



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Fifth Chamber))

21 May 2015*

(Community design — Invalidity proceedings — Registered Community design representing umbrellas — Grounds for invalidity — Disclosure of earlier design — American patent as earlier design — Circles specialised in the sector concerned — Informed user — Degree of attention of an informed user — Fashion accessories — Degree of freedom of the designer — Individual character — Different overall impression — Invalidity proceedings)

In Joined Cases T-22/13 and T-23/13,

Senz Technologies BV, established in Delft (Netherlands), represented initially by W. Hoyng and C. Zeri, and subsequently by W. Hoyng and I. de Bruijn, lawyers,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented initially by F. Mattina, and subsequently by A. Folliard-Monguiral, acting as Agents,

defendant,

the other party to the proceedings before the Board of Appeal of OHIM, intervener before the General Court, being

Impliva BV, established in Mijdrecht (Netherlands), represented by C. Gielen and A. Verschuur, lawyers,

ACTION brought against two decisions of the Third Board of Appeal of OHIM of 26 September 2012 (Cases R 2453/2010-3 and R 2459/2010-3), in relation to invalidity proceedings between Impliva BV and Senz Technologies BV,

THE GENERAL COURT (Fifth Chamber),

composed of A. Dittrich (Rapporteur), President, J. Schwarcz and V. Tomljenović, Judges,

Registrar: J. Weychert, Administrator,

having regard to the application lodged at the Court Registry on 16 January 2013,

having regard to the response of OHIM lodged at the Court Registry on 30 April 2013,

having regard to the response of the intervener lodged at the Court Registry on 19 April 2013,

* Language of the case: English.

having regard to the replies lodged at the Court Registry on 22 July 2013,

having regard to the rejoinders of OHIM lodged at the Court Registry on 11 November 2013,

having regard to the order of 2 October 2014 joining Cases T-22/13 and T-23/13 for the purposes of the oral procedure and the judgment,

further to the hearing on 27 November 2014,

gives the following

Judgment¹ ...

Forms of order sought

- 13 The applicant claims, both in Case T-22/13 and in Case T-23/13, that the Court should:
- annul the contested decisions;
 - uphold the arguments put forward before it and declare the registration of the contested designs to be valid; and
 - order OHIM to bear its own costs and order the intervener, should it intervene, to bear its own costs and to cover those of the applicant.
- 14 At the hearing the applicant withdrew its second head of claim both in Case T-22/13 and in Case T-23/13, by which it asked the Court to declare the registration of the contested designs to be valid.
- 15 OHIM contends, both in Case T-22/13 and in Case T-23/13, that the Court should:
- dismiss the applications;
 - order the applicant to pay the costs.
- 16 In its response, the intervener contends, both in Case T-22/13 and in Case T-23/13, that the Court should:
- dismiss the actions in their entirety or, in the alternative, refer the cases back to OHIM or, in the further alternative, declare the registration of the contested designs to be invalid;
 - order the applicant to bear its own costs and pay those incurred by the intervener, including for the purposes of the proceedings before the Board of Appeal.
- 17 At the hearing the intervener withdrew its second head of claim both in Case T-22/13 and in Case T-23/13, by which it asked the Court to refer the cases back to OHIM.

1 — Only the paragraphs of the present judgment which the Court considers it appropriate to publish are reproduced here.

Law ...

Consideration of the first plea in law: infringement of Article 7(1) of Regulation No 6/2002 ...

- 26 A design is therefore deemed to have been made available once the party relying thereon has proven the events constituting disclosure. In order to refute that presumption, the party challenging the disclosure must establish to the requisite legal standard that the circumstances of the case could reasonably prevent those facts from becoming known in the normal course of business to the circles specialised in the sector concerned.
- 27 Moreover, the presumption provided for in Article 7(1) of Regulation No 6/2002 applies irrespective of where the events constituting disclosure took place, since it can be seen from the wording of the first sentence of Article 7(1) of Regulation No 6/2002 that it is not absolutely necessary, for the purpose of applying Articles 5 and 6 of that regulation, for the events constituting disclosure to have taken place within the European Union in order for a design to be deemed to have been made available to the public (judgment of 13 February 2014 in *H. Gautzsch Großhandel*, C-479/12, ECR, EU:C:2014:75, paragraph 33).
- 28 The question whether events taking place outside the European Union could reasonably have become known to the persons forming part of the circles specialised in the sector concerned is a question of fact; the answer to that question is dependent on the assessment of the particular circumstances of each individual case (judgment in *H. Gautzsch Großhandel*, cited in paragraph 27 above, EU:C:2014:75, paragraph 34).
- 29 In order to carry out the assessment referred to by the Court of Justice, it must be examined whether, on the basis of the facts, which must be adduced by the party challenging the disclosure, it is appropriate to consider that it was not actually possible for those circles to be aware of the events constituting disclosure, whilst bearing in mind what can reasonably be required of those circles in terms of being aware of prior art. Those facts may concern, for example, the composition of the specialised circles, their qualifications, customs and behaviour, the scope of their activities, their presence at events where designs are presented, the characteristics of the design at issue, such as their interdependency with other products or sectors, and the characteristics of the products into which the design at issue has been integrated, including the degree of technicality of the product concerned. In any event, a design cannot be deemed to be known in the normal course of business if the circles specialised in the sector concerned can become aware of it only by chance.
- ...
- 36 As to the argument that the umbrella covered by the earlier patent has never been produced — a point not contested, moreover, either by OHIM or the intervener — it is clear that Article 7(1) of Regulation No 6/2002 does not impose any requirement that the earlier design relied on by the opposing party must have been used for the manufacture or marketing of a product.
- 37 However, the fact that a design has never been incorporated into a product is significant only where the applicant has established that the circles specialised in the sector concerned do not generally consult patent registers or that the circles specialised in the sector concerned do not generally attach any weight to patents, in particular American patents. In such scenarios, the argument that there are no umbrellas covered by the earlier patent on the market may make faintly plausible the fact that the earlier patent may have been known to the circles specialised in the sector concerned through other forms of information. In the present case, the fact that the umbrella designated by the earlier patent has never been produced shows that the earlier patent could not have been known to the circles specialised in the sector concerned through advertising, marketing activities or catalogues. However,

that fact does not establish that the circles specialised in the sector concerned could not have reasonably gained that knowledge otherwise, such as through an online search in the American patent register.

...

On those grounds,

THE GENERAL COURT (Fifth Chamber)

hereby:

1. **Annuls the decisions of the Third Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 26 September 2012 (Cases R 2453/2010-3 and R 2459/2010-3);**
2. **Orders Impliva BV to bear its own costs and to pay one third of the costs of Senz Technologies BV;**
3. **Orders Senz Technologies to bear two thirds of its own costs;**
4. **Orders OHIM to bear its own costs.**

Dittrich

Szwarcz

Tomljenović

Delivered in open court in Luxembourg on 21 May 2015.

[Signatures]