



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

The Boards of Appeal

**DECISION**  
**of the Third Board of Appeal**  
**of 2 September 2008**

In case R 196/2008-3

**Imperial International Limited**

Forward Park, Sheene Road  
Gorse Hill, Beaumont Leys, Leicester  
LE4 1BF  
United Kingdom

Design Holder/Appellant

represented by SERJEANTS, 25 The Crescent, King Street, Leicester LE1 6RX,  
United Kingdom

v

**Handl Cookware Limited**

Myland Lodge, 301A Mile End Road  
Colchester, Essex CO4 5EA  
United Kingdom

Invalidity Applicant/Respondent

represented by Briffa Solicitors, Business Design Centre, 52 Upper Street, Islington,  
London N1 0QH, United Kingdom

APPEAL relating to Registered Community Design application No 000 123 013-  
000 1

**THE THIRD BOARD OF APPEAL**

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

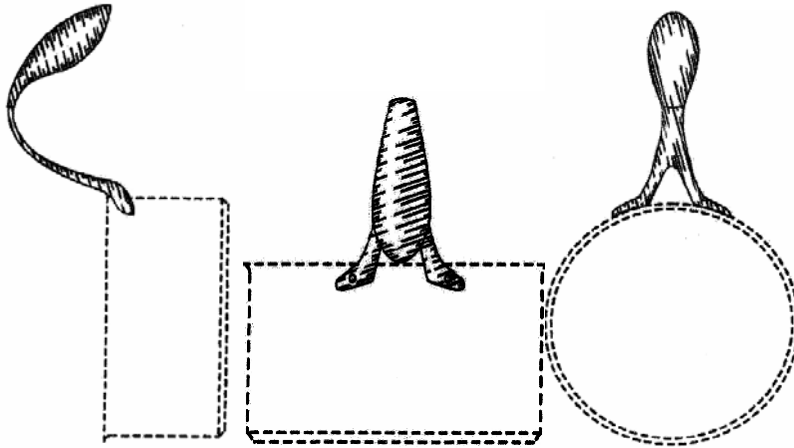
Registrar: J. Pinkowski

gives the following

## Decision

### Summary of the facts

- 1 On 19 January 2004 Imperial International Limited (hereinafter, the design proprietor) filed an application to register a Community Design whose three views are represented hereunder



in respect of the following product:

‘A handle for a saucepan’.

- 2 The Community Design was registered under No 000 123 013-0 001 and published in the Bulletin of 20 April 2004.
- 3 On 7 March 2006 Handl Cookware Limited (hereinafter, the applicant for invalidity) filed an application in order to declare the invalidity of the Community Design. In the statement of grounds attached to the application of invalidity it indicated that the design ‘is not novel’ because it was ‘disclosed’ in earlier publications, namely:
  - a) British Registered Design No 210 637, filed on 19 June 2001 and granted as of the same date, for a saucepan represented hereunder



invalid due to ‘lack of individual character’. Upon the appeal of the design proprietor, this decision was annulled (R-1456/2006-3). The Board considered, in essence, that the issue of novelty was not properly examined by the Invalidity Division and the distinction between the invalidity ground of ‘lack of novelty’ and that of ‘lack of individual character blurred. The Board noted that the only ground invoked by the applicant for cancellation was lack of novelty. The case was thus remitted to the Invalidity Division for further prosecution.

- 5 On 21 November 2007 the Invalidity Division issued a new (hereinafter the ‘contested’ decision) whereby it declared the Community Design invalid. The contents of the decision were the following:
  - As regards the admissibility of the application: the indication that the Community Design ‘is not novel’ is itself a statement of the grounds within the meaning of Article 28 (1)(b)(i) of Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community designs (‘CDIR’) (OJ EC No L 341, p. 28); therefore the application is admissible;
  - Comparing the handle of the Community Design with the handle of the prior [British] design no significant difference can be discerned. The side view does not reveal that the ‘length of the handle is significantly increased’, as claimed by the design proprietor. Similarly, the arch produced by the line of the handle is not ‘higher and more arcuate’. The fixing of the handle is also very similar in both designs, as can be seen in the top view and the rear view.
  - Since the saucepan is disclaimed, the subject matter of the design is the handle only and features such as ‘higher position’ of the handle and the ‘balance with the saucepan’ are not part of the design;
  - The RCD and the prior design are identical and differ only in immaterial features. The RCD is not new with the meaning of Article 5 RCD.
- 6 The design proprietor filed an appeal on 18 January 2008 followed by the statement of grounds on 25 March 2008. The applicant for invalidity did not respond.

### **Grounds of appeal**

- 7 The design proprietor requests annulment of the contested decision and a ruling that the Community Design is valid having regard to the prior design cited in the decision. These are the grounds:
  - The design proprietor extensively described in these proceedings the differences between the conflicting designs: ‘(i) the upsweep of the handle of the contested design from its anchorage point against the side of the saucepan is longer and takes a steeper angle to the vertical than in the prior

design; (ii) the down-turned portion of the handle of the contested design assumes a different angle to the vertical than in the prior design (with the result that the arch between the upsweep and the handle gripping portion is higher and more acute in the contested design as compared to the prior design); (iii) the distal end of the handle of the contested design is above the level at which the proximal end is secured to the saucepan side as opposed to being marginally below that level in the prior design. A drawing was already submitted in the Appeal R 1456/2006-3 which highlights these differences.

- The design at issue is a pan handle. Therefore, the intended user would be a pan manufacturer who has to decide what handle to purchase to fit it to its pan bodies. In its perception the differences listed are not immaterial. To the contrary, the height of the handle is of importance and a manufacturer would not consider a pan handle it without visualizing its size and position in relation to a pan body.
- The Invalidity Division wrongly applied the test of significant differences from Article 6 CDR instead of the test of immaterial details relevant in the context of Article 5 CDR.
- The Invalidity Division failed to consider the colour images filed by the design proprietor which highlight the differences between the designs at issue. Instead, it made its own drawing which have not been correctly scaled.
- The Invalidity Division also failed to consider the aesthetic aspect of the contested design. By using the higher and steeper upsweep of the handle, the contested design provides a better aesthetic balance.
- As the differences between the conflicting designs are not immaterial, from the point of view of an informed user, the contested design is ‘aesthetically and commercially more acceptable than the prior design’.

## **Reasons**

- 8 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.
- 9 The appeal is, however, not well founded because the contested design is not new within the meaning of Article 5 CDR. The differences between the contested design and the prior design are immaterial so the designs have to be deemed identical, pursuant to Article 5(2) CDR. The reasons are explained hereunder.
- 10 The crucial issue is whether the differences highlighted by the design proprietor shall be considered as immaterial or, to the contrary, material and, therefore, rendering the contested design novel.

- 11 The literal meaning of the term suggests that ‘immaterial differences’, as contrary to ‘material’, are those differences which do not matter.
- 12 The other issue is, from whose point of view the assessment of differences should be made. The Board is of the opinion that the reference made by the design proprietor to the assessment by the informed user is not justified in the context of Article 5 CDR. It is the individual character of the design (Article 6 CDR) that has to be judged by the reference to an informed user. In case of novelty, the Regulation does not specify the reference person. It is, therefore, the Board’s task to assess the differences on the basis of the overall appearance of the designs in question.
- 13 Turning now to the designs at issue, the Board notes that the design proprietor pointed out and described three differences. They consist, essentially, in: (i) longer and steeper upsweep of the handle of the contested design; (ii) higher and sharper arch made by the down-turned portion of the handle and; (iii) marginally different levels of two ends of the handle when secured to a saucepan.
- 14 The Board examined in details the differences described by the design proprietor which have been highlighted in a picture representing the two designs superimposed. The handle of the contested design indeed makes a slightly sharper and higher arch when viewed together with the prior design.
- 15 However, this difference is not perceivable when the two designs are viewed side by side. In order to detect it, one has to compare closely the two designs by measuring them or indeed putting the one over the other. The general view of both designs is such that they make a sharp arch. The actual difference in the arch is minimal, difficult to appreciate objectively and, therefore, it has to be considered immaterial.
- 16 The second difference mentioned by the design proprietor is complementary to the first one described. If the angle of the upsweep portion of the handle in one design is steeper, that will necessarily reflect in the angle of the down-turned portion of that handle. What can be seen, upon a very close examination of designs, is that the arch made by the handle of the contested design is slightly higher and sharper. As explained above, this difference is immaterial. As claimed by the design proprietor in relation to the second difference, the down-turned portion of the handle of the contested design assumes a different angle to the vertical. This is hardly visible without actually measuring the angles.
- 17 The third difference described by the design proprietor concerns the level at which the two extremities of the handles arrive. In case of the contested design, the distal end is higher than proximal and, in case of the prior design it is, allegedly, the distal end that is ‘marginally’ lower. The Board firstly notes that, as already pointed out by the Cancellation Division, that it is the saucepan handle only that is the subject matter of the contested design. Therefore, its securing on the saucepan does not form a part of the design. Secondly, the level at which the extremities of the handle arrive may also vary according to its inclination. That level, therefore, is not really a property of the handle but results from how it is secured to the saucepan. For this reason, that difference is immaterial.

- 18 On the basis of the foregoing the Board concludes that the contested design has to be deemed identical to the prior design.
- 19 Insofar as the design proprietor refers to the aesthetic aspect of the design, the Board recalls that the aesthetic qualities are not relevant for the assessment of the novelty.
- 20 The appeal is dismissed.

**Costs**

- 21 Since the design proprietor is the losing party it has to bear the fees and costs incurred by the applicant for invalidity, in accordance with Article 70(1) CDR.

On those grounds,

THE BOARD

hereby:

**1. Dismisses the appeal;**

**2. Orders the design proprietor to bear the fees and costs incurred by the applicant for invalidity.**

Th. Margellos

C. Rusconi

I. Meyer

Registrar:

J. Pinkowski