



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

The Boards of Appeal

**DECISION
of the Third Board of Appeal
of 30 June 2009**

In Case R 1524/2007-3

SIACO - Soc. Ind. Com.de Art P/CALÇADO, SA

Rua Comb. Ultramar, 152

Zona Industrial 1

P-3700-089 S. João da Madeira

Portugal

Invalidity applicant / Appellant

represented by J. PEREIRA DA CRUZ, S.A., Rua Vitor Cordon, 14, P-1249-103,
Lisboa, Portugal

v

**VAPESOL-FÁBRICA DE COMPONENTES PARA CALÇADO,
UNIPESOAL, LDA**

Devesa Escura - Revinhade

P-4650-373 Felgueiras

Portugal

Design proprietor / Respondent

represented by ARLINDO DE SOUSA, LDA, Rua de Sá da Bandeira, 706 - 2º. Esqº,
P-4000-432, Porto, Portugal

APPEAL relating to Invalidity Proceedings No 3622 (registered Community design
No 000638309-0001)

THE THIRD BOARD OF APPEAL

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

Registrar: J. Pinkowski

gives the following

Decision

Summary of the facts

- 1 By application received on 15 December 2006 VAPESOL – FÁBRICA DE COMPONENTES PARA CALÇADO UNIPESSOAL, LDA (hereinafter, the design proprietor) sought to register a Community Design as represented hereunder



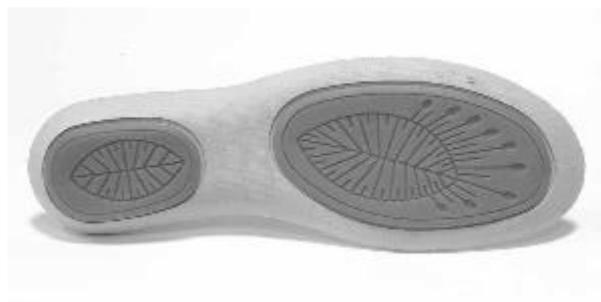
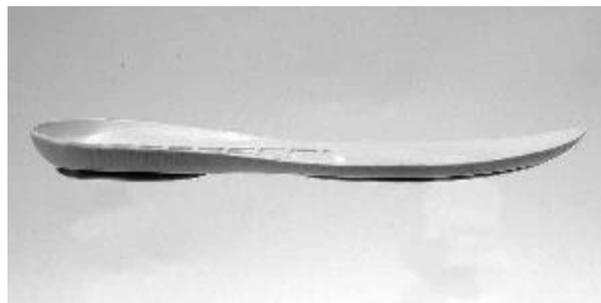
in respect of the following product:

‘Soles for footwear’.

- 2 The Community Design was registered under No 000638309-0001 and published in the Bulletin No 2007/005 of 16 January 2007.
- 3 By application received on 5 February 2007 Siaco – Soc. Ind. Com. de Art P/CALÇADO, LDA, (hereinafter, the invalidity applicant) sought a decision whereby the Office declares the invalidity of the Community Design (hereinafter, the contested design). The applicant ticked, on the application for invalidity form, boxes corresponding to the following grounds of invalidity:
 - Article 25(1)(b),
 - Article 25(1)(c), (d), (e), (f) or (g).
- 4 In the explanation of grounds the applicant claimed that contested design is invalid pursuant to Article 25(1)(b) and (d) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs (‘CDR’) (OJ EC 2002 No L 3, p 1).
- 5 In the statement of grounds attached to the application, the applicant underlines that the contested design ‘is a copy of the earlier design’ protected by Community

Design registration no. 000615075-0001, filed on 2 November 2006 and published on 21 November 2006.

- 6 The contested design presents an ‘identical design structure, contours, lines, texture and identical ornamental elements’ when compared with the earlier design. For these reasons the contested design should be declared invalid.
- 7 As evidence of invalidity of the contested design, the invalidity applicant provided the following documents:
 - a copy of its earlier design registered for ‘Soles for footwear’



- a copy of a ‘technical opinion’ (in Portuguese) elaborated by Centro Tecnológico do Calçado de Portugal, (an official body – a technological institution for Portuguese Footwear support).
- 8 The design proprietor replies that the prior design is no obstacle for the novelty and individual character of the RCD. Furthermore, it observes that the ‘technical opinion’ was not submitted in the language of the proceedings.
 - 9 By decision of 24 July 2007 (hereinafter, the contested decision) the Invalidity Division rejected the application for invalidity. The contents of the decision are the following:

On admissibility

- a. The request to declare the RCD invalid based on Article 25(1)(d) CDR is not taken into consideration, ‘because this invalidity ground does not apply, as the prior design has been made available to the public before the filing date of RCD’.

On novelty

- b. According to Article 5 CDR the Registered Community Design lacks novelty when an identical design has been made available to the public prior to the date of filing of the Registered Community Design. Designs shall be deemed to be identical if their features differ only in immaterial details.
- c. The two designs show a different decorative pattern of soles for shoes. Both designs have a similar longish and rounded form which is derived from the natural form of a foot: The front part is broader than the back part. On the upper side both soles show a lattice-like structure. The underside of the sole has two elliptical areas which are both framed. In these areas there are different decorative patterns: the contested design shows an unsystematic arrangement of longish leaves. In contrast, the prior design shows a pattern which appears to symbolize a single leaves. The pattern of the prior design and the decorative leaf of the contested design are very different in appearance.
- d. The decorative pattern on the sole is not an immaterial detail. Therefore, the two designs having different decorative patterns are not identical within the meaning of Article 5 CDR;

On individual character

- e. For the same reason the earlier design does not deprive the Contested Design of individual character.
- f. According to Article 6 CDR a design has an individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any prior design which has been made available to the public.
- g. The informed user is familiar with the design of soles and their variety on the marketplace. It is aware that the degree of freedom of a designer concerned with such soles is limited by their function in so far as the sole is the lower part of a shoe and therefore it should allow safe walking and stability for the foot.
- h. The overall impression produced on the informed user by the contested design differs from the overall impression produced by the prior design. The informed user knows the standardized form of soles and therefore recognizes in particular the significant difference regarding the decorative patterns of the two sections of each design.

- 10 The invalidity applicant filed an appeal on 21 September 2007 followed by the statement of grounds on 26 November 2007. The design proprietor responded on 4 February 2008.

Grounds of appeal

- 11 The invalidity applicant requests annulment of the contested decision and a ruling that the contested design is declared invalid because it infringes Article 25(1)(d).
- 12 The grounds of appeal are only based on Article 25(1)(d) of CDR:
- a. The application for Declaration of Invalidity was based on ‘infringement’ of Community Design no. 000615075-0001 registered in the name of appellant;
 - b. It is unquestionable that the RCD No 000615075-0001 of the appellant has priority over RCD No 000638309-0001;
 - c. The fundamental question is therefore to assess whether the similarities between the two designs are sufficient for declaring the invalidity of the more recent community design. In this regard, the appellant considers that there are grounds for invalidity;
 - d. The case at issue involves two RCDs which represent exactly the same type of product – soles for footwear;
 - e. As soon as the appellant learnt of the commercialization of the soles by the applicant, it requested an independent entity in the footwear sector – Centro Tecnológico do Calçado de Portugal (CTCP) – to carry out a study of the two soles protected by RCD Nos 000615075-0001 and 000638309-0001;
 - f. In the report drawn up by CTCP, an English version of which is attached hereto as Document no. 1, the RCD of the appellant is identified as the sole CACHOU and the contested design of the applicant as the sole NEI;
 - g. The technical opinion covers two aspects:
 - i. evaluation in terms of their shape,
 - ii. evaluation in terms of their aesthetic characteristics;
 - h. Regarding the evaluation in terms of their shape, 13 characteristics were detected for the CACHOU sole;
 - i. Identical characteristics were detected for the NEI sole;
 - j. This means that these are soles displaying *lines, contours and form* which are exactly the same;

- k. With regard to the aesthetic characteristics, eight aspects were detected for the CACHOU sole, seven of which are also present in the NEI sole;
 - l. This means that of a total 21 characteristics in terms of shape and aesthetic characteristics, the soles in question present 20 identical characteristics, differing only in respect of the decorative patterns on the bottom of the soles;
 - m. In the case of the CACHOU sole the 'leaf of a plant with nervures' is used;
 - n. In the case of NEI sole, which also displays floral characteristics, the decorative pattern takes the form of 'small floral branches';
 - o. Although the designs used on each of the soles are different, the appellant considers that the soles display a high degree of similarity;
 - p. This high degree of similarity 'produces the impression' of two design soles belonging to the same collection, designed by the same creator, who developed a variation on the initial model;
 - q. The requirements laid down in Article 25(1)(d) of the Community Design Regulation are duly met, meaning that the invalidity of RCD No 000638309-0001 must be declared.
- 13 The design proprietor responded that the appeal should be dismissed for following reasons:
- 14 Article 25(1)(d) does not apply in the present case as the said article refers exclusively to cases in which the divulgation of the design protected in the first place was divulged only after the filing of the application for the registration of the registered design which is the object of the application for the declaration of invalidity.
- 15 Since the sole ground on which the appellant founds its appeal does not apply to the present case, the said appeal must be dismissed.
- 16 According to Article 63(1) of CDR, in applications for a declaration of invalidity – and also in the respective appeals as provided for under the provisions of the said Article 3(1) of the IRC DR – examination is limited to the facts and arguments provided by the parties.
- 17 The 'technical opinion' was not submitted in the language of proceedings and for this reason should be declared inadmissible.

Reasons

- 18 The appeal complies with Articles 56 and 57 CDR and Article 34 of Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council

Regulation (EC) No 6/2002 on Community designs ('CDIR')(OJ EC L 341, 17.12.2002, p. 28–53). It is therefore admissible.

- 19 The indication and the reproduction of the earlier design is unable to support the claim that the contested design lacks individual character within the meaning of Article 6 CDR or novelty within the meaning of Article 5 CDR. As a result, the contested decision is maintained.
- 20 In the notice of appeal is mentioned as object of present appeal 'Design Invalidity Decision'.
- 21 In the 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;

- 22 The appeal is not well founded. The provisions of Article 25(1)(d) are not applicable in the present case because the earlier design has been made available before (not 'after', as the norm requires) the date of filing of the application of contested design.
- 23 The Grounds of invalidity according to the invalidity application form were:
 - a. Article 25(1)(b)
 - b. Article 25(1)(c)
 - c. Article 25(1)(d)
 - d. Article 25(1)(e)
 - e. Article 25(1)(f)
 - f. Article 25(1)(g)

The Board, for completeness sake, will examine them one by one.

- 24 As already stated, Article 25(1)(d) is not applicable.
- 25 Article 25(1)(c) states 'if, by virtue of a court decision, the right holder is not entitled to the Community design under Article 14'; in the present case, the appellant did not present any court decision of this kind before the Office. For this reason this ground does not apply.
- 26 Pursuant to Article 25(1)(e) 'if a distinctive sign is used in a subsequent design, and Community law or the law of the Member States governing the sign confers on the right holder of the sign the right to prohibit such use;' in the present case the appellant did not prove that the earlier design contains a trade mark or other

distinctive sign which constitutes its prior rights. For this reason this ground also does not apply.

- 27 According to Article 25(1)(f) ‘if the design constitutes an unauthorized use of a work protected under the copyright law in a Member State;’ in the present case no proof exists that the earlier design is protected under copyright law. For this reason this ground also does not apply.
- 28 In compliance with Article 25(1)(g) ‘if the design constitutes an improper use of any of the items listed in Article 6ter of the Paris Convention, or of badges, emblems and escutcheons other than those covered by the said Article 6ter and which are of particular public interest in a member State;’ in the present case, the appellant did not present any proof of this kind before the Office. For this reason this ground does not apply.
- 29 As the appellant, in the statement of grounds, claimed ‘Decision no. ICD/3622 on 24th July’ as a grounds of appeal, the Board will also consider the appeal on the basis on Article 25(1)(b).
- 30 Article 25(1)(b) states that:

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

...b) if it does not fulfill the requirements of Articles 4 to 9;’

Novelty

- 31 According to Article 5 CDR the RCD lacks novelty when an identical design has been made available to the public prior to the date of filing of the contested design. Designs shall be deemed to be identical if their features differ only in immaterial details. When assessing novelty and/or individual character, then RCD must be compared with each prior design individually.
- 32 The contested design and earlier design both concern soles for shoes. Both designs have a similar ‘longish’ and ‘rounded’ form which stems from the natural form of the foot (the front part is broader than the back part and even on the upper side both soles show a lattice-like structure). The underside of the sole has two elliptical areas which are both framed. In these areas you can find different decorative patterns: the contested design shows an unsystematic arrangement of longish leafs. In contrast, the earlier design shows a pattern which appears to symbolize a single leaf. The pattern of the earlier design and the decorative leaf of the contested design are very different in appearance.
- 33 The differences between the earlier design and the contested design are not just immaterial details. Therefore, the earlier design and the contested design are not identical within the meaning of Article 5 CDR.

Individual character

34 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:

...

- (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.'

35 The informed user is familiar with the design of soles for shoes and their variety on the marketplace. He is aware that the degree of freedom of a designer concerned with the design of such soles is limited by their technical function in so far as the sole is the lower part of a shoe and therefore it should facilitate the act of walking and provide stability for the foot.

36 In the present case, the overall impression produced on the informed user by the contested design differs. The informed user knows the standardised form of soles and therefore recognizes in particular the significant differences regarding the decorative pattern of the two sections of each design.

37 Therefore, the earlier design does not form an obstacle to the individual character of the RCD.

38 The Board finds that the contested design and the earlier design show an identical arrangement of components – two oval parts on a surface which is a sole. It must be noted in this regard that the two oval parts contain a different design with a different motif, i.e. decorative pattern.

39 Furthermore, the Board notes that both the soles have the same shape and that both oval parts of the soles are placed in the same way, nevertheless the decorative pattern of the sole plays a very significant role in the overall impression of the designed product.

40 The Board agrees with the contested decision that the decorative patterns are not identical in the two designs and therefore do not produce the same overall impression.

41 Another important factor in the assessment of individual character is the degree of freedom that professionals in the field of footwear design have (Article 6 (2) CDR). It must be underlined, in this respect, that the two designs concern products having a functional content. The soles will be used for (attached to) shoes and the function is that of providing a cushion for the foot.

- 42 The high degree of freedom that designers enjoy when designing footwear, allows for the decorative pattern to be different, while the shapes of the soles of shoes might be the same because of its functional purpose (the technical function being to protect the foot).
- 43 For the above reasons, the appeal is dismissed and the contested decision is maintained.

Costs

- 44 Since the appeal has been unsuccessful, the invalidity applicant must be ordered to bear the costs incurred by the design 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 costs incurred by the design proprietor.**

Th. Margellos

C. Rusconi

H. Salmi

Registrar:

J. Pinkowski