



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

DESIGNS DEPARTMENT- INVALIDITY DIVISION

**DECISION OF
THE INVALIDITY DIVISION
OF 30/08/05**

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

FILE NUMBER	ICD 000000271
COMMUNITY DESIGN	000037189-0010
LANGUAGE OF PROCEEDINGS	Italian
APPLICANT	Rodi Comercial S.A. Apartado 1 Eixo, 3801-551 Portugal
REPRESENTATIVE OF THE APPLICANT	Soldatini Andrea c/o Società Italiana Brevetti S.p.A. Corso dei Tintori, 25 Firenze, 50122 Italy
HOLDER	ISCA S.p.A. Via Navarrini, 4 I-36028 Rossano Veneto VI Italy
REPRESENTATIVE OF THE HOLDER	BUGNION S.p.A. Via G. Garibaldi, 19 I-37121 Verona Italy

The Invalidity Division,

composed of Eva Udovc (rapporteur), Harri Salmi (member) and Cécile Barrio (member) took the following decision on 30/08/05:

1. **The application for a declaration of invalidity of the registered Community design No. 000037189-0010 is rejected.**
2. **The Applicant shall bear the costs of the Holder.**

I. FACTS, EVIDENCE AND ARGUMENTS

- (1) The Community design No. 000037189-0010 (in the following: “the CD”) has been registered in the name of the Holder with the date of filing of 28/05/2003. In the CD, the indication of products reads “Wheels for bicycles” (“Ruote per bicicletta”) and the design is represented in the following view (published at http://oami.eu.int/bulletin/rcd/2003/2003_028/000037189_0010.htm):

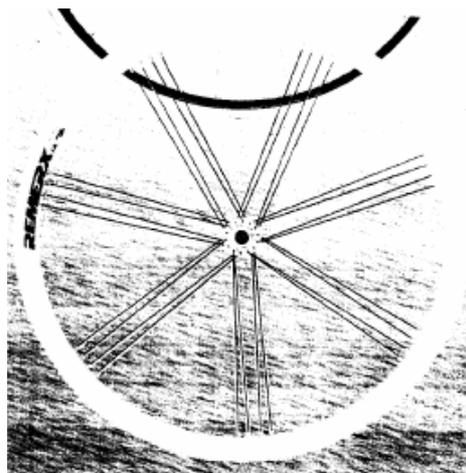


- (2) On 26/05/2004, the Applicant filed an Application for a declaration of invalidity (in the following: “the Application”) contesting the validity of the CD and the fee for the Application was paid on the same date.
- (3) The Applicant requests a declaration of invalidity of the CD “based on the grounds of lack of novelty and individual character, Articles 52(1), 25(1)(b), 4, 5, 6, 7(1) of Regulation 6/2002¹.” The Applicant states that the CD lacks novelty, because “the advertising and distribution of Remerx and Campagnolo wheels in Italy and Germany (and other European countries) destroys the novelty of the CD”, since the “Remerx and Campagnolo wheels are practically identical to the CD” and “no substantial difference can be detected by comparing the pictures of the front wheels and the CD“. The applicant states that “wheels with a design as claimed by the CD were, for example, produced, marketed and distributed by Remerx s.r.o., a company based in Slavcin in the Czech Republic, in 1999 and subsequent years” and that “Remerx distributed these wheels in various European countries including Germany.” He adds that “independently of the fact that the CD claims a ‘7x4’, ‘8x4’ or ‘9x4’ spoke system, the documents appended to this statement show that all

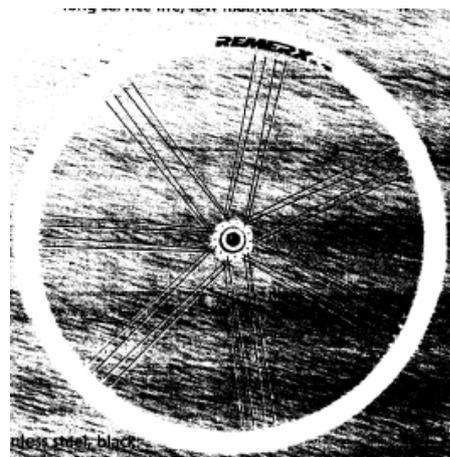
¹ Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs

these designs were known, published, produced and distributed within the European Union long before the filing date of the CD.”

- (4) With regards to individual character the Applicant further states that the CD lacks individual character, because “even supposing that in accessing the degree of novelty, importance were attributed to some perhaps insignificant differences between the CD and the earlier wheels, it is evident that the CD would still lack individual character compared with the bicycle wheels with grouped spokes which were known before the filing date”. He argues that “the general impression of the groups of four with spokes intersecting each other near the hub could produce a particular impression on the informed user”, wherein “the impression would be solely due to the use of spokes grouped in fours because the wheel shown in the CD possesses no other significant feature” and “the general impression of the CD is thus the same whether the bicycle wheel shows one or two groups more or less” and “the exact positioning of the groups within the wheel or the individual spoke within the group” does not affect the overall impression, since the “informed user can discern no difference between two wheels each with spokes arranged in groups of four, but at slightly different angles with respect to the diameter of the wheel.”
- (5) As evidence, the Applicant submits the following documents:
- a copy of a catalogue titled “Remerx Ráfky Felgen Rims” designated as “Katalog 99, Prospekt von Remerx”, a catalogue in the Czech and English language of a company Remerx s.r.o. based in Slavcin in the Czech Republic” (in the following: “D1”);
 - a copy of an invoice, dated 13/12/1999, addressed to a company RACO in Kerspleben in Germany and issued in the Czech and English language by the Remerx s.r.o., the same company as stated above (in the following: “D2”);
 - a copy of a catalogue in the Czech and English language of the company Remerx titled “Rims 2002 2003, Remerx” with the name and address of a distributor in Germany (in the following: “D3”), which discloses two designs of wheels with bundle spoking, herewith referred to as designs A and B;



A



B

- a copy of an advertisement of a Campagnolo Zonda G4 front wheel produced by a company Compagnolo on a bicycle by a company Liyang and a cover page of an Italian magazine “Bicicletta” with number 219 of March 2002, in which this advertisement was published (in the following: “D4”);



and

- a copy of a "Letter of notice" sent to a company Rodi LDA in Portugal by a company ISCA S.p.A in Italy (in the following: "D5").

- (6) On 16/06/2004 the Holder was notified of the Application and invited to submit his observations within a time limit set.
- (7) On the 22/07/2004 the Applicant applied for a rapid conclusion of the proceedings.
- (8) On the 26/07/2004 the Applicant submitted a correction of a part of the text of the initial Application referring to the exhibit 5.
- (9) On 27/07/2004 the Holder was notified of the correction of the initial Application referring to the exhibit 5.
- (10) The Holder did not submit any observations to the Application.
- (11) On 14/09/2004 the Office informed both parties that the written proceedings were closed and that a decision concerning the invalidity would be taken.
- (12) On the 27/09/2004 the Office invited the Applicant to submit the original catalogues of the Remerx, namely originals of D1 and D3, within the time limit set, because the images of the prior designs that were originally submitted by fax were not clear.
- (13) On 04/10/2004 the Applicant submitted colour copies of the original catalogues.
- (14) On the 29/10/2004 the Office communicated the submitted copies of D1 and D3 to the Holder with an invitation to submit his observations in the time limit set stating that the Office would take a decision based on the documents received should no further observations be received.

- (15) The Holder did not submit any observations within the time limit set.
- (16) On 20/12/2004 the Office informed both parties that the written proceedings were closed and that a decision concerning the invalidity will be taken based on the documents provided.
- (17) For further details to the facts, evidence and arguments submitted by the Applicant and the Holder reference is made to the documents on file.

II. GROUNDS OF THE DECISION

A. Admissibility

- (18) The request of the Applicant to declare the invalidity of the CD “based on the grounds of lack of novelty and individual character, Articles 52(1), 25(1)(b), 4, 5, 6, 7(1) of Regulation 6/2002” is a statement of the grounds on which the Application is based. Therefore, the requirement of Art. 28(1)(b)(i) CDIR² is fulfilled. Furthermore, the Application complies with the Art. 28(1)(b)(v)(vi) CDIR, since it contains an indication of the facts, evidences and arguments submitted in support of those grounds, in particular indications and reproductions of prior designs. The other requirements of Art. 28(1) CDIR are fulfilled as well. The Application is thus admissible.

B. Substantiation

- (19) From the request of the Applicant to declare the invalidity of the CD due to “lack of novelty and individual character, Articles 52(1), 25(1)(b), 4, 5, 6, 7(1) of Regulation 6/2002” in conjunction with the facts and evidences submitted with the Application, it is obvious that the Applicant seeks the declaration of invalidity of the CD on the ground that the requirements for protection are not fulfilled in view of earlier disclosures. The requirements for protection affected by an earlier disclosure are novelty and individual character (Art. 4, 5 and 6 CDR). Therefore, in the examination of the Application, novelty and individual character of the CD have to be assessed.
- (20) When considering the facts, arguments and evidence, D1 and D2 were disregarded as evidence. D1 was disregarded, because there was no information in the copy of the printed Remerx catalogue about the date of its publication or disclosure, except for the information on the first page of this copy stating “Katalog 99, Prospekt von Remerx”, which clearly appears to be handwritten on it and which casts doubt on the veracity despite the referral to this publication in the Applicant’s “Statement containing the arguments”. As can be derived from the Applicant’s statements in the Application and as is common in the sector concerned, catalogues of such specific sports articles, namely of wheels for bicycles and in particular for racing bicycles, the catalogues of such products very often state at least the season, if not also the year of catalogue issue. Even though the Applicant stated in the Application that he is prepared to make witness testimony and to provide evidence if necessary and as required by the Invalidity Division, the Division decided not to request it in respect of D1, because the design as disclosed in it would not affect the decision on the

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

invalidity. D2 was disregarded, because it states a sale of one piece of a “Grand-set” model with specification “Miche 8x4, Ot Aero” to a company RACO in Kerspleben in Germany, but contains no image of the appearance of this product and no other evidence submitted contains this product name and its image.

- (21) Other evidence affecting the invalidity decision, namely D3 and D4 was taken into consideration. D3 was taken into consideration despite the fact that it was not submitted in the language of the proceedings (Italian) pursuant to Art. 98(4) CDR, but in the Czech and English language. The Invalidity Division also did not notify the Applicant requesting him to file a translation of that evidence pursuant to Art. 29(5) CDIR and Sections 4.1 and 4.7 of the Invalidity guidelines³, because the information in D3 could be clearly understood as it is mainly numerical and figurative and its contents were provided in the language of the proceedings in the Applicant’s “Statement containing the arguments”. In D3 and D4 only designs that were relevant for assessment of the novelty and individual character of the CD were taken into consideration, namely designs with bundle spoking, having bundles of four spokes, i.e. designs A and B in D3 and design of the front wheel in D4. Other designs in D3 (i.e. designs of wheels with pair and standard spoking) and D4 (i.e. design of the back wheel with bundle spoking having bundles of three spokes) were not taken into consideration due to differences in substantial design features and the overall impressions in comparison to those of the CD.

B.1 Novelty

- (22) According to Art. 5 CDR the CD lacks novelty when an identical design has been made available to the public prior to the date of filing of the CD. Designs shall be deemed to be identical if their features differ only in immaterial details. When assessing novelty, the CD must be compared with each prior design individually.
- (23) The prior designs in D3, referred to as spoked wheels with special spoking or bundle spoking, and the CD consist of wheels including a rim with two bands, a hub in the centre and spokes with nipples, wherein the spokes in each design are arranged in seven separate groups or bundles consisting of four spokes each and these bundles are evenly distributed within the wheel. However, the prior designs and the CD differ in the pattern of distribution of the spoke bundles in the wheel and of the spokes in the bundle and in the ratios among the wheel components, in particular:
- in the prior designs the width of the bundles and the distances between the spokes in the bundle are smaller than the width of the bundles and such distances in the CD, so that the empty spaces between the subsequent bundles are larger in the prior designs than in the CD, namely in the prior designs the width of the bundle at the rim represents only $\frac{1}{4}$ of the length of the arch of the empty space between the two subsequent bundles, whereas in the CD such a width of the bundle represents $\frac{1}{2}$ of the length of the arch of the empty space;
 - in the prior designs the spokes of one bundle are crossed by the spokes of the next bundle two times to form a so called “two-cross” pattern very close to or almost at the edge of the hub or the hub flange, so that the crossings can hardly be observed, whereas in the CD the spokes are crossed two times away from the hub at around a distance of the hub radius, so that all the crossings form an isosceles seven pointed star around the hub, the sides of which start at the edge of the hub;

³ Decision No EX-04-1 of the President of the Office of 26 April 2004 adopting Guidelines for the proceedings relating to a declaration of invalidity of a registered Community design

- in the prior designs the spokes never radiate from the same point of the hub, whereas in the CD the two left or the two right spokes of the bundle always come out as a pair from the same point of the hub as do the two right spokes of one bundle and the two left spokes of the 2nd subsequent bundle;
- in the prior designs in D3 the width of the rim side wall represents around 2/3 of the bundle width at the rim and around 2/3 of the hub diameter, whereas in the CD the width of the rim side wall represents around 1/3 of such a bundle width and around 1/2 of the hub diameter.

An additional difference is in the colours of the designs, because in the CD there are no colours specified, whereas the rims in both prior designs A and B in D3 have a wider internal circular band in yellow colour and a narrower external band in white and design B has a central part of the hub in yellow colour.

(24) The prior design in D4 is a part of the whole product, namely a bicycle front wheel within a complete bicycle. This front wheel consists of a rim, a hub, spokes with nipples, wherein the spokes are arranged in five separate bundles consisting of four spokes each, and additionally contains a tyre and is incorporated into the bicycle via a fork and other components of the complete bicycle. This front wheel design in D4 differs from the CD, because:

- it contains only five bundles of spokes and altogether 20 spokes in the wheel, whereas in the CD there are seven bundles of spokes and altogether 28 spokes;
- the width of the bundle at the wheel rim is almost equal to the length of the arc of the empty space between the two subsequent bundles, whereas in the CD such a width of the bundle represents only 1/2 of the length of the arch of the empty space;
- the lacing pattern of spokes is not the same all around the hub, because in the three subsequent bundles the two left spokes cross each other away from the hub flange at a distance of around three to four hub radiuses as do the two right spokes of these bundles and in the two remaining subsequent bundles such spokes cross each other almost at the hub flange, whereas the lacing pattern in the CD is the same all around the hub as described in paragraph 23 above;
- the width of the rim side wall represents around 1/6 of the bundle width at the rim and around 4/5 of the hub diameter, whereas in the CD the width of the rim side wall represents around 1/3 of such a bundle width and around 1/2 of the hub diameter.

(25) Therefore there are clear differences in the features of the prior designs in D3 and D4 on one side and of the CD on the other which cannot be considered as immaterial details. None of the designs disclosed in D3 and D4 is thus identical to the CD. The submission of the Applicant that the CD lacks novelty is therefore not founded.

B.2 Individual Character

(26) According to Art. 6 CDR the CD shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public prior to the date of filing. When assessing individual character the degree of freedom of the designer in developing the design has to be taken into consideration.

- (27) The informed user is familiar with the spoked bicycle wheels of the type to which the CD relates. In particular, he is aware of the requirements that bicycle wheels must fulfil in order to perform their function and of the prior art known in the normal course of business to the circles specialized in the sector concerned. He takes into account that the degree of freedom of the designer is limited by the requirement, that such a wheel has to be laced with the spokes between the hub and the rim in order to support the rim and to transfer the weight of the rider to the rim. In consequence, the informed user will pay more attention to the features where the designer was not limited in his creativity, such as the pattern of distribution of the spokes around the hub and between the hub and the rim, including among others the distances and angles among the spokes, the angles among the spokes and the hub flange and among the spokes and the rim, the crossings of spokes, the grouping of spokes in the bundles, the distances among the bundles, the number of spokes that can vary above a certain minimum number and the ratios among the wheel components.
- (28) Pursuant to Art. 6 CDR the overall impression produced on the informed user by the CD must be assessed by comparison with the overall impression produced on such a user by each individual prior design cited, wherein the attention is focused on the shape of the spoked wheel as a whole.
- (29) The differences in the pattern of distribution of the spokes and in the ratios among the wheel components in the CD and in the prior designs in D3 as mentioned in paragraph 23 above, result in the different overall impressions of these designs. The CD produces an overall impression of a complex wheel, filled with many spokes that imply a rotating movement in the spokes and the weight concentrated in the spokes, whereas each of the two prior designs in D3 produces an overall impression of a simple wheel with empty space inside and an impression of fewer spokes that imply an almost motionless wheel and a concentration of the weight in the rim due to its width and coloration.
- (30) The differences in the pattern of distribution of the spokes and in the ratios among the wheel components in the CD and in the prior design in D4 as mentioned in paragraph 24 above result in the different overall impressions of these designs. The CD produces an overall impression of a complex regular wheel with symmetrical and regular distribution of the spokes with a regular star pattern of the spoke crossings around the centre, whereas the prior design in D4 produces an overall impression of a complex irregular wheel with empty space inside and without symmetry and with irregular distribution of the spokes in the bundles in one half of the wheel and with no regular shape of spoke crossings around the centre.
- (31) The overall impression produced by the CD is therefore different from that produced by the prior designs taken individually. Therefore, the submission of the Applicant that the CD lacks individual character is not founded.

C. Conclusion

- (32) The CD is considered to be new and to have individual character in comparison to the designs disclosed in D3 and D4. The submissions of the Applicant that the CD lacks novelty and individual character are not founded. Therefore, the Application is to be rejected.

III. COSTS

- (33) Pursuant to Article 70(1) CDR and Art. 79(1) CDIR, the Applicant bears the costs incurred by him essential to the proceedings.

IV. RIGHT TO APPEAL

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

THE INVALIDITY DIVISION

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