



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 1702/2010-3

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 7036 (registered Community design
No 573993-0003)

THE THIRD BOARD OF APPEAL

composed of Th. 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 8 August 2006, 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 109/2006 of 26 September 2006.
- 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 and other(s) according to Articles 25(1)(c), (d), (e), (f) or (g) CDR.
- 4 As evidence of the prior design the appellant submitted the following documents:
 - an excerpt from the book ‘PLAYMOBIL Collector 1974-2004’ (Evidence ‘D1’) including the following image of a product No 3003:



- copy of the packaging of product No 3003;
- 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 3003 has been put on the market in Germany in 1998 ('D3');
- invoices relating to the product No 3003 ('D4');
- Copy of a catalogue 'playmobil Neuheiten 2006' ('D5') including pictures of product No 4314 reproduced below:



- Invoices relating to product No 4314 ('D6');
- a written and signed statement of Mr. Hans-Carl Rathjen in which it is stated that the product No 4314 was presented to the public at the International Toy Fair 2006 in Nuremberg between 2 and 7 February 2006 ('D7');
- Copy of the International registration No DM/044 660 published in July 1998 ('D8') and containing the pictures reproduced below:



- 5 On 6 July 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:

Admissibility

- The ground for invalidity Article 25(1)(d) CDR indicated by the appellant is not admissible since the prior design, namely the International design registration No DM/044 660, has been made available to the public prior to the date of filing of the RCD.

Evidence

- D1 is a copy of the appellant’s catalogue, including the picture of a product No 3003 (of the prior design), and as such a publication addressed to the public. Therefore, D1 is evidence of 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 3003 has been made available to the public within the meaning of Article 7(1) CDR before the registration of the contested RCD.
- D5 is a copy of the appellant’s catalogue, including the picture of a product No 4314 (of the prior design), and as such a publication addressed to the public and hence evidence of the disclosure of the prior design within the meaning of Article 7(1) CDR.
- D6 is an invoice issued after the date of registration of the contested RCD and therefore is disregarded as evidence.
- D7 is supporting the claim of the appellant that the model No 4314 has been made available to the public within the meaning of Article 7(1) CDR before the registration of the contested RCD.
- D8 is a certified copy of the International Design Registration No DM/044 660 addressed to the public. Therefore, D8 is a disclosure in the meaning of Article 7(1) CDR.

Novelty

- The contested RCD and the prior design disclosed in D1 differ *inter alia* in the following features:
 - in the RCD there is an additional pallet, absent in the prior design;
 - in the RCD there is a lifting tool with a hanger, missing in the prior design;
 - in the RCD there is a trailer with a crate on it, whereas the prior design lacks any trailers.

- The contested RCD and the prior design disclosed in D5 differ *inter alia* in the following features:
 - in the RCD there is an additional pallet, absent in the prior design;
 - in the RCD there is a lifting tool with a hanger, missing in the prior design;
 - in the RCD there is a trailer with a crate on it, whereas the prior design lacks any trailers;
 - the prior design bears a word ‘CARGO’ at the front whereas the RCD does not bear any letters.
- The contested RCD and the prior design disclosed in D8 differ *inter alia* in the following features:
 - in the RCD there is an additional pallet, absent in the prior design;
 - in the RCD there is a lifting tool with a hanger, missing in the prior design;
 - in the RCD there is a trailer with a crate on it, whereas the prior design lacks any trailers;
 - the RCD is in colour whereas the prior design is black and white.
- These differences are not immaterial details and thus the RCD is not identical to the prior designs. 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 with 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 and the requirement that toy vehicles of that type should generally resemble the vehicles present in daily life. Despite 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 and a lifting tool with a hanger, absent in the prior design.
- The overall impression produced on the informed user by the prior design disclosed in D5 differs even more from the overall impression produced by

the contested design as apart from the differences mentioned in the paragraph above D5 also bears a word 'CARGO' at the front of the design.

- The same applies to the prior design disclosed in D8. Furthermore, apart from not having a trailer and a lifting tool D8 is in black and white.
- 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;

- the cabin with the previously unknown shape;
 - the wheels;
 - the lifting tool;
 - the rhomb-like logo at the side;
 - the colour of the cabin (black);
 - the colour of the wheels (black and red);
 - the colour of the main body (green);
 - the colour of the tool (yellow).
- There are the following differences, which do not change the same overall impression:
- There is an additional pallet and lifting tool plus hanger in the RCD. This is immaterial since the lifting tool is a relatively small element in the product. The shape of a lifting tool is determined by its technical function so that the user will not look at it for its non-technical design. It is generally known that a lifting tool can be exchanged so that the user will place little weight on the shape of the lifting tool.
 - There is an additional towed vehicle in the RCD. This is immaterial since it is only an additional object and it is banal in shape.
- Additionally, it should be noted that with regards to the general shape of the product the designer has almost unlimited freedom.

(ii) Comparison to D5/D6

- For the reasons stated above, the RCD also produces the same overall impression as D5/D6.

(iii) Comparison to D9

- For the reasons stated above, the RCD also produces the same overall impression as D9 (number 14.1 and 14.2). Indeed, the only difference between D9 on the one hand and D1/D2 on the other is that D9 is in black and white.

(iv) Reference to R 1337/2008-3

- The general standards applied by the Invalidity Division are not consistent with the case-law of the Board.
- Particular reference is made to decision R 1337/2008-3 of 16 March 2010 ‘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 an object that conveys a different overall impression.

Conflict with prior design

- The contested decision incorrectly denied that there was a conflict and that the grounds of appeal according to Article 25(1)(d) CDR were founded.
- The appellant is entitled to invoke the earlier right because it is the holder (Article 25(3) CDR).
- The International registration enjoys protection in the European Union that is in various countries within the European Union. Also according to Article (7)(a) Hague Act 1960 and Article 14(1), (2) Geneva Act 1999 an International design registration is deemed to have the same effect as a registered design right of a Member State.
- The International design registration has been protected from a date prior to the application date of the RCD.
- If Article 25(1)(d) CDR is taken literally, only prior designs can be invoked that have been made available to the public after the date of filing of the RCD. In the present case D9 was filed before the filing date of the RCD. However, in the view of the appellant, Article 25(1)(d) CDR is to be interpreted to read ‘...even if it has been made available to the public after the date of filing’. This is for the following reasons:
 - The Board of Appeal has stated in its decision of 18 March 2009 R 608/2008-3 that in the case before it the invalidity ground of Article 25(1)(d) CDR was given (even though the earlier design right had been published before the filing date of the RCD in question); it could only not be invoked for procedural reasons.
 - The wording of Article 25(1)(d) CDR is flexible enough to be interpreted as suggested by the appellant. Generally, provisions of Community law are open to purposive construction. By way of example, Article (4)(a) and Article 5(2) of the Council Directive 89/14/EEC relate to trade marks registered or used for goods or services that are not similar to those for which the earlier trade mark is registered. Nevertheless, the Court states that those provisions also relate to the registration or use of trade marks for goods and services that are indeed identical with or similar to those of the registered trade mark (see, amongst others, judgment of 9 January 2003, C-292/00, ‘Davidoff’).
 - It would be a contradiction if a right that has not yet been published would give the right holder better chances in invalidity proceedings as a right that has already been published. Against this argument one cannot claim that the holder of an earlier right need not rely on Article 25(1)(d) CDR because it can easily rely on

Article 25(1)(b) CDR. That counter-argument would only be valid if the term ‘conflict’ in Article 25(1)(d) CDR would mean, and only mean, to convey the same overall impression with the meaning of Article 6 CDR. This is, however, not the case. The Invalidity Division has held that a ‘conflict’ within the meaning of Article 25(1)(d) CDR can also arise if the contested RCD falls within the scope of protection of the earlier right. The Board of Appeal has taken the same view (see decision of 3 November 2007, R 115/207-3, ‘BOTELLAS PARA COSMETICOS’). There are cases where the contested RCD may have individual character with regard to the earlier design right but still fall within the scope of protection of the earlier design right. This is the case, for example, where the contested RCD shows a combination of products one of which has been protected by an earlier design right.

- The view of the appellant is also supported by the fact that Article 25(1)(e), (f) and (g) CDR does not contain any restriction with regard to the date of publication of the earlier right. There appears to be no reason why an earlier design right should have less impact in invalidity proceedings than an earlier trade mark, copyright or other right.
- The view of the appellant is also supported by the wording of Article 85(1) third sentence. This is because if a design right that has been published before the priority date of the RCD could not be the basis for a plea (rather than a counter claim) of invalidity, the holder of such an earlier right should be, without any valid reason, in a worse position than a holder of an earlier right that had not been published at the priority date of the RCD.
- The view of the appellant is also supported by the fact that Article 19(1) CDR conveys to the owner of a registered design a positive right to use and that the same is true for national designs by virtue of Article 12 of Council Directive 98/71/EC. It would be a contradiction if a party holds an RCD conveying a right to use, while the use of the same RCD infringes an earlier design right.
- The view of the appellant is also supported by the fact that Article 19(1) CDR prohibits any ‘use’ of a registered Community Design and that the same is true for national designs by virtue of Article 12 of Council Directive 98/71/EC. The term ‘use’ is broad enough to include any publication, by another party, of a protected design contravenes the legal interest of the right holder. This must also be taken into account when interpreting Article 25(1)(d) CDR.
- The view of the appellant is also supported by the wording of Article 110a(4) CDR because the right to prohibit the use of an RCD in a new Member State on the basis of an earlier national design right can obviously not be made dependent on whether the earlier national design right has been published or not at the date of accession. While referring to Article 25(1)(d) CDR, Article 110a(3) CDR obviously

confirms that the earlier design right need not be published after the priority date of the RCD.

- The General Court in its judgement of 18 March 2010, T-9/07, ‘Metal rappers’ also deals with the interpretation of Article 25(1)(d) CDR. In this case, the prior design had been filed before the contested design but published thereafter. In the case at hand, the protected design was published before the contested design. However, the decision by the General Court is also relevant for the present case for at least two reasons:

- The General Court explicitly decided that the term ‘conflict’ within the meaning of that provision means that there is a conflict whenever the later design does not create a different overall impression as the earlier design within the meaning of Article 10 CDR. Conversely, the General Court did not decide that the standard was the same as in Article 6 CDR. Both articles are phrased in very similar words. However, there is a considerable difference between the application of both provisions when only a part of the contested design is identical to or creates the same impression as the earlier design. If the General Court thought that in a situation where only a part of the contested design created the same overall impression as the earlier design, Article 25(1)(d) CDR was not applicable, the General Court would have applied the standards of Article 6 CDR instead of Article 10 CDR.

- The General Court explicitly pointed out the importance that it is ensured

‘that the rights of the proprietor of a prior design that is referred to in that provision is protected against any infringement of the design resulting from the coexistence of a subsequent Community design that produces the same overall impression on the informed user.’

This makes it clear that according to its rationale, Article 25(1)(d) CDR must obviously also apply even if the earlier design has been published before the contested design. There is absolutely no reason why a protected earlier design should not be protected ‘against any infringement of the design resulting from the coexistence of a subsequent Community design’ only if the protected design has, by pure coincidence, been published after the application date of the contested design.

- Article 25(1)(d) CDR has been phrased the same as Article 11(1)(d) of the Council Directive 98/71/EC. The German legislator is convinced that the implementing provision, paragraph 34, number 3 of the German Law on Design correctly implements Article 11 (1)(d) of Council Directive 98/71/EC. Therefore, there is a ‘conflict’ (at least) if the later design falls within the scope of design protection, even if the earlier design has been published after the filing date of the later design.
- It appears that the question at hand has not been dealt with in detail by the judiciary.

- In summary, the term ‘conflict’ is to be interpreted to the effect that there is (at least) a conflict if the contested RCD falls within the scope of protection of the earlier right i.e as in D9 for any of the European Union countries concerned which is determined by the national provisions. In the present case, D9 has been registered in black and white. When comparing D9 and the contested RCD according to Article 9 of the Council Directive 98/71/EC, it is necessary to ignore the colours of the RCD. Since D5 does not contain shading, the shading of the contested RCD may be maintained. Therefore, only the shape and shading of the products are to be compared. The products to be compared is the product according to the register excerpt D9 on the one hand and the product according to the RCD without the additional pallet, lifting tool with hanger and trailer. Considering the similarity of those designs, they as such do convey the same overall impression.
- Contrary to Article 62, first sentence, CDR, the contested decision does not state the reasons on which it is based with regard to the ground for invalidity according to Article 25(1)(d) CDR. In that regard, the contested decision only states that the prior design ‘has been made available to the public prior to the filing date of the RCD’. In the light of the substantive arguments submitted by the appellant at first instance, this is not sufficient as a statement of reasons on which the decision has been based.

Reasons

- 9 The appeal complies with Articles 55 to 57 CDR and Article 34(1)(c) and (2) CDIR. It is therefore admissible.

The admissibility of the claim under Article 25(1)(d) CDR

- 10 In the application for a declaration of invalidity of a registered Community Design and in its statement of grounds, the appellant mentioned expressly as ground of appeal Article 25(1)(d) which provides that:

‘A Community design may be declared invalid...:

...d) if the Community design is in conflict with a prior design which has been made available to the public after the date of filing of the application or, if a priority is claimed, the date of priority of the Community design, and which is protected from a date prior to the said date by a registered Community design or an application for such a design, or by a registered design right of a Member State, or by an application for such right.’

- 11 The contested decision stated that the ground for invalidity, Article 25(1)(d) CDR indicated by the appellant, is not admissible since the prior design, namely the International design registration No DM/044 660, has been made available to the public *prior* to the date of filing of the RCD. The appellant has given extensive arguments to refute this interpretation.

- 12 The Board observes that Article 25(1)(d) CDR must not be interpreted solely on the basis of its wording, but also in the light of the overall scheme and objectives of the system of which it is a part (see, by analogy, judgment of 9 January 2003, C-292/00, ‘Davidoff’, para. 24).
- 13 Having regard to the latter aspects, that article cannot be given an interpretation which would lead to prior designs which have been made available to the public prior to the date of filing of the application of the CDR (or, if a priority is claimed, the date of priority of the CDR) having less protection than prior designs which have been made available to the public after the date of filing of the application of the CDR (or, if a priority is claimed, the date of priority of the CDR). A prior design which has been made available to the public prior to the date of filing of the application of the CDR (or, if a priority is claimed, the date of priority of the CDR) must enjoy protection which is at least as extensive as a prior design which has been made available to the public after the date of filing of the application of the CDR (or, if a priority is claimed, the date of priority of the CDR).
- 14 In those circumstances the Board comes to the conclusion that Article 25(1)(d) CDR is to be interpreted as providing specific protection for prior designs also in cases where the prior design has been made available to the public prior to the date of filing of the application of the CDR (or, if a priority is claimed, the date of priority of the CDR).
- 15 The contested decision did not make a comparison of the designs based on the claim made under Article 25(1)(d) CDR. However, according to the second sentence of Article 60(1) CDR, the Board may either remit the case to the department responsible for the decision appealed for further prosecution or exercise any power within the competence of that department. For reasons of procedural economy, given that both parties have had the opportunity to present arguments during the invalidity and appeal proceedings on the claim under Article 25(1)(d), the Board is of the view that it should proceed to decide whether Article 25(1)(d) CDR is applicable to the case at hand.
- 16 Therefore the Board will begin by making the comparison based on the International design registration No DM/044 660, which includes the design shown below, which was registered on 24 July 1998 claiming priority of an earlier German application filed on 3 February 1998, published in July 1998 and renewed on 24 July 2008, and which is therefore to be considered a prior design in accordance with Article 25(1)(d) CDR which has been made available to the public prior to the date of filing of the RCD.



The comparison of the conflicting designs under Article 25(1)(d) CTMR

- 17 The Board notes that the contested RCD and the prior design differ in particular because the RCD includes a pallet, a lifting tool with a hanger and a trailer with a crate on it, all absent in the prior design.
- 18 The prior right has been registered in black and white and the comparison with the contested RCD must therefore proceed on the basis of the assumption that the prior right is intended to be used in different colour schemes (see, by analogy, decision of 2 December 2009, R 1130/2008-3, ‘Watches’, para. 20, decision upheld in judgment of 14 June 2011, T-68/10, ‘Montres’).
- 19 As to the main body of the toy vehicle, consisting of the cabin with wheels, the lifting tool, the logo at the side and the shades of the colouring, the Board finds no differences between the RCD and the prior design, which only consists of these elements. Therefore they are identical.
- 20 In such a case the RCD must be considered to be in conflict with the prior design, because it falls within the scope of protection of the earlier right, notwithstanding the fact that it contains various and notable additional elements. The RCD consists of a design in which the prior design has been fully incorporated.

Conclusion

- 21 It follows from all the above considerations that the contested decision erred in finding that the claim under Article 25(1)(d) CDR was inadmissible and that therefore the designs at issue were not in conflict within the meaning of Article 25(1)(d) CDR. On the contrary, for the reasons given above, the RCD is to be declared invalid based on Article 25(1)(d) CDR.
- 22 Accordingly, the appeal must be upheld, the contested decision annulled and the contested RCD declared invalid. Therefore there is also no need to for the Board to evaluate whether the contested RCD could be declared invalid based on the other grounds which formed the basis of the application for a declaration of invalidity.

Costs

- 23 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