



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

OPERATIONS DEPARTMENT – DESIGNS SERVICE

**DECISION OF
THE INVALIDITY DIVISION
OF 09/01/2012**

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

FILE NUMBER	ICD 000008384
COMMUNITY DESIGN	000831789-0001
LANGUAGE OF PROCEEDINGS	English
APPLICANT	Camatic Pty Ltd 93, Lewis road Wantirna South VIC 3152 Australia
REPRESENTATIVE OF THE APPLICANT	Barker Brettell LLP 100, Hagley Road B16 8QQ Birmingham United Kingdom
HOLDER	Bluecube Ltd. 19, Drysdale street N1 6ND London United Kingdom
REPRESENTATIVE OF THE HOLDER	Forrester Ketley & Co Sherborne House 119-121, Cannon street EC4N 5AT London United Kingdom

The Invalidity Division,

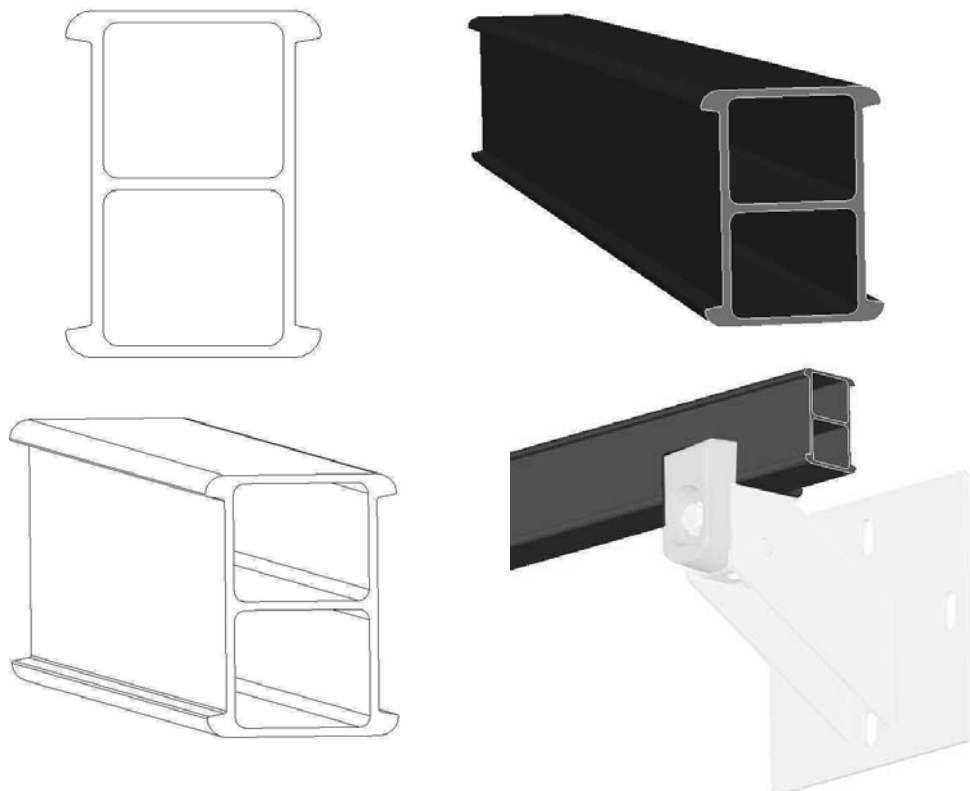
composed of Martin Schlötelburg (rapporteur), Jakub Pinkowski (member) and Natalie Pasinato (member) has taken the following decision on 09/01/2012:

1. **The registered Community design n° 000831789-0001 is declared invalid.**
2. **The Holder shall bear the costs of the Applicant.**

I. FACTS, EVIDENCE AND ARGUMENTS

- (1) The Community design n° 000831789-0001 (“the RCD”) has been registered in the name of the Holder with the date of filing of 23/11/2007. In the RCD, the indication of products reads “seating” and the design was published on 18/12/2007 in the Community Designs Bulletin in the following views:

http://oami.europa.eu/bulletin/rcd/2007/2007_193/000831789_0001.htm



- (2) On 07/03/2011, 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 the invalidation of the RCD on the grounds of Articles 4 to 9 of the Council Regulation (EC) n° 6/2002 on Community Designs (“CDR”).
- (4) As evidence, the Applicant provided *inter alia* a copy of the UK Intellectual Property Office, referring to the publication of the UK Patent GB2414025 and describing a seating support beam.
- (5) In its reasoned statement, the Applicant claims that the RCD is incorporated in a product which constitutes a component part of a complex product, namely seating, and that all the features of the RCD are invisible during normal use. When comparing the prior patent and the RCD, the Applicant argues as well on the incorporation of the RCD stating that “the only difference between the beam shown in the Registered Design and the beam shown in Figure 3 of GB2414025 is a joining line along the upper and lower surfaces of the load bearing beam... The absence of the joining line in the design is a direct result of the method of the construction of making the product as one part rather than as left or right sections”.
- (6) The Holder, responding to the Applicants observations, states that “the support beam product in which the Community Design is incorporated is sold individually to end users. The Community Design as embodied in the support beam product is therefore visible in its entirety in use to the customer and end user. The Community Design is a complete and independent design and not a component which forms part of a complex product”.
- (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 Must-Fit Clause

- (9) 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”.

- (10) According to Recital 10 of the CDR, the purpose of Art. 8(2) CDR is to guarantee that the interoperability of products of different makes is not hindered by extending protection to the design of mechanical fittings.
- (11) The so-called “must-fit clause” of Article 8(2) CDR must be taken into consideration *ex officio* in invalidity proceedings where compliance with the requirements of protection is in issue and where evidence is on file indicating that the requirements of Article 8 CDR are not fulfilled. Features of a contested RCD which are excluded from design protection according to Article 8(1) or 8(2) CDR cannot contribute to the novelty and individual character of the RCD. Therefore, an assessment of the requirements of protection under Article 4, 5 and 6 CDR must necessarily be preceded by an assessment of the requirements of Article 8 CDR within the scope of examination defined by Article 63(1) CDR, namely on the basis of the facts, evidence and arguments provided by the parties.
- (12) The RCD subsists in features of appearance of a seating beam, which is mechanically connected to the interlocking portion of a seating system in order to allow the seat to remain stable while folded or support the load of seat while being used. Evidence for the use of the seating beam in the seating system is provided in the graphical representation of the design, in particular in view number 4 which shows a part of the seating system.
- (13) The features of the RCD consist in the shape and form of an elongated metallic beam, forming a whole part as seen by the outside and divided in two parts in the inside. Its structure is longitudinal and, as observed by the Applicant, this design element results from the construction method of the product. The whole shape and the form of the RCD in general, are imposed by external designing factors and technical restrictions. The beam is necessary for supporting the seating mechanism and as regards to length and structure, the beam has to fit exactly in the module of the interlocking joint surface in order to reassure that the seat stays affixed on the wall and can accomplish a foldable move, at the same time. The shape of the beam must be the inversion of the recess of the corresponding interlocking portions so that it can perform its function as a part of a seating support application.
- (14) The fact that the product depicted in RCD can be sold separately and it does not have to be mounted in a certain way, does not eliminate the fact that the features of the RCD must be reproduced in their exact form and dimensions to fit to a given seating. The shape and the structural elements of the beam are pre-defined by the corresponding

parts of the seating support application, into which the RCD must fit like a key to a key hole.

- (15) In conclusion, the RCD subsists in features of appearance of a seating beam which must necessarily be reproduced in the exact form and dimensions in order to permit the seating support application, into which the RCD is incorporated, to be mechanically connected and perform its function.

C. Conclusion

- (16) Therefore, the RCD is to be declared invalid according to Article 25(1)(b) CDR in conjunction with Article 8(2) CDR.
- (17) The RCD having been found to be a must fit part of a product, the further examination of other grounds of invalidity, shall be omitted.

III. Costs

- (18) Pursuant to Articles 70(1) CDR and 79(1) CDR, the Holder shall bear the fees and the costs of the Applicant.
- (19) The costs to be reimbursed by the Holder to the Applicant are fixed to the amount of 750€, composed of 400€ for the costs of representation and 350€ for the reimbursement of the invalidity fee.

IV. RIGHT TO APPEAL

- (1) 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 this 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

Martin Schlötelburg

Jakub Pinkowski

Natalie Pasinato

