

INVALIDITY No ICD 127 458

Turlen Holding SA, Rue du Jura 11, 2345 Les Breuleux Switzerland (applicant), represented by **Ipside**, Tour Trinity 1 Bis, place de La Défense, 92400 Courbevoie, France (professional representative)

a g a i n s t

Lijun Wu and **Zherong Wang**, 7th Floor, Gongxin Derong Building, Shiyiheng Road, Hengjiangxia, Changping Town, Dongguan City, 523565 China (holders), represented by **Qiang Zhou**, 1 Rue Castillon 2eme Etage, 33000 Bordeaux, Francia (professional representative).

On 15/04/2025, the Invalidity Division takes the following

DECISION

1. The application for a declaration of invalidity is upheld.
2. Registered Community design No 015012178-0001 is declared invalid.
3. The holder bears the costs, fixed at EUR 750.

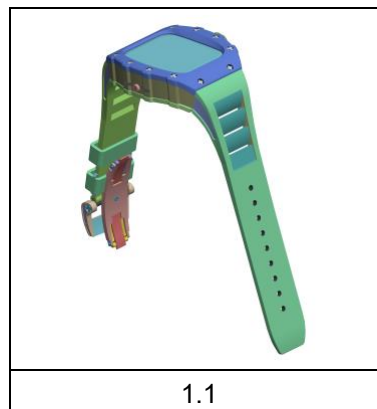
REASONS

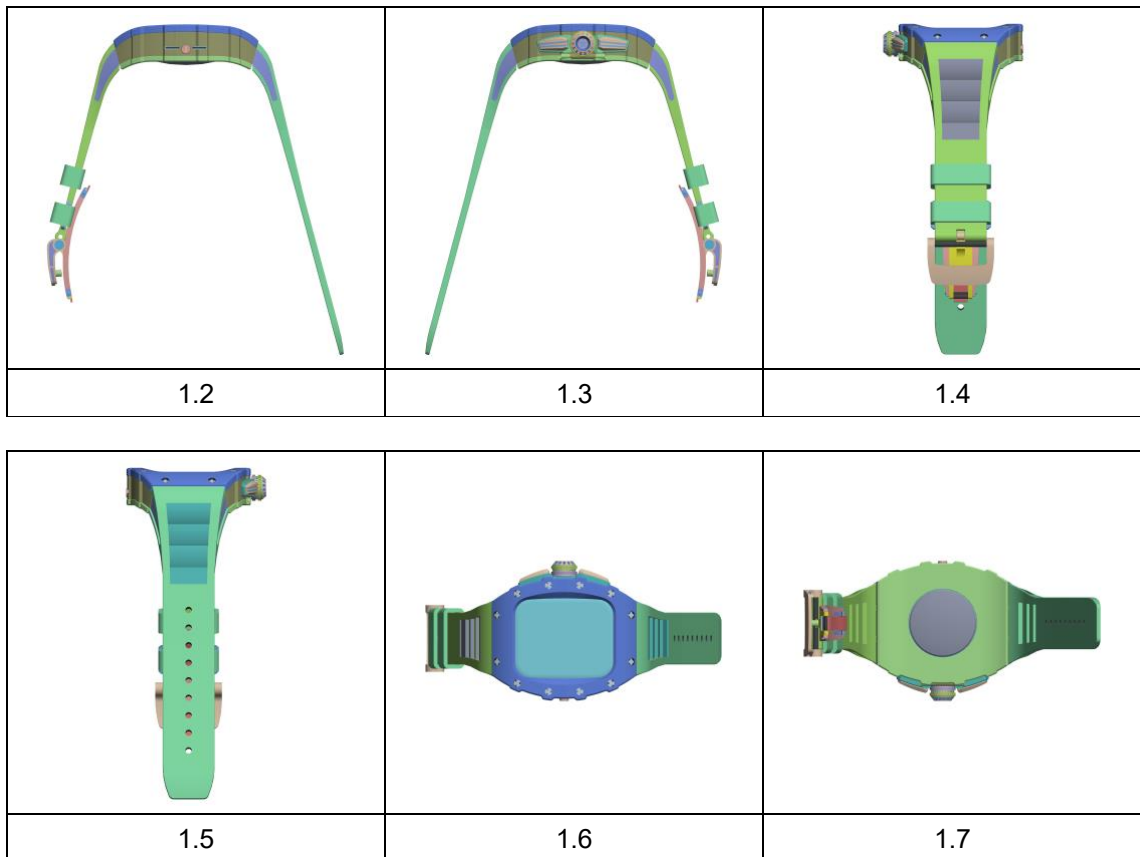
The applicant filed an application for a declaration of invalidity ('the application') against Community design No 015012178-0001 ('the contested design'). The contested design was filed and registered in the holders' names on 21/02/2023

The following products are indicated in the registration:

10-07 *Cases for watches.*

The registration contains the following views:





The applicant invoked Article 25(1)(b) CDR in conjunction with Articles 4(1) and Articles 5(1)(b) and 6(1)(b) CDR.

SUMMARY OF THE PARTIES' ARGUMENTS

The applicant argued, *inter alia*, the following:

- The contested design must be declared invalid since it lacks novelty and individual character in accordance with Article 25(1)(b) CDR;
- Indeed, the contested design presents identical features and, in any case, it produces the same overall impression as several earlier designs that have been disclosed to the public before the filing date of the contested design;
- The applicant company produces iconic Swiss made watches worn by famous personalities and sportsmen;
- The earlier international design D3, registered with No DM/083216 and corresponding to the model 'RM 35-01 Richard Mille' was also disclosed in the applicant's official website in 2014.
- The designs under comparison share the following similarities:
 1. A crenelated barrel-shape watch cases with chamfered edges.
 2. The bezels feature 12 star-shaped screws positioned symmetrically at the same place on the bezel: 4 on each right and left side of the bezel and 4 star-shaped screws, two at the top and bottom of the bezel.
 3. The watch cases are both composed of 4 merlons on each side of the watch case positioned at the same place at the level of each star-shaped screw giving it a unique geometric shape.

4. The watch cases feature a "sandwich" structure with grooves i.e. with an upper and lower part of similar width, wider than the middle part.
 5. The watch cases have a grooved crown (cylindrical knob) positioned between two merlons on the right of the watch case.
 6. The watch strap of both watches features 3 rectangular openings of the same rectangular form and positioned at the same place (i.e. at the top of the strap).
 7. The ribbed pushers are inspired by the world of Formula 1 racing and take their shape and grooves from some pedals of racing cars. They also have the same 'ring' at their base.
 8. The crown is reminiscent of the rims on racing cars. Seen from the front, it has the same star-shaped centre with holes in the outer part of the 'rim' or circle. Viewed from the side, it also appears to have the same number of 'layers' or "treads" in automotive language.
- The earlier design D3 differs from the contested design in that:
 1. The crown on the side (cylindrical knob) of the watch case in the contested design is positioned between two wing-shaped ribbed pushers (view 1.3) which are not present in the Earlier Design. However, these pushers are functional and allow with simply press to put on neutral position, rewind or set the time;
 2. On the other side of the watch case of contested design (view 1.2), there is a very tiny push-button which has certainly technical function which is not in the earlier design.
 3. On the rear view of contested design, there is no visible star-shaped screws on the sides on the watch case (see view 1.7) contrary to the visible star-shaped screws on the earlier design. Moreover, the contested design contains on the rear view a common circle watch battery which has only technical function, and which is not visible in the earlier design. However, these elements are placed in the rear view of the contested design and have less impact on the overall impression as they are not visible during the normal use of the product, which is to be worn on the handle.
 4. The watch case of the Contested Design features a visual effect with random, undulating shapes that emerge on the surface;
 5. The colour is also different. However, it is not to be considered a major difference with the earlier design as the informed user is used to see watch manufacturers offering for sale their watches in different colour ranges.
 - The above-mentioned differences are insufficient to differentiate the contested design from the earlier design in light of their common features, which contribute to the originality and 'DNA' of the earlier design making it immediately recognisable to the informed user;
 - The designer's degree of freedom in the case of watches is not limited by the technical functions of the product, nor by statutory requirements being very broad as to the shapes, proportions, materials, styles, colours and decorative elements. Consequently, the designer's degree of freedom in the sector concerned is not limited;
 - Considering all the above the contested design has to be declared invalid.

In support of its observations, the applicant submitted, inter alia, the following evidence:

1. Screenshots taken from the applicant's official website www.richardmille.com showing and advertising the watch model RM 35-01. The screenshot also shows

that the above-mentioned model was launched in 2014. The model is shown as follows:



Within its observations, the applicant also submitted the same images placed on a white background and shown as follows:



2. Screenshots taken from the website www.my-watchsite.fr showing the same watch model RM 35-01 offered for sale. The website also contains information that the model was offered for sale since 2014 and shows, inter alia, the following images of the watch:



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 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.

The evidence originating from the internet must contain all the information necessary to ascertain that the invoked design was disclosed to the public. In particular, it must contain the publication date (or other date when the design became available to the public), a

clearly identifiable illustration of the invoked prior design and the source from which the evidence comes. All those particulars must be contained in the same piece of evidence without the need to search the internet. (26/09/2023, R 531/2023 3, carrying bags (part of -), § 28 and the case-law cited).

In the present case, as evidence of disclosure the applicant submitted screenshots taken from the applicant website *www.richardmille.com* (Annex 6). The screenshots show the entire URL, several images of the watch model RM 35-01 and the date on which the design was offered for sale, 2014.

In addition, and to corroborate the above-mentioned evidence the applicant also submitted as Annex 8 screenshots taken from the website *www.my-watchsite.fr* showing the same model of watch 'RM 35-01' offered for sale since 2014.

Taking the above into account, it is concluded that the evidence supports the applicant's claim that the product was disclosed in 2014 which precedes the contested design's filing date, 21/02/2023. The holder did not comment on this. Therefore, the design is deemed to have been made available to the public on the given internet website. This is sufficient proof of disclosure 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 *cases for watches*. Therefore, the informed user, without being an expert or producer, is a person who is familiar with the cases for watches 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.

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 Invalidity Division concurs with the applicant that in the present case, and except for the presence of certain elements that are necessary for watches to fulfil their function, the designer of this kind of products enjoys a complete freedom in developing a model of cases for watches such as the one at issue (25/04/2013, T 80/10, Watches , EU:T:2013:214, § 125).

Therefore, it is considered that the designer's degree of freedom in the present case is at least average. Given that the designer's degree of freedom within the meaning of Article 6(2) CDR is not severely limited, in accordance with the case-law cited, only small differences between the compared designs will not suffice to confer individual character on the contested design.

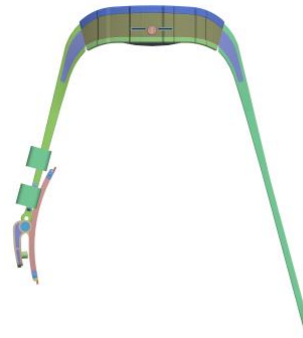
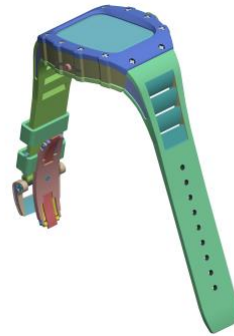
The overall impression

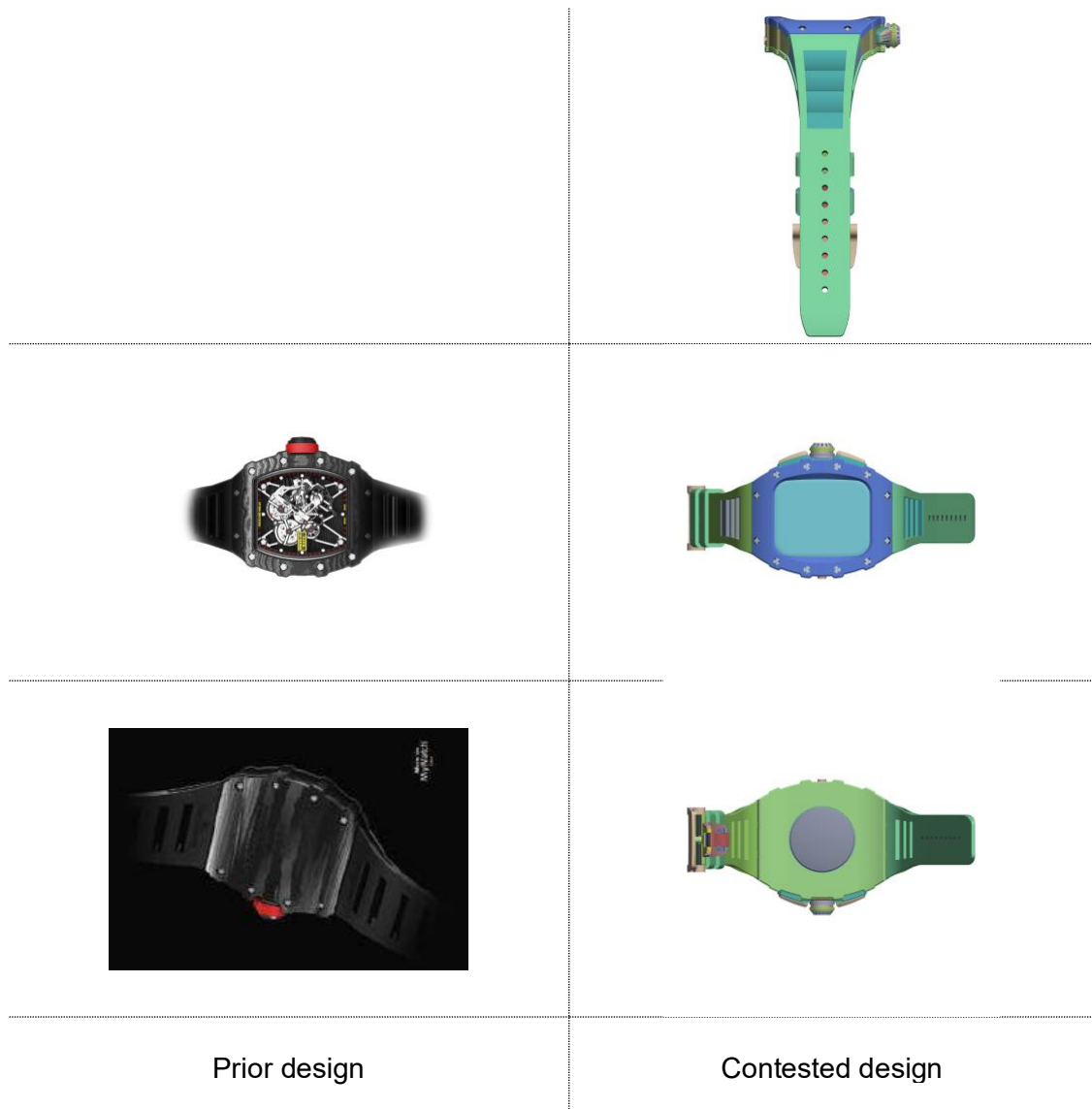
The comparison of the overall impressions conveyed by the designs must be synthetic and cannot be limited to a purely analytical comparison of a list of similarities and differences (13/06/2017, T-9/15, Dosen [für Getränke], EU:T:2017:386, § 79). It must be an all-inclusive comparison, allowing the overall impression produced by the design at issue to be determined in a sufficiently precise manner (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 73).

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, considering that those differences are sufficiently noticeable as to produce a different overall impression, and discarding the differences that do not affect the overall impression (07/11/2013, T-666/11, Felino balzante, 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,

Ornamentación, EU:C:2012:641, § 54; 18/10/2012, C-102/11 P, Ornamentación, EU:C:2011:236, § 54).





The images in this document are not to scale.

Since the contested design is the point of reference, individual character in comparison with a prior design must be assessed solely on the basis of the features disclosed in the contested design (13/06/2017, T-9/15, Dosen [für Getränke], EU:T:2017:386, § 87). Therefore, in the present case the mechanism visible within the case of the earlier design will not be taken into account for the assessment in the present case.

Taking the above into account, the Invalidity Division agrees with the applicant that the designs under comparison correspond in the following features:

- Both watches feature crenelated, barrel-shaped cases with chamfered edges.
- Each bezel has 12 symmetrically positioned star-shaped screws: four on the left, four on the right, and four more - two at the top and two at the bottom.
- Both cases incorporate four merlons on each side, aligned with the screws, giving the case a distinctive geometric profile.

- The watch cases have a "sandwich" structure, characterized by upper and lower sections of equal width, both broader than the central mid-case.
- Each watch includes a grooved crown (cylindrical knob) located between two merlons on the right side of the case.
- The watch straps of both models display three rectangular cutouts at the top, very similar in shape and placement.
- The crowns share a perforated outer ring when viewed from the front. From the side, they exhibit the same layered or "treaded" structure.

The designs differ in the following:

- The presence of two wing-shaped ribbed pushers which are visible in the contested design and that are not present in the earlier design.
- On the other side of the watch case of contested design, there is push-button which has no counterpart in the earlier design.
- The absence in the contested design of the star-shaped screws, placed on the back side of the watch case of the earlier design.
- The presence of a circle placed at the centre of the back case that is not present in the earlier design.
- The contested design also reveals the final part of the strap, which is not visible in the earlier design.

Furthermore, the designs vary in their respective colours being black the earlier design and blue with a green strap the contested design. Although the difference in colour constitutes an easily spotted difference, compared with the black of the earlier design, it is nevertheless not capable of making a different overall impression on the informed user either on its own or in combination with the other differences described above (29/11/2018, T-651/17, Spray guns for paint, EU:T:2018:855, § 47)

Moreover, as to the differences in the case back it has to be noted, as correctly argued by the applicant, that this part is not visible during the normal use and, therefore, these differences will have less impact in the informed user's perception.

In the overall impression conveyed by the designs compared, the differences described above are nevertheless less striking than their evident common features which are quite original and give the watch case a shape and appearance that is different from traditional watch-cases. This impression is reinforced by the fact that the features that the designs have in common are arbitrary, and not limited by technical or statutory constraints.

Therefore, and although the informed user would be able to perceive the differences described above, this does not change the similar overall impression conveyed by the features that are common to both designs.

In light of the foregoing, it is concluded, from the standpoint of the informed user, and taking into account the designer's freedom in the contested design and the other circumstances of the case as set out above, that the overall impression conveyed by the contested design does not differ from that conveyed by the prior design. As a result, the contested design lacks individual character within the meaning of Article 6(1)(b) CDR.

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 this ground and on the basis of this design, 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 the other earlier 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

Chiara BORACE

Enrico D'ERRICO

Carlos MATEO PEREZ

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).