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

DESIGNS DEPARTMENT- INVALIDITY DIVISION

DECISION OF THE INVALIDITY DIVISION OF 12/12/07

IN THE PROCEEDINGS FOR A DECLARATION OF INVALIDITY OF A REGISTERED COMMUNITY DESIGN

FILE NUMBER	ICD 0000003010
COMMUNITY DESIGN	000257001-0001
LANGUAGE OF PROCEEDINGS	English
APPLICANT	Holey Soles Holdings Ltd. 1628 West 75th Avenue Vancouver, British Columbia V6P 6G2 Canada
REPRESENTATIVE OF THE APPLICANT	Eisenführ, Speiser & Partner Martinistraβe 24 28195 Bremen Germany
HOLDER	Crocs, Inc. 6273 Monarch Park Place Niwot, Colorado 80503 United States of America
REPRESENTATIVE OF THE HOLDER	Field Fisher Waterhouse LLP 35 Vine Street London EC3N 2AA United Kingdom

The Invalidity Division,

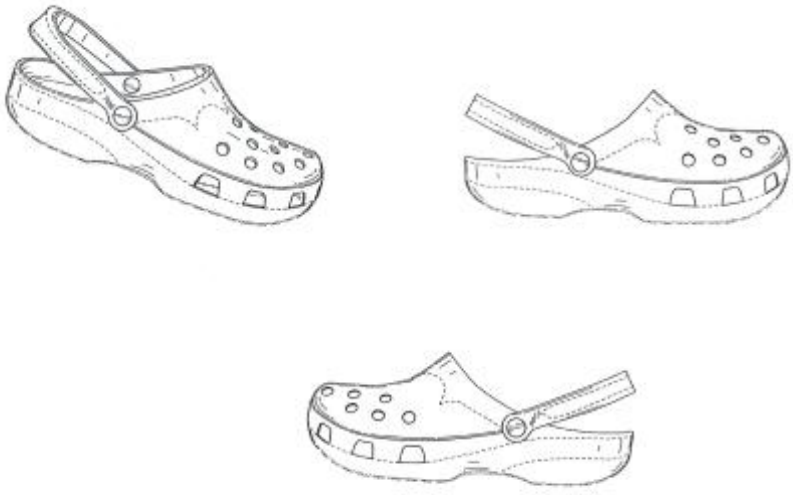
composed of Eva Udovc (rapporteur), Peter Rodinger (member) and Martin Schlötelburg (member) took the following decision on 12/12/07:

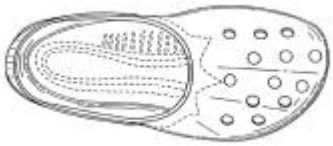
1. The registered Community design No. 000257001-0001 is declared invalid.

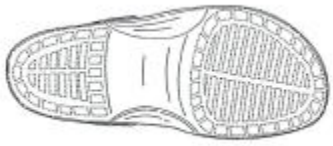
2. The Holder shall bear the costs of the Applicant.

I. FACTS, EVIDENCE AND ARGUMENTS

(1) The Community design No. 000257001-0001 (in the following: "the RCD") has been registered in the name of the Holder with the date of filing and the date of registration of 22/11/04 and with the priority date of 28/05/04 based on a prior US design patent application No. 29/206,427. In the RCD, the indication of products reads "Footwear" and the design is represented in the following seven views (published at http://oami.europa.eu/bulletin/rcd/2005/2005_009/000257001_0001.htm):







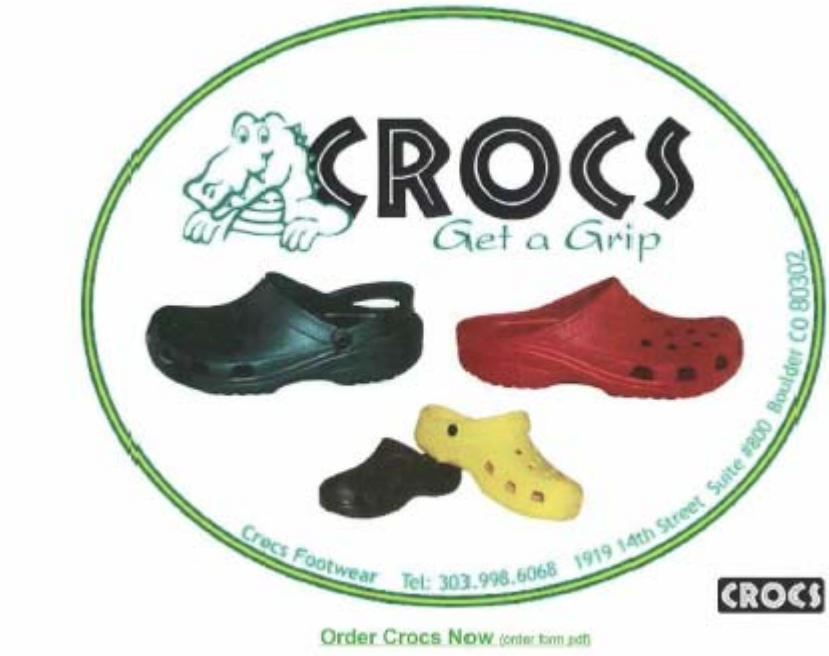
(2) On 31/07/06 the Applicant filed an application for a declaration of invalidity (in the following: "the Application") contesting the validity of the RCD. The fee for the Application was paid by current account with effect of 31/07/06.

(3) The Applicant requests invalidation of the RCD based on Article 25(1)(b) CDR[1], because it does not fulfill the requirements for protection of Articles 4 to 7 of CDR, since it lacks novelty and individual character. He therefore requests the RCD to be declared invalid and his costs to be born by the Holder.

(4) The Applicant submitted, among others, the following facts and evidence in support of his arguments in the Application:

[1] Council Regulation (EC) No 6/2002 on Community designs

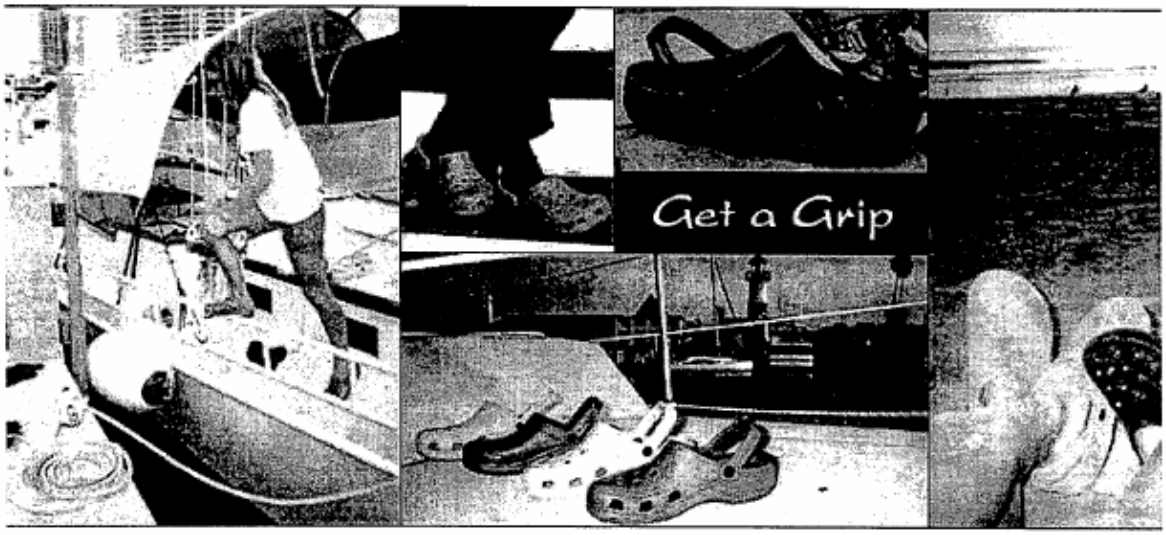
- printouts of the website http://web.archive.org/web/20021125175431/http://www.crocs.com/, dated 15/07/2006 and marked by the Applicant as "D1" (in the following: "D1"). The Applicant states that D1 are "copies of the Holder's website of November 25, 2002. The printout shows the following clog footwear:



- printouts of the websites http://web.archive.org/web/20021213143656/www.crocs.com/ and http://web.archive.org/web/20021213112059/www.crocs.com/, both dated 15/07/2006 and bearing a copyright statement "© 2003 Crocs Footwear". They are all marked by the Applicant as "D2" (in the following: "D2"). The former printouts show footwear parts (i.e. the upper, the insole and sole) and the later show two clogs. The Applicant states that D2 are "copies of the Holder's website of December 13, 2002";

- printout of the Holder's website http://www.crocs.com/company/history.jsp, dated 12/05/2006 and bearing a copyright statement "© 2005 crocs", marked by the Applicant as "D3" (in the following: "D3"). The printout shows an image of clogs and text stating that "Crocs introduced it's first model, "the Beach™", in November 2002 at the Ft. Lauderdale Boat Show.";

- a copy of the Holder's US trademark application for a word mark "CROCS", filed with the USPTO on 27/05/2003 and marked by the Applicant as "D4" (in the following: "D4"). The application contains also a copy of the catalogue front page, titled "Crocs, Get a Grip, Functional Slip Resistant Footwear with a casual Feel". The catalogue bears a date of 5/22/2003, a copyright statement "© 2003" and a website address http://www.crocs.com/index.asp. It contains the following images:



- printouts of the "Holey Sole" clogs, marked by the Applicant as "D5" (in the following: "D5"). These printouts do not contain any indication of the date of disclosure. They consist of two views as follows:

- a sample of the “Holey Soles” clog, marked by the Applicant as “D6” (in the following: “D6”). For this clog the Applicant states that it was “offered since September 2003”;

- printouts of the website http://web.archive.org/web/20021210013932/holeysoles.com/home.html, dated 20.07.2006 and marked by the Applicant as “D7” (in the following: “D7”). The Applicant states that this website is “of December 10, 2002”. It contains the following views of the clogs:

- copies of three invoices, issued by Finproject N.A. inc., Quebec, Canada, and addressed to Holey Soles, Vancouver, Canada. The invoices were issued on 25/09/02 (invoice No 00009508), 31/10/02 (invoice No 00009783) and on 29/11/02 (invoice No 00009981). The products described as Aqua Clogs are listed on these invoices. They are marked by the Applicant as “D8” (in the following: “D8”). The Applicant states, that he is “supplying” them “as evidence, that the clogs in D5 and D6 have been sold since September 2002”.

(5) The Applicant states that clogs identical to the RCD were “offered and sold by the Holder more than 12 months before the priority date”. The

Applicant asserts that “he provided D1 and D2 as evidence that the prior design has been disclosed to the public by the Holder in November and December 2002, i.e. before the priority date of the contested CD”, as “the design of the CD was made available to all third parties on a world-wide basis by 2002, considering that the Internet web page was stored in the Internet archive on November 25, 2002 and on December 13, 2002”. He requests the Office to determine “the period of time within which the Applicant must make known to the Office the names and addresses of the witnesses and experts to be heard according to Article 43(1) CDIR”, should the Holder contest the fact about the internet disclosure on the respective dates. Regarding D3 he states that he provided it “as evidence that the prior design was disclosed to the public by the manufacturer of the Holder (“Finproject”) in February 2003, i.e. more than 12 months before the priority date of the contested CD”. He contends that the RCD “lacks novelty with respect to the prior designs (D1 to D3)”, because “it can be noted that both clogs at first sight appear to be identical”. Regarding D5 and D6 the Applicant asserts, that “the clogs of D5 and D6 are identical to the Holder’s shoe except for the strap and both the Applicant and the Holder were purchasing them from the aforementioned Canadian manufacturer Finproject”, wherein “the Holder’s shoes as well as those of the Applicant initially came from the same molds”.

(6) On 11/08/06 the Holder was notified of the Application and invited to submit his observations within a time period set (13/10/06) and upon his request granted an extension until 13/12/06.

(7) In his reply and extension request of 13/11/07 the Holder contests the Applicant’s arguments and evidence. For D2 he observes that they “have checked the “web.archive.org” website and have been unable to find the web pages that have been exhibited by the Applicant at Enclosure D2” and that “the only web archive exhibited for December 2002 is dated 1 December 2002”, wherein “on the second page of Enclosure D2 there is a notation from the website indicating that the copyright in the screen display is owned by “Crocs Footwear” and claims a copyright date of 2003”. He observes that for D2 “it is claimed that the screenshots of the website were of 13 December 2002, which date is not found in the web archive website”, wherein “it would appear from the papers that it was 15 July 2006”. The Holder contests D5, because “there is no indication at all in Enclosure D5 or in any of the Application as to the date or origin of the photographs in Enclosure D5” and states that ”the position of the photographs at Enclosure D5 need to be clarified” for the Holder “to know specifically whether or not it is alleged that Holey Soles with a strap were sold since September 2002, and if not at that date, then when were they sold”.

(8) In his further observations, received on 08/12/06, the Holder states that “the CD fulfils completely the requirements of novelty and individual character as required by Articles 5 and 6 CDR” and requests “the Application to be dismissed and that the Applicant bear the costs of the

Application". He states that "the Applicant has failed in the Application to give correct interpretation of the terms of Article 7 of the CDR, in particular in failing to take account of the fact that any act of making the design available to the public outside the periods detailed in Article 7(2) are subject to an exception where the design was put into the public domain in circumstances where it could not reasonably have become known in the normal course of business to individuals in the circles specialist in the sector concerned, operating in the Community". He points out, that "it is the Holder's position that any disclosures that were made of the CD prior to the 28 May 2003 are ones which fall within the exception detailed in Article 7(1) insofar as they would not reasonably have become known in the normal course of business to individuals in the circle specialist in the sector concerned, operating within the Community". For D1 and D2 he states that "the Applicant shows what it claims to be screen shots showing a website with CROCS displayed as at 25 November 2002 and 13 December 2002" and that they "are drawn from the web archive website known as www.web.archive.org", wherein "it is noted that those who arrange the archive website do not claim that the date shown on the screen shots are necessarily accurate". Therefore, he argues that "the Applicant has not provided sufficient evidence to substantiate the dates shown on the screen shots at D1 and D2". He asserts that "prior to 28 May 2003 the Holder had not engaged in preparing a sophisticated website which would have given the maximum opportunity, for a person specialist in the sector, while operating in the course of business, to find the website", wherein "the fact that the Applicant has now displayed what it claims were web pages that were available in 2002 does not mean that these web pages would have been found by individuals working in the appropriate sector, during normal course of business". He adds that "the website that was produced by CROCS was for information and for assisting customers who may have learnt about the shoes from people who had already bought them" and that "the site was not set up as an e-Commerce site to primarily sell goods through the internet". Regarding D5 he observes, that "the shoes relied upon in Exhibit D5 are the Holey Soley shoes without the strap", wherein "the strap is an integral part of the CD and therefore reference to the shoe without the strap is of no relevance to the Application". He adds that "the design without the strap does not make up the CD and therefore all references to "Waldies" are irrelevant to the Application". He concludes that "the CD does not conflict with any prior design, and does produce on the informed user a different overall impression than existing designs", because "the strap that makes up part of the CD adds an ornamental design aspect to the CD" and "in addition to its functionality, the strap is there as a design feature". He also draws "the Office's attention to the commercial success of this shoe" as "an indication of the fact that the CD has an individual character".

(9) In support of his observations the Holder submitted two witness statements, namely a witness statement of Mr. Lyndon Hanson, identified as the Co-Founder of Crocs, Inc, and a witness statement of

Mr. Dick Wijsman, identified as the Managing Director of Crocs Europe B.V.

(10) In his witness statement Mr. Hanson states that (in the following: “E1”):

> - “in the late 1990s and early 200s a small injection moulding and manufacturing company in Quebec, Canada, Finproject NA, moulded a clog-type shoe from the soft material” and that ”these shoes were sold as “Aqua Clogs” and that “they did not have the strap at the back of the shoe”;
>
> -“Scott Seamans, a co-founder of Crocs, took a pair of Finproject Aqua Clogs and added a strap at the back of them which gave them the appearance of the present day Crocs”;
>
> - “the first time” he “saw shoes like these was in or around May or June 2002” and that “in the latter part of the summer 2002” they “set about setting up systems to deal with the new business”;
>
> - they “decided to put out shoes into the Fort Lauderdale Boat Show”, “a boat show held in Fort Lauderdale, Florida, from October 31st through November 3rd in 2002” and that “this was the first time that the Crocs, that is to say the clog with the strap, were actually put on public display”, wherein they “did sell shoes at the show, but to locals and boating enthusiasts who were attending the show”;
>
> - they “also purchased the URL “Crocs.com” from a New York company” and that he believes “that the website was eventually up and running by January 2003”;
>
> - “on 22 May 2003, Crocs applied to register the United States trade mark “Crocs”;
>
> - he believes “that any distribution that took place prior to the 28 May 2003 would either have been direct to individuals, or through small dealer locally in Florida or Colorado” or “some to people who had attended boat shows and the like”, wherein “the Fort Lauderdale Boat Show was not something where any shoe manufacturer would be likely to have gone or been to try and find out what was going on in the market”.

(11) In his witness statement of Mr. Wijsman states that (in the following: “E2”):

> – he is “the Managing Director of Crocs Europe B.V., a wholly owned subsidiary of Crocs, Inc. which was set up in 2005 in order to oversee the distribution of Crocs Clogs within the European Union” and has “held this position since March 2005”;

- he has “been informed that Crocs clogs were exhibited at a boat show in Fort Lauderdale in the United States of America prior to the period of 12 months before the priority date of Crocs’ Community Registered Design”, wherein “a boat show is not the type of event that a person like” himself, “or any of the circles which are specialised in the footwear sector to which” he refers “would attend for any business purpose related to the footwear sector”;

-“any new footwear which happened to be on show at a boat show, and in this instance the Fort Lauderdale boat show, could” in his opinion “therefore not reasonably have become known in the normal course of business to individuals in circles specialised in the footwear industry within the European Union”;

- “a photograph of the Crocs clog may have appeared on a newly set-up website for Crocs when it was still a new start-up business prior to the period of 12 months before the priority date of Crocs Community Registered Design” and that in his experience “the Internet is rarely used as a resource in the development of new shoe products”;

- “even in the unlikely circumstances that a person working in the circles specialised in the footwear sector conducted an Internet search engine search for “shoe” or “clog”, “a search on Google on 6 December 2006 identifies 67,500,000 returns for “shoe” and 6,660,000 returns for “clog” and even today the crocs website does not appear on the first page of these searches” and that “the chances of stumbling across the new start-up Crocs website at the relevant time”, “would have been extremely remote”;

- “any photographs which happen to appear on a new website for an unknown new start-up business somewhere in the world, and in this instance the early Crocs website set up in the United States of America, could” in his opinion “therefore not reasonably have become known in the normal course of business to individuals in circles specialised in the footwear industry within the European Union”.

(12) On 16/01/07 the Applicant was invited to submit his observations to the Holder’s observations within a time period set (16/03/07) and upon his request granted an extension until 16/05/07.

(13) Regarding the Holder’s observations the Applicant in his observations of 16/05/07 states that “the Holder admits that a design which is identical to the CDR has been made available to the public before 28 May 2003 by the Holder himself and also by the FinProject” and that “the Holder’s assumption is wrong that the identical design could not

reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community". He maintains his assertions that:

- "the Holder's website as depicted in D1 and D2 was on the internet at the end of 2002/beginning of 2003 (before May 2003)";

- "the Holey Soles clogs (without strap) as depicted in D5 were sold in Canada and the US since at least July 2002";

- "the Holey Soles website, which is dated December 10, 2002 (D7) was on the internet from at least December 2002";

- "the original of the "Holey Soles" clogs (D6) is offered since September 2002"; and

- that "the identical design (minus the strap" was presented to the public in Europe by L'Artigiana Stampi".

He asserts that he "additionally contacted the HDS – Hauptverband der Deutschen Schuhindustrie e.V. Waldstr. 44, 63065 Offenbach (www.hds-schuh.de), which is the Union of the German shoe manufacturers, and they confirmed that their aforementioned members offer and sell their shoes worldwide" and that "they confirmed that marketing people, product managers, designers and distributors, in particular Adidas, Lloyd, Puma, ROMIKA, SIOUX, Finn Comfort attend international trade shows, in particular in Europe and in the US, such a mentioned on their website (D13)."

He points out that "the design of the Holder's Beach Model comprises the crown design at the bootleg, the circles design at the upside of the clog and the semi-circles design on the side" and that this model "which was made available to the public before 28 May 2003", is identical to the CD". He concludes that "the CD lacks novelty, and therefore the question whether or not the strap has an individual character has not to be answered". Additionally, he observes, that "the overall impression that the clog with strap produces on the informed user, does not differ from the overall impression produced on such a user by such a clog without strap which has been made available to the public" and that "the strap only subsists in features which are solely dictated by its technical functions, since it prevents the clog from getting lost".

(14) In support of his observations the Applicant submitted additional evidence, among others, the following:

- an affidavit by of Rick Walter, marked by the Applicant as "D10" (in the following: "D10"). In this affidavit Mr. Walter asserts that:

- he has been “working with Holey Soles since May of 2004 as the Vice President of Operations and formerly as the President”;

- “Mr. Ettore Battiston is the sole author and designer of the strapless portion of the clog known as the CROCS BEACH MODEL shoe” and that “Crocs then added a strap and Crocs called it the “Beach Model” in 2002”;

- “the Beach Model created by Mr. Ettore Battiston was presented to the public in Europe”;

- “Finproject NA was offering the clog depicted in Annex B (without strap) named Aqua Clogs to Crocs and also to Holey Soles and other wholesalers and retailers in Canada and the US”;

- “the Crocs website as depicted in D1 was on the Internet at the end of 2002/beginning of 2003 (before May 2003)”;

- “the clogs (without strap) as depicted in D5 were sold in North America since at least July 2002 as per the email of Mr. Reddyhoff (Annex C)” and “the invoices of D8 are related to such clogs”;

- “the Holey Soles website, which is date December 10, 2002 and is enclosed as D7 to the writ of 28 July 2006, is correct, the website was on the Internet from at least December 2002”;

- “as regards the circles specialised in the shoe sector operating within the Community” “such European circles specialised in the shoe sector are attending trade shows in Europe, US and Canada, further they are checking shoe stores at home and abroad” and “also they are checking the websites of their competitors”;

- an affidavit of Mr. Ettore Battiston, marked by the Applicant as “D10A” (in the following: “D10A”). In this affidavit Mr. Battiston asserts that:

- he is ”the sole author and designer of strapless portions of the shoe known as the CROCS BEACH MODEL shoe (hereinafter referred to as the BEACH MODEL design)” and that he created it “in 2000 in the course of” his “employment with L’Artigiana Stampi di Battiston Ettore e C, S.n.c.” and he confirms that he has “at all relevant times been employed by L’Artigiana Stampi di Battiston Ettore a C, S.n.o.” and that “as a result” “the copyright in the BEACH MODEL design originally vested in L’Artigiana Stampi di Battiston Ettore a C, S.n.o.”;

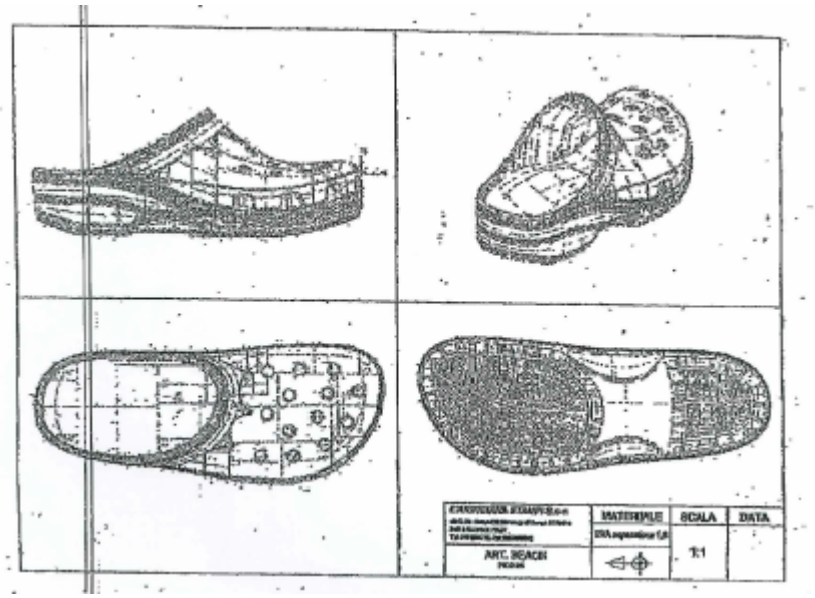
- “the copyright has subsequently been assigned by L’Artigiana Stampi di Battiston Ettore a C, S.n.o., to Finproject N.A., a

Canadian company of 1500 Rue De Tanneura, Quebec City, Quebec, Canada", wherein "a copy of the Deed of Assignment" is annexed in "Annexure "B";

- he annexes in "Annexure "A" a copy of the design drawings reflecting the BEACH MODEL design".

Enclosed to these affidavits are:

- the following four views marked by the Applicant as "Annexure A" and attached to the document D10A (in the following: "D10AA"):



- two copyright assignment agreements, marked by the Applicant as "Enclosure D10A" and referred to it also as "Annexure B". They bear signature dates of 15/09/2004 and 20/06/06, respectively;

- an affidavit of the Applicant's Representative Mr. Harald Förster, marked as "SA 6111-02EU", dated 14/05/07 (in the following: "D11). In this affidavit, Mr. Förster, among others, declares, that he contacted "the HDS - Hauptverband der Deutschen Schuhindustrie e.V Ealdstr. 44, 63065 Offenbach (www.hds-schuh .de), which is the Union of the German shoe manufacturers" and that "the relevant maganer" "confirmed that members of the HDS attend international trade shows, in particular in Europe and in the US, such as mentioned on their website (D13)";

- a printout of the webpage titled "Messen national - international 2007" from the website http://www.hds-schuh.de of the Hauptverband der Deutschen Schuhindustrie e.V. and dated 14.05.2007. It was submitted in the German language and

marked by the Applicant as “D13“. This printout contains a list of national and international exhibitions;

(15) On 25/05/07 the Holder was invited to submit his observations to the Applicant’s observations until 25/07/2007. In his reply on 31/05/07 the Holder observed that the photographs submitted in this notification were not clear and requested submission of clear copies of these photographs. Due to this the Applicant was requested on 21/06/07 to submit a second set of these photographs until 21/07/07, which he complied with on 19/07/07. On 31/08/07 the Holder was thus sent a second set of photographs and notified anew to submit his observations until 31/10/07.

(16) On 25/10/07 the Office received the second observations from the Holder, in which he explicitly contests the Applicant’s observations:

- “that an identical design was made available to the public before 28 May 2003 in such a way which would in any way interfere with the ability of the design to be novel under the provisions of the Community Design Regulation”; and

- “that an identical design was made available by FinProject prior to 28 May 2003”, wherein “the only design that FinProject made available to the public prior to 28 May 2003 was the basic clog design known as the Aquaclog”.

Regarding other Applicant’s arguments he observes that he “confirms that he agrees “that the clog, without strap, may have been made available to the public in the Community before the 12 month grace period” referring to the example of “the old, strapless design shown at D10A”.

He also agrees “that the design, with strap, was made available to the public before 12 month grace period in three ways:

(i) it appeared on a website;
(ii) it was offered for sale and sold at the Fort Lauderdale show”;
(iii) it was offered for sale and sold locally in South Florida”;

but adds, that he disputes, that by these means the design of the shoe, with strap, could reasonably have become known in the normal course of business to individuals in the sector concerned, operating in the Community”.

The Holder maintains his “position that any disclosures that were made of the CD prior to 28 May 2003 are ones which would fall within the exception detailed in Article 7(1) CDR insofar as they would not reasonably have become known in the normal course of business to individuals in the circle of specialist in the sector concerned, operating within the Community” and that “in all the circumstances a disclosure

made in a Boat Show in Florida at a small stand of the sort that is described by Mr. Hanson in his Witness Statement is clearly not a disclosure which should be deemed to be one which would fall outside the exception in Article 7(1) CDR". For this show he adds "there is no evidence of a shoe manufacturing attending a Fort Lauderdale show, except Crocs", wherein "the exhibitions which shoe manufacturers do attend are shown in D13, where no less than 85 shows are listed, but not Fort Lauderdale, or indeed any other boat show among them", where the nature of this show as the show "for the sale of boats, not shoes" "is shown in D14".He concludes that "there is no basis for saying that, by exhibiting in the Fort Lauderdale show, or any other boat show, the design could reasonably have become known to the shoe designers in the Community". Similarly, he observes for the sale in south Florida by stating that "on the evidence, no manufacturer of shoes in the Community ever in fact saw Crocs` shoe for sale in Florida", "because it was clearly of a scale of local test marketing, not international, or even national, marketing".

Regarding the web page disclosure he observes "that the presence of a design on a website does not of itself make a design known to individuals in the sector concerned, and the evidence of Mr. Wijsman paragraphs 11 and 12, has not actually been disputed by the Applicant", where "it is not reasonable to suppose that a single web page originating in the US will become known to any manufacturer in the Community". He reasons that "the fact that the website exists does not mean that its contents would reasonably become known in the normal course of business to the circles specialist in the sector operating within the Community" as these circles were "not aware of Crocs at the beginning of 2003, which they could not have been, then they would not have been looking for the Crocs website" and "if they were not specifically looking for the Crocs website, it is virtually impossible that they would have come across it by accident and certainly it would not be "reasonable" for them to have come across it in the "normal course of business".

He asserts once more, "that the design without the strap in not identical and the shoe with the strap gives a different overall impression and has a different impact upon the user" and that "the CD demonstrates a key and fundamental design feature, being the strap, which creates a different overall impression to the basic Aquaclog" as "the strap of this design is of course not a small strap", but "significant when compared to the shoe upon which it sits" and gives a "strappy sandal" impression to the shoe, as distinct from the "clog" impression given by the version without a strap". He also observes that "the strap is not capable of being viewed as solely dictated by its technical function" as "it performs an aesthetic purpose as well", which "actually outweighs the technical function" and thus "even if it was considered that the strap did have some technical function, it would not be caught by the provisions of Article 8(1) as the function may be achieved by alternative designs and different arrangement".

(17) In support of his second observations the Applicant submitted a second witness statement of Mr. Dick Wijsman (in the following "E3"). In this witness statement Mr. Wijsman states that:

> – he can confirm "that in the region of 10,000 pairs of Crocs made to the CD were sold by the Holder prior to 28 May 2003", wherein "these sales are to be seen in the context of a population of the United States which exceeds 300,000,000 people", "were through small shops or direct to individuals who had seen these shoes at the Florida Boat Show" and "that the geographical locations of the shops involved at the time up until 28 May 2003 was limited to the area around Boulder Colorado and in southern Florida";
>
> – "no shoes manufactured to the CD had been sold in the Community prior to April 2005";
>
> – "the phenomenal commercial success of these shoes is due" in his "opinion, to the fact that they have an appeal which goes beyond anything that has been put on the market in the Community prior to the launch of the Holder's shoe in the Community April 2005" and that "this" "is the clearest possible demonstration of the fact that the Holder's shoes are of a design which is individual in character and certainly novel".

(18) On 09/11/07 the Office informed both parties that the written proceedings were closed and that a decision concerning the invalidity would be taken.

(19) For further details to the facts, evidence and arguments submitted by the Applicant and the Holder reference is made to the documents on file.

II. GROUNDS OF THE DECISION

A. Admissibility

(20) The request to declare the RCD invalid, because it does not fulfill the requirements for protection of Articles 4 to 7 of CDR, since it lacks novelty and individual character, is a statement of the grounds on which the Application is based in the meaning of Article 28(1)(b)(i)

CDIR[2]. Furthermore, the Application complies with Article 28(1)(b)(v) and (vi) CDIR, since the attachment contains an indication of the facts, evidence and arguments submitted in support of these grounds. The other requirements of Art. 28(1) CDIR are fulfilled as well. The Application is thus admissible.

B. Substantiation

B.1 Evidence

(21) The witness statements in E1, E2 and E3 are verified by a statement of truth signed by the maker of the statement and contain all the other required elements and thus have the effect of statements in writing pursuant to Article 65(1)(f) CDR and are admissible as evidence.

(22) The affidavits in D10, D10A and D11 are sworn written statements, signed by a declarant, and in case of D10A witnessed by a taker of the oath. Thus, they have the effect of statements in writing pursuant to Article 65(1)(f) CDR and are admissible as evidence.

(23) For the applicable evidence submitted in the Application, which does not contain all the relevant facts, the facts declared in the above statements that were given by both parties or people related to them and which confirm the same facts were also taken into considered by the Invalidity Division.

(24) The evidence concerning sales of the footwear and mainly the sales in the North American market were taken into consideration, especially if they referred to the broad use in trade of the designs of the clogs, because this market is considered to be an important part of the market in which the Community circles specialised in the sector concerned operate and which they monitor in the normal course of business.

(25) D1, showing the Crocs clog designs with the strap, was thus considered as evidence about the prior design that was made available to the public more than 12 months prior to the priority date of the RCD by the Holder himself within the meaning of Article 7(1) CDR and with consideration of Article 7(2) CDR. Both parties have confirmed this fact in submitted written statements, namely the Applicant in D10 and the Holder in E1 and E2 as well as in his second observations.

(26) D5, D7 and D10AA were taken into consideration as evidence about prior disclosure of designs of the clogs without the straps, because both parties confirm the same fact in their statements, namely the Applicant in D10 and D10A and the Holder in his second observations. Even though D5 shows also clogs with straps, these were not taken into consideration, because in D10 it is explicitly stated that only “the

[2] Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community designs

clogs (without strap) as depicted in" it "were sold in North America since at least July 2002".

(27) D4 as a printout from the Holder's Internet website containing its address and a date of the printout was thus taken into consideration as evidence about prior design disclosure within the meaning of Article 7(1) CDR, because its date precedes 12-month period prior to the priority date of the RCD with consideration of Article 7(2) CDR. It was considered to be publicly disclosed on the specified date of the printout despite the Holder's argumentation that "the fact that the website exists does not mean that its contents would reasonably become known in the normal course of business to the circles specialist in the sector operating within the Community" as these circles were "not aware of the Crocs at the beginning of 2003" and other arguments as pointed out above. The fact about disclosure of D4 in the specified time was confirmed also by the Holder himself by filing the US trademark application based on the prior use of the trademark as shown in D4 as well as in E1 and E2.

B.2 Novelty

(28) According to Article 5 CDR the RCD lacks novelty when an identical design has been made available to the public prior to the date of filing of the RCD or the date of the priority claimed. For a design that is a subject matter a registered Community design and that was disclosed by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer or his successor in title the exception from disclosure pursuant to Article 7(2) CDR applies for the period of 12-month preceding the filing date or the date of priority claimed. Designs shall be deemed to be identical if their features differ only in immaterial details. When assessing novelty and/ or individual character, the RCD must be compared with each prior design individually.

(29) The prior designs of clogs in D1, D4, D5, D7 and D10AA and the RCD all concern a design of the clog footwear with a simple shape. They all have a sole, a heel and an upper.

(30) However, despite a similar shape of the sole, heel and upper, the RCD differs from the prior designs disclosed in D5, D7 and D10AA at least in the strap, which the RCD has placed over the back part of the clog and which these prior designs do not have. The difference in the strap subsists in a feature which is not an immaterial detail in the design of the clog. Therefore, the RCD is not identical to the prior designs in D5, D7 and D10AA.

(31) The prior designs in D1 (i.e. the clog design on the very left side) and D4 (i.e. the front clog design in the bottom view in the middle) and the RCD have the following features in common:

- the same simple general shape of the upper that covers the front 5/8 of the clog and has an opening at its back side extending from the heel part to the instep part of the clog;

- the strap of the same shape placed over the back 3/8 of the clog, which is mounted to the upper at each of its bottom lateral sides at the clog's heel part with a circularly shaped rivet;

– the sole of the same simple shape having a recess between the heel and the front part of the sole;

- the heel of the same simple shape with medium height that is placed in the back 3/8 of the sole;

- lateral side of the upper with a linear set of three bigger half circular holes arranged along the bottom edge of these sides.

(32) However, the prior designs in D1 and D4 differ from the RCD in the following features:

– a set of smaller more or less circular holes scattered on the top surface of the upper, which is present only in the RCD, whereas it does not appear to be present in the prior designs of D1 and D4;

- colour of the clog, which is not specified in the RCD and which appears to be dark in the prior design of D4 and dark green in D1;

- pattern and texture of the bottom surface of the sole, which is present in the RCD and is not disclosed in the prior designs .

(33) The above listed differences subsist in features which are not immaterial details in the design of the clog. Therefore, the RCD is not identical to the prior designs in D1 and D4.

(34) The submission of the Applicant that the RCD lacks novelty is therefore not founded.

B.3 Individual Character

(35) According to Article 6 CDR the RCD lacks individual character if the overall impression it produces on the informed user is the same as the overall impression produced on such a user by any design which has been made available to the public prior to the date of filing of the RCD

or the date of the priority claimed. For a design that is a subject matter a registered Community design and that was disclosed by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer or his successor in title the exception from disclosure pursuant to Article 7(2) CDR applies for the period of 12-month preceding the filing date or the date of priority claimed. When assessing individual character the degree of freedom of the designer in developing the design has to be taken into consideration.

(36) The informed user is familiar with the clog footwear to which the RCD relates. He is aware of the requirements that such a type of footwear must fulfill in order to perform its function as a clog and of the prior art known to the circles specialized in the sector concerned. In particular, he takes into account that the degree of freedom of the designer is limited by the requirement that such a clog must have a sole and an upper and may also have a strap, which all serve to protect the foot and provide stability to it. All these parts must be adapted to the shape of the human foot and its instep. In consequence, the informed user will pay more attention to the features where the designer was not limited in his creativity, such as the shape of the sole and the heel as well as the shape and configuration of the upper part of the upper, inclusion of a strap and especially to their decorative elements.

(37) Pursuant to Article 6 CDR the overall impression produced on the informed user by the RCD must be assessed by comparison with the overall impression produced on such a user by a prior design cited, wherein the attention is focused on the shape of the design as a whole.

(38) With exception of the strap, the RCD and the prior designs in the D5, D7 and D10AA have similar shapes of the front part of the clog, the sole and the heel clog. However the difference in the strap, which is present in the RCD and absent in these prior designs, and which represents quite a significant part of the clog affects the overall shape and configuration of the clog design. Even when considering the fairly unlimited freedom of the designer in developing the design of the clog, the difference in the strap makes the RCD produce on the informed user an overall impression that differs from the overall impressions produced on the informed user by any of the prior designs of D5, D7 and D10AA.

(39) The RCD and the prior designs in D1 and D4 all have the same general shape of the clog with the same proportions and almost the same configuration as observed in paragraphs 31 and 32 above. Because the general shape of the clog and its main parts prevail in the overall impression of the clog design, the two designs with the same general shape and almost the same configuration of the upper with strap, the sole and the heel produce the same overall impression on the informed user. Considering the fairly unlimited freedom of the designer in developing the design of the clog, the differences in the presence or

absence of the smaller holes on the top surface of the upper and the features of the bottom surface of the sole, and in the colours of the clog, which has a simple overall shape do not render the overall impression produced on the informed user by the RCD different from the overall impressions produced on the informed user by the prior designs in D1 and D4.

(40) Therefore, the RCD lacks individual character over the prior designs in D1 and D4.

C. Conclusion

(41) The Invalidity Division finds that the ground for invalidity of Article 25(1)(b) CDR prejudices the maintenance of the contested RCD. Therefore, the RCD has to be declared invalid.

III. COSTS

(42) Pursuant to Article 70(1) CDR and Art. 79(1) CDIR, the Holder shall bear the fees and the costs of the Applicant.

IV. RIGHT TO APPEAL

(43) An appeal shall lie from the present decision. Notice of appeal must be filed at the Office within two months after the date of notification of this decision. The notice is deemed to have been filed only when the fee for appeal has been paid. Within four months after the date of notification of the decision, a written statement setting out the grounds of appeal must be filed (Art. 57 CDR).

THE INVALIDITY DIVISION

Eva Udovc **Peter Rodinger** **Martin Schlötelburg**