



DECISION
of the Third Board of Appeal
of 25 January 2008

In case R 1391/2006-3

Mars UK Limited

3D Dundee Road
Slough, Berkshire SL1 4LG
United Kingdom

Invalidity Applicant/Appellant

represented by CLIFFORD CHANCE LLP MARS CO-ORDINATION TEAM, 10
Upper Bank Street, Canary Wharf, London E14 5JJ, United Kingdom

v

Paragon Products B.V

Industrieweg 12
NL-9641 HM Veendam
The Netherlands

Design Proprietor/Respondent

represented by ALLEN & OVERY, Khalila Meggough, Apollolaan 15, NL-1077 AB
Amsterdam, The Netherlands

APPEAL relating to Invalidity Proceedings No ICD 1 410 (Registered Community
Design No 000 196 167 - 0 003)

THE FIRST BOARD OF APPEAL

composed of Th. Margellos (Chairperson), C. Rusconi (Rapporteur) and D. T.
Keeling (Member)

Registrar: J. Pinkowski

gives the following

Decision

Summary of the facts

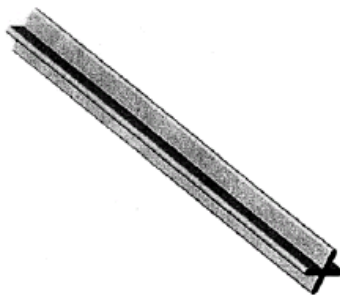
- 1 By application received on 1 July 2004 Paragon Products B.V. (hereinafter, ‘the design proprietor’) sought to register a Community Design whose single view is represented hereunder



in respect of the following product:

‘Animal foodstuffs’.

- 2 The Community Design was registered under No 000 196 167-0 003 and published in the Bulletin of 5 October 2004.
- 3 By application received on 8 August 2005 Mars UK Limited (hereinafter, ‘the applicant for invalidity’) seeks a decision whereby the Office declares the invalidity of the Community Design (hereinafter, ‘the Challenged Design’) on the ground that it lacks novelty and individual character and does not satisfy the requirements of Articles 5 and/or 6 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs (‘CDR’) (OJ EC 2002 No L 3, p 1). In the statement of grounds attached to the application it indicates firstly that the Challenged Design, which represents an animal chew consisting of multiple prongs, lacks novelty because it is substantially identical, in shape, size and proportions, to a dog chew (hereinafter, referred to as ‘the Earlier Design’), represented hereunder, that it has been marketing under the mark PEDIGREE DENTA STIX in the European Union since 2002. The differences merely affect immaterial details.



- 4 It argues secondly that the Challenged Design lacks individual character because it causes to the informed user – a pet owner – the same overall impression as the earlier design; the informed user is aware that there is a wide variety of shapes as

regards animal chews (illustrations are attached) and that the degree of freedom of the designer is almost limitless; the two designs are for elongated animal chews with multiple prongs, they are substantially identical in size and proportions and the only difference is that one has four prongs and the other five; this difference is not enough to alter the same overall impression.

- 5 By letter dated 22 December 2005 the design proprietor responds to the application for invalidity. It argues that its design has five chewing sides and its cross section resembles a flower – whereas the Earlier Design only has four – and its cross section resembles an 'x'. It denies that it enjoyed unlimited freedom in selecting the shape of its dog chew because that shape is necessary for the product to perform its function: reducing plaque. It concludes that the Earlier Design does not destroy novelty or individual character of the Challenged Design.
- 6 By letter dated 3 March 2006, the applicant explains that the design proprietor initially (in 2004) launched a dog chew with four prongs and after receiving a complaint from Mars slightly modified the shape by adding a fifth prong to its dog chew design. This addition does not substantially modify the overall impression of the two designs, which remains 'extremely similar'. The difference (of one prong) is only noticeable when the two products are compared in cross-section. The applicant also notes that the claim that the five-prong dog chew is a shape serving a functional purpose has not been substantiated and that, for this reason, its claim that its freedom in designing the product was constrained is unfounded. The five-prong design was adopted not for technical reasons but to mimic the earlier design which enjoyed enormous reputation on the market. Therefore, the Challenged Design should be declared invalid for want of novelty and individual character.
- 7 By decision of 29 August 2006 (hereinafter, 'the contested decision') the Invalidity Division rejects the application for invalidity. The contents of the decision are the following:
 - a As regards novelty: the difference of an additional prong is not an immaterial detail and thus the Challenged Design is not identical to the Earlier Design;
 - b As regards individual character: the informed user is familiar with foodstuff products and therefore knows that there is no functional limitation on the freedom of the designer in creating these products; however, the difference in the cross-section of the two products produces different overall impressions on the informed user; the Challenged Design has a five-arm star configuration whereas the prior design is shaped like a X with four arms; 'while this might not make a big difference to the end user, the informed user is well aware of this fundamental difference'; therefore, the Earlier Design does not deprive the Challenged Design of individual character.
- 8 The applicant for invalidity filed an appeal on 27 October 2006 followed by the statement of grounds on 22 December 2006. The design proprietor responded on 26 March 2007. The parties exchanged further briefs on 18 July and 17 October 2007.

Submissions and arguments of the parties

- 9 The applicant for invalidity requests annulment of the contested decision and a ruling that the Community Design is declared invalid. These are the grounds:
- a As regards novelty: the finding in the contested decision that the difference (five vs four prongs) between the two designs is not immaterial is based on the designs being seen from their ends only (that is, their cross-section), but this is not how the products are viewed normally ‘by the informed user’; dog chews are normally displayed (by manufacturers) and seen (by buyers) lengthwise; photographs of dog chew packaging are submitted to show how the product is viewed by consumers in the retail environment, that is, lengthwise; from that perspective the two designs look extremely similar, because they have the same overall shape, size and proportions and the difference in the number of prongs is hardly noticeable and therefore immaterial;
 - b As regards individual character: the contested decision placed too much emphasis on the minor difference in the cross-section of the respective designs and did not consider their overall impression on the informed user; the cross-section of the two dog chews may be different but their overall impression remains the same, particularly because the consumers are not confronted with the products from their cross-section but view them in their entirety.
- 10 The design proprietor replies as follows:
- a As regards novelty: it is not relevant how the design is viewed by an informed user in the retail environment; what matters is whether an identical design (save immaterial details) has been made available to the public before; the contested decision was therefore correct to dismiss the argument of the applicant for invalidation; in any case Mars sells its product in a packaging on which its cross-section X shape, not its lengthwise aspect, is highlighted, which confirms the importance of the cross-section;
 - b As regards individual character: the difference in the number of prongs is immediately noticeable to the informed user; one design evokes a geometrical figure (an X), the other will be associated to a flower shape.
- 11 The applicant for invalidity insists that the Community Design lacks novelty and individual character; it argues that dog chews are typically displayed in plastic packaging whose transparent window shows the longitudinal part of the product, not its end/cross-section features; the extra prong will, in these circumstances, hardly be noticed and should, therefore, be regarded as an immaterial detail in the assessment of novelty; even if the two products are viewed outside the packaging, they look extremely similar unless one deliberately counts the prongs.

- 12 The design proprietor reiterates its previous submissions.

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 No L 341, p. 28). It is therefore admissible.
- 14 The appeal is also well founded. The Challenged Design lacks individual character within the meaning of Article 6 CDR because it produces on the informed user an overall impression that does not differ from the overall impression produced by the Earlier Design. As a result, the Challenged Design should be declared invalid. The reasons are explained hereunder:

The informed user

- 15 The Challenged Design has been registered in respect of 'animal foodstuffs'. The parties agree that the product at issue is more precisely a dog chew, i.e. a product whose main purpose is to satisfy the dog's pleasure of gnawing and chewing.
- 16 The informed user against whom individual character of the Challenged Design should be measured is therefore a dog owner, who buys dog foodstuffs and treats and has become informed on the subject by visiting pet stores (or pet departments in supermarkets), downloading information from the internet, etc. (see, by analogy, decision of the Third Board of Appeal of 18 September 2007 in case R 250/2007-3 - 'tavoli').

The earlier design and its divulgation

- 17 The Earlier Design is that of a dog chew called Pedigree Denta Stix which the applicant for invalidity alleges is being sold on the marketplace in the European Union since 2002. This allegation has not been contested and the Board accordingly considers that this design has been made available to the public before the date of application of the Challenged Design and may thus be regarded as an earlier design within the meaning of Article 7 CDR.

Overall impression of the conflicting designs

- 18 The finding in the contested decision that the two designs did not produce the same overall impression was based on the different aspect of their cross-section 'shape', since in one case that shape resembled an 'X' and in the other case it was reminiscent of a star (or a flower, according to the design owner).
- 19 In the Board's opinion, to look exclusively at the cross section of the designs is an incomplete test, having in mind the sort of products they concern, for assessing their overall impression. The cross section can only be seen if the product covered by the design is looked at from one end or is cut through in the

middle. The drawing that the cross section represents is admittedly a characteristic of any three-dimensional object but is not, in the Board's opinion, the only one that must be looked at in an 'overall' assessment.

- 20 The overall impression of the design of a product is that produced by the sum of all the characteristics which may be perceived visually, not just one of them, as the Invalidity Division apparently considered. In the present case, the main characteristics of the Challenged Design are: (i) its elongated shape, in the sense that it is much longer than broad; (ii) its linear structure, in the sense that all the lines are straight; (iii) the proportions of the elements it comprises relative one another; and (iv) the drawing of the cross section, in the shape of a star.
- 21 The main characteristics of the Earlier Design are: (i) its elongated shape, in the sense that it is much longer than broad; (ii) its linear structure, in the sense that all the lines are straight; (iii) the proportions of the elements it comprises relative one another; and (iv) the drawing of the cross section, in the shape of an X.
- 22 Three out four characteristics are the same in the two designs: same elongated shape, same linear structure, same proportions between the flaps and the body of the product. This is why, in the Board's opinion, the two designs make the same overall impression on the informed user.
- 23 The difference between them consists of a different number of prongs but the Board cannot see – when looking at the two designs from an overall perspective – how the fact that one design has five prongs instead of four may radically alter overall impression. The Invalidity Division, in a rather sketchily reasoned decision, exclusively concentrated on a single characteristic. In doing so, it notably failed to analyse the designs from a broader perspective, which is necessary, in the Board's view, when assessing their 'overall impression' (see decision of the Third Board of Appeal of 25 May 2007 in Case R 1351/2006-1 - 'inverter generators').
- 24 The different number of prongs might be enough for the Challenged Design to survive the strict novelty test under Article 5 CDR but does certainly not assist it in the framework of Article 6 CDR.
- 25 It must be borne in mind in this context that dog chews come in a limitless array of shapes. As the applicant for invalidity has convincingly shown, they can be flat, round, cylindrical, long, short, etc.. They can present the aspect of a bone or that of a knot or a plait, etc.. The freedom of the designer in that field is practically limitless, as even the contested decision acknowledged. The design proprietor's position that the five-prong design is dictated by technical functions (reducing plaque) has not been substantiated. It follows that the design proprietor could have distanced itself much more from the earlier product than by merely adding a prong to its design.

Costs

- 26 The design proprietor shall be ordered, as the losing party pursuant to Article 70(1) CDR, to bear the costs and fees of the applicant for invalidity in the invalidity and appeal proceedings.

Order

On those grounds,

THE BOARD

hereby:

- 1. Annuls the contested decision and declares the invalidity of the Challenged Design.**
- 2. Orders the Design Proprietor to bear the costs and fees of the Applicant for Invalidity in the invalidity and appeal proceedings.**

Th. Margellos

C. Rusconi

D. T. Keeling

Registrar:

J. Pinkowski