



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

The Boards of Appeal

**DECISION  
of the Third Board of Appeal  
of 2 November 2010**

In Case R 1086/2009-3

**Erich Kastenholz**

Dauner Str. 14  
D-53842 Troisdorf  
Germany

Invalidity applicant / Appellant

represented by Rechtsanwälte ACKER & MÜLLER, Adenauerallee 132a, D-53113 Bonn, Germany

v

**qwatchme a/s**

Tirsbaekvej 191  
DK-7120 Vejle East  
Denmark

RCD proprietor / Respondent

represented by PATRADE A/S, Fredens Torv 3A, DK-8000 Aarhus C, Denmark

APPEAL relating to Invalidation Proceedings No ICD 5 528 (Registered Community Design No 602636-0003)

**THE THIRD BOARD OF APPEAL**

composed of Th. Margellos (Chairperson and Rapporteur), D.T. Keeling (Member) and C. Rusconi (Member)

Registrar: C. Bartos

gives the following

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Language of the case: English

## Decision

### Summary of the facts

- 1 Qwatchme A/S ('the RCD proprietor') is the holder of Registered Community Design No 602636-0003 ('the contested RCD'), which has a filing date of 28 September 2006. The contested RCD is registered for 'watch-dials'. It is represented below. The description of the representation states that 'All the representation-views show a watch-dial with special constructed watch-hands, showing the time in a different way'.



view 3.1



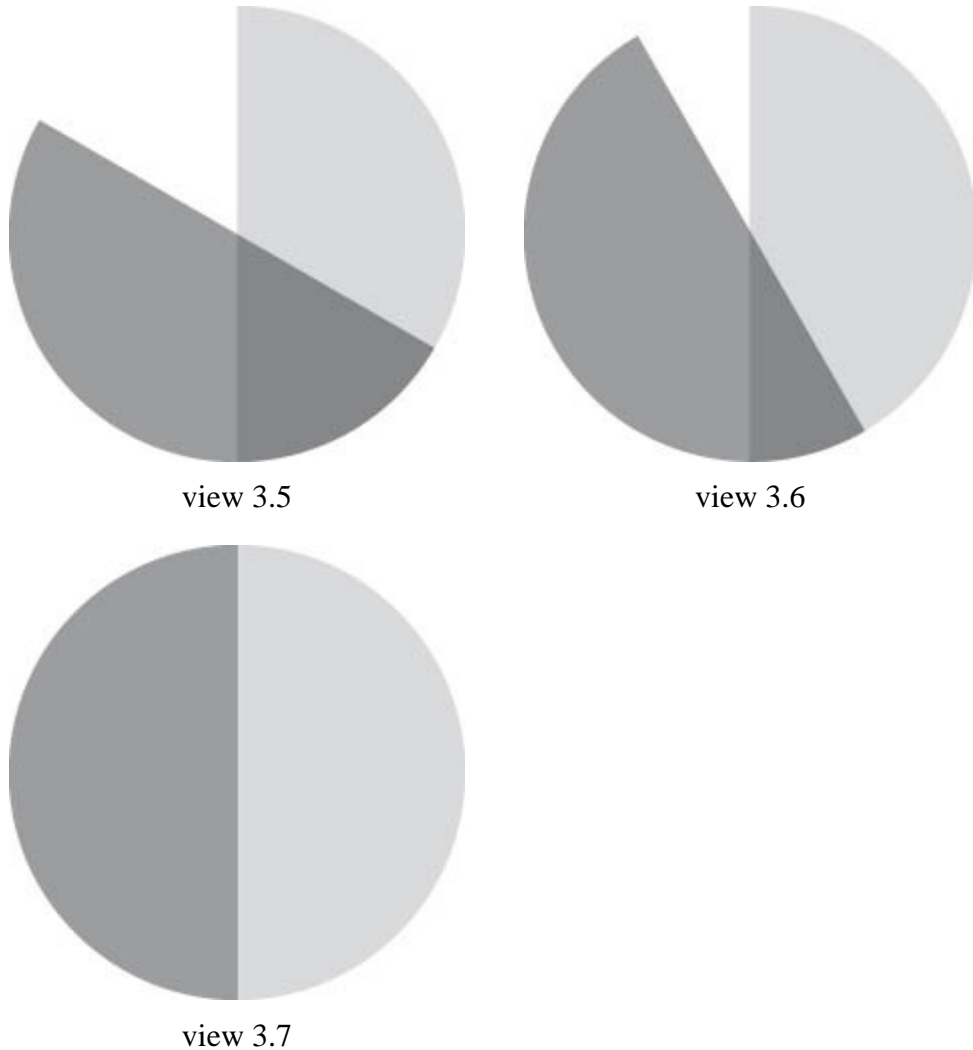
view 3.2



view 3.3



view 3.4



- 2 On 25 June 2008, Erich Kastenholz ('the invalidity applicant') filed an application for a declaration of invalidity against the contested RCD. The invalidity applicant argued that the RCD did not fulfil the requirements of Articles 4 and 5 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs ('CDR') (OJ EC 2002 No L 3, p. 1) and that it constituted an improper use of a clock-face that was protected under German copyright law pursuant to Article 25(1)(f) CDR.
- 3 The invalidity applicant claimed that the RCD was not new since an identical design of a clock-face with the technique of overlapping coloured foils ('Farbfolge 11') for '12 hours in a cadence of 5 minutes' had been shown and published by the artist Paul Heimbach in exhibitions and catalogues between 2000-2005. The invalidity applicant claimed that from the clock-face design 'Farbfolge 11', the artist Paul Heimbach developed the clock-face 'Farbzeiger 11' and that in 2001, 100 watches with the artwork 'Farbzeiger 11' were manufactured and sold to AGFA Gevaert AG, which presented the clocks to its customers as gifts. He stated that between 14 November 2003 and 13 December 2003, the 'Farbfolge' clock-face was exhibited in Düsseldorf, Germany by Buchgalerie Mergemeier. In the invalidity applicant's view, the design of the clock-face was protected under German copyright law because it

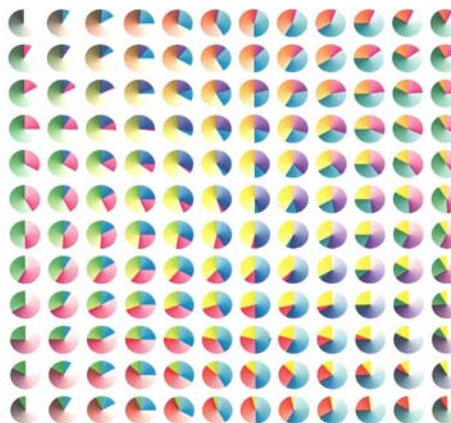
featured a clock-face that changed continuously with the movement of the clock fingers and in which each finger was attached to a half transparent foil that generated special colours each time they overlapped.

- 4 In support of his application the invalidity applicant submitted the following documentation:
- A representation of ‘Farbfolge’ (Colour sequence) 11 (Attachment 1);
  - A representation of ‘Farbzeiger’ (Colour hand) 11 (Attachment 11);
  - A copy of the flyer presented with the clocks sold to AGFA Gavaert AG in 2001 (Attachment 3);
  - A representation of the clock-face ‘Farbfolge 11’ exhibited by Buchgalerie Mergemeier in Düsseldorf in 2003 (Attachment 4);
  - Press release of Buchgalerie Mergemeier from [www.kunstaspekte.de/index/php](http://www.kunstaspekte.de/index/php) (attachment 5);
  - Articles in the press dealing with Paul Heimbach’s artwork (Attachment 6);
  - Extracts from a commentary of the German Copyright Act (Attachment 8);
  - A list of the years and the places where the work of the artist Paul Heimbach was exhibited (Attachment 9);
  - A copy of the licence agreement between Paul Heimbach and the invalidity applicant granting the latter the exclusive licence to distribute the clocks and watches (Attachment 9).
- 5 Attachment 1 of the application contained the following representation of ‘Farbfolge 11’:

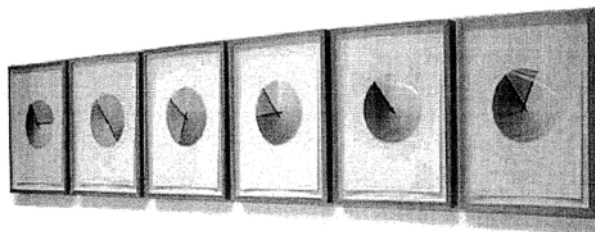


Paul Heimbach  
Farbfolge II

Tintenstrahl-Drucke und Uhrwerk in Objektrahmen, 40 x 30 cm, Auflage 100 Exemplare.  
Die nachfolgende Abbildung zeigt den Verlauf von zwölf Stunden in Fünf-Minuten-Takt.



- 6 Attachment 4 to the application depicted the 'Farbfolge 11' as follows:



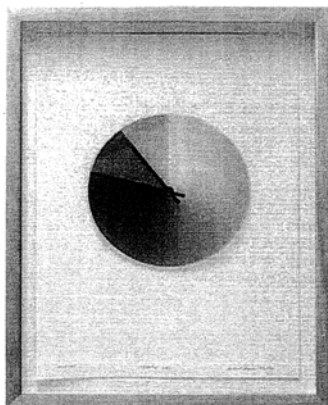
Farbfolge II 2003

Tintenstrahl auf Folie, Uhrwerk

Holzrahmen 40x30 cm, Auflage 100 Ex.

(auf dem Foto jeweils 2 Stunden vorgestellt)

- 7 Attachment 2 to the application contained the following representation of 'Farbzeiger 11':



2001

Farbzeiger (II)

Tintenstrahl auf Overhead-Folie

Uhrwerk, Holzrahmen 40x30 cm

- 8 On 27 October 2008, the invalidity applicant submitted translations of the documents in German and the following evidence:
- Two pieces of Paul Heimbach's artwork: 'Farbfolge 1' signed and dated February 2000 and 'Farbfolge 11' signed and dated September 2003:

- Copies of e-mail exchanges with the RCD proprietors' lawyers;
  - Two brochures for the RCD proprietor's watches with coloured rotating disks.
- 9 After the exchange of observations, on 16 July 2009, the Invalidity Division of the Office issued a decision ('the contested decision') rejecting the application for a declaration of invalidity. The invalidity applicant was ordered to bear the costs.
- 10 The contested decision is summarized as follows:

#### *Novelty*

- The contested RCD and the prior designs are timepieces that show time by means of coloured disks. However, the RCD on the one hand and the two prior designs on the other, are different. The disks in the invalidity applicant's designs are coloured with a clockwise increasing intensity, whereas the two half disks of the RCD are uniformly coloured (shaded). In addition, in the invalidity applicant's disks a third disk is painted on the background paper on which the two disks are mounted, whereas the RCD does not comprise a third disk.
- Due to the differences explained above the prior designs cannot be moved in any of the configurations shown in the views of the RCD, i.e. none of the configurations shown in the respective views of the RCD is anticipated by any of the prior designs. Therefore, none of the prior designs forms an obstacle to the novelty of the RCD.

#### *Individual character*

- The informed user is familiar with the design of timepieces. He is aware that the degree of freedom of a designer concerned with that type of (analog) watch or clock is limited only in so far as there must be some sort of a watch-dial with watch-hands to show the time.
- In the present case, the overall impression produced on the informed user by the RCD differs from the overall impressions produced by the prior designs. The prior designs disclosed comprise graded colouring (shading) of their disks which produce a large range of colours when the disks overlap at various angles. In contrast, the RCD only gives rise to a maximum of three different colours (shades). Therefore, the prior designs raised do not form any obstacle to the individual character of the RCD.

#### *Copyright*

- In view of the differences between the design of the RCD and the prior designs, it is found that the RCD does not make use of the work of Mr Heimbach protected under German copyright.

- 11 On 15 September 2009, the invalidity applicant filed a notice of appeal against the contested decision. The invalidity applicant submitted a statement of grounds on 17 November 2009.
- 12 The RCD proprietor submitted its response on 19 January 2010.
- 13 The invalidity applicant replied to the RCD proprietor's observations on 31 March 2010.
- 14 The RCD proprietor filed a rejoinder on 15 June 2010, stating that the invalidity applicant's reply of 31 March 2010 did not contain any new claims or allegations.

### **Submissions and arguments of the parties**

- 15 The invalidity applicant requests the Board to annul the contested decision and to declare the contested RCD invalid. His arguments may be summarized as follows:

#### *Novelty*

- The fact that the disks in the prior designs are coloured with a clockwise increasing intensity, whilst the disks of the RCD are uniformly coloured is immaterial. It is unimportant whether the colour of the divided parts of the clock-face increases or not. Despite the difference in shading, the general impression remains very strong that there are two or three surfaces coloured mainly in the same way and sharply divided from the other part of the clock-face.
- In the RCD, depending on the time, there are two or three different sectors generated by the half disks and the white background generates the third or fourth sectors. There are up to four different sectors in both the prior design and the RCD.
- The RCD and the art pieces of Paul Heimback both show differing clock-faces that depend on time. The fact that the RCD has a different background colour is not a material difference.

#### *Copyright*

- The contested decision is not in accordance with the legal provisions. The question is not whether there are differences between the RCD and the artwork. It is, rather, whether there has been an infringement of the copyright of the artist.
- According to the expert opinion of the Professor of Art of the University of Bonn, Mrs Gabriele Oberreuther, (see attachment), the general principle in the artwork of Paul Heimback does not depend on the number of half disks, the background colour or whether the disks are coloured uniformly.

- The mixture of colours and the fact that time is represented by coloured disks is Paul Heimbach’s new and original idea. It is, therefore, evident, that the RCD infringes Paul Heimbach’s copyright even if it may be as in this case that ‘the reduction of the colour scale to less colours is effected and/or more/less levels are used’. Mrs Gabriele Oberreuther concludes that there is copyright infringement.
  - ‘Paul Heimbach created his ‘Colour hand’ in 2000 and he realized the idea of forming multi-layered coloured spaces and transforming them circularly by mechanical not manual movement’.
  - According to the RCD proprietor’s own advertising, the watches it produces feature a revolutionary way of presenting time using a display which changes with every passing minute (see the RCD proprietor’s 2007 brochure).
- 16 The RCD proprietor considers that the evidence submitted on appeal should be dismissed for being filed late. It considers that the number of shades in the invalidity applicant’s artwork is not the same as the number of shades in the RCD and that the overall impression is that the former contains more than two disks whereas the latter contains only two. It contends that the differences in the number of disks and the background colour makes the objects appear very different and that, therefore, there is no copyright infringement. Furthermore, it points out that the idea of disks showing the time itself is not protected by either design or copyright legislation.
- 17 The invalidity applicant replies arguing as follows:
- The clock-face with a display that changes colours is clearly part of Paul Heimbach’s artwork.
  - The endless number of colour variations is a feature of both the RCD and the earlier artwork.
  - Paul Heimbach’s artwork is highly individual, unique and very creative.
  - Under German copyright law, the range of legal protection also depends on the individual and creative quality. The artist and copyright holder can prohibit variations and modifications of the artwork if their artwork is very unique and shows a high level of individuality and quality.

### **Reasons**

- 18 The appeal complies with Articles 55 to 57 CDR and Article 34(1) (c) and (2) of Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community designs (‘CDIR’) (OJ EC 2002 No L 341, p. 28). It is therefore admissible.
- 19 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.



- 20 Novelty is defined by Article 5 CDR in the following terms:
- ‘1. A design shall be considered to be 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.
  2. Designs shall be deemed to be identical if their features differ only in immaterial details.’
- 21 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.’
- 22 The degree of freedom of the designer of the clock is only limited by the need to track and display the change in time.
- 23 It is not disputed that the designs ‘Farbfolge 1’ (Colour sequence 1) and ‘Farbfolge II’ (Colour sequence II) were created by the artist Paul Heimbach and made available to the public prior to the filing date of the RCD.
- 24 The articles dealing with the artist Paul Heimbach’s work refer to the earlier work as ‘a wall clock [Farbzeiger] with hands that move the foils and in this way wander every 12 hours from dark grey through all colour gradations back into dark grey’. Its hands move round a clock-face with the colours of the spectrum changing in a minute cycle’ (‘Frankfurter Allgemeine Zeitung’, Culture, 2 May 2005).
- 25 The RCD is a representation of a watch-dial in which time is indicated in two shades or in varying proportions of those two shades with two other shades. The intensity of the colours does not change gradually with the change of time. In the case of the RCD two shades or colours are visible on the clock-face in the 12 o’clock and 6 o’clock positions; otherwise four distinct shades are visible at all other times, with no variation in the intensity of the shades. By contrast, the clock-face of the earlier design is able to produce a wide spectrum of colours by a movement controlled by the hands, the combination and

intensity of which changes with time. No two uniform shades or colours are possible in the 12 o'clock and 6 o'clock positions in the earlier designs. The colour of the clock or watch-face displayed in the conflicting designs differ significantly from one another.

- 26 The differentiating features mentioned have a significant impact on the overall impression produced by the two designs and lead to a different perception by the informed user. The contested RCD, therefore, possesses individual character.
- 27 The two designs are not identical. It is clear that novelty and individual character, although presented as separate requirements in Articles 4 to 6 CDR, overlap to some extent. Obviously, if two designs produce a different overall impression on the informed user, they cannot be identical for the purposes of Article 5 CDR.

### *Copyright*

- 28 Copyright confers upon the creator the exclusive right to prohibit or authorise the reproduction or adaptation of his work. Article 11 of the German Copyright Law (*Urheberrechtsgesetz*, UrhG) states that 'Copyright shall protect the author with respect to his intellectual and personal relationship with his work, and also with respect to utilization of his work'.
- 29 It is not disputed that 'Farbfolge 1' (Colour sequence I) and 'Farbfolge II' (Colour sequence) II are works of art that are protectable under German copyright law, which were created before the filing date of the RCD (see the press reports referring to the exhibition of 'Farbfolge II' at the Buchgalerie Mergemeier in 2003).
- 30 An essential feature of the earlier art work is the use of the base colours red, yellow and blue in varying proportions which produces the different shades of the colours depicted in attachment 1.
- 31 The RCD does not use the base colours red, yellow and blue in varying proportions to produce the different shades of the colours depicted. In the RCD, only four shades at most can be viewed depending on the time and there is no gradual change in the intensity of those colours. This can be seen clearly from the RCD proprietor's product catalogue. Therefore, the RCD is not a reproduction or even an adaptation of the earlier art work.
- 32 Furthermore, copyright protection extends only to expressions, and not to ideas, procedures, methods of operation or mathematical concepts as such. This principle has been confirmed by the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) of the World Trade Organization (WTO) as well as the WIPO Copyright Treaty to which Germany is a contracting party. The indication of the time by the change in the shades or colours of the clock-face or shade is merely an idea and as such is not protectable under copyright.
- 33 For the foregoing reasons the appeal is dismissed.

**Costs**

- 34 Since the appeal has been unsuccessful, the invalidity applicant must be ordered to bear the fees and costs incurred by the RCD proprietor, in accordance with Article 70(1) CDR.

**Order**

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the invalidity applicant to bear the fees and costs incurred by the RCD proprietor.**

Th. Margellos

D.T. Keeling

C. Rusconi

Registrar:

C. Bartos