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

OPERATIONS DEPARTMENT – DESIGNS SERVICE

DECISION OF THE INVALIDITY DIVISION OF 13/12/2011

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

FILE NUMBER	ICD 8335
COMMUNITY DESIGN	001203004-0001
LANGUAGE OF PROCEEDINGS	English
APPLICANT	A.C.V. MANUFACTURING NV Zoning Industriel – Zone C – Rue Henry Becquerel 7180 Seneffe Belgium
REPRESENTATIVE OF THE APPLICANT	Marx – Van Ranst – Vermeersch and Partners Tervurenlaan 270 1150 Brussels Belgium
HOLDER	AIC S.A. Ul. Rdestowi 41 81-577 Gdynia Poland
REPRESENTATIVE OF THE HOLDER	OPTIMAS KANCELARIA PRAWNA Ul. Krakowska 259A 32-080 Zabierzów Poland

The Invalidity Division

composed of Martin Schlötelburg (rapporteur), Jakub Pinkowski (member) and Natalie Pasinato (member) took the following decision on 13/12/2011:

1. The application for a declaration of invalidity of the registered Community design nº 001203004-0001 is rejected.

2. The Applicant shall bear the costs of the Holder.

I. FACTS, EVIDENCE AND ARGUMENTS

(1) The Community design nº 001203004-0001 ("the RCD") has been registered in the name of the Holder with the date of filing of 19/03/2010. In the RCD, the indication of products reads "heat exchangers" and the design is published in the Community Designs Bulletin in the following views:

http://oami.europa.eu//bulletin/rcd/2010/2010_086/001203004_0001.htm

(2) On 07/02/2011, the Applicant filed an application for a declaration of invalidity ("the Application"). The fee for the Application was paid by current account.

(3) The Applicant requests a declaration of invalidity of the RCD on the grounds of Articles 4 to 8 of the Council Regulation (EC) nº 6/2002 on Community Designs ("CDR").

(4) As evidence, the Applicant provided the following documents showing designs of heat exchangers:

- A presentation of Prestige Product range made by the Applicant's employee Herman Ulens, dated 3 May 2005 and depicting design for fire tubes.

- An e-mail containing the presentation of the Prestige Product range made by the Applicant's employee, Herman Ulens, sent to Sabrina Nasolini (sabrina.nasolini@acv-world.com) on 3 May 2005.

- An e-mail, sent on 30 May 2005 from Krzysztof Szczepanski, working for the Holder, and addressed to the involved collaborators. The e-mail contains, as attached files, the drawings of the Prestige 75 & 50 KW heat exchanger.

- An e-mail from Jean Van Den Schrieck sent to the Holder and to the management of A.C.V. International. This email, dated 13 September 2005, contains attached drawings of different proposals for the Prestige 120.

- A technical manual of installation for the Prestige 50-75 boiler.

- A technical manual of installation for the Prestige 50-75-120 boiler.

- An e-mail from the Holder's employee, Krzysztof Szczepanski sent on 27 April 2005 to ACV collaborators. The e-mail contained as enclosed documents drawings of Thermae 35, dated 26 April 2005, and drawings of Prestige rev20 bearing the date 14 April 2005.

- A technical manual for the an ACV boiler "Smart", written in French and German.

(5) In its reasoned statement the Applicant argues *inter alia* that "a heat exchanger is always a component part of a boiler and it only functions when it is integrated into a boiler. It is therefore a component part of a complex product". The Applicant argues as well on the invalidity of the RCD based on the grounds of the technical function exclusion, the absence of protection of the RCD due to its interconnection and incorporation in another product, the absence of novelty and lack of individual character. Following the arguments of the Application, it is specified that "in the present case the heat exchanger will not produce a general impression on the informed user as it is not visible. In subordinate order, even if it would be visible, considering the identity between the RCD and the prior design… an informed user will not appreciate any possible differences that do not derive from the basic shapes dictated by the technical function and by interconnections with other products. Both the RCD and the prior design produce an overall impression of a compact and modern heat exchanger, where the different components are fully integrated".

(6) In response to the Application, the Holder states in regard to the invisibility that "neither arguments of the Applicant nor evidences of the claim are sufficient to prove that heat exchanger is an invisible component part of a complex product. In reality a heat exchanger may be part of a boiler, but also it may be an installation which is not hidden into a boiler". Moreover, in the Holder's opinion, the appearance of the RCD is not solely dictated by its technical function, it is not necessarily interconnected while it presents elements of novelty and individual character, since "the slide presented… representing a heat exchanger with a commentary on its unique character confirms that it is not necessary to copy all the features of the RCD in order to permit a heat exchanger to function… A heat exchanger can be designed in many various shapes and forms".

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

B. Substance

B.1 Component part of a complex product

(9) According to Articles 4(2) and 4(3) CDR "a design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter (b) to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character. Normal use within the meaning of the paragraph (2)(a) shall mean use by the end user, excluding maintenance, servicing or repair work".

(10) Taking into consideration the aforesaid definition, it is considered that the RCD is not a "must-fit" part of a boiler. The heat exchangers are used in various applications such as industrial installations, chemical or pharmaceutical industries, oil temperature cooling, liquid and gas cooling or domestic installations, floor heating and, even, waste water heat recovery.

(11) Even though, it is commonly met that a heat exchanger is integrated into a boiler, it has not been sufficiently and undoubtedly proven that the RCD constitutes necessarily an invisible part of a boiler during normal use. The Applicant provided documents depicting heat exchangers as part of boilers. However, it has not been demonstrated that the heat exchangers shown correspond to the RCD or that the RCD is only applied and used in relation with boilers. The features of the RCD are visible during normal use, since this particular heat exchanger, incorporating the contested design, is not necessarily included in a boiler box during use. The end user is in a position to have a clear view of all the elements of the RCD while the heat exchanger is in motion without the necessity of opening a cover door or disassembling it.

(12) In conclusion, the RCD is not deprived of protection within the meaning of Article 4(2) RCD, since it can be applied as an independent part and, in any case, all of its elements are visible during normal use.

B.2 Technical function - Interconnection

(13) In accordance with Article 8(1) CDR "a Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function". Moreover, according to Article 8(2) CDR "a Community design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order 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".

(14) Following the aforesaid definition, the OHIM Board of Appeal[1] has clarified that "Article 8(1) CDR denies protection to those features of a product's appearance that were chosen exclusively for the purpose of designing a product that performs its function, as opposed to features that were chosen, at least to some degree, for the purpose of enhancing the product's visual appearance. It is not necessary to determine what actually went on in the designer's mind when the design was being developed. The matter must be assessed objectively from the standpoint of a reasonable observer who looks at the design and asks himself whether anything other than purely functional considerations could have been relevant when a specific feature was chosen".

(15) The CDR denies protection to certain designs, not because they lack aesthetic merit but because aesthetic considerations play no part in the development of the designs, the sole imperative being the need to design a product that performs its function in the best possible manner.

(16) In this instance, it should be clarified that even though the Applicant does not include the ground of Article 8 CDR in the application form, the above mentioned ground is included in the observations. The Application being perceived as an entity composed of both the necessary form and the observations, the provisions of Article 8 CDR are to be examined through the Invalidity proceeding. In that frame, the essential features of the RCD are not solely dictated by the technical function of the heat exchanger.

(17) A heat exchanger design must necessarily incorporate some features which serve a technical function namely to heat gas and exchange or transfer the heat delivered by the burned gas. The out sheath serves as to surround and isolate the hot parts of the - invisible – contained fire tubes while the presence of the holes and openings constitutes an essential feature of the outer connection of the heat exchange tubes. However, the shape of the heat exchanger, the lines of the outer shell, the position, the diameter and the number of the bulkheads, do not seem to be based exclusively on the aim to design a product that performs its heat exchanging function in the best possible manner.

(18) The arrangement of the elements of the RCD, the structure of the protective shield, as well as the geometry parameters chosen for the RCD, such as length, width and height are not solely dictated by technical function. It is estimated that the characteristics of the RCD were chosen by the designer while exercising his creative freedom and not serving solely the production of an effective and efficient heating exchanger.

[1] OHIM 3rd Board of Appeal R690/2007-3, *Lindner Recyclingtech GmbH Vs Franssons Verkstäder AB*

(19) Given the fact, that all the essential features of the appearance of the RCD are not solely dictated by its technical function, the RCD is not deprived of protection within the meaning of Article 8(1) CDR.

(20) Moreover, as accepted above (B.1), the RCD is not necessarily interconnected or incorporated into a boiler or any other mechanical engine, thus the article 8(2) CDR is not applicable in this case. Even if the heat exchanger represented in the RCD is found to be a necessary component, existing solely as an inside part of a boiler, none of the features of the contested design are dictated by its technical function or by external factors such as integration. As it has already been demonstrated, all the characteristic elements of the RCD were chosen on the basis of creative liberty and not on the criterion of functionality and efficient or improved mechanical interconnection.

(21) In conclusion, the RCD is not deprived of protection within the meaning of Article 8(2) CDR.

B.3 Disclosure

(22) According to Article 7 CDR "for the purpose of applying Articles 5 and 6, a 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 referred to in Articles 5(1)(a) and 6(1)(a) or in Articles 5(1)(b) and 6(1)(b), as the case may be, 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. The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality".

(23) A detailed analysis of the evidence provided concludes to the following observations:

- The presentation of Prestige Product range made by the Applicant's employee Herman Ulens, and depicting design for fire tubes is not considered sufficient enough to establish the disclosure within the meaning of Article 7 CDR. Despite the claims of the Applicant that said presentation was displayed to US costumers on 3 May 2005, it has not been proven that the facts and images contained were in fact shown in public.

- As for the e-mail containing the presentation of the Prestige Product range made by the Applicant's employee, Herman Ulens, sent to Sabrina Nasolini (sabrina.nasolini@acv-world.com) on 3 May 2005, it is perceived as a private document earmarked for internal communication. Thus, it doesn't demonstrate the disclosure of prior designs before the date of filing of the contested RCD.

- The e-mail, sent on 30 May 2005 from Krzysztof Szczepanski, working for the Holder, and containing as attached files, the drawings of the Prestige 75 & 50 KW heat exchanger, are not taken into consideration as documents of proof. The e-mail in question has been sent as part of internal communication of collaborating parties, thus it was distributed within the frame of mutual

confidentiality and professional secrecy or discretion. Said e-mail doesn't confirm the disclosure of designs within the meaning of Article 7 CDR.

- Concerning the e-mail, dated 13 September 2005 and sent from Jean Van Den Schrieck to AIC and to the management of ACV International, it is considered to be an internal communication and confidential document. Thereof, it can not be assumed that the drawings of the heat exchanger depicted were actually disclosed to public within the meaning of Article 7 CDR.

- A far as the technical manual of installation for the Prestige 50-75 boiler is concerned, it is found to lack of probative value. Even though, the Applicant indicates October 2005 as distribution date of said manual, no date is visible in the documents provided. Consequently, the disclosure of the designs included in the manual has not been proven.

- The technical manual of installation for the Prestige 50-75-120 boiler doesn't confirm the disclosure within the meaning of Article 7 CDR. According to the Applicant's allegations, the existing version of the manual was created and uploaded on the Applicant's website on 30 September 2008. However, the manual provided doesn't bare any date or supplementary data that confirm the production, public notification or online disclosure of said designs on a date prior to the filing of the contested RCD.

- Both the e-mail from the Holder's employee, Krzysztof Szczepanski sent on 27 April 2005 to ACV collaborators, and the enclosed drawings, are estimated as invalid documents of evidence. The e-mail is considered to be an internal and non-public documentation while the drawings of Thermae 35 and Prestige rev20, are equivalently estimated as private documents that don't prove that said designs were put into manufacture or disclosed in any way before the date of filing of the contested RCD.

- The technical manual for the ACV boiler "Smart", being written in French and German, cannot be taken into consideration following the provisions of Article 98 CDR and Article 29 CDIR.

(24) In conclusion, it is estimated that none of the documents provided prove the disclosure of the prior designs before the date of filing of the contested RCD and, thus, the disclosure of prior designs within the meaning of Article 7 CDR has not been established.

C. Conclusion

(25) The RCD being found to fulfil the requirements of protection within the meaning of Articles 4(2) and 8 CDR and in the absence of evidence proving that a prior design has been made available before the date of filing of the contested RCD, the Application for a declaration of invalidity must be rejected as unfounded.

III. COSTS

(26) Pursuant to Article 70(1) CDR and Article 79(1) CDIR, the Applicant bears the fees and costs of the Holder.

(27) The costs to be reimbursed by the Applicant to the Holder are fixed to the amount of 400€, as costs of representation.

IV. RIGHT TO APPEAL

(28) 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

Martin Schlötelburg **Jakub Pinkowski** **Natalie Pasinato**