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

OPERATIONS DEPARTMENT - Designs Service

ONTVANGEN OP
23 SEP. 2015

Alicante, 16/09/2015

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PAÍSES BAJOS

GESCAND

Fax number: **00 31-357200958**
Name of the applicant: **Desch Holding B.V.**
Language of the proceedings: **English**

File number of the invalidity application:	Community Design concerned:
ICD 9580	**002351528-0001**

NOTIFICATION OF A DECISION OF THE INVALIDITY DIVISION COMMUNICATION TO THE HOLDER

Please find enclosed the decision of the Invalidity Division in relation to the Invalidity application referred to above.

Please note that the date of fax transmission is considered to be the date of notification of the decision.

Attached: Decision of the Invalidity Division

Janine ANTON

By registered mail

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

OPERATIONS DEPARTMENT - DESIGNS SERVICE

DECISION OF THE INVALIDITY DIVISION OF 15/09/2015

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

FILE NUMBER	ICD 9580
COMMUNITY DESIGN	002351528-0001
LANGUAGE OF PROCEEDINGS	English
APPLICANT	DESCH HOLDING B.V. IJZENWERF 14 6641 TK BEUNINGEN THE NETHERLANDS
REPRESENTATIVE OF APPLICANT	ALGEMEEN OCTROOI- EN MERKENBUREAU JOHN F. KENNEDYLAAN 2 5612 AB EINDHOVEN THE NETHERLANDS
HOLDER	[redacted]
REPRESENTATIVE OF HOLDER	GRAVENDEEL ADVOCATEN UTRECHTSWEG 63 1213 TL HILVERSUM THE NETHERLANDS

The Invalidity Division, composed of Natalie Pasinato (rapporteur), Alvaro Sesma Merino (member) and Michele M. Benedetti-Aloisi (member) has taken the following decision on 15/09/2015:

1. **The application for a declaration of invalidity of the registered Community design No 2351528-0001 is rejected.**

2. **The applicant shall bear the costs of the holder.**

III. FACTS, EVIDENCE AND ARGUMENTS

(1) Community design No 2351528-0001 (the 'RCD') was registered in the name of the holder with a filing date of 25/11/2013. The RCD indication of products reads *components for garden and interior furniture, ornamental items for furniture.* The design was published in the Community Designs Bulletin with the following views (RCD 2351528-0001):

(2) On 03/06/2014, the applicant filed a request for a declaration of invalidity (the application) contesting the validity of the RCD.

(3) Using the Office's application form, the applicant requested a declaration of invalidity on the grounds that the RCD did not fulfil the requirements of Articles 4 to 9 and others according to Article 25(1)(c), (d), (e), (f) or (g) of the Council Regulation (EC) n° 6/2002 on Community Designs (CDR).

(4) The applicant claimed that the contested RCD lacked novelty and individual character because it was highly similar to an earlier design sold since the year 2000 by the applicant. The applicant also declared that the RCD infringed the applicant's copyright as it owned the right of the design of the plant pot under Dutch copy right law.

(5) As evidence, the applicant submitted:

- copy of sales figures from 2006 to 2014;
- copy of a factsheet of the "Sabina" design, which is not dated;
- copy of a catalogue 'GROWING TOGETHER Desch Plantpak' displaying a date 2012;
- copy of a catalogue 'EPLA horticultural plastic products' displaying a date 2012/2013;
- copy of a picture from 'SABINA MONICA E·PLA', which is not dated;
- copy of a picture taken at the 2005 Hortifair in the RAI Conference Center in Amsterdam, which is not dated;
- copy of a picture taken at the September 2005 Four Oaks Trade Show in Macclesfield in the United Kingdom, which is not dated;
- copy of a technical drawing of a plant pot dated 13/10/2006;
- copy of a 'Declaration of use and copyright' signed by the CEO J.W. Wieringa on 22/04/2015.

(6) In response to the application, the holder claimed that the designs under comparison were not identical and that the RCD had individual character. The holder also argued that given the differences between the contested designs, there was no copyright infringement on its side.

(7) For further details to the facts, evidence and arguments submitted by the parties, reference is made to the documents on file.

II. GROUNDS OF THE DECISION

A. Admissibility

(8) The indication of the grounds for invalidity in the application is a statement of the grounds on which the application is based within the meaning of Article 28(1)(b)(i) CDIR ([1]). Furthermore, the application complies with Article 28(1)(b)(vi) CDIR, since the application contains an indication of the facts, evidence and arguments submitted in support of those grounds. The other requirements of Article 28(1) CDIR are fulfilled as well. The application is thus admissible.

B. Substantiation

B.1 Disclosure

(9) According to Article 7(1) CDR, for the purpose of applying Articles 5 and 6, a prior design is 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 contested design, 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 Community.

(10) As a matter of principle, in invalidity proceedings, the examination carried out by the Invalidity Division is restricted to the facts, evidence and arguments provided by the parties. However, the Invalidity Division must weigh the facts, evidence and arguments, adjudicate on their conclusiveness, and thereafter draw legal inferences from them without being bound by the points of agreement between the parties.

(11) The date of disclosure of a prior design is a fact. Evidence of that fact could be the date of publication of a catalogue showing the prior design together with evidence proving that the catalogue has been made available to the public before the date of filing or the priority date of the contested Community design.

(12) On the other hand, challenging the validity of a Community design on account of its lack of novelty or of individual character requires proof that an earlier design which is identical or which produces a similar overall impression has been made available to the public before the date of filing the application for registration or, if a priority is claimed, the date of priority. The public in question is made up of the members of the circles specialised in the sector concerned, operating within the European Union. The term 'circles specialised in the sector concerned' in the meaning of Article 7(1) CDR is not limited to persons that are involved in creating designs and developing or manufacturing products based on those designs within the sector concerned.

(13) Therefore, the applicant must substantiate the disclosure of an earlier design. It is assumed that a design which has been made available to the public anywhere in the world and at any point in time, as a result of publication following registration or

[1] Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community designs.

otherwise, exhibition, use in trade or otherwise, has been disclosed for the purpose of applying Articles 5 and 6 CDR. However, acts of disclosure of an earlier design will not be taken into consideration where the holder submits convincing facts, evidence and arguments in support of the view that 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 (decision of 22/03/2012, R 1482/2009-3 – 'Insulation blocks', paragraph 38).

(14) The issue of the disclosure of the prior design is preliminary to that of whether the two designs produce the same overall impression on the informed user. If the prior design has not been made available to the public or it has been made so but in an manner inconsistent with the requirements of Article 7(1) CDR, then there is sufficient reason for rejecting the application to the extent that it is based on Articles 5 and 6 CDR (decision of 10/03/2008, R 586/2007-3 – 'Barbecues', paragraph 22 et seq).

(15) Neither the CDR nor the CDIR provides for any specific form of evidence required for establishing disclosure, Article 28(1)(b)(v) CDIR only provides that 'documents proving the existence of those earlier designs' must be submitted. Likewise, there are no provisions as to any compulsory form of evidence that must be furnished. Article 65 CDR lists possible means of giving evidence before the Office, but it is clear from its wording that this list is not exhaustive ('shall include the following'). Accordingly, the evidence in support of disclosure is a matter for the discretion of the applicant and, in principle, any evidence able to prove disclosure can be accepted.

(16) The Invalidity Division will carry out an overall assessment of such evidence by taking account of all the relevant factors in the particular case. 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 (judgment of 09/03/2012, T-450/08, 'Bottle', paragraph 21-24).

(17) Apart from the elements required under Article 28 CDIR for admissibility purposes in order to substantiate unauthorized use of a protected work under copyright law of a Member State, an application must contain:

- particulars establishing the content of the national law of which the applicant is seeking application including, where necessary, court decisions and/or academic writings (see, by analogy, judgment of 05/07/2011, C-263/09 P, 'ELIO FIORUCCI', paragraph 50; decision of 11/02/08, R 64/2007-3 – 'Loudspeakers', paragraph 20); and
- particulars showing that rights have been acquired on the work pursuant to the copyright law relied on, to the benefit of the author or its successors in title, before the filing date or the priority date of the Community design (see, by analogy, judgment of 18/01/12, T-304/09, 'BASMALI', paragraph 22); and
- particulars showing that the applicant satisfies the necessary conditions, in accordance with that law, in order to be able to have the Community design invalidated or its use prohibited by virtue of its earlier right.

(18) An invalidity applicant relying on copyright infringement has to prove its entitlement to the right to invoke copyright against the RCD as well as the existence and scope of the copyright under national law (decision of 17/10/2013, R 951/2012-3 – children's chairs).

(19) In the present case the applicant submitted copies of catalogues, sales figures for the years 2006 to 2014, loose pictures supposedly taken at fairs in 2005, a copy of a technical drawing to prove its copyright and a sworn statement.

(20) With reference to the technical drawing, there is no indication of a publication date and furthermore these are usually undisclosed documents, normally attached to a confidentiality agreement, which are exchanged by the parties. There is no supporting evidence that proves that the technical drawing was made available to the public at any

time before the filing date of the contested RCD. Hence disclosure within the meaning of Article 7(1) CDR has not been proven.

(21) The applicant raised the ground covered under Article 25(1)(f), namely unauthorized use of a protected work under copyright law of a Member State. In order to substantiate the right to a copyright of a work the applicant has to submit the relevant national legislation to prove that it is entitled under national law, and in particular under national copyright law, to the right claimed. According to the Bern Convention for the protection of Literary and Artistic Works, Article 2(2), dealing with the conditions of protection states that '[i]t shall, however, be a matter for legislation in the countries of the Union to prescribe that works in general or any specified categories of works shall not be protected unless they have been fixed in some material form.' and Article 2(4) that '[i]t is therefore the matter of the national legislature to determine when the copyright protection starts.' The applicant failed to submit the Dutch copyright law, which serves the purpose of establishing that a right effectively exists and as of when. The indication of the date on the technical drawing as such is not sufficient proof that a work has a right to copyright under the Dutch national copyright law, neither does it provide an indication at what point in time a work was granted a copyright under the same national legislation. Hence the applicant failed to prove that it is entitled to a copyright and therefore to the exclusive use of a protected work under copyright law of a Member State.

(22) As concerns the copies of the three catalogues, one catalogue is undated, whereas the other two carry a date that is prior to the filing date of the contested RCD. Notwithstanding these facts, disclosure of any of the catalogues is not supported by any further evidence that proves that the catalogues were in fact distributed and made available to the public prior to the filing date of the contested RCD. On the other hand, the applicant submitted sales figures of its products between 2006 and 2014. The document is a mere list of products and figures and it gives no further indications. Nevertheless, a link between the sales figures and the pictures of the plant pot named 'SABINA' that are shown in the catalogues can be established as the sales figures make a clear reference to the product, product name and the different varieties of the same plant pot. In fact, the catalogue 'GROWING TOGETHER Desch Plantpak', refers to different 'SABINA' models, for example SAB 12, SAB 14, SAB 15, etc. These same indications are found also in the sales figures. The Invalidity Division was able to establish that the numbers in the product name refer to the diameter of the plant pot, meaning 12, 14, 15, etc. centimetres. However, the applicant failed to submit additional evidence, such as, for instance, invoices, in support of the catalogues and sales figures that establish beyond any reasonable doubt that the 'SABINA' plant pots were indeed marketed and were therefore made available to the public, which is constituted by the interested circles of the specialised sector concerned, operating within the European Union.

(23) As concerns the loose copies of pictures supposedly taken at two fairs in 2005, none of the pictures displays a date. The pictures also fail to display any other information about the place, venue or producer that could support the applicant's statement concerning its participation in any of the two fairs. Without any further evidence in support of the pictures and the events, disclosure within the meaning of Article 7(1) CDR has not been proven.

(24) As concerns the sworn statement, this was rendered by the CEO of the applicant and therefore, the objectivity of its content is questionable.

(25) In light of the above, the evidence as filed by the applicant is not solid and objective evidence. Hence there are no prior designs that can be compared to the contested RCD.

(26) To sum up, there is no evidence to prove that a prior design was made available to the public within the meaning of Article 7(1) CDR prior to the date of filing of the contested

RCD. Specifically, even if the catalogues display the pots, which are also mentioned in the sale figures, there is no additional evidence to confirm the disclosure. To establish disclosure on the basis of these two pieces of evidence without confirmation by additional independent documents would amount to a guess hazarding. The Office must ground its evaluation of the evidence on the procedural truth and in the case at issue it is impossible to establish truthfully or at least with a reasonable certainty that the prior design was disclosed. The burden of proof when disclosure is involved is on the applicant and in this case the applicant did not back up its claim with enough evidence.

C. Conclusion

(27) The application for a declaration of invalidity of the RCD on the ground of Article 25(1)(b) and (f) CDR is rejected as unsubstantiated.

III. Costs

(28) Pursuant to Article 70(1) CDR and Article 79(1) CDIR, the applicant bears the fees and costs of the holder.

(29) The costs to be reimbursed by the applicant to the holder are fixed to the amount of EUR 400 for the costs of representation.

IV. Right to Appeal

(30) 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

Natalie Pasinato **Alvaro Sesma Merino** **Michele M. Benedetti-Aloisi**