Anatomy of a Design Regime

Kathryn C. Moore
Indiana University Maurer School of Law, moorekac@indiana.edu

Follow this and additional works at: http://www.repository.law.indiana.edu/ijgls

Part of the Intellectual Property Law Commons, International Law Commons, and the Transnational Law Commons

Recommended Citation
Available at: http://www.repository.law.indiana.edu/ijgls/vol22/iss2/17
Anatomy of a Design Regime

KATHRYN MOORE*

ABSTRACT

Since the European Union adopted uniform sui generis design rights, an increasingly complex system of cumulative and overlapping intellectual property rights has emerged. While such harmonization offers several benefits, analyzing the interpretation and application of narrow legal requirements within the EU Community Design Rights may indicate whether such benefits will actually be realized. This paper examines Regulation 6/2002's definitions of "informed user" and "overall impression" as they apply to registered designs. After summarizing relevant case law and considering underlying policy goals of the EU Community design legislation, this paper explores whether these definitions could be more efficient and intellectually honest if both the universe of invalidating prior art—relevant to a design's eligibility for protection—and the corresponding scope of protection were restricted by industrial sectors.

INTRODUCTION

By harmonizing existing national design laws through the EU Designs Protection Directive1 and creating its own freestanding design law regime through EU Regulation 6/2002's Community Design Right (CDR),2 the European Union replaced the "patchwork"3 of intellectual

* JD 2015, Indiana University Maurer School of Law; BA 2012, Murray State University. Special thanks to Professor Jason J. Du Mont for his valuable contributions to this Note, continued encouragement of my interest in intellectual property, and unfailing wit. Thanks also to my mother, Ursula Robertson-Moore, for reading this Note more times than she enjoyed, and to the Indiana University Center for Intellectual Property Research. IP is #1.


Indiana Journal of Global Legal Studies Vol. 22 #2 (Summer 2015)
© Indiana University Maurer School of Law

789
property laws with uniform sui generis design rights. Since then, an increasingly complex system of cumulative and overlapping intellectual property rights has emerged. While harmonization of international and domestic design law may present several benefits, including reducing "the cost, time and uncertainty involved in determining and/or acquiring rights, thus reducing barriers to innovation and to global trade," analyzing the interpretation and application of narrow legal requirements within the EU CDRs may indicate whether such benefits will actually be realized.

Rather than examine the EU Community design legislation as a whole, this paper examines Regulation 6/2002’s definitions of "informed user" and "overall impression" as they apply to registered designs. After summarizing relevant case law and considering underlying policy goals of the EU Community design legislation, this paper explores whether these definitions could be more efficient and intellectually honest if both the universe of invalidating prior art—relevant to a design’s eligibility for protection—and the corresponding scope of protection were restricted by industrial sectors.

I. EU COMMUNITY DESIGN RIGHTS: A BRIEF OVERVIEW

The EU Designs Protection Directive and Regulation 6/2002 are the main pieces of legislation for design protection in the European Union. While the 1998 Directive harmonized existing nationally registered design laws, Regulation 6/2002 created uniform EU-wide design rights. Part of the impetus for creating uniform design rights was the concern over dissonance in design right protections among EU Member States and what effect it would have on free trade. The Regulation states:

Identical designs may be . . . protected differently in different Member States and for the benefit of different owners. This inevitably leads to conflicts in the course of trade between Member States. The substantial differences between Member States’ design laws prevent

---

and distort Community-wide competition . . . . Enhanced protection for industrial design not only promotes the contribution of individual designers to the sum of Community excellence in the field, but also encourages innovation and development of new products and investment in their production.\(^6\)

The use of the word “enhanced” is not intended to broaden the scope of protection for designs.\(^7\) Instead, it has been interpreted to mean that no more than that design protection is desirable for the reasons given . . . if design protection is too wide, even for a strikingly innovative design, you are likely to discourage innovation and investment. Different designs will be caught or under the threat of being caught. Merely drawing inspiration from prior designs will become dangerous.\(^8\)

This policy concern, articulated in *Procter & Gamble Co. v. Reckitt Benckiser (UK) Ltd.*, is a central component of this paper’s analysis of the “overall impression” and “informed user” definitions (discussed *infra*).

While the duration and protections differ between registered and unregistered CDRs, both are subject to the same requirements and exclusions to be eligible for protection at all.\(^9\) Those who register their designs gain the exclusive right to prevent unauthorized use of designs that do not create a “different overall impression” on “the informed user,” whereas holders of unregistered design rights may only prevent unlawful copying of their designs.\(^10\) Expressly excluded from protection are “features of appearance of a product which are solely dictated by its technical function”\(^11\) or those “necessary for mechanical connectivity so that the product may perform its function.”\(^12\) Designs that fall outside of these exclusions are eligible for Community design protection depending on two elements: first, a design must be new, and second, it must have


\(^{8}\) Id.

\(^{9}\) See *TRADE DRESS AND DESIGN LAW 2014-15 SUPPLEMENT*, *supra* note 2, at 4-5.

\(^{10}\) Id. at 4.

\(^{11}\) Regulation 6/2002, *supra* note 2, art. 8(1).

“individual character” in comparison with other designs—a supplementary threshold that guards against protecting designs that differ insignificantly from prior art.\textsuperscript{14}

A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public.\textsuperscript{15} In assessing individual character, the degree of freedom of the design in developing the design shall be taken into consideration.

The individual character standard mirrors the definition of a design’s scope of protection for infringement purposes even though the individual character and infringement standards are explicitly addressed in different sections of the Regulation (Articles 6 and 10, respectively).\textsuperscript{16} Corresponding to the broad universe of designs that may be used as invalidating prior art for eligibility purposes under Article 6, Article 10 provides that “the scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression.”\textsuperscript{17}

There is no substantive examination of applications for CDR registration, making ease of application a swift and inexpensive process.\textsuperscript{18} The abolition of a substantive examination process for designs and the availability of protection for unregistered designs accommodate industries that produce a substantial number of designs that normally have a short commercial life.\textsuperscript{19} Nonetheless, one administrative requirement for CDR registration is that an application must include an indication of the products upon which the design is intended to be applied or the international class to which the products that incorporate the design belong.\textsuperscript{20} The assignment of a sector, while helpful for

\begin{itemize}
\item \textsuperscript{13} See Regulation 6/2002, supra note 2, art. 4(1).
\item \textsuperscript{14} See TRADE DRESS AND DESIGN LAW 2014-15 SUPPLEMENT, supra note 2, at 13.
\item \textsuperscript{15} Regulation 6/2002, supra note 2, art. 6(1-2).
\item \textsuperscript{16} See Regulation 6/2002, supra note 2, art. 6, 10.
\item \textsuperscript{17} Regulation 6/2002, supra note 2, art. 10(1). The parallel structure and language of the individual character and scope of protection standards can be a source of confusion, and courts sometimes conflate the respective analyses.
\item \textsuperscript{18} See TRADE DRESS AND DESIGN LAW 2014-15 SUPPLEMENT, supra note 2, at 3.
\item \textsuperscript{19} See id. at 49 n.6.
\item \textsuperscript{20} See id. at 20-21; see also Regulation 6/2002, supra note 2, art. 36(2-3).
\end{itemize}
cataloging purposes, is not critical insofar as protection is concerned.\textsuperscript{21} While such information is useful for searching purposes, invalidating prior art may come from any sector whatsoever. Consequently, the usefulness of design classification is questionable.

Overall, CDR holders enjoy broad protection under Regulation 6/2002. The breadth of such protection was illustrated in \textit{Green Lane Products Ltd.} v. \textit{PMS International Group PLC.}\textsuperscript{22} Green Lane manufactured “Dryerballs,” plastic spheres used in tumble dryers.\textsuperscript{23} PMS International Group PLC (PMS) manufactured similar designs earlier than Green Lane, but had marketed the balls as massage balls.\textsuperscript{24} In 2006, PMS began marketing the balls for other purposes, including as a laundry ball, hand exerciser, and dog trainer.\textsuperscript{25} Although a product may be assigned to a particular sector for search purposes, Regulation 6/2002 establishes protections for the design against any other form of design that does not produce a different overall impression on the informed user.\textsuperscript{26} Thus, protection transcends sectors even if a right holder only sought to bar marketing in the sector concerned (as may have been the case in \textit{Green Lane}, since Green Lane only sought enforcement of its rights once PMS began marketing its devices as laundry balls, rather than massage balls).\textsuperscript{27} Consequently, “if you register a design for a car you can stop use of the design for a brooch or a cake or a toy.”\textsuperscript{28}

\textit{Green Lane} is a particularly useful case for this analysis because it references both instances in which the “informed user” and “overall impression” definitions come into play—namely, during the “individual character” analysis for eligibility (and in determining which references may be considered as invalidating prior art) and the corresponding scope of protection for infringement purposes.\textsuperscript{29} Finding that the scope of protection grants “a monopoly over any kinds of goods according to the design,” \textsuperscript{30} the \textit{Green Lane} court concluded that the universe of invalidating prior art should transcend sectors as well. The nature of the product, however, complicates this analysis: “under \textit{Green Lane},

\begin{itemize}
\item \textsuperscript{21} See \textit{Green Lane Products Ltd.} v. \textit{PMS International Group,} [2008] EWCA (Civ) 358, [27] (Eng.).
\item \textsuperscript{22} See id. at 358.
\item \textsuperscript{23} Id. [3].
\item \textsuperscript{24} Id.
\item \textsuperscript{25} See id. [3].
\item \textsuperscript{26} See id. [27]; see also \textit{Regulation 6/2002, supra} note 2, art. 10(1).
\item \textsuperscript{27} See id. [3]–[4].
\item \textsuperscript{28} Id. [27].
\item \textsuperscript{29} See \textit{Regulation 6/2002, supra} note 2, art. 6, 10.
\item \textsuperscript{30} Green Lane Products Ltd. v. \textit{PMS International Group,} [2008] EWCA (Civ) 358, [79] (Eng.).
\end{itemize}
while the design’s nature will not impact the availability of a prior art reference for the one-to-one individual character analysis, the nature of the product could affect the overall impression left on the informed user by anchoring their expectations.\textsuperscript{31} While agreeing that the scope of protection and the scope of available invalidating prior art references should be commensurate,\textsuperscript{32} this paper explores whether, contrary to \textit{Green Lane}, they should be restrictive, rather than broad. \textit{Green Lane} may be interpreted as demonstrating that the breadth of CDR protection is excessive compared to the harm it seeks to address.

II. ELUSIVE DEFINITIONS: OVERALL IMPRESSION AND INFORMED USER

CASE LAW

A. \textit{Procter & Gamble Co. v. Reckitt Benckiser}

In \textit{Procter & Gamble Co. v. Reckitt Benckiser}, Judge L.J. Jacob reviewed the individual character requirement and analyzed who exactly constitutes the notional “informed user.”\textsuperscript{33} In this case, Procter & Gamble held a registered design right in a “sprayer” bottle (commonly seen with “Febreze” labeling).\textsuperscript{34} Reckitt Benckiser Limited, a UK company, manufactured an allegedly infringing design, consisting of a spray top affixed to a standard cylindrical canister. Procter & Gamble sued Reckitt Benckiser for infringement.

In his opinion, Judge Jacob began his analysis by addressing exactly who the “informed user” is and how discerning he or she must be in assessing differences in designs.\textsuperscript{35} He distinguished between the “informed user” of Community design rights and the “person skilled in the art” of patent law, finding that the latter standard would require a

\begin{itemize}
  \item \textsuperscript{31} \textit{Trade Dress and Design Law 2014-15 Supplement, supra} note 2, at 28.
  \item \textsuperscript{32} See Graeme B. Dinwoodie, \textit{Federalized Functionalism: The Future of Design Protection in the European Union}, 24 AIPLA Q.J. 611, 662-63 (1996) (“The Commission’s general acceptance of the necessary connection between the thresholds for protection and the scope of protection could be beneficial . . . . If a determination of ‘individual character’ influences the degree of difference required to escape infringement, the two concepts would operate as a control on each other. Minimizing the extent of difference required to demonstrate individual character might permit the protection of a greater number of designs, but it also should inform (i.e., lessen) the degree of distinction required to avoid infringement . . . . [S]uch a concept could serve as an important restraint on widely varying judicial interpretations of the protection accorded under this new regime.”).
  \item \textsuperscript{34} See id. [1].
  \item \textsuperscript{35} See id. [15]-[25].
\end{itemize}
degree of expertise beyond what was intended for assessing design infringement. Judge Jacob referenced Recital 14 for direction on determining the informed user, which states,

The assessment as to whether a design has individual character should be based on whether the overall impression produced on an informed user viewing the design clearly differs from that produced on him by the existing design corpus, taking into consideration the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs and the degree of freedom of the designer in developing the design.

Although Recital 14 related to a design's eligibility for protection rather than the test for infringement, Judge Jacob determined that some references in the Recital—while not expressly carried over into the Regulation—were relevant to the infringement analysis. Thus, Judge Jacob held that an informed user “must be taken to be aware of the ‘existing design corpus’”—a higher standard than that of the “average consumer” common to EU trademark law. While the average consumer of EU trademark law “perceives a mark as a whole and does not proceed to analyze its various details,” the informed user is one who “has experience of other similar articles [and] will be reasonably discriminatory – able to appreciate enough detail to decide whether a design creates an overall impression which has individual character and whether an alleged infringement produces a different overall impression.” Procter & Gamble illustrates that the informed user falls somewhere below the “person skilled in the art” of patent law and above the “average consumer” of trademark.

Judge Jacob further explained that an informed user is not only aware of an existing design corpus (although lacking in particular expertise) but is also cognizant of design issues—including functionality. In Judge Jacob’s opinion, the informed user is assumed to possess knowledge regarding which elements of design are dictated solely by function. Accordingly, Article 10(2) “is a narrowing provision ..
smaller differences will be enough to create a different overall impression where freedom of design is limited.”#42 While Article 8 provides some exclusions based on functionality, *Procter & Gamble* illustrates that, although it plays a part in the overall impression analysis (supplemented by an inquiry into freedom of design—discussed *infra*), CDR does not ultimately bar functional aspects of designs; rather, it factors them into the overall impression analysis as a matter of weight.#43

After identifying the informed user (as much as possible) and outlining the general principles regarding individual character assessment, Judge Jacob turned to the “different overall impression” test.#44 In noting that the test is “inherently rather imprecise,”#45 and litigants are “bound to leave a considerable margin for the judgment of the tribunal,”#46 Judge Jacob seemed to indicate that much of design infringement may be unpredictable until actually before a tribunal.#47 Despite admitting that the overall impression test is necessarily vague, Judge Jacob articulated several guiding observations: the “informed user is ‘fairly familiar’ with design issues;” protection for strikingly novel designs will be greater, inasmuch as there is correspondingly greater room for differences that do not produce a substantially different overall impression; courts must “don the spectacles of the informed user”#48 to assess the overall impression of both the design and the alleged infringing design—being wary of the level of generality in said court’s description; and finally, courts, after describing the overall impression created by each design, must ask whether the overall impression of each is different.#49

Judge Jacob assessed the lower court’s description of each design and found that the lower court erred in its analysis of overall impression.#50 In particular, the lower court erred by failing to apply the overall impression the judge had de facto described in his opinion and by failing to state the overall impression of the alleged infringing design. Further, the court erred by approaching or describing the

---

42. Id. [30].
43. See Du Mont & Janis, *supra* note 12, at 298.
45. Id.
46. Id.
47. Id. [35].
48. Id. [35](ix).
49. Id.
50. Id. [59].
dominant features of the design too generally—especially given functionality constraints.\textsuperscript{51}

\textit{Procter \& Gamble} provided some guidance on the "overall impression" test by narrowing the definition of informed user and outlining a process judges should follow in infringement analysis; however, the case left ample room for subjective interpretation—leaving evaluation of the informed user, overall impression, and degree of freedom a convoluted and inconsistent process still.

\textbf{B. Shenzhen Taiden Industrial Co. Ltd. v. Office for Harmonisation in the Internal Market}

This case arose when the Office for Harmonization in the Internal Market (OHIM) rejected Shenzhen Taiden's application for a declaration of invalidity of a conference-system communication unit designed by one of its competitors, Bosch Security Systems.\textsuperscript{52} The OHIM functions as the EU Trademark and Design Office,\textsuperscript{53} and the Boards of Appeal ("Boards") are responsible for deciding appeals against OHIM decisions concerning Community designs (and trademarks).\textsuperscript{54} In turn, the Boards' decisions are liable to actions before the General Court, whose judgments are appealable to the Court of Justice of the European Union (ECJ) on points of law.\textsuperscript{55} The Board reviewed the OHIM rejection and found that the design was new but lacked individual character because the degree of freedom of the designer was relatively wide, and the differences between the design and a prior art reference were insufficient to produce a different overall impression on the informed user.\textsuperscript{56} The General Court reviewed the Board's decision to evaluate whether, taking into account the designer's degree of freedom, the overall impressions produced by the respective designs were different.

The General Court emphasized the holistic approach to the individual character assessment, stating "[s]ince Article (6)1 of Regulation No 6/2002 refers to a difference between the overall impressions produced by the designs at issue, the individual character of a Community design cannot be examined in light of specific features

\textsuperscript{51} See id. [59](vi).
\textsuperscript{52} See Case T-153/08, Shenzhen Taiden Indus. Co. v. Office for Harmonisation in the Internal Mkt., 2010 E.C.R. II-2517 ¶¶ 1-5.
\textsuperscript{53} TRADE DRESS AND DESIGN LAW 2014-15 SUPPLEMENT, supra note 2, at 2.
\textsuperscript{55} Id.
\textsuperscript{56} Shenzhen Taiden, 2010 E.C.R. II-2517, ¶ 7.
of various earlier designs." The General Court recognized the role of functionality only insofar as it restricts the freedom of the designer. The court indicated that "account should be taken of the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs." Shenzhen discussed the definition of the notional informed user, stating,

[T]he status of 'user' implies that the person concerned uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended. The qualifier 'informed' suggests . . . that, without being a designer or a technical expert, the user knows the various designs which exist in the sector concerned, possesses a certain degree of knowledge with regard to the features which those design normally include, and, as a result of his interest in the products concerned, shows a relatively high degree of attention when he uses them.

Noting that the board identified the informed user as "anyone who regularly attends conferences or formal meetings at which the various participants have a conference unit with a microphone on the table in front of them," the Court then examined the degree of freedom of the designer.

The applicant argued that the designer's degree of freedom was restricted by the numerous features of conference units that are dictated by technical function and by a general market trend favoring particular designs. The Court rejected both assertions. First, the Court determined that although several features of a conference unit were necessary for it to function, there was no significant limitation on the ways in which such features could be designed or configured. While function restrictions "concern the presence of certain features in the conference unit, [they] do not have a significant impact on their configuration and, therefore, on the form and general appearance of the

---

58. See id. ¶¶ 54-56.
59. Id. ¶ 43.
60. Id. ¶¶ 46-47.
61. Id. ¶ 49.
62. Id. ¶ 52.
63. See id. ¶¶ 53-57.
conference unit itself." 64 Second, the Court dismissed consideration of general trends in a market as irrelevant to its analysis. 65 While the presence of such trends may have an influence on the commercial success of a product, the individual character assessment is concerned only with a difference in the overall impression produced by designs, "irrespective of the aesthetic or commercial considerations." 66 Finding that the board accurately identified the informed user and did not err in finding that the designer's freedom was relatively wide, the court concluded that the "stylised decoration on the contested design cannot offset the similarities found and is not, consequently, sufficient to confer individual character on the design." 67 Practically, Shenzhen illustrates that EU courts might not only take a broad view when defining the informed user but might also stress the importance of considering the designer's freedom.

C. PepsiCo, Inc. v. Grupo Promer Mon Graphic SA

PepsiCo 68 provides some clarification on both the informed user definition and the importance of the designer's degree of freedom. Grupo Promer sought to have PepsiCo's design for promotional items known as "pogs," "rappers," or "tazos"—game pieces in the form of small discs—declared invalid, asserting that, among other things, PepsiCo's design lacked individual character. 69 After a long and complex procedural history, PepsiCo appealed to the European Court of Justice (ECJ), with one part of the single ground for appeal concerning the definition of the informed user and his or her requisite level of attention. 70 The ECJ found that although the Regulation leaves the informed user undefined, it is to 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." 71 The ECJ endorsed the General Court's definition of the informed user in this case as a five- to ten-year-old child or a marketing manager "in a company that makes goods which are promoted by giving away 'pogs,' 'rappers,' or 'tazos.'" 72

64. Id. ¶ 54.
65. Id. ¶ 58.
66. Id.
67. Id. ¶ 73.
70. See id. ¶ 38.
71. Id. ¶ 53.
72. Id. ¶ 54.
The ECJ also noted that although the comparison of the designs should, when possible, be a direct comparison, it is acceptable to begin with the analysis premised on an indirect method of comparison based on an imperfect recollection. Additionally, the level of attention that the informed user should pay when making such an analysis, while not as minimal as the average consumer of trademark law, is also not on par with an expert or specialist who may be capable of observing minute differences that may exist between the designs in question. As the General Court previously asserted,

the qualifier 'informed' suggests that, without being a designer or a technical expert, the user knows the various designs which exist in the sector concerned, possesses a certain degree of knowledge with regard to the features which those designs normally include, and, as a result of his interest in the products concerned, shows a relatively high degree of attention when he uses them.

_PepsiCo_ helps clarify the definition of informed user and indicates that direct comparison should be made between the designs when possible. Nonetheless, determining the informed user and evaluating the overall impression of designs remain as somewhat vague notions.

### III. Analysis

The informed user and overall impression definitions are workable; however, limiting the scope of invalidating prior art and corresponding protection by sector could improve both. As a definition for informed user is notably absent from Regulation 6/2002, the daunting task of identifying such a person has been left to the courts. While the European judiciaries have significantly enriched the concept—in large part by determining whomever is _not_ the informed user—several issues arise in identifying this critical person.

First, I am hesitant to endorse the informed user definition because it does not readily match the broad universe of invalidating prior art and scope of protection. While the informed user definition makes sense if the contested designs are of the same form or nature, such as radiators or conference units, _Green Lane_ stresses that a design is protected across any form, and assignment to a particular sector is

---

73. See _id._ ¶ 55-58.
74. _Id._ ¶ 59.
merely a matter of administration, (supposedly) having no effect on the scope of protection for a design. If the forms differ significantly, how is a court to decide who constitutes the informed user—especially given how critical this notional person's perception is to the overall impression analysis?

A hypothetical illustrating this conundrum was discussed in Virtual Designs, an article by intellectual property scholars Jason J. Du Mont and Mark D. Janis. In Virtual Designs, the authors discuss emerging issues associated with design patent protection for software-generated icons, graphical user interfaces (GUIs), and "other visual elements of the virtual environment—collectively, 'virtual' designs." Among these emerging issues was the problem of comparing design patent claims, which may use broken-line designations to define the claimed design as independent of its environment, against prior art references that necessarily include or embrace their environmental aspects to determine whether the claimed design is anticipated. For example, consider the following Figure 1: a prior art reference (a daisy design on a flowerpot) and a design patent claim to a flower icon (using broken-line designations to indicate a generic screen display on which the icon may be displayed).

Figure 1


75. See Green Lane Products Ltd. v. PMS International Group, [2008] EWCA (Civ) 358, [27] (Eng.).
77. See id. at 164.
78. Id. at 164.
79. Id. at 165.
It may be conceptually difficult for the relevant observer to compare the daisy design on the flowerpot against the design patent claim to a software icon of a daisy when the product with which the icon is applied or incorporated is only represented by broken-line rectangles indicating a generic screen display.

When a design patentee claims a virtual design by depicting an icon in solid lines and an associated screen display as mere environment in broken lines, the result is an artificial construct. The relevant observer must first decode it, and then compare it to a prior art reference that will not necessarily delineate what is design and what is mere environment. The subtlety here is that the relevant observer is not a design patent expert who can readily engage in the mental exercise of ignoring the appearance of the associated environment, but rather he is the hypothetical ordinary observer who visually processes the world as it is. The potential problem is this: if the ordinary observer always views the prior art reference in its entirety, then mere environmental features disclosed in the prior art reference might be used as a basis for distinguishing the prior art reference from the claimed design. 80

Similarly, in an analysis of individual character, who would have been the informed user in this hypothetical? Would it be someone familiar with the design corpus for software icons, an avid flowerpot enthusiast, or someone possessing knowledge of both sectors? Judge Jacob recognized this issue in Procter & Gamble:

Where the alleged infringement is a quite different sort of product from that indicated as being the intended type, there may be problems about identifying the attributes of the informed user—is he a user of the kind of article such as the alleged infringement or a user of the kind of intended article? Or both? But none of that applies here. 81

80. Id. at 164.
The informed user falls somewhere between an average consumer and a person skilled in the art; an informed user is one who knows of various designs within the sector concerned, makes direct comparisons whenever possible, is aware of functional constraints, and is highly attentive and reasonably discriminatory. While such characteristics may help guide courts in assessing the informed user's overall impression, if the sectors concerned are dramatically different (e.g., flowerpot designs and software icon designs) defining the informed user may be an elusive and highly unpredictable practice. Overall, it seems likely that defining the informed user in the Virtual Designs hypothetical would have been demonstrably problematic.

First, because issues of infringement and validity are posed from the perspective of the informed user, creating a workable means for identification is critical. However, doing so may be unlikely when the universe of invalidating prior art references and corresponding scope of protection may transcend strikingly different sectors.

Second, there is some discrepancy over who can constitute the informed user in any given case. In PepsiCo, it was decided that the informed user could be either a marketing manager or a five- to ten-year-old child. While both would possibly have experience with the promotional items in question, on first impression, it seems as though these perspectives might be irreconcilable. Although both individuals may be reasonably discriminatory, it is unlikely that both will equally weigh the functional constraints of a design and the freedom of the designer. Moreover, it seems unlikely that both will have equal awareness of the existing design corpus. Hypothetically speaking, would a child between the ages of five and ten be aware of technical constraints, limited degrees of freedom, and minor variations of the prior art (and potentially, even saturation of the market) to the same extent as a marketing manager? Would the child pay equally close attention to the similarities of arbitrary features and the differences of compulsory ones or possess equal experience and capabilities in distinguishing necessary and unnecessary aspects of design? While possible, these are highly unlikely scenarios.

Since limiting the scope of protection for designs could assuage my doubts with the informed user definition, I turn now to the overall impression analysis and what effect slightly redefining the limits of CDR protection would mean in this context.

82. Id. ¶ 16, 24.
84. See Procter & Gamble, [2007] EWCA (Civ) 936, [17], [19], [21], [23]-[24].
The overall impression analysis embraces a holistic approach to evaluating designs. Use of the word "impression"—recognized as an effect, feeling, or image resulting from experience—suggests evaluation based on all sensory perceptions. Further, the qualifier "overall" stresses that the design is to be considered as a whole rather than dissected into its individual components. This aggregated approach manifests itself in the overall impression analysis's treatment of freedom of designer—an integral consideration of the informed user in deciding a design's overall impression. While freedom of design takes functional aspects of the design into account, it does so not as a complete bar but as having less weight than arbitrary features. While the informed user is aware of functionality constraints through familiarity with the products at issue, he or she is not responsible for drawing a line between those features dictated by function and those that are arbitrary. This seems to comport with deciding an overall impression as a whole.

While the analysis is still rather subjective, allowing for a method of weighing the various features of a design—without mandating outright exclusion—minimizes subjectivity and emphasizes a holistic approach. Further, although it could be argued that weighing various features is not how individuals actually perceive designs, the informed user would arguably be capable of such evaluation because he or she is charged with exercising more scrutiny and discrimination than the average consumer.

However, courts should aim for consistency when determining which considerations are weighed in overall impression analysis. Clear rules on how the designer's freedom may be limited—whether by statutory, technical, or market constraints—would provide for more uniform application of the law, consistency of outcomes, and thus, more predictable results (a worthy goal if judicial resources are strained and settlements are encouraged).

87. *See Trade Dress and Design Law 2014-15 Supplement*, supra note 2, at 101-02 ("[W]hen the designer's freedom is limited, minor variations over the prior art are often enough to warrant protection. When it comes to infringement, however, minor variations may also be enough to escape liability.").
88. *See Du Mont & Janis*, supra note 12, at 297-98 (noting that the informed user gives less weight to functional constraints of designs and greater importance to the remaining features).
89. *See Procter & Gamble*, [2007] EWCA (Civ) 936, [29].
91. *Id.* at 297 n.204.
ANATOMY OF A DESIGN REGIME

Intellectual property will always be an inherently imprecise area of the law, and there is no perfect test to determine infringement; however, the overall impression analysis is well-founded—especially given its holistic approach to design evaluation. Then again, the broad universe of invalidating prior art references and scope of protection creates issues with the overall impression analysis as well.

Recall the Virtual Designs hypothetical.92 Although the overall impression analysis suggests a holistic approach to evaluation, the daisy is only one feature of the flowerpot (although arguably its dominant visual element). It seems more intellectually honest to say that the contested designs obviously produce an overall different impression.93 The experience of each is strikingly different—one is three-dimensional with a particular feel, and the other is two-dimensional and more likely to be considered independent of the device on which it is displayed (the generic computer screen represented by the broken lines). Consequently, “the nature of the product could affect the overall impression left on the informed user by anchoring their expectations.”94 Nonetheless, the software icon design’s broad protection under CDR forces the informed user to dissect the flowerpot, thus focusing particular attention on only the flower.95 This being the case, an informed user would consider the materiality and substantiality of the prior art reference, rather than the overall impression derived from viewing both works as a whole. This disaggregated approach runs contrary to the “overall impression” that an informed user is supposed to assess.

Moreover, Green Lane seems to indicate that those who seek to protect their designs are most interested in protections for the sector concerned.96 Although an individual would undoubtedly be glad for success in any market, it seems excessive, given the concept of assessing a design’s overall impression, to allow such wide protection. If a second flowerpot designer produced a flowerpot design exceedingly similar to the first, then protection would certainly be appropriate, as the flowerpots are in direct competition with each other. When protection transcends strikingly different sectors, however, the breadth of CDR

92. Du Mont & Janis, supra note 12, at 165.
93. See Lionel Bently, Univ. of Cambridge, Designs Untethered (?) 29 (Nov. 3, 2012), http://www.cipil.law.cam.ac.uk/activities/DesignsUntethered.pdf (noting that “[t]he informed user will almost always regard a 2-d representation of a three-dimensional object as giving a different overall impression as a design”).
95. See Du Mont & Janis, supra note 12, at 114.
96. See Green Lane Products Ltd. v. PMS International Group, [2008] EWCA (Civ) 358, [3], [4] (Eng.).
protection—paired with relatively free and inexpensive registration—could stifle innovation, rather than incentivize it.

Additionally, limiting the scope of protection for designs based on sectorial registration would not bar designers from receiving intellectual property protection for their work. Designers may rely on copyright, trademark, unfair competition, and various other levels of protection for designs. Should a designer find that her designs are not protected in one sector because CDR was limited to another, the designer could pursue various other forms of protection afforded under the cumulative and overlapping regimes. Further, although limiting the universe of invalidating prior art and the scope of protection for designs could make for a more crowded landscape within individual sectors, it could also make for increased efficiency within the system as a whole and greater predictability of rights. Potential right holders could decide which sectors they should search in developing a design and could register that design for all sectors in which they intend to market the design. Classifying the design would thus be more useful for search purposes and would yield more predictable outcomes. This regime could further reduce consumption of judicial resources by allowing parties to be more certain of their rights prior to bringing the matter before a tribunal.

CONCLUSION

"[I]f design protection is too wide, even for a strikingly innovative design, you are likely to discourage innovation and investment. Different designs will be caught or under the threat of being caught. Merely drawing inspiration from prior designs will become dangerous." Limiting the universe of invalidating prior art references and corresponding scope of protection for CDRs could not only make the informed user more readily identifiable, but might also provide a more practical approach for the overall impression analysis. Individual character could still be analyzed by viewing the designs as a whole, but limited protection would allow for more realistic conclusions when assessing designs that differ significantly in form. Moreover, limiting protection could enhance global market transactions—as most right holders tend to be primarily concerned with their product sector, and those who seek to imitate successful designs would be barred from profiting within that sector. Further, if infringers imitated designs in a different sector, those who wanted to enforce their rights could likely do so under one of the increasingly cumulative and overlapping intellectual

---

property rights, including those in copyright, trademark, and unfair competition. Although Regulation 6/2002 sought to “promote[] the contribution of individual designers to the sum of Community excellence in the field, [and] encourage[] innovation and development of new products and investment in their production,” such broad production might not be the most efficient avenue to serve these aims. Rather than promote innovation, the breadth of CDR protection and relatively free, quick, and inexpensive registration could encourage monopolistic tendencies, hinder trade, and complicate judicial review.

In sum, the informed user and overall impression definitions, while workable, might be clarified and improved if the universe of invalidating prior art references and corresponding scope of protection for CDRs were restricted by sector. Restriction by sector could provide for greater certainty in acquiring rights on a global scale, consistent application of those rights and dispute resolution, and more efficient market transactions.