



**DECISION
of the Third Board of Appeal
of 16 June 2014**

In Case R 1287/2013-3

Gold Crest, LLC
650 Ward Drive
Goleta California 93111
United States of America

Invalidity Applicant / Appellant

represented by VIERING, JENTSCHURA & PARTNER, Grillparzerstraße 14,
DE-81675 München, Germany

v

Shenzhen Fzone Technology Co., Ltd.
4th Floor, Yuyi Building, Lequn Second
Industrial Zone, Xixiang, Bao'an
Shenzhen, Guangdong
People's Republic of China

RCD Proprietor / Respondent

represented by HASELTINE LAKE LLP, Redcliff Quay 120 Redcliff Street,
Bristol BS1 6HU, United Kingdom

APPEAL relating to Invalidity Proceedings No 8814 (registered Community design
No 1902578-0001)

THE THIRD BOARD OF APPEAL

composed of Th. M. Margellos (Chairperson), C. Rusconi (Rapporteur) and
H. Salmi (Member)

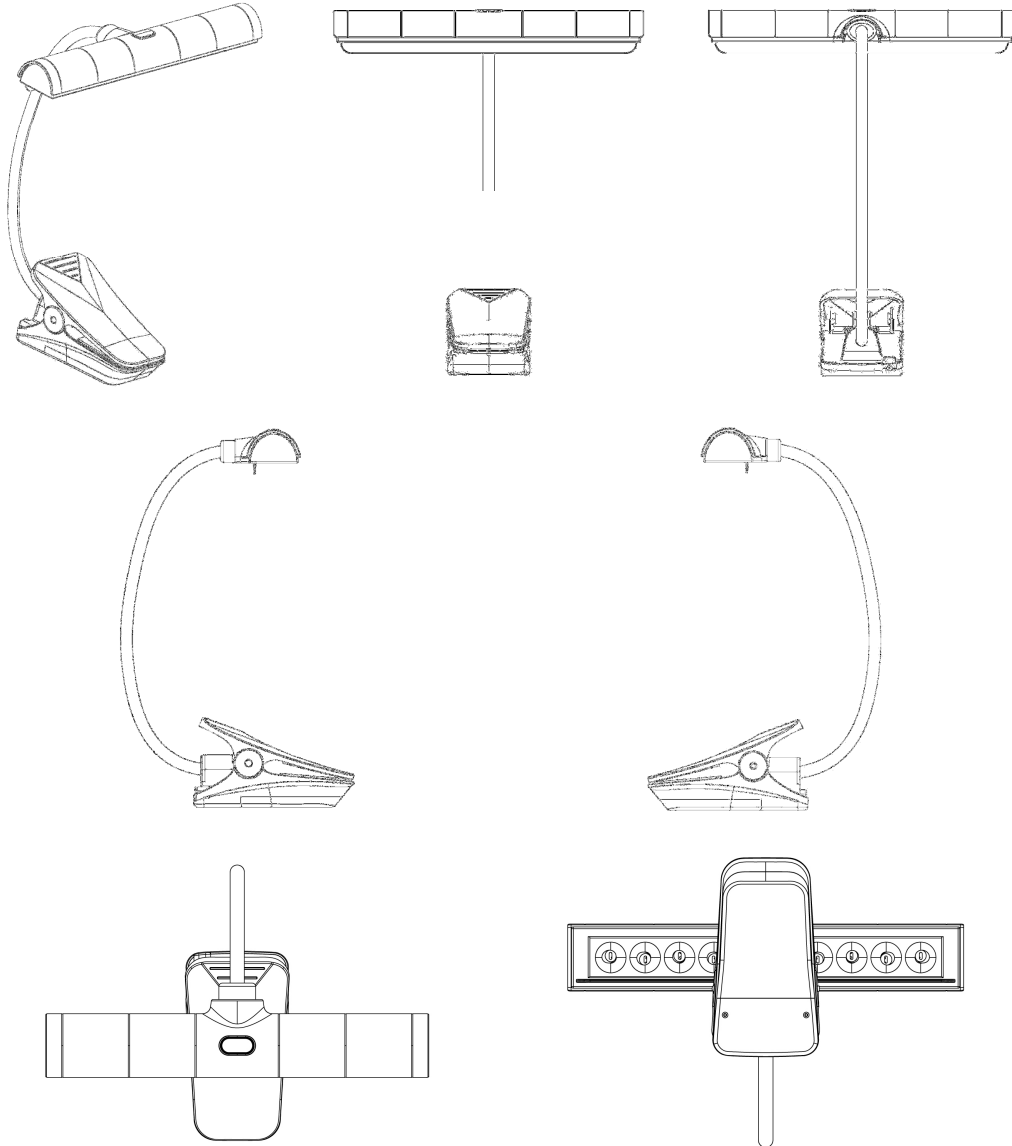
Registrar: P. López Fernández de Corres

gives the following

Decision

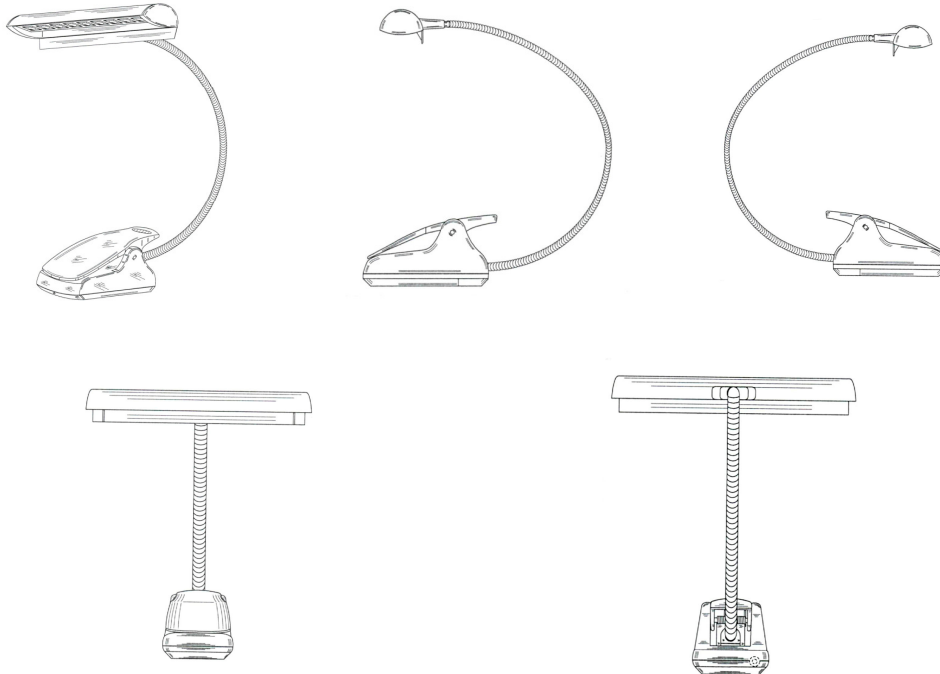
Summary of the facts

- 1 By an application filed on 9 August 2011, Shenzhen Fzone Technology Co., Ltd. ('the RCD proprietor') sought to register the following design ('the contested RCD'):



- 2 The indication of the product is 'lights'.
- 3 The design was registered and published in the Community Designs Bulletin No 182/2011 of 12 August 2011.
- 4 On 8 June 2012, Gold Crest, LLC ('the invalidity applicant') filed an application for a declaration of invalidity against the RCD. The invalidity applicant indicated as grounds for invalidity that the contested registered Community design does not fulfil the requirements of Articles 4 to 9 CDR. In the statement of grounds, the

invalidity applicant stated that the contested design lacked novelty (Article 5 CDR) and individual character (Article 6 CDR) in view of the prior registered Community design No 1255251-0001 ('the prior RCD'), reproduced hereunder,



published on 4 February 2011, because it reproduces the same essential features – clip, neck and head – and both designs provide the same overall impression.

- 5 The RCD proprietor replied that both designs are different in many aspects and that the overall impressions produced by the respective designs are different, too. This ensures, in sum, novelty and individual character to the contested RCD.
- 6 On 6 June 2013, the Invalidity Division issued a decision ('the contested decision') rejecting the application for a declaration of invalidity and ordering the invalidity applicant to bear the costs. The reasoning in the contested decision was, in essence, the following as regards novelty:
 - The prior design and the contested RCD both relate to lamps. The two designs differ at least in the following features:
 - The head of the lamp of the contested RCD has perpendicular lines engraved therein, whereas no such lines are visible in the prior design;
 - The neck (connecting the head with the base) in the contested RCD is plain, i.e. with a flat surface, whereas the neck of the prior design has a ring structure;
 - The upper part of the clip of the contested RCD is concave whereas the top of the clip of the prior design is convex;

- The upper part of the clip of the contested RCD has a triangular section which is not present in the upper part of the clip of the prior design;
- The differences in the features listed above are not immaterial details. Therefore, the prior design is not an obstacle to the novelty of the contested RCD in the meaning of Article 5 CDR.
- 7 The reasoning as regards individual character was:
- The informed user is familiar with lamps, in particular reading lamps to be clipped to desks or other surfaces of the type shown in the contested RCD. Due to their technical function, those lamps must have a head (incorporating a light bulb), a base in the form of a clip (to fix it to a desk), and a neck connecting the head with the base. As correctly observed by the invalidity applicant, within the technical constraints there are nearly endless possibilities to design such lamps. Consequently, the degree of freedom of a designer of lamps is not limited;
 - The RCD and the prior design are different as regards all the three basic elements of the lamps, namely the heads, the necks and the bases in form of clips. The clip of the lamp of the contested RCD is shaped like the head of a crocodile whereas the clip of the prior design resembles more a computer mouse. Due to its big size, the clip has a significant impact on the overall impression on an informed user produced by the design. Therefore, the overall impression produced by the lamp of the RCD on an informed user is different from the overall impression produced by the prior design. The prior design does not form an obstacle to the individual character of the contested RCD.
- 8 On 8 July 2013, the invalidity applicant filed an appeal and the corresponding statement of grounds of appeal was received on 2 October 2013.
- 9 The design holder's observations reached the Office on 10 December 2013.
- 10 The invalidity applicant replied to these observations on 14 February 2014, whilst the RCD proprietor did not to file any further submissions.

Submissions and arguments of the parties

- 11 The arguments of the invalidity applicant can be summarised as follows:
- The contested design lacks novelty because the differences are non-essential; the perpendicular lines are negligible, as is the ring structured neck and the convex instead of concave upper part of the clips;
 - The contested design also lacks individual character because the confrontation of the designs shows that their overall impression coincides;
 - The contested design takes over all relevant features of the earlier designs, namely the shape of the clip, the shape of the neck (slim, wide stretching, arc like shape), and the elongated head with LEDS placed in a row and a blind on the back side of the housing;

- The designer’s freedom is very large as lamp designs attached show.
- 12 In its observations, the RCD proprietor essentially argued on the following grounds:
- The informed user is particularly observant and can make a direct comparison according to case law (see judgment of 20 October 2011, C-281/10 P, ‘Metal rappers’);
 - There is a certain degree of designer’s freedom;
 - Clip-on desk lamps have long been available on the market;
 - Overall impression is not similar because of noticeable, striking differences in clip, neck and head.
- 13 The invalidity applicant reiterates earlier arguments.

Reasons

- 13 The appeal complies with Articles 55 to 57 CDR and Article 34(1)(c) and (2) CDIR. It is, therefore, admissible.
- 14 Under Article 25(1)(b) CDR a Community design may be declared invalid if it does not fulfil the requirements of Articles 4 to 9 CDR.
- 15 Under Article 4(1) CDR a design is to be protected as a Community design to the extent that it is new and has individual character.
- 16 Novelty is defined by Article 5(1) CDR in the following terms:

‘1. A design shall be considered new if no identical design has been made available to the public:

(a) ...

(b) in the case of a registered Community design, 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.’

- 17 Individual character is defined by Article 6 CDR:

‘1. A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public:

(a) ...

(b) in the case of a registered Community design, before the date of filing of the application for registration or, if a priority is claimed, the date of priority.

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

18 The question posed pursuant to Articles 5 to 7 CDR is essentially whether, prior to the filing date of the contested RCD, an identical design or a design that produces the same overall impression on the informed user, had been made available to the public.

Disclosure

19 The Board finds that the copies of the Community design No 1255251-0001 published on 4 February 2011 in the Community Designs Bulletin are evidence of disclosure prior to the filing date of the RCD in the meaning of Article 7(1) CDR. This has not been disputed by the parties.

Individual character

a. The informed user

- 20 It is apparent from Recital 14 in the preamble to the CDR that, when assessing whether a design has individual character, account should be taken of the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs (see judgment of 22 June 2010, T-153/08, 'Communications equipment', para. 43).
- 21 According to the case-law, an 'informed user' within the meaning of Article 6 CDR is neither a manufacturer nor a seller of the products in which the designs at issue are intended to be incorporated or to which they are intended to be applied. An informed user is particularly observant and has some awareness of the state of prior art, that is to say the previous designs relating to the product in question that have been disclosed on the date of filing, or the priority date, of the contested design (see judgments of 9 September 2011, T-10/08, 'Internal combustion engine', para. 23; and of 18 March 2010, T-9/07, 'Metal rappers', para. 62, confirmed by judgment of 20 October 2011, C-281/10 P, para. 54).
- 22 The status of 'user' implies that the person concerned uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended (see judgments of 22 June 2010, T-153/08, 'Communications equipment', para. 46; and of 9 September 2011, T-10/08, 'Internal combustion engine', para. 24).
- 23 The qualifier 'informed' suggests that, without being a designer or a technical expert, the user knows the various designs which exist in the sector concerned, possesses a certain degree of knowledge with regard to the features which those designs normally include, and, as a result of his interest in the products concerned, shows a relatively high degree of attention when he uses them (see judgments of 20 October 2011, C-281/10 P, 'Metal rappers', para. 59; and of 22 June 2010, T-153/08, 'Communications equipment', para. 47).

- 24 The contested RCD is registered for 'lights'. The representation of the design shows that it is not a mere 'light' but what is known in trade as a reading lamp for individual use. These lamps are designed to illuminate the reading area on a desk.
- 25 The informed user to be taken into account is whoever habitually purchases such an item, puts it to its intended use and has become informed on the subject by browsing through catalogues of, or including, reading lamps for personal use, visiting the relevant stores or stands, downloading information from the Internet, etc. (see, by analogy, decision of 18 September 2007, R 250/2007-3, 'TAVOLI').

b. The designer's degree of freedom in developing its design

- 26 The designer's degree of freedom in developing his design is established, *inter alia*, by the constraints of the features imposed by the technical function of the product or an element thereof, or by statutory requirements applicable to the product. Those constraints result in a standardisation of certain features, which will thus be common to the designs applied to the product concerned. The more the designer's freedom in developing the contested design is restricted, the more likely minor differences between the designs at issue will be sufficient to produce a different overall impression on the informed user (see judgment of 18 March 2010, T-9/07, 'Metal rappers', paras 67 and 72).
- 27 The greater the designer's freedom in developing the challenged design, the less likely it is that minor differences between the designs at issue will be sufficient to produce a different overall impression on an informed user. Conversely, the more the designer's freedom in developing the challenged design is restricted, the more likely minor differences between the designs at issue will be sufficient to produce a different overall impression on an informed user. Therefore, if the designer enjoys a high degree of freedom in developing a design, that reinforces the conclusion that the designs which do not have significant differences produce the same overall impression on an informed user (see judgment of 9 September 2011, T-10/08, 'Internal combustion engine', para. 33).
- 28 The Board agrees with the contested decision that the degree of freedom of the designer of the desktop reading lamp is quite broad, as it is only limited in so far as these types of lamps must have a base, a head (containing the bulbs) and an element linking the head to the base, which is referred to hereinafter as the neck. The base must be capable of keeping the lamp securely in place; the head must be capable of housing the kind of illumination that fits the purpose of the lamp: since the lamp at issue is for reading documents on a desk, the head must be designed in a way that the source of light focuses on the document; the neck must allow the user to orientate the head appropriately: it must thus be flexible.

c. Overall impression produced on the informed user

- 29 The Board agrees with the contested decision that in the present case, the contested design has many different design features that create a different overall impression with respect to the earlier design.
- 30 The first feature concerns the design of the head of the lamp. The surface of the head, in the contested design, is characterised by several equidistant lines that create five portions, whereas the surface is even in the earlier design. This difference affects the overall impression because the head is the part of the reading lamp that is immediately seen when using the product. The fact that the head has, in the two lamps, a narrow and elongated shape will be ascribed by an informed user to the specific purpose of the lamp, which is to direct light on a document or a book lying on a desk in front of a seated reader. An elongated head, perpendicular to the neck, and capable of housing a series of aligned bulbs or LEDs, is particularly suitable to illuminate evenly a document or book of a standard size that lies underneath.
- 31 The second feature concerns the design of the neck of the two lamps. The surface of the neck is, in the contested design, perfectly even whereas it has a knurled aspect similar to that of a shower hose (that aspect was referred to as that of a 'ring structure' in the contested decision) in the earlier design. This is also a difference capable of affecting the overall impression because the neck of a desk lamp is, after the head, the most immediately visible part of the product, when in use.
- 32 The third feature concerns the base of the lamp. The base is a clip in both designs which allows the lamp to be securely fitted to the rim of, for example, a desk. The aspect of the clip of the lamp according to the contested design is made of rather sharp lines (see perspective No 5) whereas it tends to be rounder in the earlier design (see perspective No 2). In particular, the upper part of the clip is concave (even if slightly so) in the later design and significantly convex in the earlier design. Even if the base of a desk lamp is not perhaps the most visible part of the product since, when the lamp is in use, it may be easily masked by reading matter, such as loose papers or books, it nevertheless contributes, together with the rest of the components, to the overall impression of the lamp from the viewpoint of an informed user.
- 33 The aforementioned differences in the designs are sufficient to produce a different overall impression on the informed user, who is particularly observant and can make a direct comparison (see judgment of 20 October 2011, C-281/10 P, 'Metal rappers'). Consequently, the overall impression of the prior design is not of such a nature as to deprive the RCD of its individual character pursuant to Article 6 CDR. The aforementioned differences are also, even more so, sufficient to deduce that the designs are not identical. Therefore, the contested RCD also does not lack novelty.

Conclusion

- 34 It follows from all the above considerations that the contested decision did not err in finding that the designs do not differ in only immaterial details and that they produce a different overall impression on the informed user. Therefore, the application of invalidity based on Article 25(1)(b) CDR was not well founded.

Costs

- 35 The invalidity applicant, as the losing party, is ordered to bear the RCD proprietor's costs (Article 70 CDR).

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the invalidity applicant to bear the RCD proprietor's costs.**

Th. M. Margellos

C. Rusconi

H. Salmi

Registrar:

P. López Fernández de Corres