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## **Legal framework**

French design law was modified by a decree of July 25 2001, which implemented the EU Designs Directive (98/71/EC). Under the doctrine of *l'unité de l'art*, designs and models are cumulatively protected in France under both copyright (Articles L111-3 and following of the IP Code) and design law (Articles L511.1 and following of the code). Although the conditions for protection under the two regimes are different ('originality' for copyright and 'novelty and individual character' for design law), the French courts usually considered that a registered design was eligible for protection under both copyright and design law when it was demonstrated that the design was new and benefited from an individual character, thus characterising the author's personality and enabling copyright protection.

However, another trend of case law tends to consider now that the conditions for copyright and design protection must be

assessed independently. Therefore, the courts have refused copyright protection to registered designs for lack of originality whereas they admitted protection under design law.

If the design was first published outside the European Union, copyright protection can be granted in France only if the owner can prove that the design is protected by copyright in its country of origin (Article 2(7) of the Berne Convention).

Under French law, any appearance or packaging of the whole or part of a product, including any two or three-dimensional figures, which differs from other existing products by "one or several exterior aspects giving it its own and new physiognomy" (Article L511-3 of the code) is eligible for protection as a design. Designs can be nearly anything – for example, lines, shapes, colours, textures, materials, industrial or natural products, packages, presentations, graphic symbols and fonts. The only elements which cannot be assimilated to a design or a model are:

- abstract concepts or genres;
- any shape that is hidden from view in the course of its normal use; and

- software (specifically excluded from design protection).

### Unregistered designs

Under French law, unregistered designs are eligible for copyright legal protection if the owner can demonstrate that the designs are 'original', meaning that the designs show the author's personality in their creation.

A design can also be protected as an unregistered Community design by virtue of Article 11 of the EU Community Designs Regulation (6/2002), provided that it complies with the condition of novelty, has individual character and has been disclosed to the public within the European Union (ie, 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 in the sector concerned operating within the European Union). For example, the French courts have protected as an unregistered Community design a design disclosed in the European Union through the diffusion of a catalogue and the realisation of a press campaign (Paris Court of Appeal, February 8 2013, *Ash Distribution v Christian Dior Couture*).

An unregistered Community design is protected for a period of three years from the date on which the design was first made available to the public within the European Union (Paris Court of Appeal, July 6 2012, *SA Christian Dior Couture v Versace France*).

Under French law, the rights in a design are granted to the creator or its successor in title (Article L511-9 of the code). In accordance with case law, in principle, if the author of the design does not claim ownership of it, a corporate entity which markets a product bearing or embodying the design under its own name is presumed to be the owner of an unregistered Community design (*Ash Distribution v Christian Dior Couture*).

This rule also applies to registered and unregistered designs which are protected by copyright.

### Registered designs

According to Articles L511-3, L511-4 and L511-8 of the IP Code, a registered design is valid if the following conditions are met:

- The design is new;
- The design benefits from individual character; and
- The design does not consist of features solely dictated by the product's technical function, or the exact form and dimension of the design need not be reproduced in order to allow it to be associated to another product mechanically by being placed against it, connected to it or placed inside or outside it in a manner that allows both products to perform their functions.

### Novelty

A registered design is new when no identical design has been disclosed before the filing date of the application for registration or before the date of the priority claim. Two designs are deemed to be identical if they differ in only insignificant details.

Any publication or disclosure of an identical design, including by the designer or another party, anywhere in the world by any means (including use or filing of a patent, trademark or prior registered design), may result in a determination that a subsequent design is not new.

If the publication or disclosure is made by the designer or its successor in title, a grace period of 12 months is provided during which any disclosure made by the designer or its successor in title does not destroy the design's novelty. This 12-month period is calculated as of the date of filing of the application or the priority date. The same applies if the design was made available to the public as a consequence of an abuse or unfair behaviour against the designer or its successor in title. Therefore, the signature of a non-disclosure agreement with any person involved in the creation of a design is vital in order to safeguard the owner's ability to file a registered design.

However, the absolute nature of the novelty requirement is slightly mitigated, as a design will not be considered to have been made available to the public if the disclosure of the design "could not reasonably have become known, according to the normal course of business in the sector concerned, by professionals operating in the European Community, before the date of filing of an application for registration or before the date of priority claimed" (Article L511-6 of the code).

Although this 12-month grace period allows enough time to consider design registration, note should also be taken of the six-month priority deadline set by Article 4 of the Paris Convention for the Protection of Industrial Property in order to benefit from the first registration date when extending protection of the design registration internationally.

### Individual character

A design has individual character when it produces in an 'informed observer' an overall visual impression which differs from any design disclosed before the date of filing of the registration application or before the priority date (the definition of 'informed user' provided in the Community Designs Regulation has been replaced by the notion of 'informed observer' in French law) To assess individual character, the French court must consider the designer's degree of freedom in developing the design.

The Supreme Court recently held (C Cass, com, April 3 2013) that the informed observer is not the customer for whom the product is intended, but rather an observer with particular vigilance by virtue of his or her personal experience or extensive knowledge of the sector. This definition is similar to that given by the European Court of Justice (ECJ) for Community designs (ECJ, October 20 2011, Case C-281/10 P *PepsiCo Inc v Grupo Promer Mon Graphic*; ECJ, October 22 2011, Cases C-101/11P and C-102/11P, *Neuman v José Manuel Baena Grupo*).

### Technical function

The design must not be dictated solely by its technical function. Design protection is not granted to features of appearance of a product which must be reproduced in the exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be assembled with another product, such that each may perform its function. However, a design allowing multiple assembly or connection of interchangeable products within a modular system is eligible for French design protection.

Thus, if the technical function is linked directly to the product's appearance, it may not be protected by the design. In such case, the only means of protection may be a patent, if the conditions for patent protection are fulfilled.

This may be the case when a specific shape leads to a technical effect, which is inseparable from the shape of the product.

### Spare parts

Designs which are part of a complex product, such as spare parts, are eligible for design protection to the extent that:

- the design, once it has been incorporated in the complex product, remains visible during normal use of the product by the end user, excluding maintenance, servicing or repair work;
- the visible features of the component part fulfil in themselves the novelty and individual character requirements; and
- the design is not dictated solely by its technical function.

Therefore, the French courts have allowed design protection for various vehicle parts (eg, lights, rearview mirrors, body, optics, bumpers, seat covers and bonnet).

### Procedures

To register a design in France, the applicant must file a design application with the French Design Office.

The application form must contain:

- a request for registration;
- the name of the applicant;
- the representation of the design;
- an indication of the product in which the design is to be incorporated or used;
- the classification of the product;
- the convention priority details, if any, and an official copy of the priority rights and/or the deed authorising the applicant to claim priority; and
- payment of the application fees.

An application can cover several designs, provided that they belong to the same category in the Locarno Classification (Locarno Arrangement, October 8 1968). There are no prerequisites for the samples of the design (drawing or picture), but they must allow hard-copy reproduction.

As described in Article R512-3 of the IP Code, the French Design Office is strict in its assessment of the sample provided: every sample must include only the design to be registered and no other elements (eg, word

elements, accessories).

The French Design Office proceeds with only a formal verification of the application; it does not check whether the design fulfils the conditions for design protection (novelty and individual character) and does not check prior rights. If irregularities are found, the French Design Office gives the applicant a deadline by which to amend or divide the application according to the Locarno Classification.

The registration is published in the *Official IP Bulletin*. With the exception of simplified proceedings, where deferment is a right, the applicant can ask that publication of the registered design be postponed, but such postponement can be granted for only up to three years. The applicant can still disclose the design at its own initiative.

A registered design is protected for five years, renewable up to a maximum of 25 years.

### **Enforcement Invalidity**

According to Article L512-4 of the IP Code, a registered design can be declared invalid by the court if the design:

- does not comply with the conditions for protection as a design (Articles L511-1 to L511-8 of the code);
- infringes the rights attached to an earlier design which was disclosed to the public after the date of the registration application or, if priority is claimed, after the date of priority, and which has been protected since an earlier date by the registration of a Community design, a French design, an international design designating France or an application to register such designs;
- infringes the copyright of a third party; or
- uses an earlier protected distinctive sign (eg, a trademark) without the authorisation of its holder.

The invalidity ruling has an *erga omnes* effect, which means that the invalidated design will be treated as if it had never existed. The ruling will be published in the National Designs Register.

### **Infringement**

The unauthorised use of a registered or unregistered design constitutes infringement.

In assessing infringement, the French courts take into account the overall visual impression that the design created for the informed observer, setting aside insignificant differences.

A design infringement lawsuit can be brought by the recorded owner of the registered design whose rights have been infringed, or by the exclusive licensee duly recorded with the French Design Office (unless there are contractual dispositions to the contrary, and provided that the design owner has not brought a lawsuit despite a formal notice), before either the criminal or civil jurisdiction. Before the criminal courts, an infringer faces a fine of up to €300,000 (or even €500,000 in certain circumstances) and imprisonment for up to three years. The criminal courts can also order the total or partial closure of the infringer's company. Before the civil courts, infringements are mainly punished by the award of damages that, in principle, must compensate the loss exactly. Punitive damages are not available under French law.

The French courts are usually quite protective of design rights and copyright holders.

### **Ownership changes and rights transfers**

As with any other IP rights (eg, patents or trademarks), any change of ownership must be recorded with the French Design Office in order to enable the assignee to enforce its design rights against third parties.

### **Related rights**

Apart from the double protection offered by copyright and design law as applied by French law, there is clear overlap between designs and trademarks, even if their respective conditions of protection and granted rights are different by nature. Therefore, the decision to register a trademark or a design must be considered seriously, taking into account the advantages and inconveniences of each type of protection. [WTR](#)

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