

JUDGMENT OF THE GENERAL COURT (Fifth Chamber)

21 May 2015 (*) (1)

(Community design — Invalidity proceedings — Registered Community design representing umbrellas — Grounds for invalidity — Disclosure of earlier design — American patent as earlier design — Circles specialised in the sector concerned — Informed user — Degree of attention of an informed user — Fashion accessories — Degree of freedom of the designer — Individual character — Different overall impression — Invalidity proceedings)

In Joined Cases T-22/13 and T-23/13,

Senz Technologies BV, established in Delft (Netherlands), represented initially by W. Hoyng and C. Zeri, and subsequently by W. Hoyng and I. de Bruijn, lawyers,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented initially by F. Mattina, and subsequently by A. Folliard-Monguiral, acting as Agents,

defendant,

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

Impliva BV, established in Mijdrecht (Netherlands), represented by C. Gielen and A. Verschuur, lawyers,

ACTION brought against two decisions of the Third Board of Appeal of OHIM of 26 September 2012 (Cases R 2453/2010-3 and R 2459/2010-3), in relation to invalidity proceedings between Impliva BV and Senz Technologies BV,

THE GENERAL COURT (Fifth Chamber),

composed of A. Dittrich (Rapporteur), President, J. Schwarcz and V. Tomljenović, Judges,

Registrar: J. Weychert, Administrator,

having regard to the application lodged at the Court Registry on 16 January 2013,

having regard to the response of OHIM lodged at the Court Registry on 30 April 2013,

having regard to the response of the intervener lodged at the Court Registry on 19 April 2013,

having regard to the replies lodged at the Court Registry on 22 July 2013,

having regard to the rejoinders of OHIM lodged at the Court Registry on 11 November 2013,

having regard to the order of 2 October 2014 joining Cases T-22/13 and T-23/13 for the purposes of the oral procedure and the judgment,

further to the hearing on 27 November 2014,

gives the following

Judgment

Background to the dispute

- 1 On 25 August 2006, the applicant, Senz Technologies BV, filed two applications 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 Community design at issue in Case T-22/13 was registered under number 000579032-0001 and published in *Community Trade Marks Bulletin* No 118/2006 of 17 October 2006, the indication of which mentions ‘umbrellas’, and which is reproduced below:



- 3 The Community design at issue in Case T-23/13 was registered under number 000579032-0002 and published in *Community Trade Marks Bulletin* No 118/2006 of 17 October 2006, the indication of which mentions ‘umbrellas’, and which is reproduced below:



- 4 On 16 July 2009, the intervener, Impliva BV, lodged an application for a declaration of invalidity pursuant to Article 52 of Regulation No 6/2002 in respect of each of those designs ('the contested designs'). Each of those applications for a declaration of invalidity was based on Article 25(1)(b) of Regulation No 6/2002 alleging that the contested designs do not comply with the requirements laid down in Articles 4 to 9 of that regulation.
- 5 The intervener contended in particular that the umbrellas covered by the contested designs did not have individual character, because they make the same overall impression on the informed user as a certain number of umbrellas with an identical or similar shape which have been the subject of patents or designs registered and made available to the public prior to the registration of the contested designs. The earlier rights relied on included American patent No 5505221 ('the earlier patent'), registered on 9 April 1996 and represented as follows:

Fig. 1



Fig. 2

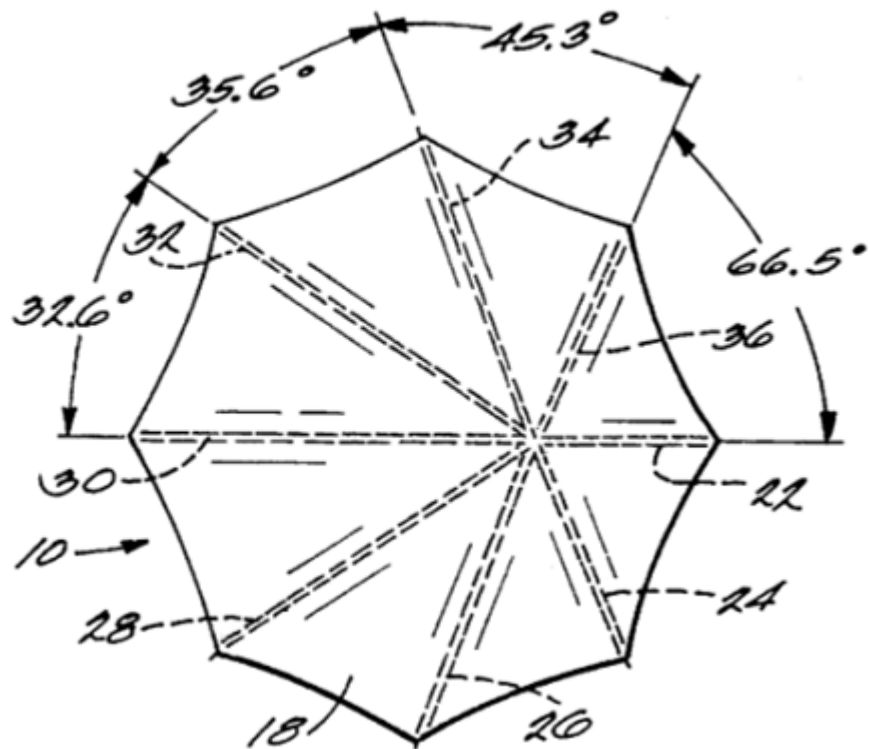
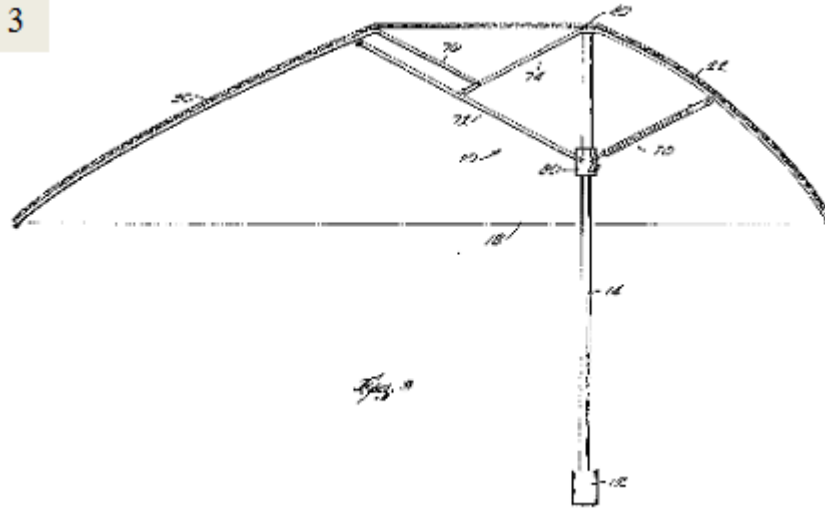


Fig. 3



- 6 On 18 October 2010 the Invalidity Division upheld the intervener's applications for a declaration of invalidity. It found that the earlier patent had been made available to the public within the meaning of Article 7(1) of Regulation No 6/2002 following its publication on the website of the United States Patent and Trademark Office (USPTO), which site is freely accessible free of charge in all Member States of the European Union. While considering the freedom of the designer in the creation of the contested designs to be limited, the Invalidity Division was of the opinion that, despite the fact that the contested designs were new within the meaning of Article 5(1) of Regulation No 6/2002, they were devoid of individual character within the meaning of Article 6(1) of that regulation. Also according to the Invalidity Division, the overall impression that each of the contested designs and the earlier patent had on the informed user was essentially the same as a result of the straight handles and especially the asymmetrical shape of the canopies which were each supported by eight ribs symmetrically arranged around the tip of the handle. By contrast, the exact spacing and shape of the ribs (straight or curved) was of only minor importance for the informed user, who, furthermore, was not familiar with designs of asymmetrical umbrellas.
- 7 On 14 December 2010 the applicant brought an appeal against each of the decisions adopted by the Invalidity Division.
- 8 By decisions dated 26 September 2012 ('the contested decisions'), the Third Board of Appeal of OHIM dismissed the appeals on the ground that the contested designs did not have distinctive character.
- 9 The Board of Appeal considered that the earlier patent could reasonably be known to the circles specialised in the sector concerned within the European Union. First, the site of the USPTO register is accessible free of charge. Secondly, designs are known in the United States as 'design patents'. Thirdly, it would be unwise on the part of those circles not to check whether prior art already exists in the American register, which is one of the most important registers of intellectual property rights in the world. Finally, the fact that the United States is the most important trading partner of the European Union makes it unlikely that the circles specialised in the sector concerned do not consult the USPTO register.
- 10 The Board of Appeal also held that the informed user knows the different designs and the normal characteristics of umbrellas and has a relatively high level of attention.

- 11 The freedom of the designer is limited as regards the design of an umbrella. There is, however, some degree of freedom as regards the overall shape and size of an umbrella and a considerable degree of freedom as regards the wide range of possibilities of decorating the canopy of an umbrella with patterns and colours.
- 12 As regards the overall impression produced by each of the contested designs, the Board of Appeal held that it was determined principally by the under and lateral sides of the umbrella designs, because while using the umbrella the user will be beneath it and will not see the umbrella from above. Despite his relatively high level of attention, the informed user pays attention to the basic structure and not the details, which moreover do not alter the fact that all the umbrellas covered by the earlier patent and the contested designs produce essentially the same overall impression, in particular because of their unusual appearance, which is elongated, asymmetric and ‘beak-like’, and of the fact that the distribution of the ribs, the proportions of the canopies and the spacing are similar. Finally, the fact that some of the depictions of the contested designs show a black or brown canopy, whereas the earlier patent is a simple diagram, is not a significant difference.

Forms of order sought

- 13 The applicant claims, both in Case T-22/13 and in Case T-23/13, that the Court should:
- annul the contested decisions;
 - uphold the arguments put forward before it and declare the registration of the contested designs to be valid; and
 - order OHIM to bear its own costs and order the intervener, should it intervene, to bear its own costs and to cover those of the applicant.
- 14 At the hearing the applicant withdrew its second head of claim both in Case T-22/13 and in Case T-23/13, by which it asked the Court to declare the registration of the contested designs to be valid.
- 15 OHIM contends, both in Case T-22/13 and in Case T-23/13, that the Court should:
- dismiss the applications;
 - order the applicant to pay the costs.
- 16 In its response, the intervener contends, both in Case T-22/13 and in Case T-23/13, that the Court should:
- dismiss the actions in their entirety or, in the alternative, refer the cases back to OHIM or, in the further alternative, declare the registration of the contested designs to be invalid;
 - order the applicant to bear its own costs and pay those incurred by the intervener, including for the purposes of the proceedings before the Board of Appeal.
- 17 At the hearing the intervener withdrew its second head of claim both in Case T-22/13 and in Case T-23/13, by which it asked the Court to refer the cases back to OHIM.

Law

- 18 In support of each of its actions, the applicant relies on two pleas in law: (i) infringement of Article 7(1) of Regulation No 6/2002 and (ii) infringement of Article 6(1) of that regulation.
- Consideration of the first plea in law: infringement of Article 7(1) of Regulation No 6/2002*
- 19 The applicant begins by criticising the Board of Appeal for having held, incorrectly, that an American patent could be known to circles specialised in the sector concerned operating in the European Union. First of all, the nature of a design has nothing to do with patents, as the former concerns the appearance of a product whilst the latter concerns technical inventions. Secondly, it is highly unlikely that the average EU designer is familiar with patent systems in general and associates the term ‘patent’ with designs. Thirdly, in the absence of any evidence to the contrary adduced by OHIM, the average EU designer cannot be presumed to have consulted patent registers, even less registers located outside the European Union.
- 20 As a second point, the applicant criticises the Board of Appeal for having held, incorrectly, that the average EU designer of umbrellas would have known that, in the United States, the term ‘patent’ also refers to ‘design’, when even many European intellectual property lawyers are not aware of this fact. Moreover, the earlier patent is not a design patent and therefore would not have turned up in a search conducted by an EU designer.
- 21 As a third point, the applicant challenges the Board of Appeal’s statement that ‘it would be imprudent for designers seeking to register designs in the EU not to check for the existence of prior art in one of the world’s major IP registers (namely the USPTO) given the almost legendary reputation of the United States as a centre of innovation and designs ...’. The applicant states that an individual designer or a small or medium-sized enterprise would, reasonably, search only on the existing market and in design registers in the European Union, inter alia because it would be beyond the financial means of designers and small enterprises to undertake excessive searches.
- 22 The applicant’s fourth point of argument is, in essence, that, contrary to the Board of Appeal’s finding, specialised circles in the umbrellas sector may not be aware of developments in the United States, because: (i) contrary to what the Board of Appeal held, incorrectly, the United States is not the European Union’s principal trading partner in umbrellas; and (ii) it is not possible to be aware of the existence of an umbrella patented in the United States if it has never been manufactured and marketed.
- 23 OHIM and the intervener contest those arguments.
- 24 Regarding the first argument put forward by the applicant, to the effect that a design has nothing to do with patents, it should first of all be borne in mind that the definition laid down in Article 3(a) of Regulation No 6/2002, under which a design is defined 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’. As rightly pointed out by OHIM at the hearing, it is only ‘the appearance’ as such which is the decisive criterion for there to be a design within the meaning of Regulation No 6/2002 and not the legal form under which that appearance is protected. The fact that the earlier right relied on by the intervener is a patent is therefore of no import in the present case, so long as that patent has the required characteristics of a design as laid down in Article 3(a) of Regulation No 6/2002. The earlier patent covers the umbrella designated by it as resulting from the features of its lines, contours, angles and shape. Therefore, the earlier patent contains not only the technical description of an asymmetrical umbrella but also its appearance. It is accordingly a design within the meaning of Article 3 (a) of Regulation No 6/2002 on which the intervener could rightly rely as an earlier design

within the meaning of Article 7(1) thereof. The applicant's argument in that regard must therefore be rejected.

- 25 As to the other arguments put forward by the applicant as part of its first plea in law, it should be remembered that Article 7(1) of Regulation No 6/2002 provides that '[f]or the purpose of applying Articles 5 and 6, a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, before the date referred to in Articles 5(1)(a) and 6(1)(a) or in Articles 5(1)(b) and 6(1)(b), as the case may be, 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'.
- 26 A design is therefore deemed to have been made available once the party relying thereon has proven the events constituting disclosure. In order to refute that presumption, the party challenging the disclosure must establish to the requisite legal standard that the circumstances of the case could reasonably prevent those facts from becoming known in the normal course of business to the circles specialised in the sector concerned.
- 27 Moreover, the presumption provided for in Article 7(1) of Regulation No 6/2002 applies irrespective of where the events constituting disclosure took place, since it can be seen from the wording of the first sentence of Article 7(1) of Regulation No 6/2002 that it is not absolutely necessary, for the purpose of applying Articles 5 and 6 of that regulation, for the events constituting disclosure to have taken place within the European Union in order for a design to be deemed to have been made available to the public (judgment of 13 February 2014 in *H. Gautzsch Großhandel*, C-479/12, ECR, EU:C:2014:75, paragraph 33).
- 28 The question whether events taking place outside the European Union could reasonably have become known to the persons forming part of the circles specialised in the sector concerned is a question of fact; the answer to that question is dependent on the assessment of the particular circumstances of each individual case (judgment in *H. Gautzsch Großhandel*, cited in paragraph 27 above, EU:C:2014:75, paragraph 34).
- 29 In order to carry out the assessment referred to by the Court of Justice, it must be examined whether, on the basis of the facts, which must be adduced by the party challenging the disclosure, it is appropriate to consider that it was not actually possible for those circles to be aware of the events constituting disclosure, whilst bearing in mind what can reasonably be required of those circles in terms of being aware of prior art. Those facts may concern, for example, the composition of the specialised circles, their qualifications, customs and behaviour, the scope of their activities, their presence at events where designs are presented, the characteristics of the design at issue, such as their interdependency with other products or sectors, and the characteristics of the products into which the design at issue has been integrated, including the degree of technicality of the product concerned. In any event, a design cannot be deemed to be known in the normal course of business if the circles specialised in the sector concerned can become aware of it only by chance.
- 30 The various arguments put forward by the applicant under the first, second, third and fourth parts of the first plea in law must be examined in the light of the considerations set out above.
- 31 It is appropriate to begin by noting that, in essence, the applicant has restricted itself to stating that it is highly unlikely that the average EU designer will be aware of the patent systems and consult patent registers inter alia outside the European Union, whilst setting out why, in its submission, the arguments contained in the contested decision were insufficient

for a finding that the earlier patent could reasonably be known to circles specialised in the sector concerned.

- 32 It seems reasonable, however, that the designer of a wind-resistant umbrella, before placing it on the market, will undertake searches in patent registers, as he may be deemed to know that such a product must meet not only aesthetic but also — and to a considerable extent — technical requirements, and that it is therefore reasonable and plausible that a wind-resistant umbrella may have already been patented. In any event, it must be remembered in the light of what has been set out in paragraphs 25 to 29 above that it was for the applicant to substantiate its argument that the specialised circles in the umbrellas sector do not engage in such searches in the USPTO register and that it nevertheless failed to adduce any factual evidence or argument — which is not simply an allegation — which would lead to such a conclusion.
- 33 The statement that many European intellectual property lawyers are not aware that, in the United States, designs are registered in a patent register has not been substantiated and, in any event, does not lead to the conclusion that specialised circles in the umbrellas sector are also not aware of that fact.
- 34 The statements set out in the contested decision and challenged by the applicant, to the effect that account must be taken of the legendary reputation of the United States in design and that it would be imprudent not to check the world's principal IP registers, need not be examined since, even if they are found not to be correct, that finding would not cast doubt on the fact that it was not for the Board of Appeal to establish that the earlier patent could reasonably be known to the circles specialised in the sector concerned but for the applicant to establish that they could not.
- 35 As to the applicant's argument that the excessive searches to be undertaken would be beyond the financial means of designers and small enterprises, suffice it to note that the applicant has not adduced any factual evidence or argument which is not simply an allegation to the effect that in the present case the circles specialised in the sector concerned are made up only of individual designers and small enterprises which, moreover, as a rule do not have the means to undertake searches to check for the existence of prior art outside the European Union. The applicant in effect merely states that the circles specialised in the sector concerned operating in the European Union do not consist of 'large companies'. However, the applicant goes on to state that there are 'a few larger (mainly German, Austrian and Dutch) companies and a lot of small companies or individuals' and that it is highly unlikely that the latter will browse in the American patent register. Even if that observation were held to be correct, in putting forth that argument the applicant recognises that the 'few larger companies' which, in the light of the point made in paragraph 30 above, must be regarded as forming part of the circles specialised in the sector concerned, probably do carry out such searches. Nor has the applicant provided any specific information about the companies operating in the European umbrellas sector. Accordingly, the applicant has once again failed to substantiate its allegations using arguments which are not simply allegations.
- 36 As to the argument that the umbrella covered by the earlier patent has never been produced — a point not contested, moreover, either by OHIM or the intervener — it is clear that Article 7(1) of Regulation No 6/2002 does not impose any requirement that the earlier design relied on by the opposing party must have been used for the manufacture or marketing of a product.

- 37 However, the fact that a design has never been incorporated into a product is significant only where the applicant has established that the circles specialised in the sector concerned do not generally consult patent registers or that the circles specialised in the sector concerned do not generally attach any weight to patents, in particular American patents. In such scenarios, the argument that there are no umbrellas covered by the earlier patent on the market may make faintly plausible the fact that the earlier patent may have been known to the circles specialised in the sector concerned through other forms of information. In the present case, the fact that the umbrella designated by the earlier patent has never been produced shows that the earlier patent could not have been known to the circles specialised in the sector concerned through advertising, marketing activities or catalogues. However, that fact does not establish that the circles specialised in the sector concerned could not have reasonably gained that knowledge otherwise, such as through an online search in the American patent register.
- 38 Lastly, as to the argument put forward by the applicant to the effect that the United States are not the European Union's principal trading partner in the field of umbrellas, it must be observed that the question whether or not that is the case is not per se decisive for ruling on the question whether the earlier patent could not reasonably be known to the specialised circles. Even if the United States are not the European Union's principal trading partner in the field of umbrellas, it still seems reasonable that a search might be undertaken in the American patent register, since the United States carries at least a certain commercial importance for the circles specialised in that sector operating in the European Union. As the applicant has failed to adduce evidence showing that that market plays only a very minor role in the normal course of business for the circles specialised in the sector concerned, its argument is irrelevant for the outcome of the present dispute.
- 39 In the light of all the foregoing, the conclusion is therefore that the applicant has failed to establish sufficiently that the circumstances of the present case prevented the circles specialised in the sector concerned from learning of the publication of the earlier patent on the USPTO website and thereby learn of the patent. Accordingly, the Board of Appeal did not err in finding that the earlier patent had been made available within the meaning of Article 7(1) of Regulation No 6/2002. The first plea in law relied on by the applicant must therefore be rejected in its entirety.

Consideration of the second plea in law: infringement of Article 6(1) of Regulation No 6/2002

- 40 Under Article 6(1)(b) of Regulation No 6/2002, a registered Community design is to 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 before the date of filing of the application for registration or, if a priority is claimed, the date of priority. Article 6(2) of Regulation No 6/2002 also states that, in assessing that individual character, the degree of freedom of the designer in developing the design must be taken into consideration.

The informed user

- 41 The Board of Appeal defined the informed user as someone wishing to use an umbrella, who needs to purchase one and who has become informed on the subject. The umbrella will be used in accordance with its purpose, which is to protect the user from rain and inclement weather.
- 42 In the application, the applicant seems at first glance to want to extend that concept of the informed user in observing that, in many countries, almost everybody uses an umbrella and

that ‘all other users who are not under the canopy but see the user of the umbrella holding his umbrella’ are therefore also informed users. Reading the application thusly, the intervener and OHIM reply that the concept of the informed user may not include third parties who see an umbrella in the street, but should extend only to persons who wish to use or purchase an umbrella.

- 43 In its reply and at the hearing, the applicant stated that it did not seek to define any third party who sees umbrellas in the street as belonging to the category of informed users, but only any user of an umbrella who sees users of umbrellas around him or her.
- 44 The Court notes that the applicant does not claim that third parties come within the concept of informed user, but that it wishes to emphasise that a person who wishes to purchase and use an umbrella is also led to look around himself or herself and observe other umbrella users. The applicant accordingly concluded, as it reiterated at the hearing, that the informed user perceived not only his or her umbrella from underneath, but also from all perspectives, including before and at the time of his or her purchase or use.
- 45 The question of what are the characteristics and perspectives of an umbrella which determine most the overall impression produced by a design must not be confused with the question of the concept of the informed user. The fact that it is logical for a user to visualise a product from a number of perspectives, including the perspective of a third-party observer prior to purchase or use does not mean that the applicant intends to extend the concept of the informed user to third parties.
- 46 The conclusion, therefore, is that the definition of the informed user adopted by the Board of Appeal is, rightly, not challenged by the applicant.

The level of attention of the informed user

- 47 The Board of Appeal held that the informed user knows the various models of umbrella and the features which they normally have and will show a relatively high degree of attention when s/he is faced with the products concerned.
- 48 The applicant considers that the informed user will focus his or her attention even more strongly on the asymmetrical umbrella because of its unusual shape and because it is a fashion accessory, like sunglasses, shoes or bags.
- 49 OHIM and the intervener dispute the applicant’s arguments.
- 50 It must be borne in mind as a preliminary point that, according to the case-law, the concept of the ‘informed user’, which is not defined in Regulation No 6/2002, must be understood as lying somewhere between that of the average consumer, applicable in trade mark matters, who need not have any specific knowledge and who, as a rule, makes no direct comparison between the trade marks at issue, and the sectorial expert, who is an expert with detailed technical expertise. Thus, the concept of the ‘informed user’ may be understood as referring, not to a user of average attention, but to a particularly observant one, either because of his personal experience or his extensive knowledge of the sector in question (see judgment of 18 October 2012 in *Neuman and Others v José Manuel Baena Grupo*, C-101/11 P and C-102/11 P, ECR, EU:C:2012:641, paragraph 53 and the case-law cited).
- 51 That case-law shows that, unlike the average consumer in the field of trade marks for which the fact of being faced with a fashion accessory may in fact play a role in the consumer’s level of attention (see, to that effect, judgment of 10 November 2011 in *Esprit International v OHIM — Marc O’Polo International (Representation of a letter on a pocket)*, T-22/10,

EU:T:2011:651, paragraph 46), the informed user of a design is already by nature a person who has a particular interest in the design of a given product and who is interested in trends in design, art and fashion which might be behind the emergence of such a design. Thus, the fact that such a product may or may not be considered a fashion accessory is irrelevant for the determination of the level of attention of the informed user.

- 52 As to the second argument put forward by the applicant, to the effect that the level of attention must be regarded as being even higher owing to the unusual shape of the umbrellas covered by the contested designs, the conclusion must be, also in the light of the considerations set out in paragraph 51 above, that the mere fact of being faced with a particular design does not make the informed user more or less attentive, as that user's level of attention is already, by its very nature, relatively high, although a particular or unusual shape or perspective may well change the overall impression produced by the design on the informed user. This aspect will be considered again in the context of the assessment of the overall impression.
- 53 It follows from the foregoing that neither an unusual shape of the umbrellas at issue nor the fact that they may be solely a fashion accessory affects the level of attention of the informed user. Therefore, the definition of the informed user and his or her level of attention as provided by the Board of Appeal is correct.

The degree of freedom of the designer

- 54 The Board of Appeal held that there was 'some degree of design freedom' in the overall shape or size of the canopy and considerable design freedom in terms of the possibilities for varying patterns and colours.
- 55 All parties to the present proceedings consider, as they confirmed at the hearing, that in the present case the designer is limited by technical constraints arising from the wind-resistance function of umbrellas, which places limits on the designer's degree of freedom.
- 56 According to the case-law, the designer's degree of freedom is established by, inter alia, 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 (judgments of 9 September 2011 in *Kwang Yang Motor v OHIM — Honda Giken Kogyo (Internal combustion engine)*, T-11/08, EU:T:2011:447, paragraph 32, and of 25 April 2013 in *Bell & Ross v OHIM — KIN (Wristwatch case)*, T-80/10, EU:T:2013:214, paragraph 112).
- 57 Therefore, the greater the designer's freedom in developing a design, the less likely it is that minor differences between the designs at issue will be sufficient to produce different overall impressions on an informed user. Conversely, the more restricted the designer's freedom in developing a design, the more likely it is that minor differences between the designs at issue will be sufficient to produce different overall impressions on an informed user. Therefore, if the designer enjoys a high degree of freedom in developing a design, that reinforces the conclusion that designs that do not have significant differences produce the same overall impression on an informed user (judgments in *Internal combustion engine*, cited in paragraph 56 above, EU:T:2011:447, paragraph 33, and *Wristwatch case*, cited in paragraph 56 above, EU:T:2013:214, paragraph 113).
- 58 In the present case, it must be observed, firstly, that an umbrella must necessarily have a shaft, a canopy resting on at least three ribs, a handle and eye savers. Although it is true that the umbrella designs may come in unlimited varieties according to the colours and patterns

used for the canopy, those design features have no bearing on the comparison of the umbrella covered by the earlier patent and the umbrellas covered by the contested designs. However, the possibilities for varying the shape of the canopy, which in turn necessarily affects the number of ribs, are rather limited in that the designer may opt for a rectangular, polyangular, round, asymmetrical or atypical shape, such as a heart or star shape, whilst accommodating functional constraints arising from the fact that the canopy must ensure sufficient protection against rain. The designer may also vary the three-dimensional appearance of the canopy to give it a cupola or more flat, conical or pyramidal shape. As regards, inter alia, the handle, the eye savers, the ribs and the shaft, the possibilities for variation are limited, principally because their appearances are to a large extent dictated by the functionality of an umbrella. By contrast, the umbrellas covered by the contested designs are umbrellas intended to be highly wind-resistant. As explained by the parties at the hearing, this wind-resistant function, which the umbrellas covered by the contested designs must perform, places limitations subsequently on the possibilities for varying inter alia the shape and depth of the canopy, ribs and eye savers.

- 59 Accordingly, the conclusion is that the degree of freedom of the designer in the present case is limited, with the result that, in accordance with the case-law cited in paragraph 57 above, even minor differences between the earlier patent and the contested designs suffice to produce different overall impressions on the informed user.

The comparison of the overall impressions produced by the earlier patent and the contested designs

– Comparison of the overhead view

- 60 The Board of Appeal observes that the overhead view of the umbrellas at issue does not show significant differences, since the rib distribution and canopy proportions and spacing are similar to the eye.
- 61 The applicant submits inter alia that the umbrella covered by the earlier patent appears as a regular and, therefore, symmetrical octagon, whereas the contested designs are asymmetrical in shape. Moreover, the umbrella covered by the earlier patent is beak-like in shape, whereas the umbrellas covered by the contested designs terminate in the front and in the back by canopy panels, which is visible inter alia from above.
- 62 OHIM states that the umbrella covered by the earlier patent and the umbrellas covered by the contested designs all have an octagonal shape made up of eight panels separated by ribs and characterised by asymmetrical contours. OHIM acknowledges that the umbrellas covered by the contested designs are more elongated than the umbrella designated by the earlier patent.
- 63 The intervener states that the canopies of the umbrella covered by the earlier patent and the umbrellas covered by the contested designs are similar in terms of rib distribution, canopy proportions, spacing and tops, inter alia because their appearances are to a large extent determined by their functions, including high wind resistance.
- 64 As a preliminary finding, the shape of the umbrella covered by the earlier patent is visibly a regular octagon, whereas the shapes of the umbrellas covered by the contested designs are visibly irregular. Moreover, as rightly observed by the applicant, the umbrella covered by the earlier patent terminates at a tip in the front and in the back, whereas the umbrellas covered by the contested designs terminate in the front and in the back with panels.

- 65 As regards the ribs, it is clear, contrary to what the Board of Appeal stated, that they are not visible when viewed from above on the earlier patent (Fig. 2). That view (Fig. 2) shows the configuration of the panels but not necessarily the ribs, as is clearly shown in the cross-section (Fig. 3) of the umbrella covered by the earlier patent: the rib visible on the left side is situated under only part of the canopy (No 30 of the cross-section) and goes down towards the shaft (No 76 of the cross-section) before going upwards again (No 74 of the cross-section). Therefore, the overhead view does not enable the appearance of the ribs to be deduced.
- 66 However, the configurations of the panels of the canopies of the umbrellas in question are visible. The proportions of the panels are rather similar in appearance, whereas their configurations and especially their distributions are rather different: the umbrella covered by the earlier patent is divided by a straight line going from the back tip to the front tip, whereas the canopies of the umbrellas covered by the contested designs are distributed around the two diagonal lines forming the aforementioned panels at the front and the back.
- 67 Lastly, eye savers are visible on the contested designs. Although it is true, as observed by the intervener, that they do serve an important technical function, that does not mean that their designs are dictated entirely by their technical functions. Thus the eye savers may have different dimensions and colours and may, depending on their size and shape, attract attention. The eye savers on the contested designs, however, are rather small and discreet.
- 68 It follows from the foregoing that the overhead views of the umbrellas covered by the contested designs and the umbrella covered by the earlier patent show differences *inter alia* in terms of canopy shape and panel configuration and position.
- Comparison of the lateral views
- 69 The Board of Appeal, which did not take into consideration the ‘fig.1’ view of the earlier patent, found that the overall impression will to a large extent be determined by the lateral sides of the umbrellas covered by the earlier patent and by the contested designs. Thus the lateral view will be determined principally by the general appearance of the canopy, which in the present case will give the umbrella covered by the earlier patent and the umbrellas covered by the contested designs rather the same overall appearance due to their general asymmetrical ‘beak-like’ elongated appearance of the lateral portion.
- 70 The applicant challenges, first of all, the fact that the Board of Appeal compared the cross-section of the earlier patent and the lateral views of the contested designs. It further submits that the contested designs do not have a ‘beak’ because the umbrellas they represent do not terminate at the front and back tips like the umbrella covered by the earlier patent, but rather panels. [REQ 51] Lastly, they give a different overall impression, their only point in common being the fact that the shapes of the umbrella covered by the earlier patent and the umbrellas covered by the contested designs are asymmetrical.
- 71 OHIM states that, despite there being a few differences in canopy shape in the umbrella covered by the earlier patent and the umbrellas covered by the contested designs, the asymmetrical shape of the umbrellas, including the off-centre positioning of the shaft in relation to the canopy, is the dominant characteristic of the earlier patent and the contested designs. The Board of Appeal, in referring to the ‘beak-like’ shape, meant that the earlier patent and the contested designs evoke the same impression arising from the fact that one side is shorter than the other.
- 72 The intervener in essence concurs with the Board of Appeal’s assessment.

- 73 Regarding the comparison of the cross-section of the earlier patent and the lateral views of the contested designs, the earlier patent has a lateral view, namely Figure No 1 of the earlier patent reproduced in paragraph 5 above. That view was not considered by the Board of Appeal, however. Since, first of all, according to the description of the earlier patent, ‘fig. 1 is a frontal view looking upwards at an asymmetrical umbrella’ and accordingly is merely a general example of that type of product and, secondly, its seams are not very precise or detailed, Figure No 1 cannot be regarded as being a precise reproduction of the lateral view of the umbrella covered by the earlier patent.
- 74 As it does not give a precise reproduction of the lateral view, the earlier patent thus merely provides a cross-section of the umbrella, which must be considered in the analysis of the other perspectives, including the lateral perspective, since those other views may be deduced from the aspects provided by the cross-section. In the present case, the aspects which may be deduced are inter alia the canopy shape and the off-centre positioning of the shaft in relation to the canopy.
- 75 Regarding the canopy shape, it is apparent from the cross-section of the earlier patent that the back part of the canopy is curved, whereas the back part of the umbrella at issue in Case T-22/13 is straight and the back part of the umbrella at issue in Case T-23/13 is made up of two straight, bent ribs. Moreover, the umbrella covered by the earlier patent has a flat top covering roughly a quarter of the diameter of the umbrella, leaving a considerable area of flat surface visible. According to the description of the earlier patent, ribs 24, 22 and 36 curve in from the outer ends of those ribs to join in the central point of the umbrella, whereas, according to Figure 2 and the description of the patent, lines 26, 28, 30, 32 and 34 form the flat surface.
- 76 It is apparent from those considerations concerning the interpretation of the lateral view of the canopy of the umbrella covered by the earlier patent as follows logically from the cross-section and the description of the umbrella in the patent, that that umbrella is characterised by a very particular asymmetrical shape comprising a flat surface. Moreover, the depth of the canopy of the umbrella covered by the earlier patent appears to be much greater than in the contested designs. The canopy shape of the earlier patent resembles rather more a bonnet marked by curved lateral contours and a flat surface in the middle, whereas the design contested in Case T-22/13 has an irregular pyramidal shape and the design contested in Case T-23/13 has a quasi-pyramidal shape with lateral contours marked by ribs made of straight parts. The conclusion is, accordingly, that the lateral view of the canopy of the earlier patent bears significant differences as compared to the canopies of the contested designs.
- Comparison of the views from underneath
- 77 The Board of Appeal took the view that the overall impression will be determined principally not only by the lateral sides but also by the undersides of the earlier patent and the contested designs. It did not, however, conduct an in-depth examination of the view from underneath, instead stating merely that each of the umbrellas compared has eight ribs which are visible from underneath, that the canopy proportions and panel configurations are visible from underneath, but that the perception of the precise curves of the ribs as viewed from underneath will be less obvious for the informed user.
- 78 The applicant submits that the view from underneath will lead the informed user to notice the general appearance of the umbrella as viewed from above, in particular the canopy shape. Moreover, an informed user looking at the top of the umbrellas will notice the rib

construction and the very different proportions and shapes of the umbrella covered by the earlier patent as compared to the umbrellas covered by the contested designs.

- 79 OHIM and the intervener concur in essence with the Board of Appeal's analysis.
- 80 Neither the earlier patent nor the contested designs contain a view from underneath. Consequently, the views from underneath can be taken into account only in so far as they may be deduced from the other views. Thus, the view from underneath corresponds to the overhead view in that the user will be able to recognise the panel configuration and proportions and the curved, flat or straight shapes of the canopies. So far as the earlier patent reproduces the rib mechanism (Fig. 3), it is possible to deduce therefrom the view from underneath the ribs, including the fact that they do not meet in a straight, direct line at the shaft, but are oriented in an off-centred manner towards the tip (Fig. 3 No 40) of the umbrella. In the contested designs, it is possible to deduce from the overhead views *inter alia* the fact that the ribs are linked to the bends which form between the panels.
- 81 It follows from the foregoing that, in so far as those views may be compared, there are also differences in the views from underneath.
- Assessment of the comparisons made
- 82 The Board of Appeal considered that the overall impressions produced by the umbrella covered by the earlier patent and the umbrellas covered by the contested designs are determined principally by the undersides and lateral sides, that the informed user's attention will be drawn to the basic structures and not the details, that all the umbrellas examined in essence have the same elongated, asymmetrical appearance and that in essence they produce the same overall impression.
- 83 The applicant submits that, *inter alia* because of the differences identified for the overhead and side views, the overall impression produced by the umbrellas covered by the contested designs was different from that produced by the umbrella covered by the earlier patent.
- 84 In OHIM's submission, the principal feature of the earlier patent and the contested designs is the off-centre positioning of the shaft in relation to the canopy. The impact of such an unusual feature is 'greater' because the informed user has only one point of comparison. The situation of the present case is comparable to a situation in which a person who has never seen an aircraft, when faced with the images of an Airbus A 380 and a Concorde, considers that the two aircraft are largely similar.
- 85 The intervener stresses *inter alia* the importance of the view from underneath, as the user views the umbrella mostly at the time of use. The intervener also considers that the general elongated, asymmetrical appearance is the most important common feature of the umbrella covered by the earlier patent and the umbrellas covered by the contested designs, whilst the differences highlighted by the applicant are of only minor importance. Lastly, the shape of the canopies on the umbrellas covered by the contested designs is due to aerodynamic constraints and cannot therefore be taken into consideration in the assessment of individual character.
- 86 In order to determine whether the contested designs have individual character in relation to the earlier patent, account must be taken of the comparisons made of different views, the degree of attention shown by the informed user and the degree of freedom of the designer in the development of the design.

- 87 As regards the informed user, the definition provided by the Board of Appeal, according to which the informed user is someone wishing to use an umbrella, who needs to purchase one and who has become informed on the subject, has been accepted. The informed user also knows the different models of umbrella and their usual features and shows a relatively high level of attention in respect of the products concerned.
- 88 The designer's degree of freedom has been held to be limited.
- 89 The comparison of the umbrella covered by the earlier patent with the umbrellas covered by the contested designs has shown that all the umbrellas are asymmetrical in appearance in that their shafts are positioned off-centre in relation to their canopies.
- 90 As to the comparison of the different views of the umbrella covered by the earlier patent and the umbrellas covered by the contested designs, it has been found that the overhead views are different, that the views from underneath, which can be taken into account only in so far as they can be deduced from the other views, comprise the same differences and that the lateral views, in terms of the lateral view of the earlier patent in so far as it can be deduced from the cross-intersection (Fig. 3), comprise significant differences.
- 91 The umbrella covered by the earlier patent has a flat surface in the middle and is characterised by curved lateral contours resting on a regular octagon, whereas the design contested in Case T-22/13 has an irregular pyramidal shape and the design contested in Case T-23/13 has a quasi-pyramidal shape with slightly bent lateral contours marked by ribs made up of straight parts. The umbrellas covered by the contested designs are also resting on an elongated, irregular octagon.
- 92 The umbrella covered by the earlier patent has curved ribs, whereas the design contested in Case T-22/13 has straight ribs and the design contested in Case T-23/13 has two ribs in the back made up of three straight parts bent towards the back and six ribs made up of two straight parts bent towards the front or towards the sides.
- 93 In the light of those observations, the conclusion is that it is the canopy shapes which characterise the overall impressions produced by the earlier patent and by the contested designs and which gives each of the umbrellas examined a very specific and, therefore, individual character within the meaning of Article 6(1) of Regulation No 6/2002.
- 94 That conclusion cannot be called into question by the arguments put forward by OHIM and the intervener.
- 95 First of all, as regards the comparison between the situation in the present case and the situation where someone who has never seen an aircraft before and for the first time sees a Concorde and an Airbus A 380, the conclusion is that a user faced for the first time with an asymmetrical umbrella cannot be likened to the user described by OHIM. The appearance of an asymmetrical umbrella may be regarded as innovative or even original, but it is not so striking that a user would lose sight of all the other remarkable features of the umbrella. Moreover, if OHIM's line of argument were to be followed, it would lead to a situation where the proprietor of the first design registered for a new product could prevent protection of any subsequent design concerning the same category of products on the sole ground that the new and unusual character of the design of the first model no longer allows for identification and perception of differences in subsequent models or, to put it another way, that the first design protected precludes, for the duration of its protection, any future design concerning the same type of product. It goes without saying that such a position is completely untenable. Contrary to OHIM's submission, nor is support for the approach it advocates to be drawn from the judgment of 13 November 2012 in *Antrax It v OHIM* —

THC (Radiators for heating) (T-83/11 and T-84/11, ECR, EU:T:2012:592), in which the Court of Justice stated, in paragraph 89, that a possible saturation of the state of the art, deriving from the alleged existence of other designs for thermosiphons or radiators which have the same overall features as the designs at issue, was relevant, in so far as it could be capable of making the informed user more attentive to the differences in the internal proportions of those different designs. There is nothing in that case-law to support the position that a user confronted with two new and unusual designs, which in the present case have significant differences, is no longer able to perceive those differences solely because one of the characteristic features of those designs is the same for both.

- 96 Secondly, as to the argument put forward a number of times by OHIM and the intervener, to the effect that the off-centre positioning in relation to the canopy is the dominant feature of the earlier patent and the contested designs, with the result that it dominates the informed user's perception, it must be observed that the off-centre positioning is perceived strongly only if the comparison is made only with a more usual type of umbrella model, that is to say, a symmetrical umbrella. By contrast, when two asymmetrical umbrellas are to be compared, the mere fact that they both are asymmetrical does not preclude the overall impression produced by the umbrellas from being different.
- 97 Thirdly, the fact that the user views the umbrella inter alia from underneath is also irrelevant to the assessment of the individual character of the contested designs. In attaching greater weight to the perception of the umbrellas from the perspective of underneath, the Board of Appeal disregards the fact that the designs are rights protecting the appearance as it results from specific designs and not perspectives which have not been reproduced in those designs. Moreover, if decisive weight were to be attached to the perspective during use for the assessment of the perception of an appearance by the user, all the objects which the user puts on (such as clothing), wears (such as hats, bonnets, glasses or helmets) or on or in which the user may habitually find himself or herself (such as bicycles), are, in principle, devoid of individual character because they have no distinctive appearance when used (glasses, helmets, hats) or a barely perceptible appearance and similar contours (bicycles, clothing). Clearly such a consequence does not reflect the reality in which the user makes his or her decision to purchase and decision to use these types of objects, which in most cases is based on their design. Moreover, even if the user sees certain products from only a limited perspective when using them, he or she will be aware of all the other perspectives at the time of use.
- 98 Fourthly, the conclusion that the contested designs each have individual character in relation to the umbrella covered by the earlier patent is not contradictory with the judgment of 9 September 2011 in *Kwang Yang Motor v OHIM — Honda Giken Kogyo (Combustion engine with the vent on the top)* (T-10/08, EU:T:2011:446) cited by the Board of Appeal in paragraph 19 of the contested decision. That case concerned a lawnmower. In paragraph 22 of that judgment the Court held that the user, standing behind the lawnmower, sees the engine from the top and therefore sees principally the upper side of the engine. It follows that the upper side of the engine determines the overall impression produced by the engine. Unlike products which the user can easily turn over and around and thus observe from any perspective, the engine of a lawnmower can be seen from another angle than from above only with difficulty. It goes without saying that the user will not engage in such behaviour when observing, purchasing or using a lawnmower. However, there is no reason to suppose that the informed user should not see an umbrella from above or the sides before making his or her purchasing decision.
- 99 Fifthly, as to the argument put forward inter alia by the intervener, with which OHIM also concurred in its final observations at the hearing, to the effect that the shape of the canopy is

the result of aerodynamic constraints, which is why it cannot be taken into consideration, or only to a lesser degree, in the assessment of individual character of the umbrella covered by the earlier patent and the umbrellas covered by the contested designs, it must be borne in mind that, under Article 8(1) of Regulation No 6/2002, a design does not subsist in the features of a product's appearance which are solely dictated by its technical function.

- 100 The Court observes, first, that the Board of Appeal, in paragraph 29 of each of the contested decisions, found only that '[d]ifferences between the umbrellas ... also depend on aerodynamic considerations rather than pure aesthetic design'. Nor did it examine to what extent the features of the appearance of the contested designs were 'solely' dictated by their function.
- 101 The Court also observes that Regulation No 6/2002 does not provide for a limitation of protection for designs and those of their features which (also) fulfil a technical function. It is only when one or more features of a product's appearance are dictated solely by its technical function that that regulation provides that such a feature must not be taken into account for the purposes of such an assessment of individual character. The Board of Appeal therefore erred in attaching only limited importance to the features which also resulted from the wind-resistance function of the umbrellas covered by the contested designs for the purpose of assessing the individual character of those designs.
- 102 It follows from all the foregoing that the Board of Appeal erred in concluding that the contested designs do not have individual character. The applicant's second plea is therefore admissible. The action must therefore be upheld and the contested decision annulled.

The intervener's claim seeking to have the Court declare the contested designs invalid

- 103 In the absence of any argument put forward by the intervener to justify its claim seeking to have the Court declare the contested designs invalid, that claim can only be rejected.

Costs

- 104 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. The applicant has asked for the intervener to be ordered to bear its own costs and to pay the applicant's costs and for OHIM to be ordered to bear its own costs, and has accordingly not asked for OHIM to be ordered to pay the costs. In those circumstances, it is appropriate to order the intervener to bear its own costs and to pay one third of the applicant's costs. The applicant shall bear two thirds of its own costs and OHIM shall bear its own costs.

On those grounds,

THE GENERAL COURT (Fifth Chamber)

hereby:

- 1. Annuls the decisions of the Third Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 26 September 2012 (Cases R 2453/2010-3 and R 2459/2010-3);**
- 2. Orders Impliva BV to bear its own costs and to pay one third of the costs of Senz Technologies BV;**

3. Orders Senz Technologies to bear two thirds of its own costs;

4. Orders OHIM to bear its own costs.

Dittrich

Szwarcz

Tomljenović

Delivered in open court in Luxembourg on 21 May 2015.

[Signatures]

* Language of the case: English.

1 This judgment is published in extract form.