

Community Designs: Update on OHIM Procedural Matters and Case Law in the Boards of Appeal and the Court of First Instance

By Harri Salmi¹

I. Change of Practice on Community Design Priority Documents

A convention priority for a Community design may be claimed on the basis of a previous filing of a design/utility model (but not patent) filed in or for a State party to the Paris Convention or the World Trade Organization. The priority claim can be made either simultaneously with the filing of the application, or within the time limit of one month subsequently to the date of filing (declaration of priority). Exhibition priorities have also been possible as of 23/3/2005 when the 2005 World Exposition in Aichi, Japan was held.

The priority check done by the Designs Department of the OHIM (Office for Harmonization in the Internal Market) consists of checking that

- a) the file number of the earlier application is indicated;
- b) the filing date of the application for a RCD (Registered Community Design) falls within the period of six months of the claimed priority date;
- c) the previous application has been filed in or for a State on the Paris Convention list or the WTO list;
- d) the time limit to file a declaration of priority is complied with and that
- e) the priority documents have been submitted.

As of February 2009 the OHIM no longer checks whether the prior application and the RCD application are for the same design. The consequence of this change of practice is that nowadays the OHIM accepts priority documents which do not include views of designs, such as German design registration certificates.

This new practice smoothes the link established in January 2008 between the RCD and the International registered design, since WIPO does not carry out any examination of priority documents. It also accelerates the registration process before the OHIM.

However, it is important for applicants to note that in invalidity proceedings, if it is necessary to determine whether the claimed priority is actually valid, the owner of the RCD must provide the necessary documents before the Invalidity Division

¹ Member of the OHIM Boards of Appeal.

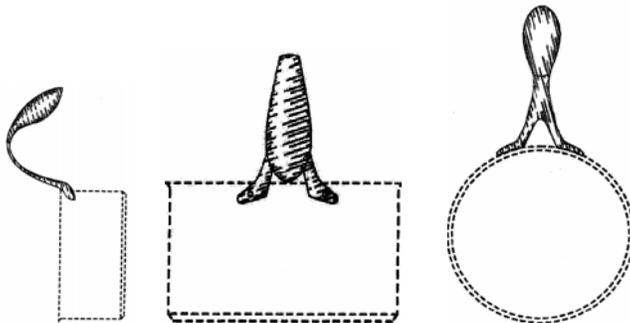
for it to be able to check whether the prior application and the RCD application are for the same design. This is of course only necessary if the applicant had not already provided them when the application was filed. If the documents have not been provided, the Invalidity Division will request for them. Further, if the registration certificate does not show the designs (which would be the case, for example, of a German registration certificate), the evidence should consist of a copy of the filing documents of the previous application, stamped or otherwise certified by the authority which received it.

II. Decisions of the OHIM Board of Appeal on declaration of invalidity

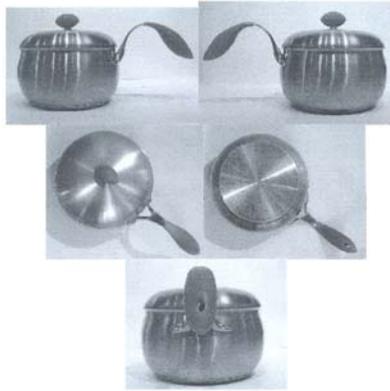
In the following, four decisions made last year concerning questions of invalidity will be discussed. In order for the presentation to be clearer, not all of the views of the designs are included, but instead I have tried to choose the ones which are the most representative for each case. I will also be bringing out the details of each case which I believe to be the most important ones. The full text of each decision can be found by making a search on our website www.oami.europa.eu.

a) R 196/2008-3, 2/9/2008 “saucepan handles”

The first case to be presented concerns the question of novelty. The RCD was applied for with three views which looked like this:



The earlier United Kingdom design was represented with the following five views:



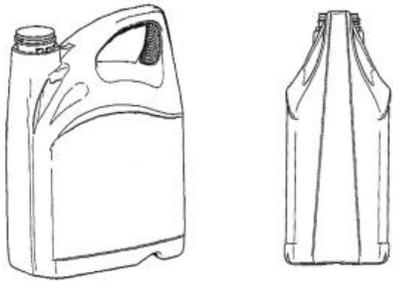
It should be remembered that the RCD application only concerns the handle of the saucepan. One must also take into account that the question to be decided was one of lack of novelty and the CD Regulation does not specify the reference person in these cases. It was, therefore, the Board's task to assess the differences on the basis of the overall appearance of the designs in question and no evaluation of an 'informed user' was done.

In its decision, the Board found that the actual difference in the arch of the handle is minimal and it can only be detected by measuring them or putting one over the other. In addition, the down-turned portion of the handle of the contested design assumes a different angle to the vertical, however, this is hardly visible without actually measuring the angles.

Further, the level at which the extremities of the handle arrive may vary according to its inclination. That level is not really a property of the handle but results from how it is secured to the saucepan. In conclusion, the Board found that the differences between the designs were immaterial, so the designs were deemed to be identical and the contested design lacked novelty. The RCD was therefore invalidated.

b) R 1516/2007-3, 7/7/2008 "cans"

The second case to be presented concerns the question of lack of individual character. The RCD was applied for with a total of six views two of which looked like this:



The earlier design was represented with a total of eight views, six of which are shown below:



First of all, the Board noted that the contested design represents a container of the type that contains lubricants (e.g. engine oils). The informed user is a professional in the trade sector for distributing such goods. He will have knowledge of the market for lubricants and the various shapes of container available.

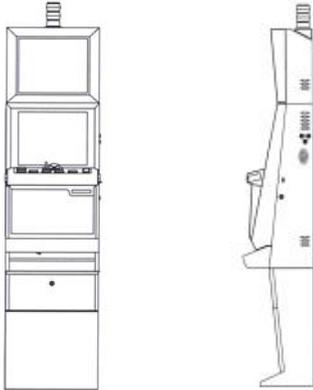
As to the differences, the Board noted, *inter alia*, that the RCD appears tall and slender whereas the earlier design appears short and squat. In addition, the handle occupies a relatively small portion in the RCD whereas, in the earlier design, it has a prominent position, accounting for practically one quarter of the can. The handle shape is also different.

The Board further took into account that the designers' freedom of manoeuvre is fairly limited. Engine-oil cans mostly have a shape resembling that of a parallelepiped, into which the handle and the neck have to be incorporated.

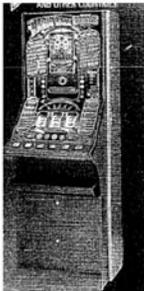
In conclusion, the Board found that the designs produced a different overall impression and dismissed the application for a declaration of invalidity.

c) ***R 135/2007-3, 13/5/2008 "automatic machines for games"***

The third case to be presented also concerns the question of lack of individual character. The RCD was applied for with a total of six views two of which looked like this:



The earlier design had been advertised as shown below:



In its decision, the Board found that the informed user is an individual who knows this type of equipment well and not only an occasional frequenter of game arcades. The Board found various strong formal similarities concerning the cylindrical turret, two rectangular elements in which a screen may be housed, the pushbutton unit and the coin collection. It also noted that a slot machine designer enjoys great freedom, as was demonstrated by the evidence provided by the invalidity applicant concerning the output of the industry sector.

In conclusion, the Board found that the RCD does not possess the necessary individual character and must be declared invalid.

d) R 860/2007-3, 17/4/2008 “inverter generators”

The final case to be presented also concerns the question of lack of individual character. The RCD was applied for with a total of six views two of which looked like this:



The earlier design had been disclosed as shown below:



In this case, as to the informed user, the Board stated that the informed user is whoever habitually purchases such an item and puts it to its intended use and has become informed on the subject by browsing through catalogues of such generators, visiting the relevant stores, downloading information from the internet, etc. The informed user is generally not technically experienced or particularly interested in the technical design of inverter generators. He will therefore not pay attention to every detail of the device. Instead, he will undertake an overall view.

The contested RCD and the prior design share numerous elements which display strong similarities. These include a) a cubic shape, b) two black panels on opposite sides enclosing a central portion of a lighter colour, c) rounded upper corners of the cubic form, d) a trolley mount with four wheels, e) a knob on the top side of the device, f) handle bars at the sides of the generator, g) a linear structure, in the sense that all the lines are straight, except for the rounded upper corners, h) indented sides on the top part of the device and i) the proportions of the elements comprised in relation to one another.

The informed user is more likely to be impressed by the overall aspect of the generator rather than the various details that characterise mechanical devices in general. The designs of inverter generators will produce the same overall impression if they globally display the same arrangement of the various component parts of the generator and these components have similar shapes and sizes relative to each other, as was the case here.

The overall shape, configuration and general appearance of the designs were found to be very similar. The differences do not significantly affect the overall impression produced by the devices since they are details which, although not insignificant, relate to what are essentially marginal elements of the two products. A close examination – going much further than the general comparison required by the regulation – would be needed before the informed user could distinguish the two devices.

In addition, the designer's degree of freedom in developing the design was found to be relatively wide. Certain features must be present in an inverter generator in the sense that it requires the provision of a housing, handles and access to instruments if it is to perform its function, but the Board found it difficult to see any reason why the respondent's design needs to resemble the appearance of the earlier design to such an extent.

An inverter generator could surely look significantly different but still function perfectly for what it is made for, as could also be seen from the examples produced by the respondent in the invalidity proceedings and also from the other designs included in the multiple application of the contested RCD.

In conclusion, the Board found that the RCD does not possess the necessary individual character and must be declared invalid.

III. Update on OHIM cases on designs pending before the CFI

At the time of writing, the Court of First Instance has not yet published any decisions concerning appeals from decisions of the OHIM Board of Appeal on design cases. These decisions are eagerly waited for, but for the time being I can only give you information as to which cases are pending before the Court. The following is a list of these cases and I have also mentioned the main content of the dispute. The main representations of the designs can be seen in my Power Point presentation.

T-9/07 'metal rappers'

The BoA decided that the designs have a different overall impression.

T-10/08 +T-11/08 'internal combustion engine'

The BoA decided that the designs have a different overall impression.

T-148/08 'instruments for writing'

The BoA decided that a distinctive sign (German trade mark) has been used in the subsequent design

T-153/08 'communication equipment'

the

The BoA decided that the designs produce same overall impression.

T-450/08 'bottle'

products
(the Board
products are
non-
to them ?

The notion of disclosure: is the sale of between two professionals enough said yes) or is it required that the put on the market in order that the professional public can have access