

## INVALIDITY No ICD 120 278

**Melissa & Doug, LLC**, 141 Danbury Road, Wilton, Connecticut 06897, United States (applicant), represented by **Boekx Trademarks B.V.**, Leidsegracht 9, 1017 NA Amsterdam, Netherlands (professional representative)

a g a i n s t

**Shantou Chenghai District Kurui Trading CO., LTD.**, No. 3, Alley 5, Gangkou Anding Road, Fengxiang Street, Chenghai District, Shantou City, Guangdong Province 515000, China (holder), represented by **Manuel de Arpe Tejero**, Calle Islas de Cabo Verde 86 1ºB, 28035 Madrid, Spain (professional representative).

On 16/05/2023, the Invalidation Division takes the following

### DECISION

1. The application for a declaration of invalidity is upheld.
2. Registered Community design No 008129746-0003 is declared invalid.
3. The holder bears the costs, fixed at EUR 750.

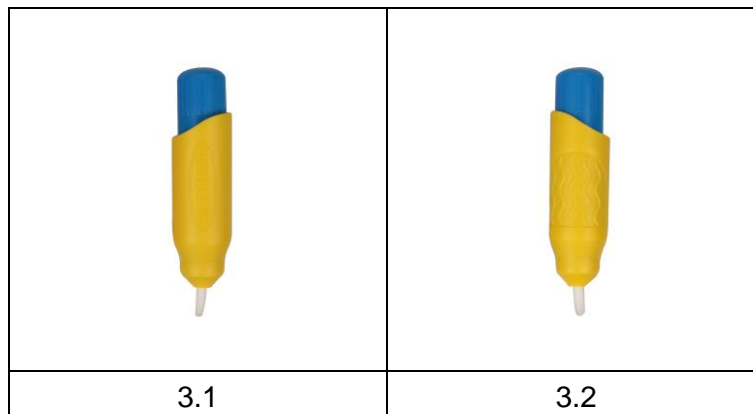
### REASONS

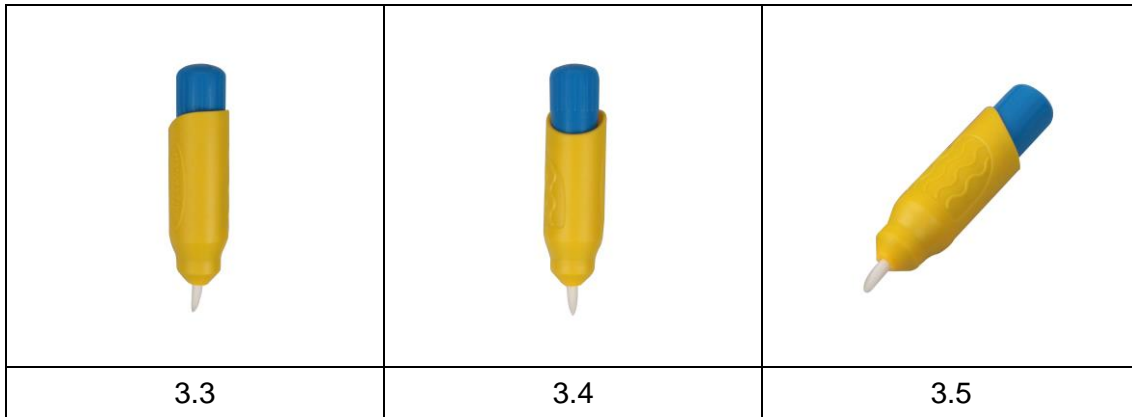
The applicant filed an application for a declaration of invalidity ('the application') against Community design No 008129746-0003 ('the contested design'). The contested design was filed and registered in the holder's name on 19/08/2020.

The following products are indicated in the registration:

21-01 toys.

The registration contains the following views:





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

### **SUMMARY OF THE PARTIES' ARGUMENTS**

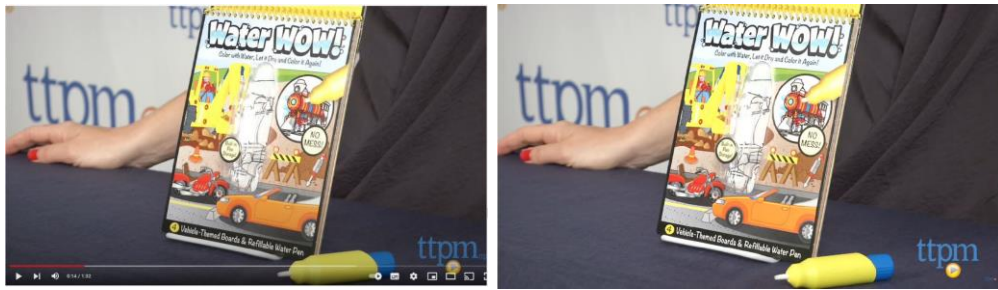
The applicant argued, inter alia, the following.

- The contested design is invalid on the grounds of lack of novelty and individual character in view of the earlier existing design for the refillable 'WATER WOW!' water pen, which has been commercialised and made available to the public by the applicant since 2012.
- The pen is used with a paint-with-water colouring book. The pen is filled with water, and this makes the colours visible in the images of the book. When the page dries, the colours disappear again. The images can therefore be painted repeatedly.
- The design of the 'WATER WOW!' pen was introduced on the YouTube video portal (<https://www.youtube.com>). The videos contain clear images of the prior design and are intended for the international public.
- Furthermore, the applicant sold, imported and delivered its 'WATER WOW!' pen and related products in the EU before the contested design's filing date. As proof, it presents (partly redacted) sample invoices in Annex 8. In 2019 and 2020, it sold more than 20 000 yellow/blue 'WATER WOW!' pens in the EU and the UK.
- The contested and prior designs both show (educational) toys. Therefore, the informed user could be a child in the approximate age range of 4-12, or an adult who buys the toy for a child. However, as follows from case-law, it makes little difference whether the informed user is a child or an adult; the important point is that both these groups are familiar with the product to the necessary level.
- The designer's degree of freedom in creating a water pen is limited by the requirement that toys of this type must have a water reservoir, a brush that can be filled with water and a shape that makes it possible to hold the product in the hand. However, as the examples of other water pens submitted in Annex 9 show, there are infinite possibilities for altering the shape, size, tip or brush, the position and number of elements composing the product, their colours, and the general appearance of the product.

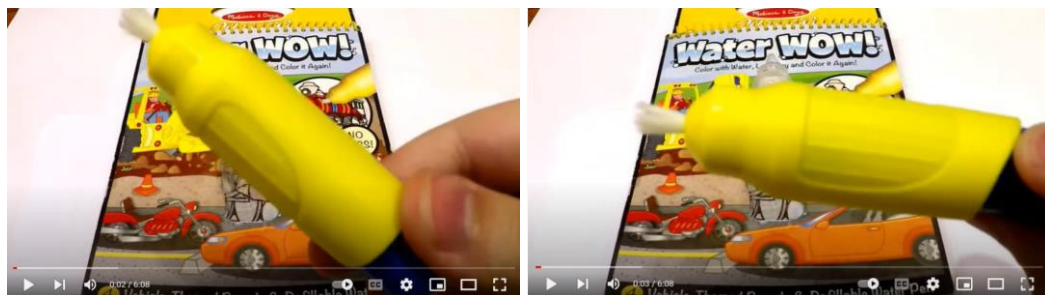
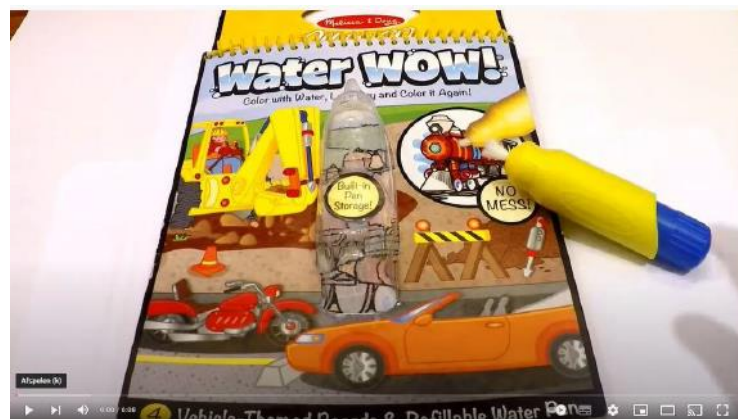
- The designs under comparison have identical sizes, shapes, elements and colours. In view of the high degree of freedom of the designer, the overall impression is strikingly similar, since all the main features that determine the overall impression produced by the designs at issue are identical. The only differences concern the text in the (otherwise identical) oval shape (reading 'Melissa & Doug' in the prior design and 'WATERDOODLE' in the contested design), and the straight lines versus wavy lines in the (otherwise identical) semicircle of the (otherwise identical) yellow holder.

In support of its arguments, the applicant submitted, inter alia, the following screenshots taken from two videos available on the YouTube video portal:

- 'Water Wow! Vehicles from Melissa & Doug', dated 10/06/2014 (the first screenshot, submitted as Annex 6), as well as a snapshot without the video track line in the holder's observations:



- 'Water Wow! Vehicles from Melissa & Doug', dated 03/07/2018 (the first screenshot, submitted as Annex 7). The images below the screenshot are included in the applicant's written observations and, although they do not show the video title, looking at their contents and footage, they appear to originate from the same video as the screenshot in Annex 7):



The holder was invited to submit observations on the application but did not reply.

### **LACK OF INDIVIDUAL CHARACTER PURSUANT TO ARTICLE 6 CDR**

According to 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 that user by any design that has been made available to the public before the filing date of the application for registration of the design for which protection is claimed or, if priority is claimed, the priority date. Article 6(2) CDR states that, in assessing that individual character, the designer's degree of freedom in developing the design must be taken into consideration.

#### **a) Disclosure pursuant to Article 7 CDR**

For the purpose of applying Article 6(1)(b) CDR, 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 contested design's filing date or, if a priority is claimed, before its priority date, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union.

In principle, the onus is on the applicant to prove that a design has been disclosed. It is deemed to have been made available within the meaning of Article 7(1) CDR if the applicant has proved the events constituting disclosure. It is for the party challenging the disclosure to rebut that presumption by establishing to the requisite legal standards that the circumstances of the case could reasonably have prevented the disclosure events from becoming known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union (21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 26; 14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 47).

As a matter of principle, disclosures on the internet form part of the prior art. Posting an image of a design on the internet constitutes disclosure for the purposes of Article 7(1) CDR (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 50), unless circumstances alleged or disputed by the parties cast such disclosure in doubt.

Furthermore, a design of a product captured in a video uploaded to an online video-sharing platform is considered to have been made available to the public within the meaning of Article 7(1) CDR, as long as the platform is a publicly accessible website for video sharing. Businesses actively use online media to promote their products (07/10/2014, R 1864/2013-3, Cases for portable computers, § 27-28).

The screenshots in Annexes 6 and 7 demonstrate that the design of the 'WATER WOW!' pen by 'Melissa & Doug' was made available to the public when two videos were uploaded to the YouTube website; the first as early as 10/06/2014 and the second on 03/07/2018.

Furthermore, since the dates on which the abovementioned product was made available to the public precede the contested design's filing date, and the holder did not comment on any of those facts, evidence and arguments, the invoked prior design of the 'WATER WOW!' pen as depicted in the abovementioned screenshots and snapshots, is deemed to have been made available to the public within the meaning of Article 7(1) CDR.

**b) Comparison of the prior and contested designs**

According to case-law, assessing the individual character of a Community design is, in essence, the result of a four-step examination. That examination consists in determining, firstly, the sector to which the products in which the design is intended to be incorporated or applied to belong; secondly, the informed user of those products in accordance with their purpose and, with reference to that informed user, their degree of awareness of the prior art and their level of attention when comparing the designs, directly if possible; thirdly, the designer's degree of freedom in developing their design; and, fourthly, the outcome of the comparison of the designs at issue, taking into account the sector in question, the designer's degree of freedom and the overall impressions produced on the informed user by the contested design and by any earlier design which has been made available to the public, taken individually (13/06/2019, T-74/18, Informationstafeln für Fahrzeuge, EU:T:2019:417, § 66, and the case-law cited therein).

*The sector concerned and the informed user*

To determine the sector to which the product of the contested design belongs (and hence the informed user and the degree of freedom of the designer in developing the design), it is appropriate to look at the design itself to specify the nature, intended purpose or function of the product. Taking the design itself into account may make it possible to better determine the product concerned within the wider category of products indicated in the registration (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 56).

The informed user is a legal fiction and the interpretation of that concept must be that the status of 'user' implies that the person concerned uses the product in which the design is incorporated, according to the purpose for which that product is intended. The qualifier 'informed' suggests that, without being a designer or a technical expert, the user is familiar with the various designs that exist in the sector concerned, possesses a certain degree of knowledge about the features which those designs normally include and, as a result of their interest in the products concerned, pays a relatively high degree of attention when they use them (18/10/2018, T-368/17, Electrically operated lifting column, in particular for tables, EU:T:2018:695, § 26 and the case-law cited therein).

In the present case, the products incorporating the contested design are *toys* and specifically, taking into account the design itself, toy writing instruments.

Therefore, the informed user, without being an expert or producer, is a person who is familiar with the toys fulfilling the function of writing instruments available on the market during the relevant period before the contested design's filing date, mainly because of their own experience or interest in these products. As the applicant points out, according to the case-law, it is not necessary to determine a particular category of user of the products incorporating the contested design.

*The designer's freedom*

The greater the designer's freedom in developing the contested design, the less likely it is that minor differences between the conflicting designs will be sufficient to produce a different overall impression, and vice versa (09/09/2011, T-10/08, Internal combustion engine, EU:T:2011:446, § 33). This factor does not determine, however, how different they have to be. It only moderates the assessment of the individual character of the contested design (10/09/2015, T-525/13, Sacs à main, EU:T:2015:617, § 35), including the weight to be given to certain features or elements in the overall impression.

The designer's freedom is limited in particular as regards those features imposed by the technical function of the product or an element thereof, or by statutory requirements, resulting in a standardisation of certain features (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 67), which thus apply to all designs intended for use in the products concerned.

However, the fact that the intended purpose of a product requires the presence of certain features does not automatically imply a limitation of the designer's freedom (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 69).

The applicant argues in this respect that the designer of the contested design was limited when developing the design as regards the presence of a water reservoir passing the water to the brush, and a shape that makes it possible to use the product by hand. However, there are infinite possibilities for altering the shape, size, tip or brush, the position and number of the elements composing the product, their colours and the general appearance of the product. In support of this, the applicant referred to Annex 9. However, this was not submitted in the application.

The Third Board of Appeal considered that the designer's degree of freedom in developing the design of a writing instrument was relatively broad (07/02/2014, R 1037/2012-3, Writing instruments, § 31). It held that certain features must be present for it to perform its function, but a highlighter could surely look significantly different from the contested design.

The Invalidity Division considers that the cited case-law can be applied by analogy here and also supports the applicant's position. It follows that only minor differences between the contested and prior designs cannot bestow individual character on the contested design.

#### *The overall impression*

According to case-law, the individual character of a design results from a different overall impression from the viewpoint of the informed user with reference to the existing design corpus, taking into account those differences sufficiently pronounced as to produce a different overall impression, and discarding the differences that do not affect the overall impression (07/11/2013, T-666/11, Gatto domestico, EU:T:2013:584, § 29).

The very nature of the informed user implies that, so far as possible, they make a direct comparison between the prior design and the contested design (18/10/2012, C-101/11 P & C-102/11 P, Ornamentación, EU:C:2012:641, § 54).

The designs under comparison are shown in the table below, side by side. The comparison table contains images of the prior design available in Annexes 6 and 7 and in the applicant's observations. The images have been rotated for easier comparison with the contested design.

The Invalidity Division considers that the evidence of disclosure concerns one design of a 'WATER WOW!' pen, despite the pen in the screenshot of the video from 2018 having a wide tip, while that in the screenshot of the video from 2014 is thin. This difference may be due to use of the pen, and is negligible, as are any possible differences in the pen's shade of colour in the screenshots of both videos.



Prior design



Contested design

The applicant argues that the contested design reproduces most of the features of the prior design, with the only differences being:

- the text in the (otherwise identical) oval shape reading 'Melissa & Doug' in the prior design and 'WATERDOODLE' in the contested design; and
- the straight lines versus wavy lines in the (otherwise identical) semicircle of the (otherwise identical) yellow holder.

The Invalidity Division notes that both designs are incorporated in a toy writing instrument of the same shape and contours. Furthermore, both designs contain the same surface elements – in the yellow part, an oval with an embossed text and a semicircle with an embossed pattern, and in the blue part, bevelling. The designs coincide in their colours and both have a tip, which, in some images of the prior design, appears to be made of hair, like a brush.

The Invalidity Division agrees with the applicant's observations as to the differences between the designs – the differing texts in the oval and patterns in the semicircle. Their coinciding placement – the fact that they form the same relief in the same yellow cylindrical part – make the differences less striking. The identity or almost identity of the designs as to their main parts, colour combination and the oval and semi-circular elements prevail in the overall impression of the designs. In all those features, the designer was free to develop the design.

Considering all the above, the Invalidity Division concludes that the contested design does not produce a different overall impression on the informed user of toys used as writing instruments. The different surface text and pattern of the contested design does not endow it with an overall different impression. Due to the otherwise identity of the designs, the contested design lacks individual character.

## **CONCLUSION**

The facts and evidence submitted by the applicant support the grounds for invalidity under Article 25(1)(b) CDR in conjunction with Article 6(1)(b) CDR. Therefore, the application is upheld, and the contested design is declared invalid.

Since the application is fully successful on these grounds, there is no need to examine the other grounds of Article 25(1)(b) CDR invoked in the application, namely those in conjunction with Article 5(1)(b) CDR nor other prior designs invoked in the application.

## **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 holder is the losing party, it must bear the invalidity fee as well as the costs incurred by the applicant 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 applicant are the costs of representation, which are to be fixed on the basis of the maximum rate set therein, and the costs of the invalidity fee.





### **The Invalidity Division**

Rasa  
BARAKAUSKIENĖ

Ludmila  
ČELIŠOVÁ

Rebecca  
SANTANA DAVIES

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).