

DECISION
of the Third Board of Appeal
of 30 May 2022

In case R 1524/2021-3

Delta Sport Handelskontor GmbH

Wragekamp 6
22397 Hamburg
Germany

Invalidity Applicant / Appellant

represented by KNPZ Rechtsanwälte – Klawitter Neben Plath Zintler –
Partnerschaftsgesellschaft mbB, Kaiser-Wilhelm-Str. 9, 20355 Hamburg, Germany

v

Lego A/S

Aastvej 1
7190 Billund
Denmark

Design Holder / Respondent

represented by BOMHARD IP, S.L., C/Bilbao, 1, 5º, 03001 Alicante, Spain

APPEAL relating to Invalidation Proceedings No ICD 10 545 (Registered Community
Design No 1 664 368-0006)

THE THIRD BOARD OF APPEAL

composed of G. Humphreys (Chairperson), S. Rizzo (Rapporteur) and E. Fink
(Member)

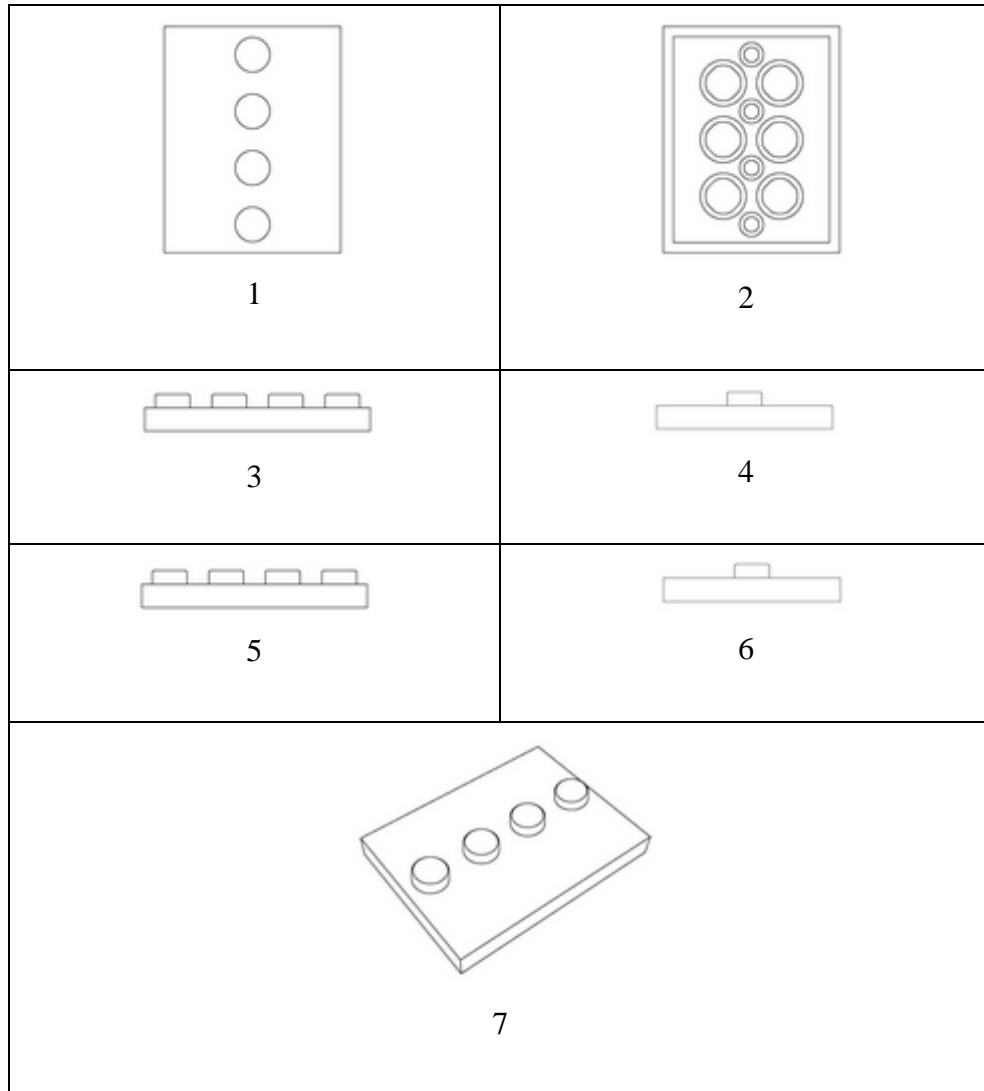
Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 Lego A/S ('the design holder') is the holder of registered Community design ('RCD') No 1 664 368-0006, with a filing date of 2 February 2010. The design is represented in the following views:



- 2 The indication of the products reads 'Building blocks from a toy building set'.
- 3 The design's registration was published in the Community Designs Bulletin No 2010/032 of 11 February 2010.
- 4 On 8 December 2016, the invalidity applicant, Delta Sport Handelskontor GmbH ('the invalidity applicant'), filed an application for a declaration of invalidity of the RCD ('the contested design') pursuant to Article 52 CDR.
- 5 The ground relied on in support of the application was that laid down in Article 25(1)(b) CDR, read in conjunction with Articles 4 to 9 CDR. In particular,

the invalidity applicant claimed that all the features of appearance of the product concerned by the contested design were solely dictated by the technical function of the product and, for that reason, were excluded from protection pursuant to Article 8(1) CDR. In particular, the invalidity applicant argued that the studs on the upper side of the block and the holes on the lower side were designed to allow interconnection with other blocks of the building set and referred, as a relevant precedent, to the decision rendered in case R 856/2004-G by the Grand Board of Appeal and the judgment of the ECJ (14/09/2010, C-48/09 P, Legobrick, EU:C:2010:516).

- 6 By decision of 30 October 2017, the Invalidity Division rejected the application for a declaration of invalidity as unfounded. In particular, it found that the technical function of the building block was to be interconnected with other building blocks for the purpose of playing, and the invalidity applicant had failed to prove that fulfilling that function was the only factor which had determined the features of appearance of the product concerned by the contested design. In order to refute the invalidity applicant's argument that the freedom of the designer of building blocks is limited, in the present case, on account of the interoperability of the elements, the Invalidity Division observed, inter alia, that the building set corresponded to the definition of a modular system and that it was not appropriate to exclude the contested design from protection on grounds of interoperability.
- 7 On 5 January 2018, the invalidity applicant appealed the decision of 30 October 2017 and submitted the corresponding statement of grounds on 12 March 2018.
- 8 The design holder responded on 8 May 2018.
- 9 The parties exchanged additional observations on 11, 19 and 30 July 2018.
- 10 By decision R 31/2018-3 of 10 April 2019, the Third Board of Appeal upheld the appeal, annulled the decision of the Invalidity Division and declared the contested design invalid. In essence, it found that all the features of appearance of the product concerned by the contested design were solely dictated by the technical function of the product, namely to allow assembly with, and disassembly from, the rest of the bricks of the set.
- 11 In the first place, the Board of Appeal observed that the product concerned by the contested design was a building block that is part of a larger set of bricks and was intended to be assembled with other bricks of the set to build objects. The technical function that that brick must fulfil is, therefore, the capability of being assembled, with sufficient stability, with other bricks of the set in order to create a toy building.
- 12 In the second place, it identified the features of appearance of the product: namely (i) the row of studs on the upper face of the brick; (ii) the row of smaller circles on the lower face of the brick; (iii) the two rows of bigger circles on the lower face of the brick; (iv) the rectangular shape of the brick; (v) the thickness of the walls of the brick; and (vi) the cylindrical shape of the studs.

- 13 In the third place, the Board of Appeal found that all the features identified by it and approved by the applicant were solely dictated by the technical function of the building brick, namely assembly with, and disassembly from, the rest of the bricks of the set. It also noted that the design holder, whilst disputing that the features of appearance are solely dictated by the technical function, did not cite a single consideration other than the technical consideration that might have determined the visual aspect of those features.
- 14 In response to the design holder's argument that no objective facts or evidence demonstrating that the features of the product concerned by the contested design are solely technical have been adduced in the present case, the Board of Appeal stated that the invalidity applicant had submitted, before both the Invalidity Division and the Board of Appeal, convincing explanations, supported by illustrations, as to how the bricks of the set are assembled together and how each of the features of their appearance make it possible for those bricks to be assembled and disassembled.
- 15 In addition, the Board of Appeal took the view that the findings of the Grand Board of Appeal, upheld by the General Court (judgment of 12 November 2008, *Lego Juris v OHIM – Mega Brands (Red Lego Brick)*, T-270/06, EU:T:2008:483) and the Court of Justice (judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516), in the case relating to trade mark application No 107 029 could be transposed *mutatis mutandis* to the contested design, in view of the fact that the features of appearance of the brick that the applicant attempted to register as a three-dimensional mark were also present in the brick in which the contested design is to be incorporated.

Judgment of the General Court in case T-515/19

- 16 The design holder filed an action before the General Court, on the grounds that the decision was in breach of Article 8(3), Article 8(1) and Article 62 CDR.
- 17 It alleged, inter alia, an error of law relating to the Board of Appeal's refusal to apply Article 8(3) CDR, even though the design holder relied on that provision during the proceedings before the Board of Appeal.
- 18 In that regard, the design holder argued that the contested design falls within the exception referred to in Article 8(3) CDR and it could therefore not be declared invalid in the present case. In its view, that provision should be interpreted as an exception to Article 8(1) CDR, either directly or via Article 8(2) CDR. If it were held that Article 8(3) constitutes an exception only to Article 8(2) and that that provision was not a *lex specialis* in relation to Article 8(1), Article 8(2) and (3) would be rendered ineffective in contradiction with the objective of the legislation, namely the protection of modular systems. As a consequence, the design holder submitted that Article 8(1) was not applicable in the present case.
- 19 By judgment of 24 March 2021 (24/03/2021, T-515/19, *Building blocks from a toy building set*, EU:T:2021:155), the General Court annulled the decision R 31/2018-3 in its entirety and ordered the EUIPO and the invalidity applicant to bear their own costs and each to pay half of the costs incurred by the design

holder. The General Court's findings on the substance of the case may be summarised as follows:

(i) Infringement of Article 8(3) CDR (§ 23-86 of the judgment)

- 20 Concerning the design holder's first plea in law, the General Court first examined whether the benefit of Article 8(3) CDR could be relied on for the first time before the Board of Appeal. The General Court reasoned, in essence, that since neither CDR nor the rules of procedure of the Boards of Appeal specify the conditions for the application of Article 8(3) CDR it is not possible to consider that the design holder's reliance on that provision, raised for the first time before the Board of Appeal, was out of time.
- 21 In that regard, the General Court also recalled that according to Article 60(1) CDR, in deciding on the appeal against a decision of the Invalidity Division, the Board of Appeal may carry out a new, full examination of the merits of the application for a declaration of invalidity of the contested design, in terms of both law and fact. Consequently, the Board of Appeal has jurisdiction, *inter alia*, to rule on the claims of the design holder relating to the benefit of Article 8(3) CDR.
- 22 The General Court added that, in accordance with Article 59(2) CDR, in the examination of the appeal, the Board of Appeal invites the parties, as often as necessary, to file observations, within a period to be fixed by the Board of Appeal, on communications from the other parties or issued by itself. That provision is intended, *inter alia*, to apply where the proprietor of a contested design relies, for the first time before the Board of Appeal, on the benefit of Article 8(3) CDR.
- 23 Secondly, concerning the applicability of Article 8(3) CDR to the contested design, the General Court observed that there is a certain overlap between the features referred to in Article 8(1) and Article 8(2) CDR, with the result that the same feature of appearance of the product concerned by a design may be covered by the description of the features referred to in both Article 8(1) and in Article 8(2). They are features of appearance of the product concerned by a design permitting the connection of that product to another product for which that function is the only factor which determined their appearance.
- 24 It follows that, in order to preserve the effectiveness of Article 8(3), in the context of an application for a declaration of invalidity based on Article 25(1)(b) CDR, read in conjunction with Article 8(1), if the features of appearance of the product concerned by the contested design fall within both Article 8(1) and Article 8(2), and where the proprietor of the contested design relies on the benefit of Article 8(3), it must be examined whether those features are capable of benefiting from the protection of modular systems for the purposes of that latter provision, including when the applicant for a declaration of invalidity did not rely on Article 8(2) of that regulation. In fact, where the features of appearance of the product concerned by a design fall within both Article 8(1) and Article 8(2), the application of Article 8(3) cannot depend on the intention of the applicant for a declaration of invalidity to rely on one or other of those provisions.

- 25 Thus, in the light of all the foregoing considerations, the General Court concluded that the Board of Appeal had to assess whether the contested design met the requirements of Article 8(3) CDR. Since it failed to do so, it erred in law. Therefore, the contested decision must be annulled.
- 26 Under those circumstances, the General Court considered that there was no need to examine the third plea in law, alleging infringement of Article 62 CDR in that regard. By contrast, since it was not possible to prejudge the outcome of the examination of the conditions for the application of Article 8(3) CDR, the General Court considered it appropriate to continue the examination of the design holder's arguments alleging infringement of Article 8(1) of that regulation.

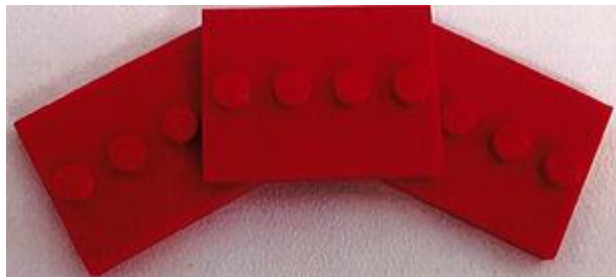
(ii) Infringement of Article 8(1) CDR (§ 87-115 of the judgment)

- 27 Concerning the design holder's second plea in law, the General Court recalled that if at least one of the features of appearance of the product covered by a contested design is not solely dictated by the technical function of that product, the design cannot be declared invalid under Article 8(1) CDR. The General Court further stressed that it is for the applicant for a declaration of invalidity to demonstrate and for the Office to find that all the features of appearance of the product covered by the contested design are solely dictated by the technical function of that product.
- 28 In that regard, the General Court considered that the smooth surface of the upper face of the toy brick is a feature of the specific appearance of the product concerned by the contested design and is not limited to a mere 'absence of studs on the upper surface of the brick'. It follows that the Board of Appeal had to take it into account. In spite of that, it was not included among the features identified by the Board of Appeal.
- 29 Therefore, the General Court concluded that the Board of Appeal infringed Article 8(1) CDR, in that it did not identify all the features of appearance of the product concerned by the contested design and, a fortiori, did not establish that all of those features were solely dictated by the technical function of that product.

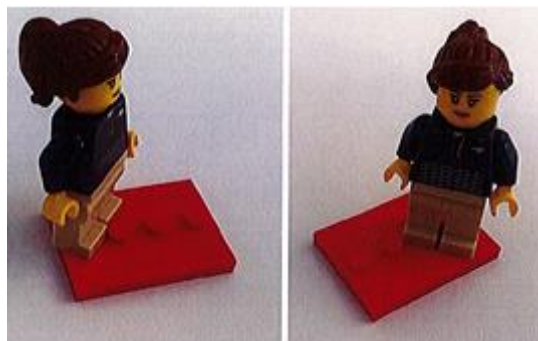
Observations in reply to the communication of the Rapporteur

- 30 On 2 December 2021, in view of the implications of the judgment of the General Court in case T-515/19 for the present proceedings, the Rapporteur invited the parties to submit their observations on 1) whether the contested design meets the requirements of Article 8(3) CDR; and 2) whether the smooth surface of the upper face of the toy brick is a feature that is solely dictated by the technical function of the product concerned, namely to allow assembly with, and disassembly from, the rest of the bricks of the set.
- 31 On 1 February 2022, the invalidity applicant submitted the following observations in reply to the communication of the Rapporteur:
- The invalidity applicant submits as 'Sample 1' ten original products in which the contested RCD is incorporated.

- The only question to be answered by the Board's new decision is whether the smooth surface to the right and left of the row of studs in the middle of the regarded bricks are solely technically conditioned in accordance with the provision of Article 8(1) CDR. This can be easily answered in the affirmative.
- In this regard, the invalidity applicant had already stated in its submission of 12 March 2018 that the smooth surface to the right and left of the centrally arranged row of studs serves special building structures, for instance when the 'classic' direction of assembling bricks is changed.
- The invalidity applicant provides further examples where 'the principles of allowing space for other bricks to be properly assembled to the product in which the design in question is incorporated' apply, taken from the 'Lego toy building set 75929 Jurassic World' and the 'Lego toy building set 75190 STAR WARS', the 'Lego toy building set 42073 TECHNIC'.
- Also, the smooth surfaces are needed to provide space on the bottom for a vault door to be installed on top.
- The principle of allowing space for other bricks to be properly assembled can also mean allowing space for other bricks to be properly moved. As already elaborated on by the EUIPO before the Court, the smooth surfaces are necessary to allow movability. For example, the absence of studs allows for two bricks to be twisted when connected by a single stud at the end of the row, thereby allowing to construe (mobile) bends, i.e. an axis, as shown below:



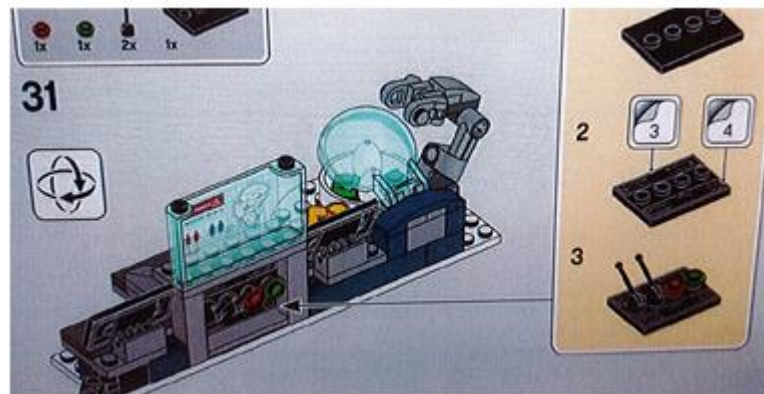
- In connection to this, when using the brick in question as presentation display for toy figures, the smooth surfaces are necessary for the figures to be moved to different angles in order to be presented interestingly and properly in different play situations, as shown below:



- Moreover, as also mentioned by the EUIPO before the Court, when studs are interlocked with the small areas adjacent to the longer side walls, steps can be built which are not obstructed by the studs, as shown below:



- Finally, only with the product in which the design in question is incorporated, a control desk can be built as shown below with stickers placed on the smooth surfaces:



- Therefore, all features of appearance of the contested RCD, including the smooth surface on either side of the row of four studs on the upper side, are solely dictated by technical function. This assessment is seamlessly consistent with the judgment of 14/09/2010, C-48/09 P, Legobrick, EU:C:2010:516.
- The contested RCD ‘exhausts itself in its technical function, as the smooth surfaces to the right and left of the centrally arranged row of studs are such functional features as other considerations, in particular those relating to the visual appearance of the product, clearly played no role’.
- It cannot be denied that even a solely technically-dictated design can have an aesthetic effect on the user and, therefore, also convey an aesthetic impression. However, even the aesthetics of a technical design do not justify protectability if and to the extent that they are exhausted in solely technically dictated design features, as in the case here.
- The design holder has not submitted anything that could have supported the assumption of design considerations.

- Article 8(3) CDR is not relevant in the present case, as it provides for a (reverse-)exception to Article 8(2) CDR, but it is not (also) intended for the exclusion under Article 8(1) CDR. This remains unchanged also in light of the judgment of the General Court of 24 March 2021, in which it is stated that there is an ‘overlap’ between the grounds for exclusion under Article 8(1) and 8(2) CDR. However, as reiterated by the Court, Article 8(2) CDR also applies if connecting elements, in addition to their technical function, could also be deemed to be an aesthetic design element.
 - Therefore, as a ‘precautionary remark’, the invalidity applicant points out that the contested RCD does not satisfy the requirements for protection under Article 8(3) CDR. This would require that the RCD at issue, irrespective of its intended purpose within a modular system, was new and had individual character at the time of its filing. Neither the one nor the other is the case here.
 - The actual interconnecting features of the contested RCD, i.e. the cylindrical studs and the respective negative spaces on the lower side of the brick, are clearly not new as they – identically – existed on a multitude of different Lego bricks decades before the filing date of the contested RCD.
 - Therefore, it is to be excluded that the informed user – be it a child or an adult – will consider the particular surface structure of the brick with the ‘legotypical’ studs in the middle of the brick as ‘creation’ according to Article 6 CDR. The exact opposite is correct.
- 32 On 2 February 2022, the design holder submitted the following observations in reply to the communication of the Rapporteur:
- The design holder fully endorses the Rapporteur’s understanding of the judgment of the General Court of 24 March 2021 expressed in the communication, in particular the summary of the legal conclusions of the Court in respect of Article 8(3) CDR as regards its systematic interpretation and its relationship with paragraphs 1 and 2 of that Article. This is very clear and accurately reflects the conclusions of the Court.
 - The contested RCD meets the requirements of Article 8(3) CDR in their entirety, as it concerns a construction toy element that serves the assembly with other such toy elements of the same or different shapes and proportions within the design holder’s modular construction toy system. Facts to illustrate this have been amply submitted by the invalidity applicant itself, and based on these, already the Invalidity Division correctly stated that, in any event, the contested RCD would be protected from invalidity based on functionality by Article 8(3) CDR.
 - The reference to Articles 5 and 6 CDR, contained in Article 8(3) CDR, is of a declaratory, or clarifying, nature. As Article 8(3) CDR reads ‘a Community design shall ... subsist in a design...’, it was thought necessary to insert the reference to the requirements of novelty and individual character to make sure those requirements remained untouched. This explains that the mention

of Articles 5 and 6 within Article 8(3) CDR obtains little to no attention in the legal writing on the provision.

- Articles 5 and 6 CDR are separate grounds for invalidity that have not been invoked or discussed in the context of the present proceedings. The onus of proof concerning these grounds is entirely on an invalidity applicant. In the absence of any facts or arguments referring to the absence of novelty or individual character of the contested RCD, there is no need for further considerations on these requirements.
 - On the question of whether the smooth surface of the upper face of the toy brick is a feature that is solely dictated by the technical function of the product concerned, namely, to allow assembly with, and disassembly from, the rest of the bricks of the set smooth surface is not solely dictated by function, it goes without saying that a smooth surface cannot technically ‘allow the assembly with’ other bricks. Moreover, given that smooth surfaces are not capable of being ‘assembled’ neither can they technically assist ‘disassembly’. Indeed, the smooth surfaces on either side of the central row of studs on the contested RCD serve no purposes other than visual and aesthetic.
- 33 On 11 February 2022, the design holder submitted that, if the Board were to consider that any of the new submissions filed by the invalidity applicant are relevant, the design holder wanted to have the possibility to be heard on them.
- 34 On 14 February 2022, the Rapporteur granted both parties a common deadline of one month to submit observations on the other party’s reply to the communication of the Rapporteur.
- 35 On 11 March 2022, the invalidity applicant submitted the following observations:
- Concerning the technical function of the smooth surfaces, the invalidity applicant refers to its previous submissions.
 - The exception in Article 8(3) CDR requires that the design in question must not only be a connecting part of a modular system, but as such must also meet the requirements of the provision in Articles 5 and 6 (novelty and individual character).
 - Article 8(3) CDR is an exception provision, on top of that an exception to the exception, which must be strictly measured by its wording and interpreted narrowly. The party invoking such an exception must also prove the factual requirements of the exception, in this case the novelty and individual character of the contested RCD, for which protection is sought contrary to the exclusion of protection under Article 8(1) and 8(2) CDR.
 - Only as a very ‘precautionary measure’ and despite the fact that the burden of proof is on the design holder, the invalidity applicant reiterates that the contested RCD is not new and has no individual character, as ‘the product in

which the contested design subsists is basically a combination of long existing LEGO bricks’.

- Furthermore, the invalidity applicant submits that the contested RCD is not protectable according to Article 4(2) CDR – which is applicable when assessing Article 8(3) CDR – since the contested design is ‘as good as invisible once incorporated into the complex product (i.e. the modular system)’.

36 On 15 March 2022, the design holder submitted the following observations:

- The invalidity applicant’s comments on the allegedly technical nature of the smooth surfaces on the upper face of the contested RCD miss the point. The invalidity applicant fails to submit any objective circumstances indicating that and how this feature and its proportions and position on the contested RCD were solely dictated by the technical function of the product. While musing about multiple possible ways in which the contested RCD can be incorporated in different structures using the LEGO construction toy system with a variety of different ‘results’ allegedly ‘achieved’ by the smooth surfaces, the invalidity applicant fails to indicate any specific technical function.
- It is not disputed that the contested RCD can be used in all the contexts mentioned by the invalidity applicant, and in many more. However, as per the ‘Doceram’ judgment (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 31 and 32), what matters in the context of Article 8(1) CDR is not whether a design or features thereof have a function, or multiple functions (which is presumably true for 99 % of all designs), but whether objective circumstances allow the conclusion that considerations related to the visual aspect ‘have not played any role’. The arbitrary mishmash of functions in part rehashed and in part introduced for the first time by the invalidity applicant does not do this in any way.
- The contested RCD was indeed developed with the ‘LEGO Minifigures’ in mind, namely, to provide a ‘standing plate’ for the ‘LEGO Minifigures’ series as shown here:



- The figurines could just as well have been mounted on plates with several parallel rows of studs. The smooth surfaces were developed with a view to the visual aspect of the ‘LEGO Minifigures’ standing (straight!) on the plates.
- In our view, this is clear-cut evidence that the contested RCD was not designed with a view to technical function but (even primarily!) with aesthetics in mind – which means that the contested RCD as a whole does not fall under Article 8(1) CDR.
- In any event, Article 8(3) CDR would shield the Design from being declared invalid.
- The invalidity applicant’s comments on pages 25-30 of its submission on Article 8(3) CDR amount to an attempt to ‘undo’ the General Court’s decision and ignore the Rapporteur’s correct understanding of that decision. The invalidity applicant’s interpretation would effectively render Article 8(3) CDR ineffective, which the General Court has said must be avoided.
- Moreover, the case-law referred to bears no relevance for the case at hand, and the allegation of a lack of novelty or individual character continues to be utterly unsubstantiated, apart from based on a misinterpretation of the reference in Article 8(3) CDR to Articles 5 and 6 CDR. This indeed refers to the design as a whole and not only to the must-fit features thereof.
- In particular, the invalidity applicant appears to think that the reference to Articles 5 and 6 CDR in Article 8(3) CDR means novelty and individual character of the interconnecting elements in isolation. This reading of the reference, however, is incorrect.
- If Article 8(3) CDR were indeed to be read as meaning that the interconnecting elements, which lead to Article 8(2) CDR applying in the first place, must be considered in isolation, the exception of Article 8(3) CDR would be rendered ineffective. This is because, in a modular system, which is what Article 8(3) CDR is all about, the whole idea is that the interconnecting elements remain the same even for subsequent designs of elements that fit into the modular system. Article 8(3) CDR could never apply because any and all interconnecting elements within modular systems would replicate the interconnecting elements from earlier elements from the same system, with which it must fit. Such a reading of Article 8(3) is counter-intuitive and – again – very much against the spirit of the interpretation as given by the General Court in the present case.

Reasons

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

Scope of the appeal proceedings

- 38 In accordance with Article 61(6) CDR, the Office shall take the necessary measures to comply with the judgment of the General Court. In that respect, the Board is not only bound by the order of the General Court, but also by the *ratio decidendi* of the judgment.
- 39 Since the General Court established that the exception provided in Article 8(3) CDR may be relied on not only for the benefit of features referred to in Article 8(2) CDR, but also for the benefit of those features that would simultaneously fall within Article 8(1) and Article 8(2) CDR, the Board is now called to assess whether the contested design meets the requirements of Article 8(3) CDR.
- 40 Moreover, the General Court stated that the smooth surface of the upper face of the toy brick is a feature that must be taken into account by the Board of Appeal when assessing whether all the features of the contested design are solely dictated by the technical function of the product concerned, namely, to allow assembly with, and disassembly from, the rest of the bricks of the set.
- 41 For reasons of procedural economy, the Board considers it appropriate to first examine the question of whether all the features of appearance of the product concerned by the contested RCD are solely dictated by the technical function of that product.
- 42 Indeed, as stated by the Court, if it were to be concluded that at least one of the features of the appearance of the product covered by a contested RCD is not solely dictated by the technical function of that product, the contested RCD could not be declared invalid under Article 8(1) CDR.
- 43 If, on the other hand, it were to be concluded that all the features of the appearance of the product concerned by the contested RCD are solely dictated by the technical function, then the Board would necessarily have to assess whether the contested RCD meets the requirements of Article 8(3) CDR, i.e. it must be examined whether those features are capable of benefiting from the protection of modular systems for the purposes of that latter provision.

The evidence submitted at the appeal stage

- 44 At the appeal stage, both parties have submitted additional evidence, most of which is incorporated in the body of the pleadings as images, hyperlinks, etc., except for the ‘Sample 1’ submitted by the invalidity applicant, consisting of ten original products in which the contested RCD is incorporated.
- 45 Pursuant to Article 63(2) CDR the Office may disregard facts or evidence which are not submitted in due time by the parties concerned. In stating that the Office ‘may’, in such a case, decide to disregard evidence, Article 63(2) CDR grants the Board a broad discretion to decide, while giving reasons for its decision in that regard, whether or not to take such evidence into account (14/03/2018, T-651/16, Crocs, EU:T:2018:137, § 32; 05/07/2017, T-306/16, Door handles,

EU:T:2017:466, § 16). In order for the belated evidence to be taken into consideration by the Board, it must be likely to be relevant for the outcome of the case and must not have been produced in due time for proper reasons, in particular where the evidence is merely supplementary to evidence already submitted or be filed to contest findings made in the contested decision, according to Article 108 CDR in conjunction with Article 27(4) EUTMDR.

- 46 In light of these principles, the Board deems it appropriate to take all the additional evidence filed on appeal into account. Firstly, because the new evidence has been submitted in response to an express invitation by the Rapporteur to the parties to submit their observations on 1) whether the contested design meets the requirements of Article 8(3) CDR; and 2) whether the smooth surface of the upper face of the toy brick is a feature that is solely dictated by the technical function of the product concerned, namely to allow assembly with, and disassembly from, the rest of the bricks of the set. Secondly, the evidence submitted appears *prima facie* to be relevant to the outcome of the case. Thirdly, the evidence was systematically notified to both parties who were given the opportunity to comment on it.
- 47 It follows that the applicable criteria for accepting the belated evidence submitted by both parties have been fulfilled. Therefore, it will be taken into account as being admissible by the Board.
- 48 Nevertheless, the Board stresses that the *prima facie* relevance of the evidence does not imply that it is conclusive for the outcome of the present case.

Article 25(1)(b) CDR, read in conjunction with Article 8(1) CDR

- 49 Article 25(1)(b) CDR provides that a Community design may be declared invalid only if it does not fulfil the requirements of Articles 4 to 9 CDR.
- 50 According to Article 8(1) CDR, a Community design may not subsist in features of appearance of a product which are solely dictated by its technical function.
- 51 In the light of Article 8(1) CDR, Recital 10 thereof states as follows:

‘Technological innovation should not be hampered by granting design protection to features dictated solely by a technical function. It is understood that this does not entail that a design must have an aesthetic quality. Likewise, the interoperability of products of different makes should not be hindered by extending protection to the design of mechanical fittings. Consequently, those features of a design which are excluded from protection for those reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection’.

- 52 In the ‘Doceram’ judgment (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172), the Court of Justice held that Article 8(1) CDR excluded protection, under the law on Community designs, for features of appearance of a product where considerations other than the need for that product to fulfil its technical function, in particular those related to the visual aspect, had not played

any role in the choice of those features, even if other designs fulfilling the same function exist.

- 53 The Court stated that, in order to determine whether the features of appearance of a product were exclusively dictated by its technical function, it had to be established that the technical function was the only factor which had determined those features, the existence of alternative designs not being decisive in that regard (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 32).
- 54 According to the Court, assessment as to whether the features of appearance of a product are covered by Article 8(1) CDR must be made having regard to all the objective circumstances relevant to each individual case. That assessment must be made, in particular, having regard to the design at issue, the objective circumstances indicative of the reasons which dictated the choice of features of appearance of the product concerned, or information on its use or the existence of alternative designs which fulfil the same technical function, provided that those circumstances, data, or information as to the existence of alternative designs are supported by reliable evidence (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, 36 and 37).
- 55 Furthermore, it is apparent from Article 8(1) CDR and the ‘Doceram’ judgment that the assessment of a design in the light of the above-mentioned provision comprises the following steps:
- it is necessary, in the first place, to determine the technical function of the product concerned;
 - in the second place, to analyse the features of appearance of that product within the meaning of Article 8(1) CDR; and,
 - in the third place, to examine, in the light of all the relevant objective circumstances, whether those features are solely dictated by the technical function of the product concerned.
- 56 In other words, it must be examined whether the need to fulfil that technical function is the only factor that determined the choice by the designer of those features, with considerations of another nature, in particular those related to the visual aspect of that product, having played no role in the choice of those features (26/01/2022, T-325/20, Water purifiers, EU:T:2022:23, § 31).
- 57 Lastly, in order to determine whether the relevant features of appearance of a product are solely dictated by its technical function, within the meaning of Article 8(1) CDR, the Court must take account of all the objective circumstances relevant to each individual case and, in that regard, there is no need to base those findings on the perception of an ‘objective observer’ (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 38).
- 58 In that regard, it must be noted that when an invalidity applicant refers to the ground of invalidity set out in Article 25(1)(b) CDR, it is for him or her to provide evidence to demonstrate that the contested design does not fulfil the

requirements of Articles 4 to 9 CDR (26/01/2022, T-325/20, Water purifiers, EU:T:2022:23, § 37).

59 In those circumstances, it is for the Board to examine the evidence adduced by the invalidity applicant and then to compare it, where appropriate, with the evidence to the contrary adduced by the design holder, and thus to assess the reliability of all the evidence provided by each party to the proceedings, in order to rule on whether the features of appearance of the product at issue are solely dictated by its technical function.

(i) Identification of the technical function of the product concerned

60 The views submitted by the design holder (see paragraph 1 above) and the indication of the product show that the contested RCD concerns a building block (or brick) from a toy building set.

61 The Board considers that the technical function of the building brick concerned by the contested RCD is to allow assembly with, and disassembly from, other bricks of the set.

62 The Board further observes that such a technical function is not challenged by the invalidity applicant and, moreover, was expressly recognised by the design holder (see paragraph 4.1 of the design holder's submissions of 2 February 2022).

(ii) Identification of the features of appearance of the product concerned

63 From the submissions of the parties, the judgment of the General Court in case T-515/19 and the Board's examination, the following seven features of appearance of the contested RCD are identified:

- (1) The row of studs on the upper face of the brick;
- (2) The row of smaller circles on the lower face of the brick;
- (3) The two rows of bigger circles on the lower face of the brick;
- (4) The rectangular shape of the brick;
- (5) The thickness of the walls of the brick;
- (6) The cylindrical shape of the studs;
- (7) The smooth surface of the upper face of the toy brick (T-515/19, § 107).

(iii) Assessment as to whether all the features of appearance of the product at issue are solely dictated by its technical function

64 Where the possibility of assembling the building brick concerned by the contested RCD with other building bricks of the set and dismantling them is the only factor

which determined all the seven features of appearance of the contested RCD, the latter necessarily fall within Article 8(1) CDR.

- 65 In the Board's view, the evidence filed by the invalidity applicant proves that all the features of appearance of the product at issue are solely dictated by its technical function, as will be explained hereunder.
- 66 The purpose of feature (1), which consists of a row of studs that protrude on the upper face of the brick, is to make it possible for the player to assemble a second brick of the set above the brick covered by the contested RCD in order to begin the construction of an object. As explained by the invalidity applicant in the statement of grounds of appeal – with the assistance of illustrations – the lower face of the second brick will engage upon the four studs on the upper face of the first brick and the two bricks will thus remain firmly in place, thus permitting to commence a toy construction. The row of studs thus represents a feature of appearance solely dictated by technical function, i.e. a feature where the technical function (being the necessity to assembly with, and disassembly from, other bricks of the set) is the only factor which determined that feature.
- 67 The design holder was unable to deny the technical function, as described above, of the studs and to explain to what extent 'other considerations' (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 31) played a role in the appearance of said studs.
- 68 Feature (2) consists of a row of smaller circles on the lower face of the brick. The circles represent, as the invalidity applicant has shown with an image of the real brick (see letter dated 27 March 2017, page 6), depressions. The depressions correspond in number (four) and position (alignment in the middle) to the studs visible on the upper face of the brick. The appearance of these small depressions is not the result of an intention to generate a particular visual aspect but is the consequence of the manufacturing process of the piece: in other words, the depressions in the lower face of the brick merely represent the 'negative', i.e. the counterpart, of the (protruding) studs on the upper face. The position and arrangement of the studs that protrude on the upper face of the brick condition the smaller circles on the lower side, in that they represent the indents caused by the protrusion of the studs.
- 69 The design holder could not explain which considerations other than technical function justified the presence, on the lower face of the brick, of small circular depressions that correspond, in number and position, to the studs on the upper face.
- 70 Feature (3), namely two rows of bigger circles on the lower face of the brick, also fulfils a purely technical function. The six circles represent, as the invalidity applicant has shown with an image of the real brick (see letter dated 27 March 2017, page 6), six slightly protruding circular walls. As the invalidity applicant has shown with images of superposed bricks at page 6 of its statement of grounds of invalidity, dated 27 March 2017, the six circular walls delimitate externally a total of twelve small areas (four along each of the two long sides of

the brick and four along its middle) which may host the twelve studs of another brick of the set.

- 71 The design holder could not explain which considerations other than technical function justified the presence of six circular walls placed in two rows of three that delimitate areas, on the lower face of the brick, inside which the studs of another brick can be lodged so that the two bricks can be firmly held in place. It is indeed difficult to recognise that any kind of visual considerations concerning had played a role in the designer's mind.
- 72 Feature (4), i.e. the rectangular shape of the brick, does not obey to considerations other than the need for it to fulfil a technical function, namely that it can be used to build the wall of, say, a toy house or an another object having a 90° angle.
- 73 The design holder has not given examples of other considerations, in particular related to the visual aspect, which could have determined a rectangular shape.
- 74 Feature (5) consists of the limited thickness of the brick's walls. The bigger or smaller thickness of a construction element fulfils no other function than that of increasing or reducing the height of the toy construction in which that element is inserted.
- 75 The design holder did not cite, as a reason for choosing that thickness, any consideration other than the need to fulfil the technical function that has just been mentioned.
- 76 Feature (6) concerns the shape of the studs protruding on the upper face of the brick. The shape is cylindrical. The invalidity applicant's position is that this shape serves the sole function of exactly matching the gaps of bricks of the toy construction set. This position is confirmed by what experts have declared in the 'Red Lego Brick Proceedings' (10 July 2006, R 856/2004-G, 3D SHAPE OF LEGO BRICK): 'the cylindrical connecting knobs [i.e. studs] with a smooth, continuous outer surface provide the best, most consistent clutch power for interlocking bricks together', because cylindrical shapes can be made 'more precisely'. The experts also pointed out that a 'cylindrical knob [i.e. stud]' allows greater versatility, since a second brick can be pivoted on it while still retaining acceptable clutch power (10 July 2006, R 856/2004-G, 3D SHAPE OF LEGO BRICK, § 49). The experts added that 'that the cylindrical knob [stud] has a greater versatility than the hexagonal knob [stud]' and that the circular stud of the typical Lego brick is a shape that provides good interconnection of one brick to another (10 July 2006, R 856/2004-G, 3D SHAPE OF LEGO BRICK, § 50).
- 77 The design holder did not cite as a reason for choosing the cylindrical shape for the studs any consideration other than the need to fulfil the technical function that has just been mentioned.
- 78 Feature (7) concerns the smooth surface of the upper face of the toy brick. The invalidity applicant's position is that the smooth surface to the right and left of the centrally arranged row of studs serves special building structures, which are explained through the following arguments and evidence:

- When the ‘classic’ direction of assembling bricks is changed, for example when assembling the product reversely, as the invalidity applicant shows with images at pages 8, 9 and 10 of its observations of 1 February 2022.
- In the example taken from the design holder’s ‘Lego toy building set 75929 Jurassic World’, the plant-like brick can only be connected with the product in which the contested RCD is incorporated ‘due to the lack of studs where the smooth surfaces are’, as the invalidity applicant shows with images at page 11 of its observations of 1 February 2022.
- In the example taken from the design holder’s ‘Lego toy building set 75190 STAR WARS’, the bricks shown under Nos 1, 2, 3 and 4 at page 12 of the invalidity applicant’s observations of 1 February 2022 can only connect with the product in which the contested RCD is incorporated ‘due to the smooth surface and no additional studs in the way’.
- In the example taken from the design holder’s ‘Lego toy building set 42073 TECHNIC’, the blue bricks shown at page 12 of the invalidity applicant’s observations of 1 February 2022 can be assembled only because the product in which the contested RCD is incorporated underneath ‘has smooth surfaces on the side and no additional studs’.
- The smooth surfaces are needed to provide space on the bottom for a vault door to be installed on top, as the invalidity applicant shows with images at pages 13 and 14 of its observations of 1 February 2022.
- The smooth surfaces are necessary to allow movability. For example, the absence of studs allows for two bricks to be twisted when connected by a single stud at the end of the row, as the invalidity applicant shows with images at page 14 of its observations of 1 February 2022.
- When using the brick in which the contested RCD is incorporated as presentation display for toy figures, the smooth surfaces are necessary for the figures to be moved to different angles in order to be presented interestingly and properly in different play situations, as the invalidity applicant shows with images at page 16 of its observations of 1 February 2022.
- When the studs are interlocked with the small areas adjacent to the longer side walls, steps can be built which are not obstructed by the studs, as the invalidity applicant shows with images at page 17 of its observations of 1 February 2022.
- Only with the product in which the design in question is incorporated, a control desk can be built as shown below with stickers placed on the smooth surfaces, as the invalidity applicant shows with images at page 18 of its observations of 1 February 2022.

- 79 The Board considers that the invalidity applicant submitted convincing explanations, supported by illustrations, as to how the smooth surface of the upper face of the toy brick is in fact technical in character as well. It was then for the design holder to prove that, on the contrary, non-technical considerations, ‘in particular considerations related to the visual aspect’ (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 31) had played a role in the choice of the mentioned features of appearance.
- 80 In this regard, the Board observes that, in order to dispute that the smooth surface on the upper side on the contested RCD is solely dictated by the technical function of the product concerned, the design holder relies, at first, on a mere argument of ‘pure logic’, namely, that ‘a smooth surface cannot technically “allow the assembly with” other bricks. Moreover, given that smooth surfaces are not capable of being “assembled”, neither can they technically assist “disassembly”’ (see paragraphs 12 to 14 of the design holder’s observations dated 2 February 2022).
- 81 Subsequently, in its observations dated 15 March 2022, the design holder argues that the ‘arbitrary mishmash of functions’, submitted by the invalidity applicant in an attempt to show the alleged technical function of the smooth surface, does not allow the conclusion that considerations related to the visual aspect ‘have not played any role’ in the appearance of such feature.
- 82 The design holder further argues that the contested RCD ‘was indeed developed with the LEGO Minifigures in mind, namely, to provide a “standing plate” for the LEGO Minifigures series’, as shown below:



- 83 The design holder submits that the figurines ‘could just as well have been mounted on plates with several parallel rows of studs. The smooth surfaces were developed with a view to the visual aspect of the Minifigures standing (straight!) on the plates’, which, according to the design holder, ‘is clear-cut evidence that the contested design was not designed with a view to technical function but (even primarily!) with aesthetics in mind’.
- 84 However, in the Board’s view, the design holder’s submissions cannot, in the absence of evidence to support it, suffice to establish that the feature of the

smooth surface of the upper face of the toy brick was chosen for anything other than the technical function of the product concerned.

- 85 In that regard, the characterisation of the contested RCD as a ‘standing plate’ for the LEGO Minifigures series by the design holder is a purely subjective claim and is not such as to reflect the objective circumstances indicative of the reasons that might have dictated the choice of the features of appearance of the product smooth surface of the upper face of the toy brick at issue. Incidentally, the Board notes that two of the studs in the upper face of the toy brick are still visible on either side of the ‘Minifigures’, so it is not clear what the desired aesthetic effect on the ‘standing plate’ would be.
- 86 Therefore, the design holder’s short explanations about the ‘original purpose’ of the contested RCD are insufficient to conclude that visual considerations played a role in the choice of the feature (7) of appearance of the product at issue and, in any event, are not such as to call into question the Board’s conclusion following the examination of the explanations and examples furnished by the invalidity applicant in relation to the technical function of the smooth surface of the upper face of the toy brick.
- 87 Since the design holder has failed to provide evidence capable of showing that considerations other than technical ones could have played a role in the choice of the smooth surface of the upper face of the toy brick, it must be concluded that feature (7) is solely dictated by the technical function of the product at issue.
- 88 It follows that all the features of appearance of the product in which the contested RCD is embodied, including the smooth surface of the upper face of the toy brick, are solely dictated by the technical function of the product, which is to allow assembly with, and disassembly from, the rest of the bricks of the set.
- 89 Consequently, the contested RCD necessarily fall within Article 8(1) CDR.

Article 8(2) CDR

- 90 Article 8(2) CDR provides that a Community design will not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function (‘features of interconnection’).
- 91 In the present case, since, in order to fulfil the function of assembly and disassembly of the product concerned by the RCD, the features of appearance of the contested design must be reproduced in the exact dimensions in order to permit their connection, they also fall within Article 8(2) CDR (24/03/2021, T-515/19, Building blocks from a toy building set, EU:T:2021:155, § 50).
- 92 It follows that all the features of appearance of the product concerned by the RCD fall within both Article 8(1) and Article 8(2) CDR, since they are both solely

dictated by the technical function of that product, namely, to allow the connection and disconnection of that product, and constitute features of interconnection.

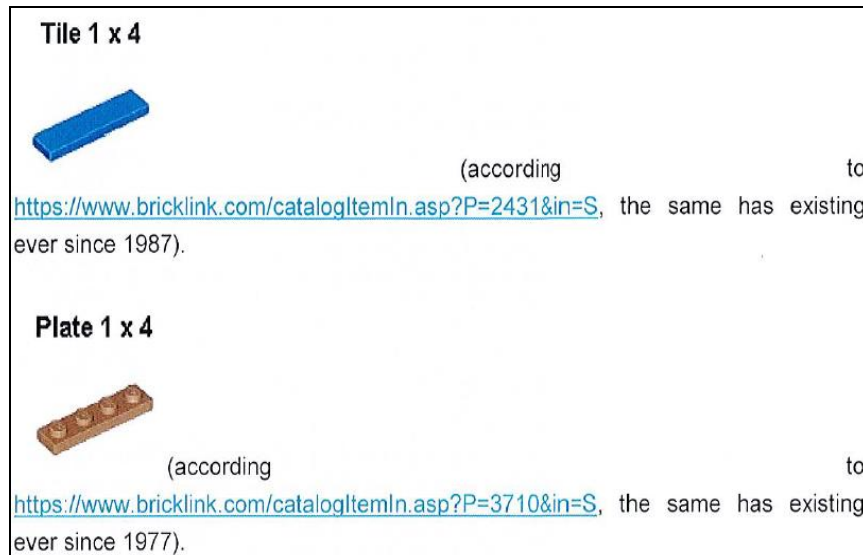
Article 8(3) CDR

- 93 According to Article 8(3) CDR, notwithstanding Article 8(2) CDR, a Community design must, under the conditions set out in Articles 5 and 6, subsist in a design serving the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system.
- 94 In this regard, the Court recalled that Article 8(3) CDR is the expression of Recital 11 CDR, according to which the mechanical fittings of modular products may nevertheless constitute an important element of the innovative characteristics of modular products and present a major marketing asset, and therefore should be eligible for protection (24/03/2021, T-515/19, Building blocks from a toy building set, EU:T:2021:155, § 31).
- 95 As stated by the General Court in case T-515/19, in order to preserve the effectiveness of Article 8(3) CDR, in the context of an application for a declaration of invalidity based on Article 25(1)(b) CDR, read in conjunction with Article 8(1), if the features of appearance of the product concerned by the contested design fall within both Article 8(1) and Article 8(2), and where the proprietor of the contested design relies on the benefit of Article 8(3), it must be examined whether those features are capable of benefiting from the protection of modular systems for the purposes of that latter provision, including when the applicant for a declaration of invalidity did not rely on Article 8(2) of that Regulation (24/03/2021, T-515/19, Building blocks from a toy building set, EU:T:2021:155, § 80).
- 96 In fact, where the features of appearance of the product concerned by a design fall within both Article 8(1) and Article 8(2), the application of Article 8(3) cannot depend on the intention of the applicant for a declaration of invalidity to rely on one or other of those provisions (24/03/2021, T-515/19, Building blocks from a toy building set, EU:T:2021:155, § 81).
- 97 Considering the above, and in view of the General Court's reasoning in case T-515/19, the Board must now assess whether the RCD meets the requirements of Article 8(3) CDR, i.e. whether the contested design can benefit of the exception protecting modular systems.
- 98 In this regard, the Board observes that the wording of Article 8(3) CDR makes it clear that, for a design to benefit from the exception protecting modular systems, in addition to meeting the requirements of Articles 5 and 6 RCD (i.e. novelty and individual character), it must serve the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system.
- 99 The Board agrees with the invalidity applicant that it is up to the design holder, who invokes the exception, to prove that the RCD serves the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system.

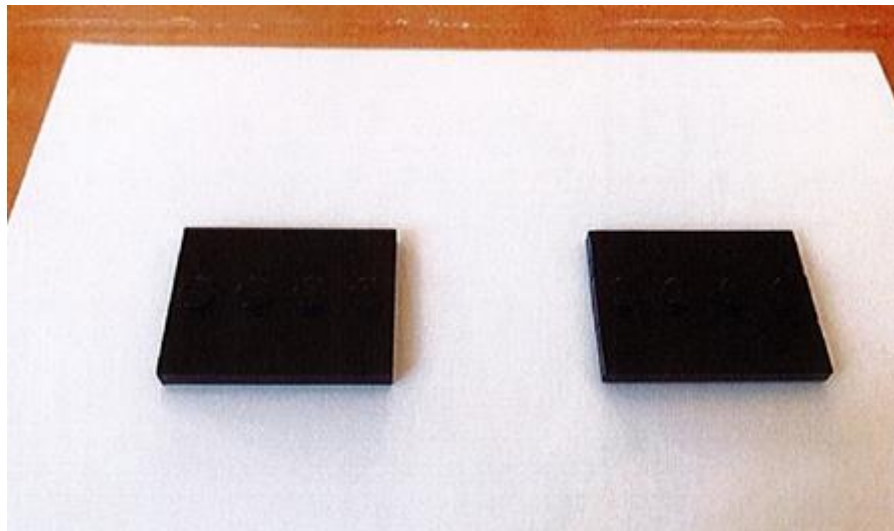
- 100 In this regard, the Board observes that, in the contested decision, the Invalidity Division, without having assessed the conditions for the application of Article 8(2) and Article 8(3) CDR, found that the product covered by the contested RCD constituted indeed an element of a modular system.
- 101 The Board further observes that, in its submissions of 8 May 2018, the design holder cited the findings of the Invalidity Division and expressly relied on the benefit of Article 8(3) CDR, stating that a) ‘the designs at issue are the quintessential parts of modular systems as addressed in Article 8(3) CDR’; b) Article 8(3) CDR ‘protects the parts of the modular system and not the modular system as such’; c) the design holder’s ‘modular toy system is the “archetypal example” of a modular system privileged by Article 8(2) CDR’; and that d) ‘any features of the design at issue that serve exclusively to allow the interoperability of products within a modular system cannot be regarded as falling under Article 8(2) CDR because they are privileged by Article 8(3)’.
- 102 Moreover, in its submissions of 2 February 2022, the design holder stressed that the invalidity applicant ‘extensively argued, and the Board in its previous composition endorsed this, that the contested design was of a purely technical nature, derived from the ability of the protrusions and indents on the upper and lower sides, respectively, to enable the assembly with other construction toy elements’ within the design holder’s system. According to the design holder, ‘this in itself means that it falls within the definition of designs that serve the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system’. The design holder added that ‘it is not for nothing that the primary example given in legal doctrine for modular systems within the meaning of Article 8(3) CDR is the LEGO construction toy system’ (for references see Section B.7 of the design holder’s response to the appeal no. R0031/2018-3 of 8 May 2018) and concluded that it is indeed correct that the contested RCD ‘concerns a construction toy element that serves the assembly with other such toy elements of the same or different shapes and proportions’ within the design holder’s modular construction toy system. The design holder pointed out that facts to illustrate this have been amply submitted by the invalidity applicant itself, and based on these, already the Invalidity Division correctly stated that, in any event, the RCD would be protected from invalidity based on functionality by Article 8(3) CDR.
- 103 Finally, in its submissions of 15 March 2022, the design holder drew the Board’s attention to the fact that the invalidity applicant ‘does not indeed question that the design at issue is caught by Article 8(3) CDR as it is part of a modular system’.
- 104 The Board agrees with the Invalidity Division and the design holder that the contested RCD subsists in a design serving the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system, within the meaning of Article 8(3) CDR. In fact, the Board notes that the contested RCD concerns a building block (or brick) from a toy building set, which can be assembled with, and disassembled from, other bricks of the set in different ways to build numerous varying creations.

- 105 Furthermore, the Board recalls that, as the design holder rightly points out, the provision of Article 8(3) CDR is informally known in the doctrine as the ‘LEGO clause’ or ‘LEGO exemption’, precisely because LEGO bricks are probably the best-known example of such a modular system. This is reflected, for example, in the article published by Prof. Annette Kur, cited by both the invalidity applicant and the design holder (Annette Kur, GRUR 2002, 661, at page 664, Section 1(c)(bb)).
- 106 Incidentally, the Board further observes that, in the ‘Basic questions’ section of the EUIPO website <https://euipo.europa.eu/ohimportal/en/cd-general-questions#1.8> (accessed 17 May 2022), to the question ‘What is a modular system whose protection may be sought under Article 8(3) of the Community design regulation?’, the answer is as follows: ‘A modular system is a number of items that are designed to be connected in a number of ways. A typical example would be building blocks or tiles for children. This notion is also of particular relevance to the furniture industry as it includes items such as desks and tables, which may consist of a number of smaller tables that can be assembled in alternative configurations’ (emphasis added).
- 107 Once it has been confirmed that the contested RCD subsists in a design serving the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system, within the meaning of Article 8(3) CDR, it must be assessed whether the other two conditions mentioned in Article 8(3), i.e. the novelty (Articles 5 CDR) and the individual character (Articles 6 CDR) of the contested RCD are fulfilled. In this regard, as stated above under paragraph 94, the Court recalled that Article 8(3) CDR is the expression of Recital 11 CDR, according to which interconnecting fittings which mean and bring innovation in a given industry should be eligible for protection.
- 108 In this respect, the Board cannot share the invalidity applicant's view that the design holder would have the burden of proving also the fulfilment of the conditions of Articles 5 and 6 CDR (i.e. novelty and individual character) in the context of Article 8(3) CDR.
- 109 In fact, challenging the validity of a Community design on account of its lack of novelty or of individual character requires proof that an earlier design that is identical or that produces a similar overall impression has been made available to the public before the filing (or priority) date of the contested RCD.
- 110 The required disclosure of the earlier design is preliminary to deciding whether the two designs are identical or produce the same overall impression on the informed user.
- 111 The Board considers that the exact identification of the earlier design and the event of its disclosure must necessarily be proven by the invalidity applicant, irrespective of whether the lack of novelty and individual character of the contested RCD have been invoked by the invalidity applicant as ‘independent grounds’ for a declaration of invalidity or, as in this case, these requirements must be assessed within the scope of Article 8(3) CDR.

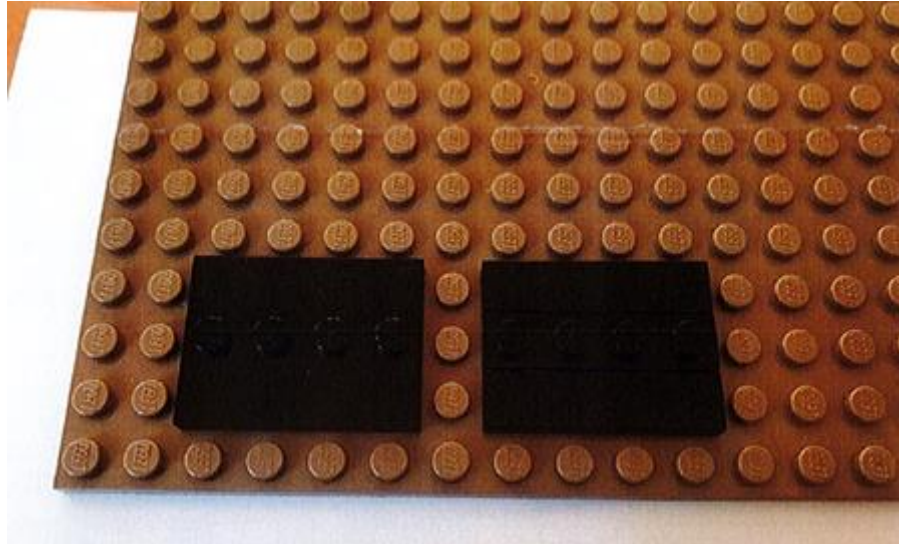
- 112 To argue otherwise would mean imposing a *probatio diabolica* on the design holder, consisting of assessing the novelty and individual character of the contested RCD design in comparison to the entire existing state of the art at the relevant date.
- 113 Pursuant to Article 7(1) CDR, for the purposes of applying Article 5 or Article 6 CDR, a design is to be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, before the filing date or, as the case may be, the priority date of the contested RCD, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union. The disclosure cannot be proved by means of probabilities or suppositions but must be demonstrated by solid and objective evidence.
- 114 The provisions of the CDR and the CDIR do not specify the kind of evidence the invalidity applicant is required to furnish in order to prove the disclosure of the prior design. It follows that, on the one hand, the invalidity applicant is free to choose the evidence it considers useful to submit in support of its application for a declaration of invalidity and that, on the other, the Board is required to examine all evidence submitted in order to establish if there is sufficient proof of a prior disclosure (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 23).
- 115 However, the Office is not required to determine through assumptions and deductions which earlier designs among those represented in the invalidity applicant's documentary evidence may be relevant where the invalidity applicant does not provide further specifications in this respect.
- 116 The Board notes that it is not clear from the invalidity applicant's submissions which are the earlier designs in respect of which the novelty and individual character of the contested RCD should be assessed, nor are the circumstances of the disclosure of those earlier designs clarified.
- 117 In particular, the Board observes that, in its submissions of 1 February 2022, the invalidity applicant argues that the actual interconnecting features of the contested RCD, 'i.e. the cylindrical studs and the respective negative spaces on the lower side of the brick, are clearly not new as they have – identically – existed on a multitude of different Lego bricks decades before the filing date' of the contested RCD. However, the invalidity applicant does not clearly identify any of the alleged earlier designs, nor does it mention the date or circumstances of their disclosure.
- 118 The Board further observes that, in its submissions of 11 March 2022, the invalidity applicant specifies that the contested RCD 'would not be new and/or of whatsoever individual character for the following reasons':
- The product in which the contested design subsists is basically a combination of long existing LEGO brick, i.e.:



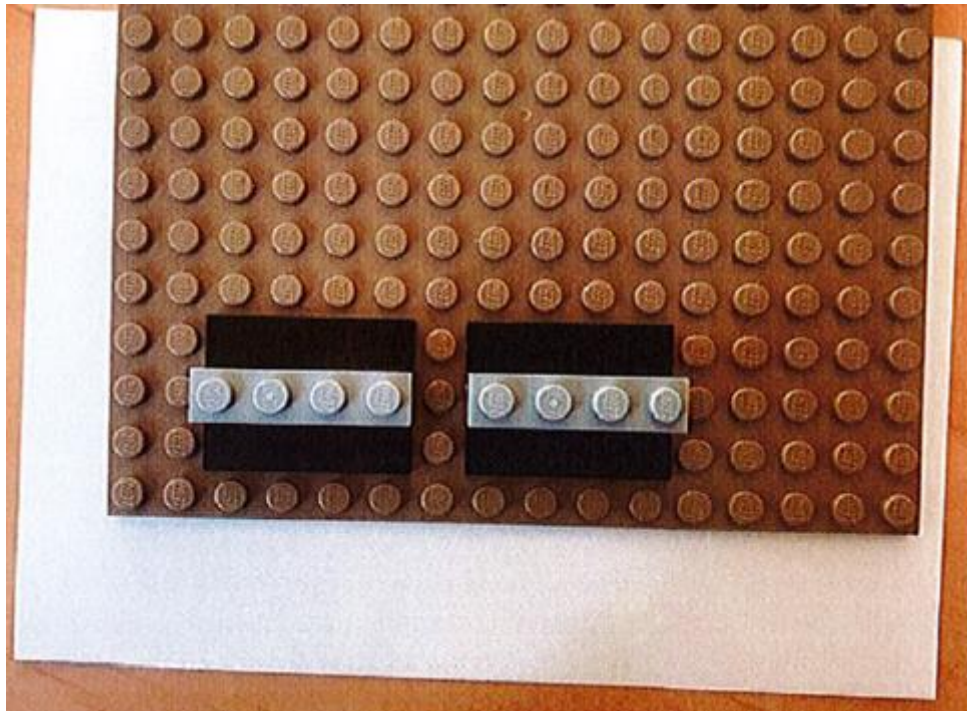
- ‘There is nothing new and/or of individual character when it comes to the contested design as shall be demonstrated by the following depictions (on the left respectively the product in which the contested design subsists, on the right respectively the earlier designs). On the first depiction below, the product in which the contested design subsists can be seen on the left. On the right, the products incorporating the earlier designs (plates 1x4 as mentioned above) are combined in very standard way mimicking the product in which the contested design subsists. There are no differences between both examples’.

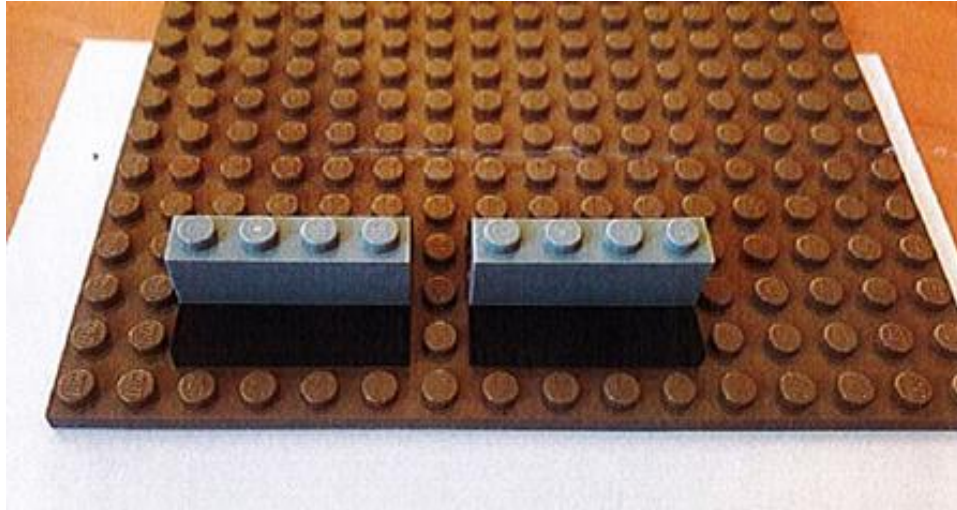


- ‘On the next depiction, the product in which the contested design subsists as well as the products incorporating the earlier designs are assembled to a bigger plate as one would do when starting to build something out of LEGO bricks’.



- ‘On the next two depiction below, a further brick is assembled on top of the product in which the contested design subsists as well as the products incorporating the earlier designs. The depicted assembly is a very standard way to assemble LEGO bricks starting to build e.g. a wall of a house, a low boundary or a fence. Again, there are absolutely no differences detectable’.





- 119 Regardless of the quality of the representation of the earlier designs, the Board notes that the evidence of disclosure of the earlier designs invoked and submitted by the invalidity applicant consists of a) two URL addresses corresponding to sections of the www.bricklink.com website, accompanied by two images of building bricks and the statement, added by the invalidity applicant next to the URL address, that those bricks have been in existence since 1987 and 1977 respectively; and b) some undated images.
- 120 Concerning the URL addresses, the Board recalls that URL addresses or hyperlinks per se cannot be considered as sufficient evidence for proving the disclosure of a prior design, as the Office is not required to examine on its own motion the links indicated by the parties in order to retrieve the information mentioned in their observations. They should be supplemented with additional evidence, such as a printout or a screenshot of the relevant information contained therein. This is because the information accessible through a hyperlink or URL address might be later altered or removed and, therefore, may not show the content that was available for the public before the date of filing or priority of the contested design. Moreover, it might be difficult to identify the relevant information, such as the specific prior design to which the invalidity applicant refers, the date of disclosure, etc. (08/12/2021, T-294/20, Kaas keys as a service, EU:T:2021:867, § 23; 30/06/2021, R1856/2020-3, Bowls, § 23).
- 121 The Board points out that this approach is in line with the so-called ‘CP10 Common Practice - Criteria for assessing disclosure of designs on the internet’ (Section 2.4.4, p. 29) and ‘CP12 Common Practice - Evidence in trade mark appeal proceedings: filing, structure and presentation of evidence, and the treatment of confidential evidence’ (Section 3.1.2.8, p. 14), established by the IP offices of the European Union in the framework of the European Union Trade Mark and Design Network, with the purpose of offering guidance on the sources, reliability, presentation and assessment of online evidence.
- 122 Therefore, with regard to this evidence, the Board considers that it is insufficient in itself to prove the disclosure of the prior design within the meaning of Article 7(1) CDR.

- 123 In relation to the other examples of allegedly earlier designs, the Board notes they consist of undated images. It is unclear whether, how, and under which circumstances the building bricks shown in the images were made available to the public. Without further supporting evidence, the images in question do not suffice to show that the prior designs depicted therein have become available to the public before the filing date of the contested RCD. Thus, it is not possible, without entering into a presumption, to determine whether, how, and under which circumstances the earlier designs shown in the picture have become publicly available. No corroborating evidence was presented in this regard. Mere statements from the invalidity applicant cannot constitute concrete evidentiary material.
- 124 In particular, the invalidity applicant's general statement that 'the product in which the contested design subsists is basically a combination of long existing LEGO bricks' cannot be followed by the Board, as the Court held that 'in order for a design to be considered to have individual character, the overall impression which that design produces on the informed user must be different from that produced on such a user not by a combination of features taken in isolation and drawn from a number of earlier designs, but by one or more earlier designs, taken individually' (19/06/2014, C-345/13, Karen Millen Fashions, EU:C:2014:2013, § 35).
- 125 As mentioned above, in accordance with the case-law (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 24), disclosure cannot be proven by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient disclosure of the earlier design. In view of the explanation above, the Board must come to the conclusion that the documents taken into account in the present case do not meet these requirements.
- 126 It follows that the evidence submitted cannot establish beyond any doubt that the prior designs submitted by the invalidity applicant had been made available to the public before the filing date of the contested RCD, pursuant to Article 7(1) CDR.
- 127 Given that disclosure in accordance with Article 7 CDR is a prerequisite for applying Articles 5 and 6 CDR, there is no need to further assess the alleged lack of novelty or individual character.
- 128 The Board points out that, by Communication of the Rapporteur of 2 December 2021, both parties were invited to submit their observations on, inter alia, 'whether the contested design meets the requirements of Article 8(3) CDR', in the light of the judgment of the General Court in case T-515/19. Furthermore, on 14 February 2022, the Rapporteur granted both parties a common deadline of one month to submit observations on the other party's reply to the Communication of the Rapporteur.
- 129 Therefore, both parties had ample opportunity to argue both on a) whether the design serves the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system; and b) whether it meets the requirements of Articles 5 and 6 RCD (i.e. novelty and individual character).

- 130 However, while the design holder has managed to convince this Board that the contested RCD subsists in a design serving the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system, within the meaning of Article 8(3) CDR, the invalidity applicant has considered it appropriate to argue relatively to the lack of novelty and individual character of the contested RCD only as a ‘precautionary remark’ and, as mentioned above, has failed to prove the disclosure of the alleged earlier designs.
- 131 Given that Article 7 CDR lays down that disclosure is a prerequisite for applying Articles 5 and 6 CDR, it must be concluded that the invalidity applicant has not established that the contested RCD lacks novelty and individual character.
- 132 Therefore, the Board concludes that the contested RCD benefits from the exception protecting modular systems referred to in Article 8(3), as in addition to meeting the requirements of Articles 5 and 6 RCD (i.e. novelty and individual character), it serves the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system.

Visible features of the component part during normal use

- 133 The Board observes that, in the last round of observations in reply to the communication of the Rapporteur, the invalidity applicant submits that the contested RCD is not protectable according to Article 4(2) CDR – which is applicable when assessing Article 8(3) CDR – since the contested design is ‘as good as invisible once incorporated into the complex product (i.e. the modular system)’.
- 134 For reasons of procedural economy, the Board considers it unnecessary to address the difference between a modular product and a complex product, as well as the procedural moment at which the invalidity applicant invokes this ground and its applicability under Article 8(3) CDR. Indeed, for the reasons set out below, the conditions for the application of Article 4(2) CDR are not met in the present case.
- 135 The invalidity applicant claims that ‘nothing remains visible once the product in which the contested design subsists has been incorporated’. However, the invalidity applicant’s arguments are to be rejected as unfounded.
- 136 Contrary to the invalidity applicant’s assertions, the Board considers that the contested RCD remains fully visible during much of its normal use, as the player will closely consider the design of the toy brick in question, from all angles, precisely to decide how and where to assemble it with the other bricks of the toy building set.
- 137 In this regard, the Board recalls that neither the wording of Article 4(2) CDR nor its purpose, namely, to exclude from design protection features that are not visible once the component part is mounted and the complex product used, support the claim that the features must be visible at all times during such normal use. In fact, the interpretation that Article 4(2) CDR would mandate for the component part corresponding to the contested RCD to remain visible in its entirety is rebutted by Recital 12 of the CDR, which expressly states that ‘protection should not be

extended to those component parts which are not visible during normal use of a product, nor to those features of such part which are not visible when the part is mounted' (emphasis added).

On the measures of instruction: the request to appoint an expert

- 138 The invalidity applicant requested the appointment of an expert because the validity of the contested RCD depends on its technical content and the Board might not have the necessary expertise in order to render an informed decision.
- 139 The Board considers the appointment of an independent expert unnecessary for the purpose of rendering the present decision because it has already been established that all the features of appearance of the product at issue are solely dictated by its technical function, which is the best scenario for the invalidity applicant.

Conclusion

- 140 The facts and evidence submitted by the invalidity applicant do not support the invalidity of the contested RCD, which benefits from the exception protecting modular systems referred to in Article 8(3).
- 141 Therefore, the appeal is dismissed and the application for a declaration of invalidity of the RCD is rejected.

Costs

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

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the invalidity applicant to bear the costs incurred by the design holder.**

Signed

G. Humphreys

Signed

S. Rizzo

Signed

E. Fink

Registrar:

Signed

H. Dijkema

