



**OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)**

DESIGNS DEPARTMENT- INVALIDITY DIVISION

**DECISION OF
THE INVALIDITY DIVISION
OF 20/07/2012**

**IN THE PROCEEDINGS FOR A DECLARATION OF INVALIDITY
OF A REGISTERED COMMUNITY DESIGN**

FILE NUMBER ICD 000008443
COMMUNITY DESIGN 000235247-0003
LANGUAGE OF PROCEEDINGS English

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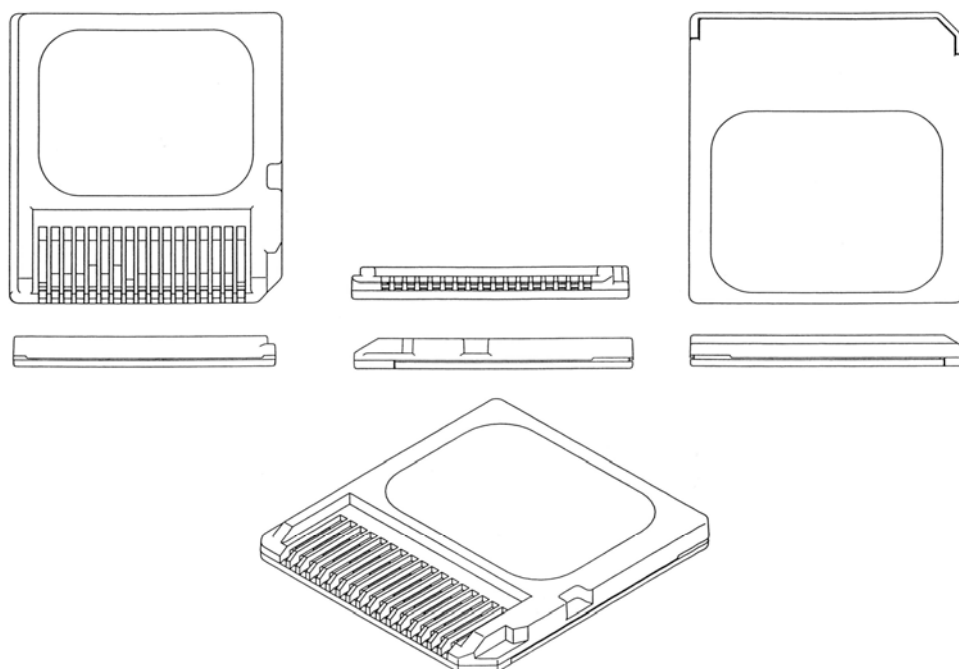
The Invalidity Division,

composed of Ludmila Čelišová (rapporteur), Jakub Pinkowski (member) and Martin Schlötelburg (member) took the following decision on 20/07/2012:

- 1. The registered Community design No. 000235247-0003 is declared invalid.**
- 2. The Holder shall bear the costs of the Applicants.**

I. FACTS, EVIDENCE AND ARGUMENTS

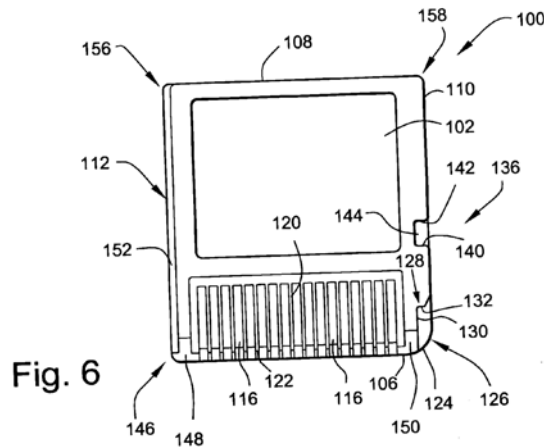
- (1) The Community design no. 000235247-0003 (hereinafter “the RCD”) has been registered in the name of the Holder with the date of filing of 06/10/2004 and the date of priority of 07/04/2004. In the RCD, the indication of products reads “game cartridges for electronic games or electronic games stations” and the design is represented in the Community Designs Bulletin, which contains the following views:
http://oami.europa.eu/bulletin/rcd/2005/2005_002/000235247_0003.htm



- (2) On 28/04/2011, the Applicants filed an application for a declaration of invalidity (hereinafter “the Application”). The fee for the Application was paid via bank transfer.
- (3) Using the Office form the Applicants request a declaration of invalidity of the RCD on the grounds that the RCD does not fulfill the requirements of Articles 4 to 9 of the Council Regulation (EC) no. 6/2002 on Community Designs (hereinafter “CDR”). In the

reasoned statement, the Applicants pointed explicitly to Articles 8(1) and 8(2) CDR.

- (4) In the reasoned statement, the Applicants claim that the contested RCD is incorporated in a game cartridge, which has to be inserted in a cartridge slot of a game device and thus it has to copy the shape of the slot to perform its function. The Applicants state that “features of appearance of the game cartridge of the RCD are clearly imposed by the specific configuration of a Nintendo DS [hereinafter also “NDS”] game device and, consequently, that it is absolutely necessary to reproduce the RCD in its exact shape and size in order for this to perform its function”.
- (5) According to the Applicants the rectangular cartridge body has a longitudinal protrusion at one side so that the cartridge is fitted in the slot of the game device in a particular position. Small notches at the side of the cartridge body and a notched corner are intended to prevent the cartridge from being inserted into the cartridge slot upside down and to embrace the cartridge eject mechanism when the cartridge is inserted. The recessed part secures exact match of electrical contacts with the corresponding portion of the socket body of the game device. The rectangular recessed middle part of cartridge is used for attaching a label. The Applicants claim that all the features of the contested RCD are determined by technical considerations and selected solely with the aim to achieve the technical function of the product. “The designer developing the contested RCD was only motivated to create a cartridge which would fit the slot of the game device without any aesthetic concerns.” “The contested RCD consists of the graphic representation of a few very simple technical solutions. Keeping registration of the contested RCD would imply the granting of a monopoly over those technical solutions.” In the view of the Applicants the RCD is thus excluded from the protection by virtue of Article 8(1) CDR.
- (6) In support of their claim the Applicants submit a report titled “Assessment on the Validity of the Registered Community Design 000235247 (0001 – 0006) drafted by Sergi Servian, a patent attorney specialized in mechanical engineering, concluding that the appearance features of the cartridge, in which the contested RCD is incorporated, i.e. shape, size and configuration, must exactly correspond to that of the slot of the game device so that both may perform the function, i.e. to play the games. In support of these arguments the Applicants further submit a report drafted by Dr. Julián Seseña specialized in telecommunication engineering. The applicants also submit three United States patent applications concerning Nintendo game device technical solutions. The United States Patent Application No. US 2005/0245313 for “game console and memory card” of the Holder published on 03/011/2005 inter alia concerns about a game console slot for the memory card and a memory card of the following appearance:



- (7) In response to the arguments concerning Article 8(1) the Holder submits a witness statement of Kenichi Sugino, the head of the team of designers who developed Nintendo device and the cartridge designs. According to the Holder the statement proves that the slot and cartridge were designed together and thus the design of cartridge is not dependant on the design of the slot of game device. The Holder claims that at the time of development of the RCD the aesthetic features of the cartridge were taken into account and that some of the elements present in the cartridge, especially the size of recesses, the notched corner and tapered end, have no technical function and they were designed solely for an aesthetically pleasing effect.
- (8) The Holder further argues that the law in the matter of consideration of technical features of designs is not settled yet and in respect of Article 8(1) a “test of multiplicity of forms”, i.e. a design is protectable where is a freedom left to the designer’s creativity and a choice among various forms in order to achieve the same technical effect, is more relevant than the examination whether there were any aesthetic considerations in the designer’s mind.
- (9) For further details to the facts, evidence and arguments submitted by the parties, reference is made to the documents on file.

II. Grounds of the Decision

A. Admissibility

- (10) The indication of the grounds for invalidity in the Application is a statement of the grounds on which the Application is based within the meaning of Article 28(1)(b)(i) CDIR¹. Furthermore, the Application complies with Article 28(1)(b)(vi) CDIR, since the Application contains an indication of the facts, evidence and arguments submitted in support

¹ Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community designs

of those grounds. The other requirements of Art. 28(1) CDR are fulfilled as well. The Application is therefore admissible.

B. Substantiation

B.1 Technical Function

- (11) According to Article 8(1) CDR a Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function.
- (12) In compliance with the Manual of the Office concerning the examination of design invalidity applications (in force as of 01/07/2012) the Article 8(1) CDR must be interpreted the way that “CDR denies protection to those features of a product’s appearance that were chosen exclusively for the purpose of designing a product that performs its function, as opposed to features that were chosen, at least to some degree, for the purpose of enhancing the product’s visual appearance.’ (decision of 22/10/2009, R 690/2007-3, ‘Chaff cutters’, para. 30 et seq.)”.
- (13) Further in compliance with the Manual “the design as a whole will be invalid only if all the essential features of the appearance of the product in question are solely dictated by its technical function (decision of 29/04/2010, R 211/2008-3, ‘Fluid distribution equipment’, para. 36)”. “In order to determine whether all essential features of the appearance of the product into which the contested RCD will be incorporated are solely dictated by the technical function of the product, it is first necessary to determine what the technical function of that product is. The relevant indication in the application for registration of that design (Article 36(2) CDR) should be taken into account and also, where necessary, the design itself, in so far as it makes clear the nature of the product, its intended purpose or its function (see, by analogy, judgement of 18/03/2010, T/9/07, ‘Representation of a circular promotional item’, para. 56).”
- (14) The RCD subsists in the shape of the cartridge, which is slim, rectangular and it has a notched down right hand side corner. There is no dispute between the parties and no contradiction in the evidence provided by them about the following: the notch and a longitudinal slot prevent the cartridge to be placed upside-down or incorrect way in the device slot; there are two recesses at the right side of the card to fit the ejection mechanism placed in the device slot; the recessed part with connectors must exactly match the socket counterpart in the device so that the data stored in cartridge were transmitted correctly into the device; the flat cartridge body, which protects internal parts of the cartridge, is gently recessed to indicate placement of a rectangular-shaped label. When entered in the slot, the cartridge does not protrude and its edge forms one line with the back side of the game device.

- (15) The indication of products of the RCD reads “game cartridges for electronic games or electronic games stations”.
- (16) The purpose of a game cartridge is to store and transfer data into a device to which the cartridge is connected so that a game can be played on the device. However, it is not a product which would be used purely for the purpose of storing data the most efficient way without any other concerns. Game cards or cartridges are accessories to the game device. The users buy them for their contents – games or software applications stored on them. Cartridges have separate market from the device, they are purchased and collected and thus they are displayed and advertised accordingly. As items targeted to a customer, the designer must consider the appearance of the products.
- (17) However, the visual attractiveness of cartridges is mainly enhanced by their labelling. Labels do not form part of the contested RCD. What matters in the present case is the shape of the cartridge. Thus the question is if purely the shape of the cartridge as claimed in the contested RCD incorporates elements enhancing the appearance of the product.
- (18) The Manual requires “where Article 8(1) CDR applies, must be assessed objectively and not with regards to the perception of the informed user, who may have limited knowledge of technical matters.” Accordingly the Board of Appeal holds in decision of 29/04/2010, R 211/2008-3, ‘Fluid distribution equipment’, para. 35 “These matters must be assessed objectively: it is not necessary to determine what actually went on in the designer’s mind when the design was being developed. The matter must be assessed from the standpoint of a reasonable observer who looks at the design and asks himself whether anything other than purely functional considerations could have been relevant when a specific feature was chosen.” According to the Manual “the technical functionality of the features of a design may be assessed, inter alia, by taking into account of the documents relating to patents describing the functional elements of the shape concerned.”
- (19) Submitting United States patent applications the Applicants claim that the RCD concerns a technical solution of the device cartridge tailored to the NDS, as shown and described in the patent application cited in the paragraph 6 of this decision. The description of the invention reads [The numbers in brackets indicate the corresponding paragraph in the patent document]: “[0008] A substantially square game or memory card designed especially for use with the game device disclosed herein...” “The terminal strips are parallel to each other and are separated by raised ribs that extend from the rear wall of the recess to the forward edge. These ribs protect the terminal strips from contact with the user’s hand or other objects.” [0009] An enlarged radius is provided at one forward corner of the card, where the forward edge of the card meets one side edge of the card. A first notch is also formed at this same corner, and a second notch is formed along this same side edge,

intermediate the forward and rearward ends of the card. These two notches interact with a spring-loaded 'push-push' mechanism inside the game slot for controlled insertion and ejection of the game card into and from the game console. [0010] The opposite forward corner of the card is defined by a smaller radius merging into the other side edge that is defined by a stepped shoulder in the upper plane of the card, extending along the entire length of the card. This shoulder insures correct orientation of the card when inserted into the game card slot.”

- (20) The above described features form part of the claim in the concerned patent application. The features secure technical effects of faultless performance both the device and the data card. The features were designed to enhance technical function of the memory card in the game device. The concerns during their development were technical but not visual. The features described above were not, in the view of the Office, chosen with the aim to enhance the visual features of the cartridge.
- (21) In what the cartridge might have been designed to the pleasant effect of the eyes, is the part of the cartridge body, and the part for placement of labels.
- (22) The cartridge body is flat, and substantially square with one notched corner. The rectangular or substantially square shape with one notched corner is the most frequent shape among game cartridges or data cards. The recessed area for placement a label on the front and back sides of the card body usually copies the outer lines of the cartridge and the recessed part of the cartridge with connectors. The contested RCD does the same. These features capture best the functionality of the corresponding parts of the cartridge and thus they form the design corpus known from the state of art. No enhanced visual effect incorporated in the contested RCD was recognized. The Office is of the opinion that the functionality of the cartridge was the only relevant factor when the shape of the cartridge was designed and all the essential elements incorporated in the shape of the cartridge as protected by virtue of RCD, viewed from the standpoint of an observer with knowledge of the field of products in concern, were chosen for the technical reasons.
- (23) In the view of the arguments given above, and the evidence presented by both parties, in the RCD no essential features enhancing the appearance of the cartridge on the contrary to its elements chosen solely for technical reasons were identified. Hence the RCD cannot enjoy the protection conferred by the registration of a Community design.

C. Conclusion

- (24) The RCD subsist in features of shape and dimensions of a cartridge which are solely dictated by its technical function. Therefore, the RCD is to be declared invalid according to Article 25(1)(b) CDR in conjunction with Article 8(1) CDR.

III. Costs

- (25) Pursuant to Article 70(1) CDR and Article 79(1) CDIR, the Holder bears the fees and costs of the Applicants.
- (26) The costs to be reimbursed by the Holder to the Applicants are fixed to the amount of 750 Euro, composed of 400 Euro for the costs of representation and 350 Euro for the reimbursement of the invalidity fee.

IV. Right to Appeal

- (27) An appeal shall lie from the present decision. Notice of appeal must be filed at the Office within two months after the date of notification of this decision. The notice is deemed to have been filed only when the fee for appeal has been paid. Within four months after the date of notification of the decision, a written statement setting out the grounds of appeal must be filed (Art. 57 CDR).

THE INVALIDITY DIVISION

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