

**DECISION
of the Third Board of Appeal
of 11 September 2024**

In case R 5/2024-3

Ekomill OÜ

Õli, Valgjärve küla
63419 Kanepi vald Põlvamaa
Estonia

Design Holder / Appellant

represented by Patendibüroo Käosaar OÜ, Tähe 94, 50107 Tartu, Estonia

v

Ecosauna Project OÜ

Õli
63419 Valgjärve küla, Kanepi vald
Estonia

Invalidity Applicant / Defendant

APPEAL relating to Invalidity Proceedings No ICD 119 727 (registered Community design No 5 809 746-0001)

THE THIRD BOARD OF APPEAL

composed of S. Stürmann (Chairperson), C. Negro (Rapporteur) and H. Salmi (Member)

Registrar: H. Dijkema

gives the following

Language of proceedings: English

Decision

Summary of the facts

- 1 On 26 October 2018, Eco Oil OÜ (the predecessor-in-title) filed the following registered Community design No 5 809 746-0001 ('the contested RCD') represented in the following views:
 - 2 The indication of the products reads: 'Buildings [transportable], Buildings'.
 - 3 Ownership of the design was transferred to Ekomill OÜ ('the design holder') on 31 august 2022, and the design was duly renewed on 27 October 2023.
 - 4 On 22 September 2022, Ecosauna Project OÜ ('the invalidity applicant') filed an application for a declaration of invalidity of the contested RCD based on Article 25(1)(b) CDR, in conjunction with Article 4 CDR, claiming that the contested RCD lacks novelty and individual character within the meaning of Articles 5 and 6 CDR, claiming in substance that oval-shaped wooden saunas, such as the one manufactured and sold by the Lithuanian company 'Kelmolis UAB' exist at least since 2013. The earlier design is identical to the contested design which therefore lacks novelty and individual character. The size or shape of a small window or a door of a small building cannot alter the overall impression produced on the informed user.
 - 5 In support of its claims, the invalidity applicant provided the following evidence:

A printed screenshot of a post made on the social network Facebook on

22 August 2013, showing an oval wooden building (Annex 3.1) with the following hyperlink:

1. <https://www.facebook.com/kelmolis/photos/pb.100054635521850.2207520000../505139396231084/?type=3>
- 2.

A printed screenshot of a post made on the social network Facebook on July 2014 showing the same oval wooden building (Annex 3.2) with the following hyperlink:

3. <https://www.facebook.com/kelmolis/photos/pb.100054635521850.-2207520000../669020229842999/?type=3>
- 4.

Two printed screenshots of posts made on the social network Facebook dated November 2017 of a German company (Annex 4) with the following hyperlinks:

5. <https://www.facebook.com/saunafaesser.de/photos/pb.100054421992154.-2207520000../2079332962207552/?type=3>

6.

7. <https://www.facebook.com/saunafaesser.de/photos/pb.100054421992154.-2207520000../2083361498471365/?type=3>

8.

- 6 In its reply, the design holder claimed that the evidence submitted could not prove disclosure of the prior designs. It also argued that one single ‘like’ was not enough to consider that the images were actually disclosed in the manner that they could reasonably have become known by the specialised circles since there were no number of views, nor any other data showing the actual disclosure of the designs within the meaning of Article 7(1) CDR. Furthermore, none of the reproductions of the prior designs show in sufficient detail their relevant characteristics. Finally, the contested design differs from those prior designs in features, which the informed user will immediately notice.
- 7 By decision of 2 November 2023 (‘the contested decision’), the Invalidity Division declared the contested design invalid. The design holder was ordered to bear the costs. The Invalidity Division gave, in particular, the following grounds for its decision:

For reasons of procedural economy, the Invalidity Division assessed first the contested design on the grounds of lack of individual character pursuant to Article 6 CDR.

The printed screenshot (Annex 3.1) proves that the picture of the prior design was posted on the Internet on the 22 August 2013, preceding the contested design’s filing date. The design holder failed to establish that certain circumstances had prevented the facts constituting disclosure from becoming known to the circles specialised in the sector concerned, operating in the European Union. in the normal course of business.

The contested design consists of products that are buildings, transportable buildings. They

are simple structures, providing a closed weather-proof space for potential use as a (temporary) living space, or a sauna. The informed user is somebody familiar with the corresponding products available on the market during the relevant period prior to filing date of the contested design, mainly because of their own experience or interest in these products.

Taking into account that the design holder's alleged constraint has not been proven, the designer's freedom in creating this type of buildings seems to be at least average and the said buildings may vary in shape and size, as well as in colours, and materials. Therefore, minor differences between the prior and the contested designs will be insufficient to produce different overall impressions on the informed user.

The comparison of the designs at issue shows that they differ in the positioning of the windows and doors as well as in the windows' shape (rectangular in the prior design and circular in the contested design) and that the designs do coincide in practically all the other features. First and most remarkably, both designs have the same exact shape with a very similar roof.

The form, configuration and overall appearance of the contested design is very similar to that of the prior design, with the exception of where the windows and doors are positioned, the designs are nearly identical. The colour palette and shape of both designs are the same, and they have an extremely comparable roof.

Consequently, the two designs create a similar overall impression because their differences are less pronounced than their obvious similarities. Therefore, the contested design lacks individual character and is declared invalid.

Since the application is fully successful on this ground and on the prior design, there is no need to examine the other ground of Article 25(1)(b) CDR in conjunction with Article 5 CDR invoked, nor the other prior design invoked in the application (Annex 4).

- 8 On 2 January 2024, the design holder filed an appeal against the contested decision, requesting that the decision be set aside in its entirety, and that the invalidity applicant bear the costs. The statement of grounds of the appeal was received on 2 March 2024.
- 9 In its observations in reply received on 3 May 2024, the invalidity applicant requested that the appeal be dismissed, and the design holder bear its own costs.

Submissions and arguments of the parties

- 10 The arguments raised in the statement of grounds by the design holder may be summarised as follows:

The product shown in Annex 4 from the invalidity applicant was initially made available by a German sauna selling company on Facebook (www.facebook.com/saunafaesser.de) between 18 and 25 November 2017. The contested design was filed on 26 October 2018. Therefore, the alleged publication of the prior design falls within the 12-month grace period under Article 7(2) CDR. Therefore, it should not be taken into consideration. Acts of disclosure made by a third person as a result of information provided or action taken by the designer or its successor in title are covered by Article 7(2) CDR. This applies where a third

party has made public a design copied from the contested design because it was previously disclosed within the grace period by the design holder itself.

As regard the design shown in Annex 3, to establish the disclosure event, the following aspects must be considered: (i) the **source** of the design's disclosure, (ii) the **design** being invoked, and (iii) the **date** when the design was disclosed.

The screenshots provided by the invalidity applicant as evidence do not offer clear and sufficient proof. On Facebook, users can change the date of a post, including any photos and videos, to alter the timeline to an earlier date:

9.

Providing a link to content on the internet (e.g., URL) is not sufficient, as the content may have been altered or removed. When a printout or screenshot lacks relevant elements, additional evidence may be provided, which was not the case here. The image does not show the URL and the content of the Facebook post could not be verified via the active link included in the invalidity applicant's observations.

Moreover, printouts from Facebook are from non-independent and biased sources because the pages belong to former buyers of the designer holder, who might be interested in the invalidity of the contested design. Furthermore, it is one of the design holder's former employee, and now acting as Management Board Member of the invalidity applicant who 'liked' the photo on the Facebook page. User comments left on e-commerce platforms or in social media might be relevant when assessing disclosure – but in the present case, there is only one reaction which is made by the invalidity applicant, and not by the relevant public/consumers/third parties. As a conclusion, there are serious aspects which raise doubts as to the authenticity of the evidence as there are reasons for manipulating the relevant information. Such proof originating from the invalidity applicant itself or related persons should be corroborated by additional evidence (which the invalidity applicant has not provided).

The views of the earlier design submitted do not enable its comparison with the contested design due to the quality of the photos, the size of the product and its partial depiction. These images are too vague to identify the features in sufficient detail. Therefore, it does not amount to a disclosure within the purpose of Article 7(1) CDR.

It is evident that the designs have different overall impressions as they differ in features,

which will be immediately noticed by the informed user. Since the differences are not immaterial, the contested design is also new.

11 In reply, the invalidity applicant raised, in particular, the following arguments:

Sufficient proof of disclosure of the prior design was submitted. The invalidity applicant did not contact any of the account owners during the proceedings and the latter had no interest in the revocation of the contested design. The design holder does not provide evidence to prove cooperation.

The dates of the posts were not changed. Moreover, Facebook does not allow changes of the post content (images) and the real uploading date is visible to the account owner even when the date has been changed.

Reasons

12 The appeal complies with Articles 56 and 57 CDR and Article 34 CDIR. It is, therefore, admissible. It is also well founded, for the reasons exposed below. The contested decision must be annulled and the application for a declaration of invalidity must be rejected in its entirety.

Article 25(1)(b) CDR in conjunction with Article 4 CDR

13 Under Article 4 CDR, a design is protected to the extent that it is new and has individual character.

14 According to Article 5 CDR, a design shall be considered to be new if no identical design has been made available to the public, that is to say a design differing only in immaterial details. According to Article 6(1)(b) CDR, a registered Community design is to be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which 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. Paragraph 2 of the same provision establishes that the degree of the designer's freedom is to be taken into account in the assessment.

Disclosure of the prior designs – Article 7 CDR

15 Pursuant to Article 7(1) CDR, for the purposes of applying Article 5 or Article 6 CDR, a design is to 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 filing date or, as the case may be, the priority date 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 European Union.

16 The provisions of the CDR and the CDIR do not specify the kind of evidence the invalidity applicant is required to furnish in order to prove the disclosure of the prior design on which the application for a declaration of invalidity is based. Article

28(1)(b)(v) CDIR only provides that ‘documents proving the existence of those earlier designs’ must be submitted. It follows that, on the one hand, the invalidity applicant is free to choose the evidence it considers useful to submit in support of its application for a declaration of invalidity and that, on the other, the Office is required to examine the evidence in its entirety in order to establish if there is sufficient proof of a prior disclosure (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 23).

- 17 In order to establish the disclosure of a prior design, an overall assessment must be made taking into account all the relevant circumstances of the particular case. Furthermore, the disclosure cannot be proved by means of probabilities or suppositions but must be demonstrated by solid and objective evidence. Such evidence must be considered in its entirety. In order to assess the evidential value of a document, it is necessary to verify the plausibility and the accuracy of the information which that document contains taking account of, inter alia, the origin of the document, the circumstances in which it came into being, the person to whom it was addressed and whether, on its face, the document appears to be sound and reliable (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 24-26).
- 18 It is settled case-law that the disclosure of an earlier design cannot be proved by means of probabilities or suppositions, but must be based on solid and objective facts (15/03/2023, T-89/22, Chairs, EU:T:2023:132, § 31; 17/05/2018, T-760/16, Baskets for bicycles, EU:T:2018:277, § 42; 27/02/2018, T-166/15, mobile telephone, EU:T:2018:100, § 23-25; 09/03/2012, T-450/08, Phials, EU:T:2012:117, § 24-26).
- 19 In the present case, the application for a declaration of invalidity was based on two prior designs, D1 and D2.

Prior design D1

- 20 The invalidity applicant invoked as prior design D1, an oval-shaped wooden sauna as manufactured and sold by a Lithuanian company. It provided as evidence of disclosure two screenshots of two posts allegedly from Facebook, dated 22 August 2013 and July 2014 (Annex 3), and indicated two hyperlinks in its observations. It did not file any additional evidence at the appeal stage.
- 21 The Invalidity Division considered that this evidence constitutes sufficient proof of disclosure. The Board does not concur.
- 22 Although the appearance of a picture of a design on the internet constitutes a publication within the meaning of Article 7(1) CDR (20/10/2021, T-823/19, Bobby pins, EU:T:2021:718, § 32), the invalidity applicant must provide solid evidence of this event of disclosure.
- 23 To establish disclosure, a printout or a screenshot should show the full URL address of a website, demonstrating the source of design disclosure on the internet (20/10/2021, T-823/19, Bobby pins, EU:T:2021:718, § 33-34).
- 24 As correctly pointed out by the design holder, the indication of a hyperlink in the invalidity applicant’s observations cannot suffice in this respect. Hyperlinks or URL addresses *per se* cannot be considered sufficient evidence for proving the disclosure of

a prior design. Even if these are active, they should be supplemented with additional evidence, such as a printout or a screenshot of the relevant information contained therein (07/02/2007, T317/05, Guitar, EU:T:2007:39, § 43) including the full URL address. This is because information accessible through a hyperlink or URL address may later be altered, removed or difficult to identify. Even assuming that the URL link would display the screenshot, as shown in Annex 3, it is impossible for the Board to ascertain whether the content to be found under the hyperlink has been changed or removed over time.

- 25 In this regard, the Board notes that this assessment aligns with the ‘CP 10 Common Practice - Criteria for assessing disclosure of designs on the internet’ (Section 2.4.4, p. 29) established by the IP offices of the European Union in the framework of the European Union Trade Mark and Design Network, with the purpose of offering guidance on the sources, reliability, presentation, and assessment of online evidence. Accordingly, when the screenshot does not contain all relevant information, namely source, date, and depiction of the invoked prior design, additional evidence should be submitted. Although these texts are not binding for the Board, it may take it into account in its decision-making process.
- 26 Considering that the screenshots provided do not show the source of disclosure, and that the event of disclosure cannot be proved by means of probabilities or suppositions but must be demonstrated by solid and objective evidence (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 24-25), the Board finds that the invalidity applicant failed to submit sufficient proof of disclosure of the prior design D1 within the meaning of Article 7(1) CDR.

Prior design D2

- 27 The invalidity applicant invoked as prior design D2, a sauna commercialised by a German company and provided as evidence of disclosure two screenshots of two posts allegedly from Facebook, dated 18 and 25 November 2017 (Annex 4), and indicated two hyperlinks in its observations. It did not file any additional evidence at the appeal stage.
- 28 The Board notes that, as for D1, the screenshots submitted as evidence of disclosure for D2 do not contain the full URL address. Therefore, the same reasoning as above equally applies to D2.
- 29 Consequently, the Board finds that the invalidity applicant also failed to submit sufficient proof of disclosure of the prior design D2 within the meaning of Article 7(1) CDR.

Conclusion

- 30 Given that disclosure in accordance with Article 7(1) CDR is a prerequisite for applying Articles 5 and 6 CDR, the application for a declaration of invalidity based on Article 25(1) (b) CDR in conjunction with Article 4 CDR is rejected, without it being necessary to examine the novelty or the individual character of the contested design.
- 31 The appeal is upheld and the contested decision is annulled.

Costs

- 32 Since the appeal has been successful, the invalidity applicant must be ordered to bear the fees and costs incurred by the design holder in the appeal and the invalidity proceedings, in accordance with Article 70(1) CDR.
- 33 Upon request from the parties, the Board orders the invalidity applicant to reimburse the appeal fees of EUR 800 paid by the design holder pursuant to Article 79(6) CDIR, and fixes the representation costs to be reimbursed by the invalidity applicant at EUR 400 for the invalidity proceedings, and at EUR 500 for the appeal proceedings, in accordance with Article 79(7)(f)(ii) and (iv) CDIR. The total amount for both proceedings is therefore EUR 1 700.

Order

On those grounds,

THE BOARD

hereby:

- 1. Annuls the contested decision and rejects the application for a declaration of invalidity.**
- 2. Orders the invalidity applicant to bear the costs and fees incurred by the design holder in the invalidity and appeal proceedings in the total amount of EUR 1 700.**

Signed

S. Stürmann

Signed

C. Negro

Signed

H. Salmi

Registrar:

Signed

H. Dijkema