

Court of Justice EU, 13 February 2014, Gautzsch v Joseph Duna



## DESIGN LAW

Distribution of images of a design to traders operating in the involved sector in the Union can be sufficient to be known in the course of business to the circles specialized in the sector concerned

- Consequently, the answer to the first question is that, on a proper construction of Article 11(2) of Regulation No 6/2002, it is possible that an unregistered design may reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union, if images of the design were distributed to traders operating in that sector, which it is for the Community design court to assess, having regard to the circumstances of the case before it.

Possibility that an unregistered design may not have become known in the circles specialised in the sector concerned even though it was disclosed to third parties if it has been made available to only one undertaking in that sector or has been presented only in the showrooms of an undertaking outside the European Union

- In the light of the foregoing, the answer to the second question is that, on a proper construction of the first sentence of Article 7(1) of Regulation No 6/2002, it is possible that an unregistered design may not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union, even though it was disclosed to third parties without any explicit or implicit conditions of confidentiality, if it has been made available to only one undertaking in that sector or has been presented only in the showrooms of an undertaking outside the European Union, which it is for the Community design court to assess, having regard to the circumstances of the case before it.

## LITIGATION

**Holder of protected design must bear the burden of proving that the contested use results from copying**

that design; national law may counter difficulties in production of evidence

- Consequently, the answer to the third question is that, on a proper construction of the first subparagraph of Article 19(2) of Regulation No 6/2002, the holder of the protected design must bear the burden of proving that the contested use results from copying that design. However, if a Community design court finds that the fact of requiring that holder to prove that the contested use results from copying that design is likely to make it impossible or excessively difficult for such evidence to be produced, that court is required, in order to ensure observance of the principle of effectiveness, to use all procedures available to it under national law to counter that difficulty, including, where appropriate, rules of national law which provide for the burden of proof to be adjusted or lightened.

Defenses of extinction of rights over time and of an action being time-barred are governed by national law

- Consequently, the answer to the fourth and fifth questions is that the defences of the extinction of rights over time and of an action being time-barred that may be raised against an action brought on the basis of Articles 19(2) and 89(1)(a) of Regulation No 6/2002 are governed by national law, which must be applied in a manner that observes the principles of equivalence and effectiveness.

Claims for the destruction of infringing products are governed by the law of the state in which the acts of infringements have been committed; claims for compensation for damage are governed by the national law of the Community design court hearing the proceedings

- In the light of the foregoing, the answer to the sixth question is that, on a proper construction of Article 89(1)(d) of Regulation No 6/2002, claims for the destruction of infringing products are governed by the law of the Member State in which the acts of infringement or threatened infringement have been committed, including its private international law. Claims for compensation for damage resulting from the activities of the person responsible for the acts of infringement or threatened infringement and for disclosure, in order to determine the extent of that damage, of information relating to those activities, are governed, pursuant to Article 88(2) of that regulation, by the national law of the Community design court hearing the proceedings, including its private international law.

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**Court of Justice EU, 31 March 2010**

(M. Ilešič, C.G. Fernlund, A. Ó Caoimh, C. Toader, E. Jarašiūnas (Rapporteur),)

JUDGMENT OF THE COURT (Third Chamber)

13 February 2014 (\*)

(Reference for a preliminary ruling – Intellectual property – Community designs – Regulation (EC) No 6/2002 – Articles 7(1), 11(2), 19(2), 88 and 89(1)(a) and (d) – Unregistered Community design – Protection – Making available to the public – Novelty – Action for infringement – Burden of proof – Extinction of rights over time – Time-barring – Applicable law)

In Case C-479/12,

REQUEST for a preliminary ruling under Article 267 TFEU from the Bundesgerichtshof (Germany), made by decision of 16 August 2012, received at the Court on 25 October 2012, in the proceedings

H. Gautzsch Großhandel GmbH & Co. KG

v

Münchener Boulevard Möbel Joseph Duna GmbH,  
THE COURT (Third Chamber),

composed of M. Ilešič, President of the Chamber, C.G. Fernlund, A. Ó Caoimh, C. Toader and E. Jarašiūnas (Rapporteur), Judges,

Advocate General: M. Wathelet,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after considering the observations submitted on behalf of:

– Münchener Boulevard Möbel Joseph Duna GmbH, by A. Rinkler, Rechtsanwalt,

– the European Commission, by G. Braun and F. Bulst, acting as Agents,

after hearing the [Opinion of the Advocate General](#) at the sitting on 5 September 2013,

gives the following

### Judgment

1 This request for a preliminary ruling concerns the interpretation of Articles 7(1), 11(2), 19(2) and 89(1)(a) and (d) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1).

2 The request has been made in proceedings between H. Gautzsch Großhandel GmbH & Co. KG ('Gautzsch Großhandel') and Münchener Boulevard Möbel Joseph Duna GmbH ('MBM Joseph Duna') concerning an action for infringement of an unregistered Community design, brought by MBM Joseph Duna against Gautzsch Großhandel.

### Legal context

3 Recital 1 in the preamble to Regulation No 6/2002 states:

*'A unified system for obtaining a Community design to which uniform protection is given with uniform effect throughout the entire territory of the Community would further the objectives of the Community as laid down in the Treaty.'*

4 Recitals 21 and 22 of that regulation state:

*'(21) The exclusive nature of the right conferred by the registered Community design is consistent with its greater legal certainty. It is appropriate that the unregistered Community design should, however, constitute a right only to prevent copying. Protection could not therefore extend to design products which are the result of a design arrived at independently by a*

*second designer. This right should also extend to trade in products embodying infringing designs.*

*(22) The enforcement of these rights is to be left to national laws. It is necessary therefore to provide for some basic uniform sanctions in all Member States. These should make it possible, irrespective of the jurisdiction under which enforcement is sought, to stop the infringing acts.'*

5 Recital 31 of that regulation is worded as follows:

*'This Regulation does not preclude the application to designs protected by Community designs of the industrial property laws or other relevant laws of the Member States, such as those relating to design protection acquired by registration or those relating to unregistered designs, trade marks, patents and utility models, unfair competition or civil liability.'*

6 Pursuant to Article 1(1) and (2)(a) of Regulation No 6/2002, a design which complies with the conditions contained in that regulation is to be protected by an 'unregistered Community design', if made available to the public in the manner provided for in that regulation.

7 Paragraph 1 of Article 4 of Regulation No 6/2002, entitled 'Requirements for protection', provides that a design is to be protected by a Community design to the extent that it is new and has individual character.

8 Paragraph 1 of Article 5 of that regulation, entitled 'Novelty', states:

*'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;*

*...'*

9 Paragraph 1 of Article 6 of Regulation No 6/2002, entitled 'Individual character', provides:

*'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;*

*...'*

10 Paragraph 1 of Article 7 of that regulation, entitled 'Disclosure', provides:

*'For the purpose of applying Articles 5 and 6, a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, before the date referred to in Articles 5(1)(a) and 6(1)(a) or in Articles 5(1)(b) and 6(1)(b), as the case may be, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community. The*

*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 Article 11 of Regulation No 6/2002, entitled 'Commencement and term of protection of the unregistered Community design', provides:

*'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. The 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.'*

12 Paragraphs 1 and 2 of Article 19 of Regulation No 6/2002, entitled 'Rights conferred by the Community design', state:

*'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.'*

13 Article 88 of that regulation, entitled 'Applicable law', provides:

*'1. The Community design courts shall apply the provisions of this Regulation.*

*2. On all matters not covered by this Regulation, a Community design court shall apply its national law, including its private international law.*

*3. Unless otherwise provided in this Regulation, a Community design court shall apply the rules of procedure governing the same type of action relating to a national design right in the Member State where it is situated.'*

14 Paragraph 1 of Article 89 of Regulation No 6/2002, entitled 'Sanctions in actions for infringement', provides:

*'Where in an action for infringement or for threatened infringement a Community design court finds that the*

*defendant has infringed or threatened to infringe a Community design, it shall, unless there are special reasons for not doing so, order the following measures:*

*(a) an order prohibiting the defendant from proceeding with the acts which have infringed or would infringe the Community design;*

*(b) an order to seize the infringing products;*

*(c) an order to seize materials and implements predominantly used in order to manufacture the infringing goods, if their owner knew the effect for which such use was intended or if such effect would have been obvious in the circumstances;*

*(d) any order imposing other sanctions appropriate under the circumstances which are provided by the law of the Member State in which the acts of infringement or threatened infringement are committed, including its private international law.'*

#### **The dispute in the main proceedings and the questions referred for a preliminary ruling**

15 It can be seen from the order for reference that the parties to the main proceedings trade in garden furniture. MBM Joseph Duna's product range includes a canopied gazebo, marketed in Germany, the design for which was created by the manager of MBM Joseph Duna in the autumn of 2004. For its part, Gautzsch Großhandel began marketing a gazebo called 'Athen' ('the "Athen" gazebo') manufactured by Zhengte, an undertaking established in China, in 2006.

16 MBM Joseph Duna brought an action for infringement against Gautzsch Großhandel before the Landgericht Düsseldorf (Regional Court, Düsseldorf) (Germany), claiming the protection afforded to unregistered Community designs for its design and seeking the following orders against that company: that it cease to use that gazebo; that it surrender, for purposes of destruction, the infringing products currently in its possession or ownership; that it disclose information relating to its activities; and that it be required to pay compensation for the damage resulting from those activities.

17 In support of its action, MBM Joseph Duna claimed, inter alia, that the 'Athen' gazebo was a copy of its own design, which, in April and May 2005, appeared in its 'MBM-Neuheitenblätter' (new products leaflets), which had been distributed to the sector's largest furniture and garden furniture retailers and to German furniture-purchasing associations.

18 Gautzsch Großhandel opposed the action, contending that the 'Athen' gazebo had been independently created by Zhengte, which was unaware of MBM Joseph Duna's design, at the beginning of 2005. It stated that its gazebo had been presented to European customers in March 2005 in Zhengte's showrooms in China and that a model had been sent to Kosmos, a company established in Belgium, in June 2005. In its defence, Gautzsch Großhandel contended that MBM Joseph Duna's rights had been extinguished over time ('extinction of rights over time') and that the right to bring an action was time-barred ('time-barring'), maintaining that MBM Joseph Duna had been aware of the 'Athen' gazebo's existence since

September 2005 and that it had known that it was being marketed since August 2006.

19 The Landgericht Düsseldorf found that, in view of the expiry of the three-year protection period for unregistered Community designs, there was no need to give a ruling on the first two heads of claim, asking for Gautzsch Großhandel to cease its use of the ‘Athen’ gazebo and to surrender the infringing products. Ruling on the other heads of claim, it ordered Gautzsch Großhandel to disclose information relating to its activities and found that it was obliged to pay financial compensation for the damage resulting from those activities.

20 The appeal brought by Gautzsch Großhandel against that judgment was dismissed by the appeal court, which held that the first two heads of claim were, in the light of Articles 19(2) and 89(1)(a) and (d) of Regulation No 6/2002 and the German legislation on the legal protection of designs, well founded originally and that MBM Joseph Duna was indeed entitled to obtain both the information sought and compensation for the damage it had suffered.

21 In the context of the appeal on a point of law brought by Gautzsch Großhandel before the Bundesgerichtshof (Federal Court of Justice) (‘the referring court’), that court seeks to ascertain, in view of the facts before it, the scope of the concept of ‘disclosure’ which appears in, inter alia, Articles 7(1) and 11(2) of Regulation No 6/2002 for the purposes of determining whether the unregistered design for which protection is claimed was made available to the public for the purpose of that regulation and whether the design on which the opposition is based was made available to the public at an earlier date.

22 In addition, the referring court is uncertain whether proof of infringement of the unregistered design and the defences of the extinction of rights over time and that the action was time-barred that may be raised against the action for infringement are governed by EU law or whether they are a matter for national law. It is also uncertain whether the law applicable to claims for destruction of infringing products, disclosure of information relating to the activities of the infringing party and compensation for the damage resulting from those activities is its own national law or the law of the Member State in which the acts of infringement were committed.

23 In those circumstances, the Bundesgerichtshof decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

‘1. *Is Article 11(2) of Regulation ... No 6/2002 to be interpreted as meaning that, in the normal course of business, a design could reasonably have become known to the circles specialised in the sector concerned, operating within the European Union, if images of the design were distributed to traders?*

2. *Is the first sentence of Article 7(1) of Regulation ... No 6/2002 to be interpreted as meaning that a design could not reasonably have become known in the normal course of business to the circles specialised in*

*the sector concerned, operating within the European Union, even though it was disclosed to third parties without any explicit or implicit conditions of confidentiality, if:*

(a) *it is made available to only one undertaking in the specialised circles,*

*or*

(b) *it is exhibited in a showroom of an undertaking in China which lies outside the scope of normal market analysis?*

3(a) *Is Article 19(2) of Regulation ... No 6/2002 to be interpreted as meaning that the holder of an unregistered Community design bears the burden of proving that the contested use results from copying the protected design?*

3(b) *If Question 3(a) is answered in the affirmative: Is the burden of proof reversed or is the burden of proof incumbent on the holder of the unregistered Community design lightened if there are material similarities between the design and the contested use?*

4(a) *Is the right to obtain an injunction prohibiting further infringement of an unregistered Community design, provided for in Article 19(2) and Article 89(1)(a) of Regulation ... No 6/2002, extinguished over time?*

4(b) *If Question 4(a) is answered in the affirmative: Is such extinction governed by European Union law and, if so, by what provision?*

5(a) *Is the right to bring an action seeking an injunction prohibiting further infringement of an unregistered Community design, provided for in Article 19(2) and Article 89(1)(a) of Regulation ... No 6/2002, subject to time-barring?*

5(b) *If Question 5(a) is answered in the affirmative: Is such time-barring governed by European Union law and, if so, by what provision?*

6. *Is Article 89(1)(d) of Regulation ... No 6/2002 to be interpreted as meaning that claims for destruction, disclosure of information and damages by reason of infringement of an unregistered Community design which are pursued in relation to the entirety of the European Union are subject to the law of the Member States in which the acts of infringement are committed?’*

#### **Consideration of the questions referred**

##### **Question 1**

24 According to the referring court, the appeal court held that the MBM Joseph Duna gazebo design at issue in the main proceedings had been made available to the public for the first time when, in April and May 2005, MBM Joseph Duna distributed between 300 and 500 copies of the ‘MBM-Neuheitenblätter’ containing images of that design to retailers and wholesalers and to two German furniture-purchasing associations.

25 In the light of those events, the referring court is uncertain whether the distribution of images of that design to traders is sufficient grounds for considering that, in the normal course of business, that design could reasonably have become known to the circles specialised in the sector concerned, operating within the European Union, for the purpose of Article 11(2) of

Regulation No 6/2002. In that regard, the referring court states that it is assumed by some that those specialised circles include only such persons as are involved in creating designs and developing or manufacturing products based on those designs within the sector concerned. Thus, on that view, it is not traders as a body that are regarded as forming part of the circles specialised, but only those which have a creative influence on the design of the product they are marketing.

26 However, no such interpretation of the concept of ‘the circles specialised’ can be inferred from the wording of Article 11(2) of Regulation No 6/2002.

27 As pointed out by the Commission in its observations submitted to the Court and by the Advocate General in point 34 et seq. of his Opinion, Article 11(2) of that regulation lays down no restrictions relating to the nature of the activity of natural or legal persons who may be considered to form part of the circles specialised in the sector concerned. Moreover, it can be inferred from the wording of that provision, especially from the fact that it considers use in trade to be one means of making unregistered designs available to the public and the fact that it requires ‘the normal course of business’ to be taken into account when assessing whether events constituting disclosure could reasonably have become known to the circles specialised, that traders which have not been involved in the design of the product in question cannot, in principle, be excluded from the group of persons who may be considered to form part of those circles.

28 An exclusion of that nature would, moreover, create a restriction of the protection of unregistered Community designs which is not supported by any of the other provisions or recitals of Regulation No 6/2002.

29 The question whether the distribution of an unregistered design to traders in the sector concerned operating within the European Union is sufficient grounds for considering that that design could reasonably have become known in the normal course of business to the circles specialised in that sector is, however, a question of fact; the answer to that question is dependent on the assessment, by the Community design court, of the particular circumstances of each individual case.

30 Consequently, the answer to the first question is that, on a proper construction of Article 11(2) of Regulation No 6/2002, it is possible that an unregistered design may reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union, if images of the design were distributed to traders operating in that sector, which it is for the Community design court to assess, having regard to the circumstances of the case before it.

#### **Question 2**

31 According to the referring court, the appeal court acknowledged that the MBM Joseph Duna design at issue in the main proceedings was new within the

meaning of Article 5(1)(a) of Regulation No 6/2002, holding that, in the normal course of business, the ‘Athen’ design presented in Zhengte’s showrooms in China and sent to Kosmos in Belgium in 2005 could not reasonably have become known to the circles specialised in the sector concerned.

32 In the light of the foregoing, the referring court is uncertain whether the first sentence of Article 7(1) of Regulation No 6/2002 is to be interpreted as meaning that a design could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union, even though it was disclosed to third parties without any explicit or implicit conditions of confidentiality, if it has been made available to only one undertaking in that sector or has been presented only in the showrooms of an undertaking which lies outside ‘the scope of normal market analysis’.

33 In that regard, it should be pointed out that it can be seen from the wording of the first sentence of Article 7(1) of Regulation No 6/2002 that it is not absolutely necessary, for the purpose of applying Articles 5 and 6 of that regulation, for the events constituting disclosure to have taken place within the European Union in order for a design to be deemed to have been made available to the public.

34 However, according to Article 7, a design cannot be deemed to have been made available to the public if the events constituting its disclosure could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union. The question whether events taking place outside the European Union could reasonably have become known to persons forming part of those circles is a question of fact; the answer to that question is dependent on the assessment, by the Community design court, of the particular circumstances of each individual case.

35 The same is true of the question whether the fact that a design has been disclosed to a single undertaking in the sector concerned within the European Union is sufficient grounds for considering that the design could reasonably have become known in the normal course of business to the circles specialised in that sector: it is quite possible that, in certain circumstances, a disclosure of that kind may indeed be sufficient for that purpose.

36 In the light of the foregoing, the answer to the second question is that, on a proper construction of the first sentence of Article 7(1) of Regulation No 6/2002, it is possible that an unregistered design may not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union, even though it was disclosed to third parties without any explicit or implicit conditions of confidentiality, if it has been made available to only one undertaking in that sector or has been presented only in the showrooms of an undertaking outside the European Union, which it is for the Community design court to assess, having regard to the circumstances of the case before it.

**Question 3**

37 According to the referring court, the appeal court ruled that Gautzsch Großhandel's design was not an independent work of creation, but rather a copy of MBM Joseph Duna's design, finding that the burden of proof incumbent on MBM Joseph Duna was lightened in that regard, given the 'actual material similarities' between those two designs.

38 In the light of those elements, the referring court is uncertain whether Article 19(2) of Regulation No 6/2002 is to be interpreted as meaning that the holder of an unregistered Community design bears the burden of proving that the contested use results from copying that design and, if so, whether the burden of proof is reversed or lightened if there are 'material similarities' between that design and another design, the use of which is contested.

39 In that regard, Article 19 of Regulation No 6/2002, which, as its title indicates, concerns the rights conferred by the Community design, provides no express rules on producing evidence.

40 However, as the Advocate General notes in points 67 to 74 of his Opinion, making reference to trade mark law, if the issue of the onus of proving that the contested use results from copying the protected design were a matter for the national law of the Member States, the consequence for holders of Community designs could be that protection would vary according to the legal system concerned, with the result that the objective of providing uniform protection with uniform effect throughout the entire territory of the European Union, as set out in recital 1 of Regulation No 6/2002 in particular, would not be attained (see, by analogy, [Case C-405/03 Class International \[2005\] ECR I-8735, paragraph 73](#)).

41 In view of that objective and in view of the structure and broad logic of Article 19(2) of Regulation No 6/2002, it should be held that, where the holder of a protected design is relying on the right set out in the first subparagraph of that provision, the onus of proving that the contested use results from copying that design rests with that holder, whereas, in the second subparagraph of that provision, the onus of proving that the contested use results from an independent work of creation rests with the opposing party.

42 As Regulation No 6/2002 does not provide any express rules on producing evidence, it follows from Article 88 of that regulation that such rules are to be determined according to the national law of the Member States. However, according to case-law, the Member States must, in accordance with the principles of equivalence and effectiveness, ensure that such rules are not less favourable than those applicable to similar domestic actions and that they do not make it in practice impossible or excessively difficult for individuals to exercise rights conferred by EU law (see, to that effect, [Case C-55/06 Arcor \[2008\] ECR I-2931, paragraph 191](#)).

43 Therefore, as the Commission points out, if the Community design court finds that the fact of requiring the holder of the protected design to prove that the

contested use results from copying that design is likely to make it impossible or excessively difficult for such evidence to be produced, that court is required, in order to ensure observance of the principle of effectiveness, to use all procedures available to it under national law to counter that difficulty (see, by analogy, [Case C-526/04 Laboratoires Boiron \[2006\] ECR I-7529, paragraph 55](#), and [Case C-264/08 Direct Parcel Distribution Belgium \[2010\] ECR I-731, paragraph 35](#)). Thus, that court may, where appropriate, apply rules of national law which provide for the burden of proof to be adjusted or lightened.

44 Consequently, the answer to the third question is that, on a proper construction of the first subparagraph of Article 19(2) of Regulation No 6/2002, the holder of the protected design must bear the burden of proving that the contested use results from copying that design. However, if a Community design court finds that the fact of requiring that holder to prove that the contested use results from copying that design is likely to make it impossible or excessively difficult for such evidence to be produced, that court is required, in order to ensure observance of the principle of effectiveness, to use all procedures available to it under national law to counter that difficulty, including, where appropriate, rules of national law which provide for the burden of proof to be adjusted or lightened.

**Questions 4 and 5**

45 First, the referring court explains that the appeal court found that, at the time when the action was brought, the right to obtain an injunction prohibiting further infringing acts on the basis of Articles 19(2) and 89(1)(a) of Regulation No 6/2002 had not been extinguished. The referring court is uncertain, with regard to that finding, whether the right to obtain such an injunction is limited in time and, if so, whether that limitation falls within the scope of EU law. The referring court observes, in that regard, that Regulation No 6/2002 contains no provisions that deal specifically with that subject, but that Article 89(1) thereof states that, where a Community design court finds that the defendant has infringed or threatened to infringe a Community design, it is to order a sanction 'unless there are special reasons for not doing so'.

46 Secondly, noting that the appeal court rejected Gautzsch Großhandel's objection that the action was time-barred, the referring court is also uncertain whether – and, if so, in what circumstances – the right to bring an action for infringement based on Articles 19(2) and 89(1)(a) of Regulation No 6/2002 may be time-barred. According to the referring court, it is important to determine whether the circumstances leading Gautzsch Großhandel to plead that the action is time-barred can be regarded as being among the 'special reasons' referred to in the latter provision.

47 In that regard, it must be stated that Regulation No 6/2002 is silent on the subject of the extinction of rights over time and of an action being time-barred, both of which are defences that may be raised against an action brought on the basis of Articles 19(2) and 89(1)(a) thereof.

48 The term ‘special reasons’, as used in Article 89(1) of that regulation, relates to factual circumstances specific to a given case (see, by analogy, [Case C-316/05 Nokia \[2006\] ECR I-12083, paragraph 38](#)). Consequently, it does not cover the extinction of rights over time or an action being time-barred, both of which constitute legal circumstances.

49 Accordingly, pursuant to Article 88(2) of Regulation No 6/2002, the defences of the extinction of rights over time and of an action being time-barred that may be raised against an action brought on the basis of Articles 19(2) and 89(1)(a) of that regulation are governed by national law, which must be applied in a manner that observes the principles of equivalence and effectiveness, the substance of which is set out in paragraph 42 above (see also, by analogy, [Joined Cases C-295/04 to C-298/04 Manfredi and Others \[2006\] ECR I-6619, paragraphs 77 to 80](#); [Case C-406/08 Uniplex \(UK\) \[2010\] ECR I-817, paragraphs 32 and 40](#); [Case C-246/09 Bulicke \[2010\] ECR I-7003, paragraph 25](#); [Case C-177/10 Rosado Santana \[2011\] ECR I-7907, paragraphs 89, 90, 92 and 93](#); and [Case C-591/10 Littlewoods Retail and Others \[2012\] ECR, paragraph 27](#)).

50 Consequently, the answer to the fourth and fifth questions is that the defences of the extinction of rights over time and of an action being time-barred that may be raised against an action brought on the basis of Articles 19(2) and 89(1)(a) of Regulation No 6/2002 are governed by national law, which must be applied in a manner that observes the principles of equivalence and effectiveness.

#### Question 6

51 Stating that the appeal court did not indicate what law was applicable to the claims for destruction of the infringing products, for disclosure of information relating to Gautzsch Großhandel’s activities and for compensation for the damage resulting from those activities, the referring court is uncertain whether those claims obey the national law of the Member State in which those rights are invoked or whether Article 89(1)(d) of Regulation No 6/2002 should be interpreted to the effect that those claims are governed by the law of the Member States in which the acts of infringement were committed. The referring court notes, in that regard, that establishing a link to the law of a single Member State could be justified as being the most effective application of that law, but that Article 89(1)(d) of Regulation No 6/2002 could militate against that approach.

52 First, regarding the claim for destruction of the infringing products, it is clear from Article 89(1) of Regulation No 6/2002, which refers, in subparagraph (a) thereof, to an order prohibiting the defendant from proceeding with the acts which have infringed or would infringe the Community design and, in subparagraphs (b) and (c), to an order to seize the infringing products and to an order to seize materials and implements used in order to manufacture those products, that the destruction of those products falls within the ‘other

sanctions appropriate under the circumstances’ referred to in Article 89(1)(d) of that regulation. It follows that, under Article 89(1)(d) of Regulation No 6/2002, the law applicable to that claim is the law of the Member State in which the acts of infringement or threatened infringement have been committed, including its private international law.

53 Secondly, regarding the claims for compensation for the damage resulting from the activities of the person responsible for the acts of infringement or threatened infringement and for disclosure, in order to determine the extent of that damage, of information relating to those activities, it must be found that the obligation to provide such information and to pay compensation for the damage suffered does not, by contrast, constitute a sanction within the meaning of Article 89 of Regulation No 6/2002.

54 Accordingly, pursuant to Article 88(2) of Regulation No 6/2002, the law applicable to the claims listed in paragraph 53 above is the national law of the Community design court hearing the proceedings, including its private international law. That finding is borne out, moreover, by recital 31 of that regulation, which states that the regulation does not preclude the application to designs protected by Community designs of the laws of the Member States relating to civil liability.

55 In the light of the foregoing, the answer to the sixth question is that, on a proper construction of Article 89(1)(d) of Regulation No 6/2002, claims for the destruction of infringing products are governed by the law of the Member State in which the acts of infringement or threatened infringement have been committed, including its private international law. Claims for compensation for damage resulting from the activities of the person responsible for the acts of infringement or threatened infringement and for disclosure, in order to determine the extent of that damage, of information relating to those activities, are governed, pursuant to Article 88(2) of that regulation, by the national law of the Community design court hearing the proceedings, including its private international law.

#### Costs

56 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (Third Chamber) hereby rules:

1. On a proper construction of Article 11(2) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, it is possible that an unregistered design may reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union, if images of the design were distributed to traders operating in that sector, which it is

for the Community design court to assess, having regard to the circumstances of the case before it.

2. On a proper construction of the first sentence of Article 7(1) of Regulation No 6/2002, it is possible that an unregistered design may not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union, even though it was disclosed to third parties without any explicit or implicit conditions of confidentiality, if it has been made available to only one undertaking in that sector or has been presented only in the showrooms of an undertaking outside the European Union, which it is for the Community design court to assess, having regard to the circumstances of the case before it.

3. On a proper construction of the first subparagraph of Article 19(2) of Regulation No 6/2002, the holder of the protected design must bear the burden of proving that the contested use results from copying that design. However, if a Community design court finds that the fact of requiring that holder to prove that the contested use results from copying that design is likely to make it impossible or excessively difficult for such evidence to be produced, that court is required, in order to ensure observance of the principle of effectiveness, to use all procedures available to it under national law to counter that difficulty, including, where appropriate, rules of national law which provide for the burden of proof to be adjusted or lightened.

4. The defences of the extinction of rights over time and of an action being time-barred that may be raised against an action brought on the basis of Articles 19(2) and 89(1)(a) of Regulation No 6/2002 are governed by national law, which must be applied in a manner that observes the principles of equivalence and effectiveness.

5. On a proper construction of Article 89(1)(d) of Regulation No 6/2002, claims for the destruction of infringing products are governed by the law of the Member State in which the acts of infringement or threatened infringement have been committed, including its private international law. Claims for compensation for damage resulting from the activities of the person responsible for the acts of infringement or threatened infringement and for disclosure, in order to determine the extent of that damage, of information relating to those activities, are governed, pursuant to Article 88(2) of that regulation, by the national law of the Community design court hearing the proceedings, including its private international law.

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#### **OPINION OF ADVOCATE GENERAL WATHELET**

delivered on 5 September 2013 (1)

Case C-479/12

H. Gautzsch Großhandel GmbH & Co. KG

v

Münchener Boulevard Möbel Joseph Duna GmbH  
(Request for a preliminary ruling from the  
Bundesgerichtshof (Germany))

(Intellectual and industrial property — Design — Meaning of ‘public disclosure’ — Meaning of ‘specialised circles’ — Burden of proving imitation of an unregistered design — Procedural rules — Applicable law)

1. By its request for a preliminary ruling, the Bundesgerichtshof (Germany) seeks from the Court an interpretation of Article 7(1), Article 11(2) and Article 89(1)(a) and (d) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (2) (‘the Regulation’).

2. For the first time, the Court is called upon to give its views on the meaning of the term ‘circles specialised in the sector concerned, operating within the Community’ used in Article 7(1) and Article 11(2) of the Regulation, and of the term ‘could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community’ used in Article 7(1) of the Regulation (questions 1 and 2). The Court is also asked to consider a number of procedural questions (burden of proof, loss of rights through lapse of time and the time-barring of claims) and the question of the applicable law (questions 3 to 6).

#### **I – Legal background**

3. Recitals 21 and 22 in the preamble to the Regulation are worded as follows:

*‘(21) The exclusive nature of the right conferred by the registered Community design is consistent with its greater legal certainty. It is appropriate that the unregistered Community design should, however, constitute a right only to prevent copying. Protection could not therefore extend to design products which are the result of a design arrived at independently by a second designer. This right should also extend to trade in products embodying infringing designs.*

*(22) The enforcement of these rights is to be left to national laws. It is necessary therefore to provide for some basic uniform sanctions in all Member States. These should make it possible, irrespective of the jurisdiction under which enforcement is sought, to stop the infringing acts.’*

4. Under Articles 1(1) and (2)(a) of the Regulation, a design which complies with the conditions set out in the Regulation is protected as an ‘unregistered Community design’ if made available to the public in the manner provided for in the Regulation.

5. Article 4 of the Regulation, entitled ‘Requirements for protection’, provides in paragraph (1) that a design is to be protected by a Community design to the extent to which it is new and has individual character.

6. Article 5 of the Regulation, entitled ‘Novelty’, 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;*

*...’*



7. Article 6 of the Regulation, entitled ‘Individual character’, provides in paragraph (1)(a):

*‘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.’*

8. Article 7 of the Regulation, entitled ‘Disclosure’, states in paragraph (1):

*‘For the purpose of applying Articles 5 and 6, a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, before the date referred to in Article 5(1)(a) ... except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community. The 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.’*

9. Article 11 of the Regulation, entitled ‘Commencement and term of protection of the unregistered Community design’, provides in paragraphs (1) and (2):

*‘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. The 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.’*

10. Article 19 of the Regulation, entitled ‘Rights conferred by the Community design’, provides in paragraph (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.’*

11. Article 85(2) of the Regulation, entitled ‘Presumption of validity — Defence as to the merits’, is worded as follows:

*‘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.’*

12. Under Article 88 of the Regulation, entitled ‘Applicable law’:

*‘1. The Community design courts shall apply the provisions of this Regulation.*

*2. On all matters not covered by this Regulation, a Community design court shall apply its national law, including its private international law.*

*3. Unless otherwise provided in this Regulation, a Community design court shall apply the rules of procedure governing the same type of action relating to a national design right in the Member State where it is situated.’*

13. Article 89 of the Regulation, entitled ‘Sanctions in actions for infringement’ provides:

*‘1. Where in an action for infringement or for threatened infringement a Community design court finds that the defendant has infringed or threatened to infringe a Community design, it shall, unless there are special reasons for not doing so, order the following measures:*

*(a) an order prohibiting the defendant from proceeding with the acts which have infringed or would infringe the Community design;*

*...*

*(d) any order imposing other sanctions appropriate under the circumstances which are provided by the law of the Member State in which the acts of infringement or threatened infringement are committed, including its private international law.*

*...’*

## **II – Factual background to the main proceedings**

14. Münchener Boulevard Möbel Joseph Duna GmbH (‘MBM Joseph Duna’) markets in Germany a canopied gazebo, the design for which was created by the director of that company in autumn 2004. During 2006, the company H. Gautzsch Großhandel GmbH & Co. KG (‘Gautzsch Großhandel’) for its part started selling a gazebo under the name ‘Athen’, manufactured by the Chinese undertaking Zhengte.

15. Taking the view that the ‘Athen’ gazebo was a copy of its own design and claiming for the latter the protection available for unregistered Community designs, MBM Joseph Duna commenced infringement proceedings against Gautzsch Großhandel before the Landgericht Düsseldorf, seeking the following orders: first, that Gautzsch Großhandel should cease selling the Athen gazebo, surrender the infringing products in its possession or owned so that they may be destroyed and

give a report on its dealings and, second, that it be ordered to pay compensation.

16. MBM Joseph Duna claimed in particular, in support of its action, that its design appeared in April and May 2005 in its ‘MBM Neuheitenblätter’ (new products leaflet) which had been distributed to the main dealers in the sector selling garden furniture, and to German furniture-purchasing associations.

17. Gautzsch Großhandel stated in its defence that its Athen gazebo had been created by the Chinese manufacturer Zhengte at the beginning of 2005 independently, without any knowledge of the MBM Joseph Duna design, and presented to European customers in March 2005 at the Zhengte showrooms in China. Asserting that a model of that gazebo had been sent in June 2005 to a company whose headquarters were in Belgium and that MBM Joseph Duna had been aware of the existence of that model since September 2005 and knew that it had been marketed since August 2006, it contended that the latter’s claims were time-barred and its rights extinguished through lapse of time.

18. The court of first instance found that there was no need to give a decision on the first and second heads of claim in view of the expiry of the three-year protection period. It ordered Gautzsch Großhandel to provide information on its dealings and held that it was under an obligation to make financial reparation.

19. The appeal brought by Gautzsch Großhandel against that judgment was dismissed. The appeal court took the view that, under Articles 19(2) and 89(1)(a) and (d) of the Regulation and under the German Law on the legal protection of designs, the first heads of claim were well founded originally and MBM Joseph Duna was in fact entitled to receive information and also compensation.

20. In an appeal on a point of law brought by Gautzsch Großhandel before the Bundesgerichtshof, that court observed, first, that the appeal court had taken the view that the MBM Joseph Duna model had been made available for the first time to the public at the time of distribution of 300 to 500 copies of the MBM new product leaflets which included images of the design in question, in April and May 2005, to retailers and wholesalers and to two German furniture-purchasing associations.

21. That court raises the question whether the transmission of images of that design, on that scale, to traders is sufficient for the design, in the normal course of business, to have become known to circles specialised in the sector concerned, operating in the European Union, within the meaning of Article 11(2) of the Regulation. It wonders, in that regard, whether specialised circles might not include anyone other than the persons who, within the sector concerned, have a creative influence on the design of the product.

22. Second, the referring court states that the appeal court accepted that the MBM Joseph Duna design was new, within the meaning of Article 5(1)(a) of the Regulation, taking the view that earlier disclosure of the Athen design did not preclude recognition of that novelty.

23. Even if the Athen model had been exhibited in showrooms of Zhengte in China in March 2005 and presented to Kosmos in Belgium, the specialised circles in the sector concerned could not, in the appeal court’s view, have thereby acquired knowledge of that model in the normal course of business.

24. Having regard to those considerations, the referring court asks in what circumstances a design, even though disclosed to third parties without any express or implied condition of confidentiality, cannot be known to specialised circles in the sector concerned within the European Union within the meaning of Article 7(1) of the Regulation.

25. Third, the referring court observes that the appeal court considered that the design at issue did not constitute a work of independent creation but a copy of the MBM Joseph Duna design, acknowledging that the latter benefited from an easing of the burden of proof on that point, in view of the actual material similarities between the two designs at issue. It raises the question as to which party has the burden of proving, for the application of Article 19(2) of the Regulation, that use of the unregistered Community design derives from a copy of the protected design.

26. Fourth, the Bundesgerichtshof observes that the appeal court considered that the right to obtain an injunction provided for in Article 19(2) and Article 89(1)(a) of the Regulation was not extinguished on the date when the action was brought. It asks, in that regard, whether the right to obtain an injunction on the ground of infringement of a design is subject to a limitation period and, if so, by what legal provisions that limitation period is governed, in so far as the Regulation contains no specific provisions on that point.

27. Fifth, the appeal court having also rejected Gautzsch Großhandel’s plea alleging that the right to obtain an injunction was time-barred, the referring court considers that the question arises whether, and if so under what conditions, a right to obtain an injunction prohibiting further infringement of an unregistered Community design, based on Articles 19(2) and 89(1)(a) of the Regulation, may be time-barred. It is important, in its view, to determine whether the circumstances which have prompted Gautzsch Großhandel to plead that the claim is time-barred fall within the category of ‘special reasons’ within the meaning of the latter provision.

28. Sixth, and last, the referring court asks whether the rights concerning destruction, information and compensation, which extend throughout the European Union, must conform to the national law of the Member State in whose territory those rights are invoked. It observes, in that regard, that a connection only to the law of that Member State might be justified from the standpoint, in particular, of effective application of the law, but that Article 89(1)(d) of the Regulation might militate against that approach, as might Article 8(2) of Regulation (EC) No 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual

obligations ('Rome II'), (3) which also militates in favour of application of the law of the Member State in which infringing acts have been committed.

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

29. By decision received by the Court of Justice on 25 October 2012, the Bundesgerichtshof stayed its proceedings and referred to the Court under Article 267 TFEU the following questions:

1. *Is Article 11(2) of [the] Regulation ... to be interpreted as meaning that, in the normal course of business, a design could reasonably have become known to the circles specialised in the sector concerned, operating within the European Union, if images of the design were distributed to traders?*

2. *Is the first sentence of Article 7(1) of [the] Regulation ... to be interpreted as meaning that a design could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union, even though it was disclosed to third parties without any explicit or implicit conditions of confidentiality, if:*

(a) *it is made available to only one undertaking in the specialised circles, or*

(b) *it is exhibited in a showroom of an undertaking in China which lies outside the scope of normal market analysis?*

3. (a) *Is Article 19(2) of [the] Regulation ... to be interpreted as meaning that the holder of an unregistered Community design bears the burden of proving that the contested use results from copying the protected design?*

(b) *If Question 3(a) is answered in the affirmative: Is the burden of proof reversed or is the burden of proof incumbent on the holder of the unregistered Community design lightened if there are material similarities between the design and the contested use?*

4. (a) *Is the right to obtain an injunction prohibiting further infringement of an unregistered Community design, provided for in Article 19(2) and Article 89(1)(a) of [the] Regulation ..., extinguished over time?*

(b) *If Question 4(a) is answered in the affirmative: Is such extinction governed by European Union law and, if so, by which provision?*

5. (a) *Is the right to bring an action seeking an injunction prohibiting further infringement of an unregistered Community design, provided for in Article 19(2) and Article 89(1)(a) of [the] Regulation ..., subject to time-barring?*

(b) *If Question 5(a) is answered in the affirmative: Is such time-barring governed by European Union law and, if so, by which provision?*

6. *Is Article 89(1)(d) of [the] Regulation ... to be interpreted as meaning that claims for destruction, disclosure of information and damages by reason of infringement of an unregistered Community design which are pursued in relation to the entirety of the European Union are subject to the law of the Member*

*States in which the acts of infringement were committed?'*

30. Written observations were lodged by Gautzsch Großhandel and the European Commission on 4 February and 15 February 2013 respectively. In accordance with Article 76(1) and (2) of the Rules of Procedure of the Court of Justice, since the Court took the view that it had sufficient information before it and the parties did not request otherwise, no arrangements were made for oral argument to be presented.

### IV – Analysis

31. The first two questions concern the concept of disclosure referred to in Articles 7(1) and 11(2) of the Regulation. They are concerned more specifically with interpretation of the expression 'circles specialised in the sector concerned, operating within the Community' used to define disclosure. The purpose of the other four questions is to determine the law applicable to a number of procedural and substantive problems.

#### A – The first question

32. By its first question, the referring court seeks a ruling from the Court of Justice on the meaning of the term 'specialised circles' used in Article 11(2) of the Regulation: is the distribution of images of a design to traders sufficient for it reasonably to be considered that that design has become known in the circles specialised in the sector concerned, operating in the European Union?

33. It is therefore a question of choosing between a restrictive interpretation — according to which the specialised circles include only persons who, within the sector concerned, are responsible for designing, developing or manufacturing products in accordance with the designs in question — and a broader interpretation — which includes traders and dealers within 'circles specialised in the sector concerned'.

34. The referring court seems inclined to favour the second interpretation. I share that view.

35. From a literal point of view, the first sentence of Article 11(2) of the Regulation comprises two parts. It starts by enumerating situations in which a design can be regarded as having been made available to the public within the European Union. That is the case 'if it has been published, exhibited, used in trade or otherwise disclosed'. The sentence then goes on to indicate the particular circumstances which will make it possible to convert such making available into 'disclosure' (the two parts being joined by the conjunction 'in such a way that'). That will be the case if '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'.

36. Within that single sentence, the use of the conjunction 'in such a way that' followed by the reference to 'these events' necessarily leads to the conclusion that all the situations and persons alluded to in the first part of the sentence, including the commercial sphere, are included in the concept of specialised circles. The expression 'in the normal course of business', used in the second part of the

sentence, also militates in favour of inclusion of dealers and traders in the ‘circles specialised in the sector concerned’.

37. The aim pursued and the general framework of which the Regulation forms part do not call that interpretation in question.

38. As summarised by the High Court of Justice (England and Wales) Chancery Division (Patents Court) (United Kingdom), the question that arises is ‘who is in the circle?’ (4) Moreover, I agree with that court’s answer to that question, namely that, in principle, the concept includes all persons who are involved in trade associated with the products in the sector concerned. That consequently includes not only those who design and manufacture them, but also those who advertise, market, distribute and sell them by way of commercial activity in the European Union. (5)

39. It appears to me therefore that the answer to be given to the first question must be positive: Article 11(2) of the Regulation must be interpreted as meaning that, in the normal course of business, a design may reasonably have become known to the circles specialised in the sector concerned, operating within the European Union, where images of that design have been distributed previously to traders operating in the sector concerned.

#### **B – The second question**

40. The second question relates not to Article 11(2) but to Article 7(1) of the Regulation. However, the term to be defined is still ‘specialised circles’. Whilst the first question was concerned with the issue, for the owner of the design, of whether the design for which he claims protection has been disclosed sufficiently to benefit from protection under the Regulation, the second question is, rather, the one raised by the alleged infringer of whether the owner could have been aware of the ‘third party’s’ design (in this case, that of the alleged infringer) before the disclosure of his own design, and therefore lose the right to protection that he claims.

41. In fact, the referring court is asking whether, in the event of the design being made available to only one undertaking in the relevant sector (question 2a) or the exhibition of that design in the showrooms of an undertaking in China, that is to say outside the scope of normal market analysis (question 2b), that design can be regarded as having ‘reasonably... become known to the circles specialised in the sector concerned, operating within the European Union’.

42. It will be remembered that Article 7(1) of the Regulation provides that a design is to be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, before the date referred to in Articles 5(1)(a) and 6(1)(a) or in Articles 5(1)(b) and 6(1)(b) of the Regulation, as the case may be.

43. That provision envisages two exceptions. First, a design will not be deemed to have been made available to the public if it has been disclosed to a third person under explicit or implicit conditions of confidentiality

(a hypothesis ruled out in the referring court’s question). Second, the general rule will likewise not apply if the events, which in principle constitute disclosure, ‘in the normal course of business, could not reasonably have become known to the circles specialised in the sector concerned, operating within the Community’.

1. Disclosure to only one undertaking

44. It seems to me that the answer to the first part of the second question is to be found in the actual text of Article 7(1) of the Regulation.

45. In so far as the legislature chose, in the wording of the first exception, to use the plural (‘except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community’), (6) it cannot be inferred from that text that disclosure to only one undertaking would be sufficient to meet the requirement laid down in Article 7, even if that undertaking belonged to the ‘specialised circles’ concerned.

2. Disclosure and territoriality

46. The second part of the second question, concerning the impact of exhibiting a design in the showroom of an undertaking in China, is more problematic.

47. As the Commission pointed out in its observations, there is an essential difference between the first sentence of Article 7(1) and Article 11(2) of the Regulation, in so far as Article 11(2) refers expressly to disclosure ‘within the Community’, whereas the first sentence of Article 7(1) makes no reference of that kind to the territory of the European Union.

48. It therefore logically follows that, in assessing whether there has been disclosure within the meaning of Article 7(1) of the Regulation, it is necessary in principle to rely on distribution, regardless of where it took place. The national courts and academic writers also appear to endorse that reading of the text. (7)

49. However, it must be observed that Article 7(1) of the Regulation makes it clear, as does Article 11(2), that the potential entities to which the design has been disclosed are undertakings which, operating within the European Union, must be regarded as belonging to the ‘circles specialised in the sector concerned’.

50. That clear statement is not without significance. It derives from a proposal for an amendment made by the Economic and Social Committee (8) with the specific aim of limiting the scope of the proposal of the Commission, which initially considered that novelty had to be determined worldwide, without any further indication. (9) In order to limit the impact of a practice whereby the sellers of infringing products (essentially in the textile industry) obtain certificates falsely attesting that the design at issue had already been created in the past by third parties, the Economic and Social Committee suggested that the definition of disclosure in Article 5(2) of the proposal (Article 7(1) of the Regulation) should be supplemented as follows: ‘[a] design shall be deemed to have been made

available to the public if it has been published following registration or exhibited, used in trade or otherwise disclosed, unless this could not reasonably be known to specialist circles in the sector in question operating within the Community before the date of reference'. (10)

51. The reference to the knowledge of specialised circles operating within the European Union is not therefore fortuitous. On the contrary, it is the result of a particular concern being taken into account. As summarised by certain authors, there are two elements: one, which is absolute, being disclosure anywhere in the world, and the other, of a relative nature, being knowledge on the part of circles specialised in the sector concerned, within the European Union. (11)

52. The use of the terms 'normal' and 'razoblamente' in the Spanish version, 'normal' and 'reasonably' in the English version, 'normale' and 'raisonnement' in the French version, and 'normale' and 'redelijkerwijs' in the Dutch version, also influences the examination to be undertaken by the court responsible for assessing the impact of any such alleged disclosure. The first can be defined as 'corriente o habitual', 'conforming to a standard; usual, typical or expected', 'ce qui est dépourvu de tout caractère exceptionnel; qui est conforme au type le plus fréquent', and 'overeenkomstig de regel, niets bijzonders of verontrustend; als norm dienend'. The second refers to what is claimed 'de manera razonable' or, that is to say 'proporcionada o equilibrada', 'to a moderate or acceptable degree' 'sans prétention excessive, sans trop exiger', or 'met billijkheid' or 'met verstand redenerend'. (12)

53. The persons concerned cannot therefore be asked to take special and far-reaching measures in order to become acquainted with an earlier design. As the Commission points out in its written observations, if the probability that the events were not known is greater than the probability that they were, they cannot be regarded as having become known in the normal course of business. In other words, it is appropriate to a certain extent to refer to the *quod plerumque fit*. (13)

54. In order to answer the question from the national court, it is therefore necessary to put oneself in the place of professionals operating within the territory of the European Union and to ask whether they could have acquired knowledge, reasonably and in the normal course of business, of the design in the manner claimed.

55. These various interpretative parameters lead me to the view that presentation of a design in a showroom of only one undertaking, which, moreover, is situated in China, is not sufficient to give rise, in the normal course of business, to knowledge of the design by specialised circles operating in the European Union. On the other hand, the position would be different if the design had been presented in China, for example, at a well-known international fair in which the main or most of the European protagonists in the relevant sector participated. (14)

### C – The third question

56. By its third question, as in the case of the fourth and fifth questions, the Bundesgerichtshof asks the Court about the rules of procedure applicable to actions under Article 19(2) of the Regulation (prohibition on grounds of infringement). The third question is concerned more particularly with the burden of proving that the disputed use derives from a copy of the protected design.

#### 1. General background

57. Title II of the Regulation is headed 'The law relating to designs'. Article 19 of the Regulation is the first article in Section 4, which is entitled 'Effects of the Community design'. That article itself has the heading 'Rights conferred by the Community design'. The first paragraph of Article 19 states: '[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 second paragraph of Article 19, for its part, provides that '[a]n 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.'

58. According to recital 22 to the Regulation, '[t]he enforcement of these rights is to be left to national laws', since the Regulation only provides for 'some basic uniform sanctions in all Member States.'

59. Moreover, Article 88 of the Regulation expressly endorses that recital by providing, in paragraphs 2 and 3, that '[o]n all matters not covered by this Regulation, a Community design court shall apply its national law, including its private international law' and that, subject to any contrary provision of the Regulation, it 'shall apply the rules of procedure governing the same type of action relating to a national design right in the Member State where it is situated'.

60. Article 85(2) of the Regulation nevertheless 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.'

61. The two last-mentioned articles form part of Title IX of the Regulation, entitled 'Jurisdiction and procedure in legal actions relating to Community designs'.

#### 2. Analysis of the relevant articles of the Regulation

62. It is clear from the structure of the Regulation, as briefly described above, that no rule of procedure can be inferred from Article 19(2) of the Regulation.

63. On the contrary, that Article is the provision which lays down the substance of the right of a holder of a Community design, regardless of any procedural consideration: the holder of an unregistered Community design is entitled to prohibit various acts, provided that the disputed use derives from a copy of the design in question.

64. Moreover, it is apparent from recital 22 and Article 88 of the Regulation that determination of the rules of procedure — including the burden of proof — is a matter for each national legislature. (15) Moreover, I endorse the Commission's view, in so far as it states in its written observations that Article 85(2) of the Regulation cannot be applied by analogy. I also consider that that provision refers only to the burden of proving fulfilment of the conditions laid down in Article 11 of the Regulation for the purpose of securing protection of the unregistered Community design, not that of proving use of a copy of that design.

65. It is therefore appropriate, at this stage, to say in reply to the referring court that Article 19(2) of the Regulation cannot be interpreted as meaning that it is incumbent upon the holder of an unregistered design to prove that the disputed use derives from a copy of that design, that issue being a matter for the national legislature. In those circumstances, it would therefore be inappropriate to answer question 3(b), which asks the Court about a possible reversal of the burden of proof or possible easing of that burden.

66. However, the general aim pursued by the Regulation and the answer given by the Court to a similar question regarding trade-marks prompt me to examine this matter further.

3. Considerations based on trade-mark law

67. In the *Class International* case, (16) the Court was asked to consider the burden of proof in proceedings relating to infringements of Community trade-marks. By way of introduction to its answer, the court observed that 'the issue of proof is raised when a dispute arises, that is to say, when the trade-mark proprietor pleads interference with the exclusive rights conferred on it by Article 5(1) of [First Council] Directive [89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade-marks] (17) and Article 9(1) of [Council] Regulation [No 40/94 of 20 December 1993 on the Community trade-mark]'. (18)

68. That situation is very similar to the one with which we are concerned here. First, the right in question — the right to prohibit certain uses of an identical or similar trade mark — is, *mutatis mutandis*, identical to the right provided for by Article 19 of the Regulation regarding designs. Second, the systems for settling disputes established by the two abovementioned regulations are similar. (19)

69. In the case giving rise to the judgment in *Class International*, Advocate General Jacobs arrived at a solution similar to that which I have just advocated. In his view, it is apparent from the recitals to regulation on the Community trade-mark that the burden of proof is covered by national procedural rules and that in a 'situation where a trade-mark proprietor is seeking to prevent a trader from using his mark in the course of trade ...' there are no 'coherent reasons [for derogating from the fact that it is the] national rules on the burden of proof [that] should apply.' (20)

70. However, the Court did not follow the Advocate General and, on the contrary, decided that, in a

situation such as the one before it (which seems to me comparable to the present case) 'the onus of proving interference [with the exclusive right] must lie with the trade-mark proprietor who alleges it [and that,] [i]f that is proven, it is then for the trader sued to prove the existence of the consent of the proprietor to the marketing of the goods in the Community.' (21)

71. In view of the structural and substantive closeness of Regulations Nos 40/94 and 6/2002 and of the protective mechanisms which they establish and because of the closeness of the objectives pursued by those two instruments, I am therefore inclined to take the view that the decision adopted by the Court in the case giving rise to the judgment in *Class International* must be transposed to the law on designs.

72. As pointed out by Advocate General Mengozzi, at point 6 of his Opinion in the case giving rise to the judgment in *FEIA*, '[a]s is clear from the recitals in the preamble to the Regulation, the purpose of establishing a Community design subject to a uniform set of rules throughout the Community is ... to prevent identical designs being protected differently and for the benefit of different owners in the various national legal systems as a result of the considerable differences still encountered between the laws of the Member States'. (22)

73. It is undoubtedly the case, as the Court held in *Class International* in relation to trade-marks, that 'if [the issue of the onus of proving infringement of the right of prohibition] were a matter for the national laws of the Member States, the consequence for trade-mark proprietors could be that protection would vary according to the legal system concerned. The objective of "the same protection under the legal systems of all the Member States" set out in the ninth recital in the preamble to the directive, where it is described as fundamental, would not be attained'. (23)

74. In the present case, since recital 1 to the Regulation states that 'uniform protection is given with uniform effect throughout the entire territory' of the European Union, it seems to me that the same reasoning can be perfectly well transposed to the law on designs.

4. Conclusion concerning the third question

75. In the light of all the foregoing considerations, I propose that the Court give the following answers to questions 3(a) and 3(b) submitted by the referring court: Article 19(2) of the Regulation contains no rule concerning the burden of proof. However, in circumstances such as those of the main proceedings, it is incumbent upon the holder of the unregistered design to prove the facts which would give grounds for exercising the right to obtain an injunction provided for in that article, by establishing that the disputed use derives from a copy of the protected design.

76. According to recital 22 and Article 88(2) and (3) of the Regulation, the specific rules regarding the burden of proof are to be laid down by the national legislature. The national courts will ensure that the principle of effectiveness is observed. Indeed, '[i]t is apparent from the case-law that the Member States

must ensure that evidential rules — and, in particular the rules on the allocation of the burden of proof applicable to actions relating to a breach of Community law — are, firstly, not less favourable than those that apply to similar domestic actions and, secondly, that they do not make it in practice impossible or excessively difficult for individuals to exercise rights conferred by Community law'. (24)

77. Consequently, as the Commission appropriately points out in its written observations, where the national court finds that, if the holder of a protected design is required to bear the burden of proof, that is liable to render impossible or excessively difficult the production of the necessary evidence (in particular because it concerns information which it is not possible for the owner of the right to have in his possession), it is then required to have recourse to all procedural means available to it under national law to mitigate that difficulty. It may, for example, resort to the mechanism of presumptions or various measures of investigation, such as the requirement on the part of either of the parties or a third party to produce a document or other instrument, (25) or decide that, in view of the evidence produced by the holder of the design, it is incumbent on the defendant to contest it in a substantive and detailed manner.

#### **D – The fourth and fifth questions**

78. The fourth and fifth questions submitted by the referring court concern rules on the extinction of rights over time and/or the time-barring of claims attaching to the right to obtain an injunction on grounds of infringement of an unregistered Community design, provided for in Articles 19(2) and 89(1)(a) of the Regulation. I therefore think that those questions can be dealt with together.

1. The 'special reasons' in Article 89(1) of the Regulation

79. As I have already indicated when examining the third question, the rights conferred by a Community design are set out in Article 19 of the Regulation.

80. Article 89 of the Regulation forms part of Title IX, 'Jurisdiction and procedure in legal actions relating to Community designs'. It is that article which specifies the penalties which may be imposed by a Community design court. They include, in particular, an injunction prohibiting the continuation of the contested infringing acts.

81. According to the first paragraph of that article, the Community design court may impose a sanction when it finds that the defendant has infringed or threatened to infringe a Community design 'unless there are special reasons for not doing so'.

82. In its decision, the referring court appears to include the extinction of rights over time among those 'special reasons'. (26) As regards the time-barring of claims, it expressly asks 'whether the situation to be assessed, from which the defendant infers that the aforementioned right is forfeited, satisfies the criterion of "special reasons" for not ordering prohibition laid down in Article 89(1)(a)'. (27)

83. I do not think, however, that any such comparison can be properly made.

84. If we refer to the explanations given by the Commission when putting forward its Proposal for a Regulation on Community designs, (28) 'special reasons' allowing derogation from an order imposing penalties might arise, for example, if, 'under the given circumstances a seizure of the goods would be pointless, or unduly harsh. Similarly, in certain cases the order to provide information could be void of any meaning, if for instance the infringer is the manufacturer of the infringing goods.'

85. What is relevant therefore is the factual situation, not procedural rules. This interpretation is confirmed by the case-law of the Court of Justice concerning the parallel provision under trade-mark law. According to the Court, 'the term "special reasons" relates to factual circumstances specific to a given case.' (29)

2. Determination of whether rights are extinguished through lapse of time and the claim time-barred: procedural autonomy

86. As I already had occasion to say when examining the third question, it is clear from recital 22 and from Article 88 of the Regulation that determination of the rules of procedure is a matter for each national legislature.

87. Whilst it is true that Article 15(3) of the Regulation speaks of a time bar, it relates only to proceedings governed by the first two paragraphs of that article, that is to say to claims relating to entitlement. (30) I also note that the Regulation is silent — in contrast to the Community trade-mark regulation (31) — on the matter of limitation. However, it does not seem to me that the prohibition of rules of that kind can be inferred from that silence.

88. Consequently, in the absence of European Union rules on the matter, those questions are, by virtue of the principle of procedural autonomy, a matter for the applicable national law in accordance with Article 88(2) and (3) of the Regulation.

89. In other words, the question whether the right to obtain an injunction referred to in Article 19(2) and Article 89(1)(a) of the Regulation is extinguished through lapse of time and/or may be time-barred and, where appropriate, what the rules should be for such extinction of rights and/or such time-bar, is a matter for the applicable national law in accordance with Article 88(2) and (3) of the Regulation.

3. Observations concerning the principles of equivalence and effectiveness

90. The case-law of the Court concerning limitation periods and time-limits is abundant. Three rules seem to me noteworthy:

– In the first place, whilst the principle of equivalence cannot be interpreted as requiring a Member State to extend its most favourable domestic rules to all actions brought in a particular area of the law, it is incumbent on the referring court 'to determine whether the procedural rules intended to ensure that the rights derived by individuals from EU law are

safeguarded under domestic law comply with that principle [of equivalence] and to consider both the purpose and the essential characteristics of allegedly similar domestic actions. For that purpose, the national court must consider whether the actions concerned are similar as regards their purpose, cause of action and essential characteristics'. (32) Article 88(3) of the Regulation itself expressly states that 'a Community design court shall apply the rules of procedure governing the same type of action relating to a national design right in the Member State where it is situated.'

– Next, the principle of effectiveness requires that a limitation period laid down by national law should not start to run until the date on which the holder of the right has or should have had knowledge of the infringement alleged. (33)

– Finally, as regards a procedure designed to prohibit continuing or repeated infringements, the national limitation period or time-limit rule cannot be drafted in such a way that a limitation period expires even before the infringement has been brought to an end. (34)

91. It is with those three rules in mind that the national court must apply the national law determining the limitation period and/or time-limit applicable to the procedure under Articles 19(2) and Article 89(1)(c) of the Regulation.

#### **E – The sixth question**

92. By its sixth question, the referring court asks the Court of Justice about the law applicable to the sanctions referred to in Article 89(1)(d) of the Regulation, such as those concerning, in this case, requests for destruction, information and compensation. Are those sanctions, not specified by the Regulation, governed by the law of the Member States in which the infringing acts were committed or by that of the Member State of the court seised?

93. According to Article 89(1)(d) of the Regulation, if it finds that the defendant has infringed or threatened to infringe a Community design, the Community design court may make 'any order imposing other sanctions [than those indicated in subparagraphs(a), (b) and (c)] appropriate under the circumstances which are provided by the law of the Member State in which the acts of infringement or threatened infringement are committed, including its private international law'.

##### **1. Scope of Article 89(1)(d) of the Regulation**

94. Before determining the law applicable to the 'other sanctions' referred to in Article 89(1)(d) of the Regulation, it is necessary to determine whether all the measures mentioned by the referring court — request for destruction, information and redress — in fact fall within that provision.

95. According to the Commission, only the request for destruction could be construed as falling within the scope of the 'sanctions' referred to in Article 89 of the Regulation. Relying on recital 22 to the Regulation, it considers that only measures capable of bringing the disputed conduct to an end are covered by that article.

96. I do not share that interpretation. On the contrary, recital 22 is drafted in such a way that the

explanation regarding the purpose of the sanctions refers only to 'basic uniform sanctions' considered necessary by the Union legislature: '[i]t is necessary therefore to provide for some basic uniform sanctions in all Member States. These should make it possible, irrespective of the jurisdiction under which enforcement is sought, to stop the infringing acts'. (35) Recital 31 adds that the Regulation does not preclude the application of other relevant rules of the Member States, such as those concerning civil liability.

97. The wording of Article 89(1) of the Regulation appears to me to reflect the various desires expressed in the abovementioned recitals. First, the Union legislature made provision for uniform basic sanctions, of such a kind as to bring infringing acts to an end. These are measures of prohibition and seizure specifically referred to in Article 89(1)(a), (b) and(c). Also, it is open to each national legislature to adopt other sanctions, such as damages. It is that possibility which is enshrined in Article 89(1)(d) of the Regulation.

98. The corresponding provision of Regulation No 207/2009 on the Community trade-mark, Article 102, is to the same effect. (36) Although it is clearly drafted in a less detailed manner, the same structure is to be found in that article as in Article 89 of the regulation on Community designs. The first paragraph of that article relates to the prohibitory measure and measures which 'in accordance with its national law ... are aimed at ensuring that this prohibition is complied with'. The second paragraph of Article 102 provides that 'the Community trade-mark court shall apply the law of the Member State in which the acts of infringement or threatened infringement were committed, including the private international law.' As explained by Advocate General Cruz Villalón in *DHL Express France*, that paragraph entails 'measures other than those ensuring enforcement'. (37)

##### **2. Determination of the law applicable to the 'other sanctions'**

99. The text of Article 89(1)(d) of the Regulation appears to be unambiguous. It authorises Community design courts to impose other sanctions 'provided for by the law of the Member State in which the acts of infringement or threatened infringement are committed, including its private international law'. It is therefore indeed a case of imposing, for each of the infringements committed, the sanction provided for by the national law applicable in that territory.

100. It is clear from the very wording of that provision that the Union legislature did not leave the choice of law applicable to the properly seized court. On the contrary, the law applicable is always the law (or laws) of the Member State (or Member States) in which the infringing act (or acts) was (or were) committed. It is therefore never a question of applying the law of the Member State of the court seised by reason merely of its territorial jurisdiction.

101. It is also to that effect that the corresponding provision of the Community trade-mark regulation has been interpreted by the Court. In *DHL Express France*,



the Court in fact followed Advocate General Cruz Villalón, according to whom ‘if the European Union legislature had intended that the law applicable to the measures ensuring compliance with a prohibition should be the same as that provided for in respect of the other measures to be adopted, Article 98(2) [now Article 102] would be redundant, since its function is precisely one of delineation, which can only be understood if the preceding provision has laid down a different rule. Article 98(2) states very clearly that the applicable law, in addition to entailing measures other than those ensuring enforcement, is “the law of the Member State [in] which the acts of infringement or threatened infringement were committed, including the private international law”. The brief reference to “national law” in Article 98(1) is in stark contrast to the reference in Article 98(2) to the *lex loci delicti commissi*, and it must therefore be concluded that these concern different conflict rules.’ (38)

102. I would add, finally, in conclusion, that that interpretation is not only shared by academic writers, (39) but is also the one adopted in Article 8 of Regulation No 864/2007 on the law applicable to non-contractual obligations, cited above.

#### V – Conclusion

103. In the light of the foregoing considerations, I propose that the Court answer the questions referred to it by the Bundesgerichtshof as follows:

(1) Article 11(2) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs must be interpreted as meaning that, in the normal course of business, a design may reasonably become known to circles specialised in the sector concerned, operating within the European Union, where images of the design have been distributed to traders operating in the sector concerned.

(2) Article 7(1), first sentence, of Regulation No 6/2002 must be interpreted as meaning that a design, even though disclosed to third parties without accompanying explicit or implicit conditions of confidentiality, cannot, in the normal course of business, be reasonably known to circles specialised in the sector concerned, operating within the European Union, if it has been made available to only one undertaking in those circles or has been exhibited only in the showrooms of an undertaking situated outside the territory of the European Union and outside the scope of normal market analysis.

(3) Article 19(2) of Regulation No 6/2002 must be interpreted as not containing any rules concerning the burden of proof. However, in a situation like that in the main proceedings, it is incumbent upon the holder of the unregistered design to prove the facts which give grounds for exercising the right to obtain an injunction provided for in that article, by establishing that the contested use derives from a copy of the protected design.

(4) In the absence of European Union rules on the matter, it is for the internal legal order of each Member State to determine whether a right to obtain an injunction prohibiting further infringement of an

unregistered design, provided for in Articles 19(2) and 89(1)(a) of Regulation No 6/2002 is extinguished over time and, if so, to determine the detailed rules applicable, provided that the principles of equivalence and effectiveness are observed.

(5) In the absence of European Union rules on the matter, it is for the internal legal order of each Member State to determine whether a right to obtain an injunction prohibiting further infringement of an unregistered design, provided for in Articles 19(2) and 89(1)(a) of the Regulation No 6/2002 is extinguished over time and, if so, to determine the detailed rules applicable thereto, provided that the principles of equivalence and effectiveness are observed.

(6) Article 89(1)(d) of Regulation No 6/2002 must be interpreted as meaning that requests for destruction, information and redress are governed by the national law, including private international law, of each Member State in which an act of infringement has been committed or threatened using the property in question.

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1 – Original language: French.

2 – OJ 2002 L 3, p. 1.

3 – OJ 2007 L 199, p. 40.

4 – Judgment of the High Court of Justice (England and Wales) Chancery Division (Patents Court) in *Green Lane Products Ltd v PMS International Group Ltd & Ors* [2007] EWHC 1712. The judgment was affirmed on appeal ([2008] EWCA Civ 358). That dispute did not concern Article 11(2) of the Regulation but Article 7 thereof. However, the terms at issue are identical in both cases, Article 7 also referring to ‘the normal course of business’ ‘to the circles specialised in the sector concerned’.

5 – This broad interpretation has also been looked on favourably by legal writers. See, to that effect, Tritton, G., *Intellectual Property in Europe*, 3rd ed., Sweet & Maxwell, London, 2008, in particular at p. 570, No 5 032; Smith, H., ‘Disagreement over “relevant sector” when determining prior art under Community design right’, *Journal of Intellectual Property Law & Practice*, 2007, vol. 2, No 12, pp. 795 and 796; Casado Cerviño, A. and Blanco Jiménez, A., *El Diseño Comunitario: una Aproximación al Régimen Legal de los Dibujos y Modelos en Europa*, 2nd ed., Thomson — Aranzadi, 2005, p. 44, and also Fernández-Nóvoa, C., ‘El diseño no registrado’, *Actas de derecho industrial y derecho de autor*, Vol. 24, 2003, pp. 81 to 90, in particular p. 86: ‘In the second place, it is necessary to determine the average level of information of those who make up the relevant sector: professional designers and specialist traders operating within the European Union’ (emphasis added; free translation of the following text: ‘En segundo lugar, habrá que establecer cuál es el nivel medio de información de que disponen quienes componen el pertinente sector: los diseñadores profesionales y los comerciantes especializados que operan en la Unión Europea’.

6 – Emphasis added.

- 7 – See, to that effect, Tritton, G., cited above, in particular p. 571; Fernández-Nóvoa, C., cited above, pp. 81 to 90, in particular p. 86. See, for an instance of application in national case-law, Hanseatisches Oberlandesgericht, 5 U 96/05, 7 June 2006. A summary of that decision was published, under the title ‘Chinese pre-publication precludes European Community unregistered design right’, in *Journal of Intellectual Property Law & Practice*, 2007, Vol. 2, No 7, pp. 441 to 443.
- 8 – Opinion of the Economic and Social Committee of 6 July 1994 on the proposals for a regulation of the European Parliament and the Council on Community designs and the proposal for a Directive of the European Parliament and the Council on the legal protection of designs (OJ 1994 C 388, pp. 9 to 13).
- 9 – See Article 5 of the Proposal for a Regulation of the European Parliament and of the Council on Community designs [COM (93) 342 final].
- 10 – See paragraph 3.1.4 of the abovementioned Economic and Social Committee opinion.
- 11 – Saez, V.M. ‘The unregistered Community design’, *European Intellectual Property Review*, 2002, Vol 24, No 12, pp. 585 to 590, in particular p. 587. Regarding the distinction between disclosure and perceived disclosure, see also Massa, Ch.-H. and Strowel, A., ‘Community design: Cinderella revamped’, *European Intellectual Property Review*, 2003, Vol 25, No 2, pp. 68 to 78, particularly p. 73.
- 12 – For the Spanish definitions, see *Diccionario del Español actual* (Manuel Seco, Olimpia Andrés and Gabino Ramos); 1999, for the English definitions, see *Oxford Dictionary of English*, 2nd ed., 2005; for the French definitions, see *Le Petit Robert, dictionnaire de la langue française*, 2003, and for the Dutch definitions, see van Dale, *Groot Woordenboek der Nederlandse Taal*, 1992.
- 13 – It is true that the adverb ‘reasonably’ does not appear in the German, Latvian, Romanian or Slovakian versions of Article 7 of the Regulation. However, the fact that it appears in 18 of the 22 language versions seems to me to be sufficiently significant to confirm the interpretation which is suggested, moreover, by the general scheme and the purpose of the Regulation and is not at odds with settled case-law according to which the wording used in one language version of a provision of EU law cannot serve as the sole basis for the interpretation of that provision, or be made to override the other language versions in that regard. Such an approach would be incompatible with the requirement for uniform application of EU law. Where there is difference between the various language versions, the provision in question must therefore be interpreted by reference to the purpose and general scheme of the rules of which it forms part (see, among others, the judgments in Case C-149/97 *Institute of the Motor Industry* [1998] ECR I-7053, paragraph 16, and Case C 451/08 *Helmut Müller* [2010] ECR I-2673, paragraph 38).
- 14 – Example given by Casado Cerviño, A. and Blanco Jiménez, A., p. 44).
- 15 – For a detailed study of the issue, see, to that effect, Mounicif Mougache M., *Les dessins et modèles en droit de l’Union européenne*, Bruylant, Brussels, 2012 (see, in particular, Chapter 2 of Title I in Part II). See also 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 y modelos comunitarios’, in *La marca comunitaria, modelos y dibujos comunitarios. Análisis de la implantación del Tribunal de marcas de Alicante, Estudios de Derecho Judicial*, No 68, Madrid 2005, pp. 119 to 198, in particular, p. 129.
- 16 – Judgment in Case C-405/03 [2005] ECR I-8735, paragraph 70.
- 17 – OJ 1989, L 40, p. 1.
- 18 – OJ 1994, L 11, p. 1. Following various amendments, Regulation No 40/94 was codified by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade-mark (OJ 2009, L 78 p. 1).
- 19 – The parallel between the two regulations has been made expressly clear from the outset. When presenting its draft regulation on Community designs, the Commission explained, with regard to Articles 83 to 89 concerning arrangements for settling disputes regarding Community designs (which became Articles 79 to 94 of the Regulation), that they ‘have been largely modelled on the corresponding provisions of the draft Regulation on the Community trade-mark’ [COM(93) 342 final, p. 46].
- 20 – Points 81 and 82 of the Opinion of Advocate General Jacobs in *Class International*.
- 21 – Judgment in *Class International*, paragraph 74.
- 22 – Judgment of the Court in Case C-32/08 [2009] ECR I-5611.
- 23 – Judgment in *Class International*, (paragraph 73).
- 24 – Judgment in Case C-55/06 *Arcor* [2008] ECR I-2931, paragraph 191.
- 25 – See, to that effect, the judgment in Case C-526/04 *Laboratoires Boiron* [2006] ECR I-7259, paragraph 55.
- 26 – ‘The Regulation contains no provisions that deal specifically with the limitation of the right to obtain a prohibitory injunction provided for in Article 89(1)(a). Article 89(1)(a) of the Regulation does, however, provide that, in the event of infringement or threatened infringement, a Community design court must order a prohibition unless there are special reasons for not doing so’ (paragraph 40 of the order for reference, emphasis added).
- 27 – Paragraph 44 of the order for reference.
- 28 – Proposal for a Regulation, cited above [COM (93) 342 final, page 51].
- 29 – Judgment in Case C-316/05 *Nokia* [2006] ECR I-12083, paragraph 38.
- 30 – Article 15 of the Regulation is worded as follows:  
*‘1. If an unregistered Community design is disclosed or claimed by, or a registered Community design has been*

*applied for or registered in the name of, a person who is not entitled to it under Article 14, the person entitled to it under that provision may, without prejudice to any other remedy which may be open to him, claim to become recognised as the legitimate holder of the Community design.*

*2. Where a person is jointly entitled to a Community design, that person may, in accordance with paragraph 1, claim to become recognised as joint holder.*

*3. Legal proceedings under paragraphs 1 or 2 shall be barred three years after the date of publication of a registered Community design or the date of disclosure of an unregistered Community design. This provision shall not apply if the person who is not entitled to the Community design was acting in bad faith at the time when such design was applied for or disclosed or was assigned to him.*

...

31 – See Article 54 of Regulation No 207/2009.

32 – Judgment in Case C-591/10 Littlewoods Retail and Others [2012] ECR, paragraph 31.

33 – See, to that effect, the judgment in Case C-46/08 Uniplex (UK) [2010] ECR I-817, paragraph 32.

34 – See, to that effect, the judgment in Joined Cases C-295/04 to C-/298/04 Manfredi and Others [2006] ECR I-6619, paragraphs 78 to 80.

35 – Emphasis added.

36 – This article reproduces Article 98 of Regulation No 40/94.

37 – Point 58 of his Opinion of 7 October 2010 in the case which gave rise to the judgment in Case C-235/09 DHL Express France [2011] ECR I-2801.

38 – Ibidem, point 58.

39 – According to Mouncif-Moungache, M., cited above, p. 333: ‘It appears that the court applies the regulation with regard to all orders issued by it. On the other hand, those penalties are implemented by the law of each Member State. This means that, in the event of an infringement taking place in various territories, the Community design court seised will be required to apply the various laws regarding calculation of reparation, confiscation or publication of notices’. See also, to that effect, Massa, Ch.-H., and Strowel, A., cited above, pp. 68 to 78, in particular p. 70: ‘Any other appropriate remedy under the national law of the place of infringement, including damages or an ‘astreinte’ (penalty for non-compliance), may also be granted. Thus, a CDC may sanction differently infringing acts committed in several Member States’.