



**DECISION**  
**of the Third Board of Appeal**  
**of 28 July 2009**

In case R 921/2008-3

**Věra Šindelářová**  
Mládežnická 148  
CZ-435 41 Litvínov  
Czech Republic

Appellant/Design Holder

v

**Blažek Glass s.r.o.**  
Olbrachtova 600/II  
CZ-290 01 Poděbrady  
Czech Republic

Respondent/Invalidity Applicant

represented by Reichel & kol., patentová kancelář, Záhřebská 30, CZ-120 00 Praha 2,  
Czech Republic

APPEAL relating to Invalidity Proceedings No ICD 4562 (Registered Community  
Design No 000 609 078 - 0 002)

**THE THIRD BOARD OF APPEAL**

composed of Th. Margellos (Chairperson), M. Bra (Rapporteur) and D. T. Keeling  
(Member)

Registrar: J. Pinkowski

gives the following

## Decision

### *Summary of the facts*

- 1 By an application filed and registered on 9 October 2006, Věra Šindelářová (hereinafter ‘the design holder’) sought to register a Community Design whose single view is represented hereunder



in respect of the following product:

‘Nail files’.

In the box titled ‘indication of products’, the application contained the following description:

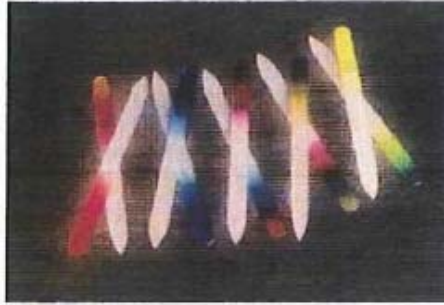
‘Glass nail file with colourful hold

Indication of the products

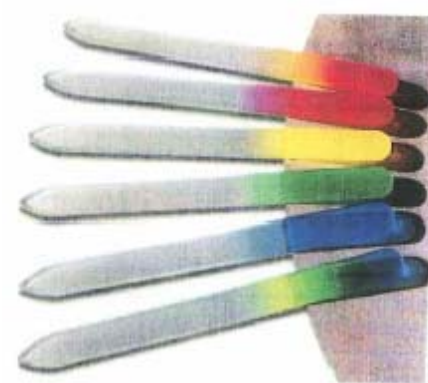
The subject matter of the industrial design is visible from the representation attached which depicts each variants of the colourful hold of the glass nail files designed for the cosmetic care of the nails and for cosmetic removal of hard skins’.

- 2 The Community Design was registered under No 000 609 078-0 002 and was published in the Community Designs Bulletin No 2007/067 of 24 April 2007.
- 3 On 9 November 2007, J. Blažek Sklo Poděbrady s.r.o. (hereinafter ‘the invalidity applicant’), filed an application for a declaration of invalidity of the Community Design (hereinafter ‘the contested design’), on the grounds that it does not fulfil the requirements of novelty and/or individual character, under Articles 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). As evidence, it provided *inter alia*, the following :

- D1: copy of a leaflet in German, titled ‘Heart of Glass Distribution’, ‘Die gläserne Nagelfeile’, ‘Auszug aus der Collection 2000’(with handwritten translation: ‘the glass nail files, Excerpts from the 2000 Collection ), also containing a price list for nail files, contact details in Germany and a trademark ‘Handmade J. Blažek Bohemian Crystal’ showing *inter alia*, the following picture of glass nail files



- D2: copy of an advertising printed material, titled ‘Finigrama®’, ‘Die gläserne Maniküre-Feile’ by a German company Treibholz, also containing a price list for various types of nail files, dated with ‘gültig ab 15.10.2001’, and showing *inter alia*, the following picture.



- On 6 February 2008, the design holder submitted observations in reply, putting forward the following arguments:
  - The ‘time priority’ is in favour of the design holder. While the invalidity applicant claims to have offered nail files with coloured holds since 2000, the design holder had traded glass nail files with colouring, as registered, as early as 1998 or 1999. In support of its claims, the design holder filed ‘exports forms’ bearing the official stamps of customs authorities from the Czech Republic and Germany and written statements from two companies, ALAP Ltd and PENTA Ltd, in the Czech Republic.
  - The invalidity applicant’s claim that the contested design lacks novelty flows from ‘an erroneous interpretation of the essence of the [contested design]’. The dominant feature and subject matter of protection of the contested design is the colour design of the holds – not the shape of the nail files. Moreover,

the ‘Prague Industrial Ownership Authority, Czech Republic, has protected the possible individual shapes for [the design holder]’.

- 5 On 31 March 2008 the Invalidity Division issued a decision (hereinafter: ‘the contested decision’) declaring the contested design invalid pursuant to Article 25(1)(b) CDR and ordered the design holder to bear the costs. The reasons may be summarized as follows:

*Evidence:*

- The leaflet filed (D1), bearing the line ‘excerpt from Collection 2000’, supported by the invalidity applicant’s statement that this is the leaflet of ‘collection for the year 2000 of glass nail files manufactured by J. Blažek, intended for distribution in Germany’, proves that the designs disclosed therein were made available to the public in 2000, that is prior to the filing date of the contested design. The design holder does not dispute this evidence.
- The printed advertising material filed (D2), containing the price list for these nail files ‘valid from 15.10.2001’, supported by the invalidity applicant’s statement that these products were intended for distribution in Germany, proves that the designs disclosed in D1, were made available to the public in 2001, thus prior to the filing date of the contested design.

*On novelty:*

- The prior design with a pinkish-red lateral part (i.e. the first from the left, in D1 and the second from the top, in D2) and the contested design, all concern a design of a nail file, with a simple elongated strip-like form, in the same configuration and almost the same proportions (straight and parallel longer sides, the short side being rounded and the other one being sharply pointed). All contain a colour feature, whereby the three fifths of the nail file at the pointed side are coloured white and two fifths at the rounded side are coloured in a darker colour, preferentially in a hue of a pinkish-red colour, which is concentrated almost all along the lateral two fifths of the file and gets slightly dispersed at its medial edge, where it gradually and hazily transits into white towards the middle of the strip. The prior design in D1 and D2 and the contested design differ slightly in the hue of the pinkish-red colour: whereas in the contested design this colour is slightly more pink than red, in the prior designs it is slightly more red than pink, but this is an immaterial detail.
  - Since almost all of the features of the prior design and the contested design are the same, the two designs are identical. Thus, the contested design lacks novelty over the prior design in D1.
- 6 On 16 June 2008, the design holder filed an appeal, followed by the statement of grounds, filed on 8 August 2008.
- 7 On 23 October 2008 the invalidity applicant submitted its observations.

- 8 On 22 December 2008, the representative of design holder informed the Office about the change of company name of its client from ‘J. Blažek Sklo Poděbrady s.r.o.’ to ‘Blažek Glass s.r.o.’.

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

- 9 The design holder requests that the contested decision be annulled and that the contested design to be declared valid, putting forward the following arguments:
- The Office erroneously based its assessment on a comparison of the respective products of the parties as they appear on photographic materials. Only a physical comparison of the respective products of the parties could unambiguously testify their identity, or difference, whilst it would have to be established that the products were manufactured prior to the filing date of the contested design.
  - The pictures submitted by the invalidity applicant confirm that the products are different: the shapes are different particularly insofar as the top/pointed part of the invalidity applicant’s product has a continuous rounding end, while the design holder’s nail file ends with two opposite sharp edges and the colour is markedly different. These marked differences were the reasons why the holder’s product was submitted for registration as an industrial design and thus, it is undoubtedly novel.
- 10 The invalidity applicant requests the contested decision to be confirmed, reiterating in substance the arguments put forward in front of the Invalidity Division, further adding the following:
- The comparison was correctly carried out between the illustration of the nail file of the contested design and the almost identical nail files in the documents filed. A detailed comparison cannot be made with the nail file actually marketed by the design holder, which is not available, but only with the illustration of the nail file which is the subject of the contested design.
  - It is unclear whether the simple view of the nail file submitted with the contested design application, actually corresponds to the nail files which, according to the design holder, it was already offering on the market in 1999, i.e. several years before filing its contested design.

### **Reasons**

- 11 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.

- 12 The appeal is not well founded. The contested decision rightly held that the contested design lacks novelty, within the meaning of Article 5 CDR, because it only differs in an immaterial detail from the prior design.
- 13 Novelty is defined by Article 5 CDR in the following terms:
- ‘1. A design shall be considered to be new if no identical design has been made available to the public:
- (a) ...
- (b) in the case of a registered Community design, before the date of filing of the application for registration of the design for which protection is claimed, or, if priority is claimed, the date of priority.
2. Designs shall be deemed to be identical if their features differ only in immaterial details.’
- 14 Article 7 CDR, regarding disclosure, provides, insofar as relevant, the following:
- ‘1. For 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. The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.
2. A disclosure shall not be taken into consideration for the purpose of applying Articles 5 and 6 and if a design for which protection is claimed under a registered Community design has been made available to the public:
- (a) by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer or his successor in title; and
- (b) during the 12-month period preceding the date of filing of the application or, if a priority is claimed, the date of priority.

*Disclosure of the Prior design*

- 15 The design holder does not dispute the contested decision’s finding that the documents D1 and D2, supported by the applicant’s statements, prove that the designs disclosed therein were made available to the public, respectively in 2000 and in 2001, that is prior to the filing date of the contested design. The Board thereby endorses the contested decision’s finding that since these designs were made available to the public before the filing date of the contested design, they may be regarded as prior designs within the meaning of Article 7 CDR.

- 16 In the first instance proceedings, the design holder rather claimed that the ‘time priority’ would be in its favour, as it would have traded glass nail files with colour holds covered by the contested design, ‘as early as 1998 or 1999’.
- 17 The Board notes that the design holder’s claims could be self-destructive for the validity of the registered design. Indeed, it results from Article 7(2) CDR *a contrario* that a disclosure of the design, made by the designer itself (or its successor in title), prior to the 12-month grace period provided in point (b), must be taken into account when assessing the novelty and individual character of the design under Articles 5 and 6 CDR. Since in the present case, the contested design was filed and registered on 9 October 2006, without any claim of priority, the 12-month grace period, provided in Article 7(2)(b), within which a disclosure by the design holder itself would not destroy the novelty of the design, goes back to 9 October 2005. Therefore, had it been established that the nail files covered by the contested design had already been offered on the market by the design holder (or disclosed by its publication as a registered design, in the Czech Republic), ‘as early as 1998 and 1999’, as she claims, such a disclosure made ‘several years’ before filing the contested design, in 2006, would *in itself* destroy the novelty of the contested design, pursuant to Article 7(2) CDR.
- 18 However, as rightly pointed out by the invalidity applicant, the documents filed by the design holder do not allow to conclude that the nail files, referred to in these documents, were actually those covered by the contested design. Indeed, the design holder did not produce the alleged registration of the contested design, in the Czech Republic. Moreover, neither the ‘transport documents’ (CMR forms), nor the written statements from ALAP Ltd and PENTA Ltd, contain any picture, any complete and precise description or other reference, whereby it could be unambiguously inferred that the nail files referred to in these documents were precisely those covered by the contested design. Therefore, it is impossible for the Board to further examine the design holder’s claim, which in any case, could not change the outcome in her favour.

#### *Novelty*

- 19 The design holder disputes the alleged lack of novelty of the contested design, putting forward various arguments.
- 20 Firstly, the Board cannot sustain the design holder’s claim that the assessment of the novelty and individual character of the contested design with respect to the Prior design, could only rest on a physical examination of the respective products. It must firstly be noted that often, the contested design would not correspond to products actually put on the marketplace (or even produced), or could be a new variant of a design of products previously put on the market. Also, the prior design itself need not necessarily have been ‘used in trade’: any design which was disclosed to the public, either by being ‘published following registration or otherwise, or exhibited, or otherwise disclosed’, can also constitute a prior design, pursuant to Article 7(1) CDR. Therefore, a physical comparison of the products is in many cases impossible. Such a physical comparison is also irrelevant, since the Office must assess the novelty and individual character of the contested design ‘as registered’, i.e. ‘as represented in the views attached to the

application, taking into account the description eventually provided therein. The contested design must be compared to the prior design, ‘as it was disclosed’ to the public, according to the evidence filed by the invalidity applicant. In this respect, it must be pointed out that the invalidity applicant is free to decide which means of evidence is more appropriate to its case: filing samples of the product itself, might be useful in certain cases, but is not an absolute requirement, provided that the evidence filed contains representations (e.g. plans, pictures, etc.), which adequately represent the prior design and allow the Office to compare it with the contested design.

- 21 In this case, the contested decision rightly found that the representations contained in two of the documents filed (D1 and D2), were sufficiently clear to allow the Office to compare the prior design with the contested design.
- 22 Regarding the actual comparison of the designs at issue, the design holder claimed in the first instance proceedings, that the alleged lack of novelty flowed from an ‘erroneous interpretation of the essence of the design’, pointing out that the contested design aims to protect the colour design of the holds of the glass nail files, not their shape. The Board notes that this is confirmed by the description provided in the application, where it is stated (in the box titled ‘indication of products’): ‘The subject matter of the design is [...] the colourful hold of the glass nail files [...]’.
- 23 Even so, the design holder’s claim, that the contested design and the prior designs would contain any ‘marked differences’ in shape and colour pattern, is not supported by the evidence in the file and cannot be sustained.
- 24 The contested design has been registered in respect of a ‘nail file’. Based on the view filed in the application and taking into account the description provided therein, the contested design is characterized by (a) a shape of an elongated strip, rounded to one end and pointy at the other end (b) a colour pattern, whereby the pointed side is white and the rounded side is in pinkish-red colour, gradually fading off into white, at about two fifths of the length of the nail file (c) the glass (or similar) material.
- 25 The prior designs in Attachments D1 and D2 feature glass nail files of the same shape (contrary to the design holder’s claim) and of the same colour pattern, as rightly pointed out in the contested decision. The only difference is a slight variation in the shade of the colour pattern: in the contested design, the pinkish-red colour appears to be slightly more pink than red, whereas in the prior designs it appears to be slightly more red, than pink. The Board concurs that this amounts to no more than a hardly noticeable difference in a detail.
- 26 Therefore, the contested decision rightly held that the contested design only differs from the prior design in an immaterial detail.
- 27 Since the contested design reproduces all the characteristic features of the prior designs and its features differ only in an immaterial detail, the designs must be deemed to be identical within the meaning of Article 5(2) CDR.



- 28 Therefore, the contested decision rightly declared the contested design invalid, for lack of novelty, based on Article 25(1)(b) CDR. The appeal must be dismissed.

**Costs**

- 29 Since the appeal is unsuccessful, the design holder must be ordered to bear the fees and costs incurred by the invalidity applicant, in accordance with Article 70(1) CDR.

**Order**

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the design holder to bear the fees and costs incurred by the invalidity applicant, in the appeal proceedings.**

Th. Margellos

M. Bra

D. T. Keeling

Registrar:

J. Pinkovski