



OPERATIONS DEPARTMENT

I406B

Alicante, 26/02/2018**BRINKHOF
De Lairessestraat 111-115
NL-1075 HH Amsterdam
PAÍSES BAJOS****Notification to the holder of a decision**

<i>Your reference:</i>	SAH/20160260
<i>Invalidity number:</i>	ICD 10140
<i>Contested Community design:</i>	001688847-0002
<i>Language of proceedings:</i>	English
<i>Name of the applicant:</i>	Pacovis AG
<i>Fax number:</i>	00 31-203053201

Please see the attached decision which ends the abovementioned invalidity proceedings. It was taken on **22/02/2018**.

Katarina ČAVOR**Enclosures (excluding the cover letter): 17 pages.****By fax: 00 31-203053201 & registered mail**

INVALIDITY No ICD 10 140

Pacovis AG, Grabenmattenstrasse 19, 5608 Stetten, Switzerland (applicant),
represented by **Arnold & Siedsma**, P.O. Box 71720, 1008 DE Amsterdam,
Netherlands (professional representative)

against

Natural Tableware BV, Gedempt Hamerkanaal 179, 1021 KP Amsterdam,
Netherlands (holder), represented by **Brinkhof**, De Lairesestraat 111-115, 1075 HH
Amsterdam, Netherlands (professional representative).

On 22/02/2018, the Invalidity Division takes the following

DECISION

1. The application for a declaration of invalidity of registered Community design No 001688847-0002 is rejected.
2. The applicant bears the holder's costs, fixed at EUR 400.

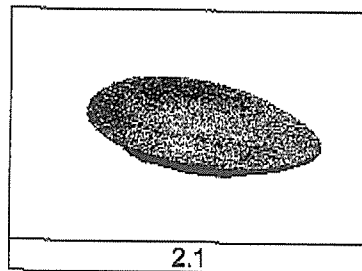
REASONS

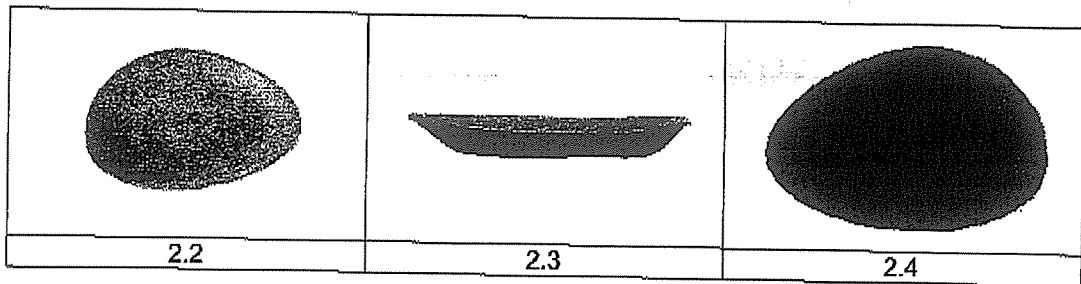
The applicant filed an application for a declaration of invalidity (the application) against Community design No 001688847-0002 (the RCD). The RCD was filed and registered in the name of Hampi Products v.o.f. on 30/03/2010, and was subsequently transferred to the holder.

The following products are indicated in the registration:

07-01 *dishes.*

The registration contains the following images:





Please note that the images in this document are not necessarily to scale.

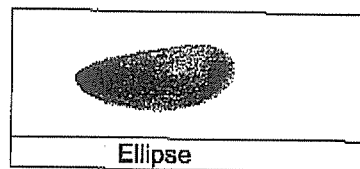
The applicant invoked Article 25(1)(b) CDR in conjunction with Article 4(1) CDR.

SUMMARY OF THE PARTIES' ARGUMENTS

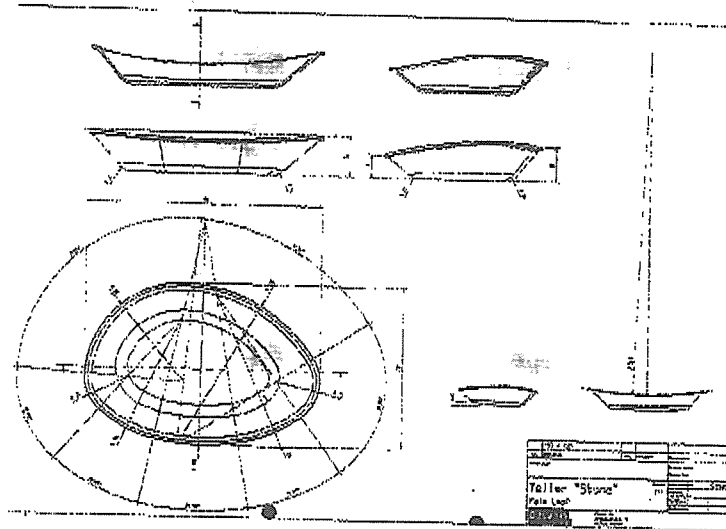
The applicant argued that the RCD lacked novelty with respect to a design that was disclosed prior to the RCD filing date. The applicant had created a very similar design in August 2009, and commercialised and published it in February 2010. The RCD also did not meet the requirement of individual character because, considering the overall impression produced, it did not differ from other previously disclosed designs.

In support of its observations, the applicant submitted the following evidence:

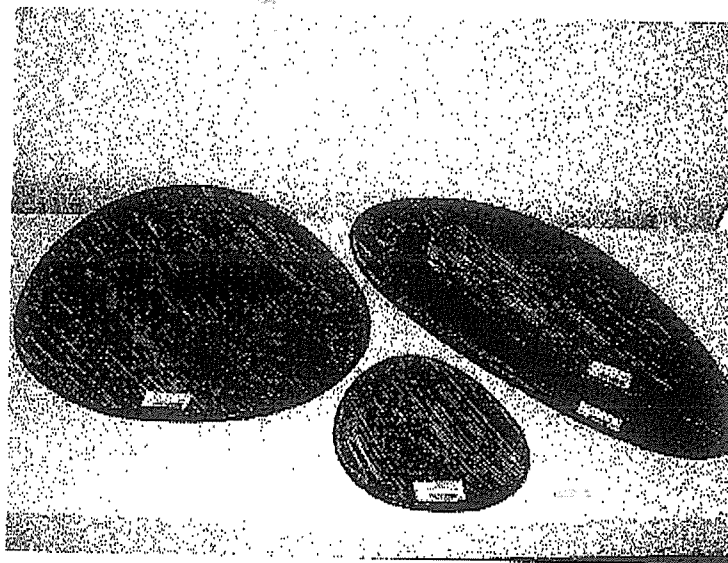
- A copy of the applicant's 'leaflet' 'naturesse innovations 2010', in which the following design of 'Ellipse' plates (Articles N138 and N139) was shown:



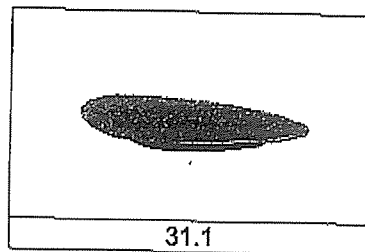
- A purchase order, with its corresponding order confirmation and delivery confirmation, issued by the applicant in the name of The Wholeleaf Co., United Kingdom, in February 2010, which mentions, inter alia, 'Ellipse' Articles N138.400 and N139.100.
- Several invoices that mention Articles N139.100 and N138.400, all dated February 2010 and issued by the applicant in the name of The Wholeleaf Co., Great Britain, except one, which was issued in the name of Planzer AG, Switzerland.
- Two technical drawings of 'Stone' palm leaf plates (the smaller 90 mm x 60 mm and the larger 190 mm x 130 mm), which are identical in form (therefore, only the drawing of the larger plate is shown below):

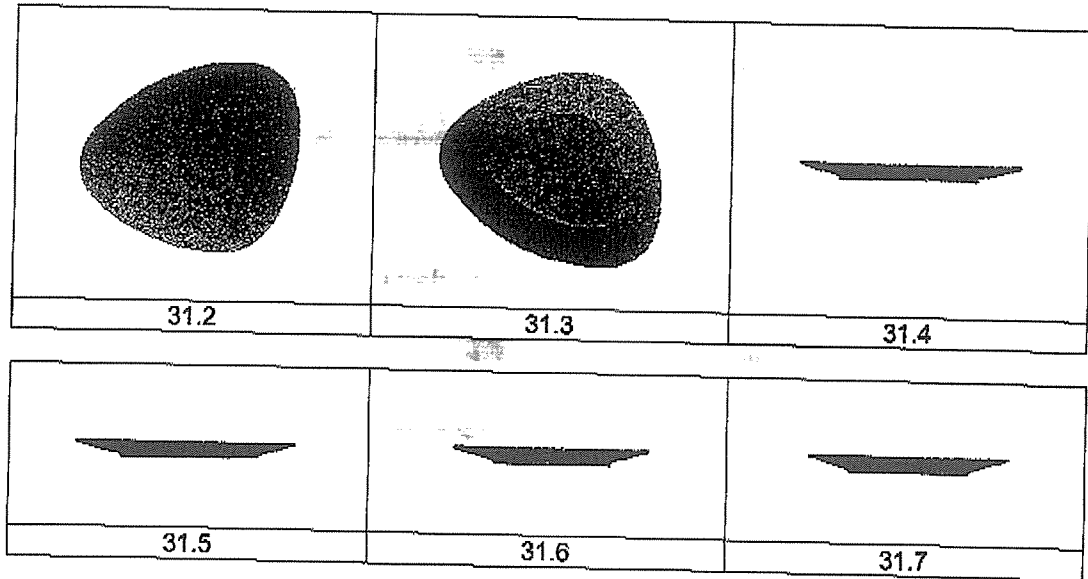


- Email correspondence from 17/12/2010 to 10/01/2011 between the applicant and the former holder of the RCD; part of it is in German.
- An excerpt from the Office's design portal relating to Community Design No 000690805-0008 for *plates [dishes]*, published in the *Community Design Bulletin* on 02/05/2007 and depicted as follows:

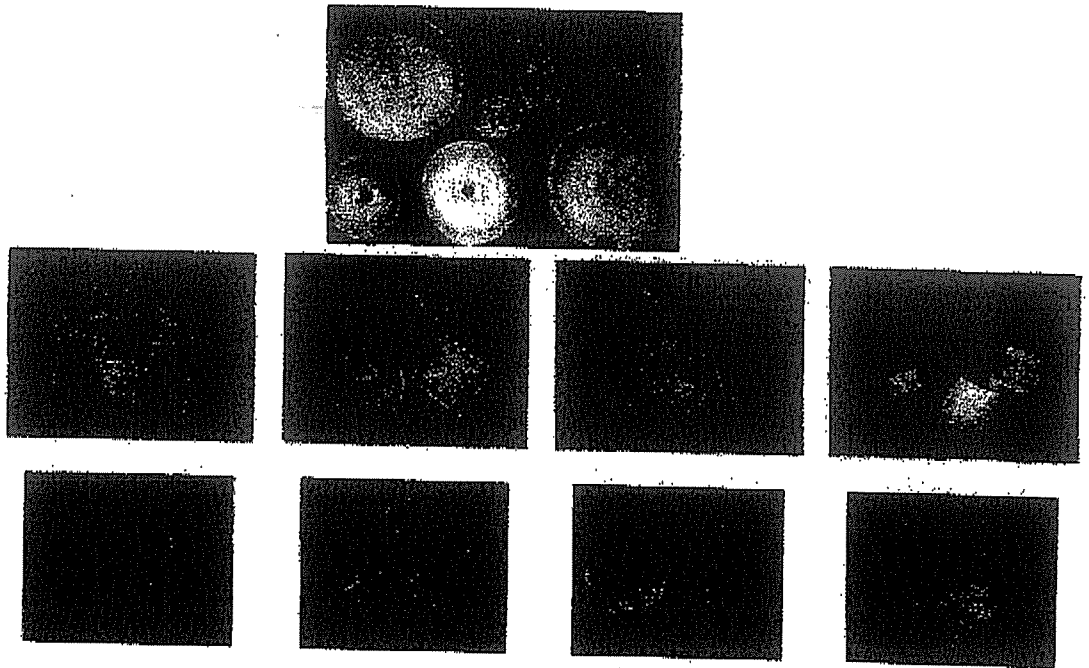


- An excerpt from the Office's design portal relating to Community Design No 000628300-0031 for *dinner plates*, published in the *Community Design Bulletin* on 23/01/2007 and depicted as follows:





- Screenshots from YouTube and the Wayback Machine internet archive that concern 'Areca leaf eco plates', shown on the website of Uniquecrafts, India, and on www.ecopalmleafplates.com. The internet archive extracts bear the dates July and August 2008 and contain the following images of plates:



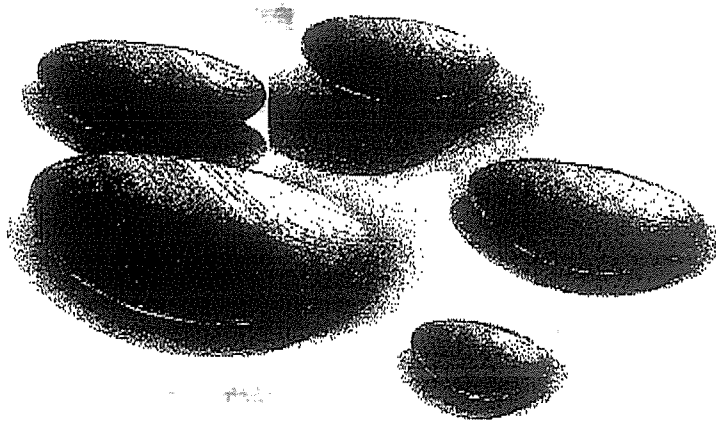
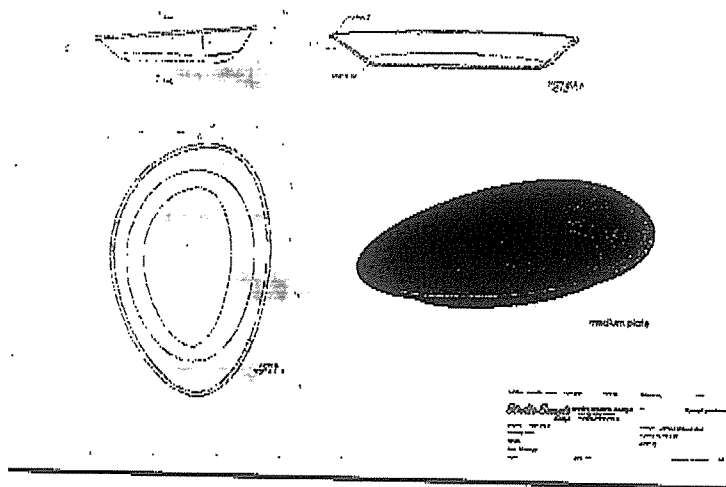
In response to the application, the RCD holder argued that:

- The facts, arguments and evidence presented by the applicant did not demonstrate any pertinent disclosure of the 'Ellipse' plate to the relevant public in the relevant period. No evidence was presented of how the 'leaflet' submitted was disclosed to the public; in addition, the purchase order, confirmation notice, delivery notice and invoices, were very hard to read and therefore it was difficult to understand their relevance. The technical drawings of the 'Ellipse' plate were made on the basis of the holder's plate, and this internal document did not demonstrate any disclosure to the relevant public.

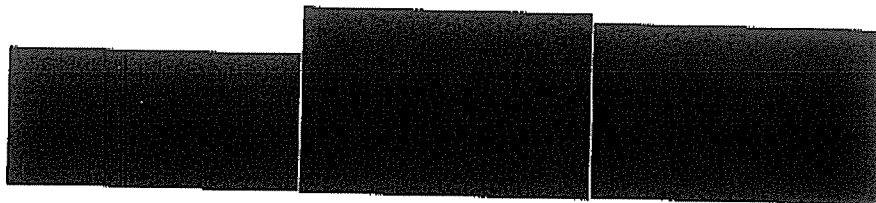
- Furthermore, as regards the disclosure of the applicant's design of 'Ellipse' plates, the holder could rely on the 12-month grace period under Article 7(2) CDR. The applicant's design of 'Ellipse' plates was clearly copied from the RCD, which was pre-disclosed by the holder during the grace period. The disclosure of the applicant's 'Ellipse' plates must have been based on information gained from the holder and therefore must be disregarded in the assessment. In addition, the disclosure of the applicant's design of 'Ellipse' plates was a clear infringement of the copyright of the RCD holder and, at the time, of an unregistered Community design. It should also be disregarded on the basis of Article 7(3) CDR.
- The contested design was incorporated in a plate made from the bark of the Areca palm tree. It was part of the former RCD holder's collection (so-called 'RAAGA' plates), which was designed in December 2008 and disclosed for the first time at the beginning of April 2009. This 'RAAGA' plate was characterised by the following visual features:
 - It was an irregular oval shape.
 - The edges of the plate were raised slightly higher at each end than in the middle, and one end was taller than the other end.
 - The appearance and shape of the plate was rather sleek, streamlined and modern.
 - The texture of the palm bark material from which the plate was made was clearly visible in the design.
 - The surface of the plate was rather smooth;
 - Overall, it was a modern and stylish, yet natural, plate; it was much more than just an oval plate made of palm bark.
- To identify all the characteristic features of the plate, both the design as registered and the design as marketed needed to be considered; therefore, images of the plate as marketed were also submitted.
- The holder had ordered the 'RAAGA' plate to be produced by The Magnus, an Indian manufacturer, and placed it on the EU market prior to the disclosure of the applicant's 'Ellipse' plate. The applicant, as a large European 'player' on the plastic disposable market, must have been aware of this. Seeing its potential, the applicant had apparently decided to make a copy for its own collection. The technical drawings submitted by the applicant of its 'Ellipse' plates were made after the disclosure of the 'RAAGA' plate.
- The technical drawings presented by the applicant were almost identical to the 'RAAGA' plate. There was no doubt that they were based on it. This followed not only from the time line and the circumstances (as explained above), but also from statements made by applicant in pending court proceedings between the parties before the Court of Appeal of Amsterdam. In the context of these court proceedings, the applicant admitted that the 'Ellipse' plates were inspired by a plate that was shown to it by the Indian manufacturer The Magnus.
- Under these circumstances, the onus to prove that the 'Ellipse' plates were independently created in parallel to the holder's design rested on the applicant.
- The other prior designs relied on by the applicant did not affect the individual character of the RCD, since they clearly produced different overall impressions on the informed user from the RCD.

In support of its observations, the holder submitted, inter alia, the following evidence:

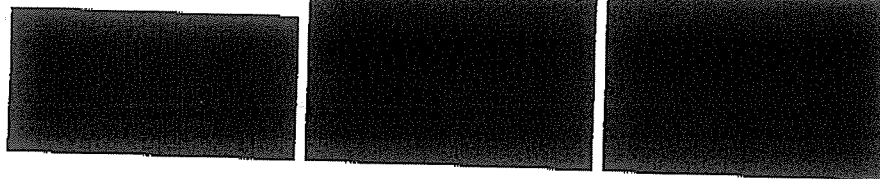
- An email dated 01/12/2008 from Studio Smeets, the creator of the 'RAAGA' plate, regarding the quotation for its creation and a contract vesting the rights in the RCD holder, with a translation of the relevant paragraphs. A screenshot shows that the design of the 'RAAGA' plate was created on 09/01/2009, as follows:



- Pictures of the 'RAAGA' plate as marketed by the RCD holder:



- An invoice dated 15/04/2009, issued by the former RCD holder to a company in the Netherlands, for the first commercialisation of the products incorporating the RCD.
- A bill of lading issued by The Magus, dated 29/05/2009, in relation to the first delivery of the 'RAAGA' plate to the EU.
- An invoice issued by The Magnus, dated 13/04/2009, for shipment to the client in the Netherlands.
- Pages 1 and 18 from the grounds of appeal submitted by the applicant to the Court of Appeal, Amsterdam, with a translation of the relevant part.
- Pictures of the 'Ellipse' plate as marketed by the applicant:



In its rejoinder, the applicant submitted that:

- The characteristic features listed by the holder were not all visible in the registration. Neither the material from which the plate was made nor the differences in the height of the edges of the plate were discernible from the registration.
- The grace period of Article 7(2) CDR, relied on by the holder, was not applicable in the present case. The 12-month grace period before registration did not apply to independently created designs, which could have been cited against the contested RCD.
- All accusations of intentional copying of the contested design or of any other design manufactured by The Magnus were strongly denied. The evidence submitted by the holder did not allow this conclusion to be drawn. Similar plates had already been available on the market and the applicant was inspired by other irregular oval 'organic' plates, including the collection produced by The Magnus. Therefore, the design of the 'Ellipse' plates could be regarded as a melting pot of various ideas, but was not a copy of one specific product. Furthermore, the former RCD holder had admitted on 06/01/2011, in the e-mail correspondence submitted, that it was possible that the applicant had independently designed the 'Ellipse' plates.

The applicant submitted further designs of irregular oval plates that were available on the internet.

In its rejoinder, the RCD holder submitted that the applicant had not presented any evidence that its previously disclosed design of 'Ellipse' plates was created independently from the RCD. The applicant simply insisted that irregular oval-shaped plates had been available on the market prior to the RCD filing date. In any case, the disclosure of the design of the 'Ellipse' plates by the applicant was an infringement of the copyright and unregistered design rights vested in the holder from its creation and disclosure of the 'RAAGA' collection. The designs invoked in addition should not be taken into account.

ARTICLE 25(1)(b) CDR IN CONJUNCTION WITH ARTICLES 4 AND 7 CDR

a) Disclosure pursuant to Article 7 CDR

For the purpose of applying Articles 5 and 6 CDR, the tests of novelty and individual character, a design will 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 RCD filing date or the RCD priority date, if a priority is claimed, 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 EU.

The onus is on the invalidity applicant to prove the disclosure of the earlier designs. There are no provisions in the CDR or the CDIR as to the kind or specific form of

evidence the invalidity applicant is required to furnish to prove that the prior design on which the application for a declaration of invalidity is based has been made available to the public before the relevant date.

Article 28(1)(b)(v) CDR only states that where the ground for invalidity is that the RCD does not fulfil the requirements set out in Article 5 or 6 CDR, the indication and the reproduction of the prior designs that could form an obstacle to the novelty or individual character of the registered Community design, as well as documents proving the existence of those earlier designs have to be contained in the application.

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 of invalidity and that, on the other hand, the Office is required to examine the evidence in its entirety in order to establish whether there is sufficient proof of a prior disclosure within the meaning of Article 7(1) CDR (judgment of 09/03/2012, T-450/08, Phials, EU:T:2012:117, § 21-23).

In this regard, the disclosure of an earlier design cannot be proved by means of probabilities or suppositions, but must be based on solid and objective evidence that proves that the earlier design was made available to the public within the meaning of Article 7 CDR (judgment of 09/03/2012, T-450/08, Phials, EU:T:2012:117, § 24).

With reference to the evidential value of the individual documents, this means that regard should be had first and foremost to the credibility of the content. It is necessary to take account, in particular, of the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, on its face, the document appears sound and reliable (judgment of 09/03/2012, T-450/08, Phials, EU:T:2012:117, § 23, 24, 26).

The case-law further specifies that the items of evidence submitted must be weighed against each other. The reason for this is that, although some of the items of evidence may be insufficient in themselves to demonstrate the disclosure of a prior design, the fact remains that, if they are combined or read in conjunction with other documents or information, they may contribute towards establishing proof of the disclosure (judgment of 09/03/2012, T-450/08, Phials, EU:T:2012:117, § 25).

The applicant submitted a two-page 'leaflet'. The second page displays the applicant's products, namely plates of different shapes, among which are two plates named 'Ellipse', produced in different dimensions but of the same shape. The document looks more like a brochure than a leaflet, and it bears the year 2010 on its first page. The applicant does not mention how, when and to whom the 'leaflet' was distributed; it states only that the design of the 'Ellipse' plates was disclosed in this 'leaflet' in February 2010. This is, however, not supported by the evidence. The document bears only the year; therefore, it can safely be concluded only that it was disclosed by the end of that year. As the contested RCD was filed in March 2010, the disclosure of the designs in the brochure cannot therefore be successfully cited against the contested design.

The applicant also submitted invoices, an order and a delivery confirmation issued by the applicant regarding articles bearing the same identifying numbers and descriptions as the 'Ellipse' dishes in the 'leaflet'. The articles were ordered by and delivered to at least one company situated in the EU in, according to the documents submitted, February 2010, which is one month earlier than the filing date of the RCD. These transaction documents, along with the depiction of the articles in the 'leaflet', are proof that the design of the 'Ellipse' plates was used in trade prior to the RCD filing date. The holder's objections that the documents are of bad quality and that therefore it is

impossible to examine them are rejected, as several of the documents included sufficient data to identify the business transaction and the time it took place, and no deficiencies were found.

The RCD holder also claimed that the disclosure of the design of the 'Ellipse' plates should not be taken into account because the disclosure concerned the design for which protection was sought and the provisions of Article 7(2) CDR should be applied.

According to Article 7(2) CDR, a disclosure must not be taken into consideration for the purpose of applying Articles 5 and 6 CDR if a design for which protection is claimed under a registered Community design has been made available to the public by the designer, his or her successor in title or a third person as a result of information provided by the designer or his or her successor in title during the 12-month period preceding the RCD filing or priority date.

The objective of that provision is to offer a creator or his or her successor in title the opportunity to market a design, for a period of 12 months, before having to proceed with the formalities of filing. The creator or the successor in title may ascertain that the design concerned is a commercial success before incurring the costs relating to registration, without fear that the disclosure that takes place at that time may be successfully raised during any invalidity proceedings brought after the possible registration of the design concerned (judgment of 14/06/2011, T-68/10, Watches, EU:T:2011:269, § 24-25).

From the evidence submitted, it follows that the RCD holder, in late 2008, commissioned a design studio to design the 'RAAGA' plate, which was later, in April 2009, sold to a company in the Netherlands. The shipping document from the Indian manufacturer The Magnus is dated May 2009.

The applicant claimed that its 'Ellipse' plate was created in August 2009 and was inspired by, *inter alia*, a plate made by the Indian manufacturer The Magnus. If compared, the RCD and the 'Ellipse' plates are very similar, if not identical, in their irregular oval shape and wood-like pattern. The two designs can be seen as quite shallow irregular oval plates with a smooth surface and a thin horizontal rim in all of the visual depictions submitted by both parties, namely in the drawing of the 'RAAGA' plate (which is allegedly the original design of the palm tree plate), the technical drawings of the applicant's 'Stone' plates, the applicant's 'Ellipse' plate as advertised in the 'leaflet', the RCD registration and the images used in the Dutch court proceedings (submitted by the holder, and allegedly showing how the plates of both parties are offered on the market). In the Invalidity Division's view, although the applicant strongly denies any intentional copying of the holder's 'RAAGA' plate and the former RCD holder admitted in email correspondence with the applicant that the applicant's 'Ellipse' plate might have been an independent creation, there is a link between the two parties as competitors on the EU market through the Indian manufacturer. The very similar appearances of the competing products also suggest that the applicant was more than just inspired by the holder's 'RAAGA' plate and, although this does not prove that it was directly copied, any indirect or subconscious copying cannot be excluded. Under these circumstances, the Invalidity Division is of the opinion that the RCD holder is correct to claim that the applicant's design of the 'Ellipse' plates should be disregarded in the assessment of the contested design, in accordance with Article 4(1) CDR.

The RCD holder submitted sound evidence demonstrating that the disclosure of the applicant's design of the 'Ellipse' plates could have resulted from information provided to the applicant by a third party and that the applicant could reasonably have learned about the commercialisation of the holder's earlier design of the 'RAAGA' plate in the

EU. The applicant did not rebut these allegations and did not submit any solid evidence of independent development of the design of the 'Ellipse' plates, which strongly resemble the contested RCD.

In accordance with Article 7(2) CDR, the cited design of 'Ellipse' plates as disclosed in the course of business in February 2010 is therefore not taken into account in the following assessment of the novelty and individual character of the contested RCD.

Furthermore, the applicant submitted a video from YouTube and stills extracted from the video. The stills, as correctly pointed out by the RCD holder in its submission, do not show any plates comparable to the RCD. As regards the video, the Office is not in a position to identify which of the designs shown in it is to be considered an obstacle to the validity of the contested design, unless the applicant clearly indicates it, for instance in the stills submitted.

The same argument must be raised as regards the disclosure of the designs of plates on the internet, submitted in the application for a declaration of invalidity. From the images submitted, it is not clear which, out of the collection of plates displayed, should be considered the relevant prior design constituting an obstacle to the individual character of the contested RCD.

The Invalidity Division is not required to determine, through assumptions and deductions, which of the earlier designs among those depicted in the applicant's documentary evidence may be relevant if the applicant does not submit further specifications in this respect.

In accordance with Article 28(1)(b)(v) CDIR, the application for a declaration of invalidity of a Community design that is based on Article 5 or 6 CDR must contain the indication and the reproduction of the prior designs that could form an obstacle to the novelty or individual character of the contested Community design, as well as documents proving the existence of those prior designs.

The applicant gave no specification of or clear instructions about the designs in the disclosure on the internet; therefore, these documents are disregarded.

As regards the additional designs invoked by the applicant at a later stage, the subject matter of the proceedings must be stated in accordance with Article 28(1)(b)(v) CDIR, cited in the application, in relation to both the contested Community design and the invoked earlier designs. Reliance on additional earlier designs and/or rights is inadmissible when submitted at the belated procedural stage of the reply if the effect is to alter the subject matter of the proceedings (decision of 22/10/2009, R 690/2007 3, Chaff cutters, § 44 et seq.).

The admissibility of additional facts, evidence and arguments relating to earlier designs and/or rights already referred to in the application is subject to the discretionary powers conferred on the Invalidity Division under Article 63(2) CDR.

This provision allows the Invalidity Division to take into consideration evidence that is directly associated with evidence already submitted, namely additional evidence that is intended, for example, to provide proof of the publication of an undated document. However, Article 63(2) CDR does not permit the subject of the proceedings to be extended by allowing the applicant to base its application on further earlier designs. Such an action would extend the proceedings and alter the subject of the proceedings. Hence, the designs invoked by the applicant in the response to the holder's observations are not admitted.

Since Article 7 CDR lays down that disclosure is a pre-requisite for applying Article 5 and Article 6 CDR, there is no need to consider further invalidity based on the lack of novelty or individual character insofar as it is based on the designs mentioned above.

Furthermore, the two excerpts submitted from the Office's design database bear the dates the designs were published, which were both prior to the RCD filing date; therefore, the designs are deemed to be disclosed pursuant to Article 7(1) CDR.

b) Novelty pursuant to Article 5 CDR

Article 5(1)(b) CDR provides that a registered Community design must be considered to be new if no identical design has been made available to the public before the date of filing of the application for registration of the design for which protection is claimed or, if priority is claimed, the date of priority. Article 5(2) of that regulation provides that designs must be deemed to be identical if their features differ only in immaterial details.

The applicant raised this ground with respect only to the design of the 'Ellipse' plates. However, it has been decided that the disclosure of this design will not be taken into account pursuant to Article 7(2) CDR. Since Article 7 CDR lays down that disclosure is a pre-requisite for applying Article 5 and Article 6 CDR, there is no need to consider further invalidity based on the lack of novelty or individual character insofar as it is based on the design of the 'Ellipse' plates.

As regards the invoked Community designs No 000690805-0008 and No 000628300-0031, the invalidity applicant expressly cited these two designs as an obstacle to the individual character of the RCD. The holder submitted its observations on the basis of this invalidity ground. The Invalidity Division therefore proceeds with the assessment of the RCD's individual character with respect to these two prior designs.

c) Individual character pursuant to Article 6 CDR

Under Article 6(1)(b) CDR, a registered Community design must 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 that has been made available to the public before the date of filing of the application for registration of the design for which protection is claimed or, if priority is claimed, the date of priority. Article 6(2) CDR states that, in assessing that individual character, the degree of freedom of the designer in developing the design must be taken into consideration.

Recital 14 CDR provides that, when assessing whether a design has individual character with respect to the existing design corpus, it is necessary to take into consideration the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs.

It follows from the above that the assessment of the individual character of a Community design with respect to any earlier design disclosed to the public must, in essence, proceed from a four-step review:

- the sector of products in which the compared designs are incorporated or to which they are applied,

- the informed user of the products according to their purpose and, in reference to the informed user:
 - the degree of knowledge of the state of the art, and
 - the degree of attention in the comparison, direct if possible, of the designs,
- the degree of freedom of the designer in the development of the designs, and
- the result of the comparison of the designs, taking into account the overall impressions produced on the user by the contested design and any of the earlier designs. The assessment should not be simply an analytical comparison of a list of similarities and differences (judgments of 18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 54-84; 20/10/2011, C-281/10 P, Metal rappers, EU:C:2011:679, § 53-59; 07/11/2013, T-666/11, Gatto domestico, EU:T:2013:584, § 21).

The comparison should focus on the contested design as registered and must be based on the elements which are actually protected, without regard to the features excluded from the protection (judgments of 14/06/2011 T-68/10, Watches, EU:T:2011:269, § 74; 07/11/2013, T-666/11, Gatto domestico, EU:T:2013:584, § 30).

The designer's degree of freedom in developing a design is established, *inter alia*, by the constraints of the features imposed by the technical function of the product or an element thereof, or by statutory requirements applicable to the product. Those constraints result in a standardisation of certain features, which will thus be common to the designs applied to the product concerned (judgments of 09/09/2011, T-10/08 & T-11/08, Internal combustion engine, EU:T:2011:446, § 32, 47; 18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 67).

The General Court has refused to allow a general design trend to be regarded as a factor that restricts the designer's freedom, since it is precisely that freedom on the part of the designer that allows him to discover new shapes and new trends or even to innovate in the context of an existing trend (judgment of 13/11/2012, T-83/11 & T-84/11, Radiatori per riscaldamento, EU:T:2012:592, § 95).

When assessing the individual character of a design taking into account the existing design corpus, the degree of freedom of the designer in developing the design may be such as to make informed users more sensitive to differences between the designs under comparison (judgment of 13/11/2012, T-83/11 & T-84/11 Radiatori per riscaldamento, EU:T:2012:592, § 81), as may the manner in which the product at issue is used, in particular the way it is usually handled (judgments of 22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 66; 07/11/2013, T-666/11, Gatto domestico, EU:T:2013:584, § 30).

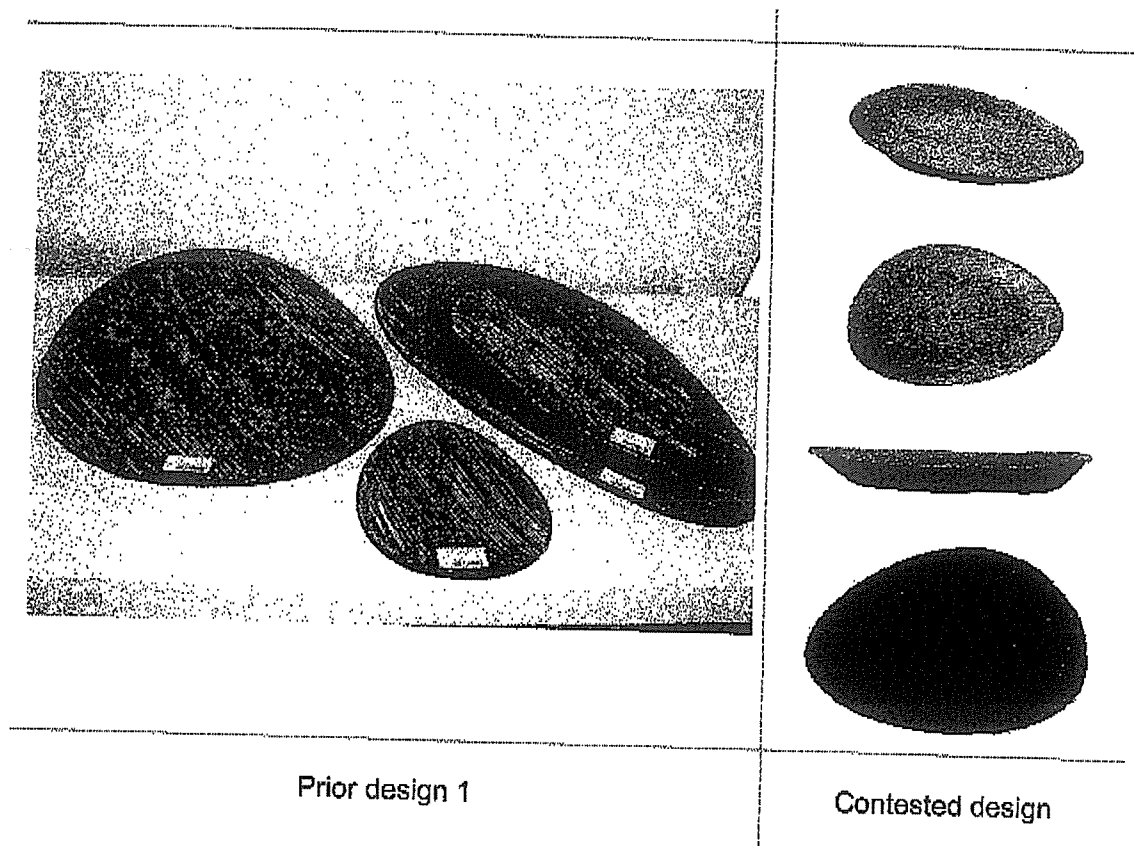
The informed user is a legal fiction that must be understood, depending on each case, as an intermediate concept between the average consumer, applicable in trade mark matters, of whom no specific knowledge is required and who, in general, does not perform a direct comparison between the marks, and the man of the art, applicable in the field of patents, an expert endowed with extensive technical skills and exhibiting a very high degree of attention when directly comparing conflicting inventions (judgments of 18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 53; 25/04/2013, T-80/10, Montres, EU:T:2013:214, § 100). Therefore, a low level of knowledge and a low degree of attention, bringing the informed user closer to the average consumer and further away from the man of the art, reinforce the conclusion that designs that do not present significant differences in the features in which the designer's freedom is unrestricted, produce the same overall impression on the informed user (judgment of 09/09/2011,

T-11/08, Internal combustion engine, EU:T:2011:447, § 33). In such cases, the contested design must be declared invalid due to lack of individual character or, as the case may be, because the allegedly infringing design actually infringes the exclusive right of the holder. A high degree of knowledge and a high degree of attention in the informed user reinforce the opposite conclusion (judgment of 07/11/2013, T-666/11, Gatto domestico, EU:T:2013:584, § 31).

Pursuant to Article 63(1) CDR, in invalidity proceedings, the Invalidity Division is restricted to examining the facts, evidence and arguments submitted by the parties and the relief sought. The Invalidity Division therefore does not carry out its own research. This, however, does not preclude it from also taking into consideration facts that are well known, that is, that are likely to be known by anyone or can be learned from generally accessible sources.

The facts and arguments in a particular case, in principle, must have been known before the RCD was filed; however, facts relating to the design corpus, the density of the market or the designer's freedom should precede the date of disclosure of the prior design.

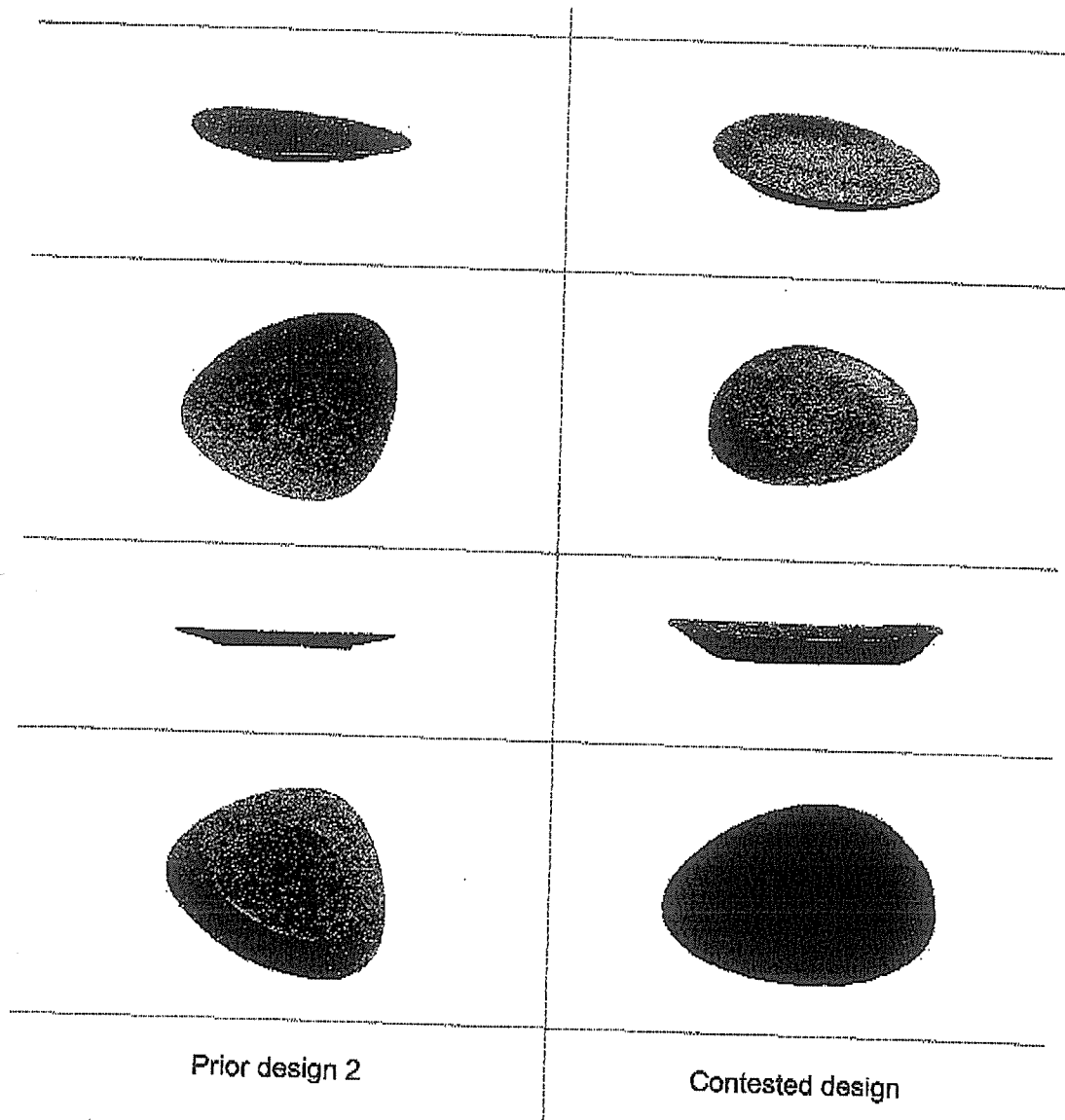
The designs under comparison are shown below:



The applicant pointed out that the RCD differed from prior design 1 only in the pattern created by the material used; however, this could not lead to the designs producing different overall impressions because the pattern was defined by the material used and was therefore not an aspect of the designer's creative freedom; therefore, it should be excluded from protection pursuant to Article 8(1) CDR.

The holder contended that the wooden plates incorporated in prior design 1 were made from a different material, were a clearly different colour and had a different texture from the contested design. The wooden plates of prior design 1 were made of a dark wood with a clear brown/black striped pattern. The contested design was made out of light palm bark. This gave the designs different visual appearances. A plate made out of palm bark (e.g. the contested design) would inevitably differ visually from a plate made out of wood (e.g. prior design 1). Following the definition of a design pursuant to Article 3(a) CDR, not only the material as such but also the colour and texture of the material were relevant, as these elements gave the design a particular visual appearance.

The holder further submitted that the shape of the wooden plates of prior design 1 were clearly different from that of the contested design. The plates of prior design 1 were far flatter and rounder than the contested design, which was shaped more like a small tub (or boat). The edges of the plate of the contested design were raised slightly higher at each end than in the middle, and one end was taller than the other end (and thus it was not flat).



With respect to prior design 2, the applicant pointed out that the designs differed only in their materials, which, it argued, could not lead to the designs producing different overall impressions on the informed user.

The RCD holder contested that the white plate of prior design 2 was made from a clearly different material, was a different colour and had a different texture from the contested design. This plate was made out of white porcelain with a smooth surface, while the contested design was made out of light palm bark. This gave the contested design a different visual appearance from the prior design.

Furthermore, the RCD holder argued that the shape of the plate of prior design 2 was clearly different from that of the contested design. The plate of prior design 2 was flat and shaped like a 'plectrum', whereas the contested design had a characteristic irregular oval shape. The holder added that the plate made out of white porcelain had a distinctive edge on the bottom, which the contested design did not feature.

The sector concerned and the informed user

The contested RCD and the prior designs are incorporated in plates and dishes. The informed user is therefore a person familiar with designs of this type of products.

The designer's freedom

A plate is a dish on which food can be served. Commonly, it is flat, it can be shallow or deep and, although it is convenient for it to be round, nothing precludes the designer from developing and using other shapes and forms. A large variability in contours, lines, materials and patterns is also within the product designer's discretion.

The applicant claimed that the pattern of a plate was determined by the material it was made of and therefore that the pattern should be disregarded from the assessment of individual character. In other words, the applicant argued that the material, not the designer, dictated the pattern of a plate and that therefore the informed user would disregard differences in pattern when viewing the designs of plates.

The Invalidity Division does not agree with the applicant on this point. It is true that the material used determines how the plate looks; however, the choice of material is entirely at the designer's discretion, as long as the material is, from a hygienic point of view, suitable for manufacturing plates. In other words, determining the material is part of the design process; the material has a substantial impact on the appearance of the product and therefore is a design feature for which protection by virtue of a Community design registration is conferred. Nothing on file indicates that the designer was severely limited, as regards the material, by any technical or standardisation constraints.

Furthermore, the designer chooses not only the type of material, but also, for instance, the way it is applied in the manufacturing process of a product, how it is finished and the orientation of the pattern with respect to the shape of the design. The Invalidity Division did not find any reason why, and the applicant did not submit any sound proof to show that, a particular pattern must be used in a plate for a technical reason. The sole argument that the material of the plate determines its pattern cannot justify the pattern being disregarded from the assessment of the individual character of the designs concerned. It is therefore concluded that Article 8(1) CDR cannot be applied in the present case, and that the designer's freedom in the development of plates is broad. Therefore, in accordance with the case-law, differences between the compared

designs that are only minor will be insufficient to confer on the contested design an overall different impression from that of the earlier designs.

The overall impression

As regards prior design 1, the Invalidity Division notes that it is depicted as a set of four plates of different dimensions and slightly different shapes. For the assessment of the individual character of the contested design, the plates in the set have to be considered individually. In addition, the two plates on the left, placed next to each other, are the same shape, which is more rounded than the shape of the two plates on the right, which are stacked on top of each other. For the purpose of the assessment, it will suffice to compare the contested RCD with one plate from each couple, because, although the plates in each couple are of different dimensions, they are of the same design. The plate at the top left is therefore considered as prior design 1A and the smaller plate on top of the other plate on the right is considered as prior design 1B.

In the Invalidity Division's view, the informed user, who is familiar with plates and dishes, will perceive substantial differences between prior designs 1A and 1B, on the one hand, and the contested RCD, on the other. The invalidity applicant argues that the designs are identical as regards their shape; however, the Invalidity Division notes that even prior designs 1A and 1B are not identical. They differ in how elongated their oval shapes are: prior design 1A is more rounded than prior design 1B. The contested RCD seems to be somewhere between those two in shape. Therefore, although it is true that all the designs are irregular ovals, in their exact shape they differ. The same can be said about the contours of the dishes. Whereas prior designs 1A and 1B are formed more like a bowl with a gradual incline towards the rim, the contested RCD clearly has a flat bottom with raised sides and a flat rim. Therefore, their contours are different. The patterns, as noted above, should not be disregarded for the reason argued by the applicant, namely that patterns are determined by the material used. First, the selection of the material is at the discretion of the designer; second, the same material or similar types of materials can be applied to products in different ways, as is true in the present case. Although in both prior designs and the contested design the designer opted for a wood-like material, the pattern and contrasting colours of the material are much more expressive and clear in the prior designs than in the contested design. Moreover, the contested design is of a natural light wood colour, whereas the prior designs are disclosed in monochrome.

The Invalidity Division concludes that the earlier disclosures are insufficient to prove that the RCD does not have individual character, despite the apparent broad degree of freedom of the designers of these products. This is justified by the fact that plates are simple products with only a few visual features. Therefore, each feature, namely the shape, lines, contours, material, pattern and colours, has a substantial impact on the perception of the informed user. In other words, each of the features will be noted by the informed user. The designs under comparison differ in all of their features.

The contested design departs substantially from prior designs 1A and 1B. The designs have only one feature in common, namely their overall irregular oval shape, and this is insufficient to conclude that the overall impressions produced by prior design 1, on one hand, and the contested design, on the other, are the same.

The same conclusion has to be made as regards prior design 2. Although both prior design 2 and the contested RCD are irregular ovals, substantial differences exist between them. First, like in the case of prior design 1, their exact shapes and contours differ: the prior design has no significant rim or sides, but forms one continuous curve all along its surface, whereas the contested RCD has a shallow bottom, sides and a flat

rim. Second, the prior design is made not of wood but rather of porcelain and has no pattern but is instead white or greyish. The contested design, by contrast, is the colour of light wood.

In the light of the foregoing, it is concluded that the contested RCD, in respect of the overall impression that it produces on the informed user, departs from prior designs 1A, 1B and 2. As a result, the RCD has individual character in the sense of Article 6(1)(b) CDR.

The Invalidity Division does not have to give any opinion on the holder's claims of copyright and unregistered Community design rights, as they do not concern the contested design in the present proceedings.

CONCLUSION

The facts and evidence submitted by the applicant do not support the grounds for invalidity under Article 25(1)(b) CDR; therefore, the application is rejected.

COSTS

According to Article 70(1) CDR, the losing party in invalidity proceedings must bear the fees and costs incurred by the other party.

Since the applicant is the losing party, it must bear the costs incurred by the holder in the course of these proceedings.

According to Article 70(1) CDR and Article 79(7)(f) CDIR, the costs to be paid to the holder are the costs of representation, which are to be fixed on the basis of the maximum rate set therein.



The Invalidity Division

Gailė SAKALAITĖ

Ludmila ČELIŠOVÁ

Michelle Marie
DELLACHERIE

According to Article 56 CDR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 57 CDR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to have been filed only when the appeal fee of EUR 800 has been paid.

The amount determined in the fixing of costs may only be reviewed on request. According to Article 79(4) CDIR, such a request must be filed within one month from the date of notification of this fixing of costs and will be deemed to have been filed only when the review fee of EUR 100 has been paid (Annex to CDFR, paragraph 24).

arrest

GERECHTSHOF AMSTERDAM

afdeling civiel recht en belastingrecht, team I

zaaknummer : 200.197.077/01 KG

zaak-/rolnummer rechtbank Amsterdam: C/13/604099 KG ZA 16-259

arrest van de meervoudige burgerlijke kamer van 20 maart 2018

inzake

PACOVIS AG,
gevestigd te Stetten (Zwitserland),
appellante,
advocaat: mr. M.J. Odink te Amsterdam,

tegen

SUSTAINABLE DISPOSABLE TRADING B.V.,
gevestigd te Amsterdam,
geïntimeerde,
advocaat: mr. S.A. Hoogcarspel te Amsterdam

1. Het geding in hoger beroep

Partijen worden hierna Pacovis en SDT genoemd.

Pacovis is bij dagvaarding van 7 juni 2016 in hoger beroep gekomen van het vonnis van de voorzieningenrechter in de rechtbank Amsterdam (hierna: de voorzieningenrechter) van 12 mei 2016, onder bovenvermeld zaak-/rolnummer in kort geding gewezen tussen Pacovis als eiseres en SDT als gedaagde.

Partijen hebben daarna de volgende stukken ingediend:

- memorie van grieven tevens vermeerdering van eis, met producties;
- memorie van antwoord, met producties;
- memorie van antwoord in incidenteel appel, met producties;
- akte na memorie van antwoord aan de zijde van Pacovis;
- akte in reactie op akte na memorie aan de zijde van SDT;
- akte houdende overlegging producties aan de zijde van SDT.

Daags voor het pleidooi, dat was bepaald op 2 februari 2018, heeft Pacovis per faxbericht van 29 januari 2018 het hof bericht het hoger beroep te willen intrekken.

SDT heeft in antwoord daarop het hof bij faxbericht van 30 januari 2018 laten weten aanspraak te maken op vergoeding van haar proceskosten en het hof verzocht, samengevat, onder bekrachtiging van het bestreden vonnis, Pacovis te veroordelen in (primair) de volledige kosten in beide instanties, althans (subsidiar) in de volledige kosten gemaakt na 17 januari 2018 tot en met 29 januari 2018 en voor het overige in de proceskosten op basis van het liquidatietarief, althans (meer subsidiar) in de proceskosten in beide instanties op basis van het liquidatietarief, een en ander te vermeerderen met de wettelijke rente.

Vervolgens heeft Pacovis per faxbericht van 2 [het hof leest:] februari 2018 op voornoemd bericht gereageerd en bezwaar gemaakt tegen de door SDT gevorderde volledige proceskostenveroordeling. Volgens Pacovis kan zij uitsluitend worden veroordeeld in de kosten op basis van het liquidatietarief.

Ten slotte is arrest gevraagd.

2. Beoordeling

2.1 Pacovis heeft te kennen gegeven dat zij het hoger beroep wenst in te trekken. Het hof maakt daaruit op dat zij de tegen het bestreden vonnis gerichte grieven niet wenst te handhaven. Bij gebreke van grieven zal zij in het hoger beroep niet ontvankelijk worden verklaard.

2.2 De kosten van het hoger beroep komen voor rekening van Pacovis. SDT heeft het hof bij voornoemd faxbericht verzocht om, in afwijking van het liquidatietarief, de volledige proceskosten toe te wijzen en daartoe een beroep gedaan op misbruik van procesrecht door Pacovis.

2.3 Het hof gaat aan dit verzoek voorbij. Voor zover SDT zich op het standpunt stelt dat Pacovis zich aan misbruik van procesrecht schuldig heeft gemaakt in de procedure zoals die tot de door SDT in hoger beroep genomen memorie van antwoord is gevoerd, mocht van SDT, mede gelet op de zogenoemde twee-conclusie regel, worden verlangd dat zij dit in die memorie aan de orde stelde. Hetgeen zich nadien heeft voorgedaan (Pacovis heeft een memorie van antwoord in incidenteel appel en een akte na memorie van antwoord ingediend waarop door SDT bij akte is gereageerd, Pacovis heeft vervolgens twaalf dagen nadat de rechtbank Den Haag in de bodemprocedure vonnis had gewezen te kennen gegeven dit hoger beroep niet te willen handhaven) valt, ook tegen de achtergrond van hetgeen voordien in de onderhavige procedure is voorgevallen, in het licht van het betrokken (proces)belang van Pacovis evenmin als misbruik van procesrecht te kwalificeren.

2.4 Het hof zal een kostenveroordeling toewijzen op basis van het liquidatietarief. Wel ziet het hof in het feit dat Pacovis eerst vier dagen voor het pleidooi de onder 2.1 bedoelde kennisgeving aan het hof en de wederpartij heeft gedaan aanleiding om bij de begroting van de kosten op basis van het liquidatietarief de voorbereiding van het pleidooi in aanmerking te nemen en daaraan een punt toe te kennen.

3. Beslissing

Het hof:

verklaart Pacovis niet-ontvankelijk in het hoger beroep;

veroordeelt Pacovis in de kosten van het geding in hoger beroep, tot op heden aan de zijde van SDT begroot op € 718,-- aan verschotten en op € 2.235,-- voor salaris;

verklaart de kostenveroordeling uitvoerbaar bij voorraad;

wijst af het in hoger beroep meer of anders gevorderde.

Dit arrest is gewezen door mrs. E.M. Polak, E.E. van Tuyll van Serooskerken-Röell en A.W.G. Artz en door de rolraadsheer in het openbaar uitgesproken op 20 maart 2018.

mr. J.C.W. Rang

AFGEGEVEN VOOR GROSSE
AAN: *Mr. S.A. Hooftkamp*
DE GRIFFIER