



DECISION

**of the Third Board of Appeal
of 24 January 2011**

In Case R 91/2010-3

Svedbergs i Dalstorp AB

S-514 63 Dalstorp

Sweden

Invalidity applicant / Appellant

represented by AWAPATENT AB, Junkersgatan 1, S-582 35 Linköping, Sweden

v

Gofab Design AB

Stansgatan 1

S-334 32 Anderstorp

Sweden

RCD proprietor / Respondent

represented by Knut Moberg, Stansgatan 1, S-334 32 Anderstorp, Sweden

APPEAL relating to Invalidity Proceedings No 6781 (registered Community design
No 1 101 885-0003)

THE THIRD BOARD OF APPEAL

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

Registrar: C. Bartos

gives the following

Decision

Summary of the facts

- 1 Gofab Design AB (hereinafter 'the respondent') is the proprietor of Registered Community Design No 1 101885-003 (hereinafter 'the contested RCD'), which has a filing date of 9 March 2009. The contested RCD is registered for 'bath tubs'. It is represented as follows:



- 2 The design was registered and published in the Community Designs Bulletin on 24 April 2009.
- 3 On 3 June 2009 Svedbergs i Dalstorp AB (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 Article 25(1) (b) (c), (d), (e), (f) or (g) CDR.
- 4 As evidence of the prior design the appellant submitted an extract from the RCD-ONLINE database related to the Community design No 000421797-0001 that was registered on 26 October 2005 and published on 13 December 2005. Two of the seven views in which the prior design is represented are reproduced below:



- 5 On 9 November 2009 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:

Disclosure

- The extract from the RCD ONLINE database related to the Community design No 000421797-0001 is evidence of disclosure in the meaning of Article 7(1) CDR.

Novelty and individual character

- In the assessment of individual character and novelty of the contested RCD also design features that are not visible during normal use of a bath tub, i.e. the base of the bath tub, are taken into account, because the bath tub is not a component part of a complex product and therefore the requirement of visibility pursuant to Article 4 CDR, which sets down an exception to a general rule, is not relevant.

Novelty

- The contested RCD and the prior design differ at least in the following features:
 - In the contested RCD the walls of the bath tub are slightly concave whereas in the prior design the lines of the walls are straight.
 - The ‘skirt’ feature of the contested RCD is not present in the prior design.
 - The brim of the contested RCD is not present in the prior design.
 - The tower of the contested RCD is lower and the back is rounded whereas the tower of the prior design is taller and rectangular.
 - In the contested RCD a tap is attached to the side of the tower and there are further plumbing elements on the front side of the tower arranged horizontally, whereas in the prior design a shower is attached to the side of the tower and the taps on the front side of the tower are arranged vertically.
- These differences are not immaterial details and the RCD is thus not identical to the prior design as invoked by the invalidity applicant. Therefore, the evidence provided by the invalidity applicant does not form an obstacle to the novelty of the contested 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 bath tubs, and of the existing design corpus of shapes and configurations available in the normal course of business. The informed user is aware of the configuration that bath tubs must

have in order to perform their function. S/he knows that the freedom of the designer in particular as to the shape, size and material of the design is limited by the requirement that a bath tub can be filled with water, a human body fits into it and it fits into a bathroom. Despite of these technical constraints the designer has a wide choice of shapes (e.g. oval, circular, corner bath tubs) colours, materials and ornamentation at its disposal. Furthermore, the designer's freedom in relation to the tower and how it is attached to the bath tub is virtually unlimited.

- 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 as a result of the numerous differences listed above at paragraph 5. Although the shapes of the bath tubs of the contested RCD and the prior design are similar, the brim of the bath tub and the height and the rounded back of the tower carry substantial weight in the formation of the overall impression of the contested RCD. In addition, the element of plumbing of the contested RCD which will be viewed by the informed user as a dominant feature is significantly different from the plumbing in the prior design. As a consequence of the number and significance of the differences in the contested RCD, the overall impression it produces differs from the overall impression produced by 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 8 January 2010, the appellant filed a notice of appeal. The statement of grounds was received on 9 March 2010.
- 7 The respondent submitted observations on 17 May 2010.

Submissions and arguments of the parties

- 8 The appellant's arguments may be summarized as follows:
- Design features which are self-evidently not visible during normal use, i.e. the base of the bath tub, shall not be taken into account. Such features are neither visible nor perceivable to the 'normal user'.
 - Whether or not the contested and prior designs form 'complex products' is irrelevant. This could be seen as self-evident for a bath tub with a separate,

loosely fitted adjoining faucet tower with plumbing constituted by separate and interchangeable faucets, drains, hoses, shower handles, water taps etc.

- The contested decision failed to note that the plumbing in the prior design is encircled by dash-dotted lines which cannot be interpreted as something included as such in the design sought for protection. The plumbing is disclaimed in the prior design and should not influence the assessment.
 - The prior design is characterized by strict simplicity and contemporary appearance of the bath tub through the consciously and carefully made choices of height and width ratios, the symmetrical relations between its constituent features, undisturbed surfaces exempt from ornamental details and framed with almost straight contour lines arranged horizontally parallel and vertically circumventing at an angle creating an overall distinct silhouette of unusual proportions in combination with a rectangular shaped front of a faucet tower clearly protruding over the middle part of one long side of the brim of the bath as seen from the side, contrasting with the narrow base and wide brim of the bath tub creating a composition of opposing basic shapes. The overall impression of the prior design is characterized by this stark contrast in form as well as the simultaneously careful incorporation and adaption of the faucet tower into the bath tub design.
 - The comparison of the overall impression produced by the designs at hand should be made with the elements forming the individual character as such of the designs in mind, i.e. the overall ‘look and feel’ of the designs should prevail over all the mechanical listings of supposed differences in detail.
- 9 The respondent supports the decision of the Invalidity Division. It adds that the appellant is also pursuing the same case in Swedish District Court where they have claimed an interim court order to prohibit any sales of the product until the court has made a verdict. The District Court has decided to reject the appellant’s request in this matter. A copy in Swedish of this decision was attached to the observations.

Reasons

- 10 The appeal complies with Articles 55 to 57 CDR and Article 34(1)(c) and (2) CDIR. It is therefore admissible.
- 11 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.
- 12 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.’

13 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.’

14 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).

Preliminary remarks

15 The appellant claims, first of all, that design features which are self-evidently not visible during normal use, i.e. the base of the bath tub, shall not be taken into account. Such features are neither visible nor perceivable to the ‘normal user’. However, the Board notes that even though a general principle according to which ‘in the assessment of individual character and novelty of the contested RCD also design features that are not visible during normal use of a bath tub, i.e. the base of the bath tub, are taken into account, because the bath tub is not a component part of a complex product and therefore the requirement of visibility pursuant Article 4 CDR, which sets down an exception to a general rule, does not concern it’, has been specifically mentioned in the contested decision, in practice, the comparison of the designs in the case at hand cannot be based on differences or similarities to be seen in the bases of the bath tubs because of the fact that the prior design does not contain any views concerning the base of the bath tub. Therefore there is no need for the Board to rule further on this matter in the case at hand.

- 16 The appellant also claims that the contested decision failed to note that the plumbing in the prior design is encircled by dash-dotted lines which cannot be interpreted as something included as such in the design sought for protection. The plumbing is disclaimed in the prior design and should not influence the assessment. This argument has not been specifically refuted by the respondent at any stage of the proceedings. The Board agrees with the appellant on this point for the following reasons.
- 17 According to the Guidelines for the examination of Community Designs, published on the Office's website www.oami.europa.eu, at section 11.4, concerning the format of the representation of the design, the representation of a design should be limited to the features for which protection is sought. However, the representations may compromise other elements that help to identify the features of a design for which protection is sought. In an application for registration of a Community design, *inter alia*, an identifier consisting of dotted lines in a view to indicate the elements for which no protection is sought is allowed. Therefore, dotted lines identify elements which are not part of the view in which they are used.
- 18 The appellant indicated clearly in its Community design application for the prior design, by using dotted lines, that the plumbing, including the shower and the taps in the faucet tower, are not elements included as such in the earlier design that is protected. These elements therefore do not form part of the earlier design (see also, e.g. decisions of 2 September 2008, R 196/2008-3, 'Saucepan handles', para. 17 and of 2 December 2009, R 1130/2008-3, 'Watches', para. 20).
- 19 The OHIM is, in principle, required to comply with its own Guidelines (see, to that effect, judgment of 24 November 2010, T-137/09, 'R10', para. 24). The Board is of the opinion that, at least on this point, the Guidelines do not derogate from the Regulations concerning Community designs, more specifically Article 4(1) CDIR and therefore they should have been followed. Disclaiming parts of a representation of a design must be possible, otherwise it would make it in many cases impossible for the design applicant to clearly identify the features of the design that it wants to protect.
- 20 However, when making the comparison of the conflicting designs the mentioned elements were, incorrectly, taken into account and seemed also to be given notable weight in the comparison due to the fact that the contested decision specifically stated that 'the element of plumbing of the contested RCD which will be viewed by the informed user as a dominant feature is *significantly different from the plumbing in the prior design* (emphasis added).'

The earlier design and its divulgation

- 21 The Board agrees with the contested decision that the extract from the RCD ONLINE database related to the Community design No 000421797-0001 is evidence of disclosure prior to the filing date of the RCD on 9 March 2009 in the meaning of Article 7(1) CDR. This has not been disputed by the appellant.

Novelty

- 22 The appellant has not given any specific arguments as to why the contested decision would be incorrect in stating that the contested RCD is not identical to the prior design. Therefore it is sufficient to note that, even taking into account that the contested decision incorrectly took into account the disclaimed elements of the prior design in its comparison, the Board endorses the conclusion of the contested decision that the prior design and the contested RCD are not identical within the meaning of Article 5 CDR (lack of novelty) because of the other differences in the designs mentioned in the contested decision.

The informed user

- 23 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).
- 24 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).
- 25 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 and of 22 June 2010, T-153/08, ‘Communications equipment’, para. 47).

The designer’s degree of freedom in developing his design

- 26 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).
- 27 The contested decision found that the freedom of the designer in particular as to the shape, size and material of the design is limited by the requirement that a bath tub can be filled with water, a human body fits into it and it fits into a bathroom. Despite these technical constraints the designer has a wide choice of shapes (e.g. oval, circular, corner bath tubs), colours, materials and ornamentation left. Furthermore, the designer’s freedom in relation to the tower and how it is

attached to the bath tub is virtually unlimited. The Board agrees with this assessment, which has not been disputed.

Overall impression of the conflicting designs

- 28 The Board agrees with the contested decision that the contested RCD and the prior design differ in the following features:
- In the contested RCD the walls of the bath tub are slightly concave whereas in the prior design the lines of the walls are straight.
 - The vertical ‘skirt’ feature of the contested RCD, insofar as it can be seen, is not present in the prior design.
 - The brim of the contested RCD is not present in the prior design.
 - The tower of the contested RCD is lower and its back is rounded whereas the tower of the prior design is taller and rectangular.
- 29 However, the fact that in the contested RCD a tap is attached to the side of the tower and there are further plumbing elements on the front side of the tower arranged horizontally, whereas in the prior design a shower is attached to the side of the tower and the taps on the front side of the tower are arranged vertically, is not, as concluded earlier, a factor to be taken into account in the comparison as the plumbing is disclaimed in the prior design and therefore cannot influence the comparison.
- 30 In the view of the Board, the contested RCD and the prior design also share numerous elements which display strong similarities which are listed as follows:
- the top and bottom shapes of the bath tubs in a specific oval form,
 - the length/height ratio of the bath tubs,
 - the angle between the bottom and the walls,
 - the faucet tower protruding over the middle part of one long side of the bath tub,
 - the incorporation and adaption of the faucet tower into the bath tub design by using a form which on the side of the bath tub follows the form and angle of the wall of the bath tub and
 - the straight front of the faucet tower on the side of the bath tub.
- 31 In the absence of any specific constraint imposed on the designer, except for the rather minor ones mentioned in paragraph 27 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.

- 32 In the opinion of the Board, the fact that in the contested RCD the walls of the bath tub are slightly concave whereas in the prior design the lines of the walls are straight is considerably less striking than the overall impression given by the highly similar top and bottom shapes of the bath tubs in oval form, the highly similar length/height ratios of the bath tubs and the almost identical angle between the bottom and the walls of the bath tubs. The very slight difference caused by the vertical 'skirt' feature of the contested RCD is also hardly noticeable.
- 33 Secondly, there is no need for a bath tub to have a tower (for example for its faucets), or for it to be situated specifically in the middle part of one long side of the bath tub, or, even more importantly, for it to be incorporated and adapted into the bath tub design by using a form which on the side of the bath tub follows the form and angle of the wall of the bath tub. Therefore the fact that the tower of the contested RCD is lower and its back is rounded, whereas the tower of the prior design is slightly taller and rectangular, is also considerably less striking than the overall impression brought on by the highly similar and partially identical factors mentioned earlier.
- 34 The respondent provided the Invalidity Division with images of bath tubs already existing on the market and other 'inspirational sources'. However, the Board notes that the only real similarity shown by these examples with the bath tubs in question lies in the fact that they are all bath tubs which have an oval form whose top part is larger, wider and longer than their bottom part. In any case, and more importantly, these examples do not show any bath tubs which might contain any kind of a tower at all.
- 35 The only difference between the two designs at issue which could have some real relevance concerns the wider and rounded brim of the contested RCD, which also causes the tower to be slightly more integrated within the bath tub, which is not present in the prior design. However, taking into account the overall impression of the bath tubs, the Board is of the opinion that this factor on its own must be seen as a minor difference which is not sufficiently pronounced or influential to distinguish the two bath tubs in the perception of the informed user. The informed user is more likely to be impressed by the overall aspect of the bath tubs rather than this difference in detail. This is not a feature which would attract the attention of the informed user as a clear difference when the design is observed in its entirety.
- 36 With regard to the overall impression produced by the earlier design, it is essentially determined by the features listed in paragraph 30 above. The overall relatively simple shape, configuration and general appearance of the two bath tubs including a tower is very similar. The mentioned differences do not significantly affect the overall impression produced by the bath tubs since they are details which, although not perhaps totally insignificant, relate to what are essentially marginal elements of the two products. A close examination – going much further than the general comparison required by the regulation – would be needed before the informed user could distinguish the two bath tubs. The differences noted by the respondent are enough for the contested RCD to survive the strict novelty test under Article 5 CDR but do not assist it in the framework of

Article 6 CDR. The Board concludes that the designs produce the same overall impression.

- 37 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

- 38 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.**