



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

The Boards of Appeal

DECISION

**of the Third Board of Appeal
of 12 July 2011**

In Case R 1701/2010-3

Geobra Brandstätter GmbH & Co. KG

Postfach 12 60

DE-90511 Zirndorf

Germany

Invalidity Applicant / Appellant

represented by Rau, Schneck & Hübner, Königstr. 2, DE-90402 Nürnberg, Germany

v

Shantou Wanshun Toys Industrial Co., Ltd.

Shantou Chenghai Lianxia Town Yinxi

Liannan Industrial Park

Guangdong Province 515000

People's Republic of China

Design Holder / Respondent

represented by Luderschmidt, Schüler & Partner, John-F.-Kennedy-Str. 4,
DE-65189 Wiesbaden, Germany

APPEAL relating to Invalidity Proceedings No 7040 (registered Community design
No 664925-0003)

THE THIRD BOARD OF APPEAL

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

Registrar: P. López Fernández de Corres

gives the following

Decision

Summary of the facts

- 1 By an application filed on 5 February 2007, Shantou Wanshun Toys Industrial Co., Ltd. (hereinafter ‘the respondent’) sought to register the following design



- 2 The design was registered and published in the Community Designs Bulletin No 39/2007 of 6 March 2007.
- 3 On 13 October 2009 Geobra Brandstätter GmbH & Co. KG (hereinafter ‘the appellant’) filed an application for a declaration of invalidity against the contested RCD. The appellant requested the invalidation of the RCD based on Articles 4 to 9 CDR.
- 4 As evidence of the prior design the appellant submitted the following documents:
 - an excerpt from the book ‘PLAYMOBIL Collector 1974-2004’ (‘D1’) including the following image of a product No 3263



- a written and signed statement and an English translation thereof of Mr Alexander Pitz from the Fantasia Verlag GmbH ('D2') in which it is stated that the 'date of first delivery' of the book 'Playmobil Collector 1974-2004' was 4 March 2004;
 - a written and signed statement of Mr. Hans-Carl Rathjen in which it is stated that the product No 3263 has been put on the market in Germany in 2003 ('D3');
 - invoices relating to the product No 3263 ('D4').
- 5 On 28 June 2010, the Invalidity Division issued a decision (hereinafter 'the contested decision') rejecting the application for a declaration of invalidity and ordering the appellant to bear the costs. It stated, in essence, the following:

Evidence

- D1 is a copy of the appellant's catalogue, including the picture of a product No 3263 and as such a publication addressed to the public. Therefore, D1 is evidence for the disclosure of the prior design within the meaning of Article 7(1) CDR.
- D2, D3 and D4 are supporting the claim of the appellant that the model No 3263 has been made available to the public within the meaning of Article 7(1) CDR before the registration of the contested RCD.

Novelty

- The contested RCD and the prior design disclosed in D1 differ *inter alia* in that there is a trailer in the RCD, absent in the prior design.
- These differences are not immaterial details and thus the RCD is not identical to the prior design. Therefore, the evidence provided by the appellant does not form an obstacle to the novelty of the RCD within the meaning of Article 5 CDR.

Individual character

- The informed user is familiar with the basic features of the products to which the contested RCD relates, namely to toy vehicles in the form of vehicles used on construction sites, and of the existing design corpus available in the normal course of business. The informed user is aware of the shape that the toy vehicle in question must have the requirement that toy vehicles of that type should generally resemble the vehicles present in daily life. Despite of the aforementioned requirement the designer has a wide choice of colours, materials and ornamentations left.
- In the present case, the overall impression produced on the informed user by the contested RCD differs from the overall impression produced by the prior design, in particular because the RCD includes a trailer absent in the prior design.

- Therefore, the prior design does not form an obstacle to the individual character of the contested RCD.

Conclusion

- None of the facts and evidence provided by the appellant supports the invoked ground for invalidity of Article 25(1)(b) CDR.
 - Therefore, the application has to be rejected.
- 6 On 2 September 2010, the appellant filed a notice of appeal. The statement of grounds was received on 13 October 2010.
- 7 The respondent did not submit observations.

Submissions and arguments of the appellant

- 8 The appellant's arguments may be summarized as follows:

Preliminary remark

- On a formal issue, the applicant designated at first instance the attachments as D1, D2 etc. The Invalidity Division used the same format but used a different numbering for different items of evidence, which might lead to confusion. Hereinafter the appellant refers to the numbering as it used at first instance.

Lack of individual character

- Reference is made to the evidence provided during the former proceedings, in particular D1 to D10. The contested decision correctly accepted those designs as disclosed within the meaning of Article 7(1) CDR.
- The contested decision incorrectly denied that there was the same overall impression.

(i) Comparison to D1/D2

- The RCD is in almost all features an identical copy of the product shown in D1 and D2. In particular, there is complete identity in :
 - the shape of the main body of the truck;
 - the collecting/discharging device at the back of the truck;
 - the cabin;
 - the logo on the doors;

- the wheels;
 - the ladder;
 - the ornamentation of the mixing drum;
 - part of the black stripes at the side;
 - the colour of the cabin (yellow);
 - the colour of the wheels (black and red);
 - the colour of the mixing drum (yellow);
 - the colour of the ornamentation of the mixing drum (red);
 - the colour of the logo on the doors (red).
- In the RCD, there is an additional element, namely a trailer. This as such does not change the overall impression. The trailer is banal in shape and recognized by the informed user to be simply an additional element. Also it should be noted that considering the almost complete identity between the trucks as such including identity in details, the mere addition of a simple product to the RCD cannot be sufficient to lead to a different overall impression.
 - Additionally, it should be noted that the designer has almost unlimited freedom for the general shape of the product.
 - The contested decision was wrong not to take into account the identity of the design of the truck including details such as ornamentation.

(ii) Reference to R 1337/2008-3

- Finally, it appears that the general standards applied by the Invalidity Division are not consistent with the judicature of the Board of Appeal.
- Particular reference is made to decision of 16 March 2010, R 1337/2008-3, 'REDUCERS'. In that decision the Board of Appeal clearly pointed out that the mere addition of a standard object to a protected design does not create a different overall impression.

Reasons

- 9 The appeal complies with Articles 55 to 57 CDR and Article 34(1)(c) and (2) CDIR. It is therefore admissible.
- 10 The question posed pursuant to Articles 5 to 7 CDR is essentially whether, prior to the filing date of the contested Community design, an identical design or a design that produces the same overall impression on the informed user, had been

made available to the public. A design is deemed to have been made available to the public if it has been published, exhibited, used in trade or otherwise disclosed, 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.

11 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.’

12 Individual character is defined by Article 6 CDR:

‘1. A design shall 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:

(a) ...

(b) in the case of a registered Community design, before the date of filing of the application for registration or, if a priority is claimed, the date of priority.

2. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.’

13 The issue therefore is whether the two designs are identical, barring immaterial details, (lack of novelty under Article 5 CDR) or whether they produce the same overall impression on the informed user, taking into consideration the designer’s degree of freedom in developing the design (lack of individual character under Article 6 CDR).

The earlier design and its divulgation

14 The allegation that the prior design has been made available to the public before the date of application of the contested RCD and may thus be regarded as an earlier design within the meaning of Article 7 CDR has not been contested and is endorsed by the Board.

Novelty

15 Although the contested decision is contested in its entirety, the appellant clarifies in its statement of grounds that the appeal is based on Article 25(1)(b), in

particular on lack of individual character. Therefore it is sufficient to note that the Board endorses the conclusion of the contested decision that the prior designs and the contested RCD are not identical within the meaning of Article 5 CDR (lack of novelty) because there are differences between the designs which cannot be considered immaterial details.

The informed user

- 16 It is apparent from Recital 14 in the preamble to the CDR that, when assessing whether a design has individual character, account should be taken of the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs (see judgment of 22 June 2010, T-153/08, ‘Communications equipment’, para. 43).
- 17 With regard to the interpretation of the concept of informed user, the status of ‘user’ implies that the person concerned uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended (see judgment of 22 June 2010, T-153/08, ‘Communications equipment’, para. 46).
- 18 The informed user is neither a designer, a technical expert, a manufacturer nor a seller of the products in which the designs at issue are intended to be incorporated or to which they are intended to be applied. The informed user is particularly observant and has some awareness of the state of the prior art, that is to say the previous designs relating to the product in question that had been disclosed on the date of filing of the contested design, or, as the case may be, on the date of priority claimed (see judgments of 18 March 2010, T-9/07, ‘Metal rappers’, para. 62; of 22 June 2010, T-153/08, ‘Communications equipment’, para. 47 and of 14 June 2011, T-68/10, ‘Montres’, para. 51).
- 19 In the case at hand, the product in question is a toy vehicle and therefore the informed user could be a child between the approximate age range of 4 to 9 or an adult who buys the toy vehicle for a child. However, it makes little difference whether the informed user is a child between the approximate age range of 4 to 9 or an adult; the important point is that both those categories of person are familiar with the product at the level indicated in the previous paragraph above (see, by analogy, judgments of 18 March 2010, T-9/07, ‘Metal rappers’, para. 65).

The designer’s degree of freedom in developing his design

- 20 The designer’s degree of freedom in developing his design is established, *inter alia*, by 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 (see judgment of 18 March 2010, T-9/07, ‘Metal rappers’, para. 67).
- 21 The contested decision found that the freedom of the designer is limited by the requirement that toy vehicles of this type should generally resemble the vehicles present in daily life. Despite this requirement the designer has a wide choice of

colours, materials and ornamentations left. The Board agrees with this assessment, which has not been disputed.

Overall impression of the conflicting designs

- 22 The Board agrees with the contested decision that the contested RCD and the prior design differ in particular because the RCD includes a trailer absent in the prior design. The Board notes that they differ also in the following features:
- In the contested RCD the bottom part of the cabin is yellow, whereas in the prior design the bottom part, insofar as it can be seen, seems to be in black.
 - The ornamentation of the mixing drum in the prior design contains the letters R&M, whereas in the contested RCD these letters are missing.
 - The colouring of the side of the truck on the bottom in the contested RCD is black, whereas in the prior design it is yellow.
- 23 In the view of the Board, the contested RCD and the prior design also share numerous elements which are identical or at least strongly similar which are listed as follows:
- the overall shape of the main bodies of the trucks;
 - the collecting/discharging device at the back of the trucks;
 - the form of the cabin;
 - the logo on the doors;
 - the wheels;
 - the ladder;
 - the ornamentation of the mixing drum, notwithstanding the slight difference mentioned in the previous paragraph;
 - the colour of the cabin (yellow), notwithstanding the slight difference mentioned in the previous paragraph;
 - the colour of the wheels (black and red);
 - the colour of the mixing drum (yellow);
 - the colour of the ornamentation of the mixing drum (red);
 - the colour of the logo on the doors (red).
- 24 In the absence of any specific constraint imposed on the designer, except for the rather minor one mentioned in paragraph 20 above, the similarities noted in the paragraph above all relate to elements in respect of which the designer was free to develop the contested design. All of these mentioned similarities are very notable

in the overall impression of the designs and will attract the informed user's attention.

- 25 In the opinion of the Board, the fact that the contested RCD contains, without taking into account the additional trailer, only the very slight differences mentioned in paragraph 21 above is considerably less striking than the overall impression given by the numerous partially identical and/or strongly similar elements mentioned in paragraph 22 above. The designs are almost identical and the slight differences are hardly noticeable.
- 26 The only relevant difference between the two designs at issue concerns the fact that the contested RCD also contains a trailer, which is not present in the previous design. The contested decision concluded that the overall impression produced on the informed user by the contested RCD differs from the overall impression produced by the prior design, in particular because the RCD includes a trailer absent in the prior design, without mentioning any other notable differences.
- 27 The Board cannot echo this reasoning because it appears to lend legitimacy to the integral reproduction of an existing design, with the sole proviso that some other component customarily used in combination with the product in question be added, for example a rim provided with a tyre. In the case at hand the prior design is easily discernible in the RCD. The trailer is a feature that the respondent added to the earlier version of the toy vehicle. Even though the trailer has thus become an element of the design of the toy vehicle, it is a relatively marginal one, in the sense that the toy vehicle – with or without the trailer – produces on the informed user the same overall impression. The informed user will perceive the trailer for what it clearly is: an accessory. The accessory character of the trailer is well demonstrated by the fact that it is not a fixed element but one that can be easily separated from the main product. The trailer is, in fact, an optional accessory – i.e. something that anybody playing with the toy may decide to use or not – and may hardly be qualified as ‘a significant part of the design’ (see also decision of 26 March 2010, R 9/2008-3, ‘Footwear’, paras 102 and 103).
- 28 Therefore, the Board takes the view that the contested design inevitably creates the same overall impression on informed users as the prior design since it reproduces all the essential characteristics of the prior design and, in order to differentiate itself, in addition to making only very slight and hardly noticeable variations, simply adds another component – a trailer – which can be usually coupled to this type of product in the course of the prior design's customary usage (see also decision of 16 March 2010, R 337/2008-3, ‘Reductores’, para. 15).
- 29 Further, the overall impression produced by a design on the informed user must necessarily be determined also in the light of the manner in which the product at issue is used (see judgments of 22 June 2010, T-153/08, ‘Communications equipment’, para. 66 and of 14 June 2011, T-68/10, ‘Montres’, para. 78). The Board notes that the person using the product would usually be a child at play and that the truck and the trailer the contested design can easily be separated from each other and used as two separate toys, or they could even be sold separately.

This factor also decreases the importance that can be given to the additional component for the evaluation of the overall impression.

- 30 It follows from all the above considerations that the contested decision erred in finding that the designs at issue produced a different overall impression on the informed user and that they were not in conflict within the meaning of Article 25(1)(b) CDR. Accordingly, the appeal must be upheld and the contested decision annulled.

Costs

- 31 Since the appeal has been successful, the respondent must be ordered to bear the fees and costs incurred by the appellant, in accordance with Article 70(1) CDR.

Order

On those grounds,

THE BOARD

hereby:

- 1. Annuls the contested decision;**
- 2. Declares the contested RCD invalid;**
- 3. Orders the respondent to bear the fees and costs incurred by the appellant.**

Th. Margellos

H. Salmi

C. Rusconi

Registrar:

P. López Fernández de Corres