

JUDGMENT OF THE GENERAL COURT (Third Chamber)

9 September 2014 (*)

(Community trade mark — Invalidity proceedings — Registered Community design representing a broken cookie — Ground for invalidity — Lack of individual character — Articles 4, 6 and Article 25(1)(b) of Regulation (EC) No 6/2002)

In Case T494/12,

Biscuits Poult SAS, established in Montauban (France), represented by C. Chapoullié, lawyer,
applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM),
represented by A. Folliard-Monguiral, acting as Agent,
defendant,

the other party to the proceedings before the Board of Appeal of OHIM, intervener before the General Court, being

Banketbakkerij Merba BV, established in Oosterhout (Netherlands), represented by M. Abello, lawyer,

ACTION brought against the decision of the Third Board of Appeal of OHIM of 2 August 2012 (Case R 914/2011-3 in relation to invalidity proceedings between Banketbakkerij Merba BV and Biscuits Poult SAS,

THE GENERAL COURT (Third Chamber),

composed of S. Papasavvas, President, N.J. Forwood (Rapporteur), and E. Bielineas, Judges,

Registrar: C. Kristensen, Administrator,

having regard to the application lodged at the Registry of the General Court on 14 November 2012,

having regard to the response of OHIM lodged at the Registry on 14 February 2013,

having regard to the response of the intervener lodged at the Registry of the Court on 12 February 2013,

further to the hearing on 2 April 2014,

gives the following

Judgment

Background to the dispute

1 On 25 March 2009, the applicant Biscuits Poult SAS, filed an application for registration of

a Community design with the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) pursuant to Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1).

2 The design in respect of which registration was sought, intended to be applied to ‘cookies’, is represented as follows:



3 The design in dispute was registered as Community design No 1114292-0001 and published in *Community Designs Bulletin* No 75/2009 of 22 April 2009.

4 On 15 February 2010, the intervener, the Banketbakkerij Merba BV applied to OHIM for a declaration that the contested design was invalid pursuant to Article 25(1)(b) of Regulation No 6/2002. In its application for a declaration of invalidity, the intervener alleged that the contested design was not new and had no individual character and that its appearance was dictated by its technical function within the meaning of Articles 5, 6 and 8 of Regulation No 6/2002.

5 In support of its application for a declaration of invalidity, the intervener argued, in support of its contention that the contested design was not new and lacked individual character, the earlier designs set out below:





6 By decision of 28 February 2011, the Cancellation Division of OHIM dismissed the application for a declaration that the contested design was invalid.

7 On 22 April 2011, the intervener lodged an appeal at OHIM against the decision of the Cancellation Division.

8 By decision of 2 August 2012 ('the contested decision'), the Third Board of Appeal of OHIM declared the contested design invalid pursuant to Article 25(1)(b) of Regulation No 6/2002

on the ground that it lacked individual character within the meaning of Article 6 of that regulation.

9 The Board of Appeal held, first of all, that the layer of filling inside the cookie could not be taken into consideration for the assessment of the individual character of the contested design, as it did not remain visible during normal use of the product. Next, the Board of Appeal considered that the outer appearance of the contested design was the same as the first three earlier designs reproduced in paragraph 5 above. Lastly, the Board of Appeal found that the contested design does not produce on an informed user who regularly consumes that type of cookie a different overall impression from that produced by the three earlier designs, given the broad margin of freedom the designer of this type of product has.

Forms of order sought

10 The applicant claims that the Court should:

- annul or ‘at the very least amend’ the contested decision;
- uphold the decision of the Cancellation Division;
- Dismiss the application for a declaration of invalidity;
- order the intervener to pay the costs.

11 OHIM contends that the Court should:

- dismiss the action;
- order the applicant to pay the costs.

12 The intervener contends that the Court should:

- dismiss the action;
- uphold the contested decision;
- in the alternative, refer the case back to the Board of Appeal so that it may rule on the individual character of the contested design in the light of all the earlier designs;
- order the applicant to pay the costs.

Law

13 In support of its action, the applicant puts forward a single plea, alleging, in essence, infringement of Article 6 of Regulation No 6/2002.

14 In support of that plea, the applicant submits that the Board of Appeal incorrectly refused to consider the internal appearance of the contested design, thereby failing to take account of the differences as compared to the earlier designs which gave that design individual character.

15 The applicant submits that a cookie cannot be considered to be a ‘complex product’ within the meaning of Article 3(c) of Regulation No 6/2002 and that, therefore, the filling inside the cookie is not a component of that product. It follows that Article 4(2) of that regulation is not applicable to the present case.

16 The applicant submits in the alternative that the layer of filling inside the cookie is visible

when the product is put to normal use, since it will be broken at the time it is consumed, which is a normal use thereof. Moreover, this type of representation of a cookie reflects the advertising practices prevalent in the relevant sector. Accordingly, the appearance of the filling ought to have been taken into consideration, even under Article 4(2) of Regulation No 6/2002.

17 The applicant thus submits that, given all the characteristics of the contested design, including its appearance, lines, contours, colours, the contrast between the inside and the outside, the golden surface, the number of chocolate chips on the surface and its texture, the Board of Appeal ought to have acknowledged the contested design's individual character in relation to the first three designs reproduced in paragraph 5 above.

18 Article 3(a) of Regulation No 6/2002 defines 'design' as 'the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation'.

19 It follows that the protection of a design for the purposes of Article 4(1) of Regulation No 6/2002 consists in the protection of the appearance of a product, that is to say, according to Article 3(b) thereof, any industrial or handicraft item, or of a part of such an item.

20 It is also apparent from recitals 7, 12 and 14 in the preamble to Regulation No 6/2002, which refer to protection of industrial design, to restricting protection to visible elements and to the impression produced on an informed user viewing the product's appearance, that that regulation confers protection only on the visible parts of the products or parts of products, which may as a result be registered as designs.

21 In that context, Article 4(2) of Regulation No 6/2002 lays down a particular rule applying specifically to a design applied to or incorporated in a product which constitutes a component part of a complex product within the meaning of Article 3(c) of Regulation No 6/2002. Under that rule, this type of design is protected only if, firstly, the component part, once it has been incorporated into the complex product, remains visible during normal use of that product and, secondly, the visible features of the component part fulfil in themselves the requirements as to novelty and individual character.

22 Given the particular nature of components of a complex product within the meaning of Article 3(c) of Regulation No 6/2002, which may be produced and marketed separately from the complex product, it is reasonable for the legislature to provide for the possibility of having them registered as designs, subject to their being visible after incorporation into the complex product and only in respect of the visible parts of the components in question at the time of normal use of the complex product and in so far as those parts are new and have individual character.

23 Article 4(2) and (3) of Regulation No 6/2002 thus has neither the object or effect of multiplying the characteristics of a product which may constitute a design under Article 3(a) of that regulation, but rather to lay down a specific rule governing a specific scenario.

24 In the present case, as mentioned in paragraph 14 of the contested decision, the applicant acknowledged before the Board of Appeal that the layer of chocolate filling inside the cookie became visible only if the cookie was broken. Consequently, this characteristic does not relate to the appearance of the product at issue.

25 It is therefore clear that the Board of Appeal applied Articles 3 and 6 of Regulation No 6/2002 correctly when it found, in paragraphs 15 and 16 of the contested decision, that the layer of chocolate filling inside the cookie was not visible because the product had to be broken open for the inside to become visible, with the result that that characteristic was not to be taken into account for the assessment of the individual character of the contested design.

26 Moreover, as OHIM and the intervener have pointed out, the fact that the product in question may bear a closer resemblance to the contested design when it is broken open in order to be consumed is irrelevant.

27 The applicant's argument to the effect that the layer of chocolate filling inside the cookie becomes visible during 'normal use' of the cookie, that is to say, when it is consumed, is based on a misunderstanding of Article 4(2) and (3) of Regulation No 6/2002 and is therefore ineffective. It is apparent from those provisions that the concept of 'normal use' is relevant only when an assessment is to be made of whether protection may be given to a design applied to or incorporated in a product which constitutes a component of a complex product within the meaning of Article 3(c) of Regulation No 6/2002. Article 4(3) of that regulation further states that the concept of 'normal use' is to mean 'use within the meaning of [Article 4](2)(a)'.

28 The parties all agree, correctly, that a cookie such as the one portrayed in the contested design is not a complex product within the meaning of Article 3(c) of Regulation No 6/2002 because it is not composed of multiple components which can be replaced permitting disassembly and re-assembly. Consequently, the characteristics of the contested design which may be protected must be determined by reference to the rules referred to in paragraphs 18 to 20 above, which, in respect of products which are not components which may be assembled in a complex product within the meaning of Article 3(c) of Regulation No 6/2002, do not refer to the concept of 'normal use', but rather to the appearance of the product within the meaning of Article 3(a) thereof.

29 Therefore the Board of Appeal did not err in stating, in paragraphs 13 and 16 of the contested decision, that the non-visible characteristics of the product, which do not relate to its appearance, could not be taken into account in the determination of whether the contested design could be protected, nor in concluding, in paragraph 17 of the contested decision, that 'it [was] not necessary to take into account, in the examination of the individual character of the design, of the filling inside the cookie, as portrayed'.

30 Moreover, since the rule specifically governing components intended for incorporation into a complex product laid down in Article 4(2) and (3) of Regulation No 6/2002 (see paragraphs 21 to 23 above) is an adaptation — pertaining to a specific field not relevant to the present proceedings — of the principle referred to in paragraphs 18 to 20 above and has neither the object nor effect of amending the requirement of visibility of the characteristics of a product portrayed in a design, the fact that paragraphs 13 and 16 of the contested decision contain a reference to that provision is not liable to cast doubt on the reasoning set out in paragraphs 13 to 17 of that decision.

31 Consequently, none of the applicant's arguments set out in paragraphs 15 and 16 above is such as to call into question the well-foundedness of the contested decision. Furthermore, since only the visible characteristics of the product portrayed by the contested design may be taken into account in the assessment of its individual character (see paragraphs 25 to 30 above), the applicant's arguments relating to that assessment (see paragraph 17 above) cannot be upheld.

32 In fact, given the designer's considerable freedom, referred to in paragraph 30 of the contested decision and not disputed by the applicant, the Board of Appeal's findings in this respect must be upheld.

33 In particular, as the Board of Appeal stated in paragraphs 21 to 24 of the contested decision, the irregular, rough surface on the outside of the cookie, its golden colour, round shape and the presence of chocolate chips are characteristics which are common to the conflicting designs and decisive for the overall impression produced on an informed user, so that the contested design cannot be regarded as having individual character.

34 The smoother surface of the contested design as compared to the first and third designs reproduced in paragraph 5 above, together with the differences relating to the number, specific

dimensions and somewhat prominent presence of the chocolate chips on each of those designs and on the contested design do not confer individual character on the latter. In fact, given the designer's considerable freedom, those differences are not liable to produce a different overall impression on an informed user, as defined in paragraph 28 of the contested decision, in such a way as to benefit the contested design.

35 Consequently, the Board of Appeal did not err in finding, in paragraph 31 of the contested decision, that the contested design had to be declared invalid pursuant to Article 25(1)(b) of Regulation No 6/2002 on the ground that it lacked individual character within the meaning of Article 6 thereof.

36 The action must accordingly be dismissed, without its being necessary to rule on the admissibility of the second head of claim put forward by the applicant or on the admissibility of an annex to the application, challenged by OHIM.

Costs

37 Under Article 87(2) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. As the applicant has been unsuccessful, it must be ordered to pay the costs incurred by OHIM and the intervener, as applied for by them.

On those grounds,

THE GENERAL COURT (Third Chamber)

hereby:

1. **Dismisses the action.**
2. **Orders Biscuits Poult SAS to bear its own expenses and to pay those incurred by the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) and Banketbakkerij Merba BV.**

Papasavvas

Forwood

Bielinas

Delivered in open court in Luxembourg on 9 September 2014.

[Signatures]

* Language of the case: French.

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