The European Court of Justice (CJEU) has handed down its decision in the case Ferrari v. Mansory Design on the scope of protection of Unregistered Community Designs (case C 123/20). This case is particularly relevant as it shines a new light on the scope of protection of part of a product under the Unregistered Community Designs (UCD) regime.

Background
Ferrari sought an injunction through the German national courts for infringements of their UCD on the Ferrari FXX K by Mansory Design. In December 2014, Ferrari had launched their new racing car by way of a press release showing images displaying a front and side view of the car. The main feature of the new Ferrari was the V-shaped element on the bonnet, which, according to Ferrari, “defines the facial features of the car and gives the car an association with a Formula 1 car”. Mansory Design, specialised in personalisation of high-end cars, is a manufacturer of so-called tuning kits. In 2016, they started the marketing of a tuning kit with the appearance of a Ferrari FXX K.

Ferrari claimed that Mansory’s tuning kits infringed three of their UCD, namely the V-shape element, the appearance of the front lip spoiler of the car, and the car in its entirety. Such UCD came to existence at the moment of the press release in 2014.

In first instance, Ferrari’s claims were dismissed in its entirety. The German court of appeal subsequently dismissed Ferrari’s appeal, deciding that only a UCD for the car in its entirety existed, but no infringement had taken place in the case at stake. Ferrari appealed the case up until the German Federal Court which held that the outcome would depend on the circumstances in which the appearance of a part of a product, specifically the V-shaped element, claimed by Ferrari may be protected as an UCD.

The Federal Court then referred the case to the CJEU asking the following questions:

1. Can an unregistered design in individual parts arise as a result product disclosure of an overall image of the product?

2. What criteria apply for assessing individual character when determining overall impression of the component part?

The Judgment

In a nutshell, the CJEU had to consider whether an image of the overall product could be interpreted as ‘making available to the public’ of only a part of the product, and if so, to what extent the appearance of that part of the product must be independent in relation to the overall product from an individual character point of view.

The CJEU held that for a design to be ‘made available to the public’, the publication of design images would suffice. However, the images should be sufficiently clear to allow the relevant part of the product to be identifiable. More importantly, there is no requirement to make every part of a product separately available, when seeking to obtain protection through a UCD. This would contradict the main function of an UCD, which is intended to provide protection without the burden of registration formalities.

Additionally, the Court provided more clarity on the interpretation of individual character. To that end, it is essential that the images of the product in its entirety clearly identifies the parts of the products to be protected. This means that for a design of a part of a product to have individual character, that design should be clearly defined by lines, contours, colours shapes and texture. These guidelines also apply in relation to components of complex designs.
Takeaways

The decision provides some new guidance on the scope of protection of UCD. It makes it easier for brands to rely on UCD, as the publication of an image of the entire product would make it possible to rely on UCD for parts of the product, provided that the appearance of the part is clearly identifiable. Therefore, it is important that images used for first publication of a product show multiple aspects of that product. This ensures that brands can maximise design protection by relying on individual parts of their design. Ultimately, UCD remains a valuable tool against infringers.

Sophie Verstraeten also contributed to this article.

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National Law Review, Volume XI, Number 333