

JUDGMENT OF THE GENERAL COURT (Fifth Chamber)

18 March 2010*

In Case T-9/07,

Grupo Promer Mon Graphic SA, established in Sabadell (Spain), represented by
R. Almaraz Palmero, lawyer,

applicant,

v

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

defendant,

* Language of the case: English.

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

PepsiCo Inc., established in New York (United States), represented by E. Armijo Chávarri and A. Castán Pérez-Gómez, lawyers,

ACTION brought against the decision of the Third Board of Appeal of OHIM of 27 October 2006 (Case R 1001/2005-3) relating to invalidity proceedings between Grupo Promer Mon Graphic SA and PepsiCo Inc.,

THE GENERAL COURT (Fifth Chamber),

composed of M. Vilaras, President, M. Prek and V.M. Ciucă (Rapporteur), Judges,

Registrar: J. Palacio González, Principal Administrator,

having regard to the application lodged at the Court Registry on 9 January 2007,

having regard to the response of OHIM lodged at the Court Registry on 27 April 2007,

having regard to the response of the intervener lodged at the Court Registry on 30 April 2007,

further to the hearing on 8 July 2009,

gives the following

Judgment

Legal framework

1. *Regulation (EC) No 6/2002*

- 1 The rules relating to Community designs are laid down in Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1).
- 2 Article 3(a) of Regulation No 6/2002 provides:

‘For the purposes of this Regulation:

- (a) “design” means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.’

3 Article 10 of Regulation No 6/2002 provides:

‘1. The scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression.

2. In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration.’

4 Article 25 of the version of Regulation No 6/2002 applicable to the facts of the case provides:

‘1. A Community design may be declared invalid only in the following cases:

(a) if the design does not correspond to the definition under Article 3(a);

(b) if it does not fulfil the requirements of Articles 4 to 9;

- (c) if, by virtue of a court decision, the right holder is not entitled to the Community design under Article 14;

- (d) if the Community design is in conflict with a prior design which has been made available to the public after the date of filing of the application or, if a priority is claimed, the date of priority of the Community design, and which is protected from a date prior to the said date by a registered Community design or an application for such a design, or by a registered design right of a Member State, or by an application for such a right;

- (e) if a distinctive sign is used in a subsequent design, and Community law or the law of the Member State governing that sign confers on the right holder of the sign the right to prohibit such use;

- (f) if the design constitutes an unauthorised use of a work protected under the copyright law of a Member State;

- (g) if the design constitutes an improper use of any of the items listed in Article 6ter of the “Paris Convention” for the Protection of Industrial Property hereafter referred to as the “Paris Convention”, or of badges, emblems and escutcheons other than those covered by the said Article 6ter and which are of particular public interest in a Member State.

...

3. The grounds provided for in paragraph (1)(d), (e) and (f) may be invoked solely by the applicant for or holder of the earlier right.

...'

5 Article 36 of Regulation No 6/2002 provides:

'...

2. The application shall further contain an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied.

...

6. The information contained in the elements mentioned in paragraph 2 and in paragraph 3(a) and (d) shall not affect the scope of protection of the design as such.'

6 Under Article 43 of Regulation No 6/2002, 'the date of priority shall count as the date of the filing of the application for a registered Community design for the purpose of Articles ... 25(1)(d) ...'

- 7 Article 52(1) of Regulation No 6/2002 provides that ‘[s]ubject to Article 25(2), (3), (4) and (5), any natural or legal person, as well as a public authority empowered to do so, may submit to [OHIM] an application for a declaration of invalidity of a registered Community design.’
- 8 Under Article 61(1) of Regulation No 6/2002, ‘[a]ctions may be brought before the Court of Justice against decisions of the Boards of Appeal on appeals.’
- 9 The first sentence of Article 62 of Regulation No 6/2002 provides that ‘[d]ecisions of [OHIM] shall state the reasons on which they are based.’

2. Directive 98/71/EC

- 10 Article 1(a) of Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs (OJ 1998 L 289, p. 28) provides:

‘For the purpose of this Directive:

‘(a) “design” means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.’

¹¹ Under Article 9 of Directive 98/71:

‘1. The scope of the protection conferred by a design right shall include any design which does not produce on the informed user a different overall impression.

2. In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration.’

Background to the dispute

¹² On 9 September 2003, the intervener, PepsiCo Inc., filed an application for registration of a Community design at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) pursuant to Regulation No 6/2002. When the registration was applied for, priority was claimed for Spanish design No 157156, which had been filed on 23 July 2003 and whose application for registration was published on 16 November 2003.

- 13 The Community design was registered under number 74463-0001 for the following goods: 'promotional item[s] for games.' It is represented as follows:



- 14 On 4 February 2004, the applicant, Grupo Promer Mon Graphic SA, filed an application for a declaration of invalidity against design No 74463-0001 ('the contested design') pursuant to Article 52 of Regulation No 6/2002.

- 15 The application for a declaration of invalidity was based on registered Community design No 53186-0001 ('the prior design'), which has a filing date of 17 July 2003 and in respect of which priority is claimed for Spanish design No 157098, which was filed on 8 July 2003 and whose application for registration was published on 1 November 2003. The prior design is registered for 'metal plate[s] for games.' It is represented as follows:



- 16 The grounds relied on in support of the application for a declaration of invalidity alleged the lack of novelty and individual character of the contested design for the purposes of Article 25(1)(b) of Regulation No 6/2002, and the existence of a prior right for the purposes of Article 25(1)(d) thereof.
- 17 On 20 June 2005, the Invalidity Division of OHIM declared that the contested design was invalid on the basis of Article 25(1)(d) of Regulation No 6/2002.
- 18 On 18 August 2005, the intervener filed a notice of appeal with OHIM, pursuant to Articles 55 to 60 of Regulation No 6/2002, against the decision of the Invalidity Division.
- 19 By decision of 27 October 2006 ('the contested decision'), the Third Board of Appeal of OHIM annulled the decision of the Invalidity Division and dismissed the application for a declaration of invalidity. After rejecting the applicant's argument concerning the intervener's bad faith, the Board of Appeal held, in essence, that the contested design was not in conflict with the applicant's prior right and that the conditions set out in Article 25(1)(d) of Regulation No 6/2002 had not therefore been fulfilled. In that connection, the Board of Appeal held that the goods covered by the designs at issue concerned a particular category of promotional items, namely 'tazos' or 'rappers', and that, therefore, the freedom of the designer of those promotional items was severely restricted. Accordingly, the Board of Appeal concluded that the difference in the profile of the designs at issue was sufficient to conclude that they produced a different overall impression on the informed user.

Procedure and forms of order sought

20 The applicant claims that the Court should:

— annul the contested decision;

— order OHIM and the intervener to pay the costs of the proceedings before the Court and the Third Board of Appeal.

21 OHIM and the intervener contend that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law

1. Documents submitted for the first time before the Court

- ²² OHIM and the intervener contest the admissibility of documents Nos 6 to 9 appended to the application, which were not submitted at an earlier stage in the proceedings. Document No 6 consists of extracts, from the OHIM website, of two registered Community designs published on 9 March 2004 and representing hexagonal gameboard pieces. Document No 7 is a partial copy of a private agreement between the applicant and another company. Document No 8 is an extract from a website containing information on ‘pogs’ and ‘tazos’. Document No 9 shows the applicant’s range of products known as ‘BEYBLADE™ SPINNERS’.
- ²³ In reply to a question put by the Court, the applicant confirmed that documents Nos 6 to 9 had been submitted for the first time before it, but explained that it had produced those documents in the light of the grounds and the operative part of the contested decision.
- ²⁴ Those documents, produced for the first time before the Court, cannot be taken into consideration. The purpose of actions before the General Court is to review the legality of decisions of the Boards of Appeal of OHIM as referred to in Article 61 of Regulation No 6/2002, so it is not the Court’s function to review the facts in the light of documents produced for the first time before it. Accordingly, the abovementioned documents must be excluded, without it being necessary to assess their probative value (see, to that effect and by analogy, Case T-346/04 *Sadas v OHIM - LTJ Diffusion (ARTHUR ET FELICIE)* [2005] ECR II-4891, paragraph 19 and the case-law cited).

25 In addition, that conclusion is not called into question by the applicant's argument, at the hearing, that it submitted those documents in the light of the wording of the contested decision.

2. *Substance*

26 The applicant raises three pleas in law, alleging, first, the bad faith of the intervener and a restrictive interpretation of Regulation No 6/2002 in the contested decision, second, lack of novelty of the contested design and, third, infringement of Article 25(1)(d) of Regulation No 6/2002.

Plea in law alleging the bad faith of the intervener and a restrictive interpretation of Regulation No 6/2002

27 The applicant challenges the contested decision inasmuch as, by failing to take account of the intervener's bad faith, the Board of Appeal interpreted Regulation No 6/2002 restrictively. In that connection, the applicant submits that its prior design was 'disclosed' to the intervener on a private and confidential basis by a letter of 21 February 2003, in the context of commercial discussions, and that the basic lines of that design were copied in the contested design, which was filed subsequently. Accordingly, the date on which the prior design was made available to the public is of little relevance and, because of the uncertain nature of publication dates, in the present case the only question which matters is whether the prior design was filed before the contested design and whether the date of priority claimed is earlier.

28 OHIM and the intervener contest the applicant's arguments.

- 29 At paragraph 25 of the contested decision, the Board of Appeal found that the argument that the proprietor of the contested design was acting in bad faith was not relevant, since the question is not whether one of the designs at issue was copied from the other, but whether they produce the same overall impression.
- 30 The Court observes that Article 25(1) of Regulation No 6/2002 lists the grounds on which a Community design may be declared invalid. That list must be regarded as exhaustive, since Article 25 provides that a Community design may be declared invalid only on one of the grounds specified therein. It must be noted that there is no reference there to the bad faith of the proprietor of a contested design.
- 31 Moreover, it must be recalled that, in support of its application for a declaration of invalidity, the applicant relied on the lack of novelty and individual character of the contested design for the purposes of Article 25(1)(b) of Regulation No 6/2002 and the existence of a prior right for the purposes of Article 25(1)(d) thereof. Therefore, in examining those grounds for invalidity, the question of the alleged bad faith of the intervener is irrelevant, since it is not a matter of ruling on the conduct of the proprietor of a contested design.
- 32 Lastly, contrary to the applicant's claims, the date on which the design relied on in support of the application for a declaration of invalidity is made available to the public is one of the conditions for the application of Article 25(1)(b) and (d) of Regulation No 6/2002. The applicant states that the prior design was 'disclosed' to the intervener on a private and confidential basis, by a letter of 21 February 2003 and made available to the public on 1 November 2003. Therefore, it must be found that the design was not made available to the public on 21 February 2003 and that that 'disclosure' cannot be relied on for the purpose of applying Article 25(1)(b) and (d) of Regulation No 6/2002.
- 33 Consequently, the plea in law alleging the bad faith of the intervener and a restrictive interpretation of Regulation No 6/2002 must be rejected.

34 Next, it is appropriate to examine the plea in law alleging infringement of Article 25(1)(d) of Regulation No 6/2002.

Plea in law alleging infringement of Article 25(1)(d) of Regulation No 6/2002

Arguments of the parties

35 First, the applicant submits that ‘tazos’ or ‘rappers’ are not a category of goods in themselves, but belong to the category of promotional items for games. The applicant criticises the Board of Appeal for referring, at paragraphs 16 to 18 of the contested decision, to goods known as ‘tazos’, ‘pogs’ or ‘rappers’ as if they were identical, and regarding the word ‘tazos’ as the Spanish translation of the English word ‘rappers’. ‘Pogs’, which date from the 1920s, are two-dimensional, very flat pieces, made of cardboard and very difficult to move around or flip. On the other hand, ‘rappers’ are designed with a metal surface which allows them to be moved around and flipped very easily. Their central part and the fact that they are made of metal make them very different from the ‘pogs’ or ‘tazos’ created in the years 1994 to 1998, and allow them to be played with in a different way.

36 Second, referring to the category of promotional items for games, the applicant submits that the finding at paragraph 20 of the contested decision is therefore incorrect, namely that the freedom of the designer in developing the contested design was severely restricted.

37 Third, the informed user is a child in the approximate age range of 5 to 10, and not a marketing manager as stated at paragraph 16 of the contested decision. A marketing

manager working in the food industry is not an end user and has a higher degree of expertise than a simple user.

- 38 Fourth, the designs at issue produce the same overall impression, since, contrary to the analysis at paragraphs 22 and 24 of the contested decision, the differences in the profile of the designs at issue are not obvious; particular attention and careful observation of the disc is required in order to discover them. The applicant doubts whether a young child will examine them very carefully in profile in order to discover their differences.
- 39 First, OHIM contends that it is for the parties to provide information regarding the specific nature of the goods at issue, the particular characteristics of the relevant market and the perception of the designs on that market by the informed user. Before the Board of Appeal, the intervener gave evidence on the goods in question, and ‘it suddenly became clear’ that ‘pogs’ form a self-contained category of goods that has a market on its own and that their particular method of use influences their shape and features. Referring to paragraph 17 of the contested decision, OHIM contends that the intervener thereby proved that the informed user was acquainted with the flat circular game pieces that may be given away as promotional items, in particular in the food industry.
- 40 Second, OHIM states that, in accordance with paragraph 20 of the contested decision, the ‘pogs’ provided by the parties to the Board of Appeal all consist of flat discs made of plastic or cardboard on which images are printed, the raised central part of which is designed to make a noise if pressed. OHIM further contends that that raised central part of the disc must be of metal in order to produce a noise, that it serves to enhance the capacity of the ‘pog’ to flip in order to introduce a random element to the game, and that it must be elementary in shape in order not to distort the image covering the ‘pogs’. The edges must be rounded for safety purposes, and the raised central part must not be higher than the edges so that the ‘pogs’ may be stacked. The Board of Appeal was therefore correct to conclude that the designer’s degree of freedom was limited by those constraints. Lastly, OHIM contends that the conclusion at paragraph 24 of the contested decision is well founded if the Court accepts that, on

the date of priority of the prior design, an informed user expected a product such as a ‘pog’ or any other product within that self-contained category of goods to be in the shape of a disc, because that was the norm for the industrial sector in question.

- 41 Third, that user is informed, and therefore observant, and has some awareness of previous designs and the product trends in the relevant market. However, he is neither a designer nor a manufacturer of the product in question. He also has a chance, *inter alia*, to make a direct comparison between the designs at issue. In response to the applicant’s argument, OHIM states that in the present case children aged between 5 and 10 are as observant as any category of adults, if not more so.
- 42 Fourth, OHIM submits that the applicant agrees with the analysis at paragraphs 22 and 23 of the contested decision that the comparison between the designs is to be confined to the graphic representations. Whether the designs at issue are intended to be applied to metal discs is irrelevant since no such specification was claimed in the registrations. The contested decision refers to differences in profile, because the projections of the designs at issue cannot be seen from above. In the light of the designer’s limited degree of freedom, even relatively minor differences suffice to create a different overall impression. The designs at issue have differences in the two main areas in which the designer’s freedom is expressed, namely the choice of the pattern that decorates the centre of the ‘pogs’ and configuration of the centre on that raised surface.
- 43 The intervener contends, first, that ‘tazos’ or ‘rappers’ form a particular category of promotional items, to which metal ‘tazos’ or ‘rappers’ belong. It has been marketing that type of goods for over 10 years. In addition, the fact that they are metal is irrelevant since this is merely functional.

- 44 Second, all the samples of ‘tazos’ or ‘rappers’ that the parties submitted to OHIM show that the goods which the applicant and the intervener market are flat, round in shape, with rounded edges and covered in colour images. The designer’s degree of freedom is very low in respect of the goods in question and minor details are sufficient to create a different overall impression.
- 45 Third, as regards the informed user, whether a child or a marketing manager, the essential point is that he is familiar with the phenomenon of ‘tazos’ or ‘rappers’, as the Board of Appeal makes clear at paragraphs 17 and 19 of the contested decision. Since the informed user is capable of detecting any small differences between various types of ‘tazos’ or ‘rappers’ that are different from the norm, marketing companies offer increasingly sophisticated ones on the market.
- 46 Fourth, the designs at issue produce a different overall impression, as the Board of Appeal shows at paragraphs 21 to 26 of the contested decision. There are substantial differences between the upper surfaces of the designs at issue, which are the most visible surfaces for users, and, accordingly, those differences are not irrelevant, in particular for an informed user.

Findings of the Court

- 47 Under Article 25(1)(d) of Regulation No 6/2002, a Community design may be declared invalid if it is in conflict with a prior design which has been made available to the public after the date of filing of the application or, if a priority is claimed, the date of priority of the Community design, and which is protected from a date prior to the said date by a registered Community design or an application for such a design, or by a registered design right of a Member State, or by an application for such a right.

- 48 Since 'conflict' is not defined as such in Regulation No 6/2002, it is necessary to clarify that concept. At paragraphs 14 and 15 of the contested decision, the Board of Appeal found, like the Invalidity Division, that a conflict arose between two designs when they produced the same overall impression on the informed user, and that in that connection the degree of freedom of the designer in developing the contested design had to be taken into account.
- 49 For the purposes of the interpretation of Article 25(1)(d) of Regulation No 6/2002, it must be recalled that, in accordance with Article 10 of Regulation No 6/2002 in the case of a Community design, and Article 9 of Directive 98/71 in the case of a design registered in a Member State, the scope of the protection conferred by a design is to include any design which does not produce on the informed user a different overall impression and that, in assessing the scope of that protection, the degree of freedom of the designer in developing his design is to be taken into consideration.
- 50 In that connection, it must be noted, first of all, that in the vast majority of the language versions, the wording of Article 10(1) of Regulation No 6/2002, like that of Article 9(1) of Directive 98/71, indicates that the issue is one of a 'different overall impression'. Two language versions (namely the French and Romanian language versions) in the case of Article 10 of Regulation No 6/2002, and one language version (namely the French language version) in the case of Article 9 of Directive 98/71, state that the issue is one of a 'different overall visual impression'. However, since, under Article 3(a) of Regulation No 6/2002 and Article 1(a) of Directive 98/71, a design is only the appearance of the whole or a part of a product, it must be found that the overall impression to which Article 10(1) of Regulation No 6/2002 and Article 9(1) of Directive 98/71 refer must be a visual one. Thus, the difference in wording between the language versions does not confer a different meaning in that respect on that provision.
- 51 Next, it is apparent from Article 10(2) of Regulation No 6/2002 and from Article 9(2) of Directive 98/71 that, in assessing whether a design is in conflict with a prior design, the designer's freedom in developing his design is to be taken into consideration.

- 52 Consequently, Article 25(1)(d) of Regulation No 6/2002 must be interpreted as meaning that a Community design is in conflict with a prior design when, taking into consideration the freedom of the designer in developing the Community design, that design does not produce on the informed user a different overall impression from that produced by the prior design relied on. The Board of Appeal was therefore correct to adopt such an interpretation.
- 53 That interpretation of Article 25(1)(d) of Regulation No 6/2002 is the only one which can ensure that the rights of the proprietor of a prior design that is referred to in that provision is protected against any infringement of the design resulting from the coexistence of a subsequent Community design that produces the same overall impression on the informed user. If Article 25(1)(d) of Regulation No 6/2002 were not interpreted in that manner, the proprietor of a prior right would be precluded from applying for a declaration of invalidity in respect of a subsequent Community design that produces the same overall impression and be deprived of the actual protection conferred by his design under Article 10 of Regulation No 6/2002 or Article 9 of Directive 98/71.

— The product in which the contested design is intended to be incorporated or to which it is intended to be applied

- 54 The applicant challenges the contested decision inasmuch as the Board of Appeal defined the category of goods identified by the designs at issue as being that of ‘pogs’, ‘rappers’ or ‘tazos’, whereas those products are not a homogeneous category of goods. The applicant submits that the Board of Appeal ought to have taken into consideration the category of promotional items for games.
- 55 The Court observes that, under Article 3(a) of Regulation No 6/2002, a design is the appearance of a product, and Article 36(2) of that regulation requires that an application for a registered Community design is to contain an indication of the products in

which the design is intended to be incorporated or to which it is intended to be applied. However, it must be pointed out that, although the indication of those products in the application for a registered Community design is compulsory, that information does not, by virtue of Article 36(6) of Regulation No 6/2002, affect the scope of protection of the design as such.

56 Accordingly, it follows from Article 36(6) of Regulation No 6/2002 that, in order to ascertain the product in which the contested design is intended to be incorporated or to which it is intended to be applied, the relevant indication in the application for registration of that design should be taken into account, but also, where necessary, the design itself, in so far as it makes clear the nature of the product, its intended purpose or its function. Taking into account the design itself may enable the product to be placed within a broader category of goods indicated at the time of registration and, therefore, to determine the informed user and the degree of freedom of the designer in developing his design.

57 It must be recalled that, at paragraphs 16 and 20 of the contested decision, the Board of Appeal found that the products in which the designs at issue are intended to be incorporated or to which they are intended to be applied were known as 'pogs' or 'rappers' in English, or 'tazos' in Spanish, whereas the Invalidity Division had taken into consideration the category 'promotional items for games'.

58 In the present case, the contested design was registered for the following goods: 'promotional item[s] for games'.

59 Although the parties agree that the contested design is intended to be applied, like the prior design, to promotional items for games, an examination of the design shows that it belongs to a particular category of those promotional items. In addition, as the Board of Appeal noted at paragraph 17 of the contested decision, the intervener

submitted evidence to the Board of Appeal concerning the goods in question, in particular evidence concerning ‘tazos’, which it has been marketing since 1995. Thus, the Board of Appeal was entitled to find that the intervener had thereby enabled the nature and function of the goods, game pieces known as ‘pogs’, ‘rappers’ or ‘tazos’, actually to be determined. Moreover, at paragraph 16 of the contested decision, the Board of Appeal stated that those specific promotional items for games were intended for young children and that they were generally used to promote biscuits or potato snacks, which is agreed by the parties.

- 60 Accordingly, it must be concluded that the Board of Appeal properly found that the product in question belonged, within the broad category of promotional items for games, to the particular category of game pieces known as ‘pogs’, ‘rappers’ or ‘tazos’.

— The informed user

- 61 The applicant challenges the contested decision inasmuch as the Board of Appeal found that the informed user could also be a marketing manager, whereas, in the present case, the informed user is a child in the approximate age range of 5 to 10.

- 62 It must be found that the informed user 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. The informed user is particularly observant and has some awareness of the state of the prior art, that is to say the previous designs relating to the product in question that had been disclosed on the date of filing of the contested design, or, as the case may be, on the date of priority claimed.

63 In that connection, although the Board of Appeal did not define the informed user precisely in the present case, it did not, contrary to the applicant's claims, rule out the possibility that he could be a child in the approximate age range of 5 to 10.

64 The Board of Appeal was correct to find, at paragraphs 16 and 17 of the contested decision, that the informed user could be a child in the approximate age range of 5 to 10 or a marketing manager in a company that makes goods which are promoted by giving away 'pogs', 'rappers' or 'tazos'. It follows from the definition of the informed user as set out at paragraph 62 above that, in the present case, since the products to which the contested design is intended to be applied are 'pogs', 'rappers' or 'tazos', the informed user must be regarded as having some awareness of the state of the prior art thereof. In addition, since the game pieces are intended more specifically for children, the informed user may, as the Board of Appeal stated in the contested decision, be a child in the approximate age range of 5 to 10, which neither OHIM nor the intervener disputes. However, since the goods are also promotional items, in the present case the informed user could also be a marketing manager in a company that uses that type of goods in order to promote its own products.

65 As the Board of Appeal made clear at paragraphs 16 and 17 of the contested decision, it makes little difference whether the informed user is a child in the approximate age range of 5 to 10 or the marketing manager in a company that makes products which are promoted by giving away 'pogs', 'rappers' or 'tazos'; the important point is that both those categories of person are familiar with the phenomenon of 'rappers'.

— The degree of freedom of the designer

66 Proceeding on the basis that the contested design relates to the general category of promotional items, the applicant challenges the contested decision inasmuch as the Board of Appeal concluded at paragraph 20 thereof that in the present case the freedom of the designer was severely restricted.

- 67 In that connection, it must be noted that 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.
- 68 At paragraph 18 of the contested decision, the Board of Appeal stated that all the 'rappers' or 'tazos' examined in the present case consisted of small, flat or slightly curved discs which may be made of plastic or metal. Accordingly, it concluded, at paragraph 20 of that decision, that the freedom enjoyed by the designer responsible for designing a product of that kind was severely restricted, because, for that type of product, '[t]he paradigm ... is a small flat or nearly flat disk on which coloured images can be printed [and o]ften the disk [is] curved toward[s] the centre, so that a noise [is] made if a child's finger presses the centre of the disk', and '[a] rapper that does not possess these characteristics is unlikely to be accepted in the marketplace'.
- 69 In that connection, it must be noted that 'pogs', 'rappers' or 'tazos' are circular in shape and that, on the date of filing of the application for registration of the contested design, in this case on the date of priority claimed for the design, 'pogs', 'rappers' or 'tazos' had those common features which the designer had to take into account, as set out at paragraphs 18 and 20 of the contested decision and reiterated at paragraph 68 above. That finding is not, moreover, contested by the parties.
- 70 Therefore, it must be held that the Board of Appeal was correct to find in the contested decision that, on the date of priority claimed for the contested design, the designer's freedom was severely restricted since he had to incorporate those common features in his design for the product in question. Moreover, as the Board of Appeal pointed out at paragraph 20 of the contested decision, the designer's freedom was also limited in so far as those items had to be inexpensive, safe for children and fit to be added to the products which they promote.

— Overall impression produced by the designs at issue on the informed user

- 71 The applicant challenges the Board of Appeal's finding in the contested decision that the designs at issue produce a different overall impression on the informed user.
- 72 In the specific assessment of the overall impression of the designs at issue on the informed user, who has some awareness of the state of the prior art, the designer's degree of freedom in developing the contested design must be taken into account. Thus, as the Board of Appeal pointed out at paragraph 19 of the contested decision, in so far as similarities between the designs at issue relate to common features, such as those described at paragraph 67 above, those similarities will have only minor importance in the overall impression produced by those designs on the informed user. In addition, 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.
- 73 As has been reiterated at paragraph 68 above, after establishing, at paragraphs 18 and 20 of the contested decision, the constraints on the designer in developing the contested design, the Board of Appeal found that the designer's freedom was in the present case severely restricted.
- 74 At paragraph 19 of the contested decision, the Board of Appeal also stated that, as regards the assessment of the overall impression produced by the designs at issue on the informed user, the latter will automatically disregard elements 'that are totally banal and common to all examples of the type of product in issue' and will concentrate on features 'that are arbitrary or different from the norm.'

- 75 Next, at paragraphs 21 to 24 of the contested decision, the Board of Appeal compared the designs at issue, describing the prior design and then the contested design, before concluding that there was a 'difference in the contours of the raised area in the centre of the disks'. Accordingly, it found, at paragraph 24 of that decision, that, given the limited degree of freedom of the designer in developing the contested design, that difference in the profile was sufficient to conclude that the designs produced a different overall impression on the informed user.
- 76 The designs at issue must be compared by reference to the criteria set out at paragraph 72 above, by examining their similarities and their differences, in order to ascertain, taking into account the degree of the designer's freedom in developing the contested design, whether the Board of Appeal was entitled, without committing any error, to conclude that the designs at issue created a different overall impression on the informed user.
- 77 As regards the similarities between the designs at issue, first, the Board of Appeal noted, at paragraph 22 of the contested decision, that both designs consisted of small discs that are almost flat. However, since, on the date of priority claimed for the contested design, that was a feature common to the designs for the goods of the type of product at issue, as noted by the Board of Appeal at paragraphs 18 and 20 of the contested decision, that similarity would not be remembered by the informed user in the overall impression of the designs at issue.
- 78 Second, the Board of Appeal also observed at paragraph 22 of the contested decision that the designs at issue both had a concentric circle very close to the edge intended to convey the idea that the disc curls over all the way round the edge. It must be noted that the designs at issue may be applied to a metal product, which is not disputed by the applicant or the intervener. Since the product is intended for children in particular, that rounded edge may therefore constitute a constraint for the designer, linked to safety requirements, so that the product does not have a sharp edge if made of metal or even of plastic or cardboard. Thus, since that similarity between the designs at issue in respect of one of their features may constitute a constraint on the designer, it will not attract the informed user's attention.

- 79 Third, the designs at issue both contain a concentric circle approximately one third of the way from the edge to the centre. At paragraph 22 of the contested decision, the Board of Appeal noted that similarity, stating that that circle was intended to convey the idea that the central part of the disc is raised slightly. However, the Court finds that that central part could have been delineated by a shape other than a circle. For it is apparent from the application for registration of the contested design, included in OHIM's file forwarded to the Court, that the contested design claims the priority of a Spanish design No 157156 which comprises three variants, and that that raised central part is, depending on the variant, delineated by a circle, a triangle or a hexagon. In addition, that finding cannot be called into question by the argument put forward by OHIM, at the hearing, that the shape had to be elementary in order not to distort the image which may cover the disc, since a triangular, hexagonal, or even a square or oval shape instead of circular one would not have distorted the image any more. Furthermore, that finding cannot be called into question by OHIM's argument that a circle had to be used so that that raised central part might be curved, because, *inter alia*, an oval shape could have been used.
- 80 Fourth, the designs at issue are similar in that the rounded edge of the disc is raised in relation to the intermediate area of the disc between the edge and the raised central area.
- 81 Fifth, the respective dimensions of the raised central part and the intermediate area of the disc, between the edge and the raised central part, are similar in the designs at issue.
- 82 In the absence of any specific constraint imposed on the designer, the similarities noted in paragraphs 79 to 81 above relate to elements in respect of which the designer was free to develop the contested design. It follows that those similarities will attract the informed user's attention, all the more so because, as the intervener itself stated, the upper surfaces are, in the present case, the most visible surfaces for that user.

- 83 As regards the differences between the designs at issue, as the Board of Appeal observed at paragraph 23 of the contested decision, when viewed from above, the contested design has two additional circles compared with the prior design. In profile, the two designs differ in that the contested design is more curved. However, it must be found that since the degree of curvature is slight, and the discs are thin, that curvature will not be easily perceived by the informed user, in particular when viewed from above, and this is borne out by the goods actually marketed, as contained in OHIM's file forwarded to the Court.
- 84 In the light of the similarities noted in paragraphs 79 to 81 above, it must be held that the differences observed by the Board of Appeal at paragraph 23 of the contested decision (see paragraph 83 above) are insufficient for the contested design to produce a different overall impression on the informed user from that produced by the prior design.
- 85 It follows from all the above considerations that the Board of Appeal erred in finding in the contested decision that the designs at issue produced a different overall impression on the informed user and that they were not in conflict within the meaning of Article 25(1)(d) of Regulation No 6/2002. Accordingly, the contested decision was adopted in breach of that provision and must therefore be annulled, it not being necessary to examine the final plea of annulment raised by the applicant.

Costs

- 86 Under Article 87(2) of the Rules of Procedure of the Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Moreover, under that same article, where there are several unsuccessful parties, the Court is to decide how the costs are to be shared.

87 In the present case, since OHIM and the intervener have been unsuccessful, they must be ordered to pay the costs incurred by the applicant in the proceedings before the Court, in accordance with the form of order sought by the applicant.

88 The applicant also applied for OHIM and the intervener to be ordered to pay the costs incurred by it for the purposes of the proceedings before the Board of Appeal. In that connection, under Article 136(2) of the Rules of Procedure, costs necessarily incurred by the parties for the purposes of the proceedings before the Board of Appeal are to be regarded as recoverable costs. Therefore, since OHIM and the intervener have been unsuccessful, they must also be ordered to pay the costs incurred by the applicant for the purposes of the proceedings before the Board of Appeal, in accordance with the form of order sought by the applicant.

On those grounds,

THE GENERAL COURT (Fifth Chamber)

hereby:

- 1. Annuls the decision of the Third Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 27 October 2006 (Case R 1001/2005-3);**

- 2. Orders OHIM and PepsiCo Inc. to bear their own costs and to pay those incurred by Grupo Promer Mon Graphic SA in the proceedings before the General Court;**

- 3. Orders OHIM and PepsiCo to bear their own costs and to pay those incurred by Grupo Promer Mon Graphic in the proceedings before the Board of Appeal.**

Vilaras

Prek

Ciucă

Delivered in open court in Luxembourg on 18 March 2010.

[Signatures]