

visions suggesting otherwise,³²⁹ remains an unexamined right, granting its proprietor only a negative right to prohibit others the use of that design, but not granting him an absolute right to use it as long as it remains valid.

C. Invalidation based on a prior distinctive sign: novelty, individual character or Art 25(1)(e) CDR?

The community design, being a relatively novel legal instrument³³⁰ still reveals a considerable number of open questions. Some of them are the controversies connected to the application of Art. 25(1)(e) CDR, especially as far as employment of national laws is concerned. Furthermore, due to the evidentiary burden resting on the applicant, covering not only the evidence on facts but also on law, Art. 25(1)(e) does seem less attractive than the other ground for invalidation available for the owners of prior distinctive signs, i.e. Art 25(1)(b) CDR.

Even though when applying for invalidation of a Community design, the applicant can avail himself of many legal grounds simultaneously, the OHIM can base its decision on only one of them without referring to the others. As the information on the Invalidity Division decisions shows,³³¹ more often than on the ground of Art. 25(1)(e) the applications are successful on Art. 25(1)(b) CDR.

Whether this trend changes will depend on the expansion of the case-law on the Community design. A recent development in that respect was the definition of the “informed user” relevant for the assessment of the design’s individual character. In the *PepsiCo*³³² case, it has been suggested by the General Court and accepted by the Advocate General Mengozzi, that “the informed user is particularly observant and has some awareness of the state of the prior art, that is to say, the previous designs relating to the product in question that had been disclosed on the date of filing of the contested design, or, as the case may be, on the date of priority claimed”.³³³ This definition has been accepted by the CJEU who con-

329 Art. 19(1) CDR.

330 Entry into force on Mar. 6, 2002, see: Ruhl 2007, *supra* note 89, V.

331 See: Decisions on Invalidity concerning Community Designs available at: <http://oami.europa.eu/ows/rw/pages/RCD/caseLaw/decisionsOffice/invalidity.en.do> (last visited June 5, 2012).

332 CJEU Case C-281/10P – *PepsiCo, Inc. v Grupo Promer Mon Graphic SA*, O.J. (C 362) 9, available at: http://curia.europa.eu/jcms/jcms/j_6/ under the case number.

333 Opinion of Advocate General Mengozzi Case C-281/10P – *PepsiCo v Grupo Promer Mon Graphic SA*, May 12, 2011, available at http://curia.europa.eu/jcms/jcms/j_6/, under the case number, para. 45; it has been also suggested that comparison in the test for individual character should include a side-by side comparison, see: Anna Carboni, *The overlap between registered Community designs and Community trade marks* [2006] JIPLP 256, 262, later confirmed

firmed that this notion “must be understood as lying somewhere between that of the average consumer, applicable in trade mark matters, who need not have any specific knowledge and who, as a rule, makes no direct comparison between the trade marks in conflict, and the sectoral expert, who is an expert with detailed technical expertise. Thus, the concept of the informed user may be understood as referring, not to a user of average attention, but to a particularly observant one, either because of his personal experience or his extensive knowledge of the sector in question”.³³⁴ Hence it is submitted that this development will not result in a major change in the attractiveness of Art. 25(1)(e) CDR as ground for invalidation in comparison to the test for the lack of individual character.

It must nevertheless be stressed that the infringement test is not just a lower threshold of the individual character requirement. The tests of Art. 6 CDR, Art. 25(1)(b) CDR and of Art. 25(1)(e) CDR differ. The starting point of the assessment of the individual character is the design at issue. The informed user should compare it as a whole with the prior sign³³⁵ and if the additional or different elements of the design are such that they result in the design producing a different overall impression – the Community design will be deemed valid because it possesses an individual character. Conversely, the starting point of the assessment under Art. 25(1)(e) CDR is the prior sign and the decision whether it has been used in the design. If it has been used in the same form – the use is confirmed, regardless of any additional elements that the design might have, i.e. the design does not need to “limit itself” to the use of the prior sign to be using the sign and therefore be eligible for invalidation.³³⁶ The comparison is not made between the prior sign and the design as in Art. 6 CDR but between the prior sign and the sign constituting an element of the design. It is also made from a perspective of a relevant consumer, which in many cases will involve a lower level of attention than the informed user and make the infringement case easier to argue.

in CJEU Case C-281/10P – *PepsiCo, Inc. v Grupo Promer Mon Graphic SA*, O.J. (C 362) 9, available at: http://curia.europa.eu/jcms/jcms/j_6/ under the case number, para. 55.

334 CJEU Case C-281/10P – *PepsiCo, Inc. v Grupo Promer Mon Graphic SA*, O.J. (C 362) 9, available at: http://curia.europa.eu/jcms/jcms/j_6/ under the case number, para. 53.

335 Suthersanen, *supra* note 21, 114-115.

336 *Id.* 152.

