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## Community design courts find infringement of well-known GHD hair straighteners

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- 🕒 **First-instance judgment**
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On 26 February 2020 Section 8 of the Alicante Court of Appeal, acting as the Community Design Court, confirmed the infringement of Jemella Limited's Community design which had previously been declared by the first-instance Community design court (Alicante Community Design Court Number 1). The Community design in question protected the special shape of the well-known GHD IV Styler hair straightener (Figure 1).

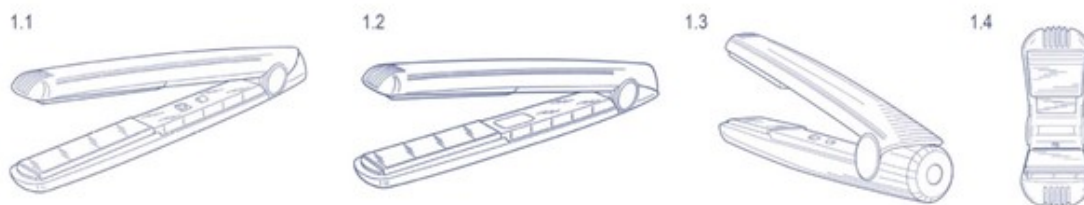
### First-instance judgment

In its judgment of 26 December 2018, Alicante Community Design Court Number 1 granted Jemella Limited's request for a declaration of infringement of its Community design and consequently ordered the defendant to:

- cease manufacturing, supplying, placing on the market, importing, exporting, using and storing the infringing products that were the object of the lawsuit;
- refrain from manufacturing, offering, putting on the market, importing, exporting, using and storing the infringing products in future;
- recall all units of the infringing product;
- destroy, at its own expense, the infringing products that it had recalled or was holding; and
- compensate Jemella Limited for damages.

The defendant filed an appeal against this judgment, arguing that it should be revoked because of the alleged error made by the court *a quo* in comparing the registered Community design and the infringing products.

In particular, the appellant argued that the lateral, upper and rear stripes shown in Views 1.1, 1.2 and 1.3 of the Community design's registration (Figure 1) were an ornamental element claimed by that design and should therefore be taken into account when comparing the infringing products with the registration.



**Figure 1**

Further, the defendant stated that the ornamental stripes were the only element which gave the Community design individual character and novelty, as the other shape elements were merely functional elements imposed by the technical result to be obtained by using the product.

Hence, the defendant claimed that the absence of such ornamental stripes on the infringing goods should lead to the dismissal of the infringement action brought by Jemella Limited.

### **Alicante Court of Appeal judgment**

The Alicante Court of Appeal rejected the defendant's arguments and confirmed the existence of infringement declared by the first-instance court on the following grounds.

The court established that in order to assess the scope and meaning of the repeated stripes shown in the Community design's registration, Article 4(1)(e) of the EU Regulation on the Implementation of Community Designs (2245/2002) must be taken into account. Under Article 4(1)(e), the quality of a representation must clearly distinguish the details of the object of protection.

Taking into account the above and Article 3(a) of the EU Regulation on Community Designs (6/2002), the Alicante Court of Appeal considered that Jemella Limited's Community design – which featured four perspectives formalised in drawings or graphical representations (not photographs or reproductions of the real product) – represented the shape of a product that was identified in the registration itself as a 'hair straightener'. The registration included no decorative or ornamental elements.

In this regard, the Alicante Court of Appeal reasoned that the lines or stripes shown in the registration were merely a graphic or pictorial resource to represent the product's smooth surface. Thus, the court established that the conflict between the registered Community design and the defendant's infringing products must be resolved solely on the basis of the product's shape, which was the object of protection of Jemella Limited's Community design.

Having clarified the above, the Alicante Court of Appeal made the following considerations in relation to the comparison between the registered design and the infringing products:

- When comparing the Community design's registration and the infringing goods, any decorative element (including colours and identifying signs) which were not part of the registration must be excluded.
- The author's degree of freedom with regard to the conflicting products (hair straighteners) was in no way limited, and there was clearly scope for creation with regard to the proportions and shapes of the product's structural elements, which could be curved, round, flat or otherwise. Further, no technical, functional or legal requirements limiting the author's degree of freedom had been proved.

In this regard, the Alicante Court of Appeal held that, in accordance with Article 8(1) of

EU Regulation 6/2002 and its interpretation by the European Court of Justice in *DOCERAM*, in order to assess whether the characteristics of a product's appearance are dictated exclusively by its technical function, it must be shown that this technical function is the only factor that determined those characteristics.

Applying these criteria to the case at hand, the court found that while certain features of hair straighteners are essential, there was no evidence that:

- the characteristics of the registered design's appearance had been dictated solely by considerations to ensure that the product fulfilled its technical function; and
- the characteristics linked to the design's visual appearance had played no role in that choice.
- As regards the concept of informed user, the court noted that the user is whoever uses the product for its designated purpose and the court considered that an informed user was someone who knows the sector because of their interest in the products at hand and pays a relatively high level of attention when using them.
- Finally, the Alicante Court of Appeal explained that the differences between the Community design and the infringing products would be perceptible only after a detailed examination of the designs by an informed user, which goes far beyond the assessment of the overall impression required by Article 10 of EU Regulation 6/2002.

In view of the above, the Alicante Court of Appeal confirmed the declaration of infringement of Jemella Limited's Community design and the consequent convictions.

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