



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

OPERATIONS DEPARTMENT – DESIGNS SERVICE

**DECISION OF
THE INVALIDITY DIVISION
OF 14/05/2013**

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

FILE NUMBER ICD 8721
COMMUNITY DESIGN 001888454-0013
LANGUAGE OF PROCEEDINGS English

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The Invalidity Division,

composed of Ludmila Čelišová (rapporteur), Jakub Pinkowski (member) and Martin Schlötelburg (member), takes the following decision on 14/05/2013:

1. **Registered Community design No 001888454-0013 is declared invalid.**
2. **The Holder shall bear the costs of the Applicants.**

I. FACTS, EVIDENCE AND ARGUMENTS

- (1) Community design No 001888454-0013 (hereinafter 'the RCD') was registered in the Holder's name with a filing date of 07/07/2011 and priority date of 07/01/2011 claimed from US design patent application No 29/382,846. In the RCD, the indication of products reads 'portable display devices'. In the application for the registration of the RCD, the description reads: 'The background and the reflections on the portable display device are not part of the claimed design. Fig. 13.7 is an enlarged view of the right bottom corner of Fig. 13.4.' The design was published in the Community Designs Bulletin in the following views:

http://oami.europa.eu/bulletin/rcd/2011/2011_214/001888454_0013.htm



13.1



13.2



13.3



13.4



13.5



13.6



13.7

- (2) On 05/04/2012, the Applicants filed an application for a declaration of invalidity ('the Application'). The fee for the Application was debited from the current account.
- (3) Using the Office form for the application, the Applicants requested a declaration of invalidity of the RCD on the grounds that the RCD does not fulfil the requirements of Articles 4 to 9 of Council Regulation (EC) No 6/2002 on Community Designs (hereinafter 'CDR').
- (4) As evidence the Applicants provide, inter alia:

A printout of the webpage <http://www.htootayzar.com/myblog/2009/03/apple-touch-screen-netbook-prototypes-hit-the-web/>, containing the article 'Apple Touch Screen Netbook Prototypes Hit the Web', dated 12/03/2009, containing images of 'prototypes' as follows (hereinafter referred as prior designs).





- (5) In the reasoned statement, the Applicants submit that the priority claim from two design patent applications (No 29/382846 and No 29/384911) should not be permitted and at least one of the priority claims is invalid.
- (6) The Applicants hold that the prior designs were disclosed before the date of filing of the contested RCD, and the disclosure was such that it could reasonably be expected to come to the attention of the circles concerned operating within the EEA.
- (7) The Applicants further submit that the prior designs are available on the internet as 'mock-ups', speculations on the appearance of the new version of Apple tablet. According to the witness statement of David Angus Stone, a partner of the Applicants' solicitors, made on behalf of the Applicants, various mock-ups of Apple Touch Screen devices appeared on the internet between 12/03/2009 and 27/11/2009. These mock-ups do not originate from the Holder but were made by fans who were speculating about the possible design of the Holder's tablet computer. The prior designs have a rectangular shape with rounded corners on all sides, and a flat transparent surface on the front, which extends to the edges of the device. Located centrally underneath the flat surface, the prior designs have a screen, which is surrounded by substantial touch-insensitive areas on all sides. Given the similarities between the contested RCD and the prior designs, the same overall impression is conveyed to the informed user, the RCD lacks individual character and it should be declared invalid.
- (8) According to the Applicants, the informed user is the user of tablet computers, equipment for recording or reproduction of sounds or pictures, data processing equipment as well as peripheral apparatus, and devices or communications equipment, wireless remote controls and radio amplifiers, which are the products of three subclasses of the International Classification for Industrial Designs in which the contested RCD was classified at the Holder's request for the registration of the design.
- (9) The Applicants further hold that not all features of the contested RCD should be given the same weight or should be considered at all in the assessment of the individual character. According to the Applicants, supported by the witness statement of WooLong Lee, the Principal Engineer from the Patent & Technology Group of the first Applicant, the freedom of the designer of the given goods is limited by the following features:
 - the product must be made of durable metal or plastic,
 - the product must be light,

- the display screen must be flat to avoid giving a distorted view and to allow easy cleaning as it is supposed to be operated by touching the display,
- the product must be as thin as possible,
- the sides of the product may contain metal as reinforcement in order to prevent damage,
- the screen has to be as large as possible to maximise text/visual/gaming capacity with the strictly limited width of the touch-insensitive area framing the display area to allow the product to be held without unwanted triggering of functions,
- a rectangular shape makes it easy to read documents, is familiar to consumers and is favoured in the manufacturing process,
- the corners must be rounded to avoid catching on clothing or incurring damage during processing, assembly or handling,
- there will usually be at least one button (on/off) and possibly other buttons (volume, etc.),
- many such products now include a camera, and
- many electronic devices require a connection so as to be recharged/powerd.

- (10) The Applicants conclude that the features of a product's appearance that were chosen exclusively for the purpose of designing a product that performs its function are not protectable. Designers of certain functional elements retain freedom to create distinctive designs, but less distinctive designs are less likely to create a different overall impression. The Applicants summarise that less importance and attractiveness towards the informed user will have features common to the design for the goods at issue, features not easily perceived by the informed user and similarities in respect of features imposed by design constraints on the contrary to features where the designer was free to develop the design.
- (11) In the rejoinder the Holder submits that priority has been properly claimed from application No 29/382,864 and submits the images contained in the priority application corresponding to the images in the RCD registration. The Apple logo applied to the product in the priority application but missing in the RCD registration, does not change matters, since the feature is not claimed as being part of the application.
- (12) The Holder further submits that the Applicants do not provide adequate evidence for demonstrating earlier disclosure of the prior designs. The witness statement of David Angus Stone must be disregarded as having a direct interest in the outcome of the proceedings, and any confirmation of facts included in the statement does not have any value as evidence. The disclosure of the prior design could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned and operating within the Community because of the countless number of blogs and websites on the internet. In contrast to published IP rights, which can be easily searched, the knowledge contained in blogs or websites cannot be systematically searched. Thus, since even attentive members of the trade circles in question can only discover blog publications by chance, these have to be disregarded.
- (13) According to the Holder, the prior designs are also subject to the exclusion from the state of art pursuant to Article 7(3) CDR, which must be understood as meaning that a disclosure will not be taken into consideration for the purpose of applying Articles 5 (novelty) and 6 (individual character) 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. The prior designs are obviously 'mock-ups', which are not based on any real product and were created by an obscure, unidentified and unidentifiable blogger by photomontages of various other original products of the Holder. The designs are based on information from leaks within the Holder's group of companies and suppliers. According to the information provided by the bloggers themselves, the basis for these assumed prototypes is mainly information that was supplied to the press by Apple suppliers and insiders without the Holder's consent.

- (14) The Holder further submits that the illustrations of the prior designs do not disclose sufficient details. The images of the prior designs provide a view of the design only from the front; thus, they are incapable of challenging the individual character of the contested RCD and may not be taken into account. Furthermore, the representations of the prior design disclose different versions or prototypes incorrectly presented as 'one design'. As the individual character cannot be denied on the basis of an overall view of a number of different designs, the individual prototypes have to be considered separately.
- (15) With respect to features of appearance dictated by technical function, the Applicants fail to provide any relevant facts or evidence to support this claim. The feature of durability of material and enforced casing made of metal claimed as being solely dictated by the technical function of the product must be dismissed because material is not claimed in the contested RCD. The claimed lightness of the product has no impact on the appearance of the product. Where various design alternatives exist with regard to features listed by the Applicants, particularly the flatness of the product, the size of the screen, the rectangular shape, rounded corners and functional elements like buttons, cameras, etc., the creative freedom of the designer is demonstrated; such features are not solely dictated by the technical function of the product. According to case-law, the informed user pays particular attention to the specific appearance of any functional element.
- (16) Because the Applicants keep silent about the ground of novelty in their submissions, the Holder assumes that they do not consider the prior designs to be identical to the RCD and, hence, the RCD is new.
- (17) Regarding individual character, according to the Holder, the Applicants limit the assessment to the front view, although the back view provides features that are protected by the contested RCD and, therefore, must also be considered. The contested RCD is essentially a rectangular device with a generally symmetrical appearance, with evenly rounded corners and a thin profile, a flat front with a continuous transparent surface, an essentially uniform border behind the transparent surface and surrounding a rectangular display area; a housing with edges surrounding the front as a thin rim, the edges having a tapered portion with a narrow, rounded transition that merges into a substantially curving portion, the narrow, rounded transition being closer to the front, the curving portion merging smoothly into a substantially flat back; with a rectangular feature at the upper, shorter, side of the back. The prior designs do not contain some of these features and include other additional features that do not form part of the contested RCD; therefore, the submission of lack of individual character of the RCD is not founded.
- (18) In the reply to the Holder's observations, the Applicants submit that the priority claim must fail as it is not in respect of the same design according to Article 41(1) CDR.
- (19) The Applicants further hold that the online disclosures are relevant and that the burden to prove that a particular disclosure is too obscure to be excluded from the assessment of novelty and individual character pursuant to Article 7 CDR is on the Holder. It is difficult to conceive of any publication on the internet that would be too obscure, especially in a case about tablet computers. The circles specialised in this sector are particularly 'tech savvy' and information quickly percolates online. The circles specialised in this sector are also likely to be backed by significant commercial resources, allowing them to keep abreast of developments in this highly competitive global industry. Large companies devote significant resources to monitoring competitors' designs.
- (20) Regarding the disclosure of the prior designs, the Applicants submit that the exception pursuant to Article 7(2) and (3) CDR relates to 'the design concerned', i.e. the contested RCD. The prior design is not the same design; hence, it is not excluded from the assessment. The Applicants failed to prove that the prior design is based on the

information from leaks in the Holder's group of companies and suppliers. The submitted documents do not establish that genuine images have been leaked, but rather that fans have imagined what future products may look like. This is not an 'abuse' within the meaning of Article 7(3) CDR, which is concerned with scenarios such as theft.

- (21) Regarding the quality of the reproductions, the Applicants hold that the established case-law does not require that a prior design be shown in all views. Inconsistently with its arguments in the invalidity proceedings, the Holder insists in related court proceedings that what matters is the front of the product, as this is how the device is seen by users and in certain positions of usage it is the only surface visible, such as when the user holds the tablet in their hands or uses it by placing it on a flat surface. According to the Applicants, the prior designs can be assessed in terms of the overall impression even if they are not shown in all views in which the RCD is registered, the prior designs are not precluded from assessment even if not shown as clearly as the RCD, and it is not necessary to be able to deduce every feature of the prior design from the disclosure where such features are of little relevance to the overall impression. The evidence submitted by the Applicants is of sufficient quality.
- (22) In the rejoinder the Holder submits that the images of the contested RCD differ from the priority document images only in the 'Apple-Logo'. This difference is, however, immaterial in the sense of Article 5 CDR and, thus, the RCD is identical to the design in the US design patent application. The logo must be disregarded anyway because it is not claimed as being part of the priority application.
- (23) The Holder further submits that Article 7 CDR does not require the Holder to positively show that the relevant circles actually had no knowledge but rather that it is sufficient to demonstrate that knowledge was not possible within the limits of what was reasonable. The facts and background information provided by the Holder about the nature, structure, distribution and popularity of the source as well as the number and variety of different sources in the field have been sufficiently provided as evidence. Blogs or websites similar to blogs as sources of disclosure are not systematically searchable and if all posts on all existing blogs had to be taken into account per se, this would lead to absurd results because it would be necessary to access and check a sheer unmanageable quantity of blogs every day, if not every hour. Obviously, this would not be part of the 'normal course of business'. The website on which the prior designs were disclosed is an uncommon private blog. Even the Applicants do not consider it as a source that could have been reasonably become known to the relevant circles when in other disclosures they rely on 'high-profile industry websites and blogs that specialize in discussing new developments in the electronics and gadgets space'.
- (24) In relation to disclosure of the prior design as an abuse vis-à-vis the Holder, a disclosure which is subject to the exception according to Article 7(3) CDR is not only limited to a disclosure of the contested RCD itself but also to any following 'copies' or 'intended reproductions' disclosed by third parties if these acts result from prior acts of the designer or their successor in title. The relevant test in this regard is individual character within the sense of Article 6 CDR. Should the Office consider that the prior designs and the RCD produce the same overall impression, Article 7(3), (2) would apply and the design would not to be taken into consideration for the purpose of applying Articles 5 and 6 CDR.
- (25) Should the Office consider the prior designs for the test of novelty and individual character, the Holder submits that the documents relating to them do not provide sufficient views and that non-visible views or features must be deemed completely different than those provided by the RCD.
- (26) Regarding the individual character, the Holder reiterates that, as shown by the various design alternatives, none of features have a limited impact on the degree of freedom of the designer of the products concerned nor are they of less importance in determining

the overall impression of the RCD. Likewise, the informed user pays particular attention to the specific appearance of any functional elements. As a result the features in question are neither solely nor 'partly' dictated by technical function and none of the features can be disregarded. The individual character must be assessed by comparing the RCD with each prior design rather than by comparison with the design corpus. It does not comply with the standard of the test of individual character to pick out individual features that can be found in the design corpus and, on this basis, deny individual character of the contested RCD.

- (27) An overall assessment of the design corpus may only be relevant with regard to the degree of freedom of the designer in developing the design, but the Applicants did not name the specific features they consider as being 'common' in the existing design corpus.
- (28) For further details on the facts, evidence and arguments submitted by the parties, reference is made to the documents on file.

II. GROUNDS OF THE DECISION

A. Admissibility

- (29) 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) CDIR¹. Furthermore, the Application complies with Article 28(1)(b)(vi) CDIR, since it 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, therefore, admissible.

B. Substantiation

B.1 Convention Priority

- (30) An application for a Community design may claim the priority of one or more previous applications for the same design or utility model in or for any State party to the Paris Convention, or to the Agreement establishing the World Trade Organisation (Article 41 CDR; Article 8 CDIR). The right of priority is of six months from the date of filing of the first application.
- (31) The effect of the right of priority shall be that the date of priority shall count as the date of filing of the application for a registered Community design for the purpose of Articles 5, 6, 7, 22, 25(1)(d) and 50(1) CDR (Article 43 CDR).
- (32) A priority claim relating to the 'same design or utility model' requires identity with the corresponding Community design without addition or suppression of features (The Manual concerning the Examination of Designs Invalidity Applications. OHIM, June 2012. Section C.5.1.8).
- (33) In the present case, the Holder of the contested RCD claimed priority from design patent application No 29/382,846 filed at the United States Patent and Trademark Office (hereinafter 'USPTO') on 07/01/2011.
- (34) The Applicants claim that the subject matter of design patent application No 29/382846 and the RCD is not the same and, therefore, the priority claim has to be rejected in respect of this application.

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

- (35) The priority application contains a verbal disclaimer regarding the logo, which is not claimed and serves only for illustrative purposes. While the filing office of the priority application does allow such a verbal disclaimer, the applicant for registration of a Community design is allowed to limit the scope of protection only by a graphical disclaimer. Thus the Holder filing the Community design application can either show the logo in dotted lines or use other graphical disclaimer, which is considerably difficult in photographs, or omit it from the representations of the design. In the present case, the applicant deleted the logo from the images. The scope of protection of the claimed design is the same in the priority application as it is in the registration of the Community design. In the absence of harmonised rules for claiming priority from and for different jurisdictions, which impose different formal requirements on the representations of designs, the Office considers the priority claim rightful and the date of priority of 07/01/2011 as effective.

B.2 Disclosure

- (36) According to Article 7(1) 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 before the date of filing of the application for registration of the design or the date of priority, 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.
- (37) 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 or, if a priority is claimed, the date of priority.
- (38) According to Article 7(3) CDR, 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 their successor in title.
- (39) The prior designs were disclosed on the internet. 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.
- (40) Neither restricting access to a limited circle of people (e.g. by password protection), nor requiring payment for access (analogous to purchasing a book or subscribing to a journal) prevent a web page from forming part of the state of the art. It is sufficient if the web page is available without any bar of confidentiality and the accessibility requirements can reasonably be met by the European professionals of the circles concerned.
- (41) The claim is that the disclosure of the prior designs does not meet the latter condition as an event which could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community, because the website, on which the prior designs were disclosed, is a blog-like website publishing contributions according to the interests of its private holder. Such contributions cannot be systematically searched and, therefore, remain unknown to the Community circles specialised in the sector concerned.
- (42) According to the evidence submitted, the images of the prior designs form part of a news article containing the date when the article was posted on the internet. Thus the date of disclosure is accorded. The article contains a range of pictures of 'mock-ups' of Apple products and references to the sources of information and previous publication

of the information and images. Hence, the disclosure of the prior designs was not a single act on the private blog. On the contrary, the disclosure of prior designs did not remain unspotted on the internet and the information was spread by publication on different websites.

- (43) The disclosure is not unsearchable either. To search on the internet, users – either the general public or experts in a particular field of industry – usually use the service of web browsers like Google or Yahoo. Applying key words, users can obtain results of websites dealing with the given subject matter. Thus, the information on the internet is not irretrievable as the Holder suggests.
- (44) The internet is a constantly changing environment. The webpages are updated mostly without archiving previous contents. Thus, the information contained on it appears and disappears in time. However, the prior designs were on the internet and were accessible and retrievable by the Applicants, the Holder and other users, which can include European professionals in the field of communication and information retrieval equipment covering tablets and other portable display devices. The disclosure is not obscure in the sense in which the limitation of the absolute novelty in Article 7(1) CDR was intended according to the *travaux préparatoires*. It is not the situation when a design disappears from mankind's memory in time and is available only in a local museum or traded on a remote local market. An obscure design on the internet would have to be irretrievable or hardly retrievable by ordinary browsers, which is not the case of the prior designs. Therefore, the exception under Article 7(1) CDR does not apply.
- (45) The Holder further claims that the disclosure should not be taken into consideration due to the abuse of the information in relation to the Holder pursuant to Article 7(3) CDR. The article refers to Article 7(2) CDR, limiting the exclusion of particular disclosures from the state of the art for the grace period of 12 months preceding the date of filing or, where the priority is claimed, the date of priority. The article containing the prior designs was posted on the internet on 12/03/2009, almost two years before the date of priority. Therefore, the exception cannot be applied either.
- (46) The fact that the disclosed products were never produced or commercialised, is irrelevant for the assessment of novelty and/or individual character. For the purpose of the tests it is enough if the prior designs are disclosed and the disclosure allows the qualified assessment of their features.
- (47) The Holder claims that the disclosure does not contain one but several designs. The Office agrees with the Holder. The images submitted show two designs: one with a switched-on display in the front view and one half of the design in the side view. The second design is shown in the front and back views. The Office further agrees with the Holder that the first of the two designs is disclosed insufficiently, not allowing an assessment of the overall impression due to the lack of rear view and incomplete side view. For this reason, only the second design is considered a relevant part of the state of the art for the purpose of the application of Articles 5 and 6 CDR and only the representations of the second design (hereinafter 'the prior design') in front and back views will be given further consideration.

B.3 Technical Function

- (48) According to 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.
- (49) In compliance with the Manual concerning the examination of design invalidity applications, Article 8(1) CDR must be interpreted as meaning that the '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' (decision of 22/10/2009, R 0690/2007-3 – 'Chaff cutters', paragraphs 30 et seq.).

- (50) Furthermore, in compliance with the Manual, to determine features solely dictated by technical function, it is necessary to determine what the technical function of that product is. The relevant indication in the application for registration of that design (Article 36(2) CDR) should be taken into account, but also, where necessary, the design itself, in so far as it makes clear the nature of the product, its intended purpose or its function (see, by analogy, judgment of 18/03/2010, T-9/07, 'Representation of a circular promotional item', ECR II-981, paragraph 56).
- (51) The indication of products of the RCD is a 'portable display device'. The representations of the RCD show a flat electronic device with a screen and casing apparently allowing it to be carried or held. The technical function of the product in which the RCD is incorporated is to display information and to allow the user to be mobile, independent of the place of use. In order for the device to be portable, it cannot be excessively large or robust; however, it does not necessarily need to be as thin as possible, as suggested by the Applicants. It is supposed to display information or internet contents; therefore, it requires a screen and elements to trigger and operate the functions of the device. The device requires at least an on/off button and can be equipped with other functionalities and elements like camera, loudspeakers, slots etc. The configuration of the device, the choice, making and placement of the elements, however, is a matter of the designer's will. The Office agrees with the Holder that features of the material like durability are not part of the claim resulting from the registration of the contested Community design, and that weight, since not a visual feature, is outside the scope of the assessment.
- (52) The Manual further states that 'Whether Article 8(1) CDR applies must be assessed objectively, not in the perception of the informed user who may have limited knowledge of technical matters.' Accordingly the Board of Appeal held in decision of 29/04/2010, R 0211/2008-3, 'Fluid distribution equipment', paragraph 35: 'These matters must be assessed objectively: 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 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.'
- (53) The market of portable electronic devices is highly competitive, targeting young people. For both reasons, the products in this field compete in terms of not only their technical features but also their design features. The nature of the product speaks in favour of strong design considerations forced by market requirements. The design of the product plays a significant role in marketing this kind of product. All the components of the products are tuned to the final overall look. The particular shape, proportions of the product and its components and their configuration are carefully considered. The Office did not find anything on file to indicate that the product in which the RCD is incorporated, or any of its parts or elements, were developed under purely functional considerations.
- (54) For the reasons given above, none of the features indicated by the Applicants (flat display, slim profile, shape, rounded corners, functional elements or camera) are considered to be dictated solely by the technical function within the meaning of Article 8(1) CDR.

B.4 Novelty

- (55) 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 or the date of priority. Designs shall be deemed to be identical if their features differ only in immaterial details.
- (56) The contested RCD and the prior design both relate to portable display devices. The designs under comparison have the following common features:
- both the designs are rectangular with evenly rounded corners,
 - both the designs have a front screen rimmed with a narrow line of the casing,
 - the screen is divided into two fields, with a rectangular inside field, which is surrounded by a frame of even width on all four sides,
 - both the designs have two buttons in the screen frame area, each on opposite shorter sides of the device,
 - the casing forms narrow side walls, which turn smoothly in the substantially flat back of the device,
 - both the designs have a dark screen and lighter-coloured casing.
- (57) The contested RCD and the prior designs are different as regards the following features:
- the home button in the prior design is in the shape of an Apple logo while the home button in the RCD is a simple square in the middle of a round, thumb-size recess,
 - the sides in the RCD are bevelled in a more acute angle toward the screen than in the prior design,
 - the RCD contains a switch, a plug, slots, perforation and a rectangular opening in the sides of the casing,
 - the prior design has the Apple logo in the middle of the casing visible from the rear view.
- (58) The Applicants raised the ground of novelty; however, they did not submit any argumentation in this regard. The Office assumes, as the Holder does, that the Applicants do not consider differences in the contested RCD to be immaterial, and, therefore, do not see the prior design as an obstacle to the novelty of the RCD.

B.5 Individual character

- (59) 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 before 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.
- (60) According to the established case law, the informed user is particularly observant, is aware of the state of the art in the sector concerned, and uses the product related to the RCD in accordance with the purpose for which the product is intended (see judgment of 09/09/2011, T-10/08, 'Internal combustion engine', paragraphs 23 to 25).
- (61) In the present case the informed user is familiar with designs of portable display devices. S/he is aware of the designs of products which were available before the date of priority of the contested RCD and s/he is aware of constraints of the designer's freedom given by technical requirements and the function of the device.
- (62) The device has to be portable; it requires a screen to display information and some functional elements to be operated. Portable display devices can significantly differ in

size, ranging from the size of mobile phones to the size of laptops, and they can differ in the ratio of the sides. The screen of the device is expected to have a display and to be rectangular, although the division of the screen or the application of borders around the screen is not dictated by severe constraints. Market tendencies, such as aesthetic or commercial considerations, as argued by the Applicants in connection with flat screens, are not regarded as restrictions to the freedom of the designer (see judgment of 22/06/2010, T-153/08, 'Communication unit', paragraph 58).

- (63) The portable device is supposed to be easily handled, carried, held, placed in bags and easily transported, etc. The user uses the device as such, not only its screen when placed on a flat surface. Thus, the informed user, as particularly observant, takes into consideration not only the front part of the device, even though this is the part of the product which allows its functioning. When making a choice at the time of purchase of the product, the informed user also considers the casing and the overall shape, and s/he is able to differentiate between different products on the market. What matters is not only the functional part of the device but also the shape and design of the body of the device. The informed user is particularly attentive also due to the saturation of the market in the given field, which was very high before the date of priority of the RCD, as follows from numerous examples of prior art submitted by the Applicants. The density in the given field makes the informed user more sensitive to the differences between products with the same or similar function (see judgment of 13/11/2012, T-83/11, 'Radiators for heating', paragraph 81). The user is attentive to even smaller differences between the designs.
- (64) The substantial features of the RCD are the considerably slim profile, flat screen extending over the whole front of the device with borders and home button, line of the casing forming a slim rim around the screen, forming slim sides and smoothly turning into a substantially flat back and contrasting black screen embedded in the lighter-coloured casing. Although each of these features may be part of the design corpus, in combining them the contested RCD differs from the prior art examples submitted. On the other hand, it also has a range of similarities with the prior design.
- (65) The RCD is registered for a particular shape and colour combination of the portable display device. Comparing the prior and the contested designs, they are almost identical on the front side, where the only difference is the shape of the home button. The designs differ in the angle in which the side walls of casing are bevelled toward the back but the contours of the casing are not very different. Though the prior design is not disclosed in a side view, from the images provided it is quite clear that it is slim rather than robust. The contested RCD has the functional elements on its sides, which is not the case in the prior design, however the overall impressions produced by the two opposing designs on the informed user are the same. The RCD does not have individual character with respect to the prior design.

C. Conclusion

- (66) The RCD is declared invalid on the ground of Article 25(1)(b) CDR in conjunction with Article 6 CDR, due to the lack of individual character.

III. COSTS

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

IV. RIGHT TO APPEAL

- (69) 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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