

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

The Boards of Appeal

DECISION
of the Third Board of Appeal
of 11 August 2009

In Case R 887/2008-3

Normann Copenhagen ApS

Strandboulevarden 98
DK-2100 Copenhagen ø
Denmark

Appellant / Design Holder

represented by SANDEL, LØJE & WALLBERG, Frederiksgade 7, DK-1265,
Copenhagen K, Denmark

v

Paton Calvert Housewares Limited

Millbrook Trading Estate
Southampton, Hampshire SO9 4UQ
United Kingdom

Respondent / Invalidity Applicant

represented by FRY HEATH & SPENCE LLP, The Gables, Massetts Road, Horley,
Surrey, RH6 7DQ, United Kingdom

APPEAL relating to Invalidity Proceedings No ICD 4661 (Registered Community
Design No 000 389 648 - 0 002)

THE THIRD BOARD OF APPEAL

composed of Th. Margellos (Chairperson and Rapporteur), D. T. Keeling (Member)
and M. Bra (Member)

Registrar: J. Pinkowski

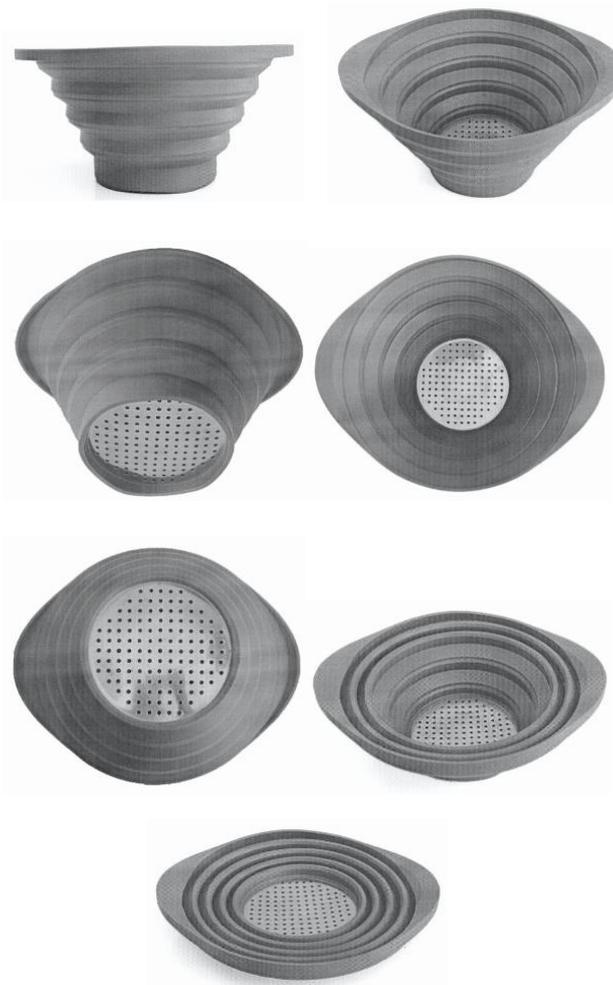
gives the following

Language of the case: English

Decision

Summary of the facts

- 1 By application received on 22 August 2005, Normann Copenhagen ApS (hereinafter, 'the design holder') sought to register a Community design whose seven views are represented hereunder



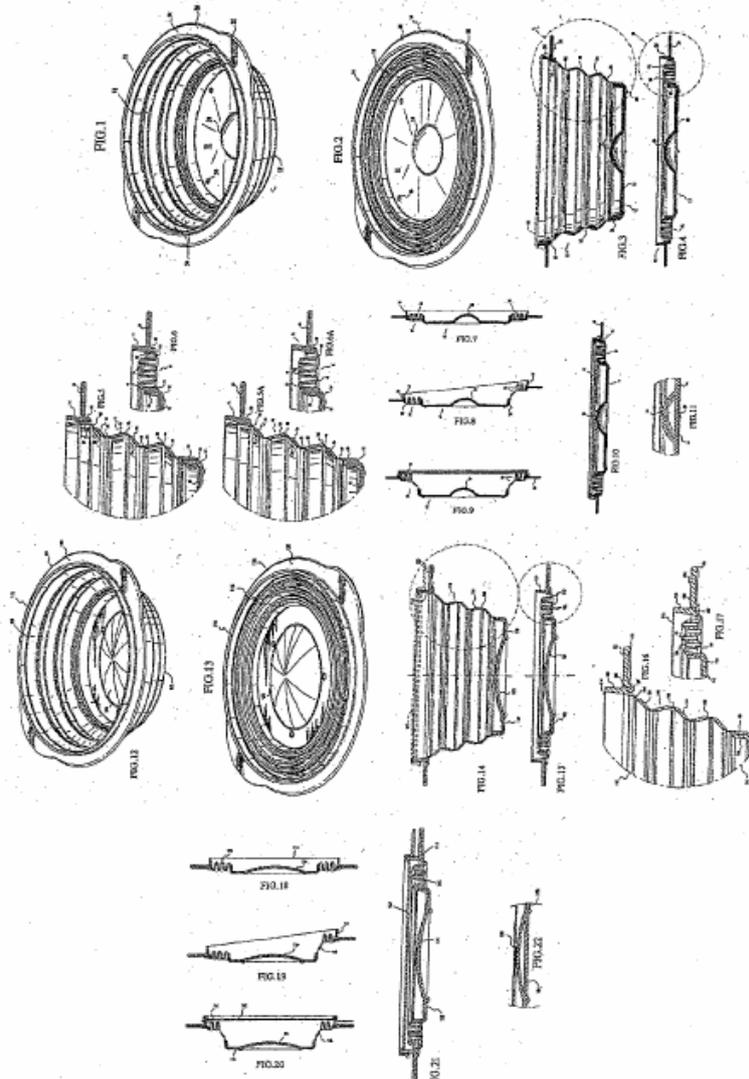
in respect of the following product: 'Colanders' in Class 07-04 of the Locarno Classification

- 2 The Community design was registered under No 000 389 948-0 002 and published in the Bulletin 2005/095 of 4 October 2005.
- 3 On 21 November 2007, Paton Calvert Housewares Limited (hereinafter 'the invalidity applicant') seeks a decision whereby the Office declares the invalidity of the Community design (hereinafter, the 'contested design') on the ground that it does not fulfill the requirements of Articles 4 to 9 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, he argued as follows:

- The contested design consists of a generally commonplace colander shape, i.e. a hemispherical section with a handle at the open end and an array of apertures distributed on the hemispherical purpose;
- The contested design is invalid under Article 8(1) as the only novelty in the design, compared with standard colanders, is solely dictated by its technical function;
- The contested design is not novel since it differs only in immaterial details from the design of a container published with the application for a European Patent no. 1 544 118 B1, on 22 June 2005, prior to the filing of the design;



- Due to the essential functions of a colander, certain features are predetermined by technical requirements, which narrows the degree of freedom of the designer, at least to some extent;
- 4 On 11 February 2008, the design holder argued that:
- Article 8(1) CDR is not applicable in the present case because the contested design is not dictated by the technical function of the product. A colander can have numerous appearances in order to fulfill its technical purpose, namely to enable the user to separate liquids from foodstuffs;
 - The contested design is not identical to the container featured in the European patent relied upon: the bottoms of the contested design and the bowl or container are different;
 - The contested design produces a different overall impression with respect to the one in the European patent application and is endowed with individual character.
- 5 By decision of 11 April 2008 (hereinafter ‘the contested decision’) the Invalidity Division upheld the application for invalidity and declared the contested RCD invalid pursuant to Article 25(1)(b), on the grounds that the RCD is not new within the meaning of Article 5 CDR.
- 6 The design holder filed an appeal on 11 June 2008 followed by the statement of grounds on 17 July 2008. The Invalidity applicant did not file observations.

Submissions and arguments of the design holder

- 7 The design holder requests the Board to annul the contested decision and to declare valid the contested design. Its submissions and arguments may be summarized as follows:
- The novelty and individual character of a Community design are to be assessed against prior designs made available to the public, but not against designs which, in the ordinary course of business, could not be reasonably expected to come to the attention of those operating in the relevant field in the Community;
 - The invalidity application is based on a European patent registration, which was published on 14 November 2007 and is basically an invention. The contested design was applied for on 22 August 2005, more than two years prior to the publication of the registration of the patent containing the prior design;
 - The contested design is an industrial design for a kitchen utensil. As a rule, such industrial designs in general only seldom contain patentable invention.

It is not reasonable to expect that the publication of a patent application would ‘come to the attention of producers of industrial design for kitchens’;

- The earlier design has therefore not been made available to the public within the meaning of Article 7 CDR. Thus the contested design does not lack novelty;
- Contrary to what it is stated in the contested decision ‘the slightly non-circular orbit that applies to the outer ring of the RCD and thus very elegantly...entails the handles of the strainer is not identical to that of the earlier design.’ In fact, the ‘outer ring of the earlier design is circular but with handles ‘attached’ to this circle, the handles being constructed by just less than the half of a circle with a radius much smaller than that of the outer ring. This difference is not immaterial in the sense of Article 5(2) CDR but is rather very clear difference in design expression, method and idea’;
- The bottom of the RCD is made from metal and has perforations; thus, it has a different surface both in colour and feel compared to the rest of the strainer. On the other hand, the bottom of the earlier design is very distinctive, as the centre of the bottom consists of a half globe and therefore differs very much from the bottom of the RCD. These differences cannot be viewed as merely immaterial details;
- The contested decision seems to rely on the concept of ‘the informed user’. However, this concept is to be used in relation to the assessment of individual character according to Article 6 CDR, not in the assessment of novelty. The argument that an informed user easily can change bottoms is therefore irrelevant in relation to the assessment of novelty.

Reasons

- 8 The appeal complies with Articles 55, 56 and 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 L 341, 17.12.2002, p. 28–53). It is therefore admissible.
- 9 Pursuant to Article 4(1) CDR, a design is to be protected as a Community design to the extent that it is new and has individual character.
- 10 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.'

11 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.'

12 In its application for declaration of invalidity, the invalidity applicant contended that the design had been anticipated by a European patent application EP 1544 118 B1 filed on 10 December 2004.

13 In that regard, the appellant's argument is that the registration of the European patent in question was published on 14 November 2007, that is more than two years after the date of filing of the application for registration of the contested RCD. It adds that it is not reasonable to expect that the publication of a patent application would come to the attention of designers of kitchenware.

14 Nevertheless, that argument cannot be sustained. As it clearly results from the evidence submitted by the invalidity applicant, the European patent application containing the earlier design was published on 22 June 2005 in the Bulletin No 2005/25 of the European Patent Office. Such a publication constitutes a disclosure within the meaning of Article 7(1) CDR. As from that date, the design in question is deemed to have been made available to the public, including consequently industrial designers of kitchenware.

15 In its application for declaration of invalidity, the invalidity applicant referred to the contested RCD's lack of novelty and individual character. The Invalidity Division based the contested decision on the lack of novelty of the Community design at issue. In its statement setting out the grounds of its appeal, the design holder argued that the contested Community design possessed novelty, and that the concept of the 'informed user' is not applicable in relation to the assessment of the novelty of a design.

- 16 In that regard, it must be stressed that novelty and individual character overlap to some extent, although presented as separate requirements in Articles 4 to 6 CDR. Obviously, if two designs are identical, except in immaterial details, they will produce the same overall impression on the informed user. It is equally obvious that if two designs produce a different overall impression on the informed user, they cannot be identical (see, in that regard, decision of 22 November 2006, in case R 196/2006-3 ('Underwater motive device') at paragraphs 19 and 20)
- 17 In spite of the overlap between novelty and individual character, there are certain differences between the two requirements. When assessing the novelty, the Board simply has to decide whether two designs are identical. The only area where difficulties of interpretation might arise is in relation to the term 'immaterial details'.
- 18 On the other hand, when assessing the individual character, the Board is required to take into account the overall impression on the informed user, having regard to the degree of freedom of a designer in developing the design. If the designer had relatively little freedom in developing the design, especially on account of technical constraints, even small differences in relation to earlier designs may be sufficient to endow the design with individual character.
- 19 In the contested decision, the Invalidity Division held that the contested RCD lacked novelty.
- 20 The present design relates to a colander of a type commonly used, i.e. a bowl section with handles at the open end and an array of apertures distributed on the bowl section. Colanders of the same type are extremely well known and are common items of kitchenware. The case at issue concerns colanders of this type, where the bowl rather than being of a rigid construction as with a conventional colander, is collapsible or foldable to a compact position when empty, to facilitate convenient storage.
- 21 The contested RCD is a design of a colander with a concentric shape, a metal plate with holes at the narrower end and two handles at the wider end. It is divided into concertina-shaped structures, which allow the colander to collapse. When collapsed, it has a series of regularly shaped rings with different diameters placed parallel from the centre to the outlines of the design, which are identical in form, with the exception of the outer ring which has a slightly non-circular orbit to encircle the handles.
- 22 The prior design is a design of a container or a bowl with a narrower end and two handles at the wider end. It is divided into concertina-shaped structures, which allows collapsing the bowl. When collapsed, it has a circular elevation in the centre. Further, it has a smooth plain surface running from the globe to three narrow rings ending the outlines of the bowl with a wider flat ring on which the handles are attached.
- 23 According to the contested decision, the differences in the bottoms are only an immaterial detail according to Article 5(2) CDR. That finding is contested by the design holder who is arguing that the center of the bottom of the earlier design

consists of a half-globe and therefore differs very much from the bottom of the contested RCD which is perforated and made from metal. It also adds that both designs differ also in the handles. According to the design holder, these differences cannot be viewed as merely immaterial details.

- 24 Nevertheless, in the present case, it is not necessary to decide on the question, 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. In fact, the contested RCD lacks individual character, since the differences highlighted by the design holder are not sufficient to affect the overall impression that the two designs produce on the informed user.

On the informed user

- 25 First, the Board is of the opinion that as correctly stressed by the design holder, the reference made by the contested decision 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 that user. In case of novelty, the regulation does not specify the reference person. It is therefore the Office's task to assess the differences on the basis of the overall appearance of the designs in question.
- 26 According to the decisional practice of this Board, the informed user is identified on the basis of the class of products within which, according to the application for registration, the design itself is intended to be incorporated.
- 27 In the present case, the holder declared in the application that the design concerned 'colanders'. The informed user against whom individual character of the contested RCD should be measured is therefore whoever habitually purchases such an item and generally kitchen utensils and puts them to its intended use and has become informed on the subject by browsing through catalogues, visiting the relevant stores, downloading information from the Internet shops, etc. (see by analogy decision the Third Board of Appeal of 18 September 2007 in Case R 250/2007-3 'Tavoli').
- 28 The informed user is generally not technically experienced or particularly interested in the technical design of colanders. He will therefore not pay attention to every detail of the device. Instead, he will undertake an overall view including *inter alia* the attractiveness of the design and the practicability of the device.

On the overall impression of the designs at issue.

- 29 The Board notes that in its statement of grounds, the design holder pointed out and described differences
- a) in the handles:
the handles of the design are encircled by adding a slightly non-circular orbit to the outer ring which makes the handles look ‘integrated’ to the outer ring instead of ‘attached’ to the outer ring which is the case for the container;
 - b) in the bottoms:
the centre of the bottom of the earlier design consists of a half globe without holes and therefore differs from the bottom of the RCD which has perforations.
- 30 Nevertheless, the two features highlighted by the design holder do not have a significant impact on the overall impression produced by the two designs. The handle is a small part of the whole unit and a small difference in the shape of the handle cannot have a significant impact on the overall impression produced by the design. The handle in the contested RCD may, as the design holder argues, look integrated to the outer ring instead of ‘attached’ to that ring but the position, shape and the general configuration of the handles in both designs are highly similar. Informed users would have to look closely before noticing the slight difference in the handles which concern a small part of the unit as a whole.
- 31 Furthermore, the differences in the bottoms of the RCD and the earlier design do not have any significant impact on the overall impression. The perforations or holes in the bottom of the RCD serve a technical purpose i.e. to allow liquids to be drained from foodstuffs. The informed user knows that it can change the bottom easily and therefore will concentrate its attention on the ground shape.
- 32 In that regard, it must be stressed that in determining whether two designs produce the same overall impression on the informed user, it is necessary to disregard elements -like the perforated bottom of a colander- that are totally banal and common to all examples of the type of products at issue. The informed user will automatically discard such features when appraising the overall impression caused by two designs and will concentrate on features that are arbitrary or different from the norm.
- 33 If the two designs in question are looked at as a whole, the conclusion of the informed user would be that they produce the same overall impression. As it was stated in the contested decision and not contested by the design holder, the two opposing designs have the same concentric shape, with the concertina-shaped structures, the purpose of which is to provide the technical function of collapsibility. The structure of both designs allows the device to remain flat when in the closed or collapsed position and remain expanded when in any open or partially open position. When they are collapsed, both have a series of rings from the center to the outlines of the design which are identical in width and are apart

from the outer ring, which has a slightly non-circular orbit that encircles the handles.

- 34 Compared to the container illustrated in the European patent in question, the differences are insignificant; the perforations in the bottom in order to provide a colander action and the handles of the contested RCD which look integrated to the outer ring rather than attached to the outer ring as is the case of the earlier container design, are not sufficient to confer individual character on the RCD.
- 35 The design holder could have sought design protection for the handles alone or for the perforated bottom since these elements are component parts of a complex product which remain visible in normal use. The question then would have been whether the handle or the bottom in the earlier design and the handle or bottom in the RCD produce the same overall impression on the informed user.
- 36 Since however the contested RCD concerns a colander device as a whole (that is not merely the handle or the bottom), the comparison must be effectuated between the whole of the earlier container design and the whole of the contested colander RCD design. If the two designs are looked at as a whole, their overall shape, configuration and general appearance is highly similar. The differences do not significantly affect the overall impression produced by the devices since they are details which although not insignificant, relate to what are essentially marginal elements of the two devices, when they are observed in their entirety.
- 37 The differences noted by the design holder might well be enough for the contested RCD to survive the strict novelty test under Article 5 CDR but do not assist in the framework of Article 6 CDR.

On the degree of freedom of the designer

- 38 Another important factor in the assessment of individual character is the degree of freedom that professionals who design colanders, enjoy. In that regard, it must be pointed out that the only requirement for a device to function as a colander is to have a concave-shaped body with perforations at least in its bottom side to allow the liquid drain through the perforations while keeping the foodstuff. Therefore, certain features must be present in a colander if it is to perform its function. It is nevertheless difficult to see any reason why the contested RCD needs to resemble the appearance of the earlier container design to such a remarkable degree.
- 39 Colanders may take many forms. The degree of freedom of the designer is relatively wide, as regards the shape of the body, the proportions, the structure and the handles. It is true that a colander device must fulfil certain basic functions but in the present case, this does not extent so far that the designer is deprived of all design options. This results in allowing for a variety of design options in order to stand out from competitors. It follows that the appellant could have distanced itself much more from the prior design.

- 40 In the light of the above considerations, the Board concludes that the designs produce the same overall impression. Consequently, the contested RCD is invalid for lack of individual character.
- 41 Accordingly, the contested decision declaring the registered Community design invalid is upheld and the appeal is dismissed.

Costs

- 42 Since the appeal has been unsuccessful, the design holder must be ordered to bear the costs incurred by the invalidity applicant in accordance with Article 70(1) CDR.

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the design holder to bear the fees and costs incurred by the applicant for invalidity.**

Th. Margellos

M. Bra

D.T. Keeling

Registrar:

J. Pinkowski