

## GERMANY



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## CJEU rules on enforcement of unregistered Community designs

In *H Gautzsch Großhandel GmbH & Co v Münchener Boulevard Möbel Joseph Duna GmbH (MBM)* (case C-479/12), the Court of Justice of the EU ruled on specific legal questions regarding Articles 7 (1), 11 (2), 19 (2), 88 and 89 (1) of Council Regulation (EC) No 6/2002 on Community designs.

The background is an infringement action invoked by MBM against Gautzsch based on its alleged unregistered Community design relating to garden furniture (a canopied gazebo). Both the lower district and upper district court of Düsseldorf found Gautzsch to be infringing, and the company filed a further appeal with the Federal Supreme Court (BGH). The BGH stayed the proceedings and filed a request for a preliminary ruling under Article 267 TFEU on certain questions relating to the mentioned articles.

On disclosure under Article 7 (1), that is at what point a design shall be deemed to have been made available to the public, the Court held that disclosure can be denied even if a non-registered design has been made available to one undertaking in the relevant sector or disclosed by such an undertaking outside the EU; these questions are facts and to be decided by the respective Community design court. On the relevant circles specialised in the sector concerned in the meaning of Article 11 (2) the Court held that next to designers also traders may be considered, again this being a matter of facts.

As for burden of proof under Art 19 (2) demonstrating that the contested design reflects a result in copying the non-registered design, the Court held that, while the burden of proof rests on the owner of the design, the design court must ensure observance of the principle of effectiveness which from case by case may lead to adjust or lighten the burden of proof where otherwise the design owner is confronted with an undue burden of proof.

Furthermore, on the defence of

extinction of rights over time and forfeiture the Court held that the term “special reasons” in Article 89 (1) only relates to factual circumstances; therefore, such legal defences are not dealt with in regulation 6/2002 and thus must be considered under national laws in ensuring the principles of equivalence and effectiveness. Finally, on the question which court is competent on request for destruction of infringing products, the Court held that in view of Article 89 (a) which calls upon the pertinent design court to take all measures prohibiting further acts of infringement, only the national laws of the member state in which the act of infringement or threatened infringement have been committed are applicable; contrary hereto, as to requests for damages including providing information on the scope of infringing conduct, Article 89 is silent. Therefore, Article 88 kicks in following which the national laws of the addressed court are to apply.