



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

DESIGNS DEPARTMENT- INVALIDITY DIVISION

**DECISION OF
THE INVALIDITY DIVISION
OF 03/05/06**

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

FILE NUMBER	ICD 0000002095
COMMUNITY DESIGN	000387584-0001
LANGUAGE OF PROCEEDINGS	English
APPLICANT	Built NY, Inc. 75 Spring Street, 7th Floor New York, New York 10012 United States of America
REPRESENTATIVE OF THE APPLICANT	KILBURN & STRODE 20 Red Lion Street London WC1R 4PJ United Kingdom
HOLDER	I-Feng Kao No 200, Shi-Ho Road West District Tainan Taiwan
REPRESENTATIVE OF THE HOLDER	BUREAU D.A. CASALONGA-JOSSE Avenida Maisonnave, 41-6C E-03003 Alicante Spain

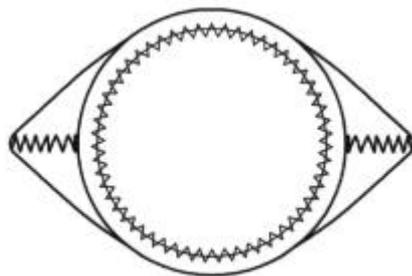
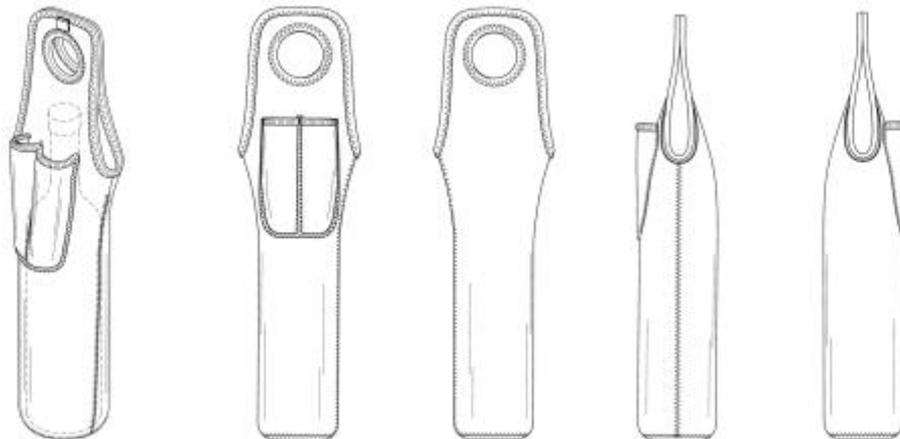
The Invalidity Division,

composed of Eva Udovc (rapporteur), Martin Schlötelburg (member) and Eva Vyoralova (member) took the following decision on 03/05/06:

- 1. The Application for a declaration of invalidity of the registered Community design No. 000387584-0001 is rejected.**
- 2. The Applicant shall bear the costs of the Holder.**

I. FACTS, EVIDENCE AND ARGUMENTS

- (1) The Community design No. 000387584-0001 (in the following: “the CD”) has been registered in the name of the Holder with the date of filing of 12/08/05. In the CD, the indication of products reads “Bottle bags” and the design is represented in the following seven views (published at http://oami.eu.int/bulletin/rcd/2005/2005_102/000387584_0001.htm):



- (2) On 01/03/06, the Applicant filed an application for a declaration of invalidity (in the following: “the Application”) contesting the validity of the CD. The fee for the Application was paid by current account with effect of 01/03/06.

- (3) The Applicant requests the invalidation of the CD “according to Article 25(1)(b) and (d) CDR¹ with costs awarded to the Applicant”, because the CD “does not fulfill the requirements of novelty or individual character as stated in Articles 5 and 6 CDR respectively, and is in conflict with the Applicant’s prior design as per Article 25(1)(d) CDR”.
- (4) The Applicant indicated as prior design the registered Community design No. 000210679-0001 (in the following: “the prior design”), which was applied for on 27/07/04 and published on 30/11/04. The publication of the prior design is available in the Community Designs Bulletin published at http://oami.eu.int/bulletin/rcd/2004/2004_099/000210679_0001.htm. The prior design has an indication of products “Bottle carriers [for transport]” and is represented in the following three views:



- (5) The Applicant argues that “the prior design removes the novelty of the challenged design”, because they “are identical in the meaning of Article 5 CDR”. He supports this argument by stating that “all the features of shape and contours of the challenged design are anticipated by the prior design except for the flattened base in the challenged design compared with the rounded base in the prior design, the slightly more streamlined handle shape and the pockets on one side of a bag”, wherein “the shape of the base and handle are immaterial details in the design of a bag, particularly when the bags are under load as the base of the prior design then appears flattened as well” and “the pockets are also an immaterial detail as they are a minor addition, visible from only one angle of elevation”.
- (6) The Applicant argues “additionally or alternatively”, “that the challenged design lacks individual character within the meaning of Article 6 CDR”, because “the challenged design and the prior design both produce the same overall impression on the informed user”. He supports this argument by stating that “the differences between the two compared designs are limited to minor deviations in the shape of the base of the body and the handle, and the addition of pockets visible in one view only”, wherein “the degree of freedom of the designer was limited only in so far as these articles necessarily comprise a body with the necessary capacity to hold a bottle, and handle elements.” He further adds that “the designer of the challenged design could have opted for

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

an entirely different shape when designing the bag” as this “would still fulfil its function with a body of different shape”, “likewise, the handle elements could have been formed differently” and “the mere addition of pockets, in particular such an addition to only one side of the bag, does not create any distinction between the Applicant’s earlier design and the challenged design”.

- (7) On 03/03/06 the Holder was notified of the Application and invited to submit his observations within a two months period.
- (8) The Holder submitted his observations on 07/04/06. The Holder contests that the Applicant’s submissions that the CD lacks novelty and individual character are not founded, because the differences between the two designs “are not immaterial details”, namely the differences in the shape of designs, the hole of the handle, the upper part of the handles, the bottom (base) of the design and the additional pocket, and because “the general impression produced by the challenged design differs from the general impression produced by the earlier design”, wherein “the similarities invoqued by the applicant for cancellation are just dictated by the technical function” and “such functional features cannot be protected according to Article 8 CDR”.
- (9) On 11/04/06 the Office informed both parties that the written proceedings were closed and that a decision concerning the invalidity would be taken.
- (10) 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

- (11) The request to declare the CD invalid because it “does not fulfill the requirements of novelty or individual character as stated in Arts. 5 and 6 CDR” is a statement of the grounds on which the Application is based in the meaning of Article 28(1)(b)(i) CDIR². Furthermore, the Application complies with Article 28(1)(b)(v) and (vi) CDIR, since the attachment contains an indication of the facts, evidence and arguments submitted in support of those grounds. The other requirements of Art. 28(1) CDIR are fulfilled as well. The Application is thus admissible.
- (12) The request to declare the CD invalid because it “is in conflict with the Applicant’s prior design as per Article 25(1)(d) CDR” was not taken into consideration, because this invalidity ground does not apply, as the prior design has been made available to the public before the date of filing of the application for the CD and not after it.
- (13) Even though the Applicant provided only the indication of the prior design, namely “the Applicant’s Registered Community Design Number 000210679-0001 was applied for on 27 July 2004 and published on 30 November 2004”, but not its reproduction and documents proving the existence of this earlier

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

design, the Application is admissible, because the prior design is a prior registered Community design. Whenever the prior design is a registered Community design, the Invalidity Division *ex officio* checks its existence and includes its reproduction in the file of the Application.

B. Substantiation

B.1 Novelty

- (14) As rightfully observed by the Holder, the prior design and the CD are not identical, because the differences between them are not immaterial details. Even though the two designs have some common features, like a simple cylindrical body with circular cross section that extends to two flattened handle parts at its top, they differ in features which are not immaterial details. In particular:
- the CD is longer than the prior design, because the ratio between the width and the height is 1 : 5.2 in the CD and 1: 4.2 in the prior design;
 - the CD has almost the same width or diameter all along its height with the exception of a slight extension in the third quarter of the height, where its body gets slightly wider at the beginning of the handle part and amounts to 1.5 of the body diameter. The prior design, on the other hand, is slightly wider at its base and much wider in the top quarter, i.e. in the handle part, where the width amounts to 1.8 of the body diameter.
 - the two handles in the CD have a small circular hole below their top and a trapeze shape with wider side placed at the top of the bag body and a narrower side at their top, whereas the handles in the prior design have a bigger elliptical hole and an elliptically rounded shape at its top which extends into the bag body at their bottom. In the CD the diameter of the circular hole amounts to $\frac{1}{2}$ of the body diameter and in the prior design the horizontal diameter of the elliptical hole equals to the body diameter.
 - the CD has double pocket on one side and is placed over the third quarter of the height and has a width slightly narrower than the bag body, whereas the prior design has no pocket.
- (15) Therefore, the prior design as invoked by the Applicant is not an obstacle to the novelty of the CD within the meaning of Article 5 CDR.

B.3 Individual Character

- (16) The informed user is familiar with bottle bags and other similar bottle carriers of the type to which the CD relates. In particular, he is aware that such devices have the function of holding the bottle and enabling its carriage and therefore must have a compartment for the bottle and at least one handle to carry it in the hand. When assessing the individual character of the CD the degree of freedom of the designer in developing his design for the bottle bags must be taken into consideration. In the present case, this degree of freedom is limited to the functional requirements of the product. Because the bottle bag has to fit the bottle, its body has to follow the generally cylindrical shape of the bottle.

Regarding the handle, the designer has a broader degree of freedom in designing it in relation to the bottle bag body.

- (17) Due to the simple overall shape of both designs the features of their shape, lines and contours prevail in their perception and impact their overall impression. Because the CD has almost the same width all along its height, it produces an overall impression of a longer cylinder with almost linear sides and contours including in its top segment, wherein the two handles with small holes look like an integral part of the cylindrical body. The prior design, on the other hand, produces an overall impression of a shorter and wider cylinder with wider top segment and due to its rounded sides and contours the two handles look like a separate segment attached to the cylindrical body. A much wider horizontally placed elliptical hole in the prior design additionally emphasizes this overall impression. Consequently, the prior design and the CD produce different overall impressions on the informed user.
- (18) Therefore, the prior design as invoked by the Applicant is not an obstacle to the individual character of the CD within the meaning of Article 6 CDR.

C. Conclusion

- (19) The prior design invoked by the Applicant does not justify the requested declaration of invalidity on the ground of Article 25(1)(b) CDR. Therefore, the Application has to be rejected.

III. COSTS

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

IV. RIGHT TO APPEAL

- (21) 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

Eva Udovc

Martin Schlötelburg

Eva Vyoralova