



**OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)**

OPERATIONS DEPARTMENT - Designs Service

Alicante, 17/02/2016

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| Fax number: | 00 31-880243001 |
| Your reference: | ADV2015-0666 |
| Community Design concerned: | 001710245-0003 |
| File number of the Invalidation application: | ICD 9934 |
| Language of the proceedings: | English |

**NOTIFICATION OF A DECISION OF THE INVALIDITY DIVISION
COMMUNICATION TO THE APPLICANT**

Please find enclosed the decision of the Invalidation Division in relation to the Invalidation application referred to above.

Janine ANTON

Attached: Decision of the Invalidation Division

By registered mail



INVALIDITY No ICD 9934

JPMC Investment Group B.V., Willem Dreeslaan 14, 3515 GB Utrecht, The Netherlands (applicant), represented by **Deterink Advocaten en Notarissen**, P.O. Box 3, 5600 AA Eindhoven, The Netherlands (professional representative)

a g a i n s t

EosProducts S.A.R.L., 7 Rue Robert Stumper 2557 Luxembourg Luxembourg (holder), represented by **Bird & Bird LLP**, Carl-Theodor-Str 6, 40213 Düsseldorf Germany (professional representative).

On 16/02/2016, the Invalidity Division takes the following

DECISION

1. Registered Community design No 001710245-0003 is declared invalid.
2. The holder bears the applicant's costs, fixed at EUR 750.

REASONS

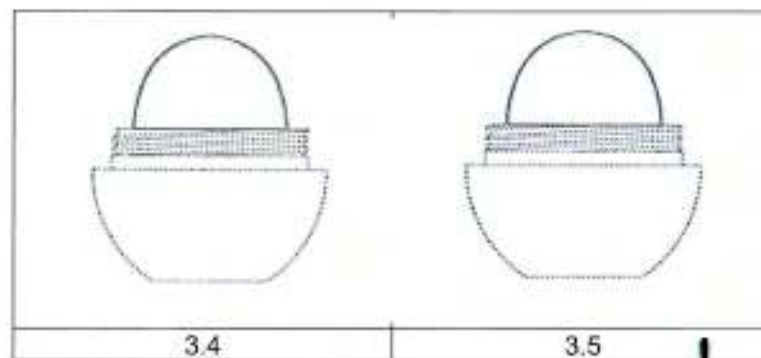
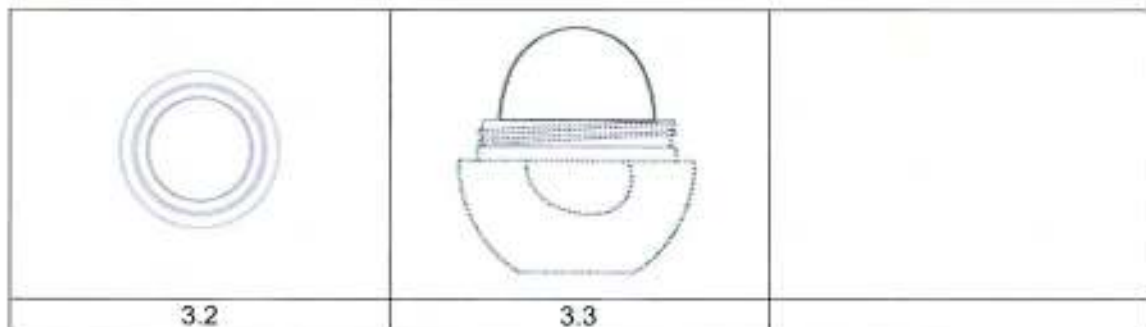
The applicant filed an application for a declaration of invalidity (the application) against Community design No 001710245-0003 (RCD). The RCD was filed and registered in the holder's name on 20/05/2010. The priority was claimed from three United States' applications, namely application No 29/350,721 filed on 23/11/2009, application No 29/350,720 filed on 23/11/2009 and application No 29/351,278 filed on 03/12/2009. The following product is indicated in the registration:

28-02 *Lip balm dispenser.*

The application for registration contains the following description of the design:

Fig. 1 is a top perspective view of the spherically-shaped lip balm; Fig. 2 is a top view of the spherically-shaped lip balm; Fig. 3 is a front view of the spherically-shaped lip balm; Fig. 4 is a rear view of the spherically-shaped lip balm; Fig. 5 is a side view of the spherically-shaped lip balm.

The registration contains the following images:



Please note that the images in this document are not necessarily to scale.

On 08/02/2016 a transfer of ownership of the RCD to Eos Products S.A.R.L. was recorded in the OHIM's database.

The applicant invoked Article 25(1)(b) CDR in conjunction with Article 4 CDR.

SUMMARY OF THE PARTIES' ARGUMENTS

The applicant argued that:

- The contested RCD lacked novelty and individual character in the light of the prior designs invoked.

In support of its observations, the applicant submitted the following evidence:

- An excerpt from the patent database of the United States Patent and Trademark Office regarding design patent No D554,529 S (D1) for a *perfume applicator*, published on 06/11/2007. This document contains, inter alia, the following graphic depiction of the invention:



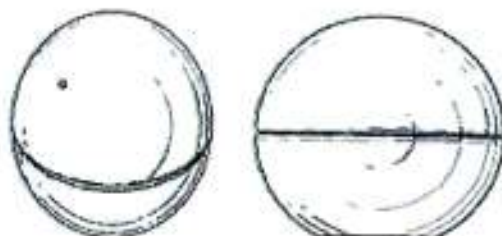
- Samples of products called 'spherical jars', which, according to the applicant, have been marketed and sold since February 2008 by Quadpack Group, a company that produces jars and bottles for cosmetics. A screenshot from the website of the company Quadpack was submitted; the information and photo are dated February 2008. The design (D2) is shown below:



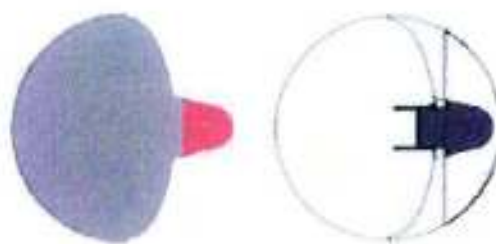
- An excerpt from the patent database of the United States Patent and Trademark Office regarding design patent No D564,900 S (D3) for a *spherical container with a flat base*, published on 25/03/2008. This document contains, inter alia, the following graphic depiction of the invention:



- An excerpt from the patent database of the United States Patent and Trademark Office regarding design patent No D465,733 S (D4) for a *container, primarily for perfume*, published on 19/11/2002. This document contains, inter alia, the following graphic depiction of the invention:



- An excerpt from the database of the French National Institute of Industrial Property regarding design No 040004-001 (D5) for a *distribution and application capsule of lipsticks and liquid products*, published on 23/02/2007. This document contains, inter alia, the following graphic depiction of the design:



The RCD holder argued that:

- The contested design is new and unique in the cosmetic lip balm sector. The inner dome-like shape is absolutely new and unique in the cosmetic lip balm sector. The holder declares expressly that as far as the views show dotted lines said features are not protected. The dome shall be embedded in a semi egg shaped container with a bottom part that has a slightly bigger diameter than the dome. The holder showed the following use in the market of the RCD:



ARTICLE 25(1)(b) CDR IN CONJUNCTION WITH ARTICLE 4 AND ARTICLES 5, 6, and 7 CDR

a) Disclosure pursuant to Article 7 CDR

For the purpose of applying Articles 5 and 6 CDR, the tests of novelty and individual character, a design will 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 RCD filing date or the RCD priority date, if a priority is claimed, 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 EU.

The onus is on the invalidity applicant to prove the disclosure of the earlier designs. There are no provisions in the CDR or the CDIR as to the kind or specific form of evidence the invalidity applicant is required to furnish to prove that the prior design on which the application for a declaration of invalidity is based has been made available to the public before the relevant date.

Article 28(1)(b)(v) CDIR only states that where the ground for invalidity is that the RCD does not fulfil the requirements set out in Article 5 or 6 CDR, the indication and the reproduction of the prior designs that could form an obstacle to the novelty or individual character of the registered Community design, as well as documents proving the existence of those earlier designs have to be contained in the application.

It follows that, on the one hand, the invalidity applicant is free to choose the evidence it considers useful to submit in support of its application of invalidity and that, on the other hand, the Office is required to examine the evidence in its entirety in order to establish whether there is sufficient proof of a prior disclosure within the meaning of Article 7(1) CDR (judgment of 09/03/2012, T 450/08, 'Phials', paragraphs 21 23).

In this regard, the disclosure of an earlier design cannot be proved by means of probabilities or suppositions, but must be based on solid and objective evidence that proves that the earlier design was made available to the public within the meaning of Article 7 CDR (judgment of 09/03/2012, T 450/08, 'Phials', paragraph 24).

With reference to the evidential value of the individual documents, this means that regard should be had first and foremost to the credibility of the content. It is necessary to take account, in particular, of the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, on its face, the document appears sound and reliable (judgment of 09/03/2012, T 450/08, 'Phials', paragraphs 23, 24, 26).

The case-law further specifies that the items of evidence submitted by the applicant for a declaration of invalidity must be weighed against each other. The reason for this is that, although some of the items of evidence may be insufficient in themselves to demonstrate the disclosure of a prior design, the fact remains that, if they are combined or read in conjunction with other documents or information, they may contribute towards establishing proof of the disclosure (judgment of 09/03/2012, T 450/08, 'Phials', paragraph 25).

Publication of an earlier design in the bulletin of any industrial property office worldwide constitutes disclosure and it is only where this publication cannot reasonably become known to the professionals of the sector concerned within the European Union that the rule is affected by an exception. Therefore, once proof of publication has been provided by the applicant, disclosure is assumed to have taken place and, considering the globalisation of the markets, it is incumbent on the holder to provide facts, arguments or evidence to the contrary, namely that publication of the earlier design could not reasonably have become known to the circles specialised in the sector concerned, operating within the European Union (decision of 27/10/2009, R 1267/2008-3 – 'Watches', paragraph 35 et seq; decision of 07/07/2008, R 1516/2007-3 – 'Cans', paragraph 9, and judgment of 07/11/2013, T-666/11, 'Gatto domestico', paragraph 25).

Whether or not the publication takes place before or after registration is irrelevant (decision of 15/04/2013, R 442/2011-3 – 'Skirting Boards', paragraph 24).

The submitted excerpts from the United States Patent and Trademark Office for D1, D3 and D4 and from the French National Institute of Industrial Property for D5 show a publication date that predates the filing date and priority date of the contested RCD. Therefore, the excerpts are evidence of the disclosure of D1, D3, D4 and D5 prior to the filing date and priority date of the contested RCD in the meaning of Article 7(1) CDR (decision of 29/01/2014, R 1464/2012-3 – 'Doors (part of —)', paragraph 24).

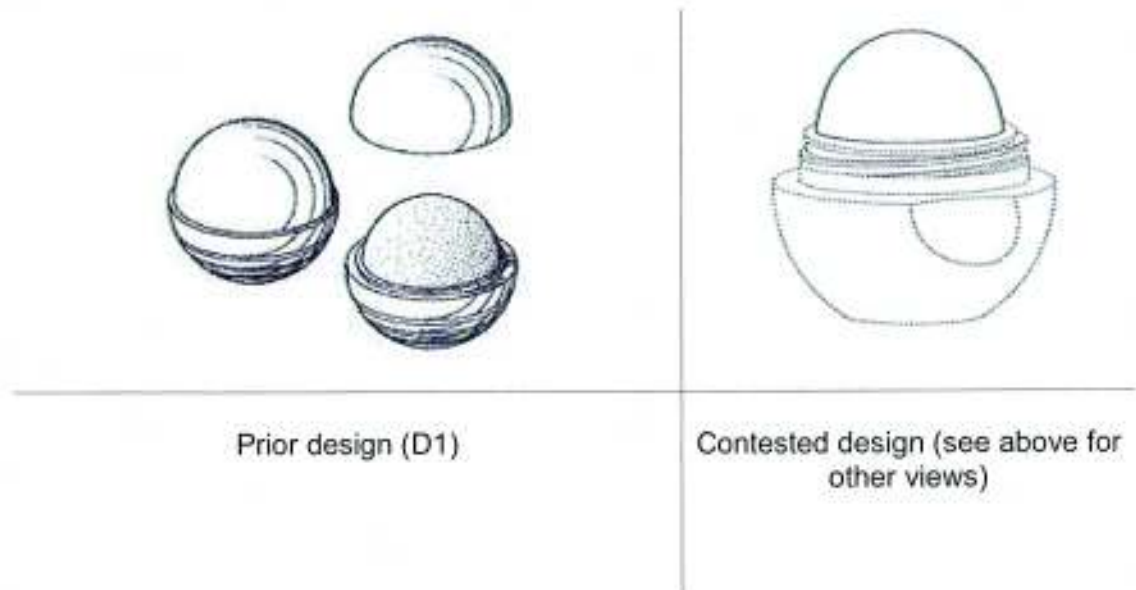
Disclosures derived from the internet form part of the prior art. The date of disclosure on the internet will be considered reliable in particular when the website provides timestamp information relating to the history of modifications to the web page. The submitted screenshot from the website of the company Quadpack shows a photo of the 'spherical jar' that is explicitly dated February 2008. As a result, this is a reliable date for the disclosure of design D2.

The Invalidity Division will analyse the novelty on the basis of D1 for the reasons of procedural economy first because if this leads to declaring invalid the RCD there is no need to compare the RCD with other prior designs.

b) Novelty pursuant to Article 5 CDR

Article 5(1)(b) CDR provides that a registered Community design must be considered to be new if no identical design has been made available to the public before the date of filing of the application for registration of the design for which protection is claimed or, if priority is claimed, the date of priority. Article 5(2) of that regulation provides that designs must be deemed to be identical if their features differ only in immaterial details.

The designs under comparison are shown below:



In order to facilitate the comparison a representation of the contested design is shown as marketed corresponding to the images of the RCD:



The applicant relies upon the following similarities between the RCD and the prior design: all designs have a semi-spherical shape; the curvature of the top element does not differ sufficiently.

The RCD holder indicates the following differences between the RCD and the prior design: the prior design shows a globe like or ball-like shape that stand in contrast to the semi ovoid shape of the contested design. The curvature of the kind of dome in the RCD differs from that depicted in the earlier design D1.

Features of a Community design which are disclaimed are disregarded for the purposes of comparing the designs. This applies to the features of a Community design represented with dotted lines, boundaries or colouring or in any other manner making clear that protection is not sought in respect of such features (judgment of 14/06/2011, T-68/10, 'Watch attached to a lanyard', para. 59-64). In the present case, according to the graphical representation of the design, the protection is sought for the semi-ovoid shown in solid line whereas the container and threading shown in dotted lines are excluded from the protection. This interpretation corresponds to the description of the design provided by the holder in the design application and to its observations made in response to the invalidity application.

The case-law has confirmed that the framework of the comparison of a Community design with an earlier design must be limited to the features making up the Community

design. It is therefore irrelevant whether or not the earlier design discloses additional features. A Community design cannot be new if it is included in a more complex earlier design (decision of 25/10/11, R 978/2010-3 – 'Part of a sanitary napkin', paragraphs 20-21). Therefore, the prior design is taken into account to the extent that it contains the semi-circle.

Taking into account the evidence and arguments of the parties, the Invalidity Division finds that the prior design is not identical to the contested RCD. The semi-ovoid shape of the RCD differs from the ball-like shape of the prior design. The degree of curvature of the dome of the RCD differs from the earlier design. In other words, the details that distinguish the compared designs from each other in view of the semi ovoid design of the RCD and different curvature of the dome cannot be regarded as being 'immaterial'. The ground based on Article 5 CDR must therefore be rejected as unfounded.

c) Individual character pursuant to Article 6 CDR

Under Article 6(1)(b) CDR, a registered Community design must 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 that has been made available to the public before the date of filing of the application for registration of the design for which protection is claimed or, if priority is claimed, the date of priority. Article 6(2) CDR states that, in assessing that individual character, the degree of freedom of the designer in developing the design must be taken into consideration.

Recital 14 CDR provides that when assessing whether a design has individual character with respect to the existing design corpus, it is necessary to take into consideration 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.

It follows from the above that the assessment of the individual character of a Community design with respect to any earlier design disclosed to the public must, in essence, proceed from a four-step review:

- the sector of products in which the compared designs are incorporated or to which they are applied,
- the informed user of the products according to their purpose and, in reference to the informed user:
 - the degree of knowledge of the state of the art, and
 - the degree of attention in the comparison, direct if possible, of the designs,
- the degree of freedom of the designer in the development of the designs, and

The result of the comparison of the designs, taking into account the overall impressions produced on the user by the contested design and any of the earlier design. The assessment should not be simply an analytical comparison of a list of similarities and differences (see judgment of 18/03/2010, T-9/07, 'Metal rappers', paragraphs 54-84, and judgment of 20/10/2011, C-281/10 P, 'Metal rappers',

- Paragraphs 53-59, and judgment of 07/11/2013, T-666/11, 'Gatto domestico', paragraph 21).

The comparison should focus on the contested design as registered and must be based on the elements which are actually protected, without regard to the features

excluded from the protection (judgment of 14/06/2011 T-68/10, 'Watch attached to a lanyard', paragraph 74, and judgment of 07/11/2013, T-666/11, 'Gatto domestico', paragraph 30). However, it is not incorrect to consider, for illustration purposes, when making said comparison, the products actually sold corresponding to the design as registered (judgment of 18/03/2010, T-9/07, 'Metal rappers', paragraph 73).

The designer's degree of freedom in developing a 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 (judgment of 09/09/2011, T-10/08 and T-11/08, 'Internal combustion engine', paragraphs 32 and 47; and judgment of 18/03/2010, T-9/07, 'Metal rappers', paragraph 67).

The General Court has refused to allow a general design trend to be regarded as a factor that restricts the designer's freedom, since it is precisely that freedom on the part of the designer that allows him to discover new shapes and new trends or even to innovate in the context of an existing trend (judgment of 13/11/2012, T-83/11 and T-84/11, 'Radiators for heating', paragraph 95).

When assessing the individual character of a design taking into account the existing design corpus, the degree of freedom of the designer in developing the design may be such as to make informed users more sensitive to differences between the designs under comparison (judgment of 13/11/2012, T-83/11 and T-84/11 'Heating radiators', paragraph 81), as may the manner in which the product at issue is used, in particular the way it is usually handled (judgment of 22/06/2010, T-153/08, 'Communications equipment', paragraph 66, and judgment of 07/11/2013, T-666/11, 'Gatto domestico', paragraph 30).

The informed user is a legal fiction that must be understood, depending on each case, as an intermediate concept between the average consumer, applicable in trade mark matters, of whom no specific knowledge is required and who, in general, does not perform a direct comparison between the marks, and the man of the art, applicable in the field of patents, an expert endowed with extensive technical skills and exhibiting a very high degree of attention when directly comparing conflicting inventions (judgment of 18/03/2010, T-9/07, 'Metal rappers', paragraph 53, and judgment of 25/04/2013, T-80/10, 'Wristwatch housing', paragraph 100). Therefore, a low level of knowledge and a low degree of attention, bringing the informed user closer to the average consumer and further away from the man of the art, reinforce the conclusion that designs that do not present significant differences in the features in which the designer's freedom is unrestricted, produce the same overall impression on the informed user (judgment 09/09/2011, T-11/08, 'Internal combustion engine', paragraph 33). In such cases, the contested design must be declared invalid due to lack of individual character or, as the case may be, because the allegedly infringing design actually infringes the exclusive right of the holder. A high degree of knowledge and a high degree of attention in the informed user reinforces the opposite conclusion (judgment of 07/11/2013, T-666/11, 'Gatto domestico', paragraph 31).

Pursuant to Article 63(1) CDR, in the invalidity proceedings, the Invalidity Division is restricted to examining the facts, evidence and arguments submitted by the parties and the relief sought. The Invalidity Division therefore does not carry out its own research. This, however, does not preclude it from also taking into consideration facts that are well known, that is, that are likely to be known by anyone or can be learned from generally accessible sources.

The facts and arguments in a particular case, in principle, must have been known before the RCD was filed; however, facts relating to the design corpus, density of the market or the designer's freedom should precede the date of disclosure of the prior design.

The sector concerned and the informed user.

The prior design is intended to be applied to a perfume applicator and the contested design to a lip balm dispenser, the informed user is therefore a person who is familiar with cosmetic products applicators and dispensers.

The informed user is aware of characteristic features attributable to the products concerned. An ovoid-like or a semi-circular dome inserted in a container has, in general, been a known form of many other industrial designs products not being lip balm dispensers; however the general shape allows for a wide spectrum of execution and the variations may differ.

Consequently, the designer's freedom within the meaning of Article 6(2) CDR is not, in this connection, limited.

The overall impression

To conclude, although informed users would be able to perceive the differences between the designs in question, this does not change the very similar overall impression produced by the design elements that are included in both designs. The contested design includes only the slight difference described above, which is much less obvious than the overall impression resulting from the general semi-circle/oval shape. The designs are very similar and the differences less perceptible. Taking into account that the contested design claims protection only for a kind of dome inserted in a container, the individual character is not different from that of the prior design. The differences of said dome with that of the prior design D1 do not have a significant effect on the overall impression, as a consequence. In order for the informed users to be able to distinguish between the two designs, they would need to examine them more in detail, which would be beyond the assessment of the overall impression that is required by the CDR. Therefore, the difference between the two designs cannot be deemed to be sufficient for the contested RCD to produce a different overall impression on informed users from that produced by the earlier design.

It almost reproduces features of the prior design that are arbitrary and not subject to any technical necessity obliging a designer to adopt a particular shape and size. As a result, the challenged design lacks individual character in the sense of Article 6(1)(b) CDR and must be invalidated.

As the prior design D1 leads to the success of the application and the invalidity of the contested RCD, there is no need to examine the other prior designs invoked by the applicant.

CONCLUSION

The facts and evidence provided by the applicant support the grounds for invalidity under Article 25(1)(b) in conjunction with Articles 6 CDR; therefore, the application is upheld and the RCD is declared invalid.

COSTS

According to Article 70(1) CDR, the losing party in invalidity proceedings must bear the fees and costs incurred by the other party.

Since the holder is the losing party, it must bear the invalidity fee as well as the costs incurred by the applicant in the course of these proceedings.

According to Article 70(1) CDR and Article 79(7)(f) CDIR, the costs to be paid to the applicant are the costs of representation, which are to be fixed on the basis of the maximum rate set therein, and the costs of the invalidity fee.



The Invalidity Division

Wolfgang Schramek

Alvaro Sesma

Ludmila Čelišová

According to Article 56 CDR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 57 CDR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to have been filed only when the appeal fee of EUR 800 has been paid.

The amount determined in the fixing of costs may only be reviewed on request. According to Article 79(4) CDIR, such a request must be filed within one month from the date of notification of this fixing of costs and will be deemed to have been filed only when the review fee of EUR 100 has been paid (Annex to CDFR, paragraph 24).