

IPEC makes first reference to CJEU

IPEC REFERS TWO QUESTIONS ON DESIGN REGULATION TO CJEU

Last week, in *Beverly Hills Teddy Bear Company v PMS International Group plc* [2019] EWHC 2419 (IPEC), Hacon sitting in IPEC made his first reference (and maybe his last) to the CJEU on an important point of design law – namely is it fatal to the subsistence of Community Unregistered Design Right (CUDR) if you disclose your design first outside the EU. A few years ago, in *Gebäckpresse II*, the Bundesgerichtshof (the German Supreme Court) said - yes, it was fatal and such was *acte clair* so there was no need to refer to the Court of Justice of the European Union.

In the IPEC proceedings, it was common ground that 5 designs for plush toys (for children) had been first published outside the EU at an international toy exhibition in Hong Kong and it was also common ground that such would have meant that the designs were known to circles specialised in the Community. Given this, the defendant brought an application for summary judgment to strike out a claim based on infringement of CUDR in 5 plush toy designs, relying upon *Gebäckpresse II*.

Counsel for the Claimant argued that the BGH had got it wrong. He said that not only had the BGH misinterpreted the Design Regulation (EC/6/2002) but that the BGH's interpretation was contrary to Art.3 TRIPS as it favoured EU nationals over non-EU nationals (as the latter would be less likely to first disclose their design in the EU as opposed to EU nationals).

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Following consideration of these submissions and textbook commentary, HHJ Hacon decided that the matters raised by the Claimant meant, contrary to the view of the BGH, were not *acte clair*, and accordingly referred two questions to the CJEU.

This reference is of great importance to practitioners advising their client on design law as often a design is first disclosed outside the EU. Hitherto, it had been thought that such meant that no CUDR subsisted. Now the CJEU shall have the opportunity to give its view.

Commentary on the judgment can be found [here](#) and the judgment can be found [here](#)

[Guy Tritton](#) represented the Claimant, Beverly Hills Teddy Bear, instructed by Bernard Whyatt

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