



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

The Boards of Appeal

**DECISION**  
**of the Third Board of Appeal**  
**of 8 October 2007**

In case R 1337/2006-3

**Honda Giken Kogyo Kabushiki Kaisha (also trading as Honda Motor Co., Ltd.)**

No.1-1, Minami-aoyama 2-chome, Minato-ku

Tokyo 107-8556

Japan

Invalidity Applicant/Appellant

represented by ROSPATT OSTEN PROSS, Kaiser-Friedrich-Ring 56, 40547  
Düsseldorf, Germany

v

**KWANG YANG MOTOR CO., LTD.**

35 Wan Hsing Street

San Min District

Kaohsiung City

Taiwan

RCD proprietor/Respondent

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

APPEAL relating to Invalidity Proceedings No ICD 990 (Registered Community  
Design No 000 163 290 - 0001)

THE THIRD BOARD OF APPEAL

composed of Th. Margellos (Chairperson), C. Rusconi (Rapporteur) and I. Mayer  
(Member)

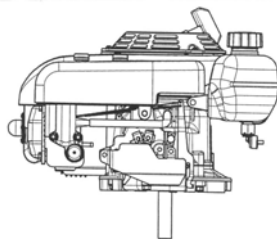
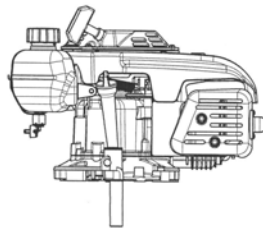
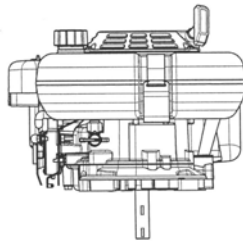
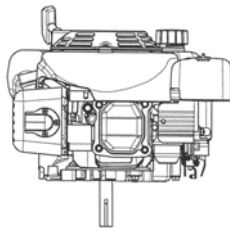
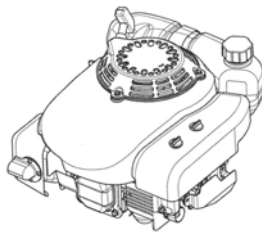
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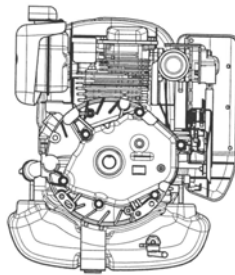
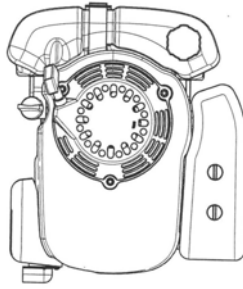
gives the following

## Decision

### Summary of the facts

- 1 By application received on 13 April 2004 Kwang Yang Motor Co., Ltd. (hereinafter, the RCD proprietor) sought to register a Community Design whose seven views are represented hereunder





in respect of the following product:

*'Internal-combustion engine'*.

- 2 The Community Design was registered under No 000 163 290-0001 and published in the Bulletin of 29 June 2004.
- 3 By application received on 17 May 2005 Honda Giken Kogyo Kabushiki Kaisha, also trading as Honda Motor Co., Ltd., (hereinafter, the invalidity applicant) seeks a decision whereby the Office declares the invalidity of the Community Design (hereinafter, the Challenged Design) on the ground that it does not fulfill the requirements of Article 4 to 6 Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs ('CDR') (OJ EC 2002 No L 3, p 1). In the statement of grounds attached to the application it indicated the following:
  - a Some parts of the Challenged Design should be excluded from consideration pursuant to Article 4 (2) CDR:  
The Challenged Design relates to an engine that is fitted on lawnmowers and the like: the driveshaft and the underside of the base plate of the engine will not be visible in normal use of the engine and should accordingly be excluded from consideration for the purpose of determining whether the design is novel and has individual character; in addition they serve a technical or interconnecting function;
  - b Considerations regarding novelty:  
Novelty must be determined on the basis of the totality of the design, disregarding 'excluded and trivial' features; because two-dimensional representations (in particular drawings) do not reflect the true-to-life aspect of a product, the issue of identity between two designs should be assessed with some latitude;
  - c Lack of novelty (Article 5 CDR):

The Challenged Design is identical to the following design of engine,

FIG. 1

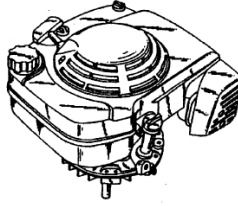


FIG. 2

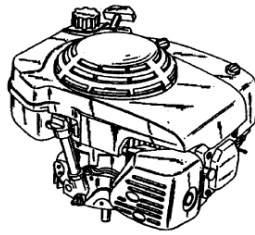


FIG. 3

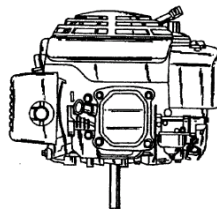


FIG. 4

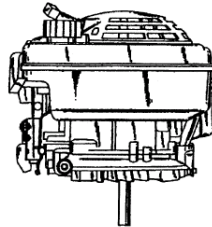


FIG. 5

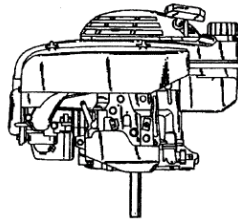


FIG. 6

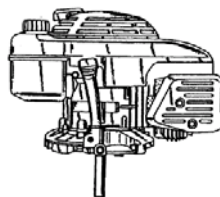


FIG. 7

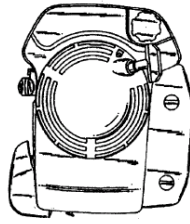
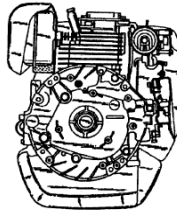


FIG. 8



published on 13 February 1996 as US Design Patent No. D367 070 (hereinafter, the Earlier Design): the top casing, the fuel tank, the air filter cover, the muffler cover of the Challenged Design are identically present in the Earlier Design.

- d Lack of individual character (Article 6 CDR):  
 Since the engine is part of a lawnmower and since users look at lawnmowers from above, the Challenged Design must also be looked at from above and produces on the informed user, who is a ‘purchaser or user of engines’, the same overall impression produced by the Earlier Design; informed users know that designs of this sort of engines can be very different as regard the appearance of the top casing, the air filter, fuel tank, etc.; a designer has significant freedom in the positioning and shape of these components (photographs showing other designs of engines were attached as Annex III).
- 4 By letter dated 1 September 2005 and received by fax on 6 October 2005 the RCD proprietor responds to the application for invalidity. It supplies a list of 32 differences between the two designs and concludes that the Earlier Design did not destroy novelty or individual character of the Challenged Design. It does not address the ground of invalidity based on article 4(2) CDR.
- 5 By letter dated 12 December 2005, received by the Office on 21 December 2005, the applicant maintains that the Challenged Design lacked novelty and individual character because the differences cited had very little impact on its overall impression: the designs should be compared as a whole, not in every individual detail. It submits a catalogue dated 2002/2003 displaying the range of lawn mower engines on offer, one of which is identified with the name GXV 160 and corresponds to the US Design Patent cited earlier in the proceedings. It argues that the Challenged Design does produce the same overall impression as that Earlier Design and that the designer of lawn mower engines has a broad margin

of freedom, as demonstrated by the numerous designs of engines available on the market.

- 6 By decision of 17 August 2006 (hereinafter, the contested decision) the Invalidity Division rejects the application for invalidity. The contents of the decision are the following:
  - a The applicant's observations received on 21 December 2005 are outside the admissible time-limit (the deadline was 12 December 2005) and are accordingly disregarded;
  - b According to Article 4(2) CDR those features of a complex product which are not visible during its normal use should be left aside when considering novelty and individual character of that product; therefore those features will be disregarded when assessing the novelty and individual character of the subject Community Design and only features of the engine that remain visible when the engine is installed on the apparatus should be looked at;
  - c There is no identity because the visible features present the following differences in the two designs: (i) the shape of the top case and the oil dipstick, (ii) the position of the starter cable, and (iii) the shape and position of the vent, the fuel tank, the air filter, the muffler cover; as a result, the Challenged Design does not lack novelty;
  - d The Challenged Design does not lack individual character, either; the informed user is someone familiar with internal-combustion engines of the type to which the Challenged Design relates; what matters is the overall impression of the appearance of the upper part of the engine because this is the part that remain visible during the normal use of this internal combustion engine; the upper part of the two designs produces a different impression on the informed user because of the mentioned differences in (i) shape, (ii) position, and (iii) shape and position.
- 7 The invalidity applicant filed an appeal on 16 October 2006 followed by the statement of grounds on 18 December 2006. The RCD proprietor responded on 7 March 2007. The parties exchanged further briefs on 18 May and 17 July 2007.

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

- 8 The invalidity applicant requests annulment of the contested decision and a ruling that the Community Design is declared invalid. These are the grounds:
  - a The contested decision is the result of a microanalysis: it concentrates on the form of each component but neglects their arrangement and their size proportions, which play a decisive role on the general aspect of the designs; the essential components of the engine (main body, vent, fuel tank, air filter cover, muffler cover) can be found in the same positions in both models and have nearly identical dimensions;

- b The minimal differences listed by the Invalidity Division might be sufficient to preserve novelty of the Challenged Design but certainly not its individual character, particularly if it is considered that the designer's freedom is ample since this sort of engine may be designed in many ways.
- 9 The RCD proprietor replies that the differences observed by the Invalidity Division are not immaterial and do not destroy the novelty of the Challenged Design. These differences do not destroy individual character, either, because the informed user is familiar with these engines and, since it knows that the designer's freedom is limited by technical factors (the engine must fit into a lawnmower, its shape is 'predestinated', engines are 'usually flat and rectangular'), will look at the particular shape of each of the components of the engine and find that their appearance is different in the two designs. The evidence regarding the alleged completely different designs (Annex III) consists of Japanese design patents and has not been translated; it should be disregarded.
- 10 The invalidity applicant insists that the designer's freedom is not so limited and refers to completely different designs of other manufacturers (examples of which were attached as Annex III to the application for invalidity). The images of the Japanese patents require no translation.
- 11 The RCD proprietor reiterates its previous submissions.

### **Reasons**

- 12 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.
- 13 The appeal is also well founded. The Challenged Design lacks individual character within the meaning of Article 6 CDR because it produces on the informed user an overall impression that does not differ from the overall impression produced by the Earlier Design. As a result, the Challenged Design should be declared invalid. The reasons are explained hereunder:

#### *Visibility of component parts, informed user*

- 14 The Challenged Design has been registered in respect of 'internal-combustion engines'. This sort of engine is based on the combustion of fuels (gasoline, diesel, petrol, etc.) within a confined, dedicated space (such as cylinders), whose combustion gases generate mechanical power. Internal-combustion engines are used to power vehicles (cars, motorcycles, mopeds, go-karts, etc.) as well as many sorts of tools, like tillers, lawn mowers, chippers/shredders, chainsaws, air compressors, electricity generators, and pumps.

- 15 A particularity of internal-combustion engines is that they are ‘component parts’ – within the meaning of Article 4 (2) CDR – of a ‘complex product’, the ‘complex product’ being the product that the engine powers: a car, a lawn mower, a generator, a compressor, a pump, etc. The RCD proprietor did not indicate, in its application, in what ‘complex product’ the engine whose design it registered was to be incorporated. The parties agree that one of those complex products are lawn mowers, and the Board will from now proceed, for the purpose of this appeal, on that assumption.
- 16 Another particularity of internal-combustion engines is that, depending on the complex product and/or the type of engine, it is hidden under a hood (this being the case for most cars, for example) or left out completely or mostly uncovered (small power generators, lawn mowers, air compressors).
- 17 According to article 4 CDR, the Challenged Design will have individual character if the engine remains visible after it has been installed on the lawn mower and the visible features have themselves individual character.
- 18 When the engine is installed on a lawn mower, the parts of the engine that remain visible during normal use of the complex product are: primarily the upper side, and secondarily the front side and the lateral sides. The rear side is less visible and the under side is not visible at all, because it is in contact with the ground.
- 19 It follows that the individual character of the Challenged Design should be assessed on the basis of the overall impression produced primarily by its upper side, and from the perspective of an informed user of the relevant lawn mower. The informed user is someone who wants to use a lawn mower to cut the grass in his garden, needs for example to buy one and has become ‘informed’ on the subject by browsing through catalogues of lawn mowers; visiting specialised stores, garden centres; downloading information from the internet, etc. (see Board of Appeal decision of 18 September 2007 in Case R 250/2007-3 – Tables).

*Overall impression of the conflicting designs*

- 20 The designs that must be compared are the Challenged Design and the Earlier Design. The Challenged Design is represented as a black-ink drawing. The Earlier Design is represented both as a black-ink drawing in the US Design Patent and as a colour picture in the 2002/2003 catalogue. The patent and the catalogue are able to prove divulgation of the Earlier Design prior to the date on which the Challenged Design was filed because patents are published and catalogues are distributed to the public.
- 21 In the Board’s opinion, the informed user of a lawn mower is more likely to be impressed by the overall aspect of the upper part of the engine (which is, at the same time, the upper part of the lawn mower itself, since the engine is generally not covered by a hood) than the dozens of details that, no doubt, characterise mechanical devices. This means that designs of lawn mower engines will produce the same overall impression if, seen from above, they globally present the same visual aspect. That aspect is the result of the arrangement of the various



component parts of the engine (the vent, the fuel tank, the casing, etc.), their shape, and their size relative to each other.

- 22 The Board notes that the Challenged Design and the Earlier Design show an identical arrangement of the components – the filter cover, the fuel tank, the vent and the muffler cover. The fact that these components are identically placed in the engine contributes to producing the same visual impression in the two designs. It must be noted in this regard that no technical necessity obliges a designer to place some components, for example, on the left side rather than on the right, or vice-versa.
- 23 The Board also notes that the vent has a very similar protruding design and the same round shape in addition to narrow apertures. The size of the vent, its round shape, the fact that it protrudes out of the top casing and its location towards the rear part of the engine are features that play a very significant role in the overall impression of the designed product because the vent is possibly the most eye-catching feature in the two designs.
- 24 The tank has a very similar crescent-like design, too, and is identically placed at the rear side of the engine; in neither design is it covered by the top cover and remains thus perfectly visible. It is noticeable that the tap is also on the same side in the two designs.
- 25 The air filter casing is located on the left side and has a similar, oblong, shape.
- 26 The muffler is also similarly shaped and placed on the same (right) side of the engine.
- 27 In the two designs, the top cover is generally flat and gently curves down at its front end. This is also a factor that contributes to producing a similar impression, particularly if the engine (and lawn mower) is looked at from the front side.
- 28 One noticeable difference between the two designs is that the starter mechanism is placed on different sides (right in the case of the Challenged Design, left in the other case), but this difference does not affect the overall impression of the engine, which is dominated, in the two conflicting designs, by a generously-sized round vent protruding from an essentially flat cover which, in turn, is surrounded by the air filter casing on the left side, the fuel tank on the rear side and the muffler on the front-right side.
- 29 The contested decision found that the overall impression of the Challenged Design was different from that of the Earlier Design, but this finding was, in the Board's estimation, the result of an excessively detailed analysis of the various components.
- 30 The Invalidity Division noted, for example, that the vent of the Challenged Design 'covers half the height of the main engine body top case and displays a circular edge with three small almost circular convexities consisting of screws placed at each third of its circumference and a flat top surface with a circular rim consisting of oval and circular elements' whereas in the Earlier Design the vent

‘covers almost two thirds of the height of the top case and has a smooth circular edge and a dome formed top with completely plain surface with no elements on it’.

- 31 By describing these details, the contested decision lost the broader perspective of the ‘overall impression’ and failed to notice the essence, namely that the vent has, in the two designs, the same circular shape, a similar size (relative to the rest of the engine), similarly shaped apertures, that it similarly protrudes vertically from the cover of the engine and is placed at the same location on the engine, namely on top of it, roughly towards the rear part. The shape of the vent, its size, its location and the fact that it protrudes out of the engine cover were, in the Board’s opinion, the four factors that should have taken precedence, in the assessment of the overall impression, over a microanalysis of the surface decorating the vents. An informed user is more likely to be impressed, when looking at the lawn mower, by these four factors than by details such as the number of convexities or the existence of screws.
- 32 A similar, somewhat obscure, analysis was made in the contested decision as regards the cap of the fuel tank. For example, the contested decision noted that the cap, in the Earlier Design, ‘has an irregular octagonal shape and is placed in the same quarter of the tank width, however at the back edge of it and almost covering the complete quarter, as its width is almost equal to the width of the quarter’ whereas in the Challenged Design it ‘has a regular hexagonal shape and is placed at the middle of the right lateral quarter of the tank width with distance from its edges as its width amounts to slightly over the half of the width of the quarter’.
- 33 The Board agrees with the contested decision that the caps are not identical in the two designs but doubts that details such as whether it has six sides or angles instead of eight really influence the overall appearance of a relatively insignificant element, or the overall impression of the whole engine. What matters is that the tank, in the two designs, is located on the rear side of the engine, has a similar oblong, crescent-like shape and that the cap, roughly circular, is placed at the same extremity. These are the factors that attract the user’s attention and are, therefore, relevant in the assessment of the overall impression.
- 34 It must be underlined that lawn mowers are technical tools and factors such as power source, ease of operation, ability to dispose of mown grass, possible hazards, etc. are of primary importance for the informed user. Therefore, informed users are more likely to be impressed by the overall aspect of the product – in this case by the internal-combustion engine of the lawn mower which powers it – rather than by relatively insignificant details, which concern minor aspects of the engine (such as the exact shape of the cap or the number of holes in a vent).
- 35 The Board does not agree with the general assessment, in the contested decision, that the Challenged design produces the impression of a ‘composite design with a complex structure and significant components maintaining their individuality’ and that the Earlier Design, gives the impression of ‘an integral design with a

simple structure in which the components parts are integrated in one common body'. In the two designs, each component (vent, fuel tank, air filter cover, muffler, top cover, starter cord) is easily discernible and its position is identical (except for the starter mechanism). Therefore, if minor differences in design are discounted, the overall impression does not differ.

- 36 Another important factor in the assessment of individual character is the degree of freedom that professionals who design engines for lawn mowers enjoy (Article 6 (2) CDR). The contested decision dispensed with this issue rapidly ('the degree of freedom is limited because the internal combustion engine has to fulfill its function') and failed to address what the invalidity applicant has convincingly shown (see Annex III to the application for invalidity) as regards the degree of freedom that designers enjoy. The underside of the engine has to be flat because that part is very close to the ground. But the upper part of the engine – which carries more weight as regards the appreciation of individual character – has no similar constraints. The components can be placed at different locations without jeopardizing functionality or, for what it matters in respect of internal-combustion engines, aesthetic considerations. For example, the vent can be placed on the front side, can be square-shaped and be designed without any protrusion; the air filter can be placed on the left side; the fuel tank may be incorporated in the top cover, etc. The different position of these components will not prevent the engine from 'fulfilling its function'.
- 37 The high degree of freedom that designers enjoy when designing internal-combustion engines for lawn mowers reinforces, therefore, the conclusion that the Challenged Design produces on the informed user the same overall impression, because of the similar shape, position and relative size of the various components of the engine, which is produced by the Earlier Design.

### **Costs**

- 38 The RCD Proprietor shall be ordered, as the losing party in accordance with Article 70 (1) CDR, to bear the costs and fees incurred by the Invalidity applicant in the invalidity and appeal proceedings.

On those grounds,

THE BOARD

hereby:

- 1 Annuls the contested decision and declares the invalidity of the Challenged Design.**
- 2 Orders the RCD Proprietor to bear the costs and fees of the Invalidity Applicant in the invalidity and appeal proceedings.**

Th. Margellos

C. Rusconi

I. Mayer

Registrar:

N. Semjevski