



**DECISION  
of the Third Board of Appeal  
of 12 November 2009**

In Case R 1114/2007-3

**Dr. Oetker Polska Sp. z o.o.**

ul. Adm. Dickmana 14/15  
PL-80-339 Gdansk  
Poland

Appellant

represented by Andrzej Przykorski, KANCELARIA PATENTOWA ANDRZEJ  
PRZYKORSKI, ul. Malawskiego 5/108, PL-02-641 Warsaw, Poland

v

**Zakład Produkcyjno - Handlowy "TROPIC"**

ul. Westerplatte 59  
PL-76-200 Slupsk  
Poland

Respondent

represented by KANCELARIA PATENTOWA DANUTA NIBURSKA,  
Al. 3 Maja 68 B, PL-76-200 Slupsk, Poland

APPEAL relating to Invalidity Proceedings No ICD 2723 (Registered Community  
Design No 273644-0001)

**THE THIRD BOARD OF APPEAL**

composed of Th. Margellos (Chairperson), D.T. Keeling (Rapporteur) and  
M. Bra (Member)

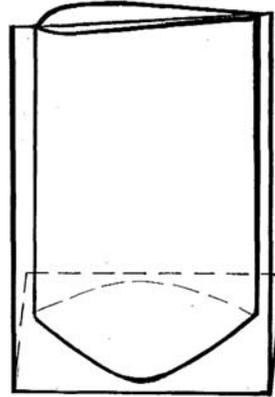
Registrar: J. Pinkowski

gives the following

## Decision

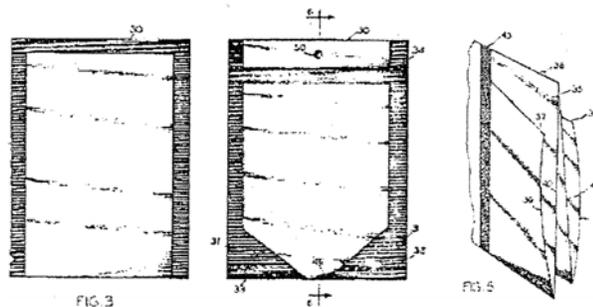
### Summary of the facts

- 1 The respondent is the holder of Registered Community Design No 273644-0001 ('the RCD'), which has a filing date of 21 December 2004. The RCD is registered for 'packaging for foodstuffs'. It is represented as follows:

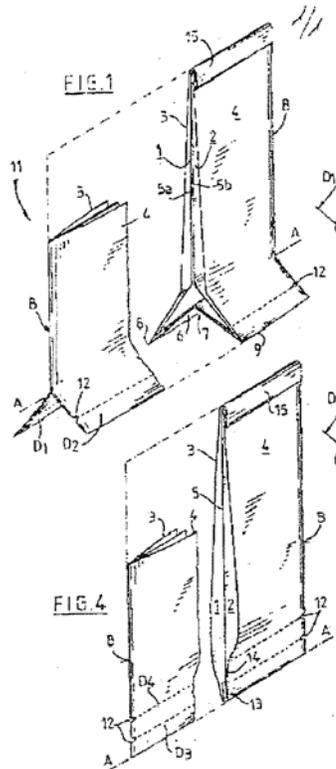


- 2 On 12 June 2006 the appellant filed an application for a declaration of invalidity against the RCD. The appellant argued that the design did not fulfil the requirements of novelty and individual character under Articles 4 to 6 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs ('CDR') (OJ EC 2002 No L 3, p.1). The appellant also argued that the RCD should be invalidated under Article 8(1) CDR since its essential features are solely dictated by the product's technical function. The appellant provided the following documents as evidence:

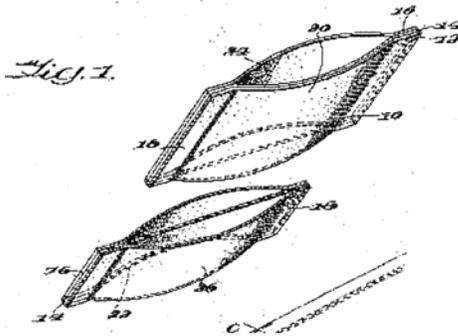
- A copy of an extract from the publication of the US patent No 3 469 768 (in the following: D1), patented on 30 September 1969, showing *inter alia* the following three figures:



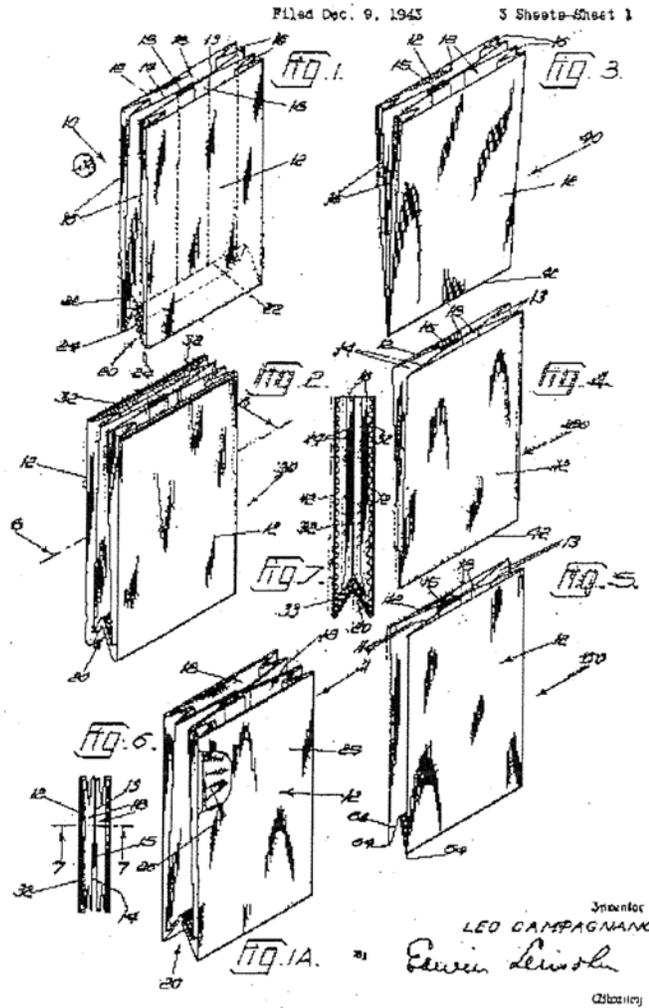
- A copy of the publication of the European Patent Application No 0 063 103 B1 (in the following: D2), published on 20 October 1982, showing *inter alia* the following two figures:



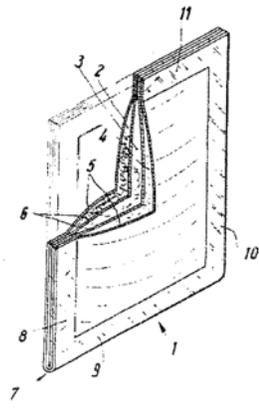
- A copy of an extract from the publication of the US patent No 2 401 110 (in the following: D3), published on 28 May 1946, showing *inter alia* the following two figures:



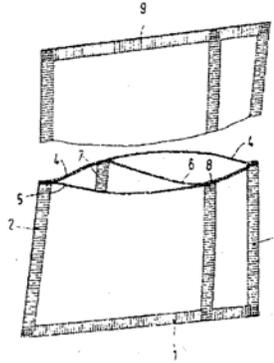
- A copy of an extract from the publication of the US patent No 2 416 816 (in the following: D4), published on 4 March 1947, showing *inter alia* the following six figures:



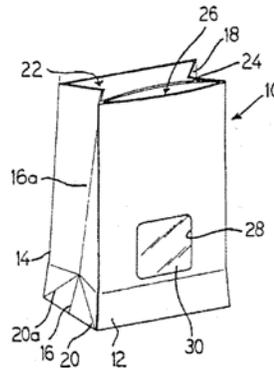
- A copy of an extract from the publication of the US patent No 3 891 138 (in the following: D5), published on 24 June 1975, showing the following figure:



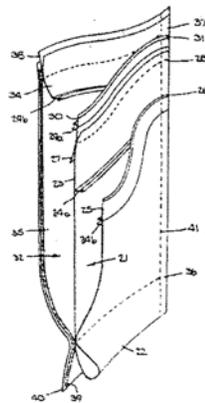
- A copy of an extract from the publication of the US patent No 4 312 473 (in the following: D6), published on 26 January 1982, showing the following figure:



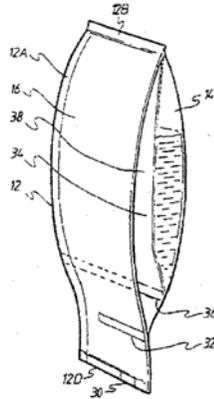
- A copy of an extract from the publication of the US patent No 4 991 980 (in the following: D7), published on 12 February 1991, showing *inter alia* the following figure:



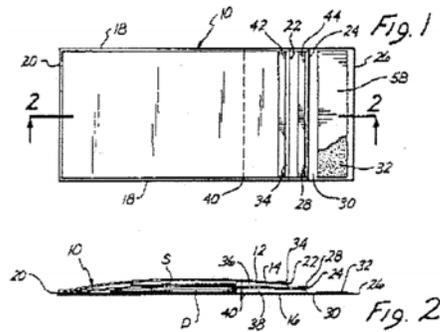
- A copy of an extract from the publication of the US patent No 4 993 844 (in the following: D8), published on 19 February 1991, showing *inter alia* the following figure:



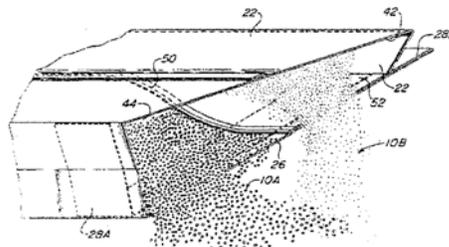
- A copy of an extract from the publication of the US patent No 5 373 966 (in the following: D9), published on 20 December 1994, showing *inter alia* the following figure:

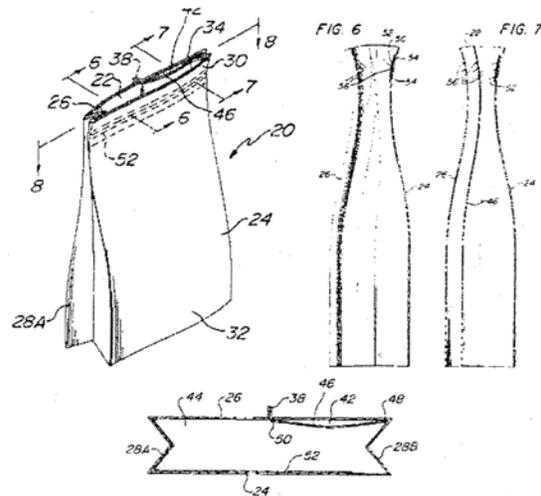


- A copy of an extract from the publication of the US patent No 5 102 234 (in the following: D10), published on 7 April 1992, showing *inter alia* the following two figures:

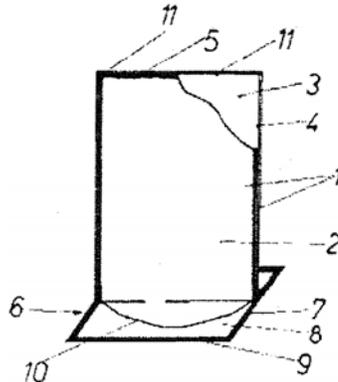


- A copy of an extract from the publication of the US patent No 5 407 278 (in the following: D11), published on 18 April 1995, showing *inter alia* the following five figures:





- A copy of a patent specification in Polish bearing the No 358 653 together with an English translation (in the following: D12), showing the following figure:



- A copy of an extract from the publication of the Polish patent bulletin BUT Nr. 17/2004 regarding the patent application No 358 653 (in the following: D13), showing the figure as D12.
- 3 On 15 May 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 The Invalidity Decision reasoned as follows:
- The RCD and the prior designs disclosed in D1-D11 all concern the designs of packaging for foodstuffs having at least one compartment. However, the prior designs and the RCD differ at least in the following:
    - The design disclosed in D1 does not comprise the feature of a rectangular bottom which, on the other hand, is not present in the RCD. In D1 the middle wall is higher than the back and front wall of the compartments, whereas in the RCD all the walls are of the same height.

- The design of D2 does not show seams at any of the sides whereas the RCD has seams on three sides. Furthermore, the bottom in the prior design is folded along a midsection which is not present in the RCD.
  - The design of D3 shows two seams at the left and the right side but none on the bottom thereby marking a difference to the RCD.
  - D4 shows various designs for packages each having two compartments, but none of the designs contains any seam.
  - D5 discloses a design of a package with three different compartments whereas the RCD has only two of them. In D5 the seams are placed at all 4 sides so that all the sides of the packaging are closed, whereas in the RCD there is no seam at the top side so that the packaging in it is open at this side.
  - In D6 the seams are placed at all four sides so that all the sides of the packaging are closed and the front and the back side also have longitudinal seams that attach the internal separational transversal wall to these sides resulting in two longitudinal, but transversally separated compartments. In the RCD, on the other hand, the two longitudinal compartments are separated by a middle wall placed parallelly with the front and back sides.
  - D7 discloses a design of a package having windows and no seams.
  - The design shown in D8 comprises two compartments of a different height whereas the RCD consists of two containers with equally high walls.
  - D9 discloses a design which differs from the RCD regarding *inter alia* the proportions of the package, the arrangement of the two compartments and the position of the seams.
  - D10 discloses the side view of cross sectional configuration of the package, but not its overall shape. Furthermore, it has three compartments whereas the RCD has only two compartments.
  - The design in D11 presents a package with non rectangular bottom and without seams at its sides.
- These differences between the prior designs and the RCD mentioned above do not concern just immaterial details. Therefore, the prior designs and the RCD are not identical within the meaning of Article 5(1) CDR.

#### *Individual character*

- A design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any prior design which has been made available to the public.
- The informed user is familiar with the design of packaging for foodstuff. He is aware that the degree of freedom of a designer concerned with such packing is

limited only in so far as there must be at least one container which is stable and allows keeping food inside. In particular, he knows that there is no technical need for an angular form of the package and the provision of a bottom. A package for foodstuff may also have a circular shape still fulfilling the same technical function. The appellant itself presented a variety of possible design alternatives.

- In the present case, the overall impression produced on an informed user by the RCD differs from the overall impressions produced by the prior designs. The feature of combination of seams on both lateral sides, two longitudinal compartments with the same height and the middle wall placed between them and parallel to their walls and a rectangular shaped bottom as described above is unique to the RCD and defines the overall impression produced on the informed user. None of the prior designs produces the same overall impression as the RCD. Therefore, the prior designs do not form any obstacle to the individual character of the RCD.
- 5 On 16 July 2007 the appellant filed a notice of appeal against the contested decision. The appellant submitted a statement of grounds on 20 September 2007.
- 6 The respondent submitted a response on 16 November 2007.
- 7 A reply and a rejoinder were submitted on 18 January 2008 and 14 February 2008 respectively.

### **Submissions and arguments of the parties**

- 8 The appellant argues as follows:
- The contested decision did not examine the appellant's argument concerning the technical function of the design 8Article 8(1) CDR).
  - The appellant's information about the identical multiple-compartment packaging for foodstuffs, shown in the RCD drawing, and introduced onto the EC market prior to the date of filing of the RCD, was not considered in the contested decision at all. The appellant mentioned the European companies that employed the packaging for foodstuffs at an earlier date. The appellant provided the exact mail address of Messrs Laudenberg Verpackungsmaschine GmbH, one of manufacturers of such packaging.
  - After filing the request for RCD invalidation, the appellant received a letter from Messrs VOLPAK SA, Barcelona, Spain, confirming that Messrs UNILEVER BESTFOODS, Italy also manufactured packaging for foodstuffs like that shown in the RCD in 2002 and offered it on the EC market. As the proof for it they enclosed the respective technical documents. One can obtain from various European manufacturers of foodstuffs, e.g. Gallina Blanca, Knorr, Pasta Time, Podravka, statements to confirm the dates of product sales in packaging as shown in the RCD drawing and prior to the filing date of the RCD. It is possible to track down the archived internet pages of product advertisements that include the internet publishing dates.

- The internet address [http://www.gnpd.com/sinatra/gnpd/search\\_results/&item\\_id=229604](http://www.gnpd.com/sinatra/gnpd/search_results/&item_id=229604) shows a double-compartment packaging for foodstuffs employed by Messrs Knorr; it is dated September 2003.
- 9 The respondent requests the Board to dismiss the appeal and award costs against the appellant. Its arguments may be summarized as follows:
- The appellant claims that it presented many examples of packages identical to the RCD and that the Office did not refer to them, among others, the packaging of Landenberg Verpackungsmaschine GmbH. The appellant did not enclose any proof confirming that the companies listed on page 1 of the application for invalidation produced identical packaging to the RCD.
  - The Invalidity Division referred to the whole of the evidence included the application, listing the evidence in the contested decision. The invalidity applicant is obliged to provide all necessary evidence in its application pursuant to Article 28(1)(b)(v) of Commission Regulation No 2245/2002.
  - The additional evidence submitted by the appellant in its grounds of appeal does not disclose a design that makes the same overall impression on the informed user as the RCD.

### **Reasons**

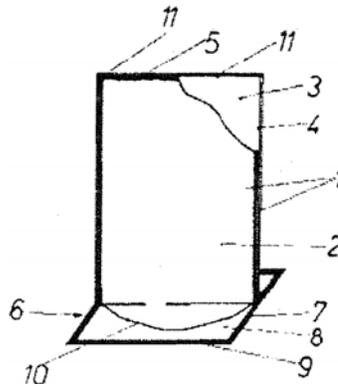
- 10 The appeal complies with Articles 55 to 57 CDR and Article 34(1)(c) and (2) of Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community designs ('CDIR') (OJ EC 2002 No L 341, p. 28). It is therefore admissible.

#### *The submission based on Article 8(1) CDR*

- 11 It is first necessary to consider the appellant's argument that the Invalidity Division failed to examine the appellant's submission that the RCD should be declared invalid under Article 8(1) CDR. This argument is clearly well founded. The submission based on Article 8(1) CDR was expressly raised in the appellant's application for a declaration of invalidity, which was submitted on 12 June 2006. There is no mention of the submission in the contested decision. The decision must therefore be annulled and the appeal fee must be refunded, pursuant to Article 37 CDIR, since the failure to examine one of the appellant's submissions constitutes a substantial procedural violation.
- 12 Rather than remit the case to the Invalidity Division under Article 60(1) CDR, the Board will decide on the substantive issue itself, on grounds of procedural economy.
- 13 Article 8(1) CDR says:

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

- 14 The appellant's submission is based on the argument that the designer of the RCD filed Polish patent application No 358 653 on 10 March 2003 and that the said patent application concerns exactly the same form of bag as the RCD. The appellant deduces from this circumstance that every feature of the RCD's appearance was solely dictated by the product's technical function. The appellant produces an extract from the Bulletin of the Polish Patent Office relating to patent application No 358 653, which contains the following drawing:



and the following description:

'Bag especially for foodstuffs, having two sidewalls, each sidewall with internal surface and external surface characterized in that it has internal wall (4) and internal wall has surfaces that both are internal surfaces (3) and it connects at least to one internal surface (3) of sidewall (1).'

- 15 It is impossible to determine on the basis of the above drawing and description whether the Polish patent application and the RCD relate to the same product or not. The drawing does not reveal the existence of twin compartments, which is clearly a characteristic feature of the RCD. The accompanying description, at least in the English version provided by the appellant, is difficult to make sense of. It might describe the RCD or it might describe a different package. It is in any event not certain that the RCD would have to be declared invalid solely because it related to the same product as a patent application.
- 16 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 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 objectively 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 (see Decision of 22 October 2009 in Case R 690/2007-3, 'Chaff cutters', at paragraph 36).
- 17 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.

- 18 It is difficult to see anything in the RCD that could have been influenced by anything other than the need to design a pouch, of convenient dimensions, that would be a practical means of packaging certain types of processed food, in particular when two portions or two separate lots of ingredients have to be put in a single packet for sale to the end consumer. The basic shape and dimensions of the RCD correspond to the existing paradigm for such products. Those features are functional in the sense that they are imposed by the norms of the marketplace. The technical function this type of product is to package certain foodstuffs in a manner that is acceptable to consumers. The twin compartments are functional because without twin compartments it would be impossible to put two portions or two separate lots of ingredients into the same package. The flap at the base of the RCD is not arbitrary. It is there for a purpose, namely to facilitate tearing the package open. The rounded edges visible at the top and bottom of the pouch correspond to the norm for this type of product. Such pouches normally bulge at the centre because that is the simplest and most obvious shape for them to have. A pouch could of course be square or octagonal or have some other shape. Such shapes would, however, be more expensive to manufacture and might encounter consumer resistance because they would depart from the norm. A rounded shape is clearly the most functional. All the essential features of the RCD have been chosen with a view to designing a product that performs its function. None of those features has been chosen for the purpose of enhancing the product's visual appearance.
- 19 It follows from the above that the RCD must be declared invalid under Article 8(1) CDR.

*The submission based on lack of novelty and lack of individual character*

- 20 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 deal with them.
- 21 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.
- 22 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.’

23 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.’

24 In order to prove lack of novelty the appellant has to show that an identical design – disregarding immaterial details – was made available to the public before the filing date of the RCD. In order to prove lack of individual character the appellant has to prove that, before the filing date of the RCD, a design that makes the same overall impression on an informed user of the product in question, taking into account the degree of freedom of the designer in developing the design, was made available to the public.

25 In the contested decision the Invalidity Division gave reasons for the finding that none of the examples of prior art cited by the appellant (see paragraph 2 above) were sufficiently similar to the RCD to destroy its novelty or individual character. The appellant has not challenged that finding. Instead the appellant points out that it had argued before the Invalidity Division that a German company called Laudenberg Verpackungsmaschine GmbH had, well before the filing date of the RCD, supplied to the market a product identical or very similar to the RCD, which was thus deprived of novelty or individual character. The appellant argues that it thereby complied with Article 28(1)(b)(v) CDIR, which provides that an application for a declaration of invalidity must contain:

‘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’.

The appellant adds that the Invalidity Division could, pursuant to Article 53(2) CDR, have requested the appellant to supplement the evidence or ‘examine by phone the facts provided about the Laudenberg Verpackungsmaschine GmbH’. The appellant points out that it provided the address, telephone and fax numbers of that company.

- 26 The appellant appended to its statement of grounds of appeal a copy of a letter of 27 March 2006 (in German) from Laudenberg GmbH which states that it has been manufacturing machines that make packaging similar to the RCD for ten years and delivered such a machine to a Croatian company on 14 May 2003. The letter goes on to state that two of Laudenberg's competitors – Volpak (Spain) and Klockner-Bartelt (USA) – make similar machines and supply Gallina Blanca in Barcelona and Unilever in Loosdrecht (Netherlands). Attached to the letter were images of various branded food products in pouches. The brands included Knorr and Gallina Blanca.
- 27 Also appended to the statement of grounds of appeal was a letter from Volpak S.A. stating that it has since 2002 been supplying packaging machines to form, fill and seal pouches with a membrane inside which creates two separate compartments. Volpak also provided images of Knorr and Gallina Blanca products.
- 28 The Board must first dismiss as wholly unfounded the appellant's argument that it complied with Article 28(1)(b)(v) CDIR by simply stating that a named company had supplied a product identical or very similar to the RCD before the filing date of the RCD. Under that provision an application for a declaration of invalidity based on lack of novelty or lack of individual character must contain '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'. The mere allegation that a company had marketed a product based on such a prior design is clearly not sufficient. Equally unfounded is the suggestion that the Invalidity Division should have contacted the Laudenberg company to seek confirmation of the alleged facts. The burden of proof is on the party who seeks to have an RCD declared invalid. To discharge the burden that party must itself produce the relevant evidence, not merely give the Office the contact details of a third party who might be in possession of the evidence and expect the Office to request the evidence from that third party.
- 29 The respondent has not objected to the admissibility of the additional evidence produced with the grounds of appeal but has instead argued that none the evidence demonstrates that the RCD lacked novelty or individual character at the filing date. The respondent contends that none of the examples of products allegedly marketed before the filing date is identical to the RCD or sufficiently similar to the RCD to produce the same overall impression.
- 30 All the examples of prior art relied on by the appellant consist of images of actual marketed food products. It is not easy to compare those images with the extremely simple line drawing that constitutes the RCD. The problem is that one is not really able to compare like with like. What the Board must do therefore is to imagine the finished products stripped of their coloured get-up and trade marks. The Board has to visualize the underlying basic product before it has been decorated with the logos, trade marks and coloured images of Knorr or Gallina Blanca and ask whether that product is identical to the RCD or sufficiently similar to produce the same overall impression on the informed user, bearing in mind the degree of freedom of the designer in developing the design.
- 31 The informed user in this case is likely to be a production manager in a company that makes food products that are packaged in pouch-like containers, rather than an

ordinary consumer who buys pre-packaged food products. The design represents ‘packaging for foodstuffs’, not finished products for sale to the end user. The informed user will be familiar with the different types of packaging that are available on the market. The degree of freedom in developing packaging designs is relatively limited. It is constrained by practical considerations and by established consumer preferences. The norm for this type of product is a rectangular pouch. If two lots of ingredients are to be kept separate, twin compartments are required.

32 The product images that come closest to the RCD are the following:



P1



P2



P3



P4



P5



P6

- 33 The characteristic features of the RCD are as follows: (i) a simple rectangular shape, the long sides being roughly 1.5 times the length of the short sides, (ii) twin compartments which are rounded when opened, (iii) short flaps at the base, and (iv) an apparently rounded shape at the bottom of the pouch.
- 34 There is no doubt that most, if not all, of the characteristic features of the RCD are contained in the designs shown in the previous paragraph. The flaps at the base of the RCD are, for example, clearly visible in P2. The twin compartments are shown in P5. The general shape is the same in all the designs. The apparent rounding at the bottom of the pouch in the RCD simply represents the rounding of the pouch as whole; it shows that the pouch, instead of being flat when it is filled with food, will bulge in the centre. This feature is obviously present in all the products from P1 to P6. It is a feature that is common to virtually all products of this nature.
- 35 There is nothing about the RCD that clearly distinguishes it from ‘the existing design corpus’, as illustrated by the selection of designs shown in the previous paragraph. That, however, is what would be required, according to recital 14 in the preamble to Regulation No 6/2002, in order to confer individual character on the RCD within the meaning of Article 6 CDR. The design shown as P2 is particularly close to the RCD. The only feature not clearly visible in that image is the existence of twin compartments. That feature will, however, be present whenever two portions of food or two separate lots of ingredients are packed in a single pouch. P5 shows what a pouch of this nature looks like when twin compartments are present. There is a striking resemblance between that design and the RCD. The Board concludes therefore that the RCD makes the same overall impression on the informed user as a number of pouches that were already on the market before the filing date. It follows that the RCD lacks individual character and must be declared invalid.
- 36 The above finding is not affected by the limited degree of freedom of the designer in developing the design. It is true that small differences might suffice to create a different overall impression in view of that limited freedom. In the present case,

however, the designer has not made any serious attempt to add to, or develop, the existing design corpus. Rather than working within a limited degree of design freedom, it would be truer to say that the designer has simply done a line drawing that reproduces all the essential features of a fairly basic product that was already well established on the market. There is therefore nothing to justify the view that the RCD possesses individual character on the basis of the designer's limited freedom of design.

37 It follows from the above that the RCD must be declared invalid.

### **Costs**

38 The respondent, as the losing party, must be ordered to bear the costs incurred by the appellant, in accordance with Article 70(1) CDR. The appeal fee must be reimbursed pursuant to Article 37 CDIR.

**Order**

On those grounds,

THE BOARD

hereby:

- 1 Annuls the contested decision;**
- 2 Declares Registered Community Design No 273644-0001 invalid;**
- 3 Reimburses the appeal fee;**
- 4 Orders the respondent to bear the costs incurred by the appellant.**

Th. Margellos

D.T. Keeling

M. Bra

Registrar:

J. Pinkowski