



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

The Boards of Appeal

DECISION
of the Third Board of Appeal
of 22 March 2010

In Case R 417/2009-3

Unistraw Asset Holding Pty. Ltd

36-42 Chippen Street
Chippendale, NSW 2008
Australia

Design Holder/Appellant

represented by OLSWANG LLP, 90 High Holborn, London WC1V 6XX, United Kingdom

v

Felföldi Edessegyarto Kft

Dioszegi ut Keteli ipartelep 6
HU-4030 Debrecen
Hungary

Invalidity Applicant/Respondent

represented by Dr. Ralf Franke, Sauerbruchweg 8, D-41564 Kaarst, Germany

APPEAL relating to Invalidation Proceedings No ICD 5296 (Registered Community Design No 422829-0002)

THE THIRD BOARD OF APPEAL

composed of Th. Margellos (Chairperson), M. Bra (Rapporteur) and D.T. Keeling (Member)

Registrar: J. Pinkowski

gives the following

Language of the case: English

Decision

Summary of the facts

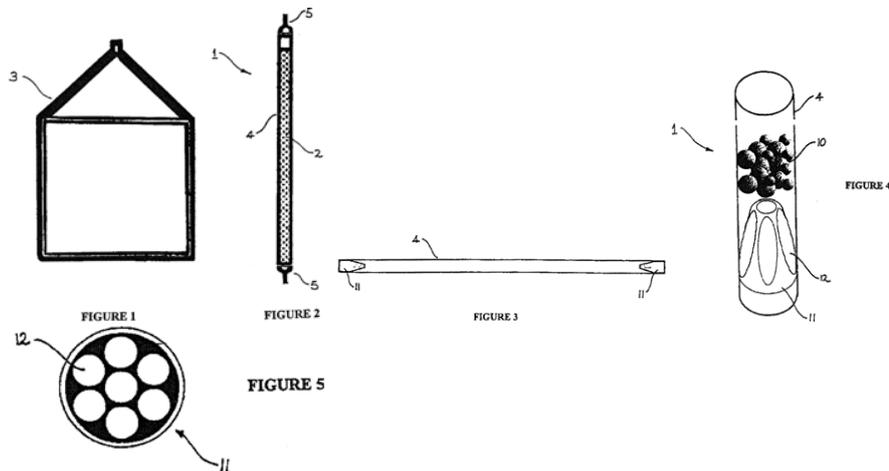
- 1 The appellant, a company domiciled in Australia, is the holder of Registered Community Design No 422829-0002 ('the contested RCD'), which has a filing date of 14 October 2005. The contested RCD is registered for 'drinking straws'. It is represented as follows:



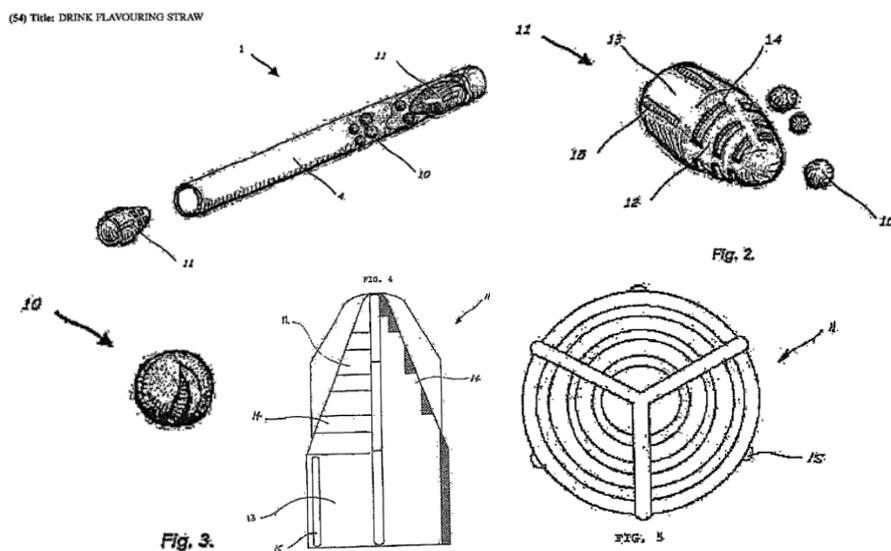
- 2 On 21 April 2008 the respondent filed an application for a declaration of invalidity against the contested RCD. The appellant argued that the design did not fulfil the requirements of novelty and individual character under Articles 4 to 6 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs ('CDR') (OJ EC 2002 No L 3, p.1).
- 3 The respondent contended that the RCD was almost identical to two earlier international patent applications which have been published before the filing date of the contested RCD. Furthermore, it submitted that the appellant itself had exhibited straws with granules at an exhibition in Cologne in Germany in 1999 and 2000.
- 4 As evidence, the respondent produced copies of the international patent applications WO 98/15187 entitled "method and apparatus for producing a flavoured beverage", published on 16 April 1998 ('citation D 1'), and

WO 03/101226 A1 entitled “drink flavouring straw”, published on 11 December 2003 (‘citation D 2’), both of which of an applicant and inventor domiciled in Australia, as well as a picture allegedly showing the product Super Candy of which the respondent claims that it has been exhibited by the appellant in Cologne in 1999 and 2000 (‘citation D 3’).

5 Citation D 1 contains the following figures:



6 Citation D 2 contains the following figures:



7 On 9 February 2009 an Invalidity Division of the Office issued a decision (‘the contested decision’) declaring the contested RCD invalid. The appellant was ordered to bear the costs.

8 The Invalidity Division reasoned as follows:

- The copies of the international patent applications in citations D 1 and D 2 are admissible as they contain a clear reference to the international publication dates and because they constitute proof for the registration of a

patent by an international organisation, namely the International Bureau at WIPO.

- According to Article 7(1) CDR, the RCD shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, before the date referred to in Articles 5(1)(a) and 6(1)(a) or in Articles 5(1)(b) and 6(1)(b) CDR, as the case may be, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community. Citations D 1 and D 2 are copies of international patent applications, which were duly published in 1998 and 2003, respectively. Therefore, the contents of citations D 1 and D 2, including the figures and their descriptions, were made available to the public in the meaning of Article 7(1) CDR. The figures and the descriptions define the appearance of a product, namely a drinking straw, and hence citations D 1 and D 2 are disclosing designs in the meaning of Article 3(a) CDR.
 - The prior designs in citations D 1 and D 2 and the contested RCD all concern a drinking straw constituted of a transparent elongated hollow cylinder partly filled with granules or pellets. The prior designs disclosed in citations D 1 and D 2 and the design of the contested RCD are identical.
- 9 On 9 April 2009 the appellant filed a notice of appeal against the contested decision. The appellant submitted a statement of grounds on 11 June 2009. The respondent submitted its observations to the appellant's statement of grounds on 27 August 2009.

Submissions and arguments of the parties

- 10 The appellant requests the Board to overturn the contested decision and to declare that the registration for the contested RCD is valid. Its arguments may be summarized as follows:
- European companies operating on the European market are not in the habit of searching patent application documents originating from Australia. Furthermore, in the confectionery industry, it is unusual for products to be the subject of patent protection. Thus, citations D 1 and D 2 do not qualify as disclosures within the meaning of Article 7 CDR.
 - Furthermore, due to their different subject-matter, patent and design protection should be treated separately. Whereas a design seeks to protect the appearance of a product, a patent seeks to protect the function, operation, construction of a new creation. As the graphical representation of an RCD determines its scope of protection, all of its features are important. The drawings included in citations D 1 and D 2, however, only serve to illustrate the technical solution and not the external appearance of the product using the technical solution, which can have a number of forms and different

external appearances. The wording of citations D 1 and D 2 cannot, by their nature, disclose a design. For these reasons, citations D 1 and D 2 do not affect the novelty and individual character of the appearance of the contested RCD.

- The figures depicted in citations D 1 and D 2 create a different overall impression to the contested RCD. The overall impression of the contested RCD is of a transparent, elongated, hollow straw, with inwardly facing conical-shaped filters at either end that have elongated slots through which liquid is able to pass, and within which are contained solid, roughly spherical granules that are located along the body of the straw to within 1-2 cm of either end of the straw. The essential design features of the contested RCD are as follows:
 - a transparent central elongated hollow cylinder;
 - filters at either end of the straw, each of which is generally conical in shape with the cone pointing into the interior of the straw;
 - the filters form end caps at either end of the straw;
 - the filters have a number of apertures, which are elongated slots of approximately 1mm in width;
 - a second view of the straw appears as a series of four concentric circles, with a solid central section and three radially extending lines projecting across the plane of the concentric circles;
 - granules or pellets are present within the body of the straw, and are held in place by the filters at either end of the straw;
 - the granules are solid, and roughly spherical in shape;
 - the granules are sized so as to be complementary to the size of the straw and the apertures in the filters, with the pellets having a diameter of between 1-2 mm;
 - the straw is transparent, so that it is possible to see the granules within the body of the straw;
 - the granules are along the length of the straw until a distance of 1-2 cm from the ends of the cylinder and form a band of colour through the body of the straw;
 - the granules are readily, individually discernible. They create a random pattern that is visible through the wall of the straw and has aesthetic merit.
- The figures depicted in citations D 1 and D 2, all of which are schematic drawings used for explaining the functional features of the patents and neither intended to nor able to convey the artistic design elements of the relevant product, create a different overall impression to the contested RCD.
- The contested RCD thus satisfies the requirements of Article 4 CDR.

- 11 On 27 August 2009 the respondent submitted a response arguing as follows:
- The appearance of the figures in citations D 1 and D 2 is identical to that of the contested RCD. All of the features of the contested RCD can identically be found in citations D 1 and D 2.
 - As citations D 1 and D 2 are international patent applications, duly published in 1998 and 2003, respectively, they – including their figures and descriptions – were made available to the public within the meaning of Article 7(1) CDR. The figures and the descriptions define the appearance of a product, namely a drinking straw, and hence citations D 1 and D 2 are disclosing designs within the meaning of Article 3(a) CDR.
 - Furthermore, all of the contested RCD’s features are technical (Article 8 CDR).
 - Both the contested RCD and citations D 1 and D 2 belong to the appellant or a related company.
 - The contested RCD lacks both novelty and individual character. Both the contested RCD and citations D 1 and D 2 concern drinking straws constituted of a transparent elongated hollow cylinder partly filled with granules or pellets. The contested RCD does not produce a different overall impression from the previously known flavouring straws disclosed in citations D 1 and D 2.

Reasons

- 12 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.
- 13 Under Article 4(1) CDR, the conditions for the validity of a Community design are that it is new and has individual character. The contested RCD lacks both novelty and individual character in relation to the products pursuant to the figures contained in citations D 1 and D 2.
- 14 Novelty is defined by Article 5 CDR:
- ‘1. A design shall be considered to be new if no identical design has been made available to the public:
- (a) ...

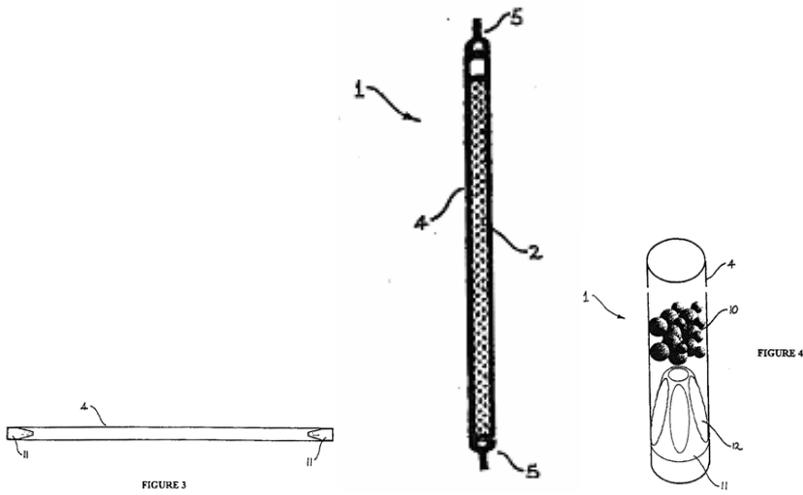
- (b) in the case of a registered Community design, before the date of filing of the application for registration of the design for which protection is claimed, or, if a priority is claimed, the date of priority.
 - 2. Designs shall be deemed to be identical if their features differ only in immaterial details.'
- 15 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.'
- 16 The contested RCD was declared invalid for lack of novelty on the ground that citations D 1 and D 2 are admissible, were made available to the public in the meaning of Article 7(1) CDR, define the appearance of a product, namely a drinking straw, and are thus disclosing designs in the meaning of Article 3(a) CDR and concern a drinking straw constituted of a transparent elongated hollow cylinder partly filled with granules or pellets identical to the design of the contested RCD.
- 17 The Board is therefore called upon to decide whether citations D 1 and D 2 disclose designs, were made available to the public before 14 October 2005 (the filing date of the contested RCD) and, if so, whether either of them is identical to the contested RCD in the sense that their features – if at all – differ only in immaterial details and whether they make the same overall impression on the informed user as the contested RCD, taking into account the freedom of the designer in developing the design.
- 18 The appellant challenges the admissibility of citations D 1 and D 2 on the ground that they neither disclose “designs” nor could reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community.
- 19 According to Article 3(a) CDR, for the purposes of the CDR, “design” means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.

- 20 According to Article 3(b) CDR, for the purposes of the CDR, “product” means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs.
- 21 It cannot be denied that the figures contained in a patent application can show the appearance of an industrial or handicraft item resulting from its features. The appellant’s submission that the technical solution offered by the patents of citations D 1 and D 2 may also be reached via products of different appearances from those depicted in the citations do not alter this fact. Citations D 1 and D 2 thus disclose designs within the meaning of Article 7(1) CDR.
- 22 The publication of the designs disclosed in citations D 1 and D 2 can also reasonably be expected to have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community.
- 23 The appellant has alleged that in the confectionery business it is unusual for products to be the subject of patent protection. This allegation has, however, by no means been substantiated by the appellant. Neither is it obvious. The products which are the subjects of citations D 1 and D 2 are entitled “method and apparatus for producing a flavoured beverage” and “drink flavouring straw”, respectively. They originate in the confectionery sector and thus show that patent protection is used by businesses in this sector.
- 24 The fact that the applicant and inventor of citations D 1 and D 2 is domiciled in Australia does not render it unreasonable to expect that they have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community. Citations D 1 and D 2 are international applications published under the Patent Cooperation Treaty (PCT) by the World Intellectual Property Organisation (WIPO) designating Member States of the Community. The Board takes the view that it belongs to the normal course of business of a confectionery company operating within the Community to monitor such publications as they are relevant for the territory in which they carry out their business activities.
- 25 The following designs must be compared:

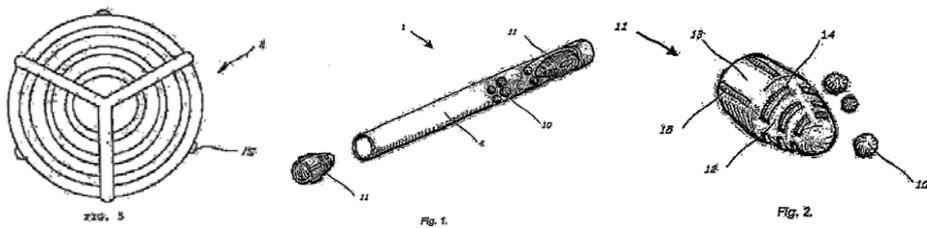
Contested RCD



Citation D 1



Citation D 2



- 26 The differences between the features of the contested RCD and those of the products pursuant to the figures contained in citations D 1 and D 2 do not go beyond immaterial details.
- 27 Both the contested RCD (entitled “drinking straws”) and the figures contained in citations D 1 (entitled “method and apparatus for producing a flavoured beverage”) and D 2 (entitled “drink flavouring straw”) show products with the following features: a transparent elongated hollow cylinder with filters at either end, each of which is conical in shape at one end with the cone pointing into the interior of the cylinder; the filters form end caps at either end of the cylinder and have a number of apertures; granules or pellets, which are roughly spherical in shape, are present and readily and individually discernible within the body of the cylinder.
- 28 The differences between the contested RCD and the products pursuant to the figures contained in citations D 1 and D 2 are limited to minor details of the structure and appearance of the end caps at either end of the cylinder. The end caps shown in the contested RCD are transparent. In citations D 1 and D 2, their colour or whether or not they are transparent can not be deduced from the figures contained therein. These differences are, however, of no material relevance to the appearance of the products at hand.
- 29 Neither does the overall impression produced on the informed user by the products pursuant to the figures contained in citations D 1 and D 2 differ from the overall impression produced on such a user by the contested RCD.
- 30 The informed user is an ordinary consumer who is familiar with straws and beverages for immediate consumption containing straws and will appreciate the functionality of a straw that contains ingredients to flavour a drink during the course of its consumption. Such a consumer will be aware that the designer’s freedom of design is fairly limited in relation to certain features of such products: an elongated hollow cylinder with filters at either end and containing a flavouring agent which allow the passage of the liquid to be flavoured through the cylinder. Small differences in such features might catch the informed user’s attention. However, in the contested RCD these features do not differ from those of the products pursuant to the figures contained in citations D 1 and D 2. In the area where the designer has greatest freedom – namely, the end caps of the straws – little use has been made of that freedom in relation to the appearance of the end caps of the straws pursuant to the figures contained in citations D 1 and D 2. The end caps, including the filters, of the contested RCD have essentially the same shape and configuration as in the products pursuant to the figures contained in citations D 1 and D 2.
- 31 The conclusion must be that the contested RCD lacks both novelty and individual character in relation to the products pursuant to the figures contained in citations D 1 and D 2 and must therefore be declared invalid.

Costs

- 32 Since the appeal has been unsuccessful, the appellant must be ordered to bear the fees and costs incurred by the respondent, in accordance with Article 70(1) CDR.

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the appellant to bear the fees and costs incurred by the respondent.**

Th. Margellos

M. Bra

D.T. Keeling

Registrar:

J. Pinkowski