Beverage can design held to be devoid of individual character

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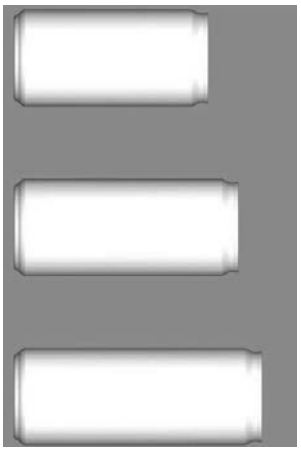
European Union - Dr. Helen G. Papaconstantinou and Partners Law Firm
In Ball Beverage Packaging Europe, Ltd v EU Intellectual Property Office (EUIPO) (Case T-9/15, June 13 2017), the General Court upheld a decision of the Third Board of Appeal which had declared a design by Ball to be invalid on the grounds that it was devoid of individual character.

Ball Europe (replaced during the proceedings by Ball Beverage Packaging Europe Ltd) obtained registration of Design 2309900006 on September 24 2004 with respect to the beverage cans shown below, claiming priority of two German designs of March 27 2004 and April 27 2004.



Although the application was made in German, the applicant also supplied a description in English, defining the design as a group of cans in three different volumes.

Crown Hellas Can SA brought an invalidity action against Ball's design on February 14 2011, based on its three cans shown below, which had been disclosed to the public before the priority date of the contested design. Crown claimed that the latter was identical to its own cans and, consequently, it was not new and lacked individual character.

On June 8 2012, the EUIPO Cancellation Division rejected the application for a declaration of invalidity and held that the contested design was new and had individual character.

Crown successfully appealed this decision before the Third Board of Appeal, which did not rule on the matter of novelty but found that the contested design was devoid of individual character. The board refused to take into consideration the English description since the language of the application was in German. It concluded that the contested design represented one single can in three different sizes and not a group of cans. It further found that the differences between the designs were not significant enough to affect the overall impression they gave to the informed user – in this case bottlers in the drinks industry.

The General Court dismissed Ball's action against the board of appeal decision. In response to Ball's allegation that the contested design represented a group of three cans of different sizes – implying that this differentiated it from the earlier designs, which were representations of a single can – the court replied that the board of appeal had correctly and lawfully regarded the contested design as a unitary object. According to the ruling, only a unitary object can form the subject matter of a design. Such a product may consist of a group of articles only if they are linked aesthetically and functionally and are usually put on the market as a unitary product. This is the case, for example, with table cutlery which has a common function. This was not the case with the contested design – the three representations of which were not found to have a common function.

Ball's complaint that the board of appeal failed to take into account the English description which led it to the erroneous conclusion that the contested design was an individual can and not a group of cans, allowed the court to clarify the purpose of the description. It explained that the description can relate only to the features which appear in the reproductions of the design and must not contain statements concerning the novelty or individual character, or its technical value. Therefore, the description cannot play any part in defining the subject matter of protection of the design, which is related to the assessment of novelty and individual

character.

The court examined how the board of appeal had assessed the individual character of the contested design and confirmed that the comparison was correctly made between the overall impression of the designs in conflict and not between their isolated characteristics. The court held that the board of appeal had not erred in finding that the differences between the designs were insignificant. Therefore, even if it had considered that the informed user (ie, the bottler) would notice some differences between the proportions of the cans, this would have had no effect on the overall impression, given that bottlers are aware of the normal capacity of the cans and would pay no attention to them as far as the overall impression was concerned. The court confirmed that the board of appeal had correctly concluded that the contested design lacked individual character.

Finally, the court referred to an article presented by the applicant during the proceedings, which described the creation of a "sleek" can and emphasised the differences from "standard" and "slim" cans. The court ruled that the "sleek" characteristic would not affect the findings of the board of appeal as it served a marketing purpose and would not substantially affect the overall impression of the informed user.

In the light of the above, the court dismissed the action.

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