



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

OPERATIONS DEPARTMENT – DESIGNS SERVICE

**DECISION OF
THE INVALIDITY DIVISION
OF 03/01/2012**

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

FILE NUMBER	ICD 8368
COMMUNITY DESIGN	000916317-0001
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

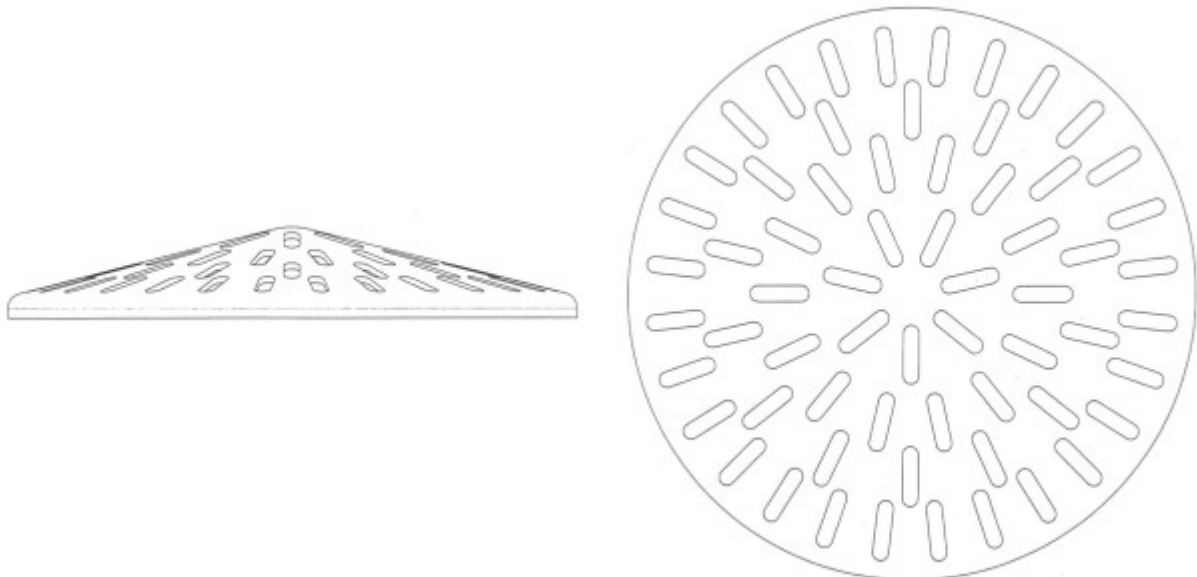
composed of Martin Schlötelburg (rapporteur), Jakub Pinkowski (member) and Natalie Pasinato (member) took the following decision on 03/01/2012:

1. **The application for a declaration of invalidity of the registered Community design n° 000916317-0001 is rejected.**
2. **The Applicant shall bear the costs of the Holder.**

I. FACTS, EVIDENCE AND ARGUMENTS

- (1) The Community design n° 000916317-0001 (“the RCD”) has been registered in the name of the Holder with the date of filing of 14/04/2008. In the RCD, the indication of products reads “sieve bottoms” and the design is published in the Community Designs Bulletin in the following views:

http://oami.europa.eu/bulletin/rcd/2008/2008_232/000916317_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) n° 6/2002 on Community Designs (“CDR”).
- (4) As evidence, the Applicant provided the following documents showing designs of heat exchangers:
 - A presentation of the Prestige Product range made by the Applicant’s employee Herman Ulens, dated 03/05/2005 and depicting designs of fire tubes.

- Drawings of “Thermont” by “Industrie Montini SrL”, bearing indications and explanations of the drawings in Italian and French.
 - An undated document from the company “CSI Ltd.”
 - A group general presentation made by the Applicant and bearing the indication “Visit at Windhager (7 October 2003)”.
 - The Applicant’s presentation of the Prestige boilers 24, 32, 50, 75 and 120, bearing the indication “Prestige and Heat Master Line - October 2006”.
 - An e-mail from the Holder’s employee, Krzysztof Szczepanski sent on 30/05/2005 to the Applicant’s employee, Herman Ulens. The e-mail contained, as enclosed documents, drawings of the Prestige 75 KW heat exchanger, dated 09/05/2005, and the Prestige 50 KW heat exchanger, bearing the date 13/05/2005.
- (5) In its reasoned statement the Applicant argues *inter alia* that “the only function of the tube sheet is to keep the fire tubes, which all have the same length, together and to provide the sealing of the primary water versus the flue gases. Therefore the RCD should be declared invalid as the essential features of its appearance are solely dictated by its technical solution.” The Applicant argues as well on the invalidity of the RCD based on the grounds of the absence of protection of the RCD due to its interconnection and incorporation in another product, and the absence of novelty and lack of individual character as an invisible component part of a complex product. Following the arguments of the Application, it is specified that “the same informed user, even if he would be aware of the presence of a heat exchanger as an operating tool of a boiler, will certainly not be aware of the basic features of such heat exchanger and of the existing design corpus and configurations available in the normal course of business because heat exchangers are always placed inside the boiler for practical and safety reasons”.
- (6) In response to the Application, the Holder states in regard to the elements imposed by technical function that “in the case of community designs of RCD type – the scope of creative freedom is limited, but the technical function does not determine the appearance of the design... preservation of a specific technical function does not interfere with the creative work of the designer, which is demonstrated in use of various shapes and composition of elements (holes) in the design”. Moreover, in the Holder’s opinion, the RCD should be protected since it is a visible part, not necessarily interconnected and fulfilling the elements of novelty and individual character, since “the product, according to community design No. 000916317-0001, is also a product which is the object of individual sale with a characteristic external appearance and it does not matter if it is part of a boiler. (The attachments from 1 to 3 show that) the sieve bottoms of the heat exchanger can be the object of individual sale and they can have various shapes”.
- (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 depicts a visible component part of a complex product. Sieve bottoms are used as parts of heating equipment in various applications such as industrial installations, chemical or pharmaceutical industries, oil temperature cooling, liquid and gas cooling or domestic installations, such as floor heating. Sieve bottoms are a necessary accessory integrated in heat exchangers, thus they are considered as component parts of a complex product.
- (11) Though sieve bottoms might be sold separately, in order to undergo the protection of Article 4 CDR, their individual commercialisation is not sufficient. Contrariwise, the prerequisite is the visibility of the RCD during normal use. In this case, the normal use of a sieve bottom is related to the normal use of a heat exchanger, into which the sieve bottom is integrated. Therefore, it must be considered that the contested RCD relates to sieve bottoms. In their turn, sieve bottoms constitute component parts of a complex product (heat exchanger) that can remain visible during normal use, only under the condition that the heat exchanger is visible during normal use as well.
- (12) Considering the Community design n° 001203004-0001, registered on 19/03/2010 in OHIM and depicting heat exchangers, it is estimated that the sieve bottom of the RCD is visible as the bottom part of the heat exchanger. Even though, it is commonly met that a heat exchanger is integrated into a boiler, the above mentioned Community design does not constitute necessarily part of a boiler and it is not necessarily included in a boiler box during use. Thus, the end user is in a position to have a full and complete view of the registered heat exchanger and, consequently, of all the elements of the sieve bottom registered as a design, while the heat exchanger is in motion.

The sieve bottom is always visible without the necessity of opening a cover door, screwing up the boiler or the heat exchanger or disassembling it.

- (13) In conclusion, the RCD is not deprived of protection within the meaning of Article 4(2) RCD, since it can be applied as a component part of a complex product whose elements are visible during normal use.

B.2 Disclosure

- (14) 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”.
- (15) A detailed analysis of the evidence provided concludes to the following observations:
- The presentation of the Prestige Product range made by the Applicant’s employee Herman Ulens, and depicting designs of 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 03/05/2005, it has not been proven that the facts and images contained were in fact shown in public.
 - The drawings of “Thermont” by “Industrie Montini SrL”, bearing explanatory indications only in Italian and French, cannot be taken into consideration following the provisions of Article 98 CDR and Article 29 CDIR.
 - The document from the company “CSI Ltd.” , not bearing any indication of date or public distribution, cannot be perceived as document of evidence, proving the disclosure of a prior design within the meaning of Article 7 CDR.
 - A far as the group’s general presentation made by the Applicant is concerned, it can not be taken into consideration as document of proof. Even though it bears the indication “Visit at Windhager (7 October 2003)”, no evidence whatsoever has been delivered to confirm that the data included was presented on public on the aforesaid date. Moreover, the presentation having been provided in a CD-ROM, the only date that appears on the electronic file refers to the date of burning of the CD and not the date of creation of the file.
 - The Applicant’s presentation of the Prestige and Heat Master Line boilers 24, 32, 50, 75 and 120, is found to lack of probative value. Despite the fact that the Applicant indicates “October 2006” as date of disclosure to public, it can not be assumed or confirmed that the data included was in fact communicated on the aforesaid date. Furthermore, the evidence having been

provided in a CD-ROM, the only date that appears on the electronic file refers to the date of burning of the CD and not the date of creation of the file.

- As for the e-mail from the Holder's employee, Krzysztof Szczepanski sent on 30/05/2005 to the Applicant's employee, Herman Ulens, it is found to be a private document earmarked for internal communication. 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. Moreover, the drawings of the Prestige 75 KW heat exchanger and the Prestige 50 KW heat exchanger, contained as enclosed documents of the e-mail, are equivalently estimated as private documents that don't prove that said designs were put into production line or disclosed in any way before the date of filing of the contested RCD.

(16) 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.

B.3 Technical function - Interconnection

(17) 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".

(18) Following the aforesaid definition, the OHIM Board of Appeal¹ 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".

(19) 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.

(20) 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 deposited observations. The Application being perceived as an entity composed of both the necessary form and the

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

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.

- (21) A sieve bottom design must necessarily incorporate some features which serve a technical function namely to cover the upper or down bottom of a heating equipment, serve the gas flow and in parallel assure the isolation shield of said equipment. The diameter of the RCD serves to fit perfectly in the cylindrical shape of the heat exchanger while the presence of the holes and openings facilitates the interflow of the gas of the heat exchanger. However, the conical shape and the lines of the heat exchanger, the position, the number and the form of the holes, 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.
- (22) It is considered 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.
- (23) 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.
- (24) Moreover, as accepted above (B.1), the sieve bottom, represented in the RCD, is a necessary component, existing as the bottom part of a heat exchanger. However, none of the features of the contested design are dictated by a "must-fit" condition in relation to its integration in a heat exchanger or a boiler. As far as the interconnection is concerned, only the geometrical parameter of the diameter and the perimeter of the component sieve bottom serve the technical function of the complex mechanical engine. 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.
- (25) In conclusion, the RCD is not deprived of protection within the meaning of Article 8(2) CDR.

C. Conclusion

- (26) 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

- (27) Pursuant to Article 70(1) CDR and Article 79(1) CDIR, the Applicant bears the fees and costs of the Holder.
- (28) 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

- (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

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