

**DECISION OF THE APPEAL COURT 's-HERTOGENBOSCH,  
Civil Law Division,  
Fourth Chamber, of October 14, 2008,  
rendered in the case of:**

the company under foreign law  
FAMILLE MICHAUD APICULTEURS S.A.,  
established in Gan, France,  
appellant in the principal appeal,  
respondent in the conditional cross-appeal,  
attorney-at-law: mr. Ph.C.M. van der Ven,

versus:

the company under Dutch law  
GRAHAM PACKAGING COMPANY B.V.,  
formerly called OWENS-ILLINOIS PLASTICS B.V.,  
established in Etten-Leur,  
respondent in the principal appeal,  
appellant in the conditional cross-appeal,  
attorney-at-law: mr. J.E. Benner,

as continuation of the interlocutory judgment of this court of February 5, 2008 in the appeal from the judgment of October 26, 2005 rendered by the Breda District Court between the parties.

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**6. Further course of the proceedings**

6.1 By said interlocutory decision the Appeal Court referred the case to the cause-list for further statement on the part of Owens for the purposes stated in the decision in 4.8 and 4.10.

6.2. Owens filed a statement after interlocutory decision while submitting one exhibit and Michaud filed a statement of defence while submitting one exhibit (No. 34).

6.3. Next the parties once more submitted the documents of the proceedings and asked for the giving of judgment.

**7. Further examination**

**In the principal appeal and in the conditional cross-appeal**

**Interlocutory decision**

- 7.1. The court has given Owens the opportunity to specify by statement
- (1) on which grounds one should assume in its view that design deposit DM/024 442 presently no longer exists and
  - (2) what the status is of any appeal proceedings concerning the judgment of the Tribunal de Commerce de Clermont-Ferrand of February 1, 2007 (jur.gr. 4.8).

7.2. In respect of point (2) Owens specified that the appeal proceedings are still pending in France and that a decision in this is expected by the end of this year. This is in line with the communication of Michaud that in said case the oral pleading is planned for October 1, 2008. Owens finds it advisable that the decision in the present proceedings will be held over until a final decision has been given in France, this in view of preventing contradictory decisions. Michaud does not find such holding over necessary.

7.3. The court considers as follows in this respect. The outcome of the appeal proceedings in France does not have decisive meaning to the present proceedings, since the proceedings relate to the design and copyrights of Michaud in the various countries. It can be admitted to Owens that it is preferable that in parallel proceedings in different countries with the same cause of action decisions will be rendered which are in line with each other, but this does not imply that the present proceedings should be held over until a final decision has been rendered in the French proceedings. After all, the decision in one kind of proceedings does not depend upon the decision in the other proceedings.

7.4. To the extent that an argument can be derived from the French proceedings, this will therefore only relate to the judgment of the Tribunal de Commerce de Clermont-Ferrand of February 1, 2007, presently available.

7.5. In respect of point (1) Owens substantiated its stand that design deposit DM/024 442 presently no longer exists by reproducing a translation of several considerations of this judgment. Owens concludes from this that according to the French court the honey jar is not new and does not have an individual character and so the international design deposit is invalid as a whole and not just for its French part. Michaud contests this view.

7.6. Like Michaud the court is of the opinion that an international design deposit results into several individual national design rights and so one cannot consider such a deposit not to exist at all but once it has been established that no national rights result from the deposit (anymore). The fact that the judgment of the Tribunal de Commerce de Clermont-Ferrand of February 1, 2007 does not seem to limit itself at first sight to the design rights of Michaud in France, but seems to concern the international design deposit as a whole, does not alter this. Said judgment does not relate to the rights which Michaud may, or may not derive from the international design deposit in the Netherlands; this is a question which should precisely be discussed in the present proceedings and which has not been answered by the French judgment.

7.7. Furthermore the court has given the parties the opportunity to give their view on any effects of copyright law which may be attached to the judgment of the Tribunal de Commerce de Clermont-Ferrand of February 1, 2007 (jur.gr. 4.10).

7.8. Owens pointed out that according to this judgment there is no copyright in this honey jar. Here also Owens referred to a translation of several considerations of the judgment. With this and with that stated on this topic by Owens before, Owens has not substantiated that and why the judgment would affect the copyright pretences of Michaud in the Netherlands. Michaud disputes on its part that there be such an effect; the court agrees. The question whether there is copyright in the honey jar in the Netherlands should be answered under Dutch law and namely in the present proceedings.

7.9. According to Michaud the judgment only matters to the answer to the question whether Michaud can be considered the owner of the copyrights in the honey jar. This question should be answered under French law according to Michaud and has been answered in the judgment by the French court with the ground that by agreement of November 3, 1992 Michaud has acquired the copyrights from Barrault. Thus Michaud has specified its observation in that respect made at the oral pleading and reproduced in the interlocutory judgment in juridical ground 4.9. This matter does not become relevant but once it has been established that there is copyright in the honey jar. This will be discussed below (as from jur.gr. 7.18).

7.10. In its statement after interlocutory decision Owens informed that it wishes to be given the opportunity to respond by brief as yet to that stated by Michaud in its statement about this topic. The court does not see any reason for this. In the interlocutory judgment the questions have been included; both parties have been given the opportunity to disclose their view on them. This does not concern any new facts which have not been brought up but by oral pleading, but it concerns an aspect of the debate on the effects of the judgment of the Tribunal de Commerce de Clermont-Ferrand of February 1, 2007; this debate has meanwhile been held by the parties to a large extent. There is no reason for any further statements since both parties had sufficient opportunity to explain and substantiate their stands.

## **Design law**

7.11. Owens takes the stand that for the Benelux Michaud cannot derive any rights from the international design deposit, because the characteristics of the design do not sufficiently appear from the deposit. The District Court concurred with this stand.

7.12. Michaud stated that Owens cannot invoke in good faith invalidity of the deposit, because Owens is fully aware of the characteristics of the design. This defence does not hold. In the substantiation of its claims against Owens Michaud invokes its design deposit. Also if Owens knows the factual characteristics of the product which the design deposit relates to exactly, this does not imply that it could not invoke invalidity of the deposit on the ground stated. After all, this does not concern the knowledge of the facts of Owen but soundness of the ground of the claim of Michaud. Owens is free to dispute such soundness; that stated by Michaud does not prevent this. Ground 1 of the principal appeal relating to this fails.

7.13. In the first instance there was a debate between the parties on the reproduction which should be taken as starting-point. In appeal Michaud submitted a copy of the international design registration comprising a colour picture. The court presently starts from this picture. The fact that a Benelux design deposit requires a black and white picture is not relevant in this respect, since the Regulations belonging to the Hague Agreement, on which the international design deposit has been founded, does not have such a condition. Ground 2 of the principal appeal which challenges the differing opinion of the District Court succeeds.

7.14. Michaud takes the stand that under the Hague Agreement and the associated Regulations no conditions can be imposed on the international design deposit as phrased in Article 4 Benelux Designs and Drawings Act (old). To this provision meanwhile substituted by the Benelux Convention on Intellectual Property reference is made, because in the Benelux for designs having a date of registration, like the one of the design of Michaud, articles 4 and 15 BDDA applicable before December 1, 2003 have staid applicable. According to Michaud the conditions which the Regulations make to the deposited picture should be conceived as quality conditions for the picture itself and not as further conditions to the reproduction of the

design. In this respect Michaud points out that Section 7 of the Hague Agreement provides that an international deposit for the designated countries has the same effect as if deposited directly in such countries.

7.15. The court considers in this respect as follows. As to the formalities and administrative acts it is such that an international registration is put on the same line as direct national registrations in all designated countries. More than the international deposit is not required to obtain such collection of national registrations. However, the international deposit does not extend beyond that either. Section 7, paragraph 2 of the Hague Agreement provides, after all, to put it briefly, that the protection of designs is governed by the provisions of national law of the designated countries. This implies that the question whether a deposit has legal effect and/or a specific scope of protection should be examined on the basis of national law. The question whether a deposit is invalid because the characteristics of a design do not sufficiently appear from it is not a matter of formalities or administrative requirements, according to the court, which the Regulations are decisive to, but a matter of legal effect and scope of protection which is governed by national law. In the present case this means that it should be examined whether the characteristics of the design sufficiently appear from the copy of the design registrations presently submitted.

7.16. In the view of the court this is not the case. In this the court takes into account that in said copy the rather large dark yellow cap adopts a conspicuous position whereas the claims of Michaud precisely do not relate to the cap, but exclusively to the jar without said cap. The cap should as it were be thought out of it when examining the deposit. What then remains, is nothing else in the perception of the court itself, but the rather vague outlines of a somewhat spherical bottle or jar. According to Michaud this can be concluded simply from the honey jar as used in practice, but the court cannot agree to this stand at all. The reproduction of the jar (without cap) may result into many varying shapes, as shown by Owens at the oral pleading, and not specifically into the specific shape which Michaud intended to deposit. The description of the design is very global in this, and so no holds can be found in this either for further specification of the characteristics of the design.

7.17. All this implies that the court reaches the same conclusion as the District Court, i.e. that the deposit is invalid and that the honey jar is not entitled to design right protection in the Benelux. Ground 3 of the principal appeal which regards this is dismissed.

### **Copyright law**

7.18. The District Court has specified as criterion for assessment under copyright law that the creation of copyright requires that the work has an individual original character and bears the personal stamp of the maker, while excluding that required to achieve a technical effect (jur.gr. 3.22). Against this starting-point no grounds of appeal have been phrased and so the court will apply this. The court notes in this that upon developing the notion of 'individual original character' the question comes up whether or not there is derivation from another work (NethSC May 30, 2008, LJN BC2153).

7.19 Ground 4 of the principal appeal addresses the opinion of the District Court that the honey jar develops the shapes common in the industry and that Michaud did not express these common shapes in a sufficiently individual manner. The District Court concludes that the honey jar does not have an individual original character and does not bear the personal stamp

of the maker. By reason of this the District Court dismisses the claims of Michaud under the Dutch Copyright Act (jur.gr. 3.23 and 3.34).

7.20. In substantiation of its stand that the honey jar does have its own personal character and bears the personal stamp of the maker Michaud submitted a report by Prof.ir. J.J. Jacobs of April 26, 2006 (Exh. 27 Michaud). Prof. Jacobs was presented, to put it briefly, both with the question whether the honey jar of Michaud can be characterized as original and the question whether the bottle produced by Owens is similar to this design. This stage concerns the answer to the first question. The answer of Prof. Jacobs to this question is in the affirmative, whereas upon answering he discussed the defences of Owens in this respect. The report by Prof. Jacobs has been drawn up by an expert hired by one of the parties. In general such reports should be looked at with some restraint. When taking this into account the court also establishes that the report comprises a sound substantiation of the stand of Michaud whereas the contestation of its merits by Owens was not sufficiently reasoned and in fact boils down to a repetition of previous allegations already refuted by Prof. Jacobs.

7.21. By reason of these considerations the court assumes that the honey jar has not been derived from any other work and does bear the personal stamp of the maker, and so in principle qualifies for protection under copyright law.

7.22. Michaud alleged that Barrault should be considered the maker and that the ownership of the copyright should next be examined under French law. Starting in this from the judgment of the Tribunal de Commerce de Clermont-Ferrand of February 1, 2007 the copyright in the honey jar of Barrault has been transferred to Michaud. The court also finds French law applicable in this respect. The transition of the ownership of Barrault to Michaud has been insufficiently contested by Owens against the substantiated stand of Michaud as such.

7.23. However, Owens alleged that Skillpack or Mr. Killestijn should be considered to be the designer. With the exhibits submitted by Michaud in appeal, including the design drawing of Barrault, the court finds that in principle it has been sufficiently shown that Barrault should be considered to be the designer. The objections which Owens brings forward in respect of this design drawing (statement of defence/grounds of appeal in 52) are found too insufficient by the court to doubt the authenticity of the design drawing to such an extent that it should be left out of consideration. The court finds the allegation of Michaud that Barrault should be considered to be the designer of the honey jar proven, for the time being, save counterproof on the part of Owens. The court will allow Owens to furnish such counterproof in conformity with its offer to furnish proof.

7.24. The other matters raised by the parties the court will deal with after the proof has been furnished and also subject to its result. Any further decision will be held over.

## 8. The decision

The Appeal Court:

### In the principal appeal and in the conditional cross-appeal

allows to furnish counterproof of the allegation found proven for the time being that Barrault should be considered to be the designer of the honey jar;

rules, in the event that Owens wishes to furnish such counterproof by oral evidence, that the hearing of witnesses will take place before mr. B.A. Meulenbroek as examining magistrate, who will hold a session to that effect in the Hall of Justice at Leeghwaterlaan 8 in 's-Hertogenbosch;

refers the case to the cause-list session of November 11, 2008 to communicate the dates of unavailability of the parties themselves, their counsels and the witness(es) on Tuesdays in the period from 4 to 12 weeks after the date of this decision;

rules that the attorney of Owens will enclose a photocopy of the file of the proceedings with his communication on said cause-list session;

rules that the examining magistrate will set a day and time of the witness hearing after said cause-list session;

rules that the attorney of Owens will communicate the names and abodes of the witnesses to be heard at least 7 days before the hearing to the other party and the clerk of the court;

holds over any further decision.

This decision was rendered by mr. Meulenbroek, mr. Huybers-Koopman and mr. Struik and pronounced in public on October 14, 2008.

clerk of the court

cause-list judge

stamp of the court