



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Second Chamber)

16 June 2021 *

(Community design – Invalidity proceedings – Registered Community design representing a table lamp – Earlier Community design – Ground for invalidity – No individual character – Article 6 of Regulation (EC) No 6/2002)

In Case T-187/20,

Davide Groppi Srl, established in Piacenza (Italy), represented by F. Boscarior de Roberto, D. Capra and V. Malerba, lawyers,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by L. Rampini, acting as Agent,

defendant,

the other party to the proceedings before the Board of Appeal of EUIPO being

Viabizzuno Srl, established in Bentivoglio (Italy),

ACTION brought against the decision of the Third Board of Appeal of EUIPO of 23 January 2020 (Case R 126/2019-3) concerning invalidity proceedings between Viabizzuno and Davide Groppi,

THE GENERAL COURT (Second Chamber),

composed of V. Tomljenović, President, P. Škvařilová-Pelzl and I. Nömm (Rapporteur), Judges,

Registrar: R. Ūkelytė, Administrator,

having regard to the application lodged at the Court Registry on 9 April 2020,

having regard to the response lodged at the Court Registry on 14 July 2020,

having regard to the Court's written question to the parties and their responses to that question lodged at the Court Registry on 9 and 18 December 2020,

* Language of the case: Italian.

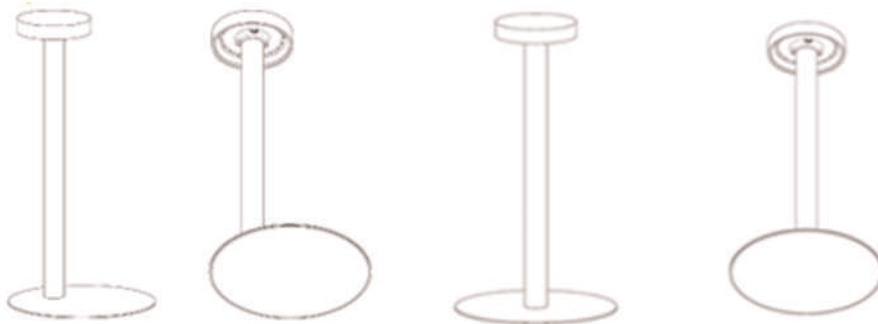
further to the hearing on 27 January 2021,

gives the following

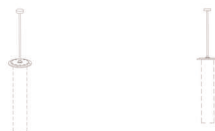
Judgment

Background to the dispute

- 1 On 16 July 2014, the applicant, Davide Groppi Srl, applied for and obtained from the European Union Intellectual Property Office (EUIPO), on the basis of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1), registration under number 2503680-0001 of the Community design which is contested in the present case, represented below:



- 2 The goods to which the contested design is intended to be applied are in Class 26-05 of the Locarno Agreement of 8 October 1968 establishing an International Classification for Industrial Designs, as amended, and correspond to the following description: ‘Lamps’. The application for registration as a Community design was published in *Community Designs Bulletin* No 2014/133 of 21 July 2014.
- 3 On 3 March 2017, the other party to the proceedings before the Board of Appeal of EUIPO, Viabizzuno Srl, filed an application with EUIPO for a declaration of invalidity of the contested design, pursuant to Article 52 of Regulation No 6/2002.
- 4 The ground relied on in support of the application for a declaration of invalidity was that referred to in Article 25(1)(b) of Regulation No 6/2002, read in conjunction with Articles 4 to 6 of that regulation, relating to earlier design No 1294664-0010 of 22 September 2011, represented below:





- 5 On 4 August 2017, the applicant requested that the proceedings be stayed on the ground that an application for a declaration of invalidity had been sought in respect of the earlier Community design.
- 6 On 22 November 2018, the Cancellation Division upheld the application for a declaration of invalidity on the ground that the contested design did not have individual character within the meaning of Article 6 of Regulation No 6/2002.
- 7 On 17 January 2019, the applicant filed a notice of appeal with EUIPO pursuant to Articles 55 to 60 of Regulation No 6/2002.
- 8 By decision of 23 January 2020 ('the contested decision'), the Third Board of Appeal of EUIPO dismissed the appeal brought by the applicant. It held that:
 - the fact that the earlier design had been declared invalid was irrelevant, since the only thing that mattered was whether that design had been disclosed;
 - the informed user of the product concerned by the contested design was deemed to be aware of what is available on the market, in that sector, in terms of table lamps and garden lamps;
 - the designer had a very high degree of freedom;
 - it was apparent from the comparison of the overall impressions produced by the designs at issue that the contested design evoked a sense of 'déjà vu', since the designs at issue represented lamps, composed of the same three distinct parts (a base, an arm and a lampshade), each of which was represented, visually, in an almost identical way;
 - the differences between the base in the contested design, which is flat and smooth, and the base in the earlier design, which has double the surface area and has mounting holes in it, did not have a decisive influence on the overall impression produced by the designs at issue, given that those differences (i) concerned a part which is often hidden during use, (ii) were due to technical requirements, and (iii) could not offset the strong similarities between the other two parts of the lamps;
 - the difference, claimed by the applicant, relating to proportion in the size relationship between the base, the arm and the lampshade could be perceived only if each of the three elements were to be carefully measured, which the informed user will not do. Moreover, that difference was not relevant, since the comparison of the overall impressions produced by the designs at issue must be carried out in a holistic manner.

Forms of order sought

- 9 The applicant claims that the Court should:
- annul the contested decision;
 - order EUIPO and the other party to the proceedings before the Board of Appeal to pay the costs.
- 10 EUIPO contends that the Court should:
- dismiss the appeal;
 - order the applicant to pay the costs.

Law

- 11 In support of its action, the applicant relies on a single plea in law, alleging infringement of Article 25(1)(b) of Regulation No 6/2002, read in conjunction with Article 6 of that regulation. This plea consists of two parts, alleging errors vitiating, first, the definition of the category of goods concerned and, secondly, the comparison of the overall impressions produced by the designs at issue.
- 12 Since both parts of the single plea relate to alleged errors committed by the Board of Appeal in the application of Article 6 of Regulation No 6/2002 to the present case, they should be examined together.
- 13 Article 25(1) of Regulation No 6/2002 provides that a Community design may be declared invalid only in the cases referred to in points (a) to (g) of Article 25(1), in particular in the case referred to in point (b), namely if it does not fulfil the requirements of Articles 4 to 9 of that regulation.
- 14 According to Article 6(1)(b) of Regulation No 6/2002, 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 date of filing of the application for registration or, if a priority is claimed, the date of priority.
- 15 Article 6(2) of Regulation No 6/2002 also states that, in assessing that individual character, the designer's degree of freedom in developing the design must be taken into consideration.
- 16 Furthermore, it is apparent from recital 14 of Regulation No 6/2002 that, when assessing whether a design has individual character, account should be taken of the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs and the designer's degree of freedom in developing the design.
- 17 The assessment as to whether a Community design has individual character involves an examination carried out, in essence, in four stages. That examination consists of deciding upon, first, the sector to which the products in which the design is intended to be incorporated or to which it is intended to be applied belong; secondly, the informed user of those products in

accordance with their purpose and, with reference to that informed user, the degree of awareness of the prior art and the level of attention to the similarities and the differences in the comparison of the designs; thirdly, the designer's degree of freedom in developing his or her design, the influence of which on individual character is in inverse proportion; and, fourthly, taking that degree of freedom into account, the outcome of the comparison, direct if possible, of 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 (see judgment of 13 June 2019, *Visi/one v EUIPO – EasyFix (Door hanger for vehicles)*, T-74/18, EU:T:2019:417, paragraph 66 and the case-law cited).

- 18 Since it is common ground that the earlier design was disclosed, for the purposes of Article 7(1) of Regulation No 6/2002, it is necessary to examine the merits of the Board of Appeal's findings concerning, first, the determination of the informed user of the contested design and the product concerned by that design, secondly, the designer's degree of freedom in developing that design and, thirdly, the comparison of the overall impressions produced by the designs at issue.
- 19 As a preliminary point, it should be noted that the earlier design was declared invalid by EUIPO on 30 October 2018.
- 20 The applicant highlighted that fact before the Board of Appeal in order to argue that the application for a declaration of invalidity submitted by the other party to the proceedings before that board should be rejected. The Board of Appeal rejected that criticism in paragraph 12 of the contested decision, stating that 'the fact that the earlier Community design has been declared invalid in the meantime does not - contrary to what is claimed by the proprietor [of the contested design] in the grounds put forward in support of the appeal - negate the logical and legal presumption of the appeal, which is not that the Community design is valid, but that it has been disclosed, which has not, moreover, been disputed'.
- 21 Such an analysis, which, moreover, is no longer challenged by the applicant before the Court, must be accepted, since the ground for invalidity relied on against the registration of the contested design is that based on Article 25(1)(b) of Regulation No 6/2002.
- 22 The rationale behind Article 25(1)(a) and (b) of Regulation No 6/2002 is not to protect earlier designs, but to prevent the registration of designs which do not fulfil the requirements for protection, in particular the requirements as to their 'novelty' and their 'individual character', within the meaning of Article 5 and Article 6 of that regulation, respectively.
- 23 In that regard, the grounds for invalidity set out in Article 25(1)(a) and (b) of Regulation No 6/2002 differ from that provided for, for example, in Article 25(1)(e) of that regulation, which seeks to protect the proprietor of a distinctive sign from the use of that sign in a design. Where the function of such a ground is the protection of an earlier right, it must be held that, in the event that an action for a declaration of invalidity against that right is upheld, the invalidity proceedings against the Community design would be devoid of purpose (judgment of 9 September 2015, *Dairek Attoumi v OHIM – Diesel (DIESEL)*, T-278/14, not published, EU:T:2015:606, paragraph 24).

- 24 Such an approach cannot, however, be transposed to the grounds referred to in Article 25(1)(a) and (b) of Regulation No 6/2002, which are not compatible with the protection of an earlier right, given only to the holder of that right. It is apparent from the case-law that such grounds may, in principle, be relied on by any person (judgment of 13 June 2019, *Door hanger for vehicles*, T-74/18, EU:T:2019:417, paragraph 64).
- 25 As regards, more specifically, the assessment as to whether a design has individual character under Article 25(1)(b) of Regulation No 6/2002, read in conjunction with Article 6 thereof, it is apparent from recital 14 of that regulation that that assessment should be based on whether the overall impression produced on an informed user viewing the design clearly differs from that produced on him by the existing design corpus.
- 26 In the context of the examination of the ground for invalidity referred to in Article 25(1)(b) of Regulation No 6/2002, read in conjunction with Article 6 thereof, the sole function of the earlier design is to reveal the state of the prior art, that is to say the corpus of previous designs relating to the product in question that were disclosed on the date of filing of the contested design (see, to that effect, judgment of 7 February 2019, *Eglo Leuchten v EUIPO – Briloner Leuchten (Lamp)*, T-767/17, not published, EU:T:2019:67, paragraph 19 and the case-law cited). However, the fact that a prior design belongs to that corpus of previous designs is the result of the mere disclosure of that design.
- 27 Therefore, what matters is the fact that the earlier design has been disclosed, and not the scope of the protection afforded to that design once the validity of its registration has been established.

The informed user and the product concerned by the contested design

- 28 In paragraphs 15 to 17 of the contested decision, the Board of Appeal found that, since the contested design designated ‘lamps’, the informed user was the person who uses that lighting fixture, who was deemed to know what is available on the market in terms of table and garden lamps.
- 29 The applicant complains that the Board of Appeal equated two different products, namely table lamps and garden lamps. First, it submits that the determination of the products in which the design is intended to be incorporated or to which it is intended to be applied is a prerequisite for the comparison of the overall impressions produced. It adds that it is insufficient to take into account only the written indication of the product in the application for registration of the contested design, and that account should also be taken, where appropriate, of the design itself. Secondly, it submits that, even though table lamps and garden lamps belong to the broader category of lamps, they differ in their nature, function and intended purpose.
- 30 EUIPO disputes those arguments.
- 31 As regards, in the first place, the determination of the product in which the design is intended to be incorporated or to which it is intended to be applied, account must be taken of the indication referring to it in the application for registration of that design, but also, where appropriate, of the design itself, in so far as the design makes clear the nature of the product, its intended purpose or its function. Taking into account the design itself may enable the product concerned to be placed within a broader category of goods such as that indicated at the time of registration (see, to that effect, judgment of 18 March 2010, *Grupo Promer Mon Graphic v OHIM – PepsiCo, (Representation of a circular promotional item)*, T-9/07, EU:T:2010:96, paragraph 56).

- 32 In that regard, it should be noted that the registration of the contested design refers generally to lamps. Furthermore, the examination of the contested design itself does not provide any additional information. The only inference to be drawn from the design is that the product concerned by it constitutes a lamp. It is not possible to determine whether it is intended to be used specifically for indoor or outdoor lighting purposes.
- 33 The Board of Appeal was therefore correct to identify those goods as being ‘lamps’ in general.
- 34 Furthermore, as regards the applicant’s arguments based on the alleged differences between the products concerned by the designs at issue, it must be pointed out that, although the determination of the sector of the products in which the design is intended to be incorporated or to which it is intended to be applied is a relevant consideration for determining the informed user and his or her level of attention, for determining the designer’s degree of freedom in developing the design and, possibly, when comparing the overall impressions produced on that informed user (see, to that effect, judgment of 20 October 2011, *PepsiCo v Grupo Promer Mon Graphic*, C-281/10 P, EU:C:2011:679, paragraphs 53, 59 and 73), it cannot, however, imply that the products concerned by the designs at issue are similar or belong to the same sector.
- 35 Under Article 25(1)(b) of Regulation No 6/2002, there is no requirement of similarity between the goods equivalent to that which applies when assessing the likelihood of confusion under Article 8(1)(b) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1). On the contrary, if the protection of a design were made dependent on the nature of the product in which that design is incorporated or to which it is applied, such protection would be limited only to the designs belonging to a specific sector, which would be inconsistent with the rationale behind Regulation No 6/2002 (see, to that effect, and by analogy, judgment of 21 September 2017, *Easy Sanitary Solutions and EUIPO v Group Nivelles*, C-361/15 P and C-405/15 P, EU:C:2017:720, paragraphs 91 to 95).
- 36 As regards, in the second place, identifying the ‘informed user’, it should be noted that Regulation No 6/2002 does not define that concept. However, it must be understood as lying somewhere between that of the average consumer, applicable in trade mark matters, who need not have any specific knowledge and who, as a rule, makes no direct comparison between the trade marks in conflict, and the sectoral expert, who is an expert with detailed technical expertise. Thus, the concept of the informed user may be understood as referring not to a user of average attention, but to a particularly observant one, either because of his or her personal experience or because of his or her extensive knowledge of the sector in question (judgment of 20 October 2011 in *PepsiCo v Grupo Promer Mon Graphic*, C-281/10 P, EU:C:2011:679, paragraph 53).
- 37 As regards the informed user’s level of attention, it should be noted that, although the informed user is not the well-informed and reasonably observant and circumspect average consumer who normally perceives a design as a whole and does not proceed to analyse its various details, he is also not an expert or specialist capable of observing in detail the minimal differences that may exist between the designs in conflict. Thus, the qualifier ‘informed’ suggests that, without being a designer or a technical expert, the user knows the various designs which exist in the sector concerned, possesses a certain degree of knowledge with regard to the features which those designs normally include, and, as a result of his or her interest in the products concerned, shows a relatively high degree of attention when he or she uses them (see, to that effect, judgment of 20 October 2011 in *PepsiCo v Grupo Promer Mon Graphic*, C-281/10 P, EU:C:2011:679, paragraph 59).

38 In the light of that case-law, the Board of Appeal did not err in finding, in paragraphs 15 to 17 of the contested decision, that the user was the person who uses the lighting fixtures constituted by the lamps, who was deemed to know what is available on the market in that sector.

The designer's degree of freedom

39 According to the case-law, the designer's degree of freedom 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 several designs applied to the product concerned (judgment of 18 March 2010, *Representation of a circular promotional item*, T-9/07, EU:T:2010:96, paragraph 67).

40 The designer's degree of freedom is, in that context, a factor which makes it possible to moderate the assessment of the individual character of the contested design, rather than an independent factor which determines how different two designs have to be for one of them to be able to rely on individual character. In other words, the factor relating to the designer's degree of freedom may reinforce or, *a contrario*, moderate the conclusion as regards the overall impression produced by each design at issue (see judgment of 6 June 2019, *Porsche v EUIPO – Autec (Motor vehicles)*, T-209/18, EU:T:2019:377, paragraph 48 and the case-law cited).

41 The influence of the factor relating to the designer's degree of freedom on individual character varies according to a rule of inverse proportionality. Thus, the greater the designer's freedom in developing a 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 a design is restricted, the more likely it is that minor differences between the designs at issue will be sufficient to produce a different overall impression on an informed user. In other words, if the designer enjoys a high degree of freedom, that reinforces the conclusion that the designs which do not have significant differences produce the same overall impression on an informed user and, accordingly, the contested design does not display an individual character. Conversely, if the designer has a low degree of freedom, that reinforces the conclusion that the sufficiently marked differences between the designs produce a dissimilar overall impression on the informed user and, accordingly, the contested design displays an individual character (see judgment of 13 June 2019, *Door hanger for vehicles*, T-74/18, EU:T:2019:417, paragraph 76 and the case-law cited).

42 In the present case, the Board of Appeal held, in paragraph 22 of the contested decision, that that degree of freedom was very high, if not almost infinite. That assessment, which, moreover, is not disputed by the applicant, must be accepted.

The comparison of the overall impressions produced

43 The Board of Appeal held, in paragraphs 23 to 35 of the contested decision, that it followed from the comparison of the overall impressions that the contested design gave an impression of 'déjà vu'.

44 In the first place, the Board of Appeal found that the designs at issue represented lamps composed of the same three parts, each of which was represented, visually, in an almost identical way.

- 45 In the second place, the Board of Appeal found that the differences between the designs were not such as to prevent an impression of ‘déjà vu’. First, the differences between the base in the contested design, which is flat and smooth, and the base in the earlier design, which has double the surface area and has holes in it, do not have a decisive influence on the overall impressions produced by the designs at issue, given that those differences (i) concern a part which is often hidden during use, (ii) are due to technical requirements and (iii) cannot offset the strong similarities between the other two parts of the lamps. Secondly, the difference, claimed by the applicant, relating to proportion in the size relationship between the base, the arm and the lampshade may be perceived only if each of the three elements are carefully measured, which the informed user would not do. Moreover, that difference is not relevant, since the comparison of the overall impressions produced by the designs at issue must be carried out in a holistic manner.
- 46 In order to challenge that assessment by the Board of Appeal, in the first place, the applicant refers to the differences relating to the goods concerned by the designs at issue. In the second place, it submits that the grounds on which the Board of Appeal held that the differences between the designs at issue were irrelevant are incorrect. That is the case, according to the applicant, first, for the ground alleging that the base of the product concerned by the earlier design is often hidden, secondly, for the ground which highlights the technical requirements of the base of the product concerned by the earlier design and, thirdly, the grounds alleging both that the differences relating to the base cannot offset the strong similarities relating to the arm and lampshade, and that the differences in the proportions between the elements of the two lamps would not be perceived by the informed user.
- 47 EUIPO disputes all those arguments.
- 48 According to settled case-law, the individual character of a design results from an overall impression of difference or lack of ‘déjà vu’, from the point of view of an informed user, in relation to any previous presence in the design corpus, without taking account of any differences that are insufficiently marked to affect that overall impression, even though they may be more than insignificant details, but taking account of differences that are sufficiently marked to produce dissimilar overall impressions (see judgment of 16 February 2017, *Antrax It v EUIPO – Vasco Group (Thermosiphons for radiators)*, T-828/14 and T-829/14, EU:T:2017:87, paragraph 53 and the case-law cited).
- 49 For the purposes of examining the individual character of a design, a comparison should therefore be made between, on the one hand, the overall impression produced by the contested Community design and, on the other, the overall impression produced by each of the earlier designs legitimately relied on by the party seeking a declaration of invalidity (judgment of 22 June 2010, *Shenzhen Taiden v OHIM – Bosch Security Systems (Communications Equipment)*, T-153/08, EU:T:2010:248, paragraph 24).
- 50 Differences are not sufficient to create an overall impression of difference where they are not sufficiently marked to distinguish the designs at issue in the perception of the informed user or offset the similarities found between the designs (see, to that effect, judgment of 18 March 2010, *Representation of a circular promotional item*, T-9/07, EU:T:2010:96, paragraphs 77 to 84).
- 51 The Board of Appeal was right to find that the contested design gave an impression of ‘déjà vu’, and therefore did not have individual character within the meaning of Article 6 of Regulation No 6/2002.

- 52 A comparison of the designs at issue shows that they concern lamps which both have round lampshades and straight arms. In both lamps, the base is circular and much larger in size than the lampshade.
- 53 In view of such similarities, the differences concerning the base of those lamps – one of which is convex and has holes in it, while the other is flat and smooth – cannot be regarded as being sufficiently marked within the meaning of the case-law cited in paragraphs 48 and 50 above, as the Board of Appeal rightly pointed out in paragraph 30 of the contested decision. The same applies to the fact that the arm in the earlier design is proportionally slightly longer and thinner, and to the resulting difference in proportion between the elements of the lamps.
- 54 In that regard, it should also be noted that, in accordance with the case-law cited in paragraph 41 above, the designer's particularly high degree of freedom in developing the contested design limits the impact that minor differences between the designs at issue can have in the context of the comparison of the overall impressions they produce.
- 55 The Board of Appeal was therefore right to find that the contested design lacked individual character within the meaning of Article 6 of Regulation No 6/2002, and therefore declared it invalid pursuant to Article 25(1)(b) of that regulation, read in conjunction with Article 6 thereof.
- 56 That conclusion is not invalidated by the applicant's argument that an element of differentiation arises from the sector of the goods concerned by the designs at issue. For the reasons set out in paragraphs 32 and 33 above, it cannot be held that the contested design is intended only to be used for indoor lighting purposes. In any event, for the reasons set out in paragraphs 34 and 35 above, even if the goods at issue are not from the same sector, but rather adjacent sectors – namely the indoor lamps sector and the outdoor lamps sector – such a difference would not be capable of offsetting the important commonalities noted between the designs at issue in the context of the comparison of the overall impressions that they produce.
- 57 In addition, there is no need to examine the applicant's arguments that the Board of Appeal erred in relying, in paragraphs 28 and 29 of the contested decision, on the fact that the base of the earlier design is often hidden and that the differences between the bases of the designs at issue are explained by technical requirements in order to argue that those differences in the lamp bases are not relevant. The ground alleging that those differences are not sufficiently marked to offset the strong similarities between the other parts of the lamps concerned by the designs at issue, set out in paragraph 30 of the contested decision, is sufficient, in itself, to establish that the Board of Appeal's assessment is well founded.
- 58 The applicant's single plea in law must therefore be rejected and, consequently, the action must be dismissed.

Costs

- 59 Under Article 134(1) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the form of order sought by EUIPO.

On those grounds,

THE GENERAL COURT (Second Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders Davide Groppi Srl to pay the costs.**

Tomljenović

Škvařilová-Pelzl

Nõmm

Delivered in open court in Luxembourg on 16 June 2021.

[Signatures]