

INVALIDITY No ICD 10 790

Jianhui Li, 161st, Pinghu Street, Pinghu Town, Longgang District, Shenzhen, the People's Republic of China (applicant), represented by **Becker Kurig Straus**, Bavariastr. 7, 80336 München, Germany (professional representative)

a g a i n s t

Shenzhen Abizoe E-commerce Co., Ltd., Room 509, No. 16, Longsheng Road, Longgang Street, Longgang District, Shenzhen, the People's Republic of China (holder), represented by **Isabelle Bertaux**, 55 rue Ramey, 75018 Paris, France (professional representative).

On 09/04/2018, the Invalidation Division takes the following

DECISION

1. The application for a declaration of invalidity is upheld.
2. Registered Community design No 003613512-0001 is declared invalid.
3. The holder bears the applicant's costs, fixed at EUR 750.

REASONS

The applicant filed an application for a declaration of invalidity (the application) against Community design No 003613512-0001 (the RCD). The RCD was filed and registered in the holder's name on 09/01/2017.

The following products are indicated in the registration:

03-01 *Tablets (Cases for -).*

The registration contains the following images:





Please note that the images in this document are not necessarily to scale.

The applicant invoked Article 25(1)(b)CDR in conjunction with Articles 4 to 7CDR.

SUMMARY OF THE PARTIES' ARGUMENTS

The applicant argued that this prior Community design No 002091934-0001, filed on 24/08/2012, was identical to the contested RCD. Both designs are registered for computer/tablet covers or cases and they have the same shape and surface pattern. A slot in the prior RCD is replaced by two smaller slots in the contested RCD, but this sole difference should be considered an immaterial detail.

In support of his observations, the applicant submitted the following evidence:

- An extract from the EUIPO database containing information on RCD No 002091934-0001, showing 29/08/2012 as the publication date.

The holder did not submit any observations in reply.

ARTICLE 25(1)(b)CDR IN CONJUNCTION WITH ARTICLES 4 TO 7CDR

a) Disclosure pursuant to Article 7CDR

For the purpose of applying Articles 5 and 6CDR, the tests of novelty and individual character, a design will be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, before the RCD filing date or the RCD priority date, if a priority is claimed, 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 EU.

Publication of an earlier design in the Office bulletin constitutes disclosure within the meaning of Article 7(1)CDR (decision of 16/06/2014, R 1287/2013-3, Lights, § 19).

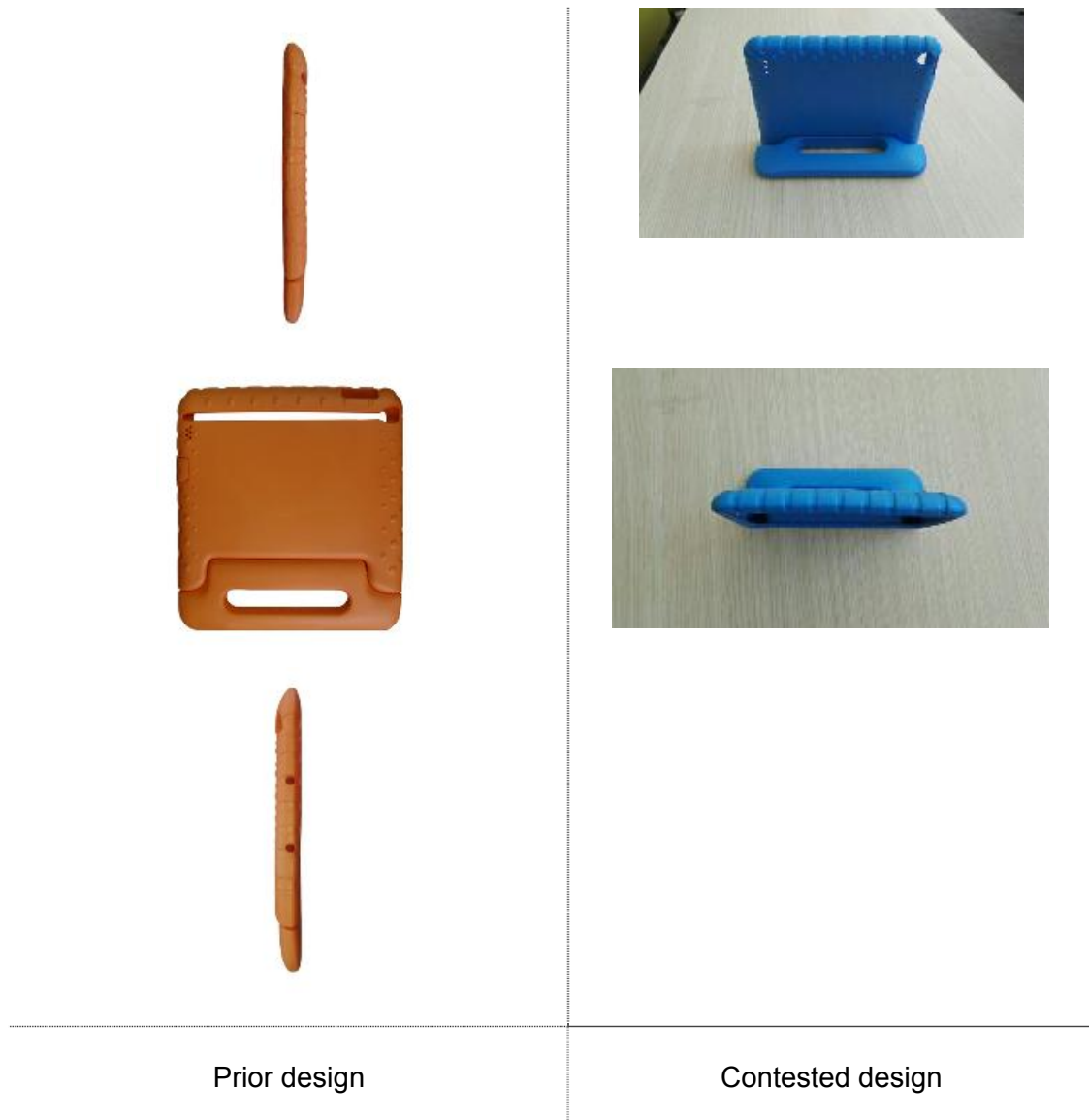
The earlier Community design was published in 2012, which was prior to the filing date of the contested RCD. Therefore, it is considered that it was made available to the public in compliance with Article 7(1)CDR.

b) Novelty pursuant to Article 5CDR

Article 5(1)(b)CDR provides that a registered Community design must be considered to be new if no identical design has been made available to the public 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. Article 5(2)CDR provides that designs must be deemed to be identical if their features differ only in immaterial details.

The designs under comparison are shown below:





The designs under comparison have the same bulky rectangular shape with rounded corners, a structure that consists of a main part and a collapsible handle or stand, and the same decorative elements on the outer sides of the main part. Both designs also include a rounded cut-out at the top left and three small oval cut-outs at the top right of the main part of the case (although the cut-out at the top left is merged with a large horizontal cut-out in the prior design).

The visible differences consist of the horizontal cut-out that stretches across the top part of the main part of the case in the prior design, which is not present in the contested design. The earlier design also shows some elements (a cut-out and a rounded button) on the left and right sides of the case, which are not clearly visible in the contested design.

The colours also differ: the prior design is red and the contested design is blue.

These differences cannot be considered totally immaterial and, therefore, the claim under Article 5 CDR must be rejected.

c) Individual character pursuant to Article 6CDR

Under Article 6(1)(b)CDR, a registered Community design must 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 that has been made available to the public 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. Article 6(2)CDR states that, in assessing that individual character, the degree of freedom of the designer in developing the design must be taken into consideration.

Recital 14CDR provides that, when assessing whether a design has individual character with respect to the existing design corpus, it is necessary to take into consideration 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.

It follows from the above that the assessment of the individual character of a Community design with respect to any earlier design disclosed to the public must, in essence, proceed from a four-step review:

- the sector of products in which the compared designs are incorporated or to which they are applied,
- the informed user of the products according to their purpose and, in reference to the informed user:
 - the degree of knowledge of the state of the art, and
 - the degree of attention in the comparison, direct if possible, of the designs,
- the degree of freedom of the designer in the development of the designs, and
- the result of the comparison of the designs, taking into account the overall impressions produced on the user by the contested design and any of the earlier designs. The assessment should not be simply an analytical comparison of a list of similarities and differences (see judgments of 18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 54-84; 20/10/2011, C-281/10 P, Metal rappers, EU:C:2011:679, § 53-59; 07/11/2013, T-666/11, Gatto domestico, EU:T:2013:584, § 21).

The comparison should focus on the contested design as registered and must be based on the elements that are actually protected, without regard to the features excluded from the protection (judgments of 14/06/2011 T-68/10, Watches, EU:T:2011:269, § 74; 07/11/2013, T-666/11, Gatto domestico, EU:T:2013:584, § 30).

The designer's degree of freedom in developing a 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 (judgments of 09/09/2011, T-10/08 and T-11/08, Internal combustion engine, EU:T:2011:447, § 32, 47; 18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 67).

The General Court has refused to allow a general design trend to be regarded as a factor that restricts the designer's freedom, since it is precisely that freedom on the part of the designer that allows him to discover new shapes and new trends or even to

innovate in the context of an existing trend (judgment of 13/11/2012, T-83/11 and T-84/11, Radiators for heating, EU:T:2014:115, § 95).

When assessing the individual character of a design taking into account the existing design corpus, the degree of freedom of the designer in developing the design may be such as to make informed users more sensitive to differences between the designs under comparison (judgment of 13/11/2012, T-83/11 and T-84/11, Radiators for heating, EU:T:2014:115, § 81), as may the manner in which the product at issue is used, in particular the way it is usually handled (judgments of 22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 66; 07/11/2013, T-666/11, Gatto domestico, EU:T:2013:584, § 30).

The informed user is a legal fiction that must be understood, depending on each case, as an intermediate concept between the average consumer, applicable in trade mark matters, of whom no specific knowledge is required and who, in general, does not perform a direct comparison between the marks, and the man of the art, applicable in the field of patents, an expert endowed with extensive technical skills and exhibiting a very high degree of attention when directly comparing conflicting inventions (judgments of 18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 53; 25/04/2013, T-80/10, Montres, EU:T:2013:214, § 100). Therefore, a low level of knowledge and a low degree of attention, bringing the informed user closer to the average consumer and further away from the man of the art, reinforce the conclusion that designs that do not present significant differences in the features in which the designer's freedom is unrestricted produce the same overall impression on the informed user (judgment of 09/09/2011, T-11/08, Internal combustion engine, EU:T:2011:447, § 33). In such cases, the contested design must be declared invalid due to lack of individual character or, as the case may be, because the allegedly infringing design actually infringes the exclusive right of the holder. A high degree of knowledge and a high degree of attention in the informed user reinforce the opposite conclusion (judgment of 07/11/2013, T-666/11, Gatto domestico, EU:T:2013:584, § 31).

Pursuant to Article 63(1)CDR, in invalidity proceedings, the Invalidity Division is restricted to examining the facts, evidence and arguments submitted by the parties and the relief sought. The Invalidity Division therefore does not carry out its own research. This, however, does not preclude it from also taking into consideration facts that are well known, that is, that are likely to be known by anyone or can be learned from generally accessible sources.

The facts and arguments in a particular case, in principle, must have been known before the RCD/IR was filed; however, facts relating to the design corpus, the density of the market or the designer's freedom should precede the date of disclosure of the prior design.

The sector concerned and the informed user

Both the prior and the contested designs are incorporated in cases for tablets; the informed user is therefore a person who is familiar with the products to which the designs pertain. The informed user is anyone who habitually purchases such an item, puts them to their intended use and has become informed on the subject by browsing through catalogues of, or including, protective cases for tablets, visiting relevant stores or stands, downloading information from the internet, etc.

The informed user will, therefore, be aware of the tendency of all developers of tablets to make them relatively small, thin and light products that are easy to carry around,

and that, therefore, the cases that protect them must also be such. However, they must also be firm, to protect the tablet from being scratched or broken.

Users of protective covers for tablets are rather sensitive to even small differences in the appearance of these portable products, and they can differentiate among them. Cases for tablets are sold on the internet and in shops where they can be compared directly side by side.

The designer's freedom

The degree of freedom of a designer of cases for tablets is basically limited only insofar as the tablet must fit into the case and the case must protect the tablet. It must also have holes for ventilation and for the camera and microphones, as well as for connecting devices. However, as the tendency of all developers of tablet computers is to make relatively small, thin and light products that are easy to carry around, the cases that protect them must also be such.

The Invalidity Division considers that, despite these limitations, the freedom of the designer in developing cases for tablets is rather broad, in particular in relation to its decoration, surface patterns and colours.

The overall impression

The elements that the two designs have in common or that are similar in both, such as their overall structure, dimensions and general proportions, are of greater importance. In particular, these include the bulky rectangular form of the case, also featuring rounded edges, decorative moulding and the attached additional handle/stand. All the common elements in the designs that are similar are very noticeable in the overall appearance of the designs and will attract the informed user's attention. Moreover, the freedom of the designer was not severely restricted and remained broad as regards the creation of the designs.

In the absence of any specific restriction imposed on the designer, with the exception of the restrictions mentioned in the paragraphs on the designer's freedom above, the similarities lie in elements for which the designer was free to develop the contested design. The sensitivity of the informed user as regards the products at issue and the fact that they can be compared side by side should also be borne in mind.

However, the Invalidity Division notes that the noticeable differences (except the long horizontal cut-out in the earlier design) lie largely in functional elements, for example (a cut-out and a rounded button) on the left and right sides of the case of the earlier design. Therefore, these elements should not be considered decisive in assessing the overall impression that the designs create. As already concluded in this decision above, the common elements of the designs compared will attract the informed user's attention and overshadow the differences found in the overall impression between the designs.

In light of the foregoing, it is concluded that the challenged design does not produce a different overall impression from that of the prior design. It almost reproduces features of the prior design that are arbitrary and not subject to any technical necessity obliging a designer to adopt a particular shape and size. As a result, the challenged design lacks individual character in the sense of Article 6(1)(b) CDR and must be invalidated.

CONCLUSION

The facts and evidence submitted by the applicant support the grounds for invalidity under Article 25(1)(b)CDR in conjunction with Article 6CDR; therefore, the application is upheld and the RCD is declared invalid.

COSTS

According to Article 70(1)CDR, the losing party in invalidity proceedings must bear the fees and costs incurred by the other party.

Since the holder is the losing party, it must bear the invalidity fee as well as the costs incurred by the applicant in the course of these proceedings.

According to Article 70(1)CDR and Article 79(7)(f)CDIR, the costs to be paid to the applicant are the costs of representation, which are to be fixed on the basis of the maximum rate set therein, and the costs of the invalidity fee.



The Invalidation Division

Ludmila ČELIŠOVA

Gailė SAKALAITĖ

Birgit FILTENBORG

According to Article 56CDR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 57CDR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to have been filed only when the appeal fee of EUR 800 has been paid.

The amount determined in the fixing of costs may only be reviewed on request. According to Article 79(4)CDIR, such a request must be filed within one month from the date of notification of this fixing of costs and will be deemed to have been filed only when the review fee of EUR 100 has been paid (Annex to CDFR, paragraph 24).