Reports of Cases

JUDGMENT OF THE GENERAL COURT (Second Chamber)

13 November 2012*

(Community design — Invalidity proceedings — Registered Community designs representing thermosiphons for radiators for heating — Earlier design — Ground for invalidity — Lack of individual character — Lack of a different overall impression — Articles 6 and 25(1)(b) of Regulation (EC) No 6/2002 — Saturation of the state of the art — Obligation to state the reasons on which a decision is based)

In Joined Cases T-83/11 and T-84/11,

Antrax It Srl, established in Resana (Italy), represented by L. Gazzola, lawyer,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented initially by G. Mannucci and A. Folliard-Monguiral, and subsequently by A. Folliard-Monguiral and F. Mattina, acting as Agents,

defendant,

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

The Heating Company (THC), established in Dilsen (Belgium), represented by J. Haber, lawyer,

ACTIONS brought against the decisions of the Third Board of Appeal of OHIM of 2 November 2010 (Cases R 1451/2009-3 and R 1452/2009-3), relating to invalidity proceedings between The Heating Company (THC) and Antrax It Srl,

THE GENERAL COURT (Second Chamber),

composed of N.J. Forwood, President, F. Dehousse (Rapporteur) and J. Schwarcz, Judges,

Registrar: C. Heeren, Administrator,

having regard to the applications lodged at the Registry of the Court on 11 February 2011,

having regard to the responses of OHIM lodged at the Registry of the Court on 24 May 2011,

having regard to the responses of the intervener lodged at the Registry of the Court on 18 May and 27 June 2011,

* Language of the case: Italian.

having regard to the replies lodged at the Registry of the Court on 22 August and 19 September 2011,

having regard to the observations of the parties of 25 and 29 May 2012, in response to the Court's question of 11 May 2012,

further to the hearing on 27 June 2012,

gives the following

Judgment

Background to the dispute

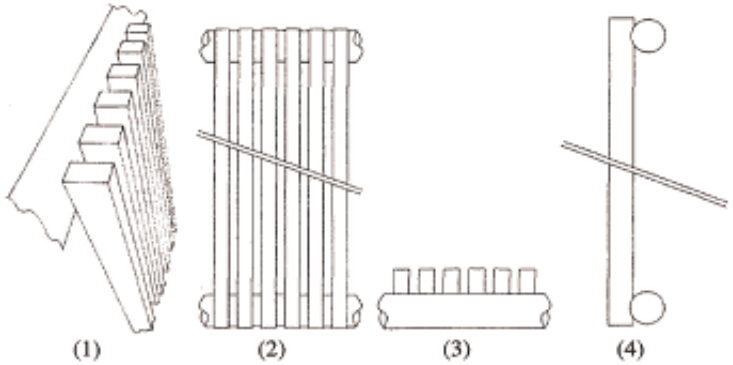
1 The applicant, Antrax It Srl, is the holder of eight Community designs, No 000593959-0001 to No 000593959-0008, which were filed on 25 September 2006 at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) and published in the *Community Designs Bulletin* on 21 November 2006 and 20 April 2009.

2 According to the actual wording of the applications for registration of a design filed by the applicant with OHIM, all those designs represent designs for thermosiphons ('modelli di termosifoni') which are intended to be applied to 'radiators for heating' in Class 23.03 of the LocarNo Agreement Establishing an International Classification for Industrial Designs of 8 October 1968, as amended.

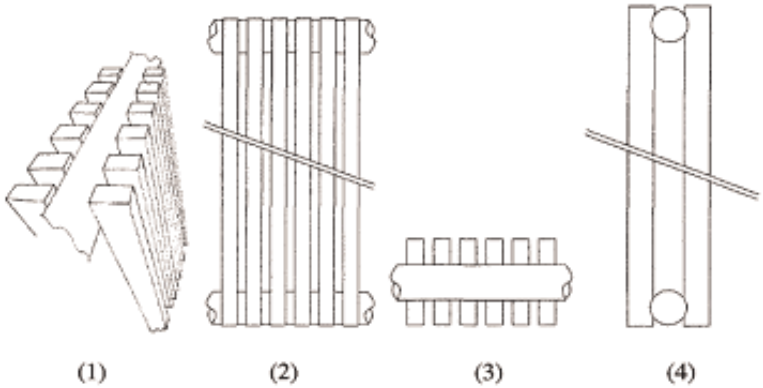
3 Of those designs, only designs No 000593959-0001 and No 000593959-0002 ('the contested designs') are the subject-matter of the present cases.

4 The contested designs are represented as follows:

— design No 000593959-0002:



— design No 000593959-0001:

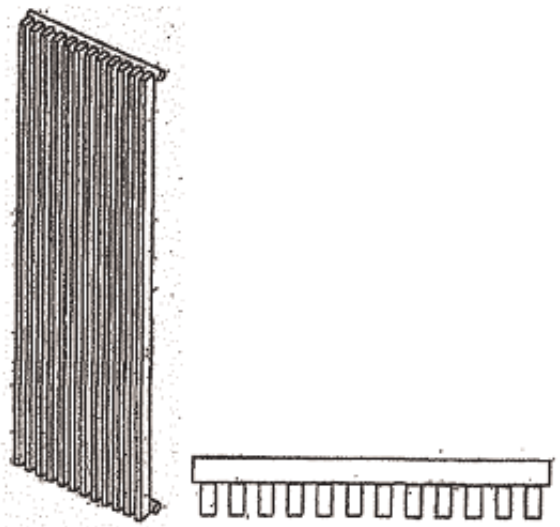


5 On 16 April 2008, the intervener, The Heating Company (THC), filed with OHIM applications for a declaration of invalidity in respect of the contested designs, which were registered under the reference numbers ICD000005312 and ICD000005320. Those applications for a declaration of invalidity were based on Article 25(1)(b) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1), a provision which refers to the requirements of Articles 4 to 9 of that regulation.

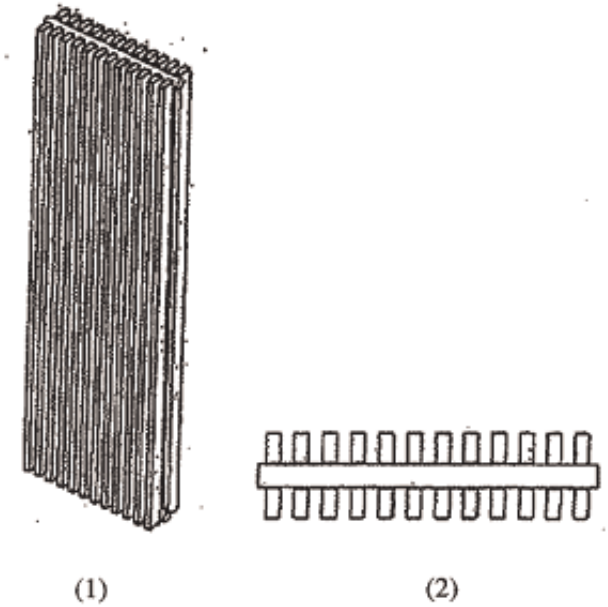
6 In support of its applications for a declaration of invalidity, the intervener invoked, against the contested designs bearing the numbers 000593959-0002 and 000593959-0001 respectively, the German designs bearing the numbers 4 and 5 respectively ('the earlier designs') included in multiple registration No 40110481.8, which was published on 10 September 2002 and extended to France, Italy and the Benelux countries as an international design bearing the reference No DM/060899.

7 The earlier designs are represented as follows:

— design No 4:



— design No 5:



8 By decisions of 30 September 2009, the Cancellation Division declared the contested designs invalid on the ground of lack of novelty within the meaning of Article 5 of Regulation No 6/2002.

9 Those decisions were the subject-matter of appeals filed by the applicant on 27 November 2009.

10 By decisions of 2 November 2010 ('the contested decisions'), the Third Board of Appeal of OHIM annulled the decisions of the Cancellation Division, in view of a failure to provide an adequate statement of reasons in respect of the ground for invalidity relating to the lack of novelty, and declared the contested designs invalid on the ground of lack of individual character.

11 In particular, the Board of Appeal, after finding that the decisions of the Cancellation Division challenged before it were not supported by an adequate statement of reasons in respect of the ground for invalidity relating to the lack of novelty (Article 5 of Regulation No 6/2002) and had, for that reason, to be annulled, carried out a fresh examination of that ground for invalidity and rejected it, on the basis that the differences between the contested designs and the earlier designs (taken together, 'the designs at issue') were not 'external' to the projects, as a product code or a quality mark would be, but concerned those projects and could not, from that point of view, be subsumed within the concept of 'immaterial details' within the meaning of Article 5(2) of Regulation No 6/2002.

12 The Board of Appeal then went on to examine the ground for invalidity relating to the lack of individual character (Articles 25(1)(b) and 6 of Regulation No 6/2002).

13 In that connection, the Board of Appeal defined the informed user, within the meaning of Article 6(1) of Regulation No 6/2002, as someone who purchases radiators for heating in order to install them in his home and who has been able to view and compare radiator designs by consulting design or development magazines, going to specialist shops and surfing the internet (paragraph 39 of the contested decisions).

14 Next, the Board of Appeal stated that 'the [designs at issue] represent[ed] radiators consisting of two horizontal collectors with circular cross-sections, joined at the front [in respect of designs No 000593959-0002 and No 4 — and at the front and back in respect of designs No 000593959-0001 and No 5] by a series of vertical elements (radiant tubes), rectangular in cross-section, with a slight space between them' (paragraph 40 of the contested decisions).

15 The Board of Appeal then made the following assessments:

'41. The [designs at issue] employ components which have the same shape. The vertical tubes are rectangular, the collectors are cylindrical. The lateral projection of the collectors is also identical.

42. The general appearance of the two radiators must be regarded as similar, or as not being such as to produce a significantly different overall impression on the informed user, whether the radiator is viewed from the front, from the side or from intermediate angles, as most often happens during normal use.'

16 The Board of Appeal subsequently found that the differences between the designs at issue pointed out by the applicant regarding, first, the relationship between the frontal dimension (the 'width') and the lateral dimension (the 'depth') of the tubes, secondly, the relationship between the width of the tubes and the space between two tubes and, thirdly, the relationship between the diameter of the collector and the depth of the tubes could not be denied, but were not sufficient, even when all were viewed at the same time, to alter, in the eyes of the informed user, the overall impression produced by the designs at issue (paragraphs 43 to 47 of the contested decisions).

17 The Board of Appeal rejected the argument that it was necessary to take into account a restricted degree of freedom on the part of the designer in the present case, pointing out that, in respect of radiator tubes in particular, a variety of cross-sections could be imagined (paragraph 48 of the contested decisions).

18 The Board of Appeal concluded that the contested designs therefore had to be declared invalid as they lacked individual character.

Forms of order sought

19 The applicant claims that the Court should:

— annul the contested decisions in so far as they declared the contested designs invalid on the ground that they lack individual character and, consequently, declare those designs valid;

— annul the contested decisions in so far as they ordered the applicant to pay the costs incurred by the intervener in the course of the proceedings before OHIM;

— order OHIM and the intervener to repay to it all the costs incurred in the course of the present proceedings and any other sum legally payable;

— order the intervener to repay to it all the costs incurred in the course of the proceedings before OHIM and any other sum legally payable.

20 OHIM contends that the Court should:

— dismiss the actions;

— order the applicant to pay the costs.

21 The intervener contends that the Court should:

— dismiss the actions;

— order the applicant to pay the costs of the present proceedings;

— order the applicant to pay the costs incurred before OHIM.

22 By letters of 13 April and 27 May 2011, OHIM, in accordance with Article 133(3) of the Rules of Procedure of the General Court, forwarded to the Court the files relating to the proceedings before the Third Board of Appeal, including the files relating to the proceedings before the Cancellation Division.

23 By decision of 29 February 2012, the President of the Second Chamber of the Court, after hearing the parties, ordered, pursuant to Article 50(1) of the Rules of Procedure, that the present cases be joined for the purposes of the oral procedure and of the final judgment.

Law

24 The applicant relies on a single plea in law alleging, in essence, infringement of Article 6 of Regulation No 6/2002.

Admissibility of the documents submitted for the first time before the Court

25 OHIM disputes the admissibility before the Court of the documents produced in Annexes A.3 and A.4 to the applications, inasmuch as those documents were not submitted at any stage of the proceedings before OHIM.

26 In reply, the applicant submits that those documents are not new items of evidence which alter the framework of the dispute, but only three-dimensional representations of the designs at issue, which were produced for the sole purpose of making it easier to visualise the fundamental differences which characterise those designs and give rise, on the part of the informed user, to a different general impression. It is one thing to adduce in proceedings before the Court evidence which introduces new facts or which serves as a basis for new and different arguments to those developed before the Board of Appeal. It is another to annex documents which tend to confirm the arguments already set out and to show that the argument which OHIM endorsed in the contested decisions is both erroneous and without foundation.

27 It must be pointed out that, irrespective of what the applicant submits, the documents produced in Annexes A.3 and A.4 to the applications do indeed constitute new items of evidence which were not available to the Board of Appeal.

28 Those documents, produced for the first time before the Court, cannot be taken into consideration. The purpose of actions brought 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, with the result that it is not the Court's function to review the facts in the light of documents which have been produced for the first time before it. Accordingly, the abovementioned documents must be excluded, without it being necessary to assess their probative value (Case T-9/07 *Grupo Promer Mon Graphic* v *OHIM - PepsiCo (Representation of a circular promotional item)* [2010] ECR II-981, paragraph 24; see also, by analogy, Case C-29/05 P *OHIM* v *Kaul* [2007] ECR I-2213, paragraph 54, and judgment of 23 May 2007 in Case T-342/05 *Henkel* v *OHIM — SERCA (COR)*, not published in the ECR, paragraph 31).

29 The same conclusion must be reached, as OHIM and the intervener submitted at the hearing, with regard to the documents annexed to the applicant's observations of 29 May 2012 and produced, for the first time, in support of its argument that there was a saturation of the state of the art.

The single plea, alleging infringement of Article 6 of Regulation No 6/2002

30 In this plea, the applicant submits that the Board of Appeal erred in its assessment of the individual character of the contested designs. The differences between the designs at issue are, it submits, such that the overall impressions produced on the informed user are different and the contested designs do not therefore lack individual character.

31 OHIM and the intervener take issue with the applicant's arguments.

32 Under Article 4(1) of Regulation No 6/2002, a design is to be protected by a Community design to the extent that it is new and has individual character.

33 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 which 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 on which the application for registration was filed or, if a priority is claimed, the date of priority.

34 Article 6(2) of Regulation No 6/2002 states that, in assessing individual character, the degree of freedom of the designer in developing the design is to be taken into consideration.

35 Article 63 of Regulation No 6/2002 provides that, '[i]n proceedings before it [OHIM] shall examine the facts of its own motion[; h]owever, in proceedings relating to a declaration of invalidity, [OHIM] shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought …'.

36 First, as regards the definition of the informed user, it must be borne in mind that, according to the case-law, the term 'informed user', within the meaning of Article 6 of Regulation No 6/2002, does not refer to either a manufacturer or a seller of the product in which the design concerned is intended to be incorporated or to which it is intended to be applied. The informed user is a person who 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 design concerned (*Representation of a circular promotional item*, paragraph 28 above, paragraph 62).

37 Furthermore, the status of 'user' implies that the person concerned uses the product in which the design is incorporated in accordance with the purpose for which that product is intended (Case T-153/08 *Shenzhen Taiden* v *OHIM - Bosch Security Systems (Communications Equipment)* [2010] ECR II-2517, paragraph 46).

38 The qualifier 'informed' suggests, in addition, 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 interest in the products concerned, shows a relatively high degree of attention when he uses them (*Communications Equipment*, paragraph 37 above, paragraph 47).

39 However, that factor does not imply that the informed user is able to distinguish, beyond the experience which he has gained by using the product concerned, the aspects of the appearance of the product which are dictated by the product's technical function from those which are arbitrary (*Communications Equipment*, paragraph 37 above, paragraph 48).

40 In paragraph 53 of its judgment in Case C-281/10 P *PepsiCo* v *Grupo Promer Mon Graphic* [2011] ECR I-10153, the Court of Justice stated that the concept of the informed user was to 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 personal experience or his extensive knowledge of the sector in question.

41 In the present case, the Board of Appeal defined the informed user as being someone who purchases radiators for heating in order to install them in his home. The Board of Appeal added that he had to be 'informed', in the sense that he had to have been able to view and compare radiator designs by consulting design or development magazines, going to specialist shops and surfing the internet. In other words, according to the Board of Appeal, that person, without being an expert in industrial design (as an architect or an interior decorator would be), is aware of what the market offers, fashion trends and the basic features of the product (paragraph 39 of the contested decisions).

42 It must be pointed out that that definition, with which, moreover, the applicant concurs, is correct.

43 Secondly, as regards the assessment of the individual character of a design, Article 6(2) of Regulation No 6/2002 provides that the degree of freedom of the designer in developing the design must be taken into consideration in that assessment.

44 The designer's degree of freedom in developing a 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 to which the design is applied. Those constraints result in a standardisation of certain features, which will thus be common to the designs applied to the product concerned (*Representation of a circular promotional item*, paragraph 28 above, paragraph 67, and judgment of 9 September 2011 in Case T-11/08 *Kwang Yang Motor* v *OHIM — Honda Giken Kogyo (Internal combustion engine)*, not published in the ECR, paragraph 32).

45 Therefore, the greater the designer's freedom in developing a design, the less likely it is that minor differences between the designs being compared 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 being compared will be sufficient to produce a different overall impression on an informed user. Therefore, if the designer enjoys a high degree of freedom in developing a design, that reinforces the conclusion that the designs being compared which do not have significant differences produce the same overall impression on an informed user (*Internal combustion engine*, paragraph 44 above, paragraph 33).

46 In paragraph 48 of the contested decisions, the Board of Appeal found that the applicant's argument that the designer's degree of freedom was restricted in the present case was unconvincing. The Board of Appeal pointed out, particularly in respect of the tubes, that various cross-sections could be imagined, as shown by the other designs making up the applicant's registrations No 000593959-0003 to No 000593959-0008.

47 It must be stated that the Board of Appeal's view is correct.

48 As regards the design of the tubes, it has been neither proven nor even alleged that the designer's freedom is subject to particular restrictions. Quite the reverse, since it appears that the designer may choose, in respect of the cross-section of the tubes, from among a great variety of different shapes, as illustrated, moreover, by the applicant's designs No 000593959-0003 to No 000593959-0008.

49 As regards the design of the collectors, the applicant has not in any way proved that there are technical or statutory requirements restricting the designer's degree of freedom. Consequently, the applicant's statement that 'it [is not] a coincidence if the diameter of the collectors of the radiators actually manufactured by [the intervener], [the applicant] and the great majority of radiator manufacturers is constant and equal in size to 34 or 35 mm' not only does not in any way constitute evidence of the existence of technical or statutory constraints which impose that diameter on manufacturers of radiators, but, quite the reverse, expresses clearly the fact that the use of other diameters for collectors — irrespective even of the use of cross-section shapes other than the cylindrical shape — was not only possible, but also took place.

50 Those considerations are, moreover, borne out by the applicant's response, in the reply, to the remark made by OHIM and the intervener concerning the absence of evidence of relevant technical or statutory constraints. The applicant's only response to that remark is to state that 'for the purposes of the present proceedings, at least, the intervener's and the applicant's products have the same diameter of collector and [that] that most certainly constitutes a genuine reference criterion in the comparative analysis of the two radiator designs'. It must, however, be stated that the fact that the radiators actually manufactured by the parties according to the designs at issue may include collectors of the same diameter does not alter the fact that it has in no way been established that there is any technical or statutory limitation of the designer's freedom as regards the collectors.

51 Lastly, the existence of statutory or technical constraints as regards the details of the arrangement of the tubes and collectors has not been established.

52 It follows from the foregoing that, as OHIM points out, the Board of Appeal was right to find, essentially, in paragraph 48 of the contested decisions, that the designer's degree of freedom was not restricted.

53 Thirdly, it is necessary to examine the Board of Appeal's assessment, criticised by the applicant, of the individual character of the contested designs.

54 The applicant submits that the Board of Appeal erred when it stated that, in the designs at issue, 'the lateral projection of the collectors was also identical' (paragraph 41 of the contested decisions). In fact, according to the applicant, the contested designs show, as regards the collectors, broken lines, since they are not of a predetermined length, while they do not, in any event, have a lateral projection, unlike the earlier designs. Consequently, the fact that, in contrast to the earlier designs, the collectors in the contested designs have no lateral projections constitutes the first substantial difference between the designs at issue, which the Board of Appeal, wrongly, failed to take into account.

55 It must be stated at the outset that, as OHIM, moreover, acknowledges before the Court, the contested designs do not include any claim as regards the ends of the collectors and, in particular, the projection which those collectors may have in relation to the last tube. That absence of a claim is deduced from the broken lines with which, in the views of the contested designs, the designs for the collectors terminate.

56 That finding in respect of the absence of a claim as regards the ends of the collectors is, moreover, consistent with the fact that the contested designs are, as is made expressly clear by the applications for registration filed by the applicant, not designs for 'radiators for heating', but, more restrictively, designs for 'thermosiphons' (modelli di termosifoni) intended to be applied to radiators for heating.

57 In that regard, it must be pointed out that the reference to 'radiators for heating' (radiatori per riscaldamento), made as a matter of course by OHIM in the registrations as published in the *Community Designs Bulletin*, is the result of a purely administrative initiative on the part of OHIM, which seeks to classify those registrations according to the non-mandatory terminology of the classification established by the Locarno Agreement (paragraph 2 above). That initiative neither replaced nor invalidated the description of the contested designs — designs for thermosiphons — set out in the applications for registration (see, in that regard, Article 36(6) of Regulation No 6/2002 and Article 3 of Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Regulation No 6/2002 (OJ 2002 L 341, p. 28)).

58 It follows from the foregoing that all the references made in the present case to the projections of the collectors in the designs at issue, whether for the purpose of finding that they are identical or that they may be, or, conversely, of claiming that they are different, go beyond the framework of the protection claimed by the contested designs and are therefore irrelevant.

59 Consequently, the Board of Appeal erred in finding, in paragraph 41 of the contested decisions, that '[t]he lateral projection of the collectors [in the designs at issue was] identical'.

60 No matter what OHIM states, that finding on the part of the Board of Appeal certainly constitutes one of those which, in paragraph 41 of the contested decisions, serve as a basis for the Board of Appeal's statement in paragraph 42 of those decisions that '[t]he general appearance of the [designs at issue] must be regarded as similar, or as not being such as to produce a significantly different overall impression on the informed user'.

61 None the less, that erroneous assessment on the part of the Board of Appeal cannot imply that the contested decisions should be annulled if it is established that the other findings made by the Board of Appeal in those decisions, relating to the shapes, arrangement and proportional relationships of the tubes and collectors, provided a sufficient legal basis for the conclusion that the contested designs did not have individual character.

62 So far as concerns those other findings, first, the Board of Appeal pointed out that the designs at issue had in common that they represent two horizontal collectors with circular cross-sections, joined at the front (in respect of designs No 000593959-0002 and No 4) and also at the back (in respect of designs No 000593959-0001 and No 5) by a series of vertical elements (radiant tubes), rectangular in cross-section, with a slight space between the tubes (paragraph 40 of the contested decisions).

63 The Board of Appeal found that the designs at issue used components which have the same shape. It referred to the fact that the vertical tubes were rectangular and the collectors were cylindrical (paragraph 41 of the contested decisions).

64 Secondly, the Board of Appeal found that the proportional differences, pointed out before it by the applicant, between the designs at issue, regarding, first, the relationship between the width and the depth of the tubes, secondly, the relationship between the width of the tubes and the space between two tubes and, thirdly, the relationship between the diameter of the collector and the depth of the tubes could not, admittedly, be denied, but were, nevertheless, not sufficient, even when all viewed at the same time, to alter, in the eyes of the informed user, the overall impression produced by the designs at issue (paragraphs 43 to 47 of the contested decisions).

65 Contesting those findings, the applicant reiterates, in essence, its line of argument already set out before OHIM and based on the proportional differences between the designs at issue, which it regards as sufficiently important to give rise to significantly different overall impressions on the part the informed user. The applicant thus compares, in respect of the designs at issue, the depth/width of tubes ratios (2.2:1 in respect of the earlier designs as opposed to 1.7:1 in respect of the contested designs) and the space between two tubes/width of tubes ratio (1:1 in respect of the earlier designs as against 0.6:1 in respect of the contested designs).

66 According to the applicant, it is undeniable that the earlier designs are much deeper than the contested designs and that the tubes in the earlier designs are much more spaced out than those in the contested designs. It follows that there is a clear and significant difference in terms of the overall impression produced on the informed user.

67 It must be noted, at the outset, that the protection sought relates to designs, irrespective of the actual dimensions of the products to which those designs are intended to be applied, and that, in addition, the applicant has furnished No evidence of any statutory or technical constraint which imposes the same diameter on collectors for radiators for heating (see, in that regard, paragraphs 49 and 50 above).

68 It must be added, in that regard, that the fact that it is perfectly permissible for the applicant to produce, in Annexes A.2 to the applications, views of the designs at issue which have been reproduced on scales which make it possible to equalise the apparent diameters of the collectors does not alter the fact that it has in no way been established that those collectors must, as a result of technical or statutory constraints, actually be manufactured with the same diameter.

69 Consequently, all the applicant's claims that the earlier designs are 'deeper' than the contested designs or that the tubes in the earlier designs are 'more spaced out' than those in the contested designs, or even that, per linear metre of thermosiphon, the radiators which may be manufactured according to the contested designs include '44 tubes' and those manufactured according to the earlier designs include '24 tubes which are manifestly wider and more spaced out', are entirely irrelevant, since they constitute comparisons made on the basis of actual dimensions which were calculated on the premiss — which has not been proved — that the collectors represented in the designs at issue are necessarily equal in diameter.

70 For the same reasons, the applicant errs in claiming that the Board of Appeal did not sufficiently assess the dimensions of the designs at issue since it did not compare those designs on the basis of having made the collectors represented in those designs equal in dimension.

71 In short, for the purposes of the comparison of the overall impressions produced by the designs at issue, and leaving aside the other relevant findings relating to the choice of shapes and the arrangement of the tubes and collectors, only the findings relating to the differences in the internal proportional relationships of those different designs are relevant in the present case.

72 In the light of those preliminary observations, it must be pointed out that it is in fact true, as was, moreover, found by the Board of Appeal itself, that there are certain differences between the designs at issue in respect of the internal proportional relationships of those designs.

73 Thus, the Board of Appeal, reproducing the evidence put forward by the applicant before OHIM, refers to differences in the depth/width of tubes ratios (2:1 in respect of the earlier designs as opposed to 1.7:1 in respect of the contested designs (paragraph 44 of the contested decisions); in the space between two tubes/width of tubes ratios (1:1 in respect of the earlier designs as against 0.6:1 in respect of the contested designs) (paragraph 45 of the contested decisions); and in the diameter of the collector/depth of tubes ratios (a ratio which is smaller than a unit in respect of the earlier designs and greater than a unit in respect of the contested designs) (paragraph 46 of the contested decisions).

74 The Board of Appeal takes the view, in essence, that those differences, whether taken individually or overall, are not significant enough to alter the overall impression produced by the designs at issue (paragraphs 44 to 47 of the contested decisions).

75 Against that background, the Board of Appeal proceeded by rejecting the applicant's argument that the designer's degree of freedom was restricted (paragraph 48 of the contested decisions).

76 At this stage of the examination of the Board of Appeal's assessments, it must be pointed out that, although the latter finding on the part of the Board of Appeal is correct (see paragraphs 46 to 52 above), the fact none the less remains that another issue, which is relevant to the assessment of the degree of attention which the informed user pays to the differences between the designs at issue, was raised by the applicant in the proceedings before OHIM.

77 It is apparent from the contested decisions themselves that the applicant argued, both before the Cancellation Division (see paragraph 4, second sentence) and before the Board of Appeal (see paragraph 11(c), second sentence), that the unit-radiators and collectors sector had been saturated in terms of design, with the result that the differences in the internal proportions of the designs at issue, far from being capable of being regarded as insignificant in comparison with the points in common linking those designs, were, on the contrary, immediately perceptible to an informed user and therefore gave rise to different overall impressions.

78 It is also apparent from the contested decisions that, before the Board of Appeal, the applicant stated that those arguments had been amply illustrated during the proceedings before the Cancellation Division, which did not take them into consideration, even to rebut them (paragraph 11(c), *in fine*).

79 It must be stated that the Board of Appeal, although it refers expressly to those arguments on the part of the applicant relating to the saturation of the state of the art, does not in turn provide, in the contested decisions, any statement of reasons with regard to them, even for the purpose of rejecting them as not proved.

80 In particular, and contrary to what OHIM suggests in its response before the Court, paragraph 48 of the contested decisions does not address that issue, but only that of the restriction of the designer's freedom by technical or statutory constraints, which is a separate issue.

81 The finding that the designer's freedom was not restricted by technical or statutory constraints in no way dealt with the question whether, de facto, there was a 'saturation of the state of the art' by reason of the existence of other designs for thermosiphons or radiators which have the same overall features as the designs at issue, a saturation of the state of the art which could be capable of making the informed user more attentive to the differences in the internal proportions of those different designs.

82 OHIM and the intervener, questioned by the Court regarding the statement of reasons for the contested decisions, in respect of the applicant's allegation relating to the saturation of the state of the art, do not dispute the view that the contested decisions do not provide a statement of reasons as regards the issue of the saturation of the state of the art. Quite the reverse, since OHIM, in its observations of 29 May 2012, concedes in essence that it did not provide such a statement of reasons.

83 At the same time, OHIM maintains, in its observations of 29 May 2012 and subsequently at the hearing, first, that the applicant claimed, not that a saturation of the state of the art could influence the informed user's perception of the design, but merely that a reduced scope for freedom on the part of designers could arise from such a saturation and, secondly, that the latter claim was erroneous.

84 In the alternative, OHIM, supported by the intervener, submits that the applicant has not, in any event, proved the saturation of the state of the art and that OHIM is not required to respond to arguments which are of no interest or are irrelevant. OHIM also refers to *Communications Equipment*, paragraph 37 above, paragraph 58, stating that the Court, in that judgment, excluded the relevance of a saturation of the state of the art which was merely linked to a design trend, or even confirmed the principle that the existence of such a trend is irrelevant in the assessment of individual character.

85 As regards the first claim which OHIM put forward in its observations of 29 May 2012 and subsequently at the hearing, relating to what the applicant did or did not claim before the Cancellation Division and the Board of Appeal, it must be stated that that claim is directly disproved both by the findings made in paragraphs 77 to 79 above and by the reference, made by OHIM itself in paragraph 15 of its response, to the applicant's argument before the Board of Appeal regarding the saturation of the state of the art. It cannot therefore seriously be disputed that the applicant claimed, before OHIM, that a saturation of the state of the art existed which was capable of influencing the informed user's perception of the designs at issue, and that OHIM had identified that argument perfectly.

86 Consequently, OHIM's second claim, to the effect that a reduced scope for freedom on the part of designers cannot arise from a saturation of the state of the art, appears to be irrelevant.

87 The only question at issue is that of whether the Board of Appeal examined the applicant's argument that there was a saturation of the state of the art which was capable of influencing the informed user's perception of the designs at issue. As has already been stated, however, the answer to that question as to whether OHIM carried out an examination is in the negative.

88 In its arguments put forward in the alternative, OHIM, supported by the intervener, submits that the applicant did not, in any event, prove before it the saturation of the state of the art and that it is not required to respond to arguments which are of no interest or are irrelevant.

89 As regards, first, the reference to the fact that OHIM is not required to respond to arguments which are of no interest or are irrelevant, it must be held, as has already been stated in paragraph 81 above, that a possible saturation of the state of the art, deriving from the alleged existence of other designs for thermosiphons or radiators which have the same overall features as the designs at issue, was relevant, in so far as it could be capable of making the informed user more attentive to the differences in the internal proportions of those different designs.

90 As for the argument that the applicant did not prove before OHIM that the state of the art was saturated, it must be held that that view constitutes, as the applicant essentially contends, an attempt to provide a belated statement of reasons for the contested decisions, which is inadmissible before the Court. According to settled case-law, the statement of reasons must in principle be notified to the person concerned at the same time as the act adversely affecting him as a failure to state the reasons cannot be remedied by the fact that the person concerned learns the reasons for the act during the proceedings before the Courts of the European Union (Case 195/80 *Michel* v *Parliament* [1981] ECR

2861, paragraph 22; Joined Cases C-189/02 P, C-202/02 P, C-205/02 P to C-208/02 P and C-213/02 P *Dansk Rørindustri and Others* v *Commission* [2005] ECR I-5425, paragraph 463; and Case T-228/02 *Organisation des Modjahedines du peuple d'Iran* v *Council* [2006] ECR II-4665, paragraph 139).

91 Furthermore, that argument on the part of OHIM, to the effect that the saturation of the state of the art was not proved in the administrative proceedings, must be rejected in so far as it may be perceived, in the same way as the claims and arguments put forward and the new documents produced by the applicant in its observations of 29 May 2012, as an invitation to the Court to examine itself the question of the existence of that saturation and its effects on the informed user's perception of the designs at issue.

92 It must be borne in mind that the power of the General Court to alter decisions does not have the effect of conferring on that Court the power to carry out an assessment on which the Board of Appeal has not yet adopted a position, and exercise of the power to alter decisions must therefore, in principle, be limited to situations in which the General Court, after reviewing the assessment made by the Board of Appeal, is in a position to determine, on the basis of the matters of fact and of law as established, what decision the Board of Appeal was required to take (Case C-263/09 P *Edwin* v *OHIM* [2011] ECR I-5853, paragraph 72).

93 Lastly, it must be pointed out that OHIM's reference to *Communications Equipment*, paragraph 37 above, paragraph 58, is irrelevant.

94 In *Communications Equipment*, the applicant's argument was, in essence, that the designer's freedom was restricted, inter alia, by the concern to conform to a general design trend (*Communications Equipment*, paragraph 37 above, paragraph 52, *in fine*). The Court rejected that argument, stating that a general design trend is relevant, at the most, in relation to the aesthetic perception of the design concerned and can therefore, possibly, have an influence on the commercial success of the product in which that design is incorporated (*Communications Equipment*, paragraph 37 above, paragraph 58).

95 In so doing, the Court merely refused to allow a general design trend to be regarded as a factor which restricts the designer's freedom, since it is precisely that freedom on the part of the designer which allows him to discover new shapes and new trends or even to innovate in the context of an existing trend.

96 The Court did not, by contrast, in *Communications Equipment*. paragraph 37 above, in any way intend to state that a saturation of the state of the art should be regarded as irrelevant in assessing the individual character of a design. At the very most it excluded from the assessment of individual character any consideration relating to the aesthetic quality of the design being examined or to the commercial success of the product in which that design is incorporated (see, to that effect, *Communications Equipment*, paragraph 37 above, paragraph 58, *in fine*).

97 It follows from the foregoing that, although the contested decisions refer expressly to the applicant's argument relating to a saturation of the state of the art, and although that argument was relevant for the purpose of assessing the individual character of the contested designs, those decisions do not contain any statement of reasons as regards that claim.

98 According to settled case-law, the obligation to state reasons, the purpose of which is, first, to provide the person concerned with sufficient information to make it possible to determine whether the act is well founded or whether it is vitiated by an error which may permit its validity to be contested before the Courts of the European Union and, secondly, to enable those Courts to review the lawfulness of the act (Case C-199/99 P *Corus UK* v *Commission* [2003] ECR I-11177, paragraph 145, and *Dansk Rørindustri and Others* v *Commission*, paragraph 90 above, paragraph 462), constitutes an essential

principle of EU law which may be derogated from only for compelling reasons (see Case T-218/02 *Napoli Buzzanca* v *Commission* [2005] ECR-SC I-A-267 and II-1221, paragraph 57 and the case-law cited).

99 Against that background, from which it is apparent that, leaving aside the erroneous assessments referred to in paragraphs 59 to 61 above, the Board of Appeal failed to state reasons for the contested decisions in respect of an issue which was, however, relevant for the purpose of assessing the individual character of the contested designs, it is necessary to annul the contested decisions inasmuch as they declared the contested designs invalid and to dismiss the present cases as to the remainder.

Costs

100 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since OHIM has been unsuccessful for the main part, it must be ordered to pay the costs, in accordance with the form of order sought by the applicant.

101 In accordance with the third subparagraph of Article 87(4) of the Rules of Procedure, the party intervening in support of OHIM is to bear its own costs.

102 The applicant also claimed that the intervener should be ordered to pay the costs incurred by the applicant in the administrative proceedings before OHIM. In that regard, it must be borne in mind that, 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. However, that is not the case with regard to the costs incurred for the purposes of proceedings before the Cancellation Division. Accordingly, the applicant's request that the intervener, having been unsuccessful, be ordered to pay the costs of the administrative proceedings before OHIM can be allowed only in regard to those costs which were necessarily incurred by the applicant for the purposes of the proceedings before the Board of Appeal.

On those grounds,

THE GENERAL COURT (Second Chamber)

hereby:

1. **Annuls the decisions of the Third Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 2 November 2010 (Cases R 1451/2009-3 and R 1452/2009-3) in so far as they declared designs No 000593959-0001 and No 000593959-0002 to be invalid;**

2. **Dismisses the actions as to the remainder;**

3. **Orders OHIM to bear its own costs and to pay those incurred by Antrax It Srl in the proceedings before the General Court;**

4. **Orders The Heating Company (THC) to bear its own costs before the General Court and to pay the costs incurred by Antrax It in the proceedings before the Board of Appeal.**

Forwood Dehousse Schwarcz

Delivered in open court in Luxembourg on 13 November 2012.

[Signatures]