

Intellectual Property - Ireland

Commercial Court Makes First Community Designs Ruling

June 08 2009

Facts Commercial Court Decision

Karen Millen Ltd v Dunnes Stores⁽¹⁾ was the first case in Ireland to be decided under the EU Community Designs Regulation (6/2002), which provides for a three-year unregistered Community design right and came into force across the European Union in 2002.

Facts

Karen Millen is a well-known high-street retailer. Dunnes Stores is a large Irish retail chain with over 100 stores selling women's clothing, among other things. Karen Millen brought proceedings pursuant to the EU Community Designs Regulation, claiming infringement of its rights to three unregistered Community designs: a knitted top and two striped shirts. Dunnes Stores accepted that it had produced its garments by copying the Karen Millen designs, but disputed that the Karen Millen designs were protected by an unregistered Community design right. Initial claims for copyright infringement and passing off were not pursued by Karen Millen.

An unregistered Community design right confers on its holder the right to prevent unauthorized third parties from using a design only if the contested use results from copying the protected design. The protection lasts for three years from the date on which the design was first made available to the public within the European Union. The unregistered Community design right is particularly relevant to the fashion industry, where a large number of designs enjoy a short market life and where the cost of registering each design would be prohibitive.

Judgment in this case was delivered by the Commercial Court, a division of the High Court which deals with multimillion-euro business and IP disputes, and has the capacity to fast-track and case manage cases admitted to its list.

Commercial Court Decision

The court accepted that the designs were vested in Karen Millen, as the clothes had been sketched and designed by an employee. Dunnes Stores failed to convince the court that the Karen Millen clothes were similar to clothes previously produced by Paul Smith and Dolce & Gabbana. The court held that the Karen Millen designs were protected by the unregistered Community design right as they had created a different overall impression on the informed user when compared to designs that had been on sale in previous years, and had individual character. The 'informed user' in this case was a notional end user with a keen sense of fashion and a good knowledge of the designs of women's tops and shirts previously made available to the public, who was reasonably alert to design issues and who possessed a basic understanding of the functional characteristics and technical limitations of designs for women's tops and shirts. The court also considered questions relating to the onus of proof and whether it should consider evidence from informed users.

Since the unregistered Community design right was upheld for all three designs, the copying of these designs by Dunnes Stores amounted to infringement, in respect of which Karen Millen was entitled to relief. Dunnes Stores was ordered to account for profits and deliver up any infringing products still in its possession, although a stay was placed on the account of profits pending the outcome of an appeal to the Supreme Court.

Authors

Aoife Murphy



Robin Hayes



For further information on this topic please contact [Aoife Murphy](#) or [Robin Hayes](#) at WhitneyMoore by telephone (+353 1 611 0000) or by fax (+353 1 611 0090) or by email (ecomms@whitney Moore.ie).

Endnotes

(1) [2007] IEHC 449.

The materials contained on this website are for general information purposes only and are subject to the [disclaimer](#).

ILO is a premium online legal update service for major companies and law firms worldwide. In-house corporate counsel and other users of legal services, as well as law firm partners, qualify for a free subscription. Register at www.iloinfo.com.



Official Online Media Partner to the International Bar Association
An International Online Media Partner to the Association of Corporate Counsel
European Online Media Partner to the European Company Lawyers Association

© Copyright 1997-2009 Globe Business Publishing Ltd