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EU General Court: Chinese design does not infringe famous Italian scooter design

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By judgment of 24 September 2019 (T-219/18), the General Court ruled that the Community design of a scooter registered for a Chinese company does not infringe the rights of a traditional Italian company to its famous scooter.

Background

In 2010, a Chinese company registered the following Community design right with the EUIPO:



The Italian plaintiff, however, in 2014 filed an application for declaration of invalidity of the design. It argued that in view of a design which it had already made available to the public in 2005, the contested design lacked novelty and individual character. The plaintiff furthermore claimed that the design also infringed a corresponding three-dimensional trademark registered for the plaintiff in Italy and its copyright existing in France and Italy in its well-known scooter.



The EUIPO dismissed the application for invalidity. After an equally unsuccessful appeal, the Italian company brought an action before the General Court.

Decision

The General Court dismissed the action and confirmed the decisions of the EUIPO.

With regard to the alleged lack of novelty and individual character of the design at issue, the General Court first held that the overall impression of the design was very different to that of the plaintiff's design due to its significantly more angular contours. Therefore, it would have individual character. Secondly, the plaintiff would not have claimed in the proceedings that the Chinese scooter design lacked novelty so that there was no design right infringement altogether.

Furthermore, the General Court also noted that there were no serious objections against the Chinese scooter under trademark law. The relevant public would perceive the contested model visually differently from the plaintiff's model. Therefore, there would be no likelihood of confusion.

Eventually, infringement of copyright in the plaintiff's scooter also would be excluded. The core creative idea protected in this respect, an overall appearance with a "round, feminine and vintage character", would not have been subject to unauthorized use.

Comment

In view of the previous decisions of the EUIPO, the ruling of the General Court is hardly surprising. It remains to be seen whether the plaintiff will appeal the decision to the CJEU. This should at least become difficult as the relevant legal hurdles have recently been significantly raised: Since 1 May 2019, appeals in cases that have already been examined by an independent Board of Appeal and the General Court are only admissible if they raise a question that is significant with respect to the unity, consistency or development of EU law. In the present case, such an essential significance would probably be difficult to prove.

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