

DECISION
of the Third Board of Appeal
of 6 June 2016

In Case R 1186/2015-3

Magmatic Limited

Shaftesbury Chapel
Union Road
Bristol BS2 0LP
United Kingdom

Invalidity Applicant / Appellant

represented by Briffa, Business Design Centre 52 Upper Street, Islington, London
N1 0QH, United Kingdom

v

Ningbo Yinzhou Yuecheng Children Products Co., Ltd.

Shuqiao Village, Dongqiao Town,
Yinzhou District, Ningbo City 315000
People's Republic of China

RCD Proprietor / Respondent

represented by 2K Patentanwälte Blasberg, Kewitz & Reichel, Partnerschaft mbB,
Schumannstrasse 27, DE-60325 Frankfurt am Main, Germany

APPEAL relating to Invalidity Proceedings No ICD 9 494 (registered Community
design No 2 385 419-0001)

THE THIRD BOARD OF APPEAL

composed of Th. M. Margellos (Chairperson), H. Salmi (Rapporteur) and
E. Fink (Member)

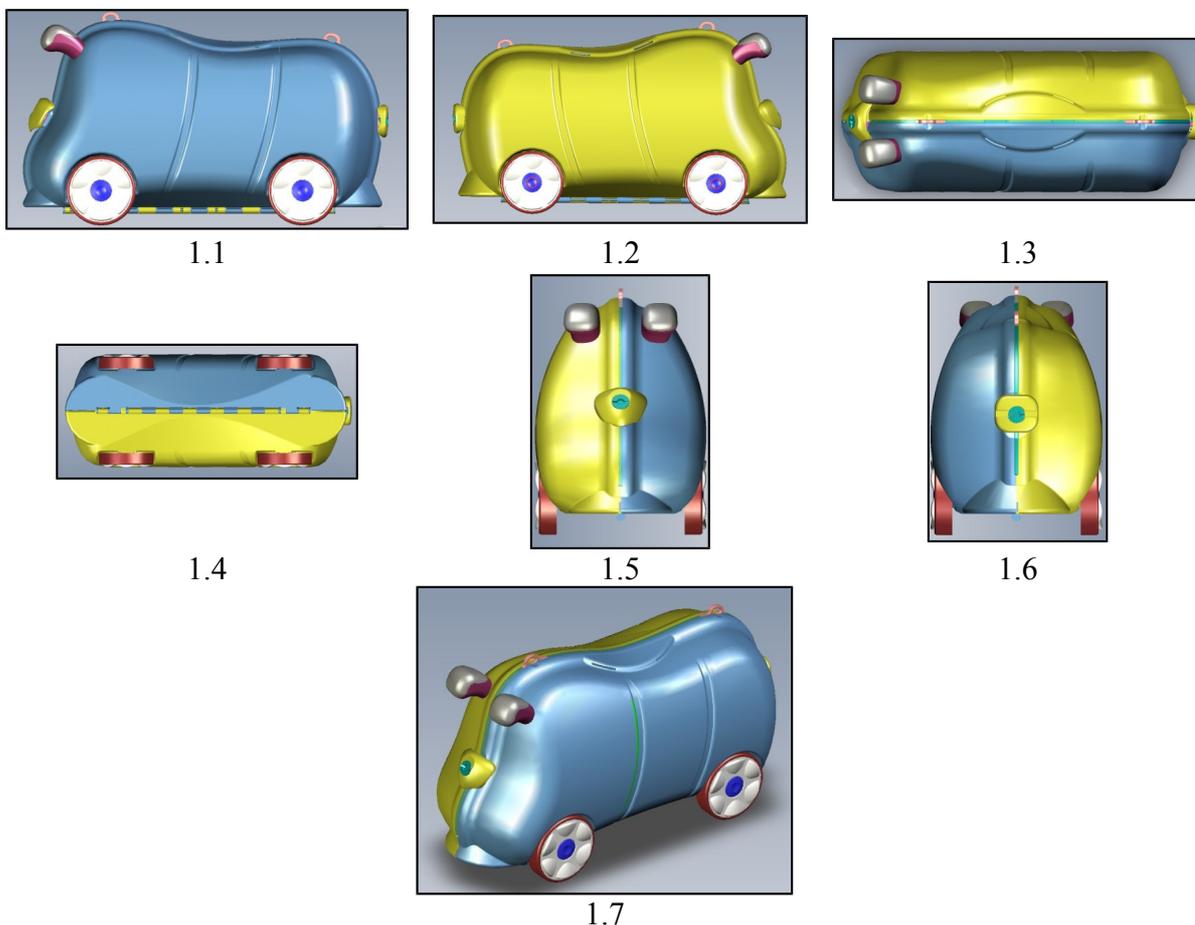
Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 16 January 2014, Ningbo Yinzhou Yuecheng Children Products Co., Ltd. (hereinafter ‘the RCD proprietor’) sought to register the following design in colour (hereinafter ‘the contested RCD’):



- 2 The indication of the products reads ‘suitcases’.
- 3 The design was registered and published in the Community Designs Bulletin No 11/2012 of 20 January 2014.
- 4 On 14 March 2014, Magmatic Limited (hereinafter ‘the invalidity applicant’) filed an application for a declaration of invalidity against the contested RCD. It requested the invalidation of the RCD based on the grounds according to Article 25(1)(b) and (c), (d), (e), (f) or (g) CDR. In the reasoned statement, the invalidity applicant claimed that the contested RCD lacked novelty and individual character because it had registered a Community design that was, if not identical, very similar to the contested RCD. It stated that the contested RCD showed two different designs, as the last view clearly showed a green line along one of its ridges. This element was absent from other views.
- 5 As evidence, the invalidity applicant provided an extract from RCD-Online database concerning the registration of the Community design No 43 427-0001 for ‘suitcases’, filed and registered on 20 June 2003, and published on

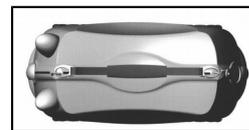
28 October 2003 in the Community Designs Bulletin with the following views in black and white (hereinafter ‘the prior design’):



1.1



1.2



1.3



1.4



1.5



1.6

- 6 The RCD proprietor, responding to the invalidity applicant’s observations, submitted that that it appeared obvious that the green contour line visible in the last view was the result of the rendering of the image when it was formatted so as to be compatible with Office’s e-filing system. IT also stated that there were no conflicts with the invalidity applicant’s prior design as concerns Article 25(1) (d) CDR because the prior design was made public before the filing date of the contested RCD and, therefore, the conditions, as laid down in Article 25(1) (d) CDR, were not met. Finally, it argued that the contested RCD and the prior design were not identical and that they were sufficiently different so as to produce a different overall impression on the informed user.
- 7 In response, the invalidity applicant declared that it was up to the RCD proprietor to file the correct views for which it sought design protection and it reiterated that the prior design fell under Article 25(1)(d) and that the contested RCD lacked novelty and individual character.
- 8 On 21 April 2014, the Invalidity Division issued a decision (hereinafter ‘the contested decision’) rejecting the application for a declaration of invalidity and ordering the invalidity applicant to bear the costs. The reasoning in the contested decision was, in essence, the following:

Disclosure

- The prior design is a registered Community design with a filing date of 26 June 2003 and it was published in the Community Design Bulletin on 28 October 2003. Hence the prior design is deemed to have been made available to the public within the meaning of Article 7(1) CDR prior to the date of filing of the contested RCD.

Novelty

- The contested RCD and the prior design both relate to suitcases. Both have the following common features: the suitcases are represented in a rectangular shape, show two small protrusions on one short side of the rectangular shape

and small wheels at the bottom and each wheel presents a smaller, circular item and they both present a depression on the top.

- The compared designs differ as regards the following features:
 - The contested RCD is displayed in colours, namely yellow and light blue, with the wheels in red, grey and dark blue and the protrusions in grey and purple, whereas the prior design is in black and white;
 - the two protrusions in the contested RCD resemble horns with the tips pointing downwards, whereas in the prior design the two protrusions look simpler and straighter;
 - the contested RCD presents two lines in relief on each larger side and one of the lines appears to include a green line; in the prior design there are no lines in relief. However, there is a marked depression on each side;
 - the prior design shows a handle, or at least a device that is used to carry the suitcase; this element is absent in the contested RCD;
 - in the contested RCD there are two small, roundish protrusions on each narrow side that present a circular element in its centre. The same two small protrusions are also visible in the prior design, but their surface is smooth and plain;
 - the contested RCD shows a bottom view; this element is absent in the prior design.
- The green-coloured line that appears in view 7 is most probably due to the light and exposure of the photograph or due to a technical mistake. When comparing the different views of the contested RCD it becomes immediately clear that it is one and the same design and not two different designs.
- Therefore, the contested RCD and the prior design are not identical and their differences are overwhelming and include important features. Therefore, said differences cannot be defined as immaterial. Hence, the prior design does not constitute an obstacle to the novelty of the contested RCD.

Individual character

- The informed user is anyone who purchases the products in question, and/or uses them for their intended purpose(s) and informs himself or herself about the range of suitcases available on the market by visiting, for example, shops selling suitcases and/or related goods.
- The designer's freedom in developing a design of a suitcase is not substantially limited. A suitcase can have different shapes, proportions and decorations as long as it is capable to store and hold personal assets. New and innovative design solutions are not hindered by severe technical or standardization constraints.
- The products in question are used for packing, transporting and travelling. Therefore, using the products indicated by the designs in conflict implies that the suitcases are used according to the needs of the traveller and the duration of the stay. In fact, a traveller would normally choose a suitcase of more reduced size for short trips and suitcases of medium or large sizes for longer and very long stays outside their home.

- The informed user is aware of the fact that the degree of freedom of the designer is limited in so far as such products must allow for a compartment in which personal items can be packed and there must be a possibility of closing it so as to prevent personal items from falling out and becoming lost. However, the designer of these products still has freedom as regards the format, size, colour, shape and lines.
- The suitcases in the RCD and the prior design are identical in some features, such as the overall rectangular shape, the depression on the top and the two protrusions that resemble horns. The differences, however, as mentioned above, are of far greater importance when compared to the features that are identical, such as, for example, the form of the horns, the lack of a handle or carrying device in the RCD and the missing depression in the RCD on each of the larger sides. The use of colours in the RCD and the absence of colours in the prior design is of less importance, as suitcases are usually available in a very broad array of colours and shades. Even though the RCD and the prior design appear to be conceptually similar, in the sense that in both cases the designer intended to communicate the idea of an animal, it is also noteworthy to mention that the very nature of an informed user means that, when possible, they will make a direct comparison between the designs under comparison and therefore, the informed user will detect the differences between those designs.
- The RCD produces a different overall impression from that produced by the prior design and thus the prior design does not form an obstacle to the individual character of the RCD within the meaning of Article 6 CDR.

Conflict with a prior design right

- The invalidity applicant has filed no arguments or evidence in support of the prior design being filed before the RCD and which has been published after the date of publication of the RCD. The requirements of Article 25(1)(d) CDR are not fulfilled. Therefore, the RCD is not in conflict with a prior design.
 - The application for a declaration of invalidity of the RCD on the grounds of Article 25(1)(b) and (d) CDR is rejected as unfounded.
- 9 On 19 June 2015, the invalidity applicant filed a notice of appeal against the contested decision. It submitted a statement of grounds on 21 August 2015.
- 10 On 3 November 2015, after the time-limit, the RCD proprietor filed its observations.

Submissions and arguments of the invalidity applicant

- 11 The invalidity applicant requests that the Board overturn the contested decision, declare the RCD invalid and orders the RCD proprietor to bear the costs. It stated, in essence, the following:
- The Invalidity Division did not adequately consider the question of the intended function of the products in question. The Board should treat the designs as ride-on suitcases i.e. as opposed to mere suitcases. In that respect, the decision of the UK Court of Appeal in *Magmatic Limited v PMS*

International Group PLe4, in which the Court of Appeal accepted that this was the case should be taken into account.

- While ride-on suitcases are suitcases, they differ materially from ‘traditional’ suitcases in the general sense in that they must, in addition to allowing the storage of goods, allow a user to ride on them; this is not a function or intended purpose of a ‘traditional’ suitcase. The users of ride-on suitcases will generally be children around 3-6 years (Internet searches are submitted as evidence).
- A 3-6 year old informed user would not, as the Invalidity Division stated, ‘inform...himself or herself about the range of suitcases available on the market by visiting, for example, shops selling suitcases and/or related shops’. By virtue of their age, a 3-6 year old child would not usually be the purchaser of the products in question and would not usually have the opportunity or desire to inform him/herself about the range of ride on suitcases available on the market through research or (save in respect of their own ride-on suitcase) actual use; any purchase or research would usually be conducted by an adult purchaser. Thus a 3-6 year old child's degree of knowledge will not be as substantial as an adult's and it will have a more limited awareness of the state of the prior art than an adult. Finally the contested decision failed to take into account that a 3-6 year old child would not be in a position to make a direct comparison of the designs in question and would have an imperfect recollection of the two designs. In addition, as correctly stated in the contested decision, in both case the designer intended to communicate the idea of an animal, taking into account the similarity of the shape and features of the products in question which produce this idea, the designs at stake will produce the same overall impression on a 3-6 year old informed user.
- As regards designer freedom, the fact that the suitcase must serve an additional function (i.e. allowing the user to ride on it) increases it. The designer is free to use various formats to allow the user to ride on the suitcase. Examples of the wide variety of formats which ride-on suitcases are submitted such as:



- Considering the differences between the two designs, only two would be visible when using the product, namely the different color and the horns. The remaining four differences would not be visible when using the suitcase (i.e. when a child is seated on it). Since the use or absence of colors has been recognized of less importance, only one of the six differences stated in the contested decision could have a major impact.
- In relation to an informed adult user (e.g. the purchaser of ride-on suitcases). taking into account the broad scope of the designer's freedom, that in both cases the designer intended to communicate the idea of an animal, that only

one difference could be mentioned, and that an informed user is not an expert or specialist capable of observing in detail the minimal differences that may exist between the designs in conflict, the RCD would not produce a different overall impression.

- It is concluded that, contrary to the finding of the Invalidity Decision, the contested RCD did not, at its filing date, possess individual character.
- The invalidity applicant insisted that the contested RCD did not possess unity of design since the colours are different.

Reasons

- 12 The appeal complies with Articles 55 to 57 CDR and Article 34(1)(c) and (2) CDIR. It is therefore admissible.

Article 25(1)(b) CDR in conjunction with Articles 4 to 7 CDR

- 13 Under Article 25(1)(b) CDR a Community design may be declared invalid if it does not fulfil the requirements of Articles 4 to 9 CDR.
- 14 Under Article 4(1) CDR a design is to be protected as a Community design to the extent that it is new and has individual character.
- 15 Novelty is defined by Article 5(1) CDR in the following terms:

‘1. A design shall be considered new if no identical design has been made available to the public:

(a) ...

(b) in the case of a registered Community design, 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.’

- 16 Individual character is defined by Article 6 CDR:

‘1. A design shall 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:

(a) ...

(b) in the case of a registered Community design, before the date of filing of the application for registration or, if a priority is claimed, the date of priority.

2. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.’

- 17 The question posed pursuant to Articles 5 to 7 CDR is essentially whether, prior to the filing date of the contested RCD, an identical design or a design that produces the same overall impression on the informed user, had been made available to the public.

The earlier design and its divulgation

- 18 The conclusion of the contested decision that the prior design has been made available to the public before the filing date of the contested RCD and may thus be regarded as an earlier design within the meaning of Article 7 CDR has not been contested and is endorsed by the Board.

Individual character

a. The informed user

- 19 It is apparent from Recital 14 in the preamble to the CDR that, when assessing whether a design has individual character, account should be taken of 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 (22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 43).
- 20 According to the case-law, an ‘informed user’ within the meaning of Article 6 CDR is neither a manufacturer nor a seller of the products in which the designs at issue are intended to be incorporated or to which they are intended to be applied. An informed user is particularly observant and has some awareness of the state of prior art, that is to say the previous designs relating to the product in question that have been disclosed on the date of filing, or the priority date, of the contested design (09/09/2011, T-10/08, ‘Internal combustion engine, EU:T:2011:446, § 23 and 18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 62, confirmed by 20/10/2011, C-281/10 P, Metal rappers, EU:C:2011:679, § 54).
- 21 The status of ‘user’ implies that the person concerned uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended (22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 46; and 09/09/2011, T-10/08, ‘Internal combustion engine, EU:T:2011:446, § 24).
- 22 Although the informed user is not the well-informed and reasonably observant and circumspect average consumer who normally perceives a design as a whole and does not proceed to analyse its various details, he is also not an expert or specialist capable of observing in detail the minimal differences that may exist between the designs at issue. Thus, the qualifier ‘informed’ suggests that, without being a designer or a technical expert, the user knows the various designs which exist in the sector concerned, possesses a certain degree of knowledge with regard to the features which those designs normally include, and, as a result of his interest in the products concerned, shows a relatively high degree of attention when he uses them (20/10/2011, C-281/10 P, Metal rappers, EU:C:2011:679, § 59 and 10/09/2015, T-526/13, Sacs à main, EU:T:2015:614, § 25).
- 23 The RCD proprietor in its appeal claims that the contested decision does not contain any statement as to the level of attention of the informed user. However, the Board notes that the contested decision does mention that an informed user is particularly observant and has some awareness of the state of prior art in paragraph 21 of the decision.
- 24 The contested RCD is registered for ‘suitcases’. However, taking into account the design itself, the contested RCD can be seen to consist of a (ride-on) suitcase

(18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 56). The invalidity applicant claims that the informed user is a child around 3-6 years. However, in the opinion of the Board, the informed user to be taken into account is someone wishing to seat a child on a ride-on suitcase who, for example, needs to purchase one and who has become informed on the subject of ride-on suitcases by browsing through catalogues of, or including, (ride-on) suitcases, visiting the relevant stores, downloading information from the Internet, etc. (by analogy, 11/05/2016, R 95/2015-3, Chairs, § 26). A child around 3-6 years cannot be considered to be by nature a person who has a particular interest in the design of a given product and who is interested in trends in design, art and fashion which might be behind the emergence of such a design (21/05/2015, T-22/13 & T-23/13, Umbrellas, EU:T:2015:310, § 51).

- 25 The informed user will, therefore, be aware that such suitcases are commonly hard shell suitcases with the closure of one side overlapping the other side. In order for them to have a ‘ride-on’ feature, producers also add two or four wheels to the bottom of suitcases so that they can be pushed or pulled by a string or a collapsible handle (18/11/2015, R 667/2014-3, Luggage, § 27).

b. The designer’s degree of freedom in developing its design

- 26 The designer’s degree of freedom in developing his 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. The more the designer’s freedom in developing the contested design is restricted, the more likely minor differences between the designs at issue will be sufficient to produce a different overall impression on the informed user (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 67 and 72 and 10/09/2015, T-526/13, Sacs à main, EU:T:2015:614, § 28).
- 27 The greater the designer’s freedom in developing the challenged design, the less likely it is that minor differences between the designs at issue will be sufficient to produce a different overall impression on an informed user. Conversely, the more the designer’s freedom in developing the challenged design is restricted, the more likely minor differences between the designs at issue will be sufficient to produce a different overall impression on an informed user. Therefore, if the designer enjoys a high degree of freedom in developing a design, that reinforces the conclusion that the designs which do not have significant differences produce the same overall impression on an informed user (10/09/2015, T-526/13, Sacs à main, EU:T:2015:614, § 29).
- 28 In the opinion of the Board, the designer’s freedom in developing a design of a (ride-on) suitcase is limited in the sense that it must be sufficiently stable to support the child and it has to contain wheels on the bottom of it. With regard to suitcases in general, the standard form is rectangular, in particular due to the standardization of luggage compartments in planes and trains and the cabin luggage requirements of airlines. Hence the freedom is limited in that respect and the informed user will pay less attention to the coincidence in the rectangular shape which is standard. Otherwise a suitcase can have different shapes,

proportions and decorations, as long as it is capable of storing and holding personal assets.

c. Overall impression produced on the informed user

- 29 As correctly found in the contested decision, the contested RCD and the prior design both have the following common features: the suitcases are represented in a rectangular shape, show two small protrusions on one short side of the rectangular shape, contain two bumpers at the bottom, one in the front and one in the back and small wheels at the bottom and each wheel presents a smaller, circular item and they both present an indent on the top.
- 30 However, the compared designs differ as regards the following features: a) the two protrusions in the contested RCD resemble horns with the tips pointing downwards, whereas in the prior design the two protrusions look simpler and straighter; b) the contested RCD presents two lines in relief on each larger side and one of the lines appears to include a green line; in the prior design there are no lines in relief. However, there is a marked depression on each side; c) the prior design shows a handle, or at least a device that is used to carry the suitcase; this element is absent in the contested RCD; d) in the contested RCD there are two small, roundish protrusions or buttons on each narrow side that present a circular element in its centre. The same two small protrusions are also visible in the prior design, but their surface is smooth and plain; e) the prior design contains an additional button at the rear which is not apparent in the contested design; f) both contain an indent on the top resembling a saddle, however, the prior design also contains a notable indent on both sides which is not apparent in the contested RCD; g) the overall shape when looked at from the side is notably different; the ‘corners’ of the contested RCD are far more rounded than in the prior design and in the contested RCD the front part of the case rises to a higher level than the back part of the case, while in the prior design they are at the same level. In the contested design the lower part of the front part of the case also protrudes when compared to the higher part, which is not the case in the prior design.
- 31 The contested RCD is displayed in colours, namely yellow and light blue, with the wheels in red, grey and dark blue and the protrusions in grey and purple, whereas the prior design is in black and white. As noted in the contested decision, the use of colours in the RCD and the absence of colours in the prior design is of less importance, as suitcases are usually available in a very broad array of colours and shades. The difference in the colours can therefore not be given decisive influence. However, even though the prior design is in black and white, it can be seen that it is not split into two different colours on each side one being clearly darker than the other, as is the case in the contested design. The wheels of the prior design are also clearly not predominantly in a light colour, as is the case in the contested RCD.
- 32 The argument of the invalidity applicant that most of the differences are not visible when a child is seated on the suitcase is rejected, because use of the ride-on suitcase also includes use without a child being placed on it.
- 33 The designs clearly differ in their overall shape, especially when viewed from the side. All of the mentioned differences are notable in the overall impression of the designs. In the Board’s opinion, the differences mentioned above in paragraph 30 will not escape the informed user’s notice. They change the appearance of the

products in a manner that will not go unnoticed by an observant user. The aforementioned differences in the designs are sufficient to deduce that they produce a different overall impression on the informed user. Consequently, the overall impression of the prior design is not of such a nature so as to deprive the contested RCD of its individual character pursuant to Article 6 CDR. The aforementioned differences are also, even more so, sufficient to deduce that the designs are not identical. Therefore, the contested RCD also does not lack novelty.

- 34 It follows from all the above considerations that the contested decision did not err in finding that the designs produce a different overall impression on the informed user and that they were not in conflict within the meaning of Article 25(1) (b) CDR.
- 35 Therefore it is also not necessary to decide on whether the observations of the RCD proprietor which were filed outside of the time limit should be taken into account.
- 36 Accordingly, the appeal must be dismissed.

Costs

- 37 Since the invalidity applicant is the losing party it has to bear the fees and costs incurred by the RCD proprietor, in accordance with Article 70(1) CDR.

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the invalidity applicant to bear the fees and costs incurred by the RCD proprietor.**

Signed

Th. M. Margellos

Signed

H. Salmi

Signed

E. Fink

Registrar:

Signed

H.Dijkema

