

# Community Designs case law

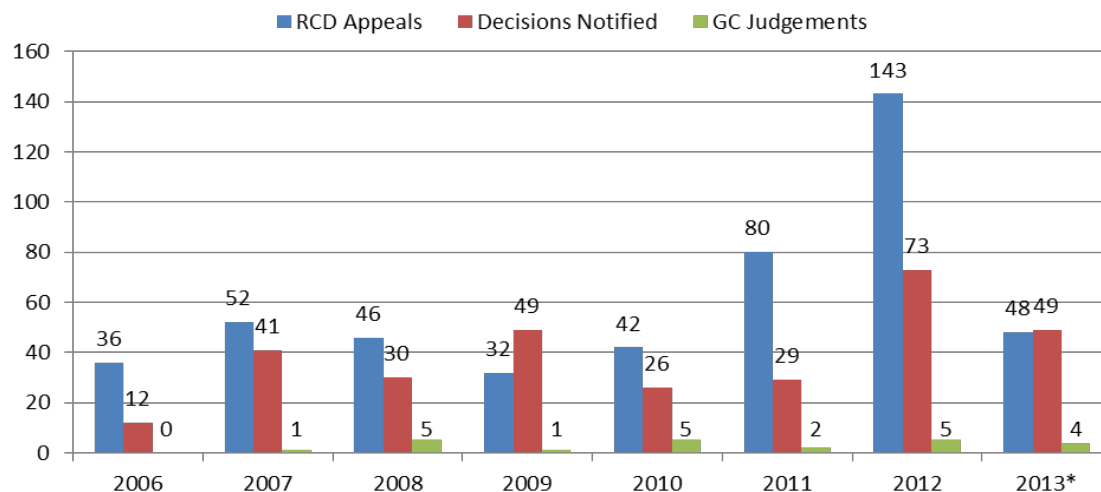
Regional Industrial Design Conference  
*Hungarian Intellectual Property Office*  
2 October 2013

Th. M. Margellos  
President of the Boards of Appeal

## Statistics

RCD Statistics					
	Appeal received	Decisions Notified	GC judgements	GC Cases pending	ECJ judgements
2006	36	12	0	0	0
2007	52	41	1	0	0
2008	46	30	5	0	0
2009	32	49	1	0	0
2010	42	26	5	1	3
2011	80	29	2	3	1
2012	143	73	5	7	2
2013*	48	49	4	4	0
TOTAL	479	309	23	15	6

(\*) until August 2013



## Individual character

- An RCD is declared invalid if it does not have the individual character.
- An RCD shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing or the date of priority.
- In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration (Art. 6 CDR<sup>1</sup>)

<sup>1</sup> Council regulation (EC) No 6/2002 on Community designs

## The designer's degree of freedom in developing his design

## Article 6(2) CDR:

2. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

- ❑ The greater the designer's freedom in developing the challenged design, the less likely it is that minor differences between the designs at issue will be sufficient to produce a different overall impression on an informed user.
- ❑ Conversely, the more the designer's freedom in developing the challenged design is restricted, the more likely minor differences between the designs at issue will be sufficient to produce a different overall impression on an informed user.
- ➡ Therefore, if the designer enjoys a high degree of freedom in developing a design, that reinforces the conclusion that the designs which do not have significant differences produce the same overall impression on an informed user (judgment of 9 September 2011, T-10/08 'internal combustion engine', para. 33).

- ❑ The designer's degree of freedom in developing his design is established, *inter alia*, by the constraints of the features imposed by the technical function of the product or an element thereof, or by statutory requirements applicable to the product.
- ❑ Those constraints result in a standardisation of certain features, which will thus be common to the designs applied to the product concerned (judgments of 9 September 2011, T-10/08, 'Internal combustion engine', para. 32; and of 18 March 2010, T-9/07, 'Metal rappers', para. 67).

### Case R 2194/2010-3 – Rocking-chairs BoA decision of 14 June 2012

RCD No 640 990-0001

Filing date: 20/12/06

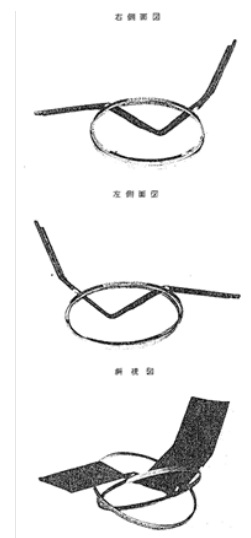
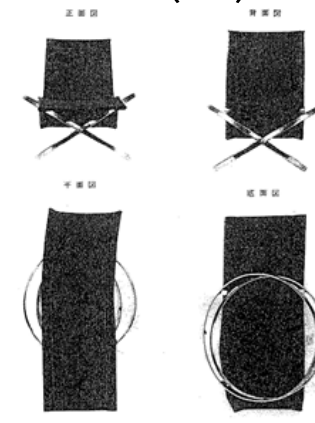


Products: rocking-chairs

Invalidity application No ICD 7052

Japanese design patent publication

JP 535 134 (D1)



Products: rocking-chairs

### Case R 2194/2010-3 – Rocking-chairs BoA decision of 14 June 2012

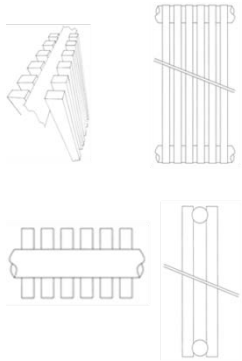
- In relation to rocking-chairs the freedom of the designer is limited to the extent that
  - they must be functional, i.e. they must at least include a seat with a back rest and
  - be construed in a way that allows the user of the chair to rock.
- However, as regards the size and shape of the seat, the construction of the chair and the materials used, the designer's freedom is almost unlimited.

### Case R 2194/2010-3 – Rocking-chairs BoA decision of 14 June 2012

- Appellant's argument: the freedom of the designer is limited in that the two-ring structure is the only known solution to the problem of providing a support structure for a foldable lounge rocking chair. **Rejected.**
  - Application of the conflicting designs is not limited to foldable rocking-chairs.
  - The functional requirement of a rocking-chair is, in principle, fulfilled by any structure that allows for the user of the chair to rock.
  - This requirement is not only met by a ring structure but by any sort of curved structure, like, for example, skids.
- ➡ Overall, the degree of freedom of the designer of rocking-chairs therefore must be considered as high.

## Cases R 1451/2009-3 & 1452/2009-3 – Radiators for heating BoA decision of 2 November 2010

RCD No 000 593 959-0001



Radiators for heating

BoA's finding:

According to the owner, in the present case, account has to be taken, for the purposes of assessing individual character, of the reduced degree of freedom of the designer (Article 6(2) CDR). However, the argument is not convincing. A variety of different section configurations can be imagined for, in particular, the radiator pipes, namely the constructive element that most influences the overall appearance of the object.

GC Judgment of 13 November 2012, T-83/11 & T-84/11

BoA was right in finding that the designer's freedom was not reduced by technical constraints.

German design No 5  
contained within multiple  
registration No 40 110 481.8

### Case R 953/2011-3 – Radiators for heating BoA decision of 3 April 2012

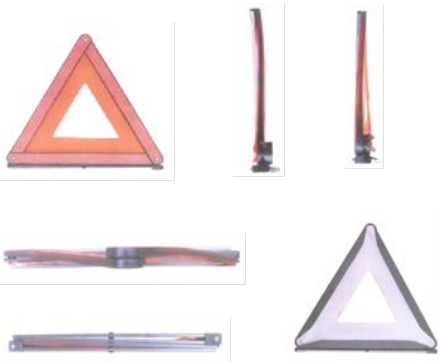


- It is certainly true that, in order to perform its primary function, a radiator for heating must have, at the very least, a set of pipes through which there circulates a liquid that, as it cools down, gives out heat to the surrounding air.
- However, this restriction does not have any significant impact on the configuration of the pipes themselves and, consequently, on the shape and general appearance of the radiator itself. In particular, the long, vertical and rectangular shape of the radiator and the rectangular cross section of the pipes do not appear necessary for guaranteeing any functional operation of the apparatus. With particular regard to the shape of the pipes, it is possible to envisage a wide variety of cross-sectional configurations
- The holder did not produce any evidence substantiating its assertion that technical or functional requirements considerably restrict the degree of freedom of the designer of a radiator for heating
- The Board considers that the degree of freedom of the designer can be defined as relatively wide

### Case R 979/2011-3 – Portable traffic warning signs BoA decision of 11 June 2012

RCD No 466 578-0001

Filing date: 20/01/06

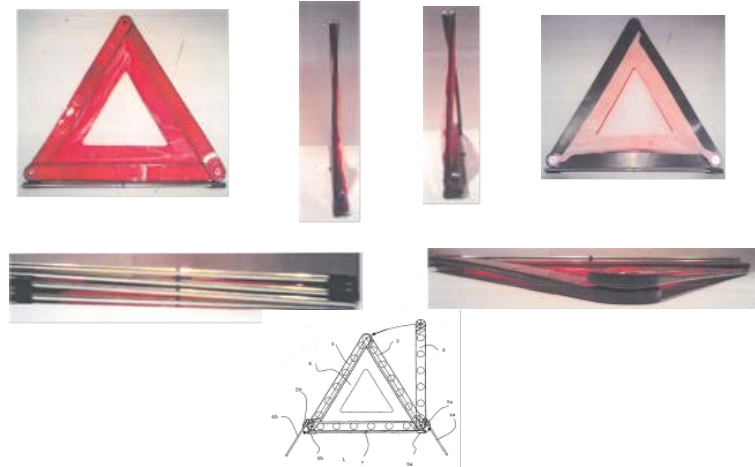


Products: Portable traffic  
warning signs

Invalidity application No ICD 7042

Earlier design

JP 535 134 (D1)



Products: Portable traffic warning  
signs

### Case R 979/2011-3 – Portable traffic warning signs BoA decision of 11 June 2012

- The appearance as well as most of the technical characteristics of the warning triangle, are determined by Regulation No 27 of the United Nations' Agreement concerning the Adoption of Uniform Technical Prescriptions for Wheeled Vehicles, Equipment and Parts which can be Fitted and/or be Used on Wheeled Vehicles and the Conditions for Reciprocal Recognition of Approvals Granted on the Basis of these Prescriptions.
- Since all the Member States of the EU have signed the aforementioned Agreement, including the aforementioned Regulation No 27, also called 'Uniform Provisions for the Approval of Advance-Warning Triangles', the subject of the present invalidity proceedings, according to the Agreement, must look practically identical in all the Member States, as defined in Annex 3 of the Agreement: 'Shape and Dimensions of the Advance-Warning Triangle and of the support'.
- Any warning triangle, different from the prescribed details will be banned from production and sale by the national authorities.

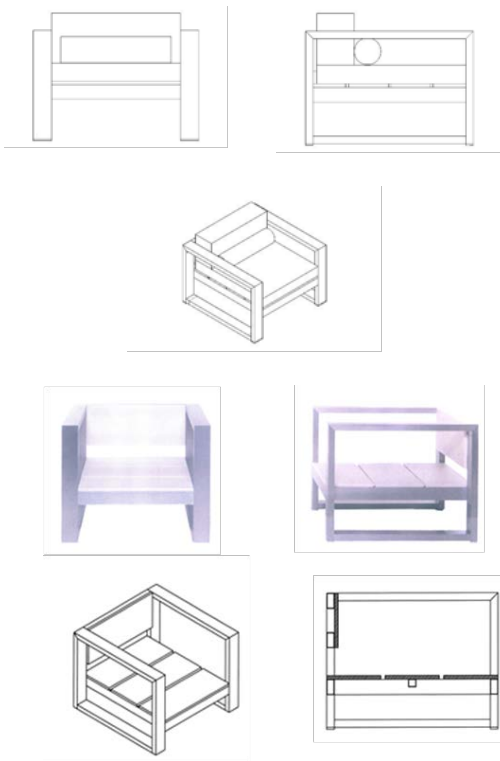
### Case R 979/2011-3 – Portable traffic warning signs

BoA decision of 11 June 2012

➔ **Conclusion:** The aforementioned Provisions leave a very low margin of freedom to 'design' this safety product, limited to the surface pattern of the retro-reflecting strip (outer triangle), the edging between the triangles (which can be less than 5 mm in width), the fluorescent coating of the inner triangle and the legs which should provide stability.

### R 969/2011-3 - Armchairs BoA Decision of 27 April 2012

The freedom of the designer of armchairs is almost unlimited since armchairs can take any combination of colours, patterns, shapes and materials. The only limitation for the designer consists in that armchairs must be functional, namely they must include at least a seat, a back rest and two armrests.



### Case R 1137/2010-3 – The shape of a domestic cat BoA decision of 23 September 2011 LOGOS

RCD No 697 016-0001

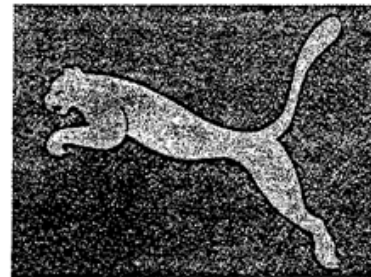
Filing date: 27/03/07



Products: 'Logos in Class 32  
of the Locarno classification

Invalidity application No ICD 6484

International trade marks Bulletin  
(in 1970)



Goods: Sports equipment  
and clothing

### Case R 1137/2010-3 – The shape of a domestic cat

BoA decision of 23 September 2011

#### LOGOS

#### LOGOS:



- In the field of logo design, the designer's degree of freedom is broad;
- There are logos of all types, based on any theme, and of any colour, form, category, class, type, stylisation or shape; this is a known fact that does not need to be demonstrated. It is therefore evident that the designer of the Community design could have moved a lot further away from the earlier design

## Informed user

- The expression 'informed user' appears three times in the Regulation (Recital 14, Articles 6 and 10)
- It is therefore a legal construct of importance

## Definition

➤ The CDR does not include a definition of the concept of 'informed user' if it applies

➤ CJEU, Judgment of 18 October 2012, Cases C-101/11 P and C-102/11 P

Personnage assis  
(sitting figure)



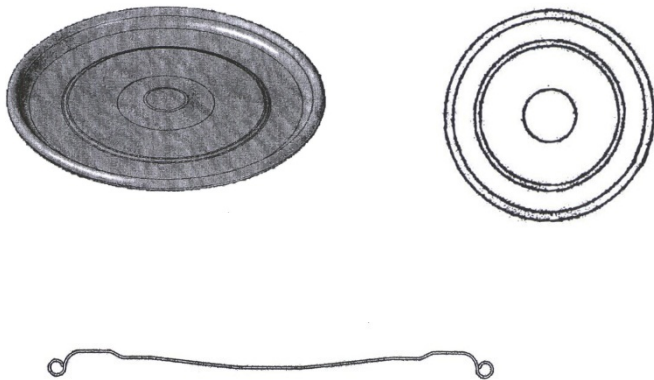
## CFI, Judgment of 18 October 2012

### Definition

- That concept must be understood as lying somewhere between that of the average consumer, applicable in trademark matters, who need not have any specific knowledge and who, as a rule, makes no direct comparison between the trade marks at issue, and the sectorial expert, who is an expert with detailed technical expertise.
- Thus, the concept of the 'informed user' may be understood as referring, not to a user of an average attention, but to a particularly observant one, either because of his personal experience or his extensive knowledge of the sector in question (paragraph 53),

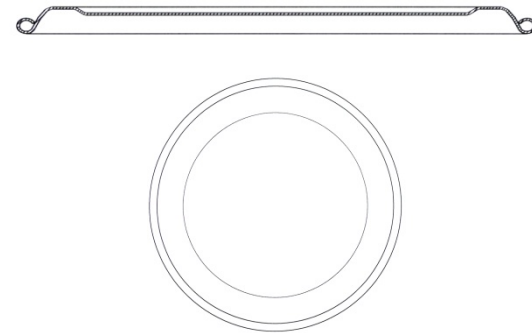
## Case R 1001/2005-3 – Metal rappers BoA decision of 27 October 2006

CD No 74463-0001



Filed on 09/09/03  
For 'promotional items for games'

Application for declaration of invalidity  
(February 2004)  
CD No 53186-0001



Filed on 17/07/03  
For 'metal plates for games'

### Case R 1001/2005-3 – Metal rappers BoA decision of 27 October 2006

## The informed user

- **ID and BoA decisions:** the informed user is the informed user of the product; a user which is familiar with the product that is subject of the design

## GC's judgment of 18 March 2010 in Case T-9/07 – Metal rappers

### Definition of the product

in which the design is intended to be incorporated or to which it is intended to be applied

- Necessary for determining the informed user (informed user of what?)

**GC:** In order to ascertain the product in which the contested design is intended to be incorporated or to which it is intended to be applied

- the **relevant indication** in the application for registration of that design should be taken into account, but also, where necessary
- the **design itself**, in so far as it makes clear the nature of the product, its intended purpose or its function. Taking into account the design itself may enable the product to be placed within a broader category of goods indicated at the time of registration and, therefore, to determine the informed user and the degree of freedom of the designer in developing his design.

## GC's judgment of 18 March 2010 in Case T-9/07 – Metal rappers

### Definition of the product

- **ID:** had taken into consideration the category for which the contested design was registered: 'promotional items'
- **BoA:** found that the products in question belonged, within the broad category of promotional items for games, to the particular category of game pieces, known as 'pogs'; rappers, or 'tazos'
- **GC:** Confirmed Boards' finding:
  - An examination of the design shows that it belongs to a specific category of those promotional items
  - Submitted evidence shows that the design was intended to be incorporated in those specific promotional items for games

### GC's judgment of 18 March 2010 in Case T-9/07 – Metal rappers

- **ID and BoA decisions:** the informed user is the informed user of the product; a user which is familiar with the product that is subject of the design
  - Not 'a person skilled in the art', or a designer or an expert in the field
  - Nor is it a casual observer or an occasional user

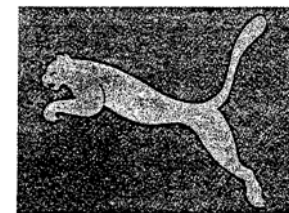
## GC's judgment of 18 March 2010 in Case T-9/07 – Metal rappers

- GC:
  - Is neither a manufacturer nor a seller of the products
  - Is a particularly observant user who has some awareness of the state of the prior art, that is to say the previous designs relating to the product in question that had been disclosed on the date of filing of the contested design or, as the case may be, on the date of priority claimed.

### Case R 1137/2010-3 – The shape of a domestic cat BoA Decision of 23 September 2011



#### Profile of the informed user



- Logos may be used in a great number of different ways. As a result, the user of logos may be anyone: an entrepreneur, a manufacturer, a retailer, a bank, a public body, a political party, etc.
- This user must, however, be 'informed'. In other words, he must be someone who, without being a design expert, has acquired a certain amount of experience in the sector and has consulted documentation relevant to graphic design, logo overviews and the like, in their sector of interest.
- Given that the earlier design has been disclosed in the sports equipment and clothing sector (among other sectors), the impression produced by the contested logo on the informed user of logos used in this sector should be taken into consideration

### Case R1701/2010-3 - Toy vehicles BoA decision of 12 July 2011

#### CD No 664925-003



#### Earlier design

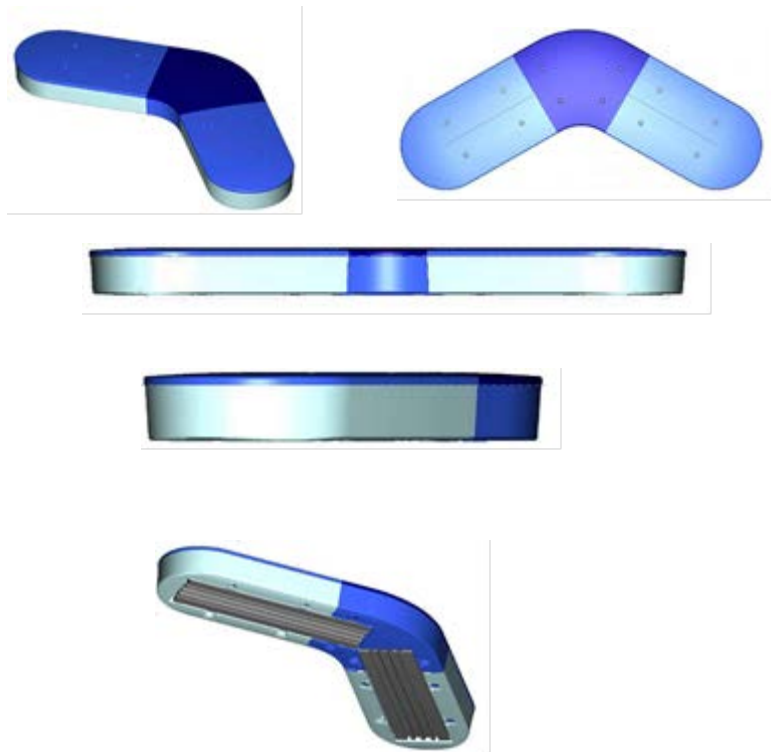


- §16 It is apparent from Recital 14 in the preamble to the CDR that, when assessing whether a design has individual character, account should be taken of the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs (see judgment of 22 June 2010, T-153/08, 'Communications equipment', para. 43)
- §19 In the case at hand, the product in question is a toy vehicle and therefore the informed user could be a child between the approximate age range of 4 to 9 or an adult who buys the toy vehicle for a child. However, it makes little difference whether the informed user is a child between the approximate age range of 4 to 9 or an adult; the important point is that both those categories of person are familiar with the product at the level indicated in the previous paragraph above (see, by analogy, judgments of 18 March 2010, T-9/07, 'Metal rappers', para. 65)

## Case R 171/2011-3 - Signalling lights and roof lights for vehicles BoA decision of 25 May 2012

RCD no 884 036-0002

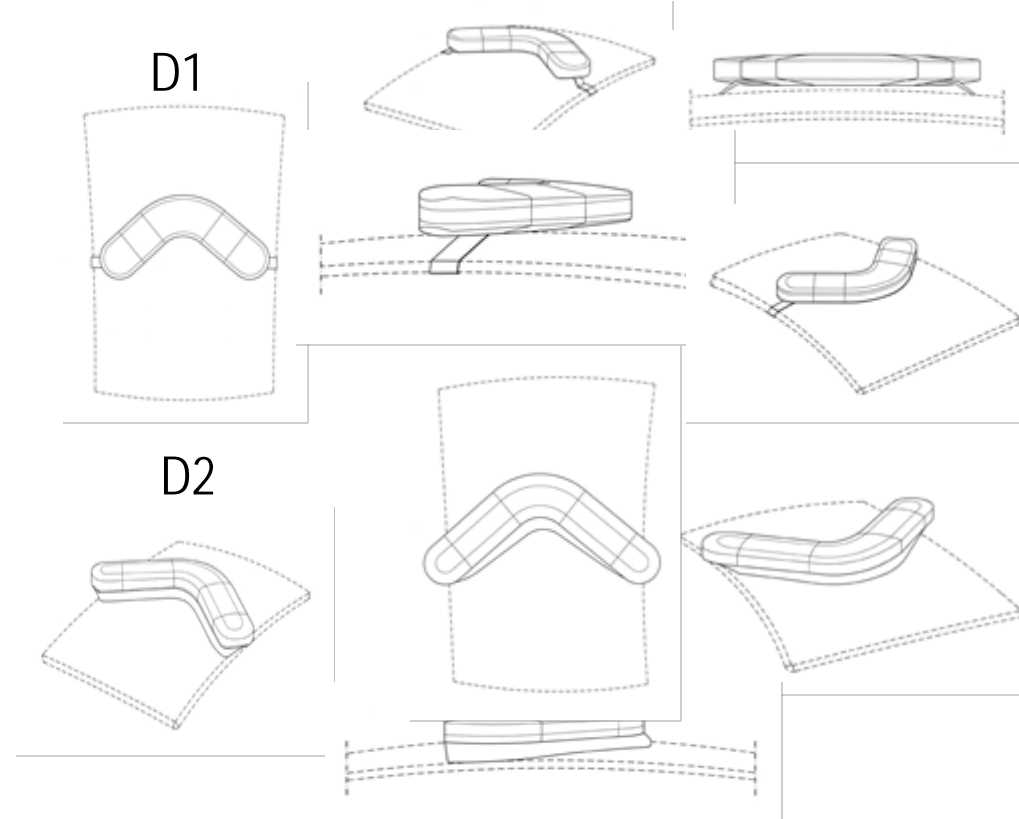
Filing date: 22 February 2008



Invalidity Application no ICD6187

Earlier RCDs

Nos 757 380-0001(D1) 757 38-00002 (D2)



### Case R 171/2011-3 - Roof lights for vehicles BoA decision of 25 May 2012

- The overall impression of the design must be appreciated from the point of view of the 'informed user'. Accordingly, this concept must be determined in the present case, on the basis of the product to which the design is to be applied according to the registration. The 'user' is the person who normally 'uses' a product, and according to the registration, the products are 'signalling lights for vehicles' and 'roof lights for vehicles'.
- 'Informed' suggests that he is familiar with the basic characteristic elements of lightbars for vehicle roofs and aware of the various designs which exist in the sector, fitted to vehicles with characteristics which require such bars to be fitted (civil or military, local or national police vehicles, ambulances, military or civil firefighting vehicles, civil protection vehicles, doctors' and other emergency service vehicles, among others).

### Case R 171/2011-3 - Roof lights for vehicles BoA decision of 25 May 2012

- The informed user in relation to whom the individual character of the CD must be measured is the one who purchases this type of product (that is, officers of the police force or other emergency services) with the intention of use, who has become an informed user by means of studying catalogues, visiting manufacturers in the sector or their commercial establishments, obtaining information over the internet, etc.

# Overall impression

What is being compared ?

Several decisions help to identify what aspects of the CD are to be considered when making the comparison with the prior design.

- As a matter of principle, all the features of a Community design must be taken into account with the following exceptions:
  - Features dictated by a technical function and features of interconnections;
  - Disclaimed features;
  - Features not clearly discernible from the design registration;
  - Features which are not visible.

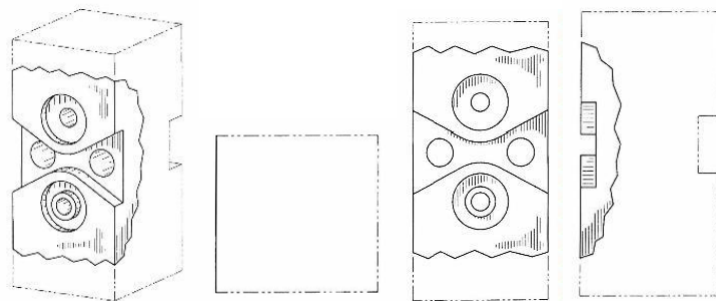
## Technical features

An RCD does not subsist in visual features which are exclusively dictated by the technical function

- ✓ According to BoA, Art. 8(1) CDR denies protection to those features of a product's appearance that were chosen exclusively for the purpose of designing a product that performs its function as opposed to features that were chosen, at least to some degree, for the purpose of enhancing the product's visual appearance. (Decision of 22/10/2009, [R 690/2007-3](#), „Chaff cutters“, para. 35 et seq.)
- ✓ The wording of Art. 8(1) CDR does not imply that the feature in question must be the only means by which the product's technical function can be achieved. On the contrary, it implies that the need to achieve the product's technical function was the only relevant factor when the feature in question was selected. (Decision of 22/10/2009, [R 690/2007-3](#), „Chaff cutters“, para. 31 & 32)

What must be analysed is the RCD and not designs consisting of other shapes.

- Whether Article 8(1) CDR applies must be assessed objectively, not in the perception of the informed user who may have limited knowledge of technical matters.
- The technical functionality of the features of a design may be assessed, inter alia, by taking account of the documents relating to patents describing the functional elements of the shape concerned.



Decision of 29/04/2010, [R 211/2008-3](#)

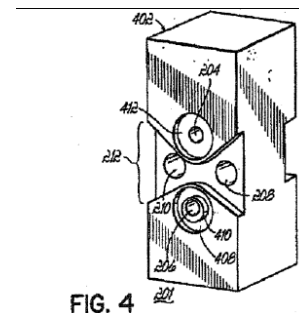


FIG. 4

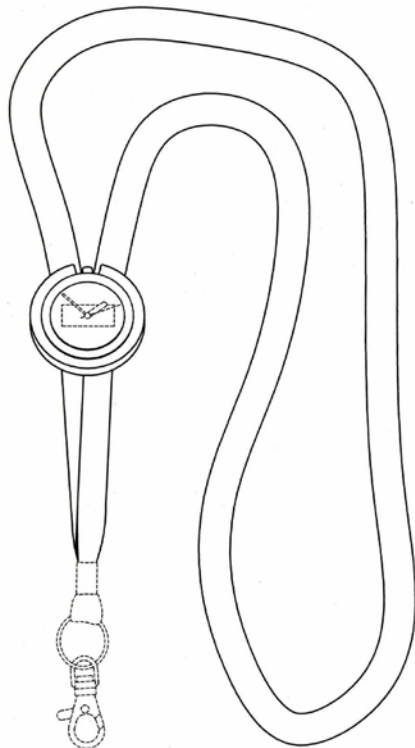
EP 1568 418 A2

## Disclaimed features

Features of a community design which are disclaimed are disregarded for the purposes of comparing the designs

### GC's judgment of 14 June 2011 in Case T-68/10

Only elements which are actually protected by the contested design are relevant in the context of the comparison of that design with an earlier design



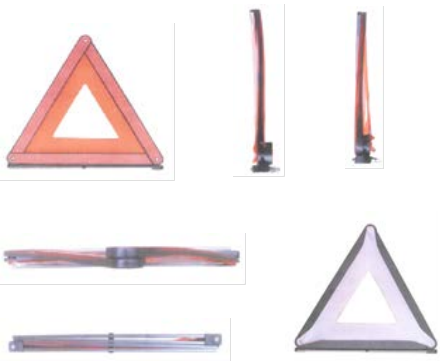
- Dotted lines identify elements which are not part of the view in which they are used
- The attachment clip, the hands of the watch and the rectangular element affixed to the watch face do not form part of the protected elements of the contested design

## Non-discernible features

### Case R 979/2011-3 – Portable traffic warning signs BoA decision of 11 June 2012

RCD No 466 578-0001

Filing date: 20/01/06

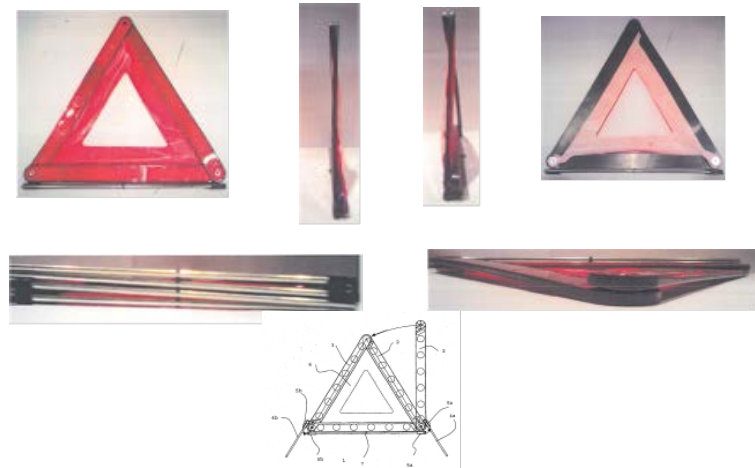


Products: Portable traffic  
warning signs

Invalidity application No ICD 7042

Earlier design

JP 535 134 (D1)



Products: Portable traffic warning  
signs

### Case R 979/2011-3 – Portable traffic warning signs BoA decision of 11 June 2012

- ➔ **Conclusion:** The aforementioned Provisions leave a very low margin of freedom to 'design' this safety product, limited to the surface pattern of the retro-reflecting strip (outer triangle), the edging between the triangles (which can be less than 5 mm in width), the fluorescent coating of the inner triangle and the legs which should provide stability.
- However, none of these details appear to be clearly visible on the drawings and photographs submitted. There is no recognizable surface pattern on the photos submitted—the edgings are not visible either—and even the back of both designs seems to follow the same technical solution, with only a slight difference in the width of the metallic frame. Under these circumstances it must be concluded that the contested design produces the same overall impression on the informed user as that produced by the earlier design, and that the contested design is not endowed by an individual character as required by Article 4(1) CDR.



## Visible features

## Requirements for protection

### Article 3 CDR

### Definitions

For the purpose of this Regulation:

- (a) 'design' means the appearance of the whole or part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation;
- (b) 'product' means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;

### Article 4(2) CDR:

A design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character:


- a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter; and
- b) to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character.

### Article 3 CDR:

For the purposes of this Regulation:

[...]

- c) 'complex product' means a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product.

- Complex products  Multiple components
- Visible once it has been incorporated
- During normal use
- Visible features fulfil in themselves the requirements as to novelty and individual character

## Normal use

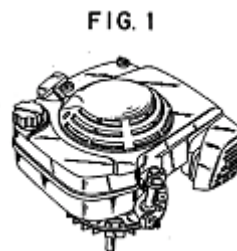
Article 4 CDR:

3. 'Normal use' within the meaning of paragraph (2)(a) shall mean use by the end user, excluding maintenance, servicing or repair work.

- Where the features of a Community design applied to a component part (e.g. an internal combustion engine) are only partially visible during normal use of the complex product (e.g. a lawnmower), the comparison with the relevant prior art must be limited to the visible parts.

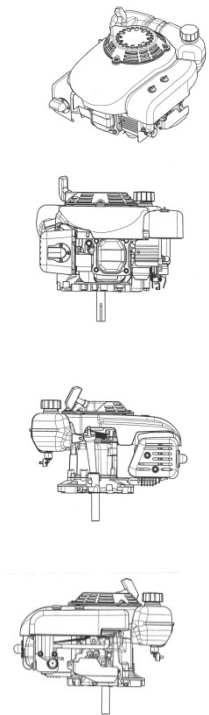
✓ Case R 1373/2006-3 – Internal combustion engine  
BoA decision of 8 October 2007

✓ GC judgment of 9 September 2011 in T-10/08

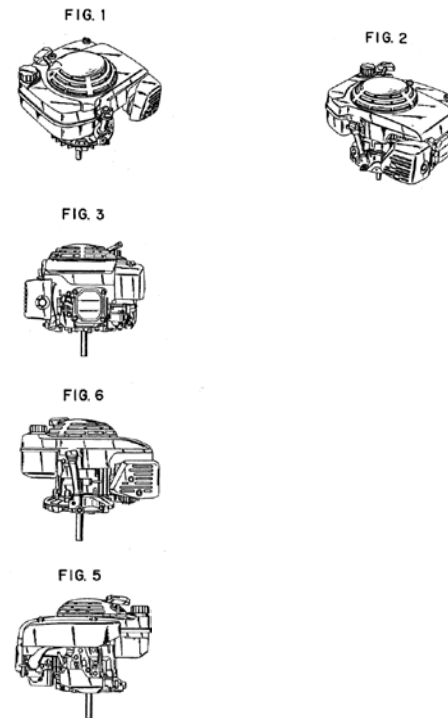


### Case R 1337/2006-3 – Internal combustion engine BoA decision of 8 October 2007

RCD No 163 290-0001



Invalidity application (Honda Motor Co. Ltd.)



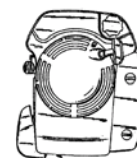
## Case R 1337/2006-3 – Internal combustion engine BoA decision of 8 October 2007

RCD No 163 290-0001



Invalidity application (Honda Motor Co. Ltd.)

FIG. 7



Product: Internal combustion engine

Article 4 RCD

Article 5 RCD (lack of novelty)

Article 6 RCD (lack of individual character)

### Case R 1337/2006-3 – Internal combustion engine BoA decision of 8 October 2007

- Only parts of the design that are visible during normal use of the complex product (lawnmower) are taken into consideration
- The parts of the engine that are not visible once it is mounted on the equipment are to be excluded from the comparison of the overall impression produced by the designs at issue
- Are visible; the upper side, the front and lateral sides



GC's judgment of 9 September 2011  
in T-10/08

### GC's judgment of 9 September 2011 in Case T-10/08

#### Holder's arguments :

- It challenges the Board of Appeal's assessment that the parts of the challenged design remaining visible during normal use of the complex product, once the engine is mounted on the lawnmower, are principally the upper side of the motor, then the front and lateral sides, whereas the rear side is less visible and the underside is not visible at all.
- It takes the view that the rear side and underside of the engine must not be neglected.

### GC's judgment of 9 September 2011 in Case T-10/08

- The applicant has accepted that :

The challenged design constituted an internal combustion engine which could be incorporated into a lawnmower. Therefore, it must be considered that the challenged design constitutes a component part of that complex product

- It is common ground that internal combustion engines are generally used for lawnmowers.
- The incorporation of the challenged design into a lawnmower may therefore serve as a basis for determining:
  - First, whether the challenged design remains visible during normal use of the complex product, in particular, a lawnmower, by the end user.
  - Second, whether the overall impression produced on an informed user by the visible features differ from that produced by another design which was made available to the public before 2 April 2004.

### GC's judgment of 9 September 2011 in Case T-10/08

During normal use the lawnmower is:

- Placed on the ground
- End user stands behind the lawnmower
- End user sees the engine from the top and therefore sees principally the upper side
- Consequently, the upper side determines overall impression produced by the engine

- Where none of the features of a Community design applied to a component part is visible during normal use of the complex product, such an RCD will be invalidated as a whole (Decision of 10/03/2008 [ICD 4380](#) "sealing ring")

✓ Case R 1052/2008-3 – Electrical contactors  
BoA decision of 3 August 2009

✓ Case R 293/2012-3 – Heat exchanger insert  
BoA decision of 10 September 2013

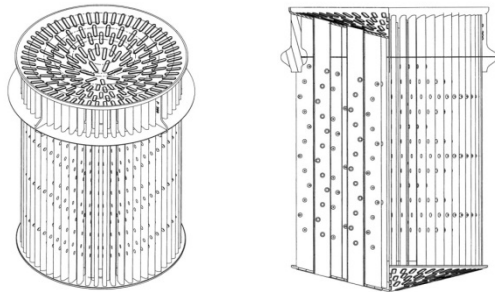
### Case R 1052/2008-3 „Electrical contactors“, paras. 42-53 Boa Decision of 03 August 2009

- An electrical connector is a component part which is normally incorporated in a casing in order to be shielded from any contact with potential users when a complex product, such as a train or electric vehicle, is in operation.
- A hypothesis of a transparent casing or cover must be disregarded



### Case R 293/2012-3 – Heat exchanger inserts BoA decision of 10 September 2013

RCD No 1137152-0001



Product: heat exchanger heater

Invalidity application RCD No 1203004-0001



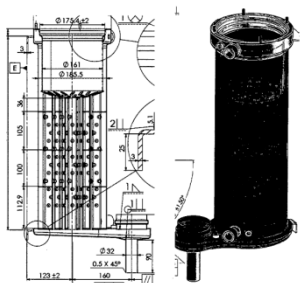
Article 4(2) (absence of visible features)  
Article 5 (lack of novelty)  
Article 6 (lack of individual character)  
Article 8 (technical function)

# Community designs case law

## Visible features

### Case R 293/2012-3 – Heat exchanger inserts BoA decision of 10 September 2013

**A)** A heat exchanger insert, similar to the one examined, shown within a heat exchanger

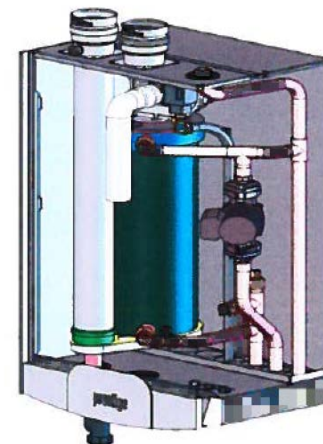


1) Structural cross-section 2) Heat exchanger



3) Photographic revealing the insert within a heat exchanger

**B)** The heat exchanger (in dark blue on the picture), encompassing the insert (which remains invisible) within the boiler, when the boiler's cover is removed, i.e. during maintenance or repair



Boilers' appearance during sale and normal use

### Case R 293/2012-3 – Heat exchanger inserts BoA decision of 10 September 2013

- The heat exchanger insert at issue forms part of a complex product, the heat exchanger, which, in turn also forms part of a more complex product, the boiler. It is the boiler, which will be bought as a final product, the heat exchanger remains invisible (to the end user) behind the walls of the boiler.
- For various reasons, including safety regulations, thermal and acoustic insulation, the boiler is allowed to operate only as a closed 'box', and only the switches of the electronic panel, the water and gas pipes remain visible to anyone not qualified for the maintenance of the boiler

### Case R 293/2012-3 – Heat exchanger inserts BoA decision of 10 September 2013

- ✓ The normal use of the insert coincides with that of the end product encompassing it, the boiler. The use of the boiler includes the use of its parts, including one of its main parts, the heat exchanger which also consists of further parts, such as the insert consisting of combustion flue profiles in the present case.
- ✓ The 'normal use' of the boiler starts after its installation,
- ✓ The heat exchanger will be visible as a whole only during the installation and maintenance processes.

Professionals in building or maintenance companies, who install boilers in houses with heating facilities, cannot be regarded as end-users. If there are problems will the user contact specialists to find out the source of the problem; he or she will not start to open the boiler and changing its internal parts, such as for example, the heat exchanger insert at issue.

Boilers' appearance during sale and normal use:



### Case R 293/2012-3 – Heat exchanger inserts BoA decision of 10 September 2013

- ✓ The RCD owner argued that the heat exchanger insert is produced and sold as an individual product.
- ✓ As regards that argument, the Board noted that all kinds of spare parts for various complex products are sold separately, similarly to certain parts of a heat exchanger. However, the fact that a spare part can be observed during a commercial transaction does not mean that the spare part at issue, because it is possible to see it then, automatically fulfils the visibility requirement, as required by Article 4(2)(a) CDR. The Regulation is clear in this respect: the requirement is fulfilled only if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter.

In the present case, once the insert is placed into the heat exchanger, and the heat exchanger is then incorporated into the boiler, it does not remain visible during normal use, which is how a boiler normally functions.

Finding: design declared invalid for absence of visibility

## Conclusion

### Component parts of complex products

Assessment of the individual character

- Determine the complex product in which the component part will be incorporated and the mode of incorporation of the design (internal combustion engine) in the complex product (lawnmowers)
- Determine the features which remain visible

### Accessory features

# Community designs case law

## Accessory features

### Case R 1703/2010-3 - Toy vehicles BoA decision of 12 July 2011

CD No 573993-004



Registered and published  
on 26 September 2006  
for 'toy vehicle'

Application for declaration of invalidity



International registration published  
on 30 June 2000

Case R 1703/2010-3 - Toy vehicles

BoA decision of 12 July 2011

## Overall impression of the conflicting designs

The Board agrees with the contested decision that the contested CD and the prior designs differ in particular because:

- the CD includes a trailer absent in the prior designs.

The Board notes that they differ also in the following features:

- In the prior design the parallel black lines on the side of the toy vehicle are followed by the type number 'R3-42T', which does not appear in the CD
- The lifting tool of the CD is pointing downwards, whereas the lifting tool of the prior design is pointing upwards

Case R 1703/2010-3 - Toy vehicles

BoA decision of 12 July 2011

## Overall impression of the conflicting designs

For the rest, in the view of the Board, the contested CD and the prior designs are identical, this including, *inter alia*, the following elements:

- The shape of the main body;
- the motor at the back;
- the cabin;
- the wheels;
- the lifting arm;
- the lifting tool;
- part of the black stripes at the side;
- the colour of the main body (yellow);
- the colour of the cabin (black);
- the colour of the wheels (yellow and red);
- the colour of the lifting tool (red).

### Case R 1703/2010-3 - Toy vehicles

BoA decision of 12 July 2011

## Overall impression of the conflicting designs

- The only relevant difference between the designs at issue concerns the fact that the contested CD also contains a trailer, which is not present in the previous design
- The trailer is a feature that the respondent added to the earlier version of the toy vehicle. Even though the trailer has thus become an element of the design of the toy vehicle, it is a relatively marginal one, in the sense that the toy vehicle – with or without the trailer – produces on the informed user the same overall impression. The informed user will perceive the trailer for what it clearly is: an accessory. The accessory character of the trailer is well demonstrated by the fact that it is not a fixed element but one that can be easily separated from the main product. The trailer is, in fact, an optional accessory i.e. something that anybody playing with the toy may decide to use or not and it may hardly be recognised as ‘a significant part of the design’

Therefore, the Board takes the view that the contested design inevitably creates the same overall impression on informed users as the prior designs, since it reproduces all the essential characteristics of the latter

### Case R 1703/2010-3 - Toy vehicles

BoA decision of 12 July 2011

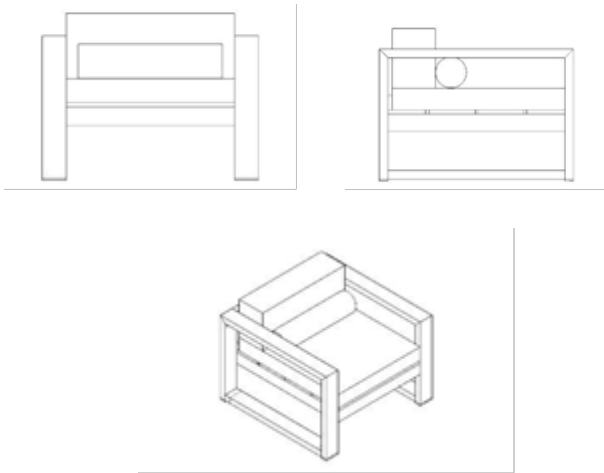
## Overall impression of the conflicting designs

- Further, the overall impression produced by a design on the informed user must necessarily be determined also in the light of the manner in which the product at issue is used (see judgments of 22 June 2010, T-153/08, 'Communications equipment', para. 66 and of 14 June 2011, T-68/10, 'Watches', para. 78). The Board notes that the person using the product would usually be a child at play and that the truck and the trailer in the contested design can easily be separated from each other and used as two separate toys, or they could even be sold separately. This factor also decreases the importance that can be given to the additional component for the evaluation of the overall impression
- The same applies to the fact that the lifting tool of the CD is pointing downwards, whereas the lifting tool of the prior design is pointing upwards. As importance must also be given to the manner in which the product at issue is used and it seems more than probable that the lifting tool of the toy vehicle can be 'clipped-on' either way, that is pointing downwards, or pointing upwards, this factor can only be qualified as immaterial

### Case R 969/2011-3 - Armchairs BoA Decision of 27 April 2012

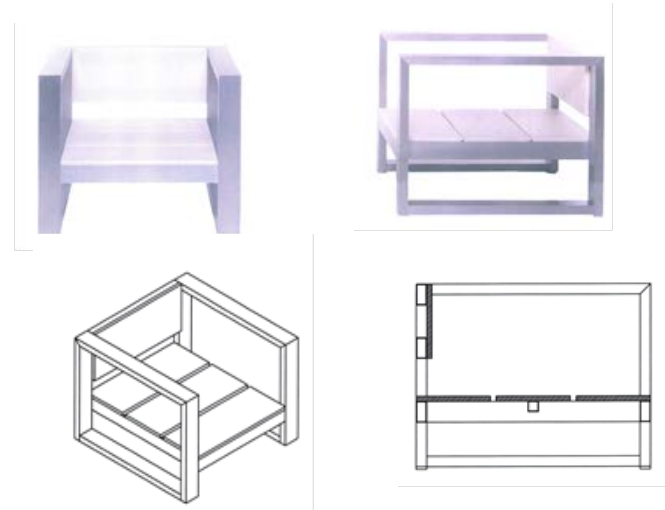
RCD No 1512 633-0003

Filed on 14 May 2009



Products: 'Armchairs, loungers'

Application for declaration of invalidity  
ICD No 7147  
RCD No 52113-0001

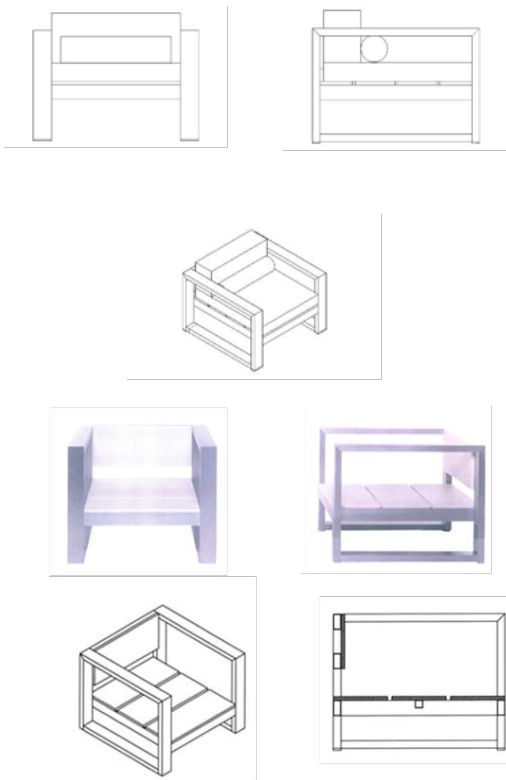


Registered for 'armchairs'  
Published on 09/12/03

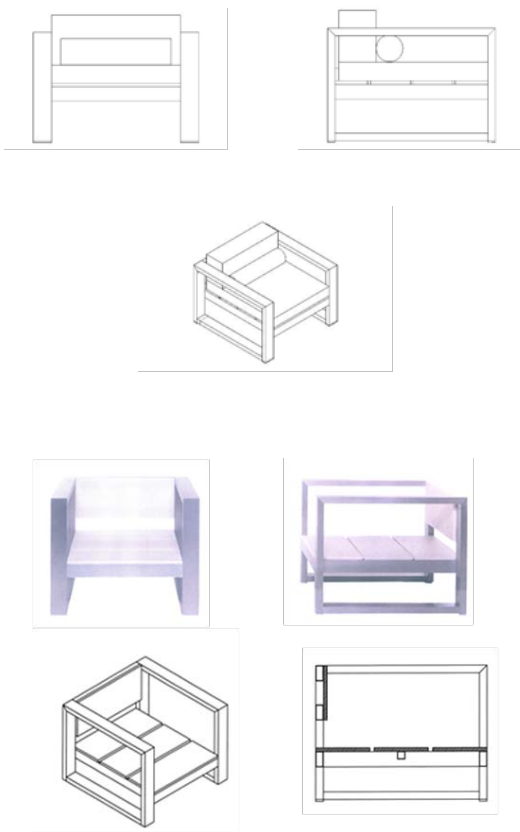
### Case R 969/2011-3 - Armchairs BoA Decision of 27 April 2012

**Common features:** The contested RCD and the prior design share numerous elements which are identical or at least strongly similar which are listed as follows:

- a rectangular overall structure including square-shaped frames as armrests;
- the heights of the frames are less than the widths;
- flat seats;
- flat vertical backrests;
- slightly separated juxtaposed rectangular plates on the seats;
- a board below the plates on each side of the armchairs;
- the armrests are on the same level as the upper limits of the backs of the armchairs; and
- the armrests are linked to the upper limits of the backs of the armchairs.

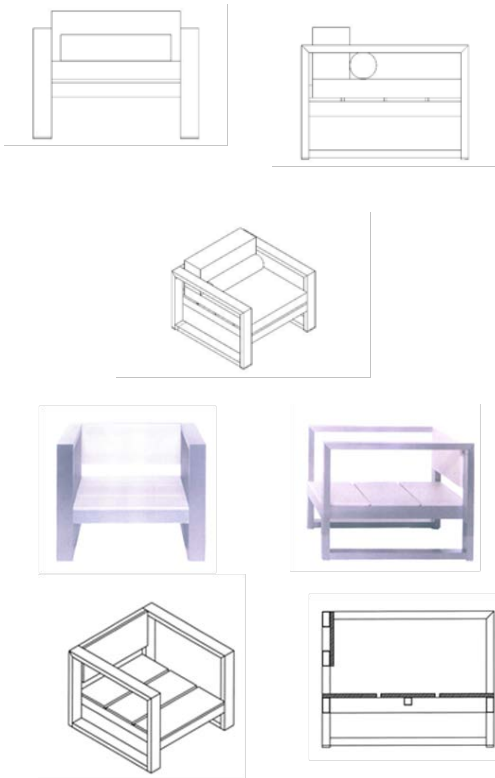


### Case R 969/2011-3 - Armchairs BoA Decision of 27 April 2012



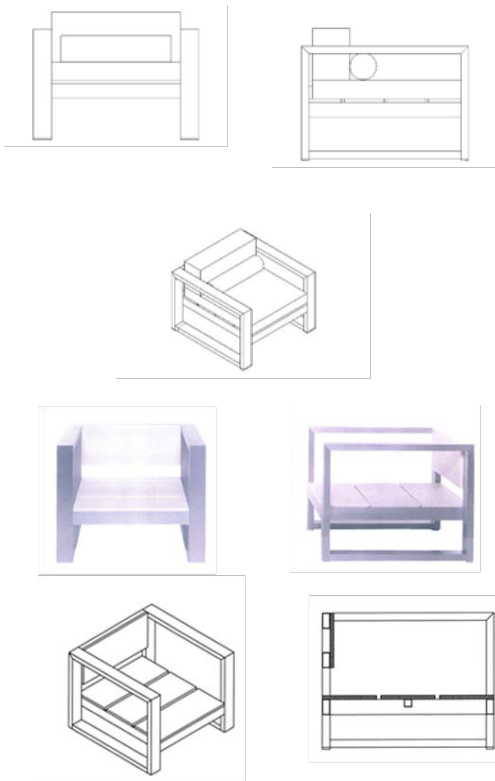
- In the absence of any specific constraint imposed on the designer, except for the rather minor one mentioned, the similarities noted above, all relate to elements in respect of which the designer was free to develop the contested design. All these similarities are very noticeable in the overall impression of the designs and will attract the informed user's attention.

### Case R 969/2011-3 - Armchairs BoA Decision of 27 April 2012



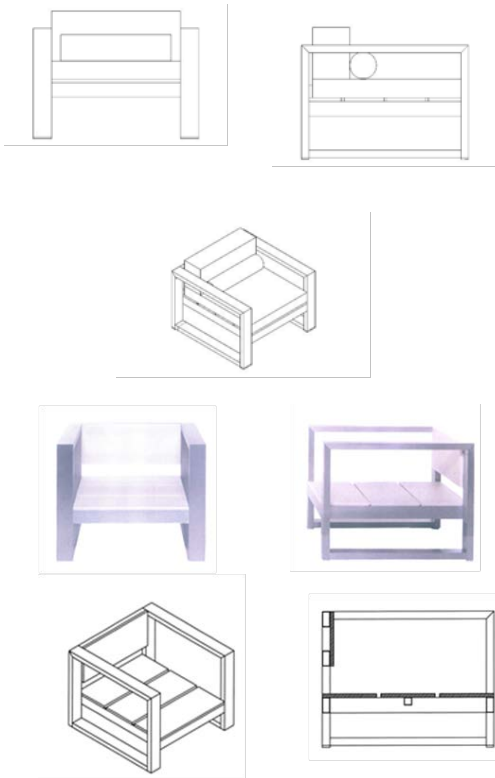
- The contested design contains three cushions which are not present in the previous design.
- The ID's decision concluded that the overall impression produced on the informed user by the contested RCD differs from the overall impression produced by the prior design, because the RCD includes these three cushions absent in the prior design (without mentioning any other noticeable differences).

### Case R 969/2011-3 - Armchairs BoA Decision of 27 April 2012



- The informed user will perceive the cushions simply as an accessory, as they are not a fixed element but one that can be easily separated from the main product. The cushions could be seen as an optional accessory – i.e. something that anybody using the chair may decide to use or not – and therefore could hardly be qualified as 'a significant part of the design' (see also decisions of 26 March 2010, R 9/2008-3, 'Footwear', paras 102 and 103 and of 12 July 2011, R1701/2010-3, 'Vehicles (Toys)', para. 27).

### Case R 969/2011-3 - Armchairs BoA Decision of 27 April 2012

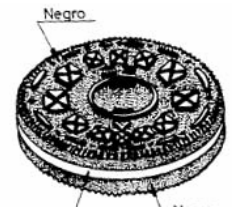


- In fact, they are often even sold and bought separately and as they are elements which often deteriorate with time, the buyer often has the option of replacing them with new ones at, at least in comparison with the actual structure of the armchair, a relatively low cost. These factors decrease the importance that can be given to these components for the evaluation of the overall impression. The informed user will give far more importance to the overall impression of the structures of the armchairs.

# Community designs case law

## Overall impression – What is being compared ?

- Unless the compared designs include functional or invisible or disclaimed features (see Section C.5.2.1), the two designs must be compared globally. That does not mean, however, that the same weight should be given to all the features of the compared designs:
  - depend on how that product is used some features may be less important depending on account of their reduced visibility when the product is in use (Decision of 22/06/2010, T-153/08, „Communications equipment“, para. 64 - 66, 72)
  - the informed user will only disregard or give minor importance to features that are totally banal, common or accessory to the type of product in issue and will concentrate on features that are arbitrary or different from the norm (Decision of 18/03/2010, T-9/07, „Representation of a circular promotional item“, para. 77; decision of 28/11/2006, [R 1310/2005-3](#), „Galletas“, para. 13; decision of 30/07/2009, [R 1734/2008-3](#), „Forks“, para. 26 et seq.)



## Trade mark vs Design

Applications for invalidity may be based on:

- Article 25(1)(b) in combination with Article 5 (lack of novelty) and Article 6 CDR (lack of individual character)
- Article 25(1)(e) CDR

### Case R 1323/2008-3 - Sitting figure BoA decision of 14 October 2009

CD No 000426895-0002



Filed on 07/11/05  
Registered on 27/12/05  
For 'T-shirts (ornamentation for –),  
caps (vizored –) (ornamentation for –),  
stickers (ornamentation for –),  
printed matter, including advertising  
materials (ornamentation for –)'

Application for declaration of invalidity  
(18 February 2008)  
CTM No 1312651



Registered on 07/11/00  
For distinguish 'clothing' and other goods  
in classes 25, 28 and 32

### Case R 1323/2008-3 - Sitting figure BoA decision of 14 October 2009

<b>Cancellation Division</b>	→ Decision 15 July 2008	→	Action upheld/design invalidated (Art. 25(1)(e)CDR)
<b>Notice of Appeal</b>	→ 16 September 2008	→	Holder of CD
<b>Board of Appeal</b>	→ Decision E-1323/2008-3: 14 October 2009	→	Invalidity confirmed but on the basis of Art. 25(1)(b), 6(1) CDR (no individual character)
<b>Action for annulment</b>	→ 22 December 2009	→	Holder of CD
<b>General Court EU</b>	Judgment T-513/09: 16 December 2010		Decision annulled (creates different overall impression)
<b>Appeals</b>	→ 28 February 2011	→	Invalidity applicant/OHIM
<b>CJEU</b>	→ Judgment of 18 October 2012, C-101/11P and C-102/11 P	→	Appeals dismissed

# Community designs case law

## Trade mark vs Design

### Case R 2378/2010-3 – Ornamentation for coffee packaging BoA decision of 17 April 2012

RCD No 000706940-0001



Products: 'Ornamentation  
for coffee packaging'

Invalidity Application ICD 5759

#### Trade marks

Portuguese TM No 162 849



CTM No 1 469 121



International trade mark  
No 500 674



Goods: Roasted coffee

### Case R 2378/2010-3 – Ornamentation for coffee packaging BoA decision of 17 April 2012

- RCD not identical
  - Absence in the RCD of ornamental motifs (dromedary, desert landscape) which appear in all the earlier disclosed designs, causes the later design to generate a different overall impression in the informed user. It is possible that the overall impression is not significantly affected by the absence of the words in the Community design (the informed user will think that they are trade names which refer to the product rather than the packaging), but the same cannot be said for the ornamental motifs because they fulfil the same function as the dark coloured background with light coloured beans, that is to say that of providing the packaging with a specific decorative appearance.
- ➡ **Conclusion:** Given that the appearance of the CD is significantly distinct, the earlier designs do not deprive the CD of its individual character.

### Case R 1341/2010-3 – Footwear decoration BoA decision of 18 January 2012

RCD

No 000653753-0002



Products: decoration for footwear

Spanish trade marks



and



Goods: Footwear

### Case R 1341/2010-3 – Footwear decoration BoA decision of 18 January 2012

- The ways of decorating shoes is practically unlimited, the only restriction being the generally small amount of space available on the shoe for decorative purposes. The degree of freedom of the designer (for the purposes of Article 6(2) CDR) is, therefore, very wide;
- Taking into account this degree of freedom, that is to say, the infinite variety of figurative motifs with which shoes can be decorated, it is striking that a large part of the Community design is identical to the earlier one.
- The identity lies in (i) the appearance of an ellipse, (ii) the appearance of a sign rather like an arrow and (iii) the fact that said sign is situated within the ellipse;

### Case R 1341/2010-3 – Footwear decoration BoA decision of 18 January 2012

- The similarity even extends to other characteristics: the degree of curvature of the ellipse, the orientation of the arrow (to the right) and the sketch of the arrow (with half of the point cut off).
- The only real difference is that the arrow touches the ellipse in the case of the Community design and does not do so in the case of the earlier one;
- However, the difference is one which does not alter the general impression of the designs

➡ **Conclusion:** The general impression is substantially the same in both cases.

### **Article 25(1)(e)CDR provides that a design may be declared invalid where**

- a) use is made in that design of a sign similar to its own (see judgment of 12 May 2010, T-148/08, 'instruments for writing', para. 59).
- b) the national law governing that sign confers to its proprietor the right to prohibit its use.

### ➤ a) Use of the earlier in the contested RCD

The ground for invalidity specified in Article 25(1)(e) CDR does not necessarily presuppose a full and detailed reproduction of an earlier distinctive sign in subsequent Community design. Even though the Community design may lack certain features of the earlier distinctive sign or may have different, additional features, this may constitute 'use' of that sign, particularly where omitted or added features are of secondary importance (see judgment of 12 May 2010, T-148/08, 'Instruments for writing', para. 50, and decision of the Board of Appeal of 3 May 2007, R 60972006-3, 'logo MIDAS', para. 17).

### ➤ b) Right to prohibit such use

Article 25(1)(e) CDR expressly refers to the law (national or community) governing the distinctive sign.

# Community designs case law

## Trade mark vs Design

Case R 1148/2010-3 – Packaging

BoA decision of 7 November 2011

Invalidity Application No ICD 7022

RCD No 001019764-0001

Filing date: 15/10/08



Products: boxes, cases, containers, tins or cans

Polish Trade marks

- **Michałki** (word mark) No R 162781
- Figurative trade marks No R138955 and No R 138954



Goods: Cakes and sweet bakery, chocolate bars, sweets, chewing gum, biscuits, caramels, fondante, pralines, jellies, sweets, wafers, confectionary products.

### **Decision based on the Polish trade mark No R-162781 for the word 'michałki'**

- a) Use of the earlier mark in the contested CTM

RCD includes the word «michałki» which is the sole element of the earlier Polish trade mark and is not negligible in the overall impression of the RCD.

- b) Right to prohibit such use

The relevant provisions are those of the Polish Industrial Property Law of 30 June 2000: The consolidated text of the Act, Journal of Laws No. 119/2003 text 1117, as amended by act of 23 January 2004 (Journal of Laws of 2 March 2004 No. 33 text 286), and in particular Article 296 of that law, according to which the proprietor of the mark has the right to prohibit the use of its sign [in the subsequent design] only where, because of the identity or similarity of the goods or services covered by the trade mark and those covered [by the subsequent design], there exists a likelihood of confusion in the part of the public.

### Assessment of the LoC

#### Relevant consumer

- In the present case, the goods covered by the earlier mark were directed at the public at large. For the purpose of a global assessment, the average consumer of the category of goods in question is deemed to be reasonably well informed and reasonably observant and circumspect.
- Furthermore, since the earlier mark in question is a trade mark registered in Poland, the relevant territory for the purpose of analysing the likelihood of confusion is Poland. Therefore, the impression that the contested RCD and the mark make on the public in this territory is relevant (see judgment of 12 may 2010, T-148/08, 'Instruments for writing', para. 108).

## Assessment of the LoC

### Comparison of the marks

- The average consumer's attention will be drawn to the word 'michałki' in the RCD on account of its central position, its letters that are larger than the remainder of the word elements, and the fact that the semi circle is flanked by thin pale green horizontal lines. The wording 'TRADYCYJNE' meaning 'traditional', commonly used to denote established methods of elaborating products and 'od 1923' meaning 'from 1923' designating the period of establishment of the undertaking are not distinctive elements. The word 'michałki' is the plural diminutive form of the Polish first name 'Michel' (Michael). 'Hanka', will be perceived as a name in feminine form. 'Hanka' does not, however, overshadow or prevail over the word 'michałki', which is at least striking; The Board, therefore, considers that the word 'michałki' plays an independent distinctive role in the RCD.
- Accordingly, insofar as the RCD includes the word 'michałki', which is the sole element of the earlier Polish trade mark, the RCD is clearly, visually, phonetically and conceptually similar to the earlier trade mark from being discernable in the contested RCD.

### Assessment of the LoC

#### Comparison of the goods

- In the present case, the contested design was registered for 'boxes, cases, containers, (preserve) tins or cans'.
- the products on which the contested RCD is intended for may be used to package any of the goods protected by the earlier trade mark. 'Cakes and sweet bakery, chocolate bars, sweets, chewing gum, biscuits, caramels, fondante, pralines, jellies, sweets, wafers, confectionary products' are commonly packaged in 'boxes, cases, containers, (preserve) tins or cans'.
- There is, therefore, a complementary relationship between the use of the packaging and the marketing of any of the Class 30 products. The goods at issue may be considered similar.

### Likelihood of confusion

- Taking into account the similarity of the RCD and the earlier mark and the similarity of the products in which the design is intended to be incorporated and the earlier mark's goods, there is a likelihood of confusion within the meaning of Article 296 of the Polish Industrial Property Law.

### ➡ Conclusion

The contested RCD is declared invalid on the basis of Article 25(1)(e)

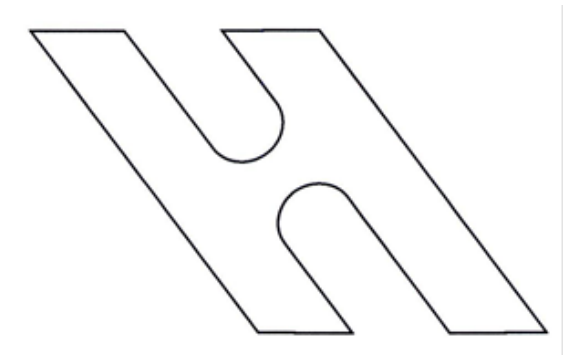
### Case R 120/2009-3 – Shoe BoA Decision of 18 January 2012

**RCD**  
**No 794870-0003**



Products: Footwear

**Spanish trade mark**  
**No 3 783 073**



Goods: Footwear

### Case R 1341/2010-3 – Footwear decorations BoA Decision of 18 January 2012

- The Community design represents a shoe on which there is likewise a figurative sign, the structure of which resembles that of an upper-case 'H';
- The differences do not prevent the earlier trade mark potentially being perceived, visually, aurally and conceptually, in the Community design;
- Since the signs are similar and the goods are identical, the conditions are met for the trade mark proprietor to be able to exercise its exclusive right against the proprietor of the design pursuant to Article 9 CTMR

### Case R 2179/2010-3 – Cleaning devices BoA Decision of 26 October 2011

**RCD**

**No 1027718-0001**

Filing date: 24/10/08

**3D CTM**

**No 5 185 079**

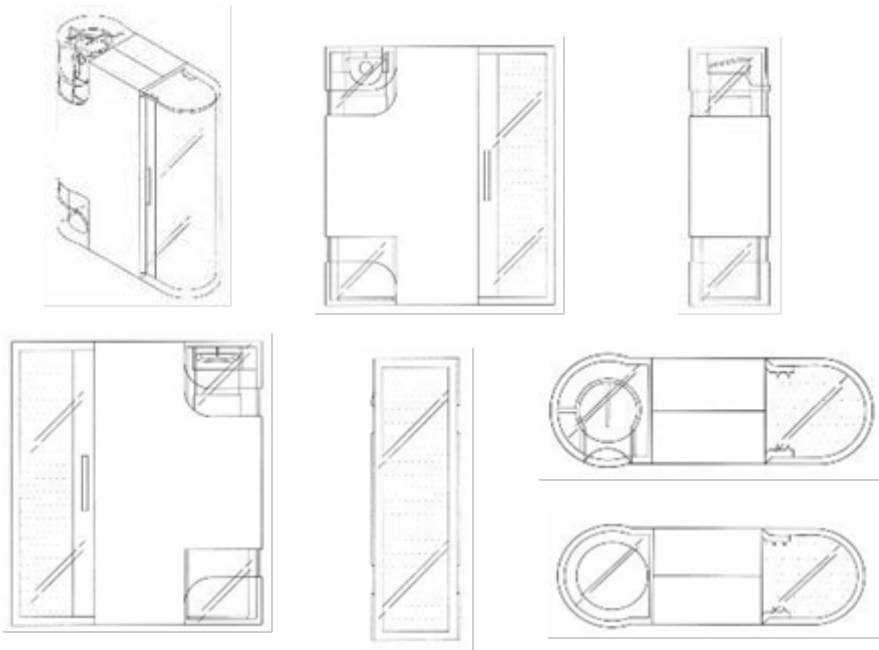
Filing date: 07/07/06



Goods:

Class 3 – Cleaning agents (not for use in manufacturing or for medical purposes), including for office machines, for audio and video apparatus and for computers; cleaning fluids (not for use of manufacturing or for medical purposes), including cleaning fluids for office machines, CD players, pick-up needles, video players, cassette recorders, sound heads for tape recorders; cleaning fluids for computer screens, glass filters for computer screens, keyboards, mice, printers and copying apparatus, disc drives, DVDs, CDs; tissues impregnated with preparations for cleaning office machines, for DVDs, CDs; polishing preparations for plastic surfaces on computers, printers and scanners; impregnated cloths (disposable);

Class 21 – Equipment and containers for cleaning, including sponges, brushes, wipes, dusting cloths, mops.



Products: Cleaning devices

### Case R 2179/2010-3 – Cleaning devices BoA Decision of 26 October 2011

- Article 25(1)(e) CDR does not presuppose a full and detailed reproduction of an earlier distinctive sign in a subsequent RCD. Though the RCD may lack certain features of the earlier distinctive sign or may have different, additional features, this may constitute 'use' of that sign, particularly where the omitted or added features are of secondary importance.
- The earlier 3D trade mark is a cleaning device in the shape of a compact rectangular body rounded at the edges. One side of the compact body houses a spray device. On the opposite side a sponge in the form of cylindrical element is attached.
- RCD is also a cleaning device in the shape of a compact rectangular body rounded at the edges and housing a spray device on one side and a cylindrical sponge on the other. It contains some additions and differences, such as a transparent cap and a transparent bottom part on both sides of the main body, as well as a thin plastic cover placed around the sponge

### Case R 2179/2010-3 – Cleaning devices BoA Decision of 26 October 2011

- The geometric form, dimensions, and shape of the CTM and the RCD are highly similar and partially almost identical in appearance. The additions in the RCD only consist of slight changes to relatively small details and are therefore of secondary importance and do not prevent the perception of the sign included in the RCD.
- The goods covered by the earlier mark are directed at the public at large.
- The products in which the contested RCD is intended to be incorporated, 'cleaning devices', are identically included in the list of goods for which the CTM is registered, i.e. cleaning agents and equipment and containers for cleaning.
- It may be doubtful whether the public would consider the shape of the device as indicative of its origin, in particular if the device carries no labelling. However, even where the earlier mark is of a weak distinctive character, there may be a likelihood of confusion, in particular, as in the present case, where the goods in question are identical and the signs at issue are similar

## Thank You

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