

DECISION
of the Third Board of Appeal
of 29 April 2019

In Case R 34/2018-3

Creative Design Ideas Limited

McGills Oakley House, Tetbury Road
Cirencester Gloucestershire GL7 1US
United Kingdom

Design Holder / Appellant

represented by Richard R. Halstead, 18 Drayton Close, Cheltenham GL51 9QB,
United Kingdom

v

Shine Shimizu

1-31-12 Oshitatecho
Fuchu, Tokyo Prefecture 183-00012
Japan

Invalidity Applicant / Respondent

represented by LANGPATENT ANWALTSKANZLEI, Ingolstädter Str. 5,
80807 München, Germany

APPEAL relating to Invalidation Proceedings No ICD 10 670 (registered Community
design No 1 424 188-0006)

THE THIRD BOARD OF APPEAL

composed of Th. M. Margellos (Chairperson), C. Bartos (Rapporteur) and E. Fink
(Member)

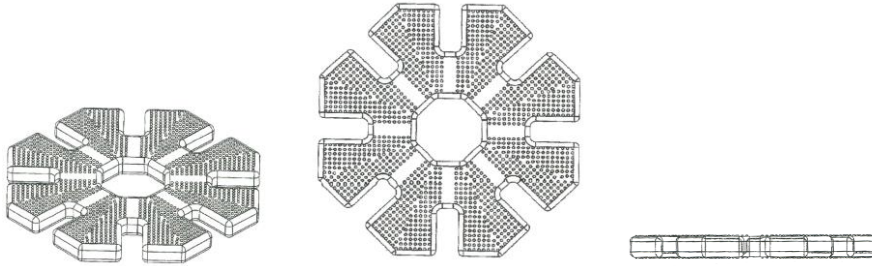
Registrar: H. Dijkema

gives the following

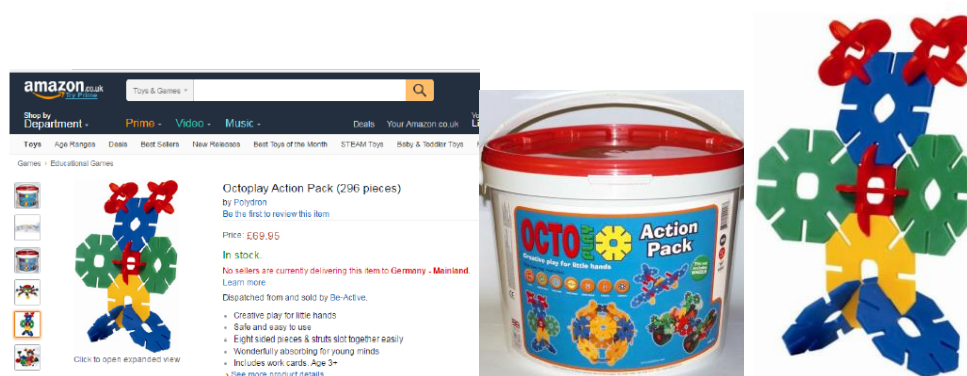
Decision

Summary of the facts

- 1 The appellant is the holder of the registered Community design No 1 424 188-0006 ('RCD'), with a filing date of 29 October 2014. The RCD is represented in the following views:



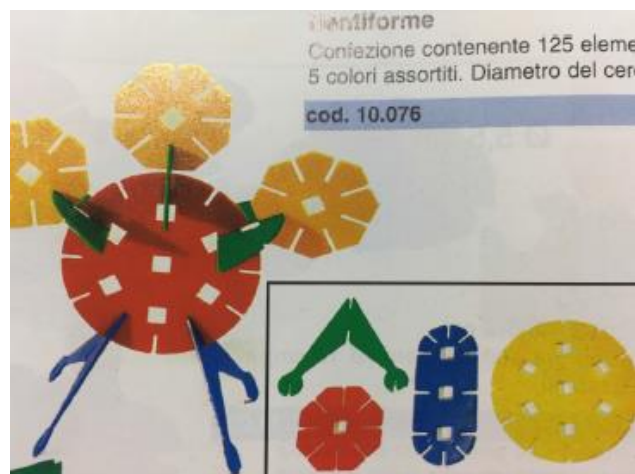
- 2 The indication of the products reads: 21-01 educational toys.
- 3 The RCD was published in the Community Designs Bulletin No 2014/225 of 28 November 2014.
- 4 On 6 March 2017 the defendant filed an application for a declaration of invalidity of the RCD based on Article 25(1)(b) CDR in conjunction with Articles 4, 5, and 6 CDR. The defendant claimed that the contested RCD lacked novelty and individual character with respect to prior designs.
- 5 As evidence for the disclosure of a prior design (in the following: D1), the defendant submitted inter alia a printout showing the 'Octoplay' educational toy on the website amazon.co.uk, indicating that it was available to the public since 08/09/2008. The print-out includes the following images:



- 6 By decision of 8 November 2017 ('the contested decision'), the Invalidation Division declared the RCD invalid due to lack of individual character, reasoning that although the informed user would be able to perceive the differences between the prior design D1 and the contested RCD, the overall impression produced was the same. The differences between the conflicting designs were much less obvious than the overall impression resulting from the numerous, very similar, features.

Submissions and arguments of the parties

- 7 The appellant filed an appeal, requesting that the contested decision be set aside. In the statement of grounds the appellant argues that the Invalidity Division wrongly evaluated the degree of freedom of designer. It attributed too much weight to the similarities resulting from the necessity to connect the toy with other such toys, while it gave too little weight to the differences where freedom of the designer existed. Had the Invalidity Division correctly assessed the importance of the distinguishing features it would have found the contested RCD to have individual character. In particular, it failed to acknowledge that a constructional toy element of octagonal shape is necessarily in the shape of an octagon, and if the intention is for the toy element to be connected with other such two elements in a push fit other than in edge-to-edge relationship (in which case some other form of connection mechanism is necessary), a central slot in the middle of each octagonal segment is a necessary function, not a design option. In short, the Invalidity Division fell into the error of failing to distinguish between ordinary toys and inter-connectable toys. The toy according to the contested RCD shows a textured arrow pattern of protruding dots on the surface of each segment and an octagonal hole in the centre of the toy, which both result to a very different overall impression compared to the prior design. The Invalidity Division also failed to point out the contested RCD is substantially thicker than D1 and that the notches are substantially wider in the contested RCD than in D1. These differences affect the whole character of the design, making it more ‘chunky’ in overall appearance than D1.
- 8 In its observations in reply the defendant endorses the contested decision and requests that the appeal be dismissed. The defendant argues that the degree of freedom of the designer of such products is broad, if not to say unlimited. There are many forms for inter-connectable toys. As evidence, the defendant refers to the catalogue ‘Selezione materiale didattico 2005/06’, published in Italy, which it had submitted previously before the Invalidity Division. The catalogue contains the following picture:



- 9 The picture above affirms that by choosing the octagonal shape for the RCD the designer him/herself restricted his/her own freedom; this cannot be evaluated to his/her advantage. The octagon exists very rarely in nature. It is a geometric form

which produces a foreign and abstract impression. Only very special design arts, in particular architecture, use octagonal shapes. As regards the other features of the RCD, the children will not pay any attention to considerations whether there are ‘arrow-shaped patterns’ or, for example, flowers or no pattern at all. Neither do the central holes make any difference as each of the holes of the conflicting design is multi-sided. Whether a hole is square or octagonal depends on the ratio of its rounded corners to its edges; the difference does not create an overall deviating visual effect. The Invalidity Division correctly recognized and took into consideration all differences between the conflicting designs as admitted by the appellant who copied the list of similarities and differences from the contested decision. Despite these differences, the prior design and the contested RCD produce the same overall impression on an informed user.

Reasons

- 10 The appeal complies with Articles 56 and 57 CDR and Article 34 CDIR. It is, therefore, admissible.

On the matter to be reviewed by the Board

- 11 The Board notes that the appellant did not contest the finding of the Invalidity Division that the prior design D1 has been made available to the public before the filing date of the contested design and may thus be regarded as prior design within the meaning of Article 7 CDR.
- 12 The Board further notes that the appellant did not contest the finding of the Invalidity Division as regards the novelty of the contested RCD but directs its appeal against the Invalidity Division’s findings concerning the individual character of the contested RCD.
- 13 The Board sees no reason why it should divert from the findings of the Invalidity Division and confirms these findings.

Individual character

- 14 Article 6(1)(b) CDR provides that individual character falls to be assessed, in the case of a registered Community design, in the light of the overall impression produced on the informed user, which must be different from that produced by any design made available to the public before the date of filing of the application for registration or, if a priority is claimed, before the date of priority. Article 6(2) CDR states that, for the purposes of that assessment, the degree of freedom of the designer in developing the design is to be taken into consideration.

(1) The informed user

- 15 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 (22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 43).

- 16 According to the case-law, an ‘informed user’ within the meaning of Article 6 CDR is neither 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 (09/09/2011, T-10/08, ‘Internal combustion engine, EU:T:2011:446, § 23; 18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 62, confirmed by 20/10/2011, C-281/10 P, Metal rappers, EU:C:2011:679, § 54).
- 17 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 (22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 46; 09/09/2011, T-10/08, ‘Internal combustion engine, EU:T:2011:446, § 24). Although the informed user is not the well-informed and reasonably observant and circumspect average consumer who normally perceives a design as a whole and does not proceed to analyse its various details, he/she is also not an expert or specialist capable of observing in detail the minimal differences that may exist between the designs at issue. Thus, the qualifier ‘informed’ suggests that, without being a designer or a technical expert, the user knows the various designs which exist in the sector concerned, possesses a certain degree of knowledge with regard to the features which those designs normally include, and, as a result of his/her interest in the products concerned, shows a relatively high degree of attention when he/she uses them (20/10/2011, C-281/10 P, Metal rappers, EU:C:2011:679, § 59; 10/09/2015, T-526/13, Sacs a main, EU:T:2015:614, § 25).
- 18 The contested RCD and the prior design D1 both show educational toys. Informed users of these kinds of products are those who usually purchase them having previously browsed through catalogues or the internet or visited the relevant stores. The circle of informed users consists of parents of infants as well as educators, child care works and kindergarten teacher, who are all familiar with the area of educational toys. . The informed user will undertake an overall view, taking into account the attractiveness of the design and the practicability and efficiency of the device (05/02/2016, R 2407/2014-3, Kitchen utensils, § 35 and 11/08/2009, R 887/2008-3, Colanders, § 27-28).

(2) The degree of freedom of the designer

- 19 According to case-law, the designer’s degree of freedom in developing his/her 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. The more the designer’s freedom in developing the contested design is restricted, the more likely minor differences between the designs at issue will be sufficient to produce a different overall impression on the informed user (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 67, 72; 10/09/2015, T-526/13, Sacs à main, EU:T:2015:614, § 28).

- 20 The degree of freedom of a designer of educational toys, including the inter-connectable toys of the type into which the contested RCD is incorporated, is limited by the requirement that toys of this type should easily connect with toys or elements of these toys of the same type. In order to do so each of the toys need to have notches for interconnection.
- 21 However, contrary to the assertion of the appellant, the requirement for inter-connection does not mean that the toys must necessarily have octagonal shapes. The evidence submitted by the defendant before the Invalidity Division shows inter-connectable educational toys in various shapes, such as circular and elongated shapes. Evidently, there is no need to limit the variety of shapes to an octagon form. On the contrary, the creation of new shapes may be welcomed by the children using these toys and foster the educational purpose of these toys by giving the users a variety of choices.
- 22 It must therefore be confirmed that there is considerable breadth of freedom of the designer also as regards the shape of the toys. **As a consequence of the high degree of freedom of the designer, small differences do not suffice to create a different overall impression.**

(3) The comparison of the overall impressions

- 23 According to case-law, the individual character of a design results from an overall impression of difference or lack of 'déjà vu', from the point of view of an informed user, in relation to any previous presence in the design corpus, without taking account of any differences that are insufficiently significant to affect that overall impression, even though they may be more than insignificant details, but taking account of differences that are sufficiently marked so as to produce dissimilar overall impressions (07/11/2013, T-666/11, Gatto domestico, EU:T:2013:584, § 29 and the case-law cited).
- 24 In the informed user's view, the designs have the following notable similarities: Both designs consist of an octagonal shape. This shape is divided into eight outer segments that have an arrow-shaped edge. The shape is divided by eight identical elongated straight notches that are perpendicular to its edges. Both designs have bevelled edges. Finally, both designs have holes in their centres, albeit of slightly different shapes.
- 25 For the informed user, the contested RCD and the prior design mainly differ in that the following features: The contested RCD shows an ornamental pattern on the design's surface, namely protruding dots all over the surface in a regular pattern of rows perpendicular to the sides of the eight segments and meeting in the central axis of each segment. The side view of the RCD shows that the contested design is thicker than D1. The hole in the centre of D1 is square, whereas in the contested RCD it is octagonal. The contested design shows cut-out sections extending from the central hole (which might also be part of the ornamentation), not present in the prior design. The eight elongated notches are wider in the contested RCD than in the prior design. The toy according to the RCD may be slightly thicker.

- 26 In the informed user's view, the differences between the contested RCD and the prior design D1 mentioned in paragraph 25 above are considerably less striking than the overall impression given by the much larger and notable strongly similar features mentioned in paragraph 24 above. The pattern on the design's surface formed by protruding dots is hardly visible as the dots are tiny, dense and uniform. Indeed, users will perceive the pattern as no more than a slight roughening of the surface. Likewise, the differences in the thickness of the toys and the widths of the notches are very small compared to the overall dimensions of the toys. The same applies to the differences in the shape of the inner holes which are very small in relation to the diameters of the toys.
- 27 Even though there are differences, the fact remains that in view of the high degree of freedom of the designer the overall impression is not different, since the main features which determine the overall impression produced by the designs at issue are highly similar. As held in the contested decision, both designs are dominated by very similar shapes of octagonal form, divided into eight outer segments by notches. Furthermore, the two designs under comparison have the bevelled edges and holes in the centre, albeit of slightly different form.
- 28 It follows from all the above considerations that the contested decision rightly found that the contested RCD did not produce a different overall impression from that of the prior design D1 on the informed user and, as a result, lacked individual character in the sense of Article 6(1)(b) CDR.
- 29 Accordingly, the appeal must be dismissed and the contested decision confirmed.

Costs

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

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Order the design holder to bear the invalidity applicant's fees and costs.**

Signed

Th. M. Margellos

Signed

C. Bartos

Signed

E. Fink

Registrar:

Signed

p.o. P. Nafz

