

Fashion Trends in EU Design Law: The CJEU's Judgment in Deity Shoes

In brief

- The Court of Justice of the European Union has clarified the requirements for design right protection under EU law, following some uncertainties around the interpretation of the EU Design Regulation.
- The court emphasised the distinction between copyright and design protection, confirming that no minimum degree of creativity is required for subject matter to merit design protection in the EU.
- The judgment provides useful guidance on the concept of 'individual character' and the extent to which a design produces a 'different overall impression' when compared to prior designs. It also focuses on (i) situations where features of a product are predetermined by a supplier and the designer simply makes ad hoc or incidental modifications to existing components; and (ii) the impact of fashion trends on design protection.
- With social media and the increasing globalisation of information driving the ebb and flow of fashion trends, this decision was a welcome opportunity to confirm the role trends play when assessing design right protection.

Background

The Court of Justice of the EU (CJEU) has delivered its judgment in [Deity Shoes. v Mundorama Confort., Stay Design](#) following a request for a preliminary ruling from the Commercial Court No. 1 in Alicante. The case relates to several Registered and Unregistered EU Designs owned by Deity Shoes for shoes based on existing models offered by its suppliers. Deity Shoes brought proceedings against Mundorama Confort and Stay Design for design infringement. Both defendants counterclaimed that the designs were invalid on the basis that they lacked novelty and individual character.

The Alicante court noted that the visual characteristics of Deity Shoes' designs were predetermined by models offered in its suppliers' catalogues. These allowed for customisation of several components of the shoe (including the colour, material, placement of laces and buckles and other decorative elements), with the designer's modifications being merely "ad-hoc and incidental". The court also noted that price and volume are important metrics in the fashion industry, and designers are incentivised to follow known fashion trends which can be marketed in large quantities at low prices, ultimately curtailing their creative freedom and incentive to make substantial changes to predetermined models.

Against this background, the court referred several questions to the CJEU relating to the conditions necessary for design protection under EU law:

- The scope of conditions for authorship and whether a design must be the result of intellectual effort by a designer, i.e., whether there is a minimum degree of creativity or customisation required for design protection.

- The treatment of "individual character" under the EU Design Regulation, particularly in the context of predetermined design models offered by suppliers, and the designer's modification of components also offered by a supplier.
- The role of fashion trends in the assessment of whether a design has individual character.

The CJEU used the judgment as an opportunity to clarify the scope of conditions for EU design protection, noting that it was apparent from the questions referred that there was some uncertainty surrounding this issue.

Minimum degree of creativity and a specified degree of customisation

The judgment focused on the concept of 'individual character', which is satisfied if the overall impression of the design on an informed user differs from that of earlier designs, having regard to (i) the nature of the product; (ii) the industrial sector; and (iii) the degree of freedom available to the designer in creating the design.

The court confirmed that the designer's freedom is relevant to the assessment of protectability (given that design freedom may be curtailed by technical and regulatory constraints). However, whether a design is the result of a minimum degree of creativity was not an additional requirement for protection. Whereas copyright protection is granted to an original work which is the result of the author's intellectual creation, the purpose of design protection is to protect subject matter which "*while being new and distinctive, is functional and liable to be mass-produced*".

The interplay between copyright and design protection has often led to uncertainty, particularly surrounding the scope of conditions for granting protection in each case. The CJEU recently addressed uncertainties surrounding copyright and design protection in works of applied art in the case of *Mio / Konektra* (discussed in our [article here](#)), confirming that such works should not be subject to stricter originality requirements when assessing whether they qualify for copyright protection. The CJEU in *Deity Shoes* took the opportunity to confirm (once again) that design and copyright protection pursue fundamentally different objectives and are therefore subject to distinct requirements, which should not be conflated (even if both rights may be applicable in a particular context). Here, the modification of a design model offered by a supplier was not subject to an additional requirement of showing a specified degree of customisation, and there was no minimum degree of creativity required for the creation to qualify for design protection.

In contrast to the EU position, following the *WaterRower* decision in the UK (which we discussed in our [article here](#)), copyright protection will only be available to designs or works of applied art which have artistic character, requiring a certain degree of artistic quality. The UK Intellectual Property Office's recent [designs consultation](#) acknowledged the tension between design and copyright protection (including the higher threshold for protectability of works of applied art in the UK), and considered various options to simplify the UK designs framework. However, the Government's preferred approach is to make no changes to UK copyright law, the view being that case law like the *WaterRower* decision serves to ensure that copyright is not overly protective or applied too liberally in respect of more functional designs.

Individual character, predetermined features and modified components

The CJEU confirmed that a design's overall impression must be different from that produced by previous designs when examined individually, rather than the overall impression produced by a combination of features taken in isolation and drawn from several earlier designs. To that extent, the individual character assessment is relevant to the relationship between a new design and other relevant designs, but not the design of a product and the designs of its component parts. This finding implies that a design composed of several prior designs can have individual character if, when taken individually, the resulting design does not produce the same overall impression as the earlier designs.

Where a design has visual features which are predetermined by models offered by a supplier and any modifications made by the designer are ad hoc or incidental and relate to components also designed by the supplier, the court confirmed that this alone cannot preclude a finding of individual character. Ultimately, the question is whether the overall impression produced by the design differs from the previous design corpus. The presence of predetermined features within the design does not alter that assessment.

Fashion trends

The court endorsed comments made by the Advocate General in their opinion on the rule of 'inverse proportionality', by which the more a designer's freedom is restricted due to technical or functional limitations, the more likely it is that minor differences between that design and earlier designs will be sufficient to produce a different overall impression on the informed user. However, the court distinguished between features dictated by functional or legal requirements and those which relate to fashion trends. Whereas the former are inevitable and permanent features which constitute an obvious restriction to the designer's freedom, it is the very essence of fashion to evolve with visual and technological innovations. Fashion trends do not limit the designer's freedom, and "*it is precisely that freedom which allows [the designer] to discover new forms, new trends or to innovate within the framework of an existing trend*".

The court therefore confirmed that fashion trends cannot be equated to technical or functional limitations, and the rule of inverse proportionality did not apply.

The court also considered the level of attention the informed user may give to a product's features that result from a trend. In particular, whether the informed user would pay less attention to such elements, given their knowledge and awareness that they are typically found in designs of that industry. In line with its approach to trends and designers' freedom, the court declined to afford fashion trends special treatment when assessing the informed user. Although fashion trends may impact the aesthetic appeal or commercial success of a product, neither factor is relevant to the examination of a design's individual character. Accordingly, features of a design which result from a fashion trend are not by *themselves* likely to weigh less heavily in the overall impression produced on the informed user.

Comment

Against the complex interplay between copyright and design protection, the judgment provides important clarification on the scope of conditions for EU design protection. It reiterates that metrics associated with creativity are not relevant to assessing design protection and a minimum degree of artistic quality is not required, even in the context of predetermined and customised designs. Meanwhile, with the growing importance of fashion trends in the digital economy, the judgment also provides important guidance on the role of fashion trends in assessing individual character. It affirms the importance of a trend-indifferent approach when examining the subject matter of protection.

For more information on the decision and other design protection queries, please get in touch with our [Designs](#) team.

