



**DECISION
of the Third Board of Appeal
of 17 April 2008**

In Case R 860/2007-3

Wuxi Kipor Power Co., Ltd.

Beside Jingyi Rd, Third-Stage Development Section
of Wangzhuang Industry Area,
214101 Wuxi High & New Technology Industry Development Zone
Wuxi City, Jiangsu Province
The People's Republic of China

RCD proprietor/Appellant

represented by Bardehle, Pagenberg, Dost, Altenburg, Geissler, Galileiplatz 1,
D-81679 Munich, Germany

v

Honda Giken Kogyo Kabushiki Kaisha

(also trading as Honda Motor Co., Ltd.)
No. 1-1, Minami-aoyama 2-cho, Minato-ku
Tokyo 107-8556
Japan

Invalidity Applicant/Respondent

represented by Rospatt Osten Pross, Kaiser-Friedrich-Ring 56, D-40547 Düsseldorf
(Oberkassel), Germany

APPEAL relating to Invalidation Proceedings No ICD 2 178 (Registered Community
Design No 171178-0004)

THE THIRD BOARD OF APPEAL

composed of Th. Margellos (Chairperson), H. Salmi (Rapporteur) and I. Mayer
(Member)

Registrar: J. Pinkowski

gives the following

Decision

Summary of Facts

- 1 On 23 April 2004 Wuxi Kipor Power Co., Ltd. (hereinafter, the appellant) filed a multiple application to register, as Community Designs, five designs of inverter generators. The design No 171178-0004 ('the contested RCD') represented below is the one at issue in these proceedings:



- 2 On 27 July 2004 the five designs were published as registered Community designs in the Community Designs Bulletin.
- 3 On 3 March 2006 Honda Giken Kogyo K.K. (hereinafter 'the respondent') filed an application for a declaration of invalidity against the contested RCD. The respondent argued that the design did not fulfil the requirements of novelty and individual character under Articles 4 to 6 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs ('CDR') (OJ EC 2002 No L 3, p 1). As evidence, it provided *inter alia* the original of a catalogue 'Der Zubehör Profi 2000' bearing an indication 'Saison ab 1.3. bis 31.7.2000' on the back page. On page 330, the catalogue shows the following design (hereinafter 'the prior design')



- 4 On 3 April 2007 the Invalidity Division of the Office issued a decision ('the contested decision') declaring the contested RCD invalid pursuant to Article 25(1)(b) CDR and ordered the appellant to bear the costs. The reasoning in the contested decision may be summarized as follows:
 - The prior design and the RCD are not identical within the meaning of Article 5 CDR since there are some differences between them. Both of the designs have a cubic shape with two black panels on opposite sides enclosing a central portion of a lighter colour. The upper corners of the cubic form of each design are rounded. Both have a trolley mount with four wheels and a knob on the top side as well as a handle bar at the sides of the generator. However, in contrast to the prior design, the RCD has an oval area for the switches and plugs as well as another additional oval air inlet/outlet. Furthermore, the handles of the RCD are bent upwards whereas the handles of the prior design are only horizontal.
 - The informed user is familiar with the design of generators and is aware that the degree of freedom of a designer concerned with generators is limited only in so far as the generator has to be operational which requires the provision of a housing, handles and access to instruments.
 - The characteristic features of the RCD are all present in the prior design. In both cases, the housing is of cubic form with black panels enclosing a central portion of a lighter colour. The variations concerning *inter alia* the form of the handle or the form of the area for the switches and plugs do not alter the fact that both designs produce the same overall impression on the informed user. Most of the differing features are situated in the darker parts of the designs. Therefore, they do not influence the overall impression of the informed user as the highly visible elements in the lighter parts in the middle of the housing do.
 - Therefore, the RCD lacks individual character in the meaning of Article 6 CDR.
- 5 On 1 June 2007, the appellant filed a notice of appeal against the contested decision. The appellant submitted a statement of grounds on 3 August 2007.
- 6 On 16 October 2007, the respondent submitted its observations.
- 7 On 27 December 2007, the appellant filed its reply.
- 8 On 11 March 2008, the respondent filed its rejoinder.

Submissions and arguments of the parties

- 9 The appellant requests the Board to revoke the contested decision and to order the respondent to bear the costs of the proceedings. Its arguments may be summarized as follows:
- In determining whether two designs produce the same overall impression on the informed user, it is necessary to disregard elements that are totally banal and common in respect to all examples of the type of product in issue (see Decision of the Board of Appeal dated 27 October 2006, in Case R 1001/2005-3 — METAL RAPPERS).
 - The individual character of the RCD must be affirmed if the RCD and the prior design differ in at least one feature (see the Decision of the Austrian Supreme Court acting as Community Design Court dated 14 February 2006 – Rolling Boards). The prior design does not show all the characteristic features of the contested CDR since the CDR includes, *inter alia*, the following ones:
 - The flattened upper corners and edges of the generator housing have a continuous surface which is not interrupted by an air inlet/outlet (feature G).
 - Air inlets/outlets have a rectangular shape and are provided on both sides of the generator housing in the lower third of the sides (feature H).
 - The handles provided on the sides of the generator housing extend horizontally and vertically with bent sections in between (feature I).
 - The generator has a main area for switches and plugs on the front side of the generator housing, wherein the area is bounded by an oval shaped perimeter (feature J).
 - On the reverse side of the generator housing, opposite to the front side of the generator housing, a second area is provided with an additional air inlet, wherein the additional air inlet/outlet has an oval shaped perimeter which is identical of the oval shaped perimeter of the main area (feature K).
 - The upper edges of the generator housing are curved (feature L).
 - The side surfaces of the generator housing are flat (feature M).
 - The front side of the generator housing has an oval decoration bar (feature N).
 - The pulling handle on the front side has an oval shape (feature O).

- The above-specified variations are partly incorporated in the darker side panels of the design. It was stated in the contested decision that the differing features situated in the darker parts of the design do not influence the overall impression in comparison to the ones incorporated in the lighter parts in the middle of the housing. It is not the depiction of the contested RCD that is decisive for the overall impression of the design, but the perception of the informed user who is familiar with generators and uses them in its daily work. It will indeed recognize the features in the darker parts of the design itself. This is particularly the case with the area for switches and plugs on the front side of the generator (feature J). Whereas, the panel of the RCD is oval, the panel of the prior design is of a rectangular shape.
 - Furthermore, the pulling handles of the conflicting designs are both incorporated in the lighter part of the middle part of the housing. The pulling handle of the RCD (feature O) is, however, round in shape, whereas the prior design is five-sided.
 - The differences in features G to O of the RCD can hardly be dismissed as insignificant. They change the appearance of the electric generator in a manner that will not go unnoticed by an informed user. Given the limited freedom of the designer in developing the design as regards those features that are totally banal and common, the differences between the two designs are sufficient to mean that they produce a different overall impression on the informed user.
 - The contested RCD has been granted protection in many countries such as Korea, Japan, Brazil, Canada or India.
- 10 The respondent requested the Board to dismiss the appeal and to order the appellant to bear the costs of the proceedings. The submissions in its observations can be summarized as follows:
- According to the decision of the Austrian Supreme Court cited by the appellant the assessment whether a design has individual character does not depend on a complete match of the features of the Community design and the prior design. Not the single features, but the respective overall impression of the designs which have to be compared has to be analyzed for differences. The overall impression can be determined by characteristic features. Therefore, to observe the overall impression the single features of the design have to be assessed and weighed according to their contribution to the overall impression.
 - The contested decision complies with these principles. The alleged additional features mentioned by the appellant were not ignored, but the contested decision did not lay the same stress on them because they are situated in the darker parts of the design rather than on the highly visible features in the lighter parts of the design. The alleged additional features are not characteristic features, because they do not contribute likewise to the overall impression as the other features. They do not change the overall impression of the RCD compared with the prior design.

- It is neither technically mandatory nor common in respect to all examples of the generators at issue to provide a housing of an approximately cubic shape with black panels which enclose a central portion of light color. These features are rather arbitrary and different from the norm.
 - The informed user of the generators at issue usually does not use them in his daily work since they are often used for camping and caravanning or gardening. Thus, the informed user will only use them at specific times of the year.
 - The registrations in other countries are irrelevant.
- 11 In its reply, the appellant reiterated its previous arguments and added, in essence, the following:
- The cubic shape of the aluminium main housing is dictated by the technical function of the generator, as it must be easily transported and stored. The use of a cubic form and aluminium as a lightweight metal are necessary to fulfil these criteria.
 - The informed users are not resistant to the features situated in the darker part of the designs but are rather trained and used to look at further details.
 - The informed user, even if it is a camper, is well informed and thus aware of more detailed features than the average consumer.
 - The features of the CDR which are not banal and common nor dictated by a technical function contribute likewise to the overall impression since none of them are dominant.
- 12 In its rejoinder, the respondent stated, in essence, the following:
- The shape of a cube is neither technically mandatory, nor banal or common. The number, size, form and position of the handles and wheels also vary in the examples shown.
 - If the appellant's reasoning is taken into account, most of the alleged additional features (G-O) would also have to be disregarded, because air inlets/outlets and an area for switches and plugs also serve technical purposes for the products at issue.
 - The informed user is the owner of a mobile home or caravan who needs a generator to be independent from power supply systems when he does not want to park on an official campsite. Its main interest is the supply of power and not the design of the generator.
 - With regards to the freedom of the designer and the substantial different overall impression between the designs at hand, the RCD could have added more than minor deviations. These deviations are not of the kind that will

attract the attention of the informed user when it looks at the design from a broader perspective.

Reasons

- 13 The appeal complies with Articles 55 to 57 CDR and Article 34(1)(c) and (2) of Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community designs ('CDIR') (OJ EC 2002 No L 341, p. 28). It is therefore admissible.
- 14 The appeal is however unfounded because the Community design fails to meet the requirement of individual character pursuant to Article 6 RCD. The reasons are set out below.
- 15 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.'
- 16 The issue therefore is whether the two designs 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 conclusion of the contested decision, which is also endorsed by the Board, that the prior design and the contested RCD are not identical within the meaning of Article 5 CDR (lack of novelty) has not been contested.

The informed user

- 17 According to the case-law 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. In the present case, the holder declared in the application that the design concerned an 'inverter generator'. The informed user against whom individual character of the contested RCD should be measured is therefore whoever habitually purchases such an item and puts it to its intended use and has become informed on the subject by browsing through catalogues of such generators, visiting the relevant stores, downloading information from the internet, etc. (see, by analogy, decision of the Third Board of Appeal of 18 September 2007 in case R 250/2007-3 - 'tavoli').

This can be, for example, the owner of a mobile home or a caravan who needs a generator to be independent from power supply systems when he does not want to park on an official campsite.

- 18 The informed user is generally not technically experienced or particularly interested in the technical design of inverter generators. 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.

The earlier design and its divulgation

- 19 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.

Overall impression of the conflicting designs

- 20 The differences highlighted by the appellant (see paragraph 9 above) cannot be described as ‘immaterial’. However, the differences are not sufficient to affect the overall impression that the two designs produce on the informed user.
- 21 In the view of the Board, the contested RCD and the prior design share numerous elements which display strong similarities which are listed as follows: a) a cubic shape, b) two black panels on opposite sides enclosing a central portion of a lighter colour, c) rounded upper corners of the cubic form, d) a knob on the top side of the device, e) handle bars at the sides of the generator, f) indented sides on the top part of the device and g) the proportions of the elements comprised in relation to one another.
- 22 The contested decision also mentions a trolley mount with four wheels as a similarity between the designs. The trolley mount with four wheels can be seen clearly in some of the images provided of the prior design, however, it does not seem to be included in the image which has been used as the basis of the contested decision. In any case such a trolley mount would seem to be an element which could be either an integral part of the design or it may be sold separately. Therefore, for the informed user, it would seem to be an accessory element aiming to give mobility to the generator. Taking these facts into account, the Board is of the opinion that this element is not of relevant importance to the evaluation and notes that the parties have not given importance to it either.
- 23 In any event, the informed user is more likely to be impressed by the overall aspect of the generator rather than the various details that characterise mechanical devices in general. This means that the designs of inverter generators will produce the same overall impression if they globally display the same arrangement of the various component parts of the generator and these components have similar shapes and sizes relative to each other, as is the case here.

- 24 The fact that the elements mentioned above are identically or at least very similarly laid out in the two generators' designs contributes to producing the same visual impression. It must be noted in this regard that no technical necessity obliges a designer to place, for example, the handles on the sides of the device, or to have two of them on the device. Various options exist, as can also be seen from the other designs included in the multiple application of the contested RCD. In fact, none of the elements described in paragraph 21 above are technically necessary.
- 25 The Board notes that there are differences in the details of the designs, such as, for example, as noted in the contested decision, the fact that the contested RCD has an oval area for the switches and plugs as well as another additional oval air inlet/outlet and the handles of the contested RCD are bent upwards whereas the handles of the prior design are horizontal, in addition to other details mentioned by the appellant. However, the Board is of the opinion that these are not features that play a significant role in the overall impression of the designed product.
- 26 It must be underlined that the two designs concern products having a high technical content. Inverted generators, internal-combustion engines, air compressors, power generators and similar appliances are products for which technical characteristics and safety considerations – ease of use, protection against hazards – are of such importance that the informed user's overall impression of the aspect of the product is more likely to be influenced by the general appearance (arrangement of component parts, size, overall shape of components) than by relatively immaterial details (see by analogy, decision of the Third Board of Appeal of 8 October 2007 in case R 1380/2006-3 - 'Internal-combustion engine').
- 27 The Board, in agreement with the contested decision, takes the view that the differences between the designs are not of a type that would attract the attention of the informed user. They are not features which attract the attention of the informed user as clear differences when the design is observed in its entirety. The overall shape, configuration and general appearance of the designs is very 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 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 devices. The differences noted by the appellant 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.
- 28 The Board also agrees with the contested decision as regards to the designer's degree of freedom in developing the design. That degree of freedom is relatively wide. Certain features must be present in an inverter generator in the sense that it requires the provision of a housing, handles and connections for appliances if it is to perform its function, but it is difficult to see any reason why the respondent's design needs to resemble the appearance of the earlier design to such an extent. An inverter generator could surely look significantly different but still function

perfectly well, as can also be seen from the examples produced by the respondent in the invalidity proceedings and, in fact, from the other designs included in the multiple application of the contested RCD. Each device must fulfil a certain basic function, but in the present case this does not extend 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, rather than by merely incorporating differences, which is what the changes it has mentioned to its design amount to.

- 29 The Board concludes that the contested RCD is invalid for lack of individual character. The appeal must be dismissed.

Costs

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

Order

On those grounds,

THE BOARD

hereby:

- 1 Dismisses the appeal;**
- 2 Orders the appellant to bear the costs incurred by the respondent.**

Th. Margellos

H. Salmi

I. Mayer

Registrar:

J. Pinkowski