



**DECISION**  
**of the Third Board of Appeal**  
**of 22 October 2009**

In Case R 690/2007-3

**Lindner Recyclingtech GmbH**

Villacherstr. 48  
A-9800 Spittal  
Austria

Appellant

represented by GRÜNECKER, KINKELDEY, STOCKMAIR &  
SCHWANHÄUSSER, Leopoldstr. 4, D-80802 Munich, Germany

v

**Franssons Verkstäder AB**

Timmervägen 8  
SE-857 53 Sundsvall  
Sweden

Respondent

APPEAL relating to Invalidation Proceedings No ICD 3150 (Registered Community Design No 253778-0001)

**THE THIRD BOARD OF APPEAL**

composed of Th. Margellos (Chairperson), D.T. Keeling (Rapporteur) and  
H. Salmi (Member)

Registrar: J. Pinkowski

gives the following

## Decision

### Summary of the facts and issues

- 1 The respondent is the holder of Registered Community Design No 253778-0001 ('the contested RCD'), which has a filing date of 15 November 2004. The contested RCD is registered for 'chaff cutters'. It is represented as follows:



- 2 On 17 August 2006 the appellant filed an application for a declaration of invalidity against the contested RCD, pursuant to Article 52 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs ('CDR') (OJ EC 2002 No L 3, p. 1). The appellant argued that the contested RCD must be declared invalid in accordance with Article 25(1)(b) CDR because it did not fulfil the requirements of novelty and individual character under Articles 4 to 6 CDR and because it was solely dictated by its technical function within the meaning of Article 8(1) CDR.

- 3 On 3 April 2007 an Invalidity Division of the Office issued a decision ('the contested decision') rejecting the application for a declaration of invalidity. The appellant was ordered to bear the costs.
- 4 On 7 May 2007 the appellant filed a notice of appeal against the contested decision. The appellant submitted a statement of grounds of appeal on 24 July 2007.
- 5 The respondent submitted a response on 1 October 2007.
- 6 A reply and a rejoinder were submitted by the appellant and the respondent respectively on 7 December 2007 and 18 February 2008.
- 7 The appellant relies essentially on four submissions:
  - (1) The contested RCD, being a component part of a complex product, is not visible in normal use once it has been incorporated into the complex product (Article 4(2)(a) CDR).
  - (2) All the features of the RCD's appearance are solely dictated by its technical function (Article 8(1) RCD).
  - (3) The contested RCD lacks novelty because it is identical, save in immaterial details, to a component part of the Jupiter 2200 shredder offered and sold by the appellant before the priority date of the contested RCD.
  - (4) The contested RCD lacks individual character because it makes the same overall impression on the informed user as the following products, all made available to the public before the priority date of the contested RCD:
    - (i) The Kvarn shredder made and sold by the respondent;
    - (ii) The TPA Trituratori shredder advertised by TPA Trituratori SpA in October 2003;
    - (iii) A shredder called 'The Terminator' advertised by Weima Zerkleinerungstechnik in September 1998;
    - (iv) The Vega (formerly N 1500) shredder sold by the appellant as early as 20 January 1998.

### **Reasons**

- 8 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.

*The relevant legislation*

- 9 Under Article 25(1)(b) CDR a Community design may be declared invalid if it does not fulfil the requirements of Articles 4 to 9 CDR.
- 10 Under 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.
- 11 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.’
- 12 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.’
- 13 According to Article 4(2) CDR, a design which is applied to or incorporated in a product which constitutes a component part of a complex product is to be considered to be new and to have individual character:
- ‘(a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter; and
  - (b) to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character.’
- 14 ‘Normal use’ is defined by Article 4(3) CDR as ‘use by the end user, excluding maintenance, servicing or repair work’.

15 Article 8(1) CDR provides:

‘A Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function.’

*The appellant’s first submission: the contested RCD does not satisfy the requirement of visibility in normal use under Article 4(2) and (3) CDR*

16 It is not disputed that the contested RCD concerns a component part of a complex product. Its validity therefore depends on its remaining visible during normal use of the complex product into which it is incorporated. The complex product in question is a machine for shredding used paper, cardboard, plastic, glass, and so forth, for recycling purposes. This is a large industrial machine for use by companies in the recycling business, not a small unit for domestic use by ecologically-minded individuals. The component part has been described as a chaff cutter and a step rotor. It is a metal cylinder, with knives attached, which rotates and thus cuts up the material that is fed into the shredder. A typical example of a shredder made by the respondent is shown here:



A shredder made by the appellant is shown here:



A shredder made by a third party (Weima Zerkleinerungstechnik) is shown in here:



All three shredders have a large, square collector unit, located in the upper part of the shredder. The material is fed into that collector and falls down on to the step rotor which spins round and shreds the material, which is then ejected somewhere at the side of the machine. It will be apparent that the step rotor will not be visible to the person operating such a machine if he or she is standing on the ground with feet at the same level as the base of the shredder. That is not contested by the respondent.

- 17 The respondent argues none the less that the requirement of visibility in normal use is satisfied, and must necessarily be satisfied, because the shredding process must, for technical reasons, be open for observation. The respondent describes how this is achieved in the following terms:

‘Shredders can be fed differently, some by loaders on wheels, for instance a truck, some with stationary conveyor devices and some even manually. If fed by truck it is common that the driver observes the process through a mirror. If fed by conveyor belt it is common with a camera attached to the shredder and if fed manually it is common with a ramp around the shredder.’

In response to the appellant’s argument that ocular observation can be dispensed with if an electronically directed observation system is used, the respondent states:

‘An electronically directed observation system in the elaborate way Lindner describes it, is not standard equipment and is supposedly quite expensive. Fransson’s has never delivered a shredder with such an advanced observation system that can replace ocular observation, and does not expect to in the near future, especially not when it comes to the single, relatively small kind of shredder of the type that Fransson’s manufactures. In the pamphlets edited by Lindner the existence of such a supervision system is not indicated which means at least that this supervision technique is not common. Even if it exists, it is a long way to go before it will be standard equipment.’

The respondent also supplied a video film to show how ocular observation of the shredding process is achieved.

- 18 The appellant argues that the respondent has adduced no evidence for the possibility of observing the shredding process by a camera or a mirror. The appellant also argues that the operator cannot see the step rotor during normal use because it is covered by the material to be shredded. Moreover, safety regulations prohibit direct access to rotating parts of the shredder; a cover is therefore required. Also, the step rotor is rotating, which means that it cannot in any event be seen properly.
- 19 Although the matter is not absolutely free from doubt, the evidence suggests on balance that the step rotor will, at least to a limited degree, be visible in normal use. The respondent has argued convincingly that the step rotor needs to remain visible for observation during the shredding process and has demonstrated various methods of achieving that result, e.g. by mirrors, cameras or an observation platform.
- 20 The extent to which the step rotor remains visible is limited because, as becomes clear in the video film supplied by the respondent, the step rotor is largely covered much of the time by the material that is being shredded. The fact that the rotor is spinning also limits the extent to which its various features can be perceived.
- 21 The Board concludes none the less that the requirements of Article 4(2)(a) CDR are satisfied. That provision does not require a component part to be clearly visible in its entirety at every moment of use. It is sufficient if the whole of the component can be seen some of the time in such a way that all its essential features can be apprehended.

*The appellant's second submission: all the features of the contested RCD's appearance are solely dictated by the product's technical function within the meaning of Article 8(1) CDR*

- 22 The appellant identifies five characteristic features of the contested RCD:
- The rotor is in the form of a cylinder having grooves in planes perpendicular to the rotation axis of the cylinder, the grooves having essentially the same width as the elevations between the grooves (feature A);
  - Knives are arranged along two parallel lines (feature B);
  - The two parallel lines are V-shaped (feature C);
  - The knives along one of the parallel lines are arranged within the grooves (feature D);
  - The knives along the other parallel line are arranged on the elevations (feature E);
- 23 According to the appellant, all five of the aforesaid 'characteristic features' pursue a purely technical function. The V-shaped knives (feature C) ensure that the material introduced into the shredder is guided into the middle of the rotor.

They also ensure that material is shredded successively, and not all at the same time. This means that the shredder operates more quietly and thus complies more easily with government regulations which protect workers against excessive noise. The appellant attempts to explain the technical function of features A, B, D and E by means of the following sketch showing the cutting region of two different shredders:

Fig. 1a

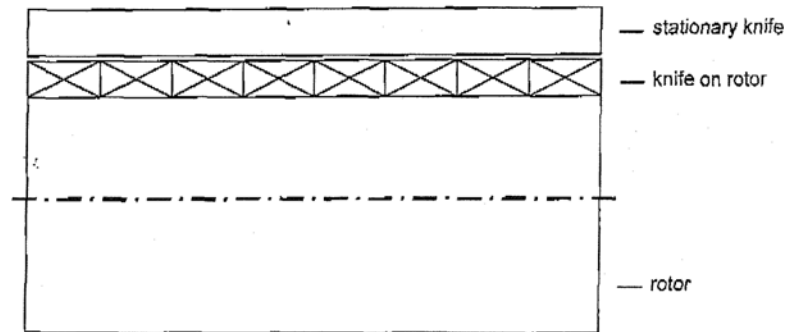


Fig. 2a

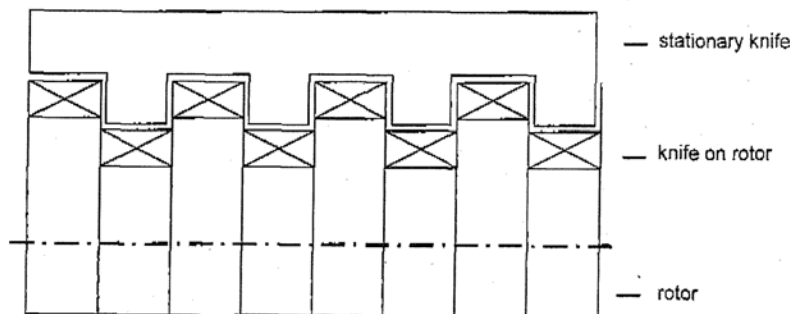


Fig. 1b

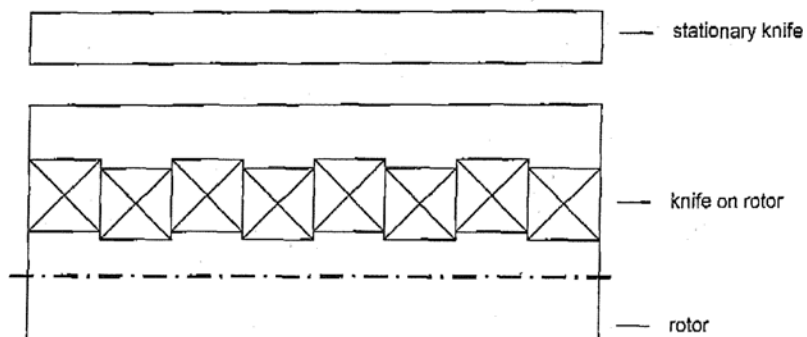
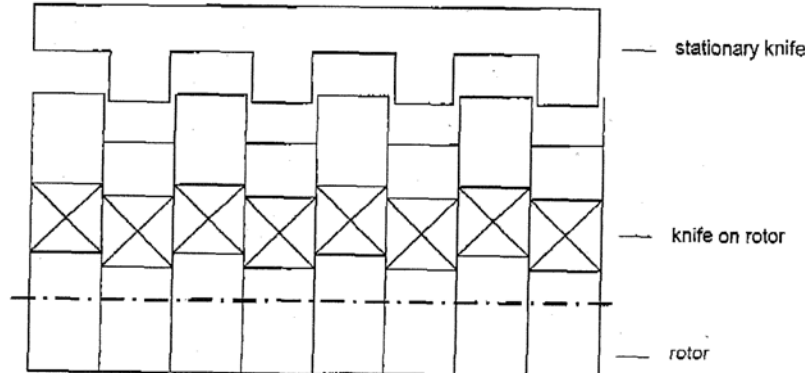




Fig. 2b



Figures 1a and 1b show the cutting region of a first shredder having a rotor in the form of a cylinder without grooves, on which the knives are arranged in two parallel lines. Figures 2a and 2b show the cutting region of a second shredder in which the rotor displays features A, B, D and E of the contested RCD. Both shredders have a stationary knife (which the respondent prefers to call an ‘anvil steel’ or *Gegenstück* in German). The shredding takes place when the knives on the rotor are facing the stationary knife. This position is shown in figures 1a and 2a. Figures 1b and 2b show the rotors in a position in which they are approximately 90° (i.e. a quarter of a revolution) before reaching the position in which the knives of the rotor face the stationary knife. In the position shown in figures 1b and 2b a gap is present between the rotor and the stationary knife. Material which is smaller than the gap can fall through it, even if it has not been shredded to the intended size. A comparison of figure 1b and 2b reveals that the gap in the first shredder is much bigger than the gap in the second shredder (i.e. the shredder which displays features A, B, D and E). Moreover, the shape of the gap in the first shredder is rectangular, whereas the gap in the second shredder has a ‘labyrinth’ shape. Owing to the smaller size of the gap in the second shredder and its labyrinth shape, only material having a size which is in the intended range can fall through the gap and larger pieces of material are shredded to the intended size. In particular, the design of the second shredder means that pieces of material that have a large extension in one direction cannot fall through the gap.

- 24 The respondent attempts to refute the appellant’s arguments about the technical function of the design by arguing as follows:

‘The RCD design has been chosen to tune with the relatively low speed rotation of the rotor; therefore the stretched out V-form has been chosen. The ‘larger’ pattern the better conception of it when [in] rotation. A zig-zag form has the same good technical function, but it is harder to identify when [in] rotation; one can also chose other angles of the V-form, for instance one that covers only 90 percent of the rotor surface. These alternatives offer a successive shredding ability and they are not significantly different as to the technical function when compared with a rotor wherein the V-shape covers 180 percent or a zig-zag shape. Lindners apparently fails to realise, that non-successive shredding can be done only when the knives are arranged in a

straight line. A 90-degree arrangement or a zig-zag shaped arrangement is not louder than the RCD V-shape arrangement.’

- 25 Both parties have submitted various items of evidence to back up their assertions. The appellant has produced an affidavit in the name of Mr Peter Schiffer, who is employed by the appellant as Head of Research and Development. Mr Schiffer confirms the appellant’s observations about the technical functions of the features referred to above as features A, B, C, D and E. The affidavit adds nothing new in comparison with the submissions formulated by the appellant’s legal representative. Its value, as corroboration of those submissions, is limited in view of the employment relationship between its author and the appellant. Of more interest perhaps is the affidavit of Mr Manfred Dossel, an engineer employed by TBM-Payr GmbH, which company was commissioned by the appellant to design a step rotor on 8 January 2003. Mr Dossel states as follows:

‘The knives were positioned on the rotor in a V-shape according to the Lindner company’s specifications. The reason for this was to centre the material in the middle and as a result to relieve the load between the rotor gasket and the housing. In addition, it was supposed to achieve an even distribution of power whilst chopping.’

This affidavit, produced by someone who is not directly employed by the appellant, confirms the strictly technical function of the V-shaped knives in a step rotor.

- 26 The appellant also produces advertising material issued by two companies that are clearly competitors of it and the respondent. One of the advertised products is the Zerma GSL. The advertisement states as follows:

‘The V-shaped arrangement of the staggered rotor blades holds pre-cut material in the centre of the cutting chamber. This prevents material sticking to the side walls and considerably reduces wear on the grinding chamber walls when processing fibre and glass reinforced plastics. The staggered rotor blades means only one blade cuts at once thus increasing the cutting torque.’

- 27 The respondent produces an affidavit by Mr Öster Gradin, an employee of Franssons Recycling AB. Mr Gradin states that the V-shaped knives on the contested RCD were chosen mainly for aesthetical reasons.

- 28 The interpretation of Article 8(1) CDR (and of the corresponding provision in Article 7(1) of Council Directive 98/71/EC on the legal protection of designs) is highly controversial. Similar provisions existed in the designs legislation of several Member States prior to harmonization of the law by Directive 98/71. The assumption has generally been made that the purpose of such provisions is to prevent design rights from being used to obtain monopolies over technical solutions without meeting the relatively stringent conditions laid down in patent law. Two contrasting views have been canvassed in the legal literature. One view holds that a technical necessity exception, such as that contained in Article 8(1) CDR applies only if the technical function cannot be achieved by any other configuration; if the designer has a choice between two or more configurations, the appearance of the product is not solely dictated by its technical function. That

theory – known as the multiplicity-of-forms theory – is defended by some German authors (see, for example, P. Schramm, *Der europaweite Schutz des Produktdesigns*, Nomos Verlagsgesellschaft, Baden-Baden 2005, at p. 242 et seq., and U. Ruhl, *Gemeinschaftsgeschmacksmuster: Kommentar*, Carl Heymanns Verlag, Köln-Berlin-München 2007, at p. 169 et seq.) and was formerly followed by the French courts (see D. Cohen, *Le droit des dessins et modèles*, 2<sup>nd</sup> edition, Economica, Paris 2004, at p. 22). Advocate General Ruiz-Jarabo suggested in *Philips v Remington* (Case C-299/99, [2002] ECR I-5475, at paragraph 34 of the Opinion) that Article 7(1) of the Designs Directive (and therefore obviously Article 8(1) CDR) should be interpreted in that manner. He stated:

‘... a functional design may, none the less, be eligible for protection if it can be shown that the same technical function could be achieved by another different form.’

The Advocate General’s comment is clearly an *obiter dictum* since *Philips v Remington* was a case on the interpretation of Article 3(1)(e) of Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (‘TMD’). Article 3(1)(e) TMD excludes from trade mark protection ‘signs which consist exclusively of the shape of goods which is necessary to obtain a technical result’.

- 29 The multiplicity-of-forms theory has been adopted by courts in the United Kingdom (see the judgment of 28 July 2006 of the Court of Appeal in *Landor & Hawa International Ltd v Azure Designs Ltd* [2006] EWCA Civ 1285) and Spain (Juzgado de lo Mercantil PTO Número Uno de Alicante, Auto No 267/07, 20 November 2007, in *Silverlit Toys Manufactory Ltd v Ditro Ocio 2000 SL and others*).
- 30 There is none the less a major flaw in the multiplicity-of-forms theory. If it is accepted that a feature of a product’s appearance is not ‘solely dictated by its function’ simply because an alternative product configuration could achieve the same function, Article 8(1) CDR will apply only in highly exceptional circumstances and its very purpose will be in danger of being frustrated. That purpose, as was noted above, is to prevent design law from being used to achieve monopolies over technical solutions, the assumption being that such monopolies are only justified if the more restrictive conditions imposed by patent law (and in some countries by the law of utility models) are complied with. If a technical solution can be achieved by two alternative methods, neither solution is, according to the multiplicity-of-forms theory, solely dictated by the function of the product in question. This would mean that both solutions could be the subject of a design registration, possibly held by the same person, which would have the consequence that no one else would be able to manufacture a competing product capable of performing the same technical function (see W. Cornish and D. Llewelyn, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights*, 5<sup>th</sup> edition, London, Sweet & Maxwell 2003, at p. 549). This leads to the conclusion that the multiplicity-of-forms theory cannot be correct.
- 31 The principal alternative, discussed by academic authors, to the multiplicity-of-forms theory has its origin in English case law. The case of *Amp v Utilux* [1971]

FR 572 concerned the interpretation of a provision of the Registered Designs Act 1949 which denied protection to the features of a design that were solely dictated by a product's technical function. The House of Lords held that a product's configuration was solely dictated by its technical function if every feature of the design was determined by technical considerations. The striking similarity between section 1(3) of the 1949 Act and Article 8(1) CDR does not of course mean that the approach of the House of Lords in *Amp v Utilux* must necessarily be adopted in relation to the Community provision. Indeed, as was noted above in paragraph 29, the multiplicity-of-forms theory has now been adopted by the English Court of Appeal in *Landor & Hawa International v Azure Designs*. Thus the Court of Appeal must have thought that the approach taken in *Amp v Utilux* was no longer valid, following harmonization, in spite of the similar wording of the Community provisions and the 1949 Act. The approach taken in *Amp v Utilux* would, however, have the advantage of allowing the purpose of Article 8(1) CDR to be achieved. No one would be able to shut out competitors by registering as Community designs the handful of possible configurations that would allow the technical function to be realised. This may explain why the French courts, which formerly espoused the multiplicity-of-forms theory, began to abandon that theory at the beginning of the 21<sup>st</sup> century in favour of an interpretation which closely resembles the *Amp v Utilux* approach (see the judgments cited by Cohen, *op. cit.*, at pp. 23-24).

- 32 In addition to being supported by a teleological interpretation, the approach discussed in the previous paragraph is also supported by the wording of Article 8(1) CDR. That provision denies protection to features of a product's appearance that are 'solely dictated by its technical function'. Those words do not, on their natural meaning, imply that the feature in question must be the only means by which the product's technical function can be achieved. On the contrary, they imply that the need to achieve the product's technical function was the only relevant factor when the feature in question was selected.
- 33 Good design involves two fundamental elements: the product must perform its function and it should be pleasant to look at. In the case of some products, such as pictures and ornaments, their very function is to please the eye. In the case of other products, such as the internal working parts of a machine, the visual appearance is irrelevant. That is why the Community design legislation denies protection to component parts that are not visible in normal use. In the case of most products the designer will be concerned with both the functional and the aesthetic elements. That applies also to large items of industrial equipment, such as shredders for use in recycling plants. The shredder must, in the first place, perform its function effectively and safely and without creating excessive noise, but it is also desirable that the shredder should be pleasing to the eye and thus enhance the working environment of the people who operate it and see it in use. For that reason there is no objection in principle to granting design protection to industrial products whose overall appearance is determined largely, but not exclusively, by functional considerations.
- 34 It is often pointed out that the Community design legislation, unlike the old laws of some Member States, does not lay down any requirement of aesthetic merit, artistic creativity or eye appeal. The absence of such a requirement is expressly mentioned in the 10<sup>th</sup> recital in the preamble of Regulation No 6/2002 and in

the 14<sup>th</sup> recital in the preamble to Directive No 98/71. Some authors infer from this that purely functional designs are protectable. That is a false analysis. Community design law is concerned with the visual appearance of products. That is clear from the definition of ‘design’ in Article 3(a) CDR and from the requirement of visibility in normal use for component parts in Article 4(2)(b) CDR. Those parts of a product that cannot be seen are of no concern to the Community law of design because no one cares what they look like. All that matters is that such parts perform their function. If the law were intended to protect purely functional designs it would not be logical to exclude the non-visible aspects of design from protection.

- 35 The significance of limiting protection to the visual appearance of products is that aesthetic considerations are in principle capable of being relevant only when the designer is developing a product’s visual appearance. Most of the time the designer will be concerned with both elements of good design: functionality and eye appeal. In some cases functionality will be the dominant preoccupation of the designer. The need to make a product that works will be uppermost in the designer’s mind and will largely determine the appearance of the product. As long as functionality is not the only relevant factor, the design is in principle eligible for protection. It is only when aesthetic considerations are completely irrelevant that the features of the design are solely dictated by the need to achieve a technical solution. This is not, it must be stressed, tantamount to introducing a requirement of aesthetic merit into the legislation. It is simply recognition of the obvious fact that when aesthetics are totally irrelevant, in the sense that no one cares whether the product looks good, bad, ugly or pretty, and all that matters is that the product functions well, there is nothing to protect under the law of designs.
- 36 It follows from the above that Article 8(1) CDR denies protection to those features of a product’s appearance that were chosen exclusively for the purpose of designing a product that performs its function, as opposed to features that were chosen, at least to some degree, for the purpose of enhancing the product’s visual appearance. It goes without saying that these matters must be assessed objectively: it is not necessary to determine what actually went on in the designer’s mind when the design was being developed. The matter must be assessed from the standpoint of a reasonable observer who looks at the design and asks himself whether anything other than purely functional considerations could have been relevant when a specific feature was chosen.
- 37 The fact that a particular feature of a product’s appearance is denied protection by Article 8(1) CDR does not mean that the whole design must be declared invalid, pursuant to Article 25(1)(b) CDR, on the ground that it does not ‘fulfil [one of] the requirements of Articles 4 to 9’. The last sentence of the 10<sup>th</sup> recital in the preamble to the Regulation makes it clear that the design as a whole may be valid even though certain features of the design are denied protection. The design as a whole will be invalid only if all the essential features of the appearance of the product in question were solely dictated by its technical function.
- 38 The appellant identified five characteristic features of the design (see paragraph 22 above). The respondent has not disputed that these are the most important features of the design. They could fairly be described as the essential features of

the design. If all five of those features were solely dictated by the technical function of the step rotor, the design must be declared invalid, under Article 25(1)(b) in conjunction with Article 8(1) CDR.

- 39 The appellant gave a detailed, coherent and convincing explanation of the technical function of each of the five features (see paragraph 23 above) and showed how each feature had been selected in such a way as to improve the shredding process. The respondent's attempts to rebut those arguments can only be described as inadequate. In the passage quoted above (see paragraph 24) the respondent recognizes that the design was chosen 'to tune with the relatively low speed rotation of the rotor'. He goes on to state that a 'zig-zag form has the same good technical function, but it is harder to identify when [in] rotation'. He then points out that certain alternative configurations could achieve the same technical result. The respondent's own statements show that the design was chosen purely for technical reasons.
- 40 The affidavit by Mr Gradin (see paragraph 27) does little to refute the view that the contested RCD was designed solely with a view to enhancing the technical performance of the shredder. The bold statement that the V-shape was chosen for mainly aesthetical reasons is scarcely credible. The statement that a zig-zag configuration would be more effective from a technical point of view is surprising: it is hard to believe that a technical advantage would be surrendered in favour of aesthetical considerations in the case of a piece of industrial equipment that might only be visible through a mirror or with the aid of a camera. In fact Mr Gradin concedes that the V-shape might have the advantage of centering the shredding process but claims that the downside of this is that more strain is put on the centrally placed teeth. What he appears to be saying is that the design represents an engineering compromise, which may well be true of most industrial designs. Something is gained, something is lost. The designer takes into account conflicting technical considerations and strives to come up with a product that has the best overall technical performance. The fact that the designer accepts a technical drawback (X) for the sake of a technical advantage (Y), knowing that he cannot have both X and Y, does not mean that the design has not been solely dictated by the technical function of the product. On the contrary, it strongly implies that nothing but the technical function of the product was relevant to the development of the design.
- 41 The respondent produces a declaration signed by Mr Jan Olsson of Bjerkens Patent Bureau KB. Mr Olsson refers to a commentary on the provision of Swedish law that implements Article 7(1) of Directive 98/71. He states that, according to this commentary, the law does not exclude 'protection of a product that lacks any aesthetical quality'. Thus, argues Mr Olsson, it is possible to protect solely functional designs. He goes on to state that it is possible 'that such details of the appearance of a product that are dictated solely by its technical function, together compose a design that [it] is possible to protect, although the particular details in themselves cannot be protected'.
- 42 The views expressed in Mr Olsson's declaration are problematical. They could, if accepted, deprive Article 7(1) of the Directive and Article 8(1) CDR of any purpose and content. Those provisions might just as well be deleted from the legislation. It is true that there is no ban on the protection of designs that lack any

aesthetic quality. Such a requirement is not imposed because it is notoriously difficult to make an objective evaluation of aesthetic merit. Article 7(1) of the Directive and Article 8(1) CDR deny protection to certain designs, not because they lack aesthetic merit but because aesthetic considerations play no part in the development of the designs, the sole imperative being the need to design a product that performs its function in the best possible manner. That may fairly be said of the contested RCD. No one cares whether such a product looks good, bad or indifferent because no one spends much time looking at it. All that matters is that the product performs its function properly. Every essential feature of the design has been chosen with a view to achieving the best possible technical performance. Those features were therefore solely dictated by the product's technical function. It follows that the contested RCD must be declared invalid under Article 25(1)(b) in conjunction with Article 8(1) CDR.

*The appellant's third and fourth submissions: the contested RCD lacks novelty and individual character*

43 In view of the finding reached above, it is not strictly necessary to examine the appellant's remaining submissions. For the sake of completeness, however, the Board will briefly deal with them.

44 In the proceedings before the Invalidity Division the appellant referred only to two items of prior art, namely its own Jupiter 2200 shredder and the respondent's Kvarn shredder. The other three examples of prior art referred in the appellant's grounds of appeal (see paragraph 7(4) above) were not cited in the proceedings before the Invalidity Division. The Board will not therefore take them into account, since to do so would contravene the clear terms of Article 28(1)(v) CDIR, which provides that:

‘An application to the Office for a declaration of invalidity pursuant to Article 52 of Regulation (EC) No 6/2002 shall contain:

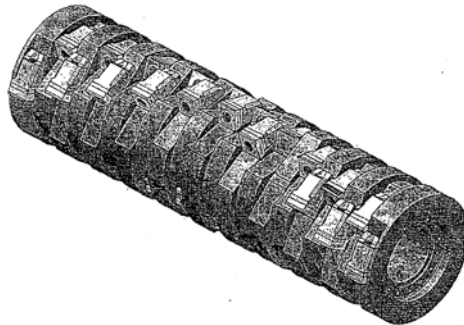
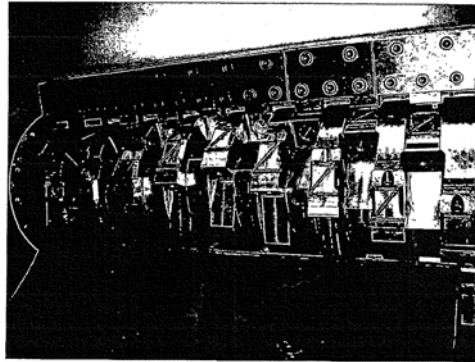
...

(v) where the ground for invalidity is that the registered Community design does not fulfil the requirements set out in Article 5 or 6 of Regulation (EC) No 6/2002, the indication and the reproduction of the prior designs that could form an obstacle to the novelty or individual character of the registered Community design, as well as documents proving the existence of those earlier designs’.

45 Under Article 30(1) CDIR, compliance with the terms of Article 28(1) CDIR is a condition for the admissibility of the application for a declaration of invalidity. It is in any case important, on grounds of fairness and procedural economy, that all the relevant prior art should be identified at an early stage in invalidity proceedings. Invalidity applicants should not in principle be allowed to cite, at the appeal stage, additional examples of prior art that could have been cited in the proceedings before the Invalidity Division.

46 The appellant argues that the contested RCD lacks novelty within the meaning of Article 5 CDR because the rotor of its own Jupiter 2200 shredder has characteristic features which are identical to those of the contested RCD. Further, the appellant argues that the step rotor of the Jupiter 2200 and the step rotor of the contested RCD make the same overall impression on the informed user and thus

deprive the contested RCD of individual character within the meaning of Article 6 CDR. As evidence that the Jupiter 2200 was made available to the public before the filing date of the contested RCD (15 November 2004), the appellant refers to the affidavit by Mr Peter Schiffer (mentioned above in paragraph 25), according to which that shredder was offered to an Italian customer on 20 January 2004 and actually delivered to the same customer on 15 March 2004. The appellant has supplied the following representations of the step rotor used in the shredder delivered to the Italian customer in March 2004:

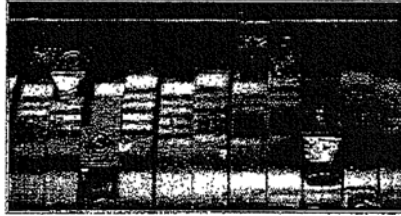


- 47 The step rotor shown in the above pictures is clearly not identical to the contested RCD. The differences are obvious and amount to more than ‘immaterial details’. In the first place the central rod is absent from the above pictures. It is of course possible that when the step rotor is in use such a rod will be present. Whether it will be identical to the rod in the contested RCD is another matter. In any event, the Board can only compare the images that are placed before it. The Board cannot be asked to imagine what the design invoked as prior art might look like. A second obvious difference is that the contested RCD has 21 grooves and 22 raised rings, while the step rotor of the Jupiter 2200 has 10 grooves and 11 raised rings. Thirdly, the circular end of the contested RCD is flat and uniform (except for a number of small depressions (which may represent screw heads)); the circular end of the other step rotor is divided into two levels.
- 48 The differences described in the previous paragraph are also sufficient to mean that the two designs make a different overall impression on the informed user, especially bearing in mind the limited freedom of the designer in developing the design in view of the undeniable technical constraints. The informed user, in this context, is someone who is familiar with large shredding machines of a type used in recycling plants. Such a user, who might for example be an operator of



shredding machines, would notice the obvious differences between the two designs and be left with a different overall impression.

- 49 Finally, the appellant argues that the contested RCD lacks novelty and individual character because the shredder in which the contested RCD is incorporated was made available to the public by the respondent as early as 2000. The appellant purports to prove this by submitting advertising brochures issued by the respondent in 2000 and 2001. The only image in those brochures that remotely resembles the contested RCD is the following one:



- 50 There is no proof that the advertising brochures in question were published in 2000, 2001 or at any other time before 15 November 2003 (which would be the relevant date in view of the 12-month grace period provided for in Article 7(2) CDR). Moreover, none of the images contained in those brochures, including the one shown in the previous paragraph, is sufficiently similar to justify the conclusion that the shredder being advertised in the brochures was identical to the contested RCD or sufficiently similar to produce the same overall impression on the informed user.
- 51 It follows from the above that the appellant's third and fourth submissions must be rejected.

### **Costs**

- 52 Since each party has succeeded on some heads and failed on others, it is appropriate to order the parties to bear their own costs, in accordance with Article 70(2) CDR.

**Order**

On those grounds,

THE BOARD

hereby:

- 1 Annuls the contested decision;**
- 2 Declares the contested RCD invalid;**
- 3 Orders the parties to bear their own costs.**

Th. Margellos

D.T. Keeling

H. Salmi

Registrar:

J. Pinkowski