

## **Registered Community Designs (RCD) Review of invalidity decisions in 2006<sup>1</sup>**

**by Pedro Rodinger**

The year 2006 has seen an important increase of new incoming cases and of cases closed and decisions taken. A review of the OHIM's performance with regard to Community Design invalidities is a pertinent task for those interested in design protection in the European Union.

This article is a contribution from the OHIM Design Department's point of view and focuses on three issues: invalidity statistics and delays; analysis of the decisions taken and the main conclusions on substantive matters; and finally some remarks on appeals against invalidity decisions and their outcome.

### **Some information about statistics, facts and duration of proceedings**

#### Evolution of case load

In 2006, 161 new invalidity applications have been filed. This represents 40% more than in the year before. The number of cases closed reached 156 (64 in 2005). Of these 156 cases, 144 decisions have so far been issued.<sup>2</sup> (44 in 2005). The remaining 12 cases were closed because the invalidity application was withdrawn, or the official fees for filing it were not paid on time, or the RCD was surrendered.

#### Nationalities of applicants and representatives

Regarding the nationality of applicants, 26% are Spanish, 15% are German, 13% are US, and 12% are UK. Italians and Dutch account for 5% each. The rest is split amongst a large number of other nationalities. It is interesting to see the geographical distribution of representatives, who come from Spain in 38% of cases, followed by representatives from Germany (23%), from UK (17%) and Italy (6%).

#### Language of proceedings

The language used in filing a Registered Community Design application is the language of the invalidity proceedings provided it is one of the five

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<sup>2</sup> All invalidity decisions are available at the OHIM Web page under case law

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languages of the Office. If this is not the case, the language of proceedings is the second language indicated in the RCD application of the contested Community design. English is used in 33% of all invalidity cases, Spanish in 29% and Italian and German in 17% each.

### Statement of grounds

An application for invalidity must be based on at least one of the grounds listed in article 25(1) CDR<sup>3</sup>. Nevertheless, it is possible to base applications on more than one ground. About 70% of the invalidity claims are based on article 25(1) b: lack of novelty and individual character. The second most used ground was article 25(1) e: the holder of a trade mark can prohibit its use in a subsequent design. Cases based on article 25(1) d – conflict with a prior design that has been made public after the filing of the new design – exist, but they are not that frequent.

### Low risk of losing a Registered Community Design through invalidity claims

As said above, during the year 2006, 144 decisions were issued. For them in 85 cases (59%) the registered Community design was declared invalid and in 59 cases (41%) the invalidity claim was rejected. This distribution does not change significantly from that of previous years.

Once an invalidity claim has been filed, there is a risk of having the registered Community design being declared invalid. Nevertheless, by the end of 2006, 214,000 designs had been registered and published, whereas the total number of designs declared invalid reached 120. This represents less than 0.1%. Therefore, in general terms, the risk of losing a RCD through an invalidity claim is relatively low.

### Duration in proceedings

Proceedings consist of three stages: the verification of the admissibility of an invalidity claim; the adversarial stage during which the parties exchange facts, evidence and arguments up until the moment the invalidity division decides not to accept any further submissions due to lack of new facts; and finally the stage when the decision is made.

Whereas the admissibility does not take more than one month, the longest part of the life cycle of an invalidity claim relates to the adversarial part (between 6 and 7 months in average during the year 2006). The average delay of all invalidity cases closed during 2006 is 9 months (13 months in 2005).

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<sup>3</sup> Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community Designs

Variety of Registered Community Designs subject to invalidity claims

The cases closed during the year 2006 relate to a vast range of products, such as: plates, lamps, mixers, typographical typefaces, ornamentation, bicycles and motorcycles, logos, perfume and other bottles, sanitary appliances, curtains, radiators for heating, bottle bags, sponges, containers and packaging, foodstuff, engines, communication equipment, metal profiles, metal hooks, faucets, snacks, toy cars, etc.

**Review of the substantive issues dealt with in invalidity decisions issued during the year 2006**

In order to structure this review, the cases discussed below have been grouped according to the relevant articles of the CDR, namely the ones relating to the requirements for protection and particularly articles 4, 5, 6, 7 and 8. Article 3 and 9 are not dealt with, as there are no decisions available yet which deal with them

Limitations of the invalidity division with regard to the decision taking

The examination performed by the invalidity division is restricted to the facts, evidence and arguments provided by the parties<sup>4</sup>. This means that arguments or evidence that are not presented by the parties cannot be introduced by the invalidity division on its own motion. The invalidity division is limited to carrying out the legal evaluation of those facts, evidence and arguments.

When analysing the outcome of the 2006 decisions, one has always to bear in mind this important limitation, as it strongly influences the end-results.

The first potential obstacle: Adequate disclosure of prior art (article 7 CDR<sup>5</sup>)

Looking at the 2006 decisions, it becomes clear that one of the first obstacles an invalidity claim has to overcome relates to the proof of the

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<sup>4</sup> Article 63 CDR

<sup>5</sup> Article 7 § 1 CDR: For the purpose of applying Articles 5 and 6, a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, before the date referred to in Articles 5(1)(a) and 6(1)(a) or in Articles 5(1)(b) and 6(1)(b), as the case may be, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community.

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prior right. An important number of claims have been rejected due to insufficient evidence with regard to the existence of a prior design.

A secure method for proving the existence of a prior design is the use of a publication in a bulletin of an industrial property office. This refers not only to design publications, but it can also refer to patent (provided the appearance of the product can be seen) or trade mark publications. The question may arise as to whether specialised circles can reasonably become aware in the course of normal business of these publications. Looking at the arguments of the parties, there seems to be no problem with regard to publications made within the EU. Doubts were initially raised with regard to publications made outside the EU, and in particular in the US. But there have now been decisions which indicate that publication in the US can be held to be known to the relevant people in the EU?

In a number of cases, the existence of a prior design was based on the use of it in trade. The invalidity claims ICD 2327 – 2418 (RCDs 428842-0001 to 10) are an illustrative example of using a commercial catalogue with a clear indication of the year and invoices that establish a clear relationship between the catalogue and the sale of the design thanks to the use of the reference numbers from the catalogues on the invoices. Third party material is also very useful (e.g. ICD 1576 (RCD 17447-0001) – use of an export magazine or ICD 1782 (RCD 370200-0001) – use of supermarket flyers with indication of date). With regard to the use of catalogues, the invalidity division pays much attention to the adequate proof of the dates. Catalogues without indication of exact dates<sup>6</sup> represent problems. Furthermore, catalogues with an indication of the year of copyright are not automatically considered as to have been made available to the public<sup>7</sup>. Nevertheless, such problems may be overcome with additional evidence, such as third party declarations or affidavits<sup>8</sup>.

The use of the Internet is not a straightforward method for proving disclosure. In a number of cases Internet print outs of the prior designs were not accepted as the date of the print out was after the date of filing of the RCD<sup>9</sup>. Nevertheless, in case ICD 1394 (RCD 289632-0003) one printout from a website was accepted even though it contained

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<sup>6</sup> ICD 875 – RCD 208335-0001, ICD 1642 – RCD 378757-0001 (appealed)

<sup>7</sup> ICD 1386, 1394, 1402 – RCDs 289632-0002, 0003, 0004

<sup>8</sup> ICD 1212 – RCD 299318-0001 - appealed (catalogue with indication of date together with an affidavit indicating the distribution of more than 24000 examples), ICD 2863 – RCD 254875-0001 (certified copy of catalogue with date together with a declaration of the TV station related to the commercials)

<sup>9</sup> ICD 941 to 982 – RCDs 199872-0001 to 0005, ICD 1303 – RCD 312202-0001, ICD 1667 – RCD 378757-0003 (appealed)

information only about the latest update of the web site (and a proper translation of the content of the Internet page into the language of proceeding was filed).

For proving disclosure in the use of trade, sales agreements between parties may also be useful. This was the case in ICD 2244 (RCD 189857-0002), where an import agreement was used as an essential part of the evidence.

One last remark: Evidence that is not submitted in the language of the proceedings or where a translation has not been provided within two months is disregarded<sup>10</sup>.

The impact of the technical function in reaching decisions on invalidity (article 8 CDR<sup>11</sup>)

There are not many cases on this. One case concerns bicycle wheels<sup>12</sup>, where the invalidity division analyses the degree of freedom of the designer, which is limited as “a wheel has to be laced with the spokes between the hub and the rim in order to support the rim and to transfer the weight of the rider to the rim.” The invalidity division therefore concludes that the informed user will pay more attention to features where the designer’s creativity is not limited, namely the number of spokes and their arrangement. Given that these features caused the same overall impression, the RCD was declared invalid.

Another case concerns internal combustion engines<sup>13</sup>. The invalidity division stated that features of a complex product which are not visible during normal use, as well as those solely dictated by technical function, are to be disregarded when assessing novelty and individual character. In the examination of the case, the features that are clearly visible and not linked to the technical function (e.g. the fuel tank, the vent, the air filter, etc.) define the degree of freedom of the designer. The informed user is aware of this and will therefore appreciate the differences of those features which produce a different overall impression.

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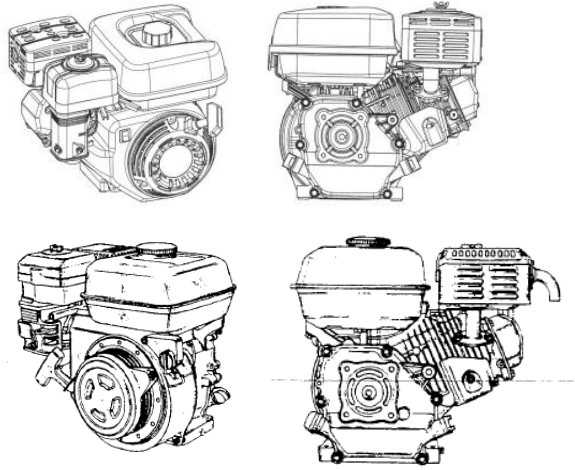
<sup>10</sup> ICD 560 – RCD 49424-0001 (appealed)

<sup>11</sup> Article 8 § 1 CDR: A Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function.

<sup>12</sup> ICD 602 – RCD 107115-0003

<sup>13</sup> ICD 1006 – RCD 163290-0002 (appealed)

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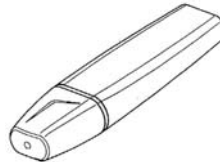


Towards the end of 2006, the Boards of Appeal confirmed the decision of the invalidity division with regard to underwater motive devices<sup>14</sup>, where the degree of freedom of the designer was considered limited only to some extent by technical function due to the necessary longitudinal body and the handle. The invalidity division found that those parts have been designed in a way that causes same overall impression.

### Overlap with trade marks (article 25(1) e CDR<sup>15</sup>)

Since article 3 of the CDR includes graphical symbols as products, the appearance of a graphical symbol can be a design, which leads to the possibility of an overlap between designs and trade marks. Therefore, it is necessary to have an appropriate defence mechanism for trade mark owners, whose trade marks are used in designs. Article 25(1) e caters for this.

Although this particular ground has been claimed in 31 invalidity applications, decisions have been taken only in eight cases, which related actually to three different issues. In all three issues, appeals are pending and therefore no definitive information yet exists as to whether the invalidity division decisions are well founded.



<sup>14</sup> ICD 867 – RCD 225073-0001 – Appeal case R 196/2006 of 22/11/2006

<sup>15</sup> Article 25(1) e: If a distinctive sign is used in a subsequent design, and Community law or the law of the Member State governing that sign confers on the right holder of the sign the right to prohibit such use;

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The first case concerns the conflict between a word mark "Midas" and a design for logos including the word "midas"<sup>16</sup>. The invalidity division considered that a trade mark that is registered in a Member State of the European Union is presumed a distinctive sign in the sense of article 25(1) e. The fact of including the letters m, i, d, a and s forming the word "midas" in the design constitutes an identical use of sign and its holder has the right to prohibit its use in relation to identical goods or services (article 5 of the Directive 89/104/EEC applicable in all Member States). The RCD is a logo and relates therefore intrinsically to any type of goods and services, which includes in an identical way the goods and services of the word mark. The RCD was declared invalid.

A second case concerns the conflict between a three-dimensional trade mark for writing instruments in class 16 of the Nice classification ("STABILO") and a design for writing instruments<sup>17</sup>. A register extract from the German Trade Mark Office was accepted as a valid proof for having a distinctive sign. The invalidity division considered that the design incorporated characteristic features of the three-dimensional trade mark and that the goods for both designs were the same. Due to the similarity between the design and the trade mark and the identity of the goods covered, likelihood of confusion was considered to exist, which gave the applicant the right to prohibit the use of the sign in the design. The RCD was declared invalid.

In the third case<sup>18</sup>, a packaging design for small bottles of yoghurt (the representation of the design includes the label 'Danone') came in conflict with the international Danone trade mark (extract from Romarin database). The design was declared invalid.

An interesting case with regard to conflict with trade marks is ICD 2467 (RCD 253273-0001). The design for a handbag shows the 'Burberry' pattern and the invalidity was based on the 'Burberry' trade mark and on catalogues. Nevertheless, the statement of grounds only referred to lack of novelty and individual character and no decision could be taken with regard to article 25(1) e. The 'Burberry' pattern has also been subject of another invalidity claim<sup>19</sup>. Although the letter e was stated as one of the grounds in this case, the design has been declared invalid based on letter b on the basis of a prior publication of design with the Burberry pattern.

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<sup>16</sup> ICD 1501 – RCD 162425-0004 (appealed)

<sup>17</sup> ICD 2426 – RCD 352315-0007 (appealed)

<sup>18</sup> ICD 2939 – RCD 339312-0001

<sup>19</sup> ICD 1568 – RCD 286430-0001

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### The trap of the publication delay (article 25(1) d CDR<sup>20</sup>)

When assessing novelty and individual character, the moment of disclosure of any prior art is an essential element. In general terms, a designer who keeps himself updated with the trends in his field and who also makes the relevant clearance search before registering a design should not run into too many problems.

Nevertheless, the process of filing and publishing a design takes time. In addition, the CDR allows for keeping designs secret (deferment up to 30 months). This provision exists also in other national design protection systems. Therefore, even when looking to what is being published in the different design bulletins, there is always a gap between the date of filing and the date of publication (disclosure in the sense of article 7 of the CDR). Article 25(1) d relates to this type of situation.

Two questions have to be raised in this context: what are the relevant dates of filing and publication of the prior design and is the subsequent design in conflict with the prior design?

The invalidity division dealt with a number of cases in 2006 that show how these two questions are approached<sup>21</sup>. The establishment of the sequence of dates is a straightforward task based on the evidence of the registration certificate. In some of the cases, the invalidity applicant only provided a reference number of his own RCD instead of a reproduction. In these cases, the invalidity division checked ex officio the existence and reproduction of the design.

The key issue relates to how to define the concept of conflict between the two designs. Since the first decision based on article 25(1) d<sup>22</sup>, the invalidity division interprets this as falling in the scope of protection of the prior design in the meaning of article 10 CDR. This means that the new design produces on the informed user the same overall impression, taking into account the degree of freedom of the designer.

This reasoning has been confirmed by a Board of Appeal decision<sup>23</sup> where the following confirmation is made under point 14: "In other words

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<sup>20</sup> Article 25(1) d: If the Community design is in conflict with a prior design which has been made available to the public after the date of filing of the application or, if a priority is claimed, the date of priority of the Community design, and which is protected from a date prior to the said date by a registered Community design or an application for such a design, or by a registered design right of a Member State, or by an application for such a right;

<sup>21</sup> ICD 1824 to 1923 – RCDs 330402-0001 to 17, ICD 2038 to 2046 – RCDs 264130-0001 to 0002, ICD 2194 – RCD 344601-0001

<sup>22</sup> ICD 24 – RCD 3595-0001 of 27/04/2004

<sup>23</sup> Appeal R 1001/2005 of 27/10/2006

a conflict exists when the earlier design would, if it had been made available to the public before the filing date (or priority date) of the later design, have deprived the later design of individual character within the meaning of Article 6 CDR. That interpretation has been accepted by both the parties and is clearly correct.”

The use of disclaimers in filing RCDs and their impact at invalidity stage

Disclaimers are used at the filing stage of RCDs in order to clearly mark that part of the product for which protection is claimed. Some examples are the use of dotted lines, colour shading or blurring.

A clear example can be found in ICD 2657 (RCD 346861-0013): The RCD concerns ornamentation for shoes and represents monkeys. The representation of the design is made by using a disclaimer that makes clear that the only part for which protection is sought is the monkeys. The prior design is a shoe with donkeys as ornament. Although the shoes are quite different, they do not count due to the disclaimer. The donkeys are identical and the RCD was declared invalid.



A similar case relates to saucepan handles<sup>24</sup> where the invalidity division declared the RCD invalid as the saucepan handles were practically identical, despite the fact that the saucepans were different.

Multiple design applications – individual invalidity claims

About 50% of all RCDs are filed by using multiple applications, whereas the rest are filed individually. As clearly indicated in the Invalidity Guidelines, RCDs must be contested individually, even if they are contained in a multiple application. Where more than one design of a multiple registration is contested, the applicant must file a separate application for a declaration of invalidity for each contested design.

The invalidity division treats these cases individually, assessing the proofs and the novelty and individual character for each single design.

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<sup>24</sup> ICD 2202 – RCD 123013-0001 (appealed)

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Therefore, some designs may be declared invalid, others not. The reasons for such a different outcome of decisions lies on the one hand on the quality of the facts, evidence and arguments provided and on the other hand on the difference (or lack of difference) of the designs.

ICD 1089 to 1139 (RCDs 218847-0001 to 0006) may serve as illustrative examples: They relate to the same RCD application where six designs have been filed concerning stuffed toy animals with different clothing. One of the designs was declared invalid due to lack of novelty. In five cases the invalidity application has been rejected because the invalidity division considered that they had individual character due to important and very visible differences of the clothing. In three of those five cases, the decision has been appealed.



ICD 891 to 933 (RCDs 253497-0004 to 0005) is another example where five designs related to coffee services (plates) came under invalidity attack. Three of them were declared invalid due to lack of novelty.

### Designs that did not fulfil the novelty requirement – borderline between novelty and individual character

Designs that are identical, or where the features differ only in immaterial details, do not fulfil the novelty requirement. Of course, a design that does not fulfil the novelty requirement can still be declared invalid due to lack of individual character.

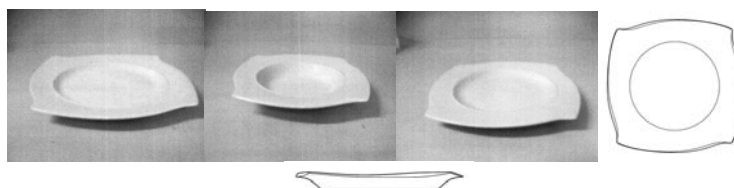
Generally speaking, the approach of the invalidity division when making the novelty test is to compare all the features of the designs, analysing differences between these features and then evaluating if these differences are relevant. Therefore it is interesting to see where the borderline is regarding immaterial details and to what extent the invalidity division bases its decisions on novelty.

ICD 1220 (RCD 299318-0002) is a good example of this approach. The design was for display units for spectacles. The different elements of these units were examined with regard to their form, length, width, proportions and distance between them, by making use of all available views. Three features were identified as more than immaterial differences: the different number of lateral devices, the representation of the signal mark in the cross-section and the different form of the closing

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handle. Therefore, the invalidity division did not base its decision on novelty, but on lack of individual character. This decision has been appealed.

In a case relating to plates,<sup>25</sup> the invalidity division considered the designs as being identical due to the same shape and the special way the borders are made. No differences between the designs was found, even though the plates had different depths, which nevertheless could not be properly perceived with the images.



Another case relates to microphone designs<sup>26</sup> which were considered identical except for the difference in the labels, and that was held an immaterial detail because their similar small size had no essential impact on the design.

In a further case,<sup>27</sup> the invalidity division came to the conclusion that the design of a lighter reproduces the prior 'BIC' design completely, as the body with oval sections, the oval base, the protection of the lightening mechanism and other elements were identical, and the presence of horizontal and vertical lines was considered as an immaterial detail.

With regard to designs<sup>28</sup> relating to taps, the invalidity division considered that one design was identical to a prior 'HANSA' design, whereas a second design passed the novelty test because even though the upper part of the tap was identical, the body was higher and curved, which was considered more than an immaterial detail. In the end, this second design was declared invalid due to lack of individual character.

A perfume bottle has also been considered identical<sup>29</sup>, as all the features of shape and contours specified were anticipated by the prior design. Both designs had the same rounded heart shape, the same proportions, an identical trigger pump occupying the same position at the top in the centre and the same stylised little heart designed in the glass at the bottom on the left side of both bottles.

<sup>25</sup> ICD 1592 to 1618 – RCDs 228333-0010 to 0012

<sup>26</sup> ICD 1329 to 1378 – RCDs 288229-0001 to 0006

<sup>27</sup> ICD 2640 – RCD 273693-0001

<sup>28</sup> ICD 2871 and 2889 – RCDs 433644-0002 and 0003

<sup>29</sup> ICD 1576 – RCD 17447-0001

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In a case concerning motor scooters,<sup>30</sup> the invalidity division concluded that all the different parts of the two scooters were identical (the bicycle frames, the tyres, the steering wheel, the bell, the shopping basket fixed at the front part of the steering wheel, the rack behind the seat, the saddle and the spokes). Nevertheless, due to the representation of one of the designs in black and white and the representation of the other in colour the designs were not considered identical. They were nevertheless declared invalid due to lack of individual character.

In a resolution<sup>31</sup> from November, the Board of Appeal confirmed a decision from the invalidity division declaring a coffee maker design invalid due to lack of novelty as compared to a prior Spanish trade mark, published in the bulletin of the Spanish Patent and Trade Mark Office. In fact, both designs shared the same external appearance, except for some immaterial differences (colour of the handle, small indication of a word mark). With regard to the prior Spanish trade mark, the Board indicated furthermore that the scope of protection of the trade mark is completely irrelevant for assessing novelty. What matters is the representation.



<sup>30</sup> ICD 2244 – RCD 189857-0002

<sup>31</sup> Appeal R 216/2005 from 8/11/2006 – ICD 65 (RCD 5269-0001)

Examples of the individual character test

Article 6 of the CDR gives the definition of a design having individual character if its overall impression on the informed user differs from the impression of the prior design, taking into consideration the degree of freedom of the designer in developing the design.

The case ICD 1782 (RCD 370200-0001 – two label designs for Vodka) shows in general lines how the invalidity division applies the different concepts foreseen in article 6. The novelty test reveals the features which differ between the two designs and which are considered to be material (colour of label background, verbal elements, number of coins). The invalidity division considered that the informed user knows about labels for bottles of spirits providing product and trade mark information and which have to fit to the bottle. Furthermore, it was considered that these labels offer an almost unlimited degree of freedom for designs. With these two conditions in mind, the invalidity division came to the conclusion that the differences between both designs mentioned above are not sufficient to produce different overall impression. The RCD was declared invalid.



Two designs for rehabilitation equipment for the back<sup>32</sup> were considered to produce the same overall impression on the informed user who is familiar with such rehabilitation equipment. The differences (variation of the colours, the fixed support on the front and the small metallic chains together with the attached pieces of leather) were not sufficiently strong to out-weigh the characteristic similarities, given the fact that the degree of freedom of the designer for such products has only to take into account fixing the back posture and preventing deformation of chests. Also in this case, the RCD was declared invalid.

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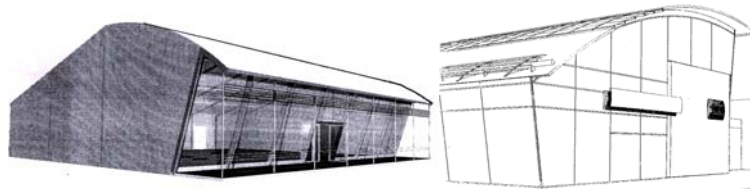
<sup>32</sup> ICD 2863 – RCD 254875-0001

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Towards the end of 2006, the invalidity division took a decision with regard to a Ferrari toy car design<sup>33</sup>. The invalidity division considered that the degree of freedom of the designer for toy cars is relatively large. Nevertheless, in the present case, both designs represent a Formula 1 car with similar characteristics, and even though some elements are different (e.g. spoilers, wheels, etc.), an informed user will get the same overall impression. Therefore the RCD lacked individual character and was declared invalid.



The coffee services (plates) decision discussed in the chapter of multiple design applications and individual invalidity claims<sup>34</sup> above is an example of the importance of different proportions between designs. The plates are both made of porcelain and their borders are designed in a very similar way. Nevertheless the plates have different proportions (width to height: 3 to 1; lengths to width: 2 to 1). These differences produce different overall impression on the informed user, who knows that proportions are one important feature for such plates (sometimes even the only one) in order to distinguish parts of coffee services.



In another invalidity case, a tent and a building were compared<sup>35</sup>. The invalidity applicant based his claim on two grounds: lack of novelty and individual character and conflict with copyright (article 25(1) f). With regard to the first claim, the invalidity division found a number of relevant differences between the two designs: the separation of the roof in a linear and curved part, the position of the entrance and the windows, the composition of the lateral wall. They produce a different overall

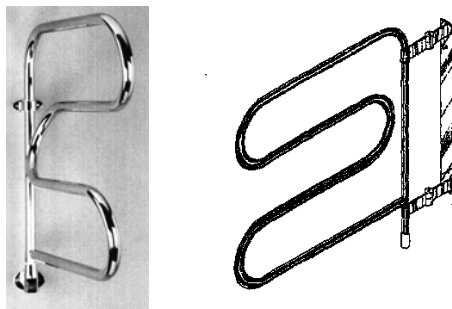
<sup>33</sup> ICD 842 – RCD 375593-0001 (appealed)

<sup>34</sup> ICD 891 and 909 – RCDs 253497-0004 and 0005

<sup>35</sup> ICD 1014 – RCD 27826-0001

impression on the informed user who knows that, even though a designer has to respect the necessary basic elements for buildings, such as a roof, walls and entrance, he has a large degree of freedom. With regard to the second claim, the invalidity division considered that the work was not used due to these same differences.

The repetition of a feature of a prior towel holder (several U-shaped loops instead of one single loop) or the twisting of a loop of a prior towel holder giving it an increased three-dimensional aspect has been considered as causing a different overall impression on the informed user who is familiar with such towel holders, which often comprise loops<sup>36</sup>.



In a case related to bottle carriers<sup>37</sup>, the invalidity division took the view that an informed user was aware of their two basic elements, namely the compartment for the bottle and the handle, and that the designer had limited freedom as such carriers need to fit bottles, which requires a cylindrical body, but nevertheless, he enjoyed a broader degree of freedom with the carrier handle. Whereas one design has a long cylinder with integrated handles, the other design is shorter and with separate handles that are also more elliptical. This led to a different overall impression and the rejection of the invalidity claim.

In a resolution<sup>38</sup> from November, the Board of Appeal confirmed a decision from the invalidity division about biscuits, where the invalidity claim that the RCD did not lack novelty or individual character was rejected. The prior design in this case was a Spanish trade mark that has been published prior to the filing of the RCD application. Whereas both designs have the same 'sandwich' form, their surface ornamentation was considered by the invalidity division as sufficiently different as to allow the informed user to get a different overall impression, because he knows that these biscuits consist of two parts of biscuit filled with cream and therefore focuses more on the biscuit surface.

<sup>36</sup> ICD 941 to 982 – RCDs 199872-0001 to 0005

<sup>37</sup> ICD 2053, 2095, 2103 – RCDs 387584-0003, 0001, 0002

<sup>38</sup> Appeal R 1310/2005 from 28/11/2006 – ICD 339 (RCD 58334-0001)

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### The first case before the Court of First Instance

The last case in this paper is actually the first Community design case before the Court of First Instance: The invalidity proceeding<sup>39</sup> Grupo Promer Mon-Graphic, S.A. v. Pepsico Inc. concerns promotional items for games, so-called metal rappers.

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Prior design



The invalidity division considered that the two opposing designs for promotional items had all the basic features in common and only minor deviations in the profile of the central area give rise to small variations in the surface patterns. Furthermore, the invalidity division considered that the degree of freedom of a designer for such promotional items is relatively large and took it that an informed user knows about promotional items for games and that he knows in particular that the targeted consumers will pay more attention to graphical elements than to small variations in the basic shapes of the items. Therefore, the invalidity division ordered the cancellation of the RCD was because it shared the same overall impression.

The Board of Appeal annulled this decision<sup>40</sup> based on the following arguments: The designs belong to a particular type of promotional item, namely rappers. This limits the designer's freedom severely. Therefore, the difference in the contours of the raised area in the center of the disks is sufficient to produce a different overall impression on the informed user. The Board's decision is now on appeal to the Court of First Instance (T-9/07).

### **Appeal cases on invalidity decisions**

The number of appeals filed against invalidity decisions increased significantly in 2006. In 2005, only 5 appeals were filed, whereas in 2006, 24 appeals were lodged.

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<sup>39</sup> ICD 172 (RCD 74463-0001) from 20/6/2005

<sup>40</sup> Appeal R 1001/2005 from 27/10/2006

Taking into account that appeals need to be filed within two months of the decision, the 144 invalidity decisions led to 36 appeals, which represents an appeal rate of 25%. This is a similar rate to appeals in CTM opposition proceedings. Of these 36 appeals, 22 are against decisions rejecting the invalidity claim and 14 relate to decisions declaring a RCD invalid.

By the end of February 2006, the Boards had rendered 8 decisions, concerning 5 different cases. In two of these cases, the Board overruled the invalidity division: One case concerns the metal rappers described above; another case concerned the question of whether once the invalidity division had given its decision, and the two month period during which an appeal could be filed had started to run, the invalidity application could be withdrawn.<sup>41</sup> The Boards decided that it could be withdrawn. In the three other cases (R 196/2006, R 216/2005 and R 1310/2005 as explained earlier in this document), the Boards confirmed the decision taken by the invalidity division.

#### **Brief evaluation of the state of play of the Community Design invalidity**

Invalidity claims increased, even though they are still very low as compared to the number of RCDs, and the risk of losing a RCD is very low. 2006 has seen an important rise in the volume of decisions from the invalidity division. The Boards of Appeal rendered their first decisions and more are expected within the coming months. Given this development, the year 2007 might therefore be a first step towards a certain consolidation of the invalidity practice at OHIM.

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<sup>41</sup> Appeals R 736/2005 and R 737/2005 from 8/12/2006 concerning ICD 16 (RCD 16183-0001) and 107 (RCD 16183-0002)