



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

The Boards of Appeal

DECISION
of the Third Board of Appeal
of 12 July 2011

In Case R 1703/2010-3

Geobra Brandstätter GmbH & Co. KG

Postfach 12 60

DE-90511 Zirndorf

Germany

Invalidity Applicant / Appellant

represented by Rau, Schneck & Hübner, Königstr. 2, DE-90402 Nürnberg, Germany

v

Shantou Wanshun Toys Industrial Co., Ltd.

Shantou Chenghai Lianxia Town Yinxi

Liannan Industrial Park

Guangdong Province 515000

People's Republic of China

Design Holder / Respondent

represented by Luderschmidt, Schüler & Partner, John-F.-Kennedy-Str. 4,
DE-65189 Wiesbaden, Germany

APPEAL relating to Invalidity Proceedings No 7037 (registered Community design
No 573993-0004)

THE THIRD BOARD OF APPEAL

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

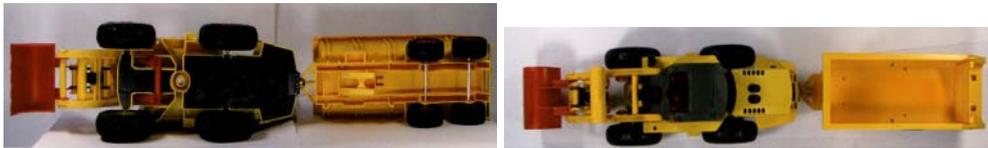
Registrar: P. López Fernández de Corres

gives the following

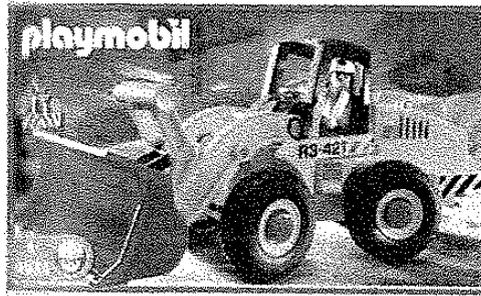
Decision

Summary of the facts

- 1 By an application filed on 8 August 2006, Shantou Wanshun Toys Industrial Co., Ltd. (hereinafter ‘the respondent’) sought to register the following design



- 2 The design was registered and published in the Community Designs Bulletin No 109/2006 of 26 September 2006.
- 3 On 13 October 2009 Geobra Brandstätter GmbH & Co. KG (hereinafter ‘the appellant’) filed an application for a declaration of invalidity against the contested RCD. The appellant requested the invalidation of the RCD based on Articles 4 to 9 CDR and other(s) according to Articles 25(1)(c), (d), (e), (f) or (g) CDR.
- 4 As evidence of the prior design the appellant submitted the following documents:
 - an excerpt from the book ‘PLAYMOBIL Collector 1974-2004’ (Evidence ‘D1’) including the following image of a product No 3934



- copy of the packaging of product No 3934;
- a written and signed statement and an English translation thereof of Mr Alexander Pitz from the Fantasia Verlag GmbH ('D2') in which it is stated that the 'date of first delivery' of the book 'Playmobil Collector 1974-2004' was 4 March 2004;
- a written and signed statement of Mr. Hans-Carl Rathjen in which it is stated that the product No 3934 has been put on the market in Germany in 2000 ('D3');
- invoices relating to the product No 3934 ('D4');
- Copy of the International registration No DM/051 462 published on 30 June 2000 ('D5') and containing the pictures reproduced below:



- 5 On 19 July 2010, the Invalidity Division issued a decision (hereinafter ‘the contested decision’) rejecting the application for a declaration of invalidity and ordering the appellant to bear the costs. It stated, in essence, the following:

Admissibility

- The ground for invalidity Article 25(1)(d) CDR indicated by the appellant is not admissible since the prior design, namely the International design registration No DM/051 462, has been made available to the public prior to the date of filing of the RCD.

Evidence

- D1 is a copy of the appellant’s catalogue, including the picture of a product No 3934 (of the prior design), and as such a publication addressed to the public. Therefore, D1 is evidence of the disclosure of the prior design within the meaning of Article 7(1) CDR
- D2, D3 and D4 are supporting the claim of the appellant that the model No 3934 has been made available to the public within the meaning of Article 7(1) CDR before the registration of the contested RCD.
- D5 is a certified copy of the International Design Registration addressed to the public. Therefore, D8 is a disclosure in the meaning of Article 7(1) CDR.

Novelty

- The contested RCD and the prior design disclosed in D1 differ *inter alia* in the following features:
 - in the RCD there is a trailer, absent in the prior design;
 - the lifting arm of the RCD is pointing downwards, whereas the lifting arm of the prior design is pointing upwards.
- The contested RCD and the prior design disclosed in D5 differ *inter alia* in the following features:
 - in the RCD there is a trailer, absent in the prior design;
 - the lifting arm of the RCD is pointing downwards, whereas the lifting arm of the prior design is pointing upwards;
 - the RCD is in colour whereas the prior design is in black and white.
- These differences are not immaterial details and thus the RCD is not identical to the prior design. Therefore, the evidence provided by the appellant does not form an obstacle to the novelty of the RCD within the meaning of Article 5 CDR.

Individual character

- The informed user is familiar with the basic features of the products to which the contested RCD relates, namely with toy vehicles in the form of vehicles used on construction sites, and of the existing design corpus available in the normal course of business. The informed user is aware of the shape that the toy vehicle in question must have and the requirement that toy vehicles of that type should generally resemble the vehicles present in daily life. Despite the aforementioned requirement the designer has a wide choice of colours, materials and ornamentations left.
- In the present case, the overall impression produced on the informed user by the contested RCD differs from the overall impression produced by the prior design disclosed in D1, in particular because the RCD includes a trailer absent in the prior design.
- The same applies to the prior design disclosed in D5. Furthermore, apart from not having a trailer D5 is in black and white.
- Therefore, the prior design does not form an obstacle to the individual character of the contested RCD.

Conclusion

- None of the facts and evidence provided by the appellant supports the invoked ground for invalidity of Article 25(1)(b) CDR.
 - Therefore, the application has to be rejected.
- 6 On 2 September 2010, the appellant filed a notice of appeal. The statement of grounds was received on 13 October 2010.
- 7 The respondent did not submit observations.

Submissions and arguments of the appellant

- 8 The appellant's arguments may be summarized as follows:

Preliminary remark

- On a formal issue, the applicant designated at first instance the attachments as D1, D2 etc. The Invalidity Division used the same format but used a different numbering for different items of evidence, which might lead to confusion. Hereinafter, the appellant refers to the numbering as it used at first instance.

Lack of individual character

- Reference is made to the evidence provided during the former proceedings, in particular D1 to D6. The contested decision correctly accepted those designs as disclosed within the meaning of Article 7(1) CDR.
- The contested decision incorrectly denied that there was the same overall impression.

(i) Comparison to D1/D2

- The RCD is in almost all features an identical copy of the product shown in D1 and D2. In particular, there is complete identity in:
 - The shape of the main body;
 - the motor at the back;
 - the cabin;
 - the wheels;
 - the lifting arm;
 - the lifting tool;
 - part of the black stripes at the side;
 - the colour of the main body (yellow);
 - the colour of the cabin (black);
 - the colour of the wheels yellow and red);
 - the colour of the lifting tool (red).
- There are the following differences, which do not change the same overall impression:
 - There is an additional trailer in the RCD. This is immaterial since it is only an additional object and it is banal in shape.
 - The parallel black lines in the earlier design are followed by the type number ‘R3-42T’, which does not appear in the RCD. This is immaterial because the user will consider the type number not to be part of the design. Also compared to the overall size of the product, the type number is only very small.

(ii) Comparison to D5

- For the reasons stated above, the RCD also produces the same overall impression as D5. Indeed the only difference between D5 and D1/D2 is that

D5 is in black and white. However, the mere addition of colour to a product such as the toy car in question does not change its overall impression for the reasons above. Also it should be noted that while D5 is in black and white, the shading is the same as in the RCD.

(iii) Reference to R 1337/2008-3

- The general standards applied by the Invalidity Division are not consistent with the case-law of the Board.
- Particular reference is made to decision R 1337/2008-3 of 16 March 2010 ‘REDUCERS’. In that decision the Board of Appeal clearly pointed out that the mere addition of a standard object to a protected design does not create an object that conveys a different overall impression.

Conflict with prior design

- The contested decision incorrectly denied that there was a conflict and that the grounds of appeal according to Article 25(1)(d) CDR were founded.
- The appellant is entitled to invoke the earlier right because it is the holder (Article 25(3) CDR).
- The International registration enjoys protection in the European Union that is in various countries within the European Union. Also according to Article (7)(a) Hague Act 1960 and Article 14(1), (2) Geneva Act 1999 an International design registration is deemed to have the same effect as a registered design right of a Member State.
- The International design registration has been protected from a date prior to the application date of the RCD.
- If Article 25(1)(d) CDR is taken literally, only prior designs can be invoked that have been made available to the public after the date of filing of the RCD. In the present case D9 was filed before the filing date of the RCD. However, in the view of the appellant, Article 25(1)(d) CDR is to be interpreted to read ‘...even if it has been made available to the public after the date of filing’. This is for the following reasons:
 - The Board of Appeal has stated in its decision of 18 March 2009 R 608/2008-3 that in the case before it the invalidity ground of Article 25(1)(d) CDR was given (even though the earlier design right had been published before the filing date of the RCD in question); it could only not be invoked for procedural reasons.
 - The wording of Article 25(1)(d) CDR is flexible enough to be interpreted as suggested by the appellant. Generally, provisions of Community law are open to purposive construction. By way of example, Article (4)(a) and Article 5(2) of the Council Directive 89/14/EEC relate to trade marks registered or used for goods or

services that are not similar those for which the earlier trade mark is registered. Nevertheless, the Court states that those provisions also relate to the registration or use of trade marks for goods and services that are indeed identical with or similar to those of the registered trade mark (see, amongst others, judgment of 9 January 2003, C-292/00, 'Davidoff').

- It would be a contradiction if a right that has not yet been published would give the right holder better chances in invalidity proceedings as a right that has already been published. Against this argument one cannot claim that the holder of an earlier right need not rely on Article 25(1)(d) CDR because it can easily rely on Article 25(1)(b) CDR. That counter-argument would only be valid if the term 'conflict' in Article 25(1)(d) CDR would mean, and only mean, to convey the same overall impression with the meaning of Article 6 CDR. This is, however, not the case. The Invalidity Division has held that a 'conflict' within the meaning of Article 25(1)(d) CDR can also arise if the contested RCD falls within the scope of protection of the earlier right. The Board of Appeal has taken the same view (see decision of 3 November 2007, R 115/207-3, 'BOTELLAS PARA COSMETICOS'). There are cases where the contested RCD may have individual character with regard to the earlier design right but still fall within the scope of protection of the earlier design right. This is the case, for example, where the contested RCD shows a combination of products one of which has been protected by an earlier design right.
- The view of the appellant is also supported by the fact that Article 25(1)(e), (f) and (g) CDR does not contain any restriction with regard to the date of publication of the earlier right. There appears to be no reason why an earlier design right should have less impact in invalidity proceedings than an earlier trade mark, copyright or other right.
- The view of the appellant is also supported by the wording of Article 85(1) third sentence. This is because if a design right that has been published before the priority date of the RCD could not be the basis for a plea (rather than a counter claim) of invalidity, the holder of such an earlier right should be, without any valid reason, in a worse position than a holder of an earlier right that had not been published at the priority date of the RCD.
- The view of the appellant is also supported by the fact that Article 19(1) CDR conveys to the owner of a registered design a positive right to use and that the same is true for national designs by virtue of Article 12 of Council Directive 98/71/EC. It would be a contradiction if a party holds an RCD conveying a right to use, while the use of the same RCD infringes an earlier design right.
- The view of the appellant is also supported by the fact that Article 19(1) CDR prohibits any 'use' of a registered Community

Design and that the same is true for national designs by virtue of Article 12 of Council Directive 98/71/EC. The term ‘use’ is broad enough to include any publication, by another party, of a protected design contravenes the legal interest of the right holder. This must also be taken into account when interpreting Article 25(1)(d) CDR.

- The view of the appellant is also supported by the wording of Article 110a(4) CDR because the right to prohibit the use of an RCD in a new Member State on the basis of an earlier national design right can obviously not be made dependent on whether the earlier national design right has been published or not at the date of accession. While referring to Article 25(1)(d) CDR, Article 110a(3) CDR obviously confirms that the earlier design right need not be published after the priority date of the RCD.
- The General Court in its judgement of 18 March 2010, T-9/07, ‘Metal rappers’ also deals with the interpretation of Article 25(1)(d) CDR. In this case, the prior design had been filed before the contested design but published thereafter. In the case at hand, the protected design was published before the contested design. However, the decision by the General Court is also relevant for the present case for at least two reasons:
 - The General Court explicitly decided that the term ‘conflict’ within the meaning of that provision means that there is a conflict whenever the later design does not create a different overall impression as the earlier design within the meaning of Article 10 CDR. Conversely, the General Court did not decide that the standard was the same as in Article 6 CDR. Both articles are phrased in very similar words. However, there is a considerable difference between the application of both provisions when only a part of the contested design is identical to or creates the same impression as the earlier design. If the General Court thought that in a situation where only a part of the contested design created the same overall impression as the earlier design, Article 25(1)(d) CDR was not applicable, the General Court would have applied the standards of Article 6 CDR instead of Article 10 CDR.
 - The General Court explicitly pointed out the importance that it is ensured

‘that the rights of the proprietor of a prior design that is referred to in that provision is protected against any infringement of the design resulting from the coexistence of a subsequent Community design that produces the same overall impression on the informed user’

This makes it clear that according to its rationale, Article 25(1)(d) CDR must obviously also apply even if the earlier design has been published before the contested design. There is absolutely no reason why a protected earlier design should not be protected ‘against any infringement of the design resulting from the coexistence of a subsequent Community design’ only if the protected design has, by

pure coincidence, been published after the application date of the contested design.

- Article 25(1)(d) CDR has been phrased the same as Article 11(1)(d) of the Council Directive 98/71/EC. The German legislator is convinced that the implementing provision, paragraph 34, number 3 of the German Law on Design correctly implements Article 11 (1)(d) of Council Directive 98/71/EC. Therefore, there is a ‘conflict’ (at least) if the later design falls within the scope of design protection, even if the earlier design has been published after the filing date of the later design.
- It appears that the question at hand has not been dealt with in detail by the judiciary.
- In summary, the term ‘conflict’ is to be interpreted to the effect that there is (at least) a conflict if the contested RCD falls within the scope of protection of the earlier right i.e. as in D9 for any of the European Union countries concerned which is determined by the national provisions. In the present case, D5 has been registered in black and white. When comparing D5 and the contested RCD according to Article 9 of the Council Directive 98/71/EC, it is necessary to ignore the colours of the RCD. Since D5 does not contain shading, the shading of the contested RCD may be maintained. Therefore, only the shape and shading of the products are to be compared. There is a conflict with Article 25 (1)(d) even if a part of a RCD falls within the scope of an earlier design right. The products to be compared is the product D5 and the car element in the RCD (without the additional trailer). Those products are identical and, in any event, convey the same overall impression.
- Contrary to Article 62, first sentence, CDR, the contested decision does not state the reasons on which it is based with regard to the ground for invalidity according to Article 25(1)(d) CDR. In that regard, the contested decision only states that the prior design ‘has been made available to the public prior to the filing date of the RCD’. In the light of the substantive arguments submitted by the appellant at first instance, this is not sufficient as a statement of reasons on which the decision has been based.

Reasons

- 9 The appeal complies with Articles 55 to 57 CDR and Article 34(1)(c) and (2) CDIR. It is therefore admissible.

The admissibility of the claim under Article 25(1)(d) CDR

- 10 In the application for a declaration of invalidity of a registered Community Design and in its statement of grounds, the appellant mentioned expressly as ground of appeal Article 25(1)(d) which provides that:

‘A Community design may be declared invalid...:

...d) if the Community design is in conflict with a prior design which has been made available to the public after the date of filing of the application or, if a priority is claimed, the date of priority of the Community design, and which is protected from a date prior to the said date by a registered Community design or an application for such a design, or by a registered design right of a Member State, or by an application for such right.'

- 11 The contested decision stated that the ground for invalidity, Article 25(1)(d) CDR indicated by the appellant, is not admissible since the prior design, namely the International design registration No DM/051 462, has been made available to the public *prior* to the date of filing of the RCD. The appellant has given extensive arguments to refute this interpretation.
- 12 The Board observes that Article 25(1)(d) CDR must not be interpreted solely on the basis of its wording, but also in the light of the overall scheme and objectives of the system of which it is a part (see, by analogy, judgment of 9 January 2003, C-292/00, 'Davidoff', para. 24).
- 13 Having regard to the latter aspects, that article cannot be given an interpretation which would lead to prior designs which have been made available to the public prior to the date of filing of the application of the CDR (or, if a priority is claimed, the date of priority of the CDR) having less protection than prior designs which have been made available to the public after the date of filing of the application of the CDR (or, if a priority is claimed, the date of priority of the CDR). A prior design which has been made available to the public prior to the date of filing of the application of the CDR (or, if a priority is claimed, the date of priority of the CDR) must enjoy protection which is at least as extensive as a prior design which has been made available to the public after the date of filing of the application of the CDR (or, if a priority is claimed, the date of priority of the CDR).
- 14 In those circumstances the Board comes to the conclusion that Article 25(1)(d) CDR is to be interpreted as providing specific protection for prior designs also in cases where the prior design has been made available to the public prior to the date of filing of the application of the CDR (or, if a priority is claimed, the date of priority of the CDR).
- 15 The contested decision did not make a comparison of the designs based on the claim made under Article 25(1)(d) CDR. However, according to the second sentence of Article 60(1) CDR, the Board may either remit the case to the department responsible for the decision appealed for further prosecution or exercise any power within the competence of that department. For reasons of procedural economy, given that both parties have had the opportunity to present arguments during the invalidity and appeal proceedings on the claim under Article 25(1)(d), the Board is of the view that it should proceed to decide whether Article 25(1)(d) CDR is applicable to the case at hand.
- 16 Therefore the Board will begin by making the comparison based on the International design registration No DM/051 462, which includes the design shown below, which was registered on 3 March 2000, claiming priority of an

earlier German application filed on 20 September 1999, published on June 30 2000 and renewed on 3 March 2005, and which is therefore to be considered a prior design in accordance with Article 25(1)(d) CDR which has been made available to the public prior to the date of filing of the RCD.



The comparison of the conflicting designs under Article 25(1)(d) CTMR

- 17 The Board notes that the contested RCD and the prior design differ in particular because the RCD includes a trailer absent in the prior design and the lifting tool of the RCD is pointing downwards, whereas the lifting tool of the prior design is pointing upwards. In the prior design the parallel black lines on the side of the toy vehicle are followed by the type number 'R3-42T', which does not appear in the RCD.
- 18 The prior right has been registered in black and white and the comparison with the contested RCD must therefore proceed on the basis of the assumption that the prior right is intended to be used in different colour schemes (see, by analogy, decision of 2 December 2009, R 1130/2008-3, 'Watches', para. 20, decision upheld in judgment of 14 June 2011, T-68/10, 'Montres').
- 19 As to the main body of the toy vehicle, the Board finds no differences between the RCD and the prior design, except for the fact that in the prior design the parallel black lines on the side of the toy vehicle are followed by the type number 'R3-42T', which does not appear in the RCD. The Board agrees with the appellant that this is immaterial because the user will consider the type number not to be part of the design. For the rest, they are identical.
- 20 As to the fact that the lifting tool of the RCD is pointing downwards, whereas the lifting tool of the prior design is pointing upwards, the Board finds this factor also to be immaterial. Importance must also be given to the manner in which the product at issue is used and it seems more than probable that the lifting tool of the toy vehicle can be 'clipped-on' either way, that is pointing downwards, or pointing upwards.

- 21 In such a case the RCD must be considered to be in conflict with the prior design, because it falls within the scope of protection of the earlier right, notwithstanding the fact that it contains notable additional elements. The RCD consists of a design in which the prior design has been incorporated in all its relevant elements.
- 22 It follows from all the above considerations that the contested decision erred in finding that the claim under Article 25(1)(d) CDR was inadmissible and that therefore the designs at issue were not in conflict within the meaning of Article 25(1)(d) CDR.
- 23 Furthermore, the RCD is also invalid due to the following reasons.

Novelty and individual character

- 24 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. A design is deemed to have been made available to the public if it has been published, exhibited, used in trade or otherwise disclosed, 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.
- 25 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.’

- 26 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.’

- 27 The issue therefore is whether the designs are identical, barring immaterial details, (lack of novelty under Article 5 CDR) or whether they produce the same overall impression on the informed user, taking into consideration the designer’s degree of freedom in developing the design (lack of individual character under Article 6 CDR).

The earlier designs and their divulgation

- 28 The allegation that the prior designs have been made available to the public before the date of application of the contested RCD and may thus be regarded as earlier designs within the meaning of Article 7 CDR has not been contested and is endorsed by the Board.

Lack of novelty

- 29 Although the contested decision is contested in its entirety, the appellant clarifies in its statement of grounds that as far as the appeal is based on Article 25(1)(b), it is based in particular on lack of individual character. Therefore it is sufficient to note that the Board endorses the conclusion of the contested decision that the prior designs and the contested RCD are not identical within the meaning of Article 5 CDR (lack of novelty) because there are differences between the designs which cannot be considered immaterial details.

The informed user

- 30 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).
- 31 With regard to the interpretation of the concept of informed user, 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 judgment of 22 June 2010, T-153/08, ‘Communications equipment’, para. 46).
- 32 The informed user is neither a designer, a technical expert, 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. The informed user is particularly observant and has some awareness of the state of the prior art, that is to say the previous designs relating to the product in question that had been disclosed on the date of filing of the contested design, or, as the case may be, on the date of priority claimed (see judgments of 18 March 2010, T-9/07, ‘Metal rappers’, para. 62; of 22 June 2010, T-153/08, ‘Communications equipment’, para. 47 and of 14 June 2011, T-68/10, ‘Montres’, para. 51).

- 33 In the case at hand, as the product in question is a toy vehicle and therefore the informed user could be a child approximately between the age of 4 to 9 or an adult who buys the toy vehicle for a child. However, it makes little difference whether the informed user is a child approximately between the age of 4 to 9 or an adult; the important point is that both those categories of person are familiar with the product at the level indicated in the previous paragraph above (see, by analogy, judgments of 18 March 2010, T-9/07, ‘Metal rappers’, para. 65).

The designer’s degree of freedom in developing his design

- 34 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 (see judgment of 18 March 2010, T-9/07, ‘Metal rappers’, para. 67).
- 35 The contested decision found that the freedom of the designer is limited by the requirement that toy vehicles of this type should generally resemble the vehicles present in daily life. Despite this requirement the designer has a wide choice of colours, materials and ornamentations left. The Board agrees with this assessment, which has not been disputed.

Overall impression of the conflicting designs

- 36 The Board agrees with the contested decision that the contested RCD and the prior designs differ in particular because the RCD includes a trailer absent in the prior designs. The Board notes that they differ also in the following features:
- In the prior design the parallel black lines on the side of the toy vehicle are followed by the type number ‘R3-42T’, which does not appear in the RCD.
 - The lifting tool of the RCD is pointing downwards, whereas the lifting tool of the prior design is pointing upwards.
- 37 For the rest, in the view of the Board, the contested RCD and the prior designs are identical, this including *inter alia* the following elements:
- The shape of the main body;
 - the motor at the back;
 - the cabin;
 - the wheels;
 - the lifting arm;
 - the lifting tool;
 - part of the black stripes at the side;

- the colour of the main body (yellow);
 - the colour of the cabin (black);
 - the colour of the wheels (yellow and red);
 - the colour of the lifting tool (red).
- 38 As to the fact that the prior right indicated as D5 has been registered in black and white, the comparison with the contested RCD must therefore be made on the basis of the assumption that the prior right is intended to be used in different colour schemes (see, by analogy, decision of 2 December 2009, R 1130/2008-3, ‘Watches’, para. 20, decision upheld in judgment of 14 June 2011, T-68/10, ‘Montres’).
- 39 In the absence of any specific constraint imposed on the designer, except for the rather minor one mentioned in paragraph 35 above, the identical elements noted in paragraph 37 above all relate to elements in respect of which the designer was free to develop the contested design. All of these identical elements are very noticeable in the overall impression of the designs and will attract the informed user’s attention.
- 40 In the opinion of the Board, the fact that the contested RCD contains, without taking into account the additional trailer, only the very slight differences mentioned in paragraph 36 above is considerably less striking than the overall impression given by the numerous identical elements mentioned in paragraph 37 above. The designs are almost identical and the slight differences are hardly noticeable.
- 41 The only relevant difference between the designs at issue concerns the fact that the contested RCD also contains a trailer, which is not present in the previous designs. The contested decision concluded that the overall impression produced on the informed user by the contested RCD differs from the overall impression produced by the prior designs, in particular because the RCD includes a trailer absent in the prior designs, without mentioning any other notable differences.
- 42 The Board cannot endorse this reasoning because it appears to lend legitimacy to the integral reproduction of an existing design, with the sole proviso that some other component customarily used in combination with the product in question be added, for example a rim provided with a tyre. In the case at hand the prior design is easily discernible in the RCD. The trailer is a feature that the respondent added to the earlier version of the toy vehicle. Even though the trailer has thus become an element of the design of the toy vehicle, it is a relatively marginal one, in the sense that the toy vehicle – with or without the trailer – produces on the informed user the same overall impression. The informed user will perceive the trailer for what it clearly is: an accessory. The accessory character of the trailer is well demonstrated by the fact that it is not a fixed element but one that can be easily separated from the main product. The trailer is, in fact, an optional accessory i.e. something that anybody playing with the toy may decide to use or not and it may hardly be recognised as ‘a significant part of the design’ (see also decision of 26 March 2010, R 9/2008-3, ‘Footwear’, paras 102 and 103).

- 43 Therefore, the Board takes the view that the contested design inevitably creates the same overall impression on informed users as the prior designs, since it reproduces all the essential characteristics of the latter and, in order to differentiate itself, in addition to making only very slight and hardly noticeable variations, simply adds another component – a trailer – which can be usually coupled to this type of product in the course of the latter’s customary usage (see also decision of 16 March 2010, R 337/2008-3, ‘Reductores’, para. 15).
- 44 Further, the overall impression produced by a design on the informed user must necessarily be determined also in the light of the manner in which the product at issue is used (see judgments of 22 June 2010, T-153/08, ‘Communications equipment’, para. 66 and of 14 June 2011, T-68/10, ‘Montres’, para. 78). The Board notes that the person using the product would usually be a child at play and that the truck and the trailer in the contested design can easily be separated from each other and used as two separate toys, or they could even be sold separately. This factor also decreases the importance that can be given to the additional component for the evaluation of the overall impression.
- 45 The same applies to the fact that the lifting tool of the RCD is pointing downwards, whereas the lifting tool of the prior design is pointing upwards. As importance must also be given to the manner in which the product at issue is used and it seems more than probable that the lifting tool of the toy vehicle can be ‘clipped-on’ either way, that is pointing downwards, or pointing upwards, this factor can only be qualified as immaterial.
- 46 It follows from all the above considerations that the contested decision erred in finding that the designs at issue produced a different overall impression on the informed user and that they were not in conflict within the meaning of Article 25(1)(b) CDR.

Conclusion

- 47 It follows from all the above considerations that the contested decision erred in finding that the claim under Article 25(1)(d) CDR was inadmissible and that therefore the designs at issue were not in conflict within the meaning of Article 25(1)(d) CDR. On the contrary, for the reasons given above, the RCD is to be declared invalid based on Article 25(1)(d) CDR. In addition, the contested decision erred in finding that the designs at issue produced a different overall impression on the informed user and that they were not in conflict within the meaning of Article 25(1)(b) CDR. Therefore, the RCD is invalid based on Article 25(1)(b) CDR as well.
- 48 Accordingly, the appeal must be upheld, the contested decision annulled and the contested RCD declared invalid.

Costs

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

Order

On those grounds,

THE BOARD

hereby:

- 1. Annuls the contested decision;**
- 2. Declares the contested RCD invalid;**
- 3. Orders the respondent to bear the fees and costs incurred by the appellant.**

Th. Margellos

H. Salmi

C. Rusconi

Registrar:

P. López Fernández de Corres