

INVALIDITY No ICD 10 545

Delta Sport Handelskontor GmbH, Wragekamp 6, 22397 Hamburg, Germany (applicant), represented by **Klawitter Neben Plath Zintler KNPZ Rechtsanwälte**, Kaiser-Wilhelm-Strasse 9, 20355 Hamburg, Germany (professional representative)

a g a i n s t

Lego A/S, Aastvej 1, 7190 Billund, Denmark (holder), represented by **Guardian IP Consulting**, Diplomvej, Building 381, 2800 Kgs. Lyngby, Denmark (professional representative).

On 30/10/2017, the Invalidation Division takes the following

DECISION

1. The application for a declaration of invalidity of registered Community design No 001664368-0006 is rejected.
2. The applicant bears the holder's costs, fixed at EUR 400.

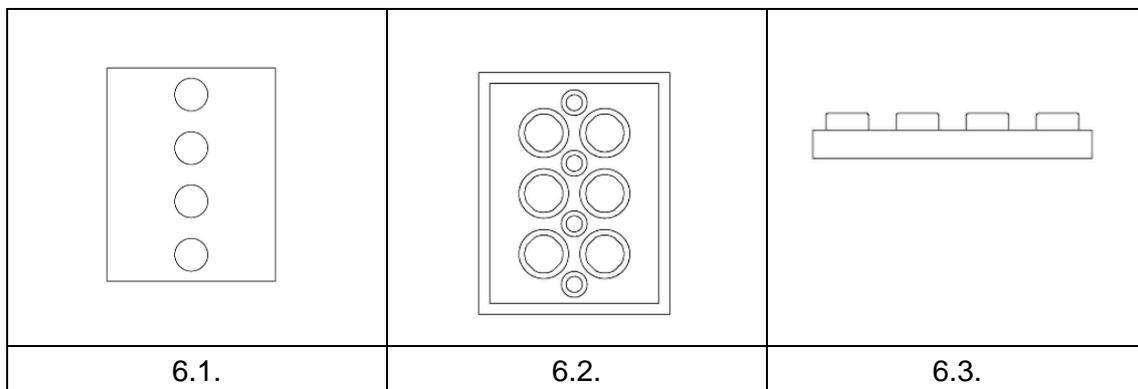
REASONS

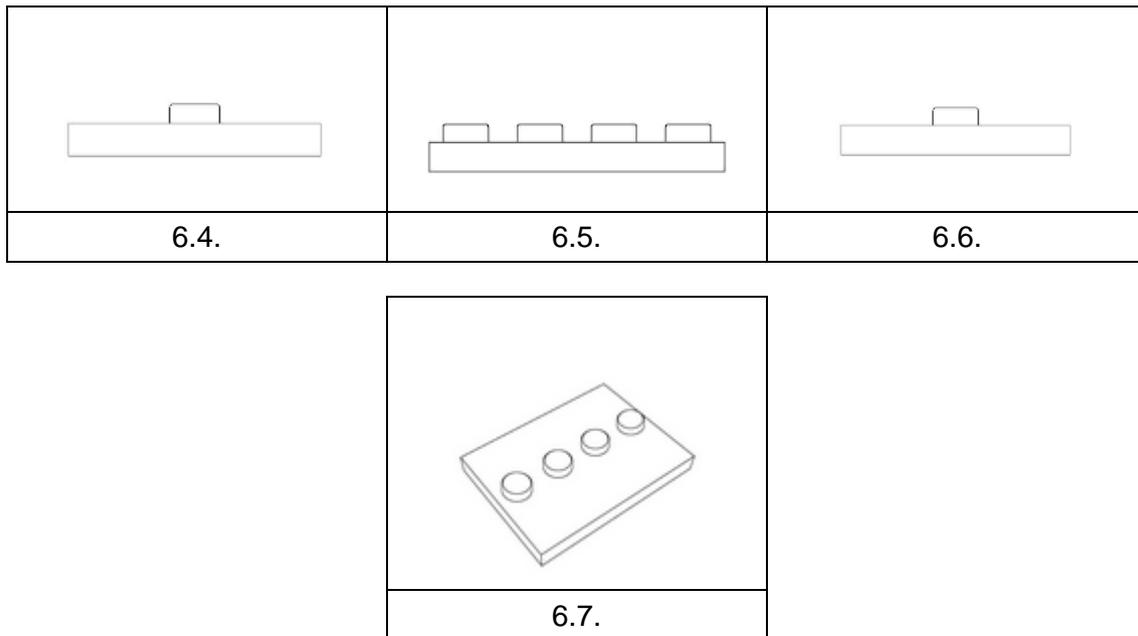
The applicant filed an application for a declaration of invalidity (the application) against Community design No 001664368-0006 (the RCD). The RCD was filed and registered in the holder's name on 02/02/2010.

The following products are indicated in the registration:

21-01 *Building blocks from a toy building set.*

The registration contains the following images:





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

The applicant invoked Article 25(1)(b) CDR in conjunction with Article 8(1) CDR.

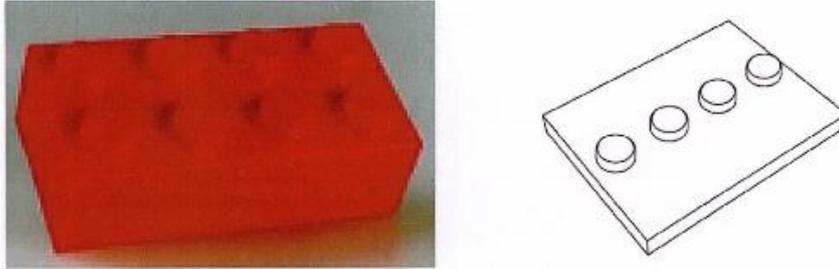
SUMMARY OF THE PARTIES' ARGUMENTS

The applicant argued that the 'LEGO' brick would appear to consist almost entirely of a functional and utilitarian shape which achieves a technical result. The applicant referred to the decisions of national courts, the EUIPO and the CJEU, in particular to the 'Red LEGO Brick' judgment (14/09/2010, C-48/09 P, Lego brick, EU:C:2010:516), denying trade mark protection of shapes that merely incorporate a technical solution.

It further cited a decision of the Grand Board of Appeal of 10/07/2006, R 856/2004-G-3D 'FORM OF A LEGO BLOCK' (3D) analysing the Lego trade mark and stating that 'the Lego brick's features were adopted to perform the above utilitarian function of the Lego brick, and not for identification purposes in the trade mark sense', as well as stating that 'the Lego brick is wholly functional since there is nothing arbitrary nor ornamental present in it. The "eye appeal" that the Proprietor speaks of, merely stems from the aesthetics of a sound structural and functional form' and that 'the essential characteristics of the shape ...are attributable solely to the technical result'.

The applicant further cited a cancellation decision (not identified), stating, inter alia, that 'each of the elements of the shape of the mark as a whole, is necessary to obtain a result' and that 'the relative proportions of the brick are determined by the power needed for assembly and disassembly', as well as that 'all the various elements of the shape of which the Lego brick consists, namely the studs, their number, their diameter, their height, their symmetrical placement on the upper side of the brick, the height, width and length of the brick itself, are all essential for the result achieved, and are all necessary to achieve it.'

Finally, the applicant compared the following toy brick and the contested design and claimed they are similar and there is no significant difference regarding the technical functions of these two bricks:



Consequently, the applicant concluded, both bricks are toy bricks simply performing interlocking functions with other toy bricks. Neither the cupped studs nor the slight indentations change anything about this assessment, because each of those elements is designed to perform the technical function of a product. If a toy brick element of an exactly the same size and function is to be inserted into the contested holder's system, it must inevitably be of exact the same size and arrangement in order to offer the necessary grip. The grip studs do not perform any aesthetic function either, concludes the applicant, as they are not visible while connected to another toy.

In reply to the applicants claims the RCD holder stated that a feature is not deemed to be solely dictated by its technical function where the designer still had some degree of freedom in the creation of the feature (decision of the Boards of Appeal of 17/09/2013, R 2081/2011-3), which was the case in the contested RCD.

As regards the size of the toy bricks, the RCD holder noted that any toy brick, as well as the contested RCD; may be used for many different purposes when assembled with other bricks of a toy of a construction set. The designer is not limited to the designing of elements for a specific purpose of functionality. Moreover, bricks could be 'reversely' mounted.

In relation to the coupling flanges, the RCD holder noted that the peripheral flange can be shaped in many different ways and still have the same functionality. Finally, the RCD holder claimed, the case-law submitted by the applicant referred to trade marks and, therefore, should not be applicable to designs.

ARTICLE 25(1)(b) CDR IN CONJUNCTION WITH ARTICLE 4 AND ARTICLE 8 CDR

a) Features solely dictated by their technical function pursuant to Article 8(1) CDR

Article 8(1) CDR denies protection to those features of a product's appearance that were chosen exclusively for the purpose of allowing a product to perform its function, as opposed to features that were chosen, at least to some degree, for the purpose of enhancing the product's appearance.

Aesthetic considerations are, in principle, only relevant when the designer is developing the product's appearance. Most of the time, the designer will be concerned with both elements of good design: functionality and visual appeal. It is only when aesthetic considerations are completely irrelevant that the features of the design are solely dictated by the need to achieve a technical solution (decision of 22/10/2009, R 690/2007-3, Chaff cutters, § 35 et seq.).

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. 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 (decision of 29/04/2010, R 211/2008-3, Fluid distribution equipment, § 36).

In order to determine whether the essential features of the appearance of the product into which the contested Community design will be incorporated are solely dictated by the technical function of the product, it is first necessary to determine what the technical function of that product is. The relevant indication in the application for registration of the design (Article 36(2) CDR) should be taken into account, but also, where necessary, the design itself, insofar as it makes clear the nature of the product, its intended purpose or its function (judgment of 18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 56).

Whether Article 8(1) CDR applies must be assessed objectively, not in the perception of the informed user, nowhere mentioned in relation to the particular case regulated by Article 8(1) CDR, who may have limited knowledge of technical matters.

In the present case the contested RCD relates to a building block from a toy building set. Its essential function is to be interconnected with other building blocks for the purpose of playing and building various objects.

The essential visual characteristics of the contested RCD are the following:

- the flat rectangular shape of the building block;
- the cylindrical shape of the studs on the upper side;
- the number of the studs: four;
- the arrangement of the studs: one row of four, equally distanced from each other and placed in the central part of the brick;
- the hollow on the bottom of the brick and the corresponding coupling flanges with six rounded elements, stretching through the centre of the brick.

It must be considered if these essential features are determined by technical function only, and not the aesthetic considerations. Moreover, these essential features should be features of appearance.

Furthermore, in order to determine whether the features of appearance of a product are solely dictated by its technical function, it should be established that obtaining a certain technical function is the sole factor that dictated the choice of the design concerned and that no creative role was therefore played by its designer in this regard (opinion of 19/10/2017, C-395/16, DOCERAM, EU:C:2017:779, § 47).

In the Invalidity Divisions' view, the applicant did not prove that obtaining a certain technical function, namely the connection of a building block from a toy building set with the other building blocks, was the sole factor that dictated the choice of the design concerned.

The creation of the essential features of this design as mentioned above shows important features of appearance, for instance the shape or form of the building block itself or its studs could all show the creativity of a designer.

Furthermore, the Invalidity Division is of the opinion that the function of a building block is to be connected with other building blocks for the purpose of the creation of a final toy e.g. a toy building); these building blocks, being elements of modular systems, contribute to the appearance and aesthetics of the final creation. Therefore, it is

possible, and not denied by the applicant, that in the development of the toy bricks their appearance was taken into account.

Consequently, the Invalidity Division notes that the applicant did not prove by the relevant evidence (e.g. patent) that there existed no creative contribution on the part of the designer in creating the contested RCD.

Given that the burden of proof is on the applicant, the claim of invalidity based on Article 8(1) CDR, must be refused.

Therefore, the Invalidity Division cannot agree with the applicant's statement that all the essential elements of the contested RCD are determined by its technical function only. The function of interconnection between building bricks for the purpose of playing can be achieved through using building bricks of various shapes and dimensions whose features are equally dictated by both technical and aesthetic functions.

Furthermore, according to the applicant, the designer's freedom is limited to the extent that the elements of a building set must be able to be interconnected. As to interoperability of products, Article 8(2) CDR excludes from protection a Community design subsisting in features of appearance of a product that must necessarily be reproduced in their exact form and dimensions 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. Community design law therefore forbids granting a monopoly to the appearance of those products or their features that would prevent another from interconnecting with them. Article 8(3) CDR, however, excludes from this provision those products that serve the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system. As toy building sets meet the definition of such modular systems, the limitation of protection for the sole reason of their interoperability does not apply. In other words, the intention of the legislator is to provide full protection for designs of modular systems.

The Invalidity Division therefore does not accept the applicant's argument that the designer's freedom in developing elements of a toy building set is substantially limited by the interoperability of the elements. The applicant did not even demonstrate which particular features or parts of the product are supposed to be so affected.

The applicant refers to the findings in the decisions of national courts, cancellation and BoA decisions of the EUIPO, as well as the 'RED LEGO BRICK' judgment of the CJEU (C-48/09 P). The Invalidity Division notes that neither the CJEU 'RED LEGO BRICK', nor the decision of the Grand Board of Appeal of 10/07/2006, R 856/2004-G 'FORM OF A LEGO BLOCK' (3D) cited by the invalidity applicant are applicable to the present case. These decisions concerned the protection of trade marks and were drafted exclusively in relation to it. Consequently, they both were based on different legal and factual circumstances and considerations, given the differences that exist between the system of EU law for trade mark protection and the system for design protection. The Invalidity Division notes that the scope of protection of trade marks and designs should be interpreted autonomously with the reference to different legal regimes, established, *inter alia*, in Article 7 EUTMR and Article 8 CDR.

Finally, the Invalidity Division notes that despite references to the trade mark - related decisions, the applicant has not submitted any convincing evidence to demonstrate that the building blocks or any of their essential features have been chosen with a view to designing the product solely for the purpose of enhancing the product's technical function. Therefore, the invalidity applicant has failed to prove that the need to achieve

the product's technical function was the only relevant factor when the abovementioned features of the product were selected (22/10/2009 R 690/2007-3, 'Chaff cutters', §°32).

Consequently, as Article 8(1) CDR does not apply to all the RCD's essential features, the request for the invalidity of the RCD based on this ground must be rejected as unfounded.

CONCLUSION

The facts and evidence submitted by the applicant do not support the grounds for invalidity under Article 25(1)(b) CDR, in conjunction with Article 8(1) CDR; therefore, the application is rejected.

COSTS

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

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

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



The Invalidation Division

Katarina ČAVOR

Gailė SAKALAITĖ

Michele M.
BENEDETTI-ALOISI

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

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