

DECISION
of the Third Board of Appeal
of 1 July 2021

In case R 1005/2018-3

Tinnus Enterprises, LLC

3429 18th Street

Plano Texas

United States of America

Design Holder / Appellant

represented by Dentons Europe LLP, Gustav Mahlerplein 2, 1082 MA Amsterdam,
The Netherlands

v

Mystic Products Import & Export, SL

Carrer Guifre N° 689

08918 Badalona

Spain

Invalidity Applicant / Defendant

represented by Isern Patentes y Marcas, S.L., Avenida Diagonal, 463 bis, 2° piso,
08036 Barcelona, Spain

Koopman International B.V.

Distelweg 88

1031 HH Amsterdam

The Netherlands

Invalidity Applicant / Defendant

represented by Merkenbureau Knijff & Partners B.V., Leeuwendeldseweg 12,
1382LX Weesp, The Netherlands

APPEAL relating to Invalidity Proceedings No ICD 10 298 (registered Community
design No 1 431 829-0006)

THE THIRD BOARD OF APPEAL

composed of G. Humphreys (Chairperson), H. Salmi (Rapporteur) and
E. Fink (Member)

Registrar: H. Dijkema

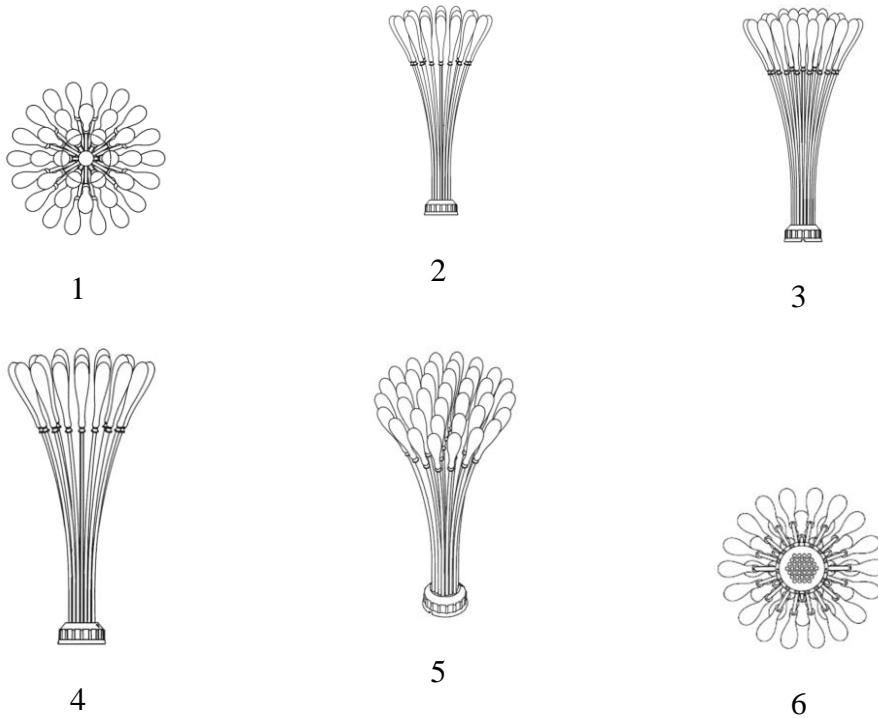
gives the following

Language of the case: English

Decision

Summary of the facts

- 1 Tinnus Enterprises, LLC ('the design holder') is the holder of registered Community design No 1 431 829-0006 ('the contested RCD'), with a filing date of 10 March 2015. The design is represented in the following views:



- 2 The indication of the products reads 'Fluid distribution equipment'.
- 3 On 13 June 2016 and 19 April 2017, respectively, Mystic Products Import & Export, SL ('the invalidity applicant I') and Koopman International B.V. ('the invalidity applicant II') filed separate applications for a declaration of invalidity of the contested RCD based on Article 25(1)(b) CDR in conjunction with, inter alia, Article 8(1) CDR.
- 4 The invalidity applicant I claimed in essence that all the features of appearance of the contested RCD, namely a housing with an opening and a plurality of holes, a number of hollow tubes attached to the housing, a number of inflatable balloons connected to the ends of the tubes and a number of fasteners fixing the balloons to the tubes had been chosen only with technical considerations in mind. Hence, the contested RCD was excluded from protection by virtue of Article 8(1) CDR. All those features were necessary for the technical solution to the question of how to fill a number of inflatable balloons simultaneously. In particular, the technical function of the housing is to convey the fluid from its source to the tubes. Therefore, the outer ring of the housing must fit into the hose or fluid source and the form chosen is necessary for this purpose pursuant to Article 8(2) CDR. The technical function of the tubes is to convey the fluid from the housing to each balloon. Finally, the balloons and the fasteners are standard features incorporated

into the design so that the product can perform its technical function and no creative effort was put into that feature. An indication of the technical character of the design was that anyone, with the aid only of a verbal description of the product, could draw a depiction of the product that would contain all the elements of and be substantially identical to the contested RCD, because no creative endeavour had gone into the design. The contested RCD would prevent others from using that purely technical solution, which was contrary to the purpose of design law. The invalidity applicant I further claimed that the contested RCD lacked individual character in relation to the prior Community design No 2 314 005-0003 published on 23 September 2013 ('prior design'). Both designs show a similar housing with a plurality of identical sticks and balloons. The designs only differed in the dimension of the housing and the number of balloons which were immaterial details unable to influence the same overall impressions.

5 The documents submitted in support of the invalidity application included the following:

- A printout from the website www.arstechnica.com, showing an article entitled 'Bunch O Balloons will revolutionise water fights' and subtitled 'The product fills multiple balloons with water simultaneously', published on 27 July 2014 with the following image:



- European patent application EP 3 005 948 A2, filed in the name of the design holder on 10 March 2015, and published on 13 April 2016. The application contains, inter alia, the following depictions of the technical solution ('the patent application'):

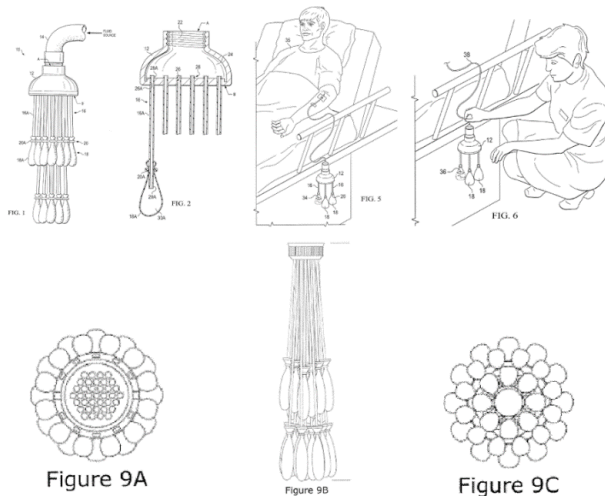


Figure 9A

Figure 9B

Figure 9C

- 6 In its response of 30 September 2016, the design holder argued essentially that the features of the contested RCD, namely the housing, the straws, the balloons and the rings are not solely dictated by technical function. The approach followed by the invalidity applicant I is misleading given that statements of invention in a patent application are intended to reflect the language of a patent claim, which are themselves intended to be a generalised version of a feature. Likewise, the verbal description proposed by the invalidity applicant I is erroneous given that this can be a subjective test depending on the amount of detail provided therein. The invalidity applicant I's allegation that the design registration is an attempt by the design holder to monopolise a technical solution – that is, that the contested RCD would prevent others from using the purely technical solution presented by that design – assumes that the product can take only one form. However, in the present case, multiple forms of the product related to the contested RCD can be envisaged. The contested RCD in question was filed in a multiple application with nine other designs, at least eight of which show forms of the product different from that shown in the contested RCD. The correct approach is to carefully consider each feature of the design independently and to consider whether the appearance of that feature has been decided based on aesthetic reasons instead of or as well as on its technical function. The product has a long, thin and simple appearance which is important due to the intended use of the product by children in a water balloon fight. First, the housing and specific arrangement thereof is one of the many configurations that achieve a close tessellation of the holes and also an aesthetically pleasing arrangement (well thought-out and tidy). Second, the length and dense arrangement of the straws contribute to the overall long, thin appearance of the product as a whole. As regards, thirdly, the balloons, their uniform shape and size makes them appear organised and tidy. Finally, the rings with the single thick band were chosen over the alternatives because this looks more tidy and simple. It follows that none of the essential features of the contested RCD has its appearance dictated solely by technical function. As regards the allegation that the shape of the housing had been chosen to fit into a hose or fluid source, in the absence of screw thread or ridges to engage a hose or fluid source, it is not possible to ascertain how this could fit therein. Contrary to the invalidity applicant I's allegation, there is no outer ring at the opening of the housing. Therefore, this feature does not contravene Article 8(2) CDR. The design holder further argued that the contested RCD possesses individual character. The designs under comparison produce different overall impressions on account of, inter alia, the differences in the shape of the tops, the number of straws and balloons and arrangement thereof. The similarities in the shape and size of the balloons and straws are not sufficient to outweigh the said differences.
- 7 In its response on 7 March 2017, the invalidity applicant I argued, inter alia, that the views No 1 and No 6 of the contested RCD are not suitable to ascertain the product. It further reiterated in essence that the patent application shows the same views contained in the contested RCD. Each feature of the latter performs a technical function, allowing all of them together to fill water in the balloons simultaneously. Even though the same result could be achieved if some of the elements were excluded or modified, the visual aspect of any such device would still be the result of its technical function. The circular shape of the housing was selected because the majority of hoses and taps to which the housing would be

applied to are circular, and therefore this feature was solely dictated by the product's technical function. There are no aesthetic considerations involved in choosing the shape of the hollow tubes or in attaching them to the housing. These are necessary to convey the fluid from the housing to the balloons. No aesthetic considerations were involved in choosing the shape of balloons. The elastic bands are barely visible, and therefore no aesthetic considerations lay behind their choice. The invalidity applicant I further argues that the contested RCD is to be declared invalid on the grounds of Article 8(2) CDR. The housing comprises an opening at one end which has been specifically chosen in order to fit in a hose or round faucet in order to make the product serviceable. Finally, the contested RCD lacks individual character in relation to the prior design invoked.

- 8 The design holder replied, inter alia, that the views are correctly drawn up and are suitable to ascertain the product. It further reiterated that the correct approach to considering the derogation under Article 8(1) CDR was to conduct an objective assessment of whether aesthetic considerations, regardless of the aesthetic quality of the result, could have been taken into account by the designer of the contested RCD. The product was intended for children and the market for children's toys was highly competitive and therefore products in that market needed to have an appealing appearance. The approach focusing on a patent application is incorrect given that the latter concerns the technical aspects of the invention, rather than its appearance. The design holder further reiterates that the appearance of the housing cannot be restricted to its exact form and dimensions in order to permit the product in which the housing is incorporated to be mechanically connected to, in, around or against another product so that either may perform its function and thus Article 8(2) CDR is not applicable. It finally restated that there are several differences between the contested RCD and the prior design invoked (e.g. size and number of balloons) that would be identified by an informed user irrespective of the design freedom, and endow individual character to the former.
- 9 The invalidity applicant II, within its statement of grounds accompanying the application for a declaration of invalidity filed on 19 April 2017, argued in essence that all, or at least several important, features of the contested RCD were solely dictated by the technical function of the product concerned and therefore the contested RCD should be declared invalid under Article 8(1) CDR. The technical function of the features of appearance could be derived from the filed European patent application EP 3 005 948 A2. The only consideration that could possibly have gone through the mind of the designer of the product was the need to create a product that would perform a technical function, namely to fill as many water balloons as possible simultaneously. All features have been chosen with a view to fulfil the technical performance of the product in question. In particular, the housing is annular shaped because it is designed to be screwed onto a water tap and it is provided with a plurality of holes in order to attach a tube to each of the holes. The tubes have an elongated shape and are flexible to allow the balloons to occupy more space as they are filled with water. The elastic bands connect the tubes to the balloons and also close the balloons when they are filled with water and become detached from the tubes while the balloons are standard-shaped water balloons. Therefore, aesthetic considerations were completely irrelevant in the development of the product. The design holder further argued that the outside of the annular housing is marked with small ridges for a better grip, the outer tubes are more flexible than the inner tubes to allow for

more balloons to be attached while the different lengths of the tubes allow more balloons to be filled by providing more space. The invalidity applicant II further declared that it had been accused of infringing the contested RCD before the District Court of The Hague and submitted the writ of summons and its translation in English. It further requested to join the invalidity proceedings initiated by invalidity applicant I pursuant to Article 54 CDR.

- 10 On 30 August 2017, both invalidity applicants were informed that the application for a declaration of invalidity No ICD 10 692 filed by invalidity applicant II was admissible and the invalidity applicant II met all the requirements stipulated in Article 54 CDR to be joined as a party in the earlier invalidity proceedings. Hence, the Office dealt with both applications in one set of proceedings under file No ICD 10 298.
- 11 In response to the invalidity applicant II's arguments, the design holder reiterated in essence that using the wording of the patent application was not a correct approach. The description in the patent focuses on the technical interaction of the features of the invention and so is intended to address the function of the product, but not its appearance. If the invalidity applicant II's approach were adopted, all registered designs of products subject to parallel patent claims would wrongly be invalidated. It continued claiming, *inter alia*, that all the features of the design should be considered independently. In relation to the straws, it explained that the contested RCD included only static images and thus the alleged flexibility of the straws could not be determined or considered a feature of the design. Likewise, the balloons are all in an uninflated state and therefore their shape cannot be determined or considered a feature of the design either. The design holder continued with the assessment of the appearance of the features and concluded that aesthetic considerations were relevant. The features of appearance and combination thereof created a long, thin, simple appearance making the product aesthetically pleasing.
- 12 In their additional submissions, the parties provided judgments from national proceedings.
- 13 By decision of 30 April 2018 ('the contested decision'), the Invalidity Division declared the contested RCD invalid on the basis of Article 25(1)(b) CDR in conjunction with Article 8(1) CDR, and ordered the design holder to bear the costs. The Invalidity Division gave, in particular, the following grounds for its decision:
 - Although the present invalidity proceedings concern solely the validity of the Community design No 1 431 829-0006, bearing in mind all circumstances and the arguments of the parties, it is not irrelevant to show the whole multiple registration that the design holder applied for, to better understand the designs of the fluid distribution equipment, for which the protection is sought. At least four designs of the design holder's multiple registration show possible alternatives to achieve a single technical solution (not leaving many other alternatives free). The straw and balloon configurations which appear in them are different ways of enabling a large number of balloons to be filled with water at once. By obtaining registration for these forms, the

design holder does not leave its competitors many options to achieve the same effect.

- The existence of alternative forms as a sole factor should not result in the automatic rejection of the application of the provisions of Article 8(1) CDR but other objective circumstances relevant to the case should be taken into consideration. Such a relevant circumstance might be the fact that all the alternative forms presented in the present case enjoy protection by virtue of registration as Community designs, like the contested RCD, and therefore should be disregarded as alternatives left free for competitors.
- The contested RCD relates to fluid distribution equipment, as specified in the product indication. Its intended purpose is to entertain children by facilitating a water balloon fight. As regards the nature of the product, it is intended as a single-use, disposable product. It is not durable and therefore it has limited aesthetic value. The product is purchased with the aim of using it to distribute water via the housing and the straws to the balloons. The balloons themselves will be disposed of once thrown in the water fight. It seems logical that, with regard to a product that is intended to be used once and then disposed of, the users' main interest would be not aesthetic – as it might be if they were investing in something durable – but rather utilitarian. Even though, one could imagine that some aesthetic aspects such as different balloon colours, the decoration of the balloons, or the use of decorative bands could add to the aesthetic value to the product, these are outside the scope of this assessment, as the contested RCD seeks protection solely for the product's form or shape.
- As regards the patent documentation submitted by the invalidity applicants, although European patent and the registered Community design, target different aspects of the product, this does not mean that the specifications in the patent application and the examples of the embodiments of the solution cannot be taken into account when the technical nature of a product related to a contested RCD is assessed. According to the patent application, the openings or holes are configured in an array allowing the tubes to be arranged in concentric circles. This description suggests the neat arrangement with the advantage that it allows a greater number of straws (tubes) to be attached. The form of the housing is that of a simple, common hose connector or threaded tap connector. The size of the housing, which in reality corresponds to the size of a common tap or hose, will not allow the user to 'appreciate' the arrangement of the holes as it will be rather negligible due to its size. It should be noted that, for the end user, the arrangement of the straws and balloons will be perceived merely as a bunch of straws and balloons with no particular pattern, as is apparent from RCD No 1 431 829-0007 in the same multiple registration, showing the actual product. Therefore, the effort of the designer in arranging the holes for the straws was driven more by the need to place a certain number of holes in the housing rather than by aesthetic considerations, which do not have a substantial impact on the overall appearance of the product.
- The Invalidity Division does not see any enhancement of the appearance of the product protected by virtue of the Community design compared with the

austere embodiment presented in the patent application (where any aesthetic references that could be an obstacle to the patentability of the invention are omitted). The embodiment in the patent document is almost identical to the design registration.

- The Invalidity Division concluded that all of the contested RCD’s essential features have been chosen with the aim of designing a product that performs a function. None of those features has been chosen for the purpose of enhancing the product’s appearance. The contested RCD is declared invalid pursuant to Article 25(1)(b) CDR in conjunction with Article 8(1) CDR in so far as it is solely dictated by technical function. Since the application for a declaration of invalidity is fully successful on this ground, there is no need to examine the other grounds invoked.
- 14 On 31 May 2018, the design holder filed an appeal against the contested decision, requesting that the decision be set aside. The statement of grounds of the appeal was received on 5 September 2018.
 - 15 In their observations in reply received on 6 and 7 November 2018, the invalidity applicants requested that the appeal be dismissed.
 - 16 After an extension of the time-limit, the design holder responded to the reply of the invalidity applicants with observations on 14 February 2019.
 - 17 The invalidity applicants filed rejoinders on 25 March 2019 and 17 April 2019, respectively.
 - 18 On 14 May 2019, expedited proceedings were requested by the invalidity applicant II.
 - 19 On 12 June 2019, in a parallel procedure, the Third Board of Appeal rendered a decision in case R 1002/2018-3 ‘Fluid distribution equipment’ regarding registered Community design No 1 431 829-0001. The same parties as in the case at hand were involved.
 - 20 On 13 August 2019, invalidity applicant II sent a letter to the Board requesting that the Board also decide on the case at hand.
 - 21 On 16 August 2019, the design holder brought an action before the General Court (case T-574/19) against the Board of Appeal’s decision in case R 1002/2018-3.
 - 22 On 18 September 2019, the Board of Appeal rendered an interim decision (R 1005/2018-3) suspending the appeal proceedings until a final judgment is given in case T-574/19.
 - 23 On 10 December 2019, the invalidity applicant II brought an action before the General Court (case T-838/19) requesting the annulment of the interim decision (R 1005/2018-3) and the resumption of the proceedings.
 - 24 On 15 July 2020, the General Court issued an order by which it dismissed the action as inadmissible and ordered the invalidity applicant II to pay its own costs and the costs incurred by the EUIPO and the intervener. The Court held that the

interim decision constitutes an intermediate measure the aim of which is to prepare for the final decision to be adopted by the Board of Appeal and does not produce binding legal effects capable of affecting the interests of the invalidity applicant II (15/07/2020, T-838/19, Fluid distribution equipment, EU:T:2020:343).

The proceedings and findings of the General Court in Case T-574/19

25 By judgment of 18 November 2020, the General Court dismissed the action and ordered the design holder to bear its own costs and pay the costs incurred by the EUIPO and the intervener (18/11/2020, T-574/19, Fluid distribution equipment, EU:T:2020:543). The General Court held, inter alia, the following:

- The steps of analysis required by Article 8(1) CDR are the following: first, to determine the technical function of the product concerned, secondly, to analyse the features of appearance of that product within the meaning of Article 8(1) CDR and, thirdly, to examine, in the light of all the relevant objective circumstances, whether those features are solely dictated by the technical function of the product concerned. If all the features of appearance of the product concerned are solely dictated by its technical function, the design at issue will not be valid, unless it is apparent that the arrangement of those features was dictated by considerations not concerned solely with the need to fulfil the technical function of the product concerned, creating, in particular, an overall visual impression going beyond mere technical function (§ 19-38 of the judgment).
- The identification of the features of appearance of a product must be carried out on a case-by-case basis depending on the product concerned. Following the identification of the features of appearance, the question of whether those are ‘solely dictated by the technical function of the product’ requires examination of the technical function of each of those features and examination of the causal link between the technical function of each of those features and the technical function of the product concerned (§ 39-58 of the judgment).
- The Board of Appeal took into account the ‘relevant objective circumstances’, in accordance with DOCERAM, including the contested design, the nature and use of the product concerned, objective data indicating the reasons that dictated the choice of the features of appearance (function of those features and the applicant’s other Community designs) as well as the use of the patent documentation provided (§ 81).
- The witness statement by the designer of the contested design had limited evidential value in so far as this presents the personal and subjective opinion of that designer and in so far as that designer has a personal interest in the validity of the contested design. The existence of alternative designs, even attested by the designer, is not decisive as regards the question of whether the technical function of the product concerned is the only factor which determined the features of its appearance. Finally, the commercial success of the product and any awards received cannot establish that considerations

related to the visual aspect had played a role in the design process of the contested design (§ 100-102 of the judgment).

The proceedings and findings of the Court of Justice of the EU in Case C-29/21 P

- 26 On 18 January 2021, the design holder filed an appeal before the Court of Justice of the European Union requesting the judgment of 18 November 2020 in case T-574/19 to be set aside. The case was assigned the number C-29/21 P.
- 27 On 5 May 2021, the Court of Justice of the European Union issued an order by which it did not allow the appeal to proceed. The design holder was ordered to bear its own costs. The Court held that the request that the appeal be allowed to proceed submitted by the design holder was not capable of establishing that the appeal raises an issue that is significant with respect to the unity, consistency or development of EU law.

Submissions and arguments of the parties at the appeal stage

- 28 The arguments raised in the design holder's statement of grounds may be summarised as follows:
- The Invalidity Division should have examined whether the facts, arguments and evidence filed by the invalidity applicants established a ground of invalidity, rather assuming that the burden of proof fell on the design holder to prove the validity of the contested RCD. For this reason alone, the contested decision should be annulled.

Article 25(1)(b) in conjunction with Article 8(1) CDR

- The Invalidity Division misapplied the test by which exclusion under Article 8(1) CDR is assessed. It seems to have been influenced by the patent application and incorrectly broke down the contested RCD into component parts and proceeded to assess the technical function of each of those, rather the technical function of the contested RCD as a whole. If the contested RCD had been considered in its entirety, the Invalidity Division would have found that aesthetic considerations had played a role. Given that the product was a consumable, there was a deliberate attempt to make the shape and appearance of the product appealing to a consumer to encourage consumers to purchase the product. In terms of specific aesthetic choices that were made when developing the design, the choice was made to keep the balloons grouped together giving the contested RCD a simple and clean appearance. This also gives the contested RCD the appearance of an arranged bouquet of flowers. Aesthetic considerations were taken into consideration when the housing was being designed, as can be seen from the chamfered edges of the top and bottom sections of the housing. Additionally, the proportions of the design as a whole, namely the length being about two times the width give the design a sleek and elegant appearance that is appealing to the user. This is again an aesthetic consideration, not a technical function, of the design as a whole. As further consideration, these choices were made by the designer

even when other more functional options were available such as having the straws attached in a spoke-like arrangement around a central hub.

- The Invalidity Division applied a different test to that set out in *DOCERAM*, in that it required the design to have an enhanced appearance or added value to justify protection. Whether or not the appearance of a feature departs ‘from a norm’, or enhances the appearance of a product is not the correct test for assessing whether the exclusion under Article 8(1) CDR applies.
- The Invalidity Division incorrectly took into account the design holder’s other RCDs. *DOCERAM* makes clear that the multiplicity of forms approach is not the correct way for assessing Article 8(1) CDR. Accordingly, the existence of other RCDs was not a proper factor to be taken into account. Instead, the correct test is to determine whether the appearance of each individual design is solely dictated by technical function. This approach is to be applied to each design individually, since each design is a separate right regardless of whether it was filed as part of a multiple application. There are a significant number of alternative variations beyond those embodied in the design holder’s RCDs which would fulfil the same technical function as the contested RCD and remain available to other parties. Therefore, contrary to the contested decision’s findings, the design holder had not monopolised all the available forms of the product. Most importantly, the approach adopted by the Invalidity Division offends against the principle of equal treatment as the design holder is being treated differently for owning ten designs to how ten separate parties, each holding one design, would be treated. Assuming the said RCDs had each been held by a different proprietor, this consideration in relation to multiple RCDs for products with similar appearances would not have been taken into account and thus the design holder is put in a worse position compared to third parties.
- The Invalidity Division incorrectly took into account arguments not presented by the parties by considering that because the product in which the design would be embodied would be ‘single use’, it must have limited aesthetic value and that users’ interests would be in its function rather than its aesthetics. This is also incorrect. The product in which the contested RCD would be embodied is a children’s toy and therefore it is a consumer product. Whether or not consumer products are disposable or durable, they are designed to be appealing to consumers. There are numerous examples of single use and/or disposable items which have clearly been designed with their aesthetic appearance in mind, such as the shapes of soft drinks bottles, the shape of various foodstuffs, dishwasher and washing machine tablets, postage stamps and fireworks. In support, the design holder submitted images of such products.
- In support of its claims, the design holder submitted a witness statement from the designer of the contested RCD who explains, among others, the aesthetic considerations behind the development of the contested RCD. For instance, there was a deliberate choice to make the contested RCD longer relative to its width, giving it an elegant appearance. This witness statement should be accepted by the Board of Appeal because it is relevant to the outcome of the case, it addresses the criticism made in the contested decision that the design

holder did not submit any supporting evidence about the designer's involvement in the design process and meets the criteria set by Article 27(4)(b) EUTMDR.

Article 25(1)(b) in conjunction with Article 8(2) CDR

- Neither the housing nor any part of the housing of the contested RCD contravenes Article 8(2) CRD. With regard to the invalidity applicant I's allegation that the shape of the outer ring of the 'housing' had been chosen specifically so that it fits into a hose or fluid source, this is not correct. The housing is a squat cylinder with some other features, which do not relate to any need to fit to a hose or fluid source. There are no features (e.g. a screw thread or ridges) to engage a hose or fluid source and no indication of which parts of the housing fits to a hose or fluid source. As such, it is not possible to ascertain exactly how the housing fits with such a hose or fluid source. This means that, because no mechanical connections are visible and the shape of the housing depicted in the contested RCD is not tailored for connection to a specific part, the shape of the housing, or any part of the housing shown in the contested RCD simply cannot have been chosen 'in order to permit' it 'to be mechanically connected to or place in, around or against another product'.

Article 25(1)(b) in conjunction with Article 6 CDR

- Contrary to the invalidity applicant I's allegations, the contested RCD possesses individual character in relation to the prior design. The latter, other than its base, is depicted in dotted lines which cannot be taken into consideration. Even if the prior design is considered in its entirety, the conflicting designs produce key differences such as the shape of their housings, the number of straws and balloons and the long, thin appearance of the contested RCD compared to the short, bulbous look of the prior design.

- 29 In reply to the appeal, the invalidity applicant I argued in essence that the Invalidity Division has been acting neutrally from the start of the invalidity proceeding up to the contested decision being granted. The contested decision analyses all relevant circumstances regarding not only the contested RCD, but also all multiple alternative registrations that the design holder applied. The fact that the contested RCD has won awards does not mean that it fulfils the necessary requisites to be granted design protection. The features of the appearance of the contested RCD are solely dictated by the technical function of the product within the meaning of Article 8(1) CDR. An examination based on the paragraphs 0004-0091 of the patent application shows that any single element that is part of the contested RCD's visual appearance performs a technical solution, allowing all of them together to fill water balloon's faster rather than filling them one by one. Even though the same result can be achieved by excluding or modifying the distribution over the device of some of the common elements mentioned, the visual aspect of any device would still be the result of its technical function. The reasonable observer does not care whether the product s/he is evaluating looks good, bad or ugly; all that matters is that the device will allow her/him to fill water balloons faster. Producing this fast water filling facility of numerous water balloons at the same time is, undoubtedly a technical function.

It further argued that the contested RCD is to be declared invalid on the grounds of Article 8(2) CDR. One of the ends of the housing must fit in a hose or round faucet in order to make the product serviceable. This can be seen in, inter alia, Fig. 1 of the patent application. The prior design destroys the individual character of the contested RCD. In this regard, reference is made to the argumentation submitted before the Invalidity Division.

- 30 In its response, the invalidity applicant II argued essentially that all features of appearance are solely dictated by the technical function of the fluid distribution equipment. This can be derived by, inter alia, the article submitted by the invalidity applicant I and from the description of the product in the patent application. The design holder's witness statement submitted on appeal is inadmissible. No valid reasons for its belated submission had been put forward, it has low probative value (if any), and is not likely to be relevant for the outcome of the case. The design holder's arguments are incorrect. The Invalidity Division correctly applied the test of Article 8(1) CDR to each of the features of the design separately but taking into account the technical function of the product as a whole. By referring to enhanced appearance, the Invalidity Division did not mean 'aesthetic quality', but 'an increase or improvement in quality, value, or extent', which encompasses much more than a (visual) enhancement giving a design an 'aesthetic quality'. In this context, it should also be taken into account that, whether or not a feature of a design has an 'aesthetic quality' is subjective and therefore not a suitable criterion to determine whether a feature of a product is solely determined by the technical function of the product. Further, taking into account the design holder's other RCD's was acceptable given that, for the purpose of determining whether Article 8(1) applies, all of the relevant objective circumstances of the case apply. Finally, the argument that the contested RCD is applied to a 'single use' product which as a consequence has limited aesthetic value follows from the arguments provided by the parties and evidence attached thereto and is a relevant circumstance for the present assessment. In support, the invalidity applicant II provided, inter alia, a letter sent to UKIPO regarding amendments in the design holder's UK Patent application No 1504038.9.
- 31 In its response, the design holder states, inter alia, that the witness statement should be accorded the same weight as it would be accorded if it derived from a person without an interest in the validity of the contested RCD. It further reiterated in essence that the approach for assessing Article 8(1) CDR set out in DOCERAM was incorrectly applied in the contested decision. The latter was formed based on incomplete facts and evidence that the design holder was not given the opportunity to remedy. Following DOCERAM, the assessment of an RCD in relation to Article 8(1) CDR is a multifactorial assessment. Some of the factors to be considered were the designer's involvement in the design process and the existence of design alternatives which fulfil the same technical function as the design at issue, while considerations related to a reasonable observer or aesthetic quality are not correct for the assessment of Article 8(1) CDR. The Invalidity Division wrongly shifted the burden of proof to the design holder and failed to consider how the features of the contested RCD interrelate and thereby how the latter as a whole appears. The features of the contested RCD interact with one another in order to give technical function to the overall design, and therefore an individual feature cannot be considered in isolation from the others. Given that the contested RCD concerns a toy, aesthetics play an important role.

The relative size and proportions of the various features are aesthetic choices in order to produce a simple, sleek and elegant overall impression. Aesthetic considerations were taken into account as part of developing the contested RCD. Reliance on the patent application causes technical aspects to be given more weight than necessary. In addition, by considering arguments not raised by the parties (i.e. RCD being a single use product), the Invalidity Division breached Article 63(1) CDR. Finally, the contested RCD does not contravene Article 6 CDR or Article 8(2) CDR.

- 32 In their rejoinders, the invalidity applicants reiterated essentially their previous arguments. The invalidity applicant I restated in essence that all features of appearance of the contested RCD and their specific collocation allow the device to perform its technical function and this is well analysed in the patent application. It further provided, inter alia, screenshots from YouTube videos showing the product as marketed. The invalidity applicant II restated, inter alia, that the witness evidence, if admitted, has no probative value and is inconclusive for the outcome and reiterated essentially its previous argumentations in an effort to rebut the design holder's argumentation. In support, it provided an annotation of the DOCERAM judgment by professor G. with its translation into English.

Reasons

- 33 The appeal complies with Articles 56 and 57 CDR and Article 34 CDIR. It is, therefore, admissible.
- 34 The appeal is not well founded. The contested decision correctly declared the contested RCD invalid under Article 8(1) CDR.

Article 25(1)(b) in conjunction with Article 8(1) CDR

- 35 According to 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'.
- 36 To determine whether the features of appearance of a product are covered by Article 8(1) CDR, all the objective circumstances relevant to each individual case must be taken into consideration. Such assessment must be made by having regard to the design at issue, the objective circumstances indicative of the reasons which dictated the choice of features of appearance of the product concerned, or information on its use or the existence of alternative designs which fulfil the same technical function, provided that those circumstances, data, or information as to the existence of alternative designs are supported by reliable evidence (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 36-38).
- 37 Article 8(1) CDR therefore requires an assessment as to whether, in view of the function of the product to which the design is to be applied, all its features of appearance are the result of technical considerations only, i.e. of considerations exclusively guided by the designer's intention to create a product that fulfils its technical function. In accordance with Article 63(1) CDR, the Board is bound in that assessment by the evidence submitted by the parties (08/03/2018, C-395/16,

DOCERAM, EU:C:2018:172, § 37; 19/10/2017, opinion of the Advocate General, EU:C:2017:779, § 66).

- 38 As a preliminary remark, the Board, firstly, notes that the evidence submitted for the first time at the appeal stage, namely the witness statement of the designer of the contested RCD and images of single use products, will be admitted since it supplements the evidence already provided during the invalidity proceedings and seems, *prima facie*, likely to be relevant to the outcome of the invalidity case that has been filed, in accordance with Article 108 CDR in conjunction with Article 27(4) EUTMDR. The Board stresses, however, that the *prima facie* relevance of the evidence does not imply that it is conclusive for the outcome of the present case. On a second procedural matter the Board notes that the design holder claims that when the Invalidity Division was assessing whether any of the grounds of invalidity had been established, it was assuming that the burden of proof fell on the design holder to prove that the contested RCD was valid when it should have been assessing whether the facts, arguments and evidence filed by the invalidity applicants established a ground of invalidity. The Board does not agree with this claim. The application for a declaration of invalidity and the invalidity applicants' submissions include an indication of the grounds on which the application is based and valid and convincing arguments as to why the contested RCD should be held invalid. This being the situation, it is then for the design holder to give convincing counterarguments to these claims. The final conclusion then depends on an evaluation of all the facts, arguments and evidence provided by all parties as required by Article 63(1) CDR, which is what the Invalidity Division has done.
- 39 The product at issue is a fluid distribution equipment which is intended to facilitate water balloon fights, as inferred from the submissions of the parties and the documents attached thereto. More specifically, this fluid distribution unit consists of a housing that can be attached to a water distribution facility. The water is then distributed via multiple straws (tubes) attached to the housing via holes and the final destination of the water is into the inflatable balloons attached to the far ends of the straws with an elastic band. It is further understood from the evidence that once sufficient water is in the balloons, the weight of the water allows the balloons to be detached from the straws and the elastic band closes the opening of the balloons so that the water is kept inside the balloons, which can be subsequently used in a water balloon fight.
- 40 The function of such a product is to fill a number of inflatable balloons at the same time, as described by the parties and the evidence provided.
- 41 It is also common ground between the parties that the contested RCD reveals the following features of appearance:
- a) A housing with an opening and a number of holes;
 - b) A number of hollow tubes attached to the housing;
 - c) A number of inflatable balloons connected to the ends of the tubes;
 - d) A number of fasteners fixing the balloons to the tubes.

- 42 These features correspond to the component parts of the product in question, as explained by the design holder (see, for instance, observations of 30 September 2016, para. 36). In the Board's assessment, all these features and arrangement thereof are solely dictated by the technical function of the product concerned, as will be explained hereunder.
- 43 The patent application provides precise information about all features of the contested RCD and its functional characteristics. Notably, figures 9A to 9C of the patent application correspond visually to some of the views of the contested RCD. Feature (a) namely the housing with an opening and a number of holes is attached to a water distribution facility (e.g. water tap or garden hose) in order to supply a fluid from the fluid source and flow it into the tubes (patent application [0104], [0109], [0112]). The housing can be of cylindrical shape with the first end having an outermost perimeter that is smaller in length than the outermost perimeter of the second end in order to attach a hose, while the second end is attached to the plurality of hollow tubes (patent application [0096], [0121]). Feature (b), namely the hollow tubes are attached to the housing via holes in arrays of concentric circles and enable the fluid to flow through (patent application [0073], [0074], [0103], [0104]). The final destination of the water is in the inflatable balloons attached to the far ends of the tubes (feature (c)). These are filled with and hold fluids (patent application [0093], [0099]). Finally, feature (d), namely the elastic fastener or band affixed to the necks of balloons, clamp the balloon to the tube sealing the fluid therein (patent application [0099], [0100], [0111], [0112]).
- 44 The technical function of the features of appearance of the product concerned are further described in the design holder's article 'Bunch O Balloons will revolutionise water fights' concerning a design comprising also a housing, tubes, balloons and fasteners. According to the article, the product is 'a hose attachment with 37 pre-connected balloons that automatically tie themselves once filled with water (...) The way it works is that the uninflated balloons have been pulled over 37 straws. Around the neck of each balloon, there is a tiny, tight rubber band securing the balloon onto the straw. The straws feed into a single head that can be attached to a hose for filling. This allows for all of the balloons to simultaneously fill with water.'
- 45 It follows that all the features of the contested RCD are solely dictated by a technical function and are necessary for the technical solution of the product on how to fill with water a number of balloons at the same time. The specific arrangement of these features is equally dictated by considerations related exclusively with the need to fulfil the technical function of the product concerned. This becomes more evident when considering that the configuration of all features of the fluid distribution equipment are meant to be in contact with a fluid, so that the shape, number and position of the features has an impact on the fluid flow and the inflation of the balloons/containers (patent application [0032]). Considering the evidence in its entirety there can be no doubt that all the features of the contested RCD and their configuration have been exclusively designed to perform a technical function and that the only concerns of the designer were of technical nature with no regard to the visual aspect.

- 46 As rightly pointed out by the design holder, the assessment under Article 8(1) CDR must be made with regard to, inter alia, the design at issue and objective circumstances indicative of the reasons which dictated the choice of features of appearance (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 37). Given that it was proven that all features of appearance of the product concerned were solely dictated by its technical function, it would have been for the design holder to demonstrate the aesthetic considerations that influenced the choice of features beyond this technical function.
- 47 The design holder was unable to rebut the technical function, as described above, of the housing, the tubes, the balloons and the fasteners and to demonstrate any other considerations that could have played a role in the appearance of said features. Mere statements such as the design has a ‘simple and clean appearance’ similar to a ‘bouquet of flowers’ due to the choice to keep the balloons grouped together and that the ‘proportions [of the length and width] of the design as a whole (...) give the design a sleek and elegant appearance that is appealing to the user’ (statement of grounds of appeal, p. 7) cannot demonstrate that aesthetic considerations played a role in the development of the design. Likewise, the design holder’s argument (and corresponding evidence) that the product is a consumable (toy) and thus there is a deliberate attempt to make the shape and appearance of the product appealing to a consumer are insufficient to demonstrate that aesthetic considerations influenced the choice of features beyond the technical functions. It is irrelevant that the product at issue was developed to be a consumer product (toy) or whether it is a ‘single use product’ or not. Finally, as regards the design holder’s allegation that there are various shapes and arrangements for the designer to choose, it is noted that the mere fact that a design alternative exists does not mean that a product’s appearance has been dictated by anything other than technical considerations (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 32). It is true that, in principle, design alternatives do exist as concern the size, shape and position of these features. Nevertheless, these alternative designs can equally be solely dictated by technical function, for instance the different length of the tubes is intended to prevent crowding and to accommodate a larger number of balloons (patent application [0108]). Notwithstanding, in the case at hand, it must also be taken into account that the features and the way that they are designed resulted exclusively from the technical function of the product concerned. The main concerns during their development were technical, not visual.
- 48 The witness statement of the designer, submitted by the design holder, has limited evidential value since it is neither objective nor supported by corroborative objective evidence (18/11/2020, T-574/19, Fluid distribution equipment, EU:T:2020:543, § 100). It does not contain any information on the features of the contested RCD and under which aesthetic considerations these were chosen. The designer mainly referred to the possibility of alternative designs and alleged a ‘simple, clean and elegant appearance’ of the design without any further elaboration on the contested RCD’s visual aspects. Mere statements such as ‘aesthetic considerations play a role in the design of products which are intended for sale directly to the end consumer’ or that ‘the overall design shown in the RCD is of an elongate shape, with a length that is approximately four times as long as its width [thereby giving] to the design a very simple, clean and elegant appearance’ (witness statement point 4 and 8, respectively) does not change the

fact that the features are still the result of the product's technical function and do not suffice to demonstrate that aesthetic considerations were relevant.

- 49 As to the design holder's contention that the contested decision incorrectly took into account the design holder's other RCDs, the Board notes that the Invalidity Division was fully entitled to also take these into account given that, for the purpose of determining whether Article 8(1) CDR applies, as noted above, all of the relevant objective circumstances of the case must be taken into account. One of these circumstances, in the present case, is the information about the design that can be derived from the design holder's other registrations for the same product.
- 50 Finally, the design holder asserts that the Invalidity Division incorrectly broke down the contested RCD into component parts and proceeded to assess the technical function of each of those component parts, rather than the technical function of the contested RCD as a whole. The Board disagrees. Article 8(1) CDR specifically refers to features of the design (rather than the design as a whole) to be excluded from protection when they are solely dictated by the technical function of the product concerned. The contested decision therefore correctly applied the test of Article 8(1) CDR to each of the features of the design separately, but taking into account the technical function of the product as a whole. Its conclusion that all of the features were solely driven by the technical function of the product, consequently led to the invalidation of the design in its entirety. In addition, the contested decision also did in fact consider the design as a whole, when considering the design holder's arguments that visual aspects played a role in the design process, and by consequently, and rightfully, dismissing these arguments.
- 51 It follows that the contested RCD subsists in features which are solely dictated by the technical function of the product to which it is applied. Since the application for a declaration of invalidity of the contested RCD is successful based on Article 25(1)(b) CDR in conjunction with Article 8(1) CDR, there is no need to examine the other invalidity grounds invoked.
- 52 The appeal is dismissed.

Costs

- 53 Since the appeal has been unsuccessful, the design holder must be ordered to bear the costs incurred by the invalidity applicants, in accordance with Article 70(1) CDR.

Fixing of costs

- 54 In accordance with Articles 79(1) and 79(7) CDIR, the Board fixes the amount of representation costs to be paid by the design holder to each of the invalidity applicants for the appeal proceedings at EUR 500 and for the invalidity proceedings at EUR 400. To this, the invalidity fee of EUR 350 must be added, Article 79(6) CDIR. The total amount is EUR 2 500.

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the design holder to bear the costs incurred by the invalidity applicants;**
- 3. Fixes the costs and fees to be paid by the design holder to the invalidity applicants for the invalidity and the appeal proceedings at EUR 1 250 each.**

Signed

G. Humphreys

Signed

H. Salmi

Signed

E. Fink

Registrar:

Signed

H. Dijkema

