

DECISION
of the Third Board of Appeal
of 22 October 2020

In case R 321/2020-3

Framery Oy

Patamäenkatu 7
FI-33900 Tampere
Finland

Invalidity Applicant / Appellant

represented by BERGGREN OY, Eteläinen Rautatiekatu 10 A, FI-00100 Helsinki,
Finland

v

Suzhou 3DS Engineering Procurement Construction Co., Ltd.

Taiping Industrial Park, Xiangcheng
District
Suzhou 215131
People's Republic of China

Design holder / Defendant

represented by Modiano Josif Pisanty & Staub LTD, Thierschstraße 11,
80538 München, Germany

APPEAL relating to Invalidity Proceedings No ICD 104 059 (registered Community
design No 5 253 069-0003)

THE THIRD BOARD OF APPEAL

composed of Th. M. Margellos (Chairperson), C. Negro (Rapporteur) and M. Bra
(Member)

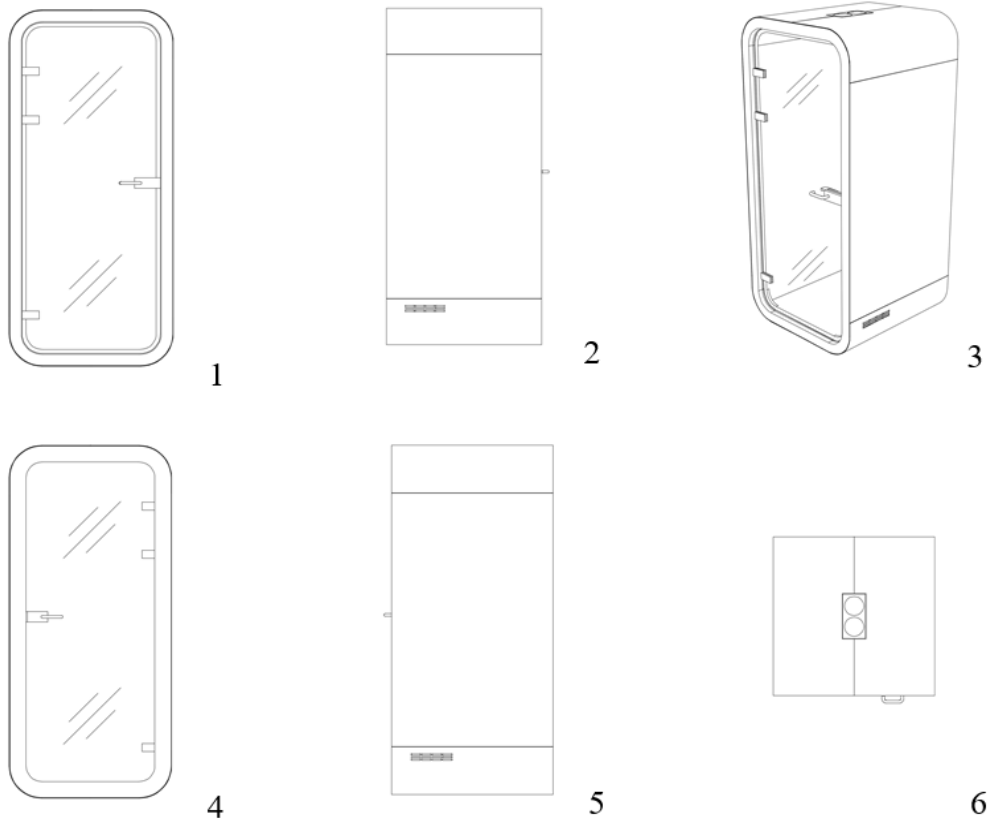
Registrar: H. Dijkema

gives the following

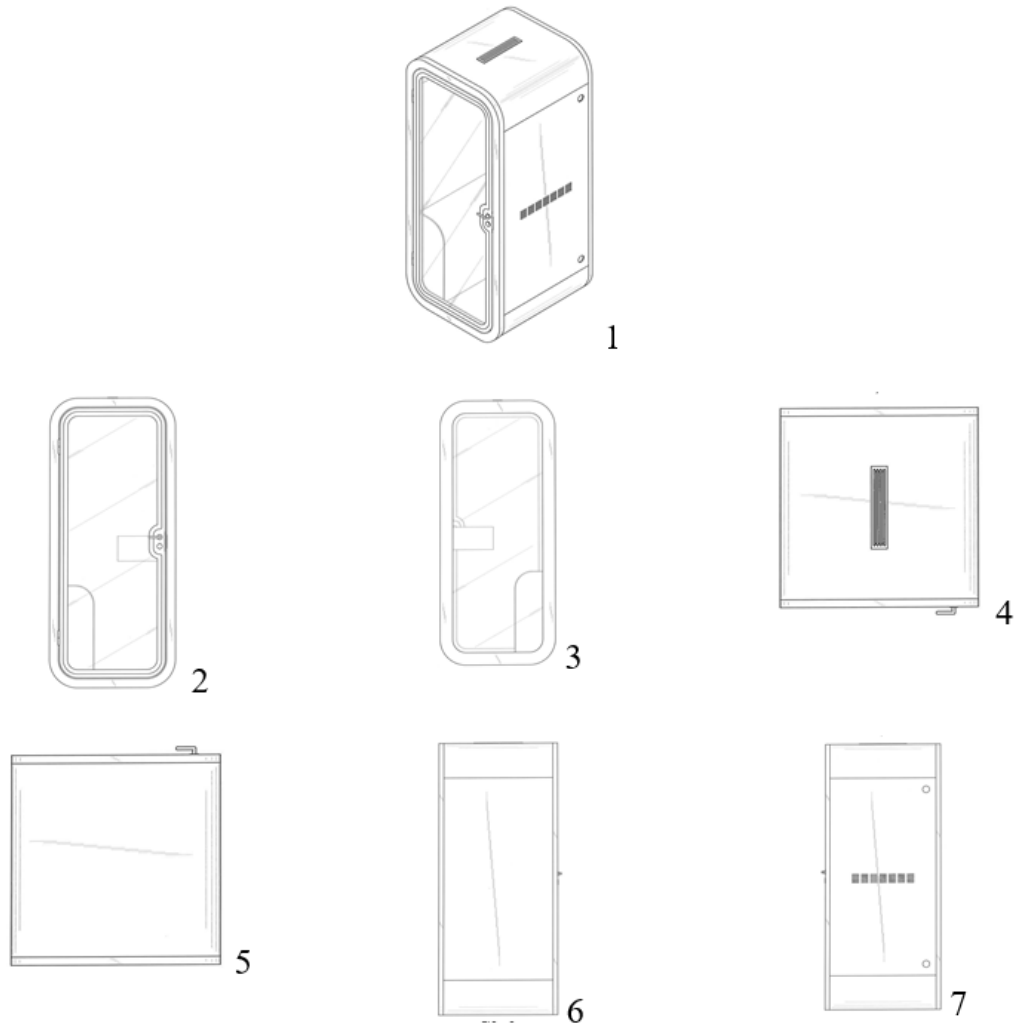
Decision

Summary of the facts

- 1 Suzhou 3DS Engineering Procurement Construction Co., Ltd. ('the design holder') is the holder of registered Community design No 5 253 069-0003 ('the contested RCD') filed on 30 April 2018 with a priority claim of 1 November 2017 for 'Telephone booths' and represented in the following six views:



- 2 On 12 October 2018, Framery Oy ('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(1) CDR claiming that the contested RCD lacks individual character, Article 6 CDR.
- 3 In support of its claims, the invalidity applicant submitted the Community design registration No 2 393 793-0002 for 'telephone boxes', which was filed and registered in the invalidity applicant's name and published on 30 January 2014 in the Community Designs Bulletin with the following views:



- 4 The invalidity applicant argued in essence that the publication of the prior design in the Community Designs Bulletin constitutes an event of disclosure within the meaning of Article 7(1) CDR. The contested RCD and the prior design produce the same overall impression on the informed user. The most dominant and eye-catching features of the earlier design, which the informed user would focus on, are the framed glass front and back walls, the rounded upper and lower corners of the front and back frames, the placement of the front door frame flush with the frame of the booth and the overall dimensions of the booth. These are all identically reproduced in the contested RCD. The earlier design creates an entirely unique experience due to its translucency, creating a distinctive visual impression. At the time of its publication, there were no other phone booths with transparent, glass front and back walls and doors. The minor differences between the booths are either in a location where they would not be accessible to the informed user during normal use (i.e. the split roof panel on the tops of the booths) or are otherwise insignificant and unlikely to influence the overall impression produced on the informed user. The latter is a purchaser of soundproof phone booths who would focus on the dimensions, shape, size and exterior surfaces of the product and would not be able to compare the designs side by side. He/she would then rely on an imperfect recollection when comparing their overall impressions. Given that the only constraint of the designs is that such soundproof phone booths must have four walls, a door and a roof, the

designer enjoys a considerable degree of freedom. The contested RCD lacks individual character.

- 5 The design holder did not submit observations in reply.
- 6 By decision of 12 December 2019 ('the contested decision'), the Invalidity Division rejected the application for a declaration of invalidity and ordered the invalidity applicant to bear the costs. The Invalidity Division gave, in particular, the following grounds for its decision:
 - The copy of the Community design registration stating that the date of publication in the Community Designs Bulletin was prior to the RCD priority date constitutes sufficient evidence of disclosure of the prior design within the meaning of Article 7(1) CDR.
 - The informed user is not an expert or a producer of telephone booths and boxes but anyone who is familiar with such products due to their availability in public (either due to their installation in a public space or their appearance in commercial offers). With regard to the argument that users would have to rely on their imperfect recollection when making a comparison, since the informed user learns about the products through his or her own experience of using such facilities to make phone calls when they are in public areas, the Invalidity Division opined that the products concerned may also be installed in open-plan offices. Therefore, as office equipment, such booths may be searched for and ordered on the internet or from paper catalogues. It is therefore not excluded that the informed user would be able to compare the designs side by side and from different perspectives at the moment of their purchase.
 - The design degree of freedom is fairly broad and telephone booths/boxes such as those shown in both design registrations can be designed in a variety of ways that do not reduce their functionality. The sole constraints reported by the invalidity applicant are that the product must have four walls, a door and a roof. The Invalidity Division agreed insofar as this is a common form for this type of product since it assures callers' privacy by enclosing the space.
 - Given that the contested RCD seeks protection for the booth only, the interior of the prior design (i.e. bench and shelf) was disregarded in the assessment. The dominant feature of both designs is their rectangular box shape with glazed front and back walls. This configuration is, however, the simplest way for the item to fulfil its purpose and will not attract any particular attention from users. The informed user will note any features that depart from this standard, namely the following points. In the contested RCD, the glass is not set in a single door frame flush with the frame of the booth but is set back from the door frame. In the prior design, on the other hand, the glass in the front and back mimics the shape of the rounded frame, and at the front, the glass is set in a double door frame and the door in a booth frame that extends from the booth body. Therefore, in addition to being flush with the frame (unlike the contested RCD's door), the door of the prior design with its double-framed door and the frame extended from the booth body, which can

also be seen from the back, give the booth the impression of being more robust, whereas the booth in the contested RCD looks more minimalist and fragile. Furthermore, the contested RCD's door includes three door hinges, which will not go unnoticed and a different roof panel. As regards the latter, this also relates to the front and hence the main views and the overall shape of the booths and will be clearly perceived by the informed user. With regard to the features common to both designs, namely the glass area, the rounded corners and the divisions in the side walls, these are not uncommon in the industrial sector in question, and thus the other features will have an impact on the overall impression of each design and will remain in the mind of the informed user even if the designs are not necessarily compared side by side. It follows that the designs under comparison produce different overall impressions on the informed user. The contested RCD has individual character with respect to the prior design.

- The facts and evidence submitted by the invalidity applicant do not support the grounds for invalidity under Article 25(1)(b) CDR and thus the application is rejected.
- 7 On 11 February 2020, the invalidity applicant filed an appeal against the contested decision, requesting that the decision be set aside. The statement of grounds of the appeal was received on 4 May 2020.
- 8 The design holder did not submit any observations in reply.

Submissions and arguments of the invalidity applicant

- 9 The invalidity applicant argues in essence that the contested RCD lacks individual character. Its arguments raised in the statement of grounds may be summarised as follows:
- The Office shall be restricted in the examination to the facts, evidence and arguments provided by the parties and the relief sought (Article 63 CDR) and its decisions shall state the reasons on which they are based (Article 62 CDR). The contested decision was in part based on probabilities or suppositions rather than the evidence submitted by the parties, and on an erroneous interpretation of the facts, in particular in its assessment of which features of the respective designs would command the attention of the informed user, and in its comparison of the designs.
 - The designs in question concern soundproof telephone booths and boxes that are usually used in open-plan offices and open public places. The informed user of such a transportable booth or workspace is anyone who habitually uses or purchases such an item, puts it to its intended use and has become informed on the main features of the goods. The informed user includes the end consumer, workers, commercial users, buyers, sellers and distributors of portable office buildings. Such a user would focus on the dimensions, shape, size, exterior surfaces and overall impression of the products since these features are important in an office environment, rather than small details concerning the furnishings of the booths. Furthermore, the informed user will

have to rely on an imperfect recollection of the overall impression produced by the designs since it is unlikely that the sellers of phone booths have different designs available for a direct, side by side comparison. When available online or in catalogues, the minor differences between the designs are not distinguishable and therefore it would be even more challenging for them to be noticed by the informed user. The latter attributes particular attention to the quality of soundproofing which cannot be ascertained from websites or catalogues. Most times, the booths are purchased based on a physical showroom visit, presentation by a sales representative on customer premises, or in large projects as proposed by an interior architect as a component in the overall office interior set-up. Under these circumstances, the informed user would not focus on minor details but on the overall design of the booths and their dominant elements.

- The designer’s degree of freedom is high. It is only limited insofar as a transportable booth needs to have at least four walls, a door and a roof and by technical specifications such as soundproofing, ventilation, providing sufficient user space, plugs, and being capable of providing a seating and working environment. As to the shape, it may be of any shape, dimensions and material of the walls and door. In support of its claims, the invalidity applicant submitted a Google image search for ‘phone booths’ and ‘phone pods’ and argued that its booths with rounded corners and glazed front and back walls, as shown in the internet search, are the original ones.
- The dominant and eye-catching features of the earlier design, which the informed user would focus on, are the framed transparent front and back walls, the rounded upper and lower corners of the front and back frames, the placement of the front door frame flush with the frame of the booth, and the overall dimensions of the booth. These dominant features are identically reproduced in the contested RCD. It follows that the designs under comparison are almost identical both in terms of their overall impression as well as their details. The minor differences between the booths are either in a location where they would not be accessible to the informed user during normal use or are otherwise insignificant and unlikely to influence the overall impression produced upon the informed user. The latter will also perceive the minor differences as an optional feature or choice amongst the range of options which cannot differentiate the designs. In addition, some features such as the air vents and door hinges perform a technical function and it is unlikely that the informed user would notice them. As regards in particular the position and shape of the air vents, this was copied from another version of the invalidity applicant’s design which was published in 2014. In support of this, the invalidity applicant submitted an extract from its Twitter account showing the actual booths exhibited at Orgatec 2014 fair in Cologne.
- The contested decision erred in finding that the box shape, the transparent back and front walls and the rounded corners would be standard and common features in the relevant industrial sector since there was no evidence submitted by the parties in this regard. Neither has the Invalidity Division provided any argumentation or evidence in support of this finding. The only booths having transparent back and front walls and rounded corners originate

from the invalidity applicant. It is actually technically challenging to manufacture booths with rounded corners and attach rounded glass walls to the booths which also explains why these kind of designs are not commonly used. The visibility through the booth is also a feature that the informed user would take note of as it has significant influence on the overall impression of the designs and the way it would fit in the place of use. At any rate, the assessment of whether a certain feature is standard or common in a certain field is not considered to be a well-known fact; rather it requires evidence from the time period prior to the RCD filing date.

Reasons

- 10 The appeal complies with Articles 56 and 57 CDR and Article 34 CDIR. It is, therefore, admissible. The appeal is not well founded.

Article 25(1)(b) in conjunction with Article 6 CDR

- 11 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 filing date of the application for registration or, if a priority is claimed, the date of priority.
- 12 The Board concurs with the findings of the contested decision that the registration details of the prior design No 2 393 793-0002 showing that this was published in the Community Designs Bulletin well before the contested RCD's priority date constitutes sufficient evidence of disclosure of the design within the meaning of Article 7(1) CDR. This has not been disputed by the design holder.

Informed user

- 13 The '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. Without being a designer or a technical expert, the informed 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 or her interest in the products concerned, shows a relatively high degree of attention when he or she uses them (20/10/2011, C-281/10 P, Metal rappers, EU:C:2011:679, § 59; 22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 47).
- 14 Both the prior design and the contested RCD are embodied in telephone booths or telephone boxes which may be placed anywhere in the exterior or interior of a building. The informed user of a telephone booth/box is anyone who habitually uses or purchases such an item, puts it to its intended use and has become informed on the subject by browsing through catalogues, visiting the relevant stores or trade fairs, downloading information from the internet, etc. The informed user includes professionals such as sellers, distributors and purchasers of portable buildings and designers thereof, as well as end consumers such as

employees or private persons who purchase such items to be installed inside or outside their homes. As a result of his or her interest in the products concerned, he or she shows a relatively high degree of attention when using them.

Designer's freedom

- 15 The degree of the freedom of the designer in developing his or her 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 (09/09/2011, T-10/08, Internal combustion engine, EU:T:2011:446, § 32; 18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 67).
- 16 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 (09/09/2011, T-10/08, Internal combustion engine, EU:T:2011:446, § 33).
- 17 The designer's freedom in developing telephone booths is limited to a certain degree by technical specifications (e.g. soundproofing, ventilation) and safety standards (e.g. size and space requirements, air quality, temperature control, use of transparent material to avoid the danger of claustrophobia). Nevertheless, the Board considers that these aspects do not put any particular constraints on the designer as regards the exterior appearance of such booths, as stressed also by the invalidity applicant. The latter states that the only real constraints are that the booth must have (at least) four walls, a door and a roof. These features are usually constructed in a rectangular shape, as shown in the images from the Google search image for 'phone booths' and 'phone pod' and those contained in the statement of grounds of appeal. Notwithstanding that the majority of telephone booths appear in rectangular box shape, telephone booths may also have different shapes (e.g. square, cylindrical) and there is a variety in terms of configuration and positioning of its components (e.g. door and air vents), choice of the number of glass sides, building materials (e.g. glass, metal, plastic or wood), colours and decorative effects. Therefore, the designer's degree of freedom is considered to be fairly broad.

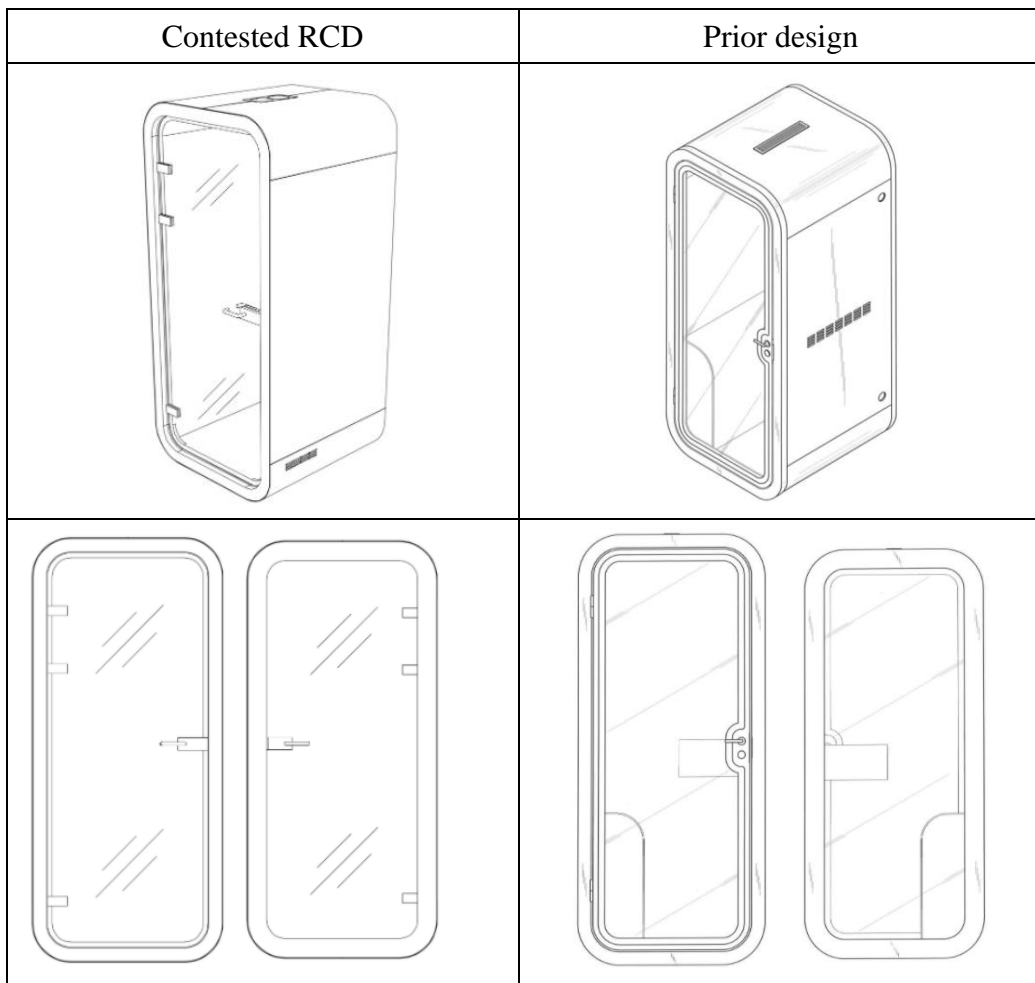
Overall impression

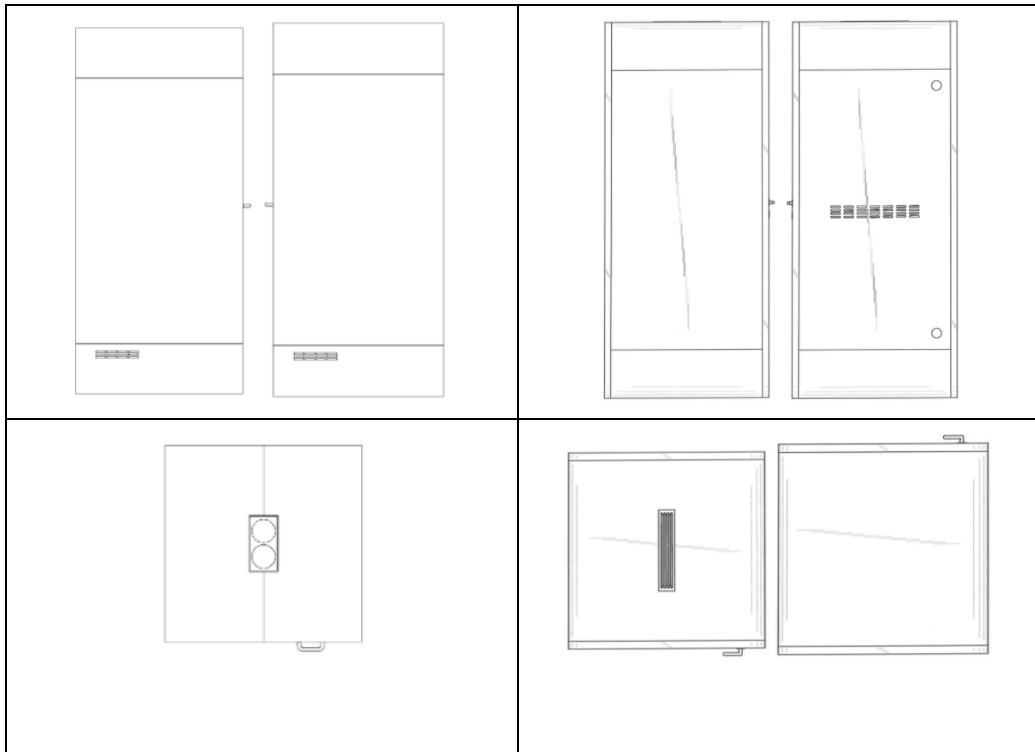
- 18 The individual character of a design results from a different overall impression or the absence of *déjà vu* from the viewpoint of the informed user with reference to the existing design corpus taking into account the differences which are sufficiently pronounced to produce a different overall impression and discarding the differences which do not affect the overall impression (07/11/2013, T-666/11,

Gatto domestico, EU:T:2013:584, § 29). The comparison of the overall impressions produced by the designs must be synthetic and may not be limited to an analytic comparison of a list of similarities and differences (07/11/2013, T-666/11, Gatto domestico, EU:T:2013:584, § 30; 06/06/2019, T-209/18, Porsche, EU:T:2019:377, § 71).

19 In principle, the assessment of the overall impression is to be based on a direct comparison (20/10/2011, C-281/10 P, Metal rappers, EU:C:2011:679, § 55; 06/06/2019, T-209/18, Porsche, EU:T:2019:377, § 78; 29/11/2018, T-651/17, Spray guns, EU:T:2018:855, § 47). The invalidity applicant's argument that the informed user will have to rely on its imperfect recollection is not convincing. It is clear from the evidence furnished by the invalidity applicant that telephone booths are exhibited in trade fairs (e.g. Orgatec 2014 trade fair) where their features are clearly displayed and a detailed, side by side comparison is allowed. The invalidity applicant itself states that 'the booths are purchased based on a physical showroom visit' (statement of grounds of appeal, p. 7). It is therefore very likely that a side by side comparison by means of an exhibition or a showroom presentation can take place on the market.

20 The designs under comparison are the following:





- 21 The Board notes preliminarily that the reference point for the assessment of the overall impression is the contested RCD under examination (13/06/2017, T-9/15, Dosen [für Getränke], EU:T:2017:386, § 87). Since the contested RCD seeks protection for the booth only, the interior elements of the earlier design are to be disregarded in the assessment.
- 22 The designs share the feature of a rectangular box of six sides with rounded corners, the front and back sides being of transparent glass. The rectangular shape of the booth and the use of transparent material will not attract the attention of the informed user since the latter is aware that telephone booths/boxes most frequently come in rectangular shape and with glass walls (fully or partially), as demonstrated by the evidence furnished by the invalidity applicant itself.
- 23 When appraising the overall impression conveyed by the conflicting designs, the informed user will therefore give greater weight to the other features, in particular the door frame and glass, the handle and the hinges. These reveal significant differences between the conflicting designs which endow the contested RCD with individual character, as will be analysed below.
- 24 The first and most conspicuous difference which determines the different overall impression on the informed user concerns the front side of the designs, in particular the door frame. In the prior design, the door frame presents two sets of ridges while in the contested RCD it presents one ridge. This results in a difference in the position and appearance of the glass door. In the contested RCD, the glass is not set in a single door frame flush with the frame of the booth but is clearly set back from the frame of the booth, whereas in the prior design the glass is set within the double ridged door frame at the same level or just slightly back giving the impression that the whole door is set in a booth frame that extends from the booth body. Therefore, the front side of the prior design with its double ridged frame door and the frame extended from the booth body give the booth the

impression of being more robust whereas the booth in the contested RCD looks more minimalist and fragile.

- 25 Second, the designs under comparison differ in the door handles. The door handle in the contested RCD sits on a rectangular horizontal plate whereas in the prior design the door handle sits on a vertical semi-oval plate which is framed in its left-hand part by the same double ridged frame of the door and is set above a circular shaped hole. This difference in the shape and position of the door handle will attract the attention of the informed user and thus affect the overall impression.
- 26 Third, the designs differ in the hinges. The contested RCD contains three rectangular straight hinges which are clearly visible since they constitute part of the glass door whereas the prior design reveals two elongated thin door hinges. The invalidity applicant claims that the hinges serve only a technical purpose and will thus go unnoticed by the informed user. Even assuming that those features may have a technical function, it is not established that they would be elements whose visual characteristics would be exclusively imposed by the technical function of the product in question (29/04/2020, T-73/19, Wood splitting tools, EU:T:2020:157, § 54). In addition, the hinges could be placed in different ways and could – and indeed have – different shapes and sizes and thus be regarded as a differentiating factor between the designs (04/07/2017, T-90/16, Measuring instruments, apparatus and devices, EU:T:2017:464, § 61). There is therefore no reason to disregard the specific appearance of these features in the overall impression produced by the designs at issue.
- 27 Finally, the designs differ in the air vents. Although this will not have much impact on the informed user's perception, it cannot be entirely excluded in the present case. The contested RCD shows a ventilation opening in the middle of the roof (in-between the split) consisting of two circular parts within a rectangle and two rectangular air vents at the bottom of each side wall. The prior design comprises two air vents of rectangular shape, one on the roof and one at the centre right-hand side wall. Even if air vents serve only a technical function (e.g. to produce and boost air flow), this does not preclude this feature from being capable of being regarded as a differentiating factor insofar as air vents could have different shapes and sizes and be arranged in different ways. The invalidity applicant argued that the position and shape of the air vents have been copied from an updated version of the prior design and submitted an extract from its Twitter account showing a telephone booth exhibited at the Orgatec 2014 fair in Cologne. This argument is to be rejected. A combination of already disclosed features is eligible for protection as a Community design, provided the combination, as a whole, is novel and has individual character (19/06/2014, C-345/13, Karen Millen Fashions, EU:C:2014:2013, § 34).
- 28 The abovementioned differences – and particularly the first one – are notable in the impression of the designs when compared as a whole. They concern features which the informed user perceives due to a high degree of attention and result in different overall impressions created by the designs under comparison. The coincidence in the rectangular box shape with rounded corners and a transparent back and front cannot counteract the important differences found between the conflicting designs.

- 29 The invalidity applicant argues that some features will not be seen in normal use (e.g. air vents) or they will be considered as an option amongst the range of available choices (e.g. handles), and thus should not be taken into consideration when comparing the designs. This argument is to be rebutted. While the normal use of a booth includes approaching it from the outside and viewing its front side, it cannot be excluded that telephone booths can be placed in open-plan offices and multi-level spaces where they could be viewed from all angles. Therefore, the roof and the sides will also be visible and play, to a certain extent, a role in the overall impression. Likewise, the fact that other options exist, does not mean that the feature concerned will go unnoticed by the informed user, in particular for the handle since this is placed in the front (main view) of the booth. In combination with the other differences, these features are liable to confer individual character on the contested RCD.
- 30 The invalidity applicant extensively argues that the rectangular box shape, the transparent front and back walls and the rounded upper and lower corners are the dominant and eye-catching features of the designs at issue; these features are not common or standard in the relevant industry and are produced identically in the designs. This claim is to be rebutted. The rectangular box shape is frequently seen in telephone booths as shown in the Google image search submitted by the invalidity applicant itself. Likewise, transparent sides are often found in booths (Google image search). The informed user knows that the sides of the booth are available with different features (e.g. solid or transparent) which can be structured differently depending on the needs, in particular the intended placement of a booth. Therefore, when comparing the conflicting designs, the informed user will not pay particular attention to whether the back and/or the front of a booth are transparent. Rather, the focus will be on the other features and the placement thereof, such as the door frame. The invalidity applicant argues that the only booths having transparent back and front walls and rounded corners originate from itself and that the positioning of the door to the transparent side is unique, creating a distinctive and original design. Sufficient evidence has not been submitted in this regard. At any rate, the alleged original character of the earlier design does not prevent the informed user from perceiving the differences in the subsequent designs (04/07/2017, T-90/16, Measuring instruments, apparatus and devices, EU:T:2017:464, § 71-72; 21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 95). Neither aesthetics nor commercial considerations play a role in the assessment of the individual character of the design concerned (07/02/2019, T-767/17, Leuchten, EU:T:2019:67, § 29). Likewise, allegations related to the technical complexities of, inter alia, the rounded corners are irrelevant when assessing the overall impressions produced by the designs. At any rate, a coincidence in the rounded corners is not sufficient, in the present case, to produce the same overall impression on the informed user, given the above-mentioned differences between the designs.
- 31 In the Board's opinion the differences analysed in paragraphs 24 to 27, and *in primis* the differences in the door frames of the booths underlined above, which make the booth in the prior design look more robust and the booth in the contested RCD look more minimalist and delicate, are sufficient to create different overall impressions and, in other words, to avoid an impression of *déjà vu* on an informed user. As a result, the prior design does not deprive the contested RCD of its individual character.

32 The appeal is to be dismissed.

Costs

33 Since the appeal has been unsuccessful, the invalidity applicant must be ordered to bear the costs incurred by the design holder, 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 costs and fees incurred by the design holder.**

Signed

Th. M. Margellos

Signed

C. Negro

Signed

M. Bra

Registrar:

Signed

p.o. R. Vidal

