/2002, read in conjunction with Article 5 of that regulation. Next, unlike the Invalidity Division, it concluded that the contested design did not lack individual character for the purposes of Article 25(1)(b) of Regulation No 6/2002, read in conjunction with Article 6 of that regulation. In that regard, the Board of Appeal indicated, first, that the differences between the designs at issue were numerous and sufficiently significant and, second, that the contested design produced a different overall impression on the informed user of that design from that generated by observing the earlier design. Lastly, exercising the powers of the Invalidity Division under Article 60 of Regulation No 6/2002, the Board of Appeal decided on the other two grounds for invalidity relied on by the applicant before the Invalidity Division, namely those referred to in Article 25(1)(e) and (f) of that regulation. Thus, it concluded that the earlier mark was not used in the contested design, due, in particular, to the obvious differences in style between them and the high level of attention of the relevant public of the earlier mark, and that, consequently, the ground for invalidity laid down in Article 25(1)(e) of Regulation No 6/2002 did not apply. In addition, with regard to the ground for invalidity laid down in Article 25(1)(f) of Regulation No 6/2002, the Board of Appeal took the view that a finding that the contested design was invalid as it infringed Italian and French copyright was not justified, inasmuch as the earlier design, as an intellectual work, was not used in the contested design, as their aesthetics and the impressions which emanated from them were different.

Procedure and forms of order sought

- 16 The applicant claims that the Court should:
- annul the contested decision and, consequently, declare the contested design invalid;
 - order EUIPO and the intervener to pay the costs relating to the proceedings before the Board of Appeal, in accordance with Article 190 of the Rules of Procedure of the General Court;
 - order EUIPO and the intervener to pay the entirety of the costs relating to the present proceedings.
- 17 EUIPO contends that the Court should:
- dismiss the action;
 - order the applicant to pay the costs.
- 18 The intervener contends that the Court should:
- dismiss the action;
 - confirm that the contested design is valid;
 - order the applicant to pay the costs.

Law

- 19 As a preliminary point, given that ‘confirm[ing] that the contested design is valid’ is tantamount to dismissing the action, the intervener’s second head of claim must be regarded as seeking, in essence, the dismissal of the action (see, by analogy, judgment of 13 December 2016, *Apax Partners v EUIPO – Apax Partners Midmarket (APAX)*, T-58/16, not published, EU:T:2016:724, paragraph 15).
- 20 In support of the action, the applicant relies on three pleas in law, the first alleging infringement of Article 25(1)(b) of Regulation No 6/2002, read in conjunction with Article 6 of that regulation, the second alleging infringement of Article 25(1)(e) of that regulation, and the third alleging infringement of Article 25(1)(f) of that regulation.

First plea in law, alleging infringement of Article 25(1)(b) of Regulation No 6/2002, read in conjunction with Article 6 of that regulation

- 21 In its first plea in law, the applicant maintains that, in paragraphs 24 to 26 of the contested decision, the Board of Appeal wrongly considered that it had acknowledged that the designs at issue were not completely identical and that the differences between them could not be described as ‘immaterial details’.
- 22 The applicant also argues that the Board of Appeal erred in the interpretation and application of the principles referred to in Article 6 of Regulation No 6/2002, when, in the light of the earlier design, the contested design lacks individual character for the purposes of that provision.
- 23 EUIPO and the intervener contest all the applicant’s arguments.
- 24 It should be borne in mind that Article 25(1)(b) of Regulation No 6/2002 provides that a Community design may be declared invalid only if it does not fulfil the requirements referred to in Articles 4 to 9 of that regulation.
- 25 Under 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.
- 26 Under Article 5 of Regulation No 6/2002, a design is to be considered to be new if no identical design has been made available to the public. Designs are to be deemed to be identical if their features differ only in immaterial details.
- 27 As a preliminary point, it should be noted that the statements set out in paragraphs 24 to 26 of the contested decision were made by the Board of Appeal as part of its examination of the contested design’s alleged lack of novelty for the purposes of Article 25(1)(b) of Regulation No 6/2002, read in conjunction with Article 5 of that regulation. As it confirmed at the hearing, the applicant does not rely, in support of its action, either on infringement of those provisions or on an error made by the Board of Appeal in its assessment of the novelty of the contested design and acknowledges that the designs at issue are not identical. As a result, the applicant cannot effectively contest, as part of the present plea in law, alleging, in particular, infringement of Article 25(1)(b) of Regulation No 6/2002, read in conjunction with Article 6 of that regulation, the Board of Appeal’s assessment, as set out in paragraphs 24 to 26 of the contested decision, of the contested design’s alleged lack of novelty for the purposes of Article 5 of that regulation.
- 28 With regard to the assessment of the individual character of the contested design, in the first place, it should be borne in mind that, according to Article 6(1)(b) of Regulation No 6/2002, a registered Community design is to 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 before the date of filing of the application for registration or, if priority is claimed, before the date of priority.

- 29 The Italian version of Article 6(1) of Regulation No 6/2002 adds that the overall impression which a design must produce for it to be considered to have individual character must differ ‘in modo significativo’ (‘significantly’) from the overall impression produced on an informed user by any design which has been made available to the public.
- 30 It should be noted that it is settled case-law that the need for a uniform interpretation of a provision of EU law means that, where there is divergence between the various language versions of the provision, the latter must be interpreted by reference to the context and purpose of the rules of which it forms part. Additionally, interpreting a provision of EU law involves a comparison of the language versions (see judgment of 23 December 2015, *Firma Theodor Pfister*, C-58/15, not published, EU:C:2015:849, paragraph 25 and the case-law cited).
- 31 Among the acts drawn up as part of the process which led to the adoption of Regulation No 6/2002, the first proposal, submitted by the European Commission, for a European Parliament and Council Regulation on Community design (OJ 1994 C 29, p. 20) included, in all the language versions, the specification ‘significantly’ in Article 6(1) thereof. Following the Opinion of the Economic and Social Committee on the ‘proposal for a European Parliament and Council Regulation on the Community design’ (OJ 1994 C 388, p. 9), which indicated that the term ‘significantly’ would have had the effect of excluding numerous designs, particularly in textiles, from the proposed protection, and which suggested, consequently, that it be deleted, that specification was removed from all the language versions, except the Italian version, of Article 6(1) of the amended proposal, submitted by the Commission, for a Council Regulation (EC) on Community Design (OJ 2000 C 248 E, p. 3). That divergence in the wording of that provision remained, in the Italian version, in the amended proposal for a Council Regulation on Community Design (OJ 2001 C 62 E, p. 173), as finally submitted by the Commission.
- 32 It is apparent, in addition, from a comparative examination of the various existing language versions of Regulation No 6/2002, and in particular Article 6(1) thereof, that, with the exception of the Italian version, all the language versions of that provision state that a registered Community design is to 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.
- 33 In those circumstances, the Court takes the view that the specification ‘significantly’ contained in Article 6(1) of Regulation No 6/2002 in just one of the language versions of that regulation is, clearly, an unfortunate remnant of the legislative process preceding the adoption of that regulation.
- 34 Article 6(1) of Regulation No 6/2002 must, consequently, be read and applied in accordance with (i) its wording, as recalled in paragraph 32 above, resulting from the various language versions of Regulation No 6/2002 currently in existence, with the exception of the Italian version, and (ii) the uniform and independent interpretation of the language version taken into account which case-law has given to that provision.
- 35 To that end, it should be borne in mind that the requirement laid down in Article 6 of Regulation No 6/2002 goes beyond that laid down in Article 5 of that regulation, in that a different overall impression on the informed user within the meaning of Article 6 can be based only on the existence of objective differences between the designs at issue (judgment of 6 June 2013, *Kastenholz v OHIM – Qwatchme (Watch faces)*, T-68/11, EU:T:2013:298, paragraph 39). Thus, account should be taken of

differences that are sufficiently marked so as to produce dissimilar overall impressions (see judgment of 4 July 2017, *Murphy v EUIPO – Nike Innovate (Electronic wristband)*, T-90/16, not published, EU:T:2017:464, paragraph 43 and the case-law cited).

- 36 In the second place, it should be noted that recital 14 of Regulation No 6/2002 indicates, inter alia, that 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.
- 37 In that regard, Article 28(1)(b)(v) of Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Regulation No 6/2002 (OJ 2002 L 341, p. 28) specifies that, where the ground for invalidity is that the registered Community design does not meet the requirements set out in, inter alia, Article 6 of Regulation No 6/2002, the application for a declaration of invalidity must contain an indication and a reproduction of the prior designs that could form an obstacle to the individual character of the registered Community design, as well as documents proving the existence of those earlier designs.
- 38 As it confirmed at the hearing, in support of the present plea in law, the applicant chose, over any previous presence in the existing design corpus to which recital 14 of Regulation No 6/2002 refers, the earlier design, inasmuch as it includes the features illustrated in paragraph 10 above, of which it provided reproductions proving its existence and its disclosure.
- 39 In the third place, it should be borne in mind that Article 6(2) of Regulation No 6/2002 specifies that, in assessing the individual character of a design, the degree of freedom of the designer in developing that design is to be taken into consideration.
- 40 It is in the light of those considerations that it is necessary to assess whether the contested design lacks individual character for the purposes of Article 6 of Regulation No 6/2002 in relation to the earlier design.

Informed user of the contested design and degree of freedom of the designer

- 41 In the present case, first of all, the Board of Appeal indicated, in paragraphs 30 to 32 of the contested decision, that the relevant sector in relation to which the informed user of the contested design was to be identified was that of ‘scooters’, as a subcategory of the category ‘Mopeds; motorcycles’.
- 42 Contrary to the intervener’s assertions, according to which the relevant sector is the ‘classic scooters’ subcategory, it must be confirmed that the relevant sector is that, selected by the Board of Appeal and not contested by the applicant, of ‘scooters’. That sector takes account of the indication, as contained in the application for registration, of ‘Mopeds; motorcycles’ as the goods into which the contested design is intended to be incorporated, but also of the contested design itself, in so far as that design enables ‘scooters’ to be identified within the broader category of goods indicated at the time of registration and, therefore, makes it possible to determine the informed user and the degree of freedom of the designer in developing the contested design (see, to that effect, judgment of 18 March 2010, *Grupo Promer Mon Graphic v OHIM – PepsiCo (Representation of a circular promotional item)*, T-9/07, EU:T:2010:96, paragraph 56).
- 43 Next, the Board of Appeal indicated, in paragraphs 33 to 35 of the contested decision, that the informed user of the contested design was the person who used a scooter for his own transport, who was familiar with the various scooter designs on the market and who had a certain degree of knowledge of the components normally included in those products. It added that, because of his

interest in the vehicles in question, that person could be understood as a user who was both particularly observant and particularly attentive and sensitive to the design and aesthetics of the goods concerned.

- 44 With regard to the degree of freedom of the designer of the contested design, the Board of Appeal indicated, in paragraphs 36 to 41 of the contested decision, that the factors that to some extent affected design freedom in relation to scooters were not design trends or the possible crowding of the sector, but were primarily linked to the type and function of the vehicle, in that the scooter had to allow the driver to sit upright with his legs bent at 90° and his feet comfortably placed on a central footboard. The scooter also had to have wheels with a limited diameter, a front protective shield and a fairing covering the engine. Consequently, creative freedom could be expressed in the design of the shield, footboard, fairing, mudguards, seat and wheels and in the design and positioning of the front and rear lights. The Board of Appeal therefore concluded that the degree of freedom of the designer could be defined as at least average.
- 45 The comparison of the overall impressions produced by the designs at issue must be carried out on the basis of those observations of the Board of Appeal, which, furthermore, are not contested by the parties.

Comparison of the overall impressions produced by the designs at issue on the informed user

- 46 According to case-law, the assessment as to whether a design has individual character must be conducted in relation to one or more specific, individualised, defined and identified designs from among all the designs which have been made available to the public previously. Consequently, in order for a design to be considered to have individual character, the overall impression which that design must produce on the informed user must be different from that produced on such a user not by a combination of features taken in isolation and drawn from a number of earlier designs, but by one or more earlier designs, taken individually (see, to that effect, judgment of 19 June 2014, *Karen Millen Fashions*, C-345/13, EU:C:2014:2013, paragraphs 25 and 35).
- 47 The individual character of a design results from an overall impression of difference, or lack of ‘déjà vu’, from the point of view of an informed user, in relation to any previous presence in the design corpus, without taking account of any differences that are insufficiently significant to affect that overall impression, even though they may be more than insignificant details, but taking account of differences that are sufficiently marked so as to produce dissimilar overall impressions (see judgment of 7 November 2013, *Budziewska v OHIM – Puma (Bounding feline)*, T-666/11, not published, EU:T:2013:584, paragraph 29 and the case-law cited).
- 48 In the assessment of the individual character of a design in relation to any previous presence in the design corpus, account must be taken of the nature of the product to which the design is applied or into which it is incorporated, and, inter alia, the industrial sector to which it belongs (see recital 14 of Regulation No 6/2002), the degree of freedom of the designer in developing the design (see Article 6(2) of Regulation No 6/2002), whether there is saturation of the state of the art, which, whilst it cannot be regarded as limiting the freedom of the designer, could be capable of making the informed user more attentive to the differences between the designs under comparison, and also the manner in which the product at issue is used, in particular on the basis of the handling to which it is normally subject on that occasion (see judgment of 7 November 2013, *Bounding feline*, T-666/11, not published, EU:T:2013:584, paragraph 31 and the case-law cited).

- 49 Since the applicant chose the earlier design over any previous presence in the design corpus, a comparison should be made between, on the one hand, the overall impression produced by that design and, on the other, the overall impression produced by the contested design (see, to that effect, judgment of 22 June 2010, *Shenzhen Taiden v OHIM – Bosch Security Systems (Communications equipment)*, T-153/08, EU:T:2010:248, paragraphs 23 and 24).
- 50 In the first place, it must be found that the applicant is not justified in maintaining that the fact that the designs at issue have several common features and have a very similar general shape shows that the contested design creates an overall impression of ‘déjà vu’ in relation to the earlier design.
- 51 As was correctly observed by the Board of Appeal, whereas the contested design is dominated by substantially angular lines, the earlier design favours rounded lines. The designs at issue consequently convey different impressions to the informed user, to whom a particular degree of attentiveness and sensitivity must be ascribed, in particular with regard to the design and aesthetics of the goods concerned.
- 52 In addition, it should be borne in mind that it is possible that, when comparing designs, the impression produced by each of them may be dominated by certain features of the goods or the parts of the goods concerned. However, in order to determine whether a given feature dominates a product, or a part thereof, it is necessary to assess the greater or lesser influence which the various features of the product or the part at issue have on the appearance of that product or that part (see, to that effect, judgment of 25 October 2013, *Merlin and Others v OHIM – Dusyma (Games)*, T-231/10, not published, EU:T:2013:560, paragraph 36).
- 53 The applicant relies on certain features of shape as distinctive features of the earlier design on which it argues the similarities between the designs at issue are based. These are the ‘X’ shape between the rear fairing and the under-seat assembly, the inverted ‘Q’ shape between the under-seat assembly and the front shield, and the arrow shape of the front shield, to which the Tribunale di Torino (District Court, Turin, Italy), in a dispute between the intervener and the applicant, added the teardrop shape of the fairing by Judgment No 1900/2017 of 6 April 2017 (‘the judgment of the District Court, Turin’), upheld by the Corte d’appello di Torino (Court of Appeal, Turin, Italy) by Judgment No 677/2019 of 12 December 2018 (‘the judgment of the Court of Appeal, Turin’). It should be noted, however, that the applicant failed to demonstrate either that the informed user would actually recognise that those features dominated the appearance of the earlier design, or that such features were also present in the contested design and had an influence on the appearance of that design comparable to that which they were alleged to have on the earlier design.
- 54 Lastly, it should be noted that the applicant’s arguments that, first, the features common to the designs at issue have also been present in the other versions of the Vespa scooter since its creation and first marketing by the applicant, both of which date back to 1945 and 1946, and, second, the Vespa S scooter design includes, in particular, a square headlight and rectilinear features are ineffective. For the reasons set out in paragraphs 38 and 49 above, those arguments are irrelevant for the purposes of examining the individual character of the contested design, which must be assessed solely in relation to the earlier design, chosen by the applicant, over any previous presence in the design corpus, in support of the application for a declaration of invalidity.
- 55 In the second place, as regards the applicant’s argument that the differences highlighted by the Board of Appeal essentially relate to details of minor importance, it should be noted that differences are insignificant in the overall impression produced by the designs at issue where they are not sufficiently pronounced to distinguish the goods at issue in the perception of the informed user or offset the similarities found between those designs (see, to that effect, judgment of 21 November 2013, *El Hogar Perfecto del Siglo XXI v OHIM – Wenf International Advisers (Corkscrew)*, T-337/12, EU:T:2013:601, paragraphs 49 to 54).

- 56 The applicant cannot effectively rely on the fact that the differences observed by the Board of Appeal are of little relevance in the context of a theoretical examination and even less decisive in a ‘real-life examination’ of the designs at issue on the ground that, when using it, the informed user would view the scooter at an angle of between 45° and 60°.
- 57 Firstly, contrary to the applicant’s assertions, for the assessment of the perception by the informed user of the appearance of the designs at issue, decisive weight must not be attached to the perspective during use of the goods into which the designs at issue are intended to be incorporated, inasmuch as the informed user also bases his decision to purchase and his decision to use the goods concerned on the design of those goods (see, to that effect, judgment of 21 May 2015, *Senz Technologies v OHIM – Impliva (Umbrellas)*, T-22/13 and T-23/13, EU:T:2015:310, paragraph 97 (not published)).
- 58 Secondly, after a detailed comparison of the front, side and rear views of the designs at issue, the Board of Appeal correctly observed that the differences between them were numerous and significant and would not escape the attention of an informed user, who, as has been noted in paragraph 43 above, is familiar with the various designs in the sector concerned, has a certain degree of knowledge of the components normally included in those designs and, because of his interest in the goods concerned, can be understood as a user who is both particularly observant and particularly attentive and sensitive to the design and aesthetics of the goods concerned.
- 59 Thirdly, according to case-law, the more the designer’s freedom in developing a design is restricted, the more likely it is that minor differences between the designs at issue will be sufficient to produce a different overall impression on an informed user. Conversely, the greater the designer’s freedom in developing a design, the less likely it is that minor differences between the designs at issue will be sufficient to produce a different overall impression on an informed user (see, to that effect, judgment of 18 July 2017, *Chanel v EUIPO – Jing Zhou and Golden Rose 999 (Ornamentation)*, T-57/16, EU:T:2017:517, paragraph 30). In the present case, however, the differences between the designs at issue, as observed by the Board of Appeal in paragraphs 44 to 47 of the contested decision and which also concern features in respect of which the designer’s freedom may be expressed, are numerous and significant, so that the degree of freedom of the designer, which was defined as at least average, cannot affect the conclusion as to the overall impression produced by each of those designs.
- 60 The differences concerning the headlight, the front shield, the central element visible on the front shield, the air intake or the protective grille for the horn, the indicators and the profile of the lower part of the mudguard strengthen the angular look of the contested design in relation to the earlier design, which is characterised by a more curved appearance. Similarly, the shape of the rear fairing – a clearly tapered semicircle in the earlier design and strictly geometric in the contested design – confirms that perception. In addition, the fairing, which leaves the wheel completely uncovered in the contested design, which is not the case in the earlier design, the design and position of the lights, which are generally the same size, form a whole and are positioned on the lower edge of the body panel in the contested design, whereas they have clearly different dimensions, are separated and placed in different positions in the earlier design, and the design of the passenger grab rail, which is vertical in the contested design and essentially horizontal in the earlier design, are also significant differences which influence the overall impression produced by each of the designs at issue.
- 61 It follows that the differences which the Board of Appeal correctly observed between the designs at issue, which also relate to the elements on which the applicant relies as being the distinctive features of the earlier design, can be perceived by the informed user and influence the overall impression on that user created by the designs at issue, irrespective of the perspective from which those designs will be observed by the informed user.
- 62 In the third place, without raising a separate plea in law alleging that the statement of reasons for the contested decision is defective, the applicant argues that the Board of Appeal failed to appropriately state the reasons why it departed from the findings of fact already made by the Invalidity Division.

That argument cannot succeed. The Board of Appeal, which is not bound by the findings of fact made by the Invalidity Division, explained to the requisite legal standard the reasons, set out in paragraphs 58 to 61 above, why, following the examination of the substance of the appeal and an objective technical assessment of the differences between the designs at issue, it had reached conclusions which differed from those of the Invalidity Division.

63 It is apparent from all of the foregoing that the Board of Appeal did not make an error of assessment in taking the view, in paragraphs 49 and 51 of the contested decision, that the contested design and the earlier design produced different overall impressions on the informed user and in concluding that the contested design did not lack individual character for the purposes of Article 6 of Regulation No 6/2002 in relation to the earlier design.

64 It follows that the first plea in law must be rejected.

Second plea in law, alleging infringement of Article 25(1)(e) of Regulation No 6/2002

65 In support of its second plea in law, the applicant argues that the contested design is invalid, pursuant to Article 25(1)(e) of Regulation No 6/2002, in that it uses an earlier distinctive sign of which the applicant is the right holder.

66 It should be borne in mind that Article 25(1)(e) of Regulation No 6/2002 provides that a design may be declared invalid if a distinctive sign is used in a subsequent design, and EU law or the law of the Member State governing that sign confers on the right holder of the sign the right to prohibit such use.

67 According to case-law, an application, based on the ground for invalidity specified in Article 25(1)(e) of Regulation No 6/2002, for a declaration that a Community design is invalid can succeed only if it is found that the relevant public will form the impression that use is made, in that Community design, of the distinctive sign relied on in support of the application for a declaration of invalidity (judgment of 12 May 2010, *Beifa Group v OHIM – Schwan-Stabilo Schwanhäuser (Instrument for writing)*, T-148/08, EU:T:2010:190, paragraph 105). The examination of that ground for invalidity must be based on the perception by the relevant public of the distinctive sign relied on in support of that ground, as well as on the overall impression which the sign leaves in the mind of the public (judgment of 12 May 2010, *Instrument for writing*, T-148/08, EU:T:2010:190, paragraph 120).

68 As it confirmed at the hearing, the sign relied on by the applicant in support of the present plea in law is the earlier mark, constituted by the three-dimensional scooter shape which is also protected by the earlier design, a mark which has allegedly been recognised and used in Italy since 2005 without, as of the date of the contested decision, having been registered.

69 Under Article 2 of the Codice della proprietà industriale (Italian Industrial Property Code), industrial property rights are acquired according to the methods provided for by law, and distinctive signs other than registered trade marks are protected where the legal requirements laid down for that purpose are met. According to the relevant Italian law and case-law, an unregistered earlier national mark is protected where it has the properties of novelty and originality specific to a registered trade mark. If it has been the subject of earlier use which is well known, which should be understood as meaning actual knowledge on the part of the relevant public, the earlier mark in question prevents the registration of a later sign which is identical or similar to it or, where applicable, causes the registration of that sign to be invalid.

70 With regard to the applicant's argument that the Board of Appeal based its decision on a personal interpretation of the applicable provisions and a subjective assessment of the evidence which the applicant had provided, it must be pointed out that that argument cannot succeed. The Board of

Appeal examined whether, as of the date of filing of the contested design, the earlier mark was used in such a way as to have become well known to the relevant Italian public in order to be validly claimed, in view of Italian law and case-law, for the purposes of the application of Article 25(1)(e) of Regulation No 6/2002.

- 71 In its examination, the Board of Appeal took into consideration the evidence produced by the applicant. On the one hand, it correctly considered irrelevant, firstly, the data on sales and market share and the information concerning the applicant's advertising activity, inasmuch as they did not relate exclusively to the earlier mark, and, secondly, the sales certificates, which did not establish sufficiently precisely if they related only or exclusively to Italy, which was the territory in which the earlier mark was supposedly protected.
- 72 The Board of Appeal, on the other hand, examined the opinion poll produced by the applicant as proof of the fact that the earlier mark was the subject of actual knowledge on the part of the relevant Italian public and that, in particular, the three-dimensional scooter shape which it protected was attributed to the applicant and had acquired a distinctive character through use.
- 73 With regard to the intervener's argument that the earlier mark could not be validly claimed by the applicant for the purposes of the application of Article 25(1)(e) of Regulation No 6/2002, it should be noted that the judgment of the District Court, Turin, upheld by the judgment of the Court of Appeal, Turin, recognised the existence and validity of the earlier mark. However, that finding is not yet final, as the intervener indicates in its responses of 16 May 2019 to the question put by the Court.
- 74 Consequently, irrespective of whether the earlier mark can validly be claimed, in view of Italian law, for the purposes of the application of Article 25(1)(e) of Regulation No 6/2002, it is necessary to examine whether the Board of Appeal was fully entitled to reject the application for a declaration of invalidity in respect of the contested design on the basis of that provision, after having taken the view that the earlier mark was not used in the contested design and that there was no likelihood of confusion, on the part of the relevant public, of the earlier mark with the contested design.

Relevant public

- 75 In analysing the conflict between the contested design and the earlier mark, it is necessary to take into consideration the average consumer, who is the consumer deemed to be reasonably well informed and reasonably observant and circumspect, forming part of the relevant public interested in the goods to which the earlier mark relates, namely 'scooters' as a subcategory of the category 'Mopeds; motorcycles', as is apparent from the contested decision and the confirmations obtained from the parties at the hearing.
- 76 It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question (judgment of 22 June 1999, *Lloyd Schuhfabrik Meyer*, C-342/97, EU:C:1999:323, paragraph 26).
- 77 In the present case, inasmuch as scooters are relatively expensive, durable goods, the average consumer will display a high level of attention, as the Board of Appeal observed in paragraph 75 of the contested decision.
- 78 Accordingly, it is in view of the average consumer as defined in paragraphs 75 and 77 above, who will also make his purchasing decision on the basis of aesthetic considerations, that it is necessary to examine whether the earlier mark is used in the contested design and whether there exists a likelihood of confusion on the part of the relevant public.

Use of the earlier mark in the contested design and existence of a likelihood of confusion on the part of the relevant public

- 79 In the first place, inasmuch as, as was recalled in paragraph 68 above, the applicant limited the right on the basis of which it applied for a declaration of invalidity in respect of the contested design, under Article 25(1)(e) of Regulation No 6/2002, to the earlier mark, the possible presence, in Vespa scooters prior to 2005, of features common to the earlier mark is not relevant for the purposes of assessing the use of that mark in the contested design under Article 25(1)(e) of Regulation No 6/2002, as was correctly indicated by the Board of Appeal.
- 80 In the second place, with regard to the elements on which the applicant relies as being the distinctive features of the three-dimensional scooter shape protected by the earlier mark which it argues were unfairly reproduced in the contested design, namely the 'X' shape between the rear fairing and the under-seat assembly, the inverted 'Ω' shape between the under-seat assembly and the front shield, and the arrow shape of the front shield, to which the judgment of the District Court, Turin added the teardrop shape of the fairing, it should be noted that the assessment of the possible use of those features in the contested design implies a comparison between the shape protected by that design and that of the earlier mark.
- 81 As the Board of Appeal remarked in paragraphs 84 to 86 of the contested decision, when he observes the three-dimensional scooter shape protected by the earlier mark and that of the contested design, the average consumer, who is not an expert with in-depth technical skills, will not be able to spontaneously identify the 'X' shape between the rear fairing and the under-seat assembly or the inverted 'Ω' shape between the under-seat assembly and the front shield, nor will he automatically notice the arrow shape of the front shield, even when displaying a high level of attention. As to the fairing, he will rather notice the difference between the tapered shape of the fairing of the earlier mark, where that of the contested design looks more like a semicircle.
- 82 More generally, irrespective of whether the relevant public will distinguish the elements relied on by the applicant, as mentioned in paragraph 81 above, as being the distinctive features of the earlier mark, the average consumer, who displays a high level of attention, will perceive the style, lines and look which characterise the three-dimensional scooter shape protected by the earlier mark as different, visually, from those of the contested design.
- 83 Consequently, the Board of Appeal's observation that there are differences between the appearance of the shapes of the earlier mark and those of the contested design must be upheld. Those differences also relate to the elements on which the applicant relies as being the distinctive features of the earlier mark.
- 84 To compensate for such visual differences, the applicant cannot effectively rely either on the identity of the goods to which the earlier mark and the contested design relate, or on the well-known use on the Italian market of the three-dimensional scooter shape protected by the earlier mark in respect of those goods, as shown by the opinion poll produced by the applicant.
- 85 As the Board of Appeal observed in paragraph 87 of the contested decision, contrary to the applicant's assertions, the information contained in that opinion poll does not show whether the relevant public actually associates the three-dimensional scooter shape protected by the earlier mark with the contested design and, thus, establish that the earlier mark is used in the contested design.
- 86 In the third place, it should be noted that Article 25(1)(e) of Regulation No 6/2002 applies where use is made not only of a sign which is identical to that relied upon in support of the application for a declaration of invalidity, but also of a sign which is similar (judgments of 12 May 2010, *Instrument for writing*, T-148/08, EU:T:2010:190, paragraph 52, and of 9 September 2015, *Dairek Attoumi v OHIM* –

Diesel (DIESEL), T-278/14, not published, EU:T:2015:606, paragraph 85), if a likelihood of confusion on the part of the relevant public can be established between those signs (judgment of 12 May 2010, *Instrument for writing*, T-148/08, EU:T:2010:190, paragraph 54).

- 87 According to settled case-law, the risk that the public might believe that the goods or services in question come from the same undertaking or from economically linked undertakings constitutes a likelihood of confusion. According to that case-law, the likelihood of confusion must be assessed globally, according to the perception that the relevant public has of the signs and of the goods or services in question and taking into account all relevant factors in the case, in particular the interdependence between the similarity of the signs and that of the goods or services identified (see judgment of 25 April 2013, *Chen v OHIM – AM Denmark (Cleaning device)*, T-55/12, not published, EU:T:2013:219, paragraph 44 and the case-law cited).
- 88 However, if it is found that the relevant public will not form the impression that, in the Community design in respect of which the application for a declaration of invalidity has been submitted, use is made of the distinctive sign relied on in support of that application, any likelihood of confusion can clearly be ruled out (see, to that effect, judgment of 12 May 2010, *Instrument for writing*, T-148/08, EU:T:2010:190, paragraph 106).
- 89 In the judgment of the District Court, Turin, the national court concluded that the contested design displayed significant aesthetic differences in relation to the earlier mark, differences which also related to the distinctive features of that mark and were capable of excluding any likelihood of confusion on the part of the relevant public, so that the claim that the contested design infringed the earlier mark had to be rejected. Those conclusions contained in the judgment of the District Court, Turin were not contested by the applicant or the intervener and therefore acquired the force of *res judicata*, as was noted in the judgment of the Court of Appeal, Turin and as was confirmed by the parties in their responses of 16 and 17 May 2019 to the question put by the Court.
- 90 It is apparent from all of the foregoing that, due to (i) the overall visual impression produced by the earlier mark, which is different from that emanating from the contested design, and (ii) the importance of aesthetics in the decision which he makes, the average consumer, who displays a high level of attention, will rule out the possibility that the earlier mark may be used in the contested design, despite the fact that the goods concerned are identical.
- 91 Consequently, the Board of Appeal did not make an error of assessment in taking the view, in paragraphs 73 and 88 of the contested decision, that there was no likelihood of confusion on the part of the relevant public, which included the likelihood of association, for the purposes of the application of Article 25(1)(e) of Regulation No 6/2002.
- 92 It follows that the second plea in law must be rejected.

Third plea in law, alleging infringement of Article 25(1)(f) of Regulation No 6/2002

- 93 In its third plea in law, the applicant argues, in essence, that the contested design should also be declared invalid on the basis of Article 25(1)(f) of Regulation No 6/2002, pursuant to Italian and French copyright law and principles.
- 94 With regard to the alleged use of an intellectual work protected by Italian copyright, namely legge n. 633 – Protezione del diritto d'autore e di altri diritti connessi al suo esercizio (Law No 633 on the protection of copyright and other rights relating to its exercise) of 22 April 1941 (GURI No 166 of 16 July 1941), as amended, the applicant referred, in the application, to 'the Vespa shape' or to 'the Vespa'. The applicant maintains that the artistic and creative core of 'the Vespa', constituted by the features of shape referred to in paragraphs 10 and 53 above, dates back to 1945 and 1946 and that

that creative heart is protected by Italian copyright, without its being possible to distinguish between the different Vespa moped designs, as was recognised by the judgment of the District Court, Turin. By virtue of those features, which have remained substantially the same since the creation and first marketing by the applicant of the first design, the Vespa has become an icon, a symbol of Italian customs and artistic design. At the hearing, the applicant stated that the earlier design encompasses the artistic and creative core of the original Vespa, namely the abovementioned features of shape.

- 95 With regard to the alleged use of an intellectual work protected by French copyright, the applicant refers to the judgment of 7 February 2013 of the tribunal de grande instance de Paris (Regional Court, Paris, France), which also recognised that ‘the Vespa’, and in particular that corresponding to the earlier design, met the requirements to be protected by French copyright, pursuant to Article L 111-1 of the code de la propriété intellectuelle français (French Intellectual Property Code), due to its specific overall look and particular shape, which had a ‘rounded, feminine and “vintage” character’, which bore the imprint of its author’s aesthetic choices and personality.
- 96 EUIPO and the intervener contest all the applicant’s arguments.
- 97 First of all, it should be borne in mind that, under Article 25(1)(f) of Regulation No 6/2002, a Community design may be declared invalid if it constitutes an unauthorised use of a work protected under the copyright law of a Member State. Accordingly, the protection may be invoked by the copyright holder when, in accordance with the law of the Member State conferring the protection on him, he can prevent the use of the design in question (see, to that effect, judgment of 6 June 2013, *Watch faces*, T-68/11, EU:T:2013:298, paragraph 79).
- 98 Next, according to case-law, an applicant relying on the ground for invalidity referred to in Article 25(1)(f) of Regulation No 6/2002 must provide evidence to demonstrate that the contested design constitutes an unauthorised use of a work protected under the copyright law of the Member State concerned (order of 17 July 2014, *Kastenholz v OHIM*, C-435/13 P, not published, EU:C:2014:2124, paragraph 55).
- 99 Lastly, it is apparent from a combined reading of the provisions of Article 25(1)(f) and (3) of Regulation No 6/2002 and of Article 28(1)(b)(iii) of Regulation No 2245/2002, first, that a Community design may be declared invalid where it constitutes an unauthorised use of a work protected under the copyright law of a Member State, secondly, that an application for a declaration of invalidity may be made solely by the holder of the copyright and, thirdly, that that application must contain the representation and particulars of the protected work on which it is based and particulars showing that the applicant for a declaration of invalidity is the holder of the copyright (judgment of 23 October 2013, *Viejo Valle v OHIM – Établissements Coquet (Cup and saucer with grooves)*, T-566/11 and T-567/11, EU:T:2013:549, paragraph 47).
- 100 In the first place, it is necessary to identify the work on which the applicant relies for the purposes of the application of Article 25(1)(f) of Regulation No 6/2002, which, although it is protected by Italian and French copyright is – according to the applicant – unfairly used in the contested design.
- 101 In that regard, on the one hand, the Board of Appeal observed, in paragraph 99 of the contested decision, that the only work identified by the applicant with the necessary precision for the purposes of the application of Article 25(1)(f) of Regulation No 6/2002 was that corresponding to the earlier design, inasmuch as the work in respect of which it was possible to rely on the ground for invalidity referred to in Article 25(1)(f) of Regulation No 6/2002 could not be an accumulation of stylistic versions of a product over many decades. On the other hand, the Board of Appeal attributed creativity and artistic value to the work corresponding to the earlier design, relying on the conclusions of the judgment of the District Court, Turin, which referred to the judgment of 7 February 2013 of the

tribunal de grande instance de Paris (Regional Court, Paris). It observed that those judgments recognised that the scooter design corresponding to the earlier design was a work protected by Italian and French copyright.

- 102 Those observations must be upheld, in that they restate the principle that copyright protects the expression of ideas and not the ideas themselves. The earlier design encompasses the core of the original ‘Vespa’, namely the features of shape referred to in paragraphs 10 and 53 above, and it is as a concrete expression of that artistic and creative core that the earlier design is capable of protection by Italian copyright. Similarly, the earlier design has a specific overall look and a particular shape, which has a ‘rounded, feminine and “vintage” character’, which are capable of protection by French copyright.
- 103 In the second place, it is necessary to verify whether there is an ‘unauthorised use’ of the earlier design, as a work protected by Italian and French copyright, in the contested design for the purposes of Article 25(1)(f) of Regulation No 6/2002.
- 104 Under Italian copyright, the use of the artistic and creative core constituted by the features of shape referred to in paragraphs 10 and 53 above cannot be discerned in the contested design. Between the rear fairing and the under-seat assembly and between the under-seat assembly and the front shield, the lines of the contested design rather have an angular look. Its pointed front shield represents a ‘necktie’ up to the mudguard, rather than an arrow. As to the fairing, the shape of that of the contested design is not tapered, unlike the teardrop shape of the fairing of the earlier design.
- 105 Neither can the specific overall look and particular shape, which has a ‘rounded, feminine and “vintage” character’, of the earlier design be found in the contested design, which is characterised by straight lines and angles, so that the impressions which emanate from the work corresponding to the earlier design and from the contested design are different, as the Board of Appeal observed in paragraph 114 of the contested decision.
- 106 It follows from all the foregoing considerations that the Board of Appeal did not make an error of assessment in considering, in paragraph 115 of the contested decision, on the basis of the evidence available to it, that the scooter design corresponding to the earlier design, protected by Italian and French copyright, was not the subject of an unauthorised use in the contested design.
- 107 It follows that the third plea in law must be rejected.
- 108 Since the applicant has been unsuccessful in all its pleas in law, the present action must be dismissed.

Costs

- 109 Under Article 134(1) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party’s pleadings.
- 110 Since the applicant has been unsuccessful in the present case, it must be ordered to pay the costs, in accordance with the forms of order sought by EUIPO and the intervener.

On those grounds,

THE GENERAL COURT (Sixth Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders Piaggio & C. SpA to pay the costs.**

Berardis

Papasavvas

Spineanu-Matei

Delivered in open court in Luxembourg on 24 September 2019.

[Signatures]