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NOVELTY REQUIREMENT IN EU DESIGN LAW**

Summary

At the end of 2024, the European Union amended its legislation in the field of legal protection of industrial designs. The aim of the changes was primarily to modernize the system and make it more attractive while leaving the core of the protection system unchanged. The author examines in the paper whether there were essential things that should have been altered regarding novelty as a condition of protection. In this regard, by applying the historical and legal-dogmatic method and analyzing case law, as well as the practice of the European Union bodies, he attempts to answer the question of whether the novelty requirement is at all necessary in the system of legal protection of designs in the European Union. The aim of the paper is to stimulate scientific debate on the necessity of constant reform and improvement of the system of protection of industrial design rights.

Key words: *Industrial design. – Novelty of industrial design. – Novelty examination. – Directive on the legal protection of designs. – Regulation on Community designs.*

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** Рад је резултат научноистраживачког рада аутора у оквиру Програма истраживања Правног факултета Универзитета у Крагујевцу за 2025. годину, који се финансира из средстава Министарства науке, технолошког развоја и иновација Републике Србије.

I Introduction

In the fall of last year, the European Union (EU) reformed its legislation on the legal protection of industrial design. Directive (EU) 2024/2823 on the legal protection of designs¹ represents a recast of the old Directive 98/71/EC on the legal protection of designs.² By Regulation (EU) 2024/2822 of the European Parliament and of the Council of 23 October 2024 amending Council Regulation (EC) No 6/2002 on Community designs and repealing Commission Regulation (EC) No 2246/2002³ the Regulation 6/2002 on community design⁴ was amended. Although there were a number of changes, the core of the system of design protection was left relatively untouched, as it stood test of the time and was accepted by the designers and undertakings. However, we believe that there are some essential changes that should be made and that the EU has missed an opportunity to correct the deficiencies of the system. One of those changes that had to be made is the fact that novelty requirement became unnecessary for the European system of design protection, or even that it was unnecessary in the first place. Therefore, we will first analyze the definition, concept, and types of novelty, and then the examination of novelty that is conducted under the EU system in order to check if novelty as a requirement is still necessary for the legal protection of industrial design.

II Types and the Concept of Novelty

Novelty as a requirement for design protection can be differentiated according to several criteria. Thus, the Swiss theory, before harmonization, distinguished between novelty in the formal sense and novelty in the material sense. Novelty in the formal sense is actually novelty in the narrower sense, which means the absence of an identical or nearly identical design anywhere in the world. On the other hand, material novelty previously meant originality and according to the new law individual character.⁵ Most of the theoreticians

1 Directive (EU) 2024/2823 of the European Parliament and of the Council of 23 October 2024 on the legal protection of designs (here-in-after: Design Directive), *OJ L*, 2024/2823, 18. 11. 2024.

2 Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs, *OJ L* 289, 28. 10. 1998, 28–35.

3 Regulation (EU) 2024/2822 of the European Parliament and of the Council of 23 October 2024 amending Council Regulation (EC) No 6/2002 on Community designs and repealing Commission Regulation (EC) No 2246/2002, *OJ L*, 2024/2822, 18. 11. 2024.

4 Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (here-in-after: Design Regulation), *OJ L* 3, 5. 1. 2002.

5 Roger Staub, Alessandro Celli, *Kommentar zum Bundesgesetz über den Schutz von Design*, Zürich, 2003, 55.

make a distinction between subjective and objective novelty, as well as between relative and absolute novelty.⁶ Subjective novelty implies that the novelty requirement will be met if the author of the design did not know that such a design existed anywhere and at any time in the world, while objective novelty implies that, regardless of the author's knowledge, such a design has never existed anywhere in the world. The division into absolute and relative novelty, on the other hand, is a subdivision in relation to objective novelty, since objective novelty can be understood absolutely (in the patent sense) that no such design has ever existed anywhere, and relatively, in which case this strict rule of patent law suffers certain limitations. This division is also considered the most significant because comparatively countries differ depending on whether they accept one or the other system. On the one hand, we have legal systems in which the concept of novelty is closer to the concept of absolute novelty in patent law. As a rule, in these countries, a substantive examination is also carried out in the design protection procedure. On the other hand, there are laws in which the novelty requirement is assessed relatively, differently than in patent law. In other words, in these countries, novelty is limited in some way, either temporally or territorially, or in terms of persons familiar with the design. As a rule, these countries do not carry out a substantive examination of the design but apply a simple deposit system. Perhaps the most interesting situation was in the earlier German law, which made a transgression from absolute novelty prescribed by law to objective relative novelty applied by the court in the *Rüschenhaupe* case of 1969, which stated that a design will be new if, by the date of filing of the application, such a design was not or could not reasonably have been known to specialized trade circles on the market of Germany and the countries with which the German economy cooperates.⁷

Both of the above approaches to novelty have advantages and disadvantages. The advantage of absolute novelty is that once novelty has been established, it can hardly be challenged in any country, which facilitates the protection of designs worldwide. This is also a disadvantage of the relative novelty system since there is always the possibility that a design may be challenged in a particular country. On the other hand, the relative novelty system facilitates examination and speeds up the procedure, while the

6 Gordian Hasselblatt, *Community Design Regulation (EC) No 6/2002*, München, Oxford, Baden-Baden, 2018, 78; Robert Stutz, Stephan Beutler, Muriel Künzi, *Designgesetz*, Bern, 2006, 115; Oliver Ruhl, Jan Tolkmitt, *Gemeinschaftsgeschmacksmuster*, Köln, 2019, 119; Helmut Eichmann, Dirk Jestaedt, *Designgesetz, Gemeinschaftsgeschmacksmusterrechtsverordnung*, München, 2019, 838; Peter Heinrich, *Schweizerisches Designgesetz, Haager Musterabkommen und weitere Erlasse*, Zürich, 2014, 146–147; Gertraud Redl, *Die Schutzvoraussetzungen des Gemeinschaftsgeschmacksmusters*, Wien, Berlin, 2007, 38.

7 Uma Suthersanen, *Design law in Europe*, London, 2000, 369.

examination of absolute novelty takes longer.⁸ However, the theory maintains that novelty in the sense of patent law is not a requirement that corresponds to the nature of industrial design. Namely, novelty as a requirement in patent law is, by its very nature, introduced in order to ensure priority in the legal protection of inventions. In other words, in order to accelerate economic development, the inventor who first invents is granted a temporary monopoly right to exploit the invention that he came up with. However, if such an invention already existed in the state of the art, the monopoly recognized in this way will not be progressive, since something that existed in the public domain is now transferred to the private portfolio of an individual. Society does not realize any benefit from the work of the inventor who would obtain the right for an already existing invention, because the development has not been achieved, and therefore there is no basis to recognizing him the monopoly on the exploitation of such an invention. Therefore, due to the importance and strength of the right that characterizes the patent, the novelty requirement must be strict and must imply that no one has ever come up with such an invention anywhere before.⁹ The situation is different when it comes to design. Namely, cultural development is by its nature circular, and not linear like technical development. Industrial design, therefore, unlike inventions, does not develop linearly, but circularly. This actually means that old styles and designs are rediscovered after some time and adapted to modern tastes. Figuratively speaking, design is “recycled”.¹⁰ Thanks to this, industrial design has a shorter circulation period – for some products, only one season of two to three months at most. Design is not an instruction for solving a technical problem that, once given, can function always and everywhere. An invention is conditioned by the laws of physics and chemistry which, at least when it comes to planet Earth, are valid everywhere and in every place. Therefore, the application of the instruction is not conditioned by space and time. On the other hand, design is conditioned by the market, perceptions in the market, the economic situation, and cultural and social influences, which depend on the time and space in which they are located. Therefore, it seems unfair and limiting to apply the same standard to design as an aesthetic creation and invention as a technological one. In theory, it is believed that for the development of art, novelty understood in the patent law sense is not progressive, but rather hinders the development of art, limiting

8 Vesna Besarović, *Intelektualna svojina*, Beograd, 2000, 136.

9 Sean B. Seymore, “Rethinking Novelty in Patent Law”, *Duke Law Journal*, No. 4/2011, 930.

10 Anette Kur, Marianne Levine, “The design approach revisited: background and meaning”, *The EU design approach* (editors Anette Kur, Marianne Levine, Jens Schovsbo), Cheltenham, Boston, 2018, 18.

the freedom of the author in his artistic expression and communication.¹¹ The essence of design is to make the object as beautiful and attractive as possible, which requires greater freedom of consideration. In other words, unlike inventiveness, which is an objective criterion in patent law, in design, there is no objective criterion that could evaluate and thus compare designs, but the criterion of essential similarity taken from copyright or trademark law should be applied.¹²

A solution in European Union law was also created on similar ideas. The editors of the Directive and the Regulation were of the opinion that the set condition of universal or absolute novelty was practically unattainable since there was no office that could examine all existing designs in the world. In practice, the novelty standard is always reduced to an examination that is limited by a temporal or territorial criterion. Moreover, it is very difficult to draw a distinction between old and new designs in the way that it is done in patent law. In addition, it is emphasized that there is no need to apply such a strict test as absolute novelty since the situation is significantly different from patents and inventions, for which maintenance in the public domain is much more important.¹³ Also, the criterion of absolute novelty was not in line with the aspirations of the textile and fashion industry of the European Union.¹⁴ Therefore, the Commission's first proposal implied novelty limited to the territory of the European Union, which meant that any design that could be considered new in the territory of the then common market could be protected. This understanding was criticized as the European Union's desire to "rob" the designs of small countries outside the Union, especially developing countries because their designs could be registered in the Union by other persons. For this reason, the criterion of absolute novelty was retained. However, this position was also criticized, because if the criterion of absolute novelty was applied, the right to an industrial design could be declared invalid even because of designs that were created a long time ago and in distant and unknown places.¹⁵

The Commission was therefore forced to take a different approach to the novelty requirement. It is thus stipulated that a design shall be considered new if no identical design has been made available to the public before the filing date, the recognized priority date, or, in the case of an unregistered

11 G. Redl, 41.

12 Orit Fischman Afori, "Reconceptualizing Property in Designs", *Cardozo Arts & Entertainment Law Journal*, No. 3/2008, 1135–1138.

13 European Commission, Green paper on legal protection of industrial design, Brussels, 1991, available at: <https://tind.wipo.int/record/19497?ln=en>, 8. 7. 2025, 67–70.

14 U. Suthersanen, 43.

15 A. Kur, M. Levine, 18–19.

design right, before the date of first making available to the public.¹⁶ This solution is specified and limited by the provision of Art. 6 of the Design Directive (Art. 7 of the Design Regulation), according to which an earlier design shall be considered to have become available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Union, before the date of filing of the application for registration or, if priority is claimed, the date of priority. By personal and territorial limitation, i.e. by limitation to circles specialised in the sector concerned and by limitation to the regular course of business, European Union law, following the practice of German courts,¹⁷ according to one part of the theory has accepted the option of objective relative novelty.¹⁸ This is also in line with the system of simple deposit for the recognition of rights provided in the Regulation. Another part of the theory believes that the so-called “grace period” and the prescription of relative secrecy of the design have mitigated the absolute effect of the novelty of the design, but not to the extent of making it relative.¹⁹ In our opinion, it is somewhat ungrateful to assess the harmonized solution in terms of whether it is relative or mitigated absolute novelty. The fact is that the Commission started from the idea of adopting a solution that would be objective relative novelty, but that absolute novelty was subsequently accepted with the addition of limitations. In fact, we believe that the aforementioned solution has given the assessment of the

16 Design Directive, Art. 4; Design Regulation, Art. 5 Par. 1.

17 In theory, the view has been expressed that this solution relies heavily on the aforementioned ruling of the German Federal Supreme Court (*Bundesgerichtshof*) *Rüschenhaupe*, Anette Kur, “Die Auswirkungen des neuen Geschmacksmusterrechts auf die Praxis”, *Gewerblicher Rechtsschutz und Urheberrecht*, Nr. 1/2002, 665.

18 Horst Peter Götting, Justus Meyer, Ulf Vormbrock, *Gewerblicher Rechtsschutz und Wettbewerbsrecht*, Baden-Baden, 2020, 595; U. Suthersanen, 43; Paul Torremans, *Holyoak and Torremans Intellectual property law*, Oxford, 2019, 352; O. Ruhl, J. Tolkmit, 119; H. Eichmann, D. Jestaedt, 838; P. Heinrich, 160; G. Hasselblatt, 79; R. Stutz, S. Beutler, M. Künzi, 114; Ekkehard Stolz, *Geschmacksmuster- und markenrechtlicher Designschutz*, Baden-Baden, 2002, 116; Alexander Bulling, Angelika Langöhrig, Tillmann Hellwig, *Geschmacksmuster, Designschutz in Deutschland und Europa*, Köln, Berlin, München, 2006, 43; G. Redl, 38.

19 Thomas Margoni, “Not for Designers: On the Inadequacies of EU Design Law and How to Fix It”, *Journal of Intellectual Property, Information Technology and Electronic Commerce Law*, No. 3/2013, 229; Lena Schickle, “Protection of Industrial Design in the United States and in the EU: Different Concepts or Different Labels”, *Journal of World Intellectual Property*, No. 1–2/2013, 24; Charles Gielen, Verona von Bombhard, *Concise European Trade Mark and Design Law*, Alpe aan den Rijn, 2017, 644; Zoran Miladinović, Siniša Varga, “Uslovi i postupak za priznanje prava na industrijski dizajn u Republici Srbiji”, *Pravni život*, No. 11/2011, 689; Lionel Bently, Brad Sherman, Dev Gangjee, Phillip Johnson, *Intellectual property law*, Oxford, 2018, 768.

character of novelty into the hands of the courts and authorities that apply the rule. Depending on the circumstances of the specific case and in particular the perception in the market and socio-cultural circumstances, the court may give novelty a more “absolute” or “relative” character.

III The Examination of Novelty

1. The State of Art

The state of the art (germ. *Formenschatz*) is the starting point for determining novelty. As explained in the previous section, it primarily covers any design that has become available to the public at any time and from any location, but under additional conditions that limit this scope. The aforementioned provision limiting novelty is called the “safeguard clause”, because its task is to prevent the right to an industrial design from being weakened too much by being constantly subject to invalidity proceedings, due to earlier objects of protection located in museums and in distant places, of which European industry could not possibly know.²⁰ The safeguard clause introduced two legal standards – professional circles specialized in the sector concerned and the regular course of business, which should determine in which cases a design, will be considered to have become available to the public.

Professional circles specialized in the sector concerned are defined as economic entities engaged in the production of goods that are designed, including designers engaged in design in that sector.²¹ In the case of *H. Gautzsch Großhanden GmbH & Co. KG v. Münchener Boulevard Möbel Joseph Duna GmbH*,²² the Court of Justice of the European Union, in response to a question from the Federal Supreme Court of Germany (*Bundesgerichtshof*), clarified that, in addition to companies engaged in design, professional circles necessarily include traders, i.e. companies engaged in trade in that sector. The Advocate General also pointed out in this case that the knowledge of one person with an earlier design is not sufficient, since the decision refers to a larger number of persons (“professional circles”).²³ A very important

20 U. Suthersanen, 43.

21 Z. Miladinović, S. Varga, 689.

22 Court of Justice of European Union, *H. Gautzsch Großhanden GmbH & Co. KG v. Münchener Boulevard Möbel Joseph Duna GmbH*, C- 479/12 of 13. 2. 2014, Par. 30. In this case, the issue was the novelty of a design for a decorative tent (porch) that was made available to the public for the first time by displaying an image of the disputed design at a closed presentation by a company in China.

23 Opinion of Advocate General Wathelet in *H. Gautzsch Großhanden GmbH & Co. KG v. Münchener Boulevard Möbel Joseph Duna GmbH* of 5. 9. 2013, Par. 38.

aspect in this regard is the sector of the economy to which the contested design relates since the definition of the relevant sector will depend on the notion of the professional circles specialised in the sector concerned.²⁴ According to the theory, the relevant sector should be taken into account in relation to the earlier design, and not the contested one, although in most situations it will be the same relevant sector.²⁵ Moreover, the knowledge of the professional circles should not be limited to a narrow group of subjects or things, since their knowledge regularly extends to other fields.²⁶ This definition of the relevant sector should not be confused with the definition of the relevant sector in trademark law. The definition of the relevant sector of the economy in trademark law aims to establish the likelihood of confusion and is directly related to the scope of the right. In contrast, the determination of the relevant sector in the novelty test serves to examine whether the earlier contested design could have been known to the relevant business circles in the European Union market, without any (or at least immediate) impact on the scope of the right.²⁷

The second legal standard implies that the professional circles specialized in the sector concerned became aware of the design in the ordinary course of business in the country. The meaning of this term will depend on the specific situation, but it is certain that all designs in the register must fall under this term. In other situations, it will be the task of the competent authority to determine, through experts and specialists, which design the professional circles could have come to in the ordinary course of business. The understanding of the Swiss theory is particularly interesting here. Namely, the court should, taking into account the circumstances of the case, take into account as separate facts the economic proximity, i.e. the proximity of the sector in which the earlier design was used, the geographical proximity of the area in which the publication occurred, as well as the proximity of the publication in time, based on which it should assess the real possibility that the professional circles would become aware of the earlier design.²⁸ Moreover, with the development of communication and active cultural exchange, it is difficult to assume that a design that exists in any part of the world will be unknown to European professional circles.²⁹ This is precisely the question that arose in the case of *Crocs, Inc. v. Holey Soles*

24 R. Stutz, S. Beutler, M. Künzi, 120.

25 C. Gielen, V. von Bombhard, 645; L. Bentley, B. Sherman, D. Gangjee, P. Johnson, 766.

26 E. Stolz, 115.

27 Wolfgang Büscher, Stefan Dittmer, Peter Schiwy, *Gewerblicher Rechtsschutz, Urheberrecht, Medienrecht*, Köln, 2015, 1251; H. P. Götting, J. Meyer, U. Vormbrock, 594; E. Stolz, 115.

28 P. Heinrich, 152; R. Stutz, S. Beutler, M. Künzi, 122–124. Same opinions for German law see in G. Redl, 39.

29 U. Suthersanen, 43–44.

Holdings Ltd.,³⁰ in which the EUIPO Board of Appeal took the position that the fact that clogs were prominently displayed on a website, although the website itself was not established, nor was there a possibility of purchasing through the website, leads to the publication of the design of the clogs, since the Internet is a powerful information tool, and it is reasonable to assume that persons interested in the said goods will easily reach the website and become familiar with the design through search engines.³¹ Also, in theory, the opinion prevails that the publication of designs in the official gazettes of the offices of the economically most important countries, such as the USA, Canada, Japan, and China, cannot be considered unknown to professional circles in the European Union.³² However, in the aforementioned judgment in *H. Gautzsch Großhandeln*, the Court of Justice of the European Union was reserved regarding the possibility that business circles operating within the EU may become aware of a design that was displayed only once at a private presentation by a company in China, although the mere fact that the display took place on a market outside the European Union does not affect the possibility of such a design becoming known to specialized design circles.³³

The aforementioned provision also states that a design shall be new provided that it has not been disclosed to the public in one of three possible ways: by publication after registration and otherwise, exhibited, used in trade, and otherwise disclosed. The entire design does not have to be made available to the public, but only a part sufficient for the design to be reproduced must be made known. In doing so, a representation of the design – a drawing, photograph,³⁴ shape, or image – must be made available to the public.³⁵ Mental representations, including those materialized in the form of text (description of the industrial design), do not enter the state of the art³⁶ and will not be considered to have been made available to the public. However, if a visual reproduction identical to the one described could be created on

30 Office for Harmonization in the Internal Market, Board of Appeals, *Crocs, Inc. v. Holey Soles Holdings Ltd.*, R-9/2008–3 of 26. 3. 2010.

31 Viola Elam, “CAD Files and European Design Law”, *Journal of Intellectual Property, Information Technology and Electronic Commerce Law*, No. 2/2016, 153.

32 B. Büscher, S. Dittmer, P. Schiwy, 1252; H. P. Götting, J. Meyer, U. Vormbrock, 595; G. Hasselblatt, 79; Philipp H. Günther, Thorsten Beyerlein, *Kommentar Designgesetz*, Frankfurt am Mein, 2015, 37.

33 Court of Justice of European Union, *H. Gautzsch Großhandeln GmbH & Co. KG v. Münchener Boulevard MobilJoseph Duna GmbH*, C– 479/12 of 13. 2. 2014. Par. 32–33.

34 Confirmed in Court of Justice of European Union, case *Ferrari SpA v. Mansory Design Holding GmbH*, C-123/20 of 28. 10. 2021, Par. 20.

35 Z. Miladinović, S. Varga, 688.

36 Milenko Manigodić, *Industrijski dizajn – zaštita modela i uzoraka u zemlji i inostranstvu*, Beograd, 1988, 40.

the basis of the description, it is considered that the design would also be disclosed in that case.³⁷

In determining the scope of the state of the art, the question of the moment at which the state of the art is assessed is also very important. Design Regulation implies that the state of the art is assessed with regard to the date of filing of the application, as stated in the definition of novelty.³⁸ However, when it comes to the right to an unregistered design, the basic rule for the moment of assessing novelty becomes inapplicable. The regulation provides that an unregistered design will meet the condition of novelty if no identical design existed on the date on which the unregistered design was made available to the public. Making available to the public is interpreted in the same way as in the case of a registered design, i.e., the design will be made available to the public on the date on which it was published, put on the market, or otherwise disclosed if there was a reasonable possibility that the specialised professional circles in the ordinary course of business within the Community would have become aware of the said design. This determination of the time of novelty actually achieves uniformity in determining the scope of the state of the design for registered and unregistered designs. Exceptions to this rule are union and fair priority under the Paris Convention.³⁹ The deadlines for union and trade fair priority should not be confused or linked with the grace period.⁴⁰ The “grace period” means that an industrial design is not considered to have become available to the public if the industrial design was discovered by the author, his legal successor or a third party on the basis of information received from the author or his legal successor, or an action taken by one of them, provided that less than 12 months have elapsed from the moment the design was discovered to the moment of filing the application, i.e. to the moment of the requested priority right.⁴¹ This corrective fiction was introduced with the aim of enabling the designer or his successor to test the design on the market in a short period of time and assess whether such a design is worth protecting by law and paying fees.⁴² The intention of the European legislator was to meet the needs of industries where designs have a short lifetime and, acting in combination with the right to an unregistered

37 Z. Miladinović, S. Varga, 688; R. Stutz, S. Beutler, M. Künzi, 124–125.

38 Design Regulation, Art. 5.

39 Paris Convention for Protection of Industrial Property, Art. 4 Par. C Line 1) and Art. 11.

40 T. Margoni, 229.

41 Design Directive, Art. 6. Par. 2; Design Regulation, Art. 7 Par. 2.

42 Z. Miladinović, S. Varga, 688. The aforementioned exception was introduced because research showed that a large number of designers published their designs without prior registration, which subsequently led to the impossibility of later registration due to the lack of novelty. See A. Kur, M. Levine, 14.

design, to provide these sectors of the economy with adequate protection and to remedy the shortcomings of the registration system.⁴³ The 12-month period⁴⁴ was not determined by any objective criterion, but the Commission assumed that such a period was sufficient to provide adequate protection to all sectors.⁴⁵ However, since the grace period does not constitute a priority, if any third party working independently comes up with the same design during this initial period, the designer cannot prohibit him from exploiting such a design or from filing an application.⁴⁶ It is also very important to establish when applying this period that the published design was indeed the one that was subsequently applied for, otherwise the grace period will not apply.

2. Comparison of two designs

In order to determine whether a design is new, it is necessary to make a comparison between the contested design and the earlier design. This entails the need to clearly define the design whose novelty is being examined. The situation is somewhat different in the case of registered and unregistered designs. Namely, in the case of a registered design, it is much easier to determine the specific appearance of the design, since it is determined by the representation in application. It is important to emphasize that only the registered design is taken into account, regardless of how the design was subsequently put into market. On the other hand, in the case of an unregistered design, the court must determine from the evidence the exact appearance of the design at the time of first making it available. Therefore, in theory, it is proposed that owners must preserve catalogues, images, websites, and other evidence of the publication of the design, as well as the date of publication of the design.⁴⁷ In addition to the contested design, it is also necessary to determine the exact appearance of the earlier design. As in the previous case, the earlier design may be registered, but it also may not. In this case, it is somewhat easier in those systems in which substantive examination is not carried out. In the simple deposit system, the examination is carried out in the invalidity procedure, so the earlier design is defined by the application for declaration of invalidity. The need for clear identification of the contested and earlier designs is more prominent when it comes to novelty examination because even very minimal differences can be decisive. Therefore, the quality

43 European Commission, Green paper on legal protection of industrial design, 5–6.

44 Before harmonization, Serbian law provided a period of 6 months. V. Besarović, 136.

45 European Commission, Green paper on legal protection of industrial design, 46, 82.

46 T. Margoni, 229.

47 B. Büscher, S. Dittmer, P. Schiwiy, 1245; G. Hasselblatt, 81; L. Bentley, B. Sherman, D. Gangjee, P. Johnson, 761.

of the image of the representation or the evidence provided by the parties is often decisive.⁴⁸

When it comes to the comparison, according to the definition of the novelty requirement, a design will be new if an identical design has not become available to the public before the date of filing the application, i.e. the recognized priority right. It is clarified that an identical design is a design that differs from the design only in irrelevant details.⁴⁹ As we can see, the concept of identity is not taken in its literal linguistic meaning, but should be interpreted more broadly in accordance with the following interpretative provision. The reason for the broader interpretation of the concept of identity is primarily of a practical nature. It is very rare for there to be two identical designs. It is far more common for two designs to be almost identical, but with certain differences.⁵⁰ In practice, it is essentially never determined whether a design is truly identical or does not differ even in immaterial details, because in both cases there will be a lack of novelty. However, this opens the door to another dilemma concerning the interpretation of the concept of differences in irrelevant details. This is a legal standard that is left to the assessment of case law. What it primarily indicates is that, unlike the approach that was in place before harmonisation, the assessment should not consist of examining the similarities⁵¹ between the designs but rather of assessing the differences.⁵² According to the view expressed in the theory, it is first necessary to determine whether there are any differences between the two designs being compared and what they are. Only then should one proceed to assess whether these differences are significant or not.⁵³

The next question is which differences can be considered “differences in immaterial details”. This question is somewhat more theoretical since the design must achieve not only a difference in immaterial details but also a difference in the overall general impression, and therefore the definition of an immaterial detail is more significant from the perspective of theory and the determination of essential elements.⁵⁴ According to one view in theory, differences in the design characteristics mentioned in the definition of design (lines, contours, shape, etc.) can in no case be considered immaterial.⁵⁵ However, this should be accepted with reservations, because it is precisely

48 O. Ruhl, J. Tolkmitt, 122.

49 Design Directive, Art. 3; Design Regulation, Art. 5 Par. 2.

50 P. H. Günther, T. Beyerlein, 35.

51 M. Manigodić, 45.

52 B. Büscher, S. Dittmer, P. Schiwy, 1245; Z. Miladinović, S. Varga, 688.

53 David Stone, *European Union design law*, Oxford, 2016, 195–196.

54 P.H. Günther, T. Beyerlein, 36.

55 G. Hasselblatt, 84.

possible for very small differences in color shades to be recognized as differences in immaterial details, which is explicitly given as an example in the EUIPO Guidelines for examination of registered community designs.⁵⁶ Differences in immaterial details exist when they are so small that they can go unnoticed, that is if the observer cannot notice them without making a conscious effort.⁵⁷ It can also be said that differences in immaterial details exist when they are external to the design itself, i.e. appear to be additional to it, or if they do not contribute to the overall impression.⁵⁸ In this sense, the EUIPO Guidelines stipulate that identity between designs will exist if the later design contains every element of the earlier design. If there are different features in relation to the earlier design, they may be significant for the assessment of whether the design is novel, unless they are so immaterial that they can go unnoticed.⁵⁹ Bearing in mind that design is seen as a fusion of aesthetics and function, those features that have a technical, but not exclusively technical, character cannot be considered immaterial simply because they are technical.⁶⁰ In any case, they cannot be differences that create a different overall overall impression, since this would fall within the area of individual character requirement.⁶¹ Examples from practice include: minor changes in colors or fabric, minor differences in the appearance of the bottom of the shoe, minor differences in the shape or color of the decoration, etc.⁶²

It should be emphasized that when assessing novelty, design is assessed in its overall appearance,⁶³ and not in details, in contrast to the solution that existed under previous law.⁶⁴ In other words, after harmonization, the so-called “mosaic examination”, where only new innovative features of the product were taken into account, was abolished. By this earlier test, applied in patent law, it was examined whether there was a certain linear progress in the development of new shapes.⁶⁵ The starting idea of this examination system actually implies that a design, like a patent, is always at least partially based

56 EUIPO, Guidelines for examination of registered community designs, available at: https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/designs_practice_manual/Draft_Guidelines_2018/examination_of_design_invalid-ity_applications_en.pdf, 10. 8. 2025, 127.

57 L. Bentley, B. Sherman, D. Gangjee, P. Johnson, 771; G. Hasselblatt, 84.

58 D. Stone, 196.

59 EUIPO, Guidelines for examination of registered community designs, 127.

60 P. Heinrich, 163.

61 O. Ruhl, J. Tolkmit, 124.

62 H. Eichmann, D. Jestaedt, 839.

63 U. Suthersanen, 37; V. Elam, 155.

64 See. M. Manigodić, 46.

65 E. Stolz, 119.

on an earlier design, or discoveries, which are viewed as pieces of a mosaic. In this sense, the condition for protection will be met by certain design, if it represents such a well-matched mosaic of elements of earlier creations, which would not be obvious to the average designer.⁶⁶ The main consequence of this change is that, unlike the previous test, a design that is merely a combination of known elements from various pre-existing designs can meet the novelty requirement.⁶⁷

The question that is also controversial is the perspective of comparison of the two designs, i.e. whether the informed user standard should be applied in this case or not. The above problem arises from the fact that the provision that prescribed novelty did not specify either an objective or subjective test. If we apply a historical interpretation, the intention of the editors was to establish a two-level design test system, and the first level involves an assessment of the novelty requirement for which a more lenient standard of identity was applied. This would mean that the difference is assessed from the perspective of an expert in the specified field of design, who is able to notice almost all differences, both material and immaterial. In the second step, assessing individual character, the court should assess the similarity from the perspective of the consumer, i.e. the informed user.⁶⁸ However, even though it is an assessment by an expert in a particular field, according to the view expressed in the theory, it is an objective, not a subjective test that implies that the design is completely the same as the earlier design. Most theoreticians believe that novelty should be considered from an objective perspective since the legislator left the aforementioned provision without referring to a specific person, and applying the informed user's would be unjustified.⁶⁹ The theory also proposes objective criteria for this assessment: the degree of freedom of the author, increased concentration of the design (crowded prior art, germ. *Musterdichte*), application of the design to a new product or to a new means, or the fact that the design is a new arrangement of known design elements.⁷⁰ On the other hand, some authors note that there are no obstacles to the standard of novelty being examined from the perspective of the informed user.⁷¹ In this domain, the situation that existed in Serbian law is

66 Božin Vlašković, "Individualnost industrijskog dizajna", *Pravo i usluge* (editor Miodrag Mićović), Kragujevac, 2012, 562–563.

67 P. Torremans, 352–353; R. Stutz, S. Beutler, M. Künzi, 131; P. Heinrich, 164; E. Stolz, 120; G. Redl, 36.

68 European Commission, Green paper on legal protection of industrial design, 70–72.

69 V. Elam, 155; C. Gielen, V. von Bombhard, 639; O. Ruhl, J. Tolkmitt, 123; D. Stone, 196; U. Suthersanen, 113; G. Hasselblatt, 78. This is also the standpoint of the EUIPO, upon which these authors base their conclusion.

70 U. Suthersanen, 38.

71 H. Eichmann, D. Jestaedt, 838.

particularly interesting, since the Law on the Legal Protection of Design from 2004⁷² and the Law on the Legal Protection of Industrial Design from 2009⁷³ until the Law on Amendments and Supplements from 2015⁷⁴ contained a provision in paragraph 3 of the first Article, which stipulated that a difference in immaterial details exists if an informed user does not distinguish two industrial designs at first glance. However, the Law on Amendments and Supplements to the Law on the Legal Protection of Industrial Designs from 2015 deleted this provision, explaining that this was done due to the need to harmonize the material conditions for the recognition of industrial designs in all EU member states.⁷⁵ As correctly noted, opting for one approach or the other will most likely not produce any drastic differences, given that it is necessary to assess whether the two designs are identical, which cannot be that different from either the expert's or the informed user's perspective.⁷⁶

The theory raises the question of the importance of examining novelty in the European system of examination. Namely, according to the position of a large part of the theory, novelty is by its nature identical to individual character. In other words, the essence of both novelty and individual character is the difference of the design to the state of the art. The difference between them is only in the degree of difference that is required. Thus, for novelty to be fulfilled, it is sufficient that the design is not identical or that it does not differ only in immaterial details, while for individual character it is necessary that it creates a different overall impression. Therefore, since a design must meet both conditions in order to be protected, this means that it must always have a different overall impression that it leaves on the informed user, which automatically implies the absence of identity. In simpler terms, if a design has individual character, it will always be novel. Therefore, according to the position of one part of the theory, there is no separate field of application of novelty in relation to design.⁷⁷ Novelty, historically speaking, according to the idea that the commission had, should have provided the possibility of resolving "pure cases". In those situations where it is certain that two designs are identical, procedural economy would be achieved insofar as it would

72 Law on Legal Protection of Designs, *Official Gazette of Serbia and Montenegro*, No. 61/2004.

73 Law on Legal Protection of Industrial Designs, *Official Gazette of the Republic of Serbia*, No. 104/2009, 45/2015, 44/2018 (other law).

74 Law on Amendments to the Law on Legal Protection of Industrial Designs, *Official Gazette of the Republic of Serbia*, No. 45/2015.

75 Government of the Republic of Serbia, Draft Law on Amendments to the Law on Legal Protection of Industrial Designs, dated 25 December 2014, available at: <http://otvorenavlada.rs/pz-industrijski-dizajn076-cyr-doc/>, 10. 7. 2025.

76 L. Bentley, B. Sherman, D. Gangjee, P. Johnson, 771.

77 O. Ruhl, J. Tolkmit, 119.

not be necessary to prove the absence of individual character. However, in practice, it has been shown that this intention has not been achieved.⁷⁸ The primary reason for this is the fact that there is a very small number of so-called “pure cases” or cases with minimal differences, where one could certainly speak of the absence of identity. In addition, the very method of examination through the invalidity proceedings has contributed to the failure to achieve procedural economy. Namely, the party, who do not want to risk losing the procedure and paying the costs, will always rather dispute individual character, which implies the existence of a greater difference than a difference in insignificant details. Hence, as a rule, individual character will be disputed, independently or in combination with novelty, and very rarely novelty on its own. The greatest importance of novelty is from a formal aspect, since TRIPS prescribes the condition of novelty or originality as mandatory. Given the controversy regarding the compliance of the condition of individual character as a condition for protection with TRIPS, in order to meet the formal compliance with this international agreement, it was important to at least formally provide for the condition of novelty.

IV Conclusion

As we have seen from conducted research, novelty before harmonization played a crucial role, i.e., it was the most important and sometimes only condition for the protection of industrial design. However, at the time, novelty was accepted as absolute, meaning it had to be proven that the contested design had not been published ever before. With the introduction of individual character requirement and relativisation of novelty requirement, it practically became superfluous, which was only emphasized by the deposit system registration and invalidity proceedings. The fact that it was provided as a condition in TRIPS cannot be decisive since it holds no real meaning for design examination. Therefore, only formal compliance with TRIPS, we believe does not represent real alignment with this document. In our opinion, in some future reformation, the novelty criterion should be removed from design law, since there are only formal and historical reasons for it to be provided in design law. Hence, novelty requirement should be left where it belongs – in patent law.

78 C. Gielen, V. von Bombhard, 640.

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НЕОПХОДНОСТ НОВОСТИ КАО УСЛОВА ЗАШТИТЕ У ПРАВУ ЗАШТИТЕ ИНДУСТРИЈСКОГ ДИЗАЈНА ЕВРОПСКЕ УНИЈЕ

Сажетак

Крајем 2024. године Европска унија је новелирала своје законодавство у области правне заштите индустријског дизајна. Циљ измена је био првенствено да се систем модернизује и учини још примамљивијим, док би основа система заштите остала непромењена. Аутор у раду истражује да ли су постојале суштинске ствари које је требало изменити, а који се ипачу новости као услова заштите. У том смислу, он применом историјској и правно-доимайској метода и анализом судске праксе, као и праксе орјана Европске уније, покушава да одговори на питање да ли је услов новости уопште неопходан у систему правне заштите дизајна у Европској унији. Циљ рада је подстицање научне расправе о неопходности константној реформисања и унапређивања система заштите права индустријског дизајна.

Кључне речи: Индустријски дизајн. – Новост индустријског дизајна. – Истраживање новости. – Директива о правној заштити индустријског дизајна. – Уредба о комунијарном дизајну.

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