



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

The Boards of Appeal

**DECISION
of the Third Board of Appeal
of 11 December 2009**

In Case R 608/2009-3

Reinhold Gerstenmeyer AB

Sveaparken, 24 A
S-702 25 Örebro
Sweden

Proprietor / Appellant

represented by AlbiHns AB, Linnégatan 2, S-114 85 Stockholm, Sweden

v

B-NU Limited

5 Liberty Square
Kings Hill
West Malling
Kent ME19 4AU
United Kingdom

Invalidity applicant / Respondent

represented by Mathew Forde, 11b English Street, Downpatrick, Co. Down BT30
6AB, Northern Ireland, United Kingdom

APPEAL relating to Invalidity Proceedings No 6104 (registered Community design
No 000683701-0001)

THE THIRD BOARD OF APPEAL

composed of Th. Margellos (Chairperson and Rapporteur), H. Salmi (Member) and
M. Bra (Member)

Registrar: J. Pinkowski

gives the following

Decision

Summary of the facts

- 1 Reinhold Gerstenmeyer AB ('the proprietor') is the holder of registered Community design No 000683701-0001 ('the RCD'), which has a filing date of 6 March 2007 and a priority claim from 7 December 2006. It registered for the product 'boots' and is represented in the following views:



- 2 On 4 November 2008, B-NU Limited ('the invalidity applicant') filed an application for a declaration of invalidity against the contested RCD pursuant to Article 25(1)(b) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs ('CDR') (OJ EC 2002 No L 3, p 1). The invalidity applicant invoked Articles 4 to 9 CDR and claimed that the RCD lacked novelty according

to Article 5(1)(b) CDR since an identical design had been made available to the public as early as 2002 ('prior design').

3 The applicant made the following remarks in support of its claims:

- The prior design, called the 'Arctic Trail' was designed by two employees of the UK footwear company, British Bata Limited ('BBL') in 2001. BBL went into voluntary administration in September 2006 and was dissolved on 13 May 2008;
- From 2002 to September 2006, BBL produced and marketed the 'Arctic Trail' boot;
- The proprietor placed numerous orders with BBL for the 'Arctic Trail' boot. On 5 August 2005, an invoice was rendered by BBL to one of the proprietor's clients for the supply of 1 044 pairs of 'Arctic Trail' boots (see exhibit JMH7 annexed to the statement of Joanne Mary Hill, the former managing director of BBL);
- The RCD and the prior design are identical. There are no material differences. Both designs have been produced using the same nickel production mould by the Malaysian undertaking. BBL sold the nickel mould to that undertaking (see the asset sale agreement referred to below).

4 The following documents were submitted:

- Statement of Joanne Mary Hill dated 27 October 2008 together with exhibits to which that statement refers: Agreement on the sale of assets by BBL to a Malaysian undertaking; 'Arctic Trail' sales summary 2002-2006; various sales invoices (Annex 2);
- Statement of Adrian John Martin, the former logistics manager of BBL, dated 27 October 2008 together with supporting invoices rendered to undertakings in Norway, Denmark, Finland, Sweden, UK and Canada in exhibit AJM1 and copy bills of lading for the shipments of boots to Oslo and Gothenburg in exhibit AJM2 (Annex 3);
- A document dated 19 February 2008 signed by the former employees of BBL; designers who it is claimed were the creators of the prior design (Annex 4);
- 'Arctic Trail' footwear specifications dated January 2004 depicting images of the prior design (Annex 5);
- BBL product catalogue dated May 2005 depicting images of the prior design (Annex 6);
- 'Arctic Trail' Sales Summary 2002-2006 (Annex 7).

- 5 On 22 January 2009, the proprietor replied by stating that Camilla Gerstenmeyer was the creator of both the RCD and the prior design.
- 6 On 2 February 2009, the invalidity applicant responded by pointing out that the proprietor did not dispute the grounds for invalidity invoked and did not raise any new issues or facts.
- 7 On 31 March 2009 the Invalidity Division of the Office issued a decision ('the contested decision') declaring the contested RCD invalid for lack of novelty according to Article 25(1)(b) CDR and ordered the proprietor to bear the costs. The reasoning in the contested decision may be summarized as follows:
 - The documentation annexed to the statement of the former managing director show that the prior design was made available to the public more than twelve months prior to the date of filing of the RCD and was, therefore, disclosed.
 - Since the disclosure of the prior design falls outside the grace period in Article 7(2) CDR, it is of no relevance whether the designer of the RCD is the same as the designer of the prior design.
 - The RCD and the prior design disclosed have the same appearance resulting from the lines, contours, colours and shape except for immaterial details. Hence the RCD and the prior design are identical.
- 8 On 29 May 2009, the proprietor filed a notice of appeal against the contested decision together with the statement of grounds.
- 9 On 5 June 2009, the invalidity applicant submitted its observations.
- 10 The proprietor did not reply.

Submissions and arguments of the parties

- 11 The proprietor requests the Board to annul the contested decision and reject the application for declaration of invalidity given that it was Camilla Gerstenmeyer, and not BBL's employees, who was the creator and designer of both the RCD and the prior design. It maintains that BBL's employees were merely involved in the development of the prototypes and transforming the drawings into the boot production moulds.
- 12 The invalidity applicant responds by contending that the proprietor's grounds of appeal are irrelevant since, as stated in the contested decision, it is of no relevance who the designer of the prior design was.

Reasons

- 13 The appeal complies with Articles 55 to 57 CDR and Article 34(1)(c) and (2) of Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community designs ('CDIR') (OJ EC 2002 No L 341, p. 28). It is therefore admissible.
- 14 Article 25(1)(b) CDR provides that a Community design may be declared invalid if it does not fulfil the requirements of Articles 4 to 9 CDR.
- 15 The proprietor has not at any stage, before the Invalidity Division of the Office or before the Board, contested the identity of the RCD and the prior design within the meaning of Article 5 CDR.
- 16 Nor has the proprietor contested the finding in the contested decision that, the prior design was produced and sold, and hence, disclosed in 2004, that is before the priority date of the RCD within the meaning of Article 7(1) CDR. There can be no doubt that a design identical to the RCD referred to as the 'Arctic Trail' boot, appearing in the product brochures dated May 2005, and the product specifications dated January 2004, was produced and sold, according to various invoices bearing dates in 2004, to undertakings in Norway and Sweden.
- 17 The proprietor has merely alleged throughout that the creator and designer of the prior design, which is identical to the RCD, is Camilla Gerstenmeyer.
- 18 Article 7(2) CDR provides that 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.
- 19 Since it has been established that the prior design, which is identical to the RCD, was disclosed in 2004 well before the 12-month period preceding the date of priority claimed of 7 December 2006, it is of no consequence, as rightly pointed out in the contested decision, whether Camilla Gerstenmeyer was the designer or BBL's employees were the designers of the prior design.
- 20 For the above reasons, the appeal is dismissed and the contested decision declaring the registered Community design invalid for lack of novelty is upheld.

Comment: 1The font here and in the next para. has changed to 11.5, please change it to 12pt.

Costs

- 21 Since the appeal has been unsuccessful, the proprietor 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 proprietor to bear the fees and costs incurred by the invalidity applicant.**

Th. Margellos

H.Salmi

M. Bra

Registrar:

J. Pinkowski