



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 1380/2006-3

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, D-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 1006 (Registered Community
Design No 000 163 290 - 0002)

THE THIRD BOARD OF APPEAL

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

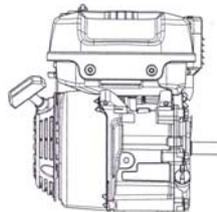
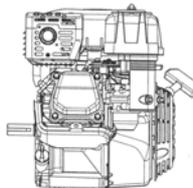
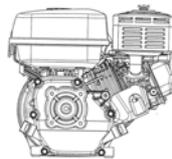
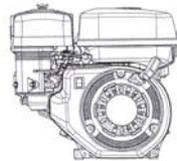
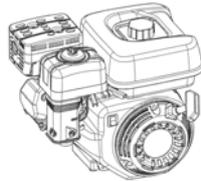
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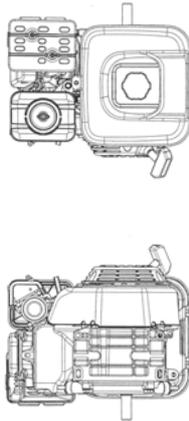
gives the following

Decision

Summary of the facts

- 1 By application received on 2 April 2004 Kwang Yang Motor Co., Ltd. (hereinafter, the RCD proprietor) sought to register a Community Design whose seven views are represented hereunder

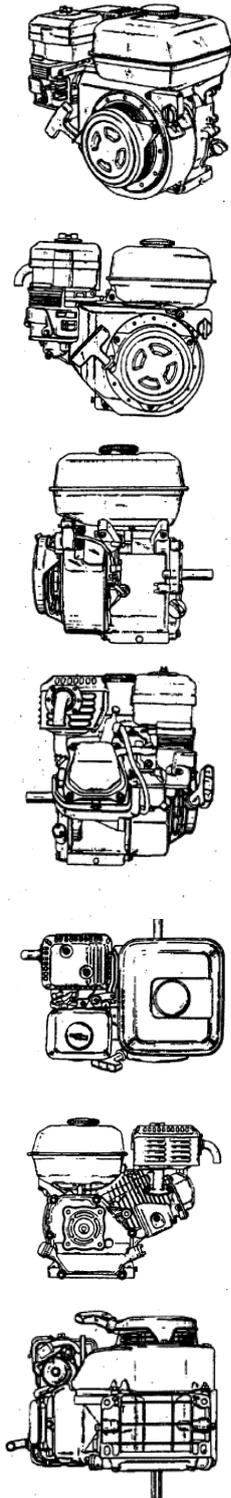




in respect of the following product:

'Internal-combustion engine'.

- 2 The Community Design was registered under No 000 163 290-0002 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 of 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 indicates 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 can be fitted on various powered tools, such as air compressors, generators and other machines: the driveshaft (view No. 4) and the attachment face of the engine (view No. 3) will not be visible in normal use and should accordingly be excluded from consideration for the purpose of determining whether the design is novel and has individual character; in addition these features serve a technical or interconnecting function;
 - b Considerations regarding novelty:
Novelty must be determined on the basis of the totality of the design, disregarding non visible parts and trivial features such as type of fastener; therefore, identity when assessing novelty of technically complex products should not be interpreted too strictly; in addition, because two-dimensional representations, such as drawings, do not reflect faithfully 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,



published on 7 January 1986 as US Design Patent No. D 282 071 (hereinafter, the Earlier Design): the crank case with a recoil starter housing, the air filter housing, the fuel tank with its fuel nozzle, the muffler cover and the cylinder head cover of the Challenged Design are identically placed and shaped in the Earlier Design.

d Lack of individual character (Article 6 CDR):

Since the engine is part of a machine that is generally used on the ground, it will be normally situated below the user's knees and users will look at the machine and the engine that powers it from above; consequently the Challenged Design must also be looked at from above and when it is so observed, produces on the informed user the same overall impression produced by the Earlier Design because the general layout and proportions of the components are identical and also the components themselves are substantially identical in shape; the overall impression of the two designs is of a compact unit with the fuel tank, the air filter and the muffler cover each being rectangular and together lying in a generally rectangular formation with the muffler housing and air filter cover lying side-by-side adjacent the fuel tank; informed users know that designs of this sort of engines have very different appearances because both the shape of the components and their position relative to each other can vary, thereby producing significantly different overall impressions (photographs showing other designs of engines were attached as Annex III); that demonstrates that a designer has significant freedom in the positioning and shape of these components.

- 4 By letter dated 5 September 2005 and received by fax on 6 October 2005, the RCD proprietor responds to the application for invalidity. It supplies a list of dozens of differences between the two designs and concludes that the Earlier Design does not destroy novelty or individual character of the Challenged Design. It argues that the Challenged Design produces an impression of a distinctly sculptured device with a compact and modern line whereas the Earlier Design looks old fashioned and composed of many parts.
- 5 By letter dated 12 December 2005, received by the Office on 21 December 2005, the applicant maintains that the Challenged Design lacks novelty and individual character because the differences cited have very little impact on its overall impression: the designs should be compared as a whole, not in every individual detail. It submits its catalogue dated 2002/2003 displaying the range of engines on offer, one of which is identified with the GX 200 name 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 this sort of engine has a broad margin of freedom, as demonstrated by the numerous designs of engines available on the market.
- 6 By decision of 30 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 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 complex product should be looked at;

- c There is no identity because the visible features of the two designs present differences in the shape of: the fuel tank, the vent, the air filter, the muffler cover and the starter cable; 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 remains 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; the Challenged Design looks compact and modern while the Earlier Design is rather old fashioned and resembles an old film projector.
- 7 The invalidity applicant filed an appeal on 25 October 2006 followed by the statement of grounds on 22 December 2006. The RCD proprietor responded on 3 April 2007. The parties exchanged further briefs on 8 June and 7 August 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 two designs are virtually identical because the basic structure consists of components – body/vent, fuel tank, air filter cover and muffler cover – that can be found in the same position; these components also have the same dimensions; the proportional arrangement is also the same; the only exception is the starter cord but this is of secondary importance;
 - b The design of each individual component is also identical in the two cases; the fuel tank is rectangular with round corners, there is a rectangular depression and the cap is located in the centre; the main body and the vent are also the same, except for small differences in details; the air filter has substantially the same design; the muffler cover, too;
 - c These common features give both designs a very compact and smooth appearance; small differences in the design of each components do not affect that appearance; bearing in mind the strong technical nature of engines, an informed user will be impressed by the arrangement and general shape of the components, not by details;
 - d The Invalidity Division failed to consider, when comparing the designs, the arrangement of the various components and their size relative to each other, i.e. factors that are very important in the assessment of the overall impression and instead cited a large number of small details that are irrelevant for the overall impression;

- e The Invalidity Division also cites non-existing features (such as screws on the air filter cover) or confuses conventional lines that simply represent curves in technical drawings with real lines;
 - f 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 for the reasons indicated in the contested decision. 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 machine, for example a shredder, its shape is 'predestinated', engines are 'usually tower-like 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 freedom of the designer is also limited by the fact the various types of engines of such a basic shape already exist. The arrangement and the size of the various components are dictated by technical functionality. The designs must be compared according to their detailed representation. 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 that 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(s)’ the engine whose design it registered is to be incorporated. The invalidity applicant argues, on the basis of the appearance of the Challenged Design, that the engine is intended to be installed on air compressors, electricity generators, pumps, chipper/shredders, lawn mowers, go-karts. The RCD proprietor did not contest this assertion (and even confirmed that the engine is intended for a shredder or a go-kart) and the Board will from now proceed, for the purpose of this appeal, on the assumption that the relevant complex products are: air compressors, power generators, pumps, chipper/shredders, lawn mowers and go-karts (hereinafter, the ‘relevant complex products’).
- 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 In accordance with article 4 CDR, the Challenged Design has individual character if the engine remains visible after it has been installed on the complex products and the visible features have themselves individual character.
- 18 When the engine is installed on the complex products, 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, which is represented in ‘view 3’ of the Challenged Design, is less visible because it is the side which is fastened to the chassis of the complex products and the under side is not visible at all, because it faces 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 any of the relevant complex products. The informed user is someone who wants to use these products, needs for example to buy one and has become ‘informed’ on the subject by browsing through catalogues of air compressors, generators, etc.; 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 whose overall impression must be compared are the Challenged Design and the Earlier Design. They are both represented as black-ink drawings. Informed users normally see real products, not technical drawings. Therefore, the overall impression on the informed user -that must be taken account of for the purpose of assessing individual character - is not the one produced by the drawings directly but that which is conveyed by the physical aspect of the product that the drawings (albeit imperfectly) attempt to reproduce.
- 21 The US Design Patent is able to prove divulgation of the Earlier Design prior to the date on which the Challenged Design was filed because patents are published.
- 22 Since the relevant complex products are heavy and lie on the ground (air compressors, electricity generators) or are pushed forward on the ground by the user (lawn mower or chipper/shredder), the informed user 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 complex product itself, since this sort of engine is generally not covered by a hood) than the dozens of details that, not surprisingly, characterise mechanical devices. This means that the designs of internal-combustion engines intended for the relevant complex products will produce the same overall impression if, seen from above, they globally display the same arrangement of the various component parts of the engine and these components have similar shapes and sizes relative to each other.
- 23 The Board notes that the Challenged Design and the Earlier Design show an identical arrangement of the components – the body/vent, the air filter cover, the fuel tank, the vent and the muffler cover. The fact that these components are identically laid out in the two engines' designs contributes to producing the same visual impression. 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.
- 24 The Board notes, in addition, that the body/vent has a similar protruding design, the same round shape, and is placed on the same side. The size of the vent, its round shape, the fact that it protrudes out and, particularly, its location on the same side of the engine are features that play a very significant role in the overall impression of the designed product.
- 25 The tank has, in the two designs, the same rectangular design with rounded corners, has a depression in the middle of which the cap is placed and is identically placed at the rear side of the engine. The cap has a different design but this hardly affects the overall impression of the designs.
- 26 The air filter casing is located on the same side and has a similar, rectangular, shape and has roughly a similar size relative to the fuel tank.
- 27 The muffler is also similarly shaped and placed on the same side of the engine in the two designs.
- 28 The cylinder head cover that can be seen when looking frontally to the engine is similarly shaped.

- 29 One difference between the two designs is that the starter cord is placed on different sides of the body/vent (right in the case of the Challenged Design, left in the other case), but this does not affect the overall impression of the engine, which is dominated, in the two conflicting designs, by identically arranged components which are, furthermore, similarly designed.
- 30 The contested decision found that the overall impression of the Challenged Design was different than 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.
- 31 The Invalidity Division noted, for example, that the vent of the Challenged Design 'has 17 rectangular openings around its centre and three sections of three grooves separated by a fixing element' whereas in the Earlier Design the vent 'displays only four bigger openings in its centre, is surrounded by a collar with no visible grooves on its surface and a triangular element is located on its right side close to the fuel tank'. By describing these details, the contested decision lost the broader perspective of the 'overall impression'. Furthermore, most of these details are best noticed if the engine is looked at laterally when, for the reasons previously indicated, the most relevant view for assessing the overall impression is from above.
- 32 A similar microanalysis was made in the contested decision as regards the fuel tank. For example, the contested decision noted that the fuel tank, in the Challenged Design, 'has two recessed portions, vertical lines located adjacently to the corners, a band which extends around its top edge, an horizontal straight boarder in its middle and a lower edge defined by two lines' whereas the Earlier Design 'displays a plane surface of the corners, no band or vertical lines, etc.'. The Board agrees with the contested decision that the fuel tanks (and the caps) are not identical in the two designs but they nevertheless produce, because of their shape, recessed areas and the position of the cap, the same overall impression. It also appears, as the appellant correctly notes, that the Invalidity Division's judgement was tainted by a misinterpretation of the 'lines' in the Challenged Design: these lines merely represent curves and were wrongly considered as a distinctive feature of the fuel tank.
- 33 The contested decision also gives some importance to the fact that the handle of the starter cable is rectangular in one case, and has a rounded appearance in the other. This is not the sort of difference, in the Board's opinion, that affects the overall impression of the engine because the starter handle is a marginal (and highly functional) component if compared with the rest.
- 34 The Board also does not agree with the general assessment, in the contested decision, that the Challenged Design represents a 'compact and modern engine, where the different components are fully integrated' whereas in the Earlier Design 'the component parts maintain their individuality and convey the impression of a rather old-fashioned engine suggesting the idea of an old film projector'. In the two designs, each component (body/vent, fuel tank, air filter cover, muffler, starter) maintains its individuality and has an identical position

relative to each other (except for the starter). Therefore, if minor differences in design are discounted, the overall impression does not differ.

- 35 It must be underlined, in this respect, that the two designs concern products having a high technical content. Internal-combustion engines, air compressors, power generators and similar tools are products for which technical characteristics and safety considerations – ease of use, protection against hazards – are so important that the informed user’s overall impression of the aspect of the product is more likely to be influenced by the general appearance (arrangement of component parts, size, overall shape of components) than by relatively immaterial details.
- 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’) even though the invalidity applicant had convincingly shown (see Annex III to the application for invalidity) that designers have a relatively high degree of freedom. The underside of the engine has to be flat because that part is very close to the ground and the rear side must be capable of being fastened to the chassis of the complex product. But the upper part of the engine – which carries more weight as regards the appreciation of individual character – has no similar constraints. The Board does not understand the RCD proprietor’s claim that these engines are generally rectangular and ‘tower-like’. 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 right side; 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 the relevant complex products 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