



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

OPERATIONS DEPARTMENT – DESIGNS SERVICE

**DECISION OF
THE INVALIDITY DIVISION
OF 21/02/2014**

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

FILE NUMBER	ICD 000008839
COMMUNITY DESIGN	002045344-0001
LANGUAGE OF PROCEEDINGS	English
APPLICANT	CORTEFIEL, S A Avda del Llano Castellano, 51 28034 Madrid Spain
REPRESENTATIVE OF THE APPLICANT	CLARKE, MODET Y CIA., S.L. Rambla Méndez Núñez, 12, 6° A E-03002 Alicante Spain
HOLDER	GMC Toy's Field Inc. 4 F. Yanai Bldg., 3-1-3 Kuramae, Taito-ku 1110051 Tokyo Japan
REPRESENTATIVE OF THE HOLDER	MICHALSKI - HÜTTERMANN & PARTNER PATENTANWÄLTE Neuer Zollhof 2 D-40221 Düsseldorf Germany

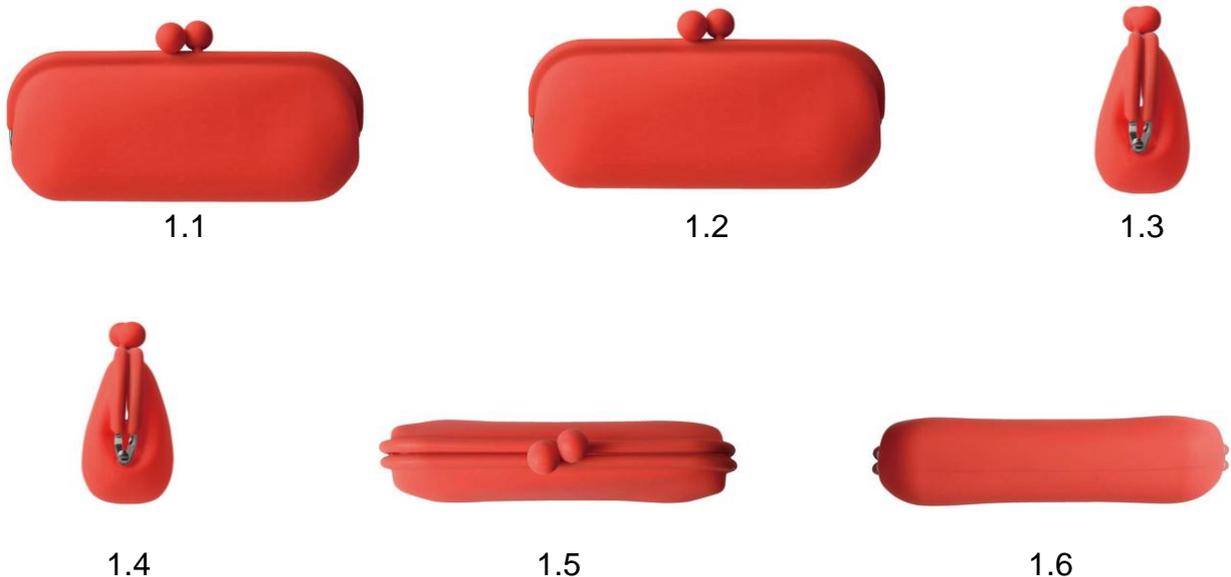
The Invalidity Division

composed of Ludmila Čelišová (rapporteur), Jakub Pinkowski (member) and Martin Schlötelburg (member) took the following decision on 21/02/2014:

- 1. The registered Community design n° 002045344-0001 is declared invalid.**
- 2. The Holder shall bear the costs of the Applicant.**

I. FACTS, EVIDENCE AND ARGUMENTS

- (1) The Community design n° 002045344-0001 (“the RCD”) has been registered in the name of the Holder with the date of filing of 22/05/2012. In the RCD, the indication of products reads “pouches” and the design is represented in the following views:

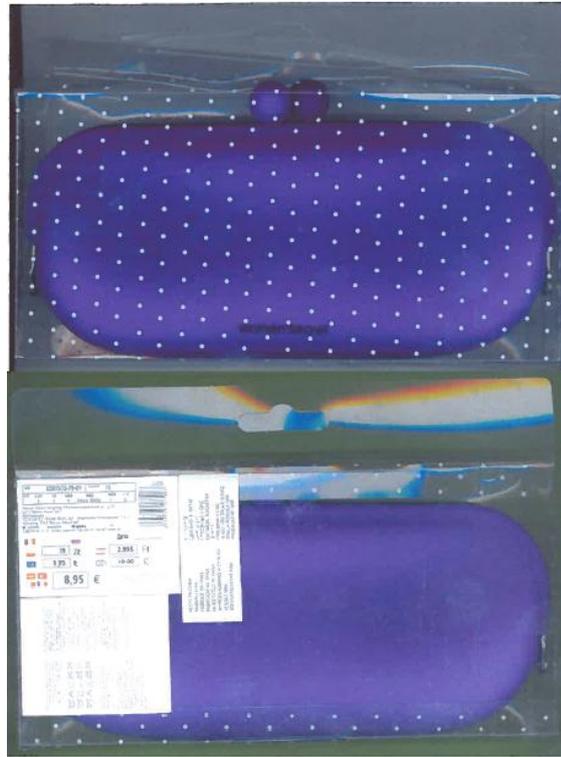


<https://oami.europa.eu/eSearch/#details/designs/002045344-0001>

- (2) On 09/07/2012, the Applicant filed an application for a declaration of invalidity (“the Application”).
- (3) The Applicant requests a declaration of invalidity of the RCD on the grounds of Article 25(1)(b) Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (hereinafter “CDR”).
- (4) As evidence, the Applicant provides:
 - extracts from internet pages Chuvaness.com containing the article “Pochi Is Here!” posted on internet on 05/05/2011. The following representations of pouches (hereinafter the prior designs 1 and 2) accompany the article. There are also attached some pages with internet discussion to the article dated on and after 06/01/2011.



- copies of
 - purchase order no. 7316798 made by women'secret CORTEF.COMMERCIAL,S.A., Switzerland at JIANGSU SUNSHINE DONGSHENG I/E CO., on 09/01/2012 with the date of delivery on 20/03/2012 for articles "Monedero generi totem wide rubber purple" no. 5297370, and destination Spain;
 - two invoices to the above said purchase order, issued for the same purchaser on article of the same article number as in the purchase order; the Invoices were issued on 14/03/2012 and 31/03/2012 by Jiangsu co.;
 - an invoice issued by CORTEF.COMMERCIAL,S.A., Switzerland on 24/04/2012 addressed to EUROFIEL CONFECION, S.A., Spain containing an item of the title, article number and order number identical to the purchase order cited above;
 - a photograph of a rubber pouch (hereinafter the prior design 3) inside women'secret transparent packaging, with a label containing article no. 5297370-78-01, as follows:



- (5) In its reasoned statement, the Applicant claims that the contested RCD is not new, because identical or almost identical designs were made available to the public before the date of filing of the contested RCD. The prior designs and the contested RCD are identical as regards material features. The RCD also lacks individual character with respect to the prior designs, because with the prior designs it shares the same shape, size, material, clasp, aperture and additional decorative elements, therefore the RCD should be invalidated.
- (6) In the reply to the Application, the Holder submits that he is the one and the only original manufacturer who created and developed a purse product made from silicone in connection with the registered Community design. He supports his claim by the submission of the Affidavit of Mr. Yuh Katoh, the representative director of the Holder. The prior designs 1 and 2 were not disclosed in compliance with article 7(1) CDR because the internet page on which the prior designs appear is a weblog originating in Philippines, and its contents could not reasonably have become known in the normal course of business to the circles specialized in the sector concerned, operating within the Community. The images of the products were made by the Holder, they were not disclosed before the filing date of the RCD and if so without his consent.
- (7) The Holder further claims that the article indicated in the invoices is supposed to be composed of 100% rubber whereas the RCD comprises some metal parts, therefore the invoices do not concern about the same product as the RCD. The destination of the delivery is Switzerland, therefore the product could not reasonably have become known in the normal course of business to the circles specialized in the sector concerned, operating within the Community hence the design was not disclosed in compliance with article 7(1) CDR. Moreover, the transaction took place within the 12-month grace period of the Holder, therefore the design was made available to the public as a consequence of an abuse in relation to the designer or his successor in title pursuant to Article 7(2) and (3) CDR and the disclosure should not be taken into consideration. The photo of the product in the transparent pack cannot be

brought in combination with any date, in particular with no date before the filing date of the RCD.

- (8) In the reply the Applicant contests that the prior designs could have become known to the circles specialized in the sector concerned operating in the Community and that the Holder did not submit any prove of abuse of the design in relation to the designer or his successor in title.
- (9) In his rejoinder the Holder submits that his product is sold by the Museum of Modern Art (MoMA) which never deals with counterfeited goods and therefore he is the original manufacturer. The weblog www.chuvaness.com belongs to an individual person and reflects the interests of this person, it is not limited to a specific field and therefore there is no reason for an entrepreneur or designer operating in the EU in the field of fashion to pay any attention to it. Moreover, according to enclosed traffic analysis 98.1% of its visitors do not come from Europe. The documents concerning the trade transaction of the product under the code 5297370 were prepared by woman'ssecret, the legal entity connected to the Applicant and therefore they do not constitute impartial evidence. The order sheet indicates that it was modified, therefore not credible.
- (10) In the reply the Applicant holds regarding the disclosure of prior designs 1 and 2 that the internet site is in English and there is no restriction in accessibility of the site. The relevant circles such as designers, manufacturers and, in general, companies closely related with the market field have easy position to get the information posted on the web site or buy the products. Regarding the exception from the novelty and individual character test pursuant Article 7(1) the Applicant contests that women'ssecret and Cortefiel are well established companies around the whole EU not solely in Switzerland and the destination in the provided transaction documents is not Switzerland but Spain.
- (11) In the rejoinder the Holder maintains that documents that should give evidence of disclosure of prior designs are not credible and therefore cannot be taken into account, mainly because the printout of the internet website does not show that the images contained have been published before the filing date of the RCD and the disclosure of the prior design 3 falls in the grace period of the Holder and thus constitutes abuse in relation to the designer or his successor in title.
- (12) For further details to the facts, evidence and arguments submitted by the parties, the reference is made to the documents on file.

II. GROUNDS OF THE DECISION

A. Admissibility

- (13) The Application complies with the formal requirements prescribed in CDR and the Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community designs (hereinafter "CDIR"), in particular as laid down in Article 28 CDIR. The Application is therefore admissible.

B. Substantiation

B.1 Disclosure

- (14) According to Article 7 (1) CDR for the purpose of applying Articles 5 and 6, a prior design shall 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 date of filing of the application for registration of the contested design, except where these events could not reasonably have become known in the normal course of business to the circles specialized in the sector concerned, operating within the Community.
- (15) According to Article 7(2) CDR a disclosure shall not be taken into consideration for the purpose of applying Articles 5 and 6 if a design for which protection is claimed under a registered Community design has been made available to the public by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer or his successor in title during the 12-month period preceding the date of filing of the application. Paragraph 2 shall also apply if the design has been made available to the public as a consequence of an abuse in relation to the designer or his successor in title.
- (16) The Applicant submitted and extract from a weblog containing a blog article about launch of Pochi purse, showing picture of Tokyo Hakuinkan Toy Park – toy department store, where the purse can be bought and images of the prior designs 1 and 2.
- (17) As a matter of principle, disclosures derived from the internet form part of the prior art. Information disclosed on the internet is considered to be publicly available as of the date the information was posted.
- (18) The weblog is well designed, with search possibility, a wide range of advertisements and readers contributions. The weblog is in English operated under .com most used domain. Nothing indicates the weblog would be difficult to reach or not accessible on internet at all. The article was posted on internet on 05/05/2011 and as there is no evidence to the contrary, the date is deemed to be the date of disclosure of the design. The date precedes the date of filing of the RCD. The prior designs 1 and 2 are therefore deemed to be disclosed in compliance with Article 7(1) CDR.
- (19) The purchase order and the invoices all contain an item having the same number as the product in the transparent package of woman's secret. All the dates precede the date of filing of the RCD and the Office did not find any discrepancies in the dates or modifications alleged by the Holder. The Holder did not provide any evidence about the alleged abuse of the information of the product by the Chinese provider either. The destination of the transaction is a Spanish retailer of fashion goods, an EU member state, therefore the argument of the Holder that the design could not become known to the circles operating within the Community is not well founded either. The prior design 3 is deemed to be disclosed in the course of business within the meaning of Article 7(1) CDR.

B.2 Novelty

- (20) According to Article 5 CDR the RCD lacks novelty when an identical design has been made available to the public prior to the date of filing of the RCD. Designs shall be deemed to be identical if their features differ only in immaterial details.
- (21) The RCD and the prior designs relate to a pouch suitable for carrying small stationery stuff, glasses etc., with a clip on its long side. The RCD, as shown in the registration, has the same shape and features of clip opening as the prior designs shown in the disclosures. In what the designs differ is their colour: whereas the RCD is registered in red colour, the prior designs are blue and violet. As the colour is not an immaterial detail, the prior designs do not constitute the obstacle to the novelty of the RCD.

B.3 Individual Character

- (22) According to Article 6 CDR, the RCD lacks individual character if the overall impression produced on the informed user is the same as 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 of the RCD or the date of the priority claimed. In assessing individual character of the RCD, the degree of freedom of the designer in developing the design shall be taken into consideration.
- (23) The informed user is familiar with stationery or glass pouches. The degree of freedom of the designer is not substantially limited. New and innovative design solutions are not hindered by severe technical or standardization constraints. The only limitation is that a pouch has to hold the contents and can be closed.
- (24) The compared designs are identical regarding their shapes, material and closures. The pouches differ only in the colour. The colour itself, however, does not deliver the design the individual character. It is the combination of all the visual features of the article - the shape, material and the colour, what makes the design of the pouch. Producers of rubber pouches, purses and similar articles use different bright colours to make these articles easily spotted and to attract users. It is thus common to find in the market purses in red, blue, pink, yellow, purple, green and other colours, as the examples from the prior art show.
- (25) As various colours are common and not unexpected, the colour of the contested design does not deliver the RCD overall different impression over the prior designs and hence the RCD lacks individual character within the meaning of Article 6 CDR.

C. Conclusion

- (26) The facts and evidence provided by the Applicant proved the ground for invalidity of Article 25(1)(b) CDR in conjunction with Article 5 CDR. The RCD is declared invalid.

III. COSTS

- (27) Pursuant to Article 70(1) CDR and Article 79(1) CDIR, the Holder bears the fees and costs of the Applicant.
- (28) The costs to be reimbursed by the Holder to the Applicant are fixed to the amount of 750 Euro, composed of 400 Euro for the costs of representation and 350 Euro for the reimbursement of the invalidity fee.

IV. Right to Appeal

- (29) 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 (Article 57 CDR).

THE INVALIDITY DIVISION

Ludmila Čelišová

Jakub Pinkowski

Martin Schlötelburg

